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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 130

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ANDREW H. CRAGG, and MICHAEL D. DAKE

Junior Party
(Application 08/461,402)

v.

ERIC C. MARTIN,

Junior Party
(Patent No. 5,575,817),

v.

THOMAS J. FOGARTY, JAY A. LENKER,
TIMOTHY J. RYAN and KIRSTEN FREISLINGER,

Senior Party
(Application 08/463,836)

Patent Interference No. 104,192

Decision on Party Cragg's Motion
to Correct the Preliminary Statement
and on Party Fogarty's Preliminary Motion 12

Before SCHAFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

Background

1. On February 11, 2000, a trial section motions panel rendered a decision on the parties' preliminary motions and ordered that the preliminary statements be mutually served. (Paper No. 108).

2. The current named inventors of party Cragg's involved application are Andrew H. Cragg and Michael D, Dake. See re-declaration of interference (Paper No. 106).

3. Party Cragg's preliminary statement identifies only Michael D. Dake as the inventor of the subject matter of the sole count, Count 2, of this interference.

4. At the time of declaration of this interference, party Cragg was accorded benefit of the earlier filing dates of European patent applications EP94400284.9 and EP94401306.9, filed respectively on February 9, 1994, and June 10, 1994.

5. At the time of declaration of this interference, party Fogarty was accorded benefit of the earlier filing date of U.S. application 08/255,681, filed June 8, 1994.

6. At the time of declaration of the interference, party Cragg was designated senior party, on the basis of the accorded benefit date of February 9, 1994.

7. The European applications EP94400284.9 and EP94401306.9 were filed by the assignee MINTEC SARL on behalf of inventors

Andrew H. Cragg, George Goicoechea, John Hudson, and Claude Mialhe.

8. After opening of the preliminary statements following the Board's decision on preliminary motions, party Fogarty filed on March 13, 2000, a motion under 37 CFR § 1.633(g) (Paper No. 113), attacking the benefit accorded party Cragg to the filing dates of European applications EP94400284.9 and EP94401306.9.

9. The basis underlying party Fogarty's motion attacking benefit is that there is no common inventor between party Cragg's involved application 08/461,402 and the European applications.

10. Also on March 13, 2000, party Fogarty filed a miscellaneous motion for leave to file its preliminary motion 12 after expiration of the time period for filing preliminary motions. (Paper No. 112).

11. The basis for Fogarty's motion for leave to file its preliminary motion 12 late is that it did not become aware of what is alleged in party Cragg's preliminary statement until service of the preliminary statement as ordered in the decision on preliminary motions dated February 11, 2000.

12. Party Cragg opposes Fogarty's preliminary motion 12 and miscellaneous motion for leave to file preliminary motion 12. (Paper No. 116).

13. The parties do not appear to dispute that in order to be entitled to benefit of the filing date of an earlier filed application or patent, there must be at least one common inventor between the involved application or patent and the benefit application or patent.

14. On March 22, 2000, party Cragg filed a miscellaneous motion to correct its preliminary statement. (Paper No. 117).

15. Party Cragg's proposed corrected preliminary statement would name Michael D. Dake and Andrew H. Cragg as co-inventors and state the date of conception of the invention as sometime as early as February 8, 1993.

16. The original preliminary statement of party Cragg only named Michael D. Dake as the inventor, and identified July 1992 as the earliest date of conception of the invention of the count.

17. The preliminary statement of party Fogarty alleges a date of conception as early as July 1993.

18. The preliminary statement of party Martin indicates that party Martin intends to rely only on its effective filing date as the date of invention.

19. In a telephone conference call held approximately 1 month ago, the priority testimony period had been set to expire on July 11, 2001, based on counsel's representation that an extraordinary amount of time will be required to locate multiple

witnesses who are no longer employed by the assignees of the involved applications of party Fogarty and party Cragg.

20. Party Fogarty's case-in-chief testimony period is now running.

Discussion

While a preliminary statement shall not be used as evidence on behalf of the party filing the preliminary statement, 37 CFR § 1.629(e), nothing precludes an opposing party from relying on statements made therein as an admission against the party filing the statement. That is consistent with 37 CFR § 1.629(b) which states that evidence which shows that an act alleged in the preliminary statement occurred prior to the date alleged in the statement shall establish only that the act occurred as early as the date alleged in the statement.

Party Cragg cites Halbert v. Schuurs, 220 USPQ 558, 565 (Bd. Pat. App. & Int. 1983), for the proposition that statements made in a preliminary statement are not regarded as effective admissions except for the setting of limiting dates. However, that case is not apposite since preliminary statements at that time did not require the naming of the inventor[s] who made the invention of each count, and the patent statute at that time did not permit the claims of different inventive entities to be included in the same application. Furthermore, the case mis-

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