

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

Patent Interference 105,569 McK
Technology Center 1600

MARCIA DAWSON, JOSEPH A. FONTANA, XIAO-KUN ZHANG,
MARK LEID, LING JONG and PETER D. HOBBS,

Patent 7,053,071 B2,
Junior Party,

v.

SABRINA DALLAVALLE, LUCI MERLINI, CLAUDIO PISANO,
LOREDANA VESCI, GUISEPPE GIANNINI and SERGIO PENCO,

Application 10/485,530,
Senior Party.

1 *Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER*
2 *and MOORE, Administrative Patent Judges.*

3
4 *McKELVEY, Senior Administrative Patent Judge.*

5
6 **JUDGMENT**

7 **A. Introduction**

8 Despite the fact that Dawson concedes priority, numerous papers have
9 been filed in this interference.

- 10 **1.** Dawson Motion to concede priority under 37 C.F.R.
11 § 41.127(b)(3) (Paper 34).

1 indication that prior to filing the motion counsel for Dawson (Albin J.
2 Nelson, Esq. and Janet E. Embretson, Esq. of Schwegman, Lundberg,
3 Woessner & Kluth, P.A) made any attempt to contact counsel for Dallavalle
4 to determine if there might be an objection to the Board granting the relief to
5 be requested. The rules require that there be a consultation. 37 C.F.R.
6 § 41.123(b)(1). There was no consultation. *Third*, the motion seeks
7 extensions of time for Time Periods 1-3 and to produce copies of known
8 prior art. If a party is conceding priority, we can divine no reason why any
9 extension of time should be requested or granted. The motion for an
10 extension of time is *dismissed* (1) for failure to comply with the rules and
11 Standing Order and (2) as unnecessary, if not frivolous.

12 (3)

13 We next consider the Dawson communication regarding 35 U.S.C.
14 § 135(c). Paper 36. The communication states that no agreement or
15 understanding with respect to settlement or collateral agreements has been
16 negotiated or reached. We have no idea why we need to know the
17 information provided in the communication. Filing the communication was
18 a waste of the Board's time and resources and of those of Dallavalle.

19 (4)

20 The next order of business is the Dawson request for ruling regarding
21 revised post conference call order of August 30, 2007. Paper 33. The
22 request appears to ask for clarification of what might happen if Dawson files
23 a reissue application post-interference. In its opposition, Dallavalle states
24 that there is no need for a ruling regarding the post conference call order of
25 August 30, 2007. Dallavalle also notes that there is no reissue application.
26 To be sure, no reissue application is involved in the interference and there
27 has been no motion to add a reissue. We agree with Dallavalle that there is

1 no reason to address the Dawson request. Furthermore, the request is
2 actually a motion for some sort of clarification. As a motion, the request
3 fails to comply with the rules and Standing Order for all the reasons set out
4 in Paragraph (2), *supra*. We decline to further address the request.

5 (5)

6 Dallavalle "additional discovery" list sets forth some information that
7 the Examiner may consider relevant in the examination of any reissue which
8 Dawson may file. The list should be provided by Dawson to the Examiner if
9 a reissue is filed. 37 C.F.R. § 1.56. In addition, Dawson should also provide
10 to the Examiner a copy of (1) the List of Specific Compounds (Paper 21),
11 filed by Dallavalle on 05 July 2007, and (2) the Statement of Structural
12 Formulas of 071 Patent Examples 1-22 (Paper 19) filed by Dawson on
13 03 July 2007. Both the List and Statement will be of considerable use to the
14 Examiner in examining any reissue. 37 C.F.R. § 1.56.

15 (6)

16 Finally, we reach the main event of the interference, priority of
17 invention. The Dawson motion to concede priority fails to comply with the
18 Standing Order because the motion is not numbered. Standing Order 121.1
19 (Paper 2, page 29). Because granting the motion ends the interference, we
20 will overlook Dawson's failure to comply with the Standing Order.

21 But, failure to comply with the Standing Order is not the only loose
22 end with the motion. Dawson not only concedes priority, but attempts to
23 make all sorts of reservations about what will or will not happen if a reissue
24 is filed.

25 For example, Dawson does not concede priority of any and all
26 compounds of the claims of its involved Patent 7,053,071. Likewise,
27 Dawson does not concede or agree that those compounds would have been

1 obvious over the count. Dawson makes what appears to be an attempt to
2 minimize or possibly obviate the application of *In re Deckler*, 977 F.2d
3 1449, 24 USPQ 1448 (Fed. Cir. 1992) and *Ex parte Tytgat*, 225 USPQ 907
4 (Bd. App. 1985), to yet unfiled reissue claims.

5 If a reissue application is filed, the Examiner will undertake an
6 examination of that reissue application. 35 U.S.C. § 131. If in the opinion
7 of the Examiner, a rejection based on *Deckler* is appropriate, the Examiner is
8 free to make the rejection notwithstanding any attempt by Dawson in the
9 motion conceding priority to preempt action by the Examiner. 35 U.S.C.
10 § 132. When a judgment is entered in an interference, the estoppel
11 provisions of 37 C.F.R. § 41.127(a) become applicable. As the Board
12 indicated in *Kaufman v. Talieh*, Interference 105,233, Paper 23, page 2
13 (Bd. Pat. App. & Int. Nov. 19, 2004) (Exhibit 1003), reservations made in
14 concessions of priority do "not negate the effects of 37 CFR § 41.127
15 [formerly 37 CFR § 1.658(c)] regarding interference estoppel."

16 In addition to possible unpatentability under 35 U.S.C. §§ 102 and
17 103, if a claim is presented in a reissue which in the opinion of the Examiner
18 could have been presented in a Dawson reissue filed during, and added by
19 motion, to the interference, a rejection based on estoppel for failure to move
20 may also be appropriate.

21 If a reissue is filed, the Examiner is free to ignore the reservations
22 attempted to be made by Dawson in the motion conceding priority. If (1) a
23 reissue is filed and (2) a rejection is made, then Dawson can then contest the
24 rejection—but not before.

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(7)

Upon consideration of the record, it is

ORDERED that judgment on priority as to Count 1 (the sole count in the interference, Paper 1, page 7) is awarded against Junior Party Marcia Dawson, Joseph A. Fontana, Xiao-Kun Zhang, Mark Leid, Ling Jong and Peter Hobbs.

FURTHER ORDERED that Junior Party Marcia Dawson, Joseph A. Fontana, Xiao-Kun Zhang, Mark Leid, Ling Jong and Peter Hobbs is not entitled to a patent containing claims 1-10, 12-16 and 22-24 (corresponding to Count 1) of:

U.S. Patent 7,053,071 B2
issued 30 May 2006
based on application 10/308,241
filed 02 December 2002.

FURTHER ORDERED that a copy of this JUDGMENT shall be placed in the files of (1) U.S. Patent 7,053,071 B2 and (2) application 10/485,530.

<u>/ss/ Fred E. McKelvey</u>)	
FRED E. McKELVEY)	
<i>Senior Administrative Patent Judge</i>)	
)	BOARD OF
<u>/ss/ Richard E. Schafer</u>)	PATENT
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)	INTERFERENCES
<u>/ss/ James T. Moore</u>)	
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