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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

In re Application of: :
Satou :
Application No. 10/458,198 : ON PETITION
Filed: June 11, 2003 :
PGPUB: US200302207506A1 11/6/03. :
Docket No.: 039280.97 :

This is a decision on the petition filed January 10, 2006, requesting under 37 CFR 1.182 that the USPTO convert the above-identified application to an application that is both a divisional and a reissue having the same filing date, from its current status as that of a divisional, but non-reissue, application.

The petition is **denied**.

BACKGROUND

Original application for patent no. 08/849,288 entered the national stage in the United States under 35 U.S.C. § 371 on May 30, 1997, from international application no. PCT/JP96/02858 filed October 2, 1996, and was issued in due course as U.S. Patent No. 5,930,607 ('607) on July 27, 1999.

On July 13, 2001, applicant filed an application given the control no. 09/903,639 ('639) which in, *inter alia*, its transmittal letter, reissue declaration, consent of the assignee to the filing of a reissue, request for transfer of drawings from the original patent to the reissue, claim for priority, as well as by way of presentation of the specification in the form of the printed patent in double column format as required by 37 CFR 1.173(a)(1), the presence of each of the original patent claims, bearing the same number as in the patent being reissued, per 37 CFR 1.177(b), and the numbering of claims following the numbering of the highest numbered original patent claim, per 37 CFR 1.177(b), with the underlining of each newly present claim in the manner required by 37 CFR 1.173(b), clearly and unambiguously sought to reissue the '607 patent. As the error given in the reissue declaration was that the patent claimed less than the inventor had a right to claim in that the original patent claims patent were unduly limited, and as the reissue application was filed within 2 years of the original patent issue date, applicant filed a broadening reissue that included, as filed 15 new claims.

On September 19, 2001, the USPTO mailed a filing receipt in the '639 reissue application to counsel, which was received on September 21, 2001, by counsel. The filing receipt included the caveat that applicant was to verify the accuracy of the data presented on the receipt.

On October 16, 2001, pursuant to 37 CFR 1.11(b), an *Official Gazette (O.G.)* notice informed the public that the '639 application had been filed to reissue the '607 patent.

On October 24, 2001, applicant filed a request in the '639 reissue application, per the above-noted caveat, for correction of the spelling of the inventor's first name to now include the last letter of the given name.

On April 11, 2003, the examiner mailed a Notice of Allowance in the '639 reissue application.

On June 6, 2003, applicant paid the issue fee in the '639 reissue application.

On June 11, 2003, the above-identified divisional application ('198) was filed, using, as permitted by 37 CFR 1.63(d)(iv), the declaration from the '639 parent case, which necessarily also complied with 37 CFR 1.63. As indicated in more detail below, applicant's did not comply with any of the regulations specific to reissue applications in general, much less to those regulations specific to an application that is both a divisional and a reissue.

On July 31, 2003, the USPTO mailed a filing receipt in the instant '198 application. The filing receipt included the caveat that applicant was to verify the accuracy of the data presented on the receipt. The filing receipt apprised applicant that he had filed a divisional application of the '609 reissue application; it did not apprise applicant that he had filed an application that was both a divisional of the '639 reissue application and a reissue of the '607 patent.

On October 28, 2003, the '639 reissue application was issued as RE38,292 with 18 additional claims over those issued in the original '607 patent.

On November 5, 2003, the USPTO mailed a Notice of Publication of Application that advised applicant that the instant '198 divisional application would be published on November 6, 2003, as US-2003-0207506-A1.

On November 6, 2003, the above-identified '198 divisional application was published as indicated immediately above.

On October 27, 2005, applicant filed a petition under 37 CFR 1.182 requesting that the USPTO convert the above-identified application to an application that is both a divisional and a reissue having the same filing date, from its current status as that of a divisional, but non-reissue, application.

The petition was dismissed in the decision of November 10, 2005.

The instant renewed petition was filed January 10, 2006.

