

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today is not binding precedent of the Board

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

HAJIME YAMAGAMI, KOUICHI TERADA, YOSHIHIRO HAYASHI,
TAKASHI TSUNEHIRO, KUNIHIRO KATAYAMA,
KENICHI KHAKI, and TAKESHI FURUNO,
Junior Party,
(Patent 5,644,539),

v.

ELIYAHOU HARARI, ROBERT D. NORMAN and
SANJAY MEHROTRA,
Senior Party,
(Application 09/103,056).

Patent Interference No. 104,760

Before LEE, CRAWFORD and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

**DECISION ON YAMAGAMI SECOND REQUEST FOR RECONSIDERATION
AND FINAL JUDGMENT**

A. Introduction

A decision on preliminary motions was entered 18 April 2003. In our decision, Yamagami was ordered to show cause why judgment should not be entered against it (Paper 91 at 35). In response to the show cause order, Yamagami filed a request for reconsideration of our decision on preliminary motions (Paper 93). Yamagami's request for reconsideration was dismissed for procedural errors, without prejudice to file another request for reconsideration (Paper 94).

On 20 May 2003, Yamagami filed a second request for reconsideration (Paper 95). Yamagami seeks reconsideration of that part of our decision on preliminary motions in which we (1) denied Yamagami Preliminary Motion 1 for judgment against Harari based on 35 U.S.C. § 112, ¶ 1, and (2) granted Harari Preliminary Motion 1 for judgment against Yamagami on the grounds that Yamagami's involved claims are unpatentable based on prior art.

B. Discussion

A party requesting reconsideration of an interlocutory decision must specify with particularity points believed to have been misapprehended or overlooked in rendering the decision. 37 CFR § 1.640(c). A request for reconsideration is not a new opportunity to raise issues which should have been raised during the preliminary motions period. Further, a request for reconsideration will not be granted where the moving party merely disagrees with the decision of the panel.

Yamagami argues that we overlooked or misapprehended Yamagami's arguments and evidence of record that Harari did not provide written description support for Harari claims 63 and 64 (Recon.¹ 2). In essence, Yamagami asserts that we did not consider that portion of

¹ Recon. refers to Yamagami's second request for reconsideration, i.e. Paper 95.

Yamagami preliminary motion 1 where Yamagami argued that Harari lacked written description support for Harari claims 63 and 64. However, as is evident from our seven page discussion addressing Yamagami's written description arguments, the panel did consider Yamagami's arguments and the evidence that Yamagami directed us to in support of its arguments.

Yamagami, as the requestor for reconsideration of our decision on preliminary motions, must demonstrate how we specifically misapprehended or overlooked an argument made, or evidence relied upon in support of an argument. A general argument such as that made by Yamagami does not provide a basis upon which relief will be granted.

Yamagami argues that there is insufficient detailed description of how to make or use the controller 31 to perform the claimed conversion with respect to sector remapping (Recon. 3-4). Yamagami argues that it set forth this point in its preliminary motion through certain Material Facts, in its argument section of the motion, in certain paragraphs of the Kimura declaration, and in its reply 1² (Recon. 3-4). We find no such argument made by Yamagami in the argument section of its preliminary motion 1. To the extent that Yamagami now directs us to statements of facts in Yamagami preliminary motion 1 and passages in the Kimura declaration in support of the new argument, it is too late. We note that in the argument section of Yamagami preliminary motion 1, there is not a single citation to the Kimura declaration, or to any statement of fact. It is not the role of the board to play detective with a party's evidence or statements of facts and come up with an argument for the party. That is the role of counsel, not judge. Yamagami should have directed our attention to any statements of facts or to paragraphs of the Kimura declaration

² In its request for reconsideration, Yamagami argues that it raised the issue on "page 5, line 29 thru page 7." (Recon. 4). We assume that Yamagami is referring to its reply 1, since the reply 1 matches the description given by Yamagami.

in its argument section of its motion. It is too late for Yamagami to do so now. Note further, that incorporation by reference of arguments is not permitted. See Paper 1, Standing Order § 13. Furthermore, in deciding Yamagami preliminary motion 1, we did not consider Yamagami's reply. Because Yamagami's preliminary motion 1 failed to set forth a prima facie case for entitlement to relief, Harari's opposition to Yamagami's preliminary motion 1 was not considered. Consequently, Yamagami's reply need not have been considered. In any event, we have considered the statements of facts, paragraphs in the Kimura declaration and arguments made in Yamagami reply that Yamagami now direct us to and do not find the argument now advanced, i.e. that there is insufficient detailed description of how to make or use the controller 31 to perform the claimed conversion with respect to sector remapping.

Yamagami argues that our statement on page 17, lines 2-11 of our decision that "we note that Yamagami's own Expert admits that the controller 31 performs a logical address to a physical address conversion operation in one embodiment (Exhibit 2001, page 5, paragraph 13)" is not true. Yamagami argues that there is no admission by Kimura at any point in his declaration (Recon. 4). We agree that paragraph 13 of the Kimura declaration does not support the statement made in our decision. Accordingly, we modify the decision, by deleting lines 8-11 on page 17, beginning with "We note...." The change to our decision to delete the above noted sentence, however, does not change the overall outcome of our decision to deny Yamagami preliminary motion 1.

Yamagami argues that the panel erred when it attributed the stated feature in the Harari specification of providing a flash EEPROM memory which remains reliable after enduring a large number of write/erase cycles to cell and sector defect re-mapping. Yamagami argues that

Harari's sector remapping is conditional, in that it only occurs after a defective sector is detected and would not satisfy the written description requirement for prolonging life (Recon. 4-5).

There are several problems with Yamagami's argument. First, we did not attribute reliability to the sector remapping embodiment. We said in our decision that "as Yamagami discloses that an object of the invention is to provide a Flash EEPROM memory system that remains reliable after enduring a large number of write cycles, it is implicit in the disclosure of the involved Harari application that there are successive write operations." Yamagami does not argue that Harari does not perform successive write operations, or that the sector remapping is not performed in two consecutive write operations. Rather, Yamagami argues that the remapping (conversion) is not done every time there is a write operation.

Yamagami made this argument in its reply 1 (Reply 1 at 6, lines 4-6) and in its opposition to Harari's preliminary motion 1. However, in deciding Yamagami preliminary motion 1, we did not consider Yamagami's reply or Yamagami's opposition to an unrelated motion. Because Yamagami's preliminary motion 1 failed to set forth a prima facie case for entitlement to relief, Harari's opposition to Yamagami's preliminary motion 1 was not considered. Consequently, Yamagami's reply need not have been considered. That Yamagami made the argument in an opposition to an unrelated motion is without merit. We will not, at this late stage in the proceedings, consider arguments Yamagami made in an unrelated opposition to an unrelated motion. Moreover, as stated above, incorporation of arguments is not permitted.

In any event, we note that Harari claims 63 and 64 are not limited to performing a conversion for every write operation. The claims are broad enough to include performing a conversion at some point in time between two consecutive write operations. Furthermore,

lacking from the claim language of Harari claims 63 and 64 is a requirement that the conversion act to prolong the life of the memory.

Yamagami argues that we misapprehended or overlooked statements made by Kimura and arguments advanced by Yamagami in its preliminary motion 1 that “it is inherently obvious that undue experimentation (although this term is not specifically used) would be required to practice the apparatus as disclosed in the Harari specification ...” (Recon. 5). As stated above, Yamagami does not, in the argument section of Yamagami preliminary motion 1, direct our attention to any passage in the Kimura declaration. Yamagami cannot now direct us to passages in the Kimura declaration with the hopes that we will consider those passages. It is too late. Consideration of such evidence would be prejudicial to Harari. In any event, it is not enough to allege, or for a declarant to state that experimentation would be required to practice an invention, or even that undue experimentation would be required without sufficient supporting evidence to back up the argument or statement.

Yamagami argues that we erred in not giving deference to the examiner’s determination that Yamagami’s claims were patentable over the subject matter of “the European patent application” and Holzhammer (Recon. at 5). We are not bound by decisions made by an examiner during ex parte prosecution. During an interference, independent review of issues are made. See Glaxo Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (BPAI (ITS)). (Neither the Board nor a party are bound by an ex parte decision made during prosecution by another party. A motion in an interference is not an appeal from the examiner's decision, but an independent request to the Board). Accordingly, we did not overlook the examiner’s determination made during ex parte prosecution of the Yamagami involved patent. Instead, we reviewed Harari

preliminary motion 1, Yamagami opposition 1, and the evidence related to the motion and opposition in making our decision.

Yamagami argues that we failed to mention, in our decision, that Harari has a burden to overcome in order for it to prove anticipation (Recon. 6). It is not necessary for an opinion to state the obvious. Rule 637(a) provides that the movant bears the burden to demonstrate that it is entitled to the relief requested. That we did not quote the rule in our decision does not mean that Harari was exempt from meeting its burden of proof. Yamagami has failed to sufficiently demonstrate that we ignored the burden in rendering our decision. By addressing Yamagami's opposition 1, it is inherent that the panel determined that Harari met its burden to demonstrate that it was entitled to the relief requested in the first place. Accordingly, we see no reason to amend our decision.

Yamagami disagrees with our determination that the European patent discloses sector re-mapping. Mere disagreement with a determination made by the panel is insufficient reason to grant a request for reconsideration.

Having considered Yamagami's arguments in its request for reconsideration, we grant Yamagami's request for reconsideration with respect to that portion of our decision on page 17, lines 8-11, by deleting the following: "[w]e note that Yamagami's own expert admits that the controller 31 performs a logical address to physical address conversion operation in one embodiment (Exhibit 2001, page 5, paragraph 13)." As noted above, the deletion does not change our decision to deny Yamagami preliminary motion 1.

Having considered Yamagami's additional arguments, we conclude that Yamagami has

failed to demonstrate that we misapprehended or overlooked any fact or argument first presented prior to the filing of the request for reconsideration. Accordingly, Yamagami's request for reconsideration is **granted-in-part**.

Since Yamagami is a junior party who has failed to overcome the effective filing date of the senior party Harari, judgment is entered against Yamagami.

Upon consideration of the record, it is

ORDERED that Yamagami's request for reconsideration is **granted-in-part**;

FURTHER ORDERED that judgment as to Count 1 (Paper 1 at 5), the sole count in the interference, is awarded against junior party HAJIME YAMAGAMI, KOUICHI TERADA, YOSHIHIRO HAYASHI, TAKASHI TSUNEHIRO, KUNIHURO KATAYAMA, KENICHI KHAKI, and TAKESHI FURUNO;

FURTHER ORDERED that junior party HAJIME YAMAGAMI, KOUICHI TERADA, YOSHIHIRO HAYASHI, TAKASHI TSUNEHIRO, KUNIHURO KATAYAMA, KENICHI KHAKI, and TAKESHI FURUNO is not entitled to a patent containing claims 9 and 14 (corresponding to Count 1) of patent 5,644,539;

FURTHER ORDERED that a copy of this paper shall be made of record in files application 09/103,056 and U.S. Patent 5,644,539;

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

JAMESON LEE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

SALLY C. MEDLEY
Administrative Patent Judge

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