

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DALE A. STRETCH

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Appeal No. 97-3085  
Application 08/236,835<sup>1</sup>

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ON BRIEF

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

DECISION ON APPEAL

Dale A. Stretch originally took this appeal from the final rejection of claims 1, 2, 4 through 7, 9 through 13 and 15 through 21, all of the claims pending in the application.

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<sup>1</sup> Application for patent filed May 2, 1994.

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The appellant has since requested that claims 9 and 15 be held withdrawn from consideration (see page 5 in the appellant's brief, Paper No. 21). Accordingly, the appeal as to claims 9 and 15 is hereby dismissed, leaving for review the standing rejection of claims 1, 2, 4 through 7, 10 through 13 and 16 through 21.<sup>2</sup>

The invention relates to an isolator for attenuating and dampening vehicle driveline torsionals (i.e., pulses) generated by accelerations/decelerations of the vehicle's engine. A copy of the appealed claims (with reference numerals added) appears in the appendix to the appellants' brief.

The instant application is one of four related applications filed concurrently on May 2, 1994 by Eaton Corporation, the assignee of entire interest in each of the applications. Three of the applications, Applications 08/236,809, 08/236,835 and 08/236,838, are currently on appeal

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<sup>2</sup> All of the claims remaining on appeal have been amended subsequent to final rejection.

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to this Board from a final rejection,<sup>3</sup> and the fourth, Application 08/236,069, has matured into U.S. Patent No. 5,577,963, issued on November 26, 1996.

The disclosures in the four applications are essentially identical and pertain to a torsion isolator having, among other

features, (1) a spring disposed in a liquid pressure dampener and functioning as a piston, (2) a pivot stop associated with the spring, (3) a counterbalance associated with the spring, and (4) a control means associated with the spring for momentarily providing hydraulic slack or delay in the dampening operation. The claims in the four applications are directed to an isolator having one or more of these features. As described by the appellant, "[i]n brief, the gist[s] of the four inventions in the '069, '809, '835 and '838 applications are respectively the pivot stop D, the counterbalance C, the momentary negation of dampening or hydraulic [slack] provided

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<sup>3</sup> Application 08/236,835 is the instant application, Application 08/236,809 is the subject of Appeal No. 97-2610 and Application 08/236,838 is the subject of Appeal No. 97-2221.

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by the control means E, and the spring A<sub>2</sub> or A<sub>3</sub> disposed in the liquid pressure dampener B<sub>2</sub> and functioning as a piston" (brief, page 31<sup>4</sup>).

The claims in each of the applications on appeal stand finally rejected under the judicially created doctrine of double patenting in view of the claims in each of the other three related applications. With specific regard to the instant appeal, the examiner states the rejection as follows:

Claims 1-2, 4-7, 10-13, and 16-21 are rejected under the judicially created doctrine of non-statutory type double patenting as being unpatentable over claims 1-10 of copending application Serial No. 08/236,809, over claims 1-8 of copending application Serial No. 08/236,069, and over claims 1-30 [sic, claims 1-6, 8-12, 14-20, 22-27 and 29-34] of copending application Serial No. 08/236,838.<sup>[5]</sup> The now claimed subject matter is

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<sup>4</sup> The appellant has used the letters A, B, C, D and E in the brief to simplify reference to the various features of the isolator.

<sup>5</sup> This rejection is actually a "provisional" rejection to the extent that it is based on the claims in copending Applications 08/236,809 and 08/236,838. Such "provisional" rejections are authorized by MPEP § 804 and have been sanctioned by this Board (see, for example, Ex parte Karol, 8

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described within the disclosure and encompassed within the scope of the claim(s) of Applicant's copending application Serial No. 08/236,809, copending application Serial No. 08/236,069, and copending application Serial No. 08/236,838 and therefore, a claim for the now claimed subject matter could have been presented therein.

The non-statutory type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent unjustified prolongation of the patent term. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) [answer, Paper No. 22, page 3].

Reference is made to the appellant's brief and to the examiner's answer for the respective positions of the appellant

and the examiner with regard to the merits of this rejection.<sup>6</sup>

*In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968),

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USPQ2d 1771 (Bd. Pat. App. & Int. 1988)) and by the predecessor of our reviewing court (see, for example, *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966)). As indicated above, Application 08/236,069 has matured into U.S. Patent No. 5,577,963.

<sup>6</sup> The final rejection also included 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102(b) and 35 U.S.C. § 103 rejections which have since been withdrawn by the examiner (see the advisory action dated June 6, 1996, Paper No. 16, and page 4 in the answer).

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cited by the examiner in support of the appealed rejection, stands for the principle that under certain circumstances a double patenting rejection other than one of the statutory same-invention-type or judicially created obviousness-type may be employed to prevent an unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about (397 F.2d at 354, 158 USPQ at 214). Accord In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982). The offending situation in Schneller involved a patent and a subsequent continuing application filed voluntarily instead of in response to a restriction requirement. The patent and the application contained common disclosures and claims which all could have been included in the patent. The claims in the application, if allowed, would afford patent protection on an invention fully disclosed in and covered by the claims in the patent. Under these circumstances, the court found that the application claims, if allowed without the filing of a terminal disclaimer, would provide an unjustified timewise extension of the right to exclude granted by the patent.

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Given the absence of a terminal disclaimer, the court affirmed the double patenting rejection entered against the application claims.

As indicated above, Applications 08/236,809, 08/236,835, 08/236,838 and 08/236,069 contain essentially identical disclosures. These applications are commonly assigned and were voluntarily filed as separate applications even though there is no apparent reason why the claims contained in each could not have been included in a single application. Also, none of the applications includes a terminal disclaimer. Thus, depending on the scope of the claims, the potential certainly exists for one or more of the applications on appeal, if allowed, to provide an unjustified timewise extension of the right to exclude granted by a patent maturing from any of the other applications.

The appellant's brief (see pages 29 through 31) contains a tabular summary of the scope of the respective sets of claims involved in the double patenting issue presented in this appeal. This summary, and our own review, indicate that the claims in the instant application, if allowed, would not result in any timewise extension of the right to exclude

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afforded by the claims in Applications 08/236,838, 08/236,809 and 08/236,069 (Patent No. 5,577,963). The examiner's determination to the contrary as set forth in the answer is fundamentally flawed in that it fails to take into account the subject matter as a whole recited in these claims.

Accordingly, we shall not sustain the examiner's double patenting rejection of claims 1, 2, 4 through 7, 10 through 13 and 16 through 21.

The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	
	)	
JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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