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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

STEVEN SPEARS
and DAVID WALKER

MAR 13 2002

Junior Party,
(Patent 5,666,156)¹,

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

DAVID E. HOLLAND and
GAVIN W. SCHUTZ

Senior Party
(Application 09/145,810)²

Patent Interference No. 104,681

Before LEE, GARDNER-LANE and MEDLEY, Administrative Patent Judges.

LEE, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

¹ Based on application 08/418,371, filed April 7, 1995.

² Filed September 2, 1998. Accorded the benefit of application 08/066,996, filed May 24, 1993. The real party in interest is 4MC-Burbank, Inc.

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Introduction

Junior party Spears initially filed preliminary motions 1 and 2. After dismissal of those preliminary motions, junior party Spears filed, in their place, preliminary motions 3, 4 and 5. Senior party Holland filed no preliminary motion. Neither party requested oral argument. None is deemed necessary.

Spears' preliminary motion 3 seeking judgment against all of Holland's claims corresponding to the count is granted, but only on the ground of anticipation over U.S. Patent No. 5,353,119.

Spears' preliminary motion 4 asserting no interference-in-fact is denied.

Spears' preliminary motion 5 seeking to designate its claims 8-12 as not corresponding to the count is denied.

Junior party Spears having failed to allege, in its preliminary statement, a date of invention prior to the effective filing date of senior party Holland, it is now time appropriate to enter judgment against both parties.

Findings of Fact

1. This interference was declared on April 9, 2001.
2. Junior party Spears is involved on the basis of its Patent No. 5,666,156, based on application 08/418,371, filed April 7, 1995.

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3. Senior party Holland is involved on the basis of its application 09/145,810, filed September 2, 1998, and accorded the benefit of application 08/066,996, filed May 24, 1993.

4. The sole count in the interference is defined as follows:

Claim 21 of Application 09/145,810

or

Claim 3 of Patent No. 5,666,156

5. Party Spears' claims corresponding to the count are claims 1-3 and 5-12.

6. Party Holland's claims corresponding to the count are claims 21 and 22.

7. Claim 4 of party Spears does not correspond to the count.

8. Other than its claims 21 and 22, party Holland has no other claim pending in its involved application.

9. The real party in interest of senior party Holland is 4MC-Burbank, Inc.

10. The real party in interest of junior party Spears is Steven Spears and David Walker.

11. The field of invention is that of a method or apparatus for converting motion picture film images to a video signal.

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12. The level of ordinary skill in the art is such that one with ordinary skill in the art would be familiar with the technology described in U.S. Patent No. 4,823,204 issued to Holland on April 18, 1989 (Exhibit 2005), and U.S. Patent No. 4,633,293 issued to Powers on December 30, 1986 (Exhibit 2006).

13. Senior party Holland's claims 21 and 22 reads as follows:

21. A method of converting motion picture film images to at least one output video signal having a correct number of video lines comprising the steps of:

a) reading substantially more vertical lines of information from a motion picture film image than is available on said output video signal;

b) performing vertical sample rate reduction operating on a plurality of vertical lines of video to produce said output video signal with the correct number of video lines.

22. A film to video transfer system comprising:

a) a telecine machine including:

i) an electron beam deflection system to produce a film scanning beam, and

ii) a detection system adapted to convert the film scanning beam to a digitized signal representing each film frame which has been scanned, said digitized signal representing a plurality of scanned lines corresponding to each said film frame wherein the number of said scan lines is greater than the number of scan lines required by an output device;

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b) sample rate converter means coupled to said detection system for performing vertical sample rate reduction on each of said frames of digitized film frame information.

14. Claim 3 of junior party Spears reads as follows:

3. A method of converting motion picture film images to at least one output video signal having a correct number of video lines comprising the steps of:

a) reading substantially more vertical lines of information from a motion picture film image than is available on said output video signal;

b) performing vertical sample rate reduction operating on a plurality of vertical lines of video to produce said output video signal with the correct number of video lines.

15. Claim 3 of party Spears and claim 21 of party Holland read the same as each other, word for word, identically.

16. Junior party Spears has filed a preliminary statement (Paper No. 28) which does not allege a date of invention prior to the effective filing date of senior party Holland; it states that the junior party "intends to rely on the filing date of its application which resulted in the patent which is the subject of this Interference, namely April 7, 1995."

17. Junior party Spears has not filed a preliminary motion to attack the benefit accorded senior party Holland to the May 24, 1993, earlier filing date of application 08/066,996.

