



Paper No. 52

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIBALD KRAUS

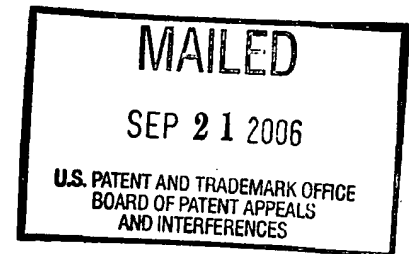
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Appeal 2005-0841  
Application 08/230,083<sup>1</sup>  
Technology Center 2600

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ORAL HEARING: April 7, 2005

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Before: FLEMING, Chief Administrative Patent Judge, and GARRIS, McQUADE, JERRY SMITH, RUGGIERO, GROSS, DELMENDO, FRANKLIN, MacDONALD and NAPPI, Administrative Patent Judges.<sup>2</sup>

PER CURIAM

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<sup>1</sup> Application filed April 20, 1994, seeking to reissue U.S. Patent 5,105,731, issued April 21, 1992, based on application 07/642,475, filed January 17, 1991. The real party in interest is TRW Automotive Electronics & Components Km/h and Co., KG, previously known as TRW United-Carr GmbH and Co., KG. Appeal Brief (second submission filed October 4, 2000), page 1.

<sup>2</sup> The appeal was originally heard by Administrative Patent Judges McQuade, Nase and Delmendo. Subsequent to oral argument, the panel was expanded to include Chief Administrative Patent Judge Fleming and Administrative Patent Judges Garris, Jerry Smith, Ruggiero, Gross, Franklin, MacDonald and Nappi. Applicant was offered, but declined, an opportunity for additional oral argument. Subsequent to the decision mailed February 22, 2006 (Decision I), Administrative Patent Judge Nase retired.

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MEMORANDUM OPINION and ORDER

This MEMORANDUM OPINION and ORDER supplements and makes the decision of this Board mailed on February 22, 2006 (Decision I) a final decision.

The Examiner has rejected claims 14 and 16 of the reissue application on appeal as being unpatentable under 35 U.S.C. 251 based on recapture. With respect to claim 14, a 6 to 4 majority of the panel affirms the decision of the Examiner. With respect to claim 16, the panel unanimously affirms the decision of the Examiner.

A (1) plurality opinion authored by Chief Judge Fleming, joined by Judges Jerry Smith, MacDonald and Nappi, (2) a concurring opinion authored by Judge Gross, joined by Judge Ruggiero, (3) an opinion concurring-in-part and dissenting-in-part authored by Judge Garris, joined by Judges Delmendo and Franklin, and (4) an opinion concurring-in-part and dissenting-in-part authored by Judge McQuade, follow.

FLEMING, Chief Administrative Patent Judge, with whom Jerry Smith, MacDonald and Nappi, Administrative Patent Judges, join, concurring.

A. Introduction<sup>3</sup>

7. On February 22, 2006, this Board entered a decision (Decision I) affirming the Examiner's rejection of claims 14 and 16.

8. In Decision I, with respect to claim 14, a 6 to 5 majority of the panel affirmed the decision of the Examiner. With respect to claim 16, the panel unanimously affirmed the decision of the Examiner.

9. Appellant filed a Brief in Response (Br. in Res.) to Decision I on April 27, 2006.

10. Pursuant to options offered by the Board in Decision I (p. 43), Appellant elected (Br. in Res. at p. 1) to treat Decision I of this Board as a non-final decision (Option 3 of Decision I at p. 44).

B. Findings of fact

Appellant references and agrees (Br. in Res. at pp. 2-3) with this Board's Findings of Fact 1-58 (Decision I at pp. 3-14). Appellant restates and agrees (Br. in Res. at p. 3) with the language of this Board's Finding of Fact 59 (Decision I at p. 14).

In addition to Findings 1-59 of Decision I, the following findings of fact are believed to be supported by a preponderance of the evidence.

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<sup>3</sup> The paragraph numbering within the Introduction, Findings of Fact, and Discussion contained herein follow sequentially from the last number of the same section in Decision I.

60. Claim 14 is directed to the second embodiment (Finding of Fact 22) shown in Figs. 1 and 6-8 (U.S. Patent 5,105,731 at col. 4, lines 31-42).

