Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

STEPHEN J. DAVIS (ON BEHALF OF HIMSELF AND LAWRENCE P. MONTE), JUNIOR PARTY
v.
ALAN K. UKE AND LAWRENCE P. MONTY, SENIOR PARTY
Interference No. 102,751
January 12, 1993

Robert B. Smith, Esq.

***1** WHITE & CASE

Carl R. Brown

BROWN, MARTIN, HALLER & McCLAIN

Douglas B. Comer

Acting Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND ORDER

The Junior Party and the Senior Party jointly petition for waiver of requirements of the rules (Paper No. 22). See 37 CFR § 1.183 and 37 CFR § 1.644(a)(3). For the reasons hereinafter given, the petition will be denied.

Background

1. The Uke/Monty patent

Application 07/339,689 was filed on April 18, 1989, naming Alan K. Uke as a sole inventor. On July 14, 1989, a request to correct the inventorship was filed in which Uke asked that the inventorship be changed to name Uke and Lawrence P. Monty as joint inventors. A Rule 63 (37 CFR § 1.63) declaration signed by both Uke and Monty accompanied the request.

According to a declaration signed by Uke which accompanied the request:

2. During preparation of this application, strong emphasis was placed on obtaining a filing date as soon as was practical prior to a scheduled meeting with customers in which specific details of the invention were to be disclosed.

3. In the process of providing full and complete disclosure of the subject matter of the invention in as short a time as possible, a thorough analysis of inventorship was not completed.[[FN1]]

4. Shortly subsequent to the filing of this application, a thorough analysis of the inventorship issuance [sic--issue] was undertaken. It

was at this time realized that a co-inventor had been inadvertently omitted from the application. Specifically, it was realized that LAWRENCE P. MONTY was the omitted inventor and he would have to be added as such to the application. [[FN2]]

Uke's request to change inventorship was granted. The application issued as U.S. Patent No. 4,953,862 on September 4, 1990, and names Uke and Monty as inventors. The assignment records of the Patent and Trademark Office (PTO) show that Monty assigned his interest in the application to Uke. Accordingly, Uke appears to be the sole owner of the patent.

2. The Davis/Monty application

Application 07/373,331 was filed on June 29, 1989, naming Stephen J. Davis and Lawrence P. Monty as joint inventors. Monty is the same Monty named as an inventor in the Uke/Monty patent. The application was filed under 35 U.S.C. § 116 and 37 CFR § 1.47(a). The Rule 63 declaration accompanying the application was signed by Davis, but not Monty. Davis alleged that Monty refused to join in the application.

A Rule 47 declaration, signed by Davis on "10/3/89" (assumed to be October 3, 1989), explains in-part as follows:

***2** 6. In May, 1989, prior to filing the present application I forwarded a copy of the application, drawings, and inventorship declaration, along with an assignment of the application to Prince Manufacturing, Inc., to Mr. Monty. On several occasions thereafter, I spoke with Mr. Monty by telephone, who indicated that he had signed the declaration and assignment and would return the same to me.

7. As of June 28, 1989, we [sic--I?] had still not received the executed application papers. At the time, Mr. Monty was in the process of moving, and I was temporarily unable to reach him. In order not to delay further the filing of the application, it was filed on June 29, 1989 with the intention of submitting Mr. Monty's declaration when received.

8. In August, 1989, after I again was able to locate Mr. Monty, Richard M. Miller, Corporate Council [sic--Counsel] for the assignee, Prince Manufacturing, Inc., spoke with Mr. Monty. [Mr. Miller told me that] Mr. Monty indicated [to Mr. Miller] that he had submitted the application papers to an attorney for review; that he was now unable to locate the original set of documents; but that he was willing to sign the application papers and assignment. [I was] [t]hereafter [told that], on August 25, 1989, Prince's outside patent counsel mailed a copy of the application, inventorship declaration, and assignment to Mr. Monty at the address indicated above.

9. In the months of September and October, I have made a number of unsuccessful attempts to reach Mr. Monty by telephone. [I was told that] [o]n September 22, 1989, Prince's outside counsel sent a follow up written reminder to Mr. Monty. Mr. Monty has not returned my telephone calls, and we [sic--I] have yet to receive the signed application papers.