PREVIOUS OPINION

Petitioner complains that the above-identified application "is presently erroneously being treated by the Patent Office as a [non-reissue] divisional application of Reissue Patent No. RE38,292 issued October 28, 2004 [from] application No. 09/903,639('639) filed July 13, 2001." Petitioner notes that under the rationale of *In re Bauman*, 214 USPQ 585 (CCPA 1982), the original patent No. 5,930,607('607) issued July 17, 1999, which was reissued by the parent '639 application for reissue is available against the above-identified application if it is treated as a non-reissue divisional of the '639 application, as opposed to being treated as a divisional application of the '639 application, but which likewise seeks to reissue the original '607 patent. Petitioner further asserts that it was applicant's intent to cover additional subject matter not originally claimed by using the instant application papers as a broadening reissue, but applicant is now barred (under 35 U.S.C. § 102(b)) from obtaining such broadening claims if this application is not treated as a reissue.

Inspection of the record of this application fails to support applicant's contention that the USPTO has "erroneously" treated this application as any thing other than a non-reissue

divisional application, and even more importantly, that petitioner has previously considered the instant application as a divisional reissue of the original '607 patent, or even an application for reissue of RE38,292, or that petitioner was diligent in seeking to correct his alleged filing error, or the alleged error of the USPTO.

Initially, petitioner points to the reissue declaration from the parent reissue application that was present on the filing of the instant application, as evidence of his intent to here file a divisional and reissue application. However, as 37 CFR 1.63(d)(iv) expressly authorizes re-submission of the declaration from a parent application when a divisional application is filed, the presence of the declaration from the parent application did not establish that petitioner was also seeking reissue by way of this divisional application. Rather, any reissue oath must necessarily also satisfy the requirements of 37 CFR 1.63, which applies to all declarations. See 37 CFR 1.175(a). Likewise, the amendment to the first line of the specification was consistent with the filing of a Bauman-type non-reissue, divisional application *per se* from a prior reissue application, and did not inform the USPTO, as required by 37 CFR 1.177(a), that this application was but one of a plurality of divisional reissues being sought for a single patent.

Indeed, what was conspicuously absent herein on filing are those indicia of the fact that a reissue has been filed (compare the contents of the '639 reissue application as filed with the contents of the instant application as filed) and furthermore, those indicia of the fact that an application that was both a divisional of the '639 application and also a reissue of the '607 patent had been filed, renders petitioner's contentions unpersuasive:

- (a) the lack of the written consent of the assignee to the filing of a reissue of any patent as required by 37 CFR 1.172;
- (b) the lack of presentation of the instant specification in the form of the printed patent in double column format as required by 37 CFR 1.173(a)(1);
- (c) the lack of compliance of the amendments made herein from filing on June 11, 2003, until the filing of the instant petition with 37 CFR 1.173, which governs reissue applications; rather the amendments were made in compliance with 37 CFR 1.121, compare e.g., the amendment to the first line of the specification made on filing with the amendment to the same part of the specification proffered with the instant petition,
- (d) the lack of a notice in the first sentence of the specification stating that more than one reissue application had been filed and their relationship, as required by 37 CFR 1.177(a);
- (e) the lack of the presence of each, much less any, of the original patent claims, bearing the same number as in the patent being reissued, per 37 CFR 1.177(b),
- (f) the lack of the numbering of any claim herein following the numbering of the highest numbered original patent claim, per 37 CFR 1.177(b).

Accordingly, any contention that the USPTO erred in not recognizing that this application was intended, as now alleged by applicant, to be both a divisional AND a reissue must fall of its own weight.

As to petitioner's belated request for extraordinary relief, consideration of all the circumstances of this case mitigates against the requested conversion.

Initially, petitioner's failure to identify this application as both a divisional and a reissue, prior to the issuance of the first reissue application, operated to preclude the USPTO from exercising its discretion to then stay the issuance of the first '639 reissue application, or even merge the '639 and *inter alia*, the instant '198 applications pursuant to 37 CFR 1.177(c), assuming for the sake

