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Paper No. 92

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ROBERT G. SPALDING

Junior Party
(Patent No. 5,195,564),

v.

HAL C. HARTSELL JR. and
KENNETH L. POPE,

Senior Party
(Application 08/033,311)

Patent Interference No. 104,699

Before LEE, TORCZON and GARDNER-LANE, Administrative Patent
Judges.

LEE, Administrative Patent Judge.

DECISION ON SPALDING'S PRELIMINARY MOTION 2

Spalding's preliminary motion 2 is denied.

Findings of Fact

1. This interference was declared on April 27, 2001.
2. Junior party Spalding is involved on the basis of its
Patent No. 5,195,564.

3. Senior party Hartsell is involved on the basis of its Application 08/033,311.

4. There are two counts, Count 1 and Count 2, in this interference.

5. At the time of declaration of this interference, the claims designated as corresponding to Count 1 were Spalding's patent claims 1-6 and Hartsell's application claim 22, and the claims designated as corresponding to Count 2 were Spalding's patent claims 7 and 8 and Hartsell's application claims 28 and 29.

6. Junior party Spalding's real party in interest is Dresser Industries, Inc.

7. Senior party Hartsell's real party in interest is Marconi Communication Systems, Inc.

8. On September 6, 2001, junior party filed preliminary motion 2 (Paper No. 50) for judgment against senior party's claims 22, 28 and 29 on the ground that they are unpatentable over the "Bergamini Paper" under 35 U.S.C. § 102(b) and/or 103(a) alone or in combination with U.S. Patent No. 4,522,237.

9. The "Bergamini Paper" is entitled "Analysis of Hydrocarbon Evaporative Emission Recovery in Relation to Stage II - Onboard Alternatives," and a copy of this paper is provided by party Spalding as its Exhibit 2012.

10. Senior party Hartsell's involved application 08/033,311 was filed on March 15, 1993, and has been accorded the benefit of application 07/946,741, filed September 16, 1992; application 07/824,702, filed January 21, 1992; and application 07/625,892, filed December 11, 1990.

11. Junior party Spalding's involved Patent No. 5,195,564 is based on application 07/693,549, filed April 30, 1991.

12. Junior party Spalding's preliminary motion 2 does not allege any specific date after which the Bergamini paper according to party Spalding should be regarded as a printed publication under 35 U.S.C. § 102.

13. Junior party Spalding's preliminary motion 2 does not include an explanation as to why the prior art asserted against senior party Hartsell in Spalding's preliminary motion 2 does not apply to Spalding's claims corresponding to the count.

14. In pertinent part, 37 CFR § 1.637(a) states:

If a party files a motion for judgment under § 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party.

Discussion

A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. 37 CFR

§ 1.637(a). Behr v. Talbott, 27 USPQ2d 1401, 1407 (Bd. Pat. App. & Int. 1992); see also Kubota v. Shibuya, 999 F.2d 517, 27 USPQ2d 1418 (Fed. Cir. 1993). Spalding's preliminary motion 2 on page 2 asserts that Hartsell's applications claims 22, 28 and 29 are unpatentable over "the Bergamini Paper under 35 U.S.C. § 102(b) and/or 103(a) alone or in combination with U.S. Patent No. 4,522,237." A prerequisite to any merit in Spalding's preliminary motion 2, even prior to examination of the substantive content of the Bergamini paper, is that it must constitute a "printed publication" under 35 U.S.C. § 102/103. Accordingly, we focus first on this issue of "printed publication."

Spalding in its preliminary motion 2 asserts that the Bergamini paper is a prior art printed publication under 35 U.S.C. § 102(b). In that connection, Spalding states that "Bergamini distributed his paper 'widely and publicly' to individuals, organizations, and companies interested in vapor recovery systems." The preliminary motion does not explain, however, how it is that the board should find that Bergamini so widely and publicly distributed his paper to the public interested in that art that the paper should be deemed a printed publication. As support for the assertion, the preliminary motion refers to four exhibits, i.e., Exhibits 2013, 2014, 2015 and 2019, the first three of which are affidavits of Giorgio

Bergamini, Carlo Cucchi, and Francesco Cavallino, respectively. The preliminary motion does not explain how the cited evidence supports Spalding's ultimate conclusion that the Bergamini paper constitutes a printed publication or that Bergamini distributed his paper "widely and publicly" to "individuals, organizations, and companies interested in vapor recovery systems." The citation to the exhibits merely invites the opponent and the decision-maker to sift through the evidence on their own initiative and to draw their own conclusions based on their own manner of harnessing, interpreting, and characterizing the evidence.

Moreover, the citations are to entire exhibits as a whole, and not to any particular section or paragraph thereof, and the citations are used to support the ultimate conclusion rather than any particular underlying fact necessary for reaching the ultimate conclusion. The entire argument portion of Spalding's preliminary motion 2 attempting to establish the Bergamini paper as a printed publication reads as follows:

A. Bergamini Paper Is A Prior Art Publication Under 35 U.S.C. § 102(b)

Bergamini was trying to persuade the industry and regulatory representatives to embrace the system described in the Bergamini Paper. Exhibit 2013, ¶ 14. To accomplish this objective, Bergamini distributed his paper "widely and publicly" to individuals, organizations, and companies interested in vapor recovery systems. **Exhibits 2013, 2014, 2015 and 2019.** The "wide and public" distribution of the Bergamini Paper qualifies it as prior art under 35 U.S.C. §

102(b). Mass. Inst. of Tech. v. Pharmacia AB, 774 F.2d 1104, 227 U.S.P.Q. 428 (Fed. Cir. 1985); Friction Division Prod., Inc. v. E.I. Dupont de Memours & Co., Inc., 658 F.Supp. 998, 3 U.S.P.Q.2d 1775 (D. Del. 1987), aff'd 883 F.2d 1027, 12 U.S.P.Q.2d 1575 (Fed. Cir. 1989); Garrett Corp. v. United States, 422 F.2d 874, 164 U.S.P.Q. 521 (Ct. Cl. 1970). (Emphasis added.)

Note that the above-quoted text does not even indicate the date at or subsequent to which Spalding would regard the Bergamini paper as a printed publication.

Even assuming that explanations about why the board should find that Bergamini had widely and publicly distributed his paper to persons of ordinary skill in the art and how the evidence supports the ultimate conclusion that the Bergamini paper is a printed publication are contained in the affidavits and other cited evidence, it would mean Spalding has improperly incorporated arguments by reference to the affidavits and evidence. Incorporation of arguments by reference is prohibited. Spalding had ample notice that incorporation of arguments by reference to declaration or affidavit testimony or other evidence is not permitted.

Specific actual notice exists by way of ¶ 13 of the STANDING ORDER (Paper No. 2) mailed to the parties at the time of declaration of this interference:

13. Prohibition against incorporation by reference

Arguments presented in one paper shall not be incorporated by reference to another paper.

The purpose of this requirement is to minimize the chance that an argument will be overlooked and to maximize the efficiency of the decision-making process. In this respect, the Trial Section adopts as its policy the following rationale of DeSilva v. DeLeonardi, 181 F.3d 865, 866-67 (7th Cir. 1999): "[a]doption by reference amounts to a self-help increase in the length of the * * * brief * * * [I]ncorporation by reference is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record."

Further notice also exists by way of a precedential decision of the Interference Trial Section, LeVeen v. Edwards, 57 USPQ2d 1406 (Bd. Pat. App. & Int. 2000). Part C1(a) of that opinion is reproduced below, LeVeen, 57 USPQ2d at 1412:

C. Opinion

1. Failure to follow applicable procedure

a.

Edwards, contrary to ¶ 13 of the NOTICE DECLARING INTERFERENCE, has incorporated "arguments" from the Siperstein and Sheehan declarations (Exs 5010 and 5015) into Edwards preliminary motion 1. Edwards misperceives the role of motions and evidence. Declarations are evidence. A motion is supposed to (1) lay out all relevant facts, with reference to the evidence which supports the facts, and (2) present an argument why the facts justify any relief requested in the motion.

The NOTICE DECLARING INTERFERENCE explicitly precludes incorporation by reference of arguments. There are numerous reasons why an agency, in general or in a particular case, may preclude incorporation

by reference in papers presented to the agency. First, an incorporated argument may be overlooked (Paper 1, page 10 n.7). Second, incorporation of arguments is not consistent with efficient decisionmaking (Paper 1, page 10 n.7). Essentially, incorporation by reference is an inappropriate role-shifting technique which makes it a decisionmaker's job to (1) scour the record, (2) come up with some theory which supports a party's case and (3) articulate a rationale in an opinion supporting the rationale without giving an opponent a reasonable chance to address the rationale. Third, through incorporation by reference an attorney can avoid page limitations applicable to motions (Paper 1, page 27 ¶ 28). Compare DeSilva v. DiLeonardi, 181 F.3d 865, 866-67 (7th Cir. 1999) ("[a]doption by reference amounts to a self-help increase in the length of the *** brief. *** [I]ncorporation by reference is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.").

We recognize in this particular case that both the preliminary motion and the declarations are short. Hence, it can be argued that there was no undue burden on the opponent or the board to look collectively at both documents. The contrary argument is that the procedure applicable to this interference is otherwise and that it would have been no undue burden for Edwards to have complied with the applicable procedure.

We follow the above-quoted principles and views set forth in LeVeen v. Edwards (Paper No. 240) and reiterate two points A and B for emphasis:

A.

[Spalding] misperceives the role of motions and evidence. Declarations [and affidavits] are evidence.

A motion is supposed to (1) lay out all relevant facts, with reference to the evidence which supports the facts, and (2) present an argument why the facts justify any relief requested in the motion.

B.

Incorporation by reference is an inappropriate role-shifting technique which makes it a decisionmaker's job to (1) scour the record, (2) come up with some theory which supports a party's case and (3) articulate a rationale in an opinion supporting the rationale without giving an opponent a reasonable chance to address the rationale.

We decline to abandon our role as impartial and unbiased judges to take on the role of an advocate on behalf of party Spalding, to analyze the evidence in the first instance to see how it may best be harnessed, interpreted, or characterized to establish the facts required to prove Spalding's assertions to the detriment of Hartsell. That is the role of Spalding's counsel, not the board.

Spalding's statement of relevant facts is also not sufficiently specific as to that which is necessary to establish the Bergamini paper as a printed publication. To constitute a printed publication under 35 U.S.C. § 102, a reference must at least have been sufficiently accessible to that part of the public which is concerned with the art of the reference to raise a presumption that that audience would know of its content. In re Bayer, 568 F.2d 1357, 1359, 196 USPQ 670, 674 (CCPA 1978). See also In re Cronyn, 890 F.2d 1158, 13 USPQ2d 1070, 1071-72 (Fed. Cir. 1989); In re Wyer, 655 F.2d 221, 226, 210 USPQ 790,

794 (CCPA 1981). In In re Hall, 781 F.2d 897, 899, 228 USPQ 453, 455 (Fed. Cir. 1986), the Court of Appeals for the Federal Circuit stated (citing In re Bayer):

The proponent of the publication bar must show that prior to the critical date the reference was sufficiently accessible, at least to the public interested in the art, so that such a one by examining the reference could make the invention without further research or experimentation.

Spalding's statement of material facts does not include sufficient assertions on the level of dissemination and accessibility to those in the public who may be interested in the subject of the Bergamini paper. For instance, it does not state the nature and business of the organization sponsoring each of the two meetings identified in Numbered Paragraph 3; it does not state the nature, purpose, or objective of any of the two meetings identified in Numbered Paragraph 3; it does not state who were invited to attend the two meetings identified in Numbered Paragraph 3; it does not state how the general public or professionals in the pertinent art were made to have advance notice of the time and nature of the two meetings identified in Numbered Paragraph 3; it does not state the paper distribution policy or mechanism of any of the organizations identified in Numbered Paragraph 3; it does not state the technical background or professional interest of any individual named in Numbered Paragraph 3 or of any participant who attended either one of the two meetings identified in Numbered Paragraph 3; it does not

state whether either meeting was open to any who desired to attend. According to Numbered Paragraphs 3 and 4, 17 people were sent or otherwise provided access to a copy of the Bergamini paper, but that alone is incapable of establishing sufficient accessibility to the Bergamini paper by those members of the public who would be interested in its contents.

In essence, Spalding is asking us to simply presume (1) that the public or at least those with an interest in the subject matter of the Bergamini paper had fair advance notice that something pertinent would be made available at the two meetings identified in Number Paragraph 3, and/or (2) that any of the organizations identified in Numbered Paragraph 3 had a paper cataloguing, distribution, or dissemination mechanism, that the Bergamini paper was accepted and processed by way of such a cataloguing, distribution, or dissemination mechanism, and that one with an interest in the subject of the Bergamini paper would have known to contact the organizations identified in Numbered Paragraph 3. We cannot presume any of the above. The individuals who attended the meetings might not have had any interest in the subject matter of the Bergamini paper, and the subject matter of the paper might not have had anything to do with the purpose or objective of the meetings identified in Spalding's Numbered Paragraph 3. Those with an interest in the subject of the Bergamini paper might not have been given notice

of the meetings or given permission to attend. Also, the organizations sponsoring the meetings might not have had any paper cataloging, distribution and dissemination policy or mechanism and might not have selected or processed the Bergamini paper for publication.

While no particular factor is always conclusive or even required for demonstrating that a reference constitutes a printed publication and each case must be decided on the basis of its own facts, see, e.g., In re Wyer, 210 USPQ 790, 795 (CCPA 1981), the wholesale lack of assertion by party Spalding of a plethora of pertinent subsidiary facts as discussed above renders Spalding's preliminary motion short of making out a prima facie basis for relief.

Part C1(b)(1) of the LeVeen v. Edwards, 57 USPQ2d at 1412, is reproduced below:

b.

Edwards also failed, in several respects, to follow the procedure set out in ¶ 26 of the NOTICE DECLARING INTERFERENCE.

(1)

Edwards did not set out the facts in the preliminary motion which would support the relief requested in its preliminary motion 1. Nine facts--identified as (1) through (9)--are set out in the statement of material facts. At best the facts establish that Edwards '597 and Edwards '267 are prior art under 35 U.S.C. § 102(e). Establishing that two "references" are prior art does not make out a case of anticipation or obviousness.

Edwards' effort totally sandbagged its opponent. An opponent is to admit or deny each fact set out in a motion so that the board may determine where there are disputed factual issues. See Paper 1, page 23, part (b)(2). LeVeen easily could have admitted the nine facts set out by Edwards and would not have conceded the preliminary motion. There is no place in interference practice for a party to require an opponent to (1) search the motion and evidence, (2) set out in an opposition the facts the opponent may believe that the party must prove to make out its case and (3) admit or deny those facts.

Like party LeVeen in LeVeen v. Edwards, Hartsell here easily can admit each of the twelve numbered facts contained in Spalding's preliminary motion 2 and the motion would still be deficient. There still will not be not enough facts for establishing the Bergamini paper as a printed publication. We reiterate here for emphasis what the board stated in the precedential decision of LeVeen v. Edwards:

There is no place in interference practice for a party to require an opponent to (1) search the motion and evidence, (2) set out in an opposition the facts the opponent may believe that the party must prove to make out its case and (3) admit or deny those facts.

Similarly, there is no place in interference practice for a moving party to shift the burden to the opponent of the motion to allege and prove facts which are necessary to establish the opposite of what the moving party needs to show entitlement for relief. The burden of proof always lies with the moving party seeking relief.

Spalding failed to sufficiently allege facts necessary for establishing entitlement to relief and also failed to articulate a sufficiently specific rationale based on such alleged facts. Like party Edwards did in LeVeen v. Edwards, party Spalding sandbagged its opponent.

For reasons discussed above, because Spalding has not made out a prima facie case that the Bergamini paper constitutes a "printed publication" within the meaning of 35 U.S.C. § 102, we need not reach the issue of whether the substance of the Bergamini paper anticipates Hartsell's claim 22 corresponding to Count 1 and Hartsell's claims 28 and 29 corresponding to Count 2.

Also because Spalding's preliminary motion 2 does not make out a prima facie case that Spalding is entitled to the relief requested, we need not consider Hartsell's opposition to Spalding's preliminary motion 2 or Spalding's reply to Hartsell's opposition to Spalding's preliminary motion 2.

Although Spalding's preliminary motion 2 has not explained why the prior art it has asserted against Hartsell is not applicable against Spalding, we will not hold Spalding's claims corresponding to the counts as unpatentable over the same prior art. If the Bergamini paper has not been regarded as a printed publication against Hartsell, it also should not be regarded as a printed publication against Spalding.

It should be noted, however, that in the context of that part of 37 CFR § 1.637(a) reproduced below, unless an explanation is provided by the moving party to the contrary, it would be presumed that the prior art asserted against the opponent's claim or claims also renders anticipated or obvious the moving party's own claim or claims corresponding to the same count:

If a party files a motion for judgment under § 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be **applicable** to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not **apply** to the party. (Emphasis added.)

The words "applicability" and "apply" refer not just to the date of the reference but also the technical merit of the reference against the moving party's own claims.

Spalding's preliminary motion 2 is **denied**.

Jameson Lee)	
Administrative Patent Judge)	
)	BOARD OF PATENT
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