

A CRITIQUE OF RECENT OPINIONS
IN PATENT INTERFERENCES¹

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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	CONCEPTION	2
III.	CLASSICAL DILIGENCE	3
IV.	ACTUAL REDUCTION TO PRACTICE.....	4
V.	PEELER DILIGENCE.....	5
VI.	CONSTRUCTIVE REDUCTION TO PRACTICE	6
	A. The Court Affirms that a Party Seeking the Benefit of a Constructive Reduction to Practice Through a Chain of Continuing Applications Must Be Accorded the Benefit Under 35 USC 119, 120, 121, or 365 of Each Application Forming a Link in the Chain of Cependency Culminating in the Involved Application or Patent	6
	Stevens v. Tamai	6
	Harris v. Dobrusin.....	17
	B. Noelle v. Lederman.....	26
VII.	DERIVATION	36
VIII.	THE 35 USC 135(b) BAR	37
	A. The Federal Circuit Affirmed Both (1) the Board’s Jurisdiction to Declare Interferences to Decide 35 USC 135(b) Issues and (2) the Board’s Discretion Not to Decide Those Issues	37
	In re Sullivan.....	37
IX.	CORROBORATION	43
X.	INTERFERENCE PRATICE	44
	A. The Court Re-Affirms The Board’s Two-Way Test for Interference-In-Fact and Also Affirms A Further, Narrow Construction of the Rules.....	44
	Noelle v. Lederman.....	44

B.	The Board Opts for an Interference-In-Fact Test for Whether an Application or Patent Should Be Added to an Interference Under 37 CFR 1.635/1.642.....	60
	Benson v. Ginter	60
C.	Belated Motions Under 37 CFR 1.645(b).....	64
1.	Bilstad v. Wakalopulos	64
2.	Cheung v. Ritzdorf.....	69
D.	The Board’s Rebuttal Arguments Against Consideration of Expert Testimony	76
	Holbrooks v. Bacchi.....	76
E.	The Board’s Present Strong Policy Is That Any Confidential Information Submitted to the Board in an Interference Will Ultimately Be Available in the Public Record.....	79
	Fletcher v. Leibu	79
F.	A Wise Advocate Should Select the Most Appropriate Terms for Use in His or Her Arguments.....	82
	Sernyk v. DeBonte	82
G.	A 37 CFR 1.634 Motion to Correct Inventorship Must Explain How the Contributions of the Inventor(s) Sought to be Added Relate to the Invention of a Specific Claim	85
	Scripps Research Institute v. Nemerson	85
H.	In an “Appropriate” Case, the Board Will Exercise Its Discretion To Order Additional Discovery	89
	Sernyk v. DeBonte	89
I.	The Board Rebuffs an Argument that Page Limitations Should Be Applied Collectively to Different Related Motions.....	99
	Holbrooks v. Bacchi.....	99
J.	The Court Finds (1) No Conflict Between 37 CFR 1.610(d) and 37 CFR 1.2 and (2) Adequate Authority for the Board to Issue Its Standing Order	101
	In re Sullivan.....	101

K.	The Board Has Reaffirmed Its Perceived Lack of Jurisdiction in Interferences Wherein More Than One Party Has a Patent Involved in the Interference	103
	Benson v. Ginter	103
XI.	PATENTABILITY ISSUES ARISING IN AN INTERFERENCE CONTEXT	107
A.	The Written Description Requirement.....	107
	Bilstad v. Wakalopoulos	107
B.	The Written Description Requirement.....	130
	Holbrooks v. Bacchi.....	130
XII.	COURT REVIEW OF DECISIONS IN INTERFERENCE.....	136
A.	The Federal Circuit Has Jurisdiction to Decide Whether the Board Had Jurisdiction	136
	In re Sullivan.....	136
XIII.	POST INTERFERENCE PRACTICE	140
XIV.	RELATIONSHIP OF INTERFERENCE PROCEEDINGS TO COURT PROCEEDINGS	141
XV.	CONCLUSION.....	142

I. INTRODUCTION

This article covers opinions relating to interferences published in volumes 69-72 of USPQ2d, with the exception of *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 69 USPQ2d 1283 (Fed. Cir. 2003), which was included in Mr. Gholz's previous article at 86 JPTOS 464, 494-96 (2004).^{4,5}

⁴See also Mr. Gholz's previous articles at 86 JPTOS 464 (2004), 85 JPTOS 401 (2003), 84 JPTOS 163 (2002), 83 JPTOS 161 (2001), 82 JPTOS 296 (2000), 81 JPTOS 241 (1999), 80 JPTOS 321 (1998), 79 JPTOS 271 (1997), 78 JPTOS 550 (1996), 77 JPTOS 427 (1995), 76 JPTOS 649 (1994), 75 JPTOS 448 (1993), 73 JPTOS 700 (1991), 71 JPTOS 439 (1989), and 69 JPTOS 657 (1987).

⁵The fact that Mr. Gholz publishes this review every year in a similar format accounts for the sections which read in their entirety "Nothing relevant this year."

II. CONCEPTION

Nothing relevant this year.

III. CLASSICAL DILIGENCE

Nothing relevant this year.

IV. ACTUAL REDUCTION TO PRACTICE

Nothing relevant this year.

V. PEELER DILIGENCE

Nothing relevant this year.

VI. CONSTRUCTIVE REDUCTION TO PRACTICE

A. **The Court Affirms that a Party Seeking the Benefit of a Constructive Reduction to Practice Through a Chain of Continuing Applications Must Be Accorded the Benefit Under 35 USC 119, 120, 121, or 365 of Each Application Forming a Link in the Chain of Copendency Culminating in the Involved Application or Patent**

Stevens v. Tamai

In *Stevens v. Tamai*, 366 F.3d 1325, 70 USPQ2d 1765 (Fed. Cir. 2004) (opinion by Circuit Judge Clevenger, joined by Circuit Judges Michel and Schall), the court reversed the board's decision according Tamai the benefit of an earlier filed Japanese application but denying Tamai the benefit under 35 USC 365 of the filing date of a bridging Japanese international application. The Japanese international application was a necessary link in the chain of continuity of copendency between Tamai's Japanese application and the earliest U.S. patent application of which Tamai had been accorded the benefit of its filing date in the notice declaring the interference.

Stevens was involved in the interference on U.S. Patent No. 5,393,368 ("the '368 patent") issued on February 28, 1995 on an application filed on February 7, 1994.⁶ Tamai's involved Application 08/196,839 ("the '839 application") was filed on February 15, 1994 as a continuation-in-part of Tamai's Application No. 08/030,183 ("the '183 application"), which was filed on March 29, 1993. The notice declaring the interference accorded Tamai's '839 application the benefit of the filing date of the '183 application, thus making Tamai the senior party.⁷

⁶ 366 F.3d at 1327-28, 70 USPQ2d at 1767.

⁷ 366 F.3d at 1328, 70 USPQ2d at 1767.

Both parties filed preliminary motions under 37 CFR 1.633(f) to be accorded the benefit of the filing date of earlier filed applications. At the relevant time, 37 CFR 1.633 provided in pertinent part that:

A party may file...

(f) A motion to be accorded the benefit of the filing date of an earlier filed application. See § 1.637(a) and (f).

37 CFR 1.637(a) provided in pertinent part that:

(a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full statement of the reasons why the relief requested should be granted....

37 CFR 1.637(f) provided in pertinent part and with emphasis added that:

(f) A preliminary motion for benefit under § 1.633(f) shall:

(1) Identify the earlier application.

(2) ...When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. *If the earlier filed application is not in English, the requirements of § 1.647 must also be met.*

(3) Show that the earlier application constitutes a constructive reduction to practice of each count.

37 CFR 1.647 provided that:

When a party relies on a document
or is
required to produce a document in a
language
other than English, a translation of
the document
into English and an affidavit
attesting to the accuracy of the translation
shall be filed with the
document.

The court noted that:

Stevens's motion was based on several European applications showing a constructive reduction to practice as early as February 10, 1993. Tamai did not oppose the motion, which was granted by the Board.

Tamai's motion was based on Japanese Patent Application No. 3-68371 ("the Japanese '371 application") and PCT Application No. PCT/JP 92/00947 ("the PCT '947 application"). Both applications are in Japanese. Tamai filed a translation of the Japanese '371 application with the motion. Stevens opposed the motion, arguing, inter alia, that Tamai had not met its burden of proof because the motion "failed to comply with 37 C.F.R. § 1.637" because "[n]o copies of [the Japanese '371 application] and the PCT '947 application were served with the motion pursuant to 37 C.F.R. § 1.637(f)(2) [and] [n]o translation of the PCT '947 application was served with the motion pursuant to 37 C.F.R. § 1.637(f)(2)." In reply, Tamai stated that copies of the Japanese language applications, the Japanese '371 application and the PCT '947 application, while not

served with the motion, were in the record. Tamai also submitted an affidavit attesting that the disclosures of the two foreign language applications were substantially the same. Importantly, with neither the original motion nor the reply did Tamai include an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation.

The Board denied Tamai's motion for benefit as directed to the PCT '947 application because "Tamai did not supply a translation of the PCT application." Nonetheless, the Board examined the Japanese '371 application and determined that the Japanese '371 application "is a constructive reduction to practice of the count." Accordingly, the Board entered judgment against Stevens.⁸

Additionally, the court noted that:

Despite prevailing in the interference, Tamai requested reconsideration of that part of the Board's decision denying Tamai's motion for benefit as directed to the PCT '947 application. Tamai's request argued that the translation of the PCT '947 application was in the record because the '183 application was in the record and "the U.S. Patent and Trademark Office identified and accepted the '183 application as a translation of Tamai's foreign language PCT application." According to Tamai, the requirements of Rule 647 that "a translation of the document into English and an affidavit attesting to the accuracy of the translation" be provided, were made inconsequential in light of 37 C.F.R. § 1.639(a).¹ Tamai's final comment in support of its argument, on the last page of the request for reconsideration, states

⁸ 366 F.3d at 1328-29, 70 USPQ2d at 1767-68.

“[I]f this request is denied, it is respectfully requested that the Board explain how Tamai is entitled to the benefit of the [Japanese ‘371 application] without the linking PCT application in the chain of priority.” Tamai’s Req. for Recons. at 7. Stevens opposed Tamai’s motion, arguing, *inter alia*:

Stevens agrees with Tamai’s apparent position that

the Board erred in granting Tamai priority benefit

of [the Japanese ‘371 application] in view of Tamai’s failure to satisfy the requirements for obtaining priority benefit of Tamai’s PCT application. Because Tamai is

not entitled to the priority benefit of the PCT application, the Board also should have denied Tamai’s motion for

the priority benefit of [the Japanese ‘371 application].

Stevens’s Opp’n to Tamai’s Req. for Recons. at 9 (citing 35 U.S.C. § 119(a)).

The Board agreed to reconsider its final decision, but refused to modify it because, “Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do.” Addressing Tamai’s argument that the ‘183 application was the translation of the PCT ‘947 application, the Board noted that “Tamai did not state that the ‘183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed.” Also, the Board concluded that Rule 637(f) requires that certain documents have to be filed with a motion for benefit and those requirements were not “obviated” by Rule 639(a). Further, the Board concluded that Tamai’s

failure to follow the rules prejudiced Stevens, who was entitled to expect that Tamai would follow them. Finally, addressing Tamai’s linking argument, the Board concluded that any inconsistency in the treatment of the Japanese ‘371 application and the PCT ‘947 application “arises because of Tamai’s inconsistent actions in regard to these two applications.” However, by not modifying its judgment, the Board affirmed its judgment in favor of Tamai. Stevens appealed the decision on reconsideration, which is the final decision of the board.⁹

¹Rule 639(a) states, in part:

[P]roof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

37 C.F.R. § 1.639(a) (2003).

The court explained that:

On appeal, Stevens argues that the Board erred in granting Tamai’s motion for benefit of the Japanese ‘371 application. According to Stevens, the statutory limits of 35 U.S.C. § 119(a) preclude Tamai directly claiming the benefit of the Japanese application because that application was filed more than one year before the ‘183 application. In particular, Stevens asserts that in order to obtain the benefit of the

⁹ 366 F.3d at 1328-29, 70 USPQ2d 1767-68; emphasis supplied.

Japanese '371 application, Tamai must obtain the benefit of the intervening PCT '947 application. In Stevens's view, because Tamai failed to prove its claim for priority benefit of the PCT '947 application, and cannot therefore obtain the benefit of the Japanese '371 application, Tamai has failed to prove a constructive reduction to practice of the subject matter corresponding to the count prior to the filing date of the '183 application, March 29, 1993. Based on Stevens's preliminary motion, the Board accorded Stevens an effective filing date of February 10, 1993. Because February 10, 1993 is an earlier effective filing date than March 29, 1993, Stevens argues that he should be awarded judgment in the interference.

Tamai does not argue that his involved application can be accorded the benefit of the Japanese '371 application if he is not accorded the benefit of the PCT '947 application. Rather, Tamai supports the Board's decision in his favor by arguing that the Board erred in not according him the benefit of the PCT '947 application. In particular, Tamai argues that a preliminary motion for benefit is not required for him to be entitled to the benefit of the PCT '947 application, or, alternatively, if a motion for benefit was required, his actions in this case were sufficient to establish entitlement to the benefit of the PCT '947 application.¹⁰

The court agreed with Stevens, explaining that:

As a matter of convenience, we first address Stevens's argument. We agree with Stevens: because Tamai failed to prove his entitlement to the benefit of the PCT '947 application, it was error for the Board to

¹⁰ 366 F.3d at 1330, 70 USPQ2d at 1769.

accord Tamai the benefit of the Japanese '371 application.

An interference is a proceeding instituted in the United States Patent and Trademark Office, designed to resolve questions of priority and patentability between two or more parties claiming the same patentable invention. *See* 35 U.S.C. § 135 (2000); 37 C.F.R. § 1.601(i) (2003). To establish priority, parties may rely on earlier filed applications because conception and constructive reduction to practice of the subject matter described in an application occur when the application is filed. *See Hyatt v. Boone*, 146 F.3d 1348, 1352 [47 USPQ2d 1128] (Fed. Cir. 1998); *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 885-86 [178 USPQ2d [sic] 158] (CCPA 1973). If a party is entitled to rely on an earlier filed application and the specification of that application shows a constructive reduction to practice of the count, no further evidence is needed to prove invention as of the filing date of the application. *See Hyatt*, 148 F.3d at 1352.

A party to an interference seeking to be “accorded the benefit of the filing date of an earlier filed application” under 37 C.F.R. 1.633(f) is seeking to establish an effective filing date. *See id.* at 1351-52. “The effective filing date of an application is the filing date of an earlier application, benefit of which is accorded to the application under 35 U.S.C. 119, 120, 121, or 365....” 37 C.F.R. § 1.601(g); *see also Hyatt*, 146 F.3d at 1352 (“When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120....”). Section 119(a) of Title 35 precludes relying on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding U.S. application. *Schmierer*

v. Newton, 397 F.2d 1010, 1014-15 (CCPA 1968).

In the matter at hand, the Board held that because Tamai did not file with his motion for benefit an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation, Tamai had not proven that he was entitled to be accorded the filing date of the '947 application. Nonetheless, the Board granted Tamai's involved application the benefit of the Japanese '371 application, which was filed July 31, 1991, more than one year prior to the filing of the '183 application. Because section 119 precludes reliance on a foreign application for priority benefit when the application was filed more than one year before the filing of the corresponding U.S. application, *see Schmierer*, 397 F.2d at 1014-15, the Board's conclusion was based on an erroneous conclusion of law, and accordingly, constituted an abuse of discretion.¹¹

Tamai's argument that no motion for benefit of the PCT application was required was answered by the court as follows:

Distilled, Tamai's argument that a motion for benefit was unnecessary in this interference rests on the premise that a motion for benefit can not be required for non-English applications where the applicant has satisfied U.S. filing requirements for prosecution purposes. In this case, Tamai filed the PCT '947 application with the United States Patent and Trademark Office ("Office") for the purpose

¹¹ 366 F.3d 1330-31, 70 USPQ2d at 1769-70; interpolation of "sic" supplied by the authors; the other interpolations supplied by the editors of USPQ2d.

of entering national stage examination in the United States. Included with the application was the declaration of Tamai that stated “on information and belief,” he was, *inter alia*, entitled to priority benefit of the Japanese ‘371 application. The PCT ‘947 application was accepted by the Office as having satisfied the requirements of 35 U.S.C. § 371 and became the ‘183 application. Tamai asserts, and we assume without deciding [,] that Tamai correctly followed the procedures for filing the PCT ‘947 application in the United States. Thus, Tamai argues that when the Office accepts a translation of a foreign language international application into the national stage, the Board, in any interference in which the applicant later becomes embroiled cannot require that the applicant seeking the benefit of the foreign language international application prove that the application contains the same disclosure as the national stage application. We disagree.

In its most favorable light, Tamai is stating that there is a conflict between Subpart E-Interferences, 37 C.F.R. §§ 1.601-1.690, which “govern the procedure in patent interferences in the Patent and Trademark Office,” 37 C.F.R. § 1.601, and sections 363 and 371(c)(2) of title 35, as they provide authority for national stage applications.

The conflict Tamai suggests simply does not exist. Sections 363 and 371(c)(2) are not inconsistent with the Office’s procedural requirements which insist that a party to an interference seeking the benefit of an earlier application prove the same by filing a motion for benefit, and, when applicable, serving a translation of a relied upon non-English language application with an affidavit attesting to the accuracy of the translation. The former sections deal with accepting an international application into national stage examination in the United

States while the latter regulations deal with proving whether the application contains a constructive reduction to practice of subject matter corresponding to a count in an interference. In short, in the context of this case, sections 363 and 371(c)(2), and 37 C.F.R. §§ 1.601-1.690, have little to do with one another....

And while overlooked by Tamai, 35 U.S.C. § 372(b)(3) permits the Director to “require the verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.” Thus, contrary to what Tamai suggests, the Office is not required to accept an applicant’s transmittal letter requesting entry into the national stage as conclusive proof that a foreign language applicants contains a particular disclosure.¹²

On appeal, Tamai also argued that, although he never made it known to the board or Stevens that a translation of the PCT ‘947 application existed in the file of the ‘183 application, the provisions of 37 CFR 1.639(a) that certain proofs need not be filed with a motion, opposition, or reply if the proof relied upon is part of the interference file or in an application of which benefit of the filing date has been accorded or is being sought protected him from having to file a translation and affidavit as required by 37 CFR 1.637(f) and 1.647. The court disagreed, stating that:

As a preliminary matter, the Office’s interpretation of its own regulations is entitled to substantial deference. *Bd. of Regents of the Univ. of Wash.*, 334 F.3d at 1266. On reconsideration, the Board addressed this argument holding that Rule

¹² 366 F.3d at 1332-33, 70 USPQ2d at 1770-1771.

639(a) does not obviate Rules 637(f) and 647. Given that Rules 637(f) and 647 are very clear in requiring the filing of a translation and affidavit with the preliminary motion for benefit, we defer to the Board's interpretation that Rule 639(a) and Rules 637(f) and 647 are separate rules that must be followed by parties to an interference. Moreover, we note that Tamai's argument on this point is undercut by the fact that his motion and reply did not notify the Board or Stevens that the '183 application was the translation of the PCT '947 application. Had Tamai alerted the Board and Stevens to the presence of the translation, and filed an affidavit attesting that the '183 application was an accurate translation of the PCT '947 application, the Board might have been more lenient.¹³

The court reversed the board's decision and remanded the case to the board with instructions to enter judgment in favor of Stevens.

Harris v. Dobrusin

Harris v. Dobrusin, 73 USPQ2d 1537 (PTOBPAI 2004¹⁴) (opinion delivered by APJ Torczon for a panel that also consisted of APJ's Schaffer and Nagumo),¹⁵ strongly suggests that the result reached in *Stevens* was wrong and that the wrong result was caused (1) by the wrongful failure of the board in declaring the *Stevens* interference to list the actual filing date of Tamai's involved national application (i.e., the date Tamai's PCT application was filed) and (2) by Tamai's choice to file a 37 CFR 1.633(f) motion to be

¹³ 366 F.3d at 1335, 70 USPQ2d at 1773.

¹⁴ The board's opinion was decided May 6, 2004, but was not published until 2005.

¹⁵ The published opinion does not indicate if it is precedential or non-precedential.

accorded the benefit of the filing date of the international application. Consequently, the panel in *Steven* denied the motion because of Tamai's failure to comply with all of the requirements for such a motion as stated in 37 CFR 1.637(f).

In *Harris*, the opinion states that the notice declaring the interference "accorded Dobrusin the benefit of the filing date of its international application"¹⁶ -- i.e., the actual filing date of the international stage of its PCT application, and that Harris filed a motion under 37 CFR 1.633(g) "attacking the benefit accorded to Dobrusin."¹⁷ Dobrusin opposed the motion, in part, on the basis that it was automatically entitled to its PCT filing date as the effective filing date of its involved national application.¹⁸ The board concluded that Dobrusin was entitled to its PCT filing date as a matter of law because its involved application was simply the national stage of the PCT application rather than a distinct application. Consequently, the board dismissed Harris's motion.¹⁹ Less than a week after the board issued its ultimate judgment, Harris again requested reconsideration, this time on the basis of the new decision of the Federal Circuit in *Stevens*.²⁰

¹⁶ 73 USPQ2d at 1538.

¹⁷ *Id.* The opinion does not explicitly state whether the notice declaring interference (a) specified the international PCT application as an "accorded benefit" application or (b) simply stated the PCT application date as the filing date of Dobrusin's involved national application.

¹⁸ 73 USPQ2d at 1538.

¹⁹ *Id.* Harris filed a timely request for reconsideration of parts of the board's opinion, but it did not seek reconsideration of its motion attacking benefit.

²⁰ *Id.*

According to the board's decision on reconsideration, its original decision on Harris's preliminary motion attacking benefit provided the following explanation for the decision to dismiss the motion:

Dobrusin does not specify whether it is relying on the statute or rule as of a particular year. In the absence of a reliance interest, the current law is applied. *Singh v. Brake*, 222 F.3d 1362, 1371, 55 USPQ2d 1673, 1679 (Fed. Cir. 2000). The current text of 35 U.S.C. 363 is:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

The statute refers to the "international application designating the United States", which means an application filed under the PCT specifying the United States as a country in which a patent is sought. 35 U.S.C. 351(a),(c) & (e). Under 35 U.S.C. 371, the national stage for the PCT is "commenced" upon the satisfaction of certain formal requirements, including the payment of a fee and submission of the inventor's oath. Despite the payment of a new fee and the submission of the oath at commencement of the national stage, the Office treats the international application and the national stage of the international application as a single application. As the Manual of Patent Examining Procedure (§ 1893.03(b)) puts it:

An International application designating the U.S. has two stages

(international and national) with the filing date being the same in both stages. Often the entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.²¹

The consequence is that we do not have the power under 37 C.F.R. § 1.633(g) to provide Harris with the relief sought. Rule 633(g) provides:

A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier filed application.

Since the PCT application is not an earlier application, but rather a stage of the international application, Rule 633(g) does not apply.²²

The panel's opinion discusses the applicability of the *Stevens* opinion and distinguishes it from the factual situation before the panel.

Comments

(1) The decision in *Stevens* makes it perfectly clear that every link between an earlier filed application and an application or patent for which the benefit of the filing date of an earlier filed application or applications is sought must meet the applicable

²¹ 73 USPQ2d at 1538-39.

²² 73 USPQ2d 1539.

requirements of 35 USC 119, 120, 121, and/or 365. That issue has arisen before in infringement cases where the required reference to an earlier bridging application had not been inserted in a necessary bridging application. For example, see *Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2nd Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); and *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962).

The issue has also arisen in previous interference proceedings.

In *Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580 (1972) (Rich, J.), the court stated with regard to a situation similar to that involved in *Stevens*:

Thus, we do not reach the question of whether the junior party's parent application supported the count, at least so far as the burden-of-proof issue is concerned. Since it was not specified in the notice of interference, the only way that Myers et al. could obtain the benefit of its filing date was by way of a motion under Rule 231(a)(4). They made no such motion, and their only excuse for not having done so [footnote omitted] is no excuse at all. We therefore conclude that under the circumstances the board imposed the correct burden of proof on the junior party.²³

Breen v. Cobb, 487 F.2d 558, 560, 179 USPQ 733, 734-35 (CCPA 1973), involved a situation in which the notice declaring the interference accorded Breen the benefit of the filing date of a grandparent application. However, the notice did not mention the bridging parent application. Cobb appealed from the board's decision awarding priority to Breen on the basis of the constructive reduction to practice in the

²³ 455 F.2d at 601, 172 USPQ at 584-85; emphasis supplied.

grandparent application. Cobb relied heavily on *Myers*, which was decided after the board's decision in *Breen*. The court distinguished the *Myers* decision as follows:

In *Myers* ... the original notice of interference did not specify *any* prior application and the examiner accorded the benefit of the prior application only in the denial of a motion to dissolve. Here there was an award of the benefit of a prior application in the original notice and the required bridging application serial No. 43,897 was identified in the involved application. Admittedly, Cobb was not prejudiced. It is true that we adopted, in *Myers*, the First Assistant Commissioner's view that a rigid adherence to the rules, absent special circumstances which might justify their waiver under Rule 183, was necessary to provide an orderly procedure, even though no special damage occurred from the waiver.

Under the circumstances here present, we do not consider that a waiver of the rules occurred or is required. The purpose of Rule 224 was fully accomplished when the notice of interference set forth the award of the benefit of application serial No. 698,103. That notice necessarily inherently included the bridging application serial No. 43,897 required to make the notice effective. In *Myers* there was no indication in the notice of interference of any award and thus nothing into which a missing application could be considered as incorporated. The notice of interference in *Myers* was complete in itself, requiring nothing more to make it effective. We do not disturb the holding in *Myers*, but we decline to extend it to the circumstances of this case.²⁴

²⁴ 487 F.2d at 560, 179 USPQ at 735; emphasis supplied.

The court's opinion in *Stevens* appears to be consistent with both *Myers* and *Breen*. Obviously, a notice declaring an interference should be carefully examined to determine whether all of the appropriate benefits of filing dates of parent applications were accorded. If any appropriate benefit was not accorded, a motion for benefit including all necessary bridging applications should be filed.

There is nothing in the court's opinion to suggest what the board was thinking, and the board's opinion on the request for reconsideration offered nothing explaining how, in its view, its award of benefit of the Japanese application without also awarding the benefit of the necessary bridging application could be based, in spite of requests from both the winning and losing parties for such an explanation. Certainly, the board's assertion that the inconsistency in the treatment of the benefit applications "arises because of Tamai's inconsistent actions in regard to these two applications" does not explain the board's inconsistent holdings. As the court concluded, Tamai's inconsistent actions led to a consistent result--denial of benefit of the filing dates for both applications.

(2) The present version of the MPEP makes it perfectly clear in § 1893.03 and § 1893.03(a) (Rev. 2, May 2004) that the original filing date of the PCT application is the *actual* filing date of the national stage application (except for purposes of 35 U.S.C. 102(e), when applicable).

If the result in *Stevens* was the consequence of (1) an error by the board in the notice declaring the interference, coupled with an unfortunate choice by Tamai to attempt to correct that error by a motion requesting benefit and (2) the failure of the board's panel in *Stevens* to rectify the error *sua sponte*, *Stevens* and *Harris* certainly lend a great deal

of ammunition to those who believe that interference practice is overly concerned with micromanaging procedural aspects to the detriment of justice. Until the situation becomes more clear, a party in Tamai's situation would be wise to proceed as Tamai proceeded except for (1) filing and serving the papers required by the rules relating to motions for benefit and (2) requesting²⁵ that the board correct its notice declaring the interference by correctly stating the actual filing date under the statute and the PCT treaty of its national stage application, citing *Harris* to support the position that the notice is legally erroneous.

(3) One of the great mysteries of interference practice is when an APJ or a panel of APJs will apply the technical requirements of the rules mercilessly, as here and in *Abrutyn v. Giovannello*, 15 F.3d 1048, 29 USPQ2d 1615 (Fed. Cir. 1994), discussed in Gholz, *A Critique of Recent Opinions of the Federal Circuit in Patent Interferences*, 77 JPTOS 427, 436-39 (1995), and when the APJ will apply a "no harm, no foul" rule. The board's conclusion, paraphrased by the court, that "Tamai's failure to follow the rules prejudiced Stevens, who was entitled to expect that Tamai would follow them"²⁶ is no help at all. That could be said every time that a party doesn't literally follow a rule--yet it has been our experience that many of the APJs will often refuse to take any action against a party that has not literally followed a rule on the ground that its opponent has suffered no real prejudice. However, the fact that, occasionally, an APJ or a panel of APJs does enforce a rule according to its literal terms despite the fact that the opposing party has

²⁵ The request may be made by way of a conference call to the APJ in charge of the interference or by filing a miscellaneous motion to correct the error.

²⁶ 366 F.3d at 1329, 70 USPQ2d at 1768.

suffered no real prejudice guarantees that such issues (or, as SAPJ McKelvey likes to call them, “side shows”) will be raised frequently.

(4) A practice tip: Ask your opponent to waive service of certified copies and certified translations in such situations. Frequently he or she will do so.

B. Noelle v. Lederman

In *Noelle v. Lederman*, 355 F.3d 1343, 69 USPQ2d 1508 (Fed. Cir. 2004) (opinion by Circuit Judge Gajarsa for a panel also consisting of Circuit Judges Clevenger and Bryson), the court affirmed the board’s decision “finding no interference-in-fact between the ‘480 application and the ‘771 patent and rejecting claims 51, 52, 53, 56, 59, and 60 of the ‘480 application pursuant to 35 U.S.C. §102(b)(2000).”²⁷

Presumably what the board actually did was to issue a judgment that Noelle’s noted claims were unpatentable, since the board does not “reject” claims. Instead, it issues a judgment that one or more claims of the party are unpatentable. The board in ex parte cases does from time to time make new “rejections” under 37 CFR 1.196(b) (“old rules”) or 41.50(b) (“new rules”). In addition, the basis for the board’s judgment of unpatentability appears to be 35 USC 102(e) and not 35 USC 102(b).²⁸

The finding of unpatentability under 35 USC 102 was based on a finding of insufficient disclosure in Noelle’s parent applications for a constructive reduction to practice of some of Noelle’s involved claims prior to the effective date of the prior art.

Lederman was involved in the interference on his U.S. Patent No. 5,474,771 (“the ‘771 patent”), issued on December 12, 1995, on an application filed on November 15, 1991.²⁹ Noelle’s involved application was Serial No. 08/742,480 (“the ‘480 application”). The ‘480 application was filed on November 1, 1996 as a continuation of

²⁷ 355 F.3d at 1344, 69 USPQ2d at 1510.

²⁸ See section XI.B infra.

²⁹ The issue date of Lederman’s ‘771 patent is not mentioned in the opinion. It was obtained by the authors from the PTO Official Gazette.

application Serial No. 08/338,975, filed November 14, 1994, which was filed as a continuation of Serial No. 07/835,799, filed February 14, 1992.³⁰

The opinion states the background of the interference as follows:

The present interference involves competing claims to an antibody (“CD40CR antibody”) that represents the cell-to-cell signaling interaction between helper T-cells and B-cells. CD40CR antigen is found on activated, but not resting, helper T-cells. CD40CR antigen acts as a “key” to unlock a protein (“CD40”) located on the surface of resting B-cells. Once CD40CR antigen and CD40 bind, the B-cell begins down the pathway to differentiation, proliferation, and antibody production. The CD40CR antibody binds to the CD40CR antigen located on the T-cell surface, thereby inhibiting its ability to bind to the CD40 receptor located on the resting B-cell. B-cells cannot then become activated, thereby preventing the B-cell from producing antibodies. CD40CR antibodies are useful for treating a hyperactive immune system that causes allergic reactions and autoimmune diseases.

Noelle’s ‘480 application was filed November 1, 1996. The ‘480 application is a continuation of application Serial No. 08/338,975 (the ‘975 application”), filed November 14, 1994, which is in turn a continuation of application Serial No. 07/835,799 (“the ‘799 application”), filed on February 14, 1992. The claims of Noelle’s ‘480 application are directed to the genus, murine (“mouse”), chimeric (“hybrid”), humanized, and human forms of the CD40CR monoclonal antibody. Noelle also

³⁰ 335 F.3d at 1345, 69 USPQ2d at 1510.

claims the hybridomal cell lines that produce the CD40CR antibody.

Lederman's '771 issued^[31] patent has an effective filing date of November 15, 1991. Lederman's '771 patent describes and claims the human form of CD40CR monoclonal antibody ("the '5c8 antibody"). The 5c8 antibody binds to "the 5c8 antigen located on the surface of activated T cells and thereby inhibits T cell activation of B cells." Also, Lederman claims a hybridoma cell line created to produce monoclonal antibody 5c8.³²

The interference was declared on September 3, 1999. Noelle was designated as the junior party, and Lederman was designated as the senior party, based on their effective filing dates. The only count read:

The monoclonal antibody of claim 1 of 5,474,771 or the monoclonal antibody of claim 42 or claim 51 of 08/742,480.³³

The panel pointed out that:

For sake of the [sic] simplicity, Claim 1 of Lederman's '771 patent and Claim 52 of Noelle's '480 application will be referred to as claims to the "human" form of CD40CR antibody. Claims 42 and 51 of Noelle's '480 application will be referred to as claims to the "mouse" and "genus" forms of CD40CR antibody, respectively.

³¹ How could a patent not be "issued"?

³² 355 F.3d at 1345, 69 USPQ2d at 1510; footnotes omitted. Lederman uses the designation "5C8" instead of Noelle's "CD40CR"

³³ 355 F.3d at 1345, 69 USPQ2d at 1511.

On June 28, 2001 the Board held a hearing to dispose of the parties' preliminary motions. Lederman moved to have Noelle's claims rejected and sought to redefine the count. Likewise, Noelle also sought to have the count redefined. The Board denied Lederman's motions for judgment against Noelle's mouse claims for lack of written description, lack of enablement, and indefiniteness.*** The Board found that Lederman had failed to demonstrate that the mouse claims in Noelle's '480 application failed to comply with 35 U.S.C. §112, paragraphs (1) and (2), as of November 1, 1996, the date Noelle filed his '480 application. The Board, however, determined that the human and genus claims in Noelle's '480 application failed to comply with the written description requirement pursuant to 35 U.S.C. §112, paragraph (1), as of February 14, 1992, the date Noelle filed the previous '799 application. The Board made a detailed analysis of this court's precedent pertaining to the doctrine of written description, focusing on the holding from *Regents of the University of California v. Eli Lilly & Co.* that an "adequate written description of a DNA sequence claim required a precise definition, such as structure, formula, chemical name, or physical properties." 119 F.3d 1559, 1556 [43 USPQ2d 1398] (Fed. Cir. 1997). The Board analogized the DNA claims from *Regents* to the antibodies in Noelle's application. Accordingly, the Board held that Noelle's claims regarding the genus and human claims from the '480 application lacked written description support in the specification of Noelle's earlier '799 application because Noelle failed to describe any structural feature of the human or genus antibodies or antigen. In other words, the Board found that the claims covering the genus and human antibodies constituted new matter because they lacked adequate written description in Noelle's earlier '799

application. The Board did not reject the claims [sic], but rather denied them the benefit of the earlier filing date of Noelle '799.

Next, the Board addressed the implication of finding a lack of written description for the genus and human claims in Noelle's '480 application. The Board determined that the claims to the human and genus forms of CD40CR antibody in Noelle's '480 application were anticipated by either Lederman '771, which claims priority to U.S. application 07/792,728, filed November 15, 1991, or Armitage 5,961,974 (the "'974 patent"), which claims priority to U.S. application 07/783,707 and 07/805,723 filed October 25, 1991, and December 5, 1991, respectively. Noelle had not attempted to distinguish his human and genus claims from the prior art and had conceded that Lederman '771 and Armitage '974 would anticipate those claims if the '480 application was not afforded the earlier filing date of Noelle's '799 application. Thus, the Board found the genus and human claims of Noelle's '480 application to be anticipated under 35 U.S.C. §102(b) [sic] by the two forms of prior art and, as a result, rejected the claims [sic] to the human and genus forms of CD40CR antibody and their respective cell lines pursuant to 37 C.F.R. §1.641.

On October 19, 2001, the Board ruled on the motions remaining from the previous hearing. The Board had determined in its previous hearing that the deferred motions were essentially requests to decide whether an interference-in-fact existed between the two parties' claims. Lederman then withdrew his pending motion and filed a new motion requesting that the Board find no interference-in-fact.

The Board concluded from the evidence submitted that there was no interference-in-fact.³⁴

The court affirmed the board's decision that Noelle's '480 application was not entitled to the benefit of the filing date of the '799 application. It reasoned that:

Indeed, the court in *Enzo Biochem v. Gen-Probe, Inc.*, 323 F.3d 956, 964 (Fed. Cir. 2002) ("*Enzo Biochem II*"), stated that "the written description requirement would be met for all of the claims [of the patent at issue] if the functional characteristic of [the claimed invention was] coupled with a disclosed correlation between that function and a structure that is sufficiently known or disclosed." Also, the court held that one might comply with the written description requirement by depositing the biological material with a public depository such as the American Type Culture Collection ("ATCC"). *Id.* at 970. The court proffered an example of an invention successfully described by its functional characteristics. The court stated:

For example, the PTO would find compliance with 112, paragraph 1, for a

³⁴ 355 F.3d at 1346-47, 69 USPQ2d 1511-12. The authors have determined (1) that the actual filing date of Lederman's '771 application, as well as its "effective filing date" and "priority date" was November 15, 1991, and (2) that the issue date of Armitage '974 was October 5, 1999. Obviously, neither the '771 patent nor the '974 patent constituted written descriptions or patents more than a year prior to the November 1, 1996 filing date of Noelle's '480 application. Thus, the statutory basis for holding Noelle's claims unpatentable over those patents must have been 35 USC 102(e), not 35 USC 102(b).

claim to an isolated antibody capable of binding to antigen X, notwithstanding the functional definition of the antibody, in light of the well defined structural characteristics for the five classes of antibody, the functional characteristics of antibody binding, and the fact that the antibody technology is well developed and mature.

Id. The court adopted the USPTO Guidelines as persuasive authority for the proposition that a claim directed to “any antibody which is capable of binding to antigen X” would have sufficient support in a written description that disclosed “*fully characterized* antigens.”***

Therefore, based on out past precedent^[35], as long as an applicant has disclosed a “*fully characterized* antigen. “ either by its structure, formula, chemical name, or physical properties, or by depositing the protein in a public depository, the applicant can then claim an antibody by its binding affinity to that described antigen.

Noelle did not provide sufficient support for the claims to the human CD40CR antibody in his ‘480 application because Noelle failed to disclose the structural elements of human CD40CR antibody or antigen in his earlier ‘799 application. Noelle argues that[,] because antibodies are defined by their binding affinity to antigens, not their physical structure, he sufficiently described human CD40CR antibody by stating that it binds to human CD40CR antigen. Noelle cites *Enzo Biochem II* for this proposition. This argument fails, however, because Noelle did not sufficiently describe the human CD40CR antigen at the time of the filing of the ‘799 patent application. In fact, Noelle only described the mouse antigen when he

³⁵ How could a precedent not be “past”.

claimed the mouse, human, and genus forms of CD40CR antibodies by citing to the ATCC number of the hybridoma secreting the mouse CD40CR antibody. If Noelle had sufficiently described the human form of CD40CR antigen, he could have claimed its antibody by simply stating its binding affinity for the “fully characterized” antigen. Noelle did not describe human CD40CR antigen. Therefore, Noelle attempted to define an unknown by its binding affinity to another unknown. As a result, Noelle’s claims to human forms of CD40CR antibody found in his ‘480 application cannot gain the benefit of the earlier filing date of his ‘799 patent application.³⁶

Finally, the court agreed with the board that Noelle cannot claim the genus form of CD40CR antibody by simply describing mouse CD40CR antigen. It wasn’t persuaded by Noelle’s arguments based on the board’s decision in *Staehelin v. Secher*, 24 USPQ2d 1513, 1519 (PTOBPAI 1992):

Noelle’s reliance on *Staehelin* is misplaced. First, it is a decision from the Board of Patent Appeals and Interferences which may be persuasive but it is not binding precedent on this court. Second, the Board in *Staehelin* cited *Utter* to support the proposition that a patentee need not cite every species of an antibody in order to claim the genus of that antibody. In *Utter*, this court held that not every species of scroll compressor used in air conditioners must be described in order for a genus claim to meet the written description requirement. 845 F.2d at 994. Since the Board’s decision in *Staehelin*, this court has subsequently held that a patentee of a biotechnical invention cannot necessarily claim a genus

³⁶ 355 F.3d at 1348-49, 69 USPQ2d at 1513-14.

after only describing a limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated. *See Enzo Biochem II*, 323 F.3d at 965; *Regents*, 119 F.3d at 1568. Therefore, to the extent the Board's decision in *Stahelin* conflicts with our decisions in *Enzo Biochem II* and *Regents*, it has been limited in applicability.³⁷

Comments

It is not clear from the opinion if or just how the disclosure in Noelle's '480 application differed from the disclosures in its parent '975 and '799 applications. The '480 application is said to be a "continuation" of the '975 application, which is said to be a continuation of the '799 application -- which of course suggests that the disclosures of all three were identical. However, it is possible that one of the downstream applications was actually a continuation-in-part.

It is also not clear from the opinion's statement that "The Board, however, determined that the human and genus claims in Noelle's '480 application failed to comply with the written description requirement pursuant to 35 U.S.C. §112, paragraph (1), as of February 14, 1992, the date Noelle filed the previous '799 application"³⁸ whether the parent applications contained descriptions of, and/or claims to, the human and genus forms, but lacked enablement for such scope. That is, it is unclear whether

³⁷ 355 F.3d at 1350, 69 USPQ2d at 1514. The bracketed material and the emphasis appear in the original.

³⁸ 355 F.3d at 1346, 69 USPQ2d at 1511.

and/or how the disclosure of the '480 application (including the claims) cured the defects in the disclosures of the two parent applications. Of course, one possible explanation is that Lederman's '771 patent issued nearly a year before Noelle filed the '480 application, thus making the human form of the antibody available in the prior art at that time. That is, Noelle may simply have kept the described but unenabled subject matter pending until the prior art provided the necessary enablement. However, (1) the court didn't say that and (2) that would indicate that the real issue was enablement rather than "written description."

VII. DERIVATION

Nothing relevant this year.

VIII. THE 35 USC 135(b) BAR

A. **The Federal Circuit Affirmed Both (1) the Board’s Jurisdiction to Declare Interferences to Decide 35 USC 135(b) Issues and (2) the Board’s Discretion Not to Decide Those Issues**

In re Sullivan

In *In re Sullivan*, 362 F.3d 1324, 70 USPQ2d 1145 (Fed. Cir. 2004) (opinion by Circuit Judge Linn for a panel also consisting of Senior Circuit Judge Archer and Circuit Judge Dyk), the court affirmed the board’s holding that it need not decide the issue of patentability under 35 USC 135(b) of Sullivan’s claims after the opposing party had conceded priority of invention. Although neither the board nor the court considered the 35 USC 135(b) issue substantively, the facts of the case raise some interesting questions. Sullivan appealed from a decision by the board in which the board entered judgment on priority against Sullivan and terminated the interference without deciding whether the opposing party Bingel was barred from provoking the interference for failing to present claims drawn to substantially the same invention claimed by Sullivan within the one year statute of limitations of 35 USC 135(b).³⁹

The opinion sets forth the background of the appeal as follows:

Sullivan was awarded United States Patent No. 6,015,916 on January 18, 2000. On August 10, 2001, Bingel copied claims 10-14 of the ‘916 patent in his pending patent application, Serial No. 09/508,057, to provoke an interference with that patent. On May 28, 2002, the Examiner declared an interference between the ‘916 patent and the ‘057 application. On November 20, 2002, the interference was redeclared to add Sullivan’s United States Patent No. 6,455,719.... At that time, the Board also entered an amendment to one of the copied claims in the ‘057 application.... After the interference was redeclared, Sullivan filed a number of preliminary motions, in which

³⁹ 362 F.3d at 1325, 70 USPQ2d at 1147.

he argued, inter alia, that the parties' claims corresponding to the interference were unpatentable as obvious in view of certain prior art references, and that the Bingel claims involved in the interference were barred by 35 U.S.C. § 135(b), because claims 10-14 of the '916 patent had been copied more than one year after the issuance of the patent.

Before the Board ruled on Sullivan's preliminary motions, however, it issued an order to Sullivan to show cause why judgment on priority should not be entered against him.¹

In response, Sullivan stated that he "acced[ed], on the facts presented, to the entry of judgment on priority only against Sullivan and in favor of Bingel." In light of this concession on priority, the Board terminated the interference.... Finding that "there is little justification in continuing the interference to develop fully issues that can be administered more efficiently in an examination," the Board recommended that the Examiner consider the patentability issues raised in Sullivan's preliminary motions.... The Board also noted that Sullivan was entitled to file a protest against the '057 application under 37 C.F.R. § 1.291....⁴⁰

¹Here the Board sua sponte issued the show cause order prior to addressing either the patentability motion or the Section 135(b) motion. Thus, this case does not present the question decided in *Berman v. Housey*, 291 F.3d 1345 [63 USPQ2d 1023] (Fed. Cir. 2002) of the order in which the Board should address a § 135(b) motion and a motion challenging patentability. *Id.* at 1352 ("[W]hen the Board is presented with both a preliminary motion involving a § 135(b) issue and a preliminary motion involving a garden-variety patentability issue, it should first address the former.").

The court first addressed Sullivan's arguments concerning the redeclaration of the interference:

⁴⁰ 362 F.3d at 1325-26, 70 USPQ2d at 1147. Citations to the board's opinion are omitted.

Sullivan challenged the final decision of the Board on a number of grounds. First, he argues that this court lacks jurisdiction to review the decision because the “the Board never acquired jurisdiction,” allegedly because some of the claims involved in the interference were copied more than one year after the issuance of the ‘916 patent. Sullivan’s jurisdictional argument is unpersuasive. This court has jurisdiction over appeals from decisions of the Board “with respect to . . . interferences” pursuant to 28 U.S.C. §1295(a)(4). Even if the Board’s assertion of jurisdiction were improper, this court would still have jurisdiction to review the decision, make that determination, and ultimately remand the case with instructions to dismiss. *See, e.g., Mitchell v. Maurer*, 293 U.S. 237, 243-44 (1934) (holding that jurisdiction was not proper in the district court and remanding with directions to dismiss).

Sullivan argues that the Board’s actions were “void ab initio” because the original declaration of the interference was allegedly unlawful. Whether or not the original interference was erroneously declared, however, the Board subsequently redeclared the interference in the exercise of its discretion under 35 U.S.C. § 135(a) and 37 C.F.R § 1.640(b)(1). The Board noted that the Bingel amendment to claim 8, which it entered simultaneously with the redeclaration of the interference, “may obviate Sullivan’s 35 U.S.C. § 135(b) motion.” . . . This was so because Sullivan “failed to specifically explain how Bingel’s amended claim 8 is the ‘same or substantially the same subject matter’ as claimed in Sullivan’s patent.” *Id.* To establish that the Board lacked jurisdiction, Sullivan must demonstrate not that the original declaration was improper, but rather that the redeclaration of the interference between the amended Bingel application and the two Sullivan patents was somehow unlawful.⁴¹

The court concluded that:

On this record, we cannot conclude that the Board’s actions in redeclaring the interference were arbitrary, capricious, an abuse of discretion, unsupported by

⁴¹ 362 F.3d at 1326-27, 70 USPQ2d at 1147-48.

substantial evidence, or otherwise not in accordance with law.⁴²

Comments

The facts stated (and those not stated) in the opinion raise clear questions as to why the interference was declared, and, since it was declared, why the “threshold” issue of compliance with 35 USC 135(b) was returned to the examiner for decision rather than being decided by the board. Sullivan’s ‘916 patent issued on January 18, 2000, and Bingel copied claims 10-14 of the ‘916 patent in his pending patent application to provoke an interference with the ‘916 patent on August 10, 2001, more than a year and a half after Sullivan’s patent issued. Of course, the examiner did not “declare” the interference that was declared on May 28, 2002.⁴³ On November 20, 2002, the interference was redeclared to add Sullivan’s later issued ‘719 patent. At that time, (i.e., November 20, 2002), nearly three years after Sullivan’s ‘916 issued, the board granted a motion authorizing the entry of an amendment to claim 8 in the ‘057 application.

It is crystal clear that none of the copied claims or the amendment to Bingel’s claim 8 was filed within the time bar that tolled from the date of the issuance of Sullivan’s ‘916 patent. The second Sullivan patent, the ‘719 patent, was obviously issued considerably later, but since that patent was added to the interference by redeclaration, the invention that it claimed must have been “substantially the same invention” claimed in the ‘916 patent (or at least the same “patentable invention.”).

⁴² 362 F.3d at 1327, 70 USPQ2d at 1148 (footnote omitted).

⁴³ Interferences are declared by an APJ; usually at the recommendation of an examiner.

37 CFR 1.610(a); 41.203(b)

The time bar for copying claims is measured from the issue date of the first patent containing the claims that have been copied. *DeFerranti v. Harmatta*, 273 F. 357, 50 App. D.C., 1921 CD 224 (D.C. Cir. 1921). There is no indication in the Sullivan opinion whether the copied claims or the amendment to claim 8 was unnecessary or that Bingel's application contained any other claims, whether or not still pending in the application or cancelled, that defined substantially the same invention as Sullivan's patent claims at some time within one year from the issue date of the '916 patent. Compare *Corbett v. Chisholm*, 568 F.2d 759, 764-65, 196 USPQ 337, 342-43 (CCPA 1977) (Rich, J.); and *Cryns v. Musher*, 161 F.2d 217, 219-20, 73 USPQ 290, 292 (CCPA 1947).

If none of Bingel's claims to substantially the same invention was present within the one year time period, why was the interference declared? The examiner could just have rejected the newly presented claims. *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997), discussed in Gholz, "A Critique of Recent Opinions of the Federal Circuit in Patent Interferences," 86 JPTOS 321, 322-35 (1998).

Since Sullivan was the designated junior party, Bingel's application presumably had an earlier effective filing date. The board's order to show cause and Sullivan's subsequent concession of priority also indicate that Bingel's application's filing date was perhaps a great deal earlier.

The board's decision to terminate the interference because the 35 USC 135(b) issue would be best handled by the examiner seems particularly lame. Isn't the examination process where the issue was located prior to the declaration of the interference? Why wasn't the issue "efficiently" resolved then? It could hardly have been overlooked in view of the long belated attempts to provoke the interference.

Of course, the board clearly had jurisdiction under 35 USC 135(a) (1985) to determine the 135(b) issue, but the obvious question is why the board declared the interference in the face of clear 35 USC 135(b) issues in view of its usual steadfast refusal to declare interferences involving a patent until all ex parte issues are settled in the provoking application. Does that only apply to hard cases and not to cases where one or two patents can be disposed of easily and quickly?

IX. CORROBORATION

Nothing relevant this year.

X. INTERFERENCE PRATICE

A. **The Court Re-Affirms The Board’s Two-Way Test for Interference-In-Fact and Also Affirms A Further, Narrow Construction of the Rules**

Noelle v. Lederman

In *Noelle v. Lederman*, 355 F.3d 1343, 69 USPQ2d 1508 (Fed. Cir. 2004)

(opinion by Circuit Judge Gajarsa for a panel also consisting of Circuit Judges Clevenger and Bryson), the court affirmed the board’s judgment of no interference-in-fact and reiterated its acceptance of the board’s “two-way test” for interference-in-fact. In addition, the court endorsed the board’s position that only the claims of a party, and not the supporting enabling disclosure of that claimed invention in the rest of the specification, can be used to determine whether or not the parties are claiming the “same patentable invention.”

The court explained that:

The present interference involves competing claims to an antibody (“CD40CR antibody”) that represents the cell-to-cell signaling interaction between helper T-cells and B-cells. CD40CR antigen is found on activated, but not resting, helper T-cells. CD40CR antigen acts as a “key” to unlock a protein (“CD40”) located on the surface of resting B-cells. Once CD40CR antigen and CD40 bind, the B-cell begins down the pathway to differentiation, proliferation, and antibody production. The CD40CR antibody binds to the CD40CR antigen located on the T-cell surface, thereby inhibiting its ability to bind to the CD40 receptor located on the resting B-cell. B-cells cannot then become activated, thereby preventing the B-cell from producing antibodies. CD40CR antibodies are useful for treating a hyperactive immune system that causes allergic reactions and autoimmune diseases.⁴⁴

Lederman’s ‘771 patent describes and claims the human form of CD40CR

⁴⁴ 355 F.3d at 1345, 69 USPQ2d at 1510 (footnote omitted).

monoclonal antibody. Noelle's '480 application claims are directed to the genus, murine ("mouse"), chimeric ("hybrid"), humanized, and human forms of the CD40CR monoclonal antibody.⁴⁵

The single count of the interference read:

The monoclonal antibody of claim 1 of 5,474,771 or the monoclonal antibody of claim 42 or claim 51 of 08/742,480.⁴⁶

The court explained that,

For sake of the [sic] simplicity, Claim 1 of Lederman's '771 patent and Claim 52 of Noelle's '480 application will be referred to as claims to the "human" form of CD40CR antibody. Claims 42 and 51 of Noelle's '480 application will be referred to as claims to the "mouse" and "genus" forms of CD40CR antibody, respectively.

On June 28, 2001 the Board held a hearing to dispose of the parties' preliminary motions. Lederman moved to have Noelle's claims rejected and sought to redefine the count. Likewise, Noelle also sought to have the count redefined. The Board denied Lederman's motions for judgment against Noelle's mouse claims for lack of written description, lack of enablement and indefiniteness. ... The Board found that Lederman had failed to demonstrate that the mouse claims in Noelle's '480 application failed to comply with 35 U.S.C. § 112, paragraphs (1) and (2), as of November 1, 1996, the date Noelle filed his '480 application. The Board, however, determined that the human and genus claims in Noelle's '480 application failed to comply with the written description requirement pursuant to 35 U.S.C. § 112, paragraph (1), as of February 14, 1992, the date Noelle filed the previous '799 application. ...

⁴⁵ 355 F.3d at 1345, 69 USPQ2d at 1510.

⁴⁶ 355 F.3d at 1345, 69 USPQ2d at 1511.

Next, the Board addressed the implication of finding a lack of written description for the genus and human claims in Noelle's '480 application. The Board determined that the claims to the human and genus forms of CD40CR antibody in Noelle's '480 application were anticipated by either Lederman '771, which claims priority to U.S. Application 07/792,728 filed November 15, 1991, or Armitage 5,961,974 (the "'974 patent"), which claims priority to U.S. applications 07/783,707 and 07/805,723 filed October 25, 1991, and December 5, 1991, respectively. Noelle had not attempted to distinguish his human and genus claims from the prior art and had conceded that Lederman '771 and Armitage '974 would anticipate those claims if the '480 application were not afforded the earlier filing date of Noelle's '799 application. Thus, the Board found the genus and human claims of Noelle's '480 application to be anticipated under 35 U.S.C. § 102(b) by the two forms of prior art and, as a result, rejected the claims to the human and genus forms of CD40CR antibodies and their respective cell lines pursuant to 37 C.F.R. § 1.641.

On October 19, 2001, the Board ruled on the motions remaining from the previous hearing. The Board had determined in its previous hearing that the deferred motions were essentially requests to decide whether an interference-in-fact existed between the two parties' claims. Lederman then withdrew his pending motions and filed a new motion requesting that the Board find no interference-in-fact.⁴⁷

In summary, the only claims remaining patentable after the board's first decision were Lederman's claims directed to the human antibody and Noelle's claims directed to the mouse antibody, and the court noted that:

The Board concluded from the evidence submitted that there was no interference-in-fact. The Board reasoned that a person of ordinary skill in the art lacked a reasonable expectation of success of obtaining the other party's claimed invention given the state of the art at the time. The Board noted three different methods disclosed in Noelle's

⁴⁷ 355 F.3d at 1346-47, 69 USPQ2d at 1511-12.

'480 application by which a person of ordinary skill in the art could have isolated the human form of the CD40CR antibody given the mouse version of the CD40CR antibody. Dr. Edward A. Clark, Noelle's expert, declared that a person skilled in the art would have had a reasonable expectation of success in isolating human CD40CR antibody by utilizing the methods disclosed in Noelle's specification.

First, Clark testified that human CD40CR antibody could be isolated by immunizing a host with human CD40CR antigen expressing cells or cell lines and selecting the antibody to the CD40CR antigen by functional or competition binding with CD40-Ig.⁴⁸ Next, Clark suggested methods of making and isolating antibodies using affinity purified human CD40CR antigen. Last, Dr. Clark declared that one skilled in the art could use [sic; could have used] the mouse CD40CR antibody or CD40-Ig to clone CD40CR antigen DNA using a method known as expression cloning.

The Board found that one skilled in the art would not have had a reasonable expectation of success of isolating human CD40CR antibodies given the mouse form of CD40CR antigen. At the outset, the Board reasoned that any reference to Noelle's own specification as prior art was improper because the specifications underlying the respective claims cannot be considered "prior art" and interference-in-fact analysis requires the comparison between the parties' claims, not their specifications. *In re Vaeck*, 947 F.2d 488, 493 [20 USPQ2d 1438, 1442] (Fed. Cir. 1991). Nevertheless, the Board refuted the three methods disclosed in Noelle's specification and endorsed by Clark. First, the Board found that the immunization technique found in the prior art would be ineffective because, at the relevant time, one skilled in the art would not have had a reasonable expectation of success of identifying the activated T-cells that produced the required CD40CR antigen or of isolating the antigen itself. Second, the Board found that it would have been "extremely difficult" for a person of ordinary skill in the art to isolate successfully CD40-Ig, which, as Noelle asserted, could then be used to obtain the claimed CD40CR antibodies. Third, the Board cited statements made during the

⁴⁸ 355 F. 2d at 1547-48, 69 USPQ at 1512 (footnote omitted).

prosecution of Armitage application 07/969,703 for the proposition that a skilled artisan could not have used expression cloning to isolate CD40CR antibody with a reasonable likelihood of success.

Thus, the Board determined that a person of ordinary skill in the art would not have been reasonably likely to isolate human CD40CR antibody, given Noelle's claimed invention of mouse CD40CR antibody. As a result, the Board found no interference-in-fact between Noelle's remaining murine CD40CR antibody claim and Lederman's claim to the human form of CD40CR antibody.
5

Citing its opinion in *Eli Lilly v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1267, 67 USPQ2d 1161, 1163 (Fed. Cir. 2003), the court explained that:

In order to determine whether the two parties claim the same patentable invention, the USPTO has promulgated a "two-way" test, which has been approved by this court. *Eli Lilly*, 334 F.3d at 1270. The two-way test reads as follows:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".
Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and nonobvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

37 C.F.R. § 1.601(n). In order for an interference-in-fact to exist, invention A must anticipate or make obvious invention B, *and* invention B anticipate or make obvious invention A, thereby meeting both prongs of the "two-way" test. ... The Board in the present case did the two-way test in a different way as follows:

Thus, for Lederman to succeed in its motion for no interference-in-fact, Lederman need only demonstrate that: (i) Lederman's claims are not anticipated or rendered

obvious by Noelle's remaining "mouse" claims; *or* (ii) Noelle's remaining "mouse" claims are not anticipated or rendered obvious by Lederman's claims.

(Emphasis in original).

Noelle's argument that the Board improperly required a two-way patentability test, or, as the Board phrased it, a "one-way distinctiveness" test, is without merit in light of this court's recent ruling in *Eli Lilly* upholding the Director's two-way test as consistent with the language of the regulation. 334 F.3d at 1268. Therefore, the Board applied the proper "two-way test." First, it determined that "one skilled in the art lacked a reasonable expectation of success of obtaining Lederman's claimed human subject matter when provided with Noelle's mouse subject matter and using the screening techniques cited by Noelle." Although the Board did not have to conduct the second prong of the test to find no interference-in-fact, it did so anyway by finding that "one skilled in the art would have lacked a reasonable expectation of success of obtaining Noel's 'mouse' subject matter when provided with Lederman's claimed 'human' subject matter and using the same screening methods." Therefore, the Board utilized the correct test to find no interference-in-fact.⁴⁹

However, the court also agreed with the board that:

Noelle's argument that the Board erred in its application of the obviousness question in the interference-in-fact analysis by ignoring the specification in Noelle's '480 application is also without merit. Both Lederman and Noelle concede that the anticipation portion of the interference-in-fact analysis is not an issue in light of the agreed variance between claims to mouse versus human forms of CD40CR antibodies. Thus, only the obviousness analysis pursuant to 35 U.S.C. § 103 is left to be determined. Obviousness is determined as follows:

a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they

⁴⁹ 355 F.3d at 1350-51, 69 USPQ2d at 1515.

should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success.

In re Vaeck, 947 F.2d at 493. Both the suggestion and reasonable expectation of success “must be found in the prior art, not in the applicant’s disclosure.” *Id.*; *see also In re Dow Chemical Co.*, 837 F.2d 469, 473 [5 USPQ2d 1529, 1531] (Fed. Cir. 1988).

The parties agree that a skilled artisan would have been motivated to obtain the human CD40CR antibody if the mouse CD40CR antibody were available. The two parties disagree, however, as to whether the prior art would provide a reasonable likelihood of success in so doing. Therefore, the issue before us is whether substantial evidence supports the Board’s determination that one of ordinary skill in the art would not have had a reasonable expectation of success of isolating the other party’s invention given the disclosures found in the claims. ...

Noelle argues that the methods disclosed in his ‘799 patent application would have provided a reasonable likelihood of success for a person of ordinary skill in the art to isolate human CD40CR antibodies using mouse CD40CR antibodies. Specifically, Noelle argues it would have been obvious to a skilled artisan to use the CD40-Ig fusion protein disclosed in the ‘799 application as a screen to locate, within a hybridomal library, monoclonal antibodies that specifically bind to human CD40CR antigen. Noelle further argues the Board improperly ignored this method of antibody isolation merely because it was disclosed in Noelle’s written description as opposed to Noelle’s claims.

The Board correctly found no interference-in-fact between Noelle’s claims and Lederman’s claims. First, the Board was correct in not considering Noelle’s methods of isolation of human CD40CR antigen using CD40-Ig found in his ‘799 specification because the methods were neither part of the parties invention nor “prior art.” USPTO rules establish that an interference-in-fact exists when both parties claim the “same patentable invention.”

37 C.F.R. § 1.601(n). A patentee’s invention is only found

in a patentee's claims, unless the patentee uses sufficient means-plus-function language to invoke 35 U.S.C. § 112, paragraph (6). Thus, if the Board is to compare two inventions, the Board must only compare the parties' claims. Noelle does not claim a method of isolating CD40CR antigens, CD40-Ig, or the receptor CD40 itself. Obviously, if certain terms in Noelle's or Lederman's claims were ambiguous, we could resort to the specification or other sources to define those terms; however, it is unnecessary here as none of the terms in the claims are ambiguous. Therefore, Noelle cannot rely on methods of isolating human CD40CR antigen using CD40-Ig in order to prove obviousness between his invention and Lederman's invention because the method is not claimed.⁵⁰

Finally, the court found sufficient evidence to support the board's conclusion that the methods described in Noelle's application would not have provided a reasonable expectation of success in obtaining the human antibody.

Comments

The acceptance by the panels of the board and the court of the categorical principle that only the subject matter set forth in a claim may be considered in determining whether opposing parties are claiming the "same patentable invention" is troubling. Neither the board nor the court cited any controlling precedent or gave any reasoned analysis to support that proposition. The Vaeck and Dow opinions were limited to ex parte determinations of patentability over prior art. They did not involve an interference-in-fact issue, and the portion of the Vaeck opinion quoted in the court's opinion sheds no light on what constitutes prior art, either in the context of a conventional ex parte rejections over prior art or in the context of determining whether different parties are claiming the "same patentable invention."

⁵⁰ 355 F.3d at 1351-52, 69 USPQ2d at 1515-16.

The board's entire analysis of the issue appears as follows:

The parties['] specifications, however, are not available as prior art for determining whether an interference-in-fact exists.

An interference-in-fact exists when:

An *interference-in-fact* exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count defines the same patentable invention.

37 CFR § 1.601(j) (emphasis in original). The test for whether claims define the same or separate patentable inventions is as follows:

Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A."

37 CFR § 1.601(n) (emphasis in original). Thus, interference-in-fact questions require an analysis of whether or not a parties [sic; party's] corresponding *claims* anticipate or render obvious the opposing parties [sic; party's] corresponding *claims*.

In determining whether an invention is a separate patentable invention, the parties['] specifications underlying the respective corresponding claims are not considered prior art. The specifications, however, could be relied upon to serve as a dictionary for the terms appearing

in the claims or for admissions against interest regarding prior art.⁵¹

The legal principle as broadly stated by the board and the court panel deserves future consideration. The practical or legal basis for using the specification as a dictionary for the claims, but not using it for any other purpose, certainly is not clear.⁵² After all, 37 CFR 1.606(n) uses the language “invention “A”” and “invention “B””, not “claim A” and “claim B.” The “invention,” while defined by one or more claims, is the thing that is defined by the claim, not simply the picture or words in the claim. *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963) (Rich, J.) (“But a formula is not a compound and while it may serve in a claim to *identify* what is being patented, as the metes and bounds of a deed identify a plot of land, the *thing* that is patented is not the formula but the compound that is identified by it.”); and *In re Ruschig*, 343 F.2d 965, 972-73, 145 USPQ 274, 281-82 (CCPA 1965) (Rich, J.).

Presumably, it would also be permissible to look to the party’s specification to determine whether the subject matter defined by a claim is supported by an enabling disclosure. That is, it is a fundamental legal principle that “prior art” for anticipation must be enabling (at least with regard to “how to make”) (e.g., *In re LeGrice*, 301 F.2d 929, 133 USPQ 65 (CCPA 1962); and *Akzo N. V. v. U. S. Int’l Trade Comm’n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) (stating this to be a well established principle). According to the legal formulations set forth by the board (which ignores everything but the claimed structure) and the court, even identical claims in different applications or

⁵¹ Noelle v. Lederman, Interference No. 104,415, “FINAL DECISION,” Paper No. 135 pages 15-16 (PTOBPAI 2001).

⁵² It appears to have been adapted whole from obviousness-type double patenting law.

patents could not necessarily meet the tests of anticipated or obviousness set forth in 37 CFR 1.601(n) and its progeny 41.203(a) as interpreted by the board and the court.⁵³

But, anticipation aside, it is well established that it is necessary in determining the obviousness of a claimed structure to consider, among other things, (1) the manner of preparation of the claimed subject matter vis-à-vis the prior art, (2) the structural similarities as well as the differences between the claimed structures and those of the prior art, and (3) the presence or absence of properties or uses which would be obvious in view of the prior art. *In re Burt*, 356 F.2d 115, 148 USPQ 548 (CCPA 1966). Moreover, a proper determination of obviousness of “the invention as a whole” quite frequently requires an evaluation of factors arising *even after the time the invention was made*, such as unexpected properties later discovered, commercial success, reception of the invention by the inventor’s peers, etc.

It is unclear whether the rule set down by the board (in a non-precedential opinion) and the court (in an unfortunately precedential opinion) would exclude evidence of unexpected properties possessed by invention “A” unless those properties were expressly set forth in the claim.

More fundamentally, the expression “patentable invention” set forth in 35 USC 135(a) and “invention” as used in priority practice is not necessarily limited to the *thing*

⁵³ Consider the case of a compound A, which can only be prepared by a new and nonobvious process, which is disclosed by both parties, but only the compound is claimed. Presumably, the board and the court would find no interference-in-fact because the claim defined only the compound, and the prior art does not enable the making of the compound. *In re Brown*, 329 F.2d 1006, 141 USPQ 245 (CCPA 1964).

(i.e., method, manufacture, or article) that is *defined* in the claim. A *patentable* invention requires not only a claim which sets forth the metes and bounds of what the inventor regards as his invention in accordance with 35 USC 112 ¶ 1, but also the necessary *enablement* (i.e., manner of making and using the claimed inventions) in a clear and concise description. Even conception of a chemical substance “invention” requires also a conception of a process or processes for making the structure and a manner of using that structure. *Kridl v. McCormick*, 105 F.3d 1446, 1449-50, 41 USPQ2d 1686, 1690 (Fed. Cir. 1997).

It is not the function of a claim to provide a complete enabling description of the invention and the manners of making and using it. The function of the claim (identification) should not be confused with the function of the specification (constructively reducing the invention defined by a claim to practice). *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1274, 23 USPQ2d 1839, 1840 (Fed. Cir. 1992)(Rich, J.), and *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1575, 1 USPQ2d 1081, 1087 (Fed. Cir. 1986).

In fact, a bare comparison of chemical structures, such as those generally appearing in claims, does not necessarily render *prima facie* obvious even very closely related structures such as homologs, etc. *In re Stemniski*, 444 F.2d 581, 170 USPQ 343 (CCPA 1971); and *In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984).

In short, a bare comparison of the structures of inventions A and B, such as normally appears in the claims, is normally insufficient for determining either their obviousness (35 USC 103) or their anticipation (35 USC 102).

The authors believe that a proper construction of the “two-way” test requires at least a consideration of not only the precise thing set out in the claim to comply with the requirement of 35 USC 112 ¶ 2 that the inventor distinctly claim (i.e., define the metes and bounds of) the invention, but also consideration of the statutorily required enablement and detailed description required by 35 USC 112 ¶ 1 to establish a constructive reduction to practice of that invention. That is, the inventions “A” and “B” identified in 37 CFR 1.601(n) and 37 CFR 41.203(a) as “inventions” and “subject matter” are not limited to the literal content of a “claim,” which defines, but may not enable, them! Instead, the “invention” defined by a “count” or a “claim” should necessarily include a consideration of all the the subject matter necessary to constitute a constructive or actual reduction to practice of that invention. Compare 37 CFR 41.201’s definition of a constructive reduction to practice as a “described and enabled anticipation under 35 USC 102(g)(1).” After all, the purpose of an interference is to determine that the losing party’s claims are not patentable in view of the winning party’s earlier actual or constructive reduction to practice of that invention. *Mikus v. Wachtel*, 504 F.2d 1150, 1151, 183 USPQ 752, 753 (CCPA 1976).

While this critique is not a proper vehicle for a detailed analysis of all of the things that are wrong with the simplistic proposition set forth by the panels of the board and the court as constituting a proper interpretation of 37 CFR 1.601(n) and, presumably, its successor, 37 CFR 41.203(a), it is devoutly to be wished that the board and the court reconsider and reverse (or, at least, limit) the rulings as set forth in their opinions.⁵⁴

⁵⁴ Since the board and the court consider the methods disclosed in Noelle’s specification and found them lacking, it can be argued that the panel’s findings on the propriety of

In the meantime, it obviously behooves applicants (and patentees) to close the “loop-hole” exploited in the opinion by providing in every case (or in at least all of those cases which are sufficiently important to warrant such precautions) claims that not only define the “thing” that the inventor regards as being his invention, but also claims that include limitations which constitute enablement for making and using that thing, such as product-by-process claims and product claims containing statements of properties or intended use (preambles, etc.) for each important structure or device claimed.

