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In re Rief, et al. :
Reexamination Proceeding : DECISION ON PETITION
Control No. 90/004,654 : FROM DENIAL OF REQUEST
Filed: June 2, 1997 : FOR REEXAMINATION
For U.S. Patent No. 5,293,659 :

Receipt is acknowledged of a Petition from Denial of Request for Reexamination, filed by the requester on September 9, 1997 and entered in the file as paper No. 6

BACKGROUND

1. U.S. Patent No. 5,293,659 issued on March 15, 1994.
2. A request for reexamination was filed by the requester on June 2, 1997.
3. An order denying reexamination was mailed on August 13, 1997.

DISCUSSION

Petitioners set forth three grounds for vacating the order denying reexamination and for requiring the examiner to compare each claim to the "new record" put before the examiner by the request for reexamination.

First Contention (Portola)

Petitioner's first contend that the order should be vacated because it does not evaluate each piece of prior art independently or compare each new prior art patent to the claim as a whole. According to petitioners, the examiner has improperly expanded the holdings of In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) and the Recreative Technologies case, 38 USPQ2d 1776 (Fed. Cir. 1996) upon which the Portola case was based. In particular, petitioners argue that it was improper for the examiner to expand the meaning of Portola to equate "original prior art" with "equivalent or similar additional prior art" while simultaneously telling the Court that Portola was not decided correctly.

Petitioners further contend that the examiner improperly compared parts of the new prior art and parts of the old prior art to determine "equivalency" between such parts instead of comparing the new prior art to the single claim of the patent in dispute, thereby defeating the purposes of reexamination.

Petitioner's contentions in this regard are not well taken.

While the Office did not agree with the Portola decision and asked the Court which rendered that decision to rehear it en banc, the Office is bound by the Court's holding and must follow it under the principle of stare decisis.

Petitioners' contentions that the examiner should not have tried to equate original prior art with equivalent or similar prior art fail to address the fact that a substantial new question of patentability is shown by pointing out "how any questions of patentability raised are substantially different from those raised in the earlier prosecution of the patent before the Office." MPEP Section 2216. One very logical way to show whether or not such differences exist is to compare the prior art cited or applied in the patent prosecution with the new prior art cited in the reexamination request.

While an order granting or denying a request for reexamination must address that issue, i.e., how any questions of patentability raised are substantially different from those raised in the earlier prosecution, there is no requirement in the reexamination statutes or rules that an examiner must perform a Graham v. John Deere type analysis of each piece of prior art cited in a reexamination request, as petitioners contend. The case law cited to support petitioner's contention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986), dealt with an infringement proceeding, not a reexamination proceeding, and is not relevant here.

The order denying the request for reexamination fully discusses how any questions of patentability raised in the reexamination request are not substantially different from those raised in the earlier prosecution of U.S. Patent No. 5,293,659, which is both logical and reasonable in determining whether or not the reexamination proceeding raises a substantial new question of patentability.

Alleged Errors of Law

Petitioner's first contention is that in paragraphs 5 through 19, there is no comparison of any new item of prior art with the claim as a whole but only comparisons of parts of new prior art to parts of prior art previously of record. This contention is considered to be without merit for the reasons stated in the previous section.

Petitioner's second contention is that in sections 5 through 19 of the order denying reexamination, there is a new patentability standard set forth, i.e., "substantial equivalent" (to other prior art). This contention overlooks the explicit language of the reexamination statutes and rules, i.e., "substantial new question of patentability." To state that certain teachings in newly cited prior art are substantially equivalent to teachings in prior art of record is perfectly logical, reasonable and proper. The use of the term "substantial" is found in the reexamination statutes and rules and its use in a reasoned statement supporting a decision not to order reexamination appears eminently reasonable. To state that something is substantially equivalent to a previously considered prior art teaching is considered reasonably related to the issue of whether a particular question of patentability is or is not substantially different from an issue raised earlier in the prosecution of the patent for which reexamination is sought.

Petitioner's third contention is that in section 9, the issue of importance to a reasonable examiner is improperly determined by comparing only parts of new prior art to parts of prior art previously of record. This contention is not well taken for reasons stated above. The examiner's approach is considered very reasonable in light of the fact that he is charged with determining differences between questions patentability raised in the prosecution of the patent for which reexamination is sought and raised in the request for reexamination.

Petitioner's fourth contention is that in section 10, an issue is framed based on whether a valve is used to "drive side frames or any other structure" while such language is not found in either of the claims for which reexamination is sought. This argument is not well taken. In paragraph 10, in response to requester's assertion

that the Hofmann reference teaches the use of a symmetrical oscillating valve, the examiner pointed out that such limitations are not found in either claim 33 or 34. The examiner then added a further reason why it would not have been reasonable to consider combining Hofmann as suggested in any of the requester's proposed reference combinations, i.e., because the valve in Hofmann is not used to drive side frames or any other structure. This comment was made in the context of whether or not the Hofmann reference would be properly combinable with other references. Whether it is proper to combine references is a proper subject to discuss in determining whether a reference presents a substantial new question of patentability.

Petitioner's fifth contention is that in paragraphs 11, 13, 15 and 17 the distinction the examiner makes between brushes for cleaning/scrubbing on the one hand, and bristles for propulsion on the other hand, is a distinction which is not supported by the claims. This contention is without merit, also. The distinction made by the examiner is relevant to whether or not prior art reference teachings are properly combinable. As pointed out above, whether it is proper to combine references is a proper subject to discuss in determining whether a reference presents a substantial new question of patentability.

Direct Conflict in PTO Positions

Petitioners contend that the Office is taking inconsistent positions by rejecting claim 23 in a pending application of a requester, which is identical to claim 33 of the Rief patent No. 33, with respect to which reexamination is requested. The rejection is said to be based on identical prior art cited in the original Rief application.

Since the Office treats pending applications as confidential, 35 USC 122, no comment will be made concerning the statements set forth by petitioners regarding the application which is said to be pending.

However, the Office must follow the holdings of the Court of Appeals for the Federal Circuit. That Court has effectively estopped the Office from conducting a reexamination proceeding based solely on prior art that was previously cited during an earlier examination of the patent. Additionally, that decision has effectively estopped the Office from conducting a reexamination of a patent on different prior art which does not raise substantial new questions of patentability, e.g. because the prior art cited in the request for reexamination presents identical or substantially identical teachings as the prior art of record, which is the situation here.

Federal Circuit Decision on Rehearing Request

The order denying the request for reexamination pointed out that the Commissioner intended to file a request a Petition for Rehearing and Suggestion for Rehearing en banc of the Portola case. The Court denied that petition and request on September 16, 1997 and its mandate issued on September 18, 1997. A copy of the Court's decision is attached for petitioners' convenience.

DECISION

Accordingly, the petition is denied.

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Atch: Federal Circuit Order, In re Portola Packaging Inc.,
Order No. 96-1376, Mandate issued September 18, 1997.