

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD MARC CLEMENT and STEPHEN DAVIES

Appeal No. 2003-0124
Application No. 09/487,832

HEARD: March 5, 2003

Before FLEMING, NASE, and SAADAT, ***Administrative Patent Judges***.
FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 23-45. Claims 1, 2, and 4-22 have been allowed. Claim 3 has been canceled.

The invention relates to a security system to detect unauthorized removal of articles from a restricted area, such as a retail store. See column 1, lines 5-7 of Appellants' specification. Fig. 1 is a block diagram schematically showing the individual elements of a security system in accordance with Appellants' invention. See column 2, lines 9-11 of Appellants'

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specification. Each store also has at least one point-of-sale, having read/write equipment 30. This equipment is linked to the store's stock control computer 20. See column 2, lines 53-58 of Appellants' specification. The equipment 30 is used to read the tag of each article being purchased. See column 2, lines 58-62 of Appellants' specification. The equipment 30 also includes a write head 34 which writes data into the tag of each article being purchased, to indicate that the article has been paid for. See column 2, line 67 through column 3, line 4 of Appellants' specification. At each exit of the store, a fixed detector 40 is installed to check that every article being taken out of the store has been paid for. See column 3, lines 7-15 of Appellants' specification. If it is determined that the detector 40 fails to read such data, detector 40 initiates an alarm. See column 3, lines 14-15 of Appellants' specification. The store also has a refunds or returns department, which includes read/write equipment 50. When a customer returns an article to this department, the equipment 50 is used to read the tag to check that the article has been paid for. This information is erased from the tag memory so that the article can be returned to stock. See column 3, lines 40-50 of Appellants' specification.

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Independent claim 23 present in the reissue application is reproduced as follows:

23. A security system to detect unauthorized removal of articles from a restricted area such as a retail store, in which each article carries a read/write tag, the security system comprising:

at least one point-of-sale or point-of authorization apparatus arranged to write specific data into (or erase specific data from) the tag to indicate that the article has been paid for, or its removal has otherwise been authorized;

a detector apparatus for the or each exit of said restricted area, said detector apparatus being arranged to read each tag to determine if said specific data has been written into (or erased from) the tag and otherwise to initiate an alarm; and

a refunds/returns detector apparatus arranged to read the tag of each article presented to it and to determine if said specific data has been written into (or erased from) the tag, and to erase (or write in) said data so that the article can be returned to stock.

Reference

The reference relied on by the Examiner is as follows:

Anders et al. (Anders) 4,656,463 Apr. 7, 1987

Rejections at Issue

Claims 42-45 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling disclosure.

Claims 23-45 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 23 and 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Anders.

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Claims 23-45 stand rejected under 35 U.S.C. § 251.

Rather than repeat the arguments of Appellants or Examiner, we make reference to the briefs¹ and the answer for the respective details thereof.

OPINION

With full consideration being given the subject matter on appeal, the Examiner's rejections and the arguments of Appellants and the Examiner, for the reasons stated *infra*, we reverse the rejection of claims 42-45 under 35 U.S.C. § 112, first paragraph, the Examiner's rejection of claims 23-30 and 32-45 under 35 U.S.C. § 112, second paragraph, the Examiner's rejection of claims 23 and 24 under 35 U.S.C. § 102 and the Examiner's rejection of claims 23-45 under 35 U.S.C. § 251. In addition, for the reasons stated *infra*, we affirm the rejection of claim 31 under 35 U.S.C. § 112, second paragraph.

We first will address the rejection of claims 42-45 under 35 U.S.C. § 112, first paragraph.

As noted by our reviewing court in *Enzo v. Calgene*, 188 F.3d 1362, 1371, 52 USPQ2d 1129, 1135 "[t]he statutory basis for the

¹ Appellants filed an Appeal Brief on January 29, 2002. Appellants filed a Reply Brief on May 15, 2002. The Examiner mailed an Office communication on May 30, 2002, stating that the Reply Brief had been entered.

