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Paper 34
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DELBERT ODMAN and **DAVID MAX KENT**
Junior Party
(Application No. 12/283,583),

v.

DAVID MAX KENT
Senior Party
(Application No. 11/371,351).

Patent Interference No. 105,748 (SCM)
(Technology Center 3700)

Before RICHARD SCHAFFER, SALLY GARDNER LANE and
SALLY C. MEDLEY, *Administrative Patent Judges.*

MEDLEY, *Administrative Patent Judge.*

1 **DECISION – MOTIONS – Bd. R. 125**

2 **A. Introduction**

3 The interference is before us to decide Odman Motion 1. Odman
4 moves for judgment on the basis of inventorship. (Paper 25 at 3:1-5).

5 Odman Motion 1 is DENIED.

1 **B. Findings of Fact (“FF”)**

2 1. Odman is involved in the interference on the basis of Application
3 12/283,583 (“583 Application”) filed 12 September 2008.

4 2. Kent is involved in the interference on the basis of Application
5 11/371,351 (“351 Application”) filed 08 March 2006.

6 3. There are 18 Counts in the interference, Count 7 is representative and
7 is as follows:

8 A loader, comprising:

9 (a) a sling;

10 (b) a lowering mechanism in contact with the sling that can
11 lower the sling;

12 (c) a release mechanism that secures at least one side of the
13 sling;

14 (d) a take-up mechanism attached to the sling on the side
15 opposite from the release mechanism; and

16 (e) a set of flippers that are actuatable from a horizontal
17 position to a vertical position.

18 4. According to Delbert Odman, Applied Engineering, Inc. was formed
19 by Delbert Odman, David Kent and Jeff Clark in 2003 to develop packing
20 line products for Packing House Services Inc., owned by Odman and his
21 family. (Ex. 2001, ¶¶ 1-3).

22 5. Delbert Odman’s son Jeff Odman testified that during 2003 and 2004
23 Kent and Delbert Odman spent many hours working to develop a new
24 machine for inserting fruit trays into packing cartons. (Ex. 2002, ¶ 3).

25 6. According to Delbert Odman and Jeff Odman, Kent and Delbert
26 Odman discussed and physically experimented with straps for lowering fruit
27 trays into packing cartons. (Ex. 2001, ¶ 8; Ex. 2002, ¶ 4).

28 7. Delbert Odman also testified that he and Kent worked on the
29 development of a box loader, offered suggestions to one another, solved

1 engineering problems and improved the design over the course of several
2 months as the invention evolved. (Ex. 2001, ¶¶ 9-11).

3 8. According to Delbert Odman, Applied Engineering ceased doing
4 business in 2004 or 2005, and Kent became associated with Seatac
5 Automation Systems LLC while Odman continued his involvement with
6 Packing House Services, Inc. (Ex. 2001, ¶¶ 17-18).

7 9. Kent filed the '351 Application on 08 March 2006, the rights of which
8 are assigned to Seatac Automation Systems LLC.

9 10. The '351 Application lists Kent as the sole inventor.

10 11. Odman filed the '583 Application on 12 September 2008, with an oath
11 listing Odman and Kent as joint inventors, bearing only Odman's signature.

12

13 12. Odman's '583 specification and claims are identical to Kent's '351
14 specification and claims. (Paper 25 at 11:26).

15 **C. Analysis**

16 This interference involves an inventorship dispute between Odman
17 and Kent. Delbert Odman believes that he is a joint inventor of the claimed
18 subject matter, while David Kent believes that he is the sole inventor of the
19 claimed subject matter. Kent filed first, followed by Odman who filed an
20 identical specification and claims, listing Kent as a co-inventor. This
21 interference was declared to resolve the inventorship dispute. *See Chou v.*
22 *University of Chicago*, 254 F.3d 1347, 1358 n.2 (Fed. Cir. 2001) (a means
23 for a putative inventor to assert inventorship rights is to file a patent
24 application and seek to have the PTO declare an interference in order to
25 establish inventorship).

26 Odman substantive Motion 1 is for judgment under 35 U.S.C. 102(f)

1 against Kent on the basis that the Kent ‘351 Application names the incorrect
2 inventors. (Paper 25 at 3:1-5, 9-10). As the moving party, Odman bears the
3 burden of establishing that it is entitled to the requested relief. Bd. R.
4 41.121(b).

5 The issue of joint inventorship is governed by 35 U.S.C. 116, which
6 provides that:

7 [w]hen an invention is made by two or more persons jointly,
8 they shall apply for patent jointly and each make the required
9 oath, except as otherwise provided in this title. Inventors may
10 apply for a patent jointly even though (1) they did not
11 physically work together or at the same time, (2) each did not
12 make the same type or amount of contribution, or (3) each did
13 not make a contribution to the subject matter of every claim of
14 the patent.

