

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUMASA SATO

Appeal No. 1996-3213
Application 08/031,596

ON BRIEF

Before William F. Smith, Lorin, and Mills, Administrative Patent Judges.

William F. Smith, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 9, all the claims remaining in the application.

Claim 1 is representative of the subject matter on appeal and reads as follows:

A lipcolor composition comprising (a) at least one metal compound selected from the group consisting of salts of divalent and trivalent metals and hydroxides of divalent and trivalent metals, and (b) a water-soluble salt of alginic acid, and wherein the composition further comprises (c) at least

one red or orange lake color with aluminum, barium or zirconium having a COONa or COOK group in its structure and (d) an oil component having appearance of liquid at a temperature of 20 EC.

The reference relied upon by the examiner is:

Japanese Kokai (Sato)¹ 1[1989]-96111 April 14, 1989

Claims 1 through 9 stand rejected under 35 U.S. C. § 103. As evidence of obviousness, the examiner relies upon Sato. We reverse.

Discussion

In relevant part, the lipcolor composition in claim 1 on appeal requires the presence of at least one red or orange lake color with aluminum, barium or zirconium having a COONa or COOK group, i.e., a sodium or potassium salt. Sato describes a lipcolor composition which may broadly contain a "pigment." See page 6, second full paragraph of the translation. In an example of a rouge according to the invention of Sato, pigments described as "red 202" and "yellow 4 aluminum lake" are used. See page 8 of the translation.

At page 3 of the Examiner's Answer, the examiner refers us to paragraph 16 of the Office action mailed February 28, 1994 for a statement of the rejection. Turning to that section of the Office action, we find the examiner's position to be that Sato "does not disclose a red or orange lake, it discloses a yellow lake. It would

¹ Our consideration of this Japanese language document has been based upon an English language translation thereof. A copy of the translation is attached to this opinion.

have been obvious . . . to use any color combination of lakes to achieve a desired lipcolor.”

While the examiner is, no doubt, correct in determining that cosmetics such as lipcolors may be provided in a variety of colors, the difficulty with the examiner's position is that the claims on appeal do not require just any color. Rather, they require specific sodium or potassium salts of red or orange lake colors with aluminum, barium or zirconium. Simply put, Sato does not describe or suggest the specific color compounds required by claim 1 on appeal. A conclusion of obviousness must be based upon the subject of a claim as a whole. 35 U.S.C. § 103(a). Here, the examiner has not focused on the precise subject matter required by claim 1 on appeal. As a result, the examiner has not addressed the key question as to whether the colors required by claim 1 on appeal were in fact available in the prior art. Where as here the examiner's determination of the obviousness is based upon less than the claimed subject matter as a whole, the determination is legally incorrect and must be reversed.

The examiner's rejection is reversed.

Other Issues

We note that appellant admits at page 4, lines 13-22 of the specification that the specific colors required by claim 1 on appeal are known. However, the specification does not indicate that these colors were known to be useful in cosmetic compositions at the time of the present invention.

Upon return of the application, we urge appellant and the examiner to make of record the relevant prior art knowledge concerning these known colors and particularly their uses. Once that knowledge is made of record, appellant and the examiner will be in a position to determine whether that prior art knowledge in combination with Sato or other relevant prior art would have rendered the subject matter as a whole of any claim on appeal obvious to one of ordinary skill in the art.

The decision of the examiner is reversed.

REVERSED

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William F. Smith)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Hubert C. Lorin)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Demetra J. Mills)	
Administrative Patent Judge)	

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