10. The development of the product to which U.S. application Ser. No. 373,331 [the Davis/Monty application] relates involved another individual, Alan Uke, who was hired by Prince to help develop the production molds. Mr. Uke did not contribute to the subject matter

claimed in the '331 patent application, i.e., a handle with a slide on, cushioned pallet composed of a solid elastomeric material and having an array of holes or the like in the outer surface. Mr. Uke, however, asserts that he proposed an additional optional feature, namely internal grooves. Originally, a patent application was drafted which, in addition to the basic invention, included dependent claims reciting the use of internal grooves and listed Mr. Uke as a co- inventor. However, Mr. Uke refused to sign the application, and proposed a draft application of his own. The Uke draft was incomplete and did not include claims or name inventors, but was intended to encompass certain product applications outside the field of tennis to which Mr. Uke alleged ownership rights. In subsequent discussions, it appeared that Mr. Uke's objectives relative to the scope of the patent application were inconsistent with those of Prince, and therefore Prince decided to file a patent application directed to the basic invention, rather than trying to include also the added feature that Mr. Uke alleges he contributed.

***3** 11. Prior to filing what became the '331 application [the Davis/Monty application], I discussed the issue of inventor contribution with Mr. Monty, who concurred that he and I, and not Allan [sic--Alan] Uke, are the inventors of the subject matter claimed in the '331 application, i.e., the basic invention. Mr. Monty confirmed that belief in the conversation with Mr. Miller referred to above.

12. Mr. Monty is a supplier of Mr. Uke's company and thus depends on Mr. Uke as a source of business. Mr. Uke has led me to believe that he has filed or is planning to file his own patent application, and it is my understanding that Mr. Uke has been in contact with Mr. Monty concerning this matter. It thus appears that pressure from Mr. Uke may be the reason that Mr. Monty has not returned the application papers to us.

The assignment records of the PTO reveal that Davis assigned his interest in the application to Prince Manufacturing, Inc. There is no record of Monty having assigned any interest in the Davis/Monty application.

During examination of the Davis/Monty application, the examiner rejected claims over the Uke/Monty patent. [FN3] Davis responded by requesting an interference with the Uke/Monty patent.

3. Interference No. 102,751

Interference No. 102,751 was declared on February 6, 1992. On August 27, 1992, the parties filed a "joint" paper styled MOTION BY THE PARTIES TO DISSOLVE THE INTERFERENCE UNDER 37 C.F.R. § § 1.635 (Paper No. 14). In the paper, the parties advised the Examiner-in-Chief, inter alia, as follows:

Under the provisions of 37 C.F.R. § 1.635 the parties Uke, et al. and Davis, et al. hereby jointly move to have the above-captioned interference dissolved [[FN4]] on the ground that there is common inventorship of the invention described [[FN5]] in the involved patent and application.

The parties [[FN6]] have conducted extensive investigation into the conception and reduction to practice [[FN7]] of this invention [[FN8]] and have ascertained that Alan K. Uke, Lawrence P. Monty and

Steven J. Davis all made significant contributions to the inventive concept [[FN9]] and to the conception and reduction to practice of the invention. The parties are therefore preparing for signature and filing a Motion Under 37 C.F.R. § § 1.324 and 1.634 and a Motion under 37 C.F.R. § § 1.48 and 1.634 ... to correct the named inventorship in the involved '862 patent [the Uke/Monty patent] and the '331 application [the Davis/Monty application] to name all three persons as co-inventors on each.

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The parties will also file an amendment [[FN10]] in the pending '331 application [[FN11]] [the Davis/Monty application] to delete common subject matter claims [sic--claimed?] and to maintain a line of demarcation between the claimed subject matter of the '862 patent [the Uke/Monty patent] and the '331 application [the Davis/Monty application].

***4** On August 27, 1992, the parties filed a paper styled MOTION BY THE PARTIES TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § § 1.634 (Paper No. 15), [FN12] accompanied by a statement signed by Uke and Davis, but not Monty. The Examiner-in-Chief declined to grant the motion, inter alia, because it was not accompanied by a statement signed by all three inventors, viz., Uke, Monty, and Davis. The Examiner-in-Chief held that the parties had to obtain a statement signed by all three inventors or seek waiver of the requirement of the rules that Monty sign the statement. Inasmuch as the parties conceded that the present designation of inventorship in both the Uke/Monty patent and the Davis/Monty application was incorrect, the Examiner-in-Chief placed both parties under an order to show cause why judgment based on unpatentability under 35 U.S.C. § 102(f) should not be entered against both parties (Paper No. 19, page 2--mailed and dated October 28, 1992).

