

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF FLORIDA  
TALLAHASSEE DIVISION

THE BOARD OF EDUCATION, a  
corporate body of the State of  
Florida, for and on behalf of the  
Board of Trustees of FLORIDA  
STATE UNIVERSITY; et al.,

Plaintiffs,

v.

Case No. 4:99 CV 131 RV

AMERICAN BIOSCIENCE, INC. a  
California corporation, formerly  
known as VIVORX PHARMACEUTICALS,  
INC.; and CHUNLIN TAO, an  
individual,

Defendants.

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**NOTICE OF APPEAL**

NOTICE IS HEREBY GIVEN that American BioScience, Inc. ("ABI"), defendant in the above-named case, hereby appeals to the United States Court of Appeals for the Federal Circuit from the Orders entered in this action on October 22, 2003 denying ABI's motions to amend the judgment, to tax costs, and for leave to file a reply brief concerning those motions. ABI also appeals from the document entitled "Taxation of Costs by Clerk" entered on October 24, 2003. Copies of the aforementioned orders are attached as Exhibits A, B and C, respectively.

OFFICE OF CLERK  
U.S. DISTRICT CT.  
NORTHERN DIST. FLA.  
TALLAHASSEE, FLA.

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Respectfully submitted,

AUSLEY & McMULLEN

By 

~~Robert W. Clarke, Jr.~~

~~Fla. Bar No. 0592900~~

Martin B. Sipple

Fla. Bar No. 0135399

Post Office Box 391

Tallahassee, Florida 32302

(850) 224-9115 - telephone

(850) 222-7560 - facsimile

and

SHEPPARD, MULLIN, RICHTER &  
HAMPTON, LLP

Joseph F. Coyne, Jr.

Phillip A. Davis

Forty-Eighth Floor

333 South Hope Street

Los Angeles, CA 90071-1448

(213) 620-1780 - telephone

(213) 620-1398 - facsimile

Attorneys for ABI

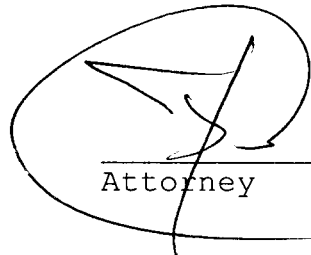
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing was mailed, first class postage prepaid, the 12 day of November, 2003, to:

Sidney L. Matthew  
Gorman & Matthew, P.A.  
135 South Monroe Street  
Suite 100  
P.O. Box 1754 (zip 32302)  
Tallahassee, Florida 32301

and

Jeffrey T. Thomas  
Gibson, Dunn & Crutcher, LLP  
Jamboree Center  
4 Park Plaza  
Irvine, California 92614-8557

  
\_\_\_\_\_  
Attorney

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF FLORIDA  
TALLAHASSEE DIVISION

BOARD OF EDUCATION OF  
THE STATE OF FLORIDA, et al.,

Plaintiffs,

v.

Case No.: 4:99cv/131/RV

AMERICAN BIOSCIENCES, INC.,  
et al.,

Defendants.

\_\_\_\_\_ /

**ORDER**

Defendant American Biosciences, Inc. ("ABI") moves to amend this court's November 5, 2001, judgment, to vacate the preliminary injunction entered on December 15, 1999, and to tax costs against the plaintiffs. (Doc. 544).

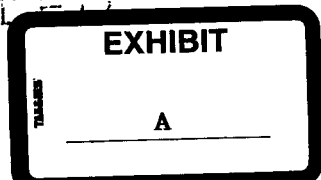
According to ABI, an amended judgment is necessary to effectuate the Federal Circuit's decision and mandate in this case. See Board of Educ. v. Amer. Biosciences, Inc., 333 F.3d 1330 (Fed. Cir. 2003). ABI appealed from this court's final judgment determining the coinventors of U.S. Patent 5,780,653 ('653 patent), declaring the '653 patent unenforceable due to inequitable conduct, and taxing costs against ABI. In this case, the Federal Circuit reversed and issued a written opinion and separate judgment on June 23, 2003, with the mandate later issuing on August 26, 2003, seven days after the petition for rehearing was denied. See FED. R. APP. PROC. 41(b), (d)(1). The "Conclusion" section of the Federal Circuit's opinion adequately explains the court's resolution of the issues and its determination of the rightful coinventors of the '653 patent. The court also concluded that each party was to bear its own costs.

U.S. DISTRICT COURT  
NORTHERN DISTRICT OF FLORIDA  
TALLAHASSEE, FLORIDA  
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ENTERED ON DOCKET 10/21/03 BY [Signature]  
(Rules 53 & 73 (e) FRCR & 201.10 FPL & 600.01 FPCORP)

Copies sent to Matthew, Evans, Carlotta, Cline,  
Davis, Arnold, Clarke, Sipple, Van Den Broek,  
O'Neil, Thomas

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The court incorporated its opinion into the judgment and did not remand the case to this court for any further proceedings.

When an appellate court's decision does not remand on any issue presented on appeal, all matters within the scope of the appellate court's mandate (i.e., all issues deemed presented to the court on appeal) are removed from the district court's jurisdiction. Engel Indus., Inc. v. Lockformer Co., 166 F.3d 1379, 1382 (Fed. Cir. 1999)(citing Sprague v. Ticonic Nat'l Bank, 307 U.S. 161, 168, 59 S. Ct. 777, 83 L. Ed. 1184 (1939)). "[U]nless remanded by [the appellate] court, all issues within the scope of the appealed judgment are deemed incorporated within the mandate and thus are precluded from further adjudication [by the district court]." Id. at 1383 (citations omitted). Where the case is not remanded, because an appellate court may review the interpretation of its own mandate *de novo*, clarification of the judgment that forms a part of an appellate court's mandate is properly presented to that court. Odetics, Inc. v. Storage Technology Corp., 185 F.3d 1259 (Fed. Cir. 1999). Thus, this court is without jurisdiction to amend its prior judgment to reflect the Federal Circuit's decision, and it appears that the previously entered judgment of the Federal Circuit is now final. Any clarification of that judgment is properly addressed to the Federal Circuit. I am likewise without jurisdiction to re-examine the Federal Circuit's decision that each party bear its own costs because the taxation of costs was within the scope of the judgment ABI appealed and any dispute over that issue appears to have been resolved by the Federal Circuit. Accordingly, ABI's motions to amend the judgment and to tax costs are DENIED.

Because the parties are in agreement on the issue, this court's preliminary injunction, entered on December 15, 1999, (doc. 67), has been rendered moot by the

Federal Circuit's judgment and is VACATED.<sup>1</sup>

DONE and ORDERED this 21<sup>st</sup> day of October, 2003.



Roger Vinson  
Chief United States District Judge

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<sup>1</sup>ABI's assertion that the preliminary injunction in some way precludes it from developing or enforcing inventions claimed in the '653 patent is incorrect. Because a preliminary injunction is, by its nature, interlocutory, its life comes to an end upon the entry of final judgment, and it is no longer enforceable against anyone. See Madison Square Garden Boxing, Inc. v. Shavers, 562 F.2d 141, 144 (2d Cir. 1977).

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF FLORIDA  
TALLAHASSEE DIVISION

BOARD OF EDUCATION

VS

CASE NO. 4:99cv131/RV

AMERICAN BIOSCIENCE, INC., et al

REFERRAL AND ORDER

Referred to Chief Judge Vinson on October 20, 2003  
Type of Motion/Pleading MOTION FOR LEAVE TO SUBMIT REPLY BRIEF IN  
SUPPORT OF DEFENDANT'S [544-1] MOTION TO AMEND THE JUDGMENT ON COUNT  
VII & OTHER RELIEF

Filed by: DEFENDANTS on 10/7/03 Doc. No. 546  
( ) Stipulated/Consented/Joint Pleading

RESPONSES:

\_\_\_\_\_ on \_\_\_\_\_ Doc. No. \_\_\_\_\_  
\_\_\_\_\_ on \_\_\_\_\_ Doc. No. \_\_\_\_\_

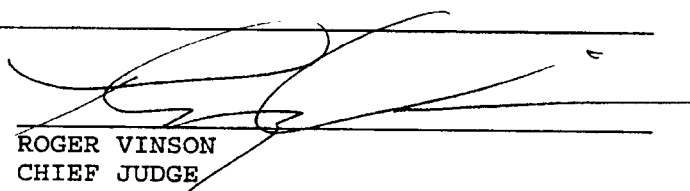
WILLIAM M. MCCOOL, CLERK OF COURT

L. JAMES  
Deputy Clerk

ORDER

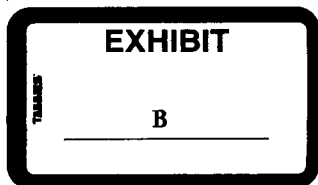
Upon consideration of the foregoing, it is ORDERED this 21<sup>st</sup> day of October, 2003, that:

- (a) The requested relief is GRANTED/DENIED.
- (b) \_\_\_\_\_

  
ROGER VINSON  
CHIEF JUDGE

Entered On Docket: 10/22/03 By: J  
Rules 58 & 79(a) FRCP or 32(d)(1) & 55 FRCP  
Copies sent to: Coyne, Matthews, Evans,  
Carlozzi, Ruma, Ansel, Clarke, Siede,  
Vandew Bosch, O'Neil, Thomas

Document No. 547



IN THE UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF FLORIDA  
TALLAHASSEE DIVISION

BOARD OF EDUCATION OF  
THE STATE OF FLORIDA, et al.,

Plaintiffs,

vs.

Case No: 4:99cv131 RV

AMERICAN BIOSCIENCES, INC.,  
et al.,

Defendants.

\_\_\_\_\_ /

TAXATION OF COSTS BY CLERK

In accordance with Order of the Court (doc. 548) filed October 22, 2003, no costs shall be taxed in this case and each party shall bear its own costs.

This 24<sup>th</sup> day of October, 2003.

WILLIAM M. McCOOL  
Clerk of Court

By: Judith Leahy  
Judith Leahy, Deputy Clerk

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U.S. DISTRICT CT.  
NORTHERN DIST. FLA.  
TALLAHASSEE

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