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Trial Section Motions Panel  
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Paper No. 65

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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CROMLISH,

Junior Party,

v.

D.Y.,

Senior Party.

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Interference No. 104,289

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Entered: 21 November 2000

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Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE,  
TORCZON, GARDNER-LANE, and MEDLEY, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

**DECISION**  
(PURSUANT TO 37 CFR § 1.640)

INTRODUCTION

Cromlish Preliminary Motion 3 (Paper No. 45), filed under 37 CFR § 1.633(g), attacks the benefit accorded to D.Y. (Paper No. 1) for failure to comply with the best mode requirement of 35 U.S.C. § 112[1]. Cromlish has not shown that

disclosure of the best mode is a requirement for priority benefit, so we deny Cromlish Preliminary Motion 3.

## DISCUSSION

Cromlish moves to attack the benefit accorded to D.Y. of four predecessor applications for which D.Y. was accorded benefit in the notice declaring this interference (Paper No. 1). Cromlish contends that D.Y. failed to disclose its contemplated best mode until it filed its involved application. A movant bears the burden of establishing its entitlement to the relief sought by a preponderance of evidence. 37 CFR § 1.637(g); Bosies v. Benedict, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1995). Cromlish has not met its burden.

Cromlish has not shown why a party must comply with the best-mode requirement of 35 U.S.C. 112[1] to receive benefit of an earlier application for the purposes of priority. For the reasons given below, it is not apparent that such a requirement would be appropriate and Cromlish provides no authority for its proposition. Cf. Tofe v. Winchell, 645 F.2d 58, 61, 209 USPQ 379, 382-83 (CCPA 1981) (holding best mode is not "determinative" of priority, but is ancillary to priority since it could moot the issue of priority).<sup>1</sup> We will not assume a central

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<sup>1</sup> Tofe was conducted under the "old" rules, 37 CFR §§ 1.201-1.288 (1984). In "old" rule interferences, the "right to make" a claim was a patentability issue ancillary to priority, which could therefore be considered in an interference. If a party did not have the right to make a claim (i.e., did not comply with § 112[1]), it had no right to an award of priority. Hence a holding of no right to make could moot the need to consider priority. Today, a failure to comply with § 112[1] would not necessarily moot the issue of priority. Cf. Perkins v. Kwon, 886 F.2d 235, 12 USPQ2d 1308 (Fed. Cir. 1989) (affirming board decision reaching priority despite unpatentability of prevailing party's claims).

element of the movant's case. Hence we hold that Cromlish has not made out a *prima facie* case for relief.

Patentability and priority benefit distinguished

Benefit accorded for the purpose of priority is not the same as benefit accorded under 35 U.S.C. 120. A patent applicant must comply with 35 U.S.C. 112[1], including the requirement to "set forth the best mode contemplated by the inventor of carrying out his invention." Section 120 explicitly incorporates the requirements of § 112[1], which includes the best-mode requirement:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States...shall have the same effect, as to such invention, as though filed on the date of the prior application....

Priority benefit, by contrast, does not establish the applicant's entitlement to a given date for the purpose of determining the patentability of a claim. Rather, it establishes a date for a party's constructive reduction to practice of all elements of the count. E.g., Credle v. Bond, 25 F.2d 1566, 1673, 30 USPQ2d 1911, 1917 (Fed. Cir. 1994); see also 37 CFR § 1.637(f)(3) (requiring a showing of constructive reduction to practice before awarding benefit of an earlier application). Priority is not a basis for granting a patent to that party; rather, it is the basis for denying patentability to another party under 35 U.S.C. 102(g)(1). Consequently, it is not apparent why it should be necessary for a priority benefit

application to satisfy all the requirements for the patentability of a claim as long as it is sufficient to show prior invention by another.

A reference need not provide the same level of disclosure as an application for patent. E.g., *In re Schoenwald*, 964 F.2d 1122, 1123-24, 22 USPQ2d 1671, 1673 (Fed. Cir. 1992) (acknowledging the double standard for applications and references, but holding that utility is not required in an anticipatory reference). The key tests for a prior art reference are whether it describes and enables the invention. Id., 964 F.2d at 1123, 22 USPQ2d at 1672. Similarly, if D.Y.'s earlier applications describe and enable an embodiment with the scope of the count,<sup>2</sup> then those applications would appear to support a constructive reduction to practice under § 102(g)(1), even if D.Y. were not entitled to a patent on the same invention for some other reason.

