PATENTABLY DISTINCT CLAIMS –RESEARCH

A. Standards

1. PTO requirements for SRR

Applicants should detail why the inventions are independent or distinct as claimed and not merely make conclusory statements that "the claims are independent and distinct." For guidance and tests for determining when inventions are independent or distinct, Applicants should refer to M.P.E.P. §§ 802.01, 806, 806.05-806.05(j), 806.06, and 808.01. To strengthen the argument, an applicant can also explain why the Examiner would be burdened if the restriction is not required. Arguments relating to the burden aspect can be based on M.P.E.P. §§ 803.02, 808, and 808.02. The Office's FAQs provide a couple of examples relating to the burden, such as providing an appropriate explanation of separate classification of claimed subject matter, or highlighting that the subject matter has separate status in the art, or that the subject matter would require a different field of search as defined in M.P.E.P. § 808.02.

2. Court's and Board's Procedure

"Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier patent and the claim in the later patent and determines the differences. Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim." *Eli Lilly v. Barr*, 251 F.3d 955, 968 (Fed. Cir. 2001).

B. Takeaways From Cases

1. Claims to a genus in a later application are likely patentably indistinct from claims to a species in an earlier application.

2. Simple changes, alterations, or modifications in claim language will likely not be sufficient to show distinctness.

3. Claims directed to a device that suggest how to use the device are not patentably distinct from claims directed to a method of using a device.

4. Make sure that claims have different elements to show distinctness

C. Patentably Indistinct Under the "One Way" Test – Obviousness Double Patenting

1. *Perricone, M.D. v. Medicis Pharmaceutical Corporation*, p.3 (later claims were patentably indistinct because they were directed to a genus of the prior species, ranges overlapped, and the rest of the changes were simple language variations)

2. *In re Setsuo Fujimura et al.*, p.4 (later claims were patentably indistinct because the only difference from the claims was obvious to one skilled in the art)

3. *Eli Lilly and Company v. Barr Laboratories, Inc.*, p.6 (later claims were patentably indistinct because they were inherently anticipated by the earlier claims)

4. *In re Robert Lonardo*, p.7 (later claims were patentably indistinct because (1) many of the differences were in genus-species form; or (2) the later claims were direct to a method using a device of the earlier claims)

5. *Ex Parte Naoyo Isoda et al.*, p.10 (claims were patentably indistinct because the only changes were linguistic)

6. *Ex Parte Joseph B. Cashman*, p.11 (claims were prima facie obvious over the earlier claims because the products in the pending claims were prepared by the process of the earlier claims)

7. *Ex Parte Charles E. Nesbit et al.*, p.13 (differences were merely obvious)

D. Patentably Distinct Under the "One Way" Test – Obviousness Double Patenting

1. *Texas Instruments Incorporated v. U.S. International Trade Commission*, p.14 (later claims were patentably distinct because they disclosed an element not present in the earlier claims)

2. *General Foods Corporation v. Studiengesellschaft Kohle*, p.16 (later claims were patentably distinct because (1) the invention in the later claims received no protection from the earlier claims; (2) the inventions were directed towards different objectives, and (3) each process was capable of being used by itself)

3. *Ex Parte Marvin Davis et al.*, p.18 (later claims were patentably distinct because they disclosed an element not present in the earlier claims)

E. Case Examples – Patentably Indistinct

1. PERRICONE, M.D v. MEDICIS PHARMACEUTICAL CORPORATION, 432 F.3d 1368 (Fed. Cir. 2005)

Claim from a prior patent

1. A method for treating skin sunburn comprising topically applying to the skin sunburn a fatty acid ester of ascorbic acid effective to solubilize in the lipid-rich layers of the skin an amount effective to scavenge therefrom free radicals present as a result of transfer of energy to the skin from the ultraviolet radiation which produced said sunburn.

