UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/122,485	04/04/2011	Peter Jaehrling	4989	9548

278 7590 11/14/2016
MICHAEL J. STRIKER
103 EAST NECK ROAD
HUNTINGTON, NY 11743

EXAMINER
ROERSMA, ANDREW MARK

ART UNIT	PAPER NUMBER
3637	

NOTIFICATION DATE	DELIVERY MODE
11/14/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

striker@strikerlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER JAEHRLING and WILLI GRIGAT

Appeal 2014-008043
Application 13/122,485
Technology Center 3600

Before: CHARLES N. GREENHUT, LYNNE H. BROWNE, and PAUL J. KORNICZKY, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1–3, 5–7, 11–15, and 32–38. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED SUBJECT MATTER

The claims are directed to a drawer slide for household appliances and lubricant. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1 A drawer slide (1) for a cooking oven, the drawer slide (1) comprising at least two rails (2, 3) that move relative to one another and are slid on each other by way of rolling elements (4) contained in tracks (6, 8), wherein the tracks (6, 8) of the rolling elements (4) are lubricated at the rails (2, 3) at least in areas by way of a lubricant (7) containing a mixture of boron nitride, graphite and silicone oil, and wherein the boron nitride is contained in a mass fraction w (boron nitride) of between 10% and 40%, the graphite is contained in a mass fraction w (graphite) of between 10% and 40% and the silicone oil is contained in a mass fraction w (silicone oil) of between 20% and 80%.

REJECTIONS

Claims 1–3, 5, 6, 12, 14, 32, 34, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner (DE102004019102, iss. Nov. 24, 2005), Levy (US 7,338,926 B2, iss. Mar. 4, 2008), and Ambrose (US 2007/0272231 A1, pub. Nov. 29, 2007).

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner, Levy, Ambrose, Gabriele (US 5,570,956, iss. Nov. 5, 1996), and Hirata (US 2008/0085070 A1, pub. Apr. 10, 2008).

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner, Levy, Ambrose, and Moseberg (US 7,393,139 B2, iss. July 1, 2008).

Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner, Levy, Ambrose, and Seemeyer (US 2008/0176778 A1, pub. July 24, 2008).

Claims 15, 33, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner, Levy, Ambrose, and Fitz Simmons (US 3,637,497 A1, iss. Jan. 25, 1972).

Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner, Levy, Ambrose, and Cardis (US 2003/0125218 A1, pub. July 3, 2003).

OPINION

Appellants group the claims according to the rejections with substantive arguments presented only for the first grouping, covering both independent claims 1 and 38. The remaining rejections are argued based on dependency.

The Examiner's rejection is predicated on the obviousness of modifying Brunner's oven slide rails to include boron nitride or graphite in the alternative, or both boron nitride and graphite in silicone oil (Brunner paras. 14–15), in the proportions recited in claims 1 and 38.

The first issue raised by Appellants is that "nowhere does Brunner teach a mixture of lubricants in a binder (e.g., 2 dry lubricants)." App. Br. 14. This point is not disputed by the Examiner. However, where Appellants contend that "Appellants do not see that Levy (or Ambrose, see below) overcomes the shortcomings of Brunner" (App. Br. 14, 18–19), the Examiner correctly responds that both Levy and Ambrose expressly contemplate such a mixture. Ans. 2–3; Levy col. 12, ll. 25–28

("Combinations of the solid or particulate inorganic lubricant and the solid or particulate organic lubricant can also be employed, especially the 2 to about 3 or 4 component combinations."); Ambrose Abst.; Claim 1 ("graphite; boron nitride;. . . and mixtures thereof").

Appellants' contention that "Levy does not teach or suggest 'combining' dry solid lubricants in silicone oil" (App. Br. 14–16) also does not appear to be an accurate interpretation of Levy. Levy indicates that the inorganic solid particulates of graphite and/or boron nitride are dispersed in, for example, "synthetic oils." Levy col. 7, ll. 3–45. As Levy expressly states that synthetic oils include silicone lubricants (col. 4, ll. 57–67), we agree with the Examiner that Levy does fairly teach or suggest graphite and boron nitride dispersed in silicone oil as one of the high-temperature lubricant possibilities.

Appellants' next argument is that "Levy cannot support forming a lubricant used in the oven as claimed, wherein the silicone oil forms a viscous layer to enable the solid dry lubricant to spread during the drawing operation of the drawer slide because of the viscosity." App. Br. 16. However, we are not apprised of why this language should be imported into the claims which do not expressly contain such limitations. Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

As noted above, contrary to Appellants' argument (App. Br. 16, 18–19), Ambrose, like Levy, expressly suggests more than one dry lubricant particulate. The Examiner notes each of Ambrose and Levy suggest particular ranges for the dry lubricants. Ans. 3. Levy's range, as found by the Examiner, is much broader than that claimed and, although not discussed

by the Examiner, Ambrose's range could potentially be regarded as overlapping the claimed ranges before us. For example, construing 20% (Ambrose para. 26), in the light most favorable to Appellants, to mean 20% total, as opposed to 20% of each particulate lubricant, could be read as fairly suggesting at least 10% of each lubricant if two, such as graphite and boron nitride, were selected. Thus, following the express teachings of Ambrose could result in a lubricant having mass fractions within the ranges claimed. Regardless, the Examiner thought it sufficient, and we agree, that by discussing the percent compositions of the dry lubricants, there was recognition in the prior art that such fractions were known result-effective variables. Thus, the Examiner reasonably concluded that the recited ranges were the product of routine optimization. Final Act. 5.

It is true that Ambrose and Levy do not contain elaborate test data discussing all of the possible effects of changing the dry lubricant proportions. However, patent documents typically do not include significant quantities of test data. Nor is it practical for the Patent Office to obtain that type of data. This is why, in a situation such as this, the burden shifts to Appellants to come forward with *objective evidence* to demonstrate why reciting the particular ranges in question results in the claimed subject matter being nonobvious. *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir.1990). "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . [I]n such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *Id*. We agree with the Examiner's

analysis, that by the Grigat declaration, Appellants have not provided a strong showing in this regard. *See* Ans. 4–5; Final Act. 13–15.

Regarding the Grigat declaration, at the outset, the Examiner points to some inconsistencies in the testing procedures employed. Ans. 4–5 (citing Grigat Decl. paras. 13, 19). Appellants have not provided any response on this point. More importantly, as the Examiner also points out (Ans. 4–5), Appellants have established only that *different* results are obtained with different fractions of dry lubricants. We are not apprised of anything in the record to show why such results were *unexpected*. We agree with the Examiner that absent evidence otherwise, one skilled in the art would *expect* the percentages of dry lubricants to impact performance of a drawer slide.

On the record before us, we agree with the Examiner that the evidence of obviousness outweighs the evidence against.

DECISION

The Examiner's rejections are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>