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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SHMUEL CABILLY, HERBERT L. HEYNEKER,
WILLIAM E. HOLMES, ARTHUR D. RIGGS
and RONALD B. WETZEL
Junior party[1]

v.

MICHAEL A. BOSS, JOHN H. KENTEN,
JOHN S. EMTAGE and CLIVE R. WOOD
Senior party[2]

Patent Interference No. 102,572

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[1] Application 08/205,419, filed June 10, 1988. According benefit of Application 06/483,457, filed April 8, 1983, now patent No. 4,816,567, issued March 28, 1989. Assignee for Genentech, Inc., South San Francisco, CA, A California Corporation.

[2] Application 06/672,265, filed November 14, 1984, now Patent No. 4,816,397, issued March 28, 1989. Accorded benefit of PCT application, PCT/GB84/00094, filed March 23, 1984 and UK application No. 83/08235, filed March 25, 1983. Assignee for Celltech Limited, Berkshire SL1 4DY, U.K., A British Company.

Interference No. 102,572

Before RONALD H. SMITH, DOWNEY and SCHAFER,[3] Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

FINAL DECISION

The interference concerns a two step process for producing either an immunoglobulin (Ig) molecule or an immunologically functional Ig fragment comprising at least the variable domains of the Ig heavy and light chains in a single host cell.

The subject matter at issue is defined by a single count, which count is identical to claim 1 of the Boss et al. patent. The count reads as follows:

Count 1

> A process for producing an Ig molecule or an immunologically functional Ig fragment comprising at least the variable domains of the Ig heavy and light chains, in a single host cell, comprising the steps of:
>
> (i) transforming said single host cell with a first DNA sequence encoding at least the variable domain of the Ig heavy chain and a second DNA sequence encoding at least the variable domain of the Ig light chain, and
>
> (ii) independently expressing said first DNA sequence and said second DNA sequence so that said Ig heavy and light chains are produced as separate molecules in said transformed single host cell.

Boss et al. claims 1-18 and Cabilly et al. claims 101-120 correspond to the count.

During the preliminary motion stage of this proceeding, the administrative patent

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[3] APJ Schafer has been substituted for APJ Pellman who has retired. *In re Bose*, 772 F.2d 866, 868-869, 227 USPQ 1, 2-4 (Fed. Cir. 1985).

judge (APJ), granted the Boss et al. motion for benefit of the March 25, 1983 and March 23, 1984, filing dates of their United Kingdom application, No. 83/08235 and PCT application, PCT/GB84/00094, respectively. With the granting of the motion for benefit, party Boss et al. became senior party in this interference.

Boss et al. took no testimony and thus stand on their March 25, 1983, filing date accorded them during the motion period.

Junior party Cabilly et al. raise the following issues in their brief (Brief, page 3):

(1) does the record establish that Cabilly et al. actually reduced to practice the invention of the count prior to the March 25, 1983, effective filing date accorded Boss et al., and if not, then,

(2) does the record establish that Cabilly et al. conceived of the invention of the count prior to the March 25, 1983, filing date accorded Boss et al. and proceeded with reasonable diligence to either an actual or constructive reduction to practice (April 8, 1983) from a time prior to conception of Boss et al. (March 25, 1983).

In addition, we have before us, a Cabilly et al. motion, pursuant to 37 CFR § 1.635, to have certain Cabilly et al. pages, 224-231 attached to exhibit 8 and page 993 attached to Exhibit 20, entered into the record (Paper No. 49). The motion stands opposed (Paper No. 50); and a reply was filed (Paper No. 51).

The following issues have not been raised by the parties:

(1) a question of no interference-in-fact;

(2) a question of separate patentability of any claim(s);

(3) a question of whether Cabilly et al. claims are unpatentable. Boss et al. filed a motion for judgment against Cabilly et al. claims during the motion stage, which motion was denied; Boss et al. do not seek review of this motion at final hearing; and

(4) a question of whether Cabilly et al. rely upon attorney diligence for their priority case. Cabilly et al. allege priority based on conception coupled with reasonable diligence to filing of their application. Cabilly et al. could have but did not offer any evidence relating to attorney diligence in preparing and filing the Cabilly et al. patent application during the critical period.

Cabilly et al. filed a record (CR) consisting of exhibits 1-20 (CX) [4] and the declarations of coinventors: Arthur D. Riggs, Ph.D, (Riggs) and Shmuel Cabilly (Cabilly), employees of City of Hope; William E. Holmes (Holmes) and Ronald B. Wetzel, Ph.D., (Wetzel), employees of Genentech, Inc.; and corroborators Paul J.

[4] The record and exhibits will be referred to as CR and CX followed by the appropriate number.

Carter, Ph.D (Carter)[5], Michael B. Mumford (Mumford), L. Jeanne Perry (Perry), Michael W. Rey (Rey), all employees of Genentech and John E. Shively, Ph.D., (Shively), an employee of City of Hope. Boss et al. did not cross examine any of the witnesses.

Both parties filed briefs and appeared through counsel at final hearing.

I.

Cabilly et al. motion to correct the record

With their reply brief, Cabilly et al. filed a motion to have entered into the record certain pages which were referred to and relied upon in various declarations but were omitted from the record when it was filed and served upon Boss et al. The omission was first realized when Boss et al. noted, in their brief, that the pages were not in the Cabilly et al. record.

The motion is granted. In view of the fact that Cabilly et al. referred to CX-8, pages 224-231 in the Wetzel and Perry declarations and CX-20, page 993 in the declaration, we find the failure to file these pages with their respective exhibits an oversight on the part of Cabilly et al.

[5] The Carter testimony was submitted in response to the Boss et al. motion for judgment; as noted the motion is not being reviewed at final hearing and thus the Carter testimony is not relevant to the issues before us and has not been considered in rendering this decision.

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