

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 18

Filed by: Trial Section Motions Panel
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ELI LILLY AND COMPANY,

Junior Party,
(U.S. Patent 5,688,796),
v.

KIMBERLY O. CAMERON, PAUL DA SILVA-JARDINE, ERIC R. LARSON,
JAMES R. HAUSKE and ROBERT L. ROSATI

Senior Party
(Application 08/628,605).

Patent Interference No. 104,104 (MPT)

Before: McKELVEY, Senior Administrative Patent Judge, and LEE and TIERNEY,
Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

JUDGMENT

(Pursuant to 37 CFR § 1.662(a))

Lilly abandons the contest and has requested entry of adverse judgment. (Eli Lilly Abandonment of Contest, Paper No. 17). Lilly attempts, however, to characterize and limit the affect of their request for adverse judgment. Specifically, Lilly states that:

The compounds and methods encompassed by the count are not commercially significant to Lilly. Therefore, Lilly abandons the contest pursuant to 37 C.F.R. § 1.662(a).

This abandonment of the contest is not an admission that Lilly agrees with the proposed count, the designation of the claims or even the patentability of Cameron's claims to Cameron. Further, Lilly reserves the right to rely upon activity that qualifies as prior art under 35 U.S.C. § 102(g) to defend against an action by Cameron of any other party.

In view of the above, Lilly requests entry of adverse judgment against Lilly as to all claims which correspond to the count.

(Paper No. 17, p. 2, bold emphasis added).

Regardless of Lilly's characterization of their request for adverse judgment, Lilly is subject to the provisions of 37 C.F.R. § 1.658(c). Specifically, section 658(c) provides that:

A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under § 1.633 (a) through (d) and (f) through (j) or §1.634, and (3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). A losing party who could have properly moved, but failed to move, under § 1.633 or 1.634, shall be estopped to take ex parte or inter partes action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move, except that a losing party shall not be estopped with respect to any claims which correspond, or properly could have corresponded, to a count as to which that party was awarded a favorable judgment.

37 C.F.R. § 1.658(c)(emphasis added). Additionally, Lilly is reminded of their obligation under 37 C.F.R. § 1.56 to disclose information, including this judgment, that is material to the patentability with respect to pending claims in other applications under consideration before the United States Patent & Trademark Office.

Lilly's bolded statements have been accorded no weight and have no bearing upon our decision to enter final judgment. Lilly's reasons for voluntarily requesting adverse judgment are irrelevant to the entry of adverse judgment. Entry of an adverse judgment in an interference is a final judgment on the merits. Judgment is entered without reservation.

Should a party believe that we have "misapprehended" Lilly's request for adverse judgment, that party may file a request for reconsideration under 37 C.F.R. § 1.658(b).

It is:

ORDERED that judgment on priority to Count 1 (Notice Declaring Interference, Paper No. 1, page 5), the sole count in the interference, is awarded against Junior Party Lilly.

FURTHER ORDERED that Junior Party Lilly is not entitled to a patent containing claims 1-13 of Lilly's U.S. Patent No. 5,688,796.

FURTHER ORDERED that a copy of this final decision shall be placed and given a paper number in the file of Cameron, U.S. Application No. 08/628,605 and Lilly's U.S. Patent No. 5,688,796.

FRED E. McKELVEY)	
Senior Administrative Patent Judge)	
)	
JAMESON LEE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
MICHAEL P. TIERNEY)	
Administrative Patent Judge)	