

**THE OPINION ENTERED TODAY IS NOT
BINDING PRECEDENT OF THE BOARD**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MINGCHIH M. TSENG

Junior Party
(Application 08/461,318)¹,

v.

SIAMAK DOROODIAN-SHOJA

Senior Party
(Patent No. 5,388,331).²

Patent Interference No. 104,482

Before SCHAFFER, LEE and TORCZON, Administrative Patent Judges.
LEE, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

Introduction

Senior party patentee Doroodian-Shoja filed (1) preliminary

¹ Filed on June 20, 1995. Accorded the benefit of application 08/269,495, filed July 1, 1994. The real party in interest is The Gillette Company.

² Based on application 08/188,244, filed January 28, 1994. The real party in interest is Arthur D. Little Enterprises, Inc.

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motion 1 alleging no interference-in-fact; and (2) preliminary motion 2 for judgment under 35 U.S.C. § 135(b). Junior party applicant Tseng filed (1) preliminary motion 1 to add more claims to its involved application; (2) preliminary motion 2 for judgment against Doroodian's patent claims 1-6 under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure; (3) preliminary motion 3 for judgment against Doroodian's patent claims 1-6 for indefiniteness under 35 U.S.C. § 112, second paragraph; (4) preliminary motion 4 for judgment against Doroodian's patent claims 1-6 under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification; and (5) preliminary motion 5 for judgment against claims 1-6 of Doroodian's patent claims 1-6 as being unpatentable over prior art.

Findings of Fact

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

1. This interference was declared on January 12, 2000.
2. Junior party Tseng is involved on the basis of U.S. application 08/461,318, filed June 20, 1995.
3. Senior party Doroodian is involved on the basis of U.S. Patent No. 5,388,331, filed January 28, 1994.

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4. At the time of declaration of this interference, junior party Tseng was accorded the benefit of application 08/269,495, filed July 1, 1994.

5. The involved application claims of junior party Tseng are claims 113, 117-123 and 130-136, which all correspond to the count in this interference.

6. The involved patent claims of senior party Doroodian are claims 1-6, which also all correspond to the count of this interference.

7. Of Tseng's involved applications claims, claims 113, 117, 118, 134 and 135 are each independent claims and the rest are dependent claims.

8. Of Doroodian's involved patent claims, only claim 1 is an independent claim.

9. The count in this interference is set forth in Paper No. 1 as:

Claim 1 of Doroodian or Claim 135 of Tseng.

10. Claim 1 of Doroodian reads as follows:

1. In a disposable razor or razor cartridge comprising at least one blade mounted in a head or frame, said blade having a shaving edge, the improvement comprising wear indicating means for indicating the amount of wear on the shaving edge, said wear indicating means being located on the head or frame in close proximity to the shaving edge of said blade, and said wear indicating means comprising a strip of material extending generally parallel to the

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shaving edge, said strip of material gradually wearing away as the disposable razor or razor cartridge is used in shaving, the amount of material wearing away being correlated with the amount of wear on the shaving edge to provide a visual indication of the relative wear on the blade.

11. The first paragraph of the BACKGROUND OF THE INVENTION section of the specification of senior party Doroodian's involved patent states:

This invention relates to disposable razors, and particularly to a visual means for readily indicating to the user the relative amount of wear that the blade of a given disposable razor has undergone.

12. The fourth paragraph of the BACKGROUND OF THE INVENTION section of the specification of senior party Doroodian's involved patent states:

It is believed that the typical user of a disposable razor would benefit from the inclusion of some reliable, and easily recognizable, visual indicator of the relative amount of wear that a particular disposable razor blade has undergone. With such a visual indication, it would not be necessary to determine the wear on the razor by the amount of pain or discomfort felt when the blade was used.

13. Doroodian's specification describes multiple embodiments of how a visual indication may be provided on a razor cartridge which reveals the relative wear on the shaving blade over a plurality of shaving sessions, including the embodiments illustrated in Figures 3a through 3j and 4a through 6b.

14. Doroodian's specification does not fully disclose how

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the embodiments shown in its Figures 2 and 7 work or operate.

15. All of the embodiments in Doroodian's specification for which there is an adequate disclosure of how they operate provide a "multiple points-in-time" indicator strip that gives a visual indication of the relative wear on the shaving blade beyond simply that the shaving cartridge or the indicator strip has reached its intended useful life.

16. Junior party Tseng's application claim 135 reads:

A razor cartridge comprising a blade and an [sic] immovable skin engaging member affixed adjacent said blade, said skin engaging member located such that it contacts the skin of a user during shaving, said skin engaging member comprising two adjoining disparately colored, solid polymeric layers, said layers comprising an erodable skin engaging layer of a first color overlaying a non-skin engaging layer of a different color, wherein said skin engaging layer is adapted to erode during contact with said skin during shaving to visually expose said non-skin engaging layer over time.

17. The Field of the Invention section of junior party Tseng's specification, as filed on June 20, 1995 (Tseng Exhibit 2008), reads in its entirety as follows:

This invention relates to an improved skin engaging member for use in razor blade cartridge assemblies and shaving systems of the wet shave type. The present invention resides broadly in providing the skin engaging cap and/or guard surfaces with configurations which reduce frictional drag of the razor across the skin. This invention also relates to a novel method of manufacturing the skin engaging member of the present invention.

18. The SUMMARY OF THE INVENTION portion of Tseng's

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specification, as filed on June 20, 1995 (Tseng Exhibit 2008),
lists three objectives for Tseng's invention:

An object of the present invention is to provide a skin engaging member with improved mechanical strength.

Another object of the present invention is to provide a skin engaging member with improved shaving aid material release characteristics.

Yet another object of the present invention is to provide a wear indicating skin engaging member.

19. On page 6 of Tseng's specification as filed on June 20, 1995 (Tseng Exhibit 2008), it is stated:

In an embodiment of the present invention a wear indicating effect is produced when the sheath material and the core material are made of disparately colored materials (e.g. white colored sheath and blue colored core). **Upon use, the sheath material over the skin engaging surface is typically worn off through use. With sufficient use, a second colored region represented by the core is exposed, thus, providing the user with [an] indication that the shaving unit and/or skin engaging surface have reached their effective life.** In a preferred embodiment, the sheath material consists of polyethylene oxide/polystyrene mixture which is white in color and the core consists of nylon and/or styrene which has been colored with a FD&C #2 dye. Other suitable dyes or pigments include FD&C Red No. 40, Erythrosine (FD&C Red No. 3), Brilliant Blue FCF (FD&C Blue No. 1), Indigotine (FD&C Blue No. 2), Tartozine (FD&C Yellow No. 5), Sunset Yellow FCF (FD&C Yellow No. 6) and Fast Green FCF (FD&C Green No. 3) and Titanium Dioxide. (Emphasis added).

20. With respect to the language on page 6 of Tseng's specification stating that "a second colored region represented by the core is exposed," the phrase makes no distinction between

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partial exposure and complete exposure of the core. Tseng's specification contains no reference to or explanation of any meaningful distinction between partial and complete exposure of the core. The core is exposed when any portion of it is exposed.

21. Tseng's specification makes no mention of the duration of or any significance, value, or benefit, of the time period, assuming that there is any such time period, between partial exposure and full exposure of the differently colored core. Tseng's specification does not describe or disclose that a meaningful such period exists or that it has a duration longer than a single shaving session.

22. Tseng's specification does not describe or disclose a "multiple points-in-time" indicator strip which provides a visual indication of the relative wear on the shaving blade from one shaving session to the next. The visual indication provided by exposure of the core reveals only that the shaving unit and/or the skin engaging layer has reached its intended useful life.

Discussion

A. Doroodian's preliminary motion 1 asserting that there is no interference-in-fact

Patentable distinctness between the parties' claims, in either direction, is sufficient to demonstrate no interference-in-fact. As the moving party, Doroodian has the burden of proof

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to demonstrate either (1) that none of its claims corresponding to the count would have been anticipated by or rendered obvious over any of Tseng's involved claims, or (2) that none of Tseng's claims corresponding to the count would have been anticipated by or rendered obvious over any of Doroodian's involved claims. Doroodian's preliminary motion 1 chooses to show the former, not the latter. In the Summary Of Argument portion of its preliminary motion 1, Doroodian states:

The Doroodian claims [1-6] require a wear indicating means (a strip of material) having two requirements that are not taught by the involved Tseng claims or suggested by the subject matter of the involved Tseng application and claims: (1) gradually wearing away during use, due to abrasion with the skin of the user, where the amount of material wearing away is correlated with the amount of wear on the shaving edge of the blade; and (2) as the material wears away, the user is provided with a visual indication of the relative wear on the blade. These patentable features recited by the involved Doroodian '331 patent Claims 1-6 are neither claimed by the Tseng claims nor disclosed nor rendered obvious by the subject matter of the Tseng application.

To connect the argument to its claims, Doroodian at page 17 of its preliminary motion 1, in lines 5-12, states:

The "wear indicating means" limitation found in independent Claim 1 and dependent Claims 2-6 of the Doroodian '331 patent, can be subdivided into at least two (2) separate elements:

- (1) a material which is primarily worn away gradually via abrasion and friction where the amount of material gradually abrading or wearing away is correlated with the wear on the shaving edge; and

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- (2) the amount of material gradually abrading or wearing away provides a visual indication of the relative wear on the blade to the user. (Emphasis in original).

Doroodian argues that the two claim elements identified above³ neither expressly nor inherently form a part of the subject matter of the involved Tseng claims and thus the subject matter of the involved Tseng claims does not anticipate the subject matter of the involved Doroodian '331 claims. According to Doroodian, these two claim elements also render Doroodian's claims 1-6 nonobvious over any one of Tseng's involved claim.

We are only partially persuaded by Doroodian's argument. In our view, only the second of the two elements identified above is not taught by the involved claims of Tseng. That difference alone, however, is sufficient to support the conclusion that none of Doroodian's involved claims is anticipated by or would have been rendered obvious over any of Tseng's involved claims.

We first discuss why Doroodian's assertion is incorrect that none of Tseng's involved claims satisfies the first of the two above-identified claim elements, i.e., that the material is worn

³ Tseng correctly notes that the word "primarily" nowhere appears in any of Doroodian's claims 1-6 in connection with the material of the wear indicating means being worn away by abrasion or friction. However, the mischaracterization is without harm because if a material is representable as being worn away by abrasion or friction it reasonably would or should be "primarily" worn away by abrasion or friction.

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away gradually by abrasion and friction and the amount of material gradually abrading or wearing away is correlated with the wear on the shaving edge. Thereafter, we will discuss why Doroodian's assertion is correct that none of Tseng's involved claims satisfies the second of the two above-identified claim elements about providing a visual indication on the relative wear of the blade.

Our interference-in-fact discussion will not include Tseng's independent claim 134, because as we will explain later that claim is unpatentable under 35 U.S.C. § 112, first paragraph. In the analysis of Doroodian's assertion of no interference-in-fact, we need not discuss any claim of Tseng which is unpatentable.

We reject Doroodian's argument that because party Tseng had previously argued to the examiner prior to declaration of this interference that its claimed invention is patentably distinct from the claims in Doroodian's involved patent, Tseng cannot now credibly argue otherwise. Tseng's argument to the primary examiner was unsuccessful and was also directed to claims different from those now involved in the interference. Tseng is not restricted to a position it had previously unsuccessfully taken before a primary examiner, even if the argument is directed to the same claims. Tseng has obtained no apparent benefit from its previous argument, which would render unfair the taking of a

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different position now.

