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Paper 178
Entered: 22 May 2014

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, *Administrative Patent Judge*.

FOURTH REDECLARATION

1 I. Introduction

2 This Fourth Redeclaration is being entered to consolidate in one paper all
3 relevant information in (1) Interference 105,961, (2) Interference 105,964,
4 and (3) Interference 105,966.

5 Unless otherwise noted, a reference to a Paper is to a Paper filed in
6 Interference 105,964.

7 It is noted that in some patents inventor Nassar's first name is listed as
8 "Nabil" whereas in other places in the record the name is listed as "Nabill".

9 This fourth redeclaration uses the first name "Nabil".

10 II. Declarations and previous redeclarations of the interferences

11 A. Interference 105,961

12 Interference 105,961 was declared on 26 September 2013. Interference
13 105,961, Paper 1.

14 B. Interference 105,964

15 Interference 105, 964 was declared on 26 September 2013. Paper 1.

16 A "first" redeclaration order was entered in Interference 105,964 on
17 27 November 2013. Paper 40.

18 C. Interference 105,966

19 Interference 105,966 was declared on 26 September 2013. Interference
20 105,966, Paper 1.

21 A "second" redeclaration order was entered in Interference 105,966 on
22 27 November 2013. Interference 105,966, Paper 42.

23 A "third" redeclaration order was entered in Interference 105,966 on
24 4 March 2014. Interference 105,964, Paper 124.

1 III. Papers in interferences

2 The file of Interference 105,961 contains Papers 1-40, as well as a transfer
3 order.

4 The file of Interference 105,966 contains Papers 1-45, as well as a transfer
5 order.

6 With the exception of transfer orders, since February of 2014, all papers in
7 all interferences have been entered as papers in Interference 105,964.

8 All papers will continue to be entered in Interference 105,964, until a final
9 decision and judgment is entered in Interference 105,964, at which time a copy of
10 the final decision and judgment will be entered in Interference 105,961 and
11 Interference 105,966.

12 As set out in this “fourth” redeclaration, Count 1 continues to appear in
13 Interference 105,964. Count 2 appears in Interference 105,961 (replacing Count 1
14 of that interference). Count 3 appears in Interference 105,966 (replacing original
15 Count 1 of that interference).

16 IV. Interference 105,961

17 A. Identification and order of the parties

18 1. Junior Party (1 patent)

19 Named Inventors: Jodi A. Dalvey, Minnesota
20 Nabil F. Nasser, Minnesota

21
22 Patent: US 7,754,042 B2
23 issued 13 July 2010
24 based on application 12/193,573
25 filed 18 August 2008

26
27 Patent Pub: U.S. Patent Publication 2008/0305253 A1
28 11 December 2008

1
2 Title: Method of image transfer on a colored base

3
4 Assignee: Jodi A. Schwendimann

5
6 2. Senior Party (1 application)

7
8 Named Inventors: Ulf Bamberg, Germany¹
9 Peter Kummer, Switzerland
10 Ilona Stiburek, Switzerland

11
12 Application: Application 13/182,197,
13 filed 13 July 2011

14
15 Patent Pub: U.S. Patent Publication 2012/0120170 A1
16 17 May 2012

17
18 Title: Ink-jet transfer system for dark textile substrates

19
20 Assignee: Arkwright Advanced Coating, Inc.
21

22 B. Count, claims of the parties, and accorded benefit

23 1. Count 2²

24 A method according to Claim 23 of Bamberg application 13/182,197

25 or

26 a method according to Claim 1 of Dalvey Patent 7,754,042.

¹ The PTAB understands that inventor Bamberg now resides in Australia.

² Count 2 replaces Count 1 of Interference 105,961. Original Count 1 of Interference 105,961 called for a “device” but it is clear from the claims mentioned in original Count 1 (now Count 2) that a method—not a device—is involved.

1 2. Claims of the parties

2 The claims of the parties are:

3 Dalvey: 1-22

4 Bamberg: 23-34

5 The claims of the parties corresponding to Count 2 are:

6 Dalvey: 1-22

7 Bamberg: 23-34

8 The claims of the parties *not* corresponding to Count 2 are:

9 Dalvey: None

10 Bamberg: None

11 3. Benefit

12 The parties are accorded the following benefit for Count 2:

13 Dalvey: Application 12/193,573, filed 18 August 2008
14 Application 12/034,392, filed 21 February 2008
15 Application 10/911,249, filed 04 August 2004
16 Application 09/541,845, filed 03 April 2000
17 Application 09/391,910, filed 09 September 1999

18
19 Bamberg: Application 13/182,197, filed 13 July 2011
20 Application 12/977,555, filed 23 December 2010
21 Application 09/980,466, filed 12 April 2006
22 Int'l Application IB99/00976, filed 01 June 1999
23

24 V. Interference 105,964

25 A. Identification and order of the parties

26 1. Junior Party (4 patents)

27 a. First patent

28 Named Inventors: Jodi A. Dalvey, Minnesota
29 Nabil F. Nasser, Minnesota

1
2 Patent: US 7,749,581 B2
3 issued 06 July 2010
4 based on application 12/193,578
5 filed 18 August 2008
6
7 Patent Pub: U.S. Patent Publication 2008/0305288 A1
8 11 December 2008
9
10 Title: Image transfer on a colored base
11
12 Assignee: Jodi A. Schwendimann

13 **b. Second patent**

14 Named Inventors: Jodi A. Dalvey, Minnesota
15 Nabil F. Nasser, Minnesota
16
17 Patent: US 7,766,475 B2
18 issued 03 August 2010
19 based on application 12/193,562
20 filed 18 August 2008
21
22 Patent Pub: U.S. Patent Publication 2008/0302473 A1
23 11 December 2008
24
25 Title: Image transfer on a colored base
26
27 Assignee: Jodi A. Schwendimann

28 **c. Third patent**

29 Named Inventors: Jodi A. Dalvey, Minnesota
30 Nabil F. Nasser, Ohio
31
32 Patent: US 8,361,574 B2
33 issued 29 January 2013
34 based on application 12/875,445
35 filed 03 September 2010

1
2 Patent Pub: U.S. Patent Publication 2010/0323132 A1
3 23 December 2010
4
5 Title: Image transfer on a colored base
6
7 Assignee: Jodi A. Schwendimann
8
9 **d. Fourth patent**
10 Named Inventors: Jodi A. Schwendimann, Minnesota
11 Nabil F. Nasser, Ohio
12 Patent: US 8,703,256 B2
13 issued 22 April 2014
14 based on application 13/745,995
15 filed 21 January 2013
16
17 Patent Pub: U.S. Patent Publication 2013/0142970 A1
18 06 June 2013
19
20 Title: Image transfer on a colored base
21
22 Assignee: Jodi A. Schwendimann
23 2. Senior party (1 application)
24
25 Named Inventors: Ulf Bamberg, Germany
26 Peter Kummer, Switzerland
27 Ilona Stiburek, Switzerland
28
29 Application: Application 13/177,284,
30 filed 06 July 2011
31
32 Patent Pub: U.S. Patent Publication 2012/0092429 A1
33 19 April 2012
34
35 Title: Ink-jet transfer system for dark textile substrates
36

1 Assignee: Arkwright Advanced Coating, Inc.
2

3 B. Count, claims of the parties, and accorded benefit

4 1. Count 1

5 An image transfer article according to Claim 30 of Bamberg
6 application 13/177,284

7 or

8 an image transfer article according to Claim 1 of Dalvey Patent 7,749,581

9 or

10 an ink-jet transfer article according to Claim 1 of Dalvey Patent 7,766,475 B2

11 or

12 an image transfer article according to Claim 15 of Dalvey Patent 8,361,574 B2

13 or

14 an image transfer article according to Claim 1 of Dalvey Patent 8,703,256 B2.

15 2. Claims of the parties

16 The claims of the parties are:

17
18 Dalvey: 1-31 (US Patent 7,749,581 B2)
19 1-21 (US Patent 7,766,475 B2)
20 1-20 (US Patent 8,361,574 B2)
21 1-20 (US Patent 8,703,256 B2)

22
23 Bamberg: 30-49
24

1 The claims of the parties corresponding to Count 1 are:

2 Dalvey: 1-31 (US Patent 7,749,581 B2)
3 1-21 (US Patent 7,766,475 B2)
4 1-20 (US Patent 8,361,574 B2)
5 1-20 (US Patent 8,703,256 B2)
6

7 Bamberg: 30-49

8 The claims of the parties *not* corresponding to Count 1 are:

9 Dalvey: None

10 Bamberg: None

11 3. Benefit

12 The parties are accorded the following benefit for Count 1:

13 Dalvey (US Patent 7,749,581 B2):

14 Application 12/193,578, filed 18 August 2008
15 Application 12/034,932, filed 21 February 2008
16 Application 10/911,249, filed 04 August 2004
17 Application 09/541,845, filed 03 April 2000
18 Application 09/391,910, filed 09 September 1999
19

20 Dalvey (US Patent 7,766,475 B2):

21 Application 12/193,562, filed 18 August 2008
22 Application 12/034,932, filed 21 February 2008
23 Application 10/911,249, filed 04 August 2004
24 Application 09/541,845, filed 03 April 2000
25 Application 09/391,910, filed 09 September 1999
26

27 Dalvey (US Patent 8,361,574):

28 Application 12/875,445, filed 03 September 2010
29 Application 10/911,249, filed 04 August 2004
30 Application 09/541,845, filed 03 April 2000
31

