

Appellant's Brief

APPELLANT'S BRIEF

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In The
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Patent Appeal Docket
No. 84-778

In The Matter Of The Reissue Application Of
RICHARD N. BENNETT, Appellant

Appeal From the Board of Appeals

Reissue Serial Number 036,745

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STATEMENT OF THE ISSUE

The sole issue is whether applicant is entitled to certain claims in the reissue application, filed less than fifteen (15) months after the issuance of the original patent with a declaration signed by the President of the assignee, subsequently replaced by a Substitute Declaration by the inventor. Prior art rejections are not in issue.

STATEMENT OF THE REAL PARTY IN INTEREST

National Instrument Co., Inc. (NIC) is the assignee of the appealed application. It is a small family-owned business in Baltimore, Maryland, engaged in the development and manufacture of special filling machines.

STATEMENT OF THE CASE

Appellant's invention is directed to a novel machine for filling containers with a fluid product. In the machine, parallel channels for empty containers to be filled are defined at least in part by a conveyor that operates continuously or intermittently. A row of filling nozzles connected with respective filling pumps is retained by a nozzle support which is adapted to be lowered and raised into and out of the containers. Additionally, the nozzle support is adapted to be reciprocated alternately over one and then the other of the two lanes in order to fill the empty containers brought into the filling station in one

lane and after completion of the filling operation, fill the empty containers brought into the filling station of the other lane, and so on. Appropriate indexing mechanisms are associated with each lane to hold the empty containers while being filled, to release the filled containers after the nozzles have been raised out of the filled containers and to permit thereafter the feed of a new batch of empty containers to be filled. In this type of filling machine, the limiting factor for maximum speed of operation of the machine is normally the conveyor speed which must be kept at a certain linear speed to avoid spilling, etc. The machine, as such, would otherwise permit a higher filling rate because the filling pumps, the indexing mechanisms, etc. can be operated faster than permitted by the maximum conveyor belt speed.

In the machine of the invention, the speed of the conveyor belt can be cut for the same filling rate, by almost one-fourth compared to the single lane filling machine of the U.S. Patent 3,237,661 and by almost one-half compared with the two lane filling machine of the U.S. Patent 3,322,167. Or stated in other words, with a given maximum conveyor belt speed, the machine of the invention permits the filling of almost four times as many containers as with a prior art filling machine utilizing only a single lane and the filling of almost twice the number of containers compared to a prior art double line arrangement in which two sets of nozzles were provided, one for each

lane. The operation and advantages attained by the machine of the invention are not in issue.

Claim 24 is reproduced below as being representative of the subject matter on appeal.^{1/} Claim 24 differs from claim 23,^{2/} allowed in the parent patent, by setting forth in the preamble of the claim^{3/} a "conveyor means" rather than a "continuously running, in operation, conveyor belt."^{3/}

Representative reissue claim 24 reads as follows:

A filling machine with a filling station for filling containers with a fluid product by the use of several filling nozzles, which comprises two substantially parallel channel means within the area of the filling station which are defined at least in part by conveyor means, a number of filling units operatively connected with a corresponding number of filling nozzles, nozzle support means supporting thereon the filling nozzles in proper position, means for lowering and raising the nozzle support means and therewith the filling nozzles into and out of containers held under the filling nozzles, indexing means for said channel means for determining the number of containers to be filled in a given filling operation while held stationary in the filling positions on

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- ^{1/} The other claims on appeal are claims 24, 25, 26, 27/24, 27/25, 27/26, 28, 29, 30/24 and 31 through 39. Of these claims, 25 through 34 are dependent on claim 24, and claims 36 through 38 are dependent on claim 35. Independent claims 35 and 39, which are more specific than claim 24, involve the same issue as claim 24.
- ^{2/} The claims set forth in the preamble the pre-existing prior art machines and appellant's inventive contribution by the limitations in the clauses following the words "characterized in that."
- ^{3/} The awkward language, which crept into claim 23 by Examiner's Amendment, was amended in the reissue application to a "conveyor belt continuously running in operation".

the conveyor means during the filling operation, and control means for the filling machine to control its operation including means for correlating the operation of the indexing means and the lowering and raising of the nozzle support means with the operation of the filling units, characterized in that reciprocating means which are operatively connected with the control means are provided for the nozzle support means to alternately place the filling nozzles over the containers to be filled in one channel means and after completion of the filling operation thereof, to move the nozzle support means transversely to the direction of movement of the conveyor means over the other channel means to fill the containers which have been brought into filling position in the meantime in said other channel means and which are held stationary thereat during the filling operation.

