

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(2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TSUGUJI TACHIUCHI, HIROYUKI MANO,  
and TERUMI TAKASHI

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Appeal No. 97-0574  
Application 07/650,763<sup>1</sup>

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HEARD: June 9, 1997

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Before HARKCOM, Vice Chief Administrative Patent Judge, and  
LEE and TORCZON, Administrative Patent Judges.

LEE, Administrative Patent Judge.

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Reissue application filed February 5, 1991, to reissue  
Patent No. 4,808,991, granted February 28, 1989, based on  
application 07/002,198, filed January 12, 1987.

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#### DECISION ON APPEAL

The involved application is a reissue application of U.S. Patent No. 4,808,991. This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, 9-18, 24-33 and 38-67, all claims in the reissue application. Claims 1-7 are the same as the original patented claims in U.S. Patent No. 4,808,991.

#### References Relied on by the Examiner

No claim has been rejected as being anticipated or unpatentable over prior art.

#### The Rejection on Appeal

All claims have been finally rejected by the examiner under 35 U.S.C. § 251 (Paper No. 23, at 4).

#### The Invention

The invention is directed to a liquid crystal display and a corresponding display method which is capable of displaying intermediate tones. Claim 9, an added claim in this reissue application, is reproduced below:

9. A method for displaying a display pattern in a plurality of intermediate tones in a liquid crystal display apparatus including a memory means for storing display data and outputting the display data, and a liquid crystal display means supplied with the display data for displaying the display pattern in a plurality of display blocks disposed in a vertical direction

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for each of a plurality of consecutively produced frames, the method comprising the steps of:

controlling the liquid crystal display apparatus to turn off display of the display data in at least one of the display blocks among an N display block unit in each of the frames so as to display the display pattern in each of the intermediate tones, where N is an integer; and

controlling the liquid crystal display apparatus to turn on display of the display data in at least one of the display blocks among the N display block unit in each of the frames so as to display the display pattern in each of the intermediate tones.

#### Opinion

The rejection of all claims under 35 U.S.C. § 251 will be sustained, although only one of the two reasons presented by the examiner for supporting the rejection has merit.

In pertinent part, Section 251, United States Code, states:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, . . . the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent . . . .

With regard to the foregoing, the examiner found that the appellants' reissue declaration<sup>2</sup> is defective for not being in

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During the course of prosecution, the appellants have filed multiple supplemental reissue declarations. The latest one was filed after final rejection, which the examiner, in an advisory Office action mailed July 3, 1995 (Paper No. 27), indicated was considered but did not overcome the outstanding rejection. At oral hearing, the appellants represented that that

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compliance with 37 CFR § 1.175. Two reasons were articulated by the examiner (Paper No. 23, at 3):

(1) the reissue declaration failed to demonstrate that the errors relied upon for the reissue application occurred without deceptive intent as is required by 37 CFR § 1.175(a)(5); and

(2) the reissue declaration failed to particularly specify the errors relied upon and how those errors arose as are required by 37 CFR § 1.175(a)(6).

For the first rationale noted above, the examiner stated in the final rejection (Paper No. 23, at 6):

Applicant has failed to prove that he had intended to claim the invention defined by [new] claims 9-18, 24-33, 38-67 and applicant has failed to prove that the error in the original patent of not claiming claims 9-18, 24-33, and 38-67 was inadvertent. In re Weiler, 229 USPQ 673 (CAFC 1986). Claims 9-18, 24-33, and 38-67 are different in scope than the patented claims and, thus, they are considered to be broader than the patented claims. Applicant has failed to prove that applicant inadvertently claimed less than he may have had a right to claim. In re Hounsfeld[,] 216 USPQ 1045 (CAFC 1983). In association with the act of claiming less in the patented claims than the added claims of this reissue application and the discovery of the Yamaha Model V6355D applicant has failed to prove

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last supplemental reissue declaration was cumulative and included all assertions in previously filed reissue declarations in this case.

Hereinafter, for convenience purposes, we will address only the last supplemental reissue application and refer to it as "the reissue declaration."

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that he intended to claim the broader invention of a liquid crystal display which may display plural tones of display patterns. In re Amos[,] 21 USPQ[2d] 1271, (CAFC 1991). Furthermore, it is noted that in the Summary of the Invention applicants' [sic] expressed that an object of the invention was to display intermediate tones of images. . . . Thus, during the prosecution of the patent application and at the time of patenting the patent application, applicant was fully aware of the differences in scope between the

patented claims and the invention described in the disclosure. By patenting a narrow invention and by describing in the Summary of the Invention of the patent a broader invention, one of ordinary skill in the art would have concluded that applicant had intended to only claim the narrower invention.  
(Emphasis added.)

The examiner's reasoning is misplaced. Certainly, the appellants intended that which was done when it was done, i.e., claiming the invention narrowly. The appellants do not represent that they actually intended to make broader claims when they presented the narrower claims. The point seemingly overlooked by the examiner is that the appellants allege that they erred in not claiming broader subject matter which they had a right to claim.

It is true that the summary part of the specification indicates an object of the invention is displaying intermediate tones of images, which reflects a scope of invention broader than that of the detailed original claims. But that does not mean the appellants knowingly elected to give up, irrevocably, coverage

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broader than that afforded by the narrower claims. However broadly stated an object of the invention is, the object of the invention does not have to be patentable over prior art. Rather, it is only that which is actually claimed which needs to be patentable over prior art. Also, it is usually the patent applicants' appreciation of the state of the prior art which determines what they actually claim. There is no proper basis to

conclude that appellants not claiming more broadly was intentional or deliberate within the meaning of 35 U.S.C. § 251.

Even assuming that there is something inherently inconsistent with having a broad summary of the invention together with more detailed claims, which there is not, the Federal Circuit's decision in In re Amos, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991) is instructive on the issue concerning the presence or absence of an "intent to claim." Quoting In re Mead, 581 F.2d 251, 256, 198 USPQ 412, 417 (CCPA 1978), the Federal Circuit in Amos, 953 F.2d at 617, 21 USPQ2d at 1274, stated:

Thus, in Rowand and similar cases, "intent to claim" has little to do with "intent" per se, but rather is analogous to the requirement of § 112, first paragraph that the specification contain a "written description of the invention, and of the manner and process of making and using it." It is, as appellant urges,

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synonymous with "right to claim." (Emphasis in original.)

The Federal Circuit further stated in Amos, 953 F.2d at 618, 21 USPQ2d at 1274-1275:

Hence, the purpose of the rubric "intent to claim" is to ask the same question as to whether "new matter" has been introduced into the application for reissue" thus, perforce, indicating that the new claims are not drawn to the same invention that was originally disclosed. . . . We agree with, and, in any event, are bound by, the statement in Mead, quoted above, that the inquiry under § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112 ¶ 1. (Emphasis added.)

Thus, with regard to "intent to claim," the important question is whether there is written description support, within the meaning of 35 U.S.C. § 112, first paragraph, in the original specification for that subject matter which the appellants have sought to cover by newly added or modified claims. Here, the examiner nowhere asserted that the new claims sought to be added by reissue lack written description support in the specification of the original patent. Thus, an intent to claim or the lack thereof is in any event a non-issue in this case.

For the foregoing reasons, we reject the examiner's apparent position that the appellants knowingly gave up broader coverage or otherwise are not entitled to claim that which is now claimed by reason of the lack of an original "intent to claim."

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We do, however, find merit in the examiner's conclusion that the appellants' reissue declaration failed to comply with 37 CFR § 1.175(a)(5) which requires "[p]articularly specifying the errors relied upon." Actually, a more appropriate section of 37 CFR § 1.175 in this context is § 1.175(a)(3). In part, 37 CFR § 1.175(a)(3) requires "distinctly specifying the excess or insufficiency in the claims" when it has been alleged, as here, that the patent is inoperative or invalid by reason of the appellants claiming more or less than they had a right to claim.

The examiner's final rejection (Paper No. 23, Paragraph Nos. 4-8) made clear that the problem with the appellants' reissue declaration lies in insufficient detail in the pointing

out of differences between the original patent claims and the added reissue claims. The appeal brief also reflects that the appellants are aware that lack of specificity in pointing out differences in the claimed subject matter is the examiner's concern. Accordingly, the lack of mention of 37 CFR § 1.175(a)(3) by the examiner is deemed harmless.

At oral hearing, the appellants' counsel represented to us that the appellants have made every effort to comply with the

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specificity requirements of 37 CFR § 1.175 in connection with the identification of error and the specifying of excesses and deficiencies in the claims. For example, the entirety of the original and new claims have been reproduced; the features taken out of the original claims have been identified; and the numerous features of the new claims have been recited. In short, the appellants' position is that they are at rope's end and simply don't know what more to do.

