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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RYAN A. JURGENSON and LLOYD C. GOSS

Junior Party
(Patent 5,657,188),

v.

JOHN CHARLES DUNFIELD and GUNTER KARL HEINE

Senior Party
(Application 09/160,593).

Patent Interference No. 104,530

Before LEE, SPIEGEL and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTIONS AND JUDGMENT

A. Introduction

This interference was declared on 30 May 2000. A hearing on preliminary motions was held on 20 April 2001. Jurgenson has filed a preliminary motion 1 under 37 CFR § 1.633(a) for judgment against Dunfield on the ground that Dunfield involved claims 40

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and 41 are unpatentable under 35 U.S.C. § 135(b) (Paper 60).

Jurgenson has filed a preliminary motion 2 under 37 CFR § 1.633(b) on the ground that there is no interference-in-fact, which is contingent on its preliminary motion 1 (Paper 61).

Dunfield has filed a preliminary motion 3 to add claims 42-46 to Dunfield's involved application (Paper 22). In Dunfield preliminary motion 2, Dunfield moves to add counts 3, 4 and 5 and to designate certain ones of Jurgenson's claims and Dunfield claims 42-46 as corresponding to proposed counts 3-5 (Paper 21). Dunfield has filed a preliminary motion 4 to be accorded the benefit of its earlier filed application 08/438,091 contingent upon adding proposed counts 3-5 (Paper 23).

Additionally, Dunfield seeks to designate several Jurgenson claims as corresponding to the count, while seeking to have several of those claims held to be unpatentable as follows:

1) Dunfield preliminary motion 1 under 37 CFR § 1.633(c)(3) to designate Jurgenson claims 5-16 and 18 as corresponding to count 2, or alternatively to designate Jurgenson claims 5-16 and 18 as corresponding to proposed counts 3-5;

2) Dunfield preliminary motion 5 under 37 CFR § 1.633(a) for judgment against Jurgenson on the grounds that Jurgenson claims 8 and 11-13 are unpatentable under 35 U.S.C. § 112, first paragraph;

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3) Dunfield preliminary motion 6 under 37 CFR § 1.633(a) for judgment against Jurgenson on the grounds that Jurgenson claims 7-16 are unpatentable under 35 U.S.C. § 112, second paragraph;

4) Dunfield preliminary motion 7 under 37 CFR § 1.633(c)(1) to drop count 2 and designate all claims as corresponding to count 1;

5) Dunfield miscellaneous motion 8 under 37 CFR § 1.635 to file belated preliminary motion 9; and

6) Dunfield preliminary motion 9 under 37 CFR § 1.635(c)(3) to designate Jurgenson claims 6, 15, and 18 as corresponding to count 1.

Upon reviewing the parties preliminary motions and after oral argument, the panel issued an order requesting the parties to provide comments regarding two issues (Paper 83). The two issues are as follows:

(1) whether Dunfield's claims 1, 2, 9, and 11 from its parent application (08/438,091) are to the same or substantially the same subject matter as Dunfield's involved claims 40 and 41; and

(2) whether a decision on the remaining preliminary motions is necessary if it is determined that Dunfield's claims 40 and 41 are barred under 35 U.S.C. § 135(b).

Each party filed a brief regarding issue 1 and a separate brief regarding issue 2. Each party filed a response regarding issue 1 and a separate response regarding issue 2.

B. Findings of Fact

Background

1. Jurgenson is involved on the basis of Patent 5,657,188, granted 12 August 1997, based on application 08/457,432, filed 1 June 1995.

2. Dunfield is involved on the basis of application 09/160,593, filed 25 September 1998.

3. Dunfield has been accorded benefit for the purpose of priority of application 08/438,091, filed 8 May 1995¹.

4. The interfering subject matter pertains to a disk drive suspension with a microactuator positioned on a rigid region of a load beam.

5. Count 1 of the interference is as follows:

Claim 40 of Dunfield

or

Claim 1 of Jurgenson

6. Dunfield claim 40 is as follows:

A disc drive suspension, including:

¹ Dunfield's involved application is a continuation of the 08/438,091 application.

- an actuator arm having a proximal end and a distal end;
- a mounting region on the proximal end of the actuator arm;
- a rigid load beam integral with the distal end of the actuator arm, the rigid load beam having a gimbal support end;
- a gimbal coupled to the gimbal support end of the rigid load beam;
- an air bearing coupled to the gimbal, the air bearing being configured for receiving and supporting a read/write head; and
- a microactuator mounted on the gimbal support end of the rigid load beam but not on the gimbal and coupled to the air bearing, the microactuator being responsive to tracking control signals for finely positioning the read/write head relative to the surface of the disk and to the rigid load beam.

7. Jurgenson claim 1 is as follows:

- A disk drive suspension, including:
 - a load beam having a rigid region, proximal and distal ends, and a spring region between the proximal end and the rigid region;
 - a mounting region on the proximal end of the load beam;
 - a flexure on the distal end of the load beam, the flexure configured for receiving and supporting a read/write head; and
 - a microactuator on the rigid region of the load beam, the microactuator responsive to tracking control signals for moving the flexure along a tracking axis with respect to the rigid region.

8. Count 2 of the interference is as follows:

Claim 41 of Dunfield

or

Claim 17 of Jurgenson

9. Dunfield claim 41 is as follows:

A magnetic disk drive suspension, including:

an actuator arm having a proximal and a distal end;

a mounting region on the proximal end of the actuator arm;

a rigid load beam integral with the distal end of the actuator arm;

a gimbal coupled to the rigid load beam;

an air bearing coupled to the gimbal, the air bearing being configured for receiving a read/write head; and

an electromagnetic microactuator including at least two coils mounted on the rigid load beam but not on the gimbal and coupled to the air bearing, the coils generating magnetic fields in response to tracking control signals and finely positioning the air bearing relative to the rigid load beam and to a track on a disk.

10. Jurgenson claim 17 is as follows:

A magnetic disk drive suspension, including:

a load beam having a rigid region, proximal and distal ends, and a spring region between the proximal end and the rigid region;

a mounting region on the proximal end of the load beam;

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a flexure at a distal end of the rigid region of the load beam, the flexure configured for receiving and supporting a magnetic read/write head; and

an electromagnetic microactuator including at least two coils on the rigid region of the load beam, the coils generating magnetic fields in response to tracking control signals and causing the flexure to move along a tracking axis with respect to the rigid region.

11. The following claims were originally designated as corresponding to count 1:

Jurgenson:	1 and 2
Dunfield:	40

12. The following claims were originally designated as not corresponding to count 1:

Jurgenson:	3-18
Dunfield:	41

13. The following claims were originally designated as corresponding to count 2:

Jurgenson:	3, 4 and 17
Dunfield:	41

14. The following claims were originally designated as not corresponding to count 2:

Jurgenson:	1, 2, 5-16 and 18
Dunfield:	40

The interfering subject matter

15. Jurgenson claims 1 and 17 recite a load beam with a mounting region, a spring region, and a rigid region.

16. Jurgenson claims 1 and 17 further recite that a microactuator is on the rigid region.

17. Dunfield claims 40 and 41 do not recite a load beam with a mounting region, a spring region, or a rigid region.

18. Dunfield claims 40 and 41 recite a rigid load beam.

19. Dunfield claims 40 and 41 recite a microactuator mounted on the rigid load beam.

20. In a statement recommending an interference, the examiner explained the difference between Dunfield's claims 40 and 41 and Jurgenson's claims 1 and 17 regarding the load beam as follows:

"[W]ith regard to the load beam, the conventional construction of a load beam, which has been stated on lines 2-5 of Claim 1 [Jurgenson patent], provides that the load beam includes, inter alia, a 'proximal end' [mounting region] (used to mount the load beam to the actuator arm); a 'spring region' which allows the 'distal end' and the 'rigid region' to move relative to the 'mounting region' of the load beam; and the 'rigid region' which can vary in shape and size but constitutes a more/less inflexible structure connecting the gimbal or flexure to the spring region. See Frater ... spring region 124; rigid region between flanges 120, mounting region 100. Note; the feature or region to which "rigid load beam" referred to in Cl. 40, line 4, of [Dunfield's involved claim 40] is in fact the rigid region of the load beam." (Dunfield Ex. 1020 at 3-4). (Emphasis added).

21. The examiner in interpreting Dunfield's involved claims, determined that the "rigid load beam" is the same as the "rigid region" of the load beam.

22. Apparently then, the examiner interprets Dunfield's claims to mean that a microactuator on the "rigid load beam" is the same as a microactuator on a particular region of a load beam, e.g. on the rigid region of the load beam.

23. Neither party disputes that Dunfield's microactuator on the "rigid load beam" means a microactuator on a particular region of a load beam, e.g. on the rigid region of the load beam (Paper 36 at 12-14; Paper 84 at 4; Paper 86 at 1; Paper 86 at 5; Paper 88 at 2).

24. The examiner further determined that the patentable feature of the involved claims was that the microactuator is on the rigid region of the load beam. (Dunfield Ex. 1020 at 1 and 4).

25. Jurgenson argues that the microactuator on the rigid load beam, e.g. on the rigid region of the load beam is a material limitation (Paper 86 at 10).

26. Jurgenson argues that the limitation is a material one, since during prosecution of Jurgenson's claims 1 and 17, the examiner did not allow the claims until the claims were amended to add the limitation that the microactuator is

located on the rigid region of the load beam (Paper 86 at 10-11).

27. Dunfield does not dispute that the microactuator located on the rigid region of the load beam is a material limitation.

28. The parties agree that there are generally three regions that comprise a load beam: (1) the rigid region; (2) the mounting region; and (3) the spring region (Paper 84 at 6 and Paper 86 at 6).

The Panels Order

29. Oral argument on preliminary motions was held April 20, 2001.

30. On May 14, 2001, an order was issued, inviting the parties to provide comments regarding two issues (Paper 83).

31. The first issue is whether Dunfield's claims 1, 2, 9, and 11 from its parent application (08/438,091) are to the same or substantially the same subject matter as Dunfield's involved claims 40 and 41.

32. The second issue is whether a decision on the remaining preliminary motions is necessary if it is determined that Dunfield's claims 40 and 41 are barred under 35 U.S.C. § 135(b).

Dunfield's claims

33. Dunfield claim 40 and claim 41 were presented in an amendment filed 29 April 1999 more than a year after the 12 August 1997 issue date of the Jurgenson patent.

34. Dunfield claim 40 and claim 41 were amended to their current form in a paper filed 30 August 1999.

35. Dunfield claims 34 and 35 were the predecessor claims to Dunfield claims 40 and 41.

36. Dunfield claims 34 and 35 were made September 25, 1998, more than a year after the 12 August 1997 issue date of the Jurgenson patent.

37. Dunfield claims 1, 2, 9 and 11 of its parent application (08/438,091) were made prior to the 12 August 1997 issue date of the Jurgenson patent.

38. During ex parte prosecution, Dunfield represented to the examiner that its earlier filed claims 1, 2, 9, and 11 were directed to the same or substantially the same subject matter as recited in Jurgenson's claims (Jurgenson Ex. 2010 at 322-323).

39. Dunfield claim 1 of Dunfield's parent application is as follows:

An apparatus in a disc drive for positioning a transducer relative to a magnetic disc, the magnetic disc

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having a surface and a track on the surface, the apparatus comprising:

a rotary actuator;

an actuator arm coupled to the rotary actuator;

a load beam coupled to the actuator arm;

a suspension coupled to the load beam;

an air bearing coupled to the suspension;

a transducer coupled to the air bearing and positioned to access the surface of the disc, the transducer having a pair of spaced disc accessing elements;

a second actuator operably coupled to the air bearing and the load beam and being controllable to move the air bearing relative to the surface of the disc and relative to the load beam; and

a controller coupled to the second actuator to reposition the transducer to align one of the pair of spaced disc accessing elements with the track on the surface of the disc, the controller varying an amount by which the transducer is repositioned based on a radial position of the track on the surface of the disc and based on spacing between the disc accessing elements on the transducer.

40. Dunfield claim 2 is as follows:

An actuator arm assembly in a disc drive, the disc drive having a disc with a surface for storing information, and a first actuator for moving the actuator arm assembly relative to the surface of the disc, the actuator arm assembly comprising:

an actuator arm coupled to the first actuator;

a load beam coupled to the actuator arm;

a suspension coupled to the load beam;

an air bearing coupled to the suspension;

a transducer coupled to the air bearing and positioned to access the surface of the disc the transducer having a pair of spaced disc accessing elements; and

a second actuator operably coupled to the air bearing and the load beam and being controllable to move the air bearing relative to the surface of the disc, wherein the second actuator is configured to be controlled between read and write operations to move the air bearing relative to the surface of the disc to align one of the pair of spaced disc accessing elements with a track on the surface of the disc.

41. Dunfield claim 9 is as follows:

The actuator arm assembly of claim 8² wherein the electromagnetic microactuator comprises:

a first polepiece coupled to the load beam;

a first conductive coil disposed about the first pole piece;

a first interactive element operably coupled to the air bearing; and

wherein current controllably provided through the first coil causes movement of the first interactive element relative to the first pole piece.

42. Dunfield claim 11 is as follows:

The actuator arm assembly of claim 9 and further comprising:

a second pole piece coupled to the load beam;

a second coil disposed about the second pole piece;

² Claim 8 recites:

The actuator arm assembly of claim 2 wherein the second actuator comprises:

an electromagnetic microactuator.

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a second interactive element operably coupled to the air bearing; and

wherein current controllably provided to the second coil tends to cause movement of the second interactive element relative to the second pole piece.

43. None of Dunfield claims 1, 2, 9 or 11, either alone or in combination, explicitly recite a microactuator on a rigid region of a load beam, or a microactuator on the rigid load beam as recited in Jurgenson's involved claims or Dunfield's involved claims.

Jurgenson preliminary motion 1 and brief
regarding issue 1

44. Jurgenson argues that Dunfield claim 40 and claim 41 are barred under 35 U.S.C. § 135(b) since the subject matter of claim 40 and claim 41 was not made within one year of the issue date of the involved Jurgenson patent.

45. It is not disputed, for the purpose of Jurgenson preliminary motion 1, that Dunfield claims 40 and 41 are directed to the same or substantially the same subject matter as Jurgenson's involved patent claims³ (Paper 60 at 12 and Paper 36 at 7-8).

³ During oral argument, counsel for Jurgenson indicated that Dunfield claim 40 and claim 41 are directed to the same or substantially the same subject matter as Jurgenson's involved claims, e.g. claim 1 and claim 17 for purposes of its preliminary motion 1.

46. Jurgenson asserts that Dunfield claims 1, 2, 9 and 11 of Dunfield's parent application are not directed to the same or substantially the same subject matter as recited in Jurgenson's claims or as recited in Dunfield's involved claims (Paper 60 at 15 and Paper 86 at 1).

Dunfield's Opposition and Brief Regarding Issue 1

47. In its opposition to Jurgenson's preliminary motion 1, Dunfield argues that Jurgenson failed to meet its burden of proof, since Jurgenson compared Dunfield's earlier claims with Jurgenson's involved claims.

48. Dunfield argues that Jurgenson should have compared Dunfield's earlier claims with Dunfield's involved claims (Paper 36 at 8).

49. Dunfield, in its brief regarding issue 1, argues that its earlier claims 1, 2, 9 and 11 of its parent application "implicitly" require mounting the microactuator on the rigid region of the load beam (Paper 84 at 5 and Paper 88 at 3).

C. Discussion

Jurgenson moves under 37 CFR § 1.633(a) for judgment against Dunfield on the ground that Dunfield claims 40 and 41, corresponding to Counts 1 and 2 respectively, are unpatentable under 35 U.S.C. § 135(b).

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Section 135(b) of Title 35 states:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

This statute bars the declaration of an interference under § 135(a) unless the claim is copied within one year of the issuance of a patent to another. In re McGrew, 120 F.3d 1236, 1237, 43 USPQ2d 1632, 1634 (Fed. Cir. 1997) (§ 135(b) is a statute of repose so that patentee is secure in his property right).

There is a dispute as to whether Jurgenson, as the moving party, must compare Dunfield's involved claims with Dunfield's earlier claims, or whether Jurgenson must compare Jurgenson's involved claims with Dunfield's earlier claims (Findings 47-48). It is not necessary for us to determine which comparison is correct. Both Jurgenson's involved claims and Dunfield's involved claims include a microactuator on a rigid region of a load beam (Findings 20-23). Thus, the issue is whether Dunfield's earlier claims include a microactuator on a particular region of a load beam, i.e. on the rigid region of a load beam.

Dunfield argues that Jurgenson has failed to satisfy its burden of demonstrating that Dunfield's involved claims are barred under 35 U.S.C. § 135(b). Dunfield argues that since the examiner determined that Dunfield's claims 40 and 41 are patentable under 35 U.S.C. § 135(b), then Jurgenson has a "particularly heavy burden" to establish that Dunfield's claims 40 and 41 are unpatentable under 35 U.S.C. § 135(b) (Paper 88 at 1). Dunfield's argument is misplaced. An examiner's decision made during ex parte prosecution of an involved application is not binding on the Board, and certainly does not raise the moving party's burden of proof. See Glaxo Wellcome, Inc. v. Cabilly, 56 USPQ2d 1983, 1984 (Bd. Pat. App. & Int. 2000) (Trial Section). (Neither the Board nor a party are bound by an ex parte decision made during prosecution by another party. A motion in an interference is not an appeal from the examiner's decision, but an independent request to the Board).

Additionally, Dunfield argues that Jurgenson has failed to satisfy its burden of proof, since Jurgenson relies on attorney argument in support of its position (Paper 88 at 6). Jurgenson, in both its preliminary motion 1 and in its brief addressing issue 1, sufficiently demonstrates that Dunfield's earlier claims do not recite a material limitation of the

interfering subject matter. It is facially apparent that the limitation is missing. No further evidence is required to instill the duty of going forward on Dunfield.

Dunfield argues that claims 1, 2, 9, and 11 of Dunfield's parent application "implicitly" require mounting the microactuator on the rigid region of a load beam. In support of this argument, Dunfield argues that Dunfield's parent disclosure discloses mounting the microactuator at the distal end of the load beam and nowhere else.

Dunfield also directs us to exhibits in which Jurgenson's expert witness, Mr. Leabch indicates that: (1) the load beam shown in the Dunfield application is equivalent to the load beam shown in the Jurgenson patent, and (2) the rigid region of a load beam makes up most of the load beam, including the distal end of the load beam (Paper 84 at 6). Dunfield additionally argues that no one would consider mounting the microactuator on either the spring region or the mounting region based on various design considerations. Dunfield then concludes that the rigid region of the load beam is the only place that one having ordinary skill in the art would consider mounting a second actuator (i.e., the microactuator) (Paper 84 at 7).

Dunfield does not dispute Jurgenson's argument that the limitation of the microactuator mounted on the rigid region of the load beam is a material one. Based on the record before us, a material limitation of the interfering subject matter is mounting the microactuator on the rigid region of the load beam (Findings 24-27). Apparently both parties agree. Still further, it appears that both parties agree that Dunfield's claims 40 and 41 when properly interpreted, specify that the microactuator is on the rigid region of a load beam (Findings 23).

Dunfield's "implicit" argument appears to go something like this: (1) because Dunfield's earlier specification describes mounting the microactuator only on the distal end similar to Jurgenson's specification, and (2) since prior art along with design considerations would suggest mounting the microactuator only on the rigid region of the load beam, (3) then Dunfield's earlier claims include mounting a microactuator on the rigid region of the load beam. We are not persuaded by Dunfield's "implicit" argument for the following reasons.

Dunfield compares its earlier specification with Jurgenson's involved specification to demonstrate that the disclosures are similar. Dunfield further directs us to its

earlier specification to demonstrate that its disclosure supports mounting an actuator on a rigid region of a load beam. Dunfield's focus on disclosures is not particularly relevant to analyzing Dunfield's earlier claims 1, 2, 9 and 11 for purposes of § 135(b).

The inquiry is whether Dunfield's earlier claims include the material limitation of mounting the microactuator on the rigid load beam, i.e. on the rigid region of the load beam. That the Dunfield and Jurgenson disclosures are similar, or that Dunfield's earlier specification supports Dunfield's involved claims is not indicative of whether Dunfield's earlier claims are drawn to the same or substantially the same subject matter as that of Dunfield's current claims.

Dunfield appears to take the position that because its specification describes a microactuator only on the distal end of the load beam (which Dunfield argues is part of the rigid region of the load beam), then its earlier claims inherently recite mounting a microactuator on the rigid region of the load beam. The argument is rejected. There is no basis to consider a missing feature inherent simply because the only described embodiments include that feature. It frequently is the case that not every single possible embodiment is described or discussed and that a claim is

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broader in scope or coverage than the particular embodiments described.

Dunfield has failed to sufficiently demonstrate that its earlier application conveys to one of ordinary skill in the art that the microactuator must necessarily be mounted on the distal end of the load beam. In In re Berger, 279 F.3d 975, 61 USPQ2d 1523 (Fed. Cir 2002), applicant's inherency argument was rejected as the court made clear that the applicant could not rely on the content of his specification and drawings to satisfy section 135(b). As stated therein, precedent makes clear that "[t]he inquiry here is not whether such a step is inherently disclosed, as it might be in a right-to-make case. Rather, the question is whether the step necessarily occurs in the process as claimed" (quoting Parks v. Fine, 773 F.2d 1577, 1580, 227 USPQ 432, 434 (Fed. Cir. 1985)).

Furthermore, Dunfield has not demonstrated that "the distal end of the load beam" is substantively the same as "the rigid part of the load beam." Even if the distal end is a portion of the rigid portion, that is still not sufficient basis to equate the two. For instance, if the rigid portion includes areas other than the distal end, then the

microactuator can be mounted outside of the distal end and still be on the rigid portion of the load beam.

Dunfield's argument that the rigid region of the load beam is the only place that one having ordinary skill in the art would mount a second actuator (i.e., the microactuator) is misplaced. What is at issue is whether a certain feature is necessarily present in the claims of Dunfield's parent application by way of inherency, not what one with ordinary skill in the art would see fit to do. In any event, prior art of record that Dunfield discusses in its brief, teaches or suggests mounting the microactuator, at least partially on the mounting region, e.g. away from the distal end. For example, Boutaghou⁴ teaches an actuator, at least partially located on the mounting region of the load beam, e.g. on the end of the load beam opposite the distal end (Boutaghou, abstract lines 4-7, Fig. 2).

Dunfield's arguments as to the design considerations that would lead one to mount the microactuator only on the rigid region of the load beam are conclusory, and based on unsupported theories made by the attorney. Argument of counsel cannot take the place of evidence lacking in the

⁴ U.S. Patent 5,521,778.

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record. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997). Also, the argument is misplaced. Inherency is not determined by what one with ordinary skill in the art would do when given various design and practical considerations. A claim need not be drawn to the most optimal or the most efficient embodiment.

Based on the record before us, a material limitation of the interfering subject matter is that the microactuator is on the rigid region of the load beam (Finding 24). We are not persuaded by Dunfield's arguments that its earlier claims 1, 2, 9, and 11, either alone or in combination, implicitly recite this limitation.

Dunfield further argues that the functional limitation of movement of the flexure with respect to the rigid region of the load beam is claimed in its earlier claims 1, 2, 9 and 11 (Paper 84 at 7). However, Dunfield has not sufficiently demonstrated that its earlier claims even include a rigid region of a load beam. Therefore, we need not address Dunfield's argument regarding movement of the flexure with respect to the rigid region of the load beam.

Lastly, Dunfield directs us to Thompson v. Hamilton, 152 F.2d 994, 68 USPQ 161 (CCPA 1946) in support of its

arguments. Dunfield fails to sufficiently discuss or explain in any meaningful way how the Thompson case relates to the facts in this case. Dunfield merely quotes certain passages from the Thompson case, but fails to provide an analysis of the facts in the Thompson case compared to the facts in this case.

Based on the recent decision in In re Berger, we are not persuaded that Thompson is controlling or applicable to the issues at hand. Dunfield has failed to demonstrate otherwise.

For the above reasons, Dunfield has failed to sufficiently demonstrate that its earlier filed claims 1, 2, 9 and 11 of its parent application (08/438,091) include the material limitation of a microactuator on the rigid region of a load beam. Accordingly, Jurgenson preliminary motion 1 is granted.

Jurgenson Preliminary Motion 2

Although Dunfield's involved claims are barred under 35 U.S.C. § 135(b)(1), we address the additional threshold question raised by party Jurgenson of whether there is an interference-in-fact. Jurgenson has made its preliminary motion 2 contingent upon the denial of Jurgenson preliminary motion 1. Since Jurgenson preliminary motion 1 is granted,

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we need not and have not considered Jurgenson preliminary motion 2. Accordingly, Jurgenson preliminary motion 2 is dismissed as moot.

