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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/792,636	03/11/2013	Paul Morgavi	1032326-000594	7982
21839	7590	11/22/2019	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			RIMELL, SAMUEL G	
			ART UNIT	PAPER NUMBER
			3992	
			NOTIFICATION DATE	DELIVERY MODE
			11/22/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL MORGAVI

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1
Technology Center 3900

Before JOHN A. JEFFERY, RAE LYNN P. GUEST, and ERIC B. CHEN,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Under 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, and 94–104. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Gemalto SA. Appeal Br. 2.

STATEMENT OF THE CASE

Appellant seeks to reissue U.S. Patent 7,286,257 B1 (“257 patent”) directed to a printing machine with a jet printing head and controller to (1) perform ink jet printing on particular areas on the surface of a medium, such as a card, and (2) avoid printing on other areas, such as a card’s margin or magnetic strip. *See generally* Abstract; col. 3, l. 65–col. 4, l. 47; col. 5, ll. 4–10. Claim 27 is illustrative:

27. A method for printing on a medium, comprising the steps of:
capturing image data of the medium:
analyzing or interpreting said captured image data in order to measure geometric and/or positioning parameters of the medium and/or to detect at least one feature of the medium, and
printing on the medium or positioning the printing, in accordance with said geometric and/or positioning parameters and/or detected feature of the medium.

THE REJECTIONS

The Examiner rejected claims 27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, and 94–104 under 35 U.S.C. § 251 as being broadened in a reissue application outside the two-year statutory period. Final Act. 6.²

The Examiner rejected claims 27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, and 94–104 under 35 U.S.C. § 102(b) as anticipated by Morgavi (US 7,286,257 B1; issued Oct. 23, 2007).³ Final Act. 7.

² Throughout this opinion, we refer to (1) the Final Office Action mailed September 1, 2017 (“Final Act.”); (2) the Appeal Brief filed March 1, 2018 (“Appeal Br.”); (3) the Examiner’s Answer mailed June 1, 2018 (supplemented July 18, 2018) (“Ans.”); and (4) the Reply Brief filed August 1, 2018 (“Reply Br.”).

³ This is also the patent for which reissue is sought.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

The Examiner rejected claims 27–31, 39, 48–57, 61–63, 68–75, 78–80, 84–92, 94–96, and 99–104 under 35 U.S.C. § 102(b) as anticipated by Elgar (US 2004/0160624 A1; published Aug. 19, 2004). Final Act. 7–22.

The Examiner rejected claims 58 and 59 under 35 U.S.C. § 103 as unpatentable over Elgar. Final Act. 22–23.

The Examiner rejected claims 47 and 64–67 under 35 U.S.C. § 103 as unpatentable over Elgar and Klinefelter (US 6,694,884 B2; issued Feb. 24, 2004). Final Act. 23–24.

The Examiner rejected claims 34–36, 81–83, 97, and 98 under 35 U.S.C. § 103 as unpatentable over Elgar and Houmeau (US 2005/0117053 A1; published June 2, 2005). Final Act. 24–29.

The Examiner rejected claim 37 under 35 U.S.C. § 103 as unpatentable over Elgar, Houmeau, and Nioche (US 5,943,238; issued Aug. 24, 1999). Final Act. 29.

The Examiner rejected claim 40 under 35 U.S.C. § 103 as unpatentable over Elgar, Houmeau, and Hatayama (US 7,614,723 B2; issued Nov. 10, 2009). Final Act. 29–30.

THE § 251 REJECTION

The Examiner finds that the present reissue application improperly broadens the patented claims beyond the two-year statutory period. Final Act. 6. According to the Examiner, because of various defects in six related applications⁴ that were filed in a chain of priority in an attempt to reissue the

⁴ Although the Examiner lists seven applications that were filed after the '257 patent issued (Ans. 4), the last application listed, namely Application

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

'257 patent—defects that rendered those applications incomplete—the earliest of those applications, namely U.S. Application 12/436,571 (“’571 application”), is not a reissue application, but rather a regular continuation application under *In re Bauman*, 683 F.2d 405 (CCPA 1982). Ans. 8. Because there were no other reissue applications filed before this “*Bauman*-type” continuation application, the Examiner reasons that the other applications filed after the ’571 application—including the present application—cannot be reissue applications, but rather are “*Bauman*-type” continuation applications subject to the requirements of 35 U.S.C. § 120. Ans. 8–13. The Examiner adds that because the filing fee was not paid in one of the applications in the priority chain, namely U.S. Application 13/167,096 (“’096 application”), the present application’s effective filing date cannot extend earlier than January 11, 2012—the filing date of the subsequent copending application in the priority chain, namely U.S. Application 13/348,086 (“’086 application”).⁵ Thus, the Examiner further rejected all claims over intervening prior art after the filing date of the ’257 patent and after the filing date of the ’571 application, including the ’257 patent itself.