The following uncontroverted facts set forth the chronology^{4/} which underlies the sole issue on appeal:

On October 22, 1976, appellant filed his parent application.^{5/} After an Examiner's Amendment in the preamble of the claim^{6/}, the parent application, assigned to NIC,

^{4/} A tabulated chronology appears in Appendix A.

^{5/} That application was given serial no. 735,034.

^{6/} The preamble of claim 23, describing the prior art types of machines, originally called for "... two substantially parallel channel means within the area of the filling station which are defined at least in part by a conveyor belt ...". This language was amended by Examiner's Amendment to specify "... two substantially parallel channel means within the area of the filling station which are defined at least in part by a continuously running, in operation, conveyor belt, ..." (emphasis added for the Examiner's Amendment).

issued on February 14, 1978 as U.S. Patent 4,073,322 (the '322 patent) with 23 claims. Since a continuously running conveyor belt was known with some types of prior art machines, as acknowledged by the patents mentioned in the application,^{7/} the Examiner's Amendment was thus directed to a feature that added no patentability to claim 23.

Shortly after the issuance of the '322 patent, NIC gave notice of infringement to Pneumatic Scale Corporation (PSC). In the ensuing correspondence, PSC brought additional prior art to the attention of NIC. A reissue application^{8/} was filed naming again Richard Nelson Bennett, the inventor also named in the '322 patent, as the sole inventor. The declaration accompanying the reissue application was signed by the President of the assignee.^{9/} Subsequently, an infringement action was also initiated by NIC against

^{7/} U.S. Patents 3,322,167 and 3,237,661 mentioned on page 2, lines 28 and 30 of reissue application (JA-3).

^{8/} Since NIC did not consider PSC's prior art to invalidate any of the claims of the '322 patent, a reissue application serial no. 036,745, was filed on May 7, 1979 to permit the U.S. Patent and Trademark Office (PTO) to pass on the validity of the claims of the '322 patent in the reissue proceedings in accordance with then existing practices.

^{9/} The declaration was signed by the President of the assignee because the principle purpose of the reissue was to permit the PTO to pass on the new prior art which had come to the attention of NIC and because claim 24 was deemed at least of the same scope as allowed claim 23 owing to additional limitations in the characterized clause of claim 24.

Adtech Design Co., Inc. (Adtech). PSC and Adtech both participated vigorously in the reissue proceedings.

On August 7, 1980, the PTO issued the first Office Action in the reissue application (JA-25 to 43), fifteen (15) months after the application was filed. The first Office Action included, inter alia a rejection under 35 USC 251^{10/} on the ground that the declaration failed to comply with certain requirements of the Rules of Practice

10/ 35 USC 251 reads as follows:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue of each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(JA-23 and 34). In this Office Action, which also responded to papers filed by the protestors PSC and Adtech,^{11/} the Examiner found that the claims in the reissue application were supported by the original disclosure (JA-38 and 39) and that the Examiner's Amendment to the original claim 23 was not the "essence of the invention" but merely directed to the "best mode of carrying out (the) invention" (JA-38, paragraph X). The Examiner further held that there was no patentable distinction between a "continuous" or an "intermittent" conveyor (JA-40, paragraph XII), thereby suggesting equivalency of these non-patentable features. Furthermore, the Examiner also indicated that his Examiner's Amendment did not raise an estoppel limiting the scope of the claims originally issued (JA-38, paragraph X). On January 26, 1981, the inventor submitted a substitute declaration (JA-71 to 75) to obviate any problem as regards the original declaration raised by the rejection under 35 USC 251.^{12/} On April 16, 1981, the Examiner accepted the

^{11/} U.S. Patent 3,139,713 to Merrill et al. was brought to the attention of the Examiner by protestor Adtech.

^{12/} Pertinent parts of this declaration which provide a succinct analysis of the reissue claims and the reasons therefor are as follows:

that I also verily believe the original patent to be wholly or partly inoperative or invalid by reason of claiming more or less than I had a right to claim in the patent in that original patent claim 23 had been changed by Examiner's Amendment to "a continuously

(Footnote continued on following page)

new declaration by the inventor and withdrew the rejection under 35 USC 251 based on the reissue declaration (JA-77, Paragraph VI(1)). Because two non-related issues

(Footnote 12 continued from previous page)

running, in operation, conveyor belt" which language is believed awkward and which has been changed to "a conveyor belt continuously running in operation", and in that the third line from the bottom of claim 23 merely referred to "said other channel" which did not have a proper antecedent and which has been changed to "said other channel means"; in that the aforementioned limitation added to claim 23 in the Examiner's Amendment dated October 20, 1977 is unduly restrictive in the light of the original specification, of the prior art cited against the claims, and of the continued development carried on at National Instrument Co., Inc.; and in that the original patent did not cover specifically the modifications described in column 9, lines 1-13 of the original patent; that claims 24-34 were added to correct the aforementioned deficiencies, claim 24 being broader than claim 23 by deleting reference to a conveyor belt continuously running in operation and substituting therefor broadly the reference to conveyor means; that claim 24 is more narrow than claim 23 by changing the "indexing means for said channel means for holding containers stationary in their filling position during the filling operation on the conveyor belt" as set forth in patent claim 23 to "indexing means for said channel means for determining the number of containers to be filled in a given filling operation while held stationary in the filling positions on the conveyor means during the filling operation" as set forth in claim 24; that claim 25 sets forth the "endless conveyor belt" while claim 26 sets forth the "endless conveyor belt running continuously in operation"; that claim 27 refers to the two feed lanes mentioned in column 9, line 11 of the original patent while claims 28 and 29 specify the modified machine as described in column 9, lines 2-8 of the original patent; that claims 30-34 also add additional limitations to claim 24 from which they are directly or indirectly dependent relating to the features of the machine as originally disclosed in connection with Figure 1 and as originally disclosed in column 9, lines 1-13 of the original patent, respectively; that claims 35-37 were added in an Initial Amendment to cover my invention in somewhat different terms in that claim 35

remained^{13/}, appellant proceeded with the appeal on the remaining two issues.

On March 22, 1982, the Board of Appeals (Board) reversed the two remaining rejections (JA-83 and 88). However, the Board entered a new ground of rejection, for claims 24-39 (JA-84 and 85), based upon the third paragraph

(Footnote 12 continued from previous page)

is somewhat broader than claim 24 by merely broadly calling for the "filling means" rather than the "number of filling units operatively connected with a corresponding number of filling nozzles" but is also more specific than claim 24 as well as original claim 23 by specifying the "means for operating the filling machine through at least one control cycle including control means..." and by further including the limitation, "said reciprocating means being controlled in proper timed relationship to the operation of the filling machine by control means therefor"; and that claims 36-37 merely specify additional limitations dealing with the merger of the two channel means into a single feed-out channel (claim 36) and the limitation of the "single conveyor means" for the two channel means (claim 37), and that claim 38 was added in the Amendment dated September 22, 1980 to cover the subject matter of previous claim 37 dependent directly on claim 35 while claim 39 was added to cover the subject matter of claim 35 in somewhat greater specificity by limiting the nozzle support means "to alternately place the same filling nozzles over the containers to be filled...to move the nozzle support means and therewith said filling nozzles transversely to the direction of movement..."

13/ (1) The rejection of certain claims under 35 USC 103 and (2) the rejection of claims 27-29 and 32-34 under 35 USC 251 as drawn to a species not claimed in the original patent (JA-77, Paragraph VI(1)).

of 35 USC 251 and upon 35 USC 118.^{14/} The Board's decision thus resurrected the issue of alleged inadequacy of the original declaration, previously resolved by the Examiner's acceptance of the substitute declaration, executed by the inventor.^{15/}

On May 19, 1982, supplemental declarations by the President of NIC (JA-100 to 103) and by the inventor (JA-104 and 105) were filed with an amendment (JA-89 to 99) to set forth the facts surrounding the filing of the reissue application. Both of these declarations stated that the filing of the reissue application was "error without deceptive intent" explaining in detail the reasons for such statements.

14/ 35 USC 118 is as follows:

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

15/ The Board predicated its new ground of rejection on a holding that the substitute declaration was not acceptable because filed more than two years after the issuance of the '322 patent (JA-84).

SUMMARY OF THE ARGUMENT

Appellant is clearly entitled to the claims indicated otherwise allowable in the reissue application for the following reasons:

(1) The reissue application was filed well within the two (2) year limitation of the fourth paragraph of 35 USC 251, thus satisfying the statutory requirements based on public policy. Assuming arguendo, that the original declaration, naming Richard N. Bennett as the sole inventor, was deficient because of inapplicability of the third paragraph of 35 USC 251, this deficiency was remedied when a substitute declaration, duly signed by the inventor was submitted to the PTO and accepted by the Examiner.

(2) Reliance in the rejection by the Board on 35 USC 118 is totally misplaced because the true inventor was named in the original reissue application.

(3) The filing of the reissue application with a declaration signed by the assignee, NIC, was, at most, an error without deceptive intent as indicated in the declarations on file.

(4) The PTO gave the original reissue application a filing date thereby indicating to the applicant that the application was a properly filed application.

(5) For reasons which remain unexplained to date, it took almost 15 months for the PTO to issue the first Office Action, notwithstanding the fact that this type of reissue

was to be treated special.^{16/} If the PTO had acted promptly, a substitute declaration could have been filed within the two year period.

