

The opinion in support of the decision being entered today is not binding precedent of the Board.

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Paper 78

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PAT. & T.M. OFFICE
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SHMUEL CABILLY, HERBERT L. HEYNEKER, WILLIAM E. HOLMES,
ARTHUR D. RIGGS and RONALD B. WETZEL,

Junior Party,
(Application 07/205,419),

v.

MICHAEL A. BOSS, JOHN H. KENTEN,
JOHN S. EMTAGE and CLIVE R. WOOD,

Senior Party
(Patent 4,816,397).

Patent Interference 102,572 (McK)

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

FINAL ORDER AFTER DISTRICT COURT JUDGMENT

A. Introduction

On 1 June 2001, the board received the following papers
filed by Cabilly:

1. CABILLY REQUEST FOR ASSIGNMENT TO NEW APJ
[ADMINISTRATIVE PATENT JUDGE] (Paper 63).

2. Certified copy of a NOTICE OF SETTLEMENT AND JOINT REQUEST FOR ENTRY OF SETTLEMENT INSTRUMENTS filed on 6 March 2001 in the United States District Court for the Northern District of California in Genentech, Inc. v. Celltech Therapeutics, Ltd., Civil Action No. C 98-3926 MMC (WDB) (Paper 66).
3. Certified copy of an ORDER REGARDING RESOLUTION OF INTERFERENCE filed in the district court on 16 March 2001 (Paper 67).
4. Certified copy of a JUDGMENT filed in the district court on 16 March 2001 (Paper 68).

At some point, the board also received a copy of the docket entries in the district court through 16 March 2001 (Paper 65).

The ORDER REGARDING RESOLUTION OF INTERFERENCE and JUDGMENT appear to have been drafted by the attorneys and were thereafter presented to the district court for consideration. In drafting the order and judgment, it would appear that the attorneys did not take into account (1) relevant provisions of 35 U.S.C. §§ 135(a) and 146 and (2) binding precedent of the Federal Circuit, e.g., Gould v. Quiqq, 822 F.2d 1074, 1079, 3 USPQ2d 1302, 1305 (Fed. Cir. 1987) and In re Ruschig, 379 F.2d 990, 154 USPQ 118 (CCPA 1967). Nevertheless, we will attempt to take action consistent with the district court's judgment to the extent possible and consistent with law.

B. Assignment of administrative patent judge (APJ)

During its pendency before the board, the interference was assigned (37 CFR § 1.610) to former Administrative Patent Judge Mary F. Downey. Judge Downey recently retired. Accordingly, the

interference has been assigned to Senior Administrative Patent Judge Fred E. McKelvey. 37 CFR § 1.610(b).

C. Finding of fact

The record supports the following findings by at least a preponderance of the evidence:

1. The interference, declared 28 February 1991, involves Cabilly application 07/205,419¹ versus Boss patent 4,816,397.
2. The Cabilly application is owned by Genentech, Inc.
3. The Boss patent is owned by Celltech R&D Ltd., formerly Celltech Therapeutics, Ltd. (Paper 64, page 2).
4. The claims of the parties are:
 - a. Cabilly: 101-134²
 - b. Boss: 1-18
5. The claims of the parties designated as corresponding to the count,³ and therefore involved in the interference (35 U.S.C. § 135(a)), are:
 - a. Cabilly: 101-120
 - b. Boss: 1-18

¹ We note that the Cabilly application is misidentified as application 08/205,419 in note 1 on page 1 of a FINAL DECISION entered 13 August 1998 (Paper 57).

² Cabilly application Paper 12, pages 1-5 (copy attached).

³ A count defines the interfering subject matter. 37 CFR § 1.601(f).

6. The claims of the parties designated as not corresponding to the count are:

- a. Cabilly: 121-134
- b. Boss: None

7. On 20 September 1991, after the interference was declared, Cabilly submitted an INFORMATION DISCLOSURE STATEMENT (IDS) (Appl'n Paper 17--copy attached) citing prior art not previously cited during prosecution before the examiner.

8. Insofar as we can tell, the IDS does not appear to have been considered by an examiner. Nor is it apparent that the examiner has assessed the correctness of allegations in the IDS to the effect that certain prior art cited in the IDS is "cumulative" to other prior art said to have been considered by the examiner.⁴

9. A final decision (i.e., a final agency action) was entered by a merits panel⁵ of the board on 13 August 1998. Cabilly v. Boss, 55 USPQ2d 1238 (Bd. Pat. App. & Int. 1998) (Paper 57).

10. In its final decision, the board determined that Cabilly had failed to sustain its burden of establishing priority

⁴ Jurisdiction over the application transfers to the board upon declaration of an interference. 37 CFR § 1.614. Hence, there is no reason to believe that the examiner would have had occasion to consider papers filed in connection with the application after declaration of the interference.

⁵ The merits panel consisted of former Administrative Patent Judges Ronald H. Smith and Mary F. Downey (both now retired) and Administrative Patent Judge Richard E. Schafer.

vis-a-vis Boss. Accordingly, the board entered judgment against Cabilly.

11. On 9 October 1998, Cabilly timely sought judicial review under 35 U.S.C. § 146 by civil action filed in the United States District Court for the Northern District of California (district court). Genentech, Inc. v. Celltech Therapeutics, Ltd., Civil Action No. C 98-3926 MMC (WDB) (Paper 65, page 2, entry 1).

12. On 16 March 2001, the district court entered (1) an ORDER REGARDING RESOLUTION OF INTERFERENCE⁶ (Paper 67) and (2) a JUDGMENT (Paper 68).

13. In its ORDER REGARDING RESOLUTION OF INTERFERENCE, the district court determined "that Genentech is entitled as a matter of law to priority over Celltech to the invention described by the count" (page 3, lines 27-28). The district court's determination appears to have been based on a Cabilly draft application, dated 25 February 1983, which (1) is said to have been uncovered during discovery and (2) was not presented

⁶ We have not proofread the documents drafted by the attorneys for consideration by the district court. However, we note at least the following error in the ORDER REGARDING RESOLUTION OF INTERFERENCE: on page 2, line 24 Genentech's issued patent is identified as U.S. Patent 4,816,517 when it appears it should have been identified as U.S. Patent 4,816,567. We also note at least the following error in the NOTICE OF SETTLEMENT AND JOINT REQUEST FOR ENTRY OF SETTLEMENT INSTRUMENTS: on page 1, line 27, the Cabilly application is identified as application 07/215,419 when it appears it should have been identified as application 07/205,419.

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