INTERFERENCE TRIAL SECTION PRECEDENTIAL OPINION

The opinion in support of the decision being entered today is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise not binding precedent. The decision was entered on 10 February 1999.

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Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

J.L.G.,

Junior Party
(Application XX/XXX,XXX),

v.

D.P.F.,

Senior Party
(Patent Y,YYY,YYY).

Interference No. 103,618

Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE, and TORCZON, Administrative Patent Judges.

PER CURIUM.

DECISION UNDER 37 CFR § 1.640

INTRODUCTION

Junior party has filed a preliminary motion under 37 CFR § 1.633(g) (Paper No. 13) in response to an ORDER TO SHOW CAUSE under 37 CFR § 1.617(a) (Paper No. 2).

FINDINGS OF FACT

1. In declaring this interference, the junior party was accorded a benefit filing date in 1988. (Paper No. 1, Att. at 1.)

2. The senior party was accorded a benefit filing date in 1987 based on the following chain of filings:

Application	**filed**	**continuation**	**status**
'EEE	1991	of 'DDD	issued in 1992 as the 'XXX patent
'DDD	1990	of 'CCC	now abandoned
'CCC	1989	in part of 'BBB	now abandoned
'BBB	1988	in part of 'AAA	now abandoned
'AAA	1987	none	now abandoned

(Paper No. 1, Att. at 2.)

3. The senior party's status as senior party can be based on the earlier filing date of either the 'BBB application or the 'AAA application.

4. Based on perceived defects in the junior party's statement under 37 CFR § 1.608(b), an ORDER TO SHOW CAUSE issued pursuant to 37 CFR § 1.617. (Paper No. 2.)

5. The ORDER TO SHOW CAUSE expressly noted that a preliminary motion under subsection 1.633(g) may be filed in response to an order under section 1.617. (Paper No. 2 at 3 n.3.)

6. The junior party responded to the ORDER TO SHOW CAUSE by filing a preliminary motion under 37 CFR § 1.633(g). (Paper No. 13.) The preliminary motion sought to deny benefit to the senior party of the 'AAA and 'BBB applications.

7. Dates were set for filing an opposition to the preliminary motion and for replying to the opposition. (Paper No. 16.)

8. The senior party's opposition focussed on the deficiencies of the junior party's evidence under 37 CFR § 1.608(b) as set out in the ORDER TO SHOW CAUSE. The opposition did not challenge the merits of the preliminary motion, but instead attacked it as irrelevant to the merits of the ORDER TO SHOW CAUSE. (Paper No. 17.)

9. The sole count comprises the senior party's claim 1 and the junior party's claims 27 and 34; all stated in the alternative.

10. All three claims in the count require a specific component to be "dispersed substantially uniformly throughout" a specific composition.

11. In the 'BBB application, the examiner rejected claim 1 under 35 U.S.C. § 112[1] for lack of supporting written description for the "substantially uniformly" element of that claim. ('BBB Final Rej. at 2-3.)

12. The senior party filed the 'CCC continuation-in-part (CIP) application and abandoned the 'BBB application without traversing the rejection.

13. The 'CCC CIP application added matter to the specification to support*in hæc verba* the "substantially uniformly" element of claim 1.

DISCUSSION

1. Subsection 1.617(b) permits a party under a section 1.617 order to show cause to file as part of its response a preliminary motion under subsection 1.633(g).

2. Subsection 1.633(g) provides for a preliminary "motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier filed application."

3. Section 1.608 applies when an involved application's effective filing date is later than an involved patent's filing date.

4. A successful motion attacking the senior party's benefit dates that are before the junior party's filing date would obviate the need for a statement under section 1.608.

5. A movant under subsection 1.633(g) bears the burden of establishing by a preponderance of evidence why another party is not entitled to the accorded benefit of the filing date of an

earlier filed application. Kubota v. Shibuya, 999 F.2d 517, 519 n.2 & text, 27 USPQ2d 1418, 1420 n.2 & text (Fed. Cir. 1993); 37 CFR § 1.637(g).

6. The senior party was obliged to oppose the motion if the senior party desired to contest the preliminary motion on its merits. Although the senior party's silence with respect to the merits of junior party's preliminary motion deprives us of the senior party's views on the issue, the burden of proof remains with the movant and no unfavorable inference will be drawn from the senior party's silence.

7. Fact findings 9-13 establish that the senior party added matter supporting a limitation in the count after the junior party's accorded benefit date in response to a rejection under section 112[1] for lack of written descriptive support.

8. The junior party argues (Paper No. 13 at 7) that

> the filing a CIP application subsequent to an Examiner's rejection that (1) the claims lack support, and (2) amendments to the specification constitute new matter, is *prima facie* acquiescence to the rejection. *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573, 222 U.S.P.Q. 833 (Fed. Cir. 1984). See also *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 U.S.P.Q. 97 (Fed. Cir. 1984).

9. We agree with the junior party that under Federal Circuit precedent, the filing of a CIP application to overcome a rejection creates a rebuttable presumption that the rejection was proper. Pennwalt Corp. v. Akzona, Inc., 740 F.2d 1573, 1578, 222

USPQ 833, 836 (Fed. Cir. 1984) (affirming a denial of benefit); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1438-40, 221 USPQ 97, 106-07 (Fed. Cir. 1984) (estopping the patentee from retroactively challenging the new matter finding).

10. In accordance with Pennwalt Corp., the facts of this case establish a rebuttable presumption that the senior party's disclosures prior to the 'CCC CIP do not support all of the limitations in the count.

11. The senior party has offered no rebuttal.

12. We hold that on the facts of record, the senior party is not entitled to be accorded the benefit of any application before its 'CCC CIP application.

13. In view of our disposition of the junior party's motion, the order to show cause is now moot.

ORDER

Upon consideration of the record of this interference, it is

ORDERED that the junior party's preliminary motion under 37 CFR § 1.633(g) is granted;

FURTHER ORDERED that the senior party is no longer accorded the benefit of its 'CCC application;

FURTHER ORDERED that the order of the parties is changed as follows:

D.P.F.,

Junior Party,

v.

J.L.G.,

Senior Party;

FURTHER ORDERED that the ORDER TO SHOW CAUSE (Paper No. 2) is vacated as moot; and

FURTHER ORDERED that this opinion shall be published without identifying the parties or their counsel.

FRED E. McKELVEY, Senior
Administrative Patent Judge

RICHARD E. SCHAFER
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

JAMESON LEE
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

10 February 1999