

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper 19

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

TETSUYA KATOU, GO HATA,
TAKEAKI ETOH and NOBUHIKO ITO,

Junior Party,
(Application 09/103,324),

v.

ROBERT P. BELKO,

Senior Party
(Patent 5,693,828).

Patent Interference No. 104,451

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge

JUDGMENT UNDER 37 CFR § 1.662(a)

A. First conference call

A first telephone conference call was held on 10 November 1999, at approximately 9:00 a.m. (0900 hours Eastern Time), involving:

- (1) Austin R. Miller, Esq., counsel for Katou (real party in interest Toray Industries, Inc.);
- (2) Arthur L. Liberman, Esq., counsel for Belko (real party in interest International Flavors & Fragrances, Inc); and
- (3) Fred E. McKelvey, Senior Administrative Patent Judge.

B. Discussion--first conference call

The first conference call was placed by the parties to inform the board that a prior art reference has been discovered which describes a compound which anticipates the claims corresponding to Count 1 of the interference. The prior art reference is "Chemical Substances" Inventory of Industrial Safety and Health Law, published by The Chemical Daily Co., Ltd. (Japan), page 863 (1994).

Following the first conference call, a draft final order was faxed to the parties for comment.

C. Second conference call

A second telephone conference call was held on 16 November 1999, at approximately 1:30 p.m. (1330 hours Eastern Time), involving:

- (1) Austin R. Miller, Esq., counsel for Katou (real party in interest Toray Industries, Inc.);
- (2) Arthur L. Liberman, Esq., counsel for Belko (real party in interest International Flavors & Fragrances, Inc); and
- (3) Fred E. McKelvey, Senior Administrative Patent Judge.

D. Discussion--second conference call

During the second conference call, the parties advised that the draft order was acceptable. Accordingly, a judgment consistent with the draft order will be entered.

E. Count

Count 1 reads as follows:

Count 1

A compound according to claim 1 of Belko,

or

a compound according to claims 11, 20 or 25 of Katou.

F. Claims of the parties

The claims of the parties are:

Katou: 11-28

Belko: 1-6

The claims of the parties which correspond to Count 1 are:

Katou: 11-16, 20 and 25-28

Belko: 1

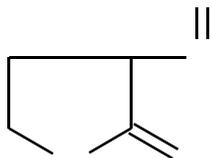
The claims of the parties which do not correspond to Count 1 are:

Katou: 17-19 and 21-24

Belko: 2-6

G. The prior art reference

The prior art reference describes a compound having the formula:



The prior art reference anticipates Belko claim 1 and Katou claims 11-16, 20 and 25-28. All of these claims have

been designated as corresponding to Count 1. The reason the prior art reference anticipates Katou claims 11-16, 20 and 25-28 is because it describes a compound having the formula of Katou claim 11 and Katou claim 19 wherein n is 10. The reference does not purport to describe any compound having a value other than n is 10.

The parties have agreed that a judgment should be entered against both parties. Counsel for Katou agreed that a judgment has to be entered with prejudice as to all claims (because those claims cover compounds wherein n is 10). Counsel for Katou believes, however, that a plausible argument can be made that compounds wherein n is 9 or less and compounds wherein n is 11 or more are patentably distinct from compounds wherein n is 10. On that basis, counsel for Katou requested entry of a judgment with prejudice as to compounds wherein n is 10, but without prejudice to compounds wherein n is 9 or less or n is 11 or more. In light of the fact that Belko and the prior art reference describe only a compound wherein n is 10 and the utility of the Belko compound and the Katou compounds are entirely different, an opportunity should be provided to Katou to establish before the primary examiner the separate patentability of compounds wherein n is 9 or less and compounds wherein n is 11 or more. Counsel for Belko has

no objection to entry of a judgment in the form suggested by counsel for Katou.

H. Order

Upon consideration of the record, including the prior art reference, the count, the claims designated as corresponding to the count and the discussion during the conference calls, it is

ORDERED that senior party Robert P. Belko is not entitled to a patent containing claim 1 (corresponding to Count 1) of U.S. Patent 5,693,828, granted 2 December 1997, based on application 08/647,248, filed 9 May 1996.

FURTHER ORDERED that junior party Tetsuya Katou, Go Hata, Takeaki Etoh, and Nobuhiko Ito is not entitled to a patent containing claims 11-16, 20 and 25-28 (corresponding to Count 1) of Application 09/103,324, filed 23 June 1998.

FURTHER ORDERED that judgment is entered with prejudice as to Belko claim 1.

FURTHER ORDERED that judgment is entered with prejudice as to Katou claims 11-16, 20 and 25-28 as presently worded, but without prejudice to further prosecution before the primary examiner to establish the separate patentability of claims to compounds having the formula set out in Katou

claim 11 and compounds having the formula set out in Katou claim 19 wherein n is an integer other than 10.

FURTHER ORDERED that nothing in this JUDGMENT UNDER 37 CFR § 1.662(a) should be construed as expressing an opinion on the patentability of claims to compounds having the formula set out in Katou claim 11 and compounds having the formula set out in Katou claim 19 wherein n is an integer other than 10 over either Belko or the prior art reference.

FURTHER ORDERED that should further prosecution by Katou result in an appeal to the board, Katou shall identify this interference as a related case.

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	FRED E. MCKELVEY, Senior)
	Administrative Patent Judge)
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	RICHARD E. SCHAFER)
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	RICHARD E. SCHAFER)
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	JAMESON LEE)
	Administrative Patent Judge)

PATENT) BOARD OF APPEALS AND INTERFERENCES

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