



The opinion in support of the decision being entered is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS WELLERDIECK,
URS WEGMANN, and KARL HOEFLER

Appeal 2007-1119
Application 10/200,207¹
(Reissue application of U.S. Patent No. 6,248,219 B1)
Technology Center 1700

Decided: May 4, 2007

Before: RICHARD E. SCHAFER, RICHARD TORCZON, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed 23 July 2002. The real party in interest is identified as Unaxis Balzers AG of Fuerstentum, Lichtenstein.

A. Introduction

Applicants appeal under 35 U.S.C. § 134 from the final rejection of claims 1–25, all the claims of their application for reissue of U.S. Patent 6,248,219 B1 ("219 patent"). We have jurisdiction under 35 U.S.C. § 6. Oral argument was heard on 2 May 2007 before a court reporter.

This appears to be a case of first impression, in which Applicants seek to expand the term of their patent, but not to change the scope of the patented subject matter. Specifically, Applicants argue that had they filed continuing applications under 37 C.F.R. § 1.53(b) rather than erroneously under § 1.53(d), they would have been granted a patent having a term of 17 years from the date of issue, that being greater than the term of 20 years from the earliest application specifically referenced in their application, as provided for by 35 U.S.C. § 154(c).

We hold that Applicants are not entitled, under 35 U.S.C. § 251, to the relief they seek. In particular, Applicants are precluded by the statute from expanding the term of their originally issued patent. Moreover, we hold that § 154(c) would not have applied to continuing applications filed under Rule 53(b), so the specific correction they seek would not yield the expanded term they believe they are entitled to. Finally, even if the relief they seek were available under the statute and would yield the expanded term they want, Applicants have failed to show that the choices they made to file continuing applications under Rule 53(d) were actually inadvertent errors correctable by reissue.

Accordingly, the Examiner's rejection is **AFFIRMED**.

B. Background and Findings of Fact

The following findings of fact and those set out in the opinion are supported by a preponderance of the evidence of record. Any conclusions of law should be treated as such.

The Reissue Application

1. The invention relates to a process and an apparatus for sputtering the surface of an object. However, because no aspect of the technology is necessary to understand the issues on appeal, we shall not describe the invention further.
2. According to Applicants, the real party in interest is Unaxis Balzers AG of Fuerstentum, Lichtenstein. (Supplemental Appeal Brief ("Br."), filed 7 September 2006, at 1.)
3. Applicants seek reissue of U.S. Patent 6,248,219 B1 ("219 patent").

Prosecution History of the 219 Patent

4. The 219 patent issued from application 08/418,256 ("256 application"), filed on 4 April 1995.
5. The first sentence of the specification of the 219 patent reads:
This is a continuation of application Ser. No.
08/250,093, filed May 26, 1994 now abandoned, which is a continuation of Ser. No.
08/033,142, filed Mar. 16, 1993 now abandoned, which is a continuation-in-part of Ser. No.
07/829,739, filed Jan. 31, 1992, now abandoned, which is a continuation of Ser. No.
07/579,068, filed Sep. 6, 1990, now abandoned, which is

a continuation of Ser. No.
07/047,896, filed 7 May 1987, now abandoned.

(219 patent at 1:4–11; indentation and line-breaks added.)²

6. According to the USPTO Patent Application Location and Monitoring ("PALM") database, a final rejection was entered in the 256 application on 16 May 1996.

7. The PALM database indicates that a "Request under Rule 129 to Reopen Prosecution" was filed and granted on 21 November 1996.

8. "Rule 129" refers to 37 C.F.R. § 1.129 (1995).

9. According to the PALM database, in due course a final rejection was entered on 21 May 1998.

10. The PALM database records the filing of a "Continuing Prosecution Application Continuation" ("CPA") on 21 January 1999.

11. The PALM database indicates a final rejection was entered 4 February 1999.

12. According to the PALM database, a second CPA was filed on 6 December 1999.

13. In due course, the 219 patent issued on 19 June 2001.

14. The face of the 219 patent displays the following notice:

This patent issued on a continued prosecution application filed under 37 C.F.R. 1.53(d), and is subject to the twenty year patent term provisions of 35 U.S.C. § 154(a)(2).

² The 219 patent also claims the benefit of priority under 35 U.S.C. § 119 of a Swiss application filed 23 June 1986.

Prosecution History of the 207 Reissue Application

15. Applicants, in their Reissue Application Declaration ("Reissue Declaration"), filed 23 July 2003, state:

We verily believe the original patent to be wholly or partly inoperative or invalid, by reason of the patentees claiming less than they had the right to claim in the patent.

Applicants seek to claim the benefit of the full term of the original patent, which term was abridged by the erroneous filing of a Continued Prosecution Application under 37 C.F.R. § 1.53(d) instead of a continuing application under 37 C.F.R. § 1.53(b), thereby subject[ing] the original patent to the twenty-year patent term under 35 U.S.C. § 154(a)(2).

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicants.

(Reissue Declaration at 2.)

16. No other statement or explanation of how the error occurred appears to be in the record before us.

17. The record of the prosecution history does not appear to be remarkable, and Applicants have not raised any procedural complaints by petition.

18. The Examiner appears to have acted with exceptional promptness whenever the reissue application was placed in the Examiner's docket.

The Examiner's Rejection

19. The Examiner, relying on the guidance provided by the Manual of Examining Procedure ("MPEP") § 1405 (8th Ed., apparently Revision 2, published May 2004) rejected the claims on the basis that the error alleged in the Reissue Application Declaration was not an error correctable by reissue.

(Examiner's Answer, mailed 29 September 2006, at 3; Final Rejection mailed 3 September 2004, at 2.)

20. MPEP § 1405 reads in relevant part:

The maximum term of the original patent is fixed at the time the patent is granted. While the term may be subsequently shortened, e.g., through the filing of a terminal disclaimer, it cannot be extended through the filing of a reissue.

Accordingly, a deletion in a reissue application of an earlier-obtained benefit claim under 35 U.S.C. 120 will not operate to lengthen the term of the patent to be reissued.

(MPEP, 8th Ed., Rev. 5 (August 2006)³ (emphasis original).)

Applicants' Argument

21. Applicants argue that the purpose of the reissue statute is remedial, and errors without deceptive intent are correctable. (Br. at 8.)

22. More specifically, Applicants argue that their error was to file CPAs under 37 C.F.R. § 1.53(d), instead of continuing applications under 37 C.F.R. § 1.53(b). (Br. at 9.)

23. Appellants argue that had they filed under Rule 53(b), they would have been entitled to a term of 17 years from the date of issue under the terms of 35 U.S.C. § 154(c). (Br. at 2 and 9; clarified at oral argument.)

24. Applicants urge that the examiner and the MPEP fail to explain why Applicants' error "is not an 'error without any deceptive intent' unequivocally falling within in patent statute [35 U.S.C. § 251]." (Br. at 7.)

³ MPEP § 1405 has not been amended since Rev. 2, the version used by the Examiner at the time of the rejection.

25. Applicants complain that "[t]his approach makes it impossible for the applicant to respond as it provides no real explication of the Office's reasoning." (Br. at 8.)

26. More specifically, Applicants argue that they should have been permitted to correct their filing error by treating the CPAs as having been filed under 37 C.F.R. § 1.53(b). (Br. at 9.)

27. Applicants argue further that the "sole basis for denying the reissue request . . . is based solely on an interpretation of 35 U.S.C. § 154(c), (which interpretation itself is highly questionable subject at the appropriate time and manner to challenge as to correctness) found, as best be determined . . . in the Official Gazette notice of February 24, 1988." (Br. at 9–10.)

C. DISCUSSION

The section of the patent statute providing for correction of errors in a patent by reissue of the patent reads, in relevant part:

Whenever any patent is, through error without any deceptive intention, deemed 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, the Director 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.

35 U.S.C. § 251, first paragraph (emphasis added).

Applicants, in their words:

seek to claim the benefit of the full term of the original patent, which term was abridged by the erroneous filing of a Continued Prosecution Application under 37 C.F.R. § 1.53(d) instead of a continuing application under 37 C.F.R. § 1.53(b), thereby

subject[ing] the original patent to the twenty-year patent term under 35 U.S.C. § 154(a)(2).

(Reissue Declaration at 2.) The practical effect of having filed Continued Prosecution Applications is that the term of the 219 patent expires 20 years from 7 May 1987, i.e., on 7 May 2007, which is five days after the date on which oral argument was held. See 37 C.F.R. § 1.53(d) (1998)⁴. In contrast, Applicants assert that they are entitled to "the full term of the original patent," which they argue should have been 17 years from the date of issue.

We begin our consideration of the merits of this appeal by inspecting the language of the statute for its plain meaning. *Medrad, Inc. v. Tyco*

⁴ 37 C.F.R. § 1.53(d) reads in most relevant part:

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

37 C.F.R. § 1.53(d)(7) (1998) (emphasis added).

This provision was explained in the Notice of Final Rule Making issued in 1997 in the following words:

an application under § 1.53(d) cannot be amended to delete the specific reference to the prior application, as well as the specific reference to any application to which the prior application contains a specific reference under 35 U.S.C. 120, 121, and 365(c). As an application under § 1.53(d) will also contain a specific reference to at least one other application under 35 U.S.C. 120, 121, and 365(c), the expiration date under 35 U.S.C. 154(b)(2) of any patent issuing from the application under § 1.53(d) will be based upon the filing date of the prior application (or the earliest application to which the prior application contains a specific reference under 35 U.S.C. 120, 121, and 365(c)).

62 Fed. Reg. 53145 (10 October 1997) (emphasis added).

Healthcare Group LPC, 466 F.3d 1047, 1051, 80 USPQ2d 1526, 1528 (Fed Cir. 2006) (reh'g and reh'g en banc denied) ("If the words [of the statute] are unambiguous, no further inquiry is usually required." (citation omitted)). Section 251 states that if the Director reissues the patent, it shall be reissued "for the unexpired part of the term of the original patent." These words are plain, direct, and unambiguous. The term of the original patent is set upon issuance, and, by the terms of the statute, reissue cannot operate to extend that term. As the MPEP puts it, "[t]he maximum term of the original patent is fixed at the time the patent is granted." MPEP § 1405, 8th Ed., Rev. 5. While circumstances can be imagined under which patent term is shortened by requirements to disclaim term, e.g., to remove a rejection for obviousness-type double patenting, the expansion of patent term by reissue is foreclosed by the plain language of the statute.

Based on our review of the record, we find that the Examiner, following the MPEP, simply applied the plain language of the statute in holding that the error asserted by Applicants was not an error correctable by reissue. Accordingly, we reject Applicants' argument that they have not been accorded adequate notice of the basis of the Office's position.

We therefore AFFIRM the Examiner's rejection on the same basis as the Examiner: section 251 expressly forbids reissue expanding the term of a reissued patent.⁵

⁵ We also note that the reissue application was filed 23 July 2003, more than two years after the 19 June 2001 issue date of the 219 patent. It is arguable, but not clear, that Applicants are seeking a broadening Reissue. We do not base our decision on this point.

Even if the expanded patent term sought by Applicants were not barred by the plain language of § 251, the specific remedy Applicants seek, namely, correcting their filings under Rule 53(d) to filings under Rule 53(b), would not afford them the relief they seek. Their interpretation of 35 U.S.C. § 154(c) is incorrect.

Section 154(c) reads in relevant part:

The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

35 U.S.C. § 154(c)(1). The Uruguay Round Agreements Act was enacted on 8 December 1994. Thus § 154(c) applies to patents that result from applications filed before 8 May 1995. The original 256 application is such an application because it was filed on 4 April 1995. Had a patent issued from the 256 application, its term would have been 17 years from the date of issue, because that term is greater than 20 years from the date of the earliest application specifically referenced under section 120, 121, or 365(c) of title 35, United States Code, as provided in subsection (a) of § 154.

Patent term is set in 35 U.S.C. § 154(a)(2), which reads:

Subject to the payment of fees under this title, such grant shall be for a term beginning of the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121 or 365(c) of this title, from the date on which the earliest such application was filed.

Pursuant to § 534 of Pub. L. 103-465, the effective date of § 154(a)(2) is 8 June 1995.

A continuing application is a distinct application having a filing date that is different from the filing date of the parent application. A continuing application is entitled to the benefit of a previously filed, copending application if it contains a specific reference to the previously filed application and satisfies the other requirements of 35 U.S.C. § 120. Thus, the CPAs filed by Applicants in this case, if filed under Rule 53(b) as continuations of the 256 application, would have been granted filing dates of 21 January 1999 and 6 December 1999. Because these dates are not before 8 May 1995, the provisions of 35 U.S.C. § 154(c)(1) would not have applied to patents issuing from the hypothetical applications filed under Rule 53(b). This interpretation of § 154(c)(1) is a straight reading of what is a "patent . . . that results from an application filed before . . . ". We have considered the Official Gazette notice referred to by Applicants (1207 Off. Gaz. Pat. Office 83 (24 February 1988)), which is a reprint of the notice of "Interim rule with request for comments," 63 Fed. Reg. 5732 (4 February 1988), although Applicants have not explained what interpretation they think is expressed there. The only interpretation we have found is consistent with the one set out *supra*: "[a]s the continued prosecution application practice was not in effect prior to June 8, 1995, no patent issuing from a continued prosecution application is entitled to the provisions of 35 U.S.C. § 154(c)." *Id.* at 5733, quoting 62 Fed. Reg. 53144 (1997), 1203 Off. Gaz. Pat. Office at 74 (response to comment 25) (1977).

