BoxInterference@uspto.gov
Tel: 571-272-4683

Paper 145
Entered 25 January 2008

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

ELAZAR **RABBANI**, JANNIS G. STAVRIANOPOULOS, JAMES J. DONEGAN, JACK COLEMAN and MARLEEN WALNER,

Junior Party
(Application 10/306,990),

v.

TSUGUNORI **NOTOMI** and TETSU HASE,

Senior Party
(Patent 6,410,278 B1)
(Patent 6,974,670 B2).

Patent Interference 105,427—McK
Patent Interference 105,432—McK
Technology Center 1600

Before: McKELVEY, *Senior Administrative Patent Judge*, and TORCZON and MOORE, *Administrative Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

MEMORANDUM OPINION and ORDER
Denying Rabbini Miscellaneous Motion 5

A. Statement of the case

The interference is in the priority phase.

Rabbani filed a motion for judgment based on priority of invention.

The motion and evidence in support of the motion were served on Notomi.

Notomi filed an opposition.

The opposition and evidence in support of the opposition were served on Rabbani.

During a conference call on 29 November 2007, it came to the attention of the Board that Rabbani intended to file a reply.

In support of the reply, Rabbani indicated an intent to rely on declaration evidence to "counter" declaration evidence offered by Notomi in its opposition.

Since evidence relating to priority is almost always in the possession of the party offering the evidence, a suggestion was made by Notomi that the probably reason to file declaration evidence in support of a reply on the issue of priority connection was to overcome some shortcoming in the initial priority case made out in the motion.

The suggestion made considerable sense to the Board.

The Federal Rules of Evidence apply to interference proceedings. 37 C.F.R. § 41.152(a) (2007).

Fed. R. Evid. 403 provides that evidence may be excluded if its probative value is outweighed by the danger of unfair prejudice or by considerations of undue delay, waste of time, or needless presentation of cumulative evidence. The rule is consistent with Board policy, established through a rule promulgated by the Director, that interference rules are to be interpreted to achieve a just, speedy, and inexpensive resolution of an interference. 37 C.F.R. § 41.1(b) (2007).

The rules also preclude raising new arguments in replies. 37 C.F.R. § 41.122(b) (2007).

The Board authorized Rabbani to file a motion *in limine* seeking a determination whether declaration evidence could be filed with any Rabbani reply. 37 C.F.R. § 41.155(d) (2007)

Rabbani's motion is before the Board as RABBANI MISCELLANEOUS MOTION 5. Paper 139.

Notomi has filed an opposition. Paper 140.

A reply was not authorized.

B. Discussion

In support of its opposition, Notomi has offered the testimony of Dr. Gerald F. Joyce (Ex 2042).

In the motion, Rabbani characterizes Dr. Joyce as Notomi's "expert". Paper 139, page 1:17.

According to Rabbani, Dr. Joyce "has not meaningfully addressed the substance of the evidence [offered by Rabbani] supporting Rabbani's motion [judgment based on] … priority." Paper 139, page 1:17-18.

Further according to Rabbani, "Dr. Joyce prefers to disregard Rabbani's submitted evidence and even denies the existence of … notebook data as being evidence." Paper 139, page 1:18-19.

Instead, it is said by Rabbani that "Dr. Joyce relies on scientifically unsupported opinions and blanket assertions that Dr. Donegan's notebooks do not describe the methods of the Counts. The proffered declaration testimony will set the record straight." Paper 139, page 1:19-21.

The declaration evidence would consist of declarations by (1) Dr. Jim Donegan (a named inventor who previously has testified) and (2) Dr. Keith Backman (a brand new witnesses who did not earlier testify). Paper 139, page 1:23.

According to Rabbani, Dr. Donegan would generally testify to the evidence in his laboratory notebooks (Ex 1073 and Ex 1074), which are said to support an actual reduction to practice. Paper 139, page 2:1-2.