A response was filed to the order to show cause (Paper No. 21). The parties also filed a CONDITIONAL PETITION UNDER RULE 183 [[FN13]] TO WAIVE SIGNATURE OF JOINT INVENTOR MONTY (Paper No. 22). The "effort" to obtain Monty's signature on an appropriate statement is set out in-part in a DECLARATION OF ROBERT B. SMITH, counsel for Davis and Prince Manufacturing, Inc., signed on November 25, 1992:

4 (part). Mr. Monty had previously had a business relation with Mr. Uke, but is an independent party not associated with either assignee [[FN14]] and is not involved (except in name) in the interference. Moreover, neither Prince nor Mr. Uke had been in contact with Mr. Monty for some time, and the parties were not sure of his current whereabouts. However, Mr. Uke indicated his belief that Mr. Monty would agree to sign the papers to correct inventorship.

7. While the parties were preparing the settlement and motion papers, I discussed with Mr. Uke's counsel, James W. McClain, the issue of obtaining Mr. Monte's signature on the papers. At the time the papers were signed, on August 27, 1992, Mr. McClain agreed to ask Mr. Uke to approach Mr. Monty to request that he sign the papers, in view of their prior business arrangement, and in view of the fact that Mr. Monty had in the past refused to sign papers forwarded by Prince. In a subsequent conversation about a week later, Mr. McClain indicated that he and Mr. Uke had not thus far been able to ascertain Mr. Monty's

current address.

9 (part). I reviewed the Davis application file to obtain Mr. Monty's last known address, which was in Milton, Vermont, and called Vermont telephone information to verify that Mr. Monty still had a telephone listing in Milton.

12 (part). On September 21, 1992, I sent by courier the two Statements of Fact and two Rule 63 declarations [[FN15]] to Mr. Monty for signature. [[FN16]]

13. On October 5, 1992, I spoke with Mr. Monty by telephone. He indicated that he had no problem with the papers, but stated that he had an agreement with Mr. Uke regarding the supply of rubber under the Uke patent, and wanted to know if Prince would agree to give him an exclusive supply contract for rubber.

***5** 15 (part). Mr. Monty returned my call on October 12, 1992. I told him that Prince would not agree to his proposal, but would agree to let him compete for a supply contract. We further discussed the fact that, if Mr. Monty believed he had an agreement with Mr. Uke, he should work it out directly with Mr. Uke. We also discussed the various declarations that Mr. Monty had received from us. Mr. Monty indicated that he would call Mr. Uke and call me back, but that he would not be able to call me back until October 19th.

16. As of October 30, 1992, Mr. Monty had not called back, on that date we received the Order to Show Cause dated October 28, 1992 [Paper No. 19].

Discussion

PTO Rules 48 and 324 (37 CFR § § 1.48 and 1.324) require a statement signed by all originally named inventors, any added inventors, and any deleted inventors in connection with any change of inventorship in an application or a patent. Hence, a statement signed by Uke, Davis, and Monty is required in this case. One purpose of the statement is to assist the PTO in determining whether the error in not naming all correct inventors occurred "without any deceptive intention." 35 U.S.C. § 116, third paragraph; 35 U.S.C. § 256, first paragraph.

There have been occasions when the PTO has waived the requirement for a statement signed by all concerned. In re Hardee, 223 USPQ 1122 (Comm'r Pat.1984). However, under applicable administrative precedent, a waiver will not be considered by PTO unless the facts of record "unequivocally support" the correction sought. In re Cooper, 230 USPQ 638, 639 (Comm'r Pat.1985); Manual of Patent Examining Procedure, § 201.03 (Nov. 1989). No showing of "unequivocally support" has been made (even remotely) in this case.

The "thorough analysis" of the inventorship issue said to have taken place shortly after the filing of the Uke/Monty application, did not result in a determination that Davis was a joint inventor of the subject matter claimed in the Uke/Monty application. Likewise, the consideration said to have been given to the inventorship issue prior to the filing of the Davis/Monty application did not result in a determination that Uke was a joint inventor of the subject matter claimed in the Davis/Monty application. If all three individuals are named as inventors with respect to both the Uke/Monty patent and the Davis/Monty application and the Davis/Monty application is abandoned,

the parties (meaning Uke, Davis, and Prince) would be in a position to leave the non-signing inventor (Monty) without any rights to the invention claimed in the Davis/Monty application.

The "facts" presented to date in the record of this case do not demonstrate with an appropriate degree of assurance that Uke, Davis, and Monty are joint inventors of any subject matter claimed in either the Uke/Monty patent or the Davis/Monty application. Accordingly, the petition seeking waiver of the requirement for a statement signed by Monty will be denied.

