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

IN RE APPLICATION OF OVSHINSKY, ET AL.
Pat. No. 4,703,336
January 29, 1992
***1** Issued: October 27, 1987

For: PHOTODETECTION AND CURRENT CONTROL DEVICE
Reexam. No. 90/001,882

Charles E. Van Horn

Patent Policy & Programs Administrator, Office of the A/C for Patents

DECISION ON PETITION

This is a decision on (1) a petition of Energy Conversion Devices, Inc. (patent owner), entitled PETITIONER'S SECOND REQUEST FOR RECONSIDERATION OF MARCH 8, 1990 PETITION FOR REMOVAL OF EXAMINER, filed October 24, 1990; and (2) a supplement to the petition, filed January 8, 1991. The petition and supplement will be referred to as the second reconsideration petition and the supplement thereto.

For the reasons stated below, the petition is denied.

Background

Patent owner owns U.S. Patent No. 4,703,336, issued on October 27, 1987, which contains claims 1–20 (the patent). The patent names two inventors. The first-named inventor is Stanford R. Ovshinsky. The patent claims an effective filing date at least as early as January 5, 1981. The application which matured into the patent was examined by Examiner Martin H. Edlow.

On August 2, 1988, a first request for reexamination was filed by a third- party (requester), alleging unpatentability over various prior art references not cited during the prosecution of the patent, including a patent to Carlson (Carlson patent) and an article in which Carlson was a co-author (Carlson article). Examiner Edlow determined that the prior art cited raised a substantial new question of patentability and instituted a reexamination proceeding (proceeding No. 90/001,571 or first reexamination).

During prosecution of the first reexamination, in an amendment filed July 20, 1989 (amendment), patent owner amended one of the two independent claims in the patent (claim 1), cancelled the other independent claim (claim 17) and all dependent claims therefrom (claims 18–20), and added new claims 21–52.

The examiner held that claim 1, as amended, dependent claims thereto 2–16, and claims 21–52, were patentable. The examiner, in stating his reasons for allowance, incorporated by reference arguments made by

patent owner on why the claims were patentable over, inter alia, the Carlson patent and the Carlson article. The examiner did not, and could not under Patent and Trademark Office (PTO) rules, have the benefit of the requester's views on patent owner's arguments or the patentability of the claims.

A reexamination certificate issued on January 16, 1990, confirming as patentable the claims as amended and added by the amendment (claims 1-16 and 21-52). None of these claims were the same as any of the claims of the patent.

On November 1, 1989, a second request for reexamination was filed, alleging unpatentability of some or all of claims 37-52 added by amendment during the first reexamination, over, alternatively, the Carlson patent and the Carlson article, as well as a reference to Ozawa. The Ozawa reference has a publication date of 1983, and thus later than the claimed effective date of the patent.

***2** At the time of the second request for reexamination, Examiner Edlow was nearing retirement. Therefore, the second request was assigned to Examiner William D. Larkins.

On January 23, 1990, Examiner Larkins entered an order granting the second request for reexamination (order to reexamine). He determined that the prior art cited raised a substantial new question of patentability and instituted a second reexamination proceeding (the second or this reexamination). The order to reexamine states specifically that a substantial new question of patentability was raised by the Carlson article as to claims 37-52 and by the Ozawa article with respect to claims 48-50. The reason given by Examiner Larkins for relying on Ozawa is that particular features in these claims are not disclosed in any prior application relied on by the patent. Examiner Larkins found that Ozawa did not raise a substantial new question of patentability with regard to other specific claims, relying on an equation or mathematical formula disclosed in the patent to support his interpretation of these claims and dismissing the requester's interpretation of them. The order set a response time of two months from the date thereof for the patent owner to file a statement under 37 CFR § 1.530(b).

Under the statute (35 U.S.C. § 304) and PTO rules (37 CFR § 1.530(b)), the patent owner, within a period not less than two months from the date of the order to reexamine, may file a statement on the new question of patentability, including any amendment to its patent and new claim or claims it may wish to propose for consideration in the reexamination. Patent owner did not file a statement in the second reexamination.

On April 27, 1990, Examiner Larkins entered an Office action. In it, he confirmed the patentability of claims 1-16, 21 and 23. He rejected remaining claims 22 and 24-52 over various prior art references and combinations thereof, including the Carlson patent and the Carlson article. Examiner Larkins did not make a rejection over Ozawa.

On February 20, 1990, patent owner filed a petition under 37 CFR § § 1.181 and 1.183 in connection with the second request for reexamination. Specifically, patent owner asked the Commissioner to

exercise his supervisory authority and, in the interests of justice:

(1) reassign reexamination of the patent to a new examiner due to bias demonstrated by Examiner Larkins against co-inventor Ovshinsky;

(2) prevent Larkins from any further participation in the reexamination;

(3) expunge the January 23, 1990 order granting reexamination, all documents relating thereto, and the petition with accompanying declarations;

(4) stay the currently running two month time period in which to file the Patent Owners Statement; and

***3** (5) find that the petition is not an action on the merits and therefore refuse to entertain a response from the Reexamination Requestor.

In a decision entered March 5, 1990, the petition was returned to patent owner, and a copy of the petition was sent to the requester. The ground for returning the petition was that it was not part of a patent owner's statement under 37 CFR § 1.530(b) and was therefore, in violation of 37 CFR § 1.540, which states, in pertinent part:

No submissions other than the statement pursuant to § 1.530 and the reply by the requester pursuant to § 1.535 will be considered prior to examination.

On March 8, 1990, patent owner filed a petition seeking reconsideration of its petition filed February 20, 1990 (first reconsideration petition). Specifically, patent owner asked the Commissioner to personally review the first reconsideration petition and exercise his supervisory authority and, in the interests of justice:

(1) find that the situation set forth in the first reconsideration petition is an extraordinary one justifying consideration outside of the Reexamination framework;

(2) reassign the second reexamination to an unbiased examiner;

(3) prevent the biased examiner from any further participation in the second reexamination;

(4) expunge or otherwise prevent the unbiased examiner from having access to the January 23, 1990 order to reexamine as well as all other documents relating thereto, the decision returning the first petition, the first reconsideration petition and accompanying declarations, and any papers filed by the requester in connection therewith;

(5) stay the two-month period in which to file the patent owner's statement;

(6) certify that the decision of PTO with respect to the first reconsideration petition constitutes a final administrative determination of the issues; and

(7) render a decision on the first reconsideration petition on an accelerated basis.

Accompanying the first reconsideration petition were declarations of Marvin S. Siskind, Subhendu Guha and Ronald W. Citkowski concerning an interview pursuant to 37 CFR § 1.133 they had with Examiner Larkins in November 1985 in connection with a different patent application, patent application serial no. 610,226 (the '226 application) in which Stanford R. Ovshinsky was a named co- inventor.

According to Siskind's declaration, while Siskind, who was the patent attorney primarily responsible for prosecution of the '226 application, and Guha, the other named co-inventor on the '226 application,

attempted to discuss the merits of the application, Mr. Larkins was more concerned with belittling the scientific credibility of Mr. Ovshinsky. We were constantly interrupted by derisive laughter from Mr. Larkins at any mention of either the merits of the subject matter being claimed or Mr. Ovshinsky's name. Further, Mr. Larkins left no doubt as to his feelings toward Mr. Ovshinsky, when he characterized the [patent] application as "... another crazy Ovshinsky patent ..." and referred to the lack of credibility which Mr. Ovshinsky enjoyed in the scientific community. He specifically referred to Mr. Ovshinsky as a "charlatan."

***4** Guha's declaration is similar although it makes no mention of derisive laughter or the reference to Mr. Ovshinsky as a charlatan. Citkowski, a patent attorney who had associate responsibility for prosecution of the patent application, states in his declaration allegations similar to Siskind's, although there is no reference to Mr. Ovshinsky as a charlatan.

On April 24, 1990, the undersigned entered a decision on the first reconsideration petition. The decision:

(1) denied the request for personal handling by the Commissioner on the ground that the undersigned had been delegated responsibility for deciding petitions in reexamination proceedings;

(2) granted the request that the first reconsideration petition be found to present an extraordinary situation, i.e., an "examiner bias" issue, justifying a waiver of the rules and entry and consideration thereof;

(3) denied the request for removal of the examiner on the ground that while the alleged remarks of Examiner Larkins "do not meet the high standard of professional conduct that an examiner should maintain," on the record as a whole, patent owner failed to show that Examiner Larkins was now personally biased against Mr. Ovshinsky and unable to impartially and objectively conduct reexamination of the patent;

(4) denied the request that the order granting reexamination and all papers relating to the first reconsideration petition be expunged or otherwise removed from the file, rejecting patent owner's argument that the presence of these documents would taint the future actions of the examiner on the merits of the reexamination proceeding. However, in order to preclude the possibility of any document which relates to the allegation of "examiner bias" from tainting the future actions of the examiner, the decision states that all documents relating to this issue will be removed from the reexamination file and stored in the Office of the Assistant Commissioner for Patents until the termination of the examination by the examiner. At that time, the documents would be returned to the file;

(5) denied the request for an order staying the period in which the patent owner may file a statement under 37 CFR § 1.530(b). The decision noted that the period had already expired and that patent owner could have addressed the substantive issues raised in the order to reexamine during the period but expressly chose not to; and

(6) denied the request that the decision be certified as a final administrative determination of the issue raised, finding that the

issue (of bias) can be reviewed on its merits at the conclusion of the reexamination proceeding.

On May 4, 1990, patent owner filed a civil action against the Commissioner, seeking a writ of mandamus directing the Commissioner to remove the examiner from the reexamination or, alternatively, review of the denial of the petition (the civil action).

To support its claim, patent owner relied on the statements said to have been made by Examiner Larkins at the November 1985 interview. In addition, patent owner relied on actions taken by Examiner Larkins in the second reexamination which it alleged demonstrated bias. It alleged that the order to reexamine entered by Examiner Larkins states at least two improper grounds for ordering the second reexamination--(1) it relies on the reference to Ozawa, which patent owner claims is not prior art, and (2) it misapplies the mathematical formula. Patent owner alleged further that the order to reexamine relies on prior art references already twice considered and that this was also improper. According to patent owner, the order to reexamine is reflective of bias. In addition, the first Office action, entered by Examiner Larkins on April 27, 1990, is also reflective of bias, according to patent owner. It was entered only three days after entry of the decision denying patent owner's first reconsideration petition. That decision was to have removed all papers on the bias issue from this reexamination file. In those papers were assertions regarding the improper grounds for ordering the second reexamination. Yet those grounds are no longer relied on in the Office action. Patent owner asserts that the Office action is based on a rationale different from that of the order to reexamine; Ozawa and the mathematical formula are absent therefrom. The Office action is based on the same prior art already considered in the examination of the patent and in the first reexamination which, according to patent owner, violates PTO practice which requires that full faith and credit be given to the action of a prior examiner.

***5** In the civil action, the Commissioner argued that the bias issue was not yet ripe for review. In a decision entered June 8, 1990, the U.S. District Court for the District of Columbia denied relief to the patent owner. Energy Conversion Devices Inc. v. Manbeck, 16 U.S.P.Q.2d 1574 (D.D.C.1990), appeal dismissed, No. 91-1217 (Fed.Cir. June 6, 1991). The decision did not go to the merits of the bias issue.

In an Order of the undersigned entered March 26, 1991, it was noted that the bias issue was by then a matter of public record and that therefore, there was no longer any need to maintain documents relating to the bias issue separate from the other documents in this reexamination file. It was further indicated that all documents in this reexamination had been associated with the file.

Attached to the Order was an affidavit of Examiner Larkins and an affidavit of Eric Fallick, the junior examiner assigned to the '226 application. Each of the affidavits was directed to the interview which transpired in the '226 application.

In his affidavit, Examiner Larkins, who claims to have some independent recollection of the interview, denies making any of the derogatory remarks attributed to him or any other derogatory remarks

about Mr. Ovshinsky. Examiner Larkins claims to have the highest regard for Mr. Ovshinsky. Examiner Larkins claims further that he is not biased or prejudiced against Mr. Ovshinsky nor has he ever been.

Former Examiner Fallick, in his affidavit, claims to also have some independent recollection of the interview. He remembers the interview as cordial. He does not believe he heard any of the derogatory remarks attributed to Examiner Larkins, nor does he believe Examiner Larkins made them. He states that the interview occurred in a room approximately 150 square feet in area and that in a room that small, he believes he would have heard the remarks which Examiner Larkins has been accused of making if he indeed made them. Mr. Fallick does not believe he left the room at any time during the interview. Mr. Fallick left the employ of PTO in 1986.

The Order found that the version of events as related in the affidavits contradict, and are apparently irreconcilable with, the versions as related in the declarations of Siskind, Citkowski and Guha discussed above. In order to reconcile these versions of events, if possible, and in order to make a complete record on the issue of bias, a hearing was set, to be conducted by the undersigned.

Subsequent to the date of the Order, on April 16, 1991, patent owner filed a petition pursuant to 37 CFR § § 1.182 and 1.183 requesting access to certain documents and witnesses. With the petition were the declarations of Siskind (April 1991 Siskind declaration) and Kenneth Massaroni, counsel for patent owner in this reexamination.

These declarations describe a meeting which was held in late 1989 in Mr. Edlow's office shortly before Mr. Edlow retired and at a time after the second reexamination request was filed but before the first reexamination certificate issued. Also present at this meeting was Mr. Andrew James, Supervisory Primary Examiner of Art Unit 253. Massaroni and Siskind both claim that when they were told at the meeting that Examiner Larkins would probably be assigned to the second reexamination request, Mr. Siskind described the November 1985 interview in the '226 application to Mr. James and Mr. Edlow. According to both declarants, Mr. James stated that this was not the first instance that Examiner Larkins' lack of professional conduct was questioned; Mr. James recalled another instance in which Examiner Larkins had placed derogatory comments about an invention and the inventor in the margins of a file wrapper. The declarants state further that Mr. James assured them that Examiner Larkins would not be assigned the second reexamination request.

***6** In view of these declarations, provision was made for an additional hearing day so that Mr. James' and Mr. Edlow's version of the events of the late 1989 meeting could be ascertained.

Before the hearing, counsel for patent owner was required to state for the record whether counsel brought the remarks which Mr. James is said to have made in the late 1989 meeting to the attention of any PTO employee present at a meeting held in PTO on February 12, 1990 in which counsel for patent owner raised the issue of Examiner Larkins' alleged bias. Counsel represents that counsel did not. The record does not contain any reference to the late 1989 meeting prior to the filing of the above-discussed Massaroni and Siskind declarations on April 16,

1991.

Counsel for patent owner was also required to produce before the hearing all notes, transcriptions and statements made by any of its witnesses about the November 1985 interview and all notes and transcriptions taken by any of its witnesses at the late 1989 meeting. Counsel represents that there are no such documents. It has been represented to patent owner that neither Former Examiner Fallick nor Examiner Larkins has any documents of the type which patent owner was directed to produce about the November 1985 interview, and that Mr. James has no such documents about the late 1989 meeting.

The Hearing

The hearing was held on May 13, 1991, and reconvened on May 16, 1991.

Sworn testimony was elicited from Messrs. Siskind, Citkowski, Guha, Fallick and Larkins about the November 1985 interview in the '226 application. Further sworn testimony was elicited from Examiner Larkins on the issue of bias in his conduct of this reexamination and on when he first learned about the issue. Sworn testimony was elicited also from Messrs. Siskind, Massaroni, James and Edlow about the late 1989 meeting held in Mr. Edlow's office. Witnesses were instructed not to discuss their testimony with witnesses remaining to testify. No other witness who was present at the November 1985 interview was present in the hearing room while a witness to the interview testified, except that Mr. Siskind was allowed to, and did, remain in the hearing room during Examiner Larkins' testimony. Similarly, no other witness who was present at the late 1989 meeting was present in the hearing room while a witness to the meeting testified. I observed the demeanor of all the witnesses.

The hearing was recorded. A written transcript thereof has been made part of the record, and reference is made thereto with the prefix "Tr." Counsel for patent owner was permitted to file, and has filed, on June 27, 1991, a post- hearing memorandum in support of the second reconsideration petition.

Counsel for patent owner was permitted to, and did, question all the witnesses. Counsel was instructed that with one exception, questions of Examiner Larkins framed to elicit an explanation of why he took certain actions would not be permitted since they go to his bases, reasons, mental processes, analyses, or conclusions (Tr. 7-8). Counsel was told, however, that he would be permitted some leeway on such questions (Tr. 9-10).

***7** Each witness reaffirmed the statements he made in his respective declaration or affidavit, described above. Additional testimony, to the extent relevant, is summarized below.

The Bias Issue

Fallick

Former Examiner Fallick testified that he had some independent recollection of the November 1985 interview (Tr. 15) adding, with respect to ¶ 6 of his affidavit, more detail of the discussion between Examiner Larkins and Dr. Guha (Tr. 32-33). Specifically, Dr. Guha, after stating that he thought Examiner Larkins was very knowledgable, asked him where he had worked before coming to PTO. He further testified that he had to get chairs from other people's offices and, using a drawing he drafted during his testimony (Hearing Exhibit 1), how the furniture was arranged during the interview and where the attendees sat. All the attendees were seated around a desk facing a wall, with himself at one end closest to a window, Examiner Larkins at the other end, closest to the door, Dr. Guha next to Examiner Larkins and Messrs. Siskind and Citkowski between Dr. Guha and himself (Tr. 16-17, 35-37). He testified that he believes he would have recalled anything said by anybody that was insulting or inappropriate (Tr. 23) and that Examiner Larkins was extremely fastidious about regulations and technical detail, and that he doesn't think Examiner Larkins would ever refer to an application as a patent (Tr. 24). He testified that he was shocked at the Guha declaration because it was so contrary to the recollection that he had (Tr. 34). When asked by counsel for patent owner what specific information he had to support his various contentions that he believed he would have remembered certain derogatory comments by Examiner Larkins if they had been said (Tr. 42), he testified (Tr. 42-43):

Well, it's like if, you know, if you went to a restaurant for lunch last Tuesday and I said, "Could you recall every word that was uttered during that lunch?" You would say, "No." I say, "Do you recall that the waiter was abusive to you?" You would say, "No, I certainly remember if a waiter was abusive to me" because that would stand out in your mind.

Likewise, the comments that Mr. Larkins is alleged to have made are horrendous things for an examiner to say, in my opinion, and being, as I think I am, also very sensitive to people's feelings and to things like that, that I would remember, you know, if he had said such bad things.

Also, when I was first shown the declarations, my immediate reaction was one of being horrified and I don't think I would have, you know, if I had remembered him--if he had said such things, you know, it wouldn't have been such a great shock to me. I mean this whole episode is a great surprise to me and I had no idea that, you know, I never would have imagined that such a thing would have come out of it.

Guha

Dr. Guha testified that he was employed by patent owner on March 7, 1990, the date of execution of his declaration, and is presently employed by a joint venture including patent owner (Tr. 46). He testified that the thing that struck him the most about the November 1985 interview is Examiner Larkins' comment about "another crazy Ovshinsky patent" (Tr. 50), which was totally unexpected (Tr. 50), which he remembers very distinctly and clearly (Tr. 53, 68), which took place within the first few or five minutes of the interview (Tr. 53, 55-56), before discussion of the physics or technical merits of the invention (Tr. 55), which comment he surmised at the time was definitely in reference to the '226 application (Tr. 54-55), and which

was not made in response to a question (Tr. 55). He testified that his basis for the statement in his declaration that Examiner Larkins was more concerned with belittling the scientific credibility of Mr. Ovshinsky was the "another crazy Ovshinsky patent" comment and the general tone of the discussion thereafter, although he doesn't remember particular words (Tr. 56-57, 58). He testified that his basis for the statement in his declaration that Examiner Larkins referred to the lack of credibility which Mr. Ovshinsky enjoyed in the scientific community is the impression he got from the discussion but he doesn't recall any specific statement (Tr. 57-58). He testified that he recalled there was a lot of discussion between himself and Examiner Larkins (Tr. 52), that he doesn't recall being complimentary to Examiner Larkins concerning his knowledge of physics or understanding of the invention (Tr. 62) but that he had a favorable impression of Examiner Larkins' knowledge (Tr. 62-63). He testified that during the technical discussion, the smile on Examiner Larkins' face and Examiner Larkins particular laughter, occurring several times, coupled with Examiner Larkins' initial "crazy Ovshinsky patent" comment, made him uncomfortable (Tr. 59, 66). This initial comment made him uncomfortable and annoyed during the technical discussion (Tr. 63). He testified that the initial comment was sufficient, in essence, for him to believe that he would not get a fair hearing from Examiner Larkins (Tr. 63-64). When asked whether Examiner Larkins' initial comment could have been made in jest, he responded by saying that he did not know what was on Examiner Larkins' mind but that it was his impression that Examiner Larkins did not rate Mr. Ovshinsky's credibility very high (Tr. 64- 65). He testified that he did not get an impression that Examiner Larkins was personally biased against Mr. Ovshinsky (Tr. 67) nor does he recall Examiner Larkins referring to Mr. Ovshinsky as a charlatan, although he thinks he would remember it if he heard it (Tr. 70). Before the technical discussion, there were other discussions going on where he may not have heard everything that was said (Tr. 70). He testified that he believes that if Examiner Larkins' "another crazy Ovshinsky patent" comment had been about a prior art reference to Ovshinsky rather than to the '226 application, Examiner Larkins is still biased against Mr. Ovshinsky (Tr. 75-76). [The record shows that two patents in which Ovshinsky was a named coinventor were cited by the examiner in the first Office action of the '226 application.] He testified that the invention disclosed in the '226 application had not been reduced to practice at the time that application was filed, nor were experimental details provided; that it was a concept not demonstrated by a specific device (Tr. 65-66). He testified that he couldn't recall specifically all who attended the November 1985 interview, nor could he recall how people were seated or who he sat next to, or who initiated the discussion of the '226 application (Tr. 51-52). He testified that Mr. Siskind drafted his, Guha's, declaration and he, Guha, edited it, prior to signing it (Tr. 69).

Citkowski

***8** Mr. Citkowski testified that Mr. Siskind notified him about the second reexamination and that Examiner Larkins was assigned to handle it, and that he remembered the November 1985 interview (Tr. 78-79). He testified that he did not recall anyone else being present at the interview besides himself, Mr. Siskind, Dr. Guha and Examiner Larkins

(Tr. 80). His recollection of the interview is that Examiner Larkins' demeanor toward Mr. Ovshinsky and the invention was very derogatory--this stands out in his mind, and that the interview did not last long (Tr. 81). He testified that Examiner Larkins ridiculed the invention, saying it would not work for this or that reason (Tr. 82), that Examiner Larkins' mind appeared to be made up (Tr. 90), that Examiner Larkins interrupted them numerous times, more than twice (Tr. 85-86), with laughter which he characterizes as derisive, admittedly a subjective characterization (Tr. 88-89). He admitted that Examiner Larkins made technical remarks about the invention but could not comment on the soundness of Examiner Larkins' theory or arguments (Tr. 91). He testified that he believes the "another crazy Ovshinsky patent" remark was made very close to the beginning of the interview (Tr. 86) and that he did not think it was in response to a question (Tr. 87). With regard to the statement in his declaration that Examiner Larkins referred to the lack of credibility which Mr. Ovshinsky enjoyed in the scientific community, he testified that the statement is not a verbatim quote of Examiner Larkins but that Examiner Larkins made remarks to that effect, although he does not recall any specific remarks (Tr. 87-88). He testified that he doesn't recall Examiner Larkins using the word "charlatan" in reference to Mr. Ovshinsky but he recalls remarks to that effect (Tr. 89). As to the logistics of the interview, he testified that he didn't recall very clearly how the people were seated but he did recall that the office was cramped, that Examiner Larkins was on one side of a desk and everyone else was on the other side, across it or perhaps one person was to the side, and that Examiner Larkins was across from him (Tr. 84-85). He testified that Mr. Siskind drafted his, Citkowski's, declaration, which he, Citkowski, reviewed and perhaps made changes to, prior to signing (Tr. 93-94).

Siskind

Mr. Siskind testified that the interview began with the visitors being greeted by Mr. Fallick, who then went to get Examiner Larkins and then additional chairs, at which time they all sat down and the interview began (Tr. 99). He testified that Mr. Fallick was not gone long in getting the chairs and that he has no specific recollection of the alleged remarks about Mr. Ovshinsky being made in Mr. Fallick's absence (Tr. 113). He testified that he had a somewhat fuzzy recollection of how the people were seated at the interview, and that seated closest to Examiner Larkins was Dr. Guha, who was seated next to him, who was seated next to Mr. Citkowski, and that Mr. Fallick was on Examiner Larkins' side of the desk or adjacent Examiner Larkins (Tr. 101). He testified that he had never spoken to Examiner Larkins himself until the interview and that his recollection is that he set up the interview with Examiner Larkins by contacting Mr. Fallick (Tr. 101-02). He testified that he, Mr. Citkowski and Dr. Guha wanted to change the general tenor of the interview away from indefiniteness or lack of enablement to advantages of the invention over the state of the art, and that Dr. Guha discussed certain technical details (Tr. 104-05). He testified that Examiner Larkins belittled the scientific credibility of Mr. Ovshinsky by derisively laughing at his name, calling the invention "another crazy Ovshinsky patent" and calling Mr. Ovshinsky a charlatan (Tr. 105-06), that the laughter repeatedly occurred throughout the technical discussion, more than once and less than five times, and was

directed against both Mr. Ovshinsky and the invention, and that the laughter could not have been good-natured (Tr. 106-08). He testified about one instance where Examiner Larkins laughed during the technical discussion and Dr. Guha looked at Siskind with a quizzical expression, which Siskind interpreted as "do I have to sit here and be exposed to this?" (Tr. 109). He testified that he remembered the "another crazy Ovshinsky patent" comment very well, although he doesn't recall whether it was made early or late in the interview or what its genesis was, and that he had no doubt that it was in reference to the '226 application and not to prior art (Tr. 111). He testified that he did not recall when and under what circumstances Examiner Larkins referred to a lack of credibility which Mr. Ovshinsky enjoyed in the scientific community (Tr. 112). He testified that he prepared his own declaration (Tr. 113-14). He testified that if Examiner Larkins' "another crazy Ovshinsky patent" comment had been about a prior art reference to Ovshinsky rather than to the '226 application, it would have made no difference to his statement in ¶ 4 of his declaration that Mr. Ovshinsky cannot receive a fair and impartial reexamination from Examiner Larkins (Tr. 115-16).

Larkins

A. Knowledge about the bias issue

***9** Examiner Larkins testified that he became aware of papers filed by patent owner to remove him from this reexamination on grounds of bias soon after they were filed in March 1990. He testified that he was keeping track of the time in the reexamination because of the expedited prosecution of reexaminations and was expecting the patent owner's statement [as provided by 37 CFR § 1.530(b)], which was due around this time, and happened to see the reexamination file on a clerk's desk with papers physically in the file wrapper although not yet entered therein. Thinking the papers were the patent owner's statement, he began to read them, briefly reading the Siskind, Citkowski and Guha declarations (Tr. 118-20, 131-32). He testified that he was amused by the allegations, finding them outrageous and a desperation attempt; a delaying or stalling tactic rather than an attack on his professionalism (Tr. 132-34). He testified that he did not see these declarations again until Mr. Rolla, Group Director, Group 250, brought them to his attention after patent owner's appeal brief before the Board of Patent Appeals and Interferences, which contained copies of the declarations attached thereto, was filed [on January 17, 1991] (Tr. 133, 135, 137). He testified that he became aware of the decision--Energy Conversion Devices Inc. v. Manbeck, 16 U.S.P.Q.2d 1574 (D.D.C.1990)--about a week or so after it was published in the USPQ advance sheet [dated November 12, 1990] and that various persons commented to him about the case, and that this was the first time he could recall discussing the issue of bias with anyone, although there were no extensive discussions (Tr. 135-37). He testified that he discussed procedural aspects of handling the bias issue, but not its merits, with various PTO officials, including the undersigned, prior to the publication of the above-mentioned advanced sheet, after the issue was raised in an amendment after final rejection filed by patent owner [on September 12, 1990] and in a subsequent paper filed by patent owner

[on October 1, 1990] asking him to comment on the bias allegation raised in the amendment (Tr. 141-48). Between the filing of papers raising the bias issue in March 1990 and the amendment after final filed in September 1990, he testified that he did not discuss the bias issue with anyone, although he did recall a remark by a supervisor in Art Unit 117 saying he, the supervisor, saw some decision or something involving Larkins and he, Larkins, cut the supervisor off (Tr. 148-50).

Examiner Larkins testified that he had no discussion with Mr. James about the late 1989 meeting nor did he ever have a discussion with Mr. Kubasiewicz, who was the Group Director of Group 250 at the time, about the February 1990 meeting (Tr. 152-53).

Examiner Larkins testified that it would not be reasonable for patent owner to conclude that his reexamination was not completely impartial based on his testimony that he saw papers raising the bias issue as early as March 1990 (Tr. 188).

B. The November 1985 Interview

***10** Examiner Larkins testified that he recalled the November 1985 interview (Tr. 121). He recalled being contacted by Eric Fallick for the interview and that in attendance at the interview other than himself were Mr. Fallick, Dr. Guha and two attorneys whose identities he could not recall (Tr. 121-22). He remembered that while the attendees were introducing themselves, he commented that 10-15 years ago he had examined on a regular basis applications dealing with amorphous semiconductor switches, most of which were from patent owner, and that one of the attorneys commented that the field of amorphous semiconductors in general was considered much more respectable in the scientific community these days (Tr. 122-23, 157-58). In answer to a question asking for more information about the beginnings of the art, he discussed the art of amorphous semiconductor switches in general, that such switches were pioneered by Mr. Ovshinsky and patent owner in the 1960's and how at first there was skepticism about their reproducibility but that by the time he came to the Patent Office in 1970, that skepticism had been laid to rest (Tr. 158- 62). He testified that following the introductory remarks, the discussion turned to technical issues, primarily with Dr. Guha, although he didn't remember the details (Tr. 124, 126, 162). He did recall that the invention was totally unlike anything that existed and that the specification had neither experimental verification that a certain effect would occur nor a theoretical analysis sufficient to give a reasonable likelihood that it would; that the case would not be allowed without convincing experimental or theoretical support; and that Dr. Guha did not have support with him at the interview (Tr. 127-28, 166-68). He testified that no derogatory remarks about anyone were made at the interview, and he speculated that his introductory remarks are the only thing which could have formed any basis, however inaccurate, for the declarants' belief that he made derogatory remarks (Tr. 156). He denied calling Mr. Ovshinsky a charlatan (Tr. 126-27). He denied raising a question or making comments about the scientific credibility of Mr. Ovshinsky (Tr. 127). He didn't deny interrupting, as one might do when having a discussion, but he did not recall laughing and didn't think he would have laughed (Tr. 128-29). He testified that he had no reason to

question the scientific accomplishments of Mr. Ovshinsky at the time of the interview nor did he do so (Tr. 130). He testified that he had no personal bias against Mr. Ovshinsky, that he's always admired and respected him and he perhaps had a bias toward him, not against him (Tr. 130). When asked the basis for his categorical denial in ¶ 5 of his affidavit of the derogatory statements he is said to have made, he testified (Tr. 163):

Well, first, because it is absolutely impossible that I would ever have said such a thing since I did not then and do not now hold any such opinion. That's absurd. Ovshinsky is, as I said, well-respected, certainly by me. I've met Mr. Ovshinsky. He's a nice guy. I like him. I respect him. I admire him. It's inconceivable that I would say such a thing for the simple reason that I know quite well that it's ridiculous.

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***11** Why would I say such a thing? Why would I say something that I do not and never have even remotely believed?

He testified that Mr. Fallick was present at all times that he was present at the interview (Tr. 123), that he did not believe that Mr. Fallick left at any time to get chairs and that he was fairly sure that Mr. Fallick did not leave (Tr. 156-57). He testified about the seating during the interview, that he believed he was seated next to Dr. Guha, the attorneys were off to one side, and Mr. Fallick was sort of slightly behind him; he then proceeded to describe the arrangement of the seats and two desks (Tr. 124-25). He testified that even if the Siskind, Citkowski and Guha declarations were submitted in good faith, it would not be reasonable to conclude that he or Mr. Fallick was not handling the '226 application with complete impartiality, because the improper conduct described in the declarations did not happen (Tr. 187).

C. This reexamination

Examiner Larkins testified about notes which he drafted on January 9, 1990 (Hearing Exhibit 2) concerning timing--he was advised by Mr. Gerald Dost [of the Office of the Assistant Commissioner for Patents] to wait until the certificate in the first reexamination issued before acting on the second request for reexamination--and his preliminary evaluation of that second request (Tr. 171-73). He then testified about the meaning of the sentence in his notes "Claims 47-50 introduced in the first reexamination are clearly new matter." Specifically, he believed that the claims were invalid on that ground but did not know how to treat claims added in a first reexamination, as these claims were, in considering a second request for reexamination; believing it to be a matter of policy, he sought the guidance of Mr. Dost and ultimately the undersigned (Tr. 174-77). He had discussions with Mr. Dost about the issue of new matter between January 9, 1990, the date of the notes, and January 23, 1990, the date of the order to reexamine (Tr. 181-82). He added that the new matter issue was raised indirectly in the order to reexamine, in stating that the Ozawa article raises a substantial new question of patentability in claims 48 to 50 (Tr. 182-83). He testified about the statement on page 11 of the first Office

action which raised an issue concerning whether claims 48 to 50 are, in essence, new matter, but then in the statement indicated that the issue would not be considered in a reexamination proceeding (Tr. 177). When asked by counsel for patent owner what the basis was for his change of views on the new matter issue between the time of the order to reexamine and the first Office action, he answered that his view hadn't changed, he had no view, and he did what he was told (Tr. 178). He testified that it was the decision of the undersigned that the new matter issue not be considered in a reexamination proceeding (Tr. 178, 183). When asked by counsel for patent owner whether the mathematical formula appearing at page 3 of the order to reexamine was the basis for one of the new questions of patentability which he found, he explained that he cited the formula as a basis for showing that the requester's assertion that a new question of patentability was raised was in error, i.e., that a new question of patentability was not raised by Ozawa as to certain claims (Tr. 183-84).

The Late 1989 Meeting

Massaroni

***12** Mr. Massaroni testified about the late 1989 meeting in Mr. Edlow's office, adding that he didn't have a clear recollection of whether Mr. Edlow summoned Mr. James to listen to Siskind's recounting of the November 1985 interview with Examiner Larkins or whether Mr. James showed up on his own volition (Tr. 197). He testified that Mr. James voluntarily proffered his assurance not to assign Examiner Larkins to the second reexamination (Tr. 201- 02). After admitting that the substance of the late 1989 meeting was not brought to the attention of any PTO employee at the February 12, 1990 meeting or in any subsequent written request (Tr. 202-04), he explained that the discussion with Mr. James was collateral and not directly relevant (Tr. 203), or wasn't as relevant as the three Siskind, Citkowski and Guha declarations, respectively (Tr. 204, 205-07).

Siskind

Mr. Siskind testified about the late 1989 meeting in Mr. Edlow's office, adding that Mr. Edlow summoned Mr. James to listen to Mr. Siskind's recounting of the November 1985 interview with Examiner Larkins (Tr. 214) and that he specifically asked Mr. James not to assign the second reexamination to Examiner Larkins (Tr. 216). After admitting that the substance of the late 1989 meeting was not brought to the attention of any PTO employee at the February 12, 1990 meeting or in any subsequent written request (Tr. 218-19), he explained that he and Mr. Massaroni saw no purpose whatsoever in it; they felt they had a very strong case and that they would obtain the relief sought (Tr. 219); that it was collateral to the question and not decisive (Tr. 220). He testified that he did not prepare the April 1991 Siskind declaration, that the first draft was prepared after discussions with him, that he made changes to the draft but could not remember them, and that the changes were suggested by himself and Mr. Massaroni (Tr. 220-

23).

Edlow

Mr. Edlow testified that he recalled the late 1989 meeting held in his office (Tr. 236-40). He confirmed most of the statements made in the Siskind and Massaroni declarations, including all of ¶ ¶ 2 through 7 and the first sentence of ¶ 9, adding to ¶ 4 that he called Mr. James into his office (Tr. 241-43). He did not recall the substance of ¶ 8, i.e., he did not recall whether or not Mr. James made reference to another instance in which Examiner Larkins' lack of professional conduct was questioned (Tr. 241, 245, 246). Nor did he recall the substance of the second paragraph of ¶ 9, i.e., he did not recall that Mr. James assured Mr. Massaroni and Mr. Siskind that the second reexamination would not be assigned to Examiner Larkins (Tr. 242, 246). At the beginning of his testimony, before being shown the Siskind and Massaroni declarations, when asked his recollection about the late 1989 meeting, and specifically his recollection of Mr. James' response to Mr. Siskind's request not to assign the second reexamination to Examiner Larkins, he testified that Mr. James stated that he, Mr. James, would take the matter under advisement (Tr. 239).

James

***13** Mr. James testified that he recalled the late 1989 meeting held in Mr. Edlow's office (Tr. 248-49). He could not confirm the statements attributed to Mr. Edlow in ¶ ¶ 3 and 4 of the Massaroni and April 1991 Siskind declarations, because he was not there, but he did state that Mr. Edlow called him into Mr. Edlow's office (Tr. 250-51, 255). He confirmed the statements in ¶ ¶ 5 and 6, except the year and particular patent application mentioned in ¶ 5 (Tr. 251, 255). He denied the substance of the second sentence of ¶ 7, i.e., he denied stating that he intended to call Examiner Larkins immediately so that Examiner Larkins could explain his behavior at the November 1985 interview (Tr. 251-52, 256-57, 258-59). He admitted the substance of the first sentence of ¶ 7, i.e., he admitted stating that he could not tolerate the behavior described by Mr. Siskind for an examiner in his art unit, but added that the statement was directed to any examiner in his art unit and not meant to question Examiner Larkins' conduct (Tr. 252, 256). He denied the substance of ¶ 8, i.e., he denied stating both that this was not the first instance that Examiner Larkins' lack of professional conduct was questioned and that he recalled another such instance and described its substance (Tr. 252, 257, 277). He didn't recall the substance of the first sentence of ¶ 9, i.e., he didn't recall whether Mr. Siskind tried to convince him not to call Examiner Larkins (Tr. 253, 257). He denied the substance of the second sentence of ¶ 9, i.e., he denied assuring Mr. Siskind and Mr. Massaroni that the second reexamination would not be assigned to Examiner Larkins (Tr. 254, 257). Rather, he claimed that in response to the request that the second reexamination not be assigned to Examiner Larkins, he stated that he would consider it (Tr. 254, 257). Similarly, at the beginning of his testimony, before being shown the Massaroni and April 1991 Siskind declarations, when asked about his recollection of

the late 1989 meeting, he testified that he indicated he would consider the request not to assign the second reexamination to Examiner Larkins (Tr. 249). He testified at first that at the time of the late 1989 meeting, he was aware of only one other instance in which allegations of improper conduct had been raised against Examiner Larkins (Tr. 260-61). He was then shown documents from the file of U.S. patent no. 4,644,380 to Zemel (Hearing Exhibit 3) and stated that the one other instance he had alluded to was in connection with the Zemel case (Tr. 264). He did not recall the allegations of misconduct in the Zemel case (Tr. 264-65). After reviewing the portion of Hearing Exhibit 3 where the allegations were made, he testified that his recollection was refreshed, and that the resolution of the complaint was a request by the Group Director that the case be assigned to another examiner (Tr. 265-66). He was then shown a copy of a letter addressed to him as part of a series of documents from the file of U.S. patent no. 4,868,624 to Grung et al. (Hearing Exhibit 4) and stated that he had seen the letter before (Tr. 268). He did not recall the subject matter of the Grung et al. case (Tr. 268). After reviewing a petition to invoke the supervisory authority of the Commissioner that followed the letter in Hearing Exhibit 4, his recollection was refreshed about the allegations of misconduct therein (Tr. 269). He indicated that he was aware of these allegations at the time of the late 1989 meeting (Tr. 272). To the question of counsel for patent owner that isn't it true he was aware of the allegations of misconduct in both the Zemel and Grung et al. cases at the time of the late 1989 meeting, Mr. James indicated it was true but then stated that it was not possible that he may have mentioned either or both of these cases, or any other case, at the late 1989 meeting (Tr. 276-77).

***14** Counsel for patent owner stipulate that neither the allegations of misconduct in the Zemel case nor in the Grung et al. case relate to Mr. Ovshinsky, patent owner, or counsel for patent owner (Tr. 267, 277).

The Second Reconsideration Petition

The second reconsideration petition raises additional allegations said to bear on Examiner Larkins' partiality and said to have arisen since entry of the decision on the first reconsideration petition.

These allegations are:

(1) In the first Office action, Examiner Larkins rejected claims drawn to Schottky barrier devices because of fallacious assertions concerning the presence of semiconductor junctions, and when these errors were pointed out in the declarations of three noted physicists, Examiner Larkins refused to retract his assertions and ignored the declarants' statements;

(2) In the first Office action, Examiner Larkins rejected different claims in a different manner than that urged by the requesting party;

(3) In the first Office action, Examiner Larkins found an affidavit of Zvi Yaniv to be totally ineffectual in demonstrating commercial success of the patented invention. Patent owner claims this finding was

gratuitous and is in clear violation of the requirement that prior actions of another examiner be given full faith and credit, since Mr. Edlow had requested the affidavit and suggested the type of evidence to be placed therein;

(4) Examiner Larkins dismissed patent owner's response, which contained over 55 pages of discussion and over 80 pages of testimony, to the first Office action, after it had been shown that Examiner Larkins' use of the term "corresponding" was identical to patent owner's use of the term. Patent owner continues that Examiner Larkins maintained his rejection, by invoking an issue that he himself admitted could not statutorily be raised during a reexamination proceeding, and that Examiner Larkins refused to admit that he was stretching PTO procedures;

(5) It took Examiner Larkins only a week to complete a 38 page final rejection after the filing of patent owner's over 130 pages of response to the first Office action. A 38 page rejection was by far and away the longest Office action ever received by patent owner.

In view of the above allegations, and in view of failure of Examiner Larkins to respond to a request by patent owner that he voluntarily recuse himself, patent owner renews its first reconsideration petition and seeks the following relief:

(1) reassignment of this reexamination to an unbiased examiner;

(2) prevention of Examiner Larkins from further participation in this reexamination;

(3) stay the current period for filing a notice of appeal;

(4) seal the prosecution history of this reexamination from the time the second request for reexamination was made;

(5) begin the reexamination proceeding ab initio; and/or

(6) certify that the decision on this second reconsideration petition constitutes a final administrative determination of the issues.

***15** The supplement to the second reconsideration petition raises two additional factors said to have arisen since the filing of the second reconsideration petition and the request to the examiner for self-recusal.

The first factor is Examiner Larkins' failure to respond to the request for self-recusal. Patent owner asserts that Examiner Larkins' silence gives rise to, at the very least, an inference of impartiality [sic, non-impartiality].

The second factor is that Examiner Larkins was now aware of the charges of bias against him, in view of the publication of the district court decision discussed above and the request for self-recusal which was hand-delivered to Examiner Larkins personally. Patent owner asserts that Examiner Larkins' knowledge of the charges against him, alone, disqualifies him from further participation in this reexamination proceeding.

Decision

I have reviewed patent owner's post-hearing memorandum (M.) and all the documentary evidence of record relevant to patent owner's allegations of bias and improper conduct, including those allegations made in the first reconsideration petition and in the civil action, and I have listened to all the testimony at the hearing, carefully observing the demeanor of the witnesses, and evaluating the witnesses' credibility. The issue before me is not whether the perceptions of patent owner's representatives are or were reasonable, i.e., whether their perceptions that Examiner Larkins is biased against Mr. Ovshinsky, patent owner or its representatives are reasonable. Rather, the issue is whether patent owner has demonstrated that Examiner Larkins should be removed from this reexamination on grounds of improper conduct, including bias or the appearance of bias, and I have proceeded on that basis.

I find that patent owner has failed to show that Examiner Larkins is biased in this reexamination, either personally or professionally, against named co- inventor Stanford R. Ovshinsky or against patent owner generally, or that Examiner Larkins' conduct suffers from an appearance of bias. Indeed, I find that Examiner Larkins is not biased against Mr. Ovshinsky or against patent owner. Further, I find that patent owner has failed to show any other improper conduct by Examiner Larkins which should result in his removal from this reexamination. Thus, the petition is denied.

After hearing the testimony of Messrs. Fallick, Larkins, Siskind, Citkowski and Guha, it is hard to believe that they were all at the same November 1985 interview yet there is no doubt in my mind that they were. Even as to non- controversial matters, such as the seating arrangement of the attendees, there appears to be significant differences in recollection, although there is some agreement that Examiner Larkins and Dr. Guha sat next to each other and that the interview was conducted in close quarters.

It is recognized that persons observing or participating in the same event frequently have different perceptions of the event, sometimes radically different perceptions. Discussion of the event among two or more of the observers or participants soon after it occurs may alter one or more of these perceptions so that it conforms to others, or there may be no alteration of perceptions. It is further recognized that perceptions often change over time and it would not be a surprise that a person's perception of an event, such as the November 1985 interview, might be different today from when the event occurred. Nor would it be surprising, on the other hand, if that person's initial perception or initial conforming perception became reinforced or more ingrained over time, as might happen when the event is periodically discussed or called into mind. It is further recognized that while a person may not remember with specificity statements he or she made years ago, the person could now truthfully testify that he or she did not make particular statements, based on the person's knowledge of his or her own habits, personality, vocabulary, etc.

***16** I am not able to find any dissembling in the testimony by any of the witnesses to the November 1985 interview nor am I able to find a lack of sincerity in their perceptions of events. I cannot find that Messrs. Siskind, Citkowski and Guha do not sincerely believe that events occurred as they recount in their declarations and testimony.

Nor can I find that Messrs. Fallick and Larkins do not sincerely believe that the inappropriate conduct which Examiner Larkins is accused of never occurred.

I add that I was very impressed with Former Examiner Fallick's demeanor, given the fact that he has no stake in the outcome of this case, and I give substantial weight to his testimony that his first impression after reading the Siskind, Citkowski and Guha declarations was one of being shocked or horrified, and not being at all consistent with his memory of the interview.

While there is conflicting testimony as to the precise time--either before or after Examiner Larkins arrived--when Mr. Fallick left his office to get additional chairs upon the arrival of the other attendees, I find that Mr. Fallick was not absent for any meaningful amount of time which would color his recollection of what transpired at the interview. Patent owner's statement at M.13 that introductory remarks were exchanged in Mr. Fallick's absence is not supported by any testimony of record.

I reject patent owner's argument at M.13 n. 8 that Mr. Fallick's testimony sheds little to no light on the events in question and that Mr. Fallick has no independent recollection of the interview. First, Mr. Fallick testified that he did have an independent recollection of the interview and his testimony manifested it. Second, his recollection of events was no worse than those of the declarants, all of whom could not recall many of the details of the interview.

On the other hand, while the following could have been an oversight on Mr. Siskind's part, I am disturbed that none of the declarations, all of which Mr. Siskind drafted, state that Mr. Fallick was also present at the interview. While the omission from both the Citkowski and Guha declarations is understandable given their testimony that they didn't recall Mr. Fallick's presence, the same does not hold for Mr. Siskind's declaration, in view of his unequivocal testimony (Tr. (1) that Mr. Fallick was present. Moreover, the statement in the Siskind declaration that he set up the interview with Examiner Larkins, and his reference therein to Mr. Fallick in another context, coupled with his testimony that he had never spoken to Examiner Larkins before the interview and that his recollection was that he contacted Mr. Fallick to set up the interview, suggests that the omission of Mr. Fallick's presence may have been more than an oversight.

I find that Examiner Larkins made some remark early in the interview--most likely during the introductory greetings and Examiner Larkins' recounting of his earlier experiences in the art and the comment by one of the attorneys about the art now being more respectable--that upset the three declarants, especially Dr. Guha. I cannot find that patent owner has proven that Examiner Larkins characterized the '226 application as "another crazy Ovshinsky patent." If he did use the word "patent," as the three declarants seem to insist he did, then it was not in reference to the '226 application. In view of Examiner Larkins' affidavit and testimony, and Mr. Fallick's testimony about Examiner Larkins' fastidiousness about technical detail, I do not believe Examiner Larkins would refer to an application as a patent. Nevertheless, whatever Examiner Larkins' words, there was no intent to impugn Mr. Ovshinsky personally or professionally. I base this finding

on what I believe was Examiner Larkins' sincere assertion that he has always respected and admired Mr. Ovshinsky and Mr. Fallick's testimony generally. While unnecessary to this finding, it can be speculated that Examiner Larkins' remark, even if made substantially as alleged, may have been intended as a joke, perhaps a throwback to the type of greeting an Ovshinsky invention, or perhaps Mr. Ovshinsky himself, may have received during the pioneering days of the art when skepticism about amorphous semiconductor switches was common, or simply as a reference to that type of greeting.

***17** I find further that Dr. Guha's impressions of what transpired during the interview after Examiner Larkins' initial remark were greatly influenced by that remark. Since I have already found that the remark was not intended to be offensive, I do not give much weight to these impressions.

I find that the expression, whether a smile or otherwise, on Examiner Larkins' face and verbal gestures which he may have made, whether laughter or otherwise, while they may have seemed derisive to Siskind, Citkowski and Guha, were not reflective of bias by Examiner Larkins against Mr. Ovshinsky personally or professionally. Nobody disputes the fact that the invention claimed in the '226 application was out of the ordinary and that Examiners Larkins and Fallick believed there was a significant issue of whether the invention worked according to the disclosure. I have no doubt that Examiner Larkins expressed skepticism in some way during the interview. And based on my observation of his demeanor at the hearing, I would not be surprised to learn that Examiner Larkins may have been aggressive in making technical points, perhaps even interrupting at times to do so and beginning each interruption with a smile or excited laughter. I find, however, that any such skepticism was directed at the invention and not at named inventor Ovshinsky.

While the declarants claimed that Examiner Larkins referred to the lack of credibility which Mr. Ovshinsky enjoyed in the scientific community, I am impressed by the fact that none of the declarants could refer to a particular statement, beyond the "crazy Ovshinsky patent" and "charlatan" comments, in support thereof.

I find further that the weight of the evidence points to a finding that Examiner Larkins did not refer in any serious way, if at all, to Mr. Ovshinsky as a "charlatan." Dr. Guha was sitting right next to him and yet he doesn't remember hearing Examiner Larkins say that word, and Guha thinks he would have remembered it if he heard it. Mr. Fallick testified similarly. Mr. Citkowski does not remember hearing it although he testified that he recalls that Examiner Larkins used words to that effect. Mr. Larkins denies saying it or anything derogatory. Thus, Mr. Siskind is the only witness who claims Examiner Larkins called Mr. Ovshinsky a "charlatan." Given the logistics in the interview setting, it is not seen how Mr. Siskind could have heard this remark without the other attendees hearing it as well, and none of them remember hearing it, unless it was either whispered directly to Mr. Siskind or was said in such a clearly inoffensive manner that none of the other attendees gave it a second thought. There is no basis in the record for finding that Examiner Larkins whispered anything.

I further find that patent owner has not demonstrated any bias by

Examiner Larkins in his conduct of this reexamination.

It is clear from the record that Examiner Larkins' reliance in the order to reexamine on the Ozawa article as raising a substantial new question of patentability was based on a PTO policy decision not of Examiner Larkins' making. Contrary to patent owner's assertions at M.23, Examiner Larkins did not decide he was going to "make new law." That policy decision was based on the question of whether claims added in a first reexamination, i.e., claims that are not patent claims, are to be treated as if they are patent claims. If so, then these added claims are presumably entitled to the effective filing date of the patent. If not, then the added claims may be entitled only to some later date, such as the date they are added, if a determination is made, for example, that the added claims are not supported by the disclosure.

***18** By the time the first Office action was entered, it was decided by PTO officials other than Examiner Larkins, as a matter of PTO policy, that such added claims would be treated as patent claims. That is why a rejection was not made over Ozawa.

The allegation of bias in connection with the citation of the mathematical formula in the order to reexamine is clearly without merit. On the contrary, if patent owner had carefully considered this allegation before it was made, patent owner would have seen that Examiner Larkins applied the formula in patent owner's favor. As the order to reexamine clearly shows, and as Examiner Larkins testified, the mathematical formula was cited in dismissing the requester's argument of a substantial new question of patentability as to some claims.

Nor is bias shown by the fact that Examiner Larkins relied on the Carlson article in the order to reexamine, and both the Carlson article and the Carlson patent in the first Office action, when Mr. Edlow had held that claims in the first reexamination were patentable over these same references. It has not been shown that Mr. Edlow had the benefit of the requester's views when he made that holding, as Examiner Larkins did in considering the second request for reexamination. Indeed, material new arguments or interpretations can raise a substantial new question of patentability as to prior art patents and publications already considered by PTO. See M.P.E.P. § 2242 and Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351, 353 (Bd.App.1984). Since patent owner has presented no analysis on the issue of whether material new arguments or interpretations were made with respect to the Carlson article or Carlson patent, I cannot find any impropriety in Examiner Larkins' reliance on them.

I find that no bias has been shown with respect to the first Office action. As stated above, its lack of a rejection over Ozawa was not Examiner Larkins' decision to make.

Nor is the fact that the date of entry of the first Office action was only three days after the date of entry of the decision on the first reconsideration petition seen to have any significance. As of the date of that decision, the time for filing the patent owner's statement under 37 CFR § 1.530(b), i.e., March 23, 1990, had already expired. When no such statement is filed, PTO policy provides that the first

Office action be completed within one month of that statement's due date. See M.P.E.P. § 2261. Thus, the first Office action should have been completed by April 23, 1990. At the time of decision on the first reconsideration petition (April 24, 1990), the time for the first Office action was already past due.

I find no bias in the fact that the first Office action rejected different claims in a different manner than that urged by the requester. Indeed, the issues to be considered in a determination of substantial new question of patentability are not necessarily the same as, and are frequently different from, patentability issues. See M.P.E.P. § 2242.

***19** Nor do I find evidence of bias in the rejection of claims drawn to Schottky barrier devices which patent owner argues is based on fallacious assertions and which assertions were not retracted after the declarations of three noted physicists pointed out their fallaciousness. Examiner Larkins' treatment of these claims and the declarations are on the record. Whether he is right or wrong is something appropriate for decision by the Board of Patent Appeals and Interferences. Patent owner has not demonstrated to me that even if Examiner Larkins' position is incorrect, it is the product of bias.

This finding of no bias shown with respect to the Schottky barrier device issue would not be altered by consideration of testimony of one Dr. Lucovsky, who ostensibly testified on the same issue in an apparently unrelated civil action, even if patent owner is correct that this testimony supports the above- mentioned three declarations. This testimony is attached to patent owner's post-hearing memorandum as Exhibit I and is referred to at M. 26. Patent owner was granted no authorization to present additional evidence with its post- hearing memorandum. Therefore, the testimony has not been considered.

I find no bias in Examiner Larkins' criticisms of the Yaniv affidavit in the first Office action. The new issues raised in the first Office action mandated reevaluation of the affidavit in light of these issues. It would have been inappropriate for Examiner Larkins not to treat the affidavit on its merits. Again, these criticisms are on the record. If they are in issue before the Board, the Board is the proper forum to consider them.

Before going onto allegations of bias in further actions of Examiner Larkins, I note that Examiner Larkins, in the first Office action, confirmed the patentability of claims 1-16, 21 and 23. The confirmation of patentability of any of the claims is scarcely consonant with the notion of bias. Nor is the confirmation of patentability consistent with patent owner's argument at M. 22- 27, based on Examiner Larkins' notes of January 9, 1990 (Hearing Exhibit 2) drafted before mailing of the order to reexamine, that Examiner Larkins had already decided to invalidate the patent claims. I find that these notes reflect Examiner Larkins' initial evaluation of some of the issues raised by the second request for reexamination, including whether some of the claims added in the first reexamination which he believed were new matter could be rejected on that basis. I further find that these notes contain no evidence of bias.

I find no bias in the fact that the final rejection is 38 pages long

and was completed in a week after patent owner's response to the first Office action was received. I find this an incredible allegation, given patent owner's admission that its response to the first Office action contained over 55 pages of discussion and over 80 pages of testimony. Patent owner claims that patent owner has never received an Office action as long as 38 pages. It would seem in this case that a shorter final rejection would be more indicative of bias than a longer one, because it would contain less in the way of explanation for why the over 135 pages of response was not persuasive. The more an examiner puts on the record in support of his position, the more that is available to be reviewed by the Board. Here again, the Board is the proper forum to review the substance of the 38-page final rejection.

***20** I find no relevance in the fact that Examiner Larkins was aware of the allegations of bias against him almost as early as they were made of record in March 1990. I do not subscribe to the view that a person accused of bias will be biased if he knows of the accusation. Nor does this view appear to be widely-held in any quarter. Indeed, as stated at page 4 in the decision on the first reconsideration petition:

> Petitioner's argument that these documents [on the bias issue] would taint the actions of an examiner conducting the reexamination are not sound.... The presence of such documents should in no way taint the actions of the examiner on the merits of this reexamination proceeding.

The bias issue documents were removed from the file anyway, for the stated reason "to preclude the possibility" of taint. In retrospect, their removal was academic, since Examiner Larkins already knew of the allegations against him. Patent owner has not shown that but for this knowledge, Examiner Larkins would have proceeded any differently on the merits of the patentability of patent owner's claims.

Examiner Larkins' failure to recuse himself can be taken as his denial of the reasons relied on in the request for him to recuse himself. Moreover, his failure to respond to that request is not indicative of bias, since that failure was not his decision.

Nor do I find any merit in patent owner's argument at M. 11, 21-22 that Examiner Larkins concealed his knowledge of the bias issue. Examiner Larkins knew while he was conducting the reexamination that certain documents concerning the bias issue were removed from the file. But before the issue became public, he had no way of knowing, unless he was told, and the record shows he was not so told by any PTO employee, that he was not supposed to know of the bias issue. Not having been asked about his knowledge of the bias issue, there was no concealment in Examiner Larkins' failure to voluntarily disclose that knowledge.

Everything stated so far is unaffected by the November 1989 meeting. There is conflicting testimony about whether Mr. James stated that he would not assign the second reexamination to Examiner Larkins and whether he made reference to an earlier instance of misconduct on the part of Examiner Larkins. Patent owner admits that it never made these alleged statements of record until April 1991. Therefore, even if I were to accept patent owner's version as the truth, patent owner has waived any rights of review it might have had of the initial decision to assign Examiner Larkins to this reexamination. Even if Mr. James did make those statements, and given the presence in the record of other instances of unprofessional conduct by Examiner Larkins, none of which

relate to bias, my findings both that patent owner has not proven bias, or the appearance of bias, or other misconduct in this reexamination, and that Examiner Larkins is not biased and has not engaged in other misconduct in this reexamination, are not affected thereby.

Conclusion

***21** The petition is denied. No reconsideration of this decision on petition will be entertained.

This decision becomes a final decision upon entry of a final decision by the Board.

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