Alternatively, the appellants contend that in any event, the specificity requirements of 37 CFR § 1.175 with regard to noting the excesses and deficiencies in the original claims are not so stringent as to call for the pointing out of each and every difference with respect to the newly added claims. The appellants cite In re Doll, 419 F.2d 925, 164 USPQ 218 (CCPA 1970), in which a reissue applicant's mere general indication that an

error was made in not previously claiming that which is later claimed was held to be in compliance with 37 CFR § 1.175. At oral hearing, the appellants' counsel pointed out that the pertinent parts of 37 CFR § 1.175 did not change since the time of Doll.

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We will address the appellants' alternative argument first, since it is more logical to first determine what is required and then follow with an analysis of whether the appellants have complied. The appellants' argument concerning Doll is misplaced.

The appellants are correct that in Doll, 419 F.2d at 928,

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defect has been singled out or commented upon by the board. On this record, we agree with appellant that the oath is adequate.

The appellants are also correct that the "distinctly specifying the excesses or deficiencies in the claims" language of the then Patent Office Rule 175 is the same language in the present 37 CFR § 1.175(a)(3) (1996). But nonetheless, the appellants can derive no meaningful support from Doll. The factual circumstance including the record on appeal is much different between that of Doll and that of this case.

Here, unlike in Doll, the examiner has articulated specific and particular defects or problems with regard to the appellants' lack of specificity in identifying differences in the claimed subject matter. Those problems will be addressed later. Also, in 1970, the Patent and Trademark Office (PTO) did not yet have the official interpretation it now has concerning the specificity requirements of 37 CFR § 1.175 and thus the CCPA in Doll did not have before it the PTO's interpretation of a regulation it promulgated and administered. In that regard, note that as early as 1983, the Manual of Patent Examining Procedure (MPEP) (original Fifth Edition), Section 1444, stated the following with regard to 37 CFR § 1.175:

Every departure from the original patent represents an "error" in said original patent under 35 U.S.C. 251 and

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must be particularly and distinctly specified and supported in the original, or a supplemental, reissue oath or declaration under 37 CFR 1.175.

The MPEP's provisions represent the PTO's interpretation of the pertinent statutes and regulations, Molins PLC v. Quigg, 837 F.2d 1064, 1067, 5 USPQ2d 1526, 1528 (Fed. Cir. 1988). An agency's interpretation of its own regulation is entitled to deference, Martin v. Occupational Safety and Health Review Commission, 499 U.S. 144, 150 (1991); Torrington Co. v. United States, 82 F.3d 1039, 1050 (Fed. Cir. 1996); Molins, 837 F.2d at 1067, 5 USPQ2d at 1528, unless, of course, it is clearly contrary to the law, which in this case it is not.

In In re Constant, 827 F.2d 728, 729, 3 USPQ2d 1479, 1480 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987), the same language in MPEP § 1444 provided support for the Board's finding that the appellant there failed to distinctly specify the excesses or deficiencies in the claims. After quoting the pertinent language of MPEP § 1444, the Federal Circuit in Constant, 827 F.2d at 729, 3 USPQ2d at 1480, stated:

Appellant has failed to show any error of law in the Board's application of rule 175 or in the rule's promulgation.

It is manifestly evident that the Federal Circuit did not find MPEP § 1444 to be contrary to law. Neither do we.

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Moreover, in Nupla Corp. v. IXL Mfg. Co., \_\_\_ F.3d \_\_\_,  
\_\_\_\_\_, 42 USPQ2d 1711, 1713 (Fed. Cir. 1997), the Federal Circuit  
cited its decision in Constant and MPEP § 1444 and stated:

Our case law requires a reissue application to include  
declarations "to specify every difference between the  
original and reissue claims."

Accordingly, the appellants must satisfy the requirements of MPEP  
§ 1444 in order to comply with 37 CFR § 1.175.

The new claims 9-18, 24-33 and 38-67 added via the reissue  
application look quite different from the original patent claims.  
It is readily apparent that they incorporate many changes rela-  
tive to original patent claims 1-7. Undeniably, the appellants  
have made significant effort in pointing out the differences in  
the claimed subject matter. Up to six reissue declarations have  
been filed, including the supplemental reissue declaration which  
was filed on June 12, 1995. That reissue declaration is thirty-  
six pages long and includes, in addition to an explanation of  
differences, the full text of each new claim.

