

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURENT CHAMBARD
and
TERENCE GARNER

Appeal No. 2004-1861
Application No. 09/846,483

HEARD: November 16, 2004

Before GARRIS, WARREN, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2004) from the examiner's final rejection of claims 1 through 8 and 10 through 17 (final Office action mailed Jul. 26, 2002), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to a trunk piston marine engine lubricating oil composition for a medium speed

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compression-ignited (diesel) marine engine (claims 1-8 and 11-16) and to a method of lubricating a medium speed compression-ignited marine engine (claims 10 and 17). Further details of this appealed subject matter are recited in representative claims 1 and 10 reproduced below:

1. A trunk piston marine engine lubricating oil composition for a medium speed compression-ignited (diesel) marine engine wherein the composition is dispersant-free and has a Total Base Number (TBN) of 25 or greater, and comprises:

- (A) an oil of lubricating viscosity, in a major amount, and added thereto:
- (B) an oil-soluble overbased metal detergent additive, as the sole overbased metal detergent, consisting of one or more aromatic carboxylates, in a minor amount, and
- (C) an antiwear additive, in a minor amount.

10. A method of lubricating a medium speed compression-ignited marine engine, which method comprises supplying to the engine the truck [sic] piston marine engine oil lubricating composition as claimed in claim 1.

The examiner relies on the following prior art references as evidence of unpatentability:

Clarke	4,283,294	Aug. 11, 1981
Fujitsu et al. (Fujitsu)	6,114,288	Sep. 05, 2000 (filed May 3, 1999)

Claims 1 through 8 and 10 through 17 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over either

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Clarke or Fujitsu. (Examiner's answer mailed Jul. 30, 2003, pages 3-6.)

We affirm these rejections. Because we are in complete agreement with the examiner's factual findings and legal conclusions, we adopt them as our own and add the following comments for emphasis.¹

Clarke

As the examiner notes (answer at 3-4), Clarke describes a lubricating oil composition for use in marine diesel engines comprising 60 to 85 parts by weight of lubricating oil, 15 to 30 parts by weight of a mixture of more than 50 wt.% of a Group IIa metal overbased detergent and up to 50 wt.% of a Group Ia metal overbased detergent, and 0.2 to 5 parts by weight of an antioxidant, provided that the weight ratio of the overbased detergent mixture to antioxidant is between 7.5:1 and 50:1, all parts by weight referring to total active matter of the additive. (Column 1, lines 17-28.) According to Clarke, the overbased detergent may be an overbased Ia or IIa metal

¹ The appellants submit that claims 10 and 17 should be considered separately from claims 1-8 and 11-16 and provide reasonably specific arguments in support thereof. We therefore select representative claims 1 and 10 from the two groups of claims and decide this appeal as to the examiner's grounds of

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salicylate, e.g., calcium salicylate (column 2, lines 43-46), which is an overbased detergent of interest to the appellants (Oils 1 and 2 of the working examples), and should have a TBN (ASTM D664) of between 175 and 500 (column 3, lines 28-31). Clarke further teaches that the lubricating oil may be an animal, vegetable, or mineral oil (column 1, lines 28-30), which are some of the same lubricating oils described as suitable for the invention in the present specification (page 4, lines 26-27). In addition, Clarke discloses that suitable antioxidants include zinc dialkyl dithiophosphates (column 4, lines 3-6), which are disclosed in the present specification as preferred antiwear additives (page 8, line 26 to page 10, line 8).

Given this disclosure in Clarke, we share the examiner's view that one of ordinary skill in the art would have been led, prima facie, to formulate a lubricating oil composition containing 60 to 85 parts by weight of an animal, vegetable, or mineral oil, 15 to 30 parts by weight of one or more Group Ia or IIa metal salicylates, and 0.2 to 5 parts by weight of zinc dialkyl dithiophosphate, thus arriving at a lubricating oil composition encompassed by appealed claim 1. Merck & Co. Inc.

rejection on the bases of these two representative claims. 37
CFR § 1.192(c)(7)(2003)(effective Apr. 21, 1995).

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v. Biocraft Labs. Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972); In re Susi, 440 F.2d 442, 445, 169 USPQ 423, 425 (CCPA 1971).

With respect to separately argued claim 10, we agree with the examiner's analysis (answer at 4) that one of ordinary skill in the art would have found it prima facie obvious to use Clarke's lubricating oil composition in any marine diesel engine, including the here recited "medium speed compression-ignited marine engine," as expressly taught by the reference.

The appellants argue that the experimental data in the specification (pages 12-14) "clearly demonstrate that compared to the dispersant-containing formulations representing conventional TPEO [trunk piston engine oil] compositions, the dispersant free compositions of the present invention actually provide improved piston deposit control." (Appeal brief at 5.) We, like the examiner (answer at 5-6), do not find the relied upon experimental evidence to be sufficient to rebut the examiner's prima facie case of obviousness. While Oils 1 and 2 are specific formulations made from an unidentified "basestock," 10.10 or 12.50 parts of an overbased calcium salicylate having a TBN of 168, 5.65 or 6.84 parts of an overbased calcium

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salicylate having a TBN of 280, and 0.61 part of a zinc dialkyldithiophosphate made from a primary C₈ alcohol, appealed claim 1 is significantly broader. Thus, we agree with the examiner (answer at 5-6) that the proffered showing is not commensurate in scope with the degree of patent protection desired. In re Kulling, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990)("[O]bjective evidence of nonobviousness must be commensurate in scope with the claims.") (quoting In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972)); In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979) ("The evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to which it pertains.").

