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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL DEGEORGE and MARK BENN¹

Appeal 2020-005604
Application 14/243,466
Technology Center 1600

Before DEBORAH KATZ, JOHN G. NEW, and ROBERT A. POLLOCK,
Administrative Patent Judges.

NEW, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as L’OREAL S.A. Appeal Br. 2.

SUMMARY

Appellant files this appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–24, 26–29, and 31 as unpatentable under 35 U.S.C. § 103 as being obvious over Legrand (US 6,444,197 B2, September 3, 2002) (“Legrand”) and Caskey (US 5,575,989, November 19, 1996) (“Caskey”).²

We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

NATURE OF THE CLAIMED INVENTION

Appellant's claimed invention is directed to powder compositions containing an alkaline material comprising hydroxide-containing compounds, a starch, a silica material, a liquid fatty substance, an acrylic polymer, a wax, and a chelant compound. Abstr. The powder may be mixed with water to form a ready-to-use composition for relaxing or straightening hair. *Id.*

REPRESENTATIVE CLAIM

Independent claim 1 is representative of independent claims 28, 29, and 31, and recites:

1. A powder composition comprising:
 - (a) from about 1% to about 30% by weight of at least one hydroxide-containing compound selected from the group consisting of alkali metal hydroxides, alkaline earth metal

² The Examiner withdrew the rejection of claims 21–24, 26, and 27 as indefinite under 35 U.S.C. § 112(b). Ans. 3.

hydroxides, transition metal hydroxides, and mixtures thereof;

(b) from about 1% to about 25% by weight of at least one starch;

(c) from about 0.1 % to about 20% by weight of at least one silica material;

(d) from about 5% to about 50% by weight of at least one liquid fatty substance;

(e) from about 0.5% to about 15% by weight of at least one acrylic polymer;

(f) from about 0.5% to about 20% by weight of at least one wax;
and

(g) from about 0.5% to about 5% by weight of at least one chelant compound;

all weights above being based on the total weight of the powder composition.

App. Br. 21.

ISSUES AND ANALYSIS

We decline to adopt the Examiner's findings, reasoning, and conclusion that the claims on appeal are *prima facie* obvious over the combined cited prior art. We address the arguments raised by Appellant below.

1. Rejection of claims 1, 28, 29, and 31 over Legrand and Caskey

Issue

Appellant argues that the Examiner erred by failing to identify a reason to pick out and combine the instantly claimed compounds, as claimed in a single composition. App. Br. 16.

Analysis

The Examiner finds that Legrand teaches a ready-to-use hair-treating powder composition. *See* Final Act. 5–6. The Examiner finds that Legrand teaches the powder composition may include a polyurethane polyether combined with maltodextrin, i.e., a starch. *Id.* at 6 (citing Legrand col. 2, ll. 50–55; col. 22, ll. 26–45 (Example 1)); *see also* Ans. 4 (citing col. 23, ll. 16–31, 51–61 (claims 1, 8–11)). The Examiner finds that in a specific example, the polyurethane polyether may include Aculyn 46, containing 4% maltodextrin. *Id.* The Examiner finds that Legrand teaches the composition further includes 1% by weight of ethylenediaminetetraacetic acid (“EDTA”), i.e., a chelating agent. *Id.* at 7 (citing Legrand col. 22, ll. 30–50 (Example 1)); *see also* Ans. 5.

The Examiner also finds that Legrand teaches various additives for the powder composition. Ans. 4–5. For example, Legrand teaches 0.05% to 30% by weight alkali metal hydroxide, e.g., sodium hydroxide and potassium hydroxide. *Id.* at 4 (citing Legrand, col. 20, ll. 58–67; col. 26, ll. 1–11 (claims 44, 45)). The Examiner finds that Legrand teaches at least one additive present in an amount ranging from 0% to 30% by weight of the composition, the additive including silica, oils, and waxes. *Id.* at 5 (citing Legrand, col. 21, ll. 20–26, 46–48, 52; col. 26, ll. 39–55 (claims 49–51)). Finally, the Examiner finds that Legrand teaches 0.05% to 10% by weight

crosslinked acrylic acid polymer used as a thickener. *Id.* at 5 (citing Legrand col. 20, ll. 39–41, 46, 54–56).

