

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 109

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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JEFFREY BEAM

Junior Party,<sup>1</sup>

LEE A. CHASE

Senior Party.

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Interference No. 103,836

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FINAL DECISION UNDER 37 CFR § 1.658

The invention at issue in this interference relates to a vehicle wheel assembly. The particular subject matter in issue is illustrated by count 1, the sole count, as follows:

Count 1

A composite vehicle wheel assembly comprising:

an annular rim defining a central axis and having a pair of spaced rim flanges;

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<sup>1</sup> Application No. 08/116,712, filed September 3, 1993, now U.S. Patent No. 5,368,370, issued November 29, 1994. Assignors to Thompson International.

<sup>2</sup> Application No. 08/479,658, filed June 7, 1995. Accorded Benefit of U.S. Application No. 08/412,619, filed March 29, 1995, now Patent No. 5,636,906, issued June 10, 1997; and U.S. Application No. 07/904,180, filed June 25, 1992.

Interference No. 103,836

a spider concentrically fixed within said rim for connecting to a rotating hub, said spider including a plurality of spokes;

an ornamental appliqué of a uniform material thickness overlapping said rim and said spider;

said appliqué having an annular outer connecting portion disposed adjacent one of said rim flanges, an annular inner connecting portion and a plurality of vent openings aligned between said spokes of said spider and positioned between said inner and outer connecting portions;

a curable adhesive of substantially uniform thickness disposed between said appliqué and said rim and said spider along overlapping surface areas; and

locking means coacting between said appliqué and said rim and said spider while said adhesive cures and for continued retention thereafter to hold said appliqué in place.

The claims of the parties which correspond to this count are:

Beam : Claims 1-17

Chase : Claims 24 and 44-48

This proceeding was declared on August 12, 1997 with count 1. At that time, Chase was accorded senior party status on the basis of the June 25, 1992 filing date of its parent U. S. Application No. 07/904,180.

On June 8, 1999, a preliminary motion of Beam for judgment on the ground that Chase does not have the right to make its claims corresponding to the count under the first paragraph of 35 U.S.C. § 112 (Paper No. 15) was denied with respect to claims 24 and 47 and was granted with respect to claims 44-46 and 48. At that time, a preliminary motion of Chase for judgment on the ground that Beam's involved claims are unpatentable under 35 U.S.C. §§ 102/103 over U.S. Patent No. 5,636,906 to Chase (Paper No. 9) was deferred to final hearing.

Both parties took testimony and filed briefs; the parties waived oral argument at final hearing.

The Issues

At page 2 of its opening brief, the party Beam presents the following issues:

1. Whether Chase claims 24 and 44-48 are unpatentable for failure to comply with 35 U.S.C. § 112, first paragraph.
2. Whether claims 1-11 and 14-17 of Beam are unpatentable under 35 U.S.C. §§ 102/103 over U.S. Patent No. 5,636,906 to Chase.
3. Priority of invention.

In addition to the above matters, at page 3-5 of its brief (Paper No. 50), the party Chase presents as issues the following:

1. Whether Beam is entitled to prove conception of the subject matter of the count at any time prior to June 1, 1992 based on its original preliminary statement.<sup>23</sup>
2. Whether Beam has established conception at any time prior to the June 25, 1992 effective filing date of Chase.
3. Whether Beam proved that it actually reduced the invention to practice.
4. Whether Beam has established reasonable diligence from just prior to senior party's entry into the field to a subsequent reduction to practice.
5. Whether Chase conceived the invention prior to Beam's conception.

Patentability of Chase's Claims 24 and 44-48

Beam contends that the senior party's involved application lacks support for the above claims under 35 U.S.C. § 112, first paragraph. With respect to Figure 3 of Chase, it is argued that the above claims are not supported because the overlay 20 (appliqué 20) does not cover any

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<sup>2</sup> This issue relates to the motion of Beam filed August 5, 1999 to correct its preliminary statement (Paper No. 42).

portion of the rim 12 since the flange 32 at the outer periphery of the appliqué is received in the recess 42 and attached at the perimeter of the wheel disk. According to Beam, Figure 3 cannot support a conclusion that appliqué 20 overlaps the rim 12 because the wheel 11 is of one-piece construction with no demarcation shown between the wheel disk 18 and the rim 12.

With respect to claims 24 and 47, Beam further contends at page 13 of its brief that Chase does not support the claimed elements of a curable adhesive disposed between the appliqué and the rim along overlapping surface areas because no adhesive 30 contacts the rim 12. It is urged that Chase does not disclose locking means coacting between the appliqué and the rim because bosses 48, recesses 50, fasteners 40 and overlay 20 coact with the wheel disk 18 and not the rim 12.

In opposition, Chase contends that the decision of the Administrative Patent Judge (APJ) in the Decision on Preliminary Motions (Paper No. 23) as to its claims 24 and 47 that these claims are supported by its disclosure was correct and should be affirmed, and that the decision in that same paper that its claims 44-46 and 48 are not supported by its disclosure should be reversed. With respect to claims 24 and 47, Chase asserts that the line of demarcation between the disk 18 and the rim 12 is the juncture between the axially thinner disk 18 and the axially thicker rim 12. Accordingly, Chase submits that appliqué 20 of its involved application is illustrated in Figure 3, at the bottom portion thereof, as overlapping rim 12.

With respect to claims 44-46 and 48, Chase contends that Figure 3 of its involved application illustrates a portion of the rim and a web or wheel disk portion that is covered by the appliqué 20. Chase draws attention to the fact that in Senior Party Exhibit No. 1 (CX-1), the specification of which corresponds to its involved application, at column 10, lines 22-25, the text

Interference No. 103,836

recites “[w]hile allowing the entire outboard surface of the wheel 11 to have a chrome-plated finish, the overlay 20. . .”

We are of the opinion that the party Chase supports its claims 24 and 44-48 under 35 U.S.C. § 112, first paragraph.

With respect to claims 24 and 47, we agree with Chase that the line of demarcation between the disk 18 and the rim 12 is the juncture between the axially thinner disk 18 and the axially thicker rim 12. Accordingly, appliqué 20 of Chase’s involved application is illustrated in Figure 3, at the bottom portion thereof, as overlapping rim 12. Similarly, adhesive 30 is disposed between the appliqué 20 and the rim 12. See the upper and lower portions of Figure 3. For example, in the upper portion of the figure, adhesive 30 is shown between rim 12 and overlay 20. The locking means coacts with the appliqué and the rim in that the locking means holds the appliqué to the rim.

The senior party’s position with respect to its claims 44-46 and 48 is persuasive. As noted by the Administrative Patent Judge (APJ) at page 3 of the Decision on Preliminary Motions (Paper No. 23):

In Figure 3, the senior party illustrates a structure wherein a portion of the wheel face outer surface, that portion between recess 42 and the peripheral lip of rim 12, is not covered by the ornamental panel member 20.

Nevertheless, this basis alone is not sufficient to hold that Chase does not support an ornamental panel member covering the entire wheel face outer surface. At column 6, lines 55-58, of CX-1, Chase discloses that wheel 11 includes wheel disk 18 and a peripheral rim portion or rim 12. At column 10, lines 11-13, Chase teaches that the appliqué 20 can cover substantially the entire exposed surface of a wheel, and at lines 22-25 of column 10 Chase teaches the entire outboard surface of the wheel has a chrome-plated finish. These teachings are such that appliqué 20

Interference No. 103,836

would cover the entire exposed surface of disk 18 and rim 12. Based on this description, it is considered that Chase discloses an ornamental panel member covering the entire wheel face outer surface.

#### Chase's Prior Applications

Whereas the count corresponds exactly to Chase claim 47, which claim has been found supported by Chase's involved application, no merit is found in the position of Beam that Chase should be denied benefit of the filing date of its prior applications. With respect to the earlier applications, Chase's involved application is a division of U.S. Application No. 08/412,619, now U.S. Patent No. 5,636,906, which is a continuation of U.S. Application No. 07/904,180 and, as such, the disclosures of the prior applications correspond to the disclosure in Chase's involved application.

#### Beam's Motion Filed August 5, 1999 to Correct Its Preliminary Statement

Changes in the corrected preliminary statement of Beam are that the invention was first conceived and disclosed to another person on March 19, 1992 and that the first drawing and first written description of the invention were made on April 10, 1992. A declaration of William Clemens, an attorney representing Beam in this interference, asserts at paragraphs 9-11 that:

9. On July 14, 1999, while reviewing the prosecution file of the '370 patent to prepare Mr. Beam's Testimonial Declaration dated July 19, 1999, I noticed that the letter dated June 1, 1992 (Exhibit A, Exhibit No. 12) referenced a file "A-308" whereas subsequent documents referenced a file "P-318". During my previous reviews of these documents, I had inadvertently not noted the different file numbers. I immediately contacted Mr. Simonelli at the Bliss McGlynn firm and inquired about the existence of a file labeled "A-308" related to the invention of the '370 patent. I explained that I was seeking any drawing or written description dated before the exhibits submitted with the Preliminary Statement. Mr. Simonelli stated to me that he would search in the stored Thompson files for a file labeled

“A-308” and forward a copy of any relevant document to me. I received the two page document dated April 10, 1992 (copy attached as Exhibit No. 11) from Mr. Simonelli by facsimile transmission on July 15, 1999.

10. I promptly confirmed with Mr. Beam that he remembered disclosing the invention of the ‘370 patent during a meeting with Mr. Shackelford and that the two page document (Exhibit No. 11) was prepared by Mr. Shackelford during that meeting. Mr. Beam also remembered that he conceived his invention during a visit to a business performing a machining operation on Hayes wheels and that Hayes employees including Tom Heck were present.

11. I confirmed with Mr. Heck that he remembered the visit described to me by Mr. Beam and the disclosure of the invention by Mr. Beam during that visit. Although Mr. Heck did not remember the date of the visit, he did remember that Hayes employee Al Coleman was present. I advised Mr. Heck that we had located a document that suggested the visit was before April 10, 1992 and Mr. Heck stated that he would search his records for the date of the visit and would contact Mr. Coleman for any information that he could provide. Mr. Heck reported to me on July 16, 1999 that he and Mr. Coleman reviewed their 1992 appointment books and pinpointed the date of March 19, 1992 as the day of the visit with Mr. Beam during which Mr. Beam disclosed his invention to them.

The motion is denied. Beam’s motion to correct material error in its original preliminary statement was filed after the June 18, 1999 date set by the APJ for service of preliminary statements. Under this circumstance, Beam is required to make a satisfactory showing that such action is essential to the interests or ends of justice, 37 CFR § 1.628(a), third sentence. This rule’s predecessor section, 37 CFR § 1.222, has been interpreted as requiring a showing that errors could not have been avoided by the exercise of reasonable care and that the moving party was not negligent in preparing the original preliminary statement. Fleming v. Bosch, 181 USPQ 761, 765 (Bd. Pat. Int. 1973); Moler v. Purdy, 131 USPQ 276, 277 (Bd. Pat. Int. 1960). The declaration of Clemens is to the effect that he simply failed to inquire about the file labeled “A-308” related to the invention of the ‘370 patent. Clearly, this does not satisfy the aforementioned requirement of a showing that the error could not have been avoided by the exercise of reasonable care and that the moving party was not negligent in preparing the original

preliminary statement. The circumstance described by Clemens, that he inadvertently had not noted the difference in file numbers in the documents which he reviewed indicates on its face that there was a lack of due care in the preparation of the original preliminary statement in that the existence of two distinct files was not recognized even though the fact was evident. The conclusion that Clemens inadvertently failed to note the difference in file numbers does not establish that the party Beam was not negligent in preparing the original preliminary statement.

At page 3 of Beam's reply to Chase's opposition to the motion, Beam asserts that Chase's theory that Beam was spurred to action to file a corrected preliminary motion by receipt of the preliminary statement of Chase is flawed because in related litigation the assignee of the junior party received a copy of Chase's first drawing and first written description as early as February 1998. This is not persuasive argument because the invention in the litigation is presumably different from that involved here, and there is no evidence in this proceeding that the alleged first description and first drawing in the litigation are the same as the first description and first drawing of the corrected preliminary statement.

In view of our opinion, above, the party Beam is limited to the dates alleged in its original preliminary statement.

#### Chase's Case for Priority

If Chase has established prior conception as alleged, Chase will be entitled to prevail on the issue of priority of invention as the first to conceive and the first to reduce to practice. Beam does not allege reduction to practice prior to the June 25, 1992 filing date of Application No. 07/904,180 accorded to Chase.

It is considered that the party Chase has not established conception in February or March 1992 as alleged. The wheel assembly of the drawing dated February 4, 1992, identified as

Interference No. 103,836

CX-12, does not disclose a locking means to hold the appliqué in place. This was admitted by the inventor Chase in Chase's record at pages 2 and 53, and there is no evidence that Chase conceived of the assembly as including a locking means at that time. Still further, there is no evidence that the appliqué of the wheel assembly included an outer annular connecting portion disposed adjacent one of the rim flanges as required by the count. CX-12 shows that the appliqué has outwardly extending fingers but no outer annular portion connecting the fingers.

