

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 171

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FAXED

GLAXO WELLCOME INC.,

APR 30 2001

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

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

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

Senior Party.
(Application 08/909,611)

Patent Interference 104,532

Before: MCKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and GARNER-LANE, Administrative Patent Judges.

PER CURIAM.

MEMORANDUM OPINION and ORDER

The board has received a PETITION FROM THE APRIL 6, 2001,
ORDER OF THE ADMINISTRATIVE PATENT JUDGE UNDER 37 C.F.R.
§ 1.644(a)(1) (Paper 170) (hereinafter "petition"). The
petition, while styled as a petition under 37 CFR § 1.644(a)(1),
is in reality a petition seeking to have the Commissioner

exercise supervisory authority over an action taken by a single Administrative Patent Judge on behalf of the board.

A. Facts

The facts are rather straightforward. Cabilly filed a preliminary motion alleging unpatentability of Glaxo claims based on alleged public use. Glaxo filed an opposition. Thereafter, additional evidence became available which Cabilly believes is relevant to the issues raised in its preliminary motion. Cabilly then submitted the additional evidence with its reply to Glaxo's opposition. Thereafter, a conference call took place between counsel for the parties and Administrative Patent Judge Sally Gardner-Lane (Paper 164, page 1). During the conference call, Glaxo sought leave to file a miscellaneous motion (37 CFR § 1.635) to "strike" (i.e., deny consideration to) at least that part of Cabilly's reply which relies on the additional evidence (Ex 2267, page 36, lines 13-16). Alternatively, Glaxo asked for an opportunity to file an additional opposition to address Cabilly's new evidence (Ex 2267, page 36, lines 16-21).

It is apparently Glaxo's position that the Cabilly preliminary motion does not make out a prima facie case for relief. Cabilly, of course, maintains otherwise. But, as counsel for Cabilly explained during the conference call, Cabilly's ability to use the additional evidence only became possible after its preliminary motion and Glaxo's opposition had been filed (Ex 2267, page 14, lines 4-16).

Based on her assessment of the case, as a whole, Judge Gardner-Lane exercised her discretion to permit Glaxo to file an additional opposition addressing Cabilly's additional evidence and for Cabilly to file an additional reply (Paper 164, page 5).

Glaxo now seeks administrative review of Judge Gardner-Lane's order by way of a petition under 37 CFR § 1.644(a)(1).

B. Petitions under Rule 644(a)(1)

The rules authorize three different types of petitions. A Rule 644(a)(1) petition is appropriate when the board is of the opinion that a decision involves a controlling question of procedure or an interpretation of a rule.

The petition is vague as to the precise issue of procedure which is in need of resolution. According to the petition (page 1):

The junior party, GWI [Glaxo] hereby requests that the Commissioner review the Order of Administrative Patent Judge Gardner-Lane issued on April 6, 2001, and modify the order to allow GWI to argue and submit evidence, at an appropriate time, that Cabilly did not make out a prima facie case in Cabilly Preliminary Motion 6 that the claims of the GWI patents are unpatentable over [sic--based on] a prior public use under 35 U.S.C. § 102(a) or (b) or 35 U.S.C. § 103, and that Cabilly improperly relied on new evidence in Cabilly Reply to GWI's Opposition to Cabilly Preliminary Motion 6.

C. Discussion

The panel is of the opinion that there is no controlling question of procedure involved in this matter. Accordingly, it declines to certify any question to the Commissioner for resolution. The petition, however, will be treated as a request for reconsideration of the order entered on 6 April 2001 (Paper 174). The request for reconsideration will be denied.

The rules contemplate that an interference will be handled in a just, speedy and inexpensive manner. 37 CFR § 1.601. A party filing a motion, including a preliminary motion, bears the burden of proof (37 CFR § 1.637(a)). A preliminary motion must make out a prima facie case for relief. Hillman v. Shyamala, 55 USPQ2d 1220 (Bd. Pat. App. & Int. 2000). If a motion fails to make out a prima facie case for relief, it may not be necessary to consider any opposition or reply.

In this case, Glaxo maintains, and Cabilly denies, that Cabilly's preliminary motion, as originally filed, fails to make out a prima facie case for relief. The policy that a preliminary motion must make out a prima facie case does not mean that a party can never be authorized to supplement the preliminary motion with additional relevant evidence which becomes available after the preliminary motion is filed. 37 CFR § 1.645(b).

It may be true that, upon availability of the additional evidence, Cabilly should have sought leave to file the additional evidence along with a supplemental preliminary motion--as opposed to just filing the additional evidence with its reply. It is

also true that it is the practice of the board not to consider new issues (or evidence) presented for the first time in a reply. But, the issue to be resolved here is whether it is "just" to consider evidence felt to be relevant by the moving party which was not available until after its preliminary motion and its opponent's opposition have been filed. Given representations by counsel for Cabilly, we feel that the additional evidence became available at a time when it could not have been presented with the preliminary motion. 37 CFR § 1.645(b).

Here, the "just" thing to do is, and we exercise our discretion, to consider Cabilly's original preliminary motion and original reply, including the additional evidence, and to permit Glaxo to address the evidence served with the original preliminary motion and Cabilly's original reply. Accordingly, under the facts of this case, it does not matter whether Cabilly's original preliminary motion makes out a prima facie case for relief. The important fact will be whether the original preliminary motion and original reply collectively make out a prima facie case. Glaxo is free under the order entered 6 April 2001 to argue that they do not. Moreover, as requested by Glaxo during the conference call, it is authorized in its supplemental opposition to address all evidence served, and rationale relied upon, by Cabilly in support of its original preliminary motion and original reply.

It is maintained in the petition that "[t]he order is not 'just' because it takes away a substantive right of GWI [Glaxo],

i.e., the ability of GWI to argue that Cabilly has not made out a prima facie case in its original [preliminary] motion" (Petition, page 9). Glaxo has been denied no substantive, or for that matter procedural, right. Glaxo has a full and fair opportunity to oppose on the merits Cabilly's public use allegations.

D. Order

Upon consideration of the petition, and for the reasons given, it is

ORDERED that the panel declines to certify any question to the Commissioner. 37 CFR § 1.644(a)(1).

FURTHER ORDERED that the petition has been treated as a request for reconsideration of the order entered 6 April 2001.

FURTHER ORDERED that the request for reconsideration is denied.

FURTHER ORDERED that all times previously set for taking action in this interference continue to run.

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FRED E. MCKELVEY, Senior Administrative Patent Judge)	
<i>Richard E. Schaffer</i> RICHARD E. SCHAFER Administrative Patent Judge)	BOARD OF PATENT APPEALS AND INTERFERENCES
<i>Sally Gardner Lane</i> SALLY GARDNER-LANE Administrative Patent Judge)	

cc (via fax)

Counsel for Glaxo Wellcome, Inc.:

Gerald M. Murphy, Jr., Esq.
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 500, East
Falls Church, VA 22042

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

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

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

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