of argument this application will be regarded by the USPTO a reissue application.¹ Of further relevance to the request for extraordinary relief is that the USPTO has been denied such discretion due to petitioner's own failure to know and apply the rules of practice applicable to reissue applications in general, and, in particular, the rules of practice specific to reissue applications that are also divisional. Further, such lack or knowledge of, or misapplication of the rules of practice has led to his current alleged predicament.² However, such is not an adequate basis for seeking, much less obtaining, extraordinary relief. The extraordinary remedy provisions of the rules of practice should not be considered a panacea for tactical errors in prosecution. See Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party or his representative makes an avoidable mistake in filing or not filing papers). Rather, as the alleged failure to comply with the rules specific to applications for reissue in general, and to the rules specific to divisional applications that are also for reissue is an oversight that could have been avoided by the exercise of reasonable care and diligence, such is not a circumstance beyond the control of petitioner warranting waiver of the rules. See Nitto, supra (Commissioner's refusal to waive requirements of 37 C.F.R. 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 C.F.R. 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 C.F.R. 1.183); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (counsel's unawareness of 37 C.F.R. 1.8 not extraordinary situation warranting waiver of a rule). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); Stevens v. Tamai, 70 USPQ2d 1765 (Fed. Cir. 2004) (court denying priority due to counsel's admitted failure to follow the Rules of Practice of the USPTO). Further, it is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or other extraordinary relief. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995). Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats. 1977).

¹ See Ex parte Johnson, 117 USPQ 412 (Pat. Off. Bd. App. 1956) "the practice under [Rule 177] ... has been for the Commissioner or some official delegated by him to write a memorandum to the examiner directing what action should be taken insofar as the separation of the original patent into several reissue patents is concerned."

² Because the USPTO regulations are published in the Federal Register as required by the Federal Register Act, 44 U.S.C. §1505 (formerly 44 U.S.C. §§5, 7), they are binding, even in the absence of actual knowledge. See, e.g., Timber Access Industries Co. v. United States, 213 Ct. Cl. 648, 553 F.2d 1250, 1255 (1977); Andrews v. Knowlton, 509 F.2d 898, 905 (2d Cir.), cert. denied, 423 U.S. 873 (1975); United States v. Aarons, 310 F.2d 341, 345-48 (2d Cir. 1962); In re Pacific Far East Line, Inc., 314 F.Supp. 1339, 1348 (N.D. Cal. 1970), aff'd, 472 F.2d 1382 (9th Cir. 1973).

Moreover, petitioner's lack of diligence in this matter also operates against any favorable treatment of his request. In this regard, the filing receipt mailed July 31, 2003, apprised petitioner that he had filed a divisional application; it did not apprise petitioner that he had filed an application that was both a divisional of the '639 application and a reissue of the '607 patent. Still further, the Notice of Publication of Application mailed November 5, 2003, advised petitioner that this application would be published on November 6, 2003, as US-2003-0207506-A1. As such, petitioner long ago knew, or should have known, that he had not filed a reissue application, since reissue applications are not subject to pre-grant publication. See 37 CFR 1.211(b). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975). Indeed, petitioner was content with the USPTO treatment of this and several similarly situated non reissue divisional applications until the original patent was applied to reject the claims in these applications claims under the rationale of In re Bauman.

Likewise, the public has had since November 6, 2003, to rely on the fact that the above-identified published application was facially not an application for reissue, much less one of a plurality of broadening reissue applications for the '607 patent; it was merely a Bauman-type divisional application. As a general rule, public policy does not favor the restoration to the applicant of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner, e.g., intervening rights in the case of a reissue patent. See Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U.S. 477, 24 USPQ 308 (1935); Wollensak v. Reiher, 115 U.S. 96 (1885). Here, petitioner dedicated to the public his opportunity to file a plurality of broadening divisional reissue applications that likewise sought to reissue the '607 patent during the pendency of the '639 reissue application. Petitioner fails to advance any explanation for his lack of diligence in this matter, which mitigates away from favorable consideration of the request, for the reasons noted above. Furthermore, petitioner does not explain how the rights of the public will be protected if this non-reissue divisional is now converted to a divisional of the '639 application as well as a reissue of the '607 patent, such that the current statutory bar on the claims herein arising under Baumann would be obviated. Rather, the publication of the above-identified application as a non-reissue divisional was proper, and clearly did not put the public on notice that applicant was seeking a further broadening reissue herein, which under § 120 would have an effective filing date within the 2 year limit for filing a broadening reissue application per 35 U.S.C. § 251. Rather, that publication only noticed the public on November 6, 2003, that a Baumann type non-reissue continuing [divisional] application had been filed on June 11, 2003. As the court observed in In re Graff, 42 USPQ2d 1471 at (Fed Cir 1997):

"[T]he interested public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.

