

The opinion in support of the decision being entered today
is not binding precedent of the Board.

Paper No. 190

Filed by: Merits panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-308-7953

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

BRUCE A. ROSENTHAL,

Junior Party,
(P.N. 5,642,226)

v.

JOHN ALLAN MAGEE,

Senior Party.
(S.N. 08/882,519)

Patent Interference No. 104,403

Heard: February 3, 2003

Before: SCHAFFER, CRAWFORD, and MEDLEY, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

FINAL DECISION

Introduction

This is a final decision in Interference No. 104,403 which was declared on
September 11, 2000.

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Rosenthal, the junior party, is involved on the basis of Patent 5,642,226 (“226 patent”), granted June 24, 1997, based on application 08/375,405, filed January 18, 1995.

Magee is involved on the basis of application 08/882,519 (“519 application) filed on June 25, 1997. Magee has been accorded the benefit for purposes of priority of application 08/227,055 (“055 application”), filed April 13, 1994, now patent 5,644,431, granted July 1, 1997 and was accorded senior party status.

Count 1, the only count is as follows:

An optical lens system comprising:

a transparent sheet having a first surface and opposite surface constituted by a plurality of parallel lenticulated conic lenses,

said first surface being constituted by a plurality of spaced-apart, raised parallel portions having a composite image positioned thereupon with indented transparent concave lens portions therebetween which permit the passage of light,

whereby an object image positioned beneath said sheet at a preselected distance is viewed through the transparent concave lens portions.

The following claims of the parties are designated as corresponding to the count:

Rosenthal: claims 1 through 8 and 11

Magee: claims 19 through 23

In addition to priority, the following motions are before us for consideration:

Magee Preliminary Motion 3 for Judgment against Rosenthal on Unpatentability (35 U.S.C. Section 103)(Paper No. 105).

Rosenthal Preliminary Motion 6 for Judgment based on Inequitable Conduct—
Concealment (Paper No. 37).

Magee Miscellaneous Motion 8 for reconsideration of Magee Preliminary Motion
4 for Judgment against Rosenthal that the Rosenthal claims are unpatentable
under 35 U.S.C. § 112 for failing to set forth a best mode (Paper No. 141).

FINDINGS OF FACT

The record supports the following findings by at least a preponderance of the
evidence.¹

1. The intended purpose or object of the invention disclosed in the Rosenthal '226
patent is to provide a lenticular optical system in which a composite image is viewable
through a lens sheet from a first angle and an object or image placed at a preselected
distance beneath the composite image is viewable from a second angle (col. 2, lines 34
to 39).
2. Rosenthal, the junior party, testifies that he made a lens sheet on May 5, 1990,
which:

. . . had conic lenses on the viewing surface and on the
opposite side had a plurality of spaced-apart, raised parallel
portions with a composite image positioned thereupon with
indented transparent concave lenses in between which
permitted the passage of light. Thereby an object beneath
the sheet at a preselected distance was viewable through
the transparent concave lens portions. I, the viewer could
see the sheet appear as an opaque image material at one
angle of view and then from, another angle of view, I saw the

¹ To the extent these facts discuss legal issues, they may be considered
conclusions of law.

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sheet as transparent, thereby providing a clear view through the sheet to objects behind it. (Rosenthal Record page 34).

3. The junior party has filed Exhibit 2141 (Rosenthal Record page 43), which he states is a photocopy of the lens prototype made on May 5, 1990 (Rosenthal Record page 34).
4. Exhibit 2141 depicts a sheet having one surface which is constituted by a plurality of conic members with planar members therebetween and a second surface which is constituted by a plurality of conic members (Rosenthal Record page 43).
5. Rosenthal testifies in regard to the May 5, 1990 prototype:

At that time, I was not sure how well it would work at a smaller scale. It would be necessary to make thinner in order for it to be utilized for one of the objects stated in my subsequent patent application, that of materials for packaging and other graphic uses. (Rosenthal Record page 34).
6. The junior party does not direct our attention to any evidence that corroborates his testimony regarding the lens sheet made May 5, 1990.
7. Rosenthal testifies that he made another prototype of a lens sheet in the first two weeks of August 1992, and has filed Exhibit 2142 (Rosenthal Record page 44) which the junior party states is a photocopy of the lens sheet constructed in August 1992 (Rosenthal Record pages 34-35).
8. Exhibit 2142 appears to be a photocopy of a sheet having one surface constituted by a plurality of spaced-apart parallel sections with concave sections

therebetween and another surface constituted by a plurality of conic sections (Rosenthal Record page 44).

9. The junior party has submitted the affidavit of Dr. Fredrick Lauter (Exhibit 2116, Rosenthal Record page 46) as corroboration of the August 1992 reduction to practice.
10. Lauter testifies that he met with Rosenthal on August 14, 1992 and was shown:

. . . a lens sheet in which I, the viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it. This lens sheet had a plurality of parallel lenticulated conic lenses on the viewing side and on the opposite side had a plurality of spaced-apart, raised parallel portions with a composite image positioned thereupon with indented transparent concave lenses in between which permitted the passage of light. Thereby an object beneath the sheet at a preselected distance was viewable through the transparent concave lens portions. (Rosenthal Record page 46).
11. Lauter further testifies that Exhibit 2118 (Rosenthal Record page 47) is a photocopy of the lens prototype of the lens he saw in August 1992 (Rosenthal Record page 46).
12. Exhibit 2118 (Rosenthal Record page 47) depicts a lens having one surface constituted by a plurality of spaced-apart parallel sections with concave sections therebetween and another surface constituted by a plurality of conic sections.
13. Lauter also testifies that he was shown unique packaging with the lens sheet as a window which provided a view of an opaque image at one angle and then at

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another angle provided a clear view through to the actual contents of the package (Rosenthal Record page 46).

14. Lauter testifies (Rosenthal Record page 46) that he signed a confidentiality agreement which has been submitted as Exhibit 2117 (Rosenthal Record page 140).
15. Rosenthal testifies that he showed Lauter a prototype of a lenticular convex/concave sheet (Rosenthal Record page 35).
16. Rosenthal testifies:

I worked on my invention continuously, developing my ideas for alternative embodiments, I made a rough prototype of a lens sheet with lens ridges on the viewing side wherein each ridge had parallel convex lens and angled planar portions, so that at one range of angles the viewer could see through the planar portions to an object beyond the lens sheet, without distortion, and wherein looking from a different range of angles, the viewer would see through the convex lens portions and see the image stripes on the back of the sheet magnified to fill a continuum. It was difficult to make the plane surface flat and smooth with my hand tools, so that this attempt was difficult to access. (Rosenthal Record page 35).

17. Rosenthal does not give specific dates for the activity described in the preceding paragraph nor has he submitted any documentary evidence regarding this activity.
18. Rosenthal's '226 patent (Exhibit 1001) includes an embodiment in which each ridge has a parallel convex lens and angled planar portions (Fig. 6; col. 10, lines 28-36).
19. Mike Karr testifies that on January 20, 1993, Rosenthal showed him:

. . . a lens sheet in which I, the viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it. This lens sheet had a plurality of parallel lenticulated conic lenses on the viewing side and on the opposite side had a plurality of spaced-apart, raised parallel portions with a composite image positioned thereupon with indented transparent concave lenses in between which permitted the passage of light. Thereby an object beneath the sheet at a preselected distance was viewable through the transparent concave lens portions. (Rosenthal Record page 22).
20. Karr testifies (Rosenthal Record page 22) that he signed a confidentiality agreement (Rosenthal Record page 23).
21. Karr further testified that Rosenthal showed him unique packaging, with his lens sheet used as a window which provided a view of an opaque image at one angle, and at another angle provided a clear view, through to the actual contents of the package (Rosenthal Record page 22).
22. Rosenthal describes the preparation of a prototype prepared at some point in

time:

I began with an existing lenticular lens sheet which had 4 arc of circle convex lenses per inch and was approximately 1/4 inch thick. I then took off varying amounts of material off the apex of the convex lenses, parallel to the sheet, creating truncated lenses. By so doing, I could "see-through" clearly to an object beyond the back of the lens when I looked from a "straight on" viewing position, and at alternative ranges of viewing, to the left and right, I could then see the print stripe which were on the back of the sheet.(Rosenthal Record page 36).

23. At some point in time, Rosenthal worked on a lens sheet comprising a parabolic lens (Rosenthal Record page 37).

24. The '226 patent (Exhibit 1001) includes an embodiment in which the lens sheet includes a parabolic lens (Figs. 4, 5 and 10; col. 9, lines 24-31 and 60-64; col. 12, lines 39-42).

25. Aron Lefkowitz testifies that on May 21, 1993, Rosenthal showed him:

. . . a lens sheet in which I, the viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it. This lens sheet had a plurality of parallel lenticulated conic lenses on the viewing side and on the opposite side had a plurality of spaced-apart, raised parallel portions with a composite image positioned thereupon with indented transparent concave lenses in between which permitted the passage of light. Thereby an object beneath the sheet at a preselected distance was viewable through the transparent concave lens portions. (Rosenthal Record page 17).

26. Lefkowitz also testifies that Rosenthal showed him unique packaging with his lens sheet used as a window which provided a

view of an opaque image at one angle, and at another angle provided a clear view, through to the actual contents of the package (Rosenthal Record page 17).

27. Lefkowitz further testifies (Rosenthal Record page 17) that he signed a confidentiality agreement (Rosenthal Record page 18).
28. At some point in time, Rosenthal made smaller scale prototypes of his lens sheet including one with convex lenses on the viewing surface and concave lenses on the opposite surface (Rosenthal Record page 37).
29. Dr. Bruce P. Rosenthal (no relation to the junior party Bruce A. Rosenthal) testifies that on July 12, 1993, he was shown:

. . . a lens sheet in which I, the viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it. This lens sheet had a plurality of parallel lenticulated conic lenses on the viewing side and on the opposite side had a plurality of spaced-apart, raised parallel portions with a composite image positioned thereupon with indented transparent concave lenses therebetween which permitted the passage of light, whereby an object beneath the sheet at a preselected distance was viewable through the transparent concave lens portions (Rosenthal Record page 8).
30. Bruce P. Rosenthal also testifies that on July 12, 1993,

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Rosenthal showed him unique packaging with his lens sheet used as a window which provided a view of an opaque image at one angle, and at another angle provided a clear view, through to the actual contents of the package (Rosenthal Record page 9).

31. Bruce P. Rosenthal testifies (Rosenthal Record page 8) that he signed a confidentiality agreement which has been submitted as Exhibit 2102 (Rosenthal Record page 10).
32. In the period from July 12, 1993 to November 1993, the evidence shows no activity either perfecting the invention of the count or preparing a patent application.
33. Rosenthal testifies that he began preparing his patent application in November 1993 (Rosenthal Record page 37).
34. Rosenthal testifies that from November 1993 until filing the application for the '226 patent, he developed various optical systems including a lens sheet with cylindrical Fresnel lenses and multiple line grids with front and rear grids aligned to create both an opaque image view and vision beyond the grid (Rosenthal Record page 38).
35. The '226 patent specification (Exhibit 1001) includes an embodiment in which a Fresnel lens is included (Figs. 13 and 14; col. 14, lines 22-30 and 61-65).

36. Rosenthal experimented and made prototypes of multiple cylindrical Fresnel lenses (Rosenthal Record page 38).
37. On April 11, 1994, Alan Rothchild testifies that he was shown:
- . . . a lens sheet in which I, the viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it. This lens sheet had a plurality of parallel lenticulated conic lenses on the viewing side and on the opposite side had a plurality of spaced-apart, raised parallel portions with a composite image positioned thereupon with indented transparent concave lenses in between which permitted the passage of light. Thereby an object beneath the sheet at a preselected distance was
- viewable through the transparent concave lens portions. (Rosenthal Record page 25).
38. Rothchild also testifies that on April 11, 1994, Rosenthal showed him unique packaging with his lens sheet used as a window which provided a view of an opaque image at one angle, and at

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39. Rothchild testifies that he signed a confidentiality agreement which has been submitted as Exhibit 2129 (Rosenthal Record page 25).
40. There is no evidence to establish what, if anything, the junior party did to perfect the invention of the count or to prepare the patent application during the period from April 11, 1994 to July 13, 1994.
41. Paul Cote testifies that on July 13, 1994, he was shown:

. . . a lens sheet in which I, the viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it. This lens sheet had a plurality of parallel lenticulated conic lenses on the viewing side and on the opposite side had a plurality of spaced-apart, raised parallel portions with a composite image positioned thereupon with indented transparent concave lenses in between which permitted the passage of light. Thereby an object beneath the sheet at a preselected distance was viewable through the transparent concave lens portions. (Rosenthal Record page 28).
42. Cote also testifies that on July 13, 1994, Rosenthal showed him unique packaging with his lens sheet used as a window which provided a view of an opaque image at one angle, and at another angle, a clear view through to the actual contents of the package (Rosenthal Record page 28).
43. There is no evidence which establishes what, if any, activity

Rosenthal undertook to perfect the invention of the count or to prepare the patent application during the period of July 13, 1994 until the patent application was filed on January 18, 1995.

44. There is no explanation on the record of why the preparation of the application for the '226 patent took from November 1993 until January 18, 1995.
45. In the opening brief (Paper No. 134), the junior party alleges that the senior party derived the invention from the junior party (Rosenthal Opening Brief page 34).
46. The junior party states in the opening brief (Paper No. 134) that Mr. Bruce A. Rosenthal communicated the invention to Kenneth Conley, who in turn communicated it to the senior party (Rosenthal Opening Brief page 34).
47. Kenneth Conley is associated with a company called Micro Lens Technology and has been involved for over 20 years with materials, techniques, and equipment for making lenticular screen sheets. Conley is acquainted with both Rosenthal, the junior party and Magee, the senior party for over 10 years. In regard to Magee, Conley has sent bids to the University of Arkansas (the real party in interest for the senior party) regarding the making of engraved cylinders and has received purchase orders for

engraved cylinders. (Rosenthal record pages 78 to 79).

48. In an affidavit submitted by the junior party (Exhibit 2159), Rosenthal states that he met with Conley on July 12, 1990 and communicated the invention to him on that date, describing:

a lens sheet, having a plurality of convex lenses on one surface and a plurality of mutually parallel and at the same spacing concave lenses with intervening planar portions, on the opposite surface, which would permit the clear view of objects beyond the lens sheet at one set of viewing angles, and alternately provide a view of an image printed on the sheet at another set of viewing angles. I further explained that the sheet therefor would appear transparent from (sic) one set of viewing angles and appear opaque, such that it could have an opaque image appear at another set of angles. I was a witness to Conley's acknowledgment that he completely understood my concepts. (Rosenthal Record pages 147-48).

49. Conley states that he had a chance meeting with Rosenthal in 1989 or 1990 at a company which produces plastic film (Rosenthal Record page 81).
50. Conley states that he was visiting the company, in connection with business of his employer, when he was called into the meeting with Rosenthal, at which seven to ten people were present. (Rosenthal Record page 81).
51. Conley further testifies (Rosenthal Record page 81) that he signed a confidentiality agreement (Rosenthal Record page 85).

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52. Rosenthal states that he communicated the invention to Conley a second time via a certified letter sent November 8, 1990, which included a drawing of the junior party's optical lens system that had been previously shown to Conley during their July 12, 1990 meeting (Rosenthal Record page 149).
53. A copy of the certified letter, postmarked November 9, 1990, (Rosenthal record page 210) and drawing (Rosenthal Record page 211) has been submitted as Exhibit 2011.
54. Conley acknowledges receipt of a certified letter which referred to an enclosed drawing, but testifies that there was no drawing enclosed (Rosenthal Record page 82).
55. Rosenthal states that Conley telephoned him prior to October 31, 1993, and said that he was representing senior party Magee, and suggested that the senior party might be able to make lab sample material of the optical lens system at issue, and acknowledged having communicated the junior party's lenticular inventions to the senior party "some time" previously. (Rosenthal Record pages 150-51).
56. Rosenthal also testifies that Conley told him that the senior party knew about the earlier Rosenthal patents (Rosenthal Record pages 41-42).

57. Rosenthal alleges in his affidavit that, as Conley was acting as a representative of the senior party during the telephone conversation which occurred prior to October 31, 1993, the senior party thereby admitted knowledge of the junior party's concept by that date (Rosenthal Record page 151).
58. Conley testifies that, since at least as early as February 1991, he has periodically provided senior party Magee with engraved cylinders for manufacturing lenticular sheet (Rosenthal Record pages 79-80), but that he was not a consultant for either the junior or senior party (Rosenthal Record page 79).
59. Conley testifies that he has never communicated any information received from either one of the junior party or the senior party to the other (Rosenthal Record page 79).
60. Conley also states that he is particularly sure he did not communicate any ideas or inventions received from the junior party to any other person, and particularly not to the senior party (Rosenthal Record page 82).
61. Conley further states that he received a number of telephone calls from Rosenthal, as well as three written communications (Rosenthal Record pages 81-82), but he testifies that he received no disclosure of "a lenticular screen sheet having

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concave lenses therein” from Mr. Rosenthal until March 10, 1995, or later (Rosenthal Record page 82).

OPINION

Magee was accorded the benefit of the filing date of the '055 application which was filed on April 13, 1994 and was accorded senior party status on that basis. In order to be awarded priority in this interference, Rosenthal must either prove an actual reduction to practice prior to the filing date of the '055 patent application or prove conception of the subject matter of the count before the filing date of the '055 patent application coupled with reasonable diligence from a time just prior to the filing date of the '055 patent application up to a reduction to practice (constructive or actual) by Rosenthal. 35 U.S.C. § 102(g)(2000); Singh v. Brake, 317 F.3d 1334, 1340, 65 USPQ2d 1641, 1645 (Fed. Cir. 2003); Griffin v. Bertina, 285 F.3d 1029, 1032, 62 USPQ2d 1431, 1433 (Fed. Cir. 2002); Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577, 38 USPQ2d 1288, 1290 (Fed. Cir. 1996).

As the junior party, Rosenthal bears the burden of proof on the issue of priority. Bosies v. Benedict, 27 F.3d 539, 541, 30 USPQ2d 1862, 1863 (Fed. Cir. 1994).

“It is well settled that where an interference is between a patent that issued on an application that was copending with an interfering

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application, the applicable standard of proof is preponderance of the evidence.” Bosies v. Benedict, 27 F.3d at 541-42, 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).

The '055 patent application was filed on April 13, 1994, and the Magee patent was issued on July 1, 1997 and the '226 patent application was filed on January 18, 1995. Therefore, Rosenthal's patent application was copending with Magee's patent application. Accordingly, the relevant standard in this case is preponderance of the evidence. Something is established by a “preponderance of the evidence” when the existence of a fact is more probable than its nonexistence. Concrete Pipe & Prods. v. Construction Laborers Pension Trust, 508 U.S. 602, 622 (1993). As such, the junior party must prove that it is more probable than not that he was the first to reduce the invention to practice prior to the filing date of the '055 patent application, or was the first to conceive the invention and utilized diligence from a time just prior to the filing date of the '055 patent application to a later reduction to practice.

The subject matter of the count is an optical lens system comprising a transparent sheet having a first and second surface. The

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first surface has a plurality of parallel lenticulated conic lenses. The second surface which is disposed opposite to the first surface includes a plurality of spaced-apart raised parallel portions which have a composite image positioned thereupon with indented transparent concave lens portions therebetween. The concave lens portions permit the passage of light so that an image positioned beneath the transparent sheet at a preselected distance can be viewed through the transparent concave lens portions of the second surface.

The subject matter of the count may be used in packaging. When the optical lens system of the count is used in packaging, a viewer can view the image (such as advertisement or labeling) on the raised parallel portions of the second surface when the viewer views the package at one angle and views an object (such as the contents of the package) beneath the sheet at a second angle.

Rosenthal's priority case

Reduction to practice

In order to prove actual reduction to practice, one must establish that a physical embodiment of the invention existed and that the physical embodiment included every limitation of the count and that it worked for its intended purpose. Correge v. Murphy, 705 F.2d 1326,

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1329, 217 USPQ 753, 755 (Fed. Cir. 1983). Corroboration is also necessary to prove reduction to practice. The corroboration can be in the form of testimony of a witness, other than the inventor, to an actual reduction to practice, or it may consist of evidence of surrounding facts and circumstances independent of the information received from the inventor.

The purpose of the rule requiring corroboration is to prevent fraud and to establish by proof that is unlikely to have been fabricated or falsified, that the inventor successfully reduced his invention to practice. Berry v. Webb, 412 F.2d 261, 267, 162 USPQ 170, 174 (CCPA 1969). The evidence necessary for corroboration is determined by the rule of reason which involves an examination, analysis and evaluation of the record as a whole to the end 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).

The junior party argues that he prepared a prototype on May 5, 1990, of a lens sheet having conical lenses on the viewing surface, and having on the opposite surface, a plurality of spaced-apart raised parallel portions with a composite image positioned thereupon with

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indented transparent concave lenses in between permitting the passage of light (Rosenthal Opening Brief page 4) and attaches a photograph of the lens sheet as Exhibit 2141 (Rosenthal Record page 43). Exhibit 2141 appears to be a sheet with one surface which is constituted by a plurality of conic members with planar members therebetween and a second surface that is constituted by a plurality of convex members. However, the junior party has not submitted any evidence which corroborates that this prototype existed on May 5, 1990 and absent corroboration, the evidence is insufficient to prove an actual reduction to practice. "In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence." Cooper v. Goldfarb, 154 F.3d 1321, 1330, 47 USQ2d 1896, 1903 (Fed. Cir. 1998).

Rosenthal testifies (Rosenthal Record pages 34 to 35) that he prepared another prototype by August 14, 1992 which was shown to Lauter. Lauter corroborates that a lens sheet which is depicted in Exhibit 2118 and which met the requirements of the count was in existence as of August 14, 1992 (Rosenthal Record page 46).

The senior party argues that the junior party's proof of reduction to practice is insufficient to carry his burden of proof (Magee Brief in Opposition to Rosenthal Opening Brief page 18). The senior party first

asserts that the lens prototype depicted in Exhibit 2141 was admitted by Rosenthal to be unacceptable for its intended purpose (Magee Brief in Opposition to Rosenthal Opening Brief page 19). This position is based on the Rosenthal statement in his affidavit that he was not sure how well the lens sheet depicted in Exhibit 2141 would work and that it would be necessary to make it thinner in order for it to be utilized for one of the objects stated in his subsequent patent application, i.e. for packaging (Rosenthal record page 34). The senior party concludes (Magee Brief in Opposition to Rosenthal Opening Brief page 19) from this statement that the lens sheet depicted in Exhibit 2141 was not suitable for packaging and thus did not work for its intended purpose. The senior party then examines the lens sheet depicted in Exhibit 2118 and concludes (Magee Brief in Opposition to Rosenthal Opening Brief page 20) from an examination of the photograph that the lens sheet depicted in Exhibit 2118 is no thinner than the lens sheet depicted in Exhibit 2141. The senior party concludes that the lens sheet depicted in Exhibit 2118 will not work for its intended purpose, i.e. packaging.

Firstly, we note that Lauter states (Rosenthal Record page 14) that he was shown unique packaging with the lens sheet as a window which provided a view of an opaque image at one angle, and then at

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another angle provided a clear view through to the actual contents of the packaging. Therefore, the testimony of Dr. Lauter corroborates that a lens system that was suitable for packaging was in existence on August 14, 1992.

In any case, we do not find the argument of the senior party persuasive because (1) we do not think that the above-referenced statement made by Rosenthal establishes that the lens sheet depicted in Exhibit 2141 would not work for its intended purpose and because (2) it has not been established that the lens sheet depicted in Exhibit 2118 is not thinner than the lens sheet depicted in Exhibit 2141.

In regard to the senior party's assertion that the lens sheet depicted in Exhibit 2141 would not work for its intended purpose because Rosenthal stated that it might be necessary to make it thinner, we note that the statement itself states that packaging and other graphic purposes was one of the objects of the invention. In our view, the major objective or intended purpose of the invention of the '226 patent is to provide a lenticular optical system in which a composite image is viewable through a lens sheet from a first angle and an object or image placed at a preselected distance beneath the composite image is viewable from a second angle (col. 2, lines 34 to 39). The use

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of the lens sheet for packaging was just one of the other objects of the invention listed in the specification. Therefore, we are not convinced that a lens system that is not suitable for packaging or graphic uses is a lens system which does not work for its intended purpose.

In addition, we are not convinced that the photographs of Exhibits 2141 and 2118 (Rosenthal Record pages 16 and 43) can be utilized to determine the size of the lens system as the senior party has not directed our attention to any evidence which establishes that the photographs of Exhibits 2141 and 2118 are of the same scale. Without establishing that the photographs are of the same scale, no meaningful comparison between the two photographs can be made.

In view of the foregoing, it is our determination that the junior party has established that he reduced the invention of the count to practice on August 14, 1992.²

Suppression and Concealment

The senior party has raised the issue of suppression and concealment (Magee's Opening Brief pages 9 to 11). We note that the burden of establishing suppression and concealment is on the party

² We need not address Rosenthal's argument that it conceived of the invention in 1982, since based on the record before us, Rosenthal has sufficiently demonstrated a reduction to practice of the invention prior to Magee. See 35 USC § 102(g).

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asserting the suppression and concealment. Gallagher v. Smith, 206 F.2d 939, 946, 99 USPQ 132, 138 (CCPA 1953).

In the instant case, as the junior party has established that he reduced the invention of the count to practice on August 14, 1992 prior to the April 14, 1994 effective filing date of the senior party's involved application, the junior party as the first to reduce the invention of the count to practice would ordinarily be entitled to a patent on the invention of the count. However, a second inventor may be awarded priority of invention if he can show that the other party (the junior party in this case) who was first to reduce the invention to practice, suppressed or concealed the invention. 35 U.S.C. § 102(g); Paulik v. Rizkalla, 760 F.2d 1270, 1271-72, 226 USPQ 224, 224-25 (Fed. Cir. 1985).

Our reviewing court stated in Correge v. Murphy, 705 F.2d at 1330, 217 USPQ at 756 (Fed. Cir. 1986) (quoting International Glass Co. v. United States, 408 F.2d 395, 403, 159 USPQ 434, 441 (Ct. Cl. 1968):

The courts have consistently held that an invention, though completed, is deemed abandoned, suppressed, or concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known. Thus, failure to file a patent application; to describe the invention in a publicly disseminated document; or to use the invention publicly, have been held to constitute abandonment, suppression or

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concealment.

The true policy and ends of the patent laws is to promote the prompt progress of science and the useful arts. This is achieved by prompt disclosure of invention. In fact, early disclosure is the linchpin of the patent system. Horwath v. Lee, 564 F.2d 948, 950, 195 USPQ 701, 703-04 (CCPA 1977); Griffin v. Kanamaru, 816 F.2d at 626, 2 USPQ2d at 1362 (Fed. Cir. 1987). The doctrine of suppression and concealment is in the nature of the equity that favors him who gives the public the benefit of the knowledge of his invention, who expends his time, labor, and money in discovering, perfecting, and patenting, in good faith, that which he and all others have been led to believe has never been discovered, by reason of the indifference, supineness, or willful act of one who may, in fact, have discovered it long before. See Woofter v. Carlson, 367 F.2d 436, 446, 151 USPQ 407, 415 (CCPA 1967). A holding that a party suppressed or concealed the invention does not require proof that the inventor was spurred into filing by the actions of another. However, spurring is an important equitable factor and evidence of spurring is relevant evidence supporting a holding of suppression or concealment. Accord. Paulik v. Rizkalla, 760 F.2d at 1275, 226 USPQ at 227.

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When there is an unreasonable delay between the completion of the invention to the filing of the patent application, there is a basis for inferring suppression and concealment. Lutzker v. Plet, 843 F.2d 1364, 1367, 6 USPQ2d 1370, 1371 (Fed. Cir. 1988).

The senior party argues:

. . . Rosenthal waited over twelve years to file a patent application even though he allegedly possessed an essentially complete application in 1982. Had Rosenthal not learned of a suspected competitor whom he could not control, it is uncertain when Rosenthal would have ever filed his application. . .

Although Rosenthal's inactivity is sufficient to support an adverse decision, the error of Rosenthal's inaction is compounded by his simultaneous aggressive suppression of others. For a time period exceeding four years preceding his application filing date, Rosenthal aggressively sought to suppress any disclosure of his alleged invention by those to whom he allegedly disclosed it. (Senior Party Magee Principal Brief page 10).

We agree with the senior party that there is evidence in the instant case that Rosenthal aggressively sought to suppress or conceal the invention of the count. In this regard, we note that between the reduction to practice on August 14, 1992 and the filing of the patent application, the junior party required several people to sign non-disclosure agreements (Rosenthal Record pages 10, 18, 26, 81, 140) .

There is also evidence that the junior party was spurred into

filing the patent application. Rosenthal testifies (Rosenthal record page 41) that he had a telephone conversation with Kenneth Conley on October 31, 1993 in which he became convinced that Conley had disclosed his invention to senior party Magee. Rosenthal also testifies (Rosenthal record page 32) that he began preparation on his patent application in November 1993. Had it not been for the telephone conversation with Conley, it is not clear when the junior party would have started preparing his patent application. As such, it appears that the junior party was spurred into filing the patent application. In this regard, we note that spurring may be stimulated by knowledge, not only of the issuance of a patent, but also of another party's possession of the inventive concept. See Woofter v. Carlson, 367 F.2d at 446, 151 USPQ at 415 (CCPA 1966).

Finally, in our view, the delay of two years and five months is a sufficiently long period to raise an inference of suppression and concealment. See Shindelar v. Holdeman, 628 F.2d 1337, 1342-43, 207 USPQ 112, 117 (CCPA 1980), cert. denied, 451 U.S. 984 (1981)(two-year and five month delay between reduction to practice and the filing of an application is prima facie unreasonable). This inference is strengthened by the evidence that the junior party intentionally kept the invention confidential and that the junior party

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was spurred into filing the patent application by the belief that a third party had disclosed the invention to the senior party.

However, even though an inference of suppression and concealment has been raised, an inventor's activities during the delay period may excuse the delay, e.g., he may have worked during the delay period to improve and perfect the invention disclosed in the patent application. Id at 952, 195 USPQ mat 705; Young v. Dworkin, 489 F.2d 1277, 1281 n.3, 180 USPQ 388, 391-92 n.3 (CCPA 1974); Frey v. Wagner, 87 F.2d 212, 215, 32 USPQ 239, 242 (CCPA 1937). These improvements, however, must be reflected in the final patent application. Id. The reason an inventor can excuse an unreasonable delay if he was working to perfect the invention is that the law does not punish an inventor for working to perfect his invention before giving it to the public. Frey v. Wagner, 87 F.2d at 215, 32 USPQ at 242. See also, Young v. Dworkin, 489 F.2d at 1281 n.3, 180 USPQ at 391-92 n.3.

In addition, if the junior party proves that he renewed activity on the invention before the earliest date to which the senior party entered the field, and proceeded diligently to filing his patent application, he may rely on the date of renewed activity to establish priority. Paulik v. Razkalla, 760 F.2d at 1273, 226 USPQ at 225 (Fed. Cir. 1985).

Activities during the delay

The junior party argues :

It is clear that by a date far earlier than any alleged date of Magee, Rosenthal had not only conceived of but had also reduced the invention of the Count to practice; namely, by at least August 14, 1992. Furthermore, between that date and the date Rosenthal filed his patent application, Rosenthal has established continuous activity, including separate acts of further corroboration of his reduction to practice on a number of dates between August 14, 1992, and Rosenthal's filing date of January 18, 1995, as well as additional reductions to practice and perfection of his invention prior to initiation of his preparation of a U.S. patent application on or about November of 1993, while such experimentation and development continued. [Rosenthal Opening Brief pages 28-29].

. . . even if Magee could somehow establish that Rosenthal did abandon, suppress or conceal his invention at some earlier date, Rosenthal's establishment of a conception and reduction to practice by August 14, 1992, renders that contention irrelevant. The same holds true, in fact, for each provable and corroborated reduction to practice by Rosenthal, on January 20, 1993; May 21, 1993; July 12, 1993; and April 11, 1994. [Rosenthal Opening Brief page 27].

The junior party has submitted the affidavit (Rosenthal Record page 34) of the inventor which generally discusses various activities of the inventor during the delay. However, the Rosenthal affidavit is not clear on what specific activities took place to perfect the invention, when the activities described took place and does not establish activity during the entire period of the delay. In addition some activities

described in the affidavit are not reflected in the Rosenthal '226 specification.

As illustrative of the lack of details regarding the dates of the activities described in the Rosenthal affidavit, we will discuss page 2 of the affidavit (Rosenthal Record page 35). This discussion, however, is only exemplary of the lack of detail regarding dates that exists in the Rosenthal affidavit.

On page 2 of the affidavit, Rosenthal states that he “made a rough prototype of a lens sheet with lens ridges on the viewing side wherein each ridge had parallel convex lens and angled planar portions.” He does not discuss what steps were taken to make this prototype. He gives no date or dates for the making of this prototype. This language of the affidavit follows the paragraph describing the August 14, 1992, reduction to practice. However, that does not necessarily mean that the activity took place after August 14, 1992. In addition, even if we assume that the activity took place after August 14, 1992, it is unclear when, after August 14, 1992, the activity took place.

As such, while Rosenthal testifies that a prototype with lens ridges was made, no details are provided as to what was done on any particular day during the period. We observe that Rosenthal states at page 1 of the affidavit (Rosenthal record page 34) that it took him two

weeks to make an earlier prototype. There is insufficient detail and explanation as to why it took from August 14, 1992 to January 20, 1994, more than five months to make another prototype. The lack of details regarding activities on particular dates is present throughout the entire affidavit.

In addition, even if we assume that the activities detailed in the Rosenthal affidavit were done in the periods between the dated reduction to practices described in the affidavit, there are periods of time which are not explained. The first such time period that is unexplained in the Rosenthal affidavit is between July 12, 1993, when he met with Dr. Bruce P. Rosenthal, and November 1993, when he began preparation on his patent application. Another time gap is between July 12, 1994, when he met with Paul Cote, and January 18, 1995, when the patent application was filed.

The junior party has submitted numerous affidavits of individuals that attest to viewing prototypes of the invention of the count. While these affidavits may be relevant to the issue of reduction to practice, they are not evidence of continuous activity to perfect the invention during the delay period. In fact, as the wording of each evidence describes the prototypes identically indicating that each witness viewed the same prototype, these affidavits are evidence that the junior party

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perfected the invention on August 14, 1992.

The junior party has not submitted documentary evidence, such as a laboratory notebook, which details what was done to perfect the invention on what date. The junior party has not submitted any evidence corroborating the activities described in the Rosenthal affidavit. It is an established principle that the testimony of the inventor must be adequately corroborated. Gould v. Schawlow, 363 F.2d 908, 918, 150 USPQ 634, 643 (CCPA 1966). Corroboration is additional evidence tending to confirm and strengthen or to demonstrate the probability of truth of the inventor's testimony. Corroboration is important because the opponent is rarely in the position to present evidence contradicting the inventor's statement. As such, without corroboration, we will not accord significant weight to the testimony of Rosenthal regarding the activities that took place between the reduction to practice on April 11, 1994 and the filing of the patent application on January 18, 1995.

When all the evidence is considered as a whole, it is our opinion that the junior party has not sufficiently rebutted the inference of suppression or concealment.

Resumed activity

The junior party may still be entitled to his reduction to practice

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date if he can establish that he resumed activity before the senior party entered the field and exercised diligence from the date of the resumed activity to the filing of the patent application. Paulik, 760 F.2d at 1273, 226 USPQ at 225.

The junior party has argued (Opening Brief at page 27) that any of the dates that Rosenthal showed the prototypes to a witness is a date of renewed interests or activity. The last such date just prior to the filing date of the senior party's application is April 11, 1994.

The Federal Circuit stated in Paulik:

We hold that such resumed activity must be considered as evidence of priority of invention. Should Paulik demonstrate that he had renewed activity on the invention and that he proceeded diligently to filing his patent application, starting before the earliest date to which Rizkalla is entitled—all in accordance with established principles of interference practice— we hold that Paulik is not prejudiced, by the fact that he had reduced the invention to practice some years earlier. (emphasis added).

In accordance with Paulik, if the senior party's filing date is utilized as the date the senior party entered the field, the junior party must show that he resumed activity prior to April 13, 1994 and proceeded diligently from that date until the patent application was filed on January 18, 1995. We will now examine the junior party's activities between April 11, 1994 and January 18, 1995.

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Assuming without holding that the activity which took place on April 11, 1994 is indicative of resumption of activity on the perfection of the invention or preparation of the patent application, the junior party must also prove that he proceeded diligently from the April 11, 1994 to file the patent application.

The junior party filed the patent application on January 18, 1995, over nine months after April 11, 1994, even though, according to the junior party, the preparation of the patent application began in November 1993.

The junior party has not submitted evidence to show activity from April 11, 1994 to the filing date of January 18, 1995, except for the general statement:

. . . I continuously conceived of and experimented on additional embodiments and processes. I was continually diligent, devising novel concepts, seeking to perfect my invention. I also incorporated my embodiments and processes into my patent application. [Rosenthal Record page 39].

General allegations are insufficient to demonstrate reasonable diligence. Wiesner v. Weigert, 666 F.2d 582, 588-89, 212 USPQ 721, 727 (CCPA 1981). A party seeking to show diligence must submit evidence that is specific as to dates and facts. Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949).

Although the Rosenthal affidavit describes the building of

prototypes, the affidavit is not specific about what acts directed to the building of prototypes took place on what date.

Rosenthal testifies that he met with Paul Cote on July 12, 1994, but not that any activity on the perfection of the invention or preparation of the patent application took place on that date (Rosenthal Record page 38).

In addition, as noted above, the Rosenthal affidavit includes a time gap between July 12, 1994 and January 18, 1995 where there is no evidence of any specific activity. This is a fatal flaw in the junior party's case to establish diligence because a party must account for the entire period during which diligence is required. Griffin v. Kanamaru, 816 F.2d at 626, 2 USPQ2d at 1362 (Fed. Cir. 1987); Gould v. Schawlow, 363 F.2d at 919, 150 USPQ at 643 (CCPA 1966).

For the foregoing reasons, it is our opinion that the junior party has not established that he proceeded diligently from April 11, 1994, to the filing of the patent application in January 18, 1995, nor that he resumed activity on the invention prior to the entrance of the senior party in the field.

The junior party has not adequately explained the delay of 2 years and 5 months from the reduction to practice on August 14, 1992 to the filing of the patent application on January 18, 1995, nor has it

proven that it resumed activity on the invention prior to the senior party's entrance into the field and proceeded diligently to file the application. As such, we conclude that the junior party suppressed or concealed the invention and is therefore not entitled to rely on its reduction to practice date of August 14, 1992 to prove priority. The junior party is restricted to its filing date of January 18, 1995.

Derivation

The junior party alleges that the senior party derived the invention from the junior party (Rosenthal Opening Brief page 34). The junior party alleges that his complete conception was communicated to Conley, and that Conley further communicated the conception to the senior party (Rosenthal Opening Brief page 34).

In order to establish derivation, the junior party must show (1) prior, complete conception of the claimed subject matter and (2) communication of the complete conception to the senior party. Cooper v. Goldfarb, 154 F.3d 1321, 1332, 47 USPQ2d 1896, 1905 (Fed. Cir. 1998); Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993); Hedgewick v. Akers, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974). Regarding communication, the standard for derivation is "whether the communication enabled one of ordinary skill

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in the art to make the patented invention.” Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1578, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

The junior party has the burden of establishing that there was a communication to Conley of the invention in such a way as to enable a person of ordinary skill in the art to make and use the invention and that Conley communicated the invention to the senior party in such a way as to enable a person of ordinary skill in the art to make and use the invention. This the junior party has not done.

In an affidavit submitted by the junior party (Rosenthal Exhibit 2159), Rosenthal testifies that he communicated the complete conception of his optical lens system to Conley in a meeting on July 12, 1990, by showing and explaining drawings thereof to Conley (Rosenthal Record pages 147-49). Rosenthal also testifies that on November 8, 1990, he sent a certified letter to Conley which included a drawing of the junior party’s optical lens system that had been shown to Conley during the meeting on July 12, 1990. The letter is said to be an additional communication of the conception (Rosenthal Record pages 149-50). A copy of the letter and drawing has been submitted as Exhibit 2011 (Rosenthal Record pages 75 and 210).

An examination of the letter reveals little concerning the

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elements of the invention that were disclosed. The letter states:

As we discussed on the phone, myself, George Turin and associates, are ready to move onto more optimal designs for our proprietary PRISMAFLOW (Image to See-thru lenticular material) as soon as you are able to produce first results in printable material. (Rosenthal record page, 75)

The drawing (Rosenthal Record page 211) that Rosenthal testifies was attached depicts several conic portions in a first line and straight lines connected to conic portions in a second line just below the first line. There is no mention in the letter of spaced-apart raised parallel portions nor are such portions depicted in the drawing. There is no mention in the letter, nor is there a depiction in the drawing of conic portions which permit the passage of light or that an object positioned beneath the sheet at a preselected distance can be viewed through the concave lens portions. In addition, the junior party has not directed our attention to an explanation in the record of what PRISMAFLOW image to see-thru lenticular material is. The letter and drawing standing alone are insufficient to enable a person skilled in the art to make and use the invention.

In addition, in an affidavit submitted by the senior party (Magee Exhibit 1024), Conley testifies that he met with Rosenthal in 1989 or 1990, but that Rosenthal had no drawings that he saw (Magee Record

page 1.4). Conley also testifies that no drawing was enclosed in the certified letter that he received from Rosenthal (Magee Record page 1.5). Conley further testifies that he did not receive any disclosure from

Rosenthal of a lenticular screen having concave lenses earlier than March 10, 1995.

In response to Conley's testimony, the junior party argues (Reply brief at page 12) that the senior party relies on the self-serving blanket denials of Conley who is essentially Magee's agent. However, the junior party has not proven that Conley is an agent of Magee. The record reflects that Conley is the owner of Micro Lens Technology and that he has offered his services in the past in preparing various optical equipment to both Rosenthal, the junior party and Magee, the senior party (Rosenthal Record pages 78 to 79).

In view of the foregoing, we find that the evidence as a whole is not of sufficient weight to establish that the junior party communicated the conception of the invention of the count to Conley in such a way as to enable a person of ordinary skill in the art to make and use the invention prior to the senior party's reduction to practice.

This precludes any finding that Conley, in turn, communicated the conception to the senior party. However, even if the junior party did

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communicate a conception to Conley, there is insufficient evidence that Conley communicated that conception to the senior party.

Rosenthal testifies that, during a telephone conversation prior to October 31, 1993, Conley acknowledged transmitting the concepts of the invention drawing and description to the senior party (Rosenthal Record page 150). However, Conley testifies that he has never communicated any information received from either one of the junior party or the senior party to the other (Rosenthal Record page 79). Specifically, Conley testifies that he is particularly sure he did not communicate any ideas or inventions received from the junior party to any other person, and particularly not to the senior party (Rosenthal Record page 82).

In addition, even if the junior party is correct that Conley acknowledged transmitting the concepts of the invention drawing and description to the senior party, such would not be enough to establish communication to the senior party required to prove derivation. As we discussed above, derivation requires that the communication be sufficient to enable the senior party to make and use the invention. There is no evidence, even if we believe the testimony of the junior party, concerning what Conley communicated to the junior party.

Accordingly, we find that the evidence fails to establish, either that Conley communicated the conception to the senior party, or that any information which may have been communicated constituted a complete and enabling conception.

