

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 46

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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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BRIAN L. GOODALL, SAIKUMAR JAYARAMAN,  
ROBERT A. SHICK, LARRY F. RHODES  
Junior Party  
(Patent 6,136,499 and U.S. Application No. 10/079,218<sup>1</sup>),

v.

MITSUHITO SUWA, TORU KAJITA,  
SHIN-ICHIRO IWANAGA, TOSHIYUKI OTA  
Senior Party,  
(Application 08/797,620).

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Patent Interference No. 104,703

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Before: SPIEGEL, TIERNEY and NAGUMO, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

**FINAL JUDGMENT**  
(Decision on Preliminary Motions)

This interference is before a merits panel for a decision on preliminary motions. As evident from the discussion below, no oral hearing on the merits was required.

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<sup>1</sup>The caption for this interference has been changed to reflect the addition of Goodall's U.S. Application 10/079,218 to the interference.

I. Summary of the Opinion

The parties have agreed to settle this interference. (Submission of Settlement Agreement, Paper No. 40). In settling the interference, however, the parties have filed several preliminary motions requesting that the interference be redefined. Specifically, the parties have filed motions requesting that the count and claim correspondence be modified (Suwa Preliminary Motions 1 and 4, Goodall Preliminary Motion 2), requested priority benefit (Suwa Preliminary Motion 5) and requested the addition of new claims and an application to the interference (Suwa Preliminary Motions 2 and 3 and Goodall Preliminary Motion 1). All of the motions filed in this interference are unopposed. Contingent upon the grant of these motions, Suwa has requested adverse judgment as to proposed Count A. (Paper No. 37 and Suwa Preliminary Motion 1, Paper No. 31). Also, contingent upon the grant of these motions, Goodall has requested adverse judgment as to the two other proposed Counts B and C. (Goodall Response 1, Paper No. 39).

Based on the evidence presented and the reasoning provided, we grant the parties' motions. Priority of invention is awarded against Suwa for Count A and against Goodall as to Counts B and C.

II. Findings of Fact

A. Real Parties in Interest

1. Junior Party

F1. Goodall's U.S. Patent No. 6,136,499 ("499") is said to have been assigned to Sumitomo Bakelite Co., Ltd. (Goodall's Notice of Change of Real Party in Interest, Paper No. 18).

2. Senior Party

F2. Suwa's U.S. 08/797,620 application ("620") is said to have been assigned to JSR Corporation. (Notice of Real Party in Interest, Paper No. 5).

B. Accorded Priority Benefit

1. Junior Party

F3. Goodall's involved '499 patent issued on October 24, 2000, from U.S. Application No. 08/812,418, filed March 6, 1997. Solely for the purpose of priority, Goodall has been accorded benefit of U.S. Provisional Application 60/025,174, filed March 7, 1996. (Notice Declaring Interference, Paper No. 1, p. 3).

2. Senior Party

F4. Suwa's involved '620 application was filed February 7, 1997. Solely for the purpose of priority, Suwa '620 application has been accorded benefit of the filing dates of:

- i. JP 8-46930, filed February 9, 1996
- ii. JP 8-227344, filed August 12, 1996
- iii. JP 8-352621, filed December 16, 1996

(Notice Declaring Interference, Paper No. 1, p. 4).

C. The Count and Claim Correspondence

A primary concern reflected in the parties' motions is the scope of the count in interference and the claim correspondence. The count and claim correspondence coming into this decision is provided below.

F5. Count 1, the sole count in interference prior to this decision, read as follows:

A composition according to any one of claims 1, 4, 6, 7 and 12 of U.S. Patent 6,136,499

or

A composition according to claim 2 of U.S. Application 08/797,620

F6. At the time of declaration, the parties' claims were as follows:

Goodall, U.S. Patent No. 6,136,499:	1-12
Suwa, U.S. Application 08/797,620:	2-22

F7. The claims of the parties which corresponded to Count 1 were:

Goodall, U.S. Patent No. 6,136,499:	1-12
Suwa, U.S. Application 08/797,620:	2-22

F8. The claims of the parties which **did not** correspond to Count 1, and therefore were not involved in the interference, were:

Goodall, U.S. Patent No. 6,136,499:	None
Suwa, U.S. Application 08/797,620:	None

D. Person of Ordinary Skill in the Art

F9. Generally, the technology involved in this interference relates to polymer chemistry and more particularly, the field of photolithography and photoresist development. The knowledge that one skilled in this art would possess is demonstrated by the prior art submitted as evidence, e.g., Goodall U.S. Patent No. 5,569,730 (SX 1003).

