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entered today is not binding precedent of the Board.

Paper 26

Filed by: Trial Section Merits Panel
Mail Stop Interference
P.O. Box 1450
Alexandria, VA 22313-1450
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JEFFREY A. SIBNER
Junior Party,
(Application 09/114,166; Patent 5,766,011),

v.

SANDRA P. GILBERT
Senior Party,
(Application 08/955,005).

Patent Interference No. 105,037

Before: LEE, LANE, and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

A. Introduction

On 13 November 2003, the board received "SIBNER RESPONSE TO ORDER TO SHOW CAUSE" (Paper 25), in which Sibner requests that the interference be terminated without entering judgment against either party. Since Sibner has failed to sufficiently demonstrate that the Gilbert subject matter and claimed invention were, at the time the invention

was made,

subject to an obligation of assignment to Sibner, it is now time appropriate to enter judgment against the junior party Sibner.

B. <u>Findings of fact</u>

1. The interference was declared on October 25, 2002 (Paper 1).

2. Sibner is involved on the basis of Patent 5,766,011, granted 16 June 1998, based on application 08/757,248, filed 27 November 1996.

3. Sibner is also involved on the basis of application 09/114,166, filed 13 July 1998.

4. Sibner has been accorded benefit for the purpose of priority for the '166 application of the involved patented file, 08/757,248.

5. Gilbert is involved on the basis of application 08/955,005, filed 20 October 1997.

6. Gilbert has been accorded benefit for the purpose of priority of provisional application 60/029,504, filed 29 October 1996.

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

Claim 1 of Sibner's Patent 5,766,011

or

Claim 1 of Sibner's Application 09/114,166

or

Claim 23 of Gilbert's Application 08/955,005

8. The claims of the parties are:

Sibner (5,766,011):	1-21
Sibner (09/114,166):	1-34
Gilbert:	1-3, 5-16 and 18-23

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

Sibner (5,766,011):	1-21
Sibner (09/114,166):	1-34
Gilbert:	1-3, 5-16 and 18-23

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

Sibner (5,766,011):	none
Sibner (09/114,166):	none
Gilbert:	none

11. Sibner real party in interest is Jeffrey A. Sibner (Paper 10).

12. At the time the interference was declared, Gilbert's real party in interest was Discus Dental Impressions, Inc. (Discus Dental) (Paper 6).

13. The times for filing preliminary motions and preliminary statements were set on December 17, 2002.

14. Per that order, the last time for taking action (time period 8) during the preliminary motions phase was set for September 22, 2003 (Paper 14).

15. Counsel for the respective parties represented to the administrative patent judge (APJ), during various conference calls, that the parties intended to settle the interference[1].

16. No papers were filed during the approximately nine month preliminary motions period.

17. On 2 October 2003, the APJ ordered Sibner to show cause why judgment should not be entered against it (Paper 17).

---

[1] Conference calls were held on at least the following dates: 25 February 2003, 5 March 2003, 2 July 2003, and 31 July 2003.

18. On 22 October 2003, the day a response was due to the show cause order, board personnel Yolunda Townes phoned counsel for Sibner, Ms. Orzechowski, to inquire whether the party Sibner intended to respond to the show cause order.

19. Ms. Orzechowski informed Ms. Townes that the parties had settled and that the senior party had assigned the involved senior party application to the junior party.

20. Later the same day, Sibner filed a copy of an assignment and a copy of a sealed settlement agreement (Papers 19 and 20).

21. According to the assignment, Gilbert's real party in interest Discus Dental is said to have assigned the Gilbert application to Jeffrey A. Sibner (Paper 19).

22. Still, no paper was submitted on the day the response to the show cause order was due indicating that adverse judgment against the party Sibner was not appropriate.

23. The APJ, through Ms. Townes, requested that Ms. Orzechowski contact the APJ as soon as possible to avoid having adverse judgment entered against Sibner.

24. The APJ attempted to reach Ms. Orzechowski on 28 October 2003.

25. Ms. Orzechowski was unavailable, and instead a conference call was held that day between the APJ and backup counsel for Sibner, Mr. Sofocleous.

26. Mr. Sofocleous informed the APJ that Ms. Orzechowski intended to file a request for an extension of time to file a response to the show cause order.

27. A conference call was held on 29 October 2003 between the APJ and Ms. Orzechowski.

28. Ms. Orzechowskil requested an extension of time to respond to the show cause order

until 11 November 2003.

29. Ms. Orzechowski informed the APJ that Gilbert was under an obligation to assign the involved Gilbert application to Sibner at the time of the invention and that the interference should be dismissed.

30. The APJ granted the request for an extension of time (Paper 24).

31. During the same conference call, Ms. Orzechowski explained, and apparently understood that in response to the show cause order that Sibner, would:

> (1) file a proposed amendment cancelling identical Sibner and Gilbert claims, and cancelling Sibner and/or Gilbert claims that would qualify as prior art under 35 U.S.C. § 102(g),
>
> (2) show, with evidence, that Gilbert was under an obligation to assign the invention, and
>
> (3) file a terminal disclaimer for any remaining claims that would qualify as obviousness-type double patenting prior art.

32. On 13 November 2003, the board received from the party Sibner a paper entitled "Sibner response to order to show cause" (Paper 25).

33. The response refers to an attached "exhibit A", which allegedly demonstrates that Sandra Gilbert was under an obligation to assign the Gilbert invention to Sibner.

34. Exhibit A[2] bears no signature.

35. Exhibit A is entitled "Confidentiality Agreement."

36. The "confidentiality agreement" is apparently between Stardent International Labs,

---

[2] None of the "exhibits" attached to the response are labled. We assume that the "exhibit A" is the document placed under Tab 1.

Inc. (Stardent) and Jeffrey A. Sibner.

37. The agreement is apparently not an assignment of any inventions, but rather is an agreement between Stardent and Sibner regarding the confidentiality of proprietary information exchanged between the two parties.

38. Part of the "exhibit A" is an e-mail from Jeffrey A. Sibner to Ms. Orzechowski stating that the "confidentiality agreement" was signed by Sandra Gilbert and himself on 11 July 1996.

C. Discussion

In response to the show cause order, Sibner must show good cause why judgment should not be entered against it. Here, Sibner has failed to show good cause why judgment should not be entered against it. Accordingly, judgment against the junior party Sibner is appropriate.

In response to the show cause order, Sibner argues that, at the time of the invention, Sandra Gilbert was under an obligation to assign the subject matter involved in the interference to Sibner. Sibner proposes to cancel those Gilbert claims that are identical to, or are anticipated by the Sibner involved claims, leaving Gilbert claims 5-11 and 18-22, claims that were originally designated as corresponding to the count. Although not clearly articulated, we understand Sibner to submit that the remaining Gilbert claims would not be prior art to Sibner or vice versa, since Gilbert was allegedly under an obligation to assign the subject matter, covered by those

remaining claims, to Sibner at the time of the invention[3].

Sibner relies on its Exhibit A to demonstrate the matter asserted. Exhibit A is copy of an unsigned agreement and an e-mail message from Jeffrey Sibner to Ms. Orzechowski, stating that the agreement was executed on "7/11/96." The agreement is apparently not an assignment of rights to any invention, but rather is a confidentiality agreement between Stardent and Jeffrey Sibner. The agreement explains that Stardent wishes to form a business relationship with Sibner, and largely sets forth terms for protecting Stardent proprietary information from exploitation by Sibner. Sibner has not directed our attention to any section of the agreement where it is indicated that Gilbert was under an obligation to assign the subject matter involved in this interference. Nor has Sibner explained why the agreement as a whole reflects that Gilbert was under an obligation to assign.

That counsel for Sibner would represent such an agreement as demonstrating an obligation to assign is disturbing and frustrating. Sibner must show good cause why judgment should not be entered against it. Submitting an unsigned, apparently non relevant agreement to the board falls far short from the good cause standard required.

We make no comment on Sibner's proposed amendment for the Gilbert application. To the extent that the assignee of the Gilbert application, now said to be Jeffrey Sibner seeks to make such changes, he may do so during ex parte prosecution. The terminal disclaimers

---

[3] 35 U.S.C. §103(c) provides:

> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, <u>at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person</u>. (Emphasis added).

submitted for the Sibner application and patent are presumably based on the assumption that the interference will be terminated without entering judgment against either Sibner or Gilbert. As explained above, since Sibner has failed to sufficiently demonstrate that Gilbert was under an obligation to assign the invention, we make no comments regarding the proposed terminal disclaimers in either the Sibner application or patent. Judgment is entered against Sibner, leaving Sibner with no claims in either its involved patent or application. Lastly, we make no comment regarding the alleged incorrect inventorship of the Gilbert application. Sibner did not file a preliminary motion, during the preliminary motion period, which alleges that the inventorship of the involved Gilbert application is incorrect. In any event, a proposed change of inventorship to the Gilbert application may be submitted during ex parte prosecution of the Gilbert application.

D. JUDGMENT

Since Sibner has failed to file a preliminary statement and since Sibner has failed to show good cause why judgment should not be entered against it, it is

ORDERED that judgment as to Count 1 (Paper 1 at 5), the sole count in the interference, is awarded against junior party JEFFREY A. SIBNER.

FURTHER ORDERED that junior party JEFFREY A. SIBNER is not entitled to a patent containing claims 1-21 (corresponding to Count 1) of patent 5,766,011, or claims 1-34 (corresponding to Count 1) of application 09/114,166;

FURTHER ORDERED that a copy of this paper shall be made of record in the files of applications 09/114,166 and 08/955,005, and U.S. Patent 5,766,011;

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

_____	)
JAMESON LEE	)
Administrative Patent Judge	)
	)
	)
_____	) BOARD OF PATENT
SALLY GARNER LANE	) APPEALS AND
Administrative Patent Judge	) INTERFERENCES
	)
	)
_____	)
SALLY C. MEDLEY	)
Administrative Patent Judge	)

cc: (via facsimile):
Counsel for Sibner and Gilbert
(real party in interest - Jeffrey A. Sibner):

Karen Lee Orzechowski (lead counsel)

Liniak, Berenato & White, LLC
6550 Rock Spring Drive
Suite 240
Bethesda, MD 20817

Telephone: 301-896-0600
Fax: 301-896-0607

Michael Sofocleous (backup counsel)

Roberts, Mlotkowski & Hobbes, P.C.
3911 Old Lee Highway
Suite 43 B
Fairfax, VA 22030

Telephone: 703-934-7005
Fax: 703-934-9405