

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 58

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PHILLIP A. FURMAN and GEORGE R. PAINTER, III,

Junior Party,
(Application 07/775,187),

v.

YUNG-CHI CHENG,

Senior Party
(Application 08/463,960).

Patent Interference No. 104,523 (SGL)

Before: McKELVEY, Senior Administrative Patent Judge, and
TORCZON and GARDNER-LANE, Administrative Patent Judges.

PER CURIAM.

**MEMORANDUM OPINION and ORDER
(Decision on preliminary motions)**

A. Introduction

The interference is before a Trial Section Motions Panel for decision on preliminary motions.

Furman Preliminary Motion 1 (Paper 20) attacks benefit for the purpose of priority accorded to Cheng in the NOTICE DECLARING INTERFERENCE (Paper 1, page 46). 37 CFR § 1.633(g). Cheng has

opposed (Paper 32) and Furman has filed a reply (Paper 39).

According to Furman, Cheng should not have been accorded benefit for the purpose of priority as to Cheng application 07/686,617 (filed 17 April 1991) (Ex 2001) or Cheng application 07/718,806 (filed 21 June 1991) (Ex 2002).

Furman has the burden of proof (37 CFR § 1.637(a)). The standard of proof is by a preponderance of the evidence.

B. "Benefit" of an earlier filing date

In view of the manner in which the parties have argued the "benefit" issue before us, we deem it appropriate to discuss benefit for the purpose of priority and to contrast that "benefit" with benefit for the purpose of overcoming prior art under 35 U.S.C. §§ 119 or 120. See also

1.

Resolution of a right to benefit under 35 U.S.C. §§ 119 or 120 arises only when a claim of a party is alleged to be unpatentable under 35 U.S.C. §§ 102 or 103 over a non-statutory bar reference with a prior art date prior to the filing date of the party. One way of overcoming an allegation of unpatentability is to obtain benefit, under 35 U.S.C. §§ 119 or 120, of a filing date of an earlier filed U.S patent application (§ 120) or an earlier filed foreign patent application (§ 119).

An earlier filed foreign or domestic application is not examined to determine whether a party is actually entitled to the benefit of an earlier filing date except when an earlier filing date is actually needed. In re Shaw, 202 USPQ 285, 292 (Comm'r

Pat. 1978). In an interference, the need for benefit under 35 U.S.C. §§ 119 or 120 arises when (1) a party files a preliminary motion under 37 CFR § 1.633(a) for judgment alleging unpatentability over the prior art of an opponent's claims and (2) the opponent opposes on the ground that it is entitled to benefit under 35 U.S.C. §§ 119 or 120.

To obtain benefit under 35 U.S.C. § 120, a party must establish that an earlier U.S. application complies with the first paragraph of 35 U.S.C. § 112 with respect to each claim for which benefit is desired. 35 U.S.C. § 120; In re Lukach, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (to be entitled to § 120 benefit, subject matter claimed in continuing application must be described in parent in manner required by § 112).

To obtain benefit under 35 U.S.C. § 119, a party must also establish that an earlier foreign application complies with the first paragraph of 35 U.S.C. § 112, again with respect to each claim for which benefit is desired. In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); In re Wertheim, 541 F.2d 257, 261, 191 USPQ 90, 95-96 (CCPA 1976).

A party may be entitled to benefit under §§ 119 or 120 as to one claim, but not for another claim. Accordingly, a party claiming benefit to overcome prior art under 35 U.S.C. §§ 119 or 120, must independently establish its entitlement to benefit for each claim for which benefit is urged. As to those claims where the benefit date is prior to the effective prior art date of a reference, the reference is overcome.

Benefit for the purpose of priority in an interference declared under 35 U.S.C. § 135(a) is something different than benefit for the purpose of overcoming prior art. Anderson v. Norman, 185 USPQ 371 (Comm'r Pat. 1968) (an earlier disclosure of a species is a constructive reduction to practice of a count expressing a genus; according benefit for purpose of priority is different from according benefit to get around prior art).

a.

In each interference, there is at least one count. The initial count is set out in a NOTICE DECLARING INTERFERENCE. A count defines the interfering subject matter. 37 CFR § 1.601(f). The claims of the parties which are involved in the interference within the meaning of 35 U.S.C. § 135(a) are designated to correspond to the count. A claim designated as corresponding to a count may be broader or narrower in scope than the count. A presumption exists that all claims of all parties which are designated as corresponding to a count are presumed to cover, in whole or in part, subject matter which defines the same patentable invention. A party may seek to overcome the presumption by filing a preliminary motion to designate a claim as not corresponding to the count. 37 CFR § 1.633(c)(4).

The presumption is important. If a party believes that a claim designated as corresponding to a count does not interfere-in-fact with any claim of its opponent, the party should file a preliminary motion to have its claim designated as not corresponding to the count. If no preliminary motion is filed, and a party loses on the issue of priority, then on that issue

all of a party's claims designated as corresponding to the count fall together. Likewise, if a preliminary motion is filed, but is denied, then on the issue of priority all claims designated as corresponding to a count fall together. On the other hand, if a party files a preliminary motion for judgment based on alleged unpatentability of its opponent's claims, the party must address each claim individually. 37 CFR § 1.633(a). Thus, on unpatentability issues raised under 37 CFR § 1.633(a), the claims do not fall together--on the merits of the prior art or attempts to obtain benefit under 35 U.S.C. §§ 119 or 120, unless the opponent fails to oppose separately. However, with respect to priority, all claims designated as corresponding to the count fall together both as to priority proofs and benefit for the purpose of priority.

b.

According benefit for the purpose of priority establishes a party's date which an opponent must "overcome." If the opponent cannot overcome a benefit date, the opponent loses on the issue of priority. Since at least some of the subject matter of all of the opponent's claims which have been designated as corresponding to the count cover a single patentable invention and because the party established priority vis-a-vis the opponent, all of the opponent's claims corresponding to the count become unpatentable.

The fact that a party "wins" an interference does not per se mean the party is entitled to a patent. What is clear, however,

is that a party who loses an interference is not entitled to a patent with claims designated as corresponding to the count. Entry of a judgment against a party in an interference is final decision of the Patent and Trademark Office refusing those claims. 35 U.S.C. § 135(a). Hence, it becomes manifest that an adverse decision on priority is patent defeating.

According benefit for the purpose of priority (i.e., a constructive reduction to practice) and proof of priority on the merits (i.e., conception, actual reduction to practice and, if necessary, diligence) involve similar concepts. Proof of a prior actual reduction to practice of a species within the scope of a count, prior to an opponent's date, results in an award of priority against the opponent. Benefit for the purpose of priority functions in much the same way. Thus, a benefit application need only describe a single enabled embodiment within the scope of the count to constitute a constructive reduction to practice of the invention of the count. Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975); see also Weil v. Fritz, 572 F.2d 856, 865 n.16, 196 USPQ 600, 608 n.16 (CCPA 1978) (as Hunt v. Treppschuh *** explains, "the § 112 paragraph, requirements need only be met for an embodiment within the count" where the count is drawn to a genus and the previously-filed application discloses only a species thereof). In establishing benefit for the purpose of priority, it is not necessary to establish that a benefit application complies with the first paragraph of 35 U.S.C. § 112 as to a claim of a party's involved patent or application.

C. Scope of the count

It is our view that this case has been made somewhat complicated by the fact that the parties do not seem to have applied the principles set out above in connection with their respective litigation strategy associated with Furman Preliminary Motion 1. For example, Furman alleges in its preliminary motion (Paper 20, page 2) that (emphasis added):

Cheng should not be accorded benefit [for the purpose of priority] of the Cheng '617 application *** or the Cheng '806 application *** because the Cheng claims corresponding to Count 1 are limited to the use of particular compounds ***.

Benefit is accorded with respect to a count, not claims corresponding to a count. Thus, to determine whether Cheng is entitled to benefit, we first need to determine the scope of the count.

