

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROBERT DEAN KING,  
NEIL RICHARD GARRIGAN, MARK EDWARD CARDINAL, and  
LEMBIT SALASCO,  
APPELLANTS

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Appeal 2008-0676  
Application 10/996,327<sup>1</sup>  
Patent 6,486,568 B1<sup>2</sup>  
Technology Center 2800

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Decided: March 19, 2008

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Before JOHN C. MARTIN, LEE E. BARRETT, and MARK NAGUMO,  
*Administrative Patent Judges.*

NAGUMO, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> Reissue application filed 23 November 2004. The real party in interest is listed as General Electric Company (Appeal Brief filed 9 March 2007 (“App. Br.”), at 1.)

<sup>2</sup> Based on Application 09/469,129, filed 21 December 1999, titled “Power System Using a Multi-Functional Power Interface Unit” (“129 Application”).

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**A. Introduction**

Appellants ("King") appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1–34, which are all the pending claims in application 10/996,327, which seeks reissue of U.S. Patent 6,486,568 B1 (“568 patent”). We have jurisdiction under 35 U.S.C. § 6(a). We AFFIRM.

The claimed subject matter relates to electrical power systems such as those found in locomotives.

The issue on appeal is whether King has established “error” that can be remedied by reissue.

**B. Findings of Fact**

Prosecution of the 129 Application (568 Patent)

1. King filed application 09/469,129 (“129 Application”) on 21 December 1999.
2. The Examiner required restriction to two groups of claims defined in the following words:
  - I. Claims 1–18, 36–53, drawn to a plural load and plural source system, classified in class 307, subclass 18.
  - II. Claims 19–35, drawn to a single source plural load system, classified in class 307, subclass 38.

(129 Application, Paper 4, mailed 27 August 2001, at 2.)

3. King “noted at the outset that applicant is not challenging the Examiner's determination that the distinct inventions identified in that Office

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Action are patentable over each other.” (129 Application, Paper 5, filed 24 September 2001, at 1).

4. King traversed the restriction on the grounds that the burden of examining the entire case would not be undue. (129 Application, Paper 5, at 1.)
5. King stated further that “applicant without any prejudice elects to prosecute claims 1–18, which correspond to one of the inventions identified by the Examiner.” (129 Application, Paper 5, at 1).
6. In due course, on 26 November 2002, the 568 Patent issued, containing claims 1–29.
7. According to King, “[n]o divisional application for non-elected claims 19–35 was filed.” (App. Br. at 5.)

#### The Reissue Application

8. On 23 November 2004, King filed reissue application 10/996,327 (“Reissue Application”).
9. King alleged error “by reason of the patentee claiming more or less than he had the right to claim in the patent” (Reissue Application Declaration by the Assignee (PTO/SB/52 (09-04)) at 1.)
10. More particularly, King stated that it was error  
not to include a claim directed to a power system for providing primary and auxiliary electrical power for a railroad locomotive having traction motors powered by the primary electrical power and auxiliary electrical loads powered by the auxiliary electrical power and including a single alternator for generating power for both the primary and auxiliary power. We believe that the

attorney that filed and prosecuted the application did not have a perfect understanding of features and aspects of the invention that we have just come to realize were omitted from the granted patent.

(*Id.* at 2.)

11. King stated that “claims 1–29 were allowed in the issued patent.” (Reissue Application, Preliminary Amendment and Reissue Statement under CFR 1.173, at 9.)

12. King stated further that claims 30–34 were being added by amendment, and cited support for the claimed subject matter in the specification. (*Id.*)

13. According to King, “new claims 30–34 are substantially different f[ro]m the non-elected invention and consequently patentability of such claims should be based on their own merits regarding any prior art that the Examiner may find.” (App. Br. at 6.)

#### The Examiner’s Rejection

14. The Examiner found that a restriction requirement had been made during prosecution of application for the 568 patent between “Group I relating to an invention having plural loads with plural sources and Group II relating to an invention having plural loads with a single source.” (Examiner’s Answer mailed 23 May 2007 (“Ans.”) at 3; Final Rejection mailed 29 January 2007 (“Final”) at 2.)

15. The Examiner found further that claims 30–34 were “drawn to the subject matter covered by the non-elected claims of the first Application

(No. 09/469,129), specifically systems having plural loads with a single source (i.e. Group II).” (Ans. at 3; Final at 2–3.)

16. The Examiner concluded that the error King was trying to correct was the failure to file a timely divisional application. (Ans. at 3; Final at 2.)

17. Accordingly, the Examiner held that King had not alleged error correctable by Reissue, and rejected the claims under 35 U.S.C. § 251. (Ans. at 3; Final at 2.)

#### Rebuttal

18. King argues that the rationale underlying the so-called *Orita* doctrine (*In re Orita*, 550 F.2d 1277 (CCPA 1977) (holding that acquiescence to a restriction requirement, followed by failure to file a timely divisional application to the non-elected subject matter, is not error correctable by reissue) extends “only to claims that are identical to or of substantially similar scope to those of the nonelected group.” (App. Br. at 6, *citing Doyle*, 293 F.3d at 1361.)

19. King argues further that the Examiner erred by failing to recognize that added claims 30–34 fall within an exception to the *Orita* doctrine carved out by the Federal Circuit “where newly presented claims of a reissue application are ‘neither identical nor substantially similar to . . . non-elected claims’ not pursued in a divisional application.” (App. Br. at 6, *citing In re Doyle*, 293 F.3d 1355, 1360 (Fed. Cir. 2002).

20. King urges that new claim 30 differs substantially from non-elected claim 19 in the recitation of “operational relationships and/or structures” (e.g., a rectifier (AC-to-DC converter) and a DC-to-AC converter; and in

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claim 31, a DC-to-DC converter), whereas “[t]he non-elected invention covered by claim 19 has nothing to do with power conversion.” (App. Br. at 7–8.)

21. King urges further that “the power conversion operational relationships and/or structures of claim 30 in combination provide a second power source (not requiring a second alternator) for powering an auxiliary electrical load. Consequently, claim 30 effectively recites a plural load and plural source power system more appropriately associated with the elected invention of claims 1–29[.]” (App. Br. at 8.)

### **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.

35 U.S.C. § 251, first paragraph.

Although reissue is remedial, “not every event or circumstance that might be labeled ‘error’ is correctable by reissue.” *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986).

On appeal, appellants bear the burden of showing reversible error in the Examiner’s rejection.

King argues that the Examiner erred in failing to recognize that as long as the newly presented claims are “neither identical nor substantially similar to . . . non-elected claims’ not pursued in a divisional application,” the reissue application is properly seeking to correct the error of claiming less than the patentee had a right to claim. (App. Br. at 6, citing *Doyle*, 293 F.3d at 1360.) According to King, the subject matter of claim 30 differs substantially from the subject matter of Group II (non-elected original claims 19-35 of the 129 Application). Moreover, King argues that claim 30 “effectively recites a plural load and plural power source system more appropriately associated with the elected invention of claims 1–29.” (App. Br. at 8.)

None of these arguments are persuasive.

As our reviewing court has emphasized, “the whole purpose of the [reissue] statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow.” *Weiler*, 790 F.2d at 1580 (quoting *In re Handel*, 312 F.2d 943, 948 (CCPA 1963)). As cases subsequent to *Handel* have shown, not all such subject matter is permissible in a timely filed reissue application.

For example, the CCPA held that the failure to file a timely divisional application to non-elected subject matter is not error correctable by reissue. *Orita*, 550 F.2d at 1280. In *Orita*, the court, following precedent, also held that acquiescence in the original restriction requirement (by permitting the examiner to cancel non-elected claims) was not error correctable by reissue. *Id.* The Federal Circuit subsequently noted that neither the court nor the Board has jurisdiction to review the merits of a requirement for restriction

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under 35 U.S.C. § 121, and that after acquiescing in the requirement, canceling the restricted and non-elected claims, and allowing the patent to issue, the applicant loses the opportunity to challenge the propriety of the restriction. *In re Watkinson*, 900 F.2d 230, 231, 233 (Fed. Cir. 1990).

The court's decision in *Doyle* rested on the finding that Dr. Doyle had obtained claims within the scope of the claims sought by reissue. In that case, Federal Circuit held that a failure to present a linking claim—a 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. 293 F.3d at 1358. Thus, the court found that the dispositive distinction between the facts in *Doyle* and the facts in *Orita* or *Watkinson* was that, unlike the other applicants, Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group, citing the linking claim examination procedure set forth in *Manual of Patent Examining Procedure* § 809.03 (8th ed. 2001). 293 F.3d. at 1360. In addition, the *Doyle* court explained that

*In re Orita* did not create a broad rule disallowing any reissue claims that read on nonelected subject matter. As discussed above, the reissue claims asserted in *In re Orita* did not just read on nonelected subject matter, but rather were “substantially identical to those non-elected in [the] application.” *In re Orita*, 550 F.2d at 1280, 193 USPQ at 149. As discussed above, the rationale underlying *In re Orita* and the holding of that case extend only to claims that are identical to or of substantially similar scope to those of the nonelected group.

293 F.3d at 1361.

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The *Doyle* court also explained that it is necessary for a reissue applicant to demonstrate that the reissue claims are directed to the invention recited in the patent claims:

Under *In re Orita*, of course, there is no correctable error in failing to prosecute divisional applications on inventions of the nonelected groups identified by the examiner in the original restriction requirement. In *In re Weiler*, we held that the result should be the same with respect to claims 13 and 19, which also asserted wholly distinct inventions from that covered by the issued patent. *Id.* at 1582 [USPQ citation omitted]. We explained that “[i]f it were not error to forego divisional applications on subject matter to which claims had been made in the original application, it cannot on the present record have been error to forego divisional applications on subject matter to which claims had never been made.” *Id.*

293 F.3d at 1362-63.

The court, in *Doyle*, distinguished *Weiler*, explaining that “*Weiler* applies only to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued claims.”

293 F.3d at 1363.

We therefore reject King’s argument that the holding in *Doyle* permits in a timely filed reissue application any claim substantially different than a claim drawn to restricted or non-elected subject matter.

Rather, the critical issue is the relation of the subject matter of newly presented claims 30–34 to the subject matter covered by Group I and Group II of the restriction requirement.

As already noted, our reviewing court has held unequivocally that the propriety of the restriction requirement is immaterial in the considerations of

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the board or the court as to whether failure to file a divisional application is error correctable by reissue. *Watkinson*, 900 F.2d at 231 (“the failure to file a divisional application, regardless of the propriety of the underlying restriction requirement, is not an error correctable by reissue under 35 U.S.C. § 251”) and at 233 (“neither this court nor the board has jurisdiction in this proceeding to review the merits of a requirement for restriction under section 121, as a restriction requirement is a matter within the discretion of the examiner and not tantamount to a rejection of claims”).

We therefore consider the restriction requirement—which King accepted—only to learn what it was that King agreed must be prosecuted in an application separate from the elected subject matter. To do so, we compare and contrast the subject matter of claim 1, original claim 19, and reissue application claim 30.

Claim 1 of the 129 application was amended by addition of the underscored passages shown below and issued as claim 1 of the 568 patent.

Claim 1 (568 patent):

A power system including

- [a] an *internal combustion engine* coupled to drive
- [b] a *main alternator* and
- [c] an *auxiliary alternator*,  
the main alternator coupled to power one or more traction motors and the auxiliary alternator coupled to power predetermined electrical equipment,

the system comprising:

- [d] a *main power bus* generally powered by the main alternator;

- [e] an *auxiliary power bus* generally powered by the auxiliary alternator; and
- [f] a *power interface unit* electrically coupled to the main power bus to capture and transfer electrical energy into the auxiliary power bus, at least some of the electrical energy being generated during a predetermined mode of operation of the system selected from the group consisting of a regenerative braking mode of operation and a self-load mode of operation, the captured and transferred electrical energy being used to directly power, at least in part, the predetermined electrical equipment coupled to the auxiliary power bus, thus enabling less dissipation of heat in one or more resistor grids operatively coupled during regenerative braking or self-load mode of operation.

