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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 405

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Box Interference

Washington, D.C. 20231

Tel: 703-308-9797

Fax: 703-308-7953

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ROBERT L. BAMBERGER, PAUL M. GERMAN,
GERALD D. MALPASS, Jr., and LAWRENCE K. LOCKE,

Junior Party,

v.

SUBRAHMANYAM CHERUVU, FREDERICK Y. LO
and S. CHRISTINE ONG,

Senior Party.

Patent Interference No. 103,844

Before: STONER, Chief Administrative Patent Judge, and
McKELVEY, Senior Administrative Patent Judge, and
SCHAFER, Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge

MEMORANDUM OPINION AND ORDER

**Cheruvu Motion 10
alleging inequitable conduct by Bamberger**

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A. Cheruvu motion

Cheruvu moves under 37 CFR § 1.635 for judgment in its favor based on alleged inequitable conduct on the part of Bamberger. CHERUVU MOTION 10 (Paper No. 169). Bamberger opposes. BAMBERGER OPPOSITION 10 (Paper No. 176). Cheruvu has filed a reply. CHERUVU REPLY 9 (Paper No. 198).

In a nut shell, Cheruvu alleges that Bamberger, supposedly with intent to deceive the Patent and Trademark Office (PTO), made misrepresentations in an amendment (BX-1003) with respect to certain properties of Resin A and Resin B described in the amendment.

B. Abbreviations

The following abbreviations appear in this opinion.

amendment	Bamberger's AMENDMENT AND REQUEST FOR INTERFERENCE PURSUANT TO 37 C.F.R. § 1.607 filed on May 29, 1996 (BX-1003) in Bamberger application 08/439,637
BR-	Bamberger record
BX-	Bamberger exhibit
DENS	density
MI	melt index
MIR	melt index ratio
ppm	parts per million

C. Findings of fact

Bamberger's amendment

1. On May 29, 1996, Bamberger filed an AMENDMENT AND REQUEST FOR INTERFERENCE PURSUANT TO 37 C.F.R. § 1.607 ("amendment") (BX-1003) presenting Bamberger claims 51-66.

2. The amendment was presented for the purpose of provoking an interference with Cheruvu based on its U.S. Patent 5,420,220.

3. The amendment was accompanied by declarations of:

- a. Dr. Robert L. Bamberger (BX-1000);
- b. Dr. Michael E. Muhle (BX-1001); and
- c. Dr. Gerald D. Malpass, Jr. (BX-1002).

4. The amendment recognizes that the Cheruvu patent claims as-synthesized resins and films made from those as-synthesized resins. The amendment also recognizes that the Cheruvu resins are claimed, inter alia, in terms of their properties, including in some instances:

- a. zirconium content (see, e.g., claim 12);
- b. settled bulk density (see, e.g., claim 22);
and/or
- c. melting point (see, e.g., claim 1).

5. The amendment states that Cheruvu's settled bulk density is "determined by an unspecified procedure" (col. 1, line 35) (BX-1003, page 19, bottom two lines).

6. The amendment acknowledges that the Bamberger application does not describe two properties, settled bulk density and zirconium content (BX-1003, page 30).

7. The Bamberger application, however, describes "Resin A" (page 9, line 27 and page 23, Table I) and "Resin B" (page 10, line 11 and page 24, Table II).

8. The amendment states that (BX-1003, page 30):

a. settled bulk density and zirconium content of Resin A "were measured contemporaneously with the synthesis of Resin A" and

b. "Resin A had a settled bulk density of approximately 26.8 lb/ft³ and a zirconium content of 1.06 ppm.

9. The amendment also states that "[c]ontemporaneous measurements show that *** Resin B has *** a settled bulk density of approximately 26.8 lb/ft³ *** and a zirconium content of approximately 1.6 ppm ***" (BX-1003, page 31).

10. Proof that Resin A and Resin B have melting points within the range of melting points claimed by Cheruvu was based on 1996 tests of 1992 samples of Resin A and Resin B which had been maintained by Exxon (BX-1000, ¶¶ 9 and 10 and attachments P and Q).

11. Since certain of the properties claimed by Cheruvu were not explicitly described in the Bamberger application, as

filed, Bamberger set out to establish that Resin A and Resin B inherently have values which fall within the scope of Cheruvu's properties.

Zirconium content of Resin B

12. Production of a copolymer of ethylene and 1-hexene in a gas phase polymerization process occurred in Exxon Reactor 124 during at least the time period December 20-21, 1992. From time to time during the production, samples of product were collected. The samples were placed in boxes numbered **Box 27**, **Box 28** and **Box 29** (BX-1002, attachment B; BX-1002, ¶ 4).

13. Dr. Muhle was of the opinion that "the continuous gas phase polymerization of ethylene and 1-hexene [to make Resin B] was carried out under substantially lined-out conditions ***" (BX-1001, ¶ 13). In other words, the reactor conditions were essentially "steady-state." According to Dr. Muhle, the "copolymer produced under such conditions is essentially uniform from hour-to-hour, day-to-day ***" (id.).

14. Dr. Muhle's opinion is based on a log of reaction conditions recorded for Exxon Reactor 124 on December 20-21, 1992 (BX-1001, attachment A).

15. Dr. Muhle is qualified to express his opinion and his opinion is credible.

16. Dr. Malpass expressed an opinion that the copolymer made in Exxon Reactor 124 on December 20-21, 1992, was Resin B (BX-1002, ¶ 8).

17. The opinion expressed by Dr. Malpass is well documented in the Muhle and Malpass declarations and attachments thereto (BX-1001 and BX-1002). The opinion expressed by Dr. Malpass is credible.

18. The opinion given by Dr. Malpass is confirmed by certain properties measured from films made from samples collected in **Box 28** and **Box 29**. Those properties (BX-1002, attachment E, Table IX, "sample 008A") are essentially the same as those reported in the Bamberger specification for Resin B (page 24, Table II).

19. A portion of the log of reaction conditions recorded for Exxon Reactor 124 on December 20-21, 1992, is reproduced below (BX-1002, attachment B):

<u>Box</u>	<u>Type</u>	<u>Sample Date & Time</u>	<u>MI</u>	<u>MIR</u>	<u>DENS</u>
26	Prime 1	12/20/92 09:00	0.85	17.71	0.9182
		12/20/92 10:00			
27	Prime 1	12/20/92 11:00			
		12/20/92 12:00	0.86	17.44	0.9185 ¹
		12/20/92 13:00			
		12/20/92 14:00			
		12/20/92 15:00			

¹ One zirconium content determination for Resin B was made from this sample (BX-1001, ¶ 8). Also a melting point determination for Resin B was made from this sample (BX-1000, ¶ 10).

28	Prime 1	12/20/92 16:00 ²			
		12/20/92 17:00	0.92	17.86	0.9181 ³
		12/20/92 18:00			
		12/20/92 19:00			
		12/20/92 20:00			
		12/20/92 21:00	0.91	17.3	0.9178 ⁴
29	Prime 1	12/20/92 22:00	0.91		0.9178
		12/20/92 23:00			
		12/21/92 00:00			
		12/21/92 01:00	0.91	17.04	0.9180 ⁵
		12/21/92 02:00			
		12/21/92 03:00			
30	Prime 1	12/21/92 04:00			
		12/21/92 05:00	0.93	17.29	0.9170
		12/21/92 06:00			
		12/21/92 07:00			
		12/21/92 08:00			
31	Prime 1	12/21/92 09:00	0.83	18.47	0.9164
		12/21/92 10:00			
		12/21/92 11:00			
		12/21/92 12:00			
		12/21/92 13:00	0.87	17.35	0.9170 ⁶
		12/21/92 14:00			
33	Prime 1	12/21/92 15:00			
		12/21/92 16:00			
		12/21/92 17:00	0.92	17.51	0.9174

² Properties for Resin B reported in the Bamberger application are based on measurements of samples from **Box 28** and **Box 29** (BX-1002, ¶¶ 4 through 8).

³ One of three measurements of bulk density for Resin B was made from this sample (BX-1001, ¶ 5).

⁴ One of three measurements of bulk density for Resin B was made from this sample (BX-1001, ¶ 5).

⁵ One of three measurements of bulk density for Resin B was made from this sample (BX-1001, ¶ 5).

⁶ One zirconium content determination for Resin B was made from this sample (BX-1001, ¶ 10).

20. Apparently no collections were made in **Box 32**, because it is not listed, yet the times run consecutively from **Box 31** to **Box 33**.

21. The properties described for Resin B in the Bamberger application are based on measurements made of samples collected in **Box 28** and **Box 29** (BX-1002, ¶¶ 4 through 8).

22. Measurements for zirconium content were made on two samples:

- a. The sample collected in **Box 27** at 12:00 hours on December 20 (BX-1001, ¶ 8), which is identified in the record as sample 37322-04 (BX-1001, ¶ 9): zirconium content 1.60 ppm (BX-1001, attachment I, report dated January 5, 1993).
- b. The sample collected in **Box 31** at 13:00 hours on December 21 (BX-1001, ¶ 10), which is identified in the record as sample 37322-05 (BX-1001, ¶ 11): zirconium content 1.67 ppm (BX-1001, attachment J, report dated January 5, 1993).

Zirconium content of Resin A

23. Production of a copolymer of ethylene and 1-hexene in a gas phase polymerization process occurred in Exxon Reactor

124 during at least the time period December 25-27, 1992. From time to time during the production, samples of product were collected. The samples were placed in boxes numbered **Box 53**, **Box 54**, **Box 55**, **Box 56**, **Box 59**, **Box 63**, **Box 64**, **Box 65** and **Box 66**. No samples were collected on the following dates and times:

- a. December 26 beginning at 13:00 until December 26 ending at 16:00;
- b. December 26 beginning at 23:00 until December 27 ending at 03:00; and
- c. December 27 beginning at 17:00 until December 27 ending at 20:00.