Claim on appeal

9. A method for the treatment of skin damaged or aged by oxygen-containing free radicals or oxidative generation of biologically active metabolites which comprises topically applying to affected skin areas a composition containing an effective amount of an ascorbyl fatty acid ester in a dermatologically acceptable, fat-penetrating carrier such that the ester is percutaneously delivered to lipid-rich layers of the skin.

REASONING

The district court first identified the differences between the two claims:

"(1) claim 9 of the '063 patent teaches a method for treatment of certain skin disorders, while claim 1 of the '693 patent teaches a method for treatment of sunburn; (2) claim 9 of the '063 patent recites the use of 'an effective amount of an ascorbyl fatty acid ester ...,' while claim 1 of the '693 patent teaches applying an ascorbyl fatty acid ester 'effective to solubilize in the lipid-rich layers of the skin an amount effective to scavenge free radicals present as a result of the transfer of energy to the skin from the ultraviolet radiation which produced [the] sunburn'; and (3) claim 9 of the '063 patent recites the use of 'a dermatologically acceptable, fat-penetrating carrier such that the ester is percutaneously delivered to lipid-rich layers of the skin,' while the '693 patent does not explicitly recite the use of a carrier.

The district court analyzed those distinctions. In the first place, the district court noted that 'sunburn is a species of the genus of skin disorders' covered by the '063 patent. Id. Next, consulting the specifications of both patents, the district court concluded that the claimed effective amount in the '063 patent falls within the ranges of effective amounts in the '693 patent. Finally, the district court construed the 'effective to solubilize' language in claim 1 of the '693 patent to mean the same thing as the language in claim 9 of the '063 patent requiring 'a dermatologically acceptable, fat-penetrating carrier such that the ester is percutaneously delivered to lipid-rich layers of the skin.' Accordingly, the district court found claim 9 of the '063 patent invalid for obviousness-type double patenting in view of claim 1 of the '693 patent." Perricone, M.D. v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1373-74 (Fed. Cir. 2005).

The Federal Circuit stated that the district court didn't err in its interpretation.

2. **IN RE SETSUO FUJIMURA, MASATO SAGAWA, YUTAKA MATSUURA, HITOSHI YAMAMOTO, AND NORIO TOGAWA, 130 Fed.Appx. 465, 76 U.S.P.Q.2d 1630 (Fed. Cir. 2005)**

Claim from a prior patent

1. A magnetic anisotropic sintered permanent magnet of the (Fe,Co)BR system in which R represents the sum of R_1 and R_2 wherein:

R_1 is at least one rare earth element selected from the group consisting of Dy, Tb, Gd and Ho, and at least 80 at % of R_2 consists of Nd and/or Pr, the balance being at least one other element selected from the group consisting of La, Ce and Y,

said system consisting essentially of, by atomic percent, 0.2 to 5% of R_1, 12.5 to 20% of R, 5 to 11% of B, and at least 69% Fe in which Co is substituted for Fe in an amount greater than zero and not exceeding 25% of the system; and

said magnet having a tetragonal (Fe,Co)-B-R crystal structure phase of at least 50 vol % of the entire magnet, having a higher Curie temperature than a corresponding Fe-B-R base composition containing no Co, and having a maximum energy product of at least 25 MGOe and an intrinsic coercive force of at least 12 kOe.

Claim on appeal

27. A fully crystalline (Fe,Co)BR permanent magnet alloy in which R represents the sum of R1 and R2 wherein:

R1 is at least one rare earth element selected from the group consisting of Dy, Tb and Ho, and

R2 consists of Nd and/or Pr,

said alloy consisting essentially of, by atomic percent, 0.2 to 3% of R1, 12.5 to 20% of R, 5 to 11% of B, and at least 69% Fe in which Co is substituted for Fe in an amount greater than zero and not exceeding 25% of the alloy; and

said alloy having a tetragonal (Fe,Co)-B-R crystal structure phase of at least 50 vol % of the entire magnet alloy, having a higher Curie temperature than a corresponding Fe-B-R base composition containing no Co.