***6** Uke, Davis, and Prince are not without a remedy. An interference is pending. An interference is a contested case within the meaning of 35 U.S.C. § 24. 37 CFR § 1.614(b). The testimony of Monty can be obtained through a deposition and a deposition can be compelled through issuance of a subpoena under § 24 from the U.S. District Court for the District of Vermont-- the district in which Monty appears to reside. Since there is a means available to obtain a statement by Monty, relief under 37 CFR § 1.644(a)(3) is not warranted. Compare In re RCA Corporation, 209 USPQ 1114, 1117 (Comm'r Pat.1981), where the Commissioner noted that a party in an interference should apply to a court for assistance. In RCA, it was suggested that an employment contract between Davidson and RCA existed which might be enforced in a state court. Id. at 1117 n. 4. Here there does not appear to be any contract between (1) Prince and/or Davis, on the one hand, and (2) Monty, on the other hand. Nevertheless, testimony can be compelled through a subpoena issued pursuant to 35 U.S.C. § 24.

If the "parties" desire to proceed with a subpoena, application should be made to the Examiner-in-Chief. 37 CFR § 1.672(c). The parties should also request the Examiner-in-Chief to set times within which evidence might be obtained under § 24 and be presented to the board.

In an effort to expedite this matter, the parties are advised that they will need to explain in detail why Uke is being added as an inventor to the Davis/Monty application and why Davis is being added as an inventor to the Uke/Monty patent. As noted above, the inventorship designation for both the application and patent were previously considered--apparently not as thoroughly as necessary. Under the circumstances of this case, the parties should present detailed testimony or affidavits stating facts to show who invented what and when, and the precise nature of the contribution of each of Uke, Monty, and Davis. The parties need to explain who conceived what and when, and whether and when any actual reduction to practice took place of any subject matter falling within the scope of the count and any of the claims corresponding to the count. [FN17] Furthermore, a full and detailed explanation should be made as to why the error in inventorship was not earlier found, given (1) the Rule 48 inventorship change in the application which matured into the Uke/Monty patent and (2) the consideration given to inventorship at the time the Rule 47 papers were prepared for submission in the Davis/Monty application. It is difficult to imagine how appropriate evidence could be presented in this case without

(1) testimony or an affidavit by both Uke and Davis,

***7** (2) testimony or an affidavit by all patent counsel involved in the earlier determinations of inventorship,

(3) a § 24 or voluntary deposition by Monty,

(4) an explanation by Davis (and possibly Monty) as to why it was felt initially that Uke was not an inventor of the subject matter claimed in the Davis/Monty application, and

(5) providing copies and full explanations of "their records regarding the work and communications by and among the said Uke, Monty, and Davis during the development of the claimed subject matter," mentioned in the settlement agreement.

Accordingly, in taking any § 24 deposition of Monty, the parties may wish to show Monty any testimony given by others or their affidavits so that the Examiner-in-Chief and/or the board are in a position to have the benefit of Monty's informed testimony on the inventorship issue. The parties are reminded that argument of counsel does not take the place of evidence. Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854 (1977). The parties are also reminded that under 37 CFR § 1.671(f), the significance of documentary and other exhibits must be discussed with particularity by a witness during oral deposition or in an affidavit. See Notice of Final Rule, 49 Fed.Reg. 48416, 48428 (Dec. 12, 1984), reprinted in 1050 Off.Gaz.Pat.Office 385, 397 (Jan. 29, 1985); Popoff v. Orchin, 144 USPQ 762 (Bd.Pat.Int.1963) (unexplained experimental data should not be considered); Chandler v. Mock, 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless), and Smith v. Bousquet, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in stipulated testimony are entitled to little weight). See also In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974) and Triplett v. Steinmayer, 129 F.2d 869, 54 USPQ 409 (CCPA 1942).

As noted briefly earlier in this opinion, the interference will not be "dissolved." Instead, a judgment will be entered. 37 CFR § 1.658(a). The judgment will indicate what patent or application claims are not patentable. The judgment will govern further proceedings. 35 U.S.C. § 135(a); 37 CFR § 1.658(c). Hence, every effort should be made to present a complete record to the Examiner-in-Chief.

It is noted that the settlement agreement contemplates possible further prosecution of the Davis/Monty application to obtain "patentable subject matter not within the count of the interference." In the event the parties are able to change inventorship in the patent and application to name Uke, Davis, and Monty, consideration should be given to how any double patenting issue might be overcome. To the extent a terminal disclaimer may be needed, it should be remembered that the ownership interest of a Uke/Monty/Davis patent (2/3 Uke and 1/3 Davis or Prince) [FN18] and the ownership interest of a Davis/Monty/Uke application (1/3 Uke, 1/3 Davis or Prince and 1/3 Monty [FN19]) are not the same. Hence, obtaining and filing a terminal disclaimer may not be practical or even possible. See 37 CFR § 1.321; In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982).

