

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 106

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CREG W. DANCE,

Junior Party,¹

v.

C. VAUGHAN SEIFERT, WOLCOTT M. DOWNEY,
and PETER J. SHANK,

Senior Party.²

Patent Interference No. 103,379

HEARD: October 5, 1999

FINAL DECISION AND JUDGMENT UNDER 37 CFR § 1.658(a)

¹ Patent No. 5,117,839, issued June 2, 1992, based on Application Serial No. 07/584,461, filed September 18, 1990. Assigned to Lake Region Manufacturing Co., Inc.

² Application Serial No. 08/069,829, filed May 28, 1993, for reissue of Patent No. 5,045,061 (hereinafter, Seifert's '061 patent), issued September 3, 1991, based on Application Serial No. 07/474,371, filed February 2, 1990. Assigned to C.R. Bard, Inc.

Before PATE, MARTIN, and CRAWFORD, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

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A. Background

The subject matter of this interference is an angioplasty device including releasable locking means which in the locked position prevents relative axial movement between the catheter body and the guidewire while permitting relative rotational movement therebetween, providing "fixed wire" operation. When the locking means is in the unlocked position, the device provides "over-the-wire" operation, wherein the catheter body is both axially and rotationally movable with respect to the guidewire.

Seifert provoked the interference by filing a reissue application including new claims 31-35 based on Dance's claims 1-4 and 8, respectively. The interference was

initially declared with these claims designated as corresponding to Counts 1-3 as follows:

Count 1: Dance's claim 1 and Seifert's claim 31;

Count 2: Dance's claims 2-4 and Seifert's claims 32-34; and

Count 3: Dance's claim 8 and Seifert's claim 35.

In Paper No. 55, the Administrative Patent Judge (APJ) redeclared the interference to additionally designate Seifert's reissue application claim 1³ to correspond to Count 1. Furthermore, because the parties's briefs for final hearing do not separately argue the three counts, the APJ again redeclared the interference in Paper No. 105 to designate all of the involved claims (i.e., Dance's claims 1-4

³ Although reissue application claim 1 is identical to original patent claim 1, the patent was not added to the interference. The APJ's "Decision on Dance request for reconsideration" (Paper No. 53) (hereinafter "Decision on Reconsideration") includes, at 8, the following instruction to the examiner regarding Seifert's remaining uninvolved reissue application claims: "In the event a final judgment is entered against claims 1 and 31 in this interference, the examiner should consider whether any of Seifert's other noninvolved reissue claims should be rejected on the ground that they are patentably indistinct from those claims. In re Deckler, 977 F.2d 1449, 1452-53, 24 USPQ2d 1448, 1449-51 (Fed. Cir. 1992)." As will appear, none of Seifert's involved claims have been determined to be unpatentable.

and 8 and Seifert's reissue application claims 1 and 31-35) as corresponding to Count 1, which is identical to Dance's claim 1 and reads as follows:

Count 1

An apparatus comprising:

- a. a catheter body having a proximal end and a distal end;
- b. a guidewire having a proximal end and a distal end moveably located within said catheter body;
- c. releasably engaging means attached to said guidewire proximal end for releasably engaging said guidewire against longitudinal movement with respect to said catheter body, said releasably engaging means comprising compressible fixation means for fixing the position of said guidewire in said catheter body upon compression thereof, and compression means associated with said compressible fixation means for compressing said compressible fixation means; and
- [d.] rotating means attached to said guidewire for rotating said guidewire with respect to said catheter body.

B. The issues

The parties' briefs⁴ for final hearing raise the following issues:

(1) Priority;

(2) Whether Dance is entitled to a Certificate of Correction of patent claim 1; and

(3) Whether Seifert's reissue claims 31-35 are unpatentable under 35 U.S.C. § 251, including whether the APJ erred in allowing Seifert to rely on the Nanto⁵ and Hoorntje⁶ articles in connection with this issue.

In addition, subsequent to the final hearing, Dance filed a motion under § 1.635 to strike the initial reissue

⁴ Dance's opening brief and reply brief are referred to hereinafter as "D.Br." and "D.R.Br." and senior party Seifert's brief is referred to as "S.Br." Seifert's record and exhibits are identified hereinafter as "SR" and "SX," respectively. Consistent with the parties' briefs, Dance's record, which contains his exhibits, is identified as "JR" ("J" meaning junior party).

⁵ S. Nanto et al., A Technique for Changing a PTCA Balloon Catheter Over a Regular-Length Guidewire, 32 *Catheterization and Cardiovascular Diagnosis* 274-77 (1994) (JR 35-38).

⁶ Jan C.A. Hoorntje, How To Change an Over-the-Wire PTCA Balloon Over a Normal Short Guidewire, 18 *Catheterization and Cardiovascular Diagnosis* 284 (1989) (JR 29-34).

declarations of Seifert, Downey, and Shank on the ground that they contain inadmissible hearsay.

Finally, there is an unbriefed issue to be considered: Seifert's Motion under § 1.634 to add Robert Scribner as a coinventor. The APJ⁷ deferred consideration of this motion to final hearing together with consideration of Dance's motion⁸ under § 1.633 (sic, § 1.635) to strike or hold non-responsive the supplemental Scribner affidavit (SR 10) filed in support of the § 1.634 motion. The failure of the parties' briefs to discuss the merits of these motions presumably results from the mistaken impression that deferred motions need not be discussed in the briefs. Sections 1.656(b)(6) and (c) require each party's opening brief to contain an argument portion containing its contentions with respect to the issues it is raising for consideration at final hearing. The commentary to the adoption of § 1.656(b)(6) in its current form, in discussing the junior party's opening brief (Seifert is the senior party), explains that the issues

⁷ See Paper No. 40, "DECISIONS ON MOTIONS, ORDER TO SHOW CAUSE, ETC." (hereinafter "Decisions on Motions") at 11-15 and Decision on Reconsideration at 8.

⁸ Paper No. 51.

the party is raising at final hearing include the issues raised in its deferred motions and its denied motions:

In order to clarify that the opening brief of a junior party need not address the evidence of the other parties, § 1.656(b)(6), as adopted, is revised to require only that the junior party's opening brief contain the contentions of the party "with respect to the issues it is raising for consideration at final hearing." These issues would include the junior party's case-in-chief for priority with respect to an opponent or derivation by an opponent as well as matters raised in any denied or deferred motions of the junior party that are to be reviewed or considered at final hearing.

Patent Appeal and Interference Practice -- Notice of Final Rule, 60 Fed. Reg. 14,488, 14,516 (March 17, 1995), reprinted in 1173 Off. Gaz. Pat. & Trademark Office 36, 60 (April 11, 1995).

Although the senior party's brief is not specifically addressed in the commentary, it should be clear that the issues the senior party is raising for final hearing likewise include any deferred motions the senior party wishes to have considered at final hearing. Despite this apparent oversight, Seifert's § 1.634 motion and Dance's motion to strike will be

considered because they concern the inventorship of an involved application and Seifert presumably is in possession of all of the relevant facts. Compare Schulze v. Green, 136 F.3d 786, 791, 45 USPQ2d 1769, 1774 (Fed. Cir. 1998):

Appellants raised the issue of proper inventorship, and Appellants had all of the facts necessary to present the issue. Therefore, because Appellants' patentability question of inventorship was fairly raised, could have been and still can be fully presented during the interference, it must be resolved inter partes. As the legislative history of the 1984 Amendments reflects, by combining the two boards, "all issues of patentability and priority which arise in an interference can be decided in a single proceeding rather than in a series of complicated inter partes and ex parte proceedings." See 130 Cong. Rec. 28,065, 28,072 (1984), reprinted in 1984 U.S.C.C.A.N. 5827, 5836-37.

C. Standard of review with respect to matters addressed in APJ's decisions on motions

We note that although several of the substantive issues before us were raised in motions which were decided in the APJ's Decisions on Motions and Decision on Reconsideration, those decisions are not entitled to deference by this panel. See § 1.655(a) as amended effective March 16, 1999, which provides

that "[t]he abuse of discretion standard shall apply only to procedural matters." Consideration of Interlocutory Rulings at Final Hearing in Interference Proceedings, 64 Fed. Reg. 12,900, 12,901 (March 16, 1999). Nevertheless, the party requesting modification of an interlocutory order⁹ bears the burden of showing that the order should be modified. 37 CFR § 1.655(a) (1999).

D. Dance's case for priority

Dance's burden of proof on the question of priority is by a preponderance of the evidence. 37 CFR § 1.657(b). Only if Dance succeeds in proving a date of invention prior to the February 2, 1990, effective filing date of Seifert's reissue application will it be necessary to consider Seifert's priority evidence.

Dance's preliminary statement¹⁰ alleges conception on or before September 5, 1989, an actual reduction to practice

⁹ 37 CFR § 1.601(q) provides: "A final decision is a decision awarding judgment as to all counts. An interlocutory order is any other action taken by an administrative patent judge or the Board in an interference, including the notice declaring an interference."

¹⁰ Paper No. 30.

on or before March 15, 1990 (which is one month after Seifert's

benefit date), and diligence beginning on or before September 12, 1989. Of the facts alleged in the "Statement of Facts" portion of Dance's opening brief, only the following concern Dance's case for priority (D.Br. 7-8):

12. The invention of the Dance patent was conceived solely by Creg W. Dance and disclosed in detail to Randy Dennis on October 9, 1991 (See declarations of Randy Dennis and Creg W. Dance and attachments thereto).

13. The structure that was disclosed to Randy Dennis was attached to the Dance Preliminary Statement and became the subject of the Dance U.S. Patent 5,117,839. (Dance declaration. Para. 6)

14. That the [sic] disclosure of Creg W. Dance is sufficiently detailed that a skilled machinist could build the catheter depicted without exercise of inventive skill (Dance declaration para. 8).

The argument portion of Dance's opening brief contains no discussion whatsoever of Dance's case for priority and therefore clearly fails to satisfy the requirements of §§ 1.656(b)(5) and (6) concerning the statement of facts and the argument portions of a junior party's opening brief.

Compare Ganguly v. Sunagawa, 5 USPQ2d 1970, 1972 (Bd. Pat. App. & Int. 1987), which involved a junior party brief filed under predecessor rule 1.254:

[W]e agree with Sunagawa that Ganguly's brief does not meet the requirements of 37 CFR 1.254, which specifies that the junior party

shall present in his brief "a clear statement of the points of law or fact upon which he relies". As noted by Sunagawa, Ganguly merely sets forth broad legal conclusions with no mention of the facts. We agree with Sunagawa that the Ganguly brief is simply an invitation to read the Ganguly record and does not fairly comply with the requirements of the rule for briefs at final hearing.

Also compare In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 33 (CCPA 1974) (vague and general statements in the broadest terms as to what the exhibits show along with the assertion that the exhibits describe a reduction to practice amounts essentially to pleading, unsupported by proof or a showing of facts). While we could enter judgment against Dance on the priority issue for failing to comply with these requirements, we decline to do so, as Seifert has not requested the entry of judgment on that ground.

Dance's priority evidence consists of declarations by noninventor Randy Dennis (JR 7-8) and by inventor Creg Dance (JR 16-18). Attached to each declaration is a copy of Dance's preliminary statement¹¹ (JR 9-15; JR 19-25), including four sheets of drawings.¹² Dance's affidavit testimony and these

drawings are entitled to weight only to the extent they have independent corroboration. Hahn v. Wong, 892 F.2d 1028, 1032-33, 13 USPQ2d 1313, 1317 (Fed. Cir. 1989) ("The inventor . . . must provide independent corroborating evidence in addition to his own statements and documents. See Lacotte v. Thomas, 758 F.2d 611, 613, 225 USPQ 633, 634 (Fed. Cir. 1985).").

Dennis's declaration (JR 7-8, ¶¶ 1-5), quoted below, presumably is being offered to corroborate inventor Dance's testimony¹³ about conception:

¹¹ Filed as Paper No. 30.

¹² Although the schedule in Paper No. 54 included dates for each party to request and perform cross-examination of the opponent's affiants, no cross-examination was conducted.

¹³ Dance, JR 16-17, ¶¶ 1-9.

1. I am Vice President of Marketing and Sales of Lake Region Manufacturing, Inc. I have senior management responsibility for product marketing for Lake Region.
2. In 1989 I was employed by Lake Region as its director of marketing and sales. As such I had responsibility for interacting with research and product development personnel to help define potential new products.
3. I have reviewed the Preliminary Statement filed by party Dance in the subject interference attached hereto, and especially the four drawing pages attached thereto. I note that my signature appears below that of Creg W. Dance and is dated October 9, 1989.
4. The drawings were created by Creg Dance and were disclosed to me on the date indicated in a meeting. At the time I understood the features of the invention and also understand

them now. They are quite clearly described and I had no input to the preparation of the drawings or the features of the device shown.
5. I do not believe, therefor [sic], that I am a co-inventor with respect to the device shown in the four pages of drawings attached to the Dance Preliminary Statement.

Seifert has moved¹⁴ to suppress paragraphs 3 and 4 and all four sheets of drawings on two grounds, the first being the absence of proper authentication:

Even assuming the accuracy of the signatures, they appear only on one of the four drawing pages. No nexus is shown, either from the drawings themselves or from the Dennis declaration, between the four pages nor is their [sic] any showing as to what the drawing pages purport to disclose. The drawings are inadmissible under Rule 909, Fed. R. Evid. [Motion at 2.]

The Federal Rules of Evidence contain no Rule 909; however, it is clear from the foregoing argument that Rule 901 was intended. We will not suppress the drawings as lacking authentication. Dance's un rebutted testimony is sufficient to make a prima facie showing that these drawings were prepared by Dance on or before October 9, 1989, which is enough to satisfy the authentication requirement. Seifert's second argument is that the drawings

also are inadmissible because junior party has not complied with 37 C.F.R. §1.671(f)

that requires that "the significance of documentary and other exhibits identified by a witness in an affidavit...shall be discussed with particularity by a

¹⁴ Paper No. 77.

witness." None of the declarations of Mr. Fleischhacker, Mr. Dennis or Mr. Dance discusses the significance of the four drawing pages or provides an explanation as to what they show. Quite clearly, the drawings have no explanatory text. The drawings do not speak for themselves. [Motion at 2.]

This argument is unconvincing because Seifert has not established that the nature of the drawings is such that their contents require explanatory testimony. Compare Price v. Symsek, 988 F.2d 1187, 1195-96, 26 USPQ2d 1031, 1037 (Fed. Cir. 1993), which held that the content of a particular drawing did not require corroboration by a witness:

The board erred in its understanding that what a drawing discloses invariably needs to be supported by corroborating evidence. Holmwood [v. Sugavanam], 948 F.2d [1236,] 1238-39, 20 USPQ2d [1712,] 1714 [(Fed. Cir. 1991)]. Exhibit 13 is before the board for the board to make its own determinations as to what this piece of evidence discloses. Unlike a situation where an inventor is proffering oral testimony attempting to remember specifically what was conceived and when it was conceived, a situation where, over time, honest witnesses can convince themselves that they conceived the invention of a valuable patent, Eibel Process [Co. v. Minnesota & Ontario Paper Co.], 261 U.S. [45,] 60

[(1923)], "corroboration" is not necessary to establish what a physical exhibit before the board includes. Only the inventor's testimony requires corroboration before it can be considered. Holmwood, 948 F.2d at 1239, 20 USPQ2d at 1715 (citing Borror v. Herz, 666 F.2d 569, 572-73, 213 USPQ 19, 22 (CCPA 1981)). While evidence as to what the drawing would mean to one of skill in the art may assist the board in evaluating the drawing, the content of Exhibit 13 does not itself require corroboration. See Loom Co. v. Higgins, 105 U.S. (15 Otto) 580, 594, 26 L. Ed. 1177 (1882) ("An invention . . . may be exhibited either in a drawing or in a model, so as to lay the foundation of a claim to priority, if it be sufficiently plain to enable those skilled in the art to understand it.").

Accordingly, Seifert's motion to suppress the four pages of drawings attached to Dennis's declaration and Dennis's testimony about them is denied.

Inasmuch as Seifert does not deny that the count reads on the apparatus shown in the four drawings, Dance is hereby accorded a conception date of October 9, 1989, which is prior to the February 2, 1990, filing date of Seifert's '061 patent.

However, in order to prove a date of invention prior to Seifert's February 2, 1990, filing date, Dance also must prove diligence

during the critical period running from just before Seifert's filing date (considered to be the date of Seifert's entry in the field prior to evaluation of Seifert's priority case) up to Dance's September 18, 1990, filing date. Scharmann v. Kassel, 179 F.2d 991, 996, 84 USPQ 472, 476 (CCPA 1950):

Where one is first to conceive and last to reduce to practice, he has the burden as first conceiver to affirmatively establish continuing and reasonable diligence, or reasonable excuse for failure to act, in reducing to practice from a date immediately prior to the time the subsequent inventor entered the field until reduction to practice by himself as the first conceiver. Hull v. Davenport, 24 C.C.P.A. (Patents) 1194, 90 F.2d 103, 33 USPQ 506 [1937].

Inventor Dance's affidavit (JR 17-18, ¶ 10) alleges the following acts, presumably as proof of diligence:

- a. A patentability search was initiated on October 11, 1989;
- b. An initial evaluation of the patentability was received on October 24, 1989;
- c. More formal engineering drawing[s] were prepared by Lake Region employee Don Hanson on November 10, 1989;
- d. Development of the invention depicted was included in a Product Development Plan dated January 10, 1990;
- e. An initial draft of the patent application relating to this invention was prepared by about March 15, 1990;
- f. Another set of drawings depicting the invention were prepared on or about March 26, 1990;

g. Work on the invention was discussed in a letter dated April 4, 1990 to one of Lake Region's vendors, CAD/CAM Engineering;

h. Work on the draft patent application continued with redrafts being generated dated May 9, 1990, July 25, 1990, and August 15, 1990[; and]

i. The Application was filed on September 18, 1990.

None of these documents have been introduced into evidence, let alone with authenticating testimony by someone other than Dance. Furthermore, the preparation of these documents is not corroborated by Dennis or anyone else. Dance therefore has failed to prove diligence, with the result that judgment is being entered infra against Dance's involved claims based on his failure to prove a date of invention prior to Seifert's filing date.

E. Seifert's case for priority

Dance's failure to prove a date of invention prior to Seifert's filing date makes it unnecessary to consider Seifert's priority evidence or Dance's contention (D.Br. 20) that some of it, i.e., the declarations by James F. Crittenden (SR 1), Marianne G. Strong (SR 6), and Russell Bowden (SR 8) and Exhibits SX1-SX5, should be denied entry.

F. Seifert's § 1.634 motion to add Scribner as a coinventor

1. The evidentiary requirements of a § 1.634 motion

As the parties' briefs were filed before the December 1, 1977, effective date of the amendments which liberalized some of the PTO rules, Changes to Practice and Procedure; Final Rule, 62 Fed. Reg. 53,132 (Oct. 10, 1997), reprinted in 1203 Off. Gaz. Pat. & Trademark Office 63 (Oct. 21, 1997) (hereinafter 1997 Amendments), we will sua sponte consider the effects, if any, of those amendments on Seifert's § 1.634 motion,¹⁵ which was filed in 1994 to correct the inventorship in his reissue application. More particularly, we will consider the effect of those amendments on the type of evidence required to establish that the error in inventorship in the application occurred "without any deceptive intention." See 35 U.S.C. § 116 (2000), third paragraph ("Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive

¹⁵ Paper No. 33.

intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.").

Section 1.634, which was not amended in December 1997, provides that "[a] party may file a motion to (a) amend its application involved in an interference to correct inventorship as provided by § 1.48 or (b) correct inventorship of its patent involved in an interference as provided in § 1.324. See § 1.637(a)." Section 1.48 is one of the rules affected by the 1997 amendments. 1997 Amendments, 62 Fed. Reg. at 53,137-40,

1203 Off. Gaz. Pat. & Trademark Office at 68-70. Section 1.175, discussed infra, is another. Id. at 53,165-66, 1203 Off. Gaz. Pat. & Trademark Office at 92-93. It is necessary to consider the effect of these amendments on Seifert's 1994 motion because it is PTO policy to retroactively apply §§ 1.48 and 1.175 as amended to applications pending on December 1, 1997. See Changes to Patent Practice and Procedure --

Training and Implementation Guide, Chapter 8, pp. 21-23 (copy enclosed):

II. CORRECTION OF INVENTORSHIP - 37 C.F.R. §§ 1.41, 1.48, 1.324

. . . .
(Q84) Will the changes to the rules with respect to deceptive intent apply only to applications filed after the effective date of the rule?

Answer: No. The changes to the rules with respect to deceptive intent will apply not only to applications filed after the effective date of the rule, but also to earlier-filed applications that are pending on the effective date of the rule. (See "Reissue Practice" Section for a question relating to the sufficiency of a reissue oath or declaration.)

See also Chapter 8, pp. 33-36 (copy enclosed):

VII. REISSUE PRACTICE - 37 C.F.R. §§ 1.171, 1.172, and 1.175

. . . .
(Q131) Is an oath or declaration filed before December 1, 1997, the effective date of the final rule, evaluated under the amended 37 C.F.R. § 1.175 of the final rule if the Office action is mailed after December 1, 1997?

Answer: Yes. Even though the reissue oath or declaration was filed prior to the effective date of the new rules, the oath or declaration is reviewed under the amended version of § 1.175.

One of the changes to § 1.48 was to make it inapplicable to reissue applications, as evidenced by its new

title: "Correction of inventorship in a patent application, other than a reissue application."¹⁶ The commentary to 1997 Amendments explains that an inventorship change in a reissue application is to be effected by filing new reissue oaths or declarations satisfying § 1.175 as amended:

Where a reissue application names an incorrect inventive entity in the executed reissue oath or declaration (whether the reissue application is filed for the sole purpose or in-part to correct the inventorship, or is filed for purposes other than correction of the inventorship), a new reissue oath or declaration in compliance with § 1.175 may be submitted with the correct inventorship without a petition under § 1.48. This is because it is the inventorship of the patent being reissued that is being corrected (via a reissue application). [1997 Amendments at 53,137, 1203 Off. Gaz. Pat. & Trademark Office at 68.]

Furthermore, § 1.175 as amended replaced the verified statement of facts previously required by § 1.48(a)(1) to establish that the inventorship error arose "without any deceptive intention" with a simple statement to that effect:

Section 1.175 relating to the content of the reissue oath or declaration (MPEP 1414), as well as §§ 1.48 and 1.324 relating to correction of inventorship in

¹⁶ The previous title was "Correction of inventorship."

an application and in a patent, respectively, are amended to remove the requirement for a factual showing relating to a matter in which a lack of deceptive intent must be established. A statement as to a lack of deceptive intent is sufficient to meet the statutory requirement under 35 U.S.C. 251 of a lack of deceptive intent relating to the error(s) to be corrected by reissue, and a factual showing of how the error(s) to be corrected by reissue arose or occurred is not required. [1997 Amendments at 53,165, 1203 Off. Gaz. Pat. & Trademark Office at 92.]

However, it is clear from the commentary this policy of relaxing the evidentiary requirements is based on ex parte rather than inter partes considerations:

As the Office no longer investigates fraud and inequitable conduct issues[] and a reissue applicant's statement of a lack of deceptive intention is normally accepted on its face (See MPEP 1448), the requirement in former § 1.175(a)(5) that it be shown how the errors being relied upon arose or occurred without deceptive intent on the part of the applicant appears to be unduly burdensome upon applicants and the Office, and is deleted. [1997 Amendments at 53,165, 1203 Off. Gaz. Pat. & Trademark Office at 92.]

This description of PTO practice ignores the fact that the inter partes nature of interference proceedings currently permits the Board to consider fraud and inequitable conduct

issues raised during an interference. Consideration of Fraud and Inequitable Conduct in Patent Interferences Cases, 1132 Off. Gaz. Pat. Office 33 (Nov. 19, 1991); Interference Practice: Consideration of Fraud and Inequitable Conduct, 1133 Off. Gaz. Pat. Office 21 (Dec. 10, 1991).¹⁷ That this relaxation of evidentiary requirements with respect to deceptive intent stems from the difficulties encountered in gathering and evaluating evidence in an ex parte proceeding is even more evident from the following explanation of why these requirements were relaxed in § 1.48 with respect to nonreissue applications:

For those situations where there was deceptive intent, the Office is lacking certain necessary tools for a thorough inquiry (e.g., subpoena authority) to

¹⁷ Compare Tropix Inc. v. Lumigen Inc., 53 USPQ2d 2018, 2021 (Bd. Pat. App. & Int. 2000) ("Inequitable conduct is becoming altogether too routine in interference cases. The statute (35 U.S.C. § 135(a)) gives the board jurisdiction over priority and patentability. A plausible argument can be made that inequitable conduct is neither priority nor patentability; rather, inequitable conduct is an equitable issue. See Gardco Mfg. v. Herst Lighting Co., 820 F.2d 1209, 1212, 2 USPQ2d 2015, 2018 (Fed. Cir. 1987) (defense of inequitable conduct is equitable in nature). We decline at this time to resolve the argument. Rather, at this time we exercise our discretion to determine when inequitable conduct may be raised.").

ascertain the truth thereof (as in other situations under §§ 1.28 and 1.56). However, the inquiry cannot be waived by the Office due to the statutory requirement under 35 U.S.C. 116. There is no other reasonable course of action than to accept as an explanation for the execution of a § 1.63 oath or declaration setting forth an erroneous inventive entity that the inventor did not remember the contribution of the omitted inventor at the time the oath or declaration was executed (absent subpoena power and inter partes [sic] hearings), and therefore further inquiries into the matter other than a statement of lack of deceptive intent are a waste of Office resources. [62 Fed. Reg. at 53,138, 1203 Off. Gaz. Pat. & Trademark Office at 69.]

The foregoing concerns are clearly inapposite to an inter partes interference proceeding, which affords a party an opportunity to, inter alia, (1) cross-examine an opponent's § 1.634 affiants or declarants pursuant to § 1.672(d), (2) request permission under § 1.639(c)-(f) to obtain direct testimony from others, including the opponent, in order to oppose a § 1.634 motion, and obtain a subpoena pursuant to 35 U.S.C. § 24 and 37 CFR § 1.671(g). We therefore hold that despite the 1997 amendments to § 1.175, an interference party moving under § 1.634 to correct the inventorship in a reissue application during an interference proceeding is required to

support the motion with evidence establishing that the error in inventorship occurred without any

deceptive intention. The appropriate quantum of proof for such a motion is a preponderance of the evidence. Compare Bruning v. Hirose, 161 F.3d 681, 48 USPQ2d 1934 (Fed. Cir. 1998) (holding that during an interference involving a patent issued from an application that was copending with the interfering application, the appropriate standard of proof for validity challenges is the preponderance of the evidence standard).

2. The merits of Seifert's § 1.634 motion

Seifert's reissue application when filed was not accompanied by a reissue oath or declaration by any of the three individuals named as inventors in the patent, i.e., Seifert, Downey, and Shank. Instead, their reissue declarations¹⁸ were filed in response to a "NOTICE TO FILE MISSING PARTS OF APPLICATION - FILING DATE GRANTED."¹⁹ These

¹⁸ Part of Paper No. 4 in the reissue application. These declarations are not included in either party's record for final hearing.

¹⁹ Paper No. 3 in the reissue application.

initial reissue declarations, which allege that the original patent is inoperative for claiming less than the patentees had a right to claim by reciting the extension wire limitations, are addressed infra in our discussion of the § 251 unpatentability issue.

Seifert's § 1.634 motion,²⁰ filed for the purpose of adding Robert M. Scribner as an inventor, was accompanied by second declarations by Seifert (SR 29-33²¹), Downey (SR 25-28²²), and Shank (SR 21-24²³), a first declaration by Scribner (SR 13-15²⁴) with an attached sketch (SR 16),²⁵ and a supporting declaration by non-inventor Jon McIntyre (SR 17-20²⁶), all attesting to the existence of the inventorship error. In his Decisions on Motions (at 11-15), the APJ (at 11-15) faulted Scribner's declaration for failing to explain the error in the

²⁰ Paper No. 33.

²¹ Exhibit A to the motion.

²² Exhibit B to the motion.

²³ Exhibit C to the motion.

²⁴ Exhibit E to the motion.

²⁵ Exhibit F to the motion.

²⁶ Exhibit D to the motion.

patent claims, as required by §§ 1.175(a) and (a)(3), and set a one-month period for the filing of a supplemental Scribner declaration, which was filed on March 6, 1996 (SR 10-12). That supplemental declaration and Dance's motion to strike it or hold it non-responsive are addressed infra in our discussion of the § 251 unpatentability issue.

Dance argues that the § 1.634 motion should be dismissed as untimely because it was filed twenty-two days after the October 3, 1994, due date²⁷ for preliminary statements (Opposition²⁸ at 3). This argument is unconvincing, because a § 1.634 motion can be filed at any time during an interference. See Schulze, 136 F.3d at 788, 45 USPQ2d at 1771 ("In dismissing the motion to correct inventorship, the APJ stated that '[t]he parties are reminded that a motion under 37 C.F.R. § 1.634, since it is not a preliminary motion, can be filed or refiled at any appropriate time in an interference'). In any event, as already noted, it is necessary to decide the inventorship question during this interference because Seifert appears to be in possession of

²⁷ See Paper No. 22.

²⁸ Paper No. 35.

all of the relevant facts. Schulze, 136 F.3d at 791, 45 USPQ2d at 1774.

Dance's objection that the motion was not accompanied by the written consent of the assignee (Opp. at 1) is now moot due to the subsequent filing of that consent.²⁹ Likewise, Dance's objection that Scribner's (first) declaration fails to address the alleged "error" is moot in view of the filing of Scribner's supplemental declaration (SR 10-12).

Dance next contends that the declarations show Scribner to be the sole inventor of the subject matter of the count: "A review of the declarations filed in support of this motion leaves one with the impression that the only inventor of the subject matter of 'the 061 [sic, the '061] patent is the person whose name is to be added, i.e., Robert M. Scribner" (Opp. at 2). Assuming for the sake of argument that Dance is correct on this point, he is incorrect to argue that this result is contrary to having Seifert, Downey, Shank, and Scribner named as joint inventors in the reissue application. Where, as here, the application in question includes claims

²⁹ Paper No. 8 in the reissue application.

(here Seifert's reissue application claims 2-30) which are not designated as corresponding to the count, the inventors who are not named as inventors of the subject matter of the count are presumed to have contributed to the subject matter of those claims. Compare Larson v. Johenning, 17 USPQ2d 1610, 1614 (Bd. Pat. App. & Int. 1991):

[I]n an interference such as this where all of the claims of Larson et al have been designated as corresponding to the count, all of the joint applicants must prima facie be deemed to be coinventors of the subject matter of the count. . . . Cf. Vanderkooi v. Hoeschele, 7 USPQ2d 1253, 1256 (BPAI 1987).

Furthermore, this conclusion is supported by the unrebutted declaration testimony of Seifert (SR 29, ¶ 5; SR 30, ¶ 5³⁰), Downey (SR 25, ¶ 6), and Shank (SR 21-22, ¶ 6), who assert they each contributed to at least the feature of making the guidewire with a reduced diameter in the region of the balloon, as recited in reissue application claim 2, which is not designated as corresponding to the count.³¹

³⁰ Numeral 5 is used to identify two different paragraphs at pages 29 and 30.

³¹ Claim 2 reads: "A dilatation catheter and guidewire as in claim 1 wherein the guidewire shaft, in the region of the balloon, is of a reduced diameter."

For the foregoing reasons, Seifert's § 1.634 motion to add Scribner as a coinventor in the reissue application is granted.