61. The “first springy tongue spaced from the surrounding wall” of claim 14 is shown as springy tongue 22, pocket like zone 23 (i.e. a space), and surrounding wall 21 of Fig. 6.

62. Claim 16 is directed to the first embodiment (Finding of Fact 18) shown in Figs. 9-11 (col. 5, lines 16-35).

63. The “resilient clip connection formed separate from the outer housing” of claim 16 is shown as tongue 22' and surrounding wall 21 of Fig. 9.

C. Discussion

1. Recapture principles

We incorporate by reference our discussion of recapture principles in Decision I (pp. 14-33) and supplement that discussion infra.

(13)

Reissue recapture is not a per se rule

Appellant argues (Br. in Res. at p. 8) “[t]he Board has taken a per se rule of reissue recapture to prevent applicant from retreating to any claim limitation determined to have secured allowance of the original patent.” Quite the contrary is true. No per se rule was adopted. As pointed out at page 22 of Decision I, “the Clement steps should not be viewed as per se rules.” Rather, “[t]he [E]xaminer can make out a prima facie

case of recapture by establishing that the claims sought to be reissued fall within Substeps (1) or 3(a) of Clement” and “once a prima facie case of recapture is established, the burden of persuasion then shifts to the applicant to establish that the prosecution history of the application which matured into the patent sought to be reissued establishes that a surrender of subject matter did not occur.” (Decision I at pp. 23-24) This rebuttable presumption is the antithesis of a per se rule.

Appellant also argues (Br. in Res. at p. 8) that at most “[his] decision not to appeal the Examiner’s original rejection of claims 1 and 3-11 [as filed,] but to amend the allowable claims into independent form may be considered to constitute an irrevocable admission that claims of the scope of claims 1 and 3-11 [as filed] are unpatentable.” Appellant’s point being that originally filed claims, which were then cancelled, can be viewed as being surrendered.

Such an irrevocable admission with respect to Appellant’s decision not to appeal the Examiner’s rejection of originally filed claims 1 and 3-11 is not before us in this appeal because Appellant has not sought to recapture in this reissue the originally filed claims he cancelled during prosecution of the original application. However, we do note that whether an admission is “irrevocable” or merely creates a “rebuttable presumption” is an open question given our discussion at pages 22-31 of Decision I.

(14)  
Appellant's view of surrender

Appellant argues (Br. in Res. at pp. 8-10) there is no reissue case under 35 U.S.C. § 251 in which a court has supported this Board's view of surrender. Rather, Appellant argues the courts support his view that only original patent application claims 1, 3-5, and 7-11 are surrendered subject matter. However, Appellant does not favor us with his views of the impact of principles announced in "doctrine of equivalents" cases on surrender in reissue recapture. We are of the view that "doctrine of equivalents" cases, particularly Festo I, Festo II, and Festo III (Decision I at p. 25), are applicable to surrender in reissue recapture (Decision I pp. 22-31). Appellant presents no argument that dissuades us from that view.

(15)  
Yamaguchi

Appellant argues (Br. in Res. at pp. 10-12) his position is similar to the situation in Ex parte Yamaguchi, 61 USPQ2d 1043 (Bd. Pat. App. & Int. 2001), which is a reissue recapture precedent binding on this Board. Appellant himself notes (Br. in Res. at pp. 11-12) the Board in Yamaguchi took the position that "The prosecution history of [Yamaguchi's] original application ... contains neither any amendments to the claims, nor any arguments made by appellants to overcome prior art or for any other purpose." 61 USPQ2d at 1046. We have already fully addressed and rejected Appellant's argument that he did not make an amendment (Decision I at pp. 37-41). We disagree with Appellant's premise that there has been no amendment. Given the presence of an

amendment by applicant during prosecution, we conclude Yamaguchi is inapplicable to the situation before us. Further, Appellant presents no convincing explanation why Yamaguchi would be applicable in the presence of such an amendment.

2. The Examiner's prima facie case

We incorporate by reference our discussion of the Examiner's prima facie case in Decision I (pp. 33-35) and modify that discussion only as noted infra.