#### ~~EFFECT ON UNPATENTABILITY MOTIONS~~

~~Cromlish has filed a number of unpatentability motions. Some of these motions will fail if D.Y. is accorded the benefit of its earlier applications under 35 U.S.C. 120. D.Y.'s chain of priority contains several continuation-in-part applications. If D.Y. opposes an unpatentability motion by asserting its entitlement to an earlier effective filing date under § 120, then Cromlish may attack that assertion in its reply.<sup>3</sup>~~

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<sup>2</sup> Cromlish challenges these points in separate motions.

<sup>3</sup> A party may not incorporate arguments by reference (Paper No. 1, ¶ 13).

#### RECONSIDERATION

The present practice is to provide a panel decision on preliminary motions whenever appropriate to minimize the preliminary motions issues lingering into the priority phase. This practice is consistent with 37 CFR § 1.601, which requires construction of the rules to ensure a just, speedy, and inexpensive determination, because it reduces the number of contingencies the parties must address during the priority phase. Deferring reconsideration until the final hearing is not consistent with this policy. Consequently, any review of a panel decision should be filed consistent with the practice for seeking reconsideration of panel decisions under 37 CFR § 1.640(c).

#### ORDER

Upon consideration Cromlish Preliminary Motion 3, and for the reasons given, it is—

ORDERED that Cromlish Preliminary Motion 3 (Paper No. 45) be denied;

FURTHER ORDERED that any request for reconsideration must be filed within fourteen (14) days of the date of this decision; and

FURTHER ORDERED that this interference be remanded to the administrative patent judge designated to administer the interference.

FRED E. McKELVEY  
Senior Administrative Patent Judge

RICHARD E. SCHAFER  
Administrative Patent Judge

JAMESON LEE  
Administrative Patent Judge

RICHARD TORCZON  
Administrative Patent Judge

SALLY GARDNER-LANE  
Administrative Patent Judge

SALLY C. MEDLEY  
Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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CROMLISH,

Junior Party,

v.

D.Y.,

Senior Party.

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Interference No. 104,289

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Entered: 12 December 2000

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Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE,  
TORCZON, GARDNER-LANE, and MEDLEY, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

**DECISION**  
(PURSUANT TO 37 CFR § 1.640)

INTRODUCTION

D.Y. requests (Paper No. 70) reconsideration of, and relief from, a portion of an earlier decision (Paper No. 65) entitled "EFFECT ON UNPATENTABILITY MOTIONS". Specifically, D.Y. urges that this portion of the decision unfairly shifts

to D.Y. the burden of establishing its entitlement to an earlier benefit date under 35 U.S.C. 120, relieves Cromlish of the responsibility to present a complete motion in the first instance, and permits Cromlish to raise a new argument in its reply brief. For the reasons provided below, the portion of Paper No. 65 entitled "EFFECT ON UNPATENTABILITY MOTIONS" is vacated.

#### FINDINGS OF FACT

F1. D.Y. was accorded the benefit of four antecedent applications (B, C, D, and E) when this interference was declared (Paper No. 1 at 40).

F2. According to the records of the Office, D.Y.'s involved application (A) (June 1995) is—

a continuation-in-part of B (April 1994),  
which is a continuation-in-part of C (April 1993),  
which is a continuation-in-part of D (December 1992),  
which is a continuation-in-part of E (September 1992).

F3. Cromlish has moved to attack the patentability of D.Y.'s involved claims as anticipated by any of the following references:

anticipation by Cromlish's involved patent (May 1993);  
Jones et al. (April 1993); and either  
Hla et al. (August 1992) or  
Hla & Neilson (March 1992).

F4. According to Cromlish, each of the references is prior art because D.Y. did not disclose the correct sequence for the claimed invention until the involved application A (CPM<sup>4</sup>8 at 18; CPM9 at 20-21; CPM10 at 20).

F5. Each of Cromlish's preliminary motions 8-10 refer to Cromlish's motions attacking benefit (CPM8 at 3; CPM9 at 3-4; CPM10 at 2-3).

F6. Cromlish's preliminary motions 8-10 do not, themselves, raise any issue about D.Y.'s compliance with the best-mode requirement in any of its parent applications.

F7. The involved Cromlish patent itself appears to be a continuation-in-part of an application filed December 1992.

F8. The Cromlish patent and Jones and Hla papers appear to have been presented to the examiner during prosecution of D.Y.'s involved application (Tab A).<sup>5</sup>

F9. The examiner accorded D.Y. § 120 benefit for application E (Tab B).

F10. The examiner withdrew rejections over Cromlish based on this according of benefit (Tab B, ¶ 7).

F11. The examiner withdrew a rejection alternatively over Jones based on this according of benefit (Tab B, ¶ 10).

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<sup>4</sup> Cromlish Preliminary Motion.

<sup>5</sup> D.Y. is reminded of its obligation to number its exhibits. Failure to number exhibits properly is a sufficient reason to return a paper.

F12. If D.Y. is entitled to the benefit of all of its earlier applications, then the Cromlish and Jones references might not be prior art.

F13. Cromlish also filed seven motions under 37 CFR § 1.633(g) attacking D.Y.'s entitlement to the priority benefit of applications B-E.

F14. Cromlish did not file any motion alleging unpatentability under 35 U.S.C. § 112[1].

F15. One of Cromlish's motions attacking priority benefit for failure to comply with the best-mode requirement has been denied (Paper No. 65).

F16. Paper No. 65 included the following discussion (footnote omitted):

#### EFFECT ON UNPATENTABILITY MOTIONS

Cromlish has filed a number of unpatentability motions. Some of these motions will fail if D.Y. is accorded the benefit of its earlier applications under 35 U.S.C. 120. D.Y.'s chain of priority contains several continuation-in-part applications. If D.Y. opposes an unpatentability motion by asserting its entitlement to an earlier effective filing date under § 120, then Cromlish may attack that assertion in its reply.

#### DISCUSSION

A movant bears the burden of establishing its entitlement to the relief sought by a preponderance of evidence. 37 CFR § 1.637(g); Bosies v. Benedict, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1995). A movant is not, however, obliged to anticipate all grounds for opposition and meet them in its motion. Cf. U.S. Patent & Trademark Off., "Interference Practice - Interference Rules Which Require a Party to 'Show the Patentability' of a Claim", 1217 Off. Gaz. 17 (8 Nov. 1998) (normally requiring movant only to show compliance with

the written description requirement of 35 U.S.C. 112[1]); Nau v. Ohuchida, 1999 Pat. App. LEXIS 15<sup>6</sup> (BPAI), modified in 1999 Pat. App. LEXIS 10<sup>7</sup> (BPAI 1999) (opposition raised unanticipated enablement questions about foreign priority document).

In the present case, Cromlish was on notice about D.Y.'s parent applications and that they antedate at least some of the references on which Cromlish relies. Thus, Cromlish was obliged to present a *prima facie* case for why its references are prior art. A single reason why D.Y. is not entitled to § 120 benefit may suffice, but (contrary to the implication in the original decision) Cromlish may not introduce new theories for denying § 120 benefit except as necessary to address a new argument raised in the opposition. Cf. Nau, 1999 Pat. App. LEXIS 15 at 14-15 (responsive argument to unexpected opposition argument is not really "new").

Since this decision on reconsideration is grounded on Cromlish's obligation to make out a *prima facie* case for why its references are prior art, we do not reach the issues of burden of proof for § 120 benefit or the effect of the examiner's earlier determination.

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<sup>6</sup> <http://www.uspto.gov/web/offices/dcom/bpai/its/104258.pdf>.

<sup>7</sup> <http://www.uspto.gov/web/offices/dcom/bpai/its/104258-2.pdf>.

ORDER

Upon consideration D.Y.'s REQUEST FOR EXPEDITED RECONSIDERATION OF NOVEMBER 21 DECISION, and for the reasons given, it is—

ORDERED that decision of Paper No. 65 be modified to vacate the portion entitled "EFFECT ON UNPATENTABILITY MOTIONS"; and

FURTHER ORDERED that this interference be remanded to the administrative patent judge designated to administer the interference.

FRED E. McKELVEY  
Senior Administrative Patent Judge

RICHARD E. SCHAFER  
Administrative Patent Judge

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