G. Whether Seifert's reissue claims 31-35 are unpatentable under 35 U.S.C. § 251

Seifert's claim 31, which is the only independent claim of involved reissue claims 31-35, is broader than Seifert's original independent patent claims 1, 14, and 23 in several respects, of which Dance focuses on the omission of the extension wire limitations, i.e., the "means for attaching an extension wire to the proximal end of the guidewire,"

recited in claims 1³² and 14, and the "connector element at the proximal end of the guidewire adapted to be connected to an

³² Seifert's patent claim 1 and reissue application claim 1 read as follows:

1. A dilatation catheter and guidewire comprising:

an elongate flexible catheter shaft having a proximal end, a distal end, a guidewire lumen and an inflation lumen;

a dilatation balloon mounted on the distal end of the shaft with the inflation lumen being in communication with the interior of the balloon;

a guidewire extending through the guidewire lumen, the guidewire comprising a shaft adapted to extend fully through the guidewire lumen and a flexible distal segment affixed to the distal end of the guidewire shaft, the flexible distal segment extending distally beyond the distal end of the catheter shaft;

means for attaching an extension wire to the proximal end of the guidewire; and

means for releasably locking a proximal portion of the guidewire to the proximal portion of the catheter;

the guidewire lumen being larger in diameter than the outer diameter of any portion of the guidewire shaft proximal to the flexible distal segment; and

the locking means, when locked, allowing the guidewire to be rotated relative to the catheter while preventing relative axial movement between the guidewire and the catheter, and when unlocked, allowing the guidewire to be rotated and advanced independently of the catheter. [Emphasis added.]

extension wire," recited in claim 23. Dance argues that the omission of these extension

wire features from the reissue claims makes them unpatentable under 35 U.S.C. § 251 (a) for containing new matter and (b) for recapturing subject matter surrendered during prosecution of the original patent.³³

Each of the initial reissue declarations by Seifert, Downey, and Shank³⁴ contain the following explanation of the alleged error in claim scope:

[T]he claims of the original patent include limitations that are not necessary to the patentability thereof. Independent Claims 1 and 14 recite "means for attaching an extension wire to the proximal end of the guidewire;...", and claim 23 recites "a connector element at the proximal end of the guidewire adapted to be connected to an extension wire;...". I realized, after issuance of this patent, that neither the means for attaching an extension wire to the proximal end of the guidewire, nor a connector element at the proximal end of the guidewire adapted to be connected to an extension wire are essential for practising

³³ The reissue application was filed within two years of the issue date of the original patent, as is necessary to obtain broader claims. 35 U.S.C. § 251, last paragraph.

³⁴ Reissue application paper No. 4.

[sic] the broad teachings of the invention disclosed in the specification of the patent. On information and belief, our attorney, Arthur Z. Bookstein, was unaware of the non-essential nature of those limitations and, therefore, did not realize the true scope of the invention.

A similar assertion appears in the supplemental declaration by Scribner, at SR 10-11. No supporting declaration was filed by Bookstein, although Seifert's brief for final hearing states that "should it become necessary or desirable to do so, such a declaration can and will be furnished" (S.Br. 17).

**1. Dance's motion to strike
Scribner's supplemental reissue declaration**

Dance has moved³⁵ under § 1.633 (sic, 1.635) to strike Scribner's supplemental declaration (SR 10-12) or hold it non-responsive for "insufficiently describing any perceived 'errors'" (Motion at 1). This motion is denied on the ground that the sufficiency of Scribner's supplemental declaration in this regard goes to its weight rather than its admissibility. Compare Hollins v. De Petris, 201 USPQ 871, 873 (Bd. Pat. Int. 1977) (assertion that evidence relates to a device that

³⁵ Paper No. 51.

does not satisfy all of the limitations of the count goes to weight rather than admissibility).

2. Dance's motion to strike the initial reissue declarations of Seifert, Downey, and Shank

On March 24, 2000, which is five and one-half months after the oral hearing, Dance filed a motion³⁶ to strike the initial reissue declarations of Seifert (SR 29-33), Downey (SR 25-28), and Shank (SR 21-24) on the ground that the following statement therein constitutes inadmissible hearsay: "On information and belief, our attorney, Arthur Z. Bookstein, was unaware of the non-essential nature of those limitations and, therefore, did not realize the true scope of the invention."³⁷ Because this hearsay objection does not affect the other statements in the declarations, the motion is hereby denied to the extent it seeks to strike the declarations in their entirety.

Although this motion does not purport to be a motion to suppress evidence pursuant to § 1.656(h), it shall be

³⁶ Paper No. 94.

³⁷ Dance has not moved to strike Scribner's supplemental declaration, which contains a similar statement at SR 10-11, on this ground.

treated as such, because a motion under that rule is required where a party seeks a ruling on the admissibility of evidence. See § 1.656(h) (1999) ("If a party wants the Board in rendering its final decision to rule on the admissibility of any evidence, the party shall file with its opening brief an original and four copies of a motion (§ 1.635) to suppress the evidence."). Because under this rule Dance should have filed the motion on September 29, 1997, with his opening brief, the motion will be considered only if Dance has shown "good cause" under § 1.645(b) for its belatedness. Dance argues that the motion should be considered timely because "it was only from and after that October 14, 1999, hearing date that it was absolutely clear that no further declaration from Attorney Bookstein would ever be submitted" (Motion at 4). This argument is unpersuasive because Dance knew as of the due date for his opening brief, which was subsequent to the close of Seifert's testimony period, that no Bookstein declaration had been filed. Dance also offers a jurisdictional argument for timeliness:

There is yet a further reason why this motion should be considered and granted[,]
viz., it goes fundamentally to the Patent
and Trademark Office jurisdiction with

respect to this interference. But for the existence of the reissue proceeding which party Dance has now demonstrated was defectively granted, the Patent and Trademark Office had no subject matter jurisdiction to adjudicate this interference. In accordance with Federal Rule of Civil Procedure 12(h)(3) issues relating to jurisdiction are never waived. [Motion at 5.]

We have jurisdiction over this interference if it was "properly declared" under 35 U.S.C. § 135(a), In re Gartside, 203 F.3d 1305, 1316-18, 53 USPQ2d 1769, 1776-78 (Fed. Cir. 2000); Guinn v. Kopf, 96 F.3d 1419, 1421-22, 40 USPQ2d 1157, 1159-60 (Fed. Cir. 1996), cert. denied, 520 U.S. 1210 (1997). This interference was properly declared under § 135(a) because (1) Seifert's reissue application was a "pending application" under 37 CFR § 1.601(i)³⁸ at the time the declaration notice was mailed, and (2) the examiner, prior to declaration of the

³⁸ Section 1.601(i) reads in pertinent part: "An interference may be declared between two or more pending applications naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention. An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an examiner, any application and any unexpired patent contain claims for the same patentable invention." Compare Petrie v. Welsh, 21 USPQ2d 2012, 2013 (Bd. Pat. App. & Int. 1991) (board lacks subject matter jurisdiction in an interference that was declared between an application and an expired patent).

interference, determined that reissue application claims 31-35 are allowable, as evidenced by his Initial Interference Memorandum (PTO-850),³⁹ which identifies these claims as "allowable." See Perkins v. Kwon, 886 F.2d 325, 327 & n.2, 12 USPQ2d 1308, 1309-10 & n.2 (Fed. Cir. 1989):

The determination that Kwon's application contained patentable subject matter was made, in the first instance, ex parte before the interference was declared. That was the practice before the consolidation of the two boards and other changes in interference rules, 37 C.F.R. §§ 1.201 et seq. (1984), and continues to be the practice. 37 C.F.R. §§ 1.601 et seq. (1985).² In this case . . . the reason for unpatentability of the subject matter to Kwon was not known to the examiner until it

was raised by Perkins' motion after the interference was declared. . . .

² The Commissioner states that the prior practice as well as that here debated was and is within the Commissioner's discretion, pointing out that 35 U.S.C. § 135(a) never required a determination of patentability to any potential party before an interference was declared. We discern no substantiation for the existence of such discretion, for this threshold determination has been judicially and administratively recognized for decades.

