

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 44

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SIGURD FROHLICH and HANS JOCHEN KOELLNER

Junior Party,
(Patent 5,884,006),

v.

WAYNE D. BALDWIN and FUJIO ABE

Senior Party,
(Application 09/526,026).

Patent Interference No. 105,005

Before LANE, MEDLEY, and TIERNEY Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTIONS AND JUDGMENT

A. Introduction

This interference was declared on 5 August 2002. Frohlich filed a miscellaneous motion 1 for judgment against Baldwin based on equitable estoppel, or alternatively estoppel by judgment. Frohlich also filed a preliminary motion 2 for judgment against Baldwin on the

ground that Baldwin's involved claims are unpatentable under 35 U.S.C. § 112, or alternatively under 35 U.S.C. §§102/103. Baldwin filed a responsive preliminary motion 1 to add claims 51-55 to its involved application and to designate those claims as corresponding to the count.

For the reasons that follow, we deny Frohlich miscellaneous motion 1, grant-in-part Frohlich preliminary motion 2, and deny Baldwin preliminary motion 1.

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. Frohlich is involved on the basis of Patent 5,884,006 ('006), granted 16 March 1999, based on application 08/954,318, filed 17 October 1997.

2. Baldwin is involved on the basis of application 09/526,026, filed 15 March 2000.

3. Baldwin has been accorded benefit for the purpose of priority of application 09/204,013, filed 1 December 1998 and application 08/706,651, filed 6 September 1996.

4. Frohlich's real party in interest is Energy Storage Technologies, Inc. (EST) (Paper 5).

5. Baldwin's real party in interest is Vesture Corporation (Paper 9).

6. The interfering subject matter pertains to a storage unit that contains a layer of phase change material, and a heater assembly on one side of the layer of phase change material for charging the phase change material.

7. Count 1, the sole count of the interference, is as follows:

Claim 20 of 09/526,026

or

Claim 1 of 5,884,006

8. Baldwin claim 20 is as follows:

A phase change thermal storage assembly, comprising:

a container assembly having first and second sides and an internal volume between the first and second sides;

a layer of phase change material in said internal volume, said phase change material being chargeable with heat energy; and

a heater assembly positioned on one side of the layer of phase change material to charge the phase change material in the internal volume with heat energy and distribute heat evenly to the phase change material in the internal volume during charging of the phase change material.

9. Frohlich claim 1 is as follows:

A rechargeable phase change material unit comprising:

a first shell portion and a second shell portion forming a shell, said first shell portion and said second shell portion defining a cavity;

at least one layer of a phase change material disposed in said cavity, said phase change material being chargeable with heat energy; and

a heater assembly positioned on one side of said layer of phase change material, said heater assembly being provided to charge said phase change material with heat energy and distribute heat energy throughout said layer of phase change material during the charging of said phase change material.

10. The claims of the parties which correspond to Count 1 are:

Frohlich: 1-5, 8-13, 15-20, 23-29, 31 and 32

Baldwin: 20-40 and 44-49

11. The claims of the parties which do not correspond to Count 1 are:

Frohlich: 6, 7, 14, 21, 22, 30 and 33-46

Baldwin: 41-43 and 50

12. The level of ordinary skill in the art is defined by the prior art references made of record.

C. Decision

Frohlich miscellaneous motion 1

Some time ago, the parties were involved in a civil action in the United States District Court for the Southern District of California. Frohlich's then real party in interest, Phase Change Laboratories, Inc. (PCL)¹ sued Baldwin's real party in interest Vesture Corporation (Vesture) for patent infringement of Frohlich's involved 5,884,006 ('006) patent. Baldwin counterclaimed that all of the claims in the '006 patent were invalid for failing to comply with one or more of the statutory requirements of the Patent Act, 35 U.S.C. § 1 et seq., including, 35 U.S.C. §§ 102, 103 and/or 112, and all parts, subparts or paragraphs thereof, and that the inventors of the Frohlich patent did not invent the inventions claimed in the Frohlich patent. The parties settled the dispute, and the district court judge entered an order dismissing the action with prejudice (Paper 17).

Frohlich, through its miscellaneous motion 1, requests that judgment be entered against Baldwin based on equitable estoppel, or alternatively, based on estoppel by judgment. It is Frohlich's position that the settlement agreement and the order from the district court dismissing the action with prejudice should have prevented Baldwin from provoking this interference.

¹ PCL assigned Frohlich's involved patent to Energy Storage Technologies (EST). Later, PCL was merged with and into EST (motion at 2).

Frohlich's estoppel theories are ultimately based on interpretation of the settlement agreement that ended the litigation. For example, under the equitable estoppel theory (motion at 7), Frohlich argues that the intent of the parties at the time of settlement was to end all disputes between the parties related to the '006 patent. Under the estoppel by judgment theory (motion at 9), Frohlich argues that the settlement and dismissal were intended as an all inclusive resolution of matters involving the '006 patent.

Absent from the record before us is a copy of the settlement agreement. Frohlich failed to file one. Without a copy of the agreement, we decline to speculate whether the agreement, as described by Frohlich, prevents Baldwin from making its claims involved in the interference. Even if Frohlich had provided a copy of the settlement agreement, the board is not in the business of interpreting and enforcing contracts made between two parties. Frohlich has failed to direct us to precedent that would suggest otherwise. Moreover, Frohlich is not without remedy. Frohlich can seek enforcement of the settlement agreement in district court. Lastly, Frohlich has failed to direct our attention to precedent that would indicate that the board must decide equitable estoppel or estoppel by judgment issues. For these reasons, Frohlich miscellaneous motion 1 is denied.

In addition, we deny Frohlich miscellaneous motion 1 for the following reasons. Frohlich argues that the intent of the parties, at the time of settling the litigation, was to end all disputes between the parties related to the '006 patent, including any assertion of priority of invention (motion at 7). Frohlich directs our attention to the Lloyd Huff (Huff) affidavit and the order entered by the district court in support of its argument as to the intent of the parties.

The Huff affidavit is not signed under 18 U.S.C. § 1001, and is therefore an out of court statement submitted for the truth of the matter asserted and is hearsay. Accordingly, the Huff affidavit is fatally flawed. Even considering the Huff affidavit, the affidavit is insufficient to support the argument made - that the intent of the parties was to prevent Baldwin from filing an application with claims drawn to the same patentable invention as the '006 patent. Huff states that it is his understanding that the parties intention, at the time of settlement was to settle all disputes against the '006 patent, including priority of invention (Frohlich Ex. 2001, ¶ 8). Huff fails to provide a factual basis for his understanding. Huff does not state what his role was during the settlement process, or how he knew the intent of the parties. Was Huff in a meeting when the terms of the agreement were discussed? Was he involved in drafting the agreement? We don't know. Huff does not tell us. As such, we cannot and will not simply take his word as to the intent of the parties. Accordingly, Huff's affidavit is not credible. See Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness).

The district court order dismissing the parties' claims with prejudice is based on the settlement agreement. The order itself does not indicate that the parties intended to prevent Baldwin from filing an application having claims to the same patentable invention as Frohlich's involved claims. Even if we were to assume that the dismissal with prejudice applied to a claim of prior invention, such dismissal does not prevent the board from determining, as between Frohlich and Baldwin, who was the first to invent the interfering subject matter. Frohlich recognizes that issue preclusion requires privity of the causes of action. Yet, Frohlich fails to

sufficiently explain how that requirement is met. The district court dispute involved the '006 patent alone. It did not involve Baldwin's application. As such, issues have been raised in this proceeding that could not have been raised in the district court proceeding. Accordingly, the two causes of action are not the same. Cf. Anderson v. Dionex Corp., 53 USPQ2d 1041, 1043 (BPAI 1999) (where motion to stay proceeding pending the outcome of litigation was denied, panel explained that the cause of action in district court and the interference before the Office were different, since application involved in the interference was not involved in litigation).

Frohlich directs our attention to Arcless Contact Co. v. General Electric Co., 87 F.2d 340, 32 USPQ 167 (2nd Cir. 1937) for the proposition that a dismissal with prejudice in District Court should prevent relitigating the question of priority of invention before the Patent Office.

Frohlich argues that since it was held in Arcless that a final decision in an interference prevented relitigating priority of invention in district court, that the reverse would also be true. However, Frohlich has provided no discussion or rationale as to why the reverse would be true.

Furthermore, decisions of regional courts of appeals are not binding precedent, and Frohlich has provided no reason why we should follow a non-precedential opinion. See Paper 1, Standing Order § 14. For these reasons, Frohlich miscellaneous motion 1 is denied.

Frohlich preliminary motion 2

Frohlich filed preliminary motion 2 for judgment against Baldwin on the basis that Baldwin's claims 20-40 and 44-49 are unpatentable under 35 U.S.C. § 112. Alternatively, Frohlich argues that Baldwin claims 20-40 and 44-49 are unpatentable under 35 U.S.C. §§ 102/103.

Unpatentability of Baldwin claims under § 112

Frohlich argues that Baldwin claims 20-40 and 44-49 are unpatentable under 35 U.S.C. § 112. Although Frohlich does not specify which paragraph of section 112 Baldwin has violated, it appears that Frohlich disagrees that there is written description support for Baldwin claims 20-40 and 44-49². Specifically, Frohlich argues that the claims are “not supported in the specification” of Baldwin (motion at 5-6).

Frohlich advances two arguments. The first is that Baldwin’s claims be interpreted in light of Frohlich’s specification, and in doing so, the Baldwin specification lacks written description for certain claim terms. Frohlich additionally argues that even if Baldwin’s claims are interpreted in light of Baldwin’s specification, the Baldwin specification lacks written description for certain claim terms. Frohlich has failed to sufficiently demonstrate that Baldwin lacks written description in either case.

Baldwin independent claims 20, 30, and 40 recite “a layer of phase change material.” Frohlich relies on In re Spina, 975 F.2d 854, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992) for the proposition that a copied claim is interpreted in light of the patent from which it was copied. Frohlich argues that the term “a layer of phase change material”, when interpreted in light of Frohlich’s specification, does not mean a phase change material in any form, but means a *solid, discrete* layer of phase change material (motion at 8).

In contrast to Spina, Rule 633(a) expressly provides that:

In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the application or patent in which it appears.

In Rowe v. Dror, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997), the court distinguished Spina

² Note, that the movant must clearly state the reason for the relief requested. 37 CFR § 1.637(a).

from Rule 633(a) and stated that:

[T]he PTO had good reason to promulgate a new rule in light of the new practice in which patentability of claims can be considered during the motion period of an interference. See 37 C.F.R. 1.633(a) (effective date February 11, 1985). Earlier case law did not deal with such a situation. Moreover, Spina did not involve a Rule 633(a) motion. Thus, the PTO was writing on a clean slate, not flouting judicial precedent.

Rowe, 112 F.3d at 479 n.2, 42 USPQ2d at 1554 n.2. See also, Cultor Corp. v. A.E. Staley Manufacturing Co., 224 F.3d 1328, 1332, 56 USPQ2d 1208, 1211 (Fed. Cir. 2000) (copied claims construed in light of specification of which they are apart). Thus, we decline to interpret Baldwin claims 20-40 and 44-49 in light of Frohlich's specification. Baldwin claims 20-40 and 40-49, to the extent necessary, are to be construed in light of Baldwin's specification.

Nevertheless, we address Frohlich's argument based on the merits. Frohlich argues that the limitation "a layer of phase change material," when interpreted in light of Frohlich's specification means a *solid, discrete layer* of phase change material. Frohlich argues that Baldwin's description of a phase change material that is in liquid form contained within an envelope is not a solid, discrete layer (motion at 8-9). Frohlich arrives at the proposed definition by impermissibly adding limitations to the claim language. Note, that such incorporation of limitations from the specification into the claims is not allowed. In re Van Geuns, 988 F.2d 1181, 1186, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (limitations are not to be read into the claims from the specification). Claims are to be given their broadest reasonable interpretation. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) (It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art). Frohlich

proposes an unreasonable interpretation of “a layer of phase change material.”

A layer is defined as a single thickness, coating, or stratum spread out or covering a surface. Webster’s II New Riverside Dictionary, Copyright 1988 (attached). Absent from the definition for layer are the words solid and discrete. The definition is broad enough to include materials that are neither solid nor discrete. Frohlich has proposed a construction of the term layer that is narrower than the ordinary meaning of that word. We recognize that an inventor can be his own lexicographer. However, Frohlich has failed to direct us to evidence that would demonstrate that the term “layer” is given a special definition in Frohlich’s specification. Note, that Frohlich’s own specification states that it is desirable for the layer to be of a discrete shape, but that the “layer 28 of phase change material 30 can have any size or shape.” (‘006 patent, col. 3, lines 59-62). That it is desirable for the phase change material to be of a discrete shape, does not mean that the layer of phase change material must necessarily be a discrete shape, or that the term “layer” is defined in the specification to always mean a solid discrete shape. Frohlich arrives at its proposed claim interpretation of “a layer of phase change material” by importing limitations from its specification into the claim language. As discussed above, such importation of limitations into claims is not permitted.

Baldwin independent claims 20, 30 and 40 additionally recite a “heater assembly positioned on one side of the layer of phase change material.” Frohlich argues that when the term is construed in light of its specification, the term “heater assembly” means a heating element alone, a heat transfer element alone, or a combination of a heating element and heat transfer element (motion at 9). Frohlich argues that Baldwin’s specification fails to describe “a heater assembly” that is a heat transfer element alone. Frohlich agrees that Baldwin does have

written description support for some “heater assembly” embodiments, just not all of the same embodiments that are described in the Frohlich patent. Again, Frohlich is impermissibly importing limitations from Frohlich’s specification into Baldwin’s claims. Frohlich has given no rationale for doing so. Based on this record, there is no apparent reason to construe the term “heater assembly” to necessarily include a heat transfer element. Accordingly, Frohlich’s proposed claim interpretation of the term “heater assembly” is rejected.

Frohlich alternatively argues that if Baldwin’s claims are interpreted in light of Baldwin’s specification per Rule 633(a), then Baldwin’s claims are not supported by Baldwin’s specification (motion at 10). Baldwin’s independent claims 20, 30 and 40 recite “a container assembly having first and second sides and an internal volume between the first and second sides” and “a layer of phase change material in said internal volume.” Frohlich argues that the phase change material **204** is not inside the internal volume of item **20**, as Baldwin indicates in its annotated set of claims (motion at 10).

As seen in the Baldwin figures **3-5**, the thermal pack assembly **20** includes, a rigid base **100** on the bottom, a thermally insulating foam cushion **102** disposed on the upper surface of the base, and a foil cover **104** on top of the foam cushion. On top of the foil cover is a heating coil subassembly **103**, which includes a heating coil **105** sandwiched between two thermally conductive metal foils **106** and **108**. The heater subassembly is secured to the foil layer **104** and base **100**. The heater subassembly **103** is also secured to the underside of a thermal retention pouch **200**. The pouch **200** is a sealed envelope of plastic in which is contained an open foam pad **202**. The foam pad is impregnated with water contained in the pouch. A phase change material can be used in the pouch **200** (application 09/526,026, page 12, lines 10-12).

In Baldwin's annotated claims, Baldwin specifies that the container assembly having first and second sides and an internal volume between the first and second sides is defined by the thermal pack assembly **20**. As described, the thermal pack assembly is primarily comprised of different layers of solid materials. However, on top of the various layers of solid materials is a pouch **200** that is also part of the thermal pack assembly, and that has first and second sides and an internal volume between the first and second sides. The pouch **200** contains a layer of phase change material in the internal volume.

Frohlich's literal and narrow interpretation of Baldwin's annotated set of claims is unreasonable. Frohlich argues that the sides of the thermal pack assembly are defined by the sides **20a** and **20b** only, and that the layer of phase change material **204** is almost entirely outside of the volume defined by sides **20a** and **20b**. Baldwin's specification clearly indicates, however, that the thermal pack assembly includes pouch **200**. Thus, the sides of the assembly **20** include the sides of all of the parts that make up the assembly **20**. This includes the sides of the pouch **200**, not just the sides of the bottom layers of the thermal pack assembly. When interpreted in that light, Baldwin's specification clearly describes a container assembly **20** having first and second sides (defined by **20a**, **20b** and the sides of **200**), and an internal volume between the first and second sides. Moreover, the pouch **200** by itself meets the limitation of a container with sides and a volume in between the sides, as does chamber **43** (application 09/526,026, page 6, lines 26-29).

It may have been more accurate for Baldwin to indicate, in its annotated set of claims, that the envelope **200** of the thermal pack assembly **20** defines the volume of the claimed container. Nonetheless, it is not Baldwin who must demonstrate in the first instance that it has

written description support. It is Frohlich, as the moving party, who must demonstrate that Baldwin fails to provide written description support for Baldwin's involved claims. Here, Frohlich has failed to sufficiently demonstrate that Baldwin's involved claims are unpatentable based on 35 U.S.C. § 112, ¶ 1.

Unpatentability of Baldwin's claims based on prior art

Frohlich alternatively argues that Baldwin's claims are unpatentable based on various pieces of prior art (motion at 11).

Toshiba reference

Frohlich argues that Baldwin claims 20-22, 26-27, 29, 40, 46-47 and 49 are anticipated by "Toshiba"³ (motion at 12). In that set of claims, Baldwin claims 20 and 40 are the only independent claims. The remaining claims depend either directly or indirectly on claims 20 and 40. Baldwin claims 20 and 40 recite a layer of phase change material and:

a heater assembly positioned on one side of the layer of phase change material to charge the phase change material in the internal volume with heat energy and distribute heat evenly to the phase change material in the internal volume during charging of the phase change material.

Frohlich argues that the latent heat storage material 9 meets the limitation of the phase change material. Frohlich has failed to direct us to evidence that would demonstrate that a "latent heat storage material" is the same as, or a subset of a "phase change material." Frohlich has failed to even address this difference. It may be that a latent heat storage material is a particular type of a phase change material, or it may not. Without an explanation from Frohlich we don't know how the reference applies to the particular claim language, and thus Frohlich has

³ The "Toshiba" reference is a brief abstract of JP1-107045A, published 24 April 1989 (Frohlich Ex. 2008).

failed to make out a *prima facie* case of anticipation.

In addition, Frohlich argues that item 6 of the Toshiba reference meets the limitation of a heater assembly for charging the phase change material with heat energy. However, as explained in the Toshiba reference, heater 6 heats oil 5, that subsequently charges the latent heat storage material. Thus, it is not the heater 6 that charges the latent heat storage material, it is the oil⁴. For this additional reason, Frohlich has failed to demonstrate that the Toshiba reference as applied anticipates Baldwin claims 20 and 40. Since Frohlich has failed to sufficiently make out a *prima facie* case of anticipation with respect to Baldwin independent claims 20 and 40, we need not address those claims that depend on claims 20 and 40.

Howell reference

Frohlich argues that Baldwin claims 20, 26-28, 40 and 46-48 are anticipated by Howell⁵ (motion at 13). Baldwin claims 20 and 40 are independent claims. The remaining claims depend either directly or indirectly from claims 20 and 40.

Baldwin claims 20 and 40 recite “a layer of phase change material” and “a heater assembly positioned on one side of the layer of phase change material.” Frohlich argues that the thermally conductive material, shown in Howell as item 17, is a layer of phase change material. Frohlich provides no explanation, nor does Frohlich direct us to evidence that would demonstrate that the thermally conductive material is the same as, or a subset of a phase change material.

⁴ Even if we were to assume that the oil and the heater together form a heater assembly, it has not been sufficiently explained, nor is it evident that the “heater assembly” is positioned on one side of the latent heat material. Note, the oil is positioned on more than one side of the latent heat material.

⁵ GB 2035764A, published 18 June 1980 (Frohlich Ex. 2009).

Without an explanation from Frohlich we don't know how the reference applies to the particular claim language, and thus Frohlich has failed to make out a *prima facie* case of anticipation.

Furthermore, Frohlich argues that Howell describes a helical heating coil 20 that meets the limitation of the claimed "heater assembly." Although Frohlich states that the helical heating coil 20 is positioned on one side of the layer of phase change material, Frohlich has failed to sufficiently explain how that is so. As seen in the sole figure, and described, helical coil 20 is embedded in the thermally conductive material (Frohlich Ex. 2009, page 1, col. 2, lines 110-111). Thus, as shown and described, the heater assembly is not positioned on one side of the phase change material as claimed. Rather, the helical coil is surrounded by the phase change material. Frohlich provides no explanation as to how the reference as applied describes a heater assembly "positioned on one side" of the "phase change material." For this additional reason, Frohlich has failed to demonstrate that Howell, as applied, anticipates Baldwin claims 20 and 40. Since Frohlich has failed to sufficiently make out a *prima facie* case of anticipation with respect to Baldwin independent claims 20 and 40, we need not address the claims that depend from claims 20 and 40.

Goswami reference

Frohlich argues that Baldwin claims 20-22, 26-27, 29, 40, 46-47 and 49 are anticipated under 35 U.S.C. § 102(e) by Goswami⁶. In that set of claims, Baldwin claims 20 and 40 are the only independent claims. The remaining claims depend either directly or indirectly on claims 20 and 40.

⁶ U.S. Patent 5,687,706, granted 18 November 1997, based on application 08/428,905, filed 25 April 1995 (Frohlich Ex. 2010).

Frohlich argues that Goswami shows a heater 30 positioned on one side of the phase change material pellets 52. However, as with the Howell reference, the phase change material surrounds the heater, and therefore the heater is not positioned on one side of the phase change material. Based on this record, Frohlich fails to provide an explanation as to how the heater is positioned on one side. For this reason, Frohlich has failed to demonstrate that Goswami, as applied, anticipates Baldwin claims 20 and 40.

Marney reference

Frohlich argues that Baldwin claims 20, 26, 28, 30, 36, 38, 40, 46 and 48 are anticipated by Marney (motion at 15).

Baldwin claims 20, 26 and 28

Frohlich has sufficiently demonstrated that Marney meets the limitations of Baldwin claims 20, 26 and 28. Specifically, Marney shows in figure 7 a container, i.e. any one of containers 27-31, with a phase change material inside the container, and a heater assembly, i.e., any one of heater elements 62-66 (claim 26) positioned on one side of any one of containers 27-31 (Baldwin claims 20 and 26), with a thermostat 76 (claim 28). Baldwin does not specifically address the application of Marney with respect to Baldwin claims 20, 26 and 28.

Baldwin's arguments are directed to the claim language in Baldwin claims 30, 36, 38, 40, 46 and 48. Specifically, Baldwin argues that Marney fails to describe a phase change thermal assembly that is removable in a pouch, and that Marney fails to describe a pizza heater for keeping pizzas warm during delivery (opposition at 14-16). Baldwin claims 20, 26 and 28 do not include the limitations that Baldwin argues are not described by Marney. Baldwin is silent with respect to the specific limitations of Baldwin claims 20, 26 and 28. Accordingly, since

Baldwin has failed to sufficiently rebut Frohlich's *prima facie* case of anticipation with respect to Marney

as that reference is applied to Baldwin claims 20, 26 and 28, those claims are unpatentable to Baldwin.

Baldwin claims 30, 36, and 38

Frohlich has failed to set forth a *prima facie* case of anticipation with respect to Baldwin claims 30, 36, and 38 in view of Marney. Baldwin claim 30 is an independent claim and claims 36 and 38 depend on claim 30. Claim 30 recites, in the preamble, "a phase change thermal storage assembly removably positioned in the pouch." Frohlich has failed to demonstrate that the phase change assembly, which as defined by claim 30, comprises a container with a volume, a layer of phase change material in the volume, and a heater assembly positioned on one side of the layer of phase change material, is removably positioned in a pouch. Frohlich argues that the phase change thermal storage assembly is removably positioned in the case 10, but fails to discuss in any meaningful way why that is so (motion at 15). Frohlich also directs us to several lengthy passages in the Marney reference that allegedly meet the limitation in its appendix (motion at 31). However, it is not enough to direct our attention to several lengthy passages that allegedly meet a limitation without discussing or explaining the passages as they relate to the claim language, especially, when as here it is not apparent from the passages that the limitation is described.

Here, Frohlich fails to direct us to evidence that would demonstrate that the "assembly" comprising the container with the phase change material and the heater element positioned on

one side of the phase change material are “removably positioned” as claimed. Note, that Marney describes that the heater elements are electrically connected in series, whose wires are terminated on the outer shell 11 of the pouch, thus indicating that the “phase change thermal storage assemblies” that include the heating elements are not “removably positioned.” Frohlich provides no explanation otherwise. As stated above, it is not enough to merely direct us to several lines of a passage in a reference, where it is not apparent in the passage that an element is met. For this reason, Frohlich has failed to set forth a *prima facie* case of anticipation with respect to Baldwin claims 30, 36 and 38. Accordingly, we need not and have not considered Baldwin’s opposition regarding those claims, or Frohlich’s reply regarding the same claims.

Baldwin claims 40, 46 and 48

With respect to Baldwin claims 40, 46 and 48, Frohlich has set forth a *prima facie* case of anticipation in view of the Marney reference. Baldwin claims 40, 46 and 48 are nearly identical to Baldwin claims 20, 26 and 28, respectively. The preamble, however, of independent claim 40 recites “a pizza heater for keeping pizza warm during delivery.” Claim 46 depends on claim 40. Claim 48 depends on claim 46. Frohlich argues that the preamble of claim 40 is not a limitation of the claim because it merely states an intended purpose of the claim (motion at 16). Indeed, where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997). The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); Loctite Corp. v. Ultra Seal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir.

1985).

Baldwin does not challenge Frohlich's position - that the preamble merely states an intended use of the claim. Baldwin merely asserts that Marney fails to disclose a pizza heater for keeping pizzas warm during delivery (opposition at 16), and argues in a conclusory manner that the preamble is a positive limitation. Specifically, Baldwin has failed to sufficiently explain why the preamble "breaths life and meaning" into the claims as asserted. Frohlich has presented a reasonable interpretation of Baldwin claim 40 - that the preamble merely recites an intended use of an apparatus. Baldwin has failed to demonstrate how Frohlich's interpretation is erroneous.

Baldwin also argues that the examiner, during ex parte prosecution of Baldwin's involved application, considered the Marney reference. However, ex parte determinations made by an examiner are not binding on the board during an inter partes proceeding. For all of these reasons, Baldwin's claims 40, 46 and 48 are unpatentable.

Baldwin claims 21-25, 27, 29, 31-35, 37, 39, 44-45, 47, and 49

Frohlich argues that Baldwin claims 21-25, 27, 31-35, 37, 39, 44-45, 47, and 49 are obvious over Marney in view of either Toshiba, Howell, Goswami, Le Poidevin, or Salyer (Motion at 16). With respect to Baldwin claims 31-35, 37 and 39, which depend either directly or indirectly from Baldwin claims 30 and 36, the additional references that Frohlich relies on as applied by Frohlich do not make up for the deficiencies of Marney with respect to Baldwin claims 30, 36 and 38. Accordingly, Frohlich has failed to sufficiently demonstrate that Baldwin claims 31-35, 37 and 39 are unpatentable.

Obviousness of Baldwin claims 21-25 and 27

Frohlich argues that Baldwin claims 21-23 are obvious over Marney in view of Le

Poidevin⁷. Baldwin claim 21 depends on claim 20 and recites that the heating assembly includes a heating element to charge the phase change material and a heat transfer element to distribute heat from the heating element to the phase change material during charging of the phase change material. Baldwin claim 22 recites that the heat transfer element is disposed between the heating element and the phase change material. Baldwin claim 23 specifies that the heat transfer element is a thermally conductive metal foil.