(BX-1002, attachment K; BX-1002, ¶ 14).

24. Dr. Muhle was of the opinion that "the continuous gas phase polymerization of ethylene and 1-hexene [to make Resin A] was carried out under substantially lined-out conditions ***" (BX-1001, ¶ 20). In other words, the reactor conditions were essentially steady-state. According to Dr. Muhle, the "copolymer produced under such conditions is essentially uniform from hour-to-hour, day-to-day ***" (id.).

25. Dr. Muhle's opinion is based on a log of reaction conditions recorded for Exxon Reactor 124 on December 25-27, 1992 (BX-1001, attachment A).

26. Dr. Muhle is qualified to express his opinion and his opinion is credible.

27. Dr. Bamberger expressed an opinion that a sample of a copolymer made in Exxon Reactor 124 on December 25-27, 1992, and designated as "403C", "45 SLP-403" or "045 SLP-403 ("3003")" is Resin A as described in the Bamberger application (BX-1002, ¶ 8).

28. The opinion expressed by Dr. Bamberger is well documented in the Bamberger, Muhle and Malpass declarations and attachments thereto (BX-1000, BX-1001 and BX-1002). The opinion expressed by Dr. Bamberger is credible.

29. The opinion given by Dr. Bamberger is confirmed by certain properties measured from a film made from sample 403C collected in **Box 53** and **Box 54** were determined. Those properties (BX-1000, attachment N, Table I (Sample Directory)) for "Sample No. 045" and Grade (1) "SLP-403 ("3003")" are essentially the same as those reported in the Bamberger specification for Resin A (page 23, Table I).

30. Specifically, the MI (melt index) is 3.2 (in the report) and 3.17 (in the specification); the density is 0.919 (in the report) and 0.9188 (in the specification).

31. A portion of the log of reaction conditions recorded for Exxon Reactor 124 on December 25-27, 1992, are reproduced below:

<u>Box</u>	<u>Type</u>	<u>Sample Date & Time</u>	<u>MI</u>	<u>MIR</u>	<u>DENS</u>
52	Prime 1	12/25/92 13:00	2.72	16.54	0.9146
		12/25/92 14:00			
		12/25/92 15:00			
		12/25/92 16:00			
53	Prime 2	12/25/92 17:00	2.96	15.8	0.9164 ⁷
		12/25/92 18:00			
		12/25/92 19:00			
		12/25/92 20:00			
		12/25/92 21:00	3.07	16.65	0.9169 ⁸
54	Prime 2	12/25/92 22:00			
		12/25/92 23:00			
		12/26/92 00:00			
		12/26/92 01:00	3.05	17.18	0.9164 ⁹
		12/26/92 02:00			
55	Prime 2	12/26/92 03:00			
		12/26/92 04:00			
		12/26/92 05:00	3.03	16.66	0.9164
		12/26/92 06:00			
		12/26/92 07:00			
		12/26/92 08:00			
56	Prime 2	12/26/92 09:00	3.33	16.64	0.9159
		12/26/92 10:00			
		12/26/92 11:00			
		12/26/92 12:00			

No measurements reported for
13:00 through 16:00

59	Prime 2	12/26/92 17:00	2.95	16.91	0.9157
		12/26/92 18:00			
		12/26/92 19:00			
		12/26/92 20:00			

⁷ Properties for Resin A reported in the Bamberger application are based on measurements of granules from **Box 53** and **Box 54** and identified as sample "403C." (BX-1002, ¶¶ 14-16). Also, one of three bulk density determinations was made from granules from **Box 53** and **Box 54** (BX-1001, ¶ 15).

⁸ One of three bulk density determinations was made from granules from **Box 53** and **Box 54** (BX-1001, ¶ 15).

⁹ One of three bulk density determinations was made from granules from **Box 53** and **Box 54** (BX-1001, ¶ 15).

12/26/92 21:00	2.19	16.59	0.9164
12/26/92 22:00			

No measurements reported for
23:00 through 03:00

63	Prime 3	12/27/92 04:00			
		12/27/92 05:00	3.61	16.86	0.9167
		12/27/92 06:00			
		12/27/92 07:00			
		12/27/92 08:00			
64	Prime 3	12/27/92 09:00	4.54	16.58	0.9180 ¹⁰
		12/27/92 10:00			
		12/27/92 10:00			
		12/27/92 12:00			
65	Prime 3	12/27/92 13:00	4.78	16.98	0.9186
		12/27/92 14:00			
		12/27/92 15:00			
		12/27/92 16:00			

No measurements reported for
16:00 through 20:00

66	Prime 2	12/27/92 21:00	3.08	16.59	0.9169
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32. The significance of "Prime 1," "Prime 2," and "Prime 3" was not been explained.

33. The properties described for Resin A in the Bamberger application are based on measurements made of samples collected in **Box 53** and **Box 54** (BX-1002, ¶¶ 14-16).

34. Measurement for zirconium content was made on one sample, i.e., the sample collected in **Box 64** on December 27 at 09:00 hours (BX-1001, ¶ 18). The sample, which is identified

¹⁰ A zirconium content determination for Resin A was made from this sample (BX-1001, ¶ 18). Also a melting point determination for Resin A was made from this sample (BX-1000, ¶ 9).

in the record as 37322-12 (BX-1001, ¶ 19), has a zirconium content 1.06 ppm (BX-1001, attachment L, report dated January 7 presumably of 1993).

Settled bulk density of Resin A and Resin B

35. Based on the log of reaction conditions in Exxon Reactor 124 for December 20/21, 1992, Dr. Muhle was able to determine that the "bulk density" for Resin B was 26.8 lb/ft³. The log establishes the following "bulk densities" for samples taken on the date and at the time indicated (BX-1001, ¶ 5):

12/20/92	17:00	26.78
12/20/92	21:00	26.08
12/21/92	01:00	26.71.

36. Based on the log of reaction conditions in Exxon Reactor 124 for December 25/26, 1992, Dr. Muhle was able to determine that the "bulk density" for Resin A was 26.8 lb/ft³. The log establishes the following "bulk densities" for samples taken on the date and at the time indicated (BX-1001, ¶ 15):

12/25/92	17:00	26.80
12/25/92	21:00	26.89
12/26/92	01:00	26.81.

37. There are at least two kinds of bulk density. One is "poured bulk density" and the other is "settled bulk density."

38. Dr. Muhle explained the difference between "poured bulk density" and "settled bulk density" as follows (BR-4578:18 through 4580:7):

Q. [By Mr. Daniels, counsel for Cheruvu] By the way, what do you mean by bulk density?

A. Bulk density is a term used to describe the mass occupied by a material in a given volume. And there is a definite procedure. There are some procedural issues around that; but normally, we have a procedure that involves having a calibrated volume in a cylinder, and we pour the resin into the cylinder till it comes to a fixed volume height, and then we weigh that cylinder.

Q. Are you aware that there are different kinds of bulk density?

A. Yes, I am.

Q. What are those different kinds?

A. The ones that I am familiar with are what are called the poured bulk density and the settled bulk density.

Q. What does each mean?

A. A poured bulk density refers to the action where you have a -- this cylinder, you put a funnel above the cylinder at a fairly fixed height. And then you take the material, a funnel or a bag, and you pour it into that funnel, so there is no vibration or tapping on

that cylinder. And you weigh the material. The question was directed to pour; is that right?

Q. That's correct. Then you also mentioned settled bulk density?

A. Yes. We don't routinely measure that, but I have experience with it in the past -- in my past career -- and what we were doing there was that people would take an object, like a heavy metal rod or anything, and they would tap the side of the cylinder to give vibration to the cylinder. And then there is a settling of that material. And you pour more material in until you get the effect of the vibrating compaction of the material. So that's what we call normally the settled bulk density.

39. Dr. John K. Beasley, a witness for Bamberger, discussed the relationship between "bulk density" and "settled bulk density" as follows (BR-2871, ¶ 71):

The bulk density for the as-synthesized copolymer measured by Exxon was the "as-poured" bulk density. The Cheruvu claims in interference refer to "settled" bulk density. For the polymers of interest, the "settled" bulk density will always be slightly higher than the "as-poured" bulk density.

Melting points of Resin A and Resin B

40. A sample (37322-12) taken from Exxon Reactor 124 at 09:00 hours on December 27, 1992, was preserved under the supervision of Dr. Muhle (BX-1001, ¶ 21).

41. In 1996, Dr. Bamberger determined the melting point of the sample 37322-12 (Resin A) to be 119^{EC} (BX-1000). The melting point said to have been found by Dr. Bamberger is fully supported by a documented analytical report of melting point determination dated May 22, 1996 (BX-1000, attachment P).

42. A sample (37322-04) taken from Exxon Reactor 124 at 12:00 hours on December 20, 1992, was preserved under the supervision of Dr. Muhle (BX-1001, ¶ 14).

43. In 1996, Dr. Bamberger also determined the melting point of the sample 37322-04 (Resin B) to be 116^{EC} (BX-1000). The melting point said to have been found by Dr. Bamberger is fully supported by a documented analytical report of melting point determination dated May 22, 1996 (BX-1000, attachment Q).

Intent to deceive

44. In presenting its amendment (BX-1003) and accompanying Bamberger, Muhle and Malpass declarations (BX-1000, BX-1001 and BX-1002), Bamberger in no way intended to deceive

officials of the PTO into either finding Bamberger claims 51-66 patentable or declaring the interference.¹¹

D. Discussion

In deciding Cheruvu Motion 10, we emphasize that Cheruvu seeks a declaration that Bamberger engaged in inequitable conduct. Whether Bamberger describes claimed subject matter and/or whether Bamberger's priority proofs are sufficient on the merits are separate matters, both of which are decided applying a preponderance of the evidence standard of proof.

In deciding Cheruvu Motion 10, we have considered only the evidence called to our attention in Cheruvu Motion 10 and Bamberger Opposition 10 opposing Cheruvu Motion 10. To the extent there is other evidence somewhere in the large record of this interference which may support Cheruvu Motion 10, it has not been considered, because it was not called to our attention in Cheruvu Motion 10. The rules require a party to set out the facts upon which a motion is based, as well as a full statement of the reasons for granting a motion. 37 CFR § 1.637(a). In other words, normally we do not undertake to search a record to determine whether there is other evidence which supports or refutes a position or whether there are other arguments which

¹¹ Cheruvu was under a burden to prove intent to deceive by clear and convincing evidence. We find that Cheruvu attempts to prove intent largely through innuendo and attorney argument; Cheruvu has failed to prove intent by any recognized standard of proof.

might have been made. In short, "the *** [board] will not pour over the document[s] to extract the relevant information."

Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997), citing United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991), which notes that judges do not hunt for truffles buried in briefs.

1. The relief sought by Cheruvu

Cheruvu seeks a judgment in its favor. We take this opportunity to discuss why Cheruvu is not entitled to a judgment in its favor even if it had proved its case, which it has not.

Prior to the Patent Law Amendments Act of 1984, Pub. L. 98-633 (1984), the former Board of Patent Interferences could consider priority and any issue which had been determined to be "ancillary" to priority when resolving an interference. 37 CFR § 1.258 (1984). Patentability was not an issue which had been determined to be ancillary to priority. Glass v. DeRoo, 239 F.2d 402, 112 USPQ 62 (CCPA 1956). Inequitable conduct was an issue which had been determined to be "ancillary" to priority. Norton v. Curtiss, 433 F.2d 779, 167 USPQ 532 (CCPA 1970). Thus, inequitable conduct, as well as a host of other issues which had been determined to be ancillary to priority, were considered a basis for "awarding priority" to an opponent.

With passage of the Patent Law Amendments Act of 1984, patentability was made an issue which could be considered in an

interference. Upon passage of the 1984 Act, the PTO and its reviewing courts "will no longer have to decide whether an issue is 'ancillary to priority.'" 103 Cong. Red. H10522, H10528, col. 3 (daily ed.) (Oct. 1, 1984).

New rules were promulgated to implement the Patent Law Amendments Act of 1984. Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416 (Dec. 12, 1984). The new rules authorized a party to file a motion for judgment based on unpatentability of a claim. 37 CFR § 1.633(a)(1985). An object of the new rules, including new Rule 633(a), was to permit a party to raise all issues which previously had been determined to be ancillary to priority, as well as patentability. The comments published with the new rules point out that "[a]ny ground of unpatentability may be made the subject of a motion under § 1.633(a) except: (1) Priority of invention of the subject matter of a count by the moving party as against any opponent or (2) derivation of the subject matter of a count by an opponent from the moving party." 49 Fed. Reg. at 48440 (col. 2). Since a claim would be unpatentable to a party who committed inequitable conduct, a preliminary motion for judgment under Rule 633(a) may be based on inequitable conduct.

Entry of a judgment against an opponent based on a preliminary motion under Rule 633(a), however, does not entitle the party to a judgment on the issue of priority. See, e.g.,

Perkins v. Kwon, 886 F.2d 325, 12 USPQ2d 1308 (Fed. Cir. 1989)

(one party not entitled to a patent because it lost on priority; the party winning on priority not entitled to a patent based on a prior public use/sale).

Hence, the most Cheruvu can achieve by its motion is a judgment against Bamberger. If Cheruvu does not prevail on priority, i.e., it is determined that Bamberger was the first inventor, the Cheruvu claims would still be unpatentable under 35 U.S.C. § 102(g)--whether the priority issue is raised by Bamberger inter partes in the interference, or by some other third party (including the PTO) in another proceeding.

2. Timeliness of Cheruvu's motion

In Cheruvu Motion 10, Cheruvu contends that Bamberger engaged in inequitable conduct based on alleged misrepresentations concerning zirconium content, settled bulk density and melting point.

Upon review of all the evidence called to our attention by Cheruvu Motion 10, it is not remotely apparent to us why Cheruvu did not earlier file Cheruvu Motion 10, at least with respect to its zirconium content and melting point arguments. All the evidence relied upon by Cheruvu was known to Cheruvu upon receipt of the Bamberger application file shortly after declaration of the interference. Bamberger Exhibits 1001 through 1003 form part of the Bamberger application.

We have not found in Cheruvu's Motion 10 any justification for Cheruvu having not presented its motion earlier in this interference. Nor was Cheruvu unaware of the seriousness with which allegations of inequitable conduct are viewed by the board (Paper No. 27, Part IV, beginning on page 10). Likewise, Cheruvu was on actual notice that inequitable conduct is to be raised by a preliminary motion.

The only fact set out in Cheruvu Motion 10 which might not have been available to Cheruvu upon receipt of a copy of the Bamberger application file is the discussion in ¶ 25 of Cheruvu Motion 10 (page 7) concerning settled bulk density. As to zirconium content and melting point, Cheruvu manifestly could have earlier filed a preliminary motion.

An order will be entered dismissing Cheruvu Motion 10 to the extent it bases inequitable conduct on zirconium content or melting point. As to zirconium content and melting point, Cheruvu Motion 10 is belated and no justification for its belatedness has been given. 37 CFR § 1.645(b).

3. Elements of inequitable conduct

A determination of inequitable conduct is committed to our discretion. Critikon, Inc. v. Becton Dickinson Vascular Access, Inc., 120 F.3d 1253, 1255, 43 USPQ 1666, 1668 (Fed. Cir. 1997). In order to convince us to exercise our discretion and hold that

conduct amounts to "inequitable conduct," a party must show that its opponent:

- (1) made an affirmative misrepresentation of fact or failed to disclose a fact;
- (2) the fact misrepresented or not disclosed was material; and
- (3) the misrepresentation or failure to disclose was done with an intent to deceive or mislead the Patent and Trademark Office.

Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178, 33 USPQ2d 1823, 1826 (Fed. Cir. 1995).

The party alleging inequitable conduct on the part of its opponent bears a burden of proving its case by clear and convincing evidence. Refac Int'l, Ltd. v. Lotus Development Corp., 81 F.3d 1576, 1581, 38 USPQ2d 1665, 1669 (Fed. Cir. 1996).

On the merits, Cheruvu's case, to quote Bamberger, "does not get off the ground."

4. Zirconium content

We need not consider Cheruvu's argument with respect to zirconium on its merits, because it was not timely raised. We nevertheless discuss the merits in the event a reviewing court determines that we abused our discretion in holding that Cheruvu's Motion 10 was not timely filed.

Assuming arguendo that Cheruvu Motion 10 were not dismissed as to zirconium content for being belated, it nevertheless fails on its merits.

All the information relating to the zirconium content of Resin A and Resin B was submitted with Bamberger's amendment.

With respect to Resin B, Bamberger told the PTO that:

- (1) measurement of properties of Resin B, as reported in the Bamberger specification, was based on samples collected in **Box 28** and **Box 29**;
- (2) a sample from **Box 27** (12/20/92 12:00 hours) was measured for zirconium content;
- (3) a sample from **Box 31** (12/21/972 13:00 hours) was measured for zirconium content;
- (4) the continuous gas phase polymerization of ethylene and 1-hexene was carried out under substantially lined-out conditions, i.e., polymerization conditions were essentially steady-state.

With respect to Resin A, Bamberger told the PTO that:

- (a) measurement of properties of Resin A, as reported in the Bamberger specification, was based on samples collected in **Box 53** and **Box 54**;

- (b) a sample from **Box 64** (12/27/92 09:00 hours) was measured for zirconium content; and
- (c) the continuous gas phase polymerization of ethylene and 1-hexene was carried out under substantially lined-out conditions, i.e., polymerization conditions were essentially steady-state.

We have to ask Cheruvu the following questions with respect to the zirconium content issues raised in Cheruvu Motion 10. What was withheld? What was misrepresented? Where is there any (and we emphasize any) intent to mislead the PTO? The answers are plain: nothing, nothing and none.

The principal argument (Cheruvu Motion 10, pages 11-12) by Cheruvu is that the zirconium content determinations were not "[c]ontemporaneous measurements" as represented by Bamberger (BX-1003, page 31). Cheruvu reasons that the zirconium content measurements were not of Resin A and Resin B. Cheruvu utterly failed in its motion to recognize and/or discuss the fact that Bamberger told the PTO precisely when a sample was taken on which zirconium content measurements were made. Cheruvu simply ignored the discussion in the Bamberger declarations that the reaction

was running essentially in steady state conditions.¹²

"Contemporaneously" means occurring during the same time. The samples on which zirconium contents were measured were made during a continuous steady-state run in Exxon Reactor 124.

Cheruvu's motion might make interesting commentary on the sufficiency of the evidence with respect to priority where Bamberger has the burden of proof. Here, Cheruvu seems to overlook the fact that it has the burden of proof by clear and convincing evidence.

5. Melting point

We need not consider Cheruvu's argument with respect to melting point on its merits, because it was belatedly filed. We nevertheless discuss the merits in the event a reviewing court determines that we abused our discretion in holding that Cheruvu's Motion 10 was timely filed.

Assuming arguendo that Cheruvu Motion 10 were not dismissed as to melting point for being belated, it nevertheless fails on its merits.

All the information relating to the melting points of Resin A and Resin B was submitted with Bamberger's amendment.

¹² Cheruvu belatedly attempts to deal with the steady state issue in a "reply brief" (Cheruvu Reply 9) by referring to evidence that was in its possession when Cheruvu Motion 10 was filed. We deal with the reply later in this opinion.

With respect to Resin B, Bamberger told the PTO that:

- (1) a sample of Resin B was preserved in 1992 and
- (2) a melting point of the sample was later determined in 1996 to be 119°C.

