

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(2) is not binding precedent of the Board.*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. 150

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

BENJAMIN S. TING,

Junior Party,¹

v.

THOMAS A. KEAN,

Senior Party.²

Patent Interference No. 103,833

JUDGMENT UNDER 37 CFR § 1.640(e)

¹ Involved on two cases:

(1) Patent No. 5,457,410, issued October 10, 1995, based on Application Serial No. 08/101,197, filed August 3, 1993.

Assigned to
BTR, INC.; and

(2) Application Serial No. 09/028,769, filed February 24, 1998, for reissue of Patent No. 5,457,410.

² Application Serial No. 08/623,715, filed March 29, 1996. Assigned to XILINX, INC. Accorded the benefit with respect to Count 1 of: U.S. application Serial No. 08/486,464, filed June 7, 1995 (now Patent No. 5,552,722); U.S. application Serial No. 08/148,793, filed November 5, 1993 (now Patent No. 5,469,003); and UK application No. 92 232 26.3, filed November 5, 1992.

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Before METZ, PATE, and MARTIN, Administrative Patent Judges.
MARTIN, Administrative Patent Judge.

Page 62 of the "DECISIONS ON MOTIONS, ETC."

(hereinafter "Decision") mailed May 24, 2000,³ states:

Because all of Ting's involved claims have been determined to be unpatentable for the reasons given in the above decisions on motions, Ting is hereby ordered pursuant to § 1.640(d)(1) to show cause why judgment should not be entered against his patent claims 1-40 and his reissue claims 1, 3-32, and 35-40 on the grounds for unpatentability set forth in Kean's motions.

In the event Ting fails to file a "paper" in response to the show cause order, Kean has 20 days from the date of the due date [sic] for Ting's response in which to file a paper explaining why judgment should not be entered against his claims 54-66, 71-73, and 75-82 as unpatentable for the reasons given in the foregoing decisions on motions.

Replacements for pages 57-61 were faxed to the parties on May 30, 2000 (paper No. 145). The cover sheet of that paper changed the due date for Ting's response to the show cause order to June 30, 2000.

Ting responded on June 30, 2000, by filing a "provisional" request for a final hearing (paper No. 149) to review the decisions on four of Ting's motions, which request

³ Paper No. 143.

was indicated to be "provisional to the extent that Party Ting only requests a final hearing to review the foregoing motions in the event that Party Kean requests a final hearing on any of Kean's motions that have been denied" (Request at 2). Kean filed a paper (No. 148⁴) stating that "the party Kean does not request a final hearing and is willing to have the board terminate the interference in accordance with Judge Martin's decision." Accordingly, judgment is being entered below in accordance with the show cause order.

1. Ting's claims

Pursuant to 37 CFR § 1.640(e), judgment is hereby entered against Ting's involved patent claims 1-40 (all of the patent claims) and against reissue application claims 1, 3-32, and 35-40 (all of the pending reissue claims) on the following grounds:

(a) patent claims 1-40 are unpatentable under 35 U.S.C. § 112 (Decision at 21, discussing Kean's Motion Nos. 1-3);

⁴ Filed July 6, 2000.

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(b) reissue claims 3, 26,⁵ and 31 are unpatentable under § 112 (Decision at 27-39, discussing Kean's Motion Nos. 15 and 16);

(c) reissue claims 9-11 are unpatentable under § 251 (Decision at 40-41, discussing Kean's Motion No. 19);

(d) patent claims 1-40 and reissue claims 1, 3-32, and 35-40 are unpatentable over Camarota et al. U.S. Patent 5,144,166 (Camarota) and El Gamal et al. U.S. Patent No. 5,187,393 (El Gamal) (Decision at 49-51, discussing Kean's Motion Nos. 7 and 8); and

(e) reissue claims 1, 3-8, 11, 12, 20-24, 27-29, and 35-38 are unpatentable for obviousness over Camarota in view of Kean's International Publication No. WO 90/11648 (Decision at 53-56, discussing Kean's Motion No. 17).

⁵ Claim 26 is incorrectly identified as claim 36 at page 27 of the decision. It is clear from the discussion at pages 35-36 that claim 26 was intended.

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2. Kean's claims

Judgment is hereby entered against Kean's involved application claims 43-66, 71-73, and 75-82 on the following grounds:

(a) claims 43-52 and 54 are unpatentable for anticipation by Camarota and claim 53 is unpatentable for obviousness over Camarota in view of El Gamal (Decision at 44-45, discussing Ting's Motion C); and

(b) claims 55-66, 71-73, and 75-82 are unpatentable for obviousness over Camarota in view of El Gamal (Decision at 45-49, discussing Ting's Motion E).

Judgment is, however, entered in favor of Kean's involved claims 67 and 68, which were not held unpatentable in

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the Decision. Consequently, on the record before us Kean is entitled to a patent including those claims.⁶

OF
APPEALS

_____)
ANDREW H. METZ)
Administrative Patent Judge)
)
) BOARD
_____) PATENT
WILLIAM F. PATE, III) AND
Administrative Patent Judge) INTERFERENCES
)
)
_____)
JOHN C. MARTIN)
Administrative Patent Judge)

⁶ Kean's pending claims 69, 70, and 74 are not involved in the interference.

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cc:

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