

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

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KAZUFUMI OGAWA  
and MAMORU SOGA

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Appeal No. 2001-1607  
Application No. 09/112,219<sup>1</sup>

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HEARD: JANUARY 10, 2002

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Before: SCHAFER, LEE and GARDNER-LANE, Administrative Patent Judges.  
SCHAFER, Administrative Patent Judge.

**Decision on Appeal under 35 U.S.C. § 134**

Applicants Kazufumi Ogawa and Mamoru Soga appeal the final rejection under 35 U.S.C. § 135(b) of claims 12, 13, 15, 16, 18, 20-22 and 24-26. We have jurisdiction under 35 U.S.C. § 134.

We reverse and remand for further proceedings not inconsistent with this opinion.

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<sup>1</sup> Which is a Reissue of 08/312,185 filed 09/26/94, now U.S. Patent 5,538,762, issued 07/23/96; which is a continuation of 08/052,913, filed 04/27/93, now abandoned; which is a division of 07/774,827, filed 10/11/91, now U.S. Patent 5,240,774, issued 08/31/93.

### **Findings of Fact**

The following findings are supported by a preponderance of the evidence:

1. Applicants' claimed subject matter is directed to methods for applying a non-wetting fluorocarbon coating to substrates such as glass and to the coated substrates made by the process.
2. The process generally involves two steps: 1) contacting the substrate with a material which includes chlorosilyl groups to form a siloxane-based film, and 2) coating the siloxane film with a non-aqueous solution of a specified group of compounds having a fluorocarbon group and a chlorosilyl group.
3. The Condensed Chemical Dictionary defines a siloxane as a straight chain compound analogous to paraffin hydrocarbons consisting of silicon atoms single bonded to oxygen arranged so that each silicon atom is linked with four oxygen atoms. Condensed Chemical Dictionary, 8<sup>th</sup> Ed., 1971, p. 785.
4. Claim 21 is representative:  
  
A method of producing a non-wetting surface on a glass substrate comprising the steps of :
  - a. coating a siloxane-based primer layer on a surface of the glass; and
  - b. coating the siloxane-based primer layer with a composition comprising a perfluoroalkyl alkyl silane.
5. Applicants filed the application involved in this appeal on July 9, 1998, seeking to reissue patent 5,538,762, issued July 23, 1996.
6. As filed, the reissue application amended the 11 original claims of the patent and added additional claims 12-26.
7. A preliminary amendment entered January 19, 1999, amended claims 12, 16, 18, and 25 and cancelled claims 17, 19 and 23.

8. On February 2, 1999, applicants filed a paper titled “Request under 37 CFR 1.607 for Interference with Patent” asserting that applicants’ claims 12, 13, 15, 16, 18, 20-22 and 24-26 interfered with all claims of patent 5,328,768 issued to George B. Goodwin.<sup>2</sup>
9. The Goodwin patent also relates to methods for applying a non-wetting fluoro carbon coating to glass substrates and the articles made by the process.
10. The Goodwin method also generally involves two steps: 1) depositing a silica primer layer on the surface and 2) coating the silica primer film with certain fluorinated compounds.
11. Silica is the compound SiO<sub>2</sub>. Condensed Chemical Dictionary, 8<sup>th</sup> Ed., 1971, p. 783.
12. Goodwin’s claim 11 is representative:
- A method of producing a non-wetting surface on a glass substrate comprising the steps of:
- a. depositing a silica primer layer on a surface of the glass; and
- b. contacting the silica primer layer with a composition comprising a perfluoroalkyl alkyl silane.
13. Applicants’ claims 12, 13, 15, 16, 18, 20-22 and 24-26 were made in the application more than four and one half years after the issuance of the Goodwin patent on July 12, 1994.
14. An examiner rejected claims 12, 13, 15, 16, 18, 20-22 and 24-26 under 35 U.S.C. § 135(b) as not being made within one year of the issuance of the Goodwin patent.
15. In response to the rejection, applicants filed an amendment amending claim 14 and adding new claims 27-33 to the reissue application.
16. Applicants also argued that § 135(b) rejection should be withdrawn because the rejected claims were of the same scope or narrower than claim 16 of applicants’ earlier application 08/052,913 (the parent to the application which issued as the patent applicants seek to reissue).

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<sup>2</sup> We note that this paper has not been entered in the contents of the application or given a paper number. We assume that the paper was intended to be entered.

17. Claim 16 was added to the '913 application by an amendment entered November 24, 1993, prior to the issuance of the Goodwin patent.

18. Claim 16 of the '913 application provides:

A method of manufacturing a fluorocarbon-based polymer coating film comprising the steps of :

contacting a substrate having a surface containing hydroxyl groups with a non-aqueous solvent comprising a material comprising a chlorosilyl group; and

coating the substrate surface with either a non-aqueous solvent comprising a compound comprising a fluorocarbon group and a chlorosilyl group or a solvent comprising a compound comprising a fluorocarbon group and an alkoxy silane group.

Emphasis added.

19. The specification of the '913 application indicates that the purpose of contacting the substrate with the chlorosilyl group is to form a siloxane intermediate layer:

The primary objective of this invention is to provide a fluorocarbon-based polymer coating film comprising at least an siloxane film formed as an inner layer and a fluorocarbon-based polymer film formed as an outer layer on the surface of a substrate. The substrate surface and the inner layer are bonded with covalent bonds, and the inner layer and the outer layer are bonded with covalent bonds.

Specification of application 08/052,913 pp. 2-3.

20. Each of the examples of the '913 application describe the formation of a siloxane layer and describe the structural formulas which are consistent with the definition of siloxane from the Condensed Chemical Dictionary.

21. The specification of the '913 application does not expressly teach the formation of a silica intermediate layer.

22. The '913 application became abandoned and was refiled as file wrapper continuation application 08/312,185 on September 26, 1994.

23. The claims of the '913 application were automatically carried over to the '185 application.

24. A preliminary amendment in the '185 application entered September 26, 1994, cancelled claim 16.
25. The examiner again rejected claims 12, 13, 15, 16, 18, 20-22 and 24-26 of this application under 35 U.S.C. § 135(b) in a final action entered April 10, 2000.
26. The examiner noted that the purpose of § 135(b) is to act as a statute of repose and that the over four-year long delay in trying to provoke the interference was contrary to that purpose.
27. The examiner also thought that claim 16 from the '913 application could not be relied upon because it had been cancelled.
28. Applicants appealed the final action.

## **Analysis**

### **The Rejection**

Section 135(b) as it existed during the prosecution of this application provides:<sup>3</sup>

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

In In re McGrew, 120 F.3d 1236, 1237, 43 USPQ2d 1632, 1634 (Fed. Cir. 1997) the federal circuit noted as correct a statement by a panel of this board that, § 135(b) was intended by Congress to be "a statute of repose . . . to be a statute of limitations, so to speak, on interferences so that the patentee might be more secure in his property right." McGrew, 120 F.3d at 1237, 43 USPQ2d at 1634 ("The Board's construction of the statutory provision at issue in this case, section 135(b) quoted above, was correct.") It is apparently the examiner's view that to allow the applicants to make claims which interfere with the Goodwin patent

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<sup>3</sup> Section 4508 of Pub. Law 106-113 amended § 135(b) by adding a second provision relating to applications published under § 122(b). The amendment does not effect the outcome of this appeal.

more than four and one-half years after that patent issued defeats the purpose of § 135(b) as a statute of repose or limitation. The question the examiner implicitly asks is how can an applicant ever be secure in its property right if a subsequent applicant can reach back many years to an earlier cancelled claim in order to defeat the § 135(b) bar?

There is no dispute that applicants' claims 12, 13, 15, 16, 18, 20-22 and 24-26 were not made within one year of the grant of the Goodwin patent. Thus, applying the express language of § 135(b), those claims would appear to be barred since they were not made prior to one year from the date the Goodwin patent issued. However, under the jurisprudence interpreting § 135(b), applicants' claims are not barred if applicant claimed the same or substantially same subject matter as claimed by the patentee prior to the critical date. See, e.g., Corbett v. Chisholm, 568 F.2d 759, 760, 196 USPQ 337, 338 (CCPA 1977) ("The issue, therefore, is whether the board was correct in holding that Corbett was not claiming subject matter substantially the same as that covered by the copied claims prior to January 19, 1972, i.e., within the year after Chisholm's patent issued"). The issue of whether cancelled claims could be relied upon was addressed squarely in Corbett. There the junior party relied upon four sets of claims to show that it was claiming the same or substantially the same subject matter. One set, claims 24-27, were cancelled prior to the issuance of the patent. The court stated the issue:

[S]hould claims 24-27 be considered in view of Chisholm's allegation that they were not presented during the "critical period."

Corbett, 568 F.2d at 764, 196 USPQ at 342. The court affirmatively answered the question:

We conclude that the claims to be considered in this appeal are claims 24-27, even though cancelled prior to issuance of Chisholm's patent . . . .

Corbett, 568 F.2d at 765, 196 USPQ at 342.<sup>4</sup> Thus, applicants claim 16 in the '913 application may be relied upon to avoid the bar of § 135(b).

There is much to be said for the examiner's position. Notwithstanding the one-year period specified in the statute, patentees could be dragged into an interference anytime during the life of the patent as long as an applicant could point to a claim filed prior to the critical date that was the same as or to substantially the same subject matter as a claim in a patent. Patentees, therefore, would be required to keep detailed records relating to the development of the invention for the life of the patent. A patentee who did not keep such records would not be able to prove a date of invention earlier than the effective filing date of the patent. However, in our view, this is what controlling precedent allows an applicant to do.

The decision of the examiner is reversed.

### **Remand**

We remand this appeal to the examiner to consider and determine whether claim 16 from the '913 application is directed to the same or substantially the same subject matter as claimed in the Goodwin patent. See 37 CFR § 1.196(a). Goodwin claims specify a method including the step of depositing an intermediate silica layer on to a substrate. For example, claim 11 specifies the following:

11. A method of producing a non-wetting surface on a glass substrate comprising the steps of:
  - a. depositing a silica primer layer on a surface of the glass; and
  - b. contacting the silica primer layer with a composition comprising a perfluoroalkyl alkyl silane.

(Emphasis added.) Claim 16 of the '913 application requires applying a material comprising a chlorosilyl group. According to the '913 specification this step results in the formation of a siloxane polymer layer:

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<sup>4</sup> We note that earlier CCPA precedent indicated that claims relied upon to avoid the § 135(b) bar had to continuously claim the subject matter beginning at a time less than one year after the issuance the patent. See Stalego v. Heymes, 263 F.2d 334, 336, 120 USPQ 473, 476 (CCPA 1959). However, Corbett being the later in time is controlling. The CCPA's later decisions control because that court always sat en banc. In re Gosteli, 872 F.2d 1008, 1011, 10 USPQ2d 1614, 1617 (Fed. Cir. 1989).

The primary objective of this invention is to provide a fluorocarbon-based polymer coating film comprising at least an siloxane film formed as a inner layer and a fluorocarbon-based polymer film formed as an outer layer on the surface of a substrate. The substrate surface and the inner layer are bonded with covalent bonds, and the inner layer and the outer layer are bonded with covalent bonds.

Specification of application 08/052,913 pp. 2-3. In addition each of applicants' examples describes the formation of a siloxane polymer layer having a structure not inconsistent with the definition of siloxane in the Condensed Chemical Dictionary.

It is not clear from the record that silica and the siloxane polymer film are the same. Applicants treat them as same thing. Thus, applicants state:

Although the claim does not literally use the term "silica primer layer" . . . that is precisely what a siloxane-based film is.

Request under 37 CFR 607 for Interference with a Patent, p. 6. Applicants also note that Example 1 states that the initial contact step results in a film adhered to the substrate "via chemical bonds of -SiO-." Request under 37 CFR 607 for Interference with a Patent, p. 6. Applicants further argue that the step in claim 16 of the '913 application "will inherently form a silica primer layer on a substrate surface." Paper 18, p. 6.

While silica and siloxane are each compositions which include both silicon and oxygen, as defined by the Condensed Chemical Dictionary, they are not recognized to be the same. Silica is  $\text{SiO}_2$ . Siloxane is a straight chain compound of silicon single-bonded to oxygen analogous to paraffin hydrocarbons. Applicants' assertion that the formation of silica is inherent and that the description of the presence of -SiO- bonds indicates that silica is formed are attorney argument which are not supported by evidence.

Since this matter was not raised during prosecution before the examiner we remand to give applicants and the examiner the opportunity to supplement the record on the question of whether silica inherently (i.e., always and necessarily) forms when the process of claim 16 of the '913 application is carried out.

Any evidence which applicants wish to have considered by the examiner on remand must be submitted to the examiner within two months of the date of this decision. This time may **not** be extended under 37 CFR § 1.136. If, upon consideration of the record including any additional evidence (whether or not supplied by applicants), the examiner determines that the formation of silica is inherent in the process of claim 16 of the '913 application, the examiner should determine whether an interference-in-fact exists between any claims of the application and the Goodwin patent. If the examiner is of the opinion that an interference-in-fact exists, an appropriate recommendation to declare an interference should be prepared following established procedures. The recommendation must include the evidence and reasoning explaining the basis for holding that Goodwin's silica and applicants' siloxane are the same or substantially the same. If, after consideration of the supplemented record, the examiner determines that silica and siloxane are not the same or substantially the same, then a rejection under 35 U.S.C. § 135(b) would be appropriate.

REVERSED AND REMANDED

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RICHARD E. SCHAFER	)	
Administrative Patent Judge	)	
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_____	)	BOARD OF PATENT
JAMESON LEE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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SALLY GARDNER-LANE	)	
Administrative Patent Judge	)	

Appeal No. 2001-1607  
Application No. 09/112,219

cc (via First Class mail):

RICHARD D. JORDAN  
MORRISON & FOERSTER  
2000 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, DC 20006-1888