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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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*Ex parte* RADHIKA AGGARWAL, WILLIAM H. KREBS JR.,  
ELIZABETH A. SCHREIBER, and DAVID B. STYLES

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Appeal 2010-011553  
Application 10/041,141  
Technology Center 2100

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Before JOSEPH L. DIXON, JEAN R. HOMERE, and JOHN A. JEFFERY,  
*Administrative Patent Judges.*

Opinion for the Board filed by JEFFERY, *Administrative Patent Judge.*

Opinion dissenting filed by DIXON, *Administrative Patent Judge.*

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

This application returns to us after another panel of this Board<sup>1</sup> affirmed the Examiner's rejection of then-pending claims 1-10. *Ex parte Aggarwal*, No. 2007-1979, 2007 WL 2843731 (BPAI 2007) (non-precedential). Prosecution was reopened after that decision, and Appellants now appeal under 35 U.S.C. § 134(a) from the Examiner's subsequent rejection of claims 1-5 and 11. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

#### STATEMENT OF THE CASE

Appellants' invention performs inline error notification in a content browser. *See generally* Spec. 4-5. Claim 1 is illustrative:

1. An inline error notification method comprising:

detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form;

inserting a row in said markup specified form in a position which is proximate to said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row;

selecting error text corresponding to said validation error and inserting said selected error text in said row;

further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element;  
and,

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<sup>1</sup> The panel for this appeal is the same as the earlier appeal except that Judge Dixon replaces then-Judge Hairston.

serving said markup specified form in a response to said form-based submit, said response referencing said anchor tag.

The Examiner relies on the following as evidence of unpatentability:

Jeffries	US 6,094,529	July 25, 2000
Upton	US 2003/0105884 A1	June 5, 2003 (eff. filed Oct. 18, 2001)
Hartman	US 6,615,226 B1	Sept. 2, 2003 (filed Sept. 12, 1997)

Alex Homer et al., INSTANT HTML 88-101 (2d ed. 1997).

#### THE REJECTIONS

1. The Examiner rejected claims 1-5<sup>2</sup> under the doctrine of *res judicata*. Ans. 3-4.<sup>3</sup>
2. The Examiner rejected claims 1, 2, and 5 under 35 U.S.C. § 103(a) as unpatentable over Upton, Jeffries, and Homer. Ans. 5-8.
3. The Examiner rejected claims 3, 4, and 11 under 35 U.S.C. § 103(a) as unpatentable over Upton, Jeffries, Homer, and Hartman. Ans. 8-10.

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<sup>2</sup> Although the Grounds of Rejection section in the Examiner's Answer does not include a specific statement of this rejection, the Examiner nonetheless indicates that *res judicata* applies to claims 1-5 of the present application. Ans. 3-4, 12. Accordingly, we presume that the Examiner intended to reject claims 1-5 on this basis.

<sup>3</sup> Throughout this opinion, we refer to (1) the Appeal Brief filed February 13, 2010; (2) the Examiner's Answer mailed May 11, 2010; and (3) the Reply Brief filed July 12, 2010.

### THE *RES JUDICATA* REJECTION

The Examiner finds that since the rejection of claims 1-5 on appeal is identical to that considered in the Board's earlier affirmance of that rejection (as are the claims), then the doctrine of *res judicata* applies. Ans. 3-5, 12. The Examiner adds that since the declarations at issue in the present appeal were filed before the Board's earlier decision,<sup>4</sup> they were therefore presented to the Board and thus "binding with the Board decision." Ans. 4, 12.

Appellants argue that *res judicata* does not apply since these declarations were not presented in the earlier Appeal Brief in connection with the Board's earlier decision, let alone considered by the Board. App. Br. 13-17; Reply Br. 5-6. According to Appellants, the earlier appeal involved different patentability questions than the present appeal, and neither Appellants, the Examiner, nor the Board addressed the declarations in connection with the earlier appeal. *Id.* Since these declarations allegedly constitute "new evidence" that the Board did not previously consider, Appellants contend that *res judicata* is inappropriate. *Id.*

### ISSUE

Has the Examiner erred in rejecting claims 1-5 under the doctrine of *res judicata*? This issue turns on whether the Board previously decided the patentability issue raised in the present appeal.

