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

Paper No. 65

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

AVISHAI NEVEL, JOHN B. LAWSON,
KENDALL W. GORDON, Jr., and DAVID BONNEAU

Junior Party
(Patent Nos. 5,570,188 and 5,541,734)[1]

v.

ROBERT HOELLER

Senior Party.
(Application 08/723,315)[2]

Patent Interference No. 104,025

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

LEE, Administrative Patent Judge.

Decision on Motion
for Additional Discovery

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[1] The real party in interest is Lawson-Hemphill, Inc. for both involved patents.

[2] The real party in interest is Zellweger Luwa Ag.

On November 23, 1999, a decision on preliminary motions was rendered in this case. (Paper No. 54). On March 1, 2000, junior party Nevel served its case-in-chief priority testimony.

On April 17, 2000, junior party Nevel et al. filed a miscellaneous motion (Motion No. 8) for seeking additional discovery under 37 CFR § 1.687(c), relating to "inventorship of Senior Party Hoeller's application which is involved in the subject Interference." According to party Nevel, (1) it recently discovered information which strongly indicates that the stated sole inventor of senior party's involved application is actually only one of three joint inventors, and (2) whether or not the defect in inventorship was intentional remains to be discovered.

Party Nevel requests the setting of a period for filing miscellaneous motions under 37 CFR § 1.635 for additional discovery under 37 CFR § 1.687(c), if necessary, so that this motion can be considered. The request is dismissed. The setting of such a period is not necessary here, where the motion for additional discovery has already been filed.

The motion for additional discovery is **denied**, because party Nevel did not set forth a prima facie case of why it is entitled to the relief sought. In particular, the evidence submitted by party Hoeller did not establish a threshold level of suspicion

sufficient to justify, in the interest of justice, additional discovery to explore inventorship issues concerning party Hoeller's involved and benefit cases.

Party Nevel states that in a "corresponding" Japanese patent[3] of the senior party, two inventors are listed in addition to the sole inventor listed on the senior party's involved application. Party Nevel further refers to this Japanese patent as "the Japanese counterpart to Senior Party Hoeller's subject application and parent patent."[4] On the basis of the different inventorship named in the Japanese patent, party Nevel asserts that Robert Hoeller is "apparently not the sole inventor of Senior Party Hoeller's claimed invention of the subject application and/or its parent applications, contrary to Mr. Hoeller's declaration of inventorship," and alludes to "possible inequitable conduct" on the part of senior party Hoeller.

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[3] Japanese Patent No. 2747451.

[4] It is not altogether clear what is meant by party Nevel as a "corresponding" or "counterpart" application, but it is represented that the Japanese patent claims priority to the same Swiss patent application from which party Hoeller's involved application in this interference claims priority benefit.

Party Nevel did not address whether Japanese patent law prohibits the inclusion of multiple claims the inventions of which are made by different inventive entities. In a U.S. patent application, not all of the named inventors in an application need to have made a contribution to each claim. Perhaps that is also the case in a Japanese patent. If that is not so, it was incumbent on party Nevel to bring that out as a part of its prima facie case. Party Nevel also did not address whether the Japanese application discloses and/or claims something other than that which is disclosed and/or claimed in party Hoeller's involved application. Even assuming that there are common claims, the Japanese patent may be claiming additional material. Party Nevel did not set forth sufficient factual basis to demonstrate that one should expect the named inventorship to be the same between Hoeller's involved application in this interference and the Japanese patent. Even assuming that inventorship should be the same between party Hoeller's involved application and the Japanese patent, party Nevel has provided no reasonable basis to suspect that it is party Hoeller's involved application in this interference and not the Japanese patent which named the wrong inventor(s). If it is the Japanese patent

which named the wrong inventor(s), that is simply of no moment in this interference.

Party Nevel is much too quick to presume a mistake in inventorship, and much much too quick to raise the specter of inequitable conduct. On this record, nothing has been demonstrated which is even remotely close to inequitable conduct. In light of the directive in 37 CFR § 1.601 for construing the rules to secure the just, speedy, and inexpensive determination of every interference, "fishing expeditions" will not be condoned and "witch hunts" will be aggressively quelched. Here, party Nevel's motion is a fishing expedition with respect to the inventorship issue and a witch hunt with respect to the issue of possible inequitable conduct.

Finally, party Nevel has not explained why it could not have earlier uncovered the same information. It has not been made known when the Japanese patent was published, and why with reasonable efforts party Nevel could not have located the Japanese patent earlier.

Because party Nevel's motion does not set forth a prima facie entitlement to the relief requested, this decision is made independent of party Hoeller's opposition to the motion and we need not consider any reply to Hoeller's opposition.

Party Nevel's Miscellaneous Motion 8 for Additional Discovery is **denied**, and it is

ORDERED that party Nevel may not re-file this motion to bring forth additional evidence for consideration. In the interest of securing a just, speedy, and inexpensive determination of every interference, we will not permit in this interference a second bite at the apple where a party squandered the first; and

FURTHER ORDERED that a copy of this decision, as is,[5] will be posted on the Interference Trial Section's Website located at[6]

http//:www.uspto.gov/web/offices/dcom/bpai/its.

Fred E. McKelvey, Senior Administrative Patent Judge	
Richard E. Schafer Administrative Patent Judge	
Jameson Lee Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
Richard Torczon Administrative Patent Judge	

[5] Although junior party Nevel objects to publication of this decision in a form which reveals its identity, its two involved cases are both issued patents, and thus the objection is overruled.

[6] Senior party Hoeller, whose involved case is an application, has indicated in a telephone conference call with Judge Lee on May 1, 2000, that it has no objection to publication of this decision, as is.