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Paper 34

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DWIGHT T. TOMES,
ARTHUR WEISSINGER, JOHN C. SANFORD,
and THEODORE M. KLEIN,

Junior Party,
(Application 08/442,522),

v.

LYNN E. MURRY,
RALPH M. SINIBALDI, PAUL S. DIETRICH,
and SHARON C.H. ALFINITO

Senior Party,
(Application 08/437,488).

Patent Interference No. 104,513

Before MCKELVEY, Senior Administrative Patent Judge, and LEE and
GARDNER-LANE, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

JUDGMENT PURSUANT TO 37 CFR § 1.662

Tomes has filed a paper entitled "ABANDONMENT OF CONTEST
FOR COUNT 2 BY TOMES" (Paper 30). In the paper, Tomes states
"Tomes hereby abandons the contest with respect to Count 2 to
insect resistant transgenic corn in Interference Nos. 104,453

and 104,513 by hereby canceling claims 41, 66 and 81 in U.S. Serial No. 08/442,522, the only Tomes claims which correspond to Count 2."

Murry has filed a paper entitled "MURRY ABANDONMENT OF CONTEST AND CONCESSION OF UNPATENTABILITY UNDER 37 C.F.R. § 1.662" (Paper 32). In the paper, Murry states that it "hereby abandons the contest as to Count 1 in the present interference and concedes that the subject matter of Count 2 is not patentable to either party in the interference." Murry states that it is expressly abandoning its involved 08/437,488 application.

When a party either (1) concedes unpatentability of the subject matter of a count or (2) abandons the contest as to a count, the concession or abandonment is treated as a request for entry of an adverse judgment against the party as to all the claims that correspond to the count. 37 CFR § 1.662(a). Accordingly, (1) the statement by Tomes (Paper 30) is treated as a request for adverse judgment as to count 2, and (2) the statement by Murry (Paper 32) is treated as a request for adverse judgment as to both counts 1 and 2.

Claims of an involved application may be amended during the interference only if a preliminary motion under 37 CFR § 1.633(c) is granted. Since Tomes did not file a preliminary motion under § 1.633(c) to amend its claims and accordingly, no such preliminary motion was granted, it would be inappropriate to cancel Tomes claims 41, 66 and 81 at this time.

Upon consideration of the record of the interference, it is ORDERED that judgment on priority as to Count 1, is awarded against senior party LYNN E. MURRY, RALPH M. SINIBALDI, PAUL S. DIETRICH, and SHARON C.H. ALFINITO;

FURTHER ORDERED that senior party LYNN E. MURRY, RALPH M. SINIBALDI, PAUL S. DIETRICH, and SHARON C.H. ALFINITO, is not entitled to a patent containing claims 25, 26, 29, 30, and 32-34 of application 08/437,488 which correspond to Count 1;

FURTHER ORDERED that judgment on priority as to Count 2, is awarded against junior party DWIGHT T. TOMES, ARTHUR WEISSINGER, JOHN C. SANFORD, and THEODORE M. KLEIN and senior party LYNN E. MURRY, RALPH M. SINIBALDI, PAUL S. DIETRICH, and SHARON C.H. ALFINITO;

FURTHER ORDERED that junior party DWIGHT T. TOMES, ARTHUR WEISSINGER, JOHN C. SANFORD, and THEODORE M. KLEIN is not entitled to a patent containing claims 41, 66, and 81, of application 08/442,522 which correspond to Count 2;

FURTHER ORDERED that senior party LYNN E. MURRY, RALPH M. SINIBALDI, PAUL S. DIETRICH, and SHARON C.H. ALFINITO, is not entitled to a patent containing claims 27, 28, and 31, of application 08/437,488 which correspond to Count 2;

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative records of Tomes 08/442,522 application and Murry's 08/437,488 application.

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FRED McKELVEY, Senior)	
Administrative Patent Judge)	
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JAMESON LEE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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SALLY GARDNER-LANE)	
Administrative Patent Judge)	

cc (via facsimile and first class mail):

Counsel for Tomes (real party in interest, Pioneer Hi-Bred International, Inc.)

John P. Isacson
Jayme A. Huleatt
Matthew R. Cohen
Foley & Lardner
3000 K St., N.W., Ste. 500
Washington, D.C. 20007-5109

Tel: 202-672-5300
Fax: 202-672-5399

Counsel for Murry and Carswell (real party in interest, Novartis AG and Novartis Finance Corporation)

John Scheibeler
Dimitrios T. Drivas
White & Case LLP
Patent Department
1155 AVE OF THE AMERICAS
NEW YORK NY 10036-2787

Tel: 212-819-8286
Fax: 212-354-8113