With respect to the reason to combine Legrand’s various components, the Examiner reasons that Legrand teaches “that a person skilled in the art would take care to select the optional additional compound(s) mentioned above such that the advantageous properties intrinsically associated with the composition usage are not, or at least are not substantially, adversely affected by the addition(s) envisaged.” Ans. 5. The Examiner finds that the additional ingredients were all commonly known in the relevant art and would have been selected based on their known use and functions. *Id.* at 6.

The Examiner concludes that:

LEGRAND provides clear suggestion and direction to a person of ordinary skilled in the art why the claimed components (a), (b), (c), (d), (e) and (g) are suitable additives and how they can be selected for use in treating human hair. Therefore, it would have been prima facie obvious to a person of ordinary skilled in the art at the time the invention was made to combine LEGRAND with CASEY to arrive at the present invention.

Id.

Appellant argues that “Legrand, the primary reference[], does not require any of the seven claimed components (a), (b), (c), (d), (e), (f), and (g). Therefore, deriving what is claimed requires simultaneously selecting all seven of the instantly claimed components from long lists of optional ingredients.” App. Br. 15 (emphases omitted). Appellant contends that the Examiner is “working backwards using applicants’ disclosure as a guide” to select the various components of Legrand’s teachings. *Id.* at 16. Appellant highlights the Examiner’s reliance on Legrand’s teaching of “maltodextrin, which is included as an additive (4%) in Aculyn 46®, a commercial

polyurethane.” *Id.* at 15. Appellant contends that “maltodextrin is circumstantially present in the [cited] commercial product.” *Id.* at 16. Appellant contends that “[a]rbitrarily picking out and relying upon a circumstantial additive is quintessential evidence of hindsight,” and as such, the rejection should be reversed.

We agree with Appellant that the Examiner failed to establish a *prima facie* case of obviousness over Legrand and Caskey. The Examiner identified that the cited art teaches the separate components of the claimed powder composition. However, as explained by the Supreme Court, “[i]nventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Accordingly, “it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.” *Id.*

We find that the Examiner has failed to identify a reason that would have prompted a person of ordinary skill in the art to combine the claimed components as the new invention does. For example, the Examiner has not identified which “optional additional compounds” would not adversely affect the “advantageous properties intrinsically associated” with Legrand’s composition. *See* Ans. 5. Notably, Legrand teaches a wide range of optional additional components that may be used in the composition, and the Examiner has not identified a reason to select and combine these independently listed components, absent Appellant’s disclosure. Likewise, the Examiner’s reliance on the known uses and functions of Legrand’s optional additional compounds does not provide a reason for forming the claimed combination. *See id.* at 6. “[R]ejections on obviousness grounds

cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418.

Without a reason to combine the claimed components apart from their known uses, the Examiner’s reasoning relies on “hindsight reconstruction to pick and choose among isolated disclosures in the prior art.” *Ecolochem, Inc. v. S. California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) (holding that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight”). *Id.* at 1371–1372. Because the Examiner failed articulate a reason to combine an alkaline metal hydroxide, a starch, silica, a liquid fatty substance, an acrylic polymer, wax, and a chelant compound in the amounts recited in claim 1, we do not sustain the Examiner’s rejection of the claims. And because this issue is dispositive of the Examiner’s rejection of the claims 1, 28, 29, and 31 upon this ground, we do not reach Appellant’s additional arguments.

2. Claims 2–24, 26 and 27

Dependent claims 2–24, 26, and 27 all depend, directly or indirectly, from independent claim 1. Because we reverse the Examiner’s rejection of claim 1, we similarly, and for the same reasons, reverse the Examiner’s rejection of claims 2–24, 26, and 27.

CONCLUSION

The Examiner’s rejection of claims 1–24, 26–29, and 31 under 35 U.S.C. § 103 is reversed.

REVERSED

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–24, 26– 29, 31	103	Legrand, Caskey		1–24, 26– 29, 31