REASONING

"[T]he appellants object to the Board's statement that 'when overlapping of subject matter occurs between two sets of claims, even though the claims are not identical, the claims are not patentably distinct from each other.' The appellants appear to argue that given the Board's statement, the Board improperly determined that substantial overlap alone was sufficient to find double patenting. That is not what the Board did, however. Instead, the Board found that, in light of the overlap between the patented claims and the

claims of the application, the examiner was correct to find that a person of ordinary skill in the art would find that the claims in the application were obvious. We find no fault with the Board's analysis in that regard." In re Setsuo FUJIMURA, 130 Fed.Appx. 465, 469 (Fed. Cir. 2005)

"The examiner explained that both claim 1 of the '255 patent and claim 27 of the application 'recite essentially the same alloy composition,' and that the sintering step recited in the '255 patent merely meant that the alloy recited in the two claims was 'in different forms,' not that the composition was different." *Id*.

"It does not matter that there may be some other precursor that could produce the sintered permanent magnet. What matters is whether the precursor permanent magnet alloy would be obvious to a person of skill in the art having knowledge, based on claim 1 of the '255 patent, of all the components of the precursor alloy. The only significant difference between claim 1 of the '255 patent and claim 27 of the application is that the former recites a sintered form of the latter. The appellants do not suggest that sintering alters the composition of the alloy. Accordingly, the examiner sensibly concluded that a person of ordinary skill in the art, having possession of a sintered magnet with particular components could infer the unsintered form of the same composition, which is the composition claimed in application claim 27." *Id.*

3. **ELI LILLY AND COMPANY v. BARR LABORATORIES, INC, 251 F.3d 955 (Fed. Cir. 2001)**

Claim from prior patent
A method for treating anxiety in a human subject in need of such treatment which comprises the administration to said human of an effective amount of fluoxetine or norfluoxetine or pharmaceutically-acceptable salts thereof.

Claim on appeal
The method of claim 4 [blocking the uptake of monoamines by brain neurons in animals] comprising administering to said animal a monoamine blocking amount of N methyl 3-p-trifluoromethylphenoxy-3-phenylproplyamine [fluoxetine] or a pharmaceutically-acceptable acid addition salt thereof.

REASONING
"Generally, an obviousness-type double patenting analysis entails two steps. First, as a matter of law, a court construes the claim in the earlier patent and the claim in the later patent and determines the differences. Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim." Eli Lilly v. Barr, 251 F.3d 955, 968.

"A person of ordinary skill in the art would have recognized that fluoxetine hydrochloride is a pharmaceutically-acceptable salt of fluoxetine. In fact, hydrochloride salts are the most common pharmaceutically acceptable salts of basic drugs, and hence are obvious compounds. Therefore, the only difference between claim 1 of the ′213 patent and claim 7 of the ′549 patent is that the former addresses a method of treating anxiety in humans with fluoxetine hydrochloride while the latter claims a method of using fluoxetine hydrochloride to block serotonin uptake in animals. Having recognized the difference between the claims at issue, we must decide whether this difference renders the claims patentably distinct.

Serotonin uptake inhibition is a natural biological activity that occurs when fluoxetine hydrochloride is administered to an animal, such as a human, for any purpose, including the treatment of anxiety. That is, serotonin uptake inhibition is an inherent property of fluoxetine hydrochloride upon its administration." *Id.* at 969.

4. **IN RE ROBERT LONARDO, 119 F.3d 960, 43 U.S.P.Q.2d 1262 (Fed. Cir. 1997)**

Claim from a prior patent

The '762 patent

1. A therapeutic leg and foot device comprising an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel-shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said foot and leg portions and having a free and unflanged edge to permit flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position, and means for releasably securing the device to the leg and foot of a patient.

