Chapter 2300 Interference Proceedings

2300.01 Introduction

35 U.S.C. 135. Interferences.

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six–month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six–month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Commissioner by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Commissioner, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Commissioner from determining patentability of the invention involved in the interference.

An interference is a proceeding, conducted before the Board of Patent Appeals and Interferences (Board), to determine priority of invention between a pending application and one or more pending applications and/or one or more unexpired patents. Jurisdiction to decide an interference is granted by 35 U.S.C. 135(a), which also grants the Board discretion to determine questions of patentability in the proceeding.

The Patent and Trademark Office (PTO) does not have jurisdiction to conduct interferences which involve only patents, i.e., which do not involve at least one pending application. Jurisdiction over those proceedings is conferred on the Federal courts by 35 U.S.C. 291.

Since the Board is the body which has jurisdiction over interferences conducted in the PTO, the examiner's involvement in the proceeding, once the interference has been declared, is minimal. This chapter therefore is generally limited to information concerning those aspects of an interference, including preliminary and subsequent proceedings, which are within the jurisdiction of, or are relevant to, the examiner. It does not include the procedure which is followed before the Board during the interference. Persons seeking information concerning that procedure should consult the text of the pertinent rules, 37 CFR 1.601 through 1.688, the notice of rulemaking and accompanying comments adopting those rules, published in the *Federal Register* at 49 FR 48416 (Dec.12, 1984), and in the Patent and Trademark Office *Official Gazette* at 1050 O.G. 385 (Jan.29, 1985), as well as the notices amending the rules, and the comments therein. These notices and comments, as well as other notices pertinent to current interference practice and procedure, are as follows:

Correction Notice, 50 FR 23122 (May 31, 1985), 1059 O.G. 27 (Oct. 22, 1985);

Notices of Rulemaking: 52 FR 13833 (Apr. 27, 1987), 1080 O.G. 15 (July 14, 1987);

53 FR 23728 (June 23, 1988), 1092 O.G. 26 (July 12, 1988);

54 FR 29548 (July 13, 1989), 1105 O.G. 5 (Aug. 1, 1989);

56 FR 42528 (Aug. 28, 1991)*, 1136 O.G. 40 (Mar. 17, 1992);

*corrected, 56 FR 46823 (Sep. 16, 1991)

58 FR 49432 (Sep. 23, 1993), 1155 O.G. 65 (Oct. 19, 1993);

60 FR 14488 (Mar. 17, 1995), 1173 O.G. 36 (Apr. 11, 1995).

Notices: *Access to Interference Settlement Agreements by Government Agencies*, 972 O.G. 2 (July 4, 1978); *Interference Practice: Response to Order to Show Cause Under 37 CFR 1.640*, 1074 O.G. 4 (Jan. 6, 1987); *Interference Practice: Fraud and Inequitable Conduct Allegations*, 1074 O.G. 42 (Jan. 27, 1987); *Interferences – Preliminary Motions for Judgment*, 1118 O.G. 19 (Sep. 11, 1990); *Consideration of Fraud and Inequitable Conduct in Patent Interference Cases*, 1133 O.G. 21 (Dec. 10, 1991); *Interference Practice: Consideration of Fraud and Inequitable Conduct* (Id.); *Interference Practice: Matters Relating to Belated Preliminary Motions*, 1144 O.G. 8 (Nov. 3, 1992); *Availability of Interference Files and Interference Related Application and Patent Files*, 1184 O.G. 15 (Mar. 5, 1996).

The text of the notices listed above is available on the PTO web page at www.uspto.gov.

2300.02 Provoking an Interference

An interference may be provoked in several different ways, depending upon the circumstances. Each of these is covered in detail in the subsequent sections.

(A) An interference between pending applications is normally initiated by the examiner, but occasionally may be requested by an applicant who has become aware of another application which may be claiming the same invention. See MPEP § 2303 and § 2304. If the applications are not claiming the same patentable invention, it may be necessary for the examiner to suggest a claim in one or more of the applications. See MPEP § 2305.

(B) An interference between a pending application and a patent is normally provoked by the applicant. See MPEP § 2306 – § 2308.

2301.01 Preliminaries to an Interference

An interference is often an expensive and time-consuming proceeding. Yet, it is necessary to determine priority when two applicants, or an applicant and a patentee, are claiming the same patentable subject matter and their filing dates are so close together that there is a reasonable possibility that the first to file is not the first inventor. The fact that an application is a reissue application does not preclude it from being involved in an interference.

The greatest care must therefore be exercised both in the search for interfering applications and in determining whether an interference should be declared. Also the claims in recently issued patents, especially those used as references against the application claims, should be considered for possible interference.

The question of the propriety of initiating an interference in any given case is affected by so many factors that a discussion of them here is impracticable. Some circumstances which render an interference unnecessary are hereafter noted, but each instance must be carefully considered if serious errors are to be avoided.

In determining whether an interference is necessary, a claim should be given the broadest interpretation which it reasonably will support, bearing in mind the following general principles:

(A) The interpretation should not be strained;

(B) Express limitations in the claim should not be ignored nor should limitations be read therein;

(C) Before a claim (unless it is a patented claim) is considered as the basis for the count of an interference, the claim should be allowable and in good form. No pending claim which is indefinite, ambiguous or otherwise defective should be the basis for a count of an interference;

(D) A claim copied from a patent, if ambiguous, should be interpreted in the light of the patent in which it originated for purposes of determining whether a party has a right to copy a claim;

(E) An interference will not normally be instituted between cases which have the same inventive entity, or a common assignee. See 37 CFR 1.602(a). Such cases should be treated as set forth in MPEP § 804 *et seq.* Also see MPEP § 2302; and

(F) If doubts exist as to whether there is an interference, an interference should not be declared.

2301.01(a) In Different Groups

If there is a prospective interference between applications assigned to different groups, the applications should be transferred to the group where the controlling interfering claim would be classified. After termination of the interference, further transfer may be necessary depending upon the outcome.

2301.01(b) The Interference Search

The search for interfering applications must not be limited to the class or subclass in which the application is classified, but must be extended to all classes, in and out of the examining group, which it has been necessary to search in the examination of the application. See MPEP § 1302.08.

Moreover, the possibility of the existence of interfering applications should be kept in mind throughout the prosecution. Where the examiner at any time finds that two or more applications are claiming the same invention and the examiner does not deem it expedient to institute interference proceedings at that time, the examiner should make a record of the possible interference as on the face of the file wrapper in the space reserved for class and subclass designations. Such notations, however, if made on the file wrapper or drawings, must not be such as to give any hint to the applicants, who may inspect their own applications at any time, of the date or identity of a supposedly interfering application. Application numbers or filing dates of conflicting applications must never be placed upon drawings or file wrappers. A book of "Prospective Interferences" should be maintained containing complete data concerning possible interferences and the page and line of this book should be referred to on the respective file wrappers or drawings. For future reference, this book may include notes as to why prospective interferences were not declared.

In determining whether to initiate an interference, the primary examiner must decide the question. An administrative patent judge may, however, be consulted for advice.

The Group Director should be consulted if it is believed that the circumstances justify an interference between applications neither of which is ready for allowance.

2301.02 Definitions

37 CFR 1.601. Scope of rules, definitions.

This subpart governs the procedure in patent interferences in the Patent and Trademark Office. This subpart shall be construed to secure the just, speedy, and inexpensive determination of every interference. For the meaning of terms in the Federal Rules of Evidence as applied to interferences, see § 1.671(c). Unless otherwise clear from the context, the following definitions apply to this subpart:

(a) *Additional discovery* is discovery to which a party may be entitled under § 1.687 in addition to discovery to which the party is entitled as a matter of right under § 1.673(a) and (b).

(b) *Affidavit* means affidavit, declaration under § 1.68, or statutory declaration under 28 U.S.C. § 1746. A transcript of an *ex parte* deposition may be used as an affidavit.

(c) *Board* means the Board of Patent Appeals and Interferences.

(d) *Case–in–chief* means that portion of a party's case where the party has the burden of going forward with evidence.

(e) *Case–in–rebuttal* means that portion of a party's case where the party presents evidence in rebuttal to the case–in–chief of another party.

(f) A *count* defines the interfering subject matter between two or more applications or between one or more applications and one or more patents. At the time the interference is initially declared, a count should be broad enough to encompass all of the claims that are patentable over the prior art and designated to correspond to the count. When there is more than one count, each count shall define a separate patentable invention. Any claim of an application or patent that is designated to correspond to a count is a claim involved in the interference within the meaning of 35 U.S.C. 135(a). A claim of a patent or application that is designated to correspond to a count and is identical to the count is said to correspond exactly to the count. A claim of a patent or application that is designated to correspond to a count but is not identical to the count is said to correspond substantially to the count. When a count is broader in scope than all claims which correspond to the count, the count is a phantom count.

(g) The *effective filing date* of an application is the filing date of an earlier application, benefit of which is accorded to the application under 35 U.S.C. 119, 120, 121, or 365 or, if no benefit is accorded, the filing date of the application. The effective filing date of a patent is the filing date of an earlier application, benefit of which is accorded to the patent under 35 U.S.C. 119, 120, 121, or 365 or, if no benefit is accorded, the filing date of the application which issued as the patent.

(h) In the case of an application, *filing date* means the filing date assigned to the application. In the case of a patent, "filing date" means the filing date assigned to the application which issued as the patent.

(i) An *interference* is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. An interference may be declared between two or more pending applications naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention. An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an examiner, any application and any unexpired patent contain claims for the same patentable invention.

(j) An *interference–in–fact* exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

(k) A *lead* attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an interference on behalf of a party and is the attorney or agent whom an administrative patent judge may contact to set times and take other action in the interference.

(l) A *party* is an applicant or patentee involved in the interference or a legal representative or an assignee of record in the Patent and Trademark Office of an applicant or patentee involved in an interference. Where acts of a party are normally performed by an attorney or agent, "party" may be construed to mean the attorney or agent. An inventor is the individual named as inventor in an application involved in an interference or the individual named as inventor in a patent involved in an interference.

(m) A *senior party* is the party with the earliest effective filing date as to all counts or, if there is no party with the earliest effective filing date as to all counts, the party with the earliest filing date. A *junior party* is any other party.

(n) Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non–obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

(o) *Sworn* means sworn or affirmed.

(p) *United States* means the United States of America, its territories and possessions.

(q) A *final decision* is a decision awarding judgment as to all counts. An *interlocutory order* is any other action taken by an administrative patent judge or the Board in an interference, including the notice declaring an interference.

(r) *NAFTA country* means NAFTA country as defined in section 2(4) of the North American Free Trade Agreement Implementation Act, Pub. L. 103–182, 107 Stat. 2060 (19 U.S.C. 3301).

(s) *WTO member country* means WTO member country as defined in section 2(10) of the Uruguay Round Agreements Act, Pub. L. 103–465, 108 Stat. 4813 (19 U.S.C. 3501).

37 CFR 1.601 defines various terms used in Subpart E of Title 37, Code of Federal Regulation, including "same patentable invention," "separate patentable invention," "sworn," "United States," "final decision," "interlocutory order," "NAFTA country" and "WTO member country." "Affidavits" include declarations filed under 35 U.S.C. 25 and 37 CFR 1.68 as well as statutory declarations under 28 U.S.C. 1746. The definition "United States" is the same as the definition of United States in 35 U.S.C. 100(c). "NAFTA country" is defined in section 2(4) of the NAFTA Implementation Act, which includes United States, Mexico and Canada. For purposes of 35 U.S.C. 104, inventions made abroad in a NAFTA country would include only Mexico and Canada.

The definition of "interference" permits an interference between one or more applications and one or more patents. Thus, the revised rules follow the policy of *Wilson v. Yakel*, 1876 C.D. 245 (Comm'r Pat. 1876) and, to the extent inconsistent therewith, do not follow the policy announced in *Touval v. Newcombe*, 194 USPQ 509 (Comm'r Pat. 1976).

A "count" defines interfering subject matter. An interference may have two counts only if the second count defines a "separate patentable invention" from the first count. The reason the second count must define a separate patentable invention is to permit the PTO to lawfully issue separate patents to different parties in an interference when a single party does not prevail as to all counts. A "separate patentable invention" is defined in 37 CFR 1.601(n):

Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

2302 Ownership of Applications and Patents Involved in an Interference

37 CFR 1.602. Interest in applications and patents involved in an interference.

(a) Unless good cause is shown, an interference shall not be declared or continued between (1) applications owned by a single party or (2) applications and an unexpired patent owned by a single party.

(b) The parties, within 20 days after an interference is declared, shall notify the Board of any and all right, title, and interest in any application or patent involved or relied upon in the interference unless the right, title, and interest is set forth in the notice declaring the interference.

(c) If a change of any right, title, and interest in any application or patent involved or relied upon in the interference occurs after notice is given declaring the interference and before the time expires for seeking judicial review of a final decision of the Board, the parties shall notify the Board of the change within 20 days after the change.

37 CFR 1.602 continues the previous PTO practice (former 37 CFR 1.201(c)) of not declaring or continuing an interference between (1) two or more applications owned by the same party or (2) an application and a patent owned by a single party unless good cause is shown. A corporation and its wholly owned subsidiary are considered a "single party" within the meaning of 37 CFR 1.602(a).

COMMON OWNERSHIP

Where applications by different inventive entities but of common ownership claim the same subject matter or subject matter that is not patentably different:

(A) Interference therebetween is normally not instituted since there is no conflict of interest. Elimination of conflicting claims from all except one application should usually be required. 37 CFR 1.78(c). The common assignee must determine the application in which the conflicting claims are properly placed. Treatment by rejection is set forth in MPEP § 804.03.

(B) Where an interference with a third party is found to exist, the commonly owned application having the earliest effective filing date will be placed in interference with the third party. The common assignee may move during the interference under 37 CFR 1.633(d) to substitute the other commonly owned application, if desired.

2303 Interference Between Applications

37 CFR 1.603. Interference between applications; subject matter of the interference.

Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant subject to a judgment in the interference. The interfering subject matter shall be defined by one or more counts. Each application must contain, or be amended to contain, at least one claim that is patentable over the prior art and corresponds to each count. All claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count.

Where two or more applications are found to be claiming the same patentable invention, they may be put in interference, dependent on the status of the respective applications and the difference between their filing dates. One of the applications should be in condition for allowance. Unusual circumstances may justify an exception to this if the approval of the Group Director is obtained.

Interferences will not be declared between pending applications if there is a difference of more than 3 months in the effective filing dates of the oldest and the next oldest applications, in the case of inventions of a simple character, or a difference of more than 6 months in the effective filing dates of the applications in other cases, except in exceptional situations, as determined and approved by the Group Director. One such exceptional situation would be where one application has the earliest effective filing date based on foreign priority and the other application has the earliest effective United States filing date. If an interference is to be declared, all applications having the interfering subject matter should be included.

Before initiating an interference, it is essential that the examiner make certain that each of the applications contains a claim to the same patentable invention (as defined in 37 CFR 1.601(n)) and that each of those claims is clearly readable upon the disclosure of that party and allowable in its application. See *Rowe v. Dror*, 112 F.3d 473, 479, 42 USPQ2d 1550, 1554 (Fed. Cir. 1997). Note that the claims of two or more applications do not have to be identical for an interference to exist. All that is necessary is that a claim of one applicant be drawn to the same invention (35 U.S.C. 102) or be obvious (35 U.S.C. 103) in view of a claim of another applicant. However, if one applicant claims a genus and the other claims a species within that genus, there is no interference on the genus if the species is patentable over the genus; in that case, the genus and species would be separate patentable inventions. See MPEP § 2144.08 regarding genus–species examination guidelines.

If the applications each contain at least one claim drawn to the same patentable invention (37 CFR 1.601(n)), the examiner proceeds under 37 CFR 1.609 to initiate the interference; otherwise, one or more claims must be suggested to some or all of the parties. See MPEP § 2305. Since two applications do not have to contain an identical claim in order to be placed in interference, the suggestion of a claim should not normally be necessary.