### FINDINGS OF FACT (FF)

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<sup>4</sup> See App. Br. Ev. App'x (including two declarations filed December 21, 2004 and December 5, 2005, respectively).

1. The Appeal Brief's Evidence Appendix includes two declarations under 37 C.F.R. § 1.131 that are said to have been entered by the Examiner. The first declaration is signed by the four co-inventors and was filed December 21, 2004 ("Inventors' Declaration"). The second declaration is signed by Gerald R. Woods who is said to be the attorney of record of the present application, and was filed December 5, 2005 ("Woods Declaration"). App. Br. Ev. App'x.

2. In the Office action mailed September 2, 2005, the Examiner noted that "[t]he Declaration filed on 12/21/2004 fails to provide evidence(s) [*sic*] to show that the prototype was actually reduced to practice." Non-Final Rej. mailed Sept. 2, 2005, at 7.

3. In the remarks accompanying an amendment filed December 5, 2005, Appellants note that on December 16, 2004, they submitted a Declaration "swearing behind Upton and establishing an invention date which precedes that of Upton." Appellants also submitted a declaration from Gerald R. Woods on December 5, 2005 "to provide additional evidence of reasonable diligence from the period between November 8, 2001 . . . and January 3, 2002 . . . ." Amd't filed Dec. 5, 2005, at 2-3.

4. In the Office Action mailed February 24, 2006, the Examiner noted that "[t]he affidavit filed on 12/05/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Upton et al. reference." Final Rej. mailed Feb. 24, 2006, at 7.

5. In the Evidence Appendix of the Appeal Brief filed September 11, 2006, Appellants state that "[n]o evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the

Examiner has been relied upon in this Appeal, and thus no evidence is attached hereto.” App. Br. filed Sept. 11, 2006, Ev. App’x.

6. The (1) Appeal Brief filed September 11, 2006; (2) the Examiner’s Answer mailed November 28, 2006; (3) the Reply Brief filed December 28, 2006; and (4) the Board decision of August 29, 2007 does not identify nor discuss the Inventors’ Declaration or the Woods Declaration.

7. The Board decision of August 29, 2007 identified two issues as follows:

Did the Examiner provide the Appellants with a reasonable notice of the portions of the ‘901 provisional application that are relied upon by the Examiner in the obviousness rejection?

Does the applied prior art teach or would it have suggested selection of an error text corresponding to a validation error?

Board Decision mailed Aug. 29, 2007, at 4 (footnote omitted).

#### PRINCIPLES OF LAW

“*Res judicata*” is “[a]n issue that has been definitively settled by judicial decision. . . . The three essential elements are (1) an earlier decision on the issue, (2) a final judgment on the merits, and (3) the involvement of the same parties, or parties in privity with the original parties.” BLACK’S LAW DICTIONARY 1425 (9th ed. 2009) (citing RESTATEMENT (SECOND) OF JUDGMENTS §§ 17, 24 (1982)).

When Appellants submit new affidavits not considered previously to make a new record, thus presenting different questions of patentability, the doctrine of *res judicata* does not apply “even if the claims are viewed as

identical to those in the prior case.” *In re Russell*, 439 F.2d 1228, 1230 (CCPA 1971).

## ANALYSIS

As noted in the issue statement above, the key threshold question in this appeal is whether the doctrine of *res judicata* applies. There is no dispute that claims 1-5 in this appeal are identical to those before the Board in the earlier appeal. Nor is it disputed that the same rejections of these claims were before the Board in the earlier appeal.

Rather, the dispute before us hinges on whether Appellants’ failure to raise a particular patentability issue before the Board in the earlier appeal based on evidence that was entered and considered by the Examiner during prosecution before that appeal can be presented in a later appeal to effectively create a new record and thus present new patentability questions involving the same claims and rejections to avoid *res judicata*.

While this interlocutory practice runs counter to notions of compact prosecution and avoiding piecemeal prosecution,<sup>5</sup> we nonetheless conclude that *res judicata* does not apply here. First, the patentability issues raised before the Board in the earlier appeal pertained solely to whether (1) the Examiner’s reliance on Upton’s corresponding provisional application in the rejection was appropriate, and (2) whether the prior art would have taught or

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<sup>5</sup> See MPEP § 707.07(g) (“Piecemeal examination should be avoided as much as possible.”); see also *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (noting that belated arguments on appeal impose costs on the Agency (particularly on the Examiner, the Technology Center Directors, and the Board), which in turn imposes costs on the public who must wait longer for the benefits provided by a healthy and vigorous patent system).

suggested selecting error text corresponding to a validation error. FF 7. The issue of whether Appellants could disqualify Upton as a prior art reference via the submitted declaration evidence was simply not raised in the earlier appeal despite this evidence having been entered and considered by the Examiner during prosecution before the earlier appeal. *See* FF 1-6. That Appellants indicated that they did not rely on evidence submitted under § 1.131 or “any other evidence entered by the Examiner” in the Appeal Brief’s Evidence Appendix in the earlier appeal (FF 5) all but indicates that Appellants deliberately chose not to raise the issue regarding disqualifying the Upton reference via the earlier-submitted declarations in the earlier appeal.

As Appellants indicate (Reply Br. 6), since this issue was not raised in the earlier appeal, the Board did not consider it, for the Board typically does not review uncontested aspects of rejections. *Ex parte Frye*, 94 USPQ2d 1072, 1075-76 (BPAI 2010) (precedential). Therefore, raising the Upton disqualification issue in this appeal effectively creates a new record for our review and thus presents a new patentability question, despite identical claims and rejections to those in the earlier appeal. *See Russell*, 439 F.2d at 1230. Although the evidence on which this issue turns was previously entered and considered by the Examiner before the earlier appeal, it was simply not germane to the issues raised in the earlier appeal and, not surprisingly, not discussed by Appellants, the Examiner, nor the Board in connection with that appeal. FF 6.

Since the Board did not render an earlier decision on the issue raised before us in this appeal—an essential element of *res judicata*<sup>6</sup>—the doctrine does not apply. To the extent that Appellants’ failure to raise the Upton disqualification issue and corresponding evidence in the earlier appeal—despite having ample opportunity to do so—constitutes a waiver of raising the issue in this appeal is a question we decline to reach.<sup>7</sup> What is clear, however, is that *res judicata* does not apply.

We are therefore persuaded that the Examiner erred in rejecting claims 1-5 under the doctrine of *res judicata*.

#### THE OBVIOUSNESS REJECTIONS

Appellants do not dispute the Examiner’s findings regarding the obviousness rejections based on Upton, Jeffries, Homer, and Hartman. Ans. 5-10. Rather, Appellants contend that Upton does not qualify as prior art since Appellants evidenced a date of invention before Upton’s effective filing date. Specifically, Appellants contend that, based on the submitted declarative evidence, they (1) actually reduced the claimed invention to practice before Upton’s filing date (App. Br. 4-6, 10-12; Reply Br. 2-4); (2) conceived the claimed invention before Upton’s filing date; and (3) exercised due diligence from before that date to when the present application

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<sup>6</sup> See RESTATEMENT (SECOND) OF JUDGMENTS §§ 17, 24 (1982) (noting that an essential element of *res judicata* is an earlier decision *on the issue*).

<sup>7</sup> We also express no opinion regarding whether Appellants’ belatedly raising the Upton disqualification issue in prosecution after apparently abandoning that position earlier in prosecution (e.g., in connection with the first appeal) constitutes prosecution history laches. We leave this issue to the Examiner to determine in the first instance. See MPEP § 2190 (discussing prosecution history laches).

was filed (i.e., constructively reduced to practice) (App. Br. 6-10, 12-13; Reply Br. 4-5).

The Examiner, however, contends that since Appellants did not provide results of tests that actually occurred and were successful from a system or apparatus, Appellants do not evidence an actual reduction to practice. Ans. 10. The Examiner adds that Appellants fail to evidence reasonable diligence from before Upton's filing date to the present application's filing date. Ans. 11-12.

### ISSUE

Has the Examiner erred in relying on Upton to reject claims 1-5 and 11 under § 103? This issue turns on whether Upton qualifies as prior art which likewise turns on whether Appellants:

(1) actually reduced the claimed invention to practice before Upton's filing date; or

(2)(a) conceived the claimed invention before Upton's filing date; and  
(b) exercised reasonable diligence from before that date to when the present application was filed.

### ADDITIONAL FINDINGS OF FACT

8. The filing date of the present application is January 3, 2002.

9. Upton was filed October 15, 2002. On Upton's front page, Provisional applications 60/347,919 and 60/347,901 are cited, both of which were filed October 18, 2001.

10. The Inventors' Declaration includes an attached IBM disclosure document "Disclosure RSW8-2000-0307" entitled "Inline Error

Highlighting for HTML 3.2 Clients” with a submission date of December 20, 2000 (“the Disclosure Document”). All four inventors are listed. Inventors’ Decl., Exh. A, at 1.

11. The Disclosure Document indicates that Appellants “[n]eeded to find a way to display dynamic error messages using only HTML 3.2. The error messages had to be displayed near the object with the invalid data. The messages also had to be created dynamically according to the data provided by the user.” Inventors’ Decl., Exh. A, at 2.

12. The Disclosure Document indicates that “[t]he presentation and placement of the error message was important part [*sic*] of the solution[,]” and notes the following:

[O]ur requirement was to use HTML 3.2 only. . . . We decided to place the error message right under the invalid object. By having the error message near the object, [it] creates an environment where the object and error message is visible together. In order to place the error message beneath the object, we would reload the page and add an extra row underneath the object. This new row would contain the error message.

Inventors’ Decl., Exh. A, at 2.

13. According to the Disclosure Document:

Another concern was to ensure that the displayed message was distinctive from the rest of text on the page. . . . To achieve that effect the row, that was added in order to hold the error message, was given a background color . . . . By giving the error message a different background[,] it made the message text look visually different from the regular text on the page.

Inventors’ Decl., Exh. A, at 2.

14. The Disclosure Document includes a rectangular box with the numeral “5” therein adjacent to an exclamation point inside a graphical

circular symbol. The legend “A Test Input Number” is located above the box. A legend “A Test Input Number (min 10, max 99)’ is too small. It has to be at least 10.” is shown in reverse highlighting and located below the box. Inventors’ Decl., Exh. A, at 2.

15. According to the Disclosure Document:

Once we displayed the error message, another concern was that would the user always immediately know that there is an invalid object. . . . Thus, we wanted that page to reload with the invalid object in the range of the window. To achieve this effect, we used the concept of jumping to a spot on the page by using the anchor tag and “#” in the URL.

Inventors’ Decl., Exh. A, at 3.

16. According to the Disclosure Document:

The invention is implemented in the Unity CSA Web-Served solution, which is currently under development. This product is a component in the Common System Administration tooling being developed to bring a more cohesive end-user experience and lower development cost to all IBM Administrative consoles.

Inventors’ Decl., Exh. A, at 3.

17. Appellants aver that “[a]t the time of submitting the Disclosure an experimental prototype of the Invention had been created and work had begun in producing a production version of the Invention.” Inventors’ Decl. at 2.

18. According to Appellants, “[o]n June 14, 2001, work commenced on a draft document which ultimately became United States Patent Application S/N 10/041,141 (the ‘Patent Application’) and on October 29, 2001, we reviewed a final draft of the Patent Application.” Inventors’ Decl. at 2.

## ANALYSIS

### *Actual Reduction to Practice*

Based on the record before us, we agree with the Examiner (Ans. 10) that Appellants have not established an actual reduction to practice of the claimed invention before Upton's effective filing date of October 18, 2001. "Proof of actual reduction to practice requires more than theoretical capability. . . ." Rather, Appellants must show that the apparatus (1) actually existed, and (2) worked for its intended purpose. *In re Asahi/America, Inc.*, 68 F.3d 442, 445 (Fed. Cir. 1995) (citations omitted); *see also* MPEP § 715.07(III). However, "[t]here are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *Id.* (emphasis added).

Although the content detailed in the Disclosure Document is reasonably commensurate with the claimed invention, and was submitted on December 20, 2000 which is before Upton's effective filing date of October 18, 2001 (FF 9-10), it does not evidence an actual reduction to practice, even when considered with other evidence on the record before us. To be sure, the invention's error message presentation and visibility aspects appear relatively simple and are implemented via HTML. *See* FF 10-15. But despite the invention's relative simplicity, there is still no proof on this record that the claimed invention actually existed, let alone that it worked for its intended purpose before Upton's filing date.

We reach this conclusion despite the fact that the Appellants indicate that an experimental prototype of the invention had been created and work had begun in producing a production version of the invention when the Disclosure Document was submitted. FF 17. On this record, however, there

is scant description of this prototype or “production version,” let alone the production version’s operational status (i.e., how much work had been done on the production version and whether it could achieve the results of the claimed invention) before Upton’s filing date.

We recognize that the Disclosure Document includes instances of terminology in the past tense which, by describing what happened in the past, arguably suggests that the invention actually existed and worked for its intended purpose. *See, e.g.*, FF 12-13, 15. But the Disclosure Document is short on specifics on exactly what apparatus was used, let alone the specific HTML code used to achieve the indicated results. Nor will we speculate in this regard here. Although the Disclosure Document indicates that the invention was “implemented in the Unity CSA Web-Served solution,” this implementation was nonetheless indicated as “under development.” FF 16. Based on this minimal description, we cannot say that Appellants have adequately shown that an apparatus actually existed and worked for its intended purpose. Indeed, it is equally plausible that the Disclosure Document describes a theoretical capability of the invention.

Notably, Appellants have provided no photographs of the invention, actual test results, descriptions of prototypes, etc. that would tend to prove that the invention was constructed (i.e., the invention actually existed in a physical, tangible form). Indeed, it is this type of documentary evidence showing an actual, physical construction of the invention that is needed to prove an actual reduction to practice. *See Wetmore v. Quick*, 536 F.2d 937, 941 (CCPA 1976) (“[A]n actual reduction to practice requires a showing of an embodiment of the invention in a physical or tangible form which shows every element of the invention defined in the count, and which

demonstrates the utility of the invention.”) (emphasis added); *see also* MPEP §§ 2138.05(II)-(III).

Appellants contend that the rectangular box with the associated adjacent error message in reverse highlighting (FF 14) is “[t]he result of a successful test.” App. Br. 5-6. But as the Examiner indicates (Ans. 10), this illustration is not a screen shot of an actual implementation of the invention. Rather, it merely illustrates desired results from the invention which, while evidencing conception, falls short of proving an actual reduction to practice.

To be sure, certain documentary evidence has been held to be sufficient to show such construction. As the MPEP indicates, “[p]hotographs, coupled with articles and a technical report describing the coupling in detail [in *Asahi*] were sufficient to show reduction to practice,” MPEP § 715.07(III) (emphasis added). Specifically, in *Asahi*, evidence was presented that the claimed coupling was manufactured by an outside vendor and described in two trade publications. Two of the three articles included photographs of the coupling. Also, the declaration in *Asahi* included a letter from the patent attorney that not only referred to a technical report detailing the system, but also referred to prototypes that the attorney received. *Asahi*, 68 F.3d at 446 (emphasis added). The court held that “[t]he photograph, coupled with the entirety of the 131 declaration, establishes that the coupling was constructed and therefore reduced to practice....” *Id.* at 447 (emphasis added). Thus, the court in *Asahi* was convinced that the invention was constructed as evidenced by the photograph of such construction, along with the other submitted evidence pertaining to prototypes and manufacturing of the coupling.

But here, we have no evidence of this sort to prove such construction. Simply put, the Disclosure Document, along with the other submitted evidence on the record before us, falls short of proving that the claimed invention actually existed and worked for its intended purpose before October 18, 2001. Therefore, Appellants have not established an actual reduction to practice of the claimed invention before that date.

*Conception and Reasonable Diligence to the Constructive Reduction to Practice*

Although we find that the Disclosure Document evidences that the claimed invention was conceived before Upton's filing date—a point that is undisputed<sup>8</sup>—we nonetheless agree with the Examiner (Ans. 11-12) that Appellants fail to evidence reasonable diligence from before Upton's filing date to when the application was filed (the constructive reduction to practice).

That said, Appellants have evidenced reasonable diligence on the part of their attorney from November 8, 2001 (when Appellants executed the Declaration and Power of Attorney) to the present application's filing date on January 3, 2002. We reach this conclusion noting that the attorney (1) took up this particular matter in the ordinary course of ongoing work and in chronological order, and (2) handled 20 patent applications during this period which included three major holidays. Woods Decl., at 2-3. The evidence therefore shows that the attorney expeditiously prepared and filed the application during this period and therefore was reasonably diligent. *See*

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<sup>8</sup> *See* Ans. 11 (admitting that Appellants conceived the invention before October 2001).

Appeal 2010-011553  
Application 10/041,141

*Bey v. Kollonitsch*, 806 F.2d 1024, 1027 (Fed. Cir. 1986) (noting that reasonable diligence can be shown by establishing that “the attorney worked reasonably hard on the particular application in question during the continuous critical period”).

But on this record, we cannot say that Appellants were reasonably diligent from before Upton’s effective filing date to when the declaration and power of attorney was executed on November 8, 2001. To be sure, an experimental prototype of the invention had been created when the Disclosure Document was submitted in December 2000, and work had begun on a production version. FF 17. And on June 14, 2001, work started on a draft document that ultimately became the present application. FF 18. Nevertheless, there is scant evidence of specific activities by Appellants throughout this period to show reasonable diligence on their part. Although Appellants reviewed a final draft of the present application on October 29, 2001 (*id.*), this review is after Upton’s effective filing date. In any event, there also scant evidence on this record detailing the activities from before Upton’s effective filing date to when Appellants executed the power of attorney on November 8, 2001. Accordingly, on this record, Appellants have failed to evidence reasonable diligence from before Upton’s filing date to when the application was filed (the constructive reduction to practice).

Since Appellant has failed to show a date of invention before Upton’s effective filing date, Upton therefore qualifies as prior art. Accordingly, we are not persuaded that the Examiner erred in rejecting claims 1-5 and 11 under § 103 based on this reference.

### CONCLUSION

The Examiner erred in rejecting claims 1-5 under the doctrine of *res judicata*. We therefore reverse this rejection. The Examiner, however, did not err in rejecting claims 1-5 and 11 under § 103. We therefore affirm this rejection.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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DIXON, *Administrative Patent Judge*, DISSENTING.

I respectfully dissent from the majority's reversing the Examiner's obviousness rejection of claim 1, and I would reverse all of the Examiner's rejections.

While I agree with the majority's determinations concerning the doctrine of res judicata and the Appellants' conception prior to the critical date of October 18, 2001, I respectfully disagree with the majority's determination of scant evidence of actual reduction to practice and scant evidence of evidence of reasonable diligence from the date just prior to October 18, 2001.

Actual Reduction to Practice:

From my review of the instant claimed invention, the prosecution history, and the proffered evidence filed in the form of a 37 CFR § 1.131 declaration by the four inventors and the proffered evidence filed in the form of a 37 CFR §1.131 declaration<sup>9</sup> of the Appellants' representative Gerald R. Woods, I find sufficient evidence of actual reduction to practice.

Appellant has argued since the Amendment, filed August 10, 2005 (p. 6) that:

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<sup>9</sup> I note that the indication of this declaration under 37 CFR §1.131 is in error and actually must be a declaration under 37 CFR §1.132 since Mr. Woods is not an inventor.

As stated on paragraph (4.) on page 2 of the Declaration, "[a]t the time of submitting the Disclosure an experimental prototype of the Invention had been created and work had begun in producing a production version of the Invention." Thus, actual reduction to practice had been achieved by Applicants. As noted in M.P.E.P. § 715.07, "[i]n general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, 'there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.'" Applicants respectfully submit that the experimental prototype of the Invention described in the Declaration constitutes an actual reduction to practice that meets the requirements of showing (A) referred to above.

I agree with Appellants that the proffered showing meets at least a minimum required showing for a preponderance of evidence standard. While the majority would like more evidence, I do not see such a requirement to be required for a preponderance of evidence standard. Considering the complexity of the instant invention in an informational based invention, I find the inventors' declaration that an experimental prototype of the invention, which the majority has accepted as evidencing conception thereof, had been created and worked for its intended purposes. I find the fact that the inventors additionally noted that work had begun on a "production version of the invention" which appears to be the integration with the "Unity CSA Web-Served solution, which is currently under development" to additionally support Appellants' contention of actual reduction to practice. I find that the assignee would not have gone forward on a "production version" in the "Unity CSA Web-Served solution, which is currently under development" if the invention had not been actually reduced to practice, at least to the extent recited in independent claim 1.

With my finding of actual reduction to practice, there would be no need for a showing of diligence as required by the majority. Therefore, I would reverse the Examiner's obviousness rejection since the Upton reference would be disqualified as prior art against the claimed invention.

Diligence:

Alternatively, if actual reduction to practice did not take place at a time before the submission of the disclosure document, and that Appellants must rely upon their filing date as a constructive reduction to practice, I find that Appellants and their representatives exercised reasonable diligence in the preparation of the patent application and filing thereof.

Again, the majority would like additional information to find reasonable diligence. I find this requirement for additional evidence unnecessary for a showing by a preponderance of the evidence. The declaration of Mr. Woods (under 37 C.F.R. §1.132) evidences a filing of 20 patent applications within the window of time from October 17, 2001 (just before the critical date of October 18, 2001) to the filing date of January 3, 2002. While Mr. Woods' declaration evidences the dates and processes for the present application, I would note that each of the other 19 applications would have had similar reviews and required execution of documents which parallel the process as set forth by Mr. Woods with respect to the instant application. Therefore, I find that the inventors and their representative Mr. Woods and his staff exercised reasonable diligence from a date just prior to October 18, 2001. While the majority may desire additional evidence to show reasonable diligence, I find the systematic processing of the numerous

Appeal 2010-011553  
Application 10/041,141

patent applications to clearly evidence the required reasonable diligence from a time just before the critical date of October 18, 2001.

I find constructive reduction to practice as of the date of the filing of the application and a showing of reasonable diligence from a date just prior to the critical date of October 18, 2001. Therefore, I would reverse the Examiner's obviousness rejection since the Upton reference would be disqualified as prior art against the claimed invention.

Vsh