

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARDO A. BLOCH, ARUNAS T. LAPINAS,
EDWARD F. OUTTEN, ANDREW J.D. RITCHIE and MALCOLM WADDOUPS

Appeal No. 97-3776
Application No. 08/396,501¹

ON BRIEF

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

DECISION ON APPEAL

¹ Application for patent filed March 7, 1995. According to appellants, this application is a continuation-in-part of Application No. 08/234,090, filed April 28, 1994, now abandoned.

Appeal No. 97-3776
Application No. 08/396,501

This is an appeal from the final rejection of claims 1-14, all the claims in the present application. Claim 1 is illustrative:

1. A crankcase lubricant having a sulfated ash content between 0.35 and 2 mass percent comprising a major amount of an oil of lubricating viscosity to which the following components have been added:

A) a nitrogenous TBN source selected from the group consisting of ashless nitrogen containing dispersants, ashless nitrogen containing dispersant viscosity modifiers, oil soluble aliphatic, oxyalkyl, or arylalkyl amines and mixtures thereof wherein said nitrogen containing dispersant is selected from the group consisting of oil soluble salts, amides, imides, amino-esters, and oxazolines of long chain hydrocarbon substituted mono and dicarboxylic acids or their anhydrides; long chain aliphatic hydrocarbons having a polyamine attached directly thereto; and Mannich condensation products formed by condensing a long chain substituted phenol with formaldehyde and polyalkylene polyamine wherein the long chain hydrocarbon has an M_w of 300 to 20,000;

B) a metal salt of an oil soluble acid having a TBN in excess of 100;

C) a magnesium salt of an oil soluble organic acid in an amount providing at least 500 ppm (mass) magnesium, and

D) at least one metal dihydrocarbyl dithiophosphate wherein the nitrogenous TBN source provides at least about 1.5 TBN to the lubricant; the metal salt of an oil soluble acid provides at least about 40% of the total TBN of the lubricant; and at least 50 mole percent of the hydrocarbyl groups on the metal dithiophosphate are secondary.

The examiner relies upon the following references as evidence of obviousness:

Appeal No. 97-3776
Application No. 08/396,501

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| Waddoups et al. (Waddoups) | 4,938,880 | Jul. 3, 1990 |
| Fetterman, Jr. et al. (Fetterman) | 5,102,566 | Apr. 7, 1992 |

Appealed claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fetterman in view of Waddoups.

Upon careful consideration of the opposing arguments presented on appeal, we find that the examiner has failed to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

There is apparently no dispute that Fetterman discloses a lubricant comprising the four components recited in the appealed claims. However, the appealed claims specifically require, inter alia, that "the nitrogenous TBN source provides at least about 1.5 TBN to the lubricant" and that "the metal salt of an oil soluble acid provides at least about 40% of the total TBN of the lubricant." Appellants set forth at page 4 of the Brief that Examples 2 and 5 of the present specification demonstrate the significance of the nitrogenous TBN source providing at least about 1.5 TBN to the lubricant and of the metal salt of an oil soluble acid providing at least about 40% of the total TBN of the lubricant. It is appellants' position that Fetterman, the primary reference,

Appeal No. 97-3776
Application No. 08/396,501

does not teach these characteristics of the lubricant, or their significance, and that Waddoups, the secondary reference, does not cure these deficiencies. In addition, appellants submit that the Waddoups declaration demonstrates that a lubricant typical of the Fetterman lubricants do not have a nitrogenous TBN contribution of at least about 1.5, and that the lubricants typical of Fetterman do not pass all of the tests required for the API CG-4 and API SH performance certifications.

Although the examiner cites Fetterman for disclosing a lubricant that comprises the four components of the claimed lubricant, the examiner has failed to address the claim limitations regarding the nitrogenous TBN source providing at least about 1.5 TBN and the metal salt of an oil soluble acid providing at least about 40% of the total TBN of the lubricant. Consequently, the examiner has failed to establish on this record that lubricants fairly within the Fetterman disclosure inherently possess the claimed characteristics, or that lubricants having the claimed characteristics would have been obvious to one of ordinary skill in the art in view of the collective teachings of Fetterman and Waddoups. As a

Appeal No. 97-3776
Application No. 08/396,501

result, the examiner has not met her initial burden of setting forth a prima facie case of obviousness for the claimed subject matter. Also, the examiner's treatment of the Waddoups declaration at page 6 of the Answer is inadequate. The examiner provides no critical analysis of the declaration in support of her conclusion that the declaration results are "expected in the use of secondary zinc dihydrocarbyl dithiophosphates over primary zinc dihydrocarbyl dithiophosphates." We note that the lubricant offered for comparison in the declaration, ECA 14751, comprises 34 mole percent sec-hydrocarbyl groups.

In conclusion, based on the present record, we are constrained to reverse the examiner's rejection.

REVERSED

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| EDWARD C. KIMLIN |) | |
| Administrative Patent Judge |) | |
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| BRADLEY R. GARRIS |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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Appeal No. 97-3776
Application No. 08/396,501

CHUNG K. PAK)
Administrative Patent Judge)

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Appeal No. 97-3776
Application No. 08/396,501

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