

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANDREW G. PAPAY

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Appeal No. 96-0306  
Application 07/709,369<sup>1</sup>

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ON BRIEF

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Before GARRIS, PAK, and WARREN, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1  
through 25 and 33 through 48.<sup>2</sup> The only other claims in the

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<sup>1</sup> Application for patent filed June 3, 1991.

<sup>2</sup> We observe that the claim amendment filed subsequent to  
the final rejection on August 22, 1994 (Paper No. 13) has not  
been clerically entered notwithstanding the examiner's  
authorization thereof in the advisory action mailed August 26,  
1994 (Paper No. 14).

Appeal No. 96-0306  
Application No. 07/709,369

application, which are claims 26 through 32, stand withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a composition for use in an automatic transmission fluid or a fluid for a wet brake system or a friction-depending lubricant which comprises at least one polyol selected from a specified grouping for increasing dynamic and/or static coefficients of friction. The appealed subject matter also relates to a method of increasing dynamic coefficient of friction in the aforementioned environments via the use of such polyols. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. In an oil-based functional fluid composition formulated for use as an automatic transmission fluid or a fluid for a wet brake system, the improvement pursuant to which said composition contains a minor amount in the range of up to about 0.5 percent by weight based on the total weight of the functional fluid composition of at least one polyol selected from the group consisting of ethylene glycol, 1,3-propylene glycol, 1,4-butylene glycol, trimethylolpropane, pentaerythritol, 2-butene-1,4-diol, cyclohexanedimethanol, and 1,2-alkanediols having from 3 to 6 carbon atoms in the molecule to increase the dynamic and/or static coefficients of friction of the frictional surfaces of the automatic transmission or wet brake system contacted by the composition.

The references relied upon by the examiner as evidence of obviousness are:

Jordan et al. (Jordan)	2,932,615	Apr. 12, 1960
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Appeal No. 96-0306  
Application No. 07/709,369

White et al. (White)	3,304,258	Feb. 14, 1967
Papay et al. (Papay)	4,857,214	Aug. 15, 1989

Claims 1 through 8, 16 through 18, 22 through 25, 33 through 37 and 42 through 47 are rejected under 35 U.S.C. § 103 as being unpatentable over White, and claims 9 through 15, 19 through 21, 38 through 41 and 48 are similarly rejected as being unpatentable over White in view of Papay.

Claims 1 through 8, 16 through 18 and 22 through 25 are rejected under 35 U.S.C. § 103 as being unpatentable over Jordan, and claims 9 through 15, 19 through 21 and 48 are similarly rejected as being unpatentable over Jordan in view of Papay.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejections.

#### OPINION

For the reasons set forth below, we cannot sustain any of the rejections before us on this appeal.

The primary references to White and Jordan contain no teaching or suggestion of compositions or the corresponding methods relating to environments such as an automatic transmission fluid or a fluid for a wet brake system as claimed

Appeal No. 96-0306  
Application No. 07/709,369

by the appellant. Rather, White's composition and method relate to lubricants for use in drawing sheet metal, and Jordan's composition and method relate to industrial or automotive gear lubrication. Similarly, White and Jordan contain no teachings or suggestions of employing polyols for increasing dynamic and/or static coefficients of friction in accordance with the appealed claims. Instead, the polyols of White are used for controlling viscosity and soap-solubility whereas those of Jordan are for increasing extreme pressure properties.

In this regard, the examiner argues that the appealed claim recitation concerning "[t]he use as an automatic transmission fluid, wet brake fluid, or friction-dependent lubricant is merely intended use and is not a positive limitation of the claims" (answer, page 5). We cannot agree. As correctly indicated by the appellant, the claim recitation is not "merely intended use" but instead is a limitation which further defines the compositions in question. In order to carry his burden, the examiner would have to show that the metal-drawing lubricants of White and the extreme pressure lubricants of Jordan are at least capable of being used as an automatic transmission fluid or a wet brake fluid or a friction-dependent lubricant, and this the examiner has not done. Thus, the mere fact that the primary reference compositions include a polyol like the here claimed

Appeal No. 96-0306  
Application No. 07/709,369

compositions, albeit for a different purpose, is inadequate to establish a prima facie case of obviousness.

In short, the primary references to White and Jordan do not teach and would not have suggested compositions and methods of the type here claimed which relate to an automatic transmission fluid or a wet brake fluid or a friction-dependent lubricant and which employs certain polyols in certain amounts in order to increase dynamic and/or static coefficients of friction. Moreover, these deficiencies of White and Jordan are not remedied by the disclosure of Papay. It follows that we cannot sustain any of the above noted § 103 rejections advanced by the examiner on this appeal.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris	)	
Administrative Patent Judge	)	
	)	
	)	
Chung K. Pak	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Charles F. Warren	)	
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Application No. 07/709,369

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Appeal No. 96-0306  
Application No. 07/709,369