

**Parts I-A, III-A, III-B and IV of this opinion
are binding precedent of the Trial Section.**

104,283 Paper 73
104,284 Paper 74

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ANDREAS WINTER, FRANK KUEBER, WALTER SPALECK,
HERBERT RIEPL, WOLFGANG A. HERRMANN,
VOLKER DOLLE and JUERGEN ROHRMANN,
Junior Party,
(Patent 5,455,365),

v.

TAKASHI FUJITA, TOSHIHIKO SUGANO and HIDESHI UCHINO,
Senior Party
(Application 08/678,686).

Patent Interference No. 104,283

Entered 16 November 1999
53 USPQ2d 1234

WALTER SPALECK, JUERGEN ROHRMANN and MARTIN ANTBERG,
Junior Party,
(Patent 5,329,033),

v.

TAKASHI FUJITA, TOSHIHIKO SUGANO and HIDESHI UCHINO,
Senior Party
(Application 08/678,686).

Patent Interference No. 104,284

MEMORANDUM IN SUPPORT OF FINAL JUDGMENTS

Before: STONER,¹ Chief Administrative Patent Judge,
McKELVEY, Senior Administrative Patent Judge, and SCHAFER,
LEE² and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Interference 104,283 and Interference 104,284 are before a merits panel for entry of final decisions. Since the issues raised in both interferences are similar, the interferences are consolidated for oral argument and entry of final decisions.

Oral argument was held on 29 September 1999 before Judges McKelvey, Schafer and Torczon. Chief Judge Stoner and Judge Lee have participated in, and join, in Parts I-A, III-A, III-B and IV of this opinion.

Ashley I. Pezzner, Esq. (argued-in-part), and Thomas M. Meshbesh, Esq. (argued-in-part), appeared on behalf of Winter and Spaleck.

Charles L. Gholz, Esq., and Alton D. Rollins, Esq. (argued), appeared on behalf of Fujita.

Oral argument was transcribed by a court reporter. A copy of a transcript of oral argument has been made part of the record in each interference.

¹ Chief Judge Stoner joins in Parts I-A, III-A, III-B and IV of the opinion, all of which are binding precedent of the Trial Section; Chief Judge Stoner otherwise did not participate in deciding these interferences.

² Judge Lee joins in Parts I-A, III-A, III-B and IV of the opinion, all of which are binding precedent of the Trial Section; Judge Lee otherwise did not participate in deciding these interferences.

Findings of fact

The records in Interference 104,283 and Interference 104,284 support, by a preponderance of the evidence, the following findings, as well as those set out in the opinion portion of this memorandum.

Junior party--Interference 104,283

1. The junior party is Andreas Winter, Frank Kueber, Walter Spaleck, Herbert Riepl, Wolfgang A. Herrmann, Volker Dolle and Juergen Rohrmann (**Winter**).³

2. Winter is involved on the basis of its U.S. Patent 5,455,365, granted 3 October 1995, based on application 08/101,408, filed 3 August 1993.

3. The real party in interest is Targor GmbH (**283 Paper** 10).

Junior party--Interference 104,284

4. The junior party in Interference 104,284 is Walter Spaleck, Juergen Rohrmann and Martin Antberg (**Spaleck**).

5. Spaleck is involved in Interference 104,284 on the basis of its U.S. Patent 5,329,033, granted 12 July 1994, based on application 08/142,512, filed 25 October 1993.

6. For the purpose of priority with respect to Count 1 of Interference 104,284, Spaleck has been accorded the

³ A list of abbreviations used in this opinion appears in an Appendix to the opinion. The first use of an abbreviation is in **bold**.

benefit of U.S. application 07/934,573, filed 24 August 1994, now U.S. Patent 5,278,264, granted 11 January 1994.

7. The real party in interest is Targor GmbH
(284 Paper 9).

Senior party--both interferences

8. The senior party in both interferences is Takashi Fujita, Toshihiko Sugano and Hideshi Uchino (**Fujita**).

9. Fujita is involved in both interferences on the basis of its application 08/678,686, filed 11 July 1996.

10. For the purpose of priority with respect to Count 1 of Interference 104,283 and Count 1 of Interference 104,284, Fujita has been accorded the benefit of:

- a. U.S. application 07/933,215, filed 20 August 1992, and
- b. Japanese patent application 208213/1991, filed 20 August 1991 (283 Paper 25, page 2; 284 Paper 23, page 2).

11. The real party in interest is Mitsubishi Chemical Corporation (283 Paper 6).

The count and claims of the parties
corresponding to the count--Interference 104,283

12. The sole count in Interference 104,283 is Count 1, which reads (283 Paper 1, page 42):

The metallocene compound according [to] claim 1 of the Winter patent

or

the catalyst according to claim 8 of the Fujita application wherein the methyl or phenyl of the R² (which is selected from the group consisting of methyl-1,3-butadienylene or phenyl-1,3-butadienylene) is attached to the 5-position of any indene ring.

13. The claims of the parties are:

Winter 1-6

Fujita 8-19

14. The claims of the parties which correspond to Count 1 are:

Winter 1-6

Fujita 8-14 and 16

15. The claims of the parties which do not correspond to Count 1 are:

Winter None

Fujita 15 and 17-19

The count and claims of the parties corresponding to the count of Interference 104,284

16. The sole count in Interference 104,284 is Count 1, which reads (284 Paper 1, page 42):

The metallocene compound according [to] claim 1 of the Spaleck patent

or

the catalyst according to claim 8 of the Fujita application wherein the methyl or phenyl of the R² (which is selected from the group consisting of methyl-1,3-butadienylene or phenyl-1,3-butadienylene) is attached to the 4-position of any indene ring.

17. The claims of the parties are:

Spaleck	1-4
Fujita	8-19

18. The claims of the parties which correspond to Count 1 of Interference 104,284 are:

Spaleck	1-4
Fujita	8-13, 15 and 17-18

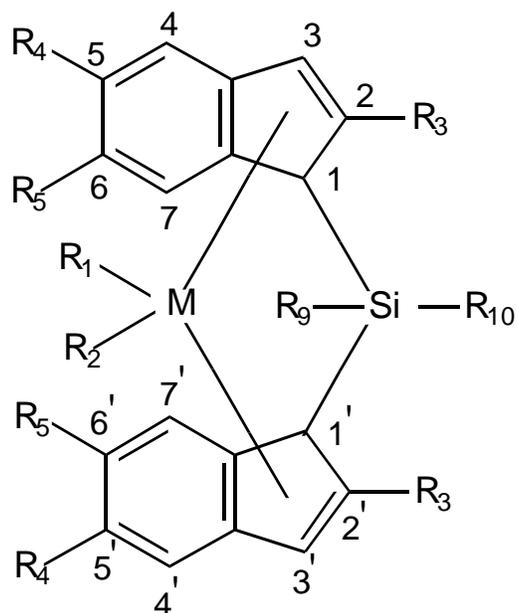
19. The claims of the parties which do not correspond to Count 1 of Interference 104,284 are:

Spaleck	None
Fujita	14, 16 and 19

Metallocenes

20. Metallocenes are compounds which can be used as a component of a catalyst in a process for polymerizing olefins.

21. An example of a metallocene is one having the following formula:



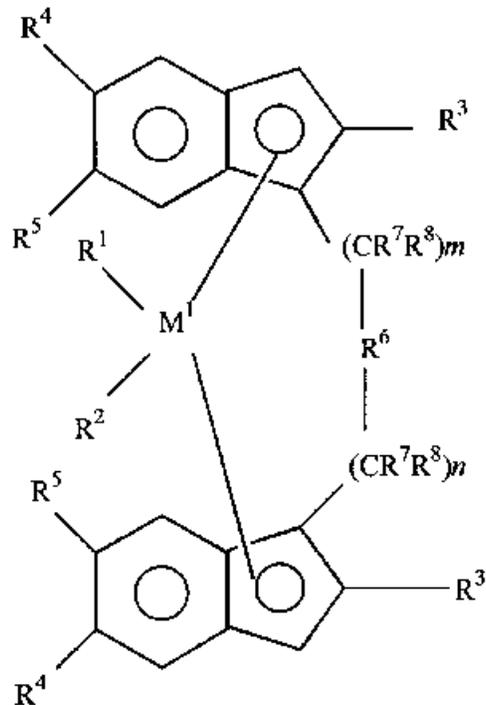
where M is

a metal, such as zirconium (Zr). The R's can be various organic moieties, such as methyl (CH_3).

22. The numbers in the formula identify the positions on the ring structures. The metallocene shown has an R_4 in both the 5 and 5' positions. As will become apparent, the position at which organic moieties are attached to the ring structure is not without significance.

Subject matter claimed by Winter
in Interference 104,283

23. Winter claims metallocene compounds having the formula:



24. Important in Interference 104,283 is the position on the ring and definition of R^4 and R^5 , as well as R^3 .

25. According to Winter claim 1, the broadest Winter claim designated as corresponding to Count 1 of Interference 104,283, R^3 , R^4 and R^5 are defined as follows:

R^3 , R^4 and R^5 are identical or different and R^3 and R^4 and/or R^5 are other than hydrogen and are a C_1 - C_{20} -alkyl group, a C_6 - C_{20} -aryl group, a C_2 - C_{10} -alkenyl group, a C_7 - C_{40} -arylalkyl group, a C_7 - C_{40} -alkylaryl group or a C_8 - C_{40} -arylalkenyl group, these radicals optionally being halogenated, [and]

R^5 may alternatively be hydrogen.

26. In its Preliminary Motion 2, Winter states that (283 Paper 27, page 5):

Winter's claimed metallocenes are directed to a 2,5-substituted indenyl ligand,⁴ a 2,6-substituted indenyl ligand⁵ or a 2,5,6-substituted indenyl ligand⁶ metallocene.

27. According to Winter, the metallocene and a cocatalyst together can be used as a catalyst to polymerize olefins (col. 1, lines 30-55).

28. The cocatalyst can be an aluminoxane (col. 5, lines 33-50).

29. According to Winter (col. 6, lines 34-50):

It is possible to preactivate the metallocene by means of an aluminoxane *** before use in the polymerization reaction.

The preactivation of the transition-metal compound is carried out in solution.

The concentration of the aluminoxane in the solution is in the region of about 1% by weight to the saturation limits, preferably from 5 to 30% by weight, in each case based on the total solution. The metallocene can be employed in the same

⁴ When the R⁵s are hydrogen and the R⁴s are not hydrogen.

⁵ When R⁴s are hydrogen and R⁵s are not hydrogen.

⁶ When none of the R⁴s and R⁵s are hydrogen.

concentration, but is preferably employed in an amount of from 10^{-4} to 1 mol per mole of aluminoxane. The preactivation time is from 5 minutes to 60 hours, preferably from 5 to 60 minutes. The reaction temperature is from -78°C . to 100°C ., preferably from 0°C to 70°C .

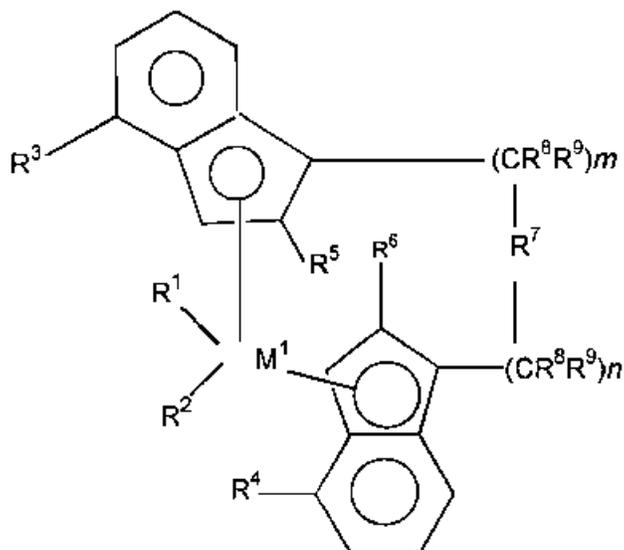
30. Further according to Winter (col. 7, lines 5-10):

When the above mentioned cocatalysts are used, the actual (active) polymerization catalyst comprises the product of the reaction of the metallocene and one of said compounds. This reaction product is therefore prepared first, preferably outside the polymerization reactor, in a separate step using a suitable solvent.

Subject matter claimed by Spaleck
in Interference 104,284

31. Spaleck claims metallocene compounds having the

formula:



32. Important in Interference 104,284 is the position on the ring and definition of R³ and R⁴. According to Spaleck claim 1, the broadest Spaleck claim designated as corresponding to Count 1 of Interference 104,284, R³ and R⁴ are defined as follows:

R³ and R⁴ are identical or different and are a halogen atom, a C₁-C₁₀-alkyl group, which can be halogenated, a C₆-C₁₀-aryl group or an)NR₂¹⁰,)SR¹⁰,)OSiR₃¹⁰,)SiR₃¹⁰ or)PR₂¹⁰ radical, in which R¹⁰ is a halogen atom, a C₁-C₁₀-alkyl group or a C₆-C₁₀-aryl group.

33. Further, according to Spaleck, the metallocene and a cocatalyst can be used to polymerize olefins (col. 2, lines 23-50).

34. The cocatalyst can be an aluminoxane (col. 8, lines 22-41).

35. Spaleck says (col. 8, line 67 through col. 9, line 50):

It is possible for the metallocene to be preactivated with an aluminoxane *** before use in the polymerization reaction.

The preactivation of the transition metal compound is carried out in solution.

The concentration of the aluminoxane in the solution is in the range from about 1% by weight to the saturation limit, preferably from 5 to 30% by weight, in each case based on the total solution. The metallocene can be employed in the same concentration, but it is preferably employed in an amount of 10^{-4} -1 mol per mole of aluminoxane. The preactivation time is 5 minutes to 60 hours, preferably 5 to 60 minutes.

If the above mentioned cocatalysts are used, the actual (active) polymerization catalyst comprises the reaction product of the metallocene and one of the compounds mentioned. This reaction product is therefore preferably prepared first outside the polymerization reactor in a separate step using a suitable solvent ***.

Difference between the Winter and Spaleck metallocenes

36. A significant difference between the metallocenes claimed by Winter and those claimed by Spaleck is the position of moieties on the ring structure. In the case of Winter, R⁴ is located at the 5- and 5'-positions. Spaleck, on the other hand, requires that R³ and R⁴ be at the 4- and 4'-positions.

37. The Winter activated metallocenes are said to produce polyolefins which "preferably have a molecular weight M_w >80,000, in particular >100,000 g/mol, a melting point of <145°C.

and a molecular weight dispersity M_w/M_n #3.5, in particular #2.8" (col. 8, lines 10-12).

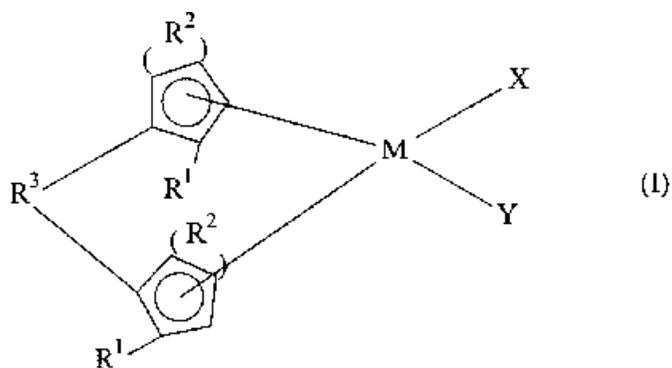
38. The Spaleck patent states (col. 10, lines 41-51):

The process according to the invention is distinguished by the fact that the metallocene catalyst systems described produce polymers having a narrow molecular weight distribution and coarse particle morphology as well as variable molecular weight and stereotacticity in the temperature range between 30E and 80EC., which is of industrial interest, but in particular in the range between 60E and 80EC. The particular polymer molecular weight and stereotacticity desired is established by choosing suitable substituents in the 2- and 4-positions of the ligand system of the metallocene [i.e., the ring portion of the metallocene].

Subject matter claimed by Fujita
in both interferences

39. The Fujita application involved in both interferences contains claims 8-19. Claim 8 is the sole independent claim and reads as follows:

A catalyst useful for the polymerization of olefins, which catalyst comprises a transition metal compound having formula (I)



wherein:

M represents a transition metal selected from the group consisting of titanium, zirconium and hafnium;

two R¹s may be the same or different, and each represents a monovalent hydrocarbyl group having 1 to 4 carbon atoms, or a monovalent hydrocarbyl group having 1 to 4 carbon atoms and containing silicon;

R² is selected from the group consisting of methyl-1,3-butadienylene and phenyl-1,3-butadienylene;

R³ is selected from the group consisting of a methylene group, an ethylene group and a silylene group which may or may not have a substituent of a lower alkyl group; and

X and Y independently represent a member selected from the group consisting of chlorine, lower alkyl and a lower alkyl substituted silyl group,

provided that the two five-membered cyclic ligands each have the substituents R¹ and R² are asymmetric

about a plane containing M when viewed from their relative position in terms of the group R_3 .⁷

40. Fujita claims 14-19 call for specific metallocenes.

41. Fujita claims 14 and 16 call for a methyl group at the 5- and 5'-positions. Accordingly, these claims were designated to correspond to the count in Interference 104,283, but not to the count in Interference 104,284.

42. Fujita claims 15, 17 and 18 call for a methyl or phenyl group in the 4- and 4'-positions. Accordingly, these claims were designated to correspond to the count in Interference 104,284, but not the count in Interference 104,283.

43. Fujita claim 19 calls for a methyl group in both the 4-, 4'-, 7- and 7'-positions. The examiner determined that Fujita claim 19 should be designated as not corresponding to the count in either interference. The examiner's determination is not contested by Winter, Spaleck or Fujita.

44. Fujita claims 8-13 mention a metallocene which is "generic" in the sense that a substituent may appear in either the 4- and 4'- or 5- and 5'-positions. Accordingly, these claims were designated as corresponding to the count in both interferences.

⁷ Perhaps the "provided" paragraph should read: "provided that the two five-membered cyclic ligands each have the substituents R^1 and R^2 **are** asymmetric about a plane containing M when viewed from their relative position in terms of the group R_3 ."

45. According to the specification of the involved Fujita application, the invention "comprises the following component (A) and component (B)" (page 2, lines 22-23).

46. Component (A) is a metallocene (page 2, line 24 et seq.).

47. Component (B) is an aluminoxane (page 3, line 25 et seq.).

48. According to Fujita (page 13, lines 5-9):

The catalyst according to the present invention can be prepared by bringing the above-described component (A) and component (B) into contact with each other in the presence or absence of monomers to be polymerized, inside or outside an autoclave.

49. Further according to Fujita (page 13, lines 29-33):

When the above catalyst system is used for the polymerization of an olefin, the components (A) and (B) may be introduced into a reaction vessel either separately or after being brought into contact with each other.

50. Fujita, acting as its own lexicographer, states in its specification (page 4, lines 16-20):

The expression "comprising component (A) and component (B)" herein means that it is possible to use a third component other than components (A)

and (B) as long as it does not impair the effects of the present invention.⁸

Preliminary and other motions
before the merits panel

51. In their respective preliminary statements, the parties do not allege a conception or actual reduction to practice prior to their filing dates.

52. Winter and Spaleck have filed several preliminary motions.

53. Fujita did not file any preliminary motion.

54. Accordingly, each party is restricted to its filing date subject to an effort by Winter (Preliminary Motion 2) and Spaleck (Preliminary Motion 2) to be accorded the benefit of the filing date of earlier U.S. and German patent application.

55. Hence, a decision on preliminary motions resolves the interferences (283 Paper 25, page 3; 284 Paper 23, page 3; **Tr 7:1-13**).

56. The following preliminary motions and other motions are before the merits panel:

⁸ It would appear that Fujita could have used the language "consisting essentially" in place of defining "comprising" in a manner contrary to its normal meaning. Compare In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963) (the presence of "consisting essentially of" in a composition claim leaves the scope of the claim open only to the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) (definition of comprising, consisting and consisting essentially). See also PPG Industries, Inc. v. Guardian Industries Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-1354 (Fed. Cir. 1998).

(1) Winter Preliminary Motion 1 for judgment based on no interference-in-fact between Winter and Fujita (283 Paper 26). 37 CFR § 1.633(b).

(2) Spaleck Preliminary Motion 1 for judgment based on no interference-in-fact between Spaleck and Fujita (284 Paper 25). 37 CFR § 1.633(b).

(3) Winter Preliminary Motion 2 to be accorded benefit of two prior U.S. patent applications and a German patent application filed 12 November 1990 (283 Paper 27). 37 CFR § 1.633(f).

(4) Spaleck Preliminary Motion 2 to be accorded benefit of two prior U.S. patent applications and a German patent application filed 12 November 1990 (284 Paper 26). 37 CFR § 1.633(f).

(5) Winter Preliminary Motion 3 (283 Paper 28) to add to Interference 104,283, application 09/252,719, filed 19 February 1999 (**Winter 719**) (**WEx** 1001),⁹ to reissue involved Winter U.S. Patent 5,455,365. 37 CFR § 1.633(h).

(6) Spaleck Preliminary Motion 3 (284 Paper 27) to add to Interference 104,284, application 09/253,832, filed

⁹ The serial number (08/101,408) and filing date (August 3, 1993) mentioned on the first page of WEx 1001 are those for the application which matured into the patent sought to be reissued and not the reissue application.

19 February 1999 (**Spaleck 832**) (**SEx 1001**),¹⁰ to reissue involved Spaleck U.S. Patent 5,329,033. 37 CFR § 1.633(h).

(7) Winter Rule 635 motion (283 Paper 56) for leave to file a belated Winter Preliminary Motion 4 to question the enablement of the Fujita application.

(8) Spaleck Rule 635 motion (284 Paper 57) for leave to file a belated preliminary motion to question the enablement of the Fujita application.

(9) Fujita has filed a Rule 635 motion (283 Paper 50) to strike Winter Reply 1 (283 Paper 44). Winter Reply 1 was filed in response to Fujita's opposition to Winter Preliminary Motion 1.

(10) Fujita has filed a Rule 635 motion (284 Paper 51) to strike a Spaleck Reply 1 (284 Paper 44). Spaleck Reply 1 was filed in response to Fujita's opposition to Spaleck Preliminary Motion 1.

(11) Fujita has filed FUJITA MOTION 2, a Rule 635 motion (283 Paper 71; 284 Paper 72) seeking leave to file a declaration of Dr. Tobin Marks (FEx 2010).

¹⁰ The serial number (08/142,512) and filing date (October 25, 1993) mentioned on the first page of SEx 1001 are those for the application which matured into the patent sought to be reissued and not the reissue application.

Interference-in-fact

57. There is no claim in the involved Winter patent which is identical to a claim in the involved Fujita application.

58. There is no claim in the involved Spaleck patent which is identical to a claim in the involved Fujita application.

59. The parties agree that Winter claim 1 is directed to compounds (283 Paper 26, page 3; 283 Paper 32, page 2).

60. The parties agree that Spaleck claim 1 is directed to compounds (284 Paper 25, page 3; 284 Paper 2).

61. The parties do not agree that Fujita claim 8--the sole independent Fujita claim--is directed to a compound.

62. In fact, Winter and Spaleck disagree with Fujita as to the scope and meaning of Fujita claim 8.

63. The parties agree that metallocene compounds have uses other than polymerization catalysts (283 Paper 26, page 3; 283 Paper 32, page 2; 284 Paper 25, page 3; 284 Paper 31, page 2).

64. Winter and Spaleck maintain that examiners have made requirements for restriction (35 U.S.C. § 121) between what they call "polymerization catalyst claims" and "metallocene claims" (283 Paper 26, page 3; 284 Paper 25, page 3).

Winter and Spaleck preliminary motions
for benefit of earlier U.S. and German applications

65. Winter and Spaleck have filed preliminary motions to be accorded the benefit for the purpose of priority (37 CFR § 1.633(f)) of:

- a. U.S. application 08/101,408,
filed 3 August 1993.
- b. U.S. application 07/789,361,
filed 8 November 1991,
now U.S. Patent 5,276,208,
granted 4 January 1994.
- c. German patent application P 4 035 884.4,
filed 12 November 1990.

66. Fujita does not oppose benefit with respect to application 08/101,408 (283 Paper 34, page 1; 284 Paper 33, page 1).

67. At oral argument, counsel for Fujita agreed that if Winter or Spaleck are entitled to benefit of application 07/789,361, they would also be entitled to benefit of the German patent application (283 Paper 61, page 3; 284 Paper 62, page 3; Tr 50:20 to 51:9).

68. Accordingly, the Winter and Spaleck preliminary motions for benefit will be resolved on the basis of whether Winter and Spaleck respectively are entitled to benefit for the purpose of priority of application 07/789,361, which is now U.S. Patent 5,276,208 (**Patent 208**) (WEx 1002; SEx 1002).

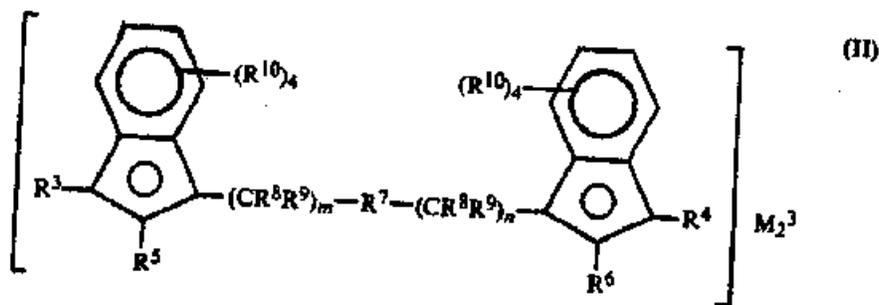
69. Patent 208 describes metallocenes (col. 1, lines 7 and 35-50).

70. Patent 208 states (col. 1, lines 7-11):

The present invention relates to novel metallocenes which contain ligands [i.e., the ring structures] of 2-substituted indenyl derivatives and can very advantageously be used as catalysts in the preparation of polyolefins of high melting point (high isotacticity).

71. Patent 208 describes metallocenes having Formula I (col. 1, lines 40-55).

72. According to Patent 208, the metallocenes of Formula I can be made from compounds having Formula II (col. 4, lines 37-55):



wherein:

R^{10} is identified as being identical or different and is as defined for R^{11} , R^{12} and R^{13} (col. 3, lines 63-64).

73. R^{11} , R^{12} and R^{13} can be a wide variety of moieties (col. 2, lines 25-33).

74. The metallocenes of Formula I do not fall within the scope of the count of Interference 104,283 or Interference 104,284; the 6-member rings of the metallocenes of Formula I are not aromatic.

75. On the other hand, the 6-member rings of the compound of Formula II are aromatic as is apparent from the circle inside the ring.

76. According to Patent 208 (col. 3, line 64 through col. 4, line 13):

The radicals R^{10} are preferably hydrogen atoms or $C_1)C_{10}$), preferably $C_1)C_4)$, alkyl groups.

The particularly preferred metallocenes are thus those in which R^{10} is hydrogen; in particular the compounds I listed in the working examples.

77. There is no description in Patent 208 of a metallocene having a non-hydrogen moiety R^{10} group specifically in the 4-, 4'-, 5- or 5'-positions.

78. Rather, according to Patent 208, the compounds of Formula (II) have four R^{10} groups some of which may be alkyl groups (e.g., methyl groups).

79. Patent 208 does not emphasize or describe any advantage of having an alkyl group in the 4-, 4'-, 5- or 5'-positions.

80. Rather, Patent 208 emphasizes a requirement that the R⁵ and R⁶ moieties in 2- and 2'-positions be something other than hydrogen (col. 2, lines 5-7; see also col. 1, line 67 et seq.), such as alkyl, particularly methyl (col. 3, lines 3-6).

81. At oral argument, Mr. Meshbesh, counsel for Winter and Spaleck, emphasized the importance of a moiety position on a metallocene ring as follows (Tr 34:9-12 and 39:13-21):

Well, each metallocene almost has to be considered on its merits because the positioning of groups of the 6-member ring of the metallocene affects its performance.

and

There is a difference in behavior -- well, they all have in common a substituent in the 2 position of the indenyl, but there's another 6-member ring and there it matters where -- let's say your substituent is a methyl group, it matters whether you put the methyl group at the 4, 5, 6 or 7 position, and it matters whether there are two methyl groups and where they happen to be located.

82. Mr. Meshbesh's observations are factually correct and are supported by the record.

83. Patent 208 does not contain a written description of the subject matter claimed in the involved Winter patent.

84. Patent 208 does not contain a written description of the subject matter of Count 1 of Interference 104,283.

85. Patent 208 does not contain a written description of a species within the scope of the claims of the involved Winter patent.

86. Patent 208 does not contain a written description of a species within the scope of the count of Interference 104,283.

87. Patent 208 does not contain a written description of the subject matter claimed in the involved Spaleck patent.

88. Patent 208 does not contain a written description of the subject matter of Count 1 of Interference 104,284.

89. Patent 208 does not contain a written description of a species within the scope of the claims of the involved Spaleck patent.

90. Patent 208 does not contain a written description of a species within the scope of the count of Interference 104,284.

Addition of Winter 719 reissue application

91. Winter 719 reissue application contains claims 1-12.

92. Winters seeks to have claims 1-6 designated as corresponding to the count of Interference 104,283.

93. Claims 1-6 are identical to claims 1-6 of Winter's involved patent.

94. Fujita opposes Winter Preliminary Motion 3 on the ground that (283 Paper 36, page 3):

Winter seeks to amend the interference by adding to its reissue application claims to be designated as not corresponding to the count.

95. Accordingly, Fujita maintains that the "motion should be dismissed" (id.).

96. Alternatively, Fujita maintains that Winter 719 claims 7-12 should be designated as corresponding to Count 1 of Interference 104,283.

Addition of Spaleck 832 reissue application

97. Spaleck 832 reissue application contains claims 1-10.

98. Spaleck seeks to have claims 1-4 designated as corresponding to the count of Interference 104,284.

99. Claims 1-4 are identical to claims 1-4 of Spaleck's involved patent.

100. Fujita opposes Spaleck Preliminary Motion 3 on the ground that (284 Paper 35, page 3):

Spaleck seeks to amend the interference by adding to its reissue application claims to be designated as not corresponding to the count.

101. Accordingly, Fujita maintains that the "motion should be dismissed" (id.).

102. Alternatively, Fujita maintains that Spaleck 832 claims 5-10 should be designated as corresponding to Count 1 of Interference 104,284.

Background as to how issue of designation of new Winter and Spaleck reissue claims arose

103. Consistent with the practice of the Trial Section, prior to setting the times for taking action during the preliminary motion phase of the interference, a conference call took place with counsel (see, e.g., 283 Paper 25, pages 1-2).

104. During the conference call, Winter and Spaleck indicated that they would file a reissue application and would move to add their respective reissue applications to the respective interferences.

105. As a result of the conference call, the following observation was made by the administrative patent judge designated to handle the interferences (283 Paper 25, page 2):

With respect to the preliminary motion to add a reissue application, it was indicated by Winter that it would be Winter's position that not all claims in the reissue application would be designated as corresponding to the

count. In the event the preliminary motion is filed and Fujita believes that claims in the reissue application should be designated as corresponding to the count, Fujita should oppose the preliminary motion and request that additional reissue application claims be designated as corresponding to the count.

106. In due course, Winter filed Winter Preliminary Motion 3 and Spaleck filed Spaleck Preliminary Motion 3 to add their respective reissue applications.

107. As indicated earlier, Fujita responded by arguing that the preliminary motions should be dismissed.

108. Alternatively, Fujita argued that the preliminary motions should be granted only if all new claims in both reissue applications are designated as corresponding to a count.

109. Winter and Spaleck replied.

110. During the preliminary motion phase of the interference, Winter and Spaleck made an assumption that Fujita had the burden of proof to the extent Fujita sought to have new claims in the reissue applications designated as corresponding to the count. Given the state of the record, the assumption was not unreasonable.

111. Fujita made an assumption, and maintains to this day, that Winter and Spaleck had the burden of proof. Given the state of the record, Fujita's assumption is likewise not unreasonable.

112. Following oral argument on preliminary motions, Fujita was given an opportunity to respond to the Winter and Spaleck replies, principally in case it turned out that Fujita had the burden of proof.

113. The Fujita response was accompanied by FUJITA MOTION 2, a Rule 635 motion for leave to file a declaration of Dr. Tobin Marks (283 Paper 71; 284 Paper 72).

114. The declaration is said to be necessary to establish that the non-original patent claims in the Winter and Spaleck reissue applications are directed to the same invention as the count of the interference into which the reissue is sought to be added.

Opinion

Part I.

Interference-in-fact

A.

Winter maintains that there is no interference-in-fact between Winter and Fujita.

Spaleck maintains that there is no interference-in-fact between Spaleck and Fujita.

An "interference-in-fact" is a term of art in interference practice. The rules define an "interference-in-fact" as follows (37 CFR § 1.601(j)):

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

The rules define "same patentable invention" as follows (37 CFR § 1.601(n)):

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Subparts (j) and (n) of Rule 601 implement holdings of the former Court of Customs and Patent Appeals. See, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977) (an interference-in-fact held to exist between a claim to a method of using cyclopentadiene and a claim to a method using butadiene, isoprene, dimethylbutadiene, piperylene, anthracene, perylene, furan or sorbic acid; the claims were held to be directed to the same patentable invention even though they did not overlap in scope). See also Notice of Final Rule, Patent Interference

Cases, 49 Fed. Reg. 48416 (Dec. 12, 1984) (see Examples 16 at 48421 and Example 20 at 48424).

An issue of whether an interference-in-fact exists is placed before the board by the filing of a preliminary motion under 37 CFR § 1.633(b). If the preliminary motion is granted, both parties would be entitled to a patent containing their respective claims initially designated as corresponding to the count because those claims would be determined to be directed to separate patentable inventions.¹¹

Resolution of an interference-in-fact issue involves a two-way patentability analysis. The claimed invention of Party A is presumed to be prior art vis-a-vis Party B and vice versa. The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must anticipate or render obvious the claimed invention of Party A. When the two-way analysis is applied, then regardless of who ultimately prevails on the issue of priority, the Patent and Trademark Office (**PTO**) assures itself that it will not issue two patents to the same patentable invention.

¹¹ See Notice of Final Rule, supra at 48440 ("Two comments questioned the nature of the judgment when a motion under § 1.633(b) is granted. Section 1.633(b) authorizes the filing of a [preliminary] motion for judgment on the ground that there is no interference-in-fact. If a [preliminary] motion under § 1.633(b) is granted, the judgment would provide that each party is entitled to a patent containing that party's claims corresponding to the count.").

B.

Winter and Spaleck maintain that their respective patent claims and the claims of Fujita are directed to "separate patentable invention[s]" within the meaning of 37 CFR § 1.601(n). We understand the argument to be the following:

1. Winter and Spaleck claim metallocene compounds.
2. Metallocene compounds have utility other than as a catalyst for making polyolefins.
3. Fujita claim 8--the only independent Fujita claim--is directed to a catalyst system in which a metallocene is used as an ingredient for making an activated "catalyst system."
4. According to Winter and Spaleck a "catalyst system" involves a reaction product of the metallocene and an activator, alternatively, the metallocene and activator are somehow bound one with the other in some chemical fashion.
5. Examiners in the Patent and Trademark Office routinely have required restriction (35 U.S.C. § 121) between metallocenes per se and catalyst systems made from metallocenes.
6. A metallocene and a "catalyst system" made from a metallocene are separate patentable inventions and

therefore there is no interference-in-fact between Winter/Spaleck and Fujita.

The party filing a preliminary motion for judgment alleging no interference-in-fact has a burden of proving its case by a preponderance of the evidence. See 37 CFR § 1.637(a), first sentence, and compare Bruning v. Hirose, 161 F.3d 681, 684, 48 USPQ2d 1934, 1937 (Fed. Cir. 1998) (burden of proof on the issue of patentability of the claims of a patent in an interference where applications are copending is by a preponderance of the evidence).

C.

At oral argument, it became apparent that the parties do not agree on the scope of, or the meaning of terms in, Fujita claim 8. The language of Fujita claim 8 which appears to create the disagreement is that which reads "A catalyst useful for the polymerization of olefins which catalyst comprises ***." Fujita maintains that Fujita claim 8 covers a metallocene per se. Winter and Spaleck maintain that (1) Fujita claim 8 is limited to a "catalyst system," (2) does not cover a metallocene per se and (3) accordingly, there is no interference-in-fact.

Construction of the meaning of words in a patent claim is an issue of law to be resolved based on the facts of each case. Markman v. Westview Instruments, Inc., 517 U.S. 370, 391, 116 S.Ct. 1384, 1396 (1996) (interpretation of the word "inventory"

[in a patent claim] in this case is an issue for the judge, not the jury ***."); Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 93 F.3d 1572, 1577, 40 USPQ2d 1019, 1022 (Fed. Cir. 1996) (significance to be given a limitation in a patent claim is a question of law which is resolved based on particular facts).

D.

Fujita claim 8 could have been presented simply as "A transition metal compound having formula (I):" followed by Formula (I). It was not. Rather, it contains additional language which reads "A catalyst useful for the polymerization of olefins which catalyst comprises ***." What is the significance, if any, of the additional language?

As a general proposition, we believe that it is appropriate, where possible, to assign some meaning to each word of a claim. Thus, like the words of a statute, each word in a claim should be given meaning if possible.

The record reveals that Winter, Spaleck and Fujita describe metallocene compounds which when activated (generally with an aluminoxane) can be used to polymerize olefins. While it may be a matter of debate as to whether the Winter, Spaleck and/or Fujita metallocenes will function as a catalyst per se (see, e.g., Tr 13:18-22), there is little doubt that the metallocenes are, at least preferably, activated with a cocatalyst. Catalysis is not a precise science as evidenced by the different results

which the Winter and Spaleck patents say are obtained depending on where substituents are placed on the ring structure.¹² It is possible that within the scope of the metallocenes of Formula (I) of Fujita claim 8, there may be some metallocene species, even when activated, which will not function for the utility described by Fujita. Fujita avoids any side-show issue of whether its enabling disclosure is commensurate in scope¹³ with the breadth of Fujita claim 8 by limiting the metallocenes of Formula (I) to those which, when used in the manner described in the Fujita specification, will be "useful for the polymerization of olefins ***."

In the context of the Fujita specification, the activated catalyst used to make polyolefins is some combination of a metallocene and an activator. Hence, Fujita's use of "which catalyst comprises" means that the catalyst must be a metallocene within the scope of Formula (I). In the final analysis, we agree

¹² We wish to emphasize that the Winter and Spaleck patents are not admissible in evidence to prove the truth of statements made therein. See NOTICE DECLARING INTERFERENCE, ¶ 41. Each patent is admissible, however, to prove what is described therein and perhaps may be used as an admission by a party opponent. Each patent describes results which are said to be obtained when the metallocenes described therein are used to polymerize olefins.

¹³ See, e.g., In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (given relative incomplete understanding in biotechnological field involved and the lack of a reasonable correlation between the narrow disclosure in Vaeck's specification and the broad scope of protection sought in the claims, PTO did not err in entering rejection based on 35 U.S.C. § 112, first paragraph, for lack of enablement); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved).

with the following statement made at oral argument by Mr. Rollins, counsel for Fujita (Tr 59:5-14):

The Fujita claim has at most three limitations. One limitation is on the structure of the metallocene compound, and I think that's quite straightforward. Another limitation or both of the other limitations appear in the preamble. One limitation is that nothing is within the scope of the claim unless it's a catalyst, and whether you consider a part of the same limitation as the catalyst or a different limitation, it has to be a catalyst useful for the polymerization of olefins.¹⁴

Based on our construction of Fujita claim 8, as outlined above, we hold, as a matter of law, that Fujita claim 8 covers a metallocene having Formula (I), but only those metallocenes within the scope of Formula (I) which can be used along with an activator to polymerize olefins. It further follows that Fujita dependent claims 14 and 16 cover specific metallocenes which fall within the scope of Winter claim 1. It still further follows that Fujita dependent claims 15, 17 and 18 cover specific metallocenes which fall within the scope of Spaleck claim 1.

E.

¹⁴ See also Tr 66:6-16: "MR. ROLLINS: So if you have a compound which is a metallocene within the scope of the claim and it is capable of acting together with an activator or without an activator, either, to polymerize olefins, it's within the scope of the claim. It's rather that simple. JUDGE McKELVEY: Actually you meant to say if you have a metallocene within the scope of the formula --. MR. ROLLINS: Of the formula, that's correct."

The subject matter of Fujita claims 14 and 16 anticipates (35 U.S.C. § 102) the subject matter of Winter claim 1, if one presumes--as we must in an interference-in-fact analysis--that the subject of Fujita claims 14 and 16 is prior art vis-a-vis Winter. Likewise, the subject matter of Winter claim 6 anticipates (35 U.S.C. § 102) the subject matter of Fujita claim 8 if one presumes that the subject matter of Winter claim 6 is prior art vis-a-vis Fujita. Hence, there is an interference-in-fact between the Winter claims and the Fujita claims designated as corresponding to the count of Interference 104,283.¹⁵

F.

The subject matter of Fujita claims 15, 17 and 18 anticipates (35 U.S.C. § 102) the subject matter of Spaleck claim 1, if one presumes that the subject of Fujita claims 15, 17 and 18 is prior art vis-a-vis Spaleck. Likewise, the subject matter of Spaleck claim 4 anticipates (35 U.S.C. § 102) the subject matter of Fujita claim 8 if one presumes that the subject matter of Spaleck claim 4 is prior art vis-a-vis Fujita. For example, the compound "rac-dimethylsilylbis(1-(2-methyl-4-ethyl-indenyl)zirconium dichloride" reads on Fujita claim 8 when:

- (1) M is zirconium;

¹⁵ Winter has not moved to have any of its claims 1-6 designated as not corresponding to the count of Interference 104,283; hence, all Winter claims stand or fall together with respect to the interference-in-fact issue.

- (2) R² is methyl-1,3-butadienylene (where the methyl is substituted at the 5- and 5'-positions)
- (3) R³ is a silylene group substituted with two methyl groups (i.e., lower alkyl groups);
- (4) X and Y are chloro groups.

Hence, there is an interference-in-fact between the Spaleck claims and the Fujita claims designated as corresponding to the count of Interference 104,284.¹⁶

G.

Notwithstanding our construction of the scope of Fujita claim 8, we believe that Winter and Spaleck have failed to sustain their burden of establishing no interference-in-fact even if Fujita claim 8 is construed to be limited to a metallocene "catalyst system" activated with an aluminoxane.

Winter, Spaleck and Fujita ultimately use their respective metallocenes in the same manner. The metallocene and an activator, e.g., an aluminoxane, are mixed and then placed in a polymerization reactor or are mixed in the polymerization reactor along with the olefin monomer to be polymerized.

¹⁶ Spaleck has not moved to have any of its claims 1-4 designated as not corresponding to the count of Interference 104,284; hence, all Spaleck claims stand or fall together with respect to the interference-in-fact issue. In particular, we note that with respect to the no interference-in-fact issue, Spaleck does not maintain that Spaleck claim 4 is entitled to any separate consideration, although later with respect to Preliminary Motion 3, Spaleck maintains that certain of (but not all) of the racemic metallocenes within the scope of Spaleck claim 4 are separately patentable from the count of Interference 104,284.

Given the similar manner in which all say their metallocenes are used, if one presumes that the Winter metallocene is prior art vis-a-vis Fujita, then it manifestly would have been obvious (35 U.S.C. § 103) to mix the Winter metallocene with an aluminoxane to make the "catalyst system" which Winter says is covered by Fujita claim 8. Likewise, if we presume that Fujita is prior art vis-a-vis Winter, then if one skilled in the art would have appreciated which metallocene is used to make the activated catalysts of Fujita claim 14. That metallocene anticipates (35 U.S.C. § 102) Winter claim 1.

If one presumes that the Spaleck metallocene is prior art vis-a-vis Fujita, then it manifestly would have been obvious (35 U.S.C. § 103) to mix the Spaleck metallocene with an aluminoxane to make the "catalyst system" which Spaleck says is covered by Fujita claim 8. Likewise, if we presume that Fujita is prior art vis-a-vis Spaleck, then if one skilled in the art would have appreciated which metallocene is used to make the activated catalysts of Fujita claim 15. That metallocene anticipates (35 U.S.C. § 102) Winter claim 1.

H.

Winter has failed to sustain its burden of demonstrating that there is no interference-in-fact between Winter and Fujita in Interference 104,283. Accordingly, Winter Preliminary Motion 1 is denied.

Spaleck has failed to sustain its burden of demonstrating that there is no interference-in-fact between Spaleck and Fujita in Interference 104,284. Accordingly, Spaleck Preliminary Motion 1 is denied.

Part II.

Winter and Spaleck request for benefit

A.

Winter and Spaleck, in their respective Preliminary Motion 2, request to be accorded the benefit for the purpose of priority of Patent 208. Fujita opposes their requests. Resolution of the issue of whether Winter and/or Spaleck should be accorded benefit turns on whether Patent 208 sufficiently describes the subject matter of the count of Interference 104,283 and/or the count of Interference 104,284.

B.

Winter and Spaleck can succeed if they can demonstrate that Patent 208 describes a species within the scope of the relevant count. Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975) (an application need only disclose a single enabled embodiment within the scope of the count to constitute a

constructive reduction to practice of the invention of the count).¹⁷

We have found, however, that Patent 208 does not describe a species within the count of Interference 104,283 or the count of Interference 104,284. Accordingly, Winter and Spaleck are not entitled to be accorded benefit for the purpose of priority based on the principles of Hunt v. Treppschuh.

C.

The fact that Patent 208 does not describe a species within the scope of the count of Interference 104,283 or the count of Interference 104,284 is not fatal to the Winter and Spaleck effort to be accorded benefit of Patent 208. In other words, we would not foreclose a possibility that in an appropriate case a benefit application might contain a sufficient description of the subject matter of the count or a party's claims corresponding to the count to justify according benefit notwithstanding the absence of a description of a species within the scope of the count (Tr 76:20 to 77:5).

In Interference 104,283, the count requires that there be a substituent on the 5- and/or 6-position of each ring structure (i.e., the R⁴ or R⁵ of Winter and the methyl or phenyl of the R²

¹⁷ A rationale which supports the holding in Hunt v. Treppschuh is that if a party describes a single species within the scope of the count, the opposing party is not entitled to a patent covering subject which is not patentably distinct from the disclosed species.

of Fujita is attached to the 5-position of the indene ring). The question thus becomes whether Patent 208 contains a sufficient description of the requirement for a substituent in the 5- and/or 6-position.

D.

Our appellate reviewing court made the following observation in Eiselstein v. Frank, 52 F.3d 1035, 1040, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citations omitted):

"Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." In order to determine whether a prior application meets the "written description" requirement with respect to later-filed claims, the prior application need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed. The test is whether the disclosure of the application relied upon reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date. "Precisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis."

Our appellate reviewing court also observed in Fujikawa v. Wattanasin, 93 F.3d 1559, 1570-71, 39 USPQ2d 1895, 1904-05 (Fed. Cir. 1996) (citations omitted):

As the Board recognized, however, ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. In other words, the question is whether Wattanasin's "application provides adequate direction which reasonably [would lead] persons skilled in the art" to the sub-genus of the proposed count.

Many years ago our predecessor court graphically articulated this standard by analogizing a genus and its constituent species to a forest and its trees. As the court explained:

It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail . . . to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.

Were we to extend Ruschig's metaphor to this case, we would say that it is easy to bypass a tree in the forest, even one that lies close to the trail, unless the point at which one must leave the trail to find the tree is well marked. Wattanasin's preferred embodiments do blaze a trail through the forest; one

that runs close by Fujikawa's proposed tree. His application, however, does not direct one to the proposed tree in particular, and does not teach the point at which one should leave the trail to find it.

E.

We do not find the necessary blaze marks in Patent 208.

Patent 208 describes a genus which embraces compounds having substituents in the 5-, 5'-, 6- and 6'-positions. However, Patent 208 does not specifically describe any particular compound with a substituent in the 5- and/or 6-positions. Patent 208 says that the preferred metallocenes are those wherein R¹⁰ is hydrogen (col. 3, line 67 through col. 4, line 13). All of the Patent 208 examples appear to describe metallocenes wherein all the R¹⁰s are hydrogen.

Winter and Spaleck acknowledge that the position of the substituent at the 5- and/or 6-position is not without significance. See Finding 81. Metallocenes with substituents at the 5- and 6-position, on this record, are patentably distinct from metallocenes with substituents at the 4-position. Otherwise, there would have been only one interference declared between Winter and Spaleck versus Fujita. The parties have treated the counts in the two interferences as patentably distinct. Both Winter (Findings 25-26) and Spaleck (Findings 32 and 38) emphasize the importance of the position where

substituents are attached. Accordingly, Patent 208 does not contain the necessary description to accord Winter and Spaleck its benefit for the purpose of priority in these interference. Cf. Bigham v. Godtfredsen, 857 F.2d 1415, 1417-18, 8 USPQ2d 1266, 1268-69 (Fed. Cir. 1988).

Winter has failed to sustain its burden of demonstrating that it is entitled to be accorded the benefit for the purpose of priority of Patent 208 in Interference 104,283. Accordingly, Winter Preliminary Motion 2 is denied. Because Winter will not be accorded benefit and there will be no priority testimony, a judgment will be entered in favor of Fujita on the issue of priority.

Spaleck has failed to sustain its burden of demonstrating that it is entitled to be accorded the benefit for the purpose of priority of Patent 208 in Interference 104,284. Accordingly, Spaleck Preliminary Motion 2 is denied. Because Spaleck will not be accorded benefit and there will be no priority testimony, a judgment will be entered in favor of Fujita on the issue of priority.

III.

Preliminary motions to add reissue applications

A.

The rules authorize a patentee involved as a party in an interference to file a preliminary motion to add a reissue

application to an interference. 37 CFR § 1.633(h). The preliminary motion must comply with the requirements of 37 CFR § 1.637(h). Rule 637(h) provides (emphasis added):

§ 1.637 Content of motions.

(h) A preliminary motion to add an application for reissue under § 1.633(h) shall:

- (1) Identify the application for reissue.
- (2) Certify that a complete copy of the file of the application for reissue has been served on all opponents.
- (3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue;^[18] when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue.
- (4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier filed application, if benefit is desired.

The parties disagree as to whether Winter and Spaleck have complied with Rule 637(h)(3). Specifically, Fujita maintains

¹⁸ With respect to the meaning of the language "[s]how the patentability of all claims *** which correspond to *** [the] count," see Notice of the Chief Administrative Patent Judge, "Interference Practice--Interference Rules Which Require a Party to "Show the Patentability" of a Claim," 1217 Off. Gaz. Pat. & Tm. Office 17 (Dec. 1, 1998).

that Winter and Spaleck did not comply with Rule 637(h)(3). See Findings 94-95, 100-101 and 107.

There is no rule which authorizes the filing of a preliminary motion to add a claim to an "ordinary" application (as distinguished from a reissue application) and have the claim designated as not corresponding to the count. Likewise, there is no rule which authorizes the filing of a preliminary motion to add a claim to a reissue application and have the claim designated as not corresponding to the count. Hence, there is a long-standing practice of not permitting an applicant in an ordinary application to file a preliminary motion to add claims to its reissue application for the purpose of having those claims designated as not corresponding to the count. See, e.g., L'Esperance v. Nishimoto, 18 USPQ2d 1534, 1537 (Bd. Pat. App. & Int. 1991). The board's practice is currently implemented by (1) dismissing preliminary motions seeking to add claims and to have those claims designated as not corresponding to the count and (2) not "entering" any amendment submitted with the preliminary motion (37 CFR § 1.615(a)). The rationale which supports the policy of not permitting an applicant to add a claim and have the claim designated as not corresponding to a count applies with equal force to claims in a reissue sought to be

added to the interference.¹⁹ Moreover, there is no express provision in Rule 637(h) which permits a patentee to discuss any non-original patent claim which the patentee believes should be designated as not corresponding to the count.²⁰ The provision of Rule 637(h)(3) which states "when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue" would be subject to the limitations of Rule 633(c) and Rule 637(c), neither of which permit a preliminary motion to add a claim to be designated as not corresponding to the count. In fact, Rule 637(h)(3) refers only to claims which correspond to the count. Hence, Rule 637(h) should be construed to not authorize the addition of reissue applications to an interference when the reissue application contains non-original patent claims which the reissue applicant does not seek to have designated as corresponding to the count. A reissue applicant should not be able through the

¹⁹ If a party could file a preliminary motion to have a claim, not previously considered by an examiner, designated as not corresponding to the count, then to grant the preliminary motion, the board in the first instance would have to determine that the claim is not directed to the same patentable invention as the count. The board would be in the business of rendering essentially advisory opinions which should not be binding on the examiner. The examiner may, and is more likely to, know of additional art, not considered by the board, which might establish that the claim is directed to the same patentable invention as the count.

²⁰ A patentee filing a reissue and asking that the reissue be added to the interference may have to mention an original patent claim because that original patent claim may have been designated as not corresponding to the count when the interference was initially declared.

back door to do what every other applicant cannot do through the front door.

For the reasons given, we agree with Fujita that the Winter and Spaleck preliminary motions to add reissue applications should be dismissed because both Winter and Spaleck seek to add reissue applications with claims which they do not feel should be designated as corresponding to the count. According, Winter Preliminary Motion 3 and Spaleck Preliminary Motion 3 are dismissed.²¹ Since both preliminary motions are being dismissed, it is not necessary to reach, or express any views on the merits of, the issue of whether Winter 719 claims 7-12 and Spaleck 832 claims 5-10 cover subject matter which is the same patentable invention as the counts in the respective interferences.²²

²¹ We recognize that Winter and Spaleck filed their respective reissue applications to claim priority. See State of Israel v. Brenner, 273 F.Supp. 714, 155 USPQ 486 (D.D.C. 1967), aff'd, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968) (reissue may be filed to perfect claim for foreign priority not perfected during prosecution of application which matured into patent sought to be reissued). The claim for priority was necessary to support their effort to obtain benefit of the 208 Patent. Since Winter and Spaleck failed on the merits (i.e, Winter and Spaleck Preliminary Motions 2 have been denied), they do not need their reissue in these interferences to perfect their claim for benefit. Had we ruled otherwise on the benefit issue, we would have granted the motion to add the reissue applications contingent on Winter and Spaleck promptly cancelling Winter 719 claims 7-12 and Spaleck 832 claims 5-10.

²² Nor do we feel that Winter and/or Spaleck necessarily had a full opportunity to develop on the merits the issue of whether Winter 719 claims 7-12 and Spaleck 832 claims 5-10 should correspond to the count. The question of who had the burden of proof in these interferences has never been clear and is contested by the parties. See Findings 110 and 111. If we had authority under the rules to reach the merits issue, we would be inclined to permit Winter and Spaleck to respond to Fujita's latest submission with cross-examination or declarations of their own witnesses or both.

B.

In light of the discussion in Part III-A, supra, we today announce the following practice. In the future we will dismiss any preliminary motion under Rule 633(h) which seeks to add a reissue application to an interference when the reissue application contains non-original patent claims which the reissue applicant does not seek to have designated as corresponding to a count. Our newly announced practice does not preclude a patentee in an interference from filing a reissue application. If the reissue application contains new claims which the reissue applicant does not seek to have designated as corresponding to the count, the reissue application will not be added to the interference.

C.

After the interference is over, the Winter and Spaleck reissue applications will come before the examiner for ex parte examination. One issue the examiner will have to consider is whether Winter 719 claims 7-12 and Spaleck 832 claims 5-10 are patentable. In particular, the examiner may have to determine whether the claims should be rejected as being unpatentable over the lost count and/or on the basis of the rationale of In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

The arguments presented by Fujita and the declaration of Dr. Tobin Marks are material to the patentability within the

meaning of 37 CFR § 1.56. Accordingly, we recommend that Winter and Spaleck supply copies to the examiner in the Winter and Spaleck reissue files of all arguments made by Fujita and all evidence supplied by Fujita, including the declaration of Dr. Marks.²³

IV.

Fujita Rule 635 motion to strike

Fujita has moved to strike Winter Reply 1 and Spaleck Reply 1. Much of what Fujita has to say about new arguments in the Winter and Spaleck replies has merit. For example, Fujita correctly notes that the replies do not follow the format required in the NOTICE DECLARING INTERFERENCE. See ¶ 26(c)(4) at page 21.²⁴ Failure to follow the format renders it difficult to determine whether a reply raises new issues.

In our opinion, Winter Preliminary Motion 1 and/or Spaleck Preliminary Motion 1 do not make out a prima facie case that there is no interference-in-fact. Based on the content of the preliminary motions and the oral argument, we have little, if

²³ A third-party declaration is admissible in ex parte examination. In re Reuter, 670 F.2d 1015, 210 USPQ 249 (CCPA 1981) (third party affidavit admissible in ex parte PTO proceeding. We voice no opinion on the weight which should be given to Fujita's arguments and evidence with respect to the patentability of Winter 719 claims 7-12 and/or Spaleck 832 claims 5-10.

²⁴ We also note the following additional defects in the Winter and Spaleck replies. The replies presume the truth of statements made in the specification of the Winter and Spaleck patents despite the fact that the patents are not admissible to prove the truth of statements made therein. See NOTICE DECLARING INTERFERENCE, ¶ 41. Copies of the Winter and Spaleck patents were not made exhibits. See NOTICE DECLARING INTERFERENCE, ¶ 37.

any, doubt that Winter or Spaleck failed to sustain their burden of establishing no interference-in-fact. Hence, it was generally unnecessary for us to consider either Fujita's oppositions or the Winter or Spaleck replies.

However, we would be less than candid if we did not acknowledge having read Fujita's oppositions. A cursory review of Winter Reply 1 and Spaleck Reply 1 will show that numerous new arguments were made by Winter and Spaleck in their replies.

We have found it unnecessary to consider the replies with one exception. Fujita in its oppositions and Winter and Spaleck in their replies have discussed the scope of, and the meaning of language in, Fujita claim 8. We have considered the Winter and Spaleck replies only to the extent that they take issue with Fujita's opposition with respect to the meaning of Fujita claim 8 and only to the extent that the replies rely on admissible evidence.²⁵ Otherwise, we have not found it necessary to consider Winter Reply 1 or Spaleck Reply 1.

We continue to be concerned with inappropriate replies being filed in interference cases. See Part 2-a. of Nau v. Ohuchida,²⁶ which states:

It has long been the perception of most, if not all, of the administrative patent judges of this board

²⁵ See n.12, supra.

²⁶ <http://www.uspto.gov/web/offices/dcom/bpai/its/104258.pdf>.

that counsel routinely raise new arguments and present new evidence with replies. Presentation of new arguments and evidence with replies raise several concerns which the Trial Section had hoped to eliminate through requirements in the NOTICE DECLARING INTERFERENCE.

One concern is whether a good faith effort was made in the first instance in filing a motion, including a preliminary motion. To this end, it is the practice of the Trial Section to consider a motion. If it finds that the motion fails to make out a prima facie case for relief, the motion may be denied without consideration of any opposition or reply. The Trial Section does not deem it fair to an opponent when a party "gets its licks in" for the first time at the reply stage after the opponent can no longer submit evidence and/or argument. In short, the Trial Section hopes to eliminate the unfair tactical advantage which can be gained through improper replies.

Another concern is that improper replies make the decision-making process difficult. It is time-consuming to read a motion only to discover that the issue to be resolved is joined at the reply stage. Hence, new arguments and new evidence at the reply stage generally result in inefficient administration of justice inefficient, all contrary to the philosophy set out in 37 CFR § 1.601.

The Trial Section's concern with replies is not a new development. At the time the "new" interference rules were being considered, it was proposed to allow replies only for certain motions. Notice of Proposed Rulemaking, Patent Interference Proceedings, 49 Fed.

Reg. 3766, 3776 (col. 3), 3793 (col. 2) (Jan. 30, 1984). As a result of comments received following the notice of proposed rulemaking, it was decided to permit replies in all instances. However, the following observation can be found in the Notice of Final Rule (emphasis added):

Another comment made at the hearing suggested that a reply to an opposition to a motion should be permitted as a matter of course. Upon consideration of the comment, it has been decided to authorize the filing of replies to opposition to all motions. Presently, replies are permitted as a matter of course only for oppositions to motions under 37 CFR 1.231 [1984]. Section 1.638(b), as changed, would permit the reply in every instance. The PTO over the years has received complaints concerning the inability of a party to file replies. The change being made in § 1.638(b) will be reviewed sometime in the future to determine whether authorizing replies is helpful to the Board and/or whether undue delay in resolving interference occurs because replies are filed. Moreover, the PTO will make a judgment on whether "new issues" are being raised as a matter of course in replies. It can thus be seen that the change in authorizing replies may be considered experimental and could be changed in the future if found to be counter-productive or inconsistent with the objective of resolving

interferences in a relatively prompt manner

(emphasis added).

Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48442 (col. 3) (Dec. 12, 1984).

The Trial Section has gone out of its way to eliminate the raising of new arguments in replies. See Paragraph 31 of the NOTICE DECLARING INTERFERENCE. If the interference bars wishes to retain its option of being able to file replies, then it should make every effort to avoid raising improper new arguments and presenting improper new evidence with replies. Quite frankly, if the efforts of the Trial Section are not successful, we see the next step as a proposal to amend the rules to permit a reply only with leave of an administrative patent judge.

The Trial Section feels that one more warning is in order to all concerned that we will strictly enforce the reply brief practice as of the date this opinion is published on the PTO Web Page or elsewhere. Whatever may have been the expectation prior to that publication, we feel we are left with little choice. Moreover, any reply which does not use the format required by ¶ 26(c), including ¶ 26(c)(4), of the NOTICE DECLARING INTERFERENCE will be returned. We take a final warning step in what we perceive to be the same spirit in which the Federal Circuit recently has taken steps to curb the raising of arguments before that court which are inconsistent with arguments made to a district court. See Key Pharmaceuticals v. Hercon Laboratories

Corp., 161 F.3d 709, 715-16, 48 USPQ2d 1911, 1916 (Fed. Cir. 1998) and Hockerson-Halberstadt v. Converse Inc., 183 F.3d 1369, 1374 (Fed. Cir. 1999), which states:

As a preliminary matter, this court decides that HHI has not waived the claim construction it advances on appeal. The recent case of Key Pharmaceuticals v. Hercon Laboratories Corp., 161 F.3d 709, 48 USPQ2d (BNA) 1911 (Fed. Cir. 1998) presented a similar issue. In Key, Hercon challenged on appeal the very claim construction it convinced the trial court to adopt. Finding Hercon's position "highly questionable," this court noted:

Ordinarily, doctrines of estoppel, waiver, invited error, or the like would prohibit a party from asserting as "error" a position that it had advocated at the trial.

Id. at 715. However, because this court had not issued an opinion publicly condemning this behavior and because Key did not object, the Key court exercised an "abundance of fairness" and revisited the claim construction issue. See id. at 715-16.

The parties completed briefing in the case at bar on November 19, 1998, about a week before this court's November 25, 1998 decision in Key. Thus, the present parties, as in Key, did not have the benefit of an opinion of this court noting the impropriety of switching claim constructions on appeal. Accordingly, this court again exercises an abundance of fairness and reviews the correctness of the district court's claim construction.

We deem it appropriate to exercise the same abundance of fairness in this case that the Federal Circuit exercised in Key and Hockerson-Halberstadt. We do not intend to be so charitable once this opinion appears on the PTO Web Page or is otherwise published.

For the reasons given, we exercise our discretion by declining to strike Winter Reply 1 and Spaleck Reply 1. Fujita's Rule 635 Motion to strike is denied.

V.

The Winter and Spaleck Rule 635 motions
to leave to file belated preliminary motions

Winter and Spaleck seek to file belated preliminary motions to challenge the patentability of Fujita's claims under the first and second paragraphs of 35 U.S.C. § 112. Winter and Spaleck argue that there is good cause for not having earlier filed the preliminary motions. We disagree and therefore the Winter and Spaleck Rule 635 motions are denied.

Winter and Spaleck are said to have been surprised by a Fujita construction given Fujita claim 8 in a paper filed by Fujita on 25 May 1999 (283 Paper 50; 284 Paper 51). By virtue of being surprised, Winter and Spaleck say they could not have earlier filed a preliminary motion attacking the patentability of Fujita claim 8 under 35 U.S.C. § 112. But, it is absolutely plain on this record that as early as the filing of Winter Reply

1 and Spaleck Reply 1 on 17 May 1999 in response to Fujita oppositions filed 16 April 1999 that there was a disagreement as to the meaning of Fujita claim 8. Moreover, both the examiner (FEx 2004, page 3--"the instant [Fujita] claims read on compounds as well as the catalyst composition") and the NOTICE DECLARING INTERFERENCE, page 43 (Fujita claim 16--which depends from Fujita claim 8--is directed to a catalyst which is a compound) construed Fujita claim 8 as being directed to a compound. It appears that Winter and Spaleck have never agreed with the examiner's construction of Fujita claim 8 or the construction placed on the Fujita claims in the NOTICE DECLARING INTERFERENCE.

The issues Winter and Spaleck seek to raise in a belated preliminary motion are manifestly afterthoughts which come too late in this interference.

VI.

Fujita Rule 635 motion 2 to file declaration

Fujita has moved to file and have considered on the merits a declaration of Dr. Tobin Marks. See Findings 56(11) and 113. Inasmuch as we have dismissed Winter Preliminary Motion 3 and Spaleck Preliminary Motion 3, as requested by Fujita, we do not reach the remaining grounds of Fujita for opposing the preliminary motions. Accordingly, there is no need to consider the Marks declaration. Fujita's Rule 635 Motion 2 is therefore dismissed.

Abbreviations used in opinion

283 Paper xx	Paper number of paper in the file of Interference 104,283, Winter v. Fujita
284 Paper xx	Paper number of paper in the file of Interference 104,284, Spaleck v. Fujita
FEx	Fujita exhibit
Fujita	The inventive entity named in application 08/678,686, filed 11 July 1996 which is involved in both Interference 104,283 and Interference 104,284
Patent 208	U.S. Patent 5,276,208, issued 4 January 1994
PTO	Patent and Trademark Office
SEx	Spaleck exhibit
Spaleck	The inventive entity named in U.S. Patent 5,329,033 which is involved in Interference 104,284
Spaleck 832	Spaleck application 09/253,832, filed 19 February 1999 seeking to reissue Spaleck U.S. Patent 5,329,033 which is involved in Interference 104,284
Tr x:y-z	Page x, lines y to z of the transcript of oral argument on 29 September 1999
WEx	Winter exhibit
Winter	The inventive entity named in U.S. Patent 5,455,365 which is involved in Interference 104,283
Winter 719	Winter application 09/252,719, filed 19 February 1999 seeking to reissue Winter U.S. Patent 5,455,365 which is involved in Interference 104,283

The opinion in support of the decision being
entered today is binding precedent of the Trial Section

104,283 Paper 82

104,284 Paper 83

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ANDREAS WINTER, FRANK KUEBER, WALTER SPALECK,
HERBERT RIEPL, WOLFGANG A. HERRMANN,
VOLKER DOLLE and JUERGEN ROHRMANN,
Junior Party,
(Patent 5,455,365),

v.

