

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 81

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

WEN-LUNG CHANG,

Junior Party,
(Patent 5,828,034),

v.

KENNETH B. WINER,

Senior Party
(Application 08/769,467).

Patent Interference No. 104,492 (JL)

Before: McKELVEY, Senior Administrative Patent Judge, and
LEE and MEDLEY, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

FINAL DECISION

The interference is before a merits panel for entry of a final decision.

A. Background

The parties

1. The junior party is Wen-Lung Chang (hereinafter "Chang"), who is involved in the interference on the basis of his Patent 5,828,034.

2. The senior party is Kenneth B. Winer (hereinafter "Winer"), who is involved in the interference on the basis of his application 08/769,467.

3. The Winer application was filed on 20 December 1996.

4. The application which matured into the Chang patent was filed on 3 January 1997.

5. Thus, Winer is senior party by fourteen (14) days.

Burden of proof

6. Chang, as junior party, has a burden of establishing priority by a preponderance of the evidence. 37 CFR § 1.657(b).

Count

7. There is only one count.

8. Count 1 reads:

An apparatus for use with a computer system comprising:
an input device having a housing and an electric heating element disposed within said housing of said input device and thermally coupled to a heat conductive top portion of said input device for conduction of heat from said heating element to said heat conductive top portion.

Claims of the parties

9. The claims of the parties are:

Chang: 1-7
Winer: 1 and 6-25

10. The claims of the parties which correspond to the count, and therefore are involved in the interference (35 U.S.C. § 135(a)), are:

Chang: 1-7
Winer: 1 and 6-25

11. The claims of the parties which do not correspond to the count are:

Chang: None
Winer: None

Briefs and record

12. Chang has submitted (1) record and (2) a principal brief on the issue of priority.

13. Winer did not submit a record or a brief opposing Chang's principal brief.

14. The Chang record includes an AFFIDAVIT OF WEN-LUNG CHANG (hereinafter "Affidavit"), signed (1) on 13 October 2000 by Wen-Lung Chang and (2) on 23 October 2000 by his patent attorney, David E. Newhouse, Esq. (hereinafter "Newhouse").

15. The fact that Winer did not file a brief opposing Chang's principal brief is not an admission per se that Chang is entitled to prevail on priority. Rather, we consider Chang's

record in light of arguments made in his "unopposed" principal brief to determine whether Chang has met his burden of proof.

B. Priority facts

1. Chang had an idea with respect to a heated element to be used in conjunction with a computer, i.e., a computer keyboard or "mouse" containing a heating element to keep the user's hands warm.

2. In connection with his idea, Chang hired patent attorney Newhouse on 24 October 1996 (Affidavit, ¶ 18).

3. In due course, Newhouse prepared, or caused to be prepared, a draft patent application.

4. One version of a draft patent application (Ex 2024) was sent by Newhouse to Chang on 6 December 1996 (Affidavit, ¶ 19).

5. The draft contains an enabled description of an embodiment within the scope of the count (Ex 2024, see discussion concerning Figure 3 on pages 5-6, particularly when considered in light of the draft specification and drawings, as a whole).

6. Chang "immediately reviewed and edited" the draft patent application prepared by Newhouse and returned an edited version of the patent application (Ex 2025) to Newhouse (Affidavit, ¶ 22).

7. During a telephone conversation on 18 December 1996, Chang and Newhouse discussed adding "a forced air embodiment" to the patent application (Affidavit, ¶ 22).

8. Drawings for the patent application, said to have been prepared by Robert Romero, were received by Newhouse on 24 December 1996 (Affidavit, ¶ 23).

9. On 31 December 1996 (Ex 2034, page 4) or 2 January 1997 (Affidavit, ¶ 24), a warmed forced air embodiment was added to the draft patent application. The embodiment appears as Figure 9 and is described at column 3, line 61 through column 4, line 13 of Chang's involved patent.

10. On 2 January 1997, Newhouse had completed modifications to the draft patent application and on that day called Chang to come to his office to sign the patent application (Affidavit, ¶ 24).

11. Chang signed the patent application on 3 January 1997 (Affidavit, ¶ 24; see also the declaration filed with the patent application).

12. Chang's application 08/779,000 was filed with the Patent and Trademark Office via Express Mail 3 January 1997.

C. Discussion

To prevail on priority under the facts of this case, Chang must establish by a preponderance of the evidence (1) conception prior to 20 December 1996, coupled with reasonable diligence from a time prior to 20 December 1996 until Chang's constructive reduction to practice on 3 January 1997. 35 U.S.C. § 102(g). Chang's case for priority must be adequately corroborated. Singh v. Brake, 222 F.3d 1362, 1367, 55 USPQ2d 1673, 1676 (Fed. Cir. 2000); Kridl v. McCormick, 105 F.3d 1446, 1449, 41 USPQ2d 1686,

1689 (Fed. Cir. 1997); Coleman v. Dines, 754 F.2d 353, 360, 224 USPQ 857, 862 (Fed. Cir. 1985).

The definition of conception is set out in Mergenthaler v. Scudder, 11 App.D.C. 264, 731, 1897 Dec. Comm'r. Pat. 724, 731 (1897), and has been accepted by our appellate reviewing court, Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998); Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1375, 231 USPQ 81, 87 (Fed. Cir. 1986):

The conception of the invention consists in the complete performance of the mental part of the inventive act. All that remains to be accomplished in order to perfect the act or instrument belongs to the department of construction, not invention. It is, therefore, the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice that constitutes an available conception within the meaning of the patent law.

In our view, the discussion of Figure 3 on pages 5-6 of the draft specification in existence on 6 December 1996 (Ex 2024) constitutes a conception. The conception is corroborated because it was completed by Newhouse, who also signed the Affidavit. Under the facts of this case, as a matter of law, Chang has established a corroborated conception no later than 18 December 1996.

It is also our view that Chang has established reasonable diligence from (1) prior to Winer's filing date of 20 December 1996 until (2) Chang's filing date of, and constructive reduction

to practice on, 3 January 1997. The draft patent application was discussed in a telephone call between Chang and Newhouse on 18 December 1996--which is a date prior to 20 December 1996. Patent application drawings were received by Newhouse on 24 December 1996. Following some revisions to the draft patent application, Newhouse called Chang on 2 January 1997 to come to his office to sign the application. The application was filed on 3 January 1997. The facts establish reasonable diligence, particularly given that the events took place around and during the Christmas to New Year's Day time frame. Under the facts of this case, as a matter of law, Chang has established reasonable diligence.

D. Conclusions of law

1. Chang conceived the invention of the count within the meaning of 35 U.S.C. § 102(g) no later than 18 December 1996.

2. Chang constructively reduced the invention of the count to practice by filing a patent application on 3 January 1997. Automatic Weighing Machine Co. v. Pneumatic Scale Corp., 166 F. 288, 296-97, 1909 Dec. Comm'r Pat. 498, 506-7 (1st Cir. 1909) (definition of constructive reduction to practice through filing patent application).

3. Chang exercised reasonable diligence from no later than 18 December 1996 through 3 January 1997.

4. Chang has established that he made his invention prior to Winer within the meaning of 35 U.S.C. § 102(g).

E. Chang's principal brief

As earlier noted, only Chang filed a brief on the issue of priority. There is much about Chang's principal brief with which we disagree. For example, we disagree with Chang's construction of the scope of the count (brief, pages 4-5). We further disagree that any activity by Chang prior to the time he hired his patent attorney is corroborated. We believe the discussion, apparently related to suppression and concealment, is essentially irrelevant since the only significant dates are those after Chang hired his patent attorney. Accordingly, while we hold that Chang has sustained his burden, we base our holding solely on the facts and rationale set out above. Otherwise, we essentially disagree with arguments made on behalf of Chang in his principal brief.

F. Judgment

Upon consideration of the record, and solely for the reasons given herein, it is

ORDERED that judgment on priority as to Count 1 (Paper 1, page 49), the sole count in the interference, is awarded against senior party Kenneth B. Winer.

FURTHER ORDERED that senior party Kenneth B. Winer is not entitled to a patent containing claims 1 and 6-25 (corresponding to Count 1) of application 08/769,467, filed 20 December 1996.

FURTHER ORDERED that a copy of this paper shall be made of record in files of application 08/769,467 and U.S. Patent 5,828,034.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

<u>FRED E. MCKELVEY, Senior</u>)	
Administrative Patent Judge)	
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)	
<u>JAMESON LEE</u>)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
<u>SALLY C. MEDLEY</u>)	
Administrative Patent Judge)	

104,492
(via Federal Express)

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