

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte DOUGLAS G. PLACEK and SUNDEEP G. SHANKWALKAR

---

Appeal No. 95-2149  
Application No. 08/026,039<sup>1</sup>

---

ON BRIEF

---

Before KIMLIN, GARRIS and PAK, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-14, all the claims in the present application. Claim 1 is illustrative:

---

<sup>1</sup> Application for patent filed March 4, 1993.

Appeal No. 95-2149  
Application No. 08/026,039

1. An improved fire resistant hydraulic base fluid composition having a specific gravity of less than 1.03, and a four-ball wear scar of less than .9 mm, the improvement consisting essentially of 1 to 12 parts by weight of a trialkoxyalkyl phosphate ester, each alkoxyalkyl moiety containing about 6 to 10 carbon atoms, and 1 part by weight of an ester or a mixture of esters selected from the group consisting of a trialkyl ester of phosphoric acid and C4-C8 alkyl alcohols, a triaryl phosphate ester wherein the aryl groups are partially C3 to C4 alkylated phenols, and a trialkyl phosphite ester having a pour point of less than -50EC, each alkyl group of the trialkyl phosphite ester containing from 8 to 12 carbon atoms.

The examiner relies upon the following references as evidence of obviousness:

Sheratte (Sheratte '324)	3,849,324	Nov. 19, 1974
Sheratte (Sheratte '129)	4,001,129	Jan. 4, 1977
Takao et al. (European '932) (European patent application)	0 135 932	Apr. 3, 1985

Appellants' claimed invention is directed to a fire resistant hydraulic base fluid consisting essentially of a trialkoxyalkyl phosphate ester and a trialkyl phosphite ester. A suitable trialkoxyalkyl phosphate ester is tributoxyethyl phosphate, while triisooctyl phosphite is an example of an trialkyl phosphite ester.

Appealed claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over European '932.

Appeal No. 95-2149  
Application No. 08/026,039

Upon careful consideration of the opposing arguments presented on appeal, we concur with appellants that the examiner has not established a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

European '932 discloses a lubricant comprising (1) a lubricating oil, such as mineral oil, (2) a condensed phosphorus compound and (3) at least one organic compound containing phosphorus, sulfur or chlorine as an extreme pressure agent. In the paragraph bridging pages 6 and 7, the reference discloses that the organic compounds containing phosphorus for use as the extreme pressure agent can be phosphite esters, such as triisooctyl phosphite, and phosphate esters, such as tributoxyethyl phosphate. As a result of this disclosure, the examiner concludes that "European patent '932 requires the presence of each of the claimed components in a single composition" (sentence bridging pages 4 and 5 of Answer). However, the examiner overstates the teaching of the reference. European '932 actually teaches that the third component can be at least one of organic compounds containing phosphorus, sulfur or chlorine. When the organic compound is

Appeal No. 95-2149  
Application No. 08/026,039

one containing phosphorus, it can be selected from a quite extensive list that includes triisooctyl phosphite and tributoxyethyl phosphate, two compounds which make up the claimed composition. Accordingly, it can be seen that the examiner errs in stating that European '932 requires the presence of the claimed components. Nonetheless, the reference does render obvious within the meaning of § 103 a lubricant comprising appellants' claimed components.

However, as urged by appellants, the claimed composition is one "consisting essentially of" a trialkoxyalkyl phosphate ester and a trialkyl phosphite ester. It is well settled that claim language "consisting essentially of" limits the scope of the claim to the ingredients specified therein and those that do not materially affect the basic and novel characteristics of the claimed composition. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). In the present case, European '932 discloses lubricating compositions comprising 100 parts by weight of the lubricating oil, 2-20 parts by weight of the condensed phosphorus compound and 5 to 30 parts by weight of the organic compound containing phosphorus. On the other hand, appellants' specification does not disclose that the



Appeal No. 95-2149  
Application No. 08/026,039

	)	
	)	
	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CHUNG K. PAK	)	
Administrative Patent Judge	)	

Appeal No. 95-2149  
Application No. 08/026,039

FMC Corp.  
Chemical Patents, Trademarks  
& Licensing  
1735 Market St.  
Philadelphia, PA 19103