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Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

AKIRA TOMITA, DAVID AMM,
MICHAEL DANEMAN and BRYAN STAKER

Junior Party
(Application 10/003,054)

v.

ASIF A. GODIL, and DAVID M. BLOOM

Senior Party
(Patent No. 6,169,624 B1)

Patent Interference No. 105,313

Before LEE, MOORE and POTEATE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

Decision – Order to Show Cause – Bd. R. 202(d)

A. Background

1. This interference was declared on May 6, 2005.

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2. Junior party Tomita is involved in this interference on the basis of its application 10/003,054, filed December 6, 2001.

3. Senior party Godil is involved in this interference on the basis of its Patent No. 6,169,624 B1, issued from application 09/372,649, filed August 11, 1999.

4. The single count, Count 1, is as follows:

Claim 25 of Tomita's Application 10/003,054
or
Claim 1 of Godil's Patent No. 6,169,624 B1

5. Claim 25 of Tomita's involved application reads as follows:

A reflective light processing element capable of modifying at least one characteristic of an optical beam, comprising:

a plurality of wide reflective surfaces, the wide reflective surfaces being substantially coplanar;

a plurality of narrow reflective surfaces, the narrow reflective surfaces being substantially coplanar, the narrow reflective surfaces facing substantially a same direction as the wide reflective surfaces, the narrow reflective surfaces alternatingly arranged with the wide reflective surfaces, the narrow reflective surfaces and the wide reflective surfaces defining a plurality of gaps between and normal to the narrow reflective surfaces and the wide reflective surfaces; and

a plurality of compensating reflective surfaces, the compensating reflective surfaces being substantially coplanar, the compensating reflective surfaces facing substantially the same direction as the narrow reflective surfaces and the wide reflective surfaces, the compensating reflective surfaces being positioned in each gap between the narrow reflective surfaces and the wide reflective surfaces, each compensating reflective surface being at least as wide as each gap;

wherein the wide reflective surfaces are capable of a displacement in a direction normal to the narrow reflective surfaces and compensating reflective surfaces, the displacement of the wide reflective surfaces capable of modifying at least one characteristic of the incident optical beam.

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6. Junior party applicant Tomita has been accorded the benefit of the earlier filing date of Application 09/802,619, filed March 8, 2001.

7. Senior party patentee Godil has not been accorded the benefit of the filing date of any earlier filed applications.

8. When junior party applicant Tomita first requested the declaration of an interference with Patent No. 6,169,624, 37 CFR § 1.608(b) was in effect, which required a showing by Tomita of why it is entitled to priority relative to the patentee. The same showing requirement now appears in new Board Rule 202(d), i.e., 37 CFR § 41.202(d), effective September 13, 2004.

9. When filed, junior party Tomita's involved application named five inventors, Akira Tomita, David Amm, Michael Daneman, Jim Hunter, and Bryan Staker. Upon petition, the named inventorship of junior party's involved application was corrected to delete the name of Jim Hunter as a co-inventor. See Paper No. 10 of Tomita's involved application.

10. Junior party applicant Tomita's Rule 608(b) showing of priority consists of the declaration testimony of each of the four inventors, together with Exhibits A, B, and C, and the declaration testimony of non-inventor Jim Hunter.

11. Party Tomita's Rule 608(b) showing alleges and attempts to establish prior actual reduction to practice of the invention of the count, prior to senior party Godil's filing date.

12. Concurrent with the declaration of this interference, junior party Tomita was placed under an order to show cause (Paper No. 3) why judgment should not be entered against the junior party on the ground that the junior party has not satisfied the requirement under

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37 CFR § 41.202(d) to show priority under 35 U.S.C. § 102(g), in order for the interference proceeding to proceed.

13. The basis of the show cause order was that party Tomita's Rule 608(b) showing did not demonstrate, in connection with its proof of actual reduction to practice, that the device constructed was tested and actually worked for its intended purpose.

14. On May 31, 2005, junior party Tomita filed its response (Paper No. 10) to the show cause order. Party Tomita does not dispute that its Rule 608(b) showing must demonstrate that the device relied upon as an actual reduction to practice must have been shown to have worked for its intended purpose. In that connection, however, party Tomita's response includes a second declaration from James Hunter (Exhibit 2002).

B. Discussion

For reasons discussed below, junior party Tomita has not shown good cause why judgment should not be entered against the junior party.

A junior party applicant who fails to demonstrate a prima facie showing under 37 CFR § 41.202(d) may file additional evidence only under very limited circumstances with a showing of good cause. 37 CFR § 41.202(d)(2). The showing of good cause requirement is the same as that under 37 CFR § 1.617(b), superceded by 37 CFR § 41.202(d)(2), which applied to submissions under 37 CFR § 1.608(b), superceded by 37 CFR § 41.202(d). The policy behind the showing of good cause requirement is articulated in the Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48423 (Dec. 12, 1984), in the context of 37 CFR § 1.617(b), as follows:

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The "good cause" showing required by § 1.617(b) imposes a stricter standard than was required under the prior rules. The stricter standard is necessary to encourage applicants copying claims from a patent to better prepare their initial showings under § 1.608(b). Under current practice, the Board of Patent Interferences has found that substantial time is lost in issuing orders to show cause based on an inadequate initial showing only to have an adequate showing made with the response to the order to show cause. Under the "good cause" standard, ignorance by a party or counsel of the provisions of the rules or the substantive requirements of the law would not constitute good cause.

See also, Hahn v. Wong, 892 F.2d 1028, 1034, 13 USPQ2d 1313, 1318-1319 (Fed. Cir. 1989)

(affirming the Board's holding of lack of showing of good cause). Note further that in *Huston v. Ladner*, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992), the Court of Appeals for the Federal Circuit held: "the Board did not abuse its discretion in finding that Huston's allegations of attorney misrepresentation and gross negligence failed to establish 'good cause' under 37 C.F.R. § 1.617(b)." In the underlying Board decision of that case, as noted by the Court of Appeals for the Federal Circuit, *Huston v. Ladner*, 973 F.2d at 1566, 23 USPQ2d at 1912, it was determined that the applicant's attorney did not appreciate the rule with regard to making the original showing complete and the substantive requirements of the law.

The junior party acknowledges that in the absence of extraordinary circumstances it may not submit additional evidence to supplement the evidence it originally submitted in the Rule 608(b) showing to demonstrate an actual reduction to practice (Paper 10, Page 13). Indeed, the response to the show cause order states on page 14: "It is clear that the law forbids, except under extreme circumstances, the submission of additional evidence establish a conception or actual reduction to practice at a time prior to the Senior Party's filing date." However, the junior party does not argue that there was any such extraordinary circumstance sufficient to establish good

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cause for submitting additional evidence. Rather, the junior party characterizes James Hunter's second declaration as merely evidence which show that the earlier showing is adequate to demonstrate an actual reduction to practice, different from evidence which add to the earlier evidence.

According to party Tomita (Response at page 14): "There is no prohibition on the submission of post-priority declarations and statements that confirm that the earlier showing is adequate to demonstrate an actual reduction to practice." Party Tomita cites no authority for that assertion. The assertion is rejected. A party may not submit evidence without an adequate explanation of the significance of that evidence, and then provide the explanation in the form of further testimony after the original showing has been ruled inadequate. The Board's decision must be made on the basis of the record that was created and presented by party Tomita for consideration, the first time. If the evidence in the record is inadequate for whatever reason, whether or not the inadequacy is in the form of missing explanation, it is too late to submit further testimony to support a missing explanation, in the absence of a showing of good cause.

The patent judge rules on whether party Tomita's Rule 608(b) submission constitutes an adequate showing based on the evidence and explanations included in the submission. It is misplaced for party Tomita to argue after the ruling that based on some other explanation and supporting evidence not included in the party's submission the patent judge came to the wrong conclusion. The key is the record created and presented by party Tomita in the original Rule 608(b) submission. Whatever party Tomita needs to make its case must be submitted in the original showing. Additional explanation and evidence in support of that explanation are

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prohibited in the absence of a showing of good cause, no different from any other additional evidence tending to show an actual reduction to practice. See, e.g., In re Zurko, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (“As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); Fromson v. Antiec Printing Plates, Inc., 132 F.3d 1437, 1448, 45 USPQ2d 1269, 1277 (Fed. Cir. 1997)(Mayer, C.J., concurring – “But, I am neither an expert in the field nor one of ordinary skill in the art despite how much I think I ‘know’ about a process I once studied. Nor do my colleagues on this court or the district court possess such expertise, and even if they did, they would have to defer to the record made in the case.”)

If the second declaration of James Hunter is necessary to explain the material in party Tomita’s original Rule 608(b) submission, e.g., how it would have been read and understood by one with ordinary skill in the art, it should have been included in that submission, not provided for the first time in the response to the show cause order. Thus, even if the second declaration indeed takes on the character alleged by party Tomita, it is not entitled to consideration.

In any event, the second declaration of James Hunter is not what party Tomita purports it is. It is not a declaration which is limited to an opinion on how Tomita’s original Rule 608(b)

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showing would have been read and understood from the perspective of a person with ordinary skill in the art. We do not find testimony in the second declaration to be in that nature or to have that character. Rather, the second declaration of James Hunter is filling in factual gaps about the details of the measurements referred to in the original Rule 608(b) showing, based on the personal knowledge of James Hunter who supposedly took those measurements.

For instance, the show cause order discussed how the testimony in the original showing about the measurements taken by James Hunter indicated only that they aided Mr. Hunter in understanding the invention and related innovations, and not that the measurements were taken on a device which had each of the elements recited in the count. Because on summary judgment a witness' testimony is ordinarily accepted at face value unless there is reason to do otherwise, if the declarant did not state that the measurements were taken when operating a device which had all the features of the count, it would be inappropriate to assume that that was the case.

Rather than explaining why one with ordinary skill in the art would have read and understood a vague and fuzzy statement that James Hunter conducted "certain measurements that aided in understanding of the invention and related innovations" as meaning that James Hunter took measurements on an actual device which had all the features recited in the count, the second declaration of James Hunter itself provides the specific information that was missing. On page 2 of James Hunter's second declaration, it is stated: "In particular, I confirmed that grating light valves **including the features recited in the claims of that U.S. patent application were made by myself and others** at the assignee of the application prior to August 11, 1999, Silicon Light

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Machines, now a division of Cypress Semiconductor, Inc. and that **I made certain measurements with respect thereto.**" (Emphasis added.) We find no statement by Mr. Hunter in his first declaration that he took measurements "with respect" to a device that had all the features of the count. The closest testimony in the first declaration is still a long way off: "I did in fact conduct certain measurements that aided in understanding of the invention and related innovations, which are reflected in pages 3-8 of Exhibit C, of Exhibit 1 attached hereto."

That the measurements James Hunter took were from a device which had all the features of the count appears to be information added on the basis of his personal knowledge. If that information is something one with ordinary skill in the art would have known based on the information provided in the original showing, the second declaration of James Hunter has not explained how. We do not credit this statement in James Hunter's second declaration: "In preparing this Declaration, I have relied exclusively on the materials in my earlier declaration." We are not persuaded that Mr. Hunter did not rely on personal knowledge or what he already knew from having taken the measurements himself.

Other examples abound. In paragraph no. 4 of his second declaration, James Hunter describes the device from which data was taken to form the upper illustration in Figure 4a. He states that the device included two sets of ribbons, one moveable with respect to the other to alter the distance of that set of ribbons from the substrate. He further states that the signal is recorded as the distance from the substrate to the ribbons is altered. It appears that Mr. Hunter is making the statement based on his personal knowledge after having seen the device and took measurements therefrom, since no explanation is offered as to why one with ordinary skill in the

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art, without any personal knowledge of the device or connection to making the measurements, would have known of those particular facts.

For the foregoing reasons, party Tomita has not shown good cause to have new evidence, in the form of James Hunter's second declaration (Exhibit 2002), considered. The declaration is not accepted for consideration.

Finally, and in the alternative, even if the second declaration of James Hunter is accepted for consideration, his position on what the illustrations in Figures 4a, and 4c of Exhibit C in the Rule 608(b) showing represent is not consistent with Exhibit C's own description of those figures. According to James Hunter, the illustrations are of data measurements taken by him on actual devices which had all the features of the count. However, on page 1 of the same Exhibit C, in the "Background" section, it is stated: "Shown in Fig. 4a, 4b, 4c are the predicted max. and min. diffraction efficiencies into the 0th order for substrate reflectivities of 30%, 50%, 80%, respectively, for a wavelength of 532nm." If the illustrations in the figures reflect mere "predicted" outcomes as the document containing the figures themselves state, that is contrary to the representation of James Hunter in his second declaration. It is noted that the highly regular curves in the figures are consistent with the description in the exhibit that the illustrations are predictions. In the absence of any explanation of the discrepancy, we do not credit the testimony of James Hunter over what the exhibit itself says about its own figures. Thus, even if the second declaration of James Hunter is accepted for consideration, which it is not, party Tomita has not shown good cause why judgment should not be entered against it.

C. Conclusion

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For reasons discussed above, the second declaration of James Hunter (Exhibit 2002) is not entitled to consideration. Since party Tomita's argument on why judgment should not be entered against Tomita is based on acceptance and consideration of James Hunter's second declaration, good cause has not been shown on why judgment should not be entered against junior party Tomita. And even if the second declaration of James Hunter is accepted for consideration and actually considered, for reasons discussed above party Tomita still has not shown good cause why judgment should not be entered against it.

Judgment will be entered against junior party Tomita in a separate paper.

<u>/ss/ Jameson Lee</u>)	
JAMESON LEE)	
Administrative Patent Judge)	
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<u>/ss/ James T. Moore</u>)	BOARD OF PATENT
JAMES T. MOORE)	APPEALS
Administrative Patent Judge)	AND
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