Each of Tseng's independent claims 113, 117, 118 and 135 recites a skin engaging member which includes an erodible skin engaging layer of a first color overlaying a non-skin engaging layer of a different color. Each of claims 113, 117, 118 and 135 further recites that the skin engaging layer erodes or is adapted to erode during contact with skin during shaving to visually expose the non-skin engaging layer.

We find that according to Tseng's disclosure all described erosion of the skin engaging layer "during contact" with the shaver's skin and "during shaving" are gradual and are through abrasion and friction. We further find that Tseng's disclosure does not contemplate, recognize, or refer to any erosion through ordinary use of the shaving cartridge during contact with skin and during shaving that is not gradual or that is not due to abrasion or friction. For instance, the shaving aid constituting Tseng's skin engaging layer is for providing shaving assistance through "multiple" shaves and the Tseng specification does not allude to any possible use for a sudden release of all shaving aid in one stroke of the razor or a single shaving session. In light of these findings concerning Tseng's specification, we find that the erosion claimed by Tseng is implicitly gradual.

Notwithstanding that Tseng's disclosed skin engaging layer

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comprises between 70% to 100% of a water soluble shaving aid, the erosion "during contact" with skin and "during shaving," as described in Tseng's disclosure is via abrasion and friction with skin. Even though Tseng's disclosed skin engaging layer is mostly, if not entirely, water soluble and is designed to dissolve or leech away during use, it is not worn away from the razor cartridge until the razor cartridge is applied in physical contact with the skin of the shaver and stroked over the area being shaved. Water solubility of the shaving aid facilitates the material's being worn off the skin engaging layer during contact with skin, and does not change the fact that abrasion and friction are responsible for wearing the material off the skin engaging layer. Merely dissolving material in water is not ordinarily considered wear on the material. Even dissolved portions of the material need to be removed, and that is done by abrasion and friction with skin during shaving. Tseng's disclosure neither refers to nor acknowledges the existence of any way to cause erosion of shaving aid material during skin contact and during shaving that would not be due to abrasion and friction with skin. Furthermore, if the material eroded away without having contacted the skin, it would not constitute a shaving aid - Tseng's disclosed intended use for the material.

In light of our findings concerning Tseng's disclosure, we

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conclude that the gradual wearing down of Tseng's skin engaging layer during contact with skin and during shaving, as is specified in Tseng's claims 113, 117, 118 and 135, is indeed by abrasion and friction.

As for whether the material gradually abrading or wearing away is correlated to the wear on the shaving edge, we find that that is an inescapable and necessary result which always follows from practicing the invention described in Tseng's disclosure. Tseng's specification recognizes that the shaving blade wears down and has only a limited life. See Tseng specification at page 5, lines 21-22. We find that during the ordinary and intended use of Tseng's disclosed invention, the wearing down of the skin engaging layer or shaving aid "during contact" with skin and "during shaving" is always associated with shaving action on the shaving blade.

While it is true that a cartridge may be placed in a pot of warm water and in sufficient time the soluble portions of the skin engaging layer can dissolve entirely without the shaving blade ever being used or worn. But based on Tseng's specification, such an event falls clearly outside of the intended and ordinary use of the disclosed razor cartridge. We find that for Tseng's disclosed invention, any time the razor cartridge is used in actual shaving, erosion of the skin engaging

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layer during skin contact and during shaving accompanies some wear on the shaving blade, without exception. Note that Tseng's claims 113, 117, 118 and 135 refers to erosion of the skin engaging layer "during contact" with skin and "during shaving." See also lines 12-15 of column 3 of Doroodian's specification, which states: "The strip should be so located that it is virtually constantly in contact with the skin and hair or beard during the shaving stroke."

Doroodian's claims require "correlation" to blade wear only generally. No particular relationship is specified in the claims. Also, no special meaning is defined in Doroodian's specification for the term "correlate," which according to Merriam Webster's Collegiate Dictionary, Tenth Edition, 1999, has the following general meaning as a verb:

2: to bear reciprocal or mutual relations: correspond-
vt 1 a: to establish a mutual or reciprocal relation
between <- activity in the lab and in the field> b: to
show correlation or a causal relationship between 2: to
present or set forth so as to show relationship

The only paragraph in the portion of Doroodian's specification entitled "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT" which uses the word "correlate" is this (column 5, lines 22-30):

An advantage of the subject invention is that the amount of wear undergone by strip itself is related to the "toughness" of the skin and hair being shaved

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i.e., as stated above, "tough" hair will cause the indicator strip to wear away more rapidly than "soft" hair. Thus the amount of wear on the strip **correlates well** with the amount of wear on the blade. (Emphasis added.)

What the above-quoted passage from Doroodian's specification indicates is that two elements are well correlated if simply that more of one means more of the other. This broad meaning of the term "correlate" is not disputed by Doroodian's counsel during oral argument on May 23, 2001, who responded to questions from the panel on what "correlate" means by stating that no particular relationship is necessary and that so long as both elements move in the same direction there is correlation.

In light of the recitation in Tseng's claims 113, 117, 118 and 135 that the skin engaging layer erodes during contact with skin and during shaving, we find that it is inherent that during ordinary and intended use of Tseng's claimed razor cartridge more erosion on the skin engaging layer means more wear of the shaving edge or blade. As skin contact erodes the skin engaging layer, the cutting action of the blade on hair wears down the shaving blade. Our finding of inherency is supported by the following cross-examination testimony of Doroodian's technical witness Anthony R. Booth (Tseng Exhibit 2089, page 527):

Q. Is the amount of material that leaches and erodes away from the outer layer 72 [Tseng's cartridge] correlated with wear on the edges of the blade 60 and

62?

[Doroodian's counsel]: Objection.

A. When used in a normal shaving manner I would expect that to be true.

* * *

Q. [exchange between counsel] Does the outer layer 72 wear away each time the cartridge is used in shaving?

[Doroodian's counsel]: Objection.

A. When the cartridge is used in a normal manner I would assume that to be true, yes.

Q. You don't have any doubt about that, do you?

A. Not if it was used in a normal manner, no.

* * *

Q. Does the amount of blade wear on the edges of blade 60 and 62 of the cartridge shown in Figure 3 [Tseng's application] increase in the aggregate as the cartridge is repeatedly used?

[Doroodian's counsel]: May I have the question back, please?

[Record read.]

[Doroodian's counsel]: Objection.

A. My understanding is that the blades would wear each time they are shaved.

We conclude that the feature that the amount of material gradually abrading or wearing away is correlated with the wear on the shaving edge is inherently a part of Tseng's claims 113, 117,

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118 and 135.

The question now remaining is this: In the invention of Tseng's independent claims 113, 117, 118, 135, and claims dependent thereon, does the amount of material worn from the skin engaging layer provide a visual indication of the wear on the shaving edge or blade? In that regard, Doroodian's independent claim 1 recites: "wear indicating means **for indicating the amount of wear on the shaving edge**" and "the amount of material wearing away being correlated with the amount of wear on the shaving edge **to provide a visual indication of the relative wear on the blade**" (Emphasis added). Doroodian's claim 1 recites a means-plus-function clause under 35 U.S.C. § 112, sixth paragraph, i.e., "wear indicating means for indicating the amount of wear on the shaving edge."

According to Doroodian, its claimed wear indicating means requires a "multiple points-in-time" indicator "where the amount of strip material wearing away is correlated with the amount of wear on the shaving edge to provide a visual indication of the relative wear on the blade beginning when the cartridge is first used, and continuing with each shave until the user decides, based upon prior experience, the indicator strip (and hence the cartridge) has worn to a level that will result in shaving discomfort if used further." Doroodian distinguishes such a

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"multiple points-in-time" indicator from a "single point-in-time" indicator which gives only a single indication that a skin engaging layer including a shaving aid is essentially all eroded away from usage. Doroodian asserts that Tseng's involved claims require a "single point-in-time" indicator while Doroodian's claims require a "multiple points-in-time" indicator.

Doroodian's argument is persuasive, except that we regard the period in which a visual indication must be provided to be from the time when the razor unit is new to a time when the blade has reached its intended useful life for shaving. Doroodian's reference to "shaving discomfort" and an actual user's prior experience is too subjective to be meaningful. We further clarify that the term "multiple points-in-time" as used herein means a substantially continuous spectrum on a shaving session by shaving session basis whereby each shaving session brings about an erosion and an observable change in the visual indication. For reasons discussed below, we regard Doroodian's claims as requiring a "multiple points-in-time" indicator and Tseng's claims as requiring a "single point-in-time indicator."

As noted above, Doroodian's claims 1 recites a means-plus-function clause the stated function of which is "for indicating the amount of wear on the shaving edge." The context of claim 1 in its entirety, as written, is not any particular fixed moment

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in time. Rather, it is expressly recited that the wear indicating means has a strip of material **"gradually wearing away as the disposable razor or razor cartridge is used in shaving."**

In such an actively or continuously changing environment, the reference to "for indicating the amount of wear on the shaving edge" does not reasonably mean an indication at a particular moment in time. Rather, it means at whatever time, i.e., the time of observation of the visual indication. The last phrase in claim 1 supports our view, in reciting: "the amount of material wearing away being **correlated with the amount of wear on the shaving edge to provide a visual indication of the relative wear on the blade.**" The phrase ties the amount of material "wearing away" to "relative wear" on the shaving blade, and that reflects appreciation for an actively or continuously changing environment and a visual indication on a progressive basis.

In an amendment filed June 22, 1994 (Paper 4a in the file of Doroodian's involved patent)⁴, wherein the language "for indicating the amount of wear on the blade edge" was added to the means plus function clause, Doroodian specifically distinguished its claimed invention from the prior art by arguing with respect to the prior art that there is "no suggestion that the strip is

⁴ We herein designate that paper as a part of the official record we have considered for purposes of this decision.

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worn away in such a way as to provide a visual indication of **progressive** blade wear" (Emphasis in original). Thus, by its own representation to the U.S. Patent and Trademark Office during examination of its involved patent, Doroodian has clarified and limited the visual indication provided by its wear indicating means to the "progressive" variety. Visual indication of progressive blade wear unmistakably corresponds to Doroodian's assertion of a "multiple points-in-time" and not a "single point-in-time" indicator.

Doroodian's specification supports our view, insofar as disclosed embodiments and 35 U.S.C. § 112, sixth paragraph, are concerned. Per 35 U.S.C. § 112, sixth paragraph, the claimed wear indicating means covers only corresponding embodiments disclosed in the specification and equivalents thereof. All of Doroodian's disclosed embodiments which have been described in sufficient detail are of the progressive or "multiple points-in-time" type. See, for instance, the embodiments illustrated in Figures 3a-3j, 4a-4b, 5a-5b, and 6a-6b.

Tseng argues that Doroodian's specification discloses other preferred embodiments which are of the "single point-in-time" indicator type, for instance, Doroodian's Figures 2 and 7. But those embodiments have not been described in sufficient detail for one with ordinary skill in the art to know how they operate

to provide the visual indication. To say that they illustrate a "single point-in-time" indicator strip more reflects wishful thinking on the part of Tseng than it does corresponding description in the specification. In our view, the embodiments of Doroodian's Figures 2 and 7 are not sufficiently described to constitute a corresponding embodiment for the wear indicating means of Doroodian's claim 1, within the context of 35 U.S.C. § 112, sixth paragraph. The claimed means-plus-function clause cannot be defined on the basis of embodiments whose operation are not sufficiently described to be reasonably understood.

