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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/147,571	05/05/2016	Carl L.C. Kah JR.	47587/0013	2148
1912	7590	09/25/2019	EXAMINER	
AMSTER, ROTHSTEIN & EBENSTEIN LLP			KAUFMAN, JOSEPH A	
90 PARK AVENUE			ART UNIT	PAPER NUMBER
NEW YORK, NY 10016			3993	
			NOTIFICATION DATE	DELIVERY MODE
			09/25/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARL L.C. KAH JR.¹

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2
Technology Center 3900

Before DANIEL S. SONG, JILL D. HILL and CYNTHIA L. MURPHY,
Administrative Patent Judges.

SONG, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Office Action (mailed September 21, 2017, "Final Act.") rejecting claims 2–17 in the present reissue application filed on May 5, 2016. Claim 1 has been allowed. The reissue application seeks to reissue Patent US 9,254,502 B2 ("the '502 patent"), issued February 9, 2016, based on application 11/496,300, filed July 31, 2006. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

¹ Referred to as "Appellant." Appeal Brief (filed March 28, 2017, "App. Br.") 2.

We AFFIRM-IN-PART.

REPRESENTATIVE REISSUE CLAIM

The claimed invention is directed to a restriction valve for a sprinkler, independent claim 9 illustrative of the claimed invention being reproduced below:

9. A restriction valve for a sprinkler comprising:
 - a valve body positioned at an inlet of the sprinkler, wherein the valve body includes a central opening through which water flows into the sprinkler;
 - a rib extending downwardly from the valve body at a location beyond a margin of the central opening;
 - a valve member configured to cooperate with the central opening to open and close the valve;
 - wherein the valve member includes a valve stem positioned and configured to be movably supported in a guide ring formed at a lower end of the rib, wherein the valve stem, is movable vertically to move the valve member to its open and closed positions.

App. Br. 16, Claims App. (emphasis added).

Claims 2, 7, 8, and 17 are also independent claims, and are directed to a sprinkler comprising a restriction valve.

BACKGROUND and FINDINGS of FACT (“FF”)

We set forth the facts pertinent to the disposition of the present appeal below.

1. The '502 Patent issued February 9, 2016 from Application 11/496,300, filed on July 31, 2006 (“the 300 Application”), which claims benefit to provisional application No. 60/703,683, filed on July 29, 2005.

The '300 Application

2. The '300 Application included claims directed to a restriction valve (claims 1–9), and a sprinkler having a restriction valve (claims 10–19).

3. During the prosecution, the Examiner issued an Office Action restricting the '300 Application under 35 U.S.C. § 121, and required the applicant to elect for prosecution, one of two distinct inventions:

I. Claims 1–9, drawn to a restriction valve, classified in class 239, subclass 569.

II. Claims 10–19, drawn to a sprinkler, classified in class 239, subclass 203.

Office Action, mailed September 29, 2008.

4. Claim 1 was the sole independent claim directed a restriction valve in the original claims of the '300 Application, and read as follows:

1. A restriction valve for a sprinkler comprising:
 - a valve body adapted to be positioned at an inlet of the sprinkler, wherein the valve body includes a central opening through which water flows into the sprinkler;
 - a rib extending downwardly from the valve body at a location beyond the margin of the central opening;
 - a valve member configured to cooperate with the central opening to open and close the valve;wherein the valve member includes a valve stem extending downwardly from the valve member, and positioned and configured to be movably supported in a guide ring formed at a lower end of the rib, wherein the valve stem is movable vertically to move the valve

member to its open and closed positions; and

a resilient member biasing the valve stem such that the valve member remains in an open position until water pressure pushing against the valve member reaches a predetermined level to move the valve member into the closed position to restrict the flow of water into the sprinkler.

'300 Application Spec. p. 8.

5. In response, the applicant elected “Group II including claims 10–19,” without traverse. Response to Restriction Requirement, filed December 22, 2008.

6. Subsequent lengthy prosecution of the '300 Application involving multiple Office Actions by the Examiner and multiple amendments by the applicant, remaining claims 11–17 were rejected by the Examiner as unpatentable under 35 U.S.C. § 103(a) over US 6,530,531 B2 to Butler (iss. Mar. 11, 2003) in view of US 2,591,060 to Garretson (iss. Apr. 1, 1952), and claim 19 over US 7,318,556 B2 to Lee (iss. Jan. 15, 2008) in view of Garretson. Non-Final Action, mailed March 2, 2012, pp. 3, 8.

7. The applicant appealed the Examiner’s decision to the Board. Notice of Appeal, filed September 4, 2012.

8. On July 23, 2015, the Board issued its Decision on Appeal 2013-008854, Affirming-In-Part, the Examiner’s rejections. Decision on Appeal, mailed July 23, 2015 (“Decision”). In its Decision, the Board affirmed the Examiner’s prior art rejection of claims 11–15, 17, and 19, but reversed the rejection of claim 16. Decision 9.

9. The rejected claims were canceled by the Examiner in view of the Board’s Decision (Notice of Allowance, mailed Oct. 7, 2015, p. 2), and the '300 Application issued as the '502 Patent on February 9, 2016 with

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

claim 16 renumbered as claim 1.

10. The applicant did not appeal the Board's Decision to the Federal Circuit.

11. The applicant did not file any continuing applications based on the '300 Application prior to its issuance as the '502 Patent.

The '571 Reissue Application

12. The subject '571 Application seeking reissuance of the '502 Patent was filed May 5, 2016.

13. The Reissue Declaration was filed November 14, 2016 ("Reissue Decl.").

14. For the basis of the reissue application, the inventor declares "I believe the original patent to be wholly or partly inoperative or invalid . . . by reason of the patentee claiming more or less than he had the right to claim in the patent." Reissue Decl. 1.

15. The inventor identifies at least one error of the '502 Patent as follows: "Issued claim 1 is narrower than necessary. Claim 1 is amended in the present reexamination application to eliminate the requirement that the riser be spring biased. New claims 2-17 have also been added." Reissue Decl. 1.

16. Claim 9 is the sole independent claim in the '571 Application directed to a restriction valve, and reads as follows:

9. A restriction valve for a sprinkler comprising:
a valve body positioned at an inlet of the sprinkler, wherein the valve body includes a central opening through which water flows into the sprinkler;

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

a rib extending downwardly from the valve body at a location beyond a margin of the central opening;

a valve member configured to cooperate with the central opening to open and close the valve;

wherein the valve member includes a valve stem positioned and configured to be movably supported in a guide ring formed at a lower end of the rib, wherein the valve stem, is movable vertically to move the valve member to its open and closed positions.

App. Br. 16, Claims App.

ANALYSIS

Only those arguments actually made by the Appellant have been considered in this decision. Arguments that the Appellant could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also In re Jung*, 637 F.3d 1356, 1365–66 (Fed. Cir. 2011); *Ex parte Frye*, 94 USPQ2d 1072, 1075–76 (BPAI 2010 (precedential)).

Rejection Under 35 U.S.C. § 251

The Examiner rejects claims 9–16 under 35 U.S.C. § 251, finding the reissue declaration to be defective “because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based.” Final Office Action (“Final Act.”) 3, citing 37 C.F.R. § 1.175; MPEP §1414. In that regard, the Examiner reproduces MPEP §1402.01 in the Final Office Action, and referring thereto, explains that claims 9–16 are rejected due to the fact that the Appellant “failed to file a timely divisional

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

for the nonelected claims drawn to the restriction valve,” and that such failure “is not considered an error correctable by reissue.” Final Act. 3.

The Appellant disagrees and points out that the error identified in the reissue declaration is that “issued claim 1 of U.S. Patent No. 9,264,602 [sic, 9,254,502]² is narrower than necessary since it requires a ‘spring-biased riser.’ The pending claims, including claims 9-16 eliminate this requirement.” App. Br. 10; *see also* Reply Brief (“Reply Br.”) 2 (“Claims 9-16 do not require a spring-biased riser’ and thus are different in scope.”). The Appellant argues that “[a]ccordingly, pending claims 9-16 relate to a different invention than the non-elected claims” of the ’300 Application. App. Br. 10; *see also* Reply Br. 2. Thus, the Appellant argues that the reissue declaration “is accurate and properly identified an error on which a reissued application can be based.” App. Br. 11; *see also* Reply Br. 2.

