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Paper 294
Entered: 12 February 2015

UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD

JODI A. **DALVEY** and NABIL F. NASSER, *Junior Party*,
v.
ULF **BAMBERG**, PETER KUMMER and ILONA STIBUREK, *Senior Party*.

Interference 105,961 McK
Daley Patent 7,754,042 B2
v.
Bamberg Application 13/182,197

Interference 105,964 McK
Dalvey Patent 7,749,581 B2, Patent 7,766,475 B2
Patent 8,361,574 B2, and Patent 8,703,256 B2
v.
Bamberg Application 13/177,284

Patent Interference 105,966 McK
Dalvey Patent 7,771,554 B2 and RE 41,623 E
v.
Bamberg Application 13/207,236 and Application 13/223,541

Before: FRED E. McKELVEY, RICHARD E. SCHAFER, and
JAMES T. MOORE, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

DECISION ON MOTIONS

1 I. Introduction

2 Three interferences were declared:

3 (1) Interference 105,961,

4 (2) Interference 105,964, and

5 (3) Interference 105,966.

6 The interferences were consolidated. *See, e.g.*, Paper 139.

7 Since February of 2014, all papers have been filed in the administrative
8 record of Interference 105,964.

9 References to Paper Numbers in this opinion are to a paper in the record of
10 Interference 105,964 unless otherwise noted.

11 The reader is referred to a Fourth Redeclaration (Paper 178) for an
12 identification of (1) the parties, (2) the patents, reissue patent, and applications
13 involved in each interference, (3) the counts, and (4) earlier constructive reductions
14 to practice (i.e., benefit for the purpose of priority) accorded to the parties.

15 A copy of Paper 178 appears as Appendix 1 to this opinion.

16 The parties are involved in a civil action for infringement filed in the
17 U.S. District Court for the District of Minnesota styled as *Schwendimann v.*
18 *Arkwright Advanced Coating, Inc.*, Civil Action No. 0:11-cv-00820-ADM-JSM.
19 Paper 14, page 2:5-6.

20 Counsel have advised the Board that the civil action has been stayed pending
21 outcome of this interference.

22 II. Counts

23 A count defines the interfering subject matter and limits the scope of proofs
24 on the issue of priority.

25 The counts are Count 1, Count 2, and Count 3.

1 Count 1 is involved in Interference 105,964. Paper 178, page 8.
2 Count 2 is involved in Interference 105,961. Paper 178, page 4.
3 Count 3 is involved in Interference 105,966. Paper 178, pages 12-13.

4 III. Oral argument

5 Oral argument took place on 24 November 2014.
6 A copy of a transcript of oral argument has been made of record. Paper 293.

7 IV. Motions

8 We decide Dalvey Motions 3 and 8 and Bamberg Motions 5 and 7.

9 A. Dalvey Motions

10 1. Dalvey Motion 3

11 Dalvey Motion 3 seeks entry of judgment based on an alleged lack of a
12 written description and enablement. Paper 110.

13 Dalvey Supplement to Motion 3 seeks entry of judgment as to all involved
14 Bamberg claims in Bamberg application 13/207,236, added to the interference
15 after Dalvey Motion 3 was filed. Paper 190.

16 Bamberg opposes. Paper 225.

17 Dalvey has replied. Paper 252.

18 2. Dalvey Motion 8

19 Dalvey Motion 8 seeks exclusion of evidence. Paper 113.

20 Bamberg opposes. Paper 227.

21 Dalvey has replied. Paper 262.

1 3. Other Dalvey Motions

2 In view of our disposition of Dalvey Motion 3 and Dalvey Motion 8, we
3 have not considered or decided the following Dalvey motions:

- 4 (1) Dalvey Motion 2 (Paper 86) (for judgment based on § 135(b));
5 (2) Dalvey Motion 4 (Paper 178) (to substitute counts); and
6 (3) Dalvey Motion 5 (Paper 113) (judgment based on priority).

7 B. Bamberg Motions

8 1. Bamberg Motion 5

9 In response to Dalvey Motion 3 (37 C.F.R. §41.121(a)(2)), Bamberg
10 Motion 5 seeks entry of an order authorizing filing a motion to amend to substitute
11 new claims. Paper 80.

12 Dalvey has opposed. Paper 217.

13 Bamberg has replied. Paper 258.

14 2. Bamberg Motion 7

15 Bamberg Motion 7 seeks to exclude evidence. Paper 270.

16 Dalvey has opposed. Paper 274.

17 Bamberg has replied. Paper 279.

18 3. Other Bamberg Motions

19 In view of our disposition of Dalvey Motion 3, we have not considered or
20 decided the following Bamberg motions:

- 21 (1) Bamberg Motion 1 (Paper 80) (substitute new counts);
22 (2) Bamberg Motion 2 (Paper 117 (vacate accorded benefit);
23 (3) Bamberg Motion 3 (Papers 118 and 190) (contingent on priority
24 be awarded to Dalvey, judgment against Dalvey based on unpatentability
25 over the prior art); and

1 (4) Bamberg Motion 6 (Paper 131) (judgment based on priority).

2 V. Dalvey Motion 3

3 A. Introduction

4 The Board may take up motions in any order. 37 C.F.R. § 125(a).

5 We elect to take up Dalvey Motion 3 first because it raises a “threshold”
6 issue. If the motion is granted, Dalvey prevails. 37 C.F.R. § 411.201 (definition of
7 “Threshold issue” (2)(ii)); 37 C.F.R. § 41.208(a)(1).

8 Dalvey Motion 3 seeks entry of judgment as to all involved Bamberg claims
9 based on an alleged lack of a written description and enablement. Paper 110;
10 Paper 190.

11 B. Facts¹

12 1. Terminology

- 13 1. “Bamberg” is a reference to the party Bamberg, the real party in
14 interest being Arkwright Advanced Coating, Inc. Paper 25.
- 15 2. “Ulf Bamberg” or “Mr. Bamberg” is a reference to inventor Bamberg.
- 16 3. “Dalvey” is a reference to the party Dalvey, the real party in interest
17 being Jodi A. Schwendimann. Paper 17. NuCoat, Inc., and Cooler
18 Concepts, Inc., are licensees. *Id.*
- 19 4. “Jodi A. Dalvey” and “Jodi A. Schwendimann” refer to the same
20 person—an inventor named in the involved Dalvey patents.

¹ To the extent that a finding is a conclusion of law, it may be treated as such.

1 2. Issue

- 2 5. The general issue is whether Bamberg's claims are unpatentable under
3 35 U.S.C. § 112, first paragraph, due to a lack of an adequate written
4 description.
- 5 6. According to Dalvey, Bamberg copied claims in its application for the
6 purpose of provoking interferences with Dalvey patents.
- 7 7. Dalvey therefore reasons that the copied Bamberg claims must be
8 construed in light of the Dalvey patents, the patents from which the
9 claims were copied. Paper 110, page 5; *Agilent Technologies, Inc. v.*
10 *Affymetrix, Inc.*, 567 F.3d 1366, 1375 (Fed. Cir. 2009).
- 11 8. Bamberg, while not explicitly denying that it copied claims, maintains
12 that the words in the claims should be given their ordinary and
13 customary meanings. Paper 225, page 2; *Phillips v. AWH Corp.*, 415
14 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc).
- 15 9. As will become apparent, in this case whether *Agilent* or *Phillips* is
16 applied makes no difference.
- 17 10. The specific issue is the parties ask us to decide is: Does the
18 descriptive portion of the specification of Bamberg's PCT application
19 have a written description for claims that cover "white layers" that
20 melt at a temperature *below* about 220° C.?

21 3. Burden and Standard of Proof

- 22 11. Dalvey has the burden of proof. 37 C.F.R. § 41.121(b).
- 23 12. The standard of proof is a preponderance of the evidence. *See, e.g.*,
24 *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1120-21 (Fed. Cir. 2004) (in

- 1 connection with a motion for judgment based on a lack of written
2 description, movant has a burden by a preponderance of the evidence).
3 13. Whether claimed subject matter is supported by a written description
4 is a question of fact. *In re Alton*, 76 F.3d 1168, 1171 (Fed. Cir. 1996).

5 4. Witnesses

6 (a) Dr. Scott A. Williams

- 7 14. Dr. Scott A. Williams was called as a witness for Dalvey. **Ex. 2016**
8 (direct testimony); **Ex. 2045** (cross-examination).
9 15. He was awarded a Bachelor of Science degree from Purdue University
10 (1984) and a Ph.D. in physical chemistry from Montana State
11 University (1989). **Ex. 2016**, Appendix A (Board Assigned
12 Page #548).
13 16. Dr. Williams is a Professor at the School of Chemistry and Materials
14 Science of the Rochester Institute of Technology. **Ex. 2016**, ¶ 1.
15 17. He has also served as a Professor of Imaging Materials and Processes.
16 **Ex. 2016**, ¶ 2.
17 18. Dr. Williams has taught courses in polymer chemistry. **Ex. 2016**, ¶ 3.
18 19. He was Director of Research & Development at Fotowear, a company
19 that Dr. Williams testified was focused on iron-on-image transfer
20 products. **Ex. 2016**, ¶ 7.
21 20. Dr. Williams is qualified to express opinions on technical matters
22 related to the subject matter involved in this interference.

1 (b) Dr. William M. Risen, Jr.

2 21. Dr. William M. Risen, Jr., was called as a witness on behalf of
3 Bamberg. **Ex. 1531** (direct testimony); **Ex. 2051** (cross-examination).

4 22. He was awarded a Bachelor of Science degree in Chemistry from
5 Georgetown University (1962) and a Ph.D. from Purdue University
6 (1967). **Ex. 1531**, Appendix A (Board page #2,653).

7 23. Dr. Risen is a Professor Emeritus of Chemistry at Brown University.
8 **Ex. 1531**, ¶2.

9 24. He has worked with polymers and associated technology. **Ex. 1053**,
10 ¶ 8

11 25. Dr. Risen has consulted “in the area of media . . . for more than 20
12 years, including specifically in the area of color print media and image
13 transfer.” *Id.*

14 26. He is named as an inventor on six patents relating to print media. *Id.*

15 27. Dr. Risen is qualified to express opinions on technical matters related
16 to the subject matter involved in this interference.

17 (c) Ulf Bamberg

18 28. Mr. Ulf Bamberg was called as a fact witness by Dalvey. **Ex. 2030**
19 (direct testimony); **Ex. 2047** (cross-examination).

20 29. He is a named inventor on the involved Bamberg applications.
21 **Ex. 2030**, ¶ 1.

22 30. Mr. Bamberg was paid by Dalvey at the rate of \$100.00 per hour.

1 31. His testimony relates to development activities associated with
 2 making the inventions described and claimed in the involved Bamberg
 3 applications. **Ex. 2030**, ¶¶ 3-10.

4 5. Claims Involved in the Interferences

5 32. The claims of the parties involved in the interferences are set out in
 6 the following Table 1.

Table 1		
Interference	Corresponding Dalvey Claims	Corresponding Bamberg Claims
105,961	Patent 7,754,042, claims 1-22	Appl'n 13/182,197, claims 23-34
105,964	Patent 7,749,581, claims 1-31 Patent 7,766,475, claims 1-21 Patent 8,361,574, claims 1-20 Appl'n 13/745,995, claims 1-20	Appl'n 13/177,284, claims 30-49
105,966	Reissue 41,623, claims 1-17 Patent 7,771,554, claims 1-14	Appl'n 13/233,541, claims 1-17 Appl'n 13/207,236, claims 1-2 and 5-14

7 Paper 110 (Dalvey Motion 3, page 3); Paper 190 (Dalvey Supplement
 8 to Motion 3, page 2.

9 6. Scope of Bamberg's Claims

10 33. According to Bamberg, "[t]he Bamberg claims, including the
 11 [Bamberg] claims that define the three Counts of the Interferences,
 12 do not include and should not be construed to include, a melting
 13 temperature . . . limitation for the white layer." Paper 225,
 14 page 5:18-20.

- 1 34. A review of the Bamberg claims designated as corresponding to the
2 counts confirms Bamberg's point.
- 3 35. For example, Bamberg Claim 30 of Bamberg application 13/177,284
4 involved in Interference 105,964 reads:
5 An image transfer article, comprising:
6 an ink-receptive layer, including at least one
7 surface configured to receive and carry indicia to be
8 transferred; a polymer layer including ethylene acrylic
9 acid underlying the ink-receptive layer;
10 a white layer underlying the polymer layer, the
11 white layer including *a pigment providing a substantially*
12 *non-transparent, opaque background for received and*
13 *transferred indicia*; and
14 a silicone-coated removable substrate underlying
15 the white layer.
- 16 **Ex. 1519**, page 3:1-8; Paper 20, page 3:1-8 (italics added).
- 17 36. Bamberg states in its opposition that:
18 The claim language regarding "white layer" explicitly
19 states that the only requirement for the white layer of
20 claim 30 is to have "a pigment providing a substantially
21 non-transparent, opaque background for received and
22 transferred indicia."
23 Paper 225, page 6:23-26.
- 24 37. Dr. Williams agrees that claim 30 does not include a melting
25 temperature. **Ex. 2045**, page 32:17 to page 33:5.

1 38. The claims of Bamberg application 13/182,197 involved in
2 Interference 105,961 likewise “do not contain any claim language
3 requiring a melt temperature range.” Paper 225, page 7:7-8.

4 39. Method claim 23 refers to the “white layer” as:
5 at least one of the one or more polymer layers with a
6 pigment, the pigment having a concentration or
7 configuration sufficient to provide an opaque background
8 for received indicia, when transferred to a base.

9 **Ex. 1520**, page 3:6-8.

10 40. The two Bamberg applications involved in Interference 105,966 do
11 not “contain any claim language that includes or should be construed
12 to include a melt temperature range . . .”

13 Paper 225, page 8:1-2.

14 41. For example, claim 1 of Bamberg application 13/12/233,541 defines
15 the “white layer” as:

16 . . . a release layer contacting the image transfer substrate
17 and an image-imparting layer that comprises a polymer
18 that includes indicia wherein the release layer is
19 impregnated with one or more titanium oxide or other
20 white pigment

21 **Ex. 1523**, page 3:3-6.

22 42. The involved Bamberg claims include within their scope:

23 (1) embodiments where the white layer is “non-fusible at
24 ironing temperatures (i.e. [that is], up to about 220°C)” and

25 (2) embodiments where the white layer is fusible at ironing
26 temperatures *below* 220°C.

1 6. Written Description Portion
2 of Bamberg Specifications

- 3 43. Normally evaluation of a lack of adequate written description issues is
4 based on the patent or application in which the claims appear. *Cf.*
5 *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1346 (Fed. Cir. 2000).
- 6 44. To establish what is contained in the written description portion of the
7 Bamberg specifications, Dalvey refers to an English language
8 translation of Bamberg PCT application PCT/IB99/00976 (filed
9 1 June 1999) and published as WO 00/73750 (7 Dec. 2000)
10 **(Ex. 1001)**.
- 11 45. Bamberg has not objected to Dalvey's use of the Bamberg PCT
12 application, as opposed to its involved applications, to resolve Dalvey
13 Motion .
- 14 46. Consistent with what appears to be the desire of the parties, we
15 therefore decide the adequate written description issue on the basis of
16 the Bamberg PCT application. *Cf. Brand v. Miller*, 487 F.3d 862,
17 869 (Fed. Cir. 2007) (in an interference the Board's role is one of an
18 impartial adjudicator of an adversarial dispute between two parties).
- 19 47. There are at least two versions of the PCT application in the record.
20 A first version is identified as Exhibit 1001 and contains Board
21 Assigned Pages #1 through #23 (the Board assigns consecutive page
22 numbers to all exhibits filed). A second version is also identified as
23 Exhibit 1001 and contains Board Assigned Pages #1285 through
24 #1307. The pages of **Ex. 1001** referred to by the parties correspond to
25 the Board Assigned Pages of the first version. Accordingly, we elect

1 to refer to the first version of **Ex. 1001**. We attach to this opinion a
2 copy of **Ex. 1001** (Board **Ex. 3001**) consisting of Board Assigned
3 Pages #2 through #23 with some of the hand-written line numbers for
4 ease of reference.

