

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAIKEN INDUSTRIES, LTD

\_\_\_\_\_  
Appeal No. 99-0655  
Application No. 90/004,586<sup>1</sup>

\_\_\_\_\_  
HEARD: March 12, 1999

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Before JOHN D. SMITH, WALTZ, and SPIEGEL, Administrative  
Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 306 from the examiner's refusal to allow claims 9 through 12 as amended after the final rejection (see the amendment dated Feb. 6,

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<sup>1</sup> This application is a Reexamination proceeding requested on March 20, 1997 by Daiken Industries, Ltd., for U.S. Patent No. 4,983,312, issued January 8, 1991, based on Application No. 07/358,364, filed May 19, 1989.

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1998, Paper No. 15, and the Advisory Action dated Feb. 17, 1998, Paper No. 16). Claims 1 and 4 are the only other claims pending in this reexamination, and the examiner has indicated that claim 1 is patentable as amended and the patentability of claim 4 is confirmed (see Paper No. 16).

According to appellants, the invention relates to a certain refrigerant composition for use in refrigeration systems (Brief, page 3). Claim 9 is illustrative of the subject matter on appeal and is reproduced below:

9. A refrigeration system comprising:

a condenser;

an evaporator in fluid flow communication with the condenser; and

a refrigerant cycled through the condenser and evaporator;

wherein the refrigerant consists essentially of 95 to 5% by weight of tetrafluoroethane and respectively 5 to 95% by weight of either chlorodifluoromethane or chlorodifluoroethane.

#### **PROSECUTION HISTORY**

Appellants' U.S. Patent No. 4,983,312 (hereafter, the '312 patent) issued on Jan. 8, 1991, and contained four claims to a refrigerant composition. Appellants submitted a Request

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for Reexamination dated Mar. 20, 1997 (Paper No. 1), including proposed addition of new claims 5 through 12. Appellants cited the "Montedison References" in this Request for Reexamination, which included Bargigia et al. (Bargigia), British patent 1,529,429. The Order granting Request for Reexamination dated May 1, 1997 (Paper No. 8) stated that a substantial new question of patentability affecting claims 1-4 of the '312 patent was raised by the Request for Reexamination.

Subsequent to the Order granting the Request, claims 1-3 of this reexamination application were rejected under 35 U.S.C.

§ 102/§ 103 as anticipated by or, in the alternative, as unpatentable over Bargigia (Paper No. 11 dated Aug. 11, 1997). According to the examiner, Bargigia disclosed an aerosol composition that was identical to or rendered obvious the refrigerant composition of claims 1-3 (*Id.*). In addition to this rejection, claims 5-12 were rejected under 35 U.S.C. § 305 as enlarging the scope of the invention and as not being

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drawn to the invention as claimed in the '312 patent (*Id.*, page 3).<sup>2</sup>

In response to this rejection, appellants amended claims 1, 5, and 9 while cancelling claims 2-3 (Amendment dated Oct. 16, 1997, Paper No. 12). The examiner issued a final rejection dated Dec. 1, 1997 (Paper No. 14), and stated that the rejection over Bargigia was withdrawn in view of appellants' amendment while the rejection under § 305 was maintained (Paper No. 14, pages 2-3). As previously noted, appellants' amendment after final rejection was entered by the examiner and obviated all rejections except the rejection under § 305 (see the amendment dated Feb. 6, 1998, Paper No. 15, and the Advisory Action dated Feb. 17, 1998, Paper No. 16). A subsequent proposed amendment was refused entry (see Paper Nos. 17, 20, and 21) and this appeal ensued.

#### **THE REJECTION**

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<sup>2</sup>Also included in this action were rejections of various claims under the first and second paragraphs of § 112. Since these rejections were later obviated or withdrawn and are not at issue in this appeal, no further discussion of these rejections is necessary.

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Claims 9 through 12 stand rejected under 35 U.S.C. § 305 as not directed to "the invention as claimed" in the '312 patent and for enlarging the scope of the claim(s) of the patent being reexamined (Answer, pages 3-4).

#### OPINION

We cannot sustain the examiner's decision that the appealed claims do not meet the requirements of 35 U.S.C. § 305. Accordingly, the rejection of claims 9 through 12 as unpatentable under 35 U.S.C. § 305 is *reversed* for reasons which follow.

35 U.S.C. § 305 (1984) provides, *inter alia*:

In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish *the invention as claimed* from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. *No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter.* (Emphasis added).

Claims 9-12 are drawn to a refrigeration system comprising a condenser, an evaporator, and a refrigerant cycled through the condenser and evaporator where the refrigerant composition is recited as originally claimed in

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claim 1 of the '312 patent. As noted by the examiner on page 3 of the Answer, claims 9-12 drawn to a refrigerant system were added to this reexamination application in the response dated March 20, 1997 (Paper No. 2) and no claims to a refrigeration system were ever presented during prosecution of the '312 patent. As previously noted, all of the claims that issued in the '312 patent were drawn to a refrigerant composition.

