

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 129

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EDWARD C. CHENEVEY and EDWARD R. KAFCHINSKI
Junior Party¹

v.

DIRK M. BAARS, DONALD D. BRETCHES, ROBERT B. DAVIS,
ANDREW C. HARVEY and RICHARD W. LUSIGNEA
Senior Party²

Patent Interference No. 103,169

Before CALVERT, DOWNEY and ELLIS, Administrative Patent Judges.³

DOWNEY, Administrative Patent Judge.

¹ Patent No. 4,898,924, issued February 6, 1990, Serial No. 07/295,689, filed January 11, 1989. Assigned to Hoechst Celanese Corporation.

² Application 07/615,988, filed November 20, 1990. Assigned to Foster-Miller, Inc., and Albany International Research Company. Accorded benefit of Serial Nos. 07/098,710, filed September 21, 1987, now Patent No. 4,973,442, issued November 27, 1990; 06/780,648, filed September 26, 1985, now abandoned.

³ APJ Calvert has been substituted for APJ Caroff, who is presently unavailable. In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

FINAL DECISION

This interference concerns a process for preparing a biaxially oriented film of a rigid rod heterocyclic liquid crystalline polymer. The subject matter at issue is defined by a single count which is identical to claim 1 of the Chenevey et al. patent.

The count reads as follows:

Count 1

A process for preparing a biaxially oriented film of a rigid rod heterocyclic liquid crystalline polymer, comprising:

- (i) providing a dope from a polymerization mixture of a rigid rod heterocyclic liquid crystalline polymer and a solvent;
- (ii) extruding the dope to form a film;
- (iii) imparting biaxial orientation to the film to increase the transverse strength thereof;
- (iv) solidifying the biaxially oriented film; and
- (v) washing the solidified film to remove the solvent.

Chenevey et al. patent claims 1-26 and Baars et al. claims 23-45 correspond to the count.

Upon declaration of the interference, Baars et al. was accorded benefit of their two earlier filed U.S. applications, by virtue of which, Baars et al. was declared senior party in this proceeding.

During the preliminary motion stage of this proceeding, Baars et al. filed a motion

for judgment that Chenevey et al. claims 1-26 were unpatentable under 35 U.S.C. § 102(e) and/or 35 U.S.C. § 103 over Harvey, U.S. Patent No. 4,939,235. Chenevey et al. did not argue the merits of the motion and the APJ, in charge of the interference, granted the motion for judgment, yet permitted Chenevey et al. to take testimony to antedate the reference (Paper No. 14).

The following issues⁴ are before us:

- (A) Does the Chenevey et al. record establish derivation on the part of Baars et al. and, if so, is derivation defeated by an earlier conception by Baars et al.
- (B) Does the Chenevey et al. record establish a reduction to practice of the subject matter of the count.
- (C) If the answer to (B) is yes, did Chenevey et al. abandon, suppress or conceal the invention.
- (D) Does the Chenevey et al. record effectively remove the Harvey patent as a reference against the Chenevey et al. claims.

Additionally, the following matters have been raised:

⁴ The Chenevey et al. brief does not set forth a statement of issues for decision in the interference. 37 C.F.R. § 1.656(b)(2) (1994). In order to not further delay a decision in this interference, we have considered the issues of reduction to practice, derivation and conception.

(E) Baars et al. belated motion filed pursuant to 37 C.F.R. §§ 1.633(a) and 1.635 for judgment that Chenevey et al. claims corresponding to the count and the subject matter of the count are unpatentable under 35 U.S.C. § 112, first paragraph, enablement requirement (Paper No. 83). The motion stands opposed (Paper No. 87).

(F) Baars et al. second belated motion pursuant to 37 C.F.R. §§ 1.633(a) and 1.635 for judgment that Chenevey et al. claims are unpatentable for inequitable conduct during the prosecution of their application and during the interference (Paper No. 84). The motion stands opposed (Paper No. 88).

(G) Baars et al. third belated motion pursuant to 37 C.F.R. §§ 1.635 and 1.655(c) for judgment that Chenevey et al. claims corresponding to the count and the subject matter of the count are unpatentable under 35 U.S.C. § 112, first paragraph, enablement requirement (Paper No. 91). The motion stands opposed and a reply was filed (Paper Nos. 99 and 103, respectively).

(H) Baars et al. fourth belated motion pursuant to 37 C.F.R. §§ 1.635 and 1.655(c) for judgment that Chenevey et al. claims are unpatentable for inequitable conduct during the prosecution of their application and during the interference (Paper No. 93). The motion stands opposed and a reply was filed (Paper Nos. 100 and 102, respectively).

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(l) Baars et al. motion to suppress Chenevey et al. Exhibits 5-13, 15, 16, 18, 19, 20, 23, 24-28, 30(a), 31, 32, 33, and 37-42 and the related testimony corresponding to these exhibits (Paper No. 110). The motion stands opposed and a reply was filed (Paper Nos. 114 and 112, respectively).

The following issues have not been raised by the parties in their briefs:

- (1) a question of separate patentability of any claim(s); and
- (2) the Chenevey et al. motion pursuant to 37 C.F.R. §§ 1.635 and 1.628 to amend their preliminary statement (Paper No. 62).⁵

We note that Chenevey et al. raise an additional issue in their brief (page 23); that is, that Baars et al. are not entitled to a patent because Baars et al. did not invent the subject matter of the count. We give no consideration to this issue. Chenevey et al. did not raise this issue by motion and, thus, it cannot be raised at final hearing. See 37 C.F.R. § 1.655.

Both parties filed briefs and appeared through counsel at final hearing. The Chenevey et al. record consists of the testimony of the Chenevey et al. inventors, Edward Chenevey and Edward Kafchinski; the Baars et al. inventors, Dirk Baars and Richard Lusignea; and corroborators, Guy Berry, a consultant for Foster-Miller(FM),

⁵ Matters not raised in the brief are ordinarily regarded as abandoned. Photis v. Lunkenheimer, 225 USPQ 948, 950 (Bd. Pat. App. & Int. 1984).

Celanese and the Air Force; Dana Eagles, an employee of Albany International Research Corp.(AIRC); and Eui Won Choe, Joseph Leal, Ashley Sabin, and Williams Timmons, employees or former employees of Celanese; and accompanying exhibits, 1-50, A-G, IIII, JJJJ, KKKK and LLLL (Exhibits G, IIII-LLLL while contained in the Chenevey et al. record are labeled Baars et al. Exhibit G, IIII-LLLL. and will be referred to as Baars et al. exhibits in this decision). The Baars et al. record consists of the testimony of inventors Robert Davis and Richard Lusignea and corroborators Pamela Aist, Dana Eagles, and William Smith, employees of AIRC; Adi Guzdar, an employee of FM, and accompanying exhibits, H-Z, AA-ZZ, AAA-ZZZ, AAAA-HHHH and 35 (Exhibit 35, while contained in the Baars et al. record, is labeled Chenevey et al. Exhibit 35 and will be referred herein as CX 35).⁶ Both parties took cross-examination of the witnesses.

I.

Additional Matters

Baars et al. belated motions for judgment

ITEMS E and F

On September 28, 1994, Baars et al. filed two belated motions for judgment, (E) and (F). The motions, while titled?Motion for judgment under §§ 1.633(a) and 1.635....,”

⁶ Baars et al. brief, record and exhibits will be identified as BB, BR and BX, followed by the appropriate page or number. Similarly, Chenevey et al. brief, reply brief, record and exhibits will be identified as CB, CRB, CR and CX.

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did not include either a motion⁷ which shows good cause why the paper was not timely filed or a certificate of conferral.⁸ Chenevey et al. countered that the motion failed to comply with the rules and was untimely, having been filed nine months after the close of the Chenevey et al. testimony period on December 10, 1993.

The first and second belated motions are dismissed since the motions fail to comply with the rules, 37 C.F.R. § §1.635, 1.645(b) and 1.637(b).

ITEMS G and H

In response to the Chenevey et al. argument that the Baars et al. motions (ITEMS E and F) were untimely and failed to comply with the rules, Baars et al. filed a third and fourth belated motion for judgment (ITEMS G and H) entitled "Motions for Judgment under 37 C.F.R. § §1.635 and 1.655(c)... ." These motions supplement the original motions in that they each contain reasons to excuse the belatedness, a certificate of conferral, and a request that the motions be entertained to prevent manifest injustice [in 1995, the rule was amended to refer to "the interest of justice" pursuant to 37 C.F.R. § 1.655(c)].

⁷ 37 C.F.R. § 1.645(b) states in part: "Any paper belatedly filed will not be considered except upon motion (§1.635) which shows good cause why the paper was not timely filed" (1995).

⁸ 37 C.F.R. § 1.637(b) states in part "... a motion under § 1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all opponents in an effort in good faith to resolve by agreement the issues raised by the motion."

Baars et al. allege that the procedure for filing a motion for judgment under the present circumstances, where the evidence came to light during the Chenevey et al. testimony period, is not spelled out in the rules or M.P.E.P. Baars et al. allege that they contacted an unidentified representative at the Board and that they were informed that the motion should be filed with their brief. Sometime later, Baars et al. contacted the APJ handling this interference and learned that the motion should have been filed as soon as the evidence became available. Baars et al. contend that the motions are not untimely and not prejudicial to Chenevey et al. because the motions were filed as soon as they learned the correct procedure. We disagree. 37 C.F.R. § 1.655(b)(3) (1995), precludes a party from raising a patentability issue at final hearing unless the party shows good cause why the issue was not timely raised by motion or opposition. A motion pursuant to 37 C.F.R. § 1.633(a) is "properly filed" if it is filed within the preliminary motion period or after the expiration of the preliminary motion period, provided it is accompanied by a 37 C.F.R. § 1.645(b) showing of good cause for the belatedness. The "good cause" requirement is satisfied by showing that the motion was filed as soon as possible after the evidence was discovered. Maier v. Hanawa, 26 USPQ2d 1606, 1610 (Comm'r Pat. 1992); Magdo v. Kooi, 699 F.2d 1325, 1329-31, 216 USPQ 1033, 1037-38 (Fed. Cir. 1983). See also the Chairman's Notice titled, "Interference Practice: Matters Relating to Belated Preliminary Motions," 1144 O.G. 8 (November 3, 1992).

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Baars et al. contend that the Board should excuse the tardiness of their motions because they didn't know the appropriate procedure to follow in filing a belated motion for judgment. The motion to excuse is denied. The rule is clear that any motion filed pursuant to 37 C.F.R. § 1.635 requires the filing of a certificate of conferral. Baars et al. offer no excuse with respect to the failure of filing such certificate with their first and second motions. Hence, motions E and F were manifestly insufficient and motions G and H, as supplements to E and F, are inappropriate. Motions should not be offered in piecemeal fashion. Bayles v. Elbe, 6 USPQ2d 1389, 1391 (Bd. Pat. App. & Int. 1990). A delay in filing a motion cannot be excused on the plea that the moving party or attorney was not sufficiently familiar with interference procedure. Rivise & Caesar, Interference Law and Practice, Vol. II. § 271, pp. 1095-1097 (Michie Co. 1940). If a late motion is filed, it has always been clear that the showing of good cause for late filing should be brought with diligence, i.e., as soon as possible after the discovery of the evidence. Id., § 267, pp. 1080-1085; see also "Interference Practice: Matters Relating to Belated Preliminary Motions," supra. Counsel's non-awareness of PTO rules does not constitute an "unavoidable" delay. Kellenberger v. Duenk, 18 USPQ2d 1573, 1575 (Comm'r Pats. & Trademarks 1991), or "good cause," Huston v. Ladner, 973 F.2d 1564, 1566, 23 USPQ2d 1910, 1912 (Fed. Cir. 1992), citing Hahn v. Wong, 892 F.2d 1028, 1034, 13 USPQ2d 1313, 1316 (Fed. Cir. 1989).

