The opinion in support of the decision being
entered today is binding precedent of the Trial Section

Paper 65

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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KOZO SHIOKAWA, SHINICHI TSUBOI, KOICHI MORIYA,
YUMI HATTORI, IKURO HONDA and KATSUHIKO SHIBUYA

Junior Party,
(Patent 5,719,146),

v.

PETER MAIENFISCH and LAURENZ GSELL

Senior Party
(Application 09/136,664).

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Patent Interference No. 104,525

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Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE, TORCZON, GARDNER-LANE and MEDLEY, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge

MEMORANDUM OPINION and ORDER
(Rationale in support of ORDER DENYING DISCOVERY)

A. Introduction

Shiokawa has filed two miscellaneous motions (37 CFR § 1.635) seeking additional discovery (37 CFR § 1.687(c)):

1. Shiokawa [Miscellaneous] Motion 11 (Paper 53) and

2. Shiokawa [Miscellaneous] Motion 12 (Paper 56).

On 29 August 2000, both miscellaneous motions were denied by a single judge without opinion. See ORDER DENYING DISCOVERY (Paper 63). This MEMORANDUM OPINION and ORDER supplies the findings of fact and rationale in support of the ORDER DENYING DISCOVERY.

B. Findings of fact

The following findings of fact are supported in the record by a preponderance of the evidence.

1. The interference involves a Shiokawa patent v. a Maienfisch application. The patent is involved in a civil action. See Bayer AG v. Novartis Crop Protection, Inc., 55 USPQ2d 1509 (M.D. La. 2000).

2. Nihon Bayer AGrochem K.K. is assignee of Shiokawa. Bayer AG is an exclusive licensee.

3. Novartis Corporation, a wholly owned subsidiary of Novartis AG, is assignee of Maienfisch.

4. The interference is in the preliminary motion phase. The next step is cross-examination by Novartis of Shiokawa's witnesses prior to filing of oppositions by Novartis.

5. In support of its preliminary motions, particularly Shiokawa preliminary motions 4-5 and miscellaneous motions 7-10, Shiokawa submitted a declaration by Dr. Christoph Erdelen (Ex 2015) (Paper 53, page 1, ¶ (1)).

6. Miscellaneous motions 7-10 invited the board to add certain Shiokawa applications to the interference. The invitation was declined (Paper 49). Hence, miscellaneous motions 7-10, in effect, have been denied.

7. Dr. Erdelen's declaration is said to evaluate material said to have been presented by Novartis in Annexes 21 and 23 in an appeal in an opposition to an application filed by Shiokawa's assignee in the European Patent Office (Paper 53, page 1, ¶ (2)).

8. Dr. Erdelen's declaration also evaluates Rule 132 declarations presented by Novartis during prosecution of U.S. patent applications said to be directed to the subject matter of this interference (i.e., Rule 132 declarations signed by Buholzer and Rindlisbacher) (Paper 56, page 2, ¶ (3)).

9. According to Shiokawa, Dr. Erdelen has no first hand knowledge of "the details of any tests conducted, the

results reported, and the methods used to summarize the data in Novartis's presentations" (Paper 53, pages 1-2, ¶ (6)).

10. In order for Dr. Erdelen to prepare adequately for cross-examination, Shiokawa tells us that (Paper 53, page 2, ¶ (6)):

> fundamental fairness and the interest of justice require (1) that Dr. Erdelen be permitted access to the details of the experiments that will be the subject of his cross-examination and (2) that Dr. Erdelen be granted access to the documents containing those details sufficiently prior to his cross-examination for an effective review of those materials.

11. Maienfisch apparently has declined to produce copies of any documents relating to test procedures, raw data, and evaluations of those test procedures and raw data relating to tests said to have been reported in the Buholzer and Rindlisbacher Rule 132 declarations (Paper 56, page 2, ¶ (5)).

12. The Buholzer and Rindlisbacher Rule 132 declarations are said to tout advantages of a species within the scope of Maienfisch's claims designated as corresponding to the count of this interference (Paper 56, page 2, ¶ (6)).

13. Dr. Erdelen's declaration is said to conclude that many other species within the scope of Maienfisch's claims do not possess the advantages of the species touted by the Buholzer and Rindlisbacher Rule 132 declarations (Paper 56, pages 2-3, ¶ (7)).

14. Dr. Erdelen did not present any results of tests conducted by him or on his behalf (Paper 53, page 2).

15. Rather, it is said that Dr. Erdelen found sufficient for his purposes the results of the testing submitted by Novartis during its appeal in the European opposition, as well as the tests and results reported in the Buholzer and Rindlisbacher Rule 132 declarations submitted during prosecution of Novartis's U.S. patent applications (Paper 53, page 2).

16. According to Shiokawa, Annexes 21 and 23 and the Buholzer and Rindlisbacher Rule 132 declarations do not indicate when any of the work summarized in the annexes and Rule 132 declarations was performed (Paper 56, page 3, ¶ (8)).

17. In Shiokawa [Miscellaneous] Motion 12, it is asserted that (Paper 56, page 3, ¶ (9)):

> Shiokawa suspects that at least some of the work on which Dr. Erdelen based his [declaration] conclusions *** was performed before the Buholzer and Rindlisbacher [Rule 132] declarations were submitted to the [US]PTO.

18. No evidence was called to our attention to support the suspicion asserted in Finding 17.

19. The basis of Shiokawa's suspicion is said to be two fold (Paper 56, page 3, ¶ 10)):

> First, to the certain knowledge of Shiokawa's assignee Bayer, tests of the kind that underlay Annexes 21 and 23 and

> the Buholzer and Rindlisbacher [Rule 132] declarations take a great deal of time to run, and the running of the large number of tests that underlay those annexes and those [Rule 132] declarations most probably extended over a period of several years. Second, Shiokawa's assignee believes that there is no reliable way of predicting the level of insecticidal activity of any given species within the scope of Maienfisch's claims ***. Hence, Shiokawa believes that Maienfisch's assignee had, and knew it had, some losers as well as some winners within the scope of its claims *** when it filed the Buholzer and Rindlisbacher [Rule 132] declarations touting the advantages of one of its winners.

20. No evidence was called to our attention to support the "certain knowledge" and beliefs asserted in Finding 19.

21. Shiokawa suspects that those responsible for submitting the Buholzer and Rindlisbacher Rule 132 declarations to the USPTO were aware of the work on which Dr. Erdelen based his declaration conclusions (Paper 56, pages 3-4, ¶ (11)).

22. No evidence was called to our attention to support the suspicion set out in Finding 21.

23. Shiokawa tells us that it is contemplating filing a belated preliminary motion to raise the issue of "fraud" based on its undocumented suspicions set out above (Paper 56, page 4, ¶ (12)).

24. According to Shiokawa (Paper 56, page 4, ¶ 14)):

> Establishing the accuracy of its [fraud] suspicion recited *** [above] would be the first step in gathering the facts that Shiokawa would need to have in its possession before filing *** [a preliminary motion for judgment based on fraud].

25. Shiokawa seeks production of the following material:

(1) Copies of all original documents (e.g., laboratory notebook entries and memoranda) from which the summaries in Annexes 21 and 23 were produced (Paper 53, page 3).

(2) Copies of the original documents (e.g., laboratory notebook entries and memoranda) detailing the experiments summarized in the Buholzer and Rindlisbacher Rule 132 declarations (Paper 56, page 4).

(3) Reports or memoranda evaluating the results of those experiments and any evaluations of those experiments (Paper 56, pages 4-5).

(4) Reports and memoranda evaluating the results of the experiments summarized in Annexes 21 and 23 (Paper 56, page 5).

C. Discussion

Granting additional discovery[1] under 37 CFR § 1.687(c) is discretionary with the board. Cochran v. Kresock, 530 F.2d 385, 396, 188 USPQ 553, 561 (CCPA 1976) (interpreting former 37 CFR § 1.287(c) (1984), the predecessor to Rule 687(c)[2]).

Shiokawa has failed to establish that it would be in the interest of justice to grant the additional discovery requested.

1. The "underlying test data"

Shiokawa attempts to obtain through the back door additional discovery that it could not have obtained from Novartis through the front door.

Shiokawa tells us that its preliminary motions rely on the declaration testimony of Dr. Erdelen. The declaration testimony apparently is based on evaluations found in a European opposition involving Novartis and U.S. patent applications owned by Novartis. There is nothing wrong per se with relying on material in a European opposition involving Novartis or U.S. applications

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[1] "Additional discovery" is a term of art in interference practice and is discovery to which a party may be entitled under *** [Rule 687(c)] in addition to discovery to which the party is entitled as a matter of right *** under other rules governing interferences. 37 CFR § 1.601(a).

[2] The scope of discovery under Rule 687(c) was intended to be the same as that under former Rule 287(c). Notice of Final Rule, 49 Fed. Reg. 48416, 48417 (col. 2) (Dec. 12, 1984) ("[t]he scope of the additional discovery would be the same as under current practice.").

owned by Novartis. The material may well be admissible against Novartis as an admission. However, when a party elects as a matter of litigation strategy to rely on material generated by its opponent in other proceedings, as opposed to running the party's own tests, the party cannot expect the opponent to supply the underlying data which supports the evaluation the opponent made in another forum.

Dr. Erdelen's evaluations are based on Novartis-generated material. In essence, Dr. Erdelen is testifying that if the Novartis-generated material is assumed to be accurate, then certain conclusions follow. Shiokawa should not now be permitted to undermine material upon which it elected to rely as part of its litigation strategy. Novartis's underlying data is essentially irrelevant given Shiokawa's litigation strategy of assuming the truth of the Novartis material and then basing its case on that material.

Also irrelevant would be any Novartis underlying data which would be limited to issues raised in Shiokawa miscellaneous motions 7-10, which have been denied. There can be no cross-examination associated with those miscellaneous motions.

It cannot be in the interest of justice to order Maienfisch to produce the additional discovery which would be irrelevant.

Alternatively, under the additional discovery provisions applicable to interference cases, Shiokawa's request is

premature. We would find hard to believe that Novartis in its cross-examination of Dr. Erdelen intends to rely on any of the underlying data sought by Shiokawa. However, at the cross-examination deposition, should Novartis elect to rely on data underlying its material, Dr. Erdelen could be subject to redirect. It would then follow that a request for relevant material under 37 CFR § 1.687(b) might be appropriate. At this time, however, Shiokawa's request is premature because cross-examination has not taken place. Additional discovery is not generally authorized for the purpose of preparing for cross-examination. Tropix, Inc. v. Lumigen, Inc, 53 USPQ2d 2018, 2020 (Bd. Pat. App. & Int. 2000);Schubert v. McKernan, 188 USPQ 496, 499 (Bd. Pat. Int. 1975).

We have not overlooked Shiokawa's argument that "fundamental fairness and the interest of justice" requires authorizing additional discovery. Shiokawa utterly fails to explain why "fundamental fairness" requires granting additional discovery for the purpose of preparing a witness for cross-examination, particularly given the provisions of 37 CFR § 1.687(b).

It is not in the interests of justice to permit additional discovery under 37 CFR § 1.687(c) when there is an alternative possibility for discovery under some other provision of the rules, in this case 37 CFR § 1.687(b).

2. The "fraud" discovery

It is a well-established practice in interference cases that discovery as broad as that authorized by the Federal Rules of Civil Procedure is not available in interference cases pending before the USPTO. Tropix v. Lumigen, supra at 2020. We find it hard to believe that counsel for Shiokawa is not fully aware of the well-established practice, particularly given the publication on 27 March 2000 of the Tropix v. Lumigen publication.

Nevertheless, Shiokawa has embarked on what only can be called a "fishing expedition" in search of "fraud fish" which Shiokawa suspects are swimming in Novartis's "fish ponds." Fishing expeditions are not authorized by the additional discovery provisions of 37 CFR § 1.687(c). To perhaps beat a dead horse, we again remind counsel that additional discovery under the interference rules is not commensurate in scope with discovery under the Federal Rules of Civil Procedure.

Apart from being a fishing expedition, there is further fundamental flaw in Shiokawa's miscellaneous motions for additional discovery. The evidence necessary to support a miscellaneous motion is to accompany the motion. 37 CFR § 1.639(a). Yet, Shiokawa failed to call our attention to evidence which would support its suspicions, beliefs and other assertions of fact. Thus, Shiokawa attempts to engage in a

fishing expedition sans pole and reel. The argument of counsel in a brief is not evidence.

We wish to re-enforce our views that motions, oppositions and replies must be supported by evidence which is admissible under our rules. Moreover, that evidence must be called to our attention with sufficient detail such that we do not have to undertake a search of the record to make out a case on behalf of the moving or opposing party. A party must make out its case in its motion or opposition and we, like a Federal court, will not serve as advocate for either party in considering and deciding a motion. Compare Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 111-12, 49 USPQ2d 1377, 1378-79 (2d Cir. 1999). Nor, where a party points the board to a multi-page exhibit without citing a specific portion or page, will the board pour over the document or the record to extract the relevant information. Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997), citing United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991).

It cannot be in the interest of justice to authorize additional discovery when (1) a party in need of evidence supplies none, or if evidence is supplied, the party does not call our attention to the relevant part of the evidence or (2) a party engages in a fishing expedition.

D. Order

Upon consideration of Shiokawa's Miscellaneous Motions 11 and 12, seeking additional discovery, and for the reasons given, it is

ORDERED that Shiokawa Miscellaneous Motion 11 is denied.

FURTHER ORDERED that Shiokawa Miscellaneous Motion 12 is denied.

FRED E. McKELVEY, Senior
Administrative Patent Judge

RICHARD E. SCHAFER
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

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