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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW HOWARD FRONK, RODNEY LYNN BORUP, JAY
S. HULETT, BRIAN K. BRADY, and KEVIN M. CUNNINGHAM

Appeal 2010-004537
Application 10/720,005
Technology Center 1700

Before ALLEN R. MACDONALD, *Vice-Chief Administrative Patent Judge*,
and MICHAEL P. COLAIANNI and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 9-172 in reissue application 10/720,005. Reissue application 10/720,005 seeks to reissue U.S. Patent 6,372,376 B1, issued April 16, 2002 (the '376 Patent). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention is directed to a PEM (Proton Exchange Membrane) fuel cell having contact element comprising a corrosion-susceptible metal substrate having a protective polymer coating including electrically conductive particles. (Col. 2, ll. 18-41.)

Claims 1 and 9 are illustrative (with underlining and brackets showing additions and deletions relative to the original claims):

1. In a PEM fuel cell having at least one cell comprising a pair of opposite polarity electrodes, a membrane electrolyte [intedacent] interjacent said electrodes for conducting ions therebetween, and an electrically conductive contact element having a working face confronting at least one of said [electrodessfor] electrodes for conducting electrical current from said one electrode, the improvement comprising: said contact element comprising a corrosion-susceptible metal substrate and an electrically conductive, corrosion-resistant protective coating on said face to protect said substrate from the corrosive environment of said fuel cell, said protective coating comprising a mixture of electrically conductive particles dispersed throughout an oxidation-resistant and acid-resistant, water-insoluble polymeric matrix and having a resistivity no greater than about 50 ohm-cm, said mixture comprising graphite particles having a first particle size and other electrically conductive particles selected from the group consisting of gold, platinum, nickel, palladium, rhodium,

niobium, titanium carbide, titanium nitride, titanium diboride, chromium-alloyed titanium, nickel-alloyed titanium, rare earth metals and carbon, said other particles having a second particle size less than said first particle size to enhance the packing density of said particles.

9. A product comprising:

a fuel cell comprising a bipolar plate and an electrically conductive corrosion-resistant protective coating over the bipolar plate, the coating comprising a water-insoluble polymer and a plurality of first electrically conductive particles, and a plurality of second electrically conductive particles, the first particles being larger than the second particles, the first particles forming interstices therebetween and the at least a portion of the second particle filling the interstices.

Appellants seek review of the Examiner's rejection of claims 9-172 under 35 U.S.C. § 251 as being broadened in a reissue application outside the two year statutory period.

ISSUE

The issue presented by this appeal is:

Did the Examiner err in determining that Appellants' intent to file a broadening reissue was not expressed until after two years from the issue date of the '376 Patent?

PRINCIPLES OF LAW

"No 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.

The Appellant's mere reiteration of the statutory language "more or less" does not clearly identify the error to be corrected by reissue, because it does not indicate whether the patent is partly inoperative because the original claims are too broad in scope, or whether the patent is partly inoperative because the original claims are too narrow in scope. *Ex parte Tanaka*, 93 USPQ2d 1291, 1297 (BPAI 2009) (Precedential) (citing *e.g.*, *Ex parte Oetiker*, 1997 WL 1883795, Appeal No. 96-4146 (BPAI 1997) (holding that a reissue declaration which merely repeats the disjunctive statutory language that the error was one of claiming "more or less" than the patentee had a right to claim is an insufficient statement of error to satisfy 35 U.S.C. § 251)).

[T]he public is entitled to be put on notice as to the particular error which a patentee seeks to correct by reissue without in some way imposing a degree of uncertainty as to the specific nature of that error. . . . Thus, merely repeating the disjunctive statutory language (*i.e.*, "more or less"), as appellant has done here, improperly creates an ambiguity which deprives the PTO and the public of appropriate notice as to the specific type of error which the patentee seeks to correct by a reissue. . . . Having failed to positively and unequivocally specify the statutory error for which a reissued patent is sought in any of the reissue declarations, appellant has not satisfied the provisions of § 251. For this reason alone, the examiner's rejection of the appealed claims under § 251 is sustainable.

Oetiker, 1997 WL 1883795 at *5.

Admittedly, appellant's counsel states on page 19 of the main brief that appellant is "seeking a narrowed reissue patent . . ." Appellant's counsel further suggests on page 26 of the main brief that statements made by him over his signature during prosecution be considered "as if made under oath." Statements made by appellant's counsel over his signature but not under oath or declaration are not acceptable as a substitute for or a supplement to the oath or declaration required under 37 CFR §

1.175(a). The necessity for such an oath or declaration is absolute.

Id., at *5-6.

