

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHAN VON TAPAVICZA,
WOLFGANG ZOELLNER, CLAUS-PETER HEROLD,
JACQUES GROFFE, AND JEAN ROUET

Appeal No. 1997-2263
Application No. 08/256,199

ON BRIEF

Before OWENS, WALTZ, and ROBINSON, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 12-32, which are all of the claims remaining in the application.

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THE INVENTION

Appellants claim a process for inhibiting the formation of solid hydrocarbon incrustations from hydrocarbon mixtures by adding to the hydrocarbon mixtures a recited inhibitor mixture.

Claim 12 is illustrative and reads as follows:

12. The process of inhibiting the formation of solid hydrocarbon incrustations from hydrocarbon mixtures which are fluid and prone to form such incrustations, comprising contacting said hydrocarbon mixtures with an inhibitor mixture comprising
(a) esters of phosphoric acid or salts thereof and alkoxyated aliphatic, cycloaliphatic or aromatic alcohols, and
(b) fatty acid oligo-dialkanolamides.

THE REFERENCES

Walton	4,813,482	Mar. 21, 1989
Sugier et al. (Sugier)	4,973,775	Nov. 27, 1990

THE REJECTION

Claims 12-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Walton in view of Sugier.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection is not well founded. Accordingly, we reverse this rejection.

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The examiner argues, in reliance upon *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980), that it would have been obvious to one of ordinary skill in the art to combine Sugier's fatty acid oligo-dialkanolamides with Walton's polyoxyalkylene phosphate ester to form a third composition for the same use (answer, pages 5 and 6). In *Kerkhoven*, the court stated, regarding the issue of the obviousness of combining two active detergents, that "[i]t is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose." See *Kerkhoven*, 626 F.2d at 850, 205 USPQ at 1072. The examiner has not established that such a situation exists in the present case.

Walton discloses a process for removing paraffin formations from a producing oil well by shutting down the well, removing the production equipment from the hole, contacting the interior of the well with a heated mixture of a paraffin dispersing amount of an alkyl or aralkyl polyoxyalkylene phosphate ester surfactant in the free acid, alkali metal, amine or ammonium

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salt form, a mutual

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solvent and water, for a sufficient time to disperse the paraffin, and then removing the dispersed paraffin from the well (col. 2, lines 46-58; example 2). Walton teaches that this process also minimizes residual seed crystals which promote additional paraffin formation (col. 2, lines 41-42).

Sugier discloses a process for reducing the agglomeration tendency of hydrates of gases such as natural gas and petroleum gas when water is in the presence of such a gas in the free state or dissolved in a liquid phase such as a hydrocarbon, by adding to the gas or liquid an amphiphilic compound which, appellants acknowledge (brief, page 5), can be a fatty acid oligo-dialkanolamide (col. 1, lines 6-20; col. 2, lines 19-26; col. 3, lines 1-4).

The Walton and Sugier compositions, therefore, do not appear to be for the same use as in *Kerkhoven*. Regardless, even if the compositions are considered to both be incrustation inhibiting compositions, the examiner's argument is not well taken for the following reason.

In the Walton process, the composition containing a polyoxyalkylene phosphate ester is pumped into a well which has

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been taken out of service. Walton indicates that the shut-down

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well contains some oil (col. 10, line 58), but the examiner has not pointed out, and we do not find, where it contains any gas which can form hydrates. Thus, it is not apparent why the references would have led one of ordinary skill in the art to combine with Walton's composition Sugier's fatty acid oligo-dialkanolamides which serve to prevent hydrate formation from gases. Also, it is not apparent why one of ordinary skill in the art would have been led by the references to use Walton's polyoxyalkylene phosphate ester, which functions in combination with a solvent and water to clean paraffin formation out of wells which are shut down, as a hydrocarbon additive as in Sugier's process.

For the above reasons, we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the invention recited in any of appellants' claims. Since no *prima facie* case of obviousness has been established, we need not address the experimental results. See *In re Piasecki*, 745

F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

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DECISION

The rejection of claims 12-32 under 35 U.S.C. § 103 over
Walton in view of Sugier is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

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