Further according to Rabbani, Dr. Backman would testify as to the conclusions that one of ordinary skill in the art would reach from an examination of Dr. Donegan's lab notebooks.

Rabbani represents that Notomi's opposition relies extensively on Dr. Joyce's declaration testimony to support its arguments that Rabbani has not adequately made out its priority case. Paper 139, page 2:12-14.

Pointing out the obvious, Rabbani argues that it could not have earlier presented the proffered declaration evidence because Dr. Joyce had not yet testified when Rabbani filed its motion for judgment. Paper 139, page 2:17-20.

It is well-established practice at the Board that in presenting a motion for relief, a moving party must make out a *prima facie* case for relief. *See, e.g.*, *Stampa v. Jackson*, 78 USPQ2d 1567, 1571, 1574 (Bd. Pat. App. & Int. 2005); *Stice v. Campbell*, 76 USPQ2d 1101, 1110 (Bd. Pat. App. & Int. 2004); *Glaxo Wellcome, Inc. v. Cabilly*, 58 USPQ2d 1859, 1861 (Bd. Pat. App. & Int. 2001); *LeVeen v. Edwards*, 57 USPQ2d 1416, 1422 (Bd. Pat. App. & Int. 2000). If a *prima facie* case is not made out in the motion, it cannot be made out in a reply. 37 C.F.R. § 41.122(b) (2007) (first sentence). In the case of priority, where priority evidence is generally in the possession of the moving party, there should be little, if any, occasion to file declaration evidence in support of a reply. Since an opponent has no right to respond to a reply, there exists a real danger, whether intentionally or inadvertently, that a moving party supplementing its priority case when filing declaration evidence in support of the reply will raise new factual issues.

In its motion, Rabbani explains why it believes testimony is needed to "reply" to paragraphs 3 and 5-15 of the Joyce declaration testimony. In deciding the motion, we have not read Dr. Joyce's testimony. Rather, we have considered the motion on the basis of the representations made by Rabbani in the motion.

Paragraph 3 of the Joyce testimony

According to Rabbani, in ¶ 3 of the Joyce testimony, Dr. Joyce states that the quality of the copies of the lab notebooks is very poor and what appear to be photographs of gels are so poorly reproduced that Dr. Joyce could not clearly see much of what is on them. Paper 139, page 3:1-3.

Rabbani proposes to have Dr. Donegan and Dr. Backman testify that one skilled in the art would be able to discern features on the pages of the lab notebooks and photographs of the gels. It was Rabbani's obligation to put clear documents in front of the Board and to explain those documents with its motion for priority. If Rabbani is to be believed, then according to Rabbani, Dr. Joyce had some trouble with the documents apparently finding them not to be clear enough to decipher. The "remedy" was to cross-examine Dr. Joyce to determine precisely what Dr. Joyce could not decipher

Rabbani proposes to have not one witness, but two witnesses, tell us that the documents are clear. The need for two witnesses is not satisfactorily explained and seems inconsistent with both Fed. R. Evid. 403 and 37 C.F.R. § 41.1(b) (2007). No imagination is needed to figure out that Rabbani's use of two witnesses would mean that Notomi might have to cross-examine two witnesses, which at this stage of the interference strikes us as unduly burdensome. Moreover, if it turned out on cross-examination that the documents are clear, then Notomi would have to recall Dr. Joyce to obtain his observations with respect to the reply testimony of the two witnesses.

One can speculate that there would never be an end to the need to get more evidence. Rabbani's witnesses should have testified why the documents make out a *prima facie* case. Dr. Joyce testified why they do not. We have to determine whether to credit Rabbani's witnesses or Dr. Joyce. We do not need any help from a reply witnesses to do so. Presumably Notomi pointed out in its opposition why Dr. Joyce is the more credible witness. Rabbani may point out in its reply why Dr. Joyce is not the more credible witness.

