

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE R. ZEHLER

Appeal No. 2001-1249
Application 08/658,341

ON BRIEF

Before KIMLIN, OWENS and TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the refusal to allow claims 8, 16, 24-29, 31-34 and 40-44 as amended after final rejection. These are all of the claims remaining in the application.

THE INVENTION

The appellant's claimed invention is directed toward a grease formulation which includes a base stock and a thickener. Claim 27 is illustrative:

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27. A grease formulation comprising a mixture of (1) an environmentally friendly inorganic thickener or a gelling agent additive thickener, and (2) a base stock, said base stock consisting essentially of a neopentyl polyol ester consisting essentially of the reaction product of a neopentyl polyol and a C₁₂-C₂₀ monocarboxylic acid, said base stock having the following characteristics:

(i) flash point of 175°C;

(ii) kinematic viscosity of less than 15 cSt at 100°C;

and a biodegradability of ≥ 70%, as determined by CEC-L-33-T-82.

THE REFERENCES

Mores et al. (Mores)	4,066,789	Jan. 3, 1978
Tubbs et al. (Tubbs)	4,557,839	Dec. 10, 1985
Zehler et al. (Zehler '990)	4,589,990	May 20, 1986
Zehler et al. (Zehler '840)	4,601,840	Jul. 22, 1986
Mullin	4,780,229	Oct. 25, 1988
King	4,965,001	Oct. 23, 1990
Schmid et al. (Schmid)	5,057,247	Oct. 15, 1991

THE REJECTION

Claims 8, 16, 24-29, 31-34 and 40-44 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Schmid, Mullin, Zehler '990, King, Tubbs, Zehler '840 and Mores.

OPINION

We affirm the aforementioned rejection.

The appellant states (brief, page 4): "Claims 27, 8, 16, 28, 29 and 31 may be considered to stand or fall together, but not

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claims 25 and 32-34. Further, claims 24, 40, 41, 43 and 44 may be considered to stand or fall together, but not claim 26." We address the claims separately to the extent justified by the appellant's arguments. See *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979); *In re Herbert*, 461 F.2d 1390, 1391, 174 USPQ 259, 260 (CCPA 1972); 37 CFR § 1.192(c)(7) (1997).

King discloses a lubrication blend which consists essentially of at least one complex sulfide of antimony having a specified formula, at least one antimony oxide, and at least one lamellar crystalline solid lubricant (col. 1, lines 39-49). The lubrication blend can be combined with any suitable lubricant base, the exemplified lubricant bases including greases and synthetic fluids (col. 3, lines 31-38). The synthetic fluids can, and often do, include a thickener (col. 3, lines 56-57). Because the thickeners disclosed by King (col. 3, lines 57-61) are the same as those disclosed by Tubbs (col. 2, lines 6-9) for forming a grease, it reasonably appears that King's mixture of synthetic lubricant and thickener is a grease. King's thickeners include soaps, which are among the appellant's gelling agent additive thickeners (specification, page 4, lines 19-23), and silica and clay, which are among the appellant's inorganic thickeners (specification, page 12, lines 21-23). King's silica

and clay are "environmentally friendly" as that term is used by the appellant.¹

King discloses a wide range of exemplified synthetic lubricants (col. 3, lines 48-56), one of which (trimethylolpropane tripelargonate) is among the second neopentyl polyol esters encompassed by the appellant's claim 40. King does not disclose that the synthetic lubricant can be the reaction product of a neopentyl polyol and a C₁₂-C₂₀ monocarboxylic acid as recited in both of the appellant's independent claims 27 and 40. However, King indicates that any synthetic fluid having lubricating viscosity is suitable as the lubricating base (col. 3, lines 48-49). Two such synthetic fluids which are among the neopentyl polyol esters encompassed by the appellant's claim 27 and the first neopentyl polyol esters encompassed by the appellant's claim 40 are, as indicated by Zehler '990 (col. 14, lines 22-23 and 52) and Zehler '840 (col. 14, lines 48-49; col. 15, lines 9-10), trimethylolpropane triisostearate and trimethylolpropane trioleate. Mullin also indicates that trimethylolpropane triisostearate has a lubricating viscosity, and discloses its use in combination with trimethylolpropane

¹ The appellant indicates that as used by the appellant, "environmentally friendly" refers to thickeners which are naturally occurring (specification, page 12, lines 23-26).

tripelargonate, which is among the second neopentyl polyol esters encompassed by the appellant's claim 40 (col. 8, lines 36-37).² Consequently, the use of trimethylolpropane triisostearate, trimethylolpropane trioleate, or a mixture of trimethylolpropane triisostearate and trimethylolpropane tripelargonate as King's lubricant base would have been fairly suggested to one of ordinary skill in the art by the applied prior art. Because these synthetic lubricants are among those recited in the appellant's claims 27 and 40, they necessarily have the flash point, kinematic viscosity and biodegradability recited in those claims. See *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963) ("From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing.")³

The appellant argues that each of the applied references lacks some element of the invention recited in claims 27 and 40 (brief, pages 4-6). This argument is not well taken because the

²Because trimethylolpropane triisostearate is disclosed by the Zehler references and Mullin, the appellant's argument that this compound is not disclosed by Schmid (brief, page 4) is not convincing.

³Hence, the appellant's argument that the references do not address biodegradability (brief, pages 4-5) is not persuasive.

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appellant is attacking the references individually when the rejection is based on a combination of references. See *In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968). As discussed above, the combined teachings of the references would have fairly suggested, to one of ordinary skill in the art, each of the elements recited in these claims.

We therefore conclude that the appellant's claimed invention would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Accordingly, we affirm the examiner's rejection.

DECISION

The rejection of claims 8, 16, 24-29, 31-34 and 40-44 under 35 U.S.C. § 103 over the combined teachings of Schmid, Mullin, Zehler '990, King, Tubbs, Zehler '840 and Mores is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

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