BRIEF FOR THE COMMISSIONER OF PATENTS AND TRADEMARKS

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

APPEAL NO. 84-778

IN THE MATTER OF THE APPLICATION OF

RICHARD N. BENNETT

Appellant

HIGH SPEED FILLING MACHINE

Appeal from the Board of Appeals

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STATEMENT OF THE ISSUE

In the opinion of the Commissioner, the issue herein is whether or not the Board of Appeals was clearly wrong in affirming the examiner's rejection of claims 24 through 39 in appellant's application for reissue entitled "High-Speed Filling Machine" under the third paragraph of 35 U.S.C. 251?

STATEMENT OF THE CASE

This is an appeal from a decision of the Board of Appeals, pursuant to 35 U.S.C. 141-144.

Appellant's (hereinafter, applicant) Statement of the Case should be supplemented in the following particulars.

The Examiner's Amendment in the original application, referred to at pages 3,4, and 5 of Appellant's Brief (hereinafter, Br. 3,4,5), stated in part:

> In a telephone interview on September 8, 1977, applicant's representative, Mr. Paul M. Craig, authorized the following changes:
>
> . . .
>
> (b) Claim 23, line 4 -- continuously running, in operation, -- has been inserted before "conveyor."

The Declaration, Power of Attorney and Petition filed with the present reissue application on May 7, 1979 (A-19, 20) stated, in part:

> I, SIDNEY ROSEN, President of NATIONAL INSTRUMENT COMPANY, INC. of 4119-27 Fordleigh Road, Baltimore, Maryland 21215, declare ... that the entire title to Letters Patent No. 4,073,322 for HIGH-SPEED FILLING MACHINE, granted on February 14, 1978 to RICHARD NELSON BENNETT, Is vested in NATIONAL INSTRUMENT COMPANY, INC. ... I verily believe the original patent to be wholly or partly inoperative or invalid 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 20, 1977 added limitations unduly restrictive in the claims ... and in that the original patent failed to cover the modified structure disclosed in column 9, lines 1 through 13. ...
>
> (A 19, 20).

The Office Action issued on August 7, 1980, (A 25, Paper No. 18) was the first action by the examiner in the case. However, it was not the first Office Action in the

application. Paper Nos. 10, 13, and 16 were prior Office Actions dealing primarily with the procedural aspects of various petitions.

Applicant's Statement of the Case and the Chronology (Br 30, 31) both fail to indicate that following responses to Paper No. 18, the examiner entered a Final Rejection (Paper No. 25, A 57 - 67) on November 19, 1980, and also provided an Advisory Action (Paper No. 27) on December 24, 1980.

ARGUMENT

a. Summary of argument

Claims 24 through 39 are properly rejected under 35 U.S.C. 251, third paragraph. Applicant's arguments do not demonstrate error in the Board's decision.

b. Claims 24 through 39 are properly rejected under 35 USC 251, third paragraph.

The third paragraph of 35 U.S.C. 251 provides:

> 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.

This paragraph provides a limited exception[1] to the requirement that applications for patent be made by the inventor, see 35 U.S.C. 111. This exception permits the

1. Other limited exceptions to this requirement are provided in 35 U.S.C. 116, 117, and 118.

assignee to make application for reissue if the scope of claims in the original patent is not to be broadened in the reissue patent.

The assignee of the original patent, National Instrument Company, Inc., made this reissue application (see A 19, 20). In so doing the assignee clearly indicated an intention to broaden the patent's claims by the reissue. The assignee indicated that certain limitations in the patent claims were "unduly restrictive" (A 19) and, further, that "the original patent failed to cover the modified structure disclosed in column 9, lines 1 through 13" (A 20).

Claim 24, newly submitted in the reissue application, is patterned after claim 23, which was present in the original patent. One of the differences between these claims is that claim 23, as it appears in the patent, stated "defined in part by a continuously running, in operation, conveyor belt," (see A 15, lines 4,5), while claim 24 states "defined at least in part by conveyor means" (A 16, line 4). Accordingly, newly presented claim 24 seeks to cover "conveyor means" whereas the original patent covered "continuously running, in operation, conveyor belts." Clearly, the reissue application seeks to broaden the patent

in seeking statutorily provided for coverage of the equivalents of the continuously running conveyor belts disclosed in the specification (A 7, lines 55-57), see 35 U.S.C. 112, last paragraph.