Doroodian's Figure 2 possibly illustrates the shaving head after a top layer of wear indicating means has been eroded away completely to reveal the indicia "DISPOSE" on the shaving head. It also possibly illustrates the indicia on the lower layer of a two-layer wear indicating means after the top layer has been eroded away completely. Which is it? A structure according to either possibility is similar to another embodiment in Doroodian's disclosure (see column 3, lines 24-31) wherein the wear indicating means is in a single color that contrasts with the color of the razor head, whereby the color of the razor head is revealed after the wear indicating layer has been eroded away.

Doroodian's Figure 7 illustrates an embodiment with a two-layer wear indicating means in which both layers have the same

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longitudinal cross-section (see column 3, lines 42-43) but contrasting colors. In column 3, lines 42-47, the Doroodian specification states:

The two layers may have the same longitudinal cross-sections (**as, for example, in FIG. 7**) or may have different longitudinal cross-sections to create different visual patterns for example as shown in FIG. 3a, where the upper layer tapers from a thin edge at one end of the strip to a wide edge at the other. (Emphasis added).

Doroodian's argument that Figure 7 in Doroodian's specification does not illustrate an embodiment of the wear indicator means claimed in the patent is rejected. Whatever else may be illustrated via Figure 7, the Figure unquestionably reveals an embodiment wherein the two layers of the wear indicator means have the same longitudinal cross section. While Dr. Booth testified that he does not view Figure 7 as an embodiment, we have not been directed to any testimony of Dr. Booth in which he accounted for the above-quoted language in Doroodian's specification.

The embodiments noted in the two immediately preceding paragraphs, including the Figure 2 and Figure 7 embodiments, share a common deficiency in completeness. For these embodiments, the Doroodian specification does not describe what the visual indication looks like before the upper layer of the two-layer indicating means is completely worn away or before the

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single layer of contrasting color with the shaving head is completely worn away. What we have is simply a snap-shot in time when what we need for a full understanding is a more complete description of the changes, if any, in visual appearance leading up to the time of complete erosion of the upper layer, as the blade is being progressively worn. It is at least plausible that more and more of the contrasting color or other indicia below will become visible as a user goes through each shaving session even though no portion of the lower layer or the shaving head is physically exposed or uncovered. Whether that is the case is uncertain. Note further that Dr. Anthony R. Booth testified that the Figure 2 embodiment is only partially disclosed in Doroodian's specification. (Booth Tr, 354). It is simply uncertain how these embodiments work.

Doroodian's specification is far from being a model of clarity. Many parts of it are outright confusing. In column 3, lines 6-8, a "wear indicating strip" is defined; but in line 16, it apparently became a "wear indicating means." No explanation is provided for this transformation and it should be noted that under 35 U.S.C. § 112, sixth paragraph, the legal residence of a means-plus-function clause is only in a claim.

In the brief description of the drawings, Figure 7 is described as follows: "Figure 7 comprises a diagram illustrating

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the formula for determining the coefficient of wear for a given set of shaving parameters." With regard to Figure 7, the specification in column 4, lines 48-52 states that " X is the change in thickness X resulting from stroking the razor blade over the skin for a distance L" and that "L is the distance that the blade is stroked along the skin in a given [single] shaving session." But Figure 7 also evidently shows X to be the entire thickness of the skin engaging layer A which should last multiple shaving sessions, for instance an average of four sessions according to column 5, lines 8-9. Clearly, X cannot be both.

In column 3, lines 31-37, the Doroodian specification states:

In a preferred embodiment, two layers of material are used to comprise the wear indicating means, so that, as the uppermost layer is worn away, the color of the next layer becomes visible. As a further alternative, a word such as "DISPOSE", or other words or indicia (such as diagonal stripes or a row of stars), could be made to appear as the upper layer is worn away.

But the disclosure immediately preceding the above-quoted text does not define a general invention which encompasses the above-described preferred embodiment. Specifically, in column 3, lines 24-30, the specification states:

By making the wear indicating means in a color that contrasts with the color of the razor head 14, the relative wear on the strip will be evident because the strip will be worn away, and the head will become

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visible. For example, a white strip on a blue razor head will gradually be worn away to reveal the blue color underneath.

The above-quoted text does not set forth an invention for which two layers having contrasting colors would constitute an embodiment of the wear indicating means. At most, it is an alternative embodiment which has not been referred to as "preferred." Furthermore, assuming that it is an alternative embodiment, it is just as incomplete as are the Figure 2 and Figure 7 embodiments discussed above. It is uncertain just what the visual indication reveals before the wear indicating means is completely worn, beginning when the razor unit is new and unused.

In column 3, lines 38-41, Doroodian's specification states:

In this preferred two layer embodiment, two basic methods of construction are contemplated. In the first method, the two layers are constructed from either the same or different material, but are of contrasting colors. . . . [Emphasis added.]

No second method is thereafter described, however, even as the specification commences, beginning in column 3, line 59, to set forth an alternative embodiment to the two layer preferred embodiment.

In column 3, lines 59-64, Doroodian's specification states:

In another alternative embodiment, the indicator means may consist of a single strip of material, but colored or dyed by known methods, so as to creat[e] distinguishable zones. As the upper portion or zone of the strip (of one color) is abraded away, the

contrastingly colored lower zone becomes visible.

The above-quoted description suggests that the two layers included in the earlier described embodiment do not constitute a single strip of material. But the two-layered preferred embodiment described earlier in the specification does appear to be an implementation of the wear indicating strip first defined in column 3, lines 6-8. Moreover, as for just how the contrastingly colored lower layer or zone becomes visible **as** the upper layer or zone is abraded away, without abrasion of the lower layer or zone mixed in with the upper layer or zone, Doroodian's specification does not say.

In this sea of confusion one particular point stands out with remarkable clarity - that there is not a single instance in Doroodian's specification where it discusses or appreciates the benefit of knowing that the shaving blade is completely worn, separate and apart from the benefit of knowing on a continuous basis how much the blade has worn through each shaving session. On the basis of Doroodian's specification, we cannot find that there is any "single point-in-time" embodiment, not even with respect to Doroodian's Figures 2 and 7 which, as we discussed above, lack detailed explanations as to how they work. We are not free to add embodiments to Doroodian's disclosure. Nor are we free to add material to render complete an otherwise

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incompletely disclosed embodiment.

Note further that Doroodian's specification refers to the embodiments of Figure 7, Figures 3a through 3j, and Figures 4 through 6, all in the same vein. See column 3, lines 42-57. There is not the slightest inkling that a major difference may exist between these embodiments, e.g., that Figure 7's embodiment would only give a visual indication at a single point in time, when the blade is completely worn.

With regard to a two layered embodiment, evidently including that of Figure 7 because this preferred embodiment can have either the same or different cross-section, Doroodian's specification states (column 3, lines 32-34):

"[a]s the uppermost layer is worn away, the color of the next layer becomes visible. (Emphasis added.)

Further with regard to this preferred two layered embodiment, which can have either the same or different cross-section, Doroodian's specification states (column 3, lines 47-51):

As the two layers wear away through abrasion and/or shear stress against the skin and hair, more and more of the contrasting colored lower layer is disclosed [reference to the illustrations of Figure 3].

For all of the foregoing reasons, we do not find that Doroodian's specification discloses any "single point-in-time" embodiment which gives only an on/off visual indication as to whether the shaving blade is completely worn. Furthermore, even

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if it does, Doroodian through its own representation to the U.S. Patent and Trademark Office during prosecution of the application maturing into its involved patent has limited or narrowed its claims to cover only "progressive" indication as discussed above.

Because Doroodian's specification does not disclose a "single point-in-time" embodiment, the claimed wear indicating means under 35 U.S.C. § 112, sixth paragraph, cannot be construed as though a "single point-in-time" embodiment is a corresponding embodiment in the specification. Furthermore, because "multiple points-in-time" embodiments are not equivalent to a "single point-in-time" embodiment⁵, it is our determination that Doroodian's involved claims are limited to "multiple points-in-time" embodiments and do not cover "single point-in-time" embodiments.

We recognize that Doroodian's technical witness, Dr. Anthony R. Booth, on cross-examination by Tseng, indicated that Doroodian's claim 1 covers Doroodian's Figure 7 embodiment. However, Tseng pointed to no testimony of Dr. Booth to the effect that one with ordinary skill in the art would understand Doroodian's Figure 7 embodiment as not providing a substantially continuous indicator but only an on/off indicator. Moreover, if

⁵ Neither party asserts that there is such an equivalence.

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it is Dr. Booth's view that claim 1 is sufficiently broad to cover both on/off and substantially continuous embodiments, the issue is a question of law and thus Dr. Booth's conclusion on the ultimate legal issue carries no weight. In any event, Tseng has not directed our attention to the underlying basis or rationale for Dr. Booth's conclusion that Doroodian's claim 1 covers the Figure 7 embodiment. For all of these reasons, Dr. Booth's testimony does not change our view as to what is covered by Doroodian's claims.

Tseng asserts that Doroodian's exclusive licensee and real party in interest, Arthur D. Little Enterprises ("ADLE"), in or about November 1996, provided Tseng's real party in interest ("Gillette Company") with a document entitled "Razor Gauge™ Wear Indicator Technology for Razor Blades, Licensing Opportunity presented to: The Gillette Company, October 1996." Tseng notes page 6 of that document which describes how the technology works, in part, as follows:

- *□ Strip of material (integral with or separate from comfort strip) that changes physical properties (preferably appearance) as a function of wear/use.
- *□ Could be designed as an off/on device or a continuously changing indicia to let users judge for themselves when it is time to discard product (equivalent to the Oral-B Toothbrush Indicator).

Tseng further points out that the document on page 10 illustrates

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both the On/Off method and the Progressive method. On the basis of the foregoing, Tseng argues that ADLE contended that the Doroodian involved patent claims cover both the on/off and the progressive visual indication. The argument is without merit, because page 11 of the same document identifies more than Doroodian's involved patent as the source of proprietary coverage for the technology being marketed in the document. Moreover, on page 11 of the document where Doroodian's involved patent is mentioned, the language states: "Broad U.S. Patent claims covering change of physical properties **as the blade is used** US Patent # 5,388,331." (Emphasis added). The bolded text suggests a progressive rather than an on/off mechanism insofar as Doroodian's involved patent is concerned. Also, it appears that an in-house counsel for the Gillette Company (Tseng's real party in interest), Mr. Stephan P. Williams, has acknowledged that the licensing document can include technology not covered by Doroodian's involved patent. Williams Tr. 158-59.

Tseng also asserts that in 1999 Doroodian had made statements to the Australian Patent Office to the effect that Doroodian's claimed invention provided both a single point-in-time and a multiple points-in-time blade wear indicator, citing to Tseng Exhibit 2090. We have reviewed Tseng's Exhibit 2090 in detail and do not find the purported representation to the

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Australian Patent Office. The exhibit appears to be a communication from Doroodian's legal representative to the Australian Patent Office. In a pertinent part thereof quoted by Tseng, the communication states: "One of the advantages of the invention in each of its forms is the ability to construct the wear indicator so it will indicate wear after a predetermined amount of or number of uses." This language does not necessarily indicate that prior to reaching the predetermined number of uses there would not be any visual indications of wear.

In any event, Tseng has not established that the disclosure of the Australian patent application it refers to is the same as the disclosure of Doroodian's involved patent or that the claims in the Australian patent application are the same as Doroodian's involved claims in this interference. Tseng has not satisfied us that oranges are being compared with oranges and apples to apples. Moreover, as we discussed above, in its remarks to the examiner during prosecution of Doroodian's involved patent in the U.S. Patent and Trademark Office, Doroodian in no uncertain terms represented that its claimed invention is directed to providing a visual indication of "progressive blade wear." We credit that representation to the U.S. Patent and Trademark Office more than we do any contrary statement to the Australian Patent Office.

