



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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE F. ADAMS

Appeal 2007-0441¹
Reissue Application 10/155,945²
Patent 5,311,959
Technology Center 3600

Oral Argument: None
Decided: March 14, 2007

Before: FRED E. McKELVEY, *Senior Administrative Patent Judge*, and ROMULO H. DELMENDO and ALLEN R. MacDONALD, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL UNDER 35 U.S.C. § 134(a)

¹ Appeal docketed at the Board on 05 December 2006.

² Reissue application filed 24 May 2002 to reissue U.S. Patent 5,311,959, issued 17 May 1994, based on application 07/868,066, filed 13 April 1992. The real party in interest is Kennametal, Inc.

1 **A. Introduction**

2 The appeal under 35 U.S.C. § 134(a) is from the Examiner’s rejection
3 of claims 1-5, all the claims in Applicant’s application to reissue U.S. Patent
4 5,311,959. The Board has jurisdiction under 35 U.S.C. § 6(b). We affirm.

5
6 **B. Findings of fact**

7 The following findings of fact are supported by the record by at least a
8 preponderance of the evidence. To the extent that a finding is a conclusion of law,
9 it may be treated as such.

10
11 Patent file

12 At the time we took up the appeal for consideration, it turned out that the
13 patent file was “lost” within the Patent and Trademark Office.

14 Counsel for the Applicant was requested to supply a copy of the patent file
15 and has done so.

16 We will make the copy of the patent file a document in the reissue
17 application IFW file.

18 The Board appreciates counsel’s cooperation and prompt action in supplying
19 the copy of the patent file.

20
21 Invention

22 The invention concerns a mine tool roof bit insert.

23 Claims 1-5 were presented in the original application as filed.

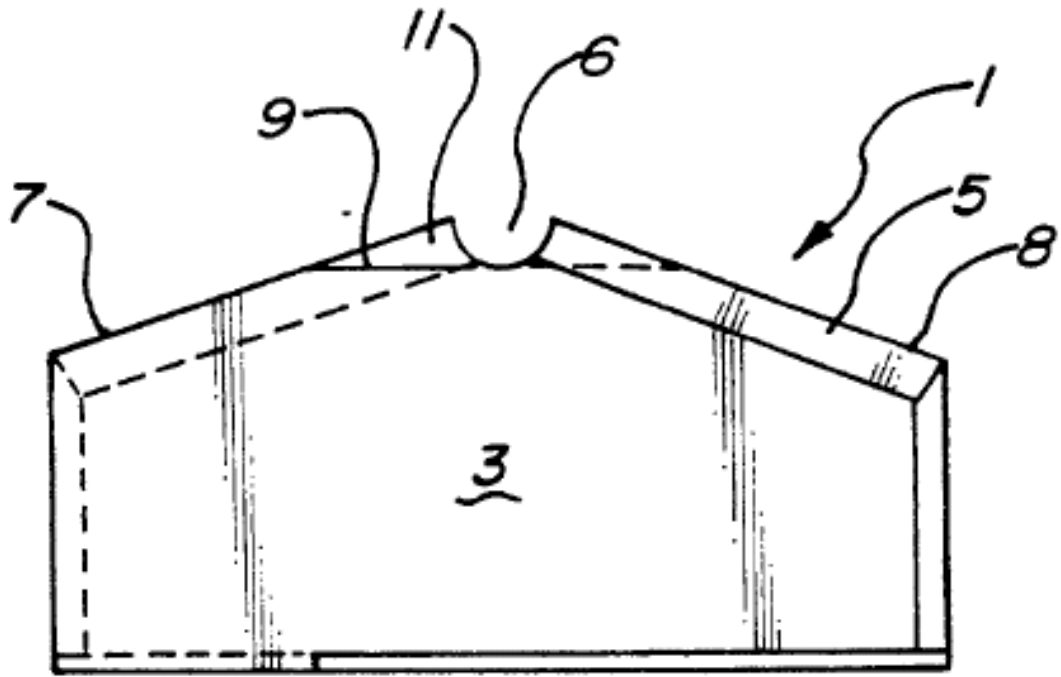
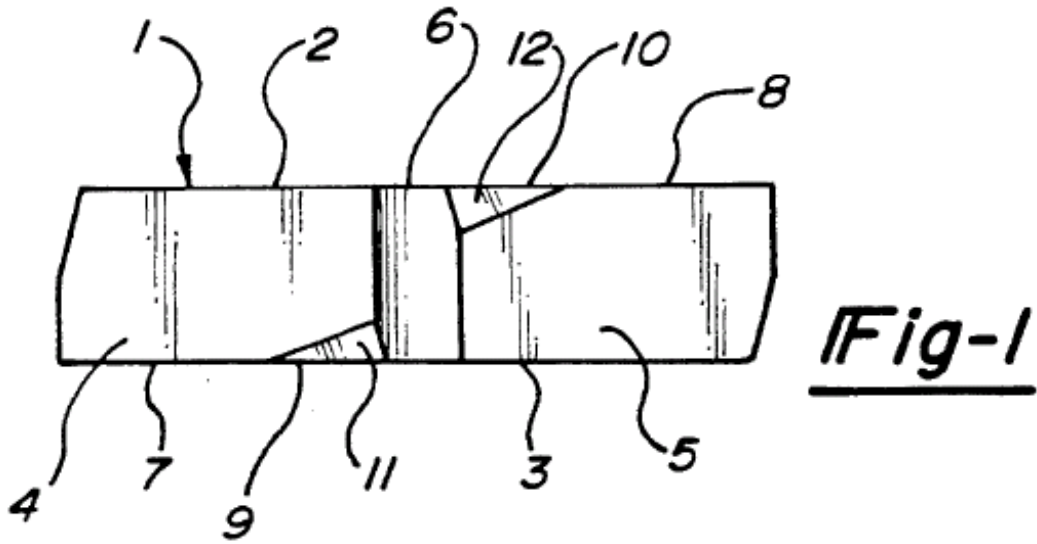


Fig-2

1 With reference to Figs. 1-2 of the drawings, as filed, claim 1 of the original
2 application, as filed, reads as follows [matter in brackets added]:

3 A mine tool roof bit insert [Fig. 1, element 1] having two
4 flat parallel sides extending in the long dimension of the
5 insert [Fig. 1, elements 2 and 3] and having two
6 uppermost slanted surfaces [Figs. 1 and 2, elements 4
7 and 5] extending between said two flat parallel sides, the
8 insert having a trough [Figs. 1 and 2, element 6] at the
9 top thereof, the trough being substantially orthogonal to
10 the flat parallel sides, the trough being between the two
11 uppermost slanted surfaces.

12

13

Prosecution leading up to the patent

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The Examiner determined that claim 1 was anticipated by U.S. Patent
4,342,368 to Denman. Office action entered 03 February 1993.

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Applicant essentially “confessed and avoided” by amending claim 1 to read
as follows (italicized matter added):

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A mine tool roof bit insert having two flat parallel sides
extending in the long dimension of the insert and having
two uppermost slanted surfaces extending between said
two flat parallel sides, the insert having a trough at the
top thereof, the trough being substantially orthogonal
along its entire length to the flat parallel sides, the trough
being between the two uppermost slanted surfaces.

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27

In the amendment presenting the change to claim 1, Applicant argued as
follows:

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Specifically, Claim 1 has been amended as indicated in
order to distinctly point out that the trough ... is
substantially orthogonal along its entire length to the two
flat parallel sides. A review of Denman '368,

1 particularly at figures 4 through 7 does not show this
2 feature.

3
4 Amendment filed 30 April 1993, page 2.

5 The Examiner was not totally satisfied with the amendment.

6 A telephone interview is said to have taken place on or about 19 May 1993.

7 Office action mailed 28 May 1993.

8 In the Office action of 28 May 1993, the Examiner entered an Examiner's
9 Amendment of claim 1 to read as follows [italicized matter added to claim 1 as
10 amended by Applicant; matter deleted in strikeout]:

11 A mine tool roof bit insert having two flat parallel
12 sides extending in the long dimension of the insert and
13 having two uppermost slanted surfaces extending
14 between said two flat parallel sides, the insert having a
15 trough at the top thereof, the trough *and the two*
16 *uppermost slanted surfaces* being *substantially parallel*
17 *and* substantially orthogonal along [~~its~~] *their* entire length
18 to the flat parallel sides, the trough being between the
19 two uppermost slanted surfaces.

20
21 In the Office action, the Examiner advised Applicant as follows:

22 Should the changes and/or additions be unacceptable to applicant, an
23 amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure
24 consideration of such an amendment, it MUST be submitted no later
25 than the payment of the Issue Fee.

26
27 Office action of 28 May 1993, page 2.

