

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK H. BAILEY

Appeal No. 1996-1838
Application No. 08/119,655

ON BRIEF

Before STONER, Chief Administrative Patent Judge, HAIRSTON and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65, which are all of the claims pending in this application.

We REVERSE.

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Application No. 08/119,655

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BACKGROUND

The appellant's invention relates generally to systems for storing digital information, and, more particularly, to video disc systems for storing digital information in a pulse-length modulation format (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The sole rejection on appeal as set forth in the examiner's answer (Paper No. 32, mailed December 14, 1999) is¹:

Claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 stand rejected under the judicially created doctrine of nonstatutory (i.e., obviousness-type) double patenting over claim 24 of U.S. Patent No. 5,321,680 since the instant application claims are not patentably distinct inventions from the patent claims.

¹ Since the other grounds of rejection set forth in the final rejection (Paper No. 16, mailed October 20, 1994) were not set forth in the examiner's answer we assume that these other grounds of rejection have been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed September 18, 1995) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions set forth by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the decision of the examiner to reject claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 under the judicially created doctrine of double patenting must be reversed. Our reasoning for this determination follows.

Double patenting is a legal doctrine that forbids an inventor from obtaining a second valid patent for either the same invention or an obvious modification of the same

invention claimed in that inventor's first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). The basic concept of double patenting is that the same invention cannot be patented more than once since to do so would result in a second patent that would expire some time after the first patent expired and extend the protection timewise. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279-80, 23 USPQ2d 1839, 1845 (Fed. Cir. 1992); In re Kaplan, 789 F.2d 1574, 1579-80, 229 USPQ 678, 683 (Fed. Cir. 1986).

35 U.S.C. § 101 states "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor..." (Emphasis added). The prohibition of double patenting of the same invention is based on 35 U.S.C. § 101. In re Goodman, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993); Longi, 759 F.2d at 892, 225 USPQ at 648. By "same invention," the court means "identical subject matter." Longi, 759 F.2d at 892, 225 USPQ at 648; In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 621

(CCPA 1970). A good test, and probably the only objective test, for "same invention," is whether one of the claims would be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. Vogel, 422 F.2d at 441, 164 USPQ at 621-22 (halogen is not the "same" as chlorine; meat is not the "same" as pork). All types of double patenting which are not "same invention" double patenting have come to be referred to as "obviousness-type" double patenting. See In re Van Ornum, 686 F.2d 937, 942-43, 214 USPQ 761, 766 (CCPA 1982), which states in discussing cases leading to Vogel's restatement of the law of double patenting,^{2,3}

numerous cases were considered in which application claims were directed to mere obvious modifications of, or improvements on, inventions defined in the claims of patents already issued to the same inventors, or to common assignees, and it had been decided that they might be allowed to go to patent if the applicants filed terminal disclaimers. We classified these as "obviousness type double patenting." This latter classification has, in the course of time, come, somewhat

² Vogel, 422 F.2d at 441-42, 164 USPQ at 621-22.

³ Judge Rich in Kaplan, 789 F.2d at 1579, 229 USPQ at 682, stated that the restatement of the law of double patenting set forth in Vogel "serves as a good starting place" for deciding the double patenting issue raised in that appeal.

loosely, to indicate any "double patenting" situation other than one of the "same invention" type.

See also General Foods, 972 F.2d at 1279-80, 23 USPQ2d at 1844-45.

"Obviousness-type" double patenting extends the fundamental legal doctrine to preclude "obvious variants" of what has already been patented. See In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998); Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015 and General Foods, 972 F.2d at 1280, 23 USPQ2d at 1845. "Obviousness-type" double patenting precludes issuance where there is no "patentable difference" or no "patentable distinction" between the two claims. Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015; General Foods, 972 F.2d at 1278-79, 23 USPQ2d at 1844. This allows the public to practice obvious variations of the first patented invention after the first patent expires. See Longi, 759 F.2d at 892-93, 225 USPQ at 648. The courts adopted the doctrine out of necessity where claims in two applications by the same inventor were so much alike that to allow the latter would effectively extend the

life of the first patent. See Gerber Garment Technology, Inc. v. Lectra Sys., 916 F.2d 683, 686 16 USPQ2d 1436, 1439 (Fed. Cir. 1990); In re Thorington, 418 F.2d 528, 534, 163 USPQ 644, 648 (CCPA 1969), cert. denied, 397 U.S. 1038, 165 USPQ 290 (1970).

In summary, "obviousness-type" double patenting is a judge-made doctrine that prevents an unjustified extension of the patent right beyond the statutory time limit. It requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by a patent. In order to overcome an "obviousness-type" double patenting rejection, an applicant may file a "terminal disclaimer," foregoing that portion of the term

of the second patent that extends beyond the term of the first. Berg, 140 F.3d at 1431-32, 46 USPQ2d at 1229.

Thus, if a claim sought in the application is not identical to yet **not patentably distinct** from a claim in an inventor's earlier patent, then the claim must be rejected under "obviousness-type" double patenting rejection. See Berg, 140 F.3d at 1431, 46 USPQ2d at 1229; In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991); Goodman, 11 F.3d at 1052, 29 USPQ2d at 2015; Vogel, 422 F.2d at 441, 164 USPQ at 622. In determining whether a claim sought in the application is **patentably distinct** from the claims in an inventor's earlier patent a variety of tests have been utilized. In Berg, 140 F.3d at 1433-34, 46 USPQ2d at 1230-31 and In re Emert, 124 F.3d 1458, 1461-62, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997), a "one-way" test was applied. Under this "one-way" test, the examiner asks whether the application claims are obvious over the patent claims. In Goodman, 11 F.3d at 1052-53, 29 USPQ2d at 2015-16 and Van Ornum, 686 F.2d at 942-43, 214 USPQ at 766-67, a test similar to the "one-way" test was applied. Under this test, the examiner asks whether the application claims are generic to any species set forth in the patent claims. In In re

Dembiczak, 175 F.3d 994, 1002, 50 USPQ2d 1614, 1619-20 (Fed. Cir. 1999) and Braat, 937 F.2d at 593-94, 19 USPQ2d at 1292-93, a "two-way" test was applied. Under this "two-way" test, the examiner asks whether the application claims are obvious over the patent claims and also asks whether the patent claims are obvious over the application claims.

We recognize that the examiner's rejection is based in large measure on the decision of the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).⁴ However, it is our view that Schneller does not set forth another test for

⁴ Schneller is a rather unusual case in that there was no majority opinion because only Judges Rich and Smith joined the principal opinion, while Judges Worley and Kirkpatrick concurred in the result and Judge Almond wrote a concurring opinion. Thus, the principal opinion therein is of doubtful controlling precedent. As Judge Rich observed in Kaplan, 789 F.2d at 1578, 229 USPQ at 682,

[t]he development of the modern understanding of "double patenting" began in the Court of Customs and Patent Appeals (CCPA) about the time of In re Zickendraht, 319 F.2d 225, 138 USPQ 22 (CCPA 1963), a rather unusual case is [sic, in] that there was no majority opinion because only two judges joined each of the two principal opinions. Neither opinion therein, therefore, can be regarded as controlling precedent in this court.

determining "obviousness-type" double patenting. In that regard, it is clear to us that the court in Schneller was concerned with whether or not the invention claimed in the patent was **independent and distinct** from the invention of the appealed claims.⁵ While the court in Schneller did use a "cover" test⁶ in making the determination that the invention claimed in the patent was not **independent and distinct** from the invention of the appealed claims, we are of the view that the term "cover" was used by the court as synonymous with not patentably distinct. Thus, under the "cover" test, one would ask whether the application claims are **covered** by (i.e., not patentably distinct from) the claims of the patent. To the extent that Judge Rich in Schneller was setting forth a domination theory⁷ of double

⁵ See Schneller, 397 F.2d at 354, 158 USPQ at 214-15.

⁶ As set forth in the Manual of Patent Examining Procedure (MPEP) § 804, one part of the test is whether patent protection for the invention, fully disclosed in and **covered** by the claims of the reference, would be extended by the allowance of the claims in the later filed application.

⁷ A first patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on
(continued...)

patenting, we note that Judge Rich in Kaplan, 789 F.2d at 1577-78, 229 USPQ at 681-82, set forth the Courts opinion that "[d]omination is an irrelevant fact." In any event, it is our view that Schneller did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. In fact, the Court in Schneller, 397 F.2d at 355, 158 USPQ at 215, cautioned against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations.

Accordingly, the question before us in this appeal is whether the application claims are **patentably distinct** from claim 24 of U.S. Patent No. 5,321,680.

With respect to the rejection before us, the examiner has stated the following:

All of the claims of the instant application and patent No. 5,321,680 are drawn to a single embodiment of

⁷(...continued)
an invention defined in a narrower or more specific claim in the second patent or application.

the invention; the inventions set forth in the claims of the instant application and patent No. 5,321,680 are not independent and distinct from each other. . . . These claims [of the instant application] drawn to a single disclosed embodiment of the invention are considered to be mere obvious variant ways of claiming the same invention within the scope of the meaning of the judicially created doctrine of "obviousness-type" double patenting. [Answer, pp. 10-11].

Instant application claims 59 and 61 and patent claim 24 are not patentably distinct over one another. . . . The subject matter encompassed by instant application claims 59 and 61 and patent claim 24 are obvious variants of one another. [Answer, p. 14].

Our review of the claims under appeal and claim 24 of U.S. Patent No. 5,321,680 leads us to conclude that, absent the presence of additional evidence not before us in this appeal, the claims under appeal are **patentably distinct** from claim 24 of U.S. Patent No. 5,321,680. In that regard, from a review of the claims under appeal it is quite clear that only claims in the present application recite a record medium/optical disc/disc having a header portion including address information as set forth in claims 8, 32, 54 and 59 (the independent claims on appeal). Thus, claims 8, 32, 54 and 59

and claims dependent thereon are **patentably distinct** from claim 24 of U.S. Patent No. 5,321,680 in the absence of any evidence establishing that the claimed header portion including address information was known in the art. While the examiner has stated that the claims under appeal are obvious variants of claim 24 of U.S. Patent No. 5,321,680, the examiner has not produced any evidence that the claimed header portion including address information was so much as known in the art, much less that it would have been obvious to add such a header portion including address information to the inventor's previously claimed subject matter.⁸

In summary, the examiner has failed to establish that the claims under appeal are not patentably distinct from claim 24 of U.S. Patent No. 5,321,680. Likewise, the examiner has failed to establish that the claims under appeal are obvious

⁸ While the examiner did not require restriction between the claims under appeal and claim 24 of U.S. Patent No. 5,321,680, as far as we are able to determine there would be no reason why it would not have been proper for the examiner to have made a restriction requirement under the criteria of distinctness set forth in MPEP § 806.05(c).

from or generic to claim 24 of U.S. Patent No. 5,321,680.
Furthermore, it is our view that the facts of this case are sufficiently different from the facts present in Schneller that a double patenting rejection in this application is inappropriate. Accordingly, the decision of the examiner to reject claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 under the judicially created doctrine of nonstatutory (i.e., obviousness-type) double patenting over claim 24 of U.S. Patent No. 5,321,680 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 8, 10, 11, 32, 34, 35, 37, 54 to 59 and 61 to 65 is reversed.

REVERSED

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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