1. Testimony of Toru Kajita

F10. Suwa has submitted two declarations by Toru Kajita, a named inventor of Suwa's involved '620 application. (Declarations of Toru Kajita, SX 1004 and SX 1018).

F11. According to Suwa, Mr. Kajita received his Bachelor of Science degree from Kyoto University in 1986. Mr. Kajita is said to have received his Masters Degree in 1988 from Kyoto University's Department of Synthetic Chemistry. (Suwa Submission, Paper No. 45).

F12. Mr. Kajita began work at JSR Company, Ltd. in 1988. Mr. Kajita is said to have more than ten years experience in the field of research and development of photoresist polymer materials, including photoresists for semiconductor fabrication at JSR Company, Ltd. Mr. Kajita is said to hold the title of Manager, Research and Development Department at JSR. (Paper No. 45).

F13. Given Mr. Kajita's background, we conclude that he is qualified to testify as to the knowledge of one skilled in the art in the field of photolithography and photoresist development.

2. Testimony of John Sturtevant

F14. Suwa has submitted a declaration of a Mr. John Sturtevant. (SX 1005). In the declaration, Mr. Sturtevant testifies that he has a Ph.D. in Physical Chemistry and is presently the Manager of Photolithography Research and Development at Integrated Device Technology. Of note, Mr. Sturtevant has been the Co-Chairman of the SPIE Microlithography Symposium of the Advances in Photoresist Technology Conference since 1996. Further, Mr. Sturtevant states that he has published extensively in the area of polymer physics and polymer chemistry, particularly with respect to photoresist compositions. (SX 1005, ¶1).

F15. Given Mr. Sturtevant's background, we conclude that he is qualified to testify as to the knowledge of one skilled in the art in the field of photolithography and photoresist development.

3. Testimony of Andrew Bell

F16. The parties have submitted testimony from a Mr. Andrew Bell. Mr. Bell is said to have received a Ph.D. in Organometallic Chemistry from Purdue University in 1985. Mr. Bell performed research and development in the area of polycyclic olefin polymerization chemistry for Hercules, Incorporated during the years of 1987 to 1994. From 1994 to 2000, Mr. Bell performed research and development in the area of polycyclic olefin polymerization chemistry with a focus on nickel and palladium addition of polycyclic olefins for the B.F. Goodrich

Company. Furthermore, Mr. Bell is said to have directed the development of new catalysts and commercialization efforts involving ruthenium alkylidene derivatives and norbornene- and dicyclopentadiene-based polymers from 2000 to April 2001 for Cymetech, LLC. (GX 2005, ¶1).

F17. Mr. Bell is said to be an inventor or coinventor of 17 U.S. patents and international patent applications covering a wide range of subject matter in the fields of polymer science and catalysis. (GX 2005, ¶1).

F18. Given Mr. Bell's background, we conclude that he is qualified to testify as to the knowledge of one skilled in the art in the field of polymer science and catalysis.

### III. Opinion

#### A. Suwa Preliminary Motion 1: Substitute Proposed Counts

Suwa Preliminary Motion 1 requests that the interference be redefined by substituting two new counts for the existing count and adding a third new count to the interference. (Paper No. 31, p. 2). Goodall does not oppose this motion. Indeed, Goodall has filed a response requesting the Suwa Preliminary Motion 1 be granted. (Goodall Response 1, Paper No. 39, p. 2).

There are three new proposed counts, A, B and C. Generally, the subject matter of the new counts is as follows:

Count A: Polymers ("AD") formed by an addition polymerization reaction.

Count B: Polymers ("ROMP") formed by a ring opening metathesis polymerization.

