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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIK STAATS and ROBIN D. LASH

Appeal 2009-007162¹
Application 11/503,541
Technology Center 2100

Decided: April 26, 2010

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, and
JAMES T. MOORE and ALLEN R. MacDONALD, *Vice Chief
Administrative Patent Judges*, FRED E. McKELVEY, *Senior Administrative
Patent Judge*, and JOHN A. JEFFERY, *Administrative Patent Judge*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-4 and 8-32.² We have jurisdiction under 35 U.S.C. § 6(b) (2008). We affirm.

¹ Appeal No. 2009-006496 (Appl'n 10/669,119) is related to this appeal.
See App. Br. 1.

STATEMENT OF THE CASE

The reissue application on appeal seeks a third reissue of U.S. Patent 5,940,600 (“the ‘600 patent”). As set out in more detail in our Findings of Fact, two earlier reissue patents have already issued.

Oral argument on the appeal was heard on July 8, 2009, before a panel consisting of Judges MacDonald, McKelvey and Jeffery. Upon consideration of the appeal, the Chief Judge expanded the panel to the current panel. Appellants were invited to present additional oral argument,³ but did not respond to the order. Since the time period for responding to the order has lapsed, we therefore decide this appeal without an additional hearing.

Appellants invented a method for establishing an isochronous channel within a computer system between a subset of plural nodes associated with various interconnected components (e.g., a video camera, VCR, printer, etc.). Figure 1 of the ‘600 patent illustrates the computer system of the present invention with these nodes. Figure 1 is reproduced below:

² Original patent claims 5-7 were cancelled. *See* “Amendment A” dated June 11, 2007.

³ *See* Order mailed Aug. 13, 2009 (giving Appellants the opportunity to request another oral hearing within seven days).

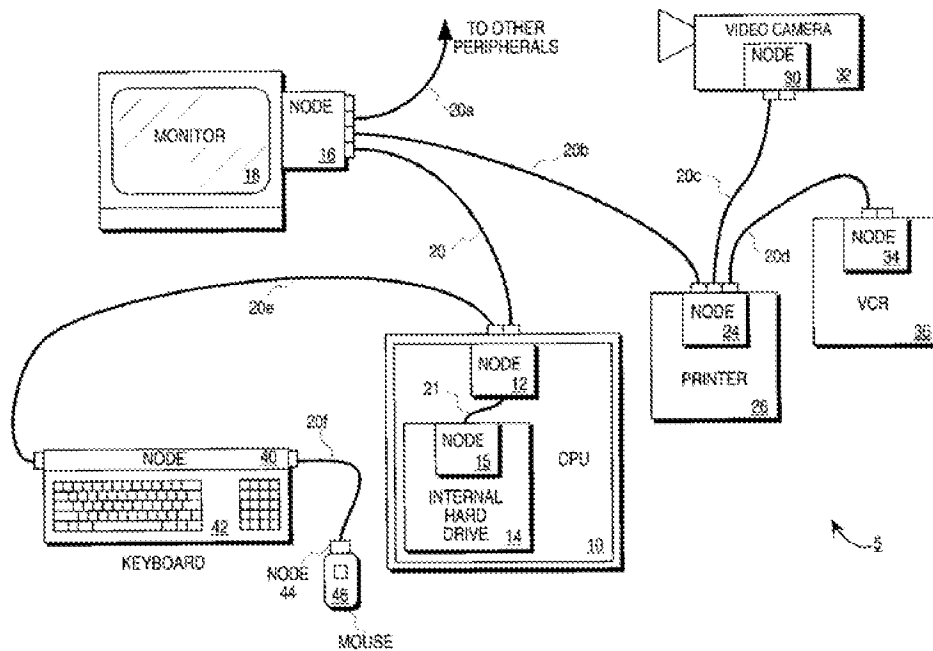


Figure 1 of the '600 Patent Illustrating a Computer System and Nodes

In one embodiment, the isochronous data channel includes a linked list of buffers that are used as temporary storage locations for data transmitted on the isochronous data channel. In another embodiment, the isochronous channel is established in which sender and listener clients are added by device drivers.⁴ Claim 12 is illustrative:

12. A method comprising:

establishing an isochronous channel within a computer system to receive isochronous data transmitted from a first device driver to a second device driver;

⁴ See generally '600 Patent, Abstract; col. 8, l. 34 – col. 10, l. 52; Figs. 1 and 4.

by the first device driver, adding a sender client configured to transmit the isochronous data to the isochronous channel and providing the sender client with a channel identifier;

passing a reference to the channel identifier from the first device driver to the second device driver; and

by the second device driver, adding a listener client to the isochronous channel by providing the listener client with the channel identifier.

1. The Examiner rejected claims 1-4 and 8-32 under 35 U.S.C. § 251 as being based upon a defective reissue declaration.⁵ Ans. 3.⁶
2. The Examiner rejected claims 12-32 under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two-year statutory period. Ans. 3-6.

THE REJECTION OF CLAIMS 1-4 AND 8-32 UNDER § 251

Appellants did not present any arguments pertaining to the Examiner's rejection of claims 1-4 and 8-32 under 35 U.S.C. § 251 as being

⁵ Original patent claims 1-5, 8, and 9 were amended during this proceeding. See "Amendment A" dated June 11, 2007.

⁶ Throughout this opinion, we refer to (1) the Appeal Brief filed June 17, 2008; (2) the Examiner's Answer mailed August 13, 2008; (3) the Reply Brief filed October 15, 2008; (4) the Supplemental Examiner's Answer mailed December 17, 2008 ("Supp. Ans."); and (5) the Reply Brief to the Supplemental Examiner's Answer filed February 16, 2009 ("Supp. Reply Br.").

based upon a defective reissue declaration. Ans. 3; App. Br. 9; *see also* Reply Br. 1-4. Accordingly, we summarily sustain this rejection.⁷

THE REJECTION OF CLAIMS 12-32 UNDER § 251

The Examiner found that the present reissue application impermissibly broadens the patented claims beyond two years from the original patent's issuance. The Examiner assumed that the present application is a proper continuation application of the originally-filed reissue application (09/932,846) ("the first reissue application"). Moreover, the Examiner found that Appellants indicated an intent to broaden the patented claims within two years. Ans. 3-6.

Nevertheless, the Examiner concluded that the present reissue application seeks to broaden the claims in an entirely different manner that is not covered by the declaration filed in the first reissue application. According to the Examiner, the public would therefore not have been notified of the unrelated broadening in this application within the statutory two-year time period. Ans. 3-14; Supp. Ans. 3-5.

Appellants acknowledge that the two continuation reissue applications (including the present application) were filed "to broaden the claims in different ways." App. Br. 5. And while Appellants acknowledge that they must present an intent to broaden within the two-year period to comply with the reissue statute, Appellants nonetheless contend that the eventual scope of

⁷ *See, e.g.*, Manual of Patent Examining Procedure (MPEP) § 1205.02, 8th ed., Rev. 7, July 2008 ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

broadening need not be specified within this time period. *Id.* According to Appellants, so long as the public is notified of *any* intent to broaden within two years, it is unnecessary to notify the public of the specific scope of broadening within that time period. App. Br. 5-7; Reply Br. 3-4.

The issue before us, then, is as follows:

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 12-32 under § 251 as impermissibly broadening the patented claims via reissue outside the two-year statutory period?

This issue turns on whether a continuing reissue application can broaden patented claims beyond the two-year statutory period in a manner unrelated to the broadening aspect that was identified within the two-year period.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

Original Patent

1. U.S. Patent 5,940,600 (“the original patent”) issued August 17, 1999.
2. In Figure 4, Appellants’ original patent discloses a conditional branching scheme for a linked list of buffers containing pointers that point to certain buffer addresses according to a buffer condition field in each buffer. ‘600 Patent, col. 2, ll. 57-58; col. 8, l. 33 – col. 9, l. 55; Fig. 4. This

embodiment involving a linked list of buffers supporting conditional branching is shown in Figure 4 reproduced below:

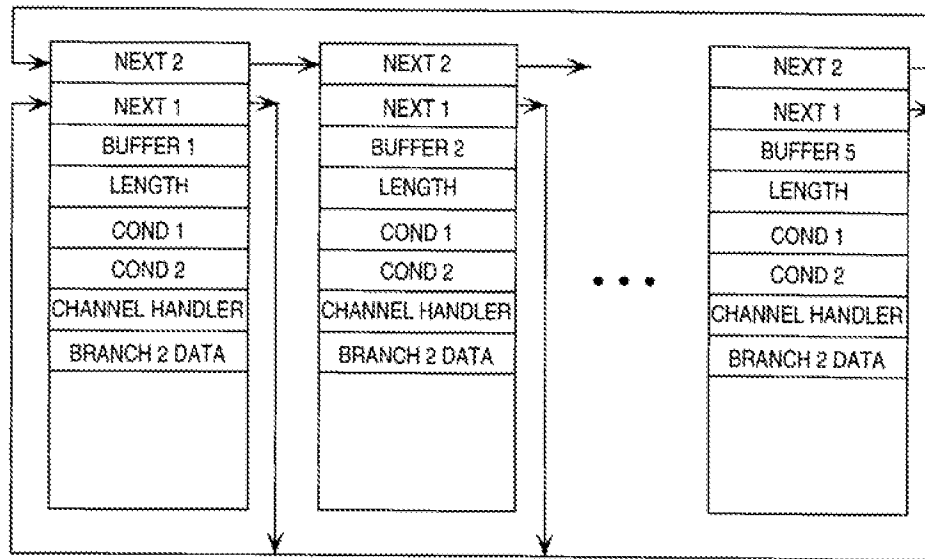


Figure 4 of the '600 Patent Showing a Linked List of Buffers Supporting Conditional Branching

3. Appellants' original patent discloses other embodiments where the CPU 10 can establish the isochronous channel without becoming part of the channel. For example, a channel can be established between only video camera 32 and VCR 36, and first and second drivers can be associated with the camera and VCR, respectively. In this embodiment, the camera driver would (1) establish the channel ID and add the camera as a sender client; (2) call the VCR driver; and (3) pass a reference to the channel ID. The VCR driver would then add the VCR as a listener client. '600 Patent, col. 9, l. 56 – col. 10, l. 52.

