

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 67

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

EARL N. PHILLIPS, RICHARD E. FORKEY
and BRIAN E. VOLK
Junior Party¹

v.

R. CALVIN OWEN, JR., ROBERT A. GALLAGHER,
ROBERT M. MURLEY, DECEASED BY FLORENCE BURLEY, EXECUTRIX;
JULIET E. BURLEY-MASON, EXECUTRIX
Senior Party²

Interference No. 103,534

HEARD: October 22, 1998

Before URYNOWICZ, PATE and MARTIN, Administrative Patent Judges.

¹ Serial 07/915,069, filed July 16, 1992, now Patent No. 5,223,974, issued June 29, 1993.

² Serial No. 08/017,875, filed February 16, 1993. Accorded benefit of Serial No. 07/803,036, filed December 6, 1991, now Patent No. 5,204,774, issued April 20, 1993.

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URYNOWICZ, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658

The invention at issue in this interference relates to a collimator assembly for an optical device. The particular subject matter in issue is illustrated by count 1, the sole count, as follows:

Count 1

In an optical device having a single source image viewed, with binocular vision, from a first and second eyepiece assembly, a collimator assembly comprising:

a focusing lens assembly for re-imaging said source image at a substantially infinite conjugate; and

a dual decentered corrector lens assembly for creating two optical paths in said collimator assembly, each said optical path being substantially optically aligned with an associated eyepiece assembly, wherein said corrector lens assembly includes at least one optical element along each of said optical paths that is substantially afocal to wavelengths in a mid-region of a desired spectral region and refracts wavelengths outside said mid-region to reduce axial chromatic aberrations in each said eyepiece assembly.

The claims of the parties which correspond to this count are:

Phillips et al. (Phillips) : Claims 1-6, 8 and 9

Owen, Jr., et al. (Owen) : Claims 46-53

U.S. patent 5,223,974 to Phillips ('974 patent) issued June 29, 1993. On July 21, 1994, Owen added claims 46-53 to its involved application S.N. 08/017,875 ('875 application) to provoke an interference with Phillips. This proceeding was declared on December 14, 1994

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with count 1. At that time, Owen was accorded senior party status on the basis of the December 6, 1991 filing date of prior U.S. application S.N. 07/803,036, now U.S. Patent 5,204,774 ('774 patent).

Phillips filed three preliminary motions (Paper Nos. 9-11). At page 14 of its brief, Phillips asserts that "In these motions, the Junior Party requested judgment on the grounds that the Senior Party failed to provide an adequate written description that would support the language of the count, failed to provide a written description that would enable one skilled in the art to make and use the invention, and failed to provide the best mode for carrying out the invention that was known at time that the application was filed." On June 19, 1995, the Administrative Patent Judge (APJ) granted a request of Owen for a testimony period within which to take evidence with respect to these motions and deferred decision on the motions to final hearing.

Owen took testimony with respect to the issues raised in Phillips' motions; Phillips took testimony in opposition thereto. Both parties filed briefs and appeared for oral argument at final hearing.

Phillips' Position

It is urged that the involved application is non-enabling because it fails to teach one of ordinary skill in the art the requisite structural details (i) of the corrector lens assembly that relate to lens prescriptions, e.g. radius of curvature and thickness, of the individual lenses

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contained therein, (ii) of the focusing lens assembly that relate to the radii of curvature, thickness, index of refraction and spacing of each of the six different lenses contained therein, and (iii) of the spacing between the corrector lens assembly and the focusing lens assembly. The junior party asserts that the drawings of senior party's application, in particular Figure 5, cannot be relied on to derive lens prescriptions, which are on the order of fractions of a millimeter, and thus establish enablement because 1) the senior party failed to disclose the scale of the drawings, 2) the senior party failed to disclose how any of the drawings were generated, and 3) the senior party's description of the drawing of Figure 5 states that it is an exploded schematic view, on an enlarged scale.

With respect to the issue of Owen's written description, Phillips contends that Owen's application fails to describe a collimator assembly having a focusing lens assembly which includes lens structures that allow the focusing lens assembly to re-image a source image at an infinite conjugate as set forth in the count. It is asserted that there are no lens prescriptions relating to radii of curvature, thickness or spacing in the Owen specification and that Owen's own witnesses testified that the prescriptions are important.

It is urged that Owen's application fails to describe at least one optical element in the corrector lens assembly of the collimator assembly which is afocal to wavelengths in the mid-region of a given spectral range and refracts wavelengths outside the mid-region.

Phillips also contends that the Owen application fails to describe a collimator

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assembly which comprises both a focusing lens assembly and a dual de-centered corrector lens assembly as set forth in the count.

With respect to the issue of best mode, Phillips contends the senior party's patent application only broadly discloses a collimator assembly with a non-specific focusing lens assembly. Accordingly, it is urged that at the time of filing, the senior party's application failed to set forth the best mode contemplated for carrying out the invention.

Owen's Position

As to the issues of enablement, written description and best mode, Owen asserts that Phillips failed to meet its burden of proof because it submitted no timely evidence in support of its preliminary motions.

With respect to the issue of enablement, Owen contends that requiring that the lens prescription variables be present in the specification of the involved application in order to satisfy the enablement requirement is tantamount to turning the specification into a blueprint. The senior party states that none of the claims corresponding to the count requires a lens prescription for any lens element and that its involved application has not been shown to deviate from standard practice of drafting optical patents.

Concerning the issue of written description, Owen asserts that none of the claims requires any specific lens prescriptions and contends that the junior party's position that the involved application does not describe a collimator assembly with a dual de-centered corrector

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lens assembly is baseless.

With respect to the best mode requirement of 35 U.S.C. § 112, first paragraph, the senior party asserts that Phillips has not established that Owen contemplated a better mode of carrying out the invention than he disclosed.

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Burden of Proof

A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. 37 CFR § 1.637(a). Thus, Phillips has the burden of proof with respect to its motions.

Opinion

Enablement, Written Description and Best Mode:

We are of the opinion that the junior party Phillips has failed to carry its burden of establishing that Owen's involved application does not comply with any of the above requirements of 35 U.S.C. § 112, first paragraph. Phillips submitted no evidence with its preliminary motions for judgment, and the motions are based on attorney argument alone.³ It is well settled that argument of counsel cannot take the place of evidence lacking in the record. Meitzner v. Mindick, 549 F.2d 775, 782, 198 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977). A party moving under 37 CFR § 1.633(a) for judgment on the ground that an opponent's claims corresponding to the count lack written description support in its involved application has the burden of submitting with the motion proof which

³ The rebuttal evidence of Owen taken in opposition to the motion is moot, as is the evidence of Phillips taken in response thereto (surrebuttal), because Phillips submitted no evidence with its motion and Owen had no evidence to rebut. To the extent the evidence of Phillips is of the type which should have been filed in support of its motion as its case-in-chief (37 CFR § 1.601(d)), it is entitled to no consideration. 37 CFR § 1.651(c).

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prima facie establishes that the limitation in question lacks either express or inherent support in the involved application. Behr v. Talbott, 27 USPQ2d 1401, 1407 (Bd. Pat. App. & Int. 1992). It is considered that the same burden is present where the charge is lack of enablement or best mode.

Not having submitted any evidence in support of its preliminary motions for judgment, the motions are denied for lack of evidence.

Priority:

At page 16 of its reply brief, the junior party states that “Phillips has not raised priority of invention as an issue because, given the deficiencies in Owen’s specification under 35 U.S.C. § 112, priority need not be resolved”. Whereas 1.) the junior party Phillips has chosen not to contest priority of invention in this proceeding, 2.) Phillips has not established that the application of Owen is not in compliance with 35 U.S.C. § 112, first paragraph, and 3.) the party Owen enjoys senior party status, the party Owen is entitled to prevail herein as the prior inventor.

Judgment

Judgment as to the subject matter of count 1, the sole count, is awarded to R. Calvin Owen, Jr., Robert A. Gallagher and Robert M. Burley, the senior party. On the present record, the party Owen is entitled to a patent with claims 46-53. The party Phillips is not entitled to its patent with claims 1-6, 8 and 9.

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STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

WILLIAM F. PATE, III
Administrative Patent Judge

JOHN C. MARTIN
Administrative Patent Judge

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