

The opinion in support of the decision being entered today is binding precedent of the Trial Section

Filed by: Motions Panel  
Interference Trial Section  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Paper No. 240  
Filed  
8 December 2000

UNITED STATES PATENT AND TRADEMARK OFFICE

-----  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
-----

ROBERT F. LEVEEN,  
Junior Party,  
(Application 08/559,072),

v.

STUART D. EDWARDS, RONALD G. LAX  
and HUGH SHARKEY,  
Senior Party,  
(Patent No. 5,536,267).

-----  
Patent Interference No. 104,290  
-----

Before: McKELVEY, Senior Administrative Patent Judge and  
SCHAFFER, LEE, TORCZON, GARDNER-LANE and MEDLEY Administrative  
Patent Judges.<sup>1</sup>

PER CURIAM.

**MEMORANDUM OPINION and ORDER**  
**(Decision on Edwards preliminary motion 1)**

-----  
<sup>1</sup> The panel was expanded after oral argument before a three-judge panel. Cf. Kingsdown Med. Consultants, Ltd. v. Hollister, Inc. 863 F.2d 867, 876 n.16, 9 USPQ2d 1384, 1392 n.16 (Fed. Cir. 1988) (in banc consideration of a single section of opinion); see also In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (change in panel composition after oral argument not error).

A. Introduction

Edwards preliminary motion 1 seeks entry of judgment against LeVeen claims 43 and 44. According to Edwards, the LeVeen claims are anticipated under 35 U.S.C. § 102(e) by Edwards '597 (U.S. Patent 5,458,597 (Ex 5001)) or are unpatentable under 35 U.S.C. § 103 over Edwards '597 in view of Ende (U.S. Patent 1,814,791 (Ex 5002)) and/or McFadden (U.S. Patent 1,943,543 (Ex 5003)).

For reasons hereinafter given, the preliminary motion is dismissed because it (1) has not been presented in a procedurally proper fashion and (2) fails to state a claim upon which relief may be granted under 37 CFR § 1.633(a).

B. Discussion

1.

Edwards was given actual notice of procedure to be followed in filing preliminary motions. Despite actual knowledge, Edwards has not followed that procedure. Moreover, as will become apparent, the facts set out in the preliminary motion fail, as a matter of law, to support a finding of anticipation under § 102(e) or a conclusion of obviousness under § 103. Hence, the preliminary motion fails to state a claim for which relief may be granted under 37 CFR § 1.633(a). Edwards has not "fairly place

at issue"<sup>2</sup> in this interference an issue of anticipation or obviousness. Hence, we elect to exercise our discretion by dismissing Edwards preliminary motion 1.

The preliminary motion filed by Edwards is basically sloppy. We regret to say that Edwards is not alone. Sloppy motions are being filed in far too many interferences. A sloppy preliminary motion has several adverse consequences on the administration of justice in interference cases. In no particular order of importance, the following adverse consequences come to mind:

- (1) unnecessary expense to the party;
- (2) prejudice to the opponent who must determine on its own the party's position so that an opposition may be presented;
- (3) unnecessary expense to the opponent; and
- (4) inefficient use of board resources.

In this particular interference, we do not know whether to be annoyed or disappointed or both with respect to the superficial effort which seems to have been made by counsel for Edwards in connection with Edwards preliminary motion 1. Without a doubt, however, we are frustrated with that effort. The board does not have unlimited resources to handle sloppy motions.

---

<sup>2</sup> Perkins v. Kwon, 886 F.2d 325, 12 USPQ2d 1308 (Fed. Cir. 1989) (if patentability is fairly placed at issue in an interference, it will be determined).

Moreover, a motion--including a preliminary motion--is not a pleading. Nor is it the function of the board to assume the role of counsel for a party by making an attempt to figure out whether the evidence in support of a motion makes out a case based on some theory not set out in the motion. The board will not engage in "role-shifting" by becoming counsel for a party and turning the interference into a contested case between (1) the party and the board, on the one hand, versus (2) the opponent, on the other hand.

2.

In a NOTICE DECLARING INTERFERENCE (Paper 1), Edwards was given actual notice of procedures which are to be followed in this interference.

a.

Paragraph 13 of the NOTICE DECLARING INTERFERENCE states in rather plain terms (Paper 1, page 10):

Arguments presented in one paper shall not be incorporated by reference to another paper.

A footnote associated with ¶ 13 explicitly states (Paper 1, page 10 n.7):

The purpose of this requirement is to minimize the chance that an argument will be overlooked and to maximize the efficiency of the decision-making process.

b.

Paragraph 26 of the NOTICE DECLARING INTERFERENCE (Paper 1) states in part (Page 22-26):

[page 22]

Motions

a. In presenting a motion, a party shall set out in the following order:

(1) The precise relief requested \*\*\*.

[page 23]

(2) The evidence (i.e., a list of all exhibits by number) the moving party relies in support of the motion.

(3) The facts in separately numbered paragraphs with a citation to the evidence.

(4) An argument setting out the reasons why relief should be granted.

Oppositions

b. In presenting an opposition, a party shall set out in the following order:

(1) The evidence (i.e., a list of all exhibits by number) the opposing party relies in support of the opposition.

(2) Whether each fact alleged by the moving party is admitted, denied or that the opposing party is unable to admit or deny the fact alleged.

(3) Any additional facts upon which the opposing party intends to rely with a citation to the evidence.

(4) An argument stating the reason why relief is opposed in the following manner: "On page x, [page 24] lines y-z of the motion, it is argued that \_\_\_\_\_. The response is \_\_\_\_\_." \* \* \* \* \* [page 25]

Preliminary motion--anticipation

d. When anticipation (35 U.S.C. § 102) over a single prior art reference is the basis for a preliminary motion for judgment (37 CFR § 1.633(a)), each claim alleged to be anticipated should be reproduced as an appendix to the preliminary motion. Following each element recited in each claim, and within braces { } and in bold, there shall be inserted a specific reference to the column and line and/or drawing figure and numeral and/or other material where the reference describes each element of the claim. A similar procedure should be used for each claim of an opponent which a party maintains is anticipated.

Preliminary motion--obviousness

e. When obviousness (i.e., 35 U.S.C. § 103) over the prior art is the basis for a preliminary motion for judgment (37 CFR § 1.633(a)), a similar procedure shall be used [at least one element of the claim will not be described in a prior art reference]. Any difference shall be explicitly identified. Finally, an explanation should be made as to why the subject matter of the claim, as a whole, would have been obvious to a person having ordinary skill in the art notwithstanding

any difference. A similar procedure should be used for each claim of

[page 26]

an opponent which a party maintains is unpatentable based on obviousness.

A footnote in part (a)(3) of ¶ 26 of the NOTICE DECLARING INTERFERENCE states (Paper 1, page 23 n.23):

A motion may be denied if the facts alleged are insufficient to state claim for which relief may be granted. Facts belatedly set out only in the argument portion of a motion may be overlooked and may result in a motion being denied.

c.

Paragraph 28 of the NOTICE DECLARING INTERFERENCE (Paper 1) states in part (page 27):

A motion is limited to twenty-five (25) pages, not including any certificate of service.

Edwards preliminary motion, sans heading, table of contents, footnotes, signature block and certificate of service follows with material in [brackets] added and material deleted noted by \*\*\*".

**I. Statement of the Precise Relief Requested**

Edwards requests judgment that both of LeVeen's claims [43 and 44] designated as corresponding to the count are anticipated by U.S. patent \*\*\* 5,498,597 (\*\* "the Edwards '597 patent") [Ex 5001] under 35 U.S.C. 102(e) and/or unpatentable [under 35 U.S.C. 103] over the Edwards '597 patent in view of \*\*\* U.S. Patent \*\*\* 1,814,791 (\*\* "the Ende patent") [Ex 5002] and/or U.S. patent 1,943,547 (\*\* the McFadden patent") [Ex 5003].

**II. Evidence Relied Upon in Support of Motion**

Exhibits 5001, 5002, 5003, 5004, 5010 and 5015.

**III. Statement of the Material Facts in Support of the Motion**

(1) The Edwards '597 patent matured from application \*\*\* 08/148,439 (\*\* "the '439 application").

(2) The '439 application was filed on November 08, 1993.

(3) The Edwards '597 patent issued on October 17, 1995.

(4) The Edwards patent [involved] in [the] interference (\*\* "the Edwards '267 patent") [Ex 5004]



matured from application \*\*\* 008/290,031 (\*\*\*) "the '031 application").

(5) The '031 application was filed on August 12, 1994.

(6) LeVeen's application [involved] in [the] interference is application \*\*\* 08/559,072 (\*\*\*) "the '072 application").

(7) The '072 application was filed on November 16, 1995.

(8) The '072 application claims the benefit of the filing date of application \*\*\* 08/410,344 (\*\*\*) "the '344 application").

(9) The '344 application was filed on March 24, 1995.

#### **IV. Statement of the Reasons Why the Relief Requested Should be Granted**

##### **A. Relevant Field and Level of Skill in the Art**

The subject matter defined by claims 43 and 44 of the LeVeen application \*\*\* is at the interface of the field of medical surgery generally and electrosurgery in particular and the field of designing devices for use in medical surgery generally and electrosurgery in particular. Exhibit 5010 ¶ 4 and Exhibit 5015 ¶ 4.

One of ordinary skill in the art in the field of medical surgery generally and electrosurgery in particular in the 1993-95 time frame would have been a medical doctor who was knowledgeable in surgery generally and electrosurgery in particular. Exhibit 5010 ¶ 5 and Exhibit 5015 ¶ 5.

One of ordinary skill in the field of designing devices for use in medical surgery generally and

electrosurgery in particular in the 1993-95 time frame would have been either a medical doctor, usually with an undergraduate degree in mechanical or electrical engineering or biological sciences, or an engineer, usually with an undergraduate degree in mechanical or electrical engineering, in either case with five to ten years experience in designing devices for use in medical surgery. Exhibit 5010 ¶ 6 and Exhibit 5015 ¶ 6.

**B. Comparison of the Claims to the Prior Art**

That LeVeen's claims 43 and 44 are either anticipated by the Edwards '597 patent or unpatentable [under 35 U.S.C. 103] over the Edwards '597 patent in view of the Ende patent and/or the McFadden patent is demonstrated in Section IV of the first declarations of Dr. Allan Siperstein, Exhibit 5010, and Mr. Neil Sheehan, Exhibit 5015.

**V. 37 CFR 1.637(a) Explanation**

The Edwards '597 patent is not applicable to Edwards because (a) it names the same inventors as the Edwards '267 patent (and hence is not available as prior art under 35 U.S.C. 102(a) and 35 U.S.C. 102(e)) and (b) it did not issue until after a year before the filing date of the '031 application (and hence is not available as prior art under 35 U.S.C. 102(b)).

4.

Edwards presented two declarations in support of Edwards preliminary motion 1, a Siperstein declaration (Ex 5010) and a

Sheehan declaration (Ex 5015). Insofar as we can tell, in all material respects the declarations appear to be essentially identical. The Siperstein declaration sans heading, table of contents and signature block follows with material in [brackets] and footnotes added for clarification and material deleted noted by "\*\*\*\*".

**I. Qualifications**

(1) A copy of my C.V. is Exhibit 5024<sup>3</sup>.

**II. Preparation of this declaration**

(2) In connection with the preparation of this declaration, I have read each document referred to herein.

(3) I have discussed this declaration with counsel<sup>4</sup> for the party Edward[s] \*\*\*. While I am by no means an expert in patent law, I believe that I have an adequate general understanding of this proceeding and the purpose for which my declaration is being used.

**III. Relevant Field and Level of Skill in the Art**

(4) The subject matter defined by count 1 and the party Edwards' \*\*\* proposed count <sup>5</sup>2 is at the interface of the field of medical surgery generally and electrosurgery in particular and the field of designing

---

<sup>3</sup> Ex 5024 is not among the exhibits listed in Edwards preliminary motion 1 as being relied upon.

<sup>4</sup> The name of counsel is not identified and we note that numerous attorneys are listed at the end of Edwards preliminary motion 1.

<sup>5</sup> There is no reference made to a document containing count 1 or proposed count 2 or to a document containing the claims which are referred to in count 1 and proposed count 2.

devices for use in medical surgery generally and electrosurgery in particular.

(5) One of ordinary skill in the art in the field of medical surgery generally and electrosurgery in particular in the 1993-95 time frame would have been a medical doctor who was knowledgeable in surgery generally and electrosurgery in particular.

(6) One of ordinary skill in the field of designing devices for use in medical surgery generally and electrosurgery in particular in the 1993-95 time frame would have been either a medical doctor, usually with an undergraduate degree in mechanical or electrical engineering or biological sciences, or an engineer, usually with an undergraduate degree in mechanical or electrical engineering, in either case with five to ten years experience in designing devices for use in medical surgery.

**IV. Edwards [Preliminary] Motion \*\*\* 1**

(7) That LeVeen's claims 43 and 44 are either anticipated [under 35 U.S.C. § 102(e)] by \*\*\* Edwards '597 [Ex 5001] \*\*\* or unpatentable [under 35 U.S.C. § 103] over \*\*\* Edwards '597 \*\*\* in view of \*\*\* Ende [Ex 5002] \*\*\* and/or \*\*\* McFadden [Ex 5003] \*\*\* can be demonstrated as follows:

<u>LeVeen's Claims 43 and 44</u>	<u>Comments Reading LeVeen's Claims on the Disclosure of the [Edwards] '597 patent</u>
43. A tissue ablation apparatus, comprising:	Passim

a delivery catheter  
with a distal end and a  
proximal end;

Sleeve 36

a handle attached to  
the proximal end of the  
delivery catheter;

Handle portion 2

an electrode  
deployment device

Sleeve connector 34

positioned at least  
partially in the delivery  
catheter and

Col. 5, lines 13-15

including a plurality of retractable electrodes that are inserted into tissue, penetrate tissue, and surround a selected mass,

The electrode 32 curves around a selected mass. The use of a plurality of electrodes that are inserted into tissue, penetrate the tissue, and surround a selected mass has long been well known in the art. See, e.g., Fig. 7 of Exhibit 5002, U.S. patent \*\*\* 1,814,791, issued in 1931 and Fig. 1 of Exhibit 5003, U.S. patent \*\*\* 1,943,543, issued in 1934.

each electrode having a non-deployed state when positioned with the delivery catheter, and

See Fig. 4

a distended deployed state when advanced from the distal end of the delivery catheter defining an ablation volume between the deployed electrodes,

See Fig. 5

each deployed electrode having at least one radii of curvature when advanced through the distal end of the delivery catheter and positioned at a desired tissue site; and

See col.5 lines 16-19

an electrode advancement and retraction member connected to the electrode deployment device, for advancing the electrodes in and out of the delivery catheter distal end.

Styilet electrode control manual tab 8

V. **Jurat**

(8) I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct \*\*\*.

C. **Opinion**

1. Failure to follow applicable procedure

a.

Edwards, contrary to ¶ 13 of the NOTICE DECLARING INTERFERENCE, has incorporated "arguments" from the Siperstein and Sheehan declarations (Exs 5010 and 5015) into Edwards preliminary motion 1. Edwards misperceives the role of motions and evidence. Declarations are evidence. A motion is supposed to (1) lay out all relevant facts, with reference to the evidence which supports the facts, and (2) present an argument why the facts justify any relief requested in the motion.

The NOTICE DECLARING INTERFERENCE explicitly precludes incorporation by reference of arguments. There are numerous reasons why an agency, in general or in a particular case, may preclude incorporation by reference in papers presented to the agency. First, an incorporated argument may be overlooked (Paper 1, page 10 n.7). Second, incorporation of arguments is

---

<sup>6</sup> A similar analysis is made for LeVeen claim 44.

not consistent with efficient decisionmaking (Paper 1, page 10 n.7). Essentially, incorporation by reference is an inappropriate role-shifting technique which makes it a decisionmaker's job to (1) scour the record, (2) come up with some theory which supports a party's case and (3) articulate a rationale in an opinion supporting the rationale without giving an opponent a reasonable chance to address the rationale. Third, through incorporation by reference an attorney can avoid page limitations applicable to motions (Paper 1, page 27 ¶ 28). Compare DeSilva v. DiLeonardi, 181 F.3d 865, 866-67 (7th Cir. 1999) ("[a]doption by reference amounts to a self-help increase in the length of the \*\*\* brief. \*\*\* [I]ncorporation by reference is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.").

We recognize in this particular case that both the preliminary motion and the declarations are short. Hence, it can be argued that there was no undue burden on the opponent or the board to look collectively at both documents. The contrary argument is that the procedure applicable to this interference is otherwise and that it would have been no undue burden for Edwards to have complied with the applicable procedure.

b.



Edwards also failed, in several respects, to follow the procedure set out in ¶ 26 of the NOTICE DECLARING INTERFERENCE.

(1)

Edwards did not set out the facts in the preliminary motion which would support the relief requested in its preliminary motion 1. Nine facts--identified as (1) through (9)--are set out in the statement of material facts. At best the facts establish that Edwards '597 and Edwards '267 are prior art under 35 U.S.C. § 102(e). Establishing that two "references" are prior art does not make out a case of anticipation or obviousness.

