

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL PY

Appeal No. 99-0184
Application No. 08/567,510¹

ON BRIEF

Before COHEN, FRANKFORT, 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 9 through 15. Claims 1 through 8, the other claims pending in this application, have been allowed.²

¹ Application filed December 5, 1995, for reissue of U.S. Patent No. 5,267,986 (Application No. 07/863,943, filed April 6, 1992).

² It appears to us that claims 2 and 3 should be made to be dependent on claim 6 to provide antecedent basis for "the finger."

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We REVERSE.

BACKGROUND

The appellant's invention relates to a cartridge for applying medicament to an eye from a dispenser. A copy of claims 9 through 15 is attached as Exhibit A to the appellant's brief.³

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

Claim 15 stands rejected under 35 U.S.C. § 251.

Claims 9 through 14 stand rejected under 35 U.S.C. § 251.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the second Office action (Paper No. 7, mailed January 30, 1997) and the examiner's answer (Paper No. 14, mailed February 12, 1998) for the

³ Claims 9 through 15 were presented in a preliminary amendment filed on December 5, 1995. We note that this amendment has not been clerically entered and that the format thereof (e.g., lack of underlining) is not appropriate (see current rule 37 CFR § 1.121(b)).

examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed November 25, 1997) and reply brief (Paper No. 15, filed April 7, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we will not sustain the examiner's rejection of claims 9 through 15 under 35 U.S.C. § 251 for the following reasons.

Claim 15

We will not sustain the rejection of claim 15 under 35 U.S.C. § 251.

The issue presented by the examiner and the appellant is whether the "divisional doctrine" is applicable in this application. We agree with the appellant's arguments (brief, pp. 10-14, reply brief, pp. 8-12) that the "divisional doctrine" is not applicable in this application. The

"divisional doctrine" as set forth in In re Orita, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977) 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 clearly does not apply to the facts of this case. In that regard, we note that method claim 15 was never subject to a restriction requirement. Thus, there never was a determination by the PTO that the subject matter of claim 15 was restrictable from the subject matter of claims 1 through 8 (i.e., that the subject matter of claim 15 defines an independent and distinct invention from the subject matter of claims 1 through 8). 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.⁴

⁴ In addition, we direct the examiner's attention to the public record set forth in the unpublished decision of the U.S. Court of Appeals for the Federal Circuit reproduced at 36 USPQ2d 1510 (**In re Swartzel**).

For the reasons stated above, the decision of the examiner to reject claim 15 under 35 U.S.C. § 251 is reversed.

Claims 9 through 14

We will not sustain the rejection of claims 9 through 14 under 35 U.S.C. § 251.

The issue presented by the examiner and the appellant is whether the "recapture doctrine" is applicable in this application. We agree with the appellant's arguments (brief, pp. 16-25, reply brief, pp. 13-18) that the "recapture doctrine" is not applicable in this application.

An attorney's failure to appreciate the full scope of the invention qualifies as an error under 35 U.S.C. § 251 and is correctable by reissue. In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 370-71 (Fed. Cir. 1984). Nevertheless, "deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. Section 251." Haliczer v. United States, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). The recapture rule,

therefore, prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. See Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). Under this rule, claims that are "broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution" are impermissible. Id. at 996, 27 USPQ2d at 1525. In addition, to determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

The "recapture doctrine" clearly does not apply to the facts of this case. In that regard, we note that the appellant never amended the claims in an effort to overcome a prior art rejection. Thus, the appellant never surrendered any particular subject matter that would be subject to the "recapture doctrine." Furthermore, while original patent

claims 1 through 6 were drawn to the cartridge per se, original patent claims 7 and 8 were drawn to the combination of a cartridge with a dispenser. Accordingly, it is clear to us the examiner's rejection of claims 9 through 14 is in error.

For the reasons stated above, the decision of the examiner to reject claims 9 through 14 under 35 U.S.C. § 251 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9 through 15 under 35 U.S.C. § 251 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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APPLICATION NO. 08/567,510

APJ NASE

APJ FRANKFORT

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 20 Jan 99

FINAL TYPED: