

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 109

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

CREG W. DANCE,
Junior Party,¹

v.

C. VAUGHAN SEIFERT, WOLCOTT M. DOWNEY,
and PETER J. SHANK,

Senior Party.²

Patent Interference No. 103,379

DECISION ON RECONSIDERATION

Before PATE, MARTIN, and CRAWFORD, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

¹ Patent No. 5,117,839, issued June 2, 1992, based on Application Serial No. 07/584,461, filed September 18, 1990. Assigned to Lake Region Manufacturing Co., Inc.

² Application Serial No. 08/069,829, filed May 28, 1993, for reissue of Patent No. 5,045,061 (hereinafter, Seifert's '061 patent), issued September 3, 1991, based on Application Serial No. 07/474,371, filed February 2, 1990. Assigned to C.R. Bard, Inc.

Dance has requested reconsideration and modification of various aspects of our FINAL DECISION AND JUDGMENT UNDER 37 CFR § 1.658(a), mailed June 20, 2000 (hereinafter, Decision). Seifert opposes the request in all respects. For the following reasons, Dance's request for modification of the Decision is denied in all respects.

A. Dance's alleged diligence and actual reduction to practice

In the Decision at 11-15, we held that Dance's and Dennis' declarations and exhibits establish conception of the subject matter of the count as of October 9, 1989, prior to Seifert's February 2, 1990, filing date, but fail to prove diligence during the critical period running from just before Seifert's filing date (considered to be the date of Seifert's entry in the field for the purpose of evaluating Dance's priority case) up to Dance's September 18, 1990, filing date (Decision at 15-16). As evidence of diligence, Dance relied on the description in Dance's declaration of the preparation of a number of documents prepared during the critical period (Dance Decl. at JR³ 17-18, ¶ 10). We held this testimony

³ Junior party Dance's record.

insufficient to prove diligence because "[n]one of these documents have been introduced into evidence, let alone with authenticating testimony by someone other than Dance. Furthermore, the preparation of these documents is not corroborated by Dennis or anyone else."

(Decision at 17.) Dance argues that

the sequence of acts listed in the Dance Declaration, since they are nowhere rebutted, must be taken as established for purposes of this proceeding. Clearly, to the extent corroboration is needed, the filing date of the Dance application is corroborated. Since Seifert in no way challenged the sufficiency of the assertions of the Dance Declaration on any basis[,] the Board is asked to recognize that diligence, to the extent it is needed, has been established as not having been objected to or otherwise disproved by Seifert. [Request at 3.]

This argument places the burden of proof on the wrong party.

It is Dance, as the party seeking to establish a date of invention prior to Seifert's filing date, who bears the burden of proving diligence, 37 CFR § 1.657(a) and § 1.657(b), which like conception must be corroborated. Price v. Symsek, 988 F.2d 1187, 1196, 26 USPQ2d 1031, 1038 (Fed. Cir. 1993).

Seifert was not required prior to filing his brief to identify the perceived weaknesses in Dance's priority evidence, with

the exception of objecting under § 1.672(c) to its admissibility⁴ if he intended to later move under § 1.656(h) to suppress it on that ground. As Seifert filed no such motion, he was not required to file a § 1.672(c) objection. Seifert's contention that Dance's testimony about the documents cited as proof of diligence lacks

corroboration does not raise an admissibility issue and thus need not have been noticed by way of an objection under § 1.672(c). Also, the admissibility of the documents themselves was never at issue, because they were not included in Dance's record.

Dance alternatively argues that a showing of diligence is unnecessary because the drawings which we held are sufficient to prove conception as of October 9, 1989, are also sufficient to establish an actual reduction to practice as of that date in accordance with Dance's preliminary statement, which asserts that the invention was actually reduced to practice on or before March 15, 1990 (Request at 2-

⁴ Admissibility is governed by the Federal Rules of Evidence, which are made applicable to interference proceedings by § 1.671(b).

3). Dance's reliance on the preliminary statement is improper because it is not evidence. 37 CFR § 1.629(e). Furthermore, the contention that the evidence establishes an actual reduction to practice fails because this evidence does not establish that (1) prior to Seifert's filing date, Dance constructed an embodiment that met every element of the interference count and (2) this embodiment operated for its intended purpose. Eaton v. Evans, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

B. The timeliness of Dance's motion to strike the initial reissue declarations of Seifert, Downey, and Shank

At pages 31-33 of the Decision, we held that Dance has not shown good cause under § 1.645(b) for waiting five and one-half months after the oral hearing to file the motion to strike the initial reissue declarations of Seifert, Downey, and Shank on the ground that they contain inadmissible hearsay due to absence of a supporting declaration by Seifert's counsel, Mr. Bookstein. We treated this motion as a motion to suppress evidence under § 1.656(h), which specifies that such a motion is due with the moving party's opening brief. Dance's argument that the motion should be considered timely because "it was only from and after that October 14, 1999[,]

hearing date that it was absolutely clear that no further declaration from Attorney Bookstein would ever be submitted" (Motion at 4) was rejected on the ground that "Dance knew as of the due date for his opening brief, which was subsequent to the close of Seifert's testimony period, that no Bookstein declaration had been filed" (Decision at 33). Dance now argues (Request at 3-4) that

[t]he rules must not be that unambiguous on the point of when it is absolutely clear that such a declaration would not be forthcoming because, as is noted by the Board on the top of page 31 from Seifert's brief, apparently with approval[:]

[]No supporting declaration was filed by Bookstein, although Seifert's brief for final hearing states that "should it become necessary or desirable to do so, such a declaration can and will be furnished[.]"