(6) The PTO, by its own admissions, has indicated that the differences between claims 23 and 24 are directed to non-essential features, which add no patentability to the claims. Consequently, for purposes of the issues raised on appeal, claims 23 and 24 are of the same scope. As a minimum, the PTO's admissions justify NIC's original evaluation and belief that claims 23 and 24 are of the same scope and thus fully vindicate the filing of the original reissue application with the declaration signed by the President of NIC.

(7) A.F. Stoddard & Co., LTD. v. Dann, Commissioner of Patents, 564 F.2d 556, 195 USPQ 97 (Ct. App. D.C. 1977) is controlling because the statutory provisions relied upon by the Board, 35 USC 118 and 251, were interpreted by the Court of Appeals for the District of Columbia Circuit. By analogy of the facts, the decision in Stoddard, supra, makes it

16/ Section 1442.03 of the MPEP is as follows:

All reissue applications are taken up "special", and remain "special" even though applicant does not respond promptly.

All reissue applications except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in "litigation" will be taken up for action in advance of other reissue application.

abundantly clear that the decision of the Board was clearly in error.

ARGUMENTS

In its first decision of March 22, 1982, the Board entered a new ground of rejection under the provisions of 35 USC 251, 3rd paragraph, (JA-84). The Board held that the "application as filed was not in accordance with the statute." Though the Board failed to indicate any specific reason in its first decision, its rationale was obviously predicated on the conclusion that claim 24 is broader than claim 23.^{17/} To bolster the tenuous rejection based on the third paragraph of the reissue statute, 35 USC 251, the Board also held that the application is "not one filed in accordance with the provisions of 35 USC 118, and the Rules of Practice promulgated under that statute" (JA-85). The Board's rejection is clearly in error for the following reasons:

^{17/} There is no specific finding in the first decision of the Board that claim 24 is "broader" than claim 23 under the decisional law cited by the Board (JA-85). The Board's second decision of December 13, 1983 is equally vague on that point by merely stating "it appears that the claims are for encompassing apparatus in which the conveyor belts are not continuously moving in operation and that would not have infringed the patented claims." (emphasis added - list sentence of JA-115).

I. APPELLANT COMPLIED WITH ALL STATUTORY REQUIREMENTS
OF THE REISSUE STATUTE, 35 USC 251

Assuming, arguendo, that claim 24 is broader than claim 23^{18/}, appellant has fully satisfied all statutory requirements of the reissue statute, 35 USC 251.

In the 1952 codification of the patent laws, a number of changes were made both in language and substance of the pre-existing reissue statute.^{19/} In the first paragraph of 35 USC 251, the right for a broadened reissue application, recognized by pre-existing decisional law, was codified in 1952. The second paragraph of 35 USC 251 liberalized the pre-existing law by requiring only that the error must have occurred "without any deceptive intention", as contrasted by the pre-existing requirement that the error previously had to be demonstrated to be "by inadvertence, accident or mistake." The third paragraph of Section 251 of the 1952 Patent Act also liberalized the procedures by permitting an application for reissue to "be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent." Finally, the fourth paragraph of Section 251 codified the pre-existing decisional law by specifying that a broadened reissue patent application must be filed within two (2) years from the grant of the original patent.

^{18/} The PTO's admission clearly indicates that the two claims are of substantially the same scope as will be demonstrated, infra.

^{19/} Section 4916 of the revised statutes (35 USC, § 64).

Claims 24 through 34 were part of the original reissue application (JA-16 through 18).^{20/} The proscription against enlarging the scope of any claim of the original patent in a reissue application filed more than two years from the date of the original grant is based on public policy. As reflected by numerous decisions prior to the Patent Act of 1952, diligence was required by the reissue applicant when filing a broadened reissue application. The reason for this requirement is self-evident. It is based on the need for an assurance to the public that the claims in a granted patent, at some point in time, cannot be broadened. In the 1952 codification, the two year limitation in the fourth paragraph of Section 251 reflected the position of Congress as regards this public policy. In 1952, the fourth paragraph of Section 251 thus substituted an absolute period of a two year limitation within which a broadened reissue application must be filed. In filing the instant reissue application within less than 15 months from the date of issuance of the '322 patent, appellant gave public notice of his intention to assert the subject matter of claims 24-34 included in the original reissue application and thus fully satisfied the mandatory provisions of the fourth paragraph of

^{20/} Claims 35-37 were added in an Initial Amendment dated September 27, 1978 while claims 38 and 39 were added in the Amendment filed September 22, 1980.

35 USC 251. The original reissue application also pointed out candidly why claims 24-34 were added.^{21/}

The issue raised in the instant appeal had been dealt with at length and laid to rest by the Court of Customs and Patent Appeals^{22/} when confronted with a similar rejection involving the PTO's contention of an inadequate reissue oath, by pointing out that the two year period of limitation refers to the filing of the application. In that case, claims broader in scope than the claims submitted with the original reissue application were asserted more than two years after the filing of the original reissue application. The Board, as in the instant case, took the position that those claims containing the doubly broadened subject matter, were without adequate reissue oath. Referring to the legislative history pertaining to the enactment of

^{21/} The original declaration, after setting forth the then customary allegations concerning prior art which had come to the attention of appellant, continued: "I verily believe the original patent to be wholly or partly inoperative by reason of the patentee claiming more or less than he had a right to claim in the patent in that the Examiner by Examiner's Amendment dated October 30, 1977 added limitations unduly restrictive in the claims in the light of the prior art and that the Examiner's Amendment renders the claim awkward in language, and in that the original patent failed to cover the modified structure disclosed in column 9, lines 1 through 13" (JA-19 and 20).

^{22/} In re Doll, 419 F.2d 925, 164 USPQ 218 (CCPA, 1970).

35 USC 251, the Court came to the conclusion that the language "applied for" in the statute refers to the filing of an application. On the basis of the analysis of the legislative history, the Court concluded there was no lack of compliance with the statutory provisions. Having complied with the two year period of the fourth paragraph of Section 251, appellant did all in the instant case that was necessary to comply with the statute. The Patent Office accepted the application as a properly filed application, gave it a serial number, published the information of the reissue application in the Official Gazette and thus made it available to the public at large. Consequently, even if the application had been filed with an improper declaration, all aspects of public policy underlying the fourth paragraph of Section 251 had been fully complied with. Any mistake as to the inapplicability in a given case of the third paragraph of Section 251 which is couched in permissive language, is of no consequence to the issue of whether an appellant complied with the fourth paragraph of Section 251. In the instant case, appellant who had filed a reissue application, broadened or otherwise, within the two year period of limitation candidly informed the public by the inclusion of claims 24-34 and the original declaration^{23/} of the scope of claims he sought to obtain in the reissue patents. As

^{23/} It is manifestly immaterial whether such notice is in a declaration signed by the inventor or the president of the assignee.

pointed out above, the third paragraph of Section 251 was merely intended to liberalize the procedure for filing reissue applications under certain circumstances by permitting the assignee to execute the declaration.^{24/} However, the two year limitation is found only in the fourth paragraph of Section 251 and not in the third paragraph, which is totally silent as to any time limitation,^{25/} and therefore forms no proper basis for the Board's rejections.^{26/} The Board thus, in effect construed, the third and fourth paragraphs of Section 251 to be in some way interrelated because they contain language referring to "enlarge (enlarging) the scope of the claims of the original patent" (JA-115) and then arrived at the startling conclusion that the mandatory provisions of the fourth paragraph are not complied with, if the third paragraph is

^{24/} The assignee's consent was required in all reissue applications whether broadened or narrowed, if filed with a reissue declaration by the inventor. 37 CFR § 1.172(a)

^{25/} Obviously, a non-broadened reissue application can be filed with a declaration by the assignee at any time during the life of the patent.

^{26/} Significantly, the Board rejected the claims only on the third paragraph of Section 251 "as being a broadened reissue application by the assignee" (JA-114).

procedurally followed, even though by mistake. Apart from the fact that the reissue application was filed, ab initio, in the name of the true inventor, the Board in its decision of December 13, 1983 conveniently overlooks the substituted declaration duly filed by the inventor. The rationale of the Board is defective on its face. It confuses the terms "application", "applicant" and "assignee" in an attempt to support the totally unwarranted rejection. The third paragraph of Section 251 merely speaks of the "application" and the procedural liberalization to file the same under certain circumstances. There is nothing in this paragraph which suggests that the "applicant" of such application, filed with a declaration signed by the assignee, can be anyone other than the true inventor(s). In fact, the PTO never once indicated that the applicant was anyone other than Richard N. Bennet,^{27/} until the Board in its decision of March 22, 1982 (JA-80), seized upon the idea, obviously in an attempt to support its new ground of rejection, to refer to the case as "Ex parte Richard N. Bennett, by National Instrument Company, Inc." Suffice it to say, the Board's rejection is clearly in error.

^{27/} In the first Office Action (JA-25), in the second Office Action (JA-57) and in the Examiner's Answer (JA-76), Richard N. Bennett was always referred to as the applicant.

