

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte GERALD D. DUNCAN

---

Appeal No. 1998-0212  
Reissue Application No. 07/837,588

---

HEARD: December 9, 1999

---

Before BARRETT, FRAHM, and BARRY, Administrative Patent Judges.  
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 35-74, 76-85, 87, 88, 90-107, 109, 110, and 112-144. We affirm-in-part.

BACKGROUND

On September 16, 1986, the appellant filed U.S. Patent Application No. 06/908,176 ('176 Application<sup>1</sup>). During prosecution, the examiner concluded that the pending claims of the '176 Application specified two independent and distinct inventions; he required restriction between two corresponding groups of the claims. The examiner explained that the claims of the first group, viz., claims 1-5, 7-9, 12-23, 25-33, and 51, were "drawn to motor control including cyclic reversing, applying power, electronic control ...." ('176 Application, Paper No. 10 at 2.) He added that the claims of the second group, viz., claims 35-49, were "drawn to [a] laundry machine ...." (Id.) In reply, the appellant elected to prosecute the claims of the first group. ('176 Application, Paper No. 11 at 2.) Acknowledging the election and noting that the appellant did not traverse the restriction requirement, the examiner

---

<sup>1</sup> We will reference papers from the original application by designating the "'176 Application." We will reference papers from the instant continuation reissue application and its parent reissue application without designating the application number.

withdrew the nonelected claims, viz., claims 35-39, from consideration. ('176 Application, Paper No. 12 at 1-2.)

During an interview on March 9, 1989, the appellant authorized the examiner to cancel the nonelected claims by an "Examiner's Amendment." ('176 Application, Paper No. 19.) On March 13, 1989, the examiner mailed a "Notice of Allowability," which included the Examiner's Amendment canceling the nonelected claims, ('176 Application, Paper No. 20 at 2), and a "Notice of Allowance and Issue Fee Due." On March 31, 1989, the appellant filed an "Amendment under Rule 312." ('176 Application, Paper No. 22) The amendment referenced the Examiner's Amendment and acknowledged the interview. (Id. at 1-2.) The amendment was entered. ('176 Application, Paper No. 23.) On June 13, 1989, the appellant filed an "Issue Fee Transmittal." On August 15, 1989, the application was issued as U.S. Patent No. 4,857,814 ('814 Patent). The '814 Patent included claims 1-34.

On June 19, 1989, the appellant filed a "Supplemental Amendment under Rule 1.312." ('176 Application, Paper No. 24.) The supplemental amendment attempted to cancel the nonelected claims, which had already been canceled by the Examiner's Amendment, "for incorporation in a divisional application." (Id. at 1-2.) It also attempted to cancel allowed claims 13, 27-31, and 55 for incorporation "into a continuation application." (Id. at 2.) Because the supplemental amendment "reached the appropriate official for action after the patent issued," ('176 Application, Paper No. 25), the Patent and Trademark Office (PTO) denied its entry. On September 25, 1989, the PTO informed the appellant of the denial. (Id.)

On May 17, 1990, the appellant filed U.S. Patent Application No. 07/526,711 ('711 Reissue Application), which was for reissue of the '814 Patent. On February 18, 1992, he filed U.S. Patent Application No. 07/837,588, which was a continuation of the '711 Reissue Application and abandoned the latter. (Paper No. 11

at 1.) On November 19, 1996, the examiner mailed an Office action making a final rejection of claims 35-74, 76-85, 87, 88, 90-107, 109, 110, and 112-144 under 35 U.S.C § 251. (Paper No. 32 at 2.) The instant appeal followed.

Claim 85, which is representative for our purposes, follows:

85. In a method of operating a laundry machine having a container for a wash load of soiled fabrics in wash water and a reciprocatable agitator in said container, an electric motor having a rotor for driving said agitator, setting means for setting a desired rate and amplitude of oscillating rotation of said agitator, electronic control means for controlling a supply of electrical power to said electric motor in one of a plurality of sequences of operation selected from an agitation sequence and a spinning sequence, the improvement comprising the steps of:

(a) setting a selected one of said plurality of sequences of operation so that said agitator is driven in oscillating rotation during a wash phase in a sequence of washing operations,

(b) sensing resistance to oscillation of said agitator due to the wash load in said container,

(c) adjusting the power supplied to said electric motor so that a selected rate of removal of soil from said soiled fabrics is substantially achieved, and

(d) sensing load on said rotor by measuring the time the rotor takes to run down in speed from a motor power off condition to a speed condition in which application of power to the motor will cause reversal of rotation of the rotor constituting a condition for reversal.