Claims on appeal

The '748 patent

1. A therapeutic leg and foot device, comprising, an L-shaped member comprised of a one piece flexible plastic material;

said L-shaped member having a leg portion, a heel portion integral with one end of said leg portion, and a foot portion extending integrally from said heel portion at right angles to said leg portion,

said heel portion having a configuration to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion when the posterior region of the lower leg and the sole of the foot of a patient wearing the device are in supporting contact with said leg portion and said foot portion, respectively, resulting from the configuration of said heel portion,

said heel portion having substantially free and unflanged side edges to permit lateral visibility of said space and a patient's heel suspended within said space, and

means for releasably securing said device to the leg and foot of a patient.

9. The device of claim 1 wherein said means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patient with a cut out heel portion adjacent said heel portion of said splint and said space

REASONING

"We agree with the PTO that the claims in question are unpatentable on the ground of obviousness-type double patenting, not because one could not practice the invention of the '762 patent without infringing claims 9 and 10, but because each of the additional limitations argued by Restorative Care is an obvious modification of the device defined

in the '762 claim. Many of the alleged differences in elements are in species-genus form, the expired '762 patent claiming an element with specificity and the '748 claims defining it more generically. For example, Restorative Care has shown no patentable distinction between a 'leg portion" ('748 patent) and a 'generally contoured and channel-shaped leg portion" ('762 patent), between a 'foot portion' and a 'generally contoured foot portion,' or between a 'heel portion' and a 'curved heel portion.'" *In re Robert Lonardo*, 119 F.3d 960, 967 (Fed. Cir. 1997)

Claim on appeal

The '013 patent

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion will provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective,

and securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space.

REASONING

"Restorative Care argues that the method of using the device would not have been obvious over a claim to the device. We do not agree that there is a patentable distinction between the method of using the device and the device itself. The claimed structure of the device suggests how it is to be used and that use thus would have been obvious." *In re Robert Lonardo*, 119 F.3d 960, 968 (Fed. Cir. 1997)

Claim on appeal

The '756 application

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion secured to one end of said leg portion, and a foot portion extending from said heel portion substantially at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion alone will provide a space between the heel portion and said heel of said patient to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respectively,

securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion, and the foot of the patient,

and providing an opening in said sandal adjacent said heel portion of said L-shaped member and said space to permit visual inspection of said space from a lateral direction.

REASONING

"For the reasons explained above, we do not agree that these are nonobvious distinctions or that there is such a distinction between the method of using the device and the device itself. Accordingly, we conclude that the board did not err in holding that the claim of the '756 application is unpatentable over the '762 patent on the ground of double patenting." *In re Robert Lonardo*, 119 F.3d 960, 968 (Fed. Cir. 1997)

5. **EX PARTE NAOYO ISODA AND MASAHIKO ENOYOSHI, 2005 WL 3524604 (Bd.Pat.App. & Interf., Oct. 19, 2005)**

Claim from prior patent

A vehicle comprised of an internal combustion engine, a transmission driven by said engine, a driven wheel driven by said transmission, and an engine control comprised of a single sensor for detecting during engine acceleration variations in the rotational state of a shaft, determining if the degree of change in rotational state variation is excessive from the output of said single sensor, and restricting engine output if the degree of change in rotational state of said shaft is excessive.

Claim on appeal

A vehicle comprised of an internal combustion engine, a transmission system driven by said engine, a driven wheel driven by said transmission system and an engine control for detecting during engine acceleration variations in the rotational state of a shaft, determining if the degree of change in rotational state variation is excessive and will cause difficulties in the transmission system, and restricting engine output if the degree of change in rotational state of said shaft is excessive.

REASONING

"Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an engine control having an engine transmitting rotation to driven wheels through a transmission system and detecting during engine acceleration variations in the rotational state of the shaft if the degree of change in variation of the shaft is excessive and restricting an engine output if the change is excessive." *Ex Parte Naoyo Isoda*, 2005 WL 3524604, *2.

