

THIS OPINION IS A PRECEDENTIAL OPINION

The opinion below has been designated by the Board as precedential with respect to Part I of the opinion relating to the summary judgment practice of the Board. The remainder of the opinion (1) was not written for publication in a law journal and (2) is not binding precedent of the Board. The judgment issued August 13, 1997.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GARO BASMADJIAN and STANLEY L. MILLS

Junior Party,

v.

DONALD W. LANDRY and KANG ZHAO

Senior Party.

Patent Interference No. 103,694

Before: STONER, Chief Administrative Patent Judge, and
McKELVEY, Senior Administrative Patent Judge, and HANLON,
Administrative Patent Judge.

McKelvey, Senior Administrative Patent Judge

MEMORANDUM OPINION AND ORDER
GRANTING SUMMARY JUDGMENT AGAINST BASMADJIAN AND MILLS
(37 CFR § 1.617)

This interference is before a merits panel for a determination of whether summary judgment should be entered against Basmadjian and Mills (Basmadjian), the junior party applicant in this junior party applicant versus senior party patent interference. We conclude that entry of summary judgment is appropriate.

I.

Summary judgment practice in patent interference proceedings before the Patent and Trademark Office

There have been "summary judgment" proceedings in patent interference proceedings in the Patent and Trademark Office (PTO) since January 1, 1965. 29 Fed. Reg. 15866 (Nov. 26, 1964) (amending 37 CFR § 1.204(b) and adding 37 CFR §§ 1.204(c) and 1.228)). We take this opportunity to (1) discuss generally summary judgment practice in patent interferences, (2) address concerns which have been mentioned in opinions entered in our appellate reviewing court, the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), and (3) clarify the appropriate substantive evidentiary standard applicable in resolving summary judgment proceedings in patent interference cases.

A.

**Why does patent interference practice include
a summary judgment procedure?**

The rationale in support of summary judgment proceedings in patent interferences is articulated in Kistler v. Weber, 412 F.2d 280, 285, 162 USPQ 214, 218-19 (CCPA 1969) (CCPA's footnotes omitted):

The expense involved in a protracted interference, and the special hardships workable on a patentee involved therein, are notorious, and to minimize both, where possible, would appear to be the laudable purpose of these rules. If a junior party [applicant] is in fact "a first inventor" and if he could prove that in a "full hearing on priority," we see no reason why he should be prejudiced or unduly burdened by a requirement that he prove (prior to a "full hearing") by way of affidavits and documentary evidence that he is at least prima facie entitled to an award of priority over the patentee's effective filing date.

By "these rules," the CCPA is referring to former Rules 204(c) [37 CFR § 1.204(c)] and 228 [37 CFR § 1.228]. Rule 204(c), then in effect, is reproduced in footnote 1 of the CCPA's opinion. Rule 228, then in effect, is reproduced in footnote 4 of the

CCPA's opinion. The corresponding rules today are Rule 608(b) [37 CFR § 1.608(b)] and Rule 617 [37 CFR § 1.617)].

B.

**What is required to avoid summary judgment
in a patent interference proceeding?**

An interference may be declared between a pending application and an unexpired patent. 35 U.S.C. § 135(a); 37 CFR § 1.606. When the effective filing date of the application is more than three (3) months after the effective filing date of a patent, before an interference will be declared, the applicant is required to file:

- (1) evidence which demonstrates that the applicant is prima facie entitled to a judgment vis-à-vis the patentee, and
- (2) an explanation stating with particularity the basis upon which the applicant would be entitled to the judgment.

37 CFR § 1.608(b). The evidence and explanation are often referred to as a "Rule 608(b) showing."

The evidence may consist of patents, printed publications, other documents and one or more affidavits. Id. The term "affidavit" includes a declaration. 37 CFR § 1.601(b). "Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit." 37 CFR § 1.608(b).

In the event a witness is not available, an affidavit may be based on "information and belief." The affidavit should state what it is believed the witness would say if the witness had been available. 37 CFR § 1.608(b); Golota v. Strom, 489 F.2d 1287, 1293, 180 USPQ 396, 400-401 (CCPA 1974); Surabian v. Brecher, 16 USPQ2d 1312, 1314 (Bd. Pat. App. & Int. 1990). Generally a witness is not available if the witness' "testimony" must be compelled under 35 U.S.C. § 24, 37 CFR § 1.671(g) and 37 CFR § 1.672(a).

When the basis upon which an applicant attempts to establish a prima facie case for judgment vis-à-vis the patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant. Id. Alternatively, the evidence may relate to patentability and need not be restricted to priority. Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 84816, 48421 col. 3 (Dec. 12, 1984), reprinted in 1050 Off. Gaz. Pat. Office 385, 390 col. 3 (Jan. 29, 1985). For example, an applicant can establish that it is entitled to a judgment vis-à-vis a patentee based on a prima facie showing of the unpatentability of the invention to the patentee under the first paragraph of 35 U.S.C. § 112, e.g., that the patentee's specification is not enabling. Compare Gould v.

Hellwarth, 472 F.2d 1383, 176 USPQ 515 (CCPA 1973), where the senior party's specification was held to be non-enabling. In summary judgment proceedings in patent interference cases, the applicant's specification is presumed to be enabling. If it were otherwise, the primary examiner would not have forwarded the application and patent to the board for declaration of an interference. Rather, the applicant's claims would have been rejected ex parte for failure to comply with the how to make or use requirement of the first paragraph of 35 U.S.C. § 112.

C.

Why do the rules require that non-self-authenticating documents be described with particularity?

"Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit." 37 CFR § 1.608(b). An example of a document which is not self-authenticating is a laboratory notebook customarily maintained by research personnel, particularly notebooks maintained in chemical and biotechnological research organizations in the United States. Prior to the rule changes in 1984, there was judicial and administrative precedent which should have discouraged the submission of unexplained non-self-authenticating documents. Chandler v. Mock, 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless); Smith v. Bousquet, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in

stipulated testimony are entitled to little weight); Popoff v. Orchin, 144 USPQ 762 (Bd. Pat. Int. 1963) (unexplained experimental data should not be considered). See also In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 33 (CCPA 1974) and Triplett v. Steinmayer, 129 F.2d 869, 871, 54 USPQ 409, 411-12 (CCPA 1942). Nevertheless, counsel regularly continued to submit non-self-authenticating documents, particularly laboratory notebooks, without particularized testimony by a witness having first-hand knowledge of the content of a document or the events supposedly set out in the document. Over an objection that the rules "should not be used to train attorneys ***", Notice of Final Rule, supra at 48447 col. 3, 1050 Off. Gaz. Pat. Office at 416, the rules were amended in 1984 to require the particularized explanation of material in non-self-authenticating documents. 37 CFR § 1.608(b) and 37 CFR § 1.671(f). As the Notice of Final Rule states:

By providing in the rules that documentary evidence must be explained, the PTO hopes to save both parties and the Board considerable difficulty in presenting and evaluating evidence.

D.

What is the limited role of a primary examiner in connection with a showing under 37 CFR § 1.608(b)?

When a patent has an effective filing date more than three months before the effective filing date of the application, the

primary examiner determines, ex parte, whether evidence and an explanation have been filed. 37 CFR § 1.608(b), last sentence. The evidence and explanation are considered by the primary examiner "only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged ***" (emphasis added). Id. The primary examiner is concerned only with procedural compliance with the requirements of 37 CFR § 1.608(b). Thus, the primary examiner does not consider the sufficiency on its merits of the applicant's evidence and explanation.

If the primary examiner determines that (1) evidence has not been filed or (2) an explanation has not been submitted or (3) any evidence and explanation, which have been filed, do not allege a basis upon which the applicant would be entitled to a judgment relative to the patentee, the primary examiner will enter an ex parte prior art rejection based on the patent. An interference is not initiated, because the patent is considered to render the applicant's claims unpatentable under 35 U.S.C. § 102(a), 35 U.S.C. § 102(e) or 35 U.S.C. § 103 until such time as the applicant procedurally complies with 37 CFR § 1.608(b).