28 Applicant did not submit any amendment, paid the issue fee and the patent
29 issued on 17 May 1994.

1 Reissue application

2 At some point, the patent owner took note of the patent and essentially
3 discovered that: “Ops. There is a loose end with claim 1.”

4 To overcome, the loose end, the patent owner filed the reissue application on
5 appeal.

6 Unfortunately for the patent owner, the reissue application was filed more
7 than two years after the patent issued.

8 The reissue oath was signed by one John J. Prizzi, who is said to be
9 Assistant Secretary of Kennametal PC, Inc.

10 At this point, we note that Kennametal PC, Inc. is a different name from the
11 real party in interest identified in the Appeal Brief. We will assume Kennametal
12 PC, Inc. and Kennametal, Inc. identified in the Appeal Brief are the same entity or
13 that any difference is irrelevant.

14 The bottom line is that the reissue application was filed by the assignee and
15 the inventor did not sign the reissue oath.

16 After stating that the patent may be partly inoperative or invalid because of
17 an error said to have arisen without deceptive intention on the part of the
18 application, the reissue oath of 24 May 2002, states:

19 That the basis for the inoperativeness is by reason of the
20 patentee failing to particularly point out and distinctly
21 claim the subject matter which the applicant regards as
22 his invention, 35 U.S.C. 112, 2nd paragraph. Claim 1
23 recites that “the trough and the two uppermost slanted
24 surfaces being substantially parallel and substantially
25 orthogonal along their entire length to the two flat
26 parallel sides,” does not particularly point out and
27 distinctly claim the subject matter regarded as the
28 invention. Accordingly, this claim may be invalid.

1
2 Claim 1 of the reissue application, which is the claim before us, reads
3 as follows (underlined material added to patent claim 1 and bracketed matter
4 with strikeout deleted from patent claim 1—*see* 37 C.F.R. § 1.173(d)
5 (2006)):

6 A mine tool roof bit insert having two flat parallel sides extending in
7 the long dimension of the insert and having two uppermost slanted
8 surfaces extending between said two flat parallel sides, the insert
9 having a trough at the top thereof having a length that extends from
10 one of said to flat parallel sides to the other of said two flat parallel
11 sides [~~the trough and the two uppermost slanted surfaces being~~
12 ~~substantially parallel and substantially orthogonal along their entire~~
13 ~~length to the two flat parallel sides,~~] said trough along said entire
14 length being substantially orthogonal to said two flat parallel sides,
15 the trough being between the two uppermost slanted surfaces.

16
17 While the issue of whether a claim is indefinite is a question of law,
18 nevertheless as a matter of fact, both the Applicant and the Examiner now agree
19 that claim 1 of the patent is indefinite.

20 For example on page 5 of the Appeal Brief of 23 January 2004, the applicant
21 states:

22 The added language set out in the Examiner's
23 Amendment fails to particularly point out and distinctly
24 claim the invention. The trough cannot be both
25 substantially parallel and substantially orthogonal to the
26 two flat parallel sides. These directional orientations of
27 the trough are directly opposed to each other.
28

1 Applicant continues:

2 The plain meaning of this language that was added into
3 patented claim 1 is a contradiction and causes confusion
4 and uncertainty as to the scope of these limitations.

5

6 The Examiner essentially agrees:

7 Applicant has argued that the language added to
8 claim 1 in the Examiner's Amendment of 28 May 1993
9 was confusing under 35 USC 112(2) thus the added
10 language made the scope of the claim impossible to
11 determine. The specific confusion being that the trough
12 cannot be both parallel and orthogonal to the two flat
13 parallel sides, the specification says nothing about the
14 two uppermost slanted surfaces being parallel or
15 orthogonal, and the two uppermost slanted surfaces, as
16 seen in the figures, cannot be parallel or orthogonal to the
17 two flat parallel sides.

18

19 The [E]xaminer agrees that the language added in
20 the Examiner's Amendment might be confusing.
21 However, all claims, even those that may be rejected
22 under 35 USC 112(2), must be examined thus the
23 broadest possible scope is applied to the claims. For
24 claims rejectable under 35 USC 112(2) due to confusing
25 claim language, this entails interpreting the claims as best
26 as possible.

27

28 Examiner's Answer entered 07 November 2005, pages 6-7.

29 As will become apparent later in this opinion, we have difficulty
30 accepting some of the statements as set out in the second paragraph of the
31 quote from the Examiner's Answer.

32

1 Examiner's rejections

2 The Examiner has rejected the claims as being unpatentable under
3 35 U.S.C. § 251, fourth paragraph (“No reissued patent shall be granted
4 enlarging the scope of the claims of the original patent unless applied for
5 within two years from the grant of the original patent.”)

6 The Examiner has also rejected the claims under 35 U.S.C. § 251,
7 third paragraph, as being based on an improper reissue oath (“application for
8 reissue may be made and sworn to by the assignee of the entire interest if the
9 application does not seek to enlarge the scope of the claims of the original
10 patent.”)

11 Other findings as necessary appear in other portions of this opinion.

12

13 **C. The issue**

14 The issue on appeal is whether reissue claim 1 enlarges the scope of
15 claim 1 of the patent.

16 More particularly, as a matter which appears to us to be an issue of
17 first impression, does a claim which is indefinite have any scope, and if not,
18 does reissue claim 1 necessarily enlarge the scope of patent claim 1.

19

20 **D. Discussion**

21 We begin our discussion with an observation in a recent opinion of
22 our appellate reviewing court to the effect that § 251 is remedial in nature,
23 based on fundamental principles of equity and fairness, and should be
24 construed liberally. However, the remedial function of the statute is

1 limited.” *MBO Laboratories, Inc. v. Becton, Dickinson & Company*,
2 474 F.3d 1323, 1331, 81 USPQ2d 1661, 1667 (Fed. Cir. 2007).

3 The fundamental problem in this case is to determine the “scope” if
4 any of patent claim 1. Once that scope is determined, it can be compared to
5 the scope of reissue claim 1 to see if reissue claim 1 “enlarges” the scope of
6 patent claim 1.

7 Binding precedent tells us that a claim which is indefinite cannot be
8 unpatentable based on obviousness. Rather, the claim is unpatentable as
9 being indefinite. *See In re Steele*, 305 F.2d 859, 863, 134 USPQ 292, 295
10 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496
11 (CCPA 1970). We are of the opinion that cases like *Steele* and *Wilson*
12 foreclose the Examiner’s observation to the effect that indefinite claims must
13 be examined giving the claim the broadest possible scope by essentially
14 interpreting the claims as best as possible. Examiner’s Answer, page 7. The
15 subject matter of a claim which is indefinite cannot be compared to the prior
16 art to determine, *e.g.*, differences between the claim and the prior art.
17 Likewise, we are having a difficult time seeing how the claim could be
18 compared to a device said to infringe the claim.

19 In this case, for example, no matter how hard one wiggles—like the
20 stepsisters trying to squeeze into Cinderella’s glass slipper—one cannot read
21 the drawing figures on to patent claim 1. The drawings simply will not fit.
22 In fact, no device would fall within the scope of patent claim 1 because it
23 requires an element to be both parallel and orthogonal (i.e., perpendicular) to
24 another element. In the world of physics and geometry this is a “no-no.”

1 We are unable on this record to come up with any device which would
2 anticipate or infringe patent claim 1. Accordingly, we are left with a not so
3 good choice of holding essentially that patent claim 1 has no scope.

4 Reissue claim 1, however, is sufficiently definite to fall within the
5 requirements of 35 U.S.C. § 112, second paragraph. The “manufacture”
6 shown in Figs. 1 and 2 of Applicant’s drawing can be read onto reissue
7 claim 1. Thus, if a prior art reference described the manufacture of reissue
8 claim 1, it would anticipate the claim; if a manufacture like that shown in
9 Figs. 1 and 2 were being used without Applicant’s permission, it would
10 infringe reissue claim 1.

11 Binding precedent, as well as § 1412.03 of the *Manual of Patent*
12 *Examining Procedure* (8th ed., Rev. 5, Aug. 2006), tells us that a claim is
13 enlarged if it is so changed as to bring within its scope any structure which
14 was not within the scope of the original patent claims. In other words, the
15 scope of a claim is enlarged if it is broader in any respect than the original
16 patent claim, even though it may be narrower in other respects. See, e.g.,
17 *In re Rogoff*, 261 F.2d 601, 120 USPQ 185 (CCPA 1958); *In re Ruth*,
18 278 F.2d 729, 126 USPQ 155 (CCPA 1960); and *Tillotson, Ltd. v. Walbro*
19 *Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987).

20 In this case, we find that the manufacture of Figs. 1 and 2 of
21 Applicant’s drawings—if prior art—would anticipate or if used without
22 Applicant’s permission would infringe reissue claim 1, but would not
23 anticipate or infringe patent claim 1. It necessarily follows that reissue claim
24 1 enlarges the “scope” of patent claim 1, all contrary to the fourth paragraph
25 of 35 U.S.C. § 251.