Observations concerning the count and corresponding claims

***8** While not an issue in connection with the petition, there is some possibility that the count is not correct in this interference and that all claims in the Davis/Monty application have not been designated as

either corresponding or not corresponding to the count. The following comments are made so that the count and the claims designated to correspond to the count may be considered in further proceedings in the interference.

There is one count in the interference, which reads:

A hand grip for a handle shaft, comprising:

an elongated sleeve of elastomeric material having an inner surface for fitting over the outer surface of a handle shaft and an outer, gripping surface;

at least one surface of the sleeve having a plurality of indentations, comprising holes, extending over at least part of its area to allow deflection of the surface in that area under normal impact loads;

the inner and outer surfaces being of octagonal cross-section, including upper and lower flats, and side flats separated from the upper and lower flats by diagonal flats, the indentations being provided at least on the upper and lower flats; and

the outer gripping surface having indentations comprising a plurality of holes extending along the upper, lower and diagonal flats, and the side flats being at least less indented.

Claims 1 and 7-9 of the Uke/Monty patent and claims 1-7, 8/1, 8/2, 8/3, 8/4, 8/5, and 13-18 of the Davis/Monty application were designated as corresponding to the count.

Claim 1 of the Uke/Monty patent appears to "correspond exactly" to the count, i.e., the count and Uke/Monty claim 1 are identical. 37 CFR § 1.601(f). The remaining claims designated as corresponding to the count "correspond substantially" to the count. Id. Uke/Monty claim 7 is an independent claim. [FN20] The scope of Uke/Monty claim 1 and Uke/Monty claim 7 appear to overlap in scope, i.e., one may not be "generic" to the other.

Four independent claims of the Davis/Monty application have been designated as corresponding to the count, viz., claims 1, 13, 16, and 18. [FN21] Claim 1 is directed to a racquet. Claim 13 is directed to a slide-on pallet. Claim 16 is directed to a sports implement. Claim 18 is directed to a handle. Claims 1, 13, 16, and 18 appear to overlap in scope with claims 1 and 7 of the Uke/Monty patent. In transmitting the Uke/Monty patent and Davis/Monty application to the board for declaration of an interference, the examiner in his Form PTO-850 indicated that claims 5-7, 8/5 [FN22] and 15 are allowable. All other claims in the Davis/Monty application were deemed "not allowable."

The scope of a count of an interference should be such as to embrace all of the patentable subject matter of all claims corresponding to the count. In this case, the count should be such as to include within its scope (1) all of the subject matter of claims 1 and 7-10 of the Uke/Monty patent and (2) all of the subject matter of allowable claims 5-7, 8/5 and 15 of the Davis/Monty application. [FN23] The count can be written in a form which recites the subject matter of claims 1 or 7 of the Uke/Monty patent or the subject matter of claims 5 or 15 of the Davis/Monty application. [FN24] See Orikasa v. Oonishi, 10 U.S.P.Q.2d 1996, 2003 (Comm'r Pat.1989), which encourages the use of counts reciting (1) the subject matter of one claim "or" (2) the subject matter of an opponent's claim. When the interference is returned to the

board, the Examiner-in-Chief may take any action he deems appropriate to be sure that the count is correct and that appropriate claims have been designated to correspond to the count. [FN25]

Order

***9** Upon consideration of the CONDITIONAL PETITION UNDER RULE 183 TO WAIVE SIGNATURE OF JOINT INVENTOR MONTY (Paper No. 22), it is

ORDERED that the petition is denied, and it is

FURTHER ORDERED that the interference is returned to the jurisdiction of the Examiner-in-Chief for such further action the Examiner-in-Chief deems appropriate.

FN1. The appropriate time for making a thorough analysis of inventorship is prior to, not after, an application is filed.

FN2. The record does not reveal what caused Uke to "realize" after the filing of the application that Monty was a co-inventor.

FN3. The Uke/Monty patent is prima facie prior art against the Davis/Monty patent. 35 U.S.C. § 102(e).

FN4. An interference is not "dissolved." Instead, a judgment is entered indicating who, if anyone, is entitled or not entitled to particular claims. 37 CFR § 1.658(a).

FN5. That there may be common inventorship of an invention which is "described" in an application is irrelevant. The relevant question is who invented the subject matter of the count and/or the claims corresponding to the count.

FN6. To the extent that the word "parties" is intended to include Monty, it is inaccurate. There is no evidence in the record that Monty participated in any "investigation." In fact, according to statements in the Davis Rule 47 declaration, Monty is said at one time to have expressed the opinion that Uke is not an inventor of the subject matter claimed in the Davis/Monty application.

FN7. The record is unclear on whether the phrase "reduction to practice" means an actual reduction to practice or a constructive reduction to practice (based on the filing of either the Uke/Monty or the Davis/Monty applications).

FN8. The meaning of the word "invention" is unclear. Invention could refer to (1) the subject matter of the count or (2) particular claims

in either the Uke/Monty patent or Davis/Monty application or (3) subject matter disclosed, but not claimed, in either the patent or application.

FN9. The phrase "inventive concept" is vague. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1547-48, 220 USPQ 303, 308 (Fed.Cir.1983); Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, ----, 4 U.S.P.Q.2d 1737, 1751 (Fed.Cir.1987) (Nies, J., concurring). Inventive concept could refer to (1) the subject matter of the count or (2) particular claims in either the Uke/Monty patent or Davis/Monty application or (3) subject matter disclosed, but not claimed, in either the patent or application.

FN10. To date, no amendment has been filed.

FN11. If claims are cancelled from the Davis/Monty application and claims to the same patentable invention are left in the Uke/Davis patent, Monty stands to lose whatever right he has to any patent which may issue on the basis of the Davis/Monty application. Monty has assigned his interest in the Uke/Monty patent to Uke. To date, PTO records do not reveal that Monty has assigned any rights he may have in the Davis/Monty application.

FN12. The "parties" have also filed a settlement agreement, which is being kept separate from the interference files at the request of the "parties." 35 U.S.C. § 135(c). Resolution of the issues on petition and other considerations necessary to bring this interference to a prompt conclusion, necessitate some brief reference to parts of the agreement. References have been kept to an absolute minimum.

FN13. The petition is authorized by 37 CFR § 1.644(a)(3). The $130.00 fee for the petition (37 CFR § 1.17(h)) is being charged against Deposit Account No. 23-1703.

FN14. Construed to mean Prince Mfg and Uke.

FN15. Two statements and two declarations were needed, one to be filed in the Uke/Monty patent file and the second to be filed in the Davis/Monty application file.

FN16. Accompanying the statements and declarations was a letter (Exhibit A to the Smith Declaration) dated September 21, 1992. The letter states, inter alia (page 2, first full paragraph):

> Earlier this year, the Patent Office declared an "Interference" between the Uke patent and the Prince patent application. In essence, the Patent Office deemed the two applications to conflict with one another, and initiated a proceeding to decide which should stand (i.e., decide whose names should properly on the patent).

The "i.e." part of the last statement is not correct. The interference

was initially declared to determine who, as between Uke/Monty and Davis/Monty is entitled to a patent with claims corresponding to the count.

FN17. Section 201.03 of the Manual states in part that "[a]s 37 CFR 1.48(a) is intended as a simply procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for considerations in determining whether the record unequivocally supports the correct sought." (Emphasis added). The parties are advised that, in this interference, determination of inventorship is a substantive matter and the noted portion of § 201.03 does not apply in this case. Compare Bloom v. Furczyk, 144 USPQ 678, 1965 Dec.Comm'r Pat. 81 (Bd.Int.1955), noting that under the interference rules now in effect the board has authority to enter judgment against one or all parties based on unpatentability under 35 U.S.C. § 102(f).

FN18. Possibly 1/2 Uke and 1/2 Prince if the settlement agreement is deemed to be in force.

FN19. The settlement agreement states that "Prince is the owner of" the Davis/Monty application. It is true that Davis assigned his interest in the Davis/Monty application to Prince. However, Monty has not assigned any interest in that application, it being noted that the application was filed by Davis on behalf of Davis and Monty. While Davis has a right to prosecute the Davis/Monty application under PTO rules, that right does not mean that Monty would not be a joint owner of any Davis/Monty patent issued on the basis of the Davis/Monty application.

FN20. Uke/Monty patent claims 1 and 7 are reproduced in Appendix 1 to this opinion.

FN21. Davis/Monty application claims 1-8, 13-16, and 18 are reproduced in Appendix 2 to this opinion.

