THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 122

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

SOMPONG WATTANASIN,

Junior Party,[1]

v.

YOSHIHIRO FUJIKAWA, MIKIO SUZUKI, HIROSHI IWASAKI, MITSUAKI SAKASHITA and MASAKI KITAHARA,

Senior Party.[2]

Patent Interference No. 102,648

FINAL HEARING: November 22, 1994

Before CALVERT, Vice Chief Administrative Patent Judge, and SOFOCLEOUS and DOWNEY, Administrative Patent Judges.

SOFOCLEOUS, Administrative Patent Judge.

[1] Application 07/498,301, filed March 23, 1990. Accorded the benefit of U.S. Application 07/318,773, filed March 3, 1989, now abandoned.

[2] Application 07/233,752, filed August 19, 1988. Accorded the benefit of Japan Applications 207224, filed August 20, 1987; 15585, filed January 26, 1988; and 193606, filed August 3, 1988. Assignors to Nissan Chemical Industries Ltd.

REQUEST FOR RECONSIDERATION

On February 28, 1995, Fujikawa et al. (hereinafter "Fujikawa") filed a request for reconsideration (Paper No. 120) of our decision of January 31, 1995. Wattanasin has filed a reply (Paper No. 121) thereto.

The request for reconsideration was filed pursuant to 37 C.F.R. § 1.658(b), which requires that a request shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. We have reviewed our decision in light of those arguments and are not persuaded that we overlooked or misapprehended any matters.

The request urges that we overlooked three matters pertaining to this interference. These matters are addressed below.

I

The first matter concerns whether the Wattanasin application contains a written description for proposed claims 11 and 12, which are directed to a limited class of compounds where R is cyclopropyl. In our decision, we agreed with the Administrative Patent Judge (APJ) that the application does not contain a written description for these claims and that the APJ had properly denied Fujikawa's motion to add two proposed counts. At page 9 of our decision, we said, "It is clear from the foregoing that the application does not describe ipsis verbis the

compounds of proposed claims 11 and 12 where R is cyclopropyl." Fujikawa urges that this statement is in error and contends that we overlooked the fact that the application contains a disclosure of cyclopropyl, since the application teaches that each of R and R_o can be C_{3-7} cycloalkyl. Fujikawa states that "Wattanasin has not contested, and the Board no where indicates, that any of the remaining identities recited in claims 11 and 12 are not described . . ." (request, page 4).

We have reviewed our decision and find that we did not overlook the matter complained of. On page 9 of our decision, we stated that "the Wattanasin application would not reasonably lead one of ordinary skill to the compounds of claims 11 and 12 where R is cyclopropyl" (emphasis added). On pages 10 and 11 of our decision, we explained our position and stated, in part, as follows:

> The Wattanasin application does not disclose any compound where R is C_{3-7} cycloalkyl, much less cyclopropyl. Rather, cyclopropyl is merely one moiety embraced by C_{3-7} cycloalkyl which is among a myriad of possibilities for either R or R_o disclosed in the application on page 1, lines 1 to 5. Further, the application at page 4, lines 26 to 34, lists its preferred compounds. None of the listed preferred compounds includes cyclopropyl or even C_{3-7} cycloalkyl in the R position. (Page 10 of our decision.)

Thus we did not overlook the matter since we specifically acknowledged that the Wattanasin application describes cyclopropyl as being a possible moiety for the compounds described therein.

Proposed claims 11 and 12 describe only four compounds out of the thousands of compounds embraced by the generic description of the Wattanasin application. See page 8 of our decision which sets forth Wattanasin's disclosure appearing on page 1, lines 1 to 14 of his application. To obtain any one of these four compounds, one skilled in the art must fortuitousily pick and choose from among the nine different variables, i.e., R, R^o, R^1, R^2, R^3, R^4, R^4, X and Z, the specific moieties including 4-flurophenyl as R_o and cyclopropyl as R. As we noted in our decision, the application provides no blazemarks or any motivation to guide one skilled in the art to these specific moieties in order to obtain any one of these four compounds. In support of our position, we cited, inter alia, In re Rushig, 379 F.2d 990, 154 USPQ 118 (CCPA 1967), wherein the Court stated, id. at 994, 154 USPQ at 122:

> Specific claims to single compounds require reasonably specific supporting disclosure and while we agree with the appellants, as the board did, that naming is not essential, something more than the disclosure of a class of 1000, or 100, or even 48, compounds is required. Surely, given time, a chemist could name (especially with the aid of a computer) all of the half million compounds within the scope of the broadest claim, which claim is supported by the broad disclosure. This does not constitute support for each compound individually when separately claimed. [Emphasis original.]

As we noted in our decision, this principle is equally applicable to the situation here where the proposed claims are directed to four specific compounds. Thus we did not overlook this matter.

II

The second matter concerns Fujikawa's motion to suppress. The motion requested that we deny consideration of certain portions of Engstrom's declaration and his supplemental declaration insofar as the declarations rely upon a computer-generated summary to obtain the ED_{50} values. On page 22 and 23 of our decision, we denied the motion to suppress and addressed the substance of the motion insofar as it urged that we deny consideration to the testimony concerning the computer-generated summary. We did not explicitly discuss the motion with regard to an error pointed out by Wattanasin, an error which we acknowledged in footnote 3 on page 20 of our decision, with respect to the switching the ED_{50} values for compounds 64-933 and 64-935.

Fujikawa now urges that we overlooked the fact that the motion to suppress also urged that the supplemental declaration was not timely submitted, was submitted belatedly without an explanation of good cause or an identification of how the error concerning switching the ED_{50} values for compounds 64-933 and 64-935 had occurred. However, in denying the motion, we implicitly agreed with Wattanasin's opposition that the error which we noted in footnote 3 should be corrected. The correction did not in any way alter the substance of Engstrom's testimony and Fujikawa's objection did not in any way show that the correction should not have been made or show any undue prejudice inuring to him by our permitting Wattanasin to

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