

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHERYAR DURRANI
and LARRY RODGER WARNER

Appeal No. 00-0910
Application No. 08/821,176

ON BRIEF

Before CALVERT, STAAB, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-11, all the claims pending in the application.¹

¹The amendment filed November 23, 1998 (Paper No. 7), while approved for entry by the examiner (see the advisory letter mailed December 2, 1998 (Paper No. 8)), has not been physically entered. Upon return of this application to the examiner's jurisdiction, this oversight should be corrected.

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Appellants' invention pertains to a modular steering wheel and airbag combination, and in particular to a worm gear drive arrangement for attaching said combination to the steering column of a vehicle. A further understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the appendix to appellants' supplemental brief.

By way of background, the present application is a continuation-in-part of U.S. Patent 5,692,770 to Scharboneau. The Scharboneau patent lists four (4) coinventors, one of whom, Sheryar Durrani, is also listed as one of the two (2) coinventors of the present application. Thus, the present application and the Scharboneau patent share one common inventor, namely Sheryar Durrani. As a further point of information, the present application and the Scharboneau patent currently are not commonly assigned. The specification of the present application includes all of the subject matter disclosed in the Scharboneau patent, and in addition includes Figures 16 and 17 drawn to another arrangement for attaching the modular steering wheel and airbag combination to a steering column. The present application and the Scharboneau

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patent are both related to and based upon provisional application No. 60/003,934, filed September 15, 1995.

The sole reference relied upon by the examiner in the final rejection is:

Scharboneau et al. (Scharboneau) 5,692,770 Dec. 2,
1997
(filing date Oct. 24,
1995)

Claims 1-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Scharboneau.

Claims 1-11 stand further rejected under the judicially created doctrine of double patenting over the claims of Scharboneau "since the [appealed] claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (answer, page 3).

Reference is made to appellants' main, supplemental and reply briefs (Paper Nos. 11, 17 and 22) and to the examiner's answer (Paper No. 20) for the respective positions of appellants and the examiner regarding the merits of these rejections.

The Double Patenting Rejection

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We shall take up first for consideration the double patenting rejection based on the Scharboneau patent.

At the outset, we observe that during examination of the parent application, the PTO made a restriction requirement requiring applicants therein to elect for prosecution in that case claims directed to either a modular steering wheel and airbag combination or a method of assembling a steering wheel and airbag. Applicants elected to prosecute the claims directed to the modular steering wheel and airbag combination. In that the above noted restriction requirement did not involve restriction between the various aspects of the modular steering wheel and airbag combination claimed in the Scharboneau patent and the present application, and in that the subject matter claimed in the present application is, for the most part, also disclosed in the application that matured into the Scharboneau patent, it appears that, as a broad proposition, appellants were not prevented by the restriction requirement made in the parent application from claiming the

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subject matter of the presently appealed claims in the parent application.²

Looking at the examiner's rationale in rejecting the appealed claims under the judicially created doctrine of double patenting, the examiner states (answer, pages 3-4):

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. That is, both the claims of the patent and the application claim a modular steering wheel and airbag combination comprising a steering wheel assembly and an airbag assembly wherein the steering wheel assembly includes a hub plate and "structure to secure the hub plate to a steering column."

Furthermore, there is no apparent reason why the applicant was prevented from presenting claims corresponding to those of the instant application

²In comparing the disclosures of the parent application and the present continuation-in-part application, we appreciate that Figures 16 and 17 and the portions of the specification describing said figures were added to the disclosure of the present application. Accordingly, to the extent any of the presently appealed claims are directed to features disclosed exclusively in Figures 16 and 17, such claims obviously could not have been presented in the parent application.

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during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804. The examiner notes that the patent disclosure provides full support for the claims of the instant application, i.e. the claims of the instant application read on at least figure 5 and 6A of the patent.

