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

MAIER ET AL., [FN1] JUNIOR PARTY
v.
HANAWA ET AL., [FN2] SENIOR PARTY
Interference No. 101,936
March 21, 1992

Douglas B. Comer

Deputy Commissioner of Patents and Trademarks

On Petition [FN3]

Introduction

***1** On February 7, 1991, the Board of Patent Appeals and Interferences (Board) rendered a final decision (Paper No. 170) in the above-identified interference. On February 22, 1991, Hanawa filed a petition (Paper No. 172) to the Commissioner of Patents and Trademarks under 37 CFR § 1.644(c) to invoke the Commissioner's supervisory authority over the Examiner-in-Chief (EIC) and the Board. It also requested that the Commissioner grant a stay of the date of finality of the Board's decision, pending a decision on this petition.

Background

1. An interference was declared on March 28, 1988, between senior party Hanawa, patentee of U.S. Patent No. 4,675,608, filed on February 14, 1986, and junior party Maier, applicant of Application Serial No. 06/907,519, filed on September 15, 1986.

2. The subject matter of the interference relates to a magnetic resonance imaging apparatus. The Count of the interference recites (Paper No. 1):

Count

A magnetic resonance imaging system comprising:
magnetic field generating means for generating a static magnetic field and a gradient magnetic field which are applied to an object;
means for applying an excitation rotating magnetic field to excite a magnetic resonance in said object to which said static magnetic field and said gradient magnetic field have been applied, said rotating field applying means having power control means for controlling a power of the excitation rotating magnetic field;
means for receiving a magnetic resonance signal due to the magnetic resonance which is caused in the object due to said static magnetic field, said gradient magnetic field, and said excitation rotating magnetic field;
image reconstruction processing means for reconstructing a magnetic

resonance image from the magnetic resonance signal which is received by said receiving means; and

control means for controlling said power control means in response to the magnetic resonance signal which is received by said receiving means.

3. Upon declaration of the interference, Maier's claims 37-47 and Hanawa's claims 1-11 were designated as corresponding to the Count (Paper No. 1). The interference was re-declared on March 22, 1988, by the EIC to add Hanawa's Reissue Patent Application Ser. No. 220,238, of which claims 1-11 and 15-40 were designated as corresponding to the Count (Paper No. 63).

4. On March 28, 1988, the EIC set the time for filing preliminary statements and preliminary motions to expire on June 28, 1988 (Paper No. 2).

5. Hanawa filed a motion (Paper No. 5) on April 11, 1988, to extend his time for filing preliminary statements and motions to July 15, 1988, which motion was approved by the EIC.

6. Maier filed a motion on July 25, 1988, (Paper No. 25) to extend his time for filing preliminary motions and oppositions to Hanawa's preliminary motions to August 30, 1988, which motion was also approved by the EIC.

***2** 7. On July 15, 1988, Hanawa filed a timely motion (Paper No. 16) under 37 CFR § 1.633(c)(3) to additionally designate Maier's claims 1-36 and claims 12-37 of Hanawa's reissue application as corresponding to the Count. In response to Hanawa's motion, Maier filed an opposition (Paper No. 35) on August 25, 1988. On September 9, 1988, Hanawa filed a reply (Paper No. 44) to Maier's opposition.

8. On March 21, 1989, the EIC issued a decision on preliminary motions (Paper No. 62). The EIC denied Hanawa's motion of July 15, 1988, to designate Maier's claims 1-36 as corresponding to the Count.

9. The EIC moved sua sponte under 37 CFR § 1.610(e) and § 633(a) for judgment against both Maier and Hanawa on the ground that the subject matter of the Count and all claims corresponding thereto is unpatentable over an imaging system of Toshiba or a manual of GE (GE manual). The EIC's decision also gave notice that judgment would be entered against both parties unless they show cause why such action should not be taken.

10. Both Hanawa and Maier then requested a final hearing before the Board (Paper Nos. 67, 68), which requests were granted by the EIC (Paper No. 72).

11. On November 17, 1989, Hanawa filed a motion (Paper No. 107) under 37 CFR § 1.635 for leave to file a belated motion under 37 CFR § 1.633(c)(3) to designate Maier's claims 1, 2, 6-11, 15, and 16 as corresponding to the Count. The belated motion under Rule 633(c)(3) (Paper No. 108) was also filed on the same date.

12. The belated Rule 633(c)(3) motion relied on a Diasonics manual and several declarations directed to the content of the manual to show

what was known in the art.

13. The Rule 635 motion referred to the Diasonics manual as newly discovered evidence and explained that prior to July 1989, neither Masatoshi Hanawa, a named inventor of the Hanawa application, nor Toshiba's in-house patent counsel, Katsuhiro Mashimo, knew that the Diasonics manual existed.

14. Declarations of Masatoshi Hanawa and Katsuhiro Mashimo were filed on November 20, 1989 (Paper No. 123). On January 24, 1990, a further declaration of Masatoshi Hanawa and a declaration of Masahiko Hatanaka, a Toshiba employee, were filed (Paper No. 143).

15. On November 17, 1989, Hanawa also moved (Paper No. 111), contingent upon the denial of his motion to file a belated Rule 633(c)(3) motion to designate Maier's claims 1, 2, 6-11, 15, and 16, for a recommendation that those claims be rejected over the Diasonics manual under either 35 U.S.C. § 102(b) or § 103.

16. Hanawa's Rule 635 motion, Rule 633(c)(3) motion, and contingent Rule 659(a) motion were each opposed by Maier (Paper Nos. 130, 126, 128).

17. On January 5, 1990, the EIC denied Hanawa's Rule 635 motion, and dismissed Hanawa's Rule 633(c)(3) motion and Rule 659(a) motions (Paper No. 137).

***3** 18. In pertinent part, the EIC's decision states: Hanawa's motion under 37 CFR 1.635 filed November 17, 1989, for leave to file a belated motion under 37 CFR 1.633(c)(3) (Paper No. 107) is denied. It is clear from other motions of Hanawa filed November 17, 1989, that it does not consider Maier claims 1, 2, 6-11, 15, and 16 allowable. It is long standing practice that a moving party must be of the opinion that proposed claims are patentable. Weinberger v. Boyce v. Russel, 1912 C.D. 374 (Comm'r 1912); Rich v. Porter v. Hamlin, 1913 C.D. [172] (Comm'r 1913).

Although this decision on Paper No. 107 is not based on unexcused belatedness of the motion under 37 CFR 1.633(c)(3) (Paper No. 108, filed November 17, 1989), it appears that Hanawa has not shown sufficient cause why Paper No. 108 was not timely filed. 37 CFR 1.645(b). It would be ludicrous to hold that Hanawa has excused belatedness of his motion because he did not bother to obtain the Diasonics manual until July 1989, when Hanawa was aware of and had the Diasonics machine in 1985. Such is evidence of a lack of careful preparation between Hanawa (Toshiba) and counsel for this proceeding from its declaration in March, 1988.

19. The Board rendered its decision on February 7, 1991 (Paper No. 170). On February 22, 1991, Hanawa filed a request for reconsideration (Paper No. 171) in response to which Maier filed a reply on March 6, 1991 (Paper No. 175). On March 6, 1991, Maier filed a request for reconsideration (Paper No. 176), in response to which Hanawa filed a reply on March 18, 1991 (Paper No. 178).

20. The Board issued a further decision on March 7, 1991 (Paper No. 173), denying Hanawa's request for reconsideration.

21. On February 22, 1991, Hanawa filed a petition to the Commissioner under 37 CFR § 1.644(a)(2) (Paper No. 172) to invoke the Commissioner's supervisory authority concerning the final Board decision.

22. On March 12, 1991, the Acting Assistant Commissioner for Patents issued an order (Paper No. 174) inviting Maier to file a response to Hanawa's petition and extending the time for judicial review of the Board's decision to one month after a decision on Hanawa's petition to the Commissioner.