Dunfield Preliminary Motion 3

Because the addition of claims to Dunfield's application may keep Dunfield in this interference, we consider Dunfield preliminary motion 3 to add claims 42-46 to its application. Dunfield's proposed claims 42-46, however, depend either directly or indirectly from Dunfield claim 41.

As stated above, in connection with Jurgenson preliminary motion 1, Dunfield claims 40 and 41 are barred under 35 U.S.C. § 135(b). The new claims that Dunfield proposes to add, claims 42-46 include the limitation of claim 41 that the microactuator is on the rigid load beam (on the rigid region of the load beam). For the reasons stated above, Dunfield has failed to demonstrate that its earlier claims recite, either explicitly or implicitly the material limitation of a microactuator on a rigid region of a load beam.

For the same reasons given in connection with Jurgenson preliminary motion 1, Dunfield's claims 42-46 do not comply with 35 U.S.C. § 135(b). Accordingly, Dunfield preliminary motion 3 is denied.

Dunfield Preliminary Motions 2 and 4

Dunfield has filed a preliminary motion 2, requesting the addition of 3 new counts and to designate its claims 42-46 and certain ones of Jurgenson's claims as corresponding to the proposed counts.

As stated above, in connection with Dunfield preliminary motion 3, Dunfield claims 42-46 are barred under 35 U.S.C. § 135(b). Thus, there is no occasion to adopt Dunfield's proposed counts 3-5. Accordingly, Dunfield preliminary motion 2 is dismissed as moot.

In Dunfield preliminary motion 4, Dunfield moves to be accorded the benefit of its earlier application 08/438,091 for its proposed counts 3-5. The preliminary motion is contingent upon the granting of Dunfield preliminary motion 2. Because we have dismissed Dunfield preliminary motion 2, the contingency did not materialize and so Dunfield's preliminary motion 4 is dismissed.

Dunfield's remaining preliminary motions

In Dunfield's remaining preliminary motions, Dunfield essentially seeks to designate several Jurgenson claims as corresponding to the count, while seeking to have several of those claims held to be unpatentable.

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The parties have briefed the issue of whether a decision on the remaining preliminary motions is necessary if it is determined that Dunfield's claims 40 and 41 are barred under 35 U.S.C. § 135(b).

Jurgenson argues that if it is determined that Dunfield claims 40 and 41 are barred under 35 U.S.C. § 135(b), then the interference should not proceed, such that the remaining preliminary motions need not be decided. Dunfield argues that having raised the patentability of several of Jurgenson's claims, we must determine the remaining preliminary motions.

Based on the recent decision in Berman v. Housey, 01-1311 (Fed. Cir. 2002), it is now settled that when an applicant is barred under § 135(b) that the remaining issues in an interference need not be considered. Specifically, the court stated that:

[T]he Board should terminate an interference once it determines that there is a § 135(b) bar, [and that] the Board acts in accordance with § 135 when it refuses to address other issues of priority and patentability raised ... (Id. at 12).

Since Dunfield claims 40 and 41, Dunfield's only two involved claims, are barred under 35 U.S.C. § 135(b), there is no occasion to consider Dunfield's remaining preliminary

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motions. Accordingly, Dunfield preliminary motions 1 and 5-9 are dismissed as moot.

Upon consideration of the record, it is

ORDERED that judgment as to Count 1 (Paper 1 at 49) is awarded against senior party JOHN CHARLES DUNFIELD and GUNTER KARL HEINE.

FURTHER ORDERED that senior party JOHN CHARLES DUNFIELD and GUNTER KARL HEINE is not entitled to a patent containing claim 40 (corresponding to Count 1) of application 09/160,593.

FURTHER ORDERED that judgment as to Count 2 (Paper 1 at 51) is awarded against senior party JOHN CHARLES DUNFIELD and GUNTER KARL HEINE.

FURTHER ORDERED that senior party JOHN CHARLES DUNFIELD and GUNTER KARL HEINE is not entitled to a patent containing claim 41 (corresponding to Count 2) of application 09/160,593.

FURTHER ORDERED that a copy of this paper shall be made of record in files application 09/160,593 and U.S. Patent 5,657,188.

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FURTHER ORDERED that if there is a settlement agreement,
attention is directed to 35 U.S.C. § 135(c) and 37 CFR
§ 1.661.

_____)	
JAMESON LEE)	
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Interference 104,530
Jurgenson v. Dunfield

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