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

ANDREW P. **LAUDANO**
and DAVID F. STERN
(08/146,235),

Junior Party,

v.

DANA-FARBER CANCER INSTITUTE, INC.
(Richard J. Epstein and Charles D. Stiles)
(5,599,681),

Senior Party.

Interference No. 104,717

Before SCHAFER, TORCZON, and SPIEGEL, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

JUDGMENT
(Pursuant to 37 CFR § 1.662(a))

INTRODUCTION

The parties have filed a Joint Request (Paper 29) seeking termination of the interference with judgment against Dana-Farber Cancer Institute, Inc. (DFCI) with respect to counts 3 and 5, and against Laudano with respect to counts 4, 6, and 7. Counts 3 and 5 are not counts in this interference. Consequently, the Board cannot offer the precise relief requested. Nonetheless, this judgment has the essentially same legal effect that granting the request would have had.

FACTS

The following facts are supported by at least a preponderance of the evidence:

[1] There are three counts in the interference, counts 4, 6, and 7:

> Count 4: Isolated antibody that specifically binds to a reversible tyrosine phosphorylation site of a reversibly phosphorylated protein in its phosphorylated isoform and does not bind to the non-phosphorylated isoform of said protein, nor to proteins other than said protein.
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> Count 6: Isolated antibody that specifically binds to a reversible phosphorylation site of the c-erbB-2 receptor in its active form and does not bind to the inactive form of said c-erbB-2 receptor, nor to proteins other than said c-erbB-2 receptor.
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> Count 7: Isolated antibody that specifically binds to a reversible serine or threonine phosphorylation site of a reversibly phosphorylated protein in its phosphorylated isoform and does not bind to the non-phosphorylated isoform of said protein, nor to proteins other than said protein.

[2] The claims corresponding to these counts[1] are:

	Total claims	**Count 4**	**Count 6**	**Count 7**	**Not involved**
Laudano	38-44 and 47-69	38, 39, 47-53, 59-64, 66, 67, and 69	38-41, 47-55, and 59-69	42, 43, 47, 51, 56, and 57	44 and 58
DFCI	1-33	1-6, 8, 10-12, 14, 18, 20-28, and 30-32	1-6, 8, 10, 13, 14, 16-18, 20-28, 30 and 33	1, 7, 9, and 29	15 and 19

[3] The parties also refer to two non-existent counts, counts 3 and 5, for purposes of illustration, but acknowledge that these counts are not really counts in this interference (Paper 27 at Fact 1 and n.1):

> Count 3: Isolated antiphosphopeptide antibodies that specifically bind to a protein containing said phosphopeptide, but not specific for the corresponding

[1] A claim can correspond to more than one count if the claim is broad enough to have been anticipated or rendered obvious by the separate inventions described in more than one count.

non-phosphorylated peptide, or a protein containing said non-phosphorylated peptide, or for the phosphoamino acid of said peptide.

Count 5: Isolated antibody that specifically binds to a reversible phosphorylation site of the c-erbB-2 receptor in its active form but [is] not specific for the inactive form of said c-erbB-2 receptor, or for the phosphoamino acid of said peptide.

[4] According to the parties, the following claims correspond to illustrative counts 3 and 4 (Paper 29, App. A):

	Count 3	**Count 5**
Laudano	38-43, 47-57, 60-62, and 67-69	40, 41, 54, 55, 59, 68, and 69
DFCI	None	None

[5] According to the parties, illustrative count 3 is generic to the other (actual and illustrative) counts and illustrative count 5 is generic to count 6 (Paper 29, App. A).

[6] According to the parties, Laudano reduced to practice a species within the scope of counts 3 and 5--but not within the scope of counts 4, 6, or 7--prior to DFCI's earliest reduction to practice of a species within the scope of count 4, 6, or 7. On the basis of these different priority proofs, Laudano concedes priority for counts 4, 6, and 7 and DFCI concedes priority for illustrative counts 3 and 5 (Paper 29 at 5).

[7] The parties would like the effect of these concessions to be that DFCI is entitled to all of its involved claims and Laudano would be entitled to its generic claims and its species claims corresponding to illustrative count 5, but not for its species claims corresponding counts 4, 6, or 7 (Paper 29 at 2).

