

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CARLTON B. **MORGAN**, BRADFORD E. GLINER,
KENT W. LEYDE and THOMAS D. LYSTER II

Junior Party
(U.S. Patent 6,241,751)¹

v.

JAMES M. OWEN, RANDALL W. FINCKE,
JAMES P. O'LEARY and MARK H. TOTMAN

Senior Party
(Application 10/159,806)²

Patent Interference No. 105,451
(Technology Center 3700)

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

LEE, Administrative Patent Judge.

Decision -- Priority -- Bd. R. 125(a)

Introduction

1 Junior party Morgan filed a motion for judgment based on priority of invention, which
2 asserts a general date of actual reduction to practice sometime between April and June 1993.
3 Junior party's involved patent in this interference is based on an application filed on April 22,
4 1999, and the junior party has not sought to be accorded the benefit of any earlier filed
5
6

¹ Based on Application 09/299,455, filed April 22, 1999. The real party in interest is Koninklijke Philips Electronics N.V.

² Filed May 31, 2002. The real party in interest is Cardiac Science Operating Company. Accorded the benefit of Application 09/652,054, filed August 31, 2000, and Application 09/036,265, filed March 6, 1998.

1 application. Seventy months span the time between junior party's alleged actual reduction to
2 practice by June 1993, and the filing of junior party's application in April 1999.

3 Senior party Owen elected to stand on its accorded benefit date of March 6, 1998. Also
4 pending before us is a matter raised by a show cause order dated June 12, 2007, which found the
5 seventy months between junior party's alleged actual reduction to practice and filing of junior
6 party's base application as the basis for an inference of suppression or concealment by the junior
7 party. The order directed junior party Morgan to show cause why judgment should not be
8 entered against the junior party on the ground of suppression or concealment if the junior party
9 had actually reduced the invention to practice in June 1993. Junior party Morgan filed a
10 response to the show cause order, and senior party Owen filed a reply to junior party's response.

11 Because senior party Owen stands solely on its accorded benefit date and has filed no
12 priority motion to establish an earlier conception or reduction to practice, junior party Morgan
13 can prevail if it shows either that (1) it had an actual reduction to practice prior to the senior
14 party's earliest accorded benefit date of March 6, 1998, or (2) it had a prior conception, a later
15 reduction to practice, and continuous diligence in reducing the invention to practice from just
16 prior to the senior party's earliest accorded benefit date of March 6, 1998, to the junior party's
17 filing date of April 22, 1999. *See* 35 U.S.C. § 102(g).

18 Only the first alternative is of relevance here in the context of the junior party's priority
19 motion. That is so because junior party Morgan alleges an actual reduction to practice by June
20 1993, which is prior to the senior party's earliest accorded benefit date, and also because the
21 priority motion does not assert continuous reasonable diligence in reducing the invention to
22 practice from just prior to the senior party's earliest accorded benefit date of March 6, 1998, to
23 the junior party's constructive reduction to practice date of April 22, 1999 (Motion 1:3-9).

24 Consequently, the dispositive issue is whether junior party Morgan has demonstrated an
25 actual reduction to practice of the subject matter of the count by the end of June 1993. If not,
26 then the junior party has not demonstrated priority of invention. On the other hand, if the junior
27 party successfully demonstrates actual reduction to practice by the end of June, 1993, then we
28 need to address the issue raised in the show cause order, i.e., whether junior party Morgan has
29 shown good cause why judgment should not be entered against it on the ground of its having
30 suppressed and concealed the invention after actually reducing the invention to practice.

Analysis

A. Morgan's Priority Motion

Junior party Morgan has the burden of proof for its priority motion by a preponderance of the evidence. See *Bruning v. Hirose*, 161 F.3d 681, 684 (Fed. Cir. 1998).

The subject matter of the interference count is defined as "Claim 15 of Morgan's Patent 6,241,751 or Claim 15 of Owen's Application 10/159,806." The two claims are identical in wording and read as follows:

A method for delivering an impedance-compensated defibrillation pulse to a patient, comprising:

measuring a patient impedance of said patient;

selecting from a set of configurations in an energy storage capacitor network to deliver an impedance-compensated defibrillation pulse to said patient responsive to said patient impedance; and

delivering said impedance-compensated defibrillation pulse to said patient.

The invention is for delivering an impedance-compensated defibrillation pulse to a patient.³ With regard to "defibrillation," junior party's involved patent states (Spec. 1:17-34):

The only effective treatment for VF [ventricular fibrillation] is electrical defibrillation in which an electrical shock is applied to the heart to allow the heart's electro-chemical system to re-synchronize itself. Once organized electrical activity is restored, synchronized muscle contractions usually follow, leading to the restoration of cardiac rhythm.

The minimum amount of patient current and energy delivered that is required for effective defibrillation depends upon the particular shape of the defibrillation waveform, including its amplitude, duration, shape (such as sine, damped sine, square, exponential decay), and whether the current waveform has a single polarity (monophasic), both negative and positive polarities (biphasic) or multiple negative and positive polarities (multiphasic). At the same time, there exists a maximum value of current in the defibrillation pulse delivered to the

³ During proceedings before the Patent and Trademark Office, claim terms are properly construed according to their broadest reasonable interpretation consistent with the specification. *E.g.*, *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1990); *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). The specifications of Morgan's involved patent and Owen's involved application do not specifically limit "patient" to a human or any particular animal. Accordingly, the term "patient" is sufficiently broad to encompass a pig.

1 patient above which will result in damage to tissue and decreased efficacy of the
2 defibrillation pulse.

3
4 Thus, a defibrillation pulse is not just any electrical pulse. It has to be at least generally effective
5 in achieving defibrillation in the patient and should not be expected to kill the patient.

6 According to well established principle in interference law, to show actual reduction to
7 practice of an invention, a party must prove (1) that he constructed an embodiment (apparatus
8 invention) or performed a process (process invention) that met all the limitations of the
9 interference count, and (2) that he determined that the intended purpose of the invention would
10 be met. *Cooper v. Goldfarb*, 154 F.3d at 1327. In this case, the intended purpose is the
11 defibrillation of a patient as is made evident by the above-quoted portion of the specification.

12 Except for very simple inventions, to demonstrate an actual reduction to practice it is
13 necessary to determine whether the embodiment relied on would work for its intended purpose.
14 See *Mahurkar v. C. R. Bard, Inc.*, 79 F.3d 1572, 1578 (Fed. Cir. 1996). In its motion, junior
15 party Morgan did not assert and made no attempt to establish that the subject matter of the count
16 belongs to that category of inventions which are so simple that no testing is necessary to see if
17 the process performed actually worked for its intended purpose. Moreover, based on the above-
18 quoted description in junior party's specification regarding what is necessary for effective
19 defibrillation, and on the acknowledged fact (Spec. 1:35-45) that the varying impedance of
20 different patients affect the effectiveness of the "defibrillation" pulse, we find that it is not so
21 simple as to not require testing.

22 When testing is necessary, as it is here, the embodiment relied upon as evidence of
23 priority must actually work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d at 1327. The
24 inventor also must contemporaneously appreciate that the embodiment worked and that it met all
25 the limitations of the interference count. *Id.* Thus, for demonstrating actual reduction to practice
26 in this case, junior party Morgan must show that delivery of the defibrillation pulse to the patient
27 actually achieved defibrillation in the patient and was so recognized by the inventor.

28 According to junior party Morgan, co-inventor Thomas Lyster designed a defibrillator
29 which had a configurable capacitor bank to enable easy variation of the defibrillation
30 capacitance, and Mr. Douglas Roberts, who is not a named co-inventor, constructed an actual
31 prototype according to that design. The prototype was known as the "pig blaster" because it was

1 to be used to study live swine subjects, and by March 1993 the construction of the prototype was
2 complete. These assertions are supported by the declaration of Thomas Lyster (Exhibit 2015,
3 ¶ 3) and the corroborating declaration of Douglas Roberts (Exhibit 2016, ¶ 3).

4 According to junior party Morgan, the capacitor bank in the “pig blaster” prototype
5 included 8 capacitors of differing capacitances, any of which could be connected in parallel with
6 any combination of one or more of the other capacitors in the bank. The “pig blaster” was
7 connected to an Apple MacIntosh-based LabView controller, which operated as the user
8 interface for the defibrillator and allowed the configuration of the capacitors in the bank to be
9 easily changed. These assertions are supported by the declaration of Thomas Lyster (Exhibit
10 2015, ¶ 4) and the corroborating declaration of Douglas Roberts (Exhibit 2016, ¶ 4).

11 Morgan has shown that by the end of March 1993, a prototype defibrillator was built
12 which in theory could be used to perform the steps recited in the subject matter of the count.
13 However, because the count is directed to a process invention, to show an actual reduction to
14 practice each step in the process recited in the count had to have been actually performed.

15 According to junior party Morgan, following the construction of the “pig blaster,” a study
16 was performed by Brad Gliner with the assistance of Thomas Lyster, both co-inventors of
17 Morgan’s involved patent, using the “pig blaster” during the period from April 1993 through
18 June 1993 (Motion 3:16-17). As support for that assertion, Morgan cites to Paragraph 5 in the
19 declaration of Thomas Lyster. Paragraph 5 of the declaration of Thomas Lyster, however,
20 indicates nothing about when the study was performed.

21 According to the junior party, during the study these steps were performed (Motion 3:19
22 to 4:6): (1) measuring the impedance of the subject, (2) using the Macintosh computer to select
23 in the “pig blaster” one of the many capacitor configurations based on the measured impedance,
24 and (3) triggering the “pig blaster” to deliver the defibrillation pulse to the subject using the
25 selected capacitor configuration. These three steps correspond to the three steps included in the
26 subject matter of the count, albeit the count does not require the use of a computer to help in
27 making the selection of capacitor configuration. As support for these assertions, Morgan cites to
28 Paragraph 8 in the declaration of Thomas Lyster (Exhibit 2015). Paragraph 8 of the declaration
29 of Thomas Lyster, however, does not say anything about the cardiac condition of the subject
30 prior to and after delivery of the “defibrillation pulse.” We do not know what effect the
31 “defibrillating pulse” had on the subject. The evidence cited does not show that a “defibrillating

1 pulse” had been delivered and that the process performed actually achieved its intended purpose
2 of cardiac defibrillation.

3 The same deficiency exists in the corroborating declaration of Douglas Roberts which
4 states (Exhibit 2016, ¶ 5):

5 5. Although I did not actively participate in the subsequent swine study using
6 the “pig [b]laster” I did witness it being used in the study on several occasions
7 during the period from April 1993 through June 1993. In particular, I witnessed
8 the impedance of the subject being measured before each test. The configuration
9 of the capacitors in the capacitor bank of the “pig blaster” was then adjusted on
10 the basis of the impedance measurement, and the configured capacitors were
11 discharged into the subject.
12

13 Mr. Roberts says nothing about the condition of the subject before and after delivery of the
14 “defibrillating pulse.” We note also that Mr. Roberts does not refer to delivery or discharge of
15 any pulse to the subject. He refers to discharging “configured capacitors” into the subject. Thus,
16 Mr. Roberts does not corroborate either that a “defibrillating pulse” was delivered or that the
17 process performed actually worked for its intended purpose of defibrillating the subject.

18 Junior party Morgan argues, however, that (Motion 4:14-18):

19 An accurate description of the study conducted using the “pig blaster”
20 during the period from April 1993 through June 1993 was described in a
21 September 15, 1995 edition of *Circulation* entitled “Transthoracic Defibrillation
22 of Swine With Monophasic and Biphasic Waveforms,” co-authored by Mr. Lyster
23 and other inventors, which can be found for the Board’s reference as Exhibit F to
24 Exhibit 2015.
25

26 In support of that argument is Paragraph 6 in Thomas Lyster’s declaration (Exhibit 2015) which
27 reads as follows:

28 6. The study we performed using the “pig blaster” is accurately
29 described in a September 15, 1995 edition of *Circulation* entitled “Transthoracic
30 Defibrillation of Swine With Monophasic and Biphasic Waveforms,” which I co-
31 authored and which is appended hereto as Exhibit F.
32

33 The publication referred to by Morgan (hereinafter “the 1995 publication”) includes four
34 co-authors only one of whom, Thomas Lyster, is a named inventors in Morgan’s involved patent.
35 Morgan’s motion refers to co-authors of the 1995 publication other than Thomas Lyster as
36 “inventors” but makes no attempt to explain the respective contributions of each to the subject
37 matter disclosed in the publication. It cannot be assumed that all of the contents of the 1995

1 publication reflect the study allegedly performed between April and June of 1993 based on the
2 design of Thomas Lyster as is presented in Morgan's motion.

