The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SATOSHI OHTA,
JUN SUGIMOTO and HIROSHI WATANABE

Appeal 2007-2485
Application 10/142,750
Technology Center 1700

Decided: July 31, 2007

Before CHUNG K. PAK, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 25-34. We have jurisdiction under 35 U.S.C. § 6 (2006).

We AFFIRM.

Appellants' invention relates to a fuel additive containing an alkylene-oxide-adducted hydrocarbyl amide. According to Appellants, the alkylene-oxide-adducted hydrocarbyl amide is useful in a method for improving the acceleration response and the driving performance of internal combustion engines when used as fuel additives in hydrocarbon-based fuels, such as gasoline fuel (Specification 3-4). Representative independent claim 25, as presented in the Brief, appears below:

25. A method of improving the acceleration performance of gasoline automobile engines comprising additizing a fuel additive comprising an alkylene-oxide adducted hydrocarbyl amide having from 3 to 50 moles of alkylene oxide per mole of hydrocarbyl amide to a gasoline and operating said engine with said gasoline.

The Examiner relies on the following reference in rejecting the appealed subject matter:

Lin	WO 98/16599	Apr. 23, 1998

Claims 25-34 stand rejected under 35 U.S.C. § 102(b) as anticipated by Lin.[1]

Anticipation under 35 U.S.C. § 102 requires that a prior art reference describe each and every limitation of a claimed invention with "sufficient

[1] In rendering this decision, we have considered Appellants' position presented in the Brief filed August 8, 2006. Appellants have asserted that the claims will stand or fall together. We select claim 25 as representative of the rejected claims and will limit our discussion thereto.

specificity" to establish anticipation. *Atofina v. Great Lakes Chem. Corp*., 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006)).

The issue presented for review with respect to this rejection is: Does the Lin reference have a disclosure that anticipates the claimed subject matter? The issue turns on whether Lin describes a method for operating an internal combustion engine comprising a gasoline composition comprising a monoamide-containing polyether alcohol compound. We answer this question in the affirmative.

The Examiner finds that Lin describes a gasoline composition comprising a monoamide-containing polyether alcohol compound of the formula R, C(O)-NR_2R_3 wherein R_1, R_2, and R_3 are each independently selected from H, C_1 -C_{100} hydrocarbyl (alkyl or alkenyl) polyoxyalkylene alcohol of 2-200 carbon atoms with the proviso that one of R_1 -R_3 is polyoxyalkylene (Lin 3, ll. 5-22). Lin teaches that the compounds reduce intake valve deposits, control octane requirement increases and reduce octane requirement (Lin 3, ll. 22-26). Lin teaches that the deposits on the intake valves results in overall poor drivability, including stumbles during acceleration (Lin 3, ll. 9-13). Therefore, the Examiner correctly determines that the fuel composition of Lin necessarily improves acceleration performance by removal or reduction of intake valve deposits. The compounds contain up to 50 moles of the alkylene oxide wherein the alkylene oxide may be ethylene, propylene or butylene oxide

(Lin 28, ll. 12-17). The amide moiety of the compound may be derived from coconut diethanolamide (Lin 26, l. 2). Accordingly, the Examiner concludes that Lin teaches all the limitations of the claims and, therefore, anticipates the claims.

Appellants have not argued that the fuel additive comprising an alkylene-oxide adducted hydrocarbyl amide described in Lin is different from the fuel additive utilized in the claimed invention.

Rather, Appellants contend that Lin does not teach or suggest that any improvement in acceleration performance would have been expected from utilizing the described fuel additive (Br. 5). Appellants contend that Lin's disclosure relating to a gasoline additive that reduces intake valve deposits, controls octane requirements increases and reduces octane requirements would not necessarily correlate to an improvement in acceleration performance (Br. 6). Appellants contend that acceleration in the present invention refers to a decrease in acceleration time once the vehicle is in motion. Lin's discussion of acceleration is not the same as the claimed invention (Br. 6). Specifically Appellants state:

> Lin et al. discloses '*deposits on the intake valves results in overall poor drivability, including stumbles during acceleration'*. However, stumbling of a vehicle typically occurs upon acceleration from a standing stop. Acceleration in the present invention refers to a decrease in acceleration time once a vehicle is in motion, e.g. traveling speed. Furthermore, while characteristics of 'drivability, including stumbles' may be indicative of improvements in the smoothness or general operability of the vehicle, such characteristics do not

> necessarily reflect on the actual 'acceleration time' of a vehicle. The Examples of the present invention clearly demonstrate a decrease in acceleration time with the fuel additive of the present invention. These results are not taught or suggested by the disclosure of WO 98/16599 [Lin]. (Br. 6).

Appellants' contentions are not persuasive. Appellants have not argued that the fuel additive of Lin is not the same as the fuel additives utilized in the claimed method. Rather, Appellants argue that Lin does not recognize that improvement in acceleration performance would have resulted from utilizing the described fuel additive.

Even if the reduction of deposits in the intake valves, for example, does not translate into an improvement in acceleration performance, a person of ordinary skill in the art utilizing the fuel additive composition in a gasoline automobile engine as described by Lin would necessarily have been practicing the claimed invention. *Mehl/Biophile Int'l Corp. v. Milgraum,* 192 F.3d 1362, 1366, 52 USPQ2d 1303, 1307 (Fed. Cir. 1999) ("[W]here, 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 appreciate the results."); *In re Woodruff,* 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) ("It is a general rule that merely discovering and claiming a new benefit of an *old* process cannot render the process again patentable."); *accord In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

For the foregoing reasons and those presented in the Answer, the rejection of claims 25-34 under 35 U.S.C. §102(b) as anticipated by Lin is affirmed.

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)(2006).

AFFIRMED

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