

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEMI NAE

Appeal No. 95-4743
Application No. 08/066,773¹

HEARD: May 5, 1999

Before CAROFF, METZ, and HANLON, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of claims 1-12, all the claims pending in the involved application.

¹ Application for patent filed May 7, 1993.

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The claims on appeal are directed to an organophilic clay thickener (claim 1-9), a process for preparing the thickener (claim 10), and a non-aqueous fluid system containing both the thickener and a naturally occurring oil (claims 11-12).

Appellant acknowledges on page 3 of the Brief that all of the claims stand or fall together for purposes of this appeal. Accordingly, we will limit our consideration to claim 1 which reads as follows:

1. An organophilic clay thickener for naturally occurring oil systems selected from the group consisting of corn oil, coconut oil, soybean oil, cottonseed oil, castor oil, linseed oil, safflower oil, palm oil, peanut oil and tung oil comprising the reaction product of:

(a) a smectite-type clay: and

(b) an organic cation derived from a naturally occurring oil residue substantially similar to the naturally occurring oil to be thickened in an amount of from about 75% to about 150% of the cation exchange capacity of the smectite-type clay.

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

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| Finlayson et al (Finlayson) | 4,412,018 | Oct. 25, 1983 |
| Magauran et al (Magauran) | 4,664,820 | May 12, 1987 |

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The following rejections under 35 USC § 103 are before us for consideration:²

I. Claims 1-12 stand rejected for obviousness in view of Finlayson.

II. Claims 1-5 and 8-12 stand rejected for obviousness in view of Maguaran.

III. Claims 6-7 stand rejected for obviousness in view of Maguaran taken in combination with Finlayson.

We have carefully considered the entire record in light of the respective positions outlined in appellant's Brief and the examiner's Answer. In doing so, we conclude that, as to each rejection, the examiner has established a prima facie case of obviousness which has not been vitiated by evidence relied upon by appellant. Accordingly, we shall affirm each of the rejections before us.

In essence, we agree with the examiner that Finlayson and Maguaran individually embrace organophilic clay thickeners or gellants within the scope of the appealed claims as explained

² By Advisory Action (Paper No. 8), the examiner has indicated that appellant has overcome a previously applied rejection under 35 USC § 112, first paragraph, which, therefore, is not before us for consideration on appeal.

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in the examiner's Answer. As noted by the examiner, the claim expression "organic cation derived from a naturally occurring oil residue substantially similar to the naturally occurring oil to be thickened", to the extent it may be considered meaningful at all, broadly encompasses tallow derivatives or derivatives of any other of the several naturally occurring oils disclosed in Finlayson (column 2, line 56 - column 3, line 13) and Maguaran (column 5, lines 16-37). With regard to claim 1, we also note that the recitation of certain base oil systems in the claim preamble, as a statement of intended use, does not represent a significant limitation on the scope of the composition claim.

We also agree with the examiner that the evidence of nonobviousness relied upon by appellant (specification: page 13, Table 1; Nae Declaration)³ is unpersuasive essentially for the reasons set forth in the examiner's Answer.

³ We also note that the Nae Declaration is informal in that it has not been properly executed in accordance with 37 CFR § 1.68.

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Since we are in substantial accord with the examiner's reasoning, set forth in his Answer, we incorporate that reasoning by reference herein to avoid unnecessary repetition.

Rejection Under 37 CFR 1.196(b)

In accordance with the provisions of 37 CFR 1.196(b), we hereby apply the following new grounds of rejection:

Claims 1-12 are rejected under 35 USC 112, paragraph 2, as being indefinite or, alternatively, under 35 USC 112, paragraph 1, as being based on a nonenabling disclosure.

With regard to indefiniteness, the term "substantially similar" or "similar", recited in independent claims 1, 10 and 11, does not define any meaningful relationship between the recited oil residue and the base oil to be thickened with a reasonable degree of precision and particularity. Specifically, the term in question does not serve to describe in what way, or to what extent, the oil residue is "similar" to the base oil. Appellant's specification is of little assistance in this regard. To wit, the specification does not define the intended metes and bounds of the word "similar" with any degree of particularity. The concept of "similarity" apparently being at the heart of appellant's invention, it is

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particularly critical that the concept be defined and claimed with a reasonable degree of precision.

We note in passing that an inkling of what appellant intends by the word "similar" first appears on page 2, numbered paragraph 5, of the Nae Declaration where similarity is defined in terms of three criteria indicating that "similar" oils are:

...a) all vegetable oils, b) have similar high linoleic acid components and c) have similar low palmitic acid components... (underlining added for emphasis)

Even this definition, had it been included in appellant's original disclosure, appears inadequate in that two of the three criteria likewise depend on the word "similar", which remains undefined.

With regard to nonenablement, we note that appellant's specification is devoid of even one example of an oil residue "similar" to a base oil for purposes of the invention other than where a cation is derived from an oil which is the same as the base oil to be thickened. While the lack of a single example is not necessarily dispositive with regard to nonenablement, in our view the practically unlimited breadth

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of the phrase "substantially similar" in the instant claim, coupled with lack of guidance in the specification as to what constitutes a "similar" pair of oils, gives rise to a prima facie case of nonenablement.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR

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§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter considered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeal and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final

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action on the affirmed rejection, including any timely request
for rehearing thereof.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED/ 37 CFR § 1.196(b)

MARC L. CAROFF)

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| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| ANDREW H. METZ |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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APJ HANLON

DECISION: AFFIRMED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: November 16, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT