

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANILKUMAR BHATT et al.

Appeal No. 2001-0323
Application No. 09/159,360

ON BRIEF

Before STONER, Chief Administrative Patent Judge, FRANKFORT and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

Upon consideration of appellants' brief (Paper No. 11, filed April 21, 2000), the examiner's answer (Paper No. 12, mailed July 13, 2000), and appellants' reply brief (Paper No. 13, filed September 1, 2000), the examiner's rejection of claims 2 to 11 and 13 to 24, the only claims pending in this reissue application, under 35 U.S.C. § 251 is REVERSED.

Appeal No. 2001-0323
Application No. 09/159,360

Page 2

FACT FINDINGS

Application No. 08/342,533

1. Application No. 08/342,533 was filed by the appellants on November 21, 1994 with claims 1 to 13 directed to a printed circuit board and claims 14 to 16 drawn to a method of preparing a printed circuit board.

2. The examiner required restriction under 35 U.S.C. § 121 between claims 1 to 13 (directed to a printed circuit board) and claims 14 to 16 (drawn to a method of preparing a printed circuit board) and the appellants elected to prosecute claims 14 to 16 (see Paper No. 3, mailed May 26, 1995, pages 2-3).

3. In the amendment filed June 26, 1995 (Paper No. 4), the appellants canceled claims 1 to 14 and amended claim 15.

4. On August 7, 1995, method claims 15 and 16 were allowed by the examiner (Paper No. 5).

5. On January 30, 1996, U.S. Patent No. 5,487,218 issued with claims 15 and 16 renumbered as claims 1 and 2, respectively.

Application No. 08/463,344

6. Application No. 08/463,344 was filed by the appellants on

June 5, 1995 under 37 CFR § 1.60 as a divisional application of Application No. 08/342,533 (the parent application). This application contained claims 1 to 13 directed to a printed circuit board and claims 14 to 16 drawn to a method of preparing a printed circuit board identical to the claims originally filed in the parent application.

7. The filing of this divisional application was accompanied by an amendment canceling claims 1 to 15 (Paper No. 2).

8. On February 7, 1996, method claim 16, identical to method claim 16 allowed in the parent application, was allowed by the examiner (Paper No. 3).

9. On September 24, 1996, U.S. Patent No. 5,557,844 issued with claim 16 renumbered as claim 1.

Application No. 09/159,360

10. Application No. 09/159,360 (the reissue application) was filed September 23, 1998 for reissue of U.S. Patent No. 5,557,844.

11. The reissue application as filed sought to cancel method claim 1 of the patent and to add claims 2 to 19 directed to a printed circuit board and claims 20 to 24 drawn to a method of

preparing a printed circuit board. Claims 2 to 24 are broader than claim 1, thus appellants are seeking to enlarge the scope of U.S. Patent No. 5,557,844.

12. The declarations accompanying the reissue application provide that the cancellation of claims 1 to 13 from divisional Application No. 08/463,344 was erroneous.

The rejection on appeal

13. Claims 2 to 11 and 13 to 24, all the claims pending in this reissue application, stand rejected under 35 U.S.C. § 251 "as these claims were not intended to be covered and secured by the original patent which is Pat No. 5,487,218." (Answer, p. 2).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we have determined that the decision of the examiner to reject claims 2 to 11 and 13 to 24 under 35 U.S.C. § 251 must be reversed for the reasons that follow.

The first paragraph of 35 U.S.C. § 251 provides:

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 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, 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.

The fourth paragraph of 35 U.S.C. § 251 provides:

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.

We find ourselves in agreement with the appellants position set forth in their briefs that the examiner's rejection of claims 2 to 11 and 13 to 24 under 35 U.S.C. § 251 is unsound. First, it is our determination that the reissue application complies with the fourth paragraph of 35 U.S.C. § 251 since the reissue application was applied for within two years from the grant of the original patent. In our view, the phrase "original patent" as used in the fourth paragraph of 35

U.S.C. § 251 means the patent upon which reissue is being sought (in this case U.S. Patent No. 5,557,844) not the first patent issued on the underlying disclosure. Since the filing date of the reissue application (i.e., September 23, 1998) is within two years of the issue date (i.e., September 24, 1996) of U.S. Patent No. 5,557,844, the appellants have meet the requirements of the fourth paragraph of 35 U.S.C. § 251 enabling the appellants to enlarge the scope of the claims of the original patent (i.e., U.S. Patent No. 5,557,844).

With respect to the requirements of the first paragraph of 35 U.S.C. § 251, it is clear to us that the record establishes that claims directed to the printed circuit board were erroneously canceled from divisional Application No. 08/463,344. Thus, a rejection of claims 2 to 11 and 13 to 24 under the first paragraph of 35 U.S.C. § 251 is not appropriate under the facts of this case.¹

¹ The appellants have offered to file a terminal disclaimer (brief, p. 13). We believe that a terminal disclaimer is necessary under the facts of this case in order to prevent or overcome obviousness-type double patenting between claims 20 to 24 in this reissue application and claims
(continued...)

¹(...continued)
1 and 2 of U.S. Patent No. 5, 487,218.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 to 11 and 13 to 24 under 35 U.S.C. § 251 is reversed.

REVERSED

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| BRUCE H. STONER, JR. |) | |
| Chief Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| JEFFREY V. NASE |) | |
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Appeal No. 2001-0323
Application No. 09/159,360

Page 10

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Appeal No. 2001-0323
Application No. 09/159,360

Page 11

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APPEAL NO. 2001-0323 - JUDGE NASE
APPLICATION NO. 09/159,360

APJ NASE

CAPJ STONER

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Jenine Gillis

DRAFT TYPED: Oct 10, 2002

FINAL TYPED: