

The opinion in support of the decision  
being entered today is  
binding precedent of the Trial Procedures Section.

Interference 105,069 Paper 124

Filed by:

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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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ALBERTO STAMPA, PELAYO CAMPS, GLORIA RODRIGUEZ,  
JORDI BOSCH and MARIA del CARMEN ONRUBIA,

Junior Party,

v.

WILLIAM P. JACKSON,

Senior Party.

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Patent Interferences 105,069 and 105,212

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Before: FLEMING, Chief Administrative Patent Judge, and HARKCOM,  
Vice Chief Administrative Patent Judge, and McKELVEY, Senior  
Administrative Patent Judge, and SCHAFER and LORIN,  
Administrative Patent Judges.<sup>1</sup>

Per curiam.

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<sup>1</sup> A decision on priority (Papers 121 and 122) was initially entered by a panel consisting of Judges McKelvey, Schafer and Lorin. At the direction of the Chief Administrative Patent Judge, Stampa's request for rehearing is being considered by an expanded panel consisting of Judges Fleming, Harkcom, McKelvey, Schafer and Lorin.

## DECISION ON REHEARING - Bd.R. 127(d)<sup>2</sup>

### A. Introduction

Stampa has filed a request for rehearing (Paper 123) of our decision and judgment (Papers 121 and 122) entered 25 January 2005 in Interference 105,069<sup>3</sup> and Interference 105,212.<sup>4</sup>

The request for rehearing is denied.

### B. Practice points

Resolution of the request for rehearing requires a discussion of numerous Trial Section practices designed to administer interference cases in a just, speedy and inexpensive manner. Bd.R. 1(b); 69 Fed. Reg. at 50003 (Aug. 12, 2004), codified at 37 CFR § 41.1(b). The practices include:

1. The manner in which a motion for judgment, including a motion for judgment based on priority, is evaluated.
2. The evidence admitted in connection with a substantive motion for judgment, including a motion for judgment based on priority.

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<sup>2</sup> As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, subsequent papers in this case originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 CFR § 10.18 (2004).

<sup>3</sup> Interference 105,069 involves (1) Stampa reissue application 10/234,659 versus (2) Jackson patent 6,093,827 and Jackson application 09/525,894.

<sup>4</sup> Interference 105,212 involves (1) Stampa reissue application 10/234,659 and Stampa patent 6,084,100 versus (2) Jackson application 09/525,894.

3. The extent, if any, to which a panel will search a record to determine if there is evidence which might support a motion for judgment.

4. The extent, if any, to which new arguments or new evidence may be called to the attention of the board and the opponent in a reply brief or a request for rehearing.

5. The manner in which a request for rehearing should be presented.

We take this opportunity to discuss each of the practices and why the practices are believed to be consistent with the efficient administration of interference in a just, speedy and inexpensive manner.

### **C. Background**

#### 1. Manner in which a motion for judgment is evaluated

There came a time in this interference when times were set for taking action in the priority phase of the interference (Paper 78). One of those times calls for the junior party--Stampa in this case--to file its principal brief on priority. Time Period 11 (Paper 78, page 2). Within the time authorized, Stampa (1) served and filed STAMPA PRINCIPAL BRIEF ON PRIORITY (Paper 81) and (2) served all evidence mentioned in its priority brief.

Jackson timely filed a brief in opposition (Paper 83).

Stampa timely filed a reply (Paper 86).

After briefs are filed, it is customary for the merits panel to determine on a case-by-case basis whether oral argument is needed. After consideration of the STAMPA PRINCIPAL BRIEF ON PRIORITY, the panel determined that oral argument was not needed in this case.

The panel then considered the STAMPA PRINCIPAL BRIEF ON PRIORITY and evaluated the merits of Stampa's priority case. Upon consideration of argument in the PRIORITY BRIEF, and the evidence mentioned therein, the panel determined that Stampa had not sustained its burden of proof on the issue of priority. Accordingly, judgment on the issue of priority was entered against Stampa.

The Trial Section has a long-standing practice of considering a brief on priority (which in reality is a motion for judgment based on priority) to determine if the brief, and the evidence mentioned in the brief, make out a case for relief on the merits under the applicable burden of proof--preponderance of the evidence in this case. If it does not, there is generally no need to consider an opposition or reply. See e.g., STANDING ORDER, § 26 (Paper 2, page 19); LeVeen v. Edwards, 57 USPQ2d 1406, 1415 (Bd. Pat. App. & Int. 2000) (it is not necessary to consider an opposition and reply when a motion fails to make out a case); Winters v. Fujita, 53 USPQ2d 1234, 1249 (Bd. Pat. App. & Int. 1999) (same). In considering a principal brief, the board determines whether the evidence relied upon is sufficient to establish a party's case on the merits under the applicable

burden of proof. In this respect, the principles announced in Basmadjian v. Landry, 54 USPQ2d 1617 (Bd. Pat. App. & Int. 1997) (involving proceedings under former 37 CFR §§ 1.608(b) and 1.617 (2004)) are applied. For example, if the party's evidence supports two inferences with respect to a particular fact, and that party has a burden of proving the particular fact, it may be held that the party failed to sustain its burden. 54 USPQ2d at 1623, ¶ F(3) (where plausible alternative inferences are possible based on the evidence presented by a party, the alternative least favorable to the party may be drawn on the theory that the party failed to prove its case).

As a result of our practice it is not unusual for relief to be denied after consideration of an opening brief without any need to consider any opposition or reply. What occurred in this case was nothing unusual. Since the STAMPA PRINCIPAL BRIEF ON PRIORITY, and the evidence mentioned therein, did not make out a case of priority, judgment was entered against Stampa without any need to consider (1) Jackson's opposition brief or (2) Stampa's reply brief or (3) any evidence mentioned therein which was not mentioned in the STAMPA PRINCIPAL BRIEF ON PRIORITY.

## 2. Admissible evidence

All evidence in an interference must be presented in the form of an exhibit. Bd.R. 154(a); 69 Fed. Reg. at 50017 (Aug. 12, 2004), codified at 37 CFR § 41.154(a); 37 CFR § 1.671(a) (2004); STANDING ORDER, § 39 (Paper 2, page 27).

The exhibits upon which a junior party relies in support of its priority case must be mentioned in the principal brief on priority. If that evidence is insufficient to establish priority, no other evidence needs to, or will, be considered.

The admissible evidence on the issue of priority which the panel considered is set out in an Appendix to this opinion. The "Evidence mentioned in Stampa Principal Brief on Priority", along with page on which that evidence was mentioned, appears in the left-hand column of the Appendix. The evidence mentioned in the request for rehearing appears in the right-hand column of the Appendix. The Appendix shows that Stampa relies in the request for rehearing on evidence not mentioned in the STAMPA PRINCIPAL BRIEF ON PRIORITY.

The "admissible evidence" in this case consists of the exhibits mentioned in the left-hand column. No other exhibit submitted by either Jackson with its opposition or Stampa with its reply was "admitted" or "considered." Since Stampa failed to make out a case with its principal brief, and the exhibits mentioned therein, it follows that the panel could not have overlooked additional Stampa evidence, such as additional evidence mentioned in Stampa's reply or in Stampa's request for rehearing.

### 3. Arguments considered

The arguments considered are those set out in the junior party's priority brief, in this case the STAMPA PRINCIPAL BRIEF ON PRIORITY (Paper 81).

There are certain principles which govern the board's consideration of a substantive motion for judgment, including a motion for judgment based on priority. Those principles are similar to those applicable in Federal courts.

It should be remembered that an interference is a contested case. In a contested interference, the issue generally is not whether a patent should issue. Rather, the issue is as between two inventors claiming the same patentable invention, who made the invention first. The "later" inventor is not entitled to a patent. 35 U.S.C. § 102(g). Unlike ex parte proceedings where the PTO can assist an applicant define patentable subject matter, in a contested case the board does not take sides on an issue involving the merits.

(1)

Each party is represented by counsel of its choice and is bound by the actions its counsel of choice. Link v. Wabash R. Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390 (1962); Irwin v. Veterans Administration, 498 U.S. 89, 92, 111 S.Ct. 453, 456 (1990) (under our system of representative litigation, each party is deemed bound by the acts of his lawyer-agent); Huston v.

Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992).

(2)

Consistent with Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997), citing United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991) (judges do not hunt for truffles buried in briefs), where a party points the board to multi-page exhibits without citing and discussing a specific portion or page, the board will not pore over the documents to extract the relevant information. See also (1) United States v. Lanzotti, 205 F.3d 951, 957 (7th Cir. 2000) ("[t]he premise of our adversarial system is that \*\*\* [the board does] not sit as self-directed \*\*\* [board] of legal inquiry and research, but essentially as \*\*\* [arbiter] of legal questions presented and argued by the parties before \*\*\* [it]" and (2) STANDING ORDER (Paper 2, page 19).

(3)

Consistent with Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 111-12, 49 USPQ2d 1377, 1378-79 (2d Cir. 1999), the board does not take on the role of advocate for one or both of the parties. As Ernst observes, "[a]ppellant's [b]rief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation."

(4)

Consistent with Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1351, 53 USPQ2d 1580, 1589 (Fed. Cir. 2000), we will not consider "witnesses [which] were never even identified by \*\*\* [a party] in \*\*\* [its] opening brief \*\*\*."

(5)

Consistent with Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989), we cannot overlook that which is not called to our attention. Keebler notes that prescience is not a required characteristic of the board and the board need not divine all possible afterthoughts of counsel that might be asserted for the first time on appeal.

In one fashion or another the principles discussed above have been announced in published opinions or the Trial Section's STANDING ORDER (Paper 2). The published opinions include:

(a) Bamberger v. Cheruvu, 55 USPQ2d 1523, 1537 (Bd. Pat. App. & Int. 1998) (we decline to search the record in the first instance to determine whether there is evidence which might support a holding of obviousness).

(b) Hillman v. Shyamala, 55 USPQ2d 1220, 1222 (Bd. Pat. App. & Int. 2000) (Hillman's attempt to shift the burden to the opponent will not be permitted; arguments made in request for rehearing which were not made in an original motion are not entitled to consideration).

(c) Shiokawa v. Maienfisch, 56 USPQ2d 1970, 1975 (Bd. Pat. App. & Int. 2000) (expanded panel) (board will not extract the relevant information where party points the board to a multi-page exhibit without citing a specific portion or page).

(d) Fulano v. Abrano, 57 USPQ2d 1091, 1092 (Bd. Pat. App. & Int. 2000) (the right of a party to counsel of its choice cannot be used as a vehicle to control the board's docket or the manner in which the board handles particular matters).

(e) LeVeen v. Edwards, 57 USPQ2d 1406, 1413 (Bd. Pat. App. & Int. 2000) (expanded panel) (board declined to search record to see if somehow it might support Edwards' anticipation argument).

(f) Anderson v. Eppstein, 59 USPQ2d 1280, 1287 (Bd. Pat. App. & Int. 2001) (board will not take up the role as counsel for one of the parties).

(g) Rohrmann v. Alt, 61 USPQ2d 1957, 1959 (Bd. Pat. App. & Int. 2001) (board declined to become an advocate for Alt to see if Alt timely presented a claim consistent with 35 U.S.C. § 135(b)).

(h) Scripps Research Institute v. Nemerson, 72 USPQ2d 1122, 1123 (Bd. Pat. App. & Int. 2004) (responsibility for developing and explaining the record for an issue rests with the movant, not the board).

(i) Wang v. Imler, 74 USPQ2d 1253, 1260 (Bd. Pat. App. & Int. 2004) (argument which is not timely presented is not entitled to consideration).

#### 4. New argument in a reply brief

We do not like new arguments in reply briefs. Why? First, it is unfair to the opponent. Second, we do not get the benefit of the opponent's views. Accordingly, the STANDING ORDER, § 30 (Paper 2, page 24) prohibits raising new arguments in a reply brief.

Our practice is consistent with long-standing practice in our appellate reviewing court and other courts of appeals. Carbino v. West, 168 F.3d 32, 34 (Fed. Cir. 1999) (a reply brief should reply to the brief of the appellee and is not the appropriate place to raise for the first time an issue; Amhil Enterprises Ltd. v. Wawa, Inc., 81 F.3d 1554, 1563, 38 USPQ2d 1471, 1477 (Fed. Cir. 1996) (same); Kaufman Co. v. Lantech, Inc., 807 F.2d 970, 973 n.\*, 1 USPQ2d 1202, 1204 n.\* (Fed. Cir. 1986) (same); Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 112, 49 USPQ2d 1377, 1378-79 (2d Cir. 1999) (the reply brief is almost three times as long as the main brief and contains some citations to pertinent legal authority; however, new arguments may not be made in a reply brief and court declined to entertain the theories so proffered).

#### 5. Requests for rehearing

Our practice authorizes a party to file a request for rehearing. Bd.R. 127(d); 69 Fed. Reg. 58260 (Sept. 30, 2004), correcting 69 Fed. Reg. 49,960, 50016 (Aug. 12, 2004), codified at 37 CFR § 41.127(d); 37 CFR § 1.658(b) (2004).

When making a point in a request for rehearing, a party should point to the precise place in the principal brief where the point was made in the first instance. A point not made in the first instance cannot have been misapprehended or overlooked. Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989). In this particular case, a point not made in the STAMPA PRINCIPAL BRIEF ON PRIORITY is not entitled to be considered on rehearing.

**D. Stampa's request for rehearing**

Numerous observations can be made about Stampa's request for rehearing.

1.

On page 13 of the request for rehearing, Stampa maintains that (1) Exhibit 2035 was discussed on pages 9-10 of STAMPA PRINCIPAL BRIEF ON PRIORITY and (2) pages 11-12 of Exhibit 2035<sup>5</sup> describe trial LTD-L6 which is said to have been performed on 7 May 1996 (Paper 123, page 13). On pages 14-15 of the request for rehearing, Stampa goes to great lengths to explain in some detail for the first time why Exhibit 2035 allegedly proves its case. According to page 13 of the request for rehearing:

It [meaning Exhibit 2035] describes trial LTD-L6, performed on May 7, 1996, as including the reaction of:

- "117 cc of THF [tetrahydrofuran]"  
(Exhibit 2035, page 11)

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<sup>5</sup> The pages of Exhibit 2035 are not numbered; the pages of multi-page exhibits should be numbered and, if necessary, renumbered with "Bates" numbers.

- "4.8 ml of  $TiCl_4$  (8.3 g) (0.0435 mol)" (Exhibit 2035, page 11)
- "5.7 g of Zn (0.0878 mol)" (Exhibit 2035, page 11)
- "2.9 ml of pyridine" (Exhibit 2035, page 11)
- a solution consisting of a saturated solution of . 5 g of LTD -13 (Ref. Morepoen Laboratory, 65/96 (0.02 mol) . 3.5 g of piperidone (0.0204 mol) and . 11.7 ml of THF.

Stampa goes on to say that clearly the list of reactants used in the trial LTD-L6 demonstrates it combined a dibenzosuberone or an aza derivative thereof<sup>6</sup> with an aliphatic ketone in the presence of low valent titanium generated by zinc (Paper 123, page 13, last paragraph).

The discussion which appears in the request for rehearing should have occurred in the STAMPA PRINCIPAL BRIEF ON PRIORITY. Instead, what appeared in the principal brief were general assertions about what a multitude of exhibits supposedly show. As indicated above, however, we were not about to search the exhibits to see if we could have divined a case for Stampa.

Even had the matter quoted on page 13 of the request for rehearing been called to our attention in the form in which it was presented in the request for rehearing, we would not have been impressed. Why?

First, the person (Lola Casas) who allegedly performed the experiment did not testify; hence the brief could not have called

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<sup>6</sup> Is it (1) the dibenzosuberone or (2) the aza derivative?

our attention to that person's testimony. What the brief amounts to is an argument of counsel;<sup>7</sup> but we know that argument of counsel cannot take the place of evidence. Estee Lauder, Inc. v. L'Oreal, S.A., 129 F.3d 588, 592, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997). Moreover, since Lola Casas did not testify, counsel's argument--to be extent made to prove the truth of what took place during the experiment--is hearsay. We are not bound to credit hearsay testimony. Chen v. Bouchard, 347 F.3d 1299, 1308, 68 UPSQ2d 1705, 1711 (Fed. Cir. 2003).

Second, it is not as clear to us as it seems to be to Stampa that the process occurred "in the presence of low valent titanium generated by zinc" (Paper 123, page 13, last two lines). Where is the testimony to support counsel's argument? How do we know that low valent titanium was generated by zinc? The matter is not cogently explained in the STAMPA PRINCIPAL BRIEF ON PRIORITY. For that matter, it is not sufficiently explained in the request for rehearing. Qualified witnesses must explain the significance of experimental work. See 37 CFR § 1.671(f), which is based on binding precedent.<sup>8</sup> See Chandler v. Mock, 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless) and Smith v. Bousquet, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in stipulated testimony are

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<sup>7</sup> The declaration of Jose Luis Stampa (Ex 2067), mentioned in the request for rehearing, but not the STAMPA PRINCIPAL BRIEF ON PRIORITY, has not been admitted into evidence.

<sup>8</sup> The requirement for an explanation was discussed in the Notice of Final Rule, 49 Fed. Reg. 48416, 48427-28 (Dec. 12, 1984).

entitled to little weight). See also In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974); Triplett v. Steinmayer, 129 F.2d 869, 54 USPQ 409 (CCPA 1942) and Popoff v. Orchin, 144 USPQ 762 (Bd. Pat. Int. 1963).

We were unable to find that low valent titanium was generated by zinc in making our initial decision because the STAMPA PRINCIPAL BRIEF ON PRIORITY did not specifically direct us to the experiment mentioned in the request for rehearing and did not direct our attention to any testimony by a witness explaining why the experiment meets the limitation of the count.<sup>9</sup>

Third, Stampa asserts that the credibility of the evidence now called to our attention was tested in open court, presumably in trial proceedings in the U.S. District Court for the Southern District of New York in Medichem S.A. v. Rolabo, S.L., [20]01 Civil Action 3087. We have several answers to Stampa's assertion. We make our credibility determinations on the evidence before us and the court makes its credibility determinations on the evidence before it. Furthermore, Stampa

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<sup>9</sup> To the extent that someone might suggest that members of this board have scientific ability (35 U.S.C. § 6(a)), we refer that person to then Chief Judge Mayer's concurring opinion in Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437, 1448, 45 USPQ2d 1269, 1277 (Fed. Cir. 1997) (I "know" what anodization means from my own undergraduate studies and experiments; the concept is not difficult and I need no further education to grasp it. I happen to have a dictionary in my chambers from the era pertinent here, which would confirm my "knowledge" about anodization. \*\*\*. But, I am neither an expert in the field nor one of ordinary skill in the art despite how much I think I "know" about a process I once studied. Nor do my colleagues on this court or the district court possess such expertise, and even if they did, they would have to defer to the record made in the case.). To the extent that Stampa may believe it can rely on its specification to prove scientific facts, we note that a specification is admissible only to prove what is described therein; it is not admissible to prove the truth of experiments described therein. STANDING ORDER, § 41 (Paper 2, 29); Wojciak v. Nishiyama, 61 USPQ2d 1576 (Bd. Pat. App. & Int. 2001).

has not pointed out where the court made a finding that the material on pages 11-12 establishes that low valent titanium was generated by zinc. We have not been able to divine the factual basis upon which the court reached its conclusion. What is more important here, however, is that Stampa did not give us a road map in its brief as to how we were to make the findings necessary to support a legal conclusion that Stampa actually reduced to practice the subject matter of the count prior to Jackson. We declined then, and decline now, to search Stampa's record in the first instance to see if there is some theory and evidence upon which Stampa might prevail.

2.

Oral argument was scheduled for 6 December 2004, but was subsequently cancelled as being unnecessary. Stampa now tells us that it prepared and served an Oral Argument Demonstrative, which it now attaches as Appendix A to the request for rehearing. The demonstrative is said to have been "prepared in order to clarify how the exhibits cited in the brief demonstrate Stampa's reduction to practice by May 7, 1996." Since there was no oral argument, Stampa was "unable" to use its demonstrative.

A review of the demonstrative shows that it is anything but a demonstrative--it is a supplement to the STAMPA PRINCIPAL BRIEF ON PRIORITY.

The demonstrative and the request for rehearing mention Ex 2066, which we are told is a declaration of Juan A. Peña. Curiously, however, Exhibit 2066 is not mentioned in the STAMPA

PRINCIPAL BRIEF ON PRIORITY. The demonstrative, therefore could not "clarify how the exhibits cited in the brief demonstrate" an actual reduction to practice by Stampa. How Stampa now can rely on the Peña declaration to make out a case of priority when that declaration was not called to our attention in the principal brief escapes us.

The bottom line is that any new explanation which Stampa intended to make with the demonstrative should have appeared in the first instance in the STAMPA PRINCIPAL BRIEF ON PRIORITY. Moreover, in fairness to Jackson, Stampa was obligated to put its whole case on in the first instance. Jackson could not have filed a written response to the Stampa reply brief or Stampa the demonstrative.

3.

On page 16 of the request for rehearing, Stampa says we overlooked the second Peña declaration, which of course is Ex 2066. The exhibit was not called to our attention in the STAMPA PRINCIPAL BRIEF ON PRIORITY. Hence, we could not have overlooked it. For reasons already given, we had no occasion in this case to consider either the Jackson opposition or the Stampa reply.

In any event, Stampa does not represent that Peña observed the experiment said to have been conducted by Lola Casas on 7 May 1996.

What is said above about Ex 2066, applies with equal force to Exhibit 2067--the Stampa declaration.

4.

The next thing we find out in the request for rehearing, but not in the STAMPA PRINCIPAL BRIEF ON PRIORITY, is the alleged "unavailability" of Lola Casas, the individual who is said to have conducted the 7 May 1996 experiment (Paper 123, page 17).

It is hard to imagine that counsel did not recognize the potential significance of testimony by Lola Casas at the time the STAMPA PRINCIPAL BRIEF ON PRIORITY was filed and served. What counsel now says is that Lola Casas was, in effect, a very bad actor. According to the request for rehearing, (1) Lola Casas was employed by Stampa's assignee, (2) quit her job only after about one year and (3) allegedly attempted to commit a fraud on Spain by applying for unemployment compensation based on allegedly having been "dismissed" from her job when according to Stampa she had voluntarily quit. Lola Casas is said to be uncooperative. She supposedly is unwilling to participate in this proceeding unless legally compelled to do so. Counsel then asserts, without reference to any Spanish or other law, that there is no mechanism to compel her testimony. On page 21 of the request for rehearing, it is said that Lola "Casas could not be compelled to testify in the interference proceeding \*\*\*." Hence, she is said to be an "unavailable witness." We are not in the least bit impressed with this story.

Why did the STAMPA PRINCIPAL BRIEF ON PRIORITY not tell Jackson and us about the Lola Casas saga? We have no idea. What Stampa did in this case was sandbag Jackson on the alleged

unavailability of Lola Casas. The importance of Lola Casas' testimony is manifest. She is the principal, if not the only, corroborating witness on the issue of whether an actual reduction to practice took place. Counsel could not possibly have overlooked the fact that Jackson was going to make a big deal about the absence of her testimony in Stampa's case-in-chief. Stampa was under an obligation to reveal the Lola Casas saga in the STAMPA PRINCIPAL BRIEF ON PRIORITY and to make out an evidentiary case that she was "unavailable."

We have at least the following observations with respect to the alleged unavailability of Lola Casas. First, no factual or legal basis is given for the proposition that her testimony could not have been compelled in Spain? Both parties seem to have some connection with Spain. It is not apparent why it would not be in Spain's interest to resolve issues between its citizens. Alternatively, Stampa's assignee is a Spanish entity. Why Spain would not be interested in helping one of its own obtain necessary testimony from a citizen of Spain is not apparent. No Spanish law is discussed. Nor does Stampa tell us whether she may have had an enforceable employment agreement which (1) would have required her to help Stampa's assignee post-employment and (2) could have been enforced in a Spanish court. Second, no explanation is proffered as to what effort, if any, was made by Stampa to secure her testimony voluntarily, e.g., by asking her if she would come to the United States to testify if Stampa was willing to pay necessary travel, per diem expenses and perhaps a

sum to compensate her for her time? Third, to the extent that her testimony cannot be compelled provides no reason whatsoever for relaxing the evidentiary standard under which Stampa labored in this case, viz., proof of priority based on a preponderance of the evidence.

5.

We have considered other arguments made in the request for rehearing to the extent that they are based on the admissible evidence and the arguments made in the STAMPA PRINCIPAL BRIEF ON PRIORITY. Based on the consideration, we find no reason to change our initial decision on priority.

**E. Order**

Upon consideration of the Stampa request for rehearing (Paper 123), and for the reasons given, it is

ORDERED that the Stampa request for rehearing (Paper 123) is denied.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c).

FURTHER ORDERED that the time for seeking judicial review begins to run with entry of the this order. Bd.R. 2 (definition of "Final"), 69 Fed. Reg. 49,960, 50003 (Aug. 12, 2004), codified at 37 CFR § 41.2.

<u>          /ss/ Michael R. Fleming          </u>	)	
MICHAEL R. FLEMING, Chief	)	
Administrative Patent Judge	)	
	)	
<u>          /ss/ Gary V. Harkcom          </u>	)	
GARY V. HARKCOM, Vice Chief	)	
Administrative Patent Judge	)	
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<u>          /ss/ Fred E. McKelvey          </u>	)	APPEALS
FRED E. MCKELVEY, Senior	)	AND INTERFERENCES
Administrative Patent Judge	)	
	)	
<u>          /ss/ Richard E. Schafer          </u>	)	
RICHARD E. SCHAFER	)	
Administrative Patent Judge	)	
	)	
<u>          /ss/ Hubert C. Lorin          </u>	)	
HUBERT C. LORIN	)	
Administrative Patent Judge	)	

APPENDIX

cc (via overnight delivery)

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