6. **EX PARTE JOSEPH B. CASHMAN, 2002 WL 31234490 (Bd.Pat.App. & Interf.)**

Claim from prior patent
A hydrometallurgical process for the recovery of base metals including any of zinc, cadmium, and copper from electric arc flue dust containing, in addition to the base metals, any of iron, sodium, magnesium, and potassium capable of forming jarosites or pseudojarosites while producing only solid, stable byproducts suitable for sale or recycle, comprising the steps of:

(a) mixing dry electric arc flue dust powder with a calcium chloride/hydrochloric acid leach mill solution to produce a slurry having a pH of about 2.6 and a solids content (pulp density) of about 15-30 wt. %;

(b) oxidizing the base metals in the slurry to produce a metal-rich solution containing the base metals and to also produce an insoluble hematite complex by heating the slurry in an oxygen atmosphere at a temperature of about 90-120 deg C and a pressure of about 50-90 psi;

(c) filtering the hematite complex from the metal-rich solution;

(d) recovering base metal oxides including zinc oxide from the metal-rich solution while producing a calcium chloride recycle stream;

(e) adding sulfuric acid to the calcium chloride recycle stream to regenerate the calcium chloride/hydrochloric acid leach mill solution while producing gypsum;

(f) recycling the hematite complex to an electric arc furnace;

(g) recovering zinc metal from the base metal oxides;

(h) recycling the calcium chloride/hydrochloric acid leach mill solution.

Claims on appeal
Claim 1. An iron-rich residue obtained by

(a) mixing dry electric arc flue dust powder with a calcium chloride/hydrochloric acid leach mill solution to produce a slurry having a pH of about 2.6 and a solids content (pulp density) of about 15-30 wt.%;

(b) oxidizing the base metals in the slurry to produce a metal-rich solution containing the base metals and an insoluble hematite complex by heating the slurry in an oxygen atmosphere at a temperature of about 90-120 deg C and a pressure of about 50-90 psi; and

(c) filtering the hematite complex from the metal-rich solution.

Claim 21. An iron-rich solid residue obtained by the process for the recovery of zinc from electric arc flue dust while recycling flue dust iron to the electric arc furnace, comprising the steps of:

(a) at a pH of about 2.6, leaching zinc in electric arc flue dust into an aqueous solution using a calcium chloride/hydrochloric acid leach mill solution;

(b) separating the aqueous solution from an iron-rich solid residue remaining after the leach of step (a);
(c) recovering the zinc from the aqueous solution by adding calcium hydroxide to the aqueous solution at a pH of about 6-10 to create a calcium-rich solution;

(d) regenerating the calcium chloride/hydrochloric acid leach mill solution by adding sulfuric acid to the calcium-rich solution to precipitate gypsum; and

(e) separating the gypsum from the leach mill solution.

Claim 29. An iron complex obtained by the process:
(a) reacting a slurry of the flue dust and a calcium chloride/hydrochloric acid leach mill solution to place the base metals in solution while leaving essentially all of the iron complexed with the sodium, potassium, and magnesium; and

(b) separating the base metal solution from the iron complex.

REASONING
"Because appellant has conceded that the products herein claimed are, in fact, prepared by the process of his earlier issued patent, we find that the products would have at least been *prima facie* obvious from the claims of appellant's prior patent." *Ex Parte Joseph B. Cashman*, 2002 WL 31234490, *6.

7. **EX PARTE CHARLES E. NESBIT AND MARK S. NESBIT, 25 U.S.P.Q.2d 1817, 1992 WL 454286 (Bd.Pat.App. & Interf. 1992)**

Claim from prior patent

1. In a basketball backboard and basketball rim combination an improvement comprising:

an illumination means in the form of illumination lights contained within both the basketball rim and portions of the basketball backboard wherein both said rim and backboard are provided with transparent surfaces that will permit the transmission of light from the said illumination lights; and

switching means for controlling the on/off actuation of said illumination lights; wherein, the switching means includes pressure sensitive means located on the face of the backboard for controlling the on/off actuation of said illumination lights.

