

Filed by: Merits Panel  
Mail Stop Interference  
P.O. Box 1450  
Alexandria Va 22313-1450  
Tel: 571-272-4683  
Fax: 571-273-0042

Paper 26

Entered 24 March 2008

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**ZHIMING ZHANG**  
Junior Party  
(Patent D539,785),

v.

**ALLAN AMSEL**  
Senior Party  
(Application 29/218,897).

Patent Interference No. 105,550 (SCM)  
(Technology Center 2900)

Before LEE, LANE and MEDLEY, *Administrative Patent Judges*.  
MEDLEY, *Administrative Patent Judge*.

**Decision – Preliminary Motion– Bd.R. 104(c)**

**A. Introduction**

This interference was declared on 30 April 2007. Zhang, through its substantive motion 1, moves for benefit of an earlier application (Paper 17). Amsel filed an opposition (Paper 20) and Zhang filed a reply (Paper 21).

For the reasons that follow, Zhang substantive motion 1 is granted.

## **B. Findings of fact**

The following findings of fact as well as those contained elsewhere in this opinion are supported by a preponderance of the evidence.

1. Zhang is involved on the basis of patent D539,785, granted 3 April 2007, based on application 29/221,626, filed 21 January 2005 (Paper 1 at 3).

2. Amsel is involved on the basis of application 29/218,897, filed 9 December 2004.

3. Neither party has been accorded benefit of any earlier application.

4. Zhang real party in interest is Compupal (Group) Corporation (Paper 4).

5. Amsel real party in interest is Sakar International Inc. (Paper 9).

6. Count 1 is as follows:

The single claim of Amsel's Application 29/218,897

or

The single claim of Zhang's Design Patent D539,785

## **C. Analysis**

Zhang moves to be accorded benefit of Chinese application Serial No. 2004-30071308.2 ("the earlier application"), filed 6 August 2004. A motion to be accorded benefit of an earlier application must show that the application includes at least one constructive reduction to practice of the count. SO ¶ 208.4.1. A constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. § 102(g)(1) in a patent application of the subject matter of the count. Bd.R. 201. An earliest constructive reduction to practice means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including the involved application or patent. For the chain to be continuous, each subsequent application must have been copending

under 35 U.S.C. §§ 120 or 121 or timely filed under 35 U.S.C. §§ 119 or 365(a). *Id.* As an initial matter, Zhang’s application which matured into the involved Zhang patent was apparently timely filed under 35 U.S.C. § 119. Zhang’s U.S. application which matured into the involved Zhang patent was granted priority benefit under 35 U.S.C. 119 of the earlier application (Ex. 1001<sup>1</sup>).

The count is the single claim of Amsel’s application or the single claim of Zhang’s patent (FF 6). The single claim of Zhang is “the ornamental design for a speaker, as shown and described” (Ex. 1006) and the single claim of Amsel is “the ornamental design for a FOLDABLE SPEAKERS, as shown and described” (Ex. 1008). We focus our analysis on the Zhang alternative of the count, since Zhang need only demonstrate that its earlier application describes an enabling embodiment within the scope of either one of the count alternatives.

The Zhang claim includes the description and showing of eight figures. Figures 1 and 2 of the Zhang patent are nearly identical to the figures shown on the page labeled “1” (center bottom) of the earlier application. Figures 5 and 6 of the Zhang patent are nearly identical to the figures shown on page “2” of the earlier application. Figures 3 and 4 of the Zhang patent are nearly identical to the figures shown on page “3” of the earlier application (Ex. 1009 and Ex. 1006). In essence, all of these figures show various views of the speakers in a closed, or non turned position. A comparison of Zhang patent Figures 1-6 and all of the earlier application figures is made below.

---

<sup>1</sup> Zhang as the junior party in interference should have used the “2000” series for exhibits.

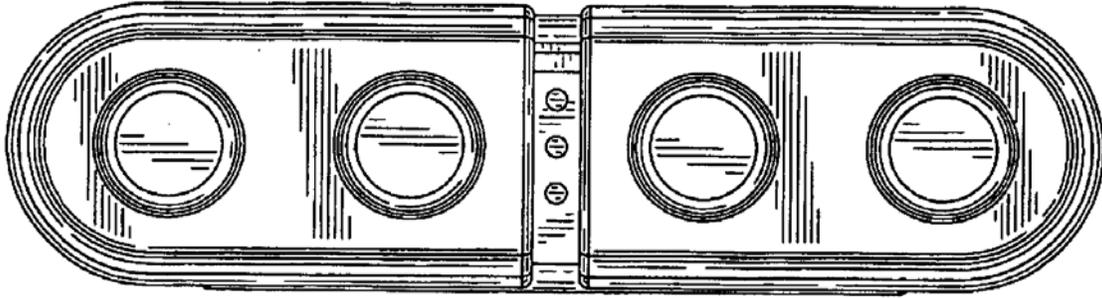
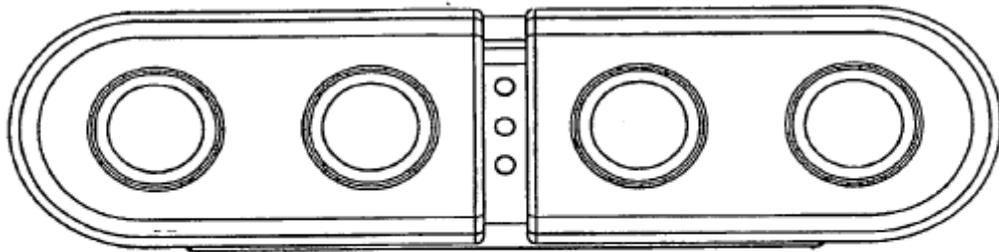


FIG. 1

Zhang Figure 1 from Zhang patent D539,785



主视图

Figure shown from page marked "1" (bottom center) from  
Zhang's earlier application

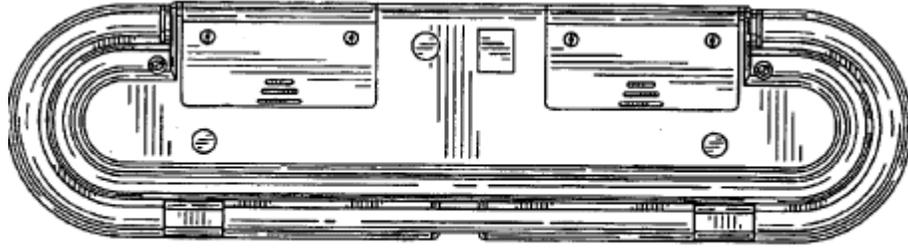
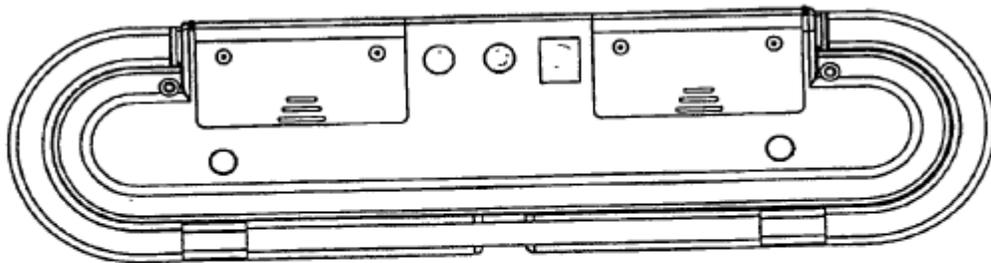


FIG. 2

Zhang Figure 2 from Zhang patent D539,785



后视图

Figure shown from page marked "1" (bottom center) from  
Zhang's earlier application

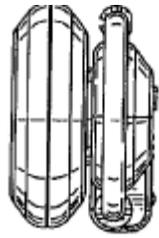
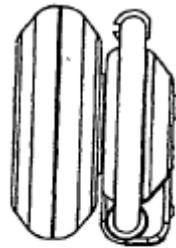


FIG. 3

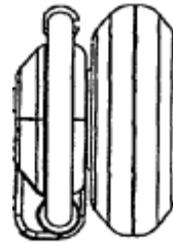


FIG. 4

Figures 3 and 4 from Zhang patent D539,785



右视图



左视图

Figures shown from page marked “3” (bottom center) from Zhang’s earlier application

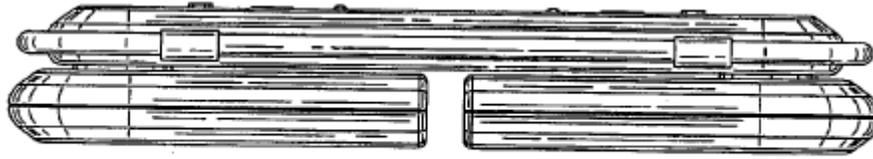
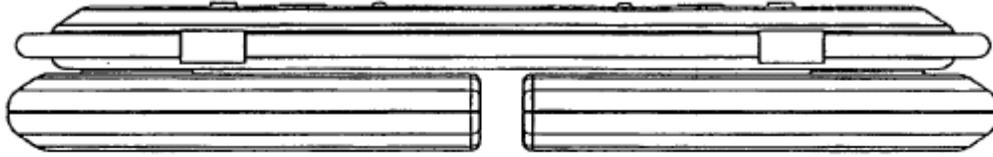


FIG. 5

Figure 5 from Zhang patent D539,785



俯视图

Figure shown from page marked "2" (bottom center) from  
Zhang's earlier application

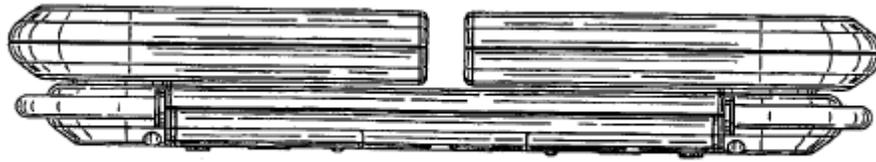
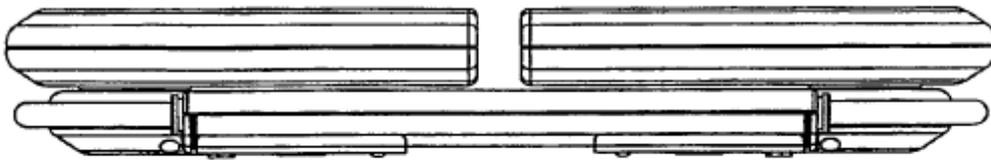


FIG. 6

Figure 6 from Zhang patent D539,785



仰视图

Figure shown from page marked "2" (bottom center) from  
Zhang's earlier application

The Zhang patent also includes two additional figures, Figures 7 and 8 that are not included in the earlier application. Zhang patent Figures 7 and 8 show the speakers in the open or "turning" position as seen below.

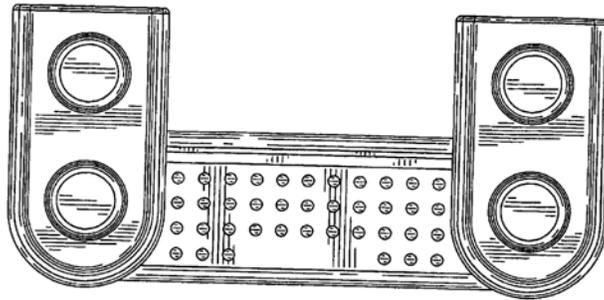


FIG. 7

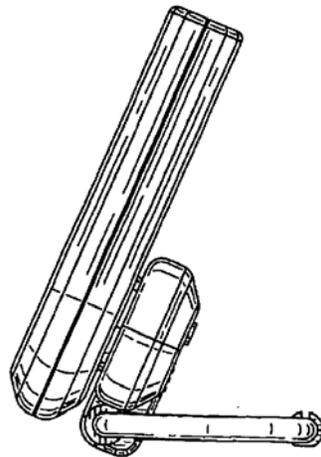


FIG. 8

Zhang characterizes the figures that show the turning or open configuration of the speakers, e.g., Zhang Figures 7 and 8, as one alternative embodiment of the count and the figures that show the various views of the closed position of the speakers, e.g., Zhang Figures 1-6, as at least one other embodiment of the count (Paper 17 at 9-11). Zhang argues that a single design claim may cover embodiments of different scope directed to the same inventive concept within a single application if the designs are not patentably distinct, citing *In re Rubinfeld*,

270 F.2d 391 (CCPA 1959). Zhang further argues that the at least two separate embodiments are not patentably distinct since the patent office allowed and issued the Zhang patent with the single claim (Paper 17 at 11). Zhang argues that for purposes of being accorded benefit for the interference, its earlier application need only enable and describe one embodiment within the scope of the count, citing *Weil v. Fritz*, 572 F.2d 856, 865 n.16 (CCPA 1978). Zhang concludes that since the earlier application describes and enables at least one embodiment within the scope of the count, e.g., the figures showing the various views of the closed position of the speakers, it should be granted priority benefit of the earlier application (Paper 17 at 12-16). Zhang has met its burden to establish that it is entitled to the relief requested, and so we consider Amsel's opposition.

Amsel did not file with its opposition a statement identifying any material facts in dispute (Paper 20). Board Rule 41.122(a) states that an opposition must include a statement identifying material facts in dispute and that any material fact not specifically denied shall be considered admitted. Since Amsel has not identified any material facts in dispute and has not specifically denied any material fact, Zhang's material facts are considered to be admitted by Amsel. On that basis alone Zhang's motion is granted.

In addition, Amsel has failed to demonstrate that the count does not include two patentably indistinct embodiments as demonstrated by Zhang. Instead, Amsel argues that the open configuration and closed configuration of the foldable speakers are two different positions of the same embodiment and not two different embodiments of the same design as Zhang argues. In support of the assertion, Amsel directs attention to the Amsel application description which makes no mention of a second embodiment (Paper 20 at 2).

Amsel fails to direct us to evidence or authority to support its argument that the open and closed configurations of the foldable speakers are a single embodiment. While we agree with Amsel that neither the Zhang specification nor the Amsel specification describe the open and closed configurations as two separate embodiments, Amsel has not explained the significance of the alleged deficiency. For instance, we do not know based on the record, why one of ordinary skill in the art viewing the Zhang figures alone, would not understand the figures to show two separate embodiments. Amsel relies on attorney argument, which is insufficient. *See Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (Argument of counsel cannot take the place of evidence lacking in the record). Furthermore, it would seem more logical that two different looks as viewed from the same angle and perspective reflect two separate embodiments. We note also that Amsel did not file a motion to redefine the count on the basis that the count includes two separately patentable embodiments.

Amsel argues that *Weil v. Fritz*, cited by Zhang for the proposition that the earlier application need only describe an enabling embodiment within the scope of the count, is inapplicable since that case was directed to a utility patent application involving chemicals and that the chemical case involving a genus and species has no applicability to the Amsel design case disclosing a single invention in two different positions. Amsel concludes that one of ordinary skill in the art, upon reviewing the earlier application, would not be taught how to make the U-shaped position (e.g., open or turning position), which is a substantial part of the design invention in Amsel's design patent case, and which is required for a full disclosure under 35 U.S.C. § 112 (Paper 20 at 2-3).

We understand Amsel to argue that Zhang’s earlier application must meet the full scope of the count under 35 U.S.C. § 112. However, that is not what is required for a party to be accorded priority benefit. The board rule requires that the moving party demonstrate that the earlier application includes at least one constructive reduction to practice of the count. SO ¶ 208.4.1. A constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. § 102(g)(1) in a patent application of the subject matter of the count. Bd.R. 201. Thus, the earlier application need not describe the full scope of the count. All that is required is that the earlier application describe an enabled embodiment within the scope of the count.

For all of these reasons, Zhang’s motion 1 is GRANTED.

|                             |   |                 |
|-----------------------------|---|-----------------|
| <u>/Jameson Lee/</u>        | ) |                 |
| JAMESON LEE                 | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| <u>/Sally Gardner Lane/</u> | ) |                 |
| SALLY GARDNER LANE          | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
| <u>/Sally C. Medley /</u>   | ) |                 |
| SALLY C. MEDLEY             | ) |                 |
| Administrative Patent Judge | ) |                 |

cc (via electronic filing):

Counsel for Zhang:

Joseph M. Skerpon, Esq.  
David R. Gerk, Esq.  
BANNER & WITCOFF, LTD  
1100 13<sup>th</sup> Street, N.W.  
Washington, D.C. 20005-4597  
Tel: 202-824-3000  
Email: [jskerpon@bannerwitcoff.com](mailto:jskerpon@bannerwitcoff.com)  
Email: [dgerk@bannerwitcoff.com](mailto:dgerk@bannerwitcoff.com)

Mr. S.J. Wang  
Mr. Philip Guo  
Compupal (Group) Corporation  
1555 Jiashan Avenue  
Jiashan 314113  
Zhejiang, China  
Email: [Philip.g@compupal.com.cn](mailto:Philip.g@compupal.com.cn)

Counsel for Amsel:

Ezra Sutton, Esq.  
**EZRA SUTTON, P.A.**  
Plaza 9, 900 Route 9  
Woodbridge, NJ 07095  
Tel: (732)634-3520  
Fax: (732)634-3511  
Email: [esutton@ezrasutton.com](mailto:esutton@ezrasutton.com)