

EXHIBIT

4

All motions respecting this case should identify it by number and names of parties.



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Interference No. 102,097

Fritsch et al

v.

Lin

*02/10/90 for
2/16/90
2/27/90
cc*

MAILED

FEB 9 1990

PAT. & T.M. OFFICE
BOARD OF PATENT APPEAL
AND INTERFERENCES

Decision on Motions

The following motions have been filed:^{1/}

AA. to terminate the interference and award priority in view of a decision rendered by the U.S. District Court for the District of Massachusetts (Civil Action No. 87-2617-Y).

H. for judgment of unpatentability to Lin of claims corresponding to the count under 35 USC 102(e) and/or 103.

I. for judgment of unpatentability to Lin of claim 65 corresponding to the count under 35 USC 112, first paragraph ("written description", "enablement" and/or "best mode" requirements).

J. to attack the benefit accorded to Lin of the filing date of its earlier applications on the grounds that those applications fail to satisfy the "written description" and/or "enablement" requirements of 35 USC 112.

K. to attack the benefit accorded to Lin of the filing dates of its earlier applications on the grounds that those applications fail to satisfy the "best mode" requirement of 35 USC 112.

^{1/} Following the convention adopted by the parties, the preliminary motions of Fritsch (Paper No. 26) are identified by the letters H through Q. The motion under \$1.635 filed by Lin (Paper No. 33) is identified by the designation "AA".

AM 17 005577
CONFIDENTIAL
SUBJECT TO PROTECTIVE ORDER

Interference No. 102,097

- 4 -

Motion M

Consideration of the motion is deferred to final hearing provided the matter is raised by Fritsch in its brief. §1.639(c). Matters not raised in the brief are ordinarily regarded as abandoned. Photis v. Lunkenheimer, 225 USPQ 948 (Bd.Pat.Int. 1984). The question of whether the applicant himself invented the subject matter at issue, and thus does not run afoul of 35 USC 102(f), is a question which ordinarily requires the taking of testimony for an adequate determination of the relevant facts. Cf. Weil v. Fritz, 601 F.2d 551, 202 USPQ 447 (CCPA 1979).

Motion O

The motion is dismissed. The present count is considered to be directed to a separate patentable invention relative to the invention defined in the proposed count and Fritsch has not shown otherwise. Accordingly, substitution of one for the other would be inappropriate. Additionally, it is noted that Lin has made no claim to the broader invention defined by the proposed count and Fritsch has not proposed that such a claim be added to Lin's involved application in accordance with §1.637(c)(1)(iii). As the proponent of the proposition that the existing count be replaced with a count of broader scope, the burden falls on Fritsch to establish that both relate to the same patentable invention. Fritsch has not done so.

Motion N

This motion is dismissed as moot in view of the dismissal of related motion O.

Motion P

The motion is denied essentially for the reasons set forth in the Decision on Motions in interference 102,096 with regard to motion E.

AM 17 005580
CONFIDENTIAL
SUBJECT TO PROTECTIVE ORDER

Interference No. 102,097

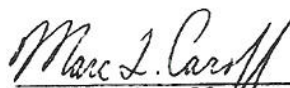
- 6 -

cooperate in allowing reasonable time for a bona fide attempt to arrive at a settlement of outstanding issues in the interferences.

Should any party have a question regarding any aspect of this interference proceeding, that party should contact the undersigned directly by telephone (via a conference call) in the interest of orderly procedure so that the matter can be resolved in the most expeditious manner. §1.640(b).

Summary of Times Running

1. Service of Preliminary Statements due by: February 16, 1990.
2. Pre-Trial Conference Call on February 27, 1990 at 1:00 PM EST.


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Examiner-in-Chief
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MLC/mjg

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SEE 1108 OG 15
(NOV. 14, 1989)

AM 17 005582
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SUBJECT TO PROTECTIVE ORDER