



Board of Patent Appeals  
and Interferences

**Informative**

Opinion

The opinion in support of the decision being entered today is not binding precedent of the board

Paper 109

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ROBERT F. SHAW

Appeal 1997-3258  
Application 07/117,393<sup>1</sup>

MAILED  
DEC 19 2005  
PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before: FLEMING, Chief Administrative Patent Judge, and HARKCOM, Vice-Chief Administrative Patent Judge, and THOMAS and GARRIS, Administrative Patent Judges, and McKELVEY, Senior Administrative Patent Judge.

McKelvey, Senior Administrative Patent Judge.

**MEMORANDUM OPINION and ORDER DENYING REHEARING**  
**37 CFR § 41.52(a)(1)**

**A. Introduction**

Applicant seeks rehearing of our DECISION ON APPEAL UNDER 35 U.S.C. § 134 (Paper 94, entered 21 May 2004).<sup>2</sup> See REQUEST FOR REHEARING UNDER 37 C.F.R. § 1.197(d) (Paper 95, filed 21 July 2004) (hereinafter "REQUEST FOR REHEARING").

We delayed action on the REQUEST FOR REHEARING with the expectation that applicant might provide us more information as to the status of a civil action which forms part of the basis of

<sup>1</sup> Application for patent filed 2 November 1987. The real party in interest is applicant, Dr. Robert F. Shaw (Supplemental Brief on Appeal, Paper 66, page 1). The application on appeal is said to be a continuation of application 06/295,929, filed 21 June 1981 (Papers 1-28), which is said to be a division of application 05/898,388, filed 20 April 1978.

<sup>2</sup> An updated Table of Contents appears as Appendix 2 to this opinion; Appendix 1, an earlier version of the Table of Contents, appears in our original opinion (Paper 94, page 3 n.3).

our decision to affirm the examiner's rejection based on a lack of enablement. Since applicant did not come forward on his own, we entered an ORDER FOR APPLICANT TO BRIEF ADDITIONAL MATTERS (Paper 96).

Applicant has responded to our ORDER. See RESPONSE TO BOARD'S ORDER FOR APPLICATION TO BRIEF ADDITIONAL MATTERS UNDER 37 C.F.R. § 41.50(d) (Paper 100) (hereinafter "RESPONSE"). The RESPONSE is deemed to have been timely filed.

The following documents accompanied applicant's RESPONSE:

1. Transmittal Letter (Paper 99).
2. Response to board's order (Paper 100).
3. Express Mail Certificate (Paper 101).
4. Declaration of Charles R. Brustman (Paper 102).
5. Declaration of Chi-Hsin Chang (Paper 103).
6. Declaration of Drago N. Gregov (Paper 104).
7. Declaration of Robert C. Morgan (Paper 105).
8. Declaration of Nicola A. Pisano (Paper 106), accompanied by a NOTICE OF APPEARANCE AND REQUEST FOR SERVICE filed in the U.S. District Court for the Northern District of California in Shaw v. Carter, Civil Action C-86-5575 MHP.
9. Declaration of S. Craig Rochester (Paper 107), accompanied by:
  - a. Exhibit 1: DEFENDANTS' NOTICE OF MOTION AND MOTION FOR SUMMARY JUDGMENT ON COUNT ONE OF THE COMPLAINT filed in Shaw v. Carter (N.D. Cal.).
  - b. Exhibit 2: Docket entries 1-73 in Shaw v. Carter.
  - c. Exhibit 3: PLAINTIFF SHAW'S MEMORANDUM IN OPPOSITION TO MOTION FOR SUMMARY JUDGMENT filed in Shaw v. Carter.
  - d. Exhibit 4: RAYCHEM MEMORANDUM IN OPPOSITION TO MOTION FOR SUMMARY JUDGMENT-COUNT ONE OF COMPLAINT filed in Shaw v. Carter.

- e. Exhibit 5: STIPULATED REQUEST FOR DISMISSAL OF CLAIMS BETWEEN RAYCHEM AND DEFENDANTS (F.R.C.P. 41(a)(2)) filed in Shaw v. Carter.
  - f. Exhibit 6: Letter dated 11 May 1988 from Patrick J. Mahoney to Magistrate Judge Claudia Wilkens of the Northern District of California.
10. Declaration of Mark D, Rowland (Paper 108), accompanied by a letter dated 11 July 2005 from Rowland to Hon. Marilyn Patel, U.S. District Judge in the Northern District of California.

**B. Findings of fact**

Findings 1 through 114 appear in our DECISION ON APPEAL UNDER 35 U.S.C. § 134 (Paper 94).

Based on applicant's RESPONSE (Paper 100) and accompanying documents, we make the following additional Findings of Fact 115 through 171, all of which are believed to be supported by at least a preponderance of the evidence.

We adhere to our original Findings of Fact 1 through 114 unless inconsistent with the additional Findings of Fact set out below.

Applicant's knowledge of dismissal of civil action

115. In Carter v. Shaw, Interference 100,775, the board entered a final decision on 05 August 1986 (100,775, Paper 1, page 1).

116. The board's decision was adverse to Shaw.

117. In Shaw v. Carter, Civil Action C-86-5575 MHP (N.D. Cal.), filed on 30 September 1986, Shaw sought judicial review under 35 U.S.C. § 146 of the adverse decision entered by the board in Interference 100,775 (RESPONSE, page 2; Rochester Declaration, Paper 107, Exhibit 2, Docket Entry 1<sup>3</sup>).

118. The U.S. District Court for the Northern District of California assigned judicial oversight of the civil action to Hon. Marilyn Hall Patel, U.S. District Judge.

119. The civil action has been dismissed.

120. No later than the evening of 2 May 2000, an attorney for applicant (Nicola A. Pisano, Esq.) learned that the civil action had been dismissed (Pisano Declaration, Paper 107, ¶¶ 6, 9 & 10). See also Paper 94, page 20, Finding 96.

121. Our understanding of applicant's position is that applicant did not know prior to the evening of 2 May 2000 that the civil action had been dismissed.

122. In any event, "[c]ounsel for applicant \*\*\* discussed the matter with applicant \*\*\* after learning of [the] dismissal in 2000, and began to make inquiries with the [District] Court in April of 2003" (RESPONSE, Paper 100, page 6).

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<sup>3</sup> We note that the copy of the Docket Entries submitted as Exhibit 2 is not complete. For example, the dates on at least the first page are not complete. In any event, we know from other sources that the Civil Action was filed in 1986 (see the Docket Entries in Exhibit A of Paper 47 and Paper 17, page 2).

### Activity in the civil action

123. The docket entries for the civil action reveal that some activity took place in the civil action between 30 September 1986 (when the civil action was filed) and at least 21 March 1988.<sup>4</sup>

124. Among other things, on or about 25 September 1987 defendant Carter filed a motion for summary judgment on count one of the complaint (Rochester Declaration, Paper 107, Exhibit 1; Exhibit 2, docket entry #47).

125. We will assume that "count one" sought to set aside, i.e., "reversal," of the board's final decision in Interference 100,775.

126. On 19 October 1987, plaintiff Shaw (applicant) filed a memorandum in opposition to defendant Carter's motion for summary judgment (Rochester Declaration, Paper 107, Exhibit 3).

127. On 20 October 1987, plaintiff Raychem filed its memorandum in opposition to defendant Carter's motion for summary judgment (Rochester Declaration, Paper 107, Exhibit 4).

128. The docket entries do not reveal that the district court rendered a decision on the motion for summary judgment.

129. "[S]ettlement discussions" are said to have taken place "from time to time during the years 1987 to 1996" (Morgan Declaration, Paper 105, ¶ 5; Rochester Declaration, Paper 107, ¶ 12 and Exhibit 6--letter to Hon. Claudia Wilkens, Magistrate Judge for the Northern District of California).

### Effort to determine why civil action was dismissed

130. According to applicant, efforts have been made to determine why the civil action has been dismissed.

### Pisano

131. Nicola A. Pisano, Esq., represented applicant from about 1991 through 2003 (Pisano Declaration, Paper 106, ¶¶ 3-4; see also Paper 47, page 14).

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<sup>4</sup> We believe the 21 March 1988 date to be correct. As noted earlier, the copy of the docket entries is not complete.

132. Pisano states that on 17 February 1999, she placed a call to one of Judge Patel's "court clerks" (Pisano Declaration, Paper 106, ¶ 8).

133. According to Pisano, the clerk advised Pisano that the civil action was pending.

134. On 2 May 2000, Pisano contacted a "docket clerk" and "was surprised to learn" that the civil action had been, in her words, "administratively dismissed" (Pisano Declaration, Paper 106, ¶ 9).

