

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JACOB EMERT, MALCOLM WADDOUPS  
and ROBERT D. LUNDBERG

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Appeal No. 1996-0047  
Application No. 08/047,758<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, PAK and WALTZ, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

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<sup>1</sup> Application for patent filed April 14, 1993. According to appellants, this application is a continuation of Application No. 07/680,204 filed April 4, 1991, now abandoned; which is a continuation of Application No. 07/378,895 filed July 12, 1989, now U.S. Patent No. 5,118,432 issued June 12, 1992; which is a continuation of Application No. 07/095,056 filed September 9, 1987, now U.S. Patent No. 4,863,624 issued September 5, 1989; which is a continuation-in-part of Application No. 07/032,066 filed March 27, 1987, now abandoned; which is a continuation of Application No. 06/754,001 filed July 11, 1985, now abandoned.

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### DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 33 which are all of the claims pending in the application.

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. An oil soluble dispersant mixture useful as an oil additive comprising:

(A) from about 10 to 90 weight percent of a first dispersant comprising a first hydrocarbyl substituted monocarboxylic acid producing material formed by reacting a first olefin polymer of C<sub>2</sub> to C<sub>10</sub> monoolefin having a number average molecular weight of about 1500 to 5,000 and a first monounsaturated mono acid material selected from the group consisting of acrylic acid, methacrylic acid, crotonic acid, and cinnamic acid,, said first acid producing material having an average of 1.05 to 1.25 monocarboxylic acid producing moieties, per molecule of said first olefin polymer present in the reaction mixture used to form said first acid producing material, and (b) a first nucleophilic reactant selected from the group consisting of amines, alcohols, amino-alcohols and mixtures thereof; and

(B) from about 90 to 10 weight percent of a second dispersant comprising a second hydrocarbyl substituted monocarboxylic acid producing material formed by reacting a second olefin polymer Of C<sub>2</sub> to C<sub>10</sub> monoolefin having a number average molecular weight of about 700 to 1150 and a second monounsaturated mono acid material selected from the group consisting of acrylic acid, methacrylic acid, crotonic acid, and cinnamic acid, said second acid producing material having an average of 1.2 to 2.0 monocarboxylic acid producing

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moieties, per molecule of said second olefin polymer present in the reaction mixture used to form said second acid producing material; and (b) a second nucleophilic reactant selected from the group consisting of amines, alcohols, amino alcohols and mixtures thereof.

Claims 1 through 33 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking descriptive support for the claimed subject matter in the disclosure as originally filed; lacking an enabling disclosure for the claimed subject matter and lacking a best mode of carrying out the claimed subject matter. We reverse.

At the outset, we note that appellants request that we review the objection to the specification under 35 U.S.C. § 132 and 35 U.S.C. § 112. However, we will not exercise our jurisdiction over this matter because the newly inserted phrases in the specification do not affect the claims or the rejection in question. Specifically, the claims do not include such newly inserted phrases. Rather, they only recite those specific species of monocarboxylic acids, which are explicitly described in the application disclosure as originally filed. The newly inserted phrases, however, are directed to a subgenus of monocarboxylic acids, which is not explicitly described in the original application disclosure.

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Accordingly, appellants' remedy regarding this matter is through petition to the Commissioner under 37 CFR § 1.181 and § 1.191.

We now turn to the rejection of claims 1 through 33 under 35 U.S.C. § 112, first paragraph. The examiner takes the position that the disclosure as originally filed (1) lacks descriptive support for the subject matter presently claimed; (2) lacks an enabling disclosure for the subject matter presently claimed; and (3) lacks the best mode of practicing the subject matter presently claimed. We do not subscribe to any of the examiner's positions for substantially those reasons set forth in the Brief and the Reply Brief. We add the following primarily for emphasis and completeness.