Accordingly, the specific correction sought by Applicants would not result in a reissued patent having a term of 17 years from the most recent filing date. In fact, the term of such a patent would have been identical to the term they now have, unless Applicants chose to forgo the benefit of

§ 120 to one or more of the parent applications. That course of action, however, would subject them to prior art dating from 23 June 1986 (the filing date of their Swiss application) until whatever benefit date they chose. At oral argument, Applicants indicated that they had always intended to keep their § 120 benefit dates.

Finally, even if the requested relief were statutory and the requested corrections would have yielded the result Applicants seek, Applicants have not shown that their error was one that is correctable by reissue. As the Federal Circuit has explained, "[t]he reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application." *In re Weiler*, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986). Thus, "not every event or circumstance that might be labeled 'error' is correctable by reissue." *Id.* at 1579, 229 USPQ at 677. As emphasized in a recent decision, "Our case law holds that the deliberate action of an inventor or attorney during prosecution generally fails to qualify as correctable error under § 251." *In re Serenkin*, 479 F.3d 1359, 1362, 81 USPQ2d 2011, 2014. In *Serenkin*, the court found that the applicant "intentionally and knowingly surrendered his right to a claim of priority, in exchange for a benefit, and is now unhappy with his choice." 479 F.3d at 1364, 81 USPQ2d at 2014. The court distinguished a number of cases, including several cited by Applicants to us, as being based on errors that "were the result of inadvertence, accident, or mistake, which are clearly appropriate bases for reissue. . . . The distinction is between a genuine error, or mistake, and a deliberate, but subsequently found to be disadvantageous, choice." *Id.*

Filing an application, including filing a continuing application, requires a number of positive steps, including determining what sort of continuing application is to be filed, whether any preliminary amendments are appropriate, whether the inventorship remains correct, whether copendency is maintained, et cetera. While some cases, including certain cases cited by Applicants, indicate that errors correctable by reissue can arise during the filing of a continuing application, those cases also indicate that the error was determined on the basis of a record that permitted the finder of fact to weigh evidence for and against the alleged inadvertence of the error.

In the present case, the only "evidence" of the nature and manner of the alleged error is Applicants' Reissue Declaration. Although "sworn," this amounts to mere pleading, as no facts are alleged that support the inadvertence of the alleged error. Applicants argue:

[a]ll that occurred here was an erroneous use of a PTO procedure (namely, the Continued Prosecution Application Procedure), instead of a regular continuing application under 37 C.F.R. § 1.53(b), without awareness of a virtually secret PTO policy that is in violation of the Administrative Procedure Act because that policy is tantamount to a rule that affects rights without proper statutory promulgation.

(Supplementary Reply Brief under 37 C.F.R. § 41.41 at 2, filed 29 November 2006.) We have already addressed the substance of Applicants' rhetorical flourishes; the difficulty with the remainder of this argument is that there is no evidence that could potentially enable us to conclude that what had happened was the result of a "trivial clerical error."

Rather, Applicants chose a course of *ex parte* prosecution, namely, to file CPAs under Rule 53(d), and now they regret the consequences. Notice of those consequences was published in the Federal Register on promulgation of the final rule. *See*, e.g., 62 Fed. Reg. at 53144 and 53245 (10 October 1997). Moreover, by choosing that course, they gained the benefit of avoiding challenges to their claimed subject matter from all art published after 23 June 1986, their Swiss foreign priority date, and as late as 6 December 1999. Granting Applicants' request for a full examination of their claimed subject matter based on a more recent priority date would be granting them the "second opportunity to prosecute *de novo*" their original application that the court precluded in *Weiler*. As our reviewing court has held, such "errors" are not correctable under § 251. Accordingly, Applicants have failed to show error by the Examiner.

We have reviewed the cases Applicants cited to the Examiner, but we conclude that they are not persuasive because the facts on which those cases rest are not sufficiently similar to the facts of this case that their holdings apply here.

D. ORDER

In view of the foregoing considerations, it is:

ORDERED that the Examiner's rejection is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136.(a).

AFFIRMED

lp

Appeal 2007-1119
Application 10/200,207

James F. McKeown
Crowell & Moring, LLP, Intellectual Property
Group
P.O. Box 14300
Washington, DC 20044-4300