It should also be noted that the board’s extremely narrow construction of its rules in this case is still another example of the many ways in which the board has made it extremely difficult to get an interference declared, and, if an interference is declared, to get a decision on priority.⁵⁵

The board might have brought the enablement issue on itself by too easily adopting the parties’ position that the invention of the mouse antibody would have provided motivation (in the sense of the patent law relating to obviousness) for preparing the human antibodies. The board stated that:

considering the specification’s disclosure is obiter dictum. However, it can also be argued that the two statements were alternative holdings.

⁵⁵ In this particular case, the extremely narrow construction given to the term “invention” (or “patentable invention”) certainly was not adapted just to save work on the part of the panel, because the panel also considered Noelle’s arguments based on the methods disclosed in its application for preparing its claimed mouse antibodies and found that they did not provide a basis for a reasonable expectation of success in using those methods to prepare human antibodies.

At the relevant time, we find that the known existence of the mouse CD40CR antigen and the general conservation in function of immune cell molecules across species would have suggested the existence of the corresponding human CD40CR antigen. As such, one skilled in the art would have been motivated to identify and obtain the anti-CD40CR antibodies via various conventional techniques, e.g., immunization and screening techniques. Yet, while the idea of using immunization and screening techniques to obtain anti-human CD40CR antibodies may have been obvious to try, the realization of the idea would not have been obvious.⁵⁶

While such general motivation might be inferred in the sense that the existence of avian flu and West Nile disease motivates a search for a prevention or cure of those diseases, that type of general motivation is not ordinarily considered to be the type of specific motivation relevant to an obviousness analysis.

Ironically, the panels of the board and the court saw no problem in using in their evaluation whether it would have been obvious to use Noelle's disclosed methods in its specification to prepare the human antibody "statements made during the prosecution of Armitage application 07/969,703 for the proposition that a skilled artisan could not have used expression cloning to isolate CD40CR antibody with a reasonable likelihood of success."⁵⁷ While a plain reading of the test of 37 CFR 1.601(n) seem to make the inventions of "A" and "B" (as a whole, as described in their applications and/or patent) hypothetical prior art to each other, statements made by a third party during the prosecution of its application clearly are *not* prior art until the application becomes

⁵⁶ Paper No. 135, cited supra, page 18.

⁵⁷ 355 F.3d at 1348, 69 USPQ2d at 1512.

available to the public (usually upon either publication of the application or issuance of a patent).⁵⁸

⁵⁸ In re Lund, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).

B. The Board Opts for an Interference-In-Fact Test for Whether an Application or Patent Should Be Added to an Interference Under 37 CFR 1.635/1.642

Benson v. Ginter

In *Benson v. Ginter*, 72 USPQ2d 1125 (PTOBPAI 2003) (non-precedential) (interlocutory opinion by APJ Lee, not joined by any other APJs)⁵⁹, Judge Lee denied Benson's 37 CFR 1.635/1.642 motion seeking to add two Ginter patents to the interference. Benson was involved in the interference on the basis of one patent and two applications, and Ginter was involved in the interference on the basis of one application. Judge Lee denied the motion on the ground that the addition of the Ginter patents to the interference would result in a conflict between two patents, which the board would not have jurisdiction to decide. However, Judge Lee also held that Benson did not follow the proper procedure for presenting the motion:

Citing Section 13.10.3.1 of the Standing order [sic], Benson analyzes claim 6 of the '876 Ginter patent sought to be added to this interference with respect to claim 140 of Ginter's already involved application, in an attempt to demonstrate interference-in-fact between Ginter's involved application and the '876 Ginter patent sought to be added to the interference. Similarly, Benson analyzes claim 1 of the '402 Ginter patent sought to be added to this interference with respect to claim 139 of Ginter's already involved application, in an attempt to demonstrate interference-in-fact between Ginter's involved application and the '402 Ginter patent sought to be added to the interference. Benson has misread the requirements of Section 13.10.3.1 of the Standing Order.

Interference-in-fact is defined in 37 CFR 1.601(j). It is a basic principle that interference-in-fact represents a

⁵⁹ Mr. Gholz and our colleagues Michael Casey, Todd Baker, and Kurt Berger represented Benson.

conflict between the claims of opposing parties in interference. A party's own claims do not "interfere" with each other. Specifically, 37 CFR § 1.601(j) states:

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

Under Section 13.10.3.1(c), Benson is to indicate which claims of the patent or application sought to be added to the interference should be designated as corresponding to the count "by explaining why there is an interference-in-fact between the claims of the patent or application sought to be added and the claims of the opponent's application or patent already involved in the interference." The reference to "opponent's application" necessarily is relative or with respect to the patent or application sought to be added, especially in light of the definition of interference-in-fact in 37 CFR § 1.601(j).

Because Benson made no comparison between any claim of the '876 and the '402 Ginter patents sought to be added and any claim of Benson's involved application or patent to establish that there is an interference-in-fact between an involved Benson claim and a claim in the Ginter patent sought to be added, Benson has not satisfied the requirements of Section 13.10.3.1(c) of the Standing Order applicable to motions filed under 37 CFR § 1.642.⁶⁰

Comments

Section 13.10.3.1(c) of the Standing Order (1 May 2003) read as follows:

(c) Indicate which claims of the patent or application should be designated as corresponding to the count by explaining why there is an interference-in-fact between the claims of the patent or application sought to be added and the claims of the opponent's application or patent already involved in the interference....

⁶⁰ 72 USPQ2d at 1127.

It was not clear from a reading of the then standing order (1) whether the test was “correspondence to the count” or “interference-in-fact”⁶¹ and (2) that, whichever standard is chosen, (a) whether the comparison should be, as the standing order *read*, “between the claims of the patent or application sought to be added and the claims of the *opponent’s* application or patent already involved in the interference” (emphasis supplied) or (b) whether, as Judge Lee asserts, the reference to the “opponent’s claims” necessarily refers to the moving party’s claims (rather than the “opponent’s” claims) when the moving party is seeking to add an opponent’s application or patent claims to the interference. Judge Lee’s interpretation of that provision might well be what the standing order was *intended* to state, but Benson was the moving party, and it moved to add two of Ginter’s patents, i.e., its opponent’s patents, to the interference. The standing order rather specifically stated that the question of interference-in-fact (or “correspondence to the count”) includes a comparison “between the claims of the patent or application sought to be added and the claims of the opponent’s [the opponent’s opponent’s?] application or patent already involved in the interference.” The opinion does not explain just how:

The reference to “opponent’s application” necessarily is relative or with respect to the patent or application sought to be added, especially in light of the definition of interference-in-fact in 37 CFR § 1.601(j).⁶²

In point of fact, it would be quite reasonable for a moving party to demonstrate that other claims of its opponent which are not currently designated as corresponding to the count *all* define the same patentable invention that is also defined by the count, even

⁶¹ The test of “correspondence to a count” is, according to the board, difference from the test for “interference-in-fact.” See 37 CFR 1.637(c)(3)(ii) and Standing Order 13.4.7.

⁶² A “necessary” reading and a “reading in light of” are not “necessarily” the same thing!

though some or all of those claims appear in other of the opponent's applications or patents and it is those applications and/or patent which are sought to be added to the interference. Such a comparison should ordinarily be a sufficient prima facie substantive demonstration as to (1) why such claims should be designated as corresponding to the count (i.e., for the same reasons that the opponent's claims already so designated correspond to the count) and (2) that such claims interfere-in-fact with the moving party's claims that already stand designated as corresponding to the count.

Of course, there may be exceptions. As Justice Jackson pointed out in analyzing the doctrine of equivalents, "things equal to the same thing may not be equal to each other."⁶³ However, in general, it should be sufficient to demonstrate that claims in an opponent's non-involved application or patent define the same patentable invention defined by the opponent's claims already designated as corresponding to the count--thus presumptively interfering with the moving party's claims that correspond to the count. To do otherwise, to quote a phrase frequently used by former Chief Judge Markey, seems to be an "exaltation of form over substance."

⁶³ *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605, 609, 85 USPQ 328, 331 (1950). Compare *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

C. Belated Motions Under 37 CFR 1.645(b)

37 CFR 1.645(b) provided in pertinent part that:

Any paper belatedly filed will not be considered except upon motion (§1.635) which shows good cause why the paper was not timely filed, or where an administrative patent judge or the Board, sua sponte, is of the opinion that it would be in the interest of justice to consider the paper....

The various versions of the Trial Section’s “Standing Order” have required that a party filing a contested 37 CFR 1.635 motion must initiate a conference call with the APJ. The present version of the Standing Order (“SO”), ¶ 15.1, entitled “**Mandatory Conference Call**” reads as follows:

Before filing a miscellaneous motion, a party must:

(a) confer with all opponents and

(b) if agreement cannot be reached, arrange a conference call to the Board official administering the contested case.

1. Bilstad v. Wakalopulos

In *Bilstad v. Wakalopulos*, 386 F.3d 1118, 72 USPQ2d 1785 (Fed. Cir. 2004) (opinion by Circuit Judge Linn, joined by Circuit Judge Bryson and Senior Circuit Judge Plager), the panel affirmed the board’s decision denying Bilstad’s motion seeking permission to file a belated 37 CFR 1.633(i)/1.633(c)(2) motion to add new claims or to amend claims and designate the new or amended claims as corresponding to a count.

The opinion explains that:

This interference was declared on March 30, 2002 between an application of Bilstad, Application Serial No. 09/294,964, filed April 20, 1999, and a patent of Wakalopulos, U.S. Patent No. 6,140,657 (“the ‘657 patent”), filed March 17, 1999 and issued October 31, 2000.***

Bilstad provoked the interference by copying claims 1, 5-8, 11, and 16-17 of the '657 patent into Bilstad's pending application as claims 57-64, as well as adding a paraphrased version of Wakalopulos's claim 18 as claim 65. The Board declared the interference, designating claim 1 of the '657 patent as the only count and identifying Bilstad's claims 57-65 as corresponding to the count.⁶⁴

During the preliminary motion period, Wakalopulos filed a preliminary motion under 37 CFR 1.633(a) asserting that all of the involved claims of the Bilstad application lacked adequate written description support under 35 USC 112 ¶1 for the claim limitation "a moveable member manipulating objects in a plurality of directions within the reactive volume." Bilstad opposed, and it sought an extension of the time set for filing 37 CFR 1.633(i) motions. 37 CFR 1.633(i) permits a party to respond to an opponent's motion attacking the patentability of the party's claims corresponding to the count by filing a responsive motion seeking to amend its claims under attack or to add new claims to be designated as corresponding to the count. The APJ denied Bilstad's request for an extension of time, and Bilstad did not file a timely motion under 37 CFR 1.633(i).⁶⁵

The board conducted the final hearing on preliminary motions on September 27, 2002, and issued its final decision on preliminary motions on March 31, 2003, granting judgment in favor of Wakalopulos and concluding that all of Bilstad's involved claims were unpatentable under 35 USC 112 for lack of written description.⁶⁶ The panel noted that:

⁶⁴ 386 F.3d at 1118, 72 USPQ2d at 1786-87.

⁶⁵ 386 F.3d at 1119, 72 USPQ2d at 1787.

⁶⁶ Id.

Bilstad sought reconsideration of the Board's decision...At the same time, Bilstad filed a miscellaneous motion under 37 C.F.R. § 1.635 seeking leave to belatedly add to the Bilstad application claims designated as corresponding to the count. The motion essentially sought leave to file a Rule 633(i) motion after the deadline for filing such motions had passed. Along with the Rule 635 motion, Bilstad filed Motion 5 which sought to add to the count [sic] a number of claims not including the term "plurality."⁶⁷

It is unclear from the foregoing quotation whether Bilstad sought (1) to add new claims to his application and to designate them as corresponding to the count (i.e., a 37 CFR 1.633(i)/1.633(c)(2) motion), or (2) to amend the *count* by adding to it claims, not necessarily supported by written description by one or either party, that did not include the term "plurality" (i.e., a 37 CFR 1.633(i)/1.633(c)(1) motion).

The court further noted that:

As to Bilstad's Rule 635 motion, the Board noted that Bilstad failed to follow the procedure in the standing order requiring a conference call prior to the filing of such motions. As such, the Board dismissed Bilstad's miscellaneous motion and returned as unauthorized the accompanying motion to add claims.*** Because the Board noted that "the matters raised in the miscellaneous motion appear also to have been raised as part of Bilstad's request for reconsideration," the Board addressed, to that extent, the merits of Bilstad's motion.*** The Board concluded that "Bilstad's current position is the result of choices made by Bilstad" and that "Bilstad was not denied the opportunity to file a motion to amend or add claims or to change the count," but rather "Bilstad did not take advantage of the opportunity afforded."⁶⁸

and that:

⁶⁷ 386 F.3d at 1119-20, 72 USPQ2d at 1787-88; footnote omitted.

⁶⁸ 386 F.3d at 1120, 72 USPQ2d at 1788.

The Board's decision, denying leave for Bilstad to file a belated motion under 37 C.F.R. § 1.633(i), is reviewed for abuse of discretion. *Rapoport v. Dement*, 254 F.3d 1053, 1058 (Fed. Cir. 2001). An abuse of discretion is found if the decision: "(1) is clearly unreasonable, or arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Id.*; *Abrutyn v. Giovanniello*, 15 F.3d 1048, 1050-51 (Fed. Cir. 1994).⁶⁹

The panel affirmed that the board's decision, stating that:

Bilstad also argues that the Board erred in rejecting Bilstad's motion under § 1.635 seeking permission to belatedly file its motion under 37 C.F.R. § 1.633(i). In particular, Bilstad argues that the Board "assured Bilstad that it would have every opportunity to file those motions" on denying Bilstad's request for an extension of time, but then prejudiced Bilstad by refusing later to entertain Bilstad's belated motion under § 1.633(i). Wakalopulos argues that the Board did not abuse its discretion in denying Bilstad's motion because Bilstad's motion under § 1.635 seeking leave to file the § 1.633(i) motion out of time did not comply with the Board's standing order requiring a conference call with the Administrative Patent Judge prior to the filing of any miscellaneous motion and because the Board provided Bilstad no assurances that it would be permitted to file a Rule 633(i) motion out of time. We agree that Bilstad failed to comply with the Board's standing order requiring a conference call with the Administrative Patent Judge prior to filing the miscellaneous motion under Rule 635. Bilstad argues that the call had already been made and that the Administrative Patent Judge had granted permission to file the motion, citing the portion of the Administrative Patent Judge's order denying his original motion without prejudice. The Administrative Patent Judge, however, did not grant Bilstad permission to file the late motion. He simply denied Bilstad's original motion without prejudice. Thus, Bilstad was starting over when filing the Rule 635 motion, and Bilstad had to comply with the Board's standing order regarding motions under Rule 635. Because the Board did

⁶⁹ 386 F.3d at 1121, 72 USPQ2d at 1789.

not abuse its discretion in rejecting Bilstad's Rule 635 motion seeking permission to file a belated Rule 633(i) motion, we affirm that portion of the Board's *Reconsideration Decision*.⁷⁰

Comments

We believe that most, if not all, of the interference bar would agree that the APJ's are generally reasonable in granting extensions of time to file motions or in accepting papers somewhat belatedly filed. However, it is unlikely that Bilstad could have reasonably expected that an attempt to change his claims or the count, presented after the board had issued its final judgment, would be given serious consideration without some *extremely persuasive* excuse. Certainly, 37 CFR 1.633(i) did not authorize a party to file a motion *responsive to the board's final judgment*. It authorized a party to file motions changing the status of the interference counts and the parties' claims corresponding to those counts during the time period set in the preliminary motion phase for filing motions, oppositions, and replies. The board has always shown an understandable reluctance to allow a party to stand on its elected strategy, receive an adverse decision, and then proceed anew with a different strategy.

The sanction of denying, on purely procedural grounds, a party's 37 CFR 1.635 motion seeking permission to file a motion responsive to an opponent's motion attacking its claims may appear at first blush to be unduly harsh. However, the facts of this particular case indicate that Bilstad sought an extension of time to file a responsive motion during the time period set for filing such motions, and, upon having that request denied, failed both to file the motion within the time that had been set and to file a

⁷⁰ 386 F.3d at 1126-27, 72 USPQ2d at 1793.

renewed or additional motion for an extension of the time period. The reasons for the denial of Bilstad's original motion to extend the time are not discussed in the opinion. However, even apart from Bilstad's unexplained failure to make the mandatory conference call, the board certainly had ample reason to dismiss the motion filed after the board's decision.

2. Cheung v. Ritzdorf

In *Cheung v. Ritzdorf*, 71 USPQ2d 1935 (PTOBPAI 2004) (non-precedential) (opinion by APJ Lee, joined by APJs Medley and Tienery and Senior Administrative Patent Judge McKelvey), the board denied the senior party Ritzdorf's miscellaneous motion under 37 CFR 1.635 seeking leave to file a belated responsive preliminary motion under 37 CFR 1.633(i) to add claims 78-87 to its involved application and to designate these claims as corresponding to the count. The motion was contingent upon the granting of Cheung's preliminary motion 2, which attacked the patentability under 35 USC 112 first paragraph, of all of Ritzdorf's claims corresponding to the count.⁷¹

The panel found that:

6. On June 18, 2003, a scheduling order was issued specifying that preliminary motions and the preliminary statement of each party are due on August 29, 2003, and that responsive preliminary motions under 37 CFR § 1.633(i) and (j) are due on September 26, 2003.

7. As authorized in the scheduling order and on August 7, 2003, the parties filed a joint stipulation agreeing to an extension of time, resetting the due date for the preliminary statement and preliminary motions to September 26, 2003, and the due date for responsive preliminary motions under 37 CFR § 1.633(i) and (j) to October 17, 2003.

⁷¹ 71 USPQ2d at 1936

8. On September 24, 2003, the parties again filed a joint stipulation agreeing to a further extension of time, resetting the due date for the preliminary statement and preliminary motions to October 23, 2003 and the due date for responsive preliminary motions under 37 CFR § 1.633(i) and (j) to November 12, 2003.

9. On October 22, 2003, the parties again filed a joint stipulation agreeing to an another [sic] extension of time, resetting the due date for the preliminary statement and preliminary motions to November 21, 2003, and the due date for responsive preliminary motions under 37 CFR §1.633(i) and (j) to December 3, 2003.

10. On November 21, 2003, junior party Cheung filed its preliminary statement as well as Preliminary Motions 1, 2 and 3.

11. By the end of [the] day on November 21, 2003, senior party Ritzdorf filed neither a preliminary statement nor any preliminary motion.

12. On December 1, 2003, ten days beyond the stipulated deadline for filing the preliminary statement and preliminary motions, counsel for the senior party requested and obtained permission from Judge Medley to file a belated preliminary statement. Counsel for the senior party also asked, in a joint telephone conference call to Judge Medley, for permission to file a belated preliminary motion.

13. On December 2, 2003, Judge Medley issued a written order granting party Ritzdorf permission to file a belated preliminary motion by December 8, 2003.***

14. Counsel for senior party Ritzdorf did not meet the extended deadline of December 8, 2003, and thus obtained a further extension from Judge Tierney and filed its Preliminary Motion 1 on December 15, 2003. That preliminary motion seeks to have junior party Cheung's claims 6-9 designated as corresponding to the count and relies on a declaration of Mr. Thomas L. Ritzdorf (Exhibit 1002).⁷²

⁷² 71 USPQ2d at 1936.

Cheung's preliminary motion 1 attacked the benefit accorded senior party Ritzdorf to parent applications. Cheung's preliminary motion 2 attacked the patentability of all of Ritzdorf's claims corresponding to the count under 35 USC 112 first paragraph. Cheung's preliminary motion 3 attacked the patentability of all of senior party Ritzdorf's claims corresponding to the count under 35 USC 103.⁷³

Stipulated extensions of time for filing responsive preliminary motions under 37 CFR 1.633(i) and (j) were due on December 3, 2003, and oppositions to preliminary motions, including responsive motions, were due on December 17, 2003. Ritzdorf filed its opposition to Cheung's preliminary motions on December 18, 2003, and Ritzdorf filed miscellaneous motion 1 seeking leave to file a belated responsive preliminary motion on January 5, 2004, nineteen days after all oppositions to preliminary motions were due, and more than one month from the date all responsive preliminary motions under 37 CFR 1.633(i) and (j) were due. On January 5, 2004, Ritzdorf also filed a responsive preliminary motion 1 along with the miscellaneous motion seeking leave to file the responsive preliminary motion late. Cheung filed its replies to Ritzdorf's oppositions also on January 5, 2004.⁷⁴

Ritzdorf's miscellaneous motion 1 asserted that:

Counsel for Ritzdorf realized, while completing Ritzdorf's oppositions to Cheung's motions, that the issue of motions under 37 CFR §§ 1.633(i) and (j) had not been dealt with in the scheduling. Ritzdorf accordingly seeks leave to belatedly file Ritzdorf's motion under 37 C.F.R. §

⁷³ Findings of fact 15, 16, and 17 at 71 USPQ2d 1937.

⁷⁴ Findings of fact 19-23 at 71 USPQ2d1937.

1.633(i) as a contingent motion, in further response to Cheung's Motion 2.⁷⁵

The board's finding of fact 25 reads:

In footnote * of Ritzdorf's Reply, it is stated, in pertinent part:

Ritzdorf does not deny that Mr. Rockey made an error. Indeed, Mr. Rockey has never suggested that he did not engage in an oversight in failing to recognize that motions under 37 CFR § 1.633(i) should have been filed.⁷⁶

The opinion first points out the board's well established practice of setting sequential times for filing preliminary motions, responsive preliminary motions, oppositions, and replies. It then explains that:

There is a reason behind the setting of a common due date for all oppositions. A party is entitled to mount a coordinated defense against all the preliminary motions of the other party. Positions taken in connection with the oppositions to one preliminary motion may add to or take away from the strength of positions taken in opposing other preliminary motions. One should not have to oppose a preliminary motion prior to being served sufficiently in advance all of the other party's preliminary motions. Here, Ritzdorf filed a preliminary motion seeking to designate Cheung's claims 6-9 as corresponding to the count, and then filed its miscellaneous motion 1 and the belated responsive preliminary motion 19 days *after* all oppositions to preliminary motions were due. Thus, it cannot be said that Cheung had an opportunity to coordinate all its oppositions to Ritzdorf's preliminary motions.

More importantly, Ritzdorf's proposed responsive preliminary motion is one aspect of Ritzdorf's entire response to Cheung's Preliminary Motion 2. Ritzdorf has not shown that it was reasonable for Ritzdorf to file its

⁷⁵ Finding of fact 24 at 71 USPQ2d 1937.

⁷⁶ 71 USPQ2d at 1937. Query: can one "engage in an oversight?"

opposition to Cheung's Preliminary Motion 2 without also having filed its responsive preliminary motion to add claims. Cheung cannot be regarded as having had full opportunity to reply to Ritzdorf's opposition, where Ritzdorf filed its miscellaneous motion and proposed responsive preliminary motion on the same date Cheung filed its reply. Cheung was not given sufficient early notice of Ritzdorf's proposed responsive preliminary motion to prepare an informed reply that included consideration of the responsive preliminary motion.

For the foregoing reasons, we find Ritzdorf has not shown that Cheung would not be substantially prejudiced by accepting Ritzdorf's filing of its responsive preliminary motion more than one month late, eighteen days after the filing of Ritzdorf's opposition to Cheung's Preliminary Motion 2 and nineteen days after filing of Cheung's opposition to Ritzdorf's Preliminary Motion 1.

According to Ritzdorf, it discovered the need to file a responsive preliminary motion while preparing oppositions to Cheung's preliminary motions.*** Ritzdorf did not file its miscellaneous motion until nineteen days after the due date for filing all oppositions. Ritzdorf has provided no cogent explanation for this delay.

It is also disturbing that an admission of mistake by counsel for Ritzdorf was not made until Ritzdorf's reply to Cheung's opposition to Ritzdorf's Miscellaneous Motion 1. On page 4 of the reply, in the first paragraph of Section III, it is stated:

In all events, the issue here, given *Mr. Rockey's admission that he overlooked the date for filing motions under 37 CFR 1.633(i)*, is whether Cheung will be prejudiced if Ritzdorf is given leave to file his motion under 37 CFR § 1.633(i) belatedly.⁷⁷

The opinion discusses both the timing and the content of Ritzdorf's "admission" of error in omitting the timely filing of the responsive motion:

⁷⁷ 71 USPQ2d at 1937-38 (emphasis in the original).

In Paragraph 14 of Ritzdorf’s Miscellaneous Motion 1, it is stated: “Counsel for Ritzdorf realized, while completing Ritzdorf’s oppositions to Cheung’s motions[,] that the issue of motions under 37 C.F.R. §§ 1.633(i) and (j) had not been dealt with in the scheduling.” The “scheduling” referred to evidently is that of Judges Medley and Tiernery in granting previous motions by party Ritzdorf for an extension of time in filing its own preliminary motions. The quoted text on its face suggests that it was the administrative patent judges who overlooked a matter when in fact it was Ritzdorf’s counsel who did not make a request in connection with its own responsive preliminary motions under 35 U.S.C. [sic: 37 CFR] §§ 1.633(i) and (j). That suggestion caused party Cheung to expend resources, unnecessarily, to address that part of the motion, and similarly caused the board to spend time, unnecessarily, to review details concerning that aspect of the motion. A party needs to own up to its mistake up-front, clearly and specifically, rather than use broad and ambiguous language that can lead the other party and the board astray.⁷⁸

Finally, the board reiterated its policy that it does not regard engagement in settlement negotiations as an excuse for missing deadlines set by the board.⁷⁹

Comments

Neither the *Bilstad* nor the *Cheung* opinion should surprise many practitioners in view of the particular facts involved. There certainly is no reason in either opinion to conclude that the board has significantly altered its usually cooperative stance in granting reasonable requests for extensions of time to file motions when (1) the motion presents a good reason for doing so and (2) the request for extension of time is presented before the

⁷⁸ 71 USPQ2d at 1938.

⁷⁹ 71 USPQ2d at 1939.

deadline has passed. It is, of course, more difficult to obtain permission to file a belated paper when that permission is sought after the deadline for filing has passed.

The likelihood of substantial prejudice to the non-moving party is greater if the non-moving party has filed additional pleadings in the meantime.

Both *Bilstad* and *Cheung* emphasize that a party receiving an opponent's motions for judgment of unpatentability of a party's involved claims must immediately consider whether a responsive motion is needed, and, if so, take action accordingly. Opportunities missed during the times set for filing appropriate preliminary motion may not arise later.

D. The Board's Rebuttal Arguments Against Consideration of Expert Testimony

Holbrooks v. Bacchi

In *Holbrooks v. Bacchi*, 69 USPQ2d 1696 (PTOBPAI 2003) (non-precedential) (opinion by APJ Urynowicz for a panel that also consisted of APJs Schafer and Lee), the board disagreed with Holbrooks's arguments in its opposition to Bacchi's 37 CFR 1.633(a) motion for judgment based on a lack of written description under the first paragraph of 35 USC 112. Holbrooks argued (1) that a declaration of an expert witness should not be considered because it was testimony to support a preliminary motion which was submitted without obtaining authorization under 37 CFR § 1.639(c), and (2) that "[i]t is urged that Dr. Davies does not qualified to provide his opinion because he has experience far in excess of that of one of ordinary skill in the art."⁸⁰

The board disagreed:

We find the Declaration of Dr. John Davies persuasive to the extent it supports Bacchi's position on this issue of whether Holbrooks satisfies the written description requirement of 35 U.S.C. § 112, first paragraph. Holbrooks did not attack the declaration specifically as to content. The junior party's argument that the declaration should not be considered because it was submitted without obtaining authorization under 37 CFR § 1.639(c) is not persuasive because § 1.639(a) of the rule authorizes the filing of proof of any material fact alleged in a motion and § 1.639(b) authorizes the filing of proof in the form of affidavits. Holbrooks' only other argument with respect to the declaration - that Dr. Davies has experience far in excess of that of one of ordinary skill in the art - is also not persuasive because it is established that an expert witness who has more than ordinary skill in the art is qualified to provide his opinion concerning matters of what would be obvious to persons of lesser skill than his own. *Moore v.*

⁸⁰ 69 USPQ2d at 1698.

Comments

It is not clear just what Holbrooks had in mind. 37 CFR 1.639(c) relates to testimony which:

If a party believes that additional evidence in the form of testimony that is unavailable to the party is necessary to support or oppose a preliminary motion under § 1.633 or a motion to correct inventorship under § 1.634, the party shall describe the nature of any proposed testimony as specified in paragraphs (d) through (g) of this section....

There is no indication in the opinion that Dr. Davies's testimony was "unavailable" to Bacchi, and there was no apparent argument as to why the provisions of 37 CFR 1.639(a) and (b) were unavailable to Bacchi.

It is possible that a plausible objection to the qualifications of an expert witness could be based on the expert's overqualification in a general sense and underqualification in the sense of any real-world experience of an ordinary variety, but a simple argument that a witness is "overqualified" and thus necessarily "underqualified" to properly evaluate the knowledge of one ordinarily skilled in the art seems to have no merit.

Many administrative patent judges have spent time in the examining corps, and many examiners have experienced (sometimes quite frequently) the arguments that start out with the applicant's advocate asserting (1) that obviousness must be determined from the standpoint of one ordinarily skilled in the art, and (2) that, of course, the examiner is of far greater skill than one ordinarily skilled in the art (e.g., "because you look at patentable inventions all the time and come to regard them as being the norm"). Most

⁸¹ 69 USPQ2d at 1699.

examiners quickly develop an immunity to such ego-stroking and become wary of the sincerity of any subsequently raised arguments. If the facts don't provide sufficient support for the development of an argument, the argument is probably best unmade.

E. The Board’s Present Strong Policy Is That Any Confidential Information Submitted to the Board in an Interference Will Ultimately Be Available in the Public Record

Fletcher v. Leibu

In *Fletcher v. Leibu*, 72 USPQ2d 1701 (PTOBPAI 2004) (non-precedential) (per curiam opinion delivered by a panel consisting of SAPJ McKelvey and APJs Schafer, Lee, and Torczon), the board granted a joint miscellaneous motion requesting withdrawal of a previous joint miscellaneous motion for entry of a STIPULATED PROTECTIVE ORDER. In doing so, the board took the opportunity to discuss generally “confidential information” as applied to evidence in patent interference cases.⁸²

The board first noted that the interference rules do not have any provision for protective orders associated with voluntary discovery or other discovery authorized by the rules, including “additional” discovery.⁸³ It noted several concerns with respect to protective orders, one of which it expressed as follows:

One concern, and perhaps the most important, is that the board has a well-established and firm policy of having its judgments subject to public scrutiny when one or more of the involved files becomes public. The third WHEREAS in the preamble of the Proposed Order collides with that policy. Currently, an interference file is available to the public after a final judgment in an interference involving a patent. 37 CFR § 1.11(e)(2003). Likewise, an interference file is open to the public upon entry of a judgment when an involved application is a reissue application or a published statutory invention registration. *Id.* Absent further study and under current conditions, we would not want to receive “confidential information” which

⁸² 72 USPQ2d at 1703.

⁸³ *Id.*

would not be available to the public upon entry of a judgment.⁸⁴

After (1) discussing the treatment of confidential information in the Federal Circuit and the PTO Trademark Trial and Appeal Board, (2) acknowledging that the board can imagine interference cases where it would be appropriate for the parties to exchange confidential information to determine whether an issue should be raised or whether an issue can be narrowed, and (3) stating that it has “no philosophical objection” to protective orders, the board pointed out that those matters involve considerations that should be addressed through rulemaking. It summed up its present position as:

While the board is disinclined at this time to enter protective orders, we nevertheless have no philosophical objection if the parties wish to enter into a confidential agreement which might be subject to enforcement as a matter of contract law in a court of competent jurisdiction. *However, to the extent that confidential information is exchanged and should it become necessary to submit “confidential information” to the board for its consideration on the merits of an issue, it must be understood at this time that any “confidential information” submitted to the board would ultimately be available to the public. 37 CFR § 1.11(e)(2003).*⁸⁵

Comments

Of course, the board’s opinion is expressly limited to documents or matters that are submitted to the board during the course of an interference. It does not conflict with the usual handling of settlement agreements under 35 USC 135(c) or the customary practice of the board and the examining corps to remove documents such as affidavits under 37 CFR 1.131 or the like from an application file prior to sending those documents

⁸⁴ Id.

⁸⁵ 72 USPQ2d at 1704 (emphasis supplied).

to the board separately so that they will be unavailable to the opposing party until such time that they are made available to the opponent.

It may be noted that the opinion, for an augmented panel of the board, is designated as non-precedential. Moreover, the relevant discussion is dictum in view of the fact that the board granted the motion to withdraw the motion requesting the protective order. Nevertheless, the opinion accurately expresses and explains the board's present policy.

In a similar vein, the board in *A v. B*, 21 USPQ2d 1960 (PTOBPAI 1991) (opinion by a panel consisting of Chairman Serota, Vice-Chairman Calvert, and Examiner-In-Chief (APJ) Urynowicz), the board denied a party's request for an order prohibiting the opposing party from disclosing files of pending patent applications involved in the interference, stating:

Although we are sympathetic to the complaint of B, we are constrained to deny his request for an order. Under 35 USC 122 and 37 CFR 1.14, the authority upon which B relies in support of his complaint and request for an order, applications for patents shall be kept in confidence by the Patent and Trademark Office. However, neither the statute nor the rule includes a provision authorizing the Office to order another, i.e., a party to an interference such as A, to keep an application for patent in confidence or to take any action with respect to material from an application which the party has disclosed to others.⁸⁶

Of course, a civil remedy might be available in the courts for situations such as *A v. B*. See Gholz, "Compelled Testimony, Testimony Abroad, and Protective Orders in Interference Proceedings Under the New Rules," 67 JPTOS 239, (October 23, 1992), at pages 239-259.

⁸⁶ 21 USPQ2d at 1960.

F. A Wise Advocate Should Select the Most Appropriate Terms for Use in His or Her Arguments

Sernyk v. DeBonte

In *Sernyk v. DeBonte*, 72 USPQ2d 1355 (PTOBPAI 2004) (non-precedential) (opinion delivered by SAPJ McKelvey for a panel that also consisted of APJs Schafer and Poteate), the panel observed that:

We do not know why parties continue to insist that claims are “invalid” in interference proceedings. *First*, 35 U.S.C. § 135(a) authorizes the board to consider patentability--not invalidity. *Second*, DeBonte’s claims presently appear in an application--not a patent. *Third*, the preponderance of the evidence applies to unpatentability in interferences, while the clear and convincing evidence test applies to invalidity in infringement cases. Use of proper terminology can avoid any number of difficulties in interferences.⁸⁷

Comments

While it is certainly true that the term “invalidity” is not normally or perhaps is not even properly applied to claims in a pending application, the panel’s assertion that “invalidity” is improperly applied to a judgment of unpatentability of a patent claim, even in interferences, seems to be picking a very fine nit indeed. 35 USC 135(a) (1984) does authorize the board to determine “patentability” of application and patent claims in interference proceedings. However, a judgment of priority either before or after the 1984 act necessarily resulted in the “unpatentability” or “invalidity” of the involved patent claims. The use of the term “patentability” in the amendment to 35 USC 135(a) was in the nature of the jurisdictional grant using a term generic to both application claims and patent claims.

⁸⁷ 72 USPQ2d at 1357 n. 3.

Moreover, the preponderance of evidence rule in determining issues of both priority and patentability between applications and between an application and one or more issued patents that were co-pending with the involved application or application(s) is not a very persuasive argument for a distinction between “unpatentability” and “invalidity” as the reason for cancellation of patent claims lost in interference. According to *Apotex USA v. Merck & Co.*, 254 F.3d 1031, 1033 n. 1, 59 USPQ2d 1139, 1143 n. 1 (Fed. Cir. 2001):

Generally speaking, the presumption of validity does not apply to patents involved in interference proceedings, and thus, the invalidity of a patent involved in an interference under § 102(g) need only be proven by preponderant evidence. *See Bruning v. Hirose*, 161 F.3d 681, 686, 48 USPQ2d 1934, 1938 (Fed. Cir. 1998) (holding that, in an interference involving a patent issued from an application that was co-pending with the interfering application, the appropriate standard of proof for validity challenges is the preponderance of the evidence standard because the presumption of validity is inapplicable). However, the presumption may effectively be implicated in the case of a priority test between an issued patent and an application that was filed after the issuance of the patent. In such a situation, the junior party must establish priority of invention by clear and convincing evidence. *Price v. Symsek*, 988 F.2d 1187, 1194, 26 USPQ2d 1031, 1036 (Fed. Cir. 1993). Such a factual scenario is not before us.

As noted in *Price*, the clear and convincing standard of proof with regard to priority in interferences predates by far the mention of patentability in 35 USC 135(a). Certainly, the question of invalidity of patent claims in infringement actions is generally a matter of determining the *patentability* of those claims.

Of course, it is always a good idea to use proper terms of art in making any legal argument, whether ex parte or inter partes as in interferences. Perhaps the greatest “difficulty” resulting from misuse of terms (e.g., confusion between “counts” and

“claims”) is the possible perception from a careless use of terminology that the proponent of the argument may not have a proper grasp of the involved issues--which, in turn, may well detract from the persuasiveness of the arguments. However, no such problem was apparent in the “misuse” which drew the SAPJ’s ire.

G. A 37 CFR 1.634 Motion to Correct Inventorship Must Explain How the Contributions of the Inventor(s) Sought to be Added Relate to the Invention of a Specific Claim

Scripps Research Institute v. Nemerson

In *Scripps Research Institute v. Nemerson*, 72 USPQ2d 1122 (PTOBPAI 2004) (opinion delivered by APJ Torczon for a panel that also consisted of APJs Medley and Poteate),⁸⁸ the board denied Nemerson's motion under 37 CFR 1.634 to add two inventors, Spicer and Bach, to its two involved applications.

The opinion first addressed Nemerson's argument that the evidentiary standard for showing inventorship is clear and convincing evidence. Scripps agreed with that position. However, the board pointed out that:

Neither cites authority or provides an explanation for the use of the clear and convincing evidence standard for the question of inventorship in an interference. The default evidentiary standard in civil proceedings, including interferences under 35 U.S.C. 135(a), is preponderance of the evidence. *Price v. Symsek*, 988 F.2d 1187, 1193, 26 USPQ2d 1031, 1035 (Fed. Cir. 1993).⁸⁹

The opinion explained that:

Inventorship depends on who conceived the subject matter of the claims at issue, *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1460, 45 USPQ2d 1545, 1548 (Fed. Cir. 1998). Consequently, we must determine what Spicer's and Bach's contributions were and then whether those contributions appear in the claimed invention. *Id.* at 1461, 45 USPQ2d at 1549. An inventor need not make a contribution to every claim in the patent; a contribution to one claim is enough. *Id.* at 1460, 45

⁸⁸ The opinion as published does not indicate that the opinion is either precedential or non-precedential.

⁸⁹ 72 USPQ2d at 1122.

USPQ2d at 1548. Since two applications are involved, there must be a claim in each application for which the change in inventorship is justified.⁹⁰

The panel pointed out that Nemerson did not identify any particular claim in either of its applications on which the board could base its analysis and that Nemerson's failure to specify any claim on which its inventorship motion was based would have been enough to deny the motion for failure to make out a case. However, the panel noted that it is sometimes possible without reaching too far to match what is being argued with a particular claim. Rather than deny the motion out of hand, it attempted to match the claims to the proofs.⁹¹

The subject matter of the claims relates to soluble human tissue factor expressed from a polynucleotide molecule encoding an amino acid sequence as provided in a figure in the specification. The panel analyzed the claims with regard to the amino acid sequences recited in each claim, and it also made specific findings of facts concerning the specific contributions of each of the proposed new inventors. However, it concluded that:

It is certainly possible to imagine how Drs. Spicer and Bach may be inventors of one or more claims. For instance, there are claims in Nemerson's 262 application that are limited by a 1-242 amino acid fragment, which is close to a 1-244 amino acid fragment. One could imagine that Spicer or Bach appreciated that the last two amino acids contributed nothing to the function of the polypeptide and thus conceived of the 1-242 amino acid fragment after having identified the 1-244 amino acid fragment. Other plausible scenarios are also possible. Possibilities do not amount to a preponderance of the evidence, however. As movant, Nemerson has the burden of proof. 37 C.F.R. §

⁹⁰ 72 USPQ2d at 1122-23.

⁹¹ 72 USPQ2d at 1123, finding of fact [3].

1.637(a). Nemerson did not carry its burden. Consequently, Nemerson's motion to change the inventorship must be denied.⁹²

Comments

The parties' confusion about the standard of proof required for a motion seeking to change inventorship is somewhat understandable. While the burden is indeed a preponderance of the evidence, that preponderance of the evidence must include proof sufficient to overcome a presumption that the inventorship identified in an application or a patent is correct. Therefore, the burden is on the moving party to explain its change of heart. *Ellsworth v. Moore*, 61 USPQ2d 1499, 1504-05 (PTOBPAI 2001) (non-precedential).⁹³

The statement of facts in the discussion in *Scripps* should not be taken as a requirement that a joint inventor's contribution to the invention necessarily must be set forth as a specific limitation in a claim. 35 USC 116, as amended in 1984, "sets no explicit lower limit on the quantum or quality of inventive contribution required for a person to qualify as a joint inventor.... Rather, a joint invention is simply the product of a collaboration between two or more persons working together to solve the problem addressed." *Fina Oil & Chemical Co. v. Ewen*, 123 F.3d 1466, 1473, 43 USPQ2d 1935, 1941 (Fed. Cir. 1997). Nemerson simply did not show how the proposed added inventors' work contributed to a collaborative joint conception of any claimed invention.

⁹² 72 USPQ2d at 1125.

⁹³ See Gholz, *A Critique of Recent Opinions in Patent Interferences*, 85 JPTOS 401 (2003) at pages 417-418.

Query: Can Nemerson try again? The opinion does not indicate whether the panel's denial of this motion was or was not with prejudice to its trying again.

H. In an “Appropriate” Case, the Board Will Exercise Its Discretion To Order Additional Discovery

Sernyk v. DeBonte

In *Sernyk v. DeBonte*, 72 USPQ2d 1355 (PTOBPAI 2004) (nonprecedential) (opinion by SAPJ McKelvey for a panel that also consisted of APJs Schafer and Poteate), the panel exercised its rarely exercised discretion (1) to permit a party to seek additional discovery under 37 CFR 1.687(c) and (2) to take testimony under 37 CFR 1.639(c).

Sernyk filed a document styled “SERNYK PRELIMINARY MOTION 3” seeking discovery and testimony said to be necessary (1) to support a preliminary motion for judgment based on a possible public use and (2) “to possibly establish” that DeBonte’s claims are unpatentable under 35 USC 102(f) for improper inventorship.⁹⁴

The subject matter of the interference, defined in two counts, related to oils expressed from the seeds of *Brassica napus* or a canola oil. The counts defined the oils as having (1) specific percentages of oleic acid and linolenic acid (count 1) or (2) specific ratios of (oleic acid + linoleic acid) to linolenic acid and specific percentages of linoleic + linolenic acids (count 2).⁹⁵

During a conference call for the purpose of setting times for taking action during the preliminary motions phase of the interference, Sernyk sought leave to file (1) a preliminary motion alleging unpatentability under 35 USC 102(b) based on a possible

⁹⁴ 72 USPQ2d at 1357. The board indicated in footnote 1 that the motion was mischaracterized as a preliminary motion when, in fact, the motion was a miscellaneous motion under 37 CFR 1.635 and should properly have been titled as “SERNYK MISCELLANEOUS MOTION 3.”

⁹⁵ 72 USPQ2d at 1357

public use involving a plant line referred to as “IMC 01” and (2) a preliminary motion alleging unpatentability under 35 USC 102(f) based on a possibility that DeBonte was not the correct inventor of the subject matter claimed in DeBonte’s involved application. Sernyk was not given leave to file the two preliminary motions pending further inquiry into the nature of those motions, and, as a result of, and in accordance with, the conference call, Sernyk filed and served several documents.⁹⁶ The documents included a plant variety certificate issued to DuPont on March 31, 2003 and later assigned to Cargill, Inc, DeBonte’s assignee.⁹⁷ Sernyk asserted that the documents indicated that the plant line “IMC 01” and oils extracted therefrom, which were the basis on which DeBonte based its involved application, were in public use prior to DeBonte’s earliest possible effective filing date. According to Sernyk, the documents indicated (1) that the plant line designated “IMC 01” had been extensively tested in public trials conducted by county agents and agronomists from land grant universities since 1989,⁹⁸ (2) that IM C01 had been released, used, offered for sale, or marketed in the U.S. or other countries,⁹⁹ and (3) that one or more of such actions took place in the U.S. in April 1990, which was said to be “only released to contract growers; not to general public.”¹⁰⁰

⁹⁶ 72 USPQ2d at 1358, findings of fact 17-25.

⁹⁷ 72 USPQ2d at 1357-58.

⁹⁸ 72 USPQ2d at 1358, finding of fact 23.

⁹⁹ 72 USPQ2d at 1358, finding of fact 25.

¹⁰⁰ 72 USPQ2d at 1358, findings of fact 24 and 25.

DeBonte’s application disclosed, inter alia, that ”This invention comprises a *Brassica napus* canola yielding seed having *** [various properties],”¹⁰¹ and that “this invention further comprises a seed designated IMC 01 deposited with the American Type Culture Collection [ATCC] *** and bearing accession number ATCC 40579, the progeny of such seed and oil of such seed possessing the quality traits of interest.”¹⁰²

DeBonte’s disclosure also indicated that the specific variety designated IMC 01 has very low levels of α -linolenic acid in the seed oil and very low levels of glucosinolates in the seed. DeBonte’s specification included a table describing the fatty acid composition of oils from IMC 01 over five generations.¹⁰³ The DeBonte disclosure further indicated that IMC 01 had undergone extensive testing during 1988, 1989 and 1990.¹⁰⁴

The board began its discussion of the issues by stating that:

The rules authorize the board to order “additional discovery” in an interference when to do so would be in the “interests of justice *** as to matters under the control of a party within the scope of the Federal Rules of Civil Procedure ***.” 37 CFR § 1.687(c). Discovery can also be ordered as to third-parties by way of a subpoena issued under the authority of an appropriate district court. 35 U.S.C. § 24; 37 CFR § 1.671(g) (2003).

Whether discovery is authorized is a matter within the discretion of the board. *Cockran [sic; Cochran] v. Kresock*, 530 F.2d 385, 396, 188 USPQ 553, 561 (CCPA 1976); *Tropix, Inc. v. Lumigen, Inc.*, 53 USPQ2d 2018, 2020 (Bd. Pat. App. & Int. 2002).

¹⁰¹ 72 USPQ at 1358, finding of fact 26d.

¹⁰² 72 USPQ2d at 1358, finding of fact 26e.

¹⁰³ 72 USPQ2d at 1358-1359.

¹⁰⁴ 72 USPQ2d at 1359.

Discovery in interference cases has been characterized as not as liberal as discovery under the Federal Rules of Civil Procedure. *Frilette v. Kimberlin*, 508 F.2d 205, 211, 184 USPQ 266, 270 (3d Cir. 1974) (*in banc*); *Tropix*, 53 USPQ2d at 2021. The interference rule authorizing additional discovery “does not bestow the right to discovery of unlimited scope.” *Cook v. Dann*, 522 F.2d 1276, 1276, 188 USPQ 175, 176 (CCPA 1975).

From the principles set out above, one might reach a conclusion that discover in an interference is always “narrow” and is “hard to get.” “Additional discovery” was first authorized in interferences by virtue of 37 CFR § 1.287(c) (1971). At the time “additional discovery” was first authorized in interference cases, the issue of principal significance was priority of invention. Priority evidence is almost always under the control of the party attempting to establish priority.