As we have detailed above, although the junior party has proven a reduction to practice of the invention of the count prior to the filing date of the '055 application, the junior party has failed to prove complete communication thereof, either to Conley initially or to the senior party ultimately. Accordingly, the junior party has likewise failed to prove derivation.

Magee Preliminary Motion 3

The senior party seeks judgment against the junior party on the ground that the junior party's claims 1 through 8 and 11, which correspond to the count, are unpatentable under 35 U.S.C. § 103 over prior art.

A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The senior party argues (pages 1 to 2):

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Rosenthal's claims 1-8 and 11 corresponding to the count are unpatentable under 35 U.S.C. Sec. 103 over the combined disclosures of U.S. Patent No. 4,451,727 (Rosenthal) and U.S. Patent No. 5,303,525 (Magee) for all claims and the additional disclosures of U.S. Patent No. 4,028,109 (Lamberts et al) with respect to claims 1-2, U.S. Patent No. 3,565,733 (Leach) with respect to claims 3-5, U.S. Patent No. 4,920,039 (Fotland et al) with respect to claims 4 and 11 and U.S. Patent 4,993,790 (Vick) with respect to claims 6-8).

The senior party relies on the Magee '525 to provide the motivation to combine the teachings of the various references in addressing obviousness of the claims. As such, the Magee '525 reference forms a part of the references relied on in support of the senior party's obviousness argument with regard to each claim.

In a Decision on Preliminary Motions (Paper No. 111) a panel of the board stated on pages 36 to 37:

Rosenthal argues that the Magee '525 reference cannot be used against it, since Rosenthal alleges a date prior to the effective filing date of Magee '525 in its preliminary statement (Paper 75 at 7). . . . According to precedential opinion LaVeen v. Edwards, 57 USPQ2d 1416, 1420 (BPAI 2000), an opponent has two choices when responding to a 35 U.S.C. §102 (e) reference. 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. A second choice is for the opponent to present proofs under 37 CFR §1.131 together with its opposition. In effect, Rosenthal has asked for the first choice in its opposition in this interference.

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In an ORDER dated February 19, 2002 (Paper No. 119) (“Feb. 19th order”) an Administrative Patent Judge assigned to this interference stated at pages 2 to 3:

. . . In accordance with the above discussion, Rosenthal’s brief should include a section regarding Magee’s preliminary motion 3. Specifically, Rosenthal’s opposition filed in its brief should discuss the significance of any Rule 131 affidavit it intends to rely upon.

In the Opening Brief of the Junior Party Rosenthal, the junior party does include a section on the Magee ‘525 reference at page 25. In this section, the junior party states that the reduction to practice relied upon in the filed 131 affidavit (Rosenthal record page 277) is the same reduction to practice relied upon in the Rosenthal priority case and that it makes no difference whether the 131 affidavit or the priority case is utilized to swear behind the Magee ‘525 reference.

We note that evidence which is sufficient to prove reduction to practice for priority purposes is not necessarily sufficient to remove a reference from consideration in accordance with 37 CFR § 1.131. Reduction to practice to establish priority requires only that the evidence proves that the party constructed an embodiment that met each limitation of the count and that the embodiment worked for its intended purpose. Slip Track Systems Inc. v. Metal-Lite Inc., 304 F.3d 1256, 1265; 64 USPQ2d 1423, 1429 (Fed. Cir. 2002). Section 1.131

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requires that a party establish that the party reduced to practice the whole claimed invention prior to the effective date of the reference. In re Tanczyn, 347 F.2d 830, 832, 146 USPQ 298, 300 (CCPA 1965). In the instant case, the junior party argues that the evidence of priority is sufficient pursuant to 37 CFR § 1.131 to swear behind the Magee '525 reference.

The junior party does not discuss how the 131 affidavit establishes that the junior party had reduced to practice the invention of claims 1 through 8 and 11. However, as the priority evidence, in our view, is sufficient to establish a reduction to practice of the whole claimed invention prior to the filing date of Magee '525, it is not necessary to discuss the 131 affidavit.

In its motion urging the obviousness of the Rosenthal claims, the senior party argues that, Magee '525 provides the motivation or incentive to modify what the senior party regards as the primary reference (U.S. Patent No. 4,541,727) by disclosing a unitary sheet having a convex outer lens combined with an internal desirable image along with regularly spaced apart transparent sections wherein a second spaced apart image may be viewed so that an observer can view either the first or second image at various orientations exclusively (Magee motion 3, page 4).

Rosenthal testifies that on August 14, 1992, prior to the filing date of the Magee '525, he prepared a prototype which is depicted in Exhibit 2142 with conic lenses on the viewing surface and spaced-apart, raised parallel portions with composite image thereupon and indented transparent concave lenses in between which permitted the passage of light (Rosenthal Record pages 34 to 35). Rosenthal also testifies that he met with Lauter and showed him the prototype of his lenticular convex/concave sheet (Rosenthal Record page 35). In addition, Dr. Lauter testified that in the prototype he viewed on August 14, 1992 a viewer could see the sheet appear as an opaque image material at one angle of view and then from another angle of view, see the sheet as transparent, thereby providing a clear view through the sheet to objects behind it (Rosenthal Record page 14). Lauter also testifies that he viewed Rosenthal's packaging in which the lens sheet was used as a window and provided a view of an opaque image at one angle and a clear view at another angle through to the actual contents of the package (Rosenthal Record page 14).

In our view, the junior party's priority evidence establishes that he had reduced the invention of claims 3 and 11 prior to the effective date of the Magee '525 reference.

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In regard to the remaining claims, in our view, these claims recite differences from the basic invention reduced to practice on August 14, 1992, which would have been obvious at the time of the reduction to practice in view of prior art. It is proper to consider the obviousness between what is shown in a § 1.131 declaration and what is claimed because possession of what is shown in the declaration carries with it possession of variations and adaptations which would have been obvious to one having ordinary skill in the art. In re Spiller, 500 F.2d 1170, 1178 n.5, 182 USPQ 614, 620 n.2 (CCPA 1974).

The recitation in claim 1 of a parabolic lens would have been obvious to one of ordinary skill in the art in view of the invention reduced to practice on August 14, 1992 and the teaching in U.S. Patent 3, 565,733 (col. 5, lines 51-75) that a parabolic lense may be utilized in a lenticular lens system to correct spherical aberrations.

The recitation in claims 2, 5 and 7 of independently replaceable composite images on the first surface would have been obvious in view of the invention reduced to practice on August 14, 1992 and the teachings of U.S. Patent No. 4,451,727 ("Rosenthal '727"). Rosenthal '727 discloses at col., 2, lines 41 to 54 that one of the drawbacks of the existing lenticular lens systems with composite images such as the one reduced to practice on August 14, 1992 is that in order to change one of

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the images of the composite image, it is necessary to change the other image as well. At col. 3, lines 13 to 16, Rosenthal '727 teaches that the use of independent replaceable composite images allows one to replace one of the images on the surface without replacing the second image. In our view, a person of ordinary skill in the art would have been motivated to modify the invention reduced to practice to obtain the advantage of being able to replace one of the images which forms the composite image without replacing the other image.