The primary examiner's final rejection based on a finding that (a) evidence has not been filed or (b) an explanation has not been filed or (c) any evidence and explanation fail to allege a basis upon which the applicant would be entitled to prevail vis-à-vis the patentee may be appealed to the Board of Patent

Appeals and Interferences (board). 35 U.S.C. § 134. Assuming that the applicant is claiming the same patentable invention as the patent, the issue on appeal to the board would not involve the merits of the sufficiency of any evidence and/or explanation. Rather, the appeal would involve a question of whether there has been procedural compliance with 37 CFR § 1.608(b). An applicant dissatisfied with a decision of the board may appeal to the Federal Circuit, 35 U.S.C. § 141, or seek judicial review in the U.S. District Court for the District of Columbia, 35 U.S.C. § 145. Ex parte appeals to the board or the Federal Circuit based on a failure to file evidence, an explanation or allege a basis upon which an applicant is entitled to prevail vis-à-vis the patentee are, and should be, rare. The only known appeal involving an alleged failure to procedurally comply with the explanation requirement of 37 CFR § 1.608(b) in the Federal Circuit is In re Baysdon, Appeal No. 93-1168. In Baysdon, the board had held that an explanation, as required by 37 CFR § 1.608(b), had not been filed by the applicant. The appeal to the Federal Circuit was ultimately settled after briefing and oral argument when Baysdon agreed to file a supplemental explanation.

E.

What is the role of the board and an administrative patent judge assigned to the interference?

When the primary examiner determines that an applicant has submitted evidence and an explanation and has alleged a basis upon which the applicant would be entitled to prevail vis-à-vis the patentee, the primary examiner forwards the application, the patent and other relevant information to the board. 37 CFR § 1.609.

At the board, the matter is assigned to an administrative patent judge (APJ). 37 CFR § 1.610(a). An APJ is an individual appointed as a member of the board pursuant to 35 U.S.C. § 7. An interference is then declared by the APJ. Id. The APJ assigned to the interference reviews the Rule 608(b) showing on its merits (i.e., substantively) to determine whether the applicant has established that it is prima facie entitled to a judgment relative to the patentee. 37 CFR § 1.617(a).

If the APJ determines that the applicant has made out a prima facie case, the interference proceeds in the normal fashion. There is no administrative review of a decision of an APJ accepting as sufficient on its merits a showing under 37 CFR § 1.608(b).

On the other hand, if the APJ determines that the applicant has not made out a prima facie case, then concurrently with the declaration of the interference, an order is entered requiring

the applicant to show cause why "summary judgment" should not be entered against the applicant. 37 CFR § 1.617(a). The APJ is required to articulate the reason or reasons why an order to show cause is believed to be appropriate. Id.

Although a single APJ normally declares an interference and reviews any Rule 608(b) showing, an order declaring an interference and/or an order to show cause may be entered by a three-judge panel. 37 CFR § 1.610(b), last sentence.

The applicant may file a "response" to the order to show cause, explaining why the APJ is believed to have erred in determining that a prima facie case has not been made out by the applicant. 37 CFR § 1.617(b). "Additional evidence" may be submitted with the response. Id. However,

[a]dditional evidence shall not be presented by the applicant or considered by the Board unless the applicant shows good cause why any additional evidence was not initially presented with the evidence filed under § 1.608(b).

Id. The "good cause" standard was first promulgated in the 1984 amendments to the interference rules. Notice of Final Rule, supra. In addition to the Notice of Final Rule, a discussion of the "good cause" standard can be found in Hahn v. Wong, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989). Before 1984, supplemental evidence would be accepted upon a "showing in excuse of *** [the] omission [of the supplemental evidence] from the original

showing." 37 CFR § 1.288 (1984). The language of Rule 288 set "no standard for showing in excuse." Nakayama v. Banner, 588 F.2d 1336, 1342-43, 200 USPQ 266, 270 (CCPA 1978). Under the "good cause" standard of 37 CFR § 1.617(b), ignorance by a party or counsel of the provisions of the rules or the substantive requirements of the law would not constitute good cause. Notice of Final Rule, supra at 48423, 1050 Off. Gaz. Pat. Office at 392. On the other hand, "good cause" might be shown if evidence first comes into existence after a Rule 608(b) showing is filed. Huston v. Ladner, 973 F.2d 1564, 1566, 23 USPQ2d 1910, 1912-13 (Fed. Cir. 1992) ("if the evidence was not available when the original showing was filed, this would have been a valid excuse for not filing the evidence"). Another basis upon which "good cause" might be established would be where a diligent effort to find evidence was unsuccessful prior to filing the Rule 608(b) showing, but continued diligence ultimately succeeded in locating the evidence after the showing was filed. Whether an applicant has shown "good cause" is a matter within the discretion of the board. Hahn v. Wong, supra at 1034, 13 USPQ at 1318.

A patentee may file a "statement" responding to any response filed by the applicant. 37 CFR § 1.617(d). The term "statement" as opposed to "opposition" is used in the rules, because the patentee is not permitted to file any evidence in support of the statement. Generally in patent interference practice, where appropriate, evidence may accompany an opposition. See 37 CFR

§ 1.639(a). The patentee's statement, therefore, is limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the APJ for issuing the order to show cause. Id. "[S]ummary judgment will not be based on a rationale raised by a patentee in a statement which does not correspond to the rationale used by the *** [APJ] in the order to show cause." Notice of Final Rule, supra at 48438, col. 3, 1050 Off. Gaz. Pat. Office at 407, col. 3. See also Hahn v. Wong, 13 USPQ2d 1211, 1216 (Bd. Pat. App. & Int. 1989), aff'd, 892 F.2d 1028, 13 USPQ 1313 (Fed. Cir. 1989); Surabian v. Brecher, 16 USPQ2d 1312, 1313 (Bd. Pat. App. & Int. 1990).

The applicant may file a reply to patentee's statement. 37 CFR § 1.617(e).

After any response, statement and reply are filed, a determination is made as to whether summary judgment should be entered against the applicant based on the evidence submitted under 37 CFR § 1.608(b) and any additional evidence properly submitted under 37 CFR § 1.617(b). Only a merits panel can determine that summary judgment should be entered. 37 CFR § 1.610(a). If summary judgment is deemed appropriate by a merits panel, a final decision is entered against the applicant. 37 CFR § 1.617(g). On the other hand, if the APJ or the merits panel determines that summary judgment is not appropriate, an order is entered allowing the interference to proceed in the normal manner.

We are aware of language in a dissent in Schendel v. Curtis, supra, as follows:

The Board was constituted in a curious manner; first an administrative patent judge, in his role as examiner, made the decision [to issue the order to show cause]; then it was reviewed by a three-member Board presided over by the same administrative patent judge, who wrote an opinion sustaining his action, quoting himself with approval.

83 F.3d at 1406 n.1, 38 USPQ2d at 1749 n.1.

Under the rules, we do not believe that there is any reason to view as curious the manner in which a merits panel is constituted to consider whether summary judgment should be entered. As noted earlier, all interferences normally are assigned to a single APJ. 37 CFR § 1.610(a). The APJ, not in any role as a "patent examiner," but in a role as APJ, issues the order to show cause. Unless the APJ is satisfied with an applicant's response, the original Rule 608(b) showing, the response and any properly filed supplemental evidence is considered by a merits panel. 37 CFR § 1.617(g). Cf. Fed. R. App. P. 27(c), authorizing a single judge to enter an order relating to non-dispositive matters, and Fed. Cir. R. 27(k) providing for requesting review by the court of an order entered by a single judge.

Normally, the APJ who issued the order to show cause is also designated to serve on a merits panel. If a merits panel entered the order to show cause in the first instance, that same merits panel would determine whether summary judgment is appropriate. In this limited sense, it is our understanding that practice before the board is similar to that before the Federal Circuit. We understand that each month, the Federal Circuit designates a motions judge and a motions panel, the latter including the motions judge. Any review under Fed. Cir. R. 27(k) of a decision of the motions judge may be by a motions panel which includes the motions judge.