Our findings of fact 55-58 (Decision I at pages 12-14) set out the basis upon which the Examiner made a recapture rejection. As noted in Finding 59 (Decision I at page 14), the record supports the Examiner's findings.<sup>4</sup>

3. Applicant's response to the Examiner's case

We incorporate by reference our discussion of Applicant's response in Decision I (pp. 35-43) and supplement that discussion infra.

(4) Argument as to the prima facie case

Appellant argues (Br. in Res. at pp. 12-13) that "the Examiner has not made a prima facie case of recapture." Quite the contrary is true as this Board pointed out at pages 33-35 of Decision I. As we concluded at page 35, "[t]he Examiner's accurate factual analysis demonstrates that the Examiner has made out a prima facie case of recapture."

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<sup>4</sup> It is Finding of Fact 59, which notes that the record supports the Examiner's findings rather than Finding 58 as stated by this Board at page 33 of Decision I.

Further, given this prima facie case the Appellant was invited at Option 3 (Decision I at page 44) to provide a rebuttal to the presumption of surrender based “(1) on the record, as it exists at this time, and (2) any public document not in the record at the present time, provided the document was available to the public at the time an amendment was made.” Appellant elected Option 3 (Br. in Res. at p. 1), but has not favored us with any such rebuttal evidence.

(5) Argument as to the view of one skilled in the art

Appellant argues (Br. in Res. at pp. 13-14) that:

- 1) “one of ordinary skill in the art would likely view ...”;
- 2) “one of ordinary skill in the art would not necessarily place ...”;
- 3) “one of ordinary skill in the art would not necessarily be inclined to place ...”; and
- 4) “one of ordinary skill in the art might look ...” (emphasis added).

Speculative argument of counsel as to what is likely or not likely, what is necessarily true or not necessarily true, or what might occur or might not occur is not a substitute for evidence in the record. As we noted above, Appellant was invited to provide rebuttal evidence and has not favored us with any such evidence.

Appellant also argues again at page 14 that “it is clear from the record that applicants never amended [originally filed claim 12] but, rather, simply presented a new independent claim 16 including all the limitations of [allowable] claim 12 as filed together with base claim 1 and intervening claims 10 and 11.” We agree Appellant did what he says he did, but we do not agree that what he did is not an amendment. When



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presented with a similar situation Honeywell (Decision I at p. 38), our reviewing court held such a change to be an amendment involving “surrender” in the context of the doctrine of equivalents. Appellant has not favored us with any reason why we should not follow the Honeywell principles with respect to “surrender” in the context of reissue recapture.

(6) Repeated arguments

Appellant’s Brief in Response at pages 14-17 and 19-21 merely repeats verbatim the arguments found at pages 10-13 and 15-17 of Appellant’s Reply Brief of September 28, 2004. We have already fully addressed and rejected those arguments at pages 35-43 of Decision I.

(7) Eggert arguments

Appellant’s Brief in Response at pages 17-19 and 21-22 argues that reissue claim 14 and reissue claim 16 do “not violate the Recapture Doctrine according to the Eggert analysis.” We have already fully addressed those arguments at pages 19-21 of Decision I. We reiterate:

It is believed that the Substep (3)(a) rationale of the Eggert majority (1) is not consistent with the rationale of the Federal Circuit in North American Container and (2) should no longer be followed or be applicable to proceedings before the USPTO.

Decision I at page 21.

D. Decision

Upon consideration of the record, and for the reasons given herein and in the opinion in support of Decision I, the decision of the Examiner rejecting reissue claims 14 and 16 based on recapture is affirmed.

E. Options for further proceedings:

1. Option 1: Applicant can accept our decision, in which case the appeal would be concluded.
2. Option 2: Within two (2) months of the date of this decision, applicant may file a request for rehearing. 37 CFR § 41.52(a)(1) (2005).
3. Option 3: Applicant may treat our decision as a final decision and seek judicial review within the time set out in 37 CFR § 1.304(a)(1) (2005).

F. Non-extendable period for response

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (2005).



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Judge Gross, with whom Judge Ruggiero joins, concurring.

We incorporate by reference our discussion of recapture principles, the relevant case law, and its application to reissue claims 14 and 16 in Decision I (pages 46-69).

