



**Board of Patent Appeals
and Interferences**

**Informative
Opinion**

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIM DANIELS, DOUG HINZIE, and DAVID SPATZ

Appeal 2008-0568
Application 09/932,571
Technology Center 2100

Decided:¹ May 20, 2009

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
JAMES T. MOORE and ALLEN R. MACDONALD, *Vice Chief
Administrative Patent Judges*, and WILLIAM F. PATE, III and
LINDA E. HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

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STATEMENT OF THE CASE

Tim Daniels et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's adverse decision rejecting claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention relates to lubricants supply chain management. Spec. 2:20. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer programmed to execute a process for lubricants supply chain management, said process comprising:
 - (a) upon receiving a request from a web-browser client, querying a database comprising a catalog of lubricants and prices and availability for same and serving the results of said query to said requesting web-browser client for display;
 - (b) serving an order form to said web-browser client which is configured to contain fields for order quantity and type for lubricants, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote;
 - (c) receiving an order from said web-browser client for a specific type and quantity of lubricants

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and having a specific delivery type selected;

(d) electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Lubricant Blender or an Order Fulfillment Agent, and mixtures thereof;

(e) electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent;

(f) wherein said Freight-Handling Agent inputs said information into a delivery optimization system which outputs a delivery schedule which includes said order, and electronically transmits over a network said order and said delivery information to at least one Trucking Company; and

(g) maintaining the status and all actions and communications for said order in a web-accessible database.

THE EVIDENCE

The Examiner relies upon the following evidence:

Hager	US 6,085,808	Jul. 11, 2000
Peterson	US 2001/0011232 A1	Aug. 2, 2001
Dabbiere	US 2002/0013721 A1	Jan. 31, 2002
Navani	US 2002/0049667 A1	Apr. 25, 2002
Phillips	US 2002/0116348 A1	Aug. 22, 2002
“Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution,” <i>Business Wire</i> , p. 17 (Aug. 2, 1999) (Business Wire).		

The Appellants rely upon the following evidence:

Affidavit of Tim Daniels, Doug Hinzie, and David Spatz, filed under 37 C.F.R. § 1.131 with accompanying exhibits (“the ‘131 affidavit”)

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THE REJECTIONS

The Appellants seek review of the following Examiner's rejections:

1. Claims 1-3, 5-8, 10, 11, and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Navani.
2. Claims 4, 9, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Navani and Hager.
3. Claims 1, 2, 6, 7, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dabbiere and Business Wire.
4. Claims 4, 9, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dabbiere, Business Wire, and Hager.
5. Claims 3 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dabbiere, Business Wire, and Peterson.
6. Claims 5, 10, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dabbiere, Business Wire, and Phillips.

ISSUE

The Appellants submitted an affidavit to antedate Navani and Dabbiere. App. Br. 5. The Examiner found that the Appellants failed to supply sufficient facts and supporting documentary evidence and exhibits to show conception prior to the effective date of the prior art and subsequent diligent reduction to practice of the claimed invention, as required by 37 C.F.R. § 1.131(b). Ans. 8-11. The Appellants contend that the Examiner has failed to correctly apply the law regarding affidavits submitted under

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37 C.F.R. § 1.131 and that the Appellants' '131 affidavit provides sufficient evidence to antedate Navani and Dabbiere. Br. 7.

The issue presented by this appeal is:

Have the Appellants shown the Examiner erred in finding that the '131 affidavit fails to provide sufficient evidence to antedate Navani and Dabbiere?

FINDINGS OF FACT

We find the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Examiner found that Navani discloses each element of claims 1-3, 5-8, 10, 11, and 13. Final Office Action dated June 8, 2005 (Final Office Action), paras. 24-30.
2. The Examiner made findings of fact and thereafter concluded that the subject matter of claims 4, 9, and 12 would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the teachings of Navani and Hager, or, in view of the teachings of Dabbiere, Business Wire, and Hager. Final Office Action, paras. 34-35 and paras. 41-42.
3. The Examiner made findings of fact and thereafter concluded that the subject matter of claims 1, 2, 6, 7, and 11 would have been obvious to one having ordinary skill in the art at the time the

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invention was made in view of the teachings of Dabbiere and Business Wire. Final Office Action, paras. 36-40.

