The opinion in support of the decision being entered today is not binding precedent of the Board.

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Paper No. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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SAMY BOUZIDA, CHRISTOPHE MIGNOT,
and MIKE V. POWERS,

Junior Party
(Application 08/991,717),

v.

HENRY E. BEAMER and TIMOTHY A. COWELL

Senior Party
(Patent 5,730,214)

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Patent Interference No. 104,621

_____

MEMORANDUM OPINION AND JUDGMENT

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

MEDLEY, Administrative Patent Judge.

A. Introduction

As a result of the decision on preliminary motions (Paper 51), Bouzida became the junior party in this interference. The interference was redeclared to indicate that Bouzida is the junior party and that Beamer is the senior party (Paper 52).

In Bouzida's preliminary statement, Bouzida stated that Bouzida "does not intend to present evidence to prove a prior conception of an actual reduction to practice of the subject matter of Count 1, and intends to reply (sic) solely on the priority of the filing date of their French priority application, French Patent Application No. 96.15584, filed on December 18, 1996." (Paper 29 at 1). Beamer unopposed preliminary motion 2, attacking the benefit granted Bouzida to its French priority application No. 96.15584, filed on December 18, 1996 was granted. An order to show cause was filed requesting Bouzida to show cause why the interference should continue, since Bouzida does not allege an earlier date of invention relative to Beamer (Paper 53).

On October 15, 2001, Bouzida filed a paper entitled "BOUZIDA'S MEMORANDUM IN RESPONSE TO THE ORDER TO SHOW CAUSE" (Paper 55). On October 15, 2001 Bouzida also filed a paper entitled "BOUZIDA'S MOTION PURSUANT TO 37 C.F.R. §§ 1.640(e)(3) and 1.635" (Paper 56).

In response to the order to show cause, Bouzida does not demonstrate that it can prove a date prior to Beamer. Instead, Bouzida's response to the order to show cause is essentially a request for reconsideration of the denial of Bouzida preliminary motion 1. Bouzida's motion under 37 C.F.R. §§ 1.640(e)(3) and 1.635 is a request for a testimony period to introduce evidence

that Bouzida wishes the board to consider at final hearing in connection with the denial of Bouzida preliminary motion 1 (Paper 56 at 2).

For the reasons that follow, we deny Bouzida's motion under 37 C.F.R. §§ 1.640(e)(3) and 1.635. We treat Bouzida's response to the order to show cause as a request for reconsideration of our earlier decision denying Bouzida preliminary motion 1. Bouzida's request for reconsideration of the denial of Bouzida preliminary motion 1 is denied. Finally, since Bouzida does not contest the board's decision that judgment should be entered against Bouzida, we enter judgment against Bouzida.

B. Discussion

Bouzida motion for testimony and final hearing

Bouzida states in its motion under 37 C.F.R. §§ 1.640(e)(3) and 1.635, that "Bouzida does not contest the Board's decision that it is not entitled to a judgment of priority as the (sic) Count" (Paper 56 at 2). Thus, Bouzida concedes priority to Beamer.

Bouzida requests in its motion under 37 C.F.R. §§ 1.640(e)(3) and 1.635, that Bouzida be granted a final hearing in connection with its preliminary motion 1. Apparently, Bouzida would also like to introduce evidence in support of its preliminary motion 1 that we have not previously considered (Paper 56 at 2).

Bouzida argues that we should consider its preliminary motion 1 during a final hearing to determine if the board legally erred in denying Bouzida's preliminary motion 1. Bouzida then cites to a string of cases for the proposition that the board should resolve patentability issues when those questions are fully presented.

A three judge panel has already determined patentability issues raised in this interference. Specifically, a three judge panel has already once considered and decided Bouzida preliminary motion 1. Thus, this is not a situation where a party has raised a patentability issue and the board has not considered the issue.

Since the inception of the Trial Section[1], it has been the standard practice for a three judge motions panel to decide all preliminary motions in an interference. The Trial Section is of the opinion that entry of three judge decisions is more efficient and establishes the law of the case. In this interference, a three judge panel decided the preliminary motions filed during the preliminary motions phase of the interference (Paper 51).

The scope of review at final hearing of a three-judge interlocutory order is explained in Trial Section precedential opinion Charlton v. Rosenstein, No. 104,148, 2000 Pat. App. Lexis

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[1] See Notice of the Chief Administrative Patent Judge of Nov. 6, 1998, Interference Practice - New Procedures for Handling Interference Cases at the Board of Patent Appeals and Interferences, 1217 Off. Gaz. Pat. & T. Office 18 (Dec. 1, 1998).

4 (Bd. Pat. App. & Int. (Trial Section) 2000).

As explained in Charlton:

> When there is review at final hearing by a 3-judge panel of an interlocutory order entered by a 3-judge panel (which will almost always be the same three judges), the case takes on a different posture. All three judges previously considered the record and cast their votes. Any review at final hearing will be on the same record and new arguments are not authorized. It should be apparent that when a 3-judge panel reviews its previous decision, the 3-judge panel, in effect, is reconsidering its earlier decision. There is no de novo consideration. Hence, it will be necessary for a party asking for review to establish that the 3-judge panel overlooked or misapprehended something in entering the order sought to be reviewed. 2000 Pat. App. Lexis 4.

A three judge panel decision establishes the law of the case. A party need not seek review of a decision made by a three judge panel to preserve a party's right to seek judicial review. The decision on preliminary motions is herein made final for purposes of judicial review.

In essence, Bouzida seeks final review of our decision to deny its preliminary motion 1. As stated above, however, such a request for "review" is treated as a request for reconsideration. A party seeking "review", e.g. reconsideration of the decision on preliminary motions, is not permitted to make new arguments, or file new evidence in support of the request.

Accordingly, Bouzida's request for a testimony period to be

set to introduce evidence in support of its preliminary motion 1 is denied. Furthermore, this interference need not be prolonged any further by allowing Bouzida to file a request for reconsideration at a later time. We have before us Bouzida's request for reconsideration, which is decided in this paper. Accordingly, there is no occasion to allow Bouzida to refile what it has already filed.

Bouzida states in its response to the order to show cause that if the board does not grant Bouzida's motion for a testimony period, then we should consider Bouzida's arguments as to why judgment should not be entered against Bouzida (Paper 55 at 2).

Bouzida's arguments as to why judgment should not be entered against it are based on the premise that the three judge panel erroneously decided Bouzida preliminary motion 1. Even if we were to agree with Bouzida, which we do not, judgment would still be entered against Bouzida. That judgment can be entered against one party does not preclude judgment from being entered against another party. There can be two losers in a two party interference. Thus, the mere fact that Bouzida does not agree with our decision to deny its preliminary motion 1 does not preclude the panel from entering judgment against Bouzida.

Bouzida's response to the order to show cause is essentially a request for reconsideration of the denial of Bouzida preliminary motion 1. Accordingly, we treat it as such.

A request for reconsideration of a three judge panel decision must be made within 14 days of the decision. 37 CFR § 1.640(c). The decision on preliminary motions was entered in this interference on September 20, 2001. Thus, any request for reconsideration was due within 14 days of that decision. Bouzida's request for reconsideration was received on October 15, 2001, beyond the fourteen day deadline, and thus is not timely.

Nonetheless, we consider Bouzida's request for reconsideration as follows.

Bouzida's request for reconsideration of its preliminary motion 1

A party requesting reconsideration of a 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.

Bouzida argues that the panel erred in determining that Beamer claim 1 includes louvers having at least three different angles. Bouzida argues that the dictionary definitions of "est" and "superlative" make clear that shallowest and steepest do not indicate a comparison between three or more things. Bouzida disagrees with our interpretation of the terms "steepest" and

"shallowest" as those terms are recited in Beamer claim 1.

As stated above, a request for reconsideration will not be granted where the moving party merely disagrees with the panel. Further, Bouzida's argument regarding interpretation of "est" and the "superlative" form of a word were not presented in connection with its preliminary motion 1. Thus, this a new argument.

Bouzida further argues that it was error for the panel to conclude from the use in Beamer claim 1 of "shallower, initial louvers" and "steeper louvers in successive walls" that Beamer used the term "shallowest" and "steepest" to refer to sets having three or more angles and used shallower and steeper to refer to a set having only two increasing angles. Bouzida disagrees with our analysis regarding the different use of the comparative and superlative form of the word "shallow" within claim 1. However, mere disagreement is not sufficient to grant a request for reconsideration of our earlier decision. We see no error in our analysis. Bouzida has failed to direct us to points that we misapprehended or overlooked in connection with Bouzida's arguments made in its preliminary motion 1.

Bouzida argues that the panel erred in narrowly interpreting Beamer claim 1, such as to exclude one of Beamer's disclosed embodiments showing louvers with only two angles (Paper 55 at 5-8). Bouzida cites to Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1676, 1583, 39 USPQ2d 1573, 1578 (Fed. Cir. 1997) for the

proposition that claim interpretation excluding the preferred embodiment is rarely, if ever, correct and would require highly persuasive evidentiary support (Paper 55 at 6).

Bouzida did not, in its preliminary motion 1, argue that the embodiment in Beamer's patent that discloses a pattern of louvers having two different angles was a preferred embodiment. Nor did Bouzida, in its preliminary motion 1, direct us to a particular passage in the Beamer patent that disclosed that the two angled louver arrangement was the preferred embodiment, or was in any way preferable over the at least three angled louver arrangements. Bouzida has failed to direct us to where in the Beamer specification it is stated that, or even to explain why, a two angled louver arrangement is <u>the preferred embodiment</u>.

Bouzida further argues that the panel erred in reading Beamer claim 1 narrowly to exclude the two angled embodiments, since the superlative form of a word is commonly used instead of the comparative form when comparing two items (Paper 55 at 7). Apparently, Bouzida is arguing that it is probable that the drafter of the Beamer claims used the superlative form of the word "shallow" when he/she really meant to use the comparative form of the word. Bouzida directs us to evidence presented in support of Beamer's opposition to Bouzida preliminary motion 1. According to the <u>Penguin Dictionary of American Usage and Style</u>, it is often the case that the superlative form of a word is used

mistakenly, instead of the comparative form of the word.