With respect to Resin A, Bamberger told the PTO that:

- (a) a sample of Resin A was preserved in 1992 and
- (3) a melting point of the sample was later determined in 1996 to be 116°C.

Cheruvu has failed to demonstrate, although there was ample opportunity to do so in this interference, that the 1996 date on which the melting point was measured had any effect whatsoever on the melting point determination.

As in the case of zirconium content, Cheruvu's motion might make interesting commentary on the sufficiency of the evidence with respect to priority where Bamberger has the burden of proof. Here, Cheruvu again seems to overlook the fact that it has the burden of proof by clear and convincing evidence with respect to the melting point issue.

6. Settled bulk density

Arguably Cheruvu discovered for the first time in these proceedings during cross-examination of Dr. Muhle that the "bulk density" values reported in the various Bamberger declarations were "poured bulk density." The Bamberger, Muhle and Malpass

declarations do not mention or refer to "settled bulk density." Rather, they mention to "bulk density."

In the amendment, counsel for Bamberger does refer to "settled bulk density" (BX-1003, page 31). Counsel's reference to "settled bulk density" in the amendment was an error. Cheruvu has failed to prove by clear and convincing evidence that the error is in any respect material or that the "error" is a misrepresentation made with intent to deceive the PTO.

Dr. Beasley tells us that "settled bulk density" is always a little higher than "poured bulk density." Cheruvu did not call as a witness any individual to establish that the use of the language "[c]ontemporaneous measurements" in the Bamberger amendment was an error made with the intent to deceive. Cheruvu could have determined through discovery, but did not determine, who wrote the amendment. Cheruvu could have called, but did not call, the individual who wrote the amendment. Cheruvu had every opportunity to establish intent, but did not do so. Rather, Cheruvu elected to rely on innuendo and speculation.

An order will be entered denying Cheruvu Motion 10 on its "merits" with respect to "settled bulk density."

7. Cheruvu Motion 10 is frivolous

Cheruvu Motion 10 is found to be frivolous for several and independent reasons.

There was no legitimate basis upon which Cheruvu could have maintained that the motion was timely filed as to zirconium content and melting point.

There was no legitimate basis upon which Cheruvu could have shown by clear and convincing evidence that Bamberger misstated any material fact with respect to zirconium content and/or melting point.

Most important, there was no legitimate basis upon which Cheruvu could have shown by clear and convincing evidence that Bamberger intended to mislead the PTO in any way in submitting the amendment and accompanying declarations of Bamberger, Muhle and/or Malpass.

8. Other Cheruvu arguments

We find at least one argument by Cheruvu to be particularly non-persuasive. Cheruvu argues that Exxon Reactor 124 was not operated under steady-state conditions. Bamberger's declarations state that the conditions in Exxon Reactor 124 during relevant time periods demonstrate steady state operation. There was no cross-examination, or if there was, it was not called to our attention. The response (Cheruvu Motion 10, page 15, first full paragraph) is attorney argument, based on data, i.e., "numbers," in the declarations and documents attached thereto. We have no quarrel with an attorney referring to data and "numbers" in an opponent's evidence. However, we decline to review the "numbers"

in a light most favorable to counsel for Cheruvu, and based on a review of those numbers, conclude that Dr. Muhle does not know what he is talking about when he determined that steady-state conditions existed in Exxon Reactor 124. Attorney argument cannot take the place of evidence, particularly where Cheruvu could have cross-examined, but elected not to cross-examine, Dr. Muhle on the numbers. Cheruvu could have asked Dr. Muhle to "square" the numbers with his opinion.¹³ On the facts before us, we decline to accord counsel's assessment of the "numbers" more weight than the credible opinion of those "numbers" by Bamberger's declarants.

In a paragraph bridging pages 15 and 16 of Cheruvu Motion 10, it is alleged that certain requests for documents were made to Bamberger, but that those requests were said to have been repeatedly "rebuffed by counsel for Bamberger" (page 16). See also page 4. But, counsel for Cheruvu knows how to make a request under 37 CFR § 1.687(b), and if the request is denied, how to file a motion for additional discovery under 37 CFR § 1.687(c). Counsel, apparently as part of its litigation strategy, elected not to file a motion for additional discovery. Having failed to do so, Cheruvu should not now burden the board

¹³ There may be other evidence relating to priority issues which might be argued to undermine Dr. Muhle's steady-state findings. If there is, that cross-examination was not called to our attention in connection with Cheruvu Motion 10.

with arguments that counsel for Bamberger failed to produce allegedly "relevant" documents.