Appellant argues that, despite various defects, the ’571 application is nonetheless a broadening reissue application given the filing of (1) the

No. 13/792,636, is the present application. Therefore, there are six applications related to the present application that were filed after the ’257 patent issued.

⁵ Although the Examiner finds that the present application’s effective filing date is March 11, 2013 on page 6 of the Final Office Action, the Examiner nonetheless finds that the effective filing date is January 11, 2012 on pages 5 and 13 of the Answer.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

assignee's written consent indicating the patentee's accepting reissue restrictions at filing, and (2) broadened claims indicating unequivocally an intent to broaden the patented claims within the statutory period. Reply Br. 2–4. Appellant adds that because other applications in the priority chain were each filed with indicia of a continuation reissue application, namely (1) a specification in double column reissue format; (2) amendments in proper format; and (3) statements of assignee ownership and consent, the applications should therefore be treated as such consistent with USPTO policy. Appeal Br. 15–17; Reply Br. 2–5. Appellant adds that, contrary to the Examiner's assertion, the '096 application's filing fee was paid while that application was pending. Reply Br. 1–2.

ISSUE

Under § 251, has the Examiner erred in rejecting claims 27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, and 94–104 by finding that they impermissibly broaden the patented claims outside the two-year statutory period? This issue turns on whether (1) the '571 application is a timely-filed broadening reissue application, and (2) the other applications in the priority chain, including the present application, are continuation reissue applications. To the extent the '571 application is a timely-filed broadening reissue application, and all applications in the priority chain, including the present application, are continuation reissue applications, the present application would have a priority date of at least September 4, 2001, the U.S. National phase filing date of the application that issued as the '257 patent, thus obviating the prior art rejections based on later intervening prior art.

ANALYSIS

The '257 patent, which Appellant seeks to reissue, issued on October 23, 2007. On May 6, 2009, Appellant filed the '571 reissue application that included, among other things, (1) a transmittal identifying the application as a reissue application, (2) a specification and claims in double column patent format; (3) an amendment adding claims 24 to 61, where these newly-added claims were underlined; (4) the assignee's consent "to the filing of the accompanying application to reissue the patent" with the associated statement under 37 C.F.R. § 3.73(b); (5) a combined declaration and power of attorney by the assignee, where the declaration stated, among other things, that the '257 patent was partly inoperative due to the patentee claiming less than it had a right to claim; and (6) a petition to accept the declaration without the inventor's signature.⁶ *See* '571 Application, Reissue Patent Application Transmittal Letter filed May 6, 2009.⁷

Appellant's petition in the '571 application, however, was dismissed on September 15, 2009, for failing to show that (1) a complete copy of the application was sent to the inventor, and (2) the registered practitioner who signed the declaration, James A. LaBarre, was authorized to act on the assignee's behalf. *See* '571 Application, Petition Decision mailed Sept. 15,

⁶ The petition asserts that the inventor refused to sign the Declaration for Reissue Patent Application. *See* '571 Application, Petition Under 37 C.F.R. § 1.47(b) to Accept Declaration Without Inventor's Signature filed May 7, 2009.

⁷ Appellant's petition is dated May 7, 2009, and was filed that day.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

2009. The '571 application was abandoned on August 27, 2010 for failure to reply timely to the petition decision.

Before this abandonment, however, on March 15, 2010, Appellant filed U.S. Application 12/659,632 (“’632 application”) with a utility Transmittal of New Application form and an application data sheet identifying the application as a continuation utility application of the '571 reissue application. The application further included, among other things, (1) a specification and claims in double column patent format; (2) an amendment adding broadened claims 24 to 61, where these newly-added claims were underlined; and (3) the assignee’s written consent “to the filing of the accompanying application to reissue the patent” and statement under 37 C.F.R. § 3.73(b). *See* '632 Application, Transmittal of New Application filed Mar. 15, 2010. After the USPTO mailed a Notice to File Missing Parts of Nonprovisional Application on April 2, 2010 (“’632 Application Missing Parts Notice”) indicating, among other things, that (1) the statutory basic filing fee, and (2) the inventor’s oath or declaration were missing, the application was abandoned on December 20, 2010 for failure to reply timely or properly to the missing parts notice—an abandonment that was revived on June 21, 2017.

Before this abandonment, however, on November 2, 2010, Appellant filed U.S. Application 12/938,313 (“’313 application”) with a utility Transmittal of New Application form and an application data sheet identifying the application as a continuation utility application of the '632 application, and included, among other things, (1) a specification and claims in double-column patent format; (2) an amendment adding broadened claims

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

24 to 61, where these newly-added claims were underlined; and (3) the assignee's written consent "to the filing of the accompanying application to reissue the patent" and statement under 37 C.F.R. § 3.73(b). *See* '313 Application, Transmittal of New Application filed Nov. 2, 2010. After the USPTO mailed a Notice to File Missing Parts of Nonprovisional Application on November 23, 2010 ("'313 Application Missing Parts Notice") indicating, among other things, that (1) the statutory basic filing fee, and (2) the inventor's oath or declaration were missing, the application was abandoned on July 8, 2011 for failure to reply timely or properly to the missing parts notice—an abandonment that was revived on June 21, 2017.

Before this abandonment, however, on June 23, 2011, Appellant filed the '096 application with a utility application transmittal form and an application data sheet identifying the application as a continuation utility application of the '313 application, and included, among other things, (1) a specification and claims in double column patent format; (2) an amendment adding broadened claims 24 to 61, where these newly-added claims were underlined; and (3) the assignee's written consent "to the filing of the accompanying application to reissue the patent" and statement under 37 C.F.R. § 3.73(b). *See* '096 Application, Transmittal of New Application filed June 23, 2011. After the USPTO mailed a Notice to File Missing Parts of Nonprovisional Application on July 11, 2011 ("'096 Application Missing Parts Notice") indicating, among other things, that (1) the statutory basic filing fee, and (2) the inventor's oath or declaration were missing, the application was abandoned on May 1, 2012 for failure to reply timely or

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

properly to the missing parts notice.⁸ Revival of the '096 Application was not requested.

Before this abandonment, however, on January 11, 2012, Appellant filed the '086 application with a utility Transmittal of New Application form and an application data sheet identifying the application as a continuation utility application of the '096 application,⁹ and included, among other things, (1) a specification and claims in double column patent format; (2) an amendment adding broadened claims 24 to 61, where these newly-added claims were underlined; and (3) the assignee's written consent "to the filing of the accompanying application to reissue the patent" and statement under 37 C.F.R. § 3.73(b). *See* '086 Application, Transmittal of New Application filed Jan. 11, 2012; *see also* '086 Application Data Sheet filed Jan. 11, 2012. After the USPTO mailed a Notice to File Missing Parts of Nonprovisional Application on January 26, 2012 ("'086 Application Missing Parts Notice") indicating, among other things, that (1) the statutory basic filing fee, and (2) the inventor's oath or declaration were missing, the application was abandoned on October 22, 2012 for failure to reply timely or properly to the missing parts notice¹⁰—an abandonment that was revived on June 21, 2017.

⁸ Although a reply to the '096 Application Missing Parts Notice was received on January 11, 2012, the reply was deemed incomplete due to, among other things, a missing oath or declaration. *See* '096 Application Notice of Incomplete Reply mailed Jan. 20, 2012.

⁹ Although the Transmittal of New Application form filed January 11, 2012 indicates that the '086 application is a continuation of the '313 application, the Application Data Sheet nonetheless indicates that the '086 application is a continuation of the '096 application.

¹⁰ Although a reply to the '086 Application Missing Parts Notice was received on July 26, 2012, the reply was deemed incomplete due, among

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

Before this abandonment, however, on July 26, 2012, Appellant filed the '773 application with a utility Transmittal of New Application form and an Application Data Sheet identifying the application as a continuation utility application of the '086 application,¹¹ and included, among other things, (1) a specification and claims in double column patent format; (2) an amendment adding broadened claims 24 to 61, where these newly-added claims were underlined; and (3) the assignee's written consent "to the filing of the accompanying application to reissue the patent" and statement under 37 C.F.R. § 3.73(b). *See* '773 Application, Transmittal of New Application filed July 26, 2012; *see also* '773 Application Data Sheet filed July 26, 2012. After the USPTO mailed a Notice to File Missing Parts of Nonprovisional Application on August 10, 2012 ("773 Application Missing Parts Notice") indicating, among other things, that (1) the statutory basic filing fee, and (2) the inventor's oath or declaration were missing, the application was abandoned on April 2, 2013 for failure to reply timely or properly to the missing parts notice—an abandonment that was revived on June 21, 2017.

Before this abandonment, however, on March 11, 2013,¹² Appellant filed the present '636 application with a utility Transmittal of New

other things, a missing (1) oath or declaration, and (2) statutory filing fee. *See* '086 Application Notice of Incomplete Reply mailed August 2, 2012.

¹¹ Although the Transmittal of New Application form filed July 26, 2012 indicates that the '773 application is a continuation of the '313 application, the Application Data Sheet nonetheless indicates that the '773 application is a continuation of the '086 application.

¹² Between the filing of the '773 Application and the present '636 Application, the Leahy-Smith America Invents Act of September 16, 2011,

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

Application form and an application data sheet identifying the application as a continuation utility application of the '773 application, and included, among other things, (1) a specification and claims in double column patent format; (2) an amendment adding broadened claims 24 to 61, where these newly-added claims were underlined; and (3) the assignee's written consent "to the filing of the accompanying application to reissue the patent" and statement under 37 C.F.R. § 3.73(b). *See* '636 Application, Transmittal of New Application filed Mar. 11, 2013; *see also* '636 Application Data Sheet filed Mar. 11, 2013. Notably, the present '636 application Specification was later amended to identify (1) the '571 application as a *reissue* application, and (2) the later-filed continuing applications—including the present '636 application—as *reissue continuation* applications. *See* Amdt. filed May 7, 2015.

The '571 application is a broadening reissue application

On this record, we agree with Appellant (Reply Br. 2–4) that the '571 application is a broadening reissue application—not a regular continuation application as the Examiner indicates (Ans. 8). First, the '571 application was filed on May 6, 2009 to reissue the '257 patent,¹³ and was the first in the

became effective on September 16, 2012. The Act amended the declaration requirement under 35 U.S.C. § 115 such that a statement by an assignee may be filed where the inventor is under obligation to assign the invention but has refused to sign an inventor's oath. *See* 35 U.S.C. § 115(d)(2)(B); 37 C.F.R. § 1.64 (2017). Thus, a Notice to File Missing Parts in the present application did not indicate the inventor's oath or declaration was missing.

¹³ *Accord* '571 Application, Petition Decision mailed Sept. 15, 2009, at 1 (acknowledging this reissue application). *See also* '571 Application, Notice

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

above-noted series of applications filed after the '257 patent issued that led ultimately to the filing of the present application. That is, the '571 application is simply a reissue application—not a continuation application.

That the '571 application included, among other things, (1) a specification and claims in double column patent format; (2) an amendment adding broadened claims 24 to 61, where these newly-added claims were underlined; (3) the assignee's consent to reissue the patent and offer to surrender the original patent with the associated statement under 37 C.F.R. § 3.73(b); (4) a combined declaration and power of attorney by the assignee, where the declaration stated, among other things, that the '257 patent was partly inoperative due to the patentee *claiming less than it had a right to claim* as noted previously indicates clearly an intent to broaden the patented claims via the '571 reissue application. Moreover, the '571 application was filed on May 6, 2009 that is less than two years after the '257 patent issued on October 23, 2007, thus satisfying the statutory two-year requirement for broadening reissue applications. *See* 35 U.S.C. § 251.

That there were defects in this filing, namely that Appellant failed to show that (1) a complete copy of the application was sent to the inventor who refused to sign the declaration, and (2) the registered practitioner who signed the declaration, James A. LaBarre, was authorized to act on the assignee's behalf, does not obviate the '571 application's status as a broadening reissue application. *See* '571 Application, Petition Decision mailed Sept. 15, 2009. As Appellant indicates (Reply Br. 2–4), these defects

to File Missing Parts of Reissue Application (according an application number and filing date to “this *reissue* application”) (emphasis added).