The appellants contend that Clarke constitutes non-analogous art because its disclosure "would not have been considered relevant by one of ordinary skill in the art attempting to formulate a TPEO." (Appeal brief at 5.) This position lacks discernible merit.

The two separate tests for determining whether a prior art reference is analogous is as follows: (1) whether the art is from the same field of endeavor, regardless of the problem addressed; and (2) if the reference is not within the inventor's

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endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. In re Bigio, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1211-12 (Fed. Cir. 2004); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

Here, the appellants' own specification (page 1, lines 7-10) indicates to one of ordinary skill in the art that the claimed lubricating oil composition can be used for purposes other than TPEO including "auxiliary power generation applications" and "main propulsion stationary land-based engines..." In addition, one of ordinary skill in the art would have considered all lubricating compositions having a major amount of lubricating oil, a minor amount of one or more aromatic carboxylates, and a minor amount of a metal dialkyldithiophosphate. Contrary to the appellants' apparent belief, one of ordinary skill in the art would have considered the teachings of Clarke to be highly relevant in view of the similarities in terms of structure and function between the claimed composition and Clarke's composition. In re Bigio, 381 F.3d at 1326, 72 USPQ2d at 1212.

The appellants urge that Clarke's "lubricating oil compositions are not constantly circulated through the engine

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crankcase, are not intended to maintain insolubles in suspension over a prolonged operating period and thus, do not conventionally contain a dispersant." (Appeal brief at 6.) We note, however, that the appellants have not identified any evidence to indicate that Clarke's lubricating oil composition cannot be used as a TPEO. Also, as we discussed above, the appellants' relied upon evidence is insufficient to prove any unexpected result over the prior art because it is not commensurate in scope with appealed claims 1 and 10.

The appellants argue that "[c]laims 11 [sic, 10] and 17, expressly require the addition of a dispersant-free lubricating oil composition into the crankcase of a four-stroke diesel engine..." (Appeal brief at 7.) This argument is also unpersuasive because no such limitations are recited in appealed claim 10.

For these reasons, we uphold the examiner's rejection of all the appealed claims as unpatentable over Clarke.

Fujitsu

Fujitsu discloses lubricating oil compositions for internal combustion engines having excellent anti-wear properties with respect to moving valve parts in four-stroke engines. (Column 1, lines 5-9.) According to Fujitsu, the lubricating oil

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composition has a high temperature high shear viscosity according to ASTM D4683 of from 2.1 to less than 2.9 and comprises lubricating base oil (e.g., mineral oil), a specified zinc dialkyldithiophosphate so that the phosphorus content in the oil is from 0.04 to 0.12 mass%, a metallic detergent selected from (i) calcium salicylate and (ii) a mixture of calcium salicylate and magnesium salicylate so that the lubricating oil sulfated ash content according to JIS K2272 is from 0.8 to 1.8 mass%, and optionally at most 2.0 mass% of friction modifier. (Column 2, line 59 to column 3, line 13.) In the working examples, Fujitsu discloses the use of calcium salicylates having mass percents and TBN values ranging from 3.4 to 10.3 mass% and 80 to 340 mg/KOH/g, respectively. (Column 5, line 47 to column 9, line 5, e.g., Example 8.)

Given the teachings of Fujitsu, we find ourselves in full agreement with the examiner (answer at 4-5) that one of ordinary skill in the art would have been led, prima facie, to formulate a lubricating oil composition encompassed by appealed claim 1. While Fujitsu's examples teaches that additives such as ash-free dispersants may be included in the lubricating oil composition, such additives are taught as optional components. (Column 4, lines 50-53.)

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The appellants' argument (appeal brief at 5 and 7-8) that Fujitsu is non-analogous prior art is unpersuasive for the same reasons discussed above with respect to Clarke.

The appellants contend that Fujitsu does not disclose compositions having the here recited TBN of 25 or greater. (Appeal brief at 8.) We note, however, that metallic detergents C and D (calcium salicylate) of Fujitsu's examples have Ca contents of 7.2 and 10.3 mass% and TBN of 340 and 290 mg KOH/g, respectively.

The appellants urge that "[o]ne of ordinary skill in the art would be aware of the fact that crankcase lubricants formulated for car and truck engines conventionally contain ashless dispersant." (Appeal brief at 9.) This position lacks merit because the appellants fail to identify any evidence in the record to support this contention. Moreover, this contention appears to be contrary to the teachings of Fujitsu, which suggests that the use of ashless dispersant is optional.

The appellants argue that Fujitsu "fails to fairly suggest that formulating a lubricating oil composition with no overbased metal detergent other than the overbased metal salicylate detergent will provide any advantage." (Appeal brief at 10.) This argument is also unpersuasive. Fujitsu suggests that the

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use of only overbased metal salicylate will result in a useful lubricating oil composition having excellent anti-wear properties with respect to moving valve parts in four-stroke engines. (Column 1, lines 5-9.) As we discussed above, the appellants' relied upon evidence of unexpected results is insufficient because it is not commensurate in scope with the claims.

As to separately argued claim 10, the appellants argue that the claim "requires the addition of a dispersant-free lubricating oil composition into the crankcase of a four-stroke diesel engine." (Appeal brief at 11.) However, such a limitation is not recited in appealed claim 10. Moreover, the appellants fail to identify any evidence in support of the theory that Fujitsu's lubricating oil composition cannot be used for the same purposes disclosed in the present specification.

For these reasons, we uphold the examiner's rejection on this ground as well.

Summary

In summary, we affirm the examiner's rejections under 35 U.S.C. § 103(a) of appealed claims 1 through 8 and 10 through 17 as unpatentable over either Clarke or Fujitsu.

The decision of the examiner is affirmed.

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

AFFIRMED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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