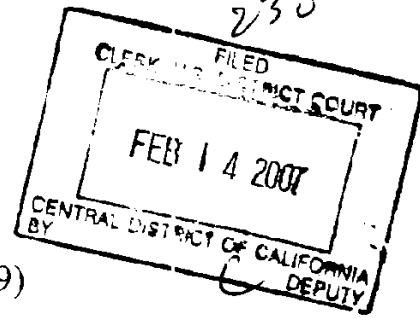


2:07cv693

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FILED

MAY 2 2007

Attorneys for Plaintiff
HT WINDOW FASHIONS CORP.

CLERK, U.S. DISTRICT COURT
WEST. DIST. OF PENNSYLVANIA

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

HT WINDOW FASHIONS CORP., a
California corporation,

Plaintiff,

v.

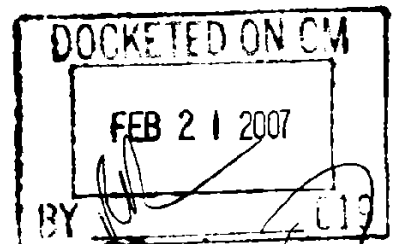
REN JUDKINS,

Defendant.

Case No.

**COMPLAINT FOR
DECLARATORY JUDGMENT OF
PATENT INVALIDITY,
NONINFRINGEMENT AND
UNENFORCEABILITY; AND
UNFAIR COMPETITION**

DEMAND FOR JURY TRIAL



Given Patent form

ROSS, DIXON & BELL, LLP
5 PARK PLAZA, SUITE 1200
IRVINE, CA 92614-8592

YS
20

ORIGINAL

1 Plaintiff HT Window Fashions Corp. ("HTW") complains against Defendant
2 Ren Judkins ("Judkins") as follows:

3
4 **The Parties**

5
6 1. Plaintiff HTW is a corporation organized under the laws of the State of
7 California, having its principal place of business and corporate headquarters located
8 at 770 S. Epperson Dr., City of Industry, California, 91748.

9
10 2. Upon information and belief, Defendant Ren Judkins is a nonresident
11 individual who is a citizen and resident of the State of Pennsylvania and may be
12 found at 46 Newgate Road, Pittsburgh, Pennsylvania 15202.

13
14 **Jurisdiction and Venue**

15
16 3. This Court has subject matter jurisdiction over this action pursuant to
17 28 U.S.C. § 1332 in that this action is between citizens of different states and the
18 matter exceeds, exclusive of interest and cost, the sum of \$75,000.

19
20 4. Additionally, this Court has subject matter jurisdiction over this action
21 pursuant to 28 U.S.C. §§ 1331 and 1338(b) in that this is an action for declaratory
22 relief under 28 U.S.C. § 2201, and the Patent Laws of the United States, 35 U.S.C.
23 §§ 271, *et seq.* This is also an Unfair Competition action arising under the
24 Trademark Laws of the United States, 15 U.S.C. § 1125(a). The Court has
25 jurisdiction pursuant to 28 U.S.C. §§ 1338(b) and 1367(a) for state law claims.

26
27 5. This Court has *in personam* jurisdiction over Defendant Judkins, *inter*
28 *alia*, pursuant to California Code of Civil Procedure Section 410.10 and Rule 4(e)

1 Fed. R. Civ. P. because, *inter alia*, Defendant committed an act with the intent to
2 cause a tortious effect within the State of California.

3
4 6. Venue is proper pursuant to 28 U.S.C. § 1391(b) because a substantial
5 part of the property that is the subject of the action is situated in this Judicial
6 District.

7
8 **Factual Background**

9
10 7. Based in the City of Industry, California, Plaintiff HTW distributes
11 custom window coverings, including a product line of double cell window
12 coverings called POLARIS®. HTW has contracts to sell the POLARIS® product
13 and other products to various customers throughout the United States.

14
15 8. Worldwide Window Fashions is a potential HTW customer. HTW has
16 made and is currently making efforts to sell Worldwide Window Fashions its
17 various custom window covering products.

18
19 9. HTW has a reasonable probability of expanded business and additional
20 contracts with various entities throughout the United States.

21
22 10. Defendant Judkins is the named inventor on certain U.S. patents related
23 to window coverings. Upon information and belief, Judkins does not manufacture
24 or distribute any window covering products. Instead, Judkins earns much of his
25 living extracting patent licensing fees from companies that manufacture and
26 distribute window coverings.

11. Lynn J. Alstadt, Esq. ("Alstadt") is an attorney practicing at Buchanan Ingersoll & Rooney, 301 Grant Street, Pittsburgh, PA, who has filed and prosecuted various U.S. Patents on which Judkins is the named inventor. Buchanan Ingersoll & Rooney also has offices in California.

12. Nien Advanced Solutions ("NAS") is a company present in California that sells window coverings, and, upon information and belief, has obtained licenses to certain U.S. Patents issued to Judkins.

Threats Based upon the Issued '634 Patent

13. On March 31, 2005, Judkins, by and through attorney Alstadt, sent a letter to Plaintiff HTW stating that HTW's "tabbed cellular products" made with a single cell will infringe an unidentified and unissued patent once that patent issues. A true and correct copy of that letter is attached hereto as Exhibit A.

14. Judkins, at trade shows and similar venues, told customers and potential customers of HTW that he was seeking a patent that would be infringed by the tabbed single cell products.

15. Over one year later, Judkins, through his attorney Alstadt, sent a letter on June 2, 2006 to HTW attaching the allowed but unissued claims of U.S. Patent Application No. 09/017,392 (the "'392 Application"). A true and correct copy of that letter is attached hereto as Exhibit B. The letter again accused HTW's "tabbed cellular products" made with a single cell of infringing the claims of this unissued patent.

1 16. As a result of this threat, HTW was forced to adopt a new design for its
2 single cell products. An example of this new single cell product was sent to Alstadt
3 for review, along with an explanation of why it did not infringe the claims of the
4 '392 Application.

5
6 17. On July 24, 2006, Judkins, through attorney Alstadt, responded to
7 HTW's explanations and agreed that the new single cell products did not infringe,
8 but warned that HTW could not sell its prior design for tabbed single cell products.

9
10 18. The '392 Application issued on January 9, 2007 as U.S. Patent No.
11 7,159,634 (the " '634 Patent"). A true and correct copy of the '634 Patent is
12 attached hereto as Exhibit C.

13
14 19. HTW still wishes to sell its prior tabbed single cell products in the
15 United States.

16
17 20. Based upon the threats contained in Judkins' letters related to the '392
18 Application, HTW has a reasonable apprehension that if its prior tabbed single cell
19 products are again sold in the United States, Judkins will bring an action for
20 infringement of the '634 Patent.

21
22 **Judkins' False Representations related to the '372 Application**

23
24 21. Judkins claims to be the applicant of U.S. Patent Application serial No.
25 09/703,372 (the " '372 Application").

26
27 22. Furthering his pattern of sending threatening letters to HTW related to
28 the unissued patent, on January 26, 2007, Judkins, through attorney Alstadt, sent a

1 letter to HTW alleging that the claims of the '372 Application cover HTW's double
2 cell POLARIS® product. A true and correct copy of that letter is attached hereto as
3 Exhibit D.

4
5 23. On February 9, 2007, HTW was informed by its customer Worldwide
6 Window Fashions that it had been given a letter dated February 7, 2007 (the "Feb. 7
7 letter") signed by Alstadt. This letter is addressed "To Whom it May Concern" and
8 first discusses the '634 Patent. The Feb. 7 letter goes on to state, *inter alia*, that
9 "[r]ecently, the United States Patent and Trademark Office allowed Mr. Judkins'
10 patent application for a tabbed double cell product" and "[i]n our opinion, HT's
11 'Polaris' product falls within one or more of those allowed claims." A true and
12 correct copy of that letter is attached hereto as Exhibit E.

13
14 24. Kevin C. Huang, Director of Marketing of Nien Advanced Solutions,
15 based in California, provided Robert Caplan of Worldwide Window Fashions with
16 the Feb. 7 letter.

17
18 25. Upon information and belief, a similar letter was provided to B.D.D.,
19 Inc., a customer of HTW.

20
21 26. Upon information and belief, Judkins, through his attorney Alstadt, is
22 distributing or is planning to distribute additional letters like the "To Whom it May
23 Concern" Feb. 7 letter to potential HTW customers throughout the window
24 covering industry.

25
26 27. Upon information and belief, Judkins knows of contracts between
27 HTW and various customers for the purchase of the POLARIS® product.
28

ROSS, DIXON & BELL, LLP
5 PARK PLAZA, SUITE 1200
DENVER, CO 80202

28. The '634 Patent and '372 Application are part of a chain of patent applications that were obtained by committing a fraud on a United States District Court and the United States Patent and Trademark Office ("PTO").

29. The subject matter of the '634 Patent and the '372 Application was abandoned, suppressed and/or concealed by Judkins in violation of 35 U.S.C. §§ 102(c) and (g).

30. The '634 Patent and any patent issuing from the '372 Application would be invalid and unenforceable.

31. Judkins has knowledge that any patent issuing from the '372 Application would be invalid and unenforceable, and knowingly made statements to HTW customers that the POLARIS® would infringe this invalid patent.

32. Judkins statements have injured HTW by loss of actual and potential sales and by a lessening of goodwill associated with HTW's products.

Background of the '372 Application

33. Judkins obtained the family of patents on which the '634 Patent and the '372 Application is based by filing sham litigation in the United States District Court for the Western District of Pennsylvania.

34. The window covering claimed in the '634 Patent and the '372 Application is created using a process in which strips of material are folded back upon themselves, glued to create a figure-eight structure, stacked on top of other similarly formed figure-eight structures, and cut through the middle (the "T19

1 Process”).

2
3 35. Judkins claims that he conceived the T19 Process in 1990. A true and
4 correct copy of the January 20, 1998 Declaration of Ren Judkins under 37 C.F.R. §
5 1.131 is attached hereto as Exhibit F.

6
7 36. Judkins claims that a drawing illustrating the T19 Process (the “T19
8 Drawing”) was created on or around February 25, 1991. (*Id.*)

9
10 37. Judkins met with attorney Alstadt on or around March 19, 1991 to
11 discuss patenting the T19 Process. During this meeting a model was created using
12 the T19 Process.

13
14 38. Alstadt and his associates drafted a patent application disclosing the
15 T19 Process, and forwarded the application to Judkins on or around July 26, 1991.
16 This patent application was not filed at that time.

17
18 39. On information and belief, between 1992 and 1996 Judkins attempted
19 to commercialize the T19 Process, and marketed the T19 Process to manufactures
20 such as Verosol, Hunter Douglas, Graber, Joanna, Levolor, Carey-McFall, Blind
21 Design, and Seco Supply. None of these manufacturers agreed to commercialize
22 the T19 Process.

23
24 40. On August 19, 1996, U.S. Patent Application serial No. 08/699,593
25 was filed in the name of James Arthur Ford, *et al.* This patent eventually issued on
26 December 2, 1997 as U.S. Patent No. 5,692,550 entitled Cellular Shade Material
27 (the “Ford ‘550 Patent”). The Ford ‘550 Patent was assigned to Newell Window
28 Furnishings, Inc. (“Newell”) on December 18, 1997.

41. On November 25, 1996 Judkins, through attorney Altstadt, filed U.S. Patent Application serial No. 08/756,282 (the “ ‘282 Application”), over four years after the Patent Application was first drafted.

42. On February 2, 1998 Judkins, through attorney Altstadt, requested that the PTO declare an interference between the Judkins ‘282 Application and the Ford ‘550 Patent. The requested interference was declared and titled Patent Interference No. 104,329.

43. On September 28, 2001, the Board of Patent Appeals and Interferences (the “Board”) found that Judkins had suppressed or concealed the invention described in the ‘282 Application within the meaning of 35 U.S.C. § 102(g). As a result, the Board ruled that Judkins was not entitled to a patent on his ‘282 Application. *See Judkins v. Ford*, 73 USPQ2d 1038, 1039 (Bd. Pat. App. & Int. 2004). A true and correct copy of that opinion is attached hereto as Exhibit G.

44. While Patent Interference No. 104,329 was pending, the Ford ‘550 Patent was also the subject of litigation pending in the United States District Court for the Northern District of Illinois. In case number 3:98-CV-5003 captioned *Newell Window, et. al v. Springs Window* (filed on January 5, 1998), Plaintiffs alleged that the Defendant Springs infringed the Ford ‘550 Patent.

45. On October 7, 1999, the Northern District of Illinois ruled that the Ford ‘550 Patent was invalid. *See Newell Window v. Springs Window*, 53 USPQ2d 1302, 1999 WL 1077882 (N.D. Ill. 1999). A true and correct copy of that ruling is attached hereto as Exhibit H.

46. The Northern District of Illinois further ruled that Judkins had abandoned, suppressed or concealed the invention of the T19 Process. In particular, the Northern District of Illinois ruled: "The 49-month delay in filing [the Patent Application] raises an inference of intent to abandon, suppress, or conceal the T19 invention; this inference is supported by Mr. Judkins' stated policy of delaying filing until he has gained financial backing. The inference shifts the burden to Springs to justify part or all of that delay with further efforts by Mr. Judkins to perfect the invention. The only justifications offered, however, relate to efforts by Mr. Judkins and Mr. Coleman to engineer and finance commercial production of the invention; these efforts do not constitute further experimentation or testing that might excuse part or all of the delay between reduction to practice and filing of the patent application. Without any grounds to delay, the court must conclude that the T19 was abandoned, suppressed, or concealed." (*Id.* at 1323.)

47. Attorney Alstadt provided testimony in the Northern District of Illinois case regarding the issue of whether Judkins suppressed or concealed the T19 Process.

48. Neither Alstadt nor Judkins disclosed to the PTO, during the pendency of the '282 Application or the '372 Application, the Northern District of Illinois's judicial finding that Judkins had abandoned, suppressed, or concealed the T19 Process.

49. Attorney Alstadt has personal knowledge of facts related to the issue of whether Judkins suppressed or concealed the T19 Process.

50. On July 2, 2001, the Federal Circuit affirmed the District Court's finding that the Ford '550 Patent was invalid. *See Newell Window v. Springs*

1 *Window*, 15 Fed. Appx. 836, 2001 WL 744460 (Fed. Cir. 2001).

2
3 51. As of July 2001, Judkins could not obtain a patent on the T19 Process,
4 because the Board had ruled that he had suppressed or concealed the invention and
5 the Ford '550 Patent had priority. At the same time, Newell (the owner of the Ford
6 '550 Patent) had no enforceable patent, because the Ford '550 Patent had been
7 ruled invalid.

8
9 52. Upon information and belief, in or around November 2001, Judkins
10 and Newell conspired to file a fraudulent lawsuit in the Western District of
11 Pennsylvania for the purpose of obtaining a patent on the T19 Process that could be
12 used by both Judkins and Newell.

13
14 53. On November 21, 2001, Judkins filed Civil Action 01-2211-GLL
15 captioned *Judkins v. Newell Window Furnishings, Inc.* in the Western District of
16 Pennsylvania, seeking review of the Board's ruling in Patent Interference No. 104,
17 329 (the "Pennsylvania Action").

18
19 54. Upon information and belief, Judkins failed to disclose in the
20 Pennsylvania Action the existence of the Northern District of Illinois's ruling that
21 Judkins abandoned, suppressed or concealed the T19 Process.

22
23 55. Upon information and belief, in or around September 2003, Judkins
24 and Newell conspired to file fraudulent papers with the Western District of
25 Pennsylvania. Specifically, Newell agreed not to contest Judkins' summary
26 judgment motion asking the Court to overturn the Board's interference ruling and
27 allow Judkins to obtain a patent for the T19 Process. In return, Judkins agreed to
28 license to Newell any patent he obtained for the T19 Process.

1 56. On September 11, 2003, Judkins filed an uncontested summary
2 judgment motion asking the Western District of Pennsylvania to vacate the Board's
3 finding that Judkins suppressed or concealed the subject matter of the '282
4 application.

5
6 57. On September 23, 2003, the Western District of Pennsylvania signed a
7 one page Proposed Order granting Judkins' September 11, 2003 motion for
8 summary judgment.

9
10 58. The September 23, 2003 Order is the same as the Proposed Order
11 submitted by Judkins as part of the September 11, 2003 summary judgment motion,
12 except that the word "Proposed" in "Proposed Order" has been stricken to read
13 "Order." A true and correct copy of the Order is attached hereto as Exhibit I.

14
15 59. The Order of the Western District of Pennsylvania states: "The Court
16 having reviewed Plaintiff's Motion for Summary Judgment and having received no
17 opposition thereto finds that Judkins did not suppress or conceal the invention of
18 the Count in each of Patent Interference Nos. 104,328 and 104,329. There being no
19 issues of material fact, and it being apparent that Plaintiff is entitled to relief, IT IS
20 ORDERED THAT: Plaintiff's Motion for Summary Judgment is granted. That
21 portion of the judgment of the Board of Patent Appeals and Interferences 104,328
22 and 104,329 finding that Judkins is not entitled to a patent containing claims 12-47
23 of Application No. 08/756,282, filed November 25, 1996, is vacated. Priority is
24 awarded to Judkins as to the Count in each of Patent Interference Nos. 104,328 and
25 104,329." *Judkins v. Ford, supra*, 73 USPQ2d, at 1040.

26
27 60. On October 1, 2003, the Board received a copy of a "Notice of Filing
28 Settlement Agreement and District Court Judgment" in Patent Interference No.

1 104,329. (*Id.*).

2
3 61. The Board determined that the proposed Motion for Summary
4 Judgment was attached to the settlement agreement and therefore known to Ford
5 and Newell prior to entering into the agreement. Ford and Newell had full
6 knowledge of what facts would be presented to the District Court. (*Id.* at 1043.).

7
8 62. The Board determined that a reasonable construction of the Settlement
9 Agreement suggests that if the District Court vacates the Board's suppression or
10 concealment holding, Ford would otherwise not contest priority being awarded to
11 Judkins. (*Id.* at 1043-44.)

12
13 63. Judkins failed to notify the Board about the pendency of the
14 Pennsylvania Action as required by 37 C.F.R. § 1.660(d). (*Id.* at 1040.)

15
16 64. Upon information and belief, Judkins intentionally failed to provide the
17 required notice to the Board in furtherance of his efforts to commit a fraud on the
18 Court and fraudulently obtain a patent covering the T19 Process. Specifically,
19 Judkins intentionally failed to notify the Board of the Pennsylvania Action in order
20 to prevent the Board from intervening in the Pennsylvania Action.

21
22 65. The Board determined that the Western District of Pennsylvania Court
23 did not have jurisdiction to require that the PTO grant a patent to Judkins for the
24 T19 process. Instead, the Pennsylvania District Court only had jurisdiction to
25 vacate the Board's final decision that Judkins suppressed or concealed, and remand
26 for further proceedings. (*Id.* at 1042-43.)

66. Nonetheless, during an April 20, 2003 conference call with the Board, Newell and Ford informed the Board that they no longer contested priority being granted to Judkins in Interference No. 104,329. The Board therefore had no choice but to grant Judkins priority in Interference No. 104,329. (*Id.* at 1039.)

67. The '372 Application that is the subject of the Feb. 7 letter claims priority to the '282 Application that was the subject of Patent Interference No. 104,329.

68. On information and belief, the '372 Application that is the subject of the Feb. 7 letter claims, *inter alia*, a window shade made by the T19 Process.

69. On information and belief, Judkins has knowledge that any patent claims based upon the T19 Process are invalid or unenforceable.

Count I

Declaratory Judgment of Invalidity

70. The allegations of paragraphs 1 through 69 above are incorporated by reference as if set forth fully herein.

71. Plaintiff has a tabbed cellular product that it desires to market in the United States.

72. Judkins has previously accused certain of HTW's tabbed cellular products of infringing the claims of the '634 Patent.

Declaratory Judgment Of Unenforceability

Count IV**Unfair Competition under § 43(a) of the Lanham Act**

88. The allegations of paragraphs 1 through 87 above are incorporated by reference as if set forth fully herein.

89. Plaintiff HTW has existing contracts and potential future contracts for the sale of its POLARIS® product to various customers throughout the United States.

90. Upon information and belief, Judkins, by and through his attorney Alstadt, has made false and misleading statements to potential and existing HTW customers about HTW's POLARIS® product. Specifically, Judkins has stated that the POLARIS® product infringes the claims of the '372 Application. These statements are false because, *inter alia*, any patent that may issue from the '372 Application is invalid and unenforceable.

91. The false statements made by Judkins actually deceive and/or have the tendency to deceive a substantial segment of the intended audience.

92. The deception created from Judkins' false statements is material, in that it is likely to influence the purchasing decisions of HTW's potential and existing customers.

93. Judkins has caused his false statements to enter interstate commerce.

94. HTW has been or is likely to be injured by Judkins' false statements by direct diversion of sales from HTW to Judkins (and companies affiliated with

Judkins) and by a lessening of goodwill associated with HTW and its products.

95. Judkins has made his false statements in bad faith by, *inter alia*, representing to the marketplace that HTW infringes claims of a patent application that he knows to be invalid.

Count V

Violation of California's Unfair Competition Act

96. The allegations of paragraphs 1 through 95 above are incorporated by reference as if set forth fully herein.

97. The actions of Judkins alleged herein, including false statements regarding HTW's double cell POLARIS® product and misleading HTW's potential customers into believing that HTW's double cell POLARIS® product was infringing on Judkins' '372 Application, constitute unfair, unlawful, and/or fraudulent business practices in violation of Sections 17200, *et seq.* of the California Business and Professions Code.

98. Judkins is engaged in unfair, unlawful, and/or fraudulent business practices by, among other things, making numerous misrepresentations regarding his claim that his '372 Application covers HTW's double cell POLARIS® product and threatening HTW's potential customers. These unfair business practices have caused and continue to cause, damage and injury to HTW, the exact amount of which is not presently known. Further, HTW is informed and believes, and on that basis alleges, that Judkins has profited as a result of these unfair business practices in an amount which is presently unknown.

Count VII

Negligent Interference with Prospective Economic Advantage

106. The allegations of paragraphs 1 through 105 above are incorporated by reference as if set forth fully herein.

107. Plaintiff HTW has relationships with various existing and potential customers which will likely result in future sales of the POLARIS® product and other future economic benefit to HTW.

108. Upon information and belief, Judkins has negligently conducted himself in a manner to disrupt these relationships.

109. Judkins' conduct has resulted in the actual disruption of relationships between HTW and existing and potential customers.

110. HTW has suffered and will continue to suffer damages caused by Judkins' conduct.

PRAYER FOR RELIEF

Wherefore, Plaintiff HTW prays for judgment as follows:

1. That U.S. Patent No. 7,159,634 is invalid;
2. That U.S. Patent No. 7,159,634 is not infringed by HTW's POLARIS® products;

3. That U.S. Patent No. 7,159,634 is unenforceable;

4. For a temporary restraining order and preliminary and permanent injunction enjoining Judkins, and those persons acting in active concert or participation with him, from making any statements to any party regarding whether HTW's POLARIS® infringes any patent on which Judkins is a named inventor;

5. That Judkins' behavior constitutes unfair competition as defined in §43(a) of the Lanham Act;

6. That Judkins' behavior constitutes unfair competition as defined by California state law;

7. That Judkins intentionally interfered with HTW's prospective economic advantage;

8. That Judkins negligently interfered with HTW's prospective economic advantage;

9. For all actual damages as allowed by law;

10. For all reasonable attorneys' fees as allowed by law;

11. For all costs of court; and

12. For any such other relief that this Court deems just and proper.

1 DATED: February 14, 2007

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JOSEPH M. KUO
MATTHEW D. KELLAM
OLSON & HIERL, LTD.

PAUL L. GALE
JENECE D. SOLOMON
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By: Paul L. Gale
Paul L. Gale
Attorneys for Plaintiff
HT Window Fashions, Corp.

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DEVEN, CA 94015-8792

DEMAND FOR JURY TRIAL

Plaintiff HTW demands a trial by jury for all claims triable by jury pursuant to Fed. R. Civ. P. 38 and Civil L.R. 38-1.

DATED: February/4, 2007

ARNE M. OLSON
JOSEPH M. KUO
MATTHEW D. KELLAM
OLSON & HIERL, LTD.

PAUL L. GALE
JENECE D. SOLOMON
ROSS, DIXON & BELL, LLP

By: Paul L. Gale
Paul L. Gale
Attorneys for Plaintiff
HT Window Fashion, Corp.

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31000 Plaza, Suite 1200
Irvine, CA 92614-8592

MAR 31 '05 14:09 FR BUCHANAN INGERSOLL

TO 92 258394661 P.02

Buchanan Ingersoll PC

ATTORNEYS

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T 412 562 8800
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March 31, 2005

VIA FACSIMILE: 626-839-8861
AND REGULAR MAIL

Steve Huang
H T Window Fashions
770 S. Epperson Drive
Industry, California 91748

Dear Mr. Huang:

We represent Ren Judkins, the inventor of tabbed window coverings. It has come to our attention that your company has been offering to sell a tabbed cellular product in the marketplace.

Mr. Judkins currently has several pending patent applications relating to tabbed cellular window coverings. Action on these applications was delayed by the United States Patent and Trademark Office because of a dispute with Newell over whether Mr. Judkins or James Ford was entitled to a patent on this product. In September 2003, the United States District Court in Pittsburgh determined that Mr. Judkins was the first inventor of the tabbed cellular disclosed in Mr. Ford's United States Patent Nos. 5,701,940 and 5,692,550. As a result of the Court decision, the United States Patent and Trademark Office Board of Patent Appeals and Interferences recently ruled that Mr. Ford is not entitled to these patents and has instructed a patent examiner to review Mr. Judkins' pending application for the tabbed cellular product. I spoke to the patent examiner a week ago about the application. Based upon that conversation, I expect that a patent will issue to Mr. Judkins from this application within a few months.

We have compared the claims of Mr. Judkins' application to a sample and drawings of your products supplied to us by Mr. Judkins and his licensee Flexo Solutions. Your product is within those claims. Therefore, the sale, offer for sale and use of your tabbed cellular products will infringe the patent that issues to Mr. Judkins.

In the event that you or any of your customers are selling or offering to sell a tabbed cellular product that is within the claims of the patent that issues to Mr. Judkins, legal action may be initiated without further notice against all who are selling the tabbed cellular product to stop the infringement.

Pennsylvania :: New York :: Washington, DC :: Florida :: New Jersey :: Delaware :: California

Mar. 31 2005 02:16AM P3/4

FAX NO. :

FROM
Exhibit A
Page 23

MAR 31 '05 14:09 FR BUSHNAN INGERSOLL

TO 98-6834861

P.03

March 31, 2005

Page - 2 -

To avoid future liability, we encourage you to cease and desist the sale of the tabbed cellular product.

If you have any questions, please call me.

Very truly yours,


Lynn J. Alstadt

*** TOTAL PAGE.03 ***

Mar. 31 2005 02:15AM P4/4

FRAX NO. :

FROM :

Exhibit A

Page 24

Buchanan Ingersoll PC
ATTORNEYS

Lynn J. Alstadt
412 562 1632
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June 2, 2006

Joseph M. Kuo, Esq.
Olson & Hierl, Ltd.
20 North Wacker Drive
36th Floor
Chicago, Illinois 60606

RECEIVED
JUN 06 2006
OLSON & HIERL, LTD

Dear Mr. Kuo:

On March 31, 2005, I wrote to HT Window Fashions advising them that my client had a pending patent application for a tabbed cellular window covering product. I further told your client that the tabbed cellular products we have seen at the trade show will infringe the claims which issue from this pending application. I can now advise you that the patent application has been allowed and the issue fee has been paid. Enclosed are the claims which have been allowed in the application. We anticipate that the patent will issue within the next few weeks.

In your letter to me dated April 21, 2005, you requested a copy of the prosecution history and the settlement agreement with Ford. That settlement agreement is confidential and will not be provided. I am enclosing a copy of the District Court Order awarding priority. I would be happy to provide the prosecution history of this application if you agree to pay the copying costs.

Upon review of the enclosed allowed claims you will find that your client's tabbed cellular product is within these allowed claims. We, therefore, demand that your client stop selling and offering to sell tabbed cellular window covering products. The fulfillment of any orders your client receives now will constitute infringement of the patent when the product is delivered.

Very truly yours,


Lynn J. Alstadt

LJA/bem

Enclosures

cc: Ren Judkins



(12) **United States Patent**
Judkins

(10) **Patent No.:** **US 7,159,634 B1**
(45) **Date of Patent:** ***Jan. 9, 2007**

(54) **PLEATED AND CELLULAR MATERIALS**

(75) **Inventor:** **Ren Judkins**, 46 Newgate Rd.,
Pittsburgh, PA (US) 15202

(*) **Notice:** Subject to any disclaimer, the term of this
patent is extended or adjusted under 35
U.S.C. 154(b) by 1019 days.

This patent is subject to a terminal dis-
claimer.

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(21) **Appl. No.:** **09/017,392**

(22) **Filed:** **Feb. 2, 1998**

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Related U.S. Application Data

(63) Continuation-in-part of application No. 08/756,282,
filed on Nov. 25, 1996, which is a continuation of
application No. 08/412,875, filed on Mar. 29, 1995,
now Pat. No. 5,630,898.

* cited by examiner

Primary Examiner—Blair M. Johnson

(74) *Attorney, Agent, or Firm*—Buchenan Ingersoll PC

(51) **Int. Cl.**
E06B 3/48 (2006.01)

(52) **U.S. Cl.** 160/84.05; 156/197; 428/116

(58) **Field of Classification Search** 160/84.01,
160/84.04, 84.05; 156/193, 197; 428/116,
428/118

See application file for complete search history.

