

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 31

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SCOTT,

Junior Party,
(Application 0*/***,***),

v.

IVAN GBUR, BRIAN TOMKINSON
and JOYCE ALSTON,

Senior Party
(Patent 6,139,883).

Patent Interference 104,763 (McK)

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFER and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
(Scott - request for test standard)

The board has received a document styled SCOTT - REQUEST FOR TEST STANDARD (Paper 27). The relief sought in the document raises an important issue with respect to the application of § 19

of the STANDING ORDER (Paper 2) used by the Trial Section in interference cases.¹

Section 19 reads:

§ 19. Copies of patents and literature mentioned in each specification (and translations, if available)

Within **twenty-one (21) days** of a request by an opponent, a party:

- (a) shall serve a legible copy of every requested patent, literature reference and test standard (e.g., an ASTM test), and in the case of patents, literature or test standards in a foreign language, a translation, if available, mentioned in the specification of the party's involved patent and/or application upon which the party will rely for benefit, and
- (b) shall file with the board a notice (without copies of the patents or literature) that it has served the patents and literature.

Upon a request by the board, the parties should be prepared to promptly file copies of the patent, literature references and/or test standards.

The purpose of the additional discovery authorized by this section is to (1) place the parties on a level playing field and (2) minimizing any proof difficulty authenticating documents when a party would like to rely on a document cited in an opponent's specification. A party should have access to documents cited in its opponent's specification and it may be difficult for an opponent to locate those documents. 37 CFR § 1.687(c).

¹ Upon receipt of the document, counsel were notified by e-mail that Gbur need not respond to the requests made in the document (copy of e-mail appears in the record as Paper 30).

The invention of the Gbur patent relates to a fibrous, porous web. Claim 1 reads (emphasis added):

A fibrous, porous web of non-heat seal tissue having a basis weight of 9 to 18 g m⁻² and comprising a first layer comprising vegetable fibres and a second layer comprising hardwood fibres juxtaposed thereto wherein the second layer has a smaller pore size than the first layer.

The Gbur specification states that "[t]he second layer may be produced in a number of ways to ensure that it has a pore size lower than the first layer. In a preferred embodiment of the invention, the second layer is produced from fibres ***" (col. 2, lines 61-64). The Gbur specification goes on to say (col. 5, lines 4-11) (emphasis added):

Tests were conducted on the material obtained to determine how effective it was at preventing the percolation therethrough of fine sand. The sand dust percolation was determined as the percent by weight of a sample of sand having a particle size in the range of 106-150 um which would pass through the paper in a standard test which involves vibrating a horizontally disposed sample of the paper on which the sand is located.

Thus, while the specification makes reference to what is characterized as a "standard test", it does not identify that

test by reference to a specific document or a test by its number, i.e., an ASTM test.

In its document (Paper 27, page numbered 1), Scott makes the following request:

The Scott party [, i.e., Scott,] hereby requests under section 19 of the STANDING ORDER, a legible copy of the test standard or test standards used in U.S. Patent No. 6,139,883 to Gbur to measure, within a layered, fibrous, porous web material, the pore size of a first layer comprising hardwood fibers and the pore size of a second layer comprising hardwood fibers juxtaposed to the first layer.

The purpose of § 19 is set out therein. Often, a party's specification will refer to specific documents, such as literature articles or a test by its number, e.g., an ASTM test. An opponent may wish to review one or more of those documents. Some documents are difficult to locate. Even when an opponent locates, or thinks it has located, a document, a party may object to its admissibility on grounds of lack of authentication. Section 19 seeks to eliminate these difficulties. A party should be able to locate documents mentioned in its specification. If upon request a party supplies the opponent with a copy of the document mentioned in the specification, authentication issues should not exist.

Section 19, however, does not serve as a tool for an opponent to seek discovery from a party as to how one skilled in

the art would go about measuring a property of an article, in this case "pore size" of layers of web materials. It may be that (1) Gbur characterizes pore size of its two-layer material to be "an important feature" of its invention, (2) each layer of Gbur's two-layer material must have different pore sizes and (3) pore size is said to have been measured by a "standard test." However, Gbur does not identify the "standard test" by reference to a document or a test number. Section 19 of the STANDING ORDER provides a basis to request production of copies of documents, or a test identified by its number, mentioned in the specification. Section 19, however, does not provide a basis for Scott to ask Gbur to produce discovery as to how pore size would be, or was, measured. In other words, § 19 of the STANDING ORDER does not provide a basis for Scott to ask Gbur to identify the "standard test" mentioned in the specification.

Nevertheless, Scott may be entitled to additional discovery of the nature of the Gbur "standard test." 37 CFR § 1.687(c). If Scott believes that it is entitled to additional discovery on the issue of pore size, including the nature of the "standard test," it may file a miscellaneous motion under 37 CFR § 1.635 seeking discovery upon complying with all requirements associated

with miscellaneous motions, including those set out in §§ 26, 28 and 32 of the STANDING ORDER.

FRED E. McKELVEY, Senior)	
Administrative Patent Judge)	
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RICHARD E. SCHAFER)	BOARD OF PATENT
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