2303.01 Interference on Nonelected Subject Matter

Where the subject matter found to be allowable in one application is disclosed and claimed in another application, but the claims therein to such subject matter are either nonelected or subject to election, the question of interference should be considered. The requirement of 37 CFR 1.601(i) that the conflicting applications shall contain claims for the same patentable invention should be interpreted as meaning generally that the conflicting claimed subject matter is sufficiently supported in each application and is patentable to each applicant over the prior art. The statutory requirement of first inventorship is of transcendent importance and every effort should be made to avoid the improvident issuance of a patent where there is an adverse claimant.

Following are illustrative situations where the examiner should take action toward instituting interference:

(A) Application filed with claims to divisible inventions I and II. Before action requiring restriction is made, examiner discovers another application having claims to invention I.

The situation is not altered by the fact that a requirement for restriction had actually been made but had not been reply to. Nor is the situation materially different if an election of noninterfering subject matter had been made without traverse but no action given on the merits of the elected invention.

(B) Application filed with claims to divisible inventions I and II and in reply to a requirement for restriction, applicant traverses the same and elects invention I. Examiner gives an action on the merits of I. Examiner subsequently finds an application to another containing allowed claims to invention II and which is ready for issue.

The situation is not altered by the fact that the election is made without traverse and the nonelected claims possibly canceled.

(C) Application filed with generic claims and claimed species a, b, c, d, and e. Generic claims rejected and election of a single species required. Applicant elects species a, but continues to urge allowability of generic claims. Examiner finds another application claiming species b which is ready for issue.

An interference may be set up even though the generic claims in the first application are not allowable.

(D) Application filed with generic claims and claims to five species and other species disclosed but not specifically claimed. Examiner finds another application the disclosure and claims of which are restricted to one of the unclaimed species and have been found allowable.

The prosecution of generic claims is taken as indication of an intention to cover all species disclosed which come under the generic claim.

In all the above situations, the applicant has shown an intention to claim the subject matter which is actually being claimed in another application. These are to be distinguished from situations where a distinct invention is claimed in one application but merely disclosed in another application without evidence of an intent to claim the same. The question of interference should not be considered in the latter instance. However, if the application disclosing but not claiming the invention is senior, and the junior application is ready for issue, the matter should be discussed with the Group Director to determine the action to be taken.

2304 Applicant Requests Interference Between Applications

37 CFR 1.604. Request for interference between applications by an applicant.

(a) An applicant may seek to have an interference declared with an application of another by,

(1) Suggesting a proposed count and presenting at least one claim corresponding to the proposed count or identifying at least one claim in its application that corresponds to the proposed count,

(2) Identifying the other application and, if known, a claim in the other application which corresponds to the proposed count, and

(3) Explaining why an interference should be declared.

(b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where it appears an applicant may have failed to comply with the provisions of this paragraph.

See MPEP § 2309–2309.02 regarding procedures for preparation of interference papers by the examiner.

2305 Examiner Suggests Claim to Applicant

37 CFR 1.605. Suggestion of claim to applicant by examiner.

(a) If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the examiner may suggest that an applicant present a claim drawn to an invention claimed in another application or patent for the purpose of an interference with another application or a patent. The applicant to whom the claim is suggested shall amend the application by presenting the suggested claim within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim. At the time the suggested claim is presented, the applicant may also call the examiner's attention to other claims already in the application or presented with the suggested claim and explain why the other claims would be more appropriate to be designated to correspond to a count in any interference which may be declared.

(b) The suggestion of a claim by the examiner for the purpose of an interference will not stay the period for response to any outstanding Office action. When a suggested claim is timely presented, *ex parte* proceedings in the application will be stayed pending a determination of whether an interference will be declared.

While the claims of two or more applications may not be identical, if they are directed to the same patentable invention, as defined in 37 CFR 1.601(n), an interference exists. See MPEP § 2303. Therefore, it should be emphasized that it should not be necessary to suggest a claim to an applicant in most situations. If an applicant is not claiming the same patentable invention as another applicant, the examiner, in deciding whether to suggest a claim or claims to the first applicant, should bear in mind that mere disclosure by an applicant of an invention which he or she is not claiming does not afford a ground for suggesting to that applicant a claim for the said invention based upon claims from another application that is claiming the invention. The intention of the parties to claim the same patentable invention, as expressed in the summary of the invention or elsewhere in the disclosure or in the claims, is an essential to declaring an interference or suggesting interfering claims in every instance.

The question of what claim or claims to suggest in the interfering application is one of great importance, and failure to suggest such claims as will define clearly the matter in issue leads to confusion and to prolongation of the contest.

Before deciding what claim or claims to suggest to an applicant, the examiner should decide what the count or counts of the prospective interference will be, keeping in mind that the count must be patentable over the prior art and define the parties' common invention (see MPEP § 2309 regarding the formation of counts). The claim suggested to the applicant need not be identical to the prospective count, but rather should be the broadest claim within the scope of the prospective count which the applicant's disclosure will support, and which is otherwise patentable to the applicant. In general, <u>only one claim should be suggested for each prospective count</u>.

Under 37 CFR 1.605, timely filing of an amendment presenting a claim suggested by the examiner for purposes of an interference would stay *ex parte* proceedings in the application in which the claim is presented pending a determination by the examiner of whether an interference will be declared. Also under 37 CFR 1.605(a), when an examiner suggests a claim, the applicant will be required to copy verbatim the suggested claim. At the time the suggested claim is copied, however, the applicant may also (1) call the examiner's attention to other claims already in the application or which are presented with the copied claim and (2) explain why the other claims would be more appropriate to be designated to correspond to a count in any interference which may be declared.

A reply to the examiner's suggestion of a claim is not complete unless it includes an amendment adding the exact claim suggested to the application. Even though the applicant may consider the suggested claim unpatentable, too narrow, or otherwise unsuitable, it must be presented; otherwise, the invention defined by the suggested claim is considered to be disclaimed. The applicant must make known any such objections to the examiner, and may at the same time present other claims, or call the examiner's attention to other claims already in the application, and explain why those claims would be more appropriately designated to correspond to a count in the interference. The examiner may then determine whether the applicant's alternatively proposed claims are more appropriate than the claim suggested.

If, in copying a suggested claim, an error is introduced by the applicant, the examiner should correct the applicant's claim to correspond to the suggested claim.

It should be noted at this point that if an applicant presents a claim which allegedly corresponds exactly or substantially to a claim in another application or patent without suggestion by the examiner, 37 CFR 1.604(b) and 37 CFR 1.607(c) require him or her to identify the other application or patent. See MPEP § 2307.05.

If the parties have the same attorney, notification of this fact should be given to both parties at the time claims are suggested even though claims are suggested to only one party. Notation of the persons to whom this letter is mailed should be made on all copies.

The content of Form Paragraph 23.05 is usually added to the letter suggesting claims where the same attorney or agent is of record in applications of different ownership which have conflicting subject matter.

¶ *23.05 Same Attorney, Both Applications*

Attention is called to the fact that the attorney (or agent) in this application is also the attorney (or agent) in an application of another party and of different ownership claiming substantially the same patentable invention as claimed in the above identified application.

The attention of the Commissioner is not called to the fact that two conflicting parties have the same attorney until actual interference is set up and then it is done by notifying the administrative patent judge as explained in MPEP § 2309.02.

Form Paragraphs 23.04 and 23.06 may be used to suggest claims for purposes of interference to applicants. If the Office action incorporating these form paragraphs addresses other issues, such as a rejection of other claims, Form Paragraph 23.07 should be included at the end of the action.

¶ *23.04 Suggestion of Claim*

The following allowable claim is suggested for the purpose of an interference:

[1]

The suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to make the suggested claim. Failure to do so will be considered a disclaimer of the subject matter of this claim under the provisions of 37 CFR 1.605(a), but will **not** result in abandonment of this application. THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

Claim[2] considered unpatentable over this suggested claim.

Examiner Note:

1. In bracket 1, insert the suggested claim.
2. In bracket 2, list <u>all</u> claims pending in the application not considered to be patentably distinct from the suggested claim.
3. Only one claim should be suggested unless claims to separate patentably distinct inventions are present. See 37 CFR 1.601(n). To suggest an additional claim to a separate distinct invention, form paragraph 23.06 should follow this paragraph.
4. If the Office action addresses other issues, such as a rejection of other claims, form paragraph 23.07 should be included at the end of the action.

¶ *23.06 Suggestion of Additional Claim for a Distinct Invention*

The following claim is considered allowable and directed to a separate patentable invention from the claim suggested above:

[1]

The additionally suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to make this additionally suggested claim. Failure to do so will be considered a disclaimer of the subject matter of this claim under the provisions of 37 CFR 1.605(a), but will **not** result in abandonment of this application. THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

Claim[2] considered unpatentable over this additionally suggested claim.

Examiner Note:

This paragraph must be preceded by form paragraph 23.04 and should only be used to suggest a patentably distinct claim from the one suggested in form paragraph 23.04.

¶ *23.07 Suggestion of Claims – Prosecution Suspended*

Applicant need not respond to the remaining issues in this action if a suggested claim is copied for the purpose of an interference within the time limit specified above (37 CFR 1.605(b)).

Examiner Note:

This paragraph should be used at the end of any Office action where claims are suggested using either form paragraph 23.04 or 23.09 and where additional issues (e.g., a rejection of other claims) are addressed in the action that will be suspended should applicant copy the suggested claim.

2305.01 Action To Be Made at Time of Suggesting Claims

At the same time that the claims are suggested, an action is made on each of the applications that are up for action by the examiner, whether they be new or amended applications. In this way, possible motions under 37 CFR 1.633(c) and (d) may be forestalled. That is, the action on the new or amended application may bring to light patentable claims that should be included as corresponding to the count of, or as forming the basis for, an additional count of the interference, and, on the other hand, the rejection of unpatentable claims will serve to indicate to the opposing parties the position of the examiner with respect to such claims.

When an examiner suggests that an applicant present a claim for interference, the examiner should state which of the claims already in the application are, in his or her opinion, unpatentable over the claim suggested. This statement does not constitute a formal rejection of the claims, but if the applicant presents the suggested claim but disagrees with the examiner's statement, the applicant should so state on the record, not later than the time the claim is presented. *In re Bandel*, 348 F.2d 563, 146 USPQ 389 (CCPA 1965). If the applicant does not present the suggested claim by the expiration of the period fixed for its presentation, the examiner should then reject those claims which were previously stated as being unpatentable over the suggested claim on the basis that the failure to present constituted a concession that the subject matter of those claims is the prior invention of another in this country under 35 U.S.C. 102(g) and thus prior art to the applicant under 35 U.S.C. 103. *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975). If the applicant does present the suggested claim, when the interference is declared, the claims stated to be unpatentable over the suggested claim will be designated as corresponding to the count.

2305.02 Time Limit Set for Presenting Suggested Claims

Where claims are suggested for interference, a limited period determined by the examiner, not less than one month, is set for reply. See MPEP § 710.02(c).

Should any one of the applicants fail to present the claim or claims suggested within the time specified, all claims not patentable thereover are rejected on the ground that the applicant has disclaimed the invention to which they are directed. If the applicant presents the suggested claims later they will be rejected on the same ground. See MPEP § 706.03(u).

2305.03 Suggested Claims Presented After Period for Reply Running Against Application

If suggested claims are presented within the time specified for making the claims, the applicant may ignore any outstanding rejections in the application. Even if claims are suggested in an application near the end of the period for reply, and the time limit for presenting the claims extends beyond the end of the period, such claims will be admitted if filed within the time limit even though outside the period for reply to the rejection (usually a 3–month shortened statutory period) and even though no amendment was filed in reply to the Office action outstanding against the application at the time of suggesting the claims. No portion of the application is abandoned provided the applicant presents the suggested claims within the time specified. However, if the suggested claims are not thus presented within the specified time, the application becomes abandoned in the absence of a reply filed within the period for reply to the rejection. 37 CFR 1.605(b).

2305.04 Suggestion of Claims, Application in Issue or in Interference

An application will not be withdrawn from issue for the purpose of suggesting claims for an interference. When an application pending before the examiner contains one or more claims defining an invention to which claims may be presented in an application in issue, the examiner may write a letter suggesting such claims to the applicant whose application is in issue, stating that if such claims be presented within a certain specified time, the application will be withdrawn from issue, the amendment entered and the interference declared. Such letters must be submitted to the Group Director. If the suggested claims are not presented in the application in issue, it may be necessary to withdraw it from issue for the purpose of rejecting other claims on the implied disclaimer resulting from the failure to present the suggested claims.

When the examiner suggests one or more claims for the purpose of interference with an application in issue to an applicant whose application is pending before him or her, the application in issue will not be withdrawn for the purpose of interference unless the suggested claims are presented in the pending application within the time specified by the examiner. The letter suggesting claims should be submitted to the Group Director for approval.

In either of the above cases, the Publishing Division should be notified when the claims are suggested, so that in case the issue fee is paid during the time in which the suggested claims may be presented, proper steps may be taken to prevent the issue fee from being applied.

The examiner should borrow the allowed application from the Publishing Division and hold the file until the claims are presented or the time limit expires. This avoids any possible issuance of the application as a patent should the issue fee be paid. To further ensure against issuance of the application, the examiner may pencil in the blank space labeled, "Date paid" in the lower right–hand corner of the face of the file wrapper, the initialed request: "Defer for interference." The issue fee is not applied to such an application until the following procedure is carried out.

When notified that the issue fee has been received, the examiner shall prepare a memo to the Publishing Division requesting that issue of the patent be deferred for a period of 3–months due to possible interference. This allows a period of 2 months to complete any action needed. At the end of this 2–month period, the application must either be released to the Publishing Division or be withdrawn from issue.

When an application is found claiming an invention for which claims are to be suggested to other applications already involved in interference, to form another interference, the primary examiner, after obtaining the consent of the administrative patent judge in charge of the interference, borrows the last named applications from the Service Branch of the Board of Patent Appeals and Interferences. In case the application is to be added to an existing interference, the primary examiner need only send the application and form PTO–850 (illustrated in MPEP § 2309.02) properly filled out as to the additional application and identifying the interference, to the administrative patent judge in charge of the interference who will determine the action to be taken. Also, see MPEP § 2342 and § 2364.01.

¶ *23.08 Suggestion of Claims – Application in Issue*

This application has been withdrawn from issue for consideration of a potential interference based on the claims suggested in this action.

Examiner Note:

1. If a conflicting application is in issue, it should be withdrawn using form paragraphs 10.01 or 10.02 prior to suggesting claims for interference.
2. Either form paragraph 23.04 or 23.09 must be used in conjunction with this paragraph.

¶ *23.19 Foreign Priority Not Substantiated*

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)–(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Examiner Note:

This paragraph may be used when claims are suggested to applicant from either an application or a patent and applicant has a claim for priority, but has not filed a translation of the priority document.

2306 Interference Between an Application and a Patent

37 CFR 1.606. Interference between an application and a patent; subject matter of the interference.

Before an interference is declared between an application and an unexpired patent, an examiner must determine that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference. The interfering subject matter will be defined by one or more counts. The application must contain, or be amended to contain, at least one claim that is patentable over the prior art and corresponds to each count. The claim in the application need not be, and most often will not be, identical to a claim in the patent. All claims in the application and patent which define the same patentable invention as a count shall be designated to correspond to the count. At the time an interference is initially declared (§ 1.611), a count shall not be narrower in scope than any application claim that is patentable over the prior art and designated to correspond to the count or any patent claim designated to correspond to the count. Any single patent claim designated to correspond to the count will be presumed, subject to a motion under § 1.633(c), not to contain separate patentable inventions.

An interference may be declared between an application and a patent if the application and patent are claiming the same patentable invention, as defined in 37 CFR 1.601(n), and at least one of the applicant's claims to that invention are patentable to the applicant. Since at least one of the applicant's claims must be patentable, an interference between an application and a patent cannot be declared if:

(A) The patent is a reference against the application under 35 U.S.C. 102(b)/103;

(B) The applicant's claims are not supported by the application disclosure, or otherwise do not comply with 35 U.S.C. 112;

(C) The applicant was not claiming the same or substantially the same invention as claimed in the patent within 1 year after the date on which the patent was issued (35 U.S.C. 135(b); see also MPEP § 2307);

(D) The patent is a reference against the application under 35 U.S.C. 102(e)/103, unless the applicant has filed a showing under 37 CFR 1.608. See MPEP § 2307.02 concerning the rejection of claims in an application which correspond to claims of a patent.

Since the claims of a patent may not be altered (except by reissue or reexamination), the applicant must claim the same patentable invention as is claimed in one or more claims of a patent in order to provoke an interference with the patent. The fact that the patent may disclose subject matter claimed by the applicant is not a basis for interference if the patent does not claim that subject matter.

The counts of the interference are formulated in essentially the same manner regardless of whether or not a patent is involved. As stated in 37 CFR 1.601(f), "each count shall define a separate patentable invention." Therefore, instead of having the same number of counts as copied patent claims, the examiner determines how many separate patentable inventions are claimed by the applicant and the patentee. When the interference is declared, there will be only one count for each separate patentable invention, with all the claims of the applicant and of the patentee which claim each invention designated as corresponding to the count for that invention. See MPEP § 2309.01 for a more detailed discussion of the formulation of counts.

An interference between an application and a patent may arise in one of the following ways:

(A) During examination of an application, the examiner may determine that the application contains one or more allowable claims which are drawn to the same invention as claimed in a patent. In that event, the examiner may proceed to initiate the interference as described in MPEP § 2309.

(B) The examiner may discover a patent having an effective U.S. filing date later than the effective filing date of an application which claims an invention which is disclosed by the applicant and to which the applicant could present patentable claims. In that event, the examiner should proceed in accordance with MPEP § 2306.01.

(C) The applicant may provoke an interference with a patent by presenting a proposed count and either presenting a claim corresponding to the proposed count, or identifying a claim already in the application that corresponds to the proposed count. See 37 CFR 1.607 and MPEP § 2307.

It should be emphasized that the requirement that the claims of the application and of the patent define the same patentable invention in order for an interference to exist does not mean that the application claim or claims must necessarily be identical to the corresponding claim or claims of the patent. All that is required under present practice is that a claim of the application be drawn to the same patentable invention as a claim of the patent. An application claim is considered to be drawn to the same patentable invention as a patent claim if it recites subject matter which is the same as (35 U.S.C. 102) or obvious in view of (35 U.S.C. 103), the subject matter recited in the patent claim. 37 CFR 1.601(n). The test is analogous to that applied for double patenting; i.e., if the applicant's claim would have been subject to a double patenting rejection of the "same invention" or "obviousness" type (see MPEP § 804) if the patent and application were by the same inventive entity, then the application and patent claim are directed to the same invention. In all cases, the examiner should keep in mind the fundamental principle that the issuance of two patents for inventions which are either identical to or not patentably distinct from each other must be avoided. *Aelony v. Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977).

37 CFR 1.601(i) includes the possibility that an interference may include more than one unexpired patent. The PTO does not have jurisdiction to determine interferences involving only patents, since 35 U.S.C. 291 grants that jurisdiction to the courts. However, if the examiner discovers two or more patents which are claiming the same invention as an application, an interference may be instituted between the application and the patents. The Group Director's approval must be obtained before an interference involving multiple patents will be declared.

PATENT IN DIFFERENT GROUP

When an applicant seeks to provoke an interference with a patent classified in another group, the propriety of initiating the interference is decided by and the interference is initiated by the group where the patent is classified. In such a case, it may be necessary to transfer the application, including the drawings, temporarily to the group which will initiate the interference.

Under 37 CFR 1.606, at the time an interference is declared, a *rebuttable* presumption will exist that any patent claim designated to correspond to a count does not embrace separate patentable inventions. The presumption is *rebuttable* and may be challenged and overcome by a motion under 37 CFR 1.633(c). Moreover, at the time the interference is declared, no count will be narrower in scope than any application claim that is patentable over the prior art and designated to correspond to the count or any patent claim designated to correspond to the count.

2306.01 Patent Has Filing Date Later Than Application

Although a patent which has an effective U.S. filing date later than the effective filing date of an application is not prior art against that application, the application should not be issued if the application and patent contain claims to the same patentable invention. In order to avoid the issuance of two patents to the same patentable invention, the examiner should take steps to initiate an interference between the application and the patent.

If the application contains at least one allowable claim drawn to the same patentable invention as at least one patent claim, the examiner may initiate the interference by proceeding as described in MPEP § 2309.

If the application discloses, but does not claim, an invention claimed in the patent, the examiner should suggest a claim or claims to the applicant (see MPEP § 2305), and include a statement that failure of the applicant to make the claim or claims will be taken as a concession that the subject matter of the claim or claims is the prior invention of another. Form Paragraphs 23.09 and 23.10 should be used for this purpose.

¶ *23.09 Requirement To Copy Patent Claim*

The following claim number [1] from U.S. Patent No. [2] is suggested to applicant under 35 U.S.C. 135(a) for the purposes of an interference:

[3]

The suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to copy this patent claim. Failure to do so will be considered a concession that the subject matter of this claim is the prior invention of another under 35 U.S.C. 102(g), and thus also prior art under 35 U.S.C. 103(a) (*In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975)), but will **not** result in the abandonment of this application. THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

Examiner Note:

1. In bracket 1, insert the number from the patent of the suggested claim.
2. In bracket 2, insert the number of the patent.
3. In bracket 3, insert a copy of the patent claim.
4. Only one claim from the patent should be suggested for interference unless other claims to a separate patentably distinct invention are claimed in the patent and can be made by the applicant. To suggest an additional claim, form paragraph 23.10 should follow this paragraph.
5. If the Office action addresses other issues, such as a rejection of other claims, form paragraph 23.07 should be included at the end of the Office action.

¶ *23.10 Copying Additional Patent Claims for a Distinct Invention*

Claim number [1] from U.S. Patent No. [2] is suggested under 35 U.S.C. 135(a) in addition to claim [3] of the patent, suggested above. The inventions defined by these patent claims are considered to be "separate patentable inventions" under 37 CFR 1.601(n) which could form the basis for plural counts in an interference.

The suggested claim, reproduced below, must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

[4]

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to copy this additional patent claim. Failure to do so will be considered a concession that the subject matter of this claim is the prior invention of another under 35 U.S.C. 102(g), and thus also prior art under 35 U.S.C. 103(a) (*In re Oguie*, 517 F.2d 1382,186 USPQ 227 (CCPA 1975)). THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

Examiner Note:

1. In bracket 1, insert the number of the patent claim that is patentably distinct from the claim specified in form paragraph 23.09.
2. This paragraph must follow form paragraph 23.09 and should only be used in those rare instances where both the patent and the application claim distinct, interfering inventions.

2307 Applicant Requests Interference With a Patent

37 CFR 1.607. Request by applicant for interference with patent.

(a) An applicant may seek to have an interference declared between an application and an unexpired patent by,

(1) Identifying the patent,

(2) Presenting a proposed count,

(3) Identifying at least one claim in the patent corresponding to the proposed count,

(4) Presenting at least one claim corresponding to the proposed count or identifying at least one claim already pending in its application that corresponds to the proposed count, and, if any claim of the patent or application identified as corresponding to the proposed count does not correspond exactly to the proposed count, explaining why each such claim corresponds to the proposed count, and

(5) Applying the terms of any application claim,

(i) Identified as corresponding to the count, and

(ii) Not previously in the application to the disclosure of the application.

(6) Explaining how the requirements of 35 U.S.C. 135(b) are met, if the claim presented or identified under paragraph (a)(4) of this section was not present in the application until more than one year after the issue date of the patent.

(b) When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office. The examiner shall determine whether there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in an interference. If the examiner determines that there is any interfering subject matter, an interference will be declared. If the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared and otherwise act on the application.

(c) When an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where an applicant fails to identify the patent.

(d) A notice that an applicant is seeking to provoke an interference with a patent will be placed in the file of the patent and a copy of the notice will be sent to the patentee. The identity of the applicant will not be disclosed unless an interference is declared. If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

If the applicant does not apply the terms of the claim presented to the disclosure of the application, i.e., does not state how each term of the copied claim is supported by the specification, as required by 37 CFR 1.607(a)(5), a one–month time period should be set for correction of this deficiency. Form Paragraph 23.12 should be used for this purpose.

COMPLIANCE WITH 35 U.S.C. 135(b)

If the claim presented or identified as corresponding to the proposed count was added to the application by an amendment filed more than one year after issuance of the patent, or the application was not filed until more than one year after issuance of the patent (but the patent is not a statutory bar), then under the provisions of 35 U.S.C. 135(b), an interference will not be declared unless at least one of the claims which were in the application, or a parent application, prior to expiration of the one–year period was for "substantially the same subject matter" as at least one of the claims of the patent. Therefore, 37 CFR 1.607(a)(6) requires that the request for interference with the patent include an explanation of how the requirements of 35 U.S.C. 135(b) are met. If this explanation is not provided, a one–month time period should be set for correction of this deficiency.

The explanation under 37 CFR 1.607(a)(6) must be considered by the examiner to determine whether the "substantially the same subject matter" requirement of 35 U.S.C. 135(b) has been met. In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim. *Parks v. Fine*, 773 F.2d 1577, 227 USPQ 432 (Fed. Cir. 1985), *modified*, 783 F.2d 1036, 228 USPQ 677 (1986). See also *Corbett v. Chisholm*, 568 F.2d 759, 196 USPQ 337 (CCPA 1977); *In re Sitz*, 331 F.2d 617, 141 USPQ 505 (CCPA 1964); *Stalego v. Heymes*, 263 F.2d 334, 120 USPQ 473 (CCPA 1959); *Rieser v. Williams*, 255 F.2d 419, 118 USPQ 96 (CCPA 1958); *Emerson v. Beach*, 215 F.2d 290, 103 USPQ 45 (CCPA 1955); *In re Tanke*, 213 F.2d 551, 102 USPQ 93 (CCPA 1954); *Andrews v. Wickenden*, 194 F.2d 729, 93 USPQ 27 (CCPA 1952); *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950); *Thompson v. Hamilton*, 152 F.2d 994, 68 USPQ 161 (CCPA 1946). The fact that the application claim may be broad enough to cover the patent claim is not sufficient. *In re Frey*, 182 F.2d 184, 86 USPQ 99 (CCPA 1950).

If none of the claims which were present in the application, or a parent application, prior to expiration of the one–year period meets the "substantially for the same subject matter" test, the claims presented or identified as corresponding to the proposed count should be rejected under 35 U.S.C. 135(b). *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997).

Note that the expression "prior to one year from the date on which the patent was granted" in 35 U.S.C. 135(b) includes the one–year anniversary date of the issuance of a patent. *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964).

SPECIAL DISPATCH

Examiners should note that 37 CFR 1.607 requires that examination of an application in which applicant seeks an interference with a patent "shall be conducted with special dispatch."

See MPEP § 708.01.

¶ *23.12 Failure To Apply Terms of Proposed Claim to the Disclosure*

Claim [1] of this application has been copied from U.S. Patent No. [2] for the purpose of an interference.

Applicant has failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application. THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

2307.01 Presentation of Claims Corresponding to Patent Claims Not a Reply to Last Office Action

The presentation of claims corresponding to claims of a patent when not suggested by the Office does not constitute a reply to the last Office action unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

2307.02 Rejection of Claims Corresponding to Patent Claims

When claims corresponding to claims of a patent are presented, the application is taken up at once and the examiner must determine whether the presented claims are unpatentable to the applicant on any ground(s), e.g., under 35 U.S.C. 102, 35 U.S.C. 103, 35 U.S.C. 112, 35 U.S.C. 135(b), double patenting, etc. If at least one of the presented claims is not rejectable on any such ground and is claiming the same invention as at least one claim of the patent, the examiner should proceed to initiate an interference.

If all of the claims presented are rejectable on any grounds, they should be so rejected. The ground of rejection of the claims presented may or may not be one which would also be applicable to the corresponding claims in the patent. If the ground of rejection is also applicable to the corresponding claims in the patent, any letter including the rejection must have the approval of the Group Director. See MPEP § 1003. Examples of grounds of rejection which would not also be applicable to the patent are double patenting, insufficient disclosure in the application, a reference whose date is junior to that of the patent, or a bar under 35 U.S.C. 135(b) (see MPEP § 2307).

The examiner should not proceed to initiate an interference where the examiner is aware of a reference or other ground of unpatentability for the application claims which correspond to the patent claims, even if the ground of unpatentability would also be applicable to the patent claims. Although an applicant may wish to have his or her application placed in interference with a patent in order to raise a ground of unpatentability against the patent claims, an interference will not be initiated unless at least one of the claims in the application which correspond to the claims of the patent is allowable.

If the patent has a filing date earlier than the application effective filing date, see MPEP § 2308.01.

37 CFR 1.607(b) requires that "[w]hen an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office." Therefore, when all the claims presented are rejected the examiner sets a time limit for reply, not less than 30 days, and all subsequent actions, including action of the Board on appeal, are special. Failure to reply or appeal, as the case may be, within the time fixed, will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

While the time limit for an appeal from the final rejection of a claim corresponding to a patent claim is usually set under the provisions of 37 CFR 1.607(b), where the remainder of the application is ready for final action, it may be advisable to set a shortened statutory period for the entire application in accordance with 37 CFR 1.134.

There is an important distinction between a limited time for reply under 37 CFR 1.607(b) and a shortened statutory period under 37 CFR 1.134. The penalty resulting from failure to reply within the time limit under 37 CFR 1.607(b) is loss of the claim or claims involved, on the doctrine of disclaimer, and this is appealable; while failure to reply within the set statutory period (37 CFR 1.134) results in abandonment of the entire application. This is not appealable.

The rejection of claims presented for interference with a patent sometimes creates a situation where two different periods for reply are running against the application – one, the statutory period dating from the last full action on the application; the other, the limited period set for the reply to the rejection (either first or final) of the presented claims. This condition should be avoided where possible as by setting a shortened period for the entire application, but where unavoidable, it should be emphasized in the examiner's letter.

In this connection it is to be noted that a reply to a rejection or an appeal from the final rejection of the presented claims will not stay the running of the regular statutory period if there is an unanswered Office action in the application at the time of reply or appeal, nor does such reply or appeal relieve the examiner from the duty of acting on the application if it is up for action, when reached in its regular order.

Where an Office action sets a time limit for reply to or appeal from that action or a portion thereof, the examiner should note at the end of the letter the date when the time limit period ends and also the date when the statutory period ends. See MPEP § 710.04.

¶ *23.13 Rejection of Claim Corresponding to Proposed Count*

Claim [1] of this application has been copied by the applicant from U.S. Patent No. [2]. This claim is not patentable to the applicant because [3].

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

Examiner Note:

This paragraph must be preceded by a rejection of the claim.

¶ *23.14 Claims Not Copied Within One Year*

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. [2] was granted.

¶ *23.15 Copied Claims Drawn to Different Invention*

Claim [1] of this application is asserted by applicant to correspond to claim(s) of U.S. Patent No. [2].

The examiner does not consider this claim to be directed to the same invention as that of U.S. Patent No. [3] because [4]. Accordingly, an interference cannot be initiated based upon this claim.

2307.03 Presentation of Claims for Interference With a Patent, After Prosecution of Application is Closed

An amendment presenting a claim to provoke an interference in an application not in issue is usually admitted and promptly acted on. However, if the application had been closed to further prosecution as by final rejection or allowance of all the claims, or by appeal, such amendment is not entered as a matter of right.

An interference may result when an applicant presents claims to provoke an interference with a patent which provided the basis for final rejection. Where this occurs, if the rejection in question has been appealed, the Board of Patent Appeals and Interferences should be notified of the withdrawal of this rejection so that the appeal may be dismissed as to the involved claims.

Where the prosecution of the application is closed and the presented claims relate to an invention distinct from that claimed in the application, entry of the amendment may be denied. See *Ex parte Shohan*, 48 USPQ 326, 1941 C.D. 1 (Comm'r Pat. 1940). Admission of the amendment may very properly be denied in a closed application, if *prima facie*, the claims are not supported by the applicant's disclosure. An applicant may not have recourse to presenting a claim corresponding to a patent claim which applicant has no right to make as a means to reopen or prolong the prosecution of his or her application. See MPEP § 714.19.