Here, the public had notice that a single broadening reissue had been filed within 2 years of the grant of the original patent, but the public did not have notice that another broadening divisional reissue claiming § 120 benefit of the prior broadening reissue filed within 2 years of the patent grant, had also been filed. The public only had notice that a non-reissue divisional application had been filed. However, the reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights. See Wollensak supra, at 100 ("[N]o one should be relieved who

has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent.") Not until applicant filed the instant petition and clarifying amendment under 37 CFR 1.177(a) did he begin to seek a true divisional application that was also a reissue of the '609 patent.³ But see In re Dien, 680 F.2d at 154, 214 USPQ at 14 (court observing that appellant had not thus far really asked for a reissue, and was not now going to get such a reissue approved); In re Fotland, 779 F.2d. 31, 228 USPQ 193 (Fed. Cir. 1985) (applicant refused reissue where he had not met requirements for a "true reissue" within the time limit for filing a claim-broadening reissue). However, petitioner's initial lack of compliance with the applicable rules for filing a divisional and a reissue, and subsequent failure to act diligently to seek this requested conversion before the termination of proceedings on the '639 reissue application weigh heavily against petitioner. For the reasons given above, that balancing of the interests of the patentee with that of the public should here be found in favor of the public interest in finality and certainty of claim scope by refusing the requested relief.

OPINION RE: RENEWED PETITION

Petitioner requests reconsideration and asserts that (1) contrary to the positions taken above by the USPTO re [lack of] public notice, and [lack of] diligence, the public was put on notice, upon the instant pre grant publication on November 6, 2003, that applicant was continuing to seek to correct errors of inadequate claim scope in the original patent, and (2) petitioner has acted with diligence since at least June 27, 2005 to correct the matter.

Petitioner is reminded that 37 CFR 1.182 applies only where the other rules are inapplicable. However, 37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures. See Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903). As shown by consideration of items (a)-(f) above, petitioner failed to follow the established rules and procedures for filing a divisional reissue application, as opposed to merely filing a non-reissue divisional application when this was filed, and was not diligent in seeking to correct his filing error. Furthermore, petitioner appears to overlook that his arguments in the amendment filed October 27, 2005, regarding alleged *dicta* in, and the total inapplicability of, Bauman (as well as Conover v. Downs) to the circumstances of this application operate to undermine his contention in the petition that extraordinary relief is warranted herein.

As to item (1) above, whatever notice was given to the public by the pre grant publication of this application on November 6, 2003, that notice, by definition, simply could not have been to the effect that there was yet another reissue application seeking to broaden the claims of the original '607 patent. Applications for reissue are simply not subject to pre grant publication. Notwithstanding the total lack of compliance herein with the regulations pertaining to the filing of a reissue application, the pre grant publication of this application simply could not operate to place the public on notice that yet another broadening reissue application of the '607 patent had been filed; it only put the public on notice that a non reissue application had been filed. Petitioner also overlooks that under 37 CFR 1.11(b), the fact of filing of all reissue applications after March 1, 1977, (except for continued prosecution applications (CPA's) filed under 37 CFR 1.53(d)) is announced in the Official Gazette (O.G.), and such thereafter are open to inspection

³ While the belated amendment to the first line of the specification constitutes applicant's initial attempt at compliance with 37 CFR 1.177(a), almost 2 years after the publication date, indicated above as item (d), items (a) through (c), (e), and (f) also noted above remain unsatisfied. Petitioner should not assume from the foregoing that even if total compliance with the applicable regulations represented by the aforementioned items (a) through (c), (e), and (f) is hereafter sought, that any renewed petition would be favorably considered.

by the general public.⁴ The total lack of any O.G. notice whatsoever indicating that this application was yet another broadening reissue of the '607 patent further refutes petitioner's contention; regardless of the claimed subject matter presented herein, such was manifestly not placed in a divisional application for reissue of the '607 patent. Accordingly, and further for the reasons of Dien and Fotland, the interested public is here entitled to rely, and to continue to rely, upon the absence of another broadening reissue of the '106 patent in addition to the '639 reissue application, which issued as RE38,292. Petitioner is not unduly prejudiced by this decision in that petitioner has already filed and obtained a broadening reissue of the '607 patent that was expressly filed for the purpose of correcting the error of insufficiently broad claims in the original patent, and to this end the reissue patent contained 18 additional claims.

