

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not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOACHIM WERRES

Appeal 2006-2966
Application 09/148,152¹
Technology Center

Decided: July 3, 2007

Before BRADLEY R. GARRIS, Administrative Patent Judge,
FRED E. MCKELVEY, Senior Administrative Patent Judge, and
ALLEN R. MACDONALD, *Administrative Patent Judge*.

GARRIS, *Administrative Patent Judge*.

¹ Application filed September 3, 1998, for reissue of U.S. Patent No. 5,656,177, which issued August 12, 1997 from Application No. 08/352,097, filed November 30, 1994.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-39 in the above-identified reissue application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellant claims a method of decreasing microbial growth and preventing slime formation in an aqueous medium which comprises incorporating into the aqueous medium an effective microbial growth retarding and slime formation preventing amount of an oil-in-water emulsion. Reissue claim 1, which corresponds to Patent claim 1, defines the method in terms of the species elected without traverse during patent prosecution. Reissue claim 10 defines the method in terms which are generic to the elected species. These claims adequately represent the claimed subject matter on appeal and are reproduced below:

1. A method of decreasing microbial growth and preventing slime formation in an aqueous medium comprising the step of incorporating in said aqueous medium an effective microbial growth retarding and slime formation preventing amount of an oil-in-water emulsion comprising an oil phase and at least one emulsifier for the oil phase, wherein the oil phase comprises saturated or unsaturated, open-chain, normal or isomeric hydrocarbons containing 8 to 30 carbon atom [sic]; and wherein said emulsion is free of toxic microbiocides.

10. A method of decreasing microbial growth and preventing slime formation in an aqueous medium comprising the step of incorporating in said aqueous medium an effective microbial growth retarding and slime formation preventing amount of an oil-in-water emulsion comprising an oil phase and at least one emulsifier for the oil phase, wherein the oil phase comprises at least one substance selected from the group consisting of:

- (i) saturated or unsaturated, open-chain or cyclic, normal or isomeric hydrocarbons containing 8 to 30 carbon atoms;
 - (ii) saturated or unsaturated fatty alcohols, saturated or unsaturated fatty acids, fatty acid monoalkyl esters, fatty acid amides, or monoalkyl amides of saturated or unsaturated fatty acids, wherein the fatty alcohol, fatty acid or fatty acid residue contains 8 to 30 carbon atoms;
 - (iii) monoesters or polyesters of saturated or unsaturated fatty acids containing 4 to 30 carbon atoms and monoalcohols or polyols except for polyethylene glycols;
 - (iv) polyamides of saturated or unsaturated fatty acids containing 8 to 30 carbon atoms and aliphatic polyamines containing 2 to 6 nitrogen atoms;
 - (v) acyclic, monocyclic or bicyclic terpenes; and
 - (vi) polyoxyalkylene compounds formed from alkylene oxides and at least one substance selected from the group consisting of C₁₂-C₁₈ fatty alcohols, C₁₂-C₁₈ fatty acids and glycerides of C₁₂-C₁₈ fatty acids;
- wherein when the aqueous medium is a water piping or a cooling or heating cycle or an industrial process water as a water carrying system and a substance of group (v) is used, said substance of group (v) is always used in admixture with at least one substance of the groups (i) – (iv) or (vi), and wherein said emulsion is free of toxic microbiocides.

Claims 1-39 are rejected under 35 U.S.C. § 251 as being based upon a defective reissue declaration. According to the Examiner, the declaration is defective "because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based" (Final Office Action, mailed Oct. 7, 1999, 2).

Claims 10-39 are rejected under 35 U.S.C. § 251 "as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based" (*id.* at 3).

The Issues

(1) Regarding claims 1-39, is the Reissue Declaration of record defective for failing to establish an error that is correctable by reissue under 35 U.S.C. § 251?

(2) Do claims 10-39 violate the recapture rule by reciting subject matter that was deliberately surrendered in an effort to obtain allowance of the '177 patent claims?

The Reissue Declaration

The Reissue Declaration, filed November 16, 1998, presents two errors in support of reissue. These errors and the undisputed facts which engendered the errors are copied below from pages 1-2 of the Declaration.