³⁹ Attached to paper No. 1 in interference file.

The Court in Brenner v. Manson, 383 U.S. 519, 528 n.12, 148 USPQ 689, 693 n.12 (1966) noted: "'The question as to patentability of claims to an applicant must be determined before any question of interference arises and claims otherwise unpatentable to an applicant cannot be allowed merely in order to set up an interference.'" (quoting In re Rogoff, 261 F.2d 601, 606, 120 USPQ 185, 188 (CCPA 1958)). No change in this practice was made in the 1984 enactment that consolidated the boards, and the implementing regulations and procedure continue to require the presence of subject matter patentable to each applicant before an interference is declared. 37 C.F.R. §§ 1.603 and 1.606 (1988); Manual of Patent Examining Procedure §§ 2307.02 and 2308.02 (5th ed. 1983 & 1988 rev. 9).

Where, as here, an interference has been properly declared under 35 U.S.C. § 135(a), a determination of unpatentability made during the interference will result in the entry of judgment against the affected claims pursuant to 37 CFR § 1.658(a).

Consequently, Dance's jurisdictional argument for timeliness also fails.

Dance's motion to strike is therefore dismissed for failing to demonstrate "good cause" for its belatedness.

3. The effect, if any, of the absence of a supporting affidavit or declaration by Bookstein

Dance argues that Bookstein's declaration is required by the reissue statute because he "is the one person who most likely had direct, personal knowledge of all of the requisite facts" (D.Br. 14). However, Dance has not cited, nor are we aware of, any requirement in that statute, the implementing rules (§§ 1.171-1.179), or the case law to the effect that an allegation of error in claim scope must be supported by an affidavit or declaration from the attorney who prepared and filed the original patent application and/or reissue application. Even prior to the liberalizing December 1997 amendments to § 1.175, affidavits or declarations were required from only the reissue applicants themselves. See 1.175(a) (1996) ("Applicants for reissue, in addition to complying with the requirements of § 1.63, must also file with their applications a statement under oath or declaration as follows: . . ."). Corroborating affidavits or declarations by other individuals were necessary

only when required by an examiner. See § 1.175(b) (1996) ("Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object."). Here, the examiner determined prior to declaration of the interference that the initial declarations by Seifert, Downey, and Shank were sufficient to demonstrate error without deceptive intention without the need for an affidavit or declaration by Bookstein. Consequently, Seifert's failure to file such an affidavit or declaration did not violate § 1.175.

Because the sufficiency of Seifert's showing of error without deceptive intention must be determined from the evidence on which Seifert relies, we need not address Dance's speculation (D.Br. 15 n.1) about Seifert's reasons for not providing an affidavit or declaration by Bookstein.

4. The "lack of appreciation" argument

Dance contends the initial reissue declarations by Seifert, Downey, and Shank and the supplemental declaration by Scribner fail to establish that the invention recited in

reissue application claims 31-35, which omit the extension wire limitations recited in the original patent claims, was recognized by the inventors prior to issuance of Dance's patent (which issued after Seifert's '061 patent):

If Mr. Bookstein and none of the inventors appreciated the true scope of the invention where can there possibly be the basis for the proposed reissue which will not introduce new matter, contrary to 35 U.S.C. § 251. Further, it is submitted that the true scope of an invention [i.e., the invention recited in claims 31-35] (as contrasted with the Seifert invention) was not apparent until the Dance patent issued. This is not and cannot be the purpose or intent of either the reissue or the interference procedures. The absence of Attorney Bookstein's declaration is merely additional support for Dance's position that Seifert et al. did not invent that which they hope to obtain through the reissue/interference. [D.Br. 15.]

This argument is unpersuasive because the failure of the inventors and their attorney to appreciate the true scope of an invention prior to issuance of the original patent is a type of "error" correctable by reissue. See C.R. Bard Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1354, 48 USPQ2d 1225, 1234 (Fed. Cir. 1998), cert. denied, 526 U.S. 1130 (1999):

An inventor's failure to appreciate the scope of an invention at the time of the original patent grant, and thus an initial

intent not to claim the omitted subject matter, is a remediable error. See In re Amos, 953 F.2d 613, 619, 21 USPQ2d 1271, 1276 (Fed. Cir. 1991) (reissue application not subject to rejection for failure to demonstrate initial intent to claim, when subject matter of reissue claims satisfies § 112 requirements); In re Weiler, 790 F.2d 1576, 1581, 229 USPQ 673, 676-77 (Fed. Cir. 1986) ("intent to claim" is shorthand for a means of measuring whether required error is present); In re Hounsfeld, 699 F.2d 1320, 1322, 216 USPQ 1045, 1048 (Fed. Cir. 1983) (lack of "intent to claim" is only one factor to be considered).

See also Hester Indus. Inc. v. Stein Inc., 142 F.3d 1472, 1479-80, 46 USPQ2d 1641, 1647 (Fed. Cir.), cert. denied, 525 U.S. 947 (1998), which specifically addresses broadening reissue claims:

One of the most commonly asserted "errors" in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application. See [In re] Amos, 953 F.2d [613,] 616, 21 USPQ2d [1271,] 1273 [(Fed. Cir. 1991)]; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See [In re] Clement, 131 F.3d [1464,] 1468, 45 USPQ2d [1161,] 1163 [(Fed. Cir. 1997)]; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Nevertheless, Hester held that an allegation of this type of error can be negated by a prosecution history which reveals a heavy reliance on the omitted features to obtain issuance of the original patent claims, 142 F.3d at 1480-84, 46 USPQ2d at 1647-51, a concern the court indicated "is addressed most squarely by the 'recapture rule,' recently discussed at length in [In re] Clement, 131 F.3d 1464, 45 USPQ2d 1161 [(Fed. Cir. 1997)]." Hester at 1480, 46 USPQ2d at 1647. Consequently, the question of whether Seifert's reliance on the extension wire limitations to obtain allowance of the original patent claims undercuts his claim of "error" is addressed below in the discussion of Dance's "recapture" argument, which follows the discussion of his "new matter" argument.

5. The "new matter" argument

Dance's "new matter" argument is being treated as based on the requirement of § 251 that the reissue claims be directed to "the invention disclosed in the original patent." This inquiry is analogous to the written description requirement of 35 U.S.C. § 112, first paragraph:

"[T]he essential inquiry under the 'original patent' clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the

subject matter of the new claims as invented and disclosed by the patentees." [Amos] at 618, 21 USPQ2d at 1275. The court noted that this inquiry is analogous to the "written description" requirement of 35 U.S.C. § 112 ¶ 1 (1994)."

Hester, 142 F.3d at 1484, 46 USPQ2d at 1651. Amos explains that this is an objective inquiry made from the standpoint of one skilled in the art:

[T]he inquiry that must be undertaken to determine whether the new claims are "for the invention" originally disclosed, to paraphrase [In re] Rowand, [526 F.2d 558, 187 USPQ 487 (CCPA 1975)] is to examine the entirety of the original disclosure and decide whether, through the 'objective' eyes of the hypothetical person having ordinary skill in the art, an inventor could fairly have claimed the newly submitted subject matter in the original application, given that the requisite error has been averred. [953 F.2d at 618, 21 USPQ2d at 1275.]

However, it is not enough to show that the broadened reissue claim reads on the disclosed structure. See Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998) ("It is a truism that a claim need not be limited to a preferred embodiment. However, in a given case, the scope of the right to exclude may be limited by a narrow disclosure."). Gentry Gallery held there was no written

description support for a claim which recited "a pair of control means, one for each seat[,] mounted on the double reclining seat sofa section"⁴⁰ without also specifying that the control means are mounted on the claimed "console." As explained in Johnson Worldwide Associates Inc. v. Zebco Corp., 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999), Gentry Gallery's "determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element--the 'control means'--as 'the only possible location' and that variations were 'outside the stated purpose of the invention.'"