Count C: Polymers (“MA”) having repeat units polymerized from maleic anhydride. (See Paper No. 31, Attachments A-C, Paper No. 39, p. 3, ¶ 5). According to both Suwa and Goodall the three polymers, “AD”, “ROMP” and “MA” have distinct structures and characteristics and define separate patentable inventions from each other. (Paper No. 39, p. 8).

When there are two or more counts in an interference, each count shall define a separately patentable invention. 37 CFR 1.601(f). Accordingly, a party moving to redefine the interfering subject matter must show that each proposed count defines a *separate patentable invention* from every other count proposed to remain in the interference. (See 37 C.F.R. § 1.637(c)(1)(v), emphasis added). A separate patentable invention is defined in 37 C.F.R. § 1.601(n) which states that:

Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

37 CFR § 1.601(n)(emphasis in original). Accordingly, in reviewing the three proposed counts for separate patentability, we focus on the patentable distinctiveness of the three counts with respect to each other.

1. The Three Proposed Counts are Separately Patentable from Each Other
  - a. Differences Between ROMP and AD Polymers

Suwa alleges that ROMP polymers and AD polymers have different alicyclic repeating

units in the polymer backbone. In contrast to AD polymers, as synthesized, Suwa states that ROMP polymers have unsaturated polymer backbones. As a result, ROMP and AD polymers are said to exhibit significantly different physical properties, including glass transition temperatures and thermal stability. (Paper No. 31, ¶ 21).<sup>2</sup>

Mr. Sturtevant testifies that significant differences in glass transition temperature and thermal stability between AD and ROMP polymers would have a significant influence on resist characteristics and could ultimately affect the resolutions that can be achieved using the photoresist. (SX 1005, ¶4). Mr. Sturtevant's testimony on this point is consistent with the written description provided in the Goodall et al., U.S. 5,569,730 patent ("‘730," SX 1003). For example, the ‘730 patent states that "[t]he differences in the structure of ROMP and addition polymers of NB type monomers is evidenced in their properties, e.g., thermal properties." (SX 1003, col. 2, lines 7-9). Based on Mr. Sturtevant testimony and the statements provided in the ‘730 patent, we conclude that Suwa has demonstrated that the Count A AD polymers and the Count B ROMP polymers are patentably distinct inventions.

b. Differences Between MA Polymers and AD and ROMP Polymers

Suwa argues that Count C (MA Copolymer) is a separately patentable invention from Count B (ROMP polymer). According to Suwa, there are structural differences between the two classes of polymers which patentably distinguish them from one another. Specifically, ROMP

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<sup>2</sup> We note that:

A ROMP polymer has a different structure than that of an addition polymer. A ROMP polymer contains a repeat unit with one less cyclic unit than did the starting monomer. (SX 1001, col. 13, lines 50-52).

polymerization is said to proceed by a ring opening mechanism as opposed to the free radical or addition polymerization techniques used to produce MA copolymers. As a result, the claimed MA copolymers possess a different alicyclic repeating unit in the polymer backbone. Further, the claimed MA and ROMP polymer based photoresists are said to differ structurally due to the presence of a repeating unit polymerized from maleic anhydride in the polymer backbone. (Suwa Preliminary Motion 1, Paper No. 31, p. 19).

Additionally, Suwa argues that Count C (MA Copolymer) defines a separately patentable invention from Count A (AD polymer). Suwa notes that Count C is directed to resist compositions comprising a polymer having an alicyclic skeleton comprising an acid labile substituted alicyclic repeating unit *and* a repeating unit derived from maleic anhydride. As such, Suwa states that the MA copolymer count is a sub-genus of the AD polymer count. (Paper No. 31, p. 20).

According to Kajita, as a result of the differences in the polymer structure of the MA copolymers, the MA copolymer based resists will generally have superior resist properties as compared to AD and ROMP polymer based resists. Kajita testifies that MA copolymer based resists have superior swelling behavior and PAG solubility which can influence the resolution of the images formed on the resist. (Second Declaration of Toru Kajita, SX 1004, ¶42).

Kajita has cited an article by Ito et al., "Dissolution/Swelling Behavior of Cycloolefin Polymers in Aqueous Base," *Advances in Resist Technology and Processing XVII*, Proceedings of SPIE Vol. 3999, pp. 2-12 (2000) (hereinafter "the Ito publication"). Based upon the swelling/dissolution behavior described in the Ito publication, Kajita testifies that significantly

higher resolutions can be attained using photoresist compositions comprising MA copolymers compared to resists comprising AD polymers. (SX 1004, ¶59).

