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

HYATT, [FN1] JUNIOR PARTY
v.
BOONE, [FN2] SENIOR PARTY
Interference No. 102,598
December 1, 1992

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Acting Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND ORDER

Two matters are before the Commissioner.

I.

The first matter is a MOTION BY SENIOR PARTY BOONE FOR PUBLIC RELEASE OF DECISION ON PRELIMINARY MOTIONS (Paper No. 122). The motion was forwarded to the Commissioner by the Examiner-in-Chief, where it is being treated as a petition. On October 2, 1992, a decision was entered dismissing the petition because it appeared that the fee required by 37

CFR § 1.17(h) had not been paid. In a RESPONSE BY SENIOR PARTY BOONE (Paper No. 129), Boone correctly points out that on pages 5 to 6 of the motion an authorization was given to charge any necessary fee against Deposit Account No. 20-0668. Hence, as it turns out the fee was paid and it is now appropriate to enter a decision on the merits on the petition seeking public release of the decision on preliminary motions.

A review of the decision on preliminary motions in this particular interference reveals no reason why it should be regarded as a precedential decision. The Examiner-in-Chief assigned to the interference has not suggested that the decision on preliminary motions should be published as a precedential decision. Nor is it apparent how the decision on preliminary motions would add to the body of existing precedent. Accordingly, the request that the decision on preliminary motions be published as PTO precedent is denied.

Denial of the request for publication does not mean that Boone cannot give copies of the decision to members of the public. This decision simply means that PTO will not publish the decision on preliminary motions as a precedential decision of PTO.

II.

The second matter before the Commissioner is a question certified by the Examiner-in-Chief. In effect, the Examiner-in-Chief has asked whether he had authority to set, or abused his discretion in setting, a testimony period after a decision on preliminary motions under the facts of this case "even though it is apparent that Boone had not fully complied with the guidance set forth in Hanagan v. Kimura, 16 USPQ2d 1791, 1974 (Comm'r Pat.1990)."

The short answer is that the Examiner-in-Chief had authority to set the testimony period and did not abuse his discretion in setting a testimony period in this case.

Background

The "guidance" to which the Examiner-in-Chief is referring appears on page 1794 of Hanagan:

> To the extent it may prove useful, the following guidance is provided. When expert testimony is needed in support of, or in opposition to, a preliminary motion, a party should:
>
> ***2** (1) identify the person whom it expects to call as an expert;
>
> (2) state the field in which the person is alleged to be an expert; and
>
> (3) state in a declaration signed by the person
>
> (a) the subject matter on which the person is expected to testify,
>
> (b) the facts and opinions to which the person is expected to testify, and
>
> (c) a summary of the grounds and basis for each opinion.
>
> If a person is to be called as a fact witness, a declaration by that person stating the facts should be filed.

If the other party is to be called, or if evidence in the possession of the other party is necessary, an explanation of the evidence sought, what it will show, and why it is needed must be supplied.

When inter partes tests are to be performed, a description of tests stating what they will show must be presented.

The nature of the showing under § 1.639(c) will vary from case to case.

In this particular interference, Hyatt timely filed a preliminary motion (Paper No. 12) to be accorded the benefit of earlier filing dates of prior applications. 35 U.S.C. § 120; 37 CFR § 1.633(f) (1991). Boone timely opposed (Paper No. 44) Hyatt's preliminary motion, stating, inter alia:

Junior Party Hyatt's motion (1) with attached declarations was not received by counsel for Senior Party Boone until July 1, 1991, just eleven business days before the due date for submission of appropriate opposition papers by the Senior Party Boone opposing proofs. As detailed in the Declaration of Michael J. Cochran, a full analysis of the feasibility studies presented by Junior Party Hyatt and independent preparation of a proper study of the issue would consume considerably more time. As recognized by the comments accompanying the USPTO's adoption of the new interference rules, inability of a party to secure sufficient proofs in the brief time allowed for preliminary motions is an appropriate reason for granting a testimony period. 1050 Off.Gaz.Pat.Off. 385, 411 (Jan. 29, 1985)

* *

Obtaining testimony of independent experts will also require a testimonial period. Accordingly, in the event the Board reaches the enablement issue and determines that evidence of the sort of evidence contained in the declarations submitted by Junior Party Hyatt is appropriate for consideration, Senior Party Boone requests, pursuant to 37 CFR § 1.639(a), that a testimonial period be granted on this issue. (Opposition at 23-24). In an earlier paper, Boone had stated:

Michael J. Cochran is an expert in the field of integrated circuit semiconductor device, microcomputer and microprocessor system design, fabrication, programming and software development. An expert witness would testify as to the state of the art in integrated circuit microcomputer design, fabrication and programming from as early as 1969 to the present in relation to the disclosure of U.S. Patent 4,942,516 Hyatt on the issue of whether the disclosure of U.S. Patent 4,942,516 Hyatt is non-enabling with respect to claims whose main focus is directed to a single chip computer.

***3** Paper No. 24 at page 14.

In due course, the Examiner-in-Chief entered a decision on preliminary motions (Paper No. 105). In Section XIX of an opinion accompanying the decision on preliminary motions (pages 15-20), the Examiner-in-Chief states, inter alia:

The motion of Hyatt filed July 1, 1991 under 37 CFR 1.633(f) (Hyatt Motion 1, Paper No. 12) to be accorded benefit of the December 28, 1970 and October 1, 1973 filing dates of Serial Nos. 101,881 and 05/402,520

is denied.

* *

It is further considered that the prior Hyatt applications are not enabling under 35 USC 112.

* *

To the extent Boone argues the prior Hyatt applications are not enabling based on their actual disclosures, the motion is deferred to final hearing. In his opposition [to Hyatt's motion for benefit] Boone has requested a testimony period on the issue of enablement in Hyatt's prior applications and, based on the amount of Hyatt's evidence, it would be manifestly unfair to require Boone to have prepared a full case in opposition to the motion in the 20 days set forth by the rules for an opposition.

(Decision on preliminary motions, at 15, 19-20).

Section XXII (pages 22-23) of the decision on preliminary motions states that:

On July 1, 1991 Boone filed a motion under 37 CFR 1.633(a) for judgment on the grounds that Hyatt's involved claims are unpatentable to Hyatt under 35 USC 112, first paragraph, for lack of enablement (Paper No. 24). Whereas the motion of Hyatt under 37 CFR 1.633(f) for benefit (Hyatt Motion 1, Paper No. 12) has been deferred in part to final hearing to permit the taking of further evidence on the issue of enablement in two of the junior party's prior applications, it is manifest that since the present motion involves the same issue but with respect to Hyatt's involved patent, the motion should be deferred such that all available evidence can be considered in deciding the matter.

In response to the Examiner-in-Chief's decision on preliminary motions granting a testimony period to Boone, Hyatt argues (Paper No. 111, pages 2 and 5) that:

(1) since Boone did not file "testimony" (i.e., declaration evidence) with its preliminary motion alleging non-enablement, Boone should not now be allowed to take testimony, and

(2) Boone's request for testimony in his opposition to Hyatt's preliminary motion for benefit did not comply with applicable interference rules.

Opinion

Unlike the facts in Hanagan, where Hanagan filed a preliminary motion, in this case Boone was opposing a preliminary motion. A party who files a preliminary motion knows the nature of the motion and can be expected to marshall its case at the time the preliminary motion is filed. A party opposing a preliminary motion is expected to make a

reasonable effort to supply appropriate counter-declarations and other evidence in support of an opposition. However, as the Examiner-in-Chief correctly noted in his decision, in this particular case "it would be manifestly unfair to require Boone to have prepared a full case in opposition to the motion in the 20 days set forth by the rules for an opposition." It is also true that more leeway can properly be granted to a party opposing a preliminary motion than a party filing a preliminary motion. If an Examiner-in-Chief finds in a particular case that a party, during the time allowed for filing an opposition to a preliminary motion, could not reasonably have fully marshalled its evidence for presentation along with the opposition to a preliminary motion, the Examiner- in-Chief may fashion an appropriate remedy. An extension of time to file an opposition could be granted, either upon request of the opponent or sua sponte by the Examiner-in-Chief. Alternatively, the Examiner-in-Chief could set a testimony period. Whether either of these two options, or some other appropriate option, should be exercised is a matter within the discretion of the Examiner-in-Chief.

***4** In this particular case, the Examiner-in-Chief's finding with respect to unfairness to Boone, and his exercise of discretion to set a testimony period, ends the matter. As a recent Federal Circuit decision reveals:

> The question is not whether we, had we been on the Board, would have voted to grant Huston's petition. As the dissent so ably demonstrates, the record before us might well have supported such a decision. Our question is much narrower: can we say that the decision to the contrary was an abuse of the Board's discretion? We conclude that we cannot.

Huston V. Ladner, --- F.2d ----, ----, 23 USPQ2d 1910, 1913 (Fed.Cir.1992). In this particular case, the question is not whether the Commissioner or Hyatt might think a testimony period should not have been granted. The question is much narrower: can it be said the Examiner-in-Chief abused his discretion in setting a testimony period. The answer is "no."

To the extent if may prove useful, the "guidance" appearing on page 1794 of Hanagan is clarified as follows:

> When expert testimony is needed in support of a preliminary motion, the moving party should:
>
> (1) identify the person whom it expects to call as an expert;
>
> (2) state the field in which the person is alleged to be an expert; and
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> (3) state in a declaration signed by the person
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> (a) the subject matter on which the person is expected to testify,
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> (b) the facts and opinions to which the person is expected to testify, and
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> (c) a summary of the grounds and basis for each opinion.
>
> If a person is to be called as a fact witness, a declaration by that person stating the facts should be filed with the preliminary motion.
>
> If the other party is to be called, or if evidence in the possession of the other party is necessary, an explanation of the evidence sought, what it will show, and why it is needed must be supplied with the preliminary motion.
>
> When inter partes tests are to be performed, a description of the

tests stating what they will show must be presented with the preliminary motion.

A party opposing a preliminary motion should make a reasonable effort to present the same kind of evidence by expert and fact witnesses as is required by a party filing a motion.

The nature of the showing under § 1.639(c) will vary from case to case. Moreover, if in the opinion of the Examiner-in-Chief, it would be manifestly unfair to require an opponent to prepare a full case in opposition to a preliminary motion in the 20-day period set forth by the rules for filing an opposition, the Examiner-in-Chief may set a testimony period if the opponent made a reasonable effort to present its case with the opposition.

ORDER

Upon consideration of the record, it is

ORDERED that MOTION BY SENIOR PARTY BOONE FOR PUBLIC RELEASE OF DECISION ON PRELIMINARY MOTIONS (Paper No. 122), treated as a petition, is denied, and it is

***5** FURTHER ORDERED that the Examiner-in-Chief had authority under the rules to set a testimony period in this interference and did not abuse any discretion in setting a testimony period, and it is

FURTHER ORDERED that the $130.00 fee for the petition shall be charged to Deposit Account No. 20-0668, and it is

FURTHER ORDERED that the interference is returned to the Examiner-in-Chief for such further action as he may deem appropriate.

FN1. On November 7, 1991, Gilbert P. Hyatt (Hyatt) submitted a NOTICE REGARDING OWNERSHIP (Paper No. 98) stating that the Hyatt patent involved in this interference has not been assigned. If there has been an assignment subsequent to Paper No. 98, Hyatt shall within twenty (20) days of the date of this order identify in writing the assignee.

FN2. Assignor to Texas Instruments, Inc.

27 U.S.P.Q.2d 1391

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