
Trial Section Motions Panel
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Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JENNIFER L. HILLMAN
(5,756,332 and 09/007,306),

Junior Party,

v.

VENKATAKRISHNA SHYAMALA
(08/886,572),

Senior Party.

Interference No. 104,436

Entered: 25 April 2000

Before McKELVEY, Senior Administrative Patent Judge SCHAFER,
LEE, and TORCZON, Administrative Patent Judges

TORCZON, Administrative Patent Judge

DECISION ON RECONSIDERATION

INTRODUCTION

Hillman requests reconsideration of a panel decision (Paper No. 38) denying Hillman's preliminary motions 5-8. The decision has been reconsidered, but relief from that decision ~~is~~ denied.

FINDINGS OF FACT

1. Hillman's involved 5,756,332 patent issued from Hillman's 08/774,169 application, which has a filing date of 26 December 1996.

2. The Hillman 332 patent was not accorded the benefit of any other application when this interference was declared.

3. Hillman's involved 09/007,306 application has a filing date of 15 January 1998.

4. The Hillman 306 application was accorded the benefit of Hillman's 169 application, which has a filing date of 26 December 1996.

5. Jennifer L. Hillman is the sole named inventor on the 332 patent.

6. Jennifer L. Hillman is the sole named inventor on the 306 application.

7. Hillman moved to be accorded the benefit of patent application 08/216,595 for the present count (Prel. Mot. 5 (Paper No. 33)) and contingently for a proposed count (Prel. Mot. 7 (Paper No. 35)).

8. Hillman has moved for the benefit of patent application 08/499,410 for the present count (Prel. Mot. 6 (Paper No. 34)) and contingently for a proposed count (Prel. Mot. 8 (Paper No. 36)).

9. The 595 application names Jeffrey J. Seilhamer, Angelo M. Delegeane, and Colleen Jernigan as inventors (595 Paper No. 7).

10. The 595 application does not name Jennifer L. Hillman as a co-inventor.

11. The 410 application names Jeffrey J. Seilhamer, Angelo M. Delegeane, and Colleen Kelleher as inventors (595 Paper No. 3).

12. The 410 application does not name Jennifer L. Hillman as a co-inventor.

13. Hillman did not contend in its motions that Jennifer Hillman is or should be named as an inventor of either the 595 or the 410 applications.

14. In its request for reconsideration, Hillman does not contend that Jennifer Hillman is or should be named as an inventor of either the 595 or the 410 applications.

15. Hillman did not contend in its preliminary motions that anyone else is or should be named as an inventor of either the 332 patent or the 306 application.

16. In its request for reconsideration, Hillman does not contend that anyone else is or should be named as an inventor of either the 332 patent or the 306 application.

17. A motions panel of the Board denied Hillman's motions for benefit, without waiting for an opposition, because Hillman failed to set forth a prima facie case for relief (Paper No. 38 at 3).

DISCUSSION

Hillman argues that compliance with 37 CFR § 1.637(f) is all that is required in a motion for benefit. This proposition is simply wrong. As the format of Hillman's motions indicate, counsel was aware of at least some of the requirements of 37 CFR § 1.637(a):

A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full statement of the reasons why the relief requested should be granted. If a party files a motion for judgment under Sec. 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party.

The salient points of the rule in this context are that the movant has the burden of proof and that the motion must contain a full statement of the reasons why the relief requested should be granted. Moreover, the requirements of 37 CFR § 1.637 are

procedural, not substantive.¹ It would be impossible to list all of the substantive requirements for each kind of motion specifically and exhaustively. Consequently, 37 CFR § 1.637 should be construed to set a minimum procedural requirement, which includes among other things that the movant provide a full statement of reasons on which it intends to rely in support of its motion.

The previous decision held that:

Some overlap in inventorship is a requirement for benefit under 35 U.S.C. § 120. In re Chu, 66 F.3d 292, 297, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995). Although the scope of disclosure requirements are different for priority benefit, Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975) (a single enabled embodiment within the scope of the count will suffice to accord benefit), Hillman has not provided any reason why the overlapping inventorship requirement does not apply to priority benefit. More fundamentally, Hillman has provided no nexus between its inventor, Jennifer L. Hillman, and the disclosures in the 595 and 410 applications. Neither the Board nor Shyamala should have to wait until Hillman's reply to discover what that nexus may be.

(Paper No. 38 t 3-4, emphasis in original.) Hillman agrees that not all § 120 requirements apply to claims to priority benefit, but complains that the decision:

assumes, without statutory, rule or case citation, that all requirements of 35 U.S.C. § 120 are imported into

¹ The interference rules were promulgated under the authority of 35 U.S.C. § 6 (1984). 37 CFR Part 1, subpart E. Former section 6 did not provide substantive rulemaking authority. E.g., Merck & Co. v. Kessler 80 F.3d 1543, 1549, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996).

37 C.F.R. §1.633(f) and 37 C.F.R. §1.637(f), including the requirement of overlapping inventorship.

First, Hillman's argument attempts to shift the burden from the movant to the Board and the opponent. As noted in the decision, such a shift is not proper and will not be permitted. Second, the case law makes clear that the requirements of § 120 generally apply to claims for priority benefit². The Board has noted, and Hillman agrees, that the scope of disclosure for a claim of priority benefit is not the same as it is for claims of § 120 benefit. Nevertheless, the burden for showing any other departure from the general applicability of § 120 requirements to priority benefit determinations rests entirely on the movant. Hillman has made no effort to meet this burden³.

Finally, in the request for reconsideration, Hillman points to its preliminary statement and the common assignment of the 332 patent and the 306, 595, and 410 applications as providing a basis for granting the preliminary motions. It is sufficient to

² E.g., Hyatt v. Boone, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998) ("When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120 and 35 U.S.C. § 112 ¶ 1 for the subject matter of the count.") (footnotes omitted).

³ Hillman correctly notes that the Board must provide a rationale for its decision (Paper No. 41 at 9, citing In re Gartside, 203 F.3d 1320, 53 USPQ2d 1769 (Fed. Cir. 2000)). Hillman has no less a duty to provide a rationale for its preliminary motion.

note that none of these arguments were made in⁴, or were readily apparent from, the motions⁵. Moreover, Hillman's arguments are not consistent with its purpose. Hillman wants the benefit of the 595 and 410 "applications which constitute the earliest proofs of conception of an embodiment within the scope of the Counts" (Paper No. 41 at 8). As evidence of conception, the 595 and 410 applications appear to be analogous to a colleague's notebook⁶ rather than a benefit application. Even for evidence of conception, the party relying on such evidence must establish a nexus between the evidence and the inventor's conception. Common ownership by itself does not establish any nexu⁷s.

ORDER

Upon reconsideration of the decision on motions (Paper No. 38), it is—

⁴ Cf. Carbino v. West, 168 F.3d 32, 34 (Fed. Cir. 1999) (A late or improper presentation of an argument—even on a question of law—need not, and ordinarily should not, be considered).

⁵ Cf. Ernst Haas Studio, Inc. v. Palm Press, Inc. 164 F.3d 110, 112, 49 USPQ2d 1377, 1379 (2d Cir. 1999) (declining invitation to scour record to make out a case for a party).

⁶ E.g., Kridl v. McCormick, 105 F.3d 1446, 1451, 41 USPQ2d 1686, 1688 (Fed. Cir. 1997) (Notebook prepared under supervision of inventor provides evidence of conception).

⁷ E.g., Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co. 973 F.2d 911, 915-17, 23 USPQ2d 1921, 1924-26 (Fed. Cir. 1992) (no joint invention where inventors at same firm worked separately).

ORDERED that Hillman's request for relief from the decision
be denied.

FRED E. McKELVEY, Senior
Administrative Patent Judge

RICHARD E. SCHAFER
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

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