(56) **References Cited**

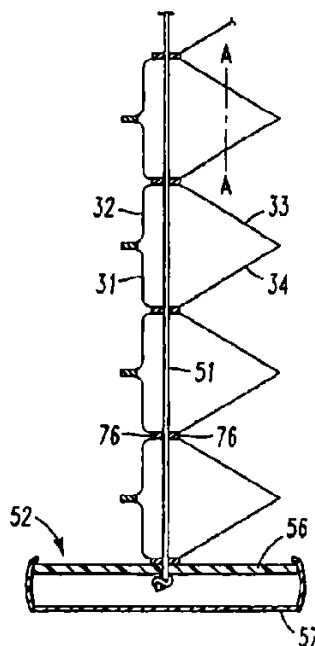
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(57) **ABSTRACT**

A tabbed honeycomb structure or pleated panel is made from
a stack of collapsed multi-cellular material. The stack is split
at bond lines thereby forming the panels of pleated or
honeycomb material having a joint tab on one face. The
tabbed, honeycomb material is attached between a headrail
and a bottomrail to form a window covering.

46 Claims, 5 Drawing Sheets

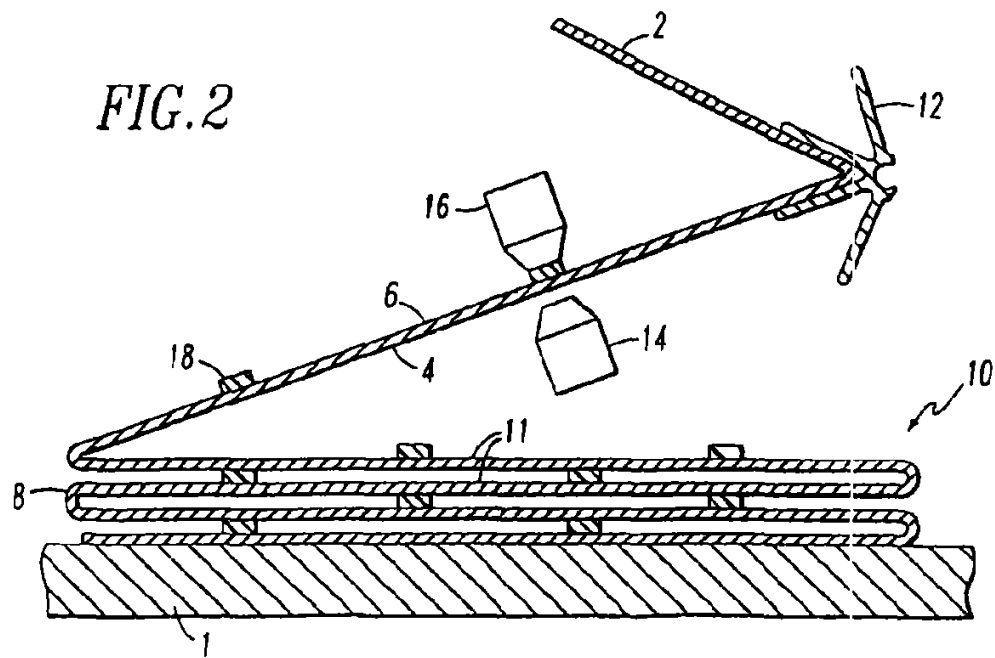
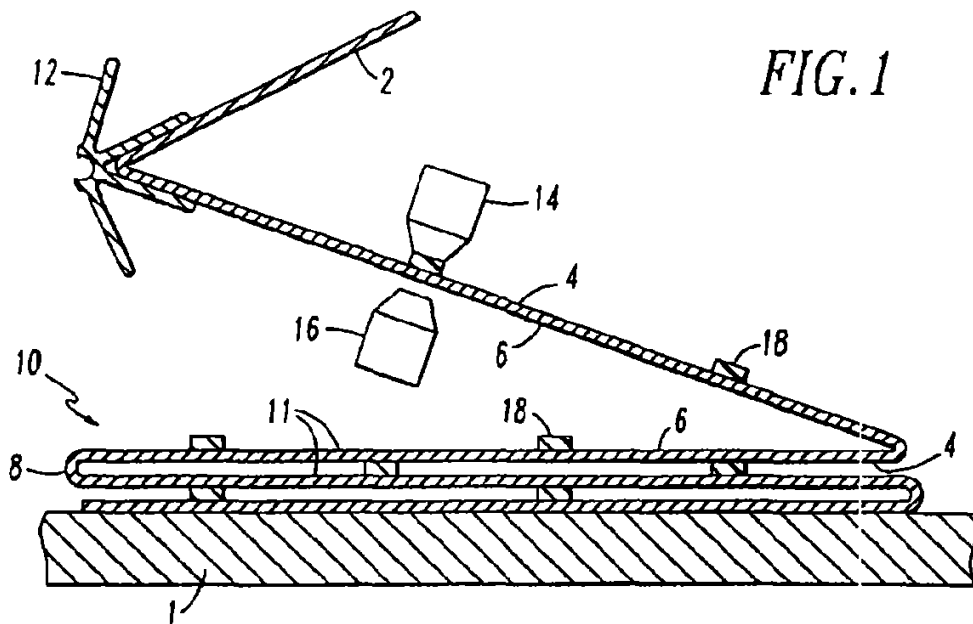


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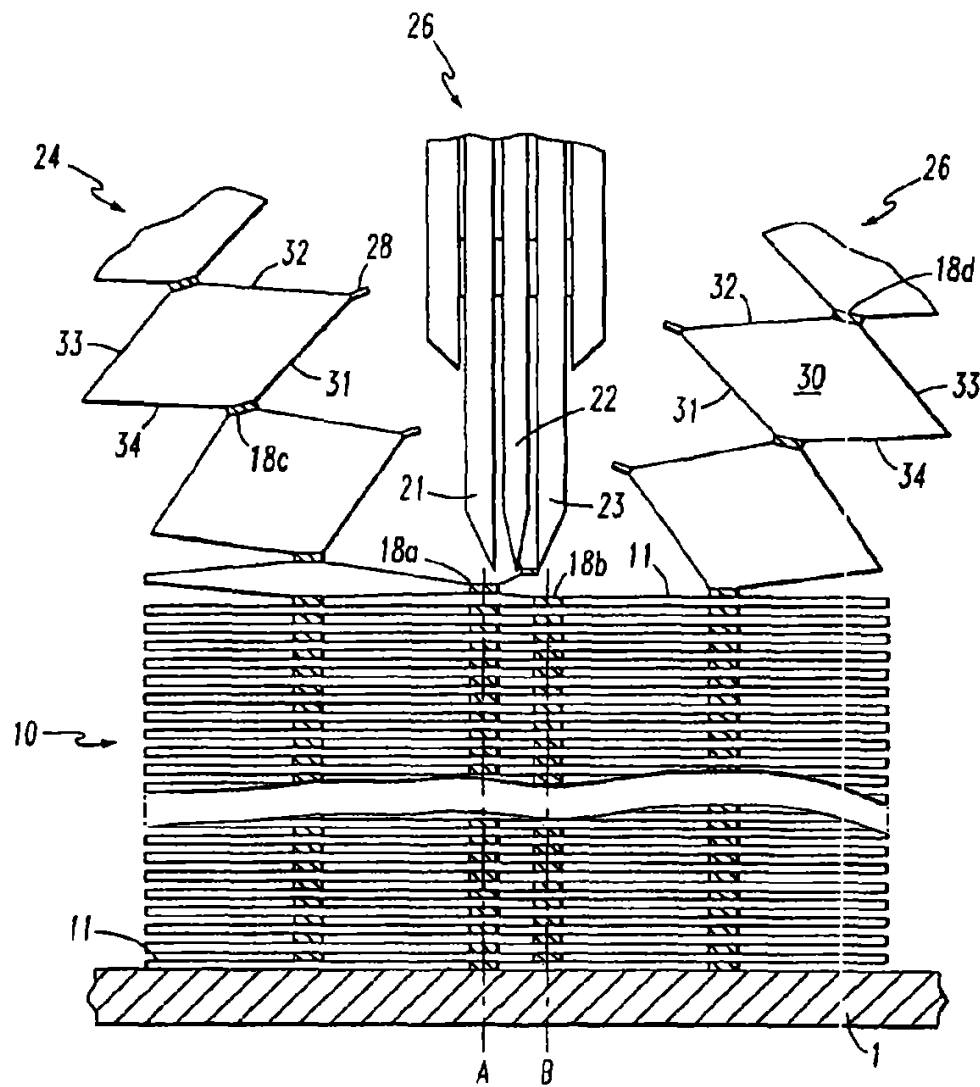


FIG. 3

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FIG. 4

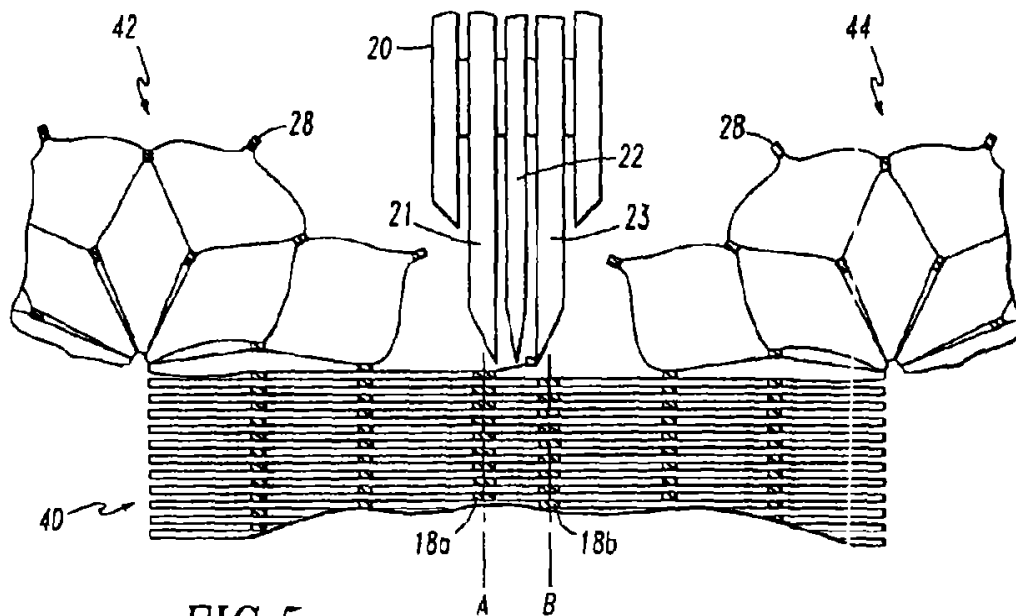
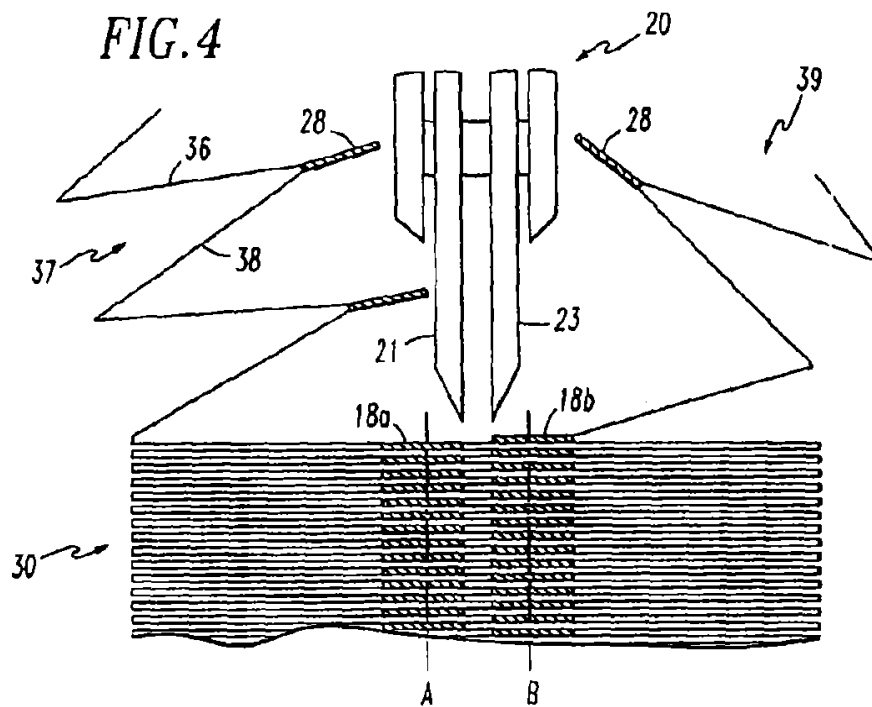


FIG.5

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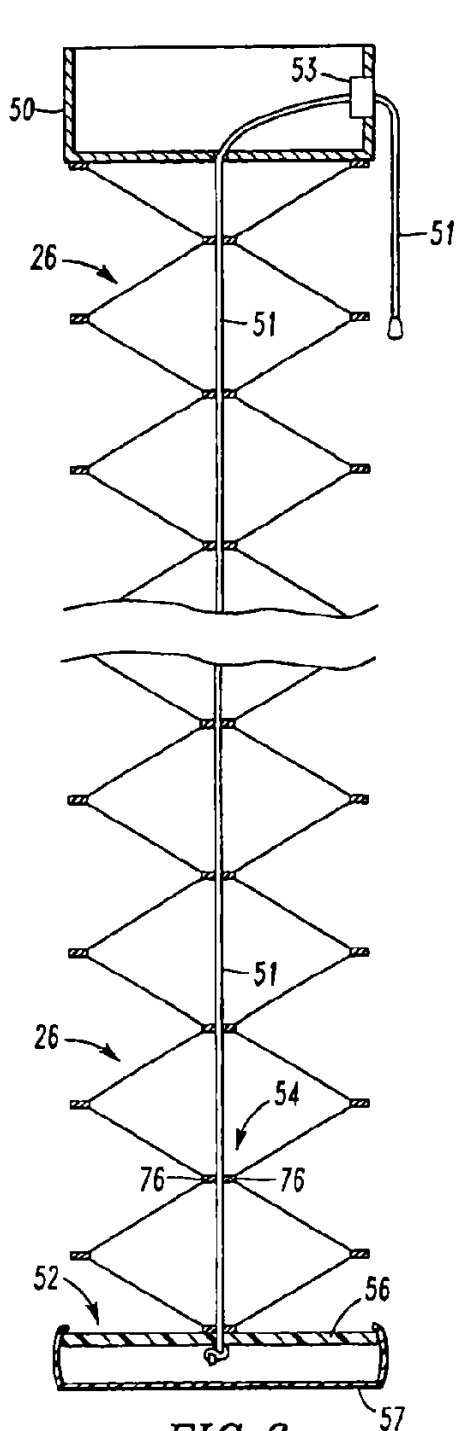


