

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NEIL ANDREW JAMESON

Appeal No. 2006-1699
Application No. 10/242,669

ON BRIEF

Before HAIRSTON, JERRY SMITH, and SAADAT, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a decision dated June 22, 2006, the Board found that evidence presented by the appellant was not sufficient to antedate the effective filing date of the Telya publication which was used by the examiner to reject all of the claims on appeal.

Appellant now argues (request, page 2) that “[t]he Board, in its decision, appears to focus on evidence prior to the Telya date, i.e., Rule 131 Declaration and Exhibits 2 & 3, while ignoring the evidence of invention on the Telya date, i.e. the Rule 131 Declaration and Exhibit 1.” We find that “[t]he mere recital of timing registers, control registers, an interface and a state machine in the last paragraph on page 1 of Exhibit 1 is not evidence

that the appellant had conceived or reduced to practice the specifically recited claimed invention” on the Telya publication date of July 11, 2002 (decision, page 7).

Appellant argues throughout the request that the Board disregarded evidence submitted by the appellant in favor of our own opinions. We disagree. The evidence submitted by appellant was weighed against the evidence of record (e.g., the claims on appeal), and it was not found to demonstrate that the appellant had reduced to practice the specifically claimed invention on or before the noted Telya publication date.

Appellant argues (request, page 4) that “[t]he sum total of these three fact statements, i.e., paragraphs 3, 4 and 7 from the Rule 131 declaration establishes that Mr. Jameson invented the subject matter of the claimed invention on or before July 11, 2002 and his testimony is that Exhibit 1, the invention disclosure form, describes that claimed invention.” As indicated supra and throughout the decision, Exhibit 1 does not describe the claimed invention.

Appellant argues (request, pages 4 and 5) that “the only reasonable decision the Board can make is to find that there is at least ‘some evidence’ that Mr. Jameson invented the appealed invention on or before July 11, 2002, the Telya publication date.” We still maintain that the “only supporting evidence of record is Exhibit 2 which vaguely mentions control registers in connection with a NAND, and Exhibit 3 which only mentions a NAND in connection with registers in general” (decision, page 6). “Such broad statements in the exhibits certainly do not provide evidence that the appellant had conceived or reduced to practice the specifically recited timing registers, the specifically recited control registers that are programmable prior to each transfer, and the sequence generator operable in

response to the numbers of timing as well as control registers set forth in the claims on appeal” (decision, page 6).

Appellant’s argument (request, page 5) to the contrary notwithstanding, the evidence submitted by the appellant does not establish that “the prior art does not meet the requirements of 35 USC § 102(a).”

The so-called ‘supporting evidence’ submitted by appellant in Exhibits 2 and 3 is nothing more than bits and pieces of the structure set forth in claim 1 on appeal (request, page 5).

Appellant argues that the Rule 131 declaration was “sufficient to meet the requirements of swearing behind the reference” (request, page 6). We still maintain that the Rule 131 declaration was not sufficient to antedate the Telya publication date.

Appellant argues (request, page 7) that paragraphs 8 through 10 of the declaration “individually and collectively establish that Jameson conceived of the invention prior to July 11, 2002.” The noted paragraphs in the declaration discuss Exhibits 2 and 3. As indicated supra, Exhibits 2 and 3 do not establish that Jameson conceived of the invention prior to the July 11, 2002 publication date.

Appellant argues (request, pages 7 through 10) that the Board misinterpreted the McGuckian and the Katz cases. We stand by our interpretations of these cases outlined in the decision. Neither of the cases supports the appellant’s erroneous interpretation of their holdings.

We agree with the appellant’s argument (request, page 11) that the “Jameson Declaration is fact evidence.” As indicated in the decision, the declaration did not,

however, sufficiently demonstrate that the Telya publication is not a proper reference to be applied against the claimed invention.

As indicated supra, appellant's argument (request, page 11) that 'the last paragraph of page 1 of Exhibit 1 parallels the structure and interrelationship of structures set out in claim 1 of the above-identified patent application and therefore, clearly describes the claimed invention' is without merit.

In summary, a mere reading of the evidence submitted by appellant reveals that the evidence falls short of establishing that the Telya publication is antedated by actions performed by appellant (request, pages 11 and 12). The Board did not "ignore fact statements and evaluations made in a sworn Rule 131 affidavit" (request, page 13). We merely disagree with the appellant's assumption that the sworn facts are sufficient to remove Telya as a proper reference in the rejection on appeal.

Appellant's request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a) (1) (iv).

REHEARING
DENIED

)
Kenneth W. Hairston)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
Jerry. Smith)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Mahshid D. Saadat)
Administrative Patent Judge)

KWH/eld

Appeal No. 2006-1699
Application No. 10/242,669

Page 6

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203