

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK L. KARN, JODY A. KOCSIS,
LAURENCE E. KING,
PAUL E. ADAMS, and VINCENT A. NOTARO

Appeal No. 1998-1664
Application No. 08/323,982

ON BRIEF

Before PAK, KRATZ, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, 51 through 62,

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75 through 77, 81 through 83, 101, and 102. These are the only claims remaining in the application.¹

The subject matter on appeal relates to an overbased metal salt of an acidic material which is useful as a lubricant additive. (Appeal brief, page 2.) Further details of this appealed subject matter are recited in representative claims 1, 23, and 28 reproduced below:

1. An overbased metal salt of an acidic material selected from the group consisting of
 - (a) hydrocarbyl-substituted carboxyalkylene-linked phenols,
 - (b) dihydrocarbyl esters of alkylene dicarboxylic acids, the alkylene group being substituted with a hydroxy group and an additional carboxylic acid group, and
 - (c) alkylene-linked polyaromatic molecules, the aromatic moieties whereof comprise at least one hydrocarbyl-substituted phenol and at least one carboxy phenol;the hydrocarbyl group or groups of said acidic material being of sufficient length to provide oil solubility to the salt;
wherein the overbased metal salt has a metal ratio of at least 1.3.

¹ Subsequent to the final Office action of January 6, 1997, the appellants filed an amendment under 37 CFR § 1.116 (1981) on March 24, 1997, proposing the cancellation of non-elected claims 9 through 18, 22, 24 through 27, 34 through 43, 48 through 50, 63 through 74, 78 through 80, and 84 through 100. According to the examiner, this amendment has been entered. (Examiner's answer, page 2.)

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23. The overbased metal salt of claim 1 wherein the metal ratio is at least about 1.5.

28. A lubricant comprising:

(a) an oil of lubricating viscosity, and
(b) an overbased metal salt of an acidic material selected from the group consisting of
(i) hydrocarbyl-substituted carboxyalkylene-linked phenols,

(ii) dihydrocarbyl esters of alkylene dicarboxylic acids, the alkylene group being substituted with a hydroxy group and an additional carboxylic acid group, and

(iii) alkylene-linked polyaromatic molecules, the aromatic moieties whereof comprise at least one hydrocarbyl-substituted phenol and at least one carboxy phenol;

the hydrocarbyl group or groups of said acidic material being of sufficient length to provide oil solubility to the salt;

wherein the overbased metal salt has a metal ratio of at least 1.3.

As evidence of unpatentability, the examiner relies upon the following prior art references:

Adams et al. (Adams) 1994	5,281,346	Jan. 25,
	(filing date Apr. 16,	
1992)		
Blystone et al. (Blystone) 1994	5,356,546	Oct. 18,
	(filing date Apr. 16,	
1992)		

The following grounds of rejection are presented for our review in this appeal:

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I. Claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, and 51 through 56 stand rejected under 35 U.S.C.

§ 102(g) as anticipated by Adams (examiner's answer, page 3);

II. Claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 83, 101, and 102 stand rejected under 35 U.S.C. § 102(g) as anticipated by Blystone (id.);

III. Claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 83, 101, and 102 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 80 of U.S. Patent 5,281,346 (Adams) (id. at page 4); and

IV. Claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 83, 101, and 102 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 69 of U.S. Patent 5,356,546 (Blystone) (id. at pages 4-5).

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We reverse rejections I and II under 35 U.S.C. § 102(g).
With respect to rejections III and IV above, we remand for
further proceedings not inconsistent with our opinion below.

Rejections I and II

"To anticipate a claim, a prior art reference must
disclose every limitation of the claimed invention, either
explicitly or inherently." In re Schreiber, 128 F.3d 1473,
1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); accord Glaxo Inc.
v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567
(Fed. Cir. 1995). Here, we determine that the relied upon
prior art references do not disclose every limitation of the
claimed invention, either explicitly or inherently.

According to the examiner, "the relied on subject matter
of the disclosure of Blystone and Adams are substantially the
same." (Examiner's answer, page 5.) Specifically, the
examiner states:

Adams et al, U.S. Patent 5,281,346, disclose
lubricant compositions comprising the instantly
claimed metal salts of formula (II) (column 2, line
17 to
column 3, line 15). The salts may contain an excess
of metal, i.e. overbased salts (column 13, lines 32-
39) . . .

