This opinion is not binding precedent of the Board.

Paper 75

Filed: January 30, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

WANG,
FINER and JIA

Junior Party,

v.

KOVESDI,
BROUGH, MCVEY, BRUDER and LIZONOVA

Senior Party
Application 08/258,416

Patent Interference No. 104,825 (CAS)

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

SPIEGEL, Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
(Decision on Wang motion to file a corrected preliminary statement)

Wang has filed WANG MOTION TO SUBSTITUTE A NEW PRELIMINARY STATEMENT (Paper 74) seeking to file WANG CORRECTED PRELIMINARY STATEMENT (Ex 2046). The motion is denied.

I. Background

Junior party, Wang, Finer and Jia (**Wang**) is involved in the interference on the basis of U.S. application * * *, filed November 3, 1994.

Senior party, Kovesdi, Brough, McVey, Bruder and Lizonova (**Kovesdi**) is involved in the interference on the basis of U.S. application * * *, filed June 10, 1994.

Interference 104,825 was declared on March 8, 2002 and defined by six (6) counts.

Wang filed its preliminary statement on October 7, 2002 (Paper 41).

Kovesdi filed its preliminary statement on October 7, 2002 (Paper 46).

As to counts 1-6, Kovesdi alleged dates of first drawing, first description, first disclosure, first conception and diligence from on or before April 8, 1993. As to counts 1-3, 5 and 6, Kovesdi alleged dates of first constructive reduction to practice of its filing date, June 10, 1994. As to count 4, Kovesdi alleged a date of actual reduction to practice of November 15, 1993.

The following dates are alleged in Wang's original and corrected preliminary statements and are common to all six counts:

	Wang's original statement	Wang's corrected statement
First drawing	N/A	N/A
First written description	November 5, 1993	January 6, 1993
First disclosure to others	no later than November 5, 1993	no later than January 6, 1993
First conception	no later than November 5, 1993	no later than October 15, 1992
First reduction to practice	on or about November 30, 1993	on or about January 11, 1993
Diligence from	on or about November 5, 1993	on or about October 15, 1992

Thus, Wang is attempting to carry its dates of invention, which were subsequent to Kovesdi's dates to dates prior thereto, after having had access to Kovesdi's preliminary statement.

II. Legal Standard

According to 37 CFR 1.628(a)

> A material error arising through inadvertence or mistake in connection with a preliminary statement or drawings or a written description submitted therewith or omitted therefrom may be corrected by a motion (§ 1.635) for leave to file a corrected statement. The motion shall be supported by an affidavit stating the date the error was first discovered, shall be accompanied by the corrected statement and shall be filed as soon as practical after discovery of the error. If filed on or after the date set by the administrative patent judge for service of preliminary statements, the motion shall also show that correction of the error is essential to the interest of justice.

Case law indicates that a motion to amend a preliminary statement must include evidence that the movant was not negligent in preparing the original statement and that the error could not have been avoided by the exercise of due care. See e.g., Methudy v. Roy, 65 F.2d 171,173, 17 USPQ 505, 508 (CCPA 1933) ("We think it proper that he be required to show that he exercised every reasonable care and proper diligence in the preparation of his original statement to avoid error therein ... ."); Holslag v. Steinert, 143 F.2d 661, 664, 62 USPQ 77, 80 (CCPA 1944) ("...[the movant] must establish with reasonable certainty that the errors in his preliminary statement could not have been avoided by the exercise of reasonable care,"); Fleming v. Bosch, 181 USPQ 761, 763 (Bd. Pat. Interf. 1973) ("This rule [Rule 222, the predecessor to Rule 628] has been interpreted to require a showing demonstrating that the moving party was not negligent

in preparing the original preliminary statement and that the error could not have been avoided by the exercise of due care ... ".)

Further, the correction must be "essential to the interest of justice". Thus, the relevant inquiries include not only why the amendment to the preliminary statement is needed, but also how can an opponent be prejudiced by the amendment sought to be made. See e.g., Rose v. Frazer, 61 USPQ2d 1606, 1606-07 (BPAI 2001).