II. THE REISSUE APPLICATION WAS FILED IN
THE NAME OF THE TRUE INVENTOR

To bolster the tenuous new ground of rejection, the Board also alluded obliquely to 35 USC 118^{28/} contending that the application is "not one filed in accordance with the provisions" of this statute (JA-85). Misconstruing the liberalizing provisions of the third paragraph of Section 251, which permit the assignee to sign the declaration on behalf of the inventor, the Board erroneously concluded that the application was not filed in the name of the true inventor (JA-84). This flies in the face of the reality not only of the entire record in this case^{29/} but also belies the declaration signed by Mr. Rosen in which he stated that he verily believed Richard Nelson Bennett to be the original first and sole inventor (JA-19). Addressing the issue of the substitute declaration filed by the inventor, which the Examiner had previously accepted,^{30/} the Board went on to state its novel concept:

^{28/} Though the rejection remains the same, no specific reference to these statutory provisions can be found in the second Board decision.

^{29/} Ibid. n. 27.

^{30/} (JA-77, paragraph VI(1)).

The filing of the declaration by the inventor, however, does not result, ipso facto, in conversion of the application to one by the inventor. (JA-84)

This statement makes absolutely no sense since the instant situation requires no "conversion" as contemplated by 35 USC 118 which applies only to situations where the inventor refuses to execute an application or cannot be found or reached after diligent effort. In that connection, the Board went on:

There has been no petition and filing of papers necessary to convert the application from one by the assignee to one by the inventor, and on the facts in the instant case, it is not clear that such a petition would be granted (emphasis added - JA-84)

This statement is truly remarkable since it reflects an attempt, by dictum, to bar any relief in the instant situation, to the extent needed at all, without the benefit of the facts or briefs, not to mention the fact that the Commissioner of Patents has the sole authority to pass on any petition of the type suggested by the Board.

Consequently, reference to 35 USC 118 which is totally inapplicable, is completely misplaced and provides no basis for the new ground of rejection.

III. THE FILING OF THE ORIGINAL DECLARATION
BY THE ASSIGNEE WAS EXCUSABLE

The filing of the reissue application with a declaration signed by the President of NIC, was at most an error without deceptive intent. This becomes quite clear from the declaration of NIC's President, Sidney Rosen (JA-100 to 103) who pointed out in paragraph 4 of the declaration that the primary purpose of the filing of the reissue application was to permit the Patent Office to pass on prior art brought to the attention of NIC by PSC, after NIC had given notice of infringement to PSC. In paragraph 5 Mr. Rosen stated that he did not believe any of the claims in the reissue application were broadened claims. Paragraph 6 of Mr. Rosen's declaration sets forth the reasons why he signed the initial reissue declaration and paragraph 7 stated that he did not realize the need for a reissue declaration signed by the inventor until after receipt of the Office Action of August 7, 1980. Finally, paragraph 3 of Mr. Rosen's declaration stated that any deficiencies in the original reissue application arose "through error and without deceptive intent". The declaration of the inventor dated May 17, 1982 corroborated the statement of Mr. Rosen that any error which

arose in the filing of the original reissue application arose "without any deceptive intention" (paragraph 1 of the declaration) (JA-106 to 108). Since the provisions of the reissue statute are remedial in nature and are so intended by the drafters of the 1952 Act, it would be highly unfair, to say the least, to deny appellant the claims asserted in the reissue application, properly filed within the two year period of limitation, merely because of a procedural error which was remedied as soon as called to the attention of appellant. Significantly, the Examiner accepted the substitute declaration (JA-77 paragraph VI(1)) and did not appear to regret his earlier position in the second Examiner's Answer of June 3, 1983, (JA-111).^{31/} Accordingly, any procedural misinterpretation or error on the part of appellant should not be a bar to the allowance of the reissue claims.

IV. THE ORIGINAL REISSUE APPLICATION WAS ACCEPTED BY THE PTO

The original reissue application with the declaration signed by the President of NIC, was accepted by the U.S. Patent Office and given a filing date and serial number.

^{31/} In dealing with appellant's arguments, the Examiner stated that they "are ineffective in that the examiner, sua sponte, will not overrule the Board of Appeals."