On the other hand, patentability over the prior art could not be raised in an interference. *Glass v. DeRoo*, 239 F.2d 402, 112 USPQ 62 (CCPA 1956). Accordingly, discovery on alleged unpatentability over the prior art generally was not authorized. *Ziembra v. Richter*, 186 USPQ 551 (Bd. Pat. Int. 1975). At the end of 1984, when the Board of Patent Appeals and Interferences was created, the board was statutorily authorized to consider patentability in interferences. 35 U.S.C. § 135(a) (1985). Thereafter, “additional discovery” on an issue of patentability could, but did not need [sic; have?] to be, authorized.

While “additional discovery” in interference cases may not be as liberal as that under the Federal Rules of Civil Procedure, it is helpful if one understands what “may not be as liberal” means. The *scope* of what can be discovered is probably the same as that under the Federal Rules. In other words, when it is in the “interest of justice” to permit discovery in an interference case, the scope of that discovery probably is as broad as that authorized by the Federal Rules.

The principal differences between practice under the Federal Rules and practice under the interference rules is that permission must always be obtained from the board before “additional discovery” can be authorized. The party seeking discovery must justify the discovery and obtain

board permission. Under the Federal Rules, the parties in a civil action are authorized to proceed on their own. If a party does not believe discovery requests are appropriate, it bears the burden of convincing a district court that discovery should not occur.

Some believe that so-called “fishing expeditions” are authorized under the Federal Rules. Without debating whether “fishing expeditions” are authorized under the Federal Rules or what is meant precisely by “fishing expedition,” we have consistently interpreted our rule to mean that uncontrolled discovery fishing expeditions are not authorized. But, to merely label something as being a “fishing expedition” does not end the inquiry. As the CCPA noted in *Cochran*, whether discovery is to be authorized is a matter within the discretion of the board. Discretion cannot be exercised merely by assigning labels to requests and “automatically” granting or denying discovery based on labels. In other words, there may be - albeit rare - legitimate “fishing expeditions” as well as inappropriate “fishing expeditions.” The fact that most fishing expeditions are inappropriate does not mean that there can never be one which is appropriate. Each case is evaluated on its own merits and discretion is exercised on a case-by-case basis.

What has been said about discovery is also true about testimony which might be authorized under 37 CFR § 1.639(c) needed to support a possible preliminary motion.

If the basis upon which [a request for] discovery or testimony is made is speculative, discovery or testimony may not be appropriate. The more speculative the case, the less likely discovery is to be authorized. On the other hand, if a party can make out what otherwise appears to be a *prima facie* case for relief without discovery or testimony, there seemingly is little need for the discovery or testimony. But, if a party can reasonably establish that its opponent or some third-party can supply a missing link to make out a *prima facie* case, then discovery or testimony may be appropriate.

Moreover, there are certain issues which give us pause when discovery or testimony is sought. For example, allegations that a party is not a proper inventor is a matter best developed during a priority phase of an interference. Hence, discovery or testimony said to be needed in support

of a preliminary motion for judgment under 35 U.S.C. § 102(f) is not calculated to result in a “speedy” and “inexpensive” resolution of an interference. 37 CFR § 1.601 (2003). On the other hand, where there is a plausible and reasonable basis for establishing a public use, it may be “just” to permit the issue to be developed through the aid of discovery and testimony.¹⁰⁵

Having stated those principles, the board then concluded that:

Sernyk has given us enough in the form of evidence and argument to justify exercising discretion to permit additional discovery and testimony on the issue of whether the “public trials” and associated activities constitute a public use. It goes without saying that we express no views on the ultimate decision which might be made with respect to whether a public use occurred within the meaning of 35 U.S.C. § 102(b). Nevertheless, it appears that there were “public trials” long prior to DeBonte’s critical date.

On the facts of this case, it is appropriate to determine whether those “public trials” constitute a public use. Accordingly, additional discovery and testimony will be allowed on the narrow issue of whether the “public trials” and their aftermath constitute a public use.¹⁰⁶

The board considered and found unpersuasive DeBonte’s arguments (1) that the long passage of time between the relevant events and the interference proceeding would make it difficult to prove the nature of the earlier events, (2) that some third-party discovery testimony may be needed, (3) that a civil action concerning the subject matter of the DeBonte patent had been filed, and that civil action presented a better forum for dealing with the discovery issues, (4) that the discovery sought relates to DeBonte’s priority case, (5) that the discovery case was premature, (6) that the so-called public use was an experimental use, (7) that the public trials may have been secret, (8) that the

¹⁰⁵ 72 USPQ2d at 1360-61 (emphasis in the original).

¹⁰⁶ 72 USPQ2d at 1361-62.

examiner did not make a public use rejection, (9) that the DeBonte assignee was a large company and maintained its documents at numerous locations, and (10) that Sernyk had presented no evidence that IMC 01 and oil produced therefrom was invented by someone other than DeBonte.¹⁰⁷

The board granted the additional discovery relating to public use, including (1) proposed interrogatories 5-8 (with some amendments by the board), (2) requests for production of categories of documents 7-9 and 11 (approved as amended by the board); and (3) requests for admissions 11-13. It also granted Sernyk's request to seek to take the testimony of an identified witness (even if the witness were a third-party witness), indicating that Sernyk should, if necessary, file a miscellaneous motion as soon as possible for approval to issue a subpoena under 35 USC 24 if such were needed. It also ordered DeBonte and its assignee to make every reasonable effort to assist Sernyk in locating the witness. The board denied the request for production of documents 10 because "in our view [the subject matter of that] requests for production is encompassed within the scope of Request for Production 9."¹⁰⁸

The board denied additional discovery relating to improper inventorship because:

¹⁰⁷ 72 USPQ2d at 1360 and 1362-64. The board did note that the examiner had rejected DeBonte's claims as being anticipated by or obvious over a European patent specification naming inventors that did not include DeBonte -- however, without asserting that it had been filed by DeBonte's assignee. The European application claimed a U.S. priority date of December 31, 1987. 72 USQP2d at 1359.

¹⁰⁸ 72 USPQ2d at 1364-65.

In our view, Sernyk has not come forward with a sufficient case to justify discovery or testimony in support of a possible preliminary motion based on alleged improper inventorship. 35 U.S.C. § 102(f).

If DeBonte puts on a priority case, it will have to establish conception and an actual reduction to practice or conception and diligence. The conception will have to be of named inventor DeBonte. Failure to establish that any conception is that of DeBonte would be fatal of DeBonte's priority case. Hence, the time to look into inventorship is when DeBonte puts on its priority case.

In this respect, we call attention to the discovery which is available to Sernyk during cross-examination of DeBonte's priority witnesses. 37 CFR § 1.687(b). Moreover, prior to the date for cross-examination, Sernyk can advise DeBonte of documents which may be requested under 37 CFR § 1.687(b) and DeBonte would be well-advised to have those documents available. 37 CFR § 1.616 (2003).¹⁰⁹

Comments

It is unlikely that one who might have reached the conclusion that discovery in an interference is always "narrow" and is "hard to get" will see the error of his or her ways from this opinion.¹¹⁰ The two issues on which Sernyk sought "additional discovery" may

¹⁰⁹ 72 USPQ2d at 1364.

¹¹⁰ For example, see Gholz, "Patent Interferences -- Big Ticket Litigation with No Effective Discovery," 4 Intellectual Property Today No. 9 at page 10 (1997); Gholz, "What's the Use of 37 CFR 41.150(c)(2)?," 12 Intellectual Property Today No. 12 at page 14 (2005); and Gholz, "Why Should Trial Section Decisions Be Given Any Deference During District Court Review?," IP Law Bulletin (February 28, 2005). For excellent but somewhat dated reviews of discovery in interference proceedings, see Purcell and Voight, "The Scope of Discovery in Patent Interference Proceedings (Part

represent both the best and the worst of scenarios for seeking additional discovery. With regard to the public use issue, the documents submitted by Sernyk identify tests of what appear to be oils expressed from the same plant species used in DeBonte's disclosure long prior to any effective date of DeBonte's involved application. That certainly raises an issue looming like an 800 pound gorilla in the consideration of the patentability of DeBonte's involved claims. If additional discovery exists at all in interference practice, it would appear to be difficult to deny such discovery in the face of the findings of fact set forth in the opinion.

Conversely, the opinion does not indicate that Sernyk presented any persuasive evidence or even any plausible reasoning in support of its request to explore the issue of inventorship through "additional discovery."

In addition to the board's perceived weakness of Sernyk's motion for additional discovery on the issue of inventorship, the probable real reason for denying inventorship discovery may appear in the board's observation that, if DeBonte puts on a priority case, issues of inventorship will necessarily be resolved at that time. However, that reasoning is not highly persuasive. A party controls both the evidence and the witnesses presented during its priority case, cross-examination addresses only those witnesses that are presented, and, generally, cross examination is limited only to testimony they chose to

1)," 62 JPOS 160 (1980); Id. "(Part II-Conclusion)," 62 JPOS 188 (1980); Walterscheid, 58 JPOS "Interference Discovery," 58 JPOS 135 (1976); and McKelvey, "Discovery Before the Board of Interferences," 58 JPOS 186 (1976).

give.¹¹¹ That is, the contents of the priority case are controlled by the presenting party. Presumably, any additional discovery sought during the priority phase will be equally as hard to get and narrow as it would have been during the preliminary motions phase.

Moreover, the possibility (probability?) that a 35 USC 102(f) patentability issue will be fully developed or even raised is often nullified in those cases where a party moving to have its opponent's claims declared unpatentable under 35 USC 102(f) faces opposing motions that the moving party's own claims are unpatentable. That is, since the board rarely exercises its discretion to continue an interference after one party's involved claims have been held to be unpatentable during the preliminary motions period, issues concerning the patentability of the other party's claims, if deferred probably, will simply not be reached.

The "brave new world" of 1984, in which the board was authorized (at the PTO's request) to settle all issues between parties to an interference, has essentially been swept away by the "braver, newer world" of the "new millennium." Perhaps the major legacy of the 1984 revolution is that the PTO may have belatedly learned to "be careful what you ask for"!

¹¹¹ But see Taskett v. Dentlinger, 344 F. 3d 1337, 68 USPQ2d 1472 (Fed. Cir. 2003), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 86 JPTOS 469 (2004) at § X.C., "The Board Has Total Discretion to Ignore the 'Rule' that Redirect Must be Within the Scope of the Cross."

I. The Board Rebuffs an Argument that Page Limitations Should Be Applied Collectively to Different Related Motions

Holbrooks v. Bacchi

In *Holbrooks v. Bacchi*, 69 USPQ2d 1696 (PTOBPAI 2003) (non-precedential) (opinion delivered by APJ Urynowicz for a panel that also consisted of APJs Schafer and Lee), Holbrooks requested in its oppositions that Bacchi's motions 3-7 should each be dismissed "because they violate Standing Order § 28 requiring that motions be limited to 25 pages."¹¹² Holbrooks contended that all of the motions:

move the Board to find claims 17-23 and/or 26-27 to be unpatentable under 35 USC § 112(1) and invalid as anticipated under 35 USC § 102(b) for the [sic] substantially the same reasons, in regard to substantially the same terms and features alleged to be unsupported by the specification, and based on substantially the same alleged facts violates the page limitations set forth in the Standing Order.¹¹³

The panel denied Holbrooks's motion, stating that:

In this decision we address only Motion 3 of Bacchi and this paper is not more than 25 pages long.

Furthermore, even if we considered it advisable to address all the issues in Motions 3-7 on the merits, we would not grant Holbrooks' request. We do not agree with the junior party that these motions are based on "substantially the same reasons." First of all, Motions 3-5 and 7, and Motion 6, are based on different statutory grounds. Motions 3-5 and 7 are based on the first paragraph of 35 U.S.C. § 112, whereas Motion 6 is based on the second paragraph of the statute. Furthermore, even when the statutory ground in the motions is the same (e.g., Motions 3-5 and 7), different groupings of claims are involved, and the arguments in the motions relate to

¹¹² 69 USPQ2d at 1697.

¹¹³ 69 USPQ2d at 1697. The bracketed material appears in the original.

different claim limitations. Compare the different groupings of claims in the three groups comprising Motion 3, Motions 4 and 5, and Motion 7.¹¹⁴

Comments

The various versions of the board's orders declaring an interference include a requirement that each party must serve and file, two days before a conference call for the purpose of setting the dates for filing preliminary motions, oppositions, and replies, a list of its proposed motions, and the APJ often inquires whether a single proposed preliminary motion should be presented as a number of separate motions, or whether a number of separate motions should be consolidated into a single motion. Assuming (1) that Bracchi's motions were properly authorized and (2) that each motion, in the absence of authorization to exceed the page limit stated in the standing order, complied with the limitations on page limits, Holbrooks's requests for dismissal seems to be quite a stretch, perhaps bordering on the frivolous.

¹¹⁴ 69 UPSQ2d at 1697-98.

J. The Court Finds (1) No Conflict Between 37 CFR 1.610(d) and 37 CFR 1.2 and (2) Adequate Authority for the Board to Issue Its Standing Order

In re Sullivan

In *In re Sullivan*, 362 F.2d 1324, 70 USPQ2d 1145 (Fed. Cir. 2004) (opinion delivered by Circuit Judge Linn for a panel also consisting of Senior Circuit Judge Archer and Circuit Judge Dyk), the court found no conflict between 37 CFR 1.610(d), which permitted conferences between the administrative patent judge and the parties in an interference and allowed the judge to enter appropriate orders after such a conference, and 37 CFR 1.2, which states that all business with the PTO should be conducted in writing. Likewise, the court found sufficient basis for the board to issue its “STANDING ORDER.”

Sullivan argued as follows:

Finally, Sullivan complains of two alleged procedural violations. Specifically, he argues that 37 C.F.R. § 1.610(d), which permits conferences between the administrative patent judge and the parties in an interference and allows the judge to enter appropriate orders after such conferences, is in conflict with 37 C.F.R. § 1.2, which states that “[a]ll business with the Patent and Trademark Office should be conducted in writing.” However, Congress has expressly delegated to the Patent and Trademark Office authority to “establish regulations, not inconsistent with law, which ... shall govern the conduct of proceedings in the Office.” 35 U.S.C. § 2(b)(2) (2000). Section 1.610(d) was the product of notice-and-comment rulemaking, *see* Patent Appeal and Interference Practice, 60 Fed. Reg. 14,488 (Mar. 17, 1995), and we must accordingly give it “controlling weight unless [it is] arbitrary, capricious, or manifestly contrary to the statute.” *Chevron U.S.A., Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837, 844 (1984). We perceive no violation of due process in the procedure contemplated by Section 1.610(d) and hold that it is not arbitrary, capricious, or manifestly contrary to the statute. Accordingly, we have no hesitation

in deferring to the Office's expertise in conducting its own proceedings in this case.

Sullivan also argues that the Board was without authority to enter a "Standing Order" governing procedure to be followed during the interference. The relevant regulation, 37 C.F.R. § 1.610, grants the administrative patent judge assigned to an interference discretion to "enter all interference orders in the interference," and provides that "times for taking action by a party in the interference will be set on a case-by-case basis by the administrative patent judge assigned to the interference." 37 C.F.R. § 1.610(a), (c) (2002). We must give "controlling weight" to the Patent and Trademark Office's interpretation of this regulation unless the interpretation is "plainly erroneous or inconsistent with the regulation." [*Bowles v. Seminole Rock [& Sand Co.], 325 U.S. [410] at 414 [(1945)].*]

The Standing Order sets forth guidelines relating to, inter alia, the form of papers to be filed, how conferences are to be conducted, the cross-examination of witnesses, and like matters. The Order specifically provides that "[w]here appropriate, the terms of this STANDING ORDER may be modified by an administrative patent judge." We see no reason why administrative patent judges should have to re-invent the wheel in such procedural matters in each new interference case, particularly where the Standing Order allows them to depart from its terms when appropriate. We hold the Board's interpretation of 37 C.F.R. § 1.610 as permitting the entry of the Standing Order in interference cases is not "plainly erroneous or inconsistent with the regulation." *Seminole Rock, 325 U.S. at 414*, and accordingly defer to that interpretation.¹¹⁵

¹¹⁵ 362 F.3d at 1328, 70 USPQ2d at 1149.

K. The Board Has Reaffirmed Its Perceived Lack of Jurisdiction in Interferences Wherein More Than One Party Has a Patent Involved in the Interference

Benson v. Ginter

In *Benson v. Ginter*,¹¹⁶ 72 USPQ2d 1125 (PTOBPAI 2003) (non-precedential interlocutory opinion by APJ Lee, not joined by any other APJ), Judge Lee denied Benson's 37 CFR 635/642 Motion 1 seeking to add two Ginter patents to the interference.

Judge Lee stated the background of the interference as follows:

Benson is involved in this interference on the basis of one patent and two applications and Ginter is involved in this interference on the basis of one application. Thus, as compared to the circumstances in *Louis v. Okada, supra* [57 USPQ2d 1430 (PTOBPAI 2000)], Benson the patentee here has two applications which are also involved in the interference. However, based on the rationale expressed in *Louis v. Okada, supra*, this is a difference without a distinction. It is inescapable that the addition of any Ginter patent in this interference will pit a Benson patent against a Ginter patent in a priority contest, provided that both the Benson patent and the Ginter patent will have claims corresponding to the same count. That result is unchanged by the fact that Benson also has applications which are involved in a priority contest with the additional Ginter patents.

While it is possible for one to ignore the presence of patents on both sides of an interference proceeding by focusing on the presence of applications on both sides, that merely creates an illusion that the board is only conducting an application versus patent or application versus application interference where in reality it is not. Where a determination of priority based on the count in an interference would resolve rights of opposing parties in conflicting patents, i.e., patents that interfere with each

¹¹⁶ In the interest of candor, author Gholz is the lead attorney for the party Benson, and author Rollins has participated in proceedings during the interference.

other, as it would be here if the additional Ginter patents are included in this interference, the board is without jurisdiction to make that determination. That is how the precedential decision *Louis v. Okada, supra*, should be read and applied. As is stated in *Louis v. Okada*, 57 USPQ2d at 1434:

A conflict between two patents is no less a conflict between two patents simply because another conflict exists between one of the patents and a separate application.

Comment

See Mr. Gholz's write-up of *Louis v. Okada* in Gholz, *A Critique of Recent Opinions of the Federal Circuit in Patent Interferences*, 84 JPTOS 163 (2002) at pages 192-94 and his write-up of *Anderson v. Hill* in Gholz, *A Critique of Recent Opinions in Patent Interferences*, 86 JPTOS 464 (2004) at pages 473-476. The authors remain of the opinions expressed in those comments.

The quoted conclusion of the board in *Louis v. Okada* invites the parallel observation that a conflict between a patent and an application or an application against an application is no less a conflict between a patent and an application or an application against application simply because other conflicting patents of one or more of the parties are directed to the same patentable invention.

It is not easy to reconcile the board's constriction of the jurisdictional aspects of 35 USC 135(a) in *Louis* with its decision in *Anderson v. Hill*. Analyzing *Anderson* in the same manner that the board analyzed the situation in *Louis*, the parties Anderson and Hill were both in the interference on patents, while Snitzer was in the interference on an application. According to the board's views in *Louis*, the interference consisted of separate interferences between applicant Snitzer and patentee Anderson, applicant Snitzer

against patentee Hill, and patentee Anderson against patentee Hill. However, the board had no problem with jurisdiction in that case, although it indicated that the interference would have to be terminated if the applicant Snitzer were to be eliminated from the interference. Apparently, the board considered that “partial” jurisdiction was sufficient for it to declare and maintain the interference. In point of fact, the board’s conclusion that the interference would have to be terminated if the applicant Snitzer were to be eliminated from the interference seems to be inconsistent with the Federal Circuit’s opinion in *Guinn v. Kopf*, 96 F.3d 1419, 40 USPQ2d 157 (Fed. Cir. 1996) (Rich, J.), discussed in Gholz, *A Critique of Recent Opinions of the Federal Circuit in Patent Interferences*, 80 JPTOS 321 (1998) at pages 339-42:

The language of the statute [35 USC 135(a)] militates against the interpretation that disclaiming all claims relating to a single count in an interference divests the Board of jurisdiction over an interference. Section 135 provides the basis for the Commissioner to declare an interference. *Guinn* does dispute that Interference 103,096 was properly declared by the Commissioner. Section 135 also states that Board “shall determine questions of priority” after the declaration of an interference. *Guinn* asserts that his unilateral act of disclaiming claim 9 from the ‘812 patent can divest the Board of its responsibility to determine the priority question in the interference. The statute does not provide for any such divestment of jurisdiction.¹¹⁷

The authors submit that a reasonable interpretation of 35 USC 135(a) and 35 USC 291 is (1) that the board has jurisdiction to determine any conflicts between an application and “any pending application, or with any unexpired patent” and (2) that Federal District Courts have no jurisdiction under 35 USC 291 to decide interferences involving even a single patent application. None of the board’s opinions in *Louis*,

¹¹⁷ 96 F.3d at 1421-22, 40 USPQ2d at 1159.

Anderson, or *Benson* addresses the meaning of “any” patent or “any” pending application in the statute.

In any event, the time may well be right for the Federal Circuit and/or Congress to address whether the board has (or should have) virtually unlimited discretion to determine whether a conflict exists between parties claiming the same patentable invention.¹¹⁸

¹¹⁸ See also Gholz, “The Majority of a Three-Judge Panel of the Federal Circuit Has Approved the Two-Way Test of *Winter v. Fujita*--But Help May Be on the Way,” 10 *Intellectual Property Today* No. 9 at page 36 (2003), which discusses another attempt by the board (so far successful) to dodge judicial work that needs to be done by somebody.

XI. PATENTABILITY ISSUES ARISING IN AN INTERFERENCE CONTEXT

A. The Written Description Requirement

Bilstad v. Wakalopulos

In *Bilstad v. Wakalopulos*, 386 F.3d 1116, 72 USPQ2d 1785 (Fed. Cir. 2004) (opinion by Circuit Judge Linn, joined by Circuit Judge Bryson and Senior Circuit Judge Plager), the court reversed the board's decision (1) holding all of Bilstad's claims designated as corresponding to the count unpatentable under the written description requirement of the first paragraph of 35 USC 112 and (2) awarding judgment in the interference to the senior party Wakalopulos. The court affirmed the board's holdings with regard to "claim construction" and dismissal of Bilstad's motion for leave to belatedly add additional claims to its application in the interference.¹¹⁹

The opinion is somewhat confusing in using the terms "count" and "claims" and the terms "patent" and "application" interchangeably. In its opening paragraph, the opinion states that:

Because the Board's claim constriction was correct, and because the Board did not abuse its discretion in dismissing Bilstad's motion for leave to belatedly add additional claims to the *count*, we affirm those portions of the Board's decision. However, because the Board failed to apply the correct standard in deciding whether Bilstad's disclosure supported the *count*, we vacate that portion of the Board's decision and remand.¹²⁰

The opinion states the background of the interference as follows:

This interference was declared on March 30, 2002 between an application of Bilstad, Application Serial No. 09/294,964, filed April 20, 1999, and a patent of

¹¹⁹ 386 F.3d at 1118, 72 USPQ2d at 1786.

¹²⁰ 386 F.2d at 1118, 72 USPQ2d at 1786; emphasis supplied.

Wakalopulos, U.S. Patent No. 6,140,657 (“the ‘657 patent”), filed March 17, 1999 and issued October 31, 2000. The claimed subject matter relates to an apparatus for sterilizing three-dimensional objects using ionizing radiation without affecting the target objects in a deleterious manner.

Bilstad provoked the interference by copying claims 1, 5-8, 11, and 16-17 of the patent into Bilstad’s pending application as claims 57-64, as well as adding a paraphrased version of Wakalopulos’s claim 18 as claim 65. The Board declared the interference, designating claim 1 of the ‘657 patent as the only count and identifying Bilstad’s claims 57-65 as corresponding to the count. The count reads as follows, with the disputed portion underlined [italized]:

A sterilization apparatus comprising,

an electron beam tube having a window permitting emergence of an electron beam from said tube into an ambient gaseous environment while preserving a vacuum environment in the tube, the electron beam having a trajectory within a plasma cloud defining a reactive volume stimulated by interaction of the electron beam with the ambient environment, with a beam energy less than 100 kV at the target, and

a moveable member *manipulating objects in a plurality of directions* within the reactive volume wherein the manipulated objects are sterilized.¹²¹

Since the board declared the interference “designating claim 1 of the ‘657 patent as the only count,” the count reproduced in the opinion presumably is identical to claim 1 of the Wakalopulos patent. None of the Bilstad claims are reproduced. The discussion of

¹²¹ 386 F.3d at 1118-1119, 72 USPQ2d at 1786-87.

the background in the opinion indicates that Bilstad's claims 57-64 were copied exactly from Wakalopulos's claims 1, 5-8, 11, and 16-17, while Bilstad's claim 65 was a "paraphrased" version of Wakalopulos's claim 18. In any event, the opinion describes Wakalopulos's preliminary motion 1 for judgment that Bilstad's claims corresponding to the count were unpatentable, asserting "that the involved claims of the Bilstad patent [sic; application] lacked adequate written description support under 35 U.S.C. § 112, ¶ 1 for the claim limitation 'a moveable member manipulating objects in a plurality of directions within the reactive volume.'"¹²²

The opinion notes that:

In addition to its opposition to Wakalopulos's motion for judgment, Bilstad sought an extension of the Rule 633(i) period. Under Rule 633(i), an opponent to a motion filed under Rule 633(a) is permitted to file a preliminary motion under Rule 633(c) to add or amend claims to address the alleged unpatentability of the claims.... The Board denied Bilstad's request for an extension of time, and Bilstad did not file a timely motion under Rule 633(i).¹²³

The board held a hearing on September 27, 2002 and granted judgment in favor of Wakalopulos on March 31, 2003.¹²⁴ The court's panel observed that:

In that judgment, the Board concluded that all of Bilstad's involved claims were unpatentable under 35 U.S.C. § 112 for lack of written description. In reaching this conclusion, the Board focused on the term "plurality," which it construed to "connote[] an indefinite numerical range. The range is bounded by two at the lower end and unbounded or infinite at the upper end."... The Board also stated that "plurality is a generic word which encompasses

¹²² 386 F.3d at 1119, 72 USPQ2d at 1787.

¹²³ Id.

¹²⁴ Id.

within its meaning any number at least two or greater.” ... Based on Bilstad’s written description, however, the Board concluded that Bilstad described manipulating objects “in a small number of directions,” and that “Bilstad’s original specification does not provide a written description of manipulations in a large number of directions.” ... The Board thus found the written description lacking and granted judgment in Wakalopulos’s favor.¹²⁵

The opinion points out that:

Bilstad sought reconsideration of the Board’s decision, arguing that: (1) the Board erred in construing “plurality” as a range; (2) Bilstad was prejudiced because the Board adopted a definition of “plurality” that neither party proffered; and (3) given the Board’s finding that Bilstad disclosed a member capable of manipulating objects in a small number of directions, “the mere disclosure of movement in two or three directions would be adequate ... support” for “plurality” under § 112 ¶ 1. At the same time, Bilstad filed a miscellaneous motion under 37 C.F.R. § 1.635 [footnote omitted] seeking leave to belatedly add to the Bilstad application claims designated as corresponding to the count. The motion essentially sought leave to file a Rule 633(i) motion after the deadline for filing such motions had passed. Along with the Rule 635 motion, Bilstad filed Motion 5 which sought to add to the count a number of claims not including the term “plurality.”¹²⁶

In its reconsideration decision of May 23, 2003, the Board addressed both Bilstad’s reconsideration motion and the miscellaneous motion under 37 C.F.R. § 1.635. The Board was unpersuaded by Bilstad’s arguments regarding

¹²⁵ Id.

¹²⁶ 386 F.3d at 1119-20, 72 USPQ2d at 1787-88 (bracketed material added). It is unclear from the opinion whether Bilstad’s motion 5 was (1) a 37 CFR 1.633(i)/1.633(c)(2) motion to add claims corresponding to the count to its involved application or (2) a 37 CFR 1.633(i)/633(c)(1) motion to add or substitute a *count* that contained added existing or proposed new Bilstad claims lacking the term “plurality.”

the construction of “plurality” and the extent of support for the term in Bilstad’s written description.... As to Bilstad’s Rule 635 motion, the Board noted that Bilstad failed to follow the procedure in the standing order requiring a conference call prior to the filing of such motions. As such, the Board dismissed Bilstad’s miscellaneous motion and returned as unauthorized the accompanying motion to add claims.... Because the Board noted that “the matters raised in the miscellaneous motion appear also to have been raised as part of Bilstad’s request for reconsideration,” the Board addressed, to that extent, the merits of Bilstad’s motion.... The Board concluded that “Bilstad’s current position is the result of choices made by Bilstad” and that “Bilstad was not denied the opportunity to file a motion to amend or add claims or to change the count,” but rather, “Bilstad did not take advantage of the opportunity afforded.”¹²⁷

Although the opinion begins its discussion with a section entitled “Standard of Review,” it actually begins that section by discussing the allocation of the burden of proof relating to interference motions. Citing *Kubota v. Shibuya*, 999 F.2d 517, 519 n. 2, 522, 27 USPQ2d 1418, 1420 n.2, 1422-23 (Fed. Cir. 1993), the court stated that:

Thus, once Bilstad convinced the examiner that he was entitled to an interference, that decision was presumed to be correct, and Wakalopulos bore the burden of proving that it was incorrect by a preponderance of the evidence.¹²⁸

Then, the panel continued:

Interpretation of an interference count is a question of law, reviewed de novo, *Credle v. Bond*, 25 F.3d 1566, 1571 [30 USPQ2d 1911, 1915] (Fed. Cir. 1994). Whether an application complies with the written description requirement of 35 U.S.C. § 112, ¶ 1 is a question of fact reviewed for substantial evidence. *Singh v. Brake*, 517 F.3d 1334, 1343 [65 USPQ2d 1641, 1647] (Fed. Cir. 2003); see also *In re Gartside*, 203 F.3d 1305, 1315 [53 USPQ2d 1769, 1775] (Fed. Cir. 2000) (adopting the substantial evidence standard of the Administrative

¹²⁷ 386 F.3d at 1119-20, 72 USPQ2d at 1788.

¹²⁸ 386 F.3d at 1120, 72 USPQ2d at 1788.

Procedure Act in reviewing factual findings of the Board). Substantial evidence is merely “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *In re Zurko*, 258 F.3d 1379, 1384 [59 USPQ2d 1693, 1696] (Fed. Cir. 2001) (quoting *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)).¹²⁹

The opinion also notes that the board’s decision denying leave for Bilstad to file a belated motion under 37 CFR 1.633(i) is reviewed for abuse of discretion. In a footnote, the court additionally noted that Bilstad argued also that the board erred in construing the term “plurality” in view of Bilstad’s disclosure, instead of looking to the ‘657 patent, but the court concluded that the construction of the term “plurality” was the same in view of either of the parties’ disclosures.¹³⁰

The panel began its “written description” analysis by citing several cases:

With particular relevance to this case, several cases have considered the issue of written description support for an added genus claim when only a species is disclosed. In *In re Smythe*, our predecessor court said, “We cannot agree with the broad proposition . . . that in every case where the description of the invention in the specification is narrower than that in the claim there has been a failure to fulfill the description requirement in section 112. 480 F.2d 1376, 1382 [178 USPQ 279, 284-85] (CCPA 1973). *Smythe* involved a question of whether a disclosure of air as a segmentizing medium was sufficient written description to support the broader claim language “inert fluid” though the term “fluid” did not appear in the written description. The court concluded,

We believe the use of an inert *fluid* broadly in this invention would naturally occur to one skilled in the art reading the description of the use of air or other gas *as a segmentizing medium* to separate the liquid samples. While fluid is a broader term,

¹²⁹ 386 F.3d at 1120-21, 72 USPQ2d at 1788-89.

¹³⁰ 386 F.3d at 1121 n. 2, 72 USPQ2d at 1789 n. 2.

encompassing liquids, as noted by the solicitor, the specification clearly conveys to one skilled in the art that in this invention, the characteristics of a fluid are what make the segmentizing medium work in this invention.

This is not a case where there is any unpredictability such that appellant's description of air or other inert gas would not convey to one skilled in the art knowledge that appellant's invented an analysis system with a fluid segmentizing medium.

Id. at 1383 [178 USPQ at 284-85]. Similarly, in *In re Rasmussen*, 650 F.2d 1212, 1215 [211 USPQ 323, 326-27] (CCPA 1981), our predecessor court considered whether a written description disclosing a single method of applying adhesive supported the amended claim containing the broad language "adheringly applying." The court explained: "[T]hat a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment." *Id.* The court stated that "one skilled in the art who read Rasmussen's specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered." *Id.* Thus, our predecessor court recognized that disclosure of a single species without a genus may be enough support for a claim directed to the genus.

In *Ralston Purina Corp. v. Far-Mar-Co. Inc.*, 772 F.2d 1570, 1575-77 [227 USPQ 177, 179-181] (Fed. Cir. 1985), this court affirmed a trial court's finding that several open-ended ranges were supported by a parent written description. In particular, this court affirmed a trial court's conclusion that the limitation "protein content of at least about that of solvent extracted soybean meal" was supported by the written description disclosing solvent extracted soybean meal with protein content of about 50 percent. *Id.* at 1375-76. Although open ended and although the parent disclosure did not teach materials having greater than 50 percent protein content, this court said, "The trial court found that the parent disclosure does support the claim language, based on the 1964 disclosure and on consideration of the knowledge possessed by those skilled in the art of extrusion of both farinaceous and proteinaceous vegetable materials in 1964." *Id.* at 1576.

We then noted that soybean meal with protein contents above 50 percent were readily available commodities in 1964. We concluded that “the court did not clearly err in determining that the parent’s disclosure adequately supports the protein content of the claims in issue.

Thus, this court has continued to apply the rule that the disclosure of a species may be sufficient written description support for a later claimed genus including that species. As we explained in *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*:

Claim 1 was properly rejected because it *recited* an element not supported by Fox’s disclosure, i.e., a lockout “on the stapler.” It does not follow, however, that Fox’s disclosure could not support claims sufficiently broad to read on a lockout off of the cartridge. If Fox did not consider the precise location of the lockout to be an element of his invention, he was free to draft claim 24 broadly (within the limits imposed by the prior art) to exclude the lockout’s exact location as a limitation on the claimed invention. Such a claim would not be unsupported by the specification even though it would be literally infringed by undisclosed embodiments.

93 F.3d 1572, 1582 n. 7 [40 USPQ2d 1019, 1027 n.7] (Fed. Cir. 1996) (citations omitted); *see also Lampi Corp. v. Am. Power Prods., Inc.*, 228 F.3d 1365, 1377-78 [56 USPQ2d 1445, 1455] (Fed. Cir. 2000) (affirming the district court’s finding that disclosure of only identical half-shells was sufficient written description support for a claim encompassing both identical and non-identical half-shells).¹³¹

The panel then stated that:

There are, however, exceptions to the general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus. For example, in the recent case of *In re Curtis*, 354

¹³¹ 386 F.3d at 1124-25, 72 USPQ2d at 1790-91.

F.3d 1347 [69 USPQ2d 1274] (Fed. Cir. 2004), this court affirmed the Board's rejection of claims directed to dental floss for failure to satisfy the written description requirement. The relevant parent application only disclosed the use of microcrystalline wax as adhered to the polytetrafluoroethylene floss. However, the claims in the continuation-in-part application were more broadly drawn to the genus of friction enhancing coatings applied to polytetrafluoroethylene floss. This court explained that the evidence relied on by the Board in determining that the later claims were not entitled to priority to the parent application indicated that at the time the parent application was filed no one knew of any material other than microcrystalline wax that would adhere to the polytetrafluoroethylene floss. *Id.* at 1352-53 [69 USPQ2d at 1277]. This court then distinguished *In re Smythe* by explaining that the Board properly found that this particular field was unpredictable. "Unlike the circumstances *In re Smythe* presented, the instant facts present a case in which there is 'unpredictability in performance of certain species or subcombinations other than those specifically enumerated.'" *Id.* at 1355 [69 USPQ2d at 1280-82] (quoting *In re Smythe*, 480 F.2d at 1383 [178 USPQ at 284-85]). Thus, unpredictability in the particular field may warrant closer scrutiny of whether disclosure of a species is sufficient to describe a genus.

The distinction in these cases is based upon what would be reasonably conveyed to a person skilled in the art at the time of the original disclosure. If the difference between members of the group is such that persons skilled in the art would not readily discern that other members of the genus would perform similarly to the disclosed members, i.e., if the art is unpredictable, then disclosure of more species is necessary to adequately show possession of the entire genus.

Another exception is presented in *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 [47 USPQ2d 1829] (Fed. Cir. 1998). In *Tronzo*, this court held that substantial evidence did not support the jury's verdict that claims to a hip prosthesis of generic shape were supported by a parent disclosing only a trapezoidal shape. We said, "Instead of suggesting that the '589 patent [the parent] encompasses additional shapes, the specification specifically distinguishes the prior art as inferior and touts the advantages of the conical shape of the '589 cup. Such statement makes clear that the '589 patent

discloses *only* conical shaped cups and nothing broader.”
Id. at 1159 [47 USPQ2d at 1833] (citations omitted).¹³²

The opinion then discussed the board’s analysis of the written description requirement as follows:

In analyzing the written description question in this case, the Board made much of how “the written description must actually describe the later-claimed invention, not just enable it or provide information to render it obvious.”... However, the Board never truly discussed the understanding of persons skilled in the art and whether Bilstad’s written description would reasonably convey to a person skilled in the art that Bilstad had possession of the claimed subject matter at the time of filing. Specifically, the Board made no findings on the unpredictability in the art or on whether Bilstad’s disclosure expressly disclaimed manipulation in a larger number of directions than the “small number” that the Board found that his disclosure taught. The Board relied heavily on *Tronzo*.... However, the Board failed to recognize how *Tronzo* fits within the spectrum of cases involving written description support for a genus when only one or more species are disclosed. In the mechanical world -- a fairly predictable field -- it is wholly conceivable that manipulation in a small number of directions may convey to one skilled in the art that Bilstad indeed described manipulation in a “plurality” of directions. See *In re Curtis*, 354 F.3d at 1354-55 [69 USPQ2d at 1279-81] (holding that an application would not have put persons skilled in the art on notice of the broad scope claimed by the applicant, where there is ‘ “unpredictability in performance of certain species or subcombinations other than those specifically enumerated.” ’ (quoting *In re Smythe*, 480 F.2d at 1383 [178 USPQ2d at 284-85])). But the record contains no analysis of what one skilled in the art would have understood from the Bilstad disclosure or the degree of predictability of technical variations in this field of art. The Board noted that Bilstad’s written description disclosed manipulating objects in only a small number of directions and concluded that this was insufficient to support the manipulation of objects in a range bounded by two and infinity.... Under the circumstances of this case, however, the Board erred in

¹³² 386 F.3d at 1123-1125, 72 USPQ2d at 1790-1792.

failing to consider the knowledge of one skilled in the art and the level of predictability in the field.

Even though the appeal is properly before us, a resolution of the question of whether Bilstad's disclosure of manipulation in a small number of directions would reasonably convey to a person skilled in the relevant art that Bilstad had possession of manipulation in a plurality of directions as of his filing date required fact findings this court is not permitted to make.¹³³

The court vacated the board's decision with respect to the written description requirement and remanded the case for reconsideration "under the proper test for support of the count."

With regard to the board's denial of Bilstad's 37 CFR 1.635 motion to file a belated motion adding or amending the claims, the panel agreed that the board did not abuse its discretion by refusing to consider Bilstad's attempt to add new claims after the board's decision on motions.¹³⁴

Bilstad argued that the board had assured him that Bilstad would have every opportunity to file those motions when it denied Bilstad's request for an extension of time, but that the board then prejudiced Bilstad by refusing later to entertain Bilstad's belated motion under 37 CFR 1.633(i). Bilstad also argued that the required conference call requesting permission to file a belated motion had been made when, during the preliminary motion period, he called requesting permission to file a belated motion at that time, stating that the administrative patent judge had granted permission to file the motion, citing the portion of the APJ's order denying his original motion "without

¹³³ 386 F.3d at 1125-26, 72 F.2d at 1792-93.

¹³⁴ 386 F.3d at 1126-1127, 72 USPQ2d at 1973.

prejudice.” The panel found that the APJ, however, did not grant Bilstad permission to file the late motion, but simply denied Bilstad’s original motion without prejudice.¹³⁵

Comments

(1) The Bilstad inventors understandably might feel that they are involved in a nightmare in which they are characters in a Kafka novel. It appears from the opinion that Bilstad filed an application approximately a month after Wakalopulos filed its application which issued as Wakalopulos’s involved patent. Since the opinion indicates that the only limitation in the only count in the interference (i.e., Wakalopulos’s claim 1) and in Bilstad’s claims which is not clearly described in Bilstad’s application is that a moveable member within the reactive volume is described as “manipulating objects in a plurality of directions,” it seems inconceivable that Bilstad could not have submitted one or more claims that both (1) interfered in fact with Wakalopulos’s claims and (2) were clearly described in Bilstad’s application as filed. The board apparently recognized that Bilstad’s disclosure did describe manipulating such objects in “a small number” of directions, but not “a large number” of directions. Nothing in the opinion provides any context for what the panels of the board and the court regarded as either “a small number” or “a large number.”

The board apparently did not find that Bilstad did not have written description support for the lower end of the range “plurality” (i.e., “two”). The opinion is uninformative about the presence or number of specific embodiments described either by Bilstad or Wakalopulos. A single embodiment of Bilstad’s invention manipulating

¹³⁵ 386 F.3d at 1126-27, 72 USPQ2d at 1793.

objects in at least two directions would have apparently been sufficient for a specific claim that would interfere with Wakalopoulos's claims designated as corresponding to the count.

It seems reasonable to assume that Bilstad filed a patent application essentially contemporaneously with the filing of Wakalopoulos's application and disclosed an invention that, if not identical to that of Wakalopoulos, only varied somewhat in the scope of the description of the movable member's directional range. That is, Bilstad's manipulation in a "small number" of directions falls within the scope of the interference count as construed by the board and the court. Consequently, Bilstad had written description support for at least some embodiments and ranges within the scope of the count, which is all the "written description support" necessary for the *count*. That is, the entire written description issue resulting in the decisions in interference and on appeal stems from Bilstad's failure to present a claim to its disclosed invention in terms that were described in its application as filed. It appears from the opinion that Bilstad copied claims 1, 5-8, 11, and 16-17 of Wakalopoulos's patent verbatim and also added a paraphrased version of Wakalopoulos's claim 18. However, all of the copied claims, according to the opinion, contained the limitation "manipulating objects in a plurality of directions" that did not literally appear in Bilstad's application as filed.

The opinion is not very informative about the relative disclosures of the parties. The count (i.e., Wakalopoulos's claim 1) is itself open-ended with regard to the specific structure of the "movable member manipulating objects in a plurality of directions."

More to the point, there is no indication in the opinion that the limitation "plurality" has any particular significance to the invention, or that it differed materially

from “a small number” or “a large number.”

In this specific case, the opinion’s mischaracterization of the issue as Bilstad’s failure to provide a written description of the “count” seems to be harmless error because the limitation in question appears both in the count and in all of the claims that Bilstad copied from the Wakalopulos patent. Even in interferences between applications, there has been no requirement to copy an opponent’s claims identically for many years. *Case v. CPC International, Inc.*, 730 F.2d 745, 749-52, 221 USPQ 196, 199-200 (Fed. Cir. 1984); *Aelony v. Arni*, 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977); *Squires v. Corbett*, 560 F.2d 424, 194 USPQ 513 (CCPA 1977); *Behr v. Talbott*, 27 USPQ2d 1401, 1405-06 (PTOBPAI 1992) (expanded panel); and *Fujiie v. Verhagen*, 13 USPQ2d 1986, 1987-88 (PTOBPAI 1989) (“The ‘count’ as distinguished from a party’s ‘claim’[,] need not be patentable to either party in the sense that it is fully supported by either party’s disclosure. *Squires, supra*, 194 USPQ 519.”) As also noted in *Fujiie*, only a single embodiment within the scope of a count is normally sufficient to “support” the count. In any event, Bilstad would have needed only a disclosure of a patentable species or sub-genus to “support” the count.¹³⁶

(2) The opinion does not explain the quantum leap from stating a “rule that disclosure of a single species *may* be sufficient support for a later claimed genus including that species,”¹³⁷ which may well find support in the *Smythe, Ralston Purina*, and *Rasmussen* opinions, to “the general rule that disclosure of a species *provides*

¹³⁶ *Weil v. Fritz*, 572 F.2d 856, 865-66 n.16, 196 USPQ 600, 609 n.16 (CCPA 1976)

¹³⁷ 386 F.3d at 1121, 72 USPQ2d at 1791 (emphasis supplied).

sufficient written description support for a latter filed claim directed to the genus”¹³⁸ (unless certain exceptions apply), which is not supported by the opinions in *Ethicon, Lampi, Curtis, or Tronzo*.

The opinions cited in support of the panel’s opinion on written description rather conspicuously omit discussion of cases such as *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479-80, 45 USPQ2d 1498, 1502-04 (Fed. Cir. 1998); *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 56 USPQ2d 1481 (Fed. Cir. 2000); *New Railhead Mfg., LLC v. Vermeer Mfg. Co.*, 298 F.3d 1290, 63 USPQ 1843 (Fed. Cir. 2002); and *TurboCare Div. of Demag Delaval Turbo Machinery Corp. v. General Electric Co.*, 264 F.3d 1111, 60 USPQ2d 1017, 1021-24 (Fed. Cir. 2001), among many others. In *TurboCare*, the panel (consisting of Judge Bryson, joined by Judges Gajarsa and Linn) stated that:

TurboCare contends that one of ordinary skill in the art would recognize that the only viable location for mounting a spring “adjacent to said rings” would be between the casing shoulders and the shoulders of the outer ring portion of the segment, and therefore that the claimed subject matter was inherent in the original disclosure. To support its contention, TurboCare offers the conclusory statements of its expert witness, Mr. Shifler, to that effect.

In order for a disclosure to be inherent, “the written descriptive matter must necessarily be present in the [original] application’s specification such that one skilled in the art would recognize such a disclosure.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998). Brandon’s original disclosure is completely lacking in any description of an embodiment in which the spring is located between the casing shoulders in the inner surface of the outer ring portion of the ring segment. Such an embodiment may have been obvious from Brandon’s vague reference to a “spring located ...

¹³⁸ 386 F.3d at 1125, 72 USPQ2d at 1791 (emphasis supplied).

adjacent to said rings.” As we held in *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 41 USPQ2d 1961 (Fed. Cir. 1997), however, that is not enough to satisfy the written description requirement:

While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.

Id. at 1572, 41 USPQ2d at 1966. No reasonable juror could find that Brandon’s original disclosure was sufficiently detailed to enable one skilled in the art to recognize that Brandon invented what is claimed.¹³⁹

While it is beyond the scope of this article to consider in great detail the large number of opinions devoted to the written description requirement, many of the opinions in the evolution of the written description requirement as a requirement apart from the enablement requirement involved situations in which the new claims were directed to a subgenus or range that was not described as such although one or numerous species under the subgenus or within the range and at least one genus broader than the subgenus or narrower range were adequately disclosed.¹⁴⁰

¹³⁹ 264 F.3d at 1119, 60 USPQ2d at 1023-24.

¹⁴⁰ See Waltersheid, Insufficient Disclosure Rejections (Part III), 62 JPOS 261-289 (1980) (written description) and Waltersheid, Insufficient Disclosure Rejections (Part V), 62 JPOS 387-418 (1980) (enablement requirement).

The discussion of the *Smythe* opinion in the *Bilstad* opinion demonstrates the extent to which *Smythe* was treated as an enablement issue. The opinion notes that “The board may have also treated the rejections of these claims under § 112 under the ‘enablement’ section of the first paragraph, but the solicitor has narrowed the rejection by argument to the ‘description’ requirement.”¹⁴¹ While obviousness or “predictability” may be issues properly considered in an enablement analysis, they are of limited value in a written description (recognition or identification) analysis. The portions of the *Smythe* opinion quoted in *Bilstad* seem more appropriate to findings of facts and conclusions of law of the type commonly found in an opinion on enablement issues.¹⁴² Similarly, the *Rasmussen* opinion quoted in *Bilstad* makes it clear that Chief Judge Markey liberally found the facts for the court (“one skilled in the art who read Rasmussen’s specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered.”) That is arguably a finding of fact somewhat couched as a conclusion of law without reference to the basis for the conclusion.¹⁴³ Conversely, as *TurboCare* and

¹⁴¹ 480 F.2d at 1382 n. 2, 178 USPQ at 284 n. 2.

¹⁴² It is interesting to note that Judge Baldwin dissented in *Smythe*, rather persuasively accusing the majority of making unwarranted findings of fact and applying an obviousness analysis, 480 F.2d at 1386-89, 178 USPQ at 287-88. In turn, Judge Baldwin’s opinion in *Ralston*, which was based primarily on a lack of “clear error” in the lower court’s findings, was persuasively characterized as employing an obviousness approach and standard in Judge Miller’s dissenting-in-part opinion, 772 F.2d at 1577-81, 227 USPQ2d at 181-84.

¹⁴³ Compare Rollins, “New Matter” Clarified? In re Rasmussen, 63 JPOS 560 (1981).

Tronzo make clear, the function of the understanding of one skilled in the art with regard to the written description requirement is to *recognize* the invention as it is claimed, not to be able to carry it out once the invention is recognized.

As Professor Chisum puts it (in discussing the knowledge of the art as represented by expert testimony):

In many instances, description requirement compliance depends primarily on an interpretation of the patent specification and the claim in question. A specification is addressed to persons of ordinary skill in the art, but this principle creates a danger that description requirement compliance questions will be resolved by a battle of partisan experts whose opinions, even when honestly put forth, may not be predicated on the proper legal standard for description. *For example, experts may tend to focus on what is “obvious” to them from the specification, which confuses the enablement requirement with the invention description. They may also use external sources and hindsight rather than focusing on what the specification clearly conveyed as of the filing date.*¹⁴⁴

Judges may also fall into the use of obviousness and hindsight. The *Smythe*, *Ralston Purina*, and *Rasmussen* opinions represent classic cases of confusing obviousness, enablement, and written description issues, together with considerable fact-finding by the appellate court.

¹⁴⁴ 3 Chisum on Patents, § 7.04 [2][f], pp. 7.201-7.202 (2003) (Rev. 8.2). Emphasis supplied.

Curiously, the panel in *Bilstad* failed to discuss what is probably the more closely analogous opinion, *In re Wertheim*.¹⁴⁵ In *Wertheim*, applicant presented a “continuation” application containing claims copied from a patent. Copied claim 1 specified a range of “at least 35%.” The specification described values of 36% and 50%. That is, the “continuation” specification was apparently the same as the parent application, except for the substitution of copied claims for the parent claims. The court held the range “at least 35%” to lack written description in the parent application’s disclosure.

(3) Although, the *Bilstand* panel was correct in finding that Wakalopulos, as the moving party, bore the *initial* burden of proof on his motion for a judgment that Bilstad’s disclosure did not provide a written description for Bilstad’s claims corresponding to the count, the opinion does not discuss the evidence necessary to meet that initial burden by a preponderance of the evidence. That is a significant point because the board and the court have provided additional interpretations of the pertinent rules in those circumstances where the initial burden of proof would require the moving party to prove a negative. In *Behr v. Talbott*, 27 USPQ2d 1401 (PTOBPAI 1992) (expanded panel), the board held that:

Consequently, a party moving under 37 C.F.R. 1.633(a) for a judgment on the ground that an opponent’s claims corresponding to the count lack written description support in the involved application has the burden of submitting with the motion proof which *prima facie* establishes that the limitation in question lacks either express *or* inherent support in the involved application.¹⁴⁶

¹⁴⁵ 541 F.2d 257, 263-64, 191 USPQ 90, 97 (CCPA 1976) (Rich, J.), appeal on other grounds after remand, 646 F.2d 527, 209 USPQ 554 (CCPA 1981) (Rich, J.).

¹⁴⁶ 27 USPQ2d at 1407; emphasis in the original.

Moreover, the Federal Circuit held in *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989), citing *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), that:

Although Gosteli does not have to describe exactly the subject matter claimed, *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971), the description must clearly allow persons of ordinary skill in the art to recognize that Gosteli invented what is claimed. *Wertheim*, 541 F.2d at 262, 191 USPQ at 196. We review this factual inquiry under the clearly erroneous standard. *See id.*

“[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *Id.* at 263, 191 USPQ at 97. In this case, the PTO has met that burden by pointing out a number of differences between what is disclosed in the Luxembourg priority application and what is claimed in Gosteli’s United States application. Gosteli does not dispute that additional subject matter is present in the United States application. Accordingly, the Board’s findings are not clearly erroneous. [Emphasis supplied].

See also the Commissioner’s Notice Interference Practice - Interference Rules Which Require a Party to “Show the Patentability” of a Claim, 1217 O.G. 1217 (1998) (limiting the interpretation of such rules to require in most cases only a showing of literal support for the terms of the claims), and *Holbrooks v. Bacchi*, 69 USPQ2d 1696 (PTOBPAI 2003), discussed below at section X.I.A.2.

While *Gosteli* is an ex parte appeal, the burden on the movant in an interference is no less than (and no more than) the burden on an examiner making a rejection of claims

or on a requestor for reexamination. *Jacobs v. Moriarity*, 6 USPQ2d 1799, 1801 (PTOBPAI 1988), and *Chiong v. Roland*, 17 USPQ 1541, 1543 (PTOBPAI 1990).

(4) The court panel's opinion begins its "Section 112 Analysis" by stating that:

Bilstad argues that the Board committed two errors in concluding that Bilstad's application provided insufficient written description to support the count, namely: (1) the Board erroneously construed the term "plurality" as used in the count, and (2) the Board erred in insisting that Bilstad's application must describe every embodiment within the range construction given by the Board to the term "plurality."¹⁴⁷

Of course, it is extremely unlikely that the board insisted "that Bilstad's application must describe every embodiment within the range construction given by the board to the term 'plurality.'" Apparently the board's position was (1) that the term "plurality" did not appear anywhere in Bilstad's application and (2) that the particular range that constituted "plurality" was not described by any other appropriate language appearing in Bilstad's application as originally filed (i.e., the term "plurality" apparently was added to Bilstad's application when Bilstad presented the claims copied from Wakalopulos's patent). Before the board, Wakalopulos argued that "plurality" meant "a large number; multitude," while Bilstad argued that "plurality" simply meant "two or more items."¹⁴⁸ The board noted that Webster's Third New International Dictionary included multiple definitions of "plurality," including "the state of being plural," "the state of being numerous," and "a large number or quantity: MULTITUDE," as well as "relatint to or consisting of or containing more than one." The board concluded that:

¹⁴⁷ 386 F.3d at 1121, 72 USPQ2d at 1789.

¹⁴⁸ 386 F.3d at 1121, 72 USPQ2d at 1789.

As is apparent from the Webster's definitions, the ordinary meaning of plurality encompasses both parties' proposed meanings. Therefore, we do not accept either party's proposed definitions because they are incomplete. Two may properly be referred to as a plurality and so may a large number. Thus, "plurality" connotes an indefinite numerical range. The range is bounded by two ... and ...infin[it]y....¹⁴⁹

Although it is unclear how the board's definition of plurality as being a range defined by the end points two and infinity differs from Bilstad's argued meaning of "two or more" or Webster's definition "relating to or consisting of or containing more than one," the court found no error in the board's construction of "plurality."¹⁵⁰ Open ended ranges are commonly used in patent claims. For example, the commonly used illustration "a vehicle comprising a wheel..." simply means having one or more wheels, although the board's finding that the upper end point of a range having no stated upper limit is "infinity" seems to be more philosophy or hyperbole than a real upper limit.¹⁵¹ Of course, some seemingly open ended ranges possess an inherent end point, such as "comprising 50 percent or more," which is inherently bounded at the upper end by 100 percent, notwithstanding the frequent assertions that someone "gave 110 percent effort."

In any event, the determination of the upper limit "plurality" is certainly an extremely close issue. The *Bilstad* panel must be commended for resisting the temptation to determine its own meaning -- a clear recognition that the type of "superexamination"

¹⁴⁹ 386 F.3d at 1122, 72 USPQ2d at 1789.

¹⁵⁰ 386 F.3d at 1122, 72 USPQ2d at 1790.

¹⁵¹ Presumably, building a vehicle comprising an infinity of wheels would be impossible because such task would require an infinity of time and an infinity of materials.

exercised in *Smythe, Ralston Purina, Rasmussen*, etc., is improper in the *Zurko/Singh, Gartside* era.

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B. The Written Description Requirement

Holbrooks v. Bacchi

In *Holbrooks v. Bacchi*, 69 USPQ2d 1696 (PTOBPAI 2003) (non-precedential) (opinion delivered by APJ Urynowicz for a panel also consisting of APJs Schafer and Lee), the board granted Bacchi's motion for a judgment that all of Holbrooks's claims designated as corresponding to the count were unpatentable under the written description requirement of the first paragraph of 35 USC 112. The board agreed with Bacchi that Holbrooks's disclosure did not specifically describe a claim limitation to a distal wrist pad with a "pad portion for supporting a wafer." Bacchi argued (1) that Holbrooks's disclosure did not explicitly describe or illustrate that a surface 42 supports a wafer and (2) that such support is not inherent in Holbrooks's disclosure.¹⁵²

Bacchi relied on an expert declaration by Dr. John Davies to the effect that, in Holbrooks's disclosure, the wafer can be held, grasped, or gripped by Holbrooks's groove without being supported, or even contacted, by surface 42.¹⁵³

Holbrooks argued that wrist pad 24 of Figure 4 of Bacchi's involved patent is "the same as, or equivalent to," Hollbrooks's finger 105 shown in its Figures 1 and 2, and operates in the same manner.¹⁵⁴ Holbrooks submitted that one skilled in the art would have recognized that the profile of its finger 105 or 205 (Figure 9) and the post 103 or 203, with a wafer being held, would look as shown in Attachment B to Holbrooks's

¹⁵² 69 USPQ2d at 1698.

¹⁵³ *Id.*

¹⁵⁴ *Id.*

opposition, and not as represented in Bacchi's motion at pages 8, 10, or 11.¹⁵⁵ Holbrooks also argued (1) that the declaration of Dr. Davies should not be considered because it was testimony to support a preliminary motion which was submitted without obtaining authorization under 37 CFR § 1.639(c) and (2) that Dr. Davies was not qualified to provide his opinion "because he has experience far in excess of one of ordinary skill in the art."¹⁵⁶

The panel agreed with Bacchi that Holbrooks had no written description under 35 USC 112, first paragraph, of a pad portion for supporting the peripheral edge of a specimen or a wafer. It explained that:

It is apparent that Bacchi has established that Holbrooks' specification does not set forth the language of the claims in identical or substantially identical words. Bacchi has also shown that the drawings do not illustrate structure that specifically meets the language of the claims. However, this alone is not fatal to Holbrooks because the written description requirement of 35 U.S.C. § 112 asks no more than whether the disclosure as originally filed would reasonably convey to an ordinary artisan that the inventor was in possession of the claimed subject matter. *Ralston Purina Co. v. Far-Mar Co. Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). Nevertheless, we find that Holbrooks' disclosure does not satisfy this requirement.

The junior party's position that the profile of its finger 105 or 205 and the post 103 and 203, with the wafer being held, would look as shown in Attachment B to its opposition has not been shown to have any basis in fact in its original disclosure. Holbrooks has not shown how its disclosure describes or illustrates a finger or post with 1) an upper portion narrower than the lower portion or 2) a wedge-shaped space of sufficient size to permit a wafer to be supported on the lower surface (wrist pad) of the groove defining the wedge-shaped space. Holbrooks has not

¹⁵⁵ Id.

¹⁵⁶ Id.

directed our attention to any part of its disclosure that would reasonably convey to an ordinary artisan that it was in possession of the subject matter illustrated in its Attachment B.

We agree with Bacchi that Holbrooks' surface 42 does not inherently support a wafer. A reasonably depicted side view of a finger or post as disclosed by Holbrooks in Figure 2b is illustrated at page 8, and again at page 11, of Bacchi's Motion 3. As shown in Holbrooks' Figure 2b, the width of the side of the finger is substantially uniform, not recessed at one end from the location of the notch or groove 126. In the embodiments presented in Holbrooks['] application, the plurality of fingers or posts grips or grasps the wafer, without a lower surface 42 of the grooves being disclosed as a pad portion for supporting the wafer. It is not sufficient for inherency that a person following the disclosure of Holbrooks might obtain the result set forth in the claims, it must invariably happen. *Scaltech Inc. v. Retec/Tetra, LLC.*, 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999); *Snitzer v. Etzel*, 531 F.2d 1062, 189 USPQ 415 (CCPA 1976). Bacchi has established that a person following Holbrooks' disclosure would not invariably obtain the subject matter set forth in the claims of a pad portion for supporting the edge of a specimen or wafer.¹⁵⁷

The panel also found that Dr. Davies's declaration was persuasive to the extent it supported Bacchi's position on the issue of whether Holbrooks satisfied the written description requirement of 35 USC 112, first paragraph. It noted (1) that Holbrooks did not attack the declaration specifically as to content and (2) that his argument that the declaration should not be considered because it was submitted without obtaining authorization under 37 CFR 1.639(c) was not persuasive because (a) 37 CFR 1.639(a) authorizes the filing of proof of any material fact alleged in a motion and (b) 37 CFR 1.639(b) authorizes the filing of proof in the form of affidavits.¹⁵⁸

¹⁵⁷ 69 USPQ2d at 1698-99.

¹⁵⁸ 69 USPQ2d at 1699.

The panel also disagreed with Holbrooks's only other argument with respect to the declaration, that Dr. Davies has experience far in excess of that of one of ordinary skill in the art, stating that it is established that an expert witness who has more than ordinary skill in the art is qualified to provide his opinion concerning matters of what would be obvious to persons of lesser skill than his own, citing *Moore v. Westbar Corp.*, 701 F.2d 1247, 1253, 217 USPQ 684, 689 (7th Cir. 1983).¹⁵⁹

Judge Lee wrote additional remarks. He began by reproducing the parts of Holbrooks's Attachment B showing the purported profile of the finger 105 or 205 of Holbrooks's disclosure. Judge Lee then stated that:

If the profile of Holbrooks' disclosed fingers really were as shown above, it may be an effective rebuttal of Bacchi's charge of lack of written description. However, the off-set or recessed concept of these illustrations does not stem from any reference disclosure in the specification but is evidently created for the purpose of opposing Bacchi's motion. It is disturbing that Holbrooks would present and rely on these illustrations as though they are what the specification describes, without citing any part of the specification and without any explanation.

What Holbrooks said about these illustrations are: (1) "A side view of the Holbrooks finger within the scope of the Holbrooks, [sic] application is shown in Attachment B"; and (2) "One skilled in the art would recognize that the profile of the Holbrooks finger 105 or 205 and the post 103 or 203, with wafer being held, would look as shown in Attachment B and not as represented in the Bacchi motion at page 8, 10, or 11." The second statement merely reflects wishful thinking that is not supported by evidence. The first statement, however, in the absence of any explanation, is a misrepresentation. It refers to "the Holbrooks finger within the scope of the Holbrooks application." In that context, use of the definite article "the" in the first instance implies that Holbrooks is referring to a specifically described embodiment and not some non-described

¹⁵⁹ Id.

embodiment which may happen to fall within the scope of what is claimed. Also, the statement refers to “within the scope of the Holbrooks application” and not “within the scope of a Holbrooks claim,” which again implies specific description in the application’s disclosure rather than any non-described embodiment which happen to fall within the scope of a claim.

In any event, a broader generic term does not provide written description for all specific embodiments that may fall within the scope of that term. Even assuming that Holbrooks meant to say “finger structure within the scope of what is claimed,” that does not effectively rebut the charge of lack of written description.¹⁶⁰

Comments

Judge Lee’s remarks emphasize that a party’s arguments in its briefs must carefully avoid either express or implied misrepresentations of the factual basis for the arguments. Persuasiveness of any argument is inversely proportional to the perceived accuracy with regard to the facts and legal opinions set forth in those arguments.

The panel’s approach to the issue of written description in the *Holbrooks* opinion certainly seems to place a lesser burden on the moving party in a written description motion and a greater burden on the non-moving party than the burdens suggested in the court’s opinion in *Bilstad*, supra. However, the opinions are not literally conflicting, and both cite *Ralston Purina* for support in reaching different results.

Holbrooks’s arguments that its structure was “the same as, or equivalent to” Bacchi’s disclosed embodiment improperly mixes the “same as” (description) and “equivalent to” (obviousness) concepts. See the comments about the *Bilstad* opinion above. The *Holbrooks* panel clearly limited the role of “one ordinarily skilled in the art”

¹⁶⁰ 69 USPQ2d at 1700-01.

as *recognizing* an explicit, implied, or inherent description in Holbrooks's disclosure, rather than finding a suggestion of obviousness (to try?).

XII. COURT REVIEW OF DECISIONS IN INTERFERENCE

A. The Federal Circuit Has Jurisdiction to Decide Whether the Board Had Jurisdiction

In re Sullivan

In *In re Sullivan*, 362 F.3d 1324, 70 USPQ2d 1145 (Fed. Cir. 2004) (opinion by Circuit Judge Linn for a panel also consisting of Senior Circuit Judge Archer and Circuit Judge Dyk), the court affirmed that the board had jurisdiction to redeclare an interference in which a party had copied claims from a patent into its pending application outside of the one year time bar of 35 USC 135(b).

The opinion explained the background of the issue as follows:

Sullivan was awarded United States Patent No. 6,015,916 on January 18, 2000. On August 10, 2001, Bingel copied claims 10-14 of the '916 patent in his pending patent application, Serial No. 09/508,057, to provoke an interference with that patent. On May 28, 2002, the Examiner declared an interference [sic; suggested an interference which was subsequently declared by an APJ] between the '916 patent and the '057 application. On November 20, 2002, the interference was redeclared to add Sullivan's United States Patent No. 6,455,719. At that time, the Board also entered an amendment [sic; granted a motion requesting the entry of an amendment] to one of the copied claims in the '057 application.... After the interference was redeclared, Sullivan filed a number of preliminary motions, in which he argued, inter alia, that the parties' claims corresponding to the interference [count] were unpatentable as obvious in view of certain prior art references, and that the Bingel claims involved in the interference were barred by 35 U.S.C. § 135(b), because claims 10-14 of the '916 patent had been copied more than one year after the issuance of the patent.¹⁶¹

¹⁶¹ 362 F.3d at 1325, 70 USPQ2d at 1147.

Prior to ruling on Sullivan’s preliminary motion, the board issued an order to Sullivan to show cause why judgment on priority should not be entered against him,¹⁶² and Sullivan responded by stating that he acceded, on the stated facts, “to the entry of judgment on priority only against Sullivan and in favor of Bingel.”¹⁶³ The board then issued (1) a judgment against Sullivan and (2) a recommendation that the examiner consider the patentability issues raised against Bingel’s application in Sullivan’s motions. The board also noted that Sullivan was entitled under 37 CFR 291 to file a protest against Bingel’s application.¹⁶⁴

Sullivan then appealed from the inter partes judgment. However, on appeal the court re-configured the appeal as an ex parte appeal. The Solicitor then filed a brief on behalf of the PTO. There is no indication that Bingel participated in the appeal.

The opinion states that:

Sullivan challenged the final decision of the Board on a number of grounds. First, he argues that this court lacks jurisdiction to review the decision because “the Board never acquired jurisdiction,” allegedly because some of the claims involved in the interference were copied more than one year after the issuance of the ‘916 patent. Sullivan’s jurisdictional argument is unpersuasive. This court has jurisdiction over appeals from decisions of the Board “with respect to . . . interferences” pursuant to 28 U.S.C. § 1295(a)(4). Even if the Board’s assertion of jurisdiction were improper, this court would still have jurisdiction to review the decision, make that determination, and ultimately remand the case with instructions to dismiss. *See e.g., Mitchell v. Maurer*, 293 U.S. 237, 243-44 (1934)

¹⁶² 362 F.3d at 1325-26, 70 USPQ2d at 1147.

¹⁶³ 362 F.3d at 1325, 70 USPQ2d at 1147.

¹⁶⁴ *Id.*

(holding that jurisdiction was not proper in the district court and remanding with directions to dismiss).

Sullivan argues that the Board's actions were "void ab initio" because the original declaration of the interference was allegedly unlawful. Whether or not the original interference was erroneously declared, however, the Board subsequently redeclared the interference, in the exercise of its discretion under 35 U.S.C. § 135(a) and 37 C.F.R. § 1.640(b)(1). The Board noted that the Bingel amendment to claim 8, which it entered simultaneously with the redeclaration of the interference, "may obviate Sullivan's 35 U.S.C. § 135(b) motion."... This was so because Sullivan "failed to specifically explain how Bingel's amended claim 8 is the 'same or substantially the same subject matter' as claimed in Sullivan's '916 patent." *Id.* To establish that the Board lacked jurisdiction, Sullivan must demonstrate not that the original declaration was improper, but rather that the redeclaration of the interference between the amended Bingel application and the two Sullivan patents was somehow unlawful.

Sullivan attacks the redeclaration of the interference and entry of the amendment on the ground that he was given no notice or opportunity to be heard. The record indicates, however, that the Board notified Sullivan that an opposition to Bingel's expedited motion to amend could be filed and was due no later than November 18, 2002. Furthermore, the Board's November 20, 2002 order entering the amendment reflects that an opposition was filed by Sullivan: "Sullivan alleges that the request and entry of the Bingel amendment is improvident due to 35 U.S.C. § 135(b) and 37 C.F.R. § 1.56."... On this record, we cannot conclude that the Board's actions in redeclaring the interference were arbitrary, capricious, an abuse of discretion, unsupported by substantial evidence, or otherwise not in accordance with law.¹⁶⁵

Comments

The jurisdictional issues in Sullivan seem clearly to lack merit. For the reasons concisely set forth by the court, the Federal Circuit clearly had jurisdiction to determine

¹⁶⁵ 365 F.3d at 1326-27, 70 USPQ2d at 1147-48 (footnote omitted).

whether or not the board had jurisdiction. Since *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997), had been decided well before the interference between Sullivan and Bingel was declared, the examiner also could have made a determination on the 35 USC 135(b) issue and perhaps avoided an interference. However, the examiner instead took steps to initiate the interference. The board certainly had jurisdiction to declare the interference under 35 USC 135(a), and, as the court explained, the board also had discretion to sua sponte issue an order to show cause to Sullivan prior to addressing either the patentability motion or the 135(b) motion.

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XIII. POST INTERFERENCE PRACTICE

Nothing relevant this year.

XIV. RELATIONSHIP OF INTERFERENCE
PROCEEDINGS TO COURT PROCEEDINGS

Nothing relevant this year.

XV. CONCLUSION

The trial section of the Board continued during 2004 its practice of providing in both precedential and non-precedential opinions, its views on the “old” rules, most of which will presumably be valid under the “new” interference rules. With the exception of its opinion in *Stevens v. Tamai*, the Federal Circuit’s opinions were mostly incidentally related to interference practice. The “written description” opinions arguably fit into the view that the court’s panels form a dichotomy adhering to a strict “written description” test and a less sharply defined “possession” test for compliance with the written description requirement. The *Stevens* case leaves one wondering whether the board and the court fail to see the forest for the trees, particularly in view of the board’s opinion in *Harris*. Was the facially well-reasoned opinion of the court fundamentally flawed in its result because of a fundamental error on the part of the board in declaring the interference and failing to accord the proper filing date to *Tamai*’s national stage application?