

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 116

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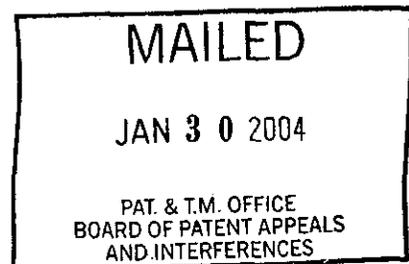
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

HANS HAZES
Junior Party
(U.S. Patent 6,086,973),

v.

JAMES L. BRIES and MICHAEL D. HAMERSKI
Senior Party,
(U.S. Application 08/989,507).



Patent Interference No. 104,833

Before: LANE, MEDLEY and TIERNEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTIONS AND JUDGMENT

A. Introduction

At the time the interference was declared on 26 March 2002 (Paper 1), the Hazes involved patent and the Bries involved application were assigned to different entities (see Papers 4 and 14). After preliminary motions, oppositions, and replies were filed, but prior to oral

argument, the parties settled the interference, whereby the party Hazes assigned its patent to Bries real party in interest, Minnesota Mining and Manufacturing Company (3M)¹.

Unless good cause is shown, an interference shall not be continued between an application and a patent owned by the same party. 37 CFR § 1.602(a). Thus, 3M was ordered to show cause why judgment should not be entered against the junior party Hazes (Paper 108). 3M responded by requesting a decision on the preliminary motions filed to make a proper determination of priority vis-à-vis Hazes and Bries (Papers 108 and 110). 3M's request was granted (Paper 110 at 3).

Oral argument on preliminary motions was held on 5 August 2003. As common assignee, only 3M had counsel present at the hearing. During oral argument, counsel for 3M requested that there emanate from this decision a precedent for deciding certain preliminary motions at the request of a common assignee. That is, counsel requested that the board undertake deciding "close" issues in order to assist a common assignee in determining priority (Paper 114 at 5). 3M's request for a precedential decision is denied.

Ordinarily, despite having filed preliminary motions, when a common assignee emerges, a decision on preliminary motions will not be decided. Here, counsel for 3M, during a conference call with the administrative patent judge (APJ) designated to handle the interference, explained to the APJ that 3M had a difficult task in deciding priority between Bries and Hazes, since it was a "close call" as to what the count should be, whether Bries' claims were patentable, and whether Hazes should be accorded benefit of its German application. Counsel for 3M

¹ According to PTO records, the assignment was executed on 12 June 2003, and recorded on 11 July 2003.

requested that the Board decide those issues. Based on the specific facts of the case, the APJ agreed to proceed to oral argument and to decide those issues raised regarding the proper count, the patentability of Bries' involved claims, and the benefit Hazes sought to be accorded (Paper 110). That the APJ did so was solely within his discretion. That the APJ did so is not, in any way, an indication that a future common assignee in the same position will be afforded the same courtesy. Based upon the particular facts of this interference, we conclude that the APJ did not abuse his discretion in continuing the interference. For these reasons, we exercise our discretion to determine all of the preliminary motions filed.

B. Findings of fact

The record supports the following findings of fact, as well as any other findings of fact set forth in the discussion portion of this decision, by at least a preponderance of the evidence.

The interference

1. The interference was declared between junior party Hans Hazes ("Hazes") and senior party James L. Bries and Michael D. Hamerski ("Bries").
2. Hazes is involved in the interference on the basis of its 6,086,973 ("973 ") patent, which issued from application 09/098,480, filed 16 June 1998.
3. Bries is involved in the interference on the basis of its 08/989,507 ("507 ") application, filed 12 December 1997.

Priority benefit

4. In the Notice Declaring Interference, neither party was granted priority benefit of any earlier filed application (Paper 1 at 3-4).

The counts

5. The interference was declared with two counts, i.e., Count 1 and Count 2 (Paper 1 at 5).

6. Count 1 is as follows:

A composition according to claim 1 of U.S. Patent No. 6,086,973.

