

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD W. BALLARD

Appeal No. 96-4038
Application 08/157,443¹

ON BRIEF

Before LYDDANE, STAAB and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 16, all of the claims pending in this application for the reissue of U.S. Patent No. 5,080,116.²

¹ Application, filed November 26, 1993, for Reissue of U.S. Patent No. 5,080,116, granted January 14, 1992, based on Application 07/585,748, filed September 20, 1990.

² Claims 1, 2 and 5 through 7 have been amended subsequent to final rejection. Although the amendments in question (Paper No. 9) initially were refused entry by the examiner (see the advisory action dated November 28, 1995, Paper No. 10), they later were entered upon reconsideration (see page 2 in the main answer, Paper No. 14).

The invention relates to a "method for conditioning hair and neutralizing permanents" (specification, column 1, lines 8 and

9). Claims 1 and 10 are illustrative and read as follows:

1. An improved method for giving a permanent comprising the steps of

- 1) wrapping the hair around perm rods,
- 2) applying permanent wave solution to the hair,
- 3) rinsing the head with water,
- 4) towel drying the hair,
- 5) applying neutralizer to the hair,
- 6) again rinsing the head with water, and

7) removing the rods, the improvement comprising the method for applying said neutralizer to said hair, said improvement comprising applying said neutralizer by means of an air brush to mix with a gas, said neutralizer being applied to the hair by lifting the rods to which said neutralizer is to be applied, spraying the bottom of the hair wrapped around the perm rod, partially restoring the hair wrapped around the perm rod to its original position and then spraying the hair wrapped around the rod again, and finally spraying the hair wrapped around the perm rod a third time with the rod in its original position, the air brush being held between 0.1-1.0 inches from the hair while the neutralizer is being applied, and wherein at least one application of neutralizer is made with a gas pressure of greater than 40 lbs. per square inch.

10. An improved method for giving a permanent comprising the steps of

- 1) wrapping the hair around perm rods,
- 2) applying permanent wave solution to the hair,

- 3) rinsing the head with water,
- 4) towel drying the hair,
- 5) applying neutralizer to the hair,
- 6) again rinsing the head with water, and

7) removing the rods, the improvement comprising the method for applying said neutralizer to said hair, said improvement comprising applying said neutralizer by means of an air brush to mix with a gas, said neutralizer being applied to the hair by lifting the rods to which said neutralizer is to be applied, spraying the bottom of the hair wrapped around the perm rod, partially restoring the hair wrapped around the perm rod to its original position and then spraying the hair wrapped around the rod again, and finally spraying the hair wrapped around the perm rod a third time with the rod in its original position, said gas being at a pressure above the ambient pressure of the air.

Claims 1 through 16 stand rejected under 35 U.S.C. § 251.

The following explanation of the rejection indicates that it is based on purported failures of the reissue declarations of record to meet the requirements of 37 CFR § 1.175 and of the appellant to allege error correctable under 35 U.S.C. § 251:³

³ Although the examiner omitted an express statement of this rejection in the main answer, the explanation clearly indicates that the claims do in fact stand rejected on this ground. Given the designation of such rejection as a new ground of rejection (see page 5 in the main answer), it is apparent that the examiner implicitly has withdrawn the corresponding 35 U.S.C. § 251 rejection set forth in the final rejection. In addition, the examiner expressly has withdrawn the 35 U.S.C. § 251 new matter rejection of claims 10 through 16 set forth in the final rejection (see page 5 in the main answer).

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--As to claims 1, 2, 5, 6 and 7, appellant failed to address the addition of, --per square inch--, in the declaration.

--As to claims 10, 12 and 14, appellant failed to clearly define why "the method of holding the hair brush between 0.1-1.0 inches from the hair while the neutralizer is being applied" is excess language and considered to be error. Also, the appellant changed the limitation of applying a neutralizer at a pressure "greater than 40 pounds" to --a pressure above the ambient pressure of air-- . . . [D]uring prosecution of Patent number 5,080,116, there is no evidence that the attorney failed to appreciate the full scope of the invention (In re Wilder, 222 USPQ 369), since the appellant during prosecution of the patent believed that a pressure of greater than 40 pounds **was required** for the method to be preformed [sic] properly, as stated in the appellant's declaration in section 10. The appellant was not aware that the method could be performed with less than 40 pounds until 6 months after Patent ('116) issued as a result of further testing of the device. Therefore, it is clear that the limitation of "greater than 40 pounds" it [sic] what the applicant intended to claim as an element that is material to his invention. Also, claim 14, has numerous other changes not discussed with respect to claim 1, as stated in section 21, line 2. Specifically the appellant failed to mention the deletion of changes in lines 13-15 of the claim and why the changes are required.

--As to claims 11, 13 and 15, the declaration failed to mention what the additional limitations are in the claim and why the limitations are required to correct an error. Appellant mentions claim 11 and 13, in sections 18 and 21, line 3, of the declaration, however it is believed that "11" should be rewritten as --12-- and "13" should be rewritten as --14--. The declaration in section 24, that claim 15, incorporates the [l]imitations previously included in claim 4, however the limitation of claim 4 "gas is carbon dioxide" is not stated in claim 15.

--As to claim 16, the declaration failed to address the deletion of applying the gas at a pressure greater than 40 pounds and the holding of the air brush

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between 0.1-1.0 inches from the hair, as set forth in the original independent claims.

