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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN L. MEAD, RODNEY LEE CRAVEY, and
MOHAMMAD ABDUR RAHMAN

Appeal 2015-001715
Application 13/846,110
Technology Center 1700

Before RICHARD E. SCHAFER, PETER F. KRATZ, and
ROMULO H. DELMENDO, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

The Applicants (hereinafter the “Appellants”)¹ appeal under 35 U.S.C. § 134(a) from a final decision of the Primary Examiner to reject claims 1–3, 5, 9–20, and 22.² We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ The Appellants state that the real party in interest is “Akzo Nobel N.V.” (Appeal Brief filed August 15, 2014, hereinafter “Appeal Br.,” 3).

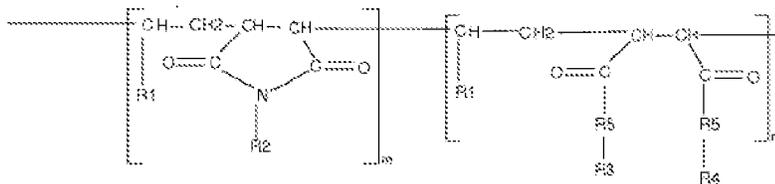
² Appeal Br. 3; Final Office Action delivered electronically on February 27, 2014, hereinafter “Final Act.,” 3–6; Examiner’s Answer delivered electronically on September 18, 2014, hereinafter “Ans.,” 3–17.

BACKGROUND

The current application is a continuation of Application 11/703,972 ('972 Application) filed February 8, 2007, now abandoned. In the '972 Application, we affirmed the Examiner's decision to reject claims similar to those before us in the current appeal because none of the Appellants' arguments raised on appeal were persuasive to identify a reversible error in the Examiner's rejection.³ See *Ex parte Mead*, <https://e-foia.uspto.gov/Foia/RetrievePdf?system=BPAI&flNm=fd2011012143-01-15-2013-1>, 3–5. Following further prosecution in the current application, the Appellants filed this new appeal based on new arguments (e.g., Appeal Br. 13) not raised in the previous appeal.

Claim 1 is representative of the claimed subject matter and is reproduced from page 15 of the Appeal Brief (Claims Appendix) as follows:

1. A crude oil composition having improved low temperature properties comprising crude oil and an effective amount of a pour point depressant additive composition that comprises at least one pour point depressant additive of the formula I:



wherein each R¹ is independently selected from H or a hydrocarbyl group having from 1 to 50 carbon atoms, R², R³ and R⁴ are each independently selected from hydrogen or a

³ *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (approving the Board's practice of reviewing a rejection for error based upon the issues identified by the appellant).

hydrocarbyl groups containing from 1 up to 50 carbon atoms, m is an integer of from 1 to 50, n is an integer of from 0 to 50, and each R⁵ is independently selected from O and NH.

REJECTION ON APPEAL

Claims 1–3, 5, 9–20, and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Krull et al. (hereinafter “Krull”)⁴ and Sweeney et al. (hereinafter “Sweeney”)⁵ (Ans. 3–17; Final Act. 3–6).

DISCUSSION

A dispositive issue in this appeal is whether the Examiner correctly determined that Krull would have suggested comonomeric units including the substituents R¹–CH–CH₂– (where R¹ is H or a hydrocarbyl group having from 1 to 50 carbon atoms) in the pour point depressant additive as specified in formula I of claim 1 (Appeal Br. 10–13; Ans. 7–8). Specifically, the Examiner found that when Krull refers to “abovementioned alkyl” in paragraph 113, Krull is not only referring to the “alkyl groups” that are present in structural unit (16) disclosed in paragraphs 105–112 but also “methyl” (as R²² and R²³) in structural units (12) and (14) disclosed in paragraphs 98–100 (Ans. 8, 13). The Appellants dispute this finding, arguing that the alkyl substituents discussed in Krull’s paragraph 113 relate only to the alkyl radicals in bivalent structural unit (16) (Appeal Br. 11; Reply Brief filed November 17, 2014 at 4).

We agree with the Appellants that the phrase “abovementioned alkyl” in Krull’s paragraph 113 refers only to the alkyl groups discussed for structural formula (16). Krull’s disclosure in paragraph 100 plainly limits

⁴ US 2001/0013196 A1, published August 16, 2001.

⁵ US 3,675,671, issued July 11, 1972.

R²² and R²³ of structural units (12) and (14) to hydrogen and methyl only. A person skilled in the relevant art would not have read “abovementioned alkyl” in Krull’s paragraph 113 to include “methyl” in paragraph 100 because, as argued by the Appellants (Appeal Br. 11), such an interpretation would render the clear teaching in the latter paragraph that “R²² and R²³ . . . are hydrogen or methyl” to be meaningless.

To the extent that the Examiner is relying on our prior decision as establishing that Krull discloses the same comonomeric units as specified in claim 1, such reliance is misplaced (Ans. 6). Our prior decision rested on the key fact that “the Examiners’ finding in terms of the structure of the terpolymers relative to ‘formulae I’ [was] undisputed.” *Mead* at 4. By contrast, in the current appeal, the Appellants are contesting such a finding. We discern no reason why the Appellants could not continue prosecution of the same or similar claims based on new arguments or theories in a continuing application, as they have done so here.

Because the other independent claims—namely, claims 11 and 18—recite the same substituents R¹–CH–CH₂–, our discussion of claim 1 applies equally to all claims on appeal.

SUMMARY

The Examiner’s final decision to reject claims 1–3, 5, 9–20, and 22 is reversed.

REVERSED