

LEXSEE 191 USPQ 334

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UNITED STATES PATENTS QUARTERLY

Ex parte Osmond, Smith, and Waite

No Number in Original

U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences

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Opinion dated July 27, 1973 Patent issued Dec. 7, 1976

CASE HISTORY and DISPOSITION: Appeal from Group 117.

Application for patent of Desmond Wilfrid John Osmond, Norman Douglas Patrick Smith, and Frederick Andrew Waite, Serial No. 818,249, filed Apr. 22, 1969, continuation in part of application, Serial No. 786,629, filed Dec. 24, 1968. From decision rejecting claims 1-6, 10, and 11, applicants appeal (Appeal No. 121-79). Reversed; Lidoff and Bennett, Examiners in Chief, concurring with opinion; Andrews, Examiner in Chief, submitted Special Opinion.

See also 191 USPQ 340 .

CLASS-NO: 15.7, 50.15, 51.2211, 51.2219, 51.223, 51.2271

COUNSEL: Cushman, Darby & Cushman, Washington, D.C., for applicants.

JUDGES: Before Roeming, Magil, Lidoff, Andrews, a1 Schneider, Mattern, Serota, Witherspoon, Sturtevant, and Bennett, Examiners in Chief, and Blech, Acting Examiner in Chief.

a1 Since Examiner in Chief Andrews retired as of June 30, 1973, a Special Opinion written by him was mailed on June 29, 1973.

OPINIONBY: Serota, Examiner in Chief.

OPINION:

This is an appeal from the Examiner's decision finally rejecting claims 1 through 6, 10, and 11. Claims 7 and 8, the only other claims remaining in this application, have been indicated to be allowable.

Claim 1, which is representative of the claims on appeal, reads as follows:

1. A liquid hydrocarbon fuel of flash point at least 90 degreesF and suitable for use in gas turbine engined aircraft, characterized in that it has a reduced tendency to particulate dissemination on being subjected to shock, the fuel containing dissolved therein an addition polymer of ethylenically unsaturated monomer which is soluble in said hydrocarbon fuel and which does not precipitate when the fuel is cooled to low temperature in an aircraft, said polymer having a viscosity average molecular weight greater than 10⁶ or of intrinsic viscosity greater than 2.5 dls./gm. in a concentration such that there is molecular overlap of the polymer molecules in the liquid.

The references relied upon are:

Skei et al.	3,013,868	Dec. 19, 1961
Van der Minne		
et al.	3,126,260	Mar. 24, 1964

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Jacobson, Defensive Publication T-858,018, Multifunctional Polymeric Additive for Mineral Oils, January 21, 1969, based on [*336] Application Serial No. 664,925, filed September 1, 1967.

All the claims on appeal were rejected under 35 U.S.C. 102 "as anticipated by Skei et al., Van der Minne et al. and Jacobson."

The Examiner's position is to the effect that each of the patents and publication relied upon describes the addition of polymers having the here claimed minimum molecular weight to a jet aviation fuel at the claimed concentration of additive to fuel. The Examiner, therefore, concludes that each of the references anticipates the here claimed compositions.

The appellants, on the other hand, contend that none of the references either evidences an appreciation of the problem attacked by the appellants or discloses their solution to the problem. The appellants additionally argue that the references do not contain any examples specifically embodying the here claimed fuel.

An analysis of the claims on appeal reveals that they define a composition having at least the following required combination of features:

- (1) a conventional jet aircraft fuel,
- (2) a polymer having a viscosity average molecular weight of greater than 1,000,000,
- (3) said polymer being an addition polymer of an ethylenically unsaturated monomer which is soluble in the fuel and non-precipitative at low temperature,
- (4) said polymer being present at a certain specified concentration.

Go to Headnotes [*1R] [1] In our view, neither the Skei et al. patent nor the Van der Minne et al. patent teaches compositions having the specific combination of features required by the claims on appeal. It may be true, as urged by the Examiner, that the aforementioned patents do teach hydrocarbon liquid compositions containing various polymer additives; that they disclose that the liquid may be jet aircraft fuels; that the polymers may have molecular weights falling within ranges which overlap that recited in the claims, and that the polymers may be present in concentration ranges which overlap that here claimed. These, however, are isolated disclosures with no teaching that there is any interrelationship among these features. There is nothing within the patents which would direct a person skilled in the pertinent art to make the selections necessary to formulate a composition having the specific combination

of features here claimed. These patents do not disclose or teach the invention here claimed in such manner as to "give possession of the invention to the person of ordinary skill," cf. *In re Borst*, infra. In such circumstances, we cannot agree with the Examiner that the compositions defined by the claims are "anticipated," within the meaning of 35 U.S.C. 102, by the disclosures of these patents.

With respect to the Jacobson reference, it is clear that the material contained in the published abstract in no way anticipates the claims on appeal. Indeed, one reading the published abstract would not reasonably expect the Jacobson application to have any disclosure dealing with the subject matter defined by the claims. However, the Jacobson application does, in fact, contain disclosure which is relevant to the here claimed subject matter and is considerably more pertinent to the here claimed subject matter than either of the other two references. Even so, the disclosure would fail as an anticipation for essentially the same reasons given above with respect to Skei et al. and Van der Minne et al.

Lest in the future there be any question of the obviousness of the subject matter here claimed from the Jacobson application disclosure, we feel compelled to consider the further issue raised as to whether the Jacobson application is available as evidence of prior knowledge as of its filing date.

The appellants' application is asserted to be a continuation-in-part of their application Serial No. 786,629, filed December 24, 1968. No issue has arisen concerning the appellants being entitled to the benefit of the filing date of their parent application under 35 U.S.C. 120 with respect to the claims on appeal, and we have, in fact, determined that they are so entitled. Thus, appellants' effective filing date for the purposes of this appeal is December 24, 1968, which date is prior to the January 21, 1969, Jacobson publication date, but is subsequent to the September 1, 1967, filing date of the now abandoned Jacobson application.

The Examiner contends that the Jacobson Defensive Publication "may be used as a reference effective from its filing date * * * under 35 USC 102(a) as evidence that the subject matter of the defensive publication constitutes prior knowledge * * *." The Examiner's position is consistent with section 711.06(a) (page 96.2) of the Manual of Patent Examining Procedure (MPEP), and with the Commissioner's Notice establishing the current Defensive Publication program as published on April 11, 1968, 33 F.R. 5623, 849 O.G. 1221.

The pertinent portion of the above referred to section of the MPEP reads as follows:

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An application or portion thereof from which an abstract, abbreviation or defense [*337] sive publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 USC 102(a) effective from the actual date of filing in the United States. (Emphasis added)

The pertinent portion of the above noted Commissioner's Notice reads as follows:

After the defensive publication has appeared in the Official Gazette the abstract and suitable drawing copies will be available as prior art from the date of publication under 35 U.S.C. 102(a) or 102(b) as a printed publication. Also, at this time the application will be available as prior art under 35 U.S.C. 102(a) as evidence of prior knowledge from the actual date of filing the application in the Patent Office.

35 U.S.C. 102(a) reads:

A person shall be entitled to a patent unless -

the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Go to Headnotes [**2R] [2] The overwhelming weight of legal authority is to the effect that the knowledge contemplated by section 102(a) is required to be public knowledge. Although there are numerous court decisions on this point, we cite only *In re Lund et al.*, 54 CCPA 1361, 376 F.2d 982, 153 USPQ 625, 633, and cases cited therein; *In re Borst*, 52 CCPA 1398, 345 F.2d 851, 145 USPQ 554 citing *In re Schlittler et al.*, 43 CCPA 986, 234 F.2d 882, 110 USPQ 304; *Minneapolis-Honeywell v. Midwestern Instruments (CA 7)* 131 USPQ 402, aff'g 127 USPQ 149, 149; *Rem-Cru Titanium, Inc. v. Watson, Comr. Pats. (D.D.C. 1957)* 152 F.Supp. 282, 114 USPQ 529. n1 The predecessor statutes of 35 U.S.C. 102(a), including R. S. 4886, have also been interpreted as requiring that the knowledge necessary to defeat another's right to a patent be publicly accessible. See, for example, *Gayler v. Wilder*, 10 Howard 477, (1850). This is recognized in the reports of the Congressional Committees which were instrumental in the passage of the present patent statute. See the Journal of the Patent Office Society, Volume 34, Number 8, particularly pages 556 and 586. The Congress, although aware of the judicial interpretation of R. S. 4886 as requiring public knowledge, included essentially the same language as previously employed in its passage of 35 U.S.C. 102(a). Thus, the implication is that Congress was satisfied with the interpretation of the language previously employed. This view is reinforced by the fact that several preliminary drafts of the bill which became

the present Title 35 of the United States Code included provisions permitting the publication of applications and making the published applications effective as references as of their filing dates, but these provisions were not included in the legislation actually enacted.

n1 With respect to the apparently contrary holding in the unpublished decision (findings of fact and conclusions of law) of the District Court for the District of Columbia in *Ruskin v. Watson*, Civil Action 621-54, June 14, 1956, we note that the decision in that case was not followed by the same court (*Rem-Cru Titanium v. Watson, supra*), other courts (*Minneapolis-Honeywell v. Midwestern Instruments, supra*) or by the Board of Appeals (*Ex parte Stalego* 154 USPQ 52; *Ex parte Thelin* 152 USPQ 624).

Go to Headnotes [**3R] [3] A departure from the general rule with respect to the necessity that the knowledge be publicly available was made by the Supreme Court in the case of *The Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 344 O.G. 817, 1926 C.D. 303. This case, in effect, held that a United States patent is evidence of prior knowledge of all subject matter described therein as of the filing date of the application from which the patent issued. The Milburn doctrine is codified in 35 U.S.C. 102(e) and is considered to be "an exception to the general rule that prior knowledge must be public in order to defeat another's patent rights," *In re Lund et al., supra*, citing *In re Land et al.*, 54 CCPA 806, 368 F.2d 866, 151 USPQ 621 and *In re Hilmer et al.*, 53 CCPA 1288, 359 F.2d 859, 149 USPQ 480, 495-496, and Committee Report, JPOS, *supra*. The Milburn doctrine has been held to be limited to its own factual situation and that in order to be applicable a patent must issue; cf. *In re Lund et al., supra*, *In re Schlittler et al., supra*, and Judge Baldwin's concurring opinion in the case of *In re Bass et al.*, (CCPA) 177 USPQ 178, 189.

Go to Headnotes [**4R] [4] A Defensive Publication is not a patent. Therefore, it cannot fall within the Milburn - 102(e) exception to the general rule. A Defensive Publication is in reality no more than a publication, and as such, cannot be effective to defeat another's right to a patent prior to its publication date. The application forming the basis of the publication is not available to the public until the date of the publication of the abstract. See Patent Office Rules 11(b), 14(b), and 139. Therefore, there does not appear to be any legal foundation for making the publication retroactively effective to defeat another's right to a patent. [**338]

Go to Headnotes [**5R] [5] It is interesting to note that

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prior to the 1968 Commissioner's Notice, abbreviations, abstracts, and Alien Property Custodian publications were effective as references only as of their publication dates, and currently A.P.C. publications are effective as references only as of their publication date; MPEP 901.06(c).

The most recent and the most pertinent decision relating to the utilization of an unpatented application as evidence of prior knowledge under 35 U.S.C. 102(a) is *In re Lund et al.*, *supra*. This case, after considering many precedent cases dealing with this issue (note Judge Smith's citation of authorities in his concurring opinion), ruled as follows:

The question remains whether the disclosure in the abandoned '806 application is otherwise available as evidence of prior knowledge under 35 U.S.C. 102(a). There it is provided that a person shall be entitled to a patent unless the invention was known or used by others in this country * * * before the invention thereof by the applicant for patent. The "knowledge" required by that provision to defeat another's patent rights has long been interpreted to mean public knowledge. See *In re Hilmer*, 53 CCPA 1287, 359 F.2d 859, 878-879, 149 USPQ 480, 480, ; *In re Borst*, 52 CCPA 1398, 345 F.2d 851, 145 USPQ 554, certiorari denied 382 U.S. 973; *In re Schlittler*, 43 CCPA 986, 234 F.2d 882, 110 USPQ 304, and cases cited therein. Consistent with those rulings, we think the disclosure in Example 2 of the abandoned Margerison application becomes available as evidence of prior knowledge, if at all, only as of the issue date of the Margerison patent, as public access to the abandoned application is then provided for by Patent Office Rule 14(b).

Go to Headnotes [****6R**] [6] Accordingly, it is our conclusion that the disclosure of a Defensive Publication application is not available as evidence of prior knowledge as of the filing date of the application.

The decision of the Examiner is reversed.

Lidoff, Examiner in Chief, with whom Bennett, Examiner in Chief joins, concurring specially.

We agree with the decision of the majority up to the second paragraph in page 336, the point at which the Commissioner's Notice is overruled. Once having held that the Jacobson application disclosure is inadequate to support the Examiner's rejection of the claims based upon 35 U.S.C. 102, we would have terminated the decision at that point since this determination is dispositive of the issues herein. We find no reason to reach out unnecessarily to rule upon and, in fact, to overrule the Commissioner's Notice.

Since the majority sees fit to go further, we express our disagreement with their conclusion.

While we might agree that the failure of the published abstract to include disclosure from the Jacobson application necessary to anticipate the claims might prevent reliance upon the filing date of said Jacobson application, we do not agree with the majority's holding, contrary to the Commissioner's Notice, that in a proper situation the benefit of the filing date of an application abandoned and published under the conditions set forth in the Commissioner's Notice is not available to support a rejection.

In the Federal Register, Volume 33, No. 71, April 11, 1968 announcing the Defensive Publication Program, it was stated that a patent applicant under the provisions of the changed Rules of Practice therein published might waive his rights to an enforceable patent on a pending patent application. It was positively stated (page 5624, column 1, third paragraph) that after publication of an abstract the patent application would become available as prior art under 35 U.S.C. 102(a) as evidence of prior knowledge from the actual date of filing the application in the United States Patent Office.

While it has been held in several decisions that the prior knowledge which is a bar to a patent under 35 U.S.C. 102(a), should be public prior knowledge, the terminology of the statute is not so limited (see also the conclusions of law 1 and, particularly, 2 in *Ruskin v. Watson*, Civil Action No. 621-54 dated June 14, 1956).

It is further quite clear that the so-called Milburn Doctrine (*Milburn Company v. Bournonville*, 270 U.S. 290), now codified in 35 U.S.C. 102(e), recognized the propriety of relying upon the filing date of a United States patent application later published as a patent as proper evidence of prior knowledge even though such prior knowledge was not publicly available at the time of filing the patent application.

It is our opinion, where there is incontrovertible evidence, in a properly filed U. S. patent application later made available to the public, of prior knowledge of an invention, even though not then public knowledge, that a patent on a later filed application should be barred under the provisions of 35 U.S.C. 102(a).

A defensive publication which has been published in accordance with the notice in [***339**] the Federal Register indicated above, wherein the applicant has properly filed a patent application and, in consideration of the published offer to afford to the application the benefit of its filing date as evidence of prior knowledge with respect to a later filed application of another, has waived his rights to a patent and permitted publication,

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constitutes a fair parallel to the patent application which became a patent in the Milburn decision. The applicant of the defensive publication has complied with the published requirements of the Patent Office and has, as an alternative to permitting his application to become a patent, made his invention available to the public by means of the procedure proffered by the Patent Office and published in the amended Rules of Practice. Thus as a parallel to the findings in Milburn, it is our opinion that a defensive application with a proper abstract should be afforded the benefit of its filing date as evidence of prior knowledge of the invention therein disclosed. The disclosure after its filing date has been under the control of the United States Patent Office and is incontrovertible evidence of prior knowledge. Its later publication renders this knowledge available to the public in accordance with procedures outlined by the United States Patent Office.

Andrews, Examiner-in-Chief.

Because I am retiring from the Board of Appeals before the rendering of the opinion of the other members of the panel that heard this appeal, I shall state my conclusions on the merits of the appeal without any prior knowledge as to the ultimate decision which all, or a majority, of the other members of the panel may adopt. My alignment with the views of any subsequently rendered opinion or opinions thus will become self-evident.

It is my view that none of the three references applied by the examiner constitutes an anticipation of the instant claims under *35 U.S.C. 102*.

The closest reference, by far, is the defensive publication T858,018, but this reference too lacks the qualities of a full anticipation of the invention, as claimed.

Because this publication does not recognize the property of the fuel composition to reduce the likelihood of explosion on impact, which is the property sought for in the instant invention, the anticipation of the claims here must rest on the proposition that this property is inherent in some particular fuel composition disclosed by the publication. There can be no such inherency for any fuel compositions arrived at by deriving them only through a process of selecting a concentration of the ingredients from one described composition and selecting a different molecular weight of the polymer from another composition.

Since the publication as a whole does disclose

sufficiently broad ranges of values that it could appear that the claimed ranges would sufficiently approach or overlap those set out in the claims, it might well be that a case could be made for the prima facie obviousness of the claimed fuel composition. However, this is not the issue before us and because of the absence, at this stage of the prosecution, of any factual development in the case bearing on the issue of obviousness, I would not join in any new ground of rejection under Rule 196(b).

The above, in my view, is dispositive of the appeal but since a holding, contrary to my views, by other members of this board that the defensive publication would not be available as a reference as of its date of filing in the Patent Office, could be considered by them as likewise dispositive of the appeal, without reaching the issue of anticipation (or obviousness), I am impelled to state my views briefly as to the effective date of the defensive publication.

35 U.S.C. 6 provides that the Commissioner may establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Rule 139 and the defensive publication program was such a regulation by the Commissioner and established the effective date of a defensive publication as the filing date in the Patent Office.

35 U.S.C. 102(a) and *102(g)* must be considered together to determine whether the program was inconsistent with law or the intent of Congress. The former section of the statute does not specify that the knowledge or use be public. This latter qualification, in other factual situations, has been invoked judicially to prevent secrecy and loss of the public disclosure, contrary to public policy. But this reason does not exist here where the prior inventor did not abandon, suppress or conceal the invention: as was specified in Section *102(g)* because he made every effort to publicize the invention. If a prior use or knowledge can bar, in an interference, a later invention while the prior use or knowledge still was maintained in secrecy, other than for the filing of a patent application, as in Section *102(g)*, there could be no logical reason why a patent application that becomes the subject of a defensive publication should not bar a later invention, for the acceptance of the defensive publication is conclusive evidence that the first inventor had not abandoned, suppressed or concealed the invention.

