2409-0001-25 INT

JRW 12/27/99

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 73

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAW-KUEN WU and JAMES R. ASHBURN
Junior Party,[1]

v.

CHING WU CHU
Senior Party.[2]

Patent Interference No. 102,447

Before PATE, SCHAFER, and HANLON, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

RECONSIDERATION

Junior party Wu et al. ("Wu") requests reconsideration of the FINAL DECISION UNDER 37 CFR § 1.658 mailed February 24, 1999

[1] Application 07/014,359, filed February 13, 1987. Assigned to the University of Alabama, Huntsville, AL.

[2] Application 07/300,063, filed January 23, 1989. Accorded the benefit of U.S. Application 07/012,205, filed February 6, 1987. Assigned to the University of Houston, Houston, TX.

Interference No. 102,447

(Paper No. 68). See Paper No. 70. Senior party Chu did not file an opposition.

According to Wu, the majority misapprehended or overlooked one point in rendering its decision, that point being (Paper No. 70, p. 1):

> [T]hat it was (and, for that matter, still is) customary not to specify the number of atoms of oxygen in shorthand or informal writings of the formulae of high temperature superconductors. Hence, the use by the students on whose writings the party Wu et al. relied of the notation "O" did not mean one and only one oxygen atom.

Discussion

The sole count at issue in this interference reads as follows:

> A superconducting composition exhibiting zero electrical resistance at a temperature of 77°K or above having the nominal formula:
>
> $$Y_A Ba_B Cu_C O_X$$
>
> where A is from 1.0 to 1.4; B is from 0.6 to 1.0; C is from 0.8 to 1.2 and X is from about 2 to 4. [Emphasis added.]

As discussed by the majority in the final decision, in order to prevail in the interference, Wu was required to establish, by a preponderance of the evidence, that prior to Chu's effective filing date, it reduced to practice a superconducting composition within the scope of the count. See Paper No. 68, p. 8. At final

hearing, Wu relied on a composition, identified by the formula $Y_{1.2}Ba_{0.8}CuO$, to establish an actual reduction to practice. See Paper No. 70, p. 1. However, as explained by the majority, this composition is not within the scope of the count since it contains only one oxygen atom. See Paper No. 68, p. 14.

In view of the arguments presented in Wu's request for reconsideration, two scenarios arise with respect to the number of oxygen atoms in the composition represented by the formula $Y_{1.2}Ba_{0.8}CuO$, neither of which establishes an actual reduction to practice of the subject matter of the count. The first scenario is a composition having one oxygen atom. Since the count requires a composition having "about 2 to 4" oxygen atoms, the majority correctly concluded that a composition, represented by the formula $Y_{1.2}Ba_{0.8}CuO$, which has only one oxygen atom is not within the scope of the count. See Paper No. 68, p. 14.

In the request for reconsideration, Wu argues that it is "customary not to specify the number of atoms of oxygen in shorthand or informal writings of the formulae of high temperature superconductors." Thus, the second scenario is a composition, represented by the formula $Y_{1.2}Ba_{0.8}CuO$, where the number of oxygen atoms is "unidentified" or "unknown." To the

extent that there is some merit to Wu's allegations,[3] the argument, nonetheless, misses the point. The formula, which fails to identify the number of oxygen atoms in the composition, is ambiguous. One is merely left to speculate as to the number of oxygen atoms in the composition. Accordingly, there can be no proof that a composition within the scope of the count was actually reduced to practice. As pointed out in the final decision, a party establishing an actual reduction to practice of the subject matter of a count must show a reduction to practice of each and every limitation of the count. Newkirk v. Lulejian, 825 F.2d 1581, 1582, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987); Correge v. Murphy, 705 F.2d 1326, 1329, 217 USPQ 753, 755 (Fed. Cir. 1983); Parker v. Frilette, 462 F.2d 544, 548, 174 USPQ 321, 325 (CCPA 1972); Szekely v. Metcalf, 455 F.2d 1393, 1396, 173 USPQ 116, 119 (CCPA 1972); see also Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) (to

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[3] We note that the evidence of record in this interference can be construed as contrary to Wu's position "that, in this art, it was (and, for that matter, still is) customary not to specify the numbers of atoms of oxygen in shorthand or informal writings of the formulae of high temperature superconductors" (Paper No. 70, p. 2). See generally Chu exhibits B, D, E, F, G and H (identifying the number of oxygen atoms); Wu record, p. 25 (identifying the number of oxygen atoms).

establish an actual reduction to practice, the inventor must contemporaneously appreciate the invention at issue; subsequent testing or later recognition may not be used to show that a party had contemporaneous appreciation of the invention). See Paper No. 68, pp. 8-9.

Wu further relies on statements made in a DECLARATION OF PROF. RUSTUM ROY, presented for the first time on reconsideration, to establish that "the nominal number of oxygen atoms in the party Wu et al.'s actual reduction to practice" falls within the scope of the count (Paper No. 70, p. 2). Not having been presented earlier, Prof. Roy's declaration could not have been considered at final hearing by the board, and therefore, is not subject matter for reconsideration. Manifestly, we could not have "misapprehended or overlooked" that which was not before us. 37 CFR § 1.658(b); see also Campbell v. Wettstein, 476 F.2d 642, 648, 177 USPQ 376, 380 (CCPA 1973) (no consideration can be given to documents inasmuch as the documents were not submitted in accordance with Title 37 of the Code of Federal Regulations); Moller v. Harding, 214 USPQ 730, 731 (Bd. Pat. Int. 1982), aff'd mem., 714 F.2d 160 (Fed. Cir. 1983) ("a party cannot wait until after the board has rendered a decision against him and then present new contentions in a request for

consideration"); compare Issidorides v. Ley, 4 USPQ2d 1862 (Comm'r Pats. & Trademarks 1985) (it is manifestly inefficient for a party to wait until the Commissioner indicates that there has been a failure of proof before submitting evidence; accordingly, evidence presented for the first time with a request for reconsideration will not be considered). Accordingly, we have not considered Prof. Roy's declaration.

Relying on In re Moore, 444 F.2d 572, 575, 170 USPQ 260, 263 (CCPA 1971), Wu cautions this panel against an "instinctive reaction" to disregard Prof. Roy's declaration (Paper No. 70, pp. 2-3, n.4). However, the holding in Moore, an appeal from a decision of the board in an ex parte case, is inapposite to the facts of this interference. See also In re Collins, 462 F.2d 538, 541, 174 USPQ 333, 336 (CCPA 1972) (appeal from a decision of the board in an ex parte case). Wu, the junior party in this interference, had the initial burden of establishing an earlier reduction to practice. To meet this burden, Wu's opening brief at final hearing was required to establish, by a preponderance of the evidence, an actual reduction to practice of an embodiment within the scope of the count. For the reasons discussed by the majority in the final decision, Wu failed to meet that burden and may not now, on reconsideration, supplement a deficient record.

Wu appears to attach some significance to Chu's failure to "attack Wu's evidence as not showing an embodiment within the scope of the count." Paper No. 70, pp. 1-2; Paper No. 68, p. 22; see also Paper No. 70, p. 2, n.4. However, it is simply irrelevant that Chu failed to raise this particular point in its brief at final hearing. It is well settled that Wu, as the junior party in this interference, bears the initial burden of establishing priority. 37 CFR § 1.657(b); Holmwood v. Sugavanam, 948 F.2d 1236, 1238, 20 USPQ2d 1712, 1714 (Fed. Cir. 1991). Manifestly, if the junior party has not met its initial burden of proof, the senior party will prevail in an interference regardless of whether or not it has filed an opposition brief. See Fitch v. Cooper, 139 USPQ 382 (Bd. Pat. Int. 1962) (notwithstanding uncontested nature of the case, the senior party is still presumed to be the first inventor, and the burden of proof rests upon the junior party to overcome this presumption). Therefore, the fact that Chu was silent on a matter is not an admission that the matter stands proven.

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For the foregoing reasons, we decline to modify the FINAL DECISION UNDER 37 CFR § 1.658 mailed February 24, 1999, in any respect.

RECONSIDERATION DENIED

WILLIAM F. PATE, III
Administrative Patent Judge

703-308-9797
RICHARD E. SCHAFER
Administrative Patent Judge

ADRIENE LEPIANE HANLON
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Interference No. 102,447

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