Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

OKADA ET AL., JUNIOR PARTY
v.
HITOTSUMACHI, SENIOR PARTY
Interference No. 102,109
April 5, 1990

Melvin Kraus, Esq.

***1** Antonelli, Terry, Stout & Kraus

Henry M. Zykorie, Esq.

Wenderoth, Lind & Ponack

Harry F. Manbeck, Jr.

Assistant Secretary and Commissioner of Patents and Trademarks

MEMORANDUM OPINION

Background

Junior party Okada et al. (Okada) has filed a PETITION UNDER 37 CFR § 1.644(a)(1) (Paper No. 42) asking the Commissioner to order an Examiner-in- Chief to grant its motion (Paper No. 33) requesting a testimony period. The motion was denied originally by the Examiner-in-Chief (Paper No. 37) and by the Board of Patent Appeals and Interferences (Board) on reconsideration (Paper No. 38), because Okada did not show, during the preliminary motion period, that a testimony period was needed to resolve any motion. Likewise, Okada has not demonstrated that necessary proofswere unavailable at the time of the preliminary motions. The petition has been opposed by senior party Hitotsumachi (Paper No. 39). The petition is before the Commissioner, having been certified by the Examiner-in-Chief. 37 CFR § 1.644(a)(1).

The question is whether the Board properly denied Okada's motion requesting a testimony period (Paper No. 43) to present evidence in connection with (1) a preliminary motion to designate claims of senior party Hitotsumachi as not corresponding to count 1 [FN1] and (2) the senior party's motion to redefine the interference subject matter. [FN2]

During ex parte prosecution prior to the interference, claims of Okada were rejected by a Primary Examiner over Hitotsumachi's published European patent application. Okada alleges that its disclosure is "substantially identical"D' to the Hitotsumachi application involved in this interference. Upon amendment of the claims and traverse of the rejection, the examiner allowed Okada's amended claims, including what is now claim 1 of his patent.

Subsequently, the Primary Examiner determined that an interference existed between claim 1 of Okada's patent and claims of the Hitotsumachi application. As declared, the interference involved count 1. Okada's claim 1 corresponded exactly to count 1. In a decision on preliminary motions (Paper No. 29), and over Okada's opposition, the Examiner-in-Chief redefined the interference by substituting count 2 for count 1. Count 2 is a broader version of count 1 which does not include limitations added to Okada's patent claim 1 during ex parte prosecution to secure allowance over Hitotsumachi's published European patent application. The Examiner-in-Chief decided that some of senior party Hitotsumachi's claims corresponding to count 1 lacked support for the limitations of count 1 (Paper No. 29, paragraph V). However, the Examiner-in- Chief considered those limitations immaterial to patentability (Paper No. 29, paragraph I). In effect, the Examiner-in-Chief determined that the invention of count 1 would have been obvious over the invention of count 2.

***2** Okada urges that the Primary Examiner allowed claim 1 of its patent to issue over Hitotsumachi's European published patent application, because patented claim 1 was drawn to patentably distinct subject matter. He urges that no objective evidence has been presented by Hitotsumachi to rebut the presumption of validity of patented claim 1; an examiner had initiated interference proceedings presuming support for all the limitations of Okada's patented claim 1 in Hitotsumachi's application; Okada never had an opportunity to present objective evidence of patentable distinction between his issued claims and the teaching of Hitotsumachi; and the denial of its motion requesting a testimony period was therefore improper. The Examiner-in-Chief relied on Orikasa v. Oonishi, 10 USPQ2d 1996 (Comm'r Pat. 1989), as precedent for denying Okada's motion. Okada cited and relied on Verbruggen v. Wells, 5 USPQ2d 1983 (Comm'r Pat. 1987) and Nabial v. May, 2 USPQ2d 1452 (Bd. Pat. App. & Int. 1986), in support of his motion. In view of a perceived conflict between Orikasa, on the one hand, and Verbruggen and Nabial, on the other hand, the Examiner-in-Chief certified Okada's petition to the Commissioner.

Discussion

Rule 1.639(a), 37 CFR § 1.639(a), requires evidence to be filed, or to be on file in the Patent and Trademark Office to support a preliminary motion under 37 CFR § 1.633(c) or an opposition to such a motion. 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, supra, at 2000 n.12. Therefore, the denial of Okada's motion requesting a testimony period by the Examiner-in-Chief was improper only if Okada has shown that the evidence it intends to present was unavailable at the time it filed preliminary motions or oppositions under 37 CFR § 1.633(c).

Okada has not suggested that proposed evidence was not available at the preliminary motion stage of this interference. Rather, in support of his position at the preliminary motion stage, Okada relied primarily on findings by the Primary Examiner that its claims were patentably distinct from the disclosure of Hitotsumachi's published European patent application. Okada also relied on the presumption of validity

expressed in 35 U.S.C. § 282. That reliance was manifestly misplaced. The "presumption of validity"D' of § 282 is not applicable in interferences. Lamont v. Berguer, 7 USPQ2d 1580, 1582 (Bd. Pat. App. & Int. 1988). Decisions of a primary examiner during ex parte prosecution are likewise not binding on the Board of Patent Appeals and Interferences in inter partes proceedings. Block v. Sze, 458 F.2d 137, 173 USPQ 498 (CCPA 1972); Heymes v. Takaya, 6 USPQ2d 1448, 1454 (Bd. Pat. App. & Int.), reh'g denied, 6 USPQ2d 2055 (Bd. Pat. App. & Int. 1988). The burden of establishing no interference-in-fact clearly sat with Okada. Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); Case v. CPC International, Inc., 730 F.2d 745, 221 USPQ 196 (Fed. Cir.), cert. denied, 469 U.S. 872 (1984); Takaya, supra at 1451. The Primary Examiner may have been convinced that Okada's claims were patentable over Hitotsumachi's published European patent application, but the Examiner-in-Chief could not find necessary proofs to support Okada's preliminary motions and oppositions. Since there is no issue as to the prior availability of the proposed proofs to be presented in a testimony period, Okada's motion requesting a testimony period to untimely provide evidence in support of patentable distinction between the claims of its patent and broadened count 2 was properly denied.

***3** To the extent that Verbruggen v. Wells, 5 USPQ2d 1983 (Comm'r Pat. 1987) and Nabial v. May, 2 USPQ2d 1452 (Bd. Pat. App. & Int. 1986) are inconsistent with the views expressed herein and in Orikasa v. Oonishi, 10 USPQ2d 1996 (Comm'r Pat. 1989), both Verbruggen and Nabial are overruled.

The Okada petition is denied.

There is a possibility that confusion existed as a result of the existence of Verbruggen, Nabial, and Orikasa. Accordingly, notwithstanding the Board's correct decision, now affirmed on petition, the Examiner-in-Chief or the Board is authorized, upon such showing as they deem sufficient, to set a testimony period in this case to permit Okada to present testimony. Should Okada seek testimony, he should present within ten (10) days a detailed proffer of the expected testimony -- not broad conclusions as to that which the testimony will show. [FN3]

ORDER

Upon consideration of the Okada petition and the Hitotsumachi opposition, it is

ORDERED that Okada's petition under 37 CFR § 1.644(a)(1) is denied, without prejudice to the setting of a testimony period if the Examiner-in-Chief or the Board be so advised.

FN1. See Paper No. 14 and 37 CFR § 1.633(c)(4).

FN2. See Paper No. 10 and 37 CFR § 1.633(c).

FN3. The fee of $120.00 for this petition has been charged to Deposit Account No. 01-2135 as requested in the petition.

16 U.S.P.Q.2d 1789

END OF DOCUMENT