According to Notomi's opposition, Notomi objected to the admissibility of the "unclear" lab notebooks. Paper 140, page 4:6-7. Rabbani did not exercise its options of responding with "clear" lab notebooks. 37 C.F.R. § 41.155(b)(2) (2007). Having failed to exercise its option, Rabbani is in no position at this point to come in with clear lab notebooks or attempt to explain what Notomi characterizes as "unclear" lab notebooks.

Paragraph 5 of the Joyce testimony

Rabbani tells us that reply testimony is needed to establishing that the lab notebook (Ex 1073) contains evidence that a PCR experiment successfully produced sequences containing a portion of the HBV template with sequences on either end capable of forming stem-loops under suitable conditions. What Rabbani now seeks to establish at the reply stage should have been established at the motion stage.

Paragraph 6 of the Joyce testimony

In paragraph 6, Dr. Joyce is said to have been unable to find any data indicating why bands produced actually correspond to a single-stranded molecule having a stem-loop structure at each end. If that data is necessary to an actual reduction to practice, then it should have been fully presented as part of the motion for judgment.

Paragraph 7 of the Joyce testimony

In paragraph 7, Dr. Joyce is said to have been unable to find that as of June 1998 that Dr. Donegan knew the nature of what is referred to as a 210 base pair piece. Assuming knowledge of the nature of the 210 base pairs piece is relevant, it should have been fully discussed in the motion for judgment.

Paragraph 8 of the Joyce testimony

Rabbani indicates that Dr. Joyce cited a portion of a Donegan lab notebook which states that one of the things "we haven't clear [sic] established" is the nature of the high MW DNA that appears after amplification. Rabbani further indicates that based on the cited portion, Dr. Donegan may not have known for certain what his results signified. The reply declaration testimony would show, says Rabbani, that the overall results support a conclusion that the higher molecular weight (high MW) amplification products were concatemeric in nature and therefore Dr. Donegan appreciated what he had.

A statement in a lab notebook which an opponent might reasonably be expected to discuss to maintain that an inventor did not appreciate the nature of the invention is something which needs to be dealt with in direct testimony. Waiting until the reply stage of an interference to see if an opponent might rely upon a negative inference in a lab notebook amounts, in effect, to sandbagging the opponent. Invariably, new argument is likely to creep into the reply if the matter is not address when the motion is presented.

Paragraph 9 of the Joyce testimony

According to Rabbani, Dr. Joyce states that he found nothing at page 162 of Ex 1073 to indicate that at the time Dr. Donegan performed experiments recorded there that he believed that any of the amplification products corresponded to an amplicon with a stem-loop at each end.

Rabbani tells us that the reply declaration testimony will reveal that Dr. Joyce considered only one page of several pages describing the relevant experiment. Presumably the direct priority evidence discusses the "several" pages. An attorney in a reply can state why Dr. Joyce should not be credited by noting that he considered only one page of several pages.

Paragraph 10 of the Joyce testimony

Dr. Joyce is said to have stated that Dr. Donegan does not point to any evidence in his notebook or elsewhere to support an assertion in his declaration. The reply declaration evidence would tell us where Dr. Donegan did so in addition to explaining scientifically why what was pointed to justifies Rabbani's priority case. Again, this issue may be addressed in the reply argument. Dr. Donegan either pointed to evidence in his notebook or he did not. If he did not, then he cannot do so in a reply declaration. If he did, then Dr. Joyce is wrong.

Paragraph 11 of the Joyce testimony

Dr. Joyce is said to have said that he can find no data, observations, or other evidence in lab notebooks that show Dr. Donegan conducted any experiments to demonstrate a particular point. The reply declarations would point to the relevant data, observations, and other evidence. In particular, we are told that the reply declaration testimony would show where those notebooks "demonstrate that strand displacement took place." Paper 139,

page 7:1. Calling the data, observations, and other evidence to our attention is something which needed to take place in the motion for judgment.

Paragraph 12 of the Joyce testimony

Dr. Joyce is said to have said that he could see no data or other observation set forth in Dr. Donegan's lab notebooks demonstrating that certain amplification took place. If amplification is relevant, then surely it would have been called to our attention in the motion. An explanation at the reply stage "that the isothermal amplifications occurred" comes too late.

