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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALEXANDER BORCK and NINA ADDEN

Appeal 2019-000960
Application 12/509,831
Technology Center 1600

Before FRANCISCO C. PRATS, JEFFREY N. FREDMAN, and TAWEN CHANG, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 2–7, 10, 13, 14, 16–19, 21, and 22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

The sole rejection before us for review is the Examiner's rejection of claims 2–7, 10, 13, 14, 16–19, 21, and 22 under pre-AIA[2] 35 U.S.C. §

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies Biotronik VI Patent AG, Baar Switzerland, as the real party in interest. Appeal Br. 2.

103(a) as being unpatentable over Bertsch,[3] Rathenow,[4] and Carlyle.[5] Non-Final 2–7 (entered March 10, 2017).

DISCUSSION

Issue

As noted above, the Examiner's obviousness rejection of claims 2–7, 10, 13, 14, 16–19, 21, and 22 over Bertsch, Rathenow, and Carlyle appears at pages 2–7 of the Non-Final Office Action entered March 10, 2017. *See* Non-Final 2–7.

Appellant does not assert error in the Examiner's characterization of the teachings in the references. *See* Appeal Br. generally. Nor does Appellant assert error in the Examiner's conclusion that, based on the teachings in the references, a skilled artisan would have considered the subject matter recited in the rejected claims obvious. *See id.*

Rather, in requesting reversal of the Examiner's obviousness rejection, Appellant contends that the Bertsch reference applied in the rejection does not qualify as prior art against the rejected claims under either pre-AIA 35 U.S.C. § 102(a) or pre-AIA § 102(b). *See* Appeal Br. 4.

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[2] The present application has a U.S. filing date of July 27, 2009. *See* Filing Receipt 1 (entered August 13, 2009). Accordingly, the pre-AIA versions of 35 U.S.C. §§ 102(b), 103(a), and 119(a) apply to Appellant's claims. *See* the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, § 3(n)(1) (2011). We therefore limit our discussion to the pre-AIA versions of the statutes.

[3] DE 10 2006 042 313 A1 (published Mar. 27, 2008). The Examiner relies on US 2008/0058923 A1 (published Mar. 6, 2008) as the English language version of Bertsch. *See* Appeal Br. 4, n.1.

[4] US 2005/0079201 A1 (published Apr. 14, 2005).

[5] US 2005/0175667 A1 (published Aug. 11, 2005).

In particular, Appellant contends, the present application claims priority under pre-AIA § 119(a) to German application DE 10 2008 040 786.0, which has a filing date of July 28, 2008 ("the German priority application"). *See* Appeal Br. 4. Appellant contends that, under pre-AIA § 119(a), the filing date of the German priority application should be considered the effective U.S. filing date of the present application, for purposes of determining whether prior art is applicable to the present application under § 102(b). *Id.* at 5–6.

Thus, Appellant contends, if the present application is entitled to its priority claim under § 119(a) to the German priority application, then the Bertsch reference cited by the Examiner is not prior art to the present application under § 102(b), because the Bertsch reference was published less than one year before the filing date of the German priority application. *See* Appeal Br. 5–6. Moreover, Appellant contends, although the Bertsch reference might nonetheless be applicable as prior art under § 102(a), the Borck Declaration[6] filed by Appellant establishes that the portions of the Bertsch reference relevant to the obviousness rejection at issue were not invented "by another" as required by § 102(a). *See id.*

The Examiner responds that, regardless of whether Appellant is granted its priority claim to the German priority application, the Bertsch reference qualifies as prior art under § 102(b) against the rejected claims because the Bertsch reference has a publication date more than one year before the filing date of the present application. *See* Ans. 4.

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[6] Declaration of Alexander Borck under 37 C.F.R. § 1.132 (signed April 25, 2016).

In view of the contentions of the Appellant and the Examiner outlined above, the critical issue in this case is whether Appellant has established that the Examiner erred in determining that the Bertsch reference qualifies as prior art against the rejected claims under § 102(b).

We acknowledge Appellant's contention that "[a] single issue that is determinative of this appeal concerns whether or not the present application is entitled to its priority claim under pre-AIA 35 U.S.C. § 119(a)." Appeal Br. 3. As evidenced by the discussion above, however, because Appellant seeks application of § 119(a) in a manner that disqualifies the Bertsch reference as prior art under § 102(b), the outcome in this case ultimately depends on whether the Bertsch reference qualifies as prior art under § 102(b).

Analysis

Having considered the arguments and evidence advanced by Appellant and the Examiner, Appellant does not persuade us that the Examiner erred in determining that the Bertsch reference qualifies as prior art against the rejected claims under § 102(b).

Pre-AIA 35 U.S.C. § 102(b) states:

> A person shall be entitled to a patent unless . . . the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Pre-AIA 35 U.S.C. § 119(a) states (emphasis added):

> An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United

> States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; ***but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.***

In the present case, it is undisputed that the Bertsch reference has a publication date (March 27, 2008) that is more than one year before the date the present application was filed in the United States (July 27, 2009). The Bertsch reference therefore qualifies as prior art against the claims of the present application under the terms of § 102(b), including in an obviousness rejection based on § 103(a). Our reviewing court's predecessor explained as follows:

> The fundamental principle which we discussed and applied in [*In re Foster*, 343 F.2d 980 (CCPA 1965)] is that an inventor is given a grace period of one year, within which to file his patent application in this country, after the occurrence of the events named in 35 U.S.C. § 102(b), which events are such as to make the invention claimed in the application available to the public in this country. Furthermore, as held in *Foster*, ***the principle***, which is intended to prevent dilatory filing, ***applies not only to the precise matter disclosed by the events of § 102(b) but also to claimed inventions which would be obvious from the matter disclosed by the events in the sense of § 103, to those of ordinary skill in the art as of a date one year prior to the filing of the U.S. application***.