FIG. 6

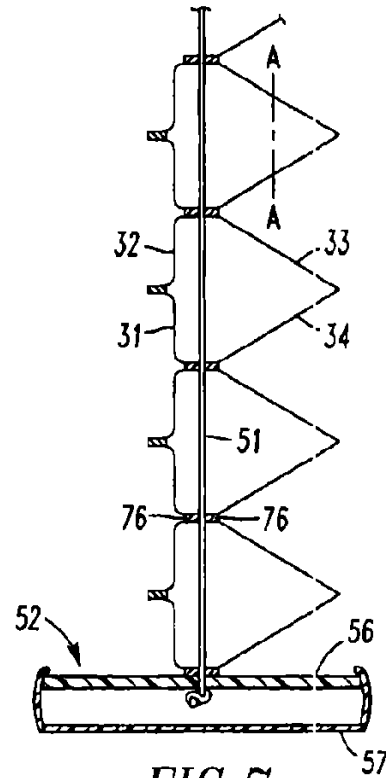


FIG. 7

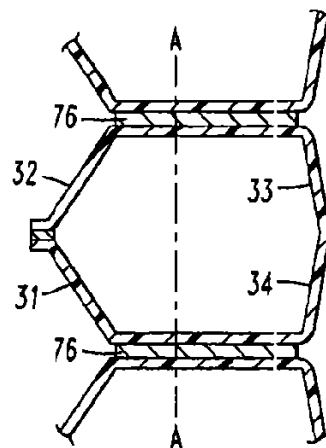


FIG. 8

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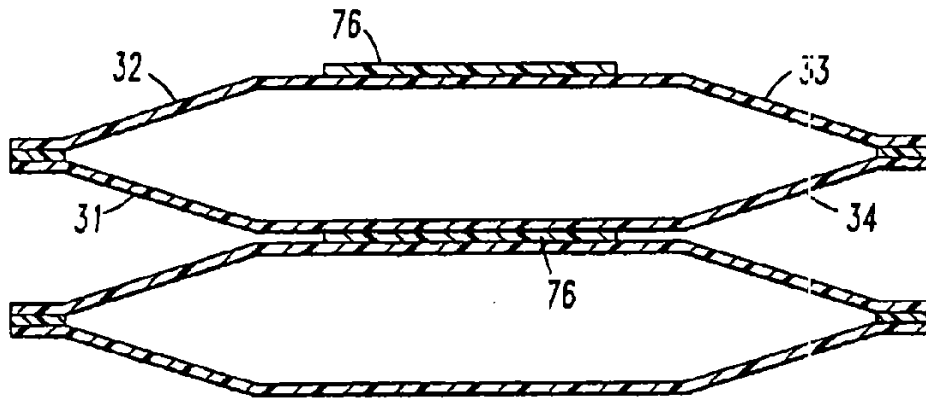


FIG. 9

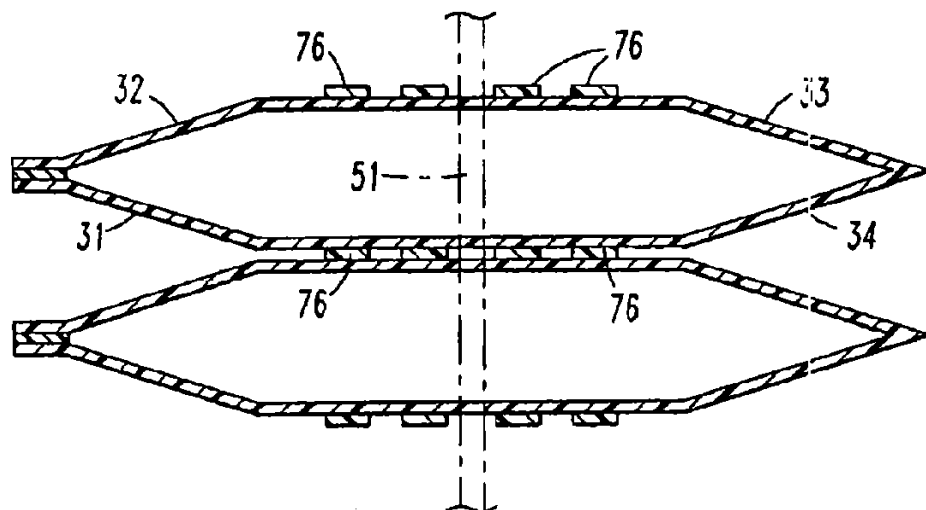


FIG. 10

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PLEATED AND CELLULAR MATERIALS

CROSS-REFERENCE TO RELATED APPLICATIONS

This is a continuation in part of U.S. patent application Ser. No. 08/756,282 filed Nov. 25, 1996, which is a continuation of U.S. patent application Ser. No. 08/412,875, filed Mar. 29, 1995, and issued as U.S. Pat. No. 5,630,898 on May 20, 1997.

BACKGROUND OF THE INVENTION

1. Field of the Invention

This invention relates to a tabbed and pleated cellular material and method for the manufacture thereof and more particularly to a window covering which contains this tabbed and pleated cellular material.

2. Description of the Prior Art

There are two basic types of folded window coverings. A first pleated type consists of a single layer of corrugated material. The other is a more complex cellular type where pleated layers are joined or folded strips are stacked to form a series of collapsible cells. This latter type is known to have favorable thermal insulation properties because of the static air mass which is trapped between the layers of material when the cells are in the expanded position. The single-layer type, on the other hand, is favored for its appearance in some cases, and is less expensive to manufacture. There is also a tabbed single layer of corrugated material which is disclosed in my U.S. Pat. No. 4,974,656. The tabbed single layer of pleated material has been sold in window coverings and been commercially successful. Consequently, there is a market for a window shade made with a tabbed cellular material.

There are two basic approaches to making cellular products and tabbed panels from a roll of fabric material. The first method pleats or bonds the material transverse to the length of the roll and the second method pleats or bonds longitudinally along its length.

The output of the transverse method cannot be wider than the roll width of the original material. The longitudinal method is limited in the types of patterns that can be printed on the material because alignment is random. The transverse methods have been limited to a single layer, a single tabbed layer or a triple layer where there are three continuous surfaces that create a panel of double cells.

There is a need to have a transverse process that can make a panel of single cells. There is also a need to increase the speed of production output of single, double and triple layers.

There are several methods of producing the cellular shades. Most similar to the pleated, single-panel method is Anderson U.S. Pat. No. 4,685,986. This method joins together two single-panel pleated lengths of material by adhesively bonding them together at opposing pleats. Other methods depart from this Anderson patent by joining together a series of longitudinally folded strips, rather than continuous sheets of pleated material. Such methods are shown in Colson U.S. Pat. No. 4,450,027, and in Anderson U.S. Pat. No. 4,676,855. In the Colson patent, strips of fabric are longitudinally folded into a U-shape and adhered on top of one another, whereas in the Anderson patent these strips are Z-shaped and are adhered in an interlocking position.

In U.S. Pat. No. 5,043,038 Colson discloses a method of cutting a honeycomb structure longitudinally to divide them into two tabbed single layer pleated panels. That honeycomb

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structure was formed from U-shaped strips as taught in Colson's U.S. Pat. No. 4,450,027 by a process of winding the foldable material around a base apparatus, applying glue to one face of the material and adhering each layer to the adjacent layer. This method tends to cause the tab to wrinkle because the stack is wrapped on a slightly curved mandrel. Also, because the material layers are wound in a stack, the length of the panels of final product are limited to the height of the wrapped stack and the ends of the stack are wasted.

Another method for making cellular shades is disclosed in U.S. Pat. Nos. 5,015,317; 5,106,444 and 5,193,601 to Corey et al. In that process fabric material is run through a production line that first screen prints the fabric and then applies thermoplastic glue lines at selected intervals. The fabric is then pleated, stacked, and placed in an oven to both set the pleats and bond the material at the glue lines.

There is a need for a method to utilize the current transverse processing equipment technology to make a larger variety of single and multi-layer panels at a faster rate.

SUMMARY OF THE INVENTION

The present method overcomes the problems and achieves the objectives indicated above by providing a method of manufacturing a pleated shade or a honeycomb structure by a means of splitting honeycomb or multicellular material into two or more tabbed, pleated panels or tabbed, cellular panels.

According to the teachings of the present invention, a stack of folded fabric is bonded to form a honeycomb structure having a series of cells connected together along bond lines. An interface region is present between adjacent cells which forms the bridge between horizontally adjacent stacks of cells. At least one bond line applied between adjacent fabric walls defines each interface region. These interface regions are split to form separate tabbed, pleated panels or separate panels of cells having tabs on one face between each pair of pleats. These tabs extending between each pleated panel or between individual cells, as the case may be, extend at least $\frac{1}{16}$ " in length. To simplify handling and to create a uniform appearance the tabs are identical in size resulting from a straight-line split along a distinct perpendicular plane, but the invention is not limited to this.

The tabbed cellular material is attached between a headrail and a bottomrail to form a window covering. Lift cords are routed from the bottomrail, through the cellular material and through the headrail for raising and lowering the window covering.

BRIEF DESCRIPTION OF THE DRAWINGS

FIGS. 1 and 2 are diagrams showing how the honeycomb stack is formed.

FIG. 3 is a diagram showing a triple cell honeycomb stack being split into two tabbed honeycomb panels according to the teachings of the present invention.

FIG. 4 is a diagram showing a double cell honeycomb stack being split into tabbed panels.

FIG. 5 is a diagram of a five cell honeycomb stack being split into two double honeycomb panels having tabs which are formed on one face of both panels.

FIG. 6 is a side view of a window covering made from tabbed, single cell material.

FIG. 7 is a side view of similar to FIG. 6 showing the lower portion of a window covering made from prismatic or D-shaped, tabbed, single cell material.

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FIG. 8 is a side sectional view of another D-shaped, tabbed, single cell material.

FIG. 9 is a side sectional view of two tabbed cells showing attachment of adjacent cells by a single strip of adhesive.

FIG. 10 is a side sectional view of two tabbed cells showing attachment of adjacent cells by several lines or beads of adhesive and a preferred location of a lift cord shown in dotted line.

DESCRIPTION OF THE PREFERRED EMBODIMENTS

Referring to FIGS. 1 and 2, I provide a sheet of pleated fabric 2 which is folded on work surface 1 to form a fabric stack 10. Pleated fabric 2 is delivered to the work surface by a sprocket or other feed mechanism 12 which draws the fabric from a source of supply which is not shown. Glue applicators 14 and 16 apply bond lines 18 of hot melt glue on a surface 4 of the fabric. When the fabric is in the position shown in FIG. 1 surface 4 is facing upward. After the fabric has been laid from right to left across the length of stack 10, the fabric is folded as shown in FIG. 2. The movement of the stack relative to the fabric being supplied folds the fabric 2 back over the stack forming a pleat 8. Now surface 4 is facing down and opposite surface 6 is facing up. In that position glue applicator 16 applies lines of glue on surface 6. The fabric is laid across the stack from left to right. The process is repeated until a complete stack of fabric 10 has been created. That stack will then have sets of bond lines in vertical planes transverse to the pleat faces. Then, the stack is placed in an oven to melt the glue and bond the pairs of opposing faces together. If desired, irons could be provided to press the pleats after a selected number of passes. Although I prefer to create bond lines using an adhesive, particularly a hot melt adhesive, it is also possible to create the bond lines using a heat welder. After each pair of opposed pleat faces is laid they are welded together. I have found that a heat welder will bond two overlying sheets without affecting a third sheet below the sheets which are bonded.

In FIGS. 1 and 2 I show the adhesive lines being applied to pleated fabric. If desired, one can apply the adhesive to the fabric first and then pleat the fabric.

Referring now to FIG. 3, a splitter 20 is positioned above the stack so that blades 21 and 23 are positioned directly above adjacent glue lines 18a and 18b. Splitter 20 is then moved through the stack thereby cutting the stack along the glue lines. These cuts form two single cell honeycomb panels 24 and 26. Preferably, the knife cuts between two planes of glue lines A and B so that after cutting the set of glue lines 18a in plane A are in one panel 24 and the set of glue lines 18b in plane B are in a second panel 26. Alternatively, the knife could cut through a plane of glue lines so that a portion of each glue line is in each panel. Each cell 30 has four primary side walls 31, 32, 33 and 34 and two parallel walls to which adjacent cells are attached forming a six-sided polygon shown in FIG. 3. Because of the method of manufacture a tab 28 has been formed between adjacent pleat faces or cell sidewalls 32 and 33 and contrast opposite side walls 33 and 34 meet to form a standard pleat, fold or crease. Adjacent cells are connected together by glue lines 18c and 18d at attachment zones, or interconnection zones as shown by FIG. 3. I prefer to provide a standard pleat face of $\frac{1}{2}$ " with a $\frac{1}{4}$ " bridge formed by glue lines 18c and 18d. Preferably the tab has a width of $\frac{1}{16}$ " creating an overall width of $\frac{3}{16}$ ". The region between glue lines 18 and 18b is preferably $\frac{1}{8}$ ". Thus, the width of stack 10 would be $\frac{3}{4}$ " to

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make two panels of this preferred fabric size. Other standard sizes of pleat faces ranging from $\frac{1}{4}$ " to about 1" can easily be made with this process. Indeed, the pleats can be any desired size.

I prefer that cutter 20 have two outside knives 21 and 23 and one inside knife as shown in FIG. 3. The use of two outside knives allows for a better curing of the glue lines and for a greater tolerance for error of a glue plane placement and thickness. The center knife cuts the accordion pleat remnant in half so that the resulting smaller strips can easily be drawn off by vacuum.

FIG. 4 shows a double cell honeycomb stack 30 being split. The cells are formed by sets of glue lines 18a and 18b in planes A and B. The double cells are split by knives 21 and 23 along a perpendicular plane through the glue lines. This method forms two panels of pleated material 32 and 34 each having a joint tab 28 on one face between each pair of adjacent pleat faces 36 and 38. The joint tabs 28 extending between each pair of pleats preferably should measure at least $\frac{1}{16}$ " in length.

FIG. 5 is a diagram of a five-cell honeycomb stack 40 being split. The five-cell honeycomb stack is split along a cutting plane parallel to the planes A and B containing glue lines 18a and 18b. This method forms two panels 42 and 44 of double cell honeycomb material having tabs 28 on one face. The splitter shown in FIG. 5, generally designated as 20, is comprised of a center blade 22 which pierces the stack 40 and two blades 21 and 23 that cut the interior edge of each alternating adhesive bond lines 18a and 18b.

Although I have shown the tabs being formed from a single glue line, tab 28 may be formed by either means of a single or a double bond or line of adhesive sometimes called an adhesive strip or glue bead depending upon how the glue is applied. The joint tabs in the separated panels in the figures are the same size. However, this is not necessary. Also, I have shown the glue lines extending to the ends of the tabs. But, this is not necessary.

A major advantage of the present method over the prior art is the gluing machine can make two, tabbed, pleated layers; two, tabbed, single-cells; or two tabbed, double-cell layers by changing the pump pressure and the orifice configuration on the glue heads. Such a change can be made in less than hour. Since the splitter is much faster and simpler than the gluing process, it is a less expensive machine and can handle the output of 3 or 4 gluing machines.

The stack of the present invention can be formed on several types of prior art pleating machines modified to have glue heads and to fold the fabric into the stack after gluing, or by simply modifying the glue heads on machines which have them to place more glue lines at different intervals. Such modified machines should be able to put out nearly twice the effective output than they did prior to modification.

As shown in FIG. 6, a tabbed, cellular panel 26 is attached between a headrail 50 and bottomrail 52. The uppermost cell is attached to the headrail. An insert or slat 56 fits through the lowermost cell and that assembly is attached to the main housing 57 of the bottomrail 52. Lift cords or pullcords 51 extend from the bottomrail 52, also called the lower rail assembly through the cellular material 26 and into the headrail 50, also called the upper rail assembly. The lift cords may pass through a cord lock 51 and the front face of the headrail as shown or may be attached to a tube lift (not shown). Typically, at least two lift cords are used for each window covering. Each lift cord 51 passes through the centerline of the cells with the glue lines 76 being approximately equidistant from that centerline. The glue lines extend the full width of the cellular material and define the

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front and rear limits or edges of the interconnection zones or the middle sides of the six-sided cells. Adjacent cells may be attached by a single strip of adhesive 76 as shown in FIG. 9 or by several glue lines 76 as shown in FIG. 10. I prefer to provide at least two spaced apart glue lines forming at least two spaced apart attachment zones so that the lift cord may pass through holes cut between them as shown in FIGS. 6 and 10. With that arrangement drilling the cord holes is much easier. The hollow drill bit is less likely to become clogged and the glue lines act as guides to direct the drill bit through the fabric between them.

The cells may be symmetrical like those shown in FIG. 6 or nonsymmetrical. In the embodiment shown in FIG. 7, the cells have a prismatic shape or D-shape. The interior angle defined between the front upper side 33 and the front lower side 34 is less than the interior angle between the rear upper side 32 and the rear lower side 31. In the symmetrical cells shown in FIG. 6, these angles are approximately equal. The symmetrical cells in FIG. 6 are connected so that a centerline through interconnection zone 54 will be collinear with a centerline through the cells. However, in the cell shapes of FIGS. 7 and 8, a centerline through the interconnection zone is rearward or forward of a centerline through the cells. The centerline through the cells is indicated by dotted line A—A in FIGS. 7 and 8. In all of the cellular structures shown in the drawings, the interconnection zones in each cellular panel are parallel to one another and equal in length. Consequently, the panel will have a uniform appearance from top to bottom when hung.

A variety of fabrics could be used to make the cellular structure. However, the industry has tended to use less expensive, non-woven fabrics made from synthetic materials, particularly polyester fabrics. Those skilled in the art will also recognize that several different adhesives could be used. One suitable adhesive is moisture cured cross-linking polyurethane adhesive. One could also use a hot-melt thermoplastic polyester UV-stabilized adhesive.

Even though I prefer to make the tabbed cellular structure in the manner illustrated and described here, other techniques could be used. Sonic welding could be used rather than adhesives. The stack could be constructed and cut to create only one cellular structure and fabric pieces rather than two panels of fabric. Strips of a hot melt glue could be applied to the fabric before the fabric is folded to form the stack.

Although I have shown certain present preferred embodiments of my method and the pleated and honeycomb structures made therefrom, it should be distinctly understood that my invention is not limited thereto, but may be variously embodied within the scope of the following claims.

I claim:

1. A cellular shade for covering a window, said shade comprising:

- a plurality of interconnected fabric cells, wherein each cell within said plurality of cells is comprised of a nonwoven fabric and has:
 - a front side and a rear side;
 - a crease forming a tip on said front side;
 - an upper cell wall extending from said tip and having a rear edge, said upper cell wall having an upper surface and an interior surface and having a longitudinal centerline equidistant along said upper cell wall from said tip and from said rear edge of said upper cell wall;
 - a lower cell wall extending from said tip and having a rear edge, said lower cell wall having a lower surface and an interior surface, said lower cell wall and said upper cell wall being substantially equal in length; and

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a fin on said rear side, wherein said fin is formed by joining a first portion of said interior surface of said upper cell wall adjacent said rear edge of said upper cell wall with a first portion of said interior surface of said lower cell wall adjacent said rear edge of said lower cell wall;

a high temperature adhesive on substantially all cells of said plurality of cells, said high temperature adhesive for connecting each cell of said substantially all cells to an adjacent cell of said plurality of cells;

an upper rail assembly, said upper rail assembly attached to an uppermost cell of said plurality of cells;

a lower rail assembly, said lower rail assembly attached to a lowermost cell of said plurality of cells; and

a pulldord, said pulldord for raising and lowering one of said upper and lower rail assembly in relation to the other of said upper and lower rail assembly.

2. The cellular shade of claim 1 wherein said high temperature adhesive extends longitudinally along said upper surface of said upper cell wall of said cell.

3. The cellular shade of claim 2, wherein said first portion of said interior surface of said upper cell wall adjacent said rear edge of said upper cell wall is joined with said first portion of said interior surface of said lower cell wall adjacent said rear edge of said lower cell wall by a high temperature adhesive.

4. The cellular shade of claim 3, wherein when said cellular shade is extended, a second portion of said interior surface of said upper cell wall and a second portion of said interior surface of said lower cell wall define a six-sided polygon, said six-sided polygon having an upper rear side, an upper middle side, an upper front side, a lower front side, a lower middle side, and a lower rear side.

5. The cellular shade of claim 4, wherein said fin, said upper middle side and said lower middle side are substantially in parallel arrangement.

6. The cellular shade of claim 4, wherein an interior angle defined by said upper front side and said lower front side is less than an interior angle defined by said upper rear side and said lower rear side.

7. The cellular shade of claim 4, wherein an interior angle defined by said upper front side and said lower front side is approximately equal to an interior angle defined by said upper rear side and said lower rear side.

8. The cellular shade of claim 5, wherein said upper middle side is approximately equal in length to said lower middle side.

9. The cellular shade of claim 8, wherein said high temperature adhesive on substantially all cells of said plurality of cells is on said upper surface of said upper cell wall of each cell of said substantially all cells and defines an interconnection zone for each cell of said substantially all cells, said interconnection zone having an interconnection centerline, and wherein said interconnection centerline is located forward of said longitudinal centerline on said upper surface.

10. A cellular shade for covering a window, said shade comprising:

- a plurality of longitudinally extending, substantially parallel interconnected fabric cells, wherein substantially all cells within said plurality of cells have for each cell:
 - a front side and a rear side;
 - a crease forming a tip on said front side;
 - an upper cell wall extending from said crease and having a rear edge, said upper cell wall having a longitudinal

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center line equidistant along said upper cell wall from said crease and from said rear edge of said upper cell wall;

a lower cell wall extending from said crease and having a rear edge, said lower cell wall and said upper cell wall being substantially equal in length; and

a fin on said rear side, wherein said fin is formed by joining a portion of said upper cell wall adjacent said rear edge of said upper cell wall with a portion of said lower cell wall adjacent said rear edge of said lower cell wall; and

material located on at least one of said upper cell wall and said lower cell wall for attaching each cell of said plurality of cells to an adjacent cell of said plurality of cells.

11. The cellular shade of claim 10, wherein said material for attaching includes an adhesive strip.

12. The cellular shade of claim 11, wherein said adhesive strip passes through said longitudinal center line of said upper cell wall.

13. The cellular shade of claim 10, wherein said material for attaching includes at least one glue bead.

14. The cellular shade of claim 13, wherein said at least one glue bead passes through said longitudinal center line of said upper cell wall.

15. The cellular shade of claim 10, wherein said material for attaching includes a glue bead on each side of said longitudinal center line of said upper cell wall.

16. The cellular shade of claim 15, wherein said glue beads are approximately equidistant along said upper cell wall from said longitudinal center line of said upper cell wall.

17. The cellular shade of claim 10, wherein said portion of said upper cell wall adjacent said rear edge of said upper cell wall is joined with said portion of said lower cell wall adjacent said rear edge of said lower cell wall by a glue bead.

18. The cellular shade of claim 10, wherein said portion of said upper cell wall adjacent said rear edge of said upper cell wall is joined with said portion of said lower cell wall adjacent said rear edge of said lower cell wall by an adhesive strip.

19. The cellular shade of claim 10, wherein said portion of said upper cell wall adjacent said rear edge of said upper cell wall is joined with said portion of said lower cell wall adjacent said rear edge of said lower cell wall by sonic welding.

20. The cellular shade of claim 10, wherein when said cellular shade is extended, the interior surfaces of said upper cell wall and said lower cell wall define a six-sided polygon, said six-sided polygon having an upper rear side, an upper middle side, an upper front side, a lower front side, a lower middle side, and a lower rear side.

21. The cellular shade of claim 20, wherein said fin, said upper middle side and said lower middle side are substantially in parallel arrangement.

22. The cellular shade of claim 20, wherein an interior angle defined by said upper front side and said lower front side is less than an interior angle defined by said upper rear side and said lower rear side.

23. The cellular shade of claim 20, wherein said upper middle side is approximately equal in length to said lower middle side.

24. A cellular shade for covering a window, said shade comprising:

a plurality of longitudinally extending interconnected fabric cells, wherein each cell within said plurality of cells has:

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a front side and a rear side;

a crease forming a tip on said front side;

an upper cell wall extending from said tip and having a rear edge, said upper cell wall having an upper surface and an interior surface and having a longitudinal center line equidistant along said upper cell wall from said tip and from said rear edge of said upper cell wall;

a lower cell wall extending from said tip and having a rear edge, said lower cell wall having a lower surface and an interior surface, said lower cell wall and said upper cell wall being substantially equal in length; and

a fin on said rear side, wherein said fin is formed by joining a first portion of said interior surface of said upper cell wall adjacent said rear edge of said upper cell wall with a first portion of said interior surface of said lower cell wall adjacent said rear edge of said lower cell wall;

an adhesive on substantially all cells of said plurality of cells, said adhesive for connecting each cell of said substantially all cells to an adjacent cell of said plurality of cells;

an upper rail assembly, said upper rail assembly attached to an uppermost cell of said plurality of cells;

a lower rail assembly, said lower rail assembly attached to a lowermost cell of said plurality of cells; and

a pulldown cord, said pulldown cord for raising and lowering one of said upper and lower rail assembly in relation to the other of said upper and lower rail assembly.

25. The cellular shade of claim 24, wherein said adhesive includes an adhesive strip on said upper surface of said upper wall.

26. The cellular shade claim 25, wherein said adhesive strip passes through said longitudinal center line of said upper cell wall.

27. The cellular shade of claim 24, wherein said adhesive includes an adhesive strip on said lower surface of said lower cell wall.

28. The cellular shade of claim 24, wherein said adhesive includes a glue bead on said upper surface of said upper cell wall.

29. The cellular shade of claim 28, wherein said glue bead passes through said longitudinal center line of said upper cell wall.

30. The cellular shade of claim 24, wherein said adhesive includes a first glue bead on said upper surface of said upper cell wall and a second glue bead on said upper surface of said upper cell wall, said first and said second glue beads being on opposite sides of said longitudinal center line of said upper cell wall.

31. The cellular shade of claim 30, wherein said first and said second glue beads extend longitudinally along said upper surface of said upper cell wall of said cell.

32. The cellular shade of claim 31, wherein said first portion of said interior surface of said upper cell wall adjacent said rear edge of said upper cell wall is joined with said first portion of said interior surface of said lower cell wall adjacent said rear edge of said lower cell wall by an adhesive.

33. The cellular shade of claim 32, wherein when said cellular shade is extended, a second portion of said interior surface of said upper cell wall and a second portion of said interior surface of said lower cell wall define a six-sided polygon, said six-sided polygon having an upper rear side, an upper middle side, an upper front side, a lower front side, a lower middle side, and a lower rear side.

US 7,159,634 B1

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34. The cellular shade of claim 33, wherein said fin, said upper middle side and said lower middle side are substantially in parallel arrangement.

35. The cellular shade of claim 33, wherein an interior angle defined by said upper front side and said lower front side is less than an interior angle defined by said upper rear side and said lower rear side.

36. The cellular shade of claim 35, wherein said first and said second glue beads are approximately equidistant along said upper cell wall from said longitudinal center line of said upper cell wall.

37. The cellular shade of claim 36, wherein said first glue bead is proximate to a front end of said upper middle side and said second glue bead is proximate to a rear end of said upper middle side.

38. The cellular shade of claim 37, wherein said upper middle side is approximately equal in length to said lower middle side.

39. The cellular shade of claim 24, wherein said adhesive includes a first glue bead on said lower surface of said lower cell wall and a second glue bead on said lower surface of said lower cell wall.

40. The cellular shade of claim 39, wherein when said cellular shade is extended, a second portion of said interior surface of said upper cell wall and a second portion of said interior surface of said lower cell wall define a six-sided polygon, said six-sided polygon having an upper rear side,

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an upper middle side, an upper front side, a lower front side, a lower middle side, and a lower rear side.

41. The cellular shade of claim 40, wherein said fin, said upper middle side and said lower middle side are substantially in parallel arrangement.

42. The cellular shade of claim 39, wherein an interior angle defined by said upper front side and said lower front side is less than an interior angle defined by said upper rear side and said lower rear side.

43. The cellular shade of claim 39, wherein said upper middle side is approximately equal in length to said lower middle side.

44. The cellular shade of claim 43, wherein said first glue bead is proximate to a front end of said lower middle side and said second glue beads is proximate to a rear end of said lower middle side.

45. The cellular shade of claim 44, wherein said first and said second glue beads extend longitudinally along said lower surface of said lower cell wall of said cell.

46. The cellular shade of claim 45 wherein said first portion of said interior surface of said upper cell wall adjacent said rear edge of said upper cell wall is joined with said first portion of said interior surface of said lower cell wall adjacent said rear edge of said lower cell wall by an adhesive.

* * * * *

Buchanan Ingersoll & Rooney PC
Attorneys & Government Relations Professionals

Lynn J. Alstadt
412 562 1632
lynn.alstadt@bipc.com

RECEIVED

JAN 30 2007

OLSON & HIERL, LTD

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January 26, 2007

Arne M. Olson, Esq.
Olson & Hierl, LTD.
20 North Wacker Drive
36th Floor
Chicago, Illinois 60606

Re: Patent Infringement by HT Window Fashions

Dear Mr. Olson:

As you know from our correspondence last year concerning your client HT Window Fashions, we represent Ren Judkins, the inventor of tabbed window coverings. Recently, the United States Patent and Trademark Office allowed Mr. Judkins' patent application for a tabbed double cell product. We have paid the issue fee and expect the patent to issue in March. Enclosed is a copy of the allowed claims.

You should be aware that your client HT Window Fashions has been selling and offering to sell tabbed double cell window coverings under the "Polaris" name. We have compared the allowed claims of Mr. Judkins' tabbed double cell application to a sample of the Polaris tabbed double cell product. That product is within those claims. Therefore, the sale, offer for sale and use of the Polaris tabbed double cell products will infringe the patent that soon will issue to Mr. Judkins.

Please tell your client about this patent which will soon issue and let me know whether your client will stop selling and offering its tabbed double cell product for sale. Indeed, you should encourage HT Window Fashions to stop selling the product now to avoid future liability.

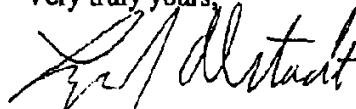
It is our intent to notify others in the industry of the patent that will soon issue and our determination that use, sale and offer for sale of the tabbed double cell product currently being marketed by your client will infringe that patent. Furthermore, we intend to vigorously enforce the patent.

January 26, 2007

Page - 2 -

I look forward to receiving your reply advising whether HT Window Fashions has or will cease and desist the sale of the tabbed double cell product.

Very truly yours,

A handwritten signature in black ink, appearing to read "Lynn J. Alstadt", written in a cursive style.

Lynn J. Alstadt

LJA/bem

Enclosure

cc: Ren Judkins

LJA/vjc

In re application of	:
REN JUDKINS	: TABBED MULTI-CELLULAR SHADE MATERIAL
Serial No. 09/703,372	:
Filed October 31, 2000	:
Allowed January 8, 2007	:

ALLOWED CLAIMS (7)

1. (11) A multi-cellular pleated shade for covering a window having a front surface and a back surface opposed to one another comprising:

a series of front cells each cell having an outer wall and an inner wall, the outer wall folded back to form a pleat and the front cells being connected to one another in a manner so that the pleats of all front cells are parallel and the outer walls of the front cells form at least a portion of the front surface;

a series of back cells connected to the front cells, each back cell having an outer wall and an inner wall and a tab extending from the outer wall away from the inner wall; the back cells being connected to one another in a manner so that the tabs are parallel and the outer walls of the rear cells form at least a portion of the back surface.

2. (12) The multi-cellular pleated shade for covering a window of claim 1 wherein the inner wall of at least one front cell is also the inner wall of at least one back cell.

3. (13) The multi-cellular pleated shade for covering a window of claim 1 wherein the front cells and the rear cells form a double cell honeycomb material.

4. (14) The multi-cellular pleated shade for covering a window of claim 1 wherein each back cell is comprised of two strips of shade material bonded together to form the tab and the outer wall.

5. (15) The multi-cellular pleated shade for covering a window of claim 4 also comprising an adhesive bonding the two strips of shade material together.

6. (16) The multi-cellular pleated shade for covering a window of claim 1 wherein each tab is formed by separate pieces of fabric bonded together by one of an adhesive, a hot melt adhesive and an ultrasonic bond.

7. (17) The multi-cellular pleated shade for covering a window of claim 1 wherein each tab has a width of at least 1/16 inch.

02/09/2007 09:25 626-5811136

HT WINDOW

PAGE 02/02

Buchanan Ingersoll & Rooney PC
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February 7, 2007

**Re: Tabbed Cellular Window Covering Patents
 and HT Window Fashions**

To whom it may concern:

We represent Ren Judkins, inventor of tabbed single and double cell window coverings. On January 9, 2007, Mr. Judkins received United States Patent No. 7,159,634 for a tabbed single cell product. Recently, the United States Patent and Trademark Office allowed Mr. Judkins' patent application for a tabbed double cell product. We have paid the issue fee and expect the patent for the tabbed double cell product to issue sometime in March or shortly thereafter. The referenced patent (and application) has been licensed to certain major manufactures of cellular window coverings.

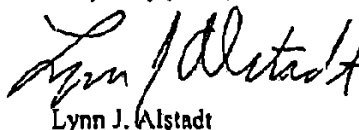
As you may know, HT Window Fashions has been selling and offering to sell double cell window coverings under the "Polaris" name. Other manufacturers have also been selling double cell window coverings. HT Window Fashions and some of these other manufacturers do not, however, have a license from Mr. Judkins to the above-referenced patent/application. We have compared the allowed claims of Mr. Judkins' tabbed double cell patent application to a sample of the "Polaris" tabbed double cell product. In our opinion, HT's "Polaris" product falls within one or more of those allowed claims. Therefore, we also are of the opinion that the sale, offer for sale and use of the "Polaris" tabbed double cell products as of the issue date will infringe the patent once the patent issues.

If you are not currently selling tabbed cellular products and have no intention of doing so, this letter does not apply to you.

Ren Judkins is an independent inventor who has over 100 patents for inventions in the window covering field. He earns much of his living from license fees that he receives from window covering manufacturers. Consequently, we intend to vigorously enforce the tabbed double cell patent as soon as it issues.

If you or your counsel have any questions, please call me directly or send me an e-mail.

Very truly yours,



Lynn J. Alstadt

Pennsylvania :: New York :: Washington, DC :: Virginia :: Florida :: New Jersey :: Delaware :: Ohio :: California

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 3101 :
Examiner Blair Johnson :
In re application of :
REN JUDKINS : PLEATED AND CELLULAR
Serial No. 08/756,282 : MATERIALS AND METHOD FOR
THE MANUFACTURE THEREOF
Filed November 25, 1996 : USING A SPLITTER

DECLARATION OF REN JUDKINS UNDER 37 C.F.R. § 1.131

I, REN JUDKINS, hereby declare as follows:

1. I am the inventor of the subject matter of the above-titled application. At least as early as 1990 I conceived of a tabbed honeycomb material for use in cellular pleated shades. I envisioned that such a shade could be made by splitting double cell or triple cell structure to create one or two stacks of single cell tabbed honeycomb. Each cell of this honeycomb would be made of strips of material folded lengthwise to form an upper cell wall and a lower cell wall. Then, the free edges would be connected together by adhesive or by welding to form a tab or fin. This cellular material would be attached between a headrail and a bottomrail and have lift cords as in other types of pleated shades.

2. Prior to March 1994 I obtained samples of multiple cell material manufactured by at least two different manufacturers. I cut that material to form one or two stacks of single cell material. Each stack consisted of a series of tabbed cells, each cell attached at its upper edge and at its lower edge to its adjacent cells.

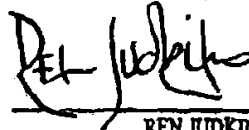
3. On February 25, 1991, during the ordinary course of business I created a computer drawing of my tabbed cellular structure. A copy of that drawing labeled T19 is attached hereto. The document number 910225A contains the date 910225 and a letter indicating it was the first drawing done that day.

4. Since originally conceiving of the tabbed cellular structure I have been diligent in testing various fabrics and adhesives, in seeking licensees for this invention and in searching for a machine builder who could manufacture a machine that could make this tabbed cellular structure.

I declare that the foregoing is true and correct, that all statements made on information and belief are believed to true, and, further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any false statements may jeopardize the validity of a patent which issues from the above-identified patent application.

Jan 20, 1998

Date: _____



REN JUDKINS

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Jenkins v. Ford

73 USPQ2d

it is likely to succeed in proving likelihood of confusion at trial. Though there are problems with both sides' expert reports, on the whole, I find Fisher-Price's surveys more persuasive. Moreover, the burden of proof is on PCA, and, even without the counter evidence of Fisher-Price's surveys, I do not think the Ostberg Study establishes likelihood of confusion.

D. Balance of Harms

Because I analyzed PCA's evidence to determine "likelihood of success," I must consider the possibility that, even if that standard is not met, PCA may still have demonstrated sufficiently serious questions on the merits plus a balance of hardships tipping decidedly in its favor. Putting aside the question whether PCA has presented enough evidence to demonstrate "sufficiently serious questions," despite not showing "likelihood of success," I find that it has not shown a balance of hardships tipping decidedly in its favor.

[4] I do not doubt that, if PCA is ultimately successful, it will have suffered harm. Fisher-Price is certainly a significant competitor, and I am sure PCA can ill afford to lose any chance at a competitive edge. Nevertheless, an injunction against Fisher-Price, particularly just before the holiday shopping season, could be devastating to the success of its new Doodle Pro product. Accordingly, on balance, I cannot say that the balance of hardships tips one way or the other; I certainly cannot say that it tips decidedly in PCA's favor.

The plaintiff's motion for preliminary injunction (doc. # 4) is DENIED.

It is so ordered.

Jenkins v. Ford

U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences
Interference Nos. 104,328 and 104,329
Decided April 23, 2004

(Nonprecedential)

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Interference —

Rules and rules practice (§ 110.1704)

Practice and procedure in Patent and Trademark Office — Interference — Pleadings and submissions (§ 110.1706)

Requirement, in 37 C.F.R. § 1.660(d), that party provide Board of Patent Appeals and Interferences with notice of civil action under 35 U.S.C. § 146 advises Director of U.S. Patent and Trademark Office that judicial review of interference decision is being sought, allows director to prevent entry of notice of abandonment of applicant's claims if applicant loses interference, and provides director with opportunity to determine whether to intervene in civil action; in present case, junior party applicant's failure to provide Rule 660(d) notice is probably harmless, since district court's order, in which court appeared to rule on issues not finally decided by board and not properly before court, will be interpreted as vacating and remanding board's final decision that junior party suppressed or concealed invention of applicant, vacating final decision that priority should be awarded against junior party, and giving advisory opinion on reduction to practice.

[2] Practice and procedure in Patent and Trademark Office — Interference — In general (§ 110.1701)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Settlement agreements; consent decrees (§ 410.43)

Settlement agreement between parties to interference, filed in U.S. Patent and Trademark Office after final order of federal district court in action seeking review of interference decision under 35 U.S.C. § 146, can be reasonably construed to indicate senior party's intent not to otherwise contest priority if district court vacates board's holding that junior party suppressed or concealed invention of application; however, board will examine other grounds for refusing to grant patent to junior party, including junior party's allegations that senior party is co-inventor, prior art that was previously held to invalidate claims of senior party's involved patents, and possible sale or public use more than one year prior to filing date of junior party's application.

Patent interferences between junior party Ren Jenkins (application no. 08/756,282), and senior party James A. Ford, Don L. Bertra, James M. Kennedy, and Ronald L. Presdorf (patent nos. 5,701,940 and 5,692,550; Newell Window Furnishings Inc., real party in interest). On Trial Section's consideration of decision entered in civil action by the U.S. District Court for the Western District of Pennsylvania. Junior party is ordered to file certified copy of complaint filed in district court, to file certified copy of any judgment entered in that action, and to file brief addressing outstanding issues.

[Editor's Note: The Board of Patent Appeals and Interferences has stated that this opinion is not binding precedent of the board.]

Lynn J. Alstadt, of Buchanan Ingersoll, Pittsburgh, Pa., for junior party.

George E. Quillin and David R. Cohen, of Foley & Lardner, Washington, D.C., for senior party.

McKelvey, S.J.

ORDER—Rule 610(e)

A. Background

These interferences are before the Trial Section of the Board of Patent Appeals and Interferences following entry of what appears to have been a final decision of the United States District Court for the Western District of Pennsylvania in a civil action under 35 U.S.C. § 146.

A conference call was held at approximately 9:40 a.m. on 20 April 2003 involving Lynn J. Alstadt, Esq. (counsel for Jenkins), David R. Cohen, Esq. (counsel for Newell Window Furnishings, Inc., Ford's real party in interest) and Senior Administrative Patent Judge Fred E. McKelvey. Relevant discussion which took place during the conference call is mentioned in the body of this order.

B. Findings of fact

The record supports the following findings of fact by at least a preponderance of the evidence. To the extent any finding is a conclusion of law, the finding may be treated as a conclusion of law.

1. A merits panel of the Board of Patent Appeals and Interferences ("board") entered final decisions [37 CFR § 1.658(a) (2001)] in

Interference 104,328 and Interference 104,329 on 28 September 2001 (Paper 130/119).¹

2. In its final decision, the board decided *inter alia* that (Paper 130/119, page 34):

- (1) priority as to Count 1 in Interference 104,328 is awarded against Jenkins;
- (2) priority as to Count 1 in Interference 104,329 is awarded against Jenkins and
- (3) Jenkins is not entitled to a patent containing claims 12-47 of Jenkins application 08/756,282, filed 25 November 1996.

3. Before the board, Jenkins alleged three actual reductions to practice:

- (1) a first in February of 1990,
- (2) a second on 19 March 1991 and
- (3) a third on 28 October 1993.

4. In the opinion of the board, the third alleged actual reduction to practice on 28 October 1993 would appear to have been irrelevant because the board held that Ford established an actual reduction to practice in June of 1993.

5. In an opinion in support of its decision, the board assumed *arguendo* that Jenkins actually reduced to practice on the dates it alleged, but determined that Jenkins had suppressed or concealed the invention within the meaning of 35 U.S.C. § 102(g) (Paper 130/119, page 9, finding 36 and pages 16-26).

6. Hence, in the opinion of the board, Jenkins was not entitled to rely on those assumed actual reductions to practice. *Paulik v. Rizkalla*, 760 F.2d 1270, 226 USPQ 224 (Fed. Cir. 1985).

7. Judicial review was sought by civil action under 35 U.S.C. § 146 filed in the United States District Court for the Western District of Pennsylvania ("District Court"). *Jenkins v. Newell Window Furnishings, Inc.*, Civil Action 01-2211-GLL.² (W.D. Pa.) ("civil action").

8. The record does not reveal the date on which a complaint was filed in the District Court.

¹ The reference to papers are (Paper # in Interference 104,328/Paper # in Interference 104,329). Hence, "Paper 130/119" refers to Paper 130 in Interference 104,328 and Paper 119 in Interference 104,329.

² GLL refers to U.S. District Judge Gary L. Lancaster.

9. Presumably the civil action was filed within the time required by 35 U.S.C. § 146 and 37 CFR § 1.304(a) (2001).

10. On 01 October 2003, the board received a copy of a "NOTICE OF FILING SETTLEMENT AGREEMENT AND DISTRICT COURT JUDGMENT" ("Notice") (Paper 131/120).

11. Attached to the Notice was a copy of a "Settlement Agreement" (Notice, Exhibit A).

12. The Settlement Agreement is said to have been filed pursuant to 35 U.S.C. § 135(c).

13. Also attached to the Settlement Agreement were copies of:

- (1) PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT;
- (2) PROPOSED ORDER and
- (3) PLAINTIFF'S BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT, including certain affidavits.

[Settlement Agreement, Exhibit A].

14. The motion for summary judgment is said to have been filed in the District Court on 11 September 2003 pursuant to the Settlement Agreement (Settlement Agreement, Exhibit A, MOTION, page 1 and BRIEF, page 2).

15. Also attached as Exhibit B to the Settlement Agreement was an ORDER ["Final Order"] which appears to have been entered by the District Court on 23 September 2003.

16. The Final Order is the same as the PROPOSED ORDER³ submitted by Jenkins, through counsel, to the District Court, except that the word PROPOSED in PROPOSED ORDER has been stricken to read ORDER.

17. The District Court's Final Order states:

The Court having reviewed Plaintiff's Motion for Summary Judgment and having received no opposition thereto finds that Jenkins did not suppress or conceal the invention of the Count in each of Patent Interference Nos. 104,328 and 104,329. There being no issues of material fact, and it being apparent that Plaintiff is entitled to relief, IT IS ORDERED THAT:

Plaintiff's Motion for Summary Judgment is granted.

That portion of the judgment of the Board of Patent Appeals and Interferences

104,328 and 104,329 finding that Jenkins is not entitled to a patent containing claims 12-47 of Application No. 08/756,282, filed November 25, 1996, is vacated. Priority is awarded to Jenkins as to the Count in each of Patent Interference Nos. 104,328 and 104,329.

There being no further issues presented in the pleadings, Final Judgment shall be entered in favor of Plaintiff.

18. According to the Final Order, the District Court

- (1) vacated the board's decision awarding priority against Jenkins and
- (2) determined that Jenkins was entitled to priority vis-a-vis Ford.

[Notice, Exhibit B].

19. Also submitted with the Settlement Agreement was a copy of an unsigned STIPULATION AND ORDER OF DISMISSAL ("Dismissal Order") presented to the District Court (Notice, Exhibit B).

20. The unsigned Dismissal Order states:

IT IS HEREBY STIPULATED by and between the undersigned counsel for the parties that pursuant to Rule 41(a)(1)(ii) of the Federal Rules of Civil Procedure, any and all claims that were asserted by either party and were not decided by the Court's decision on Plaintiff's Motion for Summary Judgment, shall be, and hereby are, dismissed with prejudice and forever barred, with each party to bear its own costs.

21. Returning to the Settlement Agreement, a support staff employee of the board acknowledged receipt of the Settlement Agreement in a communication entered on 24 October 2003 (Paper 132/121).

22. The interference rules require that "[a] party in an interference shall notify the Board promptly of any litigation related to any patent or application involved in an interference, including any civil action commenced under 35 U.S.C. 146." (Emphasis added). 37 CFR § 1.660(d) (2001).

23. The record does not reveal that Jenkins promptly gave the notice required by Rule 660(d).

24. The record suggests that there are several potential grounds upon which it could be determined that the Jenkins claims involved in the interference are unpatentable vis-a-vis the public.

³ Finding 13(2).

25. Those grounds include:

- (1) 35 U.S.C. § 102(f): based on allegations made by Judkins during the interference that Ford is a co-inventor along with Judkins;
- (2) 35 U.S.C. § 102/103: based on prior art⁴ which the United States Court of Appeals for Federal Circuit held was sufficient to render claim 1 of each of the involved Ford patents invalid [*Newell Window Furnishings Inc. v. Springs Window Fashions Division, Inc.*, 2001 U.S. App. LEXIS 15489, Appeal Nos. 00-1079, 00-1099 (Fed. Cir. 2001)];
- (3) 35 U.S.C. § 102(b)/103: based on a possible "on sale" or "public use" due to activities by Judkins to commercially exploit the invention more than one year prior to the date of a Judkins priority benefit application 08/412,875 was filed on 29 March 1995. *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 119 S.Ct. 304, [48 USPQ2d 1641] (1999).

C. Discussion

1. Notice required by Rule 660(d)

[1] The record does not reveal that Judkins gave the notice required by Rule 660(d).⁵

The notice required by Rule 660(d) is in addition to any notice a clerk of a district court may be required to give pursuant to 35 U.S.C. § 146.⁶ The notice normally provided by a clerk of a district court is (1) generally the same as a notice given under § 290 when an infringement civil action is filed, (2) addressed generally to the Patent and Trademark Office and (3) not forwarded to the board; rather, it is forwarded to the involved patent file. The notice required by Rule 660(d), on

the other hand, (1) is addressed to the board, (2) is routed to the board and placed in the interference file and (3) becomes a paper in the interference file. In the normal course of business, the board receives the Rule 660(d) notice long before any clerk's notice is matched with the patent file.

The notice required by Rule 660(d) serves several useful purposes.

a.

One purpose is to advise the Director that judicial review is being sought in a district court. In the case of a direct appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. § 141, the notice of appeal is filed in the Patent and Trademark Office [generally with the Office of the Solicitor—37 CFR § 1.302(c) (2003)] and it is placed in the interference file after a certified list is sent to the court. However, a complaint commencing a civil action is filed in a district court and is served on other parties in the interference; it is not filed in the Patent and Trademark Office.

Once the agency is on notice that judicial review has been sought, it generally takes no further substantive action in the interference. In other words, the agency does not implement the judgment of the board. On the other hand, if notice of judicial review is not received by the board, the judgment of the board is implemented.

Implementation of a judgment, when a patentee loses the interference, includes providing notice that involved claims of an involved patent have been cancelled. 35 U.S.C. § 135(a). Implementation also includes taking up for further appropriate ex parte action any application involved in the interference. 37 CFR § 1.664(a) (2003). Taking prompt appropriate ex parte action avoids unnecessary patent term adjustment due to unusual delays.

If a judgment is adverse to an applicant and all the applicant's claims are involved in the interference, the examiner may enter a notice of abandonment. In fact, in this very case the examiner entered a Notice of Abandonment (Judkins application, Paper 11) holding the involved Judkins application abandoned, "because the period for seeking court review of the [board's] decision [in the interferences] has expired and there are no allowed claims." Entry of the Notice of Abandonment would not have been necessary, and probably would

⁴ The prior art is said to have included a "roseine".

⁵ The record does reveal that notice was given pursuant to Rule 660(d) of a Federal Circuit decision involving claim 1 of each of the involved Ford patents (Paper 129/118). The Federal Circuit decision is discussed later in this opinion.

⁶ The Director " . . . shall be notified of the filing of the suit by the clerk of the [district] court in which . . . [the civil action] is filed." 35 U.S.C. § 146, second paragraph. See also 35 U.S.C. § 290 relating to notice required to be given by the clerk in patent infringement cases.

not have occurred, had Jenkins given the notice required by Rule 660(d).

b.

Another purpose is to give the Director an opportunity to determine whether intervention in the civil action is appropriate. In other words, Rule 660(d) notice implements that portion of the second paragraph of 35 U.S.C. § 146 which provides that "The Director shall not be a necessary party but he * * * shall have the right to intervene." The Director does not intervene in every civil action filed under § 146. However, there are circumstances where the Director may elect to intervene.

A decision whether to intervene is made on a case-by-case basis with the view to minimizing any additional burden intervention may place on the parties and the district court. Cases in which the Director may elect to intervene include, but are not limited to, cases where:

- (1) the lawfulness of a rule of the Patent and Trademark Office, including a rule governing interferences, is placed in issue before a district court;
- (2) an interpretation given a rule of the Patent and Trademark Office, including a rule governing interferences, is challenged before a district court; or
- (3) an unopposed, or consented to, motion is filed, the granting of which would result in a final decision being entered by a district court and the final decision is contrary to the result reached by the board, particularly on issues such as patentability and whether an "interference-in-fact" exists.

Ordinarily, the Director does not intervene where the sole issue before the district court is priority. An interference can involve questions of priority and patentability. 35 U.S.C. § 135(a). While priority is itself a kind of patentability issue, for the purposes of an interference the law treats priority issues as distinct from patentability issues. 35 U.S.C.

⁷ Cf. 28 U.S.C. § 2403(a) requiring notice to the Attorney General when the constitutionality of any Act of Congress is challenged in a civil action where the Attorney General is not a party.

§§ 6(a) and 135(a) and (d). A question of priority is an issue which Congress has indicated can be the subject of arbitration. 35 U.S.C. § 135(d). Arbitration does not preclude the Director from determining questions of patentability. *Id.*, 37 CFR § 1.690(d) (2003). A question of patentability, or to use the statutory language of § 135(d), "patentability of the invention involved in the interference," would generally involve any ground, other than priority, upon which a claim of an application or patent involved in the interference might be held to be unpatentable.

2. Effect in this case of no prompt Rule 660(d) notice

As will be seen, when the Final Order of the District Court is properly construed in light of the facts of this case, Jenkins's failure to give prompt Rule 660(d) notice is probably harmless.

The board assumed, but did not decide, that Jenkins had actually reduced to practice (1) in February of 1990 and (2) on 19 March 1991. Accordingly, a final decision with respect to Jenkins' actual reduction to practice has never been made by the board. However, the board awarded priority against Jenkins because it held that Jenkins had suppressed or concealed those assumed actual reductions to practice. Accordingly, the board made a final decision on suppression and concealment. The board's priority judgment against Jenkins was based solely on Jenkins having suppressed or concealed actual reductions to practice which were assumed to have taken place.

Jenkins sought judicial review. Only a final decision of the board is subject to judicial review. *Copelands Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989) (in banc). Hence, the only "priority" issue properly before the District Court on judicial review was whether Jenkins suppressed or concealed. The issue of whether Jenkins had actually reduced to practice was not resolved by the board and therefore could not have been before the court. Federal courts do not render advisory opinions. *Muskat v. United States*, 213 U.S. 346 (1911). A viable argument can be made that any opinion by the District Court in this case on the issue of whether Jenkins actually reduced to practice may have been an advisory opinion.

The PROPOSED ORDER presented by counsel for Jenkins, along with the motion for

summary judgment, asked the District Court to do more than it had jurisdiction to do. What the PROPOSED ORDER should have requested was that the suppression and concealment and adverse priority award be vacated and that the matter be remanded for further proceedings not inconsistent with the District Court's opinion.

Given the District Court's Article III and statutory jurisdiction over the case, a proper interpretation of the Final Order is that the District Court:

- (1) vacated the board's final decision that Judkins suppressed or concealed,
- (2) vacated the board's final decision that priority should be awarded against Judkins and
- (3) remanded for further proceedings consistent with its holding that Judkins had not suppressed or concealed.

The Final Order did not "authorize the Director to issue * * * [a] patent [to Judkins] on filing in the Patent and Trademark Office a certified copy of the judgment * * *." 35 U.S.C. § 146, second paragraph.

In an effort to (1) clarify the record, (2) expedite further proceedings in this interference and any ex parte examination of the Judkins application and (3) give weight and effect to the Final Order and the spirit of the Settlement Agreement, considered as a whole, the earlier-mentioned conference call took place. During the conference call, Mr. Alstad, counsel for Judkins, called attention to that portion of the Final Order which reads: "Priority is awarded to Judkins as to the Count in each * * * [interference]" (see also Finding 17). Mr. Cohen, counsel for Newell, Ford's assignee, indicated that Newell and Ford were satisfied with the above-quoted statement in the Final Order and had no interest in contesting that statement.

3. The Settlement Agreement

The District Court entered its Final Order on 29 September 2003. The Settlement Agreement was filed in the Patent and Trademark office on 01 October 2003.

A settlement agreement entered into prior to termination of an interference is required by law to be filed with the Patent and Trademark

Office. 35 U.S.C. § 135(c). Section 135(c) provides, inter alia, for (1) penalties for not timely filing settlement agreements⁸ and (2) when requested, maintaining the agreement "separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause."

[2] The Settlement Agreement in this case is dated in September of 2003,⁹ a date on which the civil action was pending in the District Court. Without revealing more than necessary,¹⁰ it is manifest that it was the intention of the parties that the Settlement Agreement "settle their differences on amicable terms that will result in setting aside that portion of the judgment of the Board in the '328 and '329 Interferences awarding priority against JUDKINS for the Count in each Interference (Settlement Agreement, page 2, last WHEREAS clause). Judkins was to file a Motion for Summary Judgment in the District Court (Settlement Agreement, page 2, ¶ 1). Ford and Newell agreed not to contest any fact in the Motion for Summary Judgment (Settlement Agreement, page 3, ¶ 2).¹¹ Moreover, Ford and Newell do "not object to entry of summary judgment vacating the Board's * * * awarding priority to JUDKINS" (*id.*). The Final Order was not entered pursuant to the Settlement Agreement; rather, it was entered because the District Court agreed with and granted Judkins's motion for summary judgment. The Settlement Agreement was then filed in the Patent and Trademark Office while the interference was again pending before the board. A reasonable construction of the Settlement Agreement suggests that if the District Court vacates the board's suppression or concealment holding, Ford would otherwise not contest priority being awarded to

⁸ See *Univis Corp. v. Commissioner*, 39 USPQ2d 1842 (D.D.C. 1993), mentioned in § 6 of the NOTICE DECLARING INTERFERENCE (Paper 1/1).

⁹ The agreement is dated 04 September 2003 on behalf of Judkins and 10 September 2003 on behalf of Ford and Newell.

¹⁰ Cf. *Former Employees of Barry Callebaut v. Chao*, 357 F.3d 1377, 1379 n.2 (Fed. Cir. 2004) (use of bracketed characterization to discuss confidential information).

¹¹ The proposed Motion for Summary Judgment was attached to the Settlement Agreement and therefore known to Ford and Newell prior to entering into the agreement. In other words, Ford and Newell had full knowledge of what facts would be presented to the District Court.

Jenkins. Cf. 37 CFR § 1.662(a) (2003) (a party may abandon a priority contest). In this case, there is no occasion to determine the precise basis on which priority should be awarded to Jenkins. Cf. 35 U.S.C. § 135(d). Suffice it to say that the District Court thought priority should be awarded to Jenkins and even if the District Court did not have authority to award priority to Jenkins, Ford has made it clear that it now does not contest priority being awarded to Jenkins as indicated in the Final Order of the District Court. A revised judgment awarding priority against Ford, in favor of Jenkins, and consistent with the Final Order, will be entered in due course by the board after consideration of other issues raised in this opinion.

For the reasons given, the Settlement Agreement falls within the scope of 35 U.S.C. § 135(c) and will be treated as an agreement timely filed under § 135(c). If a settlement agreement does not fall within the scope of § 135(c),¹² and is filed with the Patent and Trademark Office, there can be no assurance that the agreement would not be available to the public under the Freedom of Information Act.¹³ Cf. *R & W Flammann GmbH v. United States*, 339 F.3d 1320 (Fed. Cir. 2003) (discussion of (1) Trade Secrets Act, 18 U.S.C. § 1905 and (2) Exemption 4 of FOIA).

4. Other grounds for refusing a patent to Jenkins

Priority of invention vis-a-vis Ford is but one ground for possibly refusing to grant a patent to Jenkins. There is no reason to further pursue that ground, priority having now been settled as between Jenkins and Ford.

However, the mere fact that Jenkins succeeded in having the suppression and concealment holdings of the board vacated by the District Court, does not mean that other grounds for refusing a patent should not be considered. Indeed, they should. Nor does the "favorable" ruling by the District Court preclude the board from looking into other grounds for refusing a patent to Jenkins. See

Hoover v. Coe, 325 U.S. 79, 65 S.Ct. 955, 65 USPQ 180 (1945). *In re Ruschig*, 379 F.2d 990, 154 USPQ 113 (CCPA 1967).

There are at least three possible grounds for refusing to grant a patent to Jenkins based on the involved application which are in need of investigation. See Finding 25.

a.

A first possible ground is based on allegations made by Jenkins during the interference that Ford is a co-inventor along with Jenkins. 35 U.S.C. § 102(f). It may well be that the allegations were based on the proposition that Jenkins believes the Ford patents should have named Jenkins as an additional co-inventor and not that Jenkins and Ford are co-inventors. Jenkins will have an opportunity to clear up this matter when responding to this order.

b.

A second possible ground is based on prior art¹⁴ which the United States Court of Appeals for Federal Circuit held was sufficient to render claim 1 of each of the involved Ford patents invalid (*Newell Window Furnishings Inc. v. Springs Window Fashions Division, Inc.*, 2001 U.S. App. LEXIS 15489, Appeal Nos. 00-1079, 00-1099 (Fed. Cir. 2001)). Claim 1 of each of the Ford patents was the count in each interference. All of Jenkins' claims were designated, some at Jenkins' request, as corresponding to the those counts. A claim is designated as corresponding to a count only if it is directed to the same patentable invention as the count. 37 CFR §§ 1.601(j) (definition of interference-in-fact); 1.606 (last sentence) (2003). Facially it would appear that if claim 1 of each Ford patent is "invalid" over the prior art, then all of the Jenkins' claims corresponding to the counts might also be unpatentable.

c.

A third possible ground is based on a possible "on sale" or "public use" based on activities by Jenkins to commercially exploit the invention more than one year prior to the filing date of Jenkins' priority benefit application 08/412,875, filed on 29 March 1995. 35 U.S.C. §§ 102(b)(1)(3); *Pfaff v. Wells Electron-*

¹² An agreement which settles a civil action under 35 U.S.C. § 146 would not be an agreement under 35 U.S.C. § 135(c). *Johnson v. Beachy*, 60 USPQ2d 1584, 1588-90 (Bd. Pat. App. & Int. 2001) (Trial Section on banc).

¹³ The Settlement Agreement may have been filed "under seal" with the District Court. Settlement Agreement, ¶ 15.

¹⁴ See n.3.

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ics, Inc., 525 U.S. 55, 119 S.Ct. 304 [48 USPQ2d 1641] (1998). Jenkins alleges that Ford conceived and actually reduced to practice the invention more than one year prior to the filing date of the involved Jenkins application. Hence, the invention appears to have been ready for patenting more than one year prior to the filing date of the involved Jenkins patent. It also appears that more than one year prior to the invention Jenkins attempted to financially exploit the invention through attempted licensing efforts.

D. Order

Upon consideration of the record, and for the reasons given, it is

ORDERED that receipt of the Settlement Agreement filed with the board on 01 October 2003 is again acknowledged.

FURTHER ORDERED that the Settlement Agreement will be kept separate from the interference files as requested by Jenkins. 35 U.S.C. § 135(c).

FURTHER ORDERED on or before 10 May 2004 Jenkins shall file a certified copy of (1) the complaint filed in the United States District Court for the Western District of Pennsylvania in Civil Action 01-2211-GGL and (2) any document submitted with or attached to that complaint.¹⁵

FURTHER ORDERED that on or before 10 May 2004 Jenkins shall file a certified copy of (1) the judgment entered by the United States District Court for the Western District of Pennsylvania in Civil Action 01-2211-GLL and (2) any opinion in support of that judgment.¹⁶

FURTHER ORDERED that on or before 28 June 2004 Jenkins shall file a single "Brief" (there is no page limitation) addressing the following:

(1) in *Part A*, a discussion and argument with reference to evidence in the interferences as to why a holding of unpatentability under 35 U.S.C. § 102(f) should not be made on the ground that Jenkins and Ford are coinventors;

(2) in *Part B*, a discussion of why the prior art relied upon by the Federal Circuit in *New-*

ell Window Furnishings Inc. v. Springs Window Fashions Division, Inc., 2001 U.S. App. LEXIS 15489, Appeal Nos. 00-1079, 00-1099 (Fed. Cir. 2001)¹⁷ does not render any involved Jenkins claim unpatentable under 35 U.S.C. § 102 or 35 U.S.C. § 103.

(3) in *Part C*, a discussion of whether the activities which took place after Jenkins may have conceived and/or actually reduced to practice should be held to be an on sale or public use bar under 35 U.S.C. § 102(b);¹⁸

(4) in *Part D*, a discussion of whether the board should take action under 37 CFR § 1.641 (2003) (unpatentability discovered by the board) or 37 CFR § 1.659(a) (2003) (recommendation to the examiner for rejecting claims) or some other action and

(5) in *Part E* any additional matter which Jenkins would like to address.

FURTHER ORDERED that on or before 28 June 2004, Jenkins is also authorized to file such additional evidence as Jenkins believes appropriate in support of any argument made in response to this order.¹⁹

FURTHER ORDERED that any evidence filed by Jenkins in response to this order, including copies of any documents filed in the District Court, shall comply with the exhibit requirements of the STANDING ORDER.

FURTHER ORDERED that the Brief shall not incorporate by reference any argument made in a prior paper filed in either interference.

¹⁷ Jenkins should file copies of the relevant papers from the record of *Newell Window Furnishings Inc. v. Springs Window Fashions Division, Inc.*, 2001 U.S. App. LEXIS 15489, Appeal Nos. 00-1079, 00-1099 (Fed. Cir. 2001), which would assist the Patent and Trademark Office in determining whether any Jenkins claim is unpatentable over (1) the prior art relied upon in *Newell* or (2) that prior art in combination with any other relevant prior art known to Jenkins or the Patent and Trademark Office. 37 CFR § 1.56 (2003).

¹⁸ Jenkins also should provide all information and evidence within its possession to permit the agency to make an informed decision on any "on sale" or "public use" issue. 37 CFR § 1.56 (2003).

¹⁹ One of the consequences of Jenkins not providing the notice required by Rule 660(d) is that the interference is "distributed", i.e., the application is sent to the examiner, patents are returned to patent files and the interference file is sent to the warehouse. Exhibits can become lost in the process and, in any event, difficult to retrieve. It would be helpful when answering this order if Jenkins would again submit a copy of any exhibit Jenkins wishes considered in resolving the possible patentability issues raised herein.

¹⁵ These documents are needed to establish on the record that the civil action was timely filed in the District Court. 35 U.S.C. § 146; 37 CFR § 1.304 (2001).

¹⁶ These documents are needed because 35 U.S.C. § 146 [second paragraph, last sentence] requires the filing of a certified copy of the judgment of the District Court.

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Rossi v. Motion Picture Association of America Inc.

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FURTHER ORDERED that any document filed in these interferences shall be served on Ford.

FURTHER ORDERED that on or before 26 July 2004 Ford is authorized to file a response to any submissions made by Judkins.²⁰

FURTHER ORDERED that a copy of this order shall be placed in the file of Judkins application 08/736,282, filed 25 November 1996.

Rossi v. Motion Picture Association of America Inc.

U.S. Court of Appeals
Ninth Circuit

No. 03-16034

Decided December 1, 2004

COPYRIGHTS

[1] Rights in copyright; infringement — In general (§ 213.01)

Infringement pleading and practice — Defenses — In general (§ 217.0601)

Requirement in 17 U.S.C. § 512(c)(3)(A)(v) that copyright owner have "good faith belief" that Web site is infringing copyrighted works in order to have site shut down by Internet service provider imposes subjective, rather than objective, standard on copyright owner, since "good faith," as used in federal statutes, has traditionally been interpreted as encompassing subjective standard, since U.S. Congress understands distinction between objective reasonableness standard and subjective good faith standard, and fact that Congress did not adopt former standard in enacting Digital Millennium Copyright Act indicates intent to adhere to subjective standard traditionally associated with good faith requirement, and since overall structure of statute supports conclusion that Section 512(c)(3)(A)(v) imposes subjective good faith requirement.

²⁰ In the event Ford elects not to respond to any submission made by Judkins, the Board would appreciate receiving notice to that effect.

[2] Rights in copyright; infringement — In general (§ 213.01)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Defenses — In general (§ 410.1801)

Plaintiff failed to raise triable issue of fact as to whether defendant motion picture trade association had "good faith belief" that plaintiff's Web site was infringing copyrighted materials when defendant sought to have site shut down by Internet service provider pursuant to "notice and takedown" provisions of Digital Millennium Copyright Act, even though defendant did not attempt to download any movies from plaintiff's site or investigate links to site, since explicit statements on plaintiff's site, including "Join to download full length movies online now!" and "Full Length Downloadable Movies," compel finding that employee who reviewed site for defendant concluded in good faith that motion pictures owned by defendant's members were available for immediate downloading from plaintiff's site.

COPYRIGHTS

[3] Rights in copyright; infringement — In general (§ 213.01)

TRADEMARKS AND UNFAIR TRADE PRACTICES

Unfair competition — State and common law (§ 395.01)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Defenses — In general (§ 410.1801)

Federal district court properly granted summary judgment for defendant on claims of tortious interference with contractual relations and prospective economic advantage, libel and defamation, and intentional infliction of emotional distress, in action in which defendant caused Internet service provider to shut down plaintiff's Web site because of content on site that allegedly infringed copyrights in motion pictures, since defendant's conduct was "justified," in that defendant complied with "notice and takedown" procedures de-

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Newell Window Furnishings v. Springs Window Fashions

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U.S. District Court
Northern District of Illinois

Newell Window Furnishings Inc. v. Springs
Window Fashions Division Inc.

No. 98 C 50003

Decided October 7, 1999

PATENTS

1. Patent construction — Claims — Process
(§125.1309)

Claim limitation directed to strip of shade material "folded" lengthwise in patents for cellular window shades requires only that final product contain strip of material with fold in it, and is not process limitation, since grammatical structure of claims suggests that they be read as product claims, since applications originally contained both product and method claims but were restricted to product claims pursuant to restriction requirement, since reading limitation at issue as process limitation strains language of claims beyond their most natural meaning, and since construing this limitation as product limitation does not result in surplusage.

2. Patentability/Validity — Anticipation —
Prior art (§115.0703)

"Appreciation" requirement for anticipating prior art invention concerns realization that invented device has come into existence, not appreciation of device's novelty or patentability; thus, contention that prior art inventor believed physical structure of device to be neither novel nor patentable does not merit finding that device does not anticipate invention of patent in suit, since this legal judgment, even if mistaken, does not negate conclusion that inventor fully conceived physical structure of invention.

3. Patentability/Validity — Date of invention —
Suppression or concealment (§115.0407)

Patentability/Validity — Anticipation —
Prior art (§115.0703)

Delay of 49 months between reduction to practice and filing of patent application for allegedly anticipating invention raises inference of intent to abandon, suppress, and conceal, which is further supported by inventor's stated policy of delaying filing until financial backing is obtained, and this inference shifts burden to infringement defendant to justify part or all of delay with further efforts of inventor to perfect invention; defendant has failed to meet that burden, since only justifications offered relate to efforts to

engineer and finance commercial production of invention, which do not constitute further experimentation or testing that might excuse part or all of delay.

4. Patentability/Validity — Anticipation —
Prior art (§115.0703)

Infringement plaintiffs are not entitled to secondary presumption of validity that arises when examiner issues patent over prior art reference that is later alleged to invalidate patent in suit, even though reference in question was disclosed to same examiner during parallel prosecution of related application, since there was no judgment by examiner as to impact of reference upon subject matter of patent in suit, since related patent contains additional subject matter not found in patent at issue, and since deference to examiner's expertise that underlies secondary presumption is not warranted if examiner has not had opportunity to apply that expertise.

5. Patentability/Validity — Anticipation —
Identity of elements (§115.0704)

Prior art window shade material anticipates asserted claim of patent for cellular window shade, since prior art shade predates patent, and since it meets "cellular pleated shade member" limitation, as well as all remaining limitations of asserted claim.

6. Patentability/Validity — Anticipation —
Identity of elements (§115.0704)

Prior art window shade material does not anticipate asserted claim of patent for cellular shade material, since claim requires that each cell wall in material be attached to adjoining cell wall at no fewer than two attachment zones, and since material of prior art shade has only one attachment zone on each cell wall, and thus fails to meet this limitation.

7. Patentability/Validity — Obviousness —
Person of ordinary skill in art (§115.0902)

Art pertinent to invention of patent for cellular window shade material is art of cell structure, rather than manufacturing, and level of ordinary skill in art does not include engineering skills necessary to develop and implement manufacturing processes, since patent contains only product claims covering particular cell and shades incorporating that cell, and since this result is consistent with skill levels of inventors of patent, insofar as their educational backgrounds are concerned; one of ordinary skill in art of developing window covering designs must possess thorough knowledge of existing products, patents, and prior art.

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Newell Window Furnishings v. Springs Window Fashions

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8. Patentability/Validity — Obviousness — Secondary considerations generally (§115.0907)

License and consent judgment cited by plaintiffs, and alleged commercial success and long-felt but unmet need, are of only limited value as indicia of non-obviousness of invention of patent for cellular window shade material, since record shows that licensee entered into settlement to avoid costs of future litigation, and did so on very favorable terms, and since any nexus between invention of patent and commercial success and long-felt but unmet need is weak, in that primary obstacle to commercializing new cellular shades was development of manufacturing process, whereas patent in suit claims cellular structure only, and has no process claims.

9. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Asserted claim of patent for cellular window shade material is obvious over prior art window shade material, since prior art material meets all limitations of claim except that requiring each cell wall to be attached to adjoining cell wall at no fewer than two attachment zones, since use of dual glue lines was taught in prior art, and since secondary considerations of non-obviousness cited by plaintiff are entitled to little weight.

10. Practice and procedure in Patent and Trademark Office — Prosecution — Duty of candor — In general (§110.0903.01)

Finding of deceptive intent is not precluded by "facially legitimate" reasons for challenged actions, since "facial legitimacy" does not immunize party against finding of inequitable conduct.

11. Practice and procedure in Patent and Trademark Office — Prosecution — Duty of candor — Materiality (§110.0903.04)

Infringement action brought by third party against patent applicant was not material to patentability of invention of patent in suit, since litigation involved anomalous samples that resulted from bad production run, and charges leveled in that litigation thus had no bearing upon patentee's true product, and since insistence, by plaintiff in that litigation, that infringing samples be replaced by true product implies that true product was not infringing.

12. Practice and procedure in Patent and Trademark Office — Prosecution — Duty of candor — Materiality (§110.0903.04)

Applicant's failure to disclose prior art process did not constitute inequitable conduct in prosecution of patents in suit, since process claims in applications were eventually restricted out, and process prior art in question is material only to those initial process claims, since patents in suit are pure product claims that do not count process claims as antecedents, since process claims must be considered "entirely different inventions" from patents in suit insofar as they were restricted out at examiner's behest, and since present case thus lacks "intimate relation" among related patents that can spread taint of inequitable conduct.

13. Practice and procedure in Patent and Trademark Office — Prosecution — Duty of candor — Materiality (§110.0903.04)

Applicant's failure to disclose third party's claim of prior invention to examiner did not constitute inequitable conduct in prosecution of patents in suit, since prior invention claim had not been corroborated, and duty of candor requires applicant only to be forthright in sharing pertinent knowledge with examiner, and since attorney thus did not bear affirmative duty to disclose claim of prior invention in uncorroborated form, or to seek corroboration for it.

14. Practice and procedure in Patent and Trademark Office — Prosecution — Duty of candor — In general (§110.0903.01)

Applicant, in prosecuting patents in suit, was not required to disclose existence of license taken by defendant in infringement litigation, since, standing alone, license was favorable evidence of patentability of invention of patents in suit, and since, consistent with duty of candor, material favorable to patentability need not be disclosed to U.S. Patent and Trademark Office.

15. Practice and procedure in Patent and Trademark Office — Prosecution — Duty of candor — Materiality (§110.0903.04)

Applicant was required to disclose order denying preliminary injunction in related litigation during prosecution of patents in suit, since order is flatly inconsistent with applicant's arguments during prosecution that patents were valid over certain prior art references, and thus is "material" within meaning of 37 C.F.R. 1.56(b)(2), since dis-