

The opinion in support of the decision being entered today is binding precedent of the Trial Section

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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ROBERT F. LEVEEN,  
Junior Party,  
(Application 08/559,072),

v.

STUART D. EDWARDS, RONALD G. LAX  
and HUGH SHARKEY,  
Senior Party,  
(Patent 5,536,267).

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Patent Interference 104,290

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Before: McKELVEY, Senior Administrative Patent Judge and  
SCHAFFER, LEE, TORCZON, GARDNER-LANE and MEDLEYAdministrative  
Patent Judges.<sup>1</sup>

PER CURIAM.

**MEMORANDUM OPINION and ORDER**  
**(Decision on Edwards preliminary motion 2)**

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<sup>1</sup> The panel was expanded after oral argument before a three-judge panel. Cf. Kingsdown Med. Consultants, Ltd. v. Hollister, Inc. 863 F.2d 867, 876 n.16, 9 USPQ2d 1384, 1392 n.16 (Fed. Cir. 1988) (in banc consideration of a single section of opinion); see also In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (change in panel composition after oral argument not error).

## **A. Introduction**

Edwards preliminary motion 2 seeks entry of judgment against LeVeen claims 43 and 44. According to Edwards, LeVeen claims are

(1) anticipated under 35 U.S.C. § 102(e) by Edwards '267 (U.S. Patent 5,536,267 (Ex 5004)) or

(2) unpatentable under 35 U.S.C. § 103 over Edwards '267 in view of Ende (U.S. Patent 1,814,791 (Ex 5002)) and/or McFadden (U.S. Patent 1,943,547 (Ex 5003)).

For reasons hereinafter given, on the issue of anticipation based on Edwards '267, the preliminary motion is deferred and will be decided simultaneously with a decision on the issue of priority. The preliminary motion is otherwise dismissed.

## **B. Opinion<sup>2</sup>**

### 1.

In support of its preliminary motion, Edwards has attempted to "place in evidence" Ex 5005--a copy of the file history of Edwards "parent" application 08/148,439 ('439 application). Insofar as we can tell, Ex 5005 was "placed in evidence" only to establish the filing date of the '439 application; the file history is not otherwise discussed in Edwards preliminary motion 2 or declarations improperly incorporated by reference therein.

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<sup>2</sup> The facts, as necessary, are set out in the opinion portion of the MEMORANDUM OPINION and ORDER. All facts are supported by a preponderance of the admissible evidence.

Exercising our discretion on the issue of the admissibility of evidence, we admit Ex 5005 in evidence only to the extent that it was offered to prove that the filing date of the '439 application is November 8, 1993. Ex 5005 otherwise is not admitted in evidence. Apart from establishing the filing date of the '439 application, the remaining portions of the file history have not been shown to have any probative value. In addition, there is a danger of unfair prejudice to LeVeen should Edwards later in the interference attempt to rely on portions of the file history which have not explicitly been mentioned in connection with Edwards preliminary motion 2. Fed. R. Evid. 403.

2.

Edwards fails to clearly or fairly place on the record its position as to the "prior art" filing date of Edwards '267, the patent upon which it relies for its anticipation.

On its face, the application which matured into Edwards '267 is a "continuation-in-part" of the '439 application (Ex 5004, col. 1, lines 6-7). A patent may be prior art as of a filing date of a "parent" application. 35 U.S.C. §§ 102(e) and 120; In re Wertheim, 646 F.2d 527, 209 USPQ 554 (CCPA 1981) (U.S. Patent prior art as of its filing date, unless parent application describes claimed invention as required by § 112; invention claimed in reference patent that does not find supporting

disclosure in compliance with § 112, as required by § 120, in parent application, cannot be regarded as prior art as of the filing date of that parent application).

Whether subject matter claimed in a patent is described in a parent application is a question of fact. In re Alton, 76 F.3d 1168, 1171, 37 USPQ2d 1578, 1580 (Fed. Cir. 1996). Insofar as we can tell, Edwards preliminary motion 2 does not attempt to establish, as a matter of fact, that the subject matter claimed in Edwards '267 is described in '439 application. Edwards has failed to establish, as was its burden, that Edwards '267 should be considered prior art vis-a-vis LeVeen claims 43 and 44 as of the November 8, 1993, filing date of the '439 application. Accordingly, the anticipation issue will be restricted to determining whether LeVeen claims 43 and 44 are anticipated by Edwards '267. Since the filing date of the application which matured into Edwards '267 is August 12, 1994 and LeVeen's earliest possible effective filing date is March 24, 1995, Edwards '267 is prior art vis-a-vis LeVeen under 35 U.S.C. § 102(e).

3.

Edwards preliminary motion 2 suffers from several of the same procedural defects as Edwards preliminary motion 1. Edwards preliminary motion 1 has been dismissed in a MEMORANDUM OPINION

and ORDER (Paper 240) entered concurrently herewith. Edwards preliminary motion 2 is likewise dismissed, essentially for the same reasons except for the issue of anticipation based on Edwards '267, which is prior art as of August 12, 1994.

Given our disposition of Edwards preliminary motion 1, a reader might wonder why Edwards preliminary motion 2 likewise is not being dismissed in its entirety. At oral argument, counsel for LeVeen told us that LeVeen does not contest Edwards' position that the claims are "anticipated." LeVeen opposition 2 (Paper 96) confirms, at least with respect to LeVeen claim 43, that LeVeen concedes anticipation if Edwards '267 is prior art.

LeVeen maintains, however, that Edwards' 267 is not prior art because in its preliminary statement LeVeen "has asserted an actual reduction to practice of [the subject matter of] claims 43 and 44 prior to the filing date of Edwards '267 \*\*\*." There was no similar LeVeen concession with respect to Edwards preliminary motion 1. In fact, at oral argument, counsel for LeVeen argued that Edwards preliminary motion 1 did not make out prima facie case of anticipation or obviousness. A controlling difference between Edwards preliminary motions 1 and 2 is that LeVeen concedes a prima facie case of anticipation with respect to at least LeVeen claim 43 and may be conceding anticipation of LeVeen claim 44. LeVeen opposition 2, however, argues that LeVeen can antedate Edwards '267. Accordingly, we exercise our discretion

to consider Edwards preliminary motion 2, but only to the extent it raises anticipation based on Edwards '267.

4.

What evidence does LeVeen present to antedate Edwards '267? Based on our review of LeVeen opposition 2, it is apparent that LeVeen is basing its antedating "effort" on allegations in its preliminary statement--a document which alleges (i.e., pleads) an actual reduction to practice prior to the filing date of Edwards' '267.

Edwards responds by pointing out that a preliminary statement cannot be used as evidence by the party filing the statement. Rule 629(e) [37 CFR § 1.629(e)] supports Edwards' response. Based on a lack of evidence, Edwards maintains that it is entitled to prevail. In addition, relying on a notice<sup>3</sup> published in the Official Gazette, Edwards maintains that LeVeen cannot use the preliminary statement as a "pleading" upon which to urge that the issues raised by Edwards preliminary motion 2 should be deferred until priority evidence has been presented.

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<sup>3</sup> Notice of the Chairman of the Board of Patent Appeals and Interferences, Interferences--Preliminary Motions for Judgment 1118 Off. Gaz. Pat. & Tm. Office 19-20 (Sep. 11, 1990).

5.

History will show that preliminary statements have been used in interference cases as a basis for deferring to the priority stage of the interference issues associated with alleged unpatentability over the prior art.

a.

Forsyth v. Richards 1905 Dec. Comm'r Pat. 115 (Comm'r. Pat. 1905), reveals that a party could rely on its preliminary statement in opposing what was then called a motion to dissolve based on unpatentability over prior art. Forsyth was decided before patentability based on prior art could be an issue in interference cases. Glass v. DeRoo, 239 F.2d 402, 112 USPQ 62 (CCPA 1956) (only priority and issues ancillary to priority could be considered in an interference; patentability over prior art not ancillary to priority).

The rules applicable to (1) the Forsyth interference and (2) interferences up through the end of 1984 (37 CFR 1.201 et seq. (1984)), authorized a motion to "dissolve" based on a party applicant's claims allegedly being unpatentable over the prior art. 37 CFR § 1.231(a)(1) (1984). The motion was considered by the examiner, not the board. If the motion was denied, the interference proceeded to priority. If the motion was granted, the interference was "dissolved" (i.e., terminated without a

judgment on the merits) and the applicant returned tex parte prosecution where the examiner would enter a rejection based on the examiner (not the board) having granted the motion to dissolve. If as a result of ex parte prosecution, including any appeals, the applicant ultimately succeeded in having the claim held patentable, the interference would be reinstated or a second interference might be declared.

If an opponent defended against a party's motion to dissolve based on a § 102(a) or § 102(e) reference by calling attention to an earlier date of invention alleged in a preliminary statement, the motion would be "dismissed" and the case proceeded to the priority phase. See, e.g., Simons v. Dunlop, 103 USPQ 237 (Comm'r Pat. 1949). At the time of Simons, motions to dissolve were heard by the primary examiner. An examiner of interferences would review the motions and determine whether they were procedurally proper to be transmitted to the examiner for hearing. In Simons, the Commissioner held that the examiner of interferences did not err in refusing to transmit a motion to dissolve to the examiner for hearing.

The practical result of the Forsyth and Simons practice was that if the opponent lost on priority, the unpatentability issue became moot. On the other hand, if the opponent prevailed on priority, the patentability issue could be considered by the



examiner after the interference had been concluded<sup>4</sup>.

Alternatively, the board might have made a recommendation to the Commissioner under 37 CFR § 1.259 (1984). Cf. Bloom v. Furczyk, 144 USPQ 678 (Bd. Pat. Int. 1955).

b.

In 1984, Congress amended 35 U.S.C. § 135(a) and provided that patentability may be an issue in interferences. The amendment, in effect, legislatively rendered Class v. DeRoo inapplicable.

Under the "new" rules<sup>5</sup> implementing the congressional change, a party was authorized to file a preliminary motion<sup>6</sup> for judgment. 37 CFR § 1.633(a) (1985). If properly presented in accordance with 37 CFR § 1.637(a) (1985), any patentability issue raised in the preliminary motion was decided by the board in the

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<sup>4</sup> It should be noted that prevailing on priority does not necessarily mean that a party antedates a § 102(a) or § 102(e) reference. See Goutzoulis v. Athale, 15 USPQ2d 1461, 1462 (Comm'r Pat. 1990), and in re Moore, 444 F.2d 572, 578-79, 170 USPQ 260, 266 (CCPA 1971) and in re Eickmeyer, 602 F.2d 974, 978-79, 202 USPQ 655, 660 (CCPA 1979), cited therein. There is a fundamental difference between (1) establishing priority--which defeats the opponent's right to a patent--and (2) antedating--which establishes a party's right to a patent notwithstanding the existence of facially relevant prior art. Accordingly, the requirements for establishing priority and antedating are different, albeit in a particular case the same evidence may serve both to establish priority and to antedate.

<sup>5</sup> Notice of Final Rule, Patent Interference Practice 49 Fed. Reg. 48416 (Dec. 12, 1984).

<sup>6</sup> What were formerly known as "motions" under 37 CFR § 1.231 (1984), are now referred to as "preliminary motions", 37 CFR § 1.633(a) (2000). There are three kinds of motions which may be filed in an interference: (1) preliminary motions under 37 CFR § 1.633(a), (2) motions to correct inventorship under 37 CFR § 1.634 and (3) all other motions, which are known as "miscellaneous motions" under 37 CFR § 1.635.

interference.<sup>7</sup> Thus, there was no longer a need to transmit motions to the primary examiner.

The new rules, however, did not say what the effect of filing a preliminary motion would be on the moving party where the prior art appeared to be applicable to the moving party as well as the opponent. See 37 CFR § 1.637(a). Nor did the new rules say what effect, if any, would be given to preliminary statements in the face of a Rule 633(a) preliminary motion for judgment based on a § 102(a) or § 102(e) reference.

c.

There came a time when the Commissioner had an opportunity to consider the effect of a preliminary statement vis-a-vis a preliminary motion for judgment under 37 CFR § 1.633(a).

In Goutzoulis v. Athale 15 USPQ2d 1461, 1463 (Comm'r Pat. 1990), it was determined that in cases where the preliminary statement alleges a date of invention prior to the date of a § 102(a) or § 102(e) reference, a Rule 633(a) preliminary motion for judgment should be deferred to the priority phase. During the priority phase, a determination could be made as to whether

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<sup>7</sup> Unlike the rules in effect prior to 1984, the new rules do not contemplate entry of an order "dissolving" an interference. See Parks v. Fine, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985) amended on reconsideration, 783 F.2d 1036, 228 USPQ 677 (Fed. Cir. 1986). Instead, an interference is ordinarily terminated (1) by entry of a judgment on the merits or (2) for lack of jurisdiction.

an opponent had established a date of invention prior to any non-statutory bar reference.

d.