[8] According to the Joint Request, Laudano should be entitled to its claims 38-43, 47-57, 60-62, and 67-69 (with respect to illustrative count 3) and claims 40, 41, 54, 55, 59, 68 and 69 (with respect to illustrative count 5) (Paper 29 at 2).[2]

DISCUSSION

The requested relief is not possible

The fundamental problem with the approach the parties have proposed is that the generic counts, illustrative counts 3 and 5, are not really counts at all. A count defines the scope of proofs admissible to prove priority for the interfering subject matter. Only Laudano has claims corresponding to illustrative counts 3 and 5, hence there is no real interference for the subject matter of the illustrative counts. The Board cannot grant judgment with regard to counts that are not really counts.

What the Board can do, based on the representations of the parties, is grant judgment against Laudano on the actual counts, counts 4, 6, and 7. There is no way to sugarcoat this outcome: Laudano has lost this interference.[3] This does not, however, mean that Laudano cannot achieve its desired outcome in further prosecution. "A losing party to an interference is entitled to claim subject matter other than that of the interference count, provided the requirements of patentability are met, and subject to those constraints that flow from the adverse

[2] Although we need not decide the issue for the purposes of this judgment, only Laudano claims 47-51, 60, 62, and 63 appear to be significantly broader than counts 4, 6, and 7.

[3] It is long established that no one "wins" an interference. Had there been a generic count, the proofs Laudano submitted would only establish that DFCI is not entitled to a generic claim. It would not have established that Laudano was entitled to such a claim. In re Kyrides, 159 F.2d 1019, 1022, 73 USPQ 61, 63 (CCPA 1947) (a junior party prevailing on a generic count with proofs to a single species is nevertheless properly rejected as anticipated by senior party's patent disclosing different species). Hence, this judgment does not create the rejection that Laudano will likely face in further prosecution and could not have avoided it even if we could grant the relief sought.

decision in the interference." In re Zletz, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Ordinarily a party that loses an interference is estopped from seeking relief it could have sought during the interference. 37 C.F.R. § 1.658(c). Hence, as a threshold matter, it is necessary to establish that Laudano could not have sought the relief it requests by filing a motion.

Adding a generic count

It might have been possible to grant the requested relief if there had actually been a generic count. DFCI, however, had no claims corresponding to at least illustrative count 3. While DFCI arguably has support for such claims, it is a patentee. Consequently, Laudano could not have moved to have DFCI add claims corresponding to a proposed count 3. 37 C.F.R. § 1.633(c)(5)("requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count"); accord Green v. Rich Iron Co., 944 F.2d 852, 854, 20 USPQ2d 1075, 1076-77 (Fed. Cir. 1991) (patentee cannot be compelled to file a reissue application). Consequently, Laudano could not have moved to add count 3 and cannot be estopped from any action for failing to have so moved.

Designating the generic claims as not corresponding

The relief Laudano is requesting is essentially a judgment that its generic claims do not correspond to any of the counts. The problem with this approach is that Laudano's generic claims are necessarily anticipated by DFCI's claims corresponding to counts 4, 6, and 7. 37 C.F.R. § 1.637(c)(4)(ii) (designation is based on other claims that indisputably correspond to the count); accord In re Deckler, 977 F.2d 1449, 1452, 24 USPQ2d 1448, 1449 (Fed. Cir. 1992)

(applicant estopped from claiming subject matter obvious in view of a claim lost in an interference). Laudano could not have moved to have its generic claims designated as not corresponding to counts 4, 6, and 7, and consequently cannot be estopped from any action for failing to have so moved.

Laudano's options

Having established that Laudano could not obtain relief during the interference, the remaining question is whether the Office provides a remedy outside the interference. The case law points to two such remedies that are available to Laudano as an applicant in subsequent prosecution before an examiner.

Antedating DFCI's proofs

The joint request can be construed as an antedating effort. The Federal Circuit analyzed this option under 37 C.F.R. § 1.131 in Zletz, 893 F.2d at 322-23, 13 USPQ2d at 1322-23 (footnote and citations omitted, italics in original):

> Rule 131 provides an *ex parte* mechanism whereby a patent applicant may antedate subject matter in a reference, even if the reference describes the same invention that is claimed by the applicant, provided that the same invention is not claimed in the reference when the reference is a United States patent. As explained in [a CCPA opinion], the disclosure in a reference United States patent does not fall under 35 U.S.C. § 102(g) but under 35 U.S.C. § 102(e), and thus can be antedated in accordance with Rule 131. But when the subject matter sought to be antedated is claimed in the reference patent, Rule 131 is not available and an interference must be had to determine priority.
>
> Thus a losing party to an interference, on showing that the invention now claimed is not "substantially the same" as that of the lost count may employ the procedures of Rule 131 in order to antedate the filing date of the interfering application. The lost count of the interference is not prior art against a different invention, for "'prior art' in the sense of section 102(g) cannot be the basis of a section 102(a) rejection, the invention not being *publicly* 'known or used'".

Zletz was in a position much like Laudano in that Zletz was seeking generic claims after having lost an interference over claims to a species within the genus. As the Zletz decision indicates, antedating can be an appropriate remedy in such cases.

Zletz also provides a cautionary note, however. The Federal Circuit ultimately decided that Zletz had not provided antedating support commensurate with the scope it said it was now claiming. Zletz, 893 F.2d at 323, 13 USPQ2d at 1324; Kyrides, 159 F.2d at 1021-22, 73 USPQ at 63. We note that Laudano has alleged proofs to a single species outside the scope of counts 4, 6, and 7 to support its generic claims. It is possible, but unusual, for a single species to support a generic claim in an antedating effort.[4]

Johnson claims

A much simpler alternative would be to file claims that carve out the lost species. The Court of Customs and Patent Appeals adopted a very flexible standard for allowing an applicant to amend its generic claims to exclude the subject matter of a lost count. In re Johnson, 558 F.2d 1008, 1018, 194 USPQ 187, 196 (CCPA 1977). Admittedly this solution would not leave Laudano with generic claims that dominate DFCI's species, but Laudano would have claims to everything but the species of the lost counts.

[4] If Laudano chooses to rely on additional species in an antedating effort before the examiner, it must take care not to rely on species that are obvious variants of the subject matter of counts 4, 6, and 7. Laudano could have moved for a broader version of counts 4, 6, or 7 to encompass its best proofs to such inventions. 37 C.F.R. § 1.633(c)(1); see also Louis v. Okada, 59 USPQ2d 1073 (BPAI 2001) (explaining how to broaden a count to include best proofs of priority). Having failed to do so, it cannot rely on such proofs to obtain a dominating claim. 37 C.F.R. § 1.658(c).

CONCLUSION

The relief specifically requested is DENIED as beyond our authority, but the result of this judgment places the parties in the same legal posture that the relief requested would have placed the parties.

ORDER

Upon consideration of the Joint Request, it is:

ORDERED that judgment on priority as to Count 4 is awarded against Laudano;

FURTHER ORDERED that Laudano is not entitled to a patent containing claims 38, 39, 47-53, 59-64, 66, 67, and 69 of Laudano's 08/146,235 application, which correspond to Count 4;

FURTHER ORDERED that judgment on priority as to Count 6 is awarded against Laudano;

FURTHER ORDERED that Laudano is not entitled to a patent containing claims 38-41, 47-55, and 59-69 of Laudano's 08/146,235 application, which correspond to Count 6;

FURTHER ORDERED that judgment on priority as to Count 7 is awarded against Laudano;

FURTHER ORDERED that Laudano is not entitled to a patent containing claims 42, 43, 47, 51, 56, and 57 of Laudano's 08/146,235 application, which correspond to Count 7;

FURTHER ORDERED that, consistent with the terms of this opinion and with <u>Zletz</u>, this judgment by itself not be construed to estop Laudano from seeking claims generic to lost counts 4, 6, and 7;

FURTHER ORDERED that any request for reconsideration be filed within 1 month; and

FURTHER ORDERED that a copy of this decision be entered in the administrative record of Laudano's 08/146,235 application and DFCI's 5,599,681 patent.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

CAROL A. SPIEGEL
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

INTERFERENCE TRIAL SECTION

Notice: Any agreement or understanding between parties to this interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the United States Patent and Trademark Office before termination of the interference as between said parties to the agreement or understanding. 35 U.S.C. 135(c); 37 C.F.R. § 1.661.

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