

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. 144

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SHU-HUI CHEN and VITTORIO FARINA
Junior Party¹

v.

JACKSON B. HESTER, JR., ROY A JOHNSON, ROBERT C. KELLY,
ELDON G. NIDY and HARVEY L. SKULNICK
Senior Party²

Patent Interference No. 104,490

JUDGMENT

Before METZ, HANLON and LORIN, Administrative Patent Judges.

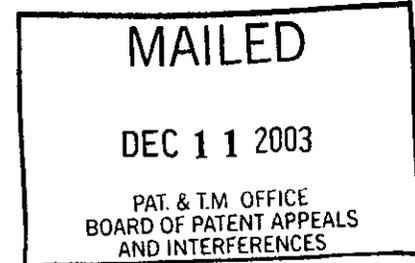
METZ, Administrative Patent Judge.

Prosecution in this proceeding is herein **REOPENED**.

On October 10, 2002, the Administrative Patent Judge (APJ) assigned to this proceeding, in the performance of his

¹ Application 08/029,819, filed March 11, 1993, now U.S. Patent Number 5,254,580, issued on October 19, 1993. Assigned to Bristol-Myers Squibb Company, New York, New York.

² Application Serial Number 08/454,210, filed on June 9, 1995. Accorded benefit of France 92 14813, filed on December 9, 1992. Assigned to Pharmacia & Upjohn Co.



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interlocutory duties, issued an order under 37 C.F.R. § 1.640(d)(1) against the party Chen et al. to show cause why judgment should not be entered against them. See Paper Number 133. Chen et al. were involved in another interference, Interference Number 103,675 and captioned Chen et al. v. Bouchard et al., based on the same claims of the same patent and involving the same counts as are involved in this interference. The basis for the order to show cause was stated as follows:

Chen et al. have not filed any notice in this interference pursuant to 37 C.F.R. § 1.660(d) indicating that they have appealed from or have otherwise sought review of the Board's decision in Interference Number 103,675 and the time for taking such action has expired. Therefore, by operation of the statute, claims 1 through 11 of Chen et al.'s involved patent in this interference are **CANCELED** and Chen et al. have no allowable claims extant in their involved patent. Accordingly, there is no longer any basis on which Chen et al. could contest priority of invention in this proceeding nor is there any reason to permit Chen et al. to pursue any other issues against Hester et al. using the interference rules.

In their response to the order to show cause, Chen et al. established that they had timely filed an appeal of the Board's decision awarding priority to the senior party Bouchard et al. to the Court of Appeals for the Federal Circuit. See Paper Number 135, filed on November 1, 2002.

In response to Chen et al.'s response to the order to show cause, the APJ closed the prosecution of this interference and suspended the proceedings pending a decision by the Court of Appeals for the Federal Circuit in Chen et al.'s appeal. Chen et al. were also ordered to:

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file in this proceeding a copy of the decision and mandate of the Court of Appeals for the Federal Circuit from the appeal taken in Interference Number 103,675 immediately after the court issues its decision and mandate.

On October 22, 2003, the Court of Appeals for the Federal Circuit rendered its opinion in Chen et al.'s appeal (Appeal Number 03-1037). Therein, the Court affirmed the Board's decision awarding priority to the senior party, Bouchard et al. On November 20, 2003, Chen et al. complied with the APJ's order and filed in this proceeding a copy of the Court's decision and mandate from Interference Number 103,675.

Accordingly, by operation of 35 U.S.C. § 135(a)³, when the court affirmed the Board's decision awarding judgment to Bouchard et al. in Interference 103,675, claims 1 through 11 of Chen et al.'s involved patent were canceled. Therefore, Chen et al. no longer have any valid, enforceable claims in their involved patent in this proceeding. As the APJ stated in his order to show cause:

there is no longer any basis on which Chen et al. could contest priority of invention in this proceeding nor is there any reason to permit Chen et al. to pursue any other issues against Hester et al. using the interference rules.

We recognize that when this interference was declared, because Chen et al. had enforceable claims in an unexpired patent which "interfered" in the sense of the statute and 37 C.F.R. § 1.601(j) with certain claims of Hester et al., Chen et al. were authorized

³ See, also, 37 C.F.R § 1.663.