Even assuming (1) that the Australian patent disclosure is

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the same as the disclosure of Doroodian's involved patent, (2) that the Australian patent application claims were the same as Doroodian's involved claims, and (3) further that Doroodian had represented to the Australian Patent Office that its claims cover both "single point-in-time" and "multiple points-in-time" embodiments, that does not counter-balance or overcome the reasons we discussed herein for concluding that Doroodian's claims are directed to an invention providing substantially continuous or progressive visual indications of blade wear.⁶

Finally, Tseng argues that by reading the "multiple points-in-time" feature into Doroodian's claim 1, we would be including into claim 1 a feature expressly added or recited in a dependent claim and that would be an indication that claim 1 should not be so construed. The argument is misplaced and thus rejected. The dependent claims are each directed to a particular embodiment, whereas claim 1 including the "multiple points-in-time" feature is broad enough to cover all disclosed "multiple points-in-time" embodiments and equivalents thereof. Tseng has not directed our attention to any dependent claim which duplicatively recites what Doroodian contends is required by its independent claim 1.

⁶ Note, for instance, that the patent laws may not be the same, especially with regard to means-plus-function clauses under 35 U.S.C. § 112, sixth paragraph.

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Now we turn to what Tseng's claims require with regard to a visual indication. In pertinent part, Tseng's independent claim 113 recites: "wherein said skin engaging layer is adapted to erode during contact with said skin during shaving **to visually expose said non-skin engaging layer**" (Emphasis added). In pertinent part, Tseng's independent claim 117 recites: "wherein said skin engaging member is constructed such that said skin engaging layer erodes during contact with said skin during shaving **to visually expose said non-skin engaging layer**" (Emphasis added). In pertinent part, Tseng's independent claim 118 recites: "wherein said skin engaging layer is adapted to erode during contact with said skin during shaving **to visually expose said non-skin engaging layer**" (Emphasis added). In pertinent part, Tseng's independent claim 135 recites: "wherein said skin engaging layer is adapted to erode during contact with said skin during shaving **to visually expose said non-skin engaging layer over time**" (Emphasis added).

None of the above-quoted portions of Tseng's claims can reasonably be regarded as requiring a progressive visual indication or a "multiple points-in-time" visual indication, especially the language of claim 135 which includes the words "over time." When something is said to be exposed "over time,"

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it means the item is not exposed immediately but only after a period of time. Tseng's specification has not coined a different definition for the term. Even assuming, without deciding, that the emphasized quoted portions of Tseng's claims 113, 117, 118 and 135 are broad enough to cover progressive visual indication or "multiple points-in-time" visual indication, that still does not mean these claims anticipate, in the sense of 35 U.S.C. § 102, Doroodian's involved claims insofar as the "multiple points-in-time" feature of Doroodian's claims are concerned.

None of Tseng's claims depending from claims 113, 117, 118 and 135 add any recitation which makes up for the shortfall of independent claims 113, 117, 118 and 135 for anticipating the "multiple points-in-time" feature of Doroodian's claims. Accordingly, we find that none of Tseng's involved claims 113, 117-123, 130-133 and 135-136 anticipates any one of Doroodian's involved claims 1-6.

Doroodian represents that it would not have been obvious to one with ordinary skill in the art to arrive at Doroodian's claims including the "multiple points-in-time" feature, starting from Tseng's involved claims. We agree.

We find that the level of ordinary skill in the art of disposable razor blades is generally reflected by the technology described in these items of prior art: U.S. Patent Nos.

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5,113,585; 4,982,767; 4,562,644; 4,170,821; 3,879,844;
and 2,703,451. The testimony of Dr. Anthony R. Booth,
Doroodian's technical witness, that "I consider a person of
ordinary skill in the art to be a scientifically trained or
technically trained individual who has worked in the industry for
ten (10) years and has experience designing razor products,
developing razor products, testing razor products and
manufacturing razor products" is too general and vague to be
meaningful. Tseng's position that Doroodian's definition
overstates the ordinary skill in the art is also not helpful.

According to Doroodian, Tseng's involved claims can only be
construed as requiring an all or nothing, or "single point-in-
time" visual indication because that is the only notion disclosed
in Tseng's specification. We agree. An application claim can
properly be construed according to its broadest reasonable
interpretation but that interpretation must be consistent with
the specification. Tseng's specification does not describe any
"multiple points-in-time" mechanism that gives a progressive
visual indication. Tseng's specification does not reveal even
that a progressive indication is anything of value or desirable.
The only reference to any kind of indication being provided is a
lone sentence in the SUMMARY OF THE INVENTION section which
reads: "Yet another object of the present invention is to

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provide a wear indicating skin engaging member," and the following paragraph appearing on page 6 of the Tseng specification as filed (Tseng Exhibit 2008):

In an embodiment of the present invention a wear indicating effect is produced when the sheath material and the core material are made of disparately colored materials (e.g. white colored sheath and blue colored core). Upon use, the sheath material over the skin engaging surface is typically worn off through use. **With sufficient use, a second colored region represented by the core is exposed, thus, providing the user with [an] indication that the shaving unit and/or skin engaging surface have reached their effective life.** In a preferred embodiment, the sheath material consists of polyethylene oxide/polystyrene mixture which is white in color and the core consists of nylon and/or styrene which has been colored with a FD&C #2 dye. Other suitable dyes or pigments include FD&C Red No. 40, Erythrosine (FD&C Red No. 3), Brilliant Blue FCF (FD&C Blue No. 1), Indigotine (FD&C Blue No. 2), Tartozine (FD&C Yellow No. 5), Sunset Yellow FCF (FD&C Yellow No. 6) and Fast Green FCF (FD&C Green No. 3) and Titanium Dioxide. (Emphasis added)

Thus, the purpose of the indication is to reveal that the shaving unit and/or the skin engaging surface have reached their effective life. The indication is not intended to come on when the shaving unit is relatively new or just beginning to be used. It is only after "sufficient use" that the second colored region becomes exposed to give a visual indication.

Consequently, the recitations in Tseng's independent claims 113, 117, 118 and 135 to the effect that the skin-engaging layer erodes to visually expose the non skin-engaging layer cannot be

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so broadly interpreted as covering either the case of "multiple points-in-time" progressive visual indication or single point-in-time" visual indication. Rather, we conclude that such recitation in these claims limit the coverage to only "single point-in-time" visual indication at a particular time.

According to Tseng, Figures 3-6 in its specification illustrates "multiple points-in-time" wear indicator strips that would provide a progressive visual indication of the wear on the blade. In support of that argument, (1) Tseng presents a drawing produced in its opposition at page 5 that supposedly illustrates how the wear indicator strip shown in Tseng's Figure 5 gives a progressive visual indication, and (2) Tseng presents recent test results on indicator strips made in 1993 by Philip Sweeney, an employee of the Gillette Co., under the direction of Mingchih M. Tseng. According to Tseng, the actual samples correspond to what is described in the specification as Example 13⁷ and tests thereon "confirm" the illustrations or depictions on page 5 of the opposition with regard to Tseng's wear indicating strip. We will discuss these efforts, in turn. However, neither

⁷ Tseng states (Opp. At 6): "Example 13 was inadvertently identified as 'Example 12' in the application as filed (TE 2008 at 9). That typographical error was corrected during prosecution (TE 2067 at 7)." Note that it is "Example 12" on page 9 of Tseng's specification which should be identified as "Example 13."

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demonstration is persuasive in establishing Tseng's argument.

Tseng's demonstration presented via a drawing on page 5 of its opposition is without merit.

First, it can be seen from the illustration on page 5 of Tseng's opposition that even according to Tseng's illustration, in going from "Before Use" to "After Some Use" in the second column of the four-column table, there has been no change in visual indication. Thus, even though the blade has been partially worn, there is no visual indication to that effect. That alone seriously undermines Tseng's assertion that the illustrated embodiment provides progressive indication of relative blade wear.

Secondly, when the lower layer of a contrasting color has been exposed, as is shown in the picture corresponding to "After Further Use" and in the second column, Tseng's specification as quoted above provides that the shaving unit and/or the skin engaging surface have reached their intended effective life. Tseng's specification makes no distinction between partial exposure and complete exposure of the differently colored core. Thus, either partial or complete exposure of the core gives a visual indication that the shaving unit and/or the skin engaging surface has reached its intended useful life.

Whether it is the shaving unit or the skin engaging surface

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that has reached its intended effective life, the result is the same. We cannot assume that a shaving unit will continue to be used when its "skin engaging surface" has reached its intended useful life. Tseng's specification does not state anything to the effect that the shaving unit will continue to be used for shaving after the shaving unit and/or the skin engaging surface thereof have reached their intended useful life.

Tseng contends that because the conjunctive-disjunctive "and/or" is used in the phrase at issue, it is not necessarily true that when the core is exposed the shaving unit has reached its intended useful life. The argument is wanting because Tseng does not explain any meaningful difference, in the context of Tseng's specification, between the shaving unit's reaching its intended useful life and the skin engaging surface's reaching its intended useful life. Tseng has pointed to nothing in its specification which describes how a user would determine whether it is one and not the other, or how the user's response or subsequent action upon detecting the visual indication would vary depending on whether it is one and not the other. In this light, the end of intended useful life of the shaving unit and of the skin engaging surface are equivalents and there is no apparent reason to continue using the shaving unit once the core of contrasting color has been exposed.

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We recognize that Tseng's specification at page 5 discloses that the core can be made of a blend of non-water soluble plastic resin and water-soluble resin and that polyethylene oxide is an example of one such water-soluble resin. Tseng points out that polyethylene oxide, according to its specification at page 4, is an example of a suitable shaving aid material included in the sheath or skin engaging layer. But that is not sufficient basis to find that according to Tseng's specification despite exhaustion of the sheath or skin engaging layer the shaving unit would continue to be used after exposure of the core.

There is no statement anywhere in Tseng's specification to the effect that the shaving unit would continue to be used after exposure of the core. Also, there are a number of indications in Tseng's specification that the polyethylene oxide used to build the core is not included as a shaving aid. Note that only the polyethylene oxide in the skin engaging layer is ever referred to as "shaving aid," and that of all the different functions Tseng's specification identifies and describes for the core, none contemplates the core itself as providing a skin engaging surface for use in further shaving when the covering sheath has been eroded away.

Consequently, the illustration corresponding to the "After Additional Use" label on page 5 of the opposition is something

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that will not be reached during normal and intended use of the shaving unit, insofar as Tseng's invention is concerned.

Tseng's specification also makes no mention of the duration of or any significance, value, or benefit, of the time period, assuming that there is any such meaningful time period, between initial partial exposure and full exposure of the core. Tseng's specification does not describe or disclose that anything meaningful occurs in such a period or that it has a duration longer than a single shaving session. This is consistent with our finding that either partial or full exposure of the core gives a visual indication that the shaving unit or the skin engaging surface has reached its intended useful life.

Alternatively, even if we regard the end of the intended useful life of the shaving unit and of the skin engaging layer as non-equivalents, and also assume that the shaving unit would continue to be used despite exposure of the underlying core, there still can be no progressive or "multiple points-in-time" visual indication as is argued by Tseng with respect to its specification. If the skin engaging layer has reached its intended useful life, then it can no longer be relied upon or expected to provide a visual indication after further use of the shaving unit. Tseng's argument improperly relies on the skin engaging layer to provide a progressive or ongoing visual

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indication even after the skin engaging layer has reached its intended useful life.

Furthermore, patent drawings are not usually made to scale and are not production drawings or blue-prints for manufacturing. Insofar as Tseng's Figures 3-6 are concerned, no one knows just how curved the core 70 is in the vicinity of its junction with the skin engaging layer 74. Indeed, even a plain observation of Figure 3-6 reveals different curvatures from one to the next, albeit all of them show only a very slight curvature. On the basis of such ambiguous evidence, there is no credible basis for Tseng to conclude that there is progressive indication beginning from when the core is first exposed to when the core is completely exposed. For instance, all of that exposure can occur in a single shaving session through multiple strokes within that session, in which case there really would be no progressive indication from shaving session to shaving session.

We have reviewed the second declaration of Edwin L. Thomas (Exhibit 2115), submitted by Tseng to support its opposition to Doroodian's motion. It does not account for the above-noted deficiencies of Tseng's argument. Mr. Thomas' depiction on page 6 of Exhibit 2115 (same as the drawing on page 5 of Tseng's opposition) of what happens when Tseng's razor unit is continued to be used after exposure of the core depends on continued usage

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of the razor unit after exposure of the core. Yet, on cross-examination, he acknowledges that according to the disclosure in Tseng's specification, the "after additional use" category in the depiction is something that is never reached. (Thomas Transcript at 1014). Mr. Thomas further explains, with respect to exposure of the differently colored core (Transcript at 1140):

A. You're reaching the time in which maybe during that after that shave is over or before the next one starts you want to change blades.

The question is not whether details can be independently proposed for various parts in Tseng's drawings such that one can justify continued use of the shaving unit after exposure of the core, but what Tseng's specification says or does not say in that regard.

Tseng's demonstration based on recent test results of indicator strips made in 1993 and which allegedly correspond to Example 13 in Tseng's specification are also not persuasive, in several respects, with regard to Tseng's argument that its specification discloses "multiple points-in-time" or progressive visual indication of the relative wear on the shaving blade.

First, the actual samples are not commensurate in scope with either Tseng's claims or the particulars described in the specification for Example 13. Example 13 does not specify how thick the skin-engaging layer should be over the core. Depending on how thick it is, the different color of the core will become

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exposed or start to become exposed at different times. Whether there is a progressive or "multiple points-in-time" visual indication depends on the thickness of the skin-engaging layer. Also, the curvature of the core beneath the skin-engaging-layer is not specified in Tseng's Example 13. Whatever is the curvature used in the actual samples, it directly affects the manner in which the color below becomes revealed and yet is without underlying basis in Example 13 of the specification.

Therefore, even if the photographs of Tseng's Exhibits 2063, 2064A, and 2092-2099 show what Tseng states they show, the showing is not commensurate in scope with what is described in the specification as Example 13. Thus, the test results of actual samples produced in 1993 do not support Tseng's argument as to what its specification discloses.

Secondly, the photographs reflecting the test results do not show changes through each successive shaving session. For instance, in all of the photographs of Tseng's Exhibits 2063, 2064A, and 2092-2099, each one depicting usage of a different shaving cartridge, there is no meaningful change in color contrast until after at least two shaving sessions. For two cartridges, (Tseng Exhibit 2064A and 2095), there is no discernable color contrast between the skin-engaging layer and the core or non-skin-engaging layer until after three shaving

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sessions. For three cartridges (Tseng Exhibits 2063, 2093 and 2097), there is no discernable color contrast until after four shaving sessions. Collectively, the results do not reasonably show that there is a progressive visual indication, even on average, as the cartridges advance from one shaving session to the next beginning from when each shaving cartridge is new, which is required for satisfying the "multiple points-in-time" visual indication feature of Doroodian's claims.

The photographs of Tseng's Exhibits 2063, 2064A, and 2092-2099 do not support the testimony of Michael J. Kwiecien (Tseng Exhibit 2110, ¶ 12) to the effect that more and more of the underlying blue layer is exposed as each shaving cartridge is used, when observation begins from when each cartridge is unused.

Finally, as is the case with our discussion of Tseng's illustration on page 5 of its opposition, the testing of the actual samples includes photographs taken even after the blue-colored non-skin-engaging layer or core has been exposed. As has already been explained, there is no basis in Tseng's specification for continuing use of the shaving cartridge when the differently colored core has been exposed, i.e., when the shaving cartridge and/or the skin-engaging layer have reached their intended useful life.

In any event, apart from the above-discussed problems, the

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photographs presented in Tseng's Exhibits 2064A and 2096-2099 have questionable value. As is pointed out by Doroodian, the succession of photographs contained in each exhibit are not illustrating the same portion of the shaving cartridge from shave to shave. On cross-examination, Ms. Linda Galfetti, a technician employed by The Gillette Co. who took the photographs in Tseng's Exhibits 2064A and 2096-2099 (Galfetti declaration ¶¶ 3-6), testified that within each exhibit the successive photographs are images taken of "random" portions of the shaving cartridge and thus the pictures do not show the same area of the shaving cartridge from shave to shave. (Galfetti Transcript at 36). Such evidence is intrinsically suspect and cannot firmly indicate the before-and-after changes in appearance or color contrast in the wear indicating strip. Note also that without counting the photographs in Tseng's Exhibits 2064A and 2096-2099, and directing our attention only to the photographs in Tseng's Exhibits 2063 and 2092-2095, Exhibit 2094 apparently shows no change until after two shaving sessions, Exhibits 2092 and 2095 apparently show no change until after three shaving sessions, and Exhibits 2063 and 2093 apparently show no change until after four shaving sessions.

We are not persuaded by Doroodian's argument pointing out the length of time the actual samples have been placed in storage

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after their production in 1993 and noting that Tseng easily could have made fresh samples. We are also not persuaded by Doroodian's argument noting the lack of sample degradation analysis. Doroodian has not presented credible evidence that Tseng's samples made in 1993 reasonably would have already reached a point of degradation that makes testing unreliable. We are also not persuaded by Doroodian's argument that the testing protocol was not adequately documented by Tseng. The cartridges were photographed before and after use in each shaving session. Doroodian has not explained what deficiency exists in the testing protocol. Michael J. Kwiecien testified that he developed a shave test protocol and the particulars of that protocol are noted in Paragraph Nos. 9-11 of his declaration. We are not also persuaded that records must be kept of each testing user's preparation habits, shaving routine, or perception of shaving quality. Each user has his own idiosyncracies that are not expected to coincide with those of other users. Although the possibility always exists that a party might have hand-picked or specially selected participants which shaved only in a particular way that would skew the test results in favor of a certain conclusion, there is not a scintilla of evidence that this occurred despite cross-examination by Tseng of pertinent witnesses. Accordingly, we do not regard this as a realistic

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possibility such that the shaving habits of each participant must be documented and/or corroborated to have value.

For all of the foregoing reasons, we reject Tseng's assertion that its Figures 3-6 are embodiments having a "multiple points-in-time" indicator strip that provides progressive visual indication of blade wear. As we stated above, Tseng's independent claims 113, 117, 118 and 135, and claims dependent thereon are limited to a "single point-in-time" indicator strip.

Doroodian asserts that the evidence of record does not support a conclusion that Tseng's claims, if limited to "single point-in-time" indicator strips, would render obvious party Doroodian's claims if they are construed so as to require "multiple points-in-time" indicator strips. On this record, the assertion is sufficient to make out at least a prima facie case of nonobviousness. In that regard, party Tseng does not contend that its claims, if limited to "single point-in-time" indicator strips, would render obvious party Doroodian's claims if they are construed so as to require "multiple points-in-time" indicator strips. We also have no reason to make that conclusion here.

For all of the foregoing reasons, Doroodian's preliminary motion 1 alleging no interference-in-fact is **GRANTED**.

B. Tseng's Claim 134 is unpatentable

Party Tseng's claim 134 reads as follows:

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In a disposable razor or razor cartridge comprising at least one blade mounted in a head or frame, said blade having a shaving edge, the improvement comprising indicating means for providing a visual indication of the relative amount of use of the razor or cartridge, said indicating means being located on the head or frame in proximity to the shaving edge of said blade so as to contact the skin during use, and comprising a strip of material having a first layer of a first color and a second layer of a color contrasting with said first color, wherein said layers are arranged so that **said strip of material changes in appearance as the disposable razor or razor cartridge is used in shaving.** (Emphasis added).

In its preliminary motion alleging no interference-in-fact, Doroodian would have us construe Tseng's claim 134 as being similarly limited to the "single point-in-time" visual indication feature that characterizes Tseng's other claims. In our view, however, the recitations of claim 134 is so inconsistent with the notion of a "single-point-in time" visual indication that the claim cannot be reasonably construed that way. Note especially the bolded text of claim 134 quoted above.

On our own initiative, and done only to provide support for our finding of no interference-in-fact, we conclude that Tseng's claim 134 is unpatentable under 35 U.S.C. § 112, second paragraph, for indefiniteness, and alternatively, under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification.

Claim 134 initially recites an "indicating means for

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providing a visual indication of the relative amount of use of the razor or cartridge." Per 35 U.S.C. § 112, sixth paragraph, the indicating means covers only those corresponding embodiments described in the specification and equivalents thereof. The only visual indication described in Tseng's specification as filed is the exposure of a different or contrasting color on the core underneath the sheath or skin-engaging layer. Note page 6, lines 14-17 of the Tseng specification as filed, which states:

Upon use, the sheath material over the skin engaging surface is typically worn off through use. With sufficient use, a second colored region represented by the core is exposed, thus, providing the user with [an] indication that the shaving unit and/or skin engaging surface have reached their effective life.

No other kind of visual indication is referred to or discussed anywhere in Tseng's specification as filed. Yet, claim 134 further recites broadly that the indicating means comprises a strip of material which changes in appearance as the disposable razor or razor cartridge is used in shaving. This language broadens out the visual indication to cover not just exposure of a different color beneath and equivalents thereof but any perceived change in appearance, e.g., size, shape, texture, regularity, consistency, uniformity, opaqueness, transparency, etc. Thus, the claim is internally inconsistent and that alone renders the claim indefinite under 35 U.S.C. § 112, second

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paragraph, for failing to particularly point out and distinctly claim that which the inventor regards as the invention.

Alternatively, even if we ignore the internal inconsistency and assume that the claim is not limited to the disclosed manner of visual indication by exposure of a different color of an initially covered layer, the claim is nonetheless indefinite because we find that no objectively determinable standard has been set forth in Tseng's specification for deciding when the appearance of the strip of material has changed in terms of overall "appearance" as is broadly recited in the claim. Claim 134 itself also does not set forth an objective standard.

Change in "appearance" as that term is broadly and loosely used is a matter of degree. No physical object has absolutely the same identical appearance at two different times. For instance, dust may have collected on an object in between the times of observation, or condensation may have developed on its surface. When would differences sufficiently amount to a "change in appearance"? Based on Tseng's specification and for the myriad of possible appearance factors mentioned above, that would not be known to one with ordinary skill in the art.

Notwithstanding its problems under 35 U.S.C. § 112, second paragraph, claim 134 is also unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description in the

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specification as filed. Claim 134 is not an original claim presented when Tseng's involved application was filed.

