

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,434

SIRNA THERAPEUTICS, INC.
(6,183,959; 6,448,009; and 10/103,480)

Junior Party,

v.

IMMUSOL, INC.

(10/613,565),

Senior Party.

Before: SCHAFER, TORCZON, and MOORE, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION

Bd.R. 125
ON PRIORITY

INTRODUCTION

The senior party has elected not to participate in the proceeding.¹
Nevertheless, parties are presumed to have invented the interfering subject

¹ Paper 9.

matter in the order of their accorded benefit dates.² Consequently, to avoid an adverse judgment on priority, the junior party (Sirna) has filed a showing³ to antedate the senior party's accorded benefit date. As the party seeking relief, Sirna bears the burden of overcoming the presumption set in the rule.⁴ Sirna has not met its burden.

FINDINGS

Accorded benefit

[1] The senior party was accorded a constructive reduction to practice date of 23 January 1997.⁵

[2] Sirna was accorded a constructive reduction to practice date of 3 July 1997.⁶

Conception and diligence

A junior party seeking a judgment of priority may demonstrate by a preponderance of the evidence conception before the senior party's priority date coupled with reasonable diligence in reducing the invention to practice from a time just before the senior party entered the field to the junior party's own reduction to practice.⁷

² Bd.R. 207(a)(1).

³ Paper 17, Sirna Therapeutics Showing of Priority.

⁴ Bd.R. 207(a)(1); *cf.* Bd.R. 121(b) (movant bears burden of proof) and Bd.R. 202(d) & (e) (junior applicant bears burden of establishing priority *prima facie*).

⁵ Paper 1 (Declaration) at 4.

⁶ *Ibid.*

⁷ 35 U.S.C. 102(g); *Griffin v. Bertina*, 285 F.3d 1029, 1032 (Fed. Cir. 2002).

[3] Sirna contends that its inventor, James D. Thompson, presented a complete conception of the invention to an advisory board on 15 November 1996.⁸

[4] Sirna contends that "the laboratory work to reduce the invention to practice was initiated by Thompson's research associate, Timothy McKenzie, as memorialized in his laboratory notebook."⁹

[5] Dr. Thompson testifies that Exhibit 2004 is the relevant portion of McKenzie's notebook.¹⁰

[6] Dr. Thompson testifies that McKenzie started preparatory laboratory work on 21 February 1997.¹¹

[7] The first page of Exhibit 2004 is dated "2/21/97" and witnessed "9/10/97".

[8] Sirna does not point to documentation of work done before 21 February 1997.

[9] The senior party's accorded benefit date, 23 January 1997, is before 21 February 1997.

[10] Sirna argues that between the November 1996 meeting and the February 1997 start of laboratory work, "Thompson exercised diligence in securing the money, equipment and personnel needed to begin the work to reduce his invention to practice."¹²

[11] Dr. Thompson testified—¹³

⁸ Paper 17 at 4:10-12, citing Exhibit 2006 (Thompson declaration) at ¶ 4.

⁹ *Id.* at 10:5-7, citing Exhs. 2004 (notebook) and 2006.

¹⁰ Exh. 2006, ¶12.

¹¹ *Id.*, ¶13.

¹² Paper 17 at 10:3-5, citing Exh. 2006, ¶11.

¹³ Exh. 2006, ¶11. *Id.*, ¶5.

Following my presentation to the SAB in November 1996, the Advisory Board and RPI management recommended that RPI proceed with the development work for my invention. A budget for the necessary equipment, reagents and headcount for the project was created and approved. Experiments related to the invention were initiated in February 1997 as described below.

[12] Sirna provides no corroborating documentation for the post-meeting, pre-laboratory process.

[13] Sirna provides no corroborating testimony regarding the post-meeting, pre-laboratory process.¹⁴

DILIGENCE

For purposes of this diligence analysis, we shall assume that conception and initiation of laboratory work have been sufficiently shown. Even with these assumptions, Sirna has not established diligence from a period before 23 January 1997 (the senior party's priority date) to 21 February 1997 (initiation of laboratory work).

The testimony provided says that administrative work was done, but does not say when it was done. The testimony implies work was done between November 1996 and February 1997, but does not expressly state that any such work was done before 23 January 1997. Moreover, an inventor's testimony regarding his reasonable diligence must be corroborated.¹⁵ Sirna has not provided any corroborating testimony or documentation for the period from just before 23 January to 21 February 1997.

¹⁴ Exh. 2007 (McSwiggen declaration) discusses the meeting, but not subsequent developments.

¹⁵ *In re Jolley*, 308 F.3d 1317, 1328 (Fed. Cir. 2002).

It would be easy to imagine activity of Thompson and his associates that would reasonably fill the month in question. Such an imagining would, however, frustrate the presumption (and attendant burden) set in Board Rule 207(a)(1). Moreover, we could just as easily imagine activity by the senior party that might push its priority date earlier. We must decide priority on the record before us. The record before us provides facially insufficient, and insufficiently corroborated, evidence of reasonable diligence. Without reasonable diligence, the assumed earlier conception is itself insufficient.¹⁶

HOLDING

Sirna has not met its burden to establish priority before the senior party's accorded benefit date.

cc:

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¹⁶ 35 U.S.C. 102(g).