

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS L. KRUEGER
and JAMES F. DYRUD

Appeal No. 95-4633
Application 07/135,067¹

HEARD: DECEMBER 9, 1997

Before KIMLIN, WEIFFENBACH and WARREN, *Administrative Patent Judges*.

WEIFFENBACH, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants' request for rehearing² of our decision of January 27, 1998, wherein we sustained the

¹ Application for patent filed December 18, 1997. According to Applicants, this application is a division of Application 06/911,394, filed September 25, 1986, now U.S. Patent No. 4,729,371, granted March 8, 1988, which is a continuation of Application 06/704,537, filed February 22, 1985, now abandoned, which is a continuation of Application 06/540,543, filed October 11, 1983, now abandoned.

² Effective December 1, 1997, 37 CFR § 1.197(b) was amended to change the term "reconsideration" to "rehearing." See the final rule notice published at 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 O.G. 63, 122 (October 21, 1997).

Appeal No. 95-4633
Application 07/135,067

examiner's rejection of claims 1-6 and 8-11 under the judicially created doctrine of obviousness-type double patenting over claims 1-11 of Krueger I (Patent No. 4,547,420) or claims 1-17 of Krueger II (Patent No. 4,795,668). We have carefully considered each of the arguments advanced by the appellants in their request for rehearing. However, those arguments do not persuade us that our decision was in error.

We do not find, on this record, evidence to show that the PTO controlled the rate of prosecution which led to the issuance of the Krueger I and II patents first. Appellants point to the “replacement” rejections during the prosecution of K/D Application II wherein in the examiner applied new prior art in the first Office action in K/D Application II from that asserted in the K/D Application I and then again applied new prior art in the second Office action in K/D Application II. We find nothing unusual with these “replacement” rejections since appellants voluntarily abandoned K/D Application I in favor of K/D Application II and since the examiner’s “replacement” rejection in the second action in K/D Application II was dictated by an amendment to claim 1 made by appellants following the first Office action. We do not find these events as PTO controlling the rate of prosecution. The examiner handled the applications in a timely manner and made the second Office action in the K/D Application II final in spite of the “replacement” rejection. In any event, appellants did not appeal the examiner’s decision, but instead abandoned the application in favor of K/D Application III in which they subsequently elected not to prosecute the claimed subject matter

prosecuted in K/D Applications I and II. As for the PTO delays in the rate of prosecution alleged by appellants to have occurred since 1989, we find such delays to be immaterial in view of the fact that both the Krueger I and Krueger II patents had already been granted by 1989.

Appellants argue that *In re Goodman*³ and *In re Emert*⁴ do not apply to the application on appeal because appellants did not act voluntarily to delay prosecution in the PTO. We disagree. The prosecution history of K/D Applications I, II and III show a pattern of activity similar to the facts in *Goodman* and *Emert*. During the four years of prosecution of applications leading to the filing of this application, appellant voluntarily abandoned and refiled applications, rather than appeal decisions of the examiner. At one point during the prosecution of K/D Application III in response to a restriction requirement, appellants voluntarily elected not to prosecute claims directed to the claimed subject matter prosecuted in K/D Applications I and II, which subject matter the examiner had been asserting was in conflict with subject matter claimed in the Krueger I patent and in applications leading to the Krueger II patent. Appellants then voluntarily waited seven months before filing the present application to continue prosecution of the claims which the examiner had determined were in conflict with the Krueger I patent and the applications leading to the Krueger II patent. The filing of the present application occurred at about the same time the Krueger II patent

³ *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

⁴ *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997).

Appeal No. 95-4633
Application 07/135,067

was being allowed. We find these facts along with other facts set forth in our decision as showing a pattern of activity in that appellants took voluntary actions which controlled the rate of prosecution of K/D Applications I, II and III.