In re Corcoran, 640 F.2d 1331, 1333 (CCPA 1981) (emphasis added); *see also* MPEP § 2133.II (citing *Foster* for the proposition that if a reference has

an effective date outside the one year § 102(b) grace period, then "the prior art need not be identical to the claimed invention but will bar patentability if it is an obvious variant thereof").

Despite the above-noted directives from *Foster*, *Corcoran*, and the MPEP, Appellant contends that when 35 U.S.C. § 119(a) is read as a whole (including the exception emphasized above), if a U.S. application is granted foreign priority under § 119(a), then a reference with a publication date less than one year before the foreign priority date qualifies as prior art under § 102(b) only if the reference anticipates the claims the reference is asserted against. *See* Appeal Br. 3–6.

In contrast, Appellant asserts, if a U.S. application is granted foreign priority under § 119(a), a reference that, as here, merely makes obvious the claims at issue, qualifies as prior art under § 102(b) only if the reference has a publication date more than one year before the foreign priority date. *See* Appeal Br. 3–6; *see also id.* at 9 ("To the extent that MPEP §2133.02 II is interpreted by the Examiner as adding an 'obviousness' exception to pre-AIA §119(a), it conflicts with the statute because the statute only includes the 'described in a printed publication' exception.").

We do not find Appellant's contentions persuasive. As Appellant notes, MPEP § 2133.02.II provides as follows (emphasis added):

> A rejection under pre-AIA 35 U.S.C. [§] 102(b) cannot be overcome by affidavits and declarations under 37 CFR 1.131 (Rule 131 Declarations), foreign priority dates, or evidence that applicant himself invented the subject matter. Outside the 1-year grace period, applicant is barred from obtaining a patent ***containing*** any anticipated ***or obvious claims***. *In re Foster,* 343 F.2d 980, 984 . . . .

Consistent with the MPEP's directive that a foreign priority claim cannot overcome an obviousness rejection based on a reference that qualifies as prior art under § 102(b), our reviewing court's predecessor explained that pre-AIA § 119(a) relates "***only*** to what an applicant or patentee may and may not do to protect himself ***against patent-defeating events occurring between his invention date and his U.S. filing date***." *In re Hilmer*, 424 F.2d 1108, 1112 (CCPA 1970) (emphasis added).

In the present case, as explained in *Hilmer*, Appellant's earliest possible invention date is the filing date of Appellant's German priority application (July 28, 2008). *See Hilmer*, 424 F.2d at 1112 ("[E]xcept as provided by § 119, an applicant or patentee may not establish a date of invention by reference to knowledge or use thereof, or other activity in a foreign country." (internal quotations omitted)).

As noted above, however, it is undisputed that the Bertsch reference (published March 27, 2008) has a publication date before the July 28, 2008, filing date of Appellant's German priority application. Therefore, the March 27, 2008, publication of the Bertsch reference is not a patent-defeating event that occurred between Appellant's earliest possible invention date (the July 28, 2008 filing date of the German priority application) and its U.S. filing date (July 27, 2009), but rather was published before Appellant's earliest possible invention date.

Because the publication of the Bertsch reference is not a patent-defeating event that occurred between Appellant's earliest possible invention date and its U.S. filing date, Appellant does not persuade us that its priority claim under § 119(a) disqualifies the Bertsch reference as prior art against the rejected claims of the present application. *See Hilmer*, 424 F.2d at 1112.

To the contrary, because the Bertsch reference was published (March 27, 2008) more than one year before the present application was filed in the United States (July 27, 2009), we agree with the Examiner that the Bertsch reference qualifies as prior art against the claims of the present application under pre-AIA § 102(b).

In sum, for the reasons discussed, Appellant does not persuade us that the Examiner erred in determining that the Bertsch reference qualifies as prior art against the present claims under § 102(b), even assuming that Appellant is granted foreign priority to the German priority application under § 119(a). Accordingly, on the current record, each of the Bertsch, Rathenow, and Carlyle references cited in the Examiner's obviousness rejection of claims 2–7, 10, 13, 14, 16–19, 21, and 22 qualifies as prior art against those claims.

Because Appellant does not assert error in the Examiner's conclusion that, based on the teachings in the Bertsch, Rathenow, and Carlyle, a skilled artisan would have considered the subject matter recited in claims 2–7, 10, 13, 14, 16–19, 21, and 22 obvious, we affirm the Examiner's rejection of claims 2–7, 10, 13, 14, 16–19, 21, and 22 over Bertsch, Rathenow, and Carlyle.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
2–7, 10, 13, 14, 16–19, 21, 22	103(a)	Bertsch, Rathenow, Carlyle	2–7, 10, 13, 14, 16–19, 21, 22	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED