

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 123

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Nagumo)

STEVEN L. **STICE**,
JOSE CIBELLI, JAMES ROBL, PAUL GOLUEKE,
F. ABEL PONCE de LEON,
and D. JOSEPH JERRY,

Junior Party,
(Patent 5,945,577),

v.

KEITH HENRY STOCKMAN **CAMPBELL**
and IAN WILMUT,

Senior Party,
(Application 09/650,194).

Patent Interference No. **104,746**

Before: McKELVEY, Senior Administrative Patent Judge, LANE, and
NAGUMO, Administrative Patent Judges.

NAGUMO, Administrative Patent Judge.

DECISION ON PRIORITY

I. Introduction

This interference relates to methods for cloning certain large farm animals, namely cattle, sheep, and pigs, by transferring the nucleus of a differentiated cell (a fibroblast) into a prepared oocyte at a specified stage of development. A merits panel held that junior party Stice was not entitled to a patent on any of its involved claims, which were claims 1-24 of its U.S. patent No. 5,945,577. (Paper 80 at 37-40.) The interference was redeclared with three counts, Counts 4 through 6, based solely on certain surviving claims of senior party Campbell. (Paper 81 at 3.)

An oral hearing on priority was held in the presence of a court reporter on 15 November 2005. (See Paper 120, transcript of oral argument.) Ronald A. Daignault, Esq., argued for Stice. Kenneth J. Meyers, Esq., accompanied by David J. Earp, Esq., argued for Campbell.

II. Findings of fact

The record supports the following findings of fact as well as any other findings of fact set forth in any other portion of the decision by at least a preponderance of the evidence.

The interference

1. This interference was declared on 30 January 2002, between junior party Steven L. Stice, Jose Cibelli, James Robl, Paul Golueke, F. Abel Ponce de Leon, and D. Joseph Jerry ("Stice") and senior party Keith Henry Stockman Campbell and Ian Wilmut ("Campbell").

2. Stice is involved in the interference on the basis of its 5,945,577 ("577") patent, issued on 31 August 1999, and based on application 08/781,752, filed 10 January 1997.

3. According to Stice, its real party in interest is "the University of Massachusetts, which has exclusively licensed their interest to Advanced Cell Technology Corporation" (Paper 9).

4. Campbell is involved in the interference on the basis of its 09/650,194 ("194") application, filed 29 August 2000.

5. According to Campbell, its real party in interest is

(1) Assignee: Roslin Institute (Edinburgh) of
Midlothian, England;

(2) licensees: Geron Corporation, of Menlo Park, CA,
and Exeter Life Sciences, Inc., of Phoenix, AZ. (Paper 98 at 2.)

The counts

6. **Count 4** reads as follows (Paper 81 at 3):
A method according to any of claims 19 or 23 of Campbell application 09/650,194.
7. **Count 5** reads as follows (Paper 81 at 3):
A method according to any of claims 27 or 31 of Campbell application 09/650,194.
8. **Count 6** reads as follows (Paper 81 at 3):
A method according to claim 35, claim 39, claim 43 or claim 47 of Campbell application 09/650,194, where the "non-human mammal" is a pig or a porcine and where the "non-human mammalian fetus" is a pig fetus or a porcine fetus.
9. Claim 23 of Campbell reads as follows:
A method of cloning a bovine fetus by nuclear transfer comprising:
 - (i) inserting a nucleus of a cultured diploid bovine fibroblast in the G1 phase of the cell cycle into an unactivated, enucleated metaphase II-arrested bovine oocyte to reconstruct an embryo;

(ii) maintaining the reconstructed embryo without activation for a sufficient time to allow the reconstructed embryo to become capable of developing to term;

(iii) activating the resultant reconstructed embryo;

(iv) culturing said activated, reconstructed embryo to blastocyst; and

(v) transferring said cultured, reconstructed embryo to a host cow such that the reconstructed embryo develops into a fetus.

10. The other Campbell claims referred to in the counts are independent claims that are also directed to methods of cloning by nuclear transfer comprising the same overall steps as Campbell claim 23. The following differences are noted:

(a) Campbell claim 19 is directed to a method of cloning a cow.

(b) Campbell claim 27 is directed to a method of cloning a sheep.

(c) Campbell claim 31 is directed to a method of cloning an ovine fetus.

(d) Campbell claim 35 is directed to a method of cloning a non-human mammal.

(e) Campbell claim 39 is directed to a method of cloning a non-human mammalian fetus.

(f) Campbell claim 43 is directed to a method of cloning a non-human mammal and requires that the donor cell be a differentiated cell.

(g) Campbell claim 47 is directed to a method of cloning a non-human mammalian fetus and requires that the donor cell be a differentiated cell.

Claim correspondence

11. The claim correspondence was not disturbed by the redeclaration of this interference. (Paper 83.)

a. The claims corresponding to **Count 4** are:

Stice: 1-24

Campbell: 19-26 and 35-50

b. The claims corresponding to **Count 5** are:

Stice: 1-22

Campbell: 27-50

c. The claims corresponding to **Count 6** are:

Stice: 1-22

Campbell: 35-51¹.

¹ Campbell was authorized to file an amendment adding claim 51 to its involved application (Paper 32 at 2). Campbell claim 51 is directed to a method of cloning a pig using the nuclear transfer method and thus corresponds to Count 6.

12. No Stice claims are patentable. (Paper 80 at 40, 43.)

Benefit

13. Stice was not accorded priority benefit of the filing date of any prior application (Paper 81 at 3).

14. Campbell was accorded priority benefit of the following three applications for all three counts of the interference (Paper 81 at 3):

US application 08/803,165, filed 19 February 1997,
and issued as patent 6,252,133 on 26 June 2001;

PCT application PCT/GB96/02098, filed
30 August 1996; and

GB application 9517779.6, filed 31 August 1995.

15. The parties continue to rely on their original priority statements. (Paper 83 (Campbell); Paper 84 (Stice).)

Arguments

16. Stice filed a principal brief on priority (Paper 92), which Campbell opposed (Paper 104); Stice filed a reply (Paper 106).

17. Stice subsequently filed a corrected brief (Paper 115) pursuant to an Order (Paper 112) to renumber its exhibits consecutively.

18. Campbell filed a principal brief on priority (Paper 99), which Stice did not oppose, as Campbell noted in a "Notice concerning filing of reply brief" (Paper 107).

Stice case for priority

Conception

19. Stice points to an entry dated "6/22/95" in a laboratory notebook prepared by Dr. Steven L. Stice as evidence of conception. (Paper 115 at 8.)

20. According to Stice, the critical sentence supporting conception reads:

"Want to try electroporation on fibroblast so that they can be used to produce nuclear transfer embryos from clonal cells. Will talk to Jose [Cibelli] about this."
(Paper 115 at 8, citing SX 2055².)

21. Stice represents that Dr. Stice signed this page of his laboratory notebook on 23 June 1995. (Paper 115 at 8.)

22. Stice represents further that this page was "subsequently corroborated" by Mr. Jeffrey Kane on 30 April 1997.

23. Review of Stice exhibit SX 2055 (Stice notebook) confirms the dates cited by Stice.

24. Exhibit 2055 is not labeled by any page numbers.

² Stice Exhibits are cited as SX 2___; Campbell exhibits are cited as CX 1___.

25. Kane testified that he signed the notebook on the date indicated. (SX 2052 at 1.)

26. Stice argues that "this is the first date [22 June 1995] indicating the conception by Dr. Steven Stice of a method of using differentiated donor cells (i.e. fibroblast cells) as donor cells for subsequent nuclear transfer experiment from which offspring could be generated. The conception corresponds to the subject matter of the Counts." (Paper 115 at 8-9.)

27. Stice has not, in its principal brief, directed our attention to any expert testimony or other evidence supporting its assertions regarding the critical sentence and its relation to any of counts 4-6.

28. Dr. Stice testified, "[t]hat entry [SX 2055] indicates that I wanted to try the process of electroporation on fibroblast cells in order that they may be used to produce nuclear transfer embryos from the cloned cells. I also indicated in my notebook that I wanted to talk to my colleague, Dr. Jose Cibelli, regarding developing this technology." (Stice declaration, SX 2050 at 2-3.)

29. We find no explanation in Stice's declaration of the relation of his sentence to the limitations of any of the Counts.

30. According to Stice, on another page of Dr. Stice's laboratory notebook, in an entry dated 27 June 1995, Dr. Stice

wrote, "Try to use the electroporation to introduce β -geo into fibroblast cells bovine (Jose's [Cibelli]). The idea is to use these transgenic cells in NT [nuclear transfer] to produce fetuses and offspring? machine?" (SX 2056; square-bracketed material added by Stice.)

31. Exhibit 2056 is not labeled by any page numbers.

32. Review of SX 2056 indicates that Dr. Stice wrote "Tried", rather than "Try" in the sentence quoted by Stice.

33. Dr. Stice appears to have signed and dated this page on 28 June 1995. (SX 2056.)

34. Exhibit 2056 also shows a partial signature, "Jeffrey J. Ka", and a partial date, "April 30". (SX 2056.)

35. Kane testified that he reviewed and signed the pages of the laboratory notebooks shown in SX 2055 and SX 2056 in 1997. (SX 2052 at 1, ¶2.)

36. Stice offers, as collaboration of Dr. Stice's conception, the signature and declaration of Mr. Jeffrey Kane (SX 2052). (Paper 115 at 8.)

Reduction to practice

37. Stice provides a "summary" of Cibelli's research notebooks (SX 2057 and 2058) covering the period 10 August 1995 through 30 August 1996. (Paper 115 at 10-21.)

38. Stice urges that it achieved an actual reduction to practice of subject matter within the scope of Count 4 on or about 30 August 1996, as shown by an entry in a notebook maintained by Cibelli. (Paper 115 at 21.)

39. Stice characterizes the actual reduction to practice as one in which "successful nuclear transfer fusions using differentiated fibroblast cells were completed leading to viable offsprings." (Paper 115 at 21.)

40. The summary for activities of 30 August 1996 refers to pregnancies of "7/30/96." (Paper 115 at 20.)

41. There is no entry in the summary table for 30 July 1996.

42. Stice, in its principal brief, has not directed our attention to any expert testimony that explains any of the summaries of Cibelli's notebooks, nor how the summaries relate to any of the counts in this interference.

43. Stice, in its principal brief, has not made any arguments relating the evidence on which it ultimately relies to support its actual reduction to practice, namely Cibelli's notebooks, SX 2057 and SX 2058, to the limitations of any of the counts.

44. Stice, in its principal brief, has not directed our attention to any expert testimony explaining the significance of

any entries in Cibelli's notebooks vis-à-vis any count; nor are any of the data in the notebook explained as to their origin, meaning, or reliability.

Diligence

45. Campbell has been accorded the benefit for priority in this interference of its UK application, filed on 31 August 1995. (Paper 81 at 3)

46. Stice cites a second entry from Dr. Stice's notebook as evidence of the beginnings of a "concerted effort to reduce this invention to practice: "Try [sic: Tried] to use the electroporation to introduce β -geo into fibroblast cells bovine (Jose's). The idea is to use these transgenic cells in NT to produce fetuses and offspring? machine?"). (Paper 92 at 10, square bracketed remarks added by Stice omitted.)

47. Stice provides a table that begins at page 10 of its priority brief and runs to the top of page 21, in which dates are paired against brief descriptions of activity, which are said to be summaries of notebook pages from Dr. Jose Cibelli's laboratory notebook.

48. Stice, in its principal brief, has not directed our attention to any testimony explaining the meaning or significance of any entries in the table.

49. The entries in the table are dated from 10 August 1995 through 30 August 1996.

50. Stice's table starts 22 days before Campbell's priority benefit date of 31 August 1995.

51. Stice's table indicates activity on 10 of the 22 days before 31 August 1995.

52. The 12 days of inactivity between the start of the Stice Table and 31 August 1995 comprise four blocks of three days each.

53. Stice has not offered any explanation of these periods of silence.

54. Of the 365 days covered by Stice's table following 31 August 1995, 149 are days for which some activity was reported. and 216 are days without reports of activity.