4. In this alternative embodiment, no linked list of buffers is required since the VCR can record video data directly. Isochronous data (i.e., video data) is transmitted from camera 32 to the VCR 36 without interrupting the CPU 10 (which is not a client of the isochronous channel). ‘600 Patent, col. 10, ll. 44-49.

4A. Claims 1-11 of the original patent all recite, in pertinent part, “a linked list of buffers configured to receive isochronous data transmitted within [the] computer system.” ‘600 Patent, col. 11, l. 5 – col. 12, l. 32 (independent claims 1, 8, and 9).

First Reissue Application

5. A first reissue application 09/932,846 was filed August 17, 2001 (“the first reissue application”) along with a preliminary amendment adding claims 12-17 directed to a computer readable medium and computer implemented process. These claims recited, among other things:

- (1) a linked list of buffers where each buffer comprises a data field for storing isochronous data;
- (2) a condition field for storing condition data;
- (3) first and second pointer fields for storing first and second pointers, respectively; and
- (4) evaluating the condition data in each buffer and using the first or second pointer to access a buffer.

Prelim. Amd’t Accompanying First Reissue Appl’n, filed Aug. 17, 2001.

6. A first declaration submitted in the first reissue application on August 17, 2001 [on the two-year anniversary of the patent] identified at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent.

First Reissue Appl'n, Decl. filed Aug. 17, 2001.

7. Appellants' remarks accompanying the preliminary amendment filed in the first reissue application indicate that "[c]laims 12-17 are supported in the patent disclosure, for example, at column 8, line 33 through column 9, line 55 and Figure 4." Remarks Accompanying First Reissue Appl'n, filed Aug. 17, 2001.

8. On February 19, 2002 [after the two-year anniversary of the patent], a second declaration was filed in the first reissue application identifying at least one error upon which the reissue was based as follows:

The failure to claim or to further claim subject matter disclosed in the specification pertaining to handling real time data transmitted on an isochronous channel within a computer system.

First Reissue Appl'n, Decl. filed Feb. 19, 2002.

9. On December 20, 2002, the Examiner rejected claims 1-17 in the first reissue application due to the reissue declaration's failure to specifically identify the error to be corrected. First Reissue Appl'n, Non-Final Rej. mailed Dec. 20, 2002, at 2-3.

10. On April 15, 2003, Appellants filed a third declaration in the first reissue application identifying at least one error upon which the reissue was based as follows:

The failure to claim or to further claim subject matter disclosed in the specification pertaining to a method for handling data transmitted on an isochronous channel using a linked list of buffers that includes the use of a condition field in each buffer.

First Reissue Appl'n, Decl. filed Apr. 15, 2003.

11. Based on the first reissue application, a first reissue of the original patent issued as US RE38,641 E on October 26, 2004.

Second Reissue Application

12. A second continuation reissue application 10/845,060 was filed May 12, 2004 ("the second reissue application"). This application was filed with claims identical to claims 1-11 of the '600 patent. *See* Second Reissue Appl'n, Claims filed May 12, 2004.

13. On May 12, 2004, the second reissue application was filed with a first declaration identifying at least one error upon which the reissue was based as follows:

The failure to claim or to further claim subject matter disclosed in the specification pertaining to a method for handling data transmitted on an isochronous channel using a linked list of buffers that includes the use of a condition field in each buffer.

Second Reissue Appl'n, Decl. filed May 12, 2004.

14. On November 19, 2004, the Examiner rejected claims 1-11 in the second reissue application due to a defective declaration since the identified error had already been corrected. Second Reissue Appl'n, Non-Final Rej. mailed Nov. 19, 2004 at 2.

15. In the same office action, the Examiner also rejected claims 1-6 and 8-11 under § 102 over a prior art reference, and noted that since "applicant has filed the same original claims in this application as in the parent, the art rejection from the parent case is repeated here." Second Reissue Appl'n, Non-Final Rej. mailed Nov. 19, 2004 at 2.

16. On July 5, 2005, Appellants filed an amendment that (1) amending claims 1 and 7-9, and (2) adding claims 12-18. Second Reissue Appl'n, Amd't filed July 5, 2005.

17. On July 5, 2005, Appellants filed a second declaration in the second reissue application identifying at least one error upon which the reissue was based as follows:

At least one error being relied upon as the basis for reissue is the inclusion of limitations pertaining to the sender client and/or the listener client "being a software driver routine" in claim 1. At least one further error being relied on as the basis for reissue is the inclusion of limitations pertaining to the sender client and/or the listener client "being a software driver routine" in claim 9.

Second Reissue Appl'n, Decl. filed July 5, 2005, at 1.

18. On August 19, 2005, the Examiner allowed claims 1-7 and 12-17. The Examiner, however, rejected claims 8-11 and 18 as unpatentable under the judicially-created doctrine of obviousness-type double patenting over claims 8-11 and 17 of U.S. Patent No. RE 38,641 E which was said to contain every element of the application claims. Second Reissue Appl'n, Final Rej. mailed Aug. 19, 2005 at 2-3.

19. The Examiner's reasons for allowance noted that "claims 1 and 13 include the limitations of each buffer comprising a data field and a condition field and the condition data in the condition field being evaluated to determine a next buffer from which to access isochronous data. The other independent claims also include these or similar limitations." Second Reissue Appl'n, Final Rej. mailed Aug. 19, 2005, at 3.

20. Appellants later filed a terminal disclaimer to overcome the double-patenting rejection. Second Reissue Appl'n, Terminal Disclaimer filed Oct. 21, 2005.

21. The Examiner subsequently allowed the application. Second Reissue Appl'n, Notice of Allowability mailed Jan. 29, 2007.

22. Based on the second reissue application, a second reissue of the original patent issued as US RE39,763 E on August 7, 2007.

Third Reissue Application (The Application on Appeal)

23. A third reissue application 11/503,541 (the application on appeal) was filed August 11, 2006 ("the present reissue application"). The third reissue application is said to be a continuation of the second reissue application.

24. The present reissue application was filed with claims identical to claims 1-11 of the '600 patent. *See* Present Reissue Appl'n, Claims filed Aug. 11, 2006.

25. On August 11, 2006, the present reissue application was filed with a first declaration identifying at least one error upon which the reissue was based as follows:

The failure to claim or to further claim subject matter disclosed in the specification pertaining to a method for handling data transmitted on an isochronous channel using a linked list of buffers that includes the use of a condition field in each buffer.

Present Reissue Appl'n, Decl. filed Aug. 11, 2006.

26. On December 8, 2006, the Examiner rejected claims 1-11 in the present reissue application due to a defective declaration since the identified error had already been corrected. Present Reissue Appl'n, Non-Final Rej. mailed Dec. 8, 2006, at 2.

27. On June 11, 2007, Appellants filed an amendment (1) amending claims 1, 8, and 9; (2) cancelling claims 5-7; and (3) adding claims 12-32. Present Reissue Appl'n, Amd't filed June 11, 2007.

28. Newly-added claims 12-32 call for, in pertinent part, an isochronous channel in which the sender and listener clients are added by device drivers. *See* Present Reissue Appl'n, Amd't filed June 11, 2007 (claims 12-32).

29. On June 11, 2007, Appellants filed a second declaration in the present reissue application identifying at least one error upon which the reissue was based as follows:

This is a broadening reissue to obtain claims that do not require all of the limitations of the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent.

At least one error being relied upon as the basis for reissue is the lack of any claims directed to an alternative embodiment of the invention for establishing an isochronous channel in which the sender and listener clients are added by device drivers. This error is being corrected by including new claims 12-32. . . .

The second declaration also identified additional limitations of claims 1, 8, and 9 that were not included in the issued claims and proposed to correct these errors by amending these claims. Present Reissue Appl'n, Decl. filed June 11, 2007, at 2.

30. On November 7, 2007, the Examiner rejected claims 12-32 under 35 U.S.C. § 251 as impermissibly broadening the original patent claims outside the two-year statutory period. According to the Examiner, newly-added independent claims 12, 20, and 27 are broader than the original patent claims since they omit limitations calling for the listener client being a software driver routine associated with sender and listener nodes of the computer system, respectively. Present Reissue Appl'n, Final Rej. mailed Nov. 7, 2007, at 2.

31. Appellants appealed the final rejection. Present Reissue Appl'n, Notice of Appeal, filed Jan. 16, 2008.

ANALYSIS

This is a case of first impression. Resolution of the case hinges on one fundamental question: Can a continuing reissue application broaden patented claims beyond the statutory two-year period in a manner *unrelated* to the broadening aspect that was identified within the two-year period? Put another way, is it enough under the law to merely present an *intent* to broaden that is limited to a particular aspect (e.g., a particular embodiment of the invention) within the two-year period, yet broaden in unforeseeable ways (e.g., pertaining to other embodiments) outside the two-year period?

To answer these questions, we first turn to the statute. Section 251 governs reissuing defective patents “deemed wholly or partly inoperative or invalid, . . . by reason of the patentee claiming more or less than he had a right to claim in the patent” 35 U.S.C. § 251, ¶ 1. Although this statute is “remedial in nature,” and “based on fundamental principles of equity and fairness, . . . not every event or circumstance that might be labelled ‘error’ is

correctable by reissue.” *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986). Notably, the statute mandates that “[n]o reissued patent shall be granted enlarging the scope of the claims of the original patent *unless applied for within two years from the grant of the original patent.*” 35 U.S.C. § 251, ¶ 4 (emphasis added).

This two-year limit codifies a long-standing equitable doctrine of laches applied to broadening reissue applications,⁸ and ensures that the public is timely notified of the intention to broaden patented claims. *See In re Graff*, 111 F.3d 874, 877 (Fed. Cir. 1997). Notice is critical since the potential expansion of the patentee’s patent rights via reissue likewise affects the public’s rights in an increased likelihood of infringing that expanded scope, notwithstanding the intervening rights provisions of § 252. *See* 35 U.S.C. §§ 271 and 252. The reissue statute therefore “balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights.” *Graff*, 111 F.3d at 877 (citation omitted). As such, the “public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.” *Id.*

In this appeal, Appellants’ original patent discloses two pertinent embodiments:

(1) a conditional branching scheme for a linked list of buffers containing pointers that point to certain buffer addresses according to a buffer condition field in each buffer (FF 2) (“the first embodiment”), and

⁸ P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. § 1 (West 1954), *reprinted in* 75 J. Pat. & Trademark Off. Soc’y 161, 205 (1993).