(App. Br., Claims App'x, at 10: *see* Paper 3 (Preliminary Amendment A, filed in the 129 application on 23 January 2001, at 1, for claim 1 as it was considered by the Examiner for restriction—i.e., without the underscored text.) (Paragraphing added: the letters in square brackets have been added to identify components (in added italics), corresponding to similar components recited in claim 19 of the 129 application and in claim 30 of the reissue application.)

Claim 19 (originally filed):

A power system including

- [a] an *internal combustion engine* coupled to drive
- [b] an *alternator*,

the system comprising:

- [d] a *main power bus* generally powered by the alternator;
- [e] an *auxiliary power bus*;
- [f] a *power interface unit* electrically coupled to the main power bus to direct electrical energy generated during a predetermined mode of operation of the system into the auxiliary power bus; and
- [g] an *energy storage unit* coupled to power interface unit and to the auxiliary bus so that the energy storage unit stores the power captured during the predetermined mode of operation of the system.

(Paper 3 (Preliminary Amendment A), filed in the 129 application on 23 January 2001, at 2–3) (emphasis, paragraphing, and letters in square brackets added).)

Claim 30 (327 Application):

A power system having

- [h] *power conversion elements* for converting power between alternating current (AC) electrical power and direct current (DC) electrical power for providing both primary and auxiliary electrical power for a railroad locomotive having traction motors powered by primary electrical power, auxiliary electrical loads powered by auxiliary electrical power, and
- [a] an *internal combustion engine* coupled to drive a
- [b] *single alternator* for generating power for both the primary and auxiliary power,

the power system comprising:

- [h1] a *rectifier* electrically coupled to receive AC electrical power from the alternator and generate DC power;
- [d] a *traction direct current (DC) bus* electrically coupled to receive electrical power from the rectifier;
- [f] a *power interface unit* coupled to receive electrical power from the traction bus;
- [e] an *auxiliary DC bus* electrically coupled to receive electrical power from the power interface unit; and
- [h2] at least one *DC-to-AC converter* electrically coupled to receive electrical power from the auxiliary DC bus, with said at least one DC-to-AC converter configured to drive an auxiliary electrical load connected thereto.

(App. Br., Claims App'x at 16, emphasis, paragraphing, and letters in square brackets added.)

As an initial matter, we note that each of the claims has a general preamble, i.e., “a power system including” (claims 1 and 19), and “a power system having” (claim 30), and a secondary preamble, “the system comprising” (claims 1, 19, and 30), the latter of which immediately precedes the formal body of the claim.<sup>3</sup> Taking all of the claim language into consideration, we construe the claimed subject matter as requiring each of the lettered elements, noting that elements recited in the general preambles are also recited to in the formal bodies of the claims.

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<sup>3</sup> Henceforth we shall refer only to claims 1, 19, and 30, without reciting their origin as the 568 patent, the 129 application, and the reissue application, respectively.

Comparison of the three claims is facilitated by the following table, which shows the elements recited in each claim:

Claim 1	Claim 30	Claim 19
[a] Internal Combustion Engine	[a]	[a]
[b] main alternator	[b*]	[b]
[c] auxiliary alternator		
[d] main power bus	[d]	[d]
[e] auxiliary power bus	[e]	[e]
[f] power interface unit	[f]	[f]
		[g] energy storage unit
	[h] AC-DC and DC-AC converters	

\* The single alternator recited in claim 30 generates power for both primary and auxiliary power buses.

Each power system recited in claims 1, 19, and 30 is driven by an internal combustion engine, and each has a main power bus, an auxiliary power bus, and a power interface unit that links the main power bus to the auxiliary power bus.

