

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 70

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JOHN STEVENS  
Junior Party<sup>1</sup>  
V.  
JOHN E. MILLER  
Senior Party<sup>2</sup>

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Interference No. 103,611

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HEARD: March 11, 1999

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Before URYNOWICZ, PATE and CRAWFORD, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

FINAL JUDGMENT

The invention at issue in this interference relates to a deck for a seat or bed. The particular subject matter is illustrated by count 1, the sole count, as follows:

Count 1

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<sup>1</sup> Application 08/101,573 filed on August 3, 1993. Assignor to L & P Property Management Deck.

<sup>2</sup> Application 08/066,993 filed on May 25, 1993.

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A deck for seating or bedding, said deck being edge supported by a frame of a sofa sleeper movable between a folded sofa position and an unfolded bed position, said deck comprising a plurality of support members extending generally in the same direction to form a support, said support members having adjacent ends connected to each other for movement relative to each other, and at least one stop on each said member arranged such that upon movement of said members in one direction the stop will engage a stop surface on an adjacent support member to limit movement and upon movement of the members in a direction opposite said one direction the stop will be spaced from the stop surface on said adjacent support member to permit movement in said opposite direction, each end of each said support member having at least one recess and at least one projection for mating with a similar said recess and projection on said adjacent support member.

The claims of the parties which correspond to this count are:

Stevens : Claims 1-15

Miller : Claims 1, 5, 10, 12, 14-21 and 23-36

This proceeding was declared on August 22, 1995 with Stevens claim 1 and Miller claim 35 corresponding exactly to count 1. The party Miller was accorded senior party status on the basis of the earlier filing date of its involved application.

The Administrative Patent Judge (APJ) decided motions filed by Miller in a Decision on Preliminary Motions dated March 21, 1996. In that decision, the APJ denied motions of Miller (1) under 37 C.F.R. § 1.633(a) for judgment that Stevens involved claims 1-15 are unpatentable to Stevens under 35 U.S.C. § 102/103 over U.S. Patent 5,231,709 to Miller and, (2) under 37 C.F.R.

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§ 1.633(f) to be accorded benefit for count 1 of the September 26, 1990 filing date of Serial No. 588,351, now U.S. Patent 5,231,709. Miller's motion under 37 C.F.R. § 1.633(c) to redefine the interfering subject matter by designating its claims 1, 5, 10, 12, 16-18 and 20-34 as not corresponding to the count was dismissed as to non-corresponding claim 22 and otherwise denied. In the decision, the APJ dismissed a motion of Miller under 37 C.F.R. § 1.633(c) to redefine the interfering subject matter by adding proposed count 2.

Both parties took testimony to establish priority of invention, filed briefs and gave oral argument under 37 C.F.R. § 1.654.

In its opening brief at page 3, the party Stevens set forth the following statement of issues:

Whether Stevens has proven by preponderance of the evidence that it conceived the invention defined by the count prior to the filing date of Miller's involved application and whether Stevens subsequently reduced the invention to practice;

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Whether Stevens has proven that its invention was communicated to Miller prior to Miller's filing date and that Miller derived the invention from Stevens;

Whether Miller's aforementioned U.S. Patent 5,231,709 provides 35 U.S.C. § 112 support for the invention defined by the count.

In its brief at pages 2 and 3, Miller asserts that the following, among other things, are issues before the Board:

Whether the count is supported by the Miller U.S. Patent 5,231,709 and whether Miller should be accorded the filing date of said patent;

Whether Stevens derived the invention from Miller;

Whether the count is unpatentable to Stevens over the Miller patent under 35 U.S.C. §§ 102 or 103;

Whether Stevens' interfering application is invalid to Stevens due to the fact that Stevens failed to inform the Patent and Trademark Office examiner that the embodiments shown in Figs. 5-18 of Miller's application are prior art;

Whether claims 1, 5, 10, 12, 16, 20, 21, 23, 26, 27, 30-32 and 34 of Miller were incorrectly designated as corresponding to the count.

#### Burden of Proof

Whereas the applications of the parties are co-pending, the burden of proof as to date of invention on the junior party Stevens is preponderance of the evidence. 37 C.F.R. § 1.657(b).

#### Positions of the Parties Concerning Priority

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The junior party Stevens does not contend that it actually reduced to practice the invention of the count prior to its filing date. In order to prevail herein as the prior inventor, Stevens submits that it conceived the invention of the count as early as January 8, 1993 and was reasonably diligent from this date to its constructive reduction to practice on August 3, 1993.

As between the parties, Miller asserts the earlier date of conception, as early as April 20, 1988. Miller will be entitled to prevail herein as first to conceive and first to reduce to practice (its May 25, 1993 filing date is a constructive reduction to practice) if it has established a date of conception prior to the January 8, 1993 date of conception alleged by Stevens.

#### Count Ambiguity

The count is the measure of the invention. Such being the case, we will address the position of Stevens that the count is ambiguous before proceeding to decide the issue of prior conception by Miller.

The count is identical to claim 1 in the Stevens application. Based upon alleged different interpretations of the count presented by Miller and Stevens, the junior party contends that the count is ambiguous and should be interpreted in light of Stevens' specification from which it originated.

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With respect to this issue, Miller's position is that the count is broad, not ambiguous.

We are not persuaded by the argument of the junior party presented in its briefs. Stevens has not made clear what language the parties interpret differently. The junior party relies on an unsupported allegation that the parties take different views on the meaning of count language.

Even if the allegation that the parties have different interpretations of certain count language were supported by a showing of Stevens, the showing would not be persuasive. A bare showing that the parties disagree as to the meaning of certain language in a count does not establish ambiguity of the count. Krokel v. Shah, 558 F.2d 29, 32, 194 USPQ 544, 547 (CCPA 1977).

Otherwise, Stevens has not specifically analyzed one or more portions of the count to show wherein ambiguity lies.

#### Miller's Case Re Conception

Miller's evidence relating to its conception is to the following effect.

On or about April 20, 1988, Miller and an acquaintance, Raymond Holobaugh, had dinner at a restaurant in North Carolina on the occasion of a furniture market. During this dinner, Miller disclosed to Holobaugh a deck for a sofa bed to be incorporated in the frame of the sofa bed below the mattress so

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that when the sofa bed was in the folded or sofa position, the deck would yield in a downward direction to provide seating comfort but not yield in an upward direction to prevent the mattress from bowing upward in a convex shape causing an upward bulge of the sofa cushions. In the unfolded or bed position the deck would not yield in a downward direction to provide the desired support for the mattress.

During the dinner, Miller disclosed to Holobaugh various forms of his deck. One form of the deck included rows of plastic members having recesses and projections in the opposite ends thereof so that the projections of one plastic member would mate into the recesses of an adjacent plastic member in end to end relationship. A hinge pin extended through the mating ends of the plastic parts to interconnect the parts for pivotal movement relative to each other. The plastic parts were provided with stops on the opposite ends thereof so that a stop on one plastic member would be engaged with a stop surface on the adjacent plastic member to prevent pivotal movement in one direction but to allow pivotal movement in the opposite direction. Miller Exhibit C is a napkin bearing a sketch made during the dinner showing the plastic members.

Opinion-Miller's Conception

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It is considered that Miller has established conception of the subject matter of the count on or about April 20, 1988, as alleged.

Stevens did not take cross-examination of Miller's witnesses, and Miller's case for prior conception based on the testimony of the inventor Miller and the corroborating witness, Raymond Holobaugh, as it relates to Miller Exhibit C, is not challenged in the briefs of party Stevens.

The testimony of the inventor Miller regarding conception on or about April 20, 1988 is corroborated by the testimony of Holobaugh and Miller Exhibit C. The apparatus in Exhibit C is very much similar to the apparatus disclosed in Figures 5-8 of Stevens' involved application and in Figures 19 and 20 of Miller's involved application. The only portion of the invention defined in the count not evident in the exhibit are the stops. However, the testimony of the inventor and Holobaugh establishes that the support members had stops on opposite ends thereof to limit movement of the plastic members in one direction and to allow pivotal movement in the opposite direction.<sup>3</sup>

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<sup>3</sup> Even if we had found that the count is ambiguous as alleged by Stevens and that it should be interpreted in light of Stevens' specification, because the apparatus illustrated in Miller Exhibit C is structurally very close to that illustrated in Figures 5-8 of Stevens and Figures 19 and 20 of Miller, we would still have concluded that Miller conceived the invention on or about April 20, 1988. In the involved applications of the

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In view of our finding above with respect to conception by the senior party Miller, the other issues raised by the parties are moot.<sup>4</sup>

Judgment

Judgment as to the subject matter of count 1, the sole count, is awarded to John E. Miller, the senior party. On the present record, the party Miller is entitled to a patent with its claims 1, 5, 10, 12, 14-21 and 23-36. The party Stevens is not entitled to a patent with its claims 1-15.

STANLEY M. URYNOWICZ, JR. )

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(...continued)  
parties, the above figures are supporting embodiments of the invention at issue in this proceeding. This fact is unchallenged.

<sup>4</sup> There can be no derivation by Miller from Stevens without prior conception on the part of Stevens. Davis v. Reddy, 620 F.2d 855, 205 USPQ 1065 (CCPA 1980).

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WILLIAM F. PATE, III	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS
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MURRIEL E. CRAWFORD	)	
Administrative Patent Judge)	)	

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Attorney for Stevens:

John D. Poffenberaer  
Wood, Herron & Evans  
2700 Carew Tower  
Cincinnati, OH 45202

Attorney for Miller:

William E. Mouzavires, Esq.  
Judicial Court  
Ste. 703  
10615 Judicial Drive  
Fairfax, VA 22030