As to item (2) above, the contention that petitioner has acted with reasonable diligence since at least June 29, 2005 is noted, but upon considering all the circumstances of this case, especially that petitioner has already obtained a broadening reissue of the '607 patent containing 18 additional claims, the requested change must be refused. Petitioner had the opportunity during the pendency of that first broadening reissue to present every claim filed herein, as well as every claim presented in the instant non reissue divisional application, for consideration in the first broadening reissue. It was unfortunate, but not beyond petitioner's control, that the instant application papers did not comply with the rules applicable to divisional applications that are also for reissue in the same manner that the application papers for the '639 reissue application complied with the rules applicable to reissue applications. It was also unfortunate, but not beyond petitioner's control, that the information on the filing receipt for instant application was not diligently scrutinized in the same manner that the filing receipt for the '639 reissue application papers was diligently scrutinized, and acted upon. Further, while petitioner asserts diligence for the last few months, the current predicament arises due to petitioner's protracted failure, since June 11, 2003, when this non reissue divisional application was filed, to know and apply the rules applicable to divisional reissues, and the interested public had since then to rely upon the absence of yet another divisional broadening reissue of the '106 patent. Applying the sentiments of the Fotland and Graff courts to this case, petitioner is properly refused the requested relief as petitioner did not meet the requirements for a true broadening divisional reissue within the time limit⁵, during the pendency of the first broadening reissue application,

⁴ The announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application. The announcement includes the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and the Technology Center (TC) to which the reissue application is initially assigned. IFW reissue application files are open to inspection by the general public by way of Public PAIR via the USPTO Internet site. In viewing the images of the files, members of the public will be able to view the entire content of the reissue application file history. To access Public PAIR, a member of the public would go to the USPTO web site at <http://www.uspto.gov>. However, this application was only publicly viewable upon its pre grant publication.

⁵ The original '607 patent issued July 27, 1999. Pursuant to 35 U.S.C. § 251, any broadening reissue had to be filed on or before July 27, 2001, or be filed, *ab initio* as a broadening reissue that itself claimed benefit under 35 U.S.C. § 120 of a broadening reissue filed on or before July 27, 2001. The '639 broadening reissue was filed July 13, 2001. This non reissue divisional, filed June 11, 2003, was thus copending with the '639 reissue which issued October 28, 2003. Petitioner had ample to time correct his non reissue filing error to avoid the use of his original patent issued July 27, 1999 as a reference against any claim where that

and petitioner compounded his initial filing error when the instant non reissue divisional application was filed on June 11, 2003. It is incumbent upon an applicant to prosecute his invention with continuing diligence and an acute awareness of the statute. See BEC Pressure Controls Corporation v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (D.C. N.Ind. 1974). Having failed to diligently take appropriate action to secure additional broadened claim coverage during the prosecution of the original reissue application, much less to secure the proper filing of a copending divisional application that were also intended to be an applications for reissue of the original '106 patent, petitioner cannot now be heard to complain as the window for presentation of such claims and reissue applications has long been closed. See Bauman at 590 (holding that a non reissue continuation of a prior reissue application is entitled to the benefit of the filing date of the prior reissue application under 35 U.S.C. § 120). That is, as petitioner did not really ask for any additional broadening divisional reissue application(s) during the period from June 11, 2003, to June 27, 2005, the instant request comes far too late. See Dien, supra, see also Wollensak, supra.

DECISION

For the reasons given above, and balancing of the interests of the patentee with that of the public, that balance will be found in favor of the public interest in the finality and certainty of claim scope by refusing the requested relief herein as it has also been refused in the non reissue divisional of this application: application No. 11/006,568 filed December 8, 2004 . The petition is **denied**. This application will continue to be treated by the USPTO as a non reissue division application.

This decision may be considered a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002. The USPTO will not further consider or reconsider this matter.

This application is being referenced to the Technology Center for continued treatment as a non-reissue divisional application.

Telephone inquiries related to this communication should be directed to Petitions Examiner Brian Hearn at (571) 272-3217.



Charles Pearson, Director
Office of Petitions

claim, as here, is found in a non reissue divisional application that is limited by 35 U.S.C. §120 to a filing date of June 11, 2003.