

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GARRETT H. DeVLIEG,
Junior Party,¹

v.

ARNOLD A. BECK, EDGAR J. RUOF,
JOHN NEDELK, RALPH J. HURLEY, and STEVEN R. SMITHBERGER,
Junior Party,²

v.

IAN L. STIMSON, RICHARD J. MILLER,
and GRAHAM CARRIER,
Senior Party.³

Patent Interference No. 102,756

HEARD: November 10, 1998

¹ Application Serial No. 07/457,053, filed December 26, 1989. Assigned to Boeing Company.

² Patent No. 4,986,610, issued January 22, 1991, based on Application Serial No. 07/380,324, filed July 17, 1989. Assigned to Aircraft Braking Systems Corporation (ABSC). Accorded benefit of Application Serial No. 07/312,994, filed February 21, 1989, now Patent No. 4,923,056, issued May 8, 1990.

³ 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.

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

MARTIN, Administrative Patent Judge.

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The subject matter of this interference is a system for operating brakes on a vehicle, which is disclosed by the parties as an aircraft having carbon brakes. Count 1, the sole count, reads as follows:

A brake system for a vehicle, comprising:

first and second sets of brakes associated with respective sets of wheels of the vehicle;

operator controlled brake actuation means interconnected with said first and second sets of brakes for allowing an operator to regulate application and release of brake pressure at said brakes;

wheel speed sensing means associated with said wheels for producing a wheel speed sensing signal indicative of instantaneous speed of the vehicle; and

brake selection means interconnected between said first and second sets of brakes and said wheel speed sensing means for enabling said first set of brakes to receive said application and release of brake pressure while inhibiting said second set of brakes from receiving said application and release of brake pressure when said speed of the vehicle is below a first predetermined threshold speed.

The meaning and scope of the count are not in dispute. The parties' claims that are designated as corresponding to this count are:

DeVlieg claims 1-14;

Beck et al. claims 1-17; and

Stimson et al. claims 20 and 21.

John Nedelk, who is one of the Beck et al. inventors, and all of the Stimson et al. inventors are involved in another interference on related subject matter: Interference No. 102,755 ('755), captioned "Nedelk v. Stimson et al." The '755 interference is between the same Stimson et al. application that is involved in this interference and Nedelk Patent No. 4,923,056, which is the parent of the Beck et al. patent that is involved in this interference. Beck et al. have been accorded benefit of the Nedelk patent. The Beck et al. and Nedelk patents are assigned to Aircraft Braking Systems Corporation (ABSC).

A. Summary entry of judgment against DeVlieg

In Paper No. 85, at 7, the Administrative Patent Judge (APJ) advised DeVlieg that due to his failure to present any testimony during his testimony-in-chief period, judgment would be entered against his claims that correspond to the count at such time as a final decision is entered in this interference. As DeVlieg has not filed a brief challenging the APJ on this or any other matter, judgment is being entered infra against those claims on the issue of priority.

B. The issues

The issues before us in this interference are essentially the same as the issues before us in the '755 interference, i.e., priority and two belated 37 CFR § 1.633(a)⁴ motions for judgment by Beck et al. (hereinafter Beck): an "on-sale motion" alleging an on-sale bar based on activities by Stimson at an Atlanta show; and an "XB-70 motion" alleging prior use of the braking system of the count by a non-party, North American Rockwell Corporation, on the XB-70 aircraft. As in the '755 interference, ABSC (i.e., Beck) has moved without opposition to strike Stimson et al.'s (Stimson's) "reply brief" to Beck's reply brief for final hearing, which motion is hereby granted, and Stimson has moved

⁴ 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).

to suppress much of the evidence relied on by Beck in support of his priority case and belated § 1.633(a) motions.⁵

There is an additional issue in this interference that was not raised in the '755 interference: whether Arnold Beck, one of the inventors named in the involved Beck patent, can testify as a corroborating witness for John Nedelk, who is identified in the preliminary statement as the sole inventor of the subject matter of the count. For the reasons given infra, we hold that he is not entitled to testify as a corroborating witness. Furthermore, if he were permitted to so testify, his testimony would be insufficient to prove either conception or diligence. We will begin with priority.

⁵ The briefs which are entitled to consideration are Beck's main brief (BMB), Stimson's main brief (SMB), and Beck's reply brief (BRB). Only Beck filed a record (BR) and exhibits (BE), which are virtually similar to Nedelk's record and exhibits in the '755 interference, except for having different page numbers due to the inclusion of Weber's July 21, 1994 declaration (BR 41-42) and Weber's cross-examination with respect thereto (BR 503-30). We will refer to Nedelk's record (NR) and exhibits (NE) in the '755 interference for the evidence that is common to both interferences.

C. Priority

Beck 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.

As already noted, Beck's preliminary statement⁶ identifies John Nedelk as the sole inventor of the subject matter of the count. Beck does not allege an actual reduction to practice prior to his filing date.⁷ Rather, Beck alleges conception by Nedelk prior to Stimson's British benefit date coupled with diligence from just before that date up to Beck's February 21, 1989, filing date. Because Beck is a junior party patentee, his burden of proof on the priority issue is proof by a preponderance of the evidence. Fredkin v. Irasek, 397 F.2d 342, 343, 158 USPQ 280, 281 (CCPA 1968).

1. Whether Arnold Beck can

⁶ Paper No. 14.

⁷ Consequently, Stimson has withdrawn (at SMB 40) his contention that Beck suppressed or concealed the invention, as argued in Stimson's § 1.632 notice of intent to argue abandonment, suppression, or concealment (Paper No. 100).

testify as a corroborating witness

Beck relies on the testimony of Arnold Beck, one of the five named coinventors in the Beck patent, to corroborate Nedelk's conception and diligence. Stimson argues that because all of the claims of that patent stand designated as corresponding to the count, there is a rebuttable presumption that all of the coinventors named in the patent, including Arnold Beck, are coinventors of the subject matter of the count, citing Larson v. Johenning, 17 USPQ2d 1610, 1614 (Bd. Pat. App. & Int. 1991), which held:

[I]n an interference such as this where all of the claims of Larson et al have been designated as corresponding to the count, all of the joint applicants must prima facie be deemed to be coinventors of the subject matter of the count. In other words, the burden is on the party asserting that the joint applicant relied upon as a corroborating witness is not a joint inventor of the subject matter of the count to establish that fact through convincing evidence in the record. Cf. Vanderkooi v. Hoeschele, 7 USPQ2d 1253, 1256 (BPAI 1987).

As Stimson correctly notes, Beck's failure to satisfy this burden would mean that Arnold Beck's testimony cannot be used to corroborate Nedelk's alleged conception or diligence. See Larson, 17 USPQ2d at 1614 (the testimony of one actual coinventor cannot be relied to corroborate conception or a

reduction to practice by another) (citing Manny v. Garlick, 135 F.2d 757, 768, 57 USPQ 377, 388 (CCPA 1943)). Beck contends (BRB 2) that his burden under Larson is satisfied by the testimony of his attorney of record, Ray Weber, concerning the contributions of the different inventors (BR 41:¶ 4, BR 512:15, and 514:6 and 12-21). We find Weber's testimony inadequate for both procedural and substantive reasons.

The procedural reason is that the evidence on the inventorship issue should have been presented in the form of a § 1.634 motion to change the inventorship from joint to sole, i.e., John Nedelk. The identification of John Nedelk in the preliminary statement as the sole inventor of the subject matter of the count when all of the Beck patent claims correspond thereto is tantamount to asserting that John Nedelk is the sole inventor of subject matter of each and every claim, thereby implying that one or more of the claims are unpatentable under 35 U.S.C. § 102(f) on the ground that the joint inventors "did not [themselves] invent the subject matter sought to be patented."⁸ Having thus implicitly conceded that one or more claims are unpatentable on this

⁸ If fewer than all of the claims were designated as corresponding to the count, it would be presumed that Nedelk's sole inventorship applies to only those claims.

ground, it was incumbent on Beck to eliminate this ground for unpatentability by moving under § 1.634 to converting the inventorship of the application from joint to sole. Compare Schulze v. Green, 136 F.3d 786, 790-91, 45 USPQ2d 1769, 1773-74 (Fed. Cir. 1998) (holding that Schulze, having raised a 35 U.S.C. § 102(f) patentability/inventorship issue by filing a § 1.634 motion that was dismissed for failing to comply with the requirements of 37 CFR § 1.48(a), should have filed a new § 1.634 motion complying with those requirements in order to have the inventorship question finally resolved in the interference). As noted in Schulze, such a motion can be filed at any time during an interference. 136 F.2d at 791, 45 USPQ2d at 1774.

