Paper 73

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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 GARDNER-LANE and MEDLEY, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge

MEMORANDUM OPINION and ORDER
(Decision on motion in limine)

Pending before the panel is ROSE MOTION IN LIMINE TO EXCLUDE FRAZER EXHIBITS (Paper 62).[1]

[1] The style of the motion fails to comply with the requirements of § 25 of the STANDING ORDER (Paper 2), which requires, inter alia, that "[a]ll motions, including Rule 633 preliminary motions, of a party shall be consecutively numbered starting with number 1." An appropriate style, given that it is Rose's eighth motion, would have been

ROSE MISCELLANEOUS MOTION 8
(Motion in limine to exclude evidence)

Rose seeks a ruling on the admissibility of (1) Ex 1026[2] (a declaration of Dr. Jian Zhou), (2) Ex 1027 (a photocopy of a micrograph), (3) ¶ 26 of a declaration of Dr. Margaret A. Stanley (Ex 1029) and (4) ¶ 24 of a declaration of Dr. Kathrin Jansen (Ex 1041).

I.
Exhibit 1026

A. Findings of fact

1. Exhibit 1026 is a declaration of Dr. Jian Zhou.

2. The Zhou declaration is dated 03/20/98, which we take to mean 20 March 1998.

3. On or about 30 March 1998, the Zhou declaration was initially served by Frazer on Rose in Interference 103,929 as an exhibit in support of a preliminary motion filed in that interference.

4. Interference 103,929 was administratively terminated on 17 October 2001 without a decision on preliminary motions.

5. This, and five other interferences, were declared in place of administratively terminated Interference 103,929.

6. During the preliminary motions period of this interference, Frazer again served the Zhou declaration (Ex 1026).

7. The parties agree that Dr. Zhou died, Rose telling us that death occurred in March of 1999.

[2] Exhibits numbered in the 1000's are Frazer Exhibits. Exhibits numbered in the 4000's are Rose Exhibits.

8. In administratively terminated Interference 103,929, Rose did not have an opportunity to cross-examine Dr. Zhou before his death.

9. According to the Zhou declaration:

a. Dr. Zhou is "the first-named author" of a "paper" identified as Zhou et al., "Expression of Vaccinia Recombinant HPV 16 L1 and L2 ORF Proteins in Epithelial Cells Is Sufficient for Assembly of HPV Virion-like Particles," 185 Virology 251-257 (1991) (Ex 4045).

b. Dr. Zhou tells us that he "was involved in the preparation of the electron micrographs shown in this paper".

c. Dr. Zhou further tells us that "[t]he electron micrograph submitted as *** Exhibit 1027 is the electron micrograph shown as the inset in Figure 5 of the Zhou et al. paper".

B. Discussion

To the extent that the Zhou declaration is being offered to prove the truth of statements contained therein, it is inadmissible as hearsay.[3]

Based on Fed. R. Evid. 804(b)(1), Frazer maintains that the Zhou declaration is not hearsay. Fed. R. Evid. 804(b)(1):

> The following are not excluded by the hearsay rule if the declarant is unavailable as a witness:

[3] "Hearsay" is a statement, other than one made by the declarant while testifying at the trial or hearing, offered in evidence to prove the truth of the matter asserted. Fed. R. Evid. 801(c). A "statement" includes a written assertion of a person, if it is intended by the person as an assertion. Fed. R. Evid. 801(a).

> (1) **Former testimony.** Testimony given as a witness at another hearing of the same or a different proceeding, or in a deposition taken in compliance with law in the course of the same or another proceeding, if the party against whom the testimony is now offered, or, in a civil action or proceeding, a predecessor in interest, had an opportunity and similar motive to develop the testimony by direct, cross, or redirect examination.

Frazer argues that Rose had an opportunity to cross-examine Dr. Zhou in administratively terminated Interference 103,929. While superficially plausible, Frazer's argument cannot withstand penetrating analysis.

An opponent (Rose in this case) has a right to cross-examine the affidavit testimony of any witness relied upon by a party (Frazer in this case) in an interference. It is true that Frazer presented the Zhou declaration during the preliminary motion phase of Interference 103,929. However, in that interference, a time period for taking cross-examination had not been set or authorized.

In October 1998, the Chief Administrative Patent Judge established the Trial Section within the Interference Division of the board. Notice of the Chief Administrative Patent Judge of Nov. 6, 1998, "Interference Practice--New Procedures for Handling Interference Cases at the Board of Patent Appeals and Interferences," 1217 Off. Gaz. Pat. & Tm. Office 18 (Dec. 1, 1998).

The Zhou declaration was initially served prior to creation of the Trial Section. In interferences declared prior to creation of the Trial Section, a preliminary motions phase of an interference normally did not include a time within which an opponent could request an opportunity to cross-examine an affiant relied upon by a party in connection with the preliminary motion. Accordingly, generally preliminary motions were decided by a single judge prior to cross-examination of affiants. If during the "testimony" period, generally set after a decision on preliminary motions, an opponent desired cross-examination of an affiant relied upon by a party, cross-examination could be undertaken as a matter of right. If cross-examination produced meaningful evidence, an opponent could ask for a decision on a preliminary motion to be reviewed by a 3-judge panel at final hearing in light of the "new evidence" in the form of cross-examination. In Interference 103,929, a testimony period was never set. Hence, Rose never had an opportunity as a matter of right to cross-examine Dr. Zhou because a decision on preliminary motions was never entered prior to termination of the interference.

One of the changes made by the Trial Section was to authorize cross-examination of a party's affiant prior to the time an opponent had to oppose any motion relying on the affiant's testimony. As applied to a party's preliminary motion, an opponent was given a right to cross-examine prior to filing an opposition to the preliminary motion. Indeed, failure to cross-

examine constitutes waiver of a right to cross-examine. Creation of the Trial Section and implementation of its procedures changed the timing for taking cross-examination. Moreover, contested preliminary motions in Trial Section-declared interferences are generally decided by a 3-judge panel. A decision on preliminary motions by a 3-judge motions panel governs further proceedings in the interference and any request for review at final hearing amounts to a request for reconsideration. No further evidence related to the preliminary motion, including additional cross-examination, is authorized or permitted after a decision on preliminary motions.

Frazer, relying on 37 CFR § 1.639(c), also maintains that Rose could have asked for leave to take cross-examination prior to any "testimony" period which might have been set. We agree that theoretically Rose could have moved to take cross-examination, but it is highly unlikely that it would have been granted.

Rule 639(c) talks in terms of "evidence in the form of testimony that is unavailable to the party ***". Evidence, in the form of cross-examination of Dr. Zhou, would have been available to Rose during the "testimony" period which would have been set after a decision on preliminary motions. Even if Rule 639(c) could be construed to permit Rose to cross-examine Dr. Zhou, it is unlikely that any motion to take cross-examination would have been granted. Rather, in pre-Trial Section-declared interferences, the board would have decided

preliminary motions prior to authorizing what then would have been regarded as premature cross-examination.

Lastly, we would observe that cross-examination is a fundamental right in interferences. Rose would have had an opportunity as a matter of right to cross-examine Dr. Zhou during a "testimony" period. However, Rose had no right to do so under Rule 639(c).

In reaching our decision, we have not overlooked Frazer's arguments based on Fed. R. Civ. P. 32(a)(3)(A) and court opinions interpreting that rule. First, Fed. R. Civ. P. 32(a)(3)(A) does not apply to interference proceedings. Second, the rule deals with depositions, not trial testimony. No discovery deposition was authorized in either this interference or terminated Interference 103,929. The Zhou declaration is not a discovery deposition; rather, it is "direct" testimony in an interference. Cross-examination of direct testimony takes place in an interference when a time is set for cross-examination. Third, we can agree that Dr. Zhou's untimely death is not the "fault" of Frazer. However, Rose had a right to cross-examine and death has prevented cross-examination.

Exhibit 1026, the Zhou declaration, is excluded from evidence.

II.
Exhibit 1027

A. Findings of fact

1. According to Frazer, Exhibit 1027 is a photocopy of a "micrograph" referred to in the Zhou declaration. See Part (I)(A)(9)(b) & (c), supra, where Dr. Zhou tells us that he "was involved in the preparation of the electron micrographs shown in *** [his] paper" and that "[t]he electron micrograph submitted as *** Exhibit 1027 is the electron micrograph shown as the inset in Figure 5 of the Zhou et al. paper".

2. According to Rose, Ex 1027 is not admissible because it has not been authenticated except through Dr. Zhou's excluded hearsay.

3. Frazer responds with a declaration of Dr. Xiao Yi Sun (Ex 1109).

4. Rose has cross-examined Dr. Sun (Ex 4073).

5. Based on (1) the Rose motion (Paper 62), (2) the Frazer opposition (Paper 67), (3) the Rose reply (Paper 68), (4) the Sun declaration (Ex 1109) and (5) the Sun cross-examination (Ex 4073),[4] the following becomes manifest:

b. Dr. Sun is the widow of Dr. Zhou (Paper 67, page 5, ¶ 14; Paper 68, page 2, ¶¶ 11-14).

c. Dr. Sun is a second named co-author of the "paper" identified earlier as Zhou et al., "Expression of Vaccinia Recombinant HPV 16 L1 and L2 ORF Proteins in Epithelial

[4] Ex 4073 constitutes portions of a transcript of Dr. Sun's cross-examination deposition.

Cells Is Sufficient for Assembly of HPV Virion-like Particles," 185 Virology 251-257 (1991) (Ex 4045).

d. Dr. Sun "was involved in the experimental work described in that paper" (Ex 1109, page 1, ¶ 3).

e. According to Dr. Sun (Ex 1109, page 1, ¶ 5):

> I agree with the statement in paragraph 2 of Dr. Zhou's *** [d]eclaration [Ex 1026] that the electron micrograph *** [Ex] 1027 *** is the electron micrograph shown as an inset to Figure 5 of Zhou 1991 [Ex 4045].

f. Further according to Dr. Sun (Ex 1109, page 2, ¶ 8):

> The electron micrograph image of the inset of Figure 5 is taken from the center of *** [Ex] 1027, which is a larger electron micrograph image.

6. Rose, based on cross-examination, makes the following points:

a. Ex 1027 is "not a micrograph, but a photocopy of something" (Paper 68, page 3, ¶ 5).

b. At the time she signed her declaration (Ex 1109), Dr. Sun had not compared Ex 1027 to any original micrograph (Ex 4073, page 20:11-15).

c. Dr. Sun did not prepare the original micrograph (Ex 4073, page 16:17:19).

d. The current whereabouts of the original micrograph apparently remains a mystery (Paper 68, page 3, ¶ 7).

7. During her cross-examination deposition, Dr. Sun testified that "I did have a good photocopy myself" (Ex 4073, page 20:17-18). She also testified that she knew who prepared the original micrograph (Ex 4073, page 16:17-19). Dr. Sun also seems to be confident that the particle shown in Ex 1027 is the same particle that was shown in the 1991 Zhou paper (Ex. 4045) (Ex 4073, page 21:05-16).

8. Ex 1027 is a photocopy of an original micrograph.

B. Discussion

According to Fed. R. Evid. 901(a), "[t]he requirement of authentication *** as a condition precedent to admissibility is satisfied by evidence sufficient to support a finding that the matter in question is what its proponents claims." A document may be authenticated by the "[t]estimony of [a] witness with knowledge" stating "that a matter is what it is claimed to be." Fed. R. Evid. 901(b)(1).

In this case, we find that Dr. Sun's testimony to be sufficient to authenticate Ex 1027. Ex 1027, therefore, will not be excluded from evidence.

III.
Parts of Stanley and Jansen testimony

A. Findings of fact

1. Rose claims that the testimony in ¶ 26 of a declaration of Dr. Margaret A. Stanley (Ex 1029) is inadmissible because that testimony is said to be based (at least in part) on the inadmissible hearsay declaration of Dr. Zhou.

2. The testimony sought to be excluded is as follows (matter in ~~strikeout~~ in declaration as filed in Interference 103,929 which has been replaced with matter in **bold** in this interference; matter in [brackets] added) (Ex 1029, page 9):[5]

> Moreover, I have reviewed the declaration of Dr. Jian Zhou of March 20, 1998 (which I am informed was submitted in the instant interference [, i.e., Interference 103,929,] on March 30, 1998) and have reviewed the electron micrograph attached as Exhibit B thereto (the Zhou declaration and its exhibits are ~~attached~~ **submitted** as **Frazer** Exhibit ~~I~~ **1026 & 1027**. This micrograph also corresponds to the VLP shown in Figure 5 of the Frazer priority application and Frazer application. Based on the 50 nm size bar shown at the bottom of the micrograph shown in Exhibit B [, i.e., Ex 1027,] of the Zhou declaration, it is my assessment that the VLP shown measures approximately 45 nm in diameter. Based on this diameter and the regular array of capsomeres shown in this micrograph, the particle is a VLP.

3. Rose also claims that the testimony in ¶ 24 of a declaration of Dr. Kathrin Jansen (Ex 1041) is inadmissible because that testimony is said to be based on the inadmissible hearsay declaration of Dr. Zhou.

4. The Jansen testimony is essentially the same as the Stanley testimony (Ex 1029, ¶ 26; Ex 1041, ¶ 24).

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[5] Some of the exhibits in this interference may contain counsel's handwritten interlineations. Those interlineations were authorized by the board so that exhibit numbers and other identifying information in exhibits filed in Interference 103,929 could be used in this interference and would conform to exhibit numbers in this interference, without the need for re-execution of declarations.

B. Discussion

The admissibility of the Stanley and Jansen testimony is governed by Fed. R. Evid. 703. Rule 703 states that "[t]he facts or data *** upon which an expert bases an opinion or inference may be those *** made known to the expert at *** the hearing. If of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject, the facts or data need not be admissible in evidence in order for the opinion or inference to be admitted."

The record supports a finding that Stanley and Jansen consider Ex 1027 to be a copy of a micrograph and that they reasonably rely on micrographs to form opinions in their field. Accordingly, ¶ 26 of Ex 1029 and ¶ 24 of Ex 1041 will not be excluded from evidence.

According to Rose, Dr. Stanley testified that "I certainly would not measure anything on a photocopy" (Ex 1074, page 209, lines 4-5). Further according to Rose, Dr. Stanley's cross-examination establishes that an expert would not rely on a photocopy of an electron micrograph. Basically, what Rose is arguing is that the testimony of Dr. Stanley is not entitled to much weight, because on cross she allegedly contradicts the basis upon which she gave her direct. The fact (assumed for the purpose of deciding the motion) that the Stanley and Jansen testimony may be entitled to little, if any, weight is not a basis for excluding that testimony from evidence.

IV.
Additional observations

A. Weight to be given admissible evidence

One problem we have had in considering the motion in limine is that we do not know precisely (1) for what purpose each exhibit might be used and (2) the context in which Frazer relies on the exhibits.

While we have not excluded Ex 1027 or portions of Ex 1029 and Ex 1041 from evidence, we here make it clear that we have not determined what weight, if any, will be accorded to any of the exhibits. Ultimately we will determine how much, if any, weight is to be accorded to those exhibits when we enter a decision on preliminary motions. Hence, our determination of admissibility should not be construed as a decision to accord any degree of weight to the exhibits.

B. Exhibit 1027

The board has received a document styled FRAZER SUBMISSION OF FRAZER EXHIBIT 1027 (Paper 71).

Apparently, two versions of Ex 1027 have been used.

A first version is Exhibit B attached to Dr. Zhou's declaration filed in Interference 103,929.

A second version is what Frazer characterizes as a "more legible copy" which has been filed along with the document mentioned above. According to Frazer, the "more legible copy" was served on Rose at a deposition which took place on 8 March 2002.

The board will assume that the second version, i.e., the "more legible copy", will be the copy which is filed when exhibits are filed during TIME PERIOD 8 of the preliminary motion phase of this interference.

V.
Order

Upon consideration of ROSE MOTION IN LIMINE TO EXCLUDE FRAZER EXHIBITS (Paper 62), and for the reasons given, it is

ORDERED that the motion is granted only to the extent that Ex 1026 is excluded from evidence.

FURTHER ORDERED that the motion is otherwise denied.

FRED E. McKELVEY, Senior Administrative Patent Judge	)	
SALLY GARDNER-LANE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
SALLY C. MEDLEY Administrative Patent Judge	)	

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