(2) an alternative embodiment requiring no linked list of buffers in which a channel is established between components of the system, and drivers are associated with the components. FF 4. In this embodiment, isochronous data is transmitted between components without interrupting the CPU (“the second embodiment”). *Id.*

Two years after the original patent issued, Appellants filed a first broadening reissue application. FF 5. Despite some technical defects with this filing, the broadening was nonetheless considered to be timely and limited to the first embodiment.⁹

But nearly six years later, in the present reissue application, Appellants seek to broaden the original patent claims in a manner germane to the second embodiment (*see* FF 29)—a broadening not mentioned in, or consistent with actions taken in connection with, the first (*see* FF 5-10) or second (*see* FF 12-20) reissue applications. Indeed, Appellants’ representative admitted this fact at the oral hearing.¹⁰

⁹ Although Appellants did not specify the nature of the broadening with particularity in identifying the error to be corrected in the originally-filed first reissue declaration, Appellants nevertheless concurrently added claims via a preliminary amendment that were *limited to the first embodiment*. *See* FF 5-6. Likewise, Appellants’ remarks accompanying the preliminary amendment indicate that the newly-added claims were supported by passages in the original patent’s disclosure commensurate with that embodiment. *Compare* FF 7 *with* FF 2. Appellants later cured the noted defect by filing another declaration [the third declaration] specifying that the error to be corrected via broadening pertained to the first embodiment. *See* FF 10.

¹⁰ The following dialogue occurred at the oral hearing:

Simply put, the broadening in the present reissue application is in a manner that was completely *unforeseeable* by the public within the two-year period following the original patent's issuance—a fact likewise admitted at the oral hearing.¹¹ Despite Appellants' arguments to the contrary (App. Br. 5-7; Reply Br. 3-4), permitting such an unforeseeable broadening nearly *eight years* after Appellants' original patent issued¹² simply runs counter to

JUDGE JEFFERY: But wasn't your original declaration really germane to a particular embodiment that is distinct from the embodiment that you're now trying to broaden claims?

MR. HULSE: Absolutely. Yeah, and I definitely would concede that. The current claims are broadening in a way that would not be covered by the original reissue declaration.

Transcript of Oral Hearing held July 8, 2009 ("Transcript"), at 4.

¹¹ The following dialogue occurred at the oral hearing:

JUDGE JEFFERY: But how would the public be on notice of such a broadening? You know, in this case, what, we're talking what, roughly 6 years later or so --

MR. HULSE: Absolutely.

JUDGE JEFFERY: -- where we're proceeding after an embodiment *that no one could have foreseen within the 2 years*.

MR. HULSE: Absolutely.

Transcript, at 6 (emphasis added).

¹² See FF 27-29 (noting that June 11, 2007 was when Appellants first indicated their intention to broaden claims directed to the second embodiment in the present reissue application).

the underlying public notice function of § 251—notice that must be timely to ensure meaningful reliance on the finality and certainty of patent rights.

See Graff, 111 F.3d at 877.

Unreasonable delays in broadening patented claims undercut this fundamental public reliance. As the Supreme Court indicates, “[e]very independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive claim.” *Miller v. Brass Co.*, 104 U.S. 350, 355 (1881). And “[t]he granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void.” *Id.* Thus, for broadening reissues, “the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent.” *Id.* at 356.

Here, Appellants chose not to broaden the patented claims in a manner directed to the second embodiment within the two-year statutory period, but instead waited nearly *eight years* after Appellants’ original patent issued to indicate their intention to broaden in this manner. *See* FF 27-29. Since this broadening was completely unforeseeable by the public within the two-year statutory period—a circumstance that is undisputed¹³—it runs counter to the public notice function underpinning § 251 and is therefore improper.

To hold otherwise would effectively give Appellants a license to unforeseeably shift from one invention to another via reissue well beyond the two-year statutory period. This tactic undermines the public notice

¹³ *See* n.8, *supra*, of this opinion.

function of § 251 and exacerbates uncertainty regarding the scope of patent protection on which the public can reasonably rely—particularly for patents with large numbers of disclosed embodiments.¹⁴

The key cases pertaining to broadening reissues do not change our conclusion. In *In re Doll*, 419 F.2d 925 (CCPA 1970), a reissue application was timely filed less than two years after the original patent issued adding broader claims (claims 20-31). *Id.* at 926. Over two years later, however, four additional broader claims were added (claims 32-35 copied from another patent). *Id.* Two years later, claims 32-35 were amended, and two additional broader claims (claims 42 and 43) were added. *Id.* Notably, claims 32-35, 42, and 43 were not only broader than the claims originally submitted in the reissue application (including claims 20-31 added in that application), they were also presented well after the two-year statutory period. *Id.*