Therefore, its own text cannot be regarded as a part of the original specification of Tseng. In no uncertain terms, claim 134 recites that the strip of material having the two layers of contrasting colors **changes in appearance as the disposable razor or razor cartridge is used in shaving.**

In our discussion of whether there is interference-in-fact, we have already explained why Tseng's specification as filed does not provide a written description for any "multiple points-in-time" embodiment that gives a progressive visual indication from one shaving session to the next. The very same analysis is applicable to explain why Tseng's specification as filed does not provide written description for the feature specifying that the indicator strip changes in appearance of the indicator strip as the disposable razor or razor cartridge is used in shaving. Furthermore, the case of lack of written description in the specification is much stronger here, in the context of Tseng's claim 134 which goes beyond visual indications from one shaving session to the next by specifying that the change in appearance is "as the disposable razor or razor cartridge is used in shaving." That means from one shaving stroke to the next, even within the same shaving session, there would be a visual

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indication of some sort. Tseng's disclosure on page 6 of its specification states that with sufficient use, the second colored region of a disparate color is exposed does not provide a description for the specific requirement set forth in Tseng's claim 134. As has been discussed above in connection with Doroodian's no interference-in-fact motion, Tseng's Figures 3-6 do not disclose any "multiple points-in-time" embodiment that gives a progressive visual indication even from shave to shave. They also do not give a progressive visual indication from stroke to stroke. As for the testing results submitted by Tseng with respect to its Example 13, the photographs of Tseng's Exhibits 2063, 2064A and 2092-2099 illustrate only images taken at the beginning of each successive shaving session. They do not reveal the state of the indicator strip from shaving stroke to shaving stroke.

For the foregoing reasons, Tseng's claim 134 is unpatentable under 35 U.S.C. § 112, first and/or second paragraphs.

Ordinarily, prior to a sua sponte holding of unpatentability we would ask the parties to address the pertinent issues. Such an invitation is unnecessary here, because the parties have already fully briefed the issue of whether Tseng's specification provides written description for a "multiple points-in-time" visual indication, in the context of Doroodian's preliminary

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motion 1 alleging no interference-in-fact. To the extent that party Tseng would like an opportunity to submit arguments relating to our finding of indefiniteness under 35 U.S.C. § 112, second paragraph, it may include such arguments in any request for reconsideration to be filed within thirty (30) days of the date of this decision.

There also does not appear to be any useful purpose for party Tseng to propose a substitute claim to replace claim 134, since we have concurrently found (1) that Tseng's specification does not provide written description support for "multiple points-in-time" visual indication, and (2) that Tseng's claims directed to "single point-in-time" visual indication do not interfere with Doroodian's involved claims. Therefore, we will not provide a period for Tseng to propose a substitute claim.

C. Tseng's preliminary motion 1 to add claims 137 and 138 to its application

Party Tseng had an opportunity to file a responsive motion under 37 CFR § 1.633(i) when Doroodian filed a preliminary motion under 37 CFR § 1.633(b) alleging no interference-in-fact. Such a responsive motion can be to redefine the interference by adding one or more claims which would interfere with Doroodian's involved claims even if it is determined that the original involved claims of Tseng do not. Here, Tseng filed no responsive

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motion under 37 CFR § 1.633(i) and we have determined that there is no interference-in-fact between the originally involved claims of the parties designated as corresponding to the count at the inception of this interference. Consequently, we need not reach any preliminary motion of Tseng. However, we are willing to give the benefit of doubt to Tseng who might have thought that it need not file a responsive motion to add claims because it already had filed a preliminary motion to add claims 137 and 138 in the initial round of preliminary motions.

Therefore, we will consider Tseng's preliminary motion 1 to add claims 137 and 138, but only from the perspective of a responsive motion under 37 CFR § 1.633(i), for the potential of these claims to salvage a holding of no interference-in-fact.

Proposed independent claim 137 reads as follows:

A razor comprising a blade member having a shaving edge, and an external skin engaging member adjacent the shaving edge of said blade member, said skin engaging member comprised of: an elongated sheath comprised of a mixture of a water soluble shaving aid and a water insoluble material, and a rigid core extending axially throughout said sheath; wherein said core and said sheath are fabricated from materials which exhibit different core and sheath colors, **wherein upon use, said sheath will wear along a skin engaging surface to expose said different colored core, thus providing an indication that the skin engaging member has reached its desired life or that the razor has reached its desired life.** (Emphasis added.)

Proposed dependent claim 138 reads as follows:

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The razor of claim 137 wherein said water soluble shaving aid is selected from the group consisting of polyethylene oxide, polyvinyl pyrrolidone, polyacrylamide, hydroxypropyl cellulose, polyvinyl imidazoline, polyhydroxyethylmethacrylate, silicone copolymers, sucrose stearate, vitamin E, panthenol, aloe, essential oils and combinations thereof and said water insoluble material is selected from the group consisting of nylon, ethylene vinyl acetate, polyethylene, polypropylene, polystyrene, polyacetal and combinations thereof.

Insofar as any visual indication is concerned, the newly proposed claims, as compared to the originally involved Tseng claims 113, 117-123, 130-133 and 135, further specify that visual exposure of the different color of the core is an indication that "the skin engaging member has reached its desired life or that the razor has reached its desired life." The addition of this recitation does not help to remedy the deficiencies of the original claims for failing to anticipate or render obvious the involved Doroodian claims which require progressive or "multiple points-in-time" visual indication of relative blade wear from shaving session to shaving session. An indication that either the skin engaging member or the razor has reached its desired life is still a "single point-in-time" visual indication not meaningfully different from that specified in Tseng's claims 113, 117-123, 130-133 and 135. We also have already determined that Tseng's specification does not disclose any embodiment having a "multiple points-in-time" visual indication. In that light,

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Tseng's motion does not make out a prima facie basis for relief.

Because proposed new claims 137 and 138 do not cure the deficiencies of the original involved claims insofar as the existence of interfering subject matter is concerned, Tseng's preliminary motion 1 to add claims 137 and 138 is **dismissed**.

D. Tseng's other pending preliminary motions

We have determined that there is no interference-in-fact, i.e., that the claims of the parties are patentable over the claims of the opponent even if the opponent is deemed to have been the prior inventor(s). Tseng has filed numerous preliminary motions seeking to have the Board hold that Doroodian's claims are unpatentable. The issue before the Board is whether Tseng's preliminary motions for judgment against Doroodian's claims should be reached on their merits when the Director, through the Board, has determined that no interference exists.

While we have held Tseng's claim 134 to be unpatentable, the determination is not made pursuant to any preliminary motion for judgment filed by Doroodian, but necessitated by our analysis of whether the claims of the parties interfere. An unpatentable claim cannot serve as the basis for an interference.

On page 24 of Tseng's opposition, it is stated:

Since Perkins v. Kwon, 886 F.2d 325, 328, 12 USPQ2d 1308, 1310 (Fed. Cir. 1989), the Federal Circuit repeatedly has held that the Board should decide issues

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of patentability and priority that have been fully developed by the parties, **even if the Board determines that there is no interference-in-fact.** (Citations omitted) (Emphasis added).

We have reviewed every case authority cited by Tseng's counsel. None of them makes the statement or representation that even if the Board finds that there is no interference-in-fact, it should nonetheless decide all issues of patentability and priority which have been fully developed by the parties. Also, none of them involves the fact situation that the Board has determined that the claims of the parties do not interfere.

The issue would appear to be one of first impression. Accordingly, the parties are required to brief the issue of whether the Board should decide on the merits Tseng's preliminary motions 2-5 attacking the patentability of Doroodian's claims.

Among other points, the parties must address the following:

1. Are there alternative remedies for Tseng to urge the unpatentability of Doroodian's claims (e.g., reexamination, defense to a civil action alleging infringement, protest under PTO rules) and, if so, are those remedies adequate or inadequate and why?

2. Would consideration of the patentability of Doroodian's claims in this interference amount to an impermissible post-grant cancellation proceeding?

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3. How will the parties be prejudiced if the Board does not decide the patentability issues raised by Tseng?

4. Given that there is no interference-in-fact, would a decision on the patentability of Doroodian's claims constitute an "advisory" opinion and, if so, what justification is there for expending fee revenue to render an advisory opinion?

5. Would deciding Tseng's preliminary motions for judgment be consistent or inconsistent with the decision of the Court of Customs and Patent Appeals in Nitz v. Ehrenrieck, 537 F.2d 539, 190 USPQ 413 (CCPA 1976), vacating an award of priority where it held there was no interference-in-fact.

The principal brief of each party must be filed within fourteen (14) days of the date of this communication. Each party may file a responsive brief within seven (7) days of the opposing party's principal brief.

E. The Parties' Motions to Suppress Evidence

Doroodian's Motions to Suppress

Doroodian's Motion 1 to suppress seeks to suppress "new" evidence relied upon by Tseng in Tseng's reply briefs and the testimony of Drs. Kwiecien and Thomas based on such "new" evidence, and to deny consideration of Tseng's replies 1-5 for failure to follow procedures governing the filing of pleadings. We have, however, not reached the merits of Tseng's preliminary

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motions 2-5. As for Tseng's preliminary motion 1, it does not make out a prima facie basis for relief and we have had no occasion to consider Doroodian's opposition or Tseng's reply. Accordingly, Doroodian's motion 1 to suppress is **dismissed**.

Doroodian's Motion 2 to suppress seeks to suppress the testimony of Drs. Kwiecien (TE 2110, ¶ 12) and Thomas (Tseng Exhibit 2115, ¶¶ 85-86) that Tseng relied on in its Oppositions 1 and 2 and Reply 1 relating to the condition and appearance of S2293-1 strips during shaving tests. Doroodian's Motion 2 to suppress also seeks to suppress (a) Tseng Exhibits 2063 and 2092-2095 (photographs of razor cartridges containing S2293-1 strips); (b) Tseng Exhibits 2064A and 2096-2099 (photographs of portions of razor cartridges containing S2293-1 strips); and (c) Tseng Exhibits 2100-2104 (actual razors with cartridges containing S2293-1 strips after the end of the shaving tests).

To the extent that items sought to be suppressed are not relied on in Tseng's opposition to Doroodian's preliminary motion 1, motion 2 to suppress is **dismissed**, because we have not reached the merits of Doroodian's preliminary motion 2 or Tseng's preliminary motions 2-5 and because Tseng's preliminary motion 1 does not make out a prima facie basis for relief. Insofar as the items are relied upon in Tseng's opposition to Doroodian's preliminary motion 1, the motion to suppress is **denied**.

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Drs. Kwiecien and Thomas testified as technical experts. Their opinions are based on the photographs taken of various razor cartridges or portions thereof. It is not necessary that either witness must have personally observed the cartridges while they were being tested, in order for them to form an opinion based on the photographs of the cartridges and portions of cartridges during the testing. Even if the photographs and the used cartridges are regarded as hearsay, it does not mean that the experts cannot have an opinion as to what they show. See Fed. R. Evid. 702. In any event, we do not regard the photographs as hearsay, because simply by themselves they do not make an assertion. They are not out-of-court statements offered to prove the truth of the matter asserted. Rather, they constitute experimental data which may be relied upon by expert witnesses in the formulation of their respective opinions. The photographs and used cartridges have been authenticated by the testimony of Linda Galfetti (Tseng Exhibit 2113). Ms. Galfetti testified about her receipt of the razor cartridges with indicator strips, the shaving test procedures, the taking of the photographs, and the transfer of the used cartridges and the photographs to Dr. Kwiecien.

Doroodian's alleges that because Tseng has failed to comply with ¶ 43 of the Notice Declaring Interference which is entitled

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"Reliance on scientific tests and data," Tseng's exhibits including Exhibits 2063, 2064A, and 2092-2104 relating to shave test data should be suppressed. Even without suppressing such exhibits, however, we have granted Doroodian's preliminary motion 1 alleging no interference-in-fact. Accordingly, with regard to alleged non-compliance with ¶ 43 of the Notice Declaring Interference, the motion to suppress is dismissed as moot.

Tseng's Motion to Suppress

Tseng moves to suppress (1) Affidavits I and II and the declaration of Anthony R. Booth; (2) Doroodian Exhibit 1023, and (3) the cross-examination testimony of Tseng's witnesses Michael J. Kwiecien, Stephan P. Williams, Colin J. Clipstone, and Edwin L. Thomas.