15 Conception is the touchstone of inventorship and each joint inventor
16 must contribute to the conception of the claimed invention. *Ethicon, Inc. v.*
17 *U.S. Surgical Corp.*, 135 F.3d 1456, 1460 (Fed. Cir 1998). Conception
18 exists when there is a definite and permanent idea of an operative invention,
19 including every feature defined by the count. *Sewall v. Walters*, 21 F.3d
20 411, 415 (Fed. Cir. 1994). “[A] joint inventor must contribute in some
21 significant manner to the conception of the invention.” *Fina Oil and Chem.*
22 *Co. v. Ewen*, 123 F.3d 1466, 1473 (Fed. Cir. 1997). As such, “each inventor
23 must contribute to the joint arrival at a definite and permanent idea of the
24 invention as it will be used in practice.” *Burroughs Wellcome Co. v. Barr*
25 *Labs, Inc.*, 40 F.3d 1223, 1229 (Fed Cir. 1994). There must be
26 corroborating evidence for any asserted contribution to the conception of the
27 invention. *Fina*, 123 F.3d at 1474 (Fed. Cir. 1997).

28 This interference was declared with 18 counts. For Odman to prevail,

1 Odman must demonstrate that Odman contributed in some significant
2 manner to the conception of at least one count. The burden of proof is a
3 preponderance of the evidence.

4 Odman's motion is brief. The motion consists of a repeat of the listed
5 facts (Paper 25 at 4:9-at 5:11 compared with 9-12) and Odman's analysis
6 that consists of a single paragraph (Paper 25 at 6:14-7:5). In its analysis
7 paragraph, Odman does not articulate nor direct us to evidence of Delbert
8 Odman's specific contribution to a conception of the invention defined by
9 any of Counts 1-18. Instead, Odman's evidence indicates that there were
10 general discussions between Odman and Kent regarding possible methods
11 for lowering trays into packing cartons and physical experiments with plastic
12 load straps. (Ex. 2001, ¶ 8; Ex. 2002, ¶ 4). For example, Delbert Odman
13 testified that:

14 [i]n the course of a discussion regarding possible methods for
15 lowering cardboard fruit trays into packing cartons, Kent and I
16 picked up plastic load straps and held the straps between us,
17 using the straps to lower the trays. We experimented with ways
18 to raise and lower the strap, as well as how to hold the strap in
19 place and how to get it out of the way when the tray is ready to
20 be released.

21 (Ex. 2001, ¶ 8). While the above may indicate that Kent and Odman
22 performed different "possible methods" for lowering fruit trays into packing
23 cartons using plastic straps, we do not know how such acts demonstrate a
24 conception of any one of the counts. All of the counts include an apparatus,
25 e.g., a loader with various mechanical parts. For example, Count 7 recites a
26 loader that includes a sling, a lowering mechanism in contact with the sling,
27 a release mechanism that secures one side of the sling, a take-up mechanism
28 attached to the sling on the side opposite the release mechanism and a set of

1 flippers. When read in light of the Kent specification¹, it is apparent that the
2 loader is a machine with various parts corresponding to the claimed elements
3 and not two individual humans lowering trays into a box. Odman's
4 argument and evidence do not address the elements of the loader apparatus
5 defined by any of the counts; i.e., the loader machine with a sling, lowering
6 mechanism, release mechanism, take-up mechanism and set of flippers. The
7 only element that is arguably the same as an element in any of the counts is
8 the sling, i.e., formed by the plastic straps that Odman and Kent allegedly
9 held in their hands and used to lower trays into boxes. Even assuming that
10 the straps identified in Odman's evidence (Ex. 2001, ¶ 8; Ex. 2002 ¶¶ 4-5)
11 are the same as a sling, Odman admits that it was Kent that initially
12 proposed using the straps to lower the trays; not Delbert Odman. (Paper 25
13 at 6:17-18; Ex. 2002, ¶ 5).

14 Odman additionally argues that Odman contributed to the process of
15 designing the patentable box loader, making vague references to "extensive
16 experimentation and collaboration". (Paper 25 at 6:16-17; 7:4-5). These
17 arguments are not specific in any way. We do not know to which
18 experimentation or collaboration Odman is referring. Odman's evidence to
19 which we are directed is also not specific. That evidence generally describes
20 that Kent and Odman (i) worked on the project, (ii) communicated with one
21 another and offered suggestions to one another, (iii) developed a machine,
22 (iv) solved engineering problems, and (v) improved the design (Ex. 2001, ¶¶
23 9-11; Ex. 2002, ¶ 3). The evidence merely shows that Odman may have
24 generally contributed work, suggestions, solutions, and design
25 improvements that may or may not have ended up in the invention defined

¹ The Odman specification is identical.

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1 by any of Counts 1-18. Odman's arguments and evidence are not specific
2 with respect to the elements of any of the counts and therefore does not
3 provide sufficient information to enable us to ascertain whether Odman's
4 work, suggestions, solutions or design improvements found their way into,
5 or were a significant contribution to, the invention defined by any one of
6 Counts 1-18.

7 For all these reasons, Odman has not sufficiently demonstrated joint
8 inventorship by showing that Odman contributed in a significant manner to
9 the conception of the invention defined by at least one of the counts. Since
10 Odman failed to sufficiently demonstrate that it is entitled to the relief
11 sought, we need not and have not considered Kent's Opposition or Odman's
12 Reply.

13 **D. Order**

14 It is

15 ORDERED that Odman Motion 1 is DENIED.

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