

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL P. DOYLE

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Appeal No. 2000-0601  
Reissue Application No. 08/601,101  
of U.S. Patent 5,296,595

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HEARD: December 6, 2000

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Before GARRIS, WALTZ, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 54 through 71. Claims 1 through 53, which are the only other claims pending in the subject application, are identical to the claims of the original patent and are allowed (examiner's answer, page 2).

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Claim 54 is illustrative of the claims on appeal and is reproduced below:

54. A method of enantioselectively catalyzing a reaction comprising the steps of:

providing a prochiral compound,  
providing a chiral catalyst comprising  
a nucleus with a first and second atom of the  
same metal aligned on an axis, said metal selected  
from the group consisting of rhodium, ruthenium,  
chromium, molybdenum, tungsten, rhenium and osmium;  
and

first, second, third and fourth bridging ligands  
oriented radially to the axis,

each ligand having a first and second complexing  
atom, the first complexing atom of each of said  
bridging ligands being complexed with said first  
metal atom, and the second complexing atom of each  
of said bridging ligands being complexed to said  
second metal atom,

said first bridging ligand further comprising a  
ring including said first complexing atom and  
attached to said second complexing atom, said ring  
also including a chiral center attached through a  
first bonding site to said first complexing atom,  
attached through a second bonding site to said ring,  
having a third bonding site occupied by a first  
substituent, and having a fourth bonding site  
occupied by a second substituent, and

said second bridging ligand further comprising a  
ring including said second complexing atom and  
attached to said first complexing atom, said ring  
also including a chiral center attached through a  
first bonding site to said second complexing atom,  
attached through a second bonding site to said ring,  
having a third bonding site occupied by a first  
substituent, and having a fourth bonding site  
occupied by a second substituent, and wherein the  
R/S configuration of the chiral center on the second  
bridging ligand is the same as the R/S configuration



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54 through 71 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 13 of Doyle.

At page 3 of the appeal brief, the appellant states: "Claims 54-71 are the newly presented claims and thus stand or fall together depending on the decision on the two issues noted above." Therefore, pursuant to 37 CFR § 1.192(c)(7) (1995), we select claim 54 from the group of rejected claims and decide this appeal as to the examiner's grounds of rejection on the basis of this claim alone.

We have carefully reviewed the entire record, including all of the appellant's arguments. Our review leads us to conclude that the examiner's rejection under 35 U.S.C. § 251 based on the recapture doctrine is not well founded. However, we affirm the examiner's other rejection under 35 U.S.C. § 251 based on the Orita doctrine and the rejection based on the judicially created doctrine of obviousness-type double patenting. The reasons for our determination follow.

The first and fourth paragraphs of 35 U.S.C. § 251 (1999) read as follows:

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Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or *by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Commissioner 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, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. [Italics added.]

\* \* \*

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

Our reviewing court has explained that section 251 "is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). Nevertheless, the court has also made it clear that "not every event or circumstance that might be labeled 'error' is correctable by reissue." Id. As often stated by the court, the reissue procedure does not entitle a patentee to "prosecute *de novo* his original application." Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, 1479, 46 USPQ2d

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1641, 1647 (Fed. Cir. 1998) (quoting Weiler, 790 F.2d at 1582, 229 USPQ at 677 and Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)).

With these legal principles in mind, we review the examiner's rejections under 35 U.S.C. § 251. The examiner states:

Applicant's failure to timely file a divisional application is not considered an error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than they had a right to claim; and thus, such appellant's error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Orita, Yohagi and Enomoti*, 193 U.S.P.Q. 145, 148 (C.C.P.A. 1977). See MPEP 1402 and 1450. Note the restriction dated 12/3/92 in the '595 patent and the subsequent cancellation of the non-elected subject matter by appellant, specifically claims 84-89 (Groups VII-IX). Also, method claims 60-64 apparently were canceled by preliminary amendment. The newly presented claims 54-71 cover such non-elected subject matter directed to divergent processes using the claimed chiral catalysts.