Appellants argue on pages 8-10 of the main brief that the present case is distinguishable from *In re Schneller* in that here there are several reasons why claims corresponding to the appealed claims could not have been presented during prosecution of the application that matured into the Scharboneau patent. Specifically, appellants argue that (1) the claims in the present application will not lead to an unjustified time wise extension of the right to exclude granted in the Scharboneau patent because any claims allowed from the present application will expire on the same date as the claims of the Scharboneau patent, (2) "the present application is exactly the 'example' set forth in *In re Schneller* of when two separate applications are appropriate [because] [t]he inventors of the present application are not the inventors of the [Scharboneau] patent" (main brief, page 9), and (3) the Scharboneau patent and the present application

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are not commonly assigned, such that "[t]he claims in the present application could not have been made in the [Scharboneau] patent. Thus, it was necessary to claim the inventions in separate applications" (main brief, page 10).

In the position we take *infra* in deciding the propriety of the examiner's double patenting rejection, it is not necessary for us to decide whether any of the above noted arguments constitute a sufficient reason why claims corresponding to the appealed claims could not have been presented during prosecution of the application that matured into the Scharboneau patent. Accordingly, we need not address the above noted arguments.

The discussion in the MPEP concerning *Schneller*-type double patent rejections indicates that rejections of this type are based on certain "unique circumstances." Taking a closer look at the facts in *Schneller*, the applicant therein had stated that the preferred and best mode of practicing the invention was a combination of elements the court designated ABCXY, of which the combination ABC was old. In the patent that formed the basis for the rejection, the claims were

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directed to BCX and ABCX using the open "comprising" format. In the continuing application under rejection, the claims were directed to the combinations ABCY and ABCXY. In affirming the examiner's double patenting rejection, the court stated at 397 F.2d 355-56, 158 USPQ 216 that:

The combination ABC was old. He [Schneller] made two improvements on it, (1) adding X and (2) adding Y, the result still being a unitary clip of enhanced utility. While his invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. . . . Anyone undertaking to utilize what [Schneller] disclosed in the patent . . . *in the preferred and only form in which he described these clips*, would thus run afoul of a still unexpired patent if the appealed claims were allowed. [Italics in original.]

Thus, among the "unique circumstances" present in *Schneller* was the circumstance that the *preferred* and *only* forms of the invention disclosed by applicant were covered by both the patent claims and the claims of the application under appeal.

Turning to the present application, the invention disclosed in the Scharboneau patent and the continuation-in-part application is a modular steering wheel and airbag combination. The combination may be regarded as comprising a

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plurality of elements, namely, a steering wheel assembly (A) comprising several subelements, an airbag assembly (B) comprising several subelements, means (C) for securing the subelements of the steering wheel assembly together, means (D) for securing the steering wheel assembly and airbag assembly together, and means (E) for securing the assembled steering wheel and airbag combination as a unit to a steering column. The Scharboneau patent discloses three (3) embodiments of E, namely, the embodiment E_1 of Figures 9A and 10, the embodiment E_2 of Figures 7 and 8, and the embodiment E_3 of Figures 5, 6A and 6C. The claims of the Scharboneau patent include three independent claims: claim 1, directed to the combination ABCE, where E is generically claimed; claim 5, directed to the combination of ABDE, where E is once again generically claimed; and claim 8, directed to the combination ABE_1 , where the specific embodiment E_1 is claimed. The disclosure of the present application includes everything disclosed in the Scharboneau patent, and also discloses an additional embodiment E_4 , see Figures 16 and 17, for securing the assembled steering wheel and airbag combination as a unit to a steering column. The claims of the present application

include two independent claims: claim 1, directed to the combination ABE_{3+4} , where the claim is readable on both E_3 and E_4 but not E_1 or E_2 ; and claim 10³, directed to ABE_{3+4} , where the claim is once again readable on both E_3 and E_4 but not E_1 or E_2 .