AFTER NOTICE OF ALLOWANCE

When an amendment which includes one or more claims presented to provoke an interference with a patent is received after the Notice of Allowance and the examiner finds one or more of the claims patentable to the applicant and an interference to exist, the examiner should prepare a letter, requesting that the application be withdrawn from issue for the purpose of interference. This letter, which should designate the claims to be involved, together with the file and the proposed amendments, should be sent to the Group Director.

When an amendment which includes one or more claims presented to provoke an interference with a patent is received after Notice of Allowance, and the examiner finds basis for refusing the interference on any ground, the examiner should make an oral report to the supervisory primary examiner of the reasons for refusing the requested interference. Notification to applicant is made on Form PTOL–271 if the entire amendment or a portion of the amendment (including all the presented claims) is refused. Form paragraph 23.01 should be employed to express the adverse recommendation as to the entry of the presented claims.

¶ *23.01 Entry of Claims Disapproved*

Entry of claim [1] disapproved because [2]. This application will not be withdrawn from issue.

Examiner Note:

In bracket 2, insert brief statement of basic reasons for disapproval. See MPEP § 2307.03.

2307.04 Presentation of Claims for Interference With a Patent Involved in a Reexamination Proceeding

An interference will not be declared with a patent which is involved in a reexamination proceeding except upon specific authorization from the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. Claims which would interfere with the patent may be rejected on any applicable ground, including, if appropriate, the prior art cited in the reexamination proceeding. See MPEP § 2307.02. Prosecution of the application should continue as far as possible, but if the application is placed in condition for allowance and still contains claims which interfere with the patent under reexamination, further action on the application should be suspended until the reexamination proceeding is terminated. See MPEP § 2284.

¶ *23.16 Patent Claims Undergoing Reexamination*

This application contains claims which conflict with the claims of U.S. Patent No. [1], now involved in a reexamination proceeding.

Prosecution in this application is SUSPENDED until termination of the reexamination proceeding.

Applicant should inquire as to the status of this application SIX MONTHS from the date of this letter.

Examiner Note:

This paragraph should only be used when the application is otherwise in condition for allowance.

2307.05 Corresponding Patent Claims Not Identified

37 CFR 1.607(c) requires that "[w]hen an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner."

This requirement of 37 CFR 1.607(c) applies to claims presented in an application at the time of filing as well as to claims presented in an amendment to a pending application. If an applicant, attorney, or agent presents a claim corresponding exactly or substantially to a patent claim without complying with 37 CFR 1.607(c) the examiner may be led into making an action different from what would have been made had the examiner been in possession of all the facts. Therefore, failure to comply with 37 CFR 1.607, when presenting a claim corresponding to a patent claim, may result in the issuance of a requirement for information as to why an identification of the source of the claim was not made. Also see 37 CFR 10.23(c)(7).

The examiner should require the applicant to supply a full identification of the copied patent claims by using Form paragraph 23.11.

¶ *23.11 Failure To Identify Source of Patent Claims*

Claim [1] of this application [2] apparently been copied from a U.S. patent without being suggested by the examiner. The patent number and the number of the copied claims have not been properly identified. 37 CFR 1.607(c).

Applicant is required to identify the patent and claim numbers and supply information explaining why a complete identification of the copied patent claim(s) has not been presented. Following applicant's reply to this requirement or the abandonment thereof, this application will be forwarded by the examiner to the Office of the Assistant Commissioner for Patents for appropriate review as noted under 37 CFR 1.607(c).

Applicant is given a TIME PERIOD of ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication for reply to avoid abandonment of this application.

Examiner Note:

1. The primary examiner must refrain from commenting as to the reasons for applicant's failure to disclose the U. S. patent identification.
2. In bracket 2, insert --has-- or --have--, as appropriate.

After the applicant's reply or abandonment of the application, the examiner is required to "notify the Commissioner of any instance where an applicant fails to identify the patent" under 37 CFR 1.607(c). The examiner's notification should be in the form of a memorandum directed to the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. The memorandum must be accompanied by the application and a copy of the patent from which the claim(s) was copied.

2307.06 Presentation of Claims for Interference with a Patent, Patentee Must Be Notified

When an applicant seeks to provoke an interference with a patent, 37 CFR 1.607(d) requires that the patentee be notified (1) when the attempt to provoke the interference is first made, and (2) if an interference is not declared of the final decision not to declare an interference.

This rule provides a patentee with notice as soon as an applicant attempts to provoke an interference with the patent so that the patentee can preserve the invention records from the moment the notice is received until the time, in some instances many years later, when the interference is ultimately declared between the patentee and the applicant.

Form paragraphs 23.20 and 23.21 should be used to notify the patentee.

¶ *23.20 Notice to Patentee, Interference Sought*

[PTO Letterhead]

[1]

You are hereby notified under 37 CFR 1.607(d) that an applicant is seeking to provoke an interference with your U. S. Patent No. [2].

The identity of the applicant will not be disclosed unless an interference is declared.

If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

If an interference is declared, notice thereof will be made under 37 CFR 1.611.

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[3]
Primary Examiner
Art Unit [4]
(703) [5]

Examiner Note:

1. This form paragraph is printed with the PTO Letterhead.
2. In bracket 1, insert the mailing address of the patentee.
3. In bracket 3, insert the name of the Primary Examiner.

¶ *23.21 Notice to Patentee, Interference Not Declared*

[PTO Letterhead]

[1]

Notice was communicated to you under 37 CFR 1.607(d) on [2] that an applicant was seeking to provoke an interference with your U.S. Patent No. [3].

A final determination of this issue has resulted in a decision not to declare an interference.

No inquiries regarding the identity of the applicant will be entertained.

---

[4]
Primary Examiner
Art Unit [5]
(703) [6]

Examiner Note:

1. This form paragraph is printed with the PTO Letterhead.
2. In bracket 1, insert the mailing address of the patentee.
3. In bracket 2, insert the date of mailing of the earlier notice that claims had been copied from that patent.
4. In bracket 4, insert the name of the Primary Examiner.

It is anticipated that patentees may make inquiries as to the status of the application after the first notification has been received. Since the group having responsibility for the application will be indicated on the letter and the letter will not contain any information pertaining to that application, it will be necessary for each examining group to establish and maintain some type of permanent record. The type of permanent record is left to the discretion of the group director. This permanent record must be independent of the application file and the patented file in order to provide adequate information for patentee inquiries relative to nonreceipt of either a second notice or a notice of declaration of interference either before or after either is mailed from the Patent and Trademark Office. Additionally, the permanent record must associate the appropriate patent number and the application number. This record could be a separate group file for 37 CFR 1.607(d) notices sent to patentees having appropriate identification of the patent and application.

In summary, a 37 CFR 1.607(d) notice (Form paragraph 23.20) is prepared by a person in the group having jurisdiction over the application attempting to provoke an interference with a patent. The original is placed of record in the patented file, one copy is sent to the patentee, and an entry is made in the permanent group record for 37 CFR 1.607(d) notices. If a final decision is made that no interference will be declared, a primary examiner will prepare and sign a 37 CFR 1.607(d) notice (Form paragraph 23.21).

The original of this notice is entered of record in the patented file, one copy is sent to the patentee, and another entry is made in the permanent record for 37 CFR 1.607(d) notices. If an interference is to be instituted, the declaration of interference notice will be sent by an administrative patent judge and no additional form will be sent by the examiner.

Although the permanent record for 37 CFR 1.607(d) notices includes identification both of the patent and application, the patentee cannot and should not be given any information concerning the party or application attempting to provoke an interference unless and until an interference is declared. 35 U.S.C. 122.

2308 Interference Between an Application and a Patent; *Prima Facie* Showing by Applicant

37 CFR 1.608. Interference between an application and a patent; prima facie showing by applicant.

(a) When the effective filing date of an application is three months or less after the effective filing date of a patent, before an interference will be declared, either the applicant or the applicant's attorney or agent of record shall file a statement alleging that there is a basis upon which the applicant is entitled to a judgment relative to the patentee.

(b) When the effective filing date of an application is more than three months after the effective filing date of a patent, the applicant, before an interference will be declared, shall file evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment. Where the basis upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would *prima facie* entitle the applicant to judgment on priority with respect to the effective filing date of the patent. To facilitate preparation of a record (§ 1.653(g)) for final hearing, an applicant should file affidavits on paper which is 21.8 by 27.9 cm. (8 1/2 x 11 inches). The significance of any printed publication or other document which is self–authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the explanation. Any printed publication or other document which is not self–authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of good cause, an affidavit may be based on information and belief. If an examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

Under 37 CFR 1.608, an applicant seeking to provoke an interference with a patent is required to submit evidence which demonstrates that the applicant is *prima facie* entitled to a judgment relative to the patentee. Evidence must be submitted when the effective filing date of the application is more than 3 months after the effective filing date of the patent. The evidence may relate to patentability and need not be restricted to priority, but if the evidence shows that the claims of the application are not patentable, the claims in the application will be rejected. The applicant can file a request for reexamination of the patent, if applicable.

2308.01 Patent Has Filing Date Earlier Than Application

When an applicant attempts to provoke an interference with a patent, the examiner must determine the effective filing dates of the application and of the patent; only the patent's effective United States filing date will be considered. Any claim of foreign priority by the patentee under 35 U.S.C. 119 will not be taken into account when determining whether or not an interference should be declared, in order to be consistent with the holding in *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966), that the effective date of a United States patent *as a reference* is not affected by the foreign filing date to which the patentee is entitled under 35 U.S.C. 119. If the patentee is determined to be entitled to the benefit of a prior United States application as to claimed subject matter involved in the interference, that application must be listed on the PTO–850 form (see MPEP § 2309).

If the effective filing date of the application is 3 months or less than 3 months after the effective filing date of the patent, the applicant must submit a statement alleging that there is a basis upon which applicant is entitled to a judgment relative to the patentee. 37 CFR 1.608(a). The statement may be made by persons other than the applicant. See MPEP § 715.04.

If the effective filing date of the application is more than 3 months after the effective filing date of the patent, 37 CFR 1.608(b) requires that the applicant must file (1) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee, and (2) an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment.

If an applicant is claiming the same invention as a patent which has an earlier effective United States filing date but there is not a statutory bar against the application, and the applicant has not submitted the items required by 37 CFR 1.608(a) or (b), as appropriate, the application should be rejected under 35 U.S.C. 102(e)/103. A statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings. Note, however, 35 U.S.C. 135(b) and MPEP § 2307. The applicant should also be advised that an affidavit under 37 CFR 1.608(b) or evidence *and* an explanation under 37 CFR 1.608(b), as appropriate, must be submitted and it should be stated, if applicable, that the patentee has been accorded the benefit of an earlier U.S. application.

If the applicant does not agree he or she is claiming the same invention as the patent, and files an affidavit under 37 CFR 1.131, the rejection should be repeated and made final. The rejection should specify what the count or counts of the interference between the application and the patent would be. If the applicant still disagrees with the examiner, the rejection may be appealed to the Board of Patent Appeals and Interferences, and the question of whether the application and the reference patent are claiming the same invention may be argued on appeal, inasmuch as the 37 CFR 1.131 affidavit cannot be considered unless the applicant is found to be claiming an invention which is patentably distinct from that claimed in the patent. See *In re Clark*, 457 F.2d 1004, 173 USPQ 359 (CCPA 1972) and *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962).

2308.02 Showing Under 37 CFR 1.608(b)

The showing under 37 CFR 1.608(b) must be such as to show that the applicant is *prima facie* entitled to a judgment relative to the patentee. Since 35 U.S.C. 135(a) gives the Board jurisdiction in an interference proceeding over questions of both priority and patentability, the 37 CFR 1.608(b) showing need not attempt to show prior invention by the applicant, but may instead demonstrate that the applicant would be entitled to a judgment against the patentee on a ground of unpatentability which does not apply to applicant's claims (as, for example, that the claims of the patent which will correspond to the count or counts are unpatentable over prior art or prior public use, or that the patent does not comply with 35 U.S.C. 112). Note, however, the last paragraph of this section.

An applicant in preparing affidavits or declarations under 37 CFR 1.608(b) to provoke an interference with a patentee whose effective U.S. filing date antedates the applicant's by more than 3 months, should have in mind the provisions of 37 CFR 1.617, and especially the following:

(A) That after these affidavits or declarations are forwarded by the primary examiner for the declaration of an interference, they will be examined by an administrative patent judge.

(B) If the affidavits or declarations fail to establish that applicant would *prima facie* be entitled to a judgment relative to the patentee, an order will be issued concurrently with the notice of interference, requiring applicant to show cause why summary judgment should not be entered against the applicant.

(C) Additional evidence in response to such order will not be considered unless justified by a showing under the provisions of 37 CFR 1.617(b). If the applicant responds, the applicant must serve the patentee and any other opponents with a copy of the original showing under 37 CFR 1.608(b) and of the response, and they will be entitled to present their views with respect thereto (37 CFR 1.617(d)).

(D) All affidavits or declarations submitted must describe acts which the affiants performed or observed, or circumstances observed, such as structure used and results of use or test, except on a proper showing as provided in 37 CFR 1.608(b). Statements of conclusion, for example, that the invention of the counts was reduced to practice, are generally considered to be not acceptable. It should also be kept in mind that documentary exhibits which are not self–authenticated must be authenticated and discussed with particularity by an affiant having direct knowledge of the matters involved. However, it is not necessary that the exact date of conception or reduction to practice be revealed in the affidavits, declarations, or exhibits if the affidavits or declarations aver observation of the necessary acts and facts, including documentation when available, before the patentee's effective filing date. On the other hand, where reliance is placed upon diligence, the affidavits or declarations and documentation should be precise as to dates from a date just prior to patentee's effective filing date. The showing should relate to the essential factors in the determination of the question of priority of invention as set out in 35 U.S.C. 102(g).

(E) The explanation required by 37 CFR 1.608(b) should be in the nature of a brief or explanatory remarks accompanying an amendment, and should set forth the manner in which the requirements of the counts are satisfied and how the requirements for conception, reduction to practice, or diligence are met, or otherwise explain the basis on which the applicant is *prima facie* entitled to a judgment.

(F) Published decisions of the Court of Appeals for the Federal Circuit, Court of Customs and Patent Appeals and the Board of Patent Interferences concerning the quantum of proof required by an applicant to make out a *prima facie* showing entitling the applicant to an award of priority with respect to the filing date of a patent so as to allow the interference to proceed, 37 CFR 1.617(a), second sentence, include *Schendel v. Curtis*, 83 F.3d 1399, 38 USPQ2d 1743 (Fed. Cir. 1996); *Hahn v. Wong*, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989); *Wetmore v. Quick*, 536 F.2d 937, 190 USPQ 223 (CCPA 1976); *Golota v. Strom*, 489 F.2d 1287, 180 USPQ 396 (CCPA 1974); *Schwab v. Pittman*, 451 F.2d 637, 172 USPQ 69 (CCPA 1971); *Kistler v. Weber*, 412 F.2d 280, 162 USPQ 214 (CCPA 1969); *Azar v. Burns*, 188 USPQ 601 (Bd. Pat. Int. 1975); *Horvitz v. Pritchard*, 182 USPQ 505 (Bd. Pat. Int. 1974); and *Murphy v. Eiseman*, 166 USPQ 149 (Bd. Pat. Int. 1970).

As noted above, the evaluation of a showing under 37 CFR 1.608(b) is made by an administrative patent judge. However, when a showing under 37 CFR 1.608(b) is filed, the examiner must inspect it to determine whether the applicant is relying upon prior invention or unpatentability as a basis for the showing. If the applicant alleges prior invention, the examiner should merely determine that (1) at least one date prior to the effective filing date of the patent is alleged and (2) the showing contains at least one affidavit or declaration by a corroborating witness, i.e., by someone other than a named inventor; if so, the examiner should proceed to initiate the interference as described in MPEP § 2309. If the showing is based on alleged unpatentability of the patent claim or claims, the examiner should determine whether any ground of unpatentability alleged is such that it would also apply to the applicant; for example, if the applicant alleges that the claims of the patent are statutorily barred by a reference which would also be a bar to the applicant. If the examiner finds that an alleged ground of unpatentability would also apply to the applicant, the interference should not be initiated and the applicant's claims which are drawn to the same invention as the claims of the patent should be rejected on this admission of unpatentability, without regard to the merits of the matter. Compare *Ex parte Grall*, 202 USPQ 701 (Bd. App. 1978). Although the applicant may wish to contest the question of whether the common invention is patentable to the patentee, an interference cannot be declared unless the common invention is patentable to the applicant. *Hilborn v. Dann*, 546 F.2d 401, 192 USPQ 132 (CCPA 1976). If the alleged unpatentability is based on patents or printed publications, the applicant may still be able to file a request for reexamination of the patent under 35 U.S.C. 302.