This broadening was permissible under § 251 since the public was notified of the patentee's intention to broaden the claims within the two-year period via the reissue application, and the statute did not preclude further broadening beyond the two-year period during the course of prosecution. *Id.* *Accord Graff*, 111 F.3d at 877. In reaching this conclusion, the *Doll* court emphasized that § 251 permits broadening patented claims if “*applied for*” (i.e., an application is filed) within two years from the original patent's

¹⁴ See Transcript, at 11 (questioning whether the public could have foreseen filing a broadening continuing reissue application for a 90th embodiment beyond the two-year statutory period for a hypothetical application containing 100 embodiments, where the applicant intended to broaden claims to just a first embodiment within the two-year period).

grant. *Doll*, 419 F.2d at 928. The court also noted that the intervening rights provisions of § 252 provide adequate safeguards to the public in this circumstance. *Id.*

But a key fact in *Doll* distinguishes it from the present appeal. The reissue oath in *Doll* referred specifically to correcting errors via broadening *pertaining to a particular embodiment*, namely the embodiment of Figure 4 of the original patent. *Id.* at 927-28.¹⁵ Claims 20-31 were therefore added via reissue for that purpose. *See id.* Notably, it was undisputed that later-added claims 32-35, 42, and 43 were broader than claims 20-31 and, like claims 20-31, pertained to the embodiment of Figure 4. *Id.*

Although the *Doll* court held that this broadening beyond the two-year statutory period was permissible, the broadening nevertheless pertained to the specific embodiment identified in the original reissue oath—a factual distinction that Appellants’ representative readily acknowledged at the oral hearing.¹⁶ To the extent that this distinction was addressed in *Doll* in

¹⁵ *Accord In re Wittry*, 489 F.2d 1299, 1302 (CCPA 1974) (noting that “the reissue oath in *Doll* stated that none of the patent claims afforded protection to a *specified embodiment* of the invention covered by the new reissue claims.”) (emphasis added).

¹⁶ The following dialogue occurred at the oral hearing:

JUDGE JEFFERY: In the reissue declaration in *Doll*, they specifically identified Figure 4, Figure 4 embodiment, and the broadened claims were germane to that embodiment after the 2-year period which was fine. *That’s distinct from your situation.*

MR. HULSE: *It absolutely is*, and to the extent that *Doll* even deals with that issue it was to a separate rejection. It wasn’t for the impermissible broadening rejection.

connection with determining whether the reissue oath was adequate as Appellants contend,¹⁷ it is of no consequence here, for the fact remains that the broader claims filed beyond the two-year statutory period in *Doll* were commensurate with the embodiment identified in the original reissue oath. *See Doll*, 419 F.2d at 927-28. As such, in *Doll*, the public was seasonably notified of the *manner* in which the claims would be broadened (i.e., with respect to the embodiment of Figure 4), although this broadening occurred beyond the two-year statutory period.¹⁸

This timely notice, however, does not exist in the present appeal. Unlike *Doll*, Appellants seek to broaden the patented claims in the present reissue application in a manner pertaining to a different embodiment than that specified in the originally-filed reissue declaration (*see* FF 29)—a manner totally unforeseeable when that declaration was filed nearly six years earlier. *See* FF 5-7. As we indicated previously, since this practice runs counter to the public notice function of § 251, it is improper under that statute.

To be sure, the agency rule governing reissue declarations does not require specifying all errors to be corrected via reissue. Rather, reissue declarations need only specify “*at least one error* being relied upon as the

Transcript, at 10-11 (emphases added).

¹⁷ *See* Transcript, at 10-11.

¹⁸ *See also Buell v. Beckestrom*, 22 USPQ2d 1128, 1131-32 (BPAI 1992) (non-precedential) (holding that § 251 did not preclude presenting claims via a timely-filed divisional reissue application after the two-year statutory period that were broader than the patented claims).

basis for reissue.” 37 C.F.R. § 1.175(a)(1) (emphasis added). A similar provision exists for continuing reissue applications.¹⁹ Despite their breadth, however, these provisions must be interpreted in light of the critical public notice function for broadening reissue applications underpinning § 251. As such, the rules cannot circumvent this statutory mandate, but should be read consistent with the statutory mandate.

Moreover, the Manual of Patent Examining Procedure notes, quite broadly, that “[w]here *any* intent to broaden is *unequivocally* indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.” MPEP § 1412.03(IV), 8th ed., Rev. 7, July 2008 (emphases added). The MPEP further explains that “a broadened claim may be presented in a reissue application after the two years, even though the broadened claim presented after the two years is *different* than the broadened claim presented within the two years.” *Id.* (emphasis added).

Appellants seize upon this ambiguous expansive language in the MPEP to support the contention that the MPEP permits broadening claims in any manner after two years so long as “*any* intent to broaden” was presented within two years which, according to Appellants, they have done. App. Br. 7; Reply Br. 3-4. Although Appellants cite to an earlier version of the

¹⁹ See 37 C.F.R. § 1.175(e) (noting that continuing reissue applications require identifying “*at least one error* in the original patent which has not been corrected by the parent reissue application or an earlier reissue application”) (emphasis added).