7. Count 2 is as follows:

A method according to claim 11 of U.S. Patent No. 6,086,973.

8. Claim 1 of the '973 patent is as follows:

An adhesive film strip composite comprising:

- a) an adhesive film strip which is elastically or plastically extensible, exhibits an adhesion less than its cohesion and the adhesion disappears on extension, and which exhibits a reaction of stripping force to tear load of at least 1:1.5, which when bonded to a substrate, can be released from said substrate by pulling on the adhesive film strip in the direction of the plane of the bond formed between said adhesive film strip and said substrate; and
- b) a plurality of hook or loop fasteners adhered to one side of said adhesive film strip in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners.

9. Claim 11 of the '973 patent is as follows:

In a method comprising bonding an adhesive film strip to a substrate, and optionally thereafter releasing said adhesive strip from said substrate by pulling on the adhesive film strip in the direction of the plane of the bond formed between said adhesive film strip and said substrate, the improvement which comprises employing as said adhesive film strip the adhesive film strip according to any one of claims 1-4, 5, 6-9 and 10.

Claim correspondence

10. All of the Hazes claims and all of the Bries claims correspond to either Count 1 or Count 2.
11. Hazes claims 1-10 and Bries claims 68-77 correspond to Count 1 (Paper 9 at 2).
12. Hazes claims 11-13 and Bries claims 78-81 correspond to Count 2 (Paper 9 at 2).

Hazes motions

13. Hazes filed the following eight preliminary motions:
 - (a) Hazes preliminary motion 1 under 37 CFR 1.633(a) for judgment that all of Bries claims are unpatentable under 35 U.S.C. § 112, ¶ 1 for lack of written description (Paper 33).
 - (b) Hazes preliminary motion 2 under 37 CFR 1.633(f) seeking priority benefit of German patent application DE 197 26 375, filed 21 June 1997 (Paper 34).
 - (c) Hazes preliminary motion 3 under 37 CFR 1.633(h) seeking to add reissue 10/192,146, filed 10 July 2002, to the interference (Paper 35).
 - (d) Hazes contingent preliminary motion 4 under 37 CFR 1.633(f) seeking priority benefit of German patent application DE 197 26 375, filed 21 June 1997, as to the reissue application, if added (Paper 36).
 - (e) Hazes preliminary motion 5 under 37 CFR 1.633(c)(1) to substitute count 3 or count 4² for counts 1 and 2 (Paper 37).

² Hazes wishes to substitute count 4 only if its motion to add the reissue application is granted (Paper 37 at 2).

(f) Hazes contingent preliminary motion 6 under 37 CFR 1.633(f) seeking priority benefit of German patent application DE 197 26 375, filed 21 June 1997, as to proposed count 3 or 4, if Hazes preliminary motion 5 is granted (Paper 38).

(g) Hazes contingent preliminary motion 7 under 37 CFR 1.633(j) and 1.633(f) seeking priority benefit of German patent application DE 197 26 375, filed 21 June 1997 as to the substituted counts, if Bries' preliminary motion 1 (to substitute counts) is granted (Paper 48).

(h) Hazes contingent preliminary motion 8 under 37 CFR 1.633(j) and 1.633(f) seeking priority benefit of German patent application DE 197 26 375, filed 21 June 1997, as to the substitute counts, if Bries' preliminary motion 3 (to substitute counts) is granted (Paper 61).

14. In addition, Hazes filed a motion to suppress (Paper 90) certain cross examination testimony of Dr. Thorsten Krawinkel (Exh. 2032).

Bries motions

15. Bries filed the following four preliminary motions:

(a) Bries preliminary motion 1 under 37 CFR 1.633(c)(1) to substitute proposed counts 3 and 4 for present counts 1 and 2 (Paper 25).

(b) Bries preliminary motion 2 under 37 CFR 1.633(c)(2) to add claims 82-85 to its '507 application and to have them designated as corresponding to either count 3 or count 4 (Paper 26).

(c) Bries preliminary motion 3 under 37 CFR 1.633(c)(1) to substitute proposed counts 5 and 6 for counts 1 and 2, provided that the Hazes reissue application is added (Paper 46).

(d) Bries preliminary motion 4 under 37 CFR 1.633(c)(2) to add claims 86-90 to its '507 application and to have them designated as corresponding to either count 5 or 6 (Paper 47)

16. In addition, Bries filed a motion to suppress the declaration testimony of Dr. Krawinkel (Exhs. 2030 and 2031) and the certificate of accuracy (Exh. 2025) (Paper 95).

C. Decision

Hazes preliminary motion 1

Hazes, through its preliminary motion 1, argues that all of Bries' involved claims 68-81 lack written description. Bries claims 69-81 depend either directly or indirectly on claim 68. The disputed limitation is contained in Bries claim 68. That claim, with the disputed limitation underlined, is as follows:

68. An adhesive film strip composite comprising:
- a) an adhesive film strip:
 - (i) which is elastically or plastically extensible,
 - (ii) which exhibits an adhesion less than its cohesion,
 - (iii) the adhesion of which disappears on extension,
 - (iv) which exhibits a ratio of peel force to tear strength of at least 1:2, and

(v) which, when bonded to a substrate, can be released from said substrate by pulling on the adhesive film strip in the direction of the plane of the bond formed between said adhesive film strip and said substrate; and

b) a plurality of hook or loop fasteners adhered to one side of said adhesive film strip in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners.

The issue before us is whether the Bries specification properly and effectively incorporates by reference the description of the underlined ratio from the Kreckel '581 patent³. Incorporation by reference is a question of law. As stated in Advanced Display Systems, Inc. v. Kent State University, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000):

To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various [referenced] documents. [Citations omitted.]

In Bries' specification, the statement of incorporation of the Kreckel '581 patent is as follows :

Suitable plastic backing materials are disclosed in U.S. Patent nos. 5,516,581 and 5,672,402 to Kreckel et al and in co-pending U.S. Patent application serial number 08/308,937 (Bries et al.), each of which are commonly owned by the Assignee of the present application, and the complete disclosures of which are incorporated by reference. (Ex. 1009 at 25, lines 16-20).

The portion of the Kreckel '581 patent that allegedly provides support for the claimed ratio is in the background section of the Kreckel patent and is in reference to a German document as follows:

German (OS) 3331 016 A1 discloses another adhesive tape for removable adhesive bonds, whereby the tape exhibits high elasticity and low plasticity. The adhesive strength

³ U.S. Patent 5,516,581 (Ex. 2005).

is less than the cohesive strength, and the adhesion capability essentially disappears as the film is being stretched. The ratio of peel force to tear strength of the tape is about 1:2 or greater and the adhesive bond can be released by pulling the film in the direction of the plane of the adhesive joint (Ex. 2005, col. 1, lines 47- 54).

By the standard set forth in Advanced Display Systems, Inc., supra, Bries's specification, has not identified with detailed particularity what specific material it seeks to incorporate. The general phrase "suitable plastic backing materials . . ." is so vague that we do not know with reasonable certainty what particular material is at stake and, more importantly where it may be found in the referenced documents. In other words, we do not know if the "suitable plastic backing materials" are those described in the Kreckel '581 embodiments, or those of the German reference, as that material is generally described in the background section of the Kreckel '581 patent, and which purportedly has numerous disadvantages that the Kreckel invention solves. Logic would dictate that the material to be incorporated is that which is specifically described in the detailed description section of the Kreckel '581 patent at columns 3 and 4, lines 62 to 17, and not what is generally described in the background section of the '581 patent, which is said to be inferior. Bries has failed to sufficiently demonstrate otherwise.

Furthermore, Bries' argument that the recited ratio is old in the art is misplaced. The issue is not whether the peel force to tear strength ratio would have been obvious to one of ordinary skill in the art based on the Bries disclosure, but whether there is sufficient support in the specification to demonstrate that the Bries inventors themselves contemplated the claimed feature at issue.

For these reasons, Hazes preliminary motion 1 is granted.

