

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID **SHAFER**, WILHELM ULRICH,
AURELIAN DODOC, RUDOLF VON BUENAU,
HANS-JUERGEN MANN, ALEXANDER EPPLE,
SUSANNE BEDER, and WOLFGANG SINGER
Junior Party
(Application 12/561,019),

v.

YASUHIRO OMURA
Senior Party
(Patent 7,309,870).

Patent Interference No. 105,753 (SCM)
(Technology Center 2800)

Before JAMESON LEE, SALLY GARDNER LANE, and SALLY C. MEDLEY,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

DECISION – ORDER TO SHOW CAUSE – Bd. R. 104(a)

Interference 105,753

1 Omura was ordered to show cause why judgment should not be entered
2 against it. (Papers 3 and 32). Omura responded. (Papers 16 and 33). Upon
3 considering Omura’s responses, and for the reasons that follow, judgment is
4 entered against Omura.

5

6

ANALYSIS

7

I. BACKGROUND AND OVERVIEW

8

A. The ‘678 Interference

9 This interference is related to interference 105,678 (‘678), also between
10 Shafer and Omura. The ‘678 interference was declared with a single Count 1 (“the
11 ‘678 count”). Omura was involved based on its 7,309,870 (“‘870”) patent and
12 Shafer was involved based on its 11/653,366 (“‘366”) application. The sole count
13 in the ‘678 interference was Omura claim 23 or Shafer claim 23. Omura
14 claims 21-24 and Shafer ‘366 claims 21-24 corresponded to the ‘678 count.
15 (‘678 Paper 1 at 4).

16 On 31 August 2009, judgment was entered against Omura as to the subject
17 matter of the ‘678 count and Omura claims 21-24, which corresponded to the
18 ‘678 count, were cancelled pursuant to 35 U.S.C. § 135(a). (‘678 Paper 49).
19 Omura appealed to the Federal Circuit. *Omura v. Shafer*, 2010-1357 (Fed. Cir.
20 2011).

21

B. The ‘753 Interference

22

23

24

While the appeal was pending, an examiner recommended that an
interference be declared between a different Shafer application, application
12/561,019 (“‘019), with a single claim 20, and Omura’s ‘870 patent with its

Interference 105,753

1 identical claim 20. It came to the Board's attention that Omura '870 claim 20 is
2 nearly identical to Omura '870 claim 22, a claim that was cancelled pursuant to
3 35 U.S.C. § 135(a) in '678. ('678 Paper 1 at 4).

4 On 29 June 2010, this interference ('753) was declared with a single count
5 ("the '753 count"). The '753 count is Omura claim 20 or Shafer claim 20.
6 (Paper 1 at 4). Only Omura claim 20 and Shafer claim 20 correspond to the
7 '753 count. The Declaration of Interference was accompanied by an order for
8 Omura to show cause why judgment should not be entered against it.¹ (Paper 3).
9 As explained in that paper, although Omura claim 20 is not identical to the lost
10 count in '678, Omura claim 20 is nearly identical to Omura claim 22 that was
11 involved in the '678 interference and was cancelled. On that basis, the Board
12 explained that it was of the impression that Omura claim 20, the sole involved
13 Omura claim in this interference, is not separately patentable from the count that
14 Omura lost in '678. (Paper 3).

15 Omura responded and requested the Board stay the '753 interference
16 pending the outcome of the appeal to the Federal Circuit. (Paper 16 at 2:6-8).
17 An issue before the Federal Circuit was whether the Board abused its discretion by
18 construing Omura's actions as a request for adverse judgment as to the contested
19 subject matter, e.g., the '678 count. *Omura v. Shafer*, 2010-1357 (Fed. Cir. 2011).
20 The Board agreed with Omura that because the Federal Circuit's decision would

¹ The Order to Show Cause requested Omura to show (1) why Omura claim 20 was patentable under the written description requirement of 35 U.S.C. § 112, ¶ 1 and (2) why judgment should not be entered against Omura based on the '678 count Omura lost. (Paper 3). This opinion addresses only the second basis for the show cause order.

Interference 105,753

1 affect (and likely control) the outcome of this interference (see, e.g., Paper 16 at
2 2:6-8), this interference was stayed pending a decision by the Federal Circuit.
3 (Paper 20). Subsequently, the Federal Circuit affirmed the Board's decision in
4 '678. *Id.* Specifically, the Federal Circuit did not disturb the Board's entry of
5 judgment against Omura as to the '678 count.

6 As a result of a subsequent conference call, the Board gave Omura an
7 additional opportunity to show, with supporting evidence, why Omura claim 20 is
8 separately patentable, e.g., patentably distinct, from the '678 count that Omura lost.
9 (Paper 32). Omura responded and argues that its claim 20 is patentably distinct
10 from the count it lost in the '678 interference. (Paper 33 at 5).

11

12 II. PRINCIPLES OF LAW

13 Claims of a party which are not patentably distinct from the subject matter of
14 an interference count lost by that party are unpatentable to that party. *In re*
15 *Deckler*, 977 F.2d 1449, 1452 (Fed. Cir. 1992).

16 A claim is not patentably distinct from the subject matter of a count if the
17 count would have either anticipated or rendered obvious the claim. *Aelony v. Arni*,
18 547 F.2d 566, 570 (CCPA 1977).

19 The evaluation of obviousness or non-obviousness involves (1) the scope
20 and content of the prior art, (2) the differences between the prior art and the claim
21 at issue, (3) the level of ordinary skill in the pertinent art; and (4) secondary
22 considerations, if any, of nonobviousness. *Graham v. John Deere Co. of Kansas*
23 *City*, 383 U.S. 1, 17-18 (1966).

24

1
2
3
4
5
6
7

III. OMURA CLAIM 20 AND THE ‘678 LOST COUNT

Omura argues that estoppel under “the doctrine of lost counts,” does not support the entry of judgment against Omura because Omura claim 20 is separately patentable from the ‘678 count. (Paper 33 at 5:4-16). A side-by-side comparison of Omura claim 20 and Omura claim 23, e.g., the ‘678 count, is as follows (differences highlighted):

Omura claim 20	Omura claim 23 (‘678 count)
<p>A catadioptric projection objective for imaging a pattern provided in an object surface of the projection objective onto an image surface of the projection objective comprising:</p> <ul style="list-style-type: none">a first, refractive objective part for imaging the pattern provided in the object surface into a first intermediate image;a second objective part for imaging the first intermediate image into a second intermediate image;a third, refractive objective part for imaging the second intermediate image onto the image surface; <p>wherein the second objective part includes a first concave mirror having a first continuous mirror surface and a second concave mirror having a second continuous mirror surface;</p> <p>pupil surfaces are formed between the object plane and the first intermediate image, between the first and the second intermediate images and</p>	<p>A catadioptric projection objective for imaging a pattern provided in an object surface of the projection objective onto an image surface of the projection objective comprising:</p> <ul style="list-style-type: none">a first, refractive objective part for imaging the pattern provided in the object surface into a first intermediate image;a second objective part for imaging the first intermediate image into a second intermediate image;a third, refractive objective part for imaging the second intermediate image onto the image surface; <p>wherein the second objective part includes a first concave mirror having a first continuous mirror surface and a second concave mirror having a second continuous mirror surface;</p> <p>pupil surfaces are formed between the object plane and the first intermediate image, between the first and the second intermediate images and</p>

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.