2309 Initiation of Interference

37 CFR 1.609. Preparation of interference papers by examiner.

When the examiner determines that an interference should be declared, the examiner shall forward to the Board:

(a) All relevant application and patent files and

(b) A statement identifying:

(1) The proposed count or counts and, if there is more than one count proposed, explaining why the counts define different patentable inventions;

(2) The claims of any application or patent which correspond to each count, explaining why each claim designated as corresponding to a count is directed to the same patentable invention as the count;

(3) The claims in any application or patent which do not correspond to each count and explaining why each claim designated as

not corresponding to any count is not directed to the same patentable invention as any count; and

(4) Whether an applicant or patentee is entitled to the benefit of the filing date of an earlier application and, if so, sufficient information to identify the earlier application.

An interference is initiated by the examiner sending to the Board of Patent Appeals and Interferences the following:

(A) a filled-out "Interference Initial Memorandum" (Form PTO-850) (see MPEP § 2309.02);

(B) a statement under 37 CFR 1.609(b) (see MPEP § 2309.02); and

(C) the files of each of the applications and patents to be involved in the interference, as well as the files of any U.S. applications or patents of which a party has been accorded benefit on the Form PTO-850.

2309.01 Formulation of Counts

Before preparing the "Interference Initial Memorandum" (Form PTO-850), the examiner must determine precisely what the count or counts of the interference will be.

In formulating the count or counts, the examiner must decide two interrelated questions: (1) how many counts will there be; and (2) what will the scope of each count be. The following principles should be kept in mind:

(A) Each count must be drawn to a separate patentable invention, that is to say, the invention defined in each count must not be the same as, or obvious over, the invention defined in any other count. However, a count may properly be included if it is unobvious over another count, even though the reverse might not be true. For example, a count to a species and a count to a genus might properly both be included in the interference if the species is patentable over the genus, even though the genus might not be patentable, given the species.

It should be emphasized that most interferences will involve only one count or a very small number of counts, in view of the requirement of separate patentability.

(B) A count should normally be sufficiently broad as to encompass the broadest corresponding patentable claim of each of the parties. However, a situation may arise where the examiner considers that an applicant's corresponding claim includes not only the common invention, but also another invention; in that case, the count should be limited to the common invention, and may be narrower than the corresponding claim which recites the additional invention. Note that 37 CFR 1.606 provides that a count may *not initially* be narrower in scope than any *patent* claim which corresponds to it; this does not preclude later substitution of a count which is narrower than the patent claim, as a result of a preliminary motion under 37 CFR 1.633(c).

(C) A count may not be so broad as to be unpatentable over the prior art. If a count cannot be made sufficiently broad in scope as to embrace the broadest corresponding patentable claims of the parties without being unpatentable, that would indicate either that the parties' corresponding claims are unpatentable or perhaps, if the parties' claims do not overlap, that they are drawn to two separately patentable inventions and there is no interference in fact between them.

The following examples illustrate how counts should be formulated. An administrative patent judge should be consulted in unusual situations which do not fit any of the examples.

Example 1: Application A contains patentable claim 1 (engine). Application B contains patentable claim 8 (engine). If an interference is declared, there will be one count (engine). Claim 1 of application A and claim 8 of application B would be designated to correspond to the count.

Example 2: Application C contains patentable claims 1 (engine) and 2 (6-cylinder engine). Application D contains patentable claim 8 (engine). An engine and a 6-cylinder engine define the same patentable invention. If an interference is declared, there will be one count (engine). Claims 1 and 2 of application C and claim 8 of application D would be designated to correspond to the count.

Example 3: Application E contains patentable claims 1 (engine), 2 (6-cylinder engine) and 3 (engine with a platinum piston). Application F contains patentable claims 11 (engine) and 12 (8-cylinder engine). Claims 1 and 2 of application E and claims 11 and 12 of application F define the same patentable invention. Claim 3 of application E defines a separate patentable invention from claims 1 and 2 of application E and claims 11 and 12 of application F. If an interference is declared, there will be one count (engine). Claims 1 and 2 of application E and claims 11 and 12 of application F would be designated to correspond to the count. Claim 3 of application E would not be designated to correspond to the count.

Example 4: Application G contains patentable claims 1 (engine), 2 (6-cylinder engine) and 3 (engine with a platinum piston). Application H contains patentable claims 11 (engine) and 15 (engine with a platinum piston). Claims 1 and 2 of application G and claim 11 of application H define the same patentable invention. Claim 3 of application G and claim 15 of application H define a separate patentable invention from claims 1 and 2 of application G and claim 11 of application H. If an interference is declared, there will be two counts: Count 1 (engine) and count 2 (engine with a platinum piston). Claims 1 and 2 of application G and claim 11 of application H would be designated to correspond to the Count 1. Claim 3 of application G and claim 15 of application H would be designated to correspond to Count 2.

Example 5: Application J contains patentable claims 1 (engine), 2 (combination of an engine and a carburetor) and 3 (combination of an engine, a carburetor, and a catalytic converter). Application K contains patentable claims 31 (engine), 32 (combination of an engine and a carburetor), and 33 (combination of an engine, a carburetor, and an air filter). The engine, combination of an engine and carburetor, and combination of an engine, carburetor, and air filter define the same patentable invention. The combination of an engine, carburetor, and catalytic convertor define a separate patentable invention from the engine. If an interference is declared, there will be one count (engine). Claims 1 and 2 of application J and claims 31, 32 and 33 of application K would be designated to correspond to the Count. Claim 3 of application J would not be designated as corresponding to the count.

Example 6: The PTO will continue to follow *Waldeck v. Lewis*, 120 USPQ 88 (Comm'r Pat. 1955). Application L contains patentable claims 1 (Markush group of benzene or toluene), 2 (benzene), and 3 (toluene). Application M contains patentable claim 11 (benzene). Benzene and toluene define the same patentable invention. If an interference is declared, there will be one count (Markush group of benzene or toluene). Claims 1, 2 and 3 of application L and claim 11 of application M would be designated to correspond to the count.

Example 7: Application N contains patentable claim 1 (benzene). Application P contains patentable claim 11 (xylene). Benzene and xylene define the same patentable invention. If an interference is declared, there will be one count (benzene or xylene). Claim 1 of application N and claim 11 of application P would be designated to correspond to the count.

Example 8: Application Q contains patentable claims 1 (Markush group of benzene or chloroform), 2 (benzene), and 3 (chloroform). Application R contains patentable claim 33 (benzene). If benzene and chloroform define the same patentable invention and an interference is declared, there will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of application Q and claim 33 of application R would be designated to correspond to the count. If chloroform defines a separate patentable invention from benzene and an interference is declared, there will be one count (benzene). Claims 1 and 2 of application Q and claim 33 of application R would be designated to correspond to the count. Claim 3 of application Q would not be designated to correspond to the count.

Example 9: Application S contains patentable claims 1 (Markush group of benzene or chloroform), 2 (benzene), and 3 (chloroform). Application T contains patentable claims 11 (Markush group of benzene or chloroform), 12 (benzene), and 13 (chloroform). If benzene and chloroform define the same patentable invention and an interference is declared, there will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of application S and claims 11, 12 and 13 of application T would be designated to correspond to the count. The PTO will continue to adhere to *Becker v. Patrick*, 47 USPQ 314 (Comm'r Pat. 1939). An interference can have two counts only if one count defines a separate patentable invention from another count. If chloroform defines a separate patentable invention from benzene and an interference is declared, there will be two counts: Count 1 (benzene) and Count 2 (chloroform). Claims 1 and 2 of application S and claims 11 and 12 of application T would be designated to correspond to Count 1. Claims 1 and 3 of application S and claims 11 and 13 of application T would be designated to correspond to Count 2.

Example 10: Patent A contains claim 1 (engine). Application U contains patentable claim 11 (engine). If an interference is declared, there will be one count (engine). Claim 1 of patent A and claim 11 of application U would be designated to correspond to the count.

Example 11: Patent B contains claims 1 (engine) and 2 (6–cylinder engine). Application V contains patentable claim 8 (engine). An engine and a 6–cylinder engine define the same patentable invention. If an interference is declared, there will be one count (engine). Claims 1 and 2 of patent B and claim 8 of application V would be designated to correspond to the count.

Example 12: Patent C contains claims 1 (engine), 2 (6–cylinder engine), and 3 (engine with a platinum piston). Application W contains patentable claims 11 (engine) and 12 (8–cylinder engine). Claims 1 and 2 of patent C and claims 11 and 12 of application W define the same patentable invention. Claim 3 of patent C defines a separate patentable invention from claims 1 and 2 of patent C and claims 11 and 12 of application W. If an interference is declared, there will be one count (engine). Claims 1 and 2 of patent C and claims 11 and 12 of application W would be designated to correspond to the count. Claim 3 of patent C would not be designated to correspond to the count.

Example 13: Patent D contains claims 1 (engine), 2 (6–cylinder engine), and 3 (engine with a platinum piston). Application X contains patentable claims 11 (engine) and 15 (engine with a platinum piston). Claims 1 and 2 of patent D and claim 11 of application X define the same patentable invention. Claim 3 of patent D and claim 15 of application X define a separate patentable invention from claims 1 and 2 of patent D and claims 11 and 12 of application X. If an interference is declared, there will be two counts. Count 1 (engine) and Count 2 (engine with a platinum piston). Claims 1 and 2 of patent D and claim 11 of application X would be designated to correspond to Count 1. Claim 3 of patent D and claim 15 of application X would be designated to correspond to Count 2.

Example 14: Patent E contains claim 1 (Markush group of benzene or toluene), 2 (benzene), and 3 (toluene). Application Y contains patentable claim 11 (benzene). Benzene and toluene define the same patentable invention. If an interference is declared, there will be one count (Markush group of benzene or toluene). Claims 1, 2 and 3 of patent E and claim 11 of application Y would be designated to correspond to the count.

Example 15: In this example, the claims of patent E and application Y of example 14 are reversed. Patent E contains claim 1 (benzene). Application Y contains patentable claim 11 (Markush group of benzene or toluene), 12 (benzene), and 13 (toluene). If an interference is declared, the count will be the same as the count in Example 14 – (Markush group of benzene or toluene). Claim 1 of patent E and claims 11, 12 and 13 of application Y would be designated to correspond to the count.

Example 16: The PTO follows cases such as *Case v. CPC International Inc.*, 730 F.2d 745, 221 USPQ 196 (Fed. Cir. 1984), *cert. denied*, 105 S. Ct. 233, 224 USPQ 736 (1984); *Aelony v. Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); and *Nitz v. Ehrenreich*, 537 F.2d 539, 190 USPQ 413 (CCPA 1976), and will declare interferences where interfering patent and application claims are mutually exclusive provided the claims define the same patentable invention. Patent F contains claim 1 (benzene). Application Z contains patentable claim 11 (xylene). Benzene and xylene define the same patentable invention. If an interference is declared, there will be one count (benzene or xylene). Claim 1 of patent F and claim 11 of application Z would be designated to correspond to the count.

Example 17: It will be the practice of the PTO under 37 CFR 1.606 to initially declare interferences with counts which are identical to or broader than patent claims which correspond to the counts. A single patent claim will be presumed, subject to a motion under 37 CFR 1.633(c), not to define separate patentable inventions. Patent G contains claims 1 (Markush group of benzene and chloroform), 2 (benzene), and 3 (chloroform). Application AA contains patentable claim 33 (benzene). If an interference is declared, initially it will be presumed by the PTO, subject to a later motion under 37 CFR 1.633(c), that benzene and chloroform define the same patentable invention.

There will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of patent G and claim 33 of application AA would be designated to correspond to the count. If a party believes benzene and chloroform define separate patentable inventions, that party could file a motion under 37 CFR 1.633(c) to redefine the count and the claims corresponding to the counts.

Example 18: Patent H contains claims 1 (Markush group of benzene and chloroform), 2 (benzene), and 3 (chloroform). Application AB contains patentable claims 11 (Markush group of benzene and chloroform), 12 (benzene) and 13 (chloroform). Benzene and chloroform initially would be presumed, subject to a motion under 37 CFR 1.633(c), to define the same patentable invention, because they were recited as a Markush group in a single patent claim. If an interference is declared, there will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of patent H and claims 11, 12 and 13 of application AB would be designated to correspond to the count. If a party believes benzene and chloroform define separate patentable inventions, the party could move under 37 CFR 1.633(c) to substitute a count (benzene) for (Markush group of benzene or chloroform) and to add a count (chloroform).

Example 19: Under 37 CFR 1.606, the PTO follows the practice announced in *Ex parte Card*, 1904 C.D. 383 (Comm'r Pat.). Patent J contains claim 1 (method of mixing, grinding, and heating).

Application AC contains patentable claim 8 (method of mixing and heating) and does not disclose or claim a grinding step. In the context of the inventions disclosed in patent J and application AC, a method of mixing, grinding, and heating is the same patentable invention as a method of mixing and heating. Under current practice, it would be said that "grinding" is an "immaterial" limitation in claim 1 of patent J. Under 37 CFR 1.606, the fact application AC does not disclose grinding would not preclude an interference. If an interference is declared, there will be one count (method of mixing and heating). Claim 1 of patent J and claim 8 of application AC would be designated to correspond to the count.

Example 20: The facts in this example are the same as Example 18. Assume that applicant AB believes that benzene and chloroform define separate patentable inventions. Applicant AB would file a motion under 37 CFR 1.633(c)(1) to substitute Count 2 (benzene) for Count 1 (Markush group of benzene or chloroform) and add Count 3 (chloroform). If the administrative patent judge grants the motion, the interference would be redeclared by deleting Count 1 and substituting in its place Counts 2 and 3. Claims 1 and 2 of the patent H and claims 11 and 12 of application AB will be designated to correspond to Count 2. Claims 1 and 3 of patent H and claims 11 and 13 of application AB will be designated to correspond to Count 3. If one party proves priority with respect to both benzene and chloroform, that party would be entitled to all claims in its application or patent corresponding to Counts 2 and 3. The other party would not be entitled to a patent containing any claim corresponding to Counts 2 and 3. If patentee H proves priority with respect to benzene and applicant AB proves priority with respect to chloroform (assuming there was no issue raised at final hearing with respect to the patentable distinctness of benzene and chloroform), the judgment will provide that patentee H is not entitled to a patent with claims 1 and 3, but is entitled to a patent with claim 2 and that applicant AB is not entitled to a patent with claims 11 and 12, but is entitled to a patent with claim 13. If an issue is properly raised at final hearing as to whether benzene and chloroform are the same patentable invention and the Board holds that they are the same patentable invention, the party proving the earliest priority as to either benzene or chloroform would prevail as to all claims. Thus, if patentee H invented benzene before applicant AB invented benzene or chloroform, patentee H would be entitled to a patent containing claims 1 through 3 even if applicant AB invented chloroform before patentee H invented chloroform. Applicant AB would not be entitled to a patent with claims 11 through 13.

2309.02 Preparation of Papers

INTERFERENCE INITIAL MEMORANDUM

The "Interference Initial Memorandum" (Form PTO – 850) prepared by the examiner and addressed to the Board, provides authorization for preparation of the declaration notices, which are prepared in the Service Branch of the Board.

If the proposed interference will involve a patent, the examiner should first determine whether the maintenance fees have been paid, by using the patent number with PALM Intranet, PALM screen 2970, or contacting the PTO Status and Entity Division. See MPEP § 1730. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 U.S.C. 135(a); 37 CFR 1.606).

A sample of a filled–out Form PTO–850 is shown below.