MPEP in the Briefs,²⁰ Appellants are nonetheless correct that the MPEP seemingly indicates as much given this broad language. Notably, however, the latest revision of the MPEP qualified this broad language by mandating that “any intent to broaden” must be “*unequivocally* indicated”—a requirement not satisfied by merely stating that the patent is inoperative by claiming “*more or less*” that applicant had a right to claim. MPEP § 1412.03.

Considering the MPEP passage as a whole, the added qualification could merely pertain to ensuring that the declaration was “unequivocal” with respect to articulating the intent to broaden generally (as opposed to narrowing), and not pertain to the specific manner of the broadening. But even assuming, without deciding, that this is the case, we still are unconvinced that the law permits broadening in a *completely unforeseeable*

²⁰ We reach this conclusion in view of Appellants’ cited quotations from passages from MPEP § 1412.03 that omit certain passages that were inserted in the July 2008 revision. For example, Appellants quote the MPEP as stating, in pertinent part, “[w]here any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.” App. Br. 7. The quotation, however, omits the term “unequivocally” that was inserted between the terms “is” and “indicated” in that passage in the July 2008 revision. *See* MPEP § 1412.03. Appellants’ quotations also omit the following sentence added to the latest revision: “(Note: A statement that ‘the patent is wholly or partly inoperative by reason of claiming more or less that applicant had a right to claim’ is NOT an unequivocal statement of an intent to broaden.” *See id.* These revisions were noted at the oral hearing. Transcript at 5.

manner after two years as Appellants have done here, particularly when considering the MPEP together with the reissue statute and its crucial public notice function.

Section 251 provides that “the Director may issue several reissued patents for *distinct and separate parts* of the thing *patented . . .*” 35 U.S.C. § 251, ¶ 2 (emphases added). This provision has been interpreted as enabling—not limiting—to ensure that applicants are not placed under any greater burden regarding divisional or continuation reissue applications as compared to divisions and continuations of original applications, so long as the statutory requirements specific to reissue applications are met. *Graff*, 111 F.3d at 876-77.

That is, the requirements for continuation and divisional reissue applications are commensurate with those for continuation and divisional applications for original applications, with the added requirement that the statutory reissue requirements must also be met. *See id.* A divisional application is filed to cover a particular invention that is independent or distinct from other inventions that are claimed in one application. *See* 35 U.S.C. § 121. “A continuation application is a second application for the *same invention claimed in a prior nonprovisional application* and filed before the prior application becomes abandoned or patented.” MPEP § 201.07 (emphasis added). Both applications, however, can claim the benefit of the filing date of their respective original applications. *See* 35 U.S.C. §§ 120 and 121.

This distinction between divisional and continuation applications applies as well to reissue applications. *See Graff*, 111 F.3d at 876-77. As noted above, § 251 enables the issuance of “several reissued patents for

distinct and separate parts of the thing patented . . .” 35 U.S.C. § 251, ¶ 2 (emphases added). But continuation reissue applications are not ordinarily filed “for distinct and separate parts of the thing patented” as called for in this section. MPEP § 1451(II). Rather, the “distinct and separate parts of the thing patented” are more commensurate with independent and distinct inventions that would be appropriate for divisional reissue applications. *See* MPEP § 1451(I).

Inventions are distinct if (1) the inventions as claimed are not connected in at least one of design, operation, or effect, and (2) at least one invention is patentable (novel and nonobvious) over the other. MPEP § 803(II). But when claims define the same essential characteristics of a single disclosed embodiment of an invention, the “claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.” MPEP § 806.03.

In the present reissue application, newly-added claims 12-32 call for, in pertinent part, an isochronous channel in which the sender and listener clients are added by device drivers (i.e., the second embodiment). FF 28. By being directed solely to the second embodiment, these claims are therefore directed to an invention that is independent and distinct from that claimed in original patent, as well as the first and second reissue applications (i.e., the first embodiment). *See* FF 4A, 5, 12, and 16-19.

While § 251, ¶ 2 permits reissue applications for “distinct and separate parts of the thing patented” (i.e., independent and distinct inventions), the other statutory requirements for reissue applications must still nevertheless be met. *See Graff*, 111 F.3d at 876-77. And these other requirements include “applying for” such an independent and distinct invention via a

reissue application (e.g., a divisional reissue application) within two years of the original patent's grant. *See* 35 U.S.C. § 251, ¶ 4; *see also Doll*, 419 F.2d at 928. That has simply not been done in this case for the independent and distinct invention pertaining to the second embodiment. Indeed, Appellants waited nearly *eight years* after Appellants' original patent issued to indicate their intention to broaden in this manner (*see* FF 27-29)—an unreasonable delay.²¹

The U.S. Supreme Court all but said as much in *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463 (1924). There, a divisional application was filed approximately five years after the parent application was filed in February 1910, but before the parent application issued in 1916. *Id.* at 464. In June of 1918, however, an amendment was filed in the divisional application adding broader claims that were later patented. *Id.* at 464-65. Notably, the broadened claims added via this amendment were first presented to the Patent Office *eight years and four months* after the original application was filed. *Id.* at 465.

