

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 81

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID J. PARINS and RICHARD K. POPPE

Junior Party,¹

v.

CHARLES R. SLATER

Senior Party.²

Patent Interference No. 104,190

FINAL HEARING: December 19, 2000

¹ Patent No. 5,540,685, granted July 30, 1996, based on Application Serial No. 08/435,305, filed May 5, 1995. Accorded the benefit of Application Serial No. 08/369,379, filed January 6, 1995, now abandoned. Assignors to Everest Medical Corporation.

² Application Serial No. 08/806,386, filed February 27, 1997. Accorded the benefit of Application Serial No. 08/354,992, filed December 13, 1994, now abandoned. Assignor to Boston Scientific Corporation.

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Before CALVERT, PATE and HANLON, Administrative Patent Judges.
PATE, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658(a)

This is a final decision in Interference No. 104,190. The junior party inventors are David J. Parins and Richard K. Poppe³ and their involved U.S. Patent No. 5,540,685 is assigned to Everest Medical Corporation. The filing date of the junior party involved patent was May 5, 1995, and the junior party has been accorded benefit of the filing date of application Serial No. 08/369,379, filed January 6, 1995. The senior party inventor is Charles R. Slater. Senior party Slater is involved on his application Serial No. 08/806,386, filed February 27, 1997, and assigned to Boston Scientific Corporation. The Slater applica- tion has been accorded the benefit of application Serial No. 08/354,992, filed December 13, 1994. Slater is the senior party by 23 days. Both parties were represented by counsel in an oral hearing held December 19, 2000.

³ Henceforth the junior party inventors will be referred to in the singular, i.e., as the first-named inventor Parins.

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The subject matter of the interference is a bipolar electrosurgical scissors. As stated in the preamble of the count, such scissors are used to simultaneously cut tissue and coagulate severed blood vessels during surgery on a living animal. The count reads as follows:

Count 2

A bipolar electrosurgical instrument for cutting and coagulating tissue comprising:

(a) first and second metal blades each having a cutting edge and shearing surface, said first metal blade supporting an insulative layer on a surface other than the cutting edge and shearing surface thereof and an electrically conductive electrode member on the insulative layer;

(b) means for pivotally joining said first and second blades together with their respective shearing surfaces facing one another;

(c) means coupled to at least one of said first and second blades for imparting a scissors-like movement relative to the other of said first and second blades; and

(d) means for applying a voltage between said second metal blade and the electrode member of said first metal blade.

Issues

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The junior party has raised the following issues for final decision:

- a) the junior party's deferred motion under 37 CFR § 1.634 to add Mark A. Rydell as a joint inventor to the junior party's involved patent;
- b) the junior party's priority case, particularly the junior party's alleged reduction to practice in December 1991;
- c) the senior party's priority case, specifically the senior party's alleged conception and reduction to practice of the subject matter of the count, and the alleged lack of diligence on the part of the senior party.

The senior party has raised the following issues in the senior party brief at final hearing:

- a) the construction of the language in the count;
- b) the junior party's alleged reduction to practice by non-inventor Rydell, specifically whether the subject matter allegedly reduced to practice was within the scope of the count and was successfully tested;
- c) alleged abandonment, suppression or concealment on the part of the junior party;

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d) the propriety of the junior party's renewed motion to correct inventorship;

e) the junior party entitlement to an award of priority.

Burden of Proof

As the junior party in an interference between co-pending applications, junior party Parins bears the burden of proving priority by a preponderance of the evidence. **See Cooper v. Goldfarb**, 154 F.3d 1321, 1326, 47 USPQ2d 1896, 1900 (Fed. Cir. 1998)(**quoting Scott v. Finney**, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994)).

Interpretation of the Interference Count

The parties have raised the issue of the proper interpretation of the interference count. The proper interpretation of a count is a question of law. **Credle v. Bond**, 25 F.3d 1566, 1571, 30 USPQ2d 1911, 1915 (Fed. Cir. 1994)(**citing Davis v. Loesch**, 998 F.2d 963, 967, 27 USPQ2d 1440, 1444 (Fed. Cir. 1993)). The established standard of

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count interpretation is that interference counts are to be given the broadest interpretation which they will reasonably support. **Mead v. McKirnan**, 585 F.2d 504, 507, 199 USPQ 513, 515-516 (CCPA 1978). Terms in the count are to be given their ordinary and accustomed meaning. **See Johnson Worldwide Assoc. Inc. v. Zebco Corp.**, 175 F.3d 985, 990, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999)(**quoting Renishaw PLC v. Marposs Societa Per Azioni**, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998)). Resort to a specification from which a claim on which the count is based or resort to extrinsic evidence is only appropriate or necessary when an ambiguity exists in the count. If an ambiguity is found, resort may be had to the specification of the patent from which the claims originate to resolve the ambiguity. **See In re Spina**, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992). Determination of the existence of an ambiguity requires consideration of both the language of the count and the reasonableness of the arguments indicating the count has different meanings. **Kroekel v. Shah**, 558 F.2d 29, 31-32, 194 USPQ 544, 546 (CCPA 1977). The mere

fact that the parties ascribe different meanings to a count or that the count is readable on more than one embodiment does not render the count ambiguous. **See id.** at 32, 194 USPQ at 547.

Turning to the specific count at issue, the senior party directs our attention to subparagraph (a) of the count which reads as follows:

(a) first and second metal blades each having a cutting edge and shearing surface, said first metal blade supporting an insulative layer on a surface other than the cutting edge and shearing surface thereof and an electrically conductive electrode member on the insulative layer.

The senior party argues that the count expression "said first metal blade supporting an insulative layer . . . and an electrically conductive electrode member on the insulative layer," requires that the first metal blade be the layer that the other layers are affixed on, with the first metal blade extending back to the means for pivotally joining and carrying the other layers. The junior party argues that the above-referred to language merely requires that the first metal blade supports the other two layers by providing reinforcement or strengthening of the other two layers, as an

additional metal ply applied to the laminate that is the first blade. This additional layer provides support in flexure, according to the junior party.

We have considered the language of the count and the respective arguments of the parties and we are of the view that both ascribed meanings are reasonable. Accordingly, we have reached the conclusion that the count is ambiguous,⁴ and it is appropriate to construe the interference count in view of the specification from which the claim the count is based on originated and, if necessary, extrinsic evidence.⁵

⁴ An additional ambiguity, related to the argued one, is that in subparagraph (a), the term "first . . . metal blade" appears to refer only to the metal layer of the blade, i.e., the first metal blade has an insulative layer and conductive electrode thereon. In subparagraph (d), the electrode is referred to as a part of the first metal blade, "of" rather than "on" the blade.

⁵ Strictly speaking, the count does not correspond exactly to any claim in an application or patent, inasmuch as the count was broadened by motion in the preliminary motion period. The count was broadened to the extent that only one laminated blade is required, rather than "first and second" such blades as claim 1 of the Parins patent recites. Nonetheless, the language at issue, *viz.*, "said first metal blade supporting an insulative layer . . . and an electrically conductive electrode member on the insulative layer," remains unchanged from the Parins patent. It is in this language that we have determined an ambiguity exists.

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When construing the meaning of a claim, we may consider both intrinsic and extrinsic evidence. Intrinsic evidence

consists of the claim itself, the specification, and any prosecution history. Extrinsic evidence includes expert testimony, inventor testimony, dictionaries, treatises, and prior art not cited in the prosecution history. We turn to extrinsic evidence only when the intrinsic evidence is insufficient to establish the clear meaning of the asserted claim. *Zodiac Pool Care Inc. v. Hoffinger Indus. Inc.*, 206 F.3d 1408, 1414, 54 USPQ2d 1141, 1145 (Fed. Cir. 2000). **See generally** *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-84, 39 USPQ2d 1573, 1576-78 (Fed. Cir. 1996).

It is noted that the claims as originally filed in the application Serial No. 08/435,505, which matured into the junior party involved patent, did not include the contested "first metal blade supporting . . ." language. See claim 1 at

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SX-9 p30.⁶ However, as pointed out by the senior party, the specification includes similar language in the description of the prior art. The prior art Rydell Patent No. 5,352,222 is described as having "conductive metal blade supports to which sharpened metal cutting blades are affixed using a nonconductive epoxy bonding and

spacing layer." SX-9 p14. The Rydell invention contrasts to the involved subject matter in that the supporting structure that extends back to the pivot and beyond and to which all layers of the scissors cutting and cauterizing structure are affixed is on the outside of the laminated member. This is opposite the disclosed subject matter of the involved junior party patent wherein the structure that extends back to the pivot for moving the laminated blade is on the inside surface--the surface that contacts the other pivoting or stationary blade

⁶ The Parins record and exhibits are herein abbreviated PR and PX- followed by the appropriate number. Likewise, the Slater record and exhibits are abbreviated SR and SX-.

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for shearing tissue therebetween. Nonetheless, the description of the prior art that refers to the portion of the blade that extends back past the pivot point to the means for imparting movement as the portion of the blade which supports the other laminated layers is some evidence that the senior party's interpretation of the claim, and the count that corresponds exactly thereto, is the construction in agreement with the disclosure. Additionally, when the Parins patent discusses the prior art Rydell patent No. 5,356,408 similar language, i.e., "honed ceramic cutting and shearing surfaces on the opposed interior surfaces of metal blade support members" is used. *Id.* Thus, the specification of the Parins involved patent provides some evidence that the senior party's construction of the count is proper in this instance.

The prosecution history is more probative. As noted above, we may also "consider the patent's prosecution history, if it is in evidence." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995) (in banc), aff'd, 517 U.S. 370, 116 S. Ct. 1384, 1393, 38 USPQ2d 1461 (1996); *Graham v. John Deere Co.*, 383 U.S. 1, 33, 148

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USPQ 459, 473 (1965). This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims. **See Markman**, 52 F.3d at 980, 34 USPQ2d at 1330; **Southwall Tech., Inc. v. Cardinal IG Co.**, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (Fed. Cir.), **cert. denied**, 516 U.S. 987 (1995). ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.") (citations omitted). Included within an analysis of the file history may be an examination of the prior art cited therein. **Autogiro Co. of Am. v. United States**, 384 F.2d 391, 399, 155 USPQ 697, 704 (Ct. Cl. 1967)("In its broader use as source material, the prior art cited in the file wrapper gives clues as to what the claims do not cover."). **Vitronics** at 1583, 39 USPQ2d at 1577.

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As we noted above, the first metal blade supporting language was not present in claim 1 as originally filed. According to the Parins patent file wrapper, this language was added by the examiner in an examiner's amendment at the time of allowance. According to the examiner's interview record summary, Mr. Nikolai approved the addition of the language to clearly define over Rydell. SX-9 at 70. This is further discussed in the examiner's reasons for allowance, which states in its entirety:

3. The following is an Examiner's Statement of Reasons for Allowance: The above amendments have been made to more clearly define the claimed invention over the Rydell (5,352,222) reference which shows metal blade supports acting as electrodes and supporting insulating layers and metal blades. This is in contradistinction to the claimed invention which uses the metal blades to support the insulating layers and electrodes.

SX-9 at 72. The examiner has recognized the structural difference outlined above and clearly states that the claimed invention uses metal blades to support the insulating layer and electrode. If the junior party's construction of the claim were accurate, there would be no sense in which Rydell's electrode layer "supported" the blade, i.e., reinforcing the

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blade in flexure and the Parins device did not. This would render the examiner's statement of a patentable distinction a nullity.

Our clear understanding of the examiner's reason for allowance is that this language was introduced into the claim to avoid the Rydell prior art. We must conclude that any claim construction broader than the one proffered by the senior party was disclaimed during prosecution. **Vitronics** at 1582, 39 USPQ2d at 1576. The prior art Rydell patent is a strong clue as to what the scope of the count covers. **Id.**

Up against the strong intrinsic evidence of file wrapper history, Parins relies on the extrinsic evidence of testimony as to the proper scope of the count. As the case law cited above suggests, extrinsic evidence is only evaluated when intrinsic evidence is insufficient to glean a clear

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meaning of the scope of the claim or count.⁷ That is not the case here.

Accordingly, we have given no consideration to the testimony of Messrs. Rydell and Osborne about the scope and meaning of claim terminology in the Parins patent.⁸

Junior Party Priority Case

Conception has been defined as the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention. **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)).

⁷ We are aware of a line of cases culminating in **Mezrich v. Lee**, 201 USPQ 922 (Bd. Pat. Int. 1978) standing for the proposition that we accord no consideration to the inventor's testimony in answer to questions on direct examination which required any qualification in context of or with reference to the specifications and claims of the respective parties. We leave open the question of whether that proposition is good law, at least with respect to patents, after **Markman**.

⁸ Nor have we given any consideration to the senior party's argument that Osborne's testimony as to the meaning of the "blade supporting" language has changed over time.

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Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation. **Sewall v. Walters**, 21 F.3d 411, 416, 30 USPQ2d 1356, 1359. **See Summers v. Vogel**, 332 F.2d 810, 816, 141 USPQ 816, 821 (CCPA 1964); **In re Tansel**, 253 F.2d 241, 243, 117 USPQ 188, 189 (CCPA 1958). Priority, conception, and reduction to practice are questions of law which are based on subsidiary factual findings. **Cooper v. Goldfarb**, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998).

For evidence of conception, the junior party is relying on work done by Mark A. Rydell at Everest Medical in December 1991. The junior party has also filed a renewed motion⁹ to add Rydell as a named inventor. The motion has been deferred to this final decision.

The record reflects that at least by August 26, 1991, Rydell was at work at Everest on bipolar electrosurgical cauterizing scissors. PR2; PX-2. On December 4, 1991, Rydell recorded details of a new scissors embodiment on page 22 of

⁹ Paper No. 42.

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his notebook. PR3; PX-4. Rydell executed CAD drawings of his new design on the same date. PR4; PX-5.

Our findings with respect to PX-4 follow.¹⁰ The notebook page has three drawings that make up the upper half of the page. The lower left-hand drawing of the three drawings shows the laminated structure of the blade. To the top, representing the outer layer of the blade, is an electrode layer, annotated as of brass, which extends the entire distance rearwardly to join the stainless steel tube that forms the elongate extension of the scissors. The middle layer, as shown in the drawing, is formed of dielectric material --polysulfone-- to insulate the brass electrode layer from a cutting layer. The dielectric also extends rearwardly to the stainless steel tube. The dielectric is fabricated with a deep recess in which the movable blade is mounted. Forming one side of the recess is the cutting layer, annotated as stainless steel. The cutting

¹⁰ As noted *infra*, the actual prototype scissors constructed according to the notebook page 22, PX-4, are of record as PX-10. The structure described in the findings is too small to see in any detail on the prototype.

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layer extends only to the base of the recess in the dielectric layer stopping well short of the stainless steel tube. The exhibit further shows a movable hook-shaped blade which is pivotable with respect to the stationary laminated blade. The hook-shaped blade is actuated by a push rod that extends down the center of the stainless steel tube. A first voltage E_1 is applied to the push rod for conduction to the first blade. A second voltage E_2 is applied to the stainless steel tube to be conducted to the outer brass electrode on the laminated stationary blade. An insulating tube surrounds the push rod to prevent an electrical short circuit from the push rod to the stainless steel tube.

In the time period between December 4, 1991 and December 19, 1991, Rydell built a prototype scissors following the design recorded in PX-4, 5. The prototype is of record as PX-10.¹¹ Between December 4 and December 19, 1991, the scissors was tested on beef liver and beef steak at Everest. PR176. On December 19, 1991, Rydell and Joseph O'Brien tested

¹¹ PX-6, 7 and 8 are photographs of prototype PX-10.

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the prototype on a live dog at the University Of Minnesota Medical School Animal Laboratory. PR-7, 14. PX-9 is Rydell's record of the test. This contemporaneous record states that scissors no. 3 [PX-10, hooked scissors] "still did not cut as good as it should have." PX-9. Rydell states that he was satisfied that the scissors carried out its intended function, even though improvements still had to be made before it would serve as a commercially acceptable scissors. PR7. O'Brien states that the scissors was operated in its normally intended fashion to cut various tissue types in the living dog, and it was able to cut and coagulate tissue and blood vessels. O'Brien further states that the scissors worked well in coagulating blood but that mechanical cutting ability was not on par with conventional laparoscopic scissors. PR14. In O'Brien's interoffice report on the completed dog testing the report stated: "Good coagulation but poor mechanical cut." PX-14.

At the point of the live dog test, the contemporaneous record¹² and the after-the-fact testimony seem

¹² In evaluating whether a particular test constitutes an actual reduction to practice, one factor to be considered is

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to diverge. On the one hand, the written meeting summary by O'Brien explicitly states "poor mechanical cut." After a single test on living tissue, this design was "retired," put away in a box. PR188. No further testing was ever done. PR 187. O'Brien could not recall the PX-10 hook scissors ever being discussed again. PR375. Thus, the contemporaneous record has all the circumstantial earmarks of a failed test, a dead-end design.¹³

To the contrary, the after-the-fact testimony while admitting the design had problems cutting--in some tissue it nibbled rather than actually cut--has both O'Brien and Rydell testifying that the device "worked pretty well," but needed

whether the inventor considered the test to be successful at the time. **Rexroth v. Gunther**, 205 USPQ 666, 673 (Bd. Pat. Int. 1979)(**citing Smith v. Nevin**, 73 F.2d 940, 23 USPQ 353, 357 (CCPA 1934)).

¹³ In the junior party reply brief, there is an argument that development proceeded directly from the PX-10 prototype, i.e., Rydell's testimony that "we learned what we wanted to learn from it." PR190-192. We do not find this testimony inconsistent with a failed prototype that was retired. Testimony with regard to any other prototype based on a similar design is vague and uncorroborated. PR192-93. It has been given no weight.

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some work. PR189. Or the device cut, but was not up to commercial

standards. PR371. In our view, this testimony does not jibe with the explicit evidence of poor mechanical cut recorded in O'Brien's summary of the test.

It is our determination that the contemporaneous report by O'Brien and circumstantial evidence of a failed design are more credible in this context. Actions do, indeed, speak louder than words in this instance. While we would not require the device to cut to commercial standards, we do recognize that such devices are required to cut with literally surgical precision, and more than a mere capacity to nibble away at the tougher tissues of the viscera would be required as evidence of a successful test. Moreover, there is no evidence establishing that to make a laminated blade that would cut with surgical accuracy is a trivial exercise requiring only ordinary skill. In short, we believe our findings with respect to the conflicting evidence regarding the test comport with the conclusion reached by Everest at the

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time of the test. This design was unsuccessful and deserved to be retired.

Legal Conclusion re Junior Party Priority Case

It is our legal determination, based upon the above recited facts, that the conception and testing of the PX-10 device is not a conception or reduction to practice of the subject matter at issue in this interference. We base this conclusion on the fact that the cutting surface or stainless steel insert cannot be said to be "said first metal blade supporting an insulative layer on a surface other than the cutting edge and shearing surface thereof and an electrically conductive electrode member on the insulative layer," as we have construed those terms based on the intrinsic evidence of the prosecution history of the Parins patent. As discussed previously, this language was inserted in Claim 1 of the Parins application to avoid the Rydell prior art patent and resulted in allowance of that application. A broad claim construction as urged by the junior party has been disclaimed

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in prosecution. While we have determined that the PX-10 embodiment is outside the scope of the count, we do acknowledge that the junior party has provided sufficient evidence of conception of that PX-10 hooked scissors embodiment, albeit outside the scope of the count, by at least December 19, 1991, based upon the corroborating evidence from O'Brien.

Secondly, it is our further legal conclusion that the testing of the PX-10 embodiment on the live dog in December 1991 was not a reduction to practice for the additional reason that the testing was unsuccessful. Both the parties and the preamble

to the count agree that the function of the interference subject matter is a dual one. Not only must the device coagulate, but it must cut tissue. We have sifted the conflicting evidence and reached a determination that the test was unsuccessful with regard to cutting ability.

Consequently, we do not credit the junior party with a reduction to practice for this second, additional reason. The testing was unsuccessful.

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Abandonment, Suppression or Concealment by the Junior Party

Although we have determined that the junior party has not established by a preponderance of the evidence that the subject matter of the count was reduced to practice, for the sake of completeness we will consider the question of whether the junior party has abandoned, suppressed, or concealed the invention within the meaning of 35 U.S.C. § 102(g) as argued by the senior party. For purposes of this determination, we must assume, contrary to the evidence, that the junior party actually reduced to practice the subject matter of the count. "[W]ithout an actual reduction to practice there is no invention in existence which can be abandoned, suppressed, or concealed." *Peeler v. Miller*, 535 F.2d 647, 651, 190 USPQ 117, 120 (CCPA 1976).

The question of the loss of a right to a patent due to suppression or concealment arises under 35 U.S.C. § 102(g). The policy behind § 102(g) is to encourage prompt disclosure of the invention to the public by an inventor after he or she has reduced it to practice. The longer the delays, the greater is the risk that he or she will be found to have

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forfeited the right to rely on the date of reduction to practice in an interference with one who independently made the invention and promptly filed a patent application. **See, for example, Horwath v. Lee**, 564 F.2d 948, 195 USPQ 701 (CCPA 1977).

Fact situations surrounding suppression and concealment issues require consideration on a case-by-case basis. **Id.** at 949, 195 USPQ at 703. Among the objective factors to be considered in assessing an alleged instance of abandonment, suppression, or concealment are: 1) the length of the delay period after the reduction to practice but before the filing of an application for patent or commercialization of the invention; **Peeler** at 654, 190 USPQ at 123 (inactivity period of senior party long enough to give rise to an inference of abandonment, suppression, or concealment); 2) the activities pursued by the inventor, his counsel and assignee during the alleged period of abandonment, suppression or concealment; **see, for example, Correge v. Murphy**, 705 F.2d 1326, 217 USPQ 753 (Fed. Cir. 1983)(activities during 17 month period between reduction to practice and filing

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including review in patent department and disclosure of invention to customers; such activities do not support a finding of abandonment, suppression or concealment); and 3) the causative factors for the resumption of activities toward filing an application or commercialization of the invention--so-called "spurring"; **see *Shindelar v. Holdeman***, 628 F.2d 1337, 1342 n.9, 207 USPQ 112, 116 n.9 (CCPA 1980), **cert. denied**, 451 U.S. 984 (1981)(while spurring into filing an application is not essential for finding suppression, that is not to say that the presence of spurring is not relevant to the issue of suppression or concealment). The subjective intent of the inventor is also relevant, but a subjective intent not to abandon the invention cannot overcome strong objective evidence of abandonment, suppression or concealment. **See *Peeler*** at 653, 190 USPQ at 122.

Our findings are as follows: After the living dog test on December 19, 1991, the prototype PX-10 was retired, and as far as O'Brien was aware, the PX-10 hooked scissors were not discussed again. The junior party has been accorded benefit of

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application Serial No. 08/369,379 with its January 6, 1995 filing

date. Thus, the record shows a period of inactivity of a little over 36 months. Under applicable precedent, this time period is sufficient to trigger the inference of abandonment, suppression

or concealment. Accordingly, we hold that the burden has shifted to the junior party to rebut the inference with appropriate evidence.

An inference of suppression or concealment may be overcome with evidence that the reason for the delay was to perfect the invention. *Lutzker v. Plet*, 843 F.2d 1364, 1367,

6 USPQ2d 1370, 1372 (Fed. Cir. 1988) (*citing Dewey v. Lawton*, 347 F.2d 629, 632, 146 USPQ 187, 189-90 (CCPA 1965)), which permitted "testing and refinement" of the invention for more than one year after reduction to practice; and *Schnick v. Fenn*, 227 F.2d 935, 941-42, 125 USPQ 567, 573-74 (CCPA 1960), which permitted a delay of about eleven months after reduction to practice while "continuing 'the development of the best design'" in further perfecting the

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invention. When, however, the delay is caused by working on refinements and improvements which are not reflected in the final patent application, the delay will not be excused. **Id.** (**citing Horwath v. Lee**, 564 F.2d at 952, 195 USPQ at 706). Further, when the activities which cause the delay go to commercialization of the invention, the delay will not be excused. **Id.** (**citing Fitzgerald v. Arbib**, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959)).

The junior party argues that the appropriate time period to consider is from the retirement of the PX-10 embodiment to the filing of the Rydell application Serial No. 08/213,671 that matured into the Rydell Patent No. 5,352,222. This time period is about 25 months.¹⁴ We agree that the structures of the embodiment of PX-10 and the Rydell patent are related in that in the Rydell patent it is the outer

¹⁴ Even if 25 months were the appropriate time period, **see Latimer v. Wetmore**, 231 USPQ 131, 136 (Bd. Pat. App. & Int. 1986)(unexplained hiatus in activity of 25 months enough to raise inference of abandonment, suppression or concealment).

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electrode that provides the support for the insulating and cutting layers. The Rydell patent is the prior art distinguished by the examiner's amendment, as discussed above. Inasmuch as the Rydell patent was determined to be patentably distinct from the claimed subject matter of the Parins application by the examiner at the time of allowance of the Parins application, any work on the Rydell invention would not be reflected in the Parins application. Work on the invention claimed in the Rydell patent, thus, does not excuse some of the delay in filing the Parins application.

The other evidence argued by the junior party is merely several tries and missteps at arriving at a commercial scissors acceptable to surgeons that could be marketed at a suitable cost. Not only is this evidence lacking in relevance to the subject matter at issue, it is almost entirely directed at commercial activities. Activities aimed at commercialization, even if relevant to the subject matter in interference, do not provide an excuse for delay. *Id.*

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As noted above, it is our determination that the December, 1991 work by Rydell was not a reduction to practice of the subject matter of the interference. Additionally, we have determined that if the work by Rydell can be considered to have been a reduction to practice, the junior party has not provided evidence to rebut the inference of abandonment, suppression or concealment raised by the substantial time period between the reduction to practice and the filing of the benefit application.

The Parins reply brief has a section discussing supposed public policy principles and equity. It must be noted that Slater as senior party does not have any burden of proof, at least until Parins can overcome Slater's effective filing date. Unless Parins can overcome the effective filing date, any action or inaction by Slater is simply immaterial. Slater has nothing to prove.

Estoppel Argument

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The junior party briefs also raise an argument based on the concession of priority by the senior party in another interference between the parties of interest in this interference. The interference was Interference No. 103,765 between Rydell and senior party Slater. It is axiomatic that the subject matter of the other interference is patentably distinct from the subject matter at issue in this final decision. Thus, any decision in the other interference respecting priority lacks common subject matter and common parties. In our view, it is simply immaterial to the subject matter at issue in this interference.

Furthermore, in the junior party's main brief, there is not even an explanation or theory of why the concession raises the issue of estoppel. We are presented with merely the charge that the senior party is estopped to argue abandonment, suppression or concealment. We consider this estoppel argument part of the junior party's case in chief. See 37 CFR § 1.656(b)(6). Failure to provide a theory or explanation disadvantages a senior party that can only guess as to what argument to respond to. Accordingly, we hold that the junior party is barred on procedural grounds from raising

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the estoppel argument, an explanation of which is only found in the reply brief.

