

BOARD OF PATENT
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INTERFERENCES

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#32

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WATTANASIN :
v. : INTERFERENCE NO.: 102,648
PICARD et al : EXAMINER-IN-CHIEF:
v. : MICHAEL SOFOCLEOUS
FUJIKAWA et al :

FUJIKAWA ET AL REPLY TO THE OPPOSITION
TO FUJIKAWA ET AL'S MOTION TO ADD COUNTS 3 AND 4

HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

BOX INTERFERENCE

SIR:

In opposition to Fujikawa's Motion to Add Counts 3 and 4, and add claims to the Wattanasin application, Wattanasin essentially urges three different grounds of opposition. First, Wattanasin insists that the claims proposed by Fujikawa for the Wattanasin application, that correspond to Counts 3 and 4, are not patentable to Wattanasin, Wattanasin lacking a written description the same, 35 U.S.C. 112, first paragraph. Second, Wattanasin urges that the

evidence submitted with the Fujikawa Motion is inadequate to demonstrate that the subject matter of Counts 3 and 4 is directed to subject matter patentably distinct from Counts 1 and 2 in the interference. Third, Wattanasin objects to the Motion on the grounds that Fujikawa's Claim 18 is directed to subject matter closely related to the subject matter of Counts 3 and 4, and not shown to be patentably distinct therefrom. Each of the arguments is replied to, below.

I. Written Description in Wattanasin's Application

Wattanasin urges that Fujikawa's proposed Claims 11 and 12 for the Wattanasin application are unsupported by the Wattanasin disclosure, in that they lack a written description. It is to be particularly noted that the contentions of Wattanasin are unsupported by proof of any kind, and that in fact the evidence of record, including admissions by Wattanasin, supports the opposite conclusion.

In exploring any question of written description, attention is focused on whether or not the specification, as originally filed,

conveys to those of skill in the art that the inventors had possession of the invention at the time the application was filed. Quite conspicuously, any testimony from the inventors, regarding their possession of this invention, is absent from the Wattanasin opposition. Note that the standard for determining compliance with written description, whether or not those of skill in the art would conclude that applicants had possession of the invention at the time of filing, has been long established. In re Smith, 178 U.S.P.Q. 620 (C.C.P.A. 1973). Thus, the sole inquiry presented to the Board on this issue is whether or not one of ordinary skill in the art, reading the Wattanasin disclosure, would conclude that Wattanasin had possession of the invention addressed in Claims 11 and 12 at the time the Wattanasin application was filed.

The sole limitation of proposed Claims 11 and 12 Wattanasin urges is not described in the Wattanasin application is the identity of substituent R as cyclopropyl. Wattanasin urges that there is no specific recitation or exemplification of this species. Fujikawa agrees, but notes that the same is not required for written description. In re Kaslow, 217 U.S.P.Q. 1089, 1996 (Fed. Cir. 1983) and cases cited therein. Specifically, Wattanasin discloses that the substituent at the 2-position may be cycloalkyl

of 3-7 carbon atoms. This identifies a class of five possible substituents. The class is not all that large, and Fujikawa submits that, without more, one of ordinary skill in the art would clearly conclude that the compound of Claim 11, and process of Claim 12, was clearly within the scope of the invention discovered by Wattanasin at the time of filing. Indeed, Wattanasin urges the same. See page 6 of the Opposition. Under similar circumstances, courts of competent jurisdiction have repeatedly held that selection of one among five is clearly supported, for the purposes of written description. In re Driscoll, 195 U.S.P.Q. 434 (C.C.P.A. 1978) (one of 14); and In re Johnson, 194 U.S.P.Q. 187, 195-96 (C.C.P.A. 1977) (a reduction of from 12 to 10 members clearly supported).

While prior cases may be of limited value in determining compliance with the written description provision of 35 U.S.C. 112, first paragraph, it is respectfully submitted that, without more, prior cases have held that the selection of one member of a class of five, when that member is encompassed by the generic disclosure, is supported by that generic disclosure, in the absence of countervailing evidence. Clearly, one of ordinary skill in the art taught that the substituent at the 2-position may be any one of cyclo-

propyl, cyclobutyl, cyclopentyl, cyclohexyl or cycloheptyl would clearly conclude that cyclopropyl is within the province of the invention of Wattanasin. Indeed, it is the likely starting point, having the lowest molecular weight. More is not required.

Beyond that, however, Wattanasin acknowledges that the Wattanasin application repeatedly exemplifies isopropyl. Indeed, isopropyl is mentioned by name as an alternate substituent at the 2-position. Having been taught that isopropyl is an acceptable substituent and within the scope of Wattanasin's invention, those of skill in the art would readily arrive at the selection of cyclopropyl, out of the disclosure of cycloalkyl of 3-7 carbon atoms, as the next logical, and analogous compound, isomerically related to exemplified species. Clearly, in the given case, there is more than simple narrowing of the Wattanasin claims from a genus of five to a sub-genus of one. Here there is additional supportive teaching that the isomer of that sub-genus is also suitable. It is well established that isomeric species are expected to behave in similar fashion, in the absence of evidence to the contrary. Those of skill in the art would certainly consider cyclopropyl to be within the scope of the compound and processes taught and claimed by Wattanasin.

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