Reply Brief

REPLY BRIEF

UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT

APPEAL 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

Joseph T. Nakamura
Solicitor

Henry W. Tarring, II
Associate Solicitor
United States Patent
and Trademark Office
(703) 557-3536

For The Commissioner
Of Patents And Trademarks

Paul M. Craig, Jr.

Craig & Burns
1825 Eye Street, N.W.
Washington, D.C. 20006

(202) 429-0400

For Appellant

REPLY BRIEF

UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT

APPEAL NO. 84-778

In The Matter Of The Reissue Application Of

RICHARD N. BENNETT

Appellant

Appeal from the Board of Appeals

The following brief is respectfully submitted in reply to the Brief for the Commissioner of Patents and Trademarks submitted in the above-identified appeal.

ARGUMENTS

The Brief for the Commissioner of Patents and Trademarks is not only significant in its arguments but even more significant in its failure to deal with the basic issue of this appeal.

Nowhere in the Brief for the Commissioner is there any indication as to

(a) why the declaration by the inventor, assented to by the President of the assignee of the application, which was submitted on January 26, 1982 (JA-70-74) should not have been accepted by the PTO (as it was originally by the Examiner in charge of this application; (JA-77), and

(b) why the declaration of the inventor filed on January 26, 1981 (JA-70-75) did not cure any deficiencies that might have existed in the application.

A subsidiary feature which the Commissioner's Brief never addresses is whether the Board of Appeals was correct in issuing the new ground of rejection after the Examiner had accepted the substitute declaration, suggesting that such declaration was null and void because of the third paragraph of 35 U.S.C. 251.

Appellant's position can be stated as follows: the fourth paragraph of 35 U.S.C. 251 requires that any broadened reissue application be filed within two (2) years. If a reissue application does not seek any broadened claims, it may additionally be executed by the assignee of the application, otherwise it should be filed with a declaration by the inventor consented to by the assignee.

In the instant case, the reissue application was filed less than fifteen months after the original patent issued, thus leaving more than nine months before the expiration of the two-year period. The original application was filed

with a declaration signed by the President of the assignee, containing all of the requirements of such declaration and naming the true inventor, Richard N. Bennett, as the applicant of the reissue application. The declaration was filed by the assignee because it was believed that the changes in the claims were such as to bring into play the third paragraph of 35 U.S.C. 251. (The reasons for this belief are fully discussed in appellant's brief and will therefore not be repeated herein). For reasons still unexplained, it took another fifteen (15) months before the first Office Action issued, raising for the first time the question of the adequacy of the declaration. Ultimately, a declaration was submitted in the application by the inventor which was accepted by the Examiner. It was only in the decision of the Board of Appeals of March 22, 1982 that the Board of Appeals, sua sponte, issued a new rejection under 35 U.S.C. 251, third paragraph (JA-84) and alluded for some mysterious reasons also to 35 U.S.C. 118 (JA-85) in support of the new ground of rejection. Consequently, the basic issue in this case is whether the new ground of rejection of the Board of Appeals, overruling the Examiner's acceptance, is warranted under 35 U.S.C. 251 in the light of the peculiar circumstances of this case, involving acceptance of the application by the PTO, acceptance of the declaration by the Examiner and an unexplained delay of more than fifteen

months between the filing of the application and the first Office Action when such reissue applications are to be treated special. None of the arguments in the Commissioner's Brief address this basic issue. Instead, arguments are advanced dealing only with subsidiary issues that do not address the basic issue.

THE COMMISSIONER'S BRIEF

At the bottom of page 2 and the top of page 3 of the Commissioner's Brief, an attempt is made to excuse the fifteen months' delay in the first Office Action by suggesting that there were quite a number of "prior Office Actions" though admitting that they dealt "primarily with procedural aspects of various petitions." Since the Commissioner did not see fit to file a motion for diminution of the record, as would be proper, attached to this Reply Brief as Exhibit A is a list of those papers which were filed, clearly indicating that none of these papers constitute any reason or excuse why the first Office Action was delayed by more than fifteen months.

In the arguments presented in the Commissioner's Brief, reliance in support of the rejection by the Board of Appeals is made exclusively on the third paragraph of 35 U.S.C. 251. This paragraph, as pointed out in Appellant's Brief, merely

permits the filing of an application by the assignee under certain circumstances. It is only the fourth paragraph of 35 U.S.C. 251 which, in mandatory language, requires the filing of a reissue application containing broadened claims within a two-year period. These two provisions are mutually exclusive, yet, without so stating, the Board of Appeals as well as the arguments presented by the Commissioner implicitly read the provisions of the fourth paragraph of 35 U.S.C. 251, mandatory in nature, into the permissive provisions of the third paragraph of this statutory section. This becomes clear from the statement on page 5 of the Commissioner's Brief where one finds the following arguments:

> "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." (emphasis added)

First of all, the Board did not affirm the rejection but made the new ground of rejection. Secondly, this sweeping conclusion is clearly contrary even to the position of the Commissioner. For example, if the declaration of the inventor had been filed within the two-year period, under the arguments in the Commissioner's Brief, the application would still be subject to the rejection under 35 U.S.C. 251.

At the bottom of page 5 and the top of page 6, the Commissioner's Brief questions certain parts of Appellant's Brief. Suffice it to state that the arguments made thereat were in response to reliance by the Board of Appeals on 35 U.S.C. 118 which the Commissioner now agrees not to be applicable to the present situation (middle of page 6 of Appellee's Brief).

