

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and (2) is not binding precedent of the Board.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. 52

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

BOLESH J. SKUTNIK and HARRY L. BRIELMANN, Jr.

Junior Party,

v.

YUTAKA HASHIMOTO, MASANOBU YUMOTO, TOSHIHIKO UMABA,
YUTAKA KAMADA, TSUTOMU MATSUBARA and SIGEO KAWAGUCHI

Senior Party.

Patent Interference No. 103,224

FINAL HEARING: November 10, 1999

Before CAROFF, HANLON and LORIN, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

1 Application 07/635,922, filed 12/28/90. Accorded the benefit of U.S. Serial No. 07/272,133, filed 11/16/88, now Patent No. 5,112,658 issued 05/12/92. Assigned to Ensign-Bickford Optics Company; A Corporation of Connecticut.

2 Application 07/187,365, filed 04/28/88, now U.S. Patent No. 4,891,241, issued 01/02/90. Assigned to Dainippon Ink and Chemicals, Inc. and Yamamura Glass Co., Ltd.; both Corporations of Japan.

FINAL DECISION UNDER 37 CFR § 1.658 (a)

This interference involves an application of the junior party, Skutnik et al (Skutnik), and a patent of the senior party, Hashimoto et al (Hashimoto).

According to the record before us, the involved Skutnik application is assigned to Ensign-Bickford Optics Company; whereas the involved Hashimoto patent is owned by co-assignees Dainippon Ink and Chemicals, Inc. and Yamamura Glass Co., Ltd.

The subject matter involved in this interference relates to a method of increasing the strength of a glass container essentially by applying a coating of a silane coupling agent and a reactive compound to the surface of the glass container, and then curing the coating. The method is more particularly defined by the sole count in this interference as follows:

Count 1

A method of increasing the strength of a glass container which consists essentially of applying a coating material consisting essentially of a silane coupling agent and a reactive compound having at least two (meth) acrylol groups in the molecule to the surface of the glass article, and then subjecting the coated glass container to energy to cure the coating.

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

Skutnik et al.: Claims 39-42

Hashimoto et al.: Claims 1-15

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The Hashimoto patent contains additional claims 16-17 which have been designated as not corresponding to the count and, therefore, are not before us for consideration.

A combined Decision on Motions and Order to Show Cause (Paper No. 30) was rendered on July 6, 1995. In that decision, the Administrative Patent Judge (APJ) found that all claims corresponding to the count are unpatentable under 35 U.S.C. § 102 or 35 U.S.C. § 103 based upon the disclosure in Japanese Patent Publication 50-50182 (Japan 50182), published on May 6, 1975.

Counsel for each party at final hearing acknowledged that neither party disputes the finding of unpatentability with respect to any claims corresponding to the count. Accordingly, the sole issue presented for our consideration is whether the APJ properly denied Hashimoto's motion (motion 1) to designate Hashimoto claims 1-8 as not corresponding to the count. A related issue to be decided is whether the first Hashimoto Declaration, filed with Hashimoto's reply to Skutnik's opposition to motion 1, and the second Hashimoto Declaration, filed with Hashimoto's response to Paper No. 30, were properly denied consideration by the APJ.

Neither party has briefed any other issues raised during the preliminary motion phase of this interference. Accordingly,

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those matters are regarded as abandoned. Photis v. Lunkenheimer, 225 USPQ 948, 950 (Bd. Pat. App. & Int. 1984).

No issue of interference-in-fact has been raised in this proceeding.

Preliminary Matter

We take note of Skutnik's filing of a § 1.635 motion for sanctions on Nov. 17, 1995 (Paper No. 44), to which Hashimoto has filed an opposition (Paper No. 42). The motion for sanctions is summarily dismissed as failing to comply with the mandatory requirements set forth in 37 CFR § 1.637 (b) relating to miscellaneous motions under § 1.635.

OPINION

There is no question that Hashimoto claims 1-8, the claims at issue, are directed to a method of separately treating a glass surface of a container with a silane coupling agent and then coating the treated surface with a reactive compound, the so-called "two-step process"; whereas all other involved claims as well as the count are directed to a method where the silane coupling agent and the reactive compound are applied together as a single coating material to the glass surface, the so-called "one-step process."

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The primary examiner determined that Hashimoto claims 1-8 correspond to the count. This determination gives rise to a rebuttable presumption that claims 1-8 are directed to the same patentable invention as the count. Cf. 37 CFR § 1.601(j); Case v. CPC International Inc., 730 F.2d 745, 749, 221 USPQ 196, 199-200 (Fed. Cir. 1984), cer . denied, 105 S. Ct. 223, 224 USPQ 736. As the proponent of separate patentability, Hashimoto bears the burden of establishing the nonobviousness of the two-step process with respect to the one-step process. See 37 CFR § 1.601(n) and Behr v. Talbott, 27 USPQ2d 1401, 1405 (Bd. Pat. App. & Int. 1992).

Accordingly, the fundamental issue for our determination is whether the presentation provided by Hashimoto in motion 1 established a prima facie case of separate patentability sufficient to shift the burden to Skutnik of coming forward with rebuttal evidence. Based on a thorough review of the entire record before us, it is our opinion that motion 1 was woefully inadequate in this regard for the following reasons.

As pointed out by the APJ in his Decision on Motions (page 6), it was incumbent upon Hashimoto as the moving party "to demonstrate by the presentation of objective evidence or sound technical reasoning why it would not have been obvious to

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separately apply the components of the coating material recited in the count to the surface of a glass article (rather than all at once)." Rather than doing this, Hashimoto merely made general reference to "the prior art of record in the files of the involved Skutnik et al. application and Hashimoto et al. patent," and set forth general conclusions to the effect that this prior art does not suggest that the two-step process is equivalent, or obvious from, a one-step process. Hashimoto failed to provide copies of any of the prior art references of record with the motion, and failed to analyze each particular reference as to its relevance by, for example, explaining where in the reference - by page and line - relevant subject matter is disclosed. Hashimoto also failed to address the obviousness issue in terms of the three factual inquiries enunciated in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

With regard to all of the aforementioned deficiencies of motion 1, its disposition is governed by well-established criteria set forth in Jacobs v. Moriarity, 6 USPQ2d 1799, 1801, (Bd. Pat. App. & Int. 1988). While Jacobs related to a preliminary motion for judgment under § 1.633(a), it is nevertheless deemed applicable where, as here, a moving party in

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an interference relies upon prior art cited during ex parte prosecution in addressing an issue of obviousness. Turning first to the issue of compliance with § 1.639(a), proof relied upon by Hashimoto, in this case copies of patents, should have been provided with the motion. As in Jacobs, Hashimoto failed to provide any such copies, and failed to establish in the motion paper why the proofs come under the exception of being "part of" the file of an involved application or patent and where in the files the evidence can be found.

That which is "part of" the file is listed in the "Contents" of the file (on the outside flap). Copies of references cited only by the examiner are not so listed and are not "part of the file" Once the application matures into a patent the copies are removed Jacobs, at 1801.

The subject motion is additionally deficient in failing to comply with § 1.637(a) since the prior art of record is given but a "broad-brush" treatment with no specific references evaluated or explained by Hashimoto, or relevant portions of each cited and discussed. In this regard, for the sake of completeness we have perused the involved Skutnik application and have found copies of five prior art references of record which appear to relate to the pretreatment of glass objects with silane coupling agents prior to applying a coating - to wit, (1) Andrews et al (4749614:

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column 3-4); (2) Bell et al (3922436: column 1, lines 31-68; column 15, lines 50-56; column 16, lines 62-66); (3) Kitaj (3873352: Example 1); (4) Kitaj (3801361: column 2, lines 49-54); (5) Russell (4371566: column 3, lines 34-37). Interestingly, none of these five references are specifically referred to or discussed in the subject motion. This constitutes a glaring omission and an example of the inadequacy of characterizing the prior art of record in terms of nothing more than broad generalities and conclusory statements.

Another evident shortcoming of Hashimoto's original motion was a failure to address teachings in Japan 50182, a prior art reference of which Hashimoto evidently was well aware at the time it filed its preliminary motions. According to the English translations filed by both Skutnik and Hashimoto, Japan 50182 characterizes the silane coupling agent as an "adhesion promotor" or "adhesive improving agents." Motion 1 fails to address the implications of this disclosed function with regard to the obviousness of separately applying the silane coupling agent. To wit, Hashimoto failed in its motion to address the question of whether the prior art disclosure of a silane as an adhesion promoter would have suggested to a person of ordinary skill in the art that the silane component could be used as a primer

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coating prior to application of the principal coating material. Again, this reflects a fundamental failure on the part of Hashimoto to follow the well-established Graham criteria for analyzing questions of obviousness.

In essence, Hashimoto merely set forth generalities and conclusions rather than a reasoned and appropriate analysis of the reference vis-a-vis the claims at issue in accordance with the Graham guidelines.

For all of the foregoing reasons, we find that motion 1 was fatally defective ab initio in failing to present a modicum of proof or reasoned analysis sufficient to establish a prima facie case of separate patentability.

As in Jacobs, we find that the subject motion was so deficient in failing to comply with the basic requirements of both § 1.639(a) and § 1.637(a) that the motion should have been dismissed rather than denied.

Turning to the two Hashimoto Declarations at issue, in view of the initial failure by Hashimoto to make out even a prima facie case of separate patentability, the denial of consideration to those later-filed declarations was entirely in order. Since Hashimoto failed to shift the burden of presenting evidence to Skutnik, Skutnik was under no obligation to present rebuttal

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evidence. Having found Hashimoto's original motion to be so manifestly insufficient as to justify dismissal, its resuscitation via consideration of later-filed declarations would be entirely inappropriate. See *Arai v. Kojima*, 206 USPQ 958, 959 (Comm'r 1978). If anything, the APJ went too far in evaluating the first Hashimoto Declaration sums ne on the merits as an alternative basis for denying the subject motion, after having already found the motion to be deficient and the declaration belated. We decline to perpetuate this dualistic approach since, had the declaration actually been earlier presented with the original motion, it would have more appropriately been subject to inter partes challenge through opposition and cross-examination during a testimony period rather than mere sua sponte evaluation by the APJ.

JUDGMENT

For all of the foregoing reasons, and in view of the uncontested finding of unpatentability with respect to all claims corresponding to the count, judgment is hereby entered as follows:

Skutnik et al, the junior party, is not entitled to a patent containing its claims 39-42 corresponding to the count.

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Hashimoto et al, the senior party, is not entitled to its
claims 1-15 corresponding to the count.

MARC L. CAROFF
Administrative Patent Judge
APPEALS AND
INTERFERENCES

BOARD OF PATENT

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