2. The improvement as in claim 1; wherein, the switching means further comprises time delay means operatively associated with said pressure sensitive means for controlling the on/off actuation of said illumination lights.

Claim on appeal

13. In a basketball backboard and basketball rim combination an improvement comprising:
an illumination means in the form of illumination lights contained within both the basketball rim and portions of the basketball backboard wherein both said rim and backboard are provided with transparent surfaces that will permit the transmission of light from the said illumination lights; and
switching means for controlling the on/off actuation of said illumination lights; wherein, the switching means includes time delay means for controlling the on/off actuation of said illumination lights.

REASONING

“Appellants have not indicated what the alleged ‘different structural limitations’ are and have not presented any arguments as to the unobviousness of such differences. We have compared the claims on appeal with [claim 2] of appellants' prior patent, and we deem such differences to be merely obvious variations of appellants' prior claimed invention considered alone . . . .”

F. **Case Examples – Patentably Distinct**

1. **TEXAS INSTRUMENTS INCORPORATED v. UNITED STATES INTERNATIONAL TRADE COMMISSION, 988 F.2d 1165 (Fed. Cir. 1993)**

Claims from a prior patent
17. A method for contacting semiconductor devices, comprising the steps of:

(a) providing a metal sheet in the form of a ladder having recesses therein which divide said sheet into a plurality of parallel strips constituting ladder rungs which are spaced apart from one another and which are joined together at at least one of their ends by at least one side piece;

(b) providing a semiconductor device constituted by a semiconductor body having at least one electrode on one surface thereof;

(c) conductively connecting said semiconductor body to one of said strips;

(d) conductively connecting said electrode to a respective other side of said strips through the intermediary of a corresponding electrode lead; and

(e) separating said strips from one another and from the remaining portion of said metal sheet for enabling said strips to be used as contacts for said semiconductor device.

Claims on appeal
12. The process for encapsulating a semiconductor device comprising:

electrically connecting each of the electrical terminals of the device to a conductor and mechanically attaching a portion of said device to at least one of the conductors for support;

disposing the conductors generally in a common plane;

disposing the device and a major portion of the means for making electrical connection between the terminals and the conductors generally on one side of the plane;

disposing the device and portions of the conductors in a mold cavity; and

holding the ends of the conductors extending from the mold cavity **while injecting a fluid insulating material into the mold cavity on the other side of the plane** to subsequently solidify and embed said device, the fluid insulating material being injected into a portion of the cavity remote from the device and the means electrically connecting the terminals of the device to the conductors, whereby the fluid will not directly engage the device and electrical connection means at high velocity, and the conductors will be secured against appreciable displacement by the fluid.

14. A process of encapsulating a semiconductor device comprising:

providing electrical connections between electrical terminals of the device and a plurality of conductors arranged in a substantially common plane, said device and the thusly provided electrical connections thereto being disposed on one side of said plane,

disposing the device and portions of the conductors in a mold cavity, and

holding the conductors while injecting a fluid insulating material into the mold cavity for subsequently solidifying and embedding said device,

the fluid insulating material being injected into a portion of the cavity on the opposite side of said plane to preclude direct high velocity engagement between the fluid and the device and the electrical connections thereto.

17. A process of encapsulating a semiconductor device comprising:

providing electrical connections between electrical terminals of the device and a plurality of conductors arranged substantially parallel to one another, said device and the thusly provided electrical connections thereto being provided on one side of said conductors,

disposing the device and portions of the conductors in a mold cavity, and

holding the conductors while injecting a fluid insulating material into the mold cavity for subseqently solidifying and embedding said device,

the fluid insulating material being injected into a portion of the cavity on the opposite side of said conductors to preclude direct high velocity engagement between the fluid and the device and the electrical connections thereto.

REASONING

"These claims are not so very much alike as to render claims 12, 14 and 17 of the '027 patent obvious in view of claim 17 of the '764 patent. Claims 12, 14, and 17 of the '027 patent disclose injecting the fluid insulating material from a gate on the opposite side of the conductors. Opposite-side injection of the fluid is not disclosed in [] claim [] 17 of the '764 patent, nor would it be obvious in light of claim[] 17 of the '764 patent."

2. **GENERAL FOODS CORPORATION v. STUDIENGESELLSCHAFT KOHLE mbH, 972 F.2d 1272 (Fed. Cir. 1992)**

Claim from prior patent

1. A process for obtaining caffein from green coffee which comprises:

a. contacting moist carbon dioxide in supercritical state with the coffee in a caffein absorption zone for absorption of caffein by the moist carbon dioxide,

b. withdrawing the moist carbon dioxide containing absorbed caffein from the absorption zone and contacting it with water for extraction of caffein from the moist carbon dioxide in an extraction zone for formation of an aqueous solution of caffein,

c. recirculating the moist carbon dioxide between the absorption zone and the contacting zone,

d. withdrawing aqueous solution of carbon dioxide from the extracting zone and introducing it into an evaporating zone, passing a stream of air or nitrogen through the aqueous solution in the evaporating zone for evaporation of water from the solution and concentration of caffein in the aqueous solution, and withdrawing a concentrated aqueous solution from the evaporating zone,

e. withdrawing the air or nitrogen laden with water vapor from the evaporating zone and cooling it for condensation of water and separating the water from the air or nitrogen in a separating zone,

f. recirculating the air or nitrogen between the evaporating zone and the separating zone,

g. admixing aqueous solution of carbon dioxide from the extraction zone with the air or nitrogen conveyed from the separating zone to the evaporating zone,

h. passing the air or nitrogen laden with water vapor and the admixture formed in step (g) in indirect heat exchange relation between the evaporating zone and the separating zone, for cooling of the air or nitrogen laden with water vapor for the condensation of step (e) and heating said admixture for heating the aqueous solution for the evaporation, and

[sic-no step i.]

j. supplying additional heat to the aqueous solution for the evaporation.

Claims on Appeal

1. A process for the decaffeination of raw coffee which comprises contacting the raw coffee with water-moist carbon dioxide above its critical temperature and critical pressure to effect removal of caffeine therefrom and recovering a substantially decaffeinated

coffee, the amount of water in the carbon dioxide being sufficient to effectuate said removal of the caffeine from the coffee.

4. A process as claimed in claim 1, in which the contact with the moist carbon dioxide is effected for a period of from 5 to 30 hours.

REASONING

"Double patenting is intended to prevent unjustified extension of protection. Because the trial court misunderstood the construction of patent claims, it failed to appreciate that the invention of the second-to-issue '639 patent received no protection from the first-issued '619 patent because no claim of the latter covers the decaffeination process." *General Foods Corporation,* 988 F.2d at 1282.

"It should be amply clear by now that the decaffeination invention and the caffeine recovery invention are separate and distinct inventions, directed to different objectives, and patentably distinguishable one from the other." *Id.* at 1277.

"Each process, nevertheless, is capable of being used by itself. The fact that it may be desirable to use both inventions in the same commercial process does not result, however, in any recognized form of double patenting, or in the "extension" of either patent; each patent has a term of seventeen years." Id. at 1279.

3. **EX PARTE MARVIN B. DAVIS AND KENT MURPHY, 2000 WL 33287861 (Bd.Pat.App. & Interf., March 22, 2000)**

