No. 102975 [redacted]

(B)
A-102648

Sofocleous
EXAMINER IN CHIEF

ADJUDGE

INTERFERENCE

ADJUDGE

CAFC

Wattanasin S.N. 07/498,301

v.

Fujikawa et al. P.N. 5,011,930

v.

Fujikawa et al. S.N. 07/233,752

Quinoline Type Mevalonolactones

Group 1201

PTO-257

Richard E. Villa, Walter P. Jewell, Thomas O. McGovern, Thomas C. Doyle, Melvyn M. Kassenoff, Joseph J. Borovian, Joanne M. Giesser and Diane E. Furman

Associate Attorney: None

Accorded Benefit of: U.S. Serial No. 07/318,773 filed 03/03/89

Address: Gerald D. Sharkin
Sandoz Corp.
59 Route 10
E. Hanover, NJ 07936

Junior Party

Applicants: Yoshihiro Fujikawa, Mikio Suzuki, Hiroshi Iwasaki, Mitsuaki Sakashita and Masaki Kitahara

Addresses: Nissan Chemical Industries, Ltd, Chuo Kenkyusho, 722-1, Tsuboi-cho, Funabashi-shi, Chiba-ken, Japan Respectfully

Serial No.: 07/483,720 filed 02/23/90, Patent No. 5,011,930 issued 04/30/91

For: Quinoline Type Mevalonolactones

Assignees: Nissan Chemical Industries Ltd., Tokyo, Japan

Attorneys of Record: Norman F. Oblon, Stanley P. Fisher, Marvin J. Spivak, C. Irvin McClelland, Gregory J. Maier, Arthur I. Neustadt, Robert C. Miller, Richard D. Kelly, James D. Hamilton, Eckhard H. Kuesters, Robert T.

Pous, Charles L. Gholz, Vincent J. Sunderdick, William E. Beaumont and Steven B. Kelber

Associate Attorney: None

Accorded Benefit of: Japan Serial Nos. 207224 filed 08/20/87, 15585 filed 01/26/88 and U.S. Serial No. 07/233,752 filed 08/19/88

Address: Steven B. Kelber
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Arlington, VA 22202

Senior Party

Applicants: Yoshihiro Fujikawa, Mikio Suzuki, Hiroshi Iwasaki, Mitsuaki Sakashita and Masaki Kitahara

Addresses: Nissan Chemical Industries, Ltd, Chuo Kenkyusho, 722-1, Tsuboi-cho, Funabashi-shi, Chiba-ken, Japan Respectfully

Serial No.: 07/233,752 filed 08/19/88

For: Quinoline Type Mevalonolactones

Assignees: Nissan Chemical Industries Ltd., Tokyo, Japan

Attorneys of Record: Norman F. Oblon, Stanley P. Fisher, Marvin J. Spivak, C. Irvin McClelland, Gregory J. Maier, Arthur I. Neustadt, Robert C. Miller, Richard D. Kelly, James D. Hamilton, Eckhard H. Kuesters, Robert T. Pous, Charles L. Gholz, Vincent J. Sunderdick, William E. Beaumont and Steven B. Kelber

Associate Attorney: None

Accorded Benefit of: Japan Serial Nos. 207224 filed 08/20/87 and 15585 filed 01/26/88
Japan Serial No. 193606, filed Aug 3, 1988.

Sel #59 4 Int 102,648

Address: Oblon, Fisher, Spivak,
McClelland & Maier
1755 S. Jeff. Davis Hwy.
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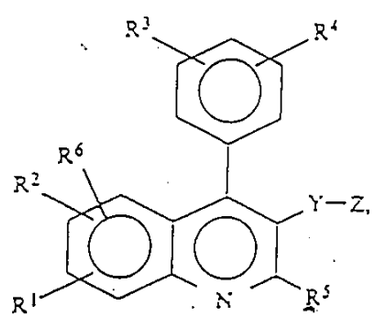
Arlington, VA 22202

Count 1

A compound of the formula:



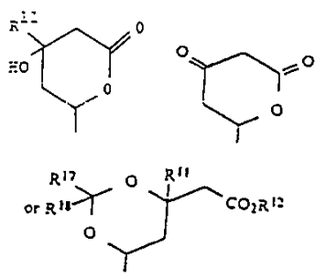
wherein R^1, R^2, R^3, R^4 and R^6 are independently
hydrogen,
C_{1-6} alkyl,
C_{1-6} cycloalkyl,
C_{1-3} alkoxy,
n-butoxy,
i-butoxy,
sec-butoxy,
R^7R^8N- (wherein R^7 and R^8 are independently hydrogen or C_{1-3} alkyl),

trifluoromethyl,
trifluoromethoxy,
difluoromethoxy,
fluoro,
chloro,
bromo,
phenyl,
phenoxy,
benzyloxy,
hydroxy,
hydroxymethyl,
$-O(CH_2)_\alpha OR^{19}$ (wherein R^{19} is hydrogen or C_{1-3}alkyl and α is 1, 2 or 3),
or when located at the ortho position to each other, R^3 and R^4 together optionally form $-CH=CH-CH=CH-$;

R^5 is hydrogen,
C_{1-6} alkyl,
C_{2-3} alkenyl,
C_{3-6} cycloalkyl,
phenyl substituted by R^9 (wherein R^9 is hydrogen, C_{1-4}alkyl, C_{1-3}alkoxy, fluoro, chloro, bromo or trifluoromethyl),
phenyl-$(CH_2)_m$- (wherein m is 1, 2 or 3), $-(CH_2)_nCH(CH_3)$-phenyl or phenyl-$(CH_2)_nCH(CH_3)$- (wherein n is 0, 1 or 2).

Y is
$-CH_2-$,
$-CH_2CH_2-$,
$-CH=CH-$,
$-CH_2-CH=CH-$, or
$-CH=CH-CH_2-$;

Z is



The claims of the parties which correspond to Count 1 are:

Wattanasin : Claims 1-7 and 10

Fujikawa et al. '930 : Claim 1

Fujikawa et al.: Claims 1-9, 11-34, 36, 39 and 40

Michael Sofocleous
Examiner-in-Chief
(703) 557-4066

gjh

Paper No. 2

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Telephone: (703)557-4007
Facsimile: (703)557-8642

Interference No. 102,975

Wattanasin

v.

Fujikawa et al.

v.

Fujikawa et al.

This interference is declared as a result of a decision on preliminary motions in related Interference No. 102,648.

No time is being set for filing motions. A time was set for filing preliminary statements concerning this interference in the related interference and such statements will be transferred to this interference. Times for taking testimony will be set concurrently with the related interference.

Michael Sofocleous
Examiner-in-Chief
(703) 557-4066

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

WATTANASIN	:	
v.	:	**INTERFERENCE NO.: 102,975**
FUJIKAWA et al	:	**EXAMINER-IN-CHIEF:**
v.	:	**MICHAEL SOFOCLEOUS**
FUJIKAWA et al	:	

PRELIMINARY STATEMENT OF FUJIKAWA ET AL

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

SIR:

With respect to both the Fujikawa '930 patent involved, and the Fujikawa application involved, Fujikawa relies, with respect to the Count of the Interference, solely on the filing dates of Japanese Patent Applications 207224/1987, 15585/1988 and 193606/1988, filed August 20, 1987, January 26, 1988 and August 3, 1988, respectively, to prove a constructive reduction to practice of the Count of the Interference. Any necessary extensions of time have been sought in the Request for Reconsideration filed in Interference 102,648.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202
(703) 521-5940

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **PRELIMINARY STATEMENT OF FUJIKAWA ET AL** was served by first class mail, postage prepaid, on counsel for the Party Wattanasin, as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

this 21st day of AUGUST, 1992.

Steven B. Kelber

Appended is the Preliminary Statement of the party Wattanasin for the subject interference.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

DEF:rmf
August 27, 1992

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on August 27, 1992
(Date of Deposit)

Diane E. Furman
Name of applicant, assignee, or Registered Representative

Diane Furman
Signature

8/27/92
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the papers entitled:

NOTICE OF THE FILING OF THE PRELIMINARY STATEMENT OF THE PARTY WATTANASIN

and

PRELIMINARY STATEMENT OF THE PARTY WATTANASIN

were served on counsel for the party Fujikawa et al., this 27th day of August 1992, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

Case No. 600-7101/CONT/Int.
Patent

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

WATTANASIN
v.
Fujikawa et al.
v.
FUJIKAWA et al.

Interference No. 102,975
Examiner-in-Chief: M. Sofocleous

PRELIMINARY STATEMENT OF THE PARTY WATTANASIN

In accordance with 37 CFR 1.622 and 1.623, the party Wattanasin hereby states as follows:

(1) That the invention of each of Counts 1 and 2 was made in the United States by Sompong Wattanasin.

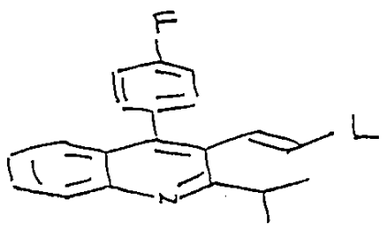
(2) That the invention of each of Counts 1 and 2 was first disclosed by Dr. Sompong Wattanasin, to Dr. Faizulla Kathawala of Sandoz Pharmaceuticals Corporation, by November 28, 1983.

(3) That the invention was first conceived no later than November 28, 1983.

(4) That the first drawing or written description of the invention of each of Counts 1 and 2 also occurred by November 28, 1983, when Dr. Wattanasin proposed to Dr. Kathawala to synthesize compounds of the invention of Counts 1 and 2 from previously synthesized intermediates and commercially available compounds for formulation into compositions for use as HMG-CoA reductase inhibitors.

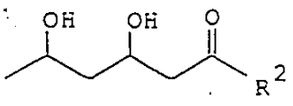
Exhibits A-B[1] document the first drawing or written description of the invention.

Exhibit A comprises a true copy of a research proposal of Sompong Wattanasin, the last page of which lists a compound designated 14, as follows:

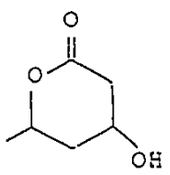


14

and "L" indicates either of the following side chains:



and

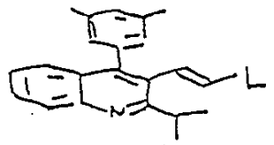


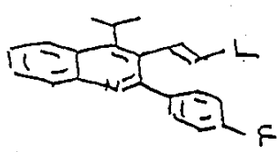
where R^2 is an acid, a salt or an ester.

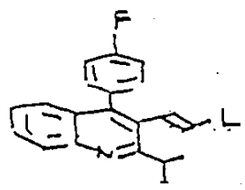
---

1. The documents appended as exhibits hereto correspond to certain of the exhibits already provided with Wattansin's Request for Interference of May 25, 1990, with the exception that the dates are left unmasked. A detailed explanation of the exhibits is provided in the Request.

Exhibit B comprises a true copy of another research proposal submitted by Dr. Wattanasin to Dr. Kathawala which further indicates a drawing or written description of the invention on November 19, 1984. Page 1 thereof contains the following compounds:







wherein L and R_2 have the significances mentioned above.

(5) That the date after conception when active exercise of reasonable diligence began was no later than May 31, 1984.

(6) That the first synthesis of a compound within the scope of Count 1, and an active agent of a method of Count 2, was performed by Sompong Wattanasin and was completed on November 15, 1984, when Compound 1079-111-19 (subsequently redesignated Compound 63-366), comprising an erythro racemate, was prepared, and recorded in his laboratory notebook.

Exhibits C-D comprise true copies of laboratory pages from the notebook of Sompong Wattanasin followed by copies of NMR spectra for the final product synthesized[2]:

Exhibit C comprises a true copy of Laboratory Notebook No. 1049, pages 237, 241, 248, 251, and Laboratory Notebook No. 1079, pages 22, 24, 27, 30, 33, 34, 39, 105, 106, 110 and 111, corresponding to the synthesis of Compound **63-366** and its non-commercially available intermediates. The NMR spectrum of Compound **63-366** was taken on November 21, 1984.

Exhibit D comprises copies of Laboratory Notebook No. 1127, pages 5, 9, and 11 (together with copies of spectra) corresponding to Compound 1127-11-34 of the invention (later redesignated Compound **63-548**) and Compound 1127-11-37 (later redesignated Compound **63-549**) of the invention and their non-commercially available intermediates. Both compounds also comprise erythro racemates.

(7) That the date of first actual reduction to practice was no later than December 31, 1984, when Compound **63-366** was known to have in vitro activity as an HMG-CoA reductase inhibitor.

---

2. On some of the notebook pages, microanalysis data were affixed subsequent to the date the actual synthesis was performe

Exhibits E-F comprise true copies of portions of bioassay data sheets which were prepared by Dr. Terence J. Scallen, an outside consultant for Sandoz. The bioassay data sheets were prepared concurrently with the tests, and then sent to Dr. Robert E. Damon of Sandoz. (The sheets bear the handwritten notations of Dr. Damon after he received them from Dr. Scallen.)

The bioassay data show that a composition containing Compound 63-366, i.e., a dimethylacetamide solution of Compound 63-366, was tested for HMG-CoA reductase inhibition activity on December 13, 1984. The test demonstrated that Compound 63-366 achieved a 50% inhibition of HMG-CoA reductase at a concentration of $< 1x10^{-6}$ µ/l.

Additionally, dimethylacetamide solutions of, respectively, Compounds 63-548 and 63-549, were each tested for HMG-CoA reductase inhibition activity on June 13, 1985.

Exhibit E comprises a true copy, of the protocol which was followed, and Scallen's Laboratory Notebook pages which recorded the data for **63-366**.

Exhibit F comprises a true copy, of the description of the procedure and the printout showing the data for **63-548** and **63-549**.

Respectfully submitted,

Diane Furman 8/27/92

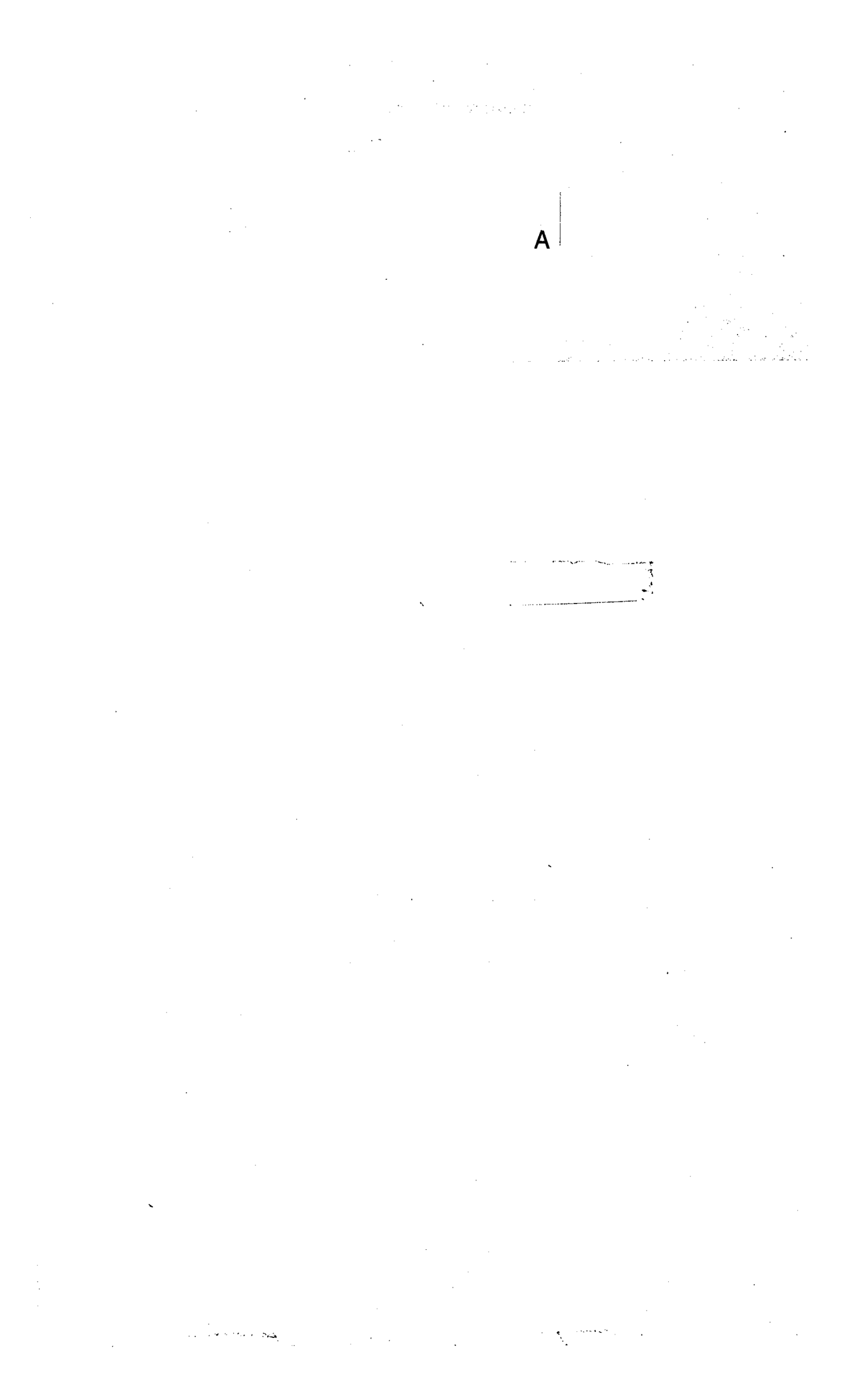
Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

DEF:rmf

August 27, 1992

Exhibits A,B,C,D,E,F


A

(3) copy to: Kathawala

1984 Proposal

Sompong Wattanasin
November 28, 1983

Our plan for 1984 was organized into four general areas of increasing difficulty.

We will conduct the work in the approximate order present below. All of our work will be guided by results of biological assays and we will use biological information as it becomes available to modify our synthetic objectives.

The four areas are:

① Synthesis of Indenes

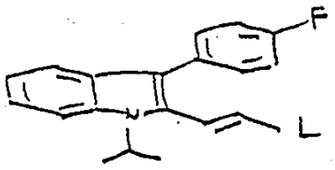
② Synthesis of "restricted rotation" Indole analogues,

× ③ Synthesis of complex analogues based on SAH 62-528 – Aza analogue of Compactin

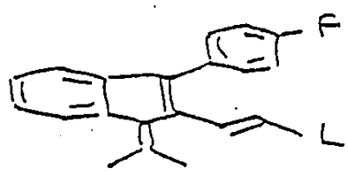
④ Synthesis of new analogues based on ① → ③.

① Synthesis of Indenes

Based on the indole 1, we intend to prepared and testing compounds 2 - 4

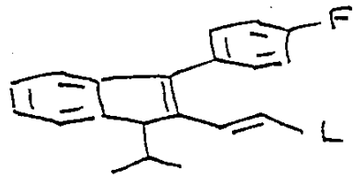


1

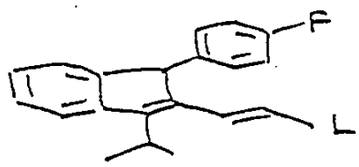


2

L = Lactone



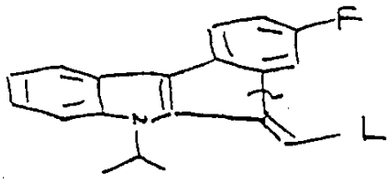
3



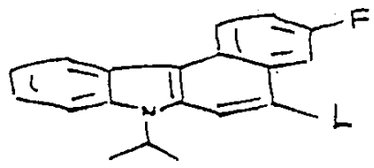
4

Compound 2 will be prepared to examine the effect of replacement of the nitrogen by carbon. Compound 3 and/or 4 will next be prepared to test whether or not the free rotation of the isopropyl group necessary for activity.

(2) Synthesis of "restricted rotation" Indoles



5

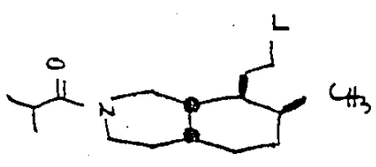


6

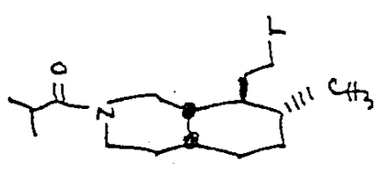
Analogues 5 and/or 6 are proposed as probes of the rotation requirements of the para-fluorophenyl group and the double bond side chain of the lactone. Nothing is currently known in this regard.

(3) Synthesis of Complex analogues based on SAH 62-528 – Aza analogue of compactin.

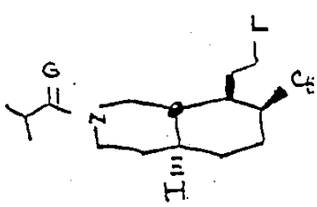
A) Asymmetric Synthesis of an aza analogue of compactin



7

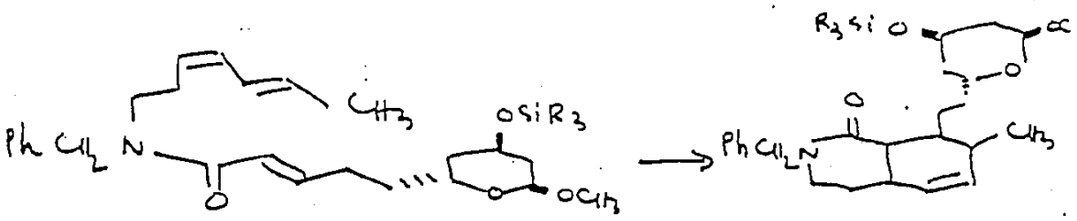


8

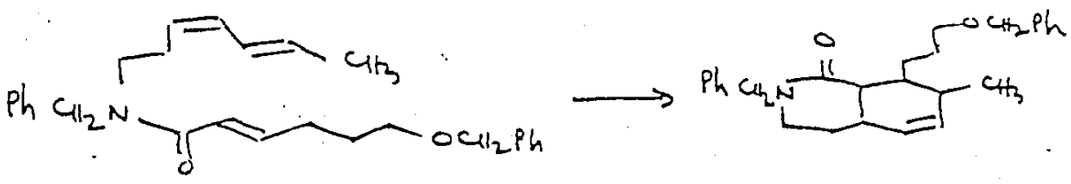


9

(b) Identity of the products from the following Diels-Alder reactions.

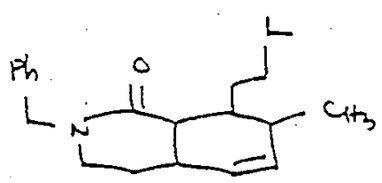


stereochemistry



C). Synthesis of the analogue 11.

Compound 11 is a close relative of the aza analogues of compactin 7 – 9, but might be more readily obtainable by the route shown above.

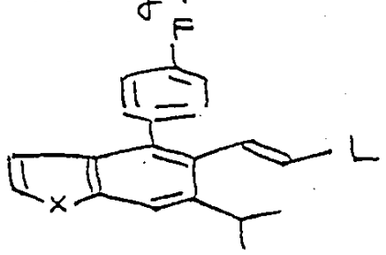


11

In addition, computer modellings show a better overlapping between compactin and 11 than those of 7 – 9

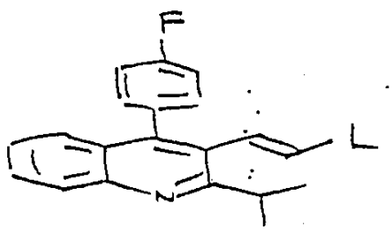
④ Synthesis of new analogues based on ① – ③

If any of the analogues thus far proposed show interesting activity, it may be necessary to prepare a variety of compounds with various modifications. In addition, several more analogues such as 12 – 14 are of interesting.



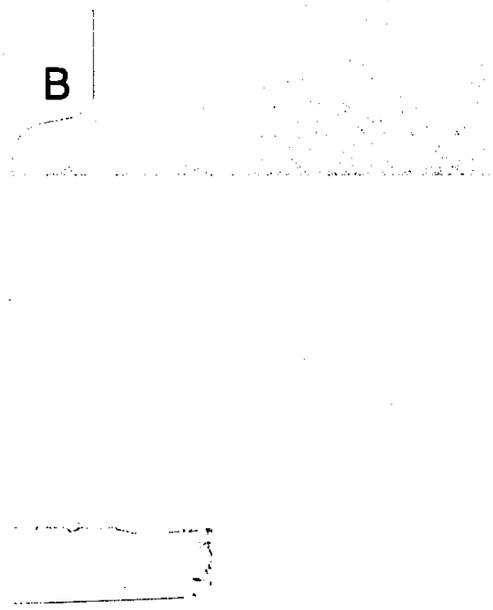
12 X = NR

13 X = S



14

It is unrealistic to expect all of these goals to be accomplished during the next year period, but we certainly expect to complete the indene analogue, the restricted rotation indole analogue, the optical synthesis of an aza analogue of compactin, to complete general study of Diels-Alder reaction of 2 aza trienes, and to make a substantial progress into the synthesis of other analogues.


B

cpy. to Dr. F.K. Kawaguchi

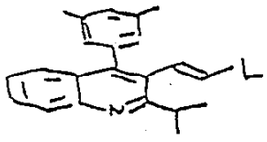
(3)

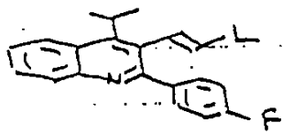
Sompong Wattanasin
Nov. 19, 1984.

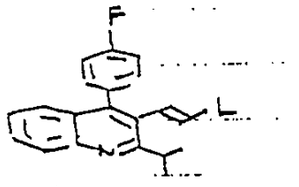
1985 Proposal

The followings are my objectives in 1985

(1) Complete the project on QUINOLINE system. If one of the quinoline proved to be very active, all of these three quinolines and

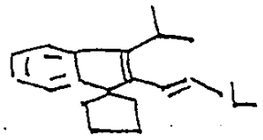


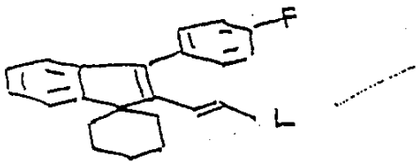


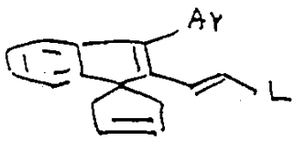


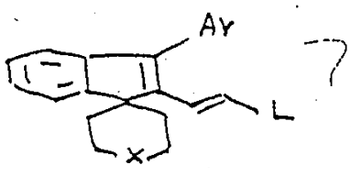
a few modifications might need to be prepared, because of their apparent ease of synthesis.

(2) Complete the project on INDENE systems. Some of these closely related analogs may be necessary to prepare, to find out the optimum structure.



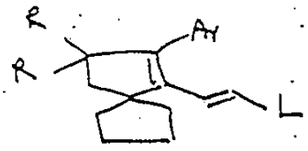




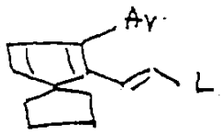


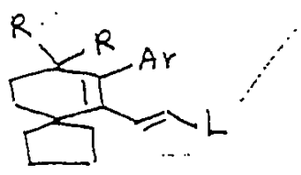
X = O, NR, S

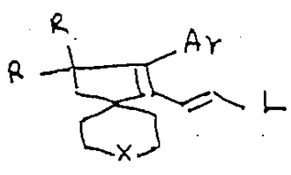
(3) New Analogs of Indeed.



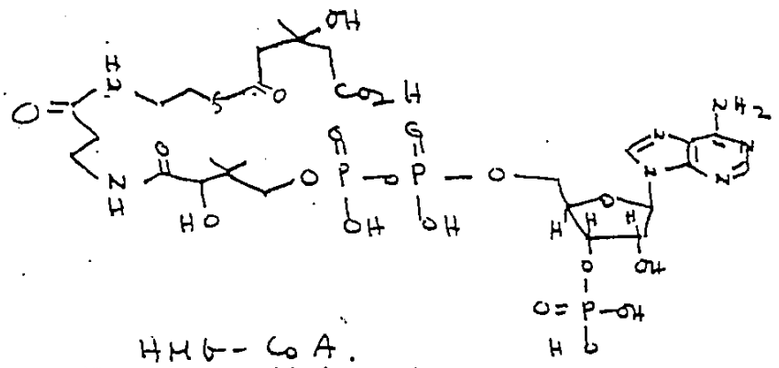
R = Aryl, alkyl groups
X = O, NR, S





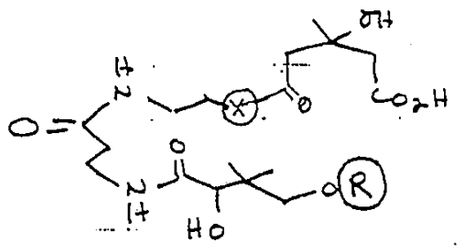


(4) X-ray structure of crystalline HMG-CoA derivatives.

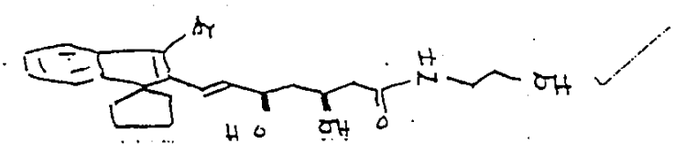


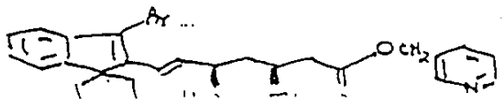
HMG-CoA.

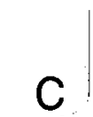
Derivatives vary R ← X



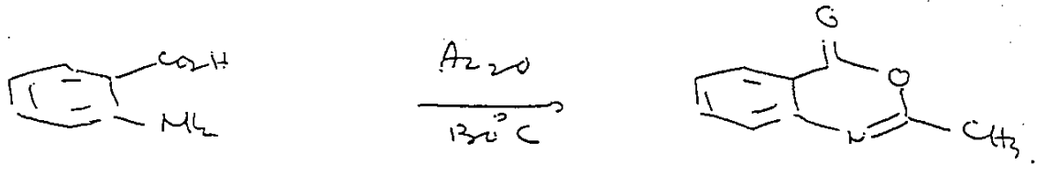
(5) New modifications based on (1 – 3), and modifications on ester R groups eg.






C

Acc. JCS 2702 (1958)



anthranilic acid = 10 g
acetic anhydride = 54 ml.

A mixture of anthranilic acid and acetic anhydride was heated at 130°C. 12.00 pm. for 30 min. Then ~ 30 ml of H_2O was removed, the residue was cooled to give a yellow solid. Recrystallization from H_2O gave a pale yellow solid = 8.9 g (1049-237-19)

nmr

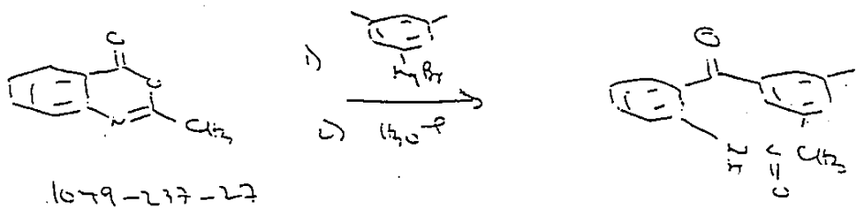
(1049-237-19) was dissolved in ether and filtered through a short pad of silica gel. Evap n gave a colorless solid = 7.0 g (1049-237-27) mp. 76-78°C

nmr ✓ IR ✓ micro ✓

$C_9H_7O_2N$ 161.161

	C	H	N	O		
Calc.	67.07	4.34	8.69			
Found						
	66.50	4.44	8.45			

cf. P. 158.



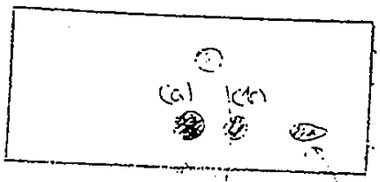
1049-237-27

161	1049-237-27	=	2 g	(0.0124 mol)
(157)	5-bromo-m-xylene	=	3.44 g	(0.0186 mol)
(24)	Mg	=	446 mg	(0.0186 mol).
	ether	=	10 ml.	
	benzene	=		

To a suspension of Mg in ether 2 ml a a few drop of I_2 at r.t, was added a few drop of 1,2 dibromoethane, followed by a sol'n of 5-bromo-m-xylene in ether (8 ml) dropwise (at a rate that the reaction mixture refluxe gently). 9. of am. -> ~~9.45~~ 9.45 am. The reaction mixture was then heated at reflux for 3 h. Then The prepared reagent was withdrawn by a syringe (2 ml) and added to a sol'n of 1049-232-22 in THF (10 ml) + ether (2 ml) dropwise (via a funnel)

6/1/84: 8.30 am. The reaction was decomposed with 3N HCl & extracted with ether to give a yellow oil = 3.6 g (1049-244-3)

Prep TLC (300 g) (1:1 ether-pet.) gave

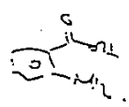


SM (a): white oil = 128 mg (1049-244-2) NMR ✓

(b): white solid = 24 mg (1049-244-3)

Shiny weak KMnO4 Pos.

Come from hydrolysis of S.M.



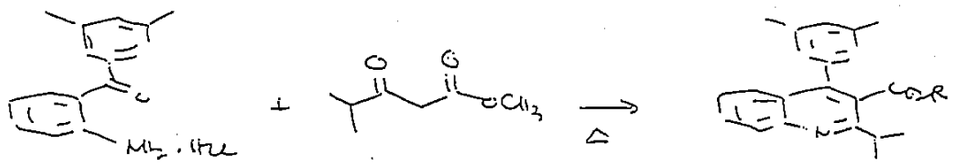
HPLC of the rest gave the product = 1.6 g (1049-244-4)

Performed by- S. Wattanasin

Witness- M. Rodella

Cont'd to-

cf. J. Het. Chem. 7 (67 (1970)
J. Prakt. Chem. [4] 34, 295 (1966)

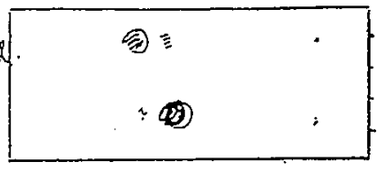


(261.5) 1049-244-24. = 20 mg (0.0000766 mol)
(144) [structure] = 11 mg (0.0002011 mol).
⇒ EtOH = 2 ml. → 0.02 ml.
conc. HCl = 1 drop.

The solution was heated at reflux 9.30 am. → ~~12.30 pm.~~ 5.00 pm.

Concentrated, about half with MeOH + extracted with ether. The ether ex was purified by prep TLC (1:1 eth—petrol) to give

(a) (i)



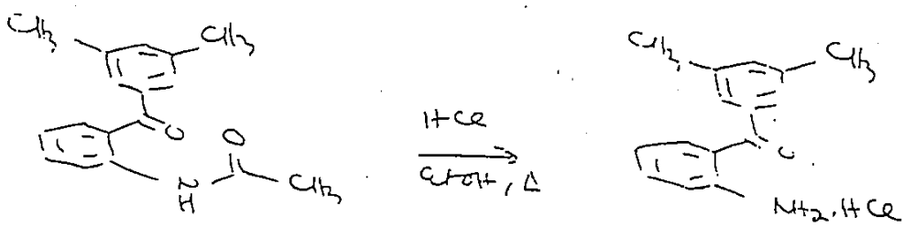
colourless oil
(a) 1 = 17 mg (1049-244-24)
NMR ✓ ⇒ perfect.

Performed by- S. Wattanasin
Witness- M. Barbella
Cont'd to-

Title- 1049

Date 6/16/89 Proj.

Cont'd From-



1049 – 241 – 43 = 1.6 g
EtOH = 20 ml
Conc HCl = 0.5 ml.

The solution was heated at 90°C

start 8:50 am.

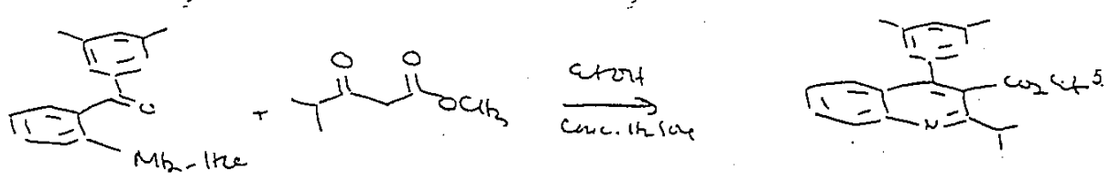
stop 4:00 pm. TLC showed very small amt of the starting material.

The soln was concentrated and the residue was taken up in ether and filtered to give a pale yellow solid = 1.15 g (1049–148–24)

Performed by: S. Wattanasin

Witness: M. Rolella

Cont'd to-

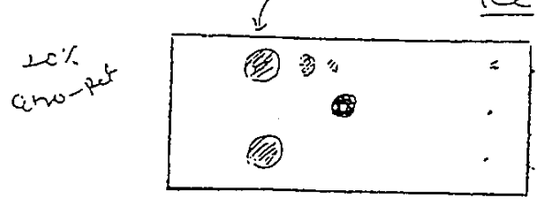


(461.5) 1049 = 248 − 24 = 500 mg (0.00191.2 mMol)
(144) = 412 mg (0.00286 mol)
AcOH = 20 ml.
Conc H2SO4 = 0.1 ml.

Procedure Same → 1049-245 Rx.

Start reflux. @ 50 am:

TLC 12.30 pm. Stop 12.30 pm



Concentrated, basified with NH4OH, diluted with lice & extracted with ether to give an oil = 420 mg Prep TLC (20% Acetone-petrol) gave one main band.

= 565 mg which on standing in the fridge solidified: pale yellow solid. (1049-271-29)

m.p. 82–83°C

$C_{23}H_{24}N_2O_2$ micro

	C	H	N	O
Calc.	78.37	7.45	4.03	
Found				
	81.78	6.83	4.20	
	80.3	7.01	4.32	

Performed by- S. Wattanasin

Witness- M. Rapicelli

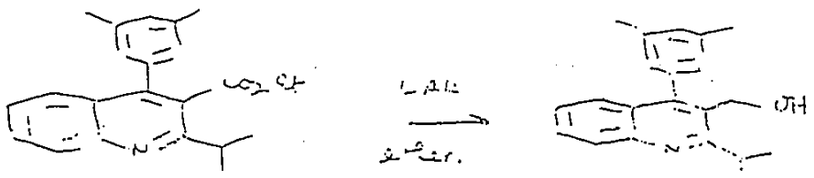
Cont'd to-

22

Title- 1079

Date 5/10/94 Proj. D

Cont'd From- C



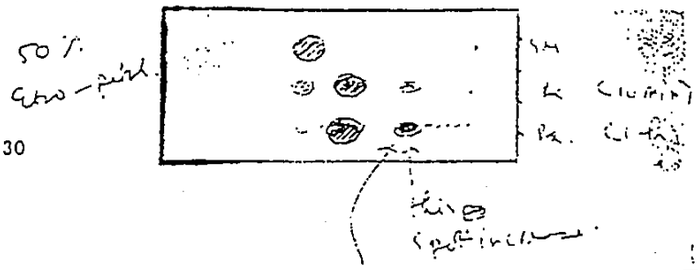
$C_{13}H_{14}O_2N$

(347) . 1049 – 221 . 29 : 535 mg (10.55 154 ml)
(38) LAH - 112 g. (0.001 mol)
ether = 8 ml

To a solution of (1049-221-29) in dry ether, at r.t. was added LAH portionwise. The mixture was then stirred at r.t. and followed by TLC.

9.15 am:

TLC after 10 min ⇒ 2 spots mainly the product.
9.50 10.15 am



This reaction was quenched with the saturated with ether to give an crude 423 mg (1049-22-29)

mp 110-112°C (Literature mp 113-114°C)

12 ⇒ pure (crystallized with ether)

Performed by- S. Wattanasin

Witness- M. Rubello

Cont'd to-

Title- # 1079

Date 5/10/24 Proj.

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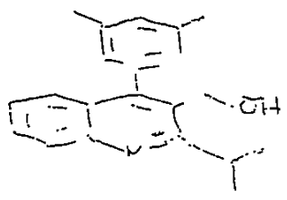
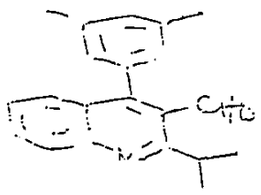
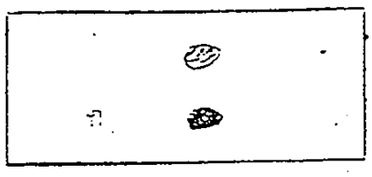
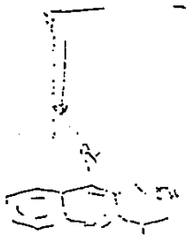


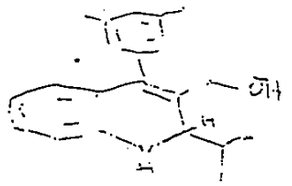
MnO_2

Toluene









Performed by- S. Wachtmeister

Witness- M. Pacholka

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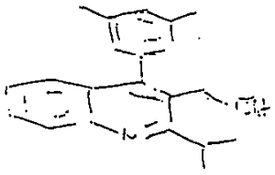
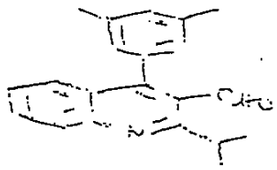


PCC.



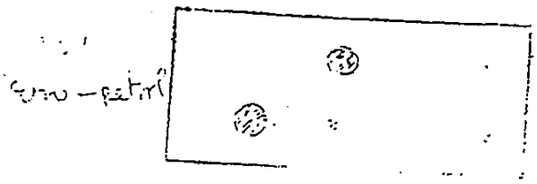
[illegible] =
DDQ =
Toluene =

→ The mixture was stirred at r.t. overnight. TLC no r.a.

The reaction mix. (dark red oil) was adsorbed onto silica and filtered through a pad of silica gel. Eluted with Hex:EtOAc 9:1 to remove dark red gum. TLC => no change.

→ The mixture was dissolved in toluene, PCC (1000 mg) and molecular sieves (1 g) were added. The mix. was stirred for 18 hr at r.t. => TLC => product + SM.

Diluted with ether, filtered through silica gel (~5 cm). Evap. Hex:EtOAc 2:1 gave a pale yellow gum (1079 — 23 — 1A). 1.2 mg. IR. Submitted for testing.

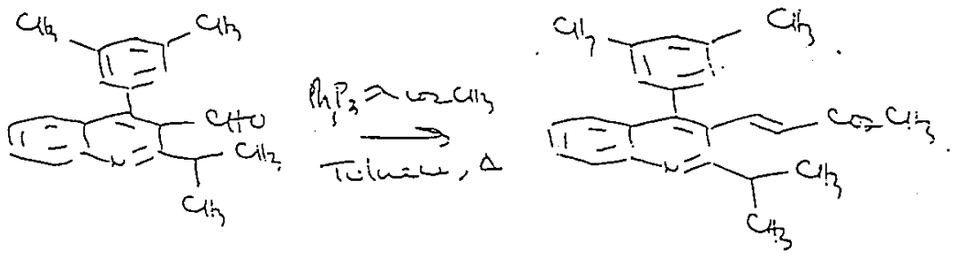


30

Title #1079

Date 8/17/94 Proj.

Cont'd From-



1079-27-4 = 140 mg
the ylide = 200 mg
toluene = 5 ml.

The mixt. was heated at reflux for 3 h. After cooling the reaction mixt. was diluted with ether and filtered through a pad of silica gel. Concentration gave a semisolid, which was purified by prep. TLC to give a colorless solid = 140 mg (1079-30-23) IR nmr / mp 110-112°C

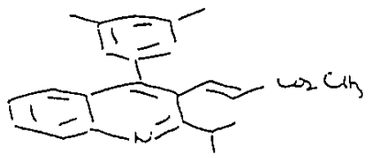
TLC => only one main band of product

Performed by- G. Wuitschik

Witness- M. Rolella

Con'd to-

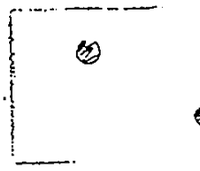
Date 8/21/94. Proj.	Title- # 1079	33
'd From-		



1079-30-23 = 130 mg (0.000368 mol)
DIBAL-H = 0.5 ml. (0.0007 mL ml).
CH_2Cl_2 = 5 ml.

To a solution of (1079-30-23) in dry CH_2Cl_2 at $-78^\circ C$ was added DIBAL-H. The mixt. was then stirred at $-78^\circ C$
11.30 am:
12.00 pm ⇒ complete reaction
The reaction was diluted with ether and filtered through a pad of silica gel. Evapn gave a crude oil = 135 mg which was used directly in the next step (1079-33-19) TLC ⇒ one spot

1:1 Hex-EtOAc



Performed by-	
Witness-	Cont'd to-

Title- # 1079

Date. 8/23/84 Proj.