55. From a calendar marked up to indicated the days of activity chronicled in Stice's table, it is apparent that there are several larger blocks of time after Campbell's priority benefit date during which no activity was reported.

a. The largest block of unexplained inactivity extends 18 days, from 29 June 1996 through 16 July 1996.

b. The second largest block of unexplained inactivity covers 16 days, from 4 November 1995 through 19 November 1995.

c. The remaining periods of unexplained inactivity after 31 August 1995 are all of shorter duration – there are three seven-day periods, three six-day periods, and six five-day periods of unexplained inactivity; we have not counted the number of shorter periods of inactivity following 31 August 1995.

d. The sum of these shorter periods of inactivity is 223 days.

56. Stice, in its principal brief, has neither identified nor explained any gaps of activity during the period covered by the table.

57. Stice, in its principal brief, has not described any activities from the period 30 August 1996 through 10 January 1997, the filing date of the application that resulted in its involved patent.

a. This last period of unexplained inactivity covers 133 days.

58. Stice offers, as corroboration of its actual reduction to practice and diligence, the signature of Ms. Catherine Blackwell ("Blackwell") on Cibelli's notebook pages presented in SX 2057, and her declaration.

59. Blackwell declares, "[b]eginning during the period of approximately June 1995, I was aware of a research project conducted primarily by Drs. Stice and Cibelli regarding the issue

of differentiated cells in nuclear transfer technology. Their goal was to produce embryos from the cloned differentiated cells." (SX 2053 at 2, ¶ 2; SX 2054 at 2, ¶2.)

Cibelli's notebooks

60. Dr. Jose B. Cibelli ("Cibelli") states, "[w]hile affiliated with Advanced Cellular Technology, my colleague and I, Dr. Steven Stice, began a series of experiments on or about June 1995 and continuing through the end of 1996, using nuclear transfer techniques with differentiated cells in the hopes of developing a method for produced cloned animals." (SX 2051 at 2, ¶ 3.)

61. Copies of Cibelli's notebook pages are presented in SX 2057 and SX 2058.

62. SX 2058 consists of two parts.

63. Part one of SX 2058 consists of pages 1 (cover) through 59 of a 96-page bound notebook, with dated entries running from "8/10/95" through "2/5/96".

64. Page numbers 2 through 59 of SX 2058 are handwritten entries at the bottom center of each page; the cover of the first notebook is not numbered.

65. Pages 1-59 of SX 2058 are not signed by the writer.

66. Pages 1-59 of SX 2058 are not witnessed, i.e., signed and dated by another, signifying that the pages have been read and understood.

67. Page 59 of SX 2058 has the notations "END OF BOOK", what appears to be signature of Jose Cibelli, and "NEXT BOOK ACT#9".

68. Part two of SX 2058 appears to consist of the cover of "NOTEBOOK NO. 9" and pages 1-80 (so labeled, apparently by the manufacturer) of that notebook.

69. Page 60 of SX 2058 appears to be the cover of "Notebook No. 9," issued to Jose Cibelli, Department ACT, returned 7 August 1997.

70. Page numbers, "60" through "141", have been entered by hand at the bottom center of each page of part two of SX 2058.

71. Pages 60-141 of SX 2058 appear generally to have been signed by Jose Cibelli on the last date noted on the body of each page.

72. Pages 61-141 appear to have been witnessed (signature illegible) in blocks at intervals of a few weeks.

73. The first entry is dated "2/5/96" and witnessed "2-9-96".

74. The last entry is dated "7/26/96" and witnessed "7-30-96".

75. SX 2057 (corrected) covers pages 81 to 102 (pre-numbered), 26 July 1996, through 4 September 1996, of a notebook, which appears to be the continuation of "Notebook No. 9".

76. Pages 81-102 are signed and dated as in SX 2058, "Notebook No. 9".

77. Page 81 is dated "7/26/96". (SX 2057).

78. Page 102 is dated "9/4/96". (SX 2057).

79. Pages 81-102 also bear the witness signature of Catherine E. Blackwell and the witness date of "5/8/97". (SX 2057).

Campbell case for priority

80. Campbell rests its case for priority on its British Application No. GB 95 17779.6 (CX 1003), filed 31 August 1995, the benefit for priority of which it has been accorded. (Campbell Principal Brief on Priority, Paper 99 at 2.)

81. Stice has not filed a brief in opposition to Campbell's case in chief for priority.

III. Discussion

The senior party in an interference is presumed to be the first inventor. 37 CFR § 41.207(a)(1) (2004)³. The junior party

³ New regulations governing interferences before the United States Patent and Trademark Office were published at 69 Fed. Reg. 49,960 (12 August 2004), effective 13 September 2004. Except in those instances in which a party would be

bears the burden of proving, by a preponderance of the evidence, a prima facie case that it was the prior inventor. The party filing a motion has the burden of proof to establish that it is entitled to the requested relief. 37 CFR § 41.121(b) (2004); *Velander v. Garner*, 348 F.3d 1359, 1369-70, 68 USPQ2d 1769, 1777 (Fed. Cir. 2003). As a consequence, if the junior party fails to make out a prima facie case that it was the prior inventor, the senior party is awarded judgment by default.

A party who was not the first to file an application for patent of the interfering invention may nonetheless be adjudged the first inventor if it proves that it was the first to conceive of an embodiment of the interfering invention, and that it worked diligently to reduce an embodiment of the interfering invention to practice from a time before the senior party conceived of its invention until the junior party reduced its invention to practice. "Priority and its constituent issues of conception and reduction to practice are questions of law predicated on subsidiary factual findings." *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000).

Conception

Conception is the formation "in the mind of the inventor of a definite and permanent idea of the complete and operative

prejudiced due to a reliance on the old rules, the new rules shall be applied.

invention, as it is therefore to be applied in practice." *Kridl v. McCormick*, 105 F.3d 1446, 1449, 41 USPQ2d 1686, 1689 (Fed. Cir. 1997) (citations omitted). Conception must include every feature or limitation of the claimed invention. *Id.* Moreover, "[c]onception must be proved by corroborating evidence . . . a reasonable analysis of all the pertinent evidence to determine whether the inventor's testimony is credible. The tribunal must also keep in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor's testimony.") *Id.* at 1449-50, 41 USPQ2d at 1689; (citations omitted.) Nonetheless, the sufficiency of corroborative evidence must be judged by the 'rule of reason,' under which the tribunal must consider and analyze all pertinent evidence to determine whether the inventor's testimony is credible. *Id.* As the Federal Circuit has emphasized, "Because conception is a mental act, evidence of conception must ultimately address whether the inventor formed 'the definite and permanent idea of the complete and operative invention' in his or her mind." *In re Jolley*, 308 F.3d 1317, 1325, 64 USPQ2d 1901, 1907 (Fed. Cir. 2002).

In the present case, with respect to count 4, junior party Stice seeks to show that it was the first to conceive and that it acted diligently to reduce its invention to practice from a time

before senior party Campbell conceived of its invention. Stice's arguments fail at virtually every level.

First, Stice has failed to show that its evidence of conception, when read by one skilled in the relevant art, discloses every element of the count. The alternative definition of count 4 provided by Campbell claim 23, which recites a method of cloning a bovine fetus, is the most relevant to Stice's proofs. The limitation to which the parties have devoted the most attention is underscored in the first step, which reads as follows:

- (i) inserting a nucleus of a cultured diploid bovine fibroblast in the G1 phase of the cell cycle into an unactivated, enucleated metaphase II-arrested bovine oocyte to reconstruct an embryo.