Specifically, Gentry Gallery held that

the original disclosure clearly identifies the console as the only possible location for the controls. It provides for only the most minor variation in the location of the controls, noting that the control "may be mounted on top or side surfaces of the console rather than on the front wall . . . without departing from this invention." '244 patent, col. 2, line 68 to col. 3, line 3. No similar variation beyond the console is even suggested. Additionally, the only discernible purpose for the

⁴⁰ This claim language appears in 134 F.3d at 1475, 45 USPQ2d at 1499.

console is to house the controls. As the disclosure states, identifying the only purpose relevant to the console, "[a]nother object of the present invention is to provide . . . a console positioned between [the reclining seats] that accommodates the controls for both of the reclining seats." Id. at col. 1, ll. 33-37. Thus, locating the controls anywhere but on the console is outside the stated purpose of the invention. Moreover, consistent with this disclosure, Sproule's broadest original claim was directed to a sofa comprising, inter alia, "control means located upon the center console to enable each of the pair of reclining seats to move separately between the reclined and upright positions." Finally, although not dispositive, because one can add claims to a pending application directed to adequately described subject matter, Sproule admitted at trial that he did not consider placing the controls outside the console until he became aware that some of Gentry's competitors were so locating the recliner controls. Accordingly, when viewed in its entirety, the disclosure is limited to sofas in which the recliner control is located on the console.

(Brackets in original.) 134 F.3d at 1479, 45 USPQ2d at 1503.

For the following reasons, we are of the view that Seifert's original patent disclosure considered as a whole does not require the use of an extension wire or means for attaching an extension wire, even though the principal disclosed object of Seifert's invention is to allow the

exchange of low-profile catheters without the need to remove the guidewire from the patient, as evidenced by the following passages in the '061 patent:

- This invention relates to percutaneous transluminal angioplasty and to a low profile balloon catheter and guidewire system which allows exchange of the catheter while the guidewire remains at a selected location. [FIELD OF THE INVENTION, at col. 1, lines 6-9.]
- There is a need . . . for a catheter that has the low profile advantages of a fixed guidewire catheter, but which enables catheter exchanges to be performed without losing guidewire position. It is an object of the present invention to provide such a catheter arrangement. [BACKGROUND OF THE INVENTION, at col. 2, lines 47-52.]
- The present invention provides a catheter system employing the combination of a low profile, multi-lumen dilatation catheter having the low profile and handling characteristics of fixed guidewire catheters, yet which enables catheter exchanges to be performed over an extendably [sic] guidewire. [SUMMARY OF THE INVENTION, at col. 2, lines 55-60.]
- It is among the general objects of the invention to provide a balloon dilatation catheter system that has the low profile advantages of a fixed wire system yet which also permits a catheter exchange to be performed without losing guidewire position. [SUMMARY OF THE INVENTION, at col. 3, lines 57-61.]

"Fixed wire" operation is achieved with the use of a releasable locking mechanism (lockable element 26, including threaded end cap 58 and compressible bushing 27), which in locked condition prevents axial movement of the guidewire relative to the locking mechanism and the catheter, while allowing rotation (via rotating joint 50) of the locking mechanism and guidewire together relative to the catheter for steering purposes (col. 4, line 39 to col. 5, line 17). When the locking mechanism is in the unlocked position, the guidewire can be moved both axially and rotationally with respect to the locking mechanism and the catheter (col. 5, lines 1-3), providing "over the wire" operation. The catheter is able to be withdrawn from the patient while leaving the guidewire in place because the diameter of the guidewire lumen 14 (Fig. 2) is larger than the outer diameter of any portion of the guidewire shaft proximal to the flexible distal tip portion 28 of the guidewire (col. 6, lines 35-38).⁴¹

⁴¹ As is apparent from Figure 2 of the patent, the diameter of tip portion 28 of the guidewire is too great to permit the guidewire to be withdrawn from the patient while leaving the catheter in place; instead, the tip portion diameter is preferably selected to be approximately equal to the outside diameter of the catheter in order to avoid a discontinuity that could inhibit catheter movement (col. 6, lines 43-54).

The parties are at odds over whether Seifert's disclosed catheter exchange operation would have been understood as requiring attachment of an extension wire to the guide wire, as shown in Seifert's Figure 3. As evidence that an extension wire is not required, Seifert cites Nanto (JR 35-38) and Hoorntje (JR 29-34).⁴² To show that Seifert's reliance on these articles is misplaced, Dance⁴³ cites a declaration by Fleischhacker (JR 3-6), which Seifert has moved to suppress.⁴⁴ We need not decide these matters, because we agree with Seifert's other argument that the artisan would have understood that the releasable locking means has a disclosed utility which is independent of permitting a catheter exchange. More particularly, the specification explains that "[w]hen unlocked, the guidewire 20 can be rotated and advanced independently of the catheter" (col. 5, lines 17-18), which

⁴² Dance correctly notes that only Hoorntje has a publication date (1989) earlier enough to make it available as prior art with respect to Seifert's reissue claims. Nanto was published in 1994.

⁴³ D.Br. 18.

⁴⁴ Paper No. 77.

clearly refers to the initial insertion of the guidewire and catheter into the patient without regard to whether a catheter exchange is to be performed. This feature is also described in the following passage, which follows a discussion of catheter exchange: "The present system also allows independent wire movement and excellent steerability while providing the option of sealingly locking the guidewire and catheter together to allow operation as a single unit" (col. 7, lines 34-38). The separate utility of this steerability feature is also apparent from its description as a separate object of the invention: "Another object of the invention is to provide a catheter system including a balloon dilatation catheter and a steerable guidewire in which the guidewire may be manipulated independently of the catheter or may be manipulated, as a unit, together with the catheter" (col. 3, lines 62-66). We therefore agree with Seifert that the artisan would have understood the following paragraph in the patent to mean that the catheter exchangeability feature is an optional aspect of the "second" (i.e., unlocked) mode of operation of the disclosed device:

In one mode of operation, the catheter and guidewire are locked together at their

proximal ends so that both can be manipulated and steered together. Then [sic] operated in this manner, the system operates as a fixed wire dilatation catheter. In a second mode of operation, the catheter and guidewire are not locked together, and the guidewire can be manipulated independently of the catheter. In this second mode of operation, the guidewire can be extended at its proximal end and the catheter exchanged for another catheter while maintaining the position of the distal end of the guidewire in the stenosis. [Emphasis added.] [Col. 3, lines 38-49.]

For the foregoing reasons, Dance has failed to prove that Seifert's reissue claim 31 is unpatentable under 35 U.S.C. § 251 for containing new matter, i.e., for failing to recite "the invention disclosed in the original patent." The same result applies to dependent claims 32-35, which are not separately argued by Dance.

6. The "recapture" argument

The rule against recapture is described as follows in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164:

The recapture rule . . . prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor [Corp. v. Coloplast, Inc.,] 998 F.2d [992,] 995, 27 USPQ2d [1521,] 1524 [(Fed. Cir. 1993)]. Under this rule, claims that are "broader than

the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution' are impermissible." Id. at 996, 998 F.2d 992, 27 USPQ2d at 1525.

It is undisputed that Seifert's reissue claim 31, by omitting the extension wire limitations, is broader than the original patent claims. It is therefore necessary to determine whether this broader aspect of the disclosed invention was surrendered during prosecution. Because Seifert, during the prosecution of the original patent claims, never presented a claim which failed to include the extension wire limitations at issue, it is necessary to determine whether Seifert surrendered the broad subject matter through argument alone. See Hester at 1482, 46 USPQ2d at 1649 ("in a proper case, a surrender can occur through arguments alone"). Hester held that repeated arguments by reissue applicant Williams to overcome a prior art rejection amounted to such a surrender:

Williams repeatedly argued that the "solely with steam" and "two sources of steam" limitations distinguished the original claims from the prior art. These were Williams' primary bases for distinguishing the broadest claim, independent claim 1, from the prior art. At no less than 27 places in six papers submitted to the

Patent Office, Williams asserted that the "solely with steam" limitation distinguished the claimed invention from the prior art, and Williams did the same with respect to the "two sources of steam" limitation at no less than 15 places in at least five papers.

