

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(2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. TRIVETT

Appeal No. 96-1126
Application 08/132,080¹

ON BRIEF

Before WARREN, LIEBERMAN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 7.²

We have carefully considered the record before us, and based thereon, we will not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103 over Abrams.³ As pointed out by appellant (brief, pages 3-4), the starting materials used in the process of Abrams will *not*

¹ Application for patent filed October 5, 1993.

² Specification, pages 40-41.

³ Examiner's answer, pages 2-3.

produce either of the two fatty acid amide species specified in appealed claim 1. The examiner has not advanced on this record any evidence or scientific reason explaining why one of ordinary skill in this art would have been motivated to modify the processes of Abrams by the use of different steps or starting materials to obtain either of the two specified species or otherwise use such species in the compositions of the reference with the reasonable expectation of preparing an aqueous base lubricant composition. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988); *see also In re Brouwer*, 77 F.3d 422, 426, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 254-55 (CCPA 1979). Accordingly, it is inescapable that the only direction to appellants' claimed invention as a whole on the record before us is supplied by appellant's own specification. *See Vaeck, supra*.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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)	
PAUL LIEBERMAN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

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Application 08/132,080

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