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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANJA BAUER, BEIERSDORF AG, VOLKER KALLMAYER,
PETERSTEIDLE, and KLAUS-PETER STANGE¹

Appeal 2020-000626
Application 15/551,597
Technology Center 1600

Before RICHARD M. LEBOVITZ, DEBORAH KATZ, and JOHN A.
EVANS, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of Claims 5–24. Appeal Br. 17–19 (Claims App.); Final Act 1. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ We use the word “Appellant” to refer to “[A]pplicant[s]” as defined in 37 C.F.R. § 1.42(a). The Appeal Brief identifies Beiersdorf AG, as the real party in interest. Appeal Br. 3.

INVENTION

The claims relate to a cosmetic preparation comprising an emulsion of one or more hydrophilic phases and one or more lipophilic phases contained within a metal can. *See* Abstract. Claim 5, the sole independent claim, is reproduced below with some formatting added.

5. A cosmetic product, wherein the product comprises a metal can which comprises

a metallic container (A) containing a cosmetic preparation (Z) and comprising a rotation thread (A') and a lid (D) having a thread (D') and being made of the same metal as the container (A), lid (D) being unscrewable and screwable onto container (A) in by thread (D') and thread (A') via rotational movement, and

wherein the cosmetic preparation (Z) comprises an emulsion of one or more hydrophilic phases and one or more lipophilic phases,

the one or more lipophilic phases comprising, in a total concentration of at least 3% by weight, based on a total weight of the preparation,

(i) at least one lipid having a spreading value at 25°C of at least 700 mm²/10 minutes,

(ii) at least one lipid having a dropping point > 30°C, and

(iii) at least one monohydric and/or polyhydric alcohol.

PRIOR ART

Name²	Reference	Date
Walsh	US 2004/0057921 A1	Mar. 25, 2004
Lee	US 2010/0287891 A1	Nov. 18, 2010
Wegner	US 2014/0364509 A1	Dec. 11, 2014
Kulkarni	US 2015/0044157 A1	Feb. 12, 2015

REJECTIONS³ AT ISSUE⁴

1. Claims 5–12, 14, 16–19, and 21–23 stand rejected under 35 U.S.C. § 103 over Wegner and Lee. Final Act. 4–8.
2. Claim 13 stands rejected under 35 U.S.C. § 103 over Wegner, Lee, and Lutz. Final Act. 8–10.
3. Claims 15 and 24 stand rejected under 35 U.S.C. § 103 over Wegner, Lee, and Kulkarni. Final Act. 10–12.
4. Claim 20 stands rejected under 35 U.S.C. § 103 over Wegner, Lee, and Walsh. Final Act. 12–14.

² All citations herein to the references are by reference to the first named inventor/author only.

³ The present application was examined under the first inventor to file provisions of the AIA. Final Act. 2.

⁴ Throughout this Decision, we refer to the Appeal Brief (“Appeal Br.”) filed July 30, 2019, the Reply Brief (“Reply Br.”) filed November 5, 2019, the Final Office Action (“Final Act.”) mailed January 2, 2019, the Examiner’s Answer mailed September 6, 2019, and the Specification (“Spec.”) filed August 17, 2017.

ANALYSIS

We have reviewed the rejections of Claims 5–24 in light of Appellant’s arguments that the Examiner erred. We have considered in this decision only those arguments Appellant actually raised in the Briefs. Any other arguments which Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2018). Except with respect to Claims 7 and 20, we are not persuaded that Appellant identifies reversible error. We adopt as our own the findings and reasons set forth in the rejection from which this appeal is taken and in the Examiner’s Answer, to the extent consistent with our analysis below. We provide the following explanation to highlight and address specific arguments and findings primarily for emphasis.

CLAIMS 5–12, 14, 16–19, AND 21–23: OBVIOUSNESS OVER WEGNER AND LEE.

Lid.

Claim 5, the sole independent claim, recites, *inter alia*, “a metallic container (A) containing a cosmetic preparation (Z) and comprising a rotation thread (A') and a lid (D) having a thread (D') and being made of the same metal as the container (A), lid (D) being unscrewable and screwable onto container (A).”

The Examiner finds Lee teaches a metallic, i.e., aluminum, storage container for pharmaceutical products. Final Act. 6–7. The Examiner finds Wegner discloses “the compositions are desirably provided as a ready to use product in a manually operated dispensing container,” provided a pump head or trigger spray mechanism, i.e., “lid.” Final Act. 6 (citing Wegner ¶ 84). But, the Examiner finds Wegner does not teach the lid is attached via a screw mechanism. The Examiner finds Lee teaches the base and lid

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comprise compatible threads. *Id.* at 7. The Examiner defines “lid” as: “a movable cover for the opening of a hollow container.” Final Act. 14; Ans. 4.

Appellant contends the portion of Lee, relied upon by the Examiner, does not fairly teach a lid. Appeal Br. 7 (quoting Lee ¶ 27) (“the connection region of the storage container can be formed by a lock-in, lock-on or screw connection. As a function of the materials which are used, the region for connecting or fixing the metering device on the storage container is configured here optimally.”). Appellant argues the “screw mentioned in LEE is not for connecting or fixing a *lid* on the storage container but rather is for connecting or fixing a metering device on the storage container.” Appeal Br. 7.

The Examiner finds Lee discloses a hollow storage container and a screw-on metering device which the Examiner finds meets the definition of “lid.” Ans. 4.

Appellant contends “the Examiner [has not] pointed to any part of the instant specification from which it might be concluded that the lid mentioned therein may be in the form of a metering device and is not just a ‘regular’ (screwable) lid as shown in the drawings of the instant application.” Reply Br. 2.

We agree with Appellant that an interpretation of a claim term must be “consistent with the specification.” Reply Br. 2 (quoting *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997)). But we are equally mindful that in interpreting the claims, however, limitations may not be imported into the claims from the Specification. *See SuperGuide Corp. v. DirectTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Appellant fails to direct our attention to any specification disclosure that limits the claimed lid to “a

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‘regular’ (screwable) lid as shown in the drawings of the instant application.” *See* Reply Br. 2. We are not persuaded the Examiner errs.

Made of the same metal.

Claim 5 recites, *inter alia*, that the lid is made of the same metal as the container. Appellant contends “LEE does not contain any indication that the ‘metering device’ mentioned therein is made of the same metal as the container.” Appeal Br. 9; *see* Reply Br. 3.

The Examiner finds Lee discloses “the storage container can be formed from glass, metal, in particular aluminum.” Adv. Act.⁵ 2. Moreover, the Examiner finds the “material of the ‘metering device’ of Lee that covers the storage container is a mere design choice.” *Id.* (quoting Lee ¶ 27) (“as a function of materials which are used, the region for connecting or fixing the metering device on the storage container is configured here optimally”).

Appellant contends Lee does not affirmatively recite the metering device is made of the same metal as the container. Appeal Br. 9. Appellant further argues it would be unlikely the metering device is made of metal.

The Examiner repeats the finding that Lee discloses the container may be formed of metal and as a function of the materials used, the connecting region of the metering device is configured optimally. Ans. 4–5.

Appellant argues the Examiner has not proffered evidence that metering devices are made of metal and not plastic. Reply Br. 3.

We find Lee at least suggests the connecting region of the metering device may be made of metal. We note Claim 5 recites “comprises,” which

⁵ Advisory Action mailed March 20, 2019.

indicates the can and lid must contain metal, but that other materials are not excluded. For example, Appellant discloses the claimed metal can further comprise an “inner protective coating applied before the shaping of the can having thermoplastically sealable or ultrasound-weldable properties.” Spec. 4, ll. 4–6. We are not persuaded the Examiner errs.

Claim 7

Claim 7 recites: “[t]he cosmetic product of claim 5, wherein the preparation comprises up to 20 % by weight of lipophilic substances, based on a total weight of the preparation.”

Appellant contends Wegner discloses a cosmetic product comprising from 40 to 99% by weight of a C₁₋₆ alcohol. Appeal Br. 10. Appellant argues such lower alcohols are lipophilic and thus, Wegner teaches away from Claim 7 which limits lipophiles to 20%. *Id.*

The Examiner finds “the hydroxyl group is referred to as a hydrophilic (i.e., not lipophilic) group, because it forms hydrogen bonds with water.” Ans. 5–6 (citing Encyclopedia Britannica (“*Physical Properties of Alcohols*,” 2019, p. 3, last ¶)). The Examiner further finds “methanol, ethanol, n-propyl alcohol, isopropyl alcohol and t-butyl alcohol are all miscible with water (i.e., hydrophilic and not lipophilic).” *Id.* at 6. The Examiner finds the low molecular weight alcohols of Wegner do not read on the claimed lipophiles. *Id.*

Appellant disputes the Examiner’s characterization of compounds having hydroxyl groups as limited to hydrophilic compounds. Reply Br. 3.

