

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

~~Ex parte~~ GILBERT P. HYATT

Appeal No. 95-2551  
Application 07/468,430

MAILED

MAY 22 1996

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

HEARD: May 9, 1996

Before CARDILLO, JERRY SMITH and LEE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-57, which constitute all the claims in the application.

The claimed invention pertains to a computer system having dynamic memory components.

<sup>1</sup> Application for patent filed January 22, 1990.

Representative claim 1 is reproduced as follows:

1. A computer system comprising:

a plurality of operator switches generating switch signals and

a serial encoder coupled to the plurality of operator switches and generating a serial encoded signal having the switch signals encoded therein in response to the switch signals;

a serial interface circuit coupled to the serial encoder and generating a computer input signal in response to the serial encoded signal;

an integrated circuit read only memory storing computer instructions;

an integrated circuit dynamic MOS memory storing computer operands;

a dynamic memory address generator generating a first dynamic memory address and a second dynamic memory address;

a dynamic memory address multiplexer coupled to the dynamic memory address generator and generating a multiplexed dynamic memory address by multiplexing the first dynamic memory address and the second dynamic memory address;

a dynamic memory accessing circuit coupled to the integrated circuit dynamic MOS memory and to the dynamic memory address multiplexer and accessing computer operands stored by the integrated circuit dynamic MOS memory in response to the multiplexed dynamic memory address;

an integrated circuit processor coupled to the integrated circuit read only memory, to the dynamic memory accessing circuit, and to the serial interface circuit and executing the computer instructions stored by the integrated circuit read only memory to process the accessed computer operands in response to the computer input signal;

a refresh control circuit periodically generating a refresh signal to command refresh of the computer operands stored by the integrated circuit dynamic MOS memory;

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a dynamic memory refresh circuit coupled to the integrated circuit dynamic MOS memory and to the refresh control circuit and refreshing the computer operands stored by the integrated circuit dynamic MOS memory in response to the refresh signal without conflict with the accessing of the computer operands by the dynamic memory accessing circuit;

a shift register coupled to the dynamic memory accessing circuit and generating a serial display refresh signal to refresh a display by shifting the accessed computer operands; and

a display coupled to the shift register and generating a refreshed display image in response to the serial display refresh signal.

The examiner relies on the following evidence:

Gilbert P. Hyatt et al. (Hyatt), "Justifiable DNC," Proceedings of the 8th annual meeting and technical conference of the Numerical Control Society, March 1971, pages 74-100.

Claims 1-57 stand rejected under 35 U.S.C. § 102(b) as being in public use or on sale in this country more than one year prior to the date of application for patent in the United States as indicated by the above-cited Hyatt article.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of public use or sale relied upon by the examiner as support for

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the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence as furnished by the examiner and appellant does not support the alleged improper public use or sale of the invention as set forth in claims 1-57. Accordingly, we reverse.

As noted above in the citation of evidence, the Hyatt article was published in March of 1971. The examiner has apparently conceded that Appellant is entitled to an effective filing date of December 28, 1970, which corresponds to application serial number 101,881, which application is claimed for benefits under 35 U.S.C. § 120. Thus, the Hyatt article was published after the effective filing date claimed by appellant. The examiner recognizes that Hyatt is not available as a printed publication prior art reference, but asserts that Hyatt is evidence of public use or sale of the invention more than one year before the effective filing date in the United States.

The examiner's position is based upon the fact that there is a figure on page 87 of Hyatt which is similar to Fig.-2A of this application. The figure in question shows a control panel

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for use with a computer system. The examiner concludes that the use of essentially the same figure in Hyatt and the patent application demonstrates that the subject matter of the invention of this application is the same subject matter described in Hyatt. The one year connection needed to make the rejection was concluded from a statement in Hyatt that "[o]ne production version of the NU-TROLLER IV...went into production in 1969" [Hyatt, page 75]. The examiner has indicated that until evidence to the contrary was furnished, the production date of 1969 was presumed to satisfy the one year statutory bar of prior public use or sale. The examiner called upon appellant to furnish additional information to resolve this issue.

Appellant filed a declaration on December 23, 1993 in an effort to supply factual evidence that there was no public use or sale of the claimed invention more than one year before the effective filing date of application for patent in the United States. The examiner considered the statements in the declaration and determined that each of them was insufficient to rebut the examiner's case of prior public use or sale as alleged in the rejection.

The examiner indicates that the rejection in this application has been made in accordance with the Federal Circuit decision in In re Epstein, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994). We find the examiner's position consistent with

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certain parts of this decision, but contrary to other parts of this decision. The examiner can be deemed in view of Epstein to have properly shifted the burden to appellant of coming forward with evidence to rebut the examiner's case of improper public use or sale. That is, the examiner can be said to have raised a reasonable concern under section 102(b), and the request for additional information was appropriate since appellant would be expected to have pertinent information readily available. The error in the examiner's position primarily lies in his failure to objectively consider the evidence. The examiner has essentially ignored the evidence submitted by appellant in the declaration.

As noted above, the basis for the examiner's rejection comes from a statement in the Hyatt article that the NU-TROLLER IV went into production in 1969. In the declaration submitted by appellant, appellant states that the phrase "went into production in 1969" was intended to mean that building a production version was commenced in 1969. Appellant adds that the device described in the article was not delivered to a customer until after December 28, 1969 [declaration, para. 3]. The examiner has refused to accept this explanation because the examiner insists that "going into production" implies at least one customer who has ordered at least one version of the machine.

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What the phrase "going into production" implies is a rebuttable presumption of what the phrase means. Nobody is more qualified to speak to the intended meaning of the phrase than the author of the article. The author of the article states under penalty of perjury that the inference drawn by the examiner from the phrase in the article is contrary to what was intended by use of the phrase. The examiner cannot continue to insist on an inference to be drawn from the article when the author specifically declares that the inference is not correct. We do not say that the thing inferred by the examiner is necessarily untrue or rebutted by the declaration, only that the inference of what the phrase "going into production" means has been properly rebutted.

The declaration filed by appellant also states that the NU-TROLLER IV contained static scratch pad memories and a static core memory. Appellant asserts that the NU-TROLLER IV did not embody the claimed invention because the claims on appeal require an integrated circuit main memory and claims 1-36 and 40-57 also require an integrated circuit scratch pad memory. Thus, regardless of when the NU-TROLLER IV was legally in public use or on sale, the device did not contain specific features of the claimed invention according to appellant.

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As the Federal Circuit said in Epstein, supra, "the question is not whether the sale, even a third party sale, 'discloses' the invention at the time of the sale, but whether the sale relates to a device that *embodies* the invention." Appellant has stated under penalty of perjury that there are specific recited elements of the claimed invention which were not embodied in the NU-TROLLER IV device when it was sold. The examiner has no reasonable basis to challenge the truth of these statements and, therefore, must accept these statements under penalty of perjury as being true.

The examiner considered these statements by appellant that the NU-TROLLER IV did not embody the claimed invention. The examiner responded that "such claimed dynamic MOS memory or associated dynamic access and control circuitry are 'equivalents' to core memory" [answer, page 4]. If the examiner means by equivalents that the two memories are capable of performing equivalent functions, such a rationale is not acceptable for holding that the NU-TROLLER IV device embodied the claimed invention anyway. A dynamic MOS memory is not structurally the same as a static core memory. Even if the different structures are capable of functional substitution, such a fact is not sufficient to state that the two structures are the same. There can be many different structures which carry out identical functions, and these different structures do not automatically

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anticipate each other within the meaning of 35 U.S.C. § 102. The claims are directed to specific structure, and not to the functions performed by that structure. Appellant has positively shown that the claimed structure is different from the structure embodied in the NU-TROLLER IV device, and the examiner has failed to properly consider this fact.

Finally, the examiner has dismissed the statements made by appellant in the declaration as being "self serving." The examiner has indicated that such statements are, therefore, treated as arguments which attempt to take the place of evidence of record and such arguments cannot take the place of evidence [answer, page 4]. The examiner's position as postulated here is simply erroneous.

In the situation where evidence is required to overcome a rejection and an applicant does not submit any evidence, then any statements made by applicant can be treated as simple arguments. Note In re DeBlauwe, 736 F.2d 699, 222 USPQ 191 (Fed. Cir 1984). That situation is not presented here because appellant has submitted a declaration containing statements of fact. Such statements of fact cannot be dismissed as being self serving. If a declarant is stating an opinion about something, then the personal interest the declarant has in the matter can be a factor in assessing the persuasive weight to be given to the opinion. If a declarant is stating facts, however, these facts must be

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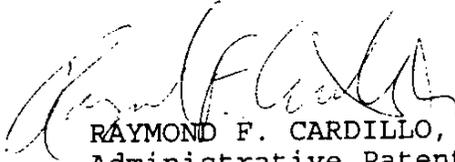
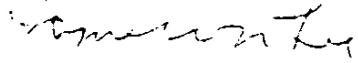
accepted as true unless the examiner has a reasonable basis for questioning the accuracy of the statements. Declarant's statements here about what elements of the claimed invention were not embodied within the NU-TROLLER IV device are facts and not opinions. The claimed dynamic memory components were not part of the NU-TROLLER IV device which was sold at some time because declarant states that they were not part of the device under penalty of perjury. Thus, the examiner cannot ignore these facts submitted by appellant simply because they are in the appellant's self interest.

In conclusion, the examiner raised the issue of prior public use or sale and invited appellant to submit evidence to rebut the examiner's case. Appellant did in fact submit evidence that the examiner's position was erroneous. The evidentiary facts submitted by appellant have gone unchallenged. The evidence submitted by appellant indicates that the inference of public use or sale made by the examiner was incorrect. Viewing all the evidence objectively, we find that appellant has successfully demonstrated that the examiner's position cannot be

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supported. Accordingly, the decision of the examiner rejecting claims 1-57 as violating the public use or sale bar of 35 U.S.C. § 102(b) is reversed on the evidence before us.

REVERSED

  
RAYMOND F. CARDILLO, JR. )  
Administrative Patent Judge) )  
)  
  
JERRY SMITH )  
Administrative Patent Judge) )  
)  
  
JAMESON LEE )  
Administrative Patent Judge)

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Gilbert P. Hyatt  
P.O. Box 1230  
Las Vegas, Nevada 89180