

The opinion in support of the decision being entered today is not binding precedent of the Board.

Filed by: Merits Panel

Interference Trial Section, Mail Stop INTERFERENCE
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P. O. Box 1450, Alexandria, Virginia 22313-1450
Tel: 703-308-9797 Fax: 703-305-0942

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

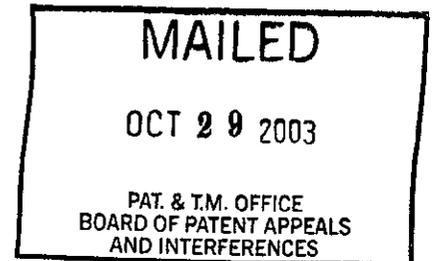
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MARK J. SCHAEZNER, LORI G. SWANSON,
GREGORY S. MOWRY and LANCE E. STOVER

Junior Party,
(Patent No. 5,831,797)¹

v.

GORDON R. KNIGHT
Senior Party
(Application 09/262,831).²



Patent Interference No. 105,058

Before LEE, GARDNER-LANE and TIERNEY, Administrative Patent Judges.
LEE, Administrative Patent Judge.

**Entry of Judgment and
Decision on Joint Preliminary Motion 3**

¹ Based on Application 08/931,431, filed September 16, 1997. The real party in interest is Seagate Technology, LLC. Accorded the benefit of provisional Application 60/053,485, filed July 23, 1997.

² Filed March 5, 1999. The real party in interest is TeraStor. Accorded the benefit of Application 08/926,907, filed September 10, 1997, and Application 08/641,513, filed May 1, 1996.

Interference No. 105,058
Schaenzer v. Knight

A. Background Facts

1. This interference was declared on November 25, 2002.
2. Junior party Schaenzer, whose real party in interest is Seagate Technology, LLC, is involved on the basis of its Patent No. 5,831,797.
3. Senior party Knight, whose real party in interest is TeraStor, is involved on the basis of its Application 09/262,831.
4. The count of the interference is Count 1:

Claim 1 of Schaenzer's Patent No. 5,831,797
or
Claim 46 of Knight's Application 09/262,831
5. As indicated in the Notice Declaring Interference (Paper No. 1), junior party Schaenzer's claims 1-15 were designated as corresponding to the count.
6. As indicated in the Notice Declaring Interference (Paper No. 1), senior party Knight's claims 46-63 were designated as corresponding to the count.
7. On January 22, 2003, the Administrative Patent Judge (APJ) issued an order directing the parties to propose several time periods including the time period within which to file preliminary motions. (Paper No. 20)
8. On February 26, 2003, the parties proposed that preliminary motions be due on May 16, 2003, which proposal was approved by the APJ.

Interference No. 105,058
Schaenzer v. Knight

9. On May 15, 2003, the parties jointly obtained a first extension of the time for filing preliminary motions, on the ground of needing time to review a draft settlement agreement. The due date for filing preliminary motions was pushed back to June 6, 2003. Paper No. 24.

10. On June 6, 2003, the parties jointly obtained a second extension of the time for filing preliminary motions, on the ground of needing time to review a draft settlement agreement. The due date for filing preliminary motions was pushed back to June 20, 2003. Paper No. 25.

11. On June 20, 2003, the parties jointly obtained a third extension of the time for filing preliminary motions, on the ground of needing time to review a draft settlement agreement. The due date for filing preliminary motions was pushed back to July 11, 2003. Paper No. 26.

12. On July 11, 2003, the parties jointly obtained a fourth extension of the time for filing preliminary motions, on the ground of needing time to review a draft settlement agreement. The due date for filing preliminary motions was pushed back to July 25, 2003. Paper No. 27.

13. On July 25, 2003, the parties jointly obtained a fifth extension of the time for filing preliminary motions, on the ground of needing time to review a draft settlement agreement. The due date for filing preliminary motions was pushed back to August 1, 2003. Paper No. 28.

