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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CORNELIS H. M. BOONS

Appeal 2019-002327
Application 14/934,541
Technology Center 1700

Before CATHERINE Q. TIMM, MICHAEL G. McMANUS, and
JANE E. INGLESE, *Administrative Patent Judges*.

INGLESE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ requests our review under 35 U.S.C. § 134(a) of the Examiner's decision to finally reject claims 1, 4–13, 15, 21, and 25.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Chevron Oronite Technology B.V. as the real party in interest. Appeal Brief filed September 12, 2018 (“Appeal Br.”) at 2.

² Final Office Action entered March 9, 2018 (“Final Act.”).

CLAIMED SUBJECT MATTER

Appellant claims a marine diesel cylinder lubricating oil composition. Appeal Br. 2–4. Claim 1 illustrates the subject matter on appeal, and is reproduced below with contested language italicized:

1. A marine diesel cylinder lubricating oil composition comprising:
 - (a) a major amount of one or more Group II basestocks,
 - (b) a detergent composition comprising (i) one or more alkaline earth metal salts of an alkylsubstituted hydroxyaromatic carboxylic acid having a total base number (TBN) greater than 250, and (ii) one or more high overbased alkyl aromatic sulfonic acids or salts thereof; wherein the aromatic moiety of the alkyl aromatic sulfonic acids or salts thereof contains no hydroxyl groups; and
 - (c) *a marine diesel cylinder lubricating oil composition additive selected from the group consisting of an ashless antioxidant, ashless dispersant, other detergent, rust inhibitor, dehazing agent, demulsifying agent, metal deactivating agent, ashless friction modifier, pour point depressant, antifoaming agent, co-solvent, corrosion-inhibitor, dyes, extreme pressure agent and mixtures thereof,*
and wherein the marine diesel cylinder lubricating oil composition has a TBN of about 40 to about 70.

Appeal Br. 11 (Claims Appendix) (emphasis added).

REJECTION

The Examiner maintains the rejection of claims 1, 4–13, 15, 21, and 25 under 35 U.S.C. § 103 as unpatentable over Nelson et al. (US 2013/0261313 A1, published October 3, 2013) in the Examiner’s Answer entered November 23, 2018 (“Ans.”).

FACTUAL FINDINGS AND ANALYSIS

Upon consideration of the evidence relied upon in this appeal and each of Appellant's contentions, we affirm the Examiner's rejection of claims 1, 4–13, 15, 21, and 25 under 35 U.S.C. § 103 for the reasons set forth in the Final Action, the Answer, and below.

We review appealed rejections for reversible error based on the arguments and evidence the appellant provides for each issue the appellant identifies. 37 C.F.R. § 41.37(c)(1)(iv); *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (explaining that even if the Examiner had failed to make a prima facie case, “it has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections”)).

Appellant argues claims 1, 4–13, 15, 21, and 25 as a group on the basis of independent claims 1 and 25, which Appellant argues together. Appeal Br. 4–9. We accordingly select claim 1 as representative, and decide the appeal as to claims 1, 4–13, 15, 21, and 25 based on claim 1 alone. 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 recites a marine diesel cylinder lubricating oil composition comprising, in part, a marine diesel cylinder lubricating oil composition additive selected from the group consisting of an ashless antioxidant, ashless dispersant, other detergent, rust inhibitor, dehazing agent, demulsifying agent, metal deactivating agent, *ashless friction modifier*, pour point depressant, antifoaming agent, co-solvent, corrosion-inhibitor, dyes, extreme pressure agent and mixtures thereof.

Nelson discloses a lubricating oil composition containing a

molybdated succinimide complex, which is used as a marine cylinder lubricant in crosshead diesel engines. Nelson ¶¶ 11, 13, 89.

Appellant argues that the molybdated succinimide complex included in Nelson’s lubricating oil composition is an ash-producing friction modifier. Appeal Br. 4–6. Appellant argues that the lubricating oil composition of claim 1 “requires an ashless friction modifier and excludes an ash-producing friction modifier” due to the “closed off” nature of the “consisting of” phrase recited in the Markush group in the claim. *Id.* Appellant argues that under *Multilayer Stretch Cling Film Holdings, Inc., v. Berry Plastics Corporation*, 831 F.3d 1350, 1360–61 (Fed. Cir 2016), claim 1 is “closed off to any marine diesel cylinder lubricating oil composition additive not recited in the Markush group,” and, therefore, excludes Nelson’s molybdenum succinimide complex ash producing friction modifier. Appeal Br. 7–9.

Appellant’s arguments do not identify reversible error in the Examiner’s rejection, for reasons well-expressed by the Examiner in the Answer, and discussed below.

A “Markush group” is a claim element expressed as a list of alternatives preceded by the phrase “consisting of,” which closes the group to alternatives not explicitly recited, and requires selection of a member from only the specified group of alternatives. *Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*, 334 F.3d 1274, 1280–1281 (Fed. Cir. 2003).

A “comprising” transitional phrase between the preamble and body of a composition claim opens the composition to inclusion of unrecited materials or components. *Gillette Co. v. Energizer Holdings, Inc.* 405 F.3d 1367, 1371–1372 (Fed. Cir. 2005) (“The word ‘comprising’ transitioning

from the preamble to the body signals that the entire claim is presumptively open-ended.”); *In re Baxter*, 656 F.2d 679, 686–87 (CCPA 1981) (“As long as one of the monomers in the reaction is [the claimed] propylene, any other monomer may be present, because the term ‘comprises’ permits the inclusion of other steps, elements, or materials.”).