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to file preliminary motions. See 37 C.F.R. § 1.633. However, in light of the Court's decision and the cancellation by operation of the statute of all Chen et al.'s claims designated as corresponding to the count in this interference, we have the discretion not to decide those motions in view of this proceeding's current posture.

Specifically, in Berman v. Housey, 291 F.3d 1345, 1351, 1352, 63 USPQ2d 1023, 1027, 1028 (Fed. Cir, 2002), the court held that the Board has the discretionary authority to decide certain issues, "even after the Board determines that one party was not entitled to its claims." Here, all Chen et al.'s claims designated as corresponding to the counts have been **canceled** by the statute ("A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office." See the last sentence of 35 U.S.C. § 135 (a).)

Therefore, because Chen et al.'s patent has **no** claims remaining therein after the issuance of the Court's decision and mandate, we decline to exercise our discretionary authority and, therefore, decline to consider any of Chen et al.'s preliminary motions in this proceeding. Accordingly, all Chen et al.'s preliminary motions are herein **DISMISSED**.

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In Interference Number 104,491 and captioned Hester et al. v. Bouchard et al., Hester et al. requested and agreed to adverse judgment against them under 37 C.F.R. § 1.662 (a). See Paper Number 67 filed on March 5, 2003, in Interference Number 104,491. On March 11, 2003, the Board entered judgment against Hester et al. in Interference Number 104,491 as to all their claims designated as corresponding to the counts. See Paper Number 69 in Interference 104,491. Hester et al. were involved in Interference Number 104,491 based on the same application as here, that is, Application Serial Number 08/454,210, and based on the identical claims as here. Thus, by conceding priority to Bouchard et al., Hester et al. were no longer entitled to the claims in their application designated as corresponding to the counts which are the same claims on which Hester et al. are involved here. Therefore, Hester et al. have no enforceable claims remaining in their involved application in this interference proceeding. Accordingly, all Hester et al.'s preliminary motions are DISMISSED.

We have the extraordinary situation here where neither party in this interference has any enforceable claims remaining in their involved patent and application, respectively. Therefore, there is no longer any basis on which we could or shall continue this proceeding as the rights of the parties as to the subject matter of the counts has already been determined in the other, related proceedings. In light of these facts, it is now

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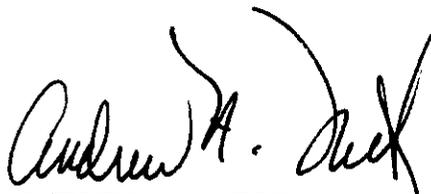
appropriate for us to render judgment in this proceeding.

In light of the cancellation of claims 1 through 11 of Chen et al.'s involved patent by operation of 35 U.S.C. § 135(a), judgment as to the subject matter of all counts in this interference, is entered against Shu-Hui Chen and Vittorio Farina, the junior party. Shu-Hui Chen and Vittorio Farina, the junior party, are not entitled to their patent containing claims 1 through 11 of their U.S. patent 5,254,580 involved in this proceeding and designated as corresponding to Count 2 (claims 7 through 9), Count 3A (claims 10 and 11) and Count 4 (claims 1 through 6, 8 and 9).

Based on the request for entry of and agreement to adverse judgment against them in Interference Number 104,491, and based on the judgment issued by the Board on March 11, 2003, in Interference Number 104,491, judgment as to the subject matter of all counts in this interference, is entered against Jackson B. Hester, Jr., Roy A. Johnson, Robert C. Kelly, Eldon G. Nidy and Harvey I. Skulnick, the senior party. Jackson B. Hester, Jr., Roy A. Johnson, Robert C. Kelly, Eldon G. Nidy and Harvey I. Skulnick, the senior party, are not entitled to claims 2, 3, 7, 19, 20, 34 through 37, 39 through 42 and 44 through 47 of their involved patent application Serial Number 08/454,210 designated

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as corresponding to Count 4 (claims 2, 3, 7, 19, 20, 34 through 37, 39 through 42, 44 and 45), Count 2 (claim 46) and Count 3A (claim 47).



ANDREW H. METZ
Administrative Patent Judge)



ADRIENE LEPIANE HANLON
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)



HUBERT C. LORIN
Administrative Patent Judge)

AHM/gjh

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