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Baars et al. request that the Board entertain the merits of motions G and H under the interest of justice provision of 37 C.F.R. § 1.655(c) if the motion to excuse is denied. 37 C.F.R. § 1.655(c) states that “the Board may exercise its discretion to consider an issue even though it would not otherwise be entitled to consideration... .”

In this instance, we decline to exercise our discretion. The discretionary action of the Board is used for the most extraordinary of circumstances, Kwon v. Perkins, 6 USPQ2d 1747, 1756 (Bd. Pat. App. & Int. 1988) aff’d, Perkins v. Kwon, 886 F.2d 325, 328, 12 USPQ2d 1308, 1311 (Fed. Cir. 1989). It is not an avenue of relief for a party’s failure to know interference procedure or law.

Baars et al. motion to suppress

ITEM I

In their motion, Baars et al. ask that Chenevey et al. Exhibits 5-13, 15, 16, 18-20, 23, 24-28, 30(a), 31-33, and 37-42 and the related testimony corresponding to the exhibits be suppressed.

At the hearing, Baars et al. renewed the motion to suppress Exhibits 18-20, 26-28, 30a, 31-33, 37-42. Accordingly, the motion to suppress with respect to Exhibits 5-13, 15, 16, 23, 24-25 is dismissed as moot. In addition, the motion to suppress Exhibits 15, 16 and 24 is dismissed because Chenevey et al. did not rely upon these exhibits in their brief.

At the hearing, the Board requested that Baars et al. submit a paper setting forth

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the following information (1) where in the Chenevey et al. brief, Chenevey et al. relied upon the exhibits now subject to the Baars et al. motion to suppress, (2) where in the Baars et al. record, Baars et al. placed an objection and (3) what that objection was. Baars et al. filed a paper (Paper No. 124) indicating that of the Exhibits subject to the motion to suppress, Chenevey et al. relied upon Exhibits 18-20, 26-28, 30(a), 32-33, and 37-39 in his brief. The motion to suppress Exhibits 40-42 is dismissed as moot in view of the fact that Chenevey et al. did not rely upon these exhibits in their brief. Photis, 225 USPQ at 950. Baars et al. submit that Chenevey et al. did not rely upon exhibit 31 in their brief, we note however a reference to Exhibit 21(CB 10). The substance of the discussion at page 10 indicates that Exhibit 21 is a typographical error and should read Exhibit 31.

This leaves for our consideration the motion to suppress as to Exhibits 18-20, 26-28, 30a, 31-33 and 37-39.

As to Exhibits 37-39, Baars et al. move to suppress these exhibits because Chenevey et al. failed to comply with 37 C.F.R. § 1.673, which requires a party to serve an opponent with a copy of any evidence prior to the deposition testimony. Chenevey et al. were on notice to comply with 37 C.F.R. § 1.673(c)(2) and acknowledged the same. See Paper No. 22, pages 2-3. Chenevey et al. did not comply with the rule or file a §1.635 motion to have the evidence considered. Further, Chenevey et al. acknowledge that Exhibits 37-39 are merely cumulative to evidence of record and

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need not be relied upon to prove any fact of consequence to this proceeding.” We find that Chenevey et al. improperly introduced these exhibits in rebuttal, failed to comply with § 1.673, and failed to timely file a §1.635 motion for consideration of these exhibits. For the foregoing reasons, the motion to suppress Exhibits 37-39 and related testimony is granted.

As to the remaining Exhibits 18-20, 26-28, 30a, 31-33, Baars et al. request suppression for a number of reasons: hearsay, not a business record, document tampering, untrustworthiness and that the original document (video tape (30a)) was never produced. To the extent that Baars et al. timely and properly objected to the exhibits on the ground of hearsay, the exhibits will be admitted merely to show that the statement was made, but not for the truth of its contents. Reports of scientific research and tests by the inventor(s) are not business records; they are no more than the inventor’s work or progress reports and as such are self-serving documentation. Alpert v. Slatin, 305 F.2d 891, 895, 134 USPQ 296, 300 (CCPA 1962). All of the above mentioned exhibits and other exhibits of record identified only by coinventors Chenevey or Kafchinski are entitled to no weight since they have not been authenticated as to date or content by evidence independent of the inventor. Reese v. Hurst, 661 F.2d 1222, 1233, 211 USPQ 936, 947 (CCPA 1981).

II.

Background

Poly(p-phenylenebenzobisthiazole) (PBT, also known as PBZT) is a rigid-rod liquid crystalline polymer. PBT has been formed into fibers by a wet-spinning process from PBT/poly(phosphoric acid)(PPA) dopes, i.e., the PBT polymerization medium (See BX IIII). PBT has a tendency when formed into a film to form a highly aligned or uniaxially oriented structure resulting in increased strength in the direction of extrusion, and a tendency to fibrillate (or to form fibers) when subjected to even the smallest forces transverse to the direction of orientation (CB, page 4).

In December of 1982, the Air Force Wright Patterson Material Labs (AFWP/ML, also referred to herein as AF) issued an announcement [PRDA 83-3-PMRR] (PRDA) seeking technical and cost proposals for an exploratory development program to develop methods of processing PBT into biaxially oriented films having high strength and high modulus (CX D). The proposals were due January 14, 1983. Id. The date was later extended to January 31, 1983. Both Chenevey et al. and Baars et al. submitted proposals. Both were awarded contracts by the Air Force and filed patent applications based on their respective work.⁹

⁹ The parties were questioned at the hearing as to whether this was an adversarial proceeding in light of the fact that both parties carried out their work under contract to the Air Force. The parties were requested to file a paper setting forth what interest the Air
(continued...)

III.

The Count

There appears to be a controversy between the parties regarding the expression “imparting biaxial orientation” in the count (see step (iii)). Baars et al. argue that Chenevey et al. never conceived of, or reduced to practice, a film having balanced biaxial orientation as required by the Air Force contract. Chenevey et al. contend that the count does not require balanced biaxial properties.

Absent any ambiguity, counts are to be given the broadest reasonable interpretation which they can reasonably support. Lamont v. Berquer, 7 USPQ2d 1580, 1582 (Bd. Pat. App. & Int. 1988); Fontijn v. Okamoto, 518 F.2d 610, 618, 186 USPQ 97, 104 (CCPA 1975). See also DeGeorge v. Bernier, 768 F.2d 1318, 1321, 226 USPQ 758, 760-61 (Fed. Cir. 1985). We have reviewed the count and find that the language of the count is not ambiguous.

⁹(...continued)

Force has in each of the applications. In response to the Board’s request, Chenevey et al. filed a 37 C.F.R. § 1.602(b) notice indicating that the Air Force has an interest in U.S. Patent 4,898,924, the involved Chenevey et al. patent (Paper No. 123); and Baars et al. filed a statement indicating that the “...Government shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any Subject Invention through the world...” in the Baars et al. application (Paper No. 124, page 2, referencing Small Business SBIR Contract No. F 33615-83-C5120 (BX S)). Since the parties’ involved cases are not assigned to the Air Force, there is no basis for termination under § 1.602(a).

The count, step (iii), states “imparting biaxial orientation to the film to increase the transverse strength thereof.” Contrary to the Baars et al. argument, we agree with Chenevey et al. that the count does not require any specific degree of biaxial orientation; only an amount necessary to increase the transverse strength. Therefore, giving the count its broadest reasonable interpretation, the phrase, “imparting biaxial orientation” requires a showing of some orientation in two axes to increase the transverse strength.

IV.

Dates

Chenevey et al. stipulated that Baars et al. reduced to practice the subject matter of the count no later than June 30, 1984 (BR12: 1129-1130). Accordingly, Chenevey et al., in order to prevail, must establish (1) derivation¹⁰ or (2) reduction to practice before June 30, 1984. If Chenevey et al. establishes an earlier reduction to practice, Baars et al. has raised the issue of abandonment, suppression or concealment.

The Chenevey et al. preliminary statement alleges a conception date of January 23, 1983, a communication date of June, 1984, and a reduction to practice date of October 3, 1983 (Paper No. 8).

¹⁰ Derivation and priority are distinct concepts. Derivation addresses originality, i.e., determining who invented the subject matter, while priority focuses on which party first invented the subject matter of the count. Bosies v. Benedict, 27 F.3d 539, 541-542, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994).

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37 C.F.R. § 1.629(b) indicates that evidence which shows that an act alleged in the preliminary statement occurred prior to the date alleged in the statement shall establish only that the act occurred as early as the date alleged in the statement. Accordingly, the earliest dates that Chenevey et al. could possibly establish are January 23, 1983, for conception and October 3, 1983, for reduction to practice.

V.

Burden of Proof

It is well settled that where an interference is between a patent that issued on an application that was copending with an interfering application, the applicable standard of proof is preponderance of the evidence. Bosies v. Benedict, 27 F.3d at 541-542, 30 USPQ2d at 1864; see also Peeler v. Miller, 535 F.2d 647, 651 n.5, 190 USPQ 117, 120 n.5 (CCPA 1976); Linkow v. Linkow, 517 F.2d 1370, 1373, 186 USPQ 223, 225 (CCPA 1975); Frilette v. Kimberlin, 412 F.2d 1390, 1391, 162 USPQ 148, 149 (CCPA 1969), cert. denied, 396 U.S. 1002(1970). See also 37 C.F.R. § 1.657(b)(1995).¹¹ Herein, Chenevey et al., as the junior party, bears the burden of proof.

VI.

¹¹ 37 C.F.R. § 1.657(b), as now amended[1995], states that: “[I]n an interference involving copending applications or involving a patent and an application having an effective filing date on or before the date the patent issued, a junior party shall have the burden of establishing priority by a preponderance of the evidence.”

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Derivation

On this record, we find that Chenevey et al. have failed to meet their burden of proof on the derivation issue.

In order to establish derivation, Chenevey et al. must establish conception of the invention and then communication of the conception of the invention to Baars et al. prior to conception by Baars et al. In re Whittle, 454 F.2d 1193, 1196, 172 USPQ 535, 537 (CCPA 1972); Davis v. Reddy, 620 F.2d 885, 888, 205 USPQ 1065, 1069 (CCPA 1980); Shumaker v. Paulson, 136 F.2d 700, 703, 58 USPQ 279, 282 (CCPA 1943).

Conception is a question of law. Kridl v. McCormick, 105 F.3d 1446, 1449, 41 USPQ2d 1686, 1688-1689 (Fed. Cir. 1997); Bosies v. Benedict, 27 F.3d at 542, 30 USPQ2d at 1864; Fiers v. Revel, 984 F.2d 1164, 1168-1169, 25 USPQ2d 1601, 1604 (Fed. Cir. 1993). Conception is defined as the formation "in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1376, 231 USPQ 81, 87-88 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987) (citing Robinson on Patents 532 (1890) and Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985)). By this definition, conception consists of two parts, the idea and the means to carry out the idea. Conception must include every feature or limitation in the count, and every limitation must have been known to the inventor at the time of the alleged conception. Coleman, 754 F.2d at 359, 224 USPQ at 862.

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Conception of an inventive process involves proof of mental possession of the steps of an operative process and, if necessary, of a means to carry it out to such a degree that nothing remains but routine skill for effectuation thereof. Alpert v. Slatin, 305 F.2d at 894, 134 USPQ at 299. Since conception takes place in the mind of the inventor, additionally there must be disclosure to and corroboration by a third party, for it is well settled that an inventor's testimony standing alone, is insufficient to prove conception. Price v. Symsek, 988 F.2d 1187, 1193-1194, 26 USPQ2d 1031, 1036 (Fed. Cir. 1993). In evaluating whether there is conception, a rule of reason is applied; the rule does not, however, dispense with the requirement of providing some evidence of independent corroboration. Coleman, 754 F.2d at 360, 224 USPQ at 862. The conception analysis necessarily turns on the inventor's ability to describe his invention with particularity. Burroughs Wellcome Co. v. Barr Laboratories, Inc., 40 F.3d 1223, 1227-1228, 32 USPQ 2d 1915, 1919 (Fed. Cir. 1994).

Chenevey et al. case for conception

For conception, Chenevey et al. state in their brief:

A full description of Chenevey's conception of the invention was reduced to writing, as a proposal in response to the PRDA, by no later than January 23, 1983. This written proposal specified each step of the process stated in the Count, and focused on imparting biaxial orientation by conical mandrel expansion (which Chenevey et al. had already successfully performed), and by blown film expansion of film extruded from an annular die, as disclosed in both specifications at issue here. Most importantly, Chenevey Exhibit 1 (page 9) specifies "film" that is "formed directly from the PPA polymerization solution" (mixture) has been "demonstrated" to be "equivalent or superior" to

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film formed with

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"redissolved" polymer (CB, paragraph bridging pages 9-10);

and

...the events at Celanese show that Chenevey had a clear conception of the Count by at least about January, 1983 when its proposal to the Air Force was prepared. See Chenevey Exhibit 1.....The technical details included the evidence of Chenevey's long experience with PBT including extruding by way of a mandrel die and blowing tubular film (Chenevey Exhibit 1, p. 2); use of the polymerization mixture which had already been found by Chenevey to be superior, Chenevey Exhibit 1, p. 5; and using a coagulation bath containing a phosphoric acid solution or merely water alone, Chenevey Exhibit 1, Page 8. Chenevey already had knowledge of what worked and what did not (CB, page 45).

Baars et al. argue that Chenevey et al. failed to establish a corroborated conception because of the lack of certainty as to the date of the proposal and the lack of corroboration thereof.

Chenevey et al. rely upon pages 2, 5, 8 and 9 of CX 1 for conception. In our view, the pages of the exhibit cited in the brief are not sufficient to establish conception.

Exhibits do not speak for themselves.¹² They require authentication¹³ as to author, content,

¹² Amoss v. McKinley, 195 USPQ 452, 453-454 (Bd. Pat. Int. 1977). The extent to which an exhibit is explained depends on the simplicity or complexity of the subject matter as well as the technical background of the tribunal hearing the case. Rivise, supra, Vol. III, § 435, page 1891. The witness's explanation as to authorship and content of a document is to be sufficiently clear and detailed as to specific entries in the exhibits relied upon by a witness in order for the Board to make a proper analysis of the record.

¹³ Authentication is defined as "genuineness" and is said to be established, when it is proved to be the thing it is supposed, or represented, to be. Rivise, supra, Vol. IV, §563, page 2148; see also FRE 901. An exhibit may be authenticated by oral testimony of a
(continued...)

and date. They must be explained even if they contain a label and a date. Further, 37 CFR §1.671(f)¹⁴ requires a witness to explain the entries on the various pages of a notebook/exhibit. This explanation provides the opponent party and the Board a basis on which to determine whether the witness's testimony is supported by contemporaneous documentation, or whether a party is relying upon the witness's oral testimony and whether corroboration is necessary. Herein, Chenevey et al. offer no testimony to authenticate Exhibit 1 (CX 1) and to corroborate the Chenevey et al. alleged conception. Counsel's conclusory statement, in the Chenevey et al. brief, that the document shows each specified limitation of the count is unsupported by any reference to the record which provides an explanation as to how the relied upon portions of the document satisfy the

(...continued)

witness, but not by the uncorroborated testimony of the party on whose behalf it is offered in evidence. Hence, a witness must properly identify the exhibit as to what it is as well as to explain the witness's relationship to the document in question. In addition, authenticity of an exhibit must be established both as to subject matter (content) and time. Extrinsic evidence of authenticity as a condition precedent to admissibility is not required for self-authenticating evidence. See FRE 902. Notebooks are not self-authenticating. Id.

¹⁴ 37 CFR § 1.671(f) states that "[t]he significance of documentary and other exhibits shall be discussed with particularity by a witness during oral deposition or in an affidavit." See Notice of Final Rule at 48447, column 3, 1050 Off. Gaz. Pat. Office at 416. In 1984 the rules were amended to require the particularized explanation of material in non-self authentication documents. The commentary explained that "[B]y providing in the rules that documentary evidence must be explained, the PTO hopes to save both parties and the Board considerable difficulty in presenting and evaluating evidence."

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count. Thus, counsel's statement constitutes attorney argument.¹⁵

In response to the Baars et al. argument that Chenevey et al. had not established a "corroborated conception," Chenevey et al., in their reply brief, offer, in addition to those pages cited in their brief, pages 1, 4, 6-7 and 15-18 of Exhibit 1 (CX 1) as evidence of conception of the subject matter of the count (CRB, page 8).

Chenevey et al. argue that "[T]he written evidence of conception is believed quite convincing in view of Mr. Chenevey's experience and complements his oral testimony in this case" (CRB, page 7). In addition, Chenevey et al. rely upon the testimony of

¹⁵ The requirements for the parties' briefs are set forth in 37 C.F.R. § 1.656(b). In particular, 37 C.F.R. § 1.656(b)(2) requires:

[A] statement of the issues presented for decision in the interference and ...

37 C.F.R. § 1.656(b)(4) requires:

[A]n argument, which may be preceded by a summary, which shall contain the contentions of the party with respect to the issues to be decided, and the reasons therefor, with citations to the cases, statutes, other authorities, and part of the record relied on. [Emphasis added.]

Conclusions of fact and law made without appropriate citation to the record or citation of authority will be taken as attorney argument. Compare Ex parte McCullough, 7 USPQ2d 1889, 1892 (Bd. Pat. App. & Int. 1987); Ex parte Meyer, 6 USPQ2d 1966, 1968-9 (Bd. Pat. App. & Int. 1988); In re Mehta, 347 F.2d 859, 863-864, 146 USPQ 284, 289 (CCPA 1965). Attorney argument cannot take the place of evidence lacking in the record. Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ2d 17, 22 (CCPA) cert. denied, 434 U.S. 854 (1977). This means that a specific citation to pages and lines of the record for each alleged fact is necessary. It is not enough to refer to "related testimony" or a range of pages as supporting a group of alleged facts. The Board is not required to search the record for facts which might support a party's position. References in the brief to supporting testimony should include the name of the witness as well as the page(s) and lines where the testimony appears in the record.

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Timmons citing CR 1778-1874 (CRB, paragraph bridging pages 2-3) and particularly the Timmons testimony of December 9, 1983, pages 9-12 (CR 18: 1780-1783) and March 23, 1994, pages 2-7 to 2-8 (CR 18: 1884-1885), and CR 18:1807 and 1820-1821 for corroboration of the existence of the proposal on January 23, 1983, when it is said that Timmons signed the cover letter.

Initially, we point out that first time reliance upon evidence for corroboration in a reply brief, when none was offered in junior party's brief, is inappropriate because junior party has the initial burden to establish priority in its brief (37 C.F.R. § 1.657(a)). Inclusion of new arguments and evidence in a reply brief does not provide senior party with an opportunity to respond. Suh v. Hoefle, 23 USPQ2d 1321, 1323 (Bd. Pat. App. & Int. 1991). It is also inappropriate for Chenevey et al. to refer broadly to Chenevey's and Timmons's oral testimony without any specific citation to pages and lines for each alleged fact. It is not our obligation to search the record to support attorney argument. Hence, the new arguments and evidence are not entitled to consideration. On this record, Chenevey et al. have not established conception.

However, if the additional pages of CX 1 and Timmons's testimony (CR 18: 1780-1783, 1884-1885, 1820 1821 and 1807) had been submitted with the Chenevey et al. brief, we would have found that Chenevey et al. had established, by a preponderance of the evidence, a date of conception no later than January 31, 1983.

CX 1, the contract proposal, is a multi-component document, comprising a cover

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letter signed by Timmons, dated January 23, 1983; AFSC Form 91, signed by M. Schultz, dated January 4, 1983; and a technical proposal dated January, 1983. The cover letter indicates that in addition to the technical proposal and AFSC Form 91, a cost proposal was attached and submitted as part of the proposal. The cost proposal, CX 34, signed by Laurence Peterson, contains a date of submission of "31 January 83." The contract solicitation was due January 31, 1983.

Timmons testified that he had every reason to believe that the technical proposal, dated "January 83," and the cost proposal dated January 31, 1983, and the associated cover letter were completed before January 23, 1983 (CR 18: 1884-85), and sent to the government "on or about January 23, 1983," the date of the cover letter (CR 18: 1780-1781). During cross examination, Timmons could not testify as to the actual date Mr. Peterson signed the cost proposal, but he did explain that the "date of submission" on the cost proposal form was the due date to the AF. During further cross examination, January 23, 1983, was shown to be a Sunday whereupon Timmons indicated that the contract proposal was not sent out on January 23, 1983, but rather sometime before the January 31, 1983, due date (CR18:1900). Because the Chenevey et al. record does not establish, with corroboration by a noninventor, a date certain as to when the technical proposal dated "January 83" was actually prepared and by whom and its content, we find that Chenevey et al. is only entitled to the date of January 31, 1983, for conception, the date that the contract was due at AFWP.

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Responding to the Baars et al. argument that Chenevey et al. failed to establish a "corroborated conception," Chenevey et al. argue that documents and "things" do not need to be corroborated, testimony does. However, if reliance is placed upon an exhibit, the content of the exhibit and its existence at a point in time must be established (corroborated) by the testimony of a person other than the inventor.

Chenevey et al. case for communication¹⁶

Chenevey et al., in their brief, allege that Baars et al. derived the Chenevey et al. invention indirectly from Berry, on January 11, 1983, when Berry and Chenevey et al. met. Chenevey et al. allege that Berry was Chenevey's consultant in 1982, and during that time (1) Chenevey disclosed to Berry his ideas for using a rotating die to extrude a biaxial film as described in CX 39, (CR19: 1963-64 and 66); (2) Chenevey went to Berry's laboratory with some reaction mixture dope and used Berry's apparatus (CR 1946-1949); and (3) Chenevey sent reports (CX 37-39) to Berry (CR19: 1944-1945).

Chenevey et al. also allege that Baars et al. derived the Chenevey et al. invention directly from Chenevey when (1) Guzdar learned of tube extrusion from Chenevey at The Polymer Order Workshop in November, 1983 (BR 5: 482,483, 487, 488, 489); (2) Lusigne learned how to make PBT film from Chenevey at the same workshop (BR 11: 984,985); and (3) Baars met with Chenevey at Celanese in May,

¹⁶ The earliest date that Chenevey et al. can establish for derivation is June 30, 1984. 37 CFR § 1.629(a).

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1984 (BR 5:498).

We have reviewed this evidence and find it insufficient to establish a corroborated communication of a complete conception sufficient to enable one of ordinary skill in the art to construct and successfully operate the invention. Since such communication is a requisite for showing derivation, Hedgwick v. Akers, 497 F.2d 905, 907, 182 USPQ 167, 168 (CCPA 1974), Chenevey et al. have not carried their burden on this issue.

With respect to Berry, Chenevey et al. fail to explain how Chenevey's activities in 1982 establish a corroborated communication of a complete conception. Moreover, an inventor's testimony, with respect to the facts surrounding a claim of derivation cannot, standing alone, rise to the level necessary to establish derivation. Price v Symsek, 988 F.2d at 1190, 26 USPQ2d at 1033. Further, CX 37-39 stand suppressed, and if not suppressed, would be non probative because Chenevey et al. admit that the contents of CX 37-39 are not germane to forming a biaxially oriented film (CR 19: 1984-1986). Lastly, Berry could not misappropriate information from Chenevey in the spring of 1982 regarding the use of PBT in its reaction solvent (PPA) because such information and its attendant advantages were publicly available in August, 1981 (BX IIII).