3 The assumption cannot be made also because the testimony of Thomas Lyster is that
4 what was performed using the "pig blaster," supposedly between April and June of 1993, is
5 accurately described in the 1995 publication, and not that everything described in the 1995
6 publication is an accurate description of the work done with the "pig blaster" between April and
7 June of 1993. There is a substantial difference in meaning between the two. The former is the
8 testimony of Thomas Lyster and it leaves open the possibility and likelihood that a portion of the
9 1995 publication accurately describes the work of Thomas Lyster between April and June of
10 1993, but other portions describe other work, perhaps an improvement over earlier work. The
11 declaration of Thomas Lyster does not make clear which is which and what is what. The issue
12 takes on an elevated significance here, because the declaration of Thomas Lyster does not
13 indicate the time period during which the study was done. Such vague testimony is unhelpful to
14 Morgan. It is also unfair for senior party Owen as well as the Board to have to parse the 1995
15 publication and make a guess as to what portion reflects the work Morgan's inventors
16 accomplished between April and June of 1993. We decline to make that speculation.

17 Even assuming that Thomas Lyster meant to say and actually said in his testimony that
18 all of the description contained in the 1995 publication accurately and precisely describes his
19 work during the period from April to June 1993, neither Morgan's motion nor the declaration of
20 Thomas Lyster has pointed us to a portion of the 1995 publication which indicates that test
21 subjects were successfully defibrillated upon delivery of the defibrillation pulse. Neither party
22 Owen nor the Board should have to perform our own separate investigation of the evidence to
23 make out Morgan's case. Further assuming that the 1995 publication does describe that subjects
24 were successfully defibrillated, the successful defibrillation has no independent corroboration via
25 the testimony of any non-inventor. Much more importantly, party Morgan has not identified or
26 explained any independent corroboration of the testimony from co-inventor Thomas Lyster that
27 the study performed between April and June of 1993 is accurately described in the 1995
28 publication. Mr. Douglas Roberts, whose declaration (Exhibit 2016) was submitted to
29 corroborate the testimony of Thomas Lyster, made no corroboration of any kind concerning a
30 comparison between what he witnessed sometime between April and June 1993 about the study

1 performed by Douglas Gliner with the assistance of Thomas Lyster and the disclosure of the
2 1995 publication.⁴

3 Furthermore, several items represented in the motion as a part of the study allegedly
4 performed by Brad Gliner and Thomas Lyster between April and June of 1993 are evidently not
5 identified or described in the 1995 publication. Specifically, the 1995 publication does not
6 appear to describe the use of a bank of eight capacitors any one of which could be connected
7 with any one or more of the other capacitors in parallel to constitute a selectable capacitor
8 configuration, or the use of an Apple MacIntosh-based Lab View controller to make the selection
9 of capacitor configuration. That discrepancy raises doubt on the credibility and meaning of
10 Thomas Lyster's testimony that the study performed by Brad Gliner and him is accurately
11 described in the 1995 publication.

12 Based on all of the foregoing, Morgan has not shown that everything described in the
13 1995 publication is an accurate description of a study performed by Brad Gliner and Thomas
14 Lyster between April and June of 1993, in the sense that the entire content of the 1995
15 publication is an account of what was actually performed between April and June of 1993 by
16 Brad Gliner and Thomas Lyster while using the "pig blaster" constructed by Douglas Roberts.
17 As presented by Morgan, the 1995 publication is of little help to Morgan in attempting to
18 establish an actual reduction to practice by the end of June 1993.

19 Because junior party Morgan has not shown that the pulse delivered by operation of the
20 "pig blaster" and witnessed by Douglas Roberts sometime between April and June 1993 actually
21 defibrillated any subject, there has been no demonstration that the process then performed
22 worked for its intended purpose. Accordingly, for reasons discussed above, Morgan has not
23 established actual reduction to practice by the end of June, 1993.

⁴ An inventor's testimonial assertions of inventive facts require corroboration by independent evidence. Brown v. Barbacid, 276 F.3d 1327, 1335 (Fed. Cir. 2002); Cooper v. Goldfarb, 154 F.3d 1321 (Fed. Cir. 1998); Lacotte v. Thomas, 758 F.2d 611, 613 (Fed. Cir. 1985); Reese v. Hurst, 661 F.2d 1222, 1125 (CCPA 1981) ("[E]vidence of corroboration must not depend solely on the inventor himself."). The application of a rule of reason does not dispense with the requirement for independent corroborating evidence. Coleman v. Dines, 754 F.2d 353, 360 (Fed. Cir. 1985). See also Hahn v. Wong, 892 F.2d 1028, 1032 (Fed. Cir. 1989) ("An inventor must provide independent corroborating evidence in addition to his own statements and documents."). Such evidence may consist of testimony of a witness other than the inventor or evidence of surrounding facts and circumstances independent of information received from the inventor. Reese v. Hurst, 661 F.2d 1222, 1225 (CCPA 1961). The purpose of the rule requiring independent corroboration is to prevent fraud. Berry v. Webb, 412 F.2d 261, 267 (CCPA 1969).

1 B. The Board's Show Cause Order

2 Because Morgan has not established actual reduction to practice, the show cause order
3 which presumed suppression or concealment based on a seventy-month delay between the time
4 of purported actual reduction to practice and the filing of Morgan's patent application resulting
5 in its involved patent is moot. Suppression and concealment is no longer an issue, as we have no
6 occasion to find that Morgan suppressed or concealed the invention given that there had been no
7 prior reduction to practice.

8 Alternatively, assuming that Morgan proved actual reduction to practice by the end of
9 June 1993, Morgan has not shown good cause why it should not be deemed as having suppressed
10 and concealed the invention. We conclude that Morgan has suppressed or concealed its
11 invention.

12 The inventor who was first to invent, provided that he or she has not thereafter
13 abandoned, suppressed, or concealed the invention, is entitled to a patent. 35 U.S.C. § 102(g).
14 Too long a delay toward filing a patent application gives rise to a legal inference of suppression
15 or concealment. *Paulik v. Rizkalla*, 760 F.2d 1270, 1273 (Fed. Cir. 1985). Here, the seventy-
16 month delay gave rise to such an inference and properly served as the basis for an order for party
17 Morgan to show cause why judgment should not be entered against it for having suppressed and
18 concealed the invention assuming that it had actually reduced the invention to practice.⁵

19 In rebutting the inference of suppression or concealment based on a seventy-month gap
20 between Morgan's purported actual reduction to practice and the filing of a patent application
21 which issued as Morgan's involved patent, Morgan made the argument that it could not have
22 suppressed and concealed because it disclosed the invention of the count as defined by Owen's
23 claim 15 in an article published in the September 15, 1995 edition of the journal *Circulation*,
24 titled "Transthoracic Defibrillation of Swine With Monophasic and Biphasic Waveforms."

25 The count of this interference is defined as Morgan's claim 15 or Owen's claim 15. The
26 two claims are identical in wording and include no means-plus-function language pursuant to
27 35 U.S.C. § 112, sixth paragraph. Morgan has not identified any special definition in either
28 party's specification for any claim term. Morgan has no basis to presume that Morgan's claims
29 15 and Owen's claim 15 are directed to different subject matter or that Owen's claim 15 is

⁵ Any public disclosure Morgan can show as having occurred during the period at issue goes toward rebutting the inference but does not demonstrate impropriety of the issuance of the show cause order based on the seventy-month delay.

1 broader in some respect than Morgan’s claim 15. No showing or reasoned explanation has been
2 made by Morgan in its response to the show cause order to establish why in Morgan’s view (1)
3 Morgan’s claim 15 requires the capacitor configuration to be selected on the basis of both patient
4 impedance and the desired energy level, and (2) Owen’s claim 15 only requires that the selection
5 be made on the basis of patient impedance. Morgan has not directed our attention to any
6 determination by the Board holding that to be so, and we are aware of none. On this record,
7 whatever describes Owen’s claim 15 also describes Morgan’s claim 15. And if the article
8 describes the subject matter of Owen’s claim 15 as Morgan’s response asserts, then it would also
9 describe the subject matter of Morgan’s claim 15. The end result will be a holding of
10 unpatentability against all of Morgan’s claims corresponding to the count.⁶

11 Party Morgan, however, failed to identify and show where in the 1995 publication is a
12 description for each feature of the process defined by the invention of the count. There is only
13 counsel’s unsupported argument (Motion 13:2-6) that:

14 This publication described the prototype defibrillator of the swine study and the
15 technique of measuring patient impedance and then selecting one of several
16 different capacitor configurations for delivery of a defibrillation pulse. [Exhibit
17 2015, ¶ 19]. Thus, the *Circulation* article fully described the subject matter of the
18 Count as interpreted consistently with the OWEN specification.
19

20 Exhibit 2015 is the declaration of co-inventor Thomas Lyster but it has no Paragraph 19. We can
21 find no paragraph which clearly describes, for each feature of the count, where in the 1995
22 publication a corresponding description can be found. Argument of counsel cannot take the
23 place of evidence lacking in the record. *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977),
24 *cert. denied*, 434 U.S. 854; *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney=s
25 argument in a brief cannot take the place of evidence.”).