4. The Examiner made findings of fact and thereafter concluded that the subject matter of claims 3 and 8 would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the teachings of Dabbiere, Business Wire, and Peterson. Final Office Action, paras. 43-44.
5. The Examiner made findings of fact and thereafter concluded that the subject matter of claims 5, 10, and 13 would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the teachings of Dabbiere, Business Wire, and Phillips. Final Office Action, paras. 45-46.
6. The Appellants do not contest the findings of fact made by the Examiner as to the scope and content of the prior art, the differences, if any, between the prior art and the claimed invention, or the level of ordinary skill in the art, and do not contest the Examiner's conclusions of anticipation and obviousness of the claimed subject matter. Br., *passim*.
7. The Appellants submitted an affidavit pursuant to 37 C.F.R. § 1.131 to antedate Navani and Dabbiere. Br. 5 and Evidence Appendix.
8. The '131 affidavit states that the invention of claims 1-13 "was reduced to practice on a date prior to May 22, 2000 or conceived

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on a date prior to May 22, 2000 and diligently reduced to practice thereafter.”

9. The ‘131 affidavit included attached “project documents used in the planning, commercial design, and/or implementation of the invention.” The ‘131 affidavit states that the attached project documents “have a date prior to May 22, 2000 and/or existed in draft form prior to May 22, 2000.”

PRINCIPLES OF LAW

37 C.F.R. § 1.131 provides in pertinent part:

- (a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based
- (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

37 C.F.R. § 1.131 (2008).

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ANALYSIS

The Appellants have waived any arguments contesting the substance of the Examiner's underlying findings as to the prior art and ultimate conclusions of anticipation and obviousness of the subject matter of claims 1-13 (Facts 1-6). Rather, the Appellants limited their challenge of the Examiner's adverse decision to an attempt to swear behind and thus remove two of the references, *viz*, Navani and Dabbiere, relied upon by the Examiner in the rejections. Br. 5.

To swear behind Navani and Dabbiere, the Appellants must establish invention of the subject matter of the rejected claims prior to the effective date of each reference by showing facts sufficient to establish reduction to practice prior to each effective date or conception of the invention prior to each effective date coupled with due diligence from prior to each effective date to a subsequent reduction to practice or to the filing of the application. 37 C.F.R. § 1.131. The Appellants have submitted evidence in an effort to establish invention of the subject matter of the rejected claims prior to May 22, 2000, i.e., the effective date of the earlier Dabbiere reference (Facts 7 & 8). This evidence consists of an affidavit under 37 C.F.R. § 1.131, signed by the inventors, and accompanying "project documents used in the planning, commercial design, and/or implementation of the invention" (Facts 7 & 9).

The '131 affidavit states that the invention of claims 1-13 "was reduced to practice on a date prior to May 22, 2000 or conceived on a date prior to May 22, 2000 and diligently reduced to practice thereafter" (Fact 8).

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The ‘131 affidavit further states that the attached project documents “have a date prior to May 22, 2000 and/or existed in draft form prior to May 22, 2000” (Fact 9).

The evidence submitted by the Appellants in the present appeal is similar in weight and character to the evidence submitted in *In re Borokowski*, 505 F.2d 713 (CCPA 1974) and *In re Harry*, 333 F.2d 920, 921 (CCPA 1964). In both of those cases, the court found the evidence insufficient to antedate the prior art.