FACTUAL FINDINGS

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

1. The '376 Patent issued on April 16, 2002.
2. On November 21, 2003, less than two years after the '376 Patent issued, Appellants filed the reissue application on appeal. (Reissue Application Transmittal, p. 1.)
3. Appellants filed a Reissue Application Declaration form PTO/SB/51 (02-01) along with the reissue application, in which Appellants declared that they believed the original patent to be wholly or partly inoperative or invalid by checking the box next to the statement "by reason of the patentee claiming more or less than he had the right to claim in the patent." (Reissue Application Declaration entered November 21, 2003, p. 1.)
4. The Reissue Application Declaration form reads "[a]t least one error upon which reissue is based is described below. ***If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening.***" (Reissue Application Declaration entered November 21, 2003, p. 1) (emphasis added.)
5. Under this statement, Appellants declared:

The amendment to claim 1 corrected an inadvertent error in claim 1. The word "no" should have been in the claim when the limitations of claim 12 were incorporated into

claim 1 by amendment (Paper No. 4) dated June 25, 2001 during the prosecution of United States Patent No. 6,372,376.

(Reissue Application Declaration entered November 21, 2003, p. 1.)

6. On October 20, 2004, more than two years after the '376 Patent had issued, Appellants first attempted to add broader claims 9-84, stating in the accompanying remarks that “[t]his Reissue application, as filed, was a broadening reissue application” in part due to the addition of the word “no” in the phrase “a resistivity no greater than about 50 ohm-cm” recited in claim 1. (Preliminary Amendment filed October 10, 2004, p. 20.)
7. On September 26, 2005, more than two years after the '376 Patent had issued, Appellants presented claims 9-172. (Preliminary Amendment filed September 26, 2005.)

ANALYSIS

There is no dispute that claims 9-172, which were added more than two years after the '376 Patent had issued (FF 6-7), are broadening claims. Thus, in order for the addition of these claims to be proper, the reissue application, originally filed within two years of the issue date of the '376 Patent, must have been intended to be a broadening reissue. *In re Doll*, 419 F.2d 925, 928 (CCPA 1970) (holding that the statute does not prevent submission of original claims, broader than both the original patent claims and the original broadening reissue claims, more than two years after the grant).

In the instant case, we cannot agree with Appellants' contentions that the statement "by reason of a patentee claiming more or less than he had a right to claim in the patent" in the Reissue Application Declaration is a clear statement of intent to file a broadening reissue application. (App Br. 9.) Appellants' position is expressly contrary to precedent on this very issue. *See Tanaka*, 93 USPQ2d at 1297 (citing *Oetiker*.)

In addition, as the Reissue Application Declaration makes clear: if the reissue sought is a broadening reissue, Appellant is required to state as such in the Declaration along with an explanation of the nature of the broadening. (FF 4.) In the present case, Appellants' description fails to indicate that the reissue is a broadening reissue and does not explain the nature of the broadening. (FF 5.) Appellants only indicate that there was an "inadvertent error" without stating that the correction of the error amounted to a broadening of the claims. (FF 5.) As such, Appellants' Reissue Application Declaration failed to provide the required notice to the public that Appellants intended to broaden the claims of the '376 Patent. *Oetiker*, 1997 WL 1883795 at *5. Accordingly, Appellants' argument that the Examiner was required to make findings that intent may be inferred from the reissue application declaration is not well taken. (App. Br. 8-9.)

Appellants' belated explanation of why the amendment to claim 1 broadens the claims of the '376 Patent in the preliminary amendment of October 20, 2004 and in the Appeal Brief (FF 6; App. Br. 11) are insufficient to rectify the deficiencies of the Reissue Application Declaration. Arguments of counsel cannot take the place of or supplement the Reissue Application Declaration. *Oetiker*, 1997 WL 1883795 at *5-6. Therefore, the Examiner did not err in rejecting claims 9-172 under 35

U.S.C. §251 as being directed to a broadening reissue improperly filed after two years from the issue date of the '376 Patent.

As to the Examiner's new ground of rejection on pages 3-4 of the Answer that the oath or declaration filed with the reissue application is defective because certain amendments were not accompanied by a supplemental declaration, we agree with Appellants that 37 C.F.R. § 1.175² only requires submission of such supplemental declarations prior to allowance. (Reply Brief 1-2.) Therefore, we do not uphold this aspect of the Examiner's reasoning for rejecting claims 9-172.

DECISION

We affirm the Examiner's rejection of claims 9-172 under 35 U.S.C. § 251.

TIME PERIOD

² 37 C.F.R. §1.175 recites, in pertinent part:

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph *must be submitted before allowance and may be submitted:*

- (i) With any amendment prior to allowance; or
- (ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection. (Emphasis added.)

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1) (2009).

ORDER
AFFIRMED

ack

cc:

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