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enablement requirement is found in Section 112, Para. 1, which provides in relevant part that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same

35 U.S.C. § 112, Para. 1 (1994)." "To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." **Genentech, Inc. v. Novo Nordisk, A/S** 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (**quoting In re Wright**, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, **see Hybritech, Inc. v. Monoclonal Antibodies, Inc.**, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986),. . . Our reviewing court has held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." **See, e.g., In re Wands,**

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858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)("Enablement is not precluded by the necessity for some experimentation However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation'.")(footnotes, citations, and internal quotation marks omitted). In **Wands**, the court set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. **Id.** at 737, 8 USPQ2d at 1404. The court has also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. **See, Amgen, Inc. v. Chugai Pharm. Co., Ltd.**, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the **Wands** factors "are illustrative, not mandatory. What is relevant depends on the facts.").

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The Examiner argues that the original disclosure teaches that the detector equipment (40) comprises ferrite core aerials (60). The Examiner argues that the ferrite core aerials are disclosed to form part of the detector equipment. The disclosure does not recite or teach separate elements for the detector apparatus and the ferrite core aerial and does not teach a relationship between these elements. See page 3 of the Examiner's final action.

Appellants argue that the Examiner's rejection fails to consider the disclosure as a whole. In particular, Appellants argue that the original claims teach that the detector apparatus is a separate element from the ferrite core aerial. See page 14 of Appellants' brief.

Upon our review of the Examiner's rejection, it is unclear to us whether the Examiner is basing the rejection on the fact that one of ordinary skill in the art would not be enabled to make and use the invention or that the Appellants had failed to properly describe their invention. Our reviewing court has made it clear that written description and enablement are separate requirements under the first paragraph of 35 U.S.C. § 112. **Vas-Cath Inc. v. Mahurkar**, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114

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(Fed. Cir. 1991). Thus, we will treat these two issues separately.

"The function of the description requirement [of the first paragraph of 35 U.S.C. § 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." ***In re Wertheim***, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations." ***Wertheim***, 541 F.2d at 262, 191 USPQ at 96 ***citing In re Smythe***, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973). Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." ***In re Wilder***, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), ***cert. denied***, 469 U.S. 1209 (1985), ***citing In re Kaslow***, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

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Upon our review of claim 42, we find that the issue is a matter of claim scope rather than description or enablement. In claim 42, the security system includes a detector apparatus being arranged to read each tag to determine if the specific data has been written into (or erased from) the tag. In claim 42, the security system also includes at least one ferrite core aerial. The scope of the claim is such that it causes both security systems in which the ferrite core aerial is or is not included in the detector apparatus. However, we fail to find that the breadth of the claim by itself gives rise to an issue of description or enablement. Appellants are just simply claiming different scope for the detector apparatus. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, second paragraph, Rejection

The Examiner rejects claims 23, 35, 38 and 42 under 35 U.S.C. § 112, second paragraph, because they recite the language "such as a retail store." The Examiner alleges that the language is confusing over what is the intended scope of the claim.

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe

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the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), ***citing In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. ***See In re Hyatt***, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) ***citing In re Borkowski***, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970). "The legal standard for definiteness is whether a claim reasonably appraises those of skill in the art of its scope." ***In re Warmerdam***, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

We fail to find that an example given in the preamble makes the claims indefinite so that one of ordinary skill in the art could not ascertain their scope. The only question is whether or not that language provides patentable weight. Therefore, the Examiner is questioning breadth and not whether the claims fail

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to set out and circumscribe a particular area for the reasonable degree of precision and particularity.

The Examiner also rejects claim 31 because the language "said identity code read from the respective tag" and "said point-of-sale read/write means" lacks proper antecedent basis. We also note the Appellants have not argued otherwise.

Upon our review, we find that claim 31 does fail to set forth the proper antecedent basis for "said identity code read from the respective tag" and "said point-of-sale read/write means." It appears to us that the problem is that claim 31 should depend from claim 30 rather than claim 28. Therefore, we will not sustain the Examiner's rejection of claims 23-30 and 32-45 under 35 U.S.C. § 112, second paragraph. However, we will sustain the Examiner's rejection of claim 31 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 102 Rejection

The Examiner has rejected claims 23 and 24 under 35 U.S.C. § 102 as being anticipated by Anders. Appellants have argued that Anders does not teach that the data is written to or removed from the tag on the item. See page 13 of the brief.

Upon our careful review of Anders, we fail to find that Anders teaches "at least one point-of-sale or point-of-

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authorization apparatus arranged to write specific data into (or erase specific data from) 'the tag to indicate that the article has been paid for, or its removal has otherwise been authorized'" as recited in Appellants claim 23.

The Examiner argues that Anders teaches

in the context of a retail store (Fig. 26), Anders et al disclose a 'point-of-sale apparatus' or cash register 319 which is 'connected to the department store's central AT data bank' (col. 37, lines 12-13), for writing or erasing 'specific data' on the tag (i.e., the tag and article will be delet(ed) from inventory,'" col. 37, line 20) to permit its removal from the store. [See page 4 of the final rejection].

Upon our review of Anders, we fail to find that Anders teaches

at least one point-of-sale or point-of-authorization apparatus arranged to write specific data into (or erase specific data from) the tag to indicate that the article has been paid for, or its removal has otherwise been authorized;

. . . .

a refunds/returns detector apparatus arranged to read the tag of each article presented to it and to determine if said specific data has been written into (or erased from) the tag, and to erase (or write in) said data so that the article can be returned to stock.

Upon our review of Anders, we find that Anders teaches that the inventory of the items are maintained in a central location.

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Each item has a tag which electronically identifies it. A signal is broadcast to locate the item. Before the item can be removed from the store, Anders' central database must be altered to remove the item from the inventory. Anders does not teach altering the data stored on the tag. Looking to the portions of Anders that the Examiner has pointed us to, we find that Anders teaches that in the event that an item having a PT is removed from the broadcast range of the antenna 322, and no deletion from inventory has been made, a buzzer 323 sounds a code to clerks nearby that an item has been removed from the permitted zone. See column 37, lines 17-22. Anders teaches that the inventory is stored at the central AT data bank. See column 37, lines 13-14. From the entire reading of column 37, lines 6-37, we find that Anders teaches that only the inventory code is removed at the central AT data bank and that the data stored on the PT is not modified. Therefore, we will not sustain the Examiner's rejection of claims 23 and 24 under 35 U.S.C. § 102 as being anticipated by Anders.

35 U.S.C. § 251 Rejection

Claims 23-45 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present

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reissue is based. The Examiner argues that the subject matter of claims 2-4 and 9 of the original application was previously surrendered upon the issue of the original application. See pages 2 and 3 of the Examiner's final rejection.

In the declaration of Hedley W. Austin, Mr. Austin declares that he was in charge of directing the prosecution of the original application that became U.S. Patent No. 5,710,540 ("the '540 patent"). Mr. Austin declares that he saw the official action of September 30, 1996, relevant to the original application, that the Examiner indicated that claims 2 and 3 would be allowable if rewritten in independent form to include all the limitations of Appellants' claim 1 and that claims 4 and 9 would be allowable if rewritten to cure the "lack of antecedent basis" issues due to improper dependent claims. Mr. Austin further declares that he completed and prepared detailed instructions to the U.S. attorney Mr. D. Gordon to file an amendment preserving the subject matter of claims 2-4 and 9. On February 12, 1997, Mr. Gordon submitted an amendment in response to the office action of September 30, 1996, incorporating the new claim which Mr. Austin had provided him. The new claims did not preserve the subject matter of claims 2-4 and 9 but instead were substantially narrower in scope than claims 2-4 and 9. Mr.

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Austin declares that these errors arose inadvertently in the course of Mr. Austin's instructions to Mr. Gordon, without any deceptive intent on Mr. Austin's part. See page 4 of the Declaration. Mr. Austin further declares that the errors were not appreciated by the Applicant, or by Mr. Austin, or by Mr. Gordon, or by the Examiner during the prosecution of the '585 application which resulted in issuance of the '540 patent. See page 5 of the Declaration.

Mr. Austin further declares that he believes that the claimed drafting errors introduced in his instructions to Mr. Gordon were the result of simple oversight and compounded by haste caused by the difficult circumstances surrounding the subject patent application and the Assignee at the time. See page 6 of the Declaration.

35 U.S.C. § 251, ¶ 1, provides in pertinent part:

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 [Director] shall . . . 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.

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35 U.S.C. § 251, ¶ 4, provides:

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.

Thus, the plain meaning of the statute allows for broadening of the scope of the claims of the original patent by reissue if applied for within two years from the grant of the original patent and the error is without any deceptive intention.