Decision on Motion Under 37 CFR § 1.634

Parins' renewed motion to add Rydell as an additional inventor in the involved Parins patent has been deferred to this final decision. Slater has opposed on two grounds, *viz.*, the invention of Rydell in December 1991 is not within the scope of the count, and there was no collaboration, whatsoever, between Parins and Poppe on the one hand and Rydell on the other.

As has already been determined with respect to conception and reduction to practice, it was our conclusion that the subject matter invented by Rydell in December 1991 was not within the scope of the count in interference. This determination alone is enough for us to deny the motion.

We, herein, further determine that Slater's second opposition to the motion also has merit. Parins argues in the junior party's main brief that different claims can have different inventive entities. We agree. However, in the

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instant case it is the same subject matter that is claimed to have been conceived by both Parins and Rydell at separate times with no recollection on the part of Parins of another's work.

For persons to be joint inventors under Section 116, there must be some element of joint behavior, such as collaboration or working under common direction, one inventor seeing a relevant report and building upon it or hearing another's suggestion at a meeting Individuals cannot be joint inventors if they are completely ignorant of what each other has done until years after their individual independent efforts. They cannot be totally independent of each other and be joint inventors.

We therefore hold that joint inventorship under Section 116 requires at least some quantum of collaboration or connection.

Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co., 973 F.2d

911, 917, 23 USPQ2d 1921, 1926 (Fed. Cir. 1992).

Parins' testimony includes a definitive statement by him that he conceived of the subject matter in November 1994. PR19. Rydell had left Everest in late 1993 and did not consult on bipolar scissors thereafter. PR130. The Junior party

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briefs understandably fail to point to any collaboration or connection between the alleged joint inventors. Instead the junior party relies only on acts by Rydell, and then, much later after Rydell had left Everest's employ, independent acts by Parins and Poppe. As such, the junior party has not shown any collaboration by a preponderance of the evidence.^{15, 16}

The junior party has failed under 37 CFR § 1.637(a) to establish that it is, in fact, entitled to the relief requested in the motion to correct inventorship. The motion is **DENIED**.

Senior Party Priority

¹⁵ The junior party argument appears to be based partly on the fact that Parins was an addressee on summary memos written by O'Brien in 1991. This argument smacks of an argument grounded on subliminal or subconscious copying as seen in copyright cases.

¹⁶ The junior party reply brief states that Parins attended meetings at which the hook scissors were discussed relying on PX-13 and 14. The testimony is clear that Parins was merely an addressee of the memos, and his attendance cannot be assumed. O'Brien: "His name is on the memo, but that doesn't necessarily mean that he was there." PR361. The reference to Parins cutting beefsteak with PX-10 at Everest before December 19, 1991 is speculative. PR177.

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As noted above, we have determined that the invention developed and tested by Rydell at Everest in December 1991 was not within the scope of the count and was not reduced to practice due to failed testing. If the invention were to have been reduced to practice and within the scope of the count it was abandoned, suppressed or concealed. The Parins motion under 37 CFR § 1.634 has been denied. Consequently, the junior party has not antedated the senior party's effective filing date. It is unnecessary for us to consider any priority evidence on the part of the senior party. We will enter judgment, hereinbelow, in favor of senior party Slater.

Judgment

Judgment in Interference No. 104,190 is entered in favor of Charles R. Slater, the senior party. Charles R. Slater

is entitled to a patent containing claims 40-54, which claims correspond to the count in interference. Judgment is entered against David J. Parins and Richard K. Poppe, the junior

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party. David J. Parins and Richard K. Poppe are not entitled to their patent containing claims 1-12 which claims correspond to the count in interference.

	IAN A. CALVERT)	
	Administrative Patent Judge)	
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	WILLIAM F. PATE, III)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	ADRIENE LEPIANE HANLON)	
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WFP:psb

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