

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 72

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

STAN WOJCIAK

Junior Party,
(Patent 5,922,783),

v.

YUKO NISHIYAMA and HIROYUKI MIKUNI

Senior Party
(Application 08/730,025).

Patent Interference No. 104,539 (McK)

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and MEDLEY, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge

MEMORANDUM OPINION and ORDER
(Decision on Wojciak motion to suppress evidence)

WOJCIAK MOTION 1 TO SUPPRESS (Paper 63) seeks to suppress, i.e., objects to the admissibility of, certain portions of DECLARATION 1 OF YUKO NISHIYAMA (Ex 1006) dated 30 November 2000 (Ex 1006, page 13).

A. Findings of fact

1. There came a time in the interference when Wojciak filed Wojciak Preliminary Motion 1 (Paper 21) alleging unpatentability under 35 U.S.C. § 103 of certain claims of the Nishiyama application (Ex 1001) involved in the interference.

2. In due course, Nishiyama timely filed an opposition (Paper 41).

3. In support of its opposition, Nishiyama relies on DECLARATION 1 OF YUKO NISHIYAMA (Ex 1006) (hereinafter "Nishiyama declaration").

4. Yuko Nishiyama is a named inventor along with Hiroyuki Mikuni in the Nishiyama application (Ex 1001) involved in the interference.

5. The specification of the Nishiyama application contains, inter alia:

- (1) EXAMPLES 1 TO 11 (Ex 1001, page 40).
- (2) COMPARATIVE EXAMPLES 1 TO 13 (Ex 1001, pages 40 and 41), results of which are summarized in a TABLE 1 (Ex 1001, page 42).
- (3) COMPARATIVE EXAMPLES 12-14 (Ex 1001, page 43), results of which are summarized in TABLE 2 (Ex 1001, page 44).
- (4) EXAMPLES 32-37 (Ex 1001, pages 46-47), results of which are summarized in TABLE 5 (Ex 1001, page 47).
- (5) EXAMPLES 54-57 AND 59-64 (Ex 1001, page 51), results of which are summarized in TABLE 9 (Ex 1001, page 52).
- (6) EXAMPLES 77-81 (Ex 1001, page 54), results of which are summarized in TABLE 11 (Ex 1001, page 54).

(7) Examples 92-93 (Ex 1001, page 56), results of which are summarized in TABLE 14 (Ex 1001, page 56).

6. In opposing Wojciak's unpatentability assertions, Nishiyama relies on the Nishiyama declaration to establish the truth of certain scientific experiments and data generated therefrom. See, e.g., ¶¶ 13-15, 15a, 15b, 17-18, 21, 21a and 22-23 of the Nishiyama declaration.

7. With respect to experimental work said to be reproduced in the Nishiyama specification as the examples and tables mentioned above, Yuko Nishiyama testifies (Ex 1006, unnumbered page 1) (bracketed matter added):

The following experiments which were conducted [1] by me or [2] under my supervision or [3] by my coinventor or [4] under his [i.e., Mikuni's] supervision are disclosed [i.e., described,] in the Nishiyama and Mikuni application no. 08/730,025; the Examples referenced [in the Nishiyama declaration] are those of the involved Nishiyama and Mikuni application 08/730,025.

8. Wojciak timely filed WOJCIAK OBJECTION (1) objecting to the admissibility of ¶¶ 13-15, 15a, 15b, 17-18, 21, 21a and 22-23 (hereinafter "objected to paragraphs") of the Nishiyama declaration.

9. A copy of WOJCIAK OBJECTION (1)¹ accompanied WOJCIAK MOTION 1 TO SUPPRESS.

WOJCIAK OBJECTION (1) should have been assigned an exhibit number. Wojciak's failure to assign an exhibit, however, is not prejudicial to Nishiyama given that the objection accompanied Wojciak's motion. In the future, a party should assign an exhibit number to a previously served, but not filed, objection when the objection accompanies a motion to suppress.

10. In WOJCIAK OBJECTION (1), Wojciak raised the following grounds to the admissibility of the objected to paragraphs:

- (1) The testimony is irrelevant (Fed. R. Evid. 402) because the underlying evidence is not prior art, and accordingly to Wojciak, can have no bearing on what a person having ordinary skill in the art would have known.
- (2) The testimony is hearsay (Fed. R. Evid. 802) and Nishiyama has not established that any exception to the hearsay rule should apply.
- (3) As to the experimental work described by Yuko Nishiyama in the objected to paragraphs, Nishiyama has not complied with ¶ 43 of the NOTICE DECLARING INTERFERENCE.²

11. Wojciak also objected to the admissibility of ¶ 34 of the Nishiyama declaration, but that objection was not renewed in WOJCIAK MOTION 1 TO SUPPRESS.

12. As was its right, Nishiyama elected not to supplement the Nishiyama declaration. 37 CFR § 1.672(c); NOTICE DECLARING INTERFERENCE, ¶ 34 (Paper 1, page 28).

¶ 43. Reliance on scientific tests and data

Parties often rely on scientific tests and data, both in the preliminary motion phase and during the priority testimony phase. Examples include IR (infra-red spectroscopy) and graphs generated therefrom, HPLC (high performance liquid chromatography) and data generated therefrom, etc. In the event a party relies on a scientific test or data generated from a scientific test, the party relying on the test or data shall explain:

- a. the reason why the test is being used and why the data is being relied upon;
- b. how the test is performed;
- c. how the data is generated using the test;
- d. how the data is used to determine a value;
- e. the acknowledged accuracy of the test; and
- f. any other information which the party believes would aid the board in understanding the significance of the test and/or data.

The explanation desirably takes place through an affidavit testimony of a witness, preferably accompanied by references to relevant pages of standard texts (which should be exhibits in the interference).

13. In due course, Yuko Nishiyama was cross-examined (Ex 1015).³

14. In connection with the Wojciak motion to suppress, the following, and only the following, portions of the cross-examination of Yuko Nishiyama have been called to our attention by Nishiyama (Paper 41, pages 2 and 5), viz., "page 68, line 1 through page 72, line 19, especially page 68, lines 9-16."

15. Cross-examination specifically relied upon by Nishiyama reveals the following testimony by Yuko Nishiyama (Ex 1015, page 68, lines 9-16):

A. [by Yuko Nishiyama]. When you say other people, are you asking me about other people who conducted these tests?

Q. [by Robert H. Fischer, Esq., counsel for Wojciak]. Yes.

A. There are no other people who conducted these tests.

Q. You conducted all the tests?

A. I conducted all so far as the data that are listed in the specification.

16. Further cross-examination reveals (Ex 1015, page 68, line 17 through page 69, line 23):

Q. Could you please turn to Exhibit 1006 which is Declaration 1 of Yuko Nishiyama [i.e., the Nishiyama declaration,] and I would direct your attention to paragraph 5 which states:

"The following experiments which were conducted by me or under my supervision

³ During cross-examination, Yuko Nishiyama testified through Shozo Otani, a Japanese-English interpreter (Ex 1015, pages 5 through 14).

or by my co-inventor or under his supervision are disclosed in *** [the] Nishiyama *** application ****."

Do you see that?

- A. Yes.
- Q. What were the tests that were conducted by Mr. Mikuni?
- A. Tests were conducted prior to those which were cited in the specification and those test[s] Mr. Mikuni conducted or as to these tests the -- under Mr. Mikuni's supervision as my co-inventor the tests were conducted.
- Q. What tests were conducted under Mr. Mikuni's supervision?
- A. The testing procedures which are described in the specification were the tests which were conducted as exchange were made between me and Mr. Mikuni as my co-inventor.
- Q. Where there not other people involved in addition to you and Mr. Mikuni in these tests? Isn't that exactly what paragraph 5 of your declaration Exhibit 1006 says, sir?
- A. I believe that during the preparation of samples, I had assistants to the extent that turning on and off of the stirrer.
- Q. And Mr. Mikuni he also had assistants in turning on and off the stirrer, sir?
- A. Such thing may have happened.

17. Still further cross-examination reveals (Ex 1015, page 71, line 14 through page 72, line 1 and page 72, lines 9-25):

- Q. An for each of those tests, if it wasn't cured as it came off the conveyor belt, you walked over, took it off the conveyor belt

and put it back on the entry to the conveyor belt, correct?

A. Yes.

Q. Mr. Mikuni, did not do that for any sample, is that your testimony?

A. I do not have a clear recollection of that but he may have conducted a test to verify what I did and -- strike that.

I do not have a clear recollection of that but he may have conducted in the manner to verify what I did.

* * * * *

Q. Did Mr. Mikuni have any involvement in those comparative examples or did you run all those alone also?

A. Since it goes way back, I do not have an accurate recollection but there may have been instruction[s] which were given to me to conduct such comparative tests.

Q. And there may have been instructions given either by you or Mr. Mikuni to people under your supervision, correct?

A. Yes.

* * * * *

Q. Now how were the test results recorded?

A. The test results were entered into lab notes.

Q. Where these lab notes loose or were they kept as lab notebooks?

A. It was in the form of one notebook.

18. In its opposition, and based on the above-noted cross-examination, Nishiyama maintains that the objected to paragraphs are not hearsay because Yuko Nishiyama "personally carried out all tests reported in his declaration" (Paper 41, page 5, last ¶).

