Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE HERBERT R. BLAESE
Serial No. 07/254,260
May 15, 1991

For: ON-GLASS ANTENNA
***1** Filed: October 6, 1988

Harry F. Manbeck, Jr.

Commissioner of Patents and Trademarks

DECISION ON PETITION

MEMORANDUM OPINION AND ORDER

Background

Blaese seeks reissue of U.S. Patent No. 4,658,259 issued April 14, 1987.

The patent is currently involved in a patent infringement suit in the Central District of California. Blaese v. Alliance Research Corp., Civil Action No. 88- 3321. As provided by an order quoted in part, infra, the civil action has been stayed pending completion of proceeding in the application.

Some of the claims of the application have been finally rejected by the Primary Examiner. An appeal has been taken to the Board of Patent Appeals and Interferences. Ex parte Blaese, Appeal No. 91-1191. A hearing before a panel of the Board is set for June 13, 1991.

On May 8, 1991, the Patent and Trademark Office (PTO) received the following request from a defendant in the civil action:

> Confirming telephone conversations with [an employee in the Clerk's Office of the Board of Patent Appeals and Interferences] at the Patent and Trademark Office, Defendant ALLIANCE RESEARCH CORPORATION, through its attorneys ARANT, KLEINBERG & LERNER, wishes to participate in the oral argument in the above identified appeal, as mandated by the Order of the United States District Court for the Central District of California. A copy of that Order was mailed to the Patent and Trademark Office by the applicant on December 1, 1988.
>
> Pursuant to that Order, Defendant has submitted papers accompanying all of Applicant's responses as a part of Applicant's responses to Official Actions. Since the oral argument is an integral part of the appeal process, it is believed that Defendant should be permitted to make an oral argument as a part of appellant's oral argument and requests that the Honorable Board extend appellant's time to accommodate this request. On April 16, 1991, Appellant confirmed attendance at the hearing. By this communication, and subject to the decision of the Board on this request, Defendant confirms its attendance at the hearing.

The Central District of California entered an order on November 28,

1988, providing in pertinent part:

The plaintiffs' motion to stay proceedings is GRANTED. The Court further orders that plaintiffs allow defendants to participate in all phases of the reissue proceedings before the Patent Office. Additionally, plaintiffs shall provide defendants with copies of all documents filed in the reissue proceedings prior to the time of submission to the Patent Office and plaintiffs shall include documents prepared by defendants in all documents filed in the reissue proceedings so as to enable defendants to effectively participate in the reissue proceedings.

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In the instant action, a stay of these proceedings can be expected to result in a simplification of the issues and benefit this litigation because the patent examiner will examine all claims in the reissue application as well as all issues relating to claim language and patentability of the patent in suit. This will reduce the need for court proceedings with respect to certain issues and will give this Court the benefit of the Patent Office's expertise on these main issues of the lawsuit. Furthermore, defendants will not be prejudiced because the Patent Office expedites reissue applications involved in litigation and defendants will be allowed to participate in all phases of the reissue proceedings. [FN1] Thus, it is to the benefit of all parties and in the interest of judicial economy that the instant action be stayed pending the examination of the reissue application.

***2** A review of the Examiner's Answer in the appeal presently before the Board indicates that:

(1) Claims 1 through 13 are allowable.

(2) Claims 14 and 15 have been rejected as being based on a defective reissue declaration under 37 CFR § 1.175.

(3) There is no rejection based on the prior art, new matter, or indefiniteness.

Pursuant to the Court's order, and as part of his response to PTO actions, reissue applicant Blaese has submitted statements prepared by counsel for defendants. In a paper submitted together with applicant's appeal brief to the Board, and styled OPPOSITION BRIEF, defendants contend:

(1) Applicant's reissue declaration fails to comply with 35 U.S.C. § 251.

(2) Applicant's added claims "contain new matter" (presumably what defendant contends is that the subject matter of those claims is not disclosed in the original patent).

(3) Prior art anticipates (35 U.S.C. § 102) or renders obvious (35 U.S.C. § 103) subject matter claimed in "new claims."

(4) Applicant seeks to recapture "matter either specifically taught away from in the originally filed specification or surrendered during the prosecution of the application into a patent" (opposition brief, p. 3).

(5) Applicant's new claims are not patentable under 35 U.S.C. § 112, because they are indefinite.

In his Answer, the Examiner notes (pages 3-4):

In regard to the paper titled "Opposition Brief" submitted with Appellant's Brief, it has been considered by the examiner and reiterates various arguments already presented. The various additional rejections suggested therein are not believed to be applicable by the examiner and are not being made herein.
Thus, with the possible exception of defendants' contention that applicant's reissue declaration fails to comply with § 251, the Examiner has declined to adopt defendants' proposed rejections.

Opinion

The Federal Circuit recently noted that a third party may not protest the grant of a patent. Animal Legal Defense Fund v. Quigg, No. 90-1364, slip op. at 20 (Fed. Cir. April 30, 1991) (5-judge court). Likewise, a protestor may not appeal a favorable decision of a patent examiner. Ely v. Manbeck, 17 U.S.P.Q.2d 1252 (D.D.C. 1990). But see 37 CFR § 1.196(b).

