

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 132

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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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JOHN **GOODCHILD** and PAUL C. ZAMECNIK  
(Application 08/346,270)

Junior Party<sup>1</sup>

v.

**JACK S. COHEN,**  
LEN NECKERS, CY STEIN, SHEE L. LOKE,  
KAZUO SHINOZUKA, GERALD ZON, and MAKOTO MATSUKURA (Patent 5,264,423),  
JACK S. COHEN, LEN NECKERS, CY STEIN, SHEE L. LOKE, and KAZUO  
SHINOZUKA (Patents 5,276,019, and 5,286,717)),

Senior Party<sup>2</sup>

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Patent Interference 105,040

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Before GRON, GARDNER LANE and NAGUMO, Administrative Patent Judges.

GARDNER LANE, Administrative Patent Judge.

**Judgment - Request for Adverse - Bd.R. 127(b)**

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<sup>1</sup> Real party in interest: University of Massachusetts, Worcester.

<sup>2</sup> The real party in interest is the United States of America, as represented by the Department of Health and Human Services, Office of Technology Transfer.

Goodchild has filed a paper conceding priority of the subject matter of Count 2, the sole count of the interference, to Cohen. (Paper 131 at 2). Goodchild's concession of priority is construed to be a request for adverse judgment. Bd.R. 127(b)(3).

*Motion for authorization to file a request for a certificate of correction*

Cohen has filed a motion requesting to seek a certificate of correction under 35 USC § 255 in one of its involved patents, i.e., the 5,286,717 ("717") patent. (Cohen Motion 7; Paper 119). It seems that Cohen wishes to make a correction in some of the '717 claims in response to indefiniteness issues raised in an Order from the Board.<sup>3</sup> The motion was deferred to final hearing. (Paper 124 at 86).

Goodchild filed an opposition to the Cohen motion. During a conference call on 24 March 2005<sup>4</sup>, Goodchild requested that it be permitted to withdraw the opposition. Goodchild's request is GRANTED.

*Deferred motions*

Certain Goodchild motions and certain Cohen motions was deferred to final hearing. (Paper 124 at 84-85). During the conference call held on 24 March 2005,

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<sup>3</sup> In its decision on preliminary motions, the Board noted that "claims 3-6 of the '717 patent are vague and indefinite in the recitation of 'the foreign nucleic acid.' We point out that there is no proper antecedent basis for this term. Thus, it appears that these claims are unpatentable under the second paragraph of 35 U.S.C. § 112." (Paper 104 at 111).

<sup>4</sup> Participating in the call were Sally Gardner Lane, Administrative Patent Judge, Michael Sofocleous representing Goodchild, and Guy Chambers and Steven Parmelee representing Cohen.

each party requested that it be permitted to withdraw each of the deferred motions, but for Cohen motion 7, that had been filed. Under the particular circumstances of the interference, we GRANT each party's request to withdraw of its deferred motions. As these deferred motions have been withdrawn, we need not consider them further in the absence of a contested contest.<sup>5</sup>

*ORDER*

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

ORDERED that judgment on priority as to Count 2, the sole count of the interference, is entered against junior party JOHN GOODCHILD and PAUL C.

ZAMECNIK;

FURTHER ORDERED that junior party JOHN GOODCHILD and PAUL C. ZAMECNIK is not entitled to a patent containing claims 17-19, 21-25, 27, 44-46, 48-52, 54-56, 58, 61, and 64 of application 08/346,270, which claims correspond to Count 2 (Paper 125 at 3) ;

FURTHER ORDERED that the request of the parties to withdraw each of the following motions is GRANTED:

Goodchild motions 1, 2, 4, 5, and 8 (Papers 33, 34, 36, 37 and 40, respectively)

Cohen motions 3 and 4 (Papers 46 and 47, respectively).

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<sup>5</sup> In any event, the deferred Cohen motions as well as one of the deferred Goodchild motions (seeking priority benefit of an earlier filed application) are moot in view of the Goodchild concession of priority.

FURTHER ORDERED that the Goodchild request to withdraw its opposition (Paper 115) to the Cohen motion seeking to request a certificate of correction (Paper 119) is GRANTED;

FURTHER ORDERED that the Cohen motion requesting to seek a certificate of correction (Paper 119) is DISMISSED without prejudice to Cohen requesting a certificate of correction *ex parte*. 35 USC § 255; 37 CFR § 1.323;

FURTHER ORDERED that a copy of the Decision on Rehearing (Paper 124) shall be given a paper number and entered into the administrative records of Cohen patents 5,264,423, 5,276,019, and 5,286,717 and Goodchild application 08/346,270; and

FURTHER ORDERED that a copy of this judgment also shall be given a paper number and entered into the administrative records of Cohen patents 5,264,423, 5,276,019, and 5,286,717 and Goodchild application 08/346,270.

cc (via facsimile and first class mail):

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