Paper 21

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JURGEN ROHRMANN,

Junior Party,
(Patent 5,391,789),

v.

HELMUT G. ALT, SYRIAC J. PALACKAL, KONSTANTINOS PATSIDIS, M. BRUCE WELCH, ROLF. L. GEERTS, ERIC T. HSIEH, MAX P. McDANIEL, GIL R. HAWLEY and PAUL D. SMITH,

Senior Party
(Application 09/197,761).

Patent Interference No. 104,626 (McK)

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

McKELVEY, Senior Administrative Patent Judge.

FINAL DECISION

A. Introduction

As the record makes clear, Rohrmann has conceded on the issue of priority with respect to Count 2, the only count in the Interference (Paper 18, page 2). The only issue remaining for

consideration is whether Rohrmann claim 5 should be designated as corresponding to Count 2. To that end, Alt has filed Alt Preliminary Motion 1 (Paper 19) seeking to have Rohrmann claim 5 designated as corresponding to Count 2. Rohrmann filed an opposition (Paper 20).

B. Facts

1. The interference was initially declared with Count 1 (Paper 1, page 5).

2. Rohrmann claim 5 was designated as not corresponding to the count, then Count 1 (Paper 1, page 5).

3. As a result of an amendment filed by Alt, and which was entered by the board (37 CFR § 1.615(a)), there came a time when the interference was redeclared to substitute Count 2 for original Count 1 (Paper 18).

4. Count 2 reads as follows (Paper 18, page 4):

Count 2

A method according to claim 6 of Rohrmann patent 5,391,789,

or

a method according to any of claims 78 and 90 and 96 of Alt application 09/197,761.

5. The claims of the parties are:

Rohrmann:	1-18
Alt '761:	42, 46, 48-49, 51-53, 78-83 and 90-101

6. The claims of the parties which correspond to Count 2, and therefore are involved in the interference (35 U.S.C. § 135(a)), are:

Rohrmann:	6 and 9-18
Alt '761:	42, 46, 48 and 90-101

7. The claims of the parties which do not correspond to Count 2, and therefore are not involved in the interference, are:

Rohrmann:	1-5 and 7-8
Alt '761:	49, 51-53 and 78-83

8. Rohrmann claim 6, mentioned in Count 2, relates to a method of polymerizing an olefin using a metallocene.

9. Alt claims 78 and 96, mentioned in Count 2, also relate to method of polymerizing an olefin using a metallocene.

10. Alt claim 90, mentioned in Count 2, relates to a method of polymerizing ethylene (ethylene is an olefin).

11. Rohrmann claim 5, not mentioned in Count 2, relates to a method of making a metallocene; Rohrmann claim 5 does not relate to a method of polymerizing an olefin.

12. We will assume that the product produced by the method of Rohrmann claim 5 can be used in the processes defined by each of Rohrmann claim 6 and Alt claims 78, 90 and 96.

13. As noted earlier, Alt has filed a preliminary motion seeking to have Rohrmann claim 5 designated as corresponding to Count 2. 37 CFR § 1.633(c)(3).

14. A party seeking to have a claim designated as corresponding to a count, inter alia, must "[s]how that the claim defines the same patentable invention as another claim whose designation as corresponding to the count the moving party does not dispute." 37 CFR § 1.637(c)(3)(ii).

15. In its preliminary motion, Alt argues that "Rohrmann [c]laim 5 cannot be viewed as patentably distinct from Alt's claim 101 and *** therefore Rohrmann's [c]laim 5 should be designated as corresponding to *** Count 2" (Paper 19, page 3, ¶ 9).

16. Alt claim 101 is directed to a two step process.

a. The first step calls for a method of making a metallocene.

b. The second step calls for using the metallocene made in the first step to polymerize an olefin.

17. Alt has not demonstrated that, within one year of the issuance of the Rohrmann patent, any attempt was made to amend its involved application to add a claim directed to a method of making the metallocene.

C. Discussion

For the reasons which follow, we do not believe Alt is entitled to the relief it seeks.

For the purpose of deciding Alt preliminary motion 1, we will assume, without deciding, that under Rule 637(c)(3)(ii), Alt was under a burden to show that the subject of Alt claim 101 is

directed to the same patentable invention as Rohrmann claim 5 if it is assumed that the subject matter of Alt claim 101 is prior art vis-a-vis Rohrmann.

We will further assume, without deciding,[1] that the method of making the metallocene set out in Alt claim 101 is the same as the method called for by Rohrmann claim 5.

If the two assumptions are correct, then it can be said that Alt has demonstrated that the subject matter of Alt claim 101 anticipates the subject matter of Rohrmann claim 5 and therefore Rohrmann claim 5 is directed to the same patentable invention as Alt claim 101. Superficially, it might be said that Alt complied with Rule 637(c)(3) and therefore is entitled to relief. An analysis of the statute, however, will show otherwise.

The rules should not be read in a vacuum. Rather, they should be interpreted consistent with applicable statutory provisions. Rohrmann correctly notes in its opposition that at this time Alt cannot present a claim to a method of making a metallocene, because Alt did not present such a claim within one year after the date the Rohrmann patent issued.[2] 35 U.S.C. § 135(b). Hence, Rohrmann reasons that Alt should not be allowed to indirectly involve Rohrmann claim 5 in the interference long after the § 135(b) bar has expired. We agree. It is not enough to obtain relief that Alt may have complied with the procedural

[1] Rohrmann contests this assumption.

[2] In this respect, we note that Alt has made no attempt to involve in this interference Rohrmann claims 1-4 directed to metallocene compounds.

requirements of Rule 637(c)(3) if Alt does not also comply with the statute. Alt has made no reasonable attempt to show that it timely presented a claim directed to the same, or substantially the same, invention as that defined by Rohrmann claim 5. We decline to undertake the role of an advocate for Alt against Rohrmann and search the record to determine if Alt timely presented a claim consistent with the requirements of § 135(b). Cf. Clintec Nutrition Co. v. Baxa Corp., 44 USPQ2d 1719, 1723 n.16 (N.D. Ill. 1997) (a court will not pour over the documents to extract the relevant information, citing United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991) (judges do not hunt for truffles buried in briefs); Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 111-12, 49 USPQ2d 1377, 1378-79 (2d Cir. 1999) ("Appellant's Brief is at best an invitation to the court to scour the record *** and serve generally as an advocate for appellant. We decline the invitation."); Bamberger v. Cheruvu, 55 USPQ 1523, 1537 (Bd. Pat. App. & Int. 1998) (board declined to search the record in the first instance to determine whether there is evidence which might support a holding of obviousness).

Because we do not designate Rohrmann claim 5 as corresponding to the count, it becomes unnecessary for us to

determine whether a broader count[3] would be necessary if the preliminary motion were to be granted. We will note that Rohrmann has not conceded priority of subject matter as broad as Rohrmann claim 5 and that it would be only fair to permit Rohrmann to contest priority on the broader invention defined by Rohrmann claim 5 if it were to be added to the interference.

Our denial of relief in this interference is without prejudice to Alt seeking to invoke other remedies which may be available to seek cancellation of Rohrmann claim 5, e.g., a request for a reexamination. We express no views on the appropriateness, or the merits, of other possibly available remedies.

D. Order

Upon consideration of the record, and for the reasons given, it is

ORDERED that Alt Preliminary Motion 1 is denied.

FURTHER ORDERED that judgment on priority as to Count 2, the sole count in the interference, is awarded against junior party JURGEN ROHRMANN.

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[3] E.g. (material in bold added and material in brackets and strikeout deleted, vis-a-vis Count 2):

> A method according to **any of claims 5 or 6** [~~claim 6~~] of Rohrmann patent 5,391,789,
>
> or
>
> a method according to any of claims 78 and 90 and 96 of Alt application 09/197,761.

FURTHER ORDERED that junior party JURGEN ROHRMANN is not entitled to a patent containing claims 6 and 9-18 (corresponding to Count 2) of U.S. Patent 5,391,789, issued 21 February 1995, based on application 07/925,985, filed 5 August 1992.

FURTHER ORDERED that a copy of this paper shall be made of record in files of Alt application 09/197,761 and U.S. Patent 5,391,789.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

FRED E. McKELVEY, Senior Administrative Patent Judge	
RICHARD E. SCHAFER Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	

104,626
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