Because Doroodian's preliminary motion 1 and its reply did not rely on Affidavit II of Anthony R. Booth (Doroodian Exhibit 1016), the motion is **dismissed** insofar as it seeks to suppress that affidavit.

Tseng's opposition did not rely on the declaration of Colin J. Clipstone (Tseng Exhibit 2025). Doroodian's preliminary motion 1 and its reply did not rely on any portion of the cross-examination testimony of Colin J. Clipstone. Accordingly, the motion is **dismissed** insofar as it seeks to suppress the cross-examination testimony of Colin J. Clipstone.

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Tseng argues that Booth's declaration is improperly duplicative of Booth's Affidavit II. The argument is rejected. The declaration and the affidavit had different contexts. As is pointed out by Doroodian, Affidavit II has to do with supporting Doroodian's prima facie case in its preliminary motion 2. The separate presentation in Booth's declaration is for rebutting Tseng's positions. While no doubt there is some overlap between the subject covered, the separation has a rational basis and appears to help in providing a better organization. At the very least it eliminates incorporation by reference or mere reference to another document which was submitted for a different purpose. Accordingly, the motion is **denied** insofar as it seeks to suppress the declaration of Anthony R. Booth on the basis of duplicativeness or redundancy.

Tseng's motion seeks to suppress the entire cross-examination transcript of Stephan P. Williams, Colin J. Clipstone, Edwin L. Thomas, and Michael J. Kwiecien on the ground that their deposition was not taken before a notary who was authorized to take such deposition in Massachusetts. The notary, Mr. Donald R. DePew, is a notary of New York, not Massachusetts where the deposition took place. In pertinent part, 37 CFR § 1.674(a) states: "(a) A deposition shall be taken before an officer authorized to administer oaths by the laws of the United

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States or of the place where the examination is held."

Because the cross-examination testimony of Colin J. Clipstone was not relied upon by either party in connection with Doroodian's preliminary motion 1 for no interference-in-fact, insofar as the motion to suppress is directed to the cross-examination testimony of Colin J. Clipstone is concerned, the motion is **dismissed**.

With regard to the cross-examination testimony of Messrs. Kwiecien, Williams, and Thomas, the motion to suppress is **denied**. The first deposition of these witnesses taken by Mr. DePew, a New York Notary, in the state of Massachusetts occurred on August 2, 2000 with the examination of Dr. Edwin L. Thomas. Dr. Michael J. Kwiecien was deposed on August 2, 2000, and Dr. Edwin L. Thomas was deposed on August 10, 11, and 23, 2000. Tseng's objection on the ground of 37 CFR § 1.674(a) was not made until September 22, 2000. Tseng was aware of the qualification of Mr. DePew at least by August 16, 2000, when it retained Mr. DePew to take the cross-examination testimony of Doroodian's witness Dr. Anthony R. Booth in New York. Tseng's objection was served more than one month after Tseng had retained the services of Mr. DePew as a notary of the state of New York. We find, under these circumstances, that Tseng had either waived the issue on the respective dates of the depositions of Messrs. Kwiecien, Williams, and Thomas by not

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making an objection at the time the testimony was taken, or made an untimely objection on September 22, 2000. The procedure for making an objection when an exhibit is served is not applicable to live depositions or cross-examinations where objections of this sort relating to testimony being produced live should be made at the time the testimony is taken. Tseng has offered no excuse for not inquiring into the qualification of the notary public at the commencement of each deposition.

Tseng's motion seeks to suppress the affidavit and declaration testimony of Dr. Anthony R. Booth on the alleged ground that Dr. Booth's testimony contains mischaracterizations and misstatements of various items of evidence about which he has made a statement. We regard this ground of the motion to suppress as frivolous and a wasting of the time and resources of the opposing party and the Board.

Mischaracterizations and misstatements, if they exist, simply go to the weight of the testimony. If in the view of Tseng the testimony of Dr. Booth contains mischaracterizations and/or misstatements, the proper action to take is to point out the alleged mischaracterizations and/or misstatements during cross-examination of Dr. Booth and either in an opposition to Doroodian's motion relying on such testimony, in a reply to Doroodian's opposition relying on such testimony, or in an

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observation with respect to cross-examination subsequent to Doroodian's reply relying on such testimony. In a proper instance where a genuine need exists, Tseng may even seek permission to file a surreply to respond to a Doroodian reply relying on such testimony. Tseng's disagreement with the statements or opinions of Dr. Booth constitutes no basis to suppress the testimony of Dr. Booth. To the extent that the motion to suppress is based on Tseng's assertion that the testimony of Dr. Booth contains mischaracterizations or misstatements, the motion is **denied**.

Tseng's motion also seeks to suppress portions of the cross-examination testimony of Michael J. Kwiecien, and Edwin L. Thomas, on the basis that Doroodian's citation to their testimony does not bring out the full story and thus mischaracterizes their testimony. This ground of suppression based on alleged incomplete citation is just as frivolous as the attempt to suppress Dr. Booth's testimony on the ground that it contains what Tseng regards as mischaracterizations or misstatements. If, in the opinion of Tseng, Doroodian's citation to transcripts of testimony does not bring out the full story, Tseng was free to identify the other parts which in its opinion should also be considered. Accordingly, insofar as the motion to suppress is based on alleged incomplete citation to the transcript of Drs.

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Kwiecien and Thomas, the motion is **denied**.

The motion to suppress further seeks to suppress the affidavits and declaration of Dr. Anthony R. Booth, on the ground that Dr. Booth quoted various passages of Doroodian's patent and then simply stated that the quoted passages constitute an accurate teaching without any explanation. The failure to explain only affects the persuasiveness or believability of the statement and does not constitute an adequate ground for suppressing Dr. Booth's testimony in that regard. Accordingly, insofar as the motion to suppress is based on this ground for suppression, the motion is **denied**.

Tseng's motion seeks to suppress Paragraph Nos. 9 and 11-12 of Booth's Affidavit I and Paragraph Nos. 9 and 11-12 of Booth's declaration on the ground that Doroodian's involved patent constitutes hearsay and those paragraphs of the testimony relies on such hearsay as proof for such testimony. Tseng's argument is misplaced. We have reviewed Paragraph Nos. 9 and 11-12 of Booth's Affidavit I and Paragraph Nos. 30, 39 and 43 of Booth's declaration but do not find them as presenting opinions on inventions, technology in general, or state of the art, whose support lies in the presumed truth of any matter asserted in Doroodian's involved patent. Rather, with regard to the specification of Doroodian's involved patent, Dr. Booth's

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testimony is about what Tseng's disclosure says, describes, and teaches. The focal point is the disclosure of Doroodian's involved patent, which Dr. Booth discusses, not any separate opinion of Dr. Booth which derives support from the content of Doroodian's patent specification. Accordingly, insofar as the motion to suppress is based on alleged reliance of Booth's testimony on hearsay, the motion is **denied**.

Tseng's motion seeks to suppress Doroodian's Exhibit 1002 which is simply a clean copy of Doroodian's involved patent claims. Tseng has failed to demonstrate how Doroodian has relied on that exhibit to prove the truth of any matter asserted in the exhibit. In our view, Doroodian has simply relied on that exhibit as an indication of what the claims say. The motion to suppress Exhibit 1002 on the ground of hearsay is **denied**.

Tseng's motion seeks to suppress Doroodian's Exhibit 1004 which a copy of Doroodian's specification as filed. Tseng asserts that Doroodian has relied on the exhibit as prove of the matter asserted in the exhibit, citing to pages 3-4 and Paragraph Nos. 5-9 of Doroodian's preliminary motion 1. However, Tseng has failed to persuade us that the assertion has merit. Tseng has not explained why the truth of anything asserted in Doroodian's specification is even an issue, as compared to just what the specification says, describes, and teaches. Paragraph Nos. 5-9

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of Doroodian's preliminary motion 1 is under the descriptive heading "The Involved Doroodian '331 Patent Specification and Claims," and appear to only set forth a picture of the world as seen through the eyes of Doroodian's specification and claims. Insofar as Tseng's motion seeks to suppress Exhibit 1004 as hearsay, the motion is **denied**.

Tseng's motion seeks to suppress Doroodian's Exhibit 1018 which is Doroodian's first drawing and written description of the invention of the count. Because the exhibit has not been relied on by either party in connection with any preliminary motion, the motion to suppress this exhibit is **dismissed**.

Tseng's motion on page 10 makes the plain assertion that Doroodian's Exhibit 1024 constitutes inadmissible hearsay. However, no explanation has been provided to demonstrate the assertion. Tseng does not even inform the Board where that exhibit has been relied upon by Doroodian to prove anything. Insofar as the motion to suppress is directed to this exhibit, the motion is **denied**.

Tseng's motion to suppress seeks to suppress the testimony of Dr. Anthony R. Booth on the ground that he is not qualified under Fed. R. Evid. 702 as an expert to give an opinion on the subject matter of the invention at issue in this interference.

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We are not persuaded and thus the motion to suppress in that regard is **denied**.

Not all persons qualified as an expert to give a technical opinion necessarily have the same background in either education or specific experience. It is also not necessary that a qualified expert must have worked on the same goals of research that produced an item with respect to which he or she would provide testimony. Fed. R. Evid. 702 is not that narrow, or else only colleagues working on the same project, having identical responsibilities, education, and employment history can qualify as an expert with respect to an issue relating to the project.

Dr. Booth received a Bachelor's degree in Metallurgy in 1963 and a Doctorate degree in Natural Science in 1967. His "years in the shaving industry" spans from 1970 to 1999 and involved various aspects of the industry including technical design, marketing, business management, licensing and evaluation of new technology. See Paragraph No. 3 of Booth's Affidavit I. Dr. Booth is a named inventor on at least three U.S. Patents in the technical field of razor cartridges: U.S. Patent No. 5,692,302 filed on May 22, 1995 and entitled "Razor Cartridges Comprising Wound Healing Compositions And Methods For Preparing And Using Same"; U.S. Patent No. 4,247,982 filed April 2, 1979 and entitled "Skin-flow Control Razor"; and U.S. Patent No. 4,170,821 filed

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December 2, 1977 and entitled "Razor Cartridges."

We are satisfied that Dr. Booth's background passes the threshold necessary for qualifying as an expert witness under Fed. R. Evid. 702, for the subject matter of the invention involved in this interference, generally identifiable as razor cartridges comprising a wear indicating strip which gives a visual indication of the relative wear of the shaving blade. The technology is not rocket science or extremely complicated. Dr. Booth may not be among the most qualified of all experts to testify about the invention, but he nonetheless qualifies. Tseng's argument about the lack of publications authored by Dr. Booth and his lack of awareness of recent razor cartridges on the market may diminish the persuasiveness of Dr. Booth's testimony but do not disqualify him as an expert witness under Fed. R. Evid. 702, in light of Dr. Booth's other qualifications. Note especially Dr. Booth's statement that "Up until the early 1990's, I kept abreast of Schick's razor products and patents directed to razor products, as well as products and patents of competitors, as part of my ongoing assignment to assist Warner Lambert in various activities regarding the litigation concerning U.S. Patent No. 4,170,821 entitled 'Razor cartridges.'"

Similarly, lack of citation to scholarly work is not a basis to suppress Dr. Booth's testimony. Dr. Booth may testify based

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on his own background and experience. We also reject Tseng's apparent position that any time the word "could" is used in Dr. Booth's testimony that testimony is by definition speculative. Whether an opinion is speculative depends on the basis for forming that opinion, and is not determined by whether the opinion is that something "could" happen.

