

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL J. HALLORAN
and JUDITH M. VINCENT

Appeal No. 95-1302
Application 07/729,281¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and GRON, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

In Paper No. 15 filed November 15, 1993, applicants appealed to the Board from the examiner's final rejection of claims 17 through 26. However, it is clear from the appeal Brief (Paper No. 16 filed January 18, 1994) that applicants withdrew their

¹ Application for patent filed July 12, 1991. According to appellants, the application is a continuation of Application 07/548,810, filed July 6, 1990, now Patent No. 5,075,103, granted December 24, 1991.

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appeal with respect to claim 18. See particularly section (1) of the appeal Brief entitled "Status of Claims". Accordingly, the appeal with respect to claim 18 is dismissed. This leaves for our consideration claims 17 and 19 through 26.²

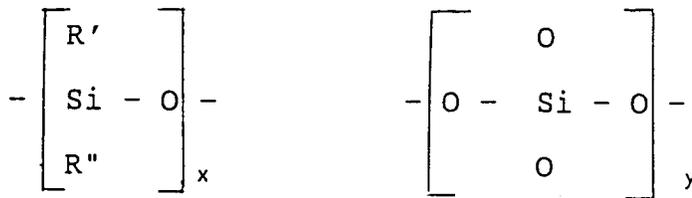
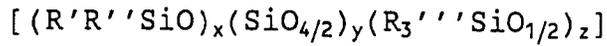
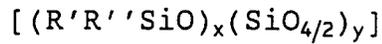
REPRESENTATIVE CLAIM

Claim 17, which is illustrative of the subject matter on appeal, reads as follows:

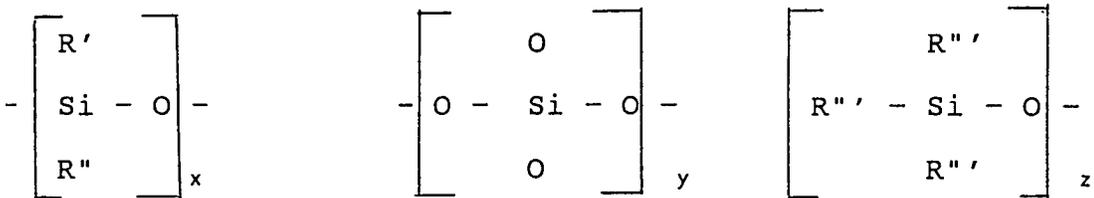
17. In a hair treating method for imparting curl retention to hair in which at least one film forming ingredient is applied to the hair as a mixture including the film forming ingredient dissolved in a solvent, the improvement comprising utilizing as the film forming ingredient an organosilicon compound having a formula selected from the group consisting of

² Apparently, in Paper No. 5 filed May 11, 1992, applicants intended to cancel claim 18 but inadvertently failed to do so. We trust that this matter will be resolved on return of the application to the examining corps.

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R, R', R'', and R''', are selected from the group consisting of alkyl, alkenyl, aryl, and alkylaryl, radicals having from one to twenty carbon atoms; x and z are each integers having a value of from zero to about one thousand provided either x or z is at

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least 1; y is an integer having a value from about one to about one thousand; and the organosilicon compound is present in the mixture at a level from about 0.1 to about fifty percent by weight based on the weight of the mixture.

THE REFERENCE

The single prior art reference relied on by the examiner is:

Lamb et al. (Lamb) 5,049,377 Sep. 17, 1991

THE ISSUE

The issue presented for review is whether the examiner erred in rejecting claims 17 and 19 through 26 under 35 USC § 102(e) as anticipated by Lamb.³

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials:

- (1) The instant specification, including all of the claims

³ In the Office Action mailed April 1, 1993, the examiner rejected claims 12 through 26 under 35 USC § 102(b) as anticipated by Lamb. The examiner refers to that Office Action in the Answer, page 2, last paragraph. However, as pointed out by applicants in the appeal Brief, page 4, lines 15 through 18, the correct statutory basis for this rejection is 35 USC § 102(e). The examiner restated the rejection in terms of 35 USC § 102(e) in the Answer, page 2, penultimate paragraph.

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on appeal;

(2) The appeal Brief;

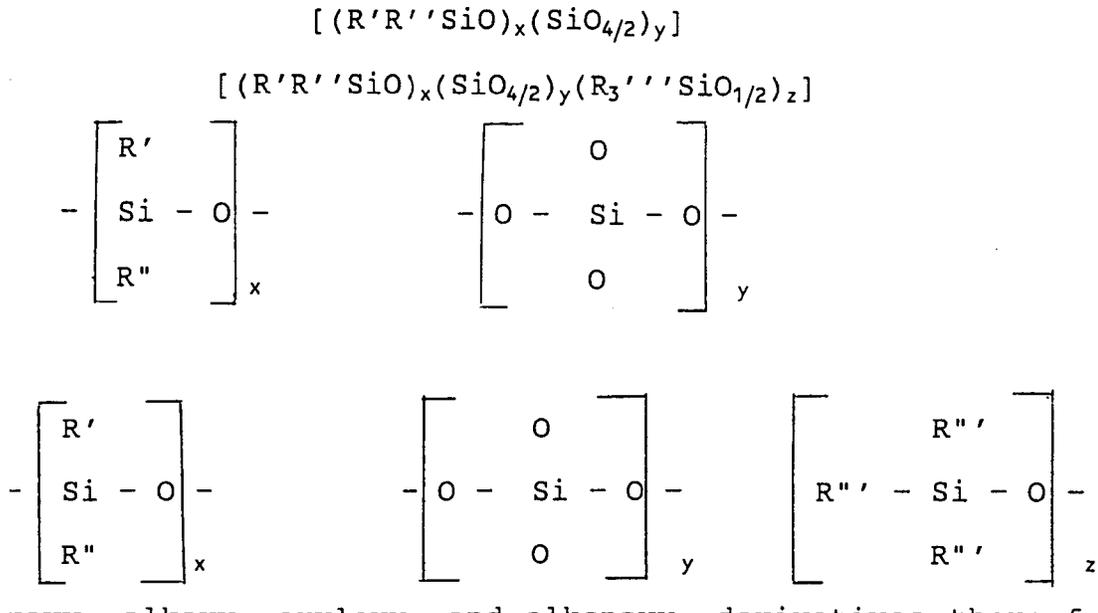
(3) The Examiner's Answer and the Office Action mailed April 1, 1993 (Paper No. 10); and

(4) The above-cited Lamb reference.

