



SEP 14 1998

Paper No. 11

MICHAEL E. MCCABE, JR.
MCDERMOTT, WILL AND EMERY
600 13th Street, N.W.
Washington, DC 20005

(For Patent Owner)

JOSEPH T. JAKUBEK
KLARQUIST, SPARKMAN, CAMPBELL,
LEIGH & WHINSTON, LLP.
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

(For Requester)

In re Reexamination Control No. 90/004,982
Filed: May 5, 1998
For: U.S. Patent No. 4,245,862

:
:
:
: **ON PETITION**
: 37 CFR §§ 1.181 & 1.515(c)
:
:
:

This is a decision on the petition filed August 13, 1998 by the third party requester, Freightliner Corporation, under 37 CFR 1.181 and 1.515(c), for review of the examiner's decision, mailed July 13, 1998, denying the above identified request for reexamination of U.S. Letters Patent No. 4,245,862.

BACKGROUND

An application for U.S. Letters Patent was filed by Frank T. Buckley, Jr. on February 19, 1976, for a "Drag Reducer For Land Vehicles" which was assigned Serial No. 659,517. During the pendency of this original application, a second application (continuation-in-part) Serial No. 763,796, was filed on February 1, 1977, claiming priority to the first application which was then expressly abandoned in favor of the second application. A third application (continuation-in-part) Serial No. 891,061, was subsequently filed on

March 30, 1978, during the pendency of the second application which was also expressly abandoned in favor of the third application. The third application claimed priority to both of the earlier filed applications under the provisions of 35 U.S.C. 120. The third application ultimately issued as U. S. Patent No. 4,245,862 on January 20, 1981.

The seventeen year term of U. S. Letters Patent No. 4,245,862 expired on January 20, 1998.

On May 5, 1998, a request for reexamination of U.S. Patent No. 4,245,862 was filed by the third party requestor, *supra*.

On July 13, 1998, the examiner issued an "Order" denying the request for reexamination.

The instant petition was then timely filed on August 13, 1998 by the requester.

CONTROLLING AUTHORITIES

Title 35 United States Code (U.S.C.)

35 U.S.C. 301 (first sentence):

Any person at any time may cite to the Office in writing prior art consisting of patents or publications which that person believes to have a bearing on the patentability of any claim of a particular patent.

35 U.S.C. 302 (first sentence):

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 303(a) (first sentence, in pertinent part):

---the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C. 303(c) (in pertinent part):

A determination by the Commissioner --- that no substantial question of patentability has been raised will be final and nonappealable.

Title 37 Code of Federal Regulations (CFR)

37 CFR 1.515(b) and (c) (in pertinent part):

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting reexamination will be made to the requester in accordance with § 1.26(c).

(c) The requester may seek review by a petition to the Commissioner--- within one month of the mailing date of the examiner's determination refusing reexamination.

37 CFR 1.26(c) (in pertinent part):

If the commissioner decides not to institute a reexamination proceeding, a refund of \$1,690.00 will be made to the requester of the proceeding.

37 CFR 1.555(b) (in pertinent part):

---information is material to patentability in a reexamination proceeding when it is not cumulative to information of record ---.

DISCUSSION

The request for reexamination filed on May 5, 1998 included the citation of the following alleged "prior art" which is presumed not to have been considered by the examiner during the original prosecution of the application resulting in U. S. Patent No. 4,245,862 since these citations were not previously "of record."

Design Patent No. D238,161 to DeVaughn, issued December 23, 1975

Society of Automotive Engineers Publication Nos. 760105, 760106 (both dated February 23-27, 1976) and 760850 (dated November 1-4, 1976).

"Aerodynamic Add-Ons for Present Rigs," Automotive Engineering, June 1976, Vol. 84, No.6, pp. 45-50.

