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Paper 126
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UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,496

CALIFORNIA INSTITUTE OF TECHNOLOGY
(5,821,058),
Junior Party,

v.

ENZO LIFE SCIENCES, INC.
(08/486,069),
Senior Party.

Before JAMES T. MOORE, *Acting Chief Administrative Patent Judge*, and SALLY G. LANE, RICHARD E. SCHAFER, JAMESON LEE, RICHARD TORCZON, SALLY C. MEDLEY, and MICHAEL P. TIERNEY, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION
Bd.R. 125
on motion

The senior party (Enzo) seeks relief in the form of removing the record of this interference from the Board's interference web portal[1] and from any other public forum that the Office operates or controls.[2] The junior party (CIT) does not oppose.[3] The relief is DENIED.

OPINION

I. FACTS AND FINDINGS

[1] Enzo's 08/486,069 application is involved in this interference.[4]

[2] The involved application was filed on 7 June 1995.[5]

[3] Enzo states that its application has not been published and is not otherwise available.[6]

The Board is not aware of a general exception to Enzo's statement prior to the release of the interference record after judgment in this interference, but Enzo's involved application was released to CIT pursuant to a rule.[7]

[4] CIT's 5,821,058 patent is involved in this interference.[8]

[5] The involved patent issued to the public on 13 October 1998.[9]

[6] A judgment was entered in this interference on 22 September 2010.[10]

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[1] https://acts.uspto.gov/ifiling/PublicView.jsp.
[2] Paper 124 at 1.
[3] *Id*. at 1 n.1.
[4] Paper 1 at 3.
[5] Exh. 1049: Request for filing a continuation application, *Hybridization assay method*, U.S. Patent Appl'n [08/]486,069 (filed 7 June 1995).
[6] Paper 124 at 1, mat'l facts 2-4.
[7] Paper 13 (Order) (authorizing copies to the parties under Bd.R. 109(b)).
[8] Paper 1 at 2.
[9] Exh. 1002: L.M. Smith et al., *Automated DNA sequencing technique*, U.S. Patent 5,821,058 (iss'd 13 October 1998), cover page.
[10] Paper 122.

[7] The judgment was entered against Enzo for count 1, the sole count.

[8] As a result, all of claims Enzo's involved application except certain listed claims were finally refused pursuant to 35 U.S.C. 135(a).

II. DISCUSSION

A. Statutory confidentiality

Under 35 U.S.C. 122(a), the Office holds a patent application in confidence unless certain exceptions are met. The major exception arises in the next subsection of the statute itself, which effectively provides for the publication of most applications no later than eighteen months after they are filed.[11] Enzo's involved application is not subject to this exception because it was filed before the effective date of the statute adding all of the subsections after subsection (a).[12]

The statute provides other exceptions, however. First, the applicant or application owner may consent to publication. Second, publication is permitted if necessary to carry out the provisions of an Act of Congress. Third, the Director may determine that special circumstances warrant publication.[13] Enzo's motion makes clear that Enzo does not consent to publication of its involved application. The remaining exceptions warrant closer examination.

B. Rule-based exceptions

Although the patent system is over two hundred years old, statutory confidentiality dates only to the 1952 Patent Act, which enacted what is now

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[11] 35 U.S.C. 122(b) (Publication).
[12] Pub. L. 106-113, Div. B, § 1000(a)(9) (applying publication provision to applications filed on or after 29 November 2000).
[13] § 122(a).

§ 122(a). Previously, application confidentiality was a creation of Patent Office rules. As P.J. Federico, one of the drafters of the Act, explains in his famous commentary, the statute was intended simply to codify the existing practice.[14] Federico notes several exceptions to confidentiality:

> patent interferences, including notice of the application and then availability of the application itself to the adverse party;
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> judicial review, where the default is for the record to be public;
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> national security, where defense agencies may review applications; and
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> patents, where not only the application resulting in the patent, but also any application to which it claims benefit, become public.

The interference exception already occurred in this case as previously noted. The national security exception may have occurred, although it is difficult to determine from this record. The judicial exception will occur if there is judicial review unless a party succeeds in moving to have the application placed under seal.