The Penguin Dictionary of American Usage and Style was not considered in rendering our decision on Bouzida preliminary motion 1. Beamer's opposition was not considered, since Bouzida failed to sufficiently demonstrate that it was entitled to the relief sought (Paper 51 at 22).

Furthermore, Bouzida did not, in its preliminary motion 1, direct us to evidence that would demonstrate that the drafter of Beamer claim 1 made the allegedly common mistake of using the superlative form of the word "shallow" when the drafter intended the comparative meaning of the word.

Bouzida appears to accuse the panel of improperly reading limitations into Beamer claim 1 to arrive at our interpretation (Paper 55 at 6-7). In the decision on Bouzida preliminary motion 1, the panel's analysis began with the language of the claim (Paper 15-16). We looked to the specification to support our interpretation, as was pointed out in our decision (Paper 55 at 16). Thus, we disagree that we impermissibly imported limitations into Beamer claim 1.

Bouzida disagrees with our decision to require Bouzida to enter into evidence the examiner's statement (Paper 55 at 9). However, Bouzida was not penalized for not doing so. We considered Bouzida's arguments regarding the examiner's statement. Thus, this point appears moot. We reiterate, as we

stated in our opinion, however, that examiner's conclusions are not binding on the Board. See Glaxo Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (BPAI (ITS) 2000). (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). The examiner's statement is not under review.

In our decision, the panel commented on the examiner's statement, although it need not have done so. We stated that:

> Bouzida has failed to demonstrate that the examiner incorrectly interpreted Beamer claim 1 (the count) in the same manner as Bouzida. That is, Bouzida has failed to direct us to evidence that demonstrates that the examiner interpreted Beamer claim 1 to have louvers with at least two angles. Based on the record before us, the examiner interpreted Beamer claim 1 as having louvers with at least three angles. Therefore, the examiner's conclusion that Beamer claim 2 and Beamer claim 3 should correspond to the count would make sense, given that Beamer claim 2 and claim 3 recite louvers having at least three angles with other minor variations (Paper 51 at 21).

Bouzida argues that the panel erred in determining that Bouzida failed to demonstrate that the examiner incorrectly interpreted Beamer claim 1 (the count) in the same manner as Bouzida. Bouzida presents new arguments as to how the examiner probably interpreted the claims involved in the interference

(Paper 55 at 9). Specifically, Bouzida argues that since the examiner's statement indicates that Bouzida claims 1, 2, 7, 13, 15 and 16, directed to two angled louver arrangements, were determined to correspond to the count, then the examiner interpreted the count as claiming a two angled louver arrangement. This argument was not presented in connection with Bouzida's preliminary motion 1. Furthermore, as stated above, we are not bound by an examiner's decision. Lastly, the examiner did refer to Bouzida's claims 1, 2, 7, 13, 15 and 16 as broader in scope than the count. Thus, it is possible that the examiner did interpret the count as reciting louvers having at least three different angles, and that the at least two angled louvered arrangements would be anticipated by or obvious in view of the count.

Bouzida also argues that the examiner stated that Beamer claims 2 and 3, reciting at least three angled louver arrangements are "virtually identical to the count" except for minor recitations. The examiner's statement could be interpreted to mean that the examiner thought that the count recited an at least three angled louver arrangement. In any event, Bouzida's arguments regarding the possible "state of mind" as to what the examiner believed, was not raised in connection with its preliminary motion 1.

C. Conclusion

Having considered Bouzida's arguments in its request for reconsideration, we conclude that Bouzida has failed to demonstrate that we misapprehended or overlooked any fact or argument first presented prior to the filing of the request for reconsideration.

The decision on preliminary motions (Paper 51) has been reconsidered to the extent necessary to provide the discussion here. No change in the decision will be made. Bouzida's request for reconsideration is denied.

Beamer need not file an opposition to Bouzida's motion for testimony period and final hearing on Bouzida preliminary motion 1.

Upon consideration of the record, it is

ORDERED that the interlocutory decision on preliminary motions is final for purposes of judicial review;

FURTHER ORDERED that Bouzida's motion for final hearing and additional testimony on its preliminary motion 1 is denied;

FURTHER ORDERED that Bouzida's request for reconsideration of the decision on Bouzida preliminary motion 1 is denied;

ORDERED that judgment on priority as to Count 1 (Paper 1 at 49), the sole count in the interference, is awarded against

junior party SAMY BOUZIDA, CHRISTOPHE MIGNOT, and MIKE V. POWERS.

FURTHER ORDERED that junior party SAMY BOUZIDA, CHRISTOPHE MIGNOT, and MIKE V. POWERS is not entitled to a patent containing claims 1, 2, 7, 13 and 15-17 (corresponding to Count 1) of application 08/991,717, filed 16 December 1997.

FURTHER ORDERED that a copy of this paper shall be made of record in files of application 08/991,717 and U.S. Patent 5,730,214.

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	
_____ SALLY GARDNER-LANE Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
_____ SALLY C. MEDLEY Administrative Patent Judge	

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