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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 64

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

NILES R. ROSENQUIST
Junior Party,¹

v.

THOMAS SCHOLL and PETER BIER
Senior Party.²

Patent Interference No. 103,812

HEARD: November 12, 1998

Before METZ, SCHAFER and HANLON, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

FINAL DECISION UNDER 37 CFR § 1.658(a)

This is a final decision under 37 CFR § 1.658(a) in Interference No. 103,812. The interference involves U.S. Patent No. 5,523,379, granted June 4, 1996, to Niles R. Rosenquist ("Rosenquist") and Application 08/438,516, filed May 10, 1995, to Thomas Scholl and Peter

¹U.S. Patent No. 5,523,379 granted June 4, 1996, based on Application 08/361,264 filed December 21, 1994. Assigned to the General Electric Company, a corporation of New York.

²Application 08/438,516 filed May 10, 1995. Accorded the benefit of German patent application P 4417748.8 filed May 20, 1994. Assigned to Bayer Aktiengesellschaft, Germany.

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Bier ("Scholl"). Scholl is the senior party by virtue of the May 20, 1994, filing date of German patent application P 4417748.8 to which benefit was accorded Application 08/438,516 under 35 U.S.C. § 119.

The sole count at issue in this interference relates to a process for endcapping high molecular weight compounds. The count reads as follows:

Count 2

A process in accordance with any of claims 1-5 of the Rosenquist patent

or

a process in accordance with any of claims 34-38 of the Scholl application.

The claims of the parties which have been designated as corresponding to Count 2 are:

Rosenquist: Claims 1-5

Scholl: Claims 34-38

Both parties filed a record and an opening brief. Junior party Rosenquist filed a reply brief.³ Both parties appeared, through counsel, at final hearing for oral argument.

³Throughout this decision, Rosenquist's opening brief and reply brief will be referred to as "RB" and "RRB," respectively, followed by the relevant page number. Similarly, Rosenquist's documentary exhibits will be referred to as "RX" followed by the relevant exhibit number, and Rosenquist's record will be referred to as "RR" followed by the relevant page number. Scholl's opening brief will be referred to as "SB" followed by the relevant page number.

The following issues are before this panel at final hearing:

(1) Whether Rosenquist has demonstrated an actual reduction to practice of an invention within the scope of Count 2 prior to May 20, 1994, the effective filing date of senior party Scholl's involved Application 08/438,516.

(2) Whether Rosenquist's proposed Count A should be substituted for Count 2.

In addition, senior party Scholl filed a motion to suppress certain evidence submitted by junior party Rosenquist. See Paper No. 44. Rosenquist filed an opposition to that motion. See Paper No. 47.

Senior party Scholl's motion to suppress

Senior party Scholl filed a motion to suppress certain evidence submitted by Rosenquist. See Paper No. 44. For the reasons set forth below, junior party Rosenquist does not prevail in this interference whether or not that evidence is suppressed. Therefore, Scholl's motion to suppress is dismissed.

Junior party Rosenquist's case for priority

I.

According to Scholl's preliminary statement, "Party Scholl et al does not intend to present evidence to prove a conception or an actual reduction to practice, but intends to rely on the filing date of German Patent Application No. P 4417748.8, filed May 20, 1994, which was identified in the notice declaring interference (37 CFR §§§ 1.626, 1.630 and 1.611(c)(5))." See Paper No. 18; see also Paper No. 31, p. 5. Therefore, the dispositive issue in this case is whether junior

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party Rosenquist has demonstrated an actual reduction to practice of an invention within the scope of count 2 prior to May 20, 1994, the effective filing date of Scholl's involved Application 08/438,516. Jepson v. Egly, 231 F.2d 947, 957, 109 USPQ 354, 362 (CCPA 1956); see also Price v. Symsek, 988 F.2d 1187, 1190, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993). Rosenquist focuses his priority case on Rosenquist patent claim 1. See RB, p. 12. Therefore, we also focus our attention on Rosenquist patent claim 1.

Rosenquist patent claim 1 is directed to a process for preparing a high molecular weight compound having a molecular weight of at least 1,125. The compound comprises (a) a condensation product comprising (i) a bis-phenol derivative and (ii) a phosgene derivative or a carbonate ester and (b) an endcapping or chain stopping molecule, including 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid, wherein the endcapping agent is chemically bound to the condensation product by an ester linkage.⁴ The process comprises (a) interfacially condensing a phosgene derivative, a bis-phenol derivative and an endcapping or chain stopping molecule, including 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid, wherein the endcapping agent is chemically bound to the condensation product by an ester linkage through the acid substituent of the phenolic substituent of the endcapping or chain stopping molecule and (b) adding a base.