Bries preliminary motions 1 and 2

Through its preliminary motion 1, Bries moves to redefine the interfering subject matter by substituting proposed counts 3 and 4 for counts 1 and 2. Bries preliminary motion 2 seeks to add claims 82-85 to the Bries application, to designate claims 82 and 84 as corresponding to count 3, and to designate claims 83 and 85 as corresponding to count 4. The proposed counts and claims eliminate any specified ratio of peel force to tear strength recited in Bries claim 68 and in count 1.

Proposed count 3, which is identical to proposed claim 82 is as follows:

An adhesive film strip composite comprising:

- a) an adhesive film strip:
 - (i) which is elastically or plastically extensible,
 - (ii) which exhibits an adhesion less than its cohesion,
 - (iii) the adhesion of which disappears on extension,
 - (iv) which, when bonded to a substrate, can be released from said substrate by pulling on the adhesive film strip in the direction of the plane of the bond formed between said adhesive film strip and said substrate;
 - (v) which, is sufficiently extensible for debonding to occur but of sufficient tensile strength so as not to rupture during debonding; and
- b) a plurality of hook or loop fasteners adhered to one side of said adhesive film strip in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners.

Proposed count 4, which is identical to proposed claim 83 is as follows:

In a method comprising bonding an adhesive film strip to a substrate, and optionally thereafter releasing said adhesive film strip from said substrate by pulling on said adhesive film strip in the direction of the plane of the bond formed

between said adhesive film strip and said substrate, the improvement which comprises employing as said adhesive film strip the adhesive film strip according to count 3 [claim 82].

Bries argues, supported by evidence, that the elimination of the ratio of the film exhibiting a reaction of stripping force to tear load of at least 1:1.5, does not render its proposed count 3, or proposed claims unpatentable, since the ratio was well known at the time of the invention (Paper 25 at 12). Bries argues, with supporting evidence, that it is the combination of the film strip composite and the hook or loop fasteners, without the ratio, which renders the count patentable over the prior art of record.

Hazes arguments in its oppositions 1 and 2 are essentially identical. Hazes does not challenge the patentability of the proposed counts or proposed Bries claims. Rather, Hazes argues that Bries failed to provide a suitable reason for substituting the counts (adding claims 82-85). However, Bries does give a reason for substituting counts 1 and 2 with proposed counts 3 and 4, and adding claims 82-85. As Bries points out in its motion, the Administrative Patent Judge (APJ) assigned to the interference, raised the issue of whether Bries had support for the ratio limitation of its involved claim 68, which is similarly contained in count 1. We understand from Bries' motions that Bries proposes to amend the counts and its claims by taking out the ratio, so as to avoid the question of patentability of the count and claims to Bries. Accordingly, Bries' position is clear. Hazes argues that changing the counts and claims as proposed, e.g., by eliminating the ratio so that the counts and claims are patentable to Bries, is not [an acceptable reason] for changing the counts and claims, since Bries admits that the scope of the counts and claims do not change. The argument is not persuasive. Hazes has failed to sufficiently

demonstrate that changing the counts and claims in order for the counts and proposed claims to be patentable to the moving party is an unacceptable reason for doing so.

Additionally, Hazes argues that it would be unjust to allow Bries to amend the counts and add claims to its application in order to make Bries whole. The interference rules allow for a party to amend or add claims to its application, and to amend or add counts to an interference. The rules do not provide limiting reasons for doing so. Often times, when a party's claims are attacked, the party with an involved application will respond by moving to amend or add claims, to amend or change the count(s), in order to overcome the rejection. Such a response is not only acceptable, but is contemplated by the interference rules. See 37 CFR § 1.633(i).

Hazes also argues that it may not be able to meet the limitation that the film be "sufficiently extensible for debonding to occur but of sufficient tensile strength so as not to rupture during debonding" as recited in proposed count 3. However, Hazes' argument is conclusory. Hazes fails to direct us to evidence that would demonstrate that it could not meet the above quoted limitation. We will not simply take Hazes word that it may not be able to meet the limitation without sufficient proof to demonstrate the matter asserted. Johnston v. IVAC Corp., 885 F.2d 1574, 1581, 12 USPQ2d 1382, 1387 (Fed. Cir. 1989) (mere attorney argument is not a substitute for evidence of record). Even Hazes does not take a clear position on the matter. It states that it may not be able to meet the limitation. We will not deny Bries' motion based on Hazes unsupported assertion that it may not be able to meet a particular limitation.

Lastly, Hazes argues that there is no reason for having two separate counts, since there is no patentable distinction between the two proposed counts. In its reply, Bries states that it does

not oppose having one count, with the count being the disjunctive alternative of Bries' proposed claims 82 and 83.

For the above reasons, Bries preliminary motion 1 is granted-in part. Bries preliminary motion 2 is granted. Counts 1 and 2 are substituted with count 3, which is the disjunctive alternative of Bries' claims 82 and 83 as follows:

82. An adhesive film strip composite comprising:

a) an adhesive film strip:

(i) which is elastically or plastically extensible,

(ii) which exhibits an adhesion less than its cohesion,

(iii) the adhesion of which disappears on extension,

(iv) which, when bonded to a substrate, can be released from said substrate by pulling on the adhesive film strip in the direction of the plane of the bond formed between said adhesive film strip and said substrate;

(v) which, is sufficiently extensible for debonding to occur but of sufficient tensile strength so as not to rupture during debonding; and

b) a plurality of hook or loop fasteners adhered to one side of said adhesive film strip in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners.

OR

83. In a method comprising bonding an adhesive film strip to a substrate, and optionally thereafter releasing said adhesive film strip from said substrate by pulling on said adhesive film strip in the direction of the plane of the bond formed between said adhesive film strip and said substrate, the improvement which comprises employing as said adhesive film strip the adhesive film strip according to claim 82.

Hazes preliminary motions 2 and 7

Hazes, through its preliminary motions 2 and 7, seeks to be accorded benefit of German Patent Application No. DE 197 26 375, filed 21 June 1997 for the original counts (preliminary motion 2) and for Bries proposed counts 3 and 4 (preliminary motion 7). Since we have adopted Bries proposed count 3 as modified, and have substituted original counts 1 and 2 with count 3, Hazes preliminary motion 2 is dismissed as moot⁴. In order to be accorded benefit, Hazes' priority application need describe an enabling embodiment within the scope of the count. Weil v. Fritz, 572 F.2d 856, 865-66 n.16, 196 USPQ 600, 608 n.16 (CCPA 1978); Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975).

Count 3 that has been adopted as discussed above, includes the limitations that (1) the film strip is elastically or plastically extensible, (2) the film strip exhibits an adhesion less than its cohesion, and (3) the adhesion disappears on extension. In its motion 7, Hazes argues that it has written description for functional limitations (1)-(3) by way of claims 5 and 6 of its German application. Claim 5 depends from either claim 1 or claim 2. Claim 6 depends from either claim 1 or claim 2. Claim 5 recites that the adhesive film strips are "elastically or plastically extensible." Claim 6 recites that "the adhesion of the adhesive film strips (2, 8) is less than the cohesion, the adhesion largely disappears on extension...."

Hazes argues that the limitations of the count that are found in two separate dependent claims in its German application, neither of which depend from the other, satisfies the

⁴ The arguments made with respect to Hazes preliminary motion 2 are essentially the same as those made with respect to Hazes preliminary motion 7. That is, the disputed language is contained in original counts 1 and 2 as well as adopted count 3.

requirements for granting priority benefit. Hazes argument is not persuasive. That the inventors had possession of two separate embodiments (claim 5 and claim 6), does not necessarily mean that the inventors had possession of yet a third embodiment that is a combination of the features of the first two embodiments. Hazes has failed to direct us to where in the German application that the inventors had contemplated a film strip that is both plastically or elastically extensible and that exhibits an adhesion less than its cohesion, the adhesion of which disappears on extension.

It may be that it would have been obvious, at the time of the invention, to combine the features of the German application claim 5 with the features of the German application claim 6. However, the question is not one of obviousness. Rather, the query is whether Hazes, at the time of filing the German application, had possession of an enabling embodiment within the scope of the count. Here, Hazes has failed to satisfy its burden to demonstrate that it should be accorded benefit, for the purposes of priority, of its German application. Accordingly, Hazes preliminary motion 7 is denied.

Hazes preliminary motion 3 to add to the interference its reissue application

Hazes seeks to add its reissue application 10/192,146 to the interference. Claim 1 of the reissue application, from which all of the remaining claims 2-15 depend, differs from Hazes involved claim 1 in that the limitation "in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners" has been removed.

As the movant, Hazes must demonstrate that the reissue claims it seeks to add to the interference interfere-in-fact with Bries' involved claims. See Paper 1, Standing Order § 24.

Instead, Hazes compares the reissue claims with the count and concludes that since the reissue claims are broader in scope than the count, then the claims should correspond to the count. Hazes' argument is flawed. Original count 1 is Hazes involved claim 1. By comparing its reissue claims to count 1 (Hazes claim 1), Hazes is in essence comparing one set of its own claims with another set of its own claims. However, Hazes must compare its claims with Bries claims in order to demonstrate that there is an interference-in-fact. Furthermore, that analysis is a two way analysis. See, Eli Lilly v. Board of Regent of the Univ. of Wash., 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003). Thus, Hazes must demonstrate that (1) at least one of Hazes' reissue claims anticipates or renders obvious one of Bries' claims and (2) that the same Bries' claim anticipates or renders obvious the same Hazes' claim. No such analysis was performed.

During oral argument, the panel expressed concern to 3M's counsel that no showing of an interference-in-fact had been made in the Hazes preliminary motion to add the reissue application (Paper 114 at 36-37). In response, counsel for 3M requested time to respond. A paper entitled "3M'S RESPONSE TO THE PANEL'S INQUIRY" was filed (Paper 115). That paper states that "3M does not and will not assert that any of the claims in Hazes's reissue application are patentably distinct from any of the claims in Bries's application." Ordinarily such a statement would not meet the requirements necessary to demonstrate that an interference-in-fact exists. However, based on the specific facts of this case, including 3M's admission against interest⁵, and in light of the language being omitted from Hazes original claims, the Hazes motion in

⁵ 3M's counsel requested that the reissue application be added to ensure that if the underlying Hazes patent lost on priority then the Hazes reissue would likewise be found unpatentable. (Paper 114 at 23-26).

combination with 3M's statement is sufficient in this particular case to demonstrate that there is an interference-in-fact between Hazes reissue claim 1 and Bries added claim 82. Accordingly, Hazes preliminary motion 3 is granted. Hazes reissue application 10/192,146 is added to the interference.

The remaining preliminary motions

Hazes has filed a preliminary motion 5 to substitute a single count 3 for original counts 1 and 2. Hazes' proposed count 3 is original count 1 or count 2. Hazes proposed count 3 is similar to the count 3 adopted, except that the adopted count 3 eliminates the ratio limitations. For the reasons discussed *supra*, in connection with Bries' preliminary motion 1, we have adopted count 3 in which the ratio is eliminated and a single count is adopted, and thus have addressed Hazes arguments with respect to Hazes preliminary motion 5. Accordingly, that portion of Hazes preliminary motion 5 seeking to substitute its count 3 is denied.

Contingent upon adding its reissue application to the interference, Hazes alternatively moves for its proposed count 4. The proposed count 4 is the reissue application claim 1 or reissue application claim 11. The proposed count 4, like reissue application claim 1, eliminates the limitation "in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners." Bries, through its preliminary motion 3, proposes to adopt counts 5 and 6 for counts 1 and 2, contingent upon the adding of Hazes reissue application to the interference. Bries' proposed count 5 is similar to Hazes reissue claim 1, in that it eliminates the limitation "in such a way that said hook or loop fasteners are free to be fastened to mating loop or hook fasteners." Bries' proposed count 5 also eliminates the ratio from the reissue claim 1. Hazes

seeks benefit of its German application for all alternatives of the count, including original counts 1 and 2, as to its reissue application (Hazes preliminary motions 4, 6, and 8). Bries preliminary motion 4 seeks leave to add claims 86-90 to its application, which are similar to Hazes reissue application claims, except that the proposed claims eliminate the ratio.

