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Paper 66

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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KEITH CHARLES DEEN,  
MARK R. HURLE, PETER YOUNG,  
and KONG B. TAN,

Junior Party,  
(Patent 6,013,476)

v.

JIAN NI,  
GUO-LIANG YU, PING FAN, and  
REINER L. GENTZ,

Senior Party,  
(Application 09/095,094).

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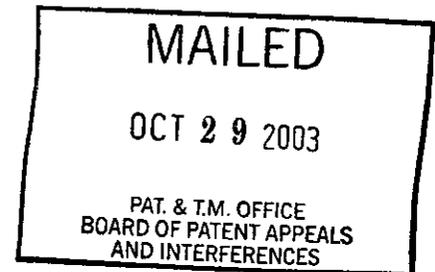
Patent Interference No. 104,784

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Before: SPIEGEL, LANE, and TIERNEY, Administrative Patent Judges.

LANE, Administrative Patent Judge.

**DECISION ON REQUEST FOR RECONSIDERATION AND FINAL JUDGMENT**



## **I. Introduction**

Deen has filed a paper entitled “DEEN RESPONSE TO ORDER TO SHOW CAUSE” (“the Response”) (Paper 65). Deen argues that “judgment should not be entered against it because the decision on preliminary motions (“the decision”) (Paper 62) is in error and should be reversed” (Paper 65 at 2). Thus, Deen’s response to the order to show cause (Paper 64) is, in effect, a request for reconsideration of our decision on preliminary motions. We GRANT the request for reconsideration to the extent that we have considered the arguments raised by Deen in the response. However, we do not modify the decision.

## **II. Discussion**

### **A. Request for reconsideration**

When seeking reconsideration of a panel decision at final hearing (37 CFR § 1.655(a)), a party should specify what points the panel overlooked or misapprehended in rendering the decision. *Charlton v. Rosenstein*, <http://www.uspto.gov/web/offices/dcom/bpai/its/104148.pdf>, 6-7, (BPAI (ITS) 2000).

Deen argues that there are two points where the decision is in error. In particular, Deen argues that:

(1) The decision failed to recognize that Deen’s proposed count “provides a better basis for deciding priority in that it is broader than the existing count” and “is better supported by Deen’s best proofs, namely its provisional application” (Paper 65 at 2), and

(2) Deen is entitled to benefit of its provisional application<sup>[1]</sup> because Deen's disclosure of "a genetic fragment of a new tumor necrosis factor receptor (TNFR) from which that TNFR could be, and eventually was, produced, entitled Deen to the benefit of the filing date of its provisional application." According to Deen, "[t]he Board's error in this respect arose from its failure to recognize" that the testimony of Ni witness Dr. Chinnaiyan was discredited upon cross-examination by Deen. In particular, Deen argues that Dr. Chinnaiyan's testimony "**was discredited because Dr. Chinnaiyan's conclusions (as an expert in death domain-containing TNFR's) were based on the absence of multiple death domains in the sequence disclosed in Deen's provisional application**" ( Paper 65 at 2-3) (emphasis in original).

Deen's points are directed to areas where it disagrees with the decision. However, Deen has not explained what we misapprehended or overlooked in rendering the decision.

*The substitute count*

In particular, regarding Deen's first point, the decision addressed why Deen's preliminary motions to substitute or add Deen's proposed count were denied. The decision stated:

(Paper 62 at 4):

Deen has not shown why it is necessary to substitute or add a count having the breadth of the proposed count in view of its proffer of proof. Moreover, Deen has not shown how the disclosure of the nucleotide sequence contained in its provisional application amounts to a constructive reduction to practice of an embodiment within the scope of the proposed count. Accordingly, Deen has not sufficiently shown why it is necessary to substitute or add the Deen proposed count and we do not substitute or add the proposed count.

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<sup>1</sup> Application 60/041,796, filed 2 April 1997.

A further explanation of why Deen's preliminary motions to substitute or add the proposed count were denied appears within the decision. (Paper 62 at 13-24).