1. Through error and without deceptive intent, the patent was allowed to issue without a generic claim. The facts are as follows:

a. On October 4, 1995, the Examiner issued an Action making two election of species requirements, the first being a choice from among 19 defined "species" of compounds and the second being a choice from among six defined "species" of uses;

b. On January 3, 1996, a provisional election was made;

c. On June 28, 1996, an Amendment was filed in response to an Office Action dated April 9, 1996, inserting a number of claims, including a generic claim numbered "17".

d. A final rejection issued September 23, 1996, and a response was filed December 23, 1996.

e. On January 17, 1997, the Examiner faxed a proposed amendment to my attorney, proposing to amend Claim 17 to limit it only to the elected species. *That proposal was erroneously agreed to.* [Emphasis added.] The Examiner then entered an Examiner's Amendment making the proposed changes and allowed the claims. The patent issued on August 12, 1997.

f. Since the Examiner found the elected "species" allowable, the generic claims were then *per se* allowable unless and until the Examiner would conduct a further search of the remaining "species". Considering the number of permutations of the denoted "species" ($19 \times 6 = 114$), it was error to have agreed to the cancellation of the generic claims [sic].

2. Through error and without deceptive intent, references cited in a Search Report dated July 14, 1994, from the German Patent Office in a corresponding German application were not brought to the attention of the U.S. Examiner. The facts, as established by a Declaration of Dr. Gerald Kloepsch accompanying this Reissue Declaration, are as follows:

a. The Search Report from the German Patent Office was mailed July 14, 1994, and received July 21, 1994. As was Dr. Kloepsch's practice, he reported the German Search Report to his client. As was the usual practice in his office, since no response to a Search Report is necessary, the Search Report was merely placed in the respective file, to wait for an Action on the merits.

b. The application Dr. Kloepsch prepared for filing in other countries was more detailed and of a different scope than [sic] that of the German application. It was his opinion at that time that the references cited in the German Search Report were not material to the scope of the coverage to be obtained in the other countries.

c. U.S. Application serial no. 08/352,097 was filed on November 30, 1994, about four months after receipt of the German Search Report. At that time, the issuance of the German Search report was forgotten.

d. During the prosecution of the U.S. application, Dr. Kloepsch sent to his U.S. associates the Search Report of the PCT Application identical in scope with the U.S. application. The references of the PCT Search Report were brought to the U.S. Examiner's attention in an IDS of January 3, 1996. But, apparently, Dr. Kloepsch still did not remember the German Search report so the references cited in it were not brought to the attention of the U.S. Examiner.

e. At least some of the references cited in the German Search Report may be considered material to the patentability of the generic claims of the U.S. application [i.e., the subject reissue application].

Principles of Law

Regarding Issue (1):

Under 35 U.S.C. § 251 (1952), reissue is permissible "[w]henver any patent is, through error without any deceptive intention, deemed totally 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 deliberate action on an inventor or attorney during prosecution generally fails to qualify as a correctible error under § 251. *In re Serenkin*, 479 F.3d 1359, 1362, 81 USPQ2d 2011, 2014 (Fed. Cir. 2007). There is no correctable § 251 error when an inventor or attorney deliberately agrees with an Examiner's requirement that non-elected claims be prosecuted in a divisional application rather than in the application containing the elected

claims. *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). This is so regardless of the propriety of the requirement. *In re Watkinson*, 900 F.2d 230, 231-32, 14 USPQ2d 1407, 1408-09 (Fed. Cir. 1990).

Regarding Issue (2):

The recapture rule prevents a patentee from regaining through reissue the subject matter that the patentee/applicant surrendered (e.g., via claim amendment) in an effort to obtain allowance of the original patent claims. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). However, the recapture rule does not apply in the absence of evidence that the applicant's amendment was an admission that the scope of the amended claim was not in fact patentable. *Id.* In determining whether surrender of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the applicant's amendment (or argument) was to overcome the prior art and secure the patent. *Kim v. Conagra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

Analysis of The Defective Reissue Declaration Rejection

Reissue Declaration Error 1

In the Reissue Declaration, the Appellant states that, through error and without deceptive intent, the '177 patent was allowed to issue without a generic claim (Declaration 1, Item 1). The undisputed facts presented in support of this statement reveal that the asserted "error" was occasioned by deliberate actions on the part of Appellant (or his attorney).

These deliberate actions included agreement with the Examiner's requirement for an election of species to be prosecuted in the '177 patent application with non-elected species to be prosecuted in divisional applications (id. at Items 1.a. and 1.b.).² Similarly, Appellant (or his attorney) deliberately agreed to an Examiner's amendment that limited or narrowed generic claim 17 to the elected species only (id. at Item 1.e.).

A correctable § 251 error does not include these deliberate decisions by Appellant whereby the '177 patent was allowed to issue with elected species claims only (i.e., without a generic claim). *Orita*, 550 F.2d at 1280, 193 USPQ at 148. These deliberate choices do not comprise error correctable by reissue regardless of the propriety of the election requirement or claim amendment made by the Examiner. *Watkinson*, 900 F.2d at 231-32, 14 USPQ2d at 1408-09. There is a distinction between a § 251 error and a deliberate choice subsequently found to be disadvantageous. *Serenkin*, 479 F.3d at 1364, 81 USPQ2d at 2015.

Appellant cites *Ex parte Holt*, 214 USPQ 381 (Bd. App. 1982), "as standing for the proposition that failure to take other remedial action, such as filing a divisional or continuation application, should not adversely affect an applicant's right to reissue" (Supple. Appeal Brief, filed May 22, 2007, 1; see also Revised Appeal Brief, filed April 25, 2000, (hereinafter Br.) 10). *Holt* involved an improper rejection of a Markush claim under 35 U.S.C. § 121. The Board found that applicant's failure to recognize the impropriety

² It might be presumed that no such divisional applications were filed and that such non-filing occurred by inadvertence and without deceptive intent as in *Orita*, 550 F.2d 1277, 193 USPQ 145. However, the record is silent on these matters.

of the rejection was a correctable error under § 251 and that applicant's failure to file a timely divisional application in response to the improper rejection should not foreclose § 251 relief.

Interestingly, *Holt* was similarly relied on by the appellant in *Watkinson*. As explained in *Watkinson*, 900 F.2d at 232, 14 USPQ2d at 1409, there is a legally significant difference between the rejection in *Holt* and a restriction requirement. That is, a restriction requirement is "proper" under 35 U.S.C. § 121, whereas the rejection of a Markush claim is not. *Id.* Moreover, the merit of a restriction requirement is not reviewable on appeal since the requirement is a matter within an Examiner's discretion and not tantamount to a rejection of claims. *Id.*, 900 F.2d at 233, 14 USPQ2d at 1409. For these reasons, the court in *Watkinson* found *Holt* inapplicable to the facts of that appeal.

The facts of the *Watkinson* appeal parallel the facts of the subject appeal. The applicants in both cases acquiesced in a restriction or election requirement, canceled (or permitted cancellation of) the non-elected claims and accepted issuance of a patent containing elected claims only. Therefore, we likewise find *Holt* inapplicable to the facts of this appeal.

In an apparent attempt to analogize the facts of this appeal to those of *Holt*, Appellant argues that the election of species requirement "results in 114 permutations of combinations of 'species' [, and] [t]he result is a *de facto* rejection of Claim 17 resulting in a denial of generic coverage such that Applicant could not be made whole through the filing of multiple applications to each species" (Br. 12). Thus, Appellant argues that the "cancellation" of generic claim 17 (i.e., amendment of claim 17 to limit it to

elected species only) was not in response to an election of species requirement but rather was in response to a *de facto* rejection of a generic claim (Br. 11).

This argument is unpersuasive. The Examiner's election of species requirement can not be properly considered a *de facto* rejection which is analogous to the improper Markush rejection in *Holt*. Indeed, as expressly stated in *Watkinson*, 900 F.2d at 233, 14 USPQ2d at 1409, "a restriction requirement is a matter within the discretion of the Examiner and not tantamount to a rejection of claims."

As further support for his position, Appellant cites *In re Doyle*, 293 F.3d 1355, 1358, 63 USPQ2d 1161, 1163 (Fed. Cir. 2002), wherein the court determined that failure to present a so-called linking claim (i.e., a generic claim broad enough to read on or link two or more groups of claims subject to a restriction requirement) is an error correctable by reissue. (Further Supple. Br., filed July 1, 2002, 1-2; Reply to Supple. Examiner's Answer, filed July 11, 2006, 3-4). According to Appellant, "[t]he facts of the present case fall into the situation described by the court in *Doyle* [since] [t]he new claims in the instant reissue application are generic, or "linking," claims which are broader than any nonelected claims and could have been prosecuted with the elected claims" (Further Supple. Br. 2). As a matter of clarification, we point out that the "new claims" referred to by Appellant are newly added reissue claims 10-39 and that Appellant characterizes independent reissue claim 10 as a generic claim corresponding to generic claim 17 of the '177 patent application (Br. 6-7 and 23-24 (Appendix II)).

The Appellant is incorrect in stating that "[t]he facts of the present case fall into the situation described by the court in *Doyle*" (Further Supple. Br. 2). As a basis for its holding in *Doyle*, the court repeatedly emphasized that the generic or linking claims of Dr. Doyle's reissue application had never been submitted for prosecution in the original patent application. *See Doyle*, 293 F.3d at 1358, 63 USPQ at 1164 ("Dr. Doyle simply seeks a broadening reissue of his '595 patent to cover material that he invented and disclosed, but inadvertently *failed to claim* in his issued patent;" emphasis added) and 293 F.3d at 1360, 63 USPQ at 1165 ("the applicant [Dr. Doyle] never asserted the reissue claims or anything similar to them in his original application").

