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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/115,766	08/01/2016	Ko ONODERA	172370	3665
25944	7590	10/01/2020	EXAMINER	
OLIFF PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			MCAVOY, ELLEN M	
			ART UNIT	PAPER NUMBER
			1771	
			NOTIFICATION DATE	DELIVERY MODE
			10/01/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KO ONODERA, SHUZO NEMOTO, TOMOHIRO KATO,
KOSUKE FUJIMOTO, and MINORU YAMASHITA

Appeal 2020-000375
Application 15/115,766
Technology Center 1700

Before BEVERLY A. FRANKLIN, JEFFREY R. SNAY, and LILAN REN,
Administrative Patent Judges.

FRANKLIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1 and 3–10. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on September 17, 2020.

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Exxonmobil Research and Engineering Co. and Toyota Jidosha Kabushiki Kaisha. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of Appellant's subject matter on appeal and is set forth below:

1. A lubricating oil composition adapted for use in a supercharged gasoline engine, comprising: a lubricating oil base oil, a compound having at least one element selected from calcium and magnesium a compound having at least one element selected from molybdenum and phosphorous, and an ashless dispersant having nitrogen; wherein,

X as determined from following equation (1):

$$X = ([Ca] + 0.5[Mg]) \times 8 - [Mo] \times 8 - [P] \times 30 \quad (1)$$

wherein [Ca], [Mg], [Mo] and [P] in equation (1) respectively represent the concentrations (wt%) of calcium, magnesium, molybdenum and phosphorous in the lubricating oil composition,

satisfies the expression $X \leq -1.68$;

Y as determined from following equation (2):

$$Y = [Ca] + 1.65[Mg] + [N] \quad (2)$$

wherein [Ca], [Mg] and [N] in equation (2) respectively represent the concentrations (wt%) of calcium, magnesium and nitrogen derived from ashless dispersant in the lubricating oil composition,

satisfies the expression $Y \geq 0.18$; and,

Z as determined from following equation (3):

$$Z = [N] / ([Ca] + [Mg]) \quad (3)$$

wherein [Ca], [Mg] and [N] respectively represent the concentrations (wt%) of calcium, magnesium and nitrogen derived from an ashless dispersant in the lubricating oil composition,

further satisfies the expression $0.3 \leq Z \leq 1.5$.

REFERENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
Kasai	US 7,820,599 B2	Oct. 26, 2010

REJECTION

Claims 1 and 3–10 are rejected under 35 U.S.C. § 103 as being unpatentable over Kasai.

OPINION

We review the appealed rejections for error based upon the issues Appellant identifies, 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.”). Upon review of the evidence and each of the respective positions set forth in the record, we find that the preponderance of evidence supports Appellant’s position in the record. Accordingly, we reverse the Examiner’s rejection on appeal

essentially for the reasons set forth in the record by Appellant, and add the following for emphasis.

We refer to the Examiner's position made on pages 3–5 of the Final Office Action and on pages 3–6 of the Answer.

Among other requirements, claim 1 requires that $X \leq -1.68$. It is the Examiner's position that although this claim requirement is not specifically met by the examples of Kasai, the entire disclosure of Kasai is not limited to the six examples therein, but more broadly teaches that the entire ranges of phosphorus, molybdenum, calcium, magnesium and nitrogen contents are acceptable for use in the lubricating oil compositions. Final Act. 5. The Examiner states that because Kasai teaches that the entire ranges of the elements are suitable, each of the various combinations of these elements would be presumptively effective in the disclosed lubricant compositions. *Id.* See also Ans. 5–6.

We agree with Appellant that while Kasai is not limited to the examples, the record before us lacks articulated reasoning, based on the disclosure of Kasai as a whole, as to why one of ordinary skill in the art would consider first, that the expression for X, i.e., $X = ([Ca] + 0.5[Mg]) \times 8 - [Mo] \times 8 - [P] \times 30$, is significant, and two, why amounts of Ca, Mg, Mo and O should be adjusted so that $X < -1.68$. Appeal Br. 7. We thus are persuaded that the rejection lacks proper motivation for the modifications as proposed by the Examiner in the rejection. Reply Br. 1–2. See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention

does.”); *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”); *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained); *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art”); *see also, e.g., In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In view of the above, we reverse the rejection.

CONCLUSION

We reverse the Examiner’s decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3–10	103	Kasai		1, 3–10

REVERSED