

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEX JUNINO, QUANG LAN N'GUYEN, REMY TULOUP, and
CHRISTIAN BLAISE

Appeal No. 95-1274
Application No. 07/914,150¹

HEARD: June 13, 1997

Before KIMLIN, OWENS, and McFARLANE, Administrative Patent Judges.

McFARLANE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1 through 6. In an amendment² subsequent to the final rejection, claim 1 has been amended, claim 7 has been canceled

¹ Application for patent filed July 16, 1992.

² The examiner indicated entry of the amendment (filed March 18, 1994 (Paper No. 12) after the final rejection. However, it was not clerically entered. For the purpose of this appeal, we will consider the amendment as having been entered.

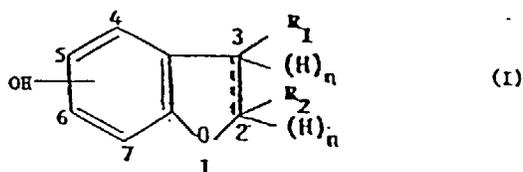
Appeal No. 95-1274
Application No. 07/914,150

and claim 8 added. The examiner indicated allowability of claim 8 in the advisory action (mailed March 25, 1994, paper no. 13).

The invention relates to a cosmetic or dermatological composition having depigmenting activity and for topical application to the skin. The composition comprises, in a cosmetically or dermatologically acceptable vehicle, an effective amount of the depigmenting substance consisting essentially of a benzofuran derivative.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A depigmenting cosmetic or dermatological composition for topical application to skin comprising in a cosmetically or dermatologically acceptable vehicle an effective amount of a depigmenting substance consisting essentially of a benzofuran derivative having the formula:



wherein

the OH function is in the 5 or 6 position,

R_1 and R_2 , each independently, represent hydrogen or alkyl having 1-4 carbon atoms,

n is 0 or 1,

when n is 0, the C_2-C_3 bond is a double bond, and

Appeal No. 95-1274
Application No. 07/914,150

must be considered in determining patentability. In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974). Here, the preamble of claim 1 recites the limitation, "[a] depigmenting cosmetic or dermatological composition." Accordingly, we must consider such a limitation in our determination of patentability of claim 1 in view of the herein applied reference. See e.g. Rowe v. Dror, 112 F.3d 473, 479, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Paul describes an antioxidant comprising a reaction product of polyhydric phenol and an aliphatic diene (page 1, column 1, lines 12-15). Paul states that the reaction product may contain, inter alia, 2-ethyl-5-hydroxy coumarane and 2,3-dimethyl-5-hydroxy coumarane, both benzofuran derivatives. Paul further states that the reaction product may be incorporated into a rubber composition. We note, as do appellants, that Paul fails to describe a "depigmenting cosmetic or dermatological composition." Significantly, Paul also fails to describe "an effective amount" of the benzofuran derivative. Paul states that 0.1% to 5% of the antioxidant may be incorporated into the rubber composition. Since Paul fails to describe the amount of the benzofuran derivatives contained in the reaction product, it

Appeal No. 95-1274
Application No. 07/914,150

follows that Paul does not describe the amount of said benzofuran derivative which is contained in the rubber composition.

In responding to appellants' argument that Paul fails to describe the claimed amount of benzofuran derivative, the examiner, at page 4 of the answer, contends that "Paul does not call for 0.01-5% [sic] of the reaction mixture but calls for this concentration of antioxidant" (emphasis in the original). We disagree with the examiner's contention. As we noted earlier, the anti-oxidant of Paul comprises the reaction product of polyhydric phenol and an aliphatic diene. This reaction product comprises a number of constituents including benzofuran derivatives. See page 1, column 2, line 21 to page 2, column 1, line 5. We find that Paul does not describe the proportion of each constituent in the reaction product and therefore does not describe the amount of benzofuran derivative as called for by claim 1.

Absence of a claim limitation in a reference negates anticipation of the claim by that reference. See e.g. Rowe v. Dror, 112 F.3d 473, 479, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). Accordingly, Paul does not anticipate the subject matter of claim 1. We therefore reverse the decision of the examiner in rejecting claims 1 through 6.

Appeal No. 95-1274
Application No. 07/914,150

The decision of the examiner is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
ANTHONY R. McFARLANE)	
Administrative Patent Judge)	

Appeal No. 95-1274
Application No. 07/914,150

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APPEAL NO. 95-1274 - JUDGE McFARLANE

APPLICATION NO. 07/914,150

McFARLANE

KIMLIN

OWENS

DECISION: **REVERSED**

Typed By: Jenine Gillis

DRAFT TYPED: 24 JUN 97

FINAL TYPED: