

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(2) is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASANOBU KITANAKA

Appeal No. 95-2657
Application 07/980,637¹

HEARD: Jul. 16, 1998

Before KIMLIN, GARRIS, and WALTZ, Administrative Patent
Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the
examiner to allow claims 2 through 7 as amended subsequent to

¹ Application for patent filed November 24, 1992.

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the final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to a method for the lubrication of an automatic transmission of a motor car with a fluid comprising an overbasic oil-soluble metal salt and a compound derived from a polyolefin having a molecular weight of 300 to 3000, said compound having a long-chain alkyl group and an amino group in the same molecular structure. Further details of this appealed subject matter are apparent from a review of independent claim 2 which reads as follows:

2. A method for the lubrication of an automatic transmission of a motorcar which comprises lubricating the automatic transmission with an automatic transmission fluid comprising, on the basis of the total amount of composition, as essential components, 0.01 to 20% by weight of an overbasic oil-soluble metal salt (a) prepared by use of an alkaline-earth metal borate, and 0.01 to 15% by weight of a compound (b) derived from a polyolefin having a molecular weight of 300 to 3000, said compound (b) having a long-chain alkyl group and an amino group in the same molecular structure selected from the group consisting of succinimide and derivatives thereof, benzylamine, polyalkylamine, and polyoxyalkylane aminoamide, the balance being lubricating base oil.

The reference relied upon by the examiner as evidence of obviousness is:

Inoue et al. 0,447,916 Sep. 25, 1991
(Inoue) (EP)

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The claims on appeal are rejected under 35 U.S.C. § 103 as being unpatentable over Inoue.

We refer to the brief and the reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejection.

OPINION

For the reasons set forth below, we cannot sustain the examiner's rejection.

The issue we consider pivotal to this appeal and the examiner's position with respect thereto are expressed by the examiner on page 4 of the answer as follows:

Appellants [sic] argue that the instant claims are drawn to a method for lubricating an automatic transmission which differs from the prior art which does not mention such a use. This is not deemed to be persuasive since the composition of the prior art is taught as an engine oil suitable for use in gasoline engines, diesel engines and the like. Appellants [sic] method of use as an automatic transmission fluid is not seen to be patentably distinct over the engine oil composition of the prior art.

We do not share the examiner's above noted position. Even assuming the composition of Inoue corresponds to the composition recited in the appealed claims, we find nothing in

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the here applied reference (and the examiner points to nothing specifically) which would have suggested using the engine lubricating oil composition thereof as an automatic transmission lubricating fluid in accordance with the appellant's claims. Stated otherwise, the examiner has proffered no probative basis and we perceive none independently which supports her aforequoted conclusion that the here claimed method for lubricating an automatic transmission "is not seen to be patentably distinct over the engine oil composition of [Inoue]".

In light of the foregoing, we cannot sustain the examiner's section 103 rejection of claims 2 through 7 as being unpatentable over Inoue.

The decision of the examiner is reversed.

REVERSED

Edward C. Kimlin)
Administrative Patent Judge)
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PATENT	Bradley R. Garris) BOARD OF
	Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
	Thomas A. Waltz)
	Administrative Patent Judge)

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