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Blystone et al, U.S. Patent 5,356,546, disclose lubricant compositions comprising the instantly claimed metal salts of formula (II) (column 2, line 58 to column 3, line 56). The salts may contain an excess of metal, i.e. overbased slats (column 14, lines 9-16). Compositions for lubricating marine diesel engines are taught in column 23, lines 39-49). [Id. at pp. 3-4.]

Regarding the limitation "wherein the overbased metal salt has a metal ratio of at least 1.3," as recited in independent claims 1 and 28 on appeal, the examiner alleges as follows:

Adams teach salts which may be "slightly basic", containing "preferably, not more than 25% excess metal, more preferably no more than 15% and even more preferably, no more than 5% excess metal". See Adams, column 13, lines 36-39. While Adams teaches that the composition "preferably" does not contain more than 25% excess metal, the reference is not limited to the preferred embodiments. Thus Adams [sic] broadest teaching of an overbased composition is the disclosure of a composition which may be "slightly basic". A "preferred", and more limited composition is one that contains "not more than 25% excess metal", i.e., having a metal ratio of 1.25. A "more preferred", and further limited composition is one that contains "not more than 15% excess metal", i.e., having a metal ratio of 1.15. The "more preferred" composition thus contains 10% less excess metal than does the "preferred" composition. A "still more preferred", and further limited composition is one containing "not more than 5% excess metal", i.e., having a metal ratio of 1.05. The "still more preferred" composition thus contains 10% less excess metal than does the "more preferred" composition. It is clear from the above that a "slightly basic" composition would contain at least 10% more excess metal than the "preferred"

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composition, i.e., would have a metal ratio of at least 1.35. Accordingly, appellants' claims are not distinguished from the prior art based on the amount of excess metal. [Underscoring added; *id.* at pp. 5-6.]

The examiner's position is untenable. As pointed out by the appellants (appeal brief, page 6; reply brief, pages 1-2), neither Adams nor Blystone describes an overbased metal salt having a metal ratio of 1.3 as recited in claims 1 and 28 on appeal. The examiner apparently relies on what he perceives to be a trend in Adams's or Blystone's preferred, "more" preferred, and "even more" preferred excess metal amounts to speculate on the meaning of "slightly basic" as used in these references. However, the examiner's reasoning relies heavily on unwarranted assumptions rather than factual evidence.

Under these circumstances, we reverse the examiner's rejections under 35 U.S.C. § 102(g) of (i) appealed claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, and 51 through 56 as anticipated by Adams and (ii) appealed claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 83, 101, and 102 as anticipated by Blystone.

Rejections III and IV

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As indicated above, appealed claims 1 through 8, 19 through 21, 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 83, 101, and 102 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 80 of the Adams patent.

Separately, the same appealed claims stand rejected under the same legal basis as unpatentable over claims 1 through 69 of the Blystone patent.

The examiner's position is stated as follows:

Although the conflicting claims [i.e., the claims of the Adams '346 patent and the claims on appeal] are not identical, they are not patentably distinct from each other because while not of the same scope, the instantly claimed overbased salts and compositions containing said salts are encompassed by the claims of the '346 patent. . . .

Although the conflicting claims [i.e., the claims of the Blystone '546 patent and the appealed claims] are not identical, they are not patentably distinct from each other because while not of the same scope, the instantly claimed overbased salts and compositions containing said salts are encompassed by the claims of the '546 patent. [Underscoring added; examiner's answer, pp. 4-5.]

Conspicuously absent in the examiner's analysis, however, is an explanation as to why one of ordinary skill in the art would have found it prima facie obvious, given the teachings

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of solely the patented claims, to make overbased metal salts having the metal ratios as recited in claim 1 on appeal and separately argued claim 28. In re Longi, 759 F.2d 887, 892 n.4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985) (“[A] double patenting of the obviousness type rejection is ‘analogous to [a failure to meet] the non-obviousness requirement of 35 U.S.C. §103,’ except that the patent principally underlying the double patenting rejection is not considered prior art.”).

In particular, the mere fact that the appellants’ claimed salts may be “encompassed by” the claims of the Adams or Blystone patent does not necessarily establish that the subject matter of the appealed claims would have been prima facie obvious to one of ordinary skill in the art over the subject matter of the patented claims. In this regard, we also point out that the specification of the Adams or Blystone patent cannot be used as if it were prior art. In re Kaplan, 789 F.2d 1574, 1579, 229 USPQ 678, 682 (Fed. Cir. 1986) (“In considering the question [of obviousness in a double patenting context], the patent disclosure may not be used as prior art. [Citation omitted.]”).