1 We have not overlooked the fact that § 251 is to be applied in an
2 equitable manner. Why should equity concern us in this case? Because, the
3 amendment which causes the concern in this case was made by the
4 Examiner (not the current Examiner) in an Examiner's Amendment. As
5 employees of the Office, we all try to avoid mistakes. However, at the end
6 of the day, because we are human, we all make mistakes. We know the
7 Examiner who made the amendment knows that an element cannot be both
8 parallel and perpendicular to another element. Nevertheless, the mistake
9 was made.

10 On the other hand, the Examiner advised Applicant that if the
11 Examiner's Amendment was unacceptable, Applicant could file an
12 additional amendment under 37 C.F.R. § 312, which authorizes amendment
13 after a notice of allowance has been issued.

14 Apparently Applicant did not review the amendment before the patent
15 issued. Likewise, the loose end in patent claim 1 did not surface within the
16 2-year period during which a reissued could be applied for without any
17 concern for enlargement of scope.

18 To the extent we need to do so, we feel comfortable balancing the
19 equities in this case against the Applicant. Apart from the explicit warning
20 in the Examiner's Amendment accompanied by instruction on "what to do,"
21 we agree with the philosophy expressed our appellate reviewing court in the
22 context of a certificate of correction issue: "Moreover, it does not seem to
23 us to be asking too much to expect a patentee to check a patent when it is
24 issued in order to determine whether it contains any errors that require the
25 issuance of a certificate of correction. In this case, the omission of the

1 Program Printout Appendix from the '257 patent resulted in the absence of
2 approximately 330 pages of text from the specification. It would seem that
3 such an error would be readily apparent.” *Southwest Software, Inc. v.*
4 *Harlequin, Inc.*, 226 F.3d 1280, 1296, 56 USPQ2d 1161, 1173, (Fed. Cir.
5 2000). The error in the case before us is also “readily apparent.”

6 The decision of the Examiner rejecting the claims under 35 U.S.C.
7 § 251, fourth paragraph has not been shown to be erroneous.

8 Likewise, the decision of the Examiner rejecting the claims under 35
9 U.S.C. § 251, third paragraph has not been shown to be erroneous.

10 At first blush, the third paragraph rejection might appear to relate to a
11 procedural matter. However, the rejection turns on whether reissue claim 1
12 enlarges the scope of patent claim 1—which is a merits issue. Having
13 concluded that impermissible enlargement occurred, we have no occasion to
14 question the Examiner’s decision to treat the third paragraph issue as a
15 merits issue. We now affirm the Examiner’s third paragraph rejection.

16 What is curious to us is why the third paragraph rejection reached us
17 at all. We have not been able to divine from the record exactly why the
18 inventor could not have signed the reissue oath. The inventor’s address is
19 set out in the reissue oath as being located in Bristol, Virginia. So far as we
20 can tell, the inventor is available. When an inventor refuses to sign an
21 application or cannot be found, the provisions of 35 U.S.C. § 118 would
22 seem to be a possibility.

23

1 **E. Additional remarks**

2 We do not know whether Applicant has considered the possibility of a
3 certificate of correction to try to overcome the error in patent claim 1. We
4 express no views on whether a certificate of correction is appropriate and if
5 filed how a petition for a certificate of correction might or should be
6 decided.

7

8 **F. Decision and order**

9 Upon consideration of the record, including the copy of the patent file
10 submitted to the Board by the Applicant, and for the reasons given, it is

11 ORDERED that the decision of the Examiner rejecting claims
12 1-5 as being unpatentable under the fourth paragraph of 35 U.S.C. § 251 is
13 *affirmed*.

14 FURTHER ORDERED that the decision of the Examiner
15 rejecting claims 1-5 as being unpatentable under the third paragraph of 35
16 U.S.C. § 251 is *affirmed*.

17 FURTHER ORDERED that the provisions of 37 CFR § 1.136(a) are
18 not applicable to time periods for taking subsequent action.

Appeal No. 2007-0441
Reissue Application 10/155,945
Patent 5,311,959

1

2

AFFIRMED

FRED E. McKELVEY)
Senior Administrative Patent Judge)
)
)
) BOARD OF PATENT

ROMULO H. DELMENDO)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)

ALLEN R. MacDONALD)
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McK/lp

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