The examiner relies on *Ex parte Wikdahl*<sup>3</sup> for the proposition that § 305 requires that newly added claims to a reexamination application (1) be directed to "the invention as claimed" and (2) do not enlarge the scope of the claims of the patent being reexamined (Answer, page 4).

"When statutory interpretation is at issue, the plain and unambiguous meaning of a statute prevails in the absence of clearly expressed legislative intent to the contrary. [citations omitted]." *In re Donaldson*, 16 F.3d 1189, 1192-93, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(*in banc*). In our view, the meaning of § 305 is plain and unambiguous regarding "the

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<sup>3</sup>10 USPQ2d 1546, 1549 (Bd. Pat. App. & Int. 1989).

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invention as claimed". We find that there is no requirement in § 305 that a new claim be directed to "the invention as claimed". In our view, this contested portion of § 305 does not impose a requirement but merely permits the patent owner to propose any amendment or new claim "to distinguish the invention as claimed", i.e., to distinguish the subject matter claimed in the patent under reexamination, from the prior art cited in the reexamination request.

It is clear that newly presented claims 9-12 were submitted to distinguish the invention as claimed from the aerosol composition of the Bargigia reference (see the "Prosecution History" discussed above).<sup>4</sup> Even assuming that being directed to "the invention as claimed" is a requirement for any amended or new claim under § 305, there is an indication in the original specification of the '312 patent

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<sup>4</sup>See the Reply Brief, pages 4-5. Although the examiner is correct that these new claims were not submitted in response to a decision adverse to the patentability of a claim of a patent (Answer, page 5), we note that § 305 also permits the addition of new claims "to distinguish the invention as claimed from the prior art" cited in the Reexamination Request under § 301. Since claims 9-12 do distinguish the invention as claimed from Bargigia, the presentation of these claims is not improper under this sentence of § 305.

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that appellants intended or considered their invention to include a conventional refrigeration system (see column 1, lines 1-2; column 2, lines 35-63; column 3, lines 17-25; and column 4, lines 13-17). See *Ex parte Wikdahl*, 10 USPQ2d at 1549.

Our reviewing court has not imposed the requirement under § 305 proposed by the examiner that the addition of new claims in a reexamination application must be directed to "the invention as claimed". See *Bloom Engineering Co. v. North American Manufacturing Co.*, 129 F.3d 1247, 1249-50, 44 USPQ2d 1859, 1861 (Fed. Cir. 1997); *Thermalloy Inc. v. Aavid Engineering Inc.*, 121 F.3d 691, 692, 43 USPQ2d 1846, 1847 (Fed. Cir. 1997); *Quantum Corp. v. Rodime PLC*, 65 F.3d 1577, 1580, 36 USPQ2d 1162, 1165 (Fed. Cir. 1995); *In re Freeman*, 30 F.3d 1459, 1464, 31 USPQ2d 1444, 1447 (Fed. Cir. 1994), cert. denied, 116 S. Ct. 1567 (1996)(which cites *Ex parte Neuwirth*, 229 USPQ 71, 73 (Bd. Pat. App. & Int. 1985)). Once an amendment is made to distinguish the invention as claimed from the prior art, the only requirement set forth by § 305 is that

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"[n]o proposed amended or new claim enlarging the scope of a claim of the patent will be permitted...".

"A new claim enlarges the scope of a claim of the patent if it includes within its scope any subject matter that would not have infringed the original patent". *Thermalloy Inc. v. Aavid Engineering Inc.*, 121 F.3d at 692, 43 USPQ2d at 1847. Whether a new claim enlarges the scope of a claim of the patent is a matter of claim construction. *Id.* Appellants argue that there is no conceivable interpretation of claims 9-12 which would be broader than the claims in the original patent (Brief, page 8, and Reply Brief, page 6). It is the examiner's position that the combination of the condenser, evaporator and the refrigerant composition recited in claim 9 would not infringe the claims of the original patent and, even if there was infringement, claims 9-12 nonetheless enlarge the scope of the original claims of the patent because these claims additionally require the condenser and evaporator (Answer, page 6).

The examiner has not presented any evidence or reasoning to support the conclusion that the combination recited in

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newly added claim 9 would not infringe the original subcombination claims to the refrigerant composition in the '312 patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)("[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability"). Any refrigerant system within the scope of added claims 9-12 would necessarily include a refrigerant composition within the scope of original claim 1 of the '312 patent. Thus one could not practice the invention as claimed in claims 9-12 without infringing the refrigerant composition as recited in the original claims of the '312 patent. Therefore the scope of claims 9-12 is more narrow than the original patent claims and claims 9-12 do not meet the "enlarges" test set forth in *Thermalloy Inc. v. Aavid Engineering Inc.*, *supra*.

For the foregoing reasons, we determine that the examiner has not established that appealed claims 9-12 fail to comply with the requirements of 35 U.S.C. § 305. Accordingly, the rejection of claims 9-12 under 35 U.S.C. § 305 is reversed.

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The decision of the examiner is reversed.

**REVERSED**

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

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APJ WALTZ

APJ SPIEGEL

APJ SMITH, JOHN

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: September 9, 1999

Draft    Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT