

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 54

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ARTHUR W. ELLSWORTH,

Junior Party,
(Application 09/123,917),

v.

JOHN CLINTON MOORE and ARTHUR W. ELLSWORTH,

Senior Party
(Patent 5,791,265).

Patent Interference No. 104,528

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

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
(Final decision)

A. Introduction

This interference involves an inventorship dispute between

- (1) Arthur W. Ellsworth (**Ellsworth**) and
- (2) John Clinton Moore (**Moore**) and Ellsworth.

Ellsworth and Moore applied for, and received, a patent. Ellsworth and Moore U.S. Patent 5,791,265 (11 August 1998). Prior to the time the patent was granted, Ellsworth

apparently had a change of heart, and now believes that he alone should have been named as the sole inventor in the patent. After unsuccessfully attempting to have the Patent and Trademark Office (PTO) delete Moore as an inventor from the Ellsworth and Moore application while it was pending, Ellsworth then filed a patent application containing essentially the same disclosure and claims as the Ellsworth and Moore application. Ellsworth Application 09/123,917 (filed 28 July 1998). Ellsworth named himself sole inventor. An interference has been declared to establish inventorship.¹

The interference is before a panel for entry of a final decision.

B. The admissible evidence²

The admissible evidence in this interference consists of:

1. The specification, including claims and drawings, of the Ellsworth application involved in the interference.
2. The specification, including claims and drawings of the Ellsworth and Moore patent involved in the interference.
3. A declaration of Arthur W. Ellsworth, dated "6/18/1999" (which we take to mean 18 June 1999) (Ex 2001),
4. A declaration of Dennis Grudt, dated "11 17 99" (which we take to mean 17 November 1999) (Ex 2003).
5. A declaration of Robert Fujioka, dated 21 October 1999 (Ex 2002).
6. A declaration signed by Ellsworth and a declaration signed by Moore in the Ellsworth and Moore patent filed, mentioned in Finding 2 of our

¹ This interference is not a typical interference where a party seeks to establish priority of invention vis-a-vis an opponent who may have independently made a patentable invention. Rather, the interference is an inventorship contest. See Chou v. University of Chicago, 254 F.3d 1347, 1358 n.2, 59 USPQ2d 1257, 1262 n.2 (Fed. Cir. 2001) (a means for a putative inventor to assert inventorship rights is to file a patent application and seek to have the PTO declare an interference in order to establish inventorship); Linkow v. Linkow and Edelman, 517 F.2d 1165, 186 USPQ 223 (CCPA 1975).

² The parties were advised of the admissible evidence in our MEMORANDUM OPINION and ORDER entered 24 September 2001 (Paper 51).

MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).

7. The claims of the Ellsworth and Moore application, as filed. See Finding 4 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
8. The examiner's rejection (Paper 2 in the Ellsworth and Moore patent file) mentioned in Finding 5 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
9. The response (Paper 3 in the Ellsworth and Moore patent file) mentioned in Finding 6 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
10. The supplemental amendment (Paper 4 in the Ellsworth and Moore patent file) mentioned in Finding 8 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
11. The paper indicating the date an issue fee was paid in the Ellsworth and Moore application mentioned in Finding 11 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
12. The document styled "Correction of Inventorship" (Paper 11 in the Ellsworth and Moore patent file) mentioned in Finding 12 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
13. The declaration (attachment to Paper 11 in the Ellsworth and Moore patent file) mentioned in Finding 13 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).

14. The "Decision Dismissing Petition" (Paper 12 in the Ellsworth and Moore patent file) mentioned in Finding 15 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).
15. The "Request for Interference" (Paper A accompanying the Ellsworth application, as filed) mentioned in Finding 19 of our MEMORANDUM OPINION and ORDER entered 13 September 2001 (Paper 49).

C. Findings of fact

The record supports the following findings by at least a preponderance of the evidence.³

Ellsworth and Moore application

1. Ellsworth and Moore filed application 08/655,419 on 30 May 1996.
2. In connection with the Ellsworth and Moore application, both Ellsworth and Moore signed separate declarations. In those declarations, both state that both Ellsworth and Moore are joint inventors.
3. According to the Ellsworth and Moore application, "[t]he present invention relates generally to a space system such as for accommodating document files, books, business equipment, computer equipment *** and any number of other general miscellaneous items typically found in an office, or room in a home ****" (specification, page 1). Further according to the application, the "system includes different sized modules that can be selectively intermounted to one another in order to conform to available room space" (id.).
4. As filed, the Ellsworth and Moore application contained claims 1-15.
5. An examiner rejected claims 1-15.
6. Ellsworth and Moore filed a response to the examiner's rejection, including amendments to the claims.
7. As a result of the response, the claims became claims 6, 13 and 16-18.

³ To the extent these findings of fact discuss legal issues, they may be treated as conclusions of law.

8. In due course, Ellsworth and Moore filed a supplemental amendment.

9. By virtue of the supplemental amendment, Ellsworth and Moore cancelled claims 6, 13 and 16-18 and substituted in their place claims 19-34.

10. Claims 19-34 became claims 1-15 of the Ellsworth and Moore patent. See 37 CFR § 1.126 (examiner to renumber claims upon allowance of application).

11. An issue fee was timely paid.

12. On 8 June 1998, the PTO received from Ellsworth a document styled "Correction of Inventorship," in which Ellsworth sought to delete Moore as a named inventor. Moore did not join in the Ellsworth request for correction of inventorship.

13. In a declaration of Ellsworth accompanying the "Correction of Inventorship," Ellsworth makes at least the following representations:

- a. At the time the Ellsworth and Moore application was filed, Ellsworth "was of the opinion" that Moore was a coinventor.
- b. Ellsworth alleges that he reviewed "the various changes in the [Ellsworth and Moore] [a]pplication claims that have been made to place them in allowable form."
- c. Based on his review of the claims, as allowed by the examiner, Ellsworth reached a conclusion that he was the "sole inventor of the invention as defined by the [a]llowed [c]laims and that *** Moore is not an inventor of the invention so defined by these claims.

14. In his declaration, Ellsworth does not explain the underlying factual basis for the conclusion he says he reached. For example, Ellsworth does not explain what limitation(s) added to, or deleted from, the original claims caused him to arrive at his conclusion that he is a sole inventor.

15. The Ellsworth request to delete Moore as a joint inventor was denied in a "Decision Dismissing Petition" inter alia on the ground that Moore had not joined in the request.

16. Ellsworth and Moore Patent 5,791,265 issued on 11 August 1998.

The Ellsworth application

17. Ellsworth filed application 09/123,917 on 28 July 1998.

18. The Ellsworth application contains claims 1-15, which are essentially identical to claims 1-15 of the Ellsworth and Moore patent. According to Ellsworth, the Ellsworth and Moore patent claims and the Ellsworth application claims "for all practical purposes are identical" (Paper 44, page 2).

19. In due course, Ellsworth presented a request for an interference accompanied by a showing under 37 CFR § 1.608(b) [Rule 608(b)].

20. In filing the Ellsworth application, Ellsworth did not claim benefit under 35 U.S.C. § 120 of the filing date of the Ellsworth and Moore application.

The interference proceedings

21. The interference was declared on 14 April 2000 (Paper 1), with 15 counts, one for each of the 15 claims of the Ellsworth and Moore patent and the 15 claims of the Ellsworth application.

22. In a "Memorandum Opinion and Order" (Paper 2) accompanying the "Notice Declaring Interference" (Paper 1), several issues were raised.

23. One of those issues was whether Ellsworth is entitled to claim benefit under 35 U.S.C. § 120 of the filing date of the Ellsworth and Moore application (Paper 2, page 9).

24. It was also noted that "if it was necessary in the first place, the Ellsworth Rule 608(b) showing is deemed to be sufficient"⁴ (Paper 2, page 11).

⁴ As will appear, infra, part of the statement turns out to have been a poor choice of words.

25. It was suggested that if Moore and Ellsworth jointly conceived the subject matter of any one of the inventions defined by claims 1-15 of the Ellsworth and Moore patent, that Moore should be deemed to have been properly named as joint inventor on the Ellsworth and Moore patent.⁵

26. In due course, Ellsworth filed a miscellaneous motion (37 CFR § 1.635) seeking to be accorded the benefit of the filing date of the Ellsworth and Moore application (Paper 13).

27. The motion was granted (Paper 16, page 1).

28. After the motion was granted, Ellsworth became entitled to a priority benefit date which is the same as the filing date to which Moore is entitled. Moore is senior party because the filing date of the application which matured into the Ellsworth and Moore patent, 30 May 1996, is prior to the filing date of the Ellsworth application, 28 July 1998. See 37 CFR § 1.601(m).

29. Times for taking action in the interference, including a time to present evidence, a record and briefs, were established in the interference (Paper 12, pages 7-10).

30. Those times expired without any record or briefs having been filed.

31. On 16 May 2001, a motions panel of the board entered an order against Ellsworth to show cause why judgment should not be entered against him (Paper 41).

32. On 1 June 2001, a further order was entered in which times were set for filing a record and briefs (Paper 43).

33. The record, consisting of the three Rule 608(b) declarations, was thereafter timely filed.

34. Ellsworth timely filed an opening brief (Paper 44).

35. Moore timely filed an opposition brief (Paper 47).

⁵ As will become apparent, infra, the suggestion does not accurately suggest the proper issue for resolution in this interference.

36. Following a review of the Ellsworth (Paper 44) and Moore (Paper 47) briefs, the motions panel became concerned over whether the parties understood what evidence would be considered by the board (Paper 49, page 2, second full paragraph). Findings of fact were made, some of which were based on documents which had not been offered in evidence by the parties (Paper 49, pages 4-9, see Findings 1-31). A decision was entered giving the parties an opportunity to supplement the evidence.

37. On 18 September 2001, Ellsworth filed a request for reconsideration (Paper 50).

38. The Ellsworth request for reconsideration was denied on 24 September 2001 (Paper 51).

39. On 27 September 2001, Ellsworth filed a second request for reconsideration (Paper 52).

40. The second request for reconsideration was returned as being an unauthorized paper inasmuch as the board had not granted leave to file a second request for reconsideration (Paper 53, pages 2-3, Part II).

41. During a conference call on 28 September 2001, counsel indicated to the board that neither party would be filing additional evidence (Paper 53, page 2).

42. On 1 October 2001, an order (Paper 53) was entered advising the parties of the documentary evidence which had been admitted in evidence and which would be considered by the motions panel (Paper 53, pages 3-4, Part III, items 1-15).

43. In an effort to allow the parties to comment on the evidence which had been admitted, and would be considered by a merits panel in entering a final decision, the parties were given an opportunity to file further briefs (Paper 53, page 5, Part IV). Ellsworth was given until 12 October 2001; Moore was given until 19 October 2001. Neither party accepted the board's invitation for supplemental briefing.

Merits findings

Critical date

44. In this interference, Ellsworth must establish a corroborated conception of the invention of each of Counts 1-15 prior to the filing date of the Ellsworth and Moore patent application, which is 30 May 1996.⁶

45. The critical date, for purpose of establishing sole conception, is therefore 30 May 1996.

Declaration testimony of Ellsworth

46. Before reaching the declaration testimony of Ellsworth, we learn from declaration testimony of Dennis Grudt, infra, that Ellsworth was the "principal founder and owner" of an entity known as Design West of Mission Viejo, California (Ex 2003, ¶ 5).

47. Ellsworth believes that he is the inventor of the subject matter claimed in the Ellsworth and Moore patent (Ex 2001, ¶ 2).

48. Ellsworth says that, on 20 December 1995, he prepared a "conception for a so-called 'step back' frame as shown in" Figs. 8, 9 and 10 of the Ellsworth and Moore patent (Ex 2001, ¶ 3 and Attachment A).

49. Ellsworth further says that, on 7 February 1996, he prepared another drawing of the so-called step back frame (Ex 2001, ¶ 3 and Attachment B).

50. Prior to 30 May 1996, Ellsworth says a photograph (Ex 2001, Attachment C) was "taken of a prototype construction of my invention made solely at my direction and my specifications ***" (Ex 2001, ¶ 4). See also Attachment C and compare with Fig. 18 of the Ellsworth and Moore patent.

51. Ellsworth does not testify as to who took the photograph.

⁶ Since this is a "who made the invention" interference, there is no issue with respect to an actual reduction to practice and/or possible diligence.

52. Ellsworth also testified with respect to other drawings and sketches which he says represent his conception (Ex 2001, ¶¶ 5-8).

53. Ellsworth does not testify as to what involvement, if any, Moore had with Design West.

54. Ellsworth does not testify as to what involvement Moore had with respect to making the originally claimed invention of the Ellsworth and Moore application. Nor does Ellsworth testify as to any contribution made by Moore with respect to that claimed invention.

55. However, in a DECLARATION OF ARTHUR W. ELLSWORTH (Attachment to Paper 12 in the Ellsworth and Moore patent file), dated 5 June 1998, Ellsworth testifies that at the time the Ellsworth and Moore application "was originally filed ***, I was of the opinion that *** Moore was a coinventor and, accordingly, the [a]pplication was filed with both of us named as coinventors (¶ 2).

56. Ellsworth goes on to testify that sometime after the examiner issued a notice of allowance, he had several times carefully reviewed "the various changes in the *** claims that have been made to place them in allowable form ***" (¶ 4).

57. Ellsworth then represented to the PTO that, based on his review of the Ellsworth and Moore application claims, as allowed by the examiner, "I conclude that I am the sole inventor of the invention as defined by the [a]llowed [c]laims and that *** More is not an inventor of the invention so defined by these claims" (¶ 5).

58. Despite being given an opportunity to do so in this interference, Ellsworth has declined to reveal to the board precisely what amendment(s) to what claim(s) caused him to have a change of heart with respect to inventorship or how any amendment(s) resulted in claims which no longer cover subject matter to which Moore made a contribution.

Declaration testimony of Gundt

59. The declaration testimony of Dennis Grudt (Ex 2003) was offered by Ellsworth.

60. As of November 1999, Grudt states that he has known Ellsworth for over 20 years (Ex 2003, ¶ 3).

61. According to Grudt, and as noted earlier, Ellsworth was the "principal founder and owner" of Design West located in Mission Viejo, California (Ex 2003, ¶ 5).

62. Grudt was employed by Design West from October 1993 until June 1998.

63. Grudt reviewed the Ellsworth declaration testimony, and the attachments to that declaration testimony, and according to Grudt "the 'SPACE SYSTEM' disclosed and depicted therein [, i.e., the Ellsworth and Moore patent,] was conceived, developed and designed at Design West by and under the direction of Ellsworth" (Ex 2003, ¶ 6).

64. Grudt does not state whether he believes the invention "disclosed and depicted therein" is the invention defined by the claims of the Ellsworth and Moore patent.

65. Grudt states that he recognizes the prototype shown in the photograph (Ex 2001, Attachment C) as having been built at Design West sometime prior to 30 May 1996 (Ex 2003, ¶ 7).

66. Grudt also states that he remembers seeing and manipulating other "step back" frames at Design West prior to 30 May 1996.

67. Grudt does not state whether he knows Moore, or what relationship, if any, Moore may have had with Design West or Ellsworth.

Declaration testimony of Fujioka

68. The declaration testimony (Ex 2002) of Robert Fujioka was offered by Ellsworth.

69. As of 21 October 1999, Fujioka states that he has known Ellsworth for over 30 years and that he had worked with Ellsworth on a continuous basis for over 30 years "in the field of conceiving, designing and developing inventions to a practical commercial state" (Ex 2002, ¶ 2).

70. Fujioka tells us that he and Ellsworth were the "principal founders and owners at all times pertinent" of Design West located in Mission Viejo, California (Ex 2002, ¶ 4).

71. Fujioka reviewed the Ellsworth declaration testimony, and the attachments to that declaration testimony, and according to Fujioka "the 'SPACE SYSTEM' disclosed and depicted therein [i.e., in the Ellsworth and Moore patent,] was conceived, developed and designed at Design West solely by Ellsworth" (Ex 2002, ¶ 5).

72. Fujioka does not state whether he believes the invention "disclosed and depicted therein" is the invention defined by the claims of the Ellsworth and Moore patent.

73. Fujioka states that he recognizes the prototype shown in the photograph (Ex 2001, Attachment C) as having been built at Design West sometime prior to 30 May 1996 (Ex 2002, ¶ 6).

74. Fujioka also states that he remembers seeing and manipulating other "step back" frames at Design West prior to 30 May 1996 (Ex 2002, ¶¶ 7-12).

75. Although unable to "confirm precise dates for the frames of *** [Attachments] A and B [of Ex 2001]," he recalls that he "first saw and assembled them sometime in early 1996" (Ex 2002, ¶ 10).

76. Fujioka does not state whether he knows Moore, or what relationship, if any, Moore may have had with Design West or Ellsworth.

D. Discussion

1.

The issue in this case is whether Ellsworth has established by a preponderance of the evidence that he alone conceived the invention defined by Counts 1-15 (alternatively claims 1-15 of the Ellsworth and Moore patent).

There is a presumption that the inventorship identified in an application or a patent is correct. Acromed Corp. v. Sofamor Danek Group, Inc., 253 F.3d 1371, 1379, 59 USPQ2d 1130, 1135 (Fed. Cir. 2001) (the inventors named in a patent are presumed to be the true and only inventors); Brown v. Edeler, 110 F.2d 858, 861, 45 USPQ 181, 184 (CCPA 1940) (an application in due form made by two or more persons claiming to be joint inventors is prima facie evidence that they are joint inventors; burden is on opponent to prove by a preponderance of the evidence otherwise); Hamer v. White, 143 F.2d 987, 991, 62 USPQ 285, 288 (CCPA 1944) (same-- quoting former Board of Patent Interferences). In this "interference" proceeding, Ellsworth bears the burden under the preponderance of the evidence standard. Linkow v. Linkow and Edelman, 517 F.2d 1370, 1373, 186 USPQ 223, 225 (CCPA 1975); Brown v. Edeler, supra.

2.

At one time, Ellsworth believed that he was a joint inventor with Moore. Apparently based on his review and construction of the claims⁷ in the Ellsworth and Moore patent as issued, Ellsworth has changed his mind. The facts, as set out above, suggest that it was an amendment or amendments which constitute the underlying basis for Ellsworth's change of heart.

We can agree in the abstract that a change in the scope of a claim can result in a need to change inventorship, particularly given 35 U.S.C. § 116 which does not require that all named inventors have contributed to the conception of all elements in all claims. However, any time an inventor--particularly in a contested case--has a change of heart about inventorship, the inventor's credibility necessarily becomes an issue.

The board, not the parties, resolves credibility issues. Even if it is assumed that the apparatus shown in the photograph referred to in the Ellsworth declaration testimony (Ex 2001, Attachment C) is an apparatus within the scope of each of Counts 1-15 or claims 1-15 of the

⁷ We will note that construction of the scope of a claim is an issue of law. It is not at all apparent to us that Ellsworth is qualified to testify on an issue of law.

Ellsworth and Moore patent,⁸ Ellsworth has not explained factually (1) what Moore had to do with the invention as originally claimed and (2) what limitation has been added or eliminated from the original claims which could legitimately cause Ellsworth's change of heart.⁹ At the present time, the board is faced with a situation where Ellsworth has taken arguably inconsistent positions and we are in no position to resolve which of Ellsworth's positions, if any, is more likely to be the correct position. There is as much reason to assume that Ellsworth's original joint declaration is accurate as there is to assume that Ellsworth's later-filed sole declaration is accurate. Ellsworth has the burden of proof by a preponderance of the evidence. However, because Ellsworth has declined our invitation to explain his change of heart, in this case a preponderance does not emerge.¹⁰

In this respect, we note that Grudt and Fujioka in their declaration testimony likewise did not acknowledge the presence of Moore anywhere in the picture. But, surely Moore at one time was involved in some way. Ellsworth has admitted as much when he signed the declaration of the Ellsworth and Moore application. What is it that Ellsworth at one time believed Moore contributed to the conception of the invention? We believe some explanation is required on this record because in his brief, Ellsworth now states without explanation that "the disclosure of the patent and application was the conception of Ellsworth" (emphasis in original). An allegation that the subject matter of the disclosure of the patent is the sole conception of Ellsworth is manifestly inconsistent with Ellsworth having signed a declaration alleging joint inventorship.

Ellsworth places heavy reliance on the Fujioka declaration, noting that Fujioka is a non-party (Paper 44, page 5). According to Ellsworth, Fujioka's testimony that the device "disclosed

⁸ See Part 3, *infra*.

⁹ As noted by Moore (Paper 47, page 4), "[f]or Ellsworth to change his mind there must have been some reasons or some event which caused him to believe that he was the sole inventor." We believe the reasons and events should be placed in the record by Ellsworth.

¹⁰ See *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1580 n.11, 6 USPQ2d 1001, 1008 n.11 (Fed. Cir. 1988) (the ultimate burden of persuasion [in a case where a party is under a burden to establish a fact by a preponderance of the evidence] is only critical in the situation where the evidence is so evenly balanced that no preponderance emerges. In that event, the party having the burden of persuasion necessarily loses).

and depicted [in the Ellsworth and Moore patent] was conceived, developed and designed *** solely by Ellsworth" makes out Ellsworth's case. Apart from the fact that "conception" is an issue of law, the statement by Fujioka is not inconsistent with joint inventorship by Ellsworth and Moore. Fujioka fails to reveal the extent to which he knows or does not know about any conversations or interaction between Ellsworth and Moore prior to the time he observed any development or design by Ellsworth. Fujioka does not rule out the reasonable possibility (in light of Ellsworth at one time agreeing he was a joint inventor with Moore) that the Ellsworth activity Fujioka says he observed took place subsequent to a time when Ellsworth and Moore collaborated in some fashion to conceive the originally claimed invention, e.g., an oral discussion taking place "off campus" from Design West at which Fujioka, or for that matter Grudt, were not in attendance.

We recognize that Moore could have presented evidence which might have aided us in resolving the case. But, Moore does not have the burden of proof and legitimately can elect a litigation strategy of simply commenting on the evidence supplied by Ellsworth. Linkow v. Linkow and Edelman, 517 F.2d 1370, 1374, 186 USPQ 223, 226 (CCPA 1975) (no adverse inference can be drawn from a senior party's refraining from taking testimony, because it has a right to stand on its position that the junior party failed to establish a prima facie case). Procedurally, the party with the burden of proof in an inventorship dispute case, such as this case, should have the burden of presenting some evidence, and explaining in light of that evidence, why the inventor sought to be "removed" was "added" in the first place and should be "deleted" in the second place. In effect, to use Moore's words, Ellsworth should have some burden to "rule out contributions by Moore" (Paper 47, page 5). If the party with the burden of proof does not present evidence with its case-in-chief as to why a "coinventor" should be deleted, an unfair burden is placed on the opponent. If the opponent testifies with respect to its contribution, the opponent stands a good chance of being unfairly ambushed when the party with the burden puts

on a rebuttal case, after which the opponent has no procedural right under our rules and practice to present additional evidence.

3.

While the foregoing serves as a basis for holding that Ellsworth failed to sustain his burden of proof, there are other reasons why Ellsworth's case is flawed.

As noted in our MEMORANDUM OPINION and ORDER of 13 September 2001 (Paper 49, pages 9-10), Ellsworth's principal brief purports, at least superficially, to present a count-by-count analysis of how the evidence is said to describe the invention of claims 1-15 (Paper 44, pages 3-4). However, no adequate effort was made by Ellsworth to read particular elements (which should have been hand-numbered in the exhibits) of Exhibits A through J attached to the three Rule 608(b) declarations on any limitation in Ellsworth claims 1-15. In other words, Ellsworth apparently expects Moore and us to look at a particular exhibit and to figure out what element shown in the exhibit corresponds to a limitation in Ellsworth claims 1-15.¹¹ Ellsworth's apparent expectation unfairly shifts the burden to Moore to show what claim element is missing from an exhibit thereby, in effect, permitting Ellsworth to unfairly make out its case in the first instance in its reply. Moreover, Ellsworth's apparent expectation shifts to the board the role of becoming an advocate for Ellsworth after briefing is closed and Moore no longer has an opportunity to respond. We said the following (Paper 49, page 10):

What we expect Ellsworth to do is (1) reproduce the exhibits, (2) hand-number elements in the reproduced exhibits, (3) assign the hand-numbered reproduced exhibits an exhibit number and (4) then read the device shown in the reproduced exhibit on each of Ellsworth claims 1-15 by reference to element numbers in the hand-numbered reproduced exhibit. Compare the procedure outlined in ¶ 21 of the NOTICE DECLARING INTERFERENCE. Once Ellsworth complies, Moore can decide whether he agrees or disagrees with Ellsworth and can focus any

¹¹ We would also observe that Ellsworth has not established that the apparatus shown in the exhibits (1) reads on claims 1-15 of the Ellsworth application but (2) does not read on the claims of the Ellsworth and Moore application, as filed.

opposition brief on what is believed to be missing. Ellsworth, of course, can then properly reply to any point raised in any Moore opposition.

