

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-PIERRE ARRAUDEAU, JEANNE PATRAUD and BERTRAND
PIOT

Appeal No. 95-3562
Application No. 08/110,996¹

HEARD: January 13, 1999

Before METZ, JOHN D. SMITH and PAK, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 16 through 25.

The subject matter on appeal relates to a waterproof composition for covering eyelashes (mascara) composed of a wax component, a thickening agent, a volatile organic solvent, and

¹ Application for patent filed August 24, 1993.

Appeal No. 95-3562
Application No. 08/110,996

at least one water-soluble film-forming agent present in an aqueous solution. Although the composition does not contain an emulsifying agent, it is nevertheless stable. See the specification, page 1, lines 17-25. Thus, the present invention is said to be based on the discovery that when an aqueous solution of a water-soluble film-forming polymer is introduced into an anhydrous waterproof mascara composition, it is possible to exclude emulsifying agents, which had been required by the prior art when introducing aqueous solutions into a hydrophobic medium. Claim 16 is representative and is reproduced below:

16. A waterproof composition for covering the eyelashes consisting essentially of from 2 to 40 percent by weight, based on the total weight of said composition, of at least one wax, from 5 to 15 percent by weight, based on the total weight of said composition, of at least one thickening agent, from 35 to 50 percent by weight, based on the total weight of said composition, of at least one volatile organic solvent and from 1 to 35 percent by weight of based on the total weight of said composition of an aqueous solution of at least one water-soluble film-forming agent present in an aqueous solution in an amount between approximately 0.1 to 55 percent, said composition not containing an emulsifying agent.

The references of record relied upon by the examiner are:

Arraudeau (Great Britain) 2,216,797
Oct. 18, 1989

Appeal No. 95-3562
Application No. 08/110,996

Remington's Pharmaceutical Sciences, page unnumbered,
(publication date not provided)

A reference of record relied upon by appellants is:

Hawley's Condensed Chemical Dictionary, Eleventh Edition,
Van Nostrand Reinhold Company, page 973, copyright 1987.

Appeal No. 95-3562
Application No. 08/110,996

The appealed claims stand rejected for obviousness (35 U.S.C. § 103) over Arraudeau.

We cannot sustain the rejection.

The relied upon reference by the examiner, Arraudeau, discloses mascaras of anhydrous, suspension and emulsion types. See page 6, lines 12 through 16 of the reference. The examiner has focused on working example 1 of this reference as evidence suggesting the claimed composition herein. Although this example describes a composition substantially corresponding to that claimed by appellants, the water soluble film forming agent in this example (a hydrolyzed keratin) is provided in the form of a solution containing, inter alia, propylene glycol. See the last paragraph of page 11 of Arraudeau. Appellants argue that the propylene glycol included in Arraudeau's keratin hydrolysate is an emulsifying agent and appellants have provided Hawley's Condensed Chemical Dictionary as evidence that propylene glycol is a known emulsifier.

On the other hand, the examiner contends that the propylene glycol component used in Arraudeau's examples functions as a cosolvent or a humectant. To support the

Appeal No. 95-3562
Application No. 08/110,996

examiner's assertions, the examiner has cited Remington's Pharmaceutical Sciences which indicates that propylene glycol is used as a solvent, preservative and a humectant.

The review of any prior art rejection, whether for anticipation or obviousness, requires first that the claims have been correctly construed to define the scope and meaning the relevant limitations. Gechter v. Davidson, 116 F.3d 1454, 1457 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). As argued by counsel for appellants at the oral hearing, the claims on appeal herein expressly and literally exclude the presence of an emulsifying agent by virtue of the claimed language "said composition not containing an emulsifying agent." See the last line of appealed claim 16. Thus, whether or not the propylene glycol added in the prior art composition functions as an emulsifying agent, this compound is excluded by the claim language "not containing an emulsifying agent." Accordingly, we cannot sustain the stated rejection of the appealed claims for obviousness.

We further note that the examiner has made no argument that it would have been obvious to a person of ordinary skill in this art to have omitted the propylene glycol component

Appeal No. 95-3562
Application No. 08/110,996

from the composition described by Arrandea. Moreover, it is also significant that the relied upon prior art reference to Arrandea is assigned to appellants' assignee. Accordingly, some weight must be given to appellants' argument that one skilled in the art would recognize that the propylene glycol actually functions as an emulsifier in the prior art composition.

The decision of the examiner is reversed.

REVERSED

ANDREW H. METZ)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CHUNG K. PAK)	
Administrative Patent Judge)	

Appeal No. 95-3562
Application No. 08/110,996

Nixon & Vanderhye P.C.
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714

JENINE GILLIS

Appeal No. 95-3562

Serial No. 08/110,996

Judge JOHN D. SMITH

Judge PAK

Judge METZ

Received: 1/19/99

Typed: 1/20/99

Rev. 1/20/99

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1616

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

Mailed: Updated Monthly Disk (FOIA): _____

Updated Monthly Report: _____