14. On August 1, 2003, the parties jointly obtained a sixth extension of the time for filing preliminary motions, on the ground of needing time to review a draft settlement agreement. The due date for filing preliminary motions was pushed back to August 8, 2003. Paper No. 29.

15. On August 11, the parties filed an interference settlement agreement pursuant to 37 CFR § 1.666.

16. On August 11, 2003, the parties jointly filed two papers each captioned "PRELIMINARY MOTION UNDER RULE 633," the first of which sought to designate claims 3-9 of the junior party as not corresponding to the count and to cancel claim 48 of the senior party, and the second of which sought to have judgment of priority awarded in favor of the senior party. These papers are not accompanied by any certificate of mailing pursuant to 37 CFR § 1.8.

17. On August 14, 2003, we decided the two joint preliminary motions, denying the motion seeking to designate junior party's claims 3-9 as not corresponding to the count (referring to the same as Joint Preliminary Motion 1) and dismissing the motion seeking to have judgment awarded in favor of the senior party (referring to the same as Joint Preliminary Motion 2).

18. In our decision on Joint Preliminary Motion 1, it is stated (at 3-5):

By Joint Preliminary Motion 1 the parties seek to redefine the interference by designating claims 3-9 of junior party Schaenzer's involved patent as not corresponding to the count. Note 37 CFR § 1.637(c)(4)(ii) which provides that a preliminary motion seeking to designate an application or patent claim as not corresponding to a count shall "Show that the claim does not define the same patentable invention as any other claim whose designation in the notice declaring the interference as corresponding to the count the party does not dispute." Also, per 37 CFR § 1.637(a), a party filing the motion has the burden of proof to show that it is entitled to the relief sought in the motion. The initial designation of claim correspondence in the Notice Declaring Interference is presumed correct unless shown otherwise by the moving party.

Here, the motion does not explain in any meaningful manner why each of the claims now sought to be designated as not corresponding to the count does not define the same patentable invention as any other claim whose designation in the notice declaring the interference as corresponding to the count the party does not dispute. Merely counsel's statement that Schaenzer's patent claims 3-9 do not define the same patentable invention as any other claim corresponding to Count 1 does not show or establish that the statement is true. At most, there is no disagreement between the parties on this issue, but that is not sufficient to

demonstrate that the original designation of claims as corresponding or not corresponding to the count is wrong. Note that the motion is also not supported by testimony of any technical witness with regard to the significance of any particular feature shared by Schaenzer's patent claims 3-9 and not present in any other claim corresponding to the count, or the state of prior art relative to that particular feature. The motion is unpersuasive as to any reason to change the initial designation of claim correspondence and thus the burden of proof applicable to a motion has not been satisfied.

It is well established that argument of counsel cannot take the place of evidence lacking in the record. Knorr v. Pearson, 671 F.2d 1368, 1373, 213 USPQ 196, 200 (CCPA 1982); Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972). That is so whether or not both parties' counsel jointly make the same argument. The matter of claim correspondence will not be determined merely by the stated opinion shared by the parties.

For the foregoing reasons, Joint Preliminary Motion 1 is **denied**.

19. Also on August 14, 2003, we issued an order for the junior party to show cause why judgment should not be entered against the junior party on the ground that the junior party had failed to file a preliminary statement. The junior party has not responded to that order.

20. In a telephone conference held on August 20, 2003, between the APJ and respective counsel for the parties, counsel for the junior party asserted (1) that it was not necessary for the parties to submit evidence to establish the assertions in the preliminary motion, and (2) that the APJ had indicated in an earlier telephone conference call that he ("the APJ") would not stand in the way of any settlement agreement between the parties so long as it was reasonable. See Summary of Telephone Conference – Paper No. 34.

Interference No. 105,058
Schaenzer v. Knight

21. Also in the telephone conference held on August 20, 2003, counsel for the junior party asked the APJ where in the interference rules is a requirement that the moving party shall bear the burden of proof. The APJ directed counsel's attention to 37 CFR § 1.637(a). See Summary of Telephone Conference – Paper No. 34.

22. At the conclusion of the telephone conference on August 10, 2003, the APJ authorized the parties to re-file their joint preliminary motion 1 as a joint preliminary motion 3 to eliminate the deficiencies articulated by the motions panel in the decision on joint preliminary motion 1, provided however, that the parties will acknowledge (See Summary of Telephone Conference – Paper No. 34):

(1) that they are charged with the burden of proof under 37 CFR § 1.637(a),

(2) the requirement of 37 CFR § 1.637(c)(4)(ii) to make a showing that claims 3-9 are not directed to the same patentable invention as any other claim (meaning all claims) whose correspondence to the count is not in dispute,

(3) that mere counsel's argument does not constitute evidence, and

(4) that the motion has to be based on evidence, e.g., testimony from one with ordinary skill in the art with regard to factual inquiries for an obviousness determination [for instance, if any feature is deemed patentably significant, there should be testimony regarding the state of ordinary skill in the art in connection with that feature, e.g., to what extent is that feature known by one with ordinary skill in the art];

23. Counsel for both parties accepted the condition set by the APJ and re-filed their preliminary motion 1 as preliminary motion 3, to fix the deficiencies noted in our decision on

Interference No. 105,058
Schaenzer v. Knight

preliminary motion 1. Preliminary motion 3 was not deemed untimely because it was expressly authorized by the APJ.

24. On September 10, 2003, the parties re-filed their preliminary motion 1 as preliminary motion 3, again seeking to designate claims 3-9 of the junior party as not corresponding to the count, and also seeking to cancel claims 48 and 57 of the senior party.

25. Schaenzer's claim 1 is an independent claim directed to an optical disc data storage system and recites, in pertinent part:

a slider coupled to the distal end of the actuator arm and carrying the transducing element, the slider having a top surface and an air bearing surface adapted to move adjacent the data surface as the disc rotates, the slider including a mesa formed on the air bearing surface and extending from the air bearing surface toward the data surface and configured to accommodate the coil,

26. Schaenzer's claim 4 depends directly from claim 1 and recites: "The optical disc data storage system of claim 1 wherein the mesa has a tapered side wall."

27. Schaenzer's claims 5-9 each depend either directly or indirectly from Schaenzer's claim 4 and thus each includes the feature recited in claim 4, i.e., that the mesa on the slider has a tapered side wall.

28. Schaenzer's claim 3 depends from claim 2, and recites:

The optical disc data storage system of claim 2 wherein the mesa includes a plateau adapted to couple light to the data surface through an evanescent field.

29. Re-filed preliminary motion 3 relies on a declaration of Richard P. Larson (Exhibit 2007) who is not a named inventor in the junior party's involved application but who had "worked at Seagate Technology LLC and other predecessor companies" for more than 19 years.

30. In his declaration, with regard to U.S Patent No. 5,345,353 (“the Krantz ‘353 patent”), Richard P. Larson states:

The ‘353 patent does not suggest, show or describe a slide having a plateau that couples light to a data surface through an evanescent field, a mesa having a tapered side wall, a tapered side wall that is formed by at least one step in the mesa, or coils surrounding a stepped mesa.

31. In his declaration, Richard P. Larson further states:

As one skilled in the art of coil design, I am unaware of any public disclosure, description, or suggestion of the additional structure claimed in claims 3-9 of the ‘797 patent [Schaenzer’s involved patent] prior to January 1, 1998.