Kajita has also cited an article by Opitz et al., entitled “Polymer Platform Dependent Characteristics of 193 nm Photoresists,” Proceedings of the SPIE Conference on Advances in Resist Technology and Processing XVI, SPIE Vol. 3678, March 1999 (hereinafter “the Opitz publication”). Kajita testifies that the Opitz article describes an MA polymer that displays a relatively constant PAG concentration throughout the film thickness whereas the AD polymer film is significantly more variable. According to the testimony of both Kajita and Sturtevant, a more uniform thickness distribution of photo-acid generator in the photoresist film would allow for the development of more uniform profiles resulting in substantial improvements in resolution and imaging performance. (SX, 1004, ¶65; SX1005, ¶ 8).

Kajita further testified that MA copolymer based resists generally have superior resist properties compared to both AD and ROMP polymer based resists. Indeed, Kajita cites a photoresist evaluation conducted at his direction and/or under his control. Kajita states that this evaluation demonstrated that improved resolution can be achieved using MA copolymer based photoresists compared to alicyclic polymer based photoresists. (SX, 1004, ¶¶65-71).

Based upon the evidence presented, we conclude that Suwa has demonstrated that the Count C MA polymers are a separate patentable invention from the Count A AD polymers as well as separately patentable from the Count B ROMP polymers. Accordingly, we **grant** Suwa’s request to substitute new Counts A, B and C for Count 1.

B. Suwa Preliminary Motion 2

Suwa Preliminary Motion 2 requests that the interfering subject matter be redefined under Rule 633(c)(2) by adding new claim 23 to the involved Suwa '620 application. (Suwa Preliminary Motion 2, Paper No. 32, p. 2). Suwa's request is not opposed by Goodall.

Suwa new claim 23 is directed to a MA polymer. Suwa claim 23 is the same patentable invention as new Count C as Count C anticipates Suwa claim 23. (Paper No. 32, p. 5).

Suwa has demonstrated that the '620 application provides written descriptive support for the claimed MA polymer. (Suwa Preliminary Motion 1, Paper No. 31, Appendix, p. 9; Paper No. 32, p. 3, ¶¶ 5-7 and Appendix). The '620 application also enables one of ordinary skill in the art to make and use the claimed MA polymer. (Paper No. 32, p. 3, ¶¶ 5-7 and p. 6). Furthermore, Suwa has affirmatively stated that "there is no teaching or suggestion in the prior art of a radiation sensitive resist composition as set forth in proposed Claim 23." (Paper No. 32, p. 6). Based on the facts presented, Suwa Preliminary Motion 2 is *granted*.

C. Suwa Preliminary Motion 3

Suwa Preliminary Motion 3 requests that the interfering subject matter be redefined under Rule 633(c)(2) by adding new claims 24-41 to the involved Suwa '620 application. (Suwa Preliminary Motion 3, Paper No. 33, p. 1). Suwa's request is not opposed by Goodall.

Suwa new claims 24-41 are directed to a ROMP polymer. Suwa claims 24-41 define the same patentable invention as new "ROMP" Count B as Count B anticipates and/or renders obvious Suwa claim 24-41. (Paper No. 32, p. 3).

Suwa has demonstrated that the '620 application provides written descriptive support for the ROMP polymer of new claims 24-41. (Suwa Preliminary Motion 1, Paper No. 31, Appendix, pages 10-19; Paper No. 33, pages 7-16). Furthermore, Suwa has noted that new claim 24 defines subject matter that is encompassed by claim 2, which was determined to be patentable over the prior art of record by an examiner. Suwa states that claims 25-41 depend from claim 24 and likewise would be patentable over the prior art of record. (Paper No. 33, p. 4). Based on the facts presented, Suwa Preliminary Motion 3 is *granted*.

