

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

EDWARD H. **KILDUFF**,
CHI MING TSE,
GARETH BROWN, AND CHI FAI CHEUNG,
JUNIOR PARTY
(APPLICATION 14/156,360)

v.

DAVID A. **HOLCOMB**
AND
ADAM A. JOSSEM,
SENIOR PARTY
(PATENT 8,353,474).

Patent Interference 106,116 (SGL)
(Technology Center 3600)

Before: SALLY GARDNER LANE, JAMES T. MOORE, and DEBORAH KATZ,
Administrative Patent Judges.

LANE, *Administrative Patent Judge.*

JUDGMENT - Bd. R. 127(a)

1 A decision granting Motion 1 of David A. Holcomb and Adam A. Jossem
2 (“Holcomb”) has been entered. (Decision, Paper 42). As a result of this Decision,
3 all the involved claims of junior party Edward H. Kilduff, Chi Ming Tse, Gareth
4 Brown, and Chi Fai Cheung (“Kilduff”) are unpatentable to Kilduff and Kilduff
5 lacks standing to continue in the interference. Bd. R. 201. Accordingly, we enter
6 judgment against Kilduff.

7 Order

8 It is

9 ORDERED that judgment on priority is entered against junior party Kilduff
10 as to Count 1, the sole Count of the interference (Declaration, Paper 1, 4);

11 FURTHER ORDERED that claims 1-12, 14-16, and 19-25 of Kilduff
12 application 14/156,360, which correspond to Count 1, are FINALLY REFUSED.
13 (Declaration, Paper 1, 4); 35 U.S.C. § 135(a);¹

14 FURTHER ORDERED that the parties are directed to 35 USC § 135(c) and
15 Bd. R. 205 regarding the filing of settlement agreements;

16 FURTHER ORDERED that a party seeking judicial review timely serve
17 notice on the Director of the United States Patent and Trademark Office;
18 37 C.F.R. §§ 90.1 and 104.2. *See also* Bd. R. 8(b); and

19 FURTHER ORDERED that a copy of this judgment be entered into the
20 administrative records of the involved Kilduff application and Holcomb patent.

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1 Any reference to a statute in this Judgment is to the statute that was in effect
on March 15, 2013 unless otherwise indicated. See Pub. L. 112-29, § 3(n), 125 Stat.
284, 293 (2011).

cc (via electronic delivery):

Attorney for Kiduff:

Thomas J. Brindisi
LAW OFFICE OF THOMAS J. BRINDISAI
tom@keyip.law

Michael J. Wise
Joseph P. Hamilton
PERKINS COIE
mwise@perkinscoie.com
jhamilton@perkinscoie.com

Attorney for Holcomb:

Steven W. Parmelee
Richard Torczon
Tasha Thomas
WILSON SONSINI GOODRICH & ROSATI
sparmelee@wsgr.com
rtorczon@wsgr.com
tthomas@wsgr.com

BoxInterferences@uspto.gov
Tel: 571-272-9797

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LANE, *Administrative Patent Judge.*

Decision - Motions - 37 C.F.R. § 41.125

1 I. INTRODUCTION

2 We have a single motion before us for decision, Holcomb Motion 1
3 (Holcomb Motion 1, Paper 24). In that motion, senior party David A. Holcomb
4 and Adam A. Jossen (“Holcomb”)¹ move for judgment against junior party Edward
5 H. Kilduff, Chi Ming Tse, Gareth Brown, and Chi Fai Cheung (“Kilduff”)² on the
6 basis that all the Kilduff claims are unpatentable for failure to comply with the
7 written description requirement of the first paragraph of 35 U.S.C. §112. Kilduff
8 opposed the motion. (Kilduff Opposition 1, Paper 36). Holcomb replied.
9 (Holcomb Reply 1, Paper 37). Holcomb Motion 1 raises a threshold issue, that is
10 “an issue that, if resolved in favor of the movant, would deprive the opponent of
11 standing in the interference [and] may include... [u]npatentability for lack of
12 written description...where an applicant suggested, or could have suggested, an
13 interference under §41.202(a)” Bd. R. 201.

14 We GRANT Holcomb Motion 1.³

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16 II. DISCUSSION

17 Kilduff is involved on the basis of its application 14/156,360, filed January
18 15, 2014. (’360 application, Ex. 1004). During prosecution of the ’360
19 application, Kilduff suggested the interference and copied claims from what is now

¹ Holcomb identifies its real party in interest as Chef’n Corporation, which is said to be a wholly owned subsidiary of Lifetime Brands, Inc. (Holcomb Real Party Notice, Paper 5).