We supplement that discussion, infra.

Appellant argues (Brief in Response, pages 8-10) that surrendered subject matter has been determined to be “either (1) the rejected claim to be deliberately canceled or amended in an effort to overcome a prior art rejection . . . ; or (2) the argued claim minus the argued limitations when surrender occurs through arguments alone.” Appellant further asserts (Brief in Response, page 9) that there are no reissue cases wherein it has been determined that surrendered subject matter includes the territory falling between a rejected claim and an amended allowable claim. However, appellant fails to acknowledge or comment upon the analysis in our concurring opinion of Decision I at pages 47-61 of the reissue cases decided by the Federal Circuit. As summarized at page 61 of Decision I, we find that according to the Federal Circuit, surrendered subject matter included any claim that lacks a limitation directed to the specific subject matter added in the original prosecution to overcome a prior art rejection.

Regarding Ex Parte Yamaguchi, the facts of the instant case differ therefrom so as to render Yamaguchi inapplicable. Specifically, as pointed out by appellant (Brief

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in Response, pages 10-12), the examiner in Yamaguchi allowed the claims in the first office action with no action by the applicant. Further, the reasons for allowance paraphrased the entire claim rather than specifying any particular limitation that was lacking from the prior art. In contrast, in the present situation, the examiner indicated that the limitations of original claims 2 and 12 were absent from the prior art, and appellant amended all of the claims (by substituting new independent claims for claims 1 and 11) to include those limitations. Thus, appellant's action indicates reliance upon specific limitations to overcome a prior art rejection in the original prosecution. Accordingly, the prosecution history provides evidence relevant to surrender as it includes an amendment to the claims to overcome a prior art rejection.

Appellant (Brief in Response, pages 14-22) analyzes reissue claims 14 and 16 using Ex Parte Eggert. However, as explained at pages 60-61 of Decision I, we find that Eggert is no longer consistent with the rationale of the Federal Circuit and should no longer be followed. Instead, as indicated at pages 46-61 of Decision I, claims should be analyzed using In re Clement as interpreted in light of Hester, Pannu, and North American Container. See our analysis of reissue claims 14 and 16 at pages 62-68 of Decision I, wherein we found that appellant has attempted to recapture surrendered subject matter in each of reissue claims 14 and 16. Nothing in

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the Brief in Response convinces us of any error in our analysis and conclusion.

Accordingly, the rejection of reissue claims 14 and 16 should be affirmed.

<i>Joseph Ruggiero</i>	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	BOARD OF PATENT
	)	
<i>Anita Pellman Gross</i>	)	APPEALS AND
ANITA PELLMAN GROSS	)	INTERFERENCES
Administrative Patent Judge	)	

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Judge Garris, with whom Judges Delmendo and Franklin join, concurring-in-part and dissenting-in-part.

We adhere to our opinion, which we incorporate herein by reference, expressed in Decision I (pages 70-101) wherein we set forth our rationale in favor of reversing the rejection of claim 14 and affirming the rejection of claim 16 under 35 U.S.C. § 251.

The Appellant's Brief in Response to this Decision contains arguments that this expanded panel of the Board committed error in affirming the rejection of claim 16. Because these arguments are fully rebutted in the record of this appeal, we shall not reiterate the rebuttals here. It follows that, for reasons of record, we remain unpersuaded by the Appellant's contentions that the claim 16 rejection is in error.

For the reasons expressed in our Decision I opinion, we also remain convinced that the majority has erred in determining that the § 251 rejection of claim 14 should be affirmed. In reaching this determination, the majority has concluded that it is no longer proper under any circumstances to define surrendered subject matter appertaining to the recapture rule in terms of a claim which has been cancelled or amended in order to avoid a rejection. Instead, it is the majority's view that surrendered subject matter must now be defined under all circumstances as including any claim which lacks a limitation added or argued by an applicant in order to avoid a rejection. As phrased by the plurality opinion,

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the "surrendered subject matter" that may not be recaptured through reissue should be presumed to include subject matter broader than the patent claims in a manner directly related to (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and (2) limitations argued to overcome a patentability rejection without amendment of a claim [Decision I, pages 27-28; emphasis deleted].