A separate form is used for each count of the interference. The form need not be typed. If the count is identical to a claim of one of the parties, the number of that claim is circled. If the count is not identical to any claim of any of the parties, the count should be typed on a plain sheet and attached to the form.

The files to be included in the interference should be listed by last name (of the first listed inventor if application is joint), application number, filing date, and, if applicable, patent number and issue date.

The sequence in which the parties are listed on the form is completely immaterial. If the examiner has determined that a party is entitled to the benefit of the filing date of one or more applications (or patents) as to the counts, the blanks provided on the form for indicating this fact should be filled in as to all such applications. It is particularly important to list all intermediate applications necessary to provide continuity of pendency to the earliest benefit application to which a party is entitled.

An applicant will be accorded the benefit of a foreign application on the Form PTO–850 and the declaration notices only if the papers required by 37 CFR 1.55, including a translation, have been filed and the primary examiner has determined that the applicant is in fact entitled to the benefit of such application. A patentee may be accorded the benefit of the filing date of a foreign application in the notice of interference provided he or she has complied with the requirements of 37 CFR 1.55, has filed a translation, and the primary examiner has determined that at least one species within the count involved in the interference is supported by the disclosure of the foreign application. Note, however, that a patentee should not be accorded the benefit of a foreign application if an application in the interference has an effective filing date subsequent to the filing date of the foreign application. See MPEP § 2308.01.

All claims in each party's application or patent must be listed in the spaces provided on the form as either corresponding or not corresponding to the count. A claim corresponds to a count if, considering the count as prior art, the claim would be unpatentable over the count under 35 U.S.C. 102 or 35 U.S.C. 103. If the examiner is in doubt as to whether a party's claim does or does not correspond to a count, it should be listed as corresponding to the count. If the party disagrees with this listing, a motion may be filed under 37 CFR 1.633(c)(4) during the interference to designate the claim as not corresponding to the count.

Note that for each count, every claim in a party's application or patent must be designated as either corresponding or not corresponding to the count; this includes any claims of the application which may be under rejection. For every claim of an application which is listed on the form, the examiner must indicate whether or not that claim is allowable by writing its number in either the "patented or patentable pending claims" box or the "unpatentable pending claims" box on the form. <u>All patent claims and at least one of the application claims designated as corresponding to the count must be listed in the "patented or patentable pending claims" box.</u>

If an involved application or patent contains multiple dependent claims, the examiner should be careful to indicate which embodiments of each multiple dependent claim correspond or do not correspond to each count. An embodiment of a multiple dependent claim should not be circled on form PTO−850 as being the count, but rather, the embodiment should be written out in independent form in the space provided.

After Form PTO−850 is filled out for each count of the proposed interference, it must be signed by the primary examiner in the space provided. The form must also be signed by the Group Director, if the Director's approval is required (as when the interference involves two applications whose effective filing dates are more than 6 months apart).

STATEMENT UNDER 37 CFR 1.609(b)

In addition to filling out Form PTO−850, the examiner must attach to the form a statement under 37 CFR 1.609(b). This statement must contain the following:

(A) For each claim of each of the involved applications or patents which is designated as corresponding to a count (except for a claim which is identical to the count), an explanation of why that claim is directed to the same patentable invention (37 CFR 1.601(n)) as the count. In other words, for each such claim the examiner must explain why it would be the same invention as (35 U.S.C. 102), or obvious over (35 U.S.C. 103), the count. Explanations of obviousness should where possible be supported by evidence in the form of patents or publications, copies of which should be attached to the statement.

(B) For each claim of each of the involved applications or patents which is designated as not corresponding to the count, an explanation of why that claim defines a different patentable invention from the count, i.e., why it is not directed to the same patentable invention (37 CFR 1.601(n)) as the count.

(C) If there is more than one proposed count, an explanation of why each proposed count defines a different patentable invention, i.e., is not directed to the same patentable invention (37 CFR 1.601(n)), as the other count or counts.

Statements explaining the designation of claims as corresponding or not corresponding to the count, or why a count defines a separate patentable invention, should be supported by reference to prior art of record whenever possible. A copy of any prior art cited in the statement should be attached. Some examples of explanations of the designation of claims as corresponding or not corresponding to the count appear below.

Example 1:

Claim 1 is directed to a reactor, and is identical to the count. Dependent claim 2, drawn to a liner, is designated as not corresponding to the count. Dependent claims 3 to 7 are designated as corresponding to the count. A possible statement explaining the designations of claims 2 to 7 as corresponding or not corresponding to the count is:

"Claim 2 does not correspond to the count because the liner recited therein has a composition not previously known and nonobvious in the art.

"Claims 3–7 are designated to correspond to the count because they recite features that are conventionally used and would have been obvious in the general class of reactors recited in claim 1 (see the Watson et al. reference which shows that the riser 44, separator 56, and catalyst member 34 are conventionally used in the type of reactor recited in claim 1)."

Note:

1. No explanation is required for claim 1, since it is identical to the count.

2. Attach a copy of the cited reference to the statement.

Example 2:

Claim 1, which is identical to the count, recites a combination of features A–F (an internal combustion engine), wherein all features except feature B (a catalytic element) are conventional. Feature B (the catalytic element) renders the claim patentable. Feature C is a filter. Claims 2–3 are dependent from claim 1 and further define feature C (the filter). A possible statement explaining the designation of claims 2–3 as corresponding to the count is:

"Claims 2–3 are designated to correspond to the count because they further define the filter recited in claim 1 as containing apertures ranging from 0.5–0.10 microns. In view of the disclosure of a filter having this aperture size in Figure 3 of Englewood, its use in the internal combustion engine of claim 1 would have been obvious."

Note: See Example 1 Notes.

Example 3:

The count is drawn to composition "A or B". Independent claim 10 recites composition A, in which radical R is defined as a lower alkyl. Claim 15, dependent from claim 10, recites that R is methyl. A possible statement explaining the designation of claims 10 and 15 as corresponding to the count would be:

"Claim 10 is designated as corresponding to the count because it recites one of the two alternative compositions recited in the count.

"Claim 15 is designated to correspond to the count because methyl is a species of the lower alkyl genus of composition A, and thus obvious over the genus. Applicant has shown no evidence that the substitution of methyl in the lower alkyl group would provide any unexpected results."

FORWARDING OF PAPERS

After the PTO–850 form or forms are signed, they are forwarded to the Board together with the statement under 37 CFR 1.609(b) and the file of each U.S. application or patent listed on the form(s), including all U.S. applications or patents of which benefit is being accorded. The examiner should keep a copy of the form or forms and all attachments for his/her records.

If two of the parties have the same attorney or agent, the examiner will in a separate memorandum call the attention of the Board to that fact when the Interference Initial Memorandum is forwarded. The administrative patent judge, when the interference is declared, can then take such action as may be appropriate under 37 CFR 1.613(b).

PTO-850 (Rev. 08-16-93)

INTERFERENCE INITIAL MEMORANDUM

Count # 1

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This interference involves 2 parties

PARTY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
SMITH et al.	08/123,456	5-22-92	5,467,890	10/28/97

If application has been patented, have maintenance fees been paid? ___Yes ___No X Maintenance fees not due yet

**Accorded the benefit of:

COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY

The claim(s) of this party which correspond(s) to this count is(are):

PATENTED OR PATENTABLE PENDING CLAIMS: 1, 2, 3, 4, 9/1

UNPATENTABLE PENDING CLAIMS:

The claim(s) of this party which does(do) not correspond to this count is(are):

PATENTED OR PATENTABLE PENDING CLAIMS: 5-8, 9/2

UNPATENTABLE PENDING CLAIMS:

PARTY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
NAKAMURA et al.	08/345,678	12/1/94		

If application has been patented, have maintenance fees been paid? ___Yes ___No ___Maintenance fees not due yet

**Accorded the benefit of:

COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
U.S.	07/987,654	8-8-92	5,456,789	10/14/97
U.S.	07/012,345	11-11-91	4,999,906	12/26/95
JAPAN	10,000/91	5-10-91		

The claim(s) of this party which correspond(s) to this count is(are):

PATENTED OR PATENTABLE PENDING CLAIMS: 11-12

UNPATENTABLE PENDING CLAIMS:

The claim(s) of this party which does(do) not correspond to this count is(are):

PATENTED OR PATENTABLE PENDING CLAIMS: 7,10

UNPATENTABLE PENDING CLAIMS: 3-6

Instructions

1. For every patent involved in the interference, check if the maintenance fees have been paid by using the patent number with PALM screen 2970. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent (35 USC 135(a); 37 CFR 1.606).

2. For each party, separately identify the patentable (or patented) and unpatentable (pending) claims which correspond to the count (37 CFR 1.601(f), (n); 1.609(b)(2)).

3. For each party, separately identify the patentable (or patented) and unpatentable (pending) claims which do not correspond to the count (37 CFR 1.609(b)(3)).

4. <u>Forward all files including those the benefit of which is being accorded.</u>

5. <u>Keep a copy of the Interference Initial Memorandum and any attachments for your records.</u>

All information requested below must be attached on (a) separate typewritten sheet(s).

6. On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.

7. For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention as the count (37 CFR 1.609(b)(2)).

8. For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention from the count (37 CFR 1.609(b)(3).

9. For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1).

DATE	PRIMARY EXAMINER (Signature)	TELEPHONE NO.	ART UNIT
2-11-99	MARY JANE OLSON	308-9000	2209
DATE	GROUP DIRECTOR SIGNATURE (If required)		

**The application number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

Page ___ of ___

2309.03 Affidavits and Declarations Retained in File

When there are of record in the file of the application affidavits or declarations under 37 CFR 1.131 or 1.608, they should not be sealed but should be left in the file for consideration by the Board. If the interference proceeds normally, these affidavits or declarations will be removed and sealed up by the Service Branch of the Board and retained with the interference.

Affidavits and declarations under 37 CFR 1.131 and 1.608 are available for inspection by an opposing party to an interference after the preliminary motions under 37 CFR 1.633 are decided. See 37 CFR 1.612(b).

Affidavits or declarations in the file of a patent are not removed, inasmuch as they have been available to the public since the date the patent issued.

2309.05 Consultation With Administrative Patent Judge

The examiner should consult with one of the administrative patent judges in any case of doubt or where the practice appears to be obscure or confused. In view of their specialized experience they may be able to suggest a course of action which will avoid considerable difficulty in the future treatment of the application.

2309.06 Interfering Subject Matter in "Secrecy Order" Cases

37 CFR 5.3. Prosecution of application under secrecy order; withholding patent.

*****

(b) An interference will not be declared involving national applications under secrecy order. However, if an applicant whose application is under secrecy order seeks to provoke an interference with an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.607(d)).

*****

Since declaration of an interference gives immediate access to applications by opposing parties, no interference will be declared involving an application which has a secrecy order therein. See MPEP § 120 and § 130. Claims will be suggested, if necessary, so that all parties will be claiming the same patentable invention. See MPEP § 2303 – § 2305.04. When each application contains at least one claim to the same patentable invention, the following letter will be sent to all parties:

> Claims 1, 2, etc. (including the conflicting claims and claims not patentable over the application under secrecy order) conflict with those of another application. However, the secrecy order (of the other application/of your application) does not permit the declaration of an interference. Accordingly, action on the application is suspended for so long as this situation continues.
>
> Upon removal of the secrecy order and markings, if applicable, from all applications, an interference will be declared.

The letter should also indicate the allowability of the remaining claims, if any.

A notice that claims have been presented in an application under secrecy order for the purpose of interference with a patent should be placed in the patented file. Also, in accordance with 37 CFR 1.607(d), the patentee should be notified. See MPEP § 2307.06. The question of an interference is taken up upon termination of the secrecy order in the application in which patent claims are presented. The suggested notices should be modified accordingly.

The notices should be signed by the primary examiner. The copy of the notice retained separately in the examining group should, in addition, contain the identification of the applications and patents involved and the interfering claims.

2311 Declaration of Interference

37 CFR 1.611. Declaration of interference.

(a) Notice of declaration of an interference will be sent to each party.

(b) When a notice of declaration is returned to the Patent and Trademark Office undelivered, or in any other circumstance where appropriate, an administrative patent judge may send a copy of the notice to a patentee named in a patent involved in an interference or the patentee's assignee of record in the Patent and Trademark Office or order publication of an appropriate notice in the *Official Gazette*.

(c) The notice of declaration shall specify:

(1) The name and residence of each party involved in the interference;

(2) The name and address of record of any attorney or agent of record in any application or patent involved in the interference;

(3) The name of any assignee of record in the Patent and Trademark Office;

(4) The identity of any application or patent involved in the interference;

(5) Where a party is accorded the benefit of the filing date of an earlier application, the identity of the earlier application;

(6) The count or counts and, if there is more than one count, the examiner's explanation why the counts define different patentable inventions;

(7) The claim or claims of any application or any patent which correspond to each count;

(8) The examiner's explanation as to why each claim designated as corresponding to a count is directed to the same patentable

invention as the count and why each claim designated as not corresponding to any count is not directed to the same patentable invention as any count; and

(9) The order of the parties.

(d) The notice of declaration may also specify the time for:

(1) Filing a preliminary statement as provided in § 1.621(a);

(2) Serving notice that a preliminary statement has been filed as provided in § 1.621(b); and

(3) Filing preliminary motions authorized by § 1.633.

(e) Notice may be given in the *Official Gazette* that an interference has been declared involving a patent.

Upon receipt of the Interference Initial Memorandum (Form PTO–850) and the application(s) and any patent files from the primary examiner, the interference is assigned to an administrative patent judge, who is thereafter responsible for handling it during its pendency before the PTO. Under the current rules, the administrative patent judge has wide discretion as to what actions he or she may take, particularly with regard to the setting of times, and in studying the rules it will be noted that many of their provisions are modified by a qualification such as "unless otherwise ordered by an administrative patent judge." Therefore, it may well be that different administrative patent judges will follow somewhat different procedures in the interferences assigned to them.

The papers necessary in declaring an interference are prepared at the Board. The notices to the parties and the declaration sheet are signed by the administrative patent judge, who declares the interference by mailing the notices to the several parties to the proceeding. Thereafter the application, patent, and interference files are kept at the Board where they are also recorded in a card index.

Once an interference is declared involving an application, *ex parte* prosecution of the application is suspended, and the applicant need not reply to any PTO action outstanding as of the date the interference is declared.

2312 Public Access to Files

37 CFR 1.11 Files open to the public.

*****

(e) The file of any interference involving a patent, a statutory invention registration, a reissue application, or an application on which a patent has been issued or which has been published as a statutory invention registration, is open to inspection by the public, and copies may be obtained upon paying the fee therefor, if:

(1) The interference has terminated or

(2) An award of priority or judgment has been entered as to all parties and all counts.

During the pendency of an interference, the public is entitled to access to the file of any patent, reissue application, or statutory invention registration involved in the proceeding. However, such access does not also entitle members of the public to access to the interference file, or to the file of a non–reissue application involved in the interference. The extent to which members of the public may be granted access to the file of an involved application is governed by the provisions of 37 CFR 1.14(a)(3). See MPEP § 103.

Once the Board enters judgment in the interference as to all parties and all counts, the interference file becomes accessible to the public if a patent, statutory invention registration, or reissue application was involved in the interference. If not, the interference file is not open to the public until one of the involved applications issues as a patent or is published as a statutory invention registration. Note that even though an interference file may be open to the public, access to the file of an application which is or was involved in the proceeding is still subject to the provisions of 37 CFR 1.14.

2314 Jurisdiction Over Interference

37 CFR 1.614. Jurisdiction over interference.

(a) The Board acquires jurisdiction over an interference when the interference is declared under § 1.611.

(b) When the interference is declared the interference is a contested case within the meaning of 35 U.S.C. 24.

(c) The examiner shall have jurisdiction over any pending application until the interference is declared. An administrative patent judge may for a limited purpose restore jurisdiction to the examiner over any application involved in the interference.