32. After submission of the parties’ joint preliminary motion 3, the APJ asked respective counsel of the parties, in a telephone conference call on September 12, 2003, if Seagate Technology, LLC, the real party in interest of the junior party, could make a representation with regard to “non-awareness of prior art which disclose use of a mesa [in a slider] having a plateau (claim 3) and use of a mesa [in a slider] having a tapered side wall (claim 4).” (Paper No. 39 – Summary of Telephone Conference Call)

33. In the conference call of September 12, 2003, counsel for the junior party represented that he could, on behalf of Seagate Technology, LLC, make the representation, albeit not having checked with every single engineer employed by Seagate Technology, LLC, that certain structural features required by Schaenzer’s claims 3 and 4 are not disclosed in any known prior art and that he could particularly specify those features. (Paper No. 39 – Summary of Telephone Conference Call). On that basis, the APJ authorized the filing by the junior party of a supplement to joint preliminary motion 3.

Interference No. 105,058
Schaenzer v. Knight

34. On September 22, 2003, Paul T. Dietz, Esq., on behalf of Seagate Technology, LLC, filed a supplement to joint preliminary motion 3. However, rather than representing that certain particular features specified in claims 3 and 4 are not disclosed in any known prior art, as was discussed and agreed to in the telephone conference call conducted on September 12, 2003, Mr. Dietz represented only that Seagate Technology, LLC deems the entire combination inclusive of the elements of independent claim 1 or other claim 2, whichever the case may be, to be novel.

Discussion

The joint preliminary motion 3 is a re-incarnation of joint preliminary motion 1 which was filed without any supporting evidence in the form of affidavits or declarations. The APJ authorized the re-filing of joint preliminary motion 1 as preliminary motion 3, subsequent to expiration of the time period for filing preliminary motions, on the condition that the parties recognize that the moving party bears a burden of proof as is provided under 37 CFR § 1.637(a), that mere attorney argument does not constitute evidence, and that the motion has to be based on evidence, e.g., testimony on the extent to which a feature relied on for patentable distinction was known or not known in the art. See Fact ¶ 22. Also, despite having obtained six extensions of time, the parties filed preliminary motion 1 three days late. We overlooked the lateness and imposed no penalty.

Joint preliminary motion 3 contains two requests, one to designate junior party Schaenzer's claims 3-9 as not corresponding to the count and one to have senior party Knight's

Interference No. 105,058
Schaenzer v. Knight

claims 48 and 57 cancelled. We assume that the latter request is contingent upon the granting of the former. In any event, party Knight is free to cancel its own application claims at any time once prosecution of its involved application is resumed after termination of this interference, without need for approval by the board.

The request to have Schaenzer's claims 3-9 designated as not corresponding to the count is **denied**. The request to have senior party Knight's claims 48 and 57 cancelled is **dismissed**.

Thus, joint preliminary motion 3 is **denied-in-part**, and **dismissed-in-part**.

Section 1.637(c)(4)(ii), of Title 37, Code of Federal Regulations provides that a preliminary motion seeking to designate an application or patent claim as not corresponding to a count shall "[s]how that the claim does not define the same patentable invention as any other claim whose designation in the notice declaring the interference as corresponding to the count the party does not dispute." Also, per 37 CFR § 1.637(a), a party filing the motion has the burden of proof to show that it is entitled to the relief sought in the motion. Thus, the initial designation of claim correspondence in the Notice Declaring Interference is presumed correct and the burden is on the moving party or parties seeking to change the status quo to make a sufficient showing. The situation is no different where both or all parties to the interference desire the same relief and together file a joint motion. A joint motion still has to be supported by sufficient evidence and the burden of proof still has to be met, or else two parties can circumvent the law by agreeing to terms which may make economic sense to the parties but lack sufficient legal foundation.

Interference No. 105,058
Schaenzer v. Knight

Unlike a civil litigation between two private parties, an interference proceeding is initiated by the U.S. Patent and Trademark Office. It cannot be terminated at will by agreement between the parties in a manner that provides no reasonable assurance that applicable patent laws have been correctly applied. The parties have to demonstrate the legal soundness of the changes they seek. For instance, if the claims of the parties are drawn to the same patentable invention, the parties may not agree to “live with” or “tolerate” each other by allowing each to retain some claims simply by agreeing to have certain claims re-designated as not corresponding to the count.

Here, the parties have settled the interference. Junior party filed no response to our show cause order and appears ready to accept entry of adverse judgment. However, before accepting adverse judgment, it desires to carve out its claims 3-9 from the effects of that adverse judgment by designating them as not corresponding to the count. If that relief is granted, the junior party will walk away with its claims 3-9 intact despite its having lost this interference. The senior party agrees to that outcome. Hence, the parties have jointly moved to have junior party’s claims 3-9 designated as not corresponding to the count.

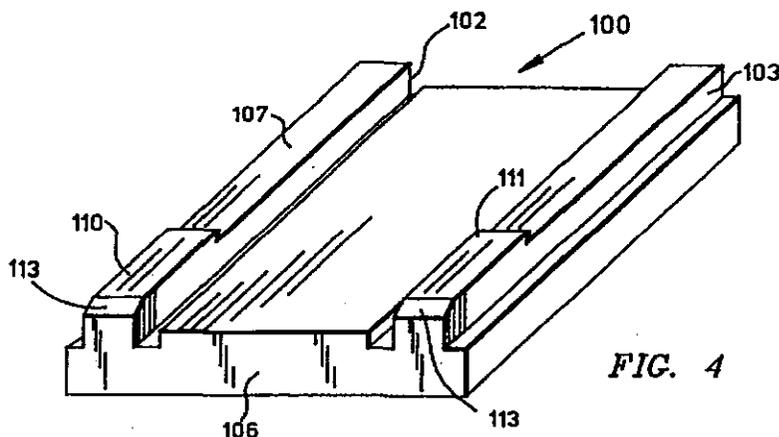
In provoking this interference, senior party Knight had represented that claim 3 of Schaenzer’s involved patent should be designate as corresponding to the count. It was represented by Knight that this claim does “not provide elements which would warrant a finding of separate patentability” (Exhibit 2004, at 2). Also in provoking this interference, senior party Knight represented that claim 4 of Schaenzer’s involved patent should be designated as corresponding to the count because the claim would have been obvious in view of U.S. Patent

Interference No. 105,058
Schaenzer v. Knight

No. 5,345,353 which discloses "a slider having a step (mesa) with a tapered wall" (Exhibit 2004, at 3). We have not been informed why the senior party has changed its mind about whether Schaenzer's claims 3 and 4 should be designated as corresponding to the count. Note further that the senior party has not specifically recanted its previous representation that U.S. Patent No. 5,345,353 discloses a slider having a mesa with a tapered wall.

In this circumstance, it is incumbent upon the moving parties, at a minimum, to explain away the pertinence of U.S. Patent No. 5,345,353, as far as the disclosure of a slider having a mesa with a tapered wall, as is required by Schaenzer's claims 4-9, is concerned. Moreover, it is our view that since the motion should establish a negative assertion, i.e., that the subject claims would not have been obvious over any of Knight's claims whose correspondence is not in dispute, the movant must also represent either that it is not aware of prior art which discloses use of a slider including a plateau adapted to couple light to the data surface through an evanescent field, as is required by Schaenzer's claim 3, or that while there is such prior art it would not have been reasonable to combine it with the subject matter of Knight's claims whose correspondence to the count is not in dispute. Similarly, the movant should represent either that it is not aware of prior art which discloses use of a slider having a mesa with a tapered wall, as is required by Schaenzer's claims 4-9, or that while there is such prior art it would not have been reasonable to combine it with the subject matter of Knight's claims whose correspondence to the count is not in dispute.

Joint preliminary motion 3 does not explain in a meaningful manner why U.S. Patent No. 5,345,353 does not disclose, in the context of an optical disc data storage system, a slider having a mesa with a tapered side wall. In that regard, the declaration of Richard P. Larson simply states in a conclusory manner that U.S. Patent No. 5,345,353 does not suggest, show or describe a slider having “a mesa having a tapered side wall,” or “a tapered side wall that is formed by at least one step in the mesa” (Exhibit 2007, ¶ 8). On its face, Figure 4 of U.S. Patent No. 5,345,353, reproduced below, appears to show mesas 110 and 111 protruding from the surface of the slider 100, and each mesa has a tapered side wall 113:



If the above-illustrated structure is not considered a slider having a mesa with a tapered side wall, that has to be explained.

Interference No. 105,058
Schaenzer v. Knight

In Paragraph No. 42 of the Standing Order attached to the Notice Declaring Interference (Paper No. 1), the parties were explicitly advised that affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based and also that expert opinions expressed without disclosing the underlying facts or data may be given little or no weight. Paragraph No. 42 of the Standing Order cites to Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997), which states: "Nothing in the [Federal Rules of evidence] or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness."

Because the assertion in ¶ 8 of the declaration of Richard P. Larson is merely conclusory and the underlying reasoning has not been disclosed, we decline to give any weight to Mr. Larson's testimony in that regard, especially in light of what is apparent from Figure 4 of U.S. Patent No. 5,345,353. Consequently, the parties have failed to demonstrate that Schaenzer's claims 4-9 should be designated as not corresponding to the count.

As for Schaenzer's claim 3, it is noted that ¶ 13 of Richard P. Larson's declaration states:

As one skilled in the art of coil design, I am unaware of any public disclosure, description, or suggestion of the additional structure claimed in claims 3-9 of the '797 patent prior to January 1, 1998.

Richard P. Larson is not one of the four named inventors on Schaenzer's involved patent, and he is also a long-time employee of the junior party's real party in interest, Seagate Technology, Inc. Based on those facts, a question immediately comes to mind, and that is, did the junior party ask numerous engineers the same question and then simply submit the answer from the one

Interference No. 105,058
Schaenzer v. Knight

engineer whose answer supports the relief requested. An unexplained failure by the party with the burden of proof to produce the most probative evidence can, itself, be very telling. Cf. Crown International v. Solutia, Inc., 289 F.3d 1367, 1377 n.4, 62 USPQ2d 1917, 1923 n.4 (Fed. Cir. 2002) (expressing frustration with a party's failure to generate test data to support its argument); accord Borrer v. Herz, 666 F.2d 569, 573-74, 213 USPQ 19, 23 (CCPA 1981) (considering the effect of missing inventor testimony). Had the testimony of the inventors been submitted, there would have been no issue with regard to selective production of testimony.

Because the administrative patent judge was disturbed by the potential of selective production of testimony, counsel for the junior party was asked to cure the problem by making a written representation, on behalf of the real party in interest, that the particular features specified in Schaenzer's claims 3 and 4 and relied on for patentable distinction were not known in the art at the time of the applicant's invention. See Fact ¶ 32. Counsel for the junior party agreed. See Fact ¶ 33. Joint preliminary motion 3 was then supplemented by a filing on September 17, 2003. (Paper No. 40). In that supplement, however, rather than representing that the particular features added by claims 3 and 4 and relied on for patentable distinction, i.e., a mesa including a plateau adapted to couple light to the data surface through an evanescent field (claim 3) and a mesa having a tapered side wall (claim 4), were not known, the representation was made that the entirety of the subject matter of claims 3 and 4 including the features of independent claim 1 and dependent claim 2, whichever the case may be, were novel. As such, the representation actually made by counsel for the junior party is substantively very different from and not an equivalent by

Interference No. 105,058
Schaenzer v. Knight

any means to the one he had indicated that he could and would make on behalf of the junior party's real party in interest, i.e., Seagate Technology, Inc. The representation is of no value since the issue is non-obviousness or patentable distinction based on the particular features recited in the body of Schaenzer's claims 3 and 4 and not anticipation of the entire combination.