In summary, the record shows that the Examiner had indicated that claims 2 and 3 in the original application were allowable. The Examiner also had indicated that claims 4 and 5 would be allowable if rewritten to cure the 35 U.S.C. § 112, second paragraph, issues of lack of antecedent basis due to improper dependency. Furthermore, the record contains evidence that the Appellants did not intend to surrender the subject matter of claims 2-4 and 9 of the original application.

With respect to a different but related issue, namely, prosecution history estoppel, the United States Supreme Court recently recognized that,

[u]nfortunately, the nature of language makes it impossible to capture the essence of a thing in a patent application. The inventor who chooses to patent an invention and disclose it to the public, rather than exploit it in secret, bears the risk that

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others will devote their efforts toward exploiting the limits of the patent's language:

An invention exists most importantly as a tangible structure or a series of drawings. A verbal portrayal is usually an afterthought written to satisfy the requirements of patent law. This conversion of machine to words allows for unintended idea gaps which cannot be satisfactorily filled. Often the invention is novel and words do not exist to describe it. The dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake of words, but words for things. *Autogiro Co. of America v. United States*, 384 F.2d 391, 397 [155 USPQ2d 697] (Ct. Cl. 1967).

The language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. For this reason, the clearest rule of patent interpretation, literalism, may conserve judicial resources but is not necessarily the most efficient rule. The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described. See *Winans v. Denmead*, 15 How. 330, 347 (1854).

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Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 122 S.Ct. 1831, 1837, 62 USPQ2d 1705, 1709-10 (2002). The United States Supreme Court also acknowledged that patent applicants should not be presumed to have had more foresight in making such amendments than an applicant whose application was granted without amendments having been submitted. Id. at 1841, 62 USPQ2d at 1712.

Moreover, with respect to the reissue statute, as recently explained by our reviewing court in In re Doyle, 293 F.3d 1355, 1358, 63 USPQ2d 1161, 1164 (Fed. Cir. 2002),

[b]y its terms section 251 restricts reissue to situations in which an error occurred - situations that include the patentee having "claim[ed] more or less than he had a right to claim in the patent." "The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986).

We are also mindful, however, of the admonition that

[e]rror under the reissue statute does not include a deliberate decision to surrender specific subject matter in order to overcome prior art, a decision which in light of subsequent developments in the marketplace might be regretted. It is precisely because the patentee amended his claims to overcome prior art that a member of the public is entitled to occupy the space abandoned by the

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patent applicant. Thus, the reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become infringers when they do so.

Mentor Corp. v. Coloplast Inc., 998 F.2d 992, 996, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). This is the underlying policy behind what has come to be known as the "reissue recapture rule." In its simplest terms, this rule may be summarized as follows: A patentee is precluded from recapturing in reissue that which he earlier conceded was unpatentable and abandoned or surrendered, whether by cancellation, amendment or argument of claims, for the purpose of obtaining the original patent.

Accordingly, it seems clear to us that the reissue recapture rule focuses on that which the prosecution history indicates that applicant intended to give up or concede to be unpatentable by an applicant, i.e., the "surrendered subject matter," in order to obtain a patent, for this is the subject matter. It is the surrendered subject matter which cannot be recaptured in reissue.

Upon our review of the facts, we find that the reissue recapture rule does not apply. As pointed out above, Appellants did not intend to give up or concede that the subject matter of claims 2-4 and 9 were unpatentable. Appellants did this in error without deceptive intent and finally, the Appellants did not give

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up the subject matter of claims 2-4 and 9 to induce the Examiner to issue the patent because these claims were indicated by the Examiner as allowable. Therefore, we will not sustain the Examiner's rejection of claims 23-45 under 35 U.S.C. § 251.

In view of the foregoing, we have sustained the Examiner's rejection of claim 31 under 35 U.S.C. § 112, second paragraph. However, we have not sustained the Examiner's rejection of claims 42-45 under 35 U.S.C. § 112, first paragraph, the rejection of claims 23-30 and 32-45 under 35 U.S.C. § 112, second paragraph, the rejection of claims 23 and 24 under 35 U.S.C. § 102 and the rejection of claims 23-45 under 35 U.S.C. § 251.

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

AFFIRMED-IN-PART

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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