Claims 35-74, 76-85, 87, 88, 90-107, 109, 110, and 112-144 stand rejected under 35 U.S.C. § 251 as not being based on an error correctable by reissue of the original patent. Rather than repeat the arguments of the appellant or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

#### OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 35-74 and 76 and 121-144. We are not persuaded, however, that he erred in rejecting claims 77-85,

87, 88, 90-107, 109, 110, and 112-120. Accordingly, we affirm-in-part. Our opinion addresses the following issues seriatim:

- grouping of the claims
- specifying of a reissue error.

We first address the grouping of the claims.

#### Grouping of the Claims

The appellant states that claims 35-74, 76-85, 87, 88, 90-107, 109, 110, and 112-144 should be considered as standing or falling together in the following groups for the appeal:

- claims 35-74 and 76
- claims 77-85, 87, 88, 90-107, 109, 110, and 112-120
- claims 121-144.

(Appeal Br. at 5.) Therefore, the claims stand or fall together in these groups. Next, we address the specifying of a reissue error.

#### Specifying of a Reissue Error

At the outset, we address the appellant's argument regarding his failure to file certain patent applications timely. He argues that on June 13, 1989, besides paying the issue fee, he "began preparing the necessary divisional application for [nonelected] claims 35-49," (Appeal Br. at 6), and "continuation applications to include the presently pending [i.e., reissue application] claims 35-74 and 76." (Id.) The appellant states that he planned to file the divisional application when he received a "Notice of Patent Issuance" from the PTO. (Id.)

In support of the appellant's position, D. Bruce Prout, the "lawyer principally responsible for the prosecution of the U.S. patent application resulting in the ['814 Patent]," (Prout Decl., 5/17/90, ¶ 1), provides the following declaration:

11. Since confirmation of the entry or denial of the Supplemental Amendment Under Rule 1.312 of June 13, 1989 had not been received, and since it has typically taken at least 3 months from the date of the payment of issue fees until patent issuance, and further since the Notice of Patent Issuance had not been received, the actual issuance of the original patent was not expected until around the middle of September 1989.

12. However, unexpectedly, on August 21, 1989, less than two months after the payment of the issue fee and before any action on the June 13, 1989 Supplemental Amendment, the undersigned received the late Notice of Patent Issuance in the U.S. patent application advising that the original patent had already issued on August 15, 1989. At this same time, the two U.S. continuation applications and the divisional applications were being finalized in my office to prepare for filing, with the intent of making them co-pending with and of claiming priority from the U.S. patent application. (Id., ¶¶ 11-12.)

The examiner's reply follows:

First, appellant should not correlate the Issue Fee Receipt to the date of patent issuance. Although the Issue Fee Receipt should precede the issue of a patent as the "standard practice", they are actually not related.

Secondly, the period from appellant's Supplemental Amendment signature date (06/13/89) (Application SN 06/908,176 paper #24) to the patent issued date (08/15/89) was two months, which should have been enough for appellant to file a continuation application if appellant had desired to do so.

Most importantly, as soon as the receiving of Notice of Allowance (03/13/89, paper #21) appellant should have prepared for filing a continuation application. Had appellant done so, the continuation application would have been filed prior to the issuance of the patent. (Examiner's Answer at 6.)

We agree with the examiner.

35 U.S.C. § 251, ¶ 1, specifies in pertinent part the following remedy.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on surrender of such patent ... reissue the patent for the invention disclosed in the original patent ....

“[T]he whole purpose of the [reissue] statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow.” In re Weiler, 790 F.2d 1576, 1580, 229 USPQ 673, 675 (Fed. Cir. 1986) (quoting In re Handel, 312 F.2d 943, 948, 136 USPQ 460, 464 (CCPA 1963)). “That is what the statute means in referring to ‘claiming more or less than he had a right to claim.’” Handel, 312 F.2d at 948, 136 USPQ at 464. Here, the appellant fails to show error by the PTO, let alone error correctable by reissue.

The examiner mailed the Notice of Allowability, (‘176 Application, Paper No. 20), which included the Notice of Allowance and Issue Fee Due, on March 13, 1989. The Notice of

Allowance and Issue Fee Due advised the appellant that he was "entitled to a patent under the law . . . ." 37 C.F.R. § 1.311 (1988). The '814 Patent did not issue until August 15, 1989. Based on these dates, the appellant had over five months to file any applications for which copendency with the '176 Application was sought.

At the time the appellant filed the Issue Fee Transmittal, viz., June 13, 1989, the Manual of Patent Examining Procedure (M.P.E.P.) provided notice that "a patent number and issue date are assigned to an application approximately within two (2) weeks after the issue fee is received in the Patent and Trademark Office, and this event starts a printing routine that takes about eight (8) weeks . . . ." M.P.E.P. § 1306.03 (5th ed., Aug. 1983). The appellant's experience with how long a patent typically took to issue and his non-receipt of a Notice of Patent Issuance, (Prout Decl., 5/17/90, ¶ 11), do not alter the fact that he had notice that the '176 Application was to issue as a patent.

Even if the PTO erred by promptly issuing the '814 Patent and not issuing a Notice of Patent Issuance, the "error" would not be correctable by reissue. The appellant's argument regarding his failure to file certain patent applications timely has not shown that the PTO's actions caused him to obtain claims that were too broad or too narrow. It is that sort of error that is correctable by reissue.

With this in mind, we address the specifying of a reissue error for the following groups of claims:

- claims 35-74 and 76
- claims 77-85, 87, 88, 90-107, 109, 110, and 112-120
- claims 121-144.

We first address the specifying of a reissue error for claims 35-74 and 76.

*Claims 35-74 and 76*

Regarding claims 35-74 and 76, the examiner asserts, "Applicant's decision to file two continuation applications and his failure to timely do so is not an error correctable by

reissue application." (Paper No. 23 at 4.) Although the assertion is not wrong, it overlooks an error that is correctable by reissue. Specifically, the error is "that the claims in the ['814 Application] claimed less than [the appellant] had a right to claim because the claims had unnecessary limitations." (Prout Decl., 5/17/90, ¶ 5.) The appellant sought to remove limitations from patented claims that he deemed too narrow by filing an application for broader claims 35-74 and 76 within two years of the '814 Patent's issuance.

Although of a different scope, claims 35-74 and 76 are directed to the same subject matter as claims 1-34 of the '814 Patent. Specifically, claims 35-48 are directed to the "method of cyclically controlling the supply of power to an electric motor" of patented claim 13. Claims 49-59 are directed to the "method of electronically cyclically controlling the supply of power to an electric motor" of patented claim 14. Claims 60-66 are directed to the "electrical control means for cyclically controlling the supply of electric power to an electric motor"

of patented claim 26. Claims 67-74 and 76 are directed to the "[e]lectrical control means for cyclically controlling the supply of electric power to an electric motor" of patented claim 10.

For the foregoing reasons, we are not persuaded that the appellant failed to satisfy the error requirement of 35 U.S.C. § 251. Therefore, we reverse the rejection of claims 35-74 and 76 under 35 U.S.C. § 251. Next, we address the specifying of a reissue error for claims 77-85, 87, 88, 90-107, 109, 110, and 112-120.

*Claims 77-85, 87, 88, 90-107, 109, 110, and 112-120*

Regarding claims 77-85, 87, 88, 90-107, 109, 110, and 112-120, the examiner asserts, "non-elected claims cannot be incorporated into a reissue application as an 'error' of claiming less than he had the right to claim. See ... **In re**

**Orita, 193 USPQ 145.**" (Paper No. 23 at 3.) The appellant replies that the "claims do not seek to recapture nonelected claims." (Appeal Br. at 2.) We agree with the examiner.

"[N]ot every event or circumstance that might be labeled 'error' is correctable by reissue." Weiler, 790 F.2d at 1579, 229 USPQ at 675. In particular, "the failure to file a divisional application, regardless of the propriety of the underlying restriction requirement, is not an error correctable by reissue under 35 U.S.C. § 251." In re Watkinson, 900 F.2d 230, 231, 14 USPQ2d 1407, 1409 (Fed. Cir. 1990). "Finally, granting by reissue claims substantially identical to those non-elected in [an original] application ... would be ignoring the proper restriction requirement set forth in that application in which appellants acquiesced." In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 149 (CCPA 1977).

