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Paper 19
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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ROBERT ROWELLS and GREGORY SAELE
Junior Party
(Application 10/745,435),

v.

KEVIN VICHINSKY
Senior Party
(Patent 6,742,489).
Patent Interference No. 105,518 (SCM)

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

MEDLEY, Administrative Patent Judge.

Decision – Order to Show Cause – Bd.R. 202(d)

A. Statement of the Case

This interference was declared on 10 January 2007. At that time, the Board determined that Rowells' Bd.R. 202(d) showing was insufficient to demonstrate that it will prevail on priority. The basis of Rowells' showing was that Vichinsky derived the invention from Rowells. Although Rowells demonstrated a prior conception, Rowells did not sufficiently demonstrate a corroborated communication of the conception to Vichinsky. Rowells was ordered to show cause why judgment should not be entered against it (Paper 3). On 20 February 2007, Rowells filed a response to the order to show cause (Paper 18).

1 **B. Issue**

2 The issue before us is whether Rowells’ response to the order to show cause
3 sufficiently demonstrates that Vichinsky derived the invention from Rowells and
4 therefore judgment should not be entered against Rowells?

5 For the reasons that follow, Rowells’ response fails to sufficiently
6 demonstrate that judgment should not be entered against it.

7 **C. Findings of fact¹**

8 1. Rowells is involved on the basis of application 10/745,435, filed 23
9 December 2003.

10 2. Vichinsky is involved on the basis of patent 6,742,489, granted 1 June
11 2004, based on application 10/244,544, filed 17 September 2002.

12 3. Vichinsky has been accorded benefit for the purpose of priority of
13 application 60/323,072, filed 19 September 2001.

14 4. Rowells earliest constructive reduction to practice is over two years later
15 than Vichinsky’s earliest constructive reduction to practice.

16 5. Count 1, the sole count, is as follows:

17 Rowells application 10/745,435 claim 1

18 6. Rowells claim 1 is as follows:

19 A combined air intake manifold and fuel rail for an internal
20 combustion engine comprising a hollow portion defining an air
21 channel with an open face, and a mounting flange portion having a
22 recess in an underside thereof defining a fuel delivery channel, said
23 manifold adapted to be installed on an engine head with the open face
24 of the air intake channel positioned over a series of air intake ports
25 and the fuel delivery channel overlying an array of fuel inlet openings

1 The following findings of fact as well as those contained elsewhere in this opinion are supported by a preponderance of the evidence.

1 in the engine head.

2
3 Order to Show Cause

4 7. Rowells filed a showing under Bd.R. 202(d).

5 8. Rowells' showing as to how it will prevail on priority is based on
6 derivation (Application 10/745,435, 11 May 2006 Response at Para. 4)

7 9. Rowells' showing is sufficient to demonstrate that Rowells conceived of
8 the invention prior to Vichinsky's 19 September 2001 constructive reduction to
9 practice (Paper 3 at 3).

10 10. Rowells' failed to sufficiently demonstrate that Vichinsky derived the
11 invention from Rowells, as explained per the Order to Show Cause (Paper 3 at 4-5)
12 as follows:

13 Counsel for Rowells argued in the 5 January 2005 response and
14 again in the 11 May 2006 response that the basis for showing priority
15 of invention was that Vichinsky derived the invention from Rowells.
16 Apparently in support of the assertion, Saele testified that on a date
17 prior to 19 September 2001 he disclosed the conception of the
18 invention to certain employees and/or agents of Mann & Hummel,
19 Inc. and/or Mann & Hummel Automotive, Inc. (Saele Declaration,
20 ¶¶14-15). The Vichinsky patent is assigned to "Filterwerk Mann &
21 Hummel GmbH" and not "Mann & Hummel, Inc." or "Mann &
22 Hummel Automotive, Inc." No explanation is provided as to why a
23 disclosure to "Mann & Hummel, Inc." and/or "Mann & Hummel
24 Automotive, Inc." agents and/or employees would in effect be a
25 communication of the conception to agents and/or employees of
26 "Filterwerk Mann & Hummel GmbH." In any event, the
27 communication of the conception must be to the opponent. Based on
28 the record, Rowells has failed to sufficiently demonstrate that the
29 conception of the invention was communicated to Kevin Vichinsky as
30 required.

31 Derivation also requires corroboration. Rowells' corroborating
32 witness Bergman does not corroborate a communication of the alleged
33 conception to Kevin Vichinsky. Nor do any of the exhibits A through

1 E provide independent corroborating evidence of a communication of
2 a conception of the invention to Kevin Vichinsky. To the extent that
3 Rowells relies on argument of counsel that is insufficient. Argument
4 of counsel cannot take the place of record evidence. For these
5 reasons, Rowells has failed to sufficiently establish that Vichinsky
6 derived the invention.
7

8 11. Rowells was ordered to show cause why judgment should not be
9 entered against it.

10 12. Rowells was not authorized to file additional evidence in support of any
11 response that it might file, except under a showing of good cause. (Paper 3 at 5).

12 13. Vichinsky was not authorized to file an opposition to any response filed
13 by Rowells (Paper 3 at 6).

14 Rowell's Response

15 14. Rowells, in its response, argues that (1) the communication of the
16 conception was to Kevin Vichinsky, (2) the communication of the conception to
17 Kevin Vichinsky is corroborated, and (3) Vichinsky has not denied or shown that
18 Kevin Vichinsky did not derive the invention from Rowells (Paper 18).

19 15. Rowells argues that the disclosure of the conception to Mann &
20 Hummel Automotive, Inc. employees or agents by Gregory Saele was corroborated
21 by David G. Bergman in his declaration at paragraphs 5-10 (Paper 18 at 2).

22 16. Paragraphs 4-10 of the Bergman declaration are as follows:

23 4. On a date prior to 19 September 2001, I attended a meeting at the
24 Melrose Park Engineering Offices.

25 5. Exhibit "A" of the Declaration of Gregory Saele is a photocopy
26 (more fully explained in Paragraphs 6-9 below) of three-pages of a
27 typed paper prepared on a date prior to 19 September 2001 as a
28 summary of that meeting.

29 6. I believe Exhibit "A" to be an accurate copy of the corresponding
30 pages of the paper as it was originally prepared, with the exception

1 that a date, which is prior to 19 September 2001, has been deleted, and
2 I further believe that the content of Exhibit "A" accurately
3 summarizes presentations and discussions at the meeting.

4 7. Exhibit "A" describes possible design options for an I313 Intake
5 Manifold.

6 8. Two of those options are designated on the third page of Exhibit
7 "A" as "Open Channel w/leak path & 4 extra bolts" and "Open
8 Channel w/push-in-place gasket".

9 9. The "Open Channel" corresponds to an "integral fuel delivery
10 groove" in a face of the manifold that fits against a face of an engine
11 cylinder head.

12 10. Sheet 1/3 of Exhibit "B" of the Declaration of Gregory Saele is a
13 reduced photocopy of an engineering drawing prepared prior to 19
14 September 2001 and showing a view of an intake manifold with open
15 fuel channel as presented in the meeting referred to in Exhibit "A" and
16 Sheet 2/3 of Exhibit "B" is an enlargement of a section of Sheet 1/3 of
17 Exhibit "B".

18
19 17. Rowells argues that the file history of the Vichinsky patent states that
20 the postal address of Kevin Vichinsky is "c/o Mann & Hummel Automotive, Inc.,
21 6400 Sprinkle Road, Portage, Michigan" (Paper 18 at 2).

22 18. Rowells argues that the postal address is circumstantial evidence that
23 Kevin Vichinsky, on the filing date of the '489 patent, was an employee of Mann
24 & Hummel Automotive, Inc.

25 19. Rowells further argues that Vichinsky has not denied that Rowells'
26 conception was disclosed to Mann & Hummel Automotive, Inc. and has not denied
27 that Kevin Vichinsky was an employee of Mann & Hummel Automotive, Inc.
28 (Paper 18 at 2).

29 20. Rowells argues that it is reasonable to conclude that Kevin Vichinsky,
30 as an employee of Mann & Hummel Automotive, Inc. was informed of Rowells'
31 conception by the other employees and/or agents of Mann & Hummel Automotive,

1 Inc. who were at a meeting that took place on or before September 19, 2001 (Paper
2 18 at 3).

3 21. Rowells argues that the drawings attached to the declaration of Gregory
4 Saele, one of the Rowells inventors is strong circumstantial evidence of derivation.
5 (Paper 18 at 3).

6 22. Rowells argues that the drawings of the '489 patent are the same or
7 substantially the same as Rowells' Exhibits B and D, attached to the Saele
8 Declaration.

9 23. Rowells concludes that based on the record there is strong
10 circumstantial evidence that Kevin Vichinsky derived the invention from Rowells
11 (Paper 18 at 7). **D. Principles of Law**

12 When a question arises as to whether the junior party will prevail on the
13 issue of priority, the junior party may be ordered to show cause why judgment
14 should not be entered against it. Bd.R. 202(d). As stated in *Kistler v. Weber*, 412
15 F.2d 280, 285, 162 USPQ 214, 218-219 (CCPA 1969):

16 [t]he expense involved in a protracted interference, and the special
17 hardships workable on a patentee involved therein, are notorious, and
18 to minimize both, where possible, would appear to be the laudable
19 purpose of these rules.

20 Rowells as part of its 202(d) showing, successfully demonstrated a
21 conception prior to Vichinsky's 19 September 2001 accorded benefit date.
22 However, Rowells failed to sufficiently demonstrate a prior actual reduction to
23 practice, diligence, or derivation of the invention (Paper 3). Rowells apparently
24 does not challenge the Board's determination that Rowells failed to sufficiently
25 demonstrate a prior actual reduction to practice or diligence. Rather, in Rowells'

1 response to the order to show cause, Rowells argues that its initial showing
2 sufficiently demonstrates derivation of the invention by Kevin Vichinsky.

3 To prove derivation, a party must establish conception of the claimed subject
4 matter and communication of the conception to the opponent. *Price v. Symsek*, 988
5 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993). As with conception,
6 corroboration is required to support testimony of the communication. *Id.* at 1196,
7 26 USPQ2d at 1038. *See also Davis v. Reddy*, 620 F.2d 885, 889, 205 USPQ
8 1065, 1068 (CCPA 1980).

9 Rowells must show that it will prevail on priority by a preponderance of the
10 evidence. Bd.R. 207(a)(2). The burden of showing something by a preponderance
11 of the evidence requires the trier of fact to believe that the existence of a fact is
12 more probable than its nonexistence before the trier of fact may find in favor of the
13 party who carries the burden. *Concrete Pipe & Products of California, Inc. v.*
14 *Construction Laborers Pension Trust for Southern California*, 508 U.S. 602, 622,
15 113 S.Ct. 2264, 2279 (1993).

16 **E. Analysis**

17 In the order to show cause, the Board determined that Rowells did not
18 sufficiently establish a corroborated communication of the conception of the
19 invention. Rowells relied on inventor testimony alone to establish that the
20 conception was disclosed to agents and/or employees of “Mann & Hummel, Inc.”
21 and/or “Mann & Hummel Automotive, Inc.” As stated in the order to show cause,
22 Rowells failed to explain how a disclosure to agents and/or employees of “Mann &
23 Hummel, Inc.” and/or “Mann & Hummel Automotive, Inc.” would in effect be a
24 communication of the conception to agents and/or employees of “Filterwerk Mann

1 & Hummel GmbH,” the assignee of the Vichinsky application at the time it was
2 filed (ff 10).²

3 In response, Rowells argues that communication of the conception to Mann
4 & Hummel Automotive, Inc. was corroborated by Bergman, directing our attention
5 to paragraphs 5-10 of Bergman’s declaration, and that Kevin Vichinsky worked for
6 Mann & Hummel, Automotive, Inc. at the time the Vichinsky application was filed
7 (ffs 15-18). Although Rowells fails to explain how a disclosure to agents and/or
8 employees of “Mann & Hummel, Inc.” and/or “Mann & Hummel Automotive,
9 Inc.” would in effect be a communication of the conception to agents and/or
10 employees of “Filterwerk Mann & Hummel GmbH,” for purposes of this decision,
11 we assume without deciding that “Mann & Hummel Automotive, Inc.” was the
12 company that Kevin Vichinsky worked for at the time of the invention.