In dealing with the arguments on page 22 et seq. of Appellant's Brief, the Commissioner's Brief merely indicates that the requirements for filing applications are set by statute, without indicating the legal significance of such argument and then continues to suggest

> "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."

This argument is not only incorrect on its face but also clearly indicates that the rejection is based on the incorporation of the mandatory provision of the fourth paragraph into the permissive provision of the third paragraph of 35 U.S.C. 251. While the Commissioner's Brief does not specifically so state, it is implicit in the statement on page 7,

> "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 provision respecting broadened claims a nullity."

With respect to the estoppel situation, the Commissioner's Brief merely brushes aside the particular circumstances of this case on the ground that its action is based "on a statute, not a rule" (page 8 of Appellee's Brief). The remainder of page 8 of the Commissioner's Brief merely suggests that allowance of certain claims may be "possible", thus indicating that even if the Commissioner's position is adhered to, the rejection of certain claims is totally untenable.

On page 9, the Commissioner's Brief seeks to justify the unexplained delay. The list attached hereto as Exhibit A clearly shows that the various documents filed in no way justify the delay. Furthermore, on page 9, the Commissioner's Brief suggests that the error was not corrected timely by the appellant. To the extent this passage refers to the error in the delay of the first Office Action, the argument is not understood. To the extent it refers to the error of originally filing the reissue application with the assignee's declaration, then under the Commissioner's present interpretation, there could have never been a timely correction of the error.

With respect to the issue of whether claims 23 and 24 are of the same scope, the Commissioner's Brief, on pages 9 and 10, alludes to certain documents filed in this case, but never analyzes the scope of the claims. Suffice it to say the documents referred to in the Commissioner's Brief were filed in compliance with the specific rules of the PTO in reissue applications which, if not complied with, would have continued the rejection of all the claims under 35 U.S.C. 251.

The lower half of page 10 and the top of page 11 brush aside the decision of A.F. Stoddard & Co. Ltd. v. Dann, Commissioner of Patents, 564 F.2d 556, 195 U.S.P.Q. 97 (Cir. Ct., D.C., 1977) on the ground that it 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. This is indeed a startling argument considering the similarity of appellate jurisdiction in patent matters of the Circuit Court of Appeals for the District of Columbia in 1977 and of this Court. If this argument is sustained, it would indicate to any future appellant that the proper way to proceed is under 35 U.S.C. 145, lest they jeopardize the broad appellate review of this tribunal. With respect to the "interstitial legislation" argument, it should be pointed out that 35 U.S.C. 251 does not clearly prohibit the submittal of a declaration by the inventor in a reissue

application, originally filed by the assignee, if it is determined subsequently that a claim is of "broadened" scope.

On page 12 of the Commissioner's Brief, there is finally a statement that the "declaration was not filed until more than two years had elapsed from the issuance of the original patent on February 14, 1978" thereby justifying the rejection under the 35 U.S.C. 251, third paragraph, as argued on page 11. For reasons pointed out in Appellant's Brief and in the instant Reply Brief, this is a legal non sequitur based on a deficient syllogism.

CONCLUSION

For the foregoing reasons, it is submitted that the decision of the Board of Appeals is clearly incorrect, and reversal thereof is respectfully solicited.

Respectfully submitted,

PAUL A. CRAIG, JR.
Craig & Burns
1825 Eye Street, N.W.
Washington, D.C. 20006
(202) 429-0400

EXHIBIT A

LIST OF PAPERS FILED IN REISSUE APPLICATION
SERIAL NO. 036,745 UP TO FIRST OFFICE ACTION
(PAPER NO. 18)

DATE	DESCRIPTION
May 7, 1979	Reissue Application
May 29, 1979	Notice Re: Filing Fee by PTO indicating an excess in filing fee and refunding $48.00
September 5, 1979	Notice of Insufficient Fee indicating a balance of $24.00 due
September 12, 1979	Transmittal of Formal Drawings And/Or Fee -- $24.00 for balance of filing fee
September 20, 1979	Change of Address of Applicant's Attorneys
September 20, 1979	Initial Amendment adding Claims 35-37
September 27, 1979 (filed in mail room Oct. 1, 1979 - rec'd in Group Oct. 17, 1979)	Brief of Pneumatic Scale Opposing Reissue of U.S. Patent 4,073,322
October 17, 1979	Partial Reply of Applicant to Brief of Pneumatic Scale Opposing Reissue of U.S. Patent 4,073,322
November 30, 1979	Letter by Group Director on Petition to Participate in Examination of Reissue Application
April 18, 1980	Letter from Applicant with attached Exhibits advising PTO of pendency of infringement action against Adtech Design Co., Inc. and submitting prior art received from latter's attorney

Date	Description
May 14, 1980	Letter from Walter B. Udell, attorney of Adtech to PTO requesting that Adtech be made Opposer of record
June 2, 1980	Letter from Paul M. Craig, Jr. to PTO requesting that participation of Protestor be limited as permitted by Rules
June 10, 1980	Letter by Group Director on Petition of Adtech to Participate in Examination of Reissue Application
June 20, 1980	Letter from Applicant's Attorney with attached copy of Order of Judge Luongo
July 2, 1980	Memorandum of Protestor Adtech Design Co., Inc. with attached Exhibits
July 7, 1980	Letter from Group Director acknowledging papers filed by Adtech on July 2
July 9, 1980	Letter from Protestor Pneumatic Scale requesting certain documents to be made of record
August 7, 1980	Paper 18 - first Office Action

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing REPLY BRIEF and attached EXHIBIT A 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 16th day of July, 1984.

By _____

PAUL M. CRAIG, JR.