Edwards' effort totally sandbagged its opponent. An opponent is to admit or deny each fact set out in a motion so that the board may determine where there are disputed factual issues. See Paper 1, page 23, part (b)(2). LeVeen easily could have admitted the nine facts set out by Edwards and would not have conceded the preliminary motion. There is no place in interference practice for a party to require an opponent to (1) search the motion and evidence, (2) set out in an opposition the facts the opponent may believe that the party must prove to make out its case and (3) admit or deny those facts.

(2)

Nor did Edwards use the format required by part (d) of ¶ 26 (Paper 1, page 25). Instead of inserting braces, i.e., {}, in a

reproduced copy of the claim, Edwards elected to do it its way by using parallel columns. The difference between the required procedure and the Edwards effort may seem trivial to a casual observer. Triviality, however, is not the point.

The Trial Section established procedures in this interference to make the overall consideration of papers efficient. There is little doubt that it would have been just as easy for Edwards to have complied with part (d) of ¶ 26 of the NOTICE DECLARING INTERFERENCE. We have no idea why Edwards did not follow the applicable procedure.

(3)

We will note another loose end in the Edwards effort. The list of exhibits relied upon as set out in the preliminary motion does not include two exhibits listed in the declarations. The C.V. mentioned in each declaration [Ex 5019 and Ex 5024] is not listed in the preliminary motion.

Edwards might say "What is the big deal?" The big deal is that Edwards did not follow proper procedure if it sought to have Ex 5019 and Ex 5024 considered. The board often does its work at places other than its physical facilities at the USPTO. When a judge decides to work on a motion at a remote location, the motion, opposition and reply can be collected along with all the exhibits identified in the motion, opposition and reply upon

which the parties rely. Failure to include all exhibits so that they may be collected frustrates the efficient administration of justice.

The NOTICE DECLARING INTERFERENCE accommodates many needs of the practicing bar. It also accommodates needs of the board. Hence, the parties are expected to follow applicable procedures.

## 2. Anticipation

LeVeen's claims 43 and 44 both contain the following limitation:

A tissue ablation apparatus \*\*\* including a plurality of retractable electrodes that are inserted into tissue, penetrate tissue, and surround a selected mass.

The preliminary motion does not tell us where Edwards describes the noted limitation. Yet, all concerned should know that anticipation requires that a single prior art reference describe each and every limitation of a claim, either explicitly or inherently. Atlas Powder Co. v. IRECO Inc, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945-46 (Fed. Cir. 1999). Since Edwards Preliminary Motion 1 fails to explain where the prior art relied upon describes the noted limitation, it follows that the preliminary motion fails to state a claim for which relief may be granted. In this particular case, the improperly incorporated by reference declarations likewise fail to explain where the prior

art describes the noted limitation. It follows that the declarations do not cure the procedural deficiencies of the preliminary motion.

We decline to search the prior art to see if somehow it might support Edwards' anticipation theory. Compare Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997), which notes that where a party points the court to multi-page exhibits without citing a specific portion or page, the court will not pour over the documents to extract the relevant information, citing United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991) (judges do not hunt for truffles buried in briefs); Ernst Haas Studio, Inc. v. Palm Press, Inc. 164 F.3d 110, 111-12, 49 USPQ2d 1377, 1378-79 (2d Cir. 1999) ("Appellant's Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation. although the issues raised are complex, appellant's main Brief is only nine pages long and does not cite a single statute or court decision related to copyright. Nor does it present a coherent legal theory, even one unsupported by citation to authority that would sustain the complaint."); Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1351, 53 USPQ2d 1580, 1589 (Fed. Cir. 2000) (We agree with Winner that the district court did not abuse its discretion in allowing allegedly late-disclosed

witnesses to testify. Such witnesses were never even identified by Wang in his opening brief \*\*\*. Under such circumstances, we will not search the record on the chance of discovering which witnesses Wang was complaining of and then determine whether the district court abused its discretion. Thus, whichever witnesses Wang was alluding to, admission of their testimony cannot be said to be an abuse of discretion based on the vague arguments made by Wang on appeal).

### 3. Obviousness

Edwards also has failed to fairly place the issue of obviousness before the board.

(1)

Obviousness is an issue of law. Graham v. John Deere Co., 383 U.S. 1, 17 (1966); In re GPAC, Inc., 57 F.3d 1573, 1577, 35 USPQ2d 1116, 1119 (Fed. Cir. 1995). Yet, Edwards presents its obviousness rationale--such as it is--through the testimony of fact witnesses. These fact witnesses disavow having expertise in the field of patent law. Moreover, we are not particularly interested in the position of a witness on any issue of law.

The "argument" presented by the witnesses in their declarations are not entitled to be considered because the argument was improperly incorporated by reference into Edwards preliminary motion 1.

(2)

Another fatal defect in Edwards preliminary motion 1 in connection with Edwards' obviousness position is that Edwards fails to set out any difference between (1) the subject of LeVein claims 43 and 44 and (2) the Edwards patents. It might have been difficult to do so because Edwards did not, or perhaps was unable to, make a decision whether to base its litigation theory on anticipation or obviousness, preferring instead to place a smorgasbord of theories in the preliminary motion. The Trial Section has noticed a recent trend on the part of counsel to "avoid" setting out the difference between claimed subject matter and a prior art reference. Perhaps counsel believe we will not notice any difference. However, it is essential when maintaining obviousness to explicitly identify a difference between claimed subject matter and a prior art reference. As the NOTICE DECLARING INTERFERENCE makes crystal clear, "[a]ny difference shall be explicitly identified" (Paper 1, page 25).

Edwards preliminary motion 1 is procedurally defective because it fails to explicitly identify any difference.

(3)

Assuming arguendo that a difference has been identified, Edwards did as poor a job as we have seen with the rest of its obviousness case.

Edwards tries to shoe horn a difference into the case by the back door via the testimony of its declarants, both of whom state that "[t]he use of a plurality of electrodes \*\*\* has long been well known in the art" (e.g., Ex 5015, page 2). However, LeVeen's claims 43 and 44 call for the use of a plurality of "retractable" electrodes and the declarants, like an ostrich, have buried the phrase "plurality of retractable electrodes" somewhere in the sand.

At oral argument, Judge Lee asked counsel for Edwards, where the declarations account for LeVeen's "plurality of retractable electrodes." Counsel had no answer. What surfaces is that the board at oral argument may have been able to ferret out that at least one difference exists. However, explicitly identifying a difference at oral argument comes too late. Compare Packard Press Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 1360, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000) (arguments raised for the first time at oral argument come too late, citing Henry v. Department of Justice, 157 F.3d 863, 865 (Fed. Cir. 1998)). At that point, the opponent is unduly prejudiced by an inability to fairly respond-- particularly with evidence to the contrary.

(4)

There is another point which Edwards totally overlooks. If one can put aside for the moment the "retractable" limitation in

the LeVeen claims, at best Edwards might have established that all the elements of the LeVeen combination are known. It may be necessary to sustain an obviousness rationale to establish that all elements of a combination are known. But, establishing that all elements of a combination are known does not establish obviousness. Smith Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999) (there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention; the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the teachings of the references, and that would also suggest a reasonable likelihood of success); In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) (identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention; rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant).

There is no discussion in Edwards preliminary motion 1 of any evidence in the record which would establish a reason, motivation, suggestion or teaching in the prior art as to why the



subject matter of LeVeen claims 43 and 44 would have been obvious notwithstanding any difference between that subject matter and one of the prior art Edwards patents. Hence, Edwards preliminary motion 1 fails to make out aprima facie case of obviousness (35 U.S.C. § 103) and therefore fails to state a claim for relief under 37 CFR § 1.633(a) as to LeVeen claims 43 and 44.

(5)

When questioned at oral argument about the lack of analysis in Edwards preliminary motion 1, counsel for Edwards in effect said that "examiners do it all the time." What counsel for Edwards apparently means is that an Examiner's Answer in ex parte appeal often fails to set out the rationale which we require of a party in an interference. When an examiner fails to engage in sufficient fact finding in the first instance, it is not unusual for the board to vacate the examiner's rejection and remand for appropriate fact findings. See, e.g., Ex parte Braeken, 54 USPQ2d 1110, 1111 (Bd. Pat. App. & Int. 1999) (non-binding precedent) (examiner failed to describe differences between claim and prior art; because issues were not sufficiently developed, examiner's rejection vacated and case remanded for development of facts).

The only difference between ex parte practice and interferences is that an examiner may be given an opportunity to

supplement the record. Inex parte practice a decision of the board reversing an examiner's rejection is necessarily a remand. Cf. In re Fisher, 448 F.2d 1406, 171 USPQ 292 (CCPA 1971) (every reversal in a patent case is in effect a remand). Indeed, prosecution in an ex parte matter may be reopened following successful administrative or judicial review. Cf. In re Ruschig, 379 F.2d 990, 154 USPQ 118 (CCPA 1967) (USPTO may reopen prosecution of an application after reversal by the CCPA) Gould v. Quigg, 822 F.2d 1074, 3 USPQ2d 1302 (Fed. Cir. 1987). However, because there are adverse parties in an interference, a party is normally given but one opportunity to make out its case. Compare Burson v. Carmichael, 731 F.2d 849, 854, 221 USPQ 664, 667 (Fed. Cir. 1984) (in an interference case where losing party wanted a remand to place additional evidence in the record, the Federal Circuit notes that "There is no support in the law for repeated bites at the apple."). Edwards had a chance to procedurally place the issue of obviousness properly before the board; it failed to do so.

Packard Press Inc. v. Hewlett-Packard Co. supra, also contains a discussion which needs to be taken to heart in presenting cases before this board. 227 F.3d at 1358, 56 USPQ2d at 1351. Judicial review under the substantial evidence standard can only take place when the agency explains its decisions with precision, including the underlying fact findings and the

agency's rationale. Accordingly, evidence and proper argument must be submitted to the agency to create an appropriate record on which the agency bases its decision. Because Hewlett Packard did not proffer such evidence in support of its argument that its trademarks are famous, the TTAB properly declined to address fame. Likewise, in the case of judicial review by civil action under 35 U.S.C. § 146, a party may not be permitted to present an issue to a reviewing district court if the issue was not fairly presented to the board in the first instance. Compare General Instrument Corporation, Inc. v. Scientific-Atlanta, Inc. 995 F.2d 209, 27 USPQ2d 1145 (Fed. Cir. 1993) (district court in civil action under § 146 did not abuse its discretion in declining to admit in evidence proofs directed to on-sale bar where on-sale had not been raised before the board).

We cannot do our job if the parties do not do their job. In this case, Edwards did not do its job and therefore we could not do our job. The remedy in this case is not to give Edwards a second bite at the apple and thereby burden LeVeen who already has expended resources opposing Edwards inadequate first bite. Rather, we will exercise discretion in this particular case to dismiss Edwards preliminary motion 1.

**D. Decision**

Edwards preliminary motion 1 is procedurally improper and therefore is dismissed.

Assuming arguendo that Edwards preliminary motion 1 remotely could be considered as having been procedurally proper, it fails to state claim for relief under 37 CFR § 1.633(a) on the ground of obviousness as to LeVeen claims 43 and 44.

**E. Order**

Upon consideration of Edwards preliminary motion 1, and for the reasons given, it is

ORDERED that Edwards preliminary motion 1 is dismissed.

FURTHER ORDERED that it has not been necessary to consider LeVeen opposition 1 (Paper 94), from which it necessarily follows that it has not been necessary to consider Edwards reply 1 (Paper 152), and accordingly both the opposition and the reply are returned without having been considered.

FURTHER ORDERED that this MEMORANDUM OPINION and ORDER shall be published.

\_\_\_\_\_)  
FRED E. McKELVEY, Senior )  
Administrative Patent Judge )  
)  
)  
\_\_\_\_\_)  
RICHARD E. SCHAFER )  
Administrative Patent Judge )  
)  
)  
\_\_\_\_\_)  
JAMESON LEE ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
) INTERFERENCES  
)  
\_\_\_\_\_)  
RICHARD TORCZON )  
Administrative Patent Judge )  
)  
)  
\_\_\_\_\_)  
SALLY GARDNER-LANE )  
Administrative Patent Judge )  
)  
)  
\_\_\_\_\_)  
SALLY C. MEDLEY )  
Administrative Patent Judge )

Via first class mail:

Counsel for LEVEEN:

Edward J. Keeling, Esq.  
TOWNSEND AND TOWNSEND AND CREW, LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, CA 94111-3834

Tel: 415-576-0200  
Fax: 415-576-0300

Counsel for EDWARDS:

Charles L. Gholz, Esq.  
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, PC  
Fourth Floor  
1755 Jefferson Davis Highway  
Arlington, VA 22202

Tel: 703-413-3000  
Fax: 703-413-2220