Rosenthal '727 teaches that the images on a lenticular lens may be formed by printing, i.e. applying ink to the lenticular lens itself (col. 5, lines 46 to 52). U.S. Patent No. 4,920,039 to Fotland at col. 4, lines 28 to 31; col. 5, lines 3 to 6; Fig. 1 teaches that pigment may be applied to a planar portion of a lenticular lens sheet to form the image in a lenticular lens system. It would have been obvious to a person of ordinary skill in the art to form the image of the invention reduced to practice on August 14, 1992 by transferring ink to the planar portions as recited in claim 4 as this was a well known way of forming the image as evidenced by the teachings of Rosenthal '727 and Fotland.

The feature recited in claims 6 and 8 of utilizing a plurality of parallel diffractive lenses on a lenticular sheet would have been obvious in view of the teaching in the prior art such as U.S. Patent 4,993,790

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(col. 3, lines 33 to 51) that a diffractive lens can be utilized to change the direction of the path of light rays. A person of ordinary skill in the art would have been motivated to use such a feature in the invention reduced to practice on August 14, 1992 as a known alternative to the convex/concave lens to achieve the feature of the invention which was reduced to practice on August 14, 1992 that an object beneath the sheet could be viewed at one angle but not at another.

In view of the above evidence, it is clear that the junior party reduced the invention to practice as of the filing date of the Magee '525 patent. As such Magee '525 can not be used as a reference against junior party claims 1 through 8 and 11.

As each of the rejections posed by the senior party utilized the Magee '525 reference to provide the motivation for combining the various references, this motion is denied.

Magee Miscellaneous Motion 8

In this motion, the senior party seeks reconsideration of Magee Motion No. 4. Magee Motion No. 4 sought a judgment against Rosenthal that claims 1 through 8 and 11 which correspond to the count are unpatentable under 35 U.S.C. §112 for failure to disclose a best mode. This motion was denied in a Decision of Preliminary Motions

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(Paper No. 111) which was decided by a panel of this board. As the decision to deny Motion No. 4 was decided by a panel of the board, it governs further proceedings on this issue. (See Standing Order paragraph 20,1). Therefore, any consideration of the matter at this time is limited to a reconsideration of the original board panel decision. (See Standing Order paragraph 20.1 and 20.2.1).

A motion for reconsideration must specify with particularity the points believed to have been misapprehended or overlooked by the board panel in rendering its decision. 37 CFR 1.658(b); Standing Order paragraph 20.2.2.

Magee's Miscellaneous Motion 8 does not address any points in the Decision on Preliminary Motions as it was directed to Magee Motion No. 4 which the senior party believes was misapprehended or overlooked by the board panel. Rather, Magee Miscellaneous Motion 8 directs our attention to additional evidence that has been submitted in the priority phase of this interference. We decline to consider this additional evidence.

A party who files a preliminary motion may request testimony by way of a miscellaneous motion pursuant to CFR §1.635 if such is necessary to meet its burden. (See Standing Order paragraph 13.4.3). As such, the senior party had an opportunity to take testimony prior to

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the time of the filing of the preliminary motion. The senior party made no such request. We will not consider additional evidence as it is directed to this motion unless the senior party has shown good cause why the evidence was not submitted with the motion. (See Standing Order paragraph 20.2.2).

The senior party states that the new evidence on which it wishes to rely comprises the testimony of its own expert and the testimony of the junior party. Firstly, the senior party has not shown good cause why the testimony of its own expert could not have been submitted with the motion. Secondly, the senior party has not shown good cause why it did not request permission to take testimony pursuant to 37 CFR §1.635 prior to the filing of the preliminary motion to obtain the testimony of the junior party. Absent a sufficient showing of good cause, this evidence will not be considered at this point in the proceeding.

The motion is denied.

Rosenthal Motion No. 6

In this motion Rosenthal argues that Magee engaged in inequitable conduct during the prosecution of the Magee '519 application, by deliberately concealing his knowledge of the Rosenthal lenticular patents, i.e. U.S. Patent Nos. 4,034,555 and 4,541,727 and

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failing to list them as prior art. Rosenthal further argues that the Rosenthal patents were the closest prior art to the invention of the Magee patent applications.

A determination of whether there has been inequitable conduct is committed to our discretion. Critikon, Inc. v. Becton Dickinson Vascular Access, 120 F.3d 1253, 1255, 43 USPQ2d 1666, 1668 (Fed. Cir. 1997). A party alleging inequitable conduct on the part of its opponent bears a burden of proving its case by clear and convincing evidence. Refrac Int'l Ltd. v. Lotus Development Corp., 81 F.3d 1576, 1581, 38 USPQ2d 1665, 1669 (Fed. Cir. 1996).

“Inequitable conduct includes affirmative misrepresentations of a material fact, failure to disclose material information, or submission of false material information coupled with an intent to deceive.” PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc., 225 F.3d 1315, 1318, 56 USPQ2d 1001, 1003 (Fed. Cir. 2000).

“Applied to patent prosecution, inequitable conduct or fraud requires (1) a false representation or deliberate omission of a fact material to patentability, (2) made with the intent to deceive the patent examiner, (3) on which the examiner justifiably relied in granting the patent, and which (4) but for which misrepresentation or deliberate omission the patent would not have been granted.” C.R. Bard, Inc. v.

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M3 Systems Inc, 157 F.3d 1340, 1364, 48 USPQ2d 1225, 1242 (Fec. Cir. 1998).

The essence of the junior party's argument is that Conley told Rosenthal in a telephone conversation on October 31, 1993 that Magee already knew about the above-listed Rosenthal patents (Rosenthal record pages 41- 42). The only evidence of this communication between Rosenthal and Conley is the testimony of Rosenthal who is the junior party. As there is no corroboration of this communication, we do not accord substantial weight to this evidence.

However, even if we were to accord substantial weight to the Rosenthal testimony, it would not establish that Conley in fact communicated the patent numbers to the senior party.

Without demonstrating that the senior party knew of the Rosenthal patents during the prosecution of the Magee patent application, the junior party has failed to prove with clear and convincing evidence that the senior party made a deliberate omission of fact, much less that any action or inaction of the senior party was done with the intent to deceive the patent examiner. This motion is denied.

Conclusion

We have examined the evidence submitted by the junior party and considered the arguments made by the junior party regarding priority of invention. While we hold that the junior party actually reduced the invention of the count to practice on August 14, 1992, we also hold that the junior party is not entitled to rely on this reduction to practice because he suppressed or concealed the invention. We also conclude that the junior party has failed to prove that the senior party derived the invention of the count or was involved in inequitable conduct.

Motions to suppress

The senior party has filed a motion to suppress various parts of the Rosenthal record. We have determined that even when all the evidence the junior party has submitted into evidence has been considered, the junior party has failed to prove priority of invention. We, therefore, find in it unnecessary to consider this motion.

Judgment

As the junior party has failed to establish priority to the senior party's filing date of April 13, 1994, judgment is hereby entered against the junior party. Accordingly, Bruce A. Rosenthal is not entitled to a patent containing claims 1 through 8 and 11, which correspond to the count.

A copy of this decision shall be placed into Application No. 08/882,519 and the file history of U.S. Patent No. 5,642,226.

Richard E. Schafer)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
Murriel E. Crawford)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	

Interference No. 104,403

Sally C. Medley
Administrative Patent Judge

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MEC/tdl

Interference No. 104,403

Attorney(s) for Rosenthal:

Arnold H. Krumholz, Esq.
Lerner, David, Littenberg, Krumholz & Mentlik, LLP
600 South Avenue West
Westfield, NJ 07090

Attorney(s) for Magee:

Robert R. Keegan
Bank of America Plaza
One East Center St., Suite 217
Fayetteville, AR 72701