37 CFR 1.614 specifies when the Board gains jurisdiction over an interference. The section also indicates when an interference becomes a contested case within the meaning of 35 U.S.C. 24. A remand to the examiner is authorized and may be useful in certain situations, such as when a party moves under 37 CFR 1.633(c) to add a proposed count which is broader than any count in an interference. Alternatively, an administrative patent judge can obtain informal opinions from examiners during the course of an interference. Nothing in the rules, however, is intended to authorize informal conferences between an administrative patent judge and an examiner with respect to the merits of an application before the Board in an *ex parte* appeal from an adverse decision of the examiner.

Where an interference is declared, all questions involved therein are to be determined *inter partes*. This includes not only the question of priority of invention but all questions relative to the patentability to each of the parties of the claims in issue or of any claim suggested to be added to the issue.

Examiners are admonished that *inter partes* questions should not be discussed *ex parte* with any of the interested parties and that they should so inform applicants or their attorneys if any attempt is made to discuss *ex parte* these *inter parte* questions.

The interference is declared when the administrative patent judge mails the notices of interference to the parties. The interference is thus technically pending before the Board of Patent Appeals and Interferences from the date on which the notices are mailed, and from that date the files of the various applications set out in the notices are opened to inspection by the other parties to the extent provided in 37 CFR 1.612.

Obvious errors on the Form PTO−850 or its attachments may be corrected by the administrative patent judge before the declaration notices are mailed. The changes will be made in red ink and initialled in the margin by the administrative patent judge.

Throughout the interference, the interference and application files involved are in the keeping of the Service Branch of the Board except at such times that action is required, such as for concurrent prosecution, when they are temporarily in possession of the tribunal before whom the particular question is pending.

If, independent of the interference, action as to one or more of the involved cases becomes necessary, the examiner should consult the administrative patent judge in charge of the interference.

After obtaining the administrative patent judge's consent, the examiner merely borrows the file, if needed, as where a patent is to be involved in a new interference. See MPEP § 2342 and § 2364.01.

2315 Suspension of *Ex Parte* Prosecution

37 CFR 1.615. Suspension of ex parte prosecution.

(a) When an interference is declared, ex parte prosecution of an application involved in the interference is suspended. Amendments and other papers related to the application received during pendency of the interference will not be entered or considered in the interference without the consent of an administrative patent judge.

(b) Ex parte prosecution as to specified matters may be continued concurrently with the interference with the consent of the administrative patent judge.

Under 37 CFR 1.615, upon declaration of an interference, *ex parte* prosecution of an application involved in the interference is suspended and any outstanding Office actions are considered as withdrawn by operation of the rule. *Ex parte Peterson*, 49 USPQ 119, 1941 C.D. 8 (Comm'r Pat. 1941). Upon termination of the interference, the examiner will reinstate the action treated as withdrawn by operation of 37 CFR 1.615 and set a shortened statutory period for reply.

The treatment of amendments filed during an interference is considered in detail in MPEP § 2364 – § 2364.01.

Ex parte prosecution of an appeal under 37 CFR 1.191 may proceed concurrently with an interference proceeding involving the same application with the consent of the administrative patent judge provided the primary examiner who forwards the appeal certifies, in a memorandum to be placed in the file, that the subject matter of the interference does not conflict with the subject matter of the appealed claims. The approval of the administrative patent judge in charge of the interference must be obtained before undertaking any concurrent prosecution of the application.

2315.01 Suspension – Overlapping Applications

Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference, the prosecution of all the cases not in the interference should be carried as far as possible, by treating as prior art the counts of the interference for the purpose of making provisional rejections and by insisting on proper lines of division or distinction between the applications. In some instances, suspension of action by the Office cannot be avoided. See MPEP § 709.01.

Where an application involved in an interference includes, in addition to the subject matter of the interference, a separate and divisible invention, prosecution of the second invention may be had during the pendency of the interference by filing a divisional application for the second invention or by filing a divisional application for the subject matter of the interference and moving to substitute the latter divisional application for the application originally involved in the interference. However, the application for the second invention may not be passed to issue if it contains claims broad enough to dominate matter claimed in the application involved in the interference.

¶ *23.17 Rejection Based on Count of an Interference*

The rejection of claim [1] above based upon count [2] of Interference No. [3], to which applicant is a party, is a provisional rejection for the purpose of resolving all remaining issues in this application. The provisional assumption that the count is prior art under 35 U.S.C. 102(g) against this application may or may not be true, and the prosecution in this case will be suspended pending final determination of priority in the interference if and when no other issues remain.

Examiner Note:

1. This paragraph must follow all rejections under 35 U.S.C. 102 or 103 using the count of the interference as prior art.
2. This paragraph is applicable only to an application which is commonly owned by a party in the interference but is not involved in the interference.

¶ *23.18 Suspension of Prosecution Pending Outcome of Interference*

The outcome of Interference No. [1] has a material bearing on the patentability of the claims in this application. Prosecution in this application is SUSPENDED pending a final judgment in the interference.

Applicant should call this case up for action upon termination of the interference.

Examiner Note:

This paragraph should only be used in an application that is not in the interference but is commonly owned by one of the parties thereto.

2333 Preliminary Motions – Related to Application Not Involved in Interference

Whenever a party in interference brings a motion under 37 CFR 1.633(d) or (e) concerning an application not already included in the interference, the administrative patent judge will normally send the primary examiner a written notice of such motion and the primary examiner should place this notice in said application file.

The notice is customarily sent to the examining group which declared the interference since the application referred to in the motion is generally examined in the same group. However, if the application is not being examined in the same group, then the correct examining group should be ascertained and the notice forwarded to that group.

This notice serves useful and essential purposes, and due attention must be given to it by the examiner when it is received. First, the examiner is cautioned by this notice not to consider *ex parte*, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party in interest. Second, if the application which is the subject of the motion is in issue and the last date for paying the issue fee will not permit determination of the motion, it will be necessary to withdraw the application from issue. Third, if the application contains an affidavit or declaration under 37 CFR 1.131 or 1.608, this must be sealed because the opposing parties have access to the application.

2340 Motions, Hearing and Decision

37 CFR 1.640. Motions, hearing and decision, redeclaration of interference, order to show cause.

(a) A hearing on a motion may be held in the discretion of the administrative patent judge. The administrative patent judge shall set the date and time for any hearing. The length of oral argument at a hearing on a motion is a matter within the discretion of the administrative patent judge. An administrative patent judge may direct that a hearing take place by telephone.

(b) Unless an administrative patent judge or the Board is of the opinion that an earlier decision on a preliminary motion would materially advance the resolution of the interference, decision on a preliminary motion shall be deferred to final hearing. Motions not deferred to final hearing will be decided by an administrative patent judge. An administrative patent judge may consult with an examiner in deciding motions. An administrative patent judge may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action which will secure the just, speedy, and inexpensive determination of the interference. A matter raised by a party in support of or in opposition to a motion that is deferred to final hearing will not be entitled to consideration at final hearing unless the matter is raised in the party's brief at final hearing. If the administrative patent judge determines that the interference shall proceed to final hearing on the issue of priority or derivation, a time shall be set for each party to file a paper identifying any decisions on motions or on matters raised sua sponte by the administrative patent judge that the party wishes to have reviewed at final hearing as well as identifying any deferred motions that the party wishes to have considered at final hearing. Any evidence that a party wishes to have considered with respect to the decisions and deferred motions identified by the party or by an opponent for consideration or review at final hearing shall be filed or, if appropriate, noticed under § 1.671(e) during the testimony–in–chief period of the party.

(1) When appropriate after the time expires for filing replies to oppositions to preliminary motions, the administrative patent judge will set a time for filing any amendment to an application involved in the interference and for filing a supplemental preliminary statement as to any new counts which may become involved in the interference if a preliminary motion to amend or substitute a count has been filed. Failure or refusal of a party to timely present an amendment required by an administrative patent judge shall be taken without further action as a disclaimer by that party of the invention involved. A supplemental preliminary statement shall meet the requirements specified in § 1.623, 1.624, 1.625, or 1.626, but need not be filed if a party states that it intends to rely on a preliminary statement previously filed under § 1.621(a). At an appropriate time in the interference, and when necessary, an order will be entered redeclaring the interference.

(2) After the time expires for filing preliminary motions, a further preliminary motion under § 1.633 will not be considered except as provided by § 1.645(b).

(c) When a decision on any motion under §§ 1.633, 1.634, or 1.635 or on any matter raised sua sponte by an administrative patent judge is entered which does not result in the issuance of an order to show cause under paragraph (d) of this section, a party may file a request for reconsideration within 14 days after the date of the decision. The request for reconsideration shall be filed and served by hand or Express Mail. The filing of a request for reconsideration will not stay any time period set by the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. No opposition to a request for reconsideration shall be filed unless requested by an administrative patent judge or the Board. A decision ordinarily will not be modified unless an opposition has been requested by an administrative patent judge or the Board. The request for reconsideration normally will be acted on by the administrative patent judge or the panel of the Board which issued the decision.

(d) An administrative patent judge may issue an order to show cause why judgment should not be entered against a party when:

(1) A decision on a motion or on a matter raised sua sponte by an administrative patent judge is entered which is dispositive of the interference against the party as to any count;

(2) The party is a junior party who fails to file a preliminary statement; or

(3) The party is a junior party whose preliminary statement fails to overcome the effective filing date of another party.

(e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which shows good cause why judgment should not be entered in accordance with the order.

(1) If the order was issued under paragraph (d)(1) of this section, the paper may:

(i) Request that final hearing be set to review any decision which is the basis for the order as well as any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at final hearing or

(ii) Fully explain why judgment should not be entered.

(2) Any opponent may file a response to the paper within 20 days of the date of service of the paper. If the order was issued under paragraph (d)(1) of this section and the party's paper includes a request for final hearing, the opponent's response must identify every decision of the administrative patent judge that the opponent wishes to have reviewed by the Board at a final hearing. If the order was issued under paragraph (d)(1) of this section and the paper does not include a request for final hearing, the opponent's response may include a request for final hearing, which must identify every decision of the administrative patent judge that the opponent wishes to have reviewed by the Board at a final hearing. Where only the opponent's response includes a request for a final hearing, the party filing the paper shall, within 14 days from the date of service of the opponent's response, file a reply identifying any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at a final hearing.

(3) The paper or the response should be accompanied by a motion (§ 1.635) requesting a testimony period if either party wishes to introduce any evidence to be considered at final hearing (§ 1.671). Any evidence that a party wishes to have considered with respect to the decisions and deferred motions identified for consideration or review at final hearing shall be filed or, if appropriate, noticed under § 1.671(e) during the testimony period of the party. A request for a testimony period shall be construed as including a request for final hearing.

(4) If the paper contains an explanation of why judgment should not be entered in accordance with the order, and if no party has requested a final hearing, the decision that is the basis for the order shall be reviewed based on the contents of the paper and the response. If the paper fails to show good cause, the Board shall enter judgment against the party against whom the order issued.

Under 37 CFR 1.640, an administrative patent judge will address all motions. A hearing (in person or by telephone) may be held on a motion in the discretion of an administrative patent judge. Where appropriate, an administrative patent judge may consult with an examiner on a question which arises in the first instance in the interference. For example, a party may allege unpatentability over a reference not previously considered, or may attempt to add a count drawn to subject matter which was not previously examined. Consultation will not be necessary where the examiner had already ruled on the patentability question which comes before the administrative patent judge or the Board.

The extent of the consultation will be determined by the administrative patent judge; the examiner may be consulted merely on one point of patentability, or may be asked to conduct a search of newly–presented counts or claims. The consultation may be informal, as by a telephone call, or may be by a more formal written memorandum to the examiner.

It should be noted that nothing in 37 CFR 1.640 authorizes conferences between administrative patent judges and examiners in *ex parte* appeals under 35 U.S.C. 134 from an adverse decision of an examiner.

2341 Unpatentability Discovered

37 CFR 1.641. Unpatentability discovered by administrative patent judge.

(a) During the pendency of an interference, if the administrative patent judge becomes aware of a reason why a claim designated to correspond to a count may not be patentable, the administrative patent judge may enter an order notifying the parties of the reason and set a time within which each party may present its views, including any argument and any supporting evidence, and, in the case of the party whose claim may be unpatentable, any appropriate preliminary motions under §§ 1.633(c), (d) and (h).

(b) If a party timely files a preliminary motion in response to the order of the administrative patent judge, any opponent may file an opposition (§ 1.638(a)). If an opponent files an opposition, the party may reply (§ 1.638(b)).

(c) After considering any timely filed views, including any timely filed preliminary motions under § 1.633, oppositions and replies, the administrative patent judge shall decide how the interference shall proceed.

If the examiner, while the interference is pending, discovers a reference or other reason which he or she believes would render one or more of the parties' claims corresponding to the count(s) unpatentable, the reference or other reason should be brought to the attention of the administrative patent judge in charge of the interference. The administrative patent judge will determine what action, if any, should be taken in the interference.

2342 Addition to Interference

37 CFR 1.642. Addition of application or patent to interference.

During the pendency of an interference, if the administrative patent judge becomes aware of an application or a patent not involved in the interference which claims the same patentable invention as a count in the interference, the administrative patent judge may add the application or patent to the interference on such terms as may be fair to all parties.

37 CFR 1.642 permits an administrative patent judge to add a newly discovered patent, as well as newly discovered applications, to an interference since 35 U.S.C. 135(a) authorizes interferences between applications and patents.

EXAMINER DISCOVERS ANOTHER APPLICATION OR PATENT DURING INTERFERENCE

If, during the pendency of an interference, the examiner discovers another application or patent claiming subject matter which is the same as, or not patentably distinct from, the invention defined in a count of the interference, the examiner should bring the application or patent to the attention of the administrative patent judge in charge of the interference. The administrative patent judge will determine what action, if any, should be taken in the interference.

If the application in question is for reissue of a patent involved in the interference, see MPEP § 2360.

2358 Final Decision

37 CFR 1.658. Final decision.

(a) After final hearing, the Board shall enter a decision resolving the issues raised at final hearing. The decision may enter judgment, in whole or in part, remand the interference to an administrative patent judge for further proceedings, or take further action not inconsistent with law. A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. When the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision for the purpose of judicial review (35 U.S.C. 141–144, 146) unless a request for reconsideration under paragraph (b) of this section is timely filed.

(b) Any request for reconsideration of a decision under paragraph (a) of this section shall be filed within one month after the date of the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. Any opposition to a request for reconsideration shall be filed within 14 days of the date of service of the request for reconsideration. Service of the request for reconsideration shall be by hand or Express Mail. The Board shall enter a decision on the request for reconsideration. If the Board shall be of the opinion that the decision on the request for reconsideration significantly modifies its original decision under paragraph (a) of this section, the Board may designate the decision on the request for reconsideration as a new decision. A decision on reconsideration is a final decision for the purpose of judicial review (35 U.S.C. 141–144, 146).

(c) A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under § 1.633 (a) through (d) and (f) through (j) or § 1.634, and (3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). A losing party who could have properly moved, but failed to move, under § 1.633 or 1.634, shall be estopped to take *ex parte* or *inter partes* action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move, except that a losing party shall not be estopped with respect to any claims which correspond, or properly could have corresponded, to a count as to which that party was awarded a favorable judgment.

In its final decision, the Board can (1) enter judgment, in whole or in part, (2) remand the interference to an administrative patent judge or (3) take further action not inconsistent with law.

A judgment as to a count will state whether or not each party is entitled to a patent containing claims which correspond to the count. When judgment is entered as to all counts, the decision of the Board is considered final for the purpose of judicial review. 37 CFR 1.658(c) defines the doctrine of interference estoppel as it is to be applied in the PTO after an interference is terminated. See MPEP § 2363.03. The definition of interference estoppel is designed to encourage parties in interference cases to settle as many issues as possible in one proceeding. 37 CFR 1.658(c) creates an estoppel both as to senior and junior parties. An estoppel will *not* apply with respect to any claims which correspond, or which properly could have corresponded, to a count as to which the party is awarded a favorable judgment.

After the Board has rendered a final decision in an interference, the losing party may either appeal to the Court of Appeals for the Federal Circuit, under 35 U.S.C. 141, or file a civil action in a United States district court, under 35 U.S.C. 146. Upon the filing of an appeal to the Court of Appeals for the Federal Circuit, the opposing party may elect to have the proceeding conducted in a district court. In either event, the files will be retained at the Board until all court proceedings have terminated. (The PTO may, but normally does not, issue the application of a winning party in an interference involving only applications, notwithstanding the filing of a civil action under 35 U.S.C. 146 by the losing party. See *Monaco v. Watson*, 270 F.2d 335, 122 USPQ 564 (D.C. Cir. 1959).) See MPEP § 1216.

