BHS

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 40

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Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WEN-FOO CHERN

Junior Party
(Patent 5,182,529),

v.

HITOSHI YAMADA, TAMIHIRO ISHIMURA, and YOSHIO OHTSUKI

Senior Party
(Application 07/986,571).

Patent Interference No. 104,624

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

MEDLEY, Administrative Patent Judge.

FINAL DECISION AND JUDGMENT UNDER 37 CFR § 1.658(a)

A. Introduction

This interference was declared on September 11, 2000. The parties agreed to proceed directly to the priority phase of the interference. Chern filed a principal brief alleging a prior

date of invention (Paper 24). Yamada filed an opposition brief to Chern's principal brief (Paper 27). Chern filed a reply brief (Paper 30). Yamada filed a principal brief (Paper 28). Yamada's principal brief does not allege an earlier date of invention. Yamada's principal brief attacks Chern's case on priority. Chern filed an opposition to Yamada's principal brief (Paper 29). Yamada filed a reply (Paper 31). Oral argument was held on 7 December 2001.

B. Findings of fact

1. Chern is involved on the basis of Patent 5,182,529 ('529), granted 26 January 1993, based on application 07/847,331, filed 6 March 1992.

2. Yamada is involved on the basis of application 07/986,571, filed 7 December 1992.

3. Yamada has been accorded benefit for the purpose of priority of Japanese application 3-324809, filed 9 December 1991.

4. Chern real party in interest is Micron Technology, Inc. (Paper 9).

5. Yamada real party in interest is Oki Electric Industry Co., Ltd. (Paper 5).

6. The interfering subject matter pertains to a ring oscillator comprising an odd number of inverters.

7. Each inverter has an output and a primary and a secondary input.

8. The output of each inverter is connected to the primary input of a succeeding inverter.

9. The secondary input of each inverter is connected to the output of the Mth proceeding inverter, where M is an odd integer, equal or greater than three.

10. Count 1, the sole count of the interference, is identical to claim 1 of Chern and is as follows:

> A ring oscillator for use in a charge pump comprising N inverter stages each having a primary input, a secondary input, and an output, wherein N is an odd integer,
>
> the output of each inverter stage is coupled to the primary input of the following inverter stage in a serially-connected ring fashion such that the output of a last inverter stage is coupled to the primary input of a first inverter stage and forms an oscillating signal output, and
>
> the secondary input of each stage is coupled to the output of an Mth preceding inverter stage, wherein M is an odd integer greater or equal to three.

11. An example of a circuit of the count is shown in Chern's '529 patent Fig. 8 as follows:

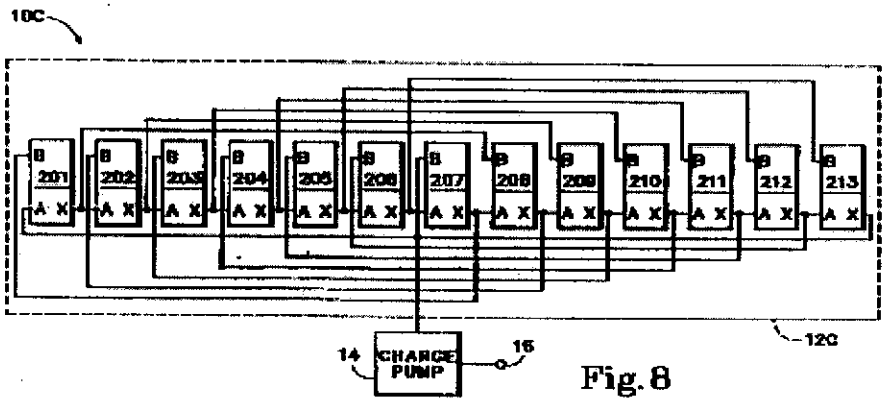


Fig. 8

12. Chern **Fig. 8** shows a ring oscillator **10c** for use in a charge pump **14.**

13. There are an odd number of inverter stages equal to 13.

14. The output of each inverter stage **X** is coupled to the primary input **A** of the succeeding inverter stage.

15. The output of the last inverter stage **213** is coupled to the primary input of the first inverter stage **201.**

16. The secondary input of each stage **B** is coupled to the output **X** of a 7^{th} preceding inverter stage (seven being greater than three).

17. The following claims were originally designated as corresponding to count 1:

Chern: 1-20

Yamada: 1-8, 18, 24, 25 and 30-35

18. The following claims were originally designated as not corresponding to count 1:

Chern: none

Yamada: none

Chern principal brief

19. Chern alleges a date of conception that is prior to Yamada's foreign priority date of December 9, 1991 (Paper 24 at 6).

20. Chern alleges that it was diligent from prior to December 9, 1991 to March 6, 1992, when Chern 5,182,529 was filed

(Paper 24 at 6).

Chern's conception

21. Chern alleges a date of conception on 14 May 1991 (Paper 24 at 6).

22. Chern submits a drawing (Chern Ex. 2002) that is dated 14 May 1991 in support of the alleged conception.

23. The drawing is dated, but not signed.

24. Chern Submits the affidavit of Wen-Foo Chern (the sole Chern inventor) who alleges that he made the drawing on 14 May 1991 (Ex. 2002, ¶ 5).