Here, the examiner concluded that the pending claims of the '176 Application specified two independent and distinct

inventions; he required restriction between two corresponding groups of the claims. ('176 Application, Paper No. 10 at 2.) The appellant acquiesced to the restriction requirement. Specifically, he elected to prosecute the claims of the first group without traversal, ('176 Application, Paper No. 11 at 2, Paper No. 12 at 2), and authorized the examiner to cancel the nonelected claims. ('176 Application, Paper No. 19, Paper No. 20 at 3.) We will not delve into the merits of the restriction requirement. Instead, we will decide whether claims 77-85, 87, 88, 90-107, 109, 110, and 112-120 are substantially identical to nonelected claims 35-49.

As mentioned regarding the grouping of the claims, claims 77-85, 87, 88, 90-107, 109, 110, and 112-120 stand or fall together as a group. Following 37 C.F.R. § 1.192(c)(7)(1997), we select claim 85 to represent the group. Claim 85 is reproduced below, with the changes from nonelected claims 36 and 37 marked. Additions are marked with underlining; deletions, with brackets.

[36] 85. In [A] a method of operating a laundry machine having a container for a wash load of soiled fabrics in wash water and a reciprocatable agitator in said container, an electric motor having a rotor for driving said agitator, setting means [to set] for setting a desired rate and amplitude of oscillating rotation of said agitator, electronic control means for controlling [the] a supply of electrical power to said electric motor in one of a plurality of sequences of operation selected from an agitation sequence and a spinning sequence, [said method including] the improvement comprising the steps of:

a setting a selected one of said plurality of sequences of operation so that said agitator is driven in oscillating rotation during a wash phase in a sequence of washing operations,

b sensing [the] resistance to oscillation of said agitator due to the wash load in said container,

c [and] adjusting the power supplied to said electric motor so that a selected rate of removal of soil from said soiled fabrics is substantially achieved, and

[37. A method as claimed in claim 36 which includes the step of] d sensing load on said [motor] rotor by measuring the time the [motor] rotor takes to run down in speed from a power off condition to a speed condition in which [the motor direction may be reversed] application of power to the motor will cause reversal of rotation of the rotor constituting a condition for reversal.

The appellant admits, "claim 85 is similar to nonelected claims 36 and 37 ...." (Reply Br. at 5.) This is an

understatement. In fact, claims 85 and 37 are substantially identical in scope.

As recited in the preambles of claims 85 and 37, both claims are directed toward a "method of operating a laundry machine." The preambles of both claims, moreover, specify substantially identical components of the washing machine, viz., a "container," a "reciprocatable agitator," an "electric motor," a "setting means," and an "electronic control means." The preambles of both claims also recite the same "plurality of sequences of operation selected from an agitation sequence and a spinning sequence" for the washing machine. In addition, the methods of claims 85 and 37 both comprise substantially identical steps, viz., "setting," "sensing," "adjusting," and "sensing."

The appellant argues that claim 85 "is written in Jepson format and therefore relies on the inventive motor control system (as in the allowed claims) for patentability." (Reply Br. at 5.) The appellant fails to show how the rewriting

claim 37 in Jepson format (as claim 85) produces a substantially different claim.

"Although a preamble is impliedly admitted to be prior art when a Jepson claim is used, ... the claimed invention consists of the preamble in combination with the improvement, see Manual of Patent Examining Procedure § 608.01(m) (5th ed., July 1983)." Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985) (internal citations omitted). Accord M.P.E.P. § 608.01(m) (7th ed., July 1998) ("The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the combination.");<sup>2</sup> Donald S. Chisum, Chisum on Patents § 8.06[1][d] (1999) ("With Jepson-style improvement claims, it is clear that the preamble is a limitation."); Light v. Hauss, 200 USPQ 638 (Bd. Pat. App. & Int. 1978) (interpreting the preamble of a count written in

---

<sup>2</sup> Based on such an interpretation, the examiner concludes that, in a restriction requirement, claim 85 would have been grouped with claim 37 and the other nonelected claims, which were drawn to a laundry machine. (Examiner's Answer at 7.)

Jepson format to include limitations recited therein as a part of the combination).

Here, we interpret the preamble of claim 85 to positively and clearly include all the elements recited therein as a part of the combination. More specifically, the claimed invention comprises the limitations in the preamble and in the body of claim 85.

As aforementioned, the limitations specify that, like claim 37, claim 85 is directed to a laundry machine. Furthermore, the limitations specify components of the washing machine that are substantially identical to those of claim 37, operation sequences that are identical to those of claim 37, and method steps that are substantially identical to those of claim 37.