Tseng's motion to suppress seeks to suppress those portions of Dr. Anthony R. Booth's Affidavit I and declaration which simply makes legal conclusions. However, the vast majority of the portions of Dr. Booth's testimony objected to by Tseng are not legal conclusions. Tseng appears to believe, erroneously, that any factual testimony whose purpose is to support an ultimate conclusion of law constitutes an improper legal conclusion. For instance, on page 16 of Tseng's motion to suppress, it is stated:

Booth's statements are not confined to technical factual issues over which Booth claims expertise.
Rather, Booth's technical factual assertions are made to support ultimate conclusions of law. (Emphasis added.)

While the ultimate question of claim scope is indisputably a conclusion of law, claim construction as a legal conclusion is based on numerous underlying factual inquiries, e.g., what do the claims say, what do the words mean to one with ordinary skill in the art, and what does the specification reveal, etc. Indeed,

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almost the entire exercise of claim construction is based on underlying factual inquiries until the very last step to make the ultimate conclusion of claim scope. An analogy can be drawn to the issue of obviousness. While obviousness is a question of law, it is based on four underlying factual inquiries (1) scope and content of the prior art; (2) differences between the claimed invention and the prior art; (3) level of ordinary skill in the art; and (4) secondary considerations of objective evidence of nonobviousness. The underlying factual inquiries are no less factual just because they are relied upon to make a legal determination on an ultimate issue of law.

Tseng mistakenly views Dr. Booth's testimony on what the Tseng claims and the Doroodian claims say, describe, disclose, or teach as testimony on an ultimate legal conclusion. What the claims say, describe, disclose, or teach is not the end of the game insofar as the ultimate question of claim construction is concerned. For instance, because of possible application of the principles of prosecution history estoppel, claim differentiation, or an unduly narrow or inconsistent specification, a claim's scope may not be the same as what the words of the claim say or teach to one with ordinary skill in the art. While a technical expert should not testify on the ultimate legal question of claim scope, his or her testimony with regard

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to how the words of a claim or specification would be understood or what they would describe, disclose, or teach, is appropriate.

To the extent that Dr. Booth gave mere conclusions on an ultimate legal question, Tseng's motion has not sufficiently identified them apart from proper testimony on underlying factual matters. In essence, Tseng's motion has lumped them all together as one. We decline to undertake the exercise on Tseng's behalf to separate out the true ultimate legal conclusions which may exist from the abundance of factual testimony by Dr. Booth. It suffices to say here only that to the extent that there is any testimony by Dr. Booth directly on the ultimate legal conclusion of claim scope or obviousness, we have given no weight to such testimony. Dr. Booth's testimony has been considered only insofar as it concerns the underlying factual issues on which claim construction or a determination of obviousness is based. Tseng's motion states that Dr. Booth impermissibly opines on the enablement and definiteness of Doroodian's claims. We have, however, not addressed the merits of Tseng's preliminary motions for judgment against Doroodian's claims.

For the foregoing reasons, insofar as the motion to suppress seeks to suppress the testimony of Dr. Anthony R. Booth on the ground that they improperly contain conclusions on questions of law, the motion is **denied**. To the extent that there is any such

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testimony from Dr. Anthony R. Booth, however, which gives an opinion on what is purely a legal conclusion or an ultimate question of law, we have given it no weight. With or without the testimony of Dr. Anthony R. Booth, we would have made the same legal conclusions. Note also Fed. R. Evid. 704(a) which states:

Except as provided in subdivision(b) [concerning the mental state of a defendant in a criminal case], testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact.

Conclusion

Doroodian's preliminary motion 1 alleging no interference-in-fact is **granted**.

Tseng's preliminary motion 1 to add claims is **denied**.

Tseng's claim 134 is unpatentable under 35 U.S.C. § 112, first and/or second paragraphs.

The principal brief requested in Section D of this opinion shall be filed no later than fourteen (14) days of the date of this communication, and the responsive brief within seven (7) days of the filing of the opposing party's principal brief.

Notwithstanding the request in Section D for further briefing, any request for reconsideration of the decision on Doroodian's preliminary motion 1, Tseng's preliminary motion 1, and the unpatentability holding of Tseng's claim 134 must be

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filed within the applicable time period specified in 37 CFR
§ 1.640(c), i.e., 14 days.

RICHARD E. SCHAFER)	
Administrative Patent Judge)	
)	
)	
JAMESON LEE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
RICHARD TORCZON)	
Administrative Patent Judge)	

Counsel for the Junior Party: Richard A. Inz, Fish & Neave

Counsel for the Senior party: Israel Blum, Morgan & Finnegan,
L.L.P.

**THE OPINION ENTERED TODAY IS NOT
BINDING PRECEDENT OF THE BOARD**

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Paper No. 91

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MINGCHIH M. TSENG

Junior Party
(Application 08/461,318)⁸,

v.

SIAMAK DOROODIAN-SHOJA

Senior Party
(Patent No. 5,388,331).⁹

Patent Interference No. 104,482

Before SCHAFFER, LEE and TORCZON, Administrative Patent Judges.
LEE, Administrative Patent Judge.

MEMORANDUM OPINION AND JUDGMENT

Introduction

On October 16, 2001, we issued a decision (Paper No. 85)

⁸ Filed on June 20, 1995. Accorded the benefit of application 08/269,495, filed July 1, 1994. The real party in interest is The Gillette Company.

⁹ Based on application 08/188,244, filed January 28, 1994. The real party in interest is Arthur D. Little Enterprises, Inc.

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granting senior party Doroodian's preliminary motion 1 asserting no interference-in-fact and denying junior party Tseng's preliminary motion 1 to add more claims to its involved application. On the subject of interference-in-fact, we found that Doroodian had shown that its involved claims are patentably distinct from the involved claims of Tseng. Thus, parties Doroodian and Tseng do not claim the same patentable invention.

Neither party has requested reconsideration of our decision of October 16, 2001.

In our decision, we also ordered parties Doroodian and Tseng to brief the issue of whether, in light of our holding of no interference-in-fact, we should reach Tseng's preliminary motions 2-5 for judgment against Doroodian's involved patent claims. The parties have each filed a principal brief and a reply brief.

Findings of Fact

Numbered findings 1-22 are contained in our decision of October 16, 2001. In this opinion, we begin with numbered finding 23.

23. Tseng's preliminary motion 2 is for judgment against Doroodian's patent claims 1-6 under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure.

24. Tseng's preliminary motion 3 is for judgment against Doroodian's patent claims 1-6 for indefiniteness under 35 U.S.C.

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§ 112, second paragraph.

25. Tseng's preliminary motion 4 is for judgment against Doroodian's patent claims 1-6 under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification.

26. Tseng's preliminary motion 5 for judgment against claims 1-6 of Doroodian's patent claims 1-6 as being unpatentable over prior art.

27. The prior art asserted by Tseng against Doroodian for anticipation under 35 U.S.C. § 102 are: (1) U.S. Patent No. 4,170,821 to Booth (against Doroodian's claim 1); (2) U.S. Patent No. 4,562,644 to Hitchens (against Doroodian's claims 1-4 and 6); (3) U.S. Patent No. 5,113,585 to Rogers et al. (against Doroodian's claims 1 and 2); and (4) Sensor[®] For Women cartridge (a commercial product, against Doroodian's claims 1 and 2).

28. The prior art asserted by Tseng against Doroodian for obviousness under 35 U.S.C. § 103 are: (1) U.S. Patent No. 3,879,844 to Griffith in view of U.S. Patent No. 2,703,451 to Hensel (against Doroodian's claims 1-6); (2) U.S. Patent No. 4,170,821 to Booth in view of U.S. Patent No. 2,703,451 to Hensel (against Doroodian's claims 1-6); (3) U.S. Patent No. 4,562,644 to Hitchens in view of U.S. Patent No. 2,703,451 to Hensel (against Doroodian's claims 1-6); (4) U.S. Patent No. 5,113,585 to Rogers et al. in view of U.S. patent No. 2,703,451 to Hensel

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(against Doroodian's claims 1-6); and (5) Sensor[®] For Women in view of U.S. Patent No. 2,703,451 to Hensel (against Doroodian's claims 1-6).

29. Tseng's preliminary motion 5 is entitled: "TSENG CONTINGENT PRELIMINARY MOTION 5" and states the following:

This motion only need be considered if Doroodian's anticipated motions based on no interference-in-fact and 35 U.S.C. § 135(b), as well as Tseng Preliminary Motions 2, 3 and 4 (based on invalidity under 35 U.S.C. § 112, first and second paragraphs), are all denied. In that event, Tseng requests consideration of this motion.

30. In its principal brief (Paper No. 86), party Tseng withdrew its still pending preliminary motions 2-4.

31. The only preliminary motion of party Tseng which still remains pending is Tseng's contingent preliminary motion 5.

Discussion

Party Tseng's preliminary motion 5 is contingent on a number of circumstances including the denial of Doroodian's preliminary motion 1 asserting no interference-in-fact. In Paper No. 85, however, we granted Doroodian's preliminary motion 1 asserting no interference-in-fact. Therefore, the condition triggering consideration of Tseng's preliminary motion 5 did not occur. Accordingly, Tseng's preliminary motion 5 is hereby **dismissed**.

The parties should note that if our holding of no

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interference-in-fact is reversed upon judicial review, then the contingencies triggering consideration of Tseng's preliminary motion 5 will have to be reassessed upon return of the case to the board subsequent to judicial review.

Party Tseng has withdrawn its preliminary motions 2-4 (Finding 30). Consequently, those preliminary motions are no longer before us for consideration.

It is no longer necessary to decide whether, given our conclusion of no interference-in-fact, Tseng's preliminary motions 2-5 should be decided. Because any final hearing on issues decided by a 3-judge panel would be in the nature of a request for reconsideration, Charlton v. Rosenstein, No. 104,148, 2000 Pat. App. Lexis 4 (Bd. Pat. App. & Int. (Trial Section) 2000), and because neither party has requested reconsideration of our decision of October 16, 2001, we designate the panel decision of October 16, 2001 as final for purposes of judicial review.¹⁰

Judgment

¹⁰ We recognize that Doroodian had filed a preliminary motion 2 for judgment against Tseng's claims based on late claiming under 35 U.S.C. § 135(b). The basis for relief under 35 U.S.C. § 135(b) is premised upon the same subject matter being claimed by both parties Doroodian and Tseng. Our decision granting Doroodian's preliminary motion 1 asserting no interference-in-fact implicitly disposed of the preliminary motion under 35 U.S.C. § 135(b). For the sake of clarity, Doroodian's preliminary motion 2 is herein **dismissed**.

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It is

ORDERED that judgment as to the subject matter of the count is herein entered in favor of both junior party MINGCHIH M. TSENG and senior party SIAMAK DOROODIAN-SHOJA;

FURTHER ORDERED that on this record, junior party MINGCHIH M. TSENG is entitled to a patent containing its application claims 113, 117-123, 130-133, 135 and 136, but not application claim 134, which correspond to the count;

FURTHER ORDERED that on this record, senior party SIAMAK DOROODIAN-SHOJA is entitled to a patent containing its claims 1-6 which correspond to the count;

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661; and

FURTHER ORDERED that a copy of this judgment will be entered as a paper in each party's involved application or patent.

RICHARD E. SCHAFFER)	
Administrative Patent Judge)	
)	
)	
JAMESON LEE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
RICHARD TORCZON)	
Administrative Patent Judge)	

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Counsel for the Junior Party: Richard A. Inz, Esq., Fish & Neave.

Counsel for the senior party: Israel Blum, Esq., Morgan &
Finnegan, L.L.P.