PRECEDENTIAL OPINION

Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure 2, the opinion below has been designated as precedential opinion. This decision was entered May 3, 1995.

Paper No. 174

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RONALD P. REITZ
Junior Party[1]

v.

AKIO INOUE and YOSHIO SUZUKI
Senior Party[2]

Patent Interference No. 102,644

FINAL HEARING: AUGUST 25, 1994

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[1] Application 07/219,522, filed July 15, 1988. Assignors to The United States of America, as represented by the Secretary of the Navy.

[2] Application 07/209,807, filed June 22, 1988. Accorded the benefit of Japanese Serial No. 159809/1987, filed June 29, 1987, and Japanese Serial No. 329927/1987, filed December 28, 1987. Assignors to Asahi Kasei Kogyo Kabushiki Kaisha.

Before McKELVEY, Chief Administrative Patent Judge, and SOFOCLEOUS and CAROFF, Administrative Patent Judges.

Caroff, Administrative Patent Judge.

FINAL DECISION

This interference originally involved three parties. Judgment has already been issued against one of the junior parties, Troughton et al. (Paper No. 134). Accordingly, the interference now involves an application of the remaining junior party, Reitz, and an application of the senior party, Inoue et al. (Inoue). According to the record before us, the Reitz application is assigned to The United States of America, represented by the Secretary of the Navy; and the Inoue application is assigned to Asahi Kasei Kogyo Kabushiki Kaisha, a corporation of Japan.

The subject matter involved in this interference relates to an electrorheological fluid (also known as an electro-

viscous fluid).[3] The involved subject matter is particularly defined by the sole count in issue. By redeclaration (Paper No. 126), the interference was redefined by substituting the following count for original count 1:

> An electrorheological fluid comprising an electrically non-conductive liquid and dispersed therein, composite particles comprising particles at least whose surfaces are electrically conductive and formed thereon an electrically non-conductive part, wherein said composite particles contain a hollow portion.

The claims of the parties which have been designated as corresponding to this count are:

Reitz: Claims 1-10, 12, 22-23, 25-35

Inoue: Claims 30-41

ISSUES

The following matters were raised in the parties' briefs and, therefore, define the only issues before us for consideration:[4]

I. Reitz motion attacking benefit accorded to Inoue of the filing date of Japanese application 159,809, hereinafter Japan '809 (Motion 4: denied).[5]

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[3] Both parties are in apparent agreement that the terms "electrorheological" and "electroviscous" are interchangeable. Reitz Brief, page 8 (RB-8); Inoue Brief, page 3 (IB-3).

[4] Each of the preliminary motions listed is identified by the numerical designation assigned to it in the Decision on Motions of October 8, 1992 (Paper No. 125), and the disposition of each motion by the Administrative Patent Judge (APJ) is indicated in parentheses.

II. Reitz motion attacking benefit accorded to Inoue of the filing date of Japanese application 329,947, hereinafter Japan '947 (Motion 7: denied).[6]

III. Inoue motion to designate its claims 1-29 and 42-49 as not corresponding to the count (Motion 17: granted).

Both parties have presented an evidentiary record, filed briefs and appeared, through counsel, at final hearing.[7]

No issue of interference-in-fact is before us.

Preliminary Matters

The parties have filed a number of papers (Paper Nos. 160-172) in this interference subsequent to final hearing.

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[5] Although not explicitly stated in the Decision on Motions, it is clear that the APJ considered the foreign priority benefit dates accorded to Inoue as being applicable with respect to substitute count R-1. This follows by implication from the fact that the Reitz motions attacking the benefit dates accorded to Inoue (motions 4 and 7) were considered in the APJ's Decision on Motions after the decision was made (Motion 3: granted) to substitute count R-1 for the original count. Moreover, the Order to Show Cause against Reitz (Paper No. 125) would not have issued unless the benefit accorded to Inoue under 35 U.S.C. § 119 was carried over to the substitute count. No question has been raised in the Reitz Brief as to whether it was proper for the APJ to extend benefit to Inoue with respect to a substitute count in the absence of a motion under § 1.633(j). Accordingly, that question is not before us.

[6] See footnote 5.

[7] The Reitz record, brief and reply brief will hereinafter be respectively referred to as necessary by the abbreviations "RR," "RB," "RRB" followed by an appropriate page number. Simi-lar abbreviations will be used when referring to the record and brief of Inoue (IR, IB).

All of these papers relate, either directly or indirectly, to a question which was not raised in the briefs -- namely, whether it was proper for the APJ to accord benefit to Inoue with respect to a substituted count in the absence of a motion under § 1.633(j). Since this question was not raised in the briefs, the matter has been taken up by the APJ in a separate paper (Paper No. 173).

I. Motion 4 (Benefit as to Japan '809)

The APJ's decision denying Reitz's motion attacking the benefit accorded to Inoue as to Japan '809 is presumed to have been correct and the party questioning that decision, here Reitz, has the burden of showing error or an abuse of discretion. 37 C.F.R. § 1.601(q), § 1.655(a).

We agree with Inoue that Reitz's position does not pass muster. Reitz argues that Inoue is not entitled to the benefit of the filing date of Japan '809 under 35 U.S.C. § 119 because the inventive entity in Japan '809 (Akio Inoue alone) is not the same as in Inoue's corresponding U.S. application (Akio Inoue and Yoshio Suzuki). According to Reitz, the inventive entity must be the same in both the foreign and corresponding U.S. application for Inoue to obtain benefit of the filing date of the earlier-filed foreign application under 35 U.S.C. § 119. In

making this argument, Reitz relies primarily upon Schmitt v. Babcock, 377 F.2d 994, 153 USPQ 719 (CCPA 1967); Olson v. Julia, 209 USPQ 159, 164 (Bd.Pat.Int. 1979); and Irikura v. Petersen, 18 USPQ2d 1362, 1367 (Bd. Pat. App. & Int. 1990). Upon careful perusal of these cases, we find that they are not controlling here.

In Schmitt, the court apparently deferred to the MPEP guidelines extant at the time by referring to them with evident approval. Since those guidelines have subsequently been changed to be consistent with amendments made to the statutory section dealing with joint inventorship (35 U.S.C. § 116), Inoue is correct in stating that Schmitt is outdated. Our approach here is essentially no different than that taken in Schmitt with, of course, some accommodation being made for changes in the law and in current practice regarding inventorship. In Schmitt, the court refers to MPEP § 201.15 which then, as now, essentially required that where the inventive entity differs in the foreign and in the United States application, the examiner should refuse to recognize the priority date until the inconsistency or dis-agreement is resolved. In Schmitt, the court took notice of the conversion in France of the foreign application there involved to joint inventorship status, which was consistent

with the joint inventive entity named in the corresponding U.S. application. Thus, the "disagreement" was resolved. Here, the apparent inconsistency between inventive entities has been satisfactorily resolved/explained by Inoue's reliance upon the amended version of 35 U.S.C. § 116, the corresponding revised MPEP guidelines, and the declarations of Inoue and Suzuki which indicate that Inoue is the sole inventor with respect to subject matter embraced by at least some of Inoue's claims corresponding to the count. Cf. 37 C.F.R. § 1.110. No evidence has been adduced by Reitz that Inoue and Suzuki, or their assignee, did not cause to be filed in Japan a regular application, or that Inoue is not a sole inventor with respect to at least some involved claims. Accordingly, we must conclude that the party Inoue has complied with all of the relevant provisions of 35 U.S.C. § 119 as those provisions have been construed in Schmitt. In effect, the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application as joint inventors wrought by the 1984 amendment of 35 U.S.C. § 116.

Olson and Irikura are inapposite since in both of those cases, unlike the present factual situation, the involved U.S.

application was apparently filed in the name of less than all of the inventors listed on the foreign counterpart application at issue.

Reitz insists that we should refuse to follow the MPEP guidelines since they do not have the force of law. While the MPEP may not have the force of law, or wield as much authority as the rules of practice, its interpretation of the statutes and rules is nevertheless entitled to considerable deference with respect to issues not specifically addressed by the courts. Cf. Morganroth v. Quigg, 885 F.2d 843, 848, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989). We have such an issue here, i.e., interpretation of one statutory provision (35 U.S.C. § 119) in light of changes made in another section of the statute (35 U.S.C. § 116).

We believe the MPEP correctly interprets the current state of the law as follows:

> Joint inventors A and B in an application filed in the United States Patent and Trademark Office may properly claim the benefit of an application filed in a foreign country by A and another application filed in a foreign country by B, i.e., A and B may each claim the benefit of their foreign filed applications [MPEP § 201.13].
>
> Where two or more foreign applications are combined to take advantage of the changes to 35 U.S.C. 103 or 35 U.S.C. 116, benefit as to

> each foreign application may be claimed if each complies with 35 U.S.C. 119 and the U.S. application inventors are the inventors of the subject matter of the foreign applications. For example, if foreign applicant A invents X; and files a foreign application. Applicant B invents Y and files a separate foreign application. A + B combine inventions X + Y and file U.S. application to X + Y and claim 35 U.S.C. 119 benefit for both foreign applications: then 35 U.S.C. 119 benefit will be accorded for each foreign application if 35 U.S.C. 119 requirements are met [MPEP § 605.07].

In our opinion, this is a reasonable and logical interpretation of 35 U.S.C. § 119 in light of the changes to 35 U.S.C. § 116, and is not contrary to law. Any other conclusion would be inconsistent with the spirit and scope of amended section 116 of the statute.

Reitz postulates that had Congress intended to change 35 U.S.C. § 119, it would have done so explicitly when it amended 35 U.S.C. § 116 and 35 U.S.C. § 120. However, we agree with Inoue that the failure of Congress to expressly amend § 119 is not dispositive. Rather, an equally rational explanation is that Congress did not amend § 119 because no amendment was necessary. As we have explained above, section 119, in its present form, permits the result reached here. In contrast, § 116 and § 120 contain more explicit language regarding inventorship than does § 119. Thus, prior to amendment in 1984, § 116 and § 120 clearly

would not permit what is now expressly provided for by broadened statutory language.

Moreover, as noted by Inoue, case law recognizes the parallels between sections 119 and 120. In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989); Kawai v. Metlesics, 480 F.2d 880, 178 USPQ 158, 165 (CCPA 1973). Thus, since 35 U.S.C. § 116 and 35 U.S.C. § 120 now accommodate situations where different claims in an application may have different inventive entities, § 119 can and should be construed to accommodate those situations as well to preserve symmetry of treatment between sections 119 and 120.

For all of the above reasons, we agree with Inoue that Reitz has failed to satisfy his burden of persuasion.

In view of the foregoing, judgment against Reitz is in order since Reitz has alleged no date in his preliminary statement prior to the date of invention accorded to senior party Inoue (the June 29, 1987 filing date of Japan '809). Accordingly, the other issues which have been presented for consideration are moot. Nevertheless, for the sake of completeness we will address all of the issues before us.

II. Motion 7 (Benefit as to Japan '947)

With regard to motion 7, Reitz presented a "best mode" attack on the disclosure in Japan '947. Reitz contends that the

best mode known to Inoue of practicing the invention defined by the present count was not adequately disclosed in Japan '947. Thus, Reitz takes the position that Japan '947 does not qualify as a 35 U.S.C. § 119 benefit application for failure to satisfy the "best mode" requirement of 35 U.S.C. § 112. We cannot subscribe to this position essentially for the reasons presented in the Inoue brief.

With regard to the invention disclosed in Japan '947, Reitz apparently envisions Inoue's best mode as an electroviscous fluid which must include electrically conductive particles having an outer non-conductive coating layer or insulating film with a thickness in the range of 0.1 - 1 um; 0.12 um being the preferred thickness to obtain the best electroviscous effect. Reitz derived this construct from the disclosure in Inoue's involved U.S. application and, particularly, from the corresponding disclosure in Inoue's earlier filed Japanese application -- Japan '809 (Example 6, Table 1). On the other hand, Japan '947 is said by Reitz to specifically disclose only a thickness of 0.3 um for the non-conductive coating layer (Example 2).

While, superficially, the "0.12 um" example of Japan '809 may appear to be a better mode of practicing the invention than the "0.3 um" example of Japan '947 in terms of producing a relatively large electrically-generated shear stress or

electroviscous effect, we agree with Inoue that these examples are not directly comparable. In this regard, Reitz concedes that the "0.12 um" example of Japan '809 directly relates to non-hollow particles; whereas the "0.3 um" example of Japan '947 relates to hollow particles. Also, we note that the respective particles used apparently contain different conductive materials (Japan '809: aluminum particles; Japan '947: glass balloons coated with a nickel layer). Reitz has adduced no evidence that the best mode in terms of non-conductive coating layer thickness would necessarily have been expected to be the same for these different particles. On the other hand, Inoue has presented the declaration of Suzuki who testifies that because the disclosures of Japan '947 and '809 relate to different inventions, he would expect that the best mode of practicing each invention would be different (IR-363). Also, Suzuki notes that the specific insulating layer thickness disclosed in Japan '947 falls squarely within the desired range set forth in Japan '809 and Inoue's involved U.S. application (IR-365). Both Inoue and Suzuki have testified that the best mode known to them at the time Japan '947 was filed of practicing the invention disclosed therein is clearly and unequivocally set forth in the specification of that application (IR-37, 365). This testimony stands unrebutted and, apparently, Reitz did not even request cross-examination (RB-32;

IB-27). Failure to cross-examine, or to rebut, unequivocal testimony raises a strong presumption that the testimony is accurate. McBride v. Acord, 201 USPQ 549 (Bd.Pat.Int. 1977); Cochran v. Kresock, 530 F.2d 385, 188 USPQ 553 (CCPA 1976); Sherman v. Hope, 161 F.2d 263, 73 USPQ 387 (CCPA 1947).

Reitz has his own notion of what the best mode should be relative to Japan '947. However, the appropriate inquiry is directed to what the inventors themselves (Inoue and Suzuki) contemplated as the best mode of carrying out their invention. 35 U.S.C. § 112. In this type of inquiry, mere argument by Reitz is no match for the direct testimony of the inventors. Cf. Heymes v. Takaya, 6 USPQ2d 1448, 1451 (Bd. Pat. App. & Int. 1988). Accordingly, we find that motion 7 was properly denied.

III. Motion 17 (Inoue Claims 1-29 and 42-49)

Reitz would have us conclude that the APJ, in granting motion 17, was improperly operating under the assumption that Reitz, rather than the moving party Inoue, had the burden of persuasion. We find no evidence that the APJ was operating under any misconception regarding the burden of proof. Rather, we find that it is Reitz who has misconstrued the rationale for granting motion 17.

Apparently, there is no dispute that Inoue's involved claims 30-41, as well as Reitz's involved claims and the count, define an invention (electroviscous fluid containing particles which are hollow or have a specific buoyancy) which is separately patentable from that defined by the claims in question (no limitation that particles be hollow or have a specific buoyancy) within the context of 37 C.F.R. § 1.601(n). This being the case, it follows a priori that the claims in question do not define the same patentable invention as those which correspond to the count. Thus, the requirement in 37 C.F.R. § 1.637(c)(4)(ii) is satisfied. To conclude otherwise would be contrary to the commentary on the rules which provides that "the standard of patentability will not be applied 'on a mutual basis'." 49 Fed. Reg. 48,433 (Dec. 12, 1984). Cf. MPEP § 2309.01 (Example 4). Accordingly, we find that motion 17 was properly granted.

With regard to Inoue claims 48-49, we briefly note that they were indicated by the APJ as not corresponding to the count "for the same reasons advanced with respect to parent claim 1," the claim from which they depend. Therefore, we find it unnecessary to decide whether there is yet another basis for designating claims 48-49 as not corresponding to the count.

Judgment

For the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Inoue et al., the senior party.

Accordingly, Akio Inoue and Yoshio Suzuki are entitled to a patent containing claims 30-41 corresponding to the count; whereas Ronald P. Reitz, the junior party, is not entitled to a patent containing claims 1-10, 12, 22, 23 and 25-35 corresponding to the count.

FRED E. McKELVEY)
Chief Administrative Patent Judge)
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) BOARD OF PATENT
MICHAEL SOFOCLEOUS) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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MARC L. CAROFF)
Administrative Patent Judge)