Any order entered by a merits panel may adopt or reject, in whole, or in part, findings and conclusions of law of the APJ as set out in the order to show cause and may set aside a decision of a single APJ to issue the order to show cause. Any decision to deny consideration on the merits to supplemental evidence submitted under 37 CFR § 1.617(b) is made only by a merits panel.

F.

Is there a difference between summary judgment proceedings under Rule 56 of the Federal Rules of Civil Procedure and patent interference practice?

The answer is "yes." The use of the phrase "summary judgment" in 37 CFR § 1.617, and its predecessor 37 CFR § 1.228, probably was an unfortunate choice of words. Summary judgment in a patent interference proceeding and summary judgment in a civil

action before a U.S. District Court differ in several material respects. However, both forms of summary judgment seek to make judicial and administrative proceedings efficient by avoiding unnecessary court trials and administrative evidentiary proceedings.

1.

In a civil action, generally one party moves for summary judgment against an opponent. Under patent interference practice, the applicant has to make out a prima facie case as a threshold matter. In other words, the applicant has to establish a right to participate in an interference proceeding somewhat in the same sense that a plaintiff in a civil action bears the burden of establishing Article III and "zone of interest" standing to maintain the civil action. See, e.g., Bennett v. Spear, ___ U.S. ___, ___, 117 S.Ct. 1154, 1161 (1997) ("a plaintiff must, generally speaking, demonstrate that he has suffered 'injury in fact,' that the injury is 'fairly traceable' to the actions of the defendant, and that the injury will likely be redressed by a favorable decision" (citations omitted)). For this reason, entry of a summary judgment against an applicant is not a "default" judgment. Nor can it be said that entry of a summary judgment is not a resolution of the interference on the merits which deprives the applicant of its "day in court." After all, the applicant is the only party permitted to present evidence under 37 CFR § 1.608(b), and that evidence is fully

evaluated on its merits by an APJ in the first instance and, if necessary, by a merits panel.

2.

In a civil action in a district court, the moving party has the burden of establishing (1) the absence of a genuine issue of a material fact and (2) its entitlement to a judgment as a matter of law based on the undisputed facts. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). Under patent interference practice, the applicant bears the burden of establishing the facts and the existence of a prima facie case to avoid entry of summary judgment.

3.

In a civil action, the district court in deciding a motion for summary judgment views the evidence in a light most favorable to the non-movant and all reasonable inferences must be drawn in the non-movant's favor. United States v. Diebold, 369 U.S. 654, 655 (1962). Under patent interference practice, the applicant must make out a prima facie case and, therefore, the evidence is not necessarily viewed in a light most favorable to the applicant. As the Federal Circuit has aptly noted, "[e]ven a prima facie case requires some real proof, not just vague inference, based on surrounding circumstances that tangentially support the inventor's goal." Schendel v. Curtis, 83 F.3d 1399, 1405 n.8 second paragraph, last sentence, 38 USPQ2d 1743, 1748 n.8 second paragraph, last sentence. Thus, where plausible

alternative inferences are possible based on the evidence presented by the applicant, the alternative least favorable to the applicant may be drawn on the theory that the applicant failed to prove its case.

4.

In a civil action, both parties are permitted to present evidence in a summary judgment proceeding. Fed. R. Civ. P. 56. Under patent interference practice, only the applicant may present evidence.

G.

What is the meaning of prima facie within the meaning of 37 CFR § 1.608(b) and 37 CFR § 1.617(a)?

To establish a prima facie case, an applicant must prove at least so much of applicant's case as would entitle applicant to a judgment with respect to the patentee if the patentee were to rely on only patentee's effective filing date and were not to rebut any of the applicant's case. Hahn v. Wong, supra at 1032, 13 USPQ2d at 1317, citing Kistler v. Weber, 412 F.2d 280, 285, 162 USPQ 214, 218 (CCPA 1969). See also Golota v. Strom, 489 F.2d 1287, 1291-92, 180 USPQ 396, 399-400 (CCPA 1974).

H.

What evidentiary standard should be applied in summary judgment determinations in patent interference proceedings?

In Schwab v. Pittman, 451 F.2d 637, 640, 172 USPQ 69, 71 (CCPA 1971), the CCPA made the following observation:

the language of Patent Office Rule 228 states a test which differs from the test under Federal Rule [of Civil Procedure] 56. First it must be determined whether the showing submitted under Rule 204(c) provides "sufficient basis for overcoming the effective filing date of the patentee," i.e., whether Rule 204(c) has been complied with and a prima facie case of priority has been established. Note that the burden on the applicant here is not to prove beyond a reasonable doubt, or even by a preponderance of the evidence, but merely to establish a prima facie case.

The CCPA's observation in Schwab v. Pittman was made prior to the Supreme Court's decision in Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255-56 (1986). In Anderson, the Supreme Court held that whether a given factual dispute should be submitted to a jury must be guided by the substantive evidentiary standard that applies to the case. Of course, there is no jury in a patent interference proceeding. However, summary judgment practice in patent interference proceedings seeks to spare the patentee the expense of an administrative "trial" unless an applicant makes out a prima facie case.

The rationale behind the Supreme Court's decision to apply the substantive evidentiary standard in summary judgment proceedings under Fed. R. Civ. P. 56 applies with equal force to

"summary judgment" proceedings under patent interference practice. Thus, in a civil action the judge "unavoidably asks whether reasonable jurors could find by a preponderance of the evidence that the plaintiff is entitled to a verdict ***." 477 U.S. at 252. In summary judgment proceedings in patent interference cases, the APJ, and ultimately a merits panel of the board, unavoidably ask whether applicant has shown that it is prima facie entitled to a judgment vis-à-vis the patentee.

The general rule is that a junior party must prove its case by a preponderance of the evidence, although there are some cases where the burden of proof is clear and convincing evidence. See 37 CFR § 1.657(b) and (c), codifying holdings in Price v. Symsek, 988 F.2d 1187, 26 USPQ2d 1031 (Fed. Cir. 1993). An applicant cannot show that it is entitled to judgment vis-à-vis the patentee unless, as a minimum, a case for that judgment is established by a preponderance of the evidence standard, the lowest standard of proof generally recognized in civil matters. Application of some lesser, undefined standard would make summary judgment proceedings less objective and, to some extent, would undermine the purpose of the summary judgment proceedings.

We believe the appropriate evidentiary standard to be applied in determining whether an applicant has met its prima facie burden is preponderance of the evidence, or where the applicant's effective filing date is after the issue date of the patent, clear and convincing evidence.

Application of the above-noted evidentiary standard does no violence to the phrase "prima facie" as it appears in the rules. Rather, the phrase "prima facie" in 37 CFR § 1.608(b) and 37 CFR § 1.617 is a recognition, when read with other provisions of the rules, that only the applicant is to present evidence to make out its case. Application of the preponderance of the evidence standard to showings under 37 CFR § 1.608(b) should not impose an unwarranted burden on an applicant. To prove a fact by a preponderance of the evidence simply means that when all relevant evidence is considered, a fact alleged by an applicant is more likely true than not. In a summary judgment proceeding in a patent interference, generally there is no evidence "against" the applicant inasmuch as the applicant presents all the relevant evidence. Accordingly, in a patent interference proceeding, a summary judgment determination boils down to whether the applicant has prima facie established facts, by a preponderance of the uncontested evidence, that would entitle the applicant to a judgment as a matter of law if the patentee relies on its filing date and presents no evidence in rebuttal. Application of any other evidentiary standard at the summary judgment stage would mean that an applicant might not prevail at final hearing even if (1) the applicant relies on the same evidence presented with the Rule 608(b) showing and (2) the patentee relies on its filing date and presents no evidence in rebuttal.

I.

Are facts alleged in an affidavit accepted as true?

The answer is generally "yes." In an opinion in Schendel v. Curtis, supra, a suggestion was made that allegations in an applicant's Rule 608(b) affidavits should be assumed to be true. 83 F.3d at 1406, 38 USPQ2d at 1749 (Newman, J., dissenting). Judge Newman's suggestion is believed to be consistent with statements in the CCPA's opinion in Kahl v. Scoville, 609 F.2d 991, 995, 203 USPQ 652, 656 (CCPA 1979). The Schendel majority did not address the question of whether facts alleged in an affidavit should be accepted as true: "[b]ecause Schendel did not argue for such a rule, either before the board on appeal [to the Federal Circuit], we [therefore] decline to decide whether such a rule is appropriate." 83 F.3d at 1405 n.8 last sentence, 38 USPQ2d at 1748 n.8 last sentence.

The day-to-day practice at the board in evaluating Rule 608(b) affidavits has been that, absent a good reason, facts alleged in an affidavit are accepted as true.

What would be a "good reason" for not accepting an allegation of fact as true?

Suppose the circumstances are that an applicant alleges in a first affidavit that the applicant personally mixed A with B for the first time on May 4, 1997, while a corroborating witness alleges in a second affidavit that the applicant was observed

mixing A and B on May 1, 1997. Under these circumstances, a determination would be made as to whether the difference between the applicant's allegation and the corroborating witness' allegation is material, and, if so, whose allegation most likely represents the correct statement of events. Another example might be where an applicant makes an allegation in a Rule 608(b) affidavit which is inconsistent with statements in the applicant's specification. The APJ and/or the merits panel would then weigh the applicant's allegation against the statement in the specification to determine whether the applicant's allegation is true. Experience at the board is that there have been, and should be, few occasions when a fact alleged in an affidavit is not accepted as true.

It is important, however, to distinguish between an allegation of a "fact" in a Rule 608(b) affidavit, such as an allegation as to when a particular event took place, and an allegation in the nature of a conclusion of law. For example, in a case where an applicant is attempting to establish a prima facie case of diligence, affidavit statements by the applicant and a corroborating witness that particularized events took place on specific days would be accepted as true. An allegation by the applicant and/or the corroborating witness that the applicant "diligently" sought to actually or constructively reduce to practice an invention during the month of April, without other fact details, would not be accepted as a statement of fact since

the allegation is an expression of opinion on an issue of law. Golota v. Strom, 489 F.2d 1287, 1292 n.5, 180 USPQ 396, 400 n.5 (CCPA 1974).

II.

Findings of fact

The record in this interference supports, by a preponderance of the evidence, the following findings.

The parties

1. This interference involves a junior party applicant and a senior party patentee.
2. The junior party applicant is Garo Basmadjian and Stanley L. Mills (**Basmadjian**). Basmadjian is involved in the interference on the basis of two patent applications (Paper No. 1, pages 13-14):
 - a. "Parent" patent application 07/976,584, filed November 13, 1992, entitled "Vaccines for immunization against drugs of abuse," and
 - b. "Continuing" patent application 08/451,698, filed May 26, 1995, also entitled "Vaccines for immunization against drugs of abuse."
3. Basmadjian's "continuing" application has been accorded the benefit of his "parent" application for the purpose of priority (Paper No. 1, page 14).

4. The real party in interest insofar as Basmadjian is concerned is The Board of Regents of the University of Oklahoma (Paper No. 5)

5. The senior party patentee is Donald W. Landry and Kang Zhao (**Landry**). Landry is involved in the interference on the basis of U.S. Patent N° 5,463,028, granted October 31, 1995, based on application 07/862,801, filed April 3, 1992 (Paper No. 1, page 15). The title of the patent is "Reagents for generating a polyclonal hydrolytic antibody response against cocaine and the monoclonal hydrolytic antibodies against cocaine derived through these reagents." Id.

6. The real party in interest insofar as Landry is concerned is The Trustees of Columbia University in the City of New York (Paper No. 9).

Basmadjian's invention

7. A full understanding of the invention is not necessary for resolution of the issues before us. Briefly, however, applicants state (Basmadjian parent specification, pages 5-6):

Addiction to cocaine has been unresponsive to most nonpharmacological treatment approaches. Recently there has been a flurry of clinical trials of pharmacotherapeutic agents against cocaine addiction ***. Clinical studies have evaluated the efficacy of a

number of drugs, such as buprenorphine, carbamazepine, desipramine, mazindol, flupenthixol, nifedipine, and amantadine for the treatment of cocaine addiction.

* * * * *

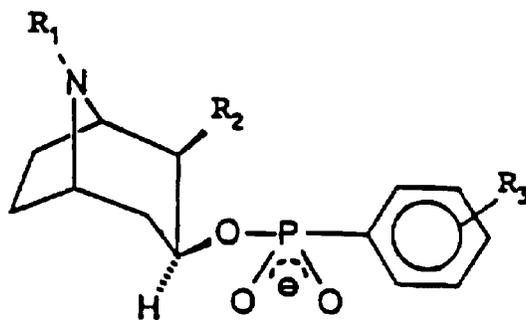
Clearly, the problem of abuse of cocaine and other psychotropic drugs such as heroin and its derivatives has reached a critical level. A technique effective in combatting such abuse would be of enormous benefit.

* * * * *

The present invention is a vaccine [and a compound to be used in the vaccine] comprising an immunogenic peptide or protein conjugated to a non-immunogenic molecule such as an analog of a psychotropic drug which can be used in mammals, including humans, to stimulate catalytic antibody production for metabolizing drugs, such as cocaine and heroin, which have psychotropic effects.

8. Claim 103 of the Basmadjian parent application reads:

Claim 103. A compound having the formula:



or any pharmaceutically acceptable salt or ester thereof, in which:

R₁ is a hydrogen atom, or a methyl group;

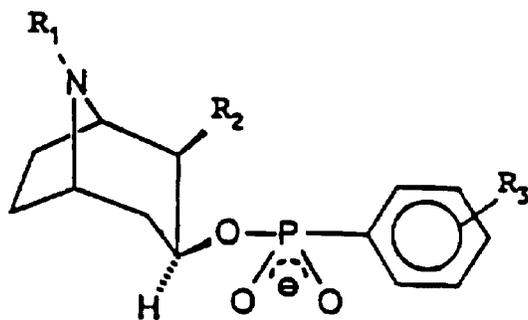
R₂ is a carboxyl group, or a carboxymethyl group; and

R₃ is a hydrogen atom, an amino group or a modified amine group.

9. Claim 6 of the Basmadjian continuing application reads:

Claim 6: A vaccine, comprising:

an analog-carrier conjugate formed by the conjugation of a non-immunogenic analog of cocaine to an immunogenic carrier molecule, the analog-carrier conjugate, when administered to a mammal in a pharmaceutically effective dosage, causing production in the mammal of catalytic antibodies which are effective in causing the catalysis of cocaine, and wherein the non-immunogenic analog is a compound having the formula:



or any pharmaceutically acceptable salt or ester thereof, in which:

R_1 is a hydrogen atom, or a methyl group;

R_2 is a carboxyl group, or a carboxymethyl group;

and

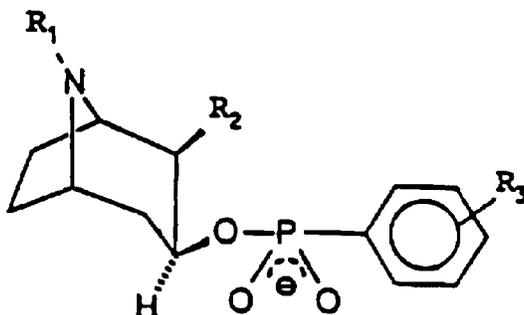
R_3 is a hydrogen atom or a group which can be activated to link the cocaine analog to the immunogenic carrier.

10. Claim 23 of the Basmadjian continuing application reads:

Claim 23. A method for causing in a mammal the in vivo production of catalytic antibodies which are effective in causing the catalysis of cocaine, comprising:

administering a pharmaceutically effective dosage of a vaccine to the mammal, the vaccine further comprising an analog-carrier conjugate formed by the conjugation of a non-immunogenic analog of

cocaine to an immunogenic carrier molecule, the non-immunogenic analog having the formula:



or any pharmaceutically acceptable salt or ester thereof, in which:

R₁ is a hydrogen atom, or a methyl group;

R₂ is a carboxyl group, or a carboxymethyl group;

and

R₃ is a hydrogen atom, or a group which can be activated to link the cocaine analog to the immunogenic carrier.

The count and claims corresponding to the count

11. There is one count in the interference, Count 1, which reads:

Count 1

A compound according to claim 103 of the Basmadjian '584 application [i.e., the Basmadjian parent application],

or

a vaccine according to claim 6 of the Basmadjian '698 application [i.e., the Basmadjian continuing application],

or

a method according to claim 23 of the Basmadjian '698 application,¹

or

a method according to claim 38 of the Basmadjian '698 application,

or

a compound according to claim 1 of the Landry patent,

or

a compound according to claim 6 of the Landry patent,

or

a compound according to claim 7 of the Landry patent,

or

a compound according to claim 8 of the Landry patent.

12. The claims of the parties which correspond to count 1 are:

Basmadjian parent:	103-112 and 114-115
Basmadjian continuing:	6-38
Landry:	1-9

13. The claims of the parties which do not correspond to count 1 are:

¹ It is noted that claims 24-35 of Basmadjian '698 appear to be improper dependent claims since claim 23 is not directed to a "non-immunogenic analog" (rather claim 23 is directed to a process).

Basmadjian parent:	None
Basmadjian continuing:	None
Landry:	10-11

Basmadjian's Rule 608(b) showing and explanation

14. Basmadjian filed Rule 608(b) showings in both his "parent" (Paper No. 27, filed August 19, 1996) and "continuing" (Paper No. 6, filed August 19, 1996) applications. Apart from references to specific claims, in most other material respects, the Basmadjian Rule 608(b) showings are essentially the same.

15. According to Basmadjian, his invention was conceived prior to the filing date (April 3, 1992) of the application which matured into the Landry patent. Basmadjian further alleged diligence from a date prior to Landry's filing date to a subsequent "reduction to practice."

16. The relevant time period in which Basmadjian was required to show reasonable continuous diligence is from

- (1) prior to April 3, 1992, through
- (2) November 13, 1992, when his "parent" application was filed.

17. As part of his Rule 608(b) showing, Basmadjian alleged that there was an ongoing dispute regarding inventorship with personnel of the Oklahoma Medical Research Foundation (OMRF). Basmadjian further alleged the dispute precluded obtaining and filing of affidavits by Dr. Morris Reichlin and Dr. Eugene Koran. According to Basmadjian, both Morris and Koran could corroborate certain work performed on behalf of Basmadjian.

18. Basmadjian filed four declarations:

- a. his own;
- b. a declaration of Dr. O. Ray Kling;
- c. a declaration of Charles A. Coddington, Esq.;
- and
- d. a declaration of Dr. Mangesh Kanvinde.

19. In his own declaration, Basmadjian states that he prepared an invention disclosure (Exhibit 1) and submitted the invention disclosure to the Office of the Vice Provost for Research for the University of Oklahoma Health Sciences Center. Basmadjian declaration, ¶ 3.

20. The Basmadjian declaration discusses many events which took place prior to Landry's filing date (April 3, 1992). Basmadjian declaration, ¶¶ 4-13.

21. Exhibit 13 of the Basmadjian declaration is a copy of a page of a laboratory notebook.

22. Basmadjian discusses Exhibit 13 as follows:

Exhibit 13 shows a log of the testing of two rabbits immunized with BSA-TSA-I which occurred from March 26, 1992 through October 5, 1992.

Basmadjian declaration, ¶ 14.

23. BSA means bovine serum albumin. Basmadjian declaration, ¶ 10.

24. BSA (bovine serum albumin) which has been conjugated to a transition state analog of cocaine is referred to by Basmadjian as TSA-1. Basmadjian declaration, ¶ 4.

25. Basmadjian's BSA-TSA-1 conjugate uses a compound within the scope of claim 103 of the "parent" application.

26. TSA was also referred to as TCA, meaning transition cocaine analog. Basmadjian declaration, ¶ 9.

27. TCA-2 is another way in which Basmadjian refers to BSA-TSA-1. Basmadjian declaration, ¶ 10.

28. Exhibit 14 is said to show "immunizations of rabbits with conjugated TSA's in April 1992." Basmadjian declaration, ¶ 15.

29. Exhibit 15 is said to show "experiments conducted on May 14 and 15, 1992 aimed at analyzing the catalytic activity of several fractions of sera." Basmadjian declaration, ¶ 16.

30. There is no particularized discussion or explanation in the Basmadjian declaration of the significance of the various entries in Exhibit 13.

31. In addition to the absence of particularized discussion or explanation concerning the entries in Exhibit 13, the Basmadjian Rule 608(b) showing does not identify who performed the experiments recorded in, or who made the entries found on, Exhibit 13.

32. Exhibit 13 mentions the following events, apparently involving two rabbits: Rabbit # 403 NZW and Rabbit # 404 NZW:

- a. Mar. 26, 1992 Pre-bleed
- b. Mar. 26, 1992 Immunization of TCA-2 BSA
- c. Apr. 01, 1992 Immunization of TCA-2 BSA
- d. Apr. 10, 1992 Rabbits bled
- e. Apr. 29, 1992 Injection via ear
- f. May 06, 1992 Bleed ~ 30 cc
- g. May 07, 1992 Bleed ~ 30 cc
- h. June 16, 1992 Injection via ear
- i. June 25, 1992 Bleed ~ 45 cc
- j. June 26, 1992 Bleed ~ 50 cc
- k. June 29, 1992 Bleed ~ 30 cc
- l. Sep. 28, 1992 Boost via ear
- m. Oct. 05, 1992 Exsanguinate: sacrifice

33. Basmadjian does not explain in his declaration what events, if any, took place between June 29, 1992 and September 28, 1992, a period of 91 days, or about 3 months.

34. Basmadjian does not explain in his declaration what events, if any, took place between October 5, 1992, and November 13, 1992, a period of 39 days.

35. In his declaration, Kling acknowledges receiving the Basmadjian invention disclosure (Exhibit 1) on or about July 1, 1990. Kling declaration, ¶ 4.

36. The Kanvinde declaration makes the following relevant allegations:

a. Kanvinde "was a doctoral student in the lab of *** Basmadjian *** from 1987 to 1992" (Kanvinde declaration, ¶ 2).

b. Kanvinde has "reviewed the Declaration of *** Basmadjian which details lab procedures, syntheses and experiments relating to the synthesis of transition state analogs of cocaine which were conducted within the lab of *** Basmadjian" (Kanvinde declaration, ¶ 3).

c. Kanvinde attests "that the activities described in the Declaration of *** Basmadjian and the exhibits attached to the Declaration are true and that they did occur. Also, on several occasions during this period I transferred samples of the transition state analogs to the Mass Spectrometry Lab at the Chemistry Department of the University of Oklahoma for analysis" (Kanvinde declaration, ¶ 4).

37. Kanvinde does not describe with particularity any of the events mentioned in Basmadjian Exhibit 13.

38. The Coddling declaration contains the following allegations:

a. Coddling is patent counsel for the University of Oklahoma Health Sciences Center. Coddling declaration, ¶ 1.

b. "I have requested in the past that the Oklahoma Medical Research Foundation (OMRF) make Dr. Morris

Reichlin and Dr. Eugene Koran available for depositions and/or to discuss their work and Dr. Garo Basmadjian's work at OMRF between February 1992 and September 1992. This request has been refused." Codding declaration, ¶ 2.

c. "I believe that Drs. Reichlin and Koran can corroborate the work done by Dr. Basmadjian and work done with Dr. Basmadjian's assistance while at OMRF between February 1992 and September 1992." Codding declaration, ¶ 3.

39. Neither Basmadjian nor Codding state in their respective declarations what work was done by Basmadjian at OMRF between February and September of 1992. Nor do the Basmadjian and Codding declarations describe with particularity any work done with Basmadjian's "assistance."

The order to show cause

40. The Basmadjian Rule 608(b) showing was reviewed by an APJ. A determination was made that the Rule 608(b) showing failed to make out a prima facie case that Basmadjian was entitled to a judgment vis-à-vis Landry. Hence, an order to show cause (Paper No. 2) was issued pursuant to 37 CFR § 1.617(a). The following appears in a "Discussion" section of the order to show cause (Paper No. 2, pages 3-7):

According to Basmadjian, "the invention was conceived of by the Applicants prior to the filing date of the Landry et al. patent (April 3, 1992) and . . . Applicants were diligent in reducing the claimed

invention to practice from a date prior to the filing of the Landry et al. patent application." RESPONSE, page 2. A similar statement appears in the paragraph bridging pages 2 and 3 in the RESPONSE TO REJECTIONS AND SHOWING UNDER 37 C.F.R. § 1.608(b).

The "explanation" does not state with any particularity what is meant by "reduction to practice." Reduction to practice can mean (1) actual reduction to practice or (2) constructive reduction to practice. No allegation of an "actual reduction to practice" has been found in any part of the papers filed by Basmadjian under 37 CFR § 1.608(b). On this record, and for the purpose of evaluating the showing under 37 CFR § 1.608(b), it will be assumed that Basmadjian is entitled to a constructive reduction to practice of November 13, 1992--the date the Basmadjian '584 ["parent"] application was filed. See paragraph 17 on page 4 of the Basmadjian declaration.

Accordingly, the issues for evaluation are two:

(a) Did Basmadjian conceive prior to April 3, 1992, the date the Landry application which matured into the Landry patent was filed?

(b) Did Basmadjian act with reasonable continuous diligence from:

(i) a date prior to April 3, 1992 until

(ii) his constructive reduction to practice on November 13, 1992?

The papers are sufficient to prima facie establish that, prior to April 3, 1992, Basmadjian conceived the invention defined by Count 1. However, the papers are not sufficient to prima facie establish reasonable continuous diligence as required by law.

The provisions of 37 CFR § 1.608(b) require that "[a]ny printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit." The various declarations submitted with the Basmadjian showing under 37 CFR § 1.608(b) contain, at best, merely cursory statements about what each exhibit is supposed to show.

Exhibit 13 is of some interest because it appears to lay out the best, albeit an insufficient, case for reasonable continuous diligence during the time period from April 1992 through September 1992. Basmadjian apparently believes that an act having some relevance to diligence took place on 4-1-92 (*** April 1, 1992). Presumably, Basmadjian believes that other relevant acts took place on the following dates:

1. April 10, 1992;
2. April 29, 1992;
3. May 6, 1992;

4. May 7, 1992;
5. June 16, 1992;
6. June 25, 1992;
7. June 26, 1992;
8. June 29, 1992;
9. September 28, 1992; and
10. October 5, 1992.

Basmdjian ["parent"] patent application '584 was filed on November 13, 1992.

There is no cogent explanation why the acts which took place on the ten days noted above, as well as November 13, 1992, constitute reasonable continuous diligence. It seems as though counsel for Basmdjian has filed very superficial declarations in the Patent and Trademark Office, accompanied by unexplained laboratory notebooks, hoping that somehow the declarations and notebooks establish reasonable continuous diligence. The burden of proving a prima facie case of reasonable continuous diligence is on Basmdjian. Stated in other terms, neither the Patent and Trademark Office nor Landry have to prove lack of diligence.

Apart from the fact that the events are not "discussed with particularity" in any of the declarations filed in the Patent and Trademark Office, there is a rather large gap between June 29, 1992, and September 28, 1992, which is simply not explained.²

)))))) •)))))))

Footnote 2 stated:

On this record, the events recited in Exhibit 13 are not corroborated. For the purpose of evaluation under 37 CFR § 1.617(a), it will be assumed that events which occurred between February 1992 and September 1992 would have been corroborated by Dr. Morris Reichlin and Dr. Eugene Koran of the Oklahoma Medical Research Foundation had they be willing to submit declarations. See the Coddling declaration. If the interference survives the summary judgment phase, then perhaps Dr. Morris and Dr. Koran can be compelled to give testimony as hostile witnesses. See 37 CFR § 1.671(g) and 35 U.S.C. § 24.

[end of footnote]

)))))) •)))))))

There is a second gap which is not explained or corroborated. The second gap is the time period from (1) September 28, 1992 (see next to last line of Exhibit 13) to (2) November 13, 1992. The Coddling declaration does not purport to say that Dr. Reichlin and/or Dr. Koran could provide any corroboration for acts which occurred during the second large gap. Based on paragraph 17 on page 4 of the Basmadjian declaration, apparently one is to assume that a

patent application was diligently prepared, signed and forwarded to the Patent and Trademark Office during the time period which I refer to as the "second gap." Interestingly enough, nothing is said in the Coddling declaration about what steps were taken to prepare a patent application and the dates when those steps took place. Yet the Coddling declaration is where one would expect to find the details of acts associated with preparing, signing and filing a patent application.

A time will be set for Basmadjian to file a "response" (37 CFR § 1.617(b)) to the order to show cause, for Landry to file a "statement" (37 CFR § 1.617(d)) and for Basmadjian to file a "reply" (37 CFR § 1.617(e)).

41. Basmadjian was expressly advised of the "good cause" requirement in the event additional evidence was to be presented in response to the order to show cause (Paper No. 2, pages 7-8).

Basmadjian's response to the order to show cause

42. Basmadjian timely responded to the order to show cause. RESPONSE UNDER 37 C.F.R. § 1.617(B) TO THE ORDER TO SHOW CAUSE (Paper No. 12).

43. Basmadjian's response:

a. does not appear to argue that the basis upon which the order to show cause was issued is erroneous;

b. presents "[a]dditional evidence further documenting diligence between April 3, 1992 and November 13, 1992 ***" in the form of Basmadjian Exhibits 16 through 37; and

c. maintains that there is good cause why the additional evidence was not presented with the original Rule 608(b) showing.

44. Basmadjian Exhibit 16 is a second declaration by Basmadjian. Basmadjian Exhibit 34 is a declaration by Dr. Christopher W. Corbett, an employee in the Dunlap and Coddling firm owned by Coddling. Basmadjian Exhibit 37 is a second declaration of Coddling.

45. The following arguments were made with respect to why there is good cause for submitting additional evidence.

a. The additional "evidence could not be corroborated by the OMRF employees due to the ongoing dispute" (Paper No. 12, page 3) (the ongoing dispute is discussed in Findings 17 and 38, supra).

b. The "evidence is not complete in describing the activities from April through July. These deficiencies could be cleared up by the testimony of Reichlin and Koran" (Paper No. 12, page 3).

c. The additional evidence "for all intents and purposes, appeared to be cumulative of the evidence which was originally provided under 37 C.F.R. § 1.608(b) in Exhibits 13-15" (Paper No. 12, page 3).

d. The additional evidence "shows other activities which occurred between July and September. These data were not originally included because [Basmadjian] Exhibit 13 was inclusive of the same time period. These data were originally and still [are] considered to be cumulative of the data in [Basmadjian] Exhibit 13" (Paper No. 12, page 4).

e. "The reason counsel did not provide the detailed explanation provided now in the Corbett Declaration ([Basmadjian] Exhibit 34) is that counsel believed that the brief period of time between the sacrificing of the rabbits on October 5, 1992 ([Basmadjian] Exhibit 13, which marked the end of that phase of experiment work on the invention), and the November 13, 1992 filing date did not raise a question as to diligence or date of conception. Counsel respectfully submits that anyone who has ever prepared a chemical patent application of the nature of the one presently under consideration [, i.e., the Basmadjian parent application,] would agree that five weeks from start to finish constitutes reasonable diligence" (Paper No. 12, page 6).

46. The Rule 608(b) showing does not identify any date on which preparation of a patent application was first authorized or began.

Landry statement

47. Landry timely filed a statement. STATEMENT OF SENIOR PARTY LANDRY UNDER 37 C.F.R. § 1.617(d) COMMENTING ON RESPONSE OF JUNIOR PARTY BASMADJIAN TO THE ORDER TO SHOW CAUSE (Paper No. 19).