For example, where one party moves to amend his dates of invention after having had access to the dates of his opponent or after priority testimony has been taken, a stricter, more convincing showing is necessary. See e.g., Methudy, 17 USPQ at 508 ("Therefore he who, in an interference proceeding, obtains access to the dates of his opponent, and seeks thereafter to change practically the entire context of his own sworn statement made before knowledge of his opponent's dates, properly is held to strictest accountability."); Myers v. Roethel, 90 F.2d 122, 124, 33 USPQ 587, 589-90 (CCPA 1937) (in affirming the decision of the Board of Appeals, the court quoted the statement of the Examiner of Interference that "This motion [to amend his preliminary statement to allege an earlier date of reduction to practice] was filed after Roethel had given testimony and could, therefore, be granted only on a most convincing showing."); Winter v. Lebourg, 394 F.2d 575, 579, 157 USPQ 574, 577 (CCPA 1968) ("As was stated in Borg v. Strauss, 1907 C.D. 320, 130 O.G. 2719: '* * * Amendments to preliminary statements are to be permitted after a party has had an opportunity to inspect his opponent's case only in cases where bona fide mistakes of fact have been made and a full and clear showing is made that there was no negligence in discovering

the true facts.'"); Adams v. St. Pierre v. Stuller, 72 USPQ 364, 365 (Comm'r Pat. 1934) ("It is well settled that where, after seeing his opponent's preliminary statement, a party attempts to carry back his dates which were subsequent to that of his opponent to dates prior thereto, his motion to so amend must be supported by very convincing reasons."). On the other hand, in the Notice of Final Rule, Patent Appeal and Interference Practice, 60 Fed. Reg. 14488, 14505 (col. 2) (March 17, 1995), the USPTO stated "Where the moving party has not yet seen the opponent's statement, an opponent normally will not be prejudiced by the filing of a corrected statement."

III. Analysis

A. The alleged error is material

An error in dates of invention alleged in a preliminary statement is material to an interference proceeding. The essence of an interference proceeding is to determine who was first to invent the subject matter of the count(s). Insomuch as a preliminary statement serves to limit a party's proofs as to time, an error in the preliminary statement is a material error. See Botnen v. Dorman, 179 F.2d 249, 252, 84 USPQ 270, 273 (CCPA 1950) ("The board, citing Brydle v. Honigbaum, 19 C.C.P.A. (Patents) 773, 54 F.2d 147, 11 USPQ 219, correctly held that testimony and exhibits tending to prove earlier dates than those named in preliminary statements are admissible, but that they will not establish any date or dates prior to the date or dates alleged in such statements."); 37 CFR § 1.629.

B. The Declaration of Linda Judge is insufficient to establish that Wang was not negligent in preparing the original statement and that the error could not have been avoided by the exercise of due care

Wang's motion is supported by a "Declaration of Linda Judge," who is patent counsel for Cell Genesys, Inc. (CGI), Wang's real party-in-interest (Ex 2024, ¶ 1).

According to Ms. Judge, she has been responsible for the prosecution of patent applications which named party Wang as inventors since sometime prior to January 2002 (Ex 2024, ¶ 2). As part of that responsibility, Ms Judge testified that she had asked Mara Matsumura, archive Librarian for CGI, "for all notebook records and other invention records of Wang, Finer and Jia" and was provided with Finer notebooks #13 and #14 and Wang notebook #163 (Ex 2024, ¶¶ 3-4). The exact date and wording of the request to Mara Matsumura is not of record. However, the request date appears to be between January 2002 and March of 2002, when the interference was declared (Ex 2024, ¶¶ 3 and 6).

Ms. Judge further testified that

> [f]rom a time beginning about January, 2002, and continuing to present day[1], an effort has been underway to establish a more permanent and condensed form of notebook storage, either by scanning, or microfilm/fiche, and transfer of notebooks offsite. This process was still incomplete as of June, 2002. As of June, 2002, all notebooks at Cell Genesys, Inc., were not present in the archives, either because they had not yet been collected, or had been collected and were not yet catalogued. [Ex 2024, ¶ 5]
>
> Subsequent to my receipt of the notebooks in response to my request to the librarian, and confirmation that all notebooks had been received, the above-captioned interference was declared, in March, 2002. After retaining patent counsel, and being requested to identify the earliest

[1] The Judge Declaration is dated November 19, 2002 (Ex 2024, p. 5).

> evidence of a date of invention of subject matter of the count of the interference, I reviewed the same notebooks that I had been provided, with the knowledge that I had received all the notebooks at Cell Genesys, Inc. for the inventors of the Junior Party, Wang et al. I also placed a request with Maria Trumbull, secretary to the Chief Executive Office of Cell Genesys and with Susan Bryant, secretary to the Vice-President of Research and Development of Cell Genesys for any Scientific Advisory Board or other presentation materials that related to deleted adenoviruse for the time period from 1992 through 1995. I placed a further request with Chris McKinley, Vice-President of Human Resources for Cell Genesys, that she evaluate the performance reviews of Wang, Finer and Jia for evidence of project goals relating to deleted adenovirus. In each case, I reviewed the archived materials together with [sic, a] relevant individual. A copy of a presentation by * * * Wang from November of 1994 was found in the Research and Development files and evidence of research goals directed to deleted adenovirus was found in performance reviews for * * * Wang dated January of 1994 and January of 1995, respectively. These materials were reviewed, and resulted in preparation of the current Preliminary Statement, a copy of which is attached hereto as Exhibit 1, identifying November, 1993 as the earliest date of invention. [Ex 2024, ¶ 6]

Ms. Judge still further testified that, in preparing for a scheduled November 5, 2002 teleconference, she "came across some notes entered into a related file by my predecessor," attached as Exhibit 2 to Ex 2024, "suggesting that there must be notebooks other than the ones he had reviewed, which gave, according to his notes, a date of invention not dissimilar from that reflected in the attached Preliminary Statement" (Ex 2024, ¶7). According to Ms. Judge, it was the discovery of her predecessor's notes that prompted her to go back to the archive librarian, now Dennis Harper, "to ensure that the notebooks I had been provided earlier were all the notebooks by the inventors Wang, Finer and Jia, possibly relevant, as my predecessor's notes indicated there must be more" (Ex 2024, ¶ 8).

First, it is unclear why Ms. Judge believed that she had received all of party Wang's notebooks given that CGI was in the midst of a process of archiving its notebooks, i.e., what "confirmation" did she have that all party Wang notebooks had been received. Ms. Judge did not testify what her personal knowledge of the status of CGI's archiving project was, e.g., whether archiving was incomplete in general or whether archiving was completed as to certain sections, laboratories, projects, etc. and we will not guess what it might have been. There is no testimony from either library archivist or the other "relevant" individuals. We have only the testimony of one patent attorney.

Alternatively, it is incongruous to search the library and the offices of the CEO, of R&D and of human resources for information on the three Wang inventors and/or deletion adenovirus materials, but not to search related in house patent application files. Put another way, Wang's failure to consider in house patent files naming a Wang inventor and/or deletion adenovirus subject matter raises serious doubts about the thoroughness of its search, despite the many places it says were searched.

Therefore, given the important effects a preliminary statement has on an interference and Wang's access to Kovesdi's preliminary statement, Wang has failed to meet its burden of proof to show that it is entitled to the relief requested.

C. Wang has not shown that correction is essential to the interest justice

Wang argues that if Kovesdi establishes an April 8, 1993 date of invention, Wang will be unable to demonstrate an earlier date of invention (Paper 74, p. 8). This is precisely why preparation of a preliminary statement requires diligent exercise of due

care in the first instance. However, for the reasons stated above, the Judge Declaration is insufficient to establish diligent exercise of due care in the first instance.

Wang further argues that Kovesdi is not prejudiced because Kovesdi prepared its preliminary motions and statement without regard to Wang's date of invention and before any priority testimony. Furthermore, according to Wang, Kovesdi itself contemplated the possibility that asserted dates of invention might change because Kovesdi seeks to redefine the interfering subject matter. [Paper 74, pp. 9-10.] First, we decline to speculate on what Kovesdi's strategy may or may not have been. Kovesdi has already expended considerable time and effort in filing its preliminary motions and statement. Second, we note that Kovesdi's preliminary motion to redefine the interfering subject matter seeks to designate certain Kovesdi claims as not corresponding to any count. Kovesdi's motion is neither opposed by Wang nor changes the interfering subject matter defined by present counts 1 through 6. Therefore, these arguments are not persuasive.

IV. Order

Upon consideration of Wang's motion to substitute a new preliminary statement, and for the reasons given, it is

ORDERED that Wang's motion is **denied**.

RICHARD E. SHAFER Administrative Patent Judge	)	
RICHARD TORCZON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CAROL A. SPIEGEL Administrative Patent Judge	)	

Wang
(real party in interest
CELL GENESYS, INC.):

Steven B. Kelber, Esq.
PIPER MARBURY RUDNICK & WOLFE LLP

Linda R. Judge, Esq.
CELL GENESYS, INC.

Kosvedi
(real party in interest
GENVEC, INC.):

John Kilyk, Jr., Esq.
Bruce M. Gagala, Esq.
Jeffrey B. Burgan, Esq.
Heather R. Kissling, Esq.
LEYDIG, VOIT & MAYER, LTD.