13 Nowhere in paragraphs 5-10 of his declaration is it apparent that Bergman
14 corroborates a communication of the conception to Mann & Hummel Automotive,
15 Inc. employees or agents as alleged. Those parts of Bergman’s declaration refer to
16 a meeting that was held prior to 19 September 2001 and a discussion of the
17 meeting minutes – a three page document labeled Exhibit A (ff 16). There is no
18 discussion by Bergman that, for example, employees or agents of Mann &
19 Hummel Automotive, Inc. attended the referred to meeting and that the conception
20 was conveyed to such employees or agents. Note, that even the declaration of
21 inventor Gregory Saele in the Rowells application does not support an argument
22 that any Mann & Hummel Automotive, Inc. employees or agents attended the
23 meeting. Rowells does not explain how Bergman’s paragraphs 5-10 corroborate a

2 ff denotes finding of fact.

1 communication of the conception to Mann & Hummel Automotive, Inc. employees
2 or agents.

3 Rowells' argument that Bergman's testimony corroborates communication
4 of the conception to Mann & Hummel Automotive, Inc. employees or agents is not
5 supported by paragraphs 5-10 of Bergman's declaration. To the extent that
6 Rowells relies on attorney argument to support the assertion, attorney argument
7 cannot replace record evidence. A communication of the conception has not taken
8 place merely because counsel argues that it did. Even if supporting evidence exists
9 somewhere in the record, it is counsel's role to identify such evidence. It would be
10 misplaced to expect the Board to search through the entire record in pursuit of
11 something that might support counsel's assertions.

12 In any event, communication to employees or agents of Mann & Hummel
13 Automotive, Inc., even if established, does not automatically demonstrate passing
14 of that information from the agents or employees in receipt of the information to
15 the named inventor of the Vichinsky patent – Kevin Vichinsky. For instance,
16 Rowells has not shown that a Mann & Hummel Automotive, Inc. employee or
17 agent even worked on the same project or reported to the same supervisor as Kevin
18 Vichinsky. It is not enough that Kevin Vichinsky worked for a company as
19 another employee or agent of the same company. At the very least, Rowells should
20 have established a connection between an employee or agent of Mann & Hummel
21 Automotive, Inc. and Kevin Vichinsky.

22 Rowells also argues that the similarities between the Vichinsky patent
23 drawings and the drawings attached to the inventor Saele's declaration provide
24 strong corroborating evidence that the conception was communicated to Kevin
25 Vichinsky (Paper 18 at 3-6). Rowells acknowledges that the Vichinsky patent

1 drawings and the drawings attached to Saele’s declaration are not the same (e.g.,
2 “Figure 1 of the ‘489 patent is a *substantial* duplicate of ... Exhibit D,” “the air
3 intake manifold disclosed in the ‘489 patent and shown in Figures 2 and 4 of the
4 ‘489 patent, is *substantially the same* as the intake manifold shown in ... Exhibits
5 B-1 and B-2.”). A comparison of the drawings of the ‘489 patent with the Exhibits
6 B and D attached to Saele’s declaration reveal that while there are some
7 similarities, there are also some differences.

8 Even if some of the drawings of the Vichinsky patent are similar to some of
9 the drawings attached to Saele’s declaration, that alone does not demonstrate that
10 Vichinsky derived the invention from Rowells. Although Rowells sufficiently
11 demonstrated that it conceived the invention prior to *the accorded benefit date* of
12 Vichinsky, that does not mean that Rowells is the first to conceive the invention.
13 Vichinsky could properly demonstrate conception prior to Rowell’s conception. In
14 other words, Rowells has not sufficiently demonstrated that it is more likely than
15 not, e.g., by a preponderance of the evidence, that Vichinsky derived the invention
16 from Rowells. The drawings, even if similar, do not demonstrate, by a
17 preponderance of the evidence, that a corroborated communication of the
18 conception was conveyed to Kevin Vichinsky.

19 Rowells argues that the absence of any disclaimer by Kevin Vichinsky that
20 he did not receive the conception from the employees and/or agents of Mann &
21 Hummel Automotive, Inc. raises a strong presumption that Rowells’ invention was
22 communicated to Kevin Vichinsky. No such presumption exists. Vichinsky was
23 specifically ordered not to file any papers in response to the order to show cause
24 (Paper 3 at 6). Indeed, Vichinsky need not respond. The burden of going forward
25 in this interference lies on Rowells alone. Bd.R. 202(d).