The Appellant’s arguments are unpersuasive because although its Reissue Declaration may have set forth an adequate statement that identifies an error, its arguments do not sufficiently address the Examiner’s rejection. First, we observe that nonelected claims 1–10 in the prior ’300 Application were directed to a restriction valve, and did not recite a “spring-biased riser,” which is a component of the pop up sprinkler, not the restriction valve. *See* Spec. col. 1, ll. 31–38, 48–53.

Second, and perhaps more important, as the text of the rejection sets forth, the § 251 rejection is due to the fact that the Appellant’s “fail[ure] to file a timely divisional for the nonelected claims drawn to the restriction valve,” is not “an error correctable by reissue.” Final Act. 3. The Examiner

² The Appellant’s legal representative misidentifies the ’502 Patent throughout its Appeal Brief and Reply Brief.

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

even specifically reproduced the pertinent section of the MPEP § 1412.01 that provides the applicable law in setting forth the rejection. Final Act. 3.

The Examiner is correct. Applicants cannot “obtain[] by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent.” *In re Watkinson*, 900 F.2d 230, 232 (Fed. Cir. 1990) (quoting *In re Orita*, 550 F.2d 1277, 1280 (CCPA 1977)). “[G]ranting by reissue claims substantially identical to those non-elected in application [] would be ignoring the proper restriction requirement set forth in that application in which appellants acquiesced.” *In re Orita*, 550 F.2d at 1280. Thus, failure to file a timely divisional application to non-elected subject matter is not error correctable by reissue. *Id.*; *see also* MPEP § 1412.01.

The Appellant has clearly acquiesced to the restriction requirement during the prosecution of the '300 Application by electing prosecution of the claims directed to a sprinkler. FF 2, 3, 5. The Appellant's assertion that the reissue claims 9–16 of the present '571 Application relate to a different invention than the non-elected claims of the '300 Application (App. Br. 10) is unpersuasive. Although some of the language in some of the reissue claims 9–16 differs slightly from that of claims 1–10 of the '300 Application, the subject matter is substantially the same. For example, independent claim 9 of the '571 Application merely omits the limitation regarding “a resilient member” that was recited in independent claim 1 of the '300 Application, but such language is found in dependent claim 11 of the '571 Application. *E.g., compare* FF 4 *with* FF 16. Claims 2 and 5–9 of the '300 Application appear unchanged as claims 10 and 12–16 in the '571 Application.

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

Accordingly, claims 9–16 are directed to non-elected subject matter restricted out of the '300 Application that ultimately issued as the '502 Patent. Therefore, in view of the above, we affirm the Examiner's rejection of claims 9–16 under 35 U.S.C. § 251.

Estoppel

As to claims 2–8 and 17 directed to a sprinkler, under the heading of “Estoppel,” the Examiner reproduces 37 C.F.R. § 42.73(d)(3), the pertinent portion of the rule stating:

A patent applicant or owner is precluded from taking action inconsistent with the adverse judgment, including obtaining in any patent: (i) A claim that is not patentably distinct from a finally refused or canceled claim.

37 C.F.R. § 42.73(d)(3).

The Examiner refers to the Board's Decision (FF 7, 8), stating that “[n]arrower claims than new claims 2-8 and 17 were previously prosecuted, and appealed to the [Board] which sustained the rejection,” and notes that the Appellant “did not request rehearing []or appeal the [Board's] decision” to the Federal Circuit. Final Act. 4; *see also* FF 10. According to, the Examiner, claims 2–8 and 17 are “a clear attempt to overcome the [Board's] decision and this is not permissible to do through the reissue process” (Final Act. 5), and the Examiner need not “revisit these claims absent entry of additional relevant evidence with respect to patentability that was not before the [Board] when its decision was rendered.” Final Act. 4.