Use of “consisting of” within the body of a claim, rather than immediately following the preamble, closes only the element preceded by “consisting of,” and does not negate the open nature of a “comprising” transition present in the claim between the preamble and body.

Mannesmann Demag Corp. v. Engineered Metal Prods. Co., 793 F.2d 1279, 1282 (Fed. Cir. 1986) (confirming that the phrase “consisting of” appearing in a clause of a claim specifically limits only the element set forth in that clause); *In re Crish*, 393 F.3d 1253, 1257 (Fed. Cir. 2004) (“Crish’s principal argument here that the claims also contain the closed-ended transition term ‘consists,’ and that that term narrows the entire claim, is unpersuasive. The reasonable interpretation of the claims containing both of the terms ‘comprising’ and ‘consists’ is that the term ‘consists’ limits the ‘said portion’ language to the subsequently recited numbered nucleotides, but the earlier term ‘comprising’ means that the claim can include that portion plus other nucleotides.”).

In the present case, the “consisting of” phrase recited within the body of claim 1 introduces a list of alternative marine diesel cylinder lubricating oil composition additives (a Markush group), one or more of which must be included in the claimed lubricating oil composition. The “consisting of” phrase closes the group of additives to those not explicitly recited in the claim, but like the situation in *Crish* set forth above, the “consisting of”

phrase in the body of claim 1 does not negate the open nature of the claim imparted by the “comprising” transition that immediately follows the preamble. *Crish*, 393 F.3d at 1257.

As the Examiner explains (Ans. 7), because claim 1 recites a lubricating oil *composition*, under a broadest reasonable interpretation, any material included in the composition other than the basestock would be an “additive,” consistent with the description provided in Appellant’s Specification. Spec. ¶¶ 108, 136; *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (During prosecution of patent applications, “the PTO must give claims their broadest reasonable construction consistent with the specification . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”). Interpreting the “consisting of” phrase in the body of claim 1 as Appellant asserts to close the claim “to any marine diesel cylinder lubricating oil composition additive not recited in the Markush group,” would, therefore, effectively change the “comprising” transition that follows the preamble of claim 1 to a “consisting of” transition, contrary to the principles of *Mannesmann* and *Crish* set forth above.

Accordingly, as the Examiner determines, although the “consisting of” transition recited in the body of claim 1 requires inclusion of one or more of the explicitly recited additives in the claimed lubricating oil composition, the “comprising” transition that immediately follows the preamble of claim 1 opens the claim to inclusion of unrecited materials. Accordingly, claim 1 does not exclude the molybdated succinimide complex disclosed in Nelson from the claimed composition, regardless of whether the complex is an ash-producing friction modifier as Appellant asserts. Ans. 6–

7.

As to Appellant's argument that under *Multilayer* claim 1 excludes Nelson's molybdenum succinimide complex ash producing friction modifier, the claim at issue in *Multilayer* recites, with emphasis added:

1. A multi-layer, thermoplastic stretch wrap film containing seven separately identifiable polymeric layers, *comprising*:
 - (a) two identifiable outer layers, at least one of which having a cling performance of at least 100 grams/inch, said outer layer being selected from the group consisting of linear low density polyethylene, very low density polyethylene, and ultra low density polyethylene resins, said resins being homopolymers, copolymers, or terpolymers, of ethylene and alpha-olefins; and
 - (b) *five identifiable inner layers, with each layer being selected from the group consisting of linear low density polyethylene, very low density polyethylene, ultra low density polyethylene, and metallocene-catalyzed linear low density polyethylene resins; said resins are homopolymers, copolymers, or terpolymers, of ethylene and C3 to C20 alpha-olefins;*wherein each of said two outer layers and each of said five inner layers have different compositional properties when compared to a neighboring layer.

Multilayer, 831 F.3d 1350, 1351 (Fed. Cir. 2016).

The court in *Multilayer* determined that “the Markush group of element (b) must be construed as closed to resins other than LLDPE, VLDPE, ULDPE, and mLLDPE.” *Multilayer*, 831 F.3d at 1358. The “consisting of” transition in the body of the claim at issue in *Multilayer*, therefore, limits the composition of the five inner layers of the claimed film to the recited resins only, and closes the composition of these layers to unrecited resins, analogous to the present situation where the “consisting of” transition in the body of claim 1 limits the lubricating oil composition additives to those explicitly recited, and closes the group of additives to

those not explicitly recited in the claim. The “comprising” transitional phrase that immediately follows the preamble of the claim at issue in *Multilayer*, however, allows additional, unrecited layers to be included in the claimed film, analogous to the present situation where the “comprising” transition in claim 1 allows additional, unrecited materials to be included in the claimed composition. *Multilayer*, 831 F.3d at 1358 (explaining that in contrast to “consisting of,” “the alternative transitional term ‘comprising’ creates a presumption that the recited elements are only a part of the device, that the claim does not exclude additional, unrecited elements.” (Citing *Crystal Semiconductor Corp. v. TriTech Microelectronics Int’l, Inc.*, 246 F.3d 1336, 1348 (Fed. Cir. 2001))).

Contrary to Appellant’s arguments, *Multilayer*, therefore, does not contradict the principles of *Mannesmann* and *Crish* set forth above, and, accordingly, does not require claim 1 to be interpreted to exclude Nelson’s molybdenum succinimide complex from the claimed composition.

We, therefore, sustain the Examiner’s rejection of claims 1, 4–13, 15, 21, and 25 under 35 U.S.C. § 103.

CONCLUSION

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 4–13, 15, 21, 25	103	Nelson	1, 4–13, 15, 21, 25	

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

AFFIRMED