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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SHINPEI OKAJIMA

Junior Party
(Application 08/665,679),

v.

JOEL BOURDEAU

Senior Party
(Application 08/676,928).

Patent Interference No. 104,193

HEARD: August 9, 2000

Before McKELVEY, Senior Administrative Patent Judge, and LEE and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

FINAL DECISION AND JUDGMENT UNDER 37 CFR § 1.658(a)

A. Introduction

A decision on preliminary motions was rendered October 20, 1999. (Paper 43). The decision included an order to show cause why judgment should not be entered against party Okajima[1]. (Paper 43 at 21). In response to the order to show cause, Okajima stated that it would accept judgment against it on the issue of priority. (Paper 45). However, Okajima made a request for final hearing to review the administrative patent judge's decision denying Okajima's preliminary motion 2 for judgment against Bourdeau's claims 13-24 and 26-28 in view of various prior art. (Paper 45).

Party Bourdeau filed a request for final hearing to review the administrative patent judge's decision (1) granting Okajima's preliminary motion 1 to designate Bourdeau's claims 13-24 and 26 as corresponding to the count; and (2) denying Bourdeau's preliminary motion 2 to designate Okajima's claims 18-20 as corresponding to the count. (Paper 44).

In its principal brief, Bourdeau states that it no longer seeks review of the granting of Okajima's preliminary motion 1. (Paper 49 at 1). In addition to its principal

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[1] Bourdeau's unopposed preliminary motion for benefit of its French application 95.08587, filed July 11, 1995 was granted. (Paper 43 at 15). In its preliminary statement, Okajima indicates that it shall rely on its filing date of June 18, 1996.

brief, Bourdeau has filed a motion to exclude certain evidence submitted by Okajima. (Paper 52).

A final hearing was held on August 9, 2000.

B. Findings of Fact

1. The interference was declared on April 30, 1998.

2. Okajima is involved on the basis of U.S. application 08/665,679, filed June 18, 1996.

3. Bourdeau is involved on the basis of U.S. application 08/676,928, filed July 8, 1996.

4. By virtue of a decision of Bourdeau's preliminary motion 1, Bourdeau has been accorded the benefit for the purpose of priority of French application 95.08587, filed July 11, 1995. (Paper 43 at 15).

<u>Okajima's brief</u>

5. Okajima maintains that Bourdeau's claims 13-24 and 26-28 are unpatentable in view of various prior art. (Paper 45 at 1).

6. In its preliminary motion 2 (Paper 13½), Okajima moved for judgment against Bourdeau's claims 13-24 and 26-28 based on alternate theories that Bourdeau's claims 13-24 and 26-28 were unpatentable under 35 U.S.C. § 103 over:

a) European Patent Office Publication 356 400 (EP '400), published February 28, 1990 in view of German

Offenlegungsschrift DE 3,622,746 (DE ‘746), published January 21, 1988;

b) German Offenlegungsschrift DE 4,333,503 (DE ‘503), published April 6, 1995, in view of EP ‘400 and DE ‘746; or

c) U.S. patent 5,401,041 (US ‘041), issued March 28, 1995 in view of EP ‘400 and DE ‘746[2]. (Paper 13½ at 8-20).

7. Okajima, in its brief, submits that Bourdeau’s claims 13-24 and 26-28 are unpatentable under 35 U.S.C. § 103 over DE ‘503 and/or US ‘041 in view of EP ‘400 alone or in combination with DE ‘746, Austrian publication 399 637 B (AT ‘637), or U.S. patent US ‘622. (Paper 51 at 24).

8. In its brief, Okajima additionally argues that claim 17 is unpatentable under 35 U.S.C. § 112. (Paper 51 at 34).

Bourdeau’s Motion to Suppress

9. Bourdeau filed a motion to exclude Okajima’s exhibits OX9, OX10, OX11, and OX12. (Paper 52).

10. Okajima’s exhibit OX9 is AT ‘637.

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[2] Okajima argues that claim 19 is unpatentable based on the third alternative only. (Paper 13½ at 13).

Okajima argues that claim 24 is unpatentable based on the three alternatives. However, in the last alternative, Okajima further relies on U.S. patent 3,584,622 (US ‘622), issued June 15, 1971. (Paper 13 ½ at 16).

Okajima argues that claims 27 and 28 are unpatentable based on the three alternatives, less the DE ‘746 reference. (Paper 13 ½ at 18-20).

11. Okajima's exhibit OX10 is U.S. Patent 4,779,892 (US '892), issued October 25, 1988.

12. Okajima's exhibit OX11 is U.S. Patent 4,699,396 (US '396), issued October 13, 1987.

13. Okajima's exhibit OX12 is U.S. Patent 4,688,822 (US '822), issued August 25, 1987.

Bourdeau's brief

14. Bourdeau maintains that Okajima's claims 18-20 should be designated as corresponding to the count. (Paper 49).

The invention

15. The interfering subject matter relates to a snowboard boot with a leg member and a heel member pivotally attached at a location that is offset from the longitudinal median plane of the boot.

16. The count is identical to Bourdeau's claim 27 and is as follows:

> A snowboard boot comprising:
>
> a heel member;
>
> a leg member positioned above the heel member;
>
> wherein the heel member is pivotally attached to the leg member at a pivot location so that the leg member is capable of movement relative to the heel member about an axis of rotation that passes through the pivot location;

wherein the axis of rotation is inclined from rear to front and from top to bottom;

wherein the pivot location is offset from the longitudinal median plane; and

wherein the axis of rotation forms an angle with the longitudinal median plane.

Okajima's claim 18

17. Okajima's independent claim 18, which Bourdeau seeks to designate as corresponding to the count is as follows:

A pair of snowboard boots comprising:

a first snowboard boot including:

a first heel member;

a first leg member positioned above the first heel member;

wherein the first heel member is pivotally attached to the first leg member at a first pivot location so that the first leg member is capable of movement relative to the first heel member about a first axis of rotation that passes through the first pivot location;

wherein the first axis of rotation is vertically inclined no more than +/- 45°;

wherein the first axis of rotation lies within a first plane that is inclined relative to a longitudinal second plane of approximate symmetry which divides left and right sections of the first boot;

wherein the first pivot location is spaced apart from the second plane of approximate symmetry;

a second snowboard boot including:

a second heel member;

a second leg member positioned above the second heel member;

wherein the second heel member is pivotally attached to the second leg member at a second pivot location so that the second leg member is capable of movement relative to the second heel member about a second axis of rotation that passes through the second pivot location;

wherein the second axis of rotation is vertically inclined no more than +/- 45°;

wherein the second axis of rotation lies within a third plane that is inclined relative to a longitudinal fourth plane of approximate symmetry which divides left and right sections of the second boot;

wherein the second pivot location is spaced apart from the fourth plane of approximate symmetry; and

wherein an angle of inclination between the first plane and the second plane of approximate symmetry is greater than an angle of inclination between the third plane and the fourth plane of approximate symmetry.

18. Okajima's specification defines the term "plane of approximate symmetry" on pages 4-5 and 9 of application 08/665,679.

19. The "plane of approximate symmetry" is defined on pages 4-5 of Okajima's specification as follows:

> ... when the shoe is placed on a horizontal plane, the heel section is approximately symmetrical with respect to a vertical longitudinal plane which contains a line in the longitudinal direction. This approximately symmetrical plane is referred to herein as the 'plane of approximate symmetry.'

20. The “plane of approximate symmetry” is defined on page 9 of Okajima’s specification as follows:

> When the boots are fixed to the snowboard, the plane of approximate symmetry of each snowboard boot can be defined as follows. When the insides of both feet are placed together so as to touch lightly at two points while standing erect, the plane of approximate symmetry is the vertical plane that is parallel to the plane containing these two points, and that contains the back end point of the heel section, which has an approximately spherical surface shape.

The prior art

21. DE ‘503 (Okajima exhibit OX2) describes a snowboard boot with a heel member 13 and a leg member 16 pivotally connected by 18 at the rear of the boot.

22. The pivot location appears to be along the line of the longitudinal median plane of the boot and not offset from the longitudinal median plane.

23. US ‘041 (Okajima exhibit OX3) describes a snowboard boot with a heel member 16 and a leg member 28 pivotally connected by 34 at the rear of the boot.

24. The pivot location is along the line of the longitudinal median plane of the boot and not offset from the longitudinal median plane.

25. EP ‘400 (Okajima exhibit OX1) describes a ski boot with a heel member 19 and a leg member 10 pivotally connected at two locations 13 and 15 on either side of the boot.

26. The two pivot locations 13 and 15 are offset from the longitudinal median plane of the boot.

27. DE ‘746 (Okajima exhibit OX4) describes a binding for a mono-ski with a heel member 3 and a leg member 2 pivotally connected by 8 at the rear of the binding.

28. The pivot location is along the line of the longitudinal median plane of the binding and not offset from the longitudinal median plane.

29. AT ‘637 (Okajima exhibit OX9) describes a snowboard shoe with a heel member 1 and a leg member M and a sole 2, whose sole is varied between low hardness 4, 5c and high hardness 5, 6 so that the leg of a wearer of the snowboard shoe is capable of tilting forward and inward.

30. US ‘622 (Okajima exhibit OX5) describes a support device for prevention of ankle injuries.

C. Discussion

Standard of Review

Although the substantive issues before us were raised in preliminary motions which were decided by a single judge in a Decision on Preliminary Motions (Paper 43), those decisions are not entitled to deference by this three judge panel. See § 1.655(a) as amended effective March 16, 1999, which provides that "[t]he abuse of discretion standard shall apply only to

procedural matters." Consideration of Interlocutory Rulings at Final Hearing in Interference Proceedings, 64 Fed. Reg. 12900, 12901 (March 16, 1999).

Bourdeau's Brief

Bourdeau maintains that Okajima's claims 18-20 should be designated as corresponding to the count. Okajima claim 18 is an independent claim. Okajima claim 19 depends on claim 18. Okajima claim 20 depends on claim 19.

At the heart of the issue is how the term "plane of approximate symmetry" should be interpreted with respect to Okajima's claim 18. Okajima's claim 18 recites "[a] pair of snowboard boots." Okajima's specification defines the term "plane of approximate symmetry" in two locations, pages 4-5 and 9. The first definition is directed to a single boot. (Finding 19). The second definition is directed to a pair of boots. (Finding 20). The first and second definitions are different. The plane of approximate symmetry will be different depending on which definition applies.

Bourdeau contends, and it is not disputed, that the first definition of the "plane of approximate symmetry" is the same as the longitudinal median plane" recited in Bourdeau's claim 27 (the count). (Paper 49 at 7). Bourdeau does not suggest that Okajima's second definition of the "plane of approximate

symmetry" is the same as the "longitudinal median plane" of Bourdeau claim 27 (the count). Rather, Bourdeau argues that the second definition of the "plane of approximate symmetry" will be consistent with the first definition where the widths of the front and rear portions of each of a pair of boots are the same, as allegedly shown in Okajima's figures. Okajima's claims 18-20 should be interpreted such that the widths of the front and rear of a boot are the same, Bourdeau argues, in order for the term "plane of approximate symmetry" to be given the same meaning throughout all of Okajima's claims as required by law, citing to Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1331, 52 USPQ2d 1590, 1598 (Fed,. Cir. 1999); Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579, 34 USPQ2d 1673, 1679 (Fed. Cir. 1995); Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987), cert, denied, 484 U.S. 1027 (1988). (Paper 49 at 7-9).

Bourdeau's arguments are not persuasive. First, while we agree that generally a claim term cannot be given a different meaning in the various claims of the same patent, there are exceptions to this rule of law. In none of the cited cases are the facts similar to those before us. Here, there are two definitions for a given term. Here, one definition applies to

claims reciting a single boot and the other definition applies to claims reciting a pair of boots.

In Georgia-Pacific, the Federal Circuit held that it was an error to interpret a claim term to have one meaning with respect to one set of claims and a different meaning with respect to another set of claims. The Federal Circuit held that a claim term cannot be given a different meaning in the various claims of the same patent "absent any indication that a different meaning was contemplated." 195 F.3d at 1331, 52 USPQ2d at 1598. In Georgia-Pacific, the disputed term was not defined in the specification. Here, the disputed term is not only defined in Okajima's specification, but defined in two ways, indicating that different meanings had been contemplated depending on the context on which the term is used.

