

Trial Section Motions Panel
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Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ROBERT D. ROSENBERG,
DAVID J. KUTER, and DAVID BEELER
(5,571,686),

Junior Party,

v.

KENNETH KAUSHANSKY
(08/461,819),

Senior Party.

MAILED

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Interference No. 104,549

Before SCHAFFER, TORCZON, and GARDNER-LANE, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

JUDGMENT

(PURSUANT TO 37 CFR § 1.640)

INTRODUCTION

The parties jointly move under 37 CFR § 1.633(b) for judgment on the ground that there is no interference-in-fact (Paper No. 20). We grant the motion.

FINDINGS OF FACT

We adopt the statement of material facts in the motion (Paper No. 20 at 2-13) for the purpose of deciding this motion.

Additional facts

1. The count is:

The method of Rosenberg's claim 3 or Kaushansky's claim 5.

2. Rosenberg's claim 3 is:

3. A method according to claim 1, wherein the platelet containing preparation is whole blood.

3. Rosenberg's claim 1 is:¹

1. A method for prolonging the survival and viability of a platelet containing preparation comprising contacting the preparation with an effective amount of a megapoiectin protein, wherein the megapoiectin protein is about 31 kd as determined by SDS gel electrophoresis under reducing conditions and is about 28 kd under nonreducing conditions, said protein being capable of: i) stimulating an increase in the megakaryocyte size, number and ploidy as well as production of platelets therefrom; and ii) binding to platelets *in vitro* or *in vivo*.

4. Kaushansky's claim 5 is:

5. A method for stimulating *in vitro* erythropoiesis comprising culturing bone marrow or peripheral blood cells with a composition comprising an amount of a mammalian thrombopoietin protein (TPO) of at least 323 amino acid residues selected from the group consisting of:

(a) a protein comprising the sequence of amino acids of SEQ ID NO:4 from amino acid residue 45 to amino acid residue 379; and

¹ As corrected: USPTO, 1240 Off. Gaz. 15 (7 Nov. 2000).

(b) species homologs of (a), sufficient to produce an increase in the number of erythrocytes or erythrocyte precursors as compared to [a] cell cultured in the absence of TPO.

5. The examiner found (Form PTO-850, attached stmt. at 1) that Rosenberg's megapoietin protein,

although not characterized by amino acid sequence, is consistent with [Kaushansky's] TPO by virtue of having the same biological activity (stimulation of platelet production by megakaryocytes and binding to platelets) and sources (plasma from thrombocytopenic animals), as well as the molecular weight of 31,000 Daltons under reducing conditions.

6. The examiner further found (id. at 2) that Rosenberg's megapoietin protein inherently stimulates erythropoiesis.

7. The examiner's reasoning regarding activity is based on the finding that binding to the c-mpl receptor would necessarily cause the result (id.).

DISCUSSION

A preponderance of the evidence of record establishes that Rosenberg's megapoietin protein and Kaushansky's TPO are not the same protein and do not share the same receptor. Specifically, Rosenberg's megapoietin protein must be about 31 kd in reducing conditions and about 28 kd under non-reducing conditions (claim 1). Kaushansky's TPO appears to be appreciably larger (e.g., Exh. 1001, ¶¶9-17). Moreover, while the examiner found that both proteins bind to the c-mpl receptor, Rosenberg's disclosure indicates that megapoietin binds to an "MP" receptor on platelets that is much less common than "the receptor for MPL" (Exh. 1005 at 32:10-20). Since the assumption underlying the interference, that

megapoietin and TPO are the same protein acting on the same receptor, is not supported by the evidence of record, there is no basis for an interference-in-fact.

We need not reach the argument about the effect of megapoietin on erythropoiesis to decide the motion. Moreover, the data presented in support of the motion (Paper No. 20 at ¶25) is inconclusive at best since the Rosenberg examples terminate before the Kaushansky example starts to show results (2 & 4 days vs. 6 days).

CAVEATS

The record does not include a sequence for Rosenberg's megapoietin protein. A close sequence similarity between megapoietin and TPO would be highly material. The fact that neither party has produced such a sequence is understood to mean that, to the best of the party's knowledge, the protein sequences are dissimilar.

Similarly, the record does not include evidence showing comparative experimental SDS-electrophoresis results for TPO. Instead, the record contains testimony that such experiments, if run, would show a significant size difference between megapoietin and TPO (e.g., Exh. 1001, ¶9). If a gel did not show a significant difference, that fact would be highly material. The fact that neither party has produced such experimental electrophoresis results is understood to mean that, to the best of each party's knowledge, any actual results would confirm a difference at least as large as the difference presented in testimony.

ORDER

Upon consideration of the record of this interference, it is—

ORDERED that, there being no interference-in-fact, there is no proper count;

FURTHER ORDERED that judgment is awarded to both parties;

FURTHER ORDERED that, based on the record before us, junior party Rosenberg is entitled to a patent containing claims 1-3 of its 5,571,686 patent, which corresponded to the count;

FURTHER ORDERED that, based on the record before us, senior party Kaushansky is entitled to a patent containing claims 1, 2, 5, and 6 of its 08/461,819 application, which corresponded to the count;

FURTHER ORDERED that the preliminary motions and statements period is terminated;

FURTHER ORDERED that no preliminary statements or further preliminary motions may be filed; and

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative record of Rosenberg's 5,571,686 patent and Kaushansky's 08/461,819 application.


RICHARD E. SCHAFER
Administrative Patent Judge


RICHARD TORCZON
Administrative Patent Judge


SALLY GARDNER-LANE
Administrative Patent Judge

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