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is not binding precedent of the Board.

Paper No. 70

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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ECKHARD BERNARDY,

Junior Party,  
(S.N. 09/035,936)

v.

ROBERT A. POWELL,

Senior Party.  
(P.N. 5,875,700)

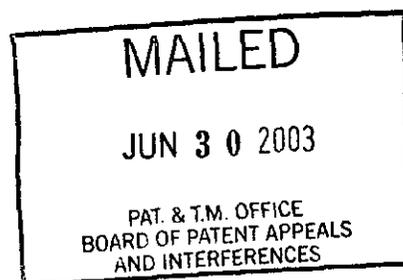
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Patent Interference No. 104,671

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Before: SCHAFFER, CRAWFORD, and MEDLEY, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.



## FINAL DECISION

### Introduction

This interference was declared on April 4, 2001. The junior party, Eckhard Bernardy copied claims 1 and 2 from U.S. Patent No. 5,875,700 to Powell ("700 patent") into application U.S. Serial No. 09/035,936 ("936" application) which was filed on March 2, 1998.

As the '700 patent was filed on November 17, 1997, Powell was accorded senior party status.

Count 1 of the interference is claim 1 of the '700 patent or claim 57 of the '936 application. Claim 1 of the '700 patent reads as follows:

A brush cutting blade for mounting to a drive shaft manipulated by a handle, said brush cutting blade comprising:

a circular disk having a disk body defining a plane and having top and bottom sides and a peripheral edge, teeth formed on the peripheral edge and defining a direction of rotation of the disk for cutting, and a center mount for mounting the disk to the drive shaft with the top side facing the handle for rotatively driving the disk in the defined direction of rotation;

at least one cutting segment formed out of the disk body positioned radially outward of the center mount and radially inward of the peripheral edge, said segment having a generally curved triangular shape with three sides, one side being unsevered and forming a juncture with the disk body and the other sides extending from said one side radially outwardly of the center mount severed from the disk body, said segment deflected outwardly of the plane of the disk body toward the bottom side of the disk body at an angled orientation relative to the disk body between positions of coplanar and normal relative to the plane of the disk body and

forming thereby an opening through the disk body that is radially outwardly of the juncture;

said segment having an inclined leading edge with cutting teeth on the edge for cutting in the direction of rotation and as a result of the angular orientation of the blades, said teeth presenting a laterally extended cutting section from a face view and laterally extended cutting section from an edge view of the disk.

Claim 57 of the '936 application reads as follows, with differences from the '700 patent claim 1 bracketed for deletions and underlined for additions:

A brush cutting blade for mounting to a drive shaft manipulated by a handle, said brush cutting blade comprising:

a circular disk having a disk body defining a plane and having top and bottom sides and a peripheral edge, teeth formed on the peripheral edge and defining a direction of rotation of the disk for cutting, and a center mount for mounting the disk to the drive shaft with the top side facing the handle for rotatively driving the disk in the defined direction of rotation;

at least one cutting segment formed out of the disk body positioned radially outward of the center mount and radially inward of the peripheral edge, said segment having a generally curved triangular shape with three sides, one side being unsevered and forming a juncture with the disk body and the other sides extending from said one side radially outward[ly] of the center mount severed from the disk body, said segment deflected outwardly of the plane of the disk body toward the bottom side of the disk body at an angled orientation relative to the disk body between positions of coplanar and normal relative to the plane of the disk body and forming thereby an opening through the disk body that is radially outwardly of the juncture;

said segment having an inclined leading edge with cutting teeth on the edge for cutting in the direction of the rotation and as a result of the angular orientation of the blades, said teeth presenting a laterally extended cutting section from a

face view and laterally extended cutting section from an edge view of the disk.

Count 2 of the interference is claim 2 of the '700 patent or claim 58 of the '936 application. Claim 2 of the '700 patent depends from claim 1 of the '700 patent. Claim 58 of the '936 application depends from claim 57 of the '936 application. Claim 2 of the '700 patent and claim 58 of the '936 application are nearly identical, the differences being in the respective independent claims. Claim 1 of the '700 patent as follows:

A brush cutting blade as defined in count 1, wherein at least three segments are provided in said disk body, and said juncture inclined from trailing end to leading end radially inward.

The following claims of the parties are designated as corresponding to count 1:

Bernardy: 42, 45, 49, 50, 57, and 59  
Powell: 1, 3, and 4

The following claims of the parties are designated as corresponding to count 2:

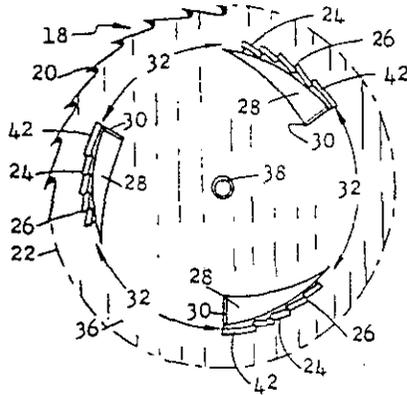
Bernardy: 43, 44, and 58  
Powell: 2

### Findings of Fact

#### The '570 blade

1. Eckhard Bernardy, the junior party, is the principal of Simplar Company, Inc. ("Simplar").
2. On July 24, 1992, Eckhard Bernardy filed a patent application for a Compound Pruning and Shredding Blade which matured on November 8, 1994 into U.S. Patent No. 5,361,570 ("570 patent").

3. The blade of the '570 patent is adapted to be mounted on a drive shaft 58 and is comprised of a circular disk having teeth 18 formed on the periphery and a center mount 38 for mounting a drive shaft 58 (col. 8, lines 17 to 43; Figs. 1 and 3b).
4. The '570 blade further has at least one cutting segment 24 formed out of the disk body. The cutting segment is disposed radially outward of the center mount 38 and radially inward of the peripheral edge (Fig. 1).
5. The cutting segment has a generally triangular shape (Fig. 1).
6. At least one side of each cutting segment 24 is unsevered and forms a juncture with the disk body (Fig. 1).
7. The cutting segment 24 is deflected outwardly of the plane of the disk body at an angled orientation relative to the disk body between positions of co-planar and normal relative to the plane of the disk body and form an opening through the disk body that is radially inward of the juncture (Figs. 1 and 3b) .
8. The '570 patent teaches that the cutting segment 24 is created using extrusion or welding (col. 7, lines 49 to 52).
9. Figure 2 of the '570 patent depict the blade of the '570 patent and appears below:



10. One of the ways that the '570 blade differs from the blade of the count is that the openings in the '570 blade are radially inward of the juncture of the cutting segment and the disk body and the openings in the blade of the count are radially outward of the juncture.

**Conception and reduction to practice by the Junior party in 1994**

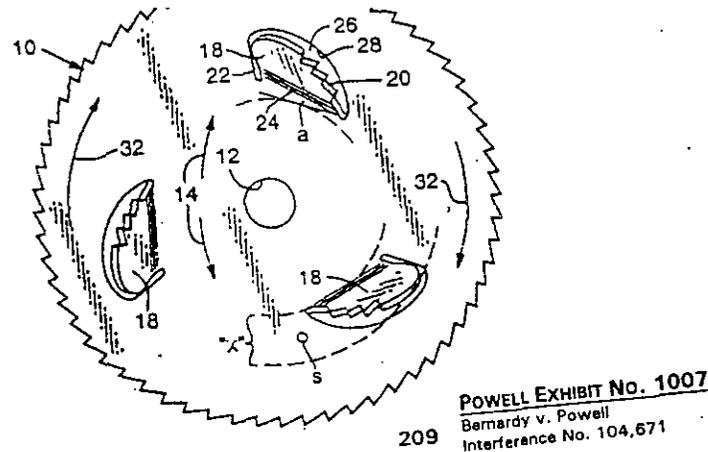
11. In the preliminary statement, the junior party alleges conception of the invention in early July 1994.
12. As evidence of this conception, the junior party has filed a copy of what is titled a Bound log book entry dated July 12, 1994 which is entitled "Blade Improvement" and further contains the words "Straight Wing Cutters---Fastened by Rivets or Pressed---WING CUTTERS FLAIR FROM INSIDE TO OUTSIDE OR TOWARD PERIPHERY -ALSO RAKING INWARD ADVANTAGE-SELF CLEANING CENTRIFUGAL FORCES." (Bernardy Record page 13).

13. The words "I have seen & understood the above invention & helped to produce a video of a sample blade in operation" appear on the page and the page is signed by R. Wooping.
14. At the bottom of the page is the word "INVENTOR" and the page is signed by Eckhard Bernardy.
15. The junior party has alleged reduction to practice as of July 12, 1994 and filed Exhibit 2008 which appears to be a photograph of a saw blade with wing cutters riveted onto the body of the blade (Bernardy Record page 14).
16. The junior party has also filed Exhibit 2056 (Bernardy Record page 81) which is also a photograph of a blade having cutting segments riveted thereon.

**Bernardy and Powell form a business relationship**

17. On or about July 1996, Bernardy contacted Robert Powell (the senior party), the owner of Performance Quality Saw Shops, Inc, about forming teeth for the blades covered by the '570 patent (Bernardy Record page 2; Powell Record page 267).
18. Mr. Powell was to perform the operation of cutting the teeth and others would produce the blank disks, cut the cutting segments and heat treat the blade. (Bernardy Record page 1; Powell Record page 267).
19. During the next few months, it was discovered by either Eckhard Bernardy or Robert Powell that the design of the "570 blade had certain problems in that it allowed plant matter to be caught in the openings in the blade which led to vibrations and created safety problems (Powell Record page 198).

20. Bernardy or Powell conceived of an improved design for the blade in which the openings formed by the cutting segment was disposed radially outward of the cutting segment.
21. This blade with an improved design is the blade of the '700 patent and the '936 application and appears below:



**Reduction to practice by junior party in 1996**

22. Mr. Bernardy alleges that he hand crafted the first blade with this improved design. He gives several time frames for this reduction to practice. At one point he says late 1996 which would indicate November or December of 1996 (Powell Record at page 168). At another point he says he made a prototype some time in late fall of 1996 which would indicate October or November of 1996 (Powell

record page 170). And he also states that he made the first prototype in August or September of 1996 (Powell Record, pages 177 to 178).

23. Mr. Schramm testifies (Bernardy Record page 8, emphasis added):

Before July of 1996, Mr. Bernardy had under Confidentiality, shown me several blade designs, some based on his own US Patent issued in 1994 that I was aware of, but also drawings and prototypes of new developments, which he felt could further improve his previous design.

Some of the new prototypes had externally mounted axial shredding elements, while others had integrally formed axial shredding elements which were pressed out of the original disk flats.

The resultant openings through the blade were distal and the outwardly flared axial shredding elements were proximal to the blade center with a centrally inclined base line.

Mr. Bernardy later became aware of a US Patent issued in March 1999 to a Mr. Robert A. Powell, which he showed me and which I have read. To the best of my knowledge and understanding, there was no significant structural difference between one of the earlier designs I already saw in Mr. Bernardy's shop in 1996 and the description and claims of the US Patent issued to Mr. Powell.

24. The junior party has filed a document signed by Mr. Ronald Thompson and dated September 1996 (Bernardy Record page 11).

25. The Thompson document (Bernardy Record page 11) reads in pertinent part:

This statement will attest to the fact that I witnessed a blade testing procedure involving a novel brush cutting and shredding blade, then called the 'SIMPLAR SHREDDER BLADE' and invented by Mr. Eckhard Bernardy . . . The tests were conducted during the month of September of 1996, at the 'SIMPLAR Co.' . . .

I have examined the US Patent 5 875 700, issued to Mr. Robert A. Powell and specifically the drawings illustrative of a brush cutting blade within this patent document and I hereby attest that they are in every key aspect an accurate reflection or identical copy of the 'SIMPLAR SHREDDER BLADE'

tested by Mr. Bernardy, and witnessed by myself during the time period and at the location stated above.

26. The junior party in his preliminary statement (Paper No. 26) states that the first time the invention was communicated to Mr. Robert Powell was November 20, 1996.
27. Mr. Bernardy states in his affidavit (Bernardy Record page 2) that he presented to Mr. Powell a set of SIMPLAR Design & Manufacturing Specifications which he believed to be within the scope of the '570 patent but which later became the basis of the "936 application (Bernardy record page 3).
28. At some point in 1996, Mr. Bernardy became unhappy with the performance of Mr. Powell in forming teeth for the blades and began looking around for someone else to form the teeth for the blades (Bernardy Record page 3).
29. On December 4, 1996, SIMPLAR sublet a job to BBC Steel Corp related to forming blades (Powell Record at page 169; Bernardy Record page 41).
30. The junior party has also submitted the affidavit of David Egbert (Bernardy Record page 6) which states:

2. During February of 1997 I was approached by Robert (Bob) Powell the owner of Performance Quality Saw Shops, Inc. of Camas, who related a work project involving a novel brush shredding blade invented by a Mr. Bernardy and for which Mr. Powell had accepted the job of cutting peripheral teeth. . . .

4. Mr. Bernardy came to my facility on the day Mr. Powell started cutting teeth and Mr. Bernardy was introduced to me by Mr. Powell as the inventor of the novel brush blade, then referred as the SIMPLAR Shredder Blade. I was shown a prototype of the blade. Mr. Powell was to perform the tooth

cutting on Mr. Bernardy's blade stock. Mr. Powell made no invention claims at the time.

5. I have reviewed the Patent 5,875,700 later issued to Mr. Powell and it has all of the elements of the early prototype of the blade shown to me in February 1997. At the time, I was told so by Mr. Powell and I had no reason to doubt that Mr. Bernardy was the true inventor of the blade.

31. Mr. Egbert testifies that he reviewed the '700 patent and saw early prototypes of a blade in February of 1997 which had all the elements of the '700 blade. However, on cross examination (Powell Record page 146 to 149), he states:

Q. My first question to you is, is everything in this affidavit 100 percent true and correct?

A. No. . . .

Q. . . . do you recall Bob Powell introducing Mr. Bernardy as the inventor of the blade?

1. Yes.

Q. Did they have a blade with them?

A. Yes.

Q. Was it considered a prototype of the blade?

A. As far as I know.

Q. Can you describe what you saw?

A. All I saw was a flat blade, at that time.

Q. And they had no things flipped up like this (indicating)?

A. No. Not at the time.

Q. There were no, what we'll call, shredding elements extending up from the bottom of the blade?

A. I don't remember. I saw some cuts on the blade.

Q. But no – they weren't flipped off, or there were no teeth on them, that you recall?

A. I sure don't remember.

Q. So to the best of your recollection – am I correct in saying that to the best of your recollection, the blade you saw was a flat disk, and may or may not have had some cuts in it?

A. It had cuts in it. But it was flat, at the time.

Q. . . . You say that you reviewed patent No. 5875700 –

A. I didn't review no patent.

Q. You did not review a patent?

- A. I looked at a sketch, and that's about it.
- Q. Do you know whether the sketch you looked at had all of the elements that that prototype had that you saw in February of 1997?
- A. I don't remember that.

32. Mr. Andrew J. Feucht II, the president of Voight Enterprises, (Bernardy Record page 9) testifies:

On March 12th, 1997 and on March 13<sup>th</sup>, 1997 and on March 14<sup>th</sup>, 1997, at the annual PORTLAND WOOD TECHNOLOGY CLINIC & SHOW, held at the OREGON CONVENTION CENTER of PORTLAND Mr. Eckhard (Eyck) Bernardy, owner of SIMPLAR™ CO, publicly did display examples of his SIMPLAR SHREDDER™ brush blade, as well as a narrated video showing the blade in use and a promotional flyer, including text and a realistic artistic rendering of the above brush blade, through Mr. and Mrs. Robert Powell, owners of PERFORMANCE QUALITY SAW SHOPS, INC. who were acting as promotional agents on behalf of Mr. Bernardy and his SIMPLAR™ CO product. . .

The attached photocopy of the promotional flyer, labeled EXHIBIT 10/b is a true and correct copy of the original promotional flyers distributed publicly during the above cited days of the PORTLAND WOOD TECHNOLOGY SHOW & CLINIC.

33. The flyer which was displayed at the March 14, 1997 Portland Wood Technology Clinic and Show is attached to the affidavit of Mr. Feucht (Bernardy Record page 10).
34. This flyer illustrates a blade disc having the characteristics of the improved design (blade of the count) including openings that are formed by the cutting segments which are outward of the juncture formed by the cutting element.

35. On June 27, 1997, Robert Powell filed a patent application for the blade of the '700 patent in Canada (Powell Record pages 247 to 256).
36. On November 11, 1997, Robert Powell filed a patent application Serial No. 08/971,454 for the improved blade in the United States.
37. On March 2, 1998, Eckhard Bernardy filed a patent application Serial No. 09/035,936 for the improved blade in the United States.
38. On March 2, 1999, U.S. Serial No. 08/971,454 matured into U.S. Patent No. 5,875,700.

### OPINION

Powell was accorded senior party status based on the first filing of the '700 patent application. In order to be awarded priority in this interference, Bernardy must either prove an actual reduction to practice prior to the '700 patent's filing date, or prove a conception of the subject matter of the counts before the '700 patent's filing date, coupled with reasonable diligence from a time just prior to Powell's filing date up to a reduction to practice (constructive or actual) by Bernardy. 35 U.S.C. 102(g)(2000); Singh v. Brake, 317 F.3d 1334, 1340, 65 USPQ2d 1641, 1645 (Fed. Cir. 2003); Griffin v. Bertina, 285 F.3d 1029, 1032, 62 USPQ2d 1431, 1433 (Fed. Cir. 2002); Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577, 38 USPQ2d 1288, 1290 (Fed. Cir. 1996).

In his preliminary statement, Bernardy alleges that he conceived the subject matter of the counts in early July 1994 and first actually reduced the invention to practice prior to July 12, 1994. However, Bernardy has also submitted documents relevant to reduction to practice in 1996 and in 1997. In his brief, the junior party has not clearly

stated whether his case for priority is founded on an actual reduction to practice prior to the '700 patent filing date or an earlier conception than Powell's coupled with reasonable diligence from a time just prior to the Powell filing date up to a reduction to practice. As such, we will examine the evidence as it relates to conception and reduction to practice in 1994, reduction to practice in 1996 and reduction to practice in 1997.

**A. The burden and standard of proof**

As the junior party, Bernardy bares the burden of proof on the issue of priority. Bosies v. Benedict, 27 F.3d 539, 541, 30 USPQ2d 1862, 1863 (Fed. Cir. 1994); Oka v. Youssefyeh, 849 F.2d 581, 584, 7 USPQ2d 1169, 1172 (Fed. Cir. 1988). "It is well settled that where an interference is between a patent that issued on an application that was copending with an interfering application, the applicable standard of proof is preponderance of the evidence." Bosies v. Benedict, 27 F.3d at 541-42, 30 USPQ2d at 1864, see also Peeler v. Miller, 535 F.2d 647, 651 n.5, 190 USPQ 117, 120 n.5 (CCPA 1976); Linkow v. Linkow, 517 F.2d 1370, 1373, 186 USPQ 223, 225 (CCPA 1975); Frilette v. Kimberlin, 412 F.2d 1390, 1391, 162 USPQ 148, 149 (CCPA 1969), cert. denied, 396 U.S. 1002 (1970).

The '700 patent was filed on November 11, 1997 and issued on March 2, 1999. Bernardy's involved application was filed on March 2, 1998. Therefore, Bernardy's application was copending with Powell's application. Accordingly, the relevant standard in this case is preponderance of the evidence. Something is established by a "preponderance of the evidence" when the existence of a fact is more probable than its nonexistence. Concrete Pipe & California, Inc. v. Construction Laborers Pension Trust

for Southern California, 508 U.S. 602, 622 (1993). As such, the junior party must prove that it is more probable than not that he was the first to reduce the invention to practice prior to the filing date of the '700 patent, or was the first to conceive the invention and utilized diligence from a time just prior to the filing of the '700 patent to a later reduction to practice.

**B. The Counts**

The subject matter of count 1 is a brush cutting blade for mounting to a drive shaft which is manipulated by a handle. The blade is utilized primarily to cut shrubbery and other plant material. The blade includes a circular disk body with teeth formed on the peripheral edge of the disk body. The disk has a center mount for mounting the disk to the drive shaft. There is at least one cutting segment formed out of the disk body and positioned radially outward of the center mount and radially inward of the peripheral edge. The cutting segment has a generally curved triangular shape with one side being unsevered and forming a juncture with the plane of the disk body. The other sides extend outwardly from the plane of the disk body at an angled orientation which is between positions which are coplanar and normal to the plane of the disk body. The formation of the cutting segments form an opening in the disk body which is disposed radially outward of the cutting segments. These cutting segments have an inclined leading edge with cutting teeth on the edge for cutting in the direction of the rotation.

The subject matter of count 2 includes all the subject matter of count 1 but in addition includes at least three cutting segments and a juncture that is formed by the

wing cutters and disk body which is inclined from a trailing end to a leading end radially inward.

**C. The precedents**

**Reduction to practice**

In order to prove actual reduction to practice, one must establish that a physical embodiment of the invention existed and that the physical embodiment included every limitation of the count and that it worked for its intended purpose. Correge v. Murphy, 705 F.2d 1326, 1329, 217 USPQ 753, 755 (Fed. Cir. 1983). Corroboration is also necessary to prove reduction to practice. The corroboration can be in form of testimony of a witness, other than the inventor, to an actual reduction to practice, or it may consist of evidence of surrounding facts and circumstances independent of the information received from the inventor.

The purpose of the rule requiring corroboration is to prevent fraud and to establish by proof that is unlikely to have been fabricated or falsified, that the inventor successfully reduced his invention to practice. Berry v. Webb, 412 F.2d 261, 267, 162 USPQ 170, 174 (CCPA 1969). The evidence necessary for corroboration is determined by the rule of reason which involves an examination, analysis and evaluation of the record as a whole to the end that a reasoned determination as to the credibility of the inventor's story may be reached. Berges v. Gottstein, 618 F.2d 771, 776, 205 USPQ 691, 695 (CCPA 1980); Mann v. Werner, 347 F.2d 636, 640, 146 USPQ 199, 202 (CCPA 1965).

## Conception

Conception is the "formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention." Kridl v. McCormick, 105 F.3d 1446, 1449, 41 USPQ2d 1686, 1689 (Fed. Cir. 1997); Mahurkar, 79 F.3d at 1577, 38 USPQ2d at 1290-91 (Fed. Cir. 1996); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987)(quoting 1 Robinson on Patents 532 (1890)). The invention is defined by the count. The idea must be "so clearly defined in the inventor's mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation." Mahurkar, 79 F.3d at 1577, 38 USPQ2d at 1291. Activity alleged to supply proof of conception of an invention defined in a given count must include all of the limitations of the count since each express limitation is considered material and cannot be disregarded. Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985); Davis v. Reddy, 620 F.2d 885, 889, 205 USPQ 1065, 1069 (CCPA 1980); Schur v. Muller, 372 F.2d 546, 551, 152 USPQ 605, 609 (CCPA 1967). Therefore, in order to prove conception of counts 1 and 2, the junior party must show that Eckhard Bernardy had a formation in his mind of all of the elements of each count at the date conception is alleged. To show all the elements of the count 1, the junior party must show not only the blade recited in the counts, but also the openings that are radially outward of the juncture. In order to show all the elements of count 2, the junior party must show all the features of count 1 and a blade that has at least three cutting

segments and a blade having a juncture of the cutting segments which is inclined from trailing end to leading end radially inward.

In addition, conception must be corroborated by a person other than the inventor. This corroboration must show that the inventor disclosed to others his "completed 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; Field v. Knowles, 183 F.2d 593, 601, 86 USPQ 373, 379 (CCPA 1950). It must also show by corroborated evidence that the party was in possession of every feature of the count and that every limitation of the count was known to the inventors at the time. Hitzeman v. Rutter, 243 F.3d 1345, 1354-55, 58 USPQ2d 1161, 1167 (Fed. Cir. 2001); Coleman, 754 F.2d at 359, 224 USPQ at 862.

If Bernardy establishes that he conceived of the inventions of counts 1 and 2 prior to the filing date of the '700 patent and supplies corroborating evidence of the conception, he must also establish that he exercised due diligence from just prior to the filing date of the '700 patent until Bernardy reduced the invention of the counts to practice. Mahurkar, 79 F.3d at 1577, 38 USPQ2d at 1290.

**D. Reduction to practice by the junior party in 1994**

The junior party, in his preliminary statement and in his brief alleges that the invention of both counts was reduced to practice on July 12, 1994.

The junior party states that Exhibit 2008 (Bernardy Record page 14) and Exhibit 2056 (Bernardy Record page 81) are depictions of a blade which was reduced to practice on July 12, 1994.

Exhibit 2008 has not been authenticated as required by Fed. R. Evid. 901.<sup>1</sup> Rule 901 requires that documents be identified or authenticated before admission into evidence, for example, by testimony of a witness with knowledge that the document is what it is claimed to be. In addition, 37 CFR §1.653(i) requires that an admissible exhibit be identified in an affidavit, be on the record in a deposition or be an official record or publication filed by a party in order to be considered as an exhibit in an interference. We note that no affidavit of record refers to Exhibit 2008.

Even if Exhibit 2008 were admissible, the blade depicted in Exhibit 2008 does not depict an opening through the disk body that is disposed radially outward of the juncture. Rather, Exhibit 2008 depicts a blade with cutting segments riveted onto the disk body.

Exhibit 2056 (Bernardy Record page 81) like Exhibit 2008 does not conform to the requirements of 37 CFR § 1.653(i), nor has it been authenticated in accordance with Fed. R. Evid. 901. As such, Exhibit 2056, like Exhibit 2008 is not admissible in this proceeding.

However, even if this document were admissible, Exhibit 2056 appears to be a photograph of a blade disk having wing cutters that are riveted and as such does not disclose the opening required by the count.

The weight of the evidence has not established reduction to practice of the invention of count 1 in 1994, because the evidence is not sufficient to establish an embodiment within count 1 was in existence in 1994. Exhibits 2008 and 2056 are

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<sup>1</sup> The Federal Rules of Evidence apply to interference proceedings. 37 CFR § 1.671(b).

inadmissible in this proceeding and even if these documents were admissible, they do not establish that the junior party had reduced to practice a blade disk that included an opening through the disk body that is radially outward of the juncture. Thus, even if the exhibits were admissible, they do not show a blade having every element of the count.

As count 2 includes all the limitations of count 1, it is our opinion that the junior party has failed to establish reduction to practice of the invention of count 2 for the same reasons detailed above in regard to count 1. Moreover, there is no depiction in Exhibits 2008 and 2056 of a juncture that is inclined from trailing end to leading end radially inward because each of these exhibits depicts a saw blade without an opening and therefore without an unsevered side of the cutting segment that forms a juncture. In addition, even if we considered the juncture made by the riveted cutting segments with the blade body, the juncture required by count 2, Exhibits 2008 and 2056, are not clear on what angle the juncture is inclined and there is no testimony of record explaining this aspect of Exhibits 2008 and 2056.

**E. Conception and diligence by the junior party in 1994**

In order to establish priority on the basis of conception of the invention in 1994, the junior party must establish not only that the invention of the count was conceived in 1994 but also that the junior party exercised diligence just prior to the filing date of the '700 patent until Bernardy's reduction to practice. The junior party has not directed our attention to any evidence regarding diligence. Therefore, even if the junior party establishes that the invention of the count was conceived in 1994, the junior party can not prevail on the basis of conception in 1994. In any case, as we discuss below, it is

our opinion that the junior party has failed to establish conception of an embodiment within the counts in 1994.

In his brief, the junior party argues:

Bernardy has a witnessed sketch and description in a bound and numbered invention log, substantially predating any claimed invention date by Powell.

The evidence is found in Exhibit No. 2007 of Bernardy and constitutes Bernardy's first documented proof of having conceived the invention. A comparative analysis of the evidence reveals that Exhibit No. 2007 satisfies both Count 1 and Count 2 in reference to the drawing of Powell's patent 5,875,700 . . . [Bernardy Principal Brief pages 19-20]

In regard to the formation of the cutting segments, the junior party argues:

A question arises at this point: does "formed out of the disk body" mean narrowly, "formed out of the disk body from native disk material?" If so, then the drawing of Exhibit No. 2007 by itself does not completely comply, because the cutting segments are attached by rivets, rather than extruded. However, the effective functioning of the cutting segment is not dependent on this particular mode of construction. Moreover, the descriptive text accompanying Exhibit No. 2007 specifically states: "FASTENED BY RIVETS OR PRESSED". The word "PRESSED" can in the given context mean only one thing "formed out of the disk body" from native material. [Bernardy Principal Brief page 20]

Exhibit 2007 (Bernard Record page 13) contains the heading "Blade Improvement." It also contains a sketch which appears to depict a circular blade with cutting segments riveted onto the blade disc body. The page also includes the words "Fastened By Rivets or Pressed." The drawing is witnessed by Ron Wooping and is dated July 12, 1994.

Exhibit 2007 does not conform to the requirements of 37 CFR § 1.653(i) nor has it been authenticated in accordance with Fed. R. Evid. 901. As such this document is not admissible in this proceeding.

However, even if Exhibit 2007 were admissible, Exhibit 2007 does not depict openings formed by the cutting segments. The junior party argues that the word "pressed" indicates an alternative embodiment to the one depicted in Exhibit 2007 in which the cutting segments are formed by pressing out of the disk body. However, there is no definition for pressed on Exhibit 2007. Bernardy has failed to direct us to evidence that would sufficiently demonstrate that the word "pressed" could only mean that the cutting segments were formed by pressing out of the disc body. The word "pressed" could refer to a method of fastening the cutting segments. For example, the word "pressed" could refer to a process in which heat and pressure is applied to attach the cutter segments to the disk body, such as the welding process which is used in the '570 patent (col. 7, lines 65-66). In that case, there would be no openings formed. Note, that Bernardy Exhibit 2007 includes the words "Fastened By Rivets or Pressed," indicating that the cutting segments are fastened by pressing, and not "formed" from the disc body.

In addition, even if Exhibit 2007 did disclose that the segments are pressed out of the disk body, Exhibit 2007 still does not disclose that the openings that would thereby be formed would be radially outward of the juncture of the cutting segments and the disk body as required by both counts. Instead, Exhibit 2007 shows cutting segments that are disposed radially inward of the juncture of the cutting segments and

the disk body. Bernardy has failed to prove conception of a blade having all the elements of the counts.

**F. Reduction to practice by the junior party in 1996**

The junior party argues:

. . . during the fall of 1996 Bernardy opted to produce blades pursuant to an earlier alternative design, due to intractable problems both in respect to production and safety.

In support of his claim for reduction to practice in 1996, the junior party has submitted an affidavit executed by Willfred Schramm (Bernardy Exhibit 8). Although, Mr. Schramm testifies that he viewed the prototype before July 1996, he doesn't give a specific date. As such, we can not attribute the activities described in the testimony to a day earlier than the last day of June 1996.

Mr. Schramm testifies that he viewed prototypes with integrally formed axial shredding elements which were pressed out of the original disk flats and that there was no significant structural difference between on the earlier designs he was shown by Bernardy and the description and claims of the '700 patent.

Mr. Schramm refers to the description contained in the '700 patent without reference to a line and column in the patent and concludes that there was "no significant structural difference" between one of the earlier designs he saw in 1996 and the description and claims of the '700 patent (Bernardy record page 8). The '700 patent includes a description of the '570 saw blade as well as a description of the '700 blade. Therefore, it is not clear whether the earlier design seen by Mr. Schramm had no significant structural difference with regard to the '570 blade described in the '700 patent

or the '700 blade itself. The '570 blade did include openings in the disk body but these openings were disposed radially inward of the cutting segments. As such, Mr. Schramm's testimony does not establish that a blade design in which the openings were outward of the juncture as required by the count was in existence as of June 30, 1996.

In addition, Mr. Schramm does not explain what is meant by the phrase "significant structural difference." As Mr. Schramm does not describe the features of the earlier blade he saw in any detail, his testimony does not establish that the blade viewed by Mr. Schramm included all the elements of the count. For example, Mr. Schramm does not discuss the shape of the cutting segments. As such, the blade he viewed could have had a shape other than the generally curved triangular shape required by the counts and not had any "significant structural difference" in the mind of Mr. Schramm with a blade with triangularly shaped cutting segments. In addition, Mr. Schramm's testimony does not establish whether the openings in the blade he saw were positioned radially outward of the cutting segments.

Mr. Schramm indicates that he viewed several blade designs. We do not know what Mr. Schramm means by the word "designs." Are these "designs" drawings or physical blades. In order for Mr. Schramm's affidavit to be evidence of reduction to practice, it must relate to an actual physical blade prototype not a drawing. The junior party has also submitted a statement signed by Ronald Thompson (Bernardy record, page 11). This statement is not testimony because it does not satisfy the requirements of 37 CFR § 1.68 that a declaration which is admissible in this proceeding warn that willful false statements and the like are punishable by fine or imprisonment.

Nor does the document satisfy the requirements of 28 U.S.C. § 1746 which requires a declaration to include a statement that it is done under penalty of perjury. Therefore, for these reasons, Exhibit 2005, is inadmissible in this proceeding.

We note that even if this document were admissible, it fails to establish reduction to practice in 1996.

According to the Thompson statement, Mr. Thompson witnessed a blade testing in September 1996. It is not clear what day in September 1996, Mr. Thompson witnessed a blade testing. As such, the blade testing could have occurred on any day in September. Without a specific date, we can not accord a date for these activities described in this statement earlier than the last day of September 1996.

The Thompson statement does not describe the features of the blade that was tested. As such, we do not know what was actually tested. Although, the document states that the blade of the '700 patent was in every "key aspect" an accurate reflection or identical copy of the blade that was tested, there is no explanation of what is considered a "key aspect" of the tested blade. Specifically, there is no evidence about whether a blade that includes these "key aspects" is a blade which includes all the elements of the counts.

Mr. Schramm testifies four and a half years after the activities testified about occurred and the Thompson statement, even if it were admissible, was signed nearly three years after the activities described therein. The testimony of witnesses, speaking long after the fact from memory in regard to past transactions, in the absence of contemporaneous documentary or physical evidence, has been held to be of little

probative value. Lockheed Aircraft Corp. v. United States, 553 F.2d 69, 75, 193 USPQ 449, 455 (Cl. Ct. 1977).

In addition, there is not enough detail in either the Schramm testimony or the Thompson statement regarding the features of the blade tested or seen to prove that the blade tested or seen had all the elements of the inventions of counts 1 and 2. The use of the phrases "every key aspects" and "no significant structural difference" do not establish that the thing viewed or tested had all of the elements of the count. When this evidence is viewed together, it is just not clear what either Schramm saw or what the Thompson document refers to. A prototype must be shown to meet all the limitations of the count in order to constitute reduction to practice. Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998).

As Mr. Schramm testifies that he viewed prototype blades and drawings of blades, it is not clear whether he is referring to actual blades or drawings of blades when he states that there was no significant structural difference between the "designs" he saw and the blade of the '700 blade.