Furthermore, a reissue will not normally be granted to "recapture" claimed subject matter deliberately canceled in an application to obtain a patent. *In re Willingham*, 282 F.2d 353, 127 U.S.P.Q. 211 (C.C.P.A. 1960). See MPEP 1412.02. As noted above, the instant claims attempt to introduce subject matter deliberately canceled by preliminary amendment and in response to a restriction requirement in the '595 patent. The claims presented are of a broader scope than those claims that were canceled from the original patent

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application. The present method claims 54-71 cover all the methods canceled in the original application. "The recapture rule bars the patentee from acquiring, through reissue claims that are of the *same or broader scope* than those claims that were canceled from the original application." *Ball Corp. v. United States*, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984). [Italics and underlining original; examiner's answer, pp. 3-5.]

Thus, it appears that the examiner is relying on the separate doctrines of (1) In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977) (holding that failure to file a timely divisional application is not an "error" within the meaning of section 251) and (2) "recapture" to support the position that the reissue declaration fails to specify an error correctable by reissue.

The appellant, on the other hand, argues as follows:

[The] "divisional rule" does not apply to the present case because the new claims sought in this reissue application (claims 54-71) had never been presented in the original application, and thus had never been deliberately cancelled in response to a restriction requirement. [Appeal brief, p. 4.]

The appellant further contends:

[T]he Reissue Declaration clearly states that the error was, in fact, the failure to file broader method claims in the first place. This error in not filing the broader method claims is particularly evident in view of the fact that such broad method claims are not taught or suggested anywhere in the

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prior art. Seeking broader claims than those originally presented is a prime example of the type of error the reissue statute is used to correct. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1009 (Fed. Cir. 1991). [Appeal brief, p. 5.]

Regarding the rejection based on the recapture doctrine, the appellant urges:

The new claims 54-71 are not the same as any claim that was ever presented during prosecution of the '595 patent. Thus, these claims themselves were never amended or cancelled in an effort to overcome a prior art rejection. These new claims 54-71 are broader than those cancelled in response to the Examiner's Restriction Requirement. Moreover, those cancelled claims, were also never rejected over the prior art. In fact, the claims that issued in the '595 patent were never rejected over the prior art. Thus, the recapture rule does not apply to new claims 54-71. [Appeal brief, pp. 7-8.]

Thus, the first question raised in this appeal is whether a reissue applicant can circumvent the Orita doctrine by presenting reissue claims that encompass not only the subject matter of the canceled, non-elected claims of the original patent application but also additional subject matter. We answer this question in the negative.

The prosecution history of the original patent reveals that the examiner required restriction under 35 U.S.C. § 121 (Paper 3). As a consequence, claims 65 through 83, directed

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to a method of inserting a carbene using a chiral catalyst, were elected for prosecution on the merits (Paper 4). The non-elected claims, i.e. claims 1 through 59 and 84 through 89, were subsequently canceled (Paper 7). No divisional application was filed.

Claims 84 through 86 were directed to a method of enantioselectively forming a metal stabilized ylide using a chiral catalyst. Claim 87 was directed to a method of enantioselectively adding a hydrogen atom using a chiral catalyst. Claim 88 was directed to a method of enantioselectively adding a silicon and a hydrogen atom using a chiral catalyst. Claim 89 was directed to a method of enantioselectively adding a boron and a hydrogen using a chiral catalyst.

The appellant does not dispute the examiner's finding that the appealed claims cover the subject matter of canceled, non-elected claims 84 through 89 of the original patent application (examiner's answer, page 4). In this regard, ylide formation, which is the subject matter of claim 84 of the original patent application, is within the scope of appealed claim 54 (paragraphs 7-12 of the reissue

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declaration). Additionally, the appellant's counsel stated during the oral hearing that the failure to file a divisional application was one of two "errors" made in the original application to support this reissue application.<sup>1</sup>

The appellant would have us believe that the Orita doctrine would not be applicable if the reissue claims are broader than the canceled, non-elected claims. We cannot agree. While the appealed reissue claims are not identical to the canceled, non-elected claims of the original patent application, they nevertheless encompass the subject matter of each of the canceled, non-elected claims. Since the Orita doctrine forecloses the appellant from presenting reissue claims directed to the subject matter of the canceled, non-elected claims of the original patent application, we hold that any reissue claim including the foreclosed subject matter is also barred. Cf. Weiler, 790 F.2d at 1582, 229 USPQ at 677 ("If it were not error to forego divisional applications on subject matter to which claims had been made in the original

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<sup>1</sup> The appellant's counsel identified the other "error" as failing to present claims broader than those of the original patent.

