The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 83

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

STAN WOJCIAK

Junior Party,
(Patent 5,922,783),

v.

YUKO NISHIYAMA and HIROYUKI MIKUNI

Senior Party
(Application 08/730,025).

Patent Interference No. 104,539

DECISION ON REHEARING and FINAL JUDGMENT

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

McKELVEY, Senior Administrative Patent Judge.

A. Conference call

A telephone conference call was held on 22 August 2001, at approximately 10:00 a.m., involving:

(1) Lawrence S. Perry, Esq., counsel for Wojciak;

(2) Louis Gubinsky, Esq., counsel for Nishiyama; and

(3) Fred E. McKelvey, Senior Administrative Patent Judge.

B. Discussion

1.

The conference call was placed by the parties to inform the board of the status of priority evidence. Wojciak was required to serve its evidence on the issue of priority on or before 23 July 2001 (Paper 78, Appendix, page 1, Time Period 2). During the conference call, counsel for Nishiyama pointed out that the time for Wojciak to serve priority evidence had expired. Counsel for Wojciak confirmed to the board that Wojciak would not be serving evidence on the issue of priority. Since Wojciak is junior party and will not file a priority case, it necessarily follows that the issue of priority must be resolved against Wojciak. The parties were advised that a judgment on the issue of priority would be entered against Wojciak.

2.

a.

There came a time during the interference when the board entered a MEMORANDUM OPINION and ORDER (Decision on Wojciak motion to suppress evidence) (Paper 72, entered 4 June 2001). As a result of the decision, certain evidence proffered by Nishiyama was excluded from evidence. Nishiyama, who will prevail on the issue of priority, timely filed a document styled NISHIYAMA REQUEST FOR RECONSIDERATION OF PAPER NO. 72 (Paper 81). By the document, Nishiyama seeks reconsideration of our decision (Paper 72) to exclude the evidence.

During the conference call, counsel for Wojciak was not in a position to state, one way or the other, whether Wojciak would seek judicial review (35 U.S.C. § 141-144 and 35 U.S.C. § 146). Both counsel were advised that if judicial review is to be sought, then the board would enter a decision on Nishiyama's request for reconsideration so that all issues could be presented to a reviewing court.

b.

The panel has determined that the best course of action is to decide Nishiyama's request for rehearing at this time.

Our decision to exclude data in the Nishiyama specification, to the extent the data was proffered to prove the truth of experimental work reported in the Nishiyama specification, was based in large measure on our assessment of the credibility of Nishiyama's witness Yuko Nishiyama. After weighing the credibility of Yuko Nishiyama, we found that we could not make a finding that Nishiyama had established by a preponderance of the evidence that Yuko Nishiyama conducted the experimental work said to be reproduced in the Nishiyama specification.

Nishiyama, in its request for reconsideration, asks us to conduct a renewed credibility assessment. We decline the invitation. All of the parts of the record referred to by Nishiyama in its request for reconsideration were considered by the panel at the time it entered its decision (Paper 72). Hence, no point raised in the Nishiyama request for reconsideration has been overlooked. Nor was any point misapprehended.

Nishiyama asserts in its request for reconsideration that cross-examination cleared up any ambiguity in the direct declaration testimony of Yuko Nishiyama. We disagree. We can agree that there is a possibility that Yuko Nishiyama conducted the experimental work reported in the specification. But, a possibility is not sufficient. Rather, a preponderance of the evidence must establish that Yuko Nishiyama conducted the experimental work. A preponderance of the evidence is based on probabilities, not mere possibilities.

Counsel for Wojciak indicated during the conference call that judicial review, review, would probably take place by civil action under 35 U.S.C. § 146. Whether further testimony in a civil action under § 146 would be admissible, and if admissible more convincing, is a matter which Nishiyama may wish to consider. However, we are not inclined in this case to change our mind on an issue which was resolved largely on the basis of a credibility assessment. While others might have resolved credibility differently, we are satisfied that our resolution was well within our role as fact finders. Accordingly, the Nishiyama request for reconsideration will be denied.

C. Order

1.

Upon consideration of NISHIYAMA REQUEST FOR RECONSIDERATION OF PAPER NO. 72 (Paper 81), and for the reasons given, it is

ORDERED that the request for reconsideration is <u>denied</u>.

Upon consideration of the fact that Wojciak has not timely served its evidence on the issue of priority, and has indicated that it will not serve any evidence on priority, it is

ORDERED that judgment on priority as to Count 2, the sole count in the interference, is awarded against junior party Stan Wojciak.

FURTHER ORDERED that junior party Stan Wojciak is not entitled to a patent containing claims 1-3 and 5-20 (corresponding to Count 2) of U.S. Patent 5,922,783, granted 13 July 1999, based on application 08/805,193, filed 27 February 1997.

FURTHER ORDERED that a copy of this paper shall be made of record in files of Nishiyama application 08/730,025 and U.S. Patent 5,922,783.

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

FRED E. McKELVEY, Senior Administrative Patent Judge	
RICHARD E. SCHAFER Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
SALLY C. MEDLEY Administrative Patent Judge	

104,539
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