

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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(2) is not binding precedent of the Board.

Paper No. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GUNSANG LIM,
RICHARD D. MAROWSKY and BEN KHOSHNOOD

Junior Party,¹

v.

JACK E. CAVENEY,
CHRISTOPHER J. HAYES, JOSEPH RINCHIUSO, ANDREW J. STROEDE
and
DONALD C. WIENCEK

Senior Party,²

¹ Patent 5,454,738, granted October 3, 1995, based on Application 08/248,997, filed May 25, 1994. Accorded the benefit of Application 08/132,015, filed October 5, 1993, now U.S. Patent 5,470,244, granted November 28, 1995. Assignor to Thomas-Betts Corporation.

² Application 08/724,365, filed October 1, 1996. Assignor to Panduit Corporation.

Interference No. 103,987

Patent Interference No. 103,987

FINAL HEARING: June 1, 2000

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

FINAL DECISION UNDER 37 CFR § 1.658

This is a decision after final hearing in Interference No. 103,987. The junior party involved patent is U.S. Patent No. 5,454,738 in the name of Gunsang Lim *et al.*³ The senior party involved application is Serial No. 08/724,365 to Jack E. Caveney *et al.* The real parties-in-interest are Thomas-Betts Corporation and Panduit Corporation, respectively.

The subject matter of the interference pertains to an RJ-45 wire connector for streaming computer data with

³ The parties will henceforth be referred to in the singular.

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improved near end crosstalk performance. The improved crosstalk performance is obtained by providing a conductive trace disposed in spatial registry with one of the connector contacts so as to generate mutual inductance and capacitance in the trace and the contact.

The interference count reads as follows:

Count 1

An electrical connector comprising:

an insulative housing;

a plurality of elongate electrical contacts supported on said housing, said contacts being disposed in a mutually spaced side-by-side arrangement;

a dielectric substrate overlying said contacts;

a conductive trace having an extent supported by said dielectric substrate, said trace being disposed in spatial registry with a longitudinal portion of one of said contacts and being of configuration to define with said one contact and with the permeability and the dielectric constant of said dielectric substrate a predetermined mutual inductance and capacitance.

The claims of the parties that correspond to the count

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are:

Lim *et al.* Claims 1-9 and 11-15

Caveney *et al.* Claims 78-86 and 88-92

Background

Interference No. 103,987 was declared on November 4, 1997 with a time period for filing preliminary motions and preliminary statements set to end on February 18, 1998. In a decision on preliminary motions entered on September 30, 1998, the Administrative Patent Judge (APJ), *inter alia*, added another count, count 2, to the interference and added another Lim patent

to the interference as corresponding to the additional count 2. The APJ also placed junior party Lim under an order to show cause pursuant to 37 CFR § 1.640(d)(3) for failure to overcome the senior party's filing date in its preliminary statement.

In response to the addition of the second Lim patent to the interference, Lim requested reconsideration. After allowing the parties to fully brief the issue, the APJ

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rendered a decision on May 21, 1999 favorable to Lim and removed the second Lim patent from the interference in favor of an additional interference where count 2 is the count in the additional interference. Additionally, the APJ again placed junior party Lim under an order to show cause under 37 CFR § 1.640(d)(3) but only for the original count 1, now the sole count in the instant interference. In response to the order to show cause, Lim filed a belated motion for judgment under 37 CFR § 1.633(a) that all claims of the Caveney application are unpatentable to Caveney under 35 U.S.C. § 112, first paragraph. Lim also filed a motion under 37 CFR §§ 1.635 and 1.645 requesting that this belated motion for judgment be considered. As a showing of good cause, Lim cited ***Gentry Gallery v. Berkline Corp.***, 134 F.3d 1473, 48 USPQ2d 1498 (Fed. Cir. 1998). This decision, dated January 27, 1998, is argued by Lim as representing a substantive change in the law that was not recognized as such until well after the end of the preliminary motion period.

The APJ deferred these two motions, the belated motion for judgment and the motion for consideration of the

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belated motion, to final hearing. They are the only issues argued at this final hearing.

Motion under 37 CFR §§ 1.635 and 1.645

Junior party Lim's belated motion for judgment was filed on July 19, 1999. This was approximately 17 months after the time for filing preliminary motions closed and approximately 18 months after the decision in the **Gentry** case was available on January 27, 1998. Thus, Lim's motion for judgment was belatedly filed. 37 CFR § 1.645 provides that:

Any paper belatedly filed will not be considered except upon notion [sic] (§ 1.635) which shows good cause why the paper was not timely filed

Thus, a prerequisite for our consideration of Lim's motion for judgment is a showing of good cause for belatedness on the part of junior party Lim. Lim's argument respecting good cause has two parts. The first part is an argument that the decision in **Gentry** represented a substantive shift in patent law with respect to descriptive support for the claimed subject

matter under section 112, first paragraph. The second part of Lim's showing is that it has understandably taken the courts and the bar some time to come to recognize the true significance of the analysis as set forth in **Gentry**. This period of time, the argument goes, should excuse the junior party's delay in filing the motion for judgment.

In the second part of this opinion, we do not find it necessary to decide whether **Gentry** is a substantive departure in the law regarding the written description requirement, since we are of the view that the facts in this interference and the **Gentry** case, as explained hereinbelow, are entirely different.⁴ Therefore, if we assume for the purpose of the motion under 37 CFR § 1.645 that Gentry did effect a substantive change in the law, is some period of

⁴ Additionally, it is apparent that the Federal Circuit is taking pains to emphasize that **Gentry** fits within the legal framework of the existing law on descriptive support. **See Reiffen v. Microsoft Corp.**, Case No. 098-1502, decided June 5, 2000, wherein the majority opinion discusses written description with respect to prior case law, and the concurring opinion carefully places **Gentry** in the context of this law.

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delay reasonable, based on the time it takes the courts and the bar to recognize and act on the change?

In support of this proposition Lim cites **Anderson v. Natta**, 480 F.2d 1392, 178 USPQ 458 (CCPA 1973), a case in which

the CCPA determined that it was unreasonable for the Board of Interferences to refuse to consider an argument raised at final hearing that was not earlier raised by a motion.

Between the motion period and the decision, the Supreme Court had decided **Brenner v. Manson**, 383 U.S. 519, 148 USPQ 689 (1966). In its comment on the Board's opinion, the Court stated:

We think it sufficient to recognize that at the very least the **Manson** opinion was an important clarification of the law of utility which brought into focus particular considerations regarded by the Supreme Court as of paramount importance in ascertaining utility within the meaning of the statute. The decision of the Supreme Court in **Manson** was, in our opinion, good reason to excuse the failure of Natta to present a motion during the motion period. While the board correctly observed that

Natta could have filed a belated motion, we do not think the failure to do that justifies refusal to hear the issue at final hearing where Rule 258 permitted consideration. We think it not unreasonable for Natta to elect, when **Manson** appeared, to wait for final hearing and attempt to argue the "good reason" exception of Rule 258 [**Anderson**, 480 F.2d at 1398, 178 USPQ at 462].

Therefore, based on this CCPA opinion, we are of the view that it is a reasonable argument that a change in the case law is proper grounds for a belated motion in an interference. However, we view the over 17 month delay as unduly long, based on the facts of the instant case. In arguing that the courts have

recognized that **Gentry** is a case of major significance, Lim admits that Judge Walker named the **Gentry** inquiry the "omitted element test" and applied **Gentry** to invalidate a patent in a decision⁵ dated **less than six months** after the **Gentry** decision. Presumably, Judge Walker and Microsoft's counsel had

⁵ Judge Walker presided in **Reiffin v. Microsoft Corp.**, 48 USPQ2d 1274 (N.D. Ca. 1998). This case was decided July 10, 1998.

enough time to digest and act on the **Gentry** decision in this less than six month period. Based on this fact, we hold that the reasonable amount of time to be excused based on the novelty of the **Gentry** opinion is approximately the time necessary for the district courts to start to use the **Gentry** case in decisions or just after the first district court case appeared relying on the **Gentry** holding. Therefore, the maximum amount of time creditable to Lim based on the perceived change in law is approximately six months. This amount of time is far short of the time that must be excused for Lim's motion under 37 CFR § 1.645 to prevail.⁶ Therefore, Lim's miscellaneous motion under 37 CFR § 1.645 for

⁶ The amount of time excused is so much shorter than the time it actually took junior party Lim's counsel to file the motion, we must, under our precedent, presume the additional delay was the result of a change in strategy, opinion, or purpose, which does not constitute good cause for excusing the belatedness of a motion. See 2 Rivise and Caesar, *Interference Law and Practice*, Section 270, The Michie Co. 1943; **Suh v. Hoefle**, 23 USPQ2d 1321 (Bd. Pat. App. & Int. 1991).

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consideration of the belatedly filed motion for judgment is DENIED.

Motion under 37 CFR § 1.633(a)

Normally, since the miscellaneous motion for consideration of the belated motion for judgment has been denied, we would simply dismiss the belated motion for judgment. However, in this instance, the impact of the **Gentry** decision on the senior party's claims has been fully briefed. Accordingly, for completeness, we will consider the junior party's motion for judgment. Additionally, our comments on the motion for judgment shall serve as guidance to the APJ in deciding the motions in the second interference.⁷

By way of background, Caveney discloses in his specification the embodiment that provides a conductive trace for reducing crosstalk for each adjacent signal pair of

⁷ Caveney is involved in the second interference with the same application, which necessarily has the same disclosure in question here.

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contacts in the RJ-45 connector (eight contacts--four contact pairs--four conductive traces). Caveney's independent claim which corresponds exactly to the count is significantly broader. It merely requires "a conductive trace" Lim's argument is that while Caveney's specification provides support for having a trace for each adjacent signal pair, the Caveney specification does not provide support for having fewer conductive traces than signal pairs or a single conductive trace per connector.

As explained above, we need not reach the issue of whether **Gentry** created a substantive change in the law respecting descriptive support under 35 U.S.C. § 112, first paragraph. In our view, the facts of this case are entirely different from the facts in **Gentry**.

Gentry was a case involving multiple reclining chairs or sofas wherein the reclining control means was placed on an attached console. In **Gentry**, the court made a specific factual finding that "the original disclosure clearly identifies the console as the **only possible** location for the

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controls" (emphasis supplied). **Gentry**, 134 F.3d at 1479, 45 USPQ2d at 1503. The

court further found that "the disclosure **is limited to** sofas in which the recliner control is located on the console" (emphasis supplied). **Id.** In the instant case, there is no disclosure specifically limiting Caveney to any particular number of conductive traces. Lim cannot point to any disclosure that all traces are "essential," or that one trace per signal pair is "the only possible" embodiment, or that "the disclosure is limited to" one trace for each signal pair. This fact alone takes the instant case out of the purview of **Gentry**.

Additionally, it is our finding that the Caveney disclosure has **ipsis verbis** support for a connector with a single trace. In the Caveney Summary of Invention (CX-2001 at 2),⁸ it is stated that the Caveney capacitive label "capacitively couple[s] a first contact of one contact pair to

⁸ Caveney Exhibits are abbreviated CX- followed by the appropriate exhibit number and page.

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a second contact of a second contact pair.” This portion of the disclosure represents express support for the questioned limitation of Caveney’s independent claim that corresponds exactly to the count. This fact, by itself, would mandate a result different from the result in **Gentry**.

Furthermore, Caveney’s originally filed independent claim refers expressly to “a capacitor for capacitively coupling a first contact of one contact pair to a second contact of a second contact pair.” CX-2001 at 23. The court in **Gentry** specifically noted that the broadest original claim of Sproule, Gentry’s inventor, was of narrower scope than the amended claim asserted against Berkline, the alleged infringer, at trial. In the instant case, the originally filed claim is of similar scope to the involved claim that corresponds exactly to the count. Here again, this fact compels the opposite outcome from the holding in the **Gentry** decision.

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In summary, whether or not **Gentry** marks a change of substance in the law of descriptive support under section 112, first paragraph, the facts of the instant case are so markedly different from **Gentry**, that any holding in that case is far from applicable here. As noted above, while the motion for judgment based on patentability has been discussed, the motion stands **DISMISSED** for failure to be timely filed.

Judgment

Judgment in Interference No. 103,987 is entered against Gunsang Lim, Richard D. Marowsky, and Ben Khoshnood, the

junior party, on the ground of priority of invention. Gunsang Lim, Richard D. Marowsky, and Ben Khoshnood are not entitled to their patent containing claims 1-9 and 11-15, which claims correspond to the count in interference. Judgment is entered in favor of Jack E. Caveney, Christopher J. Hayes, Joseph Rinchiuso, Andrew J. Stroede, and Donald C. Wiencek, the senior party. James E. Caveney, Christopher J. Hayes, Joseph

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Rinchiuso, Andrew J. Stroede, and Donald C. Wiencek are entitled to a patent containing claims 78-86 and 88-92, which claims are designated as corresponding to the count in interference.

	IAN A. CALVERT)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	WILLIAM F. PATE, III)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	ADRIENE LEPIANE HANLON)	
	Administrative Patent Judge)	

WFP:psb

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