Upon side by side comparison of the claims of the present application and the Scharboneau patent, it is clear to us that the concerns voiced by the court in *Schneller* that led the court to conclude that issuance of a second patent would lead to an unjustified time wise extension of the right to exclude do not exist here. This is so primarily because several ways are disclosed in the Scharboneau patent for practicing the invention thereof, but only one of said ways is specifically claimed therein. Thus, upon expiration of the Scharboneau patent, the public would be free to practice the invention of the independent claims of the patent by using either E_1 or E_2 , notwithstanding that appellants in the present application might have the right to exclude others from making, using, or

³Claim 10 also calls for "a plastic cover integrally molded to said steering wheel and over said airbag assembly," which limitation, for purposes of this appeal, we consider to be irrelevant to the double patenting issues raised in this appeal.

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selling subject matter corresponding to appealed claims 1 and 10. In short, the fact pattern presented here simply does not conform to the "unique circumstances" present in *Schneller*, such that the rationale used by the court in *Schneller* in affirming the examiner's rejection is not applicable here.

In light of the foregoing, we shall not sustain the double patenting rejection of the appealed claims.

The 35 U.S.C. § 102(e) Rejection

In rejecting the appealed claims as being anticipated by the Scharboneau patent, the examiner states that "[b]ased upon the earlier effective U.S. filing date of the . . . [Scharboneau patent], it constitutes prior art under 35 U.S.C. § 102(e)" (answer, page 3).

We cannot accept this position. As set forth in 35 U.S.C.

§ 120, in order for a claim in a continuing application to receive the benefit of an earlier filed parent case, the subject matter of that claim must be disclosed in the manner provided by the first paragraph of 35 U.S.C. § 112 in the parent case. That is, in order to claim benefit of earlier

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filing, there must be descriptive support within the meaning of the first paragraph of 35 U.S.C. § 112 in the parent case for the subject matter claimed in the continuing application.

Here, the disclosures of the Scharboneau patent and the present application are for the most part the same in that the only subject matter in the present application that does not also appear in the Scharboneau patent is Figures 16 and 17 and the portions of the specification relating to these figures. Concerning the appealed claims, either a claim is directed to subject matter disclosed in the parent Scharboneau patent or it is not. As to a claim directed to subject matter fully disclosed in the parent Scharboneau patent, said claim would have an effective filing that coincides with the 35 U.S.C. § 102(e) date of the patent, such that the 35 U.S.C. § 102(e) date of the patent would *not* predate the effective filing date of the claim, and the Scharboneau patent would *not* constitute prior art as to said claim. On the other hand, a claim directed to subject matter that is not fully disclosed in the parent Scharboneau patent (e.g., a claim specifically directed

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to the Figures 16 and 17 embodiment) would have an effective filing date that corresponds to the filing date of the continuing application,⁴ such that the 35 U.S.C. § 102(e) date of the Scharboneau patent in that instance would predate the effective filing date of the claim. However, the Scharboneau patent under those circumstances would not anticipate the claim because the subject matter to which the claim is directed is not disclosed in the Scharboneau patent. Thus, in either case, the Scharboneau patent would not constitute a proper anticipatory reference.⁵

We therefore shall not sustain the anticipation rejection of the appealed claims based on Scharboneau.

⁴See *In re Van Langenhoven*, 458 F.2d 132, 137, 173 USPQ 426, 429 (CCPA 1972) (As to any given claimed subject matter, only one effective date is applicable; the fact that some elements of a claim have descriptive support in a parent application does not change the result.)

⁵In that the effective filing date of any appealed claim directed specifically to the embodiment of Figures 16 and 17 would be the filing date of the present continuing application, the examiner may wish to consider whether any such claim would have been obvious under 35 U.S.C. § 103 in view of the disclosure of the Scharboneau patent.

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Conclusion

Neither of the standing rejections of the appealed claims is sustainable.

The decision of the examiner is therefore reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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DECISION: REVERSED
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or Translation (s)
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PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT