

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 42

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

BERND STILLER

Junior Party,
(U.S. Application 09/101,663),

v.

HANS HEID and JEROME SEJOURNET
(**Microm International Gmbh**)

Senior Party,
(U.S. Patent 5,895,628).

Patent Interference No. 105,044

Before: SCHAFER, LEE and TORCZON, Administrative Patent Judges.
SCHAFER, Administrative Patent Judge.

DECISION ON JOINT MOTION AND FINAL JUDGMENT

The parties have filed a joint preliminary motion for judgment asserting that there is no interference-in-fact between the parties involved claims. We grant the motion and issue final judgment.

Findings of Fact

The following findings are supported by a preponderance of the evidence.

F 1. This interference is between Application 09/101,663 and Patent 5,895,628.

F 2. The Stiller application is said to be assigned to

Helmut Goldbecker
Fuhrenkamp 21
D-30916 Isernhagen, Germany

Paper 5.

F 3. The Heid patent is said to be assigned to Microm International GmbH. Paper 14.

F 4. The subject matter of the interference relates to devices for transporting medical specimens.

F 5. Heid's Claim 18 is representative of Heid's claimed subject matter (indentation added):

18. Apparatus for treatment of specimens, comprising:
a plurality of treatment containers representing treatment stations, and
a transport device
for specimen holders
transporting the specimen holders between said treatment stations,
said transport device comprising
a vertical guide,
a receiving device and
a unit movably arranged at said transport device,
wherein said receiving device is designed to pick up said specimen holders,
wherein said unit is brought under said specimen holders
during transport of said specimen holders between said treatment
stations, and
wherein said receiving device and said unit are vertically movably guided,
independently of each other, on said vertical guide.

F 6. Stiller's Claim 9 is representative of Stiller's claimed subject matter (indenting added):

9. A transport device for conveying at least one sample holder
containing a medical specimen comprising:
(a) a carriage conveyed horizontally in at least one axis;
(b) a vertically movable hoisting device;
(c) a coupling element for the sample holder arranged on the hoisting
device;
(d) a collecting device for liquid dripping off the sample holder
positioned beneath the sample holder while the sample holder
is being conveyed.

F 7. The count of the interference is

Count 1

A transport device for specimen holders said transport device comprising
a vertical guide,
a receiving device and
a unit movably arranged at said transport device,
wherein said receiving device is designed to pick up said specimen holders,
wherein said unit is brought under said specimen holders
during transport of said specimen holders and
wherein said receiving device and said unit are vertically movably guided,
independently of each other, on said vertical guide.

F 8. The claims of the parties are:

Stiller: 9-16

Heid: 1-36

F 9. The claims of the parties which correspond to Count 1 are:

Stiller: 9-14

Heid: 1-3, 18, 20, 24-26, 30-32

F 10. The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Stiller: 15-16

Heid: 4-17, 19, 21-23, 27-29, 33-36

F 11. The parties' jointly move for a holding that no interference-in-fact exists between any of the parties' involved claims. Papers 36 and 40.

F 12. None of Heid's designated claims are identical to any of Stiller's designated claims.

F 13. A comparison of Heid's with Stiller's claims show the following differences:

(1) Heid Claims 1-3 require that the unit of the transport device positioned under the specimen holders, "to contact said specimen holders when said specimen holders are transported."

(2) Heid Claims 18 and 20 require a receiving device and unit that are "vertically movably guided, independently of each other, on [a] vertical guide."

- (3) Heid Claims 24-26 requires that treatment containers be provided with removable covers and include a removal device to remove the before the specimen holder is put into the treatment container.
- (4) Heid Claims 30-32 require a transport unit “designed to cover said treatment stations.”

- F 14.** The motion relies on the joint testimony of Hans Heid and Helmut Goldbecker (the witnesses). Heid Exhibits (HX) 1001 and 1005.
- F 15.** The witnesses confirm that the above limitations are not present in Stiller’s claims. HX 1001, ¶¶ 3-17.
- F 16.** The witnesses also testify that none of the references of record during the prosecution of the involved Heid patent or the Stiller application and the references cited in Patent 6,444,170 which issued from a C-I-P of the involved Heid patent, teach these differences. HX 1005, ¶¶ 20-22.
- F 17.** The witnesses further testify that they are unaware of any other prior art that teach the differences and that the differences are not routine or conventional practices in the art. HX 1005, ¶ 23.
- F 18.** The subject matter of Stiller’s involved claims does not anticipate any of Heid’s involved claims.

ANALYSIS

The interference rules define an "interference-in-fact" as follows (37 CFR § 1.601(j), emphasis added):

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

The rules also define "same patentable invention" (37 CFR § 1.601(n)):

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".

Subparagraphs (j) and (n) of Rule 601 together implement holdings of the former Court of Customs and Patent Appeals. See, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977) (an interference-in-fact held to exist between a claim to a method of using cyclopentadiene and a claim to a method using butadiene, isoprene, dimethylbutadiene, piperylene, anthracene, perylene, furan or sorbic acid; the claims were held to be directed to the same patentable invention even though they did not overlap in scope). See also Notice of Final Rule, Patent Interference Cases, 49 Fed. Reg. 48416 (Dec. 12, 1984) (see Example 16 at 48421 and Example 20 at 48424).

Under paragraphs 1.601(n) and 1.601(j), the determination of interference-in-fact is a two-way unpatentability test. Eli Lilly & Co. v. Board of Regents of the University of Washington, 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003); Winter v. Fujita, 53 USPQ2d 1234, 1243 (Bd. Pat. App. & Int. 1999). As noted in Winter:

The claimed invention of Party A is presumed to be prior art vis-a-vis Part B and vice versa. The claimed invention of Party A must anticipate or render obvious the claimed invention of Part B *and* the claimed invention of Party B must anticipate or render obvious the claimed invention of Party A. When the two-way analysis is applied, then regardless of who ultimately prevails on the issue of priority, the Patent and Trademark Office (PTO) assures itself that it will not issue two patents to the same patentable invention.

53 USPQ 2d at 1243. On the other hand, the determination of no interference-in-fact, is a one-way patentability test. That is, the movant must show that none of a party's involved claims, when presumed to be prior art, will anticipate or render obvious any of the opponent's claims.

The parties argue that when Stiller's claims are taken as presumed prior art, none of the claims anticipates or renders Heid's claims obvious. The parties have identified four limitations that are present in each of Heid's claims which are not present in Stiller's claims:

- (1) a transport unit, positioned under specimen holders to "contact" the specimen holders when transported, as required by Heid Claims 1-3;
- (2) a receiving device (for picking up a specimen holder) and a transport unit that are "vertically movably guided, independently of each other, on a vertical guide," as required by Heid Claims 18 and 2;
- (3) treatment stations (containers) provided with "removable covers," and a transport unit having a "removal device" to remove a cover of a

particular treatment station before a specimen holder is deposited into the particular treatment station, as required by Heid. Claims 24-26; and

- (4) a transport unit positioned under the specimen holders when transported and "designed to cover" a treatment station (container), as required by Heid Claims 30-32).

Paper 40. p. 1. Our review of the claims confirms these differences. Thus, the subject matter of Stiller's claims does not anticipate the subject matter of Heid's claims.

The parties also argue that these differences would not have been obvious. The parties rely on the testimony of Hans Heid and Helmut Goldbecker. HX 1001 and 1005. They testify that the references of record in the prosecution histories of the involved patent and application and the prosecution history of Patent 6,444,170 which is a CIP of the involved patent do not teach these limitations or suggest their use in the Stiller claims. HX 1005, ¶¶ 20-22. Our independent consideration of the references does not reveal anything inconsistent with their testimony. The witnesses also testify that based upon their experience, the differences do not reflect conventional or routine practices in the art. HX 1005, ¶ 23. We have no reason to doubt their testimony. We hold that the subject matter of Heid's involved claims would not be obvious in light of the scope and content of the prior art and the level of ordinary skill in the art as established in the record.

The parties' joint motion for no interference-in-fact is granted. A holding of no interference-in-fact means that each parties' involved claims are not an impediment to the issuance of the opponent's involved claims. Thus both parties may obtain patents. See Notice of Final Rule, Patent Interference Cases, 49 Fed. Reg. 48416, 48440 (Dec. 12, 1984) ("Two comments questioned the nature of the judgment when a motion under § 1.633(b) is granted. Section 1.633(b) authorizes the filing of a [preliminary] motion for judgment on the ground that there is no interference-in-fact. If a [preliminary] motion under § 1.633(b) is granted, the judgment would provide that each party is entitled to a patent containing that party's claims corresponding to the count."). Accordingly, we enter the following Judgment.

JUDGMENT

Upon consideration of the parties' joint motion for no interference-in-fact it is **ORDERED** that the parties' joint motion for no interference-in-fact is *granted*.

FURTHER ORDERED that there is no interference-in-fact between Claims 9-14 of Stiller Application 09/101,663 and Claims 1-3, 18, 20, 24-26, 30-32 of Heid Patent 5,895,628;

FURTHER ORDERED that judgment be entered in favor of both parties;

FURTHER ORDERED that if there is a settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661;

FURTHER ORDERED that a copy of this final decision shall be placed in the files of Stiller Application 09/101,663 and Heid Patent 5,895,628.

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RICHARD E. SCHAFER)	
Administrative Patent Judge)	
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JAMESON LEE)	BOARD OF PATENT
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)	INTERFERENCES
)	
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