48. Landry argues that the additional evidence submitted by Basmadjian should be "stricken," Basmadjian having failed to provide a showing of good cause why the additional evidence was not earlier presented (Paper No. 19, pages 3-4).

49. Landry correctly notes that "there is no showing that the documents submitted with these [additional] declarations were not available earlier" (Paper No. 19, page 4).

Basmadjian reply

50. Basmadjian timely filed a reply. REPLY UNDER 37 C.F.R. 1.617(e) TO THE ORDER TO SHOW CAUSE (Paper No. 21).

51. Basmadjian's reply:

a. argues that "[t]he original material supplied in *** Basmadjian's [Rule 608(b)] showing *** provides a prima facie showing that *** Basmadjian *** diligently worked to reduce his invention to practice ***" (Paper No. 21, page 9);

b. presents still further additional evidence in the form of Basmadjian Exhibits 38 through 40; and

c. makes additional arguments that there is good cause why the additional evidence was not presented with the original Rule 608(b) showing.

52. Basmadjian Exhibit 38 is a second declaration by Corbett.

53. The following arguments are made in Basmadjian's reply with respect to why there is good cause for submitting additional evidence.

a. There was continued mention of personnel at OMRF. Basmadjian repeated his view that "at least two employees of OMRF [can] corroborate *** Basmadjian's testimony ***" (Paper No. 21, page 5). For the first time in the interference, Basmadjian's counsel argues that:

it is more likely than not that they may be able to disclose independent acts of significance as well as documentary evidence as to ***

Basmadjian's diligence in reducing to constructive practice. See First Coddling Declaration

[submitted with Basmadjian's Rule 608(b) showing]. (Paper No. 21, page 5). Basmadjian's counsel further argues (Paper No. 21, page 7):

It must be pointed out, however, that these witnesses [, i.e., personnel at OMRF,] may also be able to supplement the testimony of *** Basmadjian with (1) additional independent acts of significance, (2) testimony of experiments or procedures conducted, and (3) documentary evidence of experiments or procedures conducted (See First Coddling Declaration).

Basmdjian's counsel still further argues (Paper No. 21, pages 7-8):

In this interference, necessary testimony as to diligence can only be obtained through subpoenas during the discovery phase.

b. The additional evidence was not earlier submitted because "it was *** reasonably believed to be cumulative of the evidence submitted" with the Rule 608(b) showing (Paper No. 21, page 6).

c. The additional evidence was not earlier submitted "because the material [, apparently a reference to additional evidence,] could not have been corroborated because of the ongoing dispute between Oklahoma University Health Sciences Center and the Oklahoma Medical Research Foundation" (OMRF) (Paper No. 21, page 6).

III.

Discussion

A.

Prima facie case based on Basmdjian's Rule 608(b) showing

For the purpose of summary judgment, we assume that Basmdjian conceived the invention prior to April 3, 1992. While it was not entirely clear based on the Rule 608(b) showing, it appeared that Basmdjian bottomed his prima facie case on conception prior to Landry's filing date coupled with reasonable

diligence from a date prior to Landry's filing date until a constructive reduction to practice by Basmadjian. Basmadjian's response and reply do not rely on any actual reduction to practice. Under applicable precedent, Basmadjian was required to establish a prima facie case of reasonable diligence from prior to Landry's filing date (April 3, 1992) until Basmadjian's constructive reduction to practice (November 13, 1992). Griffith v. Kanamaru, 816 F.2d 624, 626, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987); Gould v. Schawlow, 363 F.2d 908, 911, 150 USPQ 634, 637 (CCPA 1966).

In his Rule 608(b) showing, Basmadjian did not discuss any of the laboratory notebook entries with "particularity in an affidavit." 37 CFR § 1.608(b). Hence, we do not know the significance of entries in those laboratory notebooks. Apart from Basmadjian's failure to explain the entries in the laboratory notebooks, based on our consideration of Basmadjian Exhibit 13, and consistent with the issues raised in the order to show cause, Basmadjian's Rule 608(b) showing failed to show reasonable diligence during two time periods ("gaps") between April 3, 1992, through November 13, 1992. Those two gaps are:

- (1) June 29, 1992 through September 27, 1992; and
- (2) October 5 through November 12, 1992.

Since Basmadjian failed to describe the activity in Basmadjian Exhibit 13 with any particularity, and failed to show what activity, if any, took place during these two gaps,

Basmadjian did not make out a prima facie case of diligence in his Rule 608(b) showing.

B.

Basmadjian's arguments and additional evidence

We have considered, individually and collectively, all of Basmadjian's arguments, including those in support of his contention that there is good cause for the submission of additional evidence. The additional evidence consists of Basmadjian Exhibits 16 through 40, the latter three exhibits having been filed with Basmadjian's reply.

We hold that Basmadjian has not overcome the order to show cause. Nor has Basmadjian established good cause within the meaning of 37 CFR § 1.617(b) for the filing of additional evidence. Hence, Basmadjian's additional evidence will not be considered.

1.

The "ongoing" dispute

Basmadjian argues that there is good cause to submit additional evidence because the "evidence could not be corroborated by the OMRF employees due to the ongoing dispute" (Paper No. 12, page 3). See also Paper No. 21, page 6. None of the additional declarations or documentary evidence is alleged to have been supplied by OMRF employees after the Rule 608(b) showing was filed in the Patent and Trademark Office. The additional evidence includes declarations of Basmadjian (Exhibit

16), Corbett (Exhibits 34 and 38) and Coddling (Exhibit 37). None of these individuals is identified as being associated with OMRF. The remaining additional evidence is documentary evidence, none of which is alleged to have been unavailable when the Rule 608(b) showing was filed.

2.

Basmadjian's relationship with OMRF personnel

Basmadjian maintains (Paper No. 12, page 3) that the Rule 608(b) showing "is not complete in describing the activities from April through July. These deficiencies could be cleared up by the testimony of Reichlin and Koran." How? The Rule 608(b) showing did not sufficiently describe (1) the precise relationship between Basmadjian and personnel of OMRF, (2) the nature of the dispute, (3) what Basmadjian himself did while associated with OMRF, (4) how Basmadjian believes he was assisted by Reichlin and/or Koran, and/or (5) what testimony could be expected from Reichlin and/or Koran. Furthermore, if the Rule 608(b) showing was "not complete" and if the additional evidence renders the showing "complete," then it is curious that the following documents were not submitted with, and the entries therein explained in, the Rule 608(b) showing:

- a. Exhibit 17 (dated April 10, 1992)
- b. Exhibit 18 (dated April 14, 1992)
- c. Exhibit 19 (dated April 14-15, 1992)
- d. Exhibit 20 (dated April 20, 1992)

- e. Exhibit 21 (dated April 21, 22 and 23, 1992)
- f. Exhibit 22 (dated April 27 and 28, 1992)
- g. Exhibit 23 (dated April 29 and May 6 and 8, 1992)
- h. Exhibit 24 (dated May 11, 1992)
- i. Exhibit 25 (dated May 13, 15, 26 and 27 and June 1, 8 and 9, 1992)
- j. Exhibit 26 (dated June 8, 11, 15, 17-18, 22-25 and 28-30, 1992, July 1, 9, 10 and 15 and one date over a period June 8-19, 1992)
- k. Exhibit 27 (dated July 15, 19,² 20, 21 and 22, 1992)
- l. Exhibit 28 (dated July 25, 1992).
- m. Exhibit 29 (dated August 28, 1992)
- n. Exhibit 30 (dated September 2, 1992)
- o. Exhibit 31 (dated September 15, 1992)
- p. Exhibit 32 (dated September 25, 1992)
- q. Exhibit 33 (dated September 9, 11, 14, 16, 18, 23, 25 and 28 and October 2 and 5, 1992)
- r. Exhibit 35 (dated October 5, 1992)
- s. Exhibit 36 (attorney diary form October 9, 14, 15, 19-23 and 26-30 and November 2-6 and 11, 1992)

² There is some question whether the date is July 17 or 19, because the date is handwritten and the handwriting is not clear.

- t. Exhibit 39 (attorney diary for various dates between July 1 and September 30, 1992)
- u. Exhibit 40 (attorney reports for July, August, September and October of 1992)

We have, and will not, consider the additional documentary evidence on its merits. Suffice it to say, there is no indication that the additional documentary evidence could not have been submitted with Basmadjian's Rule 608(b) showing.

3.

The additional evidence is cumulative

Basmadjian, through counsel, maintains that "for all intents and purposes, [the additional evidence] appeared to be cumulative of the evidence which was originally provided under 37 C.F.R. § 1.608(b) in Exhibits 13-15" (Paper No. 12, page 3). See also Paper No. 21, page 6. Quite frankly, we do not know what to make of counsel's argument, which was made both in the response and the reply. If the additional evidence is cumulative, why is it being submitted at all?

4.

Other activities during July through September

Basmadjian suggests that the additional evidence:
shows other activities which occurred between July and September. These data were not originally included because [Basmadjian] Exhibit 13 was inclusive of the same time period. These data

were originally and still [are] considered to be cumulative of the data in [Basmadjian] Exhibit 13. (Paper No. 12, page 4).

The time for having submitted evidence related to other activities, assuming those activities are somehow relevant on the issue of diligence, was when the Rule 608(b) showing was filed.

5.

Diligence in preparing an application

Counsel argues:

The reason counsel did not provide the detailed explanation provided now in the Corbett Declaration ([Basmadjian] Exhibit 34) is that counsel believed that the brief period of time between the sacrificing of the rabbits on October 5, 1992 ([Basmadjian] Exhibit 13, which marked the end of that phase of experiment work on the invention), and the November 13, 1992 filing date did not raise a question as to diligence or date of conception. Counsel respectfully submits that anyone who has ever prepared a chemical patent application of the nature of the one presently under consideration [, i.e., the Basmadjian parent application,] would agree

that five weeks from start to finish
constitutes reasonable diligence.

(Paper No. 12, page 6).

In the order to show cause a view was expressed that "apparently one is to assume that a patent application was diligently prepared, signed and forwarded to the Patent and Trademark Office during the time period" September 28, 1992, through November 13, 1992 (emphasis in quote added). However, in the Rule 608(b) showing there is no clear statement as to when preparation of a patent application was authorized or began. The Rule 608(b) does not rule out a possibility that preparation of the application began prior to October 5, 1992. Hence, based on the Rule 608(b) showing, we cannot say Basmadjian or his counsel were diligent in preparing a patent application during the period from October 5, 1992, through November 13, 1992. The date for beginning the preparation of a patent application appears in the record, and vaguely at that, for the first time with the additional evidence. Counsel (1) would have us assume the preparation of the application began soon after October 5 and (2) seems to argue that preparation, signing and filing of a patent application in this field in a period of five weeks is per se diligence. We do not favor per se rules, preferring instead to evaluate each case on its own facts. Whatever the merits of counsel's argument for a rule that 5 weeks is per se diligent,

the argument is plainly bottomed on additional evidence and not on the rule 608(b) showing.

6.

OMRF personnel and independent acts

In what can only be characterized as an afterthought, for the first time in Basmadjian's reply, Basmadjian's counsel argues that "it is more likely than not that they may be able to disclose independent acts of significance as well as documentary evidence as to *** Basmadjian's diligence in reducing to constructive practice. See First Coddling Declaration [submitted with Basmadjian's Rule 608(b) showing]" (Paper No. 21, page 5). Basmadjian's counsel further argues (Paper No. 21, page 7):

It must be pointed out, however, that these witnesses [, i.e., personnel at OMRF,] may also be able to supplement the testimony of *** Basmadjian with (1) additional independent acts of significance, (2) testimony of experiments or procedures conducted, and (3) documentary evidence of experiments or procedures conducted (See First Coddling Declaration).

Basmadjian's counsel still further argues (Paper No. 21, pages 7-8):

In this interference, necessary testimony as to diligence can only be obtained through subpoenas during the discovery phase.

There are several independent difficulties with counsel's argument.

a.

The argument was made for the first time in a reply

The argument was made for the first time in a reply. A careful review of the Coddling declaration will reveal that it says only two things. First, Coddling tried without success to talk to Reichlin and Koran to discuss their work at OMRF and Basmadjian's work at OMRF during the period February through September 1992. Coddling declaration, ¶ 2. Second, it continues with a statement that Coddling believes that Reichlin and Koran can corroborate work done by and with the assistance of Basmadjian in the period February through September 1992. Coddling declaration, ¶ 3. A fair reading of the Coddling declaration is that Coddling would have liked to have talked with Reichlin and Koran to obtain evidence to corroborate activities by, and with the assistance of, Basmadjian. The lack of ability to corroborate continued to be a theme in Basmadjian's response to the order to show cause ("the evidence could not be corroborated by the OMRF employees due to the ongoing dispute ***." (Paper No. 12, page 3)). But, the order to show cause assumes that Reichlin and Koran could corroborate Basmadjian's

work, however vaguely that work was set out in the Rule 608(b) showing.

It is in the reply that counsel argues for the first time that Reichlin and Koran "more likely than not" may be able to disclose independent acts of significance (Paper No. 21, page 5). Arguments made for the first time in a reply are not entitled to be considered.

b.

The record fails to proffer with any particularity the nature of any testimony to be given by OMRF personnel

There has never been presented in this record a cogent statement of what evidence might reasonably have been expected from personnel at OMRF over-and-above corroboration of work done by Basmadjian. As noted earlier, in issuing the order to show cause, it was assumed that OMRF personnel could "corroborate" activity by Basmadjian. Presumably, Basmadjian knows what he did which OMRF personnel could corroborate. Hence, an assumption that OMRF could corroborate activity by Basmadjian was entirely reasonable.

Now it is contended that there may be "independent acts" relevant to proving diligence by, or on behalf of, Basmadjian. The meaning of the language "independent acts" is utterly vague and we have not been told that it is supposed to mean. What are the nature of those acts? Why did Basmadjian not allege in the Rule 608(b) showing that OMRF personnel might testify to

independent acts and proffer some idea of what those acts might be? The Rule 608(b) showing does not purport to say that a third-party worked apart from, but on behalf of Basmadjian. Rather, the Rule 608(b) showing gives the definite impression that Basmadjian did, or assisted in, all relevant work toward an actual reduction to practice of the invention. There was no allegation in the Rule 608(b) showing that Basmadjian revealed part or all of his conception to any individual at OMRF. There was no allegation in the Rule 608(b) showing that personnel at OMRF "derived" the invention from Basmadjian, nor was the Rule 608(b) showing based on derivation.

7.

The additional evidence will not be considered

Since we have determined that Basmadjian has not shown good cause for having not earlier presented the additional evidence, we will not consider that additional evidence.

IV.

Decision

We have reviewed de novo the order to show cause and hold that it was properly entered on the basis that Basmadjian did not make out a prima facie case of diligence.

We have reviewed Basmadjian's arguments that there is good cause for having not filed the additional evidence with the Rule 608(b) showing. We disagree and hold that Basmadjian has not

shown good cause within the meaning of 37 CFR § 1.617(b). Accordingly, the additional evidence has not been, and will not be, considered.

Basmadjian's Rule 608(b) showing does not establish a prima facie case of diligence for the time period June 29 through September 28, 1992 or the time period October 5 through November 13, 1992. Hence, Basmadjian has not made out a prima facie case of reasonable continuous diligence from prior to Landry's filing date until Basmadjian constructively reduced to practice. Accordingly, summary judgment under 37 CFR § 1.617 should be entered against Basmadjian.

V.

Judgment

For the reasons given herein, it is

ORDERED that Basmadjian additional evidence will not be considered.

ORDERED that summary judgment is entered against the Junior Party Garo Basmadjian and Stanley L. Mills.

FURTHER ORDERED that judgment as to Count 1, the sole count in the interference, is awarded against the Junior Party Garo Basmadjian and Stanley L. Mills.

FURTHER ORDERED that judgment as to Count 1 is entered in favor of the Senior Party Donald W. Landry and Kang Zhao.

cc (via Federal Express):

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