

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM G. BARRETT, JR

Appeal 2008-5141
Application 11/668,677
Technology Center 1700

Decided: September 18, 2008

Before PETER F. KRATZ, LINDA M. GAUDETTE, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 the final rejection of claims 16-20. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

INTRODUCTION

Appellant discloses a priming or lubricating composition that can be added to concrete or otherwise employed therewith to adjust the properties or to enhance and/or to facilitate the use thereof (Spec. ¶ [0002]; claim 16).

Claim 16 is illustrative:

16. A priming and lubricating composition for a concrete pump consisting essentially of a water-soluble, liquid polymeric material that, when mixed with a quantity of water sufficient to solvate the liquid polymeric material, forms a substantially neutral solution that is useful to lubricate a concrete pump and delivery conduit and improve the fluid characteristics of a concrete slurry delivered through the concrete pump.

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

Alexander	4,378,299	Mar. 29, 1983
Montgomery	5,997,633	Dec. 7, 1999

The rejections as presented by the Examiner are as follows:

1. Claims 16-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alexander.
2. Claims 16-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Montgomery.

Appellant argues claim 16 only. Appellant's arguments regarding claims 17-20 merely state what the claims recite (Br. 12-14), which do not amount to separate arguments regarding those claims. 37 C.F.R. § 41.37(c)(1)(vii) (2006). In fact, Appellant explicitly states that "it would be moot to argue that each of the references" fail to teach the claim features of claims 17-20 since the "liquid polymeric material" feature of claim 16, from which claims 17-20 depend, is not taught or suggested (Br. 12-13). We understand such statements to indicate that Appellant is separately arguing claim 16 only. Accordingly, claims 17-20 stand or fall with claim 16.

OPINION

35 U.S.C. § 103(a) REJECTIONS OVER ALEXANDER OR MONTGOMERY

Appellant argues that neither Alexander nor Montgomery teach or suggest a lubricating composition that starts with a liquid polymeric material (Br. 7-9). Appellant contends that Alexander and Montgomery disclose starting with dry, granular materials that are indicative of the prior art (Br. 7-8).

We have considered all of Appellant's arguments and are unpersuaded for the reasons below.

We agree with and adopt as our own the Examiner's analysis and factual findings on pages 3-8 of the Answer. We add the following for emphasis and completeness.

We begin our analysis by construing Appellant's claim 16. The claim recites a lubricating composition consisting essentially of a water soluble, liquid polymeric material that when mixed with a quantity of water to solvate the liquid polymeric material a substantially neutral solution is formed that is useful to lubricate a concrete pump (claim 16; Spec. ¶¶ [0021] and [0022]). The plain language of claim 16 and the Specification indicates that it is the mixture of the water and liquid polymeric material that forms the lubricating composition. Accordingly, we construe the priming and lubricating composition for a concrete pump of claim 16 as the mixture of water and polymeric material.

Alexander discloses a cable lubricating composition formed by mixing polyacrylamide polymers in a free flowing granular solid form with

water to form a stock solution to which a water-soluble cellulose derivative is added to form a gel useful as lubricant (Alexander, col. 3, ll. 63-68, col. 4, ll. 1-27).

Montgomery discloses materials added to concrete to adjust the properties or to enhance and/or to facilitate the use thereof (Montgomery, col. 1, ll. 15-17). Montgomery further discloses that the composition is a dry, particulate material comprised of a water soluble, inorganic, alkaline material in combination with a solvatable, organic, polymeric material which, when mixed with a quantity of water sufficient to dissolve the alkaline material and solvate the polymeric material, is broadly useful to improve the fluid characteristics of a concrete slurry (Montgomery, col. 5, ll. 3-9). The polymeric material used in the composition may be a copolymer of a polyacrylamide (Montgomery, col. 7, ll. 23-65).

Montgomery and Alexander each discloses that the lubricating composition is formed once the dry starting material is dissolved in water. Once Alexander's or Montgomery's dry, particulate starting material is dissolved to form the lubricating composition it would reasonably appear to be substantially identical to Appellant's claimed lubricating composition. In fact, Montgomery and Alexander, like Appellant (Spec. ¶ [0025]), use polyacrylamide as the polymeric material, which further supports the Examiner's finding that the prior art lubricating compositions are substantially identical to Appellant's claimed composition (Ans. 6, "[I]t is not clear that the claimed aqueous polymer composition differs from the prior art."). Stated differently, it reasonably appears that the difference in physical state between Appellant's liquid polymeric starting material and the

dry, particulate polymeric starting material of Alexander or Montgomery would become indistinguishable once dissolved in water.

Because Alexander's and Montgomery's lubricating compositions (i.e., the dissolved compositions) appear to be substantially identical to Appellant's claimed lubricating composition (i.e., the solvated composition), the burden was properly shifted to Appellant to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977).

Appellant's only evidence that the claimed lubricating composition is different than the prior art lubricating compositions are statements from the Specification, which indicate that prior art lubricating compositions starting with solid materials are difficult to use (e.g., the solid material requires mixing on site) (Br. 7-8; Spec. ¶¶ [0013]-[0014]). However, this evidence is directed to the starting material, not the lubricating composition end product (i.e., the polymeric material dissolved in water). None of Appellant's evidence shows any difference between the dissolved lubricating composition of Alexander or Montgomery and the solvated lubricating composition as claimed.¹ This is the required showing because Appellant's

¹ Appellant argues in response to the Examiner's finding that "colloidal dispersion" in paragraph [0024] of the Specification may reasonably include solid particulate polymeric material, that liquid-liquid colloidal dispersions may also exist. As such, Appellant contends that the disclosure in paragraph [0024] includes liquid-liquid colloidal dispersions. Though establishing that "colloidal dispersion" may include liquid-liquid dispersions and solid-liquid dispersions, such argument and evidence do not establish that the dissolved solid polymeric material (i.e., lubricating composition) of Alexander and Montgomery would not possess the characteristics of the solvated liquid polymeric material (i.e., Appellant's claimed lubricating composition).

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claim clearly states that the lubricating composition is not formed until the liquid polymeric material is solvated in water.

Accordingly, we determine that Appellant has not carried the burden of proving that the lubricating composition of Alexander or Montgomery does not necessarily or inherently possess the characteristics of the claimed product (i.e., the solvated, liquid polymeric material that forms the lubricating composition).

Therefore, we sustain the Examiner's § 103 rejections of claims 16-20 over Alexander or Montgomery.

DECISION

The Examiner's decision 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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