Claim from prior patent

1. A cartridge loading apparatus for use with a disk drive having a cartridge loading end and a remote end, said cartridge loading apparatus comprising:

a base plate having a first slider channel and a second slider channel;

means for slidably supporting a fine actuator assembly carriage relative to said base plate for movement over an information storage disk having a central hub;

a parking arm rotatably secured to said base plate about a parking arm axis, said parking arm including a linking end and a pressing end for acting upon the fine actuator assembly carriage;

a first slider slidably associated with said first slider channel, said first slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive;

a second slider slidably associated with said second slider channel, said second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive, one of said first and second sliders having lug means formed thereon for engaging said linking end of said parking arm;

a tiller having a first end and a second end, said first end of said tiller being swingably associated with said forward end of said first slider, and said second end of said tiller being swingably associated with said forward end of said second slider, so that a first rotation of said tiller in a first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

a cartridge receiver for receiving a respective cartridge containing the disk, said cartridge receiver being linked to said first and second sliders and tiltably moveable between an upper position and a lower position along a vertical path when said sliders are driven by said tiller;

a cam operatively associated with said tiller for rotating said tiller about said tiller axis so that when said first and second sliders move said cartridge receiver between said upper and lower positions, said cartridge receiver, respective cartridge, and disk move along said vertical path so that the central hub is inclined relative to a spindle magnet for loading and unloading the disk thereon thereby reducing the force needed to remove the central hub from the spindle magnet while coordinating movement of the fine actuator assembly carriage by interaction of said parking arm with said one of said first and

second sliders; and

a jaw member positioned proximate said linking end of said parking arm, said jaw member having a first side and a second side which straddle said lug means so that when said one slider is moved toward the cartridge loading end of the disk drive, said lug means engages one of the sides of said jaw member thereby rotating said parking arm about said parking axis so that the pressing end of said parking arm acts against the fine actuator assembly carriage which is thereby moved away from the cartridge loading end of the disk drive allowing said respective cartridge to be loaded therein.

Claim on appeal

1. A cartridge loading apparatus for use with a disk drive having a cartridge loading end and a remote end, said cartridge loading apparatus comprising:

a base plate having a first slider channel and a second slider channel;

a first slider slidably associated with said first slider channel, said first slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive;

a second slider slidably associated with said second slider channel, said second slider having a forward end adjacent the cartridge loading end of the disk drive and a remote end adjacent the remote end of the disk drive, **one of said first and second sliders having a notch formed therein**;

a bias coil arm rotatably secured to said base plate, said bias coil arm including a bias coil assembly and having a lever arm extending therefrom, said lever arm being engagable with said notch in said one of said first and second sliders so that when said one slider is activated, said bias coil arm turns to correspondingly position the bias coil assembly relative to an information storage disk having a central hub;

a tiller having a first end and a second end, said first end of said tiller being swingably associated with said forward end of said first slider, and said second end of said tiller being swingably associated with said forward end of said second slider, so that a first rotation of said tiller in a first direction about a tiller axis drives said first slider toward the cartridge loading end of the disk drive while driving said second slider toward the remote end of the disk drive, and a second rotation of said tiller in a second direction about said tiller axis drives said first slider toward the remote end of the disk drive while driving said second slider toward the cartridge loading end of the disk drive;

a cartridge receiver for receiving a respective cartridge containing the disk, said cartridge receiver being linked to said first and second sliders and tiltably moveable between an upper position and a lower position along a vertical path when said sliders are driven by said tiller;

a cam operatively associated with said tiller for rotating said tiller about said tiller axis so that when said first and second sliders move said cartridge receiver between said upper and lower positions, said cartridge receiver, respective cartridge, and disk move along said vertical path so that the central hub is inclined relative to a spindle magnet for loading and unloading the disk thereon to thereby reduce the force needed to remove the central hub from the spindle magnet while coordinating movement of the bias coil assembly with the disk.

REASONING

"[I]t is quite clear that only claims in the present application recite a cartridge loading apparatus having a bias coil arm including a bias coil assembly and a lever arm engageable with a notch formed in one of the first or second sliders as set forth in claim 1 under appeal. [ ] While the examiner has stated that sub-components, such as the bias coil assembly, door links, cartridge receiver latch, and parking arm, are known in the art per se, the examiner has not produced any evidence that the claimed bias coil arm was so much as known in the art, much less that it would have been obvious to add such a bias coil assembly to the inventor's previously claimed subject matter."