The evidence on which Stice relies for its proof of conception is directed to fibroblasts generally: "Want to try electroporation on fibroblast so that they can be used to produce nuclear transfer embryos from clonal cells. Will talk to Jose about this." (SX 2055.) This statement, by itself, does not relate to cattle in particular, as recited in Campbell claim 23. As counsel for Stice conceded at oral argument, "there is no cow there." (Paper 120 at 10, l. 12 (erroneously attributed to Mr. Meyers; Mr. Daignault spoke.)) Count 4 specifies further that

the nucleus to be transferred must be a "cultured diploid bovine fibroblast in the G1 phase of the cell cycle." Stice, in its principal brief, has not directed our attention to any testimony or other evidence indicating that one skilled in the art would have recognized that Stice's sentence teaches or discloses the limitation in count 4 that the transferred nucleus be in the G1 phase of the cell cycle. Similarly, the further limitations that a nucleus be implanted into an unactivated enucleated metaphase II-arrested oocyte, and that the reconstructed embryo be maintained "without activation for a sufficient time to allow the reconstructed embryo to become capable of developing to term," are not apparent from the Stice sentence. Stice has not presented any testimony or other evidence to bridge the gap between the sentence and the subject matter of count 4.

Although Stice relies on Dr. Stice's notebook entry of 27 June 1995, as evidence of diligence, we may consider whether this entry is evidence of conception of an embodiment within the scope of any of the counts. Dr. Stice wrote, "Tried to use the electroporation to introduce β -geo into fibroblast cells bovine (Jose's). The idea is to use these transgenic cells in NT to produce fetuses and offspring? machine?" (Paper 92 at 10.) We have no difficulty accepting that "Jose" refers to co-inventor Cibelli, or that "NT" is an abbreviation for "nuclear transfer."

However, although this passage at least discloses that the nucleus to be transferred is bovine, the other limitations, particularly the G1-phase of the transferred nucleus, are not plainly evident from the text.

Stice, in its principal brief, makes no effort to show that all the limitations required by the count are present in either sentence recorded by Dr. Stice. Nor did Stice, in its principal brief, attempt to show that one skilled in the art would have recognized his statement as a clear idea of an embodiment within the scope of count 4. The significance of data and other documentary exhibits must be explained. See, e.g., 37 CFR § 1.671(f) (2003) ("The significance of documentary and other exhibits identified by a witness in an affidavit or during oral deposition shall be discussed with particularity by a witness"); 37 CFR § 1.608(b) (2003) (similar requirement for discussion of the significance of documents); Standing Order §§ 42, 43 (Paper 2) requiring underlying facts be disclosed that form the basis of expert opinion, and explanations of scientific tests and data). Stice's statement that "[t]he conception corresponds to the subject matter of the Counts" is unsupported by any explanation. When questioned on this point at oral argument, Stice urged that the G1-phase limitation was met inherently by a nucleus taken from a culture of propagating cells. (Paper 120 at 11.) The

board considered and rejected this same general argument from Stice regarding whether the transfer of the nucleus of a "proliferating cell" was inherently met if the nucleus was selected from a proliferating cell culture. (Paper 80 at 37-40, discussion Campbell preliminary motion 3.) As Stice has not come forward with any new evidence or argument, we reject its contention that the missing G1 limitation is inherent.

Moreover, Stice has failed to meet the requirement that inventor testimony regarding conception be corroborated. Kane stated that "I do hereby affirm the research that is reported on those pages [SX 2055 and SX 2056] was performed by the investigators who produced the notebooks. I was given these books to sign in 1997 as signed, even though the work was done earlier." (SX 2052 at 1, ¶2.) This statement is insufficient to establish more than that those pages existed on the date Kane signed them. Kane's statement that "the research . . . was performed" begs the questions of exactly what the laboratory notebook entries indicate Dr. Stice conceived, and how that conception, whatever it was, relates to the limitations of the present counts in this interference. Dr. Cibelli's testimony and laboratory notebooks cannot provide corroboration, as Dr. Cibelli is a co-inventor. Unlike the case of *Jolley*, in which inventor McGraw established by "sufficient circumstantial evidence of an

independent nature," 308 F.3d at 1325, 64 USPQ2d at 1907, Stice has presented no probative evidence corroborating either the substance or the date of Dr. Stice's alleged conception.

Accordingly, we hold that Stice has failed to prove conception of an embodiment within the scope of count 4, prior to Campbell's constructive reduction to practice.

Stice has presented no arguments directed to its prior conception of the subject matter of counts 5 and 6, which relate to ovine (sheep) and porcine (pig) embodiments, respectively. All the evidence put forward by Stice that is arguably prior to Campbell's benefit date of 31 August 1995 relates to inventions involving bovines (cattle). Accordingly, we hold that Stice has failed to demonstrate conception of an embodiment of counts 5 or 6 prior to Campbell's constructive reduction to practice.

Actual reduction to practice

Stice's evidence in support of an actual reduction to practice of an embodiment within the scope of count 4 are similarly deficient. Stice made no attempt, in its principal brief, to explain, with the assistance of relevant evidence, including expert testimony, how the activities reported in Cibelli's research notebook on 30 August 1996, amount to a reduction to practice of an embodiment within the scope of

count 4. There is no explanation, by one skilled in the art, of the significance of the entries in Dr. Cibelli's notebooks relating to actual reduction to practice. Even counsel for Stice appear to have been confused about when critical events occurred. Review of the notebook page for "8/30/96" shows no reference to any "pregnancies from 7/30/96," as alleged by Stice. (Paper 115 at 20.) In response to Campbell's Opposition (Paper 104 at 30-31), Stice admitted, "Dr. Cibelli did not always record everything in his notebook, as evidenced by the lack of an entry for July 30, 1996, despite a reference to activities on that date in the August 30, 1996 entry." (Paper 106 at 20.) In Stice's demonstrative exhibit presented at oral argument, however, the summary for August 30, 1996, refers to "the pregnancies of July 25, 1996." (Paper 122 at 4.) When questioned about the discrepancy between Stice's principal brief and its demonstrative exhibit, counsel for Stice stated that the reference to July 25, 1996 in its brief was a typographical error. (Paper 120 at 16.) At another point, counsel for Stice also stated, "I have seen pages where there are three separate experiments, one related to the count and one related probably to a different project." (Paper 120 at 24.)

These statements by counsel emphasize the necessity of testimony by a witness intimately familiar with laboratory

notebooks. Such records are highly technical, and in practice are often rather abbreviated and idiosyncratic documents. The significance of a given entry or series of entries is often not apparent to an outsider, expert or not, although it may become so if explained. Without such testimony – and commentary, if available, from an opposing expert (or perhaps better, an independent expert) – a lay panel cannot reasonably be assured of coming to any reliable conclusions from its own study of the notebooks. In the absence of testimony explaining and evaluating the experimental procedures, tests, and the conclusions that may be drawn from them, we decline to accord any weight to the unexplained raw data of Cibelli's notebooks.

Moreover, there is no independent evidence in the record corroborating Cibelli's experiments or the results. It is well-settled that an inventor seeking to prove an actual reduction to practice "must provide corroborating evidence in addition to his own statements and documents. Such evidence may consist of testimony of a witness, other than an inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor. The purpose of the rule requiring corroboration is to prevent fraud." *Hahn v. Wong*, 892 F.2d 1028, 1033, 13 USPQ2d 1313, 1317 (Fed. Cir. 1989) (internal quotes and

citations omitted). The general testimony of Blackwell and Kane that the inventors were conducting research in nuclear-transfer techniques and animal cloning does not provide surrounding facts and circumstances sufficient to corroborate an actual reduction to practice of an embodiment within the scope of count 4.

Diligence

Stice's case for diligence is similarly flawed. Its summary of activities is mere attorney argument, unsupported by testimony regarding the underlying work reported in Cibelli's laboratory notebooks. Cibelli's broad description of the research program (SX 2051 at 3-4, ¶¶ 6-7) lacks particularity, and does not suffice to explain his notebook entries. Even regarding the summary, there is no explanation of how the activities relate to the limitations of count 4. In the absence of testimony explaining the relation of the activities reported in Cibelli's notebooks to the subject matter of the counts, and in the absence of testimony explaining the gaps in the record, we are unable to assess the significance of Cibelli's notebooks as they relate to diligent efforts to reduce an embodiment of the invention to practice, and we decline to accord them any weight.

