

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 348

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ROBERT F. LEVEEN

Junior Party,
(Application 08/559,072)¹,

v.

STUART D. EDWARDS, RONALD G. LAX
and HUGH SHARKEY

Senior Party
(Patent No. 5,536,267)²

Patent Interference No. 104,290

Before McKELVEY, Senior Administrative Patent Judge, SCHAFER and LEE, Administrative Patent Judges.

PER CURIAM.

**MEMORANDUM OPINION ON ISSUES FOR WHICH
EDWARDS SEEKS REVIEW AT FINAL HEARING**

Introduction

¹ Filed November 16, 1995. Accorded the benefit of application 08/410,344, filed March 24, 1995. The real party in interest is Radio Therapeutics corporation, which is a wholly owned subsidiary of Boston Scientific Corporation.

² Based on Application 08/290,031, filed on August 12, 1994. The real party in interest is RITA Medical Systems, Inc.

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Final hearing in this case has been bifurcated. The issues for which Edwards seeks review at final hearing are decided in this memorandum opinion, without oral argument. Another merits panel will hear oral arguments on May 15, 2002, on the issue of priority and the antedating of an asserted prior art reference.

Senior party Edwards seeks review of a single judge decision (Paper No. 290) (1) denying Edwards miscellaneous motion 29 which seeks authorization to file preliminary motion 28 more than 18 months after the time set for filing preliminary motions and more than 4 months after all preliminary motions had been decided, and (2) alternatively denying Edwards preliminary motion 28.

Edwards miscellaneous motion 29 includes the bulk of preliminary motion 28. According to these motions, LeVeen has asserted that Dr. LeVeen is the sole inventor of the subject matter recited in LeVeen's claims 43 and 44, the only claims left in LeVeen's involved application. Preliminary motion 28 requests authorization to take the testimony of Mr. Randy Fox regarding his contributions to LeVeen's claims 43 and 44. According to Edwards, **if** such testimony is taken and **if** it shows that Mr. Fox contributed to any feature recited in either LeVeen's claim 43 or

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claim 44, then Edwards will request judgment against LeVeen on that involved claim or those claims under 35 U.S.C. § 102.

According to Edwards' miscellaneous motion 29, from the time this interference was declared to the time the period for filing preliminary motions had expired, Edwards did not have enough evidence to request the taking of testimony of Mr. Randy Fox on the issue of inventorship. Further according to Edwards' miscellaneous motion 29, a threshold level of suspicion first arose on April 20, 2001, during cross-examination of Dr. Robert F. LeVeen in connection with junior party LeVeen's priority case.

Numbered paragraph 3 of section V(B) in Edwards' miscellaneous motion 29 identifies three portions of the cross-examination of Dr. Robert F. LeVeen on April 20, 2001, as the reason first acquired by Edwards to suspect (with at least a threshold level of suspicion sufficient to request the taking of testimony of Mr. Randy Fox) that Robert F. LeVeen cannot be sole inventor for LeVeen's involved application. Those portions are noted with specificity in numbered material fact items 14 through 16 in section III of Edwards' miscellaneous motion 29.

Edwards' miscellaneous motion 29 was denied and Edwards' preliminary motion 28 was alternatively denied (Paper No. 290). The denials were based on that **nothing was uncovered during the**

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cross-examination of Dr. Robert F. LeVeen on April 20, 2001, which gives rise to a threshold level of suspicion that Robert F. LeVeen cannot be sole inventor in LeVeen's involved application, sufficient to justify the taking of testimony from Mr. Randy Fox to possibly support a belated motion for judgment.

Edwards' desired threshold level of suspicion was determined to be so low that it would support speculative fishing expeditions, inconsistent with a just, speedy, and inexpensive interference proceeding. 37 CFR § 1.601.

Discussion

Edwards' brief at final hearing does not focus on the explanation and rationale for denying miscellaneous motion 29 and alternatively denying preliminary motion 28. The decision discusses all of the points raised in Edwards' motions regarding the cross-examination testimony of Dr. Robert F. LeVeen on April 20, 2001, and provides a full answer to what Edwards states in its brief (two paragraphs beginning on line 12 of page 11) as those which had been pointed out in its motions.