Treating first the patent to DeVaughn, the disclosure of this patent is clearly cumulative to the previously cited patent to Servais et al., Patent No. 3,945,677, which was considered by the examiner during prosecution of application Serial No. 891,061, filed March 30, 1978, which resulted in the issuance of the subject patent to Frank T. Buckley, Jr., for which reexamination has been requested. The patent to Servais et al. depicts a fairing for a tractor-trailer rig which is the full equivalent of the device shown in the

drawings of the design patent to DeVaughn with respect to that portion of the latter patent's disclosure which could be considered pertinent to any claim of the patent to Buckley, Jr..

With respect to the cited printed publications listed above, petitioner/requester maintains that the patent for which reexamination has been requested cannot rely upon the filing date of the earlier filed parent applications because none of the claims in the patent find support in the earlier filed applications necessary to satisfy the disclosure requirements of 35 U.S.C. 112, first paragraph. No issue is taken with respect to this argument. It is assumed, for purposes of this decision, that they each constitute "prior art" under 35 U.S.C. 102(b) and 103. However, none of these publications are considered to disclose any structure or structural arrangement between a fairing mounted on the cab-portion of a vehicle and the van-portion of such vehicle which is not disclosed in the SAE Publication 750705, authored by William T. Mason, Jr., which was cited by the applicant and was considered by the examiner during the prosecution of the Buckley, Jr. patent. Note, in particular, Figs. 12, 16-18 and 28 of the SAE publication. The requester/petitioner urges that the "Fairing C" in Figure 7 of the ASE Publication No. 760105 depicts the claimed invention and should therefore be a bar to the grant of U.S. Patent No. 4,245,862 to Buckley, Jr. However, this drawing appears to contain no more pertinent disclosure of a fairing, or the relative dimensions and shape of a fairing, than disclosed in the ASE 750705 publication, *supra*. Accordingly, the cited publications are likewise considered to be cumulative to the prior art already considered by the examiner during prosecution of the patent for which reexamination has been requested.

OPINION

For the reasons stated above, there is no basis under 35 U.S.C. 302 or 37 CFR 1.515 to grant the instant request for reexamination of Patent No. 4,245,862. Requester has failed to cite prior art which presents a substantial new question of patentability of any claim in the patent under consideration because the citations presented are cumulative to the art previously considered by the examiner during the original prosecution. Accordingly, the request filed May 5, 1998 for reexamination of U.S. Patent no. 4,245,862 is denied.

CONCLUSION


A review of the record indicates that although the examiner may have gone beyond the requirements for determining whether the request for reexamination should have been granted or denied, he merely attempted to set forth his reasons for patentability of the claims in accordance with the requirement set forth in MPEP § 2247. The examiner's statements in the Order denying the request for reexamination may have been interpreted as a new determination of patentability of the claims over the "prior art" cited by the requester. This was not the intent of the examiner. Nevertheless, the examiner neither abused his discretion nor acted in an arbitrary or capricious manner in his denial of the request for reexamination.

Petitioner's request for a review of the examiner's denial of the request for reexamination is granted, but such review has not resulted in a reversal of the examiner's conclusion that no substantial new question of patentability has been raised by the request. This decision denying reexamination of U. S. Patent 4,245, 862, based upon the request filed May 5, 1998, is final and nonappealable in accordance with 35 U.S.C. 303(c) and 37 CFR 1.515(c).

In due course, under 37 CFR 1.26(c), a refund of a portion (\$1,690.00) of the reexamination request fee will be made to requester by credit to Deposit Account No. 02-4550.

Requester should note that the correspondence address of the patent owner was changed prior to the issuance of the "Order" mailed on July 13, 1998. The correct correspondence address for the patent owner appears above. A copy of the patent owner's revocation of prior powers and appointment of new counsel is enclosed.

SUMMARY: Petition for review of examiner's decision is granted;
 Request for reexamination is denied.



Richard A. Bertsch
Director,
Technology Center Group 3610

Encl.: Copy of paper filed by patent owner on May 27, 1998.
JFP/September 3, 1998