The Board appropriately cited In re Ruth, 278 F.2d 729, 126 USPQ 155 (1970), which states:

> A claim of a reissue enlarges the scope of the claims of the patent if it is broader than such claims in any respect, even though it may be narrower in other respects or, in other words, if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent. 126 USPQ at 156

Inasmuch as "conveyor means" is clearly broader[2] than "continuously running, in operation, conveyor belts", the reissue seeks to broaden the patent's claims.

The Board, therefore, correctly affirmed the rejection under 35 U.S.C. 251 of those of the reissue claims which sought to broaden the patent claims, inasmuch as the reissue application was filed by the assignee.

c. Applicant's arguments do not demonstrate error in the Board's decision

Applicant argues that the reissue application was filed "in the name of the true inventor" (Br 20, 21). The purpose

2. The inventor clearly agrees that claim 24 is broader than claim 23 in his statement "claim 24 being broader than claim 23" (A 72).

of this argument is not clear. The third paragraph of 35 U.S.C. 251 provides that the application "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." The reissue application was unquestionably "made and sworn to" by the assignee. Regardless of whether or not the application might be construed to be "in the name of the true inventor," it cannot be used to pursue broadened claims.[3]

Applicant argues that 35 U.S.C. 118 is inapplicable to the present situation (Br 20, 21). The Board did not mention 35 U.S.C. 118 in its most recent decision (A114 et seq.), and the Commissioner agrees that section is not applicable to the present situation.

Applicant further argues that the filing of the original declaration by the assignee was excusable since it was an error without deceptive intent (Br. 22 et seq.). The requirements for filing applications are set by statute.

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3. It should not be surprising that the original declaration names the true inventor in view of 35 U.S.C. 115, the last sentence of which states, "When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him."

Those who seek to pursue the benefits afforded by the statute, are expected to meet the terms of the statute in their quest. The provision of the statute providing that assignees may file the application, contains a clear proviso therein that broadened claims may not be sought by such a reissue. For the assignee to invoke the provisions of the third paragraph of 35 U.S.C. 251 in filing the application, while ignoring the limitations as to broadened claims set forth in that very same paragraph, and then seek to have the error excused, would render the statute's proviso respecting broadened claims a nullity. Moreover, while Mr. Rosen's declaration states that he did not believe the reissue application as filed contained broadened claims (A 102, paragraph 6); such is difficult to understand in view of the original declaration submitted. As acknowledged in Mr. Rosen's later declaration (A 101, paragraph 4), the original declaration indicated that the original patent's claims were "unduly restrictive." Moreover, to whatever extent it might be pertinent, the inventor, in a declaration (A 71), clearly indicated his understanding that newly submitted claim 24 was broader than the original patent's claim 23 (A 72, line 27).

Applicant further suggests that the Patent Office should be estopped from pursuing this rejection since it accepted the original application (Br-23). Applicant suggests that such is justified because the Patent Office has not followed its own rules. It should suffice to point out that the rejection is based on a statute, not a rule. The Patent Office has no authority to ignore the statute under which it functions. It should be noted, further, that once the reissue application is amended to remove the broadening claims, it is possible that a reissue patent will issue. The application's claim 23 is an amended version of claim 23 in the patent, and to the extent that newly submitted dependent claims 27 and 30 (see A 89) rely on claim 23, they are not subject to the present rejection. It is possible that a reissue patent will issue containing these claims once the broadened claims are removed. Examination of these claims would not have progressed without the case having been accepted. Thus, it is clear that the reissue application sought to correct (a) errors by correction that did not result in claims that were broadening in scope, as well as (b) errors for which the corrections resulted in broadening claims. In view of the fact that the application was accepted and examined to an apparently satisfactory conclusion with respect to the

errors of category (a), applicant should not be heard to complain that he should be entitled to the corrections of category (b) merely because the application was originally accepted.