The failure by junior party's counsel to submit the representation as had been agreed to during the telephone conference on September 12, 2003, i.e., changing the focus from the structural details recited in the body of claims 3 and 4 to the entire combination inclusive of the elements of claims 1 and 2, raises some serious questions, both as to the issue of potential selective production of testimony as discussed earlier, and as to whether Richard P. Larson, when making reference in his declaration to "the additional structure claimed in claims 3-9 of [Schaenzer's involved patent]," was actually contemplating the entire combination resulting from the added structure. Based on counsel for counsel for junior party's submitting a representation that is far different from one he had agreed to make and without first informing the board that the representation forthcoming is not the one the administrative patent judge had specifically asked for, the junior party has lost credibility with the board. We decline to give junior party the benefit of the doubt that Richard P. Larson meant to refer only to the particular features recited in claims 3 and 4, i.e., mesa on a slider, which includes a plateau adapted to couple light to the data surface through an evanescent field (claim 3), and mesa on a slider, which has a tapered side wall (claim 4), and not the entire combination resulting from adding these particular features.

The parties have been given three chances to submit sufficient evidence to support a prima facie showing that Schaenzer's claims 3-9 should be designated as not corresponding to the count. Through their successive submissions as discussed above, it is evident that the parties are either incapable of making or reluctant to make a specific representation (1) that a slider including a mesa having a tapered side wall was not previously known, and (2) that a slider including a mesa having a plateau adapted to couple light to the data surface through an evanescent field was not previously known. Those features are what the parties now rely on for patentable distinction of Schaenzer's claims 3-9 over Knight's claims corresponding to the count.

Moreover, in its supplement to preliminary motion 3, the junior party candidly revealed that its real party in interest, Seagate Technology, Inc., in connection with the issue of seeking to designate claims 3-9 as not corresponding to the count, has not

- (1) interviewed its employees,
- (2) searched through or reviewed its employees records,
- (3) searched through or reviewed the files corresponding to the over two thousand issued U.S. patents assigned to Seagate Technology LLC, or
- (4) conducted a prior art search.

Based on the above-noted representation, the parties appear to have no reasonable basis to seek the relief requested in joint preliminary motion 3. Where there is a burden of proof to overcome, the admitted failure to conduct a prior art search and concurrent failure to interview pertinent personnel with regard to the features relied on for patentable distinction and for establishing

Interference No. 105,058
Schaenzer v. Knight

nonobviousness is fatal. The board does not rubber stamp the wishful thinking of a party, even if it is jointly wished by all parties in the interference, without sufficient supporting evidence and legally sound rationale.

It is now time appropriate to enter judgment.³

Judgment

It is

ORDERED that judgment is herein entered against junior party MARK J.

SCHAENZER, LORI G. SWANSON, GREGORY S. MOWRY, and LANCE E. STOVER;

FURTHER ORDERED that junior party MARK J. SCHAENZER, LORI G.

SWANSON, GREGORY S. MOWRY, and LANCE E. STOVER is not entitled to its patent claims 1-15 which correspond to Count 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;

FURTHER ORDERED that a copy of this judgment be placed in the respective involved application or patent of the parties; and

³ The decision on joint preliminary motion 3, ordinarily an interlocutory order, is herein made final and merged with the judgment, because it is rendered by a three judge panel. Per Trial Section precedential opinion in Charlton v. Rosenstein, Interference No. 104,148, 2000 WL 1568294 (Bd. Pat. App. & Int. 2000), the scope of review for a motion decision by a three-judge panel by the same panel is, in effect, the same as that of a request for reconsideration, and there is no de novo review. In that connection, either party is free to file a request for reconsideration pursuant to 37 CFR § 1.658(b).

Interference No. 105,058
Schaenzer v. Knight

By Federal Express:

Attorney for junior party Schaenzer:

Paul T. Dietz, Esq.
Seagate Technology, LLC
Mail Stop NRW 097
7801 Computer Avenue South
Bloomington, Minnesota 55435

Attorney for senior party Knight:

Scott C. Harris, Esq.
4350 La Jolla Village Drive, Suite 500
San Diego, California 92122