

Art Unit 2602

MAILED

Paper No. 18

Appeal No. 93-4110

FEB 22 1994

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ON BRIEF

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte Tokumichi Murakami,  
Kohtaro Asai, Koh Kamizawa,  
Masami Nishida, Eizo Yamazaki  
Atsushi Itoh and Naoto Kinjoh

Application for Patent filed January 8, 1992, Serial  
No. 07/818,277, for the Reissue of Patent No. 5,010,401, granted  
April 23, 1991, based on application Serial No. 07/340,009, filed  
April 7, 1989. Picture Coding And Decoding Apparatus Using  
Vector Quantization.

Lawrence G. Norris et al. for appellants.

Primary Examiner - John K. Peng

Before Craig, Lynch and Thomas, Administrative Patent Judges.<sup>1</sup>

Thomas, Administrative Patent Judge.

ON REQUEST FOR RECONSIDERATION

In a paper filed January 4, 1994, appellants request  
that we reconsider our decision dated December 16, 1993, wherein  
we sustained the rejection of claims 1 to 12 under 35 U.S.C. 251  
as being based upon a defective reissue declaration. There we

<sup>1</sup> The Commissioner of Patents and Trademarks has authorized the  
Examiners-in-Chief of the Board of Patent Appeals and  
Interferences to use the title of Administrative Patent Judge.  
See 1156 OG 32, November 9, 1993.

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found that appellants' reissue declaration lacked the requisite specificity under the statute and implementing Rule 37 CFR 1.175 as to the timeframe in which the alleged errors were discovered.

The alleged errors were discovered sometime after the issuance of the original patent on April 23, 1991 and before the filing of the reissue application on January 7, 1992. Initially, we do not consider a timeframe of roughly nine months to be consistent with the statement at the bottom of page 3 of the reissue declaration that the "above-noted errors were recently discovered in the last several months...." Also, we did not and currently do not consider that a relatively unspecific time-frame of roughly nine months is compatible with the requirements of the statute and implementing rule as indicated in our original opinion. In Hewlett-Packard Co. v. Bausch & Lomb Inc., 882 F.2d 1556, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989), cert den., 110 Sup. Ct. 1125 (1990) and Alcon Laboratories v. Allergan Inc., 17 USPQ2d, 1365, 1375 (DC N. Texas, 1990), relying on Hewlett-Packard, these courts reasoned that the statutory provision of 35 U.S.C. 251 was implemented and expanded by PTO regulation 37 CFR 1.175 which, the courts stated in part, requires an explanation as to how and when the alleged errors were discovered. This was explained at pages 4 to 6 of our original opinion. Nothing advanced by appellants in their request for reconsideration leads us to conclude otherwise.

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Appellants' reliance upon In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971), is misplaced. With respect to 35 U.S.C. 251, the court stated at 170 USPQ 273:

We are unable to find in this provision anything pertaining to the timeliness of an applicant's actions in the prosecution of the application for the original patent. Neither do we find any prohibition of reissue on the ground the applicant or his attorney knew of the error at the time the original patent issued.

We are not here concerned with the timeliness of any of appellants' actions during the prosecution of the application of the original patent. Similarly, we are also not concerned with any situation concerning an applicant or his attorney knowing of any error at the time the original patent issued. The sole issue that we sustained the examiner's rejection on in our original opinion was the lack of sufficient specificity as to the timeframe in which the alleged errors were discovered. In our view, from their reasoning in Hewlett-Packard and in Alcon, the courts have sanctioned the PTO's requirement of a specific explanation as to how and when any alleged errors were discovered. Appellants' reliance upon Ex parte Holt, 214 USPQ 381 (Bd.App. 1982), is considered to be not helpful to appellants' position.

The paragraph bridging pages 1 and 2 of the Request for Reconsideration is more specific than the reissue declaration. There is no statement in this declaration that appellants are unable to provide a precise date the errors were discovered or even a reasonable timeframe within the nine month timeframe here,

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such as an identified month. There is no statement in the reissue declaration that the errors were discovered by the patent department of the assignee. Finally, there is no statement in this declaration that appellants believe they have complied with 35 U.S.C. 251 and 37 CFR 1.175 to the best of their recollection and knowledge.<sup>2</sup>

With respect to certain changes made to claim 7 on appeal and not discussed in the original reissue declaration, we also maintain our position as set forth in our original opinion. The declaration referred to in the request for reconsideration and filed on November 24, 1992 was a declaration of appellants' attorney and not of appellants. To the extent the examiner's "acceptance" of this declaration in the examiner's advisory action mailed on December 3, 1992 means the issue with respect to claim 7 was resolved, the examiner still maintained the requirement in the answer that appellants file a declaration concerning the noted errors in claim 7. There was no subsequent filing of a supplemental declaration by appellants. In paragraphs 5, 6 and 8 of the declaration filed on November 24, 1992 by appellants' attorney there is no statement as to who caused the error in claim 7 to occur on the part of appellants,

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<sup>2</sup> A reissue declaration with averments by the inventors corresponding to the assertions made in the paragraph bridging pages 1 and 2 of the request for reconsideration and a reference to the claim 7 defect would, in our opinion, provide for a declaration of sufficient specificity and/or reasons why more specific facts cannot be provided that would satisfy the requirements of 37 CFR 1.175.

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though there is a statement therein that the error was not discovered or caused by the inventors of the application.

As noted in our original opinion, the prosecution history in this reissue application reflects an understanding by the examiner and the appellants that the errors with respect to claim 7 were caused by a PTO printing error. As pointed out in our original opinion, this is only partially true. Under the totality of these circumstances, the superfluous "the" in claim 7 is an error properly attributed to and addressable by appellants in a reissue declaration filed within 35 U.S.C. 251, especially since a Certificate of Correction under 35 U.S.C. 255 and 37 CFR 1.323 was not filed by appellants in the patent to correct this error before the filing of this reissue application.

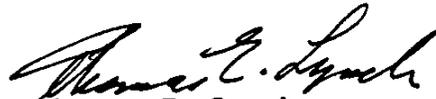
In view of the foregoing, appellants' request for reconsideration is granted to the extent that we have in fact reviewed our findings but is denied as to making any change therein.

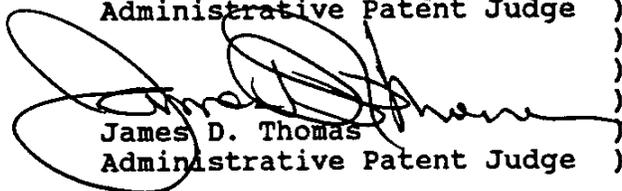
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

**DENIED**

  
Jerry D. Craig  
Administrative Patent Judge )

  
Thomas E. Lynch  
Administrative Patent Judge )

  
James D. Thomas  
Administrative Patent Judge )

BOARD OF PATENT  
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