

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RICHARD DEAN and ROBERT W. WEBER
Junior Party¹

v.

RICHARD DEAN and ROBERT W. WEBER
Junior Party²

v.

DAVID PARKER and THOMAS A. MILLICAN
Senior Party³

Patent Interference No. 103,056

Before SOFOCLEOUS, DOWNEY and SCHAFER, Administrative Patent Judges.

DOWNEY, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658

On August 20, 1998, Parker et al. filed a petition to the Commissioner under 37

¹ Application 07/312,767, filed February 17, 1989, now Patent No. 5,053,503, issued October 1, 1991. Assignee for Centocor.

² Reissue Application 08/069,529, filed June 1, 1993. Assignee for Centocor.

³ Application 07/577,072, filed August 31, 1990. Accorded benefit of Application 07/372,348, filed June 9, 1989, now abandoned and Application PCTGB88/00671, filed August 12, 1988, and U.K. Application No. 8819042, filed August 12, 1987.

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CFR § 1.644 (Paper No. 64) with respect to the final decision of the Board of Patent Appeals and Interferences, wherein the Board held that Dean et al. patent and reissue claims 8, 22 and 23 did not correspond to count 2 (Paper No. 62). In the petition, Parker et al. alleged that Dean et al. failed to provide sufficient evidence in their 37 CFR § 1.633(c)(4) motion to gain the relief requested, that Parker et al. rebutted all of the evidence/argument submitted by Dean et al. and lastly that the Board erroneously placed the burden on Parker et al. to show that one of ordinary skill would have found the claims sought to be undesignated obvious. The petition was granted to the extent that the interference was remanded to the Board to treat the petition as a request for reconsideration under 37 CFR § 1.658(b).

37 CFR § 1.658 requires that a request shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. The request seeks reconsideration of that part of the final decision wherein we found that the APJ did not abuse her discretion when she granted the Dean et al. motion to undesignate claims 8, 22 and 23 as not corresponding to count 2.

In the petition decision, the Board was reminded that a party filing a motion “has the burden of proof to show that it is entitled to the relief sought in the motion.” 37 CFR § 1.637(a) cf. Kubota v. Shibuya, 999 F.2d 517, 520, 27 USPQ2d 1418, 1420 (Fed. Cir. 1993). Hence, the Board has been directed to decide anew “whether as to Dean claims 8, 22 and 23, it was error for the APJ to conclude that, in view of the

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evidence presented by the parties, Dean had met his burden of proving that those claims were not drawn to the same patentable invention” (page 6 of petition decision).

We have reviewed our decision in light of the Parker et al. arguments and the Commissioner’s direction and are persuaded that we overlooked or misapprehended that the burden was upon Dean et al., in the first instance, to establish that they were entitled to the relief they requested. Hence, reconsideration of the final decision of August 20, 1998 is granted.

The subject matter of this interference is directed to a bifunctional chelating agent useful as a radiodiagnostic or radiotherapeutic agent. The agent is referred to as bifunctional because it joins both an antibody or antibody fragment and a metallic radionucleotide. The agent consists of a derivative of 1,4,7,10-tetraazacyclododecane-1,4,5-triacetic acid or 1,4,7,10-tetraazacyclododecane-1,4,5,10 tetraacetic acid agent (also referred to as a macrocycle), an organic linking radical, L, and a group, E, a group capable of reacting with a site on a protein, where the L-E group is attached either to a N or C of the macrocycle. Dean et al. claim 1 recites both the triacetic and tetraacetic acid formulae, L and E groupings, and further defines L as optionally containing a cleavable group. In the motion, Dean et al. moved, inter alia, to have claims 8, 22 and 23, designated as not corresponding to the count. Claim 8, which depends indirectly upon claim 1, is directed to a bifunctional coupling agent having a specific linker, -L- , identified as a cleavable linker having the formula $-(\text{CH}_2)\text{COCHCH}_2\text{OCH}_2\text{CH}_2-$ and that

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claims 22 and 23 are directed to 1,4,7,10-tetraazacyclododecane-1,4,5,10 tetraacetic acid bifunctional coupling agents wherein the L-E group is attached to the N of the tetraacetic acid chelating derivative. Dean et al., in their motion, alleged that claim 8 defines a separate patentable invention because cleavable linkers were unknown. Parker et al. correctly points out that Dean et al. did not present any arguments that claim 8 defined a separate patentable invention independently from his arguments concerning claims 6, 7, 16, 18 and 19 and 22 corresponding to the count or any evidence specific to the subject matter of claim 8. Further, Parker et al. correctly points out that Dean et al. made no specific arguments as to claims 22 and 23. In rebuttal to the motion, Parker et al. did offer evidence supported by the Yarrenton declaration to show broadly that indeed cleavable linkers were known in this art (Meares, Haseman and EP-A2-0175617) and that attaching an L-E group to the N atom of a macrocycle was also known (Australian patent AU-A-76217/87).

Therefore, we find that Dean et al., the movant who had the initial burden, failed to sustain their burden to show that their patent and reissue claims 8, 22 and 23 do not define the same patentable invention as any other claim designated in the notice declaring the interference as corresponding to the count. See 37 CFR § 1.637(c)(4)(ii) (1985). In view of our finding, we conclude that the APJ erred in granting the Dean et al. 37 CFR § 1.633(c)(4) motion to undesignate claims 8, 22 and 23 as not corresponding to count 2. The final decision of August 20, 1998 is modified to reflect

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that Dean patent and reissue claims 8, 22 and 23 remain designated as corresponding to count 2. This interference will be redeclared in a concurrent paper to reflect the correct claim correspondence of the Dean et al. patent and reissue application claims. Accordingly, the judgment issued August 20, 1998 is hereby vacated and the following judgment is issued.

Judgment

In view of decision of August 20, 1998, now modified as set forth in this decision on reconsideration, judgment as to the subject matter of count 2 is awarded to Parker et al. and against Dean et al. On this record, DAVID PARKER and THOMAS A. MILLICAN are entitled to a patent containing claims 25-29 corresponding to count 2, and RICHARD DEAN and ROBERT W. WEBER (the patentees) are not entitled to their patent containing claims 1-23 corresponding to count 2 and RICHARD DEAN and

ROBERT W. WEBER (the reissue applicants) are not entitled to a patent containing

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claims 1-23 corresponding to count 2.

MICHAEL SOFOCLEOUS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MARY F. DOWNEY)	
Administrative Patent Judge)	APPEALS AND
)	
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)	
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