

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID F. McCREADY

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Appeal No. 95-3834  
Application 07/947,569<sup>1</sup>

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ON BRIEF

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

HANLON, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed September 21, 1992.

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DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the rejection of claims 1-12, all of the claims pending in the application. Claims 1 and 9 are representative of the subject matter on appeal and read as follows:

1. A dry engine oil additive comprising the mixture of a granular metal alloy material and granular polytetrafluoroethylene (PTFE), wherein the granules are micron to sub-micron in diameter; the granulated metal alloy material for being peened and burnished to bearing surfaces in an engine and the PTFE granules for being embedded within the matrix formed thereby.

9. The method of lubricating an engine and repairing surface abrasions on bearing surfaces comprising adding a supply of a mixture of a granulated metal alloy metal and polytetra-fluoroethylene (PTFE) granules having micron to submicron sizes to an oil supply within an engine, running the engine for a time sufficient to cause the granules of the granulated metal alloy material to be peened and burnished to bearing surfaces within the engine, thereby embedding PTFE granules within the matrix of granulated metal alloy material formed by the peening and burnishing.

The references relied upon by the examiner are:

Cairns	3,994,814	Nov. 30, 1976
McCready	4,888,122	Dec. 19, 1989

The sole issue in this appeal is whether claims 1-12 were properly rejected under 35 U.S.C. § 103 as being unpatentable over the combination of McCready and Cairns.

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The claimed invention

Appellant claims a dry engine oil additive comprising a mixture of a granular metal alloy material and a granular polytetrafluoroethylene. In a preferred embodiment of the invention, titanium oxide or titanium dioxide granules may be added to the mixture (Specification, p. 2). Claim 9 recites a method of lubricating an engine and repairing surface abrasions therein comprising (1) adding a supply of the mixture of granulated metal alloy and polytetrafluoroethylene to an oil supply within an engine and (2) running the engine for a sufficient period of time to cause the metal alloy to be burnished to bearing surfaces within the engine whereby the polytetrafluoroethylene is embedded within the matrix of the metal alloy.

Rejection under 35 U.S.C. § 103

Claims 1-12 are rejected under 35 U.S.C. § 103 as being unpatentable over the combination of McCready and Cairns. We reverse this rejection.

McCready discloses an engine oil additive lubricant comprising a first polytetrafluoroethylene powder, a second polytetrafluoroethylene powder and titanium dioxide. The

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lubricant disclosed in McCready does not contain a granular metal alloy material.

Cairns relates to bearing compositions and a method of forming the compositions into bearing elements. The bearing compositions comprise a major portion of a thermoplastic resin other than polytetrafluoroethylene and a minor portion of a filled polytetrafluoroethylene material. The filled polytetrafluoroethylene material comprises a polytetrafluoroethylene polymer, a first filler material and a second filler material. The first filler material includes titanium oxide, and the second filler material includes copper alloy (col. 1, line 65-col. 2, line 15). Preferably, the bearing materials are initially in dry powder form (col. 5, lines 3-5). However, the materials are subsequently mixed together and formed into bearings using injection molding and hot extrusion methods (col. 2, lines 15-17).

According to the examiner (Answer, p.4):

One would have been motivated to . . . [modify the dry powder lubricant of McCready by additionally adding a metal alloy] because of the statement in Cairns [sic] at column 3, line 52: "The lubricant [ie. the PTFE] is more effective by virtue of its having something to hang onto as contrasted to just being in contact with a smooth steel surface."

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However, a closer reading of Cairns reveals that (col. 3,  
lines  
40-47):

The first filler material [e.g., titanium oxide], .  
. . provides an anchor for the transfer film of  
lubricating polytetrafluoroethylene. This holds the  
lubricant to make maximum use of those properties  
which result in an improvement in wear and low  
friction.

Compare appellant's specification, p. 2 ("The granulated alloy  
material is peened and burnished to the bearing surfaces,  
thereby entwining and embedding the granules of PTFE within a  
matrix formed thereby."); see also claim 9.

Therefore, we agree with appellant that nothing in the  
Cairns reference teaches, suggests or motivates one of  
ordinary skill in the art to add a metal alloy material to the  
dry lubricant powders disclosed in McCready. See In re  
Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir.  
1991) (in a determination under 35 U.S.C. § 103 it is  
impermissible to simply engage in a hindsight reconstruction  
of the claimed invention, using the applicant's structure as a  
template and selecting elements from references to fill the  
gaps; the references themselves must provide some teaching

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whereby the applicant's combination would have been obvious).

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Remand to the examiner

Upon return of this application to the examiner, the examiner should determine whether the teachings of Cairns alone anticipate or render obvious the composition of claims 1-8. As pointed out above, Cairns discloses a bearing composition comprising a filled polytetrafluoroethylene material wherein a first filler material may be titanium dioxide and a second filler material may be a copper alloy. Cairns further discloses that the polytetrafluoroethylene may be granular or in the form of fine particles and the first and second filler materials are preferably in the form of a fine powder (col. 3, lines 21-24; col. 4, lines 3-8). See Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1558, 35 USPQ2d 1801, 1804 (Fed. Cir. 1995), cert. denied, 116 S. Ct. 2554 (1996)(claims drawn to a composition read on a composition that contains the specified ingredients at any time from the moment at which the ingredients are mixed together and are not limited to the final end product).

Although the composition disclosed in Cairns contains an additional thermoplastic resin, the claims do not exclude a composition including other additional materials which are not

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claimed. In re Baxter 656 F.2d 679, 686, 210 USPQ 795, 802

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(CCPA 1981) ("the term 'comprises' permits the inclusion of other steps, elements, or materials").

Conclusion

For the reasons stated above, the rejection of claims 1-12 as being unpatentable under 35 U.S.C. § 103 over the combined teachings of McCready and Cairns is reversed. The case is remanded to the examiner to consider whether the teachings of Cairns alone either anticipate or render obvious the composition of claims 1-8.

REVERSED AND REMANDED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
ADRIENE LEPIANE HANLON	)	
Administrative Patent Judge	)	

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James C. Wray  
1493 Chain Bridge Road  
Suite 300  
McLean, Virginia 22101