

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MORIKUNI NAKAZATO, JIRO MAGARIFUCHI,
AKIHIRO MOCHIZUKI and HIROSHI TANABE

Appeal No. 96-2888
Application No. 08/222,495¹

ON BRIEF

Before JOHN D. SMITH, GARRIS and SPIEGEL, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 3, 4 and 8 through 10 which are all of the claims remaining in the application.

¹ Application for patent filed April 4, 1994. According to appellants, this application is a continuation of Application No. 07/927,906 filed August 10, 1992.

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The subject matter on appeal relates to a low phosphorous lubricating oil composition for internal combustion engines which comprises a wear inhibiting and corrosion inhibiting effective amount of a secondary zinc dialkyldithiophosphate and a thiocarbamate antiwear agent selected from a group of compounds having a particular formula. The composition has a phosphorous content of about from 0.03 to 0.09 wt.%, and the phosphorous content is attributable to the phosphorous content of said zinc dialkyldithiophosphate. A copy of the appealed claims including representative independent claim 1 appears in the appendix of the appellants' Brief.

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

Holubec	3,876,550	Apr. 8, 1975
Newingham et al. (Newingham)	3,923,669	Dec. 2, 1975
Thorsell et al. (Thorsell)	4,648,985	Mar. 10, 1987

All of the claims on appeal stand rejected under 35 U.S.C. § 103 as being unpatentable over Holubec and/or Thorsell in view of Newingham².

² The appealed claims will stand or fall together as indicated by the appellants on page 4 of their Brief.

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We refer to the Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning the above noted rejection.

OPINION

We will sustain the examiner's § 103 rejection of the appealed claims.

The only argued distinctions of the appealed claims over the applied references are set forth in the following argument expressed by the appellants on page 4 of the Brief:

The Applicants respectfully submit that the following limitations in the rejected claims are missing from the cited references and render the claimed subject matter unobvious over those cited references:

(1) the zinc dialkyldithiophosphate used with the thiocarbamate antiwear agent must be a secondary zinc dialkyldithiophosphate, and

(2) all the phosphorous content is attributable to the phosphorous content of the zinc dialkyldithiophosphate.

In our view, these distinctions do not forestall a conclusion of prima facie obviousness. The applied references in general and Holubec in particular disclose lubricating oil compositions such as compositions for internal combustion engines which comprise ingredients that encompass those here claimed

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including zinc dialkyldithiophosphates generically and secondary zinc dialkyldithiophosphates specifically in combination with thiocarbamates as properly indicated by the examiner in her Answer. Thus, contrary to the appellants' belief, it would have been obvious for one with ordinary skill in the art to combine these ingredients including a secondary zinc dialkyldithiophosphate in combination with a thiocarbamate in order to obtain an effective lubricating oil composition for an internal combustion engine based upon a reasonable expectation of success. In re O'Farrell, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). That the applied references such as the Holubec patent disclose a multitude of effective combinations does not render any particular formulation, such as the aforementioned composition, less obvious. Merck & Co. v. Biocraft Labs., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989).

Analogous reasoning applies to the argued claim feature concerning phosphorous content. Concerning this matter, we note that the appellants have acknowledged in the BACKGROUND OF THE INVENTION section of the subject specification that a low phosphorous content was known in the prior art to be desirable. This desirability would have motivated one with ordinary skill in the art to limit phosphorous content by limiting the number of

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compositional ingredients which contained phosphorous, for example, by limiting the aforescribed, modified composition of Holubec to a secondary zinc dialkyldithiophosphate as the only phosphorous-containing compositional ingredient.

The foregoing circumstances lead us to conclude that the reference evidence adduced by the examiner establishes a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

As rebuttal evidence of nonobviousness, the appellants refer to Table I of their specification and the Nakazato Declaration of record in the following paragraph from page 8 of the Brief:

A major factor in the present invention is the surprisingly good results of the combination of secondary zinc dialkyldithiophosphate and alkylene dithiocarbamate on anti-wear performance of low phosphorous lubricating compositions. The examples shown in Table I of the specification show that the use of alkylene dithiocarbamate alone is not enough to get decent anti-wear performance. The examples in the Nakazato declaration show that the use of alkylene dithiocarbamate in conjunction with primary zinc dialkyldithiophosphate is not enough to get decent anti-wear performance. When you use the combination of secondary zinc dialkyldithiophosphate and alkylene dithiocarbamate you achieve excellent anti-wear performance.

It is appropriate to here clarify that, contrary to the appellants' above quoted statement, the examples in Table I of the specification do not show the use of "alkylene dithio-

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carbamate alone" much less that the use of a thiocarbamate alone fails to provide "decent anti-wear performance." The Table I compositions which include a thiocarbamate always also include a zinc dialkyldithiophosphate. It follows that the Table I data does not exhibit unexpected results in the manner argued by the appellants.

With respect to the Nakazato Declaration, the appellants contend that the comparative testing therein "shows that the use of zinc 2-ethylhexylisobutyl phosphorodithioate in place of the secondary zinc dialkyldithiophosphate of the present invention gives inferior performance in JASO M-328-91 test" (Brief, page 12). It is significant that the appellants point to nothing (and we find nothing independently) in the Nakazato Declaration which characterizes the performance of the inventive composition as unexpected. Even if this performance were unexpected, the proffered declaration evidence of nonobviousness still would be inadequate to outweigh the examiner's reference evidence of obviousness. This is because the comparative evidence of the declaration is considerably more narrow in scope than the independent claims on appeal in terms of, for example, compositional ingredients and concentrations. In this regard, it is well settled that rebuttal evidence which is considerably more

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narrow in scope than claimed subject matter is not sufficient to rebut a prima facie case of obviousness. In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979).

For the above stated reasons, it is our ultimate determination that the argument and evidence of record weighs most heavily in favor of an obviousness conclusion. It follows that we will sustain the examiner's § 103 rejection before us on this appeal.

The decision of the examiner is affirmed.

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

AFFIRMED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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