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application, it cannot... have been error to forego divisional applications on subject matter to which claims had never been made." ).

Also, we point out that the court in Orita, 550 F.2d at 1280-81, 193 USPQ at 149 stated as follows:

Finally, granting by reissue claims substantially identical to those non-elected in application I would be ignoring the proper restriction requirement set forth in that application in which appellants acquiesced. Indeed, appellants' misapplication of section 251 would, if permitted, circumvent the copendency requirement of section 120, incorporated by reference in section 121 (see note 2 supra). Should appellants prevail, the copendency requirement would become meaningless, for should an applicant fail to file a divisional application while maintaining copendency as required by section 120, he could simply revert to section 251 in order to cure his mistake. **Section 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney...** [Footnote omitted; emphasis added.]

The same concerns of the Orita court are equally applicable here.

The appellant argues that the failure to file broader method claims is an error correctable by reissue (appeal brief, page 7). Although section 251 permits broadening within two years from the grant of the original patent, it is

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our opinion that the broadening cannot include subject matter foreclosed by the Orita doctrine.

We now turn to the examiner's rejection based on the recapture doctrine. The original patent application is a divisional application of Application No. 07/502,139 filed March 29, 1990, which is now U.S. Patent 5,175,311 to Doyle.<sup>2</sup> The original patent application was presented with claims 1 through 89. However, claims 60 through 64 which, like the claims of the '311 patent, were directed to a method of enantioselectively cyclopropanating an olefin were canceled by preliminary amendment (Paper 2). No reason was given for the cancellation of claims 60 through 64.

We concur with the appellant that the recapture doctrine does not apply to the facts of this case. As pointed out by the appellant, the claims canceled in the original application (i.e., claims 60 through 64 and 84 through 89) were never rejected over the prior art. Indeed, the claims canceled in the original application were not rejected on any ground. To

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<sup>2</sup> The Doyle '311 patent contains claims directed to a method of enantioselectively cyclopropanating an olefin with a chiral catalyst.

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invoke the recapture doctrine, there must be evidence that the cancellation of claims 60 through 64 and 84 through 89 amounted to an admission that these claims were not patentable. See, e.g., Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

Here, the examiner has not presented any such evidence. Claims 84 through 89 were canceled in response to a restriction requirement. We are unclear as to how the cancellation of these claims could possibly be considered an admission of unpatentability.

It is true that claims 60 through 64 of the original patent application and claims 1 through 13 of the '311 patent were both directed to a method of enantioselectively cyclopropanating an olefin using the same chiral catalyst. If claims 60 through 64 had not been canceled, it is conceivable that the examiner could have made an obviousness-type double patenting rejection against these claims over claims 1 through 13 of the '311 patent.

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However, the fact remains that claims 60 through 64 were canceled before the first Office action. Moreover, the obviousness-type double patenting rejection, if made in the original patent application, could have been overcome without cancellation of the claims (e.g., by filing a terminal disclaimer under 37 CFR § 1.321 (1996)). Under these circumstances, it cannot be said that the cancellation of claims 60 through 64 amounted to an admission that these claims were unpatentable.

For these reasons, we cannot sustain the examiner's rejection under 35 U.S.C. § 251 on the basis of the recapture doctrine.

Finally, we note that the appellant has not contested the rejection of claims 54 through 71 as unpatentable over the judicially created doctrine of obviousness-type double patenting. Nor has the appellant filed an appropriate terminal disclaimer under 37 CFR § 1.321. Accordingly, we summarily affirm the examiner's rejection.

In summary, the rejection of claims 54 through 71 under 35 U.S.C. § 251 and the rejection of claims 54 through 71 under the judicially created doctrine of obviousness-type

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double patenting as unpatentable over claims 1 through 13 of  
Doyle are affirmed.

The decision of the examiner is affirmed.

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

AFFIRMED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS a. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

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