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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES C. DODD and JOSHUA L. BRADLEY-SHAW

Appeal 2019-002708
Application 14/174,884
Technology Center 1700

Before JEFFREY T. SMITH, BEVERLY A. FRANKLIN, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–4 and 7–18. We have jurisdiction 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 the real party in interest as Infineum International Limited. Appeal Br. 1.

STATEMENT OF THE CASE

Appellant's invention is generally directed to a method of preparing a trunk piston marine engine lubricating oil composition for a medium-speed four-stroke compression-ignited marine engine. (Spec. 1.) The following rejections are presented for appeal:

Claims 1–4 and 7–18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Garner (WO 2010/115594 A1; Oct. 14, 2010) the U.S. equivalent (US 2012/0028522 A1; Feb. 2, 2012) is used for making the rejection.

Claims 1–4 and 7–18 are provisionally rejected on the ground of non-statutory double patenting as unpatentable over claims 1–7 of copending Application No. 14/267, 950 (now US 10,167,440 B2; Jan. 1, 2019) in view of Garner (2012/0028522).

Claims 1–4 and 7–18 are provisionally rejected on the ground of non-statutory double patenting as unpatentable over claims 1– 16 of copending Application No. 14/494,620 Gregory (now US 9,353,330 B2; May 31, 2016).

Claims 1–4 and 7–18 are rejected on the ground of double patenting as unpatentable over claims 1– 7 of Gregory (US 8,067,348 B2; Nov. 29, 2011) in view of Garner (US 2012/0028522).

Claims 1–4 and 7–18 are rejected on the ground of double patenting as unpatentable over claims 1– 8 of Dodd (US 8,071,517 B2; Dec. 6, 2011) in view of Garner (US 2012/0028522).

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Claims 1–4 and 7–18 are rejected on the ground of double patenting as unpatentable over claims 1– 7 of Gregory (US 8,067,276 B2; Dec. 13, 2011) in view of Garner (US 2012/0028522).

Claims 1–4 and 7–18 are rejected on the ground of double patenting as unpatentable over claims 1– 10 of Hartley (US 8,609,599 B2; Dec. 17, 2013) in view of Garner (US 2012/0028522).

Claims 1–4 and 7–18 are rejected on the ground of double patenting as unpatentable over claims 1– 10 of Bertram (US 8,703,676 B2; Apr. 22, 2014) in view of Garner (US 2012/0028522).

Claims 1–4 and 7–18 are rejected on the ground of double patenting as unpatentable over claims 1– 8 of Dodd (US 8,951,944 B2; Feb. 10, 2015) in view of Garner (US 2012/0028522).

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method of preparing a trunk piston marine engine lubricating oil composition for a medium-speed four-stroke compression-ignited marine engine comprising blending (A) a lubricant additive, in a minor amount, comprising an overbased metal hydrocarbyl-substituted hydroxybenzoate detergent dispersed in diluent and (B) an additive comprising a polyalkenyl substituted carboxylic acid anhydride as active ingredient dispersed in-a diluent oil containing greater than or equal to 90 % saturates and less than or equal to 0.03% sulphur with (C) an oil of lubricating viscosity in a major amount, said oil of lubricating viscosity having greater than or equal to 90% saturates and less than or equal to 0.03 % sulphur, wherein lubricant additive (A) and additive (B) together comprise from 2 to 20 mass% of said lubricating oil composition.

OPINION²

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *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) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”). After considering the evidence presented in this Appeal and each of Appellant’s arguments, we are not persuaded that Appellant identifies reversible error. Thus, we affirm the Examiner’s rejections for the reasons expressed in the Final Office Action and the Answer. We add the following primarily for emphasis.

The Examiner finds Garner teaches a method of making a trunk piston engine oil formulated with a major amount of oil of lubricating viscosity containing at least 50 mass % of the basestock which comprises greater than or equal to 90% saturates and less than or equal to 0.03% sulfur, and wherein the composition comprises a minor amount of overbased metal hydrocarbyl-substituted hydroxybenzoate detergent and at least 1% of a hydrocarbyl substituted carboxylic acid or anhydride. (Final Act. 3; Garner ¶11.) The Examiner finds Garner teaches the hydrocarbyl substituted carboxylic anhydride is polyisobutene succinic anhydride which is a polyalkenyl-substituted carboxylic acid anhydride. (Garner ¶106.) The

² The Appellant relies on the same arguments for all claims on appeal (App. Br. 2–9). Therefore, we decide this appeal on the basis of independent claim 1, which we designate as representative pursuant to 37 C.F.R. § 41.37(c)(1)(iv). Claims 2–4 and 7–18 stand or fall with claim 1.

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Examiner determines Garner teaches the amount of salicylate detergent and polyisobutene succinic anhydride combination alone, or with other additives, are present in calculated amounts of from 0.96 to 14.4% which overlaps the claimed range. (Final Act. 3.)

Appellant argues Garner fails to teach that hydrocarbyl-substituted carboxylic acid anhydride is present as concentrate (i.e., as mixture of the anhydride in oil) wherein the oil has 90% saturates content or greater in which the anhydride additive is dispersed. (App. Br. 5.) Appellant argues that Garner does not teach that the dispersion of hydrocarbyl-substituted carboxylic acid anhydride in highly saturated oil provides significant benefit. (App. Br. 6.)