Shortly after Goutzoulis, the Chairman of the Board of Patent Appeals and Interferences issued the notice (n.2<sup>supra</sup>) relied upon by Edwards.

For the most part, the notice attempted to tackle the problem of what to do when the prior art relied upon by a party to attack the patentability of its opponent's claims also was prior art to the moving party. An elaborate procedure is set out in the notice for dealing with such a situation.

The notice (1118 Off. Gaz. Pat. & Tm. Office at 20 n.1) suggests that a preliminary statement might not be considered when a preliminary motion for judgment under 37 CFR § 1.633(a) is filed. Based on the footnote, Edwards argues that LeVeen cannot rely on its preliminary statement.

e.

Subsequent events have overtaken the Chairman's notice.

The new rules were amended in 1995<sup>8</sup>.

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<sup>8</sup> Notice of Final Rule, Patent Appeal and Interference Practice 60 Fed. Reg. 14488 (Mar. 17, 1995).

Rule 633(a) was amended to state that when alleging unpatentability, a party had to address each of its opponent's claims individually. 37 CFR § 1.633(a) (1995).

Rule 637(a) was amended to state that when a party files a preliminary motion for judgment based on prior art facially applicable to the party, the party is obligated to state why the grounds of unpatentability does not apply to the party. 37 CFR § 1.637(a) (1995). In addition, Rule 640(b) was amended to provide that unless a decision on a preliminary motion would materially advance an interference, decisions on preliminary motions were to be deferred to final hearing. 37 CFR § 1.640(b) (1995). In large measure, the 1995 amendments to the new rules overtook the practice set out in the Chairman's notice. We cannot recall a single Trial Section interference in which the Chairman's notice has been applied.

For the reasons given, Edwards' reliance on the Chairman's notice is misplaced.

f.

With the experience of prior practice as a guide, how should preliminary statement "defenses" to preliminary motions alleging unpatentability over § 102(a) or § 102(e) prior art be handled?

The use of preliminary statements as a "defense" to a preliminary motion for judgment is not specifically covered by

the rules. Accordingly, pursuant to 37 CFR § 1.610(e), the Trial Section adopts the following practice. When (1) a preliminary motion for judgment under 37 CFR § 1.633(a) against an opponent relies on a § 102(a) or § 102(e) reference and (2) the opponent alleges in its preliminary statement a date of invention prior to the prior art dates of the reference, the opponent will be given two choices.<sup>9</sup>

A first choice will be for the opponent to call attention to its preliminary statement and ask that a decision on the preliminary motion be deferred to the priority phase of the interference. In effect, LeVeen has asked for this choice in its opposition in this interference.

A second choice is for the opponent to present proofs under 37 CFR § 1.131 together with its opposition.

Each choice has advantages and disadvantages. An advantage of the first choice may be that the antedating and priority efforts may be put on at the same time.

A disadvantage of the first choice may be that evidence of priority may end up inadmissible if the count is changed as a result of an opponent's inability to antedate. To be fully appreciated, the disadvantage requires further discussion and is

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<sup>9</sup> There may be other choices which might make sense in a particular case. We leave for another day any other choices and suggest that if there are other choices that the parties discuss those choices in inter partes conference call with the APJ designated to handle the interference.

best discussed by reference to a hypothetical case. Suppose moving senior Party A claims a process which uses a temperature in the range of 20-75°C and that opponent junior Party B claims the same process using a temperature in the range of 40-100°C. Party B also has a claim reciting a range of 40-50°C. The count would recite a temperature range of 20-100°C. Party A relies on a reference which is not prior art to Party A, but is prior art under § 102(a) to Party B, and describes the same process operating at a temperature of 95°C. To antedate, Party B would be required to comply with Rule 131 and the precedent applicable thereto.<sup>10</sup> Suppose Party B attempts to antedate by relying on an actual reduction to practice of a method using a temperature of 82°C, which is not within the scope of Party B's narrow claim calling for a temperature range of 40-80°C. Further suppose that Party B's proofs are not sufficient under Rule 131, but would have been sufficient for priority. The difficulty will be that Party B's broad claim calling for a range of 40-100°C becomes unpatentable and the count will have to be narrowed to cover a