There was a time when PTO encouraged participation by protestors in reissue applications. For example, in 1977, PTO rules were amended to permit increased participation by protestors. See 42 Fed. Reg. 3588, 3589, col. 1 (Jan. 28, 1977), amending 37 CFR § 1.291 (Rule 291). In 1982, however, PTO again amended Rule 291, this time to limit third-party protestor participation during ex parte examination of patent applications. 47 Fed. Reg. 21746, col. 2 (May 19, 1982) ("The rule change also seeks to reduce the amount of time required by the PTO to examine protested applications by limiting protestor participation."). Specifically, Rule 291(c) was amended to include the following sentence:

***3** The active participation of the member of the public filing a protest . . . ends with the filing of the protest and no further submission on behalf of the protestor will be acknowledged or considered . . . .

37 CFR § 1.291 (1982). The comments accompanying the rule change indicate:

Under the rule change, protestor participation will be limited to the filing of papers in opposition to the grant of a patent with no Office communications to the protestor resulting therefrom beyond an acknowledgment of receipt of a protest or petition to strike in reissue applications. The opportunity to comment on Office actions and applicants' responses is eliminated.

47 Fed. Reg. 21746, col. 2. The amendment to Rule 291(c) was specifically designed "[t]o ensure that the proceedings are essentially ex parte . . . ." 47 Fed. Reg. at 21749, col. 2. The comments accompanying the rule change note that "a sentence is being added to paragraph (c) of § 1.291, indicating that active participation by a member of the public ends with the filing of the protest." Id. PTO further explained in the notice proposing to amend Rule 291:

This proposed rule change is designed to reduce the prosecution costs of patent applicants by limiting the amount of participation by protestors during the patent application examining process.

46 Fed. Reg. 55666, col. 2 (Nov. 10, 1981).

In light of the amendment to Rule 291, defendants' request to participate in the oral hearing before the Board is denied.

Proceedings on reissue applications are open to the public. 37 CFR § 1.11(b). Hence, counsel for defendants may attend the hearing before the Board and listen to applicant's argument, even though he cannot otherwise participate in the hearing.

In denying defendants' request, PTO has not overlooked the Court's order. Defendants' participation in the oral hearing before the Board is not "mandated" by the Court's order as alleged by defendants. It is true that the Court ordered that "plaintiff allow defendants to participate in all phases of the reissue proceedings before the Patent Office." However, the order is not directed to PTO. Indeed, the doctrine of separation of powers precludes applying the order against PTO. Rule 291 has the force and effect of law. In re Rubinfield, 270 F.2d 391, 123 USPQ 210 (CCPA 1959), cert. denied, 362 U.S. 903 (1960). Rule 291 does not permit defendants to participate in oral argument before the Board.

An observation concerning the Court-ordered procedure is believed to be in order. Defendants are not protestors within the meaning of Rule 291 because they have not filed papers in PTO. It is true that papers authored by counsel for defendants have been presented to PTO. However, those papers were submitted by applicant because the Court ordered applicant to include with his responses to PTO actions "documents prepared by defendants . . . so as to enable defendants to effectively participate in the reissue proceedings." The Court's order is not inconsistent with Rule 291. Insofar as PTO is concerned, any submission by an applicant which includes (1) the applicant's views, and (2) the views of another, is a response by the applicant. That an applicant must file those views because it is ordered to do so by a Court does not change the fact that the submission is by the applicant, as opposed to direct third-party participation. The Court's procedure did not unduly delay proceedings. Applicant had to respond to PTO actions within the time set by the Primary Examiner. PTO did not have to set additional time for defendant to reply to applicant's response. Likewise, PTO did not have to supervise disputes between applicant and defendants. Accordingly, the court-ordered procedure did not require participation by defendants contrary to Rule 291, and did not involve the kind of delay and inter partes supervision which caused PTO to amend Rule 291 in 1982.

***4** Rule 291 does not permit defendants to participate in oral argument before the Board. PTO does not believe it appropriate to create an exception in this case, even though it recognizes that defendants' views will not be made known through oral argument. To some extent, defendants' inability to present oral argument leaves a "hole," albeit a small hole, in an otherwise creative order entered by the Central District of California. As a matter of comity, and to assist the Court to the maximum extent possible, without contravening PTO's Rule 219 policy, the Board is authorized and encouraged to implement the following procedure. If (1) counsel for applicant presents an oral argument to the Board, (2) counsel for defendants attends oral argument, and (3) the panel is of the opinion that significant new arguments were made at the hearing, either by counsel for applicant or as a result of questions by an Examiner-in- Chief, the panel shall ask applicant to submit, within fifteen (15) days of the hearing, a paper summarizing the new arguments at the hearing. Under the Court order,

applicant would have to give defendants an opportunity to comment and both applicant's and defendants' written comments could then be received by the Board.

ORDER

Upon consideration of defendants' request to participate in the oral hearing before the Board, it is

ORDERED that the request to participate in the hearing is denied and it is

FURTHER ORDERED that counsel for defendants may attend the hearing as a spectator, but shall not be permitted to present oral argument and it is

FURTHER ORDERED that if (1) counsel for applicant presents an oral argument to the Board, (2) counsel for defendants attends oral argument, and (3) the panel is of the opinion that significant new arguments were made at the hearing, either by counsel for applicant or as a result of questions by an Examiner-in-Chief, the panel shall ask applicant to submit, within fifteen (15) days of the hearing, a paper summarizing the new arguments and it is

FURTHER ORDERED that a copy of this MEMORANDUM OPINION AND ORDER be transmitted to counsel by fax and first-class mail.

FN1. As explained, infra, since 1982, PTO has not permitted protestors "to participate in all phases of a reissue proceeding." The parties apparently did not advise the Court of changes made in 1982 to 37 CFR § 1.291 (Rule 291).

19 U.S.P.Q.2d 1232

END OF DOCUMENT