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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/491,787	09/19/2014	Edward A. SUGG	034146.00006	1075

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EXAMINER	
MURATA, AUSTIN	

ART UNIT	PAPER NUMBER
1712	

NOTIFICATION DATE	DELIVERY MODE
06/03/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	**Application No.** 14/491,787	**Applicant(s)** SUGG ET AL.	
	Examiner AUSTIN MURATA	**Art Unit** 1712	**AIA (First Inventor to File) Status** No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/19/2014*.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5)☒ Claim(s) *1-24* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1-24* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date *12/9/2014*.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

4) ☐ Other: _____.

The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

Claim Objections

Claims 1, 10, 11, 16 and 18 are objected to because of the following informalities: the claims refer to temperature in Fahrenheit. The MPEP notes that the disclosure of an application should be in metric (S.I.), see MPEP 608.01.iv. The temperature should be in Celsius. Appropriate correction is required.

In addition, the first line in claim 10 has a hanging "-" at the end of the line. It is unclear if that is supposed to indicate that the oil composition is liquid at negative 35ºF to 500ºF (as described in the specification **[0027]**).

Claim Rejections - 35 USC § 112

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

The claim requires the oil composition to be a liquid at -35ºF but requires a pour point of 5ºF. The pour point is the point at which the oil congeals and loses its flow

characteristics. If the oil solidifies at 5ºF, it is necessarily not a liquid at about -35ºF to about 500ºF.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8 and 9 are rejected under pre-AIA 35 U.S.C. 102b as being anticipated by LEGROS et al. (US 6,919,302).

Regarding claims 1-4,

LEGROS teaches an oil composition for protecting metal surfaces **abstract** including guns **column 1 lines** . The composition is a composition of compounds A, B, and C **column 2 lines 56-65**. Compound A is coconut oil **column 3 lines 55-64**. Compound B is sunflower oil **column 3 lines 65-66**. Compound C is methyl ricinoleate **column 4 lines 5-7** which is methyl alcohol treated castor oil. The composition is made entirely of compounds A, B and C and is therefore 100% oil (at least 25%) **column 4 lines 16-18**.

The smoke point of coconut oil is about 350ºF. The smoke point of sunflower oil is about 440ºF (the specification similarly states 450º or higher **[0029]**). The smoke point of castor oil is about 390ºF.

Regarding claims 8 and 9,

LEGROS teaches using components A, B and C at a volume of 40%, 20%, and 40% respectively **column 4 lines 16-18**.

Claim Rejections - 35 USC § 103

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under pre-AIA 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under pre-AIA 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of pre-AIA 35 U.S.C. 103(c) and potential pre-AIA 35 U.S.C. 102(e), (f) or (g) prior art under pre-AIA 35 U.S.C. 103(a).

Claim 5 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over LEGROS (US 6,919,302).

Regarding claim 5,

LEGROS teaches the oleic acid content of the oils can be modified to have up to 85% oleic acid **column 2 lines 25-29**. The sunflower oil (component B) is modified to have enhanced oleic acid content **column 2 lines 31-38**. The reference does not expressly teach the oil has an oleic acid content of 80%, however, the prior art range overlaps the claimed range and is considered prima facie obvious, MPEP 2144.05.I.

Claims 11-21 and 23 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over LEGROS (US 6,919,302) in view of CIOLETTI et al. (US 2007/0010414).

Regarding claims 11-14 and 20,

LEGROS teaches an oil composition for protecting metal surfaces **abstract**. The composition is a composition of compounds A, B, and C **column 2 lines 56-65**. Compound A is coconut oil **column 3 lines 55-64**. Compound B is sunflower oil **column 3 lines 65-66**. Compound C is methyl ricinoleate **column 4 lines 5-7** which is methyl alcohol treated castor oil. The composition is made entirely of compounds A, B and C and is therefore 100% oil (at least 25%) **column 4 lines 16-18**.

The smoke point of coconut oil is about 350ºF. The smoke point of sunflower oil is about 440ºF (the specification similarly states 450º or higher **[0029]**). The smoke point of castor oil is about 390ºF.

The reference does not teach applying the composition to metal surfaces as a lubricant and corrosion protection layer. The reference does not expressly teach applying to a mechanical part. However, CIOLETTI teaches it is known in the art to provide cleaning/protective coating for metallic surfaces including all types of firearms **[0003]** and **[0017]**. At the time of the invention it would have been prima facie obvious to one of ordinary skill in the art to use the corrosion protection composition of LEGROS on firearms to extend time between cleanings.

Regarding claim 15,

LEGROS teaches the composition can be electrostatically sprayed (depositing by spraying) **column 2 lines 3-4** in addition to other conventional means, **column 5 lines 4-7**.

Regarding claim 16,

LEGROS teaches applying the composition and heating to 20-150ºC **column 5 lines 8-10**. The reference does not teach heating to a temperature of 100-400ºF. However, the prior art temperature range overlaps the claimed temperature range and is considered prima facie obvious, MPEP 2144.05.I.

Regarding claim 17,

The references teach applying an oil composition to a metal part but the references do not teach "exposing" to ultraviolet light. However, based upon the

specification, the exposure to UV light includes merely exposure to natural light **[0037]**. The LEGROS reference still does not expressly teach applying the composition during daylight hours. However, interestingly, there is still some UV light at night from moonlight and starlight. Therefore a coated part, such as a component of a firearm, will necessarily be exposed to natural UV light.

Regarding claim 18,

LEGROS teaches deposition of the composition by dipping (immersion) in a preheated bath **column 5 lines 3-10**. The reference does not teach the required duration for dipping. However, discovering the time required to assure proper application of the coating is not considered inventive because finding the workable range is determinable by routine experimentation, MPEP 2144.05.II.A.

Regarding claim 19,

LEGROS is silent to the pressure at which the composition is applied. However, in the absence of any teaching otherwise, the pressure is presumed to be atmospheric pressure which falls within the claimed range.

Regarding claim 21,

CIOLETTI teaches applying oil to a firearm and specifically mentions coating the chamber and bore **[0017]** in addition to other metallic surfaces.

Regarding claim 23,

LEGROS teaches the oil composition for application to metallic parts. The reference further teaches application of the composition by conventional means, **column 5 lines 4-7**. CIOLETTI teaches that an oil composition can be applied to an

action surface of a firearm by using a cloth patch soaked with the composition **[0039]**. At the time of the invention it would have been prima facie obvious to apply a protective oil composition to a firearm active surface by cloth as a known technique for applying a protective coating onto a firearm.

The reference does not teach the cloth patch is provided in a sealed package. However, packaging of a product is not considered inventive. A sealed package would ensure the integrity of the cloth patch. At the time of the invention it would have been prima facie obvious to one of ordinary skill in the art to provide the cloth patch in a sealed package in order to ensure the quality of the product.

Claims 22 and 24 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over LEGROS (US 6,919,302) in view of CRAMPTON (US 5,740,964).

Regarding claim 22 and 24,

LEGROS teaches the claimed composition of vegetable oils and deposition by spraying but does not teach the type of packaging that can facilitate delivery of the composition. However, CRAMPTON teaches a hand pump sprayer for vegetable oil mixtures which includes a pump for releasing the liquid by pressurizing the fluid **column 3 lines 35-60**. At the time of the invention it would have been prima facie obvious to package the composition of LEGROS by hand pump sprayer of CRAMPTON as a known container that can spray viscous fluids onto a target surface.

Claims 1, 6 and 7 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over MOSES (US 5,549,836).

Regarding claims 1, 6 and 7,

MOSES teaches a mineral oil-free aqueous composition used as a dry lubricant film **abstract**. The composition is particularly useful as a firearm cleaner/lubricant **column 4 lines 13-15**. The oils used in the composition includes mixtures of vegetable oils including canola oil (rapeseed), jojoba oil, soya oil, palm oil, olive oil and castor oil **column 1 lines 57-64**. The overall oil content can be changed to make the lubricating film softer or harder **column 2 lines 12-14**. The oils used constitute 16.7-90.9% (at least 25%) of the mixture **column 6**. The reference does not expressly teach at least 25% of the mixture is oils. However, the prior art range and the claimed range overlap and are considered prima facie obvious.

Claims 1 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over RITTER (US 2008/0221001).

Regarding claim 1,

RITTER teaches a 5 group composition that is an additive for lube oils **[0027]**. The additive is used for guns abstract. The additive can include castor oil, jojoba oil and canola oil **[0015]** and **[0030]-[0032]**. The sum of the oils is 5-45% by liquid volume (total volume) **[0015]**. The reference does not teach the range of at least 25% vegetable oils. However, the prior art range overlaps the claimed range and is considered prima facie obvious, MPEP 2144.05.I.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AUSTIN MURATA whose telephone number is (571)270-5596. The examiner can normally be reached on Monday through Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL CLEVELAND can be reached on (571)272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AUSTIN MURATA/
Primary Examiner, Art Unit 1712