5 48. According to Dalvey, “each and every embodiment described [in the
6 Bamberg PCT application] includes a white layer that **must not melt**
7 at temperature of up to 220°C.” (Bold in original, matter in brackets
8 added). Paper 110, page 7:5-6.

9 49. Dalvey relies on various portions of the Bamberg PCT specification to
10 support it “up to 220°C” argument.

11 50. **Ex. 3001**, page #6:31 to #7:6 (Paper 110, page 7:12-16):

12 The white background layer which is found directly on
13 the adhesive layer, according to the present invention,
14 comprises or is composed of permanently elastic plastics
15 which are **non-fusible at ironing temperatures (i.e.**
16 **[that is] up to about 220°C) and which are filled with**
17 **white pigments – also non-fusible (up to about 220°C).**
18 The elastic plastics must not melt at ironing temperatures
19 in order not to provide with the adhesive layer, e.g. the
20 hot-melt, which provides the adhesion to the textile
21 substrate, an undesired mixture with impaired (adhesive
22 and covering) properties.

23 51. **Ex. 3001**, page #7:17-18 (Paper 110, page 7:17-18) (bold added):

24 Suitable pigments are **only** those which do not melt at
25 ironing on temperatures.

26 52. **Ex. 3001**, page #7:30-32 (Paper 110, page 7:19-21) (bold added):

1 These pigments can be blended alone or also in a mixture
2 with other non-fusible (**up to 220°C**) carrier agents such
3 as for example silicates or aluminates.

4 53. **Ex. 3001**, page #16:6-29; see also Paper 110, page 7:27-30 (bold
5 added):

6 The coating method comprises the following steps . . .
7 b) application of a white background layer composed of
8 elastic plastics **which are non-fusible at ironing on**
9 **temperatures (i.e. up to about 220°C)**, and which are
10 filled with white, preferably inorganic, pigments onto the
11 hot-melt layer, preferably with a with a resulting layer
12 thickness of about 20-35 µm.

13 54. Original independent composition claim 1 of the Bamberg PCT
14 application also requires “a white background layer composed of
15 elastic plastics which are **non-fusible at temperatures up to 220°C.**”

16 **Ex. 3001**, page #20:8-9; Paper 110, page 7:31-33 (bold added).

17 55. Original independent method claim 14 calls for “application of a
18 white background layer composed of elastic plastics non-fusible at
19 temperatures (i.e. up to about 220°C).” **Ex. 3001**, page #22:9-10;
20 Paper 110, page 7:27-30.

21 56. The remaining original claims depend directly or indirectly from
22 independent composition claim 1 or independent method claim 14.

23 7. Testimony of Ulf Bamberg

24 57. While somewhat unusual, named Bamberg inventor Ulf Bamberg was
25 called to testify on behalf of Dalvey. **Ex. 2030.**

1 58. Mr. Bamberg testified about developing and testing of his invention.

2 **Ex. 2030, ¶¶ 3-7.**

3 59. One concern is said to have been a need “to develop a white
4 background layer that would bind effectively with the ink-receiving
5 layer and adhesive layer and would not crack or erode during typical
6 wear of the transfer substrate” **Ex. 2030, ¶ 7:1-3.**

7 60. Mr. Bamberg further testified as follows:

8 In addressing the need for a white background layer that
9 would retain a high level of contrast and resolution once
10 transferred, via application of heat, to the transfer
11 substrate, we came to understand that clarity and
12 resolution are decreased where the white background
13 layer is permitted to melt and mix with the ink-receiving
14 layer and/or the adhesive layer, causing the white
15 background layer to take on a hue of the transfer
16 substrate color. Accordingly, we developed a white
17 background layer that nonetheless formed a strong bind
18 with the ink-receiving layer **but did not melt at**
19 **conventional iron-pressing temperatures (i.e. [that is]**
20 **temperatures up to about 220°C).**

21
22 That the white background layer comprised an elastic
23 plastic and did not melt and mix with the ink-receiving
24 layer at conventional iron-pressing temperatures, yet had
25 good adhesion with the adjacent layers, were very
26 important to the Invention and were required aspects of
27 the white background layer described in the
28 [Bamberg PCT application].

29 **Ex. 2030, ¶¶ 9-10 (bold added).**

30 8. Dalvey Disclosure

- 1 61. Consistent with *Agilent*, we turn to what is described in the descriptive
2 portion of the Dalvey patents.
- 3 62. A point in dispute between the parties is whether the descriptive
4 portion of the Dalvey specification describes “white layers” having a
5 melting point below “about 220°C.”
- 6 63. In support of its discussion of the content of the Dalvey specifications,
7 Dalvey refers to **Ex. 2013**—Dalvey U.S. Patent No. 6,884,311 B1
8 (Apr. 26, 2005) (“’311 Dalvey Patent”). The ’311 Dalvey Patent has
9 a few errors, particularly when it comes to descriptions of what is
10 shown in the drawings. *See, e.g.*, Fig. 6 and compare with the
11 discussion at col. 10:15-48 mentioning drawing numbers which do not
12 appear in Fig. 6. Moreover, the ’311 Dalvey Patent is not involved in
13 the interferences. In order to avoid confusion, we refer to **Ex. 2040**—
14 Dalvey U.S. Patent No. 7,749,581 B2, a Dalvey patent involved in
15 Interference 105,964.
- 16 64. According to Bamberg, the “white layer” described by Dalvey does
17 not melt at ironing temperatures (presumably meaning temperatures
18 above about 220° C.). Paper 225, page 15:12-13.
- 19 65. In support of its position, Bamberg relies on the following:
20 Because the polymeric component of the peel layer **520**
21 generally has a high melting point, the application of heat, such
22 as from an iron, does not result in melting of this layer or in a
23 significant change in viscosity of the overall peel layer **520**.
24 The change in viscosity is confined to the polymeric component
25 that actually contacts the ink or toner and is immediately
26 adjacent to the ink or toner.

1 *Id.*, **Ex. 2013**, col. 9:34-41; **Ex. 2040**, col. 9:33-39. We note that
 2 element **520** does not appear in the drawings.

3 66. Unlike Bamberg, Dalvey does not describe a minimum melting
 4 temperature.

5 67. Fig. 8 of the '311 Dalvey patent is reproduced below.

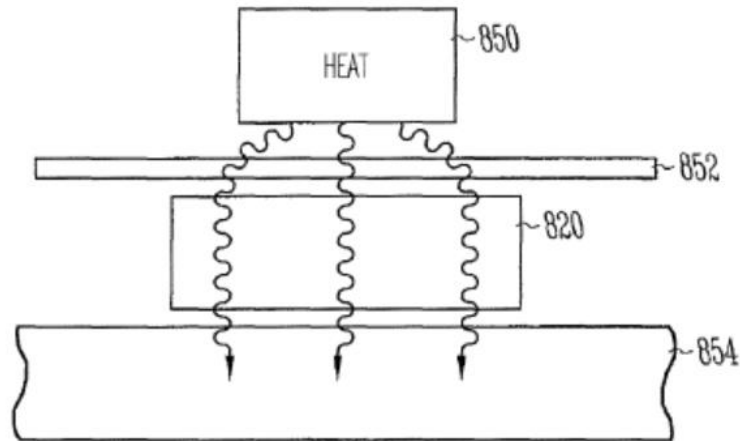


Fig. 8

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Fig 8 depicts a a cross-sectional view of one
 process of image transfer onto a colored product.

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68. Example 4 has the following to say about Fig. 8:

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As shown at **800** in Fig. 8, the peeled printed layers **820**, including at least one or more layers collectively comprising a white or luminescent pigment and received indicia, were then placed against a fabric **854** and covered with release paper **852**. Heat **850** was applied to the peeled printed layers **820** and the release paper **852**. The heat **850** was applied at 200 F, 225 F, 250 F, 300 F, 350 F, and 400 F. A good image transfer was observed for all of these temperatures.

1 **Ex. 2040**, col. 10:65 to col. 11:5.

2 69. The Farenheit temperatures described by Dalvey converted to
3 Centigrade temperatures are set out below:

Farenheit	Centigrade
200	~93
225	~107
250	~121
300	~148
350	~177
400	~204

4 70. On the other hand, Bamberg describes iron-on temperatures in the
5 range of 160 to 220°C, preferably 170°C. **Ex. 3001**, page 17:1-4; *see*
6 *also Ex. 3001*, page 18:31 (“about 190°C”).

7 71. The iron-on temperatures described by Dalvey are consistent with the
8 use of plastics that are viscous at temperatures lower than the plastics
9 described by Bamberg.

10 9. Testimony of Dr. Williams and Dr. Risen

11 72. Dr. Williams explains why he could *not* find a Bamberg written
12 description of a white layer that melted or was fusible at temperatures
13 *below* 220°C. **Ex. 2016**, ¶¶ 13, 15, and 18.

14 73. His testimony is based on his analysis of (1) portions of the Bamberg
15 PCT priority document (**Ex. 2016**, ¶ 13) and (2) testimony of Ulf
16 Bamberg (**Ex. 2016**, ¶ 19–20).

- 1 74. Dr. Risen, while generally addressing an adhesive layer, does not
2 convincingly explain how the Bamberg PCT application adequately
3 describes a “white layer” having a melting temperature *below* about
4 220 °C.
- 5 75. Dr. Risen, while critical of Dr. Williams (**Ex. 1531**, ¶¶ 36–38),
6 nowhere points to any portion of the Bamberg PCT application
7 discussing a “white layer” having a melting point below about 200°C.
- 8 76. To the extent there is a conflict between the testimony of Dr. Williams
9 and that of Dr. Risen, we credit the testimony of Dr. Williams over
10 that of Dr. Risen.
- 11 77. Unlike Dr. Risen, the facts and opinions stated by Dr. Williams are
12 based on the relevant document, *viz.*, the Bamberg PCT application
13 and are more consistent with than document than any opinion
14 expressed by Dr. Risen.
- 15 10. Prosecution History of
16 Bamberg Application 13/930,116
- 17 78. Dalvey calls attention to prosecution history in Bamberg
18 Application 13/930,116—an application not involved in these
19 interferences. Paper 110, page 8:24 to page 9:19.
- 20 79. In an Office Action dated 13 November 2013, the Examiner rejected
21 then pending claims 1-11 and 13-20 based on a lack of a written
22 description. Ex. 2008, page 2-3.
- 23 80. The Examiner found in connection with then-pending claims 1 and 19
24 that “[t]here is no support in the [descriptive portion of] the

1 specification for ‘a softening point temperature of less than about 220
2 degree[s] C.’ *Id.* at page 3:1-2.

- 3 81. Claim 1 of Bamberg application 13/930,116 read at the time as
4 follows:

5 An image transfer article, comprising: an image-parting
6 member having a softening point temperature less than
7 about 220 degree[]C., the image-imparting member
8 including (i) at least one surface configured to receive
9 and carry indicia to be transferred, the at least one surface
10 configured to be transferred in its entirety, and (ii) at least
11 one portion of a pigment which, when transferred,
12 provides an opaque background for received indicia; and
13 a removable substrate disposed adjacent the image-
14 imparting member.

15 **Ex. 2033**, page 2 (italics added).

- 16 82. Assigning any weight to the prosecution history is somewhat difficult
17 other than to note that Dr. Williams’ opinion with respect to lack of a
18 written description relating to the melt temperature is consistent with
19 the Examiner’s rejection. **Ex. 2016**, ¶¶ 21-22.

20 11. Additional Finding

- 21 83. The specifications of the involved Bamberg applications do not
22 contain an adequate written description of the subject matter claimed
23 in those applications.

1 C. Analysis

2 1. *Agilent*-based Analysis

3 Bamberg copied claims from the Dalvey patents to provoke the interference.

4 Accordingly, the scope of the copied claims is to be determined based on the
5 written description of the Dalvey patents. *Agilent Technologies, Inc. v. Affymetrix,*
6 *Inc.*, 567 F.3d 1366, 1377 (Fed. Cir. 2009).

7 In so many words, Dalvey does not describe a “white layer” that comprises
8 “plastics which are [required to be] non-fusible at ironing temperatures (i.e., up to
9 about 220° C)” (**Ex. 1001**, page 6:28-35.

10 Therefore, under *Agilent*, the Bamberg claims are to be construed as
11 “generic” claims for the purpose of determining whether Bamberg describes the
12 Dalvey inventions.

13 We find that Dalvey describes a “generic” invention where any suitable
14 white layer may be used whereas Bamberg describes a “sub-generic” invention
15 within the scope of Dalvey’s “generic” invention where the Bamberg white layer
16 must be made of plastics that are non-fusible at ironing temperatures “up to about
17 220°C.”

18 Dalvey does not require use of a plastic that is non-fusible at ironing
19 temperatures up to about 220°C.

20 When Bamberg’s claims are construed pursuant to *Agilent*, we next look to
21 the descriptive portion of the Bamberg specification with the view to determining
22 whether Bamberg describes the Dalvey “generic” invention.

23 As is apparent from our findings, we find that Bamberg does not describe
24 Dalvey’s “generic” invention.

1 It follows that under *Agilent*, Bamberg lacks the necessary written
2 description and therefore the Bamberg claims involved in the interference are not
3 patentable to Bamberg.

4 2. Non-*Agilent* Analysis

5 In opposing Dalvey Motion 3, Bamberg does not expressly concede that
6 *Agilent* is applicable precedent as applied to these interferences.

7 Rather, we understand that Bamberg is arguing that (1) the principles of
8 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) apply,
9 (2) words of the involved Bamberg claims should be given their ordinary meaning,
10 (3) when the words are given their ordinary meaning the claims should be
11 construed broadly to cover what we have referred to as a “generic” invention, and
12 (4) the descriptive portion of the involved Bamberg specification support a
13 “generic” invention. Paper 225, page 2:21 through page 3:12.

14 Bamberg goes on to say that limitations from a specification cannot be read
15 into the claims. *Id.* page 3:13-24.

16 Basically, what Bamberg may be arguing is that the Bamberg claims should
17 be construed in light of the descriptive portion of the Bamberg specifications.
18 *Cf. United States v. Adams*, 383 U.S. 39, 49 (1966), claims of a patent limit the
19 invention and the specification cannot be used to broaden the invention;
20 nevertheless claims are to be construed in light of the specification and both the
21 specification and claims are to be read with a view to ascertaining the invention);
22 *Am. Fruit Growers v. Brogdex Co.*, 283 U.S. 1, 5 (1931) (the claim of a patent
23 must always be explained by and read in connection with the specification).

1 Assuming *arguendo* that *Agilent* is not applicable precedent, as our above-
2 discussed findings make clear, we would reach the same finding, *viz.*, the
3 descriptive portion of the Bamberg specifications do not provide an adequate
4 written description of a “white layer” made of plastics that are non-fusible at
5 ironing temperatures *below* about 220°C.

6 Thus, apart from *Agilent*, it still follows that the broadly claimed Bamberg
7 subject matter is not described in the descriptive portions of the Bamberg
8 specifications.

