



IN RE HAROLD R. GARNER

Authored by: Mihsuhn Koh

2007-1221 DECIDED: December 5, 2007

JUDGES: Before RADER, SCHALL and MOORE,

OPINION BY: MOORE

Procedural Posture:

Harold R. Garner (“Garner”) appeals the decision of the BPAI (“Board”) awarding judgment against Garner, in particular, the Board’s ruling on sufficiency of *prima facie* showing of priority and the Board’s definition of “new evidence”.

Overview:

Are your attorneys certain that the Patent & Trademark Office has interpreted its own rules consistently when examining your applications? Harold Garner provoked an interference relying on extraneous evidence to establish prior invention over the senior party. Garner later submitted the specification of his provisional application to show cause why judgment should not be entered against him. The Board of Patent Appeals and Interferences determined that the specification was new (prohibited) evidence. However, the CAFC held that the Board erred and reasoned that the resubmission of evidence already in the PTO record would not be considered new evidence.

Facts:

- Harold Garner's 09/998,341 application, filed on Nov.29, 2001 (priority date: Jun. 4, 1998) and directed toward lithography technology was anticipated by US Patent No. 6,480,324 filed on Jun. 14, 2001 (priority date: May 29, 1998) by Calvin F. Quate and David Stern (“the Quate patent”). To overcome the prior art, Garner copied the Quate patent and provoked an interference. Garner, as the junior party, had the burden of establishing prior invention over the Quate patent. To that end, Garner filed a declaration in 2001, with photos, along with a declaration of an observer, John Fondon stating that Fondon saw the device shown in the photographs in Garner’s laboratory in November 1997.
- In response to a letter sent by the examiner that his 2001 declaration was “insufficient” to provoke an interference under 37 C.F.R. § 41.202(d) (Rule 202(d), Garner retitled his 2001 Rule 131 declaration to be a “Rule 202(d) declaration,”

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112 S. West Street • Alexandria, Virginia 22314
Tel: 703.548.NATH • Tel: 703.548.6284 • Fax: 703.683.8396

SAN DIEGO

12264 El Camino Real, Suite 400 • San Diego, CA 92130
Tel: 858.792.8211 • Fax: 858.792.8946



without any substantive changes, re-executed it and re-filed it (“the 2005 Garner declaration”) without change. The Examiner forwarded Garner’s request to provoke an interference to the Board.

- 37 C.F.R. § 41.202 states:
 - (a) Applicant. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:
 - ... (5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant’s specification, and ...
 - (d) Requirement to show priority under 35 U.S.C. 102(g).
 - ... (2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause ...
- The Board found Garner’s filing insufficient to establish a *prima facie* showing of priority. Per Rule 202(d), the Board declared an interference with Garner as the junior party and issued an Order to Show Cause why judgment should not be entered against him.
- In response to the Board’s Order to Show Cause, Garner relied on three items that he did not submit in his original Rule 202(d) filing to show priority: (i) a 37 C.F.R. §1.131 declaration filed on September 2, 2003 in an attempt to overcome a prior art rejection (“the 2003 Garner declaration”); (ii) the specification of his provisional application; and (iii) the specification of his utility application.
- The Board found that these three items were “new evidence” that is not permitted under Rule 202(d) without a showing of good cause and that Garner had not attempted to show good cause for his belated reliance. Therefore, the Board issued judgment against Garner.

Issue: Whether the Board’s interpretation of “new evidence” under Rule 202(d) is consistent with the regulation of Rule 202;
Whether the Garner’s evidence is sufficient for *prima facie* showing of priority

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Held: No. The Board erred when it found that the specifications constitute “new evidence” under Rule 202(d).

The Federal Circuit held that the Board’s interpretation of “new evidence” is inconsistent with the regulation, as the Board interpreted Rule 202 in a way that requires it to consider the specification under (a), but not under (d), unless the applicant resubmits the specification. Since the specifications were already before the Board in the interference proceeding pursuant to Rule 202(a), they cannot be new evidence under Rule 202(d).

On the second issue, the court affirmed the Board’s judgment that Garner failed to establish a *prima facie* showing of priority, lacking independent corroborating evidence.

Quoting *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998), among others, the court found that while “the law does not impose an impossible standard of ‘independence’ on corroborative evidence by requiring that every point of a reduction to practice be corroborated by evidence having a source totally independent of the inventor . . . corroboration of the existence of the device is not sufficient in this case to establish corroboration of reduction to practice. It is also necessary to corroborate that the device worked for its intended purpose. In his declaration Fondon does not testify that the device operated or worked for its intended purpose. Fondon does not indicate that he ever saw the device operate. At most the Fondon declaration corroborates the existence of a device purportedly shown in the photographs.

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