

INTERFERENCE TRIAL SECTION PRECEDENTIAL OPINION

This opinion is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise not binding precedent. The decision was entered on November 10, 1999.

Paper 45

Filed by: Interference Trial Section Merits 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

GERARD M. HOUSEY

Junior Party
(Patent Nos. 4,980,281; 5,266,464 and 5,688,655),

v.

PHILLIP W. BERMAN, TIMOTHY J. GREGORY,
LAURENCE A. LASKY, GERALD R. NAKAMURA,
ERIC J. PATZER, JOHN S. PATTON and ELLEN S. VITETTA

Senior Party
(Application 08/953,550).

Patent Interference No. 104,347

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE and TORCZON,
Administrative Patent Judges.¹

SCHAFER, Administrative Patent Judge.

¹ Senior APJ McKelvey was added to the panel subsequent to oral argument. See, In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985) .

**INTERLOCUTORY DECISION AND OPINION ON
HOUSEY' S PRELIMINARY MOTION UNDER 37 CFR § 1.633(a)**

Before us for consideration is Housey's preliminary motion for judgment under 37 CFR § 1.633(a) asserting that Berman's sole involved claim, Claim 64, is unpatentable under 35 U.S.C. § 135(b). We grant Housey's motion and remand the case to the APJ for further proceedings not inconsistent with this opinion.

Findings of Fact

The following findings of fact are supported by a preponderance of the evidence:²

Background

1. This interference is between Berman Application 08/953,550 and Housey patents 4,980,281, 5,266,464 and 5,688,655.
2. The subject matter of the count relates to a screening method for identifying substances which act to inhibit or promote the formation of cell proteins which cause a phenotypic change in the cell. A candidate substance is allowed to interact with each of two cell lines. One cell line produces the protein. The other either does not produce the protein or produces it to a lesser degree. The phenotypic changes in the two cell lines are compared. The comparison indicates whether the substance is an inhibitor or an activator of the protein.
3. The count of the interference is as follows:

Claim 64 of Berman application 08/953,550 or claim 1 of patent 4,980,281 or claim 22 of patent 4,980,281 or claim 1 of patent 5,266,464 or claim 5 of patent 5,266,464 or claim 1 of patent 5,688,655.

Paper 1, p. 32.

4. The notice declaring this interference designated Berman Claim 64 as corresponding to the Count. Paper 1, p. 32.
5. Claim 64 reads as follows:

64. A method of identifying an anti-gp120 monoclonal antibody that is an inhibitor of the binding of T4 receptor to the T cell binding (TCB) domain of gp120 by blocking or binding said TCB domain, which method comprises:
 - (a) providing a CHO cell which has been transformed to produce T4 receptor relative to a control CHO cell which does not produce T4

² To the extent necessary, additional findings are included in the Analysis section of this opinion.

receptor, and wherein production of T4 receptor enhances the ability to bind to the TCB domain of gp120 in the transformed cell, which ability is greater in said transformed cell than in said control cell,

(b) treating said transformed cell with an anti-gp120 monoclonal antibody and gp120, and

(c) examining the treated transformed cell to determine whether inhibition of the binding of T4 receptor to the TCB domain of gp120 has occurred in response to said anti-gp120 monoclonal antibody of (b).

Housey's Preliminary Motion

6. Housey asserts that Berman claim 64 is barred by 35 U.S.C. § 135(b) because the subject matter claim 64 was not made within one year of the issuance of the Housey 281 or 464 patents.
7. Claim 64 is the only pending claim in Berman's application.
8. Berman involved application 08/953,550 was filed October 17, 1997.
9. Berman Claim 64 was introduced into the Berman involved application by a preliminary amendment filed October 17, 1997. Berman Application 08/953,550, Paper 4, p. 2.
10. Claim 64 was amended to the form quoted above in a paper filed August 13, 1998. Berman Application, Paper 8, pp. 1-2.
11. Involved Housey Patent 4,980,281 was granted December 25, 1990.
12. Involved Housey Patent 5,266,464 was granted November 30, 1993.
13. Involved Housey Patent 5,688,655 was granted November 18, 1997.
14. Amended Claim 64 was entered into the involved Berman application nearly eight years after Housey 281 patent was granted and nearly 5 years after Housey 464 was granted.
15. In the notice declaring this interference, Berman was accorded benefit of the filing dates of a number of applications including Application 07/016,809, filed February 20, 1987.
16. Berman alleges that Claim 27 of Berman Application 07/016,809 is for the "same or substantially the same invention" as claim 1 of Housey 281 and claim 5 of Housey 484. Berman Opposition to Preliminary Motion 1 (Paper 33), p. 8-9.
17. Berman Claim 27 was an original claim in Berman Application 07/016,809.
18. Berman Claim 27 was also an original claim in Berman involved application 08/953,550 and was cancelled by preliminary amendment filed October 17, 1997, in favor of claim 64. Berman Application 08/953,550, Paper 4, p. 2.
19. Berman Claim 27 was made prior to the granting of the Housey 281 and 464 patents.

