

Not binding precedent of the Board.

Paper 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

WILLIAM ROHR,

Junior Party,
(Patent 6,143,232)¹,

v.

DONALD E. McNULTY and TODD SMITH,

Senior Party
(Application 09/328,080)².

Patent Interference 104,804 (Nagumo)

DECISION ON McNULTY REQUEST FOR RECONSIDERATION

Before: LEE, SPIEGEL, and NAGUMO, Administrative Patent Judges.
NAGUMO, Administrative Patent Judge.

Introduction

McNulty requests reconsideration of that part of a panel decision (Paper No. 36) dismissing without prejudice McNulty's preliminary motion 2 to add claims corresponding to the count to its application. The decision has been reconsidered, but relief from that decision is *denied*.

¹ Accorded benefit for priority of the filing date of its application, 09/361,210, July 29, 1999. According to Rohr, the real party in interest is Zimmer Technologies, Inc.

² Accorded benefit for priority of application 60/088,729, filed June 10, 1998. According to McNulty, the real party in interest is DuPuy Orthopaedics, Inc.

McNulty's Request

1. McNulty argues that it has complied with the requirements set out in 37 C.F.R. § 1.637(c)(2) for its motion under 37 C.F.R. § 1.633(c)(2), and is therefore entitled under the rules to the relief requested. (Paper 38 at 1.)

2. McNulty argues further the rules, "which are substantive rules promulgated under the notice and hearing requirements of the Administrative Procedure Act, 5 USC 701 et seq.," are binding on the Board and the public. (*Id.*)

3. McNulty reasons that, in promulgating the rule, "[t]he Commissioner must have intended motions under 37 CFR 1.633(c)(2) to 'materially advance the resolution of this interference,' or the rule would not exist." The board's recourse, according to McNulty, is to seek a rule change, not to deny "a proper motion for reasons not contemplated by the rules." (*Id.* at 2.)

4. Finally, McNulty urges that it seeks a complete judgment from the Board that authorizes "the issuance of a patent to McNulty containing the claims to which motion No. 2 is directed. 37 CFR 1.633(c)(2) contemplates just such a result." (*Id.*) McNulty urges that its ability to present the claims to the examiner after the interference [assuming McNulty emerges as the prior inventor] may greatly extend its quest for a patent,

and thus, it has presented good reasons beyond the reasons set forth in the rules for the grant of its motion. (*Id.* at 2-3.)

Discussion

Mere compliance with the terms of a rule does not entitle the movant to the relief sought. *Hillman v. Shyamala*, 55 USPQ2d 1220, 1221 (Bd. Pat. App. & Interf. 2000). Compliance with the terms of 1.637 assures that a motion will not be dismissed for procedural infirmities. In this case, McNulty sought this interference by filing a request for continued examination (RCE), including a set of claims it stated were substantially copied from Rohr's U.S. Patent No. 6,143,232, together with a request for a declaration of interference. (McNulty involved application, Paper No. 13, filed June 4, 2001.) Additional claims could have been submitted at that time. This is not a case in which an applicant was haled into an interference without advance knowledge of precisely what subject matter would be at stake. Moreover, to the extent that McNulty's preliminary motion 2 is responsive to Rohr's preliminary motion 2 for judgment based on prior art (see McNulty's preliminary motion 2, Paper No. 25 at 2, first sentence), we note our denial of Rohr's motion has removed that basis for relief. McNulty has not established that it needs the additional claims in its case for

its priority contest vis-à-vis Rohr, or that it has been disadvantaged in that contest by our dismissal of its motion.

The interference rules were promulgated under 35 U.S.C. § 6 (1984). 37 C.F.R. Part 1, subpart E. Former³ section 6 did not provide substantive rulemaking authority. *E.g.*, *Merck v. Kessler*, 80 F.3d 1543, 1549-50, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996). In any event, the particular rule under which McNulty seeks relief is clearly procedural in nature, as it expressly permits a party to move to add claims corresponding to the count to its application. Denying McNulty's motion does not deny any substantive right to McNulty: it merely postpones the time when McNulty may seek patent protection for certain subject matter.

McNulty has not advanced a persuasive reason to increase the complexity, time, and expense of this *inter partes* proceeding to the parties and to the board by adjudicating its additional claims. Thus, in our judgment, the general mandate that "[t]his subpart shall be construed to secure the just, speedy, and inexpensive determination of every interference" (37 C.F.R. § 1.601) is better met by dismissing McNulty's motion, without prejudice, than by granting it. Accordingly, we have exercised our discretion to maximize the efficient use of the limited

³ Former section 6 has been recodified at 35 U.S.C. § 2(b)(2)(A) (1999): "The Office * * * may establish regulations, not inconsistent with law, which shall govern to conduct of proceedings in the Office . . .".

resources of the Director in this particular case by leaving the examination of original claims where it is done best, before the examiner.

The job of the examining corps is to examine claims in applications for patent in the first instance. With experience, an examiner gains a greater familiarity and depth of knowledge of the art he or she examines than, except by coincidence, an administrative patent judge happens to have. We do not subscribe to McNulty's parade of horrible potentialities allegedly associated with *ex parte* prosecution. McNulty has not substantiated its fears by directing our attention to any facts in the prosecution record. Nor has McNulty shown that it will be prejudiced by our decision. Should McNulty be determined to be the first inventor at the conclusion of the priority phase of this interference, nothing will prevent it from seeking further patent protection of its invention.

Order

Upon reconsideration of the decision on motions (Paper No. 36), it is:

ORDERED that McNulty's request for relief from the decision is *denied*.

JAMESON LEE)	
Administrative Patent Judge)	BOARD OF PATENT
)	APPEALS AND
CAROL A. SPIEGEL)	INTERFERENCES
Administrative Patent Judge)	
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