That members of AIRC and FM attended The Polymer Order Workshop in November, 1983, and that Baars met with Chenevey in May, 1984, are insufficient to establish derivation. Chenevey's allegations that he provided a tutorial on how to

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process PBT and spoke of tube extrusion do not establish that the information provided was sufficient to communicate to the workshop attendees a complete conception of the subject matter of the count. We find insufficient detail in the Chenevey et al. allegations to conclude that Chenevey et al. have or sustained their burden, especially where as here, Chenevey's alleged communications stand uncorroborated, and Chenevey himself admits that the information he presented at the Workshop did not involve the work done in October and November, 1983, the time when Chenevey alleged that he reduced the invention to practice (CR 4: 296-297).

Even though we have found that Chenevey et al. have failed to establish derivation, for the sake of completeness, we will address conception by Baars et al., especially since an earlier conception is an absolute defense to the charge of derivation. Denen v. Buss, 801 F.2d 385, 386, 231 USPQ 159, 160 (Fed. Cir. 1986).

Baars et al. conception

We find that Baars et al. have established a date of conception no later than January 31, 1983, the date the proposal was due at AFWP.

Baars et al. allege six dates for conception. In support of these dates, Baars et al. offer the testimony of coinventors Lusignea, Davis and Baars; and corroborators: Guzdar, Eagles and Berry, as well as exhibits, BX H-P.

We focus on three of these exhibits: (1) BX J, notes taken by Lusignea at a developmental meeting on January 19, 1983; (2) BX N, the AIRC proposal which was

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incorporated in to their proposal: and (3) BX P, the FM proposal submitted to the AF on January 31, 1983.

BX J sets forth the steps of (1) using a solution (PPA); (2) orienting the molecules by, e.g., extrusion and blowing, extrusion with lateral shear (spin) and stretching; and (3) coagulating with water (see BX J20). Lusignea and Davis testified that extrusion with lateral shear involves the use of a "counter-rotating die" (BR 9:840-43 and BR 1: 39-41). Guzdar confirms this meeting and the discussion therein (BR 4:370-379, 365-366). BX N describes a process for the extrusion of PBT from a solution of PBT and PPA which includes tube extrusion with a counter-rotating die followed by coagulation and removal of the solvent (BX 39-40). BX P describes a process for producing biaxial oriented films of PBT by extruding PBT in PPA, its polymerization solvent, through a counter-rotating die followed by coagulation and removal of the solvent. Baars et al. assert that the disclosure in each of BX N and BX P is directed to PBT in PPA (its polymerization solvent) and describes the use of the polymerization mixture as set forth in the count.

Chenevey et al.'s sole argument with regard to the Baars et al. conception is that Baars et al. proposal, BX P, does not show that Baars et al. contemplated the use of a "polymerization mixture" as set forth in step (i) of the count. We do not find the Chenevey et al. argument to be persuasive. The Baars et al. record demonstrates that the polymerization mixture was contemplated by the inventors. BX P, 2-5 states "...it

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appears that solution processing of PBT can be effectively carried out in PPA solution. ... that PPA will be used in the processing methods proposed in subsection 2.3, since it is the polymerization medium for PBT and thus requires no additional solvation procedures.” (Eagles BR 3:329). In addition, Lusignea testified that the polymerization mixture was well known in 1981 to be better than the mixture of polymer and solvent. (BX IIII, CR 21: 2257-2258). Baars et al. was aware that PBT was provided in dope form where the polymer is dissolved in PPA. Davis BR 1: 80; and Guzdar BR: 360, 378-9.¹⁷ We find that corroborators Guzdar and Eagles confirm the content and dates of these exhibits.

It is our view that the testimony of the coinventors, corroborated by the Baars et al. witnesses, combined with the exhibits of Baars et al., are sufficient to establish that Baars et al. conceived of the use of the polymerization mixture, PBT/PPA, in their process no later than January 31, 1983.

Chenevey et al. also argue that Baars et al. were neophytes in the field and that they had no idea whether their proposed process would work for its intended purpose. We find this argument to be nonpersuasive. An inventor need not know that his invention will work for conception to be complete. An inventor need only show that he had the idea; the discovery that an invention actually works is part of its reduction to practice. Burroughs, 40

¹⁷ Baars et al. state that “at that time PBT was only supplied in the form of its polymerization mixture” (BB page 129, lines 4-5). This statement is not challenged by Chenevey et al.

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F.3d at 1228, 32 USPQ2d at 1919, citing Applegate v. Scherer, 332 F.2d 571, 573, 141 USPQ 796, 799 (CCPA 1964).

VII.

Chenevey et al. Reduction to Practice

We find, based on the evidence relied upon by Chenevey et al. in the brief, that Chenevey et al. have not proven, by a preponderance of evidence, an actual reduction to practice of the invention in issue prior to June 30, 1984.

The issue of reduction to practice is a question of law. Hybritech, 802 F.2d at 1376, 231 USPQ at 87. To establish a reduction to practice of a method count, a party must show that each step of the method was performed. Szekely v. Metcalf, 455 F.2d 1393, 1396, 173 USPQ 116, 119 (CCPA 1972). All limitations of the count have to be satisfied. Id. Such performance may be made by the inventor or someone on his behalf. A party must show that the method produced the product of the count. Blicke v. Treves, 241 F.2d 718, 720-721, 112 USPQ 472, 475 (CCPA 1957). Where the objective of the process is to produce a product having particular properties, the product must be tested to show that it has the desired properties, and that the product is satisfactory for its intended purpose, which in some cases requires testing of the product. Birmingham v. Randall, 171 F.2d 957, 958-959, 80 USPQ 371, 372 (CCPA 1948). Whether a product must be tested in order to establish a reduction to practice, and if so, what tests are necessary, is a question which must be decided on the basis of

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the facts of the particular case involved. Blicke, 241 F.2d at 720-721, 112 USPQ at 475 (CCPA 1957). The character of testing varies with the character of invention and the problem it solves. Scott v. Finney, 34 F.3d 1058, 1061-1062, 32 USPQ2d 1115, 1118 (Fed. Cir. 1994). When reviewing the sufficiency of evidence for reduction to practice a "reasonableness" standard is applied. Holmwood v. Sugavanam, 948 F.2d 1236, 1238, 20 USPQ2d 1712, 1714 (Fed. Cir. 1991). Lastly, there must be an appreciation of the existence of an embodiment of the invention and the operability of the embodiment. Estee Lauder v. L'Oreal, 129 F.3d 588, 594-595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997); Silvestri v. Grant, 496 F.2d 593, 597, 181 USPQ 706, 708 (CCPA 1974), cert denied, 420 U.S. 928 (1975); Heard v. Burton, 333 F.2d 239, 243, 142 USPQ 97, 100 (CCPA 1964). See also Chisum on Patents §10.06[2] (1995).