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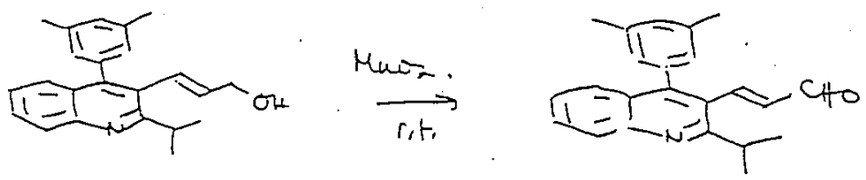
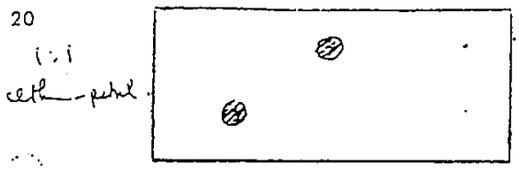


1079-33-19 = 135 mg
MnO2 = 300 mg
Toluene = 5 ml.

A mixture of (1079-33-19) and MnO2 in toluene was stirred at r.t. overnight

petroleum ether ⇒ 104 mg (1079-34-17)

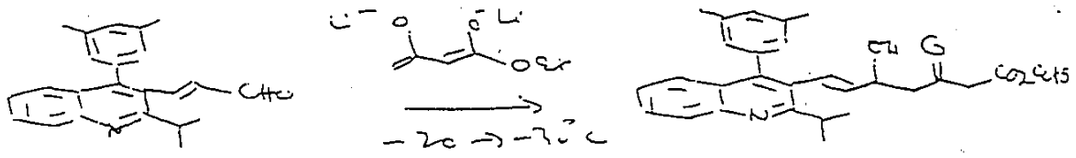
hmv



Performed by- S Wattamwar

Witness- N. Rodella

Cont'd to-



(3.9) 1079-74-17 = 100 mg (0.0003039 mol).
the diamine from
1079-38-21 = 5 ml (~ 0.0014 mol).
THF = 4 ml.

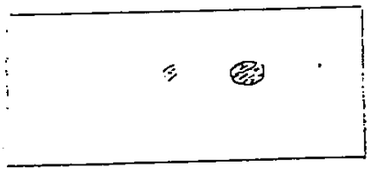
10 20 am - 10.52 am:
The ⇒ complete reaction
The reaction was quenched with sat. NH4Cl and extracted with ether.

to give an yellow oil = 177 mg (1079-39-1)

The crude P. was reduced directly without further purification
see P. ~~40~~ 41

The ⇒ one main spot.

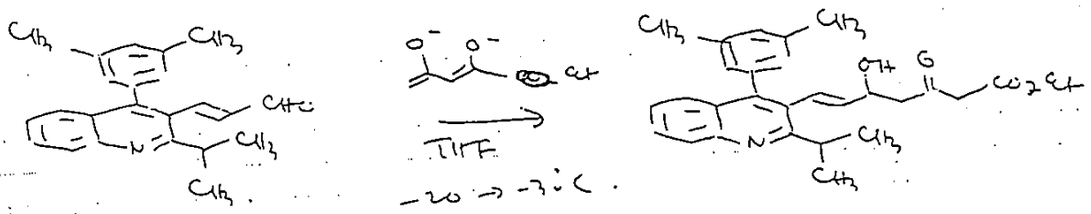
1:1 ether-pet.



Date 11/8/89 Proj.

Cont'd From-

e- LDA (mono- 22.57 wt : 1.5 M. => 1.3 M. 105



(329) 10.79 - 101 - 28 = 110 mg (0.000 3343 mol)
10.19, .322 Diisopropylamine = 0.5 ml (0.00334 mol)
1.6 M nBuLi = 2 ml. (0.00336 mol).
130.14, 1.021 ethyl acetoacetate = 0.22 ml : (0.000 1667 ml)
THF = 5 ml.

commercially available

To a soln of diisopropylamide (1.8 M in cyclohexane, 1.8 ml) in THF (4 ml) at -2°C, was added ethylacetoacetate (0.22 ml). The resulting yellow soln was stirred at -20 => -30°C for 30 min.

4.00 pm: 4 ml. of the diisopropylamide soln was added to a soln of (1079-101-29) in THF (2 ml) at -30°C. => -10°C

4.30 pm. TLC after 20 min => only trace of S.M. One main spot of product. The reaction was quenched with 2 ml of sat. NH4Cl & extracted with Et2O

(1-) (a) gave a yellow oil = 290 mg
(1:1 ether-pet.) (1:1) P.L.C. (1:1 ether-petrol)
Chromatogram

(a) : yellow oil = 112 mg (1079-101-35)
n.mr ✓ I.R. ✓

Performed by- S. Wallace

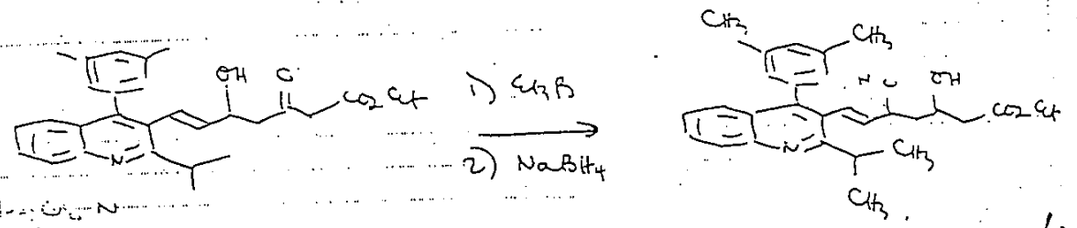
Witness- M. Rodella

Cont'd to-

Title-

Date 11/13/94 Proj.

Cont'd From-

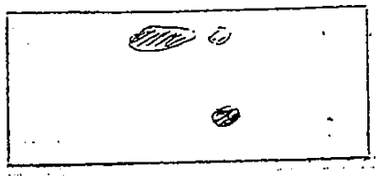


(479) 1079-105-35 = 17 mg (0.0001198 mol)
1 M Et_3B in THF = 0.15 ml (0.0001437 mol)
THF = 2 ml.

To a soln of (1079-105-35) in THF (2 ml) at r.t. was added 1M Et_3B a (1 ml) of air by syringe. The soln was stirred for 1h.
9,00 am.
10.30 am. At -78°, $NaBH_4$ (10 mg) was added.

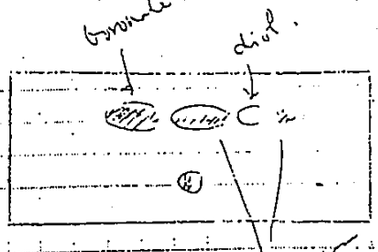
11/13/94. 8,30 am ⇒ TLC ⇒ still showed spot of S.M
15 mg more of $NaBH_4$ was added & continued stirring.

TLC 3.00 pm ⇒ Spot of the product increased, but still some S.M.



1:1 Ether-pethf.

The reaction was stirred for 3h in ice, acidified 3N HCl was added until acidic (pH-check), diluted with H2O (during this period reaction mixt. turned to fluorescence ?, dehydration ??).



The crude product (70 mg) was used directly in the next step (1079-106-76)

Performed by- S. Wattanasin

Witness- M. Kalelkar

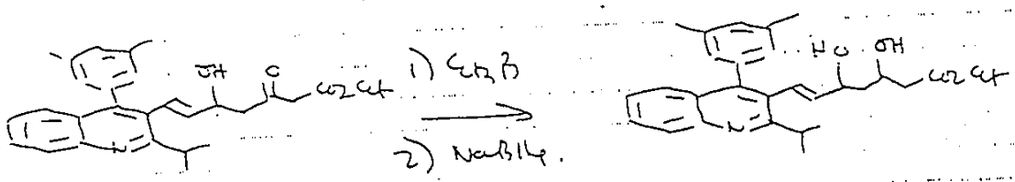
Cont'd to-

Title-

110

Date : 11/14/84 Proj.

Cont'd From-



1) Et_3B

2) $NaBH_4$.

avoid Hcl treatment!

1079-105-15	=	52 mg
1M Et_3B	=	0.12 ml.
THF	=	2 ml.
$NaBH_4$	=	20 mg.

1) 2.30 pm:

2) 3.30, -78°C

11/15/84: The reaction mixt. almost colorless. was diluted with 4 ml CH_3OH, after the cool bath was removed. After 10 min.* 1 ml 1N HCl was added. After the evolution of H_2 subsided. The reaction mixt. was concentrated a few mps of H_2O, water added. The residue was extracted with ether two times. The combined ether extracts were washed with brine, dried over $MgSO_4$ and concentrated to give a yellow oil.

* slightly fluorescent color occured.

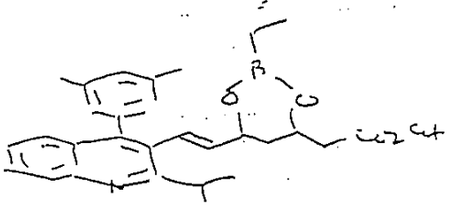
See TLC P. 109 => mixture of boronate + diol ?

=> pale yellow + sm fluorescent oil = 40 mg (1079-110-33) which was used directly in the next step.

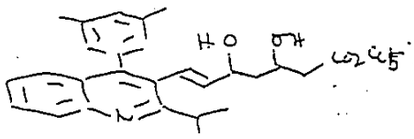
Performed by- G. Wuitz

Witness- M. Pavlellas

Cont'd to-



CH_3OH ⟶



$C_{29}H_{37}O_4N$

1079-110-33 = 40 mg

CH_3OH = 4 ml.

The soln was stirred at r.t. for 3 days.

~~9.30 a.m.~~

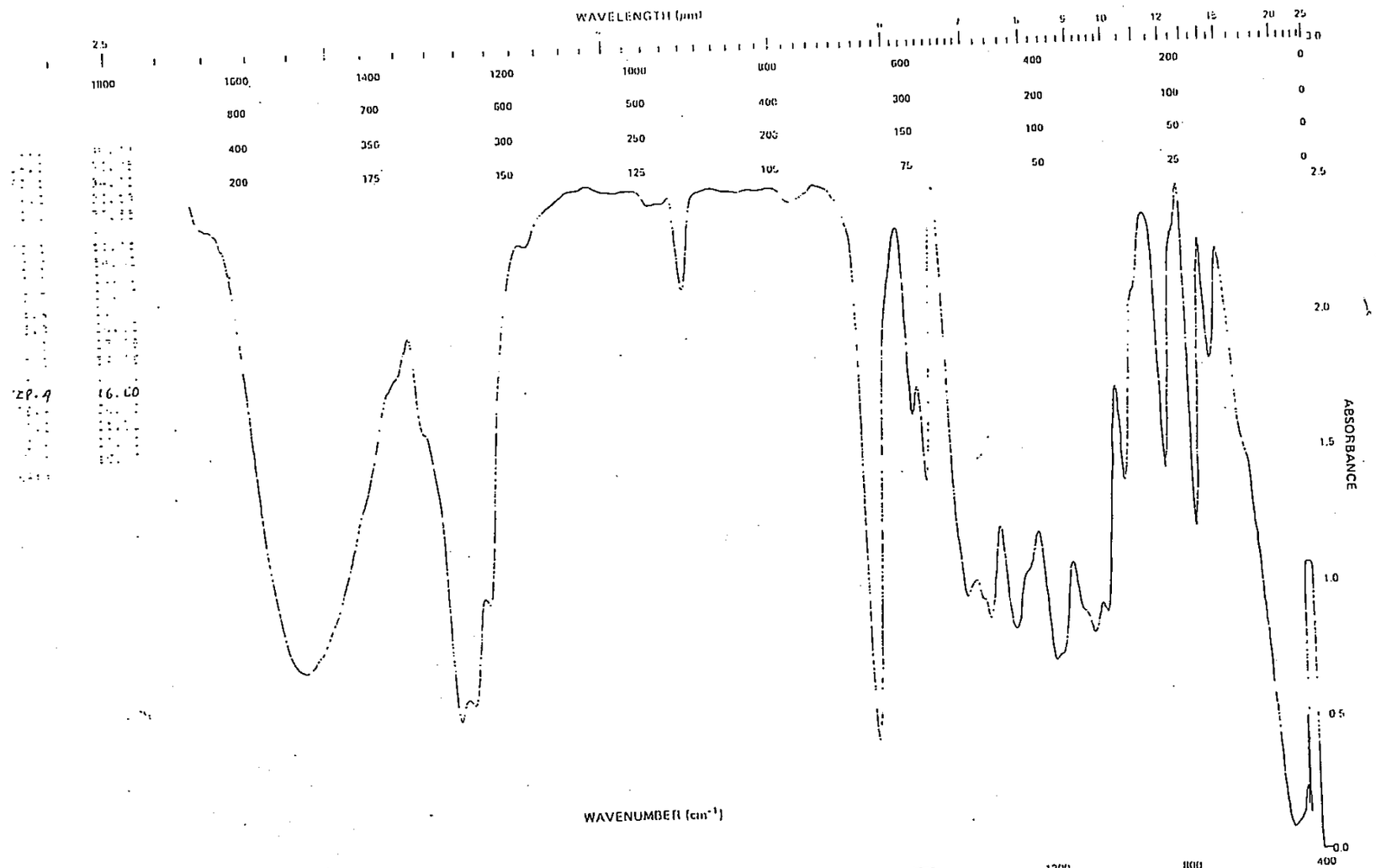
TLC ⇒ showed one main spt (1:1 ether-petrol).

Prep TLC ⇒ (1079-111-19) pale yellow oil = 25-6 mg

nmr 10 mg.

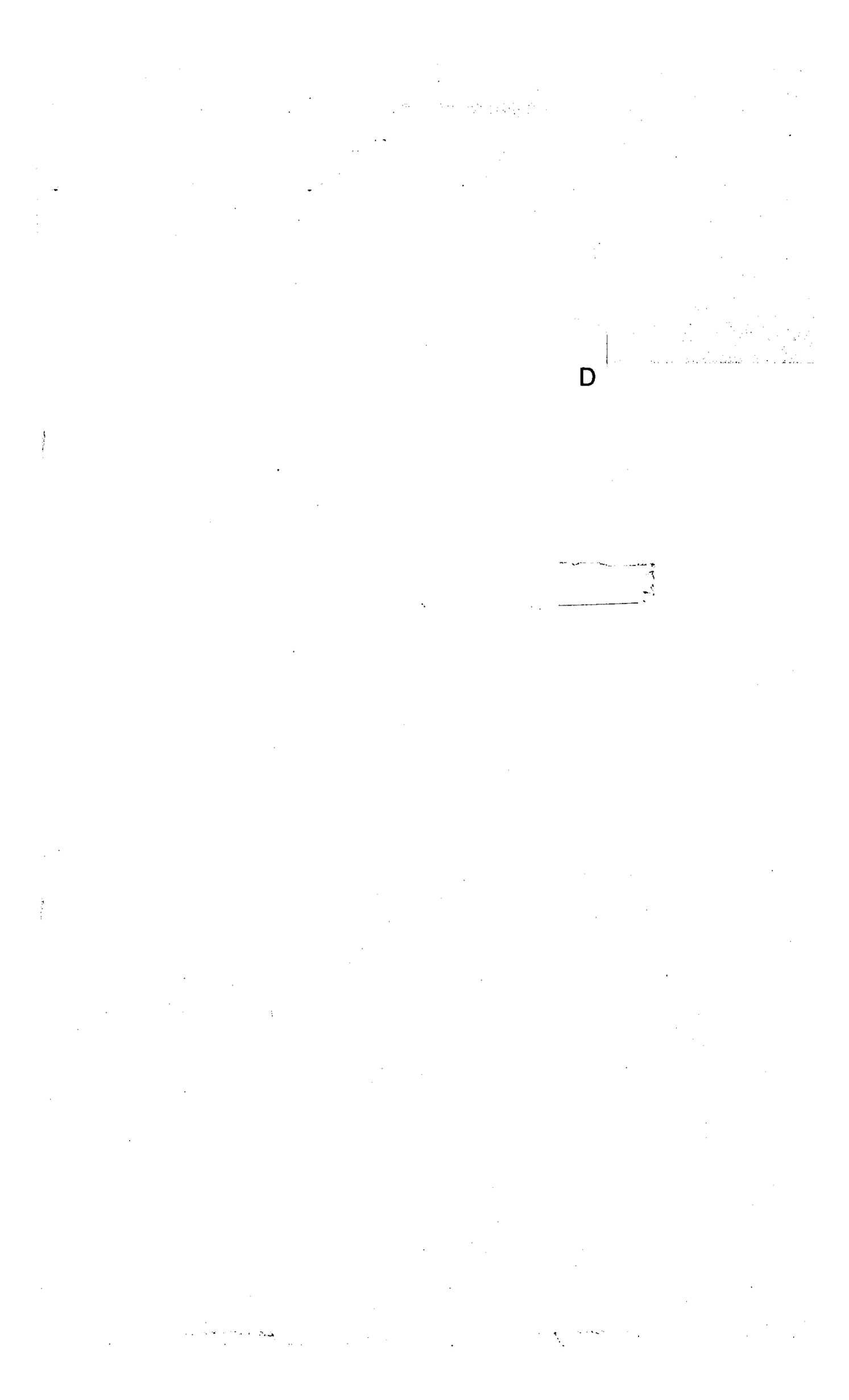
11/12/96. T. Scallen 14.5 mg.

SAMPLE NO. 679-111-19
SOLVENT C_6D_6
REFERENCE TMS
TEMP. 25 °C TUBE 5 mm
OBSERVE NUCLEUS ^1H
MENU NO. 1
IRMOD NON
IRR. POWER
PUMOD
NO. of ACCUM. 160
DATA POINTS 16K
SPECTRAL WIDTH 2KHz
DATE 21Nov84
OPERATOR KLG
FX 200
SPECTRUM NO. 7997-6

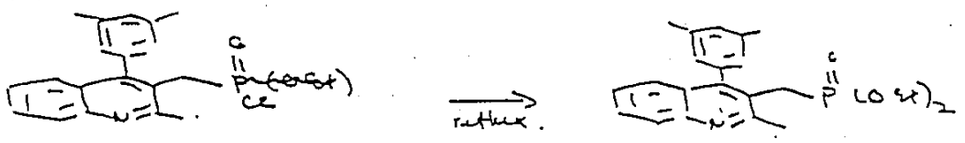


E 11-21-84	SAMPLE 1079-111-19	NOTES Put in Box B: 079-111-19	STORED ( ) INTERLEAVED ( ) BKG	TRANS. ( ) ABSORBANCE ( )
STRUM NO. 2584	E Xylene	Smooth 15	NO. SCAN PAIRS (SAM/BKG) 64/64	VERT ORIGIN 0 SPAN 120
RATOR JB	KNESS	BS/N	AUXILIARY DISPLAY	HOR. ORIGIN 4000 SPAN 4400

SANDOZ


D

cf. P. 1079-86.



397.458
$C_{23}H_{28}NO_3P$.

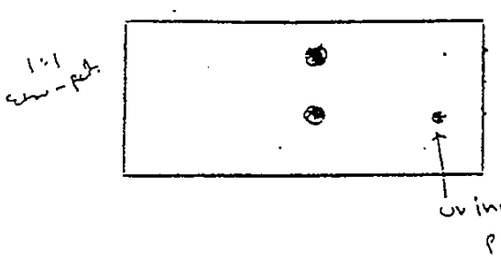
(245) 1079-296-35 = 150 mg
$P(OEt)_3$ = 0.3 ml.
Toluene = 2 ml.

9.10 am:

TLC 11.20 am: ⇒ SM.

0.5 ml of $P(OEt)_3$ was added

prolonged heating at 110° for 2nd ⇒ complete reaction



Concentration by distill^n + in vacuo. gave an oil which solidified on standing 160 mg ⇒ (127-[-23)
mp 101-102 (alkali washed solid)

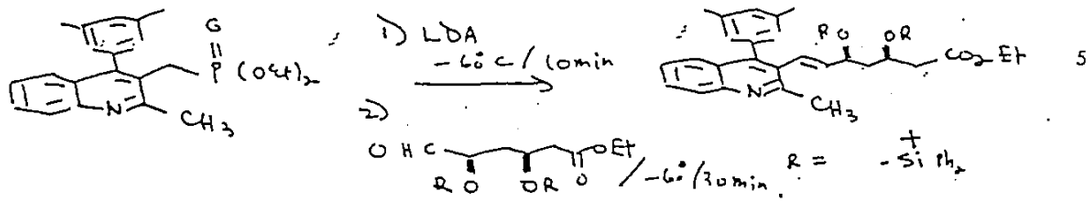
micro ✓ off

NMR ✓ : desired P.
MS M^+ 397 ✓

Performed by- S. Wallace

Witness- Stuart W. Mc

Cont'd From- | #116

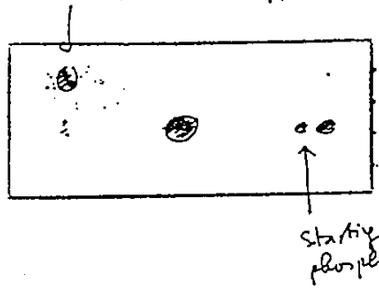


(397) 1127-5-23 = 150 mg (0.0003728 mol)
647 Pracad ald. = 293 mg (0.0004534 mol)
1.7 M LDA = 0.27 ml. 1.2 eq.
THF = 3 ml.

To a solution of 1127-5-23 in THF (3 ml) at -55°C was added LDA. The resulting dark orange soln was then stirred at -11° → -6° for 10/20 min.
9.50 am – 10.00 am.

Then a soln of aldehyde in THF (2 ml) was added
TLC after 20 min. ⇒ mainly one product

After 30 min, the reaction was quenched at -60C with 0.5 ml MeOH. Then dil. HCl and ether was added and extracted with Et2O. to give yellow oil = 500 mg (to 1127-9-



1:1 cyclohexane-petrol.

Prep TLC (1:1 cyclo-petrol) gave a yellow oil = 100 mg (to 1127-C

Nmr ✓

Performed by- S. Wattanasin

Witness- [redacted]

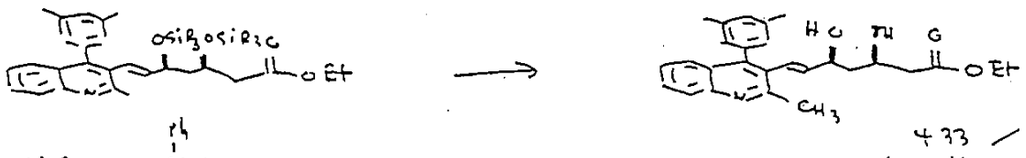
Date 5/7/85 Proj.

Title- Book # 112.

11

Cont'd From-

cf. 1079–97



433 /
$C_{27}H_{31}O_4N$

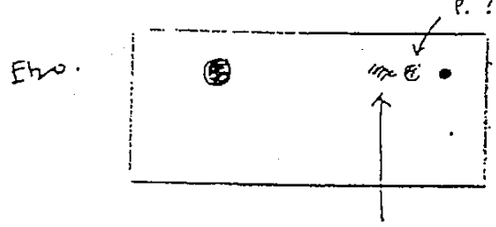
(1119) SiR_3 : $Si(Ph)_2$

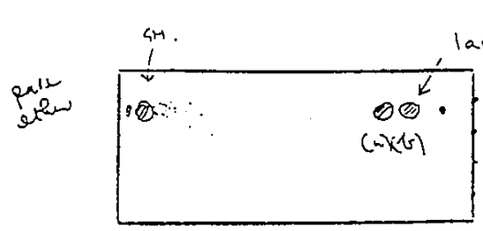
	1127-9-33	=	90 mg (0.0001012 mol)
1H	Bu$_4$NF	=	0.61 ml. (0.000607 mol) 10
6.04 ; 1.09	HOAc	=	0.03 ml. (0.0005 mol) 5
	THF	=	2 ml.

The mixt. was stirred at r.t.

9.00 am:
- Bu$_4$NF 0.6
- " " 0.6
- HOAc 0.05 ml

TLC 5/8/85 9.00 am.





TLC 5/13/85 : 8.30 am ⇒ a mixt of SM + P(S)
The solu was heated at 50°C
9.00 am:

TLC 11.00 pm : mixt. of 2 spots.
stop 5.30 pm

Concentrated & the crude was purified by prep TLC (ether : CH$_2$Cl$_2$)

(a) : colorless oil = 10 mg (1127-11-34)
nmr MS / M$^+$ 433 /

(b) : oil = 10 mg (1127-11-37)
nmr MS / M$^+$ 387 /
$C_{25}H_{34}O_3N$

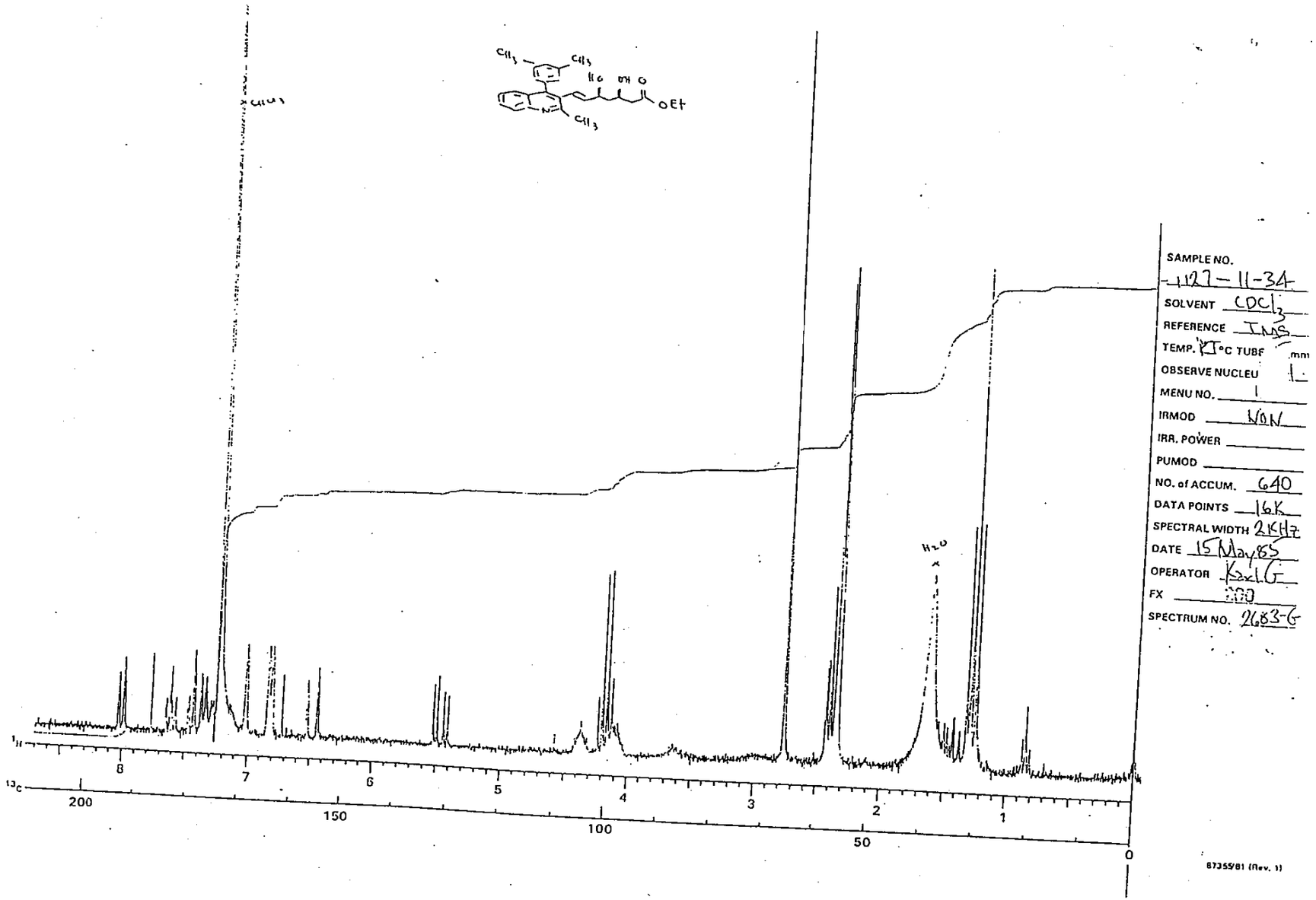
5/17/85. 1127-11-34 { 2 mg CSI
4 mg CSTU, CSTC

1127-11-37 { 2 mg CSI

Performed by- S. Wattanasin

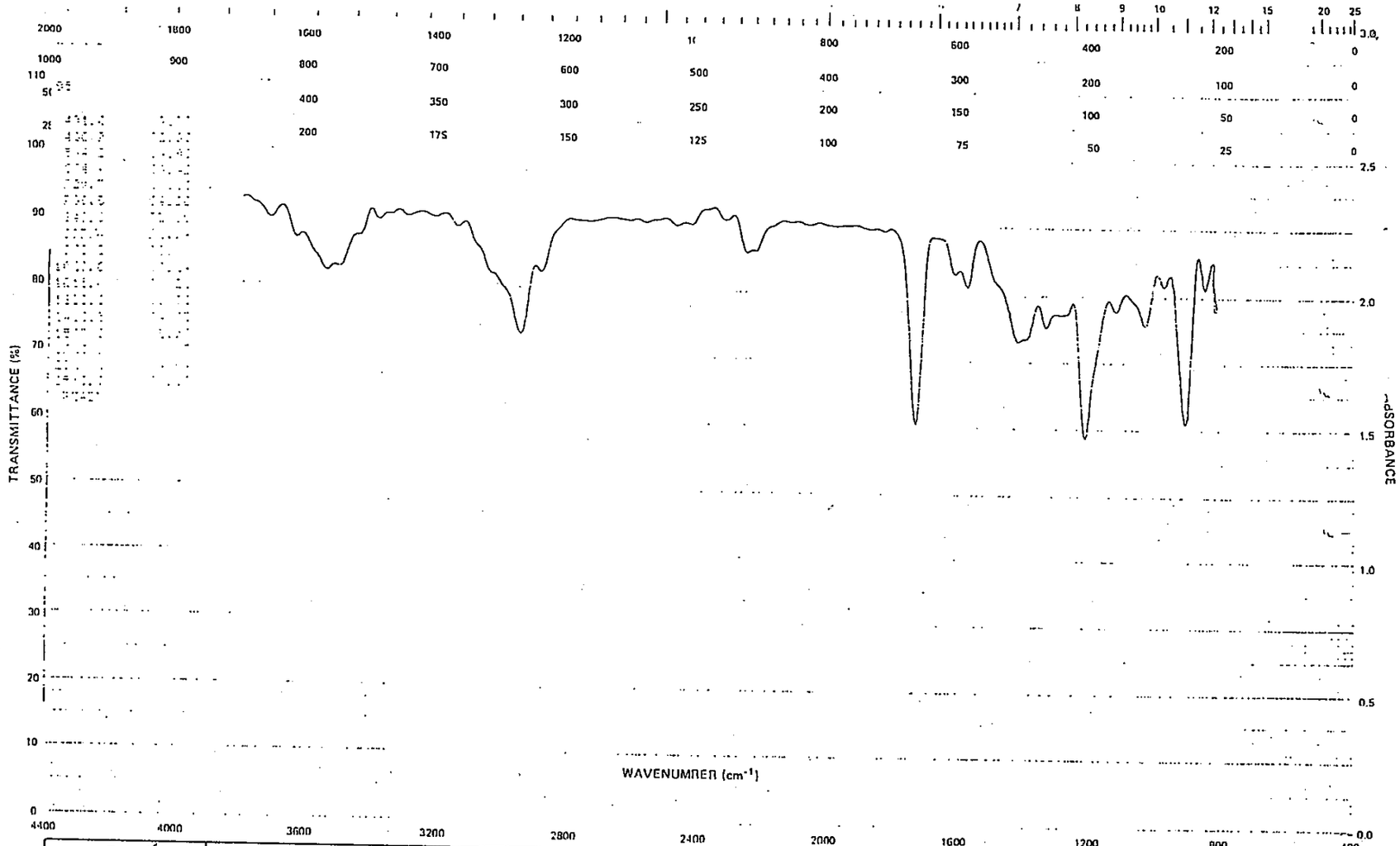
Witness-

Cont'd to-



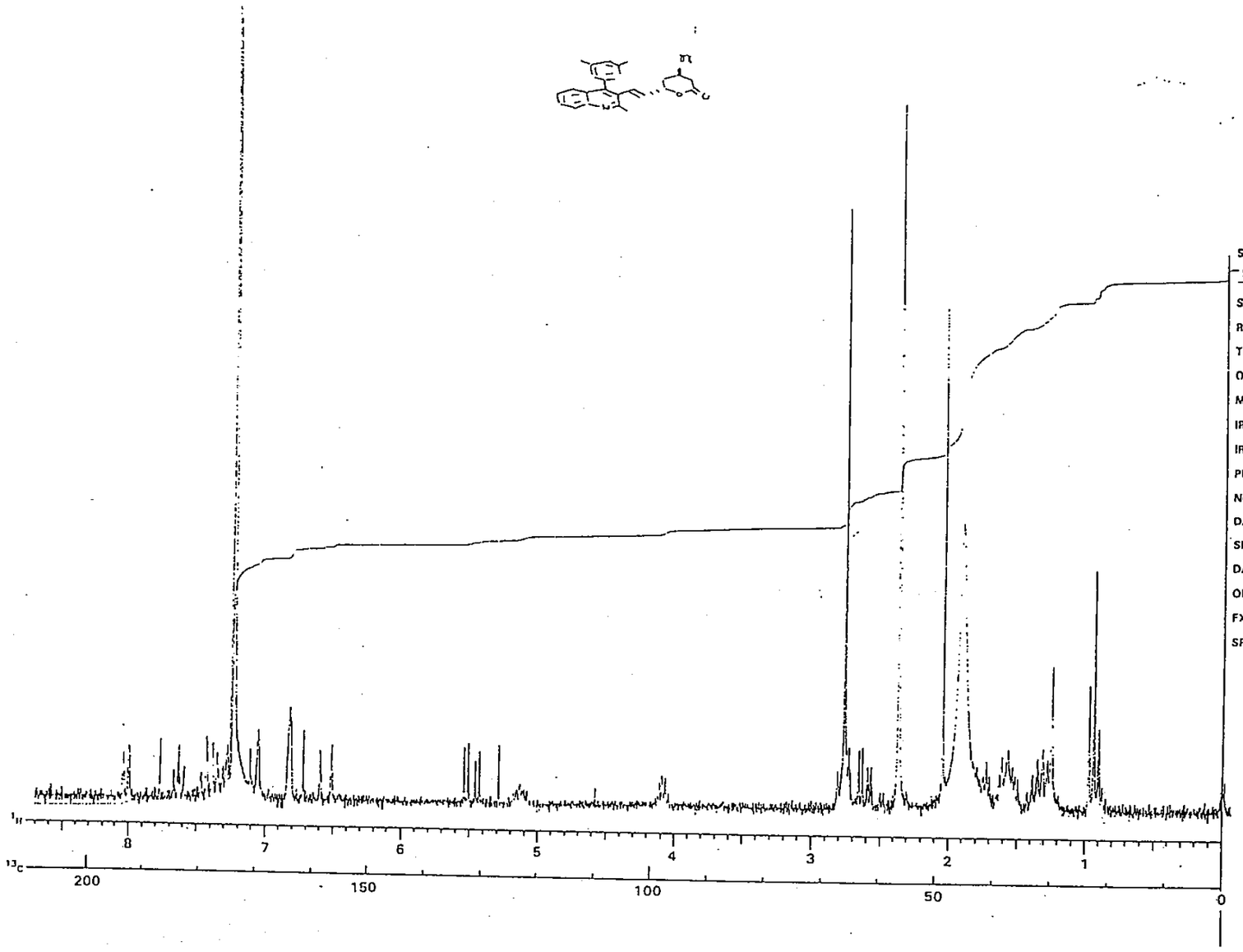
SAMPLE NO. -1127-11-34
SOLVENT $CDCl_3$
REFERENCE TMS
TEMP. RT °C TUBE mm
OBSERVE NUCLEU 1
MENU NO. 1
IRMOD NON
IRR. POWER
PUMOD
NO. of ACCUM. 640
DATA POINTS 16K
SPECTRAL WIDTH 2KHz
DATE 15 May 85
OPERATOR KaxLG
FX
SPECTRUM NO. 2683-G

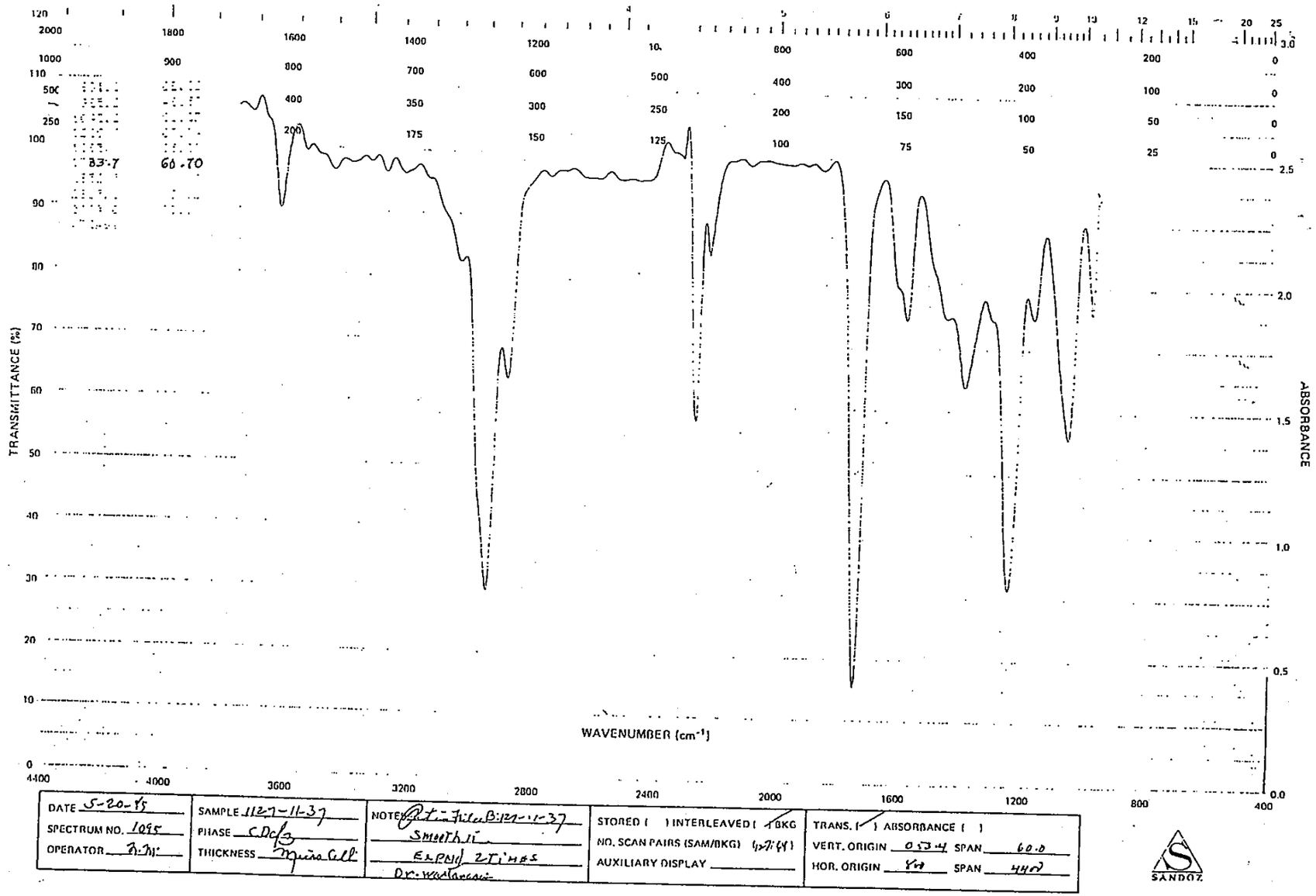
8735/81 (Rev. 1)

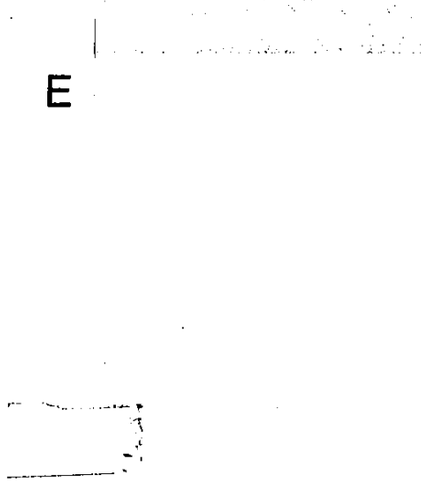


DATE 5-17-85	SAMPLE 1127-11-34	NOTE Ref: File B: 1127-11-34	STORED ( ) INTERLEAVED ( )	TRANS. ✓) ABSORBANCE ( )
SPECTRUM NO. 1094	PHASE CPCl3	Scal 1.8	NO. SCAN PAIRS (SAM/BKG) 27/27	VERT. ORIGIN 0 SPAN 1
OPERATOR B.M.	THICKNESS Micro Cell	Evaporated Sample down	AUXILIARY DISPLAY	HOR. ORIGIN 4n SPAN 44m

SANDOZ


SAMPLE NO. 1127-11-37
SOLVENT 1:1 CDCl3
REFERENCE TMS
TEMP. RT °C TUBE 5 mm
OBSERVE NUCLEUS
MENU NO. 1
IRMOD NON
IRR. POWER
PUMOD
NO. of ACCUM. 296
DATA POINTS 16K
SPECTRAL WIDTH 2KHz
DATE 15 May 85
OPERATOR LGL
FX 300
SPECTRUM NO. 2686-G
8735/81 (Rev. 1)
1H
13C
8
7
6
5
4
3
2
1
200
150
100
50
0


TRANSMITTANCE (%)
ABSORBANCE
WAVENUMBER (cm⁻¹)
83.7
60.70
DATE 5-20-85
SPECTRUM NO. 1095
OPERATOR A.M.
SAMPLE 1127-11-37
PHASE CDCl3
THICKNESS Micro Cell
NOTE Stn File B:127-11-37
Smooth 11
EXPND 2 TIMES
Dr. Wuthrich
STORED ( ) INTERLEAVED ( ) BKG
NO. SCAN PAIRS (SAM/BKG) 4/4
AUXILIARY DISPLAY
TRANS. ( ) ABSORBANCE ( )
VERT. ORIGIN 0534 SPAN 60.0
HOR. ORIGIN 44 SPAN 4402
SANDOZ


E

DRUG INHIBITION STUDY FOR SANDOZ CONTRACT

Sandoz unknowns were dissolved in DMA (Dimethylacetamide from Sigma), and Buffer A and DMSO: 0.1 M NaOH. Dilution of each compound gave the concentrations indicated in the results.

Microsomes were prepared from male Sprague-Dawley rats (180g) in Buffer A with 10 mM DTT and frozen at -80°C until thawed and used for experiment. 200 µl Aliquots of microsomal suspension (1.12-1.30 mg/ml) plus 10 µl of drug dilution were assayed for HMG-CoA reductase activity.

Compactin in DMA at various concentrations was assayed for inhibition also and is indicated in the results. Buffer A, and DMA , DMSO:0.1M NaOH were also assayed by adding 10 µl of each to 200 µl of microsomal suspension and they showed no significant inhibition of HMG-CoA reductase.

NOTE: That compound marked (SAP) was saponified in a 50° waterbath for 2 hr.

COMPOUND	DATE	SOLVENT	RESULTS S.A.	% OF CONTROL		% OF INHIBITION
21) 63-366 (25496)	12/13/84	DMA				
10^{-2}			.21	22		78
10^{-3}			.57	61		39
10^{-4}			.81	86	1.58	14
10^{-5}			.80	94		6
10^{-6}			.90	96		4
10^{-7}			.88	94		6
10^{-8}			.87	92		8
22) 63-369 (25512)	12/12/84	DMA				
10^{-2}						
10^{-3}						
10^{-4}						
10^{-5}						
10^{-6}						
10^{-7}						
10^{-8}						
23) 63-162/3						
10^{-2}						
10^{-3}						
10^{-4}						
10^{-5}						
10^{-6}						
10^{-7}						
10^{-8}						
24) 63-270/2						
10^{-2}						
10^{-3}						
10^{-4}						
10^{-5}						
10^{-6}						
10^{-7}						
10^{-8}						


F

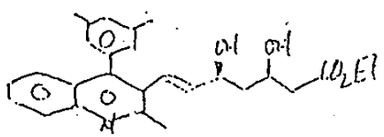
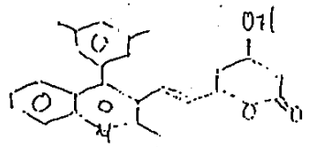
June 27, 1985

DRUG INHIBITION STUDY FOR SANDOZ CONTRACT

Sandoz unknowns were dissolved in DMA (Dimethylacetamide from Sigma), and Buffer A and DMSO: 0.1 M NaOH. Dilution of each compound gave the concentrations indicated in the results.

Microsomes were prepared from male Sprague-Dawley rats (163 g) in Buffer A with 10 mM DTT and frozen at -80°C until thawed and used for experiment. 200 µl Aliquots of microsomal suspension (.97 - 1.11 mg/ml) plus 10 µl of drug dilution were assayed for HMG-CoA reductase activity.

Compactin in DMA at various concentrations was assayed for inhibition also and is indicated in the results. Buffer A, and DMA were also assayed by adding 10 µl of each to 200 µl of microsomal suspension and they showed no significant inhibition of HMG-CoA reductase.

COMPOUND			% OF CONTROL		% OF INHIBITION	REMAI
5) 63-547(RN						
10^{-2}			-		100	
10^{-3}			8	0.017	92	
10^{-4}			28		72	
10^{-5}			48		52	
10^{-6}			88		12	
10^{-7}			100		-	
10^{-8}			100		-	
6) 63-548(RN 26080)	6/13/85	DMA				
10^{-2}		.13	28		72	
10^{-3}		.37	80		20	
10^{-4}		.47	100	3.775	-	
10^{-5}		.47	100		-	
10^{-6}		.45	96		4	
10^{-7}		.47	100		-	
10^{-8}		.45	96		4	
7) 63-549(RN 26082)	6/13/85	DMA				
10^{-2}		.21	44		56	
10^{-3}		.41	88		12	
10^{-4}		.47	100	7.31	-	
10^{-5}		.47	100		-	
10^{-6}		.47	100		-	
10^{-7}		.45	96		4	
10^{-8}		.47	100		-	
8) 63-550(RN						
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x2582A

Case No. 600-7101/CONT/Int.(1)
Patent

#4

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

WATTANASIN
v.
FUJIKAWA et al.
v.
FUJIKAWA et al.

Interference No. 102,975
Examiner-in-Chief: M. Sofocleous

ADDENDUM TO
WATTANASIN PRELIMINARY STATEMENT

A Preliminary Statement is being filed and served in the above interference.

For purposes of this interference, it shall be understood as follows:

(1) Count "1" wherever it appears in the Wattanasin Preliminary Statement refers to count 1 of the present Interference No. 102,975; and

(2) Count "2" wherever it appears in the Wattanasin Preliminary Statement refers to count 3 of related Interference No. 102,648.

Respectfully submitted,

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

DEF:rmf
August 27, 1992

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on August 27, 1992
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Signature
8/27/92
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

ADDENDUM TO
WATTANASIN PRELIMINARY STATEMENT

was served on counsel for the party Fujikawa et al., this 27th day of August 1992, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

Paper No. 5

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Telephone: (703)557-4007
Facsimile: (703)557-8642

Interference No. 102,975

Wattanasin et al.

v.

Fujikawa et al.

It is now appropriate to set times for taking testimony. In setting the times for taking testimony below, the EIC has only set Fujikawa et al. rebuttal testimony. The testimony times are set as follows:

Testimony-in-chief of the junior party Wattanasin for deposition testimony, including cross-examination of witnesses, to open October 1, 1992 and to close December 15, 1992.

Testimony-in-chief of the junior party Wattanasin for affidavit testimony (affidavits pursuant to 37 CFR 1.671(e) and 1.672(b) must be filed) to close November 15, 1992.

Cross-examination of any junior party's affiants to close December 15, 1992.

Rebuttal testimony of the senior party Fujikawa et al. for deposition testimony, including cross-examination of witnesses, to open January 5, 1993 and to close February 25, 1993.

Testimony of the senior party Fujikawa et al. for affidavit testimony (affidavits pursuant to 37 CFR 1.671(e) and 1.672(b) must be filed) to close January 30, 1993.

Cross-examination of any senior party's affiants to close February 25, 1993.

For filing and serving the record to close March 25, 1993.

The brief times are set as follows:

Junior party's brief due April 25, 1993.

Senior party's brief due May 25, 1993.

Junior party's reply brief due June 15, 1993.

Additional Discovery

Most interferences do not require motions for additional discovery (37 CFR 1.687(c)). Therefore, no period for filing such motions has been set. If additional discovery is deemed necessary, the parties should attempt to resolve the matter by agreement under 37 CFR 1.687(d) before filing a motion for additional discovery. If either party deems such a motion to be necessary, the party should contact the examiner-in-chief (EIC) via a conference call, including opposing counsel, within 20 days after the date of this order.

Other Evidence

If either party intends to rely on an affidavit filed by him during ex parte prosecution, an affidavit under 37 CFR 1.608 or an affidavit under 37 CFR 1.639(c), he must comply with the provisions of 37 CFR 1.671(e) by the close of his testimony-in-chief for affidavit testimony. If either party intends to present the testimony of a witness by affidavit, the affidavit must be filed by the close of his testimony-in-chief for affidavit testimony.

Any motion under 37 CFR 1.671(g), 1.683(a) and 1.684(a) must be filed sufficiently far in advance of the end of the testimony period that the motion (including any opposition) can be acted upon, and any resultant testimony taken or filed, prior to the end of the testimony period. Compliance with the provisions of 37 CFR 1.673(a), (b) and (g) must be completed within a reasonable time from the opening of the testimony period so as to ensure that testimony will be taken within the time set.

Cross-Examination

If either party wishes to cross-examine any of his opponent's affiants, the party should file a pro forma request therefor (37 CFR 1.672(b)) and proceed during the time set. After such request, it becomes the responsibility of the opponent to notice the depositions of his affiants during the period set for cross-examination, arrange for the court reporter and file the certified transcript of the deposition (37 CFR 1.673(e and 1.672(b)). Failure to notice the depositions during the period set may result, upon a motion from the party, in according the affidavit testimony no weight at final hearing (37 CFR 1.616).

Record and Testimony

A certified transcript of a deposition must be filed by the time set in 37 CFR 1.678.

Interference No. 102,975

Suggestion for Negotiations

The parties are strongly encouraged to make contact with each other, prior to the start of Simon et al.'s testimony period, and attempt to settle this interference or, failing that, to narrow down, as much as possible, the issues for final hearing. The EIC can be expected to cooperate in allowing reasonable time for a bona fide attempt at such negotiations.

Michael Sofocleous
Examiner-in-Chief
(703) 557-4066

gjh

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Papers # 6 to # 8

SANDOZ CORPORATION
59 ROUTE 10, EAST HANOVER NJ 07936

SANDOZ

#9

PATENT AND TRADEMARK DEPARTMENT
TELEX 240867
TELEFAX 201 503 8807

October 29, 1992

BY PRIORITY MAIL

Steven B. Kelber, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1755 Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Re: Interference Nos. 102,648, [redacted]:
WATTANASIN Declarations and
Exhibits Pursuant to 37 CFR 1.608

Dear Steve:

Per our phone conversation yesterday, enclosed please find a true copy of the above papers from the file of Wattanasin Application Serial No. 07/498,301, which were mailed to the PTO on May 25, 1990.

Very truly yours,

Diane Furman

Diane E. Furman

DEF:rf

cc: M. Sofocleous, EIC
w/o Encs.

TABLE OF CONTENTS

DECLARATIONS AND EXHIBITS SUBMITTED PURSUANT TO 37 C.F.R. 1.608 IN WATTANASIN PATENT APPLICATION SERIAL NO. 07/498,301

EXHIBITS: (CONT.)

EXHIBIT E-1
E-2
E-3
E-4
E-5

EXHIBIT F-1

EXHIBIT G-1
G-2

EXHIBIT H-1

EXHIBIT I-1

EXHIBIT J-1

Case No. 600-7101/CONT/Int. (11)
Patent

#10

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

WATTANASIN
v.
FUJIKAWA et al.

Interference No. 102,648
Examiner-in-Chief: M. Sofocleous

WATTANASIN
v.
FUJIKAWA et al.

Interference No. 102,975
Examiner-in-Chief: M. Sofocleous

v.
FUJIKAWA et al.

FYI

NOV 19 1992

RECEIVED IN
BOX INTERFERENCE

WATTANASIN MOTION TO CONSOLIDATE RECORD

Wattanasin hereby moves to consolidate the record for the above-numbered interferences, the counts of which are directed to essentially the same subject matter.

The undersigned counsel for Wattanasin has conferred with counsel for Fujikawa et al., who take no exception to the present motion to consolidate (however, without forfeiting the right to oppose in the event of unspecified changed circumstances in the future).

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on Nov. 16, 1992
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
11/16/92
Date of Signature

Respectfully submitted,

Diane Furman
Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

DEF:rmf
November 16, 1992

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN MOTION TO CONSOLIDATE RECORD

was served on counsel for the party Fujikawa et al., this 16th day of November, 1992, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman
Diane E. Furman

Case No. 600-7..1/CONT/Int (3)
Patent

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

WATTANASIN
v.
FUJIKAWA et al.

Interference No. 102,648
Examiner-in-Chief: M. Sofocleous

WATTANASIN
v.
FUJIKAWA et al.
v.
FUJIKAWA et al.

Interference No. 102,975
Examiner-in-Chief: M. Sofocleous

FYI

NOV 19 1992

RECEIVED IN
COX INTERFERENCE

WATTANASIN MOTION FOR EXTENSION OF TIME UNDER 37 CFR §1.635

It is respectfully requested that the party Wattanasin be permitted an extension of time of ten (10) days, from November 15, 1992[1], i.e. until November 25, 1992, to file and serve: (1) an executed copy of the Declaration of Lawrence B. Perez pursuant to 37 CFR 1.672; and (2) an original of the executed copy of the Declaration of Rajeshvari Patel pursuant to 37 CFR §1.672.

With regard to the Perez declaration, it was discovered today by the undersigned that the original and copies of Dr. Perez's signed declaration have regrettably been misplaced. It has also been learned that Dr. Perez, who is a Sandoz employee, is on vacation and is therefore unavailable to sign from Friday, November 13 to at least Wednesday, November 18, 1992, inclusive.

---

1. The Wattanasin deadline for filing and serving testimony in the above interferences.

An unexecuted copy of the Perez declaration is today being filed and served in the above interferences.

With respect to the declaration of Rajeshvari Patel, who is no longer employed by Sandoz: inadvertently, only a facsimile copy of the execution page of the signed declaration is currently available, perhaps owing to miscommunication between the declarant and undersigned counsel, who expected to receive the original by mail today. The facsimile copy of the Patel declaration is today being filed and served in the above interferences.

Counsel for Fujikawa et al. have been apprised of the above, and have indicated to the undersigned that they will not oppose the introduction of the Patel declaration; but they are reserving the right to oppose introduction of the Perez declaration.

Acccordingly, it is respectfully requested that Wattanasin be permitted to file a signed copy of the Perez declaration, and an original of the signed copy of the Patel declaration, on or before November 25, 1992.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORP.
59 Route 10
E. Hanover, NJ 07936
DEF:rmf
November 16, 1992

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on Nov. 16, 1992
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
11/16/92
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN MOTION FOR EXTENSION OF TIME

was served on counsel for the party Fujikawa et al., this 16th day of November, 1992, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman
Diane E. Furman

#12

49-111-0

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,648
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

APPROVED
DEC 21 1992
By ..... Examiner-in-Chief

RECEIVED
DEC 10 1992
BOARD OF PATENT APPEALS AND INTERFERENCES

REQUEST FOR EXTENSION OF TIME

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

ATTENTION: EXAMINER-IN-CHIEF: URYNOWICZ
BOX INTERFERENCE

SIR:

Pursuant to the provision of Rules 635 and 645, Fujikawa hereby requests an extension of time in which to take cross-examination of Declarants in the above-captioned patent Interferences. The Junior Party has presented testimony with respect to priority in the above-captioned Interferences. The time for cross-examination expires December 15, 1992, and the parties have been unable to schedule a time convenient to complete cross-examination. The parties are in agreement that the cross-examination may run concurrently with the rebuttal testimony of the Senior Party, as well as the Senior Party's period for affidavit testimony, set to close February 25, 1993. Further, the parties

have agreed on a tentative date for cross-examination to begin of January 12, 1993. Accordingly, this extension of time is sought on good cause, will not require the rescheduling of any of the dates set in Paper No. 59 in Interference 102,648, or Paper No. 5 in Interference 102,975, and will facilitate timely completion of testimony.

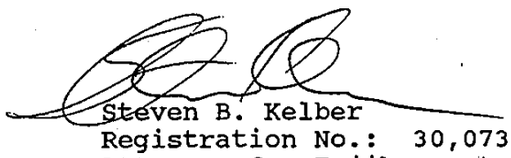
Counsel for Junior Party Wattanasin has discussed this Motion with undersigned Counsel, and the parties join in requesting this extension of time.

In the absence of EIC Sofocleous, the above proposal was discussed with EIC Urynowicz. The EIC indicated that on the above-stated grounds, this Motion would be granted. The assistance and cooperation of the EIC Urynowicz is deeply appreciated.

Accordingly, grant of this Motion, extending the time to take cross-examination testimony of the Junior Party's Affiants to February 25, 1993 is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **REQUEST FOR EXTENSION OF TIME**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 10th day of December, 1992.

STEVEN B. KELBER

#13

Docket Number: 49-[illegible]

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

WATTANASIN	:	INTERFERENCE NUMBER: 102,648
		and
	:	INTERFERENCE NUMBER: 102,975
V.		
	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

FUJIKAWA ET AL REQUEST FOR CROSS-EXAMINATION OF DECLARANT WATTANASIN

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

Sir:

Pursuant to the Decision of the EIC (Paper Number 59 in the '648 Interference, Paper Number 5 in the '975 Interference) counsel for Fujikawa et al hereby files its *pro forma* Request for Cross-Examination of Declarant Wattanasin, submitted pursuant to the provisions of Rule 672.

Undersigned counsel has already talked to counsel for the Junior Party, and has agreed that the deposition may be conducted at headquarters of the assignee in interest, East Hanover, New Jersey.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon
Attorney of Record
Registration Number 24,618

Steven B. Kelber
Attorney of Record
Registration Number 30,073

Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202
(703) 521-5940

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA REQUEST FOR CROSS-EXAMINATION OF DECLARANT WATTANASIN**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 7th day of December, 1992.

STEVEN B. KELBER

49-125-0 DIV

#14

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

WATTANASIN	:	
	:	**INTERFERENCE NO.: 102,975**
V.		
	:	**EXAMINER-IN-CHIEF:**
FUJIKAWA ET AL	:	**MICHAEL SOFOCLEOUS**

FUJIKAWA NOTICE OF INTENT
TO ARGUE ABANDONMENT, SUPPRESSION OR CONCEALMENT -
37 CFR §1.632

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

SIR:

Pursuant to the provisions of the above Rule, Fujikawa hereby serves notice it intends to argue that Wattanasin, Junior Party, has abandoned, suppressed or concealed whatever actual reduction to practice of the Count of the above Interference is made out by the priority evidence submitted by Wattanasin.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

Fourth Floor
1755 South Jefferson Davis Highway
Arlington, Virginia 22202
703-521-5940

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA NOTICE OF INTENT TO ARGUE ABANDONMENT, SUPPRESSION OR CONCEALMENT - 37 CFR §1.632**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 15th day of December, 1992.

STEVEN B. KELBER

Case No. 600-7101/CONT/Int.
Patent

#15

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

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,975

Examiner-in-Chief: M. Sofocleous

NOTICE OF DEPOSITION PURSUANT TO 37 CFR §§1.672(b), 1.673(e)

The party Wattanasin hereby serves notice that the party Fujikawa shall take cross-examination by oral deposition of the following affiant for the party Wattanasin on the date and at the place below-indicated:

Affiant:	Sompong Wattanasin, Ph.D.
Date:	Tuesday, January 12, 1993
Location:	Sandoz Pharmaceuticals Corporation Patent and Trademark Department 25 Hanover Road Building b Florham Park, NJ 07936

Undersigned counsel for Wattanasin certifies that the above represents the mutual agreement of the parties reached in oral conference.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
East Hanover, NJ 07936

DEF:rmf

December 11, 1992

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on December 11, 1992
(Date of Deposit)

Diane E. Furman
Name of applicant, assignee, or Registered Representative

Diane Furman
Signature

December 11, 1992
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

NOTICE OF DEPOSITION PURSUANT TO 37 CFR §§1.672(b), 1.673(e)

was served on counsel for the party Fujikawa et al., this 11th day of December, 1992, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman 12/11/92
Diane E. Furman

#16

49-111-0

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

WATTANASIN : MAILED

V. : INTERFERENCE NO.: 102,648
102,975

DEC 24 1992

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

FUJIKAWA ET AL : EXAMINER-IN-CHIEF: APPROVED

: MICHAEL SOFOCLEOUS

DEC 21 1992

REQUEST FOR EXTENSION OF TIME By .....
Examiner-in-Chief

RECEIVED

DEC 10 1992

BOARD OF PATENT APPEALS
AND INTERFERENCES

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

ATTENTION: EXAMINER-IN-CHIEF: URYNOWICZ
BOX INTERFERENCE

SIR:

Pursuant to the provision of Rules 635 and 645, Fujikawa hereby requests an extension of time in which to take cross-examination of Declarants in the above-captioned patent Interferences. The Junior Party has presented testimony with respect to priority in the above-captioned Interferences. The time for cross-examination expires December 15, 1992, and the parties have been unable to schedule a time convenient to complete cross-examination. The parties are in agreement that the cross-examination may run concurrently with the rebuttal testimony of the Senior Party, as well as the Senior Party's period for affidavit testimony, set to close February 25, 1993. Further, the parties

Case No. 600-7101/CONT/INT.
Patent

#17

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

WATTANASIN
v.
FUJIKAWA et al.

Interference Nos. 102,648, [redacted]
Examiner-in-Chief: M. Sofocleous

FYI

JAN 6 1993

RECEIVED IN BOX INTERFERENCE

WATTANASIN MOTION FOR LEAVE TO PRESENT ADDITIONAL TESTIMONY
37 CFR §1.635, §1.651(c)(4)

In response to the Fujikawa "Notice of Intent to Argue Abandonment, Suppression or Concealment - 37 CFR §1.632" dated December 15, 1992, in the above-captioned interferences, the party Wattanasin hereby requests leave to present additional testimony in connection with the allegations set forth in said notices.

Specifically, Wattanasin respectfully moves for designation of a testimony period for Wattanasin to present evidence by deposition or affidavit going to the absence of abandonment, suppression or concealment of the Wattanasin invention. In particular, the period of January 4, 1993 to February 1, 1993 is suggested.

REMARKS

The status of the above-captioned interferences is as follows:

Testimony-in-chief of the party Wattanasin, originally set to close December 15, 1992, has been extended for purposes of cross-examination to February 25, 1993 (See Paper No. 71, Int. No. 102,648; Paper No. 16, Int. No. 102,975).

Therefore, by prior agreement of the parties and with the approval of the EIC, the period for the Wattanasin testimony-in-chief is already set to run concurrently with the Fujikawa et al. rebuttal and affidavit testimony period, i.e. to February 25, 1993.

The party Wattanasin has presented its testimony with respect to the issue of priority during the Wattanasin affidavit testimony period, which closed November 15, 1992.

The EIC will note that Wattanasin, as junior party, has adduced for the record, for priority purposes, documentation of activities relating to an actual reduction to practice of the Wattanasin invention from prior to the Fujikawa priority date of August 20, 1987 up to a date of about December 9, 1987, which is approximately 15 months prior to the filing of the Wattanasin Rule 60 parent application on March 3, 1989. (See Record, pp. 110; 340).

Fujikawa et al. in their Rule 632 notices have now raised for the first time in these interferences an allegation of abandonment, suppression or concealment of the Wattanasin invention.

As a first matter, these Fujikawa notifications are wholly devoid of specificity or particularity as to the basis for the allegation of abandonment, suppression or concealment.

Therefore, Wattanasin requests, first of all, that the party Fujikawa indicate with specificity the basis for its allegation of abandonment, suppression or concealment.

Secondly, Wattanasin respectfully requests an opportunity to defend against the allegation of abandonment, supression or concealment of the Wattanasin invention by taking additional testimony in connection therewith. (Preferably, the substantive basis for said allegation will be sufficiently defined by Fujikawa et al. on a timely basis to permit Wattanasin to present testimony responsive thereto.)

Under the circumstances, it is believed consistent with the purpose of 37 CFR §1.632 -- that is, to foster full and fair adjudication of the issue of abandonment, suppression or concealment (see MPEP 2332)-- to afford Wattanasin an opportunity at this time to present such additional evidence.

Furthermore, given the fact that the period of the Wattanasin testimony-in-chief has already been extended to February 25, 1993 for purposes of cross-examination, it is not believed that designation of an additional Wattanasin testimony period to run from January 4, 1993 to February 1, 1993 would require rescheduling of either the above date of February 25, 1993, or of any of the other dates set forth in Paper No. 59 in Interference No. 102,648 or Paper No. 5 in Interference No. 102,975.

Therefore, in the interest of justice in permitting Wattanasin to adequately respond to the charge of abandonment, etc. now being raised for the first time by Fujikawa et al., and without foreseeably affecting the testimony periods already set and agreed to by the parties, it is respectfully requested that the EIC designate a period for Wattanasin testimony on the issue of abandonment, suppression or concealment of the Wattanasin invention.

Undersigned counsel for Wattanasin has today conferred with Mr. Steven Kelber, counsel for Fujikawa et al., who has indicated that the party Fujikawa will oppose this motion. However, there is agreement by counsel for the parties that the cross-examination of Dr. Sompong Wattanasin, now set for January 12, 1993, may be rescheduled for another time in the Wattanasin testimony period depending on the disposition of this motion.

Accordingly, grant of this motion to set a period for additional Wattanasin testimony on the issue of abandonment, suppression or concealment of the Wattanasin invention, preferably to run from January 4, 1993 to February 1, 1993, is respectfully requested.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
East Hanover, NJ 07936
DEF:rmf
December 31, 1992

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on December 31, 1992
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
Dec. 31, 1992
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN MOTION FOR LEAVE TO PRESENT ADDITIONAL TESTIMONY
37 CFR §1.635, §1.651(c)(4)

was served on counsel for the party Fujikawa et al., this 31st day of December 1992, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

49-111-0

#18

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

WATTANASIN	:	
V.	:	INTERFERENCE NO.: 102,648 INTERFERENCE NO.: 102,975
	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

FUJIKAWA ET AL OPPOSITION TO WATTANASIN'S MOTION FOR LEAVE TO PRESENT ADDITIONAL TESTIMONY

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

BOX INTERFERENCE

SIR:

Fujikawa opposes Wattanasin's Motion for a new testimony period, in which to present additional testimony, apparently related to the issues of abandonment, suppression or concealment. It is respectfully submitted that the Wattanasin Motion, presented pursuant to the provisions of 37 CFR §1.651(c)(4) is procedurally inadequate, and substantively in error. Accordingly, the Motion must be dismissed, or in the alternative, denied. Each of these

arguments is developed, sequentially, below.

I. FACTS

In Paper No. 59 (Interference 102,648) and Paper No. 5 (Interference 102,975), both mailed September 22, 1992, Junior Party Wattanasin was given a two and one-half month testimony period for its case-in-chief. That period closed December 15, 1992.

Prior to December 15, 1992, Wattanasin presented its testimony in the form of Declarations, as to which Fujikawa requested the opportunity for cross-examination. The parties have agreed to extend the period for cross-examination. The parties have not agreed to extend Wattanasin's period for testimony-in-chief.

On December 15, 1992, in accordance with the provisions of 37 CFR §1.632, Fujikawa filed Notice of its Intention to Argue Abandonment, Suppression or Concealment at final hearing, based on the testimony-in-chief presented by the Junior Party. Wattanasin does not complain that the Notice is in any way in error, or procedurally improper.

Apparently, on December 31, 1992, Wattanasin filed a Motion for Leave to Present Additional Testimony. That Motion is alleged

to be responsive to the Notice of Intention to Argue Abandonment, Suppression or Concealment filed December 15, 1992. The Motion was not received by undersigned Counsel until January 7, 1993, in response to a call made by undersigned Counsel to Counsel for Wattanasin, inquiring as to the status of the Motion proposed in an earlier teleconference.

II. ARGUMENT

A. The Wattanasin Motion is Procedurally Inadequate

Wattanasin's Motion is respectfully submitted to fail to meet the standards of the Rules. Specifically, although Wattanasin requests an additional testimony period, Wattanasin fails to describe the evidence it desires to present during that additional testimony period, save to describe it as "going to the absence of abandonment, suppression or concealment of the Wattanasin invention." See the Motion, page 1. Wattanasin does not indicate what type of testimony it will present, nor the particulars of that testimony. Fujikawa respectfully submits that not only is identification of the specific testimony sought to be presented by Wattanasin a prerequisite to the relief sought, but support for the ability of Wattanasin to present such testimony, confirmed by

appropriate Declaration, would be desirable.

It is well established that all Interference Motions, including those presented pursuant to 37 CFR §1.635, must set forth both a statement of the material facts in support of the Motion, and a full statement of the reasons why the relief requested should be granted. Specificity and particularity is important in proceeding pursuant to 37 CFR §1.637(a), which is specifically cross-referenced in Rule 635. The requirement for specificity is substantial. Jacobs v. Moriarity, 6 USPQ 2d 1799, 1801-1802 (PBAI 1988). A review of the Wattanasin Motion reveals it to be devoid as to any details of the testimony sought to be presented. It is not clear whether the testimony will be presented via deposition or affidavit. Indeed, the Motion requires both. See page 1. If presented via affidavit, it will require additional time in which to take cross-examination. Moreover, and of greater importance, the Motion fails to indicate what facts Wattanasin will attempt to prove. Indeed, the Motion is devoid of even a bare assertion that Wattanasin can adduce any evidence responsive to the issue of abandonment, suppression or concealment. Surely, such is a prerequisite prior to the extraordinary testimony period sought by Wattanasin.

It is respectfully submitted that it has long been the case

that in order to secure an extraordinary testimony period, beyond that originally provided for proof of priority, the movant should set forth the facts to be proven, and desirably accompany the Motion by affidavit sufficient to establish the movant's ability to prove the same. Revise & Caesar, Interference Law and Practice, Section 458, page 1962 (1947). This long-standing directive finds contemporary echoes in the decision Hanagan v. Kimura, 16 USPQ 2d 1791 (Comm. of Pats. 1990). Specifically, like Wattanasin herein, the party Kimura filed a Motion for permission to take testimony in a period the movant would not otherwise be entitled to. In the Motion, Kimura explained, in some detail, the nature of the testimony sought to be presented. 16 USPQ at 1792. Although the Motion was decided pursuant to the provisions of 37 CFR §1.639(c), there does not appear to be grounds for applying a different standard to Rule 639 and Rule 651. Indeed, Rule 651 has a "good cause" requirement not present in Rule 639, which presumably would require a higher standard. Note the petition for a testimony period was denied in Hanagan, for, inter alia, failure to describe the facts to be presented, identify the individuals to be called, and the absence of any declaration stating the factual testimony of the individuals to be presented. 16 USPQ 2d at 1794.

For failure to meet the simple standard of proof required of

a Motion, Fujikawa respectfully submits the Wattanasin Motion for an Additional Testimony Period must be dismissed.

B. If not Dismissed, the Wattanasin Motion must be Denied

As the sole "good cause" for an additional testimony period, Wattanasin appears to be urging that the filing of a Notice under Rule 632 automatically gives Wattanasin an opportunity to present additional testimony. The sole authority Wattanasin relies on is M.P.E.P. 2332. Neither that section, nor any other statute, regulation or case decision supports the conclusion that the appropriate response to the Notice required by 37 CFR §1.632 is the reopening of testimony. Specifically, testimony should be reopened only where the issue of abandonment, suppression of concealment comes as a surprise to the Junior Party. Nothing of the sort has been demonstrated in the current Interference.

Indeed, Wattanasin's Motion makes it quite clear that prior to the close of Wattanasin's testimony period, Counsel for Wattanasin was aware that Wattanasin's proof of priority ended approximately fifteen months prior to the filing of the Wattanasin effective filing date of March 3, 1989. See the Wattanasin Motion, page 2. Accordingly, Wattanasin was on notice, prior to the close of its

testimony period, that there was a fifteen-month delay between its proof of reduction to practice and the date for filing of a patent application. Well prior to Wattanasin's testimony in this case, it had been established that a fifteen-month delay is not per se reasonable, absent mitigating facts. Engelhard Corp. v. M.C. Canfield Sons, 13 USPQ 2d 1561 (DC NJ 1989).

M.P.E.P. 2332 indicates that Rule 632 was instituted to avoid surprise at the briefing stage. Indeed, section 2332 makes it clear that under prior practices, the Junior Party would not be aware of arguments relative to abandonment, suppression or concealment until receipt of the Senior Party's brief, a point in time at which it would be too late for the Junior Party to contest the issue. Suh v. Hoefle, 23 USPQ 2d 1321 (PBAI 1992). Wattanasin does not even allege the presence of surprise in this case, which might warrant the reopening of testimony addressed in the M.P.E.P. section referred to.

Rather, Wattanasin appears to be in the position of the party seeking a reopening of testimony in Issidorides v. Lay, 4 USPQ 2d 1854, 1859 (PBAI 1987). Specifically, Wattanasin was aware of the large hole in its proof, but decided to take the risk that Fujikawa would either not see that hole, or not take the appropriate action. Having rested its evidence with knowledge of a fifteen-month

hiatus, and electing to run the risk with respect thereto, Wattanasin cannot now be heard to reopen testimony for the purpose of presenting evidence that is not even fairly described in the Wattanasin Motion. Quite simply, there is no support in the rules or law for this repeated attempt at a bite at the apple.

Wattanasin can hardly be ignorant of the requirement that a party attempting to rely on an earlier conception and reduction to practice, such as Wattanasin, must prove that earlier invention was by one "who had not abandoned, suppressed or concealed it." 35 U.S.C. §102(g), first sentence. Thus, Wattanasin knew the task it had to meet, and quite simply elected to risk the silence of its proof as to its extended hiatus with regard to the invention in question, apparently in hopes that Fujikawa would not raise the same as an issue. While Wattanasin now suggests that it can present the necessary proofs, the type of proof to be presented is not even hinted at in the Motion. It would be highly inappropriate to present such evidence in reply to this opposition, as the provisions of 37 CFR §1.637 must be met in the motion itself, not the reply.

The requirement of presentation of good cause to reopen testimony period is hardly new. See Turner v. Bensinger, 1903 CD 53, 102 OG 1552 (Comm. 1902) and Brill v. Ubelades, 1902 CD 220, 99

OG 2966 (Comm. 1902). That requirement is codified in 37 CFR §1.651(c). Wattanasin ignores it.

While the precise issue of whether or not a filing of a notice pursuant to Rule 632 automatically gives the opponent the right to an additional testimony period does not appear to have been addressed, the legislative history of the rules, and prior case law is instructive. It was the intention of the drafter of Rule 632 that:

> Early notice will eliminate the need for the party moving to reopen the testimony period.

49 FR 48416 (December 12, 1984). This is true even though it is clear that a notice under Rule 632 is timely even if filed ten days after the period for testimony closes. 57 FR 2698. Quite clearly, both sides are on notice, absent some surprise not alleged in the Wattanasin Motion, that in those cases where abandonment, suppression or concealment may be proved by the absence of any activity on the part of the Junior Party for a substantial period of time, that abandonment may be an issue if appropriately raised pursuant to Rule 632.

As noted above, Wattanasin does not indicate the nature of the

proof it intends to submit, much less whether or not it was available during Wattanasin's original testimony period. It is respectfully submitted that prior case law indicates that if the material could have been presented during the original testimony period, the excuse of surprise, that the party seeking a new testimony period did not realize it would be required, is insufficient. Weber v. Kunz, 209 USPQ 864, 866 (POBI 1980). To the same effect Weber v. Kunz, 211 USPQ 637, 638-639 (POBI 1980) holding that the party's original showing should be as complete as possible.

The Interference decision in Rexroth v. Gunther, 202 USPQ 837, 838 (POBAI 1978) specifically deals with a party's request to present evidence responsive to the issue of abandonment, suppression of concealment. Specifically, the opportunity to respond by the presentation of evidence is not granted where the Junior Party had knowledge that the issue might be raised. Clearly, Wattanasin, having recognized the substantial hiatus in its own evidence without any indication of the same from Fujikawa, was aware that the issue might be raised. Further, the burden was on Wattanasin to explain this hiatus initially, as the burden is always on the inventor to explain an unreasonable or excessive delay. Horwath v. Lee, 195 USPQ 701 (CCPA 1977). As a general

matter, in this and other cases, additional testimony of the type sought to be presented by Wattanasin is permitted only where all possible steps have been taken to make sure that such testimony is presented in the original period provided for. Davis v. Reddy, 191 USPQ 866, 867 (POBI 1976).

Accordingly, Wattanasin was on notice during its original testimony period that it had the burden to explain the substantial, and per se, unreasonable delay between its alleged reduction to practice, and its effective filing date. Wattanasin does not indicate it was unaware of that burden, or of the hiatus in the proof offered. Wattanasin does not make any showing that it attempted to prove activity during the period in question, and was unable to, or indeed even assert that the testimony it now seeks to present was unavailable during its period for testimony-in-chief. Having failed to described with particularity the testimony Wattanasin now seeks to present, and failed to present good cause as to why it could not have earlier been presented, Wattanasin's Motion for a new testimony period must be denied. The same is respectfully requested.

C. Requiring Wattanasin to Specify its Argument is Improper

Apparently, Wattanasin finds in the rules a requirement for a

Senior Party seeking to preserve its opportunity to argument abandonment, suppression or concealment not self-evident from 37 CFR §1.632. Specifically, pages 2-3 of its Motion, Wattanasin indicates that the burden is on Fujikawa to provide the necessary:

> Specificity or particularity as to the basis for the allegation of abandonment, suppression or concealment.
>
> Therefor, Wattanasin requests, first of all that the party Fujikawa indicate with specificity the basis for its allegation of abandonment, suppression or concealment.
>
> Secondly, Wattanasin respectfully requests an opportunity to defend against the allegation of abandonment, suppression or concealment of the Wattanasin invention by taking additional testimony in connection therewith (preferably the substantive basis for said allegation will be sufficiently defined by Fujikawa et al on a timely basis to permit Wattanasin to present

testimony responsive thereto.

The final sentence of the above quotation is a non sequitur. Wattanasin is seeking a testimony period, yet it does not even know what the testimony it seeks to present is! This, in itself, is grounds for denying the Wattanasin Motion. In any event, there is absolutely no support, any where, for the argument that Fujikawa must provide additional specificity to support its Notice under Rule 632. Indeed, Rule 632 is just that, a "notice" provision, to avoid surprise. As noted above, the burden rests on Wattanasin to present a full proof in accordance with the provisions of 35 U.S.C. §102(g), either the first or second sentence. Fujikawa is obligated only to give notice that it takes issue with the adequacy of Wattanasin's proof in this regard, and Wattanasin concedes that Fujikawa has indeed done so. More is not required of Fujikawa.

D. Summary

Having failed to specify, with any particularity at all, what type of evidence Wattanasin seeks to present, having failed to establish that Wattanasin could not have presented the evidence it now seeks to present during its testimony-in-chief, having conceded that it was aware of the fifteen-month gap in proof offered in its

testimony-in-chief, and having conceded that it is not even yet aware of what type of proof it will offer (see Section C above), Wattanasin has failed to present the good cause and compelling argument required by the rules for an additional testimony period. Accordingly, the Motion must be dismissed, or in the alternative, denied.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

Fourth Floor
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703-521-5940

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL OPPOSITION TO WATTANASIN'S MOTION FOR LEAVE TO PRESENT ADDITIONAL TESTIMONY**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 13TH day of JANUARY, 1993.

STEVEN B. KELBER

Attorney Docket No.: 49-111-0
49-125-0 DIV

#19

49-125-0 DIV

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,975
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

NOTICE, 37 CFR §1.671(a)

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

BOX INTERFERENCE

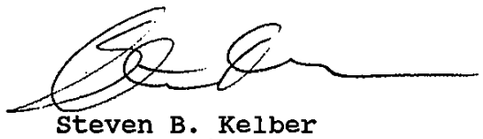
SIR:

Pursuant to the provisions of the above-captioned Rules, Fujikawa hereby serves notice of its intention to rely on the Affidavit of Masaki Kitahara - Patentably Distinct Subject Matter, and the Supplemental Declaration of Kitahara, filed and served June 11 and August 11, 1992, respectively. As copies of both Declarations have been served, the Declarations are deemed filed

pursuant to 137 CFR §1.672(b).

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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OFFICIAL FILE WRAPPER

Paper # 20

#21

Case No. 600-7101/CONT/INT FYI
Patent

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

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,975
Examiner-in-Chief: M. Sofocleous

**WATTANASIN REPLY TO
FUJIKAWA OPPOSITION TO
WATTANASIN MOTION FOR LEAVE TO PRESENT ADDITIONAL TESTIMONY**

I. BACKGROUND

By paper dated December 15, 1992, Fujikawa et al. served on Wattanasin a notification pursuant to 37 CFR §1.632 in the above interferences, indicating an intention to raise an affirmative defense of abandonment, suppression or concealment.

In response, the party Wattanasin on December 31, 1992 filed and served a motion for leave to present additional testimony going to the absence of abandonment, suppression or concealment of the Wattanasin invention.

The testimony in question would be presented in affidavit form, and relates primarily to activity of the inventor, Dr. Wattanasin, showing the absence of abandonment, suppression and concealment, and to attorney activities over a period of about fifteen months prior to the filing of the Wattanasin application on March 3, 1989.

Fujikawa have now opposed the Wattanasin motion (Paper of January 13, 1993).

Fujikawa in their Opposition have made certain arguments with respect to the substantive requirements of Rule 632, as well as the formal sufficiency of the Wattanasin motion, to which Wattanasin replies as follows:

II. 37 CFR §1.632

37 CFR §1.632, which became effective on February 11, 1985, as part of the revised interference rules, has no predecessor section in the prior interference rules.

The related commentary of the Patent and Trademark Office makes clear that Rule 632, as a newly created rule, was specifically intended to address situations developing in the case law where the issue of abandonment, concealment or suppression was not raised by a party until the briefing stage or at final hearing, thereby depriving the opposer of a fair opportunity to present relevant testimony thereon, except by way of a re-opened testimony period well beyond the interlocutory stage[1].

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1. The commentary refers to Klug v. Wood, 212 USPQ 767, 771, n. 2 (Bd. Pat. Int. 1981) wherein the senior party apparently raised the defense suppression and concealment in the final brief. The Board's denial of the junior party's motion to re-open its testimony period to admit evidence to rebut the accusation turned on the belatedness of that motion, which was not made until after final hearing

The commentary on Rule 632 states in part as follows (the sentences being separated into numbered paragraphs for convenience):

> "[1] Under current practice where notice is not required, it is possible that a party may learn for the first time that abandonment, suppression, or concealment is an issue when the party receives an opponent's brief at final hearing. See Klug v. Wood, 212 USPQ 767, 771, n.2 (Bd. Pat. Int. 1981). At that point it is often too late to reopen proceedings in the interference. The purpose of requiring the notice under §1.632 is to make the parties and the Board aware during the interlocutory stage of an interference that abandonment, suppression, or concealment may be an issue in the interference.
>
> [2] Early notice will permit the parties to ask for and the examiner-in-chief to set appropriate testimony periods for a party to present evidence related to abandonment, suppression or concealment, particularly in cases where long unexplained delays tend to prove the allegation of suppression or concealment." [emphasis supplied]
>
> "[3] Early notice will also eliminate the need for the party moving to reopen the testimony period. Klug v. Wood, supra".

1062 OG 219 (January 7, 1986)

First of all, paragraph [2] makes clear that the drafters of Rule 632 contemplated that parties will be permitted to ask for, and the EIC to set, testimony periods for evidence to be presented going to the abandonment issue during the interlocutory period.

(Footnote 1 continued from previous page)
(evidently some six months after submission of briefs).

It is noted that paragraph [3] -- isolated from context and lacking the citation of the 1981 Klug opinion -- was relied on by Fujikawa in their Opposition at p. 9 as a blanket assertion by the drafters that early notice would eliminate the need for a party to reopen the testimony period.

On the contrary, when paragraph [3] is read in context, i.e. sequentially after paragraph [2], and with the reference to Klug restored, it obviously reflects an intention by the drafters not that testimony periods never be reopened, which would surely be at variance with the prior paragraph, but that recurrence of another Klug-type situation be prevented.

Thus it is evident that the drafters did intend that reopened testimony periods, if seasonably requested, be permitted in response to a Rule 632 Notification. Moreover, given that Rule 632 permits Notification to be made even up to 10 days beyond the opposing party's testimony-in-chief, it must typically be the case that any reopened testimony period of the opposer would extend well beyond the period originally set.

The rationale of Rule 632 is clearly to facilitate an orderly presentation of testimony on all issues prior to submission of briefs and final hearing.

However, notwithstanding the clear directive contained in the PTO commentary, Fujikawa further argue that the receiving party of a Rule 632 Notification must meet some additional threshold element of "surprise" in order to be granted leave to present additional testimony going to abandonment, etc. (Opp. at

p. 9).[2]

On this rationale, Fujikawa sieze upon Wattanasin's statements concerning the substance of its proofs as to priority already made of record -- which were made for the convenience of the EIC in evaluating Wattanasin's motion -- as some sort of admission that Wattanasin lacks the requisite mental state of "surprise" to be granted a reopened testimony period.

The fact is, no such element of "surprise" is envisaged by the commentary in relation to practice under the new Rule 632.

---

2. Fujikawa cite various pre-1985 and post-1984 cases, none of which is considered on point:

Suh v. Hoefle, 23 USPQ2d 1321 (BPAI 1992), turns on whether a belated motion for judgment based on unpatentability, made some 34 months after close of the preliminary motions period, met the good cause requirement of 37 CFR §1.655(b)(3). Hanagan v. Kimura, 16 USPQ2d 1791 (Comm. Pat. 1990), concerns the sufficiency of a Rule 639 motion to take testimony. At issue in Jacobs v. Moriarity, 6 USPQ2d 1799 (BPAI 1988), is the sufficiency of a preliminary motion for judgment on the ground of unpatentability. Issidorides v. Ley, 4 USPQ2d 1854 (BPAI 1987), concerns a belated motion after final hearing to reopen the testimony period to retake deposition testimony invalidated by formal deficiencies, where the movant had already been given at least 3 "bites at the apple," including leave to take testimony after final hearing.

With respect to the pre-1985 cases:

Rexroth v. Gunther, 202 USPQ 837 (BPAI 1978), is an example of the confusion arising under the old interference rules concerning notification of intent to argue abandonment. In that case the Board ruled that the senior party had in effect given notice by requesting additional discovery in relation thereto, making the junior party aware of the issue prior to the times for taking testimony. Horwath v. Lee, 195 USPQ 701 (CCPA 1977), also referred to in the commentary to Rule 632, simply stands for the proposition that suppression or concealment issues must be considered on a case-by-case basis. In Horwath, a nearly 6-year delay between reduction to practice and filing was found prima facie unreasonable under the circumstances but rebuttable (even though not found rebutted) by the evidence.

Quite to the contrary, paragraph [2], above, specifically states that it is "particularly" instances where "long, unexplained delays" raise a prima facie case of abandonment, etc., that the rule was intended to address.[3]

While Wattanasin does not believe that the period of time at issue, i.e. about 15 months, raises a prima facie case of abandonment, paragraph [2] obviously indicates the drafters' intent, even in cases where the delay does rise to such level, that there should be no restriction on reopening of testimony to complete the record in this regard. Far from being "extraordinary," as Fujikawa persist in alleging (Opp. at p. 4-5), the Wattanasin motion is fully countenanced by the PTO commentary on Rule 632, as evident above.

Furthermore, in order to harmonize the commentary on Rule 632 with the other involved interference rules, it has to be inferred that a Rule 632 Notification, in itself, provides sufficient "good cause" under 37 CFR §1.651 for reopening the testimony period.

Wattanasin also takes issue with the Fujikawa characterization of the time period at issue as being either "not per se reasonable (Opp., p.7), or alternatively, "per se unreasonable" (Opp. at p. 11), neither of which terms to Wattanasin's knowledge has a recognized legal meaning. Fujikawa's citation to Engelhard Corp. v. M.C. Canfield Sons, 13 USPQ2d 1561

3. Alternatively, Fujikawa can hardly be saying that only a party who is "unaware" or "surprised" by either the content of its own proofs and/or the law concerning 35 USC 102(g) would receive the benefit of a reopened testimony period!

(DNJ 1989), is ironic given that the district court in that case acknowledged the virtual unanimity of the case law on the point that "delays of less than two years are reasonable," 13 USPQ2d at 1564-1565.

Of course, when an affirmative defense of abandonment is raised, the issue turns not on whether a period of inactivity is "not per se" reasonable or "per se unreasonable"; but, rather, whether it is "prima facie" unreasonable. And even when a prima facie case has been established, it can be overcome by submission of proofs that it is not unreasonable.

Lacking any real support in either the PTO commentary on Rule 632 or the relevant case law for challenging the substantive basis of the Wattanasin motion, Fujikawa refer to a litany of alleged formal deficiencies in the motion.

However, Wattanasin submits that its motion was both seasonably presented and had ample specificity, in that it referred to the Fujikawa Rule 632 notification, presented the status of the subject interferences, and described Wattanasin's requested relief in the form of an additional testimony period to present evidence going to the absence of abandonment, suppression and concealment of the Wattanasin invention.

III. CONCLUSION

The arguments of Fujikawa are contradicted by the clear language of the PTO commentary on Rule 632. Rule 632 is intended precisely to permit a party on notice of an affirmative defense of abandonment, suppression or concealment to seasonably request and

present evidence going to the absence thereof, in order to facilitate a full briefing on the issues before the Board and avoid belated presentation of testimony.

In the present circumstances, where in fact the relevant period of time before the filing of the Wattanasin application is not considered prima facie unreasonable under the prevailing law, it is appropriate and entirely consistent with the commentary surrounding Rule 632, that the Wattanasin motion be granted.

It is noted that undersigned counsel for Wattanasin in the prior motion inadvertently expressed a preference that a reopened Wattanasin testimony period run from January 4, 1993 to February 1, 1993, in erroneous disregard of the need to account for periods for filing opposition and replies on the Wattanasin motion. Therefore, Wattanasin hereby amends its motion to the extent of requesting that any such re-opened testimony period preferably run for a period of about two to three weeks from the date of the EIC decision thereon.

Grant of the Wattanasin motion would not be seem to impinge on the PTO interest in expediting resolution of the underlying interferences: Since Fujikawa et al. are relying on their Japanese priority documents as a constructive reduction to practice, it is expected that the interlocutory period will be effectively completed in relatively short time, i.e. as soon as Fujikawa have completed cross-examination of the Wattanasin testimony.

It is further noted that Mr. Kelber, counsel for Fujikawa et al. has indicated to the undersigned that he will be unavailable and out of the country during the period of February 2

to February 13, 1993; and therefore the scheduling of a re-opened Wattanasin testimony period overlapping at least with this period would not seem to be particularly disruptive to Fujikawa et al.

Accordingly, grant of the Wattanasin motion for leave to present additional testimony is respectfully requested.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
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DEF:rmf
January 28, 1993

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on Jan. 28, 1993
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
1/28/93
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

**WATTANASIN REPLY TO
FUJIKAWA OPPOSITION TO
WATTANASIN MOTION FOR LEAVE TO PRESENT ADDITIONAL TESTIMONY**

was served on counsel for the party Fujikawa et al., this 28th day of January 1993, by postage pre-paid first-class mail addressed to the following:

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Arlington, VA 22202

Diane Furman 1/28/93
Diane E. Furman

Paper No. 22

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Telephone: (703)557-4007
Facsimile: (703)557-8642

Interference No. 102,975

Wattanasin et al.

v.

Fujikawa et al.

Receipt is acknowledged of the motion for leave to present additional testimony, filed on January 6, 1993 by Wattanasin et al. (Paper No. 17). An opposition and a reply thereto have been filed.

For the reasons stated therein and in the reply to the opposition, the motion is granted. It is the practice of the Board to permit a party to reopen its testimony for the purpose of presenting additional evidence where an opponent files a notice under 37 CFR 1.632 raising the issue of abandonment, suppression or concealment.

Accordingly, the times are reset as follows:

Testimony-in-chief of the junior party Wattanasin for deposition testimony, including cross-examination of witnesses, to close February 25, 1993.

Testimony-in-chief of the junior party Wattanasin for affidavit testimony (affidavits pursuant to 37 CFR 1.671(e) and 1.672(b) must be filed) to close February 20, 1993.

Cross-examination of any junior party's affiants to close February 25, 1993.

Since the parties have agreed to have the rebuttal testimony of the senior party Fujikawa et al. run concurrently with any cross-examination of the junior party witnesses, the EIC does not perceive of any reason to reset the rebuttal testimony period.

The time for filing and serving the record and the briefs remains as set in Paper No. 5.

Michael Sofocleous
Examiner-in-Chief
(703) 557-4066

gjh

49-125-0 DIV

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

WATTANASIN	:	
	:	**INTERFERENCE NO.: 102,975**
V.	:	**EXAMINER-IN-CHIEF:**
FUJIKAWA ET AL	:	**MICHAEL SOFOCLEOUS**

MOTION FOR EXTENSION OF TIME,
37 CFR §1.645, §1.635

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

BOX INTERFERENCE

SIR:

Responsive to the Decisions of the EIC in the above-captioned Interference and related Interference (Paper No. 77 in Interference 102,648 and Paper No. 22 in Interference 102,975), Fujikawa et al hereby move all pending dates for action subsequent to the date for completion of testimony-in-chief by the Junior Party be extended one month. Accordingly, cross-examination of any Junior Party affiant, and the date for completion of any Senior Party rebuttal testimony, including any cross-examination, would close March 25,

1993. Other dates would be extended, as set forth below.

As grounds for this request, it is respectfully submitted that the reopening of the Junior Party testimony period for leave to present new testimony related to the issue of abandonment, suppression or concealment ordered does not provide sufficient time for cross-examination of the Junior Party affiants, followed by the submission of rebuttal testimony, if necessary. Specifically, the testimony of the Junior Party will not be completed until February 20, 1993 (actually filed and served February 22, 1993). The current date for cross-examination of such witnesses to close, and the date for presentation of rebuttal testimony by the Senior Party, is February 25, 1993. It is unlikely that undersigned Counsel will receive the testimony of the Junior Party, much less be in a position to cross-examine with respect to the same, or present rebuttal testimony, by February 25, 1993.

Accordingly, Counsel for the Junior Party and undersigned Counsel have discussed the situation, and are in agreement that all dates in Interferences 102,648 and 102,975 subsequent to the closing date for testimony-in-chief of the Junior Party be extended one month. This will provide sufficient time for cross-examination of the Junior Party affiants, as well as the presentation of rebuttal testimony, which should be completed by March 25, 1993.

If granted, this Motion will extend the established times as follows:

--Testimony-in-chief of the Junior Party for Affidavit Testimony to close February 20, 1993.

--Cross-examination of any Junior Party's affiants to close March 25, 1993.

--Rebuttal testimony for the Senior Party, including affidavit testimony and cross-examination as well as deposition testimony, to close March 25, 1993.

--Filing and serving of the record, April 25, 1993.

--Junior Party's Opening Brief due May 25, 1993.

--Senior Party's Brief due June 25, 1993.

--Junior Party's Reply Brief due July 15, 1993.

EIC Sofocleous was contacted on the morning of February 18, 1993, and indicated that on the above grounds, this Motion would be

granted. The cooperation and assistance of the EIC is deeply appreciated.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **MOTION FOR EXTENSION OF TIME, 37 CFR §1.645, §1.635**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 18th day of FEBRUARY, 1993.

STEVEN B. KELBER

[redacted]

[redacted]

MAILED

FEB 19 1993

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS & INTERFERENCES

APPEALS & INTERFERENCES

FEB 18 1993

#24

49-125-0 DIV

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,975
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

APPROVED

FEB 19 1993

By [signature]
Examiner-in-Chief

MOTION FOR EXTENSION OF TIME,
37 CFR §1.645, §1.635

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

BOX INTERFERENCE

SIR:

Responsive to the Decisions of the EIC in the above-captioned Interference and related Interference (Paper No. 77 in Interference 102,648 and Paper No. 22 in Interference 102,975), Fujikawa et al hereby move all pending dates for action subsequent to the date for completion of testimony-in-chief by the Junior Party be extended one month. Accordingly, cross-examination of any Junior Party affiant, and the date for completion of any Senior Party rebuttal testimony, including any cross-examination, would close March 25,

49-125-0 DIV

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

WATTANASIN	:	
V.	:	**INTERFERENCE NO.: 102,975**
	:	**EXAMINER-IN-CHIEF:**
FUJIKAWA ET AL	:	**MICHAEL SOFOCLEOUS**

FUJIKAWA ET AL REQUEST FOR CROSS-EXAMINATION

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

BOX INTERFERENCE

SIR:

Responsive to the filing of Wattanasin Consolidated Affidavit Testimony (Volume IV) bearing a filing date of February 22, 1993, Fujikawa hereby requests cross-examination of the following Affiants:

1. Sompong Wattanasin
2. Melvyn M. Kassenoff
3. Joanne M. Giesser

4. Linda Rothwell

5. Lorraine M. Chesley

The cross-examination of Robert G. Engstrom will not be required.

The cross-examination will be as to all Declarations submitted by Sompong Wattanasin in this Interference. The remaining declarants are believed confined to Volume IV.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL REQUEST FOR CROSS-EXAMINATION**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 25th day of FEBRUARY, 1993.

STEVEN B. KELBER

#26

49-125-0 DIV

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,975
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

NOTICE OF DEPOSITION

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

BOX INTERFERENCE

SIR:

Pursuant to 37 CFR §1.673(a), Fujikawa et al hereby serve notice of the deposition of Dr. Chester E. Holmlund to be held at the offices of undersigned Counsel on March 12, 1993, beginning at 10:00 AM, and continuing from time-to-time until done. It is not expected that the deposition will last beyond a single day, but in the event it does, the deposition will be resumed March 15, 1993.

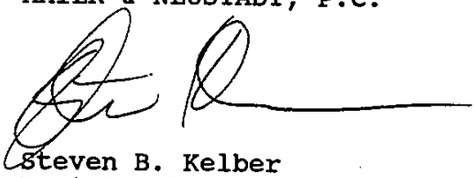
The current address for Dr. Holmlund is 9200 Edwards Way, Apartment 516, Adelphi, Maryland. The witness is expected to

testify in a rebuttal capacity, as to the adequacy of the proof of the Junior Party with respect to conception and actual reduction to practice.

Undersigned Counsel, prior to the service of this notice, contacted Counsel for the Junior Party, Diane Furman, to establish a mutually acceptable time and place for conducting the deposition. Counsel for the Junior Party indicated that she could not at the time agree to any date in the period provided in the approved Motion for Extension of Time, mailed February 19, 1993, due to unspecified contingencies. If Counsel for the Junior Party indicates the designated time is unacceptable, undersigned Counsel shall initiate a conference call with the EIC.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **NOTICE OF DEPOSITION**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via facsimile and via first-class mail, postage prepaid, this 1ST day of MARCH, 1993.

STEVEN B. KELBER

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Paper # 27

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

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,975

#28

Examiner in Chief: M. Sofocleous

APPROVED

MAR/9 1993

Examiner-in-Chief

JOINT REQUEST FOR EXTENSION OF TIME

The parties Wattanasin and Fujikawa et al. jointly request an extension of time in which to complete taking of cross-examination and rebuttal testimony, as well as an extension of the dates currently set for taking subsequent action, in the above interferences.

The EIC and the parties have been in agreement that cross-examination of the junior party Wattanasin's affiants may run concurrently with the rebuttal testimony of senior party Fujikawa. The current closing date for cross-examination and rebuttal is set for March 25, 1993.

Fujikawa et al. have noticed five Wattanasin affiants for cross-examination, and will also take rebuttal testimony from one non-party witness.

However, owing to other commitments of the involved parties and their witnesses, it has been necessary to tentatively defer the dates for taking rebuttal testimony and certain of the cross-examination until after the current closing date of March 25, 1993[1], pending decision on this motion.

Therefore, the parties now jointly move to reset the relevant dates in the above interferences as follows:

Cross-examination of Wattanasin affiants to close April 15, 1993.
Rebuttal testimony for Fujikawa ..... to close April 15, 1993.
Filing and serving of the record due ..... May 15, 1993.
Wattanasin opening brief due ..... June 15, 1993.
Fujikawa brief due ..... July 15, 1993.
Wattanasin reply brief due ..... August 4, 1993.

Undersigned counsel for the party Wattanasin has discussed this matter with EIC Sofocleous, who indicated he would be agreeable to resetting the dates as set forth above. The courtesy of the EIC is gratefully acknowledged.

---

1. The rebuttal testimony of Dr. Holmlund is tentatively set for March 26, 1993, and cross-examination of Joanne M. Giesser, Esq. is tentatively scheduled for April 9, 1993. The cross-examination of the other Wattanasin affiants will be held on March 22, 1993.

Accordingly, grant of this joint motion is respectfully requested.

Respectfully submitted,

Diane Furman 3/17/93

Diane E. Furman
Attorney for the party Wattanasin
Registration No. 31,104
201-503-7332

Steven B. Kelber
Attorney for the party Fujikawa et al.
Registration No. 30,073
(703) 413-3000

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **JOINT REQUEST FOR EXTENSION OF TIME (EXECUTED)**
2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 19TH day of MARCH, 1993.

STEVEN B. KELBER

Attorney Docket No.: 49-111-0
49-125-0 DIV

[redacted]

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

BOARD OF PATENT APPEALS & INTERFERENCES

MAR 19 1993

WATTANASIN

MAILED

v.

Interference Nos. 102,648, 102,975

#29

FUJIKAWA et al.

Examiner in Chief: M. Sofocleous

APPROVED

3/19 1993

Examiner-in-Chief

JOINT REQUEST FOR EXTENSION OF TIME

The parties Wattanasin and Fujikawa et al. jointly request an extension of time in which to complete taking of cross-examination and rebuttal testimony, as well as an extension of the dates currently set for taking subsequent action, in the above interferences.

The EIC and the parties have been in agreement that cross-examination of the junior party Wattanasin's affiants may run concurrently with the rebuttal testimony of senior party Fujikawa. The current closing date for cross-examination and rebuttal is set for March 25, 1993.

Fujikawa et al. have noticed five Wattanasin affiants for cross-examination, and will also take rebuttal testimony from one non-party witness.

49-111-0

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,975
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

NOTICE OF DEPOSITION

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

BOX INTERFERENCE

SIR:

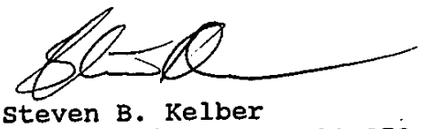
Pursuant to 37 CFR §1.673(a), Fujikawa et al hereby serve notice of the deposition of Dr. Chester E. Holmlund to be held at the offices of undersigned Counsel on March 26, 1993, beginning at 10:00 AM, and continuing from time-to-time until done. It is not expected that the deposition will last beyond a single day, but in the event it does, the deposition will be resumed March 29, 1993.

The current address for Dr. Holmlund is 9200 Edwards Way, Apartment 516, Adelphi, Maryland. The witness is expected to testify in a rebuttal capacity, as to the adequacy of the proof of the Junior Party with respect to conception and actual reduction to practice.

A true copy of the foregoing Notice of Deposition was served, by hand, on Diane Furman, Sandoz Corporation, on March 26, 1993, agreement as to the date of deposition and manner of notice having been earlier agreed upon.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

#31

Case No. 600-7101/CONT/INT
Patent

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

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,975
Examiner-in-Chief: M. Sofocleous

WATTANASIN NOTICE OF CROSS-EXAMINATION DEPOSITION 37 CFR §1.673(e)

By agreement of the parties, the cross-examination deposition of Joanne M. Giesser will be held on Friday, April 9, 1993 at the following address:

Amoco Corp.
55 Shuman Boulevard
"N Building"
Suite 600
Naperville, IL 60563

The starting time will be 12 noon.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
East Hanover, NJ 07936

DEF:rmf
April 5, 1993
Encs: OVERVIEW MAP AND LOCAL MAPS A,B AND C

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

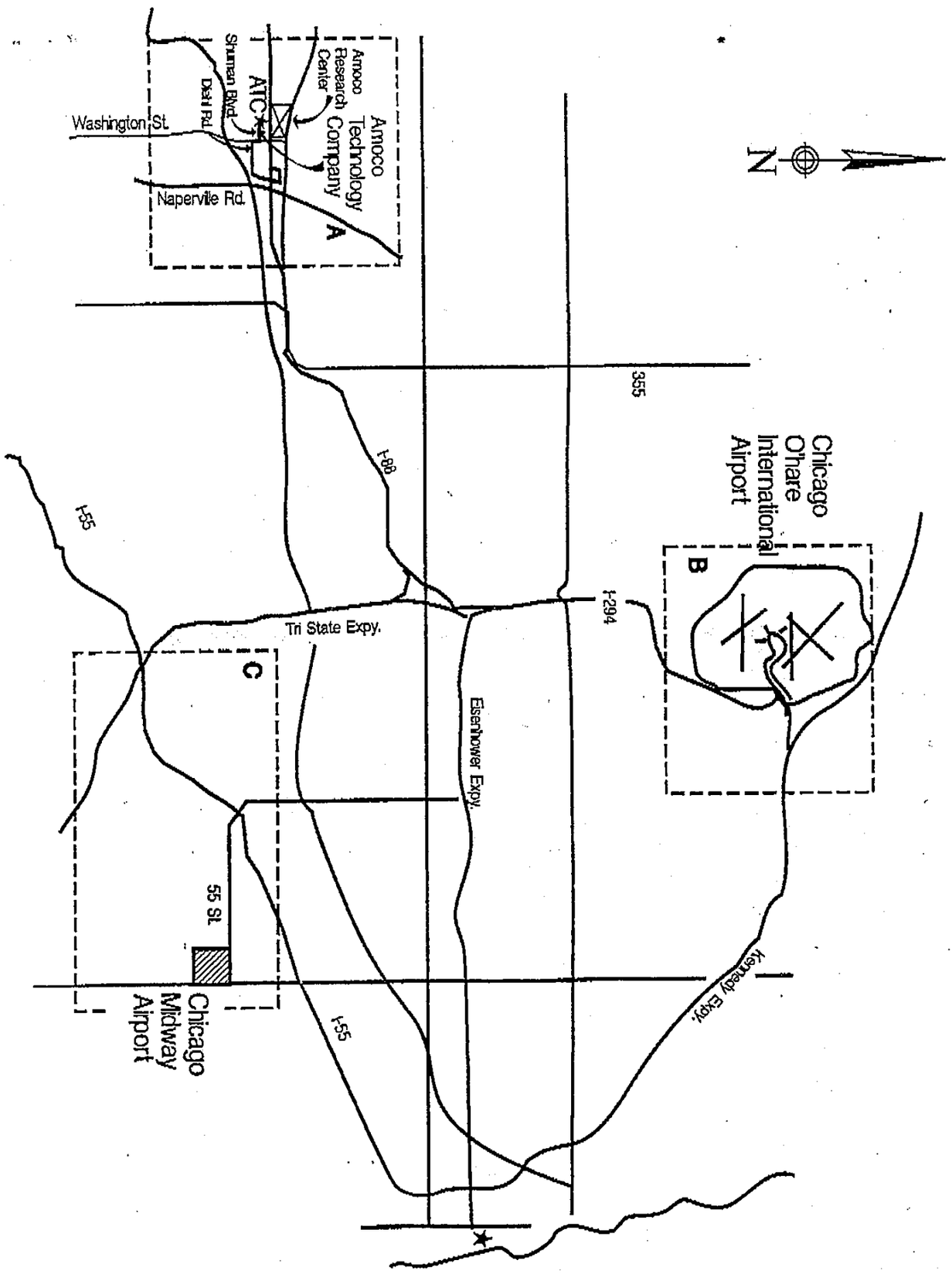
WATTANASIN NOTICE OF CROSS-EXAMINATION DEPOSITION 37 CFR §1.673(e)

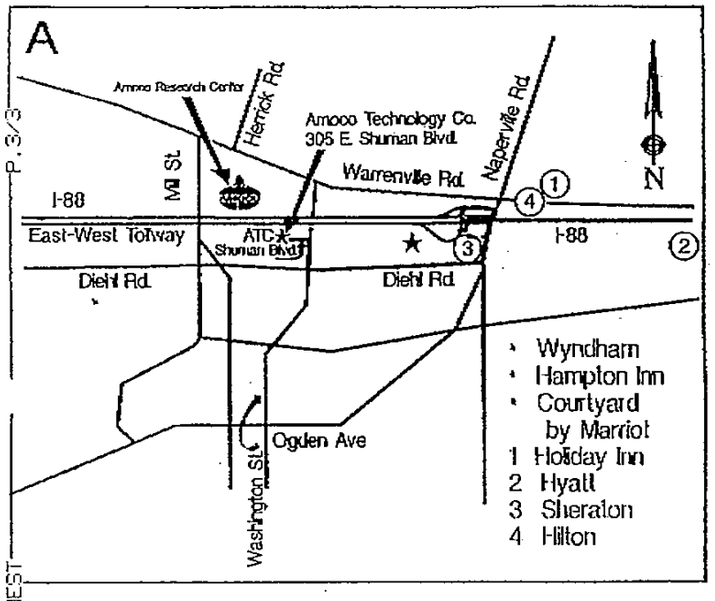
was served on counsel for the party Fujikawa et al., this 5th day of April 1993, by facsimile and by postage pre-paid first-class mail addressed to the following:

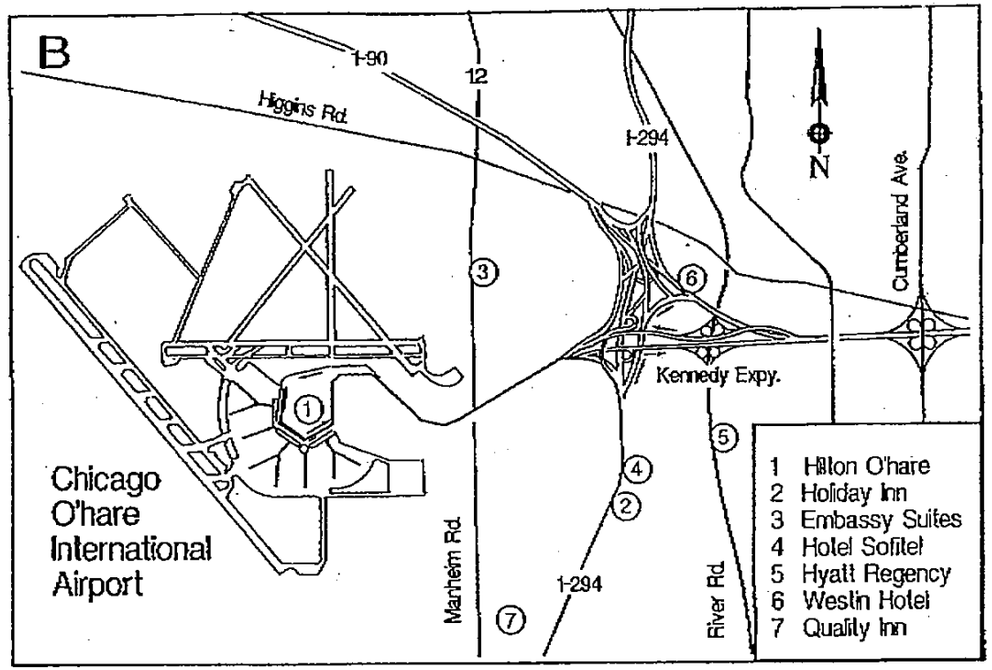
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202
FAX: (703) 413-2220

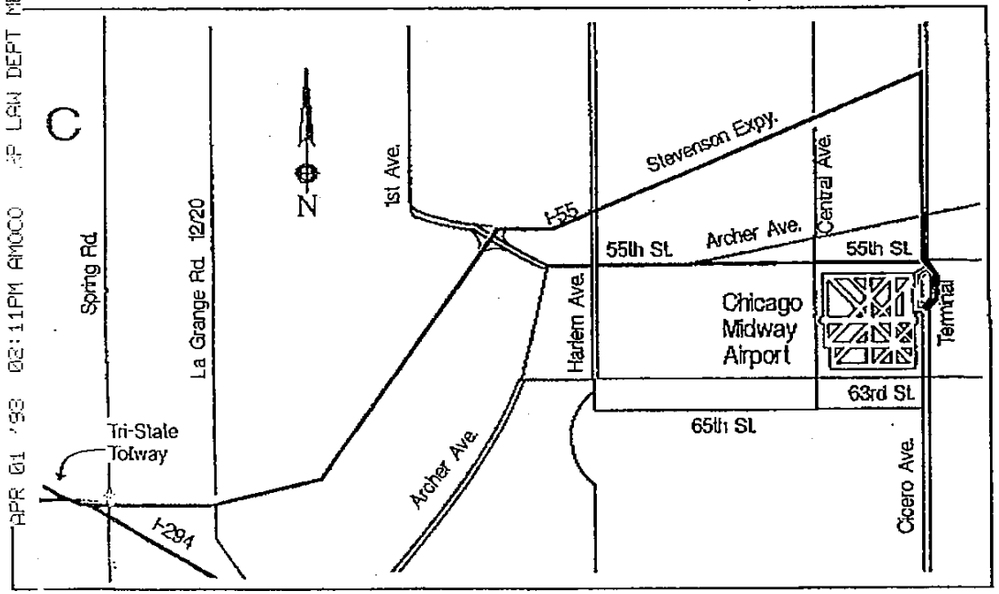
Diane Furman

Diane E. Furman


Amoco Technology Company
Amoco Research Center
ATC
Sherman Blvd.
Dist'l Rd.
Washington St.
Naperville Rd.
A
N
355
I-88
I-55
Chicago O'hare International Airport
B
I-294
Tri State Expy.
Eisenhower Expy.
C
55 St.
Chicago Midway Airport
I-55
Kennedy Expy.







55 Shuman Blvd
"The N Building"
Suite 600
Naperville, IL 60563

#32

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Express Mail Mailing Label Number TB216846399US

Date of Mailing April 22, 1993 Interference Nos. 102,648, 102,975

I hereby certify that on the date indicated above, these materials, comprising the original transcripts of the depositions of Sompong Wattanasin, Melvyn M. Kassenoff, Esq., and Linda Rothwell in Interference Nos. 102,648 and 102,975, are being deposited with the United States Postal Service as Post Office to Addressee Express Mail addressed to the Commissioner of Patents and Trademarks, Box Interference, Washington, D.C. 20231.

FYI

Antoinette Lombardi
Signature of Person Mailing the Materials

APR 29 1993

RECEIVED IN
BOX INTERFERENCE

Antoinette Lombardi
Printed or Typed Name of Person Mailing the Materials

TB216846399US POST OFFICE TO ADDRESSEE

ORIGIN

Express Mail Corporate Account No.

Federal Agency Account No.

FROM:
SANDOZ CORPORATION
PATENT DEPARTMENT
59 RT 10
EAST HANOVER NJ 07936-1080

ADDRESSEE'S COPY

TO:
US PATENT & TRADEMARK OFFICE
DEPARTMENT OF COMMERCE
WASHINGTON DC 20231-0000
BOX Interference

Waiver of Signature and Indemnity (Domestic Only)

TRADEMARK OFF.

#33

49-125-0 DIV

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,975
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

FUJIKAWA ET AL SUBMISSION OF CERTIFIED TRANSCRIPT OF DEPOSITION OF CHESTER E. HOLMLUND

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

BOX INTERFERENCE

SIR:

Submitted herewith is the certified transcript of the deposition of Chester E. Holmlund.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL SUBMISSION OF CERTIFIED TRANSCRIPT OF DEPOSITION OF CHESTER E. HOLMLUND**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via first-class mail, postage prepaid, this 28th day of APRIL, 1993.

STEVEN B. KELBER

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Paper # 34

#35

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

WATTANASIN	:	
	:	**INTERFERENCE NO.: 102,975**
V.	:	**EXAMINER-IN-CHIEF:**
FUJIKAWA ET AL	:	**MICHAEL SOFOCLEOUS**

FUJIKAWA ET AL MOTION TO CONSOLIDATE THE RECORD

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

SIR:

Pursuant to the provisions of 37 CFR §1.610(d)(e), as well as 37 CFR §1.635, Fujikawa et al hereby moves to consolidate the Record for Interferences 102,648 and 102,975, into a single Record, inasmuch as the Records are identical, the same testimony and exhibits being used for both Interferences. This is consistent with the understanding of the parties. For the convenience of the Patent Office, six copies of the Record are being filed, three for each Interference, 37 CFR §1.653(c).

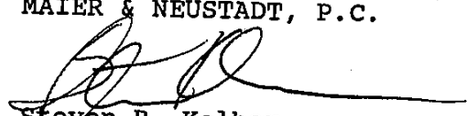
It should be expressly noted that this Motion does not include consolidation of the Briefs. The Counts of the two Interferences appear to be patentably distinct, and in any event, raise different issues with regard to the necessary proof of priority, as well as potential other issues. Accordingly, the Briefs for each Interference shall be filed separately.

Pursuant to the provisions of Rule 637(b), this Motion and the circumstances involved were discussed extensively with Counsel for Wattanasin, Diane Furman, and Counsel is in agreement with this Motion.

The substance of this Motion was discussed by phone with EIC Sofocleous, who indicated that on the grounds set forth, the Motion would be granted. The assistance and cooperation of the EIC is deeply appreciated.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL MOTION TO CONSOLIDATE THE RECORD**
2. **FUJIKAWA'S RECORD, VOLUMES 1-V, AND EXHIBIT**
3. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FEDERAL EXPRESS, this 17TH day of MAY, 1993.

STEVEN B. KELBER

Interference 102,975

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Papers # 36
and # 37

Case No. 60[illegible]-7101/CONT/INT.
Patent

#38

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

WATTANASIN

Interference No. 102,648

V.

~~Interference No. 102,975~~

FUJIKAWA et al.

Examiner-in-Chief: M. Sofocleous

FYI

WATTANASIN NOTICE OF FILING OF THE RECORD MAY 19 1993
37 CFR §1.653(c)

RECEIVED IN
BOX INTERFERENCE

Appended is the Wattanasin Consolidated Record for Interference Nos. 102,648 and 102,975.

Respectfully submitted,

Diane Furman 5/17/93
Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

Enclosures:

Record
Volumes I, II, III, IV, V

Exhibits
A-1, A-2, A-3; B-1, B-2; C-1, C-2, C-3; D-1, D-2, D-3; E-1, E-2, E-3, E-4, E-5; F-1; G-1, G-2; H-1; I-1; J-1; K-1; L-1; M-1, M-2, M-3, M-4, M-5; N; O; P-1, P-2, P-3; Q; R; S; T; U-1, U-2; V-1, V-2; W; X; Y-1, Y-2; Z; S-1, S-2, S-3, S-4.

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

DEF:rmf
May 17, 1993

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on May 17, 1993
(Date of Deposit)
Diane E. Furman
(Name of applicant, assignee, or Registered Representative)
Diane Furman
(Signature)
5/17/93
(Date of Signature)

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN NOTICE OF FILING OF THE RECORD
37 CFR §1.653(c)

and the Record and Exhibits appended thereto were served on counsel for the party Fujikawa et al., this 17th day of May 1993, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Paper # 39

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

WATTANASIN	:	
	:	**INTERFERENCE NO.: 102,975**
V.	:	**EXAMINER-IN-CHIEF:**
FUJIKAWA ET AL	:	**MICHAEL SOFOCLEOUS**

FUJIKAWA ET AL MOTION FOR SANCTIONS,
37 CFR §1.616

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

SIR:

Pursuant to the provisions of Rule 616, and in accordance with the provisions of 37 CFR §1.635, Fujikawa et al hereby request an order entering sanctions against the party Wattanasin for deliberate and knowing of violation of 37 CFR §10.62(b) and §10.63(a). Specifically, Fujikawa seeks sanctions for Wattanasin's introduction of, and reliance on, the testimony of one Melvyn Kassenoff, a crucial witness of the party Wattanasin with respect to the issues of abandonment, suppression and concealment, while at

the same time listing the same Melvyn Kassenoff as "Of Counsel" on the Record filed by Wattanasin in the above Interference, and refusing to exclude Melvyn Kassenoff from participation in the preparation of Wattanasin's Brief and Reply Brief, and in participation and preparation for Final Hearing. Further, to the extent Melvyn Kassenoff has acted as Counsel, in an advisory capacity, for the party Wattanasin throughout the Interference, such action further aggravates the violates of 37 CFR §10.62.

For the convenience of the Examiner, Fujikawa requests three different sanctions of varying severity, in the alternative. As a final matter Fujikawa requests a conference call be initiated on this matter at the earliest convenience of the EIC.

I. STATEMENT OF FACTS

1. In Wattanasin's Designation of Lead Attorney, filed March 23, 1992, Diane E. Furman was designated as Lead Attorney. Melvyn Kassenoff was designated as "Deputy Lead Attorney with full power and authority to act in the absence, for any reason, of the Lead Attorney."

2. At no time during this Interference has there been any need for action on the party Wattanasin in the absence of Lead Counsel Furman. A review of the Record reflects that only Lead Counsel Furman has appeared on behalf of Wattanasin, with supplemental questioning during certain depositions conducted by Mr. Richard Vila. No action has been taken, directly, by Melvyn Kassenoff in this Interference.

3. The Declaration of Melvyn Kassenoff was submitted by Wattanasin as evidence with respect to the issue of abandonment, suppression or concealment. The Declaration can be found at Wattanasin Record (herein after WR) pages 227-232. The Declaration is replete with statements of subjective intent that can be verified only by Melvyn Kassenoff's memory. See, e.g., paragraph 4, WR-228, "I was aware that patent disclosure 229/84 of Sampong Wattanasin had received an "A" rating. It was my intention that the case would be filed...". Similarly, paragraph 6 of the Declaration refers to Melvyn Kassenoff's "best recollection that in February of 1988, I was in communication with Dr. Wattanasin concerning information...". Finally, see paragraph 11, which refers to Melvyn Kassenoff's assertion that at no time "did I or, insofar as I aware, any other member of the patent and trademark

department of Sandoz Corporation, ever have any intention not to file a United States patent application...".

4. Due to the conclusory nature of some of the assertions in Melvyn Kassenoff's Declaration, and the lack of clarity of certain terms used, such as "backlog", Melvyn Kassenoff's cross-examination was taken, that cross-examination appearing at WR-234-317.

5. On May 15, 1993, Wattanasin filed and served its Record, which lists, as "Of Counsel" Melvyn M. Kassenoff, as well as Richard E. Vila. While Richard E. Vila has appeared in the proceedings, as a questioner in certain depositions, Melvyn M. Kassenoff had not previously appeared in the proceedings in any faculty. Thus, receipt of the Record filed by Wattanasin, which occurred on May 19, 1993, was the first opportunity undersigned Counsel had to be apprised of the fact that witness Melvyn Kassenoff would be undertaking an active, advocacy role in this proceeding.

On the following day, undersigned Counsel forwarded a letter via facsimile to Lead Counsel Furman objecting to reliance on witness Melvyn Kassenoff as Counsel, and specifically requesting, in writing, reassurance:

> That Mr. Kassenoff will have no participation in the preparation of the Brief, advice to yourself or other Counsel acting in this matter, appearance at, or suggestions with regard to Final Hearing, or any other participation in this matter.

It was further indicated that a Motion for Disqualification would be promptly filed if such written confirmation was not received. Relevant case citation was included in the letter.

On May 24, 1993, undersigned Counsel received a letter via facsimile from Lead Counsel Furman, refusing to provide the reassurances requested, and indicating reliance on 37 CFR §10.62(b)(2)-(4). A copy of that letter is enclosed herewith as Exhibit A.

6. On May 25, 1993, undersigned Counsel verified, by teleconference, that Wattanasin would oppose this Motion.

II. ARGUMENT

A. MELVYN KASSENOFF'S APPEARANCE AND PARTICIPATION AS COUNSEL VIOLATES 37 CFR §10.62(b) AND §10.63(a) AS WELL AS 37 CFR §10.110

The provisions of 37 CFR §10.62(b) are specific and unequivocal.

> A practitioner shall accept employment in a proceeding before the Office if the practitioner knows or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness....

The Rule provides for exceptions to this provision. Proof that the exceptions applies rests on the party trying to rely on those exceptions. Universal Athletic Sales Company v. American Gym, Recreational and Athletic Equipment Corporation, Inc., 192 USPQ 193, 198-199 (3rd Cir. 1976), cert. denied, 193 USPQ 570 (1977). It is unquestioned that Melvyn Kassenoff appeared as a witness. In view of his listing as "Of Counsel", and Counsel for Wattanasin's refusal to provide written assurances that he would not act in

support of Wattanasin in the Brief or at Final Hearing, Fujikawa is forced to conclude that he is also acting, actively, as Counsel for Wattanasin in this matter.

A brief inspection of the four possible exceptions clearly demonstrates that they do not apply in this case. The first exception provides that simultaneous employment and testimony may proceed

> If the testimony will relate solely to an uncontested matter.

This is clearly not applicable herein. Melvyn Kassenoff's testimony goes solely to the issue of abandonment, suppression or concealment. This is clearly a contested issue in the case. Moreover, the specifics of Melvyn Kassenoff's testimony, including the clauses quoted above, are highly contested, particularly with respect to the issue of "backlog" and the "intentions of Sandoz".

Simultaneous employment and testimony may also go forward

> If the testimony will relate solely to a matter of formality and there is no reason to

> believe that substantial evidence will be offered in opposition to the testimony.

Similarly, the testimony relates not to a matter of formality, but to a crucial issue in the case, abandonment, suppression or concealment. Moreover, Melvyn Kassenoff himself offered testimony in contradiction to his Declaration, on cross-examination, see, e.g., WR-253-257 with regard to the issue of "backlog". See also, WR-266-267 with regard to the issue of who was to be assigned responsibility for the application in question. See also the testimony of Giesser, WR-319-463. Clearly, exception 2 to Rule 10.62(b) is not applicable.

The third exception to the prohibition on simultaneous representation and testimony on behalf of a client applies only

> If the testimony will relate solely to the nature and value of legal serves rendered in the case by the practitioner or the practitioner's firm to the client.

This clearly does not characterize Melvyn Kassenoff's testimony in this matter. His testimony goes not only to value of his own

services, or the practitioner's firm, but to the practice of the firm in general, to the firm's activity with regard to other cases (and inventors other than Wattanasin) and the methods by which the real party-in-interest for Sandoz arrives at a decision to file a case. Clearly, exception 3 is not applicable.

Finally, the fourth exception is an omnibus exception, which provides that if the practitioner has distinctive value as Counsel in the particular case, simultaneous representation and testimony may be permitted. Quite clearly, that is not applicable herein. Counsel for Wattanasin has gotten along quite well without reliance on the activities of Melvyn Kassenoff. One can scan the over 140 filings in this case without ever seeing the name Melvyn Kassenoff as the attorney acting on behalf of Wattanasin. Quite simply, until receipt of the Record, attorney Melvyn Kassenoff's activity on behalf of Wattanasin was unknown to Fujikawa. This fact was made painfully clear by Fujikawa during cross-examination of Wattanasin, at which Melvyn Kassenoff was present, for undisclosed reasons. Specifically, at WR-97, Melvyn Kassenoff broke into the exchange to say

> Let me ask one question on redirect. Page 97, lines 9-10.

In response, as no question had been asked, no objection was advanced, but undersigned Counsel made it clear that activity by the witness on behalf of the party was improper. WR-97, lines 11-12. In response, Mr. Vila, appearing for Wattanasin, indicated that the question would be taken up later, WR-97, lines 13-14, and in fact, it was never taken up. If Melvyn Kassenoff's unique attributes were really so critical to the representation of Wattanasin that he be permitted to participate both as Counsel and as witness, it is absolutely clear that he would have appeared, in some capacity, in this proceeding, prior to filing of the Record. In point of fact, Melvyn Kassenoff was an emergency contact person, in Furman's absence, and as Lead Counsel Furman has never been absent from the proceedings, Melvyn Kassenoff's role was never triggered.

It should be noted that Melvyn Kassenoff may have acted, without notice or visible presence, by providing advice as Counsel to Wattanasin to Lead Counsel Furman. This is regrettable, but undersigned Counsel could not have earlier brought this Motion, as Melvyn Kassenoff's involvement was made overt only upon the filing of the Record by Wattanasin.

Even in the event Sandoz should argue that its actions do not constitute a violation of §10.62(b) and §10.63(a), it is absolutely

clear that the practice engaged in by Sandoz on behalf of Wattanasin, employing, as an attorney, a critical and contested witness in the case raises at least the appearance of professional impropriety. Such is precluded by 37 CFR §10.110. Clearly, if Sandoz determined at some point in the course of conduct of the Interference that it was necessary to have Melvyn Kassenoff testify, and Sandoz believed it could not secure other Counsel to represent Wattanasin's interests, it was incumbent on Sandoz to draw the attention of the EIC and Fujikawa to the fact that its witness was simultaneously engaging in the representation of Wattanasin, and establishing the grounds for exception to §10.62 and §10.63, in an open and fair manner, which would have permitted sufficient time to review the entire matter, rather than just prior to filing of the Brief. By failing to fully disclose and discuss this matter in a fashion that would avoid the appearance of professional impropriety, Sandoz has violated the restrictions of 37 CFR §10.110, and should appropriately be sanctioned.

B. DISQUALIFICATION IS AN APPROPRIATE REMEDY

37 CFR §10.62(b) and §10.63(a) parallels disciplinary rules of

the Code of Professional Responsibility, including DR5-101 and 102. The Code specifically provides that disqualification of Counsel acting as a witness, and the members of the witness' firm, in the case the patent and trademark department of Sandoz, is an appropriate remedy when the party elects to present the testimony of its Counsel without satisfying the exceptions to Rule 10.62(b). Accordingly, as an appropriate sanction, Fujikawa hereby requests disqualification of all members of the Sandoz patent department from further participation in this Interference. Specifically, Fujikawa requests that the EIC issue an order directing Sandoz not to further participate in this Interference, to secure outside representation, and act only to provide a complete copy of the file and Record, already conveniently prepared, to outside Counsel who will act further in this case without contact with or participation by Sandoz Counsel. Clearly, the Rule does not contemplate the simultaneous representation and testimony by Counsel for a party.

It is noted that Wattanasin's opening Brief is currently due June 15, 1993. Fujikawa appreciates the imposition on outside Counsel to grow familiar with the case solely from the Record and file an adequate Brief by the June 15, 1993 deadline. Nonetheless, this problem was of Wattanasin's own making, Wattanasin ought to pay the price. However, if this sanction is applied, Fujikawa

would be agreeable to an extension of time of up to two weeks in which to provide outside Counsel opportunity to grow familiar with the file.

Disqualification of all members of the Sandoz patent department from further representation on behalf of Wattanasin is accordingly requested.

C. IN THE ABSENCE OF DISQUALIFICATION, AN APPROPRIATE SANCTION WOULD BE TO PRECLUDE SANDOZ FROM RELYING ON THE TESTIMONY OF MELVYN KASSENOFF

Fujikawa notes that Wattanasin has provided abundant testimony from a plurality of witnesses in this case. Fujikawa also notes that as to the facts allegedly testified to by Melvyn Kassenoff, similar facts are established by reference to the Declaration of Giesser and Rothwell, and therefor, Melvyn Kassenoff's testimony as to those facts are redundant. Testimony as to opinion, thought processes and the like, should not be permitted. In the event the EIC finds the sanction of disqualification too severe under the circumstances, it is respectfully requested that Wattanasin be denied opportunity to rely on the testimony of Melvyn Kassenoff. This would permit Melvyn Kassenoff to fully act as Counsel on behalf of Wattanasin, without unduly prejudicing Wattanasin due to

the largely duplicative nature of the factual testimony provided, and at the same time avoid the impropriety and improper practice prohibited by the rules.

In the absence of disqualification, Wattanasin should be precluded from relying on the testimony of Melvyn Kassenoff to support its position in this Interference.

D. TO THE EXTENT WATTANASIN IS PERMITTED TO RELY ON THE TESTIMONY OF MELVYN KASSENOFF, IT SHOULD BE SEVERELY DISCOUNTED

It is recognized that there is precedent that suggests that notwithstanding the impropriety of an attorney acting on behalf of a client also offering testimony on that client's behalf, the testimony is not thereby rendered incompetent, and admission, per se, does not constitute reversible error. Universal Athletic Sales, Supra at 199. It is to be noted that this finding is largely due to the fact that the Code of Professional Responsibility does not have the force or effect of a statute, Universal at 198, FN 19. In contrast, Counsel for Wattanasin has violated the specific wording of a regulation, which in this case does have the force and impact of statute. Accordingly, it is believed that disqualification, or in the alternative, preclusion of reliance on the testimony of Melvyn Kassenoff by party

Wattanasin is required. Nonetheless, even if not required, it is believed that the case law clearly establishes that where not required by law, such tainted testimony should be severely discounted. Quoting from the Universal opinion at page 199:

> The Court noted that the relationship of such a witness to his client detrimentally effected the weight to be accorded his testimony and therefor "discounted" its value. Such an approach, which would appear to be equally applicable to attorneys who serve as experts for their clients, also reflects our view. We believe that, while a District Court may in limited circumstances receive the testimony of a lawyer-witness, the value of that testimony must be discounted because of the interest of the lawyer or his firm in the outcome of the litigation.

It should be noted that this discounting referred to in the decision may be so severe as to be cause to vacate a decision based on the testimony adduced. Universal at page 203.

There is abundant precedent for severely discounting the testimony of a witness who acts as Counsel for the client on whose behalf the testimony is introduced, largely acknowledging the fact that such discounting is the only remedy, as the disciplinary rules have no statutory effect. This was clearly expressed by the Court in Lau Ah Tew v. Dulles, 257 F.2d 744 (9th Cir. 1958), the Court observing:

> It is usually inappropriate for an attorney connected with the trial of a case to testify on behalf of his client. He should ordinarily withdraw before becoming a witness. (Cites omitted). It is true that the professional relationship of such a witness does not effect his competency. (Cite omitted). However, an attorney who assumes the burden of a witness while representing his client in a lawsuit does so at the very great detriment to the credibility of his testimony. (Numerous cites omitted). 257 F.2d at 747.

The Board of Patent Interferences, in Wilder v. Snyder, 201 USPQ 927 (POBI 1977) took cognizance of this rule of law in citing 97

CJS Witnesses Section 71, page 467. The Court's discussion appears at page 934 of the decision, wherein it is noted that the law directs that

> The professional relationship of the witness effects his credibility....

Disqualification was considered in the decision Little Caesar Enterprises, Inc. v. Dominos Pizza, Inc., 11 USPQ 2d 1233 (Comm. of Pats. 1989). Therein it was noted that the rules preclude conduct that would be prohibited by the disciplinary rules of the ABA Model Code of Professional Responsibility. Clearly, the conduct engaged in by Wattanasin is precluded, see the decision, at page 1235. This includes the situation where an attorney is or ought to be called to testify on behalf of his client. Thus, the Commissioner of Patents and Trademarks, having established that Wattanasin's practices here specifically violates the rules, sanction of the type requested and recognized by prior precedent is appropriate.

In the absence of disqualification or preclusion of reliance on Melvyn Kassenoff's testimony, Fujikawa submits that an appropriate sanction would be to severely discount Melvyn Kassenoff's testimony, as is required by prior precedent.

E. SUMMARY

It is beyond question that Wattanasin's offering of Melvyn Kassenoff's testimony, while simultaneously employing Melvyn Kassenoff as Counsel in this Interference, violates the explicit provisions of 37 CFR §10.62 and §10.63. The appropriate measure for such a violation would be disqualification. Time pressures may preclude the appropriate remedy from being applied herein. Accordingly, in the alternative, it would be appropriate simply to preclude Wattanasin from relying, in any fashion, on the testimony of Melvyn Kassenoff. Should the EIC find this sanction too severe, at a minimum, it is believed that the Rules, and prior case law, clearly directs that the testimony of Melvyn Kassenoff be strongly discounted, that testimony having been prejudiced and tainted by Melvyn Kassenoff's involvement and complicity in the preparation of Wattanasin's case.

Due to the impending date for filing the Brief, and the nature of the violation, it is respectfully requested that a conference call on this issue be conducted, to expedite matters. EIC Sofocleous is not in the office through May 28, 1993. Accordingly, on his return to the office, a conference call is respectfully

requested.

As noted above, Counsel for Wattanasin was contacted, and indicated that this Motion would be opposed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

ENCLOSURE: COPY OF MAY 24, 1993 LETTER
TO STEVEN B. KELBER FROM
DIANE FURMAN (EXHIBIT A)

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL MOTION FOR SANCTIONS, 37 CFR §1.616 and MAY 24, 1993 LETTER TO STEVEN B. KELBER FROM DIANE FURMAN (EXHIBIT A)**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FACSIMILE and FEDERAL EXPRESS, this 25TH day of MAY, 1993.

STEVEN B. KELBER

Interference 102,975

SANDOZ CORPORATION
59 ROUTE 10, EAST HANOVER NJ 07936

SANDOZ SBK

May 24, 1993

PATENT AND TRADEMARK DEPARTMENT

TELEFAX 201 503 8807

VIA TELEFAX
(703) 413-2220

Steven B. Kelber, Esq.
Oblon, Spivak, McClelland, Maier and Neustadt, P.C.
1755 S. Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Re: WATTANASIN v. FUJIKAWA et al.
Interference Nos. 102,648 and 102,975

Dear Steve:

I am in receipt of your telefax letter of May 20, 1993.

I. With regard to attorney Melvyn Kassenoff's of counsel status in these interferences, we believe his involvement falls squarely within the ambit of 37 CFR §10.62(b)(2)-(4), cf. 1045 OG 36.

First, as you have recognized, Mr. Kassenoff is a fact witness in these interferences, not an opinion witness. His testimony goes to the nature of his legal services rendered in connection with the involved Wattanasin application.

Second, given the distinctive nature of Mr. Kassenoff's expertise in the relevant technical area of HMG-CoA reductase inhibitors, as well as his status as a former Patent Examiner having extensive knowledge of Patent and Trademark Office procedures, it would work a substantial hardship on the Wattanasin real party of interest, i.e. Sandoz Corporation, if Mr. Kassenoff were to be prevented from providing technical or legal advice in this matter.

Indeed, practically speaking, the standard which you now evidently seek to impose on the party Wattanasin, would effectively deprive any corporation which is a party of interest in an interference, of the unique legal and technical skill of its own in-house patent staff simply because one or more of those same attorneys may almost necessarily be called as a fact witness concerning activities within the scope of their employment in connection with an involved application.

The fact is, since virtually "day one" of these interferences, you were on notice that Mr. Kassenoff is a designated deputy lead attorney for the party Wattanasin, with full power and authority to act in my absence (Int. No. 102,648, Wattanasin paper dated March 23, 1992).

Yet, for whatever reason, you failed to raise any issue in this regard when the Kassenoff Declaration of February 19, 1993 was served, and you even went ahead and took complete cross-examination by deposition from Mr. Kassenoff.

We will assume that you do not mean to impugn Mr. Kassenoff's probity, his conduct as an officer of the court, or his testimony under oath as a fact witness concerning his activities in connection with the involved Wattanasin application.

Accordingly, we simply find no inconsistency in Mr. Kassenoff's status as a fact witness and as an attorney of counsel for the party Wattanasin.

Since your position finds no support either in your own legal citations or in the Patent and Trademark Office Code of Ethics, or any legal authority of which we are aware, we must inform you that we cannot accede to your request that Mr. Kassenoff refrain from providing advice in respect of the above interferences.

II. With reference to the pentultimate paragraph of your letter, your attention is directed to pages 10-11 of the Wattanasin record, which comprise a "Cross-Reference Index of: Parties' Exhibits Marked for Identification at Cross-Examination Depositions with Documents of Record".

More specifically, Wattanasin Deposition Exhibit W-3 is cross-referenced to Wattanasin Exhibit B-2. As the Wattanasin deposition transcript, p. 69, makes clear, the deposition testimony refers to pages 164, 165 and 166 of Exhibit B-2, the pages of which are clearly marked at the upper right hand corner.

If you still insist upon copies of all of the exhibits of the relevant depositions, please let me know, and I will have them out to you as soon as possible.

III. A second copy of the Wattanasin record was mailed to you by first-class mail on Friday, May 21, 1993.

Very truly yours,

Diane Furman

Diane E. Furman

DEF:rmf

Paper No. 41

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Telephone: (703)557-4007
Facsimile: (703)557-8642

MAILED

JUN 1 1993

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Interference No. 102,975

Wattanasin et al.

v.

Fujikawa et al.

Receipt is acknowledged of the following papers, filed on May 26, 1993 by Fujikawa:

1. Motion to consolidate the record (Paper No. ~~90~~ 35).
2. Motion for sanctions under 37 CFR 1.616 (Paper No. ~~95~~ 40).

For the reasons stated therein, the unopposed motion to consolidate the record is granted subject to (1) Wattanasin et al. and Fujikawa et al. clearly identifying the party and interference to which the testimony is directed, (2) dividing the record, where possible, into separate volumes that will related to a single interference, (3) providing a separate index as required in 37 CFR 1.653(c) and (4) maintaining the testimony of the witnesses relating to the two interferences separate and distinct insofar as possible.

The motion (item 2) for sanctions will be considered after the expiration of the time for filing an opposition and reply thereto to the motion.

Michael Sofocleous
Examiner-in-Chief
(703) 557-4066

FORM PTO-78B
(Rev. 11-92)

#42

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

WATTANASIN

v. Interference Nos. 102,648, [redacted]

FUJIKAWA et al. Examiner-in-Chief: M. Sofocleous

FYI

COMMUNICATION

MAY 28 1993

RECEIVED IN
FOX INTERFERENCE

VIA EXPRESS MAIL

Honorable Commissioner of Patents and Trademarks
Washington, DC 20231

Attention: Mrs. Hall

I appreciated your telephoning me on Tuesday, May 25, 1993 concerning the Consolidated Record of the party Wattanasin in the above interferences.

I. In response to your telephone call, I am enclosing the following documents with this letter:

---

(1) Page 162 of the Wattanasin record: you indicated that this page was missing from bound Volume II; and

(2) Exhibit S-4: you indicated that while our extra two spiral-bound courtesy copies of the Wattanasin Exhibits did contain Exhibit S-4, a loose copy of Exhibit S-4 was missing.

(continued)

II. Other corrections which you have called my attention to are as follows:

-TABLE OF CONTENTS:

Index (3) (i.e. the Cross-reference Index) begins at page 10 (not page 9 as indicated);

-CROSS-REFERENCE INDEX, p. 10:

Exhibit W-1 is marked for identification at page 283 of the record (not page 83 as indicated);

Exhibit W-3 is marked for identification at page 104 of the record (not page 372 as indicated).

III. You have also requested a second set of the Wattanasin record (i.e. 15 volumes comprising 3 copies each of Vols. I-V) and exhibits.

It was not clear to me that Examiner-in-Chief Sofocleous had requested duplicate sets of the Wattanasin consolidated record and exhibits for the above interferences. Since I have limited remaining bound copies in my posession, I will

wait until I can speak with the EIC on his return to the office next week to confirm that he does want the additional copies.

Respectfully submitted,

Diane E. Furman
Attorney for Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
East Hanover, NJ 07936

DEF:rmf

May 28, 1993

Encls.: As noted
cc: S. Kelber (w. Record, p. 162, Exhibit S-4)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on May 28, 1993
(Date of Deposit)
Diane E. Furman
Name of Applicant, assignee, or Registered Representative
Signature
5/28/93
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

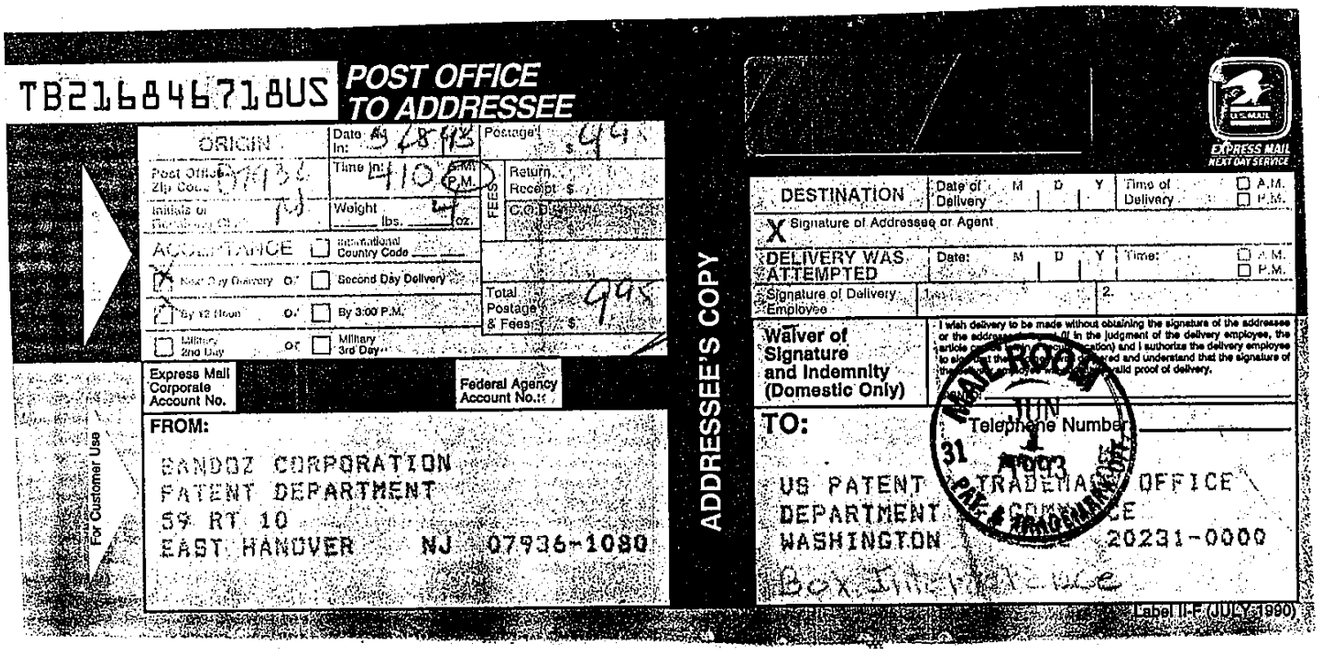
COMMUNICATION

and enclosures were served on counsel for the party Fujikawa et al., this 28th day of May 1993, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman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Signature of Delivery Employee
Waiver of Signature and Indemnity (Domestic Only)
TO:
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Label 11-F (JULY 1990)

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

#43

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,975
Examiner-in-Chief: M. Sofocleous

RECEIVED
JUN 4 - 1993
BOARD OF PATENT APPEALS AND INTERFERENCES

APPROVED
JUN 7 1993
By ..... Examiner-in-Chief

WATTANASIN REQUEST FOR EXTENSION OF TIME

The party Wattanasin hereby respectfully petitions for an extension of time of one month, from June 15, 1993 to July 15, 1993, for filing the two Wattanasin opening briefs in the above-numbered interferences, as well as a corresponding extension of the dates for taking subsequent action.

Steven Kelber, Esq., counsel for Fujikawa et al., who was consulted prior to the filing of this motion, has indicated that he will oppose any extension of time to Wattanasin, except on the following condition:

that the EIC agree to rule on Fujikawa's Motion for Sanctions of May 25, 1993 prior to the due date of the opening briefs, in which case Mr. Kelber would not oppose a 10-day extension beyond the date of the EIC's decision.

However, the party Wattanasin is simply herein requesting grant of a one-month extension of time to file the two opening briefs in the above interferences, and corresponding extensions of the subsequent due dates.

DISCUSSION

On May 25, 1993, undersigned counsel for Wattanasin was served with Fujikawa's motion for sanctions in the above interferences.

Given the severity of the sanctions demanded by counsel for Fujikawa -- including complete disqualification of the entire Sandoz in-house patent staff and retention of outside counsel on short notice and at significant expense, and, in particular, the discrediting of the testimony of Melvyn Kassenoff, Esq. -- this matter requires immediate and complete attention of the undersigned, who is also carrying a full workload otherwise.

The Wattanasin opposition paper is due June 14, 1993. The Wattanasin opening briefs are currently due June 15, 1993.

Clearly, one effect of the Fujikawa motion at this point in the interferences is to distract Wattanasin at a critical period during which the opening briefs are being prepared.

In point of fact, the apparent basis for the Fujikawa motion would seem to have existed for some months, ever since Mr. Kassenoff's affidavit was caused to be filed in February of 1993 in response to the Fujikawa notice concerning an issue of abandonment. Fujikawa have been on notice since the very beginning of these interferences that Mr. Kassenoff is a deputy lead counsel of record. Fujikawa even took cross-examination of Mr. Kassenoff in March of 1993 without raising the issue of his status as deputy lead counsel.

Now, evidently timed in a fashion to conflict with the preparation of the Wattanasin main briefs, Fujikawa have come forward with their motion for sanctions.

Wattanasin does not believe that the Fujikawa motion has any merit whatsoever, and will be filing an opposition in due course.

Prior extensions in this interference have been reasonably limited and generally confined to the logistics of testimony. At least one motion, unopposed by Wattanasin, was granted mainly for the convenience of Mr. Kelber, who now chooses, as counsel for Wattanasin sees it, to belatedly complicate the important period leading to the filing of the two main briefs.

It is submitted that the requested extension of time is justified, and its granting is respectfully requested.

Finally, it is suggested that a conference of the parties and the EIC on this matter may be worthwhile.

Accordingly, Wattanasin now moves to re-set the relevant dates of the above interferences as follows:

Wattanasin opening briefs due ..... July 15, 1993.
Fujikawa brief due ..... August 15, 1993.
Wattanasin reply brief due.....September 4, 1993.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
East Hanover, NJ 07936

DEF:rmf

June 4, 1993

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:

DIANE E. FURMAN
Type or print name of person signing certification

Diane Furman
Signature

6/4/93
Date

ACTIVITY REPORT

RECEPTION OK

TN #	6273
CONNECTION TEL	9
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START TIME	06/04 17:00
USAGE TIME	02' 59
PAGES	5

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN REQUEST FOR EXTENSION OF TIME

was served on counsel for the party Fujikawa et al., this 4th day of June 1993, by telefax addressed to the following:

(703) 413-2220
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

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

#48

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,975
Examiner-in-Chief: M. Sofocleous

MAILED

JUN 8 1993

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AND INTERFERENCES

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AND INTERFERENCES

APPROVED

JUN 7 1993

By .....
Examiner-in-Chief

WATTANASIN REQUEST FOR EXTENSION OF TIME

The party Wattanasin hereby respectfully petitions for an extension of time of one month, from June 15, 1993 to July 15, 1993, for filing the two Wattanasin opening briefs in the above-numbered interferences, as well as a corresponding extension of the dates for taking subsequent action.

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However, the party Wattanasin is simply herein requesting grant of a one-month extension of time to file the two opening briefs in the above interferences, and corresponding extensions of the subsequent due dates.

49-125-0 DIV

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

WATTANASIN	:	
	:	**INTERFERENCE NO.: 102,975**
V.	:	**EXAMINER-IN-CHIEF:**
FUJIKAWA ET AL	:	**MICHAEL SOFOCLEOUS**

FUJIKAWA REPLY TO THE WATTANASIN
OPPOSITION TO THE MOTION FOR SANCTIONS

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

SIR:

Apart from a brief and unsupported attempt to argue that the applicable Rules which serve as the predicate for the Fujikawa Motion for Sanctions, 37 CFR §10.62(b) and §10.63(a) does not apply to the instant situation, because the Patent and Trademark Department of Sandoz does not constitute a "firm" for the purpose of the Rules, Sandoz relies only on the exceptions to the general Rule of 37 CFR §10.62(b) for authorizing the simultaneous testimony by Kassenoff, and his participation as Counsel in this matter.

Neither the straw man argument that the Sandoz Patent and Trademark Department is not a firm, nor the argument with respect to the exceptions, is adequately supported by fact or law, and accordingly, the entry of sanctions is believed appropriate.

I. THE SANDOZ PATENT DEPARTMENT IS A "FIRM" FOR THE PURPOSES OF THE RULES

Without authority, or indeed without relevant facts, Sandoz urges that the Sandoz Patent and Trademark Department is not a firm, and thus, 37 CFR §10.62 and §10.63 do not apply to the Sandoz Patent and Trademark Department. Page 7 of the Opposition. The argument is nonsense, and Sandoz offers no legal support for its position. It would be an enormous elevation of form over substance if each and every corporate patent applicant could avoid the Rules of Conduct prescribed by and for the Patent Office simply by temporarily expanding its "legal department" to embrace all necessary attorneys, and thereafter return them to legal practice. Wattanasin offers neither precedent nor logic to support its view, and the same must be rejected.

II. TO THE EXTENT THE FOUR EXCEPTIONS APPLY, THE TESTIMONY MAY BE ADMITTED WITHOUT SANCTION

The four exceptions to 37 CFR §10.62(b) and §10.62(a) do not substantially apply to the testimony that is the basis for the Fujikawa Motion for Sanctions. Each of the exceptions is discussed, in turn, below. To the limited extent they do apply, that limited testimony may be admitted without sanctions.

(1) Exception one permits introduction of the testimony by an attorney acting on behalf of the party for whom it is introduced if the testimony relates solely to an uncontested matter. By Wattanasin's own admission, the testimony of Melvyn M. Kassenoff (Kassenoff) relates specifically to the issue of abandonment, suppression or concealment. This is very much a contested issue. See the Wattanasin Opposition, pages 3-4. Quite clearly, exception one is not applicable, and Wattanasin does not really argue to the contrary.

(2) Exception two pertains to testimony with respect to matters of formality. Wattanasin urges that certain of Mr. Kassenoff's testimony relates to essential formalities, establishing the existence of his handwriting in certain documents. See the Wattanasin Reply, page 8. Accordingly, Fujikawa hereby

indicates that if the Kassenoff testimony is otherwise acceptable to the EIC, it modifies its request for sanctions to the extent that the Kassenoff testimony at Wattanasin Record 230, lines 5-7, confirming the presence of Kassenoff's handwritten notations on Exhibit N, and WR-231, lines 8-11, again confirming the presence of Kassenoff's handwriting, may be admitted without sanction.

As Wattanasin does not suggest that any other part of the Kassenoff testimony qualifies under this exception, it need not be further discussed.

(3) Exception three goes to the nature and value of legal services rendered in the case. Wattanasin urges that all of Kassenoff's testimony qualifies under this exception. Fujikawa respectfully submits that this quite simply not the case. The only legal services rendered by Kassenoff in the case discussed in the Kassenoff Declaration appear at pages 229 and 230 of the Wattanasin Record. On page 229, Kassenoff indicates:

> It is my best recollection that in February of 1988, I was in communication with Dr. Wattanasin concerning information which was needed by the patent department in order to prepare an application based on PD 299/84.

Later on, on page 230, Kassenoff indicates:

> These notes further indicate that I spoke with Sompong Wattanasin ("S.W.") on February 12, 1988 concerning his quinoline compounds and requested that he provide me with certain information.

Although other portions of the Kassenoff Declaration refer to materials received by Mr. Kassenoff, and Mr. Kassenoff's activities and services in connection with <u>other</u> cases, nothing else relates to Kassenoff's activities involved in the case at bar. Accordingly, as this exception applies only to the portions quoted above, these portions may be included without censure or sanction, but the remaining should be suppressed or otherwise treated as requested in the Fujikawa Motion for Sanctions.

Beginning at page 9 of the Wattanasin Opposition, Wattanasin stresses that the Kassenoff testimony should fall within exception three because it would appear to fall within the exception carved out for a registered patent practitioner to testify concerning attorney diligence. This is fine, except that Kassenoff's

testimony was not presented for the purpose of establishing attorney diligence. Kassenoff's testimony was presented solely with respect to the issue of abandonment, suppression or concealment, not diligence. Indeed, if Kassenoff's testimony is relevant to, or presented with respect to the issue of diligence, it is untimely and improper, as it should have presented in connection with Wattanasin's case-in-chief. Thus, the Kassenoff testimony simply does not fit the exception Wattanasin seeks to rely on. The case citation to Wilder v. Snyder, 201 USPQ 927 (POBI 1977) seems clearly inappropriate, as therein Fujikawa cites the exact language on which it relies to advance the sanction that the Kassenoff testimony be discounted. Wattanasin having presented absolutely no testimony with regard to diligence, except perhaps that of attorney Geisser, who, no longer employed by Sandoz, does not fit the proscription of 37 CFR §10.63(a), the Kassenoff testimony is simply not applicable to the exception in question.

(4) Without proof of fact, or even offer of proof, Wattanasin goes on to argue that Kassenoff is so exceptional and uniquely valuable that prohibiting Kassenoff from working on the case would have worked a "substantial hardship on the client because of the distinctive value of the practitioner". While Wattanasin asserts this exception applies, Wattanasin identifies no expertise offered

by Kassenoff, nor any activity, save testifying on behalf of Wattanasin, that Kassenoff has been involved in that could not have been don by anybody within the Patent Department. Initially, the Wattanasin Opposition indicates that:

> Kassenoff's role as an attorney in these Interferences has been primarily as a consultant or "sounding board," providing occasional advice on procedural and scientific issues.

Moreover, Wattanasin urges that:

> Mr. Kassenoff has not been an active participant in these Interferences (particularly following his changed responsibilities as of January 1993, referred to above); rather, he has served as a consultant on an intermittent basis concerning technical or PTO procedural matters. Page 20 of the Wattanasin Opposition.

This is not the stuff of an indispensable individual. It is of significance that Wattanasin cannot point to a single piece of advice, consultation or instruction that Kassenoff has provided in this case, nor offers a single declaration in support of its position that Kassenoff has lent valuable expertise to the proceedings. Without such evidence, Mr. Kassenoff simply has not been established as an individual meeting the omnibus "expertise exception" of 37 CFR §10.62(b)(4). In particular, it is not clear what "scientific matters" Kassenoff was consulted with respect to, or what procedural issues remain that would require Kassenoff's comment. Indeed, procedural fencing is almost at an end, it is time for filing the Briefs. Quite simply, Wattanasin fails to establish even one activity contributed by Kassenoff since his presentation of testimony that could not have been effectively done by somebody else in the Sandoz Patent Department.

Sandoz repeatedly casts dispersions on undersigned Counsel, and Fujikawa, for attempting to "discredit" someone who has submitted to rigorous cross-examination. As the cases all uniformly confirm, it is not Fujikawa, or undersigned Counsel, but rather Kassenoff himself who has caused his discredit.

> The giving of material testimony by an attorney for his own client is generally considered to be a breach of professional ethics....

Weinsteins Evidence, Competency, Section 601[4] (1993 Supplement).

Waltzer v. Transidyne General Corporation, 697 F.2d 130, 134-135 (Sixth Cir. 1983).

Wattanasin's desire to have its cake (or Kassenoff) and eat it too, prescribes a diet far too rich in ethical violations to be tolerated. The sanctions requested by Fujikawa, in the alternative, should be imposed.

III. THE FUJIKAWA MOTION IS TIMELY AND SUPPORTED BY PRECEDENT

The Fujikawa Opposition provides a discussion of the case law, in which it relies on the Wilder decision discussed above, and the decision in Wick v. Zindler, 230 USPQ 241 (POBI 1984). Oddly, Fujikawa's presentation of extensive and relevant cases is brushed

aside as either dicta or limited to the specific facts presented. Oddly enough, Wilder is a case in which the entire discussion of ethics was in the part indicated by the Board to be dicta, and presented only in the interests of completeness. The only other case cited by Wattanasin, Wick v. Zindler, 230 USPQ 241 (POBI 1984) is necessarily further removed from the facts than those discussed in the Fujikawa Motion. Specifically, Zindler is confined to the situation wherein the attorney confirms that corroborating evidence was in fact received on a specific date. Clearly, even a barely credible witness can testify as to such matters. It would take a greater degree of credibility, one that cannot be granted to Kassenoff, to admit testimony on reasons why attorneys could not have done the work assigned in a timely fashion, something Kassenoff attempts to explain.

Page 18 of the Wattanasin Opposition is dedicated to the inventive argument that Fujikawa's Motion was belated. Wattanasin urges that having been advised that Kassenoff was considered "deputy counsel" for the Interferences, a term no where defined in the Rules, Fujikawa should have objected to Kassenoff's testimony. This is utter nonsense. Until Kassenoff's Declaration was received, Fujikawa had no reason to believe that anybody in the Sandoz Patent Department would testify in this matter. Indeed, the

Fujikawa Motion makes it clear that it proceeds principally under 37 CFR §10.63.

Once it was determined that Kassenoff should act as a witness, his activity as Counsel should have ended. See Waltzer, supra. Fujikawa has no objection to any of the activities undertaken by Kassenoff in connection with this Interference prior to his offering of testimony. It is his action subsequent that violate the Code of Ethics and specific regulations provided. Inasmuch as Kassenoff's activity was to be triggered in this Interference, according to the notice of "deputy counsel", only in the absence of lead counsel Furman, and lead counsel Furman has never been absent from these proceedings, it is hard to see how Fujikawa should have been apprised of Kassenoff's silent, secretive activities as Counsel, until the appearance of his name on the Record. It was Kassenoff, and the Sandoz Patent Department, as discussed below, that took deliberate measures to sustain this clear violation of the Rules, not belatedness on the part of Fujikawa.

IV. THE OPPOSITION CONCEDES, BY ITS SILENCE, A VIOLATION OF 37 CFR §10.110

The Fujikawa Motion makes it clear that Fujikawa's Motion

proceeds not only under 37 CFR §10.63, but 37 CFR §10.110 as well. This regulation, Canon 9, which precludes a practitioner engaging even in the appearance of professional impropriety is discussed beginning on page 11 of the Fujikawa Motion. Conspicuous, by its absence, in the Wattanasin Opposition is <u>any</u> discussion of the appearance of impropriety created by maintaining Kassenoff's activities as Counsel, without disclosing them to Fujikawa or the EIC, even <u>after</u> it became apparent that Kassenoff would have to testify in this matter. If Kassenoff was really indispensable, or otherwise critical to the maintenance of the Wattanasin interests in this Interference, or Wattanasin otherwise earnestly believed that the Kassenoff testimony fell within one or more of the exceptions to 37 CFR §10.62 and §10.63, the proper course for Wattanasin to follow would be to have advised the EIC and Fujikawa of the need to preserve Kassenoff as Counsel for Wattanasin and as a witness on behalf of Wattanasin, presented sufficient facts so as to establish the merits of the arguments, and proceed accordingly. Instead, with full knowledge of the Rules (Kassenoff is held out in the Wattanasin Opposition as having particular and detailed knowledge of the Rules), Wattanasin continued in a course of action which at least, on its face, and without the necessary supporting facts, is in violation of those Rules. At a minimum, this creates

the appearance of impropriety. As noted in the Fujikawa Motion, it is this appearance of impropriety, and the failure to advise the EIC and Fujikawa of the practice undertaken by Wattanasin and Kassenoff, that supports the requested sanction of disqualification. Fujikawa does not urge that Kassenoff is incompetent, alone, to testify, Federal Rules of Evidence 601. Rather, Fujikawa submits that in suppressing the obvious and clear issue raised by Kassenoff's simultaneous representation and testimony, Wattanasin frustrated the intent, spirit and letter of the Rules, and should be sanctioned on that ground.

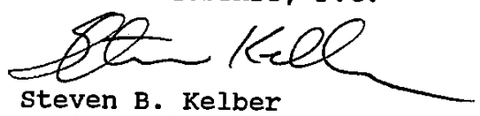
If Wattanasin had anything to say with respect to its appearance of impropriety, it certainly would have presented it in its Opposition. Having failed to do so, the conclusion that Wattanasin deliberately engaged in a course of conduct it knew, on its face, was impermissible, is driven home.

The Kassenoff testimony does not meet the exceptions one-four of Rule 10.62. Kassenoff, Wattanasin and the Patent Department at Sandoz has clearly engaged in activity that raises the appearance of impropriety, even if it could have been excused on a timely and complete explanation of the situation. On that basis alone, the sanctions requested by Fujikawa, in the alternative, should be

entered.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA REPLY TO THE WATTANASIN OPPOSITION TO THE MOTION FOR SANCTIONS**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FACSIMILE and FEDERAL EXPRESS, this 21ST day of JUNE, 1993.

STEVEN B. KELBER

Interference 102,648
Interference 102,975

Paper No. 46

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Telephone: (703)557-4007
Facsimile: (703)557-8642

Interference No. 102,975

Wattanasin et al.

v.

Fujikawa et al.

Receipt is acknowledged of the motion for sanctions under 37 CFR 1.616, filed on May 26, 1993 by Fujikawa (Paper No. 40).

Wattanasin filed an opposition captioned for both related Interference No. 102,648 and this interference. Since the opposition was physically placed in the related interference, another copy should be filed for this interference. See 37 CFR 1.4(b). A reply (Paper No. 45) to the opposition has been filed.

The motion requests that the following sanctions be entered against Wattanasin:

> 1. Disqualification of all members of the Sandoz Patent and Trademark Department from further participation in the interferences,
>
> 2. Precluding Sandoz from relying on the testimony of Mr. Melvyn Kassenoff, or
>
> 3. To the extent that Sandoz is permitted to rely upon Mr. Kassenoff's testimony, the testimony should be severely discounted.

The motion urges that sanctions are in order against the party Wattanasin for "deliberate and knowing violation of 37 CFR § 10.62(b) and § 10.63(a)." According to the motion, Wattanasin introduced and

relied on the testimony of Mr. Kassenoff, a "crucial witness" with respect to the issues of abandonment, suppression and concealment, while at the same time listing him as "Of Counsel" on the record and refusing to exclude him from participation in the preparation of the Wattanasin's brief and reply brief and for final hearing. Also the motion urges that to the extent that Mr. Kassenoff acted as a counsel in an advisory capacity, this action further aggravates the violations of § 10.62.

The opposition indicates that Mr. Kassenoff has been a member of the Sandoz Patent and Trademark Department for about 20 years and that his testimony became necessary in this case because Fujikawa filed a notice (Paper No. 69) under 37 CFR 1.632 raising the issue of suppression and concealment. Based on the filing of the notice, the party Wattanasin successfully moved to reopen its testimony period for purposes of introducing evidence to rebut any inference of suppression or concealment. See the order of February 5, 1993 (Paper No. 77), reopening testimony. According to the opposition, Mr. Kassenoff had relevant testimony which goes to the period between the last documented laboratory work and the filing of the Wattanasin application.

Insofar as the motion requests that disqualification of all members of the Sandoz Patent and Trademark Department from further participation in the interferences, the motion is denied. The movant acknowledges on page 4 of his reply (Paper No. 101) that some of the

testimony taken by Mr. Kassenoff falls within the exception of § 10.62(b)(3), i.e., Mr. Kassenoff testified as to the nature of the legal services rendered by him. Under these circumstances, the requested disqualification of the entire Sandoz legal department is not considered an appropriate, where one attorney of the department testifies as a witness in an interference within the exception of § 10.62(b)(3).

Insofar as the motion requests that Sandoz be precluded from relying on the testimony of Mr. Melvyn Kassenoff, the motion is denied. Since the movant acknowledges on page 4 of his reply (Paper No. 101) that some of the testimony taken by Mr. Kassenoff falls within the exception of § 10.62(b)(3), it would not be appropriate to preclude Sandoz from relying upon the testimony in question.

Insofar as the motion requests that the testimony of Mr. Kassenoff be "severely discounted", presumably be given little or no weight, consideration of the motion is deferred to final hearing provided that Fujikawa raises the matter in his brief. Matters not raised in the brief are ordinarily regarded as abandoned. Photis v. Lunkenheimer, 225 USPQ 948 (Bd.Pat.Int. 1984).

The times remain as set in Paper No. 44.

Michael Sofocleous
Examiner-in-Chief
(703) 557-4066

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

#47

WATTANASIN

v.

FUJIKAWA et al.

Interference Nos. 102,648, 102,945

Examiner-in-Chief: M. Sofocleous

WATTANASIN OPPOSITION TO FUJIKAWA MOTION FOR SANCTIONS

STATUS

By motion of May 25, 1993 in the above-identified interferences, the party Fujikawa et al. have requested sanctions against the party Wattanasin for alleged violation of Sections 10.62(b) and 10.63(a) of 37 CFR.

The purported violation concerns Wattanasin's introduction of and reliance on testimony of Melvyn M. Kassenoff, Esq., a patent attorney on the staff of the Sandoz Corporation Patent and Trademark Department[1], going to the issue of abandonment, suppression or concealment, while he is at least apparently participating in the interferences as "deputy lead counsel".

The sanctions demanded by Fujikawa are as follows (in the alternative):

1. Disqualification of all members of the Sandoz Patent and Trademark Department from further participation in the interferences;

2. Striking the testimony of Kassenoff;

3. "Severely discounting" the testimony of Kassenoff.

---

1. Melvyn M. Kassenoff has been employed in the Sandoz Patent and Trademark Department for about 20 years.

Wattanasin now opposes the Fujikawa motion. It is respectfully submitted that the Fujikawa motion is completely devoid of support in fact or law; and that furthermore, that it is belated, having been raised over three months after the Kassenoff testimony was made of record, and over one year after Mr. Kassenoff's designation as a counsel in these interferences.

Accordingly, Wattanasin requests that the Fujikawa motion, and each and every sanction requested therein, be denied.

STATEMENT OF FACTS

1. When these interferences first went forward, management at Sandoz Pharmaceuticals Corporaton, the assignee of interest of the party Wattanasin, made a decision to rely for representation on the Sandoz in-house patent staff (consistent with the usual practice of Sandoz in patent interferences).

2. Effective March 23, 1992, the undersigned, Diane E. Furman, an attorney in the Sandoz Corporation Patent and Trademark Department, was designated the lead attorney of record for the interferences. Melvyn M. Kassenoff, Esq., also with Sandoz, was designated deputy lead counsel, with full power and authority to

act in the absence of the lead attorney.[1] (see Exhibit A)

3. The designation of Kassenoff was made in recognition of the fact that he has substantial experience, unique to the Sandoz Patent and Trademark Department, in the subject matter area of these interferences, i.e. HMG-CoA reductase inhibitor compounds. Melvyn Kassenoff is also regarded as the Sandoz Patent and Trademark Department's foremost expert on PTO rules and regulations, and had more experience in interference procedure under the new rules than any other member of the department.[2]

4. Kassenoff's role as an attorney in these interferences has been primarily as a consultant or "sounding board," providing occasional advice on procedural and scientific issues.

5. Kassenoff did not provide any testimony in these interferences as to priority.

6. It was only when Fujikawa raised the issue of abandonment, supression or concealment, that it became apparent that Mr.

---

1. Melvyn M. Kassenoff is also listed as an attorney of record on the involved Wattanasin application. Another Sandoz patent attorney of record on the application, Richard E. Vila, Esq., became active in the interference at the deposition stage.

2. It is noted that Mr. Kassenoff is the only member of the Sandoz staff who is a former patent examiner, and also is distinguished by having an advanced degree (M.S.) in chemistry.

Kassenoff had relevant testimony which needed to be taken in order for Wattanasin to present a complete defense. More specifically, Kassenoff's testimony goes to the period between the last documented laboratory work in connection with the Wattanasin invention and the filing of the involved Wattanasin application. Although Mr. Kassenoff himself did not draft the Wattanasin involved application, his testimony of record shows that he participated in information gathering for the application, and that he was familiar with Sandoz patent policies and procedures as they applied to filing the Wattanasin case[3].

7. Wattanasin filed the Kassenoff declaration in February of 1993 (Exhibit B). At that time, not one word was heard from Mr. Kelber as to any impropriety in Mr. Kassenoff's concurrent designation as deputy lead counsel or in his continuation in such capacity.

8. In fact, in March of 1993, virtually one year to the day from Mr. Kassenoff's designation as deputy lead counsel of record, Steven B. Kelber, counsel for Fujikawa, came to the Sandoz Patent

---

3. Until January 1, 1993, when Mr. Kassenoff became supervisor of Patents Group II, one of two patent groups comprising the Sandoz Patent and Trademark Department, he reported to Mr. Vila, (who is supervisor of Patents Group I), and had no formal supervisory responsibilities. However, since about 1982, Mr. Kassenoff had certain de facto responsibilities in relation to HMG-CoA reductase matters, including assisting of junior department members working in the area, i.e. Joanne M. Giesser, Esq. (now departed from Sandoz), who drafted the involved Wattanasin application, and the undersigned lead counsel.

and Trademark Department in East Hanover, New Jersey, and subjected Mr. Kassenoff to rigorous cross-examination by deposition (see Kassenoff cross-examination transcript at pages 233-318 of the Wattanasin Record), without ever raising the question of impropriety as to Mr. Kassenoff's continuing status as deputy lead counsel.[4]

9. Subsequently, the Wattanasin Record was filed and served. The Record cover pages (Exhibit C) bear a designation of Mr. Kassenoff and Richard E. Vila, Esq. as being "of counsel".[5] No change was made in the status of Mr. Kassenoff as deputy lead counsel.

10. Thereafter, a letter was received by the undersigned from Mr. Kelber (Exhibit D) identifying Mr. Kassenoff as a "critical fact witness" for Wattanasin and objecting to his participation as an attorney for Wattanasin.

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4. During the cross-examination session at Sandoz, Mr. Kassenoff refrained from taking any testimony since he was a witness at the session, but the subject of his continued participation as deputy lead counsel was never questioned or discussed, let alone protested, by Mr. Kelber.

5. It should be noted that it has been the practice in the Sandoz Patent and Trademark Department, at least in cases before the Court of Appeals for the Federal Circuit, that the briefs and record would designate as of counsel, one or more of the immediate supervisors of the principal attorney of record, and/or to indicate that the named individuals had background or consultant status in connection with the case. This practice was followed in the current interferences.

11. On May 25, 1993, Fujikawa filed their motion for sanctions, which Wattanasin now opposes.

STATEMENT OF THE ISSUES

The critical issue is whether Melvyn M. Kassenoff's testimony for Wattanasin violates any known legal requirement, or even presents an appearance of impropriety, or needs to be discounted, in view of his status as deputy lead counsel (or "of counsel") in this matter.

APPLICABLE LAW AND ARGUMENTS

As a first matter, there is nothing in the Federal Rules of Evidence, which govern these interferences, which prevents an attorney from testifying on behalf of his client.

The most pertinent regulations bearing on the circumstances under which an attorney may serve as a witness for his client are located at 37 CFR §§10.62(b) and 10.63(a) (both effective 1985) (Exhibit E). These sections essentially track the language of the American Bar Association Code of Professional Responsibility, Disciplinary Rules (DR) 5-101(B) and 5-102(A), respectively.

1. 37 CFR §10.62, 10.63

(i) 37 CFR §10.62(b) indicates that prospective employment should be refused by a practitioner or another practitioner in his firm when the practitioner or his associate "ought to be" called as a witness for the client in the matter.

(ii) 37 CFR §10.63(a) likewise indicates that a practitioner who has already undertaken employment should withdraw if it becomes apparent that the practitioner or another in his firm "ought to" testify on behalf of the client.[6]

Of course, by their strict wording, both rules are directed to situations involving "firms," a term which is left undefined in the definitions section of Part 10 of 37 CFR. In conventional usage, however, the term "firm," would not even apply to an in-house corporate patent department.

However, assuming arguendo that Rules 10.62(b) and 10.63(a) would apply to in-house counsel, both rules are subject to four defined areas where an attorney's testimony for his client need not require him to withdraw from representation:

(1) If the testimony will relate solely to an uncontested matter.

6. 37 CFR §10.63(b) is directed to a case where the testimony is "other than" on behalf of the client, and is therefore inapplicable to the present situation.

(2) If the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to the testimony.

(3) If the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client.

(4) As to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the practitioner or the practitioner's firm as counsel in the particular case.

Sub-paragraph (1)

Sub-paragraph (1) above may or may not apply to the present situation. However, it is respectfully submitted that the Kassenoff testimony certainly falls within any one or more of sub-paragraphs (2), (3) and (4).

Sub-paragraph (2)

Concerning sub-paragraph (2), Mr. Kassenoff's testimony in part clearly relates essential to formalities, e.g., the existence of his handwriting in certain documents of record [e.g., see pages 4-5 of the Kassenoff Declaration (WR at 230-231)].

Sub-paragraph (3)

Furthermore, Mr. Kassenoff's testimony should be entirely permitted under sub-paragraph (3), which goes to the nature and value of legal services. For example, he provided testimony concerning his involvement as a member of the Sandoz Patent and

Trademark Department in the activities leading to filing of the Wattanasin application, and policy and practices applied to the filing of the Wattanasin application, as well as examples of cases which he drafted in the HMG-CoA reductase area [e.g., see pages 1-5 of the Kassenoff Declaration (WR at 227-231)].

Indeed, if there were any doubt that the Kassenoff testimony falls squarely within the purview of at least sub-paragraph (3), the underlying PTO commentary makes this crystal clear:

> "One comment suggested that proposed §10.62 should specifically authorize a registered patent practitioner to testify concerning attorney diligence in patent cases. This suggestion is not to be adopted. However, it should be clear that in most cases, the exception of proposed §10.62 (b)(3) would apply.***[citation to Wilder v. Snyder, 201 USPQ 927 (Bd. Pat. Inter. 1977]
>
> [emphasis supplied] 1045 OG 36[7] (see Exhibit F)

Thus, while the PTO drafters did not incorporate into Rule 10.62(b) the above proposed language relating to admissible attorney testimony as to diligence -- probably in the desire to adhere strictly to language paralleling the sister ABA disciplinary rules, DR 5-101(B) and 5-102(A) -- the commentary

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7. Conspicuously absent from the Fujikawa motion is any reference to this PTO commentary, to which Fujikawa were expressly directed by Wattanasin in the undersigned's letter included as Exhibit A to the Fujikawa motion.

does clarify that the present circumstances should fall within the sub-paragraph (3) exception.

The commentary goes on to state that "the weight to be given testimony by a practitioner on behalf of his or her client would be determined on a case-by-case basis" -- which, of course, the Board is free to do with respect to any testimony.

In short, there is nothing in Mr. Kassenoff's testimony, required by Fujikawa's raising of the abandonment issue, which does not legitimately come within exception (3), above.