TAKASHI FUJITA, TOSHIHIKO SUGANO and HIDESHI UCHINO,
Senior Party
(Application 08/678,686).

Patent Interference No. 104,283

Entered 5 January 2000
53 USPQ2d 1478

WALTER SPALECK, JUERGEN ROHRMANN and MARTIN ANTBERG,
Junior Party,
(Patent 5,329,033),

v.

TAKASHI FUJITA, TOSHIHIKO SUGANO and HIDESHI UCHINO,
Senior Party
(Application 08/678,686).

Patent Interference No. 104,284

MEMORANDUM OPINION and ORDER
(denying request for reconsideration filed by Fujita)

Before: STONER, Chief Administrative Patent Judge,
McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER, LEE and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Fujita²⁷ requests reconsideration of Part III-A and Part III-B of our MEMORANDUM IN SUPPORT OF FINAL JUDGMENTS entered 16 November 1999 (283 Paper 78; 284 Paper 79).²⁸ Winter v. Fujita, ___ USPQ2d ___ (Bd. Pat. App. & Int. 1999).

A. Introduction

Fujita's request for reconsideration is somewhat curious.

There came a time in the interferences when Winter and Spaleck filed preliminary motions under 37 CFR § 1.633(h) [Rule 633(h)] seeking to add Winter 719 reissue application to Interference 104,283 and Spaleck 832 reissue application to Interference 104,284 (Finding 116). Fujita opposed, arguing that Winter and Spaleck were seeking "to amend the interference by adding to its reissue application claims to be designated as not corresponding to the count" (emphasis added) (Findings 94

²⁷ In its request for reconsideration Fujita ceases to refer to Fujita as "Fujita" and instead refers to Fujita's as "Mitsubishi Chemical Company (hereinafter referred to as 'MCC')". Fujita has assigned its interest to MCC. We will not compound any confusion created by the change and instead will continue to refer to the senior party as "Fujita".

²⁸ Abbreviations in this opinion are the same as those listed on page 57 of the MEMORANDUM IN SUPPORT OF FINAL JUDGMENTS.

and 100). Fujita accordingly urged that each preliminary "motion should be dismissed"²⁹ (Findings 95 and 101). Contingent on our not dismissing the Winter and Spaleck preliminary motions, Fujita alternatively opposed on the merits. According to Fujita, Winter 719 claims 7-12 should be designated as corresponding to the count of Interference 104,283 and Spaleck 832 claims 6-10 should be designated as corresponding to the count of Interference 104,284.

The merits panel dismissed the preliminary motions just as Fujita had requested. We found that neither preliminary motion, as filed, met the requirements of 37 CFR § 1.637(h) [Rule 637(h)]. Fujita now says that we should not have dismissed the preliminary motions. Instead, Fujita maintains that we should have considered Fujita's merits opposition and should have determined whether Winter 719 claims 7-12 and Spaleck claims 6-10 correspond to a count.

The merits panel finds itself in the position of having granted the relief requested by a party only to find that the party is now dissatisfied and says we should do something else. It is difficult to see how we misapprehended or overlooked any

²⁹ The word "dismiss" as applied to preliminary and other motions filed in an interference is a term of art. In deciding any motion, a panel or APJ may grant or deny the motion. A motion which is granted or denied has been treated on the merits. Another possibility is to "dismiss" a motion. In dismissing a motion, the panel or APJ does not reach the merits. There are numerous reasons why a motion may be dismissed, including but not limited to, (1) failure to timely file the motion, (2) failure to comply with procedural requirement of the rules or the NOTICE DECLARING INTERFERENCE and (3) filing a motion not authorized by the rules.

point in granting Fujita's request that the Winter and Spaleck preliminary motions be dismissed. As we said earlier, the request for reconsideration is curious.

Despite its curious nature, we take this opportunity to address some points raised by the request which are important to the effective administration of justice in interference cases before the board.

B. Interpretation of Rule 633(h)

In Part III-A and Part III-B of the MEMORANDUM IN SUPPORT OF FINAL JUDGMENTS, the merits panel interpreted the meaning of requirements set out in Rule 637(h). Under our interpretation, a preliminary motion to add a reissue application is procedurally proper only if the reissue applicant seeks to have all "new" claims in the reissue application designated as corresponding to the count.

1.

The rules permit the filing of three types of motions in interference cases:

- a. Preliminary motions--Rule 633.
- b. Motions to correct inventorship--Rule 634.
- c. Miscellaneous motions--Rule 635.³⁰

³⁰ A miscellaneous motion is a motion other than a preliminary motion or a motion to correct inventorship. Preliminary motions generally relate to and involve a substantive issue.

The issue before us on reconsideration involves preliminary motions under Rule 633(h).

Rule 633 identifies in subparagraphs the types of preliminary motions which may be filed. Rule 637 sets forth, in corresponding subparagraphs, the procedural requirements for filing a preliminary motion.

Rule 633(h) authorizes a party to file a preliminary motion to add a reissue application to an interference. Rule 637(a) sets out the general requirements for all motions. In addition, Rule 637(h) sets out the requirements to be followed when filing a preliminary motion to add a reissue application to the interference.

Rule 633(h) provides:

A party may^[31] file the following preliminary motions:

* * *

(h) [w]hen a patent is involved in an interference and the patentee has on file or files an application for reissue ***, a [preliminary] motion to add the application for reissue to the interference. See § 1.637(a) and (h).

Rule 637(h) provides (emphasis added):

³¹ The word "may" should be interpreted to mean that a party "may" or "may not" elect to file a preliminary motion. The board, however, determines if a full (any preliminary motion) or limited (e.g., only a preliminary motion based on no interference-in-fact) preliminary motion period will be set, and if so, when (i.e., the stage of the interference) a preliminary motion can be filed. See 37 CFR § 1.636(a) [Rule 636(a)].

(h) A preliminary motion to add an application for reissue under § 1.633(h) shall:

- (1) Identify the application for reissue.
- (2) Certify that a complete copy of the file of the application for reissue has been served on all opponents.
- (3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue;^[32] when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue.
- (4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier filed application, if benefit is desired.

There are a variety of reasons why a patentee involved in an interference might wish to add a reissue application to an interference. A first reason is to avoid prior art relied upon by an opponent. For example, an opponent may file a preliminary motion alleging that the claims of a patent involved in the interference are unpatentable over the prior art. Rule 633(a).

³² With respect to the meaning of the language "[s]how the patentability of all claims *** which correspond to *** [the] count," see Notice of the Chief Administrative Patent Judge, "Interference Practice--Interference Rules Which Require a Party to "Show the Patentability" of a Claim," 1217 Off. Gaz. Pat. & Tm. Office 17 (Dec. 1, 1998).

One response by a patentee could be to file a reissue and present narrower claims to be designated as corresponding to the count but which avoid the prior art. A second reason for filing a reissue might be to perfect a claim to priority under 35 U.S.C. § 120³³ or 35 U.S.C. § 119.³⁴

2.

Each interference has a count which defines the interfering subject matter between the parties to the interference. 37 CFR § 1.601(f) [Rule 601(f)]. When an interference is initially declared, each claim of each application and patent involved in an interference is designated (1) as corresponding to the count, in which case the claim is "involved" in the interference within the meaning of 35 U.S.C. § 135(a), or (2) as not corresponding to the count, in which case it is not involved in the interference. A claim which defines the same patentable invention as a count is designated as corresponding to the count. 37 CFR § 1.603 [Rule 603], last sentence.

³³ Cf. Sampson v. Comm'r of Patents, 195 USPQ 136 (D.D.C. 1976).

³⁴ Cf. State of Israel v. Brenner, 273 F.Supp. 714, 155 USPQ 486 (D.D.C. 1967), aff'd, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968) (reissue may be filed to perfect claim for foreign priority not perfected during prosecution of application which matured into patent sought to be reissued).

3.

There are numerous possibilities when a patentee files an application to reissue a patent during an interference. Three possibilities are the following.

First, the patentee may present "new" claims, each of which the patentee believes correspond to a count. Under this possibility, the patentee should file a preliminary motion to add the reissue application to the interference. 37 CFR § 1.662(b) [Rule 662(b)] ("A patentee who files an application for reissue which includes^[35] a claim that corresponds [or should be designated to correspond^{36]} to a count shall *** timely file a preliminary motion under *** [Rule 633(h)] or show good cause why the motion could not have been timely filed or would not be appropriate."). Normally, a preliminary motion under Rule 633(h) will be granted unless the reissue is filed in such an untimely manner as to disrupt efficient administration of justice in the interference consistent with 37 CFR § 1.601 [Rule 601]. Rule 601 provides that the rules should be interpreted to secure a just, speedy and inexpensive determination of every interference.

Second, the patentee may cancel all original patent claims and present only "new" claims, taking the position that none of

³⁵ The word "includes" is used to take into account a possibility that some of the original patent claims may not have been designated as corresponding to a count.

³⁶ See Notice of Final Rule, Patent Appeal and Interference Practice, 60 Fed. Reg. 14488, 14517 col. 3 (Mar. 17, 1995).

the "new" claims of the reissue application correspond to the count. Under this possibility, judgment may be entered against the patentee as to the original patent claims involved in the interference, i.e., the patent claims designated as corresponding to the count. Rule 662(b), first sentence ("If a patentee involved in an interference files an application for reissue during the interference and the reissue application does not include a claim that corresponds to a count, judgment may be entered against the patentee.").

Third, a patentee might file a reissue application containing both (1) "original patent" claims which the patentee believes correspond to a count and (2) "new" claims which the patentee believes do not correspond to a count. The third possibility is what occurred in these interferences.

4.

Any interpretation of Rule 637(h) also requires an understanding of the preliminary motions which may be filed to "redefine" the interfering subject matter. 37 CFR § 1.633(c) [Rule 633(c)]. Rule 633(c) provides in relevant part:

A party may file the following preliminary motions:

* * *

(c) A motion to redefine the interfering subject matter by

* * *

(2) amending an application claim corresponding to a count or adding a claim in the moving party's application to be designated to correspond to a count,

(3) designating an application or patent claim to correspond to a count,

(4) designating an application or patent claim as not corresponding to a count, or

(5) requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count. See § 1.637(a) and (c).

It should be noted that not included among the list of preliminary motions authorized by the rules is a preliminary motion by an applicant to (1) add a claim to its application and (2) have the claim designated as not corresponding to the count. Accordingly, the rules do not contemplate an attempt by an applicant to add a claim not involved in the interference, within the meaning of 35 U.S.C. § 135(a), for the purpose of having the claim remain not involved in the interference. Stated in other terms, the rules do not authorized an applicant to obtain a "declaratory judgment" that a new claim, added to an application involved in an interference after it is declared, should not become involved in the interference. Rather, after the interference is terminated, any applicant is free to present any new claim and the examiner will determine whether or not the new claim is patentable. See 37 CFR § 1.658(c) [Rule 658(c)] and In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992)

(party losing interference is not entitled to claims to same patentable invention as count).

The rules do provide, however, for a party to require an applicant opponent to add a claim to its application involved in the interference and have the claim designated as corresponding to the count. Rule 633(c)(5). If the preliminary motion is granted, the applicant must present the claim, and upon presentation, the claim will be designated as corresponding to the count. If the preliminary motion is denied, the applicant is not required to present the claim.³⁷ The word "applicant" in Rule 633(c)(5) facially would appear to include an applicant for an original patent as well as an applicant seeking to reissue a patent. We would not, however, be inclined to read the word "applicant" in Rule 633(c)(5) as including a reissue applicant. It is not clear that a party may require an opponent seeking reissue to add any claim to its reissue application because a party cannot compel an opponent reissue applicant to agree that any particular error occurred in its patent sought to be reissued. See 35 U.S.C. § 251 and Green v. The Rich Iron Co., 944 F.2d 852, 20 USPQ2d 1075 (Fed. Cir. 1991).

³⁷ The Winter and Spaleck reissue application have never been involved in these interferences because no preliminary motion under Rule 633(h) has been granted adding those reissue applications. Hence, the provisions of Rule 633(c)(5) are not applicable to Winter 719 claims 7-12 and Spaleck 832 claims 6-10.

5.

It does not take much imagination to see the parallel between (1) an attempt by a party to add a new claim to an application involved in an interference for the purpose of having the claim designated as not corresponding to a count and (2) an attempt by a reissue applicant to add to an interference a reissue application containing a "new" claim and have that claim designated as not corresponding to a count.

Rule 637(h)(3) requires the patentee involved in the interference to "[s]how the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count" (emphasis added). There is no requirement for any discussion of a claim which would not correspond to a count. If a patentee were allowed to add a reissue application which contains "new" claims which it believes do not correspond to a count, a reissue applicant would be able, through the back door, to do what every other applicant cannot do through the front door. Accordingly, we have interpreted Rule 633(h) to permit the filing of a preliminary motion to add a reissue only if the reissue applicant agrees that all "new" claims in the reissue application are to be designated as

corresponding to the count.³⁸ Our interpretation of Rule 637(h) puts all applicants, including reissue applicants, on the same playing field.

6.

Fujita says that we said Rule 637(h) is "confusing." We did not use the word "confusing." The request for reconsideration makes it plain that at least counsel for Fujita "heartily agrees" that Rule 637(h) "is confusing" (Request, page 1). Despite finding "portions" of our rationale "unpersuasive" (Request, page 2),³⁹ counsel for Fujita cannot deny that our interpretation of Rule 637(h) is manifestly consistent with his request, on behalf of Fujita, that the Winter and Spaleck preliminary motions be dismissed. Curiously, the request never states the rationale upon which Fujita would now interpret Rule 637(h) to reach the object Fujita seeks.

³⁸ In an interference involving a patent, it is possible that some claims of the patent are designated as not corresponding to the count when the interference is initially declared. If a reissue application is filed and the reissue applicant seeks to have the reissue application added to the interference, it would be inappropriate for the PTO to insist that the reissue applicant cancel from the reissue original patent claims which were not initially designated as corresponding to the count. An original patent claim, designated initially as not corresponding to the count, can be cancelled only if the reissue applicant (not the PTO and the opposing party) believes its presence in the patent is an error. 35 U.S.C. § 251; Green v. The Rich Iron Co., 944 F.2d 852, 20 USPQ2d 1075 (Fed. Cir. 1991) (a district court cannot compel a patentee to seek reissue where the patentee does not believe there is any error in its patent). An opponent, however, may move to have as designated to correspond to a count an original patent claim initially designated as not corresponding to a count. Rule 633(c)(3).

³⁹ According to Fujita (Request, pages 2-3), it is far more likely that a party with an economic interest will find applicable prior art than an examiner who Fujita says is under "severe time constraints imposed by the examination process." Assuming Fujita is correct, even Fujita does not categorically rule out the possibility that the examiner will know of, or find, appropriate prior art.

Our recent experience confirms our belief that the public is not certain about how to proceed under Rule 637(h). We also believe that it is entirely possible that administrative patent judges of this board may not have administered Rule 637(h) in a uniform manner. Thus, candor would require us to concede that it is possible that some administrative patent judges may have granted preliminary motions to add reissue applications which contained "new" claims not designated as not corresponding to the count while others have not.⁴⁰ What admits of no doubt, based on our experience, is that addition to an interference of an application to reissue a patent involved in the interference complicates the interference and generally makes it more difficult to enter a final decision in a just, speedy and inexpensive manner.⁴¹

Our interpretation of Rule 637(h) should (1) make uniform the practice relating to adding reissue applications to interferences, (2) eliminate possible inconsistent handling of reissue applications from panel to panel or judge to judge and

⁴⁰ We are not aware of any published precedent by the board interpreting Rule 637(h), or any other notice interpreting Rule 637(h). Nevertheless, since our interpretation may be different from that of prior panels or judges in specific unidentified cases, we have gone to some length to provide what we hope is a "reasoned analysis" in support of our interpretation of Rule 637(b). Cf. Motor Vehicle Mfgs Ass'n of the United States, Inc. v. State Farm Mutual Automobile Insurance Co., 463 U.S. 29, 57, 103 S.Ct. 2856, 2875 (1983); Greater Boston Television Corp. v. F.C.C., 444 F.2d 841, 852 (D.C. Cir. 1983) (an agency changing its course must supply a reasoned analysis). Suffice it to say that in the future the interpretation made in this case will be uniformly applied.

⁴¹ In these interferences, for example, one difficulty involves an inability of the parties to agree on which party has the burden of proof with respect to Fujita's contingent attempt to have the Winter and Spaleck "new" reissue claims designated as corresponding to a count.

(3) give the practicing interference bar a brighter line upon which to base advice to clients as to whether to seek to add reissue applications to interferences can be made.

The result reached in these interferences does not mean that a reissue application added to an interference can never be amended to include claims which do not correspond to a count. After an interference is terminated, any applicant, including a reissue applicant, may file an amendment containing new claims when ex parte prosecution is resumed. If the applicant or reissue applicant won the interference, estoppel under 37 CFR § 1.658(c) [Rule 658(c)] is not an issue. On the other hand, if the applicant or reissue applicant lost the interference, then post-interference ex parte examination will have to examine any "new" claims taking into account the estoppel provisions of Rule 658(c) and the Federal Circuit's Deckler decision.

Given our holdings in these interferences, we would be surprised if in the future any patentee would seek to add a reissue application containing "new" claims which the patentee believes should be designated as not corresponding to a count. Rather, the patentee would probably be inclined, and advised, to wait until after the interference terminates and ex parte prosecution resumes before adding any such "new" claims.

Fujita does not suggest that our interpretation⁴² is plainly erroneous or inconsistent with the language of Rule 637(h). Apparently overlooked by Fujita, is that jurisprudence which holds that an agency interpretation of an agency regulation is entitled to "controlling weight unless it is plainly erroneous or inconsistent with the regulation." Udall v. Tallman, 380 U.S. 1, 16-17, 85 S.Ct. 792, 801 (1965), quoting Bowles v. Seminole Rock Co., 325 U.S. 410, 413-14, 65 S.Ct. 1215, 1217 (1945). If our interpretation is entitled to deference before the Federal courts, then certainly Fujita also should be able to find its way to defer to our interpretation and accept that, under our interpretation of Rule 637(h), we gave Fujita precisely the relief requested.

C. Fujita's workload argument

Fujita, characterizing our interpretation of Rule 637(h) as establishing a "new practice," "submits" that the new practice "may have been motivated by a desire to save the board work" (Request, page 3). Fujita also states that the new practice may not save work.

⁴² In appropriate circumstances, the rules provide for a petition to the Commissioner for an interpretation of a rule. 37 CFR § 1.644(a)(1). Authority to decide the petition has been delegated by the Commissioner to the Chief Administrative Patent Judge. MPEP, § 1002.02(f)(4)(a) (7th ed. July 1998). The Chief Judge is a member of the merits panel and presumably would not have joined the opinion had he disagreed with the panel's interpretation of Rule 637(h). Hence, our interpretation in this particular case is equally an interpretation of Rule 637(h) by the Commissioner.

We are tempted to summarily dismiss the argument as a side show apart from the main event. The "new practice" we are said to have adopted is the "old practice" upon which Fujita based its opposition to the Winter and Spaleck preliminary motions to add reissue applications. While others not involved in this interference may have experienced a "different practice," we find it curious that Fujita characterizes our interpretation as a "new practice."

In any event, judicial and administrative tribunals often adopt policies which "save" work. When the policy is adopted consistent with the statute and rules, saving work becomes nothing more than efficient administration of justice.

In support of its "more work" argument, Fujita says that a patentee involved in an interference might file two reissue applications. The first reissue application would contain claims which the patentee believes should correspond to the count. The second reissue application would contain claims which the patentee believes should not correspond to the count. Fujita reminds us that the patentee would then be required to file in the interference a notice of the filing of the reissue applications. 37 CFR § 1.660(b) [Rule 660(b)]. Reissue applications are open to public inspection. 37 CFR § 1.11(b) [Rule 11(b)]. Fujita reasons that upon receipt of the Rule 660(b) notice, the opponent will (1) immediately order a copy of

the file wrapper of the reissue and (2) forthwith file a miscellaneous Rule 635 motion seeking to have the Trial Section add the second reissue to the interference pursuant to 37 CFR § 1.642 [Rule 642]. Accordingly, Fujita reasons that the work the board is said to have been "saving" under the "new practice" really does not amount to any saving after all.

Fujita misapprehends the role of Rule 642 and how it may be efficiently implemented in practice. Specifically, Fujita overlooks the fact that an interference is not a full-blown pre-grant opposition to the grant of a patent or a full-blown patent cancellation proceeding. While inter partes oppositions⁴³ and cancellations⁴⁴ are provided in trademark cases before the Patent and Trademark Office, Congress has not yet seen fit to provide similar pre-grant oppositions and post-grant cancellation in patent cases. Cf. Pub.L. 106-113, sec. 4502 (1999) (to be codified at 35 U.S.C. § 122(c)) (explicitly providing that there is to be no protest or other form of pre-issuance opposition to the grant of a patent on an application after publication of the application).

Action under Rule 642 is discretionary. Likewise discretionary is how the board goes about determining how to exercise discretion under Rule 642. In the scenario suggested by

⁴³ 15 U.S.C. § 1063.

⁴⁴ 15 U.S.C. § 1064.

Fujita, a significant question is whether the Commissioner, through the examiner, is of the "opinion" that an interference exists between the second reissue and claims of the opposing party's application already involved in an interference. If a motion under Rule 642 is filed by a party applicant involved in an interference to add a reissue application not involved in the interference, the party applicant may be required by the board to convince the examiner that an interference exists between the application involved in the interference and the reissue application. See 37 CFR § 1.604 [Rule 604]. Jurisdiction over the application involved in the interference may be returned to the examiner to make a determination if an interference exists. 37 CFR § 1.615(b) [Rule 615(b)]. If the examiner determines that an interference exists, appropriate action can be taken to declare a second interference or add the second reissue application to an ongoing interference. On the other hand, if the examiner determines that no interference exists, then there is no reason to declare a second interference or add the second reissue to an existing interference.⁴⁵

⁴⁵ See 35 U.S.C. § 135(a), which states that an interference may be declared when "in the opinion" of the Commissioner there is interfering subject matter between two applications or an application and a patent. A third-party has no standing to challenge a decision of the Commissioner not to declare an interference. Thus, an opponent in an interference cannot compel the Commissioner to be of "the opinion" that a second reissue application, not involved in an interference, interferes with the third-party's application involved in an interference. Ewing v. U.S. ex rel. Fowler Car Co., 244 U.S. 1, 11, 37 S.Ct. 494, 497-498 (1917) (it is the Commissioner who is to judge (be of the opinion) whether an application will interfere with another pending application).

D. Fujita's public policy argument

1.

After learning that we dismissed the Winter and Spaleck preliminary motions, as Fujita had requested, Fujita had "second thoughts."

Fujita asserts that "public policy" dictates that the merits panel should resolve the issues of whether (1) Winter 719 claims 7-12 should be designated as corresponding to the count of Interference 104,283 and (2) Spaleck 832 claims 5-10 should be designated as corresponding to the count of Interference 104,284. Needless to say, Fujita's second thoughts approach is not consistent with the approach Fujita took in urging dismissal of the Winter and Spaleck preliminary motions to add reissue applications.

The heart of Fujita's "second thoughts" argument seems to be (1) the proposition that Fujita believes that Winter 719 claims 7-12 and Spaleck 832 claims 5-10 are directed to the same patentable invention as the counts and (2) that the designation of claims is really a "patentability" issue. Basing the request on what we believe is an unduly expansive reading of Schulze v. Green, 136 F.3d 786, 45 USPQ2d 1769 (Fed. Cir. 1998), Fujita maintains that the "patentability" issue should be fully developed and decided inter partes. We disagree and we reject, in this case, Fujita's attempt to turn these interferences into a

pre-grant opposition against all "new" claims in the Winter and Spaleck reissue applications, neither of which is involved in these interferences.

2.

Fujita's reading of Schulze v. Green as providing for a pre-grant opposition vis-a-vis the "new" claims in the Winter and Spaleck reissue application, calls for some discussion leading up to enactment by Congress of the Patent Law Amendments Act of 1984, Pub. L. 98-622, 98 Stat. 3383 (1984).

a.

Prior to the Patent Law Amendments Act of 1984, some patentability issues could not be considered in an interference declared under 35 U.S.C. § 135(a). Section 135(a) (1975) then provided in part (emphasis added):

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) [hereinafter **interference board**] ***.

Facially, the language "question of priority of invention" would seem to be limited to determining who, as between two or

more inventors, is the first inventor. See Tofe v. Winchell, 645 F.2d 58, 64-65, 209 USPQ 379, 385 (CCPA 1981) (Markey, C.J., concurring):

Hindsight is always easy, but in retrospect it does appear that the court could as well have held none of the listed issues ancillary to priority. It could have interpreted the statute, 35 U.S.C. § 135, as meaning only what it says, that is, that "The question of priority of invention" and only that question "shall be determined by a board of patent interferences."

Over the years, however, it turned out that what might seem like a simple proposition became somewhat complicated. As a result of decisions of the former U.S. Court of Customs and Patent Appeals (hereinafter **CCPA**) and its predecessor courts, as well as the interference board and its predecessors, it developed that the issues which were required to be determined in an interference were "priority" and "matters ancillary thereto." See generally 2 Rivise & Caesar, Interference Law and Practice §§ 251-253 (1943) and 4 Rivise & Caesar, Interference Law and Practice §§ 692-696 (1948).

Ultimately, the notion that priority and matters ancillary thereto were to be considered in interferences came to be codified in the PTO regulations (37 CFR § 1.258(a)(1984), first sentence):

In determining priority of invention, the ***
[interference board] will consider only priority of

invention on the evidence submitted and matters ancillary thereto.

A determination of whether an issue is a "matter ancillary thereto" was not necessarily easy. See, e.g., Tofe v. Winchell, 645 F.2d 58, 209 USPQ 379 (CCPA 1981). See also 130 Cong. Rec. H10522, H10528 (col. 2) (daily ed. October 1, 1984) (section-by-section analysis), reprinted in 1984 U.S.C.C.A.N. 5827, 5836 (1984) ("In addition, determining whether an issue is ancillary to priority is a difficult and lengthy endeavor.").

One issue which was not "ancillary" was patentability of claims involved in the interference over the prior art under 35 U.S.C. § 102 and/or 103. Glass v. DeRoo, 239 F.2d 402, 112 USPQ 62 (CCPA 1956).

There came a time when the Congress learned that the inability of the interference board to consider patentability vis-a-vis the prior art created certain complications. 130 Cong. Rec. H10522, H10528 (col. 2) (daily ed. October 1, 1984) (section-by-section analysis), reprinted in 1984 U.S.C.C.A.N. 5827, 5836 (1984) (the restriction on the interference board's "jurisdiction unduly complicates the process for obtaining a patent based on an application which becomes involved in an interference").

To correct the complications, Congress undertook, inter alia, to amend 35 U.S.C. §§ 7 and 135(a). Basically, Congress

proposed to combine the interference board with the patent appeals board and give the combined board jurisdiction over priority and patentability in interference cases. Specifically, it was proposed to amend § 7 from:

The Commissioner, the deputy commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents.

to (emphasis added to show the essence of proposed changes to § 7)

The Commissioner, the deputy commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Patent Appeals and Interferences.

The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patent and shall determine priority and patentability of invention in interferences declared pursuant to section 135(a) of this title.

S. 1538, 98th Cong., 2d Sess., § 11 (June 26 (legislative day, June 25), 1984).

In § 14 of the same bill it was also proposed to amend § 135(a), in part, from:

The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) ***

to (emphasis added to show the essence of proposed changes to § 135(a))

The Board of Patent Appeals and Interferences shall determine the priority and patentability of invention in interferences.

A subsequent House bill (H.R. 6286), the bill which ultimately passed, also proposed changes to §§ 7 and 135(a), using slightly different language. Specifically, it was proposed to amend § 135(a), in part, to read (emphasis added to show differences between S. 1538 and H.R. 6286)

The Board of Patent Appeals and Interferences shall determine questions of the priority of the inventions and may determine questions of patentability [~~of invention in interferences~~].

H.R. 6286, 98th Cong., 2d Sess., § 202 (Sept. 20, 1984).

At the end of the 98th Congress, H.R. 6286 passed both the House and the Senate and § 135(a) was amended, inter alia, to provide (emphasis added):

The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.

Section 7 was also amended to create a Board of Patent Appeals and Interferences and to provide that the board shall decide priority and patentability in interference cases.

Insofar as we are aware, there is no legislative history, in the form of floor debates or committee reports, which would explain why a change occurred in the language of § 135(a) as proposed to be amended by § 14 of S. 1538 vis-a-vis the language ultimately enacted.

b.

The Patent and Trademark Office views § 135(a) as giving the board subject matter jurisdiction over priority and patentability in interference cases.

The office views § 7 as identifying the individuals who shall constitute the board and who have authority to act, as members of the board, to make decisions required by 35 U.S.C. § 134 (ex parte appeals) and 35 U.S.C. § 135(a) (interferences).

c.

After enactment of the Patent Law Amendments Act of 1984, there came time when the Patent and Trademark Office, through its Board of Patent Appeals and Interferences, had occasions to apply § 135(a), as amended, to specific facts in specific interferences.

(1)

Perkins v. Kwon

One occasion occurred in Kwon v. Perkins, 6 USPQ2d 1747 (Bd. Pat. App. & Int. 1988).

The interference involved a Kwon application and a Perkins patent. At an appropriate time in the interference, Perkins timely filed a procedurally proper preliminary motion under Rule 633(a). Perkins alleged that the Kwon claims corresponding to the count were unpatentable under 35 U.S.C. § 102(b)/103 over the prior art. 6 USPQ2d at 1750 (¶ bridging cols. 1 and 2). Ultimately the interference reached final hearing. Before an expanded nine-member panel at final hearing there were at least two issues, including (1) priority of invention and (2) the patentability of the Kwon claims. It was determined that Kwon was the prior inventor. 6 USPQ2d at 1753 (col. 2). It was also determined that Perkins had sustained its burden of establishing that the Kwon claims were unpatentable over the prior art. 6 USPQ2d at 1751 (col. 2). The panel divided on the precise relief to be given. A majority concluded that a judgment should be entered against both Perkins (based on 35 U.S.C. § 102(g)) and Kwon (based on 35 U.S.C. § 102(b)/103). A minority insisted that there was no priority issue to be resolved once it had been determined that the Kwon claims were unpatentable.

Dissatisfied, Perkins sought judicial review in the Federal Circuit. Perkins v. Kwon, 886 F.2d 325, 12 USPQ2d 1308 (Fed. Cir. 1989). The Federal Circuit panel explained the issue before it as follows (886 F.2d at 326, 12 USPQ2d at 1309):

The question on appeal is whether it was appropriate for the Board to determine priority of invention in the interference, and to enforce the consequences thereof against Perkins, when the Board held that the count was [sic--claims of Kwon corresponding to the count were^[46]] not patentable to Kwon, a party to the interference.

The Federal Circuit affirmed, holding that the board acted properly in resolving patentability against Perkins' patent claims even though Perkins had prevailed on priority. "We agree with the Board that issues of patentability and priority that have been fully developed before the Board should be resolved by the Board." 886 F.2d at 328, 12 USPQ2d at 1311. The panel also made the observation that the word "may" in the phrase "shall determine questions of priority of the inventions and may determine question of patentability" means that the board shall decide questions of patentability when "placed in issue" and "there had been adduced an appropriate record." While we have no

⁴⁶ A count is a vehicle for contesting priority and determines what evidence is relevant on the issue of priority. Squires v. Corbett, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977); Case v. CPC International, Inc., 730 F.2d 745, 221 USPQ 196, 199 (Fed. Cir.), cert. denied, 469 U.S. 872 (1984). The count might, and need, not be patentable to either party. Squires v. Corbett, 560 F.2d at 533, 194 USPQ at 519. Accordingly, Perkins' preliminary motion under Rule 633(a) attacked the patentability of Kwon's claims corresponding to the count and not the count per se.

quarrel in the abstract with the observation, we believe, for reasons hereinafter given, that the observation is subject to misinterpretation as applied to the actual wording of § 135(a) and regulations promulgated to implement the Patent Law Amendments Act of 1984.

(2)

Schulze v. Green

While Schulze v. Green, 136 F.3d 786, 45 USPQ2d 1769 (Fed. Cir. 1998), is somewhat more complicated than Kwon v. Perkins, from a procedural point of view, it reaches a very similar result.

The interference involved a Schulze application versus a Green patent. A merits panel of the board held that Schulze was the prior inventor. Hence, the Green patent claims corresponding to the count were held to be unpatentable to Green under 35 U.S.C. § 102(g) based on priority of invention. During the interference, Schulze had filed a Rule 634 motion to correct inventorship. The Rule 634 motion fairly placed in issue the question of the inventorship of the invention claimed in the Schulze application. However, for a variety of reasons the Schulze Rule 634 motion was defective. A majority of the merits panel determined that priority having been decided, the issue of the inventorship of the Schulze application could be considered

upon resumption of ex parte prosecution. Green disagreed and sought judicial review in the Federal Circuit.

The Federal Circuit agreed with Green that the inventorship issue should be considered inter partes in the interference. The Federal Circuit's opinion notes that "[t]he very filing of this motion fairly placed the issue of inventorship of *** [Schulze's] application in the interference."⁴⁷ 136 F.3d at 790, 45 USPQ2d at 1773. The Federal Circuit further observed that "[o]nce an issue has been fairly raised during the course of an interference proceeding, the facts relating to that issue should be fully developed so that the issue can be properly adjudicated ***." Id. It was noted, however, that "[a] defective motion under the regulation cannot support adjudication of the inventorship during the interference." Id.

(3)

The significant difference between the facts in Kwon v. Perkins and Schulze v. Green, on the one hand, and these interferences, on the other hand, is that the claims, as well as the patent and application, under consideration before the Federal Circuit were involved in the interference. The Winter and Spaleck reissue applications are not involved in these interferences.

⁴⁷ We agree that the filing of a motion generally places a matter in issue, provided the motion is timely filed and that the motion complies with all procedural requirements of the rules.

d.

After Kwon v. Perkins and Schulze v. Green, parties in interference cases, including apparently now Fujita, have taken the position that any patentability issue may be raised at any time and that the board is obligated to consider each and every one of those patentability issues. We believe such an expansive interpretation of § 135(a) and the two Federal Circuit opinions is unwarranted. We express our concern, in this respect, because the efficient administration of justice in interference cases is at stake.

Section 135(a) states that the board may--not shall-- consider issues of patentability. The Commissioner has determined, through the rulemaking process, what patentability issues will be considered by the board (see Rules 633 and 634) and when those issues will be considered (see Rule 636(a)). The rules, consistent with § 135(a) provide that essentially any patentability issue, including patentability issues under 35 U.S.C. §§ 102, 103 and 112, can be raised in an interference. However, to raise a patentability issue, a party must timely file a Rule 633 preliminary motion which complies procedurally with the rules. Moreover, any preliminary motion must be filed when authorized by the board--not at any time.

Our current practice is to conduct a telephone conference call about two months after an interference is declared. By that

time, the parties generally have copies of the files of any patent or application involved in the interference. The purpose of the conference call is to set times for taking action during the preliminary motion phase of the interference. Two days prior to the conference call, the parties submit (generally by facsimile) a list of proposed preliminary motions. The list is manifestly tentative, because often more time will be needed to thoroughly study the files. During the telephone conference call, an administrative patent judge explores ways in which the interference can be resolved in an efficient manner. Also considered is whether some preliminary motions can be eliminated or whether others should be filed. As a consequence of the conference call, the issues to be raised can be limited or clarified so that the interference may be resolved in a just, speedy and inexpensive manner in accordance with Rule 601.

Despite the language of § 135(a) and Rule 633, there are circumstances where a decision on priority and a decision on patentability may not be appropriate. An example of a case where a decision on priority may not be appropriate, indeed does not make sense, is where a party files a preliminary motion for judgment based on no interference-in-fact. An interference-in-fact exists when at least one claim of a party and at least one claim of an opponent are directed to the same patentable invention. Rule 601(j). If it turns out that there is no

interference-in-fact, it means that the Commissioner, through the board, cannot be of the "opinion" that there is interfering subject matter. We question whether § 135(a) should be read to permit a party with no claims which interfere with claims of an opponent to challenge the patentability⁴⁸ of the opponent's claims. The challenge would, in effect, amount to a pre-grant opposition against an application or a post-grant cancellation proceeding against a patent.

Another instance where it may not be consistent with efficient administration of justice to decide priority is the case where all the claims of both parties corresponding to the count are held to be unpatentable over the prior art.

A third circumstance might be a case where a patentee can establish that an applicant derived an invention from the patentee. Under such a circumstance, it may be inappropriate to let an applicant benefit from its "less than good faith" by permitting an attack on the patentability of claims in the patent.

In our view the Federal Circuit has not had occasion to determine the limits, if any, on the reach of § 135(a). Obviously, the limits, if any, on § 135(a) will have to be

⁴⁸ The challenge would not be based on priority, because even if the party is first, the opponent's claimed invention is patentably distinct. The challenge could, however, be based on prior art applicable against the opponent, but not the party.

determined on a case by case basis. What we are certain about, however, is that the Federal Circuit has not held that:

- (1) a party is entitled to a resolution on the merits of an issue not timely raised;
- (2) a party is entitled to a resolution on the merits of an issue raised in a motion or preliminary motion which procedurally fails to comply with the regulations;
- (3) a party is entitled to a resolution on the merits of an issue raised in a preliminary motion filed prior to the preliminary motion phase of the interference;
- (4) an interference is a pre-grant opposition proceeding where a party may oppose the grant to an opponent of claims in an application not involved in the interference;
- (5) an interference is a post-grant cancellation proceeding where a party may seek to cancel claims of a patent not involved in an interference; and/or
- (6) that the Commissioner must determine in a particular manner how the Commissioner shall be of the "opinion" that an interference exists or does not exist.

3.

Fujita's public policy argument seeks to expand the rationale of Kwon v. Perkins and Schulze v. Green to include a right to raise an issue of the patentability of a reissue

application not involved in the interference. Neither § 135(a) nor Federal Circuit or board precedent goes that far.

4.

We recognize that both Fujita and Winter/Spaleck have addressed, at least in part, the "merits" of Fujita's contingent position that Winter 719 claims 7-12 and Spaleck 832 claims 6-10 correspond or do not correspond (depending on their point of view) to counts in these interference. We also recognize that evidence has been submitted by both parties.

The parties were allowed to develop, at least in part, the merits.⁴⁹ However, it turns out that our interpretation of Rule 637(h) does not permit Winter and Spaleck to add their reissue applications to the interference. What occurred in this interference demonstrates why it was imperative for us to make a definitive interpretation of Rule 637(h) so that unnecessary expense might be spared other patentees and applicants in future interferences.

E. Fujita's request to participate in the ex parte examination of the Winter and Spaleck reissue applications

Fujita requests that we recommend under 37 CFR § 1.659(c) that Fujita be allowed to participate in ex parte prosecution of

⁴⁹ We are not convinced, however, that Winter and Spaleck have had a full opportunity to present their case. Since we are not adding the reissue applications to the interference, we have decided that further development of a factual record by Winter and Spaleck is not consistent with a just, speedy and inexpensive resolution of these two interferences.

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