

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* PATRICK MARK HAMILL  
And JAMES MARK MALLON

---

Appeal 2008-1605  
Application 10/851,250  
Technology Center 1700

---

Decided: March 4, 2008

---

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
CHARLES F. WARREN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1 and 3-11. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim a coolant composition comprising a polyphosphoric acid and glycol ether with a pH neutralizing additive.

Representative independent claim 1 reads as follows:

1. A coolant for treating a non-magnetic substrate of a magnetic recording medium, comprising a polyphosphoric acid and glycol ether, further comprising an additive to neutralize pH of the coolant, wherein the coolant produces a removal rate for the aluminum substrate of greater than 0.3 mil/min for at least 50 runs after dress of a grinding medium.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

Beaubien	2,825,693	Mar. 4, 1958
Hwa	4,066,398	Jan. 3, 1978
Matulewicz	4,514,315	Apr. 30, 1985
Nakatani	5,718,836	Feb. 17, 1998
Brady	GB 2 357 755 A	Apr. 7, 2001
Wenderoth	US 2003/0164470 A1	Sep. 4, 2003

Under 35 U.S.C. § 103(a):

claims 1, 3, 5-7, and 9-11 are rejected as being unpatentable over Matulewicz in view of Brady;

claims 1, 3, and 5-11 are rejected as being unpatentable over Wenderoth in view of Nakatani; and

claims 1, 3, and 4 are rejected as being unpatentable over Beaubien in view of Hwa.

Appellants have not separately argued dependent claims 3-11.

Therefore, these claims will stand or fall with independent claim 1.

For the reasons expressed in the Answer and below, we will sustain each of these rejections.

Concerning the rejection based on Beaubien in view of Hwa, there is no dispute on this record that Beaubien discloses each of the compositional

ingredients required by claim 1.<sup>1</sup> The Appellants have advanced the following two arguments against this rejection.

First, Appellants argue that the Examiner has not properly considered the claim 1 recitation "wherein the coolant produces a removal rate for the aluminum substrate of greater than 0.3 mil/min for at least 50 runs after dress of a grinding medium."<sup>2</sup> We do not agree. This recitation merely describes a characteristic of the claim 1 composition when used for a certain purpose. Appellants have not even alleged much less established that such recitation somehow distinguishes the claim 1 composition from the composition taught or suggested by Beaubien.

Appellants also argue that the Examiner has not properly considered the Specification data shown in Figure 3 which is said in the Brief to exhibit unexpected results (Br. 15). However, neither Figure 3 nor the discussion of this figure at Specification 17 characterizes the results in question as being unexpected. Moreover, these results do not compare the claim 1 composition to the applied prior art composition but instead to a composition containing "triethanolamine and the balance non-hazardous ingredients" (Spec. 17, para. [0035]). Because this latter composition does not appear to contain a single one of the ingredients required by claim 1, the composition

---

<sup>1</sup> The Examiner relies on Hwa solely for the potassium hydroxide features of dependent claims 3 and 4 (Ans. 7). Because these dependent claims have not been separately argued as previously indicated, a discussion of this reference is unnecessary for a complete disposition of the issues raised by this appeal.

<sup>2</sup> We observe that the above-quoted claim 1 phrase "the aluminum substrate" lacks antecedent basis.

can not be considered the closest prior art as correctly explained by the Examiner (Ans. 17).

For these reasons, we determine that the Examiner has established a prima facie case of obviousness with respect to claim 1 which Appellants have failed to successfully rebut with argument or evidence of nonobviousness. Accordingly, we sustain the Examiner's § 103 rejection of claims 1, 3, and 4 as being unpatentable over Beaubien in view of Hwa.

As for the other rejections on appeal, it is undisputed that (1) Matulewicz discloses all claim 1 ingredients except polyphosphoric acid which is taught by Brady as useful in compositions employed for the purpose desired by Matulewicz and (2) Wenderoth discloses all claim 1 ingredients except polyphosphoric acid which is disclosed by Nakatani as useful in compositions employed for the purpose desired by Wenderoth. According to the Examiner, it would have been obvious for one with ordinary skill in the relevant art to provide Matulewicz with polyphosphoric acid in view of Brady and to likewise provide Wenderoth with polyphosphoric acid in view of Nakatani (Ans. 3-6).

In addition to the unsuccessful arguments discussed above, Appellants contend that the applied prior art would not have suggested the selection and use of polyphosphoric acid as proposed by the Examiner (Br. 8-10, 12-13). This argument is unpersuasive. As correctly indicated by the Examiner (Ans. 4, 6), it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980). The idea of combining

Appeal 2008-1605  
Application 10/851,250

them flows logically from their having been individually taught in the prior art. *Id.* Furthermore, contrary to Appellants' belief, the disclosure of numerous effective ingredient combinations for the compositions of the applied prior art does not render any particular combination of ingredients less obvious. *Merck & Co. v. Biocraft Labs. Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989).

Therefore, we again determine that the Examiner has established a prima facie case of obviousness with respect to claim 1 which Appellants have failed to successfully rebut with argument or evidence of nonobviousness. It follows that we also sustain the § 103 rejections of claims 1, 3, 5-7, and 9-11 as being unpatentable over Matulewicz in view of Brady and of claims 1, 3, and 5-11 as being unpatentable Wenderoth in view of Nakatani.

The decision of the Examiner 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).

AFFIRMED

cam

SEAGATE TECHNOLOGY  
C/O DARBY & DARBY, P.C.  
P. O. BOX 770  
CHURCH STREET STATION  
NEW YORK, NY 10008-0770