⁴The structural formula of 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid is said to correspond to the first of the two endcapping or chain stopping molecules recited in Rosenquist patent claim 1 wherein R₁ is a four carbon atom alkyl group, R₂ is hydrogen and n is 2. See RR, pp. 3-4, paragraph 6.

II.

A party establishing an actual reduction to practice of the subject matter of a count must show a reduction to practice of each and every limitation of the count. Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998); Newkirk v. Lulejian, 825 F.2d 1581, 1582, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987). A process is reduced to practice when each step is successfully performed and the product produced by the process is satisfactory for its intended use. See Cooper, 154 F.3d at 1327, 47 USPQ2d at 1901; Hess v. Bland, 347 F.2d 835, 841, 146 USPQ 378, 382 (CCPA 1965).

Where, as here, the count embraces several embodiments, a reduction to practice of one embodiment within the scope of the count constitutes a reduction to practice of the invention defined by the count for purposes of priority of invention in an interference proceeding. Cf. Breuer v. DeMarinis, 558 F.2d 22, 24 n. 5, 194 USPQ 308, 309 n.5 (CCPA 1977).

Furthermore, an actual reduction to practice must be independently corroborated. Mikus v. Wachtel, 542 F.2d 1157, 1159, 191 USPQ 571, 573 (CCPA 1976); Reese v. Hurst, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981) ("adoption of the 'rule of reason' has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself"). Although each and every element of the count must be corroborated, there is no single, fixed corroboration formula. Mikus, 542 F.2d at 1159, 191 USPQ at 573. Independent corroboration may consist of the testimony of witnesses, other than the inventor, to the actual reduction to

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practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor. Reese, 661 F.2d at 1225, 211 USPQ at 940.

Rosenquist's involved U.S. Patent No. 5,523,379 was copending with Scholl's involved Application 08/438,516. Therefore, in order to be awarded priority in this interference, junior party Rosenquist must prove, by a preponderance of the evidence, that he actually reduced to practice an embodiment within the scope of Count 2 prior to May 20, 1994. Bosies v. Benedict, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994). The preponderance of the evidence standard requires the fact finder "to believe that the existence of a fact is more probable than its nonexistence before [he] may find in favor of the party who has the burden to persuade the [judge] of the fact's existence." Bosies, 27 F.3d at 542, 30 USPQ2d at 1864 (citing In re Winship, 397 U.S. 358, 371-72 (1970)).

Rosenquist argues that an invention within the scope of Rosenquist patent claim 1 was reduced to practice by February 11, 1994, in three steps. See RB, pp. 1-2. The first step was a hydrolysis of Tinuvin 840 which is said to have produced a "UV-acid from T840." The hydrolysis was conducted by Kemuel McDurmon on October 11 through October 14, 1993. The second step was a polymerization of bis-phenol A with phosgene using the "UV-acid from T840" to form an endcapped polycarbonate resin. Carroll O. Butler was said to have conducted three such polymerizations from February 8 through February 10, 1994. The third step was a molecular weight determination of the three polymerization products produced by Mr. Butler to establish that the "UV-acid from T840" had indeed functioned as an endcapping agent. James D.

Wilson was said to have determined the molecular weights of the polymerization products on or about February 11, 1994. We examine the evidence relied on by Rosenquist more fully below.

III.

According to junior party Rosenquist's testimony, Mr. McDurmon synthesized a "UV-acid from T840" during the period from October 11 through October 14, 1993. The experiment is described on pages 58 and 59 of Mr. McDurmon's laboratory notebook no. 5249 and was performed at the direction of Dr. Rosenquist. See RX 14; RR, pp. 15-17, paragraphs 6-8.