In support of its conclusion that the application as filed was not in accordance with the statute, the Board relied on the case of In re Reissue Application Papers Executed By Assignee, 138 USPQ 80 (JA-84). In that case, the Commissioner of Patents held that an application executed by an assignee which seeks to enlarge the scope of the claims of the original patent, cannot be given a filing date. Consequently, reliance by the Board on this decision for its conclusion that the application as filed was not in accordance with the statute, is not only improper under the instant circumstances but raises a serious question of estoppel on the part of the Patent Office since it did not follow its own rules in the instant case.^{32/}

V. APPELLANT WAS DEPRIVED OF THE POSSIBILITY OF FILING THE SUBSTITUTE DECLARATION BY THE PTO'S UNEXPLAINED DELAY

As pointed out above, it took almost 15 months for the PTO from the date of filing the reissue application to the date the first Office Action issued. Under Section 1442 of

^{32/} The Board, in its second decision, shrugged off conveniently the arguments by stating: "the duty of properly filing an application under the applicable sections of the statute resides with the assignee/-appellant. As indicated, supra, the office cannot step beyond the bounds of the statute by which it is governed" (JA-118).

the MPEP, all reissue applications are given a "special" status and are to be taken up "immediately". If the PTO had promptly acted on the reissue application, filed within 15 months of the original grant, appellant would have had ample time within which to file a substitute declaration, if necessary, within the two year period. Appellant should not be penalized for unexplained delays by the PTO.

VI. CLAIMS 23 AND 24 ARE OF THE SAME SCOPE

In the first Office Action of August 7, 1980, the Examiner concluded "it is clear that applicant did not consider continuously running conveyors to be his contribution to the art" (JA-35). With respect to PSC's contention that a continuous running conveyor is "indispensible" to the operation of the invention disclosed in the reissue application, the Examiner held "that the mode of conveyor operation is not the point of criticality with regard to the patentability of the invention set forth in the reissue application. The claimed combination with an intermittent moving conveyor is not patentably distinct from the claimed combination with a continuously running conveyor" (JA-40). The recitation in the preamble of claim 23

of a "continuously running conveyor belt" must be construed in the light of these admissions of the PTO.^{33/}

35 USC 251 prohibits the reissuance of a patent applied for more than two years from the date of the grant of the original patent having one or more claims which are broader in scope than the claims of the original patent. In Re Ruth, 47 CCPA 1014, 278 F.2d 729, 126 USPQ 155 (1960) sets forth the test for what is "broader." A claim of a reissue application is broader in scope than the original claims if it contains within the scope "any conceivable apparatus or process which would not have infringed the original patent."

P.J. Frederico, in his Commentary On The Patent Act (35 USCA, pp. 1, 44) provides a test for determining whether a reissue application enlarges the scope of claims of the patent to the invention under the reissue statute:

The statute does not define a broadened reissue, or a reissue which enlarges the scope of the claims of the original patent, but the cases indicate that the general rule is that if a claim of a reissue can hold something as an infringement which would not be an infringement of any of the claims of the original patents, not considering the validity of such claims, then the particular claim of the reissue enlarges the scope of the claims of the original patent, and that claim is broadened if it is broadened in any respect.

^{33/} The PTO does not contend that the other two independent claims 35 and 39 are "broader" than claim 24 as interpreted by the PTO.

However, changes in the scope of reissue claims from the patented claims are not precluded where such changes go no further than to make express what would have been regarded as an equivalent of the original. See, Engineering Development Laboratories v. Radio Corporation of America, 153 F.2d 523 (2d Cir. 1946).

Applying the foregoing test in the light of the PTO's admission, claim 24 is no broader than original claim 23.

Moreover, any misinterpretation as to difference in scope of protection on the part of NIC is clearly excusable, considering the PTO's own admissions, and reinforces the statements in the declarations of Mr. Rosen as President of NIC and of the inventor that any error arose without deceptive intention."

VII. A.F. STODDARD & CO., LTD. v. DANN,
COMMISSIONER OF PATENTS, IS
CONTROLLING AUTHORITY

In A.F. Stoddard & Co., Ltd. v. Dann, Commissioner of Patents, 564 F.2d 556, 195 USPQ 97 (Ct. of App. D.C. 1977), the assignee filed the declaration for a reissue application naming the true inventor of the subject reissue application. That case construed the very sections applicable to the situation: 35 USC 116, 118 and 251. The Court of Appeals for the District of Columbia indicated, under circumstances similar to the present case, that the Court could delve

within the interstices of a statute to do justice. The Court also pointed out that the laws ought to be construed in the spirit in which they had been made. As in the Stoddard case, the original reissue declaration of in the instant case was signed by a person "capable of recognition by the PTO". As in the Stoddard case, the declaration in the original reissue application was "not under any statutory provision a nullity." As a matter of fact, the reissue application of appellant was not only filed by a person capable of recognition by the PTO but by one who was permitted by statute to sign the subject papers under certain circumstances.

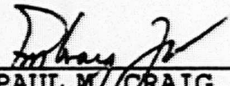
The remedial nature of the reissue statutes involved in this appeal should be construed liberally. In re Shibata, 203 USPQ 780. The signatory of the original reissue declaration is a true party in interest in the reissue application who stated candidly the reasons for filing the reissue application. To the extent the third paragraph of Section 251 is inapplicable, the signing of the original reissue declaration by the assignee was made innocently and without deceptive intent. This is evidenced in the supplemental declarations of Sidney Rosen and Richard N. Bennett submitted with the Amendment of May 19, 1982 (JA-100 to 108). Any error was corrected diligently once it was called to the attention of the inventor and the assignee. Furthermore, no harm would accrue to the public interest if the

interest if the initial acceptance of the declaration of the inventor, submitted on January 26, 1981, had been given full effect, as was originally done by the Examiner. Lack of harm to the public is best demonstrated by the vigorous participation of PSC and Adtech in the reissue proceedings as a result of the notice and availability of the reissue application with the public.

CONCLUSION

For the reasons pointed out above, appellant respectfully requests reversal of the decision by the Board of Appeals.

Respectfully submitted,



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APPENDIX A

CHRONOLOGY

<u>Significant Dates</u>	<u>Event</u>
October 22, 1976	1. U.S. Application Serial No. 735,034 filed in U.S. Patent and Trademark Office (PTO) on October 22, 1976 in name of Richard Nelson Bennett as sole inventor.
February 24, 1978	2. U.S. Patent 4,073,322 ('322 Patent) issued on February 24, 1978 with twenty-three (23) claims, assigned to National Instrument Co., Inc. (NIC) after Examiner's Amendment drawn to a non-patentable feature.
[14 1/2 Months]	3. Notice of infringement by NIC to Pneumatic Scale Corporation (PSC) shortly after issuance of '322 Patent; additional prior art called to the attention of NIC by PSC.
May 7, 1979	4. Reissue application Serial No. 036,745 filed on May 7, 1979 naming Richard Nelson Bennett as the sole inventor in the declaration signed by Sidney Rosen, President of NIC on April 30, 1979.
[15 Months]	5. Action for infringement of '322 Patent initiated by NIC against Adtech Design Co., Inc. (Adtech) by filing Complaint in U.S. District Court for Eastern District of Pennsylvania (Civil Action No. 79-3317) in September of 1979.
	6. Requests by PSC and Adtech for and permission to participate in the examination of the reissue application. Requests were granted on November 30, 1979 and June 10, 1980, respectively.
August 7, 1980	7. First Office Action, dated August 7, 1980, rejecting claims including a rejection under 35 U.S.C. 251 on the ground that the declaration failed to comply with certain PTO rules and response to brief of PSC and memorandum of Adtech. Examiner finding and admitting that the scope of the reissue claims was supported and that Examiner's Amendment was not the "essence" of the invention but merely directed to the

"best mode of carrying out [the] invention."
Examiner further admitted that the claimed combination with a "continuous" or with an "intermittent" moving conveyor "is not patentably distinct."

January 26, 1981

8. Substitute Declaration of inventor, Richard Nelson Bennett, with assent of Sidney Rosen, President of NIC, filed in PTO on January 26, 1981.

April 16, 1981

9. Examiner's Answer, dated April 16, 1981, accepting new declaration by inventor and withdrawing rejection under 35 U.S.C. 251 based on defective original declaration.

March 22, 1982

10. Decision by Board of Appeals, dated March 22, 1982, entering new ground of rejection under provisions of 35 U.S.C. 251, third paragraph.

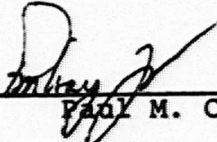
11. Supplemental Declarations by Mr. Rosen of NIC and of the inventor submitted with amendment of May 19, 1982, pointing out that the reissue application, to the extent it contained any informalities, was filed by Sidney Rosen through error and without deceptive intention.

November 21, 1983

12. Decision of Board of Appeals sustaining new ground of rejection under 35 U.S.C. 251.

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing APPELLANT'S BRIEF and JOINT APPENDIX were sent, by first-class mail, postage prepaid, to Robert T. Gammons, Esquire, Dike, Bronstein, Roberts, Cushman & Pfund, 130 Water Street, Boston, Massachusetts 02199, attorney for Protestor, Pneumatic Scale Corporation, to Walter B. Udell, Esquire, Edelson, Udell, Kimmelman and Farrell, 1328 Land Title Building, Philadelphia, Pennsylvania 19110, attorney for Protestor, Adtech Design Co., Inc. and two copies were sent, by first-class mail, postage prepaid to Henry W. Tarring, II, Esquire, Office of the Solicitor, U.S. Patent and Trademark Office, P.O. Box 15667, Arlington, Virginia 22215, attorney for the Commissioner of Patents and Trademarks, this 27th day of April, 1984.

By  _____
Paul M. Craig, Jr.