Frohlich recognizes that Marney does not disclose a heat transfer element that is a thermally conductive metal foil, disposed between a heating element and the phase change material. Frohlich relies on Le Poidevin which describes the missing heat transfer element. Le Poidevin shows, in figure 2 a heater assembly 8, with a heating element 9, and a heat transfer element 11 made of thermally conductive aluminum foil disposed between the heating element 9 and the layer of phase change material 7. Frohlich argues that it would have been obvious to modify Marney with Le Poidevin's heat transfer element, since the heat transfer element distributes heat evenly from the heating element to the phase change material. Indeed, Le Poidevin suggests the same and states that the aluminum foil layer(s) "assist in achieving an even distribution of the heat derived from the heating element layer 9, throughout the device when being heated from the source of electrical energy, and during the subsequent emission of heat from the device" (Frohlich Ex. 2012, page 1, lines 93-99).

Baldwin argues that Frohlich provides no motivation for combining Marney and Le Poidevin. However, Frohlich did provide a statement of motivation - that adding the heat transfer foil layer to the Marney device would serve to distribute heat evenly from the heating

⁷ GB 2160965, published 2 January 1986 (Frohlich Ex. 2012).

element to the phase change material. Indeed, such motivation comes from the Le Poidevin reference itself as discussed above. Accordingly, since Baldwin has failed to discuss in any meaningful way why it would not be obvious to combine the references, Baldwin has failed to rebut Frohlich's *prima facie* case of obviousness with respect to Baldwin claims 21-23.

Baldwin claim 24 depends on claim 20 and recites a supporting element for the layer of phase change material. Baldwin claim 25 depends on claim 24 and recites that the supporting element is an open cell foam. Frohlich relies on Salyer⁸ to teach incorporation of phase change material in foams, including open cell foams, to enhance insulating capacity. Again, with respect to Baldwin claims 24 and 25, Baldwin merely argues that Frohlich fails to provide a motivation to modify Marney. Here, Frohlich has provided a reason to combine the references - to enhance the insulating capacity, and Baldwin has not sufficiently challenged that reason. Accordingly, Baldwin has failed to rebut Frohlich's *prima facie* case of obviousness as to Baldwin claims 24 and 25.

Baldwin claim 27 depends on Baldwin claim 26 and recites that the heating element is an electrical resistive heating coil. Frohlich argues that Toshiba, Howell, or Goswami disclose a resistive heating coil (motion at 17). At least Howell does disclose a resistive coil. Frohlich, however, with respect to Baldwin claim 27 fails to explain why it would have been obvious to use a resistive coil in place of the Marney heating element. Frohlich merely asserts that it would have been obvious to make the modification, but fails to provide a motivation for doing so. Accordingly, Frohlich has failed to set forth a *prima facie* case of obviousness with respect to Baldwin claim 27.

⁸ U.S. patent 4,797,160, granted 10 January 1989 (Frohlich Ex. 2013).

Baldwin claim 29 depends on Baldwin claim 20 and recites that the heater assembly has a heat transfer element to charge the phase change material and to distribute heat evenly to the phase change material. In Baldwin claim 29, it is the heat transfer element that functions to heat the phase change material and to distribute heat evenly to the phase change material. Frohlich relies on any one of Toshiba, Goswami or Le Poidevin to teach a heat transfer element. As discussed above, with respect to Le Poidevin, that reference teaches a heat transfer element. Frohlich argues that it is the heat transfer element that charges the phase change material and distributes heat evenly to the phase change material. As discussed above, Frohlich has provided a motivation for doing so - to evenly heat the phase change material. Baldwin merely argues that Frohlich has failed to provide any motivation for combining the references. Baldwin's argument is insufficient to overcome Frohlich's *prima facie* case of obviousness as to Baldwin claim 29.

Baldwin claims 44-45, 47 and 49

Baldwin claim 44 depends on claim 40 and is directed to a supporting layer element for the phase change material. Baldwin claim 45 depends on claim 44 and recites that the supporting element is an open cell foam. These claims are similar to previously discussed Baldwin claims 24 and 25. Baldwin claims 44 and 45 differ in that they are directed to a pizza heater. Frohlich relies on Salyer to teach incorporating phase change material in foams, including open celled foams, to enhance insulating capacity.

Baldwin argues that neither Marney nor Salyer are directed to a pizza heater for keeping pizza warm during delivery (opposition at 17). This argument has already been rejected. Baldwin has failed to demonstrate, in any meaningful way, that the preamble is a positive limitation, and not merely a statement of the intended use of the claimed apparatus.

Accordingly, Baldwin has failed to rebut Frohlich's *prima facie* case of obviousness with respect to Baldwin claims 44 and 45.

Baldwin claim 47 recites that the heating element is an electrically resistive heating coil. Frohlich argues that Toshiba, Howell, and Goswami disclose a resistive heating coil, and that it would have been obvious to use a resistive coil as the heating element of Marney. Frohlich fails to explain why it would have been obvious to use a resistive coil in place of the Marney heating element. Accordingly, Frohlich has failed to set forth a *prima facie* case of obviousness with respect to Baldwin claim 47.

Baldwin claim 49 depends on claim 40 and recites a heat transfer element to charge the phase change material and to distribute heat evenly to the phase change material. This claim is similar to Baldwin claim 29. Frohlich makes the same argument with respect to the Le Poidevin reference teaching the heat transfer element. Again Baldwin merely argues that the references relied on do not teach a pizza heater. That argument is rejected as already discussed.

We assume that the prior art references apply to Frohlich's involved claims, since Frohlich has failed to state otherwise. Accordingly, the same rejections would apply to Frohlich that apply to Baldwin. Here, however, Frohlich has conceded priority and thus judgment is entered against Frohlich such that Frohlich is not entitled to any of its claims that correspond to the count. Accordingly, we need not determine if Frohlich's claims are also unpatentable over the prior art of record.

Frohlich's preliminary motion 2 is granted with respect to Baldwin claims 20-26, 28, 29, 40, 44-46, 48 and 49 and is otherwise denied.

Baldwin preliminary motion 1

Baldwin seeks to add to its application claims 51-55 and to designate those claims as corresponding to the count. Baldwin claims 51-55 directly or indirectly depend on claim 30. Baldwin argues that claims 51-55 are introduced to more clearly define the construction of the pouch of claim 30 so as to characterize the size of the pouch interior in the context of the food articles intended to be transported by the food heating device of claim 30.

As the movant, Baldwin must demonstrate that the claims define the same patentable invention as the count. 37 CFR § 1.637(c)(2)(ii). Baldwin must show the patentability of each claim, apply the terms of the claim proposed to be added to the disclosure of Baldwin's application, and file with the motion a proposed amendment adding the claims to the application. 37 CFR § 1.637(c)(2)(iii). Baldwin must also file a separate paper containing an annotated copy of the new claim(s). Paper 1, Standing Order § 21.

Baldwin did not file an amendment adding the claims to the application, nor did Baldwin file a copy of annotated claims 51-55. Baldwin has failed to demonstrate that its proposed claims define the same patentable invention as the count. Instead, Baldwin argues in a conclusory fashion that its proposed claims 51-55 cover the same patentable invention as Frohlich's involved claims 16-20, 23-29, 31 and 32, and "are directed at a 'food heating device'" (motion at 3). Baldwin further argues that Frohlich's involved patent describes a container used to receive and/or transport food.

Baldwin's argument that Frohlich's specification discusses the general features of the proposed claims misses the mark. Baldwin must demonstrate that the proposed claims are directed to the same patentable invention as the count. This is done through a detailed anticipation or obviousness analysis. In that analysis, an opponents specification is not prior art

to the moving party. Baldwin has failed to provide an explanation as to how its claims are directed to the same patentable invention as the count. Baldwin's conclusory statements fall short of the requirements necessary for granting the relief requested.

Lastly, Baldwin's submission that proposed claims 51-55 are supported by its application, by directing us to numerous figures, and passages throughout its specification without providing any explanation is inadequate. In essence, Baldwin asks us to sift through its specification to try to ascertain if it has written description support for its proposed claims. We decline the invitation. Baldwin should have explained, in the first instance, how the language in its proposed claims 51-55 is supported by its specification. Accordingly, Baldwin preliminary motion 1 is denied.

D. JUDGMENT

Frohlich's preliminary statement does not allege a date that is earlier than Baldwin's 6 September 1996 effective filing date. Counsel for Frohlich, during the hearing on preliminary motions conceded priority on behalf of Frohlich, provided that its miscellaneous motion 1 was denied. Frohlich miscellaneous motion 1 is denied. Accordingly, it is

ORDERED that judgment as to Count 1 (Paper 1 at 5), the sole count in the interference, is awarded against junior party SIGURD FROHLICH and HANS JOCHEN KOELLNER.

FURTHER ORDERED that junior party SIGURD FROHLICH and HANS JOCHEN KOELLNER is not entitled to a patent containing claims 1-5, 8-13, 15-20, 23-29, 31 and 32 (corresponding to Count 1) of patent 5,884,006;

FURTHER ORDERED that judgment as to claims 20-26, 28, 29, 40, 44-46, 48 and 49 corresponding to Count 1 is awarded against senior party WAYNE D. BALDWIN and FUJIO

ABE;

FURTHER ORDERED that senior party WAYNE D. BALDWIN and FUJIO ABE is not entitled to a patent containing claims 20-26, 28, 29, 40, 44-46, 48 and 49 (corresponding to Count 1) of application 09/526,026;

FURTHER ORDERED that a copy of this paper shall be made of record in the files of application 09/526,026, and U.S. Patent 5,884,006;

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

_____)	
SALLY GARDNER LANE)	
Administrative Patent Judge)	
)	
)	
_____)	BOARD OF PATENT
SALLY C. MEDLEY)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
_____)	
MICHAEL P. TIERNEY)	
Administrative Patent Judge)	

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