25. Wen-Foo Chern states that he prepared an Invention Disclosure form with an attached drawing and notes, which he signed and dated on 26 July 1991 (Ex. 2001, ¶ 7, Ex. 2002).

26. Attached to the Invention Disclosure form is a drawing dated 14 May 1991, and a copy of hand written notes dated 26 July 1991 (Ex. 2002).

27. The Invention Disclosure form is signed by Wen-Foo Chern and dated 26 July 1991 (Ex. 2002).

28. The Invention Disclosure form is also signed in the place for "WITNESS", and dated 1 August 1991.

29. Thomas M. Trent (Trent) testifies that the "WITNESS" signature was made by him (Chern Ex. 2010, ¶ 3).

30. Trent states that he "read the INVENTION DISCLOSURE and attachments and understood the construction and operation of the

invention described in the INVENTION DISCLOSURE" (Chern Ex. 2010, ¶ 3).

31. Trent states that he reviewed the attachments prepared by Wen-Foo Chern and that the attachments included a circuit drawing dated 14 May 1991, and recognized that the notes were written in Wen-Foo Chern's handwriting and dated 26 July 1991 (Ex. 2010, ¶¶ 3 and 5).

32. The Invention Disclosure form that Trent refers to in his affidavit is "Exhibit A" (Ex. 2010, ¶ 3).

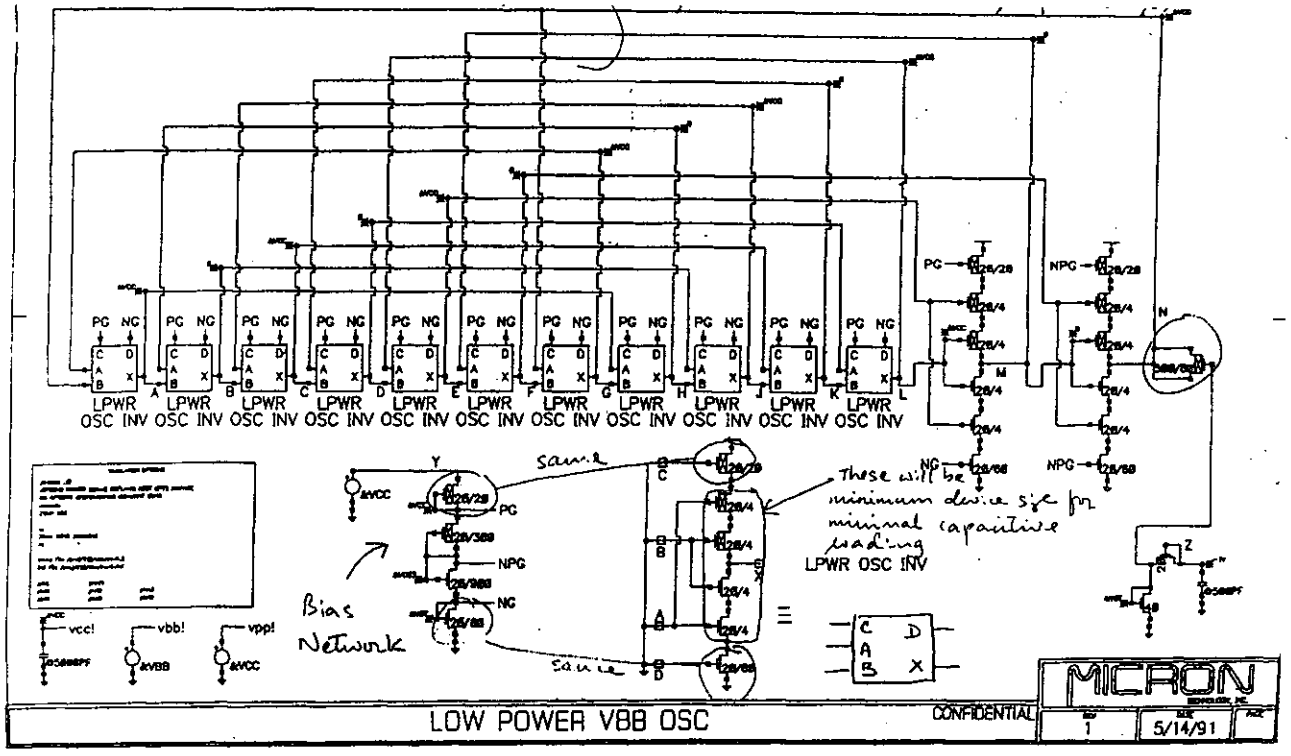
33. The Invention Disclosure form that Wen-Foo Chern refers to in his affidavit is "Exhibit A" (Ex. 2001, ¶ 7).

34. On the top of Chern Ex. 2002 (the Invention Disclosure form) the heading states "Trent Affidavit Exh. A"; "Chern Affidavit Exh. A".

35. Accordingly, the Invention Disclosure (including attachments) that Trent and Chern refer to in their respective affidavits is the one submitted as Ex. 2002.

36. The drawing, dated 14 May 1991 attached to the Invention Disclosure form is as follows[1]:

[1] The drawing, as seen here, does not include the handwritten notes at the top of the drawing as shown in Ex. 2002.



37. The drawing shows an oscillator connected to a charge pump.

38. The oscillator is made up of inverter circuits (annotated as **LPWR OSC INV**), with the output of each inverter circuit **X** connected to the input **B** of a succeeding inverter.

39. A secondary input **A** of each inverter is connected to the output **X** of a 7th proceeding inverter.

40. There are 13 inverters, where the output of the last inverter **N** is connected to the primary input **B** of the first inverter.

Chern acts of diligence

41. Chern alleges that the following events took place from

the time inventor Chern completed and signed the Invention Disclosure form (26 July 1991) to the time that the application for the involved Chern patent was filed (6 March 1992):

(a) **1 August 1991** - Chern discloses invention to Trent, who signs Invention Disclosure (Ex. 2002, Ex. 2010, ¶ 3);

(b) **6 August 1991** - Invention Disclosure is marked received prior to review by the Patent Review Committee at Micron (Ex. 2002);

(c) **9 August 1991** - Invention Disclosure is assigned Micron Docket No. 91-339 ('339) (Ex. 2003);

(d) **13 August 1991** -'339 is sent to Review Committee (Ex. 2003);

(e) **20 August 1991** - committee approves '339 for application drafting and filing (Ex. 2003; Ex. 2010, ¶¶ 4-7);

(f) **"on or about" 25 September 1991** - Counsel for Marger Johnson McCollom & Stolowitz, Peter J. Meza (Meza) is assigned to prepare a patent application for '339 (Chern Ex. 2003);

(g) **"on or about" 27 September 1991** - Meza receives from Micron '339 and another Invention Disclosure form for another Chern invention ('341) (Ex. 2011, ¶ 5);

(h) **"on or about" 27 September 1991** - Meza reviews '341 and '339 and determines that the Invention Disclosures for both are

incomplete (Ex. 2011, ¶¶ 5-7)[2];

(i) **"on or about" 1 October 1991** - Meza prepares a letter (Ex. 2012), requesting that Micron resend '339 and '341, and requesting Wen-Foo Chern's new home and business phone and fax numbers[3] (Ex. 2011, ¶ 7);

(j) **"sometime after" 1 October 1991** - Meza receives a complete copy of '339, including a written description of the invention, a copy of a 14 May 1991 circuit drawing, and handwritten notes describing concepts of the invention (Ex. 2011, ¶ 8);

(k) **"sometime prior" to 24 October 1991** - Meza makes attempts to find Wen-Foo Chern and contact him. Meza contacts Wen-Foo Chern and the two set a date of 2 November 1991 to meet and discuss '339 and '341 (Ex. 2011, ¶ 9);

(l) **"on or about" 24 October 1991** - Meza prepares a letter (Ex. 2004) to Chern outlining their 2 November 1991 meeting. The letter identifies five pending or proposed applications for discussion, including '339. Wen-Foo Chern receives the letter "on or about" 24 October 1991 (Ex. 2001, ¶ 13);

(m) **2 November 1991** - Meza and Chern meet to discuss those

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[2] Meza does not state what documents he originally received. Meza does not state why the '339 and '341 disclosures were incomplete, e.g. what was missing.

[3] Chern left Micron in August 1991 to work for Ramtron International Corporation (Ramtron) (Ex. 2001, ¶ 12).

cases identified in the letter (Ex. 2004). The subject matter of '339 is discussed in preparation for preparing and filing a patent application (Ex. 2011, ¶ 12);

(n) **"on or prior to" 18 November 1991** - Meza prepares amendment and assignment in another Micron case (90-145) (Ex. 2011, ¶ 14);

(o) **"on or about" 21 November 1991** - Meza prepares letter (Ex. 2014) to Micron regarding another Micron case (90-128) (Ex. 2011, ¶ 15);

(p) **26 November 1991** - Meza's second child is born - schedule and activities are reduced (Ex. 2011, ¶ 16);

(q) **"on or about" 2 December 1991** - Meza receives Notice of Allowance in another Micron case (90-145) (Ex. 2011, ¶ 14);

(r) **3 December 1991** - Meza prepares amendment in another Micron case (90-128) (Ex. 2011, ¶ 17);

(s) **"on or about" 5 December 1991** - Meza prepares letter (Ex. 2013) to Micron regarding Notice of Allowance received in (90-145);

(t) **"on or about" 6 December 1991** - Meza prepares a letter to Micron (Ex. 2005) and Chern regarding '340 (ex. 2011, ¶ 19);

(u) **"on or about" 6 December 1991** - Chern receives draft of '340 application;

(v) **9 December 1991** - Yamada files Japanese application

3-324809[4];

(w) **"on or about" 18 December 1991** - Meza prepares a letter to Micron (Ex. 2017) regarding Micron (91-095) application (Ex. 2011, ¶ 20);

(x) **21 December 1991 - 29 December 1991** Meza takes vacation (Ex. 2011, ¶ 21);

(y) **"on or about" 30 December 1991** - Meza prepares a letter to Micron (Ex. 2018) regarding a Micron application (91-130) (Ex. 2011, ¶ 22);

(z) **30 December 1991** - Meza works on preparing drawings and claims for '339 (Ex. 2011, ¶ 23; Ex. 2021);

(aa) **31 December 1991** - Meza completes '339 drawings and works on claims (Ex. 2011, ¶ 23; Ex. 2021);

(bb) **1 January 1991** - New Year's Day. Meza takes the day off (Ex. 2011, ¶ 23);

(cc) **2 January 1991** - Meza prepares background, summary and description of drawings for '339 (Ex. 2011, ¶ 23; Ex. 2021);

(dd) **3 January 1992** - Meza prepares claims (Ex. 2011, ¶ 23; Ex. 2021);

(ee) **4 January - 5 January 1992** - weekend. Meza performs no work (Ex. 2011, ¶ 23);

(ff) **6 January 1992** - Meza completes draft of '339 (Ex.

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[4] Yamada has been accorded benefit for the purpose of priority of Japanese application 3-324809, filed 9 December 1991.

2011, ¶ 23; Ex. 2021) and prepares letter to Chern (Ex. 2021) and Micron (Ex. 2019);

(gg) **10 January 1992** - Meza revises letters to Chern (Ex. 2006) and Micron (Ex. 2019) (Ex. 2011, ¶ 23);

(hh) **"on or about" 10 January 1992** - Chern receives a first draft of the '339 application (Ex. 2001, ¶ 16);

(ii) **10 January 1992 - 4 February 1992** - Chern reviews draft application for '339 and provides comments to Meza (Ex. 2001, ¶ 17);

(jj) **24 January 1992** - Meza and Chern speak on phone regarding the '339 draft application (Ex. 2011, ¶ 25; Ex. 2001, ¶ 17; Ex. 2021);

(kk) **10 February 1992** - Meza speaks with Micron representative to report the status of several cases, including '339 (Ex. 2011, ¶ 26; Ex. 2021);

(ll) **"sometime prior to" 13 February 1992** - Meza receives written comments from Chern regarding '339. Meza works on rewrite that day (Ex. 2011, ¶ 27, Ex. 2021);

(mm) **14 February 1992** - Meza finishes second draft and prepares letter to Chern (Ex. 2011, ¶ 27; Ex. 2021; Ex. 2008);

(nn) **17 February 1992**- Meza has conference call with Micron representative regarding '339 (Ex. 2021)[5];

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[5] Meza does not testify as to the phone call. Chern directs us to Meza's billing record (Ex. 2021). The entry there is as

(oo) **"on or about" 24 February 1992** - Chern receives letter from Meza enclosing final draft and declaration and assignment documents for '339 (Ex. 2001, ¶ 18; Ex. 2008);

(pp) **24 February 1992 - 26 February 1992** - Chern reviews final draft (Ex. 2001, ¶ 19);

(qq) **26 February 1992**- Chern executes documents and sends executed documents to Meza (Ex. 2001, ¶ 19, Ex. 2009);

(rr) **6 March 1992** - Meza files application for '339 (Ex. 2011, ¶ 29).

C. Decision

Chern has the burden of establishing priority by a preponderance of the evidence. 37 CFR § 1.657(b).

Priority of invention belongs to the first party to reduce the invention to practice unless the other party can establish that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing the invention to practice. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000). Here, Chern does not allege an earlier actual reduction to practice. Rather, Chern relies on its 6 March 1992 filing date to demonstrate a constructive reduction to practice. Chern's constructive reduction to practice is after Yamada's Japanese 9 December 1991 filing date.

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follows: "PJM Telephone conference with J. Smith".

Chern may prevail if Chern can establish that it was the first to conceive the invention and that it exercised reasonable diligence from a time prior to Yamada's conception until its own reduction to practice. 35 U.S.C. § 102(g); 204 F.3d at 1097, 53 USPQ2d at 1698. Chern must establish that it conceived prior to Yamada's 9 December 1991 Japanese filing date and that Chern was reasonably diligent from a time prior to 9 December 1991 until Chern's effective filing date of 6 March 1992.

Conception

Conception is the formation in the inventor's mind of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice. Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998). The inventor must recognize and appreciate the invention at the time, i.e., there is no nunc pro tunc conception. Breen v. Henshaw, 472 F.2d 1398, 1401, 176 USPQ 519, 521 (CCPA 1973). Corroboration is required to prove conception. Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993).

Chern alleges that it conceived of the invention and had independent corroboration of the conception by at least August 1, 1991. To demonstrate conception and corroboration of the conception, Chern relies on the Invention Disclosure (Ex. 2002) and the affidavits of Chern (Ex. 2001) and Trent (Ex. 2010).

Yamada makes several arguments as to why Chern has failed to

establish, by a preponderance of the evidence, its conception. The first of these is that the Invention Disclosure fails to describe the invention with particularity (Paper 27 at 2, Paper 28 at 5).

Specifically, Yamada argues that the Invention Disclosure (Ex. 2002):

> [F]ails to describe every feature recited by the count with particularity because it lacks explanations of the cryptic statements therein regarding the operation of the circuits discussed and depicted[,] the numerous components cited and depicted, how the components in the circuits operate individually and together, how the experimental measurements were obtained and what they mean, and how the documents of Exhibit 2002 relate to each other. In addition, several contradictions exist between the documents of Exhibit 2002, and no explanation is provided regarding these contradictions. (Paper 28 at 6).

Yamada has failed to sufficiently explain why the Invention Disclosure does not, by itself, describe with particularity the elements of the count. Specifically, Yamada has failed to sufficiently explain why the "first circuit diagram"[6] of the drawing attached to the Invention Disclosure form fails to show the elements of the count.

Yamada does not specifically address whether the "first circuit diagram" does or does not illustrate the elements of the

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[6] The "first circuit diagram" is what Yamada refers to as the portion of the drawing that includes the inverters connected together and connected to the charge pump. The remaining depictions in the drawing and handwritten notes are not part of what Yamada has labeled the "first circuit diagram" (Paper 28 at 10).

count[7]. Instead, Yamada argues that the drawing itself, fails to provide an explanation of how any of the circuit diagrams or handwritten notations in the drawing relate to the invention of the count (Paper 28 at 12).

It is not apparent why such an explanation is necessary. The "first circuit diagram" of the drawing shows the elements of the count. The "first circuit diagram" shows a ring oscillator comprising an odd number (13) of inverters (labeled **LPWR OSC INV**). The oscillator is connected to a charge pump. Specifically the output of the last inverter (annotated as "**N**") is connected to a charge pump (annotated as "**Z**"). The output of the last inverter is also connected to an input of the first inverter. The output of each inverter **X** is connected to the input **B** of a succeeding inverter. A secondary input **A** of each inverter is connected to the output **X** of a 7th proceeding inverter. (Findings 36-40).

A picture can be worth a thousand words. The "first circuit diagram" by itself, without further explanation, describes an embodiment within the scope of the count. Yamada has failed to sufficiently demonstrate why one having ordinary skill in the art would need an explanation to understand what the drawing shows.

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[7] During oral argument, counsel for Yamada indicated that the "first circuit diagram" did show the elements and connections recited in the count.

Drawings alone may provide a written description of an invention as 35 U.S.C. § 112 requires. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991). If drawings alone are sufficient to satisfy the written description requirement of 35 U.S.C. 112, ¶ 1, then obviously certain drawings do not need further explanation.

Yamada additionally argues that (1) there is no indication that the drawing was attached to the Invention Disclosure form (Paper 28 at 9), and (2) the drawing is unsigned and not witnessed (Paper 28 at 11).

Apparently, Yamada is challenging the authenticity of the drawing[8]. Chern has provided the declarations of Wen-Foo Chern and Trent to establish that Wen-Foo Chern made the drawing and that the drawing was attached to the Invention Disclosure form that both Wen-Foo Chern and Trent signed (Findings 30-35). Chern, then has sufficiently authenticated the drawing for it to be admissible in evidence.

During an interference, a party is given an opportunity to object to the admissibility of an opposing parties evidence (Paper 1, Notice Declaring Interference, ¶ 33). Yamada did not

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[8] F.R.E. 901(a) sets out the general rule for authentication:

> The requirement of authentication or identification as a condition precedent to admissibility is satisfied by evidence sufficient to support a finding that the matter in question is what its proponent claims.

object to the evidence submitted by Chern. Furthermore, Yamada did not cross examine Wen-Foo Chern or Trent. Based on the record before us, Yamada has failed to sufficiently demonstrate that the facts presented by Chern are inaccurate.

Yamada further argues that the "third note" of the handwritten notes attached to the Invention Disclosure form (Ex. 2002, R-14) does not describe and is contradictory to what is shown in the "first circuit diagram" (Paper 28 at 17). Yamada fails to sufficiently demonstrate that the third note refers to the "first circuit diagram". Part of the "third note" is a block circuit diagram with annotations that are referenced in the handwritten notes. The same annotations do not appear in the "first circuit diagram". Accordingly, a more reasonable interpretation of the "third note" is that it refers to that circuit that is part of the "third note" and not the "first circuit diagram". Yamada has failed to sufficiently demonstrate otherwise.

Yamada makes several additional arguments regarding (1) the other circuits on the drawing, (2) the handwritten notes on the drawing, (3) the handwritten notes attached to the Invention Disclosure form and, (4) the handwritten notes made on the Invention Disclosure form. Essentially, Yamada argues that the information provided for in items 1-4 is inaccurate, incomplete, inconsistent, and fails to describe the count (Paper 28 at 7-22).

The additional arguments made by Yamada regarding items (1)-

(4) fail to demonstrate that the "first circuit diagram" does not provide a written description of the count. As stated above, Yamada does not argue that the "first circuit diagram" does not describe the count. Yamada does not argue that the components shown in the "first circuit diagram" are not what they appear to be.

Not every single paragraph or separate note within the four corners of Chern's Invention Disclosure must describe the same circuit, or describe the elements of the count. All that is necessary is that somewhere within the document there exists a description for at least one embodiment of the subject matter of the count. Accordingly, we need not and have not considered each additional argument made regarding items (1)-(4).

Yamada argues that the affidavits that Chern has submitted fail to explain with particularity the Invention Disclosure as required by Rule 671(f) (Paper 28 at 22).

Wen-Foo Chern indicates that he made the drawing that is attached and a part of the Invention Disclosure (Findings 24, 33 and 34). Trent indicates that he read and understood the Invention Disclosure (Finding 30). Trent further states that the Invention Disclosure he saw included the drawing that is part of Chern Ex. 2002 (Findings 31 and 32).

While Wen-Foo Chern does not describe how each element of the count relates to the elements in, for example, the "first circuit diagram", he does state that the drawing demonstrates

conception of the invention of his involved patent (Ex. 2001, ¶ 5). Trent states that Wen-Foo Chern disclosed an invention to him (e.g., the Invention Disclosure) that is embodied in the Chern involved patent (Ex. 2010, ¶ 3). In its brief, Chern argues that "[e]ven a casual comparison between Chern's rudimentary drawing (R-13) and the '529 patent drawing Figure 8 leaves no doubt that the invention originally conceived by Chern on May 14, 1991 corresponds precisely to the invention of the count in this interference" (Paper 24 at 16).

Rule 671(f) states that:

> The significance of documentary and other exhibits identified by a witness in an affidavit or during oral deposition shall be discussed with particularity by a witness.

Rule 671(f) specifies that the significance of the exhibit be discussed with particularity. Both Wen-Foo Chern and Trent discuss the significance of the Invention Disclosure as discussed above. The purpose for having exhibits described with particularity is so that what the exhibits show, in substance, can be understood. The level or extent of "particularity" is not specified, and rightfully so. It need only be sufficient for a fair understanding of the substance of the exhibit. Here, the "first circuit diagram" shown in the exhibit requires no further explanation. Yamada has failed to sufficiently demonstrate that something else is required.

Yamada lastly argues that the drawing and notes of the

Invention Disclosure are not corroborated (Paper 28 at 27). Yamada argues that it is unclear that Chern made the drawing and notes, since neither were signed by Chern or witnessed. As explained above, Chern did sign the Invention Disclosure, and Chern testified that (1) the drawing and notes were his and that (2) the drawing and notes were attached to, and a part of, the Invention Disclosure (Findings 33-35).

The testimony of Trent corroborates Chern's story. Trent testifies that he signed the Invention Disclosure and that the drawing and notes were part of the Invention Disclosure that he signed (Findings 32, 34 and 35). Trent further testifies that he is able to recognize Chern's handwriting and that the handwritten notes were made by Wen-Foo Chern (Finding 31). The Information Disclosure, which includes the drawing and notes, was signed by both Trent and Chern. It is not apparent, and Yamada has failed to explain, why every page of the Information Disclosure need be signed.

Yamada, through counsel, argues that it may be that the drawing and notes attached to the Invention Disclosure were really not the work of Chern (Paper 28 at 28). Yamada further argues that it is doubtful that Trent could, after ten years, be able to recognize Wen-Foo Chern's handwriting, or that Chern's handwriting was so distinct to make it memorable to Trent. The arguments are based on attorney argument alone. Yamada did not cross examine Wen-Foo Chern or Trent to determine if there was

more to the story than that conveyed by Chern. Yamada has not presented a sufficient basis for us to find that the drawing and the notes are not the work of Chern.

Yamada further argues that the record is unclear as to whether the drawing and notes were actually attached to the Invention Disclosure or even existed contemporaneously with the Invention Disclosure (Paper 28 at 30). Yamada directs us to that portion of the Invention Disclosure form (paragraph 3) that states the following:

> INFORMATION CONCERNING THE INVENTION: Attach complete description, including drawings or sketches and articles relevant to the invention. (Ex. 2002, R-11).

Yamada argues that below this statement is a space to list or discuss any attachments that may be attached to the Invention Disclosure form. Yamada points out that although all of the other parts of the form are complete with handwritten entries, there is nothing in the space provided below part 3. Yamada submits that this lack of entry below part 3 indicates that, at the time Wen-Foo Chern and Trent signed the Invention Disclosure form, there were no attachments. The fact that Meza did not receive a complete Invention Disclosure (Finding 41(g)-(i)), Yamada argues, further indicates that the drawing and notes were not originally attached to the Invention Disclosure form (Paper 28 at 31).

Yamada's arguments are not persuasive. First, and foremost,

both Chern and Trent testify that when they signed the Invention Disclosure, the drawing and notes were attached to the form (Findings 30-35). That there were no handwritten entries below part 3 on the form is not an indication that something was not attached. The other parts of the form end in a colon (:), or question mark (?), or ask for an entry to be made (Please identify related invention disclosures ...). Unlike all of the other parts of the form that invite entry of notes, the third part ends with a period. There is no invitation to provide comments below part 3. Part 3 asks the reader to attach, not describe, drawings, descriptions, etc. All indicating that no entry was required.

Meza testifies that the Invention Disclosure was incomplete (Ex. 2011, ¶ 7). Meza does not indicate why the Invention Disclosure was incomplete. Thus, Yamada is guessing that the drawing and notes were not attached to the Invention Disclosure form when it was sent to Meza. Even if the drawing and notes were not attached at the time Meza received the Invention Disclosure, that does not negate the fact that both Chern and Trent testified that the drawing and notes were attached at the time Trent signed the Invention Disclosure on 1 August 1991.

For the reasons given above, Chern has established by a preponderance of the evidence that it conceived of the invention of the count at least by 1 August 1991, which is prior to Yamada's effective filing date of 9 December 1991. Yamada has

failed to sufficiently rebut Chern's prima facie showing.

Diligence

Chern need show diligence from a time prior to 9 December 1991, until its filing date of 6 March 1992, e.g. the "critical period". 35 U.S.C. § 102(g). Chern submits evidence of events that allegedly demonstrate that Chern was diligent during the critical period (Finding 41).

There is at least one particular time period during the critical period that is troublesome. Wen-Foo Chern testifies that he received a draft of his '339 application on or about 10. January 1991 (Finding 41(hh)). Wen-Foo Chern further testifies that from 10 January to 4 February he reviewed the draft and provided comments to Meza. There is evidence of a phone call between Meza and Wen-Foo Chern that occurred on 24 January 1992 (Finding 41(jj)). Meza testifies that sometime prior to 13 February 1992, he received written comments from Wen-Foo Chern regarding '339 (Finding 41(ll)).

Based on the evidence presented by Chern, Chern has failed to sufficiently demonstrate that it was diligent during at least the time from 10 January 1992 until 13 February 1992. During at least part of that time, Wen-Foo Chern states that he reviewed the '339 draft application. Chern provides no convincing explanation as to why it took Wen-Foo Chern approximately one month to review the draft application and to return it to Meza. Absent a convincing explanation, we decline to speculate or make

any inferences.

At first glance, it would appear that this case is analogous to Sletzinger v. Lincoln, 410, F.2d 808, 161 USPQ 725 (CCPA 1969), where a determination was made that a period of almost two weeks (from June 27 to July 9) was not too long for inventors to review a draft application. In Sletzinger, however, three inventors reviewed the draft application. Here, there was only one. More importantly, in Sletzinger, evidence was presented to excuse the inference that the amount of time to review the draft application was excessive. Specifically, Judge Rich, speaking for the CCPA stated:

> That the total period of review by the inventors was not unreasonable in view of the length of the application and the nature of the technical subject matter appears clear from the affidavit of the Patent Department Section Head... (Emphasis added). 410 F.2d at 812, 161 USPQ at 728.

In Sletzinger, the Patent Department Section Head provided testimony regarding how long it would take a single inventor to review an application. The Patent Department Section Head additionally explained that the inventors were aware of the importance of careful review. The Patent Department Section Head also stated that the application was lengthy and the subject matter technically difficult.

In contrast, Chern has failed to direct us to evidence that would account for the approximately one month period of time during which Wen-Foo Chern had the draft application in his possession. Based on the record, there is no demonstration that

the application was lengthy, or that the subject matter was particularly difficult. Indeed, the final product, e.g. the Chern patent is less than four pages in text (absent the drawings). There is no testimony from any "Patent Department Head" to testify that it would normally take so much time for an inventor to review a patent application in this art.

Absent such an explanation, we can only come to the conclusion that Chern has not sufficiently shown that it was diligent during that time. The reasonable diligence standard "balances the interest in rewarding and encouraging invention with the public's interest in the earliest possible disclosure of innovation." Griffith v. Kanamaru, 816 F.2d 624, 626, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987). Here, Chern has failed to sufficiently demonstrate that it was reasonably diligent such as to provide the public with the earliest possible disclosure of its invention. Where the first to conceive has failed to demonstrate that it was reasonably diligent during the critical period, there is no reason, or justification, to allow it to prevail over another who is the second to conceive but who has made prompt disclosure by the filing of a patent application.

Our decision is consistent with the one in D'Amico V. Koike, 347 F.2d 867, 146 USPQ 132 (CCPA 1965), where an unexplained one month period of time during the critical period was found to be excessive. In D'Amico, Judge Rich, again speaking for the CCPA stated that:

We agree with the general principles which appellant seems to be advocating, namely, that a rule of reason should be followed in cases of this kind and that courts should be somewhat liberal in determinations of diligence of attorneys and of their clerical and stenographic staffs, since the law cannot presume that such people can immediately begin and expeditiously perform their duties as soon as work appears on their desks. Nevertheless we think that appellant is attempting to use those principles as substitutes for record evidence, of which there is very little.

As we view this appeal, appellant asks us to rule that even after a patent application is in draft form, with finished drawings, the acts of (1) considering and approving the application by a supervisory attorney, (2) final checking, (3) placing the approved and checked draft application in final form, and (4) preparing the formal papers for execution constitute "reasonable diligence," within the meaning of 35 U.S.C. 102(g), if performed within a period of two months.

