

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

*The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.*

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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YVON ROBERGE

Junior Party,<sup>1</sup>

v.

JEFFREY STAPLES

Senior Party.<sup>2</sup>

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Patent Interference No. 103,345

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Heard: May 19, 1997

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URYNOWICZ, PATE, and MARTIN, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

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<sup>1</sup> Application 07/996,091, filed December 23, 1992.  
Unassigned. Accorded benefit of: None.

<sup>2</sup> Application 07/975,422, filed November 12, 1992.  
Unassigned. Accorded benefit of: None.

JUDGMENT

The subject matter of this interference is an orthodontic device for expanding the palate. Count 1, the sole count, reads as follows:

An orthodontia palatal expander apparatus for causing the widening of a patient's palate comprising:

an expansion screw assembly which includes:

a threaded member having a longitudinal axis;

said two bodies meshed with said threaded member, bodies being movable in opposite directions along said threaded member upon rotation of said threaded member;

first and second means for transferring pressure to side regions of a patient's palate, said first transferring means joined to one body and said second transferring means joined to the other body;

the improvement comprising:

threaded gear means operatively connected to said member for enabling selective manual rotation thereof, said gear means including a first gear fixed to said threaded member and a second gear mounted in driving relationship with the first gear, said second gear including means for enabling manual rotation thereof.

The following claims correspond to the count:

Roberge claims 1-8.

Staples claims 1-23.

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The only issues before us are priority and the admissibility of some of Staples's priority evidence.

**Roberge's motion to suppress**

Roberge has moved to suppress the initial affidavits by Jeffrey and Durenda Staples, exhibits A-D and F, and the models discussed in Jeffrey Staples's supplemental affidavit.

By way of background, during his testimony-in-chief period the party Staples filed affidavits<sup>3</sup> under § 1.672(b) by Jeffrey Staples, Durenda Staples, Howard Lambert, and Jim Smith, referencing Staples exhibits A-H.<sup>4</sup> Exhibits B, C, D, and F are photographs of what are identified as first, second, third, and fourth prototypes of the invention. Pursuant to § 1.672(c), Roberge<sup>5</sup> objected to the affidavits by Jeffrey and Durenda Staples and exhibits A-D, F, and G for failing to

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<sup>3</sup> As used in the interference rules, the term "affidavit" refers to an affidavit or a declaration. 37 CFR § 1.601(b).

<sup>4</sup> Paper No. 31, filed November 10, 1995.

<sup>5</sup> Paper No. 22, filed December 1, 1995.

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comply with the provisions of 37 CFR § 1.671(f)<sup>6</sup> and Rules 802 and 901(a) of the Federal Rules of Evidence, which apply to interferences pursuant to § 1.671(b).<sup>7</sup> As authorized by § 1.672(c), Staples responded with supplemental affidavits by Jeffrey Staples and Les Hetrick, referencing new exhibits I-K,<sup>8</sup> of which J and K are identical to exhibits E and G, respectively. Roberge elected not to cross-examine any of the Staples witnesses.

On February 16, 1996, just prior to the February 17 due date for the parties' records,<sup>9</sup> Staples filed a record<sup>10</sup> consisting of the initial affidavits by Lambert and Smith, the

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<sup>6</sup> This provision reads: "(f) The significance of documentary and other exhibits identified by a witness in an affidavit or during oral deposition shall be discussed with particularity by a witness."

<sup>7</sup> This provision reads: "(b) Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to interference proceedings. Those portions of the Federal Rules of Evidence relating to criminal actions, juries, and other matters not relevant to interferences shall not apply."

<sup>8</sup> Paper No. 23, filed December 20, 1995.

<sup>9</sup> See paper Nos. 10 and 16.

<sup>10</sup> Paper No. 26.

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supplemental affidavits by Jeffrey Staples and Hetrick, and exhibits H to K.

Roberge's motion seeks to suppress or exclude from consideration the initial affidavits by Jeffrey and Durenda Staples and exhibits A-D and F on the ground that none of this evidence is included in the Staples record. Staples effectively concedes this point by not addressing it in his opposition.<sup>11</sup> Thus, to the extent the motion concerns this evidence, it is dismissed as moot because that evidence is not part of either party's record and is therefore entitled to no consideration for that reason alone.

Roberge's motion (at 3) also "requests the suppression or exclusion of the models mentioned in [Jeffrey Staples's] Supplemental Declaration at SR-5, 6, ¶¶ 3, 6 and 7 and allegedly constructed in view of the failure of the Supplemental Declaration to comply with the provisions of 37 C.F.R. § 1.671(f) with respect to these models." As Staples's record includes neither the models nor the photographs thereof, the motion is dismissed as moot to the extent it seeks to suppress this evidence. However, Roberge's argument

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<sup>11</sup> Paper No. 30.

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that the absence of the models and the photographs "makes it difficult, if not impossible for Roberge to respond to the allegations made in [Jeffrey Staples's] Supplemental Declaration regarding their significance" (Motion at 3) suggests Roberge also is seeking to suppress those parts of the declaration on the ground that they do not describe the models with the particularity required by § 1.671(f). This reliance on § 1.671(f) is misplaced, because it applies to exhibits and the models are not exhibits. The question of whether Jeffrey Staples's declaration testimony describes the models with sufficient particularity goes to that testimony's weight, not its admissibility. As a result, the motion to suppress is denied to the extent it seeks to suppress Jeffrey Staples's testimony describing the models.

**The parties' cases for priority**

Both parties' involved cases are applications. As a result, Roberge, the junior party, is required to establish priority by only a preponderance of the evidence. 37 CFR § 1.657(b); Morgan v. Hirsch, 728 F.2d 1449, 1451, 221 USPQ 193, 194 (Fed. Cir. 1984). Inasmuch as Roberge resides in Canada, it is necessary to note that the acts relied on to

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prove a date of invention must have occurred in the United States. 35 U.S.C. § 104.<sup>12</sup>

Roberge argues that he is entitled to a judgment of priority based on the introduction of a conception of the invention into this country on or about June 16, 1992, coupled with reasonable diligence during the thirty-nine day critical period that runs from just prior to Staples's November 12, 1992, filing date up to Roberge's December 21, 1992, filing date, citing 35 U.S.C. § 102(g) and Scott v. Finney, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994). Staples argues that he has shown a conception date prior to Roberge's conception date and is therefore entitled to priority as the first to conceive and the first to reduce to reduce to practice, citing Sherman v. Hope, 161 F.2d 263, 268, 73 USPQ 387, 392 (CCPA 1947).

Roberge alternatively argues that he is entitled to an award of priority because Staples abandoned, suppressed, or concealed the invention after achieving an actual reduction to

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<sup>12</sup> Subject to a number of exceptions that do not apply to Roberge in this interference, § 104 specifies that "an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country."

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practice, citing Paulik v. Rizkalla, 760 F.2d 1270, 1272-75, 226 USPQ 224, 225-28 (Fed. Cir. 1985), and Lutzker v. Plet, 843 F.2d 1364, 6 USPQ2d 1370 (Fed. Cir. 1988). Staples denies that an actual reduction to practice occurred.

The evidence of junior party Roberge will be addressed first. As will appear, Roberge has established an introduction of a conception in this country no later than June 9, 1992, but not diligence in this country during the critical period running from just prior to Staples's November 12, 1992, filing date up to Roberge's December 21, 1992, filing date. Nicolas Pellemans testified<sup>13</sup> that on May 26, 1992, he mailed the patentability search request identified as Exhibit A to his affidavit (now Roberge Ex. 1) to Sanjiv Sharma in Burke, Virginia. This request, which indicates it relates to a "MECHANISM FOR ADJUSTING PALATAL EXPANDER" and bears reference number "29275-1 (Roberge)," includes a Figure 1 depicting a prior art jack screw mechanism for use in a palatal expander, Figures 2-4 depicting a first embodiment of a jack screw mechanism in accordance with the invention, a Figure 5 depicting a second embodiment, and a brief

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<sup>13</sup> Pellemans Aff., Roberge Record (RR) 7, para. 4.

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description of these embodiments. When the first embodiment is employed in a palatal expander, which includes means for transferring pressure from the jack screw mechanism to the side regions of a patient's mouth, the resulting device clearly satisfies all of the limitations of the count.

Although Sharma did not discuss the search request identified as Roberge Exhibit 1, his testimony establishes by a preponderance of the evidence he received that request on or before June 16, 1992. Specifically, he testified<sup>14</sup> that he prepared the search report identified as Exhibit B to his affidavit (Roberge Ex. 2) to Pellemans on June 16, 1992, the date appearing on the report. This report, like Pellemans's search request, indicates it relates to a "MECHANISM FOR ADJUSTING PALATAL EXPANDER" and includes reference number "29275-1." This testimony is sufficient to establish that a description of the subject matter of the count was received and understood in this country no later than June 16, 1992, when the search report was prepared. As a result, Roberge is entitled to a June 16, 1992, date of conception in this country. Kondo v. Martel, 220 USPQ 47, 50 (Bd. Pat. Int.

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<sup>14</sup> Sharma Aff., RR 10, para. 4.

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1983); Clevenger v. Kooi, 190 USPQ 188, 192 (Bd. Pat. Int. 1974); Mortsell v. Laurila, 301 F.2d 947, 951, 133 USPQ 380, 384 (CCPA 1962).

As for diligence, while Sharma's patentability search in this country is an act of the type which normally can be relied on to show diligence, Wilson v. Goldmark, 172 F.2d 575, 581, 80 USPQ 508, 514 (CCPA 1949); Kondo, 220 USPQ at 52, it is not evidence of diligence in this interference because it did not occur during the critical period. Instead, it was completed on June 16, 1992, which is four and one-half months before Staples's November 12, 1992, filing date, too far in advance of that date to be considered to be "just" or "immediately" prior thereto, as required by the case law. See Suh v. Hoefle, 23 USPQ2d 1321, 1334 (Bd. Pat. App. & Int. 1991) (evidence of work taking place at least one month prior to the date of an opponent's entry into the field does not constitute diligence just prior to that date) (citing Reiser v. Williams, 255 F.2d 419, 118 USPQ 96 (CCPA 1958)). In Reiser, the court held that Reizer's testimony, even if corroborated, failed to establish activity by him at any particular time in August or September and therefore did not

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show that he was doing anything toward preparing or filing his application during a period of one month or more immediately preceding Williams's September 29 entry into the field. 255 F.2d at 424, 118 USPQ at 101. See also Scharmann v. Kassel, 179 F.2d 991, 997, 84 USPQ 472, 477 (CCPA 1950) (January 19 letter referring to earlier patent memorandum was not immediately prior to opponent's February 15 entry into the field and thus was not relevant to question of diligence); I C. Rivise and A. Caesar, Interference Law and Practice § 178, at 550 (The Michie Co. 1940).

Although Pellemans testified<sup>15</sup> that "[u]pon review of Mr. Sharma's search report, we recommended filing a patent application, and began preparation of such an application," neither Pellemans nor any other witness testified that any part of this preparation occurred in the United States. The only activity said to occur in this country during the critical period was the receipt by Michael Lasky of Minneapolis, Minnesota, of Pellemans's December 21, 1992, letter identified as Exhibit C (Roberge Ex. 3), requesting that the application be filed in the United States Patent and

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<sup>15</sup> Pellemans Aff., RR 7-8, para. 6.

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Trademark Office, which occurred two days later, on December 23, 1992. Since this leaves the first five and one-half weeks of the critical period unaccounted for, Roberge cannot be credited with diligence during that period. See Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (party held not diligent where, after making a drawing in June, the party took no other action until December 2, nearly one month after opponent's November 4 entry into the field).

Roberge's failure to prove diligence means Staples is entitled to an award of priority based on his filing date, which makes it unnecessary to consider any of Staples's priority evidence. This includes the evidence that Roberge argues demonstrates abandonment, suppression, or concealment of the invention following actual reductions to practice in 1990 and 1992, when Staples constructed the first and second models of the invention. Even if abandonment, suppression, or concealment occurred, this would not have the effect of depriving Staples of the benefit of his filing date. Instead, he would be barred only from relying on those reductions to

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practice to establish priority. Paulik v. Rizkalla, 796 F.2d 456, 460, 230 USPQ 434, 437 (Fed. Cir. 1986).

While Roberge's failure to prove diligence is dispositive of this interference, in the interest of completeness we have also considered how the parties would have fared had Roberge proved diligence. Staples argues that under these circumstances he would prevail based on conception prior to Roberge's June 16, 1992, conception date, in which case Staples would be entitled to an award of priority as the first to conceive and the first to reduce to practice. Sherman v. Hope, 161 F.2d at 268, 73 USPQ at 392. For the following reasons, we agree with Roberge that Staples has not proved he was the first to conceive.

Conception is the formation "in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is therefore to be applied in practice," Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985), and must include every feature or limitation of the claimed invention. Davis v. Reddy, 620 F.2d 885, 889, 205 USPQ 1065, 1069 (CCPA 1980). Moreover, "[c]onception must be proved by corroborating evidence which

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shows that the inventor disclosed to others his 'complete 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. However, "there is no final single formula that must be followed in proving corroboration." Berry v. Webb, 412 F.2d 261, 266, 162 USPQ 170, 174 (CCPA 1969). Rather, the sufficiency of corroborative evidence is determined by the "rule of reason." Berry, 412 F.2d at 266, 162 USPQ at 173; Price v. Symsek, 988 F.2d 1187, 1195, 26 USPQ2d 1031, 1037 (Fed. Cir. 1993). Accordingly, a tribunal must make a reasonable analysis of all of the pertinent evidence to determine whether the inventor's testimony is credible. Price, 988 F.2d at 1195, 26 USPQ at 1037. The tribunal must also bear in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor's testimony. Berry, 412 F.2d at 267, 162 USPQ at 174; see also Reese v. Hurst, 661 F.2d 1222, 1125, 211 USPQ 936, 940 (CCPA 1981) ("evidence of corroboration must not depend solely on the inventor himself").

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The only evidence of record regarding Staples's activities prior to Roberge's June 16, 1992, conception date is Jeffrey Staples's testimony<sup>16</sup> that he

(a) conceived the invention on December 2, 1979, when he made the drawings identified as Exhibit I;

(b) constructed a first model of the invention in January 1980;

(c) constructed a second model of the invention in February 1990; and

(d) constructed a third, plastic model in February 1992.<sup>17</sup>

Not only is this testimony uncorroborated by any of the other witnesses, the earliest activity mentioned by any of them is Lambert's September 29, 1992, meeting with Jeffrey Staples concerning the preparation of a patent application, which occurred well after Roberge's June 16, 1992, conception date.<sup>18</sup>

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<sup>16</sup> Supp. Aff., Staples Record (SR) 4-6, paras. 2, 6, and 7.

<sup>17</sup> As noted supra, Staples's record does not include any of these models or any photographs of these models.

<sup>18</sup> Hetrick Aff., SR 12, para. 1; Staples Exhibit H.

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Staples contends that Jeffrey Staples's asserted December 2, 1979, conception date is corroborated by Exhibit I, which shows that date and which Staples contends need no corroboration, since "[o]nly an inventor's testimony needs corroboration," quoting Holmwood v. Sugavanam, 948 F.2d 1236, 1239, 20 USPQ2d 1712, 1715 (Fed. Cir. 1991). Staples has taken this statement out of context. The court was simply rejecting the Board's conclusion that corroboration was required for the testimony of Dr. Zeck, who was not an inventor; the court was not addressing the question of whether an inventor's documents require corroboration. That question was considered and answered in the affirmative in Hahn v. Wong, 892 F.2d 1028, 1032-33, 13 USPQ2d 1313, 1317 (Fed. Cir. 1989):

The inventor . . . must provide independent corroborating evidence in addition to his own statements and documents. See Lacotte v. Thomas, 758 F.2d 611, 613, 225 USPQ 633, 634 (Fed. Cir. 1985). Such evidence "may consist of testimony of a witness, other than the inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor." Reese v. Hurst v. Wiewiorowski, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981). See also Lacotte v. Thomas, 758 F.2d at 613, 225 USPQ at 634 (citing Reese); 37 C.F.R. § 1.608(b). "The purpose of the rule requiring corroboration is to prevent

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fraud." Berry v. Webb, 412 F.2d 261, 267, 56 CCPA 1272, 162 USPQ 170, 174 (1969).

In the absence of any corroboration, Jeffrey Staples's testimony that the invention was conceived on December 2, 1979, is entitled to no weight. The same is true of his testimony about making the first and second models in 1980 and 1990.

We note that Staples also has failed to demonstrate that any of the devices depicted in the December 7, 1979, drawings (Exhibit I) satisfy all of the limitations of the count, as is required to establish conception. Coleman, 754 F.2d at 359, 224 USPQ at 862; Davis v. Reddy, 620 F.2d at 889, 205 USPQ at 1069. Specifically, Staples has not shown that the drawing includes the required

gear means operatively connected to said threaded member for enabling selective manual rotation thereof, said gear means including a first gear fixed to said threaded member and a second gear mounted in driving relationship with the first gear, said second gear including means for enabling manual rotation thereof.

Jeffrey Staples's testimony<sup>19</sup> that the drawing in the lower left-hand corner of this exhibit shows "a first gear fixed to

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<sup>19</sup> Supp. Aff., SR 5, paras. 1-2.

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the threshold member and a second gear mounted in driving relationship with the first gear, the second gear being disposed to provide means for enabling manual rotation thereof" is unpersuasive because gears are not shown and Staples has not explained why they are inherent. The drawing leaves open the possibility that the knob controls rotation of the threaded member in some other way, such as by being releasably mounted on the end of the threaded member in such a way that the knob and threaded member rotate together.

Staples contends that Jeffrey Staples's testimony and Exhibit I have adequate corroboration when considered under the "rule of reason" standard of Coleman, 754 F.2d at 360, 224 USPQ at 862 (Br. at 11). However, as explained in Reese, 661 F.2d at 1225, 211 USPQ at 940, "the adoption of the "rule of reason" has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself. . . . Independent corroboration may consist of testimony of a witness, other than the inventor, to the actual reduction to practice or it may consist of surrounding facts and circumstances independent of information received from the inventor." Staples has not identified any surrounding facts

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or circumstances that corroborate Jeffrey Staples's testimony. Staples's contention that conception is confirmed by Exhibit J, which is a "Record of Conception of Invention" dated "7/16/92," is unpersuasive for several reasons. First, the existence of this document on that date is uncorroborated.<sup>20</sup> Second, assuming that the invention record's "7/16/92" date were corroborated and that a device disclosed therein satisfies the limitations of the count, it fails to corroborate that conception occurred more than one month earlier, i.e., prior to June 16, 1992, or that the first and second models were made prior to that date.

For the forgoing reasons, Staples has not shown that he was the first to conceive. Therefore, had Roberge proved that he had coupled his June 16, 1992, conception date with the requisite diligence, Staples would have been unable to prevail as the first to conceive and the first to reduce to practice. Thus, priority would have been awarded to Roberge.

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<sup>20</sup> Although the invention record includes the signature of Linda Nann(?) indicating that it was witnessed and understood on "9/10/92," she did not testify. Nor did anyone else corroborate the date of this document.

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In the interest of completeness, we have also considered whether, if Staples had succeeded in proving he was the first to conceive and the first to reduce to practice, Roberge nevertheless would have been entitled to judgment on the ground that Staples abandoned, suppressed, or concealed the invention after achieving actual reductions to practice by constructing the first and second models in January 1980 and February 1990. The answer is no, because a holding of abandonment, suppression, or concealment would not bar Staples from relying on the date of the actual reduction to practice date as his conception date. See Paulik v. Rizkalla, 796 F.2d at 460, 230 USPQ at 437:

[B]ecause of Paulik's long delay in filing his application, he could not rely upon the date of his actual reduction to practice as establishing priority as of the date of that reduction to practice. Paulik, however, still may rely upon the fact that he had reduced his invention to practice four years before Rizkalla filed, for example, as evidence of possession of the completed invention.

See also Connin v. Andrews, 223 USPQ 243, 250 (Bd. Pat. Int. 1984) ("the de facto first inventor who suppresses or conceals forfeits only the right to rely on his prior actual reduction to practice and does not forfeit his right to rely on his prior conception"). Furthermore, even assuming a holding of

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abandonment, suppression, or concealment would bar Staples from relying on the date of an actual reduction to practice date as his conception date, Roberge's argument fails because, as explained below, he has not established that either of these two models constituted an actual reduction to practice. For purposes of this discussion we assume that, as Jeffrey Staples testified,<sup>21</sup> the first model was constructed in January 1980 in accordance with the December 2, 1979, drawing and that the second model employed a worm gear mechanism. We also assume that Roberge is correct to assert that a reduction to practice of the palatal expander of the count does not require testing in a patient's mouth.<sup>22</sup> To prove that the first model satisfies all of the limitations of the count, as is necessary for this model to constitute an actual reduction to practice

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<sup>21</sup> Supp. Aff., SR 4-5, paras. 2-3.

<sup>22</sup> Roberge contends testing was unnecessary because the operability of the models was readily apparent from an inspection of the models, citing In re Asahi/America Inc., 68 F.3d 442, 445, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995), which in discussing the elements of an actual reduction to practice under 37 CFR § 1.131 held that "[t]here are some devices so simple that a mere construction of them is all that is necessary to constitute a reduction to practice" (quoting Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931)). Staples argues that an actual reduction to practice did not occur, because testing was required but not performed.

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of the subject matter of the count, Roberge cites Jeffrey Staples's "admission"<sup>23</sup> that the drawing in the lower left-hand corner of Exhibit I shows the two gears required by the count. However, this statement is not binding on Staples, because it is contradicted by the drawing itself, which, as noted above, does not show or necessarily imply the presence of such gears. See Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 929, 198 USPQ 151, 153-54 (CCPA 1978):

Facts alone may be "admitted." [Footnote omitted.] In reaching the legal conclusion, the decision maker may find that a fact, among those on which the conclusion rests, has been admitted; he may not, however, consider as 'admitted' a fact shown to be non-existent by other evidence of record; nor may he consider a party's opinion relating to the ultimate conclusion an "admission."

Since this first model does not include the two gears, it did not constitute an actual reduction to practice of the subject matter of the count, in which case it is immaterial whether this model was abandoned, suppressed, or concealed. See Peeler v. Miller, 535 F.2d 647, 651, 190 USPQ 117, 120 (CCPA 1976) ("without an actual reduction to practice there is no

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<sup>23</sup> Supp. Aff., SR 4-5, para. 2.

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invention in existence which can be abandoned, suppressed, or concealed").

As for the second model, which was constructed in February 1990 with a worm gear mechanism, Staples testified that this model "demonstrated that a worm gear mechanism was suitable for moving the bodies in opposite directions upon rotation of the threaded member."<sup>24</sup> We assume for the sake of argument that this model satisfies all of the limitations of the count. Roberge contends that abandonment, suppression, or concealment is demonstrated by the absence of any corroborated activity during the thirty-one month period between February 1990, when the second model was constructed, and September 1992, when Jeffrey Staples met with Lambert to discuss the preparation of a patent application. In support of his contention that a thirty-one month period of unexplained inactivity is sufficient to establish abandonment, suppression, or concealment, Roberge cites Engelhardt v. Judd, 369 F.2d 408, 151 USPQ 732 (CCPA 1966) (two years and three months); Shindelar v. Holdeman, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980), cert. denied, 451 U.S. 984 (1981); and Young v.

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<sup>24</sup> Staples Supp. Aff., SR 6, para. 6.

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Dworkin, 489 F.2d 1277, 180 USPQ 388 (CCPA 1974). Roberge's reliance on these cases is misplaced, however, because none of them concerns a charge of abandonment, suppression, or concealment leveled against a senior party, as in the present case. Under these circumstances, it is not enough to show that an actual reduction to practice was followed by a long period of unexplained inactivity; instead, it is necessary to show spurring or a specific intent to abandon, suppress, or conceal. See Connin, 223 USPQ at 250:

Although a 22-month unexplained delay might, under other circumstances, be considered fatal to a de facto first inventor's case (see, e.g., Smith v. Crivello, 215 USPQ 446 (Bd. Pat. Int. 1982)), we believe that where, as here, the charge of suppression or concealment is leveled against the senior party, other considerations come into play. The policy implemented in 35 U.S.C. 102(g) was discussed in Peeler v. Miller, [535 F.2d at 655, 190 USPQ at 123], as follows:

At least since Mason v. Hepburn, 12 App. D.C. 86 (1898), the courts have implemented a public policy favoring, in interference situations, the party who expeditiously starts his invention on the path to public disclosure through the issuance of patents by filing a patent application. This policy is now implemented through §102(g) even as it was in Mason v. Hepburn prior to that statute, by denying de jure first inventor status to de facto first inventors who, or whose assignees, frustrate this policy. (190 USPQ 123)

Since the senior party, by definition, is the party who first started his invention on the path to

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public disclosure by filing a patent application, we do not believe that a charge of abandonment, suppression or concealment may be sustained against a senior party where, as here, the charge is based solely on an unexplained delay between actual reduction to practice and filing, and there is no evidence either of specific intent or that the senior party was spurred into filing his application by knowledge of the opponent's activities.

Roberge has pointed to no evidence of spurring or specific intent and therefore has failed to demonstrate that Staples abandoned, suppressed, or concealed the invention even assuming the second model amounted to an actual reduction to practice. Consequently, we need not decide whether, as Staples contends, that model failed to constitute an actual reduction to practice because it was not tested in a patient's mouth.

#### Judgment

Judgment on the issue of priority is hereby awarded in favor of Staples, who is therefore entitled to a patent containing his application claims that correspond to the count, i.e., claims 1-23. Accordingly, judgment on the issue of priority is hereby entered against Roberge, who is therefore not

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entitled to a patent containing his application claims that correspond to the count, i.e., claims 1-8.

OF  
APPEALS

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STANLEY M. URYNOWICZ, JR. )  
Administrative Patent Judge )  
 )  
 ) BOARD

\_\_\_\_\_ ) PATENT

WILLIAM F. PATE, III ) AND  
Administrative Patent Judge ) INTERFERENCES  
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JOHN C. MARTIN )  
Administrative Patent Judge )

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