As expressed somewhat differently in the concurring opinion, "the proper interpretation of the applicable and binding case law is that surrendered subject matter includes any claim that lacks a limitation directed to the specific subject matter that was added to overcome a prior art rejection" (*id.* at page 61).

The majority's position regarding surrendered subject matter is erroneous.

As fully explained in our Decision I opinion including the appendices thereof, binding precedent includes numerous decisions which defined surrendered subject matter in terms of a claim that had been canceled or amended to avoid a rejection. For example, see In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984); In re Richman, 409 F.2d 269, 161 USPQ 359 (CCPA 1969); In re Byers, 230 F.2d 451, 109 USPQ 53 (CCPA 1956); In re Wadsworth, 107 F.2d 596, 43 USPQ 460 (CCPA 1939). The majority has contradicted this binding precedent in taking the position that such a definition is no longer proper under any circumstances.



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It is clear that the definition of surrendered subject matter espoused by the majority would be proper under appropriate factual circumstances. For example, see Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir.), cert. denied, 525 U.S. 947 (1998). However, the majority has erred in contending that such a definition is proper under all circumstances. This error is revealed by the unacceptable consequences of the majority's decision to affirm the § 251 rejection of claim 14.

A discussion of these consequences follows.

We begin with the established legal principles that the recapture rule is analogous to prosecution history estoppel (id., 142 F.3d at 1481-82, 46 USPQ2d at 1649) and that actions or statements made during prosecution must be clear and unmistakable to establish disavowal or surrender of subject matter under either the recapture rule (id.) or prosecution history estoppel (Omega Eng'g., Inc. v. Raytek Corp., 334 F.3d 1314, 1325-26, 67 USPQ2d 132, 1329 (Fed. Cir. 2003)). The prosecution history involved in this appeal does not include any actions or statements which, as in North American Container, Inc., v. Plastipak Packaging, Inc., 415 F.3d 1335, 1349-50, 75 USPQ2d 1545, 1556-57 (Fed. Cir. 2005) or Hester, clearly and unmistakably surrender the subject matter upon which is based the majority's recapture determination. On the contrary, this prosecution history contains clear and unmistakable evidence in the form of patent claim 11 that the subject matter in question has not been surrendered as more fully explained in our Decision I opinion (e.g., see

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page 73). Significantly, neither the plurality opinion nor the concurring opinion addresses this deficiency of the majority decision.

In addition, the majority's affirmance of the claim 14 rejection violates the Appellant's statutory rights under 35 U.S.C. § 251. At pages 72 and 94-96 of Decision I, we previously explained that claim 14 includes a narrowing aspect directed to an expressly disclosed embodiment of the invention which had never before been claimed. In this regard, claim 14 includes a material narrowing relative to an overlooked aspect of the invention. For this reason claim 14 avoids the recapture rule under any definition of surrender because it is "materially narrower in other overlooked aspects of the invention" and thereby provides the Appellant with "a scope of protection to which he is rightfully entitled for such overlooked aspects" (Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1650). Again, neither the plurality opinion nor the concurring opinion addresses this deficiency of the majority decision to affirm the claim 14 rejection.

The plurality opinion is also defective in applying to the recapture rule the policy considerations which attend surrendered subject matter via prosecution history estoppel as discussed in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002). According to the plurality "[t]he same policy considerations that prevent a patentee from urging equivalents within what the Supreme Court refers to as 'surrendered territory' should prima facie prohibit the patentee from being able to claim subject matter within the surrendered territory in reissue" (Decision I, page 27).


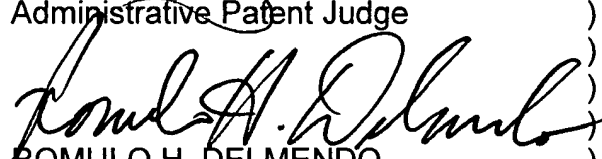

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Contrary to the plurality's belief, however, the policy considerations relating to prosecution history estoppel vis-à-vis the doctrine of equivalents are not coincident with the policy considerations relating to the recapture rule vis-à-vis reissue. See Ball, 729 F.2d at 1439 n.29, 221 USPQ at 296-97 n.29. For example, by extending protection beyond the literal terms in a patent, the doctrine of equivalents can create substantial uncertainty about where the patent monopoly ends, and, to reduce this uncertainty, the public may rely on the prosecution history of the patent proceedings. Festo, 535 U.S. at 727. On the other hand, this uncertainty is not present in the context of reissue since the original patent is surrendered in favor of the reissue patent which contains a new public record of prosecution history. 35 U.S.C. § 251.

The majority's definition of surrendered subject matter has certain desirable attributes such as uniformity and simplicity of application. Because of these attributes, this definition provides the Patent and Trademark Office with an exceedingly low hurdle for establishing a prima facie case of recapture. Regardless, this definition is fatally erroneous in that it is contrary to the binding precedent of our past and present reviewing courts and is contrary to a reissue applicant's right under 35 U.S.C. § 251 to enlarged claim scope.

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For the reasons set forth above and in our opinion at pages 70-101 of  
Decision I, we would reverse the rejection of claim 14 and affirm the rejection of  
claim 16 under 35 U.S.C. § 251.

  
BRADLEY R. GARRIS  
Administrative Patent Judge )  
  
ROMULO H. DELMENDO )  
Administrative Patent Judge )  
  
BEVERLY A. FRANKLIN )  
Administrative Patent Judge )

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Judge McQuade, concurring-in-part; dissenting-in-part.

I remain of the view, for the reasons set forth in the decision mailed February 22, 2006 (see pages 102-105), that the 35 U.S.C. § 251 rejection should be reversed with respect to claim 14 and affirmed with respect to claim 16.

In the brief filed April 27, 2006, the appellant continues to argue that the rejection of claim 16 is unsound, essentially because:

a) “[r]eissue claim 16 is in no way broader than the surrendered subject matter [original application claims 1, 10, and 11]” (page 20);

b) “[e]ach and every limitation of the surrendered subject matter finds a corresponding limitation in reissue claim 16” (page 20); and

c) “reissue claim 16 has been narrowed relative to the surrendered subject matter in that it includes the limitation of ‘the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle’” (page 21).

The appellant’s first two points regarding the alleged lack of any broadening in reissue claim 16 relative to original application claim 11 are not well taken.

Original application claim 11, which admittedly embodies surrendered subject matter, recites via its dependency from original application claim 10 that the clip connection of the claimed check valve assembly comprises “a springy tongue.” Reissue claim 16 contains no such limitation.

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Hence, the appellant's position that reissue claim 16 is in no way broader than the surrendered subject matter as embodied by original application claim 11 and that each and every limitation of this surrendered subject matter finds correspondence in claim 16 is without merit.

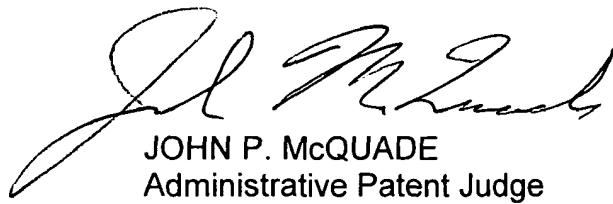
The appellant's third point asserting a narrowed aspect of claim 16 as compared to original application claim 11 is well founded but of no moment with respect to the recapture analysis.

More particularly, reissue claim 16 is narrower than original application claim 11 in that it calls for the clip connection to secure the outer housing to the locking element. In contrast, original application claim 11 fails to specify how the locking element and housing element are connected. The underlying disclosure, however, does not attribute much importance to the manner in which this connection is effected. In this regard, the specification merely states that the locking element 30 "can be connected with the outer housing 3" (column 5, lines 21 and 22, emphasis added), and that the locking element "may also have a gripping edge 33 [shown in Figures 9-11 as part of the clip connection or springy tongue 22'] to engage behind a stop surface 32 of the outer housing 3" (column 5, lines 26-28, emphasis added).

Consequently, while claim 16 is narrower than original application claim 11 in the aspect noted by the appellant, the narrowing is relatively minor as compared to the broadened aspect of the claim.

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In summary, and as stated in the earlier decision, "claim 16 would allow the appellant to regain through reissue subject matter that was surrendered to obtain the patent" (page 105).



JOHN P. McQUADE  
Administrative Patent Judge

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