We reaffirm the decision (Paper No. 290) as our own, except that the reference to additional discovery on line 21 of page 7, lines 2-3 of page 8, and line 7 of page 4 is changed to taking of testimony, and the reference on line 2 of page 2 of

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that decision to take additional testimony is changed to take testimony. Technically, Edwards request is to take testimony, rather than to have additional discovery which is a term of art. 37 CFR § 1.601(a). This difference in terminology does not affect the substance of the decision.

We reiterate here, for illustrative purposes only, a portion of the stated rationale: In the decision on page 7, it was concluded:

In short, nothing was uncovered during the cross-examination of Mr. LeVeen that is necessarily inconsistent with anything previously known to party Edwards. Furthermore, it is plausible that the testimony of Mr. LeVeen on cross-examination is entirely consistent with what was previously known to party Edwards.

It was also explained on pages 5-7 of the decision that there is an apparent, logical, and manifestly plausible explanation for the various cross-examination testimony of Dr. LeVeen which were alluded to by party Edwards. Specifically:

There is an apparent, logical, and manifestly plausible explanation for all of the above [various testimony of Dr. LeVeen on cross-examination relating to the work of Randy Fox in connection with the system disclosed in the specification of LeVeen's involved application]. In Mr. LeVeen's Rule 1.131 declaration (Exhibit 1120), in paragraph 8, it is stated: The construction of the device described above and illustrated in LeVeen Exhibits 1121 and 1122 was performed by Randy Fox in the United States **under my direct supervision** while I was an Associate Professor for the Department of Radiology of the University of Nebraska College of

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Medicine, Omaha, Nebraska. (Emphasis added.) In Mr. LeVeen's supplemental declaration (Exhibit 1123), in paragraph 2, it is stated: **I personally instructed Randy Fox** to construct the device (Emphasis added.) Also in that supplemental declaration, in paragraph 4, it is stated: Randy Fox performed the experiment which resulted in the liver ablation illustrated in LeVeen EXHIBIT 1121 **under my direction.** (Emphasis added.) Mr. LeVeen's reference to an ongoing, interactive, and collaborative effort may fairly and accurately describe the supervisor/supervisee or instructor/instructee relationship between Robert F. LeVeen and Randy Fox without the latter's having made an inventive contribution to the subject matter of LeVeen's claims 43 and 44.

Not all of the details in the system and methods disclosed in the specification of LeVeen's involved application is claimed in LeVeen's only two pending claims 43 and 44. Thus, Randy Fox may well have made contributions to the disclosed system without having made an inventive contribution to the subject matter of LeVeen's claims 43 and 44. That is consistent with the testimony of Robert F. LeVeen, on cross-examination, that Mr. Fox made some subsidiary contributions on the original [apparently referring to the joint Rule 1.131 declaration in Patent No. 5,855,576]; however, the major concept and contributions were mine.

We have substantial difficulty understanding Edwards' presentation of the issues for review and its reasons for relief. Edwards' arguments are disjointed and are based on a wide assortment of principles without adequate explanation as to how they undermine or defeat the explanation and rationale of the decision sought to be reviewed.

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Off the cuff and aimless rambling about a variety of matters, whether or not they correspond to the reasons for relief advanced in Edwards miscellaneous motion 29 and preliminary motion 28 and whether or not they undermine or defeat the rationale of the decision, characterizes the major portion of Edwards brief. There is no glue that binds or thread that ties the arguments into a meaningful and pertinent presentation.

The two paragraphs beginning on line 12 of page 11 of Edwards brief note points which were made in Edwards motions. Those points were addressed by the decision and yet Edwards does not explain why the treatment of those points should be deemed erroneous or an abuse of discretion.

Setting the stage for not focusing on the stated reasons for denying Edwards motions, Edwards begins the argument portion of its brief by arguing that the administrative patent judge (APJ) designated to handle this interference abused his discretion by ordering that senior party Edwards principal brief shall refer only to arguments made and facts presented in its original motion and not include new arguments and/or new presentation of pertinent facts.

Edwards argument is rejected. The APJ could not have abused his discretion in connection with arguments or facts which

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were not presented and developed by party Edwards. LeVeen also would not have had an opportunity to address and rebut any argument or fact not contained in Edward s motion. Final hearing for the purpose of reviewing an APJ s decision for abuse of discretion does not operate to put the parties back where they were before the motions were filed such that they could start afresh with a new set of facts and arguments. Cf. Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989) (where review is under an abuse of discretion standard, prescience is not a required characteristic of the board and the board need not divine all possible afterthoughts of counsel that might be asserted for the first time on review).

Read in context, the term original motion as used by the APJ refers to papers submitted by the parties in connection with the motion, and thus is inclusive of the opposition to the motion and the reply to the opposition. The APJ has not precluded Edwards from referring to arguments or facts presented in oppositions to motions 28 and 29 or in replies to those oppositions. The APJ made reference to Edwards original motion, in contrast with the Edwards brief at final hearing.

Party Edwards changed counsel subsequent to the rendering of the APJ s decision on Edwards miscellaneous motion 29 and

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preliminary motion 28. That, however, does not mean Edwards new counsel can take the opposing party and the board back in time and start afresh from the very beginning as if nothing had occurred before the coming on scene of new counsel.

I.
37 CFR § 1.4(b)

Edwards now argues for the first time that 37 CFR § 1.4(b) requires that each [application] file must be complete in itself, and that a separate copy of every paper to be filed in a patent or trademark application . . . must be furnished for each file to which the paper pertains. Edwards correctly quotes from 37 CFR § 1.4(b). However, how does the rule come to the aid of Edwards in refuting that nothing was uncovered during the cross-examination of Dr. Robert F. LeVeen on April 20, 2001, which gives rise to a threshold level of suspicion that LeVeen s named inventorship is wrong, sufficient to warrant a late motion for judgment and a taking of testimony to support the motion?

It does not.

Moreover, the APJ remanded LeVeen s involved application to the examiner for entry of a formal decision on the petition to change inventorship, and the examiner entered a formal decision. Note that in Paper No. 35 of LeVeen s involved application, mailed on 05/18/01, the examiner stated:

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On October 15, 1998, this application was forwarded to the Board of Patent Appeals and Interferences for a proposed interference. Prior to the forwarding of the application, a petition to change inventorship under 37 CFR 1.48(b) was submitted on March 10, 1998. The petition was filed to delete Randy Fox as an inventor since he was no longer an inventor of the invention in the remaining claims of the application. No formal acknowledgment was made in the application of the proposed change in inventorship; however, **the examiner did consider and accept the change in inventorship prior to forwarding the application to the Board. This is evidenced by the papers submitted to the Board in which the sole inventor listed for 08/559,072 is Robert F. LeVeen.**

Accordingly, in view of the papers filed March 10, 1998, the inventorship in this nonprovisional application has been changed by the deletion of Randy Fox. (Emphasis added.)

Thus, as of May 18, 2001, LeVeen's application file was complete insofar as a decision on the petition to change inventorship is concerned.

Moreover, the examiner's communication indicates that he had previously granted the pending petition to change inventorship even though no formal paper was entered in the application file. The indication is supported by the fact that within the Notice Declaring Interference (Paper No. 1) the sheet containing all of junior party's information identifies **only** Robert F. LeVeen as the inventor of LeVeen's involved application, and that since the declaration of this interference the caption of this case lists **only** Robert F. LeVeen as the junior party inventor.

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The lack of a formal decision in the application file prior to May 18, 2001, does not mean LeVeen's petition to correct inventorship was not granted by the primary examiner prior to May 18, 2001. It means only that prior to May 18, 2001, the LeVeen application file did not contain a formal decision on the matter and thus may be deemed incomplete.

Section 1.4(b) of Title 37, Code of Federal Regulations, does not provide that any decision of an examiner, if it is not reflected in a formal paper entered of record in the application file, is conclusively deemed non-existent. Section 1.4(b) of Title 37, Code of Federal Regulations, does not provide that an action taken by an examiner is as good as null until the application file contains a formal notice of the action taken, even though there may be other indications of the examiner's action. Section 1.4(b) of Title 37, Code of Federal Regulations, does not preclude an examiner from entering a formal paper to complete a file and to acknowledge in the same paper that corresponding action had been taken at an earlier time.