Thus, despite the late stage of the proceeding, we gave Ellsworth what we thought was an additional opportunity to show how the devices shown in Exhibits A through J read on each of Ellsworth claims 1-15 (Paper 49, pages 9-10; Paper 53, page 5, Part IV). Ellsworth declined the opportunity.

In Okajima v. Bourdeau, 261 F.3d 1350, 59 USPQ2d 1795 (Fed. Cir. 2001), a Federal Circuit merits panel noted that at oral argument before a merits panel of the board, Okajima was given an opportunity to address concerns expressed in the form of questions from Judge Lee. While oral argument was not requested in this interference, we invited Ellsworth to both (1) explain what involvement Moore had with the invention and filing of the Ellsworth and Moore application and (2) provide us with marked copies of the documentary attachments to Ex 2001. As noted earlier, Ellsworth declined our invitation. We try to be fair and objective in resolving interferences and we make an effort not to become an advocate for one party against its opponent, even in a case like the one before us where we imagine that both parties are probably operating on "shoestring" budgets. Numerous telephone conference calls which took place during the interference confirm that, in our opinion, counsel for both parties may well have handled the interference essentially pro bono. We appreciate the effort of both counsel. However, shoestring budgets (1) cannot override the need for proof, (2) cannot act to shift the burden to the opponent and (3) can be no legitimate basis for requiring the board to expend its resources to dig into a case to see if it might be able to come up with some theory on which one pro bono client might be able to prevail over a pro bono opponent, particularly when the pro bono opponent would have no procedural chance as a matter of right to respond with evidence, in writing or orally to some imaginative theory on our part.

4.

In its principal brief, Ellsworth maintains that he does not have to establish conception of the invention defined by all of Ellsworth claims 1-15 to prevail. We now agree.¹²

Ellsworth would have been entitled a patent containing those claims for which he could have established sole inventorship. If he had established sole inventorship for the subject matter of all 15 claims, then a patent should be issued to Ellsworth with 15 claims and all claims of the Ellsworth and Moore patent should be cancelled. 35 U.S.C. § 135(a). On the other hand, if Ellsworth would have established sole inventorship with respect to only some of the claims, then any patent issued to Ellsworth should be limited to those claims and corresponding claims in the Ellsworth and Moore patent should be cancelled. Id.

5.

Ellsworth continues to argue in the principal brief, that some effect should be given to the fact that the Rule 608(b) showing was said to be "sufficient." To put this argument to bed once and for all, Ellsworth was advised that the Rule 608(b) showing was not considered on its merits, because it was not necessary (Paper 49, page 14, Part (3)). Once it was determined that Ellsworth was entitled to a "priority" benefit filing date which is the same as the filing date of the Ellsworth and Moore application, the Rule 608(b) showing became a "side-show" and unnecessary in this case.

For completeness, we will note that even if the Rule 608(b) showing had been determined to be "sufficient" by a single judge, that determination would not be binding on a three-judge merits panel. Cf. Nilssen v. Motorola, Inc., 203 F.3d 782, 785 n.2, 53 USPQ2d 1765, 1767 n.2 (Fed. Cir. 2000) (decision by a single Federal Circuit motions judge as not being binding on a Federal Circuit panel); Thomson v. Merit Systems Protection Board, 772 F.2d 879, 882 n.5 (Fed. Cir. 1985) (same).

¹² As noted above, there was a time in the interference when the board felt that Ellsworth had to prevail as to all of claims 1-15 to prevail in the interference.

E. Order

Upon consideration of the admissible evidence, and for the reasons given, it is

ORDERED that judgment on inventorship as to Counts 1-15, the sole counts in the interference, is awarded against junior party Arthur W. Ellsworth.

FURTHER ORDERED that junior Arthur W. Ellsworth is not entitled to a patent containing claims (corresponding to Counts 1-15, respectively) of application 09/123,917, filed 29 July 1998.

FURTHER ORDERED that a copy of this paper shall be made of record in files of application 09/123,917 and U.S. Patent 5,791,265.

FURTHER ORDERED that the opinion in support of the decision entered today shall be forwarded for publication in the USPQ2d and on the USPTO Web Page.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

FRED E. McKELVEY, Senior Administrative Patent Judge)))	
JAMESON LEE Administrative Patent Judge)	BOARD OF PATENT APPEALS AND INTERFERENCES
SALLY C. MEDLEY Administrative Patent Judge))	