On consideration of the record, including the above-listed materials, we reverse the § 102(e) rejection.

DISCUSSION

Independent claim 17 defines a hair treating method for imparting curl retention to hair, where at least one film forming ingredient is applied to the hair as a mixture including the film forming ingredient dissolved in a solvent. The claim requires using, as the film forming ingredient, an organosilicon compound having a formula selected from the group consisting of



and hydroxy, alkoxy, aryloxy, and alkenoxy, derivatives thereof, wherein R, R', R'', and R''', are selected from the group consisting of alkyl, alkenyl, aryl, and alkylaryl, radicals having from one to twenty carbon atoms; x and z are each integers having a value of from zero to about one thousand provided either x or z is at least 1; y is an integer having a value from about one to about one thousand; and the organosilicon compound is present in the mixture at a level from about 0.1 to about fifty percent by weight based on the weight of the mixture.

In the Answer, page 2, last paragraph, the examiner states that claims 17 and 19 through 26 stand rejected under 35 USC § 102(e) as anticipated by Lamb "for the reasons as stated in paragraph 17 of the Office Action mailed April 1, 1993". We here

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reproduce the reasons set forth in paragraph 17 of that Office

Action:

Lamb et al. disclose hair care compositions and methods of treating hair comprising applying to the hair a formulation comprising at least one of the materials selected from the group consisting of a conditioning agent, surfactant, neutralizing agent, water soluble quaternized protein, silicone polymer, water, thickener, nonionic emulsiying [sic] wax, sunscreen, fixative and antimicrobial, the improvement comprising a conditioning agent which is a hydrophobic cationic aqueous emulsion of a highly branched and crosslinked polydimethylsiloxane resin present in an amount of from 0.05 to 20% by weight of the composition [emphasis added].

Manifestly, the examiner's statement of rejection does not explain how each and every element set forth in claim 17 is found in the Lamb reference. The examiner does not explain how or where the organosilicon compound, recited in claim 17 by way of Markush Group, is found in Lamb. See § 2131 of the Manual of Patent Examining Procedure (6th Edition, Revision 2, July 1996). For this reason alone, the § 102 rejection is flawed.

We point out that paragraph 17 of the Office Action mailed April 1, 1993, refers to a "silicone polymer" and a "hydrophobic cationic aqueous emulsion of a highly branched and crosslinked

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polydimethylsiloxane resin" disclosed by Lamb. It is unclear, however, whether the examiner relies on the former or the latter in rejecting the claims before us. Apparently, the examiner believes that Lamb describes the organosilicon compound recited in claim 17. The statement of rejection, however, lacks clarity because the examiner does not state whether reliance is placed on the "silicone polymer" and/or the "hydrophobic cationic aqueous emulsion of a highly branched and crosslinked polydimethylsiloxane resin" disclosed by Lamb.

If the examiner relies on Lamb's "silicone polymer" to fully meet the claimed subject matter, we believe that such reliance is misplaced. The general term "silicone polymer" lacks the requisite specificity to support a rejection under 35 USC § 102 of claims 17 and 19 through 26, which recite specific organosilicon compounds depicted by structural formula.

It is apparent from the appeal Brief that applicants assume the examiner relies on Lamb's "hydrophobic cationic aqueous emulsion of a highly branched and crosslinked silicone polymer" in rejecting the claims on appeal. That emulsion is described at column 2, lines 35 through 60 of Lamb, note particularly the formula illustrated at column 2, line 41. However, the examiner has not established, as a factual matter, that Lamb's

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organosiloxane (column 2, line 41) is identical to any of the organosilicon compounds illustrated by structural formula in claim 17. The examiner asserts that (1) both Lamb and applicants use "the same organosilicon compounds", and (2) "[t]here is no structural difference" between the organosilicon compounds recited in claim 17 and those disclosed by Lamb. See the Examiner's Answer, page 3, last paragraph. Those assertions, however, amount to examples of ipse dixit reasoning. Simply stated, the examiner does not explain how she has determined that Lamb and applicants use "the same organosilicon compounds" or that "[t]here is no structural difference" between these compounds. Nor does she provide any analysis, scientific reasoning, or evidence to support that determination.

The examiner's rejection under 35 USC § 102(e) is reversed.⁴

REVERSED

⁴ The examiner previously entered a rejection of applicants' claims under 35 USC § 112, second paragraph, as indefinite. See Paper No. 6 mailed August 11, 1992. That rejection has been withdrawn. However, on return of this application to the examining corps, the examiner may wish to revisit that rejection in light of the third and fourth organosilicon compounds illustrated by structural formula in claim 17. Specifically, see the appendix to the appeal Brief, claim 17, lines 10 through 16. On its face, it appears that those structural formulas are incorrect because, as drawn, the oxygen atoms do not have an appropriate site for bonding. As stated by the examiner in Paper No. 6, "what are the oxygen atoms bonded to"? In this regard, note particularly that variables x, y, and z are integers.

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