Our observation that Seifert's brief included an offer to file a Bookstein declaration was not intended to imply prospective approval of that offer. This should be apparent from the fact that the offer was mentioned in the summary of the background facts of Dance's § 1.633(a) motion for judgment under 35 U.S.C. § 251 (Decision at 28-31) rather than in the discussion of Dance's motion to strike (id. at 31-36). All of

the evidence on which Seifert intends to rely to demonstrate compliance with 35 U.S.C. § 251 was due with the opposition to Dance's 37 CFR § 1.633(a) motion. See Irikura v. Petersen, 18 USPQ2d 1362, 1368 (Bd. Pat. App. & Int. 1990) ("A good faith effort must be made to submit evidence to support a preliminary motion or opposition when the evidence is available. Orikasa v. Oonishi, [10 USPQ2d 1996, 2000 n.12 (Comm'r Pats. & Trademarks 1989)].") Further- more, in Paper No. 54⁵ (at 12) the Administrative Patent Judge advised the parties that any new evidence submitted in connection with previously filed motions "may be submitted with respect to such motions only upon a showing (§ 1.635) that the evidence was unavailable when the corresponding motion, opposition or reply was filed. Such a motion must be filed at least **10 days** prior to the end of that party's relevant testimony period." As no Bookstein declaration was filed by the end of Seifert's testimony period (with or without an accompanying § 1.635 motion), Dance's motion to strike was due with his opening

⁵ "ADDITION OF SEIFERT CLAIM 1; SCHEDULE FOR § 1.640(b) STATEMENTS, TESTIMONY, RECORDS AND BRIEFS," mailed November 15, 1996.

brief, as specified in § 1.656(h). This is not altered by the fact that Seifert's brief, which was filed after Dance's opening brief, contains the offer to submit a Bookstein declaration.

C. Dance's jurisdictional argument

At pages 33-35 of the Decision, we rejected Dance's alternative argument that his belated motion to strike the initial Seifert, Downey, and Shank reissue declarations should be considered because "it goes fundamentally to the Patent and Trademark Office jurisdiction with respect to this interference. But for the existence of the reissue proceeding which party Dance has now demonstrated was defectively granted, the Patent and Trademark Office had no subject matter jurisdiction to adjudicate this interference." (Motion at 5.)⁶

Dance does not take issue with our holding that we have jurisdiction over the interference if it was "properly declared" under 35 U.S.C. § 135(a), in support of which

⁶ Although not noted in the Decision, we should point out that Dance's reasons for making this jurisdictional argument are unclear; if we lack jurisdiction over this interference, we also lack the authority to enter judgment against Seifert's reissue claims for unpatentability under 35 U.S.C. § 251.

proposition we cited In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000), and Guinn v. Kopf, 96 F.3d 1419, 40 USPQ2d 1157 (Fed. Cir. 1996), cert. denied, 520 U.S. 1210 (1997) (Decision at 33). Gartside held that junior party Forgac's amendment canceling all of his claims involved in the interference styled as "Forgac v. Gartside" did not divest the Board of jurisdiction over that interference and thus over Gartside's involved claims. 203 F.3d at 1316-18, 53 USPQ2d at 1776-78. Likewise, Guinn held that Guinn's statutory disclaimer of his single claim involved in the interference did not divest the Board of jurisdiction over the interference and that claim. 96 F.3d at 1421-22, 40 USPQ2d at 1159-60. Furthermore, as we explained in the Decision at pages 33-35, the interference was "properly declared" under § 135(a) in accordance with Perkins v. Kwon, 886 F.2d 325, 327 & n.2, 12 USPQ2d 1308, 1309-10 & n.2 (Fed. Cir. 1989), because (1) Seifert's reissue application was a "pending application" under 37 CFR § 1.601(i) at the time the declaration notice was mailed and (2) the examiner, prior to declaration of the interference, had determined that Seifert's now involved

reissue application claims 31-35 are allowable. Dance has not explained why the interference was not "properly declared" in accordance with Perkins and why Seifert's alleged failure to comply with 35 U.S.C. § 251, if proved (it has not been), should lead to a different result on the jurisdiction issue than was reached in Gartside and Guinn.⁷

For the foregoing reasons, we remain of the view that Seifert's failure to comply with the requirements of 35 U.S.C. § 251, if proved, would result in the entry of judgment against Seifert's reissue claims for unpatentability on that ground rather than a holding that we lack subject matter jurisdiction over the interference.

D. Dance's "new matter" argument

At pages 40-47 of the Decision, we rejected Dance's argument that the omission from Seifert's reissue claims of the extension wire limitations recited in the original patent claims constitutes "new matter" in contravention of the 35 U.S.C. § 251 (Dance's opening brief at 15). We treated this

⁷ See also Gustavsson v. Valentini, 25 USPQ2d 1401, 1406-07 (Bd. Pat. App. & Int. 1991), wherein the Board rejected Gustavsson's argument that Valentini's admitted failure to comply with 35 U.S.C. § 135(b) rendered the interference void ab initio.

"new matter" argument as based on the requirement of § 251
that the reissue

claims be directed to "the invention disclosed in the original
patent" and, citing Hester Indus. Inc. v. Stein Inc., 142 F.3d
1472, 1484, 46 USPQ2d 1641, 1651 (Fed. Cir.), cert. denied,
525 U.S. 947 (1998), noted that this inquiry is analogous to
the written description requirement of 35 U.S.C. § 112, first
paragraph (Decision at 40). After analyzing the facts in the
present case in accordance with the principles set forth in
Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473,
45 USPQ2d 1498 (Fed. Cir. 1998), which held that the
disclosure of Gentry's patent (i.e., Sproule patent No.
5,062,244) did not provide § 112, first paragraph, written
description support for the broadened amended claim, we
concluded that Seifert's original disclosure provides written
description support for Seifert's broadened reissue claims.
Dance argues that our decision is incorrect because it ignores
U.S. Indus. Chems. Co. v. Carbide & Carbon Chems. Corp., 315
U.S. 668, 678 (1941); Russell v. Dodge, 93 U.S. 460, 463
(1876); Pattee Plow Co. v. Kingman, 129 U.S. 294, 299 (1888);

and Ballew v. Watson, 129 USPQ 48, 49-50 (D.C. Cir 1961), cited in Dance's opening brief at 16, which are characterized in Dance's request for reconsideration (at 5) as "stand[ing] for the principle that removal of language from the specification [sic, claims] introduces 'new matter' and is contrary to the reissue statute." This is not a fair characterization of the holdings in these cases, which we understand to mean that reissue claims may not be broadened to omit features described as essential in the original patent. For example, while Dance's opening brief (at 16) correctly quotes U.S. Indus., the most recent of the cited Supreme Court cases, as stating that

[t]his court has uniformly held that the omission from a reissue patent of one of the steps or elements prescribed in the original, thus broadening the claims to cover a new and different combination, renders the reissue void, even though the result attained is the same as that brought about by following the process claimed in the original patent.

(emphasis added) 315 U.S. at 678, the phrase "prescribed in the original" must be read in conjunction with the Court's holding that "[w]e think it plain that the reissue omitted a

step in the process which was described and claimed as essential in the original patent." 315 U.S. at 677.⁸

Likewise, in Ballew the District of Columbia Court of Appeals held that "we have no basis

for characterizing as clearly erroneous the finding of the District Court that the claims in the reissue application omitted essential elements of the original patent and were drawn to an invention different from that intended to be secured by the original patent." 129 USPQ at 50. For the reasons given in the Decision at pages 40-47, we remain of the view that the artisan would not have understood the extension wire feature to be an essential part of Seifert's invention.

E. Dance's "recapture rule" argument

Dance contends our conclusion (Decision at 49) that Seifert made no argument during prosecution which amounts to a surrender of the invention recited in the reissue claims,

⁸ We should also point out that in contrast to current 35 U.S.C. § 251, which requires that the reissue claims be "for the invention disclosed in the original patent," the reissue statute involved in U.S. Indus., i.e., 35 U.S.C. § 46, required that the reissue claims be for the "same invention." Hester, 142 F.2d at 1485, 46 USPQ2d at 1651; In re Amos, 953 F.2d 613, 619 n.2, 21 USPQ2d 1271, 1275 n.2 (Fed. Cir. 1991).

Interference No. 103,379
Decision on Reconsideration

Hester at 1481, 46 USPQ2d at 1648, is erroneous because "Seifert made three very strident arguments in its Amendment dated February 4, 1991 which distinguish [the claims from] the prior art based upon the required presence of the Extension Wire Structure" (Request at 6). We do not agree that the arguments made in that amendment, which were discussed at pages 49-50 of the Decision (wherein it was identified as the amendment received February 19,

1991), can fairly be characterized as strident arguments based on the extension wire limitations.

For the foregoing reasons, Dance's request for modification of our Decision is **DENIED**.

OF
APPEALS

_____)
WILLIAM F. PATE, III)
Administrative Patent Judge)
)
) BOARD

_____) PATENT

JOHN C. MARTIN) AND
Administrative Patent Judge) INTERFERENCES
)
)
)
_____)
MURRIEL E. CRAWFORD)
Administrative Patent Judge)

Interference No. 103,379
Decision on Reconsideration

For the party Dance:

Grady J. Frenchick, Esq.
Michael, Best & Friedrich, LLP
One South Pinckney Street
Suite 700
P.O. Box 1806
Madison, WI 53701-1806

For the party Seifert et al.:

David K.S. Cornwell, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, NW, Suite 600
Washington, DC 20005-3934