The Office rules provide a process for case-by-case determinations.[15] They provide at least two categorical "special circumstance" exceptions as well.

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[14] P.J. Federico, Commentary on the New Patent Act (1953), *available at* http://ipmall.info/hosted_resources/lipa/patents/federico-commentary.asp#Application_for_Patent (visited 20 Oct. 2010) at "Confidential status of applications (section 122)": "Section 122 is a new section which enacts as part of the statute the rule of secrecy of patent applications which has been in the Patent Office rules in one form or another for about a hundred years."

[15] 37 C.F.R. § 1.14(a)(1)(i) (2010). Unless otherwise noted, all references are to current rules.

1. Reissue applications

A reissue application must arise from a previously issued patent.[16] It is open to the public[17] even though § 122(a) does not distinguish between regular applications and reissue applications.[18] As a policy matter, the exception makes sense since there are relatively few reissue applications, the invention disclosure has already been published in a patent, and such an application may change the public record in a case of public interest. The original rule making noted that this change in the rules was favored in public comments except for concern about a lack of statutory authority. The rulemaking expressly grounded the rule on the "special circumstance" provision of § 122.[19]

2. Interference records

A similar exception has existed even longer for applications appearing in the record of an interference. The interference record is public by default.[20] The exception to this default publication arises when an involved application is not publicly available.[21] Even then, once the interference ends with a judgment, if the interference involved a patent or if an involved application becomes public, the record becomes public.[22] This exception predates the current secrecy statute.

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[16] 35 U.S.C. 251.
[17] 37 C.F.R. § 1.11(b).
[18] 35 U.S.C. 122(a).
[19] Final Rule, *Patent Examining and Appeal Procedures*, 42 Fed. Reg. 5588, 5588 (28 January 1977).
[20] 37 C.F.R. § 1.11(e). Indeed, most are freely available on the Board's interference web portal.
[21] Bd.R. 6(b)(1).
[22] Bd.R. 6(b)(2).

In 1948, Patent Rules 15 and 16 provided:

> 15. Pending applications are preserved in secrecy. No information will be given, without authority, respecting the filing by any particular person of an application for a patent or for a reissue of a patent, the pendency of a particular case before the office, or the subject matter of any particular application, unless it shall be necessary to the proper conduct of business before the office, as provided by rules [list omitted].
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> 16. After a patent has issued, the model, specification, drawings, and all documents relating to the case are subject to general inspection, and copies, except of the model, will be furnished at the rates specified in [another rule].

Note that under Rule 15, even reissue applications were held in confidence. Rule 16 ensured the essential feature of a patent, its openness, by making "all documents relating to the" patent publicly available.

Effective 1 March 1949, Rule 15 was modified and expanded to provide more detail and to state expressly the national security exception. Rule 16, however, was moved to Rule 11 with a significant clarification:[23]

> After a patent has been issued, the specification, drawings, and all papers relating to the case in the file of the patent are open to public inspection by the general public, and copies may be furnished upon payment therefore. *The file of any terminated interference involving a patent*, or an application on which a patent has subsequently issued, *is similarly open to public inspection and procurement of copies*.

In the 1940s, rule making was much terser than now, so unfortunately there is not much guidance on why the rule was changed. A contemporaneous

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[23] Final Rule, *Certain Amendments and Additions to Regulations*, 13 Fed. Reg. 9575 (31 Dec. 1948) (emphases added).

treatise, however, explains that the new sentence simply reflected existing practice:[24]

> Rule 11, first sentence, is a recasting of old Rule 16…; the other sentence is new, but states old practice.

It may be significant that the clarification in the rule arose at a time of growing public concern about abuses occurring under a veil of secrecy in settling interferences. In 1945, the Supreme Court declined to enforce a patent that issued on an application after misconduct in an interference that came to light during an infringement suit.[25] In 1962, Congress added 35 U.S.C. 135(c) to require interference parties to put their agreement into writing and file it with the Office.[26] Subsection (c) provides for qualified confidentiality upon request, reflecting the understanding that the agreement would otherwise become public with the rest of the record.

The current practice of opening the interference record after judgment whenever a patent is involved was already established when application confidentiality was first enacted in 1952. The practice makes sense because an interference may play a substantial role in the evolution of patent claims. Hence, the interference record may be as vital as any other part of the prosecution history to understanding the scope and meaning of a claim. In any case, the practice is facially consistent with the two Director-vested exceptions in § 122(a). We are not aware of any reason to believe Congress meant to end the practice when enacting § 122 in 1952. If anything, the

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[24] A.R. McCrady, Patent Office Practice 19 (1950).
[25] *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816-19 (1945)
[26] S. Rep. 87-2169 (1962), *reprinted in* 1962 U.S.C.C.A.N. 3286, 3286.

authorities indicate that this practice has long been understood to be consistent with regulatory and statutory confidentiality of applications.

C. Enzo's argument

1. Board Rule 6(b)(2)

Enzo argues that publication of the record in the present interference was inconsistent with Board Rule 6(b),[27] which provides:

> (b) *Record of proceeding*. (1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.
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> (2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under §1.11 of this title or an involved application is or becomes published under §§1.211 to 1.221 of this title.

Paragraph (b)(1) explains the default that the record of a Board proceeding is available to the public. It also explains the exception to this default, which applies when a patent application is not otherwise available to the public. Such was apparently the case for Enzo's involved application, which is why the record was not publicly available earlier. Paragraph (b)(2) provides a negation of the exception, however, once a judgment issues. The negation applies "if any involved file is…open to the public under § 1.11 of this title". The 1948 Rule 11 discussed above is the lineal antecedent of the 37 C.F.R. § 1.11, which provides that:

> (a) The specification, drawings, and all papers relating to the file of:…a patent…are open to inspection by the public….

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[27] Paper 124 at 3.

CIT's patent is thus open to the public, as are all papers relating to it. Enzo's application was the reason for confidentiality under Board Rule 6(b)(1): it is CIT's patent, not Enzo's application, that operated as the trigger for publication under Board Rule 6(b)(2) once a judgment was entered. Enzo's motion does not address the relevance of CIT's patent.

2. Standard Operating Procedure 2

Enzo also cites[28] to a Board standard operating procedure for the proposition that:[29]

> All opinions in support of a final decision will be posted at: http://des.uspto.gov/Foia/BPAIReadingRoom.jsp unless the opinion is subject to confidentiality protections under 35 U.S.C. § 122(a) or secrecy under 35 U.S.C. § 181.

The SOP does not support Enzo's contention. On its face, the SOP is directed to final Board *opinions* generally, rather than interference *records* specifically, in an effort to comply with the Freedom of Information Act.[30] Indeed, the postings at the FOIA BPAI Reading Room site are final decisions from various Board proceedings rather than entire records. In general, FOIA operates to facilitate publication rather than confidentiality.

Moreover, the exception in the SOP is expressly grounded on § 122(a). Board Rule 6(b) provides the relevant application of § 122(a) to Board records. The SOP does not purport to overturn the rule; quite to the

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[28] *Id*.
[29] *Publication of opinions and binding precedent*, Standard Operating Procedure 2 [SOP] 7 (rev. 7, 2008).
[30] 5 U.S.C. 552 [FOIA], especially § 552(a)(2)(A) (requiring public availability of final opinions, electronically after 1996).

contrary, it expressly states that "It does not create any legally enforceable rights."[31]

III.CONCLUSION AND HOLDING

On this record, publication of the interference record appears to have been not only appropriate, but actually required under Board Rule 6(b). Enzo's motion misses the significance of the involvement of CIT's patent for purposes of publication. The authorities on which Enzo relies do not compel a different conclusion.

Board support staff did not abuse their authority in publishing the record for this interference after judgment was entered.

cc:

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For Enzo Life Sciences, Inc.: Robert M. Schulman, HUNTON & WILLIAMS, LLP, of Washington, D.C., with Scott F. Yarnell of McLean, Virginia and Robert C. Lampe, III of Washington, D.C.; and with Eugene C. Rzucidlo of Alexandria, Virginia; and with Ronald C. Fedus, ENZO BIOCHEM, INC., of New York City, New York.

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[31] SOP 2 at 1.