Appellant's arguments are not persuasive of reversible error for the reasons expressed by the Examiner in the Answer. (Ans. 12–13.) Appellant has not disputed the Examiner's determination that Garner teaches a method of making a trunk piston engine oil formulated with amount of salicylate detergent and polyisobutene succinic anhydride combination alone, or with other additives, are present in calculated amounts of from 0.96 to 14.4% which overlaps the claimed range. (Final Act. 3.) As stated above, Garner teaches a method of making a trunk piston engine oil formulated with a major amount of oil of lubricating viscosity containing at least 50 mass % of the basestock which comprises greater than or equal to 90% saturates. Contrary to Appellant's arguments, the patentability of an invention does not require Garner to recognize the advantages discovered by Appellant. *See MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1366 (Fed. Cir. 1999) ("Where, as here, the result is a necessary consequence of what was deliberately intended, it is of no import that the Article's authors did not

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appreciate the results.”); *Ex parte Obiaya*, 227 USPQ 58, 60 (BPAI 1985) (“The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the difference would otherwise have been obvious.”); *see also In re Spada*, 911 F.2d 705, 709 (Fed. Cir. 1990) (explaining that a chemical composition and its properties are inseparable.).

Appellants argue that the claimed composition possesses significant benefit over the prior art. (App. Br. 6.) Appellant specifically argues that the inventive examples demonstrate that compositions having PIBSA (polyisobutene succinic anhydrides) dispersed in highly saturated oil having 90% or higher saturates content provided superior results. (App. Br. 7.)

When evidence of secondary considerations is submitted, we begin anew and evaluate the rebuttal evidence along with the evidence upon which the conclusion of obviousness was based. *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976). The burden of establishing unexpected results rests on Appellant. Appellant may meet this burden by establishing that the difference between the claimed invention and the closest prior art was an unexpected difference. *See In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972). The unexpected results must be established by factual evidence, and attorney statements are insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470–71 (Fed. Cir. 1997). Further, a showing of unexpected results supported by factual evidence must be reasonably commensurate in scope with the degree of protection sought by the claims

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on appeal. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035 (CCPA 1980).

We adopt the Examiner’s thorough review and explanation of the deficiencies in Appellants relied upon evidence. (Ans. 14–18.) We add the following.

Appellant does not direct us to portions of the Specification that acknowledges the data of Tables 1 and 2 demonstrates unexpected results. The Specification states “[t]he results show that performance generally improves as the PIBSA active matter % increases, but that the improvement is much more significant when the additive diluent is a high saturate oil.” (Spec. 21.) To show unexpected results, Appellant must not only show that the invention reflects different results than those of the prior art, but also “that the difference actually obtained would not have been expected by one skilled in the art at the time of invention.” *In re Freeman*, 474 F.2d 1318, 1324 (CCPA 1973) (citations omitted). Appellant has failed to explain why the results obtained are different from the results that would have been expected from Garner. Furthermore, it is not clear that the showing to which Appellant directs our attention compares the claimed invention against the closest prior art (Garner).

Obviousness double patenting

Claims 1–4 and 7–18 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting as unpatentable over claims 1– 7 of copending Application No. 14/267, 950 (now US 10,167,440) in view of Garner; and over claims 1– 16 of copending Application No. 14/494,620 (now US 9,353,330).

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Appellant argues neither co-pending Application 14/267,950; nor 14/494,620 disclose or claim a method of preparing a trunk piston marine engine lubricating oil composition as specified by the present application. (App. Br. 7.)

The claims on appeal are directed to (1) a method of preparing a trunk piston marine engine lubricating oil composition (claim 1); (2) a trunk piston marine engine lubricating composition (claim 15); and (3) a method of operating a trunk piston medium-speed compression-ignited marine engine (claim 16). Appellant's arguments have not disputed that applications 14/267,950 and 14/494,620 contained claims directed to one or more of the identified claim subject matter. Appellant has not presented a technical explanation disputing the Examiner's determination that the present claims are patently indistinct from the claims of applications 14/267,950 [in view of Garner] and 14/494,620. As discussed above, Appellant has not established that the present invention provides an unexpected performance improvement.

Claims 1–4 and 7–18 are rejected on the grounds of non-statutory obviousness-type double patenting as unpatentable over claims 1–7 of US 8,067,348 in view of Garner; claims 1–8 of US 8,071,517 in view of Garner; claims 1–7 of US 8,076,276 in view of Garner; claims 1–10 of US 8,609,599 in view of Garner; claims 1–10 of US 8,703,676 in view of Garner; and claims 1–8 of US 8,951,944 in view of Garner.

Appellant's arguments have not disputed that US patents 8,067,348; 8,071,517; 8,076,276; 8,609,599; 8,703,676; and 8,951,941 contain claims directed to one or more of the identified claim subject matter. Appellant has not presented a technical explanation disputing the Examiner's

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determination that the present claims are patently indistinct from the claims of US patents 8,067,348; 8,071,517; 8,076,276; 8,609,599; 8,703,676; and 8,951,941 each in view of Garner as explained by the Examiner. As discussed above, Appellant has not established that the present invention provides an unexpected performance improvement.

Accordingly, we sustain the Examiner’s obviousness rejections of claims 1–4 and 7–18 for the reasons presented by the Examiner and given above.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 7–18	103	Garner	1–4, 7–18	
1–4, 7–18		Non-statutory Double Patenting US Application 14/494,620	1–4, 7–18	
1–4, 7–18		Non-statutory Double Patenting US Application 14/267,950, Garner	1–4, 7–18	
1–4, 7–18		Double Patenting US 8,067,348, Garner	1–4, 7–18	
1–4, 7–18		Double Patenting US 8,071,517 Garner	1–4, 7–18	
1–4, 7–18		Double Patenting US 8,067,276, Garner	1–4, 7–18	
1–4, 7–18		Double Patenting US 8,609,599, Garner	1–4, 7–18	
1–4, 7–18		Double Patenting	1–4, 7–18	

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Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
		US 8,703,676, Garner		
1-4, 7-18		Double Patenting US 8,951,944, Garner	1-4, 7-18	
Overall Outcome			1-4, 7-18	

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

AFFIRMED