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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LILLIAN P. STURM and KURT D. SALOMON

Appeal No. 97-3187
Application No. 07/999,422[1]

HEARD: September 16, 1997

Before CALVERT, COHEN, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's final rejection (Paper No. 18, mailed November 13, 1995) of claims 1 through 6

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[1] Application for reissue patent filed December 31, 1992. According to the appellants, the application is a reissue of U.S. Patent No. 4,981,095 (Application No. 07/470,974, filed January 26, 1990), which was a continuation of Application No. 07/321,720, filed March 10, 1989, now U.S. Patent No. 4,901,661.

which are all of the claims pending in this application. However, the appellants on page 4 of their brief (Paper No. 25, filed November 8, 1996) have withdrawn the appeal on claims 3 and 4. Accordingly, the appeal as to claims 3 and 4 is dismissed, leaving only claims 1, 2, 5 and 6 for our consideration.

We REVERSE and enter a new ground of rejection pursuant to
37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a decorative ribbon and a method of securing a wire filament along an edge of a fabric ribbon. Copies of claims 1, 2, 5 and 6 are attached to this decision.

Application No. 07/321,720

Application No. 07/321,720 was filed by the appellants on March 10, 1989 with claims 1 through 13. Claims 1 through 6 were directed to a decorative edge-reinforced ribbon. Claims

7 through 12 were directed to a method of securing a wire along an edge of a fabric ribbon. Claim 13 was directed to a stitching machine for producing a decorative wired ribbon.

The examiner required restriction (see Paper No. 5, mailed July 18, 1989) between Group I (claims 1 through 12) and Group II (claim 13). The appellants elected Group I and canceled claim 13 (see Paper No. 6, filed August 21, 1989).

The examiner then allowed claims 1 through 12 (see Paper No. 7, mailed September 5, 1989).

The appellants submitted an amendment and petition under Rule 312 (37 CFR § 1.312) (see Paper No. 10, filed September 26, 1989). The amendment presented proposed claims 14 and 15 and the appellants stated on page 3 of the petition that the proposed claims were "intended to ensure that the applicant is adequately protected against infringers -- two of which have already been discovered." Proposed claim 14 was directed to a decorative ribbon. Proposed claim 14 differed from allowed claim 1 in that it did not require the wire filament to be

disposed within the fold of the lateral folded edge. Proposed claim 15 was directed to a method of securing a wire filament along an edge of a fabric ribbon. Proposed claim 15 differed from allowed claim 7 in the language used in the stitching step.

The amendment under Rule 312 was disapproved (see Paper No. 11, mailed November 11, 1989). The reason stated for not entering the amendment was that proposed claim 14 would not be patentable over the newly cited patent to Stevens (U.S. Patent No. 1,657,184).

The appellants paid the issue fee on December 7, 1989 and this application issued as U.S. Patent No. 4,901,661 on February 20, 1990.

Application No. 07/470,974

Application No. 07/470,974 was filed by the appellants on January 26, 1990 as a 37 CFR § 1.60 continuation of Application No. 07/321,720 (the parent application). Claims 1 through 13 from the parent application were canceled and new

claims 14 and 15 were added (see Paper No. 3, filed January 26, 1990). New claim 14 was directed to a decorative ribbon. New claim 14 differed from proposed claim 14 in the parent application in that it required a folded edge. New claim 15 was directed to a method of securing a wire filament along an edge of a fabric ribbon. New claim 15 is identical to proposed claim 15 in the parent application.

The examiner required restriction (see Paper No. 5, mailed June 13, 1990) between Group I (claim 14) and Group II (claim 15). The examiner stated the inventions were distinct because

> Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process. (MPEP 806.05(f)).
> In the instant case, the ribbon of claim 14 need not be folded around the wire filament, as required by claim 15.

The appellants' response to the restriction requirement (see Paper No. 6, filed July 3, 1990) amended claim 14 so that

it is consistent with claim 15 and elected amended claim 14.

In this response the appellants stated

> Claim 14 now requires the wire to be within the folded edge, not merely proximate thereto. As a result, the ribbon of claim 14, as amended, <u>is</u> folded around the wire filament, as required by claim 15. In view of this amendment, the examiner is respectfully requested to withdraw the restriction requirement.

The examiner then allowed claims 14 and 15 (see Paper No. 7, mailed July 31, 1990). The examiner stated that

> In view of the amendment to claim 14, claims 14 and 15 are no longer considered to be distinct inventions. Thus the restriction requirement of the first office action is withdrawn.

The appellants paid the issue fee on October 25, 1990 and this application issued as U.S. Patent No. 4,981,095 on January 1, 1991.

<u>Application No. 07/999,422</u>

Application No. 07/999,422 was filed with claims 1 through 6 by the appellants on December 31, 1992 as a reissue application for U.S. Patent No. 4,981,095. Claims 1 and 2 were the original patent claims (i.e., amended claim 14 and

claim 15 from Application No. 07/470,974). Claims 3 and 4 were broader claims directed to a decorative ribbon. Claims 5 and 6 were broader claims directed to a method of securing a wire along an edge of a web of fabric ribbon. Claims 3 through 6 were broader than claims 1 and 2 since they were not limited to the ribbon fabric being folded around the wire filament.

The reissue declaration of Lillian P. Sturm (the reissue declaration) filed with this application avers that

> the patentees failed to appreciate and recognize that the claims as presented unduly limit the claimed ribbon and the method of manufacturing the ribbon to only the embodiment wherein the ribbon fabric is specifically folded around the wire filament . . . the above errors arose because the patentees and counsel, throughout the prosection of the application that matured into the '095 patent, focused only on the claims encompassing the embodiment of the invention wherein a fold is provided for surrounding the wire filament. Specific attention was not directed to claiming the embodiment disclosed wherein the fold is absent and the wire filament is simply positioned along the edge of the web of ribbon material and surrounded by the binding and trim filaments [pp. 2-3].

The examiner finally rejected claims 1 through 6 (see Paper No. 18, mailed November 13, 1995) under 35 U.S.C. § 251

as the appellants' failure to timely file a divisional application was not considered to be error causing the patent granted on the elected claims to be partially inoperative by reason of claiming less than they had a right to claim.[2]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the 35 U.S.C. § 251 rejection, we make reference to the final rejection and the examiner's answer (Paper No. 26, mailed February 28, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain the examiner's rejection under 35 U.S.C.

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[2] As noted above, the appellants have withdrawn claims 3-4.

§ 251 for the following reasons.

The issue presented by the examiner and the appellants is whether the "divisional doctrine" set forth in In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977) is applicable in this application. The "divisional doctrine" declares that where the PTO issues a restriction requirement and the applicant responds by canceling claims to the nonelected invention, and then the applicant fails to file a divisional application with the canceled claims, the applicant is deemed to have acquiesced in the restriction and is estopped from obtaining by reissue the subject matter of the canceled claims. Orita, 550 F.2d at 1280, 193 USPQ at 148. This "divisional doctrine" has been strictly construed against reissue applicants claiming "error" in failing to file a divisional application after a restriction requirement. Even if the applicant's representative misunderstood the applicant's instructions, this does not constitute "error" within the meaning of 35 U.S.C. § 251. See In re Weiler, 790 F.2d 1576, 1582, 229 USPQ 673, 677 (Fed. Cir. 1986). "Section 251 is not a panacea designed to cure every mistake which might be committed by an

applicant or his attorney." Orita, 550 F.2d at 1281, 193 USPQ at 149. On the other hand, Section 251 is a remedial statute that is to be interpreted liberally. Weiler, 790 F.2d at 1579, 229 USPQ at 675. "Although attorney error is not an open invitation to reissue every case in which it may appear . . . the purpose of the reissue statute is to avoid forfeiture of substantive rights due to error made without intent to deceive." Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1575, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991).

The "divisional doctrine" set forth in Orita does not apply to the facts of this case. In that regard, we note that method claims 5 and 6 were never subject to a restriction requirement. The restriction requirement made in Application No. 07/470,974 was between a process of making and product made. Thus, there never was a determination by the PTO that the subject matter of claims 1 and 2 was restrictable from the subject matter of claims 5 and 6 (i.e., that the subject matter of claims 1 and 2 defines an independent and distinct invention from the subject matter of claims 5 and 6).

Furthermore, it is our opinion that it is inappropriate to extend the "divisional doctrine" set forth in Orita to cover the facts of this case.

For the reasons stated above, we do sustain the examiner's rejection of claims 1, 2, 5 and 6 under 35 U.S.C. § 251.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection:

Claims 1, 2, 5 and 6 are rejected for obviousness-type double patenting over claims 1, 3 and 7 from U.S. Patent No. 4,901,661, for the reasons explained below.

In this case, the proper test for obviousness-type double patenting is the "one-way" test set forth in In re Goodman, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2015-16 (Fed. Cir. 1993), since the appellants chose to file a continuation (i.e., Application No. 07/470,974) and seek issuance of the allowed claims in Application No. 07/321,720 by payment of the issue

fee after notification of the examiner's refusal to enter the appellants' amendment under Rule 312 (Paper No. 10, filed September 26, 1989). Under the "one-way" test for obviousness-type double patenting, we must determine whether the pending claims 1, 2, 5 and 6 define merely an obvious variation of claims 1, 3 and 7 from U.S. Patent No. 4,901,661.

Pending claim 1

A comparison of pending claim 1 and claim 1 from U.S. Patent No. 4,901,661 reveals that both are directed to a decorative ribbon comprising (1) a web of ribbon material a folded edge, (2) a wire filament disposed along and within the folded edge; and (3) stitch means for securing the folded edge of the web to the wire filament, wherein the stitch means includes a trim filament substantially covering the edge and the wire filament from view and a binding filament passing through the web of ribbon material and around the trim filament to secure the wire filament and the trim filament to the folded edge. However, this comparison also reveals that pending claim 1 recites the following features that claim 1 from U.S. Patent No. 4,901,661 does not recite: (1) the web

has two faces, and (2) the binding filament and the trim filament being of different constructions.

With respect to the web having two faces, it is our opinion that such a limitation is inherently present in the web recited in claim 1 from U.S. Patent No. 4,901,661.

With respect to the binding filament and the trim filament being of different constructions, we note that claim 3 from U.S. Patent No. 4,901,661 recites that the trim filament is of metallic thread and the binding filament is a solid monofilament.

It is our opinion that claim 3 from U.S. Patent No. 4,901,661 can be equated to a species of the invention, while pending claim 1 can be equated to a genus of the invention. However, the generic invention of pending claim 1 is "anticipated" by the species of the patented invention (i.e., claim 3 from U.S. Patent No. 4,901,661). See Goodman, 11 F.3d at 1053, 29 USPQ2d at 2016. Thus, without a terminal disclaimer, the species claims preclude issuance of the

generic claims as in In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982) and In re Schneller, 397 F.2d 350, 354, 158 USPQ 210, 214 (CCPA 1968).

Pending claim 2

A comparison of pending claim 2 and claim 7 from U.S. Patent No. 4,901,661 reveals that both are directed to a method of securing a wire along an edge of a fabric ribbon, comprising the steps of (1) positioning a wire filament adjacent to and in parallel contact with the edge; (2) folding the edge of the ribbon around the wire filament, such that at least some of the circumference of the wire filament is coextensive with and covered by the ribbon, thereby creating a sleeve of fabric for engaging the wire filament; and (3) stitching the wire filament to the edge using at least two additional filaments, such that the wire filament is in tight engagement with the edge, said stitching step including, in a single continuous operation, passing a trim filament at least partially around the edge and the wire filament, said trim filament covering substantially all of the wire filament from view, and passing a binding filament through the ribbon and

around the edge, the trim filament and the wire filament, thereby securing the wire filament to the edge.

This comparison also reveals that pending claim 2 recites the step of passing a binding filament through the ribbon proximate the edge which claim 7 from U.S. Patent No. 4,901,661 does not recite.

It is our opinion that it would have been obvious to one of ordinary skill in the art to pass the binding filament of claim 7 from U.S. Patent No. 4,901,661 through the ribbon proximate the edge in order to reduce the amount of binding filament needed to secure the wire filament to the edge.

Pending claim 5

A comparison of pending claim 5 and claim 7 from U.S. Patent No. 4,901,661 reveals that both are directed to a method of securing a wire along an edge of a fabric ribbon, comprising the steps of (1) positioning a wire filament adjacent to and in parallel contact with the edge; and (2) stitching the wire filament to the edge using at least two

additional filaments, such that the wire filament is in tight engagement with the ribbon, said stitching step including, in a single continuous operation, passing a trim filament around the edge and the wire filament, said trim filament covering substantially all of the wire filament from view, and passing a binding filament through the ribbon and around the wire filament, thereby securing the wire filament to the ribbon.

This comparison also reveals that pending claim 5 does not recite the step of folding the edge of the ribbon around the wire filament as recited in claim 7 from U.S. Patent No. 4,901,661.

It is our opinion that claim 7 from U.S. Patent No. 4,901,661 can be equated to a species of the invention, while pending claim 5 can be equated to a genus of the invention. However, as pointed out with respect to pending claim 1 above, the generic invention of pending claim 5 is "anticipated" by the species of the patented invention (i.e., claim 7 from U.S. Patent No. 4,901,661). See Goodman, supra. Thus, without a terminal disclaimer, the species claims preclude issuance of

the generic claims as in In re Van Ornum, supra and In re Schneller, supra.

Pending claim 6

Pending dependent claim 6 adds the limitation to parent claim 5 that the wire filament is positioned along the bottom face of the web.

It is our opinion that it would have been obvious to one of ordinary skill in the art to position the wire filament of claim 7 from U.S. Patent No. 4,901,661 on the bottom face of the ribbon since the placement of the wire filament on either the top or bottom face of the ribbon is a matter of designer's choice since claimed relationship does not solve a stated problem or yield an unexpected result. See In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5 and 6 under 35 U.S.C. § 251 is reversed; and a new rejection of claims 1, 2, 5 and 6 for obviousness-type

double patenting has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT Administrative Patent Judge	)	
IRWIN CHARLES COHEN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

Appeal No. 97-3187
Application No. 07/999,422

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APPENDIX

Claims 1, 3 and 7 from U.S. Patent No. 4,901,661

1. A decorative edge-reinforced ribbon comprising:

a web of ribbon material having a lateral folded edge;

a wire filament disposed along and within the fold of said edge; and

stitch means for securing the folded edge of the web around said wire filament, said means including a trim filament passing through the ribbon material and positioned substantially around the wire filament and the folded edge, thereby substantially covering the edge and the wire filament from view, and a binding filament passing through the ribbon material and around the wire filament, the folded edge and the trim filament, thereby securing the wire filament and the trim filament to the folded edge.

3. A ribbon according to claim 1, wherein the wire filament is of galvanized steel, the trim filament is of metallic thread, and the binding filament is a solid monofilament.

7. A method of securing a wire along an edge of a fabric ribbon, comprising the steps of:

positioning a wire filament adjacent to and in parallel contact with said edge;

folding the edge of the ribbon around the wire filament, such that at least some of the circumference of the wire filament is coextensive with and covered by the ribbon, thereby creating a sleeve of fabric for engaging the wire filament; and

stitching said wire filament to said edge using at least two additional filaments, such that the wire filament is in tight engagement with the edge, said stitching step including, in a single continuous operation, passing a trim filament through the ribbon and around the edge and the wire filament, said trim filament covering substantially all of the wire filament from view, and passing a binding filament through the ribbon and around the edge, the trim filament and the wire filament, thereby securing the wire filament to the edge.

Claims 1 and 2 from U.S. Patent No. 4,981,095 and from Application No. 07/999,422

1. A decorative ribbon comprising:

a web of ribbon material having two faces and a folded edge therebetween;

a wire filament disposed along and within said edge; and

stitch means for securing the edge of the web to said wire filament, said stitch means including a trim filament, said trim filament substantially covering the edge and the wire filament from view from at least one said face, and a binding filament passing through said web proximate to said edge and interlocking with the trim filament to secure the wire filament and the trim filament to the edge, said binding filament and trim filament being of different constructions.

2. A method of securing a wire filament along an edge of a fabric ribbon, comprising the steps of:

positioning a wire filament adjacent to and in parallel contact with said edge;

folding the edge of the ribbon around the wire filament such that at least some of the circumference of the wire filament is coextensive with and covered by the ribbon, thereby creating a sleeve of fabric for engaging the wire filament; and

stitching said wire filament to said edge using at least two additional filaments, such that the wire filament is in tight engagement with the edge, said stitching step including, in a single continuous operation, passing a trim filament at least partially around the edge and the wire filament, said trim filament covering substantially all of the wire filament from view from at least one face of the ribbon, and passing a binding filament through the ribbon proximate the edge, and intermingling said binding filament with the trim filament and the wire filament to secure the wire filament to the edge.

Claims 5 and 6 from Application No. 07/999,422

5. A method of securing a wire filament along an edge of a web of fabric ribbon having top and bottom faces and at least a first edge therealong, said method comprising the steps of:

positioning a wire filament along said web of fabric in parallel relationship with and adjacent to said first edge of said web; and

stitching said wire filament to said fabric web using at least two additional filaments, such that said wire filament is in tight engagement with of [sic] said web, said stitching step including, in a single continuous operation:

passing a binding filament through said web and around said wire filament to secure said wire filament against said web, and interlocking a trim filament with said binding filament along said web such that said trim filament substantially covers said wire filament and said edge from view along at least one of said faces.

6. A method as claimed in claim 5, wherein said wire filament is positioned along said bottom face of said web.

APPEAL NO. 97-3187 - JUDGE NASE
APPLICATION NO. 07/999,422

APJ NASE

APJ COHEN

APJ CALVERT

DECISION: **REVERSED**; **1.196(b)**

Prepared By: Delores A. Lowe

DRAFT TYPED: 26 Sep 97
1st Rev. 09 Dec 97

FINAL TYPED: