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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARD M. GORDON

Appeal No. 96-0321, Application 08/016,004[1]
Appeal No. 96-2521, Application 08/277,496[2]
Appeal No. 96-2522, Application 08/277,337[3]
Appeal No. 96-2523, Application 08/227,331[4]

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[1]Reissue application filed February 10, 1993. According to appellant, this application is a continuation of reissue Application 07/744,112, filed August 9, 1991, now U.S. Patent No. Re. 34,379 reissued September 14, 1993 based on original Patent No. 4,928,283 issued May 22, 1990.

[2]Reissue application filed July 19, 1994. According to appellant, this application is a divisional reissue application of Reissue Application 08/016,004 filed February 10, 1993, which is a continuation of Reissue Application 07/744,112, filed August 9, 1991, now U.S. Patent No. Re. 34,379 reissued September 14, 1993 based on original Patent No. 4,928,283 issued May 22, 1990.

[3]Reissue application filed July 19, 1994. According to appellant, this application is a divisional reissue application of Reissue Application O8/016,004 filed February 10, 1993, which is a continuation of Reissue Application 07/744,112, filed August 9, 1991, now U.S. Patent No. Re. 34,379 reissued September 14, 1993 based on original Patent No. 4,928,283 issued May 22, 1990.

[4]Reissue application filed July 19, 1994. According to appellant, this application is a divisional reissue application of Reissue Application O8/016,004 filed February 10, 1993, which is a continuation of Reissue Application 07/744,112, filed August 9, 1991, now U.S. Patent No. Re. 34,379 reissued September 14, 1993 based on original Patent No. 4,928,283 issued May 22, 1990.

HEARD: December 2, 1996

Before, JOHN D. SMITH, WEIFFENBACH and WALTZ, *Administrative Patent Judges.*

WEIFFENBACH, *Administrative Patent Judge*.

DECISION ON APPEAL

The real party of interest in the above-identified applications is Analogic Corporation, hereinafter the appellant.

The four above-identified appeals are directed to subject matter relating to an x-ray tomography apparatus. In view of the relationship of the applications, as per appellant's request, the appeals have been consolidated for consideration, decision, and entry of an opinion.

In each of the reissue applications, the examiner has rejected all of the claims on the ground that the Commissioner of Patents and Trademarks lacks authority to reissue the applications under 35 U.S.C. § 251, second paragraph. To the extent indicated below, we will affirm these rejections in Appeal Nos. 96-2521, 96-2522 and 96-2523 and reverse the rejection in Appeal No. 96-0321. However, the claims in each application under appeal are subject to new grounds of rejection under 37 CFR 1.196(b).

Background

On May 22, 1990, Patent No. 4,928,283 issued to appellant with 11 claims directed to an x-ray tomography apparatus comprising an elongated patient table, means for supporting the table, a rotary fan beam x-ray tomography means, and means for rotating the tomography means around the table and moving the tomography means along a substantial portion of the table. The patent was assigned to the appellant. Claims 1, 2, 6 and 7 are representative of the subject matter in the original patent claims:

1. An x-ray tomography apparatus, comprising:

an elongated patient table means having opposite ends;

a rotary fan beam x-ray tomography means encircling the patient table means; and

means for supporting the table means at opposite ends thereof and for supporting the tomography means from underneath and including means for moving the tomography means along a substantial portion of the table means,

wherein the tomography means includes means for causing at least a portion of the tomography means to continuously rotate around the table means.

2. The apparatus of claim **1**, wherein the tomography means comprises a multiplicity of members including an x-ray source, an array of detectors, tomography electronics and at least one means for supplying electrical power for the tomography means.

6. The apparatus of claim **2**, further comprising means for transmitting control and data signals to and from the tomography means.

7. The apparatus of claim **2**, wherein the means for supplying electrical power are battery powered.

On August 9, 1991, appellant filed Application 07/744,112 seeking to reissue Patent No. 4,928,283. Appellant added new claims 12-24 to broaden the scope of the claims because the inventor, Bernard M. Gordon, realized that after reviewing the patent claims, the claims did not cover all of the features desired by the inventor or appellant. The alleged error was that the patentee had claimed less than he had a right to claim and that the error ocurred by reason of the failure of the attorney who prosecuted the patent, David W. Gomes, to appreciate "the true nature and scope of the invention described in the original application."[5]

The examiner allowed reissue application 07/744,112 with original claims 1-11 and new claims 12-24. On May 14, 1992,

[5]In paragraph 6 of the Declaration of David W. Gomes In Support of the Reissue Declaration of Bernard M. Gordon, Mr. Gomes stated that he had prepared and caused to be filed an amendment to the original claims in the application which issued as Patent No. 4,928,283 and that at the time he filed the amendment, he "did not appreciate the true nature and scope of the invention described in the original application; and, thus, when [he] prepared the Amendment, [he] did not prepare claims of broad enough scope to provide the patent application to which the invention is properly entitled." (Application 07/744,112, Paper No. 1).

appellant surrendered the original letters patent to the PTO (Application 07/744,112, Paper No. 12). The issue fee was paid on July 20, 1992. Claims 12, 18 and 19 are representative of the claimed subject matter of the new claims:

12. An X-ray tomography apparatus comprising in combination:

a support structure for supporting an elongated patient table;

tomographic scanning means also supported on said support structure, said scanning means including an X-ray source and X-ray detection means for detecting X-rays emitted by said X-ray source;

means for rotating said scanning means about a rotation axis so as to circumscribe an inner region large enough to encompass said patient table with a patient thereon; and,

means for pivoting said scanning means between a first position wherein said scanning means is rotatable so as to define a scanning plane substantially normal to the elongated direction of said table, and a second position wherein said plane is subtantially parallel to said elongated direction.

18. The apparatus of claim 12 further comprising battery means for powering said apparatus.

19. The apparatus of claim 18 wherein said battery means comprise rechargeable batteries.

On February 10, 1993, appellant filed Application 08/016,004 (Appeal No. 96-0321) seeking to reissue the original patent

(Patent No. 4,928,283). The application, according to appellant, is a Rule 60 continuation reissue application of Application 07/744,112. Application 08/016,004 included a new reissue declaration which included a copy of the reissue declaration filed in Application 07/744,112 and a continuation reissue application declaration signed by the inventor restating the error which led to the filing of Application No. 07/744,112 (paragraphs 2-6) and adding new claims 12-28[6] asserting a new error which allegedly occurred <u>after allowance</u> of Application 07/744,112, namely, the inventor had claimed less than he had a right to claim because claims drawn to additional features regarding a pivoting means for the scanner and a battery means for the x-ray source were required to cover embodiments related to developing a commercial product of the invention. Claims 25 and 26 are representative of the subject matter added by new claims 25-28:

25. An X-ray tomography apparatus for use with an elongated patient table, said apparatus comprising, in combination:

[6]New claims 12-24 are identical to claims 12-24 allowed in reissue Application 07/744,112. Claims 25-28 were drawn to the additional features discussed in paragraphs 10-12 of the inventor's continuation reissue application declaration.

tomographic scanning means, said scanning means including an X-ray source and X-ray detection means for detecting X-rays emitted by said X-ray source;

means for rotating said tomographic scanning means about a rotation axis so as to circumscribe an inner region large enough to encompass said patient table with a patient thereon;

support means for supporting said tomography means; and

means for pivoting said scanning means, relative to said support means about a substantially vertical axis between a first, scanning position wherein said scanning means can be used to scan a patient on the patient table, and a second, transport position wherein said apparatus can be more easily transported.

26. In an X-ray tomography apparatus comprising in combination (a) tomographic scanning means including (i) an X-ray source and (ii) X-ray detection means for detecting X-rays emitted by said X-ray source; and (b) means for rotating said scanning means about a rotation axis; the improvement comprising

battery means for powering said X-ray source.

The error asserted by the inventor in paragraph 2 of the continuation reissue application declaration was that “the original patent is partly invalid by reason of my claiming less than I had the right to claim in the patent...” According to the inventor, the error arose as follows:

> 10. After reviewing the original claims of US Patent 4,928,283 and the allowed claims 12-24 in [reissue Application No. 744,112], I concluded that both the transportability and the rechargeable batteries could be claimed more broadly than presented in claims 1-24.

> 11. Specifically, I determined that there were no claims in the patent, nor the above-identified application, which are broadly directed to an X-ray apparatus in which the scanning means is pivotal about a vertical axis between a first position (in which the scanning plane is at an angle other than "substantially normal" to the elongated direction of the patient table as defined in allowed claim 12, or "substantially normal" to the axis of linear movement as defined in allowed claim 20) and a second position (in which the scanning plane is at an angle other than "substantially parallel" to the elongated direction of the patient table as defined in allowed claims [sic] 12, or "substantially parallel" to the axis of linear movement as defined in allowed claim 20). (See new claim 25).
>
> 12. In addition, I determined that there were no claims broadly to a tomography apparatus whose X-ray source is powered by battery means (claim 26), wherein the battery means are rechargeable batteries (claim 27) and the battery means can also be used to power the data gathering means of the tomography apparatus (claim 28).

On February 16, 1993, counsel for appellant filed an amendment entitled "AMENDMENT 'C' UNDER 37 CFR §1.312 AFTER PAYMENT OF ISSUE FEE" to add new claims 25-28 to allowed Application No. 07/744,112. However, the examiner refused to enter the amendment pursuant to the provisions of 37 CFR § 312 (Application 07/744,112; Paper No. 15).

On August 16, 1993 in Application 08/016,004, counsel for appellant added new claims 29-56 drawn to (i) using a rechargeable battery to operate the scanner for at least one tomographic scan (claims 29-35 and 39), (ii) using wireless

communications (claims 36-49), and (iii) providing for a helical scan (claims 38, 55 and 56). On the same date, counsel also filed a petition along with an amendment entitled "AMENDMENT 'D' UNDER 37 CFR §1.312 AFTER PAYMENT OF ISSUE FEE" to add new claims 29-56 to allowed application 07/744,112. Although, the amendment was received in the examining group on September 13, 1993, the day before Application 07/744,112 issued as Reissue Patent No. 34,379, the amendment was denied entry by the examiner on September 29, 1993 (Application 07/744,112, Paper No. 20). Claims 29, 36 and 55 are representative of the subject matter claimed in new claims 29-56:

29. In an X-ray tomography apparatus of the type comprising: (a) an X-ray source; (b) X-ray detection means for detecting X-rays emitted by said X-ray source during a tomographic scan; and (c) tomographic scanning means for moving at least the X-ray source during a tomographic scan; the improvement comprising:

power storage means for storing sufficient energy for powering said x-ray source during at least one tomographic scan.

36. An X-ray tomography apparatus comprising (a) an X-ray source; (b) X-ray detection means for detecting X-rays emitted by said X-ray source during a tomograhic scan; (c) tomographic scanning means for supporting at least said X-ray source; (d) support means for supporting said tomographic scanning means so that said tomographic scanning means is movable relative to said support means during a tomographic scan; and (e) communication means, including first communication means fixed relative to said tomographic scanning means and second communication means fixed relative to said support means, for establishing a wireless

communication link between said first communication means and said second communication means so as to permit in use wireless transmission of data therebetween.

55. In an X-ray tomography apparatus of the type comprising (a) an X-ray source; (b) X-ray detection means for detecting X-rays emitted by said X-ray source; (c) tomographic scanning means for supporting at least said X-ray source; and (d) support means for supporting said tomographic scanning means so that said scanning means is rotatable about a rotation axis during a tomographic scan; wherein the improvement comprises:

means for moving said tomographic scanning means along said rotation axis during a scan so that said tomographic scanning means provides a helical scan about said rotation axis.

Along with the amendment filed August 16, 1993 adding new claims 29-56, counsel filed a supplemental reissue declaration wherein the inventor asserted that

> 15. After filing [reissue Application No. 08/016,004], as a part of the continuing development work by Analogic Corporation on a commercial product incorporating features disclosed in US Patent No. 4,928,283, a list of invention disclosures was first developed by another employee of Analogic for the purpose of pursuing additional patent protection on improvements and additional features of the product not previously disclosed in US Patent No. 4,928,283. As a part of the effort to pursue maximum patent coverage, because of my special perspective over the project, I was asked by Mr. Kusmer [new counsel for appellant who has prosecuted all four reissue applications on appeal] to assign some type of priority listing to these features in order to insure that the more important cases are filed first. In assigning priorities, I decided to develop my own list of concepts that I thought should be considered in filing new patent applications.

16. I, accordingly, prepared the list of inventions that I considered important in a memorandum.

17. Having prepared the list, I now believe that of great importance is the utilization of an energy storage mechanism to store the energy sufficient to perform at least one tomographic scan so as to eliminate the need for a special power installation. The concept of a stored energy system in a high powered CAT scanner is based on the realization that there is a certain finite amount of peak energy that is required to perform a scan slice of a given image quality, particularly with respect to photon noise, regardless of the time required to make a slice. Further, the energy storage system needs to be capable of accumulating energy and delivering relatively high peak power over a relatively short period of time during a scan slice. As a result the energy storage system need not be limited to a battery system, but can include any device capable of accumulating sufficient peak energy to perform at least one tomographic scan. I determined, with the help of Mr. Kusmer, that there were no claims in the patent, or the above identified reissue application [reissue Application No. 08/016,004], which are broadly directed to a tomographic X-ray apparatus comprising power storage means for storing sufficient peak energy for powering the X-ray source during at least one tomographic scan. (claims 29-35, 39 ...).

18. The system makes it possible to continuously rotate the tomographic scanning means ... [claim 35]. I also believe that the portable CAT scanner described in the patent has an advantage that the tomographic scanning means moves relative to the patient table making it possible to perform helical scans. (claims 33, 34, 38, ... 55 and 56) The scanning means preferably is moveable in the direction of its rotation axis while scanning so that the patient table can remain stationary. (claim 56) This provides an advantage, for example, when treating trauma patients. I determined, with the help of Mr. Kusmer, that there were no claims in the patent, or the above identified

> pending reissue application, which are broadly directed to these features.
>
> . . .
>
> 20. I also believe that the use of wireless communication makes it possible to eliminate data slip rings. I also determined, with the help of Mr. Kusmer, that there were not claims in the patent, or the above-identified pending reissue application, which are broadly directed to an X-ray tomographic apparatus comprising a wireless communication system for transmitting power control signals and/or data in connection with a tomographic scan. (claims 36-49)

On July 19, 1994, pursuant to Rule 37 CFR 1.60, appellant filed three reissue applications: Reissue Application 08/277,331; Reissue Application 08/277,337; and Reissue Application 08/277,496. According to appellant, each application seeks to reissue the original patent, Patent No. 4,928,283. We note, however, that the original patent grant, at the time these reissue applications were filed, had been surrendered and reissued as Patent No. Re. 34,379. Appellant further designated each of these applications as being divisional reissue application of Reissue Application 08/016,004. Reissue Application No. 08/277,331 contains only claims 55 and 56 which are identical to claims 55 and 56 in Reissue Application 08/016,004 (on July 25, 1994, counsel for appellant cancelled claims 50-54 in Application 08/016,004); Reissue Application 08/277,337 contains only claims 26-35 which are identical to

claims 26-35 in Reissue Application 08/016,004; and Reissue Application 08/277,496 contains only claims 36-49 which are identical to claims 36-49 in Reissue Application 08/016,004.[7]

On September 22, 1994, the Office of the Assistant Commissioner for Patents sent counsel for appellant a letter regarding the 37 CFR § 1.177 status of the then pending reissue applications. The letter merely directed appellant's attention to 37 CFR § 1.177 noting the requirement by rule that all divisional reissue applications must issue simultaneously. The letter does not appear to indicate that the Commissioner has rendered any decision as to whether the divisional applications are directed to "distinct and separate parts of the thing originally patented."

The Rejections

All of the claims in each reissue application stand rejected under the second paragraph of 35 U.S.C. § 251 because the reissue application is not drawn to "distinct and separate parts of the

[7]It is noted that claims 1-11 in each divisional reissue application have not been properly amended. In a preliminary amendment C, Paper No. 6 in each divisional application, counsel for appellant directed the Office to "cancel", inter alia, claims 1-11. Since claims 1-11 are original patent claims, these claims cannot be "canceled" in accordance with 37 CFR § 1.121(b). Counsel for appellant should have instructed the Office to enclose each of claims 1-11 in brackets as required by 37 CFR § 1.121(e).

thing originally patented." The claims also stand rejected on the ground that the reissue declaration is defective because the errors alleged cannot be the basis for filing a continuing or divisional of the continuing reissue application since appellant paid the issue fee in the initial reissue application and accepted the allowed claims.[8]

Opinion

We have carefully reviewed the records of the reissue applications which led to this appeal and the respective positions advanced by both the appellant and the examiner. For the reasons discussed *infra*, we will sustain the examiner's rejections to the extent that the divisional reissue applications on appeal are not drawn to "distinct and separate parts of the thing originally patented." In addition, we will enter new grounds of rejection under 35 U.S.C. § 101 in all of the reissue applications on appeal pursuant to our authority under 37 CFR § 1.196(b).

The examiner's rejections appear to be based on a "directive regarding the treatment of 'continuations' of reissues to insure

[8]Although the examiner did not state a statutory ground for this rejection, for purposes of this decision we consider the rejection to be based on 35 U.S.C. § 251.

uniformity in the treatment of these applications." The directive was reproduced on page 2 of the first Office action in Appeal No. 96-0321 (Paper No. 6). According to the examiner, the "directive," in pertinent part, states, that

> If ... the multiple reissue applications originating from a single original patent are <u>not</u> drawn to "separate and distinct parts of the thing originally patented", the Commissioner lacks authority to permit the issuance of more than a single reissue patent upon surrender of a single letters patent.
>
> In situations where the multiple reissue applications based upon a single original patent are not filed together, the second application is frequently styled a "continuation application ....
>
> If the first application has been allowed and issues, inadvertently or otherwise, the subsequent continuing application can be allowed upon petition and payment of the appropriate fee (37 CFR 1.177), provide [sic] that (1) the requirements for establishing "error" under 35 USC 251 and 37 CFR 1.175 have been satisfied and (2) the petition established that the second application is properly regards [sic, regarded] as being for a "separate and distinct part of the thing originally patented".
>
> However, if the first reissue application has issued and the second application is not for a "separate and distinct part of the thing originally patented", the second application should be rejected under 35 USC 251, second paragraph, as being outside of the Commissioner's authority to reissue. Moreover, since applicant has paid the issue fee in the first reissue and has accepted the allowed claims, it would appear that the applicant cannot allege any error as a basis for filing the "continuing" application, and a rejection on this ground should also be made. [Appeal No. 96-0321, first Office action, pages 2 and 3, Paper No. 6; emphasis in the original.]

Appellant characterizes the directive as being a “secret” directive and argues that it is not a proper basis for rejecting the claims as a matter of law and of fact because no public notice was given prior to implementation of the directive.

At the outset, we agree with appellant and hold that the proper basis for rejecting claims is based on a matter of law and of fact, and not on a directive. Rejections under 35 U.S.C. § 251 are be made in accordance with the prevailing law as dictated by the particular facts of record in the reissue application. The Commissioner has authority under 35 U.S.C. § 251 to reissue patents based on continuing and divisional reissue applications provided the reissue applicant meets the requirements of § 251. The statute is remedial in nature. In re Willingham, 282 F.2d 353, 354, 127 USPQ 211, 212 (CCPA 1960). We find no reason on this record or under the reissue statute why appellant could not properly assert an error in a continuing reissue application even after the issue fee had been paid in the parent reissue application. In a recent decision by our reviewing court, the court held that no different burden is placed on divisional or continuing reissue applications than on non-reissue divisional or continuing applications and that it was improper to reject a continuing reissue application on the ground

that the original patent had been surrendered and reissued. *In re Graff*, 111 F.3d 874, 876, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997). Thus, to the extent that the examiner's rejection is based on the ground that appellant's reissue declaration is defective because the errors alleged cannot be a basis for filing a continuing or the divisional reissue applications since appellant allowed the parent reissue application to issue, we reverse.

Notwithstanding the above noted directive, we find that under the reissue statute the Commissioner does lack authority to permit the issuance of more than one reissue patent where multiple reissue applications originating from a single original patent are not drawn to "separate and distinct parts of the thing originally patented." The second paragraph of 35 U.S.C. § 251 provides:

> The Commissioner may issue several reissued patents for <u>distinct and separate parts of the thing patented</u>, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents. [Emphasis ours.]

The meaning of the expression "distinct and separate parts" is not defined by the statute nor does the legislative history provide any guidance as to the meaning of the expression. However, under the rule making authority of the Commissioner, 35

U.S.C. § 6, the Commissioner has promulgated rule 37 CFR § 1.177 pertaining to divisional reissue applications:

> The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawings may represent only such part or parts, subject to the provisions of §§1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in §1.17(i)(1), all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the other will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order. [Emphasis ours.]

The expression "distinct and separate parts of the thing patented" by the rule appears to pertain to restrictable subject matter, i.e. subject matter which is ordinarily found in divisional applications following restriction by the examiner or voluntary division of the invention by the patent applicant.

Section 1450 of the *Manual of Patent Examining Procedure*[9] states that the examiner may not require restriction in a reissue application. Such a restriction is entirely at the option of the reissue applicant. Accordingly, the reissue applicant may file

[9]*Manual of Patent Examining Procedure*, 6th Edition, Rev. 2, July 1996.

multiple reissue applications directed to “distinct and separate parts of the thing patented.” However, under the statute, it would appear that the examiner may reject such an application under the second paragraph of 35 U.S.C. § 251 if he or she finds that the subject matter of a continuing or divisional reissue is not “distinct and separate parts of the thing patented.” Such is the case before us.

Section 802.01 of the *Manual of Patent Examining Procedure*[10] defines the term “distinct” as meaning “two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of prior art).” Where several inventions claimed are related, but not patentably distinct as claimed, restriction is never proper (Section 808.02 of the *Manual of Patent Examining Procedure*[11]).

The term “separate” is defined in Section 808.02 of the *Manual* as follows:

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[10]Id.

[11]Id.

> Where the related inventions as claimed are shown to be distinct ..., the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:
>
> (1) Separate classification thereof:
> This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.
>
> (2) A separate status in the art when they are classified together:
> Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

In the final rejection, the examiner concluded that "[w]ere these claims [i.e. claims 25-49, 55 and 56] set forth in the 'original' application [presumably the application which issued as Patent No. 4,928,283], a restriction requirement would not have been proper" (final rejection, paragraph 3, Paper No. 13). Appellant argues that the claims are distinct and separate because the subject matter defined in each of the claims is capable of separate manufacture, use or sale and that claims 25-35, claims 36-49, and claims 55 and 56 would not infringe any of claims 7, 6 and 1, respectively, so as to negate any double patenting.

The examiner has not provided any analysis of the record or presented any reasons as to why the new claims if presented in the original patent application would not have been restrictable or why the subject matter defined by added claims 25-49, 55 and 56 do not constitute "distinct and separate parts of the thing patented." However, we find ample evidence of record which would support the rejection. Accordingly, we will affirm the examiner's rejection in Appeal Nos. 96-2521, 96-2522 and 96-2523 for reasons herein below. However, because our affirmance of the examiner's rejection is based on a rationale not advanced by the examiner, we denominate our affirmance as a new ground of rejection under 37 CFR § 1.196(b).

Appellant's original claims and all newly added claims set forth in the reissue patent and reissue applications are all directed to the same statutory class of invention, namely, a machine, i.e., a x-ray tomography apparatus. See 35 U.S.C. § 101. Thus, there can be no distinctness based on different statutory class of invention, e.g. product/apparatus or process/apparatus, etc.

All of appellant's claims are directed to related subject matter, and if claims 1-49, 55 and 56 had been presented in the original patent application, we find that a restriction would not

have been made. According to appellant, the subject matter claimed has been divided into four parts, i.e. divisions of the thing patented (original patent claims 1-11 and reissue patent claims 12-24), namely, (i) a tomography scanning means combined with a pivoting means which allows the tomography means to pivot between a scanning position and a transport position (claim 25, Appeal No. 96-0321), (ii) a tomography scanning means combined with a battery (claims 26-35, Appeal No. 96-2522), (iii) a tomography scanning means combined with a communication means (claims 36-49, 96-2521) and (iv) a tomography scanning means combined with a means to provide for a helical scan (claims 55 and 56, Appeal No. 96-2523). Appellant argues that restriction would have been imposed

> ...on the ground that each class of claims: pivoting means, independent power supply [battery], wireless transmission of data, and helical scanning by moving the scanning means, constitutes a distinct improvement in the x-ray tomography art. Each of the classes of embodiments can be considered to be a subcombination invention: the embodiments may be used together in a single combination and they can be used separately. Such subcombinations are usually considered to be distinct from each other [footnote omitted]. [Brief, paragraph bridging pages 21 and 22.]

We do not agree with appellant’s restriction theory. Restriction is not based on improvements in the art, but on a finding that the claimed subject matter as grouped is distinct and separate.

Although the claims are directed to related subject matter, we do not find the claimed subject matter to be “distinct.” Contrary to appellant’s argument, the claims on appeal are not directed to a combination and subcombination. All of appellant’s claims are drawn to combinations, i.e. a tomography scanning means combined with a pivotal means, battery, communication means and/or means for providing a helical scan. There are no claims in any of the appealed applications directed only to the particular subcombination, namely, the pivotal means, the battery, the communication means, or the means for a helical scan means. Accordingly, distinctness cannot be predicated on combination/subcombination.

Even assuming that the inventions are distinct, for restriction, it also must be shown that the related inventions have acquired a separate status in the art. On this record, no separate classification or separate field of search has been established for the four classes identified by appellant. First, each of the divisional reissue applications herein are classified in the same class and subclass. Second, there is no evidence of record to show that the subject matter claimed in each of the divisional applications has acquired a separate status in the art.

There are other reasons which we find do not render the subject matter claimed in the divisional applications to be distinct and separate. There are original patent claims and reissue patent claims directed to the subject matter of the divisional reissue applications on appeal which appellant has not grouped with claim 25 and any of claims 26-35 and claims 36-49. Claims 1-24 include claims which recite a tomography means combined with a battery or electrical power means which are not grouped with claims 26-35. See in particular, original patent claims 2-9 and reissue claims 18, 19, 21 and 22 which define a tomography apparatus having tomography scanning means combined with an electrical power means or battery (including a rechargeable battery). Also, claim 6 is directed to a tomography scanning means combined with a communication means. This claim has not been grouped with claims 36-49 in Appeal No. 96-2521. In addition, there are several linking claims. Claims 6 and 39 link the electrical power means with the communication means, claim 34 links the battery combination with helical scanning, and claim 38 links the helical scan with a wireless communication means. These claims link together the subject matter which appellant asserts is distinct and separate.

Thus, for the reasons given above, we find that if the subject matter of claims 1-49, 55 and 56 had been presented in the original application for patent, the examiner would not have made a restriction. Accordingly, we sustain the examiner's rejection under 35 U.S.C. § 251 to the extent it is based on the ground that the claimed subject matter in each divisional reissue application is not directed to "distinct and separate parts of the thing patented." While we affirm the decision of the examiner rejecting the claims in each of the divisional reissue applications under 35 U.S.C. § 251, we enter the following new grounds of rejection under the provisions of 37 CFR 1.196(b) in each of the reissue applications.

New Grounds of Rejection Under 37 CFR § 1.196(b)

Application 08/016,004

1. Claims 1-24 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-24 of Reissue Patent No. Re. 34,379. This is a statutory double patenting rejection. This statutory double patenting rejection can be overcome by making a proper supplemental reissue oath or

declaration to reissue Patent No. Re. 34,379 and surrendering the original reissue patent.[12]

2. Claims 26-35 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 26-35 in copending Application 08/227,331. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. Claims 36-49 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 36-49 in copending Application 08/227,496. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. Claims 55 and 56 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 55 and 56 in copending Application 08/227,337. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Application 08/227,331

Claims 55 and 56 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 55 and 56

[12]On page 14 of the Brief in Appeal No. 96-0321, appellant indicated its willingness to surrender the original reissue patent (Patent No. Re. 34,271).

in copending Application 08/016,004. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Application 08/277,337

Claims 26-35 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 26-35 in copending Application 08/016,004. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Application 08/277,496

Claims 36-49 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 36-49 in copending Application 08/016,004. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Other Issues - Repatentability of Claims

On return of these applications, the examiner should also consider the following matters:

1. With regard to at least claims 1, 55 and 56, the examiner should consider the patentability of these claims over Mori. Mori discloses a tomography device having a fan-beam x-ray

which helically rotates around patient M. See Figs. 1-3. Mori discloses that

> ... the patient M is continuously transported by the drive control circuit **18** for table couch while the fan-beam FB continuously rotates and data is acquired. The patient M is transported by a distance of "P" mm along the longitudinal axis thereof upon one rotation of the fan-beam. <u>With this construction, the same effect can be realized as in the case wherein the fan-beam rotates around the patient M which [the patient] is remained stationary while it [the fan-beam] is subject to parallel movement along the longitudinal axis</u>. Consequently, the fan-beam helically rotates around the patient M and acquires data (this rotation is so-called "helical scanning"). [Column 3, lines 40-65; emphasis ours.]

This passage appears to suggest that the scan can be accomplished by moving either the tomography device or the table on which the patient is lying.

2. New claims 26-35, 55 and 56 are in the Jepson format. *See Ex parte Jepson*, 1917 Dec. Comm'r Pat. 62 (Comm'r Pat. 1917); 37 CFR § 1.75(e). When the Jepson format is used, an applicant impliedly admits that the subject matter recited in the preamble up to the phrase "the improvement wherein" is old and known in the art. *In re Ehrreich*, 590 F.2d 902, 909-910, 200 USPQ 504, 510 (CCPA 1979). Appellant appears to be admitting that an x-ray tomography apparatus comprising in combination a tomography scanning means having an x-ray source and an x-ray detection

means, and means for supporting the scanning means and for rotating the scanning means about a rotation axis are known in the art. The examiner should consider the patentability of the claims in each of the reissue applications in light of appellant's admissions and the prior art.

Conclusion

The decision of the examiner is affirmed with respect to Appeal Nos. 96-2521, 96-2522 and 96-2523 albeit for reasons different from those advanced by the examiner. The examiner's decision in Appeal No. 96-0321 is reversed. Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within **ONE MONTH** from the date of the decision. 37 CFR § 1.197.

With respect to the new rejections under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire **TWO MONTHS** from the date of this decision. In the event appellant elects this alternate option, in order to preserve the

right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

The decision of the examiner is affirmed and this application is REMANDED to the examiner pursuant to 37 CFR § 1.196(b).

AFFIRMED

JOHN D. SMITH Administrative Patent Judge	)	
CAMERON WEIFFENBACH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
THOMAS A. WALTZ Administrative Patent Judge	)	

Appeal No. 96-2523
Application 08/277,331

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