THIS DOCUMENT IS BINDING PRECEDENT OF THE TRIAL SECTION

Paper 41

Filed by: Trial Section
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GLAXO WELLCOME INC.

Junior Party
(Patents 5,545,403, 5,545,404,
and 5,545,405)

v.

SHMUEL CABILLY,
HERBERT L. HEYNEKER, WILLIAM E. HOLMES,
ARTHUR D. RIGGS, and RONALD B. WETZEL

Senior Party
(Application 08/909,611)

Patent Interference No. 104,532

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE, TORCZON, GARDNER-LANE, and MEDLEY, Administrative Patent Judges.

PER CURIAM.

ORDER MAKING ORDER PRECEDENTIAL

Upon consideration of the record in this interference, it is

ORDERED that the ORDER DENYING GLAXO WELLCOME INC. MISCELLANEOUS MOTION 1 (Paper 39) is made precedential;

FURTHER ORDERED that lines 1-2 of page 1 of the ORDER (Paper 39) reading "THIS DOCUMENT WAS NOT WRITTEN FOR PUBLICATION and is not binding precedent of the Board" be amended to read "The opinion in support of the decision being entered today is binding precedent of the Trial Section."

_____	
FRED E. McKELVEY, Senior	
Administrative Patent Judge	
_____	
RICHARD E. SCHAFER	
Administrative Patent Judge	
_____	
JAMESON LEE	TRIAL SECTION
Administrative Patent Judge	
	BOARD OF PATENT
	APPEALS AND
_____	INTERFERENCES
RICHARD TORCZON	
Administrative Patent Judge	
_____	
SALLY GARDNER-LANE	
Administrative Patent Judge	
_____	
SALLY C. MEDLEY	
Administrative Patent Judge	

cc (via facsimile and first class mail):

Counsel for Glaxo Wellcome, Inc.:

Gerald M. Murphy, Jr.
Raymond C. Stewart
BIRCH, STEWART, KOLASCH, & BIRCH, LLP
8110 Gatehouse Rd., Ste. 500 East
Falls Church, Va. 22042

Tel: 703-205-8000
Fax: 703-205-8050 or 8060

Counsel for Cabilly (real party in interest, Genentech, Inc.):

Steven B. Kelber
PIPER, MARBURY, RUDNICK & WOLFE, LLP
1200 Nineteenth St., N.W.
Washington, D.C. 20036-2430

Tel: 202-861-3900
Fax: 202-223-2085

THIS DOCUMENT WAS NOT WRITTEN FOR PUBLICATION
and is not binding precedent of the Board

Paper 39

Filed by: Sally Gardner-Lane
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GLAXO WELLCOME INC.

Junior Party
(Patents 5,545,403, 5,545,404,
and 5,545,405)

v.

SHMUEL CABILLY,
HERBERT L. HEYNEKER, WILLIAM E. HOLMES,
ARTHUR D. RIGGS, and RONALD B. WETZEL

Senior Party
(Application 08/909,611)

Patent Interference No. 104,532

ORDER
DENYING GLAXO WELLCOME INC. MISCELLANEOUS MOTION 1

Background

On 28 September 2000, Glaxo Wellcome Inc. ("Glaxo") filed a paper entitled "GLAXO WELLCOME INC.'S MISCELLANEOUS MOTION 1"

(Paper 33). Glaxo moves for leave to take additional discovery to support preliminary motions seeking judgment against Cabilly on the basis that Cabilly claims corresponding to the count are unpatentable for failing to meet the enablement or written description requirement of 35 USC § 112, ¶ 1.

According to Glaxo, during the prosecution of the Cabilly application the examiner rejected claims of the Cabilly application based on 35 USC § 112, ¶ 1, but later withdrew the rejection after submission of a declaration ("the Ridgeway declaration") and two interviews with counsel for Cabilly. Glaxo states that the Ridgeway declaration "appears in the prosecution history of the Cabilly application to have been the sole factual basis upon which the attorneys for Cabilly and Genentech overcame the [35 USC § 112, ¶ 1] rejections that the Examiner had advanced." It is Glaxo's position that the Ridgeway declaration provides inadequate details to allow Glaxo to prepare its preliminary motion for judgment. (Paper 33 at 2-3). Glaxo requests additional discovery, including testimony from Mr. Ridgeway and information relating to the interviews involving the examiner and Cabilly counsel. (Paper 33 at 3).

Discussion

Glaxo seems to be under the impression that it must address or rebut the Ridgeway declaration in its preliminary motion for

judgment since it apparently believes that the examiner relied on the declaration in support of a decision to withdraw the 35 USC § 112, ¶ 1, rejections. However, neither the Board nor Glaxo is bound by an ex parte decision of the examiner made during prosecution of the involved Cabilly application. Compare Switzer v. Sockman, 333 F.2d 935, 942, 142 USPQ 226, 232 (CCPA 1964) and Sze v. Bloch, 458 F.2d 137, 141, 173 USPQ 498, 501 (CCPA 1972). When considering a preliminary motion for judgment, such as the one Glaxo says it intends to file, the Board looks solely to the evidence in the interference. The Ridgeway declaration has not been placed in evidence in the interference. Any discussion at the interviews involving the examiner and Cabilly counsel is not likely to be relevant, and in any event has not been placed in evidence.

Glaxo has the burden of proving unpatentability vel non of Cabilly's claims. 37 CFR § 1.637(a). To prove unpatentability, Glaxo must file a preliminary motion under 37 CFR § 1.633(a). A preliminary motion under Rule 633(a) is not an appeal from an examiner's decision to allow a claim. Rather, it is an independent request to the Board for entry of judgment against a party. In rendering a decision on a preliminary motion for judgment, the Board is not compelled to defer to an examiner's decision to allow a claim. If Cabilly relies on the Ridgeway declaration in opposing any Glaxo preliminary motion for

judgment, Glaxo will have an opportunity to cross-examine Mr. Ridgeway.

The discovery requested by Glaxo does not appear to be necessary for Glaxo to support its preliminary motions for judgment. Hence, it would impose an unnecessary expense on Cabilly that would be inconsistent with a just, speedy, and inexpensive resolution of the interference. 37 CFR § 1.601. Accordingly, Glaxo has not shown that the interest of justice requires the requested discovery.

Order

Upon consideration of the record of the interference, it is

ORDERED that Glaxo miscellaneous motion 1 to take additional discovery is DENIED.

_____
Sally Gardner-Lane
Administrative Patent Judge

18 October 2000
Arlington, Va.

cc (via facsimile and first class mail):

Counsel for Glaxo Wellcome, Inc.:

Gerald M. Murphy, Jr.
Raymond C. Stewart
BIRCH, STEWART, KOLASCH, & BIRCH, LLP
8110 Gatehouse Rd., Ste. 500 East
Falls Church, Va. 22042

Tel: 703-205-8000
Fax: 703-205-8050 or 8060

Counsel for Cabilly (real party in interest, Genentech, Inc.):

Steven B. Kelber
PIPER, MARBURY, RUDNICK & WOLFE, LLP
1200 Nineteenth St., N.W.
Washington, D.C. 20036-2430

Tel: 202-861-3900
Fax: 202-223-2085