Assuming for the sake of argument that a § 1.634 motion was not required, Weber's testimony fails to satisfy the "convincing" evidence requirement of Larson. While his affidavit⁹ explains that he was the attorney in charge of the preparation and prosecution of involved Beck et al. U.S. Patent 4,986,610 (BR 41, ¶ 2) and that "[b]ased on my extensive dealings with the inventors of U.S. Patent 4,986,610, it is my belief that Mr. Nedelk was the inventor of

⁹ As used in the interference rules, the term "affidavit" also includes declarations. 37 CFR § 1.601(n).

the invention defined by the count" (BR 41, ¶ 4), his testimony on cross-examination does not adequately explain why he reached this conclusion. Weber explains that he talked briefly with Nedelk (BR 506:1-3), worked primarily with Beck and Ruof to prepare the application (BR 506:19-20; 507:2-5; 511:4-9), and met with Beck and Ruof concerning Figures 3 and 4, respectively (BR 513:11-13). However, when asked to identify Beck's contributions to the disclosed invention, he was unable to do so (BR 513:22 to 514:21):

Q. What was your understanding as to what part of the invention Mr. Beck was involved [in]?"

A. Right now I have to be frank with you, I don't recall what parts. I can tell you that -- that Beck was the antiskid man, and Beck would have been -- you know, if I hadn't even been involved in this and you asked me I would say Beck worked with the interface --- interfacing this with an antiskid system, so that you don't have antiskid operation while you're doing Taxi Brake Select.

Q. Do you remember specifically what the various contributions were?

A. No.

Q. Okay.

A. No, I really don't. I don't --

Q. Was John Nedelk in there because he was the inventor of the parent?

A. Well, I think he was in there -- A, he was the inventor of the parent, but also he was the inventor -- you know, the way I was drafting the -- the main claim, he was the inventor of that as well.

Q. Okay.

A. Although the other gentlemen contributed to an embodiment or embodiments that also were covered by that claim.

Notably absent from Weber's testimony is an assertion that it was Nedelk's rather than Beck's idea to make selective braking responsive to wheel speed, as required by the count in this interference.

For the foregoing reasons, Weber's testimony fails to establish that Arnold Beck is not a coinventor of the subject matter of the count, with the result that he may not testify as a corroborator of John Nedelk's alleged conception or diligence. In any event, as explained infra, Beck's testimony would fail as corroboration even if it could be relied on for that purpose.

2. Stimson's motion to suppress most of Beck'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 Beck to prove conception and diligence; Stimson also requests that the references to this

evidence in Beck's opening brief be given no consideration.¹⁰ For the reasons given in our decision in the '755 interference, which are repeated below, 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 self-serving excuse for the absence of [an] actual reduction to practice."¹¹ 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."¹² We are of the view that these paragraphs are relevant to 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

¹⁰ Paper No. 112, at 11-15.

¹¹ Id. at 11.

¹² Id.

be irrelevant because "efforts to commercially exploit an invention are not the equivalent of diligence. MPEP 2138.06."¹³ These efforts may be relevant if, as Nedelk contends, testing in a commercial aircraft was the only way to achieve an actual reduction to practice. For the foregoing reasons, none of paragraphs 8-11 will be suppressed.

(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."¹⁴ 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 against 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 Beck's priority case.¹⁵ In our view, Gillespie's

¹³ Id.

¹⁴ Id. at 11-12.

¹⁵ Id.

testimony is relevant because it is being offered to prove he was told that Nedelk's conception date preceded his.

(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 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 Beck concedes this installation occurred after the critical period for showing diligence (Opposition at 11),¹⁶ we will not suppress this testimony, as it may shed light on whether the activities during the 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 also relevant to Beck's priority case and will not be suppressed.

¹⁶ The critical period runs from just before Stimson's February 16, 1988, benefit date up to Beck's February 21, 1989, filing date.

(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 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.

3. Beck's case for conception

The requirements for proof of conception are described as follows 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 Beck's case for conception by Nedelk fails because it is not supported by any documentary evidence: "[N]ot 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" (SMB 15). 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 Beck's evidence of conception, Boeing invited representatives of Goodyear Aerospace Corporation (GAC), one of the two predecessor corporations to Aircraft

Braking Systems Corporation (ABSC),¹⁷ to Seattle to discuss a problem it was experiencing with the Dunlop carbon brakes in use on the Boeing 757. As explained in John Nedelk's April 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.]

Nedelk, identified in Beck's preliminary statement¹⁸ as the sole inventor of the invention defined by the count, testified that during the course of the Boeing trip he (a) conceived the idea of using only one half of the brakes

¹⁷ 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, the four divisions were converted into four separate companies, including ABSC (Milliken, NR 188:21-22).

¹⁸ Paper No. 14.

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 his April 29, 1985, memorandum about the Boeing trip. Instead, to corroborate conception the party Beck relies principally on testimony by Arnold Beck. For the reasons given above, Beck's testimony cannot be relied on as corroboration.

Even assuming Beck's testimony can be relied on as corroboration, it fails for the following reasons. Beck testified that during the afore-mentioned trip to Boeing, 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). However, Beck's testimony about his discussions with Nedelk prior to that date, including on or shortly after their April 23, 1985, trip to Boeing, does not demonstrate that Nedelk's concept included (a) wheel speed sensing means and (b) brake selection means for enabling/ inhibiting the sets of brakes with respect to a threshold speed, as recited in the count and required for the party Beck to be credited with conception. Coleman, 754 F.2d at 359, 224 USPQ at 862; Davis, 620 F.2d at 889, 205 USPQ at 1069. (In fact, even Nedelk's testimony about his discussions with Beck fails to mention these limitations.) Beck's position appears to be that one skilled in the art would have recognized that all brake control systems include wheel sensors (BRB 3) and thus would also have recognized that Nedelk's braking concept as disclosed to Beck inherently would employ (a) wheel speed sensing means and (b) brake selection means for enabling/inhibiting the sets of brakes with respect to a threshold speed (BRB 4). This inherency argument is contradicted by Nedelk's August 17, 1988, invention disclosure

document (BE 6-9), which does not mention using wheel speed to control brake selection. Instead, it explains that the invention can be implemented using one-way check valves which permit only some of the brakes to be used during taxi/snub stops, when the braking pressure is below the threshold pressure of the valves. Nor is wheel speed sensing mentioned in Beck's benefit case, i.e., the Nedelk patent, filed February 21, 1989, which discloses (at col. 2, line 67 to col. 3, line 43) the one-way check valve embodiment described in the invention disclosure as well as a second embodiment that employs a switch 26 associated with the landing gear (col. 3, line 44 to col. 4, line 26).¹⁹

Beck's contention that Nedelk's conception is corroborated by Gillespie's testimony is unconvincing for the following reasons. 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:

¹⁹ Stimson did not move under § 1.663(g) motion to attack Beck's benefit of the Nedelk patent on this or any other ground.

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

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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.²⁰ 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 prior inventor or when he was told (NR 426:23 to 429:14). His testimony therefore leaves open the possibility that this information

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

was obtained directly or indirectly from the Beck and/or Nedelk and thus lacks the requisite independence from the inventors.²¹ In addition, Gillespie's testimony, like Arnold Beck's, fails to show that Nedelk's concept prior to Stimson's February 16, 1988, benefit date included (a) wheel speed sensing means and (b) brake selection means for enabling/inhibiting the sets of brakes with respect to threshold speed.

The earliest evidence disclosing a brake select system responsive to wheel speed is Moseley's block diagram dated July 15, 1988 (NE 48), five months after Stimson's benefit date.

This diagram includes a block labeled "Check: Pedal < 35% and Speed < 50 mph" that receives inputs labeled "Pedal" and "Speed." There is no evidence that the idea of using wheel speed to control the brake selection process originated with Nedelk, the alleged sole inventor, rather than with Moseley, as is necessary to credit Nedelk with conception of the subject matter of the count. As noted above, Nedelk's

²¹ Although Nemcheck testified he was aware of Nedelk's 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).

invention disclosure and patent do not disclose using wheel speed to control the brake selection process.

3. Beck's case for diligence

Although Beck has not demonstrated conception by Nedelk prior to Stimson's February 16, 1988, benefit date, we will assume that conception has been proved in order to address the question of whether Beck has shown diligence for the critical period running from just prior to Stimson's benefit date up to Beck's February 21, 1989, effective filing date. 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 at 626, 2 USPQ2d at 1362.

Beck does not allege any acts toward a constructive or actual reduction to practice during the first five months of the critical period. Instead, Beck argues that the failure to perform any such acts during this interval should be excused on the ground that the control apparatus 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, either actually or constructively. A party cannot be excused for failing to act unless the party had an intent to act but for the circumstances offered as the 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) shortly after learning of the invention from Nedelk decided that 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 of which Beck no longer has any record (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.) Furthermore, when asked whether at that point 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 on behalf of ABSC at that time to reduce Nedelk's invention to practice as soon as possible. On the contrary, 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.)

Furthermore, 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 likewise 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 392:6-13.]

Nor is there any documentary evidence dated prior to February 16, 1988, 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. The testimony also fails to establish that any of the wear data obtained using ABSC's shaft dynamometer prior to February 16, 1988, was obtained as part of an effort to reduce Nedelk's invention to practice. See Zarembka's testimony at NR 22-23, ¶¶ 6-11 regarding the wear data in Zarembka Exhibits A-F (NE

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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 reduce Nedelk's invention to practice 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), as evidenced by the last two lines of Moseley's notes from that meeting, which read, "4. Define brake cycling control system to reduce taxi wear rate. Action DD Moseley & AA Beck." (NE 46; Moseley, NR 19, ¶ 4.) 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 Beck 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, Beck's excuses for inactivity are unpersuasive and Nedelk cannot be credited with diligence. Accordingly, judgment on the issue of priority is being entered infra against Beck's claims. Alternatively, assuming for the sake of argument that the evidence demonstrates such a decision had been made prior to Stimson's benefit date, judgment is entered against

Beck 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 were made to reduce Nedelk's invention to practice prior to the Airbus proposal is clear from Beck's testimony (NR 472:14-17):

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 249:11 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 these 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, Beck'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); See also Hudson v. Giuffrida, 328 F.2d 918, 923, 140 USPQ 569, 573 (CCPA 1964). Thus, the unexcused five months of inactivity at

the beginning of the critical period is another reason for entering judgment against Beck. See Bigham v. Godtfredsen, 222 USPQ 632, 637-38 (Bd. Pat. Int. 1984) (unexplained inactivity for one month defeats claim of diligence); Moller v. Harding, 214 USPQ 724, 729 (Bd. Pat. Int. 1982) (unexplained inactivity for one and one-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 Beck was diligent during the remainder of the critical period, i.e., from July 1988 up to Beck's February 21, 1989, effective filing date.

D. Beck's belated on-sale and XB-70 motions

As already noted, the APJ dismissed Beck's on-sale and XB-70 motions for failing to show good cause under § 1.645(b) for their belatedness.²²

1. Standard of review

As explained in Consideration of Interlocutory Rulings at Final Hearing in Interference Proceedings, 64 Fed. Reg. 12,900, 12,901 (March 16, 1999), § 1.655(a) was amended effective March 16, 1999,

²² 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).

to emphasize that a panel of the Board will resolve the merits of an interference as a panel without deference to any interlocutory order. Panels will, however, continue to apply the abuse of discretion standard, but

only with respect to procedural orders. No list could completely detail which issues are procedural, but examples would include granting or denying an extension of time, granting or denying additional discovery under 37 CFR 1.687(c), dismissing a motion for failure to comply with the rules and setting times to take action in an interference, and determining the dates for conference calls.

An abuse of discretion occurs if the decision (1) is clearly unreasonable, arbitrary or fanciful, (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 14,514-15, 1173 Off. Gaz. Pat. & Trademark Office at 58. Section 1.655(a) as amended further provides that the party requesting modification of an interlocutory order has the burden of showing that the order should be modified.

Stimson's belated § 1.633(a) motions included § 1.635 motions purporting to show good cause for their belatedness, thereby satisfying § 1.645(b)'s procedural requirement that a belated motion be accompanied by or include a § 1.635 motion demonstrating good cause for the belatedness.

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Thus, in dismissing the § 1.633(a) motions for failing to show good cause, the APJ implicitly denied the § 1.635 motions on the merits,

which denial in our view therefore is not subject to the deferential "abuse of discretion" standard. However, the APJ's refusal to consider evidence filed with replies for the § 1.633(a) motions is reviewable based on that standard.

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 is involved in only this interference, filed a § 1.633(a) motion²³ 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 DeVlieg²⁴ stating that on July 20, 1992, he and Ms. Harasek, counsel of record in the involved DeVlieg 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

²³ Paper No. 19 in this interference.

²⁴ In paper No. 85, at 6 n.6, the APJ indicated that the motion incorrectly states (at 2) that it is accompanied by an affidavit by Ms. Harasek.

§ 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.

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 and served a § 1.628 motion²⁵ in each interference for leave to file a corrected preliminary statement²⁶ alleging prior importation into the United States in the form of meeting

²⁵ Paper No. 39.

²⁶ Paper No. 38.

between Stimson and Delta Airlines in Atlanta.²⁷ The corrected preliminary statement and a supporting affidavit by Trevor Wells were filed on October 23, 1992 in a sealed envelope but not served. The notice²⁸ of filing the corrected preliminary statement indicated that the corrected preliminary statement and Wells affidavit (including exhibits) would be served upon order of the APJ.

On December 6, 1993, the APJ mailed his "Decisions on Motions" in both interferences.²⁹ In both interferences, the APJ granted Stimson's motion to file a corrected preliminary statement, set due dates for the parties' testimony, records,

²⁷ The new material added to the preliminary statement (at 2) reads as follows:

(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). [Emphasis omitted.]

²⁸ Also Paper No. 38.

²⁹ Paper No. 43 in this interference.

and briefs, and ordered the parties to serve their preliminary statements, including Stimson's corrected preliminary statements, within two weeks of the mailing date of the Decisions on Motions. Stimson does not dispute Beck's claim (BMB 12) of receiving Stimson's corrected preliminary statement on or about December 20, 1993. In addition, in this 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-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 Beck/Nedelk and Stimson were made to coincide in both interferences.³⁰

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 to file their

³⁰ Paper Nos. 54 and 55.

priority affidavit testimony in both interferences, they filed their priority testimony and the two belated motions now before us: (a) the on-sale motion³¹ alleging that Dunlop's activities at the Atlanta meeting described in the Wells affidavit amounted to an offer to sell the invention to Delta; and (b) the XB-70 motion,³² which repeats the XB-70 unpatentability argument that was initially raised in DeVlieg's timely § 1.633(a) motion filed on August 31, 1992.³³ Both of Beck's belated motions included requests under § 1.639(c) to take testimony of persons having knowledge of the facts and explained why Beck believed he had "good cause" under

³¹ Paper No. 64.

³² Paper No. 65.

³³ On the same date that Beck's belated motions were filed, DeVlieg, too, filed a belated § 1.633(a) motion in this interference raising the on-sale issue against Stimson, which motion the APJ dismissed for the same reasons as the belated Beck motion raising this issue (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.

§ 1.645(b) for the belatedness of the motions. Because Beck 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

Nedelk's belated July 21, 1994, XB-70 motion was filed twenty-two and one-half months after DeVlieg's timely August 31, 1992, motion raising that issue in the '756 interference. The DeVlieg motion was based on Mr. DeVlieg's affidavit describing a conversation with Smith (NE 1068):

Mr. Smith said during that conversation that shutting off half the brakes for taxiing had been tried in 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, resulting in the dismissal of his timely XB-70 motion.³⁴

Beck's belated motion as filed is based on evidence which 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 (FOIA).³⁵ In response to Stimson's opposition,³⁶ which argues (at 3-4) that the motion and evidence fail to prove dates for the acts alleged therein, Beck filed a reply³⁷ accompanied by new evidence including DeYoung's November 1, 1994, deposition testimony (Reply Ex. A, NR 502-26) about his July 21, 1994, affidavit and the following evidence (Reply Exs. B-H), which

³⁴ Paper No. 85, at 7, in this interference.

³⁵ Beck'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 Beck had not demonstrated that the testimony was unavailable at the time the belated motion was filed (paper No. 85, at 7-8), he reversed himself on reconsideration, holding that because the belated § 1.633(a) motion was filed at the beginning of Beck's testimony-in-chief period, it was reasonable for Beck to assume that the requested testimony need not accompany the motion (paper No. 91, at 7).

³⁶ Paper No. 72.

³⁷ Paper No. 78, filed December 21, 1994.

is not included in either party's record:³⁸ (a) a December 21, 1994, affidavit by DeYoung; (b) a December 4, 1994, affidavit by Ray Weber; (c) a December 21, 1994, affidavit by Arnold Beck; and the exhibits referred to in these affidavits.

Furthermore, the APJ correctly 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."³⁹ It is well settled that all of the available evidence on which a party intends to 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.

³⁸ Neither party has objected to our consideration of these affidavits on this ground.

³⁹ Paper No. 85, at 10.

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 DeYoung's deposition testimony is not entitled to consideration, Stimson's motion to suppress 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, Stimson⁴⁰ seeks to suppress the 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 instruction 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. 85, at 3 n.4.]

Beck does not take issue with the foregoing instruction, arguing instead that he is entitled, as part of our review of the dismissal of the XB-70 motion, to consideration of all of the evidence filed with the motion.⁴¹ Because the motion relies on the efforts to acquire this test data to excuse the belatedness, we will not suppress the data. Consequently, the question before us reduces to whether the belated motion and the evidence filed therewith (i.e., DeYoung's July 21, 1994, affidavit and the FOIA documents) establish good cause for the belatedness. We hold that they do not.

⁴⁰ Paper No. 112, at 7-8.

⁴¹ Paper No. 115, at 8.

The explanation given in the 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)⁴²]," reads in its entirety as follows:

Junior Party Beck et al. 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 C.F.R. §1.655(b)(3). Specifically, all of the facts as presented hereinabove were not known to Junior Party Beck et al. 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 Beck et al. 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 Beck et al. 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

⁴² 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 14,513; 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.").

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 Beck et al. 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 Beck et al. 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. 65, at 5-6.]

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.⁴³ The APJ explained that these dates are necessary because Beck 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

⁴³ Paper No. 91, at 11-12.

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such a duty, the APJ⁴⁴ cited two authorities. The first is an October 6, 1992, notice by the Chairman of the Board of Patent Appeals and Interferences,

⁴⁴ Paper No. 85, at 10.

Interference Practice: Matters Relating to Belated Preliminary Motions, 1144 Off. Gaz. Pat. Office 8 (Nov. 3, 1992)

(hereinafter, Notice), which reads in pertinent part as follows:

In some interference proceedings, evidence which would provide a basis for a 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 U.S.C. § 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 APJ⁴⁵ is Maier v. Hanawa, 26 USPQ2d 1606, 1610 (Comm'r Pats. & Trademarks 1992), which held that belatedness in filing a motion alleging unpatentability will not be excused if the underlying evidence could have been discovered earlier through reasonable efforts:

[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.]

Beck questions the APJ's reliance on both of these cited authorities. Beck argues⁴⁶ that because the first paragraph of the Notice mentions only prior art discovered after the date of an APJ's decision on preliminary motions, it is clear that the Notice is not relevant to the fifteen month period between the filing date of DeVlieg's motion and the mailing date of the APJ's Decisions on Motions. Otherwise, Beck contends, the first paragraph is completely immaterial to the Notice. We do not agree. It is clear that the first paragraph describes the facts which occurred in a particular

⁴⁵ Paper No. 91, at 9-10.

⁴⁶ BMB 19.

interference and led to publication of the Notice. The second paragraph, on the other hand, sets forth guidelines which are applicable whenever evidence of unpatentability is discovered after the close of the preliminary motion period.

Beck next argues⁴⁷ that neither the Notice nor Maier imposed a duty to promptly investigate DeVlieg's XB-70 allegations. As to the Notice, Beck argues that "[a]ll that is required by this notice is that the moving party file its motions promptly after the evidence becomes available" (BMB 22). 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. Maier is alleged to be inapposite because it concerns prior art that could have been located prior to the close of the preliminary motion period, whereas Beck first learned of DeVlieg's XB-70 allegations after the close of the preliminary motion period, when he received the served copy of DeVlieg's motion. While it is true that the facts in Maier differ in this respect from those in this interference, we are of the view that Maier nevertheless stands for the broader proposition that a party has duty to

⁴⁷ BMB 20.

promptly investigate apparently relevant prior art whenever it comes to light. See also English v. Ausnit, 38 USPQ2d 1625, 1640 (Bd. Pat. App. & Int. 1993):

The "sufficient cause" requirement [of § 1.645(b)⁴⁸] 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).

Beck's next argument is 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" (BMB 24). The assertion that the XB-70 braking system was not believed to be relevant is not supported by DeYoung's affidavit testimony, quoted 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-

⁴⁸ 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.

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." (NR 501, ¶ 3.)

Regarding this testimony, Beck 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. [BMB 24.]

This argument is not apropos to the issue, which is whether Beck 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.

Beck further argues that "[t]o require that Junior Party 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" (BMB 24). We do not agree that requiring Beck to investigate the two alternative

interpretations DeYoung gave to Smith's account constituted an unfair burden. Finally, Beck 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 (Beck et al.) 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? [BMB 24-25.]

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 improperly was offered for the first time in Beck's request for reconsideration⁴⁹ of the APJ's decision dismissing the motion. 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. 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[,]

⁴⁹ Paper No. 87, at 4.

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. The 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 [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, Beck should have promptly

joined in DeVlieg's timely XB-70 motion and § 1.639(c) request to take testimony. In addition, Beck should have promptly begun his own efforts to obtain further information about the XB-70 braking system under FOIA. Furthermore, as noted earlier, the motion and DeYoung affidavit are also deficient in failing to give the dates when the XB-70 test data were sought and obtained under FOIA and when it was decided that the test data were sufficient to support a § 1.633(a) motion alleging unpatentability.

For the foregoing reasons, the § 1.635 motion to excuse the belatedness of the XB-70 § 1.633(a) motion is denied and the XB-70 motion is dismissed.

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

Beck's belated on-sale motion,⁵⁰ filed July 21, 1994, relies on only the Wells affidavit (NE 1071-81) and exhibits thereto (NE 1082-91) that were submitted with Stimson's corrected preliminary statement. Stimson has moved⁵¹ under § 1.656(h) to suppress the Wells affidavit and exhibits on the ground that they concern the merits of the on-sale motion and the APJ advised the parties that they cannot argue the merits

⁵⁰ Paper No. 64.

⁵¹ Paper No. 112.

of dismissed motions at this final hearing.⁵² Because, as will appear, Becks's excuse for the belatedness of the on-sale motion depends in part on the date of his receipt of this evidence, it will not be suppressed. The belated on-sale 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 Beck et al. until after the Preliminary Statements were opened and analyzed." (Motion at 6.) The APJ held,⁵³ and Stimson does not dispute, that the foregoing reason constitutes good cause for the delay up to about December 20, 1993, when Beck received and opened copies of Stimson's corrected preliminary statement and the accompanying Wells affidavit and exhibits thereto.

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

⁵² Paper No. 85, at 3 n.4.

⁵³ Paper No. 79, at 3.

[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 Beck et al. has only recently become fully aware of certain facts set forth hereinabove through information obtained during exploration of settlement 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 Beck et al.'s affidavits. [Motion at 6.]

However, the motion was not accompanied by an affidavit supporting these assertions. Becks's briefs for final hearing do not pursue the argument that some relevant facts first came to light during the exploration of settlement possibilities.⁵⁴ Instead, Beck argues that the last seven months of delay should be excused on the ground that "Junior Party Beck et al. 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" (BMB 13, ¶ 43). Stimson's

⁵⁴ 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).

opposition,⁵⁵ which was filed November 10, 1994, is accompanied by the affidavit of Deborah Utstein, one of Beck's counsels of record, asserting that Stimson made no agreement concerning the withholding of motions of any party.⁵⁶ Beck's reply,⁵⁷ 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 Beck et al.'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

⁵⁵ Paper No. 71.

⁵⁶ Although none of the affidavits filed by the parties regarding the alleged agreement appear in Nedelk's record (Stimson did not file a record), neither party has objected to their consideration at this final hearing.

⁵⁷ Paper No. 77.

additional affidavits on this question.⁵⁸ Stimson responded with affidavits by Anthony Lorusso, William Knoeller, Thomas Saunders, and William Wesley as well as a supplemental affidavit by Ms. Utstein. Beck 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 Beck's affidavits than to Stimson's, the APJ held that Beck 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.⁵⁹ 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

⁵⁸ Paper No. 79, at 6-7. Beck 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 7). Beck 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. 80).

⁵⁹ Paper No. 85, at 2.

all of the parties. This question was not addressed by any of the parties. [Paper No. 85, at 3.]

Beck filed a request for reconsideration⁶⁰ of the dismissal of the belated on-sale motion, which request was denied by the APJ in a paper mailed November 14, 1996.⁶¹

Stimson argues⁶² that Beck is not entitled to argue the alleged agreement at this final hearing because it was mentioned for the first time in the reply. Beck responds to this argument as follows:

[I]t is true that the issue of an agreement was not raised in Beck's initial brief [sic, 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. [BRB 13-14.]

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 (§

⁶⁰ Paper No. 88.

⁶¹ Paper No. 91.

⁶² SMB 38.

1.638(b)), not to correct deficiencies in the motion that are pointed out in the opposition. Consequently, we agree with Stimson that Beck's asserted belief in the existence of the agreement in question is entitled to no consideration, with the result that the on-sale motion is denied.

We would reach the same conclusion even if the motion as filed were construed as implying either the existence of an agreement or Beck's belief in the existence of an agreement, in which case Beck would not be precluded from arguing the agreement at final hearing. Although Beck's reply is accompanied by affidavits purporting to establish an agreement or at least Beck's belief in an agreement, this evidence is entitled to no consideration, because Beck has not shown good cause for not filing this evidence 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 Beck'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

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and thus 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, Beck 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 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 that an agreement existed. [BMB 28.]

This argument was made for the first time in Beck's request for reconsideration and therefore is not entitled to consideration. Nevertheless, we note the language of the motion as filed leaves open the possibility that it was Beck's intention not to file a belated motion in the event a settlement agreement was reached; Beck has not explained why he believed the chances for reaching a settlement would be

better if the belated motion were filed later rather than sooner.

Another reason Beck'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-discussed Notice, which requires that any belated motions based on newly discovered evidence be promptly filed after the evidence is discovered. As Stimson correctly notes,⁶³ the policy reasons given in Beck's briefs 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 they were considered and rejected in the APJ's decision on reconsideration.⁶⁴ 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

⁶³ SMB 39.

⁶⁴ Paper No. 91, at 1-3.

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, the § 1.635 motion to excuse the belatedness of the on-sale § 1.633(a) motion is denied and the on-sale motion is dismissed.

E. Judgment

For the foregoing reasons, judgment on the issue of priority is hereby entered against: (a) DeVlieg's application claims that correspond to the count, i.e., claims 1-14, which means DeVlieg is not entitled to a patent containing those claims; and (b) Beck et al.'s patent claims that correspond to the count, i.e., claims 1-11, which means Beck et al. are not entitled to a patent containing those claims. Judgment therefore is 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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JCM/cam

Interference No. 102,756

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