We find, contrary to the Examiner’s finding, that “[a]lcohols are also the simplest form of amphiphilic molecules having both hydrophobic and

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hydrophilic segments”⁶ and thus are correctly found to be a lipophilic phase as required by the claims. Whereas Claim 7 limits lipophiles to a concentration of 20 wt.%, Wegner discloses a composition comprising a minimum of 40 wt% lipophile. The Examiner did not provide a reason why such value would have been obvious to one of ordinary skill in the art. We decline to sustain the rejection of Claim 7.

Claim 19.

Claim 19 recites: “[t]he cosmetic product of claim 5, wherein the preparation comprises hydrogenated coconut fatty acid glycerides.”

Appellant contends the Examiner’s citation to Wegner’s disclosure of PEG-30 or PEG-80 glyceryl cocoates are ethoxylated compounds which fail to “qualify as hydrogenated coconut fatty acid glycerides.” Appeal Br. 11.

The Examiner finds Wegner discloses: “low spreading emollients include mono-, di-, and triglycerides and butters and hydrogenated versions of seed and nut oils (e.g., coconut oil).” Ans. 6.

Appellant does not reply to this finding. We are not persuaded the Examiner errs.

CLAIM 13: OBVIOUSNESS OVER WEGNER, LEE, AND LUTZ.

Claim 13 depends from Claim 5. Appellant contends Lutz fails to cure the deficiencies of Wegner with respect to Claim 5.

Because Appellant fails to persuade us the Examiner errs with respect to Claim 5, we are not persuaded the Examiner errs with respect to Claim 13.

⁶ Deepti Ballal and Walter G. Chapman, *Hydrophobic and hydrophilic interactions in aqueous mixtures of alcohols at a hydrophobic surface*, The Journal of Chemical Physics 139, 114706 (2013).

CLAIMS 15 AND 24: OBVIOUSNESS OVER WEGNER, LEE, AND KULKARNI.

Claim 15 recites: “The cosmetic product of claim 5, wherein the preparation comprises palmitic acid, stearic acid, myristic acid, arachidonic acid, and oleic acid.”

The Examiner finds Wegner teaches wherein the composition further contains skin conditioners such as carboxylic and fatty acids, but fails to teach wherein the “acid is stearic, palmitic, myristic, arachidonic or oleic acid.” Final Act. 11 (emphasis added). The Examiner finds Kulkarni teaches that stearic acid and palmitic acid are both used as skin conditioners. *Id.*

Appellant contends the preparation of Claim 5 comprises “palmitic acid, stearic acid, myristic acid, arachidonic acid, and oleic acid.” Appeal Br. 13. Appellant argues Kulkarni fails to teach the combination of the five acids. *Id.*

The Examiner finds Kulkarni discloses the inclusion of cottonseed oil which is known to contain each of the claimed acids. Ans. 6–7.

Appellant does not reply to this finding of the Answer. We are not persuaded the Examiner errs.

CLAIM 20: OBVIOUSNESS OVER WEGNER, LEE, AND WALSH.

Claim 20 recites: “The cosmetic product of claim 5, wherein the preparation comprises cera microcristallina.”

Appellant contends the Examiner has provided no motivation to combine the microcrystalline wax of Walsh into Wegner’s alcohol-based sanitizer composition. Appeal Br. 13–14. Appellant argues there is no motivation to combine exfoliating particles into a sanitizer, particularly one that claims an improved feel. Appeal Br. 14.

The Examiner finds “Walsh teaches that such microcrystalline wax particles advantageously aid in exfoliating the skin which provides a reason/motivation for one of ordinary skill in the art to incorporate it into the sanitizer composition of Wegner.” Ans. 7.

Appellant replies the Examiner has not explained why, nor provided evidence, that it is commonly considered advantageous for a sanitizer composition to have exfoliating properties. Reply Br. 3.

We agree that the Examiner did not meet the burden of providing adequate reason or motivation to add the exfoliating particles to Wegner.

CONCLUSION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
5–12, 14, 16–19, 21–23	103	Wegner, Lee	5, 6, 8–12, 14, 16–19, 21–23	7
13	103	Wegner, Lee, Lutz	13	
15, 24	103	Wegner, Lee, Kulkarni	15, 24	
20	103	Wegner, Lee, Walsh		20
Overall Outcome			5, 6, 8–19, 21–24	7, 20

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART