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(For Patent Owner)

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(For Requester)

In re Ductmate Industries, Inc. :
Reexamination Proceeding :
Control No. 90/004,369 : DECISION ON PETITION
Filed: September 16, 1996 : REGARDING ORDER DENYING
For: U.S. Patent No. 4,584,756 : REQUEST FOR REEXAMINATION
Issued: April 29, 1986 :

Mez Industries, Inc. (hereinafter Requester), petitions pursuant to 37 CFR § 1.515(c) from the examiner's Order dated December 5, 1996 denying Requester's request for reexamination of United States Patent No. 4,584,756.

The petition is DENIED.

Basis for the Petition

Under 35 USC § 302, reexamination of any United States Patent may be requested on the basis of any prior art cited under the provisions of 35 USC § 301. Under 35 USC § 301, prior art is defined as consisting of patents or printed publications. The petition alleges that the examiner erred in refusing to order reexamination because Exhibits 1-4, which formed part of the basis for alleging that the request for reexamination presented a substantial new question of patentability, were not considered. The examiner held that Exhibits 1-4 were not patents or printed publications. The petition alleges that it was error to hold that Exhibits 1-4 are not patents or printed publications.

Standard of Review

Under the practice established at MPEP § 2248 to carry out the review of petitions filed

pursuant to 37 CFR § 1.515(c), the undersigned has reviewed the record *de novo*. Therefore, while the entire petition has been considered, a detailed analysis of the Statement of Facts presented therewith will not be repeated. Rather, the record has been independently analyzed and the status of Exhibits 1-4 has been carefully reviewed in light of the authorities presented in the petition. Although not specifically requested as part of the desired relief, the issue of whether a substantial new question of patentability is presented by the request for reexamination in the absence of Exhibits 1-4 has also been reviewed.

Documents in Question

Exhibit 1

The petition alleges that Exhibit 1 is, on its face, a catalog for marketing air duct components. A review of this document, together with a review of the uncertified English language translation of the document that accompanied the original request for reexamination as Exhibit 5 shows that the document states, on page 3 of the translation, that it is "catalog edition 475". It appears that the figure "475" has been changed in Exhibit 1 in writing; it originally read "275". Exhibit 5, page 3, also indicates that the document is a "Manufacturing Program" dealing with "Cold-rolled sections". Pages 6-34 of the Exhibit 5 translation illustrate various components or sections of air ducts. Pages 35-37 of the translation are entitled "Manufacturing and Delivery Program". The document does not, on its face, show a date of distribution, describe any indexing or cataloging of the document according to a retrieval system, explain who received or had access to the document, and indicate whether access to the document was restricted.

Exhibit 2

The petition alleges that Exhibit 2 is, on its face, a catalog for marketing air duct components. A review of this document, together with a review of the uncertified English language translation of the document that accompanied the original request for reexamination as Exhibit 6 shows that the document states, on page 38 of the translation, that it is entitled "This Section Matters!". The document illustrates various duct components and a duct made with the components. The document does not, on its face, show a date of distribution, describe any indexing or cataloging of the document according to a retrieval system, explain who received or had access to the document, and indicate whether access to the document was restricted.

Exhibit 3

The petition alleges that Exhibit 3 is the assembly instructions distributed with the sale of the actual air duct components. Exhibit 7 is the uncertified English language translation of Exhibit 3 which was submitted with the reexamination request. A review of this document shows that it is concerned with the "Layout of ducts with SMB frames", and contains illustrations of various components. Again, the document on its face does

not show a date of distribution or a date of any kind. There is also no showing of any indexing or cataloging of the document according to a retrieval system, or an explanation of who received or had access to the document, and whether access to the document was in any way restricted.

Exhibit 4

The petition alleges that Exhibit 4 is an engineering drawing that was provided to anyone who requested further information regarding "the 3514 corner piece". A review of this document and of the uncertified English language translation of this document which was submitted with the request for reexamination as Exhibit 8 shows that it is a drawing of a corner angle which bears various dates upon which changes to the original were made. These dates are in 1972 and 1973. The original drawing date appears to be 1971. The document, on its face, does not show any date of upon which the document was distributed, any indexing or cataloging of the document according to a retrieval system, explain who received or had access to the document, and indicate whether access to the document was in any way restricted.

Statement of Georg Mez

Filed as part of the request for reexamination is a document headed:

"Georg Mez, under penalty of perjury, declares:"

The document states that it was executed in Reutlinger on August 28, 1996 and is signed by Georg Mez. This document explains Exhibits 1-4 and supplies information concerning these documents which does not appear on the face of the documents. The petition appears to allege that this document is a verified document, but was improperly ignored by the examiner. A review of the document shows that it is not executed under oath, and certainly is not properly authenticated as required with respect to an oath executed abroad, it being noted that Reutlinger is a city in Germany. See MPEP §§ 602.04 and 604. The document lacks a verification clause under 35 USC § 25 and 37 CFR § 1.68.

Related Proceedings

The petition is accompanied by evidence showing that in each of reexamination proceedings 90/004,368, 90/004,370 and 90/004,371, a request for reexamination based in part upon documents identical to Exhibits 1-4 was granted. The petition alleges that in reaching a result in this reexamination proceeding different from the results reached in the other proceedings, the benefits of reexamination have been "negated".

Analysis of Documents

Exhibits 1-2

Requester has cited at least two authorities in support of the argument that the catalogs of Exhibits 1-2 are printed publications. None of the authorities is persuasive. While catalogs may, by their nature, be intended to be widely disseminated, the documents submitted as Exhibits 1 and 2 do not, on their face, show such dissemination. They do not show that access to these documents was unrestricted. They do not even clearly and unequivocally show publication dates. And they do not show that, in the absence of distribution, they were so indexed and catalogued that a person of ordinary skill in the art, interested in obtaining a copy, could have done so. *In re Hall*, 228 USPQ 453 (Fed. Cir. 1986); *In re Cronym*, 13 USPQ2d 1070 (Fed. Cir. 1989).

Requester argues on page 8 of the petition that these catalogs include a list inside the front cover of the distributors of these catalogs. However, Exhibits 5 and 6 do not expressly state or otherwise indicate that the addresses listed in the catalogs are distributors of the catalogs. Exhibit 5 contains no explanation of the list of addresses, and Exhibit 6 terms the list "illegible". The cases of *Deep Welding, Inc. v. Sciaky Brothers, Inc.*, 417 Fed.2d. 1227 (7th Cir. 1969) and *Jockmus v. Leviton*, 28 F.2d, 812 (2d Cir. 1928), relied upon by Requester with respect to the status of catalogs as publications, are in complete accord with the proposition that in order to qualify as a printed publication, a document must be publicly available, without restriction, to people of ordinary skill in the art seeking the information contained therein. However, in each of these cases, the documents in question were authenticated by witnesses at trial. For example, in *Jockmus*, the fact that the catalog was in fact distributed was established by the testimony of witnesses. In other words, to the extent that the documents did not display all of the necessary indica of public availability, without restriction, on their face, the testimony of witnesses at trial supplied this data.

Exhibits 3-4

Exhibits 3 and 4 suffer from the same defects as were discussed above with respect to Exhibits 1 and 2, save only that Exhibit 4 is clearly dated. However, there is simply no information on the face of these drawings which indicates that they were distributed, how extensive such distribution might have been, and whether any distribution which may have occurred was conditioned on confidentiality. Indeed, the dates on Exhibit 4 may well relate to the date the drawing was executed and to the dates it was thereafter modified, not necessarily to the date that the drawing was disseminated. The authorities cited by Requester with respect to these exhibits have been reviewed, but are not persuasive. The cases are all in agreement that in order to qualify as a printed publication, a document must have been disseminated without restriction, or else must have been freely available to members of the interested public seeking access thereto. Nothing in Exhibits 3 and 4 themselves can be taken as complying with these requirements, with the possible exception of the dates in Exhibit 4. And as noted, the

meaning of such dates is not indicated as being that the drawings were in any way distributed or disseminated on such dates. The arguments contained in the petition simply assume that the threshold level of distribution without restriction is established by the statement of Georg Mez, but in no way argues or establishes that the documents, themselves, qualify by their content as publications.

