The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 23

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ROBERT C. ROSE, WILLIAM BONNEZ
and RICHARD C. REICHMAN,

Junior Party,
(Application 08/207,309)

v.

IAN FRAZER and JIAN ZHOU,

Senior Party.
(Application 08/185,928)

Patent Interference 104,773 (McK)

Before: McKELVEY, Senior Administrative Patent Judge, and TORCZON and MEDLEY, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge,

MEMORANDUM OPINION and ORDER

Frazer has filed FRAZER MISCELLANEOUS MOTION 1 (Paper 18) seeking leave to file FRAZER CORRECTED PRELIMINARY STATEMENT (Paper 19). The motion is denied without prejudice.

A. Background

This interference (Interference 104,773) is one of six interferences which replaced now administratively terminated

Interference 103,929, Rose v. Lowy v. Schlegel v. Frazer. In Interference 103,929, Frazer had filed a preliminary statement ('929 preliminary statement) in which it alleged, inter alia, derivation by all opponents. The '929 preliminary statement alleges that communication took place "on July 20 to 26, 1991".

After this interference was declared, the parties were directed to file a copy of the '929 preliminary statement. The '929 preliminary statement was to serve as the preliminary statement in this interference. Frazer now seeks leave to file a preliminary statement in this interference which alleges that communication took place "on July 20, 1991" (Paper 19, Part II, ¶ (6) on page 5).

Since Frazer's opponent would not consent to the relief requested, prior to filing its miscellaneous motion, Frazer initiated a telephone conference call to discuss the motion (Paper 18, page 6, ¶ 15). During the conference call, the board made several inquiries, including (1) Why is the amendment to the preliminary statement needed? and (2) How can an opponent be prejudiced by the amendment sought to be made?

Frazer apparently believes that the '929 preliminary statement should be corrected because:

(1) Rule 629(a) [37 CFR § 1.629(a)] states that "doubts as to the definiteness or sufficiency of any allegation in a preliminary ... will be resolved against the party filing the statement by restricting the party ... to the latest date of a period alleged in the preliminary statement" (emphasis added) and

(2) "[t]here is evidently some uncertainty as to whether this rule [, i.e., Rule 629(a),] applies to allegations of derivation made in preliminary statements" (Paper 19, page 11).

Rule 629(a) provides (emphasis added):

> A party shall be strictly held to any date alleged in the preliminary statement. Doubts as to definiteness or sufficiency of any allegation in a preliminary statement or compliance with formal requirements will be resolved against the party filing the statement by restricting the party to its effective filing date or to the latest date of a period alleged in the preliminary statement, <u>as may be appropriate</u>. A party may not correct a preliminary statement except as provided by § 1.628.

In the Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48439 (col. 1) (Dec. 12, 1984), the USPTO stated:

> A preliminary statement serves several useful purposes in an interference: (1) it serves to limit a party's proofs as to time, (2) it serves as a vehicle for permitting the *** [administrative patent judge] or the Board to issue orders to show cause in those cases where it would be futile to take testimony, and (3) it serves as notice to an opponent of the case which is alleged by a party.

Under Rule 629(a), a party alleging a conception in "March 1991" will have its date of conception restricted to 31 March 1991. It would not be "appropriate" within the meaning of Rule 629(a) for the party to be entitled to a date of conception prior to 31 March 1991. Thus, the party would not be entitled to a

date of conception prior to 31 March 1991 even if the proofs establish a conception on 28 February 1991.

Likewise, a party alleging an actual reduction to practice in "1991" will have its actual reduction to practice date restricted to 31 December 1991. It would not be "appropriate" within the meaning of Rule 629(a) for the party to be entitled to an actual reduction to practice date prior to 31 December 1991. Thus, the party would not be entitled to an actual reduction to practice date prior to 31 December 1991, even if the proofs establish an actual reduction to practice on 1 November 1991.

Finally, a party alleging diligence beginning "around 1 June 1991" or "on or about 1 June 1991" will have its date of beginning of diligence restricted to 1 June 1991. It would not be "appropriate" within the meaning of Rule 629(a) for the party to be entitled to a date of beginning of diligence prior to 1 June 1991 even through 29 May 1991 might be considered to be "around" 1 June 1991.

For the purpose of deciding Frazer's motion, we will assume the facts set out therein to be true. We do not feel, on those facts, that an allegation of "communication" "on July 20 to 26, 1991" in connection with an assertion of derivation is indefinite or insufficient. In other words, we do not believe it would be "appropriate" within the meaning of Rule 629(a) to limit Frazer to a communication date of no earlier than 26 July 1991.

According to Frazer, a "Papillomavirus Workshop" took place in Seattle, Washington, from 20 July 1991 to 26 July 1991.

A "Book of Abstracts" is said to have been distributed on 20 July 1991. One abstract (the "Zhou abstract") is said to contain an enabling description of the invention involved in the interference.[1] Frazer's opponent is said to be named in a "list of attendees" to the workshop. What Frazer alleges is that a communication took place during the Workshop sometime between 20 July and 26 July 1991, apparently on the supposition that the opponent obtained the "Book of Abstract" on 20 January 1991 and that the opponent read the "Zhou abstract" on the same day. Obviously, Frazer will be under a burden to establish the precise date when communication actually took place. That (1) Frazer's opponent was scheduled to present at the workshop and (2) a Book of Abstracts was distributed at the workshop does not establish (a) whether Frazer's opponent was in attendance at the workshop, (b) when, if ever, the opponent received a copy of the Book of Abstracts or (c) when the opponent may have first read the Zhou abstract.

The "July 20 to 26" allegation in the '929 preliminary statement is sufficient notice to Frazer's opponent of when communication is said to have taken place. No amendment to the '929 preliminary statement is necessary in this case at this time. We will deny Frazer Miscellaneous Motion 1 without prejudice. In the future, should Frazer or Frazer's opponent believe that it has suffered actual prejudice as a result of the

[1] Zhou and Frazer are named as joint inventors in the involved Frazer application.

events discussed herein, the board will entertain a further motion seeking appropriate relief.

B. Order

Upon consideration of Frazer Miscellaneous Motion 1 (Paper 18), and for the reasons given, it is

ORDERED that the motion is denied without prejudice to renewal as indicated herein.

_____ FRED E. McKELVEY, Senior Administrative Patent Judge	)
_____ RICHARD TORCZON Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
_____ SALLY C. MEDLEY Administrative Patent Judge	)

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