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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LAURENT CHAMBARD and ADRIAN DUNN

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Appeal 2011-011673  
Application 10/863,041  
Technology Center 1700

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Before BRADLEY R. GARRIS, RICHARD E. SCHAFER, and  
JAMES C. HOUSEL, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134, Appellants appeal from the Examiner's rejections under 35 U.S.C. § 103(a) of claims 1, 3, 4, and 6-9 as unpatentable over Dunn 734 (US 2001/0003734 A1 published June 14, 2001) and as unpatentable over Hammond (EP 1236792 A1 published Sept. 4, 2002) in view of Dunn 698 (EP 1046698 A1 published Oct. 25, 2000) as evidenced by Dabbousi (US 6,884,531 B2 issued Apr. 26, 2005). We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim a method of operating a marine diesel engine comprising fueling the engine with diesel fuel having a sulfur content of at most 1.5 mass % and lubricating the engine with a cylinder lubricant having a total base number of more than 30 and less than 70 mg KOH/g wherein the lubricant includes a detergent prepared from at least two surfactants including salicylate and phenate and/or sulfonate (claim 1).

Representative claim 1, the sole independent claim on appeal, reads as follows:

1. A method of operating a marine diesel engine, the method comprising: fueling the marine diesel engine with diesel fuel having a sulfur content of at most 1.5 mass %;

and

lubricating the marine diesel engine with a cylinder lubricant having a total base number of more than 30 and less than 70 mg KOH/g as determined in accordance with ASTM D2896, the cylinder lubricant including:

(a) greater than 70 mass % of an oil of lubricating viscosity, and

(b) from greater than about 6 mass % to about 28 mass % of at least one detergent having a total base number in the range of 250 to 500mg KOH/g, prepared from at least two surfactants, including from about 5 to about 95 mass% of salicylate and from about 5 to about 95 mass% of phenate and/or sulfonate.

Appellants do not separately argue the dependent claims under rejection (Br. 3-7). Accordingly, we will focus on sole independent claim 1 in our disposition of this appeal.

#### The § 103 Rejection based on Dunn 734

Appellants do not contest the Examiner's finding that Dunn 734 discloses a method of operating a marine diesel engine using ingredients which include those of claim 1 and ranges which at least overlap those of claim 1 (cf., Br. para. bridging 3-4 and Ans. 5-6). Instead, Appellants argue that Dunn 734 does not expressly suggest certain ingredients and ranges required by their independent claim (Br. para. bridging 3-4).

This argument does not persuade us that the Examiner has failed to establish a prima facie case of obviousness. Contrary to Appellants' apparent belief, obviousness does not require that the claimed invention must be expressly suggested by an applied reference. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Further, a prima facie case of obviousness typically exists when, as here, the ranges of a claimed invention overlap the ranges disclosed in the prior art. *See In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003).

Appellants also argue that any prima facie case of obviousness "is overcome by the objective evidence of non-obviousness provided in the

specification . . . [which] establishes the surprising and unexpected nature of the invention" (Br. para. bridging 4-5).

We agree with the Examiner that the scope of the Specification evidence referred to by Appellants (i.e., comparative examples 1, 2, and 4 and inventive example 3) is not commensurate with the scope of the claim 1 ingredients (e.g., the claimed surfactants are broader than the exemplified surfactants) and ranges (e.g., the claimed total base number range is broader than the exemplified range) (Ans. 10). For this reason alone, Appellants' evidence of non-obviousness does not outweigh the Dunn 734 evidence of obviousness. *See Peterson*, 315 F.3d at 1330-31 ("[T]he applicant's showing of unexpected results must be commensurate in scope with the claimed range.").

We sustain the Examiner's § 103 rejection of the appealed claims as unpatentable over Dunn 734.

The § 103 Rejection based on Hammond, Dunn 698, and Dabbousi

We share the Examiner's position (Ans. 7-8) that the combined teachings of Hammond and Dunn 698 support a conclusion that it would have been prima facie obvious to provide the lubricant composition of Hammond with a total base number within the claimed range and to utilize the resulting composition as a cylinder lubricant for a marine diesel engine in view of Dunn 698.

In contesting this rejection, Appellants state that trunk piston engine oil differs in utility from marine diesel cylinder lubricant, that artisans would not apply a disclosure of the former to the latter, and that the claimed

invention is directed to a marine diesel cylinder lubricant composition (Br. 6). However, as Appellants implicitly concede, the composition of Hammond is described as useful in the formulation of marine diesel engine lubricants generally and is not limited to the formulation of trunk piston engine oil (*id.* at para. bridging 6-7). Moreover, Appellants expressly acknowledge that Dunn 698 is directed to both trunk piston engine oil and marine diesel cylinder lubricant (*id.*).

Appellants additionally state that "EP '698 [i.e., Dunn 698], like EP '792 [i.e., Hammond] fails to suggest that such detergents will provide any specific advantage in an MDCL [i.e., marine diesel cylinder lubricant] having a TBN [i.e., total base number] within the presently claimed range" (*id.*). This statement fails to establish non-obviousness because no explanation has been provided as to why the alleged absence of a specific advantage is considered to militate against a prima facie case of obviousness.

Concerning the claim 1 requirement for diesel fuel having a sulfur content of at most 1.5 mass %, Appellants argue that Dabbousi is directed to a fuel source for fuel cells and would not be combined with Hammond and Dunn 698 absent use of impermissible hindsight (*id.*). Regardless, Appellants do not dispute with any reasonable specificity the Examiner's conclusion, with which we agree, that it would have been prima facie obvious to fuel the marine diesel engine of Hammond with diesel fuel having the claimed sulfur content in view of Hammond's disclosure of using low sulfur fuel (Ans. 7).

Finally, Appellants again argue that any prima facie case of obviousness is overcome by their Specification evidence of non-obviousness

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(Br. para. bridging 6-7). As indicated previously, this non-obviousness evidence is not commensurate in scope with claim 1 and therefore does not outweigh the applied reference evidence of obviousness.

For the above stated reasons, we sustain the Examiner's § 103 rejection of the appealed claims based on Hammond, Dunn 698 and Dabbousi.

### Conclusion

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136.

AFFIRMED

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