

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EARL N. PHILLIPS, RICHARD E. FORKEY
and BRIAN E. VOLK
Junior Party¹

v.

R. CALVIN OWEN, JR., ROBERT A. GALLAGHER,
ROBERT M. BURLEY, DECEASED BY FLORENCE BURLEY, EXECUTRIX;
JULIET E. BURLEY-MASON, EXECUTRIX
Senior Party²

Interference No. 103,357

HEARD: October 22, 1998

¹ Application Serial No. 07/811,836, filed December 20, 1991, now U.S. Patent No. 5,157,553, issued October 20, 1992.

² Application Serial No. 08/017,875, filed February 16, 1993. Accorded benefit of Serial No. 07/803,036 filed December 6, 1991, now Patent No. 5,204,774, issued April 20, 1993.

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Before URYNOWICZ, PATE and MARTIN, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658

The invention at issue in this interference relates to a corrector lens assembly for reducing axial chromatic aberrations. The particular subject matter in issue is illustrated by count 1, the sole count, as follows:

Count 1

In an optical device having an optical arrangement that creates known axial chromatic aberrations in light of a desired spectral range, a corrector lens assembly for reducing said axial chromatic aberrations, comprising:

a plurality of lens elements having dissimilar refractive properties and having given dimensions, said lens elements arranged along an optical axis with said lens elements being substantially afocal for wavelengths of light in a mid-region of said spectral range, whereby light in said region entering said lens elements emerges from said lens elements in a substantially parallel direction, while wavelengths of light other than in said mid-region are refracted, in such a manner, to counteract said axial chromatic aberrations.

The claims of the parties which correspond to this count are:

Phillips et al. (Phillips) : Claims 1-3 and 7-11

Owen, Jr., et al. (Owen) : Claims 38-45

U.S. patent 5,157,553 to Phillips ('553 patent) issued October 20, 1992. On June 14, 1993, Owen added claims 38-45 to its involved application S.N. 08/017,875 ('875 application) to provoke an interference with Phillips. This proceeding was declared on April 21,

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1994 with count 1. At that time, Owen was accorded senior party status on the basis of the December 6, 1991 filing date of prior U.S. application S.N. 07/803,036, now U.S. Patent 5,204,774 ('774 patent).

On September 21, 1994, the Administrative Patent Judge (APJ) rendered a decision on preliminary motions. In that decision, a motion of Phillips under 37 CFR § 1.633(a) for judgment against the party Owen on the grounds of unpatentability of all of its involved claims based on a lack of written description under 35 U.S.C. § 112, first paragraph, was granted, and a motion of Phillips under 37 CFR § 1.633(a) for judgment on the grounds of unpatentability based on a failure of Owen to disclose its best mode of practicing the invention under 35 U.S.C. § 112, first paragraph, was denied.

In view of the finding of unpatentability of all of Owen's corresponding claims, notice was given pursuant to the provisions of 37 CFR § 1.640(d) that judgment on the record as to those claims will be entered against the senior party Owen unless it shall show cause why such action should not be taken. In response, Owen requested final hearing to review the grant of Phillips' motion under 37 CFR § 1.633(a) for judgment on the ground that the senior party's involved claims are unpatentable to it under 35 U.S.C. § 112, first paragraph, due to lack of written description of the invention in its involved application. The request of Owen was granted. However, a motion of Owen requesting a testimony period with respect to the decision on the granted motion was denied.

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Neither party took testimony. Both parties filed briefs and appeared for oral argument at final hearing.

The Issues

The issues to be decided at final hearing are:

1. Whether the APJ's decision denying the request of Owen for additional testimony at final hearing was an abuse of discretion. 37 CFR § 1.655(a).
2. Whether the APJ's decision granting Phillips' motion for judgment was an abuse of discretion. 37 CFR § 1.655(a).

Owen's Position

As to the issue of whether Owen should have been granted a testimony period within which to take testimony in response to the order to show cause, Owen contends that there is no requirement that a party seek testimony on every preliminary motion in order to preserve the right to take testimony in the event an order to show cause issues.³ The junior party argues that the rules provide for a testimony period at final hearing without qualification. It is urged that neither of the two cases relied on in support of the denial of a testimony period are controlling because neither involved an order to show cause and the express provisions specified in the

³ Although this issue is rendered moot by our decision herein with respect to the issue involving Owen's alleged non-compliance with 35 U.S.C. § 112, first paragraph, we have decided the matter for purposes of completeness.

