

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID G. WILSON

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Appeal No. 98-0541  
Application No. 08/409,137<sup>1</sup>

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HEARD: April 7, 1998

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Before STONER, Chief Administrative Patent Judge, CALVERT, Administrative Patent Judge, and MCKELVEY, Senior Administrative Patent Judge.

PER CURIAM

Decision on appeal under 35 U.S.C. 134

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<sup>1</sup> Application filed March 23, 1995, seeking to reissue U.S. Patent 5,259,444, granted November 9, 1993, based on application 07/609,362, filed November 5, 1990. We are told that the real party in interest is the Massachusetts Institute of Technology.

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This appeal is from the Primary Examiner's rejection of claims 13-14, 21-23, 26, 28, 46 and 48 as lacking a statutory basis for reissue. All remaining claims have been indicated as being allowable.

**A. Background**

The application involved in this appeal seeks to reissue U.S. patent 5,259,444. The reissue application was filed within two years from the grant of the patent. See n.1, supra.

The application which matured into the patent sought to be reissued described and claimed at least two species of regenerative heat exchangers. No generic claim was presented which covered both species. One of the described species was a "rotary" heat exchanger; the other was a "modular" heat exchanger.

During prosecution of the application which matured into the patent, the examiner made a restriction requirement thereby causing appellant to elect to prosecute claims to the rotary heat exchanger or claims to the modular heat exchanger. Appellant elected to prosecute claims to the modular heat

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exchanger without traverse and the patent subsequently issued claiming only a modular heat exchanger. A divisional application was not filed to prosecute claims directed to the rotary heat exchanger.

In this reissue application on appeal, appellant presented claims 1-58. Claims 1-12, 15-20, 24-25, 27, 29-45, 47 and 49-58 have been allowed by the examiner (examiner's answer, page 3, lines 1-2). Allowed claim 12 is generic to rotary and the modular heat exchangers. Claims 13-14, 21-23, 26, 28, 46 and 48 depend from claim 12 and are limited to rotary heat exchangers. The examiner has rejected claims 13-14, 21-23, 26, 28, 46 and 48 on the basis that appellant is attempting to recapture by reissue the non-elected invention said to have been "surrendered" in the application which matured into the patent, namely, the rotary heat exchanger.

#### **B. Discussion**

In support of his recapture rejection, the examiner relies on In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990). However, the facts here differ from those in Watkinson and other similar cases, such as In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977). A generic claim was not

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presented in the application which matured into the Watkinson patent. Instead, in seeking reissue, Watkinson filed claims corresponding solely to the non-elected invention which had not been prosecuted in the application which matured into the Watkinson patent. In the present reissue application, appellant--unlike Watkinson and Orita--has presented a generic claim which the examiner has found to be supported by the specification and subsequently allowed. In presenting generic claim 12 in the reissue application on appeal, appellant took a step which he could have taken during prosecution of the application which matured into the patent. On the record before us, the examiner has not questioned that appellant erred, within the meaning of the reissue statute, when he failed to present claim 12 in the application which matured into the patent.

Following oral hearing in this appeal, we became concerned as to whether the subject matter of claim 12 was described in the specification of the patent in the manner required by the first paragraph of 35 U.S.C. § 112. We asked appellant to address our concern and he has done so in a timely fashion. Upon consideration of appellant's response,

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we--like the examiner--are persuaded that claim 12 complies with the description requirement of the first paragraph of 35 U.S.C. § 112.

It is true that the claims on appeal cover a rotary heat exchanger and that appellant elected to prosecute only a modular heat exchanger following a restriction requirement in the application which matured into the patent. Had appellant presented claim 12 in the application which matured into the patent, he also would have been able to present the rejected claims on appeal. Appellant is not here attempting to claim something he could not have claimed in the application which matured into the patent. Rather, through error, he failed to present claim 12 during prosecution of the application which matured into the patent sought to be reissued. Since claim 12 is generic to both rotary and modular heat exchangers, and has been found to be allowable, we perceive no reason why appellant should not also be able to present claims limited to rotary heat exchangers.

### **C. Decision**



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