A second document relied on by Chase is identified in the record as CX-13. It is a letter composed by the inventor dated February 24, 1992 relating to a chrome plated composite/cast aluminum wheel. As noted by the party Beam, the letter simply describes the invention as including a wheel, a cover and an adhesive to attach the cover to the wheel, and refers to the drawing identified as CX-12. There is no testimony related to CX-13 establishing that the wheel referred to therein included locking means, or that the appliqué included an outer annular connecting portion.

A third document (CX-16) relied on by the senior party is a memo dated March 16, 1992 authored by the inventor Chase. The contention is made that item 2 at page A16964 establishes conception by Chase of the subject matter of the count with a locking means. However, a locking means is not specifically disclosed in CX-16 and the inventor's testimony at CR-71 that item 2 relates to bosses or snap tabs or mechanical devices is simply not corroborated.

Regardless of our negative findings above with respect to Chase's case for prior conception, we are of the opinion that the party Chase has established a date of conception of May 26, 1992, the date on the drawing identified in the record as CX-14. The corroborating witness, Kevin Burch, testified that he made the drawing under the supervision of the inventor, Lee Chase, and that it was completed by him on or about May 26, 1992.

It is considered that the drawing clearly illustrates the invention of the count. With respect to the count, the drawing shows a cross-section of a rim with rim flanges (see especially the left-most figure, which is a side view of the apparatus), a spider within the rim formed by the spokes as illustrated in the large central figure comprising a front view of the apparatus, and an ornamental appliqué identified as an overlay overlapping the rim. The appliqué has an annular outer portion adjacent one of the rim flanges in that the outer portions of the spokes of the appliqué which cover the spokes of the wheel are interconnected by an annular outer ring as shown by the front view of the apparatus; the appliqué has an annular inner connecting portion and a plurality of vent openings between the spokes as shown in the front view. A curable adhesive is disposed between said appliqué and said rim and said spider, as shown in the front and SEC A-A views, in that the adhesive is applied on the spider and extends outward toward the rim flanges to the annular outer portion of the rim, and locking means, identified in the central figure at “7.0 DIA. COUNTER BORE FOR ATTACHING OVERLAY (5 PLACES),” holds the appliqué in place.<sup>4</sup>

Other than the charge that Chase has not identified all the elements of the count in CX-14, the only argument made by Beam against the content of the drawing is that there is no indication on the drawing of the demarcation between the spider and the rim. This argument is not persuasive. Even if one were to hold that the rim of the count is limited to the outer annular portion of the wheel structure, the demarcation between the spider and the rim in CX-14 would be essentially where the spokes forming the spider are joined to the outer annular portion of the wheel structure. The side view of CX-14 is essentially the same as Figure 3 of CX-1, which we have held, above, discloses an appliqué 20 overlapping a rim 12.

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<sup>4</sup> The adhesive is curable in that as it ages it hardens for its use to bond the applique to the rim.

Beam can establish no date of conception prior to May 31, 1992. This is because Beam's preliminary statement sets forth that the invention was first conceived on an unknown date during 1992 prior to June 1, 1992. 37 CFR § 1.629(b). Further, Beam's preliminary statement sets forth actual reduction to practice during the first week of January 1993. Whereas Chase has established a date of conception of May 25, 1992 and has a constructive reduction to practice of June 25, 1992, the party Chase is entitled to prevail as the first to conceive the invention and the first to reduce it to practice.<sup>5</sup>

#### Chase's Motions to Suppress

The motions of Chase filed April 27, 2000 to suppress BX-9 and BX-10, and BX-23 through 29 are dismissed as moot because none of the exhibits are relied on by the Board in its decision.

#### Patentability of Beam's Claims

Whereas Chase is entitled to prevail herein as the first to invent, the question of whether Beam's involved claims are unpatentable under 35 U.S.C. § 102/103 over Chases's '906 patent is dismissed as moot.

#### Summary of Major Issues

Beam's motion to amend its preliminary statement is denied.

Beam's position that Chase's involved claims are unpatentable to Chase under 35 U.S.C. § 112, first paragraph, is unpersuasive on the merits.

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<sup>5</sup> Even if Beam were entitled to a date of conception prior to Chase, Beam could not prevail herein as the first to conceive who was reasonably diligent from a time prior to conception by Chase (35 U.S.C. § 102(g)) because Beam's case concerning diligence is general in nature and has little specificity as to dates and facts. Kendall v. Searles, 173 F.2d 986, 992-93, 81 USPQ 363, 368-69 (CCPA 1949). Beam's brief at pages 9 and 10 concerning its diligence is a reflection of this fact.



Interference No. 103,836

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