In his declaration, Mr. McDurmon characterizes the experiment described on page 58 of his laboratory notebook no. 5249 as a hydrolysis of "T-840." See RR, p. 16, paragraph 7. "T-840" is said to be a shorthand notation for Tinuvin 840, a light stabilizer for polymers. See RR, pp. 2-3, paragraph 4; RR, p. 16, paragraph 7; RX 4 and RX 5. Mr. McDurmon obtained T-840 from a commercial container labeled "Tinuvin 840" and reacted it with potassium hydroxide in methanol under moderate heat. The reaction was conducted for approximately forty-eight hours. Thereafter, the reaction product was diluted with methanol and further reacted with hydrochloric acid. The resulting product precipitate was washed with methanol, then washed with deionized water and finally dried to a powder. The dried powder was placed in a container labeled "5249-58" and given to Dr. Rosenquist. See RR, p. 16, paragraph 7. Significantly, the record is devoid of any evidence that testing was conducted to identify the structure of the "5249-58" product.

Page 266 of Mr. Butler's laboratory notebook no. MV 90-12 identifies "5249-58" as a "UV acid from T840" and a "UV acid endcap" having the structure of the first "endcapping or chain stopping molecule" listed in Rosenquist patent claim 1 wherein R_1 is a four carbon atom alkyl group, R_2 is hydrogen and n is 2. See RX 15. However, Dr. Rosenquist states that he explained the nature and chemical structure of the "5249-58" product to Mr. Butler. See RR, p. 6, paragraph 8. In any event, the evidence fails to provide a factual basis for Dr. Rosenquist's conclusion that "5249-58" was in fact 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid.

Junior party Rosenquist argues that one cannot prove the existence of a chemical structure. Rather, one deduces that certain reactions occur and confirms that the reactions most likely did occur by testing the products formed. However, in this case, Rosenquist argues that the hydrolysis performed by Mr. McDurmon will produce 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid because "the matter is one of most elementary chemistry." Therefore, no analysis of the "5249-58" product is necessary. See RRB, pp. 5-6.

We disagree. First, the evidence of record appears to establish that the reaction performed by Mr. McDurmon was not as simple as alleged by junior party Rosenquist. In an invention disclosure letter, Dr. Rosenquist states (third page of RX 9):⁵

⁵The document is dated March 9, 1994, and was signed by Dr. Rosenquist on March 9, 1994, although it does not bear the signature of a witness. See RR, p. 10, paragraph 14. The document also bears a stamp indicating the date "RECEIVED." That date is illegible. See RX 9 (stamp appears to read, "RECEIVED May 1[-, ----]").

My initial record of attempting to prepare the "UV acid" from commercially-available Tinuvin 840, with the stated intention of reacting it with polycarbonate resin by the extrusion process mentioned above, is on pages 177 to 179 of notebook MV91-1 dated June 21 and 23, 1992. The work was then suspended because another program ("LR2") required a high priority effort. Almost immediately upon the conclusion of that program, this work was resumed. Records are in notebook 92-10 beginning on page 227 (July 9, 1993). [Emphasis added.]

Pages 177 to 179 of notebook MV91-1 and the work beginning on page 227 of notebook 92-10 are not of record in this interference.⁶

Furthermore, the "UV acid" referred to in the invention disclosure letter is not identified.

According to the invention disclosure letter (second page of RX 9):

The invention consists of a new polycarbonate resin composition with some or all of its end groups consisting of the ester derived from a bisphenol-A in the resin chain and the the [sic] carboxylic acid group on the the [sic] compound labeled "UV acid" on the attached page.

The "attached page" was not provided by junior party Rosenquist.

Second, a party establishing an actual reduction to practice of the subject matter of a count must show a reduction to practice of each and every limitation of the count. Cooper, 154 F.3d at 1327, 47 USPQ2d at 1901. There is simply no evidence in the record that junior party Rosenquist was in possession of an endcapping molecule within the scope of the count prior to the senior party's effective filing date. At best, the evidence of record establishes that Dr.

⁶In his declaration, Dr. Rosenquist identifies RX 6 as a copy of pages 304 and 305 from his laboratory notebook no. MV 92-10. See RR, pp. 7-8, paragraphs 9 and 10. However, RX 6 does not include a copy of the laboratory notebook cover sheet or provide any other indication that RX 6 is indeed a copy of pages 304 and 305 from laboratory notebook no. MV 92-10. Compare RX 14 and RX 15.

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Rosenquist conceived of hydrolyzing T-840 to form an endcapping compound within the scope of the count prior to the senior party's effective filing date. See RR, pp. 3-4, paragraph 6 ("Prior to October 1993, I conceived of hydrolyzing T-840 to form the corresponding benzotriazol benzene propanoic acid . . ."). However, a conception is not an actual reduction to practice. Compare Cooper, 154 F.3d at 1327, 47 USPQ2d at 1901 (conception is the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice); with Estee Lauder v. L'Oreal, S.A., 129 F.3d 588, 592, 44 USPQ2d 1610, 1613 (Fed. Cir. 1997) (to prove an actual reduction to practice, an inventor must establish that he actually prepared the invention and knew it would work).

IV.

The count further requires interfacially condensing a phosgene derivative, a bis-phenol derivative and an endcapping or chain stopping molecule, including 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid, wherein the endcapping agent is chemically bound to the condensation product by an ester linkage through the acid substituent of the phenolic substituent of the endcapping or chain stopping molecule. See Rosenquist patent claim 1.

According to junior party Rosenquist's testimony, shortly before February 8, 1994, Dr. Rosenquist gave a portion of the "5249-58" product to Mr. Butler. See RR, p. 6, paragraph 8. From February 8 through February 10, 1994, Mr. Butler conducted three interfacial polycarbonate polymerizations using different proportions of the "5249-58" product as the

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endcapping component. The experiments are described on pages 266 and 268 of Mr. Butler's notebook no. MV 90-12 and were performed at the direction of Dr. Rosenquist. See RX 15; RR, pp. 6-7, paragraph 9; RR, p. 21-22, paragraph 7.

Page 266 of notebook no. MV 90-12 describes the first experiment as reacting 57.0 g of BPA (bis-phenol A), 400 mls of CH_2Cl_2 (methylene chloride), 325 mls of H_2O (water), 0.7 mls (2 m%) of TEA (triethyl amine), 2.63 gms (3.1 m%) of the "5249-58" product and 30 gms of COCl_2 (phosgene) in a flask. The reaction was run at a pH of 8 for twelve minutes and then ramped to a pH of 10.2 for the rest of the reaction. See RX 15, RR, pp. 6-7, paragraph 9. According to Mr. Butler's notebook, the reaction "[r]an good no problem separated quickly. Washed 2X in 2% HCL and 3X in DI H_2O . Dried over MgSO_4 . Organic phase has slight yellow color." See the second page of RX 15.

Mr. Butler repeated the experiment twice using 3.48 g (4.1 m%) and 3.9 g (4.6 m%) of the endcap, respectively. See the second and third pages of RX 15. Page 268 of Mr. Butler's notebook no. MV 90-12 indicates that the third polymer was submitted for "GPC" and bears the notation "GPC 21,719." See the third page of RX 15. Pages 266 and 268 of Mr. Butler's laboratory notebook no. MV 90-12 are said to have been signed by Carroll Butler and are dated February 10, 1994. See RR, p. 20, paragraph 5.

According to Dr. Rosenquist, Mr. Butler gave Dr. Rosenquist the polycarbonate polymer specimens he had produced along with copies of pages 266 and 268 from his notebook. Dr.

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Rosenquist attached these pages from Mr. Butler's notebook to page 304 of his own laboratory notebook. See RX 6; RR, p. 7, paragraph 9.

Dr. Rosenquist further testified that on about February 11, 1994, the molecular weights of the three polycarbonate specimens were measured by GPC (gel permeation chromatography). See RR, p. 8, paragraph 10. According to page 305 of Dr. Rosenquist's notebook, Dr. Rosenquist obtained the molecular weight data from Jim Wilson. See RX 6. However, Mr. Wilson was unable to locate that data in the electronic records where data of that type is usually stored. See RR, p. 44, paragraph 5.

In any event, according to Dr. Rosenquist, he received the "MW" and "MN" measurements for the three specimens and made the necessary calculations on February 11, 1994. The results, including "Target MW," were recorded on page 305 of Dr. Rosenquist's notebook. The molecular weights ("MW") reported for the three specimens were 32,300, 25,900 and 21,700, respectively. See RR, p. 8, paragraph 10; fifth page of RX 6.

In his declaration, Dr. Rosenquist explains that (RR, p. 8, paragraph 10):

[The data reported on page 305 of Dr. Rosenquist's laboratory notebook (RX 6)] shows that the product 5249-58 is indeed functioning as a monofunctional endcapping agent to control polymer molecular weight, producing essentially the same polymerization control as the same proportion of standard phenol endcapping agent.