D. Suwa Preliminary Motion 4

Suwa claim 18 is directed to a radiation-sensitive resin composition, wherein the amount of the residual halogen contained in the resin is 3 ppm or less, and the amount of the residual metal contained therein is 300 ppb or less. Suwa Preliminary Motion 4 moves to have Suwa claim 18 designated as *not* corresponding to any count in the interference. (Suwa Preliminary Motion 4, Paper No. 34, p. 1). Goodall does not oppose.

Generally, Suwa alleges that Suwa claim 18 does not define the same patentable invention as any other Goodall claim. (Paper No. 34, p. 4). According to Suwa, alicyclic polymer photoresists can have metal contents well in excess of the limits recited in Suwa claim 18. (Paper No. 34, p. 5). For example, under Kajita's direction and/or control, an evaluation was conducted regarding alicyclic polymers polymerized using transition metal catalysts as described in Goodall's involved '499 patent. According to Kajita, the AD polymer evaluated had a metal content of almost 8000 ppb prior to washing and filtering. (SX 1004, ¶37). Further, Kajita

testified that, even after washing and filtering, the metal content still exceeded 3600 ppb. (SX 1004, ¶38).

Sturtevant has testified that higher levels of metallic contamination on the semiconductor substrate would result in significantly higher semiconductor device defect and failure rates. (SX 1005, ¶14). Sturtevant also testifies that it is his opinion that the significantly reduced metal content of the resists as defined in Suwa claim 18 would allow for the manufacture of semiconductor devices with reduced defect rates and improved device performance. (SX 1005, ¶15).

Based upon the evidence presented, we conclude that Suwa has demonstrated that Suwa claim 18 does not define the same patentable invention as any corresponding Goodall claim. Accordingly, we *grant* Suwa's request to have Suwa claim 18 designated as *not* corresponding to any of the counts in the interference.

E. Suwa Preliminary Motion 5

Suwa Preliminary Motion 5 moves to be accorded an earlier priority benefit date for the ROMP polymer Count B and the MA copolymer Count C. Specifically, for Count B, Suwa requests priority benefit of JP Application No. 8-227344 (“344”), filed August 12, 1996. For Count C, Suwa requests benefit of JP Application No. 8-046930 (“930”), filed February 9, 1996. (Suwa Preliminary Motion 5, Paper No. 35, p. 1). Goodall does not oppose Suwa's requested priority benefit.

For an earlier-filed application to serve as constructive reduction to practice, “the

applicant must describe the subject matter of the count in terms that establish that he was in possession of the later-claimed invention, including all of the elements and limitations presented in the count, at the time of the earlier filing.” *Hyatt v. Boone*, 146 F.3d 1348, 1353-54, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). Moreover, “it is insufficient as written description, for purposes of establishing priority of invention, to provide a specification that does not unambiguously describe all limitations of the count.” *Id.*

1. Priority Benefit for Count B ROMP Polymer

Suwa has demonstrated that the ‘930 application discloses a radiation sensitive composition comprising a ROMP polymer resin (SX 1022, p. 1, claim 1). Additionally, Suwa has demonstrated that the ‘930 application discloses a radiation sensitive acid generating agent. (SX 1022, p. 21, paragraph [0027]). Furthermore, the ‘930 application teaches a method of making the radiation sensitive resist composition and a method of forming a resist pattern using the composition. (SX 1022, p. 22, paragraph [0028] and p. 23, paragraph [0029]). Based on the facts presented, Suwa’s request for priority benefit of the ‘930 filing date of February 9, 1996 for Count B is *granted*.

2. Priority Benefit of Count C “MA” Copolymer

Suwa has demonstrated that the ‘344 application provides a description of “a method comprising radical copolymerizing at least one norbornene derivative (a) and at least one copolymerizable unsaturated compound such as ethylene or maleic acid anhydride.” (SX 1020,

paragraph [0015], item (b)). Furthermore, the '344 application teaches the synthesis of a copolymer of a methoxy carbonyl substituted alicyclic monomer and maleic anhydride. (SX 1020, paragraph [0083]). Accordingly, based on the facts presented, Suwa's request for priority benefit of the '344 filing date of August 12, 1996 for Count C is *granted*.

F. Goodall Preliminary Motion 1

Goodall requests that Goodall's U.S. Application No. 10/079,218 ("218"), filed on February 19, 2002 be added to the interference. Goodall also requests that claim 47 of the '218 application be designated as corresponding to the MA copolymer Count C.

According to Goodall, no pending or patented Goodall claim is specifically directed to the subject matter of Count C. (Goodall Preliminary Motion 1, Paper No. 29, p. 6). As amended, Goodall's '218 application contains a claim 47 that is said to correspond to Count C. Specifically, Goodall states that Goodall claim 47 is patentably indistinct from Count C. (Paper No. 29, pages 8-10). According to Goodall, to fully adjudicate the priority of the inventions defined by Counts A, B and C, it is necessary, inter alia, that Goodall claim 47 be added to the interference. (Paper No. 29, pages 6-7).

Suwa has joined in Goodall's Preliminary Motion 1. Specifically, Suwa states that by adding the Goodall '218 application and Goodall claim 47 to the interference as corresponding to Count C, the goals expressed in 37 C.F.R. §1.601, et. seq. are met, by contesting in a single interference, all subject matter disclosed and patentable to Goodall and Suwa in the involved cases. (Suwa Response 1, Paper No. 38).

As noted above, contingent upon the grant of the various preliminary motions, Goodall has requested adverse judgment as to proposed Counts B and C. (Goodall Response 1, Paper No. 39). To obviate a future interference between Goodall and Suwa arising from their involved specifications description of MA copolymers, we **grant** Goodall Preliminary Motion 1.

G. Goodall Preliminary Motion 2

Goodall moves to have Goodall claims 2, 4, 5 and 7-11 designated as not corresponding to any existing or proposed count in this interference. (Goodall Preliminary Motion 2, Paper No. 44). According to Goodall, Goodall claims 2, 4, 5 and 7-11 are directed to a separate patentable invention from Counts A, B and C. Suwa does not dispute this allegation. (Paper No. 44, p. 11).

Goodall states that Goodall claims 2, 4 and 5 are directed to polymer compositions containing a polymer formed by addition polymerization wherein the polymer has a pendant perfluorophenyl group on at least one terminal end. (Paper No. 44, p. 6, ¶ 9). Goodall argues that none of Count A, B or C recites an addition polymer having a pendant perfluorophenyl group on at least one terminal end. According to Goodall, the presence of the pendant perfluorophenyl group on at least one terminal end is an indication that the polymer has been formed in the presence of the nickel-based catalyst  $E_nNi(C_6F_5)_2$  (where E represents a neutral 2 electron ligand donor and  $C_6F_5$  represents perfluorophenyl) or in the presence of a catalyst formed from the combination nickel ethylhexanoate, tris(perfluorophenyl)boron and triethylaluminum. (Paper No. 44, pages 11-12).

Goodall states that claims 7-11 claim a radiation sensitive composition having polymers formed by addition polymerization in the presence of a single or multicomponent catalyst system. (Paper No. 44, p. 7, ¶ 14). Goodall argues that these claims are patentably distinct from Counts A, B and C as Goodall claims 7-11 recite specific methods of polymerization and catalysts that are not recited in Counts A, B and C and are not taught or suggested by the prior art. (Paper No. 44, p. 7, ¶ 15).

Goodall states that the multi-component catalysts of the prior art Goodall '730 patent would not generate a radiation sensitive polymer. (Paper No. 44, p. 8, ¶ 19). Further, Goodall alleges that Suwa's involved '620 application does not claim, teach or suggest the single or multicomponent catalyst systems as well as the specific methods of polymerization recited in Goodall claims 7-11. (Paper No. 44, p. 8, ¶ 20).

Mr. Andrew Bell has testified that it would not be obvious to form the addition polymers having a pendant acid labile group as recited in Goodall claims 2, 4, 5 and 7-11 from norbornene-functional monomers in view of the catalysts employed in the '730 patent, alone or further in view of the '620 application. (GX 2005, ¶ 13). Specifically, Mr. Bell states that there is no teaching or suggestion in the '730 patent of using the disclosed catalysts with norbornene monomers bearing acid labile groups to form a radiation sensitive polymer. (GX 2005, ¶ 13). Mr. Bell also testifies that there is no teaching or suggestion in the '620 claims for using addition polymerization catalysts, such as those disclosed in the '730 patent, to prepare a radiation-sensitive resin composition. (GX 2005, ¶ 13). Moreover, Mr. Bell testifies that he is of the belief that even if the teachings of Suwa's involved '620 application were combined with the

teachings of the '730 patent, the resulting polymer would be different from that of Goodall claims 2, 4, 5 and 7-11. (GX 2005, ¶ 15).

As mentioned above, Suwa does not oppose Goodall's request to have claims 2, 4, 5 and 7-11 designated as *not* corresponding to Counts A, B, and C. On this record, Goodall has submitted sufficient evidence demonstrating that these claims are patentably distinct from Counts A, B, and C. Thus, we **grant** Goodall Preliminary Motion 2.

#### H. Claim Correspondence

At the beginning of the interference, Suwa's '620 application had claims 2 through 22 pending. As discussed below, Suwa has requested to add claims 23 through 41 to the '620 application. Suwa's request has been granted. As such, Suwa's '620 application contains claims 2 through 41.

Goodall's involved '499 patent contains claims 1 through 12. Goodall has requested the addition of Goodall U.S. Application 10/079,218 ("218") to the interference. Independent claim 47 is the only pending claim in Goodall '218. As discussed above, Goodall's request to add the '218 application to the interference has been granted.

After evaluating the parties respective preliminary motions, the parties' claims are as follows:

Suwa '620:	2-41
Goodall '499:	1-12
Goodall '218:	47

1. Suwa's Claim Correspondence

Suwa Preliminary Motion 1 proposes the following claim correspondence for Suwa's claims:

Count A ("AD"): 2-4, 16, 17 and 19-22  
Count B ("ROMP"): 2-17, 19-20 and 24-41  
Count C ("MA"): 23

(Paper No. 31, pages 13-14). Goodall has argued in support of Suwa's proposed claim correspondence. (Goodall Response 1, Paper No. 39, ¶¶6-8). As we are not aware of any error in Suwa's proposed claim correspondence for Suwa's claims, we adopt Suwa's proposed claim correspondence for Suwa's claims.

2. Goodall Claim Correspondence

Suwa Preliminary Motion 1 proposes the following claim correspondence for the claims of Goodall's '499 patent:

Count A ("AD"): 1, 3 and 12  
Count B ("ROMP"): 6

(Paper No. 31, p. 16). Further, Suwa states that claims 2, 4, 5 and 7-11 of Goodall '499 do not correspond to any proposed count. (Paper No. 31, p. 16). Goodall concurs. (Paper No. 39, pages 9-12).

Goodall has requested the addition of the '218 application to the interference. Further, Goodall has proposed the following claim correspondence for the claim of the '218 application:

Count C ("MA"): 47

(Goodall Preliminary Motion 1, Paper No. 29, p. 1).

For purposes of resolving the issues in this interference we adopt the parties' proposed Goodall claim correspondence.

IV. Order

**ORDERED** that Suwa Preliminary Motion 1 to substitute proposed Counts A, B and C for Count 1 is granted.

**FURTHER ORDERED** that Suwa Preliminary Motion 2 to add new claim 23 to the involved Suwa '620 application is granted.

**FURTHER ORDERED** that Suwa Preliminary Motion 3 to add new claims 24-41 to the involved Suwa '620 application is granted.

**FURTHER ORDERED** that Suwa Preliminary Motion 4 to have Suwa claim 18 designated as *not* corresponding to any count in the interference is granted.

**FURTHER ORDERED** that Suwa Preliminary Motion 5 for priority benefit is granted.

**FURTHER ORDERED** that Goodall Preliminary Motion 1 to add Goodall's U.S. Application No. 10/079,218 ("218"), filed on February 19, 2002 be added to the interference. and that claim 47 of the '218 application be designated as corresponding to the MA copolymer Count C is granted.

**FURTHER ORDERED** that Goodall Preliminary Motion 2 to have Goodall claims 2, 4, 5 and 7-11 designated as not corresponding to Counts A, B and C is granted.

**FURTHER ORDERED** priority of invention is awarded against Suwa for Count A and against Goodall as to Counts B and C.



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