Conclusions

As we have stated repeatedly in other cases, we shall not act as an advocate for either of the parties. When arguing a case concerning a rapidly developing, complicated, highly technical art, it is particularly important to explain how the evidence of record relates to the critical legal issue – here, the counts. The opposing party may then admit or deny the validity of the evidence and its relevance to the issues, providing its own evidence, including expert testimony, if appropriate. Following a reply, the tribunal is then in some reasonable position to weigh the merits of the arguments and to determine whether the moving party has carried its burden. Although Stice's Reply Brief, Paper 106, offers considerably more detailed argument than in its Principal Brief, to the extent it attempts to establish a prima facie case of priority, or any of the underpinnings, it is untimely, and we shall not consider them. No good cause has been shown to present new arguments. It is fundamentally unfair to sit back and wait for an opposition, and then attempt to put together a prima facie case in reply, when the opposing party has no opportunity to contest the belated and newly presented arguments.

ORDER

In view of the foregoing considerations, it is:

ORDERED that Stice has failed to establish, by a preponderance of the evidence, that it conceived an embodiment within the scope of any of counts 4-6, which are all the counts of this interference, before Campbell's constructive reduction to practice;

FURTHER ORDERED that Stice has failed to establish, by a preponderance of the evidence, that it reduced to practice an embodiment within the scope of any of counts 4-6;

FURTHER ORDERED that Stice has failed to establish, by a preponderance of the evidence, that it was diligent in its attempts to reduce to practice an embodiment within the scope of any of counts 4-6.

FURTHER ORDERED that Judgment is entered in Paper 124 which accompanies this decision.

FURTHER ORDERED that this paper be given an appropriate number and placed in the patent file of U.S. Patent 5,945,577 and in the application file of 09/650,194.

FURTHER ORDERED that if there is a settlement, the attentions of the parties are directed to 35 U.S.C. § 135(c) and 37 CFR § 41.205.

_____)	
FRED E. McKELVEY)	
Senior Administrative Patent Judge)	
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)	BOARD OF
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SALLY GARDNER LANE)	AND
Administrative Patent Judge)	INTERFERENCES
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MARK NAGUMO)	
Administrative Patent Judge)	

Alexandria, VA
__ December 2004

Interference 104,746
Stice v. Campbell

Paper 123

cc: via first class mail:

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

Paper 124

Filed by: Trial Section Motions Panel
Mail Stop Interference
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Filed
20 December 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Nagumo)

STEVEN L. **STICE**,
JOSE CIBELLI, JAMES ROBL, PAUL GOLUEKE,
F. ABEL PONCE de LEON,
and D. JOSEPH JERRY,

Junior Party,
(Patent 5,945,577),

v.

KEITH HENRY STOCKMAN **CAMPBELL**
and IAN WILMUT,

Senior Party,
(Application 09/650,194).

Patent Interference No. **104,746**

Before: McKELVEY, Senior Administrative Patent Judge, LANE, and
NAGUMO, Administrative Patent Judges.

NAGUMO, Administrative Patent Judge.

FINAL JUDGMENT - PRIORITY - Bd. R. 127

In view of the discussion Decision on Priority, Paper 123,
it is:

ORDERED that adverse judgment as to priority with
respect to counts 4, 5, and 6 is entered against Stice;

FURTHER ORDERED that Steven L. Stice, Jose Cibelli,
James Robl, Paul Golueke, F. Abel Ponce de Leon, and D. Joseph
Jerry are not entitled to a patent containing claims 1-24 of U.S.
Patent 5,945,577;

FURTHER ORDERED that this paper be given an appropriate
number and placed in the patent file of U.S. Patent 5,945,577 and
in the application file of 09/650,194.

FURTHER ORDERED that if there is a settlement, the attentions of the parties are directed to 35 U.S.C. § 135(c) and 37 CFR § 41.205.

_____)	
FRED E. McKELVEY)	
Senior Administrative Patent Judge)	
)	
)	
)	BOARD OF
)	PATENT APPEALS
_____)	AND
SALLY GARDNER LANE)	INTERFERENCES
Administrative Patent Judge)	
)	
)	TRIAL SECTION
)	MERITS PANEL
_____)	
MARK NAGUMO)	
Administrative Patent Judge)	

Alexandria, VA
___ December 2004

Interference 104,746
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