

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KLAUS WELLERDIECK,  
URS WEGMANN, and KARL HOEFLER

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Appeal 2007-1119  
Application 10/200,207<sup>1</sup>  
(Reissue application of U.S. Patent No. 6,248,219 B1)  
Technology Center 1700

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Decided: November 6, 2007

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

NAGUMO, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

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<sup>1</sup> Reissue application filed 23 July 2002. The real party in interest is identified as Unaxis Balzers AG of Fuerstentum, Lichtenstein.

Applicants ("Wellerdieck") request rehearing and reconsideration of our Decision mailed 4 May 2007. (Request<sup>2</sup> at 1.)

We held that Wellerdieck are not entitled, under 35 U.S.C. § 251, to expand the term of their originally issued patent. Moreover, we held that the specific relief Wellerdieck sought, namely to treat the applications filed under 37 C.F.R. § 1.53(d) ("Rule 53(d)") (as "continued prosecution applications") as though they had been filed as continuing applications under 37 C.F.R. § 1.53(b) ("Rule 53(b)'), would not have resulted in a term of 17 years from the date of issue, due to the action of 35 U.S.C. § 154(c). Finally, we noted that even if the relief sought were available under the statute and would yield the desired expanded term, Wellerdieck failed to show that the choices made to file continuing applications under Rule 53(d) were inadvertent errors correctable by reissue, rather than decisions that are now regretted.

Wellerdieck urges that the Board applied circular reasoning in its analysis of 35 U.S.C. § 251, resulting in a reading that ignores the remedial intent of the statute to provide equitable results. (Request at 7.)

The Board's analysis of the statue is narrower than the reading urged by Wellerdieck, but it is not circular. Section 251 authorizes the Director to reissue "for the unexpired part of the term of the original patent" when the patent is "deemed wholly or partly inoperative or invalid" as the result of some error committed without deceptive intent. 35 U.S.C. § 251. Our reviewing court has read the class of error more broadly than erroneously

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<sup>2</sup> Request for Rehearing and/or Reconsideration ("Request"), timely filed on 5 July 2007.

claimed subject matter, encompassing, for example, failing to perfect claims for priority (even though correction was sought more than two years after issuance of the original patent), *Fontijn v. Okamoto*, 518 F.2d 610, 186 USPQ 97 (CCPA 1975), and correcting inventorship declarations, *Medrad, Inc. v. Tyco Healthcare Group LP*, 466 F.3d 1047, 80 USPQ2d 1526 (Fed. Cir. 2006) (Reh'g and Reh'g en banc denied 3 January 2007). However, no prior case has been brought to our attention holding that "the unexpired part of the term of the original patent" includes term that might have been obtained had some other route to patentability been traveled. We decline to trump the plain language of the statute with an equitable remedy.

Wellerdieck argues further that its error was "largely caused by the PTO's unorthodox promulgation and publication of the CPA 'final rule'". (Request at 7.) In Wellerdieck's words, "[r]emarkably, neither the Examiner nor the Board can point to where this so-called final rule was codified in the Code of Federal Regulations as it should have been." (*Id.* at 3–4.)

Wellerdieck's complaints of lack of notice due to an alleged failure to follow "appropriate rule making procedures required by the Administrative Procedure Act" (Request at 4) are devoid of merit. The rules at issue here were promulgated through the standard procedure of issuance of a Notice of Proposed Rule Making<sup>3</sup>, followed by public comment and in due course

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<sup>3</sup> Rule 129: 59 Fed. Reg. 63951 (12 December 1994) and in the Patent and Trademark Office Gazette at 1170 Off. Gaz. Pat. Office 377 (3 January 1995). Rule 53(d): 61 Fed. Reg. 49,819 (23 September 1996) and 1191 Off. Gaz. Pat. Office 105 (22 October 1996).

publication of a Notice of Final Rule Making<sup>4</sup>. Constructive notice was thus provided of the regulations. 44 U.S.C. § 1507. The responses to comments discussed the effects of filing continuation-like applications under each rule. Moreover, the resulting rules were "codified" in the Code of Federal Regulations, Title 37, revised as of 1 July 1995, 37 C.F.R. §1.129, ("Rule 129") and in the revision as of 1 July 1998 (Rule 53(d)) and carried forward in every subsequent year. Practitioners registered to practice before the Office are charged with keeping abreast of current regulations. 37 C.F.R. § 10.76. Their failure to do so cannot be charged in this case to any failure by the USPTO to give notice.