Bernardy's testimony regarding when the invention of the counts was reduced to practice introduces further confusion regarding the reduction to practice. At one point, he states that he reduced the invention to practice in late 1996 (Powell Record page 168). At another point, he says it was late fall of 1996 (Powell Record page 170) and at another point he indicates that it was August or September of 1996 (Powell Record page 170).

When the evidence of reduction to practice in 1996, is viewed as a whole, it is not of sufficient weight to establish reduction to practice in 1996. It is our opinion that the junior party has not established that it is more probable than not that the junior party reduced the inventions of the counts to practice in 1996.

**G. Reduction to practice by the junior party in 1997**

Bernardy testifies:

At a wood precessing industry convention on March 12, 13, 14 and 1997, the 'Woodworking Technology Show & Clinic' held in Portland, Oregon, Simplar presented a first commercially acceptable prototype and descriptive flyers of the invention, along with a video showing operation of the device. Mr. Powell and his wife, Mrs. Esther Powell acted as and held themselves out as, the invention promotional agents for Simplar at the event. [Bernardy Record pages 3 to 4]

Mr. Egbert testifies that he saw a prototype of a blade in February 1997 and that the '700 blade has all the elements of the blade he saw in February 1997 (Bernardy record at page 6). Mr. Egbert on cross examination admitted that he never reviewed the '700 patent but was shown a sketch only (Powell Record page 147). No sketch has been entered into evidence. Accordingly, we do not credit Egbert's testimony.

Mr. Feucht testifies that he saw a blade tested on March 12 through 13, 1997 and that a flyer promoting the blade was distributed at a trade show (Bernardy record page 9) and that the blade he saw was the same as the blade in the flyer. A copy of the flyer has been submitted as Exhibits 2004 and 2025 (Bernardy Record page 10 and 30).

The junior party states:

. . . another Bernardy Exhibit, No. 2025, the trade show flyer, comes into prominence. It is uncontested that this flyer was

an exclusive Bernardy creation and provided to Powell for a March 1997 trade show. [Bernardy Principal Brief page 22]

The flyer of Exhibit 2004 depicts what is titled the Simplar Shredder. The flyer depicts a blade that has all the elements of the counts. The blade has cutting segments that are formed out of the disc body and are positioned radially outward of the center mount. The segment has a generally curved triangular shape with three sides with one side unsevered and forming a juncture with the disk body. There is an opening formed by each segment which is through the disk body and radially outward of the juncture. Each cutting segment has a leading edge with cutting teeth on the edge for cutting in the direction of the rotation. There are three cutting segments and the juncture is inclined from trailing end to leading end radially outward.

We find that the testimony of Feucht with the accompanying flyer establishes a blade meeting the limitations of the counts was in existence as of March 12 to 14 of 1997.

However, the affidavit and flyer do not establish reduction to practice of the invention of the counts by the junior party as of March 1997, because neither Feucht nor the flyer attributes the reduction of practice of the blade being promoted to the junior party.

The record also indicates that the senior party and junior party were involved in a business enterprise in which the senior party was to perform the operation of cutting teeth. At the trade show in March of 1997, the record indicates that both the junior party and the senior party were promoting the sale of the blade of the counts. In addition, the

flyer that was distributed had the name of Performance Quality Saw Shops, Inc., which is owned by the senior party, as well as SIMPLAR Co., which is owned by the junior party. We note that even if Bernardy created the flyer as is argued by the junior party, the creation of the flyer does not establish that the junior party reduced to practice the blade depicted in the flyer.

Therefore, even though the evidence proves that the invention of the counts was in existence as of March 12 to 14 of 1997, the evidence fails to identify, directly or by implication, that the junior party reduced the invention to practice.

In view of the foregoing, we are of the opinion that the evidence as a whole is not of sufficient weight to establish reduction to practice by the junior party in 1994, 1996 or 1997. The evidence fails to establish that any prototype that can be attributed to the junior party alone included each element of the counts. Although, it has been established that an embodiment of the counts was reduced to practice in March of 1997, it has not been established that it is more probable than not that the junior party reduced the inventions of the counts to practice in March of 1997.

#### H. Derivation

The junior party alleges that the senior party derived the invention from the junior party. In order to establish derivation, the junior party must show (1) prior, complete conception of the claimed subject matter and (2) communication of the complete conception to the senior party. Cooper v Goldfarb, 154 F.3d 1321, 1332, 47 USPQ2d 1896, 1905 (Fed. Cir. 1998); Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031,

1033 (Fed. Cir. 1993); Hedgewick v. Akers, 497 F.2d 905, 908, 182 USPQ 167, 169 (CCPA 1974).

As we have detailed above, the junior party has failed to prove conception of the invention prior to the filing date of the '700 patent. As such, the junior party has likewise failed to prove derivation.

#### Conclusion

We have examined the evidence as regards to priority of invention of the junior party as a whole, not individually, in determining whether Bernardy conceived the inventions of the counts before Powell.

After careful review of the record and consideration of the Bernardy arguments, we conclude that Bernardy has not proved conception nor reduction to practice by the junior party of every limitation of the count prior to November 17, 1997. In particular, Bernardy has not shown that he had possession of the conception or reduction to practice of a blade in which the cutting segments form an opening that is radially outward of the juncture of the cutting segment and the blade disk body.



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