1 Dalvey (US Patent 8,703,256):

2 Application 13/745,995, filed 21 January 2013
3 Application 12/875,445, filed 03 September 2010
4 Application 10/911,249, filed 04 August 2004
5 Application 09/541,845, filed 03 April 2000
6 Application 09/391,910, filed 09 September 1999

7
8 Bamberg:

9 Application 12/977,555, filed 23 December 2010
10 Application 09/980,466, filed 12 April 2006
11 Int'l Application IB99/00976, filed 01 June 1999

12 VI. Interference 105,966

13 A. Identification and order of the parties

14 1. Junior Party (1 patent and 1 reissue)

15 **a. Patent**

16 Named Inventors: Jodi A. Dalvey, Minnesota
17 Nabil F. Nasser, Minnesota

18
19 Patent: US 7,771,554 B2
20 issued 10 August 2010
21 based on application 12/034,932
22 filed 21 February 2008

23
24 Patent Pub: U.S. Patent Publication 2008/0149263 A1
25 26 June 2008

26
27 Title: Image transfer on a colored base

28
29 Assignee: Jodi A. Schwendimann

30
31 **b. Reissue patent**

32 Named Inventors: Jodi A. Schwendimann
33 a/k/a Jodi A. Dalvey, Minnesota
34 Nabil F. Nasser, Minnesota

1
2 Patent: RE 41,623 E, issued 07 September 2010
3 (US Patent 6,884,311 issued 26 April 2005)
4 based on application 12/218,260
5 filed 11 July 2008
6
7 Title: Method of image transfer on a colored base
8
9 Assignee: Jodi A. Schwendimann

2. Senior Party (2 applications)

a. First application

Named Inventors: Ulf Bamberg, Germany
Peter Kummer, Switzerland
Ilona Stiburek, Switzerland

Application: Application 13/223,541,
filed 01 September 2011

Patent Pub: U.S. Patent Publication 2012/0105560 A1
03 May 2012

Title: Ink-jet transfer system for dark textile substrates

Assignee: Arkwright Advanced Coating, Inc.

b. Second application

Named Inventors: Ulf Bamberg, Germany
Peter Kummer, Switzerland
Ilona Stiburek, Switzerland

Application: Application 13/207,236,
filed 10 August 2011

Patent Pub: U.S. Patent Publication 2012/0120132 A1
17 May 2012

Title: Ink-jet transfer system for dark textile substrates

Assignee: Arkwright Advanced Coating, Inc.

B. Count, claims of the parties, and accorded benefit

1. Count 3

A method according to Claim 1 of Bamberg application 13/207,236,

or

1 a method³ according to Claim 1 of Bamberg application 13/223,541,

2 or

3 a method according to Claim 1 of Dalvey RE 41,623 E,

4 or

5 a method according to Claim 1 of Dalvey Patent 7,771,554 B2.

6 2. Claims of the parties

7 The claims of the parties are:

8 Dalvey: 1-17 (RE 41,623 E)
9 1-14 (US Patent 7,771,554 B2)

10 Bamberg: 1-14 (Application 13/207,236)
11 1-17 (Application 13/223,541)

12 The claims of the parties corresponding to Count 3 are:

13 Dalvey: 1-17 (RE 41,623 E)
14 1-14 (US Patent 7,771,554 B2)

15 Bamberg: 1-14 (Application 13/207,236)
16 1-17 (Application 13/223,541)

17
18 The claims of the parties *not* corresponding to Count 3 are:

19 Dalvey: None

20 Bamberg: None

³ Count 3 replaces Count 1 of Interference 105,966. Count 1 of Interference 105,966 calls for a “device” but it is clear from the claims mentioned in Count 1 (now Count 3) that a method—not a device—is involved.

3. Benefit

The parties are accorded the following benefit for Count 3:

Dalvey (RE 41,623 E):

Application 12/218,260, filed 11 July 2008

Application 09/541,845, filed 03 April 2000

Application 09/391,910, filed 09 September 1999

Dalvey (US Patent 7,771,554 B2):

Application 12/034,932, 21 February 2008

Application 10/911,249, filed 04 August 2004

Application 09/541,845, filed 03 April 2000

Application 09/391,910, filed 09 September 1999

Bamberg (both applications):

Application 12/977,555, filed 23 December 2010

Application 09/980,466, filed 12 April 2006

Int'l Application IB99/00976, filed 01 June 1999

1 cc (via Electronic mail):
2
3 Junior Party Dalvey:
4
5 Devan V. Padmanabhan (dpadmanabhan@winthrop.com)
6 Nathan J. Witzany (nwitzany@winthrop.com)
7
8 Senior Party Bamberg:
9
10 Bruce J. Koch, Esq. (bkoch@schmidt-llc.com)
11 Thorsten Schmmidt, Esq. (tschmidt@schmidt-llc.com)