

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 77

By: Trial Section Merits Panel
Board of Patent Appeals and Interferences
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

WEN-HWA LEE
and EVA Y-H.P. LEE

Junior Party,
(U.S. Patent 5,998,134)

v.

THADDEUS P. DRYJA,
STEPHEN FRIEND and DAVID W. YANDELL

Senior Party,
(Application 09/387,158)

Patent Interference No. 105,182

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

SPIEGEL, Administrative Patent Judge.¹

JUDGMENT - PRELIMINARY MOTIONS - Bd. R. 127

¹ As part of the Board's efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See e.g., 37 C.F.R. § 10.18.

I. Introduction

Interference 105,182 was declared on 22 September 2004 between junior party WEN-HWA LEE and EVA Y-H.P. LEE (“**Lee**”) and senior party THADDEUS P. DRYJA, STEPHEN FRIEND and DAVID W. YANDELL (“**Dryja**”). Lee is involved in the interference on the basis of U.S. Patent 5,998,134 (“the ‘134 patent”), issued 7 December 1999, based on U.S. application 08/482,627 (“the ‘627 application”). Dryja is involved in the interference on the basis of U.S. application 09/387,158 (“the ‘158 application”) filed 31 August 1999. The subject matter of the interference is defined by one count, i.e., Lee ‘134 patent claim 1 or Dryja ‘627 application claim 22, and is directed to a method of detecting a mutated retinoblastoma (“RB”) nucleic acid in a sample by using an isolated cDNA which encodes a full length, wild-type RB protein as a hybridization probe. Lee ‘134 patent claims 1-4 and Dryja ‘158 application claims 22, 23 and 49 were designated as corresponding to the count. [Paper 1.]

Among the motions filed during the motion phase of the interference was Dryja revised motion 2. Dryja revised motion 2 sought judgment that Lee ‘134 patent claims 1-4 are barred on the basis of interference estoppel or res judicata because Lee received an adverse decision in prior interferences 103,426 (“the ‘426 interference”) and 104,259 (“the ‘259 interference”) (Paper 33). Dryja revised motion 2 was **granted** for reasons set forth in the “DECISION - PRELIMINARY MOTIONS - Bd.R. 125(a)” (Paper 76) issued concurrently with this judgment and is a dispositive motion. As a result of granting Dryja revised motion 2, Lee no longer has any patentable claims corresponding to the sole count in the interference. Since Lee no longer has any

patentable claims corresponding to the sole count in the interference, it is appropriate to enter judgment at this time.

II. Order

Therefore, based on the foregoing, it is

ORDERED that judgment on priority as to Count 1 (Paper 1, p. 5) is awarded against junior party WEN-HWA LEE and EVA Y-H.P. LEE;

FURTHER ORDERED that junior party WEN-HWA LEE and EVA Y-H.P. LEE is not entitled to a patent containing claims 1-4 (corresponding to Count 1);

FURTHER ORDERED that if there is a settlement agreement and it has not already been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661; and,

FURTHER ORDERED that a copy of this judgment (Paper 77) and of the decision on motions (Paper 76) be given appropriate paper numbers and entered into the file records of U.S. Patent No. 5,998,134 and U.S. application 09/387,158.

<u>Richard Torczon</u>)	
RICHARD TORCZON)	
Administrative Patent Judge)	
)	
<u>Carol A. Spiegel</u>)	BOARD OF PATENT
CAROL A. SPIEGEL)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
<u>Sally Gardner Lane</u>)	
SALLY GARDNER LANE)	
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cc (via overnight delivery):

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