² Kilduff identifies its real party in interest as Enrico Dalla Piazza. (Kilduff Real Party Notice, Paper 10).

³ Kilduff requested oral argument. (Kilduff Request, Paper 41). Holcomb requested that there be no oral argument. (Holcomb Request, Paper 40). We see no need for oral argument on the motion before us and none was ordered.

1 Holcomb’s involved patent, i.e., 8,353,474 (’474) (Ex. 1001). (HMF⁴s 1, 2,
2 admitted by Kilduff; ’360 Response, Ex. 1006).

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Legal Principles

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The evidence supports any findings of fact in this Decision by a preponderance of the evidence. As the moving party, Holcomb has the burden of proof and must support its motion with appropriate evidence such that, if unrebutted, it would justify the relief sought. Bd. R. 208(b).

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In evaluating written description we consider whether the disclosure of the application reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991).

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We give claims their broadest reasonable interpretation by considering not only the claim language but also how one skilled in the art would understand the claim in view of the specification. *Phillips v. AWH*, 415 F.3d 1303, 1316, (Fed. Cir. 2005). Because the Holcomb ’474 specification is the originating one, for purposes of evaluating written description, we construe Kilduff’s involved claims in view of the Holcomb ’474 specification. *Agilent v. Affymetrix, Inc* 567 F.3d 1366, 1375 (Fed. Cir. 2009). (“...where the PTO must assess whether both parties have a right to claim the same subject matter, the claim construction analysis properly occurs in the context of the specification from which the claims were copied.”)

23

Holcomb urges that construction of the Kilduff claims requires the

⁴ Holcomb statement of material fact. The statements are found at Appendix 2 of Holcomb Motion 1. Kilduff’s responses are found at Appendix 2 of Kilduff Opposition 1.

1 application of 35 U.S.C. 112(f).⁵ Where the Kilduff claims contain a limitation
2 expressed as a means or step for performing a specified function without reciting
3 the structure, material, or act in support of the function we must construe the
4 limitation to cover the corresponding structure, material, or act described in the
5 specification, and equivalents thereof. 35 USC §112(f). Ordinarily we are required
6 to construe a means plus function limitation within the Kilduff claims as covering
7 the corresponding structure found in the Kilduff specification containing that
8 claim. 35 USC §112(f). Given the holding of *Agilent* though, for written
9 description purposes only, here we must construe any means plus function
10 limitation in view of the Holcomb specification. That is, because each claim
11 Kilduff presented was copied from Holcomb, i.e., from a claim that originated
12 from the Holcomb specification, we are in essence construing a Holcomb claim
13 and considering whether the Kilduff specification provides written description
14 support for such a claim. *Agilent*, 567 F.3d at 1375.

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16 *The Kilduff claims*

17 Claim 1 of Kilduff, reproduced below, is illustrative of the Kilduff claims.

- 18 1. A device for use with food items, comprising:
19 an assembly including a bowl and a lid formed to mate with the
20 bowl, the lid defining a handle axis of rotation, the bowl defining a
21 holding area;
22 a handle mechanism pivotally coupled to the lid and rotatable
23 about the handle axis of rotation;
24 an inner member rotatable about an inner member axis of
25 rotation to spin food items, if any, in the holding area, the inner
26 member axis of rotation being non-parallel with and spaced apart from
27 the handle axis of rotation; and
28 a drive-train configured to rotate the inner member and
29 including a *slidable member*, the *slidable member* being movable

⁵ 35 USC § 112(f) is also referred to as 35 USC § 112(6).

1 along at least a portion of the lid when the handle mechanism is
2 rotated about the handle axis of rotation.

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4 (Kilduff Clean Copy of Claims, Paper 12, relevant limitation italicized).

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6 This claim is directed towards a device for spinning items to take advantage
7 of centrifugal force, e.g., drying lettuce by spinning it to expel water. ('360
8 application, Ex. 1004, ¶2; See also Ex. '474 patent, Ex. 1001, 1:65–2:7 and 2:60–
9 67).

10 *Summary of parties' arguments*

11 Holcomb contends that Kilduff lacks written description for the “slidable
12 member” limitation of the Kilduff claims. (Holcomb Motion 1, Paper 24, 2:6-12).
13 The parties agree that this limitation is a means plus function one and, as a copied
14 limitation, it therefore must be construed in view of the Holcomb specification.
15 (Kilduff Opposition 1, Paper 36, 2:9-12). Holcomb asserts that both “slider 190”
16 and “slider 560”, described and illustrated in its specification, are the structures
17 that correspond to the “slidable member” limitation. (Holcomb Motion 1, Paper
18 24, 8:1-12:10). Kilduff does not dispute that “slider 190” is a corresponding
19 structure or that its specification does not describe such a structure or an equivalent
20 one. Kilduff disagrees that Holcomb has shown “slider 560” to be a corresponding
21 structure. (Kilduff Opposition 1, Paper 36, 4:11-5:7). Further Kilduff argues that
22 Holcomb did not meet its burden of proof to show that Kilduff does not describe
23 the “slidable member” by describing an equivalent structure to “slider 560”.
24 Kilduff asserts that, for example, Holcomb did not show why either “rack 72” or
25 “cog 44”, shown in the Kilduff specification, is not an equivalent structure to
26 “slider 560”. (Kilduff Opposition 1, Paper 36, 7:1-8:17).

1 *Means plus function determination*

2 Each of the Kilduff independent claims, i.e., claims 14-16, 19, and 20 recite
3 “[a] device for use with food items” having a “drive train” that includes a “slidable
4 member”. (HMFs 7, 8, admitted by Kilduff; Kilduff Clean Copy of Claims, Paper
5 12). Because the “slidable member” limitation does not use the word “means”
6 there is a presumption that §112(f) does not apply. However, “[w]hen a claim term
7 lacks the word ‘means,’ the presumption can be overcome and § 112, para. 6 will
8 apply if the challenger demonstrates that the claim term fails to ‘recite sufficiently
9 definite structure’ or else recites ‘function without reciting sufficient structure for
10 performing that function.’”. *Diebold Nixdorf, Inc. v. International Trade*
11 *Commission*, 899 F.3d at 1298, citing *Williamson v. Citrix Online, LLC*, 792 F.3d
12 1339. 1348-49 (Fed. Cir. 2015).

13 Holcomb argues that, in each of the Kilduff involved claims, “slidable
14 member” should be construed as a means plus function limitation. (Holcomb
15 Motion 1, Paper 24, 3:18-4:13). Holcomb directs us to the declaration testimony
16 of Dr. Glenn E. Vallee.⁶ Dr. Vallee’s testimony supports Holcomb’s argument.
17 For example, Dr. Vallee opined that the term “slidable member” as used in the
18 Kilduff claims would not have been considered by one skilled in the art to be a
19 term of art that is associated with a sufficiently definite structure. Dr. Vallee
20 testified that instead one skilled in the art⁷ would have viewed the term as a generic

⁶ We have reviewed Dr. Vallee’s credentials and find Dr. Vallee qualified to testify regarding the technical issues arising in this interference. (Vallee Declaration, Ex. 1002, ¶¶ 1-5; *Curriculum vitae*, Ex. 1003).

⁷ Dr. Vallee’s testimony regarding the level of skill in the art at the relevant time is not disputed by Kilduff. A person having ordinary skill in the art is presumed to know the relevant prior art. *In re GPAC*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). We accept Dr. Vallee’s testimony that such a person may have the education, training, and experience in the field that Dr. Vallee describes. (Vallee Declaration, Ex. 1002, ¶¶ 11-13).

1 description of a component’s function, i.e., as a component that is capable of being
2 moved along a surface to cause movement of another component within the same
3 device. Further Dr. Vallee’s testimony explains, as to each independent Kilduff
4 claim, why he is of the opinion that the Kilduff claims do not recite additional
5 limitations that a person of ordinary skill would have understood as providing
6 sufficiently definite structure for performing the claimed function. (Vallee
7 Declaration, Ex. 1002, ¶¶ 21-29).

8 Kilduff does not dispute that the term “slidable member” is a means plus
9 function limitation that should be construed to cover the corresponding structures
10 described in Holcomb’s specification and equivalents thereof. (Kilduff Opposition
11 1, Paper 36, 2:9-12). Kilduff did not opt to cross-examine Dr. Vallee or present its
12 own expert testimony.

13 The evidence before us, which includes Dr. Vallee’s unchallenged testimony
14 concerning the underlying structures, establishes that one skilled in the art would
15 have considered the claim term “slidable member” to recite function without
16 reciting sufficient structure for performing that function. Accordingly, the
17 presumption created by the lack of the use of “means” language is rebutted and we
18 must construe the term “slidable member” as a means plus function limitation. As
19 required by 35 USC §112(f), we construe the limitation “slidable member” to
20 cover the corresponding, structure, material, or acts described in the specification
21 and equivalents thereof for that limitation.

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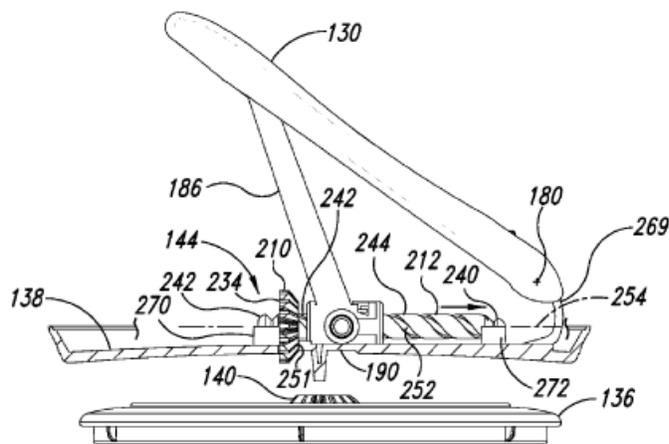
23 *Written Description -Corresponding structure*

24 Holcomb asserts that its specification describes “food processing systems for
25 drying, grinding, milling, dispensing, or otherwise processing” food, and in
26 particular, the systems incorporating manual drive mechanisms, containing, *inter*
27 *alia*, a “slidable member”, for spinning a tool, such as a perforated basket.

1 Holcomb urges that one skilled in the art would have understood the function of
2 the claimed “slidable member” to be movement for causing rotation of another
3 component. Holcomb asserts that its specification describes two corresponding
4 structures of a “slidable member” that perform this function, i.e. “slider 190 and
5 slider 560”. (Holcomb Motion 1, 11:10-14; Vallee Declaration, Ex. 1002, ¶ 39).

6 According to Holcomb and Dr. Vallee, the specification provides for three
7 embodiments of a food processing system, two of which use the same drive
8 mechanisms for spinning the tool and contains “slider 190”. A third embodiment
9 uses a different drive mechanism for spinning the tool and contains “slider 560”.
10 (Holcomb Motion 1, Paper 24, 7:18-24, citing ’474, Ex. 1001, Abstract; Vallee
11 Declaration, Ex. 1002, ¶ 32).

12 Slider 190 is shown at Figure 6, reproduced below:
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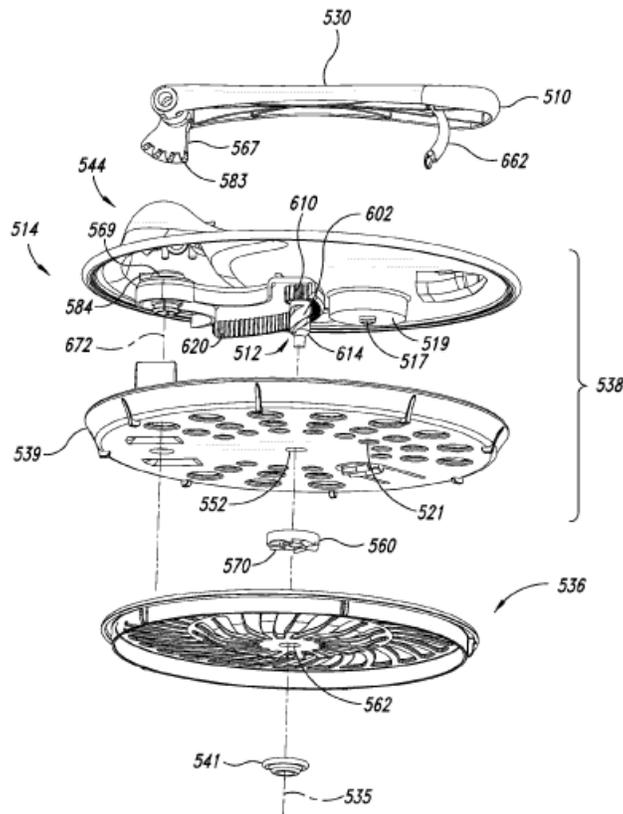


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15 Above is Figure 6 of Holcomb’s ’474 patent.
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17 According to Holcomb, relying upon Dr. Vallee’s description, in this first
18 corresponding structure, “slider 190 moves linearly along the elongated member
19 212 (a worm screw) and toward the outer periphery of the main body 106 when the
20 lever 130 is pressed downward from its open position, which causes the elongated

1 member 212 and the inner container 122 to rotate.” Dr. Vallee further explains that
2 when lever 130 returns to its open position, “slider 190” moves back along the
3 elongated member in a linear direction and toward the center of main body 106.
4 (Holcomb Motion 1, Paper 24, 11:21-12:3, citing Vallee Declaration, Ex. 1002,
5 ¶ 41; HMFs 70, 71, admitted by Kilduff).