The appellant also argues that claim 85 "requires the added limitation of 'having a rotor for driving said agitator.'" (Reply Br. at 5.) He adds, "Appealed claim 85

further differs from nonelected claim 36 and 37 in that it contains the added step of sensing the load on the rotor. Although a similar step is present in nonelected claim 37, the appealed claim specifically refers to sensing the load on the 'rotor' unlike nonelected claim 37." (Id. at 5-6.)

This argument is an overstatement. Like claim 85, claim 37 specifies in pertinent part the limitations of "an electric motor driving said agitator" and "sensing load on said motor." Claim 85 merely adds a rotor to the electric motor and the sensing step of claim 37. Claims are not interpreted in a vacuum but are part of and are read in light of the specification. Slimfold Mfg. Co. v. Kinkead Indus., Inc., 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987).

Here, the specification includes the following disclosure about the electronically commutated motor (ECM) of claim 37.

The ECM 2 constitutes a stationary assembly having a plurality of winding stages adapted to be selectively commutated, and rotatable means associated with that stationary assembly in selective magnetic coupling relation with the winding stages. The winding stages are commutated without brushes by sensing the rotational position

of the rotor as it rotates within the stationary assembly. ('176 Application, Spec. at 13.)

Reading claim 37 in light of the specification, one of ordinary skill in the art would have known that the electric motor of the claim includes a rotor. Such a one also would have known that the final step of claim 37 senses the load on the claimed motor's rotor. In view of this knowledge, the express addition of the rotor to claim 85 amounts to an insubstantial change from the scope of claim 37.

For the foregoing reasons, we are not persuaded that claim 85 is not substantially identical to nonelected claim 37. The appellant's alleged "error" is a deliberate choice to file a divisional application rather than traverse the restriction requirement and a subsequent failure to file the application timely. We agree with the examiner that this case falls within the holding of Orita where the court said that section 251 "is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure." 550 F.2d at 1281, 193 USPQ at 149.

Moreover, granting by reissue, claims that are substantially identical to those nonelected in the '176 Application, would be tantamount to ignoring the restriction requirement set forth in the original application. Indeed, such a misapplication of section 251 would bypass the copendency requirement of 35 U.S.C. §§ 120 and 121.

In summary, the appellant has not established the requisite error under 35 U.S.C. § 251 to justify granting a reissue patent containing claims substantially identical to those non-elected in the original application. Claims 77-84, 87, 88, 90-107, 109, 110, and 112-120 fall with claim 85. Therefore, we affirm the rejection of claims 77-85, 87, 88, 90-107, 109, 110, and 112-120 under 35 U.S.C. § 251.

Our affirmance is based only on the arguments made in the briefs. Arguments not made therein are not before us, are not at issue, and are thus considered waived. Next, and last, we address the specifying of a reissue error for claims 121-144.

*Claims 121-144*

Regarding claims 121-144, the examiner asserts, "Applicant's decision to file two continuation applications and his failure to timely do so is not an error correctable by reissue application." (Paper No. 23 at 4.) Although the assertion is not wrong, it overlooks an error that is correctable by reissue. Specifically, the error is that "the ['814 Patent] claims less than [he] had a right to claim . . . ." (Supplemental Duncan Decl., 6/17/91, ¶ 34.) The appellant sought to remedy this deficiency by filing a reissue application for claims 121-144 within two years of the '814 Patent's issuance.

Although of a different scope, claims 121-144 are directed to the same subject matter as claims 1-34 of the '814 Patent. Specifically, claims 121-144 are directed to the "cyclically reversing an electronically commutated motor" of patented claim 2.

For the foregoing reasons, we are not persuaded that the appellant failed to satisfy the error requirement of 35 U.S.C.

§ 251. Therefore, we reverse the rejection of claims 121-144 under 35 U.S.C. § 251.

CONCLUSION

To summarize, the rejection of claims 35-74, 76, and 121-144 under 35 U.S.C. § 251 is reversed. The rejection of claims 77-85, 87, 88, 90-107, 109, 110, and 112-120 under 35 U.S.C. § 251, however, is affirmed. Accordingly, we affirm-in-part.

No period for taking subsequent action concerning this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

LEE E. BARRETT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
ERIC FRAHM	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

Appeal No. 1998-0212  
Reissue Application No. 07/837,588

Page 27

LLB/kis

Appeal No. 1998-0212  
Reissue Application No. 07/837,588

Page 28

CHRISTIE, PARKER & HALE  
P. O. Box 7068  
Pasadena, CA 91109-7068