During oral argument, counsel for 3M agreed that if the panel determined that Hazes should not be accorded benefit of its German application for the purposes of priority with respect to its involved patent, that Hazes would also not be entitled to the benefit of the German application for its reissue application that it seeks to add to the interference (Paper 114 at 22-24). Indeed, all of the variations of the count(s) in contemplation of adding the Hazes reissue application, include the limitations that (1) the film strip is elastically or plastically extensible, (2) the film strip exhibits an adhesion less than its cohesion, and (3) the adhesion disappears on extension. As discussed in connection with Hazes preliminary motion 7, Hazes has failed to direct us to where in the German application that the inventors had contemplated a film strip that is both plastically or elastically extensible and that exhibits an adhesion less than its cohesion, the adhesion of which disappears on extension. Hazes failed to sufficiently demonstrate that the German application's two mutually exclusive dependent claims 5 and 6, without more, constitute an enabling embodiment within the scope of the various counts.

Counsel for 3M agreed that if the reissue application was added solely for the purpose of entering judgment against it, on the basis that Hazes was not entitled to the benefit of its German patent application for its reissue application, then there would be no reason to decide the remaining preliminary motions regarding count and claim construction with respect to Hazes

reissue application (Paper 114 at 29-34). Accordingly, we dismiss as moot Bries preliminary motions 3 and 4, Hazes preliminary motions 4, 6 and 8, and that portion of Hazes preliminary motion 5 seeking to add count 4. For the purpose of entering judgment against Hazes reissue application claims 1-15, those claims are designated as corresponding to count 3.

Motions to suppress

Both Hazes and Bries filed motions to suppress certain evidence (Papers 90 and 95). During oral argument, counsel for 3M withdrew from consideration both motions to suppress (Paper 114 at 8). Accordingly, Bries motion to suppress and Hazes motion to suppress are dismissed.

D. Redeclaration of Interference

This interference is herein re-declared to the following extent:

1. Hazes reissue application 10/192,146⁶, filed 10 July 2002 is added to the interference.
2. Original counts 1 and 2 are substituted with count 3.
3. Count 3 is:

Bries claim 82

or

Bries claim 83

4. The parties' claims corresponding to count 3 are:

Hazes 6,086,973 patent: 1-13

⁶ Hazes reissue application has been assigned to 3M. According to PTO records, the assignment was executed on 12 June 2003 and recorded on 11 July 2003.

Hazes 10/192,146 application: 1-15

Bries: 68-85

E. Judgment

Junior party Hazes is not entitled to the benefit of its German Patent Application No. DE 197 26 375, filed 21 June 1997 for either its patent or reissue application. Accordingly, judgment is entered against junior party Hazes. Furthermore, as discussed *supra*, in connection with Hazes preliminary motion 1, Bries does not have written description for its claims 68-81. Therefore, it is

ORDERED that judgment as to the subject matter of count 3 is herein entered against junior party HANS HAZES ;

FURTHER ORDERED that junior party HANS HAZES is not entitled to its U.S. patent 6,086,973 claims 1-13 or its reissue application 10/192,146 claims 1-15 which correspond to count 3;

FURTHER ORDERED that the examiner shall enter the Bries amendment adding claims 82-85 to application 08/989,507;

FURTHER ORDERED that Bries claims 68-81 are unpatentable to Bries under 35 U.S.C. § 112, ¶1;

FURTHER ORDERED that if there is a settlement agreement, the parties should note the requirements of 35 U.S.C. § 135(c) and 37 CFR § 1.666; and

cc (via Federal Express):

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