Obviously such a ruling must depend on a great number of circumstances such as, but not limited to, complexity of the invention, length of the application, detail of the drawings, experience, workload and availability of the attorney, availability of the draftsman and the inventor during the period involved, size of the attorney's staff, procedure and policy in reviewing the application, type and thoroughness of the review, number of people involved in preparing the application and their location, and the number of changes which the subject application underwent.

Certainly, evidence as to all these factors need not be of record; possibly evidence as to only one or two would suffice in certain cases. However, in the present appeal we know essentially nothing about the handling of the application during the two-month period except that (a) Breen did in fact "consider and approve" the application, and (b) the other work, i.e., checking, placing in final form, and preparing the formal papers, was done sometime. There is no end to the inferences which might be drawn from the scanty record before us and we prefer not to indulge in them, but we cannot overlook the fact that Koike's priority date falls nearly midway in this two-month period and it is certainly possible that all of D'Amico's activity took place during the period prior to October 29, whereupon the application lay idle for nearly one month awaiting execution by the inventor. Be that as it may, that month is the critical month and the record contains no evidence, even of the weakest sort, whether in it anything occurred.

Like D'Amico, Chern provides little evidence as to what

occurred during the approximately one month period that Wen-Foo Chern had the draft application, or why it took Wen-Foo Chern so long to review the draft application. We only know that on 24 January 1992, Meza and Wen-Foo Chern discussed the application.

There are other unaccounted for gaps during the critical period. From 2 November 1991 until 30 December 1991, Meza did no work on the '339 application. Chern argues that Meza was working through his backlog on other cases, and on related cases (Paper 24 at 19). While the diligence law permits an attorney to work in this manner[9], the law also specifies that "the attorney has the burden of keeping good records of the dates when cases are docketed as well as the dates when specific work is done on the applications." Bey v. Kollonitsch, 806 F.2d 1024, 1028, 181 USPQ 967, 970 (Fed. Cir. 1986).

Here, there is no account for the time from 6 December 1991 until 18 December 1991. Meza states that "on or about" 6 December 1991 he prepared a letter to Chern regarding a draft application '340 (Finding 41(t)). Based on the record, no work was performed until 18 December 1991, at which time Meza prepared a letter to Micron regarding an unrelated application (91-095) (Finding 41(w)). Chern argues that Meza worked on the 91-095 application, an older case on Meza's docket, prior to the time

[9] See Bey v. Kollonitsch, 806 F.2d 1024, 1028, 181 USPQ 967, 970 (Fed. Cir. 1986), for a discussion regarding reasonable diligence and work on related cases.

Meza prepared the letter on 18 December 1991 (Paper 24 at 17). In support of its argument, Chern directs us to the letter Meza sent to Micron regarding the 91-095 draft application (Ex. 2017).

The letter by itself, however, does not indicate that Meza worked on the application for substantial parts of every working day from 6 December 1991 until 18 December 1991. The letter merely indicates that Meza sent a draft application to Micron. Meza does not testify that he was working on the 91-095 application during the time of 6 December 1991 until 18 December 1991. Chern fails to direct us to evidence that indicates that Meza was working on the 91-095 application, or indeed, that Meza was doing anything from 6 December 1991 until 18 December 1991.

There is also a gap of time from when Meza completed the final draft of '339 on 14 February 1992 until "on or about" 24 February 1992, when Wen-Foo Chern received the final application for execution. Chern argues that on 17 February 1992, Meza had a conference call with a Micron representative regarding the '339 application (Finding 41(nn)). Meza does not testify as to the conference call. Chern relies solely on the billing records for '339 that indicate that a call took place between Meza and J. Smith on 17 February 1992. Assuming that a call was made to discuss the status of '339, there is no account for the other nine days, or the rest of the time on 17 February 1992.

These two additional gaps alone may not be enough to conclude that Chern failed to sufficiently demonstrate that it

was diligent. However, when coupled with the approximately one month period of time that the draft application was in Wen-Foo Chern's possession, we conclude that Chern has failed to sufficiently demonstrate that it was diligent during the critical period.

D. Judgment

Upon consideration of the record, it is

ORDERED that judgment on priority as to Count 1 (Paper 1, page 49), the sole count in the interference, is awarded against junior party WEN-FOO CHERN.

FURTHER ORDERED that junior party WEN-FOO CHERN is not entitled to a patent containing claims 1-20 (corresponding to the count) of U.S. patent 5,182,529 issued 26 January 1993, based on application 07/847,331, filed 6 March 1992.

FURTHER ORDERED that if there is any settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

FRED E. MCKELVEY, Senior
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

SALLY C. MEDLEY
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

cc (via federal express):

Attorney for Chern:

Thomas J. D'Amico, Esq.
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L Street, N.W.
Washington, D.C. 20037

Attorney for Yamada:

Robert J. Frank, Esq.
VENABLE
1201 New York Avenue, N.W.
Suite 1000
Washington, D.C. 20005-3917