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19. U.S. Patent No. 5,353,119 issued to Dorricott et al. (Exhibit 2008) discloses in connection with its Figure 66 not simply a digital video format converter but an assembly including (1) a scanner 104 for reading a motion picture film 100, (2) a VTR 108 for recording the scanned motion picture film as a produced video signal, and (3) a plurality of converters which act on the produced video signal after it has been further processed by various combinations of post production elements 118, 120, 122 and 126. The converters are elements 128, 130, 132, 136 and 138. (Column 51, line 37 to column 52, line 21).

20. U.S. Patent No. 5,353,119 issued to Dorricott et al. (Exhibit 2008) discloses the coupling of digital video format converters to the back end of a signal detection system which scans a motion picture film to produce a first video signal. See Figure 66.

Discussion

A. Spears' Preliminary Motion 4

Patentable distinctness between the parties' claims, in either direction, is sufficient to demonstrate no interference-in-fact. See Winter v. Fujita, 53 USPQ 1234, 1243 (Bd. Pat. App. & Int. 2000). As the moving party, Spears has the burden of proof to demonstrate either (1) that none of its claims corresponding to the count would have been anticipated by or

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rendered obvious over any of Holland's involved claims, or (2) that none of Holland's involved claims corresponding to the count would have been anticipated by or rendered obvious over any of Spears' own involved claims.

Claim 3 of party Spears and claim 21 of party Holland read the same as each other, word for word, identically. Neither claim includes any means-plus-function recitation which, under 35 U.S.C. § 112, sixth paragraph, potentially may mean different things depending on the existence of any difference between embodiments described in Spears' specification and Holland's specification. In that regard, 35 U.S.C. § 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Junior party Spears argues, however, that claim 3 of party Spears and claim 21 of party Holland include step-plus-function recitations under 35 U.S.C. § 112, sixth paragraph, and thus those limitations must be separately construed based on the corresponding content of each party's own disclosure and specification. In that regard, Spears' argument is reproduced below:

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Claim 21 of the Senior party corresponding to the count is expressed as steps for performing a specified function without the recital of structure, material, or acts in support thereof. Therefore, such claim must be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof pursuant to 35 USC 112, paragraph 6. Thus, notwithstanding that Claim 3 of the Junior Party is identical to Claim 21 and the count, the claims may not define the same invention notwithstanding that the same literal wording is used. 37 CFR 1[.]633(b).

In O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997), the Court of Appeals for the Federal Circuit, in no uncertain terms, determined that although a step for accomplishing a particular function in a process claim may be claimed without specificity under 35 U.S.C. § 112, sixth paragraph, and thus be subject to step-plus-function treatment under that section of the statute, "claiming a step by itself, or even a series of steps, does not implicate section 112, ¶ 6." Most recently, the Federal Circuit again made the same determination in Epcon Gas Systems Inc. v. Bauer Compressors Inc., 61 USPQ2d 1470, 1475 (Fed. Cir. 2002). The following explanation was provided by the Court in O.I. Corp. v. Tekmar Co., 115 F.3d at 1583, 42 USPQ2d at 1782:

Merely claiming a step without recital of a function is not analogous to a means plus a function. . . . If we were to construe every process claim containing steps described by an "ing" verb, such as passing, heating, reacting, transferring, etc. into a step-plus-function

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limitation, we would be limiting process claims in a manner never intended by Congress. (Emphasis added.)

Also, even if the recitations in a method claim "parallel" those in apparatus claims which are subject to means-plus-function construction under 35 U.S.C. § 112, sixth paragraph, that does not mean, necessarily, that the steps in the method claim are step-plus-function recitations under § 112, sixth paragraph. Id. Each claim must be independently reviewed in order to determine if it is subject to the requirements of section 112, ¶ 6. Epson Gas Systems Inc., 61 USPQ2d at 1475; O.I. Corp., 115 F.3d at 1583, 42 USPQ2d at 1782.

In Epson Gas Systems Inc., 61 USPQ2d at 1475, the Federal Circuit reasoned that claim 2 at issue there includes no words indicating step-plus-function form, such as "step for," and determined that "[c]laim 2 is a garden variety process claim." Similarly, in this case, claim 3 of junior party Spears and claim 21 of senior party Holland each include no words indicating step-plus-function form, such as "step for," and represent a garden variety process claim. Party Spears has not provided a meaningful explanation as to why the following two clauses of its claim 3 and Holland's claim 21 are not simply ordinary method steps:

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a) reading substantially more vertical lines of information from a motion picture film image than is available on said output video signal;

b) performing vertical sample rate reduction operating on a plurality of vertical lines of video to produce said output video signal with the correct number of video lines.

We can see no basis for regarding the above-identified claim recitations as triggering the limiting construction rules of 35 U.S.C. § 112, sixth paragraph, and party Spears has offered us none beyond that the features are steps in a method claim. Accordingly, we reject party Spears' assertion that the above-quoted recitations are step-plus-function features subject to the special limiting rules of construction under 35 U.S.C. § 112, sixth paragraph. It is not necessary to determine and compare the embodiments described in Spears' specification and disclosure with those described in Holland's specification and disclosure.

Note further that Spears has not alleged that any word appearing in claim 3 of Spears has a specially defined definition according to Spears that is contrary to that as would be understood by one with ordinary skill in the art, or that any word appearing in claim 21 of Holland has a specially defined definition according to Holland that is contrary to that as would be understood by one with ordinary skill in the art.

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In light of the foregoing, because of the existence of Spears' claim 3 and Holland's claim 21, Spears has demonstrated neither (1) that none of its claims corresponding to the count would have been anticipated by or rendered obvious over any of Holland's involved claims, or (2) that none of Holland's involved claims corresponding to the count would have been anticipated by or rendered obvious over any of Spears' own involved claims. At least claim 3 of Spears and claim 21 of Holland interfere.

Spears' preliminary motion 4 alleging no interference-in-fact is denied.

B. Spears' Preliminary Motion 5

In this preliminary motion, junior party Spears seeks to designate its claims 8-12 as not corresponding to the count. Per 37 CFR § 1.637(c)(4), a preliminary motion seeking to designate an application or patent claim as not corresponding to a count shall show that the claim does not define the same patentable invention as any other claim whose designation in the notice declaring the interference as corresponding to the count the party does not dispute.

In paragraph 26(j) of the Standing Order accompanying the Notice Declaring Interference (Paper No. 1), however, it was clarified that a moving party seeking to designate its own claims

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as not corresponding to a count shall "establish that the claim covers an invention which is not the same patentable invention as any of the opponent's claim designated as corresponding to a count."³ Thus, party Spears need not establish that its claims 8-12 do not define the same patentable invention as any of its claims 1-3 and 5-7 which correspond to the count and which party Spears does not seek to have designated as not corresponding to the count. In that connection, party Holland's argument that Spears has not established that claims 8-10 do not define the same patentable invention as claims 1-3 and 5-7 is irrelevant.

The issue regarding Spears' claims 8-10 is whether the preliminary motion has made out a prima facie case that these claims do not define the same patentable invention as Holland's claims 21 and 22. In that regard, the preliminary motion on page 7 makes the assertion that "there is no prior art of record or known to the inventors of the Spears Patent which teaches or suggests the limitations of Claim 8," citing to the declaration of inventor Steven Spears (Exhibit 2011) and inventor David Walker (Exhibit 2012).⁴ If Messrs. Spears and Walker actually stated in their declarations the substance of the above-quoted

³ Party Spears' own claims do not constitute 35 U.S.C. § 102(g) prior art against party Spears.

⁴ Note that claims 9 and 10 depend from claim 8.

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language of their counsel, perhaps at least a plausible argument has been made that junior party Spears has made out a prima facie case that its claims 8-10 do not define the same patentable invention as Holland's claims 21 and 22. The idea is that if nothing teaches or suggests the limitations of claim 8,⁵ then nothing in combination with Holland's claim 21 or 22 would arrive at the subject matter of claim 8, assuming that Holland's claims 21 and 22 also do not contain the limitations of Spears' claim 8.

However, we have reviewed the cited portions of the declarations of Mr. Steven Spears and Mr. David Walker. They do not support the above-quoted statement made by counsel. Specifically, both Mr. Steven Spears and Mr. David Walker merely state (Exhibit 2011, ¶ 2 and Exhibit 2012, ¶ 2):

2. With respect to the invention defined by claims 8-10 of the above-identified patent, I am unaware of any printed publication, public use, sale or offer for sale of such invention prior to the filing date of April 7, 1995 for the application which resulted in U.S. Patent No. 5,666,156.

Even when viewed in a light most favorable to junior party Spears, the above-quoted statement indicates only that the inventors are not aware of any prior art which is the same as the

⁵ It is assumed that this reference to "the limitations of claim 8" refers to those limitations of claim 8 expressly discussed by party Spears in the preliminary motion as constituting the basis of patentably distinguishing claims 8-10 from other claims.

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subject matter of Spears' claims 8-10. It is a long way from a representation that the inventors are not aware of prior art which, if combined with the subject matter of Holland's claims 21 or 22, would lead to the subject matter of Spears' claims 8-10. It is also a long way from a representation that the inventors are not aware of prior art which discloses one or two of the two features (a) and (b) of Spears' claim 8 specifically discussed in the preliminary motion as providing the basis of patentable distinction for Spears' claims 8-10:

a) a telecine machine including scan generator means operable to produce a film scanning beam and a detection system operable to convert film modulated light from said film scanning beam to a digitized signal representing a plurality of non forward-sequential scanned lines corresponding to film frame information wherein the number of said scanned lines is greater than the number of scan lines available to an output device;

b) temporary storage means coupled to said detection system operable to provide a video signal representing sequentially ordered video;

Note also that party Spears has not compared its claims 8-10 with claim 22 of Holland. Spears has the burden to show that its claims 8-10 do not define the same patentable invention as any claim of Holland whose correspondence to the count Spears does not dispute. That means an analysis has to be made with respect to each claim of Holland whose correspondence to the count Spears does not dispute. Proof of "not any" necessarily cannot be

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satisfied by a showing based on just one within the group, e.g., Holland's claim 21 (same as Spears' claim 3) from the group consisting of Holland's claims 21 and 22.

Spears has not articulated what is not present in Holland's claim 22 but required by its claims 8-10. Holland's claim 21 is the same as Spears' claim 3 with respect to which a comparison has been made, but Holland's claim 22 is not. A comparison of Spears' claims 8-10 with the count does not equate with a comparison with Holland's claim 22. It is not the role of this board to help party Spears articulate a difference between Spears' claims 8-10 and Holland's claim 22. That is the role of Spears' counsel as an advocate, not the role of the board as an unbiased and impartial decision maker. Taking sides to aid one party to the detriment of the other is not what we do.

Even assuming that the same differences exist with respect to Holland's claim 22 as those with respect to Holland's claim 21, as is discussed above, the attorney's argument of unobviousness is not supported by the evidence cited for that proposition. We are not persuaded that the inventors are not aware of prior art which discloses claim features (a) and/or (b) of Spears' claim 8 and which, if combined with Holland's claim 22, would have rendered the subject matter of Spears' claims 8-10 obvious.

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With respect to Spears' claims 11 and 12, the same type of deficiency discussed above with respect to Spears' showing for its claims 8-10 also exists and undermines Spears' argument that claims 11 and 12 should be designated as not corresponding to the count. First, there is no comparison of Spears' claims 11 and 12 with Holland's claim 22. In addition, even assuming that Holland's claim 22 does not include the two features of claims 11 and 12 which Spears has discussed, i.e., conversion of motion picture film image to video and reading substantially more vertical lines of information from a motion picture film than is available on an output video signal, counsel's argument that the inventors are not aware of prior art which teaches or suggests the limitations of claim 11⁶ is not supported by evidence. What Mr. Steven Spears and Mr. David Walker actually state is this (Exhibit 2011, ¶ 3 and Exhibit 2012, ¶ 3):

3. With respect to the invention defined by claims 11-12 of the above-identified patent, I am unaware of any printed publication, public use, sale or offer for sale of such invention prior to the filing date of April 7, 1995 for the application which resulted in U.S. Patent No. 5,666,156.

⁶ Claim 12 depends from claim 11 and thus includes all features of claim 11.

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The above-quoted statement refers to the invention of claims 11 and 12 as a whole and does not indicate whether the inventors are aware of prior art which discloses conversion of motion picture film image to video and/or reading substantially more vertical lines of information from a motion picture film than is available on an output video signal, the two features which Spears relies on in asserting patentable distinction of claims 11 and 12.

For the foregoing reasons, party Spears has not made out a prima facie case that it is entitled to the relief requested in its preliminary motion 5, to designate claims 8-12 as not corresponding to the count.

Accordingly, Spears' preliminary motion 5 is denied.⁷

C. Spears' Preliminary Motion 3

Paragraph 26(a)(1) of the Standing Order attached to the Notice Declaring Interference (Paper No. 1) provides that in presenting a motion a party shall first state the precise relief requested. The first paragraph of Spears' preliminary motion 3

⁷ We disagree with Holland's assertion that functional language in a claim element of an apparatus claim "cannot lend patentable weight to the claim," but that issue is moot in light of Spears' failure to show patentable distinction of claims 8-10 despite according weight to all claim features Spears asserts. We also disagree with Holland's assertion that the recitation "video camera system" in the preamble of claim 11 should not be accorded any weight, but that issue is moot in light of Spears' failure to show patentable distinction of claims 11 and 12 despite according weight to all claim features Spears asserts.

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is entitled "RELIEF REQUESTED" but is the antithesis to something precise. Party Holland cannot reasonably be expected to figure out the precise ground of unpatentability alleged by party Spears and neither could the board. Specifically, the paragraph states:

Spears and Walker (Junior Party) move for judgment on the grounds that claims 21 and 22 of Holland and Schultz (Senior party) designated to correspond to the count are unpatentable to the Senior Party under 35 USC 102 and/or 35 USC 103 over U.S. Patent No. 4,823,204 issued April 18, 1989, U.S. Patent No. 4,633,293 issued December 30, 1986, U.S. Patent No. 5,303,044 issued April 12, 1994, U.S. Patent No. 5,353,119 issued October 4, 1994 and in view of the prior art as set forth in the Declaration of David Walker re Prior Art.

It is well established that to constitute anticipation under 35 U.S.C. § 102, all the limitations of a claim being attacked must be found within the four corners of a single reference. E.g., Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). Spears refers to four prior art patents, not in the alternative, and further adds the phrase "in view of" If it takes a combination of four patents plus the addition of another item of prior art to arrive at Holland's claimed invention, the ground of unpatentability cannot be anticipation under 35 U.S.C. § 102.

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The body portion of Spears' preliminary motion adds further confusion. For instance, from the middle of page 5 to the top of page 6, the motion reproduces certain content from U.S. Patent No. 4,823,204 (Exhibit 2005), from U.S. Patent No. 4,633,293 (Exhibit 2006), and from U.S. Patent No. 5,353,119 (Exhibit 2008). With reference to these reproduced content, the motion on page 7, lines 4-5 states: "It is submitted that such teachings fully anticipate the preamble and step a) of Claim 21 and the preamble and element a) of Claim 22." A review of the reproduced content from U.S. Patent No. 4,823,204, indicates, however, that that disclosure corresponds only to what is in the preamble of claims 21 and 22 and not to step a) in either claim. The reproduced content from U.S. Patent No. 4,823,204 is this:

"To convert from a film to a tape a flying spot scanner or telecine is used. A source of light, as for example a laser beam or light from a phosphorous screen, scans the film in a raster or line-by-line fashion. The transmitted light is converted into an electrical signal through known means and stored on a video tape."

At most, the above-quoted text anticipates only the preamble portion of Holland's claim 21 or claim 22 and not step (a) in claim 21 which reads:

reading substantially more vertical lines of information from a motion picture film image than is available on said output video signal;

or element (a) in claim 22 which reads:

a telecine machine including:

i) an electron beam deflection system to produce a film scanning beam, and

ii) a detection system adapted to convert the film scanning beam to a digitized signal representing each film frame which has been scanned, said digitized signal representing a plurality of scan lines corresponding to each said film frame **wherein the number of said scan lines is greater than the number of scan lines required by an output device;** (emphasis added)

Thus, the body portion of Spears' preliminary motion does not clarify the picture. Rather, it adds to the appearance that Spears improperly relies on a combination of references to make out a charge of anticipation under 35 U.S.C. § 102.

We turn to Appendix I attached to the preliminary motion to see if it might help to clarify the situation. Paragraph 26(d) of the Standing Order requires that where anticipation (35 U.S.C. § 102) is the basis for a preliminary motion for judgment, each claim alleged to have been anticipated shall be reproduced and following each element or step recited in the claim there shall be inserted "in bold a specific citation to the column and line and/or drawing figure and numeral and/or other material where a prior art reference describes each element or step recited in the claim." In other words, the source of prior art is supposed to

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be expressly and specifically identified for each element or step in a claim said to be unpatentable for anticipation under 35 U.S.C. § 102.

Our review of Appendix I reveals that with references to four prior art patents in all, only one prior art patent has been cited for each and every feature or element of Holland's claim 21, U.S. Patent No. 4,633,293 (Exhibit 2006). With respect to Holland's claim 22, in Appendix I party Spears cites nothing for the preamble and also cites nothing for element (a)(i) which states: "an electron beam deflection system to produce a film scanning beam."

In light of the foregoing, it is an understatement to say that Spears' preliminary motion 3 is sloppy. It is so sloppy that one cannot be reasonably certain as to what are each of the underlying basis for the assertion of unpatentability. Only one fact salvages Spears' preliminary motion from outright dismissal in its entirety, that Appendix I includes a citation to U.S. Patent No. 4,633,293 for each element of Holland's claim 21.

Accordingly, Spears' preliminary motion 3, insofar as it asserts unpatentability of Holland's claims for anticipation under 35 U.S.C. § 102, except with regard to anticipation of Holland's claims 21 and 22 by U.S. Patent No. 4,633,293 (Exhibit

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2006), and by U.S. Patent No. 5,353,119 (Exhibit 2008)⁸, is dismissed. We discuss below the issue of anticipation based on U.S. Patent No. 4,633,293 (Exhibit 2006), and based on U.S. Patent No. 5,353,119 (Exhibit 2008).

We have reviewed the portion of U.S. Patent No. 4,633,293 (Exhibit 2006) which, according to Spears, discloses the features of the preamble and step (a) of Holland's claim 21 and the preamble and element (a) of Holland's claim 22, i.e., column 1, lines 7-33. However, we see nothing which describes a method of converting motion picture film images to at least one output video signal, including the step of reading substantially more vertical lines of information from a motion picture film image than is available on the output video signal. Similarly, we see nothing which describes a system which converts a motion picture film to video where the scan lines from the film are greater in number than the number of scan lines required by the output.

That digital standards conversion equipment existed which was capable of converting video signals from a first to a second format does not mean such equipment was a part of the entire

⁸ On page 7, Spears apparently refers to the teachings of U.S. Patent Nos. 4,633,293 and 5,353,119 as anticipating the preamble and step (a) or element (a) of Holland's claims 21 and 22, and those patents have been cited in Appendix I with respect to all other features of Holland's claims 21 and 22.

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assembly at the time an original motion picture film was being processed into video in a first format such that the resulting signal in the second format can reasonably be regarded as the output of the process applied to the motion picture film. Party Spears has provided no meaningful explanation as to how the cited portion of U.S. Patent No. 4,633,293 satisfies step (a) or element (a) of Holland's claims 21 and 22.

Accordingly, Spears has not satisfied its burden of proof in establishing that either Holland's claims 21 or 22 is unpatentable for anticipation by U.S. Patent No. 4,633,293 (Exhibit 2006) under 35 U.S.C. § 102.

U.S. Patent No. 5,353,119 (Exhibit 2008), however, is different. Citing to Figure 66 and textual portions of that prior art patent, Spears makes the statement that the coupling of a sample rate converter means to a detection system is clearly shown, and that more vertical lines of information is read from the motion picture film than is ultimately provided as a video output signal. Spears' argument is persuasive, at least in the absence of rebuttal from Holland. In a first stage, a motion picture image is scanned by scanner 104 and turned into video signal of a first format and recorded by VTR 108 (Figure 66). After some post production processing by various combinations of

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elements 118, 120, 122 and 126,⁹ a plurality of video format converters are available to convert the processed signal to an ultimate output video signal. Many converters are available, including 128, 130, 132, 134, and 138, and at least some of the ultimate video output signals have fewer vertical lines of information than the original motion picture image as scanned by scanner 104. (See column 30, lines 51-54 and column 52, lines 6-21). The foregoing also makes clear that with regard to claim 22's features which are missing a corresponding citation in Appendix I accompanying Spears' preliminary motion 3, U.S. Patent No. 5,353,119 does disclose a film to video transfer system comprising a telecine machine¹⁰ including an electron beam deflection system to produce a film scanning beam. Consequently, Spears has made out a prima facie case that claims 21 and 22 are anticipated by U.S. Patent No. 5,353,119.

We reject Holland's argument that:

Junior Party seems to merely suggest that the claim is directed to a standards converter. It is not. It is directed to a system having all of the limitations of

⁹ Holland's claims 21 and 22 do not preclude the presence of additional signal processing circuitry between the first recorded video signal corresponding to the scanned motion picture film and the components for performing subsequent sample rate reduction. Party Holland also has not asserted the contrary.

¹⁰ Assuming that a telecine machine is a device which turns film, pictures, or slides into electrical signals.

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the claim, including the vertical sample rate reduction step operating on a plurality of vertical lines as required by the claim.

Spears' motion has not simply relied on the video format converters of U.S. Patent No. 5,353,119, but the combination of the converters on the back end and the scanner and VTR on the front end as discussed above. Holland provides no explanation that is meaningful in light of the presentation made by Spears, on why Holland believes U.S. Patent No. 5,353,119, does not disclose vertical sample rate reduction operating on a plurality of vertical lines of video to produce a correct number of lines.

For the foregoing reasons, Spears' preliminary motion 3 is granted, to the extent that it asserts that Holland's claims 21 and 22 are anticipated by U.S. Patent No. 5,353,119 (Exhibit 2008) under 35 U.S.C. § 102, and denied insofar as it asserts that Holland's claims 21 and 22 are anticipated by U.S. Patent No. 4,633,293 (Exhibit 2006) under 35 U.S.C. § 102.

We need not consider the merits of Spears' explanation that the prior art applied by Spears against Holland's claims are not applicable against Spears' own claims corresponding to the count, because Spears has not alleged a date of invention prior to senior party Holland's effective filing date. Party Spears is not entitled to any of its claims corresponding to the count.

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In the alternative, we reject party Spears' explanation on why the same prior art applicable to render Holland's claims unpatentable would not render Spears' own claims unpatentable. The only argument advanced by Spears appears in section D of the preliminary motion. Party Spears reads certain limitations from the specification into the claims on the ground that:

It is axiomatic that a claim should be interpreted to preserve, rather than defeat, its validity. ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929, 932 (Fed. Cir. 1984). Thus, Spears' Claim 3 must be interpreted to such that its "reading" step is one capable of handling film recorded in a non-anamorphic format and not be limited only to film recorded in an anamorphic format as is the case with Senior Party's claims 21 and 22.

Spears' position is misplaced. The idea that where possible, claims should be construed to preserve their validity, is a principle applied to issued patents in a non-USPTO proceeding, most frequently during an infringement suit by the patentee. It is inapplicable to proceedings in the USPTO. Before the USPTO, application and patent claims are treated alike. There is no presumption of validity for an issued patent in an interference. Perkins v. Kwon, 886 F.2d 325, 12 USPQ2d 1308 (Fed. Cir. 1989), Lamont v. Berquer, 7 USPQ2d 1580, 1582 (BPAI 1988); there is no presumption of validity for a patent claim in a reexamination proceeding, In re Etter, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985); there also is no presumption of validity for a patent

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claim in a reissue proceeding. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).

Furthermore, even if there is presumption of validity just as is the case in an infringement suit, the principle does not stand for reading in anything from the specification to save a claim. There has to be some reasonable basis for the incorporation other than that the claim would otherwise be unpatentable or invalid. In section D of its motion, Spears has not provided an explanation as to why a reasonable interpretation would lead to such incorporation. There has to be sufficient room for interpretation to allow for incorporation. It is not a matter of just adding features to save a claim. Moreover, as is recited in Holland's claims 21 and 22, the motion picture film is not limited only to film recorded in an anamorphic format.

Finally, section D of the preliminary motion of Spears discusses only claim 3 of Spears. In the context of preliminary motion 3, no pertinent explanation is provided for Spears' other claims corresponding to the count.

For the foregoing reasons, Spears has not demonstrated that U.S. Patent No. 5,353,119 renders Holland's claims unpatentable but not Spears' own claims.

As for Spears' assertion of obviousness against Holland's claims 21 and 22, it is dismissed on several grounds.

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First, the statement of the precise relief requested does not make clear the ground of the obviousness assertion. Is each of the references involved in an overall big combination, or are there several smaller combinations which each render the claims obvious? Secondly, paragraph 26(e) of the Standing Order requires that any difference between the claimed invention and the prior art reference be explicitly identified, and party Spears has made no express identification of such differences, either in Appendix I or in the body of its preliminary motion 3.

Furthermore, paragraph 26(e) of the Standing Order requires that:

An explanation shall be made in the body of the preliminary motion (not an appendix) as to why the subject matter of the claim, as a whole, would have been obvious to a person having ordinary skill in the art notwithstanding any difference.

In that regard, Spears in its preliminary motion 3 states only the following (at page 12):

[t]he Junior Party respectfully submits that it has been amply demonstrated that the teachings of the references themselves, all of which are directed to converting motion picture film images to video images, and the nature of the problem to be solved clearly demonstrates that the prior art references relied upon (Exhibits 2005 to 2009) may be combined to establish that Claims 21 and 22 corresponding to the count are not patentable to the Senior Party under 35 U.S.C. § 103.

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What that amounts to is an invitation for the board to look through each of the cited references and come up with a theory on which teachings from which references would be combined with each other to render Holland's claims obvious. Party Spears is guilty of major improper role-shifting and confuses the rôle of the board with the role of counsel for the junior party. Let's assume that indeed some combination of the prior art references indeed may render Holland's claims 21 and 22 obvious, but party Spears has not presented the story.

We do not know, according to Spears, how each of the cited references differ from Holland's claims 21 and 22. We do not know, according to Spears, which teaching from which reference is being combined with which teaching from which other reference or references to arrive at Holland's claims 21 and 22. We do not know, what is the motivation for making the unknown combinations.

Moreover, the prior art referenced as that set forth in the declaration of David Walker has not even been identified, referred to, discussed, or explained in the body of the preliminary motion. And to the extent that any story that should have been told by Spears in its motion is presented in David Walker's declaration, paragraph 13 of the Standing Order prohibits incorporation of arguments by reference. The board discussed that prohibition in detail in a precedential opinion in

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LeVeen v. Edwards, 57 USPQ2d 1406 (Bd. Pat. App. & Int. 2000).

Part C1(a) of that opinion is reproduced below, LeVeen, 57 USPQ2d at 1412:

C. Opinion

1. Failure to follow applicable procedure

a.

Edwards, contrary to ¶ 13 of the NOTICE DECLARING INTERFERENCE, has incorporated "arguments" from the Siperstein and Sheehan declarations (Exs 5010 and 5015) into Edwards preliminary motion 1. Edwards misperceives the role of motions and evidence. Declarations are evidence. A motion is supposed to (1) lay out all relevant facts, with reference to the evidence which supports the facts, and (2) present an argument why the facts justify any relief requested in the motion.

The NOTICE DECLARING INTERFERENCE explicitly precludes incorporation by reference of arguments. There are numerous reasons why an agency, in general or in a particular case, may preclude incorporation by reference in papers presented to the agency. First, an incorporated argument may be overlooked (Paper 1, page 10 n.7). Second, incorporation of arguments is not consistent with efficient decisionmaking (Paper 1, page 10 n.7). Essentially, incorporation by reference is an inappropriate role-shifting technique which makes it a decisionmaker's job to (1) scour the record, (2) come up with some theory which supports a party's case and (3) articulate a rationale in an opinion supporting the rationale without giving an opponent a reasonable chance to address the rationale. Third, through incorporation by

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reference an attorney can avoid page limitations applicable to motions (Paper 1, page 27 ¶ 28). Compare DeSilva v. DiLeonardi, 181 F.3d 865, 866-67 (7th Cir. 1999) ("[a]doption by reference amounts to a self-help increase in the length of the *** brief. *** [I]ncorporation by reference is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.").

We recognize in this particular case that both the preliminary motion and the declarations are short. Hence, it can be argued that there was no undue burden on the opponent or the board to look collectively at both documents. The contrary argument is that the procedure applicable to this interference is otherwise and that it would have been no undue burden for Edwards to have complied with the applicable procedure.

We follow the above-quoted principles and views set forth in LeVeen v. Edwards (Paper No. 240) and reiterate two points A and B for emphasis:

A.

[Spears] misperceives the role of motions and evidence. Declarations [and affidavits] are evidence. A motion is supposed to (1) lay out all relevant facts, with reference to the evidence which supports the facts, and (2) present an argument why the facts justify any relief requested in the motion.

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B.

Incorporation by reference is an inappropriate role-shifting technique which makes it a decisionmaker's job to (1) scour the record, (2) come up with some theory which supports a party's case and (3) articulate a rationale in an opinion supporting the rationale without giving an opponent a reasonable chance to address the rationale.

We decline to abandon our role as impartial judges to take on the role of an advocate on behalf of party Spears.

For the foregoing reasons, that portion of Spears' preliminary motion 3 alleging obviousness of Holland's claims under 35 U.S.C. § 103 is dismissed.

Judgment

It is

ORDERED that judgment as to the subject matter of the count is herein entered against STEVE SPEARS and DAVID WALKER, who are not entitled to their patent claims 1-3 and 5-12 which correspond to the count;

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FURTHER ORDERED that judgment as to the subject matter of the count is herein entered against senior party DAVID E. HOLLAND and GAVIN W. SCHUTZ, who are not entitled to a patent containing their application claims 21 and 22 which correspond to the count;¹¹

FURTHER ORDERED that a copy of this paper will be given a paper number and entered in the involved application or patent of the respective parties; and

FURTHER ORDERED that failure to file a copy of any agreement regarding the termination of this proceeding may render the agreement and any resulting patents unenforceable. See section 135(c) and 37 CFR § 1.661 for more details.

¹¹ Claims 21 and 22 of Holland, the only claims of the senior party corresponding to the count, have been determined as unpatentable over prior art.

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Jameson Lee
Jameson Lee)
Administrative Patent Judge)

Sally Gardner-Lane
Sally Gardner-Lane)
Administrative Patent Judge)

Sally C. Medley
Sally C. Medley)
Administrative Patent Judge)

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By Federal Express

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