Dr. Chinnaiyan's testimony

As to Deen's second point, the decision addressed Dr. Chinnaiyan's cross-examination testimony regarding TNFR death domains. The decision stated (Paper 62 at 18-19):

Deen argues that we should not accept the testimony of Dr. Chinnaiyan. In particular, Deen argues that Dr. Chinnaiyan's declaration testimony is contradicted by Dr. Chinnaiyan's cross-examination testimony that... (FF 35)<sup>[2]</sup>:

(2) most TNFRs do not have death domains...

...However...Dr. Chinnaiyan did not testify in his declaration that all TNFRs have death domains. Our understanding of Dr. Chinnaiyan's testimony is that it is necessary to characterize the intracellular domain to determine activity of a potential TNFR. Dr. Chinnaiyan's testimony indicates that it would be necessary to identify a death domain in order to characterize a TNFR as apoptosis inducing. Since no death domain is identified in the TR7 fragment, the fragment cannot be characterized as having apoptosis inducing activity.

Moreover, our determination that Deen did not sufficiently show that its provisional application provided a constructive reduction to practice within the scope of either Count 1 or

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<sup>2</sup> "FF 35" refers to finding of fact 35 of the decision which reads:

35. On cross-examination, Dr. Chinnaiyan testimony indicated, *inter alia*, that:

(1) Most TNFRs do not have death domains (Exh. 2013 at 23), and

(2) even though there are exceptions (at least one where a TNFR has only one CRD[cysteine rich domain]), most TNFRs have multiple CRDs. Accordingly, the presence of multiple CRDs increases one's confidence that a TNFR has been discovered. (Exh. 2001 at 37-50).

Deen's proposed count was not based solely on Dr. Chinnaiyan's testimony. As we stated in the decision "Deen has not directed us to evidence sufficient to show that one skilled in the art would have recognized that the fragment disclosed in the Deen provisional was in fact a TNFR fragment" (Paper 62 at 23). Deen had the burden of proof but did not meet its burden in its preliminary motions. 37 CFR § 1.637(a).

Furthermore, Dr. Chinnaiyan's testimony that one skilled in the art would not have recognized the Deen provisional fragment as a fragment of a TNFR was not based solely on his observation that the fragment did not contain a death domain. Dr. Chinnaiyan testified that other indicators of a TNFR, e.g., multiple CRDs, were not present in the fragment (Paper 62 at 11-12 and 19). Dr. Chinnaiyan's cross-examination testimony highlighted that not all TNFRs have all the indicators. However, overall, Dr. Chinnaiyan's testimony indicated that one skilled in the art could not have reasonably predicted a TNFR based on the fragment found in the Deen provisional application since insufficient indicators were present.

*B. Request for hearing*

Deen has indicated that it will not present any evidence on the issue of priority (Paper 64 at 2). Thus, the only issue before us is whether to modify our decision on preliminary motions. As noted above, Deen has not directed us to any points that we misapprehended or overlooked in rendering the decision.

Nonetheless, Deen states that "it is the preference of Deen to have an opportunity to appear before the Board to present oral argument at a final hearing" (Paper 65 at 3).

We do not exercise our discretion to conduct a hearing in the circumstances before us. Conducting a hearing where there is nothing new to consider would not be in the interest of

securing “the just, speedy, and inexpensive determination” of the interference. 37 CFR § 1.601. To the extent that current practice may be interpreted as requiring a final hearing with briefing for purposes of “finality”,<sup>3</sup> we deem the hearing on preliminary motions (see Paper 60) to be that “final hearing.”

### **III. Conclusion**

In response to the order to show cause, Deen states that judgment should not be entered against it because the decision was in error and should be reversed. Deen has not shown the decision to be in error and we do not modify our decision. Accordingly, it is appropriate to enter final judgment against Deen.

### **IV. Order**

Upon consideration of the record of the interference and for reasons given, it is

ORDERED that Deen’s request for reconsideration of our decision on preliminary motions (Paper 65) is GRANTED to the extent that we have considered the arguments raised by Deen;

FURTHER ORDERED that we do not modify our decision on preliminary motions (Paper 62);

FURTHER ORDERED that judgment as to Count 1, the sole count in the interference, is awarded against junior party KEITH CHARLES DEEN, MARK R. HURLE, PETER YOUNG, and KONG B. TAN;

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<sup>3</sup> See 37 CFR § 1.654.



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