20. Berman claim 27 is directed to an antibody.
21. Berman claim 27 reads:
27. An antibody which has the TCB domain binding characteristics of monoclonal antibody 5C2E5 (ATCC _____).
22. Claim 1 of Housey 281 and claim 5 of Housey 464 relate to a method for determining whether a substance is an activator or an inhibitor of a protein.
23. Claim 1 of Housey 281 reads:
1. A method of determining whether a substance is an inhibitor or activator of a protein whose production by a cell evokes a responsive change in a phenotypic characteristic other than the level of said protein in said cell per se, which comprises:
- (a) providing a first cell line which produces said protein and exhibits said phenotypic response to the protein;
 - (b) providing a second cell line which produces the protein at a lower level than the first cell line, or does not produce the protein at all, and which exhibits said phenotypic response to the protein to a lesser degree or not at all;
 - (c) incubating the substance with the first and second cell lines;
- and
- (d) comparing the phenotypic response of the first cell line to the substance with the phenotypic response of the second cell line to the substance.
24. Claim 5 of Housey 464 reads:
5. A method of determining whether a substance is an inhibitor or activator of a protein whose production by a cell evokes a responsive change in a phenotypic characteristic other than the level of said protein in said cell per se, which comprises:
- (a) providing a first CHO cell line which produces the protein and exhibits said phenotypic response thereto;
 - (b) providing a second CHO cell line which produces the protein at a lower level than the first cell line, or does not produce the protein at all, and which exhibits said phenotypic response to the protein to a lesser degree or not at all;
 - (c) incubating the substance with the first and second CHO cell lines; and
 - (d) comparing the phenotypic response of the first CHO cell line to the substance with the phenotypic response of the second CHO cell line to the substance.
25. We find that Berman's claim 27 is not the same as claim 1 of Housey 218 or claim 5 of Housey 464.

26. We find that Berman's claim 27 is not directed to the same or substantially the same subject matter as claim 1 of Housey 218 or claim 5 of Housey 464.

Analysis

We conclude that Berman's Claim 64, the sole claim in the Berman application, is barred under 35 U.S.C. § 135(b).

The statute here involved reads as follows:

Section 135 Interferences

...

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Neither Housey nor Berman asserts, for the purpose of this motion, that Berman Claim 64 is not directed to the same or substantially the same subject matter as claimed the Housey 281 and 464 patents. There is also no dispute that Berman Claim 64 was not made within one year of the grant of either Housey patent 281 or 464. Thus, applying the express language of § 135(b), Berman's Claim 64 would appear to be barred since it was not made within one year of the date in which these Housey patents were granted. However, under the jurisprudence interpreting § 135(b), Berman Claim 64 is not barred if Berman had on file a claim which was directed to the same or substantially same subject matter as claimed by the patentee prior to the critical period. See, e.g., Corbett v. Chisholm, 568 F.2d 759, 760, 196 USPQ 337, 338 (CCPA 1977) ("The issue, therefore, is whether the board was correct in holding that Corbett was not claiming subject matter substantially the same as that covered by the copied claims prior to January 19, 1972, i.e., within the year after Chisholm's patent issued"). Berman asserts that original claim 27 in application 07/016,809 is such a claim. That application was filed on February 20, 1987, long before the granting of the Housey 281 and 464 patents. More particularly Berman asserts that claim 27 when combined with certain prior art references "would have rendered obvious, at the very least, claim 1 of the 1990 Housey Patent and claim 5 of the 1993 Housey Patent." Berman Opposition to Preliminary Motion (1), Paper 33, pp. 8-9.

Berman claim 27 reads as follows:

27. An antibody which has the TCB domain binding characteristics of monoclonal antibody 5C2E5 (ATCC _____).

This claim is directed to a specific antibody. Claim 1 of Housey 281 and claim 5 of Housey 464 are directed to a method of determining whether a substance is an inhibitor or activator of a protein. We reproduce these claims below:

Housey Patent 4,980,281, Claim 1

1. A method of determining whether a substance is an inhibitor or activator of a protein whose production by a cell evokes a responsive change in a phenotypic characteristic other than the level of said protein in said cell per se, which comprises:
 - (a) providing a first cell line which produces said protein and exhibits said phenotypic response to the protein;
 - (b) providing a second cell line which produces the protein at a lower level than the first cell line, or does not produce the protein at all, and which exhibits said phenotypic response to the protein to a lesser degree or not at all;
 - (c) incubating the substance with the first and second cell lines;and
 - (d) comparing the phenotypic response of the first cell line to the substance with the phenotypic response of the second cell line to the substance.

Housey Patent 5,266,464, Claim 5

5. A method of determining whether a substance is an inhibitor or activator of a protein whose production by a cell evokes a responsive change in a phenotypic characteristic other than the level of said protein in said cell per se, which comprises:
 - (a) providing a first CHO cell line which produces the protein and exhibits said phenotypic response thereto;
 - (b) providing a second CHO cell line which produces the protein at a lower level than the first cell line, or does not produce the protein at all, and which exhibits said phenotypic response to the protein to a lesser degree or not at all;
 - (c) incubating the substance with the first and second CHO cell lines; and
 - (d) comparing the phenotypic response of the first CHO cell line to the substance with the phenotypic response of the second CHO cell line to the substance.

As a comparison of the claims shows, Berman claim 27 is not “the same as” any of the above reproduced Housey claims.

The question remains as to whether the Berman’s claim 27 is “for the same or substantially the same subject matter” as claimed in the Housey patents. Again a comparison of the claims shows

that the subject matter is substantially different than the subject matter of Housey's claims. Berman's claim 27 is limited to a class of antibodies having a specific characteristic. They are said to have the TCB domain binding characteristics of a monoclonal antibody identified as 5C2E5. The TCB domain is the portion of the envelope protein of a human immunodeficiency virus (HIV env polypeptide) which is responsible for binding the polypeptide to the T4 cell surface marker of T helper cells. Specification of Berman Application 08/016,809, pp. 7-8. Berman says that antibody 5C2E5 "appears to be directed to an epitope that is located adjacent to the sequence in the TCB domain that binds to the T4 cell surface marker." Specification of Berman Application 08/016,809, p. 8. The claim does not specify any method steps, require any cell lines, or comparison of results. On the other hand, neither claim 1 of Housey 281 or claim 5 of Housey 464 are directed to or specifically require an antibody. Housey's claims are directed to a method for determining whether a substance is an inhibitor or activator of a protein which causes a phenotypic change in the cell. The method requires the utilization of two cell lines, the control cell line and the test cell line, to determine whether a substance inhibits or activates a protein. The control cells either produce no protein or produce less protein than the test cells. Whether the test substance inhibits or activates the protein of the test cell is determined by comparing the phenotypic responses of the control and test cells to the substance. The fundamental differences between Berman claim 27 and the Housey claims demonstrate that claim 27 is not directed to the same or substantially the same subject matter as claimed in either of the Housey patents.

Berman argues that Housey has not made out a prima facie case of unpatentability. Berman Opposition to Preliminary Motion (1), pp. 5-6. We disagree. The very apparent differences between the subject matter claimed in Berman's claim 27 and Housey's patent claims, under the specific facts of this case, is sufficient alone to make out a prima facie case. While Berman's claim 27 may be related to the subject matter of Housey's patent claims, § 135(b) requires that there must have been a claim to the same or substantially the same subject matter prior to the critical date, not merely a claim to related subject matter. See Corbett, 568 F.2d at 766, 196 USPQ at 344. Berman's claim 27, on its face, is sufficiently divergent in scope and emphasis from the subject matter of the Housey claims that a comparison of the covered subject matter is sufficient, under the particular facts of this interference, to establish a prima facie case.

Berman argues that the fact that claim 27 is not directed to a method of identification is not controlling. It is argued that when it comes to applying the bar of § 135(b), the rule that every limitation in the count must be considered material does not apply. Rather it is whether the differences are of “patentable significance.” Berman relies upon Reiser v. Williams, 255 F.2d 419, 422, 118 USPQ 96, 99 (CCPA 1958) and Stalego v. Heymes, 263 F.2d 334, 335, 120 USPQ 473, 475 (CCPA 1959) and argues that

[u]nder current practice, the analysis is whether the subject matter in the respective claims is the “same patentable invention” as defined by 37 CFR § 1.601(n). Under that section, it is sufficient if the two inventions being compared are obvious in view of each other under 35 USC § 103. In essence, the question of whether a limitation is material is handled as a question of obviousness.