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rules for testimony in response to an order to show cause.⁴

With respect to the issue of written description, the senior party argues that it was wrong for the APJ to hold that there is no disclosure in Owen's '875 application for the lens elements being substantially afocal for wavelengths of light in a mid-region of a desired spectral range as required by the claims corresponding to the count. Owen states that the '875 application discloses that the lens assemblies are achromatized for the colors green and yellow and that these colors lie in the middle of the visible color spectrum, and thus the mid-region of a spectral range. The senior party states that the '875 application also discloses that the optical power of the lens assemblies is preferably 0, but may range from approximately -0.05 to +0.05, thus providing support for the substantially afocal limitation specified in the claims corresponding to the count.

Phillips' Position

The junior party contends that the APJ properly denied the request of Owen for a testimony period to introduce new evidence at final hearing because good cause was not established by Owen in its request as to why a testimony period should be set. 37 CFR § 1.651(c)(4).

With respect to the issue of the senior party's written description, Phillips contends

⁴ These cases are Okada v. Hitotsumachi, 16 USPQ2d 1789 (Com'r Pat. 1990) and Hanagan v. Kimura, 16 USPQ2d 1791 (Com'r Pat. 1990).

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that the Board should not be misled by the senior party's brief, which states that the colors green and yellow discussed in the Owen specification lie in the middle of the visible color spectrum, and thus the mid-region of a spectral range. Phillips charges that the senior party's application makes no disclosure as to how or why the lens assemblies should be afocal in the mid-region of a particular spectral range.

Phillips argues that the Owen disclosure that "the lens assemblies are preferably achromatized for the colors green and yellow" is ambiguous because the entire image being viewed is green. The junior party charges that this language can be interpreted as teaching that the lens assembly is achromatized for the entire image, and that this contradicts the wording of the count that calls for lens elements being substantially afocal for wavelengths of light only in a mid-region of a spectral range.

Phillips contends that the specification of Owen is deficient because it does not describe lens materials, spaces and curvatures.

Opinion

Owen's Request for Additional Testimony:

We are of the opinion that Owen has not established an abuse of discretion on the part of the APJ who denied its request for additional testimony. The senior party's position that the rules expressly provide for a testimony period in response to an order to show cause without

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qualification is not well-taken. Under 37 CFR § 1.651(c), four circumstances are listed under which a party is entitled to take testimony at final hearing. Unless one of the four situations is satisfied, a party is not entitled to take testimony. Owen has not carried its burden of establishing that it satisfied one of the four conditions of the rule.

That the two cases relied on by the APJ may not have involved an order to show cause is not controlling. Both cases are relied on for the proposition that a party filing a motion for testimony with respect to a matter raised in a preliminary motion after the close of the preliminary motion period must, in order to meet the good cause requirement of 37 CFR § 1.651(c)(4), show that evidence it intends to present was unavailable at the time it filed its preliminary motion or opposition.

Owen's Written Description:

We are of the opinion that the interlocutory order granting Phillips' motion for judgment on the ground that Owen's claims corresponding to the count are not patentable to Owen for lack of a written description of the invention under 35 U.S.C. § 112, first paragraph, constitutes an abuse of discretion. Phillips provided no evidence with its motion charging that the Owen specification does not contain a written description of the invention, and the manner and process of making it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, in support of its argument. Thus, the decision granting Phillips' motion was based on

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attorney argument alone. However, it is well settled that argument of counsel cannot take the place of evidence lacking in the record. Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977). A party moving under 37 CFR § 1.633(a) for judgment on the ground that an opponent's claims corresponding to the count lack written description support in its involved application has the burden of submitting with the motion proof which prima facie establishes that the limitation in question lacks either express or inherent support in the involved application. Behr v. Talbott, 27 USPQ2d 1401, 1407 (Bd. Pat. App. & Int. 1992). Accordingly, the APJ's decision granting Phillips' preliminary motion for judgment is reversed for lack of any evidence.

Priority:

At the oral hearing of October 22, 1998, counsel for the junior party stated to the effect that Phillips has chosen not to raise priority of invention as an issue in this proceeding. Whereas 1.) the junior party Phillips has chosen not to contest priority of invention, 2.) the application of Owen has not been shown by Phillips not to be in compliance with 35 U.S.C. § 112, first paragraph, and 3.) the party Owen enjoys senior party status, Owen is entitled to prevail herein as the prior inventor.

Judgment

Judgment as to the subject matter of count 1, the sole count, is awarded to R. Calvin Owen, Jr., Robert A. Gallagher and Robert M. Burley, the senior party. On the present

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record, the party Owen is entitled to a patent with claims 38-45. The party Phillips is not entitled to its patent with claims 1-3 and 7-11.

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