We initially note that the written description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. ***See Vas-Cath Inc. v. Mahurkar***, 935 F.2d 1555, 1561-63, 19 USPQ2d 1111, 1115-17 (Fed. Cir. 1991); ***In re Barker***, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), ***cert. denied***, 434 U.S. 1064, 197 USPQ 271 (1978). With respect to the written

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description requirement under 35 U.S.C. § 112, first paragraph, the court stated in *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. (citations omitted)

In the present case, we agree with appellants that the application disclosure as originally filed reasonably conveys to one of ordinary skill in the art that appellants (inventors) had possession of the presently claimed oil dispersant mixture. We find that the specification as originally filed describes the claimed first and second hydrocarbyl substituted monocarboxylic acid producing materials which are formed by reacting particular olefins and a monocarboxylic acid selected from the group consisting of acrylic acid, methacrylic acid, crotonic acid and cinnamic acid. See specification, pages 9 and 10. Accordingly, we reverse the examiner's decision rejecting claims 1 through 33

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as lacking the written description for the presently claimed subject matter in the original application disclosure.

With respect to the enablement requirement under 35 U.S.C.

§ 112, first paragraph, we observe that the test is whether one of ordinary skill in the art could make or use the claimed invention from the disclosure, as filed, coupled with information known in the art without undue experimentation. **See United States v. Telectronics, Inc.**, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), **cert. denied**, 490 U.S. 1046 (1989); **In re Wands**, 858 F.2d 731, 737 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). It is incumbent upon the examiner to initially produce reasons that substantiate a rejection based on lack of enablement. **See In re Marzocchi**, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1974). In other words, the examiner must supply a reasonable basis to question the adequacy or accuracy of appellants' presumptively correct disclosure. **Marzocchi**, 439 F.2d at 224, 169 USPQ at 370. The examiner's reasoning must take into account, **inter alia**, those

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factors enumerated in **Ex parte Forman**, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Here, the examiner states (Answer, page 7) that:

Appellant indicates that the subject matter of the instant claim is commensurate with the scope of the written disclosure in that the four monocarboxylic acids recited in the claims are the same four monocarboxylic acids disclosed in the original specification. The examiner agrees with appellants' statement and further point out that the claims as originally filed were directed only to dicarboxylic acids. The four monocarboxylic acids are only mentioned on page 10, lines 18-19 of the specification and are not mentioned anywhere else throughout pages 1-52 of the specification including the examples and data, as well as, the claims as originally filed in the parent application.

However, the examiner has not explained why such a limited disclosure on monocarboxylic acids does not enable one of ordinary skill in the art to make and use the claimed subject matter without undue experimentation. The examiner simply has not taken into consideration in her analysis, *inter alia*, the nature of the invention involved and information known to those skill in the art. In this regard, we observe that the examiner has not responded to appellants' arguments and evidence referred to at page 7 of the Brief. According to

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appellants (Brief, page 7), the evidence proffered is said to show that the use of mono and dicarboxylic acids to prepare hydrocarbyl substituted mono or dicarboxylic acid producing materials was known to those skill in art at the time of the invention. This statement has not been refuted by the examiner. On this record, we are of the view that the examiner simply fails to demonstrate that one of ordinary skill in this art would not know how to make and use the claimed invention without undue experimentation. This being the case, we reverse this rejection as well.

With respect to the best mode requirement under 35 U.S.C. § 112, first paragraph, we are aware that the appellants must disclose the best mode known to them at the time a patent application is filed. ***Spectra-Physics, Inc. v. Coherent, Inc.***, 827 F.2d 1524, 1535, 3 USPQ2d 1737, 1745 (Fed. Cir.), ***cert. denied***, 484 U.S. 954 (1987). The examiner, however, fails to establish that appellants have withheld any information regarding what he knew to be his best mode at the time the parent or present application was filed. ***In re Gay***, 309 F.2d 769, 773, 135 USPQ 311, 315-16 (CCPA 1962). The fact

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that the best mode or any mode for making and using the  
claimed dispersant mixture was not supplied at the time the  
parent or present application was filed does not demonstrate  
that appellants have concealed or withheld such information.  
Accordingly, we reverse this rejection.

**REVERSED**

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

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