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On remand, the examiner should determine whether one of ordinary skill in the art would have found it obvious, given the subject matter of the patented claims only, to arrive at the subject matter of appealed claims 1 and 23. If so, the examiner should explain the reasons in support of a conclusion of obviousness.

Other Issues

1. If the examiner determines that the obviousness-type double patenting rejections should be maintained, the following should be considered.

At pages 2 through 3 of the Office action of January 29, 1996 (paper 10), the examiner rejected (i) claims 1 through 8, 19 through 23, 28 through 35, 44 through 47, and 51 through 56 under 35 U.S.C. § 102(e) as anticipated by Adams and (ii) claims 1 through 8, 19 through 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 89, 101, and 102 under 35 U.S.C. § 102(e) as anticipated by Blystone. Further, the examiner rejected claims 1 through 8, 19 through 23, 28 through 33, 44 through 47, 51 through 62, 75 through 77, 81 through 89, 101, and 102 under the judicially created doctrine

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of obviousness-type double patenting over (i) claims 1 through 80 of Adams and (ii) claims 1 through 69 of Blystone. (Pages 3-4.)

Notwithstanding these obviousness-type double patenting rejections, which have been maintained, the examiner withdrew the §102(e) rejections upon the appellants' submission of a declaration under 37 CFR § 1.131 (1995). But if the obviousness-type double patenting rejections are to be maintained here, a declaration under 37 CFR § 1.131 would be ineffective to antedate Adams and Blystone as prior art references available under

§ 102(e). Specifically, 37 CFR § 1.131(a)(1) (1995) states:

When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another which is prior art under 35 U.S.C. 102(a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in 37 CFR 1.601(n),² or on reference to a foreign patent

² 37 CFR § 1.601(n) (1995) reads in part:

Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

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or to a printed publication, the inventor of the subject of the rejected claim, the owner of the patent under reexamination, or the party qualified under 37 CFR 1.42, 1.43 or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. . . [Underscoring added.]

Hence, a declaration under 37 CFR § 1.131 cannot be used to antedate a U.S. patent which is available as prior art under § 102(e) and which claims the "same patentable invention." In re Zletz, 893 F.2d 319, 323, 13 USPQ2d 1320, 1323 (Fed. Cir. 1989) ("[W]hen the subject matter sought to be antedated is claimed in the reference patent, Rule 131 is not available and an interference must be had to determine priority.").

If the examiner determines that the claims of the Adams or Blystone patent and the appealed claims recite the "same patentable invention," Adams or Blystone would still be available as prior art under 35 U.S.C. § 102(e). It would then follow that Adams and Blystone, unlike prior art which is available only under 35 U.S.C. § 102(g),³ can be used in rejections under 35 U.S.C. § 103.

2. The appellants have argued claim 23 separately from the other appealed claims. (Appeal brief, pages 5 and 8).

³ 35 U.S.C. § 103(c) (1999).

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The examiner, however, has not addressed the appellants' argument with respect to appealed claim 23. On remand, the examiner should do so.

3. In the answer at page 2, the examiner states:

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: In the final rejection mail[ed] January 6, 1997, claims 47 and 77 are rejected under the second paragraph of 35 USC § 112. This rejection should have been under the fourth paragraph of 35 USC § 112. Appellants' Brief does not identify this rejection as an issue on appeal or present any arguments directed thereto. Accordingly, the rejection of claims 47 and 77 under the second paragraph of 35 USC § 112 is expressly withdrawn.

This statement cannot be understood. Specifically, we are unclear whether the examiner has withdrawn the rejection because (1) it is considered to lack merit or (2) the appellants have not contested it. On remand, the examiner should clarify the record. Also, if a rejection under 35 U.S.C. § 112, fourth paragraph, is warranted, it should be made.

In summary, we reverse rejections I and II above. With respect to rejections III and IV, we remand the application to the examiner for the reasons stated above. Also, we remand this

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application for additional reasons as outlined under "Other
Issues" supra.

This application, by virtue of its "special" status,
requires an immediate action. See MPEP § 708.01(D) (7th ed.,
Rev. 1, Feb. 2000).

REVERSED AND REMANDED

CHUNG K. PAK)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

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