26 In rebutting the inference of suppression or concealment based on a seventy-month gap
27 between Morgan’s purported actual reduction to practice and the filing of a patent application
28 which issued as Morgan’s involved patent, Morgan also made the argument that it could not have
29 suppressed and concealed because it filed a patent application on July 31, 1996, not the patent

⁶ By definition, a claim corresponds to a count if the subject matter of the count, if treated as prior art, either anticipates or renders obvious the subject matter of the claim. 37 C.F.R. § 41.207(b)(2). Therefore, if a publication describes and thus anticipates the count, it follows without more that the publication renders unpatentable all claims corresponding to the count, provided that the publication qualifies as prior art. In this case, the September 15, 1995 publication date of the article makes the article statutory prior art under 35 U.S.C. § 102(b) in light of the April 22, 1999 filing date of the application which issued as Morgan’s involved patent.

1 application which issued as Morgan's involved patent, but a patent application nonetheless,
2 which describes the invention of the count as defined by Owen's claim 15. That application
3 issued as Patent 5,749,904 (Exhibit 2002)(Gliner patent). Here, it suffices to say only that
4 Morgan's response to the show cause order contains no analysis comparing the disclosure of the
5 Gliner patent to each limitation required by the count in this interference, whether it is Morgan's
6 claim 15 or Owen's claim 15. There is only counsel's conclusory statement that the count as
7 defined by Owen's claim 15 is described in the Gliner patent (Response 5:n.3; 14:n.4; 15:6-7).
8 Argument of counsel cannot take the place of evidence lacking in the record. Meitzner v.
9 Mindick, 549 F.2d at 782; In re Pearson, 494 F.2d at 1405.

10 Consequently, Morgan has not shown that it disclosed the invention of the count in the
11 1995 publication or in the specification of the Gliner patent which was filed on July 31, 1996.
12 Also, Morgan's response to the show cause order identifies no activity from July 31, 1996, to the
13 April 22, 1999, the filing date of Morgan's involved patent (See Chart in Attachment A,
14 Response to Show Cause Order). Even assuming that Morgan had been diligent through July 31,
15 1996, in perfecting the invention and in bringing the invention to the public, a thirty-three
16 months gap still exists from July 31, 1996, to April 22, 1999, for which no activity has been
17 shown.⁷ The gap remains unexplained, and is significant because Morgan indicates that as early
18 as June of 1994, the invention had been perfected for human use (Response 11:10-13; 14:n.4).

19 For the foregoing reasons, if Morgan actually reduced to practice the invention of the
20 count by the end of June, 1993, then it has suppressed or concealed that invention because it has
21 shown no diligent activity in disclosing the invention to the public, in further perfecting the
22 invention, or in filing a patent application during the thirty-three months from July 31, 1996 to
23 April 22, 1999. In Shinedelar v. Holdeman, 628 F.2d 1337 (Fed. Cir. 1980), a delay of twenty-
24 nine months between actual reduction to practice and receipt of an invention disclosure by a
25 patent attorney, and actual filing of a patent application for the invention, was sufficient to
26 support a holding of suppression or concealment because it was held, as is here, that the delay
27 was unreasonably long.

⁷ Contrary to Morgan's assertion, the Board has not required activity for every working day for a showing of reasonable diligence. Morgan was merely required to submit a diligence table with its response to the show cause order, which table accounts for each working day, consistent with ¶ 208.6 of the Standing Order. Such a table renders evident where any gap in activity may exist. If there is a gap, it can be explained and does not per se establish lack of reasonable diligence. If there is no gap, that also does not per se establish reasonable diligence.

1
2 Conclusion
Morgan's Motion 1 for priority of invention is **denied**.

/ss/ Jameson Lee
JAMESON LEE
Administrative Patent Judge

/ss/ Sally G. Lane
SALLY G. LANE
Administrative Patent Judge

/ss/ Sally C. Medley
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