

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte I-CHING CHIU,
SELDA GUNSEL
AND PAUL LACEY

Appeal 2008-1982
Application 10/253,126
Technology Center 1700

Decided: April 24, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
THOMAS A. WALTZ, *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 1-17, 22, 23, and 25-30. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim an environmentally friendly lubricant or oil, as well as a method for the manufacture thereof, comprising a transesterified triglycerol oil and a class of synthetic ester (e.g., a certain class of dibasic ester) different from the triglycerol oil.

Further details of this claimed subject matter are set forth in representative claim 1 which reads as follows:

1. An environmentally friendly lubricant, comprising:
 - a) a transesterified triglycerol oil; and
 - b) a first synthetic ester different from the triglycerol oil;

wherein the environmentally friendly lubricant is at least 60% biodegradable and has a gelation index less than about 12, and the first ester is a dibasic ester of a C₄-C₁₂ dicarboxylic acid reacting with 2 moles of C₁-C₁₂ alcohols, a tribasic ester product from a C₄-C₁₂ tricarboxylic acid reacting with 3 moles of C₁-C₂₀ alcohols or made by a fatty acid condensing with a triol or a polyol ester.

The reference set forth below is relied upon by the Examiner as evidence of obviousness:

Kodali 6,291,409 B1 Sep. 18, 2001

All appealed claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kodali.

According to Appellants, the claims on appeal stand or fall together (App. Br. 3, Reply Br. 3). Therefore, in assessing the merits of the rejection before us, we will focus on independent claim 1 with which the remaining claims will stand or fall.

For the reasons expressed in the Answer, the above-noted rejection will be sustained. We add the following comments for emphasis only.

On this record, Appellants do not dispute the Examiner's finding that Kodali discloses an environmentally friendly lubricant comprising a wide variety of components including the transesterified triglycerol oil and synthetic ester defined by appealed claim 1. The only issue on this appeal is whether the Examiner has correctly concluded that it would have been *prima facie* obvious for one with ordinary skill in this art to combine the transesterified triglycerol oil and synthetic ester defined by claim 1 and disclosed by Kodali.

Appellants argue that "[t]he recited oils [of Kodali] encompass so many thousands of variations and such a broad range of possible compositions, that no specific selection thereof can be said to be obvious" (App. Br. 4). In support of this argument, Appellants rely principally on *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994). See App. Br. 4, Reply Br. 5-6. This argument is unpersuasive.

As recently instructed by the Supreme Court, when a claim defines a combination of elements known in the prior art, the combination must do more than yield a predictable result. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007). In this regard, the Supreme Court explains that often it will be necessary to examine the effects of demands known to the design community or present in the market place as well as the background knowledge possessed by a person having ordinary skill in the art in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed. *KSR*, 127 S. Ct. at 1740-41. In

expressly rejecting an "obvious to try" argument in support of patentability, *KSR* states:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR, 127 S. Ct. at 1742.

In applying the *KSR* analysis to the facts of this appeal, we find that the design need or problem to be solved in Kodali is the selection of components disclosed therein for the purpose of formulating an environmentally friendly lubricant. While the number of suitable components disclosed in Kodali is arguably large, it is nevertheless finite. Moreover, since these components are taught by Kodali as suitable, each of the various combinations of these components would be presumptively effective as an environmentally friendly lubricant. That Kodali discloses a multitude of effective combinations does not render any particular formulation less obvious. *Merck & Co. v. Biocraft Labs.*, 874 F.2d 804, 807 (Fed. Cir. 1989).

For these reasons, an artisan would have anticipated success in combining the ingredients disclosed in the Kodali reference including the transesterified triglycerol oil and synthetic ester defined by claim 1. Therefore, an obviousness conclusion is warranted not only by the "obvious to try" standard of *KSR* but also by the more rigorous teaching, suggestion

or motivation test since the teachings of Kodali would have given an artisan a reasonable expectation that combining patentee's disclosed ingredients would have successfully produced an environmentally friendly lubricant.

See In re O'Farrell, 853 F.2d 894, 904 (Fed. Cir. 1988).

Contrary to Appellants' belief, *In re Baird*, 16 F.3d 380, does not demand a conclusion of nonobviousness under the facts of this appeal. The *Baird* case involved a claim to a flash fusible toner comprising a bisphenol A polyester containing an aliphatic carboxylic acid selected from the group consisting of succinic acid, glutaric acid, and adipic acid. The prior art reference disclosed the polymeric esterification product of a dicarboxylic acid and a diphenol having a generic formula with a broad range of variables thus encompassing a large number of different diphenols, one of which was bisphenol A. The claim was rejected under 35 U.S.C. § 103 over this reference, and the Board upheld the rejection. Our reviewing court, however, reversed because the prior art "appears to teach away from the selection of bisphenol A by focusing on more complex diphenols." *Baird*, 16 F.3d at 382. The Court explained that "[a] disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds." *Id.* at 383.

In contrast, the applied reference to Kodali would not have taught away from the ingredient combination defined by claim 1. To the contrary, an artisan would have had a reasonable expectation of anticipated success as previously explained. For this reason, the *Baird* decision is inapposite to the facts of this appeal.

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In light of the foregoing and for the reasons well stated in the answer, we sustain the Examiner's § 103 rejection of all appealed claims as being unpatentable over Kodali.

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

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