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

were not germane to the indicia of Appellant’s intent to reissue the ’257 patent via the ’571 application, including (1) the assignee’s written consent to reissue the patent, and (2) the broadened claims that were filed in the ’571 application to correct the identified error in the patent, namely that the patentee claimed less than it had a right to claim. That the ’571 application was later abandoned for failure to reply timely to the petition decision likewise does not obviate that application’s status as a broadening reissue application—an application that has priority at least as early as the filing date of the ’257 patent’s underlying U.S. Application 09/914,868, namely September 4, 2001.¹⁴ To the extent that the Examiner finds otherwise (*see* Ans. 6–9), we disagree.

The applications filed after the ’571 application are reissue continuation applications

On this record, we also agree with Appellant (Appeal Br. 15–17; Reply Br. 4–5) that the applications filed after the ’571 application (“the post-’571 applications”), including the present ’636 application, are reissue continuation applications—not regular or “*Bauman-type*” continuation applications as the Examiner indicates (Ans. 9–13).

As noted previously, each application filed after the ’571 application was styled as a continuation application, and there was copendency between

¹⁴ Although Appellant contends that the effective filing date is February 21, 2000—the filing date of the ’257 patent’s underlying PCT Application PCT/FR00/00454—we need not determine whether Appellant is entitled to this earlier date, for the ’257 patent’s U.S. filing date of September 4, 2001 is dispositive of this appeal.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

successive applications such that the chain of priority was maintained back to the '571 reissue application. *Accord* '636 Application Bib. Data Sheet (summarizing this chain of priority in the “Continuing Data” section).

To be sure, filing a continuation application of a reissue application does not guarantee that the continuation application is also a reissue application. *See Bauman*, 683 F.2d at 409; *see also* Manual of Patent Examining Procedure (MPEP) § 1451 (9th ed. Rev. 08.2017, Jan. 2018) (“[T]he mere fact that the application purports to be a continuation or divisional of a parent reissue application does not make it a reissue application itself, since it is possible to file a [regular] . . . continuing application of a reissue application.”). Therefore, to ensure that a continuation application is also a reissue application with its earlier filing date, namely the effective filing date of the patent for which reissue is sought, the patentee must accept “reissue restrictions.” *See Bauman*, 683 F.2d at 409. Otherwise, the patentee must accept a later filing date, namely that of the associated reissue application, via a regular continuation application. *See id.*; *see also* MPEP § 1451 (referring to “*Bauman*-type” continuation applications).

As the *Bauman* court explains, the key differences between regular and reissue applications relate to the legal effect of patents issuing from those applications. *Bauman*, 683 F.2d at 409. Unlike regular utility patents, reissue patents are (1) issued for the original patent’s unexpired term; (2) subject to intervening rights under 35 U.S.C. § 252; and (3) are issued only

upon surrender of the original patent.¹⁵ *Id.* These reissue restrictions, however, can be avoided by filing a regular continuing application—a so-called “*Bauman-type*” continuation or divisional application. *See id.*; *see also* MPEP § 1451.

Unlike reissue continuation¹⁶ applications, “*Bauman-type*” continuation applications are limited to the filing date of the reissue application—not that of the original patent. *See Bauman*, 683 F.2d at 409; *see also* MPEP § 1451. Nor can a patentee who files a “*Bauman-type*” continuation application file a later reissue application of the original patent once there are no pending reissue applications. *Id.*

Therefore, if a patentee chooses to file a reissue continuation application, it is crucial that the patentee identify clearly and unambiguously that is the case: otherwise, the application could be considered a “*Bauman-type*” continuation application. *See id.* To this end, (1) the application data sheet must state, or (2) the specification must be amended to state that the application is a “continuation reissue application” of its parent reissue application. *Id.* The MPEP notes that, in general, a continuing application of a reissue application will be considered a “*Bauman-type*” continuing application when there are *no indicia* on filing that a continuing reissue application is filed. *See id.*

¹⁵ The original patent’s surrender now occurs when the reissued patent issues. *See* 35 U.S.C. § 252; *see also* MPEP § 1416 (noting that before October 21, 2004, a reissue applicant was required to physically surrender the letters patent before the reissue application would be granted).

