Paper 26

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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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NIKOLAI S. STRELCHENKO, JEFFREY M. BETTHAUSER,
GAIL L. JURGELLA, MARVIN M. PACE and MICHAEL D. BISHOP,

Junior Party,
(Application 09/357,445),

v.

KEITH HENRY STOCKMAN CAMPBELL and IAN WILMUT,

Senior Party
(Application 09/650,194).

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Patent Interference 104,809 (McK)

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**ORDER**
**(Re times for filing oppositions and replies to Campbell Preliminary Motion 1)**

Campbell has filed a preliminary motion under 37 CFR § 1.633(a) asserting that all of Strelchenko's involved claims are barred under 35 U.S.C. § 135(b). Since the motion appeared to address a threshold issue, the filing of the motion was expedited. Paper 17, p. 3. However, under the particular facts here involved, I have decided not to treat this issue as a threshold issue and authorize an opposition and reply to be filed according to the schedule and conditions set for other preliminary motions in the Appendix to Paper 17.

**DISCUSSION**

This interference is between Strelchenko Application 09/357,445 and Campbell Application 09/650,194. Campbell asserts that Strelchenko's involved claims are unpatentable under 35 U.S.C. § 135(b)(1) because those claims were not made within one year of issuance of Patent 5,945,577 to Stice. The Stice patent is not involved in this interference.[1]

With respect to the purpose of § 135(b) the Federal Circuit recently stated:

> [S]ection 135(b) was enacted to codify a legal principle akin to laches, imposing "a statute of limitations, so to speak, on interferences so that the patentee might be more secure in his property right."

In re Berger, 279 F.3d 975, 982, 61 USPQ2d 1523, 1527 (Fed. Cir. 2002) quoting Corbett v. Chisholm, 568 F.2d 759, 765, 196 USPQ 337, 342 (CCPA 1977) (emphasis added). Thus, the fundamental purpose of § 135(b) is to protect the patentee from being involved in an interference where certain conditions are met. The Stice patent is not involved in this interference. Thus, the fundamental purpose of § 135(b) of protecting the patentee from an interference is not implicated by Campbell's motion. An early decision on the motion is therefore not necessary to protect the patentee from having to prosecute this interference.

In this regard, the facts here are unlike those in Berman v. Housey, Appeal No. 01-1311 (Fed. Cir., May 29, 2002). Berman provoked and interference by substantially copying a claim from a Housey patent. An interference was declared between three Housey patents and the Berman application. Housey filed a preliminary motion asserting that Berman's sole involved claim was unpatentable under § 135(b) in view of the claims of two of the Housey patents in the interference. The Board, in response to Housey's request, agreed to take up the motion on an expedited basis ahead of any other motions. The board granted Housey's preliminary motion and terminated the interference with a judgment against Berman without consideration of Berman's motion asserting unpatentability of Housey's claims and without proceeding to the priority phase of the interference. The board reasoned that "continuation of the interference under the circumstances of this case would

[1] Campbell's application is also involved in Interference 104,746 with the Stice patent and Strelchenko's application is also involved in Interference 104,808 with the Stice patent.

be contrary to the purpose of § 135(b) to act as a stature of repose." On appeal of the board's decision the Federal Circuit affirmed stating:

> [W]e hold that § 135(b) is a threshold issue that should be addressed by the Board at the preliminary stage of an interference before proceeding to the merits, and that the Board in this case properly refused to consider Berman's unpatentability motion once it determined that Berman's claim 64 was barred under § 135(b). . . . . Housey's motion involved Berman's right to contest that he had priority of invention over the subject of the count, and thus, as discussed above, implicated the Board's authority to conduct the interference. Berman's motion , on the other hand, involved a "mere" patentability issue. As discussed above, a determination that the claims involved in an interference are not barred by § 135(b) is a condition precedent to the declaration of an interference that should be resolved before issues of priority and patentability are addressed, and thus when the board is presented with both a preliminary motion involving a § 135(b) issue and a preliminary motion involving a garden-variety patentability issue it first should address the former. . . . Because the Board should terminate an interference once it determines that there is a § 135(b) bar, the Board acts in accordance with § 135 when it refuses to address other issues of priority or patentability raised in that interference.

Berman v. Housey, 01-1311, *10-*13 (Fed. Cir., May 29, 2002) (Fed. Cir. BBS).

Unlike the facts in Berman where the patentee Housey raised the § 135(b) issue to terminate the interference involving Housey's patents, the 135(b) question is raised by an applicant with respect to a patent not involved in this interference. Granting this motion will not necessarily prevent Stice from having to defend an interference. Granting Campbell's motion will not result in termination of this interference. Under the particular facts of this case, Campbell's motion is more akin to a "'mere' patentability issue," than to an application of a statute of limitation or repose in favor of Stice.

I recognize that Berman is binding precedent, however, the significant difference in facts militates a different result. As the Federal Circuit has noted:

> Undue liberties should not be taken with court decisions, which should be construed in accordance with the precise issue before the court, and . . . a fertile source of error in patent law is the misapplication of a sound legal principle established in one case to another case in which the facts are essentially different and the principle has no application whatsoever.

FMC Corp. v. Manitowoc Co., 835 F.2d 1411, 1417 n.12, 5 USPQ2d 1112 , 1117 n.12 (Fed. Cir. 1987) quoting In re Ruscetta, 255 F.2d 687, 689, 118 USPQ 101, 103 (CCPA 1958).

Under the paticular facts of this interference, I see no reason to continue to expedite proceedings on Campbell's motion.

An opposition and reply may be filed according to the schedule set in the Appendix to Paper 17.

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