Berman Opposition to Preliminary Motion (1), p. 8. Applying this theory Berman argues that the subject matter of Claim 1 of the 1990 Housey patent and claim 5 of the 1993 Housey patent would have been obvious from the subject matter of Berman claim 27 (assuming that subject matter to be prior art) in combination with certain prior art references. Berman also relies on the declaration of Dr. Anthony B. Chen as evidence of obviousness.

We do not agree with Berman that the decision whether a party was claiming “the same or substantially the same subject matter” as that language is used in 35 U.S.C. § 135(b) is governed by the obviousness standard of 35 U.S.C. § 103. Berman has cited no authority which so holds.

The crux of Berman’s argument is that the meaning of the phrase “same patentable invention” as used in the interference regulations is the same as the meaning of the phrase “the same or substantially the same subject matter” used in 35 U.S.C. § 135(b). “Same patentable invention” is defined in 37 CFR § 1.601(n). Section 1.601(n) provides in part:

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”.

A review of the interference regulations indicates that the phrase “same patentable invention,” and its definition in § 1.601(n), are relevant only to 35 U.S.C. § 135(a). Section 135(a) provides:

(a) 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, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as

the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office. [Emphasis added.]

The section authorizes the declaration of an interference when the Commissioner is of the opinion that an application interferes with another application or an unexpired patent. The statute also specifies the effect of an adverse final decision on the “involved” claims of a “losing” party. An “involved claim” is a claim designated as corresponding to a count. 37 CFR § 1.601(f). Except for § 1.601(n), which defines the meaning of “same patentable invention,” every occurrence of that phrase relates either to the existence of an interference (37 CFR §§ 1.601(i); 1.601(j); 1.604; 1.605(b); and 1.633(b)) or to identifying the involved claims, i.e., those that correspond to the count (37 CFR §§ 1.603; 1.606; 1.609(b)(2) and (3); 1.611(c)(8); and 1.637(c)(1)(iv), (c)(2)(ii), (c)(3)(ii), (c)(4)(ii), (c)(5)(iv), and (g)(2)(v)). For example, 37 CFR § 1.601(i) and (j) define interference and interference-in-fact in terms of the “same patentable invention.” These sections provide:

(i) An interference is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. An interference may be declared between two or more pending applications naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention. An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an examiner, any application and any unexpired patent contain claims for the same patentable invention.^[3] [Emphasis added.]

³ The concept of “same patentable invention” was also used to define interference under the “old” interference rules. Thus, 37 CFR § 1.201(a) (1984) provides:

(a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(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.

[Emphasis added.]

These sections, which identify interfering subject matter in terms of claims “directed to the same patentable invention,” are consistent with precedent holding that an interference may be declared where the inventions are not patentably distinct under 35 U.S.C. §§ 102 and 103. Thus, in Aelony v. Arni, 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977) the court stated:

We believe that these board precedents correctly set forth the test of interference in fact and are grounded on sound policy considerations. Sections 102, 103, and 135 of 35 USC clearly contemplate — where different inventive entities are concerned — that only one patent should issue for inventions which are either identical to or not patentably distinct from each other.

[Footnote omitted.]

Section 1.606 exemplifies the regulations relating to which claims are “involved” in the interference. That section (along with § 1.601(f)) defines the involved claims as all the claims which define the same patentable invention as the count. Sections 1.606 and 1.601(f) provide in part:

§ 1.606

All claims in the application and patent which define the same patentable invention as a count shall be designated to correspond to the count.

§ 1.601(f)

Any claim of an application or patent that is designated to correspond to a count is a claim involved in the interference within the meaning of 35 U.S.C. 135(a).

The other sections which use the phrase “the same patentable invention” similarly relate to either identifying interfering subject matter or the claims involved in the interference. This consistent use of the phrase “same patentable invention” with relationship to the terms used in § 135(a) indicates that the phrase provides guidance with respect to the application of § 135(a) and interpretation of the words and phrases “interfere,” “interference” and “claims involved in the interference” used therein.

On the other hand, none of the regulations which use the phrase “same patentable invention” has any relationship to § 135(b). Section 135(b) does not use the words “interference,” “interfere” or “claims involved in the interference.” Rather, the bar of that section is specified in terms of the “the same or substantially the same subject matter.” The use of different language in the proximate subsections of the same statute gives rise to a presumption that the different language implies a

different meaning. See Russello v. United States, 464 U.S. 21, 22-23, 104 S.Ct. 296, 300 (1983); Hoechst-Roussel Pharmaceuticals, Inc. v. Lehman, 109 F.3d 756, 759, 42 USPQ2d 1220, 1224 (Fed. Cir. 1997); Cabell Huntington Hosp., Inc. v. Shalala, 101 F.3d 984, 989 (4th Cir. 1996). Had Congress meant § 135(b) to bar a claim directed to subject matter which “interfered” with the subject matter claimed in a patent it could have easily written the statute using that language. Instead, the Congress used the clearly different language “same or substantially the same subject matter” as the standard to be applied. Berman has not directed us to anything that suggests Congress intended that the meaning of “interfere” and “same or substantially the same subject matter” are the same notwithstanding the difference in language.

Berman relies upon Reiser v. Williams, 255 F.2d 419, 422, 118 USPQ 96, 99 (CCPA 1958) and Stalego v. Heymes, 263 F.2d 334, 335, 120 USPQ 473, 475 (CCPA 1959) to support its theory that a claim meets the “the same or substantially the same subject matter” requirement of § 135(b) if the subject matter of a claim filed before the critical date would have rendered the subject matter of the later claims obvious. In our view, neither case supports Berman’s argument. In Reiser v. Williams, Reiser asserted that Williams did not copy claims prior to the critical date. The board held that § 135(b) did not bar the interference because Williams’ claim 6 was made prior to the critical date and was directed to substantially the same subject matter. The court made a limitation by limitation comparison of Williams claim 6 with the counts (which were identical to the copied claims). The court stated:

we conclude that the differences between the counts and claim 6 of Williams involve mechanical expedients only and that the essential patentable subject matter is the same in each case. [Emphasis added.]

Riser, 255 F.2d at 421, 118 USPQ at 98. In Stalego v. Heymes, Stalego asserted that Heymes had not copied claims prior to the critical date. The board held that § 135(b) did not apply because Heymes had been continuously claiming substantially the same subject matter since prior to the critical date. The court again undertook a limitation by limitation comparison of the counts and Heymes claim 1. The court stated with respect to count 2 that

count 2 and Heymes et al. claim 1 are directed to substantially the same invention, since they relate to substantially identical processes designed to produce the same result and differ only in minor details which do not materially affect the results obtained. [Emphasis added.]

Stalego, 263 F.2d at 339, 120 USPQ at 478. In these cases, the earlier filed claims satisfied § 135(b) because they were directed to the same “essential patentable subject matter” or “to substantially identical processes.” Neither case applied the broad obviousness standard now asserted by Berman. And our attention has not been directed to any case that applied the general obviousness standard of 35 U.S.C. § 103 in considering the applicability of § 135(b). Compare, Aelony, 547 F.2d at 570, 192 USPQ at 490. In addition, a comparison of the subject matter of Berman’s claim 27 with the subject matter of Housey’s claims shows that Berman’s antibody is not directed to the same “essential patentable subject matter” or to a “substantially identical process” as Housey’s method claims.

Accordingly, we reject Berman’s obviousness theory. Since we do not agree that with Berman’s theory we decline to address the issue of whether the subject matter of Berman’s claim 27 in combination with prior art renders the subject matter of certain of Housey’s involved claims obvious. We therefore need not consider the Chen declaration.

Berman’s claim 64 is barred by 35 U.S.C. § 135(b).

LIMITED REMAND TO APJ

We remand this interference to the APJ to conduct any further proceedings, not inconsistent with this opinion, which may be necessary.

This panel decision is law of the case. See 37 CFR § 1.640(c) with respect to any request for reconsideration of this decision.

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

cc: (via Federal Express)

Attorneys for Housey:

Steven J. Lee, Esq.
Henry S. Hadad, Esq.
KENYON & KENYON
One Broadway
New York, NY 10004

Tel: 212-425-7200
Fax: 212-425-5288
E-Mail None

Attorney for Berman:

R. Danny Huntington
BURNS, DOANE, SWECKER &
MATHIS, L.L.P.
1737 King Street
Alexandria, VA 22314-2756

Tel: 703-836-6620 (Main)
Fax: 703-836-2021
E-Mail: DannyH@BurnsDoane.com