

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 81

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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ANNE R. KOPF-SILL and JOHN W. PARCE,

Junior Party,  
(Patent 5,842,787),

v.

PAUL YAGER, JAMES P. BRODY, MARK R. HOLL,  
FRED K. FORSTER and PAUL C. GALAMBOS,

Senior Party  
(Application 09/346,852).

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Patent Interference No. 104,718

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**DECISION ON YAGER MISCELLANEOUS MOTION 4**

Yager was authorized to file a miscellaneous motion to belated file seven preliminary motions. Yager Miscellaneous Motion 4 is dismissed and Belated Preliminary Motions 5-11 are returned.

**Findings of Fact**

1. Pursuant to 37 CFR § 1.633(a) Kopf-Sill filed Kopf-Sill Preliminary Motions 1-7 . Papers 28-34.
2. The motions assert that Yager's involved claims are unpatentable over U.S. Patent 5,500,071 (Kaltenbach) alone or in combination with U.S. Patent 6,001,229 (Ramsey).

3. The content of motions under § 1.633(a) is specified by 37 CFR § 1.637(a).
4. In relevant part, § 1.637(a) provides:

If a party files a motion for judgment under § 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party.
5. Kopf-Sill's preliminary motions did not provide an explanation as to why the grounds of unpatentability asserted against Yager are not also applicable against Kopf-Sill's involved claims.
6. Kopf-Sill's preliminary statement (Paper 27) does not allege a date prior to the 35 U.S.C. 102(e) dates of either the Kaltenbach or Ramsey patents.
7. Yager's miscellaneous motion seeks permission to belatedly file seven preliminary motions (Yager Belated Preliminary Motions 5-11, Papers 64-70.)
8. Yager seeks to have the belated motions considered to raise patentability issues against Kopf-Sill's involved claims.
9. These motions assert that Kopf-Sill's involved claims are unpatentable over Kaltenbach alone or in combination with Ramsey for substantially the same reasons that Kopf-Sill stated that Yager's involved claims were unpatentable.
10. The Kaltenbach patent was cited during the prosecution of Kopf-Sill's involved patent.

### **Analysis**

Yager's miscellaneous motion is dismissed because (1) the presumption of 37 CFR § 1.637(a) will be applicable against Kopf-Sill's involved claims by operation of that rule, if Kopf-Sill's preliminary motions establish prima facie cases of unpatentability of Yager's involved claims and (2) Yager has not provided a sufficient explanation of why a timely preliminary motions asserting the unpatentability of Kopf-Sill's claims could not have been filed during the time set for filing preliminary motions.

Section 1.637 creates a presumption that a moving party's claims are unpatentable over the prior art asserted against the opponent's claims, if the motion fails to explain why that art does not render the movant's claims unpatentable. However, the presumption of § 1.637(a) is not triggered

by the mere failure of the movant to explain why the prior art is not applicable. The presumption is triggered by the failure to provide an explanation coupled with a holding by an APJ, or panel of the board, that the preliminary motion has made out a prima facie case of unpatentability over the prior art. See Patent Interference Practice, Notice of Proposed Rule Making, 57 Fed. Reg. 2698, 2699 (January 23, 1992), reprinted at 1135 Off. Gaz. Pat. Off. 37 (Feb. 11, 1992). A prima facie case is made out when the prior art, without consideration of any other evidence<sup>1</sup>, teaches or suggests the claimed subject matter. If Kopf-Sill's motion establishes prima facie unpatentability of Yager's claims, then the presumption of § 1.637(a) will apply and Kopf-Sill's involved claims will be presumed unpatentable. If the preliminary motion fails to establish prima facie unpatentability, then there is no presumption, which is applicable against Kopf-Sill. Where the presumption arises, it applies automatically against the movant by operation of the rule. It is unnecessary and inappropriate to file a motion to invoke the presumption.

Other than reliance on the presumption of 37 CFR § 1.637(a), Yager has not provided an explanation why a preliminary motion relying on Kaltenbach could not have been filed during the time for filing preliminary motions. It is noted that at least the Kaltenbach patent was of record in the file history of the Kopf-Sill involved patent. Yager has failed to provide good cause for failing to timely file the preliminary motions. 37 CFR § 1.645(b).

Yager Miscellaneous Motion 4 (Paper 63) is dismissed.

### **ORDER**

It is --

ORDERED that Yager Miscellaneous Motion 4 is dismissed; and

FURTHER ORDERED that Yager Belated Preliminary Motions 5-11, Papers 64-70 be returned (37 CFR § 1.618).

Richard E. Schafer  
Administrative Patent Judge

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<sup>1</sup> E.g., evidence of patentability submitted under 37 CFR § 1.131 or 1.132.

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