Sub-paragraph (4)

With respect to sub-paragraph (4), the "hardship exception," it is a given that disqualification of Mr. Kassenoff from this matter would work a substantial hardship on the party Wattanasin. As indicated above, Mr. Kassenoff not only has distinctive knowledge of the HMG-CoA reductase inhibitor area, but also considerable and valued expertise concerning PTO interference procedure. In particular, Mr. Kassenoff has been engaged in the drafting and prosecution of HMG-CoA cases, and building of a patent estate in this subject matter area, since about 1982. Mr. Kassenoff has been a primary liaison with Sandoz management concerning both Sandoz and third-party coverage in the HMG-CoA reductase area. Disqualification of Mr. Kassenoff as a counsel in these interferences would unfairly deprive Sandoz of Mr. Kassenoff's wide technical and patent knowledge gained from substantial experience in the HMG-CoA area. Furthermore, Mr. Kassenoff, as a member of the Sandoz Patent Committee, also has

intimate knowledge of the procedure and practices of the Committee in the rating of patent disclosures.

Accordingly, it is believed that the present facts amply justify application of subparagraph (4) permitting attorney testimony in hardship cases.

2. Caselaw

There appears to be no decisional law under the 1985-enacted 37 CFR 10.62 or 10.63, save for the Domino[8] case referred to by Fujikawa, where, in fact, the Commissioner was concerned with Rule 10.63(b) which is not at issue here, and in any event, denied a motion for disqualification.

This points up a fundamental problem with the legal authority relied on by Fujikawa in their brief: in the context of a highly fact-dependent inquiry such as one directed to attorney impropriety and sanctions, Fujikawa are casting about for support in various judicial dicta and broad-brush restatements of the law -- in complete disregard, however, of the underlying facts which distinguish their cited caselaw from the instant situation.[9]

8. Little Caesar Enterprises Inc. v. Domino's Pizza Inc., 11 USPQ2d 1233 (Comm. 1989).

9. Fujikawa certainly cast wide for the broad dicta appearing in Lau Ah Tew v. Dulles, 257 F.2d 744 (9th. Cir. 1958), a naturalization case where the attorney's testimony in question concerned his ability to recognize the identity of his client, a petitioner for naturalization.

For example, the 1977 Wilder case (Exhibit G) mentioned in the PTO commentary on Rule 10.62(b) and also cited by Fujikawa, involved an interference situation where the Board, in fact, found "no reason not to accord weight" to testimony given by an attorney for the senior party.

Universal Athletic Sales Co. v. American Gym, Rec. & Ath. Equip. Corp., 192 USPQ 193 (3d Cir. 1976), cert. den. 193 USPQ 570 (1977) (Exhibit H), relied on extensively by Fujikawa, is concerned with a situation where an attorney in the law firm representing the infringement defendant testified as a purported expert as to the invalidity of plaintiff's patent at issue. The Third Circuit vacated the district judge's finding of patent invalidity on the ground that the arguable deficiency of the witness as an expert and his role as an attorney should have prevented his testimony from being given controlling weight to rebut the presumption of validity of an issued patent.

Therefore, the Universal case, notwithstanding its broad-brush restatements of the law amounting to dicta, is limited on its facts to a situation involving expert testimony by a law firm attorney -- which is recognized to be severely deficient to begin with -- being given controlling weight in overcoming the presumption of validity attaching to an issued U.S. patent. The Third Circuit ruling overturning the trial judge's unpatentability finding had to be colored by the obvious deficiencies of the witness's purported expert testimony.

By contrast, Mr. Kassenoff is an in-house counsel being relied on as a fact witness, as even Fujikawa acknowledge. Mr. Kassenoff is not being offered as an expert witness. Nor is Mr. Kassenoff testifying as to the validity of an issued patent. In sum, it is difficult to find any substantive influence that the Universal case on its facts could have as to these interferences.

In very illustration of this point, the court in the succeeding interference case of Wilder, while paying "lip service" to the broad pronouncements in Universal and similar language in 97 C.J.S. Witnesses §71, in fact, chose to admit into evidence the attorney testimony at issue in Wilder.

Even more instructive in an interference setting is a case overlooked by Fujikawa: Wick v. Zindler, 230 USDPQ 241 (Bd. Pat. Inter. 1984) (Exhibit I). In that case, the attorney, Holtz, who prepared the involved application of the senior party, also served as a designated co-counsel in the interference. Holtz's testimony was needed to corroborate the senior party's date of conception.

The junior party moved to exclude the Holtz testimony. In deciding the motion, the Board first referred to the Wilder case for authority that an attorney is competent to serve as a witness for or against his client. In dictum, the Board also recited that this testimony could be discounted. However, in fact, the Board went on to consider the testimony:

> Nevertheless, under the circumstances of this case where Holtz has identified certain documents that the inventor used to explain the invention during conferences with him, we believe that his testimony as to when the conferences occurred and that the invention was then explained and understood by him is entitled to sufficient weight to corroborate conception. We note that Holtz supported his tesitimony with documentary evidence in the form of calendar entries... and entries in his law firm's log of invention disclosures ... [emphasis supplied]

230 USPQ at 246

Finally, reference is made to the case of SMI Industries Canada Ltd. v. Caelter Industries, Inc., 223 USPQ 742 (NDNY 1984) (Exhibit J), which involved an action for patent and trademark infringement, and unfair competition. Denying plaintiff's motion to disqualify defendant's law firm under DR 5-102(A) of the ABA Code of Professional Responsibility, the parallel section to 37 CFR 10.63(a), the court stated that the resulting loss of services would create precisely the kind of hardship which is protected against by sub-paragraph (4) of DR 5-101(B) [analogous to 37 CFR 10.62(b)(4)]:

> Even assuming, arguendo, that members of the Limbach firm ought to be called as witnesses at trial, the court concludes that disqualification is not appropriate in this case. As noted previously, DR 5-101(B)(4) provides that an attorney may continue representation of his client in a proceeding in which the attorney is called upon to testify if disqualification would work a special and unwarranted hardship on the client by virtue of the distinctive value of the lawyer or his firm as counsel in the case.

> In the present case, George Limbach has represented the related predecessor coporation of defendant in patent and trademark matters since 1967, and the Limbach firm has represented defendant and its related companies since early in 1968. The attorney-client relationship has become intimate, and the firm has acquired specialized knowledge of defendant, defendant's related companies, and their operations. The Limbach firm's representation of defendant in the present action involves a complex set of legal and factual issues which the firm has been familiar with for many years. At this late juncture it would work a substantial hardship upon the defendant to require it to retain new counsel. Moreover, there is no basis for concluding that the continued representation by the Limbach firm will prejudice the plaintiff in this proceeding in any way or taint the underlying trial. Accordingly, plaintiff's motion to disqualify pursuant to Canon 5 is denied. [emphasis supplied]

223 USPQ at 748.

It is believed that the disqualification of Kassenoff or any other in-house Sandoz attorney would present no less hardship on the party Wattanasin than is described in the above SMI decision concerning the Limbach disqualification.

Counsel for Wattanasin can understand that there would be legitimate concern to separate the role of an attorney as a witness from the role of an advocate at trial before a jury. Avoiding prejudice before the jury is a guiding consideration in many disqualification cases. However, even in these cases, the courts have often simply prevented the attorney giving testimony from appearing in court before the jury as trial counsel for his client.

Of course, the present case does not involve a jury trial, but a proceeding conducted before a panel of Examiners-in-Chief. Surely the concern to avoid prejudice that informs the ABA's restraints against attorney testimony in jury trials, would not obtain in a patent interference proceeding.

Particularly in a case where an attorney is testifying on behalf of his client, there is a harsh injustice to the client to force him to choose between the attorney's legal knowledge and the attorney's often critical knowledge as fact witness. The hardship is even greater when an attorney is forced to abandon his legal role in mid-stream in order to have his testimony received into the record.

In particular, the policy which Fujikawa now seeks to apply against Wattanasin is manifestly unfair: If the EIC were to approve the Fujikawa motion, this would mean that any corporation which is a party of interest in an interference, would effectively be deprived of the unique legal and technical skill of its own in-house patent staff simply because one or more of those same attorneys may almost necessarily be called as a fact witness concerning activities within the scope of their employment in connection with an involved application.

In summary, the express terms of 37 CFR §10.62(b) and §10.63(a), and the weight of decisional authority as well as

policy considerations, are squarely against disqualification of the Sandoz Patent and Trademark Department, or Mr. Kassenoff individually, from the present interferences. Similarly, it is submitted that under the present circumstances, there is absolutely no reason or justification for discrediting the Kassenoff testimony.

Given the improbability under all relevant legal authorities of his obtaining disqualification of the Sandoz Patent and Trademark Department or of Mr. Kassenoff alone, what Mr. Kelber is transparently really after is "discounting" or "discrediting" of the Kassenoff testimony.

Why Mr. Kassenoff's testimony should be "discounted" as opposed to that of any other witness is not entirely clear. Like the other deposed Wattanasin witnesses, Mr. Kassenoff was subjected to rigorous cross-examination by Mr. Kelber. Even more so than the other, non-attorney witnesses, Mr. Kassenoff would have been conscious of his obligation, as member of the bar and an officer of the court, to uphold his oath. Likewise, Mr. Kassenoff would have been aware of the severe toll on his professional status that could attend violation of his oath. Mr. Kassenoff furthermore being an acknowledged fact witness, there is no good reason to discredit his testimony, and none is really offered by Fujikawa.

FUJIKAWA BELATEDNESS

For whatever reason, Fujikawa have until now -- over three months after the Kassenoff testimony was presented and over a year after Mr. Kassenoff's designation as a deputy counsel of record -- failed to raise any issue of disqualification or "discounting" of testimony, and even have taken cross-examination from Mr. Kassenoff without raising the issue.

In short, Fujikawa are raising an issue long after it should have been raised. To all appearances, Fujikawa saved their motion for a time when opposition to it would have been due one day before Wattanasin's main briefs.

It has to be concluded that the probable cause for the Fujikawa motion for sanctions is that counsel for Fujikawa happened to elicit from Mr. Kassenoff on cross-examination, information going to Sandoz Patent and Trademark Department procedure and the like, which could not be favorable to Fujikawa. Grasping for a rationale to eliminate or discredit this testimony, Fujikawa counsel have fabricated a strategy based on allegations of attorney impropriety. Such belated action and conduct should not be permitted.

CONCLUSION

Accordingly, the Fujikawa motion for sanctions should be denied on the basis of any one or more of the following reasons:

1. The testimony of Melvyn M. Kasssenoff for the party Wattanasin falls within the protected activity of 37 § 10.62(b)(2) and (3), because it constitutes testimony going to formalities and the factual circumstances of his activities in relation to the Wattanasin invention;

2. The testimony of Melvyn M. Kassenoff also falls within 37 CFR 10.62(b)(4), because otherwise the party Wattanasin would be deprived of Kassenoff's in-house technical and patent law expertise, which would work a serious hardhip;

3. The Fujikawa motion is belated, as it could have been filed much earlier. The suggestion by Mr. Kelber that he only became aware of the situation upon filing of the Wattanasin Record is without merit. Mr. Kassenoff has been listed as deputy lead attorney from the beginning of this matter.

4. None of the sanctions sought by Fujikawa is justified, and in fact would only serve to give Fujikawa undeserved advantage to the extent the Kassenoff testimony was discounted. Counsel for Fujikawa caused this testimony to be taken, and subjected Mr. Kassenoff to cross-examination under oath. Counsel for Fujikawa

should face the testimony rather than have the PTO discount it in advance for no justifiable reason.

Finally, Mr. Kassenoff has not been an active participant in these interferences (particularly following his changed responsibilities as of January 1993, referred to above); rather, he has served as a consultant on an intermittent basis concerning technical or PTO procedural matters. Wattanasin would be willing to remove Mr. Kassenoff as deputy lead counsel, but cannot without hardship meet Fujikawa's demands, which would deny the undersigned any right to consult with Melvyn Kassenoff concerning these interferences.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
East Hanover, NJ 07936

June 14, 1993

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on June 14, 1993
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
June 14, 1993
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN OPPOSITION
TO FUJIKAWA MOTION FOR SANCTIONS

was served on counsel for the party Fujikawa et al., this 14th day of June 1993, by first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

INTRF

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

WATTANASIN

v. Interference No. 102,975

FUJIKAWA et al. Examiner-in-Chief: M. Sofocleous

COMMUNICATION

At the direction of the Examiner-In-Chief in Paper No. 46 of the above-numbered interference, a duplicate copy of the Wattanasin Opposition filed as Paper No. 100 in related Interference No. 102,648, is being provided herewith for the file of this interference.

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

June 29, 1993

Encl.: As noted

DEF:rmf

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on June 29, 1993
(Date of Deposit)
Diane E. Furman
Name of Applicant, assignee, or Registered Representative
Diane Furman
Signature
6/29/93
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

COMMUNICATION

and the enclosure thereto were served on counsel for the party Fujikawa et al., this 29th day of June, 1993, by postage prepaid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt P.C.
Attn.: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

#48

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

FYI

JUL 19 1993

RECEIVED IN
BOX INTERFERENCE

WATTANASIN

v. Interference No. 102,975

FUJIKAWA et al. Examiner-in-Chief: M. Sofocleous

APPROVED

JUL 22 1993

By ..... Examiner-in-Chief

MOTION FOR EXTENSION OF TIME

Petition is made for an extension of time of one day from July 15 to July 16, 1993, to file the Wattanasin Opening Brief in the above interference, since binding cannot otherwise be performed in time.

A telephone conference call was held today with EIC Sofocleous and opposing counsel, Steven B. Kelber, at which the requested extension of time was indicated to be acceptable to the EIC and opposing party [The Wattanasin Opening Brief (without binding) is today being served on counsel Kelber, as agreed.]

Respectfully submitted,

Diane Furman

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

July 15, 1993

Encl.: As noted

DEF:rmf

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on July 15, 1993
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
July 15, 1993
Date of Signature

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

MOTION FOR EXTENSION OF TIME

was served on counsel for the party Fujikawa et al., this 15th day of July, 1993, by postage prepaid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt P.C.
Attn.: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

#48

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

JUL 19 1993

RECEIVED IN
BOX INTERFERENCE

WATTANASIN

v. Interference No. 102,975

FUJIKAWA et al. Examiner-in-Chief: M. Sofocleous

APPROVED

JUL 22 1993

By .....
Examiner-in-Chief

MOTION FOR EXTENSION OF TIME

Petition is made for an extension of time of [illegible] from July 15 to July 16, 1993, to file the Wattanasin Opening Brief in the above interference, since binding cannot otherwise be performed in time.

A telephone conference call was held today with EIC Sofocleous and opposing counsel, Steven B. Kelber, at which the requested extension of time was indicated to be acceptable to the EIC and opposing party [The Wattanasin Opening Brief (without binding) is today being served on counsel Kelber, as agreed.]

Respectfully submitted,

MAILED

JUL 22 1993

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Diane Furman
Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

SANDOZ CORPORATION
59 Route 10
E. Hanover, NJ 07936

July 15, 1993

Encl.: As noted

DEF:rmf

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on July 15, 1993
(Date of Deposit)
Diane E. Furman
Name of applicant, assignee, or Registered Representative
Diane Furman
Signature
July 15, 1993
Date of Signature

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Papers # 50 to # 54

#55

49-125-0 DIV

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,975
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

**FUJIKAWA ET AL'S
SUBMISSION OF ERRATA SHEET FOR
BRIEF AT FINAL HEARING
AND
OPPOSITION TO WATTANASIN'S PROPOSED
FINDINGS OF FACT, 37 CFR §1.656(g)**

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

SIR:

Fujikawa et al submits errata sheets for the Brief at Final Hearing and Opposition to Wattanasin's Proposed Findings of Fact, 37 CFR §1.656(g) filed at the Board of Patent Appeals and Interferences on August 16, 1993 in the above-captioned Interference. The corrections are all of a typographical nature. Fujikawa regrets any inconvenience these errors may have caused the Board and Counsel for the Party Wattanasin.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL'S SUBMISSION OF ERRATA SHEET FOR BRIEF AT FINAL HEARING AND OPPOSITION TO WATTANASIN'S PROPOSED FINDINGS OF FACT, 37 CFR §1.656(g)**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FEDERAL EXPRESS, this 7TH day of SEPTEMBER, 1993.

STEVEN B. KELBER

Interference 102,648
Interference 102,975

#56

49-111-0

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

WATTANASIN	:	
	:	INTERFERENCE NO.: 102,648
V.	:	EXAMINER-IN-CHIEF:
FUJIKAWA ET AL	:	MICHAEL SOFOCLEOUS

**FUJIKAWA ET AL'S
SUBMISSION OF ERRATA SHEET FOR
BRIEF AT FINAL HEARING
AND
OPPOSITION TO WATTANASIN'S PROPOSED
FINDINGS OF FACT, 37 CFR §1.656(g)**

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

SIR:

Fujikawa et al submits errata sheets for the Brief at Final Hearing and Opposition to Wattanasin's Proposed Findings of Fact, 37 CFR §1.656(g) filed at the Board of Patent Appeals and Interferences on August 16, 1993 in the above-captioned Interference. The corrections are all of a typographical nature. Fujikawa regrets any inconvenience these errors may have caused the Board and Counsel for the Party Wattanasin.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL'S SUBMISSION OF ERRATA SHEET FOR BRIEF AT FINAL HEARING AND OPPOSITION TO WATTANASIN'S PROPOSED FINDINGS OF FACT, 37 CFR §1.656(g)**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FEDERAL EXPRESS, this 7TH day of SEPTEMBER, 1993.

STEVEN B. KELBER

Interference 102,648
Interference 102,975

MISSING PAGE(S)

FROM THE U.S. PATENT OFFICE

OFFICIAL FILE WRAPPER

Papers #57 to #60

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

#261

WATTANASIN

v.

FUJIKAWA et al.

Interference No. 102,975

Examiner-in-Chief: M. Sofocleous

FYI

COMMUNICATION

Attention: Mrs. Hall

Pursuant to your telephone request today, enclosed are three (3) additional copies of each of the following papers mailed by the party Wattanasin on September 7, 1993 for the above-identified interference:

(1) Wattanasin Filing of Reply Brief

(2) Wattanasin Reply to Fujikawa Opposition to Wattanasin Proposed findings of Fact

(3) Wattanasin Opposition to Fujikawa Motion to Suppress Evidence

Respectfully submitted,

Diane Furman 9/21/93

Diane E. Furman
Attorney for the Party Wattanasin
Registration No. 31,104
201-503-7332

Enclosures as noted

Paper No. 62

All communications respecting this case should identify it by number and names of parties.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Telephone: (703)557-4007
Facsimile: (703)557-8642

MAILED

SEP 16 1994

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Interference No. 102,975

Wattanasin
v.
Fujikawa et al
v.
Fujikawa et al

The final hearing in this case is set for November 22, 1994 at 9:00 a.m., in Room A, Crystal Gateway 2, 1225 Jefferson Davis Highway, Arlington, VA 22202.

Counsel who do not expect to attend are requested to promptly notify this Office and such notice must be served on opposing party. 37 CFR 1.646.

Attention of the parties is directed to 35 USC 135(c) regarding the filing of settlement agreements in interferences.

Merrell C. Cashion, Jr.
Program and Resource Administrator
Board of Patent Appeals &
Interferences
(703) 603-3339

ce

FORM PTO-78B
(Rev. 11-92)

FORM PO-644 (REV. 12-74) . DEPARTMENT OF COMMERCE PATENT OFFICE

APPEARANCE RECORD

PROCEEDING	PAPER NO.
102,975	63
HEARING DATE	TIME
Nov 22, 1994	9:00 am

INSTRUCTIONS - This form, properly filled out, should be placed in the file of the above numbered proceeding at the commencement of the hearing.

HEARING BEFORE (✓)	HEARD BY (NAMES)
☐ TRADEMARK TRIAL AND APPEAL BOARD ☐ BOARD OF PATENT INTERFERENCES	Ian A. Calvert Mary F. Downey X Michael Sofocleous

ADVERSARY PARTIES	COUNSEL
Wattanasin	Diane Furman 31,104
Vs.	
Fujikawa et al	Steven B Kelber
Vs.	30,073
Fujikawa et al	Steven B. Kelber
Vs.	30,073

USCOMM-DC 70447-P75

Paper No. 64

IN THE 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]

v.

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

Senior Party.[3]

Patent Interference No. 102,975

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

SOFOCLEOUS, Administrative Patent Judge.

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[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. Assignor to Sandoz Pharmaceuticals Corporation.

[2] Patent 5,011,930, granted April 30, 1991, based on Application 07/483,720 filed February 23, 1990. Accorded the benefit of Japan Application Nos. 207224 filed August 20, 1987 and 15585 filed January 26, 1988 and U.S. Application 07/233,752 filed August 19, 1988. Assignors to Nissan Chemical Industries Ltd.

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

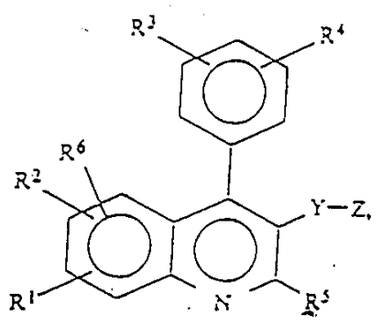
Interference No. 102,975

FINAL DECISION

The subject matter of this interference relates to novel mevalonolactones which are useful to inhibit cholesterol formation. The mevalonolactones inhibit the enzyme, ß-hydroxy-ß-methyl-glutaryl-CoA reductase (HMG-CoA), which controls a key step in the biosynthesis of cholesterol, by catalyzing the conversion of the substrate HMG-CoA to mevalonate, an intermediate of cholesterol. The count of this interference is as follows:

Count 1

A compound of the formula:

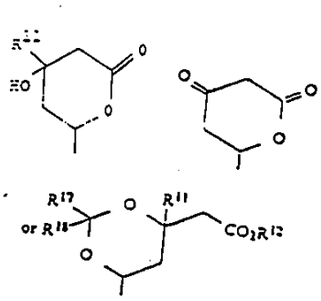


wherein R^1, R^2, R^3, R^4 and R^6 are independently
hydrogen,
C_{1-6} alkyl,
C_{1-6} cycloalkyl,
C_{1-3} alkoxy,
n-butoxy,
i-butoxy,
sec-butoxy,
R^7R^8N- (wherein R^7 and R^8 are independently hydrogen or C_{1-3} alkyl),
trifluoromethyl,
trifluoromethoxy,
difluoromethoxy,
fluoro,
chloro,
bromo,
phenyl,
phenoxy,
benzyloxy,
hydroxy,
hydroxymethyl,
$-O(CH_2)_\alpha OR^{19}$ (wherein R^{19} is hydrogen or C_{1-3}alkyl and α is 1, 2 or 3),
or when located at the ortho position to each other, R^3 and R^4 together optionally form -CH=CH-CH=CH-;

R^5 is hydrogen,
C_{1-6} alkyl,
C_{2-3} alkenyl,
C_{3-6} cycloalkyl,
phenyl substituted by R^9 (wherein R^9 is hydrogen, C_{1-4}alkyl, C_{1-3}alkoxy, fluoro, chloro, bromo or trifluoromethyl),
phenyl-$(CH_2)_m$- (wherein m is 1, 2 or 3), -$(CH_2)_nCH(CH_3)$-phenyl or phenyl-$(CH_2)_nCH(CH_3)$- (wherein n is 0, 1 or 2).

Y is
$-CH_2-$,
$-CH_2CH_2-$,
$-CH=CH-$,
$-CH_2-CH=CH-$, or
$-CH=CH-CH_2-$;

Z is



or $-Q-CH_2WCH_2-CO_2R^{12}$ (where R^{12} is hydrogen or R^{14});

Q is $-CH(OH)-$,
$-C(O)-$, or
$-C(OR^{13})_2-$;

W is $-C(R^{11})(OH)-$ (where R^{11} is hydrogen or C_{1-3} alkyl),
$-C(O)-$, or
$-C(OR^{13})_2-$;

the two R^{13} are independently primary or secondary C_{1-6} alkyl; or two R^{13} together form $-(CH_2)_2-$ or $-(CH_2)_3-$;

R^{14} is physiologically hydrolyzable alkyl or M (wherein M is NH_4, sodium, potassium, 1/2 calcium or a hydrate of lower alkylamine, di-lower alkylamine or tri-lower alkylamine); and

R^{17} and R^{18} are independently hydrogen or C_{1-3} alkyl;

Wattanasin's claims 1 to 7 and 10, Fujikawa et al.'s (Fujikawa's) '930 patent claim 1 and Fujikawa's application claims 1 to 9, 11 to 34, 36, 39 and 40 correspond to the count. No question of interference-in-fact or separate patentability of claims in accordance with 37 CFR 1.633(b) has been raised.

This interference was declared as a result of the Decision on Preliminary Motions in related Interference No. 102,648. After the declaration of this interference, times for taking testimony were set. Wattanasin presented testimony in order to establish priority of invention within the meaning of 35 U.S.C. 102(g). Fujikawa took cross-examination and presented rebuttal testimony. Both parties filed briefs and appeared, through counsel, at final hearing.

The briefs raise the issue of whether Wattanasin has established priority of invention prior to August 20, 1987, Fujikawa's effective filing date.

WATTANASIN'S CASE FOR PRIORITY

Fujikawa is the senior party, having been accorded under the provisions of 35 U.S.C. 119 the benefit of its earliest filed Japan application Serial No. 207224, filed August 20, 1987. For its case for priority of invention, the junior party Wattanasin relies upon actual reduction to practice prior to Fujikawa's effective filing date or conception coupled with diligence starting just prior to Fujikawa's effective filing date up to actual reduction to practice.

Burden of Proof

Wattanasin, as the junior party, whose application is copending with the senior party's involved application and with the senior party's patent before its issuance as a patent, has the burden of proving priority of invention by a preponderance of the evidence. Bosies v. Benedict, 27 F.3d 539, 30 USPQ2d 1862 (Fed.Cir. 1994); Holmwood v. Sugavanam, 948 F.2d 1236, 20 USPQ2d 1712 (Fed.Cir. 1991); and Morgan v. Hirsch, 728 F.2d 1449, 221 USPQ 193 (Fed.Cir. 1984).

Fujikawa's argument that Wattanasin must prove its case for priority by clear and convincing evidence is not well taken. This argument is based on the premise that this interference should have been declared with the party Picard, whose patent issued prior to the filing date of Wattanasin's involved application. If Picard were involved in this interference, we would have agreed with Fujikawa that Wattanasin, whose application was filed after the issuance of Picard's patent, would have had the burden of proof by clear and convincing evidence with respect to Picard. See Price v. Symsek, 988 F.2d 1187, 26 USPQ2d 1031 (Fed.Cir. 1993). However, since this interference was not declared with Picard, the burden of proof upon Wattanasin vis-a-vis Fujikawa is the preponderance of the evidence, inasmuch as Wattanasin's application is copending with both Fujikawa's involved application and Fujikawa's involved patent before its issuance as a patent.

The Wattanasin Record

Wattanasin presented a record consisting of the testimony of 16 witnesses together with 51 associated exhibits. The testimony will be referred to by WR followed by its page number; each exhibit, by WX followed by its identifier. The record shows that Sandoz Pharmaceuticals Corporation, the assignee of the involved Wattanasin application, has been involved since 1979 in a research program to discover compounds having HMG-CoA reductase inhibiting activity. In 1979, Dr. Kathawala, a Ph.D., was the section head of a research team responsible for the research. This team was expanded over time to five laboratory units, each headed by a Ph.D. In 1982, Dr. Wattanasin, the named inventor, joined the project, worked under Dr. Kathawala and was later appointed as head of one of the five laboratory units. WR 136.

The First Phase Activity

I

The record shows that during the period from May 31, 1984 to May 17, 1985, Dr. Wattanasin synthesized three compounds (63-366, 63-548 and 63-549) falling within the scope of the count. Employees reporting to Dr. Barcza, a Ph.D chemist and director of the Sandoz Department of Physical Organic Chemistry, performed the spectra, microanalyses and thin layer chromatography (TLC) on the various intermediates and the final compounds. Samples of the final compounds were sent to the Drug Room of Sandoz and their receipt was

recorded in the computer database. Dr. Damon, a Ph.D. chemist, who was in charge of the Drug Room, had samples of the compounds forwarded to Dr. Scallen for testing. WR 22 to 24, 27 to 44, 48 to 54, 172 to 185 and 196; WX A-1, A-2, B-1, B-2, C-1 to 3, D-1, D-2, G-1, G-2, H-1 and I-1.

Dr. Scallen, a professor of biochemistry and medical doctor at the School of Medicine, University of New Mexico, has performed extensive research in the area of cholesterol biosynthesis inhibition and is very familiar with compounds which possess cholesterol biosynthesis inhibition activity. Dr. Scallen received the compounds and tested them in an established protocol using rat liver microsomes to determine whether they were competitive inhibitors of HMG-CoA reductase, the rate limiting enzyme in cholesterol biosynthesis. Dr. Scallen testified:

> If a compound possesses this activity [inhibits HMG-CoA reductase], it would be useful for lowering the blood cholesterol level in animals. WR 188.

Also Dr. Scallen testified that a compound which is an inhibitor of HMG-CoA reductase would be useful as a hypolipoproteinemic and anti-atherosclerotic agent. WR 188. He further testified that it has been

> my judgment since prior to August 20, 1987, that the level of <u>in vivo</u> activity of a compound as a cholesterol inhibitor or anti-atherosclerotic when administered to a patient, is typically highly correlatable to its <u>in vitro</u> activity in my HMG-CoA reductase inhibitor assays. WR 193

Dr. Scallen explained that he has "substantial experience in testing compounds for HMG-CoA reductase activity in vitro". WR 193.

On or before December 13, 1984, Dr. Scallen had an in vitro biological assay of compound 63-366 performed in his laboratory under his supervision. The results indicated HMG-CoA reductase activity and Dr. Scallen reported the results to Dr. Damon of Sandoz. Likewise, on or before June 13, 1985, Dr. Scallen had in vitro biological assays of compounds, 63-548 and 63-549, performed in his laboratory under his supervision. The results indicated HMG-CoA reductase activity and were reported to Dr. Damon of Sandoz. WR 187 to 191; WX E-1 and E-2.

Upon receiving the results, Dr. Damon calculated the IC_{50} for each compound. The IC_{50} value is the concentration of the test substance in the assay system to produce a 50% inhibition of HMG-CoA reductase. The smaller the IC_{50} value, the more active the compound was in the assay. Dr. Damon would send Dr. Wattanasin within three or four days of receiving the test results a report with the assay data (including the IC_{50}) and the structure of the compound. The report (WX E-5), stamp-dated December 20, 1984, indicated that compound 63-366 had an IC_{50} of 1.58 μmoles (μM); the reports (WX E-5), stamp-dated June 28, 1985, indicated that compounds 63-548 and 63-549 each had, respectively, an IC_{50} of 3.775 μM and 7.3100 μM. He compared these values to the IC_{50} value of compactin, a known HMG-CoA inhibitor for administration to patients to inhibit cholesterol

biosynthesis. Compactin has an IC_{50} value of 1.011 μM. WR 196 to 201 and 483; WX E-1 and E-5.

Concerning these test results, Dr. Damon testified that based on his knowledge and experience,

> it was my judgment on or prior to December 31, 1984, that there was a high probability that Wattanasin compound 63-366 would be active when administered in vivo to a patient to inhibit cholesterol biosynthesis, i.e. for the treatment of hypercholesteremia or atherosclerosis. WR 201.

He testified that he had the same opinion for the other tested compounds.

Dr. Wattanasin testified that no other experimental work was done on his invention because of a manpower shortage in his lab. WR 106 to 110. Ms. Patel was hired in January 1987. In late March of 1987, Dr. Wattanasin submitted an Invention Disclosure (A-3), dated March 16, 1987, to the Sandoz Patent and Trademark Department and that disclosure was presented on several occasions to the Patent Committee which decided after its January 1988 meeting to file an application. WR 24 and 25; WX A-3.

II

Fujikawa has urged that the Wattanasin record does not establish actual reduction to practice by June 13, 1985. We need not reach this issue.

Assuming that the Wattanasin record establishes an actual reduction to practice on December 13, 1984, the date that Dr. Scallen

had successfully tested compound 63-366 for HMG-CoA reductase activity, then we would agree with Fujikawa that Wattanasin suppressed or concealed his invention. It is a settled that if a junior party relies upon an actual reduction to practice and if the hiatus in time between the date for its asserted actual reduction to practice and filing of its application is unreasonably long, the hiatus may give rise to an inference that the junior party suppressed or concealed the invention. Lutzker v. Plet, 843 F.2d 1364, 6 USPQ2d 1370 (Fed.Cir. 1988); Paulik v. Rizkalla, 760 F.2d 1270, 226 USPQ 224 (Fed. Cir. 1985); Shindelar v. Holdeman, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980), cert. denied, 451 U.S. 984, 210 USPQ 776 (1981); Peeler v. Miller, 535 F.2d 647, 190 USPQ 117 (CCPA 1976); Young v. Dworkin, 489 F.2d 1277, 180 USPQ 388 (CCPA 1974); Holmwood v. Cherpek, 2 USPQ2d 1942 (BPAI 1986). Each case of concealment and suppression must be decided on its own particular set of facts. Shindelar v. Holdeman, supra.

As noted by the court in Peeler v. Miller, 190 USPQ 122,

> ...a four year delay from the time an inventor is satisfied with his invention and completes his work on it and the time his assignee-employer files a patent application is, prima facie, unreasonably long in an interference with a party who filed first.

In this case, the relevant time gap would be approximately four years and three months from the first actual reduction to practice on December 13, 1984 up to March 3, 1989, the filing date of Wattanasin's parent application. This hiatus in time would be

unreasonably long and would raise the inference that Wattanasin suppressed or concealed the invention. Here the experimental work was completed by June 13, 1985 with the in vitro assays of three compounds. The two later made compounds (63-548 and 63-549) were not as effective as the first made compound (63-366). For nearly 21 months up to March 16, 1987, Wattanasin did no further work on his invention except to write an invention disclosure (A-3). Thus, assuming there was a reduction to practice by June 13, 1985, the burden falls on Wattanasin to excuse, explain or justify the lack of activity. Lutzker v. Plet, supra.

To excuse this lack of activity, Wattanasin urges that he had a manpower shortage, necessitating the cessation of work on his invention. In our view, this excuse is not sufficient to sustain Wattanasin's burden to explain the delay. Rather, we infer that Wattanasin made a conscious decision not to pursue any further work on his invention because of the failure of the two later made compounds to have any better activity than compound 63-366. Our inference is buttressed by Wattanasin's assertion that the other compounds synthesized during the second phase of activity, namely, 64-933 synthesized by July 28, 1987 and 64-934/NA synthesized by July 29, 1987, need not have been tested for utility in order to have established reduction to practice since in Wattanasin's view utility was established by the testing of the three compounds 63-366, 63-548 and 63-549. If utility testing were not required, as urged by

Wattanasin, then the Wattanasin invention was completed by June 13, 1985 and the invention disclosure should have been written shortly thereafter. The failure to do so clearly raises the inference of suppression or concealment which has not been rebutted.

For the foregoing reasons, Wattanasin could not rely upon the syntheses and the testing of compounds 63-366, 63-548 and 63-549 even if that activity was an actual reduction to practice. At best this work can only be relied upon for conception. Accordingly, we hold that this work establishes conception of the invention of the count by at least June 13, 1985.

The Second Phase Activity

I

Pages 31 to 44 of the Wattanasin main brief with references to the testimony and exhibits set forth a detailed explanation of Wattanasin's renewed activity.

Essentially from early March 1987 into September, 1987, Ms. Patel synthesized four compounds, 64-933, 64-934/NA, 64-935 and 64-936/NA, within the scope of the count and forwarded the compounds to the Sandoz Drug Room. By July 28, 1987, she synthesized compound 64-933; by July 29, 1987, compound 64-934/NA; by August 20, 1987, compound 64-935; and by August 25, 1987, compound 64-936/NA. During the synthesis, purification and characterization of the compounds, Dr. Wattanasin went to a meeting in New Orleans for over a week and when he returned, he found out that the next scheduled shipment out

of the Sandoz drug room to Dr. Scallen would be on October 2, 1987, even though the compounds were made before October 2. He wanted all the compounds shipped together for testing so that he could get a better comparison of their potency in the same study. The compounds were shipped on October 2, 1987 overnight to Dr. Scallen. Dr. Scallen received the compounds, tested them in an established protocol using rat liver microsomes to their biological activity in vitro and reported the raw results to Dr. Damon on or before October 20, 1987.

Dr. Damon calculated the IC_{50} for each compound and compared each value with compactin which has an IC_{50} of 1.011 M. Compound 64-933 had an IC_{50} of 2.3700 μM; compound 64-934/NA, an IC_{50} of 2.6100 μM; compound 64-935, an IC_{50} of 0.4130 μM; and compound 64-936/NA, an IC_{50} of 0.5300 μM. WR 183 to 195; WX E-1 to E-5, H-1 and I-1.

Dr. Engstrom of the Sandoz Lipid Metabolism Department commenced the in vivo testing of compound 64-936 on or before October 22, 1987 and the testing of compounds 64-933 and 64-935 on October 29, 1987. The testing was completed on or prior to December 9, 1987. The compounds were administered to male Wistar Royal Hart rats in accordance with the protocol described at WR 204. Mr. Slaughter, Dr. Engstrom's lab assistant, entered the raw data into a computer program which converted the data to nano Curies (nCi) of sterol per 100 ml. of serum at 4 hours after injection of ^{14}C-acetate. Thereafter Dr. Engstrom entered this data into a computer program

which calculated the ED_{50} values for the compounds. The ED_{50} value[4] for compound 64-933 is >1; for compound 64-935, 0.49; and for compound 64-936, >1. Dr. Wattanasin testified that the data on WX K-1 indicates that the compounds would have activity as a HMG-CoA reductase inhibitor when administered to a patient. Compactin has an ED_{50} of 3.5. WR 56, 203 to 212 and 485; WX K-1 and Q.

Contemporaneous with these second phase activities, the Sandoz Patent Committee met on April 29, 1987 and considered the Wattanasin invention disclosure (A-3). According to the testimony of Linda Rothwell and Joanne M. Giesser, the committee deferred a decision for three months on whether to file an application because of the ongoing work. Again at its meeting on July 29, 1987, the committee deferred its decision for another three months. As a result of the October 28, 1987 and November 25, 1987 meetings, the committee's decision was deferred to January, there being no committee meeting during the month of December. At the January 27, 1988 meeting, the committee decided that an application should be filed on the Wattanasin disclosure. The disclosure, which had been assigned to Mr. Weinfeldt, was reassigned to Ms. Giesser, a junior patent attorney in the Sandoz Patent Department. The application was

[4] The ED_{50} values for compounds 64-933 and 64-935 were inadvertently switched as explained in Dr. Engstrom's supplemental declaration at WR 207 and 208.

filed on March 3, 1989. WR 213 to 215 and 319 to 323; WX M-1 to M-5 and P-1 to 3.

II

We hold that the Wattanasin record establishes prior conception coupled with due diligence from just prior to August 20, 1987, Fujikawa's effective filing date, up to December 9, 1987, the date of the in vivo testing of compound 64-935.

Prior conception is established by June 13, 1985, when the work performed during the first phase of the interference was completed. Thus the Wattanasin record establishes prior conception.

With respect to diligence, Wattanasin has the burden to establish reasonable diligence from just prior to August 20, 1987, up to December 9, 1987, the date of in vivo testing of compound 64-935. As noted by Wattanasin in his reply brief at page 24, "it does not appear that Fujikawa contest diligence as to this period." We agree. Nowhere in its brief has the party Fujikawa shown where Wattanasin was not reasonably diligent during this period. Accordingly, we hold that the Wattanasin record establishes reasonable diligence during the critical period in question.

III

We hold that the Wattanasin record establishes actual reduction to practice by October 20, 1987, the date compound 64-935 was successfully tested in vitro or by at least December 9, 1987, the date the in vivo testing of the compound was completed.

Before we discuss the Wattanasin record, we must consider Fujikawa's motion (Paper No. 53) to suppress, which was filed at the same time as Fujikawa's brief. In the motion, Fujikawa requests that we not consider Dr. Engstrom's testimony at WR 204 to 208 because the testimony relies upon a computer-generated summary to obtain the ED_{50} values. We agree with Wattanasin's opposition (Paper No. 58) that the ED_{50} value for compound 64-935 should not be invalidated because of a purported lack of foundation for the underlying computer programs used to calculate the value from the raw data. As pointed out by Wattanasin, Dr. Holmlund, Fujikawa's rebuttal witness, had "no quarrel with the techniques for determining statistical activity." Likewise, we do not consider that Wattanasin had to have placed in evidence the computer programs used to calculate the value from the experimental data. It is enough to have placed into evidence the experimental data, which showed that the compound had significant activity. Accordingly, the motion to suppress is denied.

IV

It is settled that a practical utility must be established for a novel compound before it can be said to have been reduced to practice. Brenner v. Manson, 382 U.S. 519, 148 USPQ 689 (1966); Kawai v. Metlesics, 480 F.2d 880, 178 USPQ 158 (CCPA 1973); Blicke v. Treves, 241 F.2d 718, 112 USPQ 472 (CCPA 1957); Hoffman v. Klaus, 9 USPQ2d 1657 (BPAI 1988) and Bindra v. Kelly, 206 USPQ 570 (Bd.Pat.Int. 1979). Where the count does not state any utility, any

utility is sufficient to establish actual reduction to practice. Newkirk v. Lulejian, 825 F.2d 1581, 3 USPQ2d 1793 (Fed.Cir. 1987). Each utility question arising in an interference must be decided on its own facts. Nelson v. Bowler, 626 F.2d 853, 206 USPQ 881 (CCPA 1980). Tests evidencing pharmacological activity may manifest a practical utility, even though they may not establish a specific in vivo therapeutic use, provided that a reasonable correlation is established between the tests and the therapeutic use. Cross v. Iizuka, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985); Nelson v. Bowler, supra; Hoffman v. Klaus, supra; DeSolms v. Shoenwald, 15 USPQ2d 1507 (BPAI 1990).

We do not agree with Wattanasin's position that actual reduction occurred on July 28, 1987 when Ms. Patel synthesized compound 64-933 and by July 29, 1987 when Ms. Patel synthesized compound 64-933/NA. A practical utility must be established for a novel compound before it can be said to have been reduced to practice. Brenner v. Manson, supra; Kawai v. Metlesics, supra; and Hoffman v. Klaus, supra. These compounds, 64-933 and 64-933/NA, were novel and it could not be reasonably ascertained without testing whether they would be useful in inhibiting cholesterol formation. The fact that they are structurally similar to compound 63-366 which has cholesterol inhibitory action is not persuasive to show that they would also have a similar activity. In this regard we note that compounds 64-933 and 64-933/NA did not have a comparable activity as

compounds 63-548 and 63-549, which were synthesized in 1985, even though all the compounds are also structurally similar. Consequently, one skilled in this art could not have reasonably ascertained without testing for cholesterol inhibitory activity whether a novel compound having a structural similarity to a known compound would have an activity comparable to the known compound.

V

We agree with Wattanasin that actual reduction occurred by October 20, 1987, the date the in vitro testing of compound 64-935 was completed. Here Fujikawa does not question that compound 64-935 is a compound within the scope of the count. Rather Fujikawa questions whether Wattanasin has shown a practical utility for this compound, i.e., whether a sufficient correlation has been shown between the in vitro tests performed by Wattanasin and an in vivo activity to establish a practical utility.

In our view, the Wattanasin record provides such a correlation. Both the Wattanasin application at page 35, lines 1 to 9 and the Fujikawa application at page 26, lines 5 to 13, acknowledge that HMG-CoA reductase is the rate limiting enzyme in the formation of cholesterol and that the inhibition of this reductase would suppress or reduce the amount of cholesterol in the blood. Both applications use rat liver microsomal suspensions for their in vitro testing of compounds.

We consider that Fujikawa's argument that an insufficient correlation exists between the in vitro activity and the in vivo activity is not well founded. In this regard, Dr. Scallen, who conducted the in vitro testing of Wattanasin's compounds, testified that if a compound inhibits HMG-CoA reductase, the compound would be useful for lowering blood cholesterol levels in animals and that based on his judgment in vivo activity is typically highly correlatable to a compound's in vitro activity in the HMG-CoA reductase inhibitor assay. Compound 64-935 was tested in the in vitro protocol using rat liver microsomes and found to inhibit the formation of HMG-CoA reductase better than compacting. Compound 64-935's IC_{50} value was calculated to be 0.413 μM as compared to an IC_{50} value of 1.011 μM for compactin. In our view, this establishes a sufficient correlation between the in vitro tests and the ultimate therapeutic use. Thus we conclude that the successful in vitro testing of compound 64-935 establishes actual reduction to practice by October 20, 1987.

We note Fujikawa's reliance of Dr. Holmlund's testimony that...

> [T]here is a reasonable element of doubt that some compounds may be encountered which are active in the in vitro assay, but yet inactive in the in vivo assay. FR 223 and 224.

Dr. Holmlund reasoned that there are a large number of steps (between ten and twenty) in the synthesis that occurs in vivo, and that

assessment of any particular activity in vitro would involve assessment of thirty or more enzymes depending on the starting material. FR 235 and 236. The Fujikawa brief at pages 38 and 39 also relies upon certain references submitted under 37 CFR 1.682 as evidencing the lack of reliability of in vitro testing to predict in vivo activity. Pointing to the table at FR 455 comparing various in vitro activities for compounds corresponding to the compounds of the interference, the brief contends that it is the conclusion of the authors that in only three of the ten cases studied were in vitro predictions accurate as to in vivo performance. Pointing to FR 464, the brief contends that "even between cells of different mammals, prediction is not accurate." Pointing to FR 465, the brief contends that the reference documents the fact as testified by Dr. Holmlund that a variety of events may occur in an intact animal that preclude obtaining the results reflected in in vitro assays, such as the poor bioavailability to the liver. Pointing to FR 486 and 487, the brief contends that this article, which was published by Dr. Kathawala, Dr. Wattanasin's supervisor, concedes...

> that it is not correct to conclude that in vitro microsomal activity against HMG-CoA reductase parallels in vivo activity in rates for all compounds of the class embraced by the Count herein. Fujikawa's brief at page 39.

The Fujikawa brief contends that the article shows that reliability to be at best only slightly more than 50 percent of the compounds studied.

It appears to be Fujikawa's position that absolute predictability, which can only be shown by human testing and the absence of toxicity to humans, is required before the Wattanasin compound 64-935 can be concluded to be useful. We disagree. As noted by Cross, supra,

> under appropriate circumstances, the first link in the screening chain, in vitro testing, may establish a practical utility for the compound in question.

While Cross concerns utility with respect to a constructive reduction to practice, we consider Cross equally applicable here with respect to an actual reduction to practice since in both circumstances in vitro tests are being relied upon to establish practical utility. In this case, the Wattanasin record demonstrates a reasonable correlation between the in vitro screening test and a pharmacological activity.

VI

Even if the in vitro testing of compound 64-935 were insufficient to establish reduction to practice, we are of the view that the in vivo testing of the compound establishes actual reduction to practice by December 9, 1987.

The Wattanasin record shows that by December 9, 1987 compound 64-935 was administered to a rat. The compound exhibited significant activity at levels of 1 and 0.1 milligrams per kilogram and its ED_{50} value was calculated to be 0.49 μM, an activity greater than compactin. Dr. Wattanasin testified that this activity showed

that the compound would be active as a HMG-CoA reductase inhibitor when administered to a patient. Further Dr. Holmlund, Fujikawa's rebuttal witness acknowledged that the compound did in fact exhibit significant activity at those levels. See the Fujikawa record at pages 207 to 209 and 243 (FR 207 to 209 and 243).

We do not agree with the party Fujikawa's position on page 32 of its main brief that the proofs of Wattanasin fail because a human patient was not tested. In this case, the count is directed to compounds per se and the testing of the compound in rats is sufficient to establish actual reduction to practice.

It is also Fujikawa's position that the in vivo testing of compound 64-935 does not demonstrate a practical utility. This position is not well taken. To support this position, Fujikawa relies on Dr. Holmlund's testimony at FR 209 that since the compound was not significantly active at 0.3 milligrams and that since he (Dr. Holmlund) could not have obtained the ED_{50} value on the basis of WX K-1 in the absence of any reasonable dose response curve, he could not make any final conclusion on the compound's activity. In effect, Dr. Holmlund would want a commercially satisfactory performance; however, a commercially satisfactory performance is not necessary for an actual reduction to practice. Creamer v. Kirkwood, 305 F.2d 486, 134 USPQ 330 (CCPA 1962). Practical utility for compound 64-935 existed when it was found to have significant activity at 1 and 0.1 milligrams.

Nor do we agree with the Fujikawa brief at pages 53 and 54 that the Engstrom declaration should be "severely discounted," because it reflects a ED_{50} value for a compound never tested, i.e., 64-936. The fact that Dr. Engstrom had been provided the sodium salt of 64-936 (64-936NA) and had not assigned any ED_{50} value for that compound does not in any way impugn the test results for compound 64-935.

For the foregoing reasons, we hold that the Wattanasin record establishes actual reduction to practice by October 20, 1987 the date of the in vitro testing of compound 64-935 or by at least December 9, 1987, the date of the in vivo testing of compound 64-935. Accordingly, the Wattanasin record establishes prior conception coupled with due diligence from just prior to August 20, 1987, Fujikawa's effective filing date, up to an actual reduction to practice on October 20, 1987 or on December 9, 1987.

VII

In view of our foregoing holding, Wattanasin is entitled to judgment vis-a-vis Fujikawa. However, Fujikawa urges that judgment should not be entered in Wattanasin's favor because the evidence shows that Wattanasin suppressed or concealed the invention. In this case, the hiatus in time between the actual reduction to practice on December 9, 1987 up to March 3, 1989, the filing date of Wattanasin's parent application, is approximately fifteen months. In our view, this hiatus in time is not sufficiently long to raise the inference

that Wattanasin suppressed or concealed the invention considering the nature and complexity of the invention here. Cf. Bigham v. Godtfredsen, 222 USPQ 632 (Bd.Pat.Int. 1984) and Halbert v. Schuurs, 220 USPQ 558 (Bd.Pat.Int. 1983).

Since we have held that the hiatus in time is not sufficiently long to raise the inference that Wattanasin suppressed or concealed his invention, we need not evaluate the testimony of Mr. Melvyn Kassenoff, which bears on this question and which the Fujikawa brief requests that we discredit. We consider this matter moot.

JUDGMENT

Judgment with respect to the subject matter of the count in issue is hereby awarded to Sompong Wattanasin, the junior party. Accordingly, on the present record, Wattanasin is entitled to a patent containing claims 1 to 7 and 10, Fujikawa et al. (Patent No. 5,011,930) are not entitled to a patent containing claim 1, and Fujikawa et al. (Application Serial No. 07/233,752) is not entitled to a patent contining claims 1 to 9, 11 to 34, 36, 39 and 40.

IAN A. CALVERT, Vice Chief
Administrative Patent Judge

MICHAEL SOFOCLEOUS
Administrative Patent Judge

MARY F. DOWNEY
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Interference No. 102,975

Gerald D. Sharkin
Sandoz Corp.
59 Route 10
E. Hanover, N.J. 07936

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United States Court of Appeals for the Federal Circuit

95-1418

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

v.

SOMPONG WATTANASIN,
Appellee.

- - - - - - - - - - - -

95-1425

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

v.

SOMPONG WATTANASIN,
Appellee.

JUDGMENT

Appeal from decisions of the Board of Patent Appeals and Interference Nos. 102,648 and 102,975 dated January 31, 1995, and upon reconsideration on April 6, 1995.

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: **AFFIRMED**

ENTERED BY ORDER OF THE COURT

DATED: AUGUST 28, 1996

Francis X. Gindhart

Francis X. Gindhart, Clerk

ISSUED AS A MANDATE: SEP 6 1996

REVISED: 08-28-96

Official Caption[1]

95-1418

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

v.

SOMPONG WATTANASIN,
Appellee.

- - - - - - - - - - - -

95-1425

YOSHIHIRO FUJIKAWA, MIKIO SUZUKI,
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v.

SOMPONG WATTANASIN,
Appellee.

Appeal from decisions of the Board of Patent Appeals and Interference Nos. 102,648 and 102,975 dated January 31, 1995, and upon reconsideration on April 6, 1995.

Authorized Abbreviated Caption[2]

FUJIKAWA V WATTANASIN, 95-1418,-1425

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[1]Required for use on petitions, formal briefs and appendices, court opinions, and dispositive court orders. FRAP 12(a); 32(a).

[2]Authorized for use only on items not requiring the Official Caption as listed in note 1.

UNITED STATES CC 1T OF APPEALS FOR THE F ERAL CIRCUIT

NOTICE OF ENTRY OF
JUDGMENT ACCOMPANIED BY OPINION

OPINION FILED AND JUDGMENT ENTERED: 08/28/96

The attached opinion announcing the judgment of the court in your case was filed and judgment was entered on the date indicated above. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

Costs are taxed against the Appellant(s) in favor of the Appellee(s) under Rule 39. The party entitled to costs is provided a bill of costs form and an instruction sheet with this notice.

The parties are encouraged to stipulate to the costs. A bill of costs will be presumed correct in the absence of a timely filed objection.

Costs are payable to the party awarded costs. If costs are awarded to the government, they should be paid to the Treasurer of the United States. Where costs are awarded against the government, payment should be made to the person(s) designated under the governing statutes, the court's orders, and the parties' written settlement agreements. In cases between private parties, payment should be made to counsel for the party awarded costs or, if the party is not represented by counsel, to the party pro se. Payment of costs should not be sent to the court. Costs should be paid promptly.

If the court also imposed monetary sanctions, they are payable to the opposing party unless the court's opinion provides otherwise. Sanctions should be paid in the same way as costs.

Exhibits and visual aids shall be promptly retrieved by the party that lodged them with this court.

FRANCIS X. GINDHART
Clerk

cc: STEVEN B. KELBER ✓
DIANE E. FURMAN

FUJIKAWA V WATTANASIN, 95-1418,-1425
PTO - 102,648 , 102,975

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

95-1418

YOSHIHIRO FUJIKAWA, MIKIO SUZUKI,
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95-1425

YOSHIHIRO FUJIKAWA, MIKIO SUZUKI,
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v.

SOMPONG WATTANASIN,
Appellee.

Steven B. Kelber, Oblon, Spivak, McClelland, Maier & Neustadt, P.C., of Arlington, Virginia, argued for appellants.

Diane E. Furman, Sandoz Corporation, of East Hanover, New Jersey, argued for appellee.

Appealed from: U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

95-1418

YOSHIHIRO FUJIKAWA, MIKIO SUZUKI,
HIROSHI IWASAKI, MITSUAKI SAKASHITA
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Appellants,

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SOMPONG WATTANASIN

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- - - - - - - - - - - - -

95-1425

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

Appellants,

v.

SOMPONG WATTANASIN

Appellee.

DECIDED: August 28, 1996

Before MAYER, CLEVENGER, and RADER, Circuit Judges.
CLEVENGER, Circuit Judge.

Yoshihiro Fujikawa et al (Fujikawa) appeal from two decisions of the Board of Patent Appeals and Interferences of the United States Patent & Trademark Office (Board) granting priority of invention in two related interferences to Sompong Wattanasin, and denying Fujikawa's motion to add an additional sub-genus count to the interferences. We affirm.

I

These interferences pertain to a compound and method for inhibiting cholesterol biosynthesis in humans and other animals. The compound count recites a genus of novel mevalonolactones. The method count recites a method of inhibiting the biosynthesis of cholesterol by administering to a "patient in need of said treatment" an appropriate dosage of a compound falling within the scope of the compound count.

The real parties in interest are Sandoz Pharmaceuticals Corporation (Sandoz), assignee of Wattanasin, and Nissan Chemical Industries, Ltd. (Nissan), assignee of Fujikawa.

The inventive activity of Fujikawa, the senior party, occurred overseas. Fujikawa can thus rely only on his effective filing date, August 20, 1987, to establish priority. 35 U.S.C. § 102(g) (1994). Whether Wattanasin is entitled to priority as against Fujikawa therefore turns on two discrete questions. First, whether Wattanasin has shown conception coupled with diligence from just prior to Fujikawa's effective filing date until reduction to practice. Id. Second, whether Wattanasin suppressed or concealed the invention between reduction to practice and filing. Id. With respect to the first question, Fujikawa does not directly challenge the Board's holdings on Wattanasin's conception or diligence, but rather contends that the Board incorrectly fixed the date of Wattanasin's reduction to practice. As for the second question, Fujikawa contends that the Board erred in concluding that Wattanasin had not suppressed or concealed the invention. Fujikawa

seeks reversal, and thus to establish priority in its favor, on either ground.

II

The Board divided Wattanasin's inventive activity into two phases. The first phase commenced in 1979 when Sandoz began searching for drugs which would inhibit the biosynthesis of cholesterol. Inventor Wattanasin was assigned to this project in 1982, and during 1984-1985 he synthesized three compounds falling within the scope of the compound count. When tested in vitro, each of these compounds exhibited some cholesterol-inhibiting activity, although not all the chemicals were equally effective. Still, according to one Sandoz researcher, Dr. Damon, these test results indicated that, to a high probability, the three compounds "would be active when administered in vivo to a patient to inhibit cholesterol biosynthesis, i.e. for the treatment of hypercholesteremia or atherosclerosis." Notwithstanding these seemingly positive results, Sandoz shelved Wattanasin's project for almost two years, apparently because the level of in vitro activity in two of the three compounds was disappointingly low.

By January 1987, however, interest in Wattanasin's invention had revived, and the second phase of activity began. Over the next several months, four more compounds falling within the scope of the compound count were synthesized. In October, these compounds were tested for in vitro activity, and each of the four compounds yielded positive results. Again, however, there were significant differences in the level of in vitro activity of the four

compounds. Two of the compounds in particular, numbered 64-935 and 64-936, exhibited *in vitro* activity significantly higher than that of the other two compounds, numbered 64-933 and 64-934.

Soon after, in December 1987, the three most active compounds *in vitro* were subjected to additional *in vivo* testing. For Sandoz, one primary purpose of these tests was to determine the *in vivo* potency of the three compounds relative to that of Compactin, a prior art compound of known cholesterol-inhibiting potency. From the results of the *in vivo* tests, reproduced in the margin,[1] Sandoz calculated an ED_{50}[2] for each of the compounds and compared it to the ED_{50} of Compactin. Only one of the compounds, compound 64-935, manifested a better ED_{50} than Compactin: an ED_{50} of 0.49 as compared to Compactin's ED_{50} of 3.5. All of the tests performed by Sandoz were conducted in accordance with established protocols.

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[1]

Compound	dosage	% change
64-933	1.0	-36.3%
	0.3	-17.0%
	0.1	-18.6%
64-935	1.0	-65.8%
	0.3	-29.7%
	0.1	-36.3%
64-936	1.0	-9.0%
	0.3	-39.2%
	0.1	-22.5%

[2] The ED_{50} of a compound represents the effective concentration, measured in milligrams of compound per kilogram of laboratory specimen, which inhibits cholesterol biosynthesis by 50%.

During this period, Sandoz also began to consider whether, and when, a patent application should be filed for Wattanasin's invention. Several times during the second phase of activity, the Sandoz patent committee considered the question of Wattanasin's invention but decided that it was too early in the invention's development to file a patent application. Each time, however, the patent committee merely deferred decision on the matter and specified that it would be taken up again at subsequent meetings. Finally, in January 1988, with the in vivo testing completed, the Committee assigned Wattanasin's invention an "A" rating which meant that the invention was ripe for filing and that a patent application should be prepared. The case was assigned to a Ms. Geisser, a young patent attorney in the Sandoz patent department with little experience in the pharmaceutical field.

Over the next several months the Sandoz patent department collected additional data from the inventor which was needed to prepare the patent application. This data gathering took until approximately the end of May 1988. At that point, work on the case seems to have ceased for several months until Ms. Geisser began preparing a draft sometime in the latter half of 1988. The parties dispute when this preparation began. Fujikawa contends that it occurred as late as October, and that Ms. Geisser was spurred to begin preparing the draft application by the discovery that a patent to the same subject matter had been issued to a third party, Picard. Fujikawa, however, has no evidence to support that contention. In contrast, Sandoz contends that Ms. Geisser began

the draft as early as August, and that she was already working on the draft when she first heard of Picard's patent. The evidence of record, and in particular the testimony of Ms. Geisser, supports that version of events. In any event, the draft was completed in November and, after several turn-arounds with the inventor, ultimately filed in March of 1989.

Both Wattanasin and Fujikawa requested an interference with Picard. The requests were granted and a three-party interference between Picard, Fujikawa, and Wattanasin was set up. Early in the proceedings, however, Picard filed a request for an adverse judgment presumably because he could not antedate Fujikawa's priority date. What remained was a two-party interference between Fujikawa and Wattanasin. Ultimately, for reasons not significant to this appeal, the interference was divided into two interferences: one relating to the method count and one relating to the compound count. The Board decided each of these interferences adverse to Fujikawa.

With respect to the compound count, the Board made two alternative findings regarding reduction to practice. First, it found that the in vitro results in October 1987 showed sufficient practical utility for the compound so as to constitute a reduction to practice as of the date of those tests.[3] In the alternative, the Board held, the in vivo tests which showed significant activity

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[3] As explained more fully below, reduction to practice requires a showing of practical utility, which may be satisfied by an "adequate showing of any pharmacological activity." Nelson v. Bowler, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980).

in the 64-935 compound at doses of 1.0 and 0.1 mg were sufficient to show practical utility. Consequently, Wattanasin had reduced the compound to practice, at the latest, as of December 1987. Since Fujikawa did not challenge Wattanasin's diligence for the period between Fujikawa's effective filing date of August 20, 1987 and Wattanasin's reduction to practice in either October or December 1987, the Board held that Wattanasin was de facto the first inventor of the compound count. Finally, the Board found that the seventeen month period (counting from the in vitro testing) or fifteen month period (counting from the in vivo testing) between Wattanasin's reduction to practice and filing was not sufficient to raise an inference of suppression or concealment given the complexity of the invention, and therefore awarded priority of the compound count to Wattanasin. In reaching this conclusion, the Board rejected Fujikawa's argument that Wattanasin was spurred to file by Picard because it held that spurring by Picard, a third party, had no legal effect in a priority dispute between Fujikawa and Wattanasin.

With respect to the method count, the Board determined that Wattanasin reduced to practice in December 1987 on the date that in vivo testing of the 64-935 compound was concluded. In reaching that conclusion, the Board first noted that a reduction to practice must include every limitation of the count. Consequently, Wattanasin's early in vitro testing could not constitute a reduction to practice of the method count, since that count recites administering the compound to a "patient." The in vivo testing,

however, met the limitations of the count since the word "patient" was sufficiently broad to include the laboratory rats to whom the compounds were administered. The in vivo testing also proved that 64-935 had practical utility because the compound displayed significant cholesterol inhibiting activity at doses of 1.0 and 0.1 mg. Given this date of reduction to practice, the Board again held that Wattanasin was the de facto first inventor of the count and that the delay in filing of fifteen months was not sufficient to trigger an inference of suppression or concealment. The Board therefore awarded priority of the method count to Wattanasin.

Before this court, Fujikawa seeks review of these adverse priority determinations. In addition, during the motions period of the interference, Fujikawa moved to have an additional sub-genus count added to the interference. The Board denied that motion on the ground that the Wattanasin disclosure did not contain a sufficient written description to support the proposed count. Fujikawa appeals that decision, as well. We have jurisdiction to hear this appeal under 28 U.S.C. § 1295(a)(4)(A) (1994).

III

We first address Fujikawa's argument that Wattanasin's in vitro and in vivo tests failed to establish a practical utility for either the compound or method count. The Board held that the in vitro tests established a practical utility for the compound and that the in vivo tests established a practical utility for both the compound and method counts. For the reasons set out below, we affirm these findings of the Board.

For over 200 years, the concept of utility has occupied a central role in our patent system. See Brenner v. Manson, 383 U.S. 519, 529, 148 USPQ 689, 693 (1966). Indeed, "[t]he basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility." Id. at 534, 148 USPQ at 695. Consequently, it is well established that a patent may not be granted to an invention unless substantial or practical utility for the invention has been discovered and disclosed. See Cross v. Iizuka, 753 F.2d 1040, 1044, 224 USPQ 739, 742 (Fed. Cir. 1985). Similarly, actual reduction to practice, which constitutes in law the final phase of invention, cannot be established absent a showing of practical utility. See Blicke v. Treves, 241 F.2d 718, 720-21, 112 USPQ 472, 474-75 (CCPA 1957).

In the pharmaceutical arts, our court has long held that practical utility may be shown by adequate evidence of any pharmacological activity. See, e.g., Nelson v. Bowler, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980); In re Krimmel, 292 F.2d 948, 952-53, 130 USPQ 215, 219 (CCPA 1961). For example, in Campbell v. Wettstein, 476 F.2d 642, 646-47, 177 USPQ 376, 379 (C.C.P.A. 1973) we stated that "[m]oreover, the interference counts contain no limitation relating to intended use or to discovered properties of the claimed compounds. Accordingly, under well-established precedent, evidence establishing substantial utility for any purpose is sufficient to show reduction to practice." The rule in Campbell was applied in Rey-Bellet v. Engelhardt, 493 F.2d

1380, 1383, 181 USPQ 453, 454 (C.C.P.A. 1974) ("Since the count contains no limitation related to any utility, evidence which would establish a substantial utility for any purpose is sufficient to show its reduction to practice.").[4] Such activity constitutes a practical utility because "[i]t is inherently faster and easier to combat illnesses and alleviate symptoms when the medical profession is armed with an arsenal of chemicals having known pharmacological activities. Since it is crucial to provide researchers with an incentive to disclose pharmacological activities in as many compounds as possible, we conclude that adequate proof of any such activity constitutes a showing of practical utility." Nelson, 626 F.2d at 856, 206 USPQ at 883; see also Krimmel, 292 F.2d at 952-53, 130 USPQ at 219.

It may be difficult to predict, however, whether a novel compound will exhibit pharmacological activity, even when the behavior of analogous compounds is known to those skilled in the art. Consequently, testing is often required to establish practical utility. See, e.g., Blicke, 241 F.2d at 720, 112 USPQ at 475. But the test results need not absolutely prove that the

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[4] Strictly speaking, this articulation of the standard (i.e. evidence of any pharmacological activity) applies only when the count does not recite a particular utility. See Rey-Bellet v. Engelhardt, 493 F.2d 1380, 1383, 181 USPQ 453, 454 (CCPA 1974). In contrast, when the count recites a particular utility, practical utility requires an adequate showing of the recited utility. In this case, the compound count does not recite a particular utility, and practical utility is thus satisfied by evidence of any pharmacological activity. The method count, however, does recite a particular utility (i.e., cholesterol inhibition in patients in need of such treatment), and practical utility for that count therefore requires an adequate showing of that recited utility.

compound is pharmacologically active. All that is required is that the tests be "reasonably indicative of the desired [pharmacological] response." Nelson, 626 F.2d at 856, 206 USPQ at 884. (emphasis added). In other words, there must be a sufficient correlation between the tests and an asserted pharmacological activity so as to convince those skilled in the art, to a reasonable probability, that the novel compound will exhibit the asserted pharmacological behavior. See Cross, 753 F.2d at 1050, 224 USPQ at 747.

The ultimate determination of reduction to practice is a question of law which we review de novo. See Holmwood v. Sugavanam, 948 F.2d 1236, 1238, 20 USPQ2d 1712, 1714 (Fed. Cir. 1991). In contrast, we review the Board's factual findings supporting its legal conclusions about reduction to practice for clear error. Id. Whether a practical utility has been established for a novel compound is a question of fact. See Cross, 753 F.2d at 1044 n.7, 224 USPQ at 742 n.7. We therefore review the Board's findings with respect to practical utility for clear error.

A

This court has, on many occasions, considered the type and quantity of testing necessary to establish a practical utility for a novel compound. Although each case of practical utility must be considered on its own facts, see, e.g., Blicke, 241 F.2d at 720, 112 USPQ at 475, examination of our precedent illustrates the degree of proof which we have deemed sufficient to establish practical utility in the past.

The facts in this case are substantially similar to those in Cross v. Iizuka, 753 F.2d 1040, 224 USPQ 739 (Fed. Cir. 1985). There, we expressly held that, in appropriate circumstances, evidence of in vitro testing could adequately establish a practical utility.[5] As we there explained:

> We perceive no insurmountable difficulty, under appropriate circumstances, in finding that the first link in the screening chain, in vitro testing, may establish a practical utility for the compound in question. . . . [U]nder the circumstances of the instant case, where [an application] discloses an in vitro utility, . . . and where the disclosed in vitro utility is supplemented by the similar in vitro and in vivo pharmacological activity of structurally similar compounds, . . . we agree with the Board that this in vitro utility is sufficient to [establish utility].

Id. at 1051, 224 USPQ at 748. Thus, Cross holds that positive in vitro results, in combination with a known correlation between such in vitro results and in vivo activity, may be sufficient to establish practical utility.

Fujikawa does not argue that the law as stated in Cross is incorrect. Instead, Fujikawa contends that Wattanasin has failed to establish an adequate correlation between in vitro and in vivo results in the field of cholesterol-inhibiting compounds to permit Wattanasin to rely on affirmative in vitro results to establish a practical utility for the compound.

The Board determined that Wattanasin had reduced the compound count to practice in October 1987 when several compounds falling within the scope of the genus count exhibited activity in vitro.

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[5] While Cross involved a constructive reduction to practice, the same general principles are applicable to an actual reduction to practice. See id. at 1046 n.14, 224 USPQ at 744 n.14.

In reaching that conclusion, the Board relied on testimony from those skilled in the art that the in vitro results convinced them that the claimed compounds would exhibit the desired pharmacological activity when administered in vivo. This included testimony that "in vivo activity is typically highly correlatable to a compound's in vitro activity" in this field. The facts in this case are thus analogous to the ones in Cross where the court relied on positive in vitro test results in combination with a known correlation between such in vitro tests and in vivo activity to support a finding of practical utility.

To counter the Board's decision, Fujikawa points to the testimony of its own expert, Dr. Holmlund, who testified that:

> there is a reasonable element of doubt that some elements may be encountered which are active in the in vitro assay, but yet inactive in the in vivo assay.

According to Fujikawa, this testimony establishes that the in vitro tests were insufficient to prove practical utility.

We note first that to the extent the record presents a conflict in the testimony, the Board was well within its discretion as fact finder to credit the testimony of Wattanasin's witnesses over that of Fujikawa's. More fundamentally, however, we do not consider Dr. Holmlund's testimony as a whole to contradict the Board's finding. Of course, it is possible that some compounds active in vitro may not be active in vivo. But, as our predecessor court in Nelson explained, a "rigorous correlation" need not be shown in order to establish practical utility; "reasonable correlation" suffices. Here, even Dr. Holmlund implied in the

question and answer immediately following the above quoted portion of his testimony, that such a "reasonable correlation" exists:

> Q. Would you accept, subject to exceptions that might occur, that the failure to find [in vivo] activity would be considered an exception, that there would be a reasonable expectancy [that in vitro activity implies that the compound will be active in vivo]?
> A. I think I would probably accept that.

Fujikawa also cites two articles[6] which it claims show that there is no reliable relationship between in vitro results and in vivo results in cholesterol inhibiting compounds similar to the ones at issue in this case. We disagree. Although the Sliskovic article, for example, teaches that in vitro testing is sometimes not a good indicator of how potent a compound will be in vivo, it does imply that compounds which are active in vitro will normally exhibit some in vivo activity. See Sliskovic, at 370. Similarly, the Kathawala article expressly states: "For most substances, although not for all, the relative potency determined in in vitro microsomal assay against HMG-CoA reductase parallels the in vivo activity in rats for the inhibition of ^{14}C-acetate into sterols." Kathawala at 136-37. On these facts, we hold that the Board did not err in finding that Wattanasin's in vitro tests established a practical utility for the genus recited in the compound count.

B

Turning to the method count, the Board found that Wattanasin

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[6] The two articles are D. R. Sliskovic et al, Inhibitors of Cholesterol Biosynthesis, 34 J. Med. Chemistry 367 (1991) (Sliskovic); and F. G. Kathawala, HMG-CoA Reductase Inhibitors: An Exciting Development in the Treatment of Hyperlipoproteinemia, 11 Medicinal Research Reviews 121 (1991) (Kathawala).

reduced the method to practice in December 1987 when successful in vivo testing of the compound was completed. This finding, too, was based on testimony that the in vivo data for one of the compounds tested, 64-935, showed significant cholesterol inhibiting activity in the laboratory rats tested.

Fujikawa challenges the Board's holding by referring to an anomaly in the test data of the 64-935 compound which it contends undercuts the reliability of the in vivo tests. In particular, Fujikawa points to the fact that the compound's potency was less at a dosage of 0.3 mg than it was at a dosage of 0.1 mg. On the basis of this aberration, Fujikawa's expert, Dr. Holmlund, testified that this test data was unreliable and could not support a finding that the compound was pharmacologically active.

It is clear from the Board's opinion, however, that to the extent Dr. Holmlund was testifying that this aberration would lead one of ordinary skill to completely reject these test results, the Board did not accept his testimony. This decision of the Board was not clear error. Admittedly, the decreased potency at 0.3 mg is curious. The question remains, however, as to how much this glitch in the data would undercut the persuasiveness of the test results as a whole in the mind of one of ordinary skill. Each party presented evidence on this point and the Board resolved this disputed question of fact by finding that the test results as a whole were sufficient to establish pharmacological activity in the minds of those skilled in the art. In doing so, the Board properly exercised its duty as fact finder, and we therefore affirm its

finding on this point.[7]

As noted above, Fujikawa does not challenge the Board's conclusions that Wattanasin conceived prior to Fujikawa's effective date or that Wattanasin pursued the invention with diligence from just prior to Fujikawa's date until his reductions to practice in October and December 1987. Consequently, we affirm the Board's finding that Wattanasin has shown conception coupled with diligence from just prior to Fujikawa's effective date of August 20, 1987 up to the date he reduced the invention to practice in October 1987, for the compound, or December 1987, for the method.

IV

Having determined that Wattanasin was the de facto first inventor, the remaining question before the Board was whether Wattanasin had suppressed or concealed the invention between the

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[7] Before the Board, Fujikawa additionally argued that in vivo testing cannot establish reduction to practice of the method count because it does not fulfill every limitation of the count. In particular, Fujikawa argued that only human beings can be considered "patients in need of" cholesterol biosynthesis inhibition, as required by the count. As noted above, the Board rejected this argument and held that the term "patient" in the count is broad enough to encompass mammals, such as the laboratory rats tested in vivo.

In its brief to this court, Fujikawa renews this argument. In the process, however, Fujikawa seems to add an additional ground which it did not argue before the Board below. We are not absolutely certain, but it appears that Fujikawa is now contending that in vivo testing cannot constitute a reduction to practice because the rats tested were, from all that would appear, healthy animals, rather than animals in need of cholesterol biosynthesis inhibition. To the extent that Fujikawa's argument before this court is directed to this novel ground not raised below, we consider the argument waived and decline to address it. To the extent that Fujikawa is still arguing that the count requires administration of the compound to a human, we disagree, and affirm the Board's decision on this point.

time he reduced to practice and the time he filed his patent application. Suppression or concealment of the invention by Wattanasin would entitle Fujikawa to priority. 35 U.S.C. § 102(g).

Suppression or concealment is a question of law which we review de novo. Brokaw v. Vogel, 429 F.2d 476, 480, 166 USPQ 428, 431 (CCPA 1970). Our case law distinguishes between two types of suppression and concealment: cases in which the inventor deliberately suppresses or conceals his invention, and cases in which a legal inference of suppression or concealment is drawn based on "too long" a delay in filing a patent application. Paulik v. Rizkalla, 760 F.2d 1270, 1273, 226 USPQ 224, 226 (Fed. Cir. 1985) (in banc).

Fujikawa first argues that there is evidence of intentional suppression or concealment in this case. Intentional suppression refers to situations in which an inventor "designedly, and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public." Id. (quoting Kendall v. Winsor, 62 U.S. (21 How.) 322, 328 (1858)). Admittedly, Sandoz was not overly efficient in preparing a patent application, given the time which elapsed between its reduction to practice in late 1987 and its ultimate filing in March 1989. Intentional suppression, however, requires more than the passage of time. It requires evidence that the inventor intentionally delayed filing in order to prolong the period during which the invention is maintained in secret. Cf. Peeler v. Miller, 535 F.2d 647, 653-54, 190 USPQ 117, 122 (CCPA 1976) (implying that intentional

suppression requires showing of specific intent). Fujikawa presented no evidence that Wattanasin delayed filing for this purpose. On the contrary, all indications are that throughout the period between reduction to practice and filing, Sandoz moved slowly (one might even say fitfully), but inexorably, toward disclosure. We therefore hold that Wattanasin did not intentionally suppress or conceal the invention in this case.

Absent intentional suppression, the only question is whether the 17 month period between the reduction to practice of the compound, or the 15 month period between reduction to practice of the method, and Wattanasin's filing justify an inference of suppression or concealment. See id. The Board held that these facts do not support such an inference. As the Board explained: "In our view, this hiatus in time is not sufficiently long to raise the inference that Wattanasin suppressed or concealed the invention considering the nature and complexity of the invention here."

Fujikawa attacks this finding of the Board on two grounds. First, it contends that the Board should not have held that a 15 or 17 month delay is per se insufficient to raise an inference of suppression or concealment without examining the circumstances surrounding the delay and whether, in view of those circumstances, Wattanasin's delay was reasonable. Second, Fujikawa argues that the Board failed to consider evidence that Wattanasin was spurred to file by the issuance of a patent to a third party, Picard, directed to the same genus of compounds invented by Wattanasin. Evidence that a first inventor was spurred to disclose by the

activities of a second inventor has always been an important factor in priority determinations because it creates an inference that, but for the efforts of the second inventor, "the public would never have gained knowledge of [the invention]." Brokaw, 429 F.2d at 480, 166 USPQ at 431. Here, however, the Board expressly declined to consider the evidence of spurring because it held that spurring by a third party who is not a party to the interference is irrelevant to a determination of priority as between Wattanasin and Fujikawa. We first address Fujikawa's arguments concerning spurring.

A

We are not certain that the Board is correct that third party spurring is irrelevant in determining priority. After all, "[w]hat is involved here is a policy question as to which of the two rival inventors has the greater right to a patent." Brokaw, 429 F.2d at 480, 166 USPQ at 430. Resolution of this question could well be affected by the fact that one of the inventors chose to maintain his invention in secrecy until disclosure by another spurred him to file, even when the spurrer was a third party not involved in the interference. We need not resolve that question here, however, because we hold that no reasonable fact finder could have found spurring on the facts of this case. The only evidence in the record on the question of spurring is the testimony of Ms. Geisser who expressly testified that she had already begun work on the Wattanasin draft application before she learned of Picard's patent, in other words, that she had not been spurred by Picard.

Consequently, we leave the question of the relevance of third party spurring for another case.

B

Fujikawa's other argument also requires us to examine the evidence of record in this case. As Fujikawa correctly notes, this court has not set strict time limits regarding the minimum and maximum periods necessary to establish an inference of suppression or concealment. See Correge v. Murphy, 705 F.2d 1326, 1330, 217 USPQ 753, 756 (Fed. Cir. 1983). Rather, we have recognized that "it is not the time elapsed that is the controlling factor but the total conduct of the first inventor." Young v. Dworkin, 489 F.2d 1277, 1285, 180 USPQ 388, 395 (CCPA 1974) (Rich, J., concurring). Thus, the circumstances surrounding the first inventor's delay and the reasonableness of that delay are important factors which must be considered in deciding questions of suppression or concealment. See, e.g., id. at 1281-82, 180 USPQ at 392-93. Fujikawa again correctly notes that the Board's opinion gives short shrift to the question of whether this delay on the facts of this case was reasonable. In seeking reversal of the Board's decision, Fujikawa asks us to assess the factual record for ourselves to determine whether Wattanasin engaged in sufficient disclosure-related activity to justify his 17-month delay in filing. The facts of record, however, do not support Fujikawa's position.

In our view, the circumstances in this case place it squarely within the class of cases in which an inference of suppression or concealment is not warranted. We acknowledge, of course, that each

case of suppression or concealment must be decided on its own facts. Still, the rich and varied case law which this court has developed over many years provides some guidance as to the type of behavior which warrants an inference of suppression or concealment. See Paulik, 760 F.2d at 1280, 226 USPQ at 231-32 (Rich, J., concurring). In this case Wattanasin delayed approximately 17 months between reduction to practice and filing. During much of that period, however, Wattanasin and Sandoz engaged in significant steps towards perfecting the invention and preparing an application. For example, we do not believe any lack of diligence can be ascribed to Wattanasin for the period between October and December 1987 when in vivo testing of the invention was taking place. See Young, 489 F.2d at 1281, 180 USPQ at 392. Similarly, at its first opportunity following the in vivo testing, the Sandoz patent committee approved Wattanasin's invention for filing. This takes us up to the end of January 1988.

Over the next several months, until May 1988, the Sandoz patent department engaged in the necessary collection of data from the inventor and others in order to prepare Wattanasin's patent application. We are satisfied from the record that this disclosure-related activity was sufficient to avoid any inference of suppression or concealment during this period.[8] Cf. Correge,

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[8] Our conclusion in this regard is based, in small part, on the testimony of Mr. Melvyn Kassenoff, a lawyer in Sandoz's patent department. Before the Board, Fujikawa challenged large parts of this testimony as inadmissible. In this opinion we therefore rely only on those portions of the testimony which even Fujikawa concedes are admissible, i.e., testimony relating to Mr. (continued...)

705 F.2d at 1330-31, 217 USPQ at 756 (five significant acts of disclosure-related activity over the course of seven months sufficient to rebut any inference of suppression). Also, as noted above, the record indicates that by August 1988, Ms. Geisser was already at work preparing the application, and that work continued on various drafts until Wattanasin's filing date in March 1989. Thus, the only real period of unexplained delay in this case is the approximately three month period between May and August of 1988.

Given a total delay of 17 months, an unexplained delay of three months, the complexity of the subject matter at issue, and our sense from the record as a whole that throughout the delay Sandoz was moving, albeit slowly, towards filing an application, we conclude that this case does not warrant an inference of suppression or concealment. Consequently, we affirm the Board on this point.

C

Finally, Fujikawa contends that assuming in vitro tests are sufficient to establish reduction to practice, Wattanasin reduced the compound count to practice in 1984 when he completed in vitro testing of his first three compounds falling within the scope of the count. If so, Fujikawa argues, the delay between reduction to practice and filing was greater than four years, and an inference

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[8](...continued)
Kassenoff's legal services rendered in connection with the prosecution of Wattanasin's application.

of suppression or concealment is justified.[9]

We reject this argument in view of Paulik v. Rizkalla, 760 F.2d 1270, 226 USPQ 224 (Fed. Cir. 1985) (in banc). In Paulik, we held that a suppression or concealment could be negated by renewed activity prior to an opposing party's effective date. There, inventor Paulik reduced his invention to practice and submitted an invention disclosure to his employer's patent department. For four years the patent department did nothing with the disclosure. Then, just two months before Rizkalla's effective date, the patent department allegedly picked up Paulik's disclosure and worked diligently to prepare a patent application which it ultimately filed. See id. at 1271-72, 226 USPQ at 224-25. We held that although Paulik could not rely on his original date of reduction to practice to establish priority, he could rely on the date of renewed activity in his priority contest with Rizkalla. In large measure, this decision was driven by the court's concern that denying an inventor the benefit of his renewed activity, might "discourage inventors and their supporters from working on projects that had been 'too long' set aside, because of the impossibility of relying, in a priority contest, on either their original work or their renewed work." Id. at 1275-76, 226 USPQ at 227-28.

Paulik's reasoning, if not its holding, applies squarely to this case. A simple hypothetical illustrates why this is so. Imagine a situation similar to the one facing Sandoz in early 1987.

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[9] This argument, of course, relates only to the compound count, since, as explained above, the method count was not reduced to practice until the in vivo testing in December 1987.

A decisionmaker with limited funds must decide whether additional research funds should be committed to a project which has been neglected for over two years. In making this decision, the decisionmaker would certainly take into account the likelihood that the additional research might yield valuable patent rights. Furthermore, in evaluating the probability of securing those patent rights, an important consideration would be the earliest priority date to which the research would be entitled, especially in situations where the decisionmaker knows that he and his competitors are "racing" toward a common goal. Thus, the right to rely on renewed activity for purposes of priority would encourage the decisionmaker to fund the additional research. Conversely, denying an inventor the benefit of renewed activity would discourage the decisionmaker from funding the additional research.

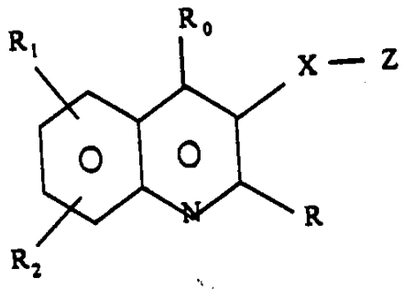
Here, Wattanasin returned to his abandoned project well before Fujikawa's effective date and worked diligently towards reducing the invention to practice a second time. For the reasons explained above, we hold that, on these facts, Wattanasin's earlier reduction to practice in 1984 does not bar him from relying on his earliest date of renewed activity for purposes of priority.

V

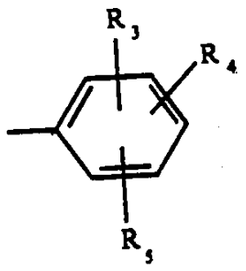
Fujikawa also appeals the Board's decision denying Fujikawa's motion to add a sub-genus count to the interference. The Board denied the motion because it found that Wattanasin's disclosure did not sufficiently describe Fujikawa's proposed count. Whether a disclosure contains a sufficient written description to support a

proposed count, is a question of fact which we review for clear error. Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). We affirm the Board's denial of Fujikawa's motion because we do not believe it was clearly erroneous.

Wattanasin's application disclosed compounds of the following structure:



wherein each of R and R_0 is, independently, C_{1-6} alkyl (primary, secondary, or tertiary), C_{3-7} cycloalkyl, or the following ring,



and each of R_1, R_2, R_3, R_4, and R_5 is, independently, hydrogen, C_{1-4}alkyl, C_{1-4}alkoxy, trifluoromethyl, fluoro, chloro, phenoxy, benzyloxy, or hydroxy.

In addition to this genus of compounds, Wattanasin disclosed as his preferred embodiments that: R_1 and R_2 are most preferably hydrogen, R_0 is most preferably phenyl, 4-fluorophenyl, or 3,5-dimethylphenyl; and R is most preferably methyl[10] or isopropyl.[11]

Essentially, Fujikawa's proposed sub-genus is directed to compounds of the above structure in which R is cyclopropyl[12] and R_0 is 4-fluorophenyl. In other respects, the parties do not dispute that the particular constituents recited in Fujikawa's proposed count are adequately disclosed in Wattanasin's application. Thus, for example, both Wattanasin's most preferred embodiment and Fujikawa's proposed count describe R_1 and R_2 as hydrogen.

In denying Fujikawa's motion, the Board first noted that the proposed sub-genus was not disclosed ipsis verbis by Wattanasin. Specifically, the Board noted that Wattanasin preferred methyl and isopropyl for R, rather than cyclopropyl as in the proposed count. In addition, Wattanasin listed three preferred choices for R_0 only one of which was 4-fluorophenyl and gave no indication in his application as to whether he would prefer any one of the choices over the other two.

As the Board recognized, however, ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of

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[10] Methyl is another name for C_1 alkyl.

[11] isopropyl is another name for C_3 alkyl.

[12] cyclopropyl is another name for C_3 cycloalkyl.

the subject matter in question. In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). In other words, the question is whether Wattanasin's "application provides adequate direction which reasonably [would lead] persons skilled in the art" to the sub-genus of the proposed count. Id. at 1352, 196 USPQ at 467.

Many years ago our predecessor court graphically articulated this standard by analogizing a genus and its constituent species to a forest and its trees. As the court explained:

> It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail . . . to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.

In re Ruschig, 379 F.2d 990, 994-95, 154 USPQ 118, 122 (CCPA 1967).

In finding that Wattanasin's disclosure failed to sufficiently describe the proposed sub-genus, the Board again recognized that the compounds of the proposed count were not Wattanasin's preferred, and that his application contained no blazemarks as to what compounds, other than those disclosed as preferred, might be of special interest. In the absence of such blazemarks, simply describing a large genus of compounds is not sufficient to satisfy the written description requirement as to particular species or sub-genuses. See, e.g., id. at 994, 154 USPQ at 122 ("Specific claims to single compounds require reasonably specific supporting disclosure and while . . . naming [each species] is not essential, something more than the disclosure of a class of 1000, or 100, or even 48 compounds is required.").

Before this court, Fujikawa challenges the Board's denial of its motion on two grounds. First, Fujikawa persists in arguing that its proposed count is disclosed ipsis verbis in Wattanasin's application. The basis for this contention seems to be that Wattanasin lists cyclopropyl as one possible moiety for R in his disclosure of the genus. Clearly, however, just because a moiety is listed as one possible choice for one position does not mean there is ipsis verbis support for every species or sub-genus that chooses that moiety. Were this the case, a "laundry list" disclosure of every possible moiety for every possible position would constitute a written description of every species in the genus. This cannot be because such a disclosure would not "reasonably lead" those skilled in the art to any particular species. We therefore reject Fujikawa's argument on this point.

Second, Fujikawa claims that the Board erred in finding that Wattanasin's disclosure contained insufficient blazemarks to direct one of ordinary skill to the compounds of its proposed count. Specifically, Fujikawa points out that with respect to practically every position on the compound, the proposed count recites at least one of Wattanasin's preferred choices. Even with respect to position R, Fujikawa further explains, one of ordinary skill would have been moved by Wattanasin's disclosure to substitute cyclopropyl for isopropyl because the two substituents are isosteric.

While Fujikawa's arguments are not without merit, we cannot say, on this record, that the Board's decision was clearly

erroneous. As the Board pointed out, Fujikawa's proposed sub-genus diverges from Wattanasin's preferred elements at least with respect to position R. Although, in hindsight, the substitution of cyclopropyl for isopropyl might seem simple and foreseeable, Wattanasin's disclosure provides no indication that position R would be a better candidate for substitution than any other. Thus, faced with Wattanasin's disclosure, it was not clear error to hold that one of ordinary skill would not be led to Fujikawa's sub-genus in particular.

Were we to extend Ruschig's metaphor to this case, we would say that it is easy to bypass a tree in the forest, even one that lies close to the trail, unless the point at which one must leave the trail to find the tree is well marked. Wattanasin's preferred embodiments do blaze a trail through the forest; one that runs close by Fujikawa's proposed tree. His application, however, does not direct one to the proposed tree in particular, and does not teach the point at which one should leave the trail to find it. We therefore affirm the Board's denial of Fujikawa's motion.

VI

For the reasons we set forth above, the decision of the Board is, in all respects,

AFFIRMED.

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

WATTANASIN	:	
	:	**INTERFERENCE 102,975**
V.	:	**EXAMINER-IN-CHIEF:**
	:	**MICHAEL SOFOCLEOUS**
FUJIKAWA ET AL	:	

REQUEST FOR RECONSIDERATION OF FINAL DECISION,
37 CFR §1.658

HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, DC 20231
BOX INTERFERENCE

SIR:

Pursuant to the provisions of the above-captioned Rule, the party Fujikawa respectfully requests reconsideration of the aspects of the final decision of the Board, dated January 31, 1995, which Fujikawa respectfully submits reflects points misapprehended or overlooked by the Board in rendering its decision. Fujikawa respectfully notes that it will seek court review of this decision, and accordingly, even in the event this Request For Reconsideration does not result in a modification of the decision on final hearing,

a full explanation of the consideration of the points identified herein is respectfully requested, so that the court review sought can be full and complete, without a clear need for remand.

As points misapprehended or overlooked, Fujikawa identifies the following:

> 1. The Board appears to have misapprehended the nature of the disclosure of the involved application of the party Wattanasin in concluding, "it is clear from the foregoing that the application does not describe in *ipsis verbis* the compounds of proposed claims 11 and 12 where R is cyclopropyl." Fujikawa does not seek reconsideration of the court's conclusion that the application lacks "blaze marks or any motivation to guide one skilled in the art to select the cyclopropyl compounds of proposed claims 11 and 12 from Wattanasin's broad generic disclosure". While Fujikawa believes this decision to be in error, there does not appear to be anything misapprehended or overlooked with respect to this aspect of the decision. (This issue applies solely to

Interference 102,648).

2. The Board appears to have overlooked Fujikawa's Motion to Suppress the Supplemental Declaration of Engstrom at WR207-208 and exhibit Q discussed therein, on the grounds that the Engstrom declaration was not timely submitted, was submitted belatedly without an explanation of good cause, or an identification of how the error which is alleged to support the submission occurred.

3. The Board's decision appears to have overlooked the arguments presented by Fujikawa stressing direct evidence of suppression and concealment on the part of Wattanasin. The final decision of the Board deals only with inferred suppression. The Fujikawa Brief is not so confined.

Each of these issues is discussed, in turn, below.

I. CYCLOPROPYL AS AN IDENTITY FOR R DOES APPEAR, *IPSISSIMUS VERBIS*

On page 9 of the Final Decision of the Board in Interference

102,648, after quoting language appearing in the Wattanasin patent application, the decision reflects

> 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.

It is respectfully submitted that the Board has misapprehended the nature of the Wattanasin disclosure. 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, *ipsissimus verbis* (*ipsis verbis* is a contracted form of the original latin) in the Wattanasin application as filed. Indeed, the remaining identities appear described not only *ipsissimus verbis*, but exemplified as well. Thus, the Board holds that the term "R is cyclopropyl" does not appear *ipsissimus verbis*. In this, the Board may have misapprehended the disclosure of the Wattanasin application, a pertinent portion of which appears on page 8 of the Board's decision. That disclosure includes the statement

> wherein each of R and R_0 is independently C_{1-6} alkyl (primary, secondary or tertiary), C_{3-7} cycloalkyl....

The testimony of Wattanasin confirms that C_3 is cyclopropyl. Thus, the Wattanasin application does in fact include, *ipsissimus verbis*, a description of compounds of the type proposed in claims 11 and 12 wherein "R is cyclopropyl". Fujikawa does acknowledge that there is no exemplification of such compounds. It is not believed, however, that exemplification is necessary.

It is well established that the disclosure of a range identifies at least two points, the beginning and end point of the range. This is true of patent applications, and documents other than patent applications. In re Wertheim, 191 USPQ 90, 90-99 (CCPA 1976) and In re Malagerí, 183 USPQ 549, 553, (CCPA 1974). Applying such analysis to the disclosure in Wattanasin of substituent R, it is easy to note that this disclosure specifically identifies, *ipsissimus verbis*, at least 4 compounds, C_1 alkyl (methyl), C_6 alkyl (hexyl), C_3 cycloalkyl (cyclopropyl) and C_7 cycloalkyl (cycloheptyl). While all four of the embodiments do not appear as examples in the Wattanasin application, that is not to say that the language recited in the proposed claims does not appear, *ipsissimus verbis*, in the application as filed.

It is axiomatic that the application is directed to those of skill in the art, and the test is whether or not those of ordinary skill in the art would understand the subject matter to be

described, in this case, *ipsissimus verbis*. In re Edwards, 196 USPQ 465 (CCPA 1978). There is testimony as to what those of ordinary skill in the art would understand the Wattanasin disclosure to describe, *ipsissimus verbis*. See the testimony of Wattanasin himself, FR116, cited at page 22 of Fujikawa's Brief, and FR294, the testimony of Geisser

> Certainly that phrase "C3-7 cycloalkyl" identifies two possible compounds, one cycloalkyl compound with three carbon atoms and one with seven: is that correct?
>
> A. Yes.

The term *ipsissimus verbis* refers to a disclosure appearing in so many words, rather than, e.g., substantially appearing. The terms C3 cycloalkyl and cyclopropyl are legal equivalents, as noted above. This term, as the identity for R, literally appears in the disclosure, and need not be inferred. Thus, this disclosure appears *ipsis verbis*. Reconsideration is respectfully requested.

II. THE ENGSTROM SUPPLEMENTAL DECLARATION

The decision in both interferences, treats, and denies, the Fujikawa motion to suppress the Engstrom Declaration on the grounds that it was not supported as required by the Federal Rules of

Evidence. The decision in both interferences also heavily relies not on the Engstrom Declaration, but rather the Supplemental Engstrom Declaration, see footnote 3, page 20 of the decision in Interference 102,648 and footnote 4 in the decision in Interference 102,975. Fujikawa moved to suppress this document on the grounds that its submission was untimely, that the error relied upon as a grounds for correction was not explained, and that no good cause was shown for submitting it at the time it was submitted. Accordingly, Fujikawa moves to suppress this document, which is critical to the decision in both interferences.

Specifically, the original Engstrom Declaration, which does not contain evidence of a reduction to practice with respect to 64-935 or any other compound (the 0.49 value assigned cannot be supported on the basis on the data provided in the original declaration, see the Homland testimony with respect thereto) was not submitted until after the period for testimony by Wattanasin closed. In response to the Notice by Fujikawa of an intent to argue suppression, abandonment, or concealment, Wattanasin sought, and received, and additional testimony period, <u>confined to the submission of testimony relevant to the issues of abandonment, suppression and concealment</u>.

The Supplemental Engstrom Declaration, which corrects an

earlier Engstrom Declaration, does not pertain to the issues of suppression, abandonment or concealment. It does not reflect on any of these issues at all. Rather, it changes five numbers appearing in the original Engstrom Declaration and Exhibits, relating to activity.

The Motion To Suppress presents the arguments apparently overlooked, and whose treatment on the record Fujikawa now seeks. They are not repeated herein, other than to note that the arguments are independent of the arguments with respect to the original Declaration. The untimely submission of the Declaration, coupled with a total absence of reasoning or excuse of the submission, or an explanation of the error corrected by the submission and when the error that was the basis for the preparation of the Supplemental Declaration was detected, leads to the conclusion that this Declaration must be suppressed. Reconsideration is respectfully requested.

III. THERE IS DIRECT EVIDENCE OF SUPPRESSION

In the decisions in Interference 102,648 and 102,975, the Board disposes of the issue of suppression and concealment, raised by Fujikawa in its Brief, on the grounds that the delay between reduction to practice and filing is simply not long enough to raise

an inference of suppression, see, e.g., page 26 of the Decision in the Interference 102,648. Yet, Fujikawa's arguments with respect to suppression and concealment were not based on inference alone. Rather, Fujikawa specified evidence of deliberate steps taken to a) prevent publication or public access to information regarding the invention, and b) deliberately delayed preparation of the patent application. Moreover, Fujikawa relied on indirect evidence of suppression or concealment, spurring, Sandoz not actually moving toward the preparation of an application until issuance of the '419 patent. These arguments appear beginning on page 71 of Fujikawa's main brief, and are not considered in the Board's Decision. It is concluded that the Board simply overlooked this aspect of the Brief.

Again and again, Sandoz took deliberate action to prevent publication of information with regard to the invention. Thus, Wattanasin testified that he had been told not to publish information regarding his invention even after the date of conception found by the Board herein, and indeed, well after the actual reduction to practice. Further, even after the conception date, the Patent Committee again and again and again decided not to make a decision whether to proceed with the filing or not, thus extending the period in which the application was considered

secret. Even after a decision was made to bring the "secret" forward in the form of an application, Sandoz, through its agent, repeatedly selected work of lesser priority, work docketed in at a later date, and unrelated to the Wattanasin invention, rather than work on the Wattanasin case to bring it forward.

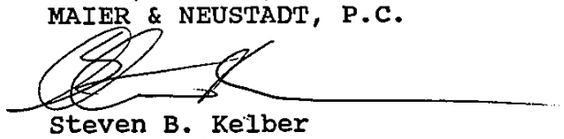
That this is in fact a classic case of suppression is brought home by the fact that the issuance of the '419 patent for Warner-Lambert was the spur that actually caused Sandoz to begin work on a patent application. Inasmuchas, on page 80 of it's brief, Fujikawa specifically noted that this is not a common case, where direct evidence of intention to suppress is difficult to find, but was in fact based on admissions against interest by Wattanasin, and evidence of deliberate attempts to suppress, Fujikawa respectfully submits that, for purposes of a record on appeal if for no other purpose, this argument should be considered. Reconsideration of the Fujikawa arguments with respect to suppression or concealment, and a decision on the record, is respectfully requested.

With respect to this point, it is believed that the date of suppression should be measured from the date of conception, not the date of reduction to practice. In this particular case, Wattanasin must necessarily rely, and the Board has held, that Wattanassin's date "of invention" is a date beginning "early March 1987", page 19

of the decision in Interference 102,648. In any event, the invention date is no later than August 19, 1987, see page 21 of the same decision. This would make the length of delay 18 months, not 16, and consideration of this greater length of delay, which is longer than a delay adequate to raise an inference of suppression in other cases is sought. Accordingly, the Board's Reconsideration of the direct evidence of suppression, and the actual period involved with respect to inferring suppression, is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **REQUEST FOR RECONSIDERATION OF FINAL DECISION, 37 CFR §1.658**

2. **CERTIFICATE OF SERVICE**

were served upon Counsel for Wattanasin as follows:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FACSIMILE and FEDERAL EXPRESS, this 28th day of February 1995.

STEVEN B. KELBER

Interference 102,975
Attorney Docket No.: 49-125-0 DIV
Wattanasin v. Fujikawa et al
SBK/vdb

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

#66

WATTANASIN

v. Patent Interference No. 102,975

FUJIKAWA et al. Administrative Patent Judge: Sofocleous

v.
FUJIKAWA et al.

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Washington, D. C.

WATTANASIN REPLY to

FUJIKAWA REQUEST FOR RECONSIDERATION

In a Final Decision dated January 31, 1995, the Board awarded judgment with respect to the subject matter of count 1, the sole count at issue in the present interference, to Sompong Wattanasin, the junior party. The Board ruled that Wattanasin was entitled to a patent containing claims 1-7 and 10 of its involved application Serial No. 07/498,301, and Fujikawa et al. (hereinafter "Fujikawa") were not entitled to claim 1 of their USP 5,011,930, nor to a patent containing claims 1-9, 11-34, 36, 39 and 40 of their involved application Serial No. 07/233,752.

On February 28, 1995, Fujikawa filed a Request for Reconsideration, indicating that they will be appealing the Board's decision, and seeking reconsideration confined to three issues allegedly "misapprehended" or "overlooked" by the Board.

These three issues comprise the following:

1. Whether the Board "misapprehended" the Wattanasin application by not finding "*ipsis verbis*" 35 USC 112 written description support therein for Fujikawa's proposed claims 11 and 12 corresponding to its proposed added count directed to cyclopropyl-substituted quinoline compounds[1].

2. Whether the Board "overlooked" Fujikawa's attempt to suppress the Engstrom *Supplemental* Declaration and accompanying Exhibit Q even while the Board denied Fujikawa's motion to suppress the *original* Engstrom Declaration and accompanying Exhibit K-1.

3. Whether the Board "overlooked" Fujikawa's argument that "deliberate" acts of supression were carried out by Wattanasin prior to the filing of the involved Wattanasin application, and even prior to a reduction to practice.

With respect to the above, Wattanasin responds as follows:

1. Literal Support.

As the Board specifically indicated in its Final Decision in companion Interference No. 102,648 (at 7), the proposed Fujikawa claims 11 and 12 are directed to compounds of the following structural formula:

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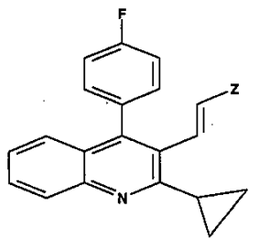
[1] This issue is addressed by the Board in the Final Decision in companion Interference No. 102,648 at pp. 6-11.



[where Z is a lactone or dihydroxy or keto-hydroxy side chain, as defined in claim 1 of the involved Fujikawa application]

In its analysis, the Board first looked to the Wattanasin application for "*ipsis(sima) verbis*" -- i.e. literal -- support for the Fujikawa claims. Finding neither actual disclosure nor examples, the Board, far from closing its inquiry, continued with a close examination of the Wattanasin disclosure for "blazemarks or motivation" which otherwise would guide one skilled in the art to select the cyclopropyl compounds of the proposed claims from Wattanasin's generic disclosure. The Board concluded that the Wattanasin disclosure was also lacking not only in a literal disclosure of cyclopropyl-substituted compounds, but also in the requisite direction or motivation to prepare such compounds.

Fujikawa, narrowly focusing for purposes of reconsideration on the Board's finding of no literal support for its proposed claims, contends that the Board must have "misapprehended" the Wattanasin disclosure of a C_{3-7}cycloalkyl substituent to arrive at this conclusion.

However, Fujikawa's argument relies on an apparent mischaracterization of the Board's actual holding. That is, while Fujikawa in their Request for Reconsideration represent the Board as holding, in Fujikawa's words, "that the term 'R is cyclopropyl' does not appear *ipsissimus verbis*" [underlining supplied] (Req. Recon. at 4), what the Board actually said -- in *ipsis verbis*, if you will -- is that:

> "It is clear from the foregoing that the application does not describe in *ipsis verbis* the compounds of proposed claims 11 and 12 where R is cyclopropyl...In our view, the Wattanasin application would not reasonably lead one of ordinary skill to the compounds of claims 11 and 12 where R is cyclopropyl, i.e., the application does not reasonably convey to those skilled in the art that Wattanasin invented the compounds [underlining supplied]."

Final Decision in Inteference No. 102,648, at 9.

Thus the Board recognized that there can be a critical difference for section 112 written description purposes, between a disclosure of a particular substituent (assuming arguendo that Wattanasin even made such disclosure), and disclosure of a compound containing that particular substituent among others (e.g., 4-fluorophenyl), which introduces an element of selection, as the Board observed.

In essence, Fujikawa are alleging that the Board has made a mistake of fact in interpreting the literal content of the Wattanasin disclosure.

However, the compounds of the Fujikawa proposed claims are no more disclosed nor exemplified by Wattanasin than compounds bearing a C_7cycloalkyl substituent. In fact, were Wattanasin himself during prosecution to have sought to introduce a claim to a cyclopropyl-substituted compound, there would at least be a question whether the Wattanasin specification provided the requisite written description support for such a claim.

There is no reason why Fujikawa should be accorded any greater benefit from the Wattanasin disclosure for this interference than would be afforded to Wattanasin in ex parte prosecution.

2. Engstrom Supplemental Declaration.

The Board explicitly denied Fujikawa's motion to suppress the Engstrom Declaration and accompanying Exhibit K-1, on which decision had been deferred to final hearing. Fujikawa claims the Board "overlooked" that part of its motion seeking to remove the Engstrom *Supplemental* Declaration, which Wattanasin acknowledges was submitted during the Wattanasin reopened testimony period.

Fujikawa persists in grossly mischaracterizing the Wattanasin *Supplemental* Declaration as being, somehow, a belated attempt to shore up the *original* Engstrom Declaration, and Fujikawa also urges, cryptically, that the Supplemental Declaration entered "critically" into the Board's final decision. (Assuming arguendo this is true, then it must be concluded that the Board already implicitly denied Fujikawa's motion to suppress.)

However, reviewing for a moment the substance of the Engstrom declarations -- it is plainly obvious that the *original* Engstrom Declaration is, within its four corners, fully corroboratory of a reduction to practice of the Wattanasin compounds of the count by in vivo testing in rats. In this declaration, Engstrom describes in detail the methodology by which how the in vivo testing of the Wattanasin compounds was carried out. He refers to appended Exhibit K-1 comprising his notebook pages for the raw computer data obtained by administering a radiolabelled starting material in the cholesterol biosynthesis pathway to rats dosed with test compounds. Exhibit K-1 also contains a computer printout page from the Engstrom notebook listing the ED_{50} values computed from this raw data.[2]

Dr. Engstrom goes on -- redundantly in view of what is already in plain view on the notebook pages of Exhibit K-1 -- to tabulate the ED_{50}'s for the three tested compounds. At this point, a typographical error caused a reversal of the ED_{50} values for 64-933 and 64-935. That this is merely a typographical error is self-evident from the original data in Exhibit K-1, and if that were not enough, from the ED_{50}'s recited elsewhere on the record, beginning

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[2] For example, the raw data on notebook page 137 obtained from rats #25-30 show that a 1 mg/kg dose of compound 64-933 resulted in an average 36.3% reduction in blood cholesterol. On notebook page 138, rats #43-48 registered an average 65.8% reduction in serum cholesterol after being dosed with 1 mg/kg of the most active compound of the Wattanasin series, 64-935. (Note further that the Wattanasin compounds were tested alongside marketed fluvastatin, i.e. compound 62-320).

with page 34 of the involved Wattanasin specification, on which Dr. Wattanasin has given his oath; and continuing into Watanasin Exhibits Y-2 and S-2[3].

In his *Supplemental* Declaration, Engstrom relates that he sent a Biological Activity Data Report dated May 24, 1988 on the Wattanasin compounds (constituting Exhibit Q) to the Sandoz Patent Department, and parenthetically, refers to various handwritten notations and corrections on said Exhibit Q as being made by him at the time the report was prepared. The *Supplemental* Engstrom Declaration and its appended Exhibit Q are wholly consistent with the original Engstrom Declaration as well as the Wattanasin application and other exhibits mentioned above.

This Supplemental Declaration is important to Wattanasin because it contains evidence of activity around May of 1988 toward the filing of a patent application on the Wattanasin invention, which bears on Fujikawa's supression allegations.

Fujikawa complain that there has been no explanation of Wattanasin's typographical errors over which Fujikawa, "late in the day," affect confusion. However, Fujikawa likewise never sought explanation. For whatever reason, Fujikawa chose not to cross-examine Mr. Engstrom, a current employee of Sandoz (the Wattanasin

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[3] Wattanasin Exhibit S-2 was entered into evidence in response to Fujikawa's requests for information and materials at the Kassenoff and Wattanasin depositions, *see* WR 130, 270 and 371-2.

assignee of interest), even when their counsel visited the Sandoz site in New Jersey to cross-examine three other Wattanasin declarants. If Fujikawa had questions about the original or Supplemental Engstrom Declarations, then surely they forwent the opportunity to have their questions answered, and not by counsel for Wattanasin, but by the declarant himself. For this reason alone, Fujikawa should be held to a high degree of persuasion to suppress testimony otherwise important to the Wattanasin, and this burden of persuasion simply has not been met.

3. Suppression.

Fujikawa are also asking the Board to revisit Fujikawa's argument that Wattanasin suppressed his invention.

Fujikawa's current contentions appear to be, on the one hand, that the Board erred in computing the period of time for alleged Wattanasin suppression by not starting from just prior to the Fujikawa critical date; and on the other hand, that the Board overlooked Fujikawa's claims of "deliberate" supression of the Wattanasin invention.

With respect to the first point, if Fujikawa are saying that the relevant time period for analyzing for alleged suppression by Wattanasin begins prior to Wattanasin's reduction practice, then this is surely contrary to fundamental patent law. It is equally inappropriate as Fujikawa's schematic timeline, first produced at final hearing, which went back to Wattanasin's conception document for the start of [sic] "Wattanasin's Period of Suppression of Publications".

35 USC 102(g) does not speak to suppression of a conception, or supression of diligence, or as Fujikawa put it, suppression of "publications". Section 102(g) deals with supression of inventions. The black letter law requiring a reduction to practice before suppression can be found is simply at odds with Fujikawa's contentions. Fujikawa continue to try to "shoehorn" the Wattanasin facts into the configuration of suppression, but the facts just don't fit.

As to Fujikawa's second line of argument, mentioned above, Wattanasin believes that the record amply refutes any allegation of deliberate suppression and/or spurring. The fact that, prior to the meeting of January 27, 1988, the Sandoz Patent Committee voted to defer filing of a patent application on Wattanasin's invention until the in vivo results were in, is not suppression. Moreover, the Committee did act expeditiously to confer an "A" rating for filing as soon as the ED_{50}'s of the Wattanasin compounds were available. Therafter, the record demonstrates that Kassenoff of the Patent Department took early action in February of 1988 to initiate the "spadework" for filing of what ultimately was a 58-page application. Engstrom and Kassenoff have testified about their activities into May of 1988 to enable filing of a patent application, and Giesser testifed working on the draft no later than October 1988 and even prior to September (WR at 450).

Furthermore, there can be no question that the present facts are vastly different from a "spurring" case, where the filing of a patent application is prompted solely by another's entrance into the field, and only after long inactivity by the patent applicant.

Accordingly, the Board is respectfully requested to adhere to its final decision and judgment in this interference.

Respectfully submitted,

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Registration No. 31,104
Attorney for Wattanasin
(201) 503-7332

SANDOZ Corp.
59 Route 10
E. Hanover, NJ 07936

March 14, 1995

Interference No. 102,975
Watt. Reply to
Fuj. Req. Reconsid.

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the paper entitled:

WATTANASIN REPLY to
FUJIKAWA REQUEST FOR RECONSIDERATION

was served on counsel for the party Fujikawa et al., this 14th day of March 1995, by postage pre-paid first-class mail addressed to the following:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Attn: Steven B. Kelber, Esq.
1755 South Jefferson Davis Highway
Crystal Square 5, Ste. 400
Arlington, VA 22202

Diane Furman

Diane E. Furman

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. 67

IN THE 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,

Junior Party,[2]

v.

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

Senior Party.[3]

---

[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] Patent 5,011,930, granted April 30, 1991, based on Application 07/483,720, filed February 23, 1990. Accorded the benefit of Japan Application Nos. 207224, filed August 20, 1987; and 15585, filed January 26, 1988; and U.S. Application 07/233,752, filed August 19, 1988. Assignors to Nissan Chemical Industries Ltd.

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

Patent Interference No. 102,975

FINAL HEARING: November 22, 1994

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

SOFOCLEOUS, Administrative Patent Judge.

REQUEST FOR RECONSIDERATION

On February 28, 1995, Fujikawa et al. (hereinafter "Fujikawa") filed a request for reconsideration (Paper No. 65) of our decision of January 31, 1995. Wattanasin has filed a reply (Paper No. 66) 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 two matters pertaining to this interference. These matters are addressed below.

I

The first 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 18 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 4 on page 16 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 4 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 correct the error. Cf. Gunn v. Bosch, 181 USPQ 758, 759 (Bd.Pat.Int. 1973). Thus we did not overlook the foregoing matter.

II

The second matter concerns the issue of suppression or concealment. Fujikawa asserts that we overlooked his arguments

stressing direct and indirect evidence of suppression and concealment on the part of Wattanasin and that Wattanasin's assignee took deliberate action to prevent publication of information with regard to the invention. Contrary to any assertions in the request, we did not overlook any of Fujikawa's arguments concerning suppression.

As we noted on pages 11 to 14 of our decision, Wattanasin could not rely upon the experimental work completed by June 13, 1985 for actual reduction to practice because of his failure to rebut the inference that he had suppressed or concealed the invention due to the delay in filing his application. However, we found that during Wattanasin's second phase of activity actual reduction to practice had occurred by either October 20, 1987 (the date of the in vitro testing of compound 64-935) or December 9, 1987 (the date of the in vivo testing of that compound). The hiatus in time[4] from the latter date for reduction to practice to Wattanasin's filing date is approximately fifteen months. On pages 25 and 26 of our decision, we found that this hiatus is insufficient to raise the inference of suppression.

At page 9 of the request, Fujikawa states that Sandoz, Wattanasin's assignee, "took deliberate action to prevent publication of information with regard to the invention" (emphasis added), that Wattanasin "had been told not to publish information regarding his

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[4] The hiatus from the earlier date for actual reduction to practice to Wattanasin's filing date is approximately seventeen months.

invention even after the date of conception found by the Board herein, and indeed, well after the actual reduction to practice" (emphasis added), and that the "Patent Committee again and again and again decided not to make a decision whether to proceed with the filing or not . . . ." At page 10 of the request, Fujikawa urges that we should have measured the hiatus from Wattanasin's date of conception and not from the date of actual reduction to practice. These positions are not well taken. It is well settled that without an actual reduction to practice, there is no invention which can be abandoned, suppressed or concealed. Correge v. Murphy, 705 F.2d 1326, 217 USPQ 753 (Fed.Cir. 1983) and Peeler v. Miller, 535 F.2d 647, 190 USPQ 117 (CCPA 1976).

Further at page 10 of the request, Fujikawa urges that this is a classic case of suppression because Wattanasin was spurred into filing his application by the issuance of the Picard patent. As we noted on page 7 of our decision, Picard is not involved in this interference. This interference is between Wattanasin and Fujikawa and any action taken with respect to the Picard patent is not relevant to the question of priority between Wattanasin and Fujikawa.

For the foregoing reasons, the request for reconsideration is granted to the extent that we have reviewed our decision and is denied insofar as it seeks any modification thereof.

IAN A. CALVERT, Vice Chief
Administrative Patent Judge

MICHAEL SOFOCLEOUS
Administrative Patent Judge

MARY F. DOWNEY
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

svt

Interference No. 102,975

Gerald D. Sharkin
Sandoz Corp.
59 Route 10
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Oblon, Fisher, Spivak,
McClelland & Maier
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Crystal Square Five-Ste. 400
Arlington, VA 22202

#68

SOLICITOR

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

JUN 0 2 1995

U.S. PATENT & TRADEMARK OFFICE

SOMPONG WATTANASIN	:	
	:	INTERFERENCE 102,975
V.	:	ADMINISTRATIVE LAW JUDGE
	:	MICHAEL SOFOCLEOUS
YOSHIHIRO FUJIKAWA ET AL	:	

FUJIKAWA ET AL, NOTICE OF APPEAL, 37 CFR §1.301

HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, DC 20231
BOX INTERFERENCE

SIR:

Pursuant to the provisions of the above-captioned Rule, 37 CFR §1.302 and 37 CFR §1.304, Fujikawa et al hereby serves notice that it appeals the Decision on Final Hearing in the above-captioned Interference, and Decision on Reconsideration, to the U.S. Court of Appeals for the Federal Circuit. Pursuant to the provisions of Rule 301(b), a copy of this Notice of Appeal, together with the requisite fee, has been filed in the Court this day.

It is noted that the Decision on Request for Reconsideration being dated April 6, 1995, this filing on June 2, 1995 is timely.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Steven B. Kelber
Registration No.: 30,073
Attorney for Fujikawa et al

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mailed 6-5-95

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. **FUJIKAWA ET AL, NOTICE OF APPEAL, 37 CFR §1.301**
2. **CERTIFICATE OF SERVICE**

were served as follows:

Counsel for Wattanasin:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FIRST-CLASS MAIL, postage prepaid,

U.S. Court of Appeals for the Federal Circuit

Clerk
U.S. Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439

via HAND DELIVERY TO THE CLERK'S OFFICE WITH $100.00 FEE

this SECOND day of JUNE, 1995.

STEVEN B. KELBER

Interference 102,975

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

SOMPONG WATTANASIN	:	
	:	**INTERFERENCE 102,975**
V.	:	**ADMINISTRATIVE LAW JUDGE**
	:	**MICHAEL SOFOCLEOUS**
YOSHIHIRO FUJIKAWA ET AL	:	

FUJIKAWA ET AL, NOTICE OF APPEAL, 37 CFR §1.301

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Attorney for Fujikawa et al

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I hereby certify that true copies of:

1. **FUJIKAWA ET AL, NOTICE OF APPEAL, 37 CFR §1.301**
2. **CERTIFICATE OF SERVICE**

were served as follows:

Counsel for Wattanasin:

Diane E. Furman
SANDOZ CORP.
59 Route 10
E. Hanover, New Jersey 07936

via FIRST-CLASS MAIL, postage prepaid,

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STEVEN B. KELBER

Interference 102,975

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

SOMPONG WATTANASIN	:	
	:	INTERFERENCE 102,975
V.	:	ADMINISTRATIVE LAW JUDGE
	:	MICHAEL SOFOCLEOUS
YOSHIHIRO FUJIKAWA ET AL	:	

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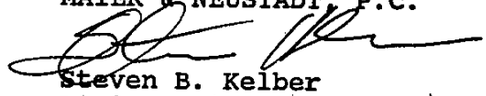
It is noted that the Decision on Request for Reconsideration being dated April 6, 1995, this filing on June 2, 1995 is timely.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Steven B. Kelber
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via FIRST-CLASS MAIL, postage prepaid,

U.S. Court of Appeals for the Federal Circuit

Clerk
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717 Madison Place, NW
Washington, DC 20439

via HAND DELIVERY TO THE CLERK'S OFFICE WITH $100.00 FEE

this SECOND day of JUNE, 1995.

STEVEN B. KELBER

Interference 102,975

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

#69

YOSHIHIRO FUJIKAWA, MIKIO SUZUKI, HIROSHI IWASAKI, MITSUAKI SAKASHITA, and MASAKI KITAHARA,	)	
Appellant,	)	
v.	)	
SOMPONG WATTANASIN,	)	Appeal No. 95-
Appellee.	)	
Interference No. 102,975	)	

NOTICE FORWARDING CERTIFIED LIST

A notice of appeal to the U.S. Court of Appeals for the Federal Circuit was timely filed on June 2, 1995, in the Patent and Trademark Office in connection with the above-identified interference. Pursuant to 35 U.S.C. § 143 and Federal Circuit Rule 17(b)(1), a certified list is this day being forwarded to the Federal Circuit.

A copy of the list is this day being forwarded to counsel for appellant and appellee in envelopes addressed as follows:

Oblon, Fisher, Spivak,
McClelland & Maier
1755 S. Jefferson Davis Highway
Crystal Square 5, Suite 400
Arlington, VA 22202

Gerald D. Sharkin
Sandoz Corporation
59 Route 10
E. Hanover, NJ 07936

If copies of the notice of appeal and the docketing fee of $100.00 have not been already filed with the Federal Circuit, counsel is reminded that three copies of the notice and the docketing fee should be promptly filed with the Federal Circuit. The mailing address of the Federal Circuit is:

U.S. Court of Appeals for
the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

Counsel for appellant may contact counsel for appellee to arrange for designating the record.

Respectfully submitted,

BRUCE A. LEHMAN
Assistant Secretary of Commerce
and Commissioner of Patents
and Trademarks

Date: July 6, 1995

By: Laura Lee Feldman
Laura Lee Feldman
Paralegal Specialist
P.O. Box 15667
Arlington, Virginia 22215
703-305-9035

Form PTO 55 (12-80)

U. S DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

June 30, 1995
(Date)

THIS IS TO CERTIFY that the annexed is a true copy from the records of this office

of the "Contents" page of the file wrapper of the interference proceeding identified below, said "Contents" page being a list of the papers comprising the record before the United States Court of Appeals for the Federal Circuit in the matter of

Sompong Wattanazin

v.

Yoshihiro Fujikawa, Mikio Suzuki, Hiroshi Iwasaki, Mitsuaki Sakashita and Masaki Kitahara

v.

Yoshihiro Fujikawa, Mikio Suzuki, Hiroshi Iwasaki, Mitsuaki Sakashita and Masaki Kitahara

Interference No. 102,975 Declared August 19, 1992

By authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

Certifying Officer.

Docket No: 49-111-0

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

#70

WATTANASIN	:	
V.	:	INTERFERENCE NO.: 102,975
FUJIKAWA ET AL	:	EXAMINER-IN-CHIEF:
	:	MICHAEL SOFOCLEOUS

POWER TO INSPECT AND MAKE COPIES

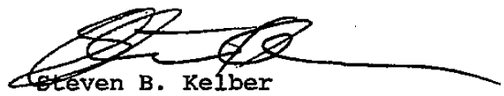
Assistant Commissioner For Patents
Washington, D.C. 20231

SIR:

The undersigned hereby grants Muralidhar Pai and Sam Brown the power to inspect the above-identified application and make copies of the entire record of Inteference No. 102,648.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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1755 Jefferson Davis Highway
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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Interference No. 102,975

Wattanasin
v.
Fujikawa et al

Civil Action No.

A survey of our records indicates that the above identified interference is involved in Civil Action No._____ under 35 USC 146 in the U.S. Court of Appeals for the Federal Circuit. In an effort to bring our records up to date, it is requested that this Office be informed as to the present status and the disposition, if any, of the action.

It should be noted that before this interference can be terminated in the Patent and Trademark Office and the files returned to the examiner for Ex parte prosecution this Office **must be in receipt of a certified copy of the court's termination paper**. See 35 USC 146, last sentence.

ce

Olivia M. Duvall

Olivia M. Duvall, Sup'v Legal
Instruments Examiner
Board of Patent Appeals &
Interferences
(703) 308-9846

SANDOZ CORPORATION
59 ROUTE 10, EAST HANOVER NJ 07936

SANDOZ

#72

PATENT AND TRADEMARK DEPARTMENT

TELEFAX 201 503 8807

December 18, 1996

By Facsimile

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

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DEC 18 1996
BOARD OF PATENT APPEALS AND INTERFERENCES

Attn: Olivia M. Duvall, Sup'v Legal

Re: Interference No. 102,975
Wattanasin v. Fujikawa et al

Dear Sir:

Enclosed please find a copy of the final Judgment of the U.S. Court of Appeals for the Federal Circuit in Interference Nos. 102,648 and 102,975.

Very truly yours,

Diane Furman

Diane E. Furman
Reg. No. 31.104

DEF/fp
Enclosures

Certificate of Facsimile

I hereby certify that this correspondence is being faxed to fax number (703) 308-7952 at the United States Department of Commerce, Patent and Trademark Office, Box Interference, Commissioner of Patents and Trademarks, Washington, D.C. 20231, to the attention of Olivia M. Duvall, Sup'v Legal on December 18, 1996.

Diane Furman

Diane Furman

Dec. 18, 1996

Date

SANDOZ CORPORATION
Patent and Trademark Department
59 Route 10
East Hanover, New Jersey 07936

Facsimile: (201) 503-8807

FACSIMILE COVER SHEET

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To: OLIVIA M. Duvall, Sup'v Legal

From: Diane Furman

Fax No.: 703 - 308-7952

Re: Interference # 102,975

Date: 12/18 **No. of Pages:** 4 (including cover page)

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Interference No. 102,975

Wattanasin
v.
Fujikawa et al

609 - 7101/cont
07/498,301

Civil Action No. December 31, 1996

A survey of our records indicates that the above identified interference is involved in Civil Action No._____ under 35 USC 146 in the U.S. Court of Appeals for the Federal Circuit. In an effort to bring our records up to date, it is requested that this Office be informed as to the present status and the disposition, if any, of the action.

It should be noted that before this interference can be terminated in the Patent and Trademark Office and the files returned to the examiner for Ex parte prosecution this Office **must be in receipt of a certified copy of the court's termination paper**. See 35 USC 146, last sentence.

ce

Olivia M. Duvall
Olivia M. Duvall, Sup'v Legal
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United States Court of Appeals for the Federal Circuit

95-1418

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

v.

SOMPONG WATTANASIN,
Appellee.

95-1425

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

v.

SOMPONG WATTANASIN,
Appellee.

JUDGMENT

Appeal from decisions of the Board of Patent Appeals and Interference Nos. 102,648 and [redacted] dated January 31, 1995, and upon reconsideration on April 6, 1995.

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: AFFIRMED

ENTERED BY ORDER OF THE COURT

DATED: AUGUST 28, 1996

Francis X. Gindhart, Clerk

ISSUED AS A MANDATE: SEP [illegible] 1996

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Yoshihiro Fujikawa et al.
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1755 S. Jeff. Davis Hwy.
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Arlington, VA 22202

Wattanasin v. Fujikawa et al. v Fujikawa et al.
Patentee

102975

19AUG 1992 **DECLARATION, MOTIONS DUE**

19AUG 1992 — ~~PS's RESPS DUE 18 NOV 1992~~

Aug. 21, 92 - Preliminary Statement - Fujikawa et al

Aug. 31, 92 Notice of Filing Preliminary Statement - Wattanasin

Sept 22, 92 - Jr. party's reply brief due 6/15/93

Nov. 19, 92 Notice of Intent to Rely - Wattanasin (c of m 11/16/92) 6/29 Rm. 10C06

Nov. 19, 92 TESTIMONY FOR Wattanasin, 2 1/2 yds., (c of m 11/16/92) Rm. 10C06

Nov. 19, 92 EXHIBITS FOR Wattanasin, (c of m 11/16/92) Room 10C06

Oct. 30, 92 Proof of Service - Wattanasin

Nov. 19, 92 MO to Consolidate Record - Wattanasin (c of m 11/16/92)

Nov. 19, 92 MO for Ext. of Time - Wattanasin (c of m 11/16/92)

Dec. 10, 92 Request for Ext. of Time - Fujikawa

Dec. 7, 92 Request for Cross-Exam. - Fujikawa

Dec. 15, 92 - Notice of Intent to Argue Abandonment, Suppression or Concealment (R.632) - Fujikawa, et al.

Dec. 14, 92 Notice of Deposition - Wattanasin, (c of m 12/11/92)

DEC 24, 92 - EXT. OF TIME APPROVED - TEST. due 2/25/93 3/11

Jan. 6, 93 MO for Additional Tests - Wattanasin

Jan. 13, 93 - Oppos. to Motion for Leave to Present Additional Tests - Fujikawa et al.

Feb. 1, 93 Notice of Intent to Rely - Fujikawa et. al.

Feb. 1, 93 Official Records & Printed Publications TESTIMONY FOR Fujikawa (c of m 1/20/93)

Feb. 1, 93 Reply to Oppo. to Mot. for Leave - Wattanasin

Feb. 3, 93 - Time for filing & serving record & briefs remains as set Page 11 5

Feb. 18, 93 - Motion For Extension of time (R.645) (635) - Fujikawa et al. 4/8

Feb. 19, 93 - ~~Jr. party's reply brief due~~ Extension of time granted to 3/25/93

Feb. 25, 93 - Request For Cross-Examination - Fujikawa et al.

Mar. 1, 93 Notice of Deposition - Fujikawa et. al.

Feb. 24, 93 TESTIMONY FOR Wattanasin, (c of m 2/22/93)

Mar. 19, 93 - Joint Request For Extension of time - Wattanasin & Fujikawa et al.

Mar. 19, 93 - Extension of time granted to 8/09/93 - R.B. due

Mar. 29, 93 - Notice of deposition - Fujikawa et al 5/15

★ U.S. GOVERNMENT PRINTING OFFICE 1985-468-632

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[SHEET 2]

31 Apr. 6, 93 Notice of Deposition - Wattanasin
32 Apr. 22, 93 TESTIMONY FOR Fujikawa, 3 vols., Room 10C06 (C of m 4/22/93)
33 Apr. 28, 93 TESTIMONY FOR Fujikawa, 1 vol. Room 10C06
34 May 10, 93 TESTIMONY FOR Wattanasin, 1 vol. Room 10C06
35 May 17, 93 Motion to Consolidate Record Fujikawa
36 May 17, 93 RECORD FOR Fujikawa et al., 5 vols., 3 copies Rm. 10C06
37 May 17, 93 EXHIBITS FOR Fujikawa et al. Rm. 10C06
38 May 19, 93 RECORD FOR Wattanasin (Rm. 10C06) 5 vols., 3 copies (C of m 5/17/93)
39 May 19, 93 EXHIBITS FOR Wattanasin Room 10C06 et al.
40 May 26) 93 - Motion For Sanction - (R. 616) - (w/attach) - Fujikawa et al.
41 June 1, 93 - Receipt acknowledged. Paper Nos. 35 + 40
42 May 28, 93 Communication - Wattanasin
43 Jun. 4, 93 — Request for Extension of time - Wattanasin
44 Jun. 8, 93 - Extension of time granted to 9/04/93 9/18 Fujikawa et al.
45 Jun. 21, 93 - Reply to oppos. to mo. for sanctions -
46 June 23 93 - Times remain as set in Paper No. 44
47 Jun 29, 93 - Opposition to motion for sanctions Wattanasin (C of m 6/29/93)
48 July 19, 93 Motion for Extension of Times - Wattanasin (C of m 7/15/93)
49 July 22 93 - Extension of time granted to 7/16/93
50 July 19, 93 BRIEF FOR: Wattanasin, 1 orig., 3 copies, Rm. 10C06 (C of m 7/16/93)
51 July 19, 93 Proposed Findings of Fact & Conclusions of Law - Wattanasin Rm. 10C06
52 Aug. 16, 93 BRIEF FOR: Fujikawa et al, 1 orig., 3 copies Rm. 10C06
53 Aug. 16, 93 Motion to Suppress Evidence - Fujikawa Rm. 10C06
54 Aug. 16, 93 Oppo. to Proposed Findings of Fact - Fujikawa Rm. 10C06
55 Sept. 7, 93 Errata Sheet for Brief - Fujikawa Rm. 10C06
56 Sept. 7, 93 Errata Sheet for Findings of Fact - Fujikawa Rm. 10C06
57 Sept. 13, 93 REPLY BRIEF FOR Wattanasin, 1 orig., 3 copies (C of m 9/7/93)
58 Sept. 13, 93 Mot. to Suppress Evidence - Wattanasin
59 Sept. 13, 93 Reply to Oppo. to findings of fact - Wattanasin
60 Sept. 22, 93 Reply to Oppo. to Mot. to Suppress - Fujikawa

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[SHEET 3]

6 1. Sept. 22, 93 Extra copies of MOL to Suppress & findings of fact - Wattanasin
6 2. Sep 16, 94 - Final Clearance letter for 11-22-94
6 3. Nov 22, 94 - Appearance Record
6 4. Jan. 31, 95 - Judgment awarded to Wattanasin
6 5. Feb. 28, 95 - Request for Reconsideration of Final Decision - Fujikawa et al.
6 6. Mar. 17, 95 - Reply to Request for Reconsideration - Wattanasin
6 7. April 6, 95 - Reconsideration - Denied
6 8. June 2, 95 appeal to Fed. Cir.
6 9. Jul. 6, 95 - Notice forwarding Certified list
7 0. Jun. 8, 95 - Power to Inspect & make copies - Fujikawa et al
7 1. May 14, 96 - C/A status ltr
7 2. Sept. 8, 96 - Ordered and Adjudged (Affirmed) Issued as mandate 9/16/96
7 3. April 21, 1997 - Decision noted

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