

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. SNYDER and JAMES R. SCHWARTZ

Appeal No. 1998-0654
Application No. 08/522,874

ON BRIEF

Before KIMLIN, WARREN and TIERNEY, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11. Claims 12-15, the other claims remaining in the present application, stand withdrawn from consideration as being directed to a non-elected invention. Claim 1 is illustrative:

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1. Shampoo compositions comprising:
 - (A) from about 0.5% to about 50% by weight of synthetic surfactant;
 - (B) from about 0.05% to about 25% by weight of dispersed water insoluble polymer latex particles having a glass transition temperature of from about -20EC to about 10EC; and
 - (C) water.

The examiner relies upon the following references as evidence of obviousness:

Gerstein	5,391,368	Feb. 21, 1995
Tsaur et al. (Tsaur)	5,441,728	Aug. 15, 1995

Appellants' claimed invention is directed to a water-based shampoo comprising a surfactant and dispersed water insoluble polymer latex particles of the recited glass transition temperature. According to appellants, they "have found that styling shampoos provide improved styling polymer deposition and performance by using dispersed latex styling polymer particles, provided that the styling polymers are dispersed rather than solubilized in the shampoo matrix and provided that they have a selectively low Tg value as described above" (sentence bridging pages 3 and 4 of principal brief).

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Appealed claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tsaur in view of Gerstein.

Upon careful consideration of the opposing arguments presented on appeal, we find that the prior art cited by the examiner fails to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

While Tsaur discloses a composition comprising components within the scope of claim 1, the examiner recognizes that the composition of Tsaur is a hairspray, not a shampoo. To alleviate this deficiency of Tsaur, the examiner relies upon Gerstein which discloses an aqueous-based shampoo which comprises anionic and amphoteric surfactants, a hair styling polymer and a cationic conditioning polymer. Although the examiner appreciates that Gerstein does not disclose appellants' water insoluble polymer latex particles as a hair styling polymer or a conditioning polymer, the examiner concludes that:

It is a matter of ordinary skill in the art to formulate the nonaerosol aqueous composition of Tsaur et al[.] as a shampoo in order to achieve [sic] cleansing and setting of the hair in a single treatment based on the teaching in Gerstein that an

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aqueous composition comprising equivalent anionic surfactants and hair styling polymers yield a shampoo with both cleansing and hair setting characteristics.

See page 4 of Answer, second full paragraph. In a somewhat different approach, the examiner concludes that "[i]t would have been obvious to incorporate the water-insoluble polymer particles of Tsaur et al[.] into the aqueous shampoo of Gerstein to provide a composition with superior hair setting by virtue of the interaction between the hair fixative polymer and water-insoluble polymer particle latex" (page 4 of Answer, last paragraph).

We do not subscribe to the examiner's rationale for the following reasons. First, if it is the examiner's position that Gerstein discloses hair styling polymers that are equivalent to the latex particles of Tsaur, and this is not clear from the Examiner's Answer, the examiner has not established on this record such an equivalency in the shampoo art. In any event, the examiner's conclusion of obviousness is based on what could have been performed by one of ordinary skill in the art rather than on the requisite suggestion in the disclosures of Tsaur and Gerstein. In re Gordon, 733 F.2d

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900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We agree with appellants that neither of the applied references provides any teaching or suggestion of employing dispersed water insoluble polymer latex particles in an aqueous-based shampoo, let alone such latex particles having the claimed glass transition temperature. Consequently, a prima facie case of obviousness has not been made out by the examiner.

This application is remanded to the examiner for the purpose of considering the obviousness of the claimed invention, within the meaning of § 103, in view of the acknowledged prior art set forth in the paragraph bridging pages 1 and 2 of the present specification. In particular, appellants' specification acknowledges that "[t]o minimize the use of these organic solvents, latex polymers rather than dissolved polymers have been employed as a means of incorporating styling polymers into a shampoo composition" (page 1 of specification, lines 26-28). Also, the specification states that "[h]istorically, styling polymers (both latex and dissolved polymers) for use in shampoos have been selected so as to have higher Tg values," and that "[i]t was believed that higher Tg polymers would form stiffer films

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on hair, thus providing improved styling performance"
(sentence bridging pages 1 and 2, and lines 2-3,
respectively). Hence, it is apparent that appellants'
invention resides not in incorporating latex polymer particles
in aqueous-based shampoos but, rather, utilizing latex
particles having a lower Tg than customary. Accordingly, the
examiner should explore the specific Tg values for the latex
particles of the acknowledged prior art, and determine whether
the difference between the latex particles within the scope of
the appealed claims and those of the acknowledged prior art
would have been obvious to one of ordinary skill in the art.
Also, the examiner should consider commonly-assigned U.S.
Patent No. 6,113,890, for obviousness-type double patenting
issues, as well as for the cited prior art.

In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed, and the
application is remanded to the examiner for the reasons set
forth above.

This application, by virtue of its "special" status,
requires immediate action. See the Manual of Patent Examining

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Procedure, § 708.01(D) (7th ed., July 1998). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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MICHAEL TIERNEY)	
Administrative Patent Judge)	

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