In accordance with Rule 42(b), Cross-Appellants PAUL J. CARTER and LEONARD G. PRESTA ("Carter") move the Court to dismiss Carter's cross-appeal filed on January 18, 2011, and assigned Appeal No. 2011-1213.

In support of this motion, Carter states as follows:

1. Carter filed two substantive motions with the Board of Patent Appeals and Interferences, which asserted "threshold" issues that if decided in Carter's favor would end the interference. The first motion requested that Adair claim 24 be found to be barred under 35 U.S.C. § 135(b)(1). The second motion requested that Adair claim 24 be found unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description. On August 30, 2010, the Board granted Carter's first motion concluding that Adair's involved claim 24 is barred under 35 U.S.C. § 135(b)(1). The Board denied Carter's second motion. The Board entered judgment against Adair on September 2, 2010, "[b]ecause Adair no longer has an interfering claim that is not barred under 35 U.S.C. § 135(b)." Adair's request for rehearing, filed October 1, 2010, was denied by the Board on November 5, 2010.

2. On January 4, 2011, Appellants JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, and JOHN SPENCER EMTAGE ("Adair") filed its notice of appeal of the Board's adverse decision that its claim 24 was barred under 35 U.S.C. § 135(b).

3. On January 18, 2011, Carter filed a notice of cross-appeal of the Board's adverse decision denying Carter's motion that Adair's claim 24 was unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description.

4. Adair requested and was granted a twenty-five day extension of time extending the time to file its principal brief from April 18, 2011, to May 13, 2011. Adair filed its principal brief on May 13, 2011.

5. On March 24, 2011, this Court issued a precedential order in *Aventis Pharma S.A. v. Hospira,* Nos. 2011-1018, -1047 (Fed. Cir. March 24, 2011). In that order, the Court held that Apotex's additional claims for invalidity and claims of non-infringement to the same claims did not expand the scope of the judgment in Apotex's favor and thus were improper grounds for cross-appeal. Slip op. at 4-5. The Court did go on to note, however, that Apotex could "consistent with our practice and precedent, raise these arguments in its appellees' brief if it so chooses." *Id.* at 5.

6. The *Aventis* order does not address the specific circumstance wherein a claim has been held to be barred under 35 U.S.C. § 135(b) but a motion asserting the unpatentability of the same claim under 35 U.S.C. § 112, first paragraph, has been denied. Nevertheless, in view of the Court's concern expressed in *Aventis* as to whether an issue on cross-appeal would expand the scope of the judgment, Carter withdraws its cross-appeal relating to the issue of whether Adair's claim 24

is unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description. The parties agree that this motion does not preclude Carter from raising the issue of the unpatentability of Adair claim 24 under 35 U.S.C. § 112, first paragraph, in its responsive brief in Appeal No. 2011-1212 as an alternative ground for affirmance of the Board's entry of judgment against Adair.

7. Adair consents to the withdrawal of the cross-appeal and each party has agreed to bear its own costs on the cross-appeal.

For the foregoing reasons, Carter's cross-appeal should be dismissed. A proposed order with service list is attached.

Respectfully submitted,

June 9, 2011

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Attorneys for Cross-Appellants, Carter *et al.*

CERTIFICATE OF FILING

The undersigned certifies that an original and three copies of the paper entitled "**UNOPPOSED MOTION TO DISMISS CARTER"S CROSS-APPEAL**" was filed this 9th day of June, 2011, by Federal Express overnight delivery service, to:

Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

6-9-11
Date

Oliver R. Ashe, Jr.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the paper entitled "**UNOPPOSED MOTION TO DISMISS CARTER"S CROSS-APPEAL**" was served this 9th day of June, 2011, by sending in the following manner:

VIA INTERFERENCE WEB PORTAL(https://acts.uspto.gov/ifiling/):

Doreen Yatko Trujillo, Esq.
Cozen O'Connor P.C.
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VIA FIRST CLASS MAIL (Postage pre-paid):

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United States Patent and Trademark Office
P.O. Box 15667
Arlington, VA 22215

6-9-11
Date

Oliver R. Ashe, Jr.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2011-1212, -1213
(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,
Cross Appellants.

Appeals from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

ORDER

Upon consideration of the Unopposed Motion to Dismiss Carter's Cross-Appeal filed by Cross-Appellants PAUL J. CARTER and LEONARD G. PRESTA,

IT IS ORDERED THAT:

1) The unopposed motion be GRANTED, and the Clerk of the Court dismiss the cross-appeal assigned Appeal No. 2011-1213.

2) Each side shall bear its own costs.

FOR THE COURT:

Date: _____ _____

Copies to:

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The Office of Solicitor
United States Patent and Trademark Office
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The Board of Patent Appeals and Interferences
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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2011-1212, -1213
(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,
Cross Appellants.

Appeals from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

---

UNOPPOSED MOTION OF CROSS APPELLANTS, PAUL J. CARTER AND LEONARD G. PRESTA, FOR A THIRTY-DAY EXTENSION OF TIME TO FILE ITS OPENING BRIEF

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(202) 736-8000

Attorneys for Cross-Appellants, Carter *et al.*

June 15, 2011

CERTIFICATE OF INTEREST

Counsel for the Cross-Appellants certifies the following:

1. The full name of every party or amicus represented by me is:

PAUL J. CARTER and LEONARD G. PRESTA

2. The name of the real party in interest represented by me is:

GENENTECH, INC.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

ROCHE HOLDINGS, INC.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Oliver R. Ashe, Jr. of ASHE, P.C.
Jeffrey P. Kushan and Rachel H. Townsend of SIDLEY AUSTIN, LLP

Dated: June 15, 2011

Oliver R. Ashe, Jr.

UNOPPOSED MOTION OF CROSS APPELLANTS, PAUL J. CARTER AND LEONARD G. PRESTA, FOR A THIRTY-DAY EXTENSION OF TIME TO FILE ITS OPENING BRIEF

Pursuant to Fed. R. App. P. 26(b), Cross-Appellants PAUL J. CARTER AND LEONARD G. PRESTA ("Carter") respectfully requests that this Court grant a thirty (30) day extension of time to and including July 27, 2011, within which to file its opening brief in the above-identified case.

The date that Carter's opening brief is currently due is June 27, 2011. Carter has not previously sought any extension of time in this appeal and is filing this motion at least seven days before the brief due date. Counsel for JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, and JOHN SPENCER EMTAGE has represented that it does not oppose this motion.

There is good cause for this motion as explained below. Carter's lead attorney on this appeal, Oliver R. Ashe, Jr., is lead and backup lead counsel on five interference proceedings presently before the Board of Patent Appeals and Interferences ("the Board"). Two of these interference proceedings are in fully active motions phases and the schedules are not amenable to significant alterations. Mr. Ashe is responsible for preparing a number of motions to be filed at the Board, including motions due on Wednesday, June 15, 2011, in Interference No. 105,792, motions due on June 24, 2011, in Interference No. 105,771, and responsive motions due on July 15, 2011, in Interference No. 105,771. In addition, due to

longstanding plans for a family vacation, Mr. Ashe will be away from the office from June 25, 2011, through July 10, 2011.

Additionally, one of Carter's other appellate counsel, Jeffery P. Kushan, has a variety of professional commitments that has limited and will continue to limit the time that he is able to devote to the assistance of the preparation and review of Carter's brief. Mr. Kushan is one of the attorneys responsible for preparing and filing expert reports on July 1, 2011 in a case docketed in the District of Delaware. In addition, Mr. Kushan has a longstanding speaking engagement on June 21. And due to a longstanding professional commitment and planned vacation, Mr. Kushan will be away from the office from June 22 through June 28.

Accordingly, Carter needs additional time to prepare its brief. For the purposes of Fed. Cir. R. 27(a)(8), it is not believed that any of the above facts are subject to dispute. However, for the purposes of Fed. Cir. R. 26(b)(5), Carter hereby submits declarations of counsel showing good cause for the extension.

For the reasons set forth herein, it is respectfully requested that Carter's unopposed motion to extend the due date for its brief in the above appeal by thirty (30) days to and including July 27, 2011, be granted.

A proposed order granting the relief requested in this motion with service list is attached.

Respectfully submitted,

June 15, 2011

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(703) 467-9001

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Rachel H. Townsend
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(202) 736-8000
Attorneys for Cross-Appellants, Carter *et al.*

CERTIFICATE OF FILING

The undersigned certifies that an original and three copies of the paper entitled "**UNOPPOSED MOTION FOR CROSS APPELLANTS, PAUL J. CARTER AND LEONARD G. PRESTA, FOR A THIRTY-DAY EXTENSION OF TIME TO FILE ITS OPENING BRIEF** " was filed this 15th day of June, 2011, by Hand-Delivery, to:

Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

6-15-11
Date

Oliver R. Ashe, Jr.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the paper entitled "**UNOPPOSED MOTION FOR CROSS APPELLANTS, PAUL J. CARTER AND LEONARD G. PRESTA, FOR A THIRTY-DAY EXTENSION OF TIME TO FILE ITS OPENING BRIEF**" was served this 15th day of June, 2011, by sending in the following manner:

VIA INTERFERENCE WEB PORTAL(https://acts.uspto.gov/ifiling/):

Doreen Yatko Trujillo, Esq.
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6-15-11
Date

Oliver R. Ashe, Jr.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2011-1212, -1213
(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,
Cross Appellants.

Appeals from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

ORDER

Upon consideration of the Unopposed Motion for Extension of Time filed by Cross-Appellants PAUL J. CARTER and LEONARD G. PRESTA,

IT IS ORDERED THAT:

1) The unopposed motion be GRANTED, and the Clerk of the Court note this extension on the docket.

2) The principal brief of Cross-Appellants PAUL J. CARTER and LEONARD G. PRESTA shall be due on July 27, 2011.

FOR THE COURT:

Date: _____ _____

Service List:

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2011-1212, -1213
(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,
Cross-Appellants.

Appeals from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

Declaration of Oliver R. Ashe, Jr.

1. I am lead counsel for Cross-Appellants PAUL J. CARTER and LEONARD G. PRESTA ("Carter").

2. This appeal was docketed in this Court on February 15, 2011, which made Appellants JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, and JOHN SPENCER EMTAGE ("Adair")'s opening brief due on April 18, 2011. Adair requested and was granted an extension of time in which to file its opening brief. Adair filed that brief on May 13, 2011. Based on the May 13 filing of Adair's brief, Carter's brief is due on June 27, 2011.

3. I am lead and backup lead counsel on five interference proceedings presently before the Board of Patent Appeals and Interferences ("the Board"). Two of these interference proceedings are in fully active motions phases and the schedules are not amenable to significant alterations. I am responsible for preparing a number of motions to be filed at the Board, including motions due on Wednesday, June 15, 2011, in Interference No. 105,792, and motions due on June 24, 2011, in Interference No. 105,771, and responsive motions due on July 15, 2011, in Interference No. 105,771. In addition, due to longstanding plans for a family vacation, I will be away from the office from June 25, 2011, through July 10, 2011.

4. While significant efforts have been made to avoid having to seek an extension in this case, it has now been determined that an extension of time of thirty (30) days to and including July 27, 2011, would allow adequate time for me to coordinate the drafting, reviewing and filing of Carter's brief.

Pursuant to 29 U.S.C. §1746, I declare under penalty of perjury that the foregoing is true and correct.

June 15, 2011

Oliver R. Ashe, Jr.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2011-1212, -1213
(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,
Cross-Appellants.

Declaration of Jeffrey P. Kushan

1. I am co-counsel for Cross-Appellants PAUL J. CARTER AND LEONARD G. PRESTA ("Carter").

2. This appeal was docketed in this Court on February 15, 2011, which made Appellants JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, and JOHN SPENCER EMTAGE ("Adair") opening brief due on April 18, 2011. Adair requested and was granted an extension of time in which to file its opening brief. Adair filed that brief on May 13, 2011. Based on the May 13 filing of Adair's brief, Carter's brief is due on June 27, 2011.

3. Various professional commitments have limited and will continue to limit the time that I am able to devote to the assistance of the preparation and review of

Carter's opening brief. Among other matters, I am counsel for Alza Corporation and Ortho-McNeil-Janssen Pharmaceuticals, Inc. in *Alza Corp. v. Kremers Urban, LLC.*, CA No. 10-23-LPS (D. Del.) and am one of the attorneys responsible for preparing and filing expert reports in that case on July 1, 2011. I also have a speaking engagement on June 21 for which I will be out of the office. In addition, due to a longstanding professional commitment and family vacation, I will be away from the office from June 22 through June 28.

4. As a result of these and other commitments, and despite diligent efforts, it will not be possible for me to assist in the preparation and filing of Carter's opening brief in this matter by June 27, 2011. An extension of time of thirty (30) days to and including July 27, 2011, would allow adequate time for counsel to coordinate the drafting, reviewing and filing of Carter's brief.

Pursuant to 29 U.S.C. §1746, I declare under penalty of perjury that the foregoing is true and correct

June 15, 2011

Jeffrey P. Kushan

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, AND JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER AND LEONARD G. PRESTA,
Appellees.

2011-1212
(Interference No. 105,744)

Appeal from the United States Patent & Trademark Office, Board of Patent Appeals and Interferences.

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, AND JOHN SPENCER EMTAGE,
Appellees,

v.

PAUL J. CARTER AND LEONARD G. PRESTA,
Appellants.

2011-1213
(Interference No. 105,744)

Appeal from the United States Patent & Trademark Office, Board of Patent Appeals and Interferences.

ORDER

Upon consideration of the cross-appellants' unopposed motion for voluntary dismissal of cross-appeal, 2011-1213, pursuant to Fed. R. App. P. 42(b),

IT IS ORDERED THAT:

The motion is granted. The revised caption in 2011-1212 is reflected above.

(2) Each side shall bear its own costs in 2011-1213.

FOR THE COURT

JUL 6 2011
Date

/s/ Jan Horbaly
Jan Horbaly
Clerk

cc: Doreen Yatko Trujillo, Esq.
Oliver R. Ashe, Jr., Esq.

s24

ISSUED AS A MANDATE (as to 2011-1213 only): JUL 6 2011

2011-1212
(Interference No. 105,744)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,

Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,

Cross Appellants.

Appeals from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

REPLY BRIEF OF THE APPELLANTS JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, and JOHN SPENCER EMTAGE

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(Counsel of Record)
Kyle Vos Strache
Cozen O'Connor, P.C.
1900 Market St.
Philadelphia, PA 19103
215-665-2000

Attorneys for Appellants
John Robert Adair, Diljeet Singh Athwal,
And John Spencer Emtage

Dated: August 15, 2011

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party) APPELLANT ADAIR certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

UCB Pharma S.A.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

UCB Pharma S.A. is wholly-owned by UCB S.A.
Financiere de Tubize S.A. is a publicly owned company that owns more than 10% of the stock of UCB S.A.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Cozen O'Connor P.C. – Doreen Yatko Trujillo, Michael B. Fein, Kyle Vos Strache

August 15, 2011
Date: August 15, 2011

Doreen Yatko Trujillo
Signature of counsel

Doreen Yatko Trujillo
Printed name of counsel

TABLE OF CONTENTS

TABLE OF AUTHORITIES

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Cases:

Statutes & Other Authorities:

INTRODUCTION

Carter dedicated over seven pages of its 57-page brief (twice as long as Adair's principal brief) arguing, essentially, that Adair's claims should be limited by its specification, and that the specification requires multiple framework residues to be changed to donor, i.e., to be non-human (Red Br. 11-18). Adair is unsure why Carter dedicated such a major portion of its brief to an argument not relevant to the issues on appeal. Nonetheless, Carter is misrepresenting Adair's specification. Adair's specification is not as limiting as Carter alleges – the specification does not require multiple framework residues to be changed (A565). Carter is relying upon what is clearly delineated as a "preferred" protocol in arguing that the specification is so limited (Red Br. 12; A576). Further, *In re* Berger, 279 F.3d 975 (Fed. Cir. 2002) disapproves of focusing upon the specification for satisfying *§ 135(b)*. *Id.*, at 983.

Citing an irrelevant patent issued to Adair, Carter also advances the disingenuous argument that changing multiple residues to donor was necessary for Adair to overcome the prior art (Red Br. 18). But Carter's claims do not recite changing multiple residues (A91-3). If the recitation of multiple residues was not necessary for Carter's claims to overcome the prior art, then it is difficult to see how it would be necessary for Adair claim 24.

Neither of the foregoing arguments is relevant to the basis for this appeal.

I. The Basis For This Appeal

The basis for this appeal is the correct interpretation of 35 U.S.C. § 135(b). Specifically, does *§ 135(b)* require applicants to show, in an interference based upon a claim that was submitted post-critical date, not only that the claim has pre-critical date support for its post-critical date identity with a claim of the patent, but also an additional requirement, as Carter and the Board allege, that the claim does not differ from the pre-critical date claim in virtually any respect? By presuming that any change to pre-critical date claims is material and suggesting (repeatedly) that Adair could have moved to add claims **identical** to pre-critical date claims in the involved application, the Board is essentially requiring a showing that the post-critical date claim does not differ from the pre-critical date claim in any respect, thereby setting forth a standard that is not only inconsistent with legal precedent, but is also impossible for applicants to meet.

As anyone who has prosecuted an application before the USPTO[1] knows, particularly in the field of biotechnology, originally-filed claims are rarely, if ever, allowed. Indeed, if they are, applicants are concerned that they did not claim broadly enough. Thus, the fact that an applicant chooses to amend the claims upon rejection, or even cancel them in favor of different claims, is not a concession of unpatentability *per se*, particularly for applications filed after June 7, 1995, but

[1] Unless otherwise indicated, the same abbreviations as were used in the principal brief are used here.

more a reflection of a desire to get allowable claims in a reasonable time frame. An appeal of a rejection can take years to be resolved, particularly if the appeal has to be taken to this Court.

II. 35 U.S.C. § 135(b) Does Not Require An Additional Comparison Between Pre- And Post-Critical Date Claims Without Reference To The Patent Claims Being Copied For Interference

Adair contends that this Court did not impose an additional requirement in *Regents of the Univ. of Cal. v. Univ. of Iowa Res. Found.*, 455 F.3d 1371 (Fed. Cir. 2006), *reh'g en banc denied*, 2006 U.S. Appl. Lexis 27583 (Fed. Cir., Oct. 16, 2006) that pre- and post-critical date claims do not differ from each other in any respect, irrespective of whether or not both contain all material limitations of the patent claim. In *Regents*, this Court stated that *§ 135(b)* prohibits unsupported post-critical date **identity** with a **patent** claim, that one must show pre-critical date support for the post-critical date **identity** between the post-critical date claim in interference and a **patent** claim, and that this demonstration entails a comparison between the pre- and post-critical date claims. *Id.*, at 1375, emphasis added. Accordingly, the pre-critical date claim must have all material limitations of the post-critical date claim, with materiality being assessed in view of the patent claim. This analysis is all that the precedent cited throughout *Regents*, i.e., *Berger*, 279 F.3d 975 and *Corbett v. Chisholm*, 568 F.2d 759 (CCPA 1977), required. In *Berger*, a limitation added by the patentee was considered material.

> The Board found the "circumferential groove" limitation to be material because it was added by Muller [the patentee] during prosecution to avoid prior art. We agree with the Board's determination of materiality.

Berger, 279 F.3d at 982. Similarly, in Chisholm, materiality was assessed in view of the patent claim.

> Turning to a comparison of Chisholm patent claim 1 and claims 24-27, we agree with the conclusion of the board that these claims, even considered as a group, do not recite Chisholm's claimed squeezing step (b). Corbett does not seriously contend that this is not a material limitation, that is, necessary to patentability. . . There being a material limitation of the copied claim not present in Corbett's claims 24-27, they cannot be said to be directed to substantially the same invention.

Corbett, 568 F.2d at 765-66. The pre-critical date claim does not need to have all limitations of the post-critical date claim, then, just those limitations that were material to the **patented** claim.

Indeed, every express limitation is not material under *§ 135(b)*. *Stalego v. Heymes*, 263 F.2d 334, 339 (CCPA 1959). A review of *Berger* reveals that the "circumferential groove" was not the only difference between the post-critical date claim that was copied from the Muller patent and the pre-critical date claim. The pre-critical date claim also did not contain a recitation of a pull tab. *Berger*, 279 F.3d 977-78.

When the post-critical date claim contains all material limitations of the patented claim the comparison becomes, in essence, a comparison between the pre-

critical date claims and the patent claims. *See Berger*, 279 F.3d at 982-83 and *Corbett*, 568 F.2d at 763,765-66. The Court in *Regents* also stated, however, that there is a distinction between comparing pre- and post-critical date claims with one another and comparing pre-critical date claims with the patented claims. *Regents*, 455 F.3d at 1375. The Board, and Carter, has interpreted this statement in *Regents* to mean that there is an additional requirement that the pre-critical date claims contain, essentially, all the limitations of the post-critical date claims, and *vice versa*, irrespective of whether both contain all material limitations of the patent claims. Adair, however, cannot reconcile this interpretation with the purpose of *§ 135(b)*, nor the Court's statements in *Regents* regarding the purpose of *§ 135(b)*, i.e., prohibiting unsupported post-critical date identity with the patent claim, nor the Court's repeated references to *Berger* and *Corbett*. *Regents*, 455 F.3d 1374-75.

An alternative interpretation proffered by Adair in this interference is that if, after prosecution, the applicant's allowed post-critical date claims lack material limitations from the pre-critical date claims, i.e., limitations that were necessary to the patentability of the patent claims, the applicant should not be allowed in the interference, as the claims are no longer to substantially the same invention (Br. 14). Under such circumstances, it would not be sufficient to compare the pre-critical date claims to the patent claims alone. Consistent with this view, the Court distinguished cases in which the post-critical date claims were the ones copied

from the patent. *Regents*, 455 F.3d at 1375.

This interpretation seems to be the most consistent with the whole of the Court's decision but, unfortunately, it is not consistent with the underlying facts as Adair interprets them. A review of the underlying decision of the Board in *Regents* suggests that the post-critical date claim had all the material limitations of the patented claim. *Univ. of Iowa Res. Found. v. Regents of the Univ. of Cal.,* Interf. No. 105,171, slip op. at 3 and 6 (B.P.A.I. March 10, 2005) (Board Decision) Perhaps, however, the Court took the appellant in *Regents* at its word that there were material differences between the post- and pre-critical date claims, and assumed that the post-critical date claims were no longer to the same invention as the patent claims.

Assuming Adair's alternative interpretation is correct, *Regents* is not applicable to the current facts. Adair first requested this interference post-critical date. Even if applicable, Adair maintains that *Regents* did not create an additional test for materiality completely divorced from the patent claims for purposes of compliance with *§ 135(b)*.

Carter argues, incredulously, that this Court found the limitations of the patent claims to be irrelevant in *Regents* because "the relevant question for the issue of repose is whether the later claim is entitled to the effective date of the earlier claim . . . which is essential to establishing that the *same* interference could

have been declared earlier" (Red Br. 43, emphasis in original). Adair questions how the limitations of the patent claims can ever be irrelevant under a statute that requires that a claim that is to substantially the same subject matter as a claim of an issued **patent** be submitted within a specified time frame. 35 U.S.C. § 135(b). Further, *§ 135(b)* does not require that the **same** interference could have been declared earlier, just that **an** interference could have been declared earlier.

Adair contends that both Carter and the Board are confounding the analysis for determining effective filing date for purposes of 35 U.S.C. § 120 with the analysis for determining effective filing date for purposes of 35 U.S.C. § 135(b). But these sections of the Patent Statute serve distinct purposes and have very different requirements. This distinction was recognized in *Berger* which refers to "the earlier effective filing date of those prior claims **for purposes of satisfying 35 U.S.C. § 135(b)**." *Berger*, 279 F.3d at 982 (emphasis added). For example, *§ 120* allows an application for patent to rely upon the filing date of an earlier filed application if the invention is disclosed in the earlier application in the manner provided by the first paragraph of 35 U.S.C. § 112. 35 U.S.C. § 120. Accordingly, under *§ 120*, one must show, *inter alia*, written descriptive support for the recitations in the claims in earlier applications, and one can look to the specification for such support. Contrastingly, *§135(b)* makes no reference to the first paragraph of 35 U.S.C. § 112, nor to the benefit of a filing date, and focuses

upon the claims alone. All that *§ 135(b)* requires is that a claim that is to substantially the same subject matter, not exactly the same subject matter, as a claim of the patent be made prior to one year from the date the patent was granted. 35 U.S.C. § 135(b). The Board and Carter, however, are requiring applicants to show, allegedly under *§ 135(b)*, written descriptive support for all recitations in the post-critical date claims in the pre-critical date claims themselves.

One source of the confusion may be the apparent discrepancy in the various reported versions of a statement in *Berger*, 279 F.3d at 982. The Lexis® and Westlaw® electronic databases report the statement as the following:

> This is a distinctly different question from whether claims made for purposes of interference by different parties are directed to **interfering** subject matter.

Other electronic databases, as well as the book version of the reporter, report the statement as the following:

> This is a distinctly different question from whether claims made for purposes of interference by different parties are directed **to the same or substantially the same** subject matter.

The differences between the two are highlighted in bold. Notably, the immediately preceding sentence in *Berger* sets forth what must be shown under *§ 135(b)*. *Id.*, 279 F.3d at 981-2. As discussed above, *§ 135(b)* recites the language "the same or substantially the same subject matter." 35 U.S.C. § 135(b). Adair contends that the correct version is the first one because interfering subject matter under (prior)

37 C.F.R. § 1.601 was being distinguished from the requirements under *§ 135(b)* in *Berger*. *Id.* Under the latter version, showing that claims are to the same or substantially the same subject matter is being distinguished from showing that claims are to the same or substantially the same subject matter.

III. Even If An Additional Comparison Under *§135(b)* Is Required, Adair Claim 24 Satisfies It

As the Board, and Carter, repeatedly asserted, a limitation that is necessary to patentability is material (see, for example, Red Br. 36). Adair claim 24, having been indicated as allowable, is presumptively patentable (Red Br. 26). If Adair claim 24 is lacking limitations from the earlier claims, then, those limitations could not have been material. Regardless, as Adair argued in its request for rehearing, claim 2 of the PCT application recites all the residues recited as alternatives in Adair claim 24 (Br. 14; A431, A435). As shown in the appendix to Adair's request for rehearing, claim 16 of the PCT application, as depending from claim 2 of the PCT application, thus, contains all material limitations of Adair claim 24, and *vice versa*.[2] The Board declined to consider claim 2 of the PCT application,

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[2] Carter also argues that the Board noted that Adair did not make a sufficient comparison to show that claim 2 is materially the same as the copied claim, evidently in reference to claim 66 of the Carter patent (Red Br. 24). In its initial decision, however, the Board argued that Adair was not to compare its pre-critical date claims to the patent claims under *Regents* (A9). Regardless, if Adair claim 24 contains all material limitations of claim 66 of the Carter patent, which neither the Board nor Carter has argued to the contrary, and claim 16 of the PCT application, as depending from claim 2, contains all material limitations of Adair claim 24,

however, citing a rule related to *ex parte* appeals, not interferences (A26).

In defense of the Board's declination, Carter asserts that Adair has been prosecuting this portfolio for over 14 years and had ample opportunity to explain why claim 2 provided the requisite pre critical date support under *§ 135(b)* (Red Br. 51). Carter's assertion is flawed. Adair had only been trying to provoke an interference with the Carter patent since November 21, 2005 (Br. 2-3). Adair would have had no reason to raise the issue before then. Further, as Adair has repeatedly pointed out, the rules do not require Adair to show compliance with *§ 135(b)* to provoke an interference (Br. 4-5). Carter keeps faulting Adair for not raising an issue that Adair was not required to raise. Notably, nothing prevented the USPTO from raising *§135(b)* as a basis for rejection during that five-year period. *See Berger*, 279 F.3d at 981.

Carter also asserts the Adair's submission of arguments regarding claim 2 of the PCT application were belated (Red Br. 52-3). Carter notes that the Board's Standing Order explains that the Board will not consider evidence presented belatedly in a reply (Red Br. 52). Carter is completely disregarding that the burden was on Carter, as the movant, to make out a *prima facie* case, not on Adair. All Adair needed to do in its opposition was address the arguments raised by Carter. Carter did not cite *Regents* in its motion to support its arguments that Adair claim

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claim 16 of the PCT application, as depending from claim 2, must contain all material limitations of claim 66 of the Carter patent.

24 differed materially from Adair's non-original, pre-critical date claims (A308). In its opposition, then, Adair focused upon arguing that Carter was applying the incorrect materiality test (372). *Regents* was first raised by the Board in its decision (A6). Adair's first chance to address the Board's interpretation of *Regents*, thus, was in its request for rehearing.

Carter also argues that 37 C.F.R. § 41.125(c)(3) prevents a party from raising a matter on rehearing that was not previously addressed by requiring a party to show all matters believed to have been overlooked and to show where the matter was previously addressed in the motion, opposition, or reply (Red Br. 52). First, the Board did not raise this section of the regulations in its decision. Second, Adair complied with 37 C.F.R. § 41.125(c)(3). Adair pointed out that the Board had overlooked claim 2 of the PCT application because Carter failed to meet its burden of addressing each pre-critical date claim in its motion, which Adair had argued in its opposition (A430-1; A370-1).

Regardless, the Board did not raise the Standing Order or 37 C.F.R. § 41.125(c)(3) when it declined to consider claim 2 of the PCT application. Rather, the Board cited a rule relating to *ex parte* appeals (A26). Adair pointed out this further legal error in its brief (Br. 27). Carter faults Adair for not arguing that the Board's declination was arbitrary or unreasonable or otherwise an abuse of discretion (Red Br. 51). Adair did not make such arguments because Adair

contends it was legal error for the Board to apply the wrong regulation. Nonetheless, an abuse of discretion can be established if the exercise of discretion is based upon **an error of law**. *Novo Nordisk of North America, Inc. v. Genentech, Inc.*, 77 F.3d 1364, 1367 (Fed. Cir. 1996) (emphasis added).

IV. No Precedent Requires Patentability of Pre-critical Date Claims Under *§ 135(b)*

Carter maintains that pre-critical date claims must be patentable (Red Br. 37). Notably, Carter could not point to any legal precedent supporting its position that *§ 135(b)* requires pre-critical date claims to be patentable. Instead, Carter could only argue that the absence of observations in *Corbett* regarding the requirement of patentability of pre-critical date claims cannot be used as precedent that patentability of a pre-critical date claim is **not** a factor in a *§ 135(b)* determination (Red Br. 40-1, emphasis added). But Carter is wrong regarding the absence of observations in *Corbett* regarding the requirement of patentability of pre-critical date claims. In *Corbett*, four sets of pre-critical date claims (or 12 claims) were being analyzed to determine support for the post-critical date claim copied from the patent in interference. *Corbett*, 568 F.2d at 759-63. The court indicated that one claim (which made up one of the sets) was allowed. *Id.*, at 763. The court, thus, did make observations about the patentability of the pre-critical date claims, but clearly did not consider it a factor in its *§ 135(b)* analysis.

Carter's error regarding *Corbett* appears to be based upon a misreading of

the facts. Carter asserts that patentability was not an issue addressed by the court in *Corbett* because the pre-critical date claims and post-critical date claims were identical (Red Br. 40). Carter is wrong. One set of pre-critical date claims (four claims) was cancelled even before the involved patent had issued, so there clearly could not be any post-critical date claims identical to those claims. *Corbett* at 761.

Regardless, the fact that Carter could not point to any precedent in **support** of a requirement of showing patentability supports Adair's contention that such a requirement by the Board is legal error.

V. The Board Cannot Create Substantive Law

Adair maintains that the burden was upon Carter, as the movant, to show that **no** Adair pre-critical date claim supports the identity between the patent claim and the post-critical date claim. If the application claims priority to several applications and spans over 12 years of prosecution, as in the present case, the burden on the patentee can be quite onerous. No matter how onerous the patentee's burden may be, however, the Board does not get to shift the burden of persuasion to Adair through its creation of a presumption, particularly one as far-reaching as the one created here – i.e., that a cancelled pre-critical date claim is, *a priori*, materially different from the post-critical date claim. In support of the presumption created by the Board, Carter argues that courts routinely draw from related legal doctrines to support their decisions. The Board, however, is not a

court of law, and does not get to create substantive law. *See Merck & Co., Inc. v. Kessle*r, 80 F.3d 1543, 1549–50 (Fed. Cir. 1996) ("[T]he broadest of the PTO's rulemaking powers—35 U.S.C. §6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does not grant the Commissioner the authority to issue substantive rules.")

VI. The Board Improperly Shifted The Burden Of Production To Adair

In addition to creating the presumption, the Board inappropriately shifted the burden of production to Adair. Citing 37 C.F.R. § 41.208(b), Carter contends that the USPTO's regulations only require a "**demonstration** that if unrebutted would justify the relief sought" by the movant to make out a *prima facie* showing (Red Br. 47, emphasis added). The cited rule does not require a mere demonstration, however, but rather a "showing." 37 C.F.R. § 41.208(b). As Adair stated previously, the burden was upon Carter to **show** that none of Adair's pre-critical date claims could be relied upon under *§ 135(b)* (Br. 17), not to **demonstrate** that some of Adair's pre-critical date claims could not be relied upon. Under Carter's analysis, demonstrating that **two** patent claims out of many are invalid would be sufficient to shift the burden of production to the patentee to show that **all** of its claims are valid. It is doubtful that Carter would argue that the burden should be shifted under such circumstances.

Carter further contends that the showing by Carter was completely reasonable in view of the page limitations for briefs in an interference. Carter alleges that it would have been impossible for Carter to separately address each of Adair's pre-critical date claims in the 25-page limit (Red Br. 48). Of course, Carter could have asked for a waiver of the page limit. Regardless, Adair is aware of no precedent excusing a party from meeting their burden because of a page limit.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

Adair contends that the Board erred as a matter of law in finding that Adair claim 24 does not comply with 35 U.S.C. § 135(b)(1). Adair respectfully requests that this Court reverse the Board's decision and deny Carter Substantive Motion 1.

Respectfully Submitted,

Dated: August 15, 2011

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CERTIFICATE OF SERVICE

United States Court of Appeals
for the Federal Circuit
No. **2011-1212 (Interference No. 105,744)**
----------)
John Robert Adair, Diljeet Singh Athwal, and
John Spencer Emtage

Appellants,

v.

Paul J. Carter and Leonard G. Presta,

Cross Appellants.
----------)

I, Elissa Matias being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by COZEN O'CONNOR, Attorneys for Appellants to print this document. I am an employee of Counsel Press.

On the **15th Day of August, 2011**, I served the within **Reply Brief of Appellants John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage** upon:

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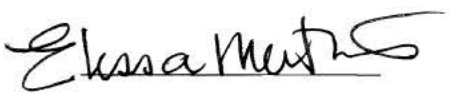
via Federal Express, overnight delivery by causing 2 true copies of each, enclosed in a properly addressed wrapper, to be deposited in an official depository of FedEx.

Unless otherwise noted, 12 copies have been delivered to the Court on the same date via Federal Express

August 15, 2011



United States Court of Appeals for the Federal Circuit

(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, AND JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER AND LEONARD G. PRESTA,
Appellees.

2011-1212

Appeal from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

Decided: February 7, 2012

DOREEN YATKO TRUJILLO, Cozen O'Connor, P.C., of Philadelphia, Pennsylvania, argued for appellants. With her on the brief was KYLE VOS STRACHE.

OLIVER R. ASHE, JR., Ashe, P.C., of Reston, Virginia, argued for appellees. Of counsel on the brief were JEFFREY P. KUSHAN and RACHEL H. TOWNSEND, Sidley Austin, LLP, of Washington, DC.

Before RADER, *Chief Judge*, LINN and MOORE, *Circuit Judges*.

LINN, *Circuit Judge*.

Appellants John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage (collectively, "Adair") appeal a decision of the Board of Patent Appeals and Interferences ("Board") holding that Adair's single claim involved in Interference 105,744 with junior party Paul J. Carter and Leonard G. Presta (collectively, "Carter") was barred under 35 U.S.C. § 135(b)(1). Because the Board properly determined that Adair's claim was barred under § 135(b)(1), this court affirms.

I. BACKGROUND

On November 21, 2005, Adair filed U.S. Application Serial No. 11/284,261 ("'261 Application") with the United States Patent and Trademark Office ("PTO"). In a preliminary amendment filed concurrently with this application, Adair requested an interference based on Carter's U.S. Patent No. 6,407,213 ("'213 Patent"). The only count of the interference is drawn to humanized antibodies. More specifically, the count involves non-human amino acid substitutions on specific residues of the heavy chain variable domain (an antibody comprises two light chains and two heavy chains, each with a "constant" and "variable" domain). On February 2, 2010, the Board declared the interference, identifying the claims in the count to be claims 30, 31, 60, 62, 63, 66, 67, 70, 73, 77-81 of the '213 Patent and claim 24 of the '261 Application. *Carter v. Adair*, Interference No. 105,744, Declaration of Interference at 4 (Feb. 2, 2010). The Board awarded Adair priority benefit to PCT/GB90/02017 ("PCT Application"), filed December 21, 1990, which claims priority to a British application filed by Adair on December 21, 1989.

Claim 66 of Carter's '213 Patent, representative of the claims in the count and the basis for an interference-in-fact, recites:

> **66.** A humanized antibody heavy chain variable domain comprising non-human Complementarity Determining Region (CDR) amino acid residues which bind antigen incorporated into a human antibody variable domain, and further comprising a Framework Region (FR) amino acid substitution at a site selected from the group consisting of: 24H [H=heavy], 73H, 76H, 78H, and 93H, utilizing the numbering system set forth in Kabat.

'213 Patent col.88 l.66-col.89 l.6.

Corresponding claim 24 in Adair's '261 Application recites:

> 24. A humanised antibody *comprising a* heavy chain variable domain comprising non-human complementarity determining region amino acid residues which bind an antigen and a human framework region wherein said framework region comprises a *non-human* amino acid substitution at a residue selected from the group consisting of 23, 24, 49, 71, 73, and 78, and combinations thereof, as numbered according to Kabat.

'261 Application, Preliminary Amendment and Request for Interference dated Nov. 21, 2005 at 3, *as amended by* Amendment of Sept. 9, 2009 at 4 (added language emphasized).

Because Adair's claim 24 was not presented to the PTO prior to June 18, 2003, one year from issuance of the Carter '213 Patent (the "critical date") as required by 35 U.S.C. § 135(b)(1), Adair relied on pre-critical date claims

1 and 16 of the PCT Application and corresponding U.S. national stage Application No. 07/743,329 ("'329 Application") to avoid the bar of § 135(b)(1). Claims 1 and 16 recite:

> 1. A CDR-grafted antibody heavy chain having a variable region domain comprising acceptor framework and donor antigen binding regions wherein the framework comprises donor residues at at least one of positions 6, 23 and/or 24, 48 and/or 49, 71 and/or 73, 75 and/or 76 and/or 78 and 88 and/or 91.
>
> 16. A CDR-grafted antibody heavy or light chain or molecule according to any one of the preceding claims comprising human acceptor residues and non-human donor residues.

PCT Application at 67-69. Adair originally relied on claim 8 of the PCT Application, but because that claim related to light chains, Adair later abandoned that argument. In its request for rehearing before the Board, Adair argued for the first time that claim 2 of the PCT Application also provided pre-critical date support for claim 24, but the Board declined to consider this argument for the first time on rehearing. *Carter v. Adair*, Interference No. 105,774, Decision on Request for Rehearing at 4-5 (Nov. 5, 2010) ("*Rehearing*").

At the national stage, the examiner originally rejected each of Adair's PCT claims under one or more of the following sections: 101, 102(b), 103, and 112 first and second paragraphs. '329 Application, Office Action of November 18, 1992. Adair cancelled the PCT claims and added claims 23-66, later cancelled by an amendment adding claims 67-119 requiring multiple amino acid substitutions at specific locations in the heavy chain. '329

Application, Amendments of January 19, 1993 and April 16, 1993.

The Board rejected Adair's argument that claims 1 and 16 in the PCT Application provide pre-critical date support for claim 24 in the '261 Application because: (1) the PCT claims were not patentable to Adair; (2) Adair added limitations to overcome the examiner's rejection; and accordingly, (3) material differences presumptively existed between the post- and pre-critical date claims that Adair failed to rebut. *Carter v. Adair*, Interference No. 105,774, Decision on Motions at 9-10 (Aug. 30, 2010) ("*Decision*"). Citing *Regents of the University of California v. University of Iowa Research Foundation*, 455 F.3d 1371, 1377 (Fed. Cir. 2006), the Board stated that "[a]n applicant cannot expect to avoid the bar of § 135(b) by timely copying a claim from an issued patent when that claim is not patentable to that applicant." *Decision* at 10-11. On rehearing, the Board rejected Adair's assertion that materiality must be "determined in view of the patent claims being copied" and declined to compare Adair's post- or pre-critical date claims with copied claim 66 from Carter's '213 Patent. *Rehearing* at 3. Adair appeals, and this court has jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

II. DISCUSSION

A. Standard of Review

"We review the Board's construction of 35 U.S.C. § 135(b)(1) de novo, as statutory interpretation is a question of law." *In re Berger*, 279 F.3d 975, 980 (Fed. Cir. 2002).

B. Analysis

Adair argues that the Board erred by failing to assess material differences "in view of the patent claim being copied [claim 66 from Carter's '213 Patent]." Appellant Br. 22. According to Adair, this court's precedent does not endorse a test that allows the Board to completely ignore copied claim 66 from Carter's '213 Patent when assessing the material differences between the post- and pre-critical date claims. Adair argues that the materiality test from *Berger* and *Regents* requires an assessment of material limitations based on the "identity" between the post-critical date claim and copied claim 66 from Carter's '213 Patent—in other words, in view of the "count"—and not based on the post-critical date claim standing alone. *See Regents*, 455 F.3d at 1375 ("[A]s this court's precedent explains, California must demonstrate that claims in the '191 application provide pre-critical date support for the *post-critical date identity* between claim 205 [the post-critical date claim] and the '646 patent [the issued patent]." (emphasis added)); *Berger*, 279 F.3d at 983.

Carter counters that the question of "[w]hether there is a sufficient degree of identity between pre- and post-critical date claims for compliance with § 135(b) is an inquiry that is distinct and independent" from any comparison with the patent claims copied. Appellee Br. 33. According to Carter, the Board correctly interpreted § 135(b)(1) in holding that "establishing support for post-critical date claims does not entail looking at material limitations of the patented claims." *Id.* 42.

This court agrees with Carter. Section 135(b)(1) states:

> A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any appli-

> cation unless such a claim is made prior to one year from the date on which the patent was granted.

35 U.S.C. § 135(b)(1). Notwithstanding the seemingly strict language of the statute, a limited exception to this one year bar exists "where the copier had already been claiming substantially the same invention as the patentee" during the critical time period. *Corbett v. Chisholm*, 568 F.2d 759, 765 (CCPA 1977).

i.

In *Corbett*, the post-critical date claims "correspond[ed] exactly" with issued "Chisholm patent" claim 1. 568 F.2d at 759. The Board rejected Corbett's post-critical date claims under § 135(b)(1). *Id.* Corbett relied upon several groups of pre-critical date claims from the application and a predecessor application in an attempt to avoid the § 135(b) bar. *Id.* at 761-63. On appeal, this court compared the "copied claim" with the pre-critical date claims and affirmed the Board's finding that material differences precluded Corbett from relying on any of the pre-critical date claims to overcome the § 135(b) bar. *Id.* at 765-66. In identifying certain limitations of Chisholm patent claim 1 as "material," the court was simply noting the material differences that existed between that claim as copied by Corbett after the critical date and those pre-critical date claims Corbett was relying on to overcome the § 135(b) bar. The court did not establish any rule requiring some sort of threshold assessment of which limitations of the copied patent claim are material before determining whether material differences exist between post- and pre-critical date claims. In making this comparison, the court referenced Chisholm patent claim 1 only because that was the post-critical date claim.

Similarly, in *Berger*, the post-critical date claim was copied directly from and identical to issued "Muller patent" claim 1. 279 F.3d at 978. The examiner rejected Berger's pre-critical date claims 1-6 for indefiniteness and other grounds, and rejected post-critical date claim 7 under § 135(b)(1). *Id.* at 979. The Board rejected Berger's argument that claims 1-6 provided pre-critical date support for claim 7 because it found material differences between the "copied claim" and the pre-critical date claims, and this court affirmed. *Id.* at 982 ("The Board found the 'circumferential groove' limitation to be material because it was added by Muller during prosecution to avoid prior art. We agree with the Board's determination of materiality."). Again, the court in *Berger* referenced the issued Muller patent claim 1 only because the post-critical date claim, claim 7, was a direct copy of the patent claim. *Id.* at 981-83. This court affirmed the Board's analysis based only on the material differences between the *post- and pre-critical date claims*. *Id.* at 983 ("Because Berger's *original claims 1-6* [the pre-critical date claims] *do not include a material limitation of Berger claim 7* [the post-critical date claim], copied claim 7 is not entitled to the earlier effective date of those original claims for purposes of satisfying § 135(b)." (emphasis added)).

In *Regents*, this court expressly approved an analysis of material differences based solely on a comparison of the post- and pre-critical date claims in order to obtain the benefit of the earlier filing date:

> The Board compared claim 205 [the post-critical date claim] with claims 202-203 . . . and then with claim 204 [collectively, the pre-critical date claims]. The Board found that California's claim 205 contained material differences from claims 202-204. Therefore, claim 205 could not benefit from the earlier filing date of those claims. . . . On

> appeal, California does not contest the Board's finding of material differences between claim 205 and claims 202-204. Instead, California challenges the Board's conclusion that the correct inquiry under § 135(b)(1) asks whether claims 202-204 contain material differences from claim 205 and not whether claims 202-204 are to the same invention as claims in the '646 patent.

455 F.3d at 1373. The court in *Regents* rejected California's argument, explaining that "the relationship between the post- and pre-critical date claims . . . is not only relevant, but dispositive of the section 135(b)(1) question." *Id.* at 1374. Adair's arguments in this case are similar to California's arguments in *Regents*, where the court held that there is no requirement that the Board reference the issued patent claim(s) in the count to assess the material differences between the post- and pre-critical date claims. *Id.* at 1374-76.

The statement in *Regents* that the applicant's earlier filed claims must "provide pre-critical date support for the *post-critical date identity* between [the post-critical date claim] and the [issued patent]" to avoid the § 135(b)(1) bar, 455 F.3d at 1375 (emphasis added), does not require the Board to assess material differences in view of the issued patent claim(s) in the count. *See Berger*, 279 F.3d at 982. The question of material differences between post- and pre-critical date claims for purposes of overcoming a § 135(b) bar "is a distinctly different question from whether claims . . . are directed to the same or substantially the same subject matter" for purposes of provoking an interference. *Id.* As explained in *Regents*, § 135(b) is a statute of repose, intended to "limit[] the patentee's vulnerability to a declaration of an interference" by "limit[ing] the window of time in which the cause of the interference can occur." 455 F.3d at 1376. When a material difference exists between the post- and pre-critical

date claims, a belated interference is improper because it would be a "*different interference*[]" than that which "should have been earlier declared by the PTO." *Id.* (emphasis added).

For these reasons, this court holds that to overcome a § 135(b) bar for a post-critical date claim, an applicant must show that such claim is not materially different from a pre-critical date claim present in the application or any predecessor thereto in order to obtain the benefit of the earlier filing date. Any claims filed within the critical period, whether or not later cancelled, may provide pre-critical date support for the later filed patent claim(s), so long as the pre-critical date claims are not materially different from the later filed claim(s). *Corbett*, 568 F.2d at 765-66; *see also Regents*, 455 F.3d at 1373; *Berger*, 279 F.3d at 981-82.

Here, the Board found material differences between post-critical date claim 24 of the '261 Application and pre-critical date claims 1 and 16 of the PCT Application based on the prosecution history of the '261 Application. During prosecution, Adair added several limitations to claim 24—limitations not present in claims 1 and 16 of the PCT Application—to avoid examiner rejections during prosecution. *Decision* at 9. Adair failed to rebut the Board's finding with any evidence that the differences between claim 24 and claims 1 and 16 of the PCT Application were immaterial. *Id.* at 10. Adair criticizes the Board for failing to consider claim 66 from Carter's '213 Patent in assessing material differences. But, for the reasons explained above, an assessment of claim 66 was not necessary. What was required in determining whether the § 135(b) bar might be overcome was an assessment of the material differences between the post- and pre-critical date claims, which is precisely what the Board did.

ii.

Adair also contends that the Board erred in applying *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002) in the context of an interference to conclude that a limitation added to a claim in response to a rejection that results in allowance is presumed to be necessary to patentability and therefore "material." Adair asserts that the burden of proof for the § 135(b) motion lay with Carter, and thus Adair cannot be faulted "for not providing any reason why the limitations that differ . . . were not material." Appellant Br. 25. Carter counters that "the Board's presumption of material differences is firmly grounded in the law." Appellee Br. 44. *See Parks v. Fine*, 773 F.2d 1577, 1579 (Fed. Cir. 1985); *Corbett*, 568 F.2d at 765.

Carter is correct. When an applicant adds limitations in response to an examiner's rejection, and those limitations result in allowance, there exists a well established presumption that those limitations are necessary to patentability and thus material. *See Festo*, 535 U.S. at 734; *Corbett*, 568 F.2d at 765. This presumption applies with equal force in the interference context. *Parks*, 773 F.2d at 1579 (holding in an interference case that "[t]he insertion of [a] limitation to overcome the examiner's rejection is *strong, if not conclusive, evidence of materiality*" (emphasis added)). Here, because Adair cancelled claims 1 and 16 of the PCT Application in response to the examiner's rejections, and added limitations into what eventually became claim 24 of the '261 Application to secure allowance, the Board properly presumed material differences between Adair's post- and pre-critical date claims. Adair failed to rebut this presumption.

iii.

Adair argues that the Board erred by establishing an absolute requirement that the pre-critical date claims be patentable to the applicant for the applicant to rely on those claims to avoid the § 135(b) bar. Carter counters that the Board did not articulate such a requirement, but even if it did, the requirement is appropriate. The Board quoted language from *Regents*, where this court stated that it "perceives no inequity in a construction of section 135(b)(1) that might, in some circumstances, prevent a patent applicant from relying on the filing date of a claim to which it was not statutorily entitled." *Regents*, 455 F.3d at 1377.

The court in *Regents* did not articulate a per se patentability requirement for an applicant to rely on pre-critical date claims, but rather observed that where material limitations are added to overcome an examiner's rejection after the critical date, there is "no inequity" in finding the later added claims barred under § 135(b)(1). Adair is correct that cancelled claims may be relied upon to avoid the § 135(b) bar. *See Corbett*, 568 F.2d at 765 ("The words 'prior to' in the present code clearly point to a 'critical date' prior to which . . . the copier had to be claiming the invention, whether or not the claims were subsequently cancelled."). Adair is incorrect, however, in contending that the Board established any absolute requirement that the pre-critical date claims must have been patentable to Adair. Even if it did, the error would have been harmless because the Board found material differences between the post- and pre-critical date claims, which Adair failed to rebut.

iv.

Finally, Adair argues that the Board abused its discretion in failing to consider claim 2 of the PCT Application as pre-critical date support for claim 24. The Board did not abuse its discretion in declining to consider claim 2 of the PCT Application for the first time on rehearing. 37 C.F.R. § 41.125(c), governing rehearing before the Board, provides that "[t]he burden of showing a decision should be modified lies with the party attacking the decision [and t]he request must specifically identify . . . (ii) The place *where the matter was previously addressed* in a motion, opposition, or reply." 37 C.F.R. § 41.125(c)(3) (emphasis added). Because Adair failed to previously address claim 2 prior to its petition for rehearing, the Board properly refused to consider it on rehearing.

III. CONCLUSION

For the foregoing reasons, this court affirms the decision of the Board.

AFFIRMED

2011-1212
(Interference No. 105,744)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,

Appellants,

v.

PAUL J. CARTER and LEONARD G. PRESTA,

Appellees.

Appeals from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

PETITION FOR PANEL REHEARING of APPELLANTS JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, and JOHN SPENCER EMTAGE

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Dated: March 7, 2012

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party) APPELLANT ADAIR certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

UCB Pharma S.A.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

UCB Pharma S.A. is wholly-owned by UCB S.A.
Financiere de Tubize S.A. is a publicly owned company that owns more than 10% of the stock of UCB S.A.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Cozen O'Connor P.C. – Doreen Yatko Trujillo, Michael B. Fein, Kyle Vos Strache

March 7, 2012
Date

Doreen Yatko Trujillo
Signature of counsel

Doreen Yatko Trujillo
Printed name of counsel

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Blue Br. at ___	Appellant's Blue Brief at page ___
Gray Br. at___	Appellant's Gray Brief at page ___
Board	Board of Patent Appeals and Interferences

POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED BY THE PANEL

1. The panel's adoption of Carter's position that "establishing support for post-critical date claims does not entail looking at material limitations of the patented claims" misapprehends, and appears to directly conflict with, 35 U.S.C. § 135(b) and binding precedent of this Court.
2. The panel's assertion that the Board found that Adair added limitations to its post-critical date claim not present in its pre-critical date claims to avoid examiner rejections during prosecution is factually incorrect and not supported by the record.
3. The panel's requirement that Adair rebut a factual finding and a presumption before either was levied against Adair and, in the case of the presumption, before it was even created, is factually and legally impossible.
4. The panel's failure to address the differences between the two reported versions of *In re Berger* overlooks the fact that the two versions yield different results and, therefore, leaves a conflict unresolved.

ARGUMENT

In a precedential opinion, the panel affirmed the Board of Patent Appeals and Interferences ("Board") finding that Adair's claim involved in the interference, claim 24, was barred under 35 U.S.C. § 135(b). Slip Op. at 13. As indicated

above, and discussed in more detail below, the panel misapprehended or overlooked several points of law and fact in its opinion.

1. The panel's adoption of Carter's position that "establishing support for post-critical date claims does not entail looking at material limitations of the patented claims" misapprehends, and appears to directly conflict with, 35 U.S.C. § 135(b) and binding precedent of this Court.

Section 135(b) requires that a claim to, at least, substantially the same subject matter as **a claim of an issued patent** be made prior to one year from the date on which the patent was granted. 35 U.S.C. § 135(b) (emphasis added). As the panel noted "a limited exception to this one year bar statute exists 'where the copier had already been claiming substantially the same invention as the **patentee**' during the critical time period." Slip Op. at 7 (citing *Corbett v. Chisholm*, 568 F.2d 759, 765 (CCPA 1977)) (emphasis added). Section 135(b) does not require that the claim be identical to a claim of an issued patent, or that it be to the same subject matter as a claim of an issued patent, just that it be to substantially the same subject matter as a claim of an issued patent. A claim is to substantially the same subject matter as a claim of an issued patent if it has all material limitations of the patent claim, i.e., all limitations necessary to patentability of the patent claim. *Corbett* at 765-66.

Notwithstanding the foregoing, the panel adopted Carter's position that, to establish pre-critical date support for post-critical date claims, one does not need to consider the material limitations of the patented claims at all. Under the panel's

analysis, one only looks at the pre- and post-critical date claims of the provocateur of the interference. Under such an analysis, the pre-critical date claim could be lacking a material limitation of the patent claim, yet the interference could still proceed. Alternatively, as in the present case, the pre-critical date claims could contain all material limitations of the patent claim, which is all that § 135(b) requires, yet the interference will not proceed. The panel's adoption of the position that one does not need to consider the material limitations of the patent claims at all not only misapprehends § 135(b) and binding precedent of this Court, but it also appears to be in direct conflict with both.

In support of its position, the panel stated that the court in *Corbett* did not establish any rule requiring a threshold assessment of which limitations of the copied patent claim are material and "referenced Chisholm patent claim 1 only because that was the post-critical date claim." Slip. Op at 7. The panel's statement is not consistent with *Corbett*. The court in *Corbett* not only referred to the patented claim, but it also referred to Figures 1 and 4 of the patent to support its conclusion that the **patentee** contemplated sufficiently severe reduction and expansion steps. *Corbett* at 760. Both steps were considered to be material by the court in its assessment of compliance with § 135(b). *Id.*, at 765-6. Thus, the court in *Corbett* clearly made a threshold assessment of materiality based upon the patent claim. Notably, the court in *Corbett* did not argue that the limitations were

material simply because they were added by **Corbett**, the provocateur of the interference, to its own pre-critical date claims.

The panel made a similar assertion regarding *In re Berger*, 279 F.3d 975 (Fed. Cir. 2002). The panel stated that the Court in *Berger* "referenced the issued Muller patent claim 1 only because the post-critical date claim, claim 7, was a direct copy of the patent claim." Slip Op. at 8 (citing *Berger* at 981-83). Again, the panel's statement is not consistent with *Berger*. The Court in *Berger* did not merely reference the patent claim; it referenced the prosecution history of the patent claim. The Court in *Berger* found that the limitation "circumferential groove" in the copied claim, i.e., the post-critical date claim, was material "because it was added by Muller [the patentee] during prosecution to avoid prior art." *Berger* at 982. The Court in *Berger* did not argue that the "circumferential groove" limitation was material because it was added by **Berger**, the provocateur of the interference, during prosecution of its own claims but, rather, because the limitation was added by **Muller**, the patentee, during prosecution of the patent claims.

To the extent the panel may take the position that the situation is different when the post-critical date claim is not identical to the patent claim, Adair directs the panel to *Parks v. Fine*, 773 F.2d 1577 (Fed. Cir. 1985). In *Parks*, the post-critical date claim was **not** identical to the patented claim. *Id.* at 1578. Once

again, however, the Court assessed materiality of a limitation based upon the patented claim. "The record establishes that the 'absence of a catalyst' limitation in the **Parks patent** claims and the contested counts is material. **Parks** inserted this limitation in his claims in response to, and to avoid, a rejection by the examiner." *Id.* at 1579 (emphasis added). The Court did not find that the limitation was material simply because it was added to the pre-critical date claims of **Fine**, the provocateur of the interference, but rather because it was added by **Parks**, the patentee, during prosecution of the patent claims.[1]

The only precedent arguably consistent with the panel's position is *Regents of the Univ. of Cal. v. Univ. of Iowa Res. Found.*, 455 F.3d 1371 (Fed. Cir. 2006) *reh'g en banc denied*, 2006 U.S. Appl. Lexis 27583 (Fed. Cir. Oct. 16, 2006).[2] *Regents* is cited as approving an analysis of material differences based **solely** upon a comparison of post- and pre-critical date claims. Slip Op. at 8 (emphasis added). To the extent *Regents* approved such an analysis, however, it is not consistent with the prior binding precedent of this Court as discussed above, i.e., *Corbett*, *Berger*,

---

[1] The panel relied upon *Parks* to support the levying of a presumption regarding materiality based upon Adair's prosecution, but seems to have overlooked the fact that the passage it relied upon was referring to what occurred during prosecution of the patent claim. Slip Op. at 11.

[2] *Regents* cites the correct standard for assessing compliance with § 135(b) -- "[A]s this court's **precedent** explains, California must demonstrate that claims in the '191 application provide pre-critical date support for the *post-critical date* ***identity*** between [the post-critical date claim] and the [issued patent]" -- but apparently did not apply it. *Id.* at 1375 (emphasis in bold added; emphasis in italics in Slip Op. at 9).

and *Parks*. Binding precedent cannot be overruled by a panel decision; binding precedent can only be overruled *en banc*. *Mothers Restaurant, Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1573 (Fed. Cir. 1983).

2. The panel's assertion that the Board found that Adair added limitations to its post-critical date claim not present in its pre-critical date claims to avoid examiner rejections during prosecution is factually incorrect and not supported by the record.

Citing the Board's decision, the panel stated that one of the reasons the Board rejected Adair's arguments that claims 1 and 16 of the PCT Application provide pre-critical date support for claim 24 was because Adair added limitations to overcome the examiner's rejection. Slip. Op. at 5, 10. The Board, however, never stated that Adair had **added limitations** to claims 1 and 16, just that there were limitations that differed between involved claim 24 and claims 1 and 16:

> Adair does not provide any reason why the limitations that differ between involved claim 24 and original claims 1 and 16 were not necessary to the patentability of claim 24.

A10. Nor did the Board state what limitations allegedly differed between the two sets of claims; the Board simply levied a presumption of materiality based upon the cancellation of claims 1 and 16 after rejection. A9-10. Regardless, such a finding is not supported by the record. A comparison between claim 24 and claims 1 and 16 of the PCT Application reveals that **all** limitations of claim 24 are recited in

claims 1 and 16, including the two words emphasized by the panel. *See* Slip Op. at 3-4.

Further, the presumption of materiality levied by the Board, and approved by the panel, is based upon a fiction that the amendments to claim 24 on September 9, 2009 were in response to rejections levied almost 16 years earlier against different claims. A9-10; Slip Op. at 3, 11. The rejections being relied upon were levied November 18, 1992 against, among others, claims 1 and 16 of the PCT Application. A9. Claims 1 and 16 of the PCT Application were cancelled shortly thereafter, i.e., on January 19, 1993. A9. Claim 24 was added on November 21, 2005 to provoke the interference. Blue Br. at 4, 6. Claim 24 was clearly not amended on September 9, 2009 in response to a rejection levied almost 16 years earlier. By relying upon the presumption, the panel is disregarding the facts in favor of a fiction.

Indeed, it is difficult to understand how a presumption could ever be levied when, as a panel of this Court recently confirmed, multiple pre-critical date claims can be relied upon to show support for the post-critical date claim. *See Pioneer v. Monsanto,* No. 2011-1285, 2012 WL 612800 (Fed. Cir. February 28, 2012). If multiple claims can be relied upon to show support for post-critical date claims, then what happens to an individual claim, i.e., whether it was rejected or not, cannot be relevant. Consistent with this, *Pioneer* contained no analysis of what

happened to the pre-critical date claims during prosecution to arrive at the post-critical date claim, even though a review of the underlying facts reveals that the provocateur had admitted that at least one recitation in the post-critical date claim was added to overcome a rejection over the prior art. *Id.*[3]

3. The panel's requirement that Adair rebut a factual finding and a presumption before either was levied against Adair and, in the case of the presumption, before it was even created, is factually and legally impossible.

The panel criticized Adair for not rebutting the finding regarding pre-critical date claims 1 and 16 of the PCT Application with any evidence that the differences were immaterial. Slip Op. at 10. The panel made the same assertion regarding the presumption. Slip Op. at 11. First, the Board never identified which differences were material; instead the Board levied a presumption of materiality based on alleged differences. Second, both the finding and presumption were levied for the first time in the Board's decision. Indeed, the presumption was **created** for the

[3] Several differences between the post-critical date claim and the pre-critical date claims are evident in *Pioneer*, even when the pre-critical date claims are combined. In particular, the recitation "transformed cell" is completely absent from the pre-critical date claims. See *Pioneer*; Slip Op. at 7. Indeed, Monsanto, the provocateur of the interference, admitted that the "transformed cell" recitation was added to overcome an obviousness rejection. *Monsanto v. Pioneer,* Interference No. 105,728, Monsanto Opposition 1, Appendix 2 (March 25, 2010) (Material Facts 24 and 26-28 admitted by Monsanto); *Monsanto v. Pioneer,* Interference No. 105,728, Pioneer Motion 1, Appendix 2 (February 24, 2010). Yet, the Board did not even discuss materiality in its decision. *Monsanto v. Pioneer*, Interference 105,728, Decision, Bd. R. 125 (April 22, 2010). (All of the foregoing papers from Interference No. 105,728 are available on the United States Patent & Trademark Office's website, in the Interference Portal.)

first time in the Board's decision. Adair could not have rebutted either one before it was levied, which means that Adair could not have rebutted either one before it filed its request for rehearing.

The panel also asserted, however, that the Board did not abuse its discretion in refusing to consider a rebuttal argument Adair made in it its request for rehearing, i.e., that claim 2 of the PCT Application contained all material limitations of claim 24. Slip Op. at 13. The panel cited the rule governing rehearings before the Board that requires the requestor to show where it previously addressed a matter in a motion, opposition, or reply. *Id.* At the time Adair filed its opposition, however, no finding or presumption existed. Adair could not have addressed a finding or a presumption before it was levied. The panel has imposed a standard which is impossible for Adair to meet and has left Adair without any legal recourse. At a minimum, the panel should have considered claim 2 of the PCT Application, or remanded the matter to the Board to do so.

4. The panel's failure to address the differences between the two reported versions of *In re Berger* overlooks the fact that the two versions yield different results and, therefore, leaves a conflict unresolved.

As Adair pointed out in its reply brief, there is a discrepancy in the various reported versions of a statement in *Berger*. The Lexis® and Westlaw® electronic databases report the statement as follows:

> This is a distinctly different question from whether claims made for purposes of interference by different parties are directed to **interfering subject matter**.

Other electronic databases, as well as the book version of the Federal Reporter, report the statement as follows:

> This is a distinctly different question from whether claims made for purposes of interference by different parties are directed **to the same or substantially the same subject matter**.

Berger at 982. The differences between the two are highlighted in bold. *See* Gray Br. at 8. Without addressing the discrepancy, the panel relies upon the latter version to support its contention that material differences between post- and pre-critical date claims for purposes of overcoming a § 135(b) is a distinctly different question from whether the claims are directed to substantially the same subject matter. Slip Op. at 9. The Court should grant rehearing not only to clarify this conflict in the reported versions of *Berger*, but also because the outcome of the present appeal is clearly affected by which version is being relied upon -- the first version does not support the panel's contention.

Adair maintains that the correct version is the first one. As Adair argued previously, the sentence immediately preceding the statement in question sets forth what must be shown under § 135(b). Gray Br. at 8-9 and *Berger* at 981-82. As discussed above, § 135(b) recites the language "the same or substantially the same subject matter." 35 U.S.C. § 135(b). The sentence immediately following the

passage states that the "comparison standard of 37 C.F.R. § 1.601(n) was formulated not to determine the effective date of a claim in one party's application for compliance with § 135(b), but instead to define the extent of **interfering subject matter** as between applications of potentially conflicting parties." *Id.* at 982 (emphasis added). In the statement in question, then, interfering subject matter under (prior) 37 C.F.R. § 1.601(n) was being distinguished from the requirements under § 135(b), which is consistent with the first reported version. *Id* at 981-82. Further, under the second reported version, showing that claims are to the *same or substantially the same subject matter* is being distinguished from showing that claims are to the *same or substantially the same subject matter,* which is a distinction without a difference.

CONCLUSION

The petition for panel rehearing should be granted.

Respectfully Submitted,

Dated: March 7, 2012

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ADDENDUM

United States Court of Appeals for the Federal Circuit

(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL, AND JOHN SPENCER EMTAGE,
Appellants,

v.

PAUL J. CARTER AND LEONARD G. PRESTA,
Appellees.

2011-1212

Appeal from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

Decided: February 7, 2012

DOREEN YATKO TRUJILLO, Cozen O'Connor, P.C., of Philadelphia, Pennsylvania, argued for appellants. With her on the brief was KYLE VOS STRACHE.

OLIVER R. ASHE, JR., Ashe, P.C., of Reston, Virginia, argued for appellees. Of counsel on the brief were JEFFREY P. KUSHAN and RACHEL H. TOWNSEND, Sidley Austin, LLP, of Washington, DC.

Before RADER, *Chief Judge*, LINN and MOORE, *Circuit Judges*.

LINN, *Circuit Judge*.

Appellants John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage (collectively, "Adair") appeal a decision of the Board of Patent Appeals and Interferences ("Board") holding that Adair's single claim involved in Interference 105,744 with junior party Paul J. Carter and Leonard G. Presta (collectively, "Carter") was barred under 35 U.S.C. § 135(b)(1). Because the Board properly determined that Adair's claim was barred under § 135(b)(1), this court affirms.

I. BACKGROUND

On November 21, 2005, Adair filed U.S. Application Serial No. 11/284,261 ("'261 Application") with the United States Patent and Trademark Office ("PTO"). In a preliminary amendment filed concurrently with this application, Adair requested an interference based on Carter's U.S. Patent No. 6,407,213 ("'213 Patent"). The only count of the interference is drawn to humanized antibodies. More specifically, the count involves non-human amino acid substitutions on specific residues of the heavy chain variable domain (an antibody comprises two light chains and two heavy chains, each with a "constant" and "variable" domain). On February 2, 2010, the Board declared the interference, identifying the claims in the count to be claims 30, 31, 60, 62, 63, 66, 67, 70, 73, 77-81 of the '213 Patent and claim 24 of the '261 Application. *Carter v. Adair*, Interference No. 105,744, Declaration of Interference at 4 (Feb. 2, 2010). The Board awarded Adair priority benefit to PCT/GB90/02017 ("PCT Application"), filed December 21, 1990, which claims priority to a British application filed by Adair on December 21, 1989.

Claim 66 of Carter's '213 Patent, representative of the claims in the count and the basis for an interference-in-fact, recites:

> **66.** A humanized antibody heavy chain variable domain comprising non-human Complementarity Determining Region (CDR) amino acid residues which bind antigen incorporated into a human antibody variable domain, and further comprising a Framework Region (FR) amino acid substitution at a site selected from the group consisting of: 24H [H=heavy], 73H, 76H, 78H, and 93H, utilizing the numbering system set forth in Kabat.

'213 Patent col.88 l.66-col.89 l.6.

Corresponding claim 24 in Adair's '261 Application recites:

> **24.** A humanised antibody *comprising a* heavy chain variable domain comprising non-human complementarity determining region amino acid residues which bind an antigen and a human framework region wherein said framework region comprises a *non-human* amino acid substitution at a residue selected from the group consisting of 23, 24, 49, 71, 73, and 78, and combinations thereof, as numbered according to Kabat.

'261 Application, Preliminary Amendment and Request for Interference dated Nov. 21, 2005 at 3, *as amended by* Amendment of Sept. 9, 2009 at 4 (added language emphasized).

Because Adair's claim 24 was not presented to the PTO prior to June 18, 2003, one year from issuance of the Carter '213 Patent (the "critical date") as required by 35 U.S.C. § 135(b)(1), Adair relied on pre-critical date claims

1 and 16 of the PCT Application and corresponding U.S. national stage Application No. 07/743,329 ("'329 Application") to avoid the bar of § 135(b)(1). Claims 1 and 16 recite:

> 1. A CDR-grafted antibody heavy chain having a variable region domain comprising acceptor framework and donor antigen binding regions wherein the framework comprises donor residues at at least one of positions 6, 23 and/or 24, 48 and/or 49, 71 and/or 73, 75 and/or 76 and/or 78 and 88 and/or 91.
>
> 16. A CDR-grafted antibody heavy or light chain or molecule according to any one of the preceding claims comprising human acceptor residues and non-human donor residues.

PCT Application at 67-69. Adair originally relied on claim 8 of the PCT Application, but because that claim related to light chains, Adair later abandoned that argument. In its request for rehearing before the Board, Adair argued for the first time that claim 2 of the PCT Application also provided pre-critical date support for claim 24, but the Board declined to consider this argument for the first time on rehearing. *Carter v. Adair*, Interference No. 105,774, Decision on Request for Rehearing at 4-5 (Nov. 5, 2010) ("*Rehearing*").

At the national stage, the examiner originally rejected each of Adair's PCT claims under one or more of the following sections: 101, 102(b), 103, and 112 first and second paragraphs. '329 Application, Office Action of November 18, 1992. Adair cancelled the PCT claims and added claims 23-66, later cancelled by an amendment adding claims 67-119 requiring multiple amino acid substitutions at specific locations in the heavy chain. '329

Application, Amendments of January 19, 1993 and April 16, 1993.

The Board rejected Adair's argument that claims 1 and 16 in the PCT Application provide pre-critical date support for claim 24 in the '261 Application because: (1) the PCT claims were not patentable to Adair; (2) Adair added limitations to overcome the examiner's rejection; and accordingly, (3) material differences presumptively existed between the post- and pre-critical date claims that Adair failed to rebut. *Carter v. Adair*, Interference No. 105,774, Decision on Motions at 9-10 (Aug. 30, 2010) ("*Decision*"). Citing *Regents of the University of California v. University of Iowa Research Foundation*, 455 F.3d 1371, 1377 (Fed. Cir. 2006), the Board stated that "[a]n applicant cannot expect to avoid the bar of § 135(b) by timely copying a claim from an issued patent when that claim is not patentable to that applicant." *Decision* at 10-11. On rehearing, the Board rejected Adair's assertion that materiality must be "determined in view of the patent claims being copied" and declined to compare Adair's post- or pre-critical date claims with copied claim 66 from Carter's '213 Patent. *Rehearing* at 3. Adair appeals, and this court has jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

II. DISCUSSION

A. Standard of Review

"We review the Board's construction of 35 U.S.C. § 135(b)(1) de novo, as statutory interpretation is a question of law." *In re Berger*, 279 F.3d 975, 980 (Fed. Cir. 2002).

B. Analysis

Adair argues that the Board erred by failing to assess material differences "in view of the patent claim being copied [claim 66 from Carter's '213 Patent]." Appellant Br. 22. According to Adair, this court's precedent does not endorse a test that allows the Board to completely ignore copied claim 66 from Carter's '213 Patent when assessing the material differences between the post- and pre-critical date claims. Adair argues that the materiality test from *Berger* and *Regents* requires an assessment of material limitations based on the "identity" between the post-critical date claim and copied claim 66 from Carter's '213 Patent—in other words, in view of the "count"—and not based on the post-critical date claim standing alone. *See Regents*, 455 F.3d at 1375 ("[A]s this court's precedent explains, California must demonstrate that claims in the '191 application provide pre-critical date support for the *post-critical date identity* between claim 205 [the post-critical date claim] and the '646 patent [the issued patent]." (emphasis added)); *Berger*, 279 F.3d at 983.

Carter counters that the question of "[w]hether there is a sufficient degree of identity between pre- and post-critical date claims for compliance with § 135(b) is an inquiry that is distinct and independent" from any comparison with the patent claims copied. Appellee Br. 33. According to Carter, the Board correctly interpreted § 135(b)(1) in holding that "establishing support for post-critical date claims does not entail looking at material limitations of the patented claims." *Id.* 42.

This court agrees with Carter. Section 135(b)(1) states:

> A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any appli-

> cation unless such a claim is made prior to one year from the date on which the patent was granted.

35 U.S.C. § 135(b)(1). Notwithstanding the seemingly strict language of the statute, a limited exception to this one year bar exists "where the copier had already been claiming substantially the same invention as the patentee" during the critical time period. *Corbett v. Chisholm*, 568 F.2d 759, 765 (CCPA 1977).

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In *Corbett*, the post-critical date claims "correspond[ed] exactly" with issued "Chisholm patent" claim 1. 568 F.2d at 759. The Board rejected Corbett's post-critical date claims under § 135(b)(1). *Id.* Corbett relied upon several groups of pre-critical date claims from the application and a predecessor application in an attempt to avoid the § 135(b) bar. *Id.* at 761-63. On appeal, this court compared the "copied claim" with the pre-critical date claims and affirmed the Board's finding that material differences precluded Corbett from relying on any of the pre-critical date claims to overcome the § 135(b) bar. *Id.* at 765-66. In identifying certain limitations of Chisholm patent claim 1 as "material," the court was simply noting the material differences that existed between that claim as copied by Corbett after the critical date and those pre-critical date claims Corbett was relying on to overcome the § 135(b) bar. The court did not establish any rule requiring some sort of threshold assessment of which limitations of the copied patent claim are material before determining whether material differences exist between post- and pre-critical date claims. In making this comparison, the court referenced Chisholm patent claim 1 only because that was the post-critical date claim.

Similarly, in *Berger*, the post-critical date claim was copied directly from and identical to issued "Muller patent" claim 1. 279 F.3d at 978. The examiner rejected Berger's pre-critical date claims 1-6 for indefiniteness and other grounds, and rejected post-critical date claim 7 under § 135(b)(1). *Id.* at 979. The Board rejected Berger's argument that claims 1-6 provided pre-critical date support for claim 7 because it found material differences between the "copied claim" and the pre-critical date claims, and this court affirmed. *Id.* at 982 ("The Board found the 'circumferential groove' limitation to be material because it was added by Muller during prosecution to avoid prior art. We agree with the Board's determination of materiality."). Again, the court in *Berger* referenced the issued Muller patent claim 1 only because the post-critical date claim, claim 7, was a direct copy of the patent claim. *Id.* at 981-83. This court affirmed the Board's analysis based only on the material differences between the *post- and pre-critical date claims*. *Id.* at 983 ("Because Berger's *original claims 1-6* [the pre-critical date claims] *do not include a material limitation of Berger claim 7* [the post-critical date claim], copied claim 7 is not entitled to the earlier effective date of those original claims for purposes of satisfying § 135(b)." (emphasis added)).

In *Regents*, this court expressly approved an analysis of material differences based solely on a comparison of the post- and pre-critical date claims in order to obtain the benefit of the earlier filing date:

> The Board compared claim 205 [the post-critical date claim] with claims 202-203 . . . and then with claim 204 [collectively, the pre-critical date claims]. The Board found that California's claim 205 contained material differences from claims 202-204. Therefore, claim 205 could not benefit from the earlier filing date of those claims. . . . On

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455 F.3d at 1373. The court in *Regents* rejected California's argument, explaining that "the relationship between the post- and pre-critical date claims . . . is not only relevant, but dispositive of the section 135(b)(1) question." *Id.* at 1374. Adair's arguments in this case are similar to California's arguments in *Regents*, where the court held that there is no requirement that the Board reference the issued patent claim(s) in the count to assess the material differences between the post- and pre-critical date claims. *Id.* at 1374-76.

The statement in *Regents* that the applicant's earlier filed claims must "provide pre-critical date support for the *post-critical date identity* between [the post-critical date claim] and the [issued patent]" to avoid the § 135(b)(1) bar, 455 F.3d at 1375 (emphasis added), does not require the Board to assess material differences in view of the issued patent claim(s) in the count. *See Berger*, 279 F.3d at 982. The question of material differences between post- and pre-critical date claims for purposes of overcoming a § 135(b) bar "is a distinctly different question from whether claims . . . are directed to the same or substantially the same subject matter" for purposes of provoking an interference. *Id.* As explained in *Regents*, § 135(b) is a statute of repose, intended to "limit[] the patentee's vulnerability to a declaration of an interference" by "limit[ing] the window of time in which the cause of the interference can occur." 455 F.3d at 1376. When a material difference exists between the post- and pre-critical

date claims, a belated interference is improper because it would be a "*different interference*[]" than that which "should have been earlier declared by the PTO." *Id.* (emphasis added).

For these reasons, this court holds that to overcome a § 135(b) bar for a post-critical date claim, an applicant must show that such claim is not materially different from a pre-critical date claim present in the application or any predecessor thereto in order to obtain the benefit of the earlier filing date. Any claims filed within the critical period, whether or not later cancelled, may provide pre-critical date support for the later filed patent claim(s), so long as the pre-critical date claims are not materially different from the later filed claim(s). *Corbett*, 568 F.2d at 765-66; *see also Regents*, 455 F.3d at 1373; *Berger*, 279 F.3d at 981-82.

Here, the Board found material differences between post-critical date claim 24 of the '261 Application and pre-critical date claims 1 and 16 of the PCT Application based on the prosecution history of the '261 Application. During prosecution, Adair added several limitations to claim 24—limitations not present in claims 1 and 16 of the PCT Application—to avoid examiner rejections during prosecution. *Decision* at 9. Adair failed to rebut the Board's finding with any evidence that the differences between claim 24 and claims 1 and 16 of the PCT Application were immaterial. *Id.* at 10. Adair criticizes the Board for failing to consider claim 66 from Carter's '213 Patent in assessing material differences. But, for the reasons explained above, an assessment of claim 66 was not necessary. What was required in determining whether the § 135(b) bar might be overcome was an assessment of the material differences between the post- and pre-critical date claims, which is precisely what the Board did.

ii.

Adair also contends that the Board erred in applying *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002) in the context of an interference to conclude that a limitation added to a claim in response to a rejection that results in allowance is presumed to be necessary to patentability and therefore "material." Adair asserts that the burden of proof for the § 135(b) motion lay with Carter, and thus Adair cannot be faulted "for not providing any reason why the limitations that differ . . . were not material." Appellant Br. 25. Carter counters that "the Board's presumption of material differences is firmly grounded in the law." Appellee Br. 44. *See Parks v. Fine*, 773 F.2d 1577, 1579 (Fed. Cir. 1985); *Corbett*, 568 F.2d at 765.

Carter is correct. When an applicant adds limitations in response to an examiner's rejection, and those limitations result in allowance, there exists a well established presumption that those limitations are necessary to patentability and thus material. *See Festo*, 535 U.S. at 734; *Corbett*, 568 F.2d at 765. This presumption applies with equal force in the interference context. *Parks*, 773 F.2d at 1579 (holding in an interference case that "[t]he insertion of [a] limitation to overcome the examiner's rejection is *strong, if not conclusive, evidence of materiality*" (emphasis added)). Here, because Adair cancelled claims 1 and 16 of the PCT Application in response to the examiner's rejections, and added limitations into what eventually became claim 24 of the '261 Application to secure allowance, the Board properly presumed material differences between Adair's post- and pre-critical date claims. Adair failed to rebut this presumption.

iii.

Adair argues that the Board erred by establishing an absolute requirement that the pre-critical date claims be patentable to the applicant for the applicant to rely on those claims to avoid the § 135(b) bar. Carter counters that the Board did not articulate such a requirement, but even if it did, the requirement is appropriate. The Board quoted language from *Regents*, where this court stated that it "perceives no inequity in a construction of section 135(b)(1) that might, in some circumstances, prevent a patent applicant from relying on the filing date of a claim to which it was not statutorily entitled." *Regents*, 455 F.3d at 1377.

The court in *Regents* did not articulate a per se patentability requirement for an applicant to rely on pre-critical date claims, but rather observed that where material limitations are added to overcome an examiner's rejection after the critical date, there is "no inequity" in finding the later added claims barred under § 135(b)(1). Adair is correct that cancelled claims may be relied upon to avoid the § 135(b) bar. *See Corbett*, 568 F.2d at 765 ("The words 'prior to' in the present code clearly point to a 'critical date' prior to which . . . the copier had to be claiming the invention, whether or not the claims were subsequently cancelled."). Adair is incorrect, however, in contending that the Board established any absolute requirement that the pre-critical date claims must have been patentable to Adair. Even if it did, the error would have been harmless because the Board found material differences between the post- and pre-critical date claims, which Adair failed to rebut.

iv.

Finally, Adair argues that the Board abused its discretion in failing to consider claim 2 of the PCT Application as pre-critical date support for claim 24. The Board did not abuse its discretion in declining to consider claim 2 of the PCT Application for the first time on rehearing. 37 C.F.R. § 41.125(c), governing rehearing before the Board, provides that "[t]he burden of showing a decision should be modified lies with the party attacking the decision [and t]he request must specifically identify . . . (ii) The place *where the matter was previously addressed* in a motion, opposition, or reply." 37 C.F.R. § 41.125(c)(3) (emphasis added). Because Adair failed to previously address claim 2 prior to its petition for rehearing, the Board properly refused to consider it on rehearing.

III. CONCLUSION

For the foregoing reasons, this court affirms the decision of the Board.

AFFIRMED

CERTIFICATE OF SERVICE

United States Court of Appeals
for the Federal Circuit
No. **2011-1212 (Interference No. 105,744)**
----------)
John Robert Adair, Diljeet Singh Athwal, and
John Spencer Emtage

Appellants,

v.

Paul J. Carter and Leonard G. Presta,

Appellees.
----------)

I, Robyn Cocho, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press was retained by COZEN O'CONNOR, Attorneys for Appellants to print this document. I am an employee of Counsel Press.

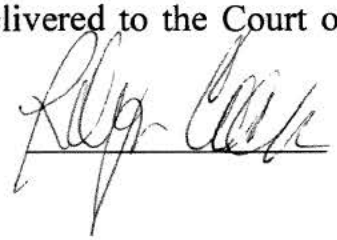
On the **7th Day of March, 2012**, I served the within **Petition for Panel Rehearing of Appellants John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage** upon:

Oliver R. Ashe, Jr.
ASHE, P.C.
11440 Isaac Newton Square North
Suite 210
Reston, VA 20190
Tel: 703-467-9001
Fax: 703-467-9002

via Federal Express, overnight delivery by causing 2 true copies of each, enclosed in a properly addressed wrapper, to be deposited in an official depository of FedEx.

Unless otherwise noted, 19 copies have been delivered to the Court on the same date via Federal Express

March 7, 2012



11/284,261

United States Court of Appeals for the Federal Circuit

2011-1212
(Interference No. 105,744)

JOHN ROBERT ADAIR, DILJEET SINGH ATHWAL,
and JOHN SPENCER EMTAGE,

Appellants,

v.

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Appellees.

Judgment

ON APPEAL from the Appeals and Interferences: United States Patent and Trademark Office, Board of Patent

in CASE NO(S). Interference No. 105,744

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

DATED FEB - 7 2012

Jan Horbaly, Clerk

CERTIFIED COPY
I HEREBY CERTIFY THIS DOCUMENT
IS A TRUE AND CORRECT COPY
OF THE ORIGINAL ON FILE.
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ISSUED AS A MANDATE: APR - 2 2012

United States Court of Appeals for the Federal Circuit

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v.

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2011-1212

Appeal from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

Decided: February 7, 2012

DOREEN YATKO TRUJILLO, Cozen O'Connor, P.C., of Philadelphia, Pennsylvania, argued for appellants. With her on the brief was KYLE VOS STRACHE.

OLIVER R. ASHE, JR., Ashe, P.C., of Reston, Virginia, argued for appellees. Of counsel on the brief were JEFFREY P. KUSHAN and RACHEL H. TOWNSEND, Sidley Austin, LLP, of Washington, DC.

Before RADER, *Chief Judge*, LINN and MOORE, *Circuit Judges*.

LINN, *Circuit Judge*.

Appellants John Robert Adair, Diljeet Singh Athwal, and John Spencer Emtage (collectively, "Adair") appeal a decision of the Board of Patent Appeals and Interferences ("Board") holding that Adair's single claim involved in Interference 105,744 with junior party Paul J. Carter and Leonard G. Presta (collectively, "Carter") was barred under 35 U.S.C. § 135(b)(1). Because the Board properly determined that Adair's claim was barred under § 135(b)(1), this court affirms.

I. BACKGROUND

On November 21, 2005, Adair filed U.S. Application Serial No. 11/284,261 ("'261 Application") with the United States Patent and Trademark Office ("PTO"). In a preliminary amendment filed concurrently with this application, Adair requested an interference based on Carter's U.S. Patent No. 6,407,213 ("'213 Patent"). The only count of the interference is drawn to humanized antibodies. More specifically, the count involves non-human amino acid substitutions on specific residues of the heavy chain variable domain (an antibody comprises two light chains and two heavy chains, each with a "constant" and "variable" domain). On February 2, 2010, the Board declared the interference, identifying the claims in the count to be claims 30, 31, 60, 62, 63, 66, 67, 70, 73, 77-81 of the '213 Patent and claim 24 of the '261 Application. *Carter v. Adair*, Interference No. 105,744, Declaration of Interference at 4 (Feb. 2, 2010). The Board awarded Adair priority benefit to PCT/GB90/02017 ("PCT Application"), filed December 21, 1990, which claims priority to a British application filed by Adair on December 21, 1989.

Claim 66 of Carter's '213 Patent, representative of the claims in the count and the basis for an interference-in-fact, recites:

> **66.** A humanized antibody heavy chain variable domain comprising non-human Complementarity Determining Region (CDR) amino acid residues which bind antigen incorporated into a human antibody variable domain, and further comprising a Framework Region (FR) amino acid substitution at a site selected from the group consisting of: 24H [H=heavy], 73H, 76H, 78H, and 93H, utilizing the numbering system set forth in Kabat.

'213 Patent col.88 l.66-col.89 l.6.

Corresponding claim 24 in Adair's '261 Application recites:

> **24.** A humanised antibody *comprising a* heavy chain variable domain comprising non-human complementarity determining region amino acid residues which bind an antigen and a human framework region wherein said framework region comprises a *non-human* amino acid substitution at a residue selected from the group consisting of 23, 24, 49, 71, 73, and 78, and combinations thereof, as numbered according to Kabat.

'261 Application, Preliminary Amendment and Request for Interference dated Nov. 21, 2005 at 3, *as amended by* Amendment of Sept. 9, 2009 at 4 (added language emphasized).

Because Adair's claim 24 was not presented to the PTO prior to June 18, 2003, one year from issuance of the Carter '213 Patent (the "critical date") as required by 35 U.S.C. § 135(b)(1), Adair relied on pre-critical date claims

1 and 16 of the PCT Application and corresponding U.S. national stage Application No. 07/743,329 ("'329 Application") to avoid the bar of § 135(b)(1). Claims 1 and 16 recite:

> 1. A CDR-grafted antibody heavy chain having a variable region domain comprising acceptor framework and donor antigen binding regions wherein the framework comprises donor residues at at least one of positions 6, 23 and/or 24, 48 and/or 49, 71 and/or 73, 75 and/or 76 and/or 78 and 88 and/or 91.
>
> 16. A CDR-grafted antibody heavy or light chain or molecule according to any one of the preceding claims comprising human acceptor residues and non-human donor residues.

PCT Application at 67-69. Adair originally relied on claim 8 of the PCT Application, but because that claim related to light chains, Adair later abandoned that argument. In its request for rehearing before the Board, Adair argued for the first time that claim 2 of the PCT Application also provided pre-critical date support for claim 24, but the Board declined to consider this argument for the first time on rehearing. *Carter v. Adair*, Interference No. 105,774, Decision on Request for Rehearing at 4-5 (Nov. 5, 2010) ("*Rehearing*").

At the national stage, the examiner originally rejected each of Adair's PCT claims under one or more of the following sections: 101, 102(b), 103, and 112 first and second paragraphs. '329 Application, Office Action of November 18, 1992. Adair cancelled the PCT claims and added claims 23-66, later cancelled by an amendment adding claims 67-119 requiring multiple amino acid substitutions at specific locations in the heavy chain. '329

Application, Amendments of January 19, 1993 and April 16, 1993.

The Board rejected Adair's argument that claims 1 and 16 in the PCT Application provide pre-critical date support for claim 24 in the '261 Application because: (1) the PCT claims were not patentable to Adair; (2) Adair added limitations to overcome the examiner's rejection; and accordingly, (3) material differences presumptively existed between the post- and pre-critical date claims that Adair failed to rebut. *Carter v. Adair*, Interference No. 105,774, Decision on Motions at 9-10 (Aug. 30, 2010) ("*Decision*"). Citing *Regents of the University of California v. University of Iowa Research Foundation*, 455 F.3d 1371, 1377 (Fed. Cir. 2006), the Board stated that "[a]n applicant cannot expect to avoid the bar of § 135(b) by timely copying a claim from an issued patent when that claim is not patentable to that applicant." *Decision* at 10-11. On rehearing, the Board rejected Adair's assertion that materiality must be "determined in view of the patent claims being copied" and declined to compare Adair's post- or pre-critical date claims with copied claim 66 from Carter's '213 Patent. *Rehearing* at 3. Adair appeals, and this court has jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

II. DISCUSSION

A. Standard of Review

"We review the Board's construction of 35 U.S.C. § 135(b)(1) de novo, as statutory interpretation is a question of law." *In re Berger*, 279 F.3d 975, 980 (Fed. Cir. 2002).

B. Analysis

Adair argues that the Board erred by failing to assess material differences "in view of the patent claim being copied [claim 66 from Carter's '213 Patent]." Appellant Br. 22. According to Adair, this court's precedent does not endorse a test that allows the Board to completely ignore copied claim 66 from Carter's '213 Patent when assessing the material differences between the post- and pre-critical date claims. Adair argues that the materiality test from *Berger* and *Regents* requires an assessment of material limitations based on the "identity" between the post-critical date claim and copied claim 66 from Carter's '213 Patent—in other words, in view of the "count"—and not based on the post-critical date claim standing alone. *See Regents*, 455 F.3d at 1375 ("[A]s this court's precedent explains, California must demonstrate that claims in the '191 application provide pre-critical date support for the *post-critical date identity* between claim 205 [the post-critical date claim] and the '646 patent [the issued patent]." (emphasis added)); *Berger*, 279 F.3d at 983.

Carter counters that the question of "[w]hether there is a sufficient degree of identity between pre- and post-critical date claims for compliance with § 135(b) is an inquiry that is distinct and independent" from any comparison with the patent claims copied. Appellee Br. 33. According to Carter, the Board correctly interpreted § 135(b)(1) in holding that "establishing support for post-critical date claims does not entail looking at material limitations of the patented claims." *Id.* 42.

This court agrees with Carter. Section 135(b)(1) states:

> A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any appli-

> cation unless such a claim is made prior to one year from the date on which the patent was granted.

35 U.S.C. § 135(b)(1). Notwithstanding the seemingly strict language of the statute, a limited exception to this one year bar exists "where the copier had already been claiming substantially the same invention as the patentee" during the critical time period. *Corbett v. Chisholm*, 568 F.2d 759, 765 (CCPA 1977).

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date claims, a belated interference is improper because it would be a "*different interference*[]" than that which "should have been earlier declared by the PTO." *Id.* (emphasis added).

For these reasons, this court holds that to overcome a § 135(b) bar for a post-critical date claim, an applicant must show that such claim is not materially different from a pre-critical date claim present in the application or any predecessor thereto in order to obtain the benefit of the earlier filing date. Any claims filed within the critical period, whether or not later cancelled, may provide pre-critical date support for the later filed patent claim(s), so long as the pre-critical date claims are not materially different from the later filed claim(s). *Corbett*, 568 F.2d at 765-66; *see also Regents*, 455 F.3d at 1373; *Berger*, 279 F.3d at 981-82.

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ii.

Adair also contends that the Board erred in applying *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002) in the context of an interference to conclude that a limitation added to a claim in response to a rejection that results in allowance is presumed to be necessary to patentability and therefore "material." Adair asserts that the burden of proof for the § 135(b) motion lay with Carter, and thus Adair cannot be faulted "for not providing any reason why the limitations that differ . . . were not material." Appellant Br. 25. Carter counters that "the Board's presumption of material differences is firmly grounded in the law." Appellee Br. 44. *See Parks v. Fine*, 773 F.2d 1577, 1579 (Fed. Cir. 1985); *Corbett*, 568 F.2d at 765.

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iii.

Adair argues that the Board erred by establishing an absolute requirement that the pre-critical date claims be patentable to the applicant for the applicant to rely on those claims to avoid the § 135(b) bar. Carter counters that the Board did not articulate such a requirement, but even if it did, the requirement is appropriate. The Board quoted language from *Regents*, where this court stated that it "perceives no inequity in a construction of section 135(b)(1) that might, in some circumstances, prevent a patent applicant from relying on the filing date of a claim to which it was not statutorily entitled." *Regents*, 455 F.3d at 1377.

The court in *Regents* did not articulate a per se patentability requirement for an applicant to rely on pre-critical date claims, but rather observed that where material limitations are added to overcome an examiner's rejection after the critical date, there is "no inequity" in finding the later added claims barred under § 135(b)(1). Adair is correct that cancelled claims may be relied upon to avoid the § 135(b) bar. *See Corbett*, 568 F.2d at 765 ("The words 'prior to' in the present code clearly point to a 'critical date' prior to which . . . the copier had to be claiming the invention, whether or not the claims were subsequently cancelled."). Adair is incorrect, however, in contending that the Board established any absolute requirement that the pre-critical date claims must have been patentable to Adair. Even if it did, the error would have been harmless because the Board found material differences between the post- and pre-critical date claims, which Adair failed to rebut.

iv.

Finally, Adair argues that the Board abused its discretion in failing to consider claim 2 of the PCT Application as pre-critical date support for claim 24. The Board did not abuse its discretion in declining to consider claim 2 of the PCT Application for the first time on rehearing. 37 C.F.R. § 41.125(c), governing rehearing before the Board, provides that "[t]he burden of showing a decision should be modified lies with the party attacking the decision [and t]he request must specifically identify . . . (ii) The place *where the matter was previously addressed* in a motion, opposition, or reply." 37 C.F.R. § 41.125(c)(3) (emphasis added). Because Adair failed to previously address claim 2 prior to its petition for rehearing, the Board properly refused to consider it on rehearing.

III. CONCLUSION

For the foregoing reasons, this court affirms the decision of the Board.

AFFIRMED