Paragraph 13 of the Joyce testimony

Rabbani advises that Dr. Joyce states that nowhere in Dr. Donegan's notebook is there any indication of the significance of the statement "the lowest band of the ladder looks like its (sic [—it's]) in the appropriate space." Paper 139, page 7:19-20 [bracketed matter added].

If being in the right place is significant to priority, then it should have been explained with the motion. If it is not significant, then counsel can tell us so in the reply brief.

Paragraph 14 of the Joyce testimony

According to Rabbani, Dr. Joyce says there is no data to support a particular conclusion. The reply declarations would explain otherwise. If the conclusion is important to priority, it should have been explained with the motion.

Paragraph 15 of the Joyce testimony

Dr. Joyce is said to have alleged that one skilled in the art would conclude that certain gel results would not support a conclusion that Rabbani carried out the amplification method of Count 1. The reply declaration testimony supposedly would show that the gel results support the

conclusion. If gel results are relevant to priority, they should have been discussed in the motion.

Due process argument based on alleged change in course

Rabbani alleges that submission of evidence with a reply "is common in interference proceedings." Paper 139, page 9:16-24. Rabbani points out that in connection with other motions, it filed replies.

Rabbani correctly points out that during a recent conference call authorizing this motion the Board noted that the Board's recent experience with reply briefs in general has demonstrated that its current practice of permitting evidence to come in with a reply just does not work. Paper 139, page 10:4-6. Reply briefs, accompanied by evidence, on the issue of priority have been particularly troublesome.

Reference to the Board's order is believed appropriate. Paper 137, page 1:4 through page 3:22:

> Counsel for Rabbani represented that due to the Thanksgiving holiday, Rabbani was unable to complete its reply brief on the issue of priority. Counsel further represented that Rabbani intended to file declaration testimony with its reply. Counsel still further represented that Notomi would not agree to an extension of time. Rabbani asked that the reply brief be filed on or before 10 November 2007.
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> Counsel for Notomi represented that its opposition to an extension was not based on any "excuse" Rabbani might have for wanting the extension. Rather, counsel for Notomi was concerned that what Rabbani was actually up to was preparing declaration testimony to bolster its priority case. Notomi is of the view that Rabbani failed to make out a prima facie case of

priority with its motion for judgment based on priority. Accordingly, counsel for Notomi suggested that further declarations in a reply on the issue of priority more than likely would raise new factual issues.

Both counsel agreed that Rabbani had put on a priority case. Both counsel agreed that Notomi called a witness who discussed what Notomi feels are "holes" in priority case put on by Rabbani. Counsel for Rabbani, while not agreeing that there are any "holes," indicated that Rabbani nevertheless wanted to put on a witness to explain why there are no "holes" in its priority case. Rabbani advised the Board that it exercised its right not to cross-examine and therefore the Notomi witness [Dr. Joyce] was not cross-examined.

The Board's recent experience with reply briefs in general has demonstrated that its current practice of permitting (as a matter of right so to speak) evidence to come in with a reply just does not work. It appeared to the Board, at least at first blush, that Notomi may have a point under the facts of this case—Rabbani is attempting at the reply stage to put in evidence which should have been put in with the motion.

Counsel for Rabbani suggested that if Rabbani does not put on evidence it will be met with the "argument of counsel cannot take the place of evidence" argument. However, pointing out via argument why one witness is more credible than another is a proper function of argument.

What the case may boil down to is whether the Board finds the Rabbani witness testimony and documentary evidence

more credible than the Notomi witness and documentary evidence. What the reply brief needs to address is why the Board should credit the Rabbani witnesses over those of Notomi. Presumably, the Notomi opposition tells us why its witness is more credible. What is not necessary is a lot of new evidence which should have been filed with the motion. For example, this is not a case where Notomi attempted to repeat a Rabbani experiment to show that what Rabbani did "does not work" in which case Rabbani might be allowed to conduct its own experiment.

The Board's resolution, at least at this stage, is to permit a reply without any additional declaration testimony. At the same time, the Board authorized Rabbani to file a motion to proffer what any declaration testimony would be. No declaration may accompany the motion, just a proffer by counsel. For the nature of a proffer, the parties may wish to consult *Byrn v. Aronhime*, Interference 105,384, Paper 64 (Bd. Pat. App. & Int. Sept. 8, 2006) (https://acts.uspto.gov/ifiling then enter interference number, then file contents, then document 64).

An opposition to the motion will be allowed, but no reply is authorized.

Rabbani alleges that there was a change in practice and that the "change in practice in the midst of an interference, particularly without any reasoned analysis as why the change is necessary, is a potential violation of Rabbani's procedural due process rights." Cited in support of Rabbani's

contention is (1) 5 U.S.C. § 706 (2007) and (2) *Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Insurance Co.*, 463 U.S. 29, 42 (1983). In addition, we call attention to *Greater Boston Television Corp. v. F.C.C.*, 444 F.2d 841, 852 (D.C. Cir. 1970) (agency changing its course of action must supply a reasoned analysis indicating that prior policies and standards are being deliberately changed).

Fact-specific analysis will reveal that what Rabbani asserts is a change in practice is actually an application of the rules to the facts of this case. Conference calls with the Board are held on a routine basis in interference cases. In this case a conference call was held to discuss an extension of time to file Rabbani's reply brief. The conference call was necessary because Notomi (1) had a concern and (2) would not agree to the requested extension. 37 C.F.R. § 41.123(b)(1)(ii) (2007). Notomi's concern turned out to be an apprehension that Rabbani was about to supplement its motion for judgment with improper reply evidence. As noted earlier, it was not Notomi's position that an extension of time was not appropriate for other reasons. Upon further discussion, the Board became convinced that Notomi may have a point. Rather than "shut the door" on Rabbani, the Board authorized Rabbani to file a miscellaneous motion for leave to include declaration evidence with the reply. The rules authorize a party to file a miscellaneous motion *in limine* for a ruling on the admissibility of evidence. 37 C.F.R. § 41.155(d) (2007). Rabbani Miscellaneous Motion 5 is such a motion. We have considered the motion on its merits and now deny the motion. There is no change in practice—all that has occurred is that a motion has been decided on its merits under the applicable rules. The proffered declaration evidence has been excluded from evidence.

C. Order

Upon consideration of Rabbani Miscellaneous Motion 5 (Paper 139), and for the reason given herein as well as all the reasons given in Notomi Opposition 5 (Paper 140), it is

ORDERED Rabbani Miscellaneous Motion 5 is *denied*.

cc (via Electronic Mail):

Attorney for Notomi
(real party in interest Eiken Kagaku Kabushiki Kaisha;
licensee: Meridian Bioscience, Inc.):

Barry E. Bretschneider, Esq.
Peter J. Davis, Esq.
MORRISON & FOERSTER LLP
1650 Tysons Boulevard, Suite 300
McLean, VA 22102

Tel: 703-760-7743 (Bretschneider)
Tel: 703-760-7748 (Davis)
Fax: 703-760-7777
Email: bbretschneider@mofo.com
Email: pdavis@mofo.com

Attorney for Rabbani
(real party in interest
Enzo Life Sciences, Inc.,
subsidiary of Enzo Biochem, Inc.):

Eugene C. Rzucidlo, Esq.
Robert M. Schulman, Esq.
HUNTON & WILLIAMS
1900 K Street, N.W.
Washington, D.C. 20006

Tel: 212-309-1214 (Rzucidlo)
Fax: 212-309-1100 (Rzucidlo)
Tel: 202-955-1500 (Schulman)
Fax: 202-778-2201 (Schulman)
Email: gcr@hunton.com
Email: rschulman@hunton.com