FN22. Meaning claim 8 to the extent it depends from claim 5. It is noted that Form PTO-850 does not indicate one way or the other whether claim 8/6 or claim 8/7 is allowable or unpatentable. In filling out a Form PTO-850, the examiner should indicate whether each claim in an application is allowable or not allowable. In the case of multiple dependent claims, such as Davis/Monty claim 8, the Form PTO-850 must indicate the claimed subject matter which corresponds, and the claimed subject matter which does not correspond, to each count. Manual of Patent Examining Procedure, § 2309.02, p. 2300-24 (1989). On the present record, there is no indication whether the subject matter of claim 8/6 or the subject matter of claim 8/7 corresponds or does not correspond to the count.

FN23. It is appropriate to designate non-allowable claims of an

application as corresponding to a count, but the scope of the count should not include non- allowable subject matter. Manual of Patent Examining Procedure, § 2309.03, p. 2300-24 (1989).

FN24. A count which would include all necessary subject matter is set out in Appendix 3 to this opinion.

FN25. The Examiner-in-Chief can also determine whether claims 8/6 and 8/7 should correspond to the count.

Appendix 1

Claims 1 and 7 of the Uke/Monty patent

***10** 1. A hand grip for a handle shaft, comprising:
an elongated sleeve of elastomeric material having an inner surface for fitting over the outer surface of a handle shaft and an outer, gripping surface;
at least one surface of the sleeve having a plurality of indentations, comprising holes, extending over at least part of its area to allow deflection of the surface in that area under normal impact loads;
the inner and outer surfaces being of octagonal cross-section, including upper and lower flats, and side flats separated from the upper and lower flats by diagonal flats, the indentations being provided at least on the upper and lower flats; and
the outer gripping surface having indentations comprising a plurality of holes extending along the upper, lower and diagonal flats, and the side flats being at least less indented.

7. A hand grip for a handle shaft, comprising:
an elongated sleeve of resilient material having an internal surface for fitting over a handle shaft and an outer gripping surface;
the sleeve having areas of varying softness extending around its periphery, with softer areas comprising at least those areas to which pressure is applied by a hand gripping the sleeve on impact;
the areas of varying hardness comprising alternating elongate regions having a greater and lesser number of indentations on at least one of the inner and outer surfaces of the sleeve; and
the areas having a greater number of indentations being generally perpendicular to the impact direction.

Appendix 2

Claims 1, 17, 2, 5, and 13-15 of the Davis/Monty application

1 (not allowable). A racquet comprising a frame and a handle; wherein the frame includes a head and an axially extending shaft portion, wherein the shaft portion of the frame has an outer periphery; and wherein the handle includes a pallet formed of a solid elastomeric material, with an outside gripping surface and a hollow interior having

inside surfaces conforming to the outer periphery of the shaft portion of the frame and forming contact surfaces therewith; and wherein said pallet further includes means for increasing the resiliency of the pallet in selected gripping areas, said means being in the form of an array of holes, located in at least one gripping area of the handle, the holes extending from the outside surface partially through the pallet toward the hollow interior.

17 (not allowable). A racquet according to claim 1 wherein the pallet with a uniform hollow interiorconforms to the outer surface of a uniform shaft; and wherein the pallet is premolded such that the shaft portion of the racquet may be inserted into the hollow interior of the pallet which thereafter slides onto the shaft portion of the racquet for mounting, such that the outside surfaces of the shaft portion are in contact with the complimentary inside surface of the pallet.

2 (not allowable). A racquet according to claim 17, wherein the holes extend generally perpendicular to the frame axis.

***11** 5 (allowable). A racquet according to claim 2, wherein the frame has a head portion lying generally in a plane, and wherein the pallet has outside surfaces which are generally octagonal in configuration and include top and bottom walls parallel to said plane, opposed sides perpendicular to said plane, and diagonal walls joining the sides to the top and bottom walls, wherein the array of holes is formed only in the top, bottom and diagonal walls, and wherein said holes extend generally perpendicular to said top and bottom surfaces and substantially through the respective walls.

13 (not allowable). A slide-on pallet for forming the handle of a tennis racquet frame of the type having a shaft with opposed, parallel top and bottom surfaces and opposed sides, said pallet being molded of a solid elastomeric material with a hollow interior including opposed, parallel, top and bottom surfaces and opposed sides, the interior surfaces being sized to form contact surfaces with the shaft of a tennis racquet; and means for increasing the resiliency of the pallet in selected gripping areas, said means being in the form of an array of spaced holes on at least one gripping portion of said pallet extending inwardly toward said hollow interior.

14 (not allowable). A pallet according to claim 13, wherein the outside surfaces include a top surface and a bottom surface, wherein said array is provided on said surfaces, and wherein the holes extend perpendicular thereto and through the top and bottom walls of the pallet.

15 (allowable). A pallet according to claim 14, wherein said handle includes opposed sides and diagonal surfaces joining the sides to the top and bottom surfaces, and holes are provided in said top, bottom, and diagonal surfaces only and extend perpendicular to the top and bottom surfaces.

Appendix 3

Count covering claims 1 and 7 of the Uke/Monty patent and allowable claims 5

and 15 of the Davis/Monty application

Count 1.

A hand grip [FN1] for a handle shaft, comprising:

an elongated sleeve of elastomeric material having an inner surface for fitting over the outer surface of a handle shaft and an outer, gripping surface;

at least one surface of the sleeve having a plurality of indentations, comprising holes, extending over at least part of its area to allow deflection of the surface in that area under normal impact loads;

the inner and outer surfaces being of octagonal cross-section, including upper and lower flats, and side flats separated from the upper and lower flats by diagonal flats, the indentations being provided at least on the upper and lower flats; and

the outer gripping surface having indentations comprising a plurality of holes extending along the upper, lower and diagonal flats, and the side flats being at least less indented;

or

A hand grip [FN2] for a handle shaft, comprising:

an elongated sleeve of resilient material having an internal surface for fitting over a handle shaft and an outer gripping surface;

***12** the sleeve having areas of varying softness extending around its periphery, with softer areas comprising at least those areas to which pressure is applied by a hand gripping the sleeve on impact;

the areas of varying hardness comprising alternating elongate regions having a greater and lesser number of indentations on at least one of the inner and outer surfaces of the sleeve; and

the areas having a greater number of indentations being generally perpendicular to the impact direction.

or

A racquet [FN3] comprising a frame and a handle; wherein the frame includes a head and an axially extending shaft portion, wherein the shaft portion of the frame has an outer periphery; and wherein the handle includes a pallet formed of a solid elastomeric material, with an outside gripping surface and a hollow interior having inside surfaces conforming to the outer periphery of the shaft portion of the frame and forming contact surfaces therewith; and wherein said pallet further includes means for increasing the resiliency of the pallet in selected gripping areas, said means being in the form of an array of holes, located in at least one gripping area of the handle, the holes extending from the outside surface partially through the pallet toward the hollow interior and extending generally perpendicular to the frame axis, the pallet having a uniform hollow interior which conforms to the outer surface of a uniform shaft; and wherein the pallet is premolded such that the shaft portion of the racquet may be inserted into the hollow interior of the pallet which thereafter slides onto the shaft

portion of the racquet for mounting, such that the outside surfaces of the shaft portion are in contact with the complimentary inside surface of the pallet, the racquet further having a frame with a head portion lying generally in a plane, and wherein the pallet has outside surfaces which are generally octagonal in configuration and include top and bottom walls parallel to said plane, opposed sides perpendicular to said plane, and diagonal walls joining the sides to the top and bottom walls, wherein the array of holes is formed only in the top, bottom and diagonal walls, and wherein said holes extend generally perpendicular to said top and bottom surfaces and substantially through the respective walls.

or

A slide-on pallet [FN4] for forming the handle of a tennis racquet frame of the type having a shaft with opposed, parallel top and bottom surfaces and opposed sides, said pallet being molded of a solid elastomeric material with a hollow interior including opposed, parallel, top and bottom surfaces and opposed sides, the interior surfaces being sized to form contact surfaces with the shaft of a tennis racquet; and means for increasing the resiliency of the pallet in selected gripping areas, said means being in the form of an array of spaced holes on at least one gripping portion of said pallet extending inwardly toward said hollow interior, wherein the outside surfaces include a top surface and a bottom surface, wherein said array is provided on said surfaces, and wherein the holes extend perpendicular thereto and through the top and bottom walls of the pallet, and wherein said handle includes opposed sides and diagonal surfaces joining the sides to the top and bottom surfaces, and holes are provided in said top, bottom, and diagonal surfaces only and extend perpendicular to the top and bottom surfaces.

FN1. The hand grip of claim 1 of the Uke/Monty patent.

FN2. The hand grip of claim 7 of the Uke/Monty patent; Uke/Monty claims 8 and 9 depend from 7 and hence are within the scope of the count.

FN3. Allowable claim 5 of the Davis/Monty application re-written in independent form (matter added to claim 1 from claim 17 is indicated in bold; matter further added from claim 2 is underlined; matter still further added from claim 5 is underlined and bold).

FN4. Allowable claim 15 of the Davis/Monty application re-written in independent form (matter added to claim 13 from claim 14 is indicated in bold; matter further added from claim 15 indicated by underlining).

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