23. Maier's opposition to Hanawa's petition was filed on March 8, 1991.

Discussion [FN4]

Hanawa's petition to the Commissioner requests:

A. That the finality of the Board decision of February 7, 1991, be stayed, pending a decision on Hanawa's petition under 37 CFR § 1.644(a)(2); [FN5]

B. That Hanawa's Rule 635 motion establishes sufficient cause to excuse the belatedness of Hanawa's Rule 633(c)(3) motion;

C. That Hanawa's Rule 633(c)(3) motion to designate Maier's claims 1, 2, 6- 11, 15, and 16 as corresponding to the Count be addressed on the merits;

***4** D. That a showing of patentable subject matter in Maier's claims 1, 2, 6-11, 15, and 16 is not required in a motion under 37 CFR § 633(c)(3) to designate them as corresponding to the Count; and

E. That portions of the Board's opinion at pages 11 and 12 of its decision of February 7, 1991 (Paper No. 170) be expunged.

A. Hanawa's belated motion under Rule 633(c)(3) and motion under Rule 635 to excuse the belatedness

Hanawa's motion under 37 CFR § 1.635 (Paper No. 107) sought to excuse the belatedness of his motion under 37 CFR § 1.633(c)(3) (Paper No. 108) to designate Maier's claims 1, 2, 6-11, 15, and 16 as corresponding to the Count. The EIC denied Hanawa's Rule 635 motion, but expressly stated that the denial "was not based on unexcused belatedness" (Paper No. 137). Rather, the EIC considered the Rule 633(c)(3) motion as in any event deficient because Hanawa believed Maier's claims sought to be additionally designated to be unpatentable over the Diasonics manual.

The Board agreed with the EIC that Hanawa could not properly move to additionally designate Maier's claims which it did not believe to be patentable, stating (Paper No. 170):

> 37 CFR 1.637(c)(3)(ii) requires that the moving party show the

claims sought to be designated as corresponding to the Count--here, Maier claims 1, 2, 6-11, 15, and 16--define the same patentable invention as the Count. By asserting the position that these claims of Maier are unpatentable, Hanawa has not met his burden under the above rule of establishing patentability. [Emphasis in original]
For the following reasons, the EIC and the Board erred in interpreting a PTO rule.

The "same patentable invention" requirement of 37 CFR § 1.637(c)(3)(ii) concerns only the relationship between the Count and the claims sought to be additionally designated. It does not concern general patentability over the prior art. In that regard, what constitutes "the same patentable invention" in the context of aninterference is defined by 37 CFR § 1.601(n). See Ex parte Standish, 10 U.S.P.Q.2d 1454, 1456 (Bd.Pat.App. & Int.1989).

This definition is provided in 37 CFR § 1.601(n):
(n) Invention "A" is the "same patentable invention" as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a "separate patentable invention" with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

***5** While it is true that an interference should not be declared unless the involved subject matter is believed to be patentable by the examiner, Hanawa's belief that claims 1, 2, 6-11, 15, and 16 of Maier are unpatentable is just Hanawa's belief, not a determination by the EIC or the Board. Once the additional Maier claims are designated to correspond to the count, their patentability over the Diasonics manual may be determined by the EIC or the Board, just as the Board has already ruled that the Count and all claims now corresponding to the Count are unpatentable over the GE manual (Paper No. 170).

In determining whether it is proper to designate a claim as corresponding to the Count, the pertinent inquiry is whether that claim and the Count define the same patentable invention, i.e., whether they are patentably distinct. If they are patentably distinct, then they do not define "the same patentable invention" under 37 CFR § 1.637(c)(3)(ii). If they are not patentably distinct, then they do define "the same patentable invention." Patentability over the prior art in general is not involved.

The EIC stated that it is a long standing practice that a moving party must be of the opinion that proposed claims to be added to an interference must be patentable. While the EIC cited two Commissioner's decisions, one in 1912 and one in 1913, they are not apposite because they:

1. both were rendered when the Board of Interferences could not decided patentability issues;

2. both were rendered prior to the promulgation of 37 CFR § § 1.601(n) and 633(c); and

3. both were applying long superceded interference Rule 109 which pertained to a party's amending his own application to include further claims to be ruled upon in the interference.

There is no known authority subsequent to the creation in 1985 of the Board of Patent Appeals and Interferences and to the promulgation of 37 CFR § § 1.601(n) and 1.633(c) on February 11, 1985, which supports the position of the EIC and the Board.

The error of the EIC and the Board and the EIC's statement that his decision was not based on unexcused belatedness of Hanawa's motion ordinarily would dictate a remand to the Board for a determination whether the Hanawa's belatedness is excusable. If it is not, then the belated motion to designate additional Maier claims need not be considered. If it is, then a determination has to be made on whether Maier's claims 1, 2, 6-11, 15, and 16 are patentably distinct from the Count.

But a remand here for that purpose is unnecessary. The EIC already made a finding that it would be ludicrous to hold that Hanawa has excused belatedness of his motion (Paper No. 137), and the Board has determined that the EIC's determination that Hanawa had not shown sufficient cause for delay has not been shown to be erroneous (Paper No. 170). There is no basis to conclude that the EIC and the Board erred in declining to excuse Hanawa's belatedness.

***6** Because preliminary motions under 37 CFR § 1.633(a) through (h) must be filed within the time period set by an EIC, 37 CFR § 1.636, a party does not have unlimited opportunity to urge the merits of whatever it would seek by way of a preliminary motion under Rules 633(a)-(h). Thus, it is incumbent on a party to make its best reasonable effort within the time period allotted by the EIC to uncover all evidence on which it would rely in making a preliminary motion. If information which could have been discovered with reasonable effort within the period set by the EIC, its later discovery after the expiration of the period would not be sufficient cause for delay in the late filing of any preliminary motion relying on that information. [FN6]

In 1985, Masatoshi Hanawa (a named inventor) and Masahiko Hatanaka together purchased a Diasonics scanner in the United States and took it to Japan to study its hardware and software which controlled image quality (Paper Nos. 123 and 143, Hanawa and Hatanaka declarations). Around July 1989, in a meeting concerning GE's efforts to patent a curve-fitting technique, Masahiko Hatanaka recalled that the Diasonics scanner employed a curve-fitting prescan technique and that the technique would probably be explained in the machine's manual (Paper Nos. 123 and 143, Hanawa and Hatanaka declarations). Masahiko Hatanaka's suggestion led to Hanawa's becoming aware of the contents of a Diasonics manual describing the operations of the Diasonics scanner.

Hanawa's first motion to additionally designate certain uninvolved claims of Maier as corresponding to the Count was filed on July 22, 1988, within the time period for filing such motions (Paper No. 16). It sought to designate Maier claims 1-36 as corresponding to the Count. But neither the Diasonics scanner nor the Diasonics manual was mentioned in that motion and the motion was denied.

On November 17, 1989, after the expiration of Hanawa's time for filing preliminary motions, Hanawa moved (Paper No. 108) to designate Maier's uninvolved claims 1, 2, 6-11, 15, and 16 as corresponding to the Count. The motion represented that the EIC had earlier refused to designate Maier's claims 1, 2, 6-11, 15, and 16 as corresponding to the Count because (1) the Count was directed broadly to a prescan technique, (2) the Maier claims were directed to a specific prescan calculation such as by curve-fitting, and (3) the prior art does not teach curve-fitting prescanning.

Hanawa's belated motion relied on the Diasonics manual to show what was known in the art, for urging that Maier's claims 1, 2, 6-11, 15, and 16 were not patentably distinct from the Count. Hanawa stated (Paper No. 108):

> [The Diasonics manual] teaches that it is old to perform a power or energy calculation and to calculate the value of the transmit power that gives a maximum in the received signal, as, for example, by using curve fitting techniques." [Emphasis added]

***7** That Hanawa had acquired the Diasonics scanner in 1985, and had studied it, places the Diasonics scanner and its manual within the reasonable grasping range of Hanawa in connection with any effort to obtain evidence on what was known in the magnetic resonance imaging art. It is not particularly relevant whether Masatoshi Hanawa had actual knowledge of the Diasonics manual. [FN7] What is important is whether Hanawa should have earlier mentioned the Diasonics scanner or produced the Diasonics manual for showing what was known in the art.

Although Masatoshi Hanawa may not have actually known the existence of the Diasonics manual until 1989, others employed by Toshiba, e.g., Masahiko Hatanaka, may have. In any event, for a showing of what was known in the imaging art regarding curve-fitting techniques, Hanawa should have earlier produced the Diasonics manual and/or identified the Diasonics scanner purchased by Masatoshi Hanawa and Masahiko Hatanaka in 1985. The EIC correctly criticized Hanawa for not obtaining the Diasonics manual until July, 1989. [FN8] The Board correctly concluded that error has not been shown in the EIC's finding that Hanawa's belatedness was inexcusable.

B. The Board's not recommending rejection of Maier's uninvolved claims

Hanawa's contingent motion (Paper No. 11) for a recommendation under 37 CFR § 1.659(a) that Maier's claims 1, 2, 6-11, 15, and 16 are unpatentable over the Diasonics manual, was denied by the Board (Paper No. 170). The Board's reasons for not making the requested recommendation are expressed on pages 11- 12 of its decision.

Hanawa concedes that the Board has discretion on whether to make a recommendation pursuant to 37 CFR § 1.659(a) concerning claims uninvolved in the interference (Paper No. 172, Page 9). But Hanawa contends that when the Board refuses to make the requested recommendation, the inclusion of the Board's reasoning in its decision not to make the recommendation is manifest error and constitutes an abuse of discretion (Paper No. 172, Page 9).

According to Hanawa, "a simple statement by the Board that it chooses not to exercise its discretion to recommend would be sufficient" (Paper No. 172, Page 9). Hanaw is also concerned that the Board's reasoning would bias the primary examiner who will later determine patentability of Maier's uninvolved claims (Paper No. 172, Page 9).

The contentions of Hanawa are without merit. First, Hanawa requested the Board to make a recommendation; he cannot reasonably expect the Board not to make known its reasons for not making the recommendation. Second, Hanawa argues that a simple statement by the Board denying the request would be sufficient. Assuming that it is so, it does not follow that the Board's revelation of its reasons for denying the requested recommendation is inappropriate. Moreover, the Board's merely stating that Hanawa's motion under Rule 659(a) is denied may not provide adequate basis for determining whether the Board indeed exercised its discretion or whether that discretion was abused. [FN9]

***8** Hanawa's contention that the Board's reasoning will have an unwarranted influence over the primary examiner who will later determine the patentability of Maier's uninvolved claims is also without merit. The Board's reasoning is a part of the record and may properly be considered by an examiner in further ex parte proceedings involving Maier's claims.

There is no reason to expunge portions of the Board's opinion which explain the Board's reasons for not making the recommendation requested by Hanawa.

Decision

Hanawa's petition to the Commissioner under 37 CFR § 1.644(a)(2) is denied.

FN1. Maier et al. (Maier) are assignors to the General Electric Company (GE), a corporation of the state of New York (Paper No. 1).

FN2. Hanawa et al. (Hanawa) are assignors to Kabushiki Kaisha Toshiba (Toshiba), a corporation of Japan (Paper No. 1).

FN3. Commissioner Manbeck has recused himself from deciding this petition because he was a former employee of Maier's assignee, the General Electric Company. Authority to decide this petition has been delegated to the Deputy Commissioner.

FN4. Maier's reconsideration request of March 6, 1991, appears not to have been addressed by the Board. The Board is authorized to consider that request upon return of the case files to the Board following this decision. The time for appeal or civil action is reset to that provided under 37 CFR § 1.304.

FN5. This part of Hanawa's petition has already been decided by order of the Assistant Commissioner for Patents dated March 12, 1991 (Paper No. 174).

FN6. 37 CFR § 1.645 permits one to file a motion under Rule 635 for an extension of time except for an extension to file a notice of appeal to the Court of Appeals for the Federal Circuit or for commencing a civil action, but requires a showing of good cause why the motion should be granted.

FN7. The declarations of Masatoshi Hanawa (Paper Nos. 123 and 143) indicate that he did not have actual knowledge of the existence of a Diasonics manual until sometime after around July 27, 1989.

FN8. When Hanawa first moved within the motions period set by the EIC to have additional Maier claims designated as corresponding to the Count, a meeting at that time between Hanawa's attorneys, Masatoshi Hanawa, and Masahiko Hatanaka may well have uncovered the Diasonics manual. The EIC correctly noted that not uncovering the Diasonics manual until July 1989, reflects lack of careful planning (Paper No. 137).

FN9. Hanawa evidently does not assert that the Board abused its discretion in not making the requested recommendation. However, had the Board not explained its reasoning, Hanawa may be without adequate basis to assess whether it should be making that assertion.

26 U.S.P.Q.2d 1606

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