However, only the power system covered by claim 1 is required to have two alternators, a “main alternator” which powers the main power bus and an “auxiliary alternator” which powers the auxiliary power bus. The alternators are “power sources”—the sources of electrical power in the system—that are driven by the internal combustion engine. That is, the “plural sources” of Group I must be the main and auxiliary alternators recited in claim 1, while the “single source” of Group II must be the alternator that powers the main power bus recited in claim 19. Both sets of claims recite the presence of an internal combustion engine, so that cannot be a “plural source.” Both also cite the presence of a main power bus and an

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auxiliary power bus, so these cannot be a single power source in one power system and plural power sources in another. In contrast, the power system covered by claim 30 is required to have only a single alternator that is coupled to both the main and the auxiliary power buses. King's argument that the power system of claim 30 provides a second power source (not requiring a second alternator) does not correct this deficiency, because it is at odds with the meaning of "single source" and "plural sources" in the restriction requirement. Thus, we conclude that claim 30 is not broad enough to "read on" subject matter covered by claim 1. Accordingly, we hold that claim 30 is not within the linking claim "exception" to the *Orita* doctrine governed by *Doyle*.

Language in *Doyle* indicates that the *Orita* doctrine applies only to claims that are identical to or of substantially similar scope to those of the nonelected group. *Doyle*, 293 F.3d at 1361. Given the factual basis of the decision in *Doyle*—the claims sought to be added were linking claims and therefore encompassed the patented claims—we understand this language to mean that claims subject to the holding in *Orita* cannot be so broad as to encompass the patented subject matter.

Claim 19 recites an alternator that powers the main power bus. The additional elements recited in claim 30, such as [h1], the rectifier that converts the AC electrical power from the alternator and that feed DC electrical power to [d], the traction DC current bus, are not excluded by the express or implicit limitations of claim 19. Thus, claim 19 recites that the main power bus is "generally powered by the alternator," not that the main power bus is an AC or a DC power bus. The limitation "generally powered"

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is broad enough to encompass a direct coupling between the alternator and the bus (i.e., an AC bus) or—as recited in claim 30—an intervening AC-to-DC converter (i.e., a DC bus). Similar considerations show that the auxiliary power bus recited in claim 19 can be a DC power bus, as recited in claim 30, or a DC power bus maintained at a voltage different from the voltage of the main power bus, as recited in claim 31. Moreover, the energy storage unit, [g], recited in claim 19, is not excluded by any limitation recited in claim 30.

For the foregoing reasons, claim 30 is “identical to or of substantially similar scope to” nonelected claim 19 and thus barred by *Orita*. For the same reasons, claim 30 is directed to an invention distinct from the invention recited in patent claim 1 and thus barred by *Weiler*.

King accepted the correctness of the Examiner’s restriction requirement (Paper 4) and subsequently canceled original (and restricted) claims 19–35 (Paper 11, filed 12 April 2002, at 1). When the 568 patent issued with the claims covering the plural source power systems of Group I, without King having traversed the restriction requirement or having filed a divisional application to the subject matter within the scope of Group II, or any other subject matter described and enabled by the 129 specification, King “foreclosed (because that was not error) his right to claim that subject matter” [with the benefit of the filing date of the 129 application]. *Weiler*, 790 F.2d at 1582. Thus, we find that King has not shown any reversible error in the Examiner’s determination that claim 30 is drawn to a single source, plural load system covered by nonelected Group II and not covered by elected Group I. We conclude that King has not shown error in the

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Examiner's holding that King has not established an error that can be corrected by reissue.

**E. Summary**

In view of the record and the foregoing considerations, it is:

ORDERED that the rejection of claims 1–34 as unpatentable under 35 U.S.C. § 251 is AFFIRMED.

**AFFIRMED**

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BEUSSE WOLTER SANKS MORA & MAIRE, P. A.  
390 NORTH ORANGE AVENUE  
SUITE 2500  
ORLANDO FL 32801