The reduction to practice must be corroborated in point in time. An inventor must provide independent corroborating evidence in addition to his own statements and documents. Hahn, 892 F.2d at 1032, 13 USPQ2d at 1317; Lacotte v. Thomas, 758 F.2d 611, 613, 225 USPQ 633, 634 (Fed. Cir. 1985). Such evidence "may consist of testimony of a witness, other than an inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor" [emphasis added]. Hahn, 892 F.2d at 1032-33, 13 USPQ at 1317; Reese, 661 F.2d at 1225, 211 USPQ at 940. The purpose of the rule requiring corroboration is to prevent fraud. Berry v. Webb, 412 F.2d

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261, 267, 162 USPQ 170, 174 (CCPA 1969). A rule of reason applies to determine whether the inventor's testimony has been sufficiently corroborated. Price v. Symsek, 988 F.2d at 1192, 26 USPQ2d at 1036-37. The "rule of reason" involves an examination, analysis and evaluation of the record as a whole so that a reasoned determination as to the credibility of the inventor's story may be reached. Berges v. Gottstein, 618 F.2d 771, 776, 205 USPQ 691, 695 (CCPA 1980); Mann v. Werner, 347 F.2d 636, 640, 146 USPQ 199, 202 (CCPA 1965). There is no single formula that must be followed in providing corroboration. Whether an actual reduction to practice has been corroborated must be decided on the facts of each particular case. Berges, 618 F.2d at 776, 205 USPQ at 695. Nevertheless, adoption of the "rule of reason" has not dispensed with the requirement that corroborative evidence must not depend solely from the inventor himself but must be independent of information received from the inventor. Coleman, 754 F.2d at 359, 22 USPQ at 862; Reese, 661 F.2d at 1225, 211 USPQ at 940; Mikus v. Wachtel, 542 F.2d 1157, 1159, 191 USPQ 571, 573 (CCPA 1976). Thus, where as here, the process is carried out by the inventors, there must be corroborated evidence that all the limitations as to the materials, the properties, the steps and the results required by the count were present in the work performed. Land v. Regan, 342 F.2d 92, 101, 144 USPQ 661, 669 (CCPA 1965); Vandenberg v. Reynolds, 268 F.2d 744, 747, 122 USPQ 381, 383 (CCPA 1959).

In order to establish a reduction to practice, Chenevey et al. rely upon

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- (1) the testimony of Chenevey (CR 3: 226, 228-231); and
- (2) (a) Exhibits 18 and 21[sic: 31] and Exhibits 19 and 27, respectively to establish a reduction to practice on January 7, 1983, and February 10, 1983 (CB. page 10),

(b) Exhibits 28, 20, 32 and 33 and “related testimony” for a reduction to practice on October 5, 1983 (CB, pages 11-12), and

(c) Exhibit 33, samples 32621-7-1 through 7 and Exhibit 8, page 3 for properties of 32621-7-2, and 6 for reduction to practice no later than November 6, 1983, and December 83, respectively (CB 12).

We have carefully reviewed this testimony and the referenced exhibits but do not find that Chenevey et al. have sustained their burden of proof to establish an actual reduction to practice.

The Chenevey et al. Exhibit 8 is a progress report with a cover letter signed by Timmons. The Chenevey et al. Exhibits 18, 20, 26, 28, are notebook pages signed by Chenevey or both Chenevey and Kafchinski. Chenevey et al. Exhibits 19, 27, 31 are unsigned notebook pages presumably written by the inventors; and Chenevey et al. Exhibits 32 and 33 are loose pages unsigned and unwitnessed.

We do not find that these exhibits aid the Chenevey et al. case. As we noted earlier, exhibits do not speak for themselves. Amoss, 953 F.2d at 617, 21 USPQ2d at 1274. The only testimony offered by Chenevey et al. in their brief and with regard to these exhibits was that of coinventor Chenevey. Thus, these exhibits have not been authenticated as to date and content by evidence independent of the inventor and they,

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therefore, are entitled to no weight.

The Chenevey et al. brief (CB 10 and 11) refers to “related testimony.” However, such a broad reference to general testimony does not satisfy the requirement of 37 C.F.R. § 1.656(b) as to briefs (see footnote 15, supra). It is not incumbent upon the Board to search the record for the testimony alluded to in the brief.

Since Chenevey et al. have not established an actual reduction to practice of the subject matter of the count, the issue of abandonment, suppression and concealment is deemed moot.

VI.

Since Chenevey et al. have not established derivation or an earlier reduction to practice, the issue of whether the Chenevey et al. record has removed the Harvey reference is deemed moot.

JUDGMENT

For the foregoing reasons, judgment as to the subject matter of the count is entered in favor of DIRK M. BAARS, DONALD D. BRETCHES, ROBERT B. DAVIS, ANDREW C. HARVEY and RICHARD W. LUSIGNEA, senior party, and against EDWARD C. CHENEVEY and EDWARD R. KAFCHINSKI, junior party. On this record, Baars et al. is entitled to a patent containing claims 23-45 corresponding to the count and Chenevey et al. are not entitled to their patent containing claims 1-26 corresponding to the count.

IAN A. CALVERT
Administrative Patent Judge

MARY F. DOWNEY
Administrative Patent Judge

JOAN ELLIS
Administrative Patent Judge

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