135. Pisano represents that she did not receive "notice" that the civil action had been dismissed.

136. By "notice", we assume Pisano means "written notice" because on 02 May 2000 Pisano received oral notice from the docket clerk that the civil action had been dismissed.

#### Morgan

137. Robert C. Morgan, Esq., was an attorney of record in the civil action (Morgan Declaration, Paper 105, ¶ 4) and in the application on appeal (Paper 37).

138. Morgan participated in settlement discussions from 1987 to 1996 (Morgan Declaration, Paper 105, ¶ 5).<sup>5</sup>

139. Morgan represents that he did not receive written notice that the civil action had been dismissed (Morgan Declaration, Paper 105, ¶ 7).

140. Morgan says that he learned of the dismissal from Pisano (Morgan Declaration, Paper 105, ¶ 8).

#### Chang & Gregov

141. Chi-Hsin Chang, now a registered patent agent, at all relevant times worked for firms representing applicant in the civil action (Chang Declaration, Paper 103, ¶ 1).<sup>6</sup>

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<sup>5</sup> See also Paper 45, ¶ 5 discussing settlement discussions.

<sup>6</sup> The firms include (1) Fish & Neave, (2) Fish & Neave LLP and (3) Fish & Neave Intellectual Property Group of Ropes and Gray. Chang Declaration, Paper 103, ¶ 1.

142. During the period from April 2003 through "the present", which we take to be 22 September 2005--the date Chang appears to have signed her declaration--Chang performed various investigations into the dismissal of the civil action (Chang Declaration, Paper 103, ¶¶ 3 & 4).

143. Chang states that she found out from a librarian at Fish & Neave who found out from Washington Document Service ("WDS") that a PACER sheet showed the civil action had been dismissed (Chang Declaration, Paper 103, ¶ 5).<sup>7</sup>

144. Chang also found out through the same "channel" that the file for the civil action in the Northern District of California "was not available through the archives" and "may not have been archived at all" (Chang Declaration, Paper 103, ¶¶ 7 & 8).

145. Chang tells us that the firm records do not include any paper indicating that the civil action had been administratively dismissed (Chang Declaration, Paper 103, ¶ 9).

146. On at least five different days between 30 September 2003 and 15 October 2003, Chang, along with Drago Gregov, searched the firm records for information about the dismissal, all without success (Chang Declaration, Paper 103, ¶ 10; Gregov Declaration, Paper 104, ¶ 3).

147. On several occasions, Chang placed calls to Gina Augustine-Rivas, who is said to be Judge Patel's "docket clerk" (Chang Declaration, Paper 103, ¶ 11).

148. Those occasions are said to have occurred on the following dates:

- a. 23 December 2003
- b. 08 January 2004
- c. 02 November 2004
- d. 09 November 2004
- e. 18 November 2004

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<sup>7</sup> Chang's statement is hearsay within hearsay. Nevertheless, we will consider the statement.

149. We note that the time period between 08 January 2004 and 02 November 2004 is considerable.

150. The calls are said to have been made to (1) request assistance in obtaining a copy of "the docket modification" (which we assume means the "modification" "administratively" dismissing the civil action) and (2) determine the status of the case (Chang Declaration, Paper 103, ¶ 11).

151. On other occasions, Chang left "numerous" voice mail messages for Augustine-Rivas (Chang Declaration, Paper 103, ¶ 12)

152. Chang says that Augustine-Rivas "gave me [Chang] assurances that she [Augustine-Rivas] was investigating the matter" (Chang Declaration, Paper 103, ¶ 13).

153. Chang represents that Augustine-Rivas "never returned any of my voice-mail messages" (Chang Declaration, Paper 103, ¶ 15).

154. On 22 December 2004, Chang and Gregov went to the Federal Courthouse in San Francisco, California, to further inquire into the "status" of the civil action (Chang Declaration, Paper 103, ¶ 16; Gregov Declaration, Paper 104, ¶ 5).

155. Chang and Gregov say they spoke with Augustine-Rivas, who is said to have said that she remembers seeing the file for the case and would look for the "administrative docket modification in the file" (Chang Declaration, Paper 103, ¶ 17; Gregov Declaration, Paper 104, ¶ 5).

156. Gregov says he gave Augustine-Rivas his business card and asked her to call him if she learned anything (Gregov Declaration, Paper 104, ¶ 5; Chang Declaration, Paper 103, ¶ 18).

157. According to Chang, Augustine-Rivas thereafter never contacted anyone at the firm with respect to the civil action (Chang Declaration, Paper 103, ¶ 19)

158. Gregov likewise says that Augustine-Rivas never contacted him (Gregov Declaration, Paper 104, ¶ 6).



159. Chang says she called Augustine-Rivas on 11 January 2005 and left a voice mail, but no return phone call was received (Chang Declaration, Paper 103, ¶ 20).

160. Several months later, on 09 September 2005, Chang again called Augustine-Rivas (Chang Declaration, Paper 103, ¶ 21).

161. Apparently Chang and Augustine-Rivas had a discussion in which (1) Augustine-Rivas is said to have indicated that the administrative dismissal would not have "generated any papers" and (2) that administrative dismissals "are entered directly into the computer at the request of Judge Patel" (Chang Declaration, Paper 103, ¶ 21).

162. Augustine-Rivas is said to have suggested to Chang that Chang contact an Anthony Bowser who is said to be Judge Patel's "courtroom deputy clerk" (Chang Declaration, Paper 103, ¶ 22).

163. Chang tells us that on 09 and 15 September 2005, she called Bowser and left voice mails, neither of which is said to have been returned (Chang Declaration, Paper 103, ¶ 23).

#### Rowland

164. Mark D. Rowland, Esq., works for Fish & Neave Intellectual Property Group of Ropes & Gray LLP (Rowland Declaration, Paper 108, ¶ 1).

165. On 11 July 2005, Rowland sent a letter to Judge Patel (Rowland Declaration, Paper 108, ¶ 4 and Exhibit 1).

166. The letter, which speaks for itself, requests Judge Patel to assist Rowland in obtaining information about the dismissal of the civil action (Rowland Declaration, Exhibit 1).

167. Conspicuously absent from the letter is any indication that it was served on, or otherwise sent to, counsel for Carter.

#### Brustman declaration

168. Charles R. Brustman is a "managing clerk" in the Fish & Neave Intellectual Property Law Group of Ropes and Gray LLP (Brustman Declaration, Paper 102, ¶ 1).

169. Brustman tells us that in Polaroid v. Kodak, a civil action in the District of Massachusetts, the court rendered a decision three and one-half years after conclusion of a trial (Brustman Declaration, Paper 102, ¶¶ 4 & 5).

170. The Brustman Declaration is given no weight in this appeal on the ground that its content, assuming the content to be true, is irrelevant to any issue in this appeal.

171. The fact that a district court in Massachusetts may have needed three and one-half years to decide a civil action in that court has nothing to do with why a different civil action in a different district court has been dismissed.

### C. Discussion

#### 1. There has been an adjudication on the merits

Applicant maintains that issue preclusion is not appropriate because there has not been an adjudication on the merits (REQUEST FOR REHEARING, page 7). We disagree.

The board in Interference 100,775 entered a decision on the merits holding that applicant did not enable his claimed apparatus involved in the interference. Judicial review was sought by civil action under 35 U.S.C. § 146. The civil action in which judicial review was sought has been dismissed. The time for appeal of the dismissal has expired. Under 35 U.S.C. § 135(a), once an appeal cannot be taken, the Patent and Trademark Office implements the judgment in the interference.

In this case, the board's undisturbed "judgment" is that applicant was not entitled to the apparatus claims of the application involved in the interference based on lack of enablement.

The following is apparent: (1) there has been an administrative adjudication by the board on the merits, (2) the adjudication was not disturbed on judicial review and (3) the administrative adjudication is sufficient to support application of issue preclusion. See United States v. Utah Construction & Mining Co., 384 U.S. 394, 421, 86 S.Ct. 1545, 1559-60 (1966). See also Astoria Federal Savings and Loan Ass'n. v. Solimino, 501

U.S. 104, 107, 111 S.Ct. 2166, 2169 (1991), both cited in our original decision (Paper 94, page 25).

Applicant maintains that the Northern District of California never decided the civil action on the merits. But, applicant cannot deny that the civil action has been dismissed without affecting in any way the merits decision entered by the board in Interference 100,775.

Applicant's principal position seems to be that the civil action should not have been dismissed. We are in no position, one way or the other, to (1) overlook the dismissal or (2) determine, as applicant would seem to want us to do, that the district court should not have entered the dismissal, "administrative" or otherwise.

It is curious to us that applicant seems to have been somewhat indifferent upon learning of the dismissal. No cogent explanation has been given as to why action was not taken reasonably soon after the evening of 02 May 2000 to undo what applicant calls an administrative dismissal.<sup>8</sup>

There are two ways to "get" a district court "to do something": (1) file a complaint asking for relief or (2) file a motion. Making phone calls years after the fact to court personnel cannot take the place of an inter partes motion. At this late date, more than 5 years after learning that the civil action had been dismissed, a formal motion to "undo" the dismissal apparently has not been filed with the Northern District of California or served on counsel for Carter. We express no views on whether such a motion, if timely filed, would be or would have been granted or denied. Nor do we know what Carter would have said about any motion which might have been

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<sup>8</sup> Applicant's inaction upon learning of the dismissal of the civil action should be contrasted with applicant's action in seeking to revive the parent application upon learning of its abandonment. A notice of abandonment was issued on 17 August 1983 (Paper 6). Shortly thereafter, on 12 September 1983, applicant appointed new counsel (Paper 7). A petition to revive was filed on 15 March 1984 (Paper 10) and was granted on 12 April 1984 (Paper 11).

filed. What we do know is that the complaint filed in the civil action has been dismissed.

We note that applicant represents that numerous attempts have been made to "communicate" with court personnel about the dismissal--all in applicant's view without success. Our own observation is that it is not court personnel's responsibility to "revive" applicant's civil action. At the end of the day it was up to applicant, not court personnel, to file (and serve) an inter partes motion to have the dismissal set aside and applicant did not file a motion.

We also have been told about a letter sent on 11 July 2005 to Judge Patel by Mark D. Rowland. The letter was not served on any attorney for Carter. Hence, we are not in the least bit surprised that Mr. Rowland has not heard back from Judge Patel; judges do not engage in ex parte communications with counsel for one of the parties.<sup>9</sup>

At the end of the day all the phone calls (whether returned or not) and letters have not changed the fact that the civil action stands dismissed.

## 2. Equities

Application of issue preclusion is discretionary (Paper 94, page 27). Applicant maintains that "equity" and "fairness" dictate in this case that discretion be exercised to not apply issue preclusion. A review of facts shows that applicant does not "have the cleanest of hands" and that application of issue preclusion in this case is consistent with the equities in this case.

### a.

Defendant Carter, not applicant, filed a motion for summary judgment in the civil action in September of 1987. Applicant filed an opposition in October of 1987. According to applicant,

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<sup>9</sup> In this respect, attention is directed to comments made by Pisano to the examiner concerning ex parte communications with a court (Paper 47, page 2).

the summary judgment motion filed in 1987 has not been decided. It is now 2005. One can reasonably conclude that applicant was not diligent in attempting to have the court decide Carter's motion for summary judgment. In the mean time, the Carter and Krumme patent has expired and Krumme never had a chance to have his reissue application involved in the interference examined on the merits after termination of the interference.

The summary judgment motion is said to have been related to "count one" of the complaint. We have assumed that "count one" deals with the issue decided by the board in Interference 100,775. Applicant has not explained why a decision denying Carter's motion for summary judgment per se results in a determination that the board incorrectly decided the interference. Applicant apparently did not file a cross-motion for summary judgment. Carter's motion could have been denied without reaching the merits, e.g., because a material fact could have been in dispute thereby necessitating a trial.

b.

There is something odd about:

- (1) an applicant filing a civil action under 35 U.S.C. § 146 in 1986 to seek review of a decision that an apparatus he claimed is not sufficiently disclosed;
- (2) allowing the civil action to languish before the district court,
- (3) finding out in 2000 that the civil action had been dismissed,
- (4) failing to take appropriate steps (e.g., filing an inter partes motion) even as late as 2005 to have the dismissal vacated and
- (5) then attempting to secure ex parte a patent to a method of using an apparatus, where (i) the other side's patent to the apparatus expired during the pendency of the civil action and (ii) the other side can no longer participate.

The patent involved in the interference and civil action has expired. There is no reliable evidence that applicant attempted inter partes in any timely manner to call Judge Patel's attention to an undecided summary judgment motion. By not attending to the civil action in a timely manner, applicant has not come to grips with the fact that the patent involved in the civil action has expired and that the public would now be prejudiced if we were to authorize a patent to a method of using an apparatus which has been held to have been insufficiently disclosed. We believe it was up to applicant to prosecute the civil action in a more timely fashion so as not to prejudice the public interest by the late-issuance of a patent. The board merits decision against applicant in the interference, which was not disturbed as a result of the civil action, provides an adequate discretionary basis for applying issue preclusion in this case.

C.

Applicant would have us exercise discretion by not applying issue preclusion and instead to re-decide the same issue which was decided by the board in Interference 100,775. According to applicant, there is "new evidence" which applicant says was "not available in the '775 interference" and that the evidence "may very well lead to a different result than in the '775 interference" (REQUEST FOR REHEARING, page 9).

We found in our original decision that all the so-called "new" "witnesses" were individuals available at the time Interference 100,775 was pending. While applicant painting with a broad brush says those witnesses were "unavailable," the evidence suggests otherwise. See Finding 101. The so-called "new evidence" is no reason, in this case, to decline to apply issue preclusion. After all, the reason for issue preclusion is to keep from re-litigating an issue already decided.

**D. Errata**

In a paragraph bridging pages 26-27 of our DECISION ON APPEAL UNDER 35 U.S.C. § 134 (Paper 94), we state:

While the opinion in Deckler based estoppel on a board decision, we wish to point out that Deckler's assignee sought judicial review by civil action under 35 U.S.C. § 146, but -- as occurred in the present case -- the civil action was dismissed on stipulation of the parties.

That sentence should have read:

While the opinion in Deckler based estoppel on a board decision, we wish to point out that Deckler's assignee sought judicial review by civil action under 35 U.S.C. § 146, but -- as occurred in the present case -- the civil action was dismissed.

In Deckler, the civil action was dismissed on stipulation of the parties; in this case, the civil action appears to have been "administratively" dismissed.

Footnote 25 in the DECISION (Paper 94, page 27) is not affected by this errata.

**E. Order**

Upon consideration of the REQUEST FOR REHEARING, and for the reasons given, it is


ORDERED that the REQUEST FOR REHEARING is denied.

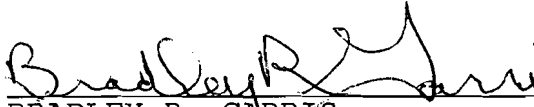
FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (2005).

FURTHER ORDERED that the time for seeking judicial review is found in 37 CFR § 1.304 (2005).

  
MICHAEL R. FLEMING, Chief  
Administrative Patent Judge

  
GARY V. HARKCOM, Vice Chief  
Administrative Patent Judge

  
JAMES D. THOMAS  
Administrative Patent Judge

  
BRADLEY R. GARRIS  
Administrative Patent Judge

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FRED E. MCKELVEY, Senior  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES



## Appendix 2<sup>10</sup>

### Table of Contents Application 06/295,929 Rule 60

01	1981-06-21	Application
02	1981-06-21	Preliminary amendment A
03	1981-06-21	Preliminary amendment B
04	1982-11-22	Request for attorneys to withdraw
05	1983-01-17	Rejection
06	1983-08-17	Notice of abandonment
07	1983-09-12	Revocation of power of attorney
08	1983-10-11	Power to inspect
09	1984-03-15	Amendment C
10	1984-03-15	Petition to revive (137(b))
11	1984-04-12	Petition to revive granted
12	1984-05-16	Suspension
13	1984-11-23	Status inquiry
14	1985-01-11	Suspension
15	1985-08-25	Status inquiry
16	1985-12-31	Suspension
17	1986-07-07	Status inquiry
18	1986-09-02	Rejection
19	1987-03-03	Amendment D and petition to suspend
20	1987-03-18	Petition dismissed
21	1987-03-03	Information disclosure statement
22	1987-03-12	Letter of protest (missing)
23	1987-03-27	Interview summary record
24	1987-03-27	Letter
25	1987-04-29	Supplemental information disclosure statement
26	1987-07-02	Rejection
27	1987-11-02	Petition for extension of time
28	1988-02-01	Notice of abandonment

### Application 07/117,393 Rule 62

29	1987-11-02	Preliminary amendment E
30	1987-11-02	Preliminary amendment F
31	1988-08-30	Final rejection
32	1989-03-06	Petition for extension of time
33	1989-03-06	Notice of appeal
34	1989-03-06	Declaration of Isackson (Ex 1-6 missing)
34½	1989-03-06	Declaration of Eggers
35	1989-03-06	Associate power of attorney
36	1989-03-06	Amendment G
37	1989-03-06	Revocation of atty/power of attorney
38	1989-03-10	Acceptance of revocation

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<sup>10</sup> Appendix 1 appears at the end of our original opinion (Paper 94).

39	1989-03-29	Suspension
40	1990-04-24	Suspension
41	1991-12-16	Suspension
42	1993-01-07	Suspension
43	1994-02-10	Rejection
44	1994-06-15	Response to Office action
45	1994-06-15	Declaration of Pisano
46	1994-07-29	Interview summary
47	1994-08-15	Supplemental response to office action
48	1994-03-25	Final rejection (missing)
49	1995-01-11	Change of address
50	1995-01-12	Final rejection (as remailed)
51	1995-04-12	Notice of appeal
52	1995-06-12	Brief on appeal
53	1995-09-06	Examiner's answer
54	1995-10-05	Power to inspect
55	1995-11-03	Reply brief
56	1996-03-12	Power to inspect
57	1997-01-24	Acknowledgement of reply brief
58	1997-10-28	Request for oral hearing
59	1997-12-31	Status inquiry
60	1998-02-18	Response to status inquiry
61	1998-10-08	Petition to make special
62	1998-10-29	Petition granted
63	1998-11-19	Change of address (via fax)
64	1999-02-01	Order (need for compliance with Rule 192(c))
65	1999-01-20	Change of address (via fax)
66	1999-03-08	Supplemental brief on appeal
67	2000-03-28	Notice of oral hearing
68	2000-04-04	Confirmation of oral hearing
69	2000-05-17	Remand to examiner
70	2000-08-31	Supplemental examiner's answer
71	2000-11-06	Reply to supplemental examiner's answer
72	2000-12-19	Acknowledgement of reply
73	2002-07-22	Letter--suspending appeal
74	2003-03-27	Decision on appeal
75	2003-05-27	Request for rehearing
76	2003-07-11	Decision denying rehearing
77	2003-09-10	Notice of appeal to Federal Circuit
78	2003-11-20	Joint Motion to Remand (filed in Fed Cir)
79	2003-12-19	Federal Circuit mandate
80	2004-03-15	Protest under 37 CFR § 1.291a
81	2004-03-15	Copy Final Rejection (Paper 50)
82	2004-03-15	Declaration of Stutz (see Paper 52)
83	2004-03-15	Declaration of Eggers (see Paper 52)
84	2004-03-15	Declaration of Eggers (see Paper 52)
85	2004-03-15	Isackson Exhibits E,F,G,H and CJR (see Paper 47)
86	2004-03-15	Exhibits 1-6 of Paper 34
87	2004-03-15	Declaration of O'Neill (see Papers 36, 47 & 52)
88	2004-03-15	Declaration of Macovski (see Papers 36, 47 & 52)
89	2004-03-15	Declaration of Ingle (see Papers 36, 47 & 52)
90	2004-03-15	Declaration of Shaw (see Papers 36 & 47)

91 2004-03-15 Declaration of Miller (see Papers 36, 47 & 52)  
92 2004-03-15 Declaration of Craig (see Papers 36 & 47)  
93 2004-03-15 Isackson Exhibits B,C and CSR (see Papers 36 & 52)  
94 2004-05-21 Decision on Appeal  
95 2004-07-21 Request for Rehearing  
96 2005-06-24 Order for Applicant to Brief Additional Matters  
97 2005-09-06 Status Inquiry  
98 2005-09-09 Acknowledgement of Status Inquiry  
99 2005-09-29 Transmittal Letter  
100 2005-09-29 Response to Board's order for additional briefing  
101 2005-09-29 Express Mail Certificate  
102 2005-09-29 Declaration of Charles R. Brustman  
103 2005-09-29 Declaration of Chi-Hsin Chang  
104 2005-09-29 Declaration of Drago N. Gregov  
105 2005-09-29 Declaration of Robert C. Morgan  
106 2005-09-29 Declaration of Nicola A. Pisano and exhibit  
107 2005-09-29 Declaration of S. Craig Rochester and exhibits  
108 2005-09-29 Declaration of Mark D. Rowland  
109 2005-12-19 Decision on Rehearing

cc (Via Federal Express):

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