In Southwall, the issue was whether the remarks made as part of the prosecution history applied to all of the claims with the disputed term, even though a particular claim was not mentioned during prosecution history. The Federal Circuit held that "arguments made during prosecution regarding the meaning of a claim term are relevant to the interpretation of that term in every claim of the patent absent a clear indication to the contrary." 54 F.3d at 1579, 34 USPQ2d at 1679. In Southwall, the Federal Circuit found that the

prosecution history discussing the disputed term was applicable for determining the meaning of the term in all of the claims. In Southwall, there was not, as there is here, two definitions in the specification for the disputed term. Unlike in Southwall, here the prosecution history tends to show that the "plane of approximate symmetry" has a different meaning for Okajima's claims 18-20. Note Okajima's argument that the term "plane of approximate symmetry" has a different meaning for its claims 18-20. (Paper 55 at 3-5).

Likewise, in Fonar Corp., the disputed term did not have more than one definition in the specification. Nor was there prosecution history tending to show that the disputed term should be interpreted inconsistently from other claims using the same term, as there is here. Thus, the facts before us are distinguishable from the facts in the above cited cases.

Bourdeau asserts that Okajima's Figs. 1-7, 10 and 12 show boots where the "plane of approximate symmetry" is the same as the longitudinal plane. (Paper 49 at 8). But only Fig. 10 of Figs. 1-7, 10 and 12 shows a pair of boots[3]. The rest of Okajima's figures show a single boot. The figures showing a single boot are consistent with the first Okajima definition

[3] Okajima Fig. 11 is the only other figure that shows a pair of boots. There, the plane of approximate symmetry is not illustrated.

of “plane of approximate symmetry”, where the “plane of approximate symmetry” is the same as the longitudinal median plane of Bourdeau claim 27 (the count). While Fig. 10 does appear to show a pair of boots where each boot has a plane of approximate symmetry which is the same as the longitudinal median plane, the figure is a mere abstract representation for illustrating the Okajima page 9 definition of the “plane of approximate symmetry”, as further discussed below.

Okajima’s Fig. 10 shows two ellipses representing a pair of boots. There is nothing in Okajima’s specification to indicate that the ellipses are actual designs of snowboard boots, where the front and rear widths of the boots are the same. Bourdeau has not sufficiently explained, or established, why one of ordinary skill in the art would not view the ellipses of Okajima’s Fig. 10 as an illustration for how the “plane of approximate symmetry” is determined. The illustration of Fig. 10 would be similar to the situation where the snowboard boots were represented by two rectangles. Such a figure would not convey that the snowboard boots are actually in the shape of rectangles. Rather, we believe that one of ordinary skill in the art would interpret such a drawing to be illustrative of the concept to be conveyed, e.g. how to determine the “plane of approximate symmetry” for each

of a pair of boots. For the foregoing reasons, we are unpersuaded by Bourdeau's argument that when interpreted in light of Okajima's figures and specification, the term "plane of approximate symmetry" as it applies to Okajima's claim 18 is the same as the "longitudinal median plane" of Bourdeau claim 27 (the count).

Bourdeau additionally argues that even if the second definition is interpreted inconsistently with the first definition for the term "plane of approximate symmetry", Okajima's claim 18, when broadly construed, would cover snowboard boots with planes of approximate symmetry that are the same as the longitudinal median plane. (Paper 49 at 8). This does not mean however, that the subject matter of Okajima's claims 18-20 would have been obvious given the subject matter of Bourdeau's claim 27 as prior art. Even though Okajima's claim 18 may "cover" snowboard boots whose front and rear widths are the same, does not mean that one having ordinary skill in the art knew of such snowboard boots or that such snowboard boots existed. Further, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). Claim 27 does not recite the

shape of a boot either, and Bourdeau has failed to direct us to sufficient and credible evidence which show that one of ordinary skill in the art knew of snowboard boots whose rear and front widths are equal. The fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 12666 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

Bourdeau argues in its reply that:

> even if the Board does not find the two planes to be the same as a matter of law, the two planes are nevertheless practically the same. Both planes pass through the center of the heel and are used simply as a reference point. (Paper 56, Introduction at 1).

The above quoted remark is found under the heading "Introduction" which precedes the section entitled "Reply to the Specific Points Raised By Okajima". (Paper 56 at 1-2). The rule regarding a reply states that a "reply shall be directed only to new points raised in the opposition." 37 CFR § 1.638(b). The above quoted argument was not in response to new points raised in Okajima's opposition.

Bourdeau reiterated this new argument at final hearing. What we understand Bourdeau's new argument to be is that even if the "plane of approximate symmetry" and the "longitudinal

median plane” have different meanings, both planes pass through the center of the heel, and as a practical matter, if a pivot is offset from one plane it is also offset from the other plane, and that the exact location of the offset of the pivot would be a matter of routine optimization and obvious to one with ordinary skill.

The problem with Bourdeau’s new argument made in its reply and at final hearing is that Okajima had no meaningful opportunity to present evidence to respond to the new argument. Okajima might have demonstrated that an offset from one reference plane does not equate to an offset from the other reference plane, or that an optimized angle from one reference plane may not be an optimized angle with respect to the other reference plane. The new argument was not raised in Bourdeau’s original motion or in Bourdeau’s principal brief. Since Okajima has had no meaningful opportunity to rebut the newly presented argument made by Bourdeau in its reply brief and at final hearing, we decline to consider the argument on its merits or to express any views as to its soundness.

For the foregoing reasons, Bourdeau has failed to demonstrate that Bourdeau’s preliminary motion 2 to designate Okajima’s claims 18-20 as corresponding to the count was improperly denied.

Okajima's Brief

Okajima maintains that Bourdeau's claims 13-24 and 26-28 are unpatentable under 35 U.S.C. § 103 over DE '503 and/or US '041 in view of EP '400 alone or in combination with DE '746, AT '637 or US '622. (Paper 51 at 24).

At the outset, we note that Bourdeau in its opposition argues that the combination of references Okajima relies upon to demonstrate that Bourdeau's claims are unpatentable is different than the combination of references relied upon in Okajima's preliminary motion 2. (Paper 53 at 16-17). Bourdeau argues that the Board should not consider the new arguments because a "party shall not be entitled to raise for consideration at final hearing any matter which properly could have been raised by a motion ..." 37 CFR § 1.655(b). (Paper 53 at 17).

We agree that the references Okajima relied upon in its preliminary motion 2 have been applied differently in its brief. (Findings 6 and 7). The new rationale should not be considered. Alternatively, we have considered the merits of Okajima's new rationale and find that in any event Okajima has failed to prove a prima facie case of obviousness.

Bourdeau claims 13, 27 and 28 are independent claims. Bourdeau claims 14-24 and 26 depend either directly or

indirectly on claim 13. Bourdeau claim 13 requires that the journal attachment be positioned on a medial side of the boot, along a journal axis forming an angle of between 20° and 40° with respect to the longitudinal median plane of the boot. Bourdeau claims 27 and 28 require that the heel member (claim 28 - rear portion) and leg member (claim 28 - rigid back portion) of the boot be pivotally attached at a pivot location that is offset from the longitudinal median plane.

Okajima argues that DE ‘503 and/or US ‘041 teach the features of Bourdeau’s claims 13, 27 and 28 with the exception of the pivot being offset from the longitudinal median plane. (Paper 51 at 30-31). Okajima relies on EP ‘400 to teach the claimed pivot location. Okajima argues that the motivation to combine DE ‘503 and/or US ‘041 with DP ‘400 may be found in AT ‘637 and DE ‘746. (Paper 51 at 31-33).

We disagree that there is a suggestion or teaching in the prior art of record to make the modification to either the DE ‘503 or US ‘041 snowboard boot such as to offset the journal from the longitudinal median plane of the boot as claimed in Bourdeau claims 13, 27 and 28. EP ‘400 describes a ski boot with two journals 13 and 15 located on opposite sides of a ski boot. (Findings 25 and 26). The journals are offset from each other to provide a swiveling action longitudinally and

slightly inwardly. While the location of the journals allow for a slightly inward bend of the wearers lower leg (Fig. 1 (d)), the journals 13 and 15 on opposite sides of the boot would appear to hinder or obstruct most lateral movement by the wearer. In contrast, DE ‘503 and US ‘041 teach snowboard boots where substantial lateral movement by the wearer is not only possible but desirable. Why then would one of ordinary skill in the art look to EP ‘400 to arrive at the claimed invention? Okajima has failed to provide a sufficient reason.

Likewise, AT ‘637 would not have reasonably suggested modifying either DE ‘503, US ‘041 and/or EP ‘400. AT ‘637 describes a snowboard shoe whose sole has varying stiffness. The design of the shoe sole allows downward and inward motion of the wearers lower leg. Although AT ‘637 does suggest a solution to the problem, e.g. a design that allows a wearer’s leg to bend downward and forward, the solution is different than the claimed pivot located offset from the longitudinal median plane of the boot. Similarly, while DE ‘746 shows a binding design that allows the wearer’s lower leg to bend downwardly and inwardly, the pivot location of the binding is located along the longitudinal plane and is not offset therefrom. The teachings of DE ‘746 do not make up for the lack of suggestion from any of the aforementioned references

to motivate one of ordinary skill in the art to modify either US ‘041 and/or DE ‘503 and/or EP ‘400 as is proposed by Okajima. Lastly, US ‘622 describes an ankle brace for preventing injury to the wearer’s ankle. US ‘622 appears to have little, if any relevance to the claimed subject matter.

We find that Okajima’s suggestion that one skilled in the art would have been motivated to modify the DE ‘503 and/or US ‘041 boot in view of EP ‘400, DE ‘746, AT ‘637 and/or US ‘622 to arrive at the claimed invention can only be made with the benefit of knowledge found in Bourdeau’s disclosure. It is improper to rely on Bourdeau’s own disclosure as motivation for combining the prior art. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."); In re McLaughlin, 443 F. 2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (obviousness judgments are necessarily based on hindsight; so long as judgment takes into account only knowledge known in the art, there is no error.).

Lastly, we note that Okajima argues that Bourdeau claim 17 is unpatentable under 35 U.S.C. § 112, since Bourdeau claim 17 is a duplicate of Bourdeau claim 14. (Paper 51 at 34). In response, Bourdeau states that it will cancel claim 17. (Paper 53 at 21). We construe that response as an agreement that claim 17 is a duplicate and thus is unpatentable. Therefore, we grant Okajima's motion for judgment against Bourdeau's claim 17.

For the foregoing reasons, Okajima's motion for judgement against Bourdeau's claim 17 as being unpatentable is granted. Okajima's motion for judgment against Bourdeau's claims 13-16, 18-24 and 26-28 as being unpatentable is denied.

Bourdeau's Motion to Exclude Evidence

Bourdeau moves to suppress Okajima's exhibits OX9-OX12. Okajima does not rely on its exhibits OX10-OX12 to support its argument that Bourdeau's claims 13-24 and 26-28 are unpatentable. Rather, Okajima's exhibits OX10-OX12 are relied upon in its discussion of why Bourdeau's claims 13-24 and 28 properly correspond to the count. Whether Bourdeau's claims 13-24 and 28 should correspond to the count is not an issue before us and therefore we need not consider whether Okajima's exhibits OX10-OX12 should be suppressed.

Further, we find it unnecessary to consider the specific objections to the admissibility of Okajima's exhibit OX9, since Okajima has failed to make a prima facie case of obviousness against Bourdeau's claims even assuming OX9 to be admissible.

Accordingly, Bourdeau's motion to suppress is dismissed as moot.

D. Judgment

Upon consideration of the record, it is

ORDERED that judgment on priority as to Count 1, the sole count in the interference, is awarded against junior party SHINPEI OKAJIMA.

FURTHER ORDERED that junior party SHINPEI OKAJIMA is not entitled to a patent containing claims 1-4, 6-11 and 21 of US application 08/665,679, filed June 18, 1996, which correspond to count 1.

FURTHER ORDERED that judgment is entered against BOURDEAU with respect to its claim 17.

FURTHER ORDERED that BOURDEAU is not entitled to a patent containing claim 17 of US application 08/676,928, filed July 8, 1996, which corresponds to count 1.

FURTHER ORDERED that if there is any settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

FRED E. McKELVEY, Senior Administrative Patent Judge	)	
JAMESON LEE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
SALLY C. MEDLEY Administrative Patent Judge	)	

cc (first class mail):

Counsel for party Okajima:

James A. Deland
2010 Crow Canyon Place, Suite 100
San Ramon, CA 94583-5611

Counsel for party Bourdeau:

Michael J. Fink
Greenblum & Bernstein, P.L.C.
1941 Roland Clark Place
Reston, VA 20191