. . . .
The examiner believes that a reissue application should not be used to broaden a claim in view of new technology discovered by the applicant after issuance of his or her patent . . . [w]herein, the applicant deemed the deleted limitations in the reissue to be essential to the method as set forth in his or her claims during prosecution of the patent application [main answer, Paper No. 14, pages 3 through 5, emphasis in the original].

The record in this application contains three reissue declarations, namely: the declaration of the inventor, Gerald W. Ballard, filed on November 26, 1993, the declaration of Mr. Ballard's attorney, Patrick P. Phillips, filed on November 26, 1993, and the declaration of Mr. Ballard filed on October 23, 1995. Reference is made to the main and reply briefs (Paper Nos. 13 and 15) for a full statement of the appellant's position that these declarations collectively satisfy the requirements of 37 CFR § 1.175 and allege error correctable under 35 U.S.C. § 251.

With regard to the issue of compliance with 37 CFR § 1.175, when it is claimed that a patent is inoperative or invalid by reason of the patentee claiming more or less than he had the right to claim, the reissue oath or declaration is required to distinctly specify the excess or insufficiency in the claims (37

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CFR § 1.175(a)(3)), to particularly specify the errors relied upon, and how they arose or occurred (37 CFR § 1.175(a)(5)), and to state that said errors arose without any deceptive intention on the part of the applicant (37 CFR § 1.175(a)(6)). Every difference between the original and reissue claims must be specified (Nupla Corp. v. IXL Manufacturing Co., 114 F.3d 191, 192-93, 42 USPQ2d 1711, 1713 (Fed. Cir. 1997); In re Constant, 827 F.2d 728, 729, 3 USPQ2d 1479, 1480 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987)) and explained in terms of the errors relied upon and how they arose or occurred (Nupla Corp. v. IXL Manufacturing Co., 141 F.3d at 195, 42 USPQ2d at 1715)).

The appellant's reissue declarations fail to comply with these requirements in most of the instances noted by the examiner.

To begin with, the declarations do not mention the addition of the "per square inch" language to patent claims 1, 2, 5, 6 and

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7, do not explain the underlying errors relied upon or how such arose or occurred, and do not state that such errors arose without any deceptive intention on the part of the appellant.

The declarations do not explain with any reasonable specificity why the recitation of "the air brush being held between 0.1-1.0 inches from the hair while the neutralizer is being applied" which appears in independent patent claims 1, 5 and 6 but not in new independent claims 10, 12 and 14 is excess language. The declarations also fail to specify the underlying errors relied upon, and how they arose or occurred. The ambiguous references to drafting errors in the discussion bridging paragraphs 7 through 20 of the Phillips declaration are not sufficient in this respect.

With additional regard to new claim 14, although the examiner is correct in pointing out that the differences between the subject matter recited on lines 13 through 15 of this claim

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and the corresponding portion of patent claim 1 are not treated in the declarations, these differences do not exist between claim 14 and patent claim 6 which more closely corresponds to claim 14 than does claim 1. The difference in scope between claims 14 and 6 is suitably addressed in paragraph 18 of the Phillips declaration.

New claims 11, 13 and 15 depend from claims 10, 12 and 14, respectively, and set forth the limitation that "the air brush is held between 0.1-1.0 inches from the hair while the neutralizer is being applied." As touched upon by the examiner, the declarations contain several confusing typographical errors relating to the discussion of claims 11, 13 and 15. In addition, the declarations fail to specify the underlying errors necessitating these particular claims, and how they arose or occurred. Here again, ambiguous references to drafting errors are not sufficient.

Similarly, the declarations do not explain with any reasonable specificity the difference in scope between new claim

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independent 16 and the patent claims, do not explain the underlying errors relied upon or how such arose or occurred, and do not state that such errors arose without any deceptive intention on the part of the appellant.⁴

Thus, for at least the foregoing reasons, the examiner's position that the appellant's reissue declarations fail to comply with the requirements of 37 CFR § 1.175 with respect to the subject matter recited in claims 1 through 16 is well founded.

The examiner's additional position that the appellant has failed to allege error correctable under 35 U.S.C. § 251 with respect to the "greater than 40 lbs." gas pressure limitation

⁴ New claim 16 is very similar in scope to claim 1 as originally filed in the application which matured into the patent for which reissue is being sought. The record in that application indicates that originally filed claim 1 was rejected by the examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,738,793 to Voorhees, and subsequently canceled by the appellant. The examiner may wish to reconsider whether the subject matter recited in claim 16 is patentable over the Voorhees reference, and whether the presentation of claim 16 in the instant reissue application raises a "recapture" issue (see MPEP 1412.02).

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which appears in independent patent claims 1, 5 and 6 but not in new independent claims 10, 12, 14 and 16 is not well founded. The discussion of this matter in the reissue declarations sufficiently demonstrates that the inclusion of the foregoing limitation in the independent patent claims was due to a failure at that time by the inventor and attorney to appreciate the full scope of the invention. The examiner's reliance on In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984), cert. denied, 469 U.S. 1209 (1985) is misplaced since this case actually supports the appellant's contention that errors of this sort are correctable by reissue under 35 U.S.C. § 251.

In light of the foregoing, we shall sustain the standing 35 U.S.C. § 251 rejection of claims 1 through 16 to the extent that it is based on a failure of the reissue declarations of record to meet the requirements of 37 CFR § 1.175, but not to the extent that it is based on a failure of the appellant to allege error correctable under this section of the statute.

The decision of the examiner is affirmed.

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

AFFIRMED

WILLIAM E. LYDDANE)	
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
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