Williams argued that each of these limitations was "critical" with regard to patentability, and Williams further stated that the "solely with steam" limitation was "very material" in this regard. In essence, these repeated arguments constitute an admission by Williams that these limitations were necessary to overcome the prior art. Indeed, when the Board reversed the Examiner's rejection of the original claims, these were the primary bases indicated for patentability. Williams, through his admission effected by way of his repeated prosecution arguments, surrendered claim scope that does not include these limitations.

142 F.3d at 1482, 46 USPQ2d at 1649.

In our view, Seifert did not make any arguments during prosecution which "evidence an admission sufficient to give rise to a finding of surrender." Hester at 1481, 46 USPQ2d at 1648. The only rejection made during prosecution of the original patent was a rejection⁴⁵ of original patent claims 1-11, 14-17, and 20 as unpatentable over Samson et al.

⁴⁵ Paper No. 5 in the '061 patent file, at 2-4.

(Samson)⁴⁶ in view of Taylor et al. (Taylor),⁴⁷ Willard et al. (Willard),⁴⁸ and Levy.⁴⁹ The examiner cited Samson as disclosing all of the claimed elements except (a) the "means for attaching an extension wire," for which he cited Taylor and (b) the "means for releasably locking," for which he cited Willard. In our view, Seifert's response⁵⁰ to the rejection of claim 1 does not evidence an admission sufficient to give rise to a finding that Seifert surrendered the invention recited in the reissue claims. Seifert's principal argument in response to the rejection is that Samson does not, as apparently believed by the examiner, disclose a catheter which is removable from the guidewire, as required by claim 1's recitation of a "guidewire lumen . . . larger in diameter than the outer diameter of any portion of the guidewire shaft proximal to the flexible distal segment" (28 in Fig. 2) and that the other references, including Taylor (which discloses

⁴⁶ U.S. Patent No. 4,616,653.

⁴⁷ U.S. Patent No. 4,827,941.

⁴⁸ U.S. Patent No. 4,846,174.

⁴⁹ U.S. Patent No. 4,490,421.

⁵⁰ Amendment received February 19, 1991 (Paper No. 7 in the '061 patent file).

an extension wire), fail to suggest modifying Samson to have a removable catheter, as such a modification would have the effect of rendering Samson inoperable for its intended purpose (Amendment at 6-7). Seifert's next argument in response to the rejection is that Willard's locking means does not operate in the manner required by claim 1 (Amendment at 7-8). Seifert also argues that because it would have been unobvious to make Samson's catheter removable from the guidewire, it would have been unobvious to employ Taylor's extension wire in either the Samson device or the proposed Samson/Willard device (Amendment at 8-9). In contrast to Williams' arguments in Hester, Seifert does not characterize (let alone repeatedly characterize) the extension wire limitation as either critical or essential to the disclosed invention.

Consequently, we are not persuaded that Seifert's reissue claim 31 or any of its dependent claims 32-35 is unpatentable under 35 U.S.C. § 251 for violating the recapture rule.

H. Dance's Certificate of Correction of claim 1

By way of background, during the preliminary motion period, Seifert filed a § 1.633(a) motion⁵¹ alleging that Dance's involved patent claims 1-4 and 8 are unpatentable under 35 U.S.C. § 112, ¶ 1 (written description and enablement requirements) because claim 1 specifies that the "releasably engaging means" and the "rotating means" are "attached to" the guidewire, whereas Dance's drawings and specification show and describe these means mounted on the catheter body. Dance's opposition⁵² (at 2), which characterized this discrepancy as a "clerical error" in the claim, was accompanied by a request for issuance of a Certificate of Correction to amend the claim to specify that the "releasably engaging means" and the "rotating means" are attached to the catheter body. Because

⁵¹ Seifert Motion I (Paper No. 11).

⁵² Paper No. 18.

the request was not accompanied by a § 1.635 motion, as required by 37 CFR § 1.323,⁵³ the APJ⁵⁴ authorized the filing of such a motion, which was filed,⁵⁵ followed by an opposition by Dance.⁵⁶ The APJ addressed the merits of Seifert's § 1.633(a) motion and Dance's § 1.635 motion in his Decisions on Motions, wherein he (a) denied Seifert's motion to the extent it is based on the written description requirement of § 112, ¶ 1, (b) granted it to the extent it is based on the enablement requirement of that paragraph, and (c) granted it to the extent it was implicitly based on § 112, ¶ 2.⁵⁷ In his Decision on Reconsideration (at 3-4), however, he denied the motion in all respects, which decision Seifert does not challenge at final hearing.

⁵³ Section 1.323 reads in pertinent part: "A request for a certificate of correction of a patent involved in an interference shall comply with the requirements of this section and shall be accompanied by a motion under § 1.635."

⁵⁴ Paper No. 21.

⁵⁵ Motion under § 1.635 (Dance Motion IV), Paper No. 25.

⁵⁶ Paper No. 29.

⁵⁷ Decisions on Motions at 3-5.

Regarding Dance's § 1.635 motion for a certificate of correction, the APJ⁵⁸ noted that the Dance patent file inadvertently had been released to Certificates of Correction Branch, which, after obtaining the approval of the examiner,⁵⁹ issued the requested certificate of correction of claim 1 on October 3, 1995.⁶⁰ The APJ: (a) held that without his approval the examiner and Certificates of Correction Branch lacked the jurisdiction to approve or issue the certificate;⁶¹ (b) denied Dance's § 1.635 motion for the certificate on the ground that the proposed correction affects the scope of claim 1 and thus is inappropriate for correction by a certificate of correction;⁶² (c) indicated that he would arrange to have the certificate withdrawn "following a final decision that does not reverse [his] decision on this matter";⁶³ and (d) held that

⁵⁸ Decisions on Motions at 8.

⁵⁹ "NOTICE RE: CERTIFICATES OF CORRECTION," Paper No. 16 in Dance patent file.

⁶⁰ See Certificate of Correction in Dance patent file.

⁶¹ Decisions on Motions at 7.

⁶² Id. at 10.

⁶³ Id.

Dance's involved patent claims are the patent claims as they stood prior to issuance of the certificate of correction.⁶⁴

Dance's only argument in support of the issuance of the certificate is as follows:

The certificate of corrections branch applies the Patent and Trademark Office Rules and policies to issue many hundred[s] of certificates of correction annually. Yet, in this instance, the administrative patent judge has seen fit to interpose his interpretation of those rules and policies even though an actual decision was previously made. Reversal of that decision as an abuse of discretion is earnestly solicited. [D.Br. 19.]

This argument is unconvincing because it (1) overlooks the fact that § 1.323, by requiring an accompanying § 1.635 motion for a request for a certificate of correction of a patent involved in an interference, authorizes only an APJ or a panel of the Board to grant such a request and (2) fails to explain why the error to be corrected is appropriate for correction by a certificate of correction. Consequently, Certificates of Correction Branch will be requested to issue a new Certificate of Correction reinstating patent claim 1 to its original form.

⁶⁴ Id.

I. Judgment

Judgment on the issue of priority is hereby entered against Dance's patent claims that correspond to the count, i.e., Dance's original patent claims 1-4 and 8, which means Dance is not entitled to a patent containing those claims.⁶⁵ Accordingly, judgment on the issue of priority is hereby entered in favor of Seifert et al.'s reissue application claims that correspond to the count, i.e., claims 1 and 31-35, which means that based on the record and arguments before us, Seifert et al. are entitled to a patent containing those claims.

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)	
	_____)	
	WILLIAM F. PATE, III)	
	Administrative Patent Judge))	
)	
)	BOARD
OF)	
	_____)	PATENT
APPEALS)	
	JOHN C. MARTIN)	AND
	Administrative Patent Judge))	INTERFERENCES
)	

⁶⁵ Had we been persuaded of the propriety of entry of the Certificate of Correction of claim 1, we would be entering judgment on priority grounds against claim 1 thus corrected and its dependent claims 2-4 and 8. Dance has not argued, let alone demonstrated, that the claims thus corrected should be designated as not corresponding to the count.

Interference No. 103,379

_____))
MURRIEL E. CRAWFORD)
Administrative Patent Judge)

JCM:psb

Interference No. 103,379

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