

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEE K. BIEBERSTEIN

Appeal No. 2001-2115
Reissue Application 08/433,986¹

HEARD: January 9, 2002

Before JERRY SMITH, BARRETT, and FLEMING, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-26.

We reverse.

¹ Application for reissue filed May 4, 1995, entitled "Miniature Flashlight," which is a continuation of reissue Application 07/498,824, filed March 22, 1990, now abandoned, for the reissue of U.S. Patent 4,733,337, issued March 22, 1988.

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BACKGROUND

No prior art is relied upon in the rejection.

Claims 1-26 stand rejected under 35 U.S.C. § 251 as being based on a defective reissue declaration under 37 CFR § 1.175.

We refer to the final rejection (Paper No. 15) and the examiner's answer (Paper No. 19) (pages referred to as "EA__") for a statement of the Examiner's position, and to the brief (Paper No. 18) (pages referred to as "Br__") for a statement of Appellant's arguments thereagainst.

OPINION

This pending reissue application is given the benefit of the current more liberal version of 37 CFR § 1.175, which became effective on December 1, 1997. See Shockley v. Arcan, Inc., 248 F.3d 1349, 1358-59, 58 USPQ2d 1692, 1697 (Fed. Cir. 2001). An oath or declaration under the old Rule 1.175 would satisfy the requirements of the new rule. The Examiner's statement of the ground of rejection refers to the old rule (EA3), while the response to the arguments refers to the new rule (EA4), so the Examiner has considered the new rule.

It appears that the Examiner considers Mr. Bieberstein's declaration to be defective because it does not contain a verbatim recitation of the language of § 1.175 rather than because of some missing substantive requirement of the rule. Appellant argues that "neither the statute nor the Rules require

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a verbatim incantation of some 'magic words' in order to satisfy the requirements of § 251" (Br7). The Examiner does not respond to this argument and does not deny that the rejection is based on failure to recite the exact words of 37 CFR § 1.175.

We agree with Appellant that the oath or declaration does not need to recite the language of Rule 1.175 verbatim (although the problems could have been avoided by sticking to the wording of the rule and no reasons have been presented why the declaration was not drafted to more closely follow the rule). The old Rule 1.175(a)(6) required a statement under oath or declaration "[s]tating that said errors arose 'without any deceptive intention' on the part of the applicant," where the quotation marks suggest that exact words are required. However, when the new Rule 1.175 was enacted, it was stated that "[t]he quotes around lack of deceptive intent, currently found in § 1.175(a)(6), are removed as the exact language is not required." See Changes to Patent Practice and Procedure, 1203 Off. Gaz. 63 (Sep. 26, 1997). The other sections of old Rule 1.175 do not contain any quote marks suggesting that exact language is required. We interpret the new (and old) Rule 1.175 to describe the requirements of the oath or declaration, not to state the exact language which must be used.

The Examiner's rejection is based on the strictly technical ground that the declaration does not contain the exact language

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of the Rule 1.175 and it does not consider what substantive requirements of the rule are missing in the different language of the declaration. Nevertheless, we address whether Mr. Bieberstein's declaration satisfies the substantive requirements of Rule 1.175(a)(1) and (a)(2).

The declaration must state under 37 CFR § 1.175(a)(1): "The applicant believes the original patent to be wholly or partly inoperative or invalid . . . by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue." Mr. Bieberstein's declaration indicates that he had a "lack of understanding or any idea that the concept of an end cap switch might be novel and unobvious" (p. 3), which states at least one error relied on as the basis for reissue. Mr. Bieberstein's declaration states that there was "a mistake . . . with the claiming of less than I now understand upon information and belief to be patentable as detailed in the Declarations of Richard E. Lyon, Jr. and John D. McConaghy, copies of which I have reviewed and are attached thereto" (p. 4).² This indicates that Mr. Bieberstein claimed less than he had a right to claim, which implies that the original patent

² Referring to the Declaration of John D. McConaghy Under 37 CFR 1.47(b), dated May 4, 1995, and the Declaration of Richard E. Lyon, Jr. Under 37 CFR 1.47(b), dated May 4, 1995.

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is partly inoperative or invalid. Although Appellant argues that the declaration of Mr. Lyon is incorporated by reference because Mr. Bieberstein specifically referenced and swore that he had reviewed the Declaration of Richard E. Lyon, Jr. (Br8), we do not consider the language of Mr. Bieberstein's declaration to clearly incorporate by reference the Lyon declaration. See Advanced Display Systems Inc. v. Kent State University, 212 F.3d 1272, 1282-83, 54 USPQ2d 1673, 1679-80 (Fed. Cir. 2000) (must cite in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein). Thus, we do not rely on the declarations by Mr. Lyon and Mr. McConaghy. Nevertheless, Mr. Bieberstein's declaration satisfies the requirements of Rule 1.175(a)(1).

The declaration must state under 37 CFR § 1.175(a)(2): "All errors . . . arose without any deceptive intention on the part of the applicant." Mr. Bieberstein stated that there was "no intent to deceive or delay in achieving the correct result" (p. 4), which we find to be the same as stating that the error arose "without deceptive intention." The requirement of Rule 1.175(a)(2) is satisfied.

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For the reasons discussed above, we conclude that the declaration of Mr. Bieberstein satisfies the requirements of 37 CFR § 1.175 (1997) and 35 U.S.C. § 251. The rejection of claims 1-26 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MICHAEL R. FLEMING)	
Administrative Patent Judge)	

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