Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

HANAGAN, JUNIOR PARTY
v.
KIMURA ET AL., SENIOR PARTY
Interference No. 102,105
April 5, 1990

Harry F. Manbeck, Jr.

Assistant Secretary and Commissioner of Patents and Trademarks

DECISION ON PETITION

***1** Kimura et al. (Kimura) seek administrative review, by PETITION UNDER 37 C.F.R. § 1.644(a)(1) (Paper No. 72). In particular, Kimura requests that the Commissioner set aside a decision by the Board of Patent Appeals and Interferences (Board) refusing to authorize Kimura to take testimony pursuant to 37 CFR § 1.639(c). The petition has b en certified to the Commissioner pursuant to 37 CFR § 1.644(a)(1).

Facts

Kimura filed a preliminary motion for judgment under 37 CFR § 1.633(a) alleging that Hanagan's claims corresponding to the count are unpatentable (Paper No. 19). According to the motion, Hanagan's patent specification does not provide a disclosure which would enable one skilled in the art to make and use the compounds of Hanagan's claims 1-19 corresponding to the count. Kimura also moved under 37 CFR § 1.633(g) to deny Hanagan the benefit of a "parent" D' application (Paper No. 21).

At the time he filed preliminary motions, Kimura also filed motions under 37 CFR § 1.639(c) to take testimony (Paper Nos. 20 and 22). A declaration by Shigeo Murai was filed (Paper No. 27) in support of the motions. Kimura explained the nature of the testimony needed as follows:

> The nature of the testimony needed involves (1) testimony by Party Hanagan concerning Equations 3-5 and Examples 1-3 of the involved Hanagan patent, (2) testimony from organic chemistry synthesis scientific experts including Declarant Murai, and scientific parties of average skill in the organic synthesis art, relating to the disclosure of Hanagan Equations 3-5, including Hanagan's reference citations, and Hanagan Examples 1-3. Inter partes experimentation may be needed.

Hanagan opposed all of Kimura's motions (Paper Nos. 35-38, 41 and 42) and submitted declarations by Hanagan (Paper No. 46), Amos Smith (Paper No. 45), and Wendy Richardson (Paper No. 47) in support of the oppositions.

Kimura replied and further submitted a declaration by Takahiro Haga (Paper No. 61).

The Examiner-in-Chief denied Kimura's preliminary motions. Also denied were Kimura's motions to take testimony, except that Kimura was permitted to rely upon the declaration of Murai and to cross-examine Hanagan and Smith on their declarations (Paper No. 62). Subsequently, the Examiner-in-Chief authorized Kimura to (1) cross-examine Richardson on her declaration and (2) rely on evidence presented in his own motions and reply to an opposition.

Kimura requested reconsideration (Paper No. 67), which was denied by a panel of the Board (Paper No. 68). Kimura then petitioned the Board to certify the following question:

***2** The propriety of allowing Kimura to take testimony-in-chief regarding issue of Hanagan's support under 35 U.S.C. § 112, first paragraph, for her claims corresponding to the count.

(Paper No. 72). The Examiner-in-Chief granted the petition indicating that:

A substantial disagreement exists between the panel and Kimura on the interpretation of 37 CFR 1.639(c) which requires that a party believing that testimony is necessary to support his preliminary motion to "describe the nature of the testimony needed ["] and, the panel believes that a decision on this petition may materially advance the ultimate termination of this interference.

(Paper No. 73).

Discussion

This interference is governed by the "new"D' patent interference rules, which became effective on February 11, 1985. The certified petition raises the following substantial question:

What is the meaning of the phrase "describe the nature of the testimony needed"D' in 37 CFR § 1.639(c) as applied to the facts of this case?

When 37 CFR § 1.639(c) was proposed, the following explanation [FN1] was provided:

Section 1.639, as proposed, sets forth the evidence which may accompany a motion, opposition, or reply (assuming a reply is authorized). Every material fact alleged in a motion, opposition, or an authorized reply would have to be supported by proof . . . . When a party believes that testimony is necessary to decide a preliminary motion under proposed § 1.633, the party would have to describe the nature of the testimony needed. If an examiner-in- chief agrees that testimony is needed, appropriate interlocutory relief would be granted and testimony would be ordered.

In the notice of final rule, § 1.639 was amended to add a reference to § 1.634 to make it clear that a moving party or opponent may describe any testimony needed to resolve a motion under either § § 1.633 or 1.634 because often testimony is needed to resolve inventorship disputes. [FN2] There was no lengthy explanation on the type of justification required to take testimony. [FN3]

It has been observed that the failure of a party to seek testimony under § 1.639 does not preclude it from later being permitted to take testimony, although a showing of good cause [FN4] may be required. See

Nabial v. May, 2 USPQ2d 1453 (Bd. Pat. App. Int. 1986) [FN5] and Verbruggen v. Wells, 5 USPQ2d 1983 (Comm'r Pat. 1987). However, the new interference rules were not intended to permit routine requests to take testimony in lieu of presenting timely affidavits and other available proof of material with the motion. Orikasa v. Oonishi, 10 USPQ2d 1996, 2000 n.12 (Comm'r Pat. 1989).

In this case, Kimura sought to establish that one of ordinary skill in the art could not make the compounds of claims 1-19 corresponding to the count from either the disclosure of the Hanagan patent or the Hanagan "parent"D' application. In support of the motions raising lack of enablement, Kimura submitted a declaration of Murai. Another declaration by Haga was also filed in Kimura's reply to Hanagan's opposition. The Examiner-in-Chief denied the two motions and found that the Hanagan patent disclosure was enabling for the reasons stated in Hanagan's opposition as supported by the Hanagan and Smith declarations.

***3** As noted above, Kimura (1) sought testimony by Hanagan concerning Equations 3-5 and Examples 1-3 of the involved Hanagan patent, (2) sought testimony from organic chemistry synthesis scientific experts and scientific parties of average skill in the organic synthesis art, relating to the disclosure of Hanagan Equations 3-5, including Hanagan's reference citations, and Hanagan Examples 1-3 and (3) suggested a need for inter partes experimentation.

The Examiner-in-Chief declined to authorize testimony from organic chemistry scientific experts and scientific parties of ordinary skill in the organic synthesis art because the motions did not describe the nature of the testimony needed. On reconsideration, the Board agreed, noting that the motions did not identify the experts or the parties of ordinary skill, nor did they state with specificity the facts to which they would testify or the nature of the inter partes tests. The Board felt that letting a party "test the waters"D' with insufficient evidence and later supplement the original evidence would lead to piecemeal prosecution of an interference.

The Examiner-in-Chief and the Board in this case have correctly construed the meaning of the phrase "nature of the testimony needed."D' A proper request under § 1.639(c) must describe the nature of the testimony being sought. The description must be of sufficient detail so that the Examiner-in-Chief can determine whether or not there is a need for the requested testimony.

To the extent it may prove useful, the following guidance is provided. When expert testimony is needed in support of, or in opposition to, a preliminary motion, a party should:

(1) identify the person whom it expects to call as an expert;

(2) state the field in which the person is alleged to be an expert; and

(3) state in a declaration signed by the person (a) the subject matter on which the person is expected to testify, (b) the facts and opinions to which the person is expected to testify, and (c) a summary of the grounds and basis for each opinion.

If a person is to be called as a fact witness, a declaration by that person stating the facts should be filed.

If the other party is to be called, or if evidence in the possession of the other party is necessary, an explanation of the evidence sought, what it will show, and why it is needed must be supplied.

When inter partes tests are to be performed, a description of the tests stating what they will show must be presented.

The nature of the showing under § 1.639(c) will vary from case to case. In this case, both the Examiner-in-Chief and the Board properly concluded that Kimura's description of the nature of the testimony was not sufficient.

Kimura's statement that testimony by Hanagan concerning Equations 3-5 and Examples 1-3 in Hanagan's patent is not a sufficient description of expected testimony. There is no precise description of what questions were to be put to Hanagan or what answers were expected. Kimura's offer to supply testimony from "'organic chemistry synthesis scientific experts"D' is manifestly insufficient. The experts were not identified. The precise field of expertise was not identified. The expected opinions and facts in support of those opinions were not described. The persons of ordinary skill in the art who were to be called were not identified. Likewise, no declaration stating the factual testimony of those individuals was set out.

***4** Preliminary motions should be supported by facts which would justify granting the motion. The facts may appear in declarations, publications, or other material. When a declaration is needed to support a fact, it should be filed with the motion. Likewise, oppositions to preliminary motions should be supported by facts. It is not appropriate to file a motion, see if the motion will be granted, and then ask for testimony only after the motion is denied. It is likewise not appropriate to ask for testimony periods during the preliminary motion stage and base the request on broad assertions or argument of counsel -- the latter not being evidence.

Kimura did not properly meet the requirements of 37 CFR § 1.639. However, given the state of the law at the time Kimura filed its preliminary motions and requests for testimony, it cannot be said that Kimura's position was implausible. Both Verbruggen v. Wells, 5 USPQ2d 1983 (Comm'r Pat. 1987) and Nabial v. May, 2 USPQ2d 1452 (Bd. Pat. App. & Int. 1986), and statements in Collins, supra n. 3, arguably support Kimura's position. Today's decision expressly overrules both Verbruggen and Nabial to the extent they are not consistent with the views expressed herein and in Orikasa v. Oonishi, 10 USPQ2d 1996 (Comm'r Pat. 1989).

Kimura's petition is denied.

Notwithstanding the Board's correct decision, now affirmed on petition, the Examiner-in-Chief or the Board is authorized, upon such showing as they deem sufficient, to set a testimony period in this case to permit Kimura to present testimony. Should Kimura seek testimony, he should present within ten (10) days a detailed proffer of the expected

testimony in accordance with the views set out in this opinion. [FN6]

ORDER

Upon consideration of the Kimura petition and the Hanagan opposition, it is

ORDERED that Kimura's petition under 37 CFR § 1.644(a)(1) is denied, without prejudice to the setting of a testimony period if the Examiner-in- Chief or the Board be so advised.

FN1. 49 Fed. Reg. 3768, 3776 (Jan. 30, 1984), reprinted in 1039 Off. Gaz. Pat. Office 11, 39-40 (Feb. 14, 1984).

FN2. 49 Fed. Reg. 48416, 48442-43 (Dec. 12, 1984), reprinted in 1050 Off. Gaz. Pat. Office 385, 411-12 (Jan. 29, 1985).

FN3. Id. at 48425, 1050 Off. Gaz. Pat. Office at 394. See also Collins, Current Patent Interference Practice § 4.5, p. 80 (1987) (a request to take testimony must explain the nature of the testimony which is needed).

FN4. See e.g. § 1.651(c)(4).

FN5. On the basis of this decision, one author has concluded that if a party complies with 37 CFR § 1.637(a), the party is entitled to present testimony on that issue whether or not he has complied with § 1.639 by submitting proof or requesting testimony. Collins, supra, at p. 82.

FN6. The fee of $120.00 for this petition has been charged to Deposit Account No. 19-4880 as authorized in Paper No. 71.

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