Curiously, and ultimately, we find out in Cheruvu Reply 9 that, as a result of discovery in Mobil v. Exxon before the Eastern District of Virginia, Cheruvu already had the documents it had supposedly repeated requested from Bamberger (Cheruvu Reply, page 10). Having belatedly discovered the documents, Cheruvu proceeded to file Cheruvu Exhibits 151 and 152, along with Cheruvu Reply 9, leaving Bamberger no opportunity to respond. According to Cheruvu, those documents show that certain zirconium content measurements made of copolymers prepared in Exxon reaction 123 somehow are faulty. Because we do not consider the reply (see the next section in this opinion), we decline to consider Cheruvu Exhibits 151 and 152, which we hold to be inadmissible as belatedly filed. Even if we were inclined to consider Cheruvu's argument and exhibits on their merits, Cheruvu's argument fails. There is absolutely no evidence in the record that the copolymers made in Exxon Reactor 123, and which are said to have zirconium contents of 3.67 ppm and 3.71 ppm, have anything to do with Resin A and/or Resin B. Moreover, Cheruvu's opportunity to prove relevance has come and gone. Cheruvu simply failed to take timely advantage during the testimony period of available discovery under 37 CFR § 1.687.

9. Cheruvu Reply 9

An order entered June 19, 1997 (Paper No. 27) states the following (pages 8-9):

FURTHER ORDERED, as provided by the rules, no new issues are to be raised in replies (the best way to convince *** [the board] that a new issue is not being raised in a reply is to say: "On page x of the opposition, it is said (or argued) that _____. The answer (or response) is _____." There is no need to "restate" the background. A reply which is longer than a motion or an opposition probably raises new issues).

Unfortunately, Cheruvu generally, if not totally, ignored the order. Cheruvu Reply 9 in certain respects is particularly egregious.

First, the reply reargues the argument presented in the motion. Compare, e.g., (1) the paragraph which begins on the last line of page 3 of the reply with (2) the paragraph which begins the last paragraph on page 9 of the motion (including the quotes contained within those paragraphs). Hence, it is difficult to cull out any legitimate reply arguments in Cheruvu Reply 9.

Second, the reply argues that there are differences between Cheruvu's resins and Bamberger's resins. The motion was not a

motion for judgment based on no interference-in-fact. It was a motion charging Bamberger with inequitable conduct.

Third, Cheruvu addresses in the reply a point which manifestly should have been addressed in the motion in the first instance. There is a section in the reply styled "The Generally Constant Polymerization Conditions" (page 8). It refers to certain polymerizations said to have been carried out in July of 1989. According to Cheruvu, variations in properties measured of copolymer samples obtained during polymerizations in July of 1989 somehow demonstrate that the polymerizations in December of 1992 in Exxon Reactor 124 were not under steady state. This argument is manifestly belated. Bamberger's declarations make plain Bamberger's position on steady-state conditions in Exxon Reactor 124 in December of 1992. The time to have attacked Bamberger's steady state position was in the motion. Nor can Cheruvu claim the argument was not recognized. See the first full paragraph on page 15 of the motion. Bamberger had no opportunity to respond to Cheruvu's belatedly raised non-steady state argument based on runs which occurred in July of 1989.

Fourth, whether Mr. Vispi R. Sagar had anything to do with Resin A and/or Resin B (reply, page 13) is absolutely irrelevant to any inequitable conduct issue raised by Cheruvu.

Based on the analysis of the reply, one might think that we have considered on their merits the arguments made in Cheruvu

Reply 9. We have not. We have simply analyzed the reply to demonstrate that it is not a reply. Furthermore, we decline to separate what might be legitimate reply from non-legitimate reply.

The reply is manifestly an improper reply and we decline to consider the arguments made therein on the merits.

E. Final observation

We close this chapter of the interference with the following observation. In interference cases the charge of inequitable conduct is appearing with more frequency. The following observation of the Federal Circuit with respect to inequitable conduct in court litigation applies with equal force to administrative litigation in interferences before this board:

[T]he habit of charging inequitable conduct in almost every major patent case has become an absolute plague. Reputable lawyers seem to feel compelled to make the charge *** on the slenderest grounds, to represent their client's interests adequately, perhaps. They get anywhere with the accusation in but a small percentage of the cases, but such charges are not inconsequential on that account. They destroy the respect for one another's integrity ***. A patent litigant should be made to feel, therefore, that an unsupported charge of "inequitable conduct in the Patent Office" is a

negative contribution to the rightful administration of justice. The charge was formerly known as "fraud on the Patent Office," a more pejorative term, but the change of name does not make the thing itself smell any sweeter. Even after complete testimony the court should find inequitable conduct only if shown by clear and convincing evidence.

Burlington Industries Inc. v. Dayco Corp., 849 F.2d 1418, 1422, 7 USPQ2d 1158, 1161 (Fed. Cir. 1988).

F. Order

Upon consideration of Cheruvu Motion 10, and for the reasons given, it is

ORDERED that, as to any argument with respect to zirconium content and/or melting point, the motion is dismissed.

FURTHER ORDERED that even if any argument with respect to zirconium content and/or melting point was timely filed, the motion with respect to zirconium content and melting point is denied.

FURTHER ORDERED that the motion is otherwise denied.

FURTHER ORDERED that Cheruvu Reply 9 is deemed to be an improper reply and is not entitled to consideration on its merits.

BRUCE H. STONER, Jr., Chief)
Administrative Patent Judge)

FRED E. McKELVEY, Senior)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

RICHARD E. SCHAFER)
Administrative Patent Judge)