19. Nishiyama also maintains that even if the data is hearsay, it is admissible as an exception to the hearsay rule as "data *** kept in the course of regularly conducted business activity, as evidenced by the Nishiyama involved patent application" (Paper 41, pages 5-6). See Fed. R. Evid. 803(6).

B. Discussion

1. Wojciak's objection based on relevance

As we understand it, Wojciak maintains that the data in the specification of the Nishiyama specification is not prior art and therefore cannot be relevant on the issue of what one skilled in the art could have known.

We believe Wojciak has completely missed a significant point.

Relevant evidence is any evidence having any tendency to make the existence of any fact that is of consequence to the determination of an interference more probable or less probable than it would be without the evidence. Fed. R. Evid. 401. An unexpected result obtained with an invention vis-a-vis a result obtained with the prior art is a fact that is of consequence on an issue of obviousness under 35 U.S.C. § 103. The data presented in the specification is offered, inter alia, to prove unexpected results.

Moreover, if Wojciak were correct, then the claimed invention being compared with the "prior art" could never be novel because the comparative testing would have to be described in the prior art! No citation of precedent is required to establish, as a matter of law, that evidence of comparative

testing to demonstrate an unexpected result is manifestly relevant on the legal issue of obviousness apart from the time when comparative testing occurred.

Wojciak's objection based on relevance is overruled.

2. Wojciak's objection based on hearsay

Wojciak's objection based on hearsay presents a different question.

In an interference, data based on experiments described in a specification of an involved patent or application is not admissible per se to establish that the experiments, in fact, were carried out as described, or that data generated as a consequence of the experiments (i.e., a particular result), in fact, was obtained as described. All parties to an interference are given notice of the hearsay nature of statements in a specification in ¶ 41 of the NOTICE DECLARING INTERFERENCE (Paper 1). Paragraph 41 states:

A specification of an application or patent involved in the interference is admissible as evidence only to prove what the specification or patent describes. If there is data in the specification upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated (i.e., the individual who performed an experiment reported as an example in the specification) must be filed.

The individual will be subject to cross-examination.

Apparently taking heed of ¶ 41, Nishiyama presented the Nishiyama declaration to establish through a witness the "truth"

of the experiments and data generated therefrom, all said to be described in the specification of the Nishiyama application involved in the interference.

In his declaration testimony, Yuko Nishiyama states that the experiments reported in the specification of the Nishiyama application involved in the interference "were conducted [1] by me or [2] under my supervision or [3] by my coinventor^[4] or [4] under his supervision" (bracketed matter added). We are not concerned so much with the "under my supervision" or "under his supervision" portion of Yuko Nishiyama's testimony. Rather, our concern is with that portion of his testimony which plainly seems to indicate that his coinventor "conducted" "experiments reported in the specification ***." Based on the declaration testimony of Yuko Nishiyama, it has not been established which experiments were conducted by or under the supervision of Yuko Nishiyama and which were conducted by or under the supervision of Hiroyuki Mikuni.

During cross-examination, a different version of who conducted the experiments begins to surface. Based on cross-examination, Nishiyama, through Yuko Nishiyama, would now have us believe that only he, and "no other people *** conducted these tests" (Ex 1015, page 68, lines 12-13). At the same time, Yuko Nishiyama acknowledges that he may not have an "accurate recollection" given that "it goes way back ***."

As a first step in our determination, we undertake to assess the credibility of the testimony of Yuko Nishiyama with respect

⁴ Yuko Nishiyama's coinventor (Hiroyuki Mikuni) did not testify.

to whether he or he and his coinventor "conducted" tests described in the Nishiyama specification and Nishiyama declaration. There is a conflict between the testimony in the Nishiyama declaration and the Nishiyama cross-examination. Furthermore, Yuko Nishiyama has conceded that he had some difficulty with his recollection. Under these circumstances, and while the matter may not be free from doubt, we find that Nishiyama has not convincingly established that Yuko Nishiyama personally conducted all the experiments described in the Nishiyama specification and Nishiyama declaration. If he conducted some of the experiments, his testimony fails to convincingly establish which experiments he personally conducted.

Counsel for Wojciak attempted to clarify the conflict during cross-examination. However, Yuko Nishiyama's attempts to reconcile the conflict between his declaration testimony and his cross-examination (quoted above) are unintelligible and unsatisfactory. After Wojciak filed its objection, and after the above-noted cross-examination of Yuko Nishiyama, counsel for Nishiyama (1) at the cross-examination deposition should have recognized the conflict between the declaration and cross-examination testimony, and the unclear manner in which Yuko Nishiyama attempted to reconcile the conflict, and (2) should have taken steps to have Yuko Nishiyama clarify the matter, if he could. Alternatively, given the declaration testimony and the Wojciak objection, and prior to cross-examination, Nishiyama had an opportunity to file, and could have filed, supplemental declarations of Yuko Nishiyama, Hiroyuki Mikuni, both and/or

perhaps even others, to establish the facts surrounding who conducted the experimental work.

Lacking from the record is sufficient credible testimony to permit us to accurately determine, as a matter of fact, who conducted what experiment. Likewise lacking from the record is sufficient testimony to permit us to reconcile the conflict in the testimony of Yuko Nishiyama. Accordingly, we decline to find that Yuko Nishiyama conducted all, or even some (and if so, which) of the experiments upon which Nishiyama seeks to rely. Accordingly, we agree with Wojciak that the objected to paragraphs of the Nishiyama declaration are hearsay to the extent they seek to establish that, in fact, the experiments were conducted, as described, and that, in fact, the resulting data was obtained, as described. Cf. In the Matter of James Wilson Associates, 965 F.2d 160, 173 (7th Cir. 1992):

*** the judge must make sure that the expert isn't being used as a vehicle for circumventing the rules of evidence.

If for example the expert witness (call him A) bases his opinion in part on a fact (call it X) that the party's lawyer told him, the lawyer cannot in closing argument tell the jury, "See, we proved X through our expert witness, A."

3. Record of a regularly conducted activity

Nishiyama maintains that the objected to paragraphs are admissible under the "records of regularly conducted activity" (business record) exception to the hearsay rule. See Fed. R. Evid. 803(6), which provides in relevant part:

A memorandum, report, record, or data compilation, in any form, of acts, events, conditions, opinions, or diagnoses, made at or near the time by, or from information transmitted by, a person with knowledge, if kept in the course of a regularly conducted business activity, and if it was the regular practice of that business activity to make the memorandum, report, record, or data compilation, all as shown by the testimony of the custodian or other qualified witness, unless the source of information or the method or circumstances of preparation indicate lack of trustworthiness.

Nishiyama, not Wojciak, has the burden of establishing that the objected to paragraphs fall within the Rule 803(6) exception to the hearsay rule. Rule 803(6), as applied to the facts of this case, boils down to the following:

A [1] *** report *** or data compilation, in any form, of [2] acts, events, conditions, opinions, or diagnoses, [3] made at or near the time by, or [4] from information transmitted by, a person with knowledge, if [5] kept in the course of a regularly conducted business activity, and [6] if it was the regular practice of that business activity to make the report *** or data compilation, [7] all as shown by the testimony of the custodian or other qualified witness, unless [8] the source of information or the method or circumstances of preparation indicate lack of trustworthiness.

Nishiyama must establish each of the eight elements necessary to invoke the Rule 803(6) exception. Kolmes v. World Fibers Corp., 107 F.3d 1534, 1542-43, 41 USPQ2d 1829, 1834-35 (Fed. Cir. 1997) (World unable to establish that Rule 803(6)

exception should apply). It has not done so.

According to Yuko Nishiyama, experimental work is said to have been recorded in a lab notebook. The notebook was not offered in evidence, and therefore, any entry in the notebook cannot be compared with material described in the Nishiyama application involved in the interference. There is no credible evidence that all relevant information in the lab notebook found its way into the Nishiyama specification. Nor is it clear who recorded any information in the lab notebook or to whom the lab notebook was assigned. Moreover, as we have already found, it is not clear on this record who performed each of the experiments embodied in the examples discussed in the objected to paragraphs. Hence, Nishiyama has failed to establish factually that Yuko Nishiyama is a "person with knowledge" within the meaning of Rule 803(6) of all the information proffered in the objected to paragraphs of the Nishiyama declaration.

Apart from the fact Nishiyama has not established Yuko Nishiyama's personal knowledge, we have some doubt as to whether experimental work of the type discussed in the Nishiyama specification and Nishiyama declaration is "a regularly conducted business activity" within the meaning of Rule 803(6). It is safe to assume that research per se is a regularly conducted activity in the sense that many corporations carry on research activity. Records associated with the names of research personnel employed by a corporation, time and attendance records related to research activity, financial information (e.g., purchase orders), and the like, are the type of record which might be shown to be kept in

the course of a regularly conducted business activity. However, on this record, a laboratory notebook recording a specific experiment has not been shown to be "a regularly conducted business activity" within the meaning of Rule 803(6).⁵

Experiments of the type described in the Nishiyama application and Nishiyama declaration are normally unique one-time events, i.e., events leading to the making of a patentable invention. The experiments are not the same, for instance, as records generated by operating a chemical plant (e.g., recording a condition in the plant such as a temperature at a particular location at regular time intervals). Moreover, (1) even if a laboratory notebook recording a unique one-time event, or data copied therefrom could be considered a record of "a regularly conducted business activity," where (2) the individual who participated in the events recorded in the notebook is available to testify, we probably would be inclined to exercise our discretion to require the testimony of that individual, particularly in light of 37 CFR § 1.671(f). See Fed. R. Evid. 403 (relevant evidence may be excluded if its probative value is substantially outweighed, inter alia, by danger of unfair prejudice or confusion of issues). Our experience establishes that laboratory notebook entries often are not self-explanatory and for that reason Rule 671(f) provides that the significance of documentary and other exhibits identified by a witness shall be

⁵ Cf. Alpert v. Slatin, 305 F.2d 891, 895-96, 134 USPQ 296, 300 (CCPA 1962) (declining to apply the former Federal Shop Book rule of 28 U.S.C. § 1732, which is not as liberal as Rule 803(6)).

discussed with particularity by the witness.⁶ And, as applied to laboratory notebooks or information copied therefrom, the discussion generally should take place through the testimony of the individual who recorded information in the notebook. In the case before us, neither the notebooks nor testimony of an individual credibly shown to have first-hand knowledge with respect thereto has been offered in evidence.

4. Initial objection based on ¶ 43 of the NOTICE DECLARING INTERFERENCE

WOJCIAK OBJECTION (1) included an objection to the admissibility of the objected to paragraphs based on an alleged failure of Nishiyama to comply with ¶ 43 of the NOTICE DECLARING INTERFERENCE. See Finding 10(3), supra. The objection was not renewed in WOJCIAK MOTION 1 TO SUPPRESS. Accordingly, the objection is waived.

Nevertheless, we take this opportunity to note that a failure to comply with ¶ 43 of the NOTICE DECLARING INTERFERENCE, now ¶ 43 of the Trial Section's STANDING ORDER, is not a basis for objecting to the admissibility of evidence. Rather, a failure of a party to comply with ¶ 43 goes to the weight to be

⁶ See also Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48427-28 (Dec. 12, 1984):

Under § 1.671(f), the significance of documentary and other exhibits must be discussed with particularity by a witness during oral deposition or in an affidavit. Section 1.671(f) sets out in the regulations an evidentiary requirement imposed by precedent. See Popoff v. Orchin, 144 USPQ 762 (Bd. Pat. Int. 1963) (unexplained experimental data should not be considered); Chandler v. Mock, 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless), and Smith v. Bousquet, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in stipulated testimony are entitled to little weight). See also In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974) and Triplett v. Steinmayer, 129 F.2d 869, 54 USPQ 409 (CCPA 1942).

given testimony relying on scientific tests and data. A failure to explain scientific tests and data in the manner required by ¶ 43 more than likely will lead to the board according little, if any, weight to scientific tests and data.

5. Conclusion

We exercise our discretion to sustain Wojciak's objection to the admissibility of the objected to paragraphs of the Nishiyama declaration to the extent that they are offered to prove the truth of statements made therein.

In sustaining the objection, we recognize that generally an administrative agency is not bound strictly by the rules of evidence. In re Epstein, 32 F.3d 1559, 1565, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994). Indeed, in ex parte patent prosecution hearsay may properly be considered. See, e.g., In re Reuter, 670 F.2d 1015, 1020-21, 210 USPQ 249, 254-55 (CCPA 1981). However, in inter partes interference proceedings, the Federal Rules of Evidence apply (37 CFR § 1.671(b)), and those rules authorize the board to exercise its discretion to sustain an objection to the admissibility of evidence based on hearsay (Fed. R. Evid. 802). In re Epstein, supra.

C. Order

Upon consideration of WOJCIAK MOTION 1 TO SUPPRESS (Paper 63), and for the reasons given, it is

ORDERED that the motion is granted to the extent that Wojciak's objection to the admissibility of ¶¶ 13-15, 15a, 15b, 17-18, 21, 21a and 22-23 of the Nishiyama declaration (Ex 1006)

is sustained to the extent that they are offered to prove the truth of statements made therein. Fed. R. Evid. 802; In the Matter of James Wilson Associates, 965 F.2d 160, 173 (7th Cir. 1992).

FURTHER ORDERED that the motion is otherwise denied.

_____)	
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Administrative Patent Judge)	
_____)	
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