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<sup>10</sup> See, e.g., (1) In re Stempel, 241 F.2d 755, 760, 113 USPQ 77, 81 (CCPA 1957) (to antedate, applicant need show in Rule 131 affidavit only so much of the claimed invention as the references disclose); (2) In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965), (3) In re Hostettler, 356 F.2d 562, 148 USPQ 514 (CCPA 1966), (4) In re Clarke, 356 F.2d 987, 148 USPQ 665 (CCPA 1966), (5) In re Rainer, 390 F.2d 771, 156 USPQ 334 (CCPA 1968), (6) In re Stryker, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971), (7) In re Plumb, 470 F.2d 1403, 175 USPQ 323 (CCPA 1973), (8) In re Spiller, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974) and (9) In re Schaub, 537 F.2d 509, 190 USPQ 324 (CCPA 1976).

range of 20-80°C.<sup>11</sup> Under these circumstances, proofs at a temperature of 80°C are not admissible on the issue of priority because they would not fall within the scope of the count. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000) (to establish an actual reduction to practice for the purpose of priority, it must be established that (1) the party constructed an embodiment or performed a process that met every element of the count and (2) the embodiment or process operated for its intended purpose).

An advantage of the second choice may be that Rule 131 showings do not need corroboration. In this respect, a showing under Rule 131 may be viewed as easier than a showing for priority. Moreover, proof under Rule 131 in a particular case may minimize the need to reveal to the moving party proprietary material, such as material in laboratory notebooks.<sup>12</sup>

A disadvantage of the second choice may be that the opponent may have to put on an antedating case followed by a priority case and the evidence may be similar, albeit not identical.

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<sup>11</sup> The scope of the count would be changed from (1) a range of 20-~~100~~ (the combined scope of the temperature ranges of both Party A and Party B) to (2) a range of 20-80°C (the combined scope of the 20-70°C range patentable to Party A and the 40-80°C range patentable to Party B).

<sup>12</sup> The Trial Section recently had a case where a party relied on a specification which had been circulated to inventors for signature (conception) coupled with diligence to the filing of an application. No proprietary information was revealed to the opponent because the opponent already had access to the party's application. All evidence was presented through the testimony of the attorney.

There may be other advantages and disadvantages for both the first and second choices. Our decision leaves to the opponent to sort out the advantages and disadvantages in a particular case and for the opponent to make an election. If the opponent elects to present a Rule 131 showing, and it is not successful, its claims may be held to be unpatentable and any necessary adjustment to the count will be made. Whether the opponent with no patentable claims should then be allowed to put on a priority case to defeat the moving party, and what the count should be for that purpose, are matters which we leave for another day. Cf. Perkins v. Kwon, 886 F.2d 325, 12 USPQ2d 1308 (Fed. Cir. 1989).

### **C. Decision**

Edwards preliminary motion 2 will be deferred to final hearing only to the extent that it maintains that LeVeen claims 43 and 44 are anticipated by Edwards '267 based on its filing date of November 8, 1993. The preliminary motion is otherwise dismissed as being procedurally improper for the reasons given in connection with our decision on Edwards preliminary motion 1. The preliminary motion does not fairly place before LeVeen or the board any issue under 35 U.S.C. § 103 or any issue of anticipation based on any filing date of the '439 application.

During the priority testimony phase, LeVeen should make out its antedating and priority cases.



**D. Order**

Upon consideration of Edwards preliminary motion 2, and for the reasons given, it is

ORDERED that Edwards Exhibit 5005 has been admitted in evidence only to the extent that it is offered to prove that the filing date of application 08/148,439 is November 8, 1993.

FURTHER ORDERED that Edwards preliminary motion 2 is deferred to the priority phase of the interference, but only to the extent that it maintains that LeVeen claims 43 and 44 are anticipated by Edwards '267 based on its filing date of November 8, 1993.

FURTHER ORDERED that the preliminary motion is otherwise dismissed.

FURTHER ORDERED that this MEMORANDUM OPINION and ORDER shall be published.

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FRED E. McKELVEY, Senior )  
Administrative Patent Judge )  
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