



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

In re Bass

No. 02-1046
Federal Circuit
Dec. 17, 2002

***“A [Notice of
Intent to Issue
Reexamination
Certificate]
does not wrest
jurisdiction
from the PTO
precluding
further review
of the matter.”***

On December 17, 2002, the Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences upholding the patent examiner’s obviousness rejection under 35 U.S.C. § 103 in a reexamination of U.S. Patent No. 4,473,026, which related to a fishing boat. In January 1996, a third party requested the reexamination citing prior art references including Cargile and Lucander. The examiner initially found claims 1-8 of the ’026 patent allowable, and in October of 1996, issued a Notice of Intent to Issue Reexamination Certificate (NIRC). Shortly thereafter, but before the reexamination certificate issued, the same third party requested a second reexamination submitting the same references plus others. The examiner granted the second request for reexamination, stating that Lucander raised a substantial new question as to patentability, and merged the two reexamination proceedings. The Board affirmed the examiner’s rejection finding that Lucander alone taught all of the limitations of claims 1-4.

In *Portola Packaging*, the Federal Circuit held that prior art from a prior proceeding could not raise a substantial new question of patentability. On November 2, 2002, 35 USC § 303(a) was amended by the passage of Pub. L. No. 107-273, § 13105, (116 Stat.) 1758, 1900, to add “[t]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office,” thereby overruling *Portola Packaging*. But because the change only applies to decisions made by the PTO on or after its enactment, this case was not affected. In any event, the Federal Circuit stated:

Bass argues that the PTO was not permitted to consider any of the references discussed in the first reexamination, either in granting the second reexamination or in evaluating the merits of the merged proceeding. . . . Because a NIRC had issued, Bass argues that Lucander was previously considered prior art which the PTO could not reconsider in either the second reexamination or the merged proceeding.

Until a matter has been completed, however, the PTO may reconsider an earlier action. A reexamination is complete upon the statutorily mandated issuance of a reexamination certificate, 35 U.S.C. § 307(a); the NIRC merely notifies the applicant of the PTO’s intent to issue a certificate. A NIRC does not wrest jurisdiction from the PTO precluding further review of the matter. Because no prior completed proceeding had reviewed the Lucander and Cargile references, the PTO was free to reconsider, and ultimately base a rejection upon them.

Bass also disputes the board’s finding that Lucander renders claims 1-4 of the ’026 patent obvious, arguing specifically that Lucander does not disclose a “low profile,” “motorized sports boat” that “had the control console been placed against the bulkhead, the pilot would then be in the cockpit and have limited visibility.” In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification. [S]ubstantial evidence supports the board’s finding that Lucander discloses [each of the claimed limitations].