In contrast, Appellant submitted generic claim 17 for prosecution in the '177 patent application and deliberately authorized an amendment by the Examiner of the claim to limit or narrow its coverage to the elected species only. By now seeking reissue of appealed generic claim 10 which corresponds to former generic claim 17, the Appellant clearly is attempting to retract his deliberate decision made during prosecution of the '177 patent application. This deliberate decision is not an error that is correctable under § 251. *Serenkin*, 479 F.3d at 1362-63, 81 USPQ2d at 2014.

For the above-stated reasons, the facts presented in the Reissue Declaration do not establish that issuance of the '177 patent without a generic claim was due to an error which can be corrected by reissue under 35 U.S.C. § 251.

Reissue Declaration Error 2

As an additional reissue error, Appellant states: "Through error and without deceptive intent, references cited in a Search Report dated July 14, 1994, from the German Patent Office in a corresponding German application were not brought to the attention of the US Examiner" (Decl. 2, Item 2). Concerning the relevancy of these references, Appellant states only that "[a]t least some of the references cited in the German Search Report may be considered material to the patentability of the generic claims of the US application [i.e., the subject reissue application]" (Decl. 2, Item 2.e). Indeed, Appellant acknowledges that these references would not raise a substantial new question of patentability of the patented claims but urges that they would have been relevant to generic claim 17 of the original '177 patent application and are relevant to generic claim 10 of this reissue application (Br. 6).

As previously explained, § 251 permits the reissue of defective patents "[w]henver 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" (1952). Here, the failure to bring the above-noted references to the attention of the US Examiner has not rendered the '177 patent defective in any perceptible way. As the Appellant has acknowledged, these references do not raise a substantial new question of patentability of the '177 patent claims. Furthermore, it is simply irrelevant to Appellant's request for reissue under

§ 251 that these references may be pertinent to other claims such as former generic claim 17 and current generic reissue claim 10.

As support for his belief that the above discussed failure is correctable by reissue, Appellant cites *In re Harita*, 847 F.2d 801, 6 USPQ2d 1930 (Fed. Cir. 1988). However, unlike the circumstances before us, the references cited in the reissue application of *Harita* rendered at least some of *Harita*'s patent claims invalid. *Id.*, 847 F.2d at 802, 6 USPQ2d at 1930. Although the reissue claims patentably distinguished over this prior art, they were subjected to an "inequitable conduct" rejection which was reversed. *Harita*, 847 F.2d at 802, 6 USPQ2d at 1930. Because these facts are completely dissimilar to those before us, the Appellant's position is not supported by *Harita*.

Summary of Analysis of Defective Reissue Declaration Rejection

For the above-stated reasons, the Reissue Declaration of record is defective in that it fails to present any error which is correctable by reissue under 35 U.S.C. § 251.

Analysis of The Recapture Rejection

This rejection of newly added reissue claims 10-39 is based on the Examiner's determination that generic reissue claim 10 is an attempt by Appellant to recapture subject matter which was surrendered when Appellant authorized the Examiner to amend generic claim 17 of the '177 patent application to narrow its coverage to the elected species only. However, there is no evidence that Appellant authorized this narrowing

amendment in order to avoid a prior art (or any other kind of) rejection, and the Examiner does not argue otherwise. Instead, the Examiner believes his recapture rejection is proper simply because Appellant authorized the Examiner to amend claim 17 so as to remove from its coverage subject matter generic to the elected species.

The Examiner's theory for this rejection is not well-taken. As explained earlier, the recapture rule does not apply in the absence of evidence that a claim amendment was an admission that the scope of the unamended claim was not in fact patentable. *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. Here, there is no evidence that Appellant's authorization of the Examiner's amendment was an admission that the scope of generic claim 17 was not patentable. Additionally, the Examiner points to nothing and we find nothing in the prosecution history of the '177 patent application which would lead an objective observer to conclude that the purpose of the claim 17 amendment was to overcome prior art and secure the patent. In the absence of such prosecution history, no basis exists for determining that the subject matter defined by the reissue claims had been surrendered during prosecution of the original application. *Kim v. Conagra Foods, Inc.*, 465 F.3d at 1323, 80 USPQ2d at 1502.

Conclusions of Law

(1) With respect to claims 1-39, the Appellant has failed to establish on this record any error which is correctable by reissue under 35 U.S.C. § 251.

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(2) With respect to claims 10-39, the Examiner has failed to establish on this record that these claims recapture subject matter which was surrendered by Appellant during prosecution of the '177 patent application.

Order

The rejection of claims 1-39 under 35 U.S.C. § 251 based upon a defective reissue declaration is AFFIRMED.

The rejection of claims 10-39 under 35 U.S.C. § 251 based on recapture is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED

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