In *In re Borokowski*, 505 F.2d 713 (CCPA 1974), the appellants submitted a Rule 131 affidavit to antedate a prior art patent. *Id.* at 714. The appellants asserted that they conceived and reduced to practice the disclosed and claimed subject matter prior to the filing date of the prior art patent. *Id.* at 716. The remainder of the affidavit referred to attached exhibits, including notebook pages and laboratory data, which the appellants asserted described a reduction to practice of the process of the application. *Id.* The appellants also submitted a supplemental affidavit with a supplemental progress report discussing the significance of the test runs described in the earlier-submitted exhibits. *Id.* at 717.

In determining that the original and supplemental affidavits were insufficient to antedate the prior art reference, the court in *Borokowski* stated:

The original and supplemental affidavits together with the accompanying comments do not adequately explain what facts or data appellants are relying upon to show a completion of their

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invention prior to [the effective date of the prior art]. The affidavits for the most part consist of vague and general statements in the broadest terms as to what the exhibits show along with the assertion that the exhibits describe a reduction to practice. This amounts essentially to mere pleading, unsupported by proof or showing of facts.

Id. at 718 (citing *In re Harry*, 33 F.2d 920 (CCPA 1964)). In particular, the court found that the fifteen notebook pages submitted in the exhibits to the original affidavit were not clear on their face and that “[i]t was appellants’ burden to explain the content of these notebook pages as proof of acts amounting to reduction to practice.” *Id.* at 719. The court concluded that “[a]bsent a clear explanation of the [pertinent] notebook pages pointing out exactly what facts are established therein and relied on by appellants, the affidavits based thereon are of little assistance in enabling the Patent Office and its reviewing courts to judge whether there was an actual reduction to practice of the invention.” *Id.* (citing *In re Harry, supra*).

The court in *Borokowski* acknowledged that differences exist between the requirements of interference practice and the ex parte showing of completion of an invention prior to the effective date of a patent or publication under Rule 131; nonetheless, the court upheld the board’s determination that the affidavits submitted in the case were insufficient to meet the requirements of Rule 131. *Id.* (stating that the court’s holding in *In re Spiller*, 500 F.2d 1170 (CCPA 1974), “nowhere weakens the requirement,

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under Rule 131, of a factual showing of completion of the invention before the critical date.”).

Similarly, in *In re Harry*, 333 F.2d 920, 921 (CCPA 1964), the appellant filed two affidavits attempting to antedate prior art references. The first affidavit stated that the subject matter of a drawing annexed “was diligently reduced to practice,” and the second affidavit stated that “steps were taken to reduce the invention to practice in a commercial size unit by engineering preparation of drawings, cost estimates and both construction and installation of apparatus embodying the invention was done as promptly as possible in all the circumstances.” *Id.* at 922. The court held that Rule 131 requires “not a statement that facts exist” but an “oath to facts showing a completion of the invention” and “the showing of facts shall be such, in character and weight, as to establish reduction to practice, etc.” *Id.* The court found that the appellant’s affidavits were “not proof or ‘showing of facts’ but mere pleading” and merely asserted “that facts exist but does not tell what they are or when they occurred.” *Id.*

In the case before us, the ‘131 affidavit consists of only a bald assertion in the broadest terms that the invention of claims 1-13 was either reduced to practice prior to the effective date or conceived of prior to the effective date and thereafter diligently reduced to practice.² The Appellants rely on the project documents submitted with the ‘131 affidavit as evidence

² It appears from the Appellants’ arguments in the Brief that they are submitting the affidavit to show conception prior to May 22, 2000 and diligence from a time just prior to May 22, 2000 to the date of Appellants’ filing and constructive reduction to practice on August 16, 2001. Br. 6.

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in support of this assertion. The Appellants state that the project documents “have a date prior to May 22, 2000 and/or existed in draft form prior to May 22, 2000” (Fact 9). Because the documents attached to Appellants’ affidavit may have been only in draft form prior to the effective date of the prior art, we have no way of knowing from the Appellants’ affidavit what portion of the information in the attached project documents existed prior to the effective date.

As in *Borokowski and Harry*, the Appellants’ ‘131 affidavit also fails to sufficiently explain the content of the project documents or how the information therein establishes acts amounting to reduction to practice or conception and diligent reduction to practice of the claimed invention. Thus, the Appellants’ assertion of prior invention amounts to mere pleading unsupported by proof or showing of facts of sufficient character and weight to establish prior invention by the Appellants. *In re Borokowski*, 505 F.2d at 718.

The Appellants discuss the content of the attached project documents on page 6 of the Brief, in which they contend that the charts and diagrams at pages 18, 20, and 24 “teach the invention as claimed sufficiently to enable one skilled in the art to practice the invention.” As we noted above, based on the statement in the ‘131 affidavit that these documents existed “in draft form” prior to May 22, 2000, we have no way of knowing whether the information in the charts and diagrams on pages 18, 20, and 24 existed as now shown prior to the effective date of the prior art or whether some other draft form of these pages existed prior to the effective date.

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Further, the Appellants have failed to point to the specific information on these identified pages on which they rely to show conception of the invention. Neither the ‘131 affidavit nor the arguments in the Brief establish facts sufficient to tie the information found in the charts and diagrams of the project documents to the claim limitations in a manner to show conception of even the basic invention. *See In re Spiller*, 500 F.2d 1170, 1178 (CCPA 1974) (holding a Rule 131 declaration that shows reduction to practice of the inventor’s “basic invention” is also sufficient as to claims differing therefrom in details which are obvious to one of ordinary skill in the art). As such, the attached project documents are of little assistance in enabling the Patent Office to judge whether there was conception of the invention prior to the effective date of the prior art and diligence thereafter until Appellants’ constructive reduction to practice.

The Appellants contend the Examiner improperly rejected the ‘131 affidavit because the dates on the accompanying exhibits were redacted. Br. 5. The Examiner mentioned the redacted dates only in the context of finding that “[t]he Applicants have failed to meet their burden of providing explicit facts and supporting evidence which would demonstrate diligence in reducing the invention to practice over the critical period, which in this case begins 22 May 200 and ends on the date the instant patent application was filed.” Ans. 8 (quoting Final Office Action, para. 17). The Examiner did not refer to the redacted dates in finding that the ‘131 affidavit fails to clearly set out specific facts which demonstrate that the claimed invention was conceived before the effective date of the applied references and fails to

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clearly explain which exhibits are relied upon as evidence to support which facts. Final Office Action, paras. 11 and 15. Rather, the Examiner’s determination that the ‘131 affidavit failed to establish conception before the effective date of the prior art was based on the lack of a sufficient showing of facts, as explained *supra*, to support the Appellants’ bald assertion of prior conception, and was not based on the redacted dates of the accompanying exhibits.

As to the issue of diligence, the Appellants contend that given the “relatively short period of time between [the effective date of the earliest cited reference and the date the Appellants’ application was filed], the 131 Affidavit’s express recital of due diligence is sufficient.” Br. 6. As noted by the Appellants, the time period in this case for showing diligence is approximately 15 months. *Id.* We do not agree with the Appellants’ characterization of this time period as a “relatively short period of time” for showing diligence. *Cf. In re Mulder*, 716 F.2d 1542, 1545 (Fed. Cir. 1983) (affirming the Board’s refusal to accept declarations as meeting the requirements of Rule 131 when the declarations contained no evidence showing diligence during the two-day period between the effective date of the prior art and the Appellants’ filing date). Regardless, an “express recital of due diligence” without showing any facts to support such a recital is mere pleading, which is insufficient to establish diligence. *See e.g., In re Borokowski*, 550 F.2d at 718 and *In re Harry*, 333 F.2d at 922.

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CONCLUSION

The Appellants have not shown the Examiner erred in finding that the ‘131 affidavit fails to provide sufficient evidence to antedate Navani and Dabbiere.

DECISION

The decision of the Examiner to reject claims 1-13 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

LV

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