Statement of Georg Mez

Requester appears to regard the statement of Georg Mez as being a verified statement. Certainly, Requester appears to have been of the view that the statement of Georg Mez was required to be a verified statement, because the document purports to be a verified statement by reason of its heading which states that it is made "under penalty of perjury". Under 28 USC § 1746, a statement under penalty of perjury is acceptable in place of a sworn declaration or oath or affidavit if it is submitted in *substantially* the following form, (emphasis supplied):

[1] If executed without the United States:

"I declare (or certify, verify, or state) under penalty of perjury *under the laws of the United States of America* that the foregoing is true and correct. Executed on (date).

(Signature).

[2] If executed within the United States its territories, possessions or commonwealths:

"I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature)." (emphasis supplied)

Clearly, this document does not *substantially* comply with the form permitted under 28 USC § 1746. It omits any reference to the "laws of the United States of America". These very words are the words which Congress chose to require whenever a document was executed without the United States, as opposed to the language required for documents executed within the United States. Therefore, it cannot be contended that a statement signed in Germany which omits the words "under the laws of the United States of America" qualifies as a statement which is "substantially" in compliance with 28 USC § 1746. Had Congress felt the omitted words to be so unimportant, it would not have taken the trouble to require them specifically in statements executed abroad.

It appears, therefore, that the statement submitted by Georg Mez does not qualify as a verified statement under 28 USC § 1746. It is not a verified statement under 35 USC § 25 and is not a verified statement as an oath executed in the manner of an oath under 35 USC § 115 (when made in a foreign country, must appear before a diplomatic or consular office of the United States authorized to administer oaths, etc.).

The general rule is that administrative agencies are not bound by the rules of evidence which govern judicial proceedings, *In re Epstein*, 31 USPQ2d 1817 (Fed. Cir. 1994). Agencies may provide for the application of evidence rules, as the Office has done in certain *inter partes* proceedings. *Id.* No specific evidentiary rule has been promulgated with respect to the quality of evidence received during the initial phase of a reexamination proceeding. By its nature, reexamination during the period prior to the beginning of *ex parte* examination under 37 CFR § 1.550(a) can be considered to be *inter partes* in that limited participation by a "third party" Requester is permitted, 37 CFR §§ 1.510, 1.515 and 1.535. It is noted that reexamination is specifically required to be conducted in a manner similar to that in which other *ex parte* "examinations" are conducted, 37 CFR § 1.550(a), following the period in which the granting or denying of the order to reexamination takes place. It is logical that prior to the commencement of the *ex parte* stage of reexamination, the evidence submitted in the reexamination proceeding should be treated in a manner analogous to the manner in which evidence is treated during other Office *inter partes* proceedings. Therefore, it is believed that evidence should be submitted in a manner analogous to the manner in which evidence is received in proceedings such as interferences and public use proceedings. Pursuant to 37 CFR §§ 1.292(a) and 1.671(b), statements of individuals in these proceedings would have to be verified statements. Even with respect to *ex parte* examinations conducted pursuant to 37 CFR §§ 1.104-119, evidence such as a statement submitted by an individual with respect to the status of a document as "prior art", or a statement submitted to establish other relevant factual matters relating to "prior art" such as inoperability of a device described in a document, must be verified statements. 37 CFR §§ 1.131 and 1.132; MPEP §§ 715 and 716.

In light of these considerations, the statement of Georg Mez, which is not a verified statement, is entitled to no weight. The various allegations contained within the document are simply unverified hearsay. In addition, a careful reading of the statement by Georg Mez shows that Mr. Mez only alleges personal familiarity with the dissemination, without restriction, of Exhibit 4. As to Exhibits 1-3, no allegation of personal familiarity therewith is made on "personal knowledge" in the manner that Mr. Mez sets forth in paragraph 11 of his statement. No allegation as to the unrestricted access to Exhibits 1-3 is made, only that they were "widely disseminated". It would be fundamentally unfair to require Patent Owner to attempt to rebut allegations of this sort in order to defend an issued patent when the allegations are not contained within a verified statement. And the fact that Exhibits 5-8 are not themselves certified translations provides an additional reason for precluding reliance upon an unverified statement by an individual with respect to the meaning and content of Exhibits 1-4.

Other Documents

The reexamination request also refers to a United States patent 4,123,094 to Smitka and to United States patent 4,508,376 to Arnoldt as raising a substantial new question of patentability. The Smitka patent is not alleged to raise a substantial new question of patentability apart from Exhibits 1-4, and was of record during prosecution of United

States patent 4,584,756. A review of the record of the reexamination file and of the patented file fails to establish that a substantial new ground of patentability is raised by the Smitka document considered alone. The Arnoldt patent is said to form the basis of "obvious type double patenting". This ground of rejection is normally not considered as being a rejection based upon "prior art", see MPEP § 2217, but assuming, *arguendo*, that it had some application here, it appears that Patent Owner has filed an appropriate terminal disclaimer so as to obviate any potential obvious type double patenting rejection based upon the Arnoldt patent.

Related Proceedings

The treatment of the reexamination requests in other reexamination proceedings is not controlling on this proceeding, and does not establish that Requester is entitled to identical treatment in this proceeding. It is noted that nothing precludes Requester from again requesting reexamination of the Arnoldt 4,584,756 patent, provided that any new request for reexamination relies upon properly established printed publications.

Conclusion

The reexamination request fails to raise a substantial new question of patentability. To the extent that it is based upon the Smitka patent *per se*, this document was considered during the prosecution of the original patent and raises no issue not cumulative to the issues considered during that prosecution. The Arnoldt '376 patent clearly fails to raise a substantial new question of patentability because any argument concerning obvious type double patenting raised by the reexamination request based upon this patent has been undercut by the filing of a terminal disclaimer which disclaims the terminal portion of Arnoldt patent 4,584,756 with respect to Arnoldt '376. Exhibits 1-4, considered in light of the uncertified translations thereof embodied in Exhibits 5-8, do not qualify as printed publications, and therefore are not considered to be prior art within the meaning of 35 USC §§ 301 and 302. Therefore, they are not available for consideration with the Smitka patent and can not raise a substantial new question of patentability taken therewith. Exhibits 1-3 simply do not, on their face, establish definite publication dates, do not show that the documents were in fact disseminated, do not show that access thereto was unrestricted even if dissemination is presumed, and do not evidence cataloging or indexing so that interested members of the public could readily secure unrestricted access thereto. Exhibit 4 does evidence, on its face, certain dates, which may or may not be dates of availability, but lacks all other indicia of publication such as dissemination without restriction on access, or cataloging or indexing so that the public could otherwise secure unrestricted access thereto in the absence of dissemination. The statement of Georg Mez is clearly not a verified statement, and is entitled to no weight in supplying this data with respect to Exhibits 1-4. It does ^{not} cure any of the defects in Exhibits 1-4 so as to elevate these documents to the status of publications. The contrary holdings of the Primary Examiner in other reexamination proceedings based upon submissions identical to, or similar to, the submission which accompanied the

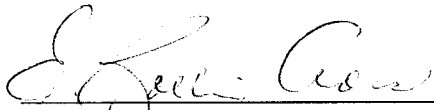
reexamination request in this proceeding was not controlling on the decision of the the Primary Examiner in this proceeding, and are not controlling upon the undersigned in reaching a decision herein. The benefits of reexamination have not been "negated" by the result reached in this decision, but can be secured, if they are in fact available to Requester, upon submission of a reexamination request which relies upon patents and printed publications and is otherwise in compliance with the relevant statutes and regulations.

Decision

The petition fails to establish that a substantial new question of patentability was presented by the prior art submitted with the request for reexamination. The petition clearly fails to establish that Exhibits 1-4 represent patents or printed publications, and therefore fails to establish that Exhibits 1-4 qualify as prior art. The reexamination file is being forwarded for a refund pursuant to 37 CFR § 1.26(c), and will thereafter be endorsed as "Terminated".

The petition is DENIED.

This decision is final and nonappealable. 37 CFR § 1.515(c). No further communication on this matter will be acknowledged or considered.



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