²¹ Although the present reissue application is considered to be a broadening reissue despite the added claims 12-32 being directed to an independent and distinct invention (*see* FF 29), we note in passing that the mere failure to file a divisional application on disclosed, but unclaimed patentably distinct inventions during prosecution is not an error correctable by reissue. *See Weiler*, 790 F.2d at 1581-83; *see also In re Mead*, 581 F.2d 251 (CCPA 1978). Similarly, deliberately failing to file continuing applications to cover disclosed but unclaimed subject matter in the original application is likewise uncorrectable via reissue. *See In re Serenkin*, 479 F.3d 1359, 1362-63 (Fed. Cir. 2007).

The Court held this delay was unreasonable, noting that the patentee “Kane did not originally intend to assert these amended claims, because he considered their subject-matter one merely of design and not of invention, and the inference is fully warranted that the intention to do so was not entertained prior to 1918.” *Id.* The Court noted that during all of this time, the subject matter of the broadened claims “was disclosed and in general use, and Kane and his assignee . . . simply stood by and awaited developments.” *Id.* This was not, however, “the simple case of a division of a single application for several independent inventions, . . . but [rather] a case of *unreasonable delay and neglect* on the part of the applicant and his assignee in bringing forward claims *broader* than those originally sought.” *Id.* at 465-66 (emphases added).

In reaching its decision, the Court relied heavily on equitable principles, particularly as they applied to delays in correcting errors via reissue applications,²² and adopted a similar two-year time limit for divisional applications. *Id.* at 471. Although the Court later held that *Webster’s* presumptive two-year time limit was dictum, the Court nevertheless “ratified prosecution laches as a defense to infringement actions involving new claims issuing from divisional and continuation applications that prejudice intervening adverse public rights.” *Symbol Techs., Inc. v. Lemelson Med., Educ. & Res. Found.*, 277 F.3d 1361, 1364 (Fed. Cir. 2002) (citing *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938) and *Gen. Talking Pictures Corp. v. W. Elec. Co., Inc.*, 304 U.S. 175

²² See *id.* at 466-69 (discussing cases adopting an equitable two-year time limit to correct errors via broadening reissue applications).

(1938)). That is, the Court ratified the doctrine of prosecution laches in *Crown Cork* and *General Talking Pictures*, but did not apply it in those cases in the absence of intervening rights.

But broadening patented claims via reissue by its very nature prejudices intervening adverse public rights since the public is entitled to rely on the patentee's rights that existed before the patent's error was corrected (i.e., before the broadening). *See* 35 U.S.C. § 252. Therefore, the doctrine of prosecution laches is particularly applicable in reissue. Indeed, these very equitable principles were codified in 35 U.S.C. §§ 251 (reissue statute) and 252 (intervening rights regarding reissued patents).²³

Webster is therefore analogous to the present reissue application. Like the divisional application in *Webster*, the present reissue application was filed such that it was copending with its parent application (*see* FF 22-23)—a continuation reissue application that was itself filed during the copendency of the first reissue application (*see* FF 11-12). That is, both the divisional application in *Webster* and the present reissue application were timely filed in terms of their copendency with their respective parent applications to obtain the benefit of the earlier-filed applications. *See* 35 U.S.C. §§ 120 and 121.

But mere continuity to the parent application under §§ 120 and 121 is not enough to foreclose the doctrine of prosecution history laches in a manner commensurate with the delay in *Webster*. *See In re Bogese*, 303 F.3d 1362, 1367 (Fed. Cir. 2002) (citing *Webster* as an example of prosecution history laches). Where, as here, Appellants waited nearly *eight*

²³ *See* n.6, *supra*, of this opinion.

years after their original patent issued to indicate their intention to broaden claims to the independent and distinct invention pertaining to the second embodiment (*see* FF 27-29), we see no reason why this situation should be treated any differently than *Webster*. In this circumstance, the public can reasonably infer that Appellants had no such intention and therefore dedicated this subject matter to the public.²⁴

To hold otherwise would eviscerate the public notice function of § 251 by essentially giving patentees a license to unforeseeably shift from one invention to another via reissue well beyond the two-year statutory period. This tactic not only exploits latent subject matter that is reasonably presumed to be dedicated to the public by Appellants' own actions, but also circumvents the countervailing public reliance interest in the certainty and finality in patent rights guaranteed by the two-year statutory period. *See Graff*, 111 F.3d at 877.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 12-32 under 35 U.S.C. § 251. Therefore, we will sustain the Examiner's rejection of those claims.

CONCLUSION

Appellants have not shown that the Examiner erred in rejecting claims 1-4 and 8-32 under § 251.

²⁴ *See Sontag Chain Stores Co., Ltd. v. Nat'l Nut Co. of Cal.*, 310 U.S. 281, 291 (1940) (“[D]ue diligence must be exercised in discovering the mistake in the original patent, and that, if . . . sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public”) (quotation marks and citation omitted).

ORDER

The Examiner's decision rejecting claims 1-4 and 8-32 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Nhl/pgc

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