The Appellant argues that claims 2–8 and 17 are “different than the previously rejected claims,” and that “[t]he Board's prior Decision . . . was limited to the prior claims. The Examiner concedes that the presently

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

pending claims are different from those considered by the Board.” App. Br. 11; *see also* Reply Br. 3. Indeed, the record indicates that the Appellant previously pointed out to the Examiner that in contrast to the claims of the ’300 Application, the subject claims recite that the sprinkler comprises “a cylindrical body,” and omit the requirement for a “spring biased” riser. *See* Amendment, filed Aug. 18, 2017, p. 10.

The Examiner responds that

deleting/broadening limitations in the claims and adding a non-patentably distinct limitation (the body being “cylindrical”) is not sufficient. The references used to reject the claims in the prior application clearly show cylindrical bodies. The body being cylindrical is not considered a patentably distinct feature and would have been easily met by the prior art used to reject the original claims.

Answer (“Ans.”) 5.

We find the Examiner’s position with respect to claims 2–8 and 17 problematic in that it is not apparent to us what the legal basis for the Examiner’s action is, or for that matter, what that action is.

First, although the Examiner relies on 37 C.F.R. § 42.73(d)(3) (Final Act. 4), we observe that Part 42 of 37 C.F.R. is entitled “Trial Practice Before the Patent Trial and Appeal Board.” In addition, 37 C.F.R. § 42.73 cited and relied upon by the Examiner is entitled “Judgement,” this term being defined as “a final written decision by the Board, or termination of a proceeding.” 37 C.F.R. §§ 42.2, 42.73. Thus, it is clear that 37 C.F.R. § 42.73(d)(3) pertains to trial proceedings at the Board, and final written decisions setting forth an adverse judgment.

In contrast, the Board’s Decision in the ’300 Application stemmed from an *ex parte* appeal by the applicant. FF 7, 8. As such, although the Board rendered a Decision, there is no “final written decision” or “adverse

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

judgment” in accordance with the rule cited and relied upon by the Examiner. It is not evident to us how 37 C.F.R. § 42.73(d)(3) is pertinent to the present appeal in which seeks review of the Examiner’s refusal to reissue the ’502 Patent.

Second, the Examiner has not examined claims 2–8 and 17 on their merits, and has not entered a corresponding rejection based on such examination. *See* Final Act. 4 (stating that the Examiner “will not revisit these claims” absent entry of evidence with respect to patentability that was not before the Board). Although the Examiner states that the added limitation of the body being “cylindrical” is a “non-patentably distinct limitation,” that “[t]he references used to reject the claims in the prior application clearly show cylindrical bodies,” and this limitation “would have been easily met by the prior art used to reject the original claims” (Ans. 5), no such findings or rejections based thereon, are entered in the Final Office Action. In particular, the Examiner does not rely on, and reject claims 2–8 and 17 based on, the prior art cited and applied during the prosecution of the ’300 Application (FF 6), although stating that these claims could be so rejected.

Nonetheless, claims 2–8 and 17 are identified as being “rejected.” *See* Final Act. PTOL-326 (indicating that claims 2–17 are “rejected”). The Appellant likewise understand the Examiner’s action based on 37 C.F.R. § 42.73(d)(3) to be a rejection of claims 2–8 and 17. App. Br. 11 (under the heading “Rejection of Claims 2-8 and 17,” stating “[c]laims 2-8 and 17 have been rejected based on alleged ‘estoppel’.”); *see also* Reply Br. 2.

Therefore, in view of the above, to any extent that the Examiner’s action with respect to claims 2–8 and 17 constitutes a “rejection,” we reverse

Appeal 2019-005136
Application 15/147,571
Patent US 9,254,502 B2

the same for the reasons discussed above. There is no reasonable basis for relying on 37 C.F.R. § 42.73(d)(3) in the examination of the present reissue application. To be clear, our Decision and reversal herein as to claims 2–8 and 17, does not conclude that these claims are patentable or unpatentable.

CONCLUSIONS

1. The Examiner’s rejection of claims 9–16 under 35 U.S.C. § 251 is Affirmed.

2. The Examiner’s apparent rejection of claims 2–8 and 17 under the provisions of 37 C.F.R. § 42.73(d)(3) is Reversed.

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-IN-PART