6 Slider 560 is shown at Figure 30 of Holcomb, reproduced below:



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Above is Figure 30 of Holcomb's '474 patent.

10 As to slider 560, Holcomb asserts, and Dr. Vallee testifies, that in this
11 second corresponding structure, “when the lever 530 is pressed downward from its
12 open position, a spur gear rotates the elongated member 614 to cause the slider 560
13 to rotate and move linearly along the elongated member 614 to rotate the inner
14 cover 536”. Dr. Vallee goes on to explain that “[w]hen the lever 530 returns to its

1 open position, the spur gear rotates the elongated member 614 in the opposite
2 direction, causing the slider 560 to rotate and move linearly along the elongated
3 member 614 away from the inner cover 536.” (Holcomb Motion 1, Paper 24, 12:4-
4 10, citing Vallee Declaration, Ex. 1002, ¶ 42).

5 Holcomb characterizes both sliders as having the same general structure of a
6 sleeve with a bore through which a threaded member or screw extends. Relying
7 upon Dr. Vallee’s testimony for support, Holcomb explains that “the sleeve is
8 threadedly connected to the screw (via, for example, a tooth that rides within the
9 helical groove of the screw) such that the sleeve acts as a nut capable of rotating
10 relative to and linearly along the screw, ultimately causing rotation of a tool or
11 inner container or basket.” (Holcomb Motion 1, Paper 24, 11:15-20, citing Vallee
12 Declaration, Ex. 1002, ¶ 40; ’474, Ex. 1001, 5:23-27, 5:30-35; 7:38-42).

13 According to Holcomb and Dr. Vallee, Kilduff “slider 190” corresponds to
14 the functions of claims 1, 14, 16, 19, and 20, and “slider 560” corresponds to the
15 functions of claims 1, 14, 15, and 20. (Holcomb Motion 1, Paper 24, 12:2-3, 9-10;
16 citing Vallee Declaration, Ex. 1002, ¶¶ 72, 75).⁸

17 Kilduff agrees that the “slider 190” performs the function of the “slidable”
18 member” and that “slider 190” is a corresponding structure.⁹

⁸ In discussing each claim Holcomb notes that dependent claim 11 of Kilduff, which depends from claims 1 and 10, recites some structure providing that the “slidable member” ... “comprises at least one tooth positioned to engage [a] gear member.” However, Holcomb urges, and Kilduff does not dispute, that this structure only serves to further limit the corresponding structure to one having a tooth for engaging the gear member to cause rotation, which is consistent with the “slider 190” described in Holcomb’s specification. (Holcomb Motion 1, Paper 24, 12:11-20; citing Vallee Declaration, Ex. 1002, ¶ 43; HMFs 76, 78, admitted by Kilduff).

⁹ In its Reply 1, Holcomb notes that Kilduff only contests whether “slider 560” is also a corresponding structure such that even if correct (i.e., slider 560 is

1 However, Kilduff does not agree that Holcomb has shown “slider 560” to be
2 a corresponding structure. Kilduff argues that Holcomb does not explain why it
3 does not expressly assert that “slider 560” is a corresponding structure for the
4 “slidable member” of independent claims 16 and 19 while asserting this structure
5 for generic claim 1. (Kilduff Opposition 1, Paper 36, 5:5-7). Despite this
6 assertion, we agree with Holcomb’s explanation, which relies upon Dr. Vallee’s
7 testimony, that the sliding movement of “slider 560” itself is not “linearly movable
8 away from the basket axis of rotation” (claim 16) and does not “cause[] rotation of
9 [a] gear member” (claim 19) so is not encompassed by the claims have these
10 further limitations. (Holcomb Motion 1, Paper 24, 5:10-6:6; *See also* Holcomb
11 Reply 1, Paper 37, 4, fn.2).