Significantly, there is no direct evidence that the ester linkage required by the count was formed in any one of the three interfacial polycarbonate polymerizations performed by Mr. Butler from February 8 through February 10, 1994. See Rosenquist patent claim 1.

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Nevertheless, relying on U.S. Patent No. 4,431,793 to Rosenquist (RX 7) and U.S. Patent No. 5,025,081 to Fontana et al. (RX 8), Rosenquist argues that formation of the requisite ester linkage can be established. Specifically, Rosenquist argues that the prior art shows the reactivity of a carboxylic acid with a polymer phenol under interfacial reaction conditions, both as a polycarbonate endcapper (RX 7) and as a comonomer to form polyestercarbonates (RX 8). See RRB, pp. 18-19.

Rosenquist's argument is not persuasive. First, as discussed above, Rosenquist has failed to establish that an endcapping agent within the scope of the count was formed. Therefore, based on this record, it is not possible to determine how the product identified as "5249-58" would have bound to the condensation product in the three interfacial polycarbonate polymerizations performed by Mr. Butler. Second, assuming *arguendo*, that the "5249-58" product was an endcapping agent within the scope of the count, U.S. Patent No. 4,431,793 (RX 7) and U.S. Patent No. 5,025,081 (RX 8) fail to establish, by a preponderance of the evidence, that the requisite ester linkage would have been formed.

Specifically, neither U.S. Patent No. 4,431,793 (RX 7) nor U.S. Patent No. 5,025,081 (RX 8) disclose an endcapping agent within the scope of the count. U.S. Patent No. 4,431,793 (RX 7) discloses a monofunctional polycarbonate endcapper which reacts with a polymer phenol through an acid substituent. See RX 7, col. 3, lines 43-48 and Table 5. Similarly, U.S. Patent No. 5,025,081 (RX 8) discloses that a monofunctional agent such as a carboxylic is useful as a

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chain terminating agent. However, both U.S. Patent Nos. 4,431,793 and 5,025,081 recognize that phenol can be used as a chain terminating agent. See RX 7, col. 1, lines 17-20; RX 8, col. 4, lines 25-32.

Scholl argues that the benzotriazole endcapping agents of the count have both acid and hydroxyl functionalities. Scholl relies on U.S. Patent No. 4,153,780 to Narita et al. (RX 2) to establish that the endcapping agents of the count could chemically bind to the condensation product by an ester linkage through the hydroxyl group, rather than the acid substituent, of the phenolic substituent of the endcapping agents. See SB, pp. 9-10.

Specifically, Narita et al. disclose that benzotriazole compounds are useful in adjusting the molecular weight of polycarbonate compositions. According to Narita et al., the hydroxyl group of the benzotriazole compounds reacts with the terminal chloroformate group of the polycarbonate and binds chemically to the termini of the polycarbonate. Through this reaction, the molecular weight of the polycarbonate is controlled. See generally RX 2, col. 3, lines 8-45.

Rosenquist argues that the phenolic hydroxyl group in the endcapping agent of the count is hindered, and therefore, would not react with the condensation product to provide an endcapping function. According to junior party Rosenquist (RRB, p. 19):

If the hindered phenolic hydroxy group were reacting with the polycarbonate (i.e. with the phosgene component), the benzotriazol benzene propanoic acid would have been difunctional (i.e. hydroxy and carboxylic acid functionality), and would then have functioned as a comonomer, and the resultant molecular weights of the polymers would have been many fold higher than measured and reported at RX-6, page 305. This matter is fully explained by Dr. Rosenquist at RR-009 at par. 11.

Similarly, Dr. Rosenquist explains (RR, p. 9, paragraph 11):

If the hindered phenolic hydroxy group had been reacting with the polycarbonate, the product 5249-58 would have been a difunctional comonomer, with the hydroxyl group reacting with a chloro of the phosgene and the carboxyl group reacting with an hydroxyl of the bis-phenol A, to form a polyester polycarbonate. Therefore, no endcapping function would have been available, and the molecular weight of the polymers would all have been many fold higher than shown above in paragraph 10 [wherein the data from page 305 of Dr. Rosenquist's laboratory notebook is said to have been reproduced].

Rosenquist does not provide a factual basis for this conclusion. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973) ("the affidavits fail in their purpose since they recite conclusions and few facts to buttress said conclusions"); Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997) ("Nothing in the rules or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness."); see also In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (arguments in the brief do not take the place of evidence in the record).

In any event, Rosenquist's argument is not persuasive. It appears that the benzotriazole compounds disclosed in Narita et al., which perform an endcapping function by binding with the polycarbonate through the hydroxyl group of the benzotriazole compound, have hindered hydroxyl groups. See RX 2, col. 3, lines 20-39.

Therefore, based on the record before us, Rosenquist has failed to establish, by a preponderance of the evidence, that an ester linkage within the scope of the count would necessarily have been formed between the condensation product and the "5249-58" product.

This is especially true where Rosenquist has failed to establish, in the first instance, that the "5249-58" product is an endcapper within the scope of the count.

V.

Finally, senior party Scholl argues that junior party Rosenquist has failed to establish that Dr. Rosenquist contemporaneously appreciated that an endcapped polycarbonate resin having the ester linkage required by the count was produced by Mr. Butler during the period from February 8 through February 10, 1994. See SB, pp. 10-11. See Breen v. Henshaw, 472 F.2d 1398, 1401, 176 USPQ 519, 521 (CCPA 1973) (a reduction to practice cannot be established nunc pro tunc). Relying on Dr. Rosenquist's testimony in paragraph 12 on pages 9 through 10 of the Rosenquist record and Rosenquist exhibit 9, junior party Rosenquist argues that Dr. Rosenquist did in fact appreciate an invention within the scope of the count prior to Scholl's effective filing date. See RRB, pp. 19 and 25.

Dr. Rosenquist's testimony at paragraph 12 of pages 9 through 10 of the Rosenquist record refers to an invention disclosure letter (RX 9). The invention disclosure letter is said to exemplify Dr. Rosenquist's recognition that (RR, pp. 9-10, paragraph 12):

[T]he UV-acid from T-840 (i.e. product 5249-58) provides an improved covalently bondable UV stabilizer for polycarbonate resins, bondable by reaction of its carboxylic acid functionality with the hydroxy functionality of the bisphenol component of the polycarbonate.

According to the invention disclosure letter (second page of RX 9):

The invention consists of a new polycarbonate resin composition with some or all of its end groups consisting of the ester derived from a bisphenol-A in the resin

chain and the the [sic] carboxylic acid group on the the [sic] compound labeled "UV acid" on the attached page.

The invention disclosure letter neither identifies the "UV acid" nor the polycarbonate resin composition. Although reference is made to "the compound labeled 'UV acid' on the attached page" and "attachments" illustrating the test data or reduction to practice, those attachments were not provided by Rosenquist.

To the extent that the letter does discuss the use of a carboxylic acid group as an endcapping agent for a polycarbonate resin, the count requires the endcapping agent to be chemically bound to the condensation product by an ester linkage through the acid substituent of the phenolic substituent of the endcapping molecule. See Rosenquist patent claim 1. The letter fails to indicate that an endcapped polycarbonate resin having this ester linkage was formed. See the second page of RX 9 ("Three routes [for making endcapped resins] are under investigation . . . Each of these routes should yield resin with end groups of the proposed structure."). In fact, the letter fails to establish that the "UV acid" endcapper was even made. See the third page of RX 9 (the initial record of attempting to prepare the "UV acid" from commercially available Tinuvin 840, with the stated intention of reacting it with polycarbonate resin, is in a notebook dated June 21 and 23, 1992; the work was suspended but later resumed, apparently in July 1993).

In sum, the evidence of record, including the invention disclosure letter, fails to establish that an endcapped polycarbonate resin was produced according to the process of the count. Therefore, the letter cannot serve as a contemporaneous recognition and appreciation of that fact.

VI.

For the reasons set forth above, junior party Rosenquist has failed to establish, by a preponderance of the evidence, an actual reduction to practice of an invention within the scope of Count 2 prior to senior party Scholl's effective filing date.

Junior party Rosenquist's motion to substitute Count 2 with proposed Count A

During the preliminary motions period, Rosenquist filed a motion to substitute proposed Count A for Count 1. The motion was denied in an Order mailed February 18, 1998. See Paper No. 31, pp. 3-4. In that same Order, the interference was redeclared to substitute Count 2 for Count 1. See Paper No. 31, pp. 4-5. At final hearing, Rosenquist argues that the motion to substitute proposed Count A for Count 1, now Count 2, should be granted if Rosenquist's proofs are insufficient to establish an actual reduction to practice of Count 2. See RB, pp. 15-16.

