

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 102

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JOHN NEDELK,

Junior Party,<sup>1</sup>

v.

IAN L. STIMSON, RICHARD J. MILLER,  
and GRAHAM CARRIER,

Senior Party.<sup>2</sup>

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Patent Interference No. 102,755

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HEARD: November 10, 1998

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STONER, Chief Administrative Patent Judge, and PATE and  
MARTIN, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

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<sup>1</sup> Patent No. 4,923,056, issued May 8, 1990, based on Application Serial No. 07/312,994, filed February 21, 1989. Assigned to Aircraft Braking Systems Corporation (ABSC).

<sup>2</sup> Application Serial No. 07/696,750, filed May 7, 1991. Assigned to Dunlop Limited. Accorded benefit of U.S. Application Serial No. 07/307,633, filed February 8, 1989, and British Application No. 8803544, filed February 16, 1988.

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The subject matter of this interference is a method of operating carbon brakes on an aircraft assembly. Count 1, the sole count, reads as follows:

A method of increasing the service life of carbon disks which form the functional braking elements of a brake disk stack of an aircraft brake assembly, each brake assembly associated with a respective wheel of a plurality of wheels which comprise a landing gear configuration of the aircraft, the method comprising the steps of:

establishing a preselected first group of brake assemblies of a total number of brake assemblies which are actuated for both low-pressure and high[-]pressure braking of the aircraft;

establishing a preselected second group of brake assemblies which comprises the remaining number of the total number of braking assemblies which are actuated only during high-pressure braking of the aircraft;

actuating the first group of brake assemblies during the taxi-snob stops of the aircraft when it is on the ground; and

actuating the first and second groups of brake assemblies during landing of the aircraft.

Although the meaning and scope of the count are not in dispute, we note that while the count does not expressly call for actuating only the first group of brake assemblies during taxi-snubs, both parties seem to have interpreted it in this way and so will we. Otherwise, the count would encompass

prior art braking systems which used all of the brakes during taxi-snubs as well as during landing.

The parties' claims that are designated as corresponding to the count are Nedelk patent claims 1-11 and Stimson et al. (Stimson) application claims 16-19. John Nedelk and all of the Stimson et al. inventors are also involved with a third party (DeVlieg) in another interference on related subject matter: Interference No. 102,756, captioned "DeVlieg v. Beck et al. v. Stimson et al.," wherein the party Beck et al. includes Arnold A. Beck and John Nedelk as well as Edgar J. Ruof, Ralph J. Hurley, and Steven R. Smithberger. The Beck et al. patent involved in the '756 interference is a continuation-in-part of the Nedelk patent involved in this interference; both are assigned to Aircraft Braking Systems Corporation (ABSC).

**A. The issues**

The issues before us are priority and two belated 37 CFR § 1.633(a)<sup>3</sup> motions for judgment filed by Nedelk, including an "on-sale motion" alleging an on-sale bar based on

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<sup>3</sup> All references to the interference rules in this decision are to the rules as amended effective April 21, 1995. Patent Appeal and Interference Practice -- Notice of Final Rule (hereinafter 1995 Final Rule Notice), 60 Fed. Reg. 14,488 (March 17, 1995); 1173 Off. Gaz. Pat. & Trademark Office 36 (April 11, 1995).

activities by Stimson at an Atlanta show and an "XB-70 motion" alleging prior use of the braking system by a non-party, North American Rockwell Corporation, on the XB-70 aircraft. In addition, Nedelk has moved without opposition to strike Stimson's "reply brief" (i.e., surreply brief) for final hearing, which motion is hereby granted.<sup>4</sup> Finally, Stimson has moved to suppress evidence relied on by Nedelk in support of his priority case and his belated § 1.633(a) motions. We will begin with priority.

**B. Priority**

Nedelk does not dispute that Stimson was properly accorded the benefit of the February 8, 1989, filing date of U.S. Application Serial No. 07/307,633 and the February 16, 1988, filing date of British Application No. 880354 with respect to the count. Stimson's earliest alleged date of invention at final hearing is his February 16, 1988, British benefit date.

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<sup>4</sup> The briefs which are entitled to consideration are Nedelk's main brief (NMB), Stimson's main brief (SMB), and Nedelk's reply brief (NRB). Nedelk's records and exhibits for final hearing are identified by NR and NE, respectively. Stimson filed no record or exhibits for final hearing.

Nedelk does not allege an actual reduction to practice prior to his filing date.<sup>5</sup> Instead, Nedelk alleges conception prior to Stimson's British benefit date coupled with diligence from just before that date up to Nedelk's February 21, 1989, filing date. Because Stimson's effective filing date is prior to the issue date of the Beck patent, Beck's burden of proof on the priority issue is a preponderance of the evidence. 37 CFR § 1.657(b).

**1. Stimson's motion to suppress most of Nedelk's priority evidence**

Stimson seeks to suppress, as lacking relevance under Fed. R. Evid. 401 and 402, most of the affidavit evidence and exhibits offered by Nedelk to prove conception and diligence; Stimson also requests that the references to this evidence in Nedelk's opening brief be given no consideration.<sup>6</sup> For the following reasons, the motion is denied in all respects.

(a) Nedelk affidavit, NR 2-3, ¶¶ 8-11, and NE 1-5.

Paragraph 8 is alleged to be irrelevant because it "offers a

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<sup>5</sup> Consequently, Stimson has withdrawn (at SMB 31) his contention that Nedelk suppressed or concealed the invention, as argued in Stimson's § 1.632 notice of intent to argue abandonment, suppression, or concealment (paper No. 75).

<sup>6</sup> Paper No. 88, at 10-15.

self-serving excuse for the absence of [an] actual reduction to practice."<sup>7</sup> This argument fails because excuses for inactivity are relevant to diligence. See Griffith v. Kanamaru, 816 F.2d 624, 626, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987) (diligence can be shown by evidence of activity aimed at reducing the invention to practice, either actually or constructively, and/or by legally adequate excuses for inactivity). Paragraphs 9-11 are alleged to be irrelevant because they "relate to the economics of the invention."<sup>8</sup> We are of the view that these paragraphs are relevant to the state of the art at the time the alleged conception and diligence occurred. Paragraph 11, which discusses a response to a request for a proposal purportedly containing the invention, is alleged to be irrelevant because "efforts to commercially exploit an invention are not the equivalent of diligence. MPEP 2138.06."<sup>9</sup> These efforts are relevant if, as Nedelk contends, they were part of an effort to achieve an actual reduction to practice. For the foregoing reasons, none of paragraphs 8-11 will be suppressed.

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<sup>7</sup> Id. at 11.

<sup>8</sup> Id.

<sup>9</sup> Id.

(b) Beck affidavit, NR 6-12, ¶¶ 7 and 9-25, and NE 10-34. Paragraph 7 is alleged to be irrelevant because it "is no more than Becks' [sic] thoughts after hearing Nedelk's alleged concept."<sup>10</sup> In our view, Beck's understanding of Nedelk's concept is relevant to the question of whether Beck can corroborate Nedelk's alleged conception. The objections raised in paragraphs 9-25 are the same as those raised against Nedelk's affidavit and are unconvincing for the reasons given above.

(c) Gillespie affidavit, NR 14-17, all paragraphs, and NE 35-45. Stimson objects to this affidavit as concerning only Gillespie's alleged independent conception and thus being irrelevant to Nedelk's priority case.<sup>11</sup> In our view, the affidavit is relevant because Gillespie is being relied on to prove he was told that Nedelk was the prior inventor of the subject matter in issue.

(d) Zarembka affidavit, NR 21-23, all paragraphs, and NE 53-276. Stimson argues that this affidavit is irrelevant because it is "no more than Mr. Zarembka's views on brake wear and brake systems on the Fokker 100[, ] which arose

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<sup>10</sup> Id. at 11.

<sup>11</sup> Id.

after all of the critical dates in this interference" (Motion at 12). Actually, this argument is applicable to only paragraph 11, the sole paragraph which discusses installation of the invention on the Fokker 100. While Stimson concedes this installation occurred after the critical period for showing diligence (Opposition at 11),<sup>12</sup> we will not suppress this testimony, as it may shed light on whether the activities during critical period were directed toward an actual reduction to practice. The other paragraphs, which concern Zarembka's experience and tests of carbon braking materials conducted prior to February 21, 1989, are relevant to Nedelk's priority case and will not be suppressed.

(e) Moseley affidavit, NR 19-20, ¶¶ 5-8, and NE 46-52. Moseley's testimony about the July 1988 Airbus proposal (¶ 5) and his subsequent thermal analysis of Nedelk's brake control system for use in the Fokker 100 (¶ 6), though occurring after the critical period for diligence, may shed light on activities during that period and therefore will not be suppressed. The same is true of Moseley's discussion (¶¶ 7

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<sup>12</sup> The critical period runs from just before Stimson's February 16, 1988, benefit date up to Nedelk's February 21, 1989, filing date.

and 8) of the fact that Nedelk's braking system was subsequently installed on that aircraft.

(f) Crampton affidavit, NR 30-33, all paragraphs, and NE 363-77. Stimson's objections to this evidence are unpersuasive for reasons already discussed.

(g) Webb affidavit, NR 27-29, all paragraphs, and NE 308-62. See (f), above.

(h) Nemcheck affidavit, NR 24-26, all paragraphs, and NE 277-91. See (f), above.

## **2. Nedelk's case for conception**

As explained in Kridl v. McCormick, 105 F.3d 1446, 1449-50, 41 USPQ2d 1686, 1689 (Fed. Cir. 1997):

Conception is the formation "in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is therefore to be applied in practice." Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985) (quoting Gunter v. Stream, 573 F.2d 77, 80, 197 USPQ 482, 484 (CCPA 1978)) (emphasis omitted). Conception must include every feature or limitation of the claimed invention. Davis v. Reddy, 620 F.2d 885, 889, 205 USPQ 1065, 1069 (CCPA 1980).

"Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his 'complete thought expressed in such clear terms as to enable those skilled in the art' to make the invention." Coleman, 754 F.2d at 359,

224 USPQ at 862 (quoting Fields v. Knowles, [37 C.C.P.A. 1211], 183 F.2d 593, 601, 86 USPQ 373, 379 (CCPA 1950)). However, "there is no final single formula that must be followed in proving corroboration." Berry v. Webb, [56 C.C.P.A. 1272], 412 F.2d 261, 266, 162 USPQ 170, 174 (CCPA 1969). Rather, the sufficiency of corroborative evidence is determined by the "rule of reason." Price [v. Symsek], 988 F.2d [1187,] at 1195, 26 USPQ2d [1031,] at 1037 [(Fed. Cir. 1993)]; Berry, 412 F.2d at 266, 162 USPQ at 173. Accordingly, a tribunal must make a reasonable analysis of all of the pertinent evidence to determine whether the inventor's testimony is credible. Price, 988 F.2d at 1195, 26 USPQ at 1037. The tribunal must also bear in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor's testimony. See Berry, 412 F.2d at 266, 162 USPQ at 173 ("The purpose of the rule requiring corroboration is to prevent fraud."); Reese v. Hurst, 661 F.2d 1222, 1125, 211 USPQ 936, 940 (CCPA 1981) ("[E]vidence of corroboration must not depend solely on the inventor himself.").

Stimson argues that Nedelk's case for conception fails because it was not supported by any documentary evidence:

Not a single piece of paper has been introduced to establish conception of the invention prior to February 16, 1988, Senior Party's filing date.

Not a single piece of paper has been introduced to establish conception of the invention by Nedelk prior to August 17, 1988[, ] the date Nedelk submitted an information disclosure statement to the corporate Patent Screening Committee.

While conception of the invention by oral testimony of the inventor unsupported by contemporaneous documents is permitted (Sabo v. Neu and Wilhelm, 148 U.S.P.Q. 378 (Bd. Pat. Interf. 1964)), the absence of documentation as to Nedelk is contrasted to the presence of documentation as to Gillespie, an[] employee with the same company for the same invention at the same time. [SMB 10.]

This argument is unpersuasive because documentary corroboration, though preferred, is not required. See Reese v. Hurst, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981) (independent corroboration may consist of testimony of a witness, other than the inventor, or it may consist of surrounding facts and circumstances independent of information received from the inventor).

Turning now to the evidence, Boeing invited representatives of Goodyear Aerospace Corporation (GAC), one of the two predecessor corporations to Aircraft Braking Systems Corporation (ABSC),<sup>13</sup> to Seattle to discuss a problem it was experiencing with the Dunlop carbon brakes that were in use on the Boeing 757. As explained in John Nedelk's April

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<sup>13</sup> In 1987, GAC was purchased by Loral Corporation and became one of its four divisions (Milliken, NR 187:21 to 188:16). Beginning in April 1988, these four divisions were converted into four separate companies, including ABSC (Milliken, NR 188:21-22).

29, 1995, memorandum, "Trip Report, Boeing Meetings April 24 and 25, 1985" (NE 180-85), the problem was

[i]nconsistent and unpredictable average torque output at taxi/snub/park conditions. Variations of 9 to 1 are observed. This problem produces severe consequences such as passengers and crew being knocked off their feet. This problem has not yet been solved, and is the reason for Boeing's request for industry-wide assistance. [NE 181.]

During the course of the visit, Boeing invited GAC to "[c]reate and provide GAC taxi/snub/park data which will become part of an industry-wide data bank at Boeing. This data bank will be used to help create the Boeing control system." [NE 181.]

John Nedelk testified that during the Boeing trip he (a) conceived the idea of using only one half of the brakes during taxiing operations, (b) realized at that time that the wear/energy characteristics of carbon brakes were such that controlled brake applications of this nature would likely result in improved carbon utilization in the brakes, and (c) explained the concept to Arnold Beck, who accompanied him on the trip (NR 2, ¶ 6). However, Nedelk's brake control concept is not mentioned in Nedelk's April 29, 1985, memorandum about the Boeing trip. Instead, to corroborate

conception Nedelk relies principally on testimony by Beck.<sup>14</sup> Beck confirms that during the afore-mentioned trip to Boeing in Seattle, Nedelk disclosed to him "his concept for selective braking during taxiing to reduce brake wear" (NR 6, ¶ 6), which involved "selective activation of a certain number of brakes on an aircraft while leaving the other brakes idle during taxiing operations" (NR 6, ¶ 7). According to Beck, Nedelk explained "that the wear/energy characteristics of carbon were such that the wear on the carbon disc brakes was significant, and that carbon wear was, to some degree, independent of the amount of energy being dissipated during the braking operation" (NR 6, ¶ 7).

Although, as Stimson correctly notes, neither Nedelk nor Beck testified that the concept included using all of the brakes during landing, as required by the count, that is clearly implied by the requirement that only some of the brakes be used during taxi maneuvers.<sup>15</sup> As a result, we hold that Beck's testimony is sufficient to corroborate Nedelk's

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<sup>14</sup> Stimson does not dispute Nedelk's right to rely on Beck's testimony as corroboration in this interference.

<sup>15</sup> This argument was not made in the '756 interference, wherein the count makes no reference to landing.

conception of the subject matter of the count on or about April 23, 1985.

Beck also contends, incorrectly, that conception by Nedelk is further corroborated by Gillespie's testimony. Gillespie explains that in the fall of 1985, he was faced with the problem that the carbon brakes on the McDonnell Douglas MD-80 were "grabby" at low speeds (NR 15, ¶ 5). He proposed selective braking as a solution in an October 9, 1985, letter (NE 36) to J.P. Nelson, Director, Divisional Engineering, Aircraft Wheel and Brake Division:

On [c]ommercial aircraft having eight or more main wheels/brakes, the attractiveness of carbon might be enhanced if one half or more of the brakes could be idled during low energy stops. The enhancement would stem from two characteristics of carbon brakes:

- 1) Carbon supposedly experiences a decrease or a plateau in wear as energy increases at the low end of the spectrum.
- 2) Carbon brakes are often very sensitive at low speeds because operating pressures are extremely low.

By idling one half the brakes for taxi stops and taxi snubs, we might experience no more wear on the active brakes than if all brakes were active. (Alternating the active and passive brakes for each braking occurrence would benefit thermal considerations). With taxi stops and snubs

constituting upwards of 90% of brake applications, the potential for increased brake life is very substantial.

The sensitivity at low speeds would likewise be ameliorated as brake pressure would be doubled.

On October 10, 1985, Gillespie filled out an invention disclosure form (NE 38) accompanied by a copy of the foregoing letter (NE 40) and a copy of a sketch showing carbon wear versus kinetic energy (NE 39)(Gillespie, NR 15, ¶ 7; Germain, NR 38, ¶ 6). The invention disclosure form gives a conception date of September 19, 1985, nearly five months after Nedelk's conception date. Within a week or so of receiving a copy of Gillespie's letter, Tom Webb, who worked in Advanced Technology, Wheel & Brake Engineering, made notes (NE 309) describing Gillespie's concept as a good one and suggesting, inter alia, a "[n]eed to select a potential aircraft and preform [sic] more tests." On October 21, Gillespie was asked by ABSC patent agent Lee Germain to fill out a Rule 56 questionnaire (NE 41-42)(Gillespie, NR 16). On October 31, 1985, Webb sent a letter (NE 43-45) to his manager, T.E. Nemcheck, recommending further study of Gillespie's concept

and identifying a number of matters requiring investigation.<sup>16</sup> Gillespie testified that "[s]ometime later, I was told that the Patent Department would prepare a patent application once the invention had actually been reduced to practice and substantiated" (NR 17, ¶ 11). Gillespie further explains that he

subsequently learned that a patent application on a substantially identical invention conceived by John Nedelk was filed for Taxi Brake Select, as the concept is now referred to in our company. I informed Arnold Beck that I believed I conceived of this invention. However, I was advised that Mr. Nedelk had conceived of the invention on a date prior to the conception date noted in my Invention Disclosure, i.e., September 19, 1985. Accordingly, the Patent Department determined that John Nedelk would be the named inventor of this patent application. [NR 17, ¶ 12.]

On cross-examination, Gillespie explained that he does not recall who told him that Nedelk was the first inventor or when he was so informed (NR 426:23 to 429:14). His testimony therefore leaves open the possibility that this information was obtained directly or indirectly from Nedelk rather than from Beck and thus lacks the requisite independence from the

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<sup>16</sup> Webb, when asked if any of his recommended further investigations were carried out, responded that he could not recall. Webb, NR 309:16-20.

inventor.<sup>17</sup> As a result, the only corroboration for Nedelk's conception prior to Stimson's benefit date is Beck's testimony.

### 3. Diligence

Inasmuch as Nedelk has proved a corroborated conception prior to Stimson's February 16, 1988, benefit date, we turn to the question of whether Nedelk has also shown diligence for the critical period running from just prior to Stimson's benefit date up to Nedelk's February 21, 1989, filing date, as required for Nedelk to prevail on the issue of priority. 35 U.S.C. § 102(g). Diligence can be shown by evidence of activity aimed at reducing the invention to practice, either actually or constructively, and/or by legally adequate excuses for inactivity. Griffith v. Kanamaru, 816 F.2d 624, 626, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987).

Nedelk does not allege any acts toward a constructive or actual reduction to practice during the first five months of the critical period. Instead, Nedelk argues that the failure to perform any such acts during this interval should be excused on the ground that the control apparatus

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<sup>17</sup> Although Nemcheck testified that he was aware of the Taxi Brake Select concept prior to the October 9, 1985, date of Gillespie's letter to Nelson (NR 238:25 to 239:10), he is not sure who had the idea first (NR 257:7-19).

required to carry out the invention was simple and required no research and development, with the result that all that was required to reduce the invention to practice was to install the control apparatus on a suitable new aircraft, which did not become available until the summer of 1988, when British Aerospace issued a request for proposals for a braking system to be used in the Airbus A330/340. The fundamental problem we have with this argument is that the evidence fails to demonstrate that prior to February 16, 1988, a decision had been made to reduce Nedelk's invention to practice. A party cannot be excused for failing to act unless the party had an intent to act but for the circumstances offered as an excuse. See Smith v. Crivello, 215 USPQ 446, 453 (Bd. Pat. Int. 1982) ("an essential requirement of every acceptable excuse for lack of diligence is a reasonable showing that except for the excuse the inventor would have been working on the invention during the period he seeks excused."). Compare Keizer v. Bradley, 270 F.2d 396, 399, 123 USPQ 215, 217 (CCPA 1959) (holding that the evidence shows a continuing intent to reduce automatic chroma control circuit to practice as soon as television receiver reached suitable stage of development). The testimony to the effect that the Patent Screening Committee decided in December 1986 to delay filing a patent

application on Gillespie's invention until the invention could be reduced to practice through testing on an aircraft (Gillespie, NR 17, ¶ 11; Webb, NR 28, ¶ 9, NR 291:15-25, NR 292:16-23, and NR 296:3-9) is irrelevant because decisions regarding Gillespie's invention do not inure to Nedelk's benefit. See Cooper v. Goldfarb, 154 F.3d 1321, 1332, 47 USPQ2d 1896, 1905 (Fed. Cir. 1998) ("In order to establish inurement, an inventor must show, among other things, that the other person was working either explicitly or implicitly at the inventor's request. See Chisum [on Patents (1995)], supra, § 10.06[3]."). See also Hartley v. Joyce, 96 F.2d 296, 300, 37 USPQ 525, 529 (CCPA 1938) ("there seems to be no sound reason why the activity of one inventor should inure to the benefit of another merely because they are employed by the same company.").

Beck testified that he and Ruof (who did not testify) decided shortly after Beck learned of the invention from Nedelk it would be a simple matter to modify an antiskid system to include Nedelk's invention (NR 459:16-19), that they made a sketch which Beck has no record of anymore (NR 459:22-23; NR 462:16-24), and that "I think our idea at that time was that, you know, when an application comes along we'll build it, there isn't really any R & D to do." (NR 460:6-9.)

Likewise, when asked whether at that time they "basically were just waiting for an application", he replied, "That's right."

(NR 462:25 to 463:1.) This testimony is insufficient to establish the required intent to reduce to practice because it does not establish a decision by ABSC at that time to reduce Nedelk's invention to practice as soon as possible. On the contrary, when asked whether there was a conscious decision by someone in 1985 to table the invention until a suitable aircraft came along to bid on, Beck replied, "A conscious decision? I guess I'm -- I don't know if it was or not."  
(NR 459:8-12.)

While Beck and Crampton gave various reasons why it was determined to be necessary to delay efforts to reduce the invention to practice until a suitable new aircraft became available, they did not give specific dates for these determinations, let alone dates prior to Stimson's February 16, 1988, benefit date. Specifically, Beck testified as follows (NR 7-8, ¶¶ 11-13):

11. While Nedelk's concept was theoretically attractive, and while available data correlating carbon wear with energy dissipation suggested that improved carbon utilization could be obtained by following Nedelk's concept, we know from long experience in dealing with aircraft that concepts of this nature may only be substantiated by actual in-field use on an

aircraft. Accordingly, we determined that the concept would need to be substantiated over a period of time in which the flight and landing patterns of aircraft employing the invention could be monitored, the brake wear could be measured, and overall brakes [sic] perform[ance] on the aircraft could be assessed.

12. We determined that we could introduce the concept on a new program for commercial aircraft in which the airframe manufacturer accepted carbon brakes for the wheel and brake system. We also knew that the aircraft would require at least four brake wheels so that a pair of wheels (one on each side of the aircraft) could be actuated during the selective braking process. Alternatively, we considered implementing the concept on an existing aircraft that had four braked wheels employing carbon brakes. However, the retrofitting of one brake assembly for another on an aircraft is something not easily done in the aircraft industry and this situation would have been further complicated by the fact that, since carbon brakes for aircraft were relatively new at this time, we would necessarily be retrofitting carbon brakes onto an aircraft which had previously employed steel brakes. The likelihood of convincing any aircraft owner to allow such a retrofit was extremely minimal.

13. In further considering how to verify Nedelk's concept, we determined that the best type of aircraft for testing the concept would be one having eight braked wheels, comprising two 4-wheel trucks. We were concerned that aircraft employing 2-wheel trucks (a four braked wheel aircraft) would give rise to torsion on the landing gear strut, since the selective braking approach would necessarily activate the brakes on a wheel on one side of the strut, while leaving the wheel on the other side of the strut free-wheeling. We were most interested in proving that the selective braking concept would result in improved carbon utilization, and did not want our test to be aggravated by any ancillary problem such as strut torsion.

Crampton's testimony also fails to give dates (NR 31):

5. In view of the fact that Taxi Brake Select® was a totally new concept to the industry and no testing had actually been performed on an aircraft yet, we felt that in order to give this concept every possible chance to succeed, the aircraft should be equipped with four brake/wheel landing gears so as not to create any torsion problem or other significant problem when only half of the brakes are applied. In addition, because the control system would have to deactivate the carbon brakes and then reactivate them, we had to know the specific braking characteristics of those carbon brakes and how they could be used with our control system. Accordingly, the safest way to do that was to seek an aircraft which had our control system and our carbon brakes.

Moreover, when Crampton was asked to give dates for the discussions described in the foregoing testimony, he was unable to do so:

Q. Could you put paragraph five in a time frame, you know, when these types of conversations took place, or these kinds of decisions were made?

A. Well, the concept came out in 1985, so it would have been after '85.

Q. Okay.

A. Specific dates, I can't give you specific dates. [NR 394:6-13.]

There is also no documentary evidence dated prior to Stimson's February 16, 1988, benefit date which implies that a

decision had been made to reduce Nedelk's invention to practice. As already noted, the documents relating to Gillespie's invention do not inure to Nedelk's benefit, since they were not generated on his behalf. Cooper, 154 F.3d at 1332, 47 USPQ2d at 1905. Nor does the testimony establish that any of the wear data obtained using ABSC's shaft dynamometer prior to February 16, 1988. See Zarembka's testimony at NR 22-23, ¶¶ 6-11 regarding the wear data in Zarembka Exhibits A-F (NE 53-276) and see Webb's testimony at NR 28, ¶ 7 regarding the wear data in Webb Exhibit C (NE 311-59). Consequently, the earliest corroborated date for a decision to submit a bid employing Nedelk's invention to an aircraft manufacturer is July 1, 1988, about four and one-half months after Stimson's benefit date, when Moseley attended a design review meeting to discuss a braking system proposal for the Airbus A330 (Moseley, NR 19, ¶ 3; NR 129-32). During that meeting, Nedelk described the Taxi Brake Select concept and asked Moseley and Beck to discuss the control system required for its operation (Moseley, NR 19, ¶ 4). The last two lines of Moseley's notes (NE 46) from the meeting (Moseley, NR 19, ¶ 4) read, "4. Define brake cycling control system to reduce taxi wear rate. Action DD Moseley & AA Beck." Shortly thereafter, on July 15, 1988, Moseley made a block diagram (NE

48) of a brake control circuit for controlling brake selection as a function of pedal position and aircraft speed (Moseley, NR 19, ¶ 5).

Because for the foregoing reasons Nedelk has failed to prove that a decision was made prior to Stimson's February 16, 1988, benefit date, to reduce Nedelk's invention to practice, Nedelk's excuses for inactivity are unpersuasive and Nedelk cannot be credited with diligence. Accordingly, judgment is being entered infra against Nedelk's claims on that ground.

Furthermore, assuming for the sake of argument that the evidence demonstrates such a decision had been made prior to Stimson's benefit date, judgment would be entered against Nedelk for failing to adequately account for the five-month period between Stimson's benefit date and July 1988, when Nedelk's braking concept was considered for inclusion in ABSC's proposal to Airbus (Beck, NR 9, ¶¶ 15-16; Moseley, NR

18-19, ¶¶ 3-5). That no efforts to reduce Nedelk's invention to practice were made prior to the Airbus proposal during this time is clear from Beck's testimony (NR 474:14-17):

Q. Okay. So to be clear, after '85, in the work you did with Mr. Ruof, until this [Airbus] proposal came in, this was on the back burner; is that correct?

A. Yes.

However, Nemcheck conceded that as early as 1985 ABSC could have used one of its dynamometers to verify that Nedelk's Taxi Brake Select concept reduced carbon wear (NR 251:11 to 251:11):

Q. . . . What's a dynamometer?

A. . . . In our case it's a device for simulating the speed and energy of an aircraft for brake testing. We also have roll test dynamometers for wheels, which are primarily to simulate the loads on aircraft wheels under rolling conditions.

BY MR. MURRAY:

Q. Under braking conditions also?

A. And -- yes.

Q. Did you have a dynamometer in 1985?

A. Yes, uh-huh.

Q. Yes?

A. Sure, yes, we did.

Q. Would that have been a piece of equipment that you could have used to validate the -- the taxi braking concept?

A. Attempts to validate that concept would have been done on a dynamometer.

Q. Do you know whether any were?

A. Wear testing that we've been talking about.

Q. Okay. Was the Taxi Brake Select system ever tested on that dynamometer?

A. The system, itself, would not have been tested on a dynamometer.

Q. Okay. But what parts of it would have been?

A. We would have -- we would have tested the brake for wear characteristics in an effort to verify the effect of Taxi Brake Select on brake wear.

Q. Do you know if those tests were ever done?

A. Yes. We -- we did do tests in which the wear data was reviewed -- reviewed relative to the Taxi Brake Select concept.

Q. And do you know when those tests were done?

A. I can't give you an exact date.

Q. I know it's a long time ago. But the -- is there documentation that's maintained on this type of testing that would reflect when that testing was done?

A. Yes.

Q. Is it --

A. But --

Q. -- basically the same files we talked about previously?

A. Yes, it would be.

The earliest date mentioned in those files, i.e., Exhibits A (NE 277-91) and B (NE 292-307) to Nemcheck's affidavit, for obtaining wear data is the November 30, 1988, date given at the bottom of NE 287, which Nemcheck testified gives some indication of when the test data was obtained (NR 246:17-21). In our view, Nedelk's (ABSC's) failure to conduct such testing during the first five months of the critical period shows a lack of diligence, regardless of whether a suitable aircraft was available for in-flight testing, because the failure to conduct a test that can be of practical value is inconsistent with the exercise of reasonable diligence. Naber v. Cricchi, 567 F.2d 382, 385, 196 USPQ 294, 297 (CCPA 1977); Hudson v. Giuffrida,

328 F.2d 918, 923, 140 USPQ 569, 573 (CCPA 1964). Thus, this unexcused five months of inactivity at the beginning of the critical period is another reason for entering judgment against Nedelk. See Bigham v. Godtfredsen, 222 USPQ 632, 637-

38 (Bd. Pat. Int. 1984) (unexplained inactivity for one and one-half months defeats claim of diligence); Moller v. Harding, 214 USPQ 724, 729 (Bd. Pat. Int. 1982) (unexplained inactivity for one and one-half months defeats claim of diligence); Morway v. Bondi, 203 F.2d 742, 749, 97 USPQ 318, 323 (CCPA 1953) (party not diligent where, following June 7 activity, which was just prior to opponent's June 14 entry into the field, party did not perform other acts until August 1); Ireland v. Smith, 97 F.2d 95, 99-100, 37 USPQ 807, 811 (CCPA 1938) (held not diligent for failing to account for period of three and one-half weeks). Consequently, it is not necessary to consider whether Nedelk was diligent during the remainder of the critical period, i.e., from July 1988 up to Nedelk's February 21, 1989, filing date.

**C. Nedelk's belated on-sale and XB-70 motions**

As already noted, the APJ dismissed Nedelk's on-sale and XB-70 motions for failing to show good cause under § 1.645(b) for the belatedness.<sup>18</sup>

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<sup>18</sup> A preliminary motion is belated in the sense of § 1.645(b) if it is filed after the close of the preliminary motion period. General Instrument Corp. v. Scientific-Atlanta Inc., 995 F.2d 209, 213, 27 USPQ2d 1145, 1147-48 (Fed. Cir. 1993).

### 1. Standard of review

Stimson correctly notes<sup>19</sup> and Nedelk does not dispute that the standard of review for the APJ's dismissal of Nedelk's belated § 1.633(a) motions is the abuse of discretion standard. See Consideration of Interlocutory Rulings at Final Hearing in Interference Proceedings, 64 Fed. Reg. 12,900, 12,901 (March 16, 1999), which amended § 1.655(a) to make it clear that a Board panel at final hearing will resolve the merits of an interference (e.g., patentability or an attempt to obtain the benefit of an earlier application) without giving deference to any interlocutory order<sup>20</sup> and will apply the abuse of discretion standard to any interlocutory procedural orders, such as the dismissal of a motion for failing to comply with the rules. The amended rule further provides that the party requesting modification of an interlocutory order has the burden of showing that the order should be modified. An abuse of discretion occurs if the decision (1) is clearly unreasonable, arbitrary or fanciful,

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<sup>19</sup> SMB 21-22.

<sup>20</sup> 37 CFR § 1.601(q) provides: "A final decision is a decision awarding judgment as to all counts. An interlocutory order is any other action taken by an administrative patent judge or the Board in an interference, including the notice declaring an interference."

(2) is based on an erroneous conclusion of law, (3) rests on clearly erroneous fact findings, or (4) involves a record that contains no evidence which provides rational support for the decision. Abrutyn v. Giovanniello, 15 F.3d 1048, 1050-51, 29 USPQ2d 1615, 1617 (Fed. Cir. 1994). See also 1995 Final Rule Notice, 60 Fed. Reg. at 14514-15; 1173 Off. Gaz. Pat. & Trademark Office at 58.

**2. Background facts leading up to the filing of the two belated motions**

On August 31, 1992, the last day for filing preliminary motions in the '756 interference, DeVlieg (Boeing), who was involved in only that interference, filed a § 1.633(a) motion<sup>21</sup> for judgment against all of the parties' involved claims on the ground that "the concept of applying only a portion of the brakes on an aircraft when the speed of the aircraft is below a predetermined threshold speed was invented and reduced to practice in connection with the XB-70 program" (Motion at 2). The motion was accompanied by an affidavit by DeVlieg<sup>22</sup> stating that on July 20, 1992, he and Ms. Harasek, counsel of record in the involved DeVlieg

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<sup>21</sup> Paper No. 19 in the '756 interference file.

<sup>22</sup> In paper No. 62 of the '755 interference file, at 6 n.6, the APJ indicated that the motion was incorrect to state (at 2) that it is accompanied by an affidavit by Ms. Harasek.

application and in the '756 interference, were advised of this prior use in a telephone conversation with Hal Smith, of Northrup. The motion included (at 2) a request under § 1.639(c) for the APJ to "order that the testimony of Hal Smith, and any other competent witness able to testify to the facts of earlier invention of the subject matter of the count, be taken." The motion also requested that a decision be deferred until final hearing, pending the outcome of such testimony.

Next, on October 23, 1992, which was after the close of the preliminary motion period but before the parties were required to serve their preliminary statements, Stimson filed a § 1.628 motion<sup>23</sup> in each interference for leave to correct his preliminary statement by adding the following paragraphs:

(E) Importation of the invention into the United States at least as early as August 21, 1987 (see the attached file note sub-titled "Notes on Meetings held with Delta Air Lines in Atlanta August 21/87" -- 7 pages by L. Fitzgerald of Dunlop Aviation, including a one-page cover letter from L. Fitzgerald (in the USA);

(F) A three-page report from G. Carrier (one of the inventors) under date of "8-10-87" (October 8, 1987) reporting the results of some dynamometer tests L. Fitzgerald and R. Errett in Seattle).

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<sup>23</sup> Paper No. 17 in this interference.

[Underlining omitted.] [Page 2 of corrected preliminary statement, paper No. 18.]

The motion, which was filed and served, was accompanied by a notice<sup>24</sup> that the corrected preliminary statement, including a supporting declaration by Trevor C. Wells and exhibits thereto were being filed (in a sealed envelope) and would be served upon order of the APJ.

On December 6, 1993, the APJ mailed his "Decisions on Motions" in both interferences.<sup>25</sup> In both interferences, the APJ granted Stimson's motion to file a corrected preliminary statement, set due dates for the parties' testimony, records, and briefs, and ordered the parties to serve their preliminary statements, including Stimson's corrected preliminary statement, within two weeks of the mailing date of the Decisions on Motions. Stimson does not dispute Nedelk's claim (NMB 12) of receiving Stimson's corrected preliminary statement on or about December 20, 1993. In addition, in the '756 interference the APJ deferred a decision on the XB-70 motion to final hearing, and authorized DeVlieg (Boeing) to take testimony on the XB-70 issue during his testimony-in-

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<sup>24</sup> Paper No. 18.

<sup>25</sup> Paper No. 21.

chief period, which was set to end on March 1, 1994. As a result of a number of granted extensions of time to accommodate the appointment of new counsel for Stimson and to allow for settlement negotiations, the closing date for DeVlieg's deposition testimony period for priority and XB-70 testimony was extended to July 7, 1994, in the '756 interference and the due dates for Nedelk and Stimson were made to coincide in both interferences.<sup>26</sup>

The July 7, 1994, closing date for DeVlieg's testimony-in-chief passed without DeVlieg taking any priority testimony or XB-70 testimony. Two weeks later, on the July 21, 1994, closing date for Nedelk and Beck et al. to file their priority affidavit testimony in both interferences, they filed their priority testimony and the two motions which are before us at this final hearing: (a) the on-sale motion<sup>27</sup> alleging that Dunlop's activities at the Atlanta meeting described in the Wells affidavit that accompanied Stimson's corrected preliminary statement amounted to an offer to sell the invention to Delta; and (b) the XB-70 motion,<sup>28</sup> which

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<sup>26</sup> Paper Nos. 31 and 32.

<sup>27</sup> Paper No. 39.

<sup>28</sup> Paper No. 40.

repeats the XB-70 unpatentability argument that was initially raised in DeVlieg's timely § 1.633(a) motion filed on August 31, 1992.<sup>29</sup>

Both of Nedelk's belated motions included requests under § 1.639(c) to take testimony of persons having knowledge of the facts and explained why Nedelk believed he had "good cause" under § 1.645(b) for the belatedness of the motions. Because Nedelk offers different excuses for the belatedness of the two motions, we will discuss those excuses separately.

**3. The excuses for the belatedness of the XB-70 motion**

As noted earlier, the XB-70 patentability issues raised in Nedelk's belated XB-70 motion, filed July 21, 1994, was initially raised twenty-two and one-half months earlier in a timely motion filed by DeVlieg in the '756 interference on August 31, 1992, based on DeVlieg's affidavit describing a conversation with Smith (NE 1068). According to DeVlieg,

Mr. Smith said during that conversation that shutting off half the brakes for taxiing had been tried in

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<sup>29</sup> On the same date Nedelk's belated motions were filed, DeVlieg, too, filed a belated § 1.633(a) motion in the '756 interference raising the on-sale issue against Stimson, which motion the APJ dismissed for the same reasons as the belated Nedelk motion raising this issue ('756 paper No. 85, at 3). The dismissal of DeVlieg's belated motion is not before us, as DeVlieg failed to file a brief for final hearing.

connection with the B-70 in the early 1960's. He said such a system had actually been installed and tested on an aircraft.

The [p]urpose of the system was to reduce brake grabbiness during taxi. However, with half the brakes released, the remaining brakes would experience some tire skidding during taxi stops. This resulted in pilots losing feel for the brakes. The system was not used in the final configuration of the aircraft.

Although, as already noted, consideration of this motion was deferred to final hearing so that DeVlieg could take the testimony of Smith and others during his deposition testimony period regarding the XB-70 braking system, DeVlieg failed to take any such testimony. This resulted in the dismissal of his timely XB-70 motion.<sup>30</sup>

Nedelk's belated motion as filed is based on evidence that did not accompany DeVlieg's motion, namely, a July 21, 1994, affidavit by ABSC's General Counsel, Bruce DeYoung (NR 500-01), and a number of documentary exhibits (NE 679-1067) obtained through the Freedom of Information Act

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<sup>30</sup> Paper No. 85, at 7, in the '756 interference.

(FOIA).<sup>31</sup> In response to Stimson's opposition,<sup>32</sup> which argues (at 3-4) that the motion and evidence fail to prove dates for the acts alleged therein, Nedelk filed a reply<sup>33</sup> accompanied by new evidence including the deposition testimony by DeYoung (NR 502-26) concerning his first affidavit and some affidavits that are not of record: (a) a December 21, 1994, affidavit by DeYoung; (b) a December 4, 1994, affidavit by Ray Weber; and (c) a December 21, 1994, affidavit by Arnold Beck. The APJ held that the reply evidence "is not entitled to consideration, as it is not directed to new points of argument raised in the opposition, as required by § 1.638(b). Instead, it is directed to deficiencies in the motion that were identified in the opposition."<sup>34</sup> We agree. It is well settled that all of the available evidence on which a party intends to

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<sup>31</sup> Nedelk's belated XB-70 motion includes a § 1.639(c) request for permission to take the testimony of persons having knowledge of the XB-70 braking system. Although the APJ initially denied the request on the ground that Nedelk had not demonstrated that the testimony was unavailable at the time the belated motion was filed (paper No. 62, at 7-8), he reversed himself on reconsideration, holding that because the belated § 1.633(a) motion was filed at the beginning of Nedelk's testimony-in-chief period, it was reasonable for Nedelk to assume that the requested testimony need not accompany the motion (paper No. 68, at 7).

<sup>32</sup> Paper No. 49.

<sup>33</sup> Paper No. 54.

<sup>34</sup> Paper No. 62, at 10.

rely to show prima facie entitlement to the relief sought in a motion must accompany the motion. See 37 CFR § 1.639(a):

(a) Except as provided in paragraphs (c) through (g) of this section, proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

See also Irikura v. Petersen, 18 USPQ2d 1362, 1368 (Bd. Pat. App. & Int. 1990) ("A good faith effort must be made to submit evidence to support a preliminary motion or opposition when the evidence is available"); Bayles v. Elbe, 16 USPQ2d 1389, 1392 (Bd. Pat. App. & Int. 1990) ("The rules provide that all evidence in support of a motion must be filed and served with the motion. See 37 CFR §1.639"); Orikasa v. Oonishi, 10 USPQ2d 1996, 2000 n.12 (Comm'r Pats. 1989):

[W]here the moving party is in possession of the necessary evidence, there is no legitimate reason why it should not be presented with the motion. If the motion is not accompanied by then available proof of a material fact, no further evidence should be received in the interference in connection with the issue raised in the motion. 37 CFR §1.639.

For the foregoing reasons, the APJ did not abuse his discretion by refusing to consider the reply evidence and the arguments based thereon. Because this reply evidence is not entitled to consideration, Stimson's motion to suppress DeYoung's deposition testimony, which is part of the reply evidence, is hereby dismissed as moot with respect to that testimony.

Of the evidence that was submitted with the motion, i.e., DeYoung's July 21, 1994, affidavit and XB-70 test data obtained under the FOIA, Stimson<sup>35</sup> seeks to suppress the XB-70 test data (NR 679-1067) on the ground that it relates to the merits of the XB-70 motion rather than to its dismissal, citing the APJ's statement that

[w]hile the dismissal of a motion is reviewable at final hearing for abuse of discretion pursuant to § 1.655(a), the issues raised in a dismissed motion are not entitled to review at final hearing. Bayles v. Elbe, 16 USPQ2d 1389, 1392 n.9 (Bd. Pat. App. & Int. 1990); Land v. Dreyer, 155 F.2d 383, 69 USPQ 602 (CCPA 1946); Jacobs v. Moriarity, 6 USPQ2d 1799, 1802 (Bd. Pat. App. & Int. 1988). [Paper No. 62, at 3 n.4.]

Nedelk does not take issue with the foregoing instruction, arguing instead that he is entitled, as part of our review of

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<sup>35</sup> Paper No. 88, at 7-8.

the dismissal of the XB-70 motion, to consideration of all of the evidence filed with the motion.<sup>36</sup> Because the motion relies on the acquisition of this test data to excuse the belatedness, we will not suppress the data. Consequently, the question before us is whether the APJ abused his discretion in holding that the belated motion and the evidence filed therewith, i.e., DeYoung's July 21, 1994, affidavit (NE 500-01) and the FOIA documents, is sufficient to establish good cause for the belatedness.

The explanation given in the XB-70 motion under the heading, "V. GOOD CAUSE SHOWING FOR BELATED MOTION UNDER 37 C.F.R. §1.635 PURSUANT TO 37 C.F.R. §1.655(b) [sic, §1.645(b)<sup>37</sup>]," reads in its entirety as follows:

Junior Party Nedelk requests that this motion under 37 C.F.R. §1.633(a), be entered inasmuch as good cause can be shown why this motion was not earlier filed. 37

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<sup>36</sup> Paper No. 91, at 8.

<sup>37</sup> The requirement to file a § 1.635 motion showing good cause for the belatedness of a preliminary motion appears in § 1.645(b) rather than § 1.655(b). The requirement of § 1.655(b) to show "good cause why the issue [argued at final hearing] was not properly raised by a timely motion" refers to issues that were not raised by a timely motion or a belated motion. See 1995 Final Rule Notice, 60 Fed. Reg. at 14513; 1173 Off. Gaz. Pat. Office at 58 ("For purposes of sections other than § 1.645, a belatedly filed paper is considered 'timely filed' if accompanied by a motion under § 1.635 to excuse the belatedness, which is granted.").

C.F.R. §1.655(b)(3). Specifically, all of the facts as presented hereinabove were not known to Junior Party Nedelk until after the decisions on preliminary motions had been made. In fact, the test reports attached hereto as Exhibit B were not available to Junior Party Nedelk until just recently when the documents were acquired under the Freedom of Information Act (FOIA). As soon as the information was obtained, it was reviewed and this Motion was prepared.

Junior Party Nedelk acknowledges that it knew of Mr. Smith's statements to Ms. Harasek and Mr. DeVlieg before the time for making decisions on Preliminary Motions in this interference had lapsed. However, as noted in Mr. DeYoung's Declaration, no one at Aircraft Braking Systems Corporation believed the statements were factually correct. From what Aircraft Braking Systems could ascertain, the operation of the braking control system on the XB-70 aircraft may have related to differing pressures on the brakes, not to the use of only a portion of the brakes at lower speeds.

It was not until Junior Party Nedelk received the test reports under the Freedom of Information Act and had reviewed the documents that it learned that the XB-70 braking system was indeed relevant to the invention involved in this interference. Thus, Junior Party Nedelk now presents this evidence with this motion.

Support for filing this motion belatedly can be found in General Instrument Corp., Inc. v. Scientific-Atlanta Inc., [995 F.2d 209, 213,] 27 USPQ2d 1145[, 1147-48] (Fed. Cir. 1993), wherein it is noted that belated motions for judgment under §1.633(a) can be made and will likely meet the good cause requirement where the supporting

information had not been available earlier in the proceeding. [Paper No. 40, at 5.]

DeYoung's accompanying affidavit reads in pertinent part as follows (NR 501):

2. In the course of fact finding relative to this interference, I have become aware that Elizabeth Harasek, Esq. and Garrett DeVlieg, both employees of Boeing Corporation, engaged in a telephone conference with Hal Smith of Northrup Corporation of Dayton, Ohio, on July 20, 1992, and were advised by Mr. Smith that the concept of applying and/or inhibiting selected portions of the brakes on an aircraft when the aircraft speed was below a predetermined threshold level was practiced at least as early as the mid-1960's in conjunction with the XB-70 program at Edwards Air Force Base in California.
3. After I obtained the information set forth in paragraph 2, above, I questioned the accuracy of Mr. Smith's recollection and, based upon conversations that I then had with other personnel at ABSC, I formed the opinion that the brake modification undertaken on the XB-70 aircraft may have dealt with pressure regulation on the brakes, or may have dealt with selective inhibiting and enabling of the brakes at lower speeds.
4. In an attempt to further explore this matter, we sought documents under the Freedom of Information Act (FOIA) relative to the brake control system on the XB-70 aircraft. While we have obtained some documentation relative to the development of the brake control system on that aircraft, other documentation which is known to exist has still not been released

under the FOIA because the controlling agency no longer exists. The information and documentation that was obtained clearly demonstrates that during flight tests of the XB-70 only a portion of the brakes were used during taxiing (selective inhibiting and enabling of the brakes - - not pressure regulation on the brakes), while all of the brakes were used during normal braking operations. Accordingly, it appears that the broad concept of Count I in this interference was known well prior to August 21, 1987.

The APJ considered the motion and DeYoung's affidavit insufficient for failing to prove, or even allege, the dates of the acts alleged therein.<sup>38</sup> The APJ explained that these dates are necessary because Nedelk is required to show that he promptly and diligently investigated the XB-70 braking system upon being served with DeVlieg's XB-70 motion in order to preserve the right to file a belated motion alleging unpatentability based on that braking system. As support for such a duty, the APJ<sup>39</sup> cites two authorities, the first being Interference Practice: Matters Relating to Belated Preliminary Motions (hereinafter, Notice), 1144 Off. Gaz. Pat. Office 8 (Nov. 3, 1992), which reads in pertinent part as follows:

In some interference proceedings,  
evidence which would provide a basis for a

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<sup>38</sup> Paper No. 68, at 11-12.

<sup>39</sup> Paper No. 62, at 10.

preliminary motion under 37 CFR 1.633 does not come to light until after a decision on preliminary motions has been entered. For example, a party may conclude, after hearing the opponent's testimony, that the opponent's application or patent does not comply with the "best mode" requirement of 35 USC § 112, first paragraph; or a prior art reference may be found which the party could not previously have located. The purpose of this notice is to clarify the policy of the Board of Patent Appeals and Interferences as to what steps the party must take if it wishes to have an issue based on such evidence considered by the Board.

If the time for filing preliminary motions has expired, and then evidence comes to light which in the opinion of a party would provide [a] basis for a preliminary motion under 37 CFR 1.633, that party may not simply raise the matter in its brief at final hearing for the Board's consideration. Rather, it is the policy of the Board that it will not consider the matter unless the party files promptly after the evidence becomes available:

(1) the appropriate preliminary motion under 37 CFR 1.633; and

(2) a motion under 37 CFR 1.635 showing sufficient cause why the preliminary motion was not timely filed, as required by 37 CFR 1.645(b). This motion must include the certificate required by 37 CFR 1.637(b). [Emphasis added.]

The second authority cited by the APJ<sup>40</sup> is Maier v. Hanawa, 26 USPQ2d 1606, 1610 (Comm'r Pats. & Trademarks 1992), which held that a party has a duty to locate, during the preliminary motion period, any relevant prior art it wishes to rely on in support of a motion alleging unpatentability:

[I]t is incumbent on a party to make its best reasonable effort within the time period allotted by the [APJ] to uncover all evidence on which it would rely in making a preliminary motion. If information . . . could have been discovered with reasonable effort within the period set by the [APJ], its later discovery after expiration of the period would not be sufficient cause for delay in the late filing of any preliminary motion relying on that information. [Footnote omitted.]

Nedelk argues<sup>41</sup> that the APJ's reliance on the Notice to show a duty to investigate as early as about August 31, 1992, when DeVlieg's motion was filed and served, is misplaced because the first paragraph of the Notice makes it clear that the Notice concerns prior art discovered after the date of the APJ's decisions on preliminary motions, which in this

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<sup>40</sup> Paper No. 68, at 9-10.

<sup>41</sup> NMB 19.

interference were mailed on December 6, 1993, only seven and one-half months before Nedelk's belated motion was filed. Otherwise, Nedelk contends, the first paragraph is completely immaterial to the Notice. We do not agree. It is clear that the first paragraph describes the facts in the particular interference which led to publication of the Notice. The second paragraph, on the other hand, gives the procedure to be followed whenever relevant prior art that can be the subject of a § 1.633(a) motion is discovered after the close of the preliminary motion period.

Nedelk next argues<sup>42</sup> that neither the Notice nor Maier imposes a duty on Nedelk to promptly investigate DeVlieg's XB-70 allegations. As to the Notice, Nedelk argues that "[a]ll that is required by this notice is that the moving party file its motions promptly after the evidence becomes available" (NMB 20). This argument ignores the reference in the first paragraph of the Notice to "prior art reference . . . which the party could not previously have located," which clearly implies such a duty. Nedelk next argues that Maier is inapposite because it concerned prior art that could have been located prior to the close of the preliminary motion period,

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<sup>42</sup> NMB 20.

whereas Nedelk first learned of DeVlieg's XB-70 allegations after the close of the preliminary motion period, when he was served with DeVlieg's motion. While it is true that the facts in Maier differ in that respect from those in this interference, Maier nevertheless stands for the broader proposition that a party has duty to promptly investigate apparently relevant prior art. See also English v. Ausnit, 38 USPQ2d 1625, 1640 (Bd. Pat. App. & Int. 1993):

The "sufficient cause" requirement [of § 1.645(b)<sup>43</sup>] is satisfied by showing that the motion was filed as soon as the patentability issue was discovered, unless the issue could have been discovered earlier. Maier v. Hanawa, 26 USPQ2d 1606, 1610 (Comm'r Pat. 1992); Magdo v. Kooi, 699 F.2d 1325, 1329-31, 216 USPQ 1033, 1037-38 (Fed. Cir. 1983).

Nedelk next argues that "[i]t is simply not understood how one has a duty to obtain further information on subject matter which he does not believe to be claim defeating, after the time for filing preliminary motions has expired" (NMB 22). This assertion is unconvincing because it is not supported by DeYoung's affidavit testimony, quoted

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<sup>43</sup> Effective April 21, 1995, the term "sufficient cause" in § 1.645(b) was changed to "good cause" to be consistent with the terminology used in other interference rules. 1995 Final Rule Notice, 60 Fed. Reg. at 14,513; 1173 Off. Gaz. Pat. & Trademark Office at 57.

above, which explains that he believed the XB-70 braking system may have worked in either of two ways, one of which is the basis for the unpatentability charge made in the belated motion: "I formed the opinion that the brake modification undertaken on the XB-70 aircraft may have dealt with pressure regulation on the brakes, or may have dealt with selective inhibiting and enabling of the brakes at lower speeds."

Regarding this testimony, Nedelk contends that

[w]hile the latter possibility noted by Mr. DeYoung might be relevant to the claimed subject matter, it is clear that neither Mr. DeYoung nor any personnel at ABSC were of the opinion that the evidence submitted by DeVlieg was sufficient to provide a basis for filing a belated preliminary motion under 37 CFR §1.633. [NMB 22.]

This contention is not germane to the issue, which is whether Nedelk had a duty to promptly investigate DeVlieg's allegations about the XB-70 braking system in order to preserve the right to file a belated § 1.633(a) motion based on that braking system.

Nedelk further argues that "[t]o require that Junior Party Nedelk expend further resources to investigate the possibility that DeVlieg's affidavit might be factually correct is inherently unfair, especially when the possibility exists that nothing may have been obtained through the search" (NMB 22).

We do not agree that requiring Nedelk to investigate the two alternative

interpretations DeYoung gave to Smith's account constituted an unfair burden on Nedelk. Finally, Nedelk argues that

[t]o require a party to seek further information on subject matter which is already the subject of a [DeVlieg's] pending motion for which further discovery had already been sought [in the '756 interference], places an unfair and economic hardship on the party and is simply unreasonable. Again, why should one party (Nedelk) be required to spend its money and other resources to seek further information, while another party (DeVlieg) is allowed to await a decision by the Administrative Patent Judge before attempting to locate additional information on the same subject matter? [NMB 23.]

There are several problems with this argument. The first is that

it is entitled to no consideration because it was not made in the motion, as required by § 1.637(a). Instead, it was made for the first time in Nedelk's request for reconsideration<sup>44</sup> of the APJ's decision dismissing the motion, which is improper. See Gable v. Ericson, 228 USPQ 222, 223-24 (Bd. Pat. App. & Int. 1985) (party cannot use request for reconsideration to amplify the showing made in the original motion); Arai v.

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<sup>44</sup> Paper No. 64, at 4.

Kojima, 206 USPQ 958, 959 (Comm'r Pats. & Trademarks 1978) (using request for reconsideration to present reasons not included in the original motion as filed "constitutes unjustifiable piecemeal prosecution of the interference[, ] which is contrary both to the public interest and orderly procedure. See Pritchard v. Loughlin, 360 F.2d 250, 149 USPQ 676 [sic, 361 F.2d 483, 487, 149 USPQ 841, 844] (CCPA 1966).").

The second problem with the argument is that it is incorrect on the merits. Belatedness of a party's motion is not excusable on the ground that the party was waiting for a decision on a similar motion by another party. See Jackson v. Cuntz, 1905 Comm'r Dec. 92, 92, 115 Off. Gaz. Pat. & Trademark Office 510 (Comm'r Pats. 1905):

It is said in the affidavit in support of the [Jackson's] motion [to dissolve] that a motion for dissolution was brought by one Brown, who was a party to the proceedings, and such motion was not decided until December 30, 1904. This seems to be regarded by Jackson as an excuse for not taking steps to make his own motion before December 30; but it is well settled that it constitutes no valid excuse. (Perrussel v. Wichman, C.D., 1902, 228; 99 O.G., 2970). The pendency of Brown's motion constituted no obstacle to the filing of Jackson's motion, but, on the contrary, it would seem that both might have been filed and considered with advantage at the same time. To delay one

until after the other was disposed of would accomplish no useful purpose, but, on the contrary, would result in unnecessary delay.

Thus, in order to ensure that he would be permitted to argue the XB-70 patentability issue, Nedelk should have promptly joined in DeVlieg's timely XB-70 motion and § 1.639(c) request to take testimony. In addition, Nedelk should have promptly begun his efforts to obtain further information about the XB-70 braking system through FOIA.

Moreover, as noted earlier, the motion and DeYoung affidavit are also deficient for failing to give the dates when the XB-70 test data were obtained under FOIA and when it was decided that the test data and information contained therein were sufficient to prove unpatentability.

For the foregoing reasons, we hold that the APJ did not abuse his discretion when he dismissed the belated XB-70 motion for failing to show good cause for the belatedness.

**4. The excuses for the belatedness  
of the on-sale motion**

Nedelk's belated on-sale motion,<sup>45</sup> filed July 21, 1994, relies on only the Wells affidavit and exhibits thereto that were submitted with Stimson's corrected preliminary

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<sup>45</sup> Paper No. 39.

statement. The belated motion includes a section entitled "V. GOOD CAUSE SHOWING FOR BELATED MOTION UNDER 37 C.F.R. §1.635 PURSUANT TO 37 C.F.R. §1.655(b) [sic, §1.645(b)]," which gives several reasons for the belatedness. The reason offered to explain the initial part of the delay is that "the pertinent dates of the on-sale bar and other activities that support the bar were not known to Junior Party Nedelk until after the Preliminary Statements were opened and analyzed." (Motion at 6.) The APJ held,<sup>46</sup> and Stimson does not dispute, that this constitutes good cause for the delay up to about December 20, 1993, when Nedelk received and opened copies of Stimson's corrected preliminary statement and the accompanying Wells affidavit and exhibits thereto.

Nedelk seeks to excuse the last seven months of delay between December 20, 1993, and July 21, 1994, for the following reasons:

[B]ecause efforts to resolve this interference without filing additional, substantive motions have been ongoing, and in the interest of economy, the subject Motion was not filed immediately upon discovery of the pertinent dates. Indeed, Junior Party Nedelk has only recently become fully aware of certain facts set forth hereinabove through information obtained during exploration of settlement

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<sup>46</sup> Paper No. 57, at 3.

possibilities. However, it is believed that Stimson et al. suffers no prejudice by the filing of the Motion and, in fact, knew that this Motion was going to be filed if settlement was not reached prior to the filing of Junior Party Nedelk's affidavits. [Motion at 6.]

Nedelk's briefs for final hearing do not pursue the argument that some relevant facts first came to light during the exploration of settlement possibilities.<sup>47</sup> Instead, Nedelk argues that the last seven months of delay should be excused on the ground that "Junior Party Nedelk believed it had an agreement with Senior Party Stimson et al. to attempt to resolve the interference without filing additional substantive motions until after the settlement discussions terminated" (NMB 12). Stimson's opposition,<sup>48</sup> which was filed November 10, 1994, is accompanied by the affidavit of Deborah Utstein, one of Nedelk's counsels of record, asserting that Stimson made no

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<sup>47</sup> Arguments made in a motion but not in the brief for final hearing are regarded as abandoned. Irikura v. Petersen, 18 USPQ2d 1362, 1365 n.6 (Bd. Pat. App. & Int. 1990); Chai v. Frame, 10 USPQ2d 1460, 1461 n.1 (Bd. Pat. App. & Int. 1989); Photis v. Lunkenheimer, 225 USPQ 948, 950 (Bd. Pat. Int. 1984).

<sup>48</sup> Paper No. 48.

agreement concerning the withholding of motions of any party.<sup>49</sup>

Nedelk's reply,<sup>50</sup> relying on affidavits by Bruce DeYoung and Ray Weber, insists (at 2) that

Stimson et al. was well aware that such a Motion was going to be filed if settlement could not be reached between all parties involved. In fact, as noted herein, to the extent there was any "delay" in the filing of Nedelk's Belated Motion, such "delay" occurred only after counsel for Stimson et al. encouraged it, and to have filed this Motion sooner[] would have created an atmosphere not conducive to good faith settlement negotiations.

Finding the parties' affidavits to be in direct conflict regarding the existence of an agreement, the APJ required additional affidavits on this question.<sup>51</sup> Stimson responded with affidavits by Anthony Lorusso, William Knoeller, Thomas Saunders, and William Wesley as well as a supplemental

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<sup>49</sup> We note that although none of the affidavits filed by the parties regarding Nedelk's "agreement" excuse appear in Nedelk's record and Stimson did not file a record, neither party makes an objection to the opponent's affidavits based on this omission. Consequently, that omission will not stand in the way of our consideration of those affidavits.

<sup>50</sup> Paper No. 53.

<sup>51</sup> Paper No. 57, at 5-6. Nedelk was also given twenty-one days to file a paper explaining why, if it so believes, its involved claims are patentable over the prior art cited in the belated motions (*id.* at 6-7). Nedelk responded by conceding that its claims are unpatentable over the cited prior art if Stimson's claims are determined to be unpatentable over that prior art (paper No. 58).

affidavit by Ms. Utstein. Nedelk filed a supplemental affidavit by Weber and an affidavit by Rodney Skoglund. After determining that the new affidavits also were in direct conflict and seeing no reason to give greater weight to Nedelk's affidavits than to Stimson's, the APJ held that Nedelk had failed to prove the existence of an agreement and dismissed the § 1.633(a) motion for lack of good cause for the last seven months of delay.<sup>52</sup> Regarding the alleged agreement, the APJ further noted that it was

not necessary to decide whether the parties should be allowed to make such an agreement without the approval of the administrative patent judge, where, as here, the evidence to be relied on in the belated motion (i.e., the Wells affidavit and exhibits) was known to all of the parties. This question was not addressed by and of the parties. [Id. at 3.]

Nedelk filed a request for reconsideration<sup>53</sup> of the dismissal of the § 1.633(a) motion, which request was denied by the APJ in a paper mailed November 14, 1996.<sup>54</sup>

Stimson has moved<sup>55</sup> under § 1.656(h) to suppress the Wells affidavit (NE 1070-81) and exhibits thereto (NE 1082-

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<sup>52</sup> Paper No. 62, at 2.

<sup>53</sup> Paper No. 65.

<sup>54</sup> Paper No. 68.

<sup>55</sup> Paper No. 88.

91), which accompanied Stimson's corrected preliminary statement, on several grounds. The first is that the Wells affidavit and exhibits thereto concern the merits of the on-sale motion and the APJ advised the parties that they cannot argue the merits of dismissed motions at this final hearing.<sup>56</sup> Because Nedelk's excuse for the belatedness of the on-sale motion depends in part on his efforts to obtain these documents, they will not be suppressed.

Stimson argues<sup>57</sup> that Nedelk is not entitled to argue this "agreement" at this final hearing because the belated motion did not mention an agreement; instead, it was asserted for the first time in the reply. Nedelk gives the following explanation of why the motion fails to mention the alleged agreement:

[I]t is true that the issue of an agreement was not raised in Nedelk's initial brief [sic, belated motion]. The reason is simple. The undersigned never imagined, in his wildest dreams, that a counselor with whom he had engaged in seemingly good faith settlement discussions on numerous occasions, would renege on his assurance that the "torched [sic, scorched] earth" motion could be filed belatedly. [NRB 11.]

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<sup>56</sup> Paper No. 62, at 3 n.4.

<sup>57</sup> SB 30.

This explanation misses Stimson's point, which is that § 1.637(a) requires a motion to contain all of the arguments on which the movant intends to rely to show prima facie entitlement to the relief sought. The sole purpose of a reply is to address any new points raised in the opposition (§ 1.638(b)), not to correct deficiencies in the motion that are pointed out in the opposition. Consequently, we agree with Stimson that Nedelk's argument that he believed in the existence of the agreement in question is entitled to no consideration. A fortiori, the APJ's decision to dismiss the § 1.633(a) motion for failing to prove the existence of such an agreement was not an abuse of discretion.

We would reach the same conclusion even if the motion as filed were construed as implying either the existence of an agreement or Nedelk's belief in the existence of an agreement, in which case Nedelk would not be precluded from arguing the agreement at final hearing. Although Nedelk's reply is accompanied by affidavits purporting to establish an agreement or at least Nedelk's belief in an agreement, this evidence is entitled to no consideration, because Nedelk has not demonstrated that this evidence could not have been filed with the motion. 37 CFR § 1.639(a); Irikura, 18 USPQ2d at 1368; Bayles, 16 USPQ2d at 1392;

Orikasa, 10 USPQ2d at 2000 n.12. As a result, there is no evidence entitled to consideration which supports the factual assertions regarding the existence of an agreement or Nedelk's belief in the existence of an agreement, as required by § 1.639(a) when a material fact is alleged in support of a motion. In the absence supporting evidence, factual assertions in the motion are only attorney argument and hence entitled to no weight. Compare Behr v. Talbott, 27 USPQ2d 1401, 1407 (Bd. Pat. App. & Int. 1992):

[A] party moving under 37 CFR 1.633(a) for judgment on the ground that an opponent's claims corresponding to the count lack written description support in its involved application has the burden of submitting with the motion proof which prima facie establishes that the limitation in question lacks either express or inherent support in the involved application. Mere attorney argument will not suffice. Meitzner v. Mindick, 549 F.2d 775, [782,] 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977)("the argument that the Mindick parent application does not disclose 'true porosity' is unsupported by evidence. Argument of counsel cannot take the place of evidence lacking in the record").

In the following passage, Nedelk seems to be arguing that his belief in the existence of an agreement is necessarily implied by the belated filing of the motion:

The APJ's decision further begs the question as to what incentive Junior Party

Nedelk would have to delay the filing of the belated on-sale bar motion, had an agreement not existed. There is clearly no reason supported by the evidence other than reasons of economy and the belief of Junior Party Nedelk that an agreement existed. [NMB 26.]

This argument was made for the first time in Nedelk's request for reconsideration and therefore is not entitled to consideration as implicit proof of Nedelk's belief in the existence of the agreement. Nevertheless, we note the language of the motion as filed leaves open the possibility that it was Nedelk's intention not to file a belated motion in the event a settlement agreement was reached. In this regard, we also note that Nedelk has not explained why he believed the chances for reaching a settlement would be improved by filing the on sale motion later rather than sooner.

Another reason Nedelk's "agreement" excuse fails is that the motion does not describe the details of the agreement or explain why the parties should be permitted, with or without the approval of the APJ, to make an agreement apparently contrary to the above-described Notice, which requires that belated motions based on newly discovered evidence be promptly filed after the evidence is discovered.

As Stimson correctly notes,<sup>58</sup> the policy reasons Nedelk offers for allowing such agreements (i.e., a PTO policy favoring amicable resolution of interferences and the economic benefits of having the on-sale issue decided in the PTO rather than in litigation) did not appear in the motion and therefore are not entitled to consideration at final hearing, even though these policy reasons were considered and rejected in the APJ's decision on reconsideration.<sup>59</sup> In any event, we are not persuaded that the alleged economic benefits and lack of prejudice outweigh the requirements of the rules and the decisions interpreting those rules. See Myers v. Feigelman, 455 F.2d 596, 601, 172 USPQ 580, 584 (CCPA 1972):

[T]he [interference] rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules and substantially confuse interference practice.

For the foregoing reasons, we hold that the APJ's decision to dismiss the on-sale motion did not constitute an abuse of discretion. Consequently, we do not reach the

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<sup>58</sup> SMB 31.

<sup>59</sup> Paper No. 68, at 1-3.

question of whether the parties' affidavits, which were filed subsequent to the motion, prove either the existence of the alleged agreement or Nedelk's belief in the existence of such an agreement.

**D. Judgment**

For the foregoing reasons, judgment on the issue of priority is hereby entered against Nedelk's patent claims that correspond to the count, i.e., claims 1-11, which means Nedelk is not entitled to a patent containing those claims. Judgment is

therefore awarded in favor of Stimson et al.'s application  
claims  
that correspond to the count, i.e., claims 16-19, which means  
Stimson et al. are entitled to a patent containing those  
claims.

OF  
APPEALS

\_\_\_\_\_ )  
BRUCE H. STONER, JR., Chief )  
Administrative Patent Judge )  
\_\_\_\_\_ ) BOARD  
\_\_\_\_\_ ) PATENT  
WILLIAM F. PATE, III ) AND  
Administrative Patent Judge ) INTERFERENCES  
\_\_\_\_\_ )  
JOHN C. MARTIN )  
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Interference No. 102,755

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