There is but one count. It reads as follows (Paper 1, page 47):

A method according to claims 1, 2, 3 or 5 of Furman application 07/775,187

or

a method according to claims 3, 37, 40, 41, 152, 153, 156 or 157 of Cheng application 08/463,960.

The count "consists" of the sum of the scopes of Furman claims 1, 2, 3 and 5 and the sum of the scopes of Cheng claims 3, 37, 40, 41, 152, 153, 156 and 157. Proof of a constructive reduction to practice of a species within the scope of any one of the mentioned Furman or Cheng claims constitutes a basis for

according benefit for the purpose of priority.

The scope of the mentioned Furman and Cheng claims differ. Highly relevant to Cheng's benefit for the purpose of priority is the alternative of Count 1 represented by Furman claim 2. Furman claim 2 reads:

A method of interfering with HBV [meaning hepatitis B virus] production in an HBV infected host comprising the administration of an effective HBV production interfering amount of the compound 1-(2-(hydroxymethyl)-1,3-oxathiolan-5-yl)-cytosine to said HBV infected host.

If Cheng can establish that its benefit applications constitute a constructive reduction to practice of the subject matter of Furman claim 2 (one alternative of the count) then Cheng can establish its right to benefit for the purpose of priority as to Count 1. Since that benefit was accorded in the NOTICE DECLARING INTERFERENCE, it becomes Furman's burden to establish (37 CFR § 1.637(a)) that Cheng's benefit applications do not constitute a constructive reduction to practice of any alternative of the count, including Furman claim 2. The mere fact that Cheng may not be entitled to benefit for the purpose of priority, say of Cheng claim 3¹ corresponding to the count, does not mean Cheng is not entitled to benefit for the purpose of priority with respect to another Cheng or Furman claim mentioned in the count.

¹ Furman claim 3 is directed to a methyl substitute compound, which probably is not described in the '806 and '617 applications given its definition of R as limited to hydrogen (H) and fluoro (F).

D. Findings of fact on the merits

The following findings are supported on this record by at least a preponderance of the evidence.

The issue

1. In the NOTICE DECLARING INTERFERENCE (Paper 1, page 46), Cheng was accorded benefit for the purpose of priority of several patent applications, including:

- a. Cheng U.S. application 07/686,617 (filed 17 April 1991) (Ex 2001) and
- b. Cheng application 07/718,806 (filed 21 June 1991) (Ex 2002).

2. The issue before us is whether Furman has established that the two Cheng benefit applications do not constitute a constructive reduction to practice of the invention defined by Count 1.

3. As we see it, the issue narrows to whether Furman has established that the two Cheng benefit applications do not constitute a constructive reduction to practice of the subject matter of Furman claim 2.

The invention

4. The invention relates to treatment of hepatitis B viral infections in mammals, including humans.

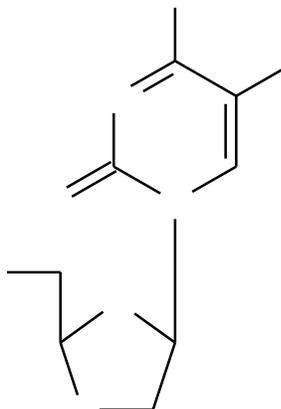
5. Furman involved application 07/775,187 was filed on 11 October 1991.

6. Furman has been accorded the benefit for the purpose of priority of a British patent application filed on

2 May 1991 (Paper 1, page 45).

7. According to Furman (specification, pages 2-3):²

We have now surprisingly found that
1-(2-(hydroxymethyl)-1,3-oxathiolan-5-yl)-cytosines
of formula I



wherein R is hydrogen or C₁₋₃ alkyl or a pharmaceutically acceptable salt, ester or other physiologically functional derivative thereof have potent activity against HBV [hepatitis B virus].

It should be noted that the compounds of formula I contain two chiral centers and therefore exist in the form of two pairs of optical isomers (i.e. enantiomers) and mixtures thereof including racemic mixtures. Thus the compounds of formula I may be either cis or trans isomers or mixtures thereof. Each cis and trans isomer can exist as one of two enantiomers or mixtures thereof including racemic mixtures. All such isomers and mixtures thereof including racemic mixtures are within the scope of the invention. The

² The Furman specification has not been made an exhibit by either party. Nevertheless, it is part of the record in this particular interference. 37 CFR § 1.671(a)(1) (2000). Rule 671(a) was recently amended. Final Rule, Simplification of Certain Requirements in Patent Interference Practice, 65 Fed. Reg. 70489, 70490 (Nov. 24, 2000). In the future in this and other interferences, all evidence must be presented in the form of an exhibit.

cis isomers of the compound of formula I are preferred.

8. Cheng involved application 08/463,960 was filed on 5 June 1995.

9. Cheng benefit application 07/718,806 ('806) was filed on 21 June 1991 (Ex 2002).

10. Cheng benefit application 07/686,617 ('617) was filed on 17 April 1991 (Ex 2001).

11. Cheng has been accorded benefit for the purpose of priority of both the '806 and the '617 applications (Paper 1, page 46).

12. Cheng '806 makes the following observation (Ex 2002, pages 14-15) (indentation and paragraph numbering in brackets added):

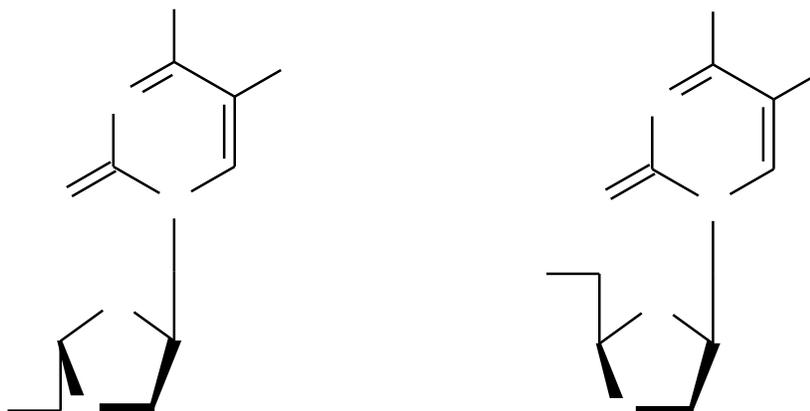
The present invention concerns a method involving the administration of

[1] (-)3'-thia-2',3'-dideoxycytidine,

[2] (±)3'-thia-2',3'-dideoxycytidine,

*** (referred to herein as "the compounds of formula (I)" or a salt or ester thereof, alone or in admixture with a pharmaceutically acceptable carrier in order to treat patients suffering from hepatitis B virus or to prevent hepatitis B virus infection.

Formula (I) is as follows:



wherein R is selected from the group consisting of H [hydrogen] and F [fluoro].

13. The Cheng '806 specification tells us that
(Ex 2002, page 7):

Unless indicated to the contrary, whenever 3'-thia-2',3'-dideoxycytidine without a plus or minus sign before it is stated herein, it is understood that such means (\pm)3'-thia-2',3'-dideoxycytidine ***.

14. Cheng '617 makes the following observation
(Ex 2001,³ renumbered pages 0012-0013-11) (indentation and paragraph numbering in brackets added):

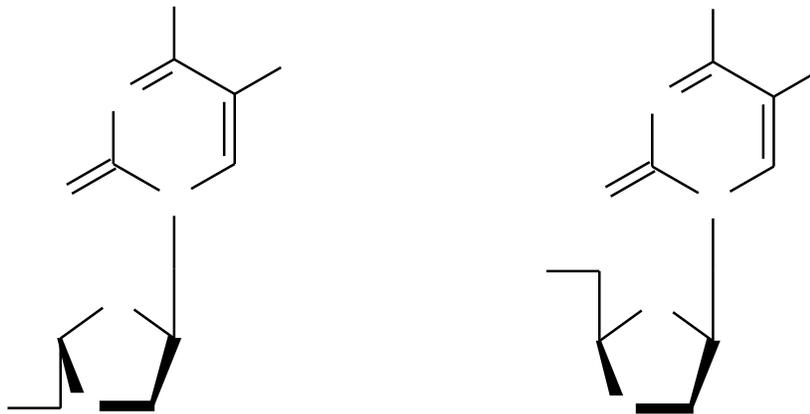
The present invention concerns a method involving the administration of

- [1] 3'-thia-2',3'-dideoxycytidine,
- [2] 3'-thia-2',3'-dideoxycytidine

³ Furman presented Ex 2001 which includes the '617 specification drawings. Ex 2001 is not a full and correct reproduction of the '617 specification inasmuch as the top portion of numerous pages is missing. The copies of the drawings are not clear. Where necessary we have consulted the actual specification.

*** (referred to herein as "the compounds of formula (I)" or a salt or ester thereof, alone or in admixture with a pharmaceutically acceptable carrier in order to treat patients suffering from hepatitis B virus or to prevent hepatitis B virus infection.

Formula (I) is as follows:



wherein R is selected from the group consisting of H [hydrogen] and F [fluoro].

As referred to herein, formula (I) refers to either or both of the above structures or a mixture thereof.

Testimony

15. Both Furman and Cheng presented testimony of scientists.

16. Dr. John J. Partridge testified on behalf of Furman (Ex 2004 and reply declaration).

17. Cheng elected not to cross-examine Dr. Partridge.

18. Dr. Jonathan S. Dordick testified on behalf of Cheng (Ex 1001).

19. Furman elected not to cross-examine Dr. Dordick.

20. On this record, it should be manifest even to the casual observer that Furman and Cheng use different chemical terminology to describe what is the same "compound"--at least in the generic sense and putting aside possible stereoisomers of the "compound."

21. Dr. Partridge correctly testifies that 1-(2-(hydroxymethyl)-1,3-oxathiolan-5-yl)-cytosines (the terminology used by Furman) can also be called 3'-thia-2',3'-dideoxycytidine (the terminology used by Cheng) (Ex 2004, renumbered page 0008).

22. Dr. Partridge further correctly testifies that the "compound" 1-(2-(hydroxymethyl)-1,3-oxathiolan-5-yl)-cytosine (again, the terminology used by Furman) and the "compound" 3'-thia-2',3'-dideoxycytidine (again the terminology used by Cheng) can exist as four stereoisomers and as two racemates (Ex 2004, renumbered page 0007).

23. As explained by Dr. Partridge, the Furman "compound" and the Cheng "compound" (i.e., the same compound) exists in six stereoisomeric forms (Ex 2004, page 4):

- (1) two enantiomers of the cis isomers;
- (2) two enantiomers of the trans isomers; and
- (3) a cis racemate; and
- (4) a trans racemate.

There are two cis and two trans enantiomers because the "compound" has two chiral "centers," i.e., the two carbon atoms on either side of the oxygen (O) in the 5-member ring portion.

24. Dr. Partridge supports his explanation graphically

with the following depiction of the chemical structures of the various stereoisomers (Ex 2004, page 5):

where R is H (hydrogen).

25. Dr. Partridge tells us the following with respect to Compound B shown in his graph (Ex 2004, page 7):

Compound B is named (-)-cis-1-(2-(hydroxymethyl)-1,3-oxathiolan-5yl)cytosine and is also known as (2R, cis-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidin-2-one or lamivudine. Compound B is an active ingredient in the marketed drugs COMBIVIR®, EPIVIR® and

EIPVIR-HBV®.

26. According to Dr. Partridge, the Cheng '806 application is directed to a compound named "(-)3'-thia-2',3'-dideoxycytidine" and when the name of the compound is considered in light of chemical structures in the '806 application, the named compound "defines one of the two trans stereoisomeric forms of 1-(2-(hydroxymethyl)-1,3-oxathiolan-5yl)cytosine" (Ex 2004, page 13).

27. Further according to Dr. Partridge, Formula (I) of the Cheng '617 application represents (Ex 2004, page 8):

one stereoisomer of 1-(2-(hydroxymethyl)-1,3-oxathiolan-5yl)cytosine called "3'-thia-2',3'-dideoxycytidine" and one trans stereoisomer of 1-(2-(hydroxymethyl)-1,3-oxathiolan-5yl)cytosine, respectively. Therefore the Cheng '617 (FE 2001 [i.e., Ex 2001]) application teaches the ordinary artisan that administration of either or both of these two compound having the formula (I) is useful for the treatment of HBV infection.

28. Dr. Partridge alleges that (Ex 2004, page 15):
one of ordinary skill in the art would not have known from the *** disclosures contained in both the '617 *** and '806 *** applications that cis-1-(2-(hydroxymethyl)-1,3-oxathialan-5-yl)cytosine *** and (-)-cis-1-(2-(hydroxymethyl)-1,3-oxathiolan-5-yl)(cytosine (Compound B) are useful in the treatment of HBV infections.

29. Dr. Partridge does not appear to have been educated by counsel for Furman as to the breadth of Count 1.

30. In particular, it is not apparent on this record that Dr. Partridge considered the scope of that portion of

Count 1 represented by Furman claim 2.

31. Dr. Partridge appears to have assumed that the invention involved in this case is limited to a cis-stereoisomer, possibly because various cis-stereoisomers are commercially important.

32. However, included within the scope of Count 1 are the trans stereoisomers and the Furman specification states that the trans form of the compound is useful for treating HBV (see Finding 7).

33. Both Cheng '806 and Cheng '617 include drawings containing Figs. 1-5⁴ (Ex 2001, renumbered pages 0008 through 0010; 0055 through 0059; Ex 2002, renumbered pages 0011 through 0013 and 0069 through 0071).

34. Insofar as we can tell, Dr. Partridge does not discuss the drawings and related discussion in the specification of the '806 and '617 applications.

35. Example 12 of '806 and Example 11 of '617 contain the following discussion:

2.2.15 cell lines was used to evaluate the antiviral activities of *** 3'-thia-2',3'-dideoxycytine (SddC).

* * *

The antiviral effects were measured by analysis of extracellular HBV DNA (Fig. 1). The experiment revealed that the amount of extracellular HBV DNA decreased in a dose dependent manner. The inhibitory concentration for a 50% decrease in viral replication (BHID₅₀) *** is presented in Table 1. At [a] concentration of 2 M, *** 3'-thia 2',3'-dideoxycytidine completely inhibited the replication of HBV.

⁴ Cheng '806 includes other figures in its drawings.

36. According to Table 1 (e.g., Ex 2001, renumbered page 0045), 3'-thia-2',3'-dideoxycytine produced the following numerical results:

(1)	HBID ₅₀ ⁵	0.05 M
(2)	MTID ₅₀ ⁶	47 M
(3)	ED ₅₀ ⁷	37 M
(4)	S.I. ⁸	740
(5)	ED ₅₀ /MTID ₅₀	0.79

37. While each party had an opportunity to do so, neither attempted to repeat the tests described in the Examples, Table 1 and Fig. 1 of the drawings to determine which isomer or racemic mixture would inherently produce the results set out in Table 1 and Fig. 1 of the drawings.

38. Accordingly, while we credit the testimony of Dr. Partridge to the extent he explains stereoisomeric chemistry; we decline to credit his testimony to the extent Furman relies on that testimony to establish that Cheng '806 and '617 do not describe an embodiment within the scope of Count 1.

Adjudicatory findings

39. Furman has not established as a matter of fact that Cheng '806 does not describe an embodiment within the scope of Furman claim 2 and therefore does not describe an embodiment

⁵ Concentration which caused a 50% reduction in HBV replication.

⁶ Concentration which caused a 50% reduction in mitochondria DNA content.

⁷ Concentration which caused a 50% reduction in cell density.

⁸ Selective Index (ED₅₀/MBID₅₀).

within the scope of Count 1.

40. Furman has not established as a matter of fact that Cheng '617 does not describe an embodiment within the scope of Furman claim 2 and therefore does not describe an embodiment within the scope of Count 1.

E. Discussion

1.

As noted earlier, a party is entitled to benefit for the purpose of priority if its earlier application describes an embodiment within the scope of the count. As our findings make clear, Furman has failed to establish that Cheng '806 and '617 do not describe embodiments within the scope of Count 1. Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975).

Insofar as we can tell, Furman's preliminary motion makes no attempt to establish that Cheng does not describe an embodiment within the scope of Furman claim 2 which is within the scope of Count 1. We recognize that Dr. Partridge has testified that he believes that the Cheng benefit applications do not describe specific isomers, albeit he concedes certain isomers are described. Dr. Partridge does not purport to have first-hand knowledge of the tests described in Example 11 of '617 and Example 12 of '806 or of the Table presented in Table 1 and Fig. 1 of the drawings. We find no analysis of that data by Dr. Partridge. In particular, we note that on the record, despite an opportunity to do so, Furman has not established that no relevant isomer or racemic mixture is inherently in the examples, Table 1 and Fig. 1. Accordingly, Furman has failed to

prima facie establish, as was its burden, that Cheng should not have been accorded benefit for the purpose of priority of the Cheng '806 and '617 applications. Furman Preliminary Motion 1 should be denied.

2.

Furman and Dr. Partridge have construed Count 1 too narrowly. Contrary to the assertion in Furman's preliminary motion, to be accorded benefit for the purpose of priority Cheng does not have to establish that one or more of its claims involved in the interference are described in the Cheng '806 and '617 applications. A description of an enabled embodiment is sufficient.

At oral argument, counsel for Furman argued that only the cis form is operative and that the cis form is commercially significant. An argument made for the first time at oral argument comes too late. LeVeen v. Edwards, 57 USPQ2d 1406, 1414 (Bd. Pat. App. & Int. 2000); Packard Press Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 1360, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000); Henry v. Department of Justice, 157 F.3d 863, 865 (Fed. Cir. 1998). Had Furman timely made the argument, Cheng might have provided evidence to the contrary. In this particular case, the Furman specification itself provides an answer inasmuch as it indicates that both the cis and trans forms of the compound are within the scope of the Furman invention, an invention said to involve compounds useful for treating hepatitis B. In this case, we believe Furman should have to live with the representations made in its specification. Cf. Power Patents Co. v. Coe, 110

F.2d 550, 551, 44 USPQ 389, 390 (D.C. Cir. 1940) (if a feature is inherent in a disclosed process, the applicant may claim the feature although he does not in terms disclose it; court was not inclined to extend this principle to a case in which the language of the disclosure negatives the feature which is now claimed to inhere in it); Chemithon Corp. v. The Procter & Gamble Co., 287 F.Supp. 291, 304, 159 USPQ 139, 150 (D. Md. 1968) (same).

Moreover, we note that Dr. Partridge never alleges that the trans form of the compound will not function as an HBV inhibitor.

Counsel for Furman may have reason to believe that the cis form is preferred. The Furman specification would confirm counsel's belief (page 3, lines 1-2). Nevertheless, Furman claim 2 cannot properly be construed, when considered in light of the Furman specification, to be limited to a cis embodiment, as was suggested at oral argument.

In this case, and if Furman believed the cis embodiment is patentably distinct from the trans or racemate embodiments, Furman had an opportunity to file a preliminary motion to seek to narrow the count to the cis embodiment or to add a second count limited to the cis embodiment and to argue that Cheng would not have been entitled to benefit for the purpose of priority as to the narrow cis count. 37 CFR § 1.633(c). Furman did not take advantage of the opportunity offered to it by the rules. Accordingly, we have no occasion to make any findings or conclusions of law, in this case, as to whether a narrow count would have been appropriate or whether any cis form is patentably distinct from any trans or racemic form of the compound.

F. Order

Upon consideration of Furman Preliminary Motion 1, and for the reasons given, it is

ORDERED that the motion is denied.

FRED E. MCKELVEY, Senior Administrative Patent Judge

RICHARD TORCZON, Administrative Patent Judge

SALLY GARDNER-LANE, Administrative Patent Judge