We also reject Edwards' argument that it was not placed on notice that a decision had been entered on LeVeen's petition to change inventorship. Implicit notice was given when this interference was declared on July 16, 1999, listing Robert F.

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LeVeen as the sole inventor for LeVeen's involved application and each time a communication was sent from the board having in the caption thereof for this interference an identification of only Robert F. LeVeen as the junior party inventor. Explicit formal notice was given in a communication from the examiner (Paper 35 in LeVeen's involved application) and sent to the parties on May 18, 2001. Moreover, it should be noted that Edwards' motions 28 and 29 were denied not because Edwards took too much time from April 20, 2001 (date of cross-examination of Dr. Robert F. LeVeen), to June 8, 2001, to file its miscellaneous motion 29 and belated preliminary motion 28, but because nothing was uncovered during the cross-examination of Dr. Robert F. LeVeen on April 20, 2001, to justify the taking of testimony from Mr. Randy Fox in connection with a belated motion for judgment under 35 U.S.C. § 102(f).

In any event, we regard whether the petition to change inventorship was granted by the primary examiner before May 18, 2001, and whether Edwards should have been given earlier notice of the same as inconsequential side shows. The timing of the examiner's decision and when Edwards received notice of the same do not affect the APJ's analysis that during the cross-examination of Dr. Robert F. LeVeen on April 20, 2001, nothing

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was uncovered which gives rise to a threshold level of suspicion that Dr. Robert F. LeVeen cannot be sole inventor for LeVeen's involved application, sufficient to justify the taking of testimony by Edwards in a belated motion for judgment based on incorrectly named inventorship under 35 U.S.C. § 102(f).

II.

37 CFR § 1.48(b) and 37 CFR § 1.634

Edwards now argues also for the first time that the party LeVeen did not file a motion under 37 CFR § 1.634 as required by 37 CFR § 1.48(b). Section 1.48(b) of Title 37, Code of Federal Regulations, states in pertinent part:

When the application is involved in an interference, the amendment [to change inventorship and attached to a petition to correct inventorship] must comply with the requirements of this section and must be accompanied by a motion under 37 CFR § 1.634.

LeVeen's petition to correct inventorship was filed in its involved application on March 10, 1998. This interference was declared on July 16, 1999. When LeVeen's petition was filed in its involved application, LeVeen's involved application was not involved in an interference. Therefore, 37 CFR § 1.48(b) does not require LeVeen's petition and corresponding amendment to have been accompanied by a motion to correct inventorship under 37 CFR § 1.634. A remand by the APJ to the primary examiner for the primary examiner to formally enter a decision on LeVeen's

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previously filed petition does not constitute a re-filing of LeVeen's petition. We hold that LeVeen's petition and related amendment to change inventorship need not have been accompanied by a motion under 37 CFR § 1.634.

Moreover, the remand by the APJ, for the sole purpose of allowing the primary examiner to enter a formal decision on LeVeen's petition was made with the express consent of counsel for senior party Edwards. (See Paper No. 266). That consent was given after counsel for Edwards had been informed that the examiner indicated to the APJ that he had granted the petition before the declaration of this interference and that the Form 850 and papers associated therewith implicitly make known his decision. (See Paper No. 266). Pertinent portions of the remand order (Paper No. 266) is reproduced below:

In a telephone conference with the parties this morning, the administrative patent judge was made aware of a petition to correct inventorship in the junior party's application file which appears to not have been decided. The junior party was directed to make an inquiry to the examiner to ascertain the status of that petition. Early this afternoon, **the administrative patent judge received a telephone call from Examiner Lee Cohen who indicated that he had granted the petition before the declaration of this interference and that the Form 850 and papers associated therewith implicitly make known that decision.** In a telephone conference with the parties this afternoon, the Examiner's remarks were conveyed to respective counsel of the parties.

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Also in the telephone conference conducted this afternoon, **the parties agreed to a proposal by the administrative patent judge that junior party s involved application be remanded to the examiner for entry of a formal decision on the petition.** As for a motion for judgment based on incorrectly named inventorship, which Edwards desires to file, Edwards counsel agreed to wait a short time until early next week for the examiner to enter a formal decision on LeVeen s petition before filing such a motion. (Emphasis added.)

Given the consent given by counsel for party Edwards as is reflected above, Edwards cannot credibly argue that LeVeen should have filed a motion under 37 CFR § 1.634, and that Edwards would have had an opportunity, as a matter of right, to cross-examine corresponding affiants or declarants whose testimony support the hypothetical motion under 37 CFR § 1.634. Edwards had agreed to entry of the examiner s decision without there having been an associated motion under 37 CFR § 1.634 in this interference. Furthermore, at least from the date of declaration of this interference on July 16, 1999, Edwards was on notice that LeVeen had previously filed a petition to correct inventorship. If it is Edwards view that a motion under 37 CFR § 1.634 should have accompanied LeVeen s petition, the time to make that argument would be shortly after the declaration of this interference on July 16, 1999, not more than two years and five months later, on January 10, 2002, in Edwards brief for final hearing.

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Also, whether LeVeen's petition should have been accompanied by a motion under 37 CFR § 1.634 does not affect the APJ's analysis that during the cross-examination of Dr. LeVeen on April 20, 2001, nothing was uncovered which gives rise to a threshold level of suspicion that he cannot be sole inventor for LeVeen's application, sufficient to justify the taking of testimony in a belated motion for judgment under 35 U.S.C. § 102(f).

Not only do we regard Edwards' argument based on 37 CFR § 1.48(b) and 37 CFR § 1.634, as inappropriate new argument, we are also of the view, for reasons discussed above, that it is a frivolous argument that wasted the time and resources of opposing party and counsel as well as the board.

III.

That Party Edwards Had Insufficient Notice That
Randy Fox Had Changed from Inventor To Corroborator

Edwards now argues for the first time that (1) the party Edwards was not put on notice that the status of Fox had changed from that of an inventor to that of a corroborator.

The argument is rejected.

For each party, the identity of the inventive entity responsible for the subject matter of the count to be proven during the priority phase of the interference proceeding is specified in the party's own preliminary statement. Party LeVeen

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filed its preliminary statement with the board on December 3, 1999, (Paper No. 52) and filed proof of service (Paper No. 58) of its preliminary statement to party Edwards with the board on December 9, 1999. LeVeen s preliminary statement identifies only Dr. Robert F. LeVeen as the inventor for the subject matter of the count in this interference.

Party LeVeen s preliminary statement, served on party Edwards on December 9, 1999, states in pertinent part:

Robert F. LeVeen is the Junior party in the above-identified interference. Robert F. LeVeen is the sole inventor of the invention defined by the count in the interference, and the invention was made by LeVeen in the United states.

Accordingly, as early as several days after December 9, 1999 (accounting for the transit time by mail), party Edwards was on notice that with respect to the subject matter of the count of this interference if Mr. Randy Fox were to testify in the priority phase of the interference, it would be as a corroborator and not as an inventor. That is as much notice as any party in interference can expect. The argument that Edwards was not on notice that Mr. Randy Fox, if he testifies, would be testifying as corroborator rather than as an inventor is frivolous.

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Conclusion

Because Edwards did not comply with the APJ's valid instruction that no new argument shall be presented in its brief at final hearing, it is

ORDERED that Edwards' brief for final hearing is stricken and not entitled to consideration.

Alternatively, even if Edwards' brief for final hearing is considered on its merits, we reject each of the arguments contained therein for reasons discussed above.

It is

FURTHER ORDERED that within fourteen (14) days of the date of this communication party Edwards shall show good cause why we should not impose sanction under 37 CFR § 1.616 (a) (5) in the form of compensatory attorney fees against Edwards for filing a brief which contains new **and** frivolous arguments, specifically those discussed in Sections II and III above; and

FURTHER ORDERED that party LeVeen shall not file any reply to Edwards' response to our show cause order above.

FRED E. MCKELVEY, Senior)	
Administrative Patent Judge)	
)	BOARD OF PATENT
RICHARD E. SCHAFER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
JAMESON LEE)	
Administrative Patent Judge)	