Appellants point to portions (indicated in italics) of the following passages from pages 18 and 19 of our decision contending that the prosecution of the K/M applications is not relevant to the issues on appeal:

... We find under this record that *appellants had and maintained complete control over the prosecution of the applications in the line of cases which led to this appeal and to the line of cases leading to the issuance of the Krueger I and Krueger II patents.*

* * *

... Moreover, *double patenting has been a continuing issue during the prosecution of [the] applications leading up to this application.* The examiner has maintained throughout the prosecution that the subject matter claimed in the Krueger-Dyrud line of applications and the subject matter claimed in the Krueger-Meyer line of applications leading to the Krueger I and Krueger II patents were conflicting. In the first two Krueger-Dyrud applications (K/D Applications I and II) leading to this application, the examiner maintained that the subject matter claimed therein and the subject matter claimed in the applications leading to the Krueger I and Krueger II patents was directed to a “single inventive concept” such that they were not patentably distinct from one another. In both applications, the examiner required applicants under 37 CFR § 1.78(c) to determine priority of invention or to provide evidence that the applications were commonly owned. *Rather than petitioning the examiner’s requirement in K/D Application I, appellants chose to abandon the application and file KD Application II and to allow K/M Application I to issue as the Krueger I patent.*

The thrust of appellants’ argument is that they properly and diligently prosecuted the K/D and K/M

applications and that their actions were dictated by the PTO.

First, we must point out that the part of our decision referred to above was not intended to point to any impropriety in the prosecution of the applications by counsel for appellants. The remarks were intended to merely point out that counsel was controlling the rate of prosecution of the applications in the PTO in view of the fact that alternative courses of action were open to counsel and that counsel voluntarily elected a particular course of action such as abandoning application K/D Application I rather than appealing the examiner's final rejection and/or petitioning for supervisory review of the examiner's requirement under 37 CFR § 1.78(c).⁵ These actions were in no way controlled by any action taken by the PTO.

Second, while we agree that a double patenting rejection had not been made until the first Office action in this application (Paper No. 8, ¶¶ 16 and 17), the double patenting issue has been present since the first Office actions in the first K/D and K/M applications by virtue of the facts that both applications were commonly owned and that the examiner made requirements under 37 CFR § 1.78(c). At that time, the examiner made a determination that the claims of both applications were directed to a "single inventive concept." Under PTO practice and procedure, any requirement under 37 CFR § 1.78(c) involving

⁵We note that the examiner made a similar requirement under 37 CFR § 1.78(c) in the first Office action in K/M Application I noting the claims in that application were in conflict with the claims in K/D Application I. However, the examiner dropped the requirement in the second Office action of K/M Application I while at the same time maintaining the requirement in the second Office action of K/D Application I. It would appear from these facts that grounds existed for a petition for supervisory review since it appears to be inconsistent for the examiner to assert that the claims in K/D Application I are in conflict with the claims in K/M Application I while at the same time not asserting that the claims in K/M Application I are in conflict with the claims in K/D Application I.

Appeal No. 95-4633
Application 07/135,067

applications which are commonly owned raises the specter of double patenting.⁶ See Section 804.03 of the *Manual of Patent Examining Procedure*, 6th Edition, Rev. 3, July 1997 where 37 CFR § 1.78(c) is cited and where under the heading “DOUBLE PATENTING” it is stated that the examiner “may reject claims of commonly owned applications of different inventive entities on the ground of double patenting.”

As a final note, this panel is aware of the recent decision in the Federal Circuit styled *In re Berg*, ___ F.3d ___, ___ USPQ2d ___, Appeal No. 97-1367, decided March 30, 1998 which distinguished the *Braat*⁷ decision and held that the appellants were not entitled to the “two-way” test for determining obviousness-type double patenting because their claims, which were presented in separate applications, could have been presented in a single application. We have considered our decision and appellants’ arguments in their request for rehearing in light of this decision, but we do not find our decision on appeal or our decision in this request for hearing to be inconsistent with the Court’s decision.

⁶ The fact that all of the K/D and K/M applications were prosecuted by Mr. Tamte of 3M is evidence that the applications at the time they were examined by the examiner were commonly owned.

⁷ *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

Appeal No. 95-4633
Application 07/135,067

In light of the foregoing, appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to modifying the decision.

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

DENIED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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) BOARD OF PATENT
CAMERON WEIFFENBACH) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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CHARLES F. WARREN)
Administrative Patent Judge)

Appeal No. 95-4633
Application 07/135,067

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