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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STEPHEN **QUAKE** and HEI-MUN CHRISTINA FAN
Junior Party
(Patent 8,008,018),

v.

YUK-MING DENNIS **LO**, ROSSA WAI KWUN CHIU,
and KWAN CHEE CHAN
Senior Party

(Application 13/070,275).

Patent Interference No. 105,920 (DK)
(Technology Center 1600)

Judgment

37 C.F.R. § 41.127

Before, SALLY GARDNER LANE, JAMES T. MOORE, and DEBORAH KATZ, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

Following the Decision on Remand ("Decision," Paper 273), Quake was ordered to show why the interference should continue to a priority or derivation phase. (*See* "Order," Paper 274.) The Order was issued because Quake asserted dates of conception and derivation in its Priority Statement earlier than the dates accorded to and asserted by Lo. (Compare Quake Priority Statement, Paper 57, with Redeclaration, Paper 43, and Lo Priority Statement, Paper 52.) Quake failed, though, to "[p]rovide a copy of the earliest document upon which [Quake] will rely to show conception" with its Priority Statement as required under 37 C.F.R. § 41.204(2)(iv). Instead, Quake asserted that "the earliest document proving conception is a communication between Dr. Stephen Quake and his attorney dated January 2, 2006, that is subject to attorney client privilege." (Quake Priority Statement, Paper 57, at 2:25-3:1.) The Order to Show Cause provided Quake an opportunity to submit this document.

In its Response to the Order to Show Cause, Quake did not submit a copy of the communication between Dr. Quake and his attorney. Instead, Quake submitted a copy of Quake's application 11/701,686 ("the '686 application"), filed on February 2, 2007 (Exh. 2004[1]) as the earliest document on which it intends to rely. (Response to Order to Show Cause ("Response"), Paper 275, at 3:8–9.)

In the Decision on Remand, the Board determined that the '686 application is not a constructive reduction to practice of the Count in this Interference. (*See* Decision, Paper 273, at 17:11–21:5.) We denied Quake's request for rehearing of

[1] We note that Quake cites Exhibit 2002, while Quake Exhibit List (Paper 265) identifies the '686 application as Exhibit 2004.

that Decision. (Decision on Request for Rehearing, Paper 277.) The arguments Quake puts forth in its response to the Order to Show Cause are similar to those it raised in its Request for Rehearing. For example, Quake argues that there is testimony in the record showing that methods were well-known at the time the '686 application was filed to utilize sequence/statistical analyses on individually sequenced samples, and that those methods would have been equally applicable to the sequence data obtained in Quake's sequenced mixed sample. (*See* Response, Paper 275, at 4:20–25.) Quake argues that methods were well known in the prior art that could be applied to carry out the method of the Count, along with the disclosures of the '686 application. (*See* Response, Paper 275, at 5:11-13.)

As discussed in the Decision on Request for Rehearing, Quake's arguments do not persuade us that the decision to deny Quake benefit of its '686 application should be modified. (*See* Decision on Request for Rehearing, Paper 277.) Because we determine that the '686 application is not a reduction to practice of the Count, Quake has failed to show why it will prevail over Lo in a priority or derivation phase. Quake does not submit any other evidence of an earlier conception, reduction to practice, or derivation.

Quake also argues that the interference should proceed to a priority phase because of the determination in Interference 105,922 that Quake had an actual reduction to practice of the sequencing embodiment of the Count prior to the filing date accorded to Lo in that proceeding. (Response, Paper 275, at 5:16–19.) The count of Interference 105,922 was different from the current count and the specifications of Quake's currently involved patent and applications are different from the Quake specifications involved in that interference. Accordingly, the

determination of priority in that interference is not dispositive of the issues of this interference.

Because Quake has failed to submit a document on which it can rely to show priority earlier than Lo's accorded priority date and has failed to provide a persuasive reason why this interference should continue to a priority or derivation phase, we enter judgment against Quake as to Count 1, the sole count in the interference.

It is ORDERED that claims 1-4 of Quake's involved patent 8,008,018 be CANCELED 35 U.S.C. § 135(a);

FURTHER ORDERED that a copy of this judgment be entered in the administrative records of the involved 8,008,018 patent and 13/070,275 application.

FURTHER ORDERED that a party seeking judicial review timely serve notice on the Director of the United States Patent and Trademark Office. 37 C.F.R. §§ 90.1 and 104.

FURTHER ORDERED that the parties are directed to 35 U.S.C. § 135(c) and to 37 C.F.R. § 41.205 regarding the filing of settlement agreements.

cc (via electronic delivery):

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