12 Further, Kilduff asserts that “slider 560” is not a corresponding structure
13 since it “causes *engagement* with-not motion or rotation of-another component.”
14 (Kilduff Opposition 1, Paper 36, 4:15-5:7). In its Reply, Holcomb points to Dr.
15 Vallee’s testimony explaining that “slider 190” and “slider 560” differ as to how
16 the inner basket is ultimately caused to rotate due to the sliders’ performing their
17 common sliding function but that both cause rotation of another component. As
18 Holcomb notes, Dr. Vallee discussed that the sliding movement of “slider 190”
19 causes rotation of elongate member 212 and gear 234, which engages and rotates
20 inner cover 136 of inner container 120. Dr. Valle explained that the sliding
21 movement of “slider 560” causes engagement of the teeth of the slider 570 with the
22 inner cover 536 to cause rotation of the inner cover. (Holcomb Reply 1, Paper 37,
23 4:1-5:4; Vallee Declaration, 1002, ¶¶ 34-35, 42; HMF 67, admitted by Kilduff).

not a corresponding structure), its claims necessarily lack written description for the claimed “slidable member” because, as Kilduff concedes, its specification does not describe the only agreed-upon structure that corresponds to the term (i.e., slider 190) or any of its equivalents. (Holcomb Reply 1, Paper 37, 2:13-20).

1 We are convinced upon weighing the evidence before us that one skilled in
2 the art would have understood the function of both “slider 190” and “slider 560” to
3 be that of the claimed “slidable member”, i.e., to be movement for causing rotation
4 of another component. Further we find convincing Dr. Vallee’s testimony in that it
5 explains why both “slider 190” and “slider 560” are structures which correspond to
6 the function of movement for causing rotation of another component.

7
8 *Kilduff’s Written Description*

9 35 USC §112(f) requires that we construe a means plus function limitation
10 as covering both the corresponding structure and its equivalents. Two structures
11 are equivalent if they perform the claimed function in substantially the same way
12 with substantially the same result. *Kemco Sales, Inc. v. Control Papers Co.*, 208
13 F.3d 1352, 1364 (Fed. Cir. 2000).

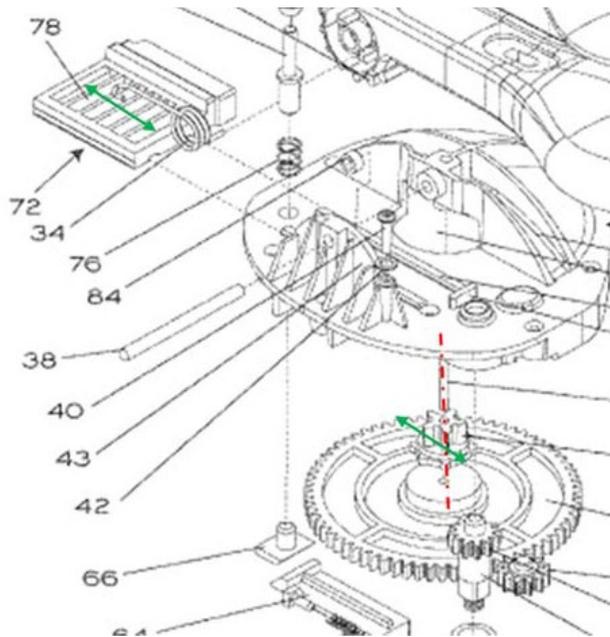
14 Holcomb asserts that Kilduff does not describe the corresponding structure
15 for, nor an equivalent of, a “slidable member” as that term is construed in view of
16 the Holcomb specification. Dr. Vallee testified to his opinion that “Kilduff does
17 not describe the corresponding structure or its equivalent for the term ‘slidable
18 member’”, referred to by Holcomb as a nut-screw structure, i.e., “a sleeve or nut
19 threadedly connected to a screw for rotating relative to and moving linearly along
20 the screw to cause rotation of an inner member or basket”. Dr. Vallee also opined
21 that a person of ordinary skill would have immediately recognized that, rather than
22 describing this nut-screw structure for performing the claimed sliding function,
23 Kilduff describes an entirely different type of structure, i.e., a rack-and-pinion
24 structure. (Holcomb Motion 1, Paper 24, 13:8-11; Vallee Declaration, Ex. 1002,
25 ¶¶ 40, 47, 48).

26 In addition to his general consideration of the Kilduff specification and
27 whether equivalents are described, Dr. Vallee specifically analyzed whether “rack

1 72” of the Kilduff specification, the structure that Kilduff has on multiple
2 occasions asserted corresponds to the “slidable member” limitation, is an
3 equivalent structure. (Holcomb Motion 1, Paper 24, 13:8-14:2; citing Vallee
4 Declaration, Ex. 1002, ¶ 48; Kilduff annotated claims, Paper 13 (identifying “72”
5 of Figures 3 and 7 as the “slidable member”; Kilduff Suggestion of Interference,
6 Ex. 1005, 2, 27, 29, 33-34, 36; Appeal Brief, Ex. 1007, 19).

7 Holcomb argues that a person of ordinary skill would have understood the
8 Kilduff specification to identify the structure that causes rotation to be a “rack 72”.
9 Holcomb asserts, and Kilduff agrees, that “rack 72” is described as having a rack
10 and pinion structure. (HMFs 97, 99, admitted by Kilduff). Dr. Vallee opines that
11 the rack and pinion structure is substantially different from the nut and screw
12 structure shown at “slider 190” and “slider 560”. (Holcomb Motion 1, Paper 24,
13 13:12-15, citing Vallee Declaration, Ex.1002, ¶ 48; ’360 application, Ex. 1004, ¶7).

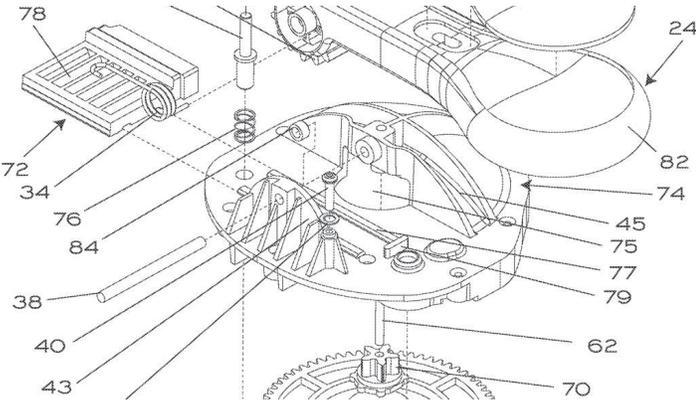
14 Below is a partially-reproduced, annotated version of Kilduff Figure 7 which
15 Dr. Vallee discusses in his testimony:
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18 Above is a partially-reproduced, annotated version of Kilduff Figure 7.

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Because this partial annotated version omits identifying information for some structures referred to in Dr. Vallee’s testimony, we reproduce below that part of Figure 7 having this information:



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Above is a partially-reproduced, unannotated version of Kilduff Figure 7.

10 Dr. Vallee explains that in the Kilduff structure, “rack 72 moves linearly
11 along tracks 77 provided on top of the gear housing 74, which causes the pinion 70
12 to rotate about an axis of rotation indicated by the dashed red line [and] [b]ecause
13 the rack 72 moves linearly along tracks 77, the rack 72 applies a force in the
14 direction of its movement (as indicated by the green double-arrow) to the ends of
15 the pinion teeth to cause it to rotate.” Dr. Holcomb opined that, unlike the slider of
16 Holcomb, the direction of the motion of the rack and the axis of the pinion’s
17 rotation are perpendicular to one another. (Vallee Declaration, Ex. 1002, ¶ 51).
18 Dr. Vallee testified that, given this substantial difference between the design of the
19 Holcomb corresponding structure and that of Kilduff, the person of ordinary skill
20 would not have viewed Kilduff’s “rack 72” to be an equivalent structure to the
21 corresponding structure identified in Holcomb because the rack performs its

1 function in a substantially different way than the slider of Holcomb. (Holcomb
2 Motion 1, Paper 24, 14:3-10; citing Vallee Declaration, Ex. 1002, ¶¶ 49, 51; HMF
3 89, admitted by Kilduff). Dr. Vallee opined further that “[a] person of ordinary
4 skill would have considered this difference to be significant because the design
5 would involve materially different considerations [such as] rather than analyzing
6 the effects of compressive loading, the person of ordinary skill would have
7 understood that this type of implementation would require analysis into the effects
8 of the bending loads caused by the force applied by the rack to the pinion’s teeth.”
9 According to Dr. Vallee, one skilled in the art would have understood that this
10 would necessarily involve completely different equations for determining the loads
11 and stress that the structures would undergo given the particular design. (Vallee
12 Declaration, Ex. 1002, ¶ 51).

13 Kilduff agrees that “rack 72” is not a corresponding structure or equivalent
14 to “slider 190”. (Kilduff Opposition 1, Paper 36, 4:4-6). Kilduff argues however
15 than Holcomb did not provide a detailed analysis of why “rack 72” is not an
16 equivalent structure to Holcomb’s “slider 560”.

17 In his testimony, Dr. Vallee’s used annotated “slider 190” to illustrate
18 engineering considerations that would be involved in the design of the nut and
19 screw structures found in both sliders 190 and 560. While Kilduff does not take
20 issue with Dr. Vallee’s opinions regarding “slider 190”, Kilduff does not agree
21 with Dr. Vallee’s testimony regarding the engineering factors that a person of
22 ordinary skill would have considered in the design of sliding structures like those
23 of “slider 560”. In particular Kilduff does not agree that, with respect to “slider
24 560”, one skilled in the art would have analyzed the effects of compressive loading
25 because “slider 560 does not cause elongated member 614 to rotate, nor does it
26 apply an axial force to...the elongated member”, but rather is rotated by the

1 elongated member and transfers its load radially unlike “slider 190’.” (Kilduff
2 Opposition, 1 Paper 36, 8:8-17).

3 Here we credit the testimony of Dr. Vallee, whom we find to be qualified to
4 testify about the technical issues involved in engineering the claimed invention. In
5 his testimony Dr. Vallee, using annotated slider 190 as an illustrative example,
6 described the common structural features that performed the core “sliding”
7 function (i.e., nut-screw interaction) of the corresponding structures, and explained
8 the key engineering considerations that would be involved in the design of such a
9 common structure (e.g., compressive loading). Dr. Vallee’s testimony is based on
10 a review of the record, including the parties’ specifications, and his knowledge of
11 the art. (Vallee Declaration, Ex. 1002, Table 1, ¶¶ 1-5; *Curriculum vitae*, Ex.
12 1003). We find the testimony convincing. Kilduff did not choose to cross-
13 examine Dr. Vallee, present expert testimony in support of its position, and
14 otherwise has not directed us to evidence sufficient to show that one skilled in the
15 art, upon considering the Holcomb specification, would have had a different
16 opinion than Dr. Vallee.

17 In its Opposition Kilduff also points to “cog 44” as a possible equivalent
18 structure to “slider 560”. (Kilduff Opposition, 1 Paper 36, 7:13-22). Dr. Vallee
19 testified that he considered the Kilduff specification, which includes the structure
20 “cog 44”, and determined that it did not describe equivalents to either “slider 190”
21 or “slider 560”. (Vallee Declaration, Ex. 1002, ¶¶ 7, 46, 47; Table 1). We find it
22 reasonable that Dr. Vallee focused on “rack 72” and not “cog 44” in providing his
23 analysis since, as we note above, Kilduff identified “rack 72” as corresponding to
24 the “slidable member” limitation in the suggestions of interference, in its annotated
25 claims, and in prior briefing before the Board. (Kilduff annotated claims, Paper 13
26 (identifying “72” of Figures 3 and 7 as the “slidable member”; Kilduff Suggestion
27 of Interference, Ex. 1005, 2, 27, 29, 33-34, 36; Appeal Brief, Ex. 1007, 19).

1 Further, Kilduff has not directed us to evidence, such as testimony from one
2 skilled in the art, to show that “cog 44” would have been considered by one skilled
3 in the art to be an equivalent to “slider 560”. We do not consider attorney
4 argument to be evidence. *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595
5 (Fed. Cir. 1997).

6 For reasons stated above, Holcomb’s arguments and Dr. Vallee’s supporting
7 testimony show that Kilduff does not describe the corresponding structures for the
8 “slidable member” limitation or any structure that is equivalent to these
9 corresponding structures.

10 We are convinced, upon considering the arguments and weighing the
11 evidence before us, that Holcomb has shown that the disclosure of the Kilduff
12 involved application did not reasonably convey to those skilled in the art that the
13 Kilduff inventors had possession of the claimed subject matter at filing.

14 We have considered all other arguments presented by Kilduff in its briefing
15 opposing Holcomb Motion 1, even if not specifically discussed, but do not find
16 those arguments convincing.

17
18 III. CONCLUSION

19 Because we grant Holcomb Motion 1 and find the Kilduff claims to lack
20 written description support, Kilduff lacks standing to continue in this interference.
21 Bd.R. 201. Accordingly, we enter judgment against Kilduff in a separate paper.
22

1 IV. ORDER
2 It is
3 ORDERED that Holcomb Motion 1 is GRANTED; and
4 FURTHER ORDERED that judgment against Kilduff will be entered
5 in a separate paper.
6

cc (via electronic delivery):

Attorney for Kilduff:

Thomas J. Brindisi
LAW OFFICE OF THOMAS J. BRINDISAI
tom@keyip.law

Michael J. Wise
Joseph P. Hamilton
PERKINS COIE
mwise@perkinscoie.com
jhamilton@perkinscoie.com

Attorney for Holcomb:

Steven W. Parmelee
Richard Torczon
Tasha Thomas
WILSON SONSINI GOODRICH & ROSATI
sparmelee@wsgr.com
rtorczon@wsgr.com
tthomas@wsgr.com