The question is whether the appellants' reissue declaration  
sufficiently specified the excesses or deficiencies in the  
claims. For reasons discussed hereinafter, we conclude that the  
appellants have not.

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On pages 21 and 22, in lettered paragraph (s), the reissue declaration explains what was included in the original patent

claims but not recited in the newly added claims. In that regard, the appellants made clear what the excesses were in the original patent claims and thus how the new claims are made broader. Commencing on page 22, the reissue declaration starts to explain what each of the newly added claims recite and goes into substantial detail about each new claim. The problem, however, is that the declaration does not make known which features are first presented in the new claims as opposed to those which were already in the original claims. Thus, the deficiencies relative to the original claims, i.e., the features added by the new claims, have not been distinctly specified.

The examiner specifically pointed out several deficiencies as an example of the type of deficiency which extends throughout the reissue declaration. At page 5 in the examiner's answer, the examiner notes that while new claim 9 recites a "plurality of intermediate tones" in the liquid crystal display, original patent claims 1, 2 and 3 require only "an intermediate tone." That is one type of claim change which the Federal Circuit in

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Nupla, \_\_\_ F.3d at \_\_\_\_, 42 USPQ2d at 1713, regarded as material and in need of a specific explanation in the reissue declaration. Specifically, in Nupla, id., the corresponding change was from "a plurality of grooves" to "at least one groove." Additionally, the examiner also indicated that while the original claims 1, 2

and 3 require a "character" or a "figure" in the display pattern, new claim 9 does not.<sup>3</sup> These differences are also substantive but are nowhere identified, discussed or explained in the reissue declaration. As is indicated by the Federal Circuit in Nupla, \_\_\_ F.3d at \_\_\_\_, 42 USPQ2d at 1715, the reissue declarations require a full explanation of each excess and deficiency in the original claims. That, the appellants have not done.

It is the appellants' burden to point out all the substantive differences, notwithstanding whether the examiner or one

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<sup>3</sup> The examiner further found fault with the appellants not accounting for the change in claim language to directly recite a method rather than indirectly through the introductory phrase "[i]n a method . . . ." We apply a rule of reason and do not find that this change would require its own separate discussion in the reissue declaration. It is implicit that the reference in MPEP § 1444 to every departure from the original claims is directed to substantive features. The examiner has not adequately explained, and it is not apparent, how this difference in wording amounts to a substantive change.

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with ordinary skill in the art, looking at the original claims and the newly added claims, can form his or her own conclusions in that regard. No one but the appellants themselves are qualified to declare the errors sought to be corrected. Note that the reissue declaration under 37 CFR § 1.175 is one to be executed by the applicants for patent, not the examiner or a person of ordinary or expert skill in the art.

Finally, we reject the appellants' argument made in the reply brief at page 5 that they have pointed out the differences "of what is considered to be a substantial nature rather than that of the substantially inconsequential nature." The examiner's example of the unidentified deficiencies such as that concerning a plurality of intermediate tones and the display of character patterns or figures cannot be regarded as inconsequential.

Moreover, the appellants cannot dismiss substantive changes as merely inconsequential.<sup>4</sup> The reading and interpreting of claims can often be complicated. Reasonable people including

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<sup>4</sup> The scope of non-substantive changes is very limited. See footnote 3.

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examiners, applicants, and potential infringers frequently may disagree on what is or is not inconsequential. Compliance with MPEP § 1444, which requires identification of every departure from the original claims as an "error" within the meaning of 35 U.S.C. § 251, builds a record for each error which has been corrected and ensures that no substantive change slips through the reissue process without notice and corresponding support in the reissue declaration. The appellants' casualness with respect to the specifying of excesses and deficiencies in the claims entirely frustrates that result.

For the foregoing reasons, we affirm the rejection of claims 1-7, 9-18, 24-33, and 38-67 under 35 U.S.C. § 251, as being based on a defective reissue declaration not in compliance with 37 CFR § 1.175.

#### Conclusion

The rejection of claims 1-7, 9-18, 24-33, and 38-67 under 35 U.S.C. § 251 is affirmed.

The decision of the examiner is affirmed.

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

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AFFIRMED

GARY HARKCOM	)	
Vice-Chief	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JAMESON LEE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
RICHARD TORCZON	)	
Administrative Patent Judge	)	

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