Applicant also argues that the Patent and Trademark Office's (PTO) "unexplained delay" of 15 months to the first Office Action precluded him from filing a substitute declaration within the two-year period. It should not be necessary for the PTO to further explain to applicant why it took 15 months to issue paper No. 18 (A 25), the paper applicant contends is the "first Office Action." Presumably, applicant was either served with or generated papers 2 through 17, which papers should adequately explain the "delay." Moreover, contrary to applicant's assertions (Br 28), the error was not diligently corrected once it was drawn to applicant's attention. The error was pointed out in paper No. 18 (A 34) and was not corrected until after a final rejection (Paper No. 25, A 57) and an advisory action (Paper No. 27, dated December 24, 1980) had been further entered by the Examiner.

Applicant argues that claims 23 and 24 are of the same scope. The evidence submitted by applicant however, is to the contrary. The assignee has clearly indicated twice that the reissue was being filed to correct an error in that the

original patent claims were "unduly restrictive" (A 19, last line and A 101, paragraph 4). The inventor has also submitted a declaration wherein he stated "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" (A 72, lines 27-29). In any event, contrary to applicant's argument (Br 25), the examiner's position that intermittent moving conveyors and continuously running conveyors are not patentably distinct does not establish, either, that a claim distinctly drawn to continuously running conveyors is broad enough to cover intermittently running conveyors, or that the reissue claims are not broader than the patent claims.

Applicant's argument (Br 27) that A.F. Stoddard & Co. Ltd. v. Dann, Commissioner of Patents, 564 F.2d 556, 195 USPQ 97 (Cir. Ct., D.C., 1977) is controlling, overlocks numerous distinctions between that case and the one at bar. That case was an appeal from a civil action under 35 U.S.C. 145, whereas this case is a direct appeal under 35 U.S.C. 141 from a Board of Appeals decision. While the courts in Stoddard had broad equity jurisdiction, the jurisdiction of this court is more limited on direct appeal. As recognized in the Stoddard decision, the PTO is obliged to carry out its duties under the authorizing statute and must follow the

strict provisions of such statute. The Board has done such, and it is not seen how, in this appeal, it can be faulted or overruled for refusing to exercise equitable powers which it does not possess. Moreover, the Stoddard decision involved what could be termed "interstitial legislation" based on the finding that the statute neither authorized nor prohibited the kind of conversion of inventorship there in issue. The third paragraph of 35 U.S.C. 251 quite clearly prohibits broadened claims in reissue applications filed by assignees. While it is recognized that the reissue statutes are remedial in nature and to be liberally construed, such does not mean that the statutes can be completely ignored.

Finally, applicant extensively argues (Br-14) that the application was filed within the two years provided for filing broadened reissues in the fourth paragraph of 35 U.S.C. 251. The rejection, however, is not under the fourth paragraph, it is under the third paragraph. The fact that the application complied with the fourth paragraph does not establish that it complied with the third paragraph, for it obviously did not. The only way the fourth paragraph is pertinent to this appeal is with respect to applicant's contention that the inventor's declaration (A 71) submitted on January 26, 1981, somehow provides an application wherein broadened claims should be permitted (See Br 29). As indicated previously, this Declaration was not provided as

diligently as applicant's argument would indicate. More importantly, the declaration was not filed until more than two years had elapsed from the issuance of the original patent on February 14, 1978 (A 1). Applicant appears to recognize the defect in this argument in the first partial paragraph at page 25 of his brief. Clearly, such an interpretation of the various submissions would only provide an inventor filed reissue application as of the date the inventor's declaration was received, which date is outside of the two years provided for filing broadening reissues by the fourth paragraph of section 251. Clearly, nothing is to be gained by construing the application as having been filed by the inventor on January 26, 1981. Presumably, that is why no significant effort has been expended in pursuing such a construction.

CONCLUSION

For the foregoing reasons, it is submitted the decision of the Board of Appeals is clearly correct. Affirmance thereof is in order and is solicited.

Respectfully submitted,

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