Substantively, Wellerdieck argues that "CPA's were a type of 'continuing' application that, in fact, used the same serial number and file wrapper as its 'parent' application. For all intents and purposes, it was the same application." (Request at 3, emphasis added.) This argument is wrong. Wellerdieck appears to have confused the "Transitional procedures for limited examination after final rejection and restriction practice" provided by Rule 129 with the procedures for a "Continued Prosecution Application" provided for by Rule 53(d). The comments to the rule-making point out that CPAs are treated the same way as continuing applications filed under Rule 53(b), i.e., as subject to terms of 20 years from the earliest claimed United States utility application filing date. It appears that Wellerdieck has in mind the provisions of Rule 129, under which an

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<sup>4</sup> Rule 129: 60 Fed. Reg. 20,195(25 April 1995), 1174 Off. Gaz. Pat. Office 15; Rule 53(d): 62 Fed. Reg. 53,131 (19 October 1977), 1203 Off. Gaz. Pat. Office 63 (21 October 1977), amended at 63 Fed. Reg. 5,732 (4 February 1998), 1207 Off. Gaz. Pat. Office 83 (24 February 1998).

applicant can request examination after final rejection in an application pending for at least two years as of 8 June 1995, provided the application has not been abandoned or an appeal filed. Rule 1.129(a). Only two such requests can be granted. *Id.* Of all "continuation-like" applications "filed" after 1 December 1997, the effective date of Rule 53(d), only those "filed" under Rule 129(a) are entitled to issue as patents with a term of 17 years.

Wellerdieck argues further that it undertook "all that was necessary to preserve the 17-year term option, namely a notice of appeal after the first CPA and both a notice of appeal and an appeal brief, after the second CPA." (Request at 6.)

First, Wellerdieck fails to identify where such an argument was made in its appeal brief. The Board cannot have overlooked or misapprehended an argument that was not made. Moreover, Wellerdieck fails to cite any authority in support of its argument. As we have pointed out, every continuing application filed after the effective date of Rule 53, 1 December 1997, issues, if at all, as a patent with a term of 20 years from the date of the earliest United States utility application for which the benefit of 35 U.S.C. § 120 is claimed. After the Examiner entered a final rejection on 21 May 1998, Wellerdieck filed a notice of appeal on 21 August 1998. Then, rather than filing an appeal brief or a second request for prosecution under Rule 129(a), Wellerdieck filed a CPA on 21 January 1999. This CPA was in such a condition that the Examiner entered a final rejection in the first office action on the merits.<sup>5</sup> Although, as Wellerdieck points out, a notice of

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<sup>5</sup> Such "first-final" rejections are typically made only when no new evidence or amendments have been submitted. *See, e.g.,* MPEP 706.07(b) (This

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appeal was filed in the CPA, no appeal brief was filed. Instead, Wellerdieck filed a second CPA application on 6 December 1999. Again, the application was in such a condition that the Examiner entered a final rejection in the first action on the merits on 19 January 2000. It was not until 19 December 2000, some two years and seven months after the final rejection in the original application, that Wellerdieck filed an appeal brief that apparently persuaded the Examiner to enter a Notice of Allowability on 19 January 2001. We do not find in this course of events evidence that there is "no question" that Wellerdieck would have been issued its patent if an appeal brief had been filed during prosecution of the application under Rule 129(a). What might have happened had Wellerdieck followed another course is a matter of pure speculation.

Wellerdieck chose the circumstances for prosecuting its application. On the record before us, it did so deliberately: its filings under Rule 53(d) were not the result of a paperwork oversight. Such errors are not correctable by reissue. Wellerdieck complains that the adequacy of the Reissue Declaration and the evidence in this case were never called into question during the examination process, and that it is unfair that they did not have an opportunity to respond. (Request at 4.)

On the facts as candidly admitted to the Board, Wellerdieck twice filed continued prosecution applications under Rule 53(d) without understanding the consequences of those acts. (Request at 4.) As counsel registered to practice before the USPTO, Wellerdieck's representative is

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section is substantially the same in the 8th Ed., rev. 5 (2006) as the 7th Ed. (1998).)

presumed to be informed of current USPTO practices. Wellerdieck is accordingly charged with the consequences of errors by its counsel. It is difficult but probably not impossible to imagine other circumstances under which inadvertent errors might give rise to the present situation. A review of salient cases in this area, such as *In re Serenkin*, 479 F.3d 1359, 81 USPQ2d 2011 (Fed. Cir. 2007), and *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), suggests that only a detailed explanation of all the facts and circumstances leading to the alleged error would persuade a decision maker that the alleged error was not a deliberate action that is now regretted, but an error without deceptive intent. The mere assertion of error, without recitation of facts, leaves nothing on which the finder of facts may base an opinion in favor of the requester.

**D. ORDER**

In view of the foregoing considerations, it is:

ORDERED that Wellerdieck's Request for Rehearing and/or Reconsideration is granted to the extent that its arguments have been considered, but all relief requested is DENIED.

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

**DENIED**

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