Rosenquist's motion was denied for the following reasons (Paper No. 31, pp. 3-4):

Count 2 (which is substituted for Count 1 of the interference as declared) consists of subject matter, recited in the alternative, of all the claims of both parties which have been designated as being involved in the interference, i.e., which correspond to the "count." In the priority phase of the interference, proof of priority by Rosenquist of a species within the scope of any claim designated as corresponding to the "count" should be sufficient for Rosenquist to prevail on the issue of priority. No need is seen for a phantom count including any subject matter not embraced by a claim designated as corresponding to the count. The statute (35 U.S.C. § 135(a)) does not mention a count. Rather, the statute refers to the claims "involved" in the interference. The count mentioned in the rules has been, and will continue to be, an alternative recitation of the subject matter of all claims involved (to use the words of the statute) in the interference (i.e., those designated to correspond to the count (to use the words of the rules)). [Emphasis added.]

According to Rosenquist, "alternative-claims-counts" can restrict a party to a narrower claim merely because of a difference in the language used. In contrast, a "classical phantom count," as proposed by Rosenquist, is said to provide "a true level playing field, enabling all parties to present their best proofs of the invention at issue without disputes over language, equivalents and the like" (emphasis in original). See RB, pp. 16-17. Specifically, Rosenquist explains that in this case (RRB, p. 27):

The way the count is now drafted, Rosenquist cannot use any of the Scholl count claims, because they all contain the limitation "weight average [molecular weight] determined by light scattering". On the other side of the coin, Scholl argues in its brief that the Rosenquist proofs do not meet the Rosenquist count claims, because those claims contain the recitation of "phosgene derivative". Both limitations or features are removed from the proposed phantom count, the issues disappear, and both parties can offer their earliest proofs based on the same definition of the invention, and free of these problems or arguments. [Emphasis in original.]

Rosenquist urges this panel to substitute proposed Count A for Count 2 so that Rosenquist "can present its earliest priority proofs with a minimum of argumentation over the meaning of the words of the count." See RB, p. 18.

Rosenquist's arguments are not persuasive. First, Rosenquist is the only party that has presented a priority case. Senior party Scholl is restricted to the May 20, 1994, filing date of German patent application P 4417748.8, to which benefit was accorded Application 08/438,516 under 35 U.S.C. § 119. Therefore, it is not necessary to "level the playing field" so that "the priority proofs of both parties can be measured against the same definition of the invention." See RB, pp. 18-19.

Second, whether Rosenquist used phosgene or a phosgene derivative in the interfacial polycarbonate polymerizations on February 8 through February 10, 1994, is not dispositive in this case. For the reasons set forth above, Rosenquist has failed to establish that the "UV acid endcap," identified as "5249-58," was 3-(2H-benzotriazol-2-yl)-5-(1,1-dimethylethyl)-4-hydroxy-benzene-propanoic acid and was chemically bound to the condensation product by an ester linkage through the acid substituent of the phenolic substituent of the endcap.

Finally, the first alternative of proposed Count A requires the chain terminator to chemically bond to the polycarbonate by an ester linkage through the acid substituent of the phenolic substituent of the chain terminator. See "Count A" in the Appendix attached to Rosenquist's brief. Therefore, even if this panel were to grant Rosenquist's motion, Rosenquist has failed to establish, by a preponderance of the evidence, an actual reduction to practice of an invention within the scope of proposed Count A for the same reasons that he failed to establish an actual reduction to practice of an invention within the scope of Count 2.

Judgment

Judgment as to Count 2, the sole count at issue in this interference, is entered against the junior party Niles R. Rosenquist. Niles R. Rosenquist is not entitled to claims 1 through 5 of U.S. Patent No. 5,523,379 which have been designated as corresponding to the count.

Patent Interference No. 103,812

Judgment as to Count 2 is awarded in favor of the senior party Thomas Scholl and Peter Bier. On the record before the United States Patent and Trademark Office in this interference, Thomas Scholl and Peter Bier are entitled to a patent containing claims 34 through 38 of involved Application 08/438,516 which have been designated as corresponding to the count.

ANDREW H. METZ)	
Administrative Patent Judge)	
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Administrative Patent Judge)	INTERFERENCES
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)	
ADRIENE LEPIANE HANLON)	
Administrative Patent Judge)	

Patent Interference No. 103,812

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