9 D. Decision

10 For the reasons given, Dalvey Motion 3 is *granted*, based solely on a failure
11 of Bamberg to satisfy the written description requirement of the first paragraph of
12 35 U.S.C. § 112.

13 We have not considered or decided any issue in connection with Dalvey’s
14 lack of enablement arguments.

15 VI. Bamberg Responsive Motion 5

16 A. Background

17 In response to Dalvey Motion 3 (lack of written description), Bamberg
18 Responsive Motion 5 requests entry of amendments in Bamberg applications:

- 19 (1) Bamberg application 13/182,197 (Paper 130, Appendix 3);
20 (2) Bamberg application 13/177,284 (Paper 130, Appendix 5);
21 (3) Bamberg application 13/223,541 (Paper 130, Appendix 7); and
22 (4) Bamberg application 13/207,236 (Paper 130, Appendix 9)

23 Dalvey has opposed. Paper 217.

1 Bamberg has replied. Paper 258.

2 B. Facts

3 1. Requirement for a Claim Chart

4 1. The rules provide that the Board may authorize a party to file a
5 responsive motion to add amended claims. 37 C.F.R. § 41.121 (a)(2).

6 2. The rules specifically provide:

7 Any motion to add a claim must include . . . [a] claim chart
8 showing where the disclosure of the . . . application provides
9 written description of the subject of the claim

10 37 C.F.R. § 41.110(c)(2).

11 3. The Standing Order (Paper 2) also discusses the need for claim charts.
12 Standing Order ¶ 110.

13 4. Paragraph 110 states that “[a] movant seeking to add a claim must
14 comply with the requirements of Bd.R. 110(c) for the proposed
15 claim.” Standing Order, ¶ 110 (first sentence).

16 5. The Federal Register Notice of Final Rule advises that “a movant
17 adding a claim must show where the written description for the claim
18 can be found (§ 41.110(c)(2)).” 69 Fed. Reg. 49960, 49995 (col. 2,
19 first full paragraph, second sentence) (Aug. 12, 2004).

20 6. The requirement for a claim chart serves a highly useful function in
21 administration of interferences.

22 7. Often an argument opposing a motion to add claims is a lack of
23 written description as to those claims.

24 8. A party seeking to add a claim, and providing a claim chart, puts the
25 opponent on notice of why the moving party believes the subject

- 1 matter proposed added claim is supported by an adequate written
2 description.
- 3 9. The claim chart permits the opponent to focus on those claimed
4 limitations that an opponent believes are not supported by an adequate
5 written description.
- 6 10. Any opposition can then address why the information in the claim
7 chart is not adequate to confirm support for a written description of
8 particular limitations.
- 9 11. The moving party may then file a reply with any observations in its
10 opponent's opposition.
- 11 12. Failure to file a claim chart complicates administration of interference
12 cases and is contrary to the policy objectives of the Director that
13 proceedings under Part 41 be conducted in a just, speedy, and
14 inexpensive manner. 37 C.F.R. § 41.1(b).
- 15 13. Where a party does not provide a claim chart, the opponent—a party
16 not having the burden of proof—out of an abundance of caution may
17 feel that it has to discuss in the first instance where a particular
18 limitation is not supported by an adequate written description.
- 19 14. In that case, the moving party addresses the opponent's observations
20 in its reply.
- 21 15. However, the rules do not authorize an opponent to file a sur-reply.
- 22 16. The opponent, therefore, would not have a fair opportunity to address
23 a moving party's views on where the descriptive portion of the
24 specification describes any contested limitation.

- 1 17. It is possible, of course, that the Board can authorize a sur-reply.
2 However, authorizing a sur-reply burdens both the opponent and the
3 Board.
- 4 18. If a party complies with the rules, no occasion arises (1) for the
5 opponent to ask for a conference call to seeking authorization to file a
6 sur-reply, (2) for the conference call, (3) for additional resources to be
7 expended by the opponent in preparing and filing a sur-reply, and
8 (4) possible delay in reaching a final resolution of the interference.

9 2. Bamberg—No Claim Chart Provided

- 10 19. Bamberg did not provide a claim chart with its Responsive Motion 5.
11 20. The lack of a claim chart was called to our attention, as well as to the
12 attention of Bamberg, in Dalvey Opposition 5. Paper 217, page 1:22
13 through page 2:2.
- 14 21. Notwithstanding this fact, we have not found in Bamberg Reply 5 any
15 discussion responsive to Dalvey's opposition observation concerning
16 the lack of claim chart.
- 17 22. Bamberg Motion 5 was accompanied by a Statement of Facts.
18 Paper 130, Appendix 2.
- 19 23. Dalvey Opposition 5 admits or denies facts set out by Bamberg.
20 Paper 217, Appendix 2.
- 21 24. Dalvey Appendix 2 does not set out any additional facts.
- 22 25. A conference call was held on 12 May 2014 after which a Post
23 Conference Call Order was entered. Paper 139.
- 24 26. Dalvey observes that:

1 [i]n view of the Board’s Post Conference call Order entered
2 May 12, 2014 (Paper 139), page 8, indicating that the parties
3 may, but no longer requiring the parties to, continue using a
4 statement facts in opposition and replies, however, Dalvey has
5 not provided additional facts in Appendix 2 instead opting to
6 provide all facts in the body of the opposition, as requested [by
7 the Board] during the telephone conference of May 1, 2014.

8 Paper 217, page 1:13-17.

- 9 27. The order provided , *inter alia*, that “[t]he parties may continue to use
10 [a] statement of facts in opposition and replies.” Paper 139, page 8.
- 11 28. Bamberg maintains that Dalvey “misread this Order.” Paper 258,
12 page 1:10.
- 13 29. As a result of Dalvey’s failure to supply additional facts (to be
14 admitted or denied), Bamberg says that it “is now unable to respond
15 properly to Dalvey’s additional ‘material facts’ . . . [Bamberg’s]
16 opposition.” Paper 258, page 1:15-16.
- 17 30. Dalvey did not “misread this Order.”
- 18 31. Rather, by use of the word “may”, the judge assigned to the
19 interferences authorized—consistent with the rules—facts to be set
20 out in (1) the body of an opposition or reply or (2) a statement of
21 facts. 37 C.F.R. § 41.104(b) (a rule may be waived); 37 C.F.R.
22 § 121(d) (requiring a statement of facts).
- 23 32. Dalvey elected to set out its additional facts in the body of its
24 opposition and we find no fault in Dalvey having done so.
- 25 33. Moreover, Dalvey Opposition 5 plainly factually states that Bamberg
26 did not supply the required claim chart. Paper 217, page 2:1-2.

1 C. Analysis

2 A party seeking to add a new claim has the burden of establishing that the
3 new claim is supported by an adequate written description. 37 C.F.R. § 41.121(b).

4 Because of the burden, the moving party must establish that all, not just
5 some, limitations in the claim proposed to be added are supported by an adequate
6 written description. In other words, the claim as a whole—as opposed to a
7 limitation of the claim—must be supported.

8 The Director has determined that the burden is best satisfied with a claim
9 chart. 37 C.F.R. § 41.110(c)(2).

10 Contrary to the Director’s policy requiring a claim chart, Bamberg in its
11 statement of facts details only where some, but not all, of the claimed limitations
12 that are said to be supported in the descriptive portion of the specification.

13 Thus, Bamberg left Dalvey to figure out in the first instance whether the
14 proposed new claims are adequately supported—but that was not Dalvey’s burden.

15 Proposed new claim 39, to be added to involved Bamberg application
16 13/182,197, calls for “an adhesive layer with a softening point [that is] *less* than
17 about 220°C” Paper 130, Appendix 3, page 11-5 (italics added).

18 For example, according to Bamberg, “[t]he temperature range for new
19 claim 39 is supported in the specification of the Bamberg [PCT] priority
20 application. Ex. 1001 at 6[5], 8[2], 7[3], 8[5], 10[2] and 18[6]. Paper 130,
21 page 18, Fact 22.

22 A first difficulty with Fact 22 is that we are not sure what is meant by 6[5].

23 A second difficulty is that a computer word search of **Ex. 1001** does not
24 reveal any mention of the word “softening.”

1 A third difficulty is that even if there were support for the limitation,
2 Bamberg still would not have satisfied its burden to show that the claim *as a whole*
3 is supported by an adequate written description.

4 A fourth difficulty is that the proposed new claim needs to be supported in
5 the involved Bamberg application. Showing that a claim is supported in a priority
6 application does not necessarily establish support in an involved application.

7 Bamberg's election not to present a claim chart ultimately amounts to a
8 subtle way of shifting the burden of proof to Dalvey.

9 The shift becomes apparent from the remarks in the Bamberg reply
10 concerning its alleged "inability" to respond to Dalvey's opposition due to an
11 alleged failure on the part of Dalvey to present additional facts in a statement of
12 facts.

13 To the extent that Bamberg had an "inability," that "inability" is a self-
14 imposed hardship brought on by Bamberg's failure to supply a claim chart in the
15 first instance.

16 D. Decision

17 For the reasons given, Bamberg Motion 5 is *denied*.

18 VII. Dalvey Miscellaneous Motion 8

19 Dalvey Miscellaneous Motion 8 seeks exclusion of some of Bamberg's
20 evidence.

21 However, with one exception, none of the evidence sought to be excluded
22 has been relied upon by Bamberg in connection with Dalvey Motion 3 or Bamberg
23 Motion 5.

1 The exception is a part of the direct declaration testimony of Dr. Williams
2 related to enablement. **Ex. 2016**, ¶¶ 36-38.

3 We have not found it necessary to consider ¶¶ 36-38. We did not find it
4 necessary to reach enablement because we found that Dalvey sustained its burden
5 with respect to Dalvey Motion 3 based on lack of written description.

6 Accordingly, we need not further consider Dalvey Miscellaneous Motion 8.

7 Dalvey Miscellaneous Motion 8 is *dismissed* without prejudice to further
8 consideration should it become necessary.

9 VIII. Bamberg Miscellaneous Motion 7

10 Bamberg Miscellaneous Motion 7 seeks exclusion of some of Dalvey's
11 evidence.

12 However, none of the evidence sought to be excluded has been relied upon
13 in connection with Dalvey Motion 3 or Dalvey Opposition 5.

14 Accordingly, we need not further consider Bamberg Miscellaneous
15 Motion 7.

16 Bamberg Miscellaneous Motion 7 is *dismissed* without prejudice to further
17 consideration should it become necessary.

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