¹⁶ Although we refer to only reissue continuation applications here and later in the opinion for brevity, these general principles also apply to reissue divisional applications.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

The MPEP lists six such indicia that a continuing reissue application is filed, namely (1) a 37 C.F.R. § 1.175 oath/declaration, which is not merely a copy of the parent's reissue oath/declaration; (2) a specification and/or claims in proper double column reissue format per 37 C.F.R. § 1.173; (3) amendments in proper format per 37 C.F.R. § 1.173; (4) a 37 C.F.R. § 3.73 statement of assignee ownership and consent; (5) a correct transmittal letter identifying the application as a reissue filing under 35 U.S.C. § 251; and (6) an identification of the application as being (a) a reissue continuation of the parent reissue application; (b)(i) a continuation of the parent reissue application, *and* (ii) an application to reissue the patent; or (c) equivalent language. Notably, indicia (6) most clearly distinguishes these identifications from merely stating that the application is a continuation of the parent reissue application, and the MPEP gives nine examples of acceptable identifications of reissue continuing applications as opposed to “*Bauman-type*” continuation applications. *Id.*

Although the MPEP does not specify how many of the six enumerated indicia must be present to identify a reissue continuation application, the MPEP nonetheless states explicitly that when there are *no such indicia* on filing, a continuing application of a reissue application will be considered a “*Bauman-type*” continuing application. MPEP § 1451. Notably, the Examiner apparently construes this section to require satisfying *only one* of the six enumerated criteria to indicate that a reissue continuation application is filed as opposed to a “*Bauman-type*” continuation application. *See* Ans. 11 (“If an applicant supplies *one* of the indicia at the time of filing, a working assumption is made that the applicant intended to file a reissue

continuation”); *see also id.* (referring to the “*at least one* indicia policy” in MPEP § 1451) (emphases added).

Nevertheless, Appellant contends that because *three* such indicia were present in each application filed after the ’571 application by containing (1) a specification in double column reissue format; (2) amendments in proper format; and (3) statements of assignee ownership and consent which characterizes the application as an “application to reissue the patent,” the post-’571 applications should therefore be treated as reissue continuation applications consistent with USPTO policy. Appeal Br. 15–17; Reply Br. 2–5.

Although these three indicia could arguably be present in a regular “*Bauman*-type” continuation application, their presence in the post-’571 applications nonetheless weighs in Appellant’s favor, at least to the extent that the three indicia, considered in light of the other evidence of record,¹⁷ at least suggest that Appellant was willing to accept “reissue restrictions” noted by the *Bauman* court when those applications were filed. *See Bauman*, 683 F.2d at 409. *Accord* Appeal Br. 15 (noting this point). That the present ’636 application’s Specification was amended to specify explicitly that each post-’571 application was a *reissue continuation* application of its respective predecessor application—thus providing the sixth enumerated indicator in

¹⁷ Although not included in MPEP § 1451’s enumerated indicia, we note that the Appellant filed the same broadened claim set in each application, which further evidences Appellant’s intent to file broadening reissue continuations in each application throughout the priority chain, as opposed to *Bauman*-type continuation applications where such broadened claims are improper.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

MPEP § 1451¹⁸—only further weighs in favor of Appellant in this regard, as does the fact that all applications filed after the '257 patent issued recited broadened claims indicating unambiguously an intent to broaden the patented claims via reissue. *See* Reply Br. 2–4.

We reach this conclusion despite these applications' defects that ultimately resulted in their abandonment. Leaving aside the fact that four of those abandoned applications have been revived as the Examiner acknowledges (Ans. 4), and the fees have been paid in all applications in the priority chain as Appellant indicates (Appeal Br. 14–15; Reply Br. 1–2),¹⁹

¹⁸ Notably, the Utility Patent Application Transmittal Form PTO/AIA/15 Form and Application Data Sheet filed March 11, 2013 in the present '636 application do not clearly identify the application (or any other post-'571 applications) as reissue continuation applications consistent with the guidance in the Reissue Application Filing Guide for Applications filed on or after September 16, 2012 (“Reissue Filing Guide”) referenced in MPEP § 1451. *See* Reissue Filing Guide, at 8–9 (noting that the Reissue Patent Application Transmittal Form PTO/AIA/50 provides the ability to identify reissue continuation applications by merely checking the appropriate box); *see also id.* at 10 (showing an example of how to make this identification on the Application Data Sheet). Although it is unclear why Appellant did not use this straightforward identification procedure in the '636 application or file a supplemental Application Data Sheet correcting the information under 37 C.F.R. § 1.76(c), Appellant's amendment to the '636 application on May 7, 2015 nevertheless is consistent with the recommendation in MPEP § 1451 to also identify reissue continuation applications in the first line of the Specification.

¹⁹ Although the Examiner finds that the filing fee was not paid in the '096 application during its pendency and, consequently, the present application's effective filing date cannot extend earlier than January 11, 2012, the filing date of the subsequent copending application in the priority chain, namely the '086 application (Ans. 4–5), this fee was, in fact, paid on January 11, 2012 as Appellant indicates. *See* Reply Br. 1–2 (citing evidence of this

the fact that the post-'571 applications' defects prevented their examination does not preclude their status as filed reissue applications. The Examiner's reliance on the reissue statute, 35 U.S.C. § 251, and associated regulations, namely 37 C.F.R. §§ 1.171–75, is unavailing in this regard. Although reissue applications have special filing requirements beyond those for regular utility applications, that does not mean that reissue continuation applications must be complete in all respects—including containing a complete reissue declaration—before those applications can be considered reissue continuation applications. The Examiner cites no such authority for such a rigid requirement—nor are we aware of such a requirement. Indeed, our reviewing court has permitted correction of a defective declaration in a broadening reissue application more than two years after the associated patent was granted. *See In re Bennett*, 766 F.2d 524, 528 (Fed. Cir. 1985). Although not precisely on point with the facts at issue here, *Bennett* nonetheless shows that an imperfect reissue declaration is not fatal to a broadening reissue application despite its unique statutory and regulatory requirements, and that some flexibility in correcting those defects is permissible—even after a statutory time period.

Here, although the defects in the post-'571 applications yielded incomplete applications that prevented their examination in all but the present '636 application, those deficiencies nevertheless did not materially affect their *status* as reissue continuation applications given the evidence on

payment). Accordingly, the Examiner's finding the present application's effective filing date is January 11, 2012 due to this alleged non-payment is incorrect.

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

this record.²⁰ Indeed, this result is consistent with similar situations involving utility patents, where the oath/declaration requirement for every application in a chain of continuing applications need not be completed for the parent utility application to be recognized. *Accord* Reply Br. 4–5 (noting this point). We see no reason to treat reissue continuation applications any differently.

Therefore, given the chain of priority established by the applications filed after the '257 patent issued, a priority that not only dates back to the filing of the '571 broadening reissue application on May 6, 2009—an application that sought to reissue the '257 patent whose effective filing date is at least as early as September 4, 2001. Accordingly, the Examiner's § 251 rejection premised on Appellant's broadening the patented claims outside the two-year statutory period is erroneous.

THE PRIOR ART REJECTIONS

Because the effective filing date of the present '636 application is at least as early as September 4, 2001 which predates the Morgavi and Elgar references on which the Examiner's anticipation and obviousness rejections are based (*see* Final Act. 7–30), these rejections are likewise erroneous.

²⁰ Indeed, for clarity, Appellant should file corrected supplemental Application Data Sheets, amend the first line of the Specifications in each pending application in this priority chain to identify the applications expressly as reissue continuation applications in accordance with the Reissue Application Filing Guide for Applications filed on or after September 16, 2012 (“Reissue Filing Guide”) referenced in MPEP § 1451, and file a supplemental declaration identifying an error relied upon as the basis for reissue in accordance with 37 C.F.R. § 1.175(a).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s) /Basis	Affirmed	Reversed
27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, 94–104	251	Improper Broadening		27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, 94–104
27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, 94–104	102(b)	Morgavi		27–31, 34–37, 39, 40, 47–59, 61–75, 78–92, 94–104
27–31, 39, 48–57, 61–63, 68–75, 78–80, 84–92, 94–96, 99–104	102(b)	Elgar		27–31, 39, 48–57, 61–63, 68–75, 78–80, 84–92, 94–96, 99–104
58, 59	103	Elgar		58, 59
47, 64–67	103	Elgar, Klinefelter		47, 64–67
34–36, 81–83, 97, 98	103	Elgar, Houmeau		34–36, 81–83, 97, 98
37	103	Elgar, Houmeau, Nioche		37
40	103	Elgar, Houmeau, Hatayama		40

Appeal 2018-007998
Reissue Application 13/792,636
Patent 7,286,257 B1

Overall Outcome				27-31, 34-37, 39, 40, 47-59, 61-75, 78-92, 94-104
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REVERSED