

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

Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal No. 2000-2192
Application 08/943,123

HEARD: July 15, 2003

Before PAK, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the first three grounds of rejection advanced on appeal: claims 72 through 86 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which appellant regards as the invention; claims 79 through 81 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and claims 72 through 86 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over Levy '389 and '251 in combination with Reick and Lewis et al. (Lewis).^{1,2,3} We refer to the examiner's answer and to appellant's brief and reply brief for a complete exposition of the opposing views of the parties.

In the first ground of rejection, the examiner contends (answer, pages 4 and 6) that the scope of the appealed claims exceeds the subject matter which appellant regards as his invention as set forth in the amendment filed July 1, 1998 (Paper No. 27; pages 9-11; *see* reply brief, pages 2-5 and attachment; *see also* brief, pages 12-14). We must agree with appellant that the statements in the amendment cannot reasonably be construed as a specific statement by appellant that his invention is limited solely to the subject matter relied on in argument presented in the amendment. *Compare In re Cormany*, 476 F.2d 998, 1001-02, 177 USPQ 450, 453 (CCPA 1973). Accordingly, we reverse this ground of rejection.

In the second ground of rejection, the examiner contends that there is no antecedent basis in appealed claim 78 for the mixture of water and a lubricant as an additional ingredient as set forth in each of appealed claims 79 and 80, because appealed claim 78 specifies that the "said material for decreasing friction is water" (answer, pages 4-5 and 7). We have carefully considered the respective positions of the examiner and appellant (brief, page 16-17; reply brief, pages 5-6). We interpret the transitional phrase "consisting essentially of" to open appealed claim 78 to include at least materials disclosed by the specification to be lubricating materials useful with superabsorbent polymers. *See generally, In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); *Ex parte Boukidis*, 154 USPQ 444 (Bd. App. 1966). Thus, the compositions containing water and a lubricating material encompassed by appealed claims 79 and 80 find antecedent basis in appealed claim 78 on which they directly depend, and accordingly, we reverse this ground of rejection.

In the third ground of rejection, the examiner contends that, *prima facie*, the combined

¹ Appended claims 72 through 86 are all of the claims in the application. *See* the appendix to the brief.

² Answer, pages 4-6.

³ The examiner withdrew grounds of rejection under 35 U.S.C. § 112, first paragraph, and second paragraph, except for the grounds of rejection under 35 U.S.C. § 112, second paragraph, set forth above.

teachings of the Levy references, Reick and Lewis would have suggested to one of ordinary skill in this art to use the superabsorbent solid organic polymer containing herbicidal delivery compositions and insecticidal compositions disclosed in the respective Levy references, either alone or with other additives as shown by Reick and Lewis, in a method of applying a lubricant composition to a surface because the “surface” to be lubricated is not specified in the appealed claims. In doing so, the examiner takes the position that appellant has not established that the combination of references would not produce lubricating properties when applied to a substrate, that the polymers of Lewis and Reick are not the superabsorbent polymers required by the claims, and that the Levy reference are non-analogous art (answer, pages 5-6 and 7-8). Appellant submits that the examiner has not established why one of ordinary skill in this art would have combined the teachings of the Levy references drawn to herbicidal and insecticidal compositions with the lubricant compositions of Reick and Lewis, pointing out the Levy references are nonanalogous prior art and that the examiner has not established that the polymers of Reick and Lewis are superabsorbent polymers (reply brief, pages 6-7 and 8-10; *see also* brief, pages 18-22).

In order to establish a *prima facie* case of obviousness, the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant’s disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

We agree with appellant that the examiner has not established on this record that one of ordinary skill in this art would have combined the Levy references with Reick and Lewis. We

fail to find in the record any evidence or a scientific reasoning establishing that the use of polymers in lubricant compositions by Reick and Lewis or other teachings of these references would have suggested to one of ordinary skill in this art to use the superabsorbent polymer containing herbicidal and insecticidal compositions of Levy either alone or combined with other ingredients used in lubricants, as lubricant compositions in a process of applying a lubricant composition to a surface. Indeed, the examiner has the initial burden to establish the factual foundation for the *prima facie* case of obviousness, including the evidence establishing why one of ordinary skill in the art would have combined the references, and only then does the burden shift to appellant to submit argument in rebuttal. *See generally, Lee, supra; Oetiker, supra.* Thus, the examiner must carry the burden of establishing that, *prima facie*, the polymers of Reick and/or Lewis are superabsorbent polymers *per se* as specified in appealed claim 72, and can absorb greater than about 100 times its weight in water as specified in the remaining appealed claims before the burden shifts to appellant to establish otherwise. The disclosure of the superabsorbent polymer with water and oil in the Levy references as noted by the examiner does not establish that these references are analogous prior art because the Levy references are not within the field of appellant's endeavor which is the lubricant arts, and are not reasonably pertinent to the particular problem of applying lubricants to a surface which appellant is attempting to solve. *See In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Thus, we conclude that the examiner has not pointed to some teaching, suggestion or motivation in the prior art to combine the applied references, and accordingly, we reverse this ground of rejection.

We summarily affirm the fourth ground of rejection advanced on appeal because appellant has stated the intention to file a terminal disclaimer to obviate the rejection of appealed claims 72 through 86, which are all of the appealed claims, under the judicially created doctrine of obviousness-type double patenting over copending application 08/943,125 (brief, page 4; reply brief, page 7).

The examiner's decision is affirmed.

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