2359 Board Recommendation

37 CFR 1.659. Recommendation.

(a) Should the Board have knowledge of any ground for rejecting any application claim not involved in the judgment of the interference, it may include in its decision a recommended rejection of the claim. Upon resumption of *ex parte* prosecution of the application, the examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(b) Should the Board have knowledge of any ground for reexamination of a patent involved in the interference as to a patent claim not involved in the judgment of the interference, it may include in its decision a recommendation to the Commissioner that the patent be reexamined. The Commissioner will determine whether reexamination will be ordered.

(c) The Board may make any other recommendation to the examiner or the Commissioner as may be appropriate.

Under 37 CFR 1.659, the Board can make recommendations to examiners and the Commissioner, including recommendations that application claims not involved in the interference be rejected and that a patent be reexamined as to patent claims not involved in the interference.

When a patent is involved in an interference each claim of the patent will be designated to (1) correspond to a count or (2) not correspond to a count. All claims which are ultimately determined to correspond to a count will be involved in the judgment of the interference. Inasmuch as they are involved in the judgment of the interference, there is no need to recommend reexamination of those claims. The claims involved in the interference are either patentable or unpatentable based on the final decision of the Board. 37 CFR 1.659(b) merely authorizes the Board to recommend reexamination of patent claims which (1) are *not* involved in the judgment and (2) for one reason or another neither party saw fit to move to designate as corresponding to a count.

2360 Reexamination, Reissue, Protest, or Litigation During Interference

37 CFR 1.660. Notice of reexamination, reissue, protest or litigation.

(a) When a request for reexamination of a patent involved in an interference is filed, the patent owner shall notify the Board within 10 days of receiving notice that the request was filed.

(b) When an application for reissue is filed by a patentee involved in an interference, the patentee shall notify the Board within 10 days of the day the application for reissue is filed.

(c) When a protest under § 1.291 is filed against an application involved in an interference, the applicant shall notify the Board within 10 days of receiving notice that the protest was filed.

(d) A party in an interference shall notify the Board promptly of any litigation related to any patent or application involved in an interference, including any civil action commenced under 35 U.S.C. 146.

(e) The notice required by this section is designed to assist the administrative patent judge and the Board in efficiently handling interference cases. Failure of a party to comply with the provisions of this section may result in sanctions under § 1.616. Knowledge by, or notice to, an employee of the Office other than an employee of the Board, of the existence of the reexamination, application for reissue, protest, or litigation shall not be sufficient. The notice contemplated by this section is notice addressed to the administrative patent judge in charge of the interference in which the application or patent is involved.

Under 37 CFR 1.660, a party is required to notify the Board when the party's patent or application becomes involved in other PTO proceedings (reexamination, reissue, or protest) or litigation.

Before taking any action on the reexamination, reissue, or protest, the primary examiner should consult the administrative patent judge in charge of the interference. It is particularly important that a reissue application not be granted without the approval of the administrative patent judge. Also see MPEP § 2284 concerning requests for reexamination of a patent involved in an interference.

2361 Termination of Interference After Judgment

37 CFR 1.661. Termination of interference after judgment.

After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had.

37 CFR 1.661 sets forth when an interference is considered terminated after a judgment is entered in the interference. For the purpose of filing copies of settlement agreements under 35 U.S.C. 135(c), if an appeal or civil action is not filed, the interference is considered terminated as of the date the time for filing an appeal or civil action expired. 37 CFR 1.661; *Tallent v. Lamoine*, 204 USPQ 1058 (Comm'r Pat. 1979). See also *Nelson v. Bowler*, 212 USPQ 760 (Comm'r Pat. 1981). If an appeal is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the Patent and Trademark Office. See MPEP § 1216.01. If a civil action is filed, and the decision of the district court is not appealed, the interference terminates on the date the time for filing an appeal from the court's decision expires. *Hunter v. Beissbarth*, 15 USPQ2d 1343 (Comm'r Pat. 1990).

2363 Action After Interference

37 CFR 1.664. Action after interference.

(a) After termination of an interference, the examiner will promptly take such action in any application previously involved in the interference as may be necessary. Unless entered by order of an administrative patent judge, amendments presented during the interference shall not be entered, but may be subsequently presented by the applicant subject to the provisions of this subpart provided prosecution of the application is not otherwise closed.

(b) After judgment, the application of any party may be held subject to further examination, including an interference with another application.

The files are returned to the examining group after termination of the interference. Jurisdiction of the examiner is automatically restored with the return of the files, and the cases of all parties are subject to such *ex parte* action as their respective conditions may require. The date when the interference terminates does not mark the beginning of a statutory period for reply by the applicant. See *Ex parte Peterson*, 49 USPQ 119, 1941 C.D. 8 (Comm'r Pat. 1941).

Under 37 CFR 1.664(a), the examiner must promptly take such action in any application which was involved in the interference as may be necessary. The action to be taken by the examiner depends upon how the interference was terminated, and in some instances, the basis of the termination. See MPEP § 2363.01 to § 2363.03. All interferences conducted under 37 CFR 1.601 – 1.688 will be terminated by judgment. If the interference is one which was conducted under the former interference rules, 37 CFR 1.201 to 1.288 (generally these were interferences declared prior to February 11, 1985), an administrative patent judge should be consulted before taking any action on the involved application(s).

Before allowing a losing party's application, the examiner should carefully consider whether the grounds of estoppel have been fully applied. In order to promote uniform application of the doctrines of lost counts and estoppel, the examiner must consult the administrative patent judge who was in charge of the interference before allowing a losing party's application.

If an application has been withdrawn from issue for interference and is again passed to issue, a notation "Re–examined and passed for issue" is placed on the file wrapper together with a new signature of the primary examiner in the box provided for this purpose. Such notation will be relied on by the Publishing Division as showing that the application is intended to be passed for issue and makes it possible to screen out those applications which are mistakenly forwarded to the Publishing Division during the pendency of the interference.

See MPEP § 1302.12 with respect to listing references discussed in motion decisions, and MPEP § 2364 concerning the entry of amendments.

Form paragraph 23.02 may be used to resume *ex parte* prosecution.

¶ *23.02 Ex Parte Prosecution Is Resumed*

Interference No. [1] has been terminated by a decision [2] to applicant. *Ex parte* prosecution is resumed.

Examiner Note:

In bracket 2, insert whether favorable or unfavorable.

2363.01 No Interference in Fact

The Board may, if it finds that there is no interference in fact, award judgment to both parties. In such a case, each party–applicant may be granted a patent on the claims of the application designated to correspond to the count, if those claims are otherwise patentable.

2363.02 The Winning Party

If prosecution of the winning party's application had not been closed, the winning party generally may be allowed additional and broader claims to the common patentable subject matter. Note, however, *In re Hoover Co.*, 134 F.2d 624, 57 USPQ 111 (CCPA 1943). The winning party of the interference is not denied anything he or she was in possession of prior to the interference, nor does he or she acquire any additional rights as a result of the interference. His or her application thus stands as it was prior to the interference. If the application was under final rejection as to some of its claims at the time the interference was formed, the institution of the interference acted to suspend, but not vacate, the final rejection. After termination of the interference, a letter is written the applicant, as in the case of any other action unanswered at the time the interference was instituted, setting a shortened period of 2 months within which to file an appeal or cancel the finally rejected claims.

¶ *23.03 Office Action Unanswered*

This application contains an unanswered Office action mailed on [1]. A shortened statutory period for reply to such action is set to expire TWO MONTHS from the mailing date of this letter.

Examiner Note:

This paragraph must be preceded by paragraph 23.02.

2363.03 The Losing Party

37 CFR 1.663. Status of claim of defeated applicant after interference.

Whenever an adverse judgment is entered as to a count against an applicant from which no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had, the claims of the application corresponding to the count stand finally disposed of without further action by the examiner. Such claims are not open to further *ex parte* prosecution.

The Board's judgment in an interference conducted under 37 CFR 1.601 – 1.688 will state that the losing party is not entitled to a patent containing the claims corresponding to the count or counts. Under 37 CFR 1.663, such claims "stand finally disposed of without further action by the examiner." See also 35 U.S.C. 135(a). When the files are returned to the examining group after termination of the interference, a pencil line should be drawn through the claims as to which a judgment of priority adverse to an applicant has been rendered, and the notation "37 CFR 1.663" should be written in the margin to indicate the reason for the pencil line. If these claims have not been canceled by the applicant and the application is otherwise ready for issue, these notations should be replaced by a line in red ink and the notation "37 CFR 1.663" in red ink before passing the application to issue, and the applicant notified of the cancellation by an Examiner's Amendment. If an action is necessary in the application after the interference, the applicant should also be informed that "Claims (designated by numerals), as to which a judgment adverse to the applicant has been rendered, stand finally disposed of in accordance with 37 CFR 1.663."

If all the claims in the application are eliminated, a letter should be written informing the applicant that all the claims in the application have been disposed of, indicating the circumstances, that no claims remain subject to prosecution, and that the application will be sent to the abandoned files with the next group of abandoned applications. Proceedings are terminated as of the date the interference terminated. See MPEP § 2361.

If the losing party's application was under rejection at the time the interference was declared, such rejection is ordinarily repeated (either in full or by reference to the previous action) and, in addition, any other suitable rejections, as discussed below, are made. If the losing party's application was under final rejection or ready for issue, his or her right to reopen the prosecution is restricted to subject matter related to the issue of the interference.

Where the losing party failed to get a copy of the opponent's drawing or specification during the interference, the losing party may order a copy thereof to enable said party to respond to a rejection based on the successful party's disclosure. Such order is referred to the administrative patent judge who has authority to approve orders of this nature.

In addition to repeating any outstanding rejection, the examiner should consider whether any remaining claims in the losing party's application should be rejected on the ground of unpatentability under 35 U.S.C. 102/103, or on the ground of estoppel.

UNPATENTABILITY UNDER 35 U.S.C. 102/103

The examiner should determine from the Board's decision the basis on which judgment was rendered against the applicant. If the judgment was that applicant was not the first inventor of the subject matter in issue, the application claims may be rejected under 35 U.S.C. 102(g)/103 as unpatentable over the lost counts. If the judgment was based on a holding that applicant derived the invention from another, a rejection of claims as unpatentable over the lost counts under 35 U.S.C. 102(f)/103 may be in order. Where the Board rendered judgment against the applicant because his or her claims were unpatentable over prior art, under 35 U.S.C. 112, or on other grounds, the other claims in the application should be reviewed to determine whether any of those grounds may be applicable to them.

ESTOPPEL

Claims which cannot be rejected as unpatentable over the lost counts may still be subject to rejection on the ground of estoppel. As stated in 37 CFR 1.658(c), a losing party who could have properly moved under 37 CFR 1.633 or 1.634, but failed to do so, is estopped to take subsequent action in the PTO which is inconsistent with the party's failure to properly move. However, in the event of a "split award," the losing party is not estopped as to claims which corresponded, or properly could have corresponded, to a count which he or she won.

The following examples illustrate the application of estoppel to the losing party:

Example 1. Junior party applicant AL and senior party applicant AK both disclose separate patentable inventions "A" and "B" and claim only invention A in their respective applications. An interference is declared with a single count to invention A. Neither party files a motion under 37 CFR 1.633(c)(1) to add a count to invention B. Judgment as to all of AL's claims corresponding to the sole count is awarded to junior party applicant AL. Senior party applicant AK will be estopped to thereafter obtain a patent containing claims to invention B, because applicant AK failed to move to add a count to invention B in the interference. Junior party applicant AL will not be estopped to obtain a patent containing claims to invention B.

Example 2. In this example, the facts are the same as in example 1 except that judgment is awarded as to all AK's claims corresponding to the count to senior party applicant AK. Junior party applicant AL will be estopped to obtain a patent containing claims to invention B in the interference. Senior party applicant AK will not be estopped to obtain a patent containing claims to invention B.

Example 3. Junior party applicant AM and senior party applicant AP both disclose separate patentable inventions "C", "D", and "E" and claim inventions C and D in their respective applications. An interference is declared with two counts. Count 1 is to invention C and Count 2 is to invention D. Neither party files a preliminary motion to add a proposed Count 3 to invention E. Judgment as to all AM's claims corresponding to Counts 1 and 2 is awarded to junior party AM. Senior party applicant AP will be estopped to thereafter obtain a patent containing claims to invention E, because applicant AP failed to move to add a count to invention E to the interference. Junior party applicant AM will not be estopped to obtain a patent containing a claim to invention E.

Example 4. In this example, the facts are the same as in Example 3 except that judgment is awarded as to all AP's claims corresponding to Counts 1 and 2 to senior party applicant AP. Junior party applicant AM will be estopped to obtain a patent containing claims to invention E, because applicant AM failed to move to add a count to invention E in the interference. Senior party applicant AP will not be estopped to obtain a patent containing claims to invention E.

Example 5. In this example, the facts are the same as in Example 3 except that judgment is awarded on all of AM s claims corresponding to Count 1 to junior party applicant AM and judgment is awarded to all AP's claims corresponding to Count 2 to senior party applicant AP. Both parties will be estopped to obtain a patent containing claims to invention E, because neither moved to add a count to invention E during the interference. Assume that junior party AM could have properly moved under 37 CFR 1.633(f) to be accorded the benefit of an earlier application, but did not do so during the interference. Junior party AM will not be estopped in subsequent *ex parte* prosecution from asking for benefit of the earlier application as to the invention defined by Count 1. Accordingly, if the examiner were to reject junior party AM's claim corresponding to Count 1 on the basis of some newly discovered art, junior party AM could properly antedate the prior art by seeking the benefit under 35 U.S.C. 120 of the earlier application. Thus even though junior party AM was a "losing party" as to Count 2 (an adverse judgment as to junior party AM's claims corresponding to Count 2 having been entered), junior party AM was awarded a favorable judgment (37 CFR 1.658(c)) as to Count 1. Junior party AM will be estopped in subsequent *ex parte* prosecution from attempting to be accorded the benefit of the earlier application as to the invention of Count 2.

Example 6. Applicant AQ discloses and claims invention "F." Applicant AR discloses and claims separate patentable inventions "F" and "G." The assignee of applicant AQ also owns an application of applicant AS which discloses and claims invention "G." An interference is declared between applicant AQ and applicant AR. The sole count is directed to invention F. No motion is filed by applicant AQ or its assignee to declare an additional interference between applicant AR and applicant AS with a count to invention G. A judgment as to all AR's claims corresponding to the sole count is awarded to applicant AR. Applicant AS and the assignee will be estopped to obtain a patent containing claims to invention G, because applicant AQ and the assignee failed to move to declare an additional interference with a count to invention G.

Example 7. The facts in this example are the same as the facts in Example 6 except that judgment as to all of AQ's claims corresponding to the sole count is awarded to applicant AQ. Applicant AS and the assignee would not be estopped, because applicant AQ was not a "losing party" (37 CFR 1.658(c)).

Example 8. Applicant AT discloses a generic invention to "solvent" and a species to "benzene." Application AT contains a patentable claim 1 (solvent) and no other claims. Applicant AU discloses the generic invention to "solvent" and species to "benzene" and "toluene." Application AU contains patentable claim 3 (solvent) and no other claims. An interference is declared with a single count (solvent). Claim 1 of application AT and claim 3 of application AU are designated to correspond to the count. No preliminary motions are filed. A judgment is entered in favor of applicant AT on the claim corresponding to the sole count. Applicant AU would be estopped to obtain a patent containing a claim to benzene, because applicant AU failed to file a preliminary motion under 37 CFR 1.633(c)(1) seeking to add a count to benzene and benzene was disclosed in winning party AT's application. Applicant AU would also be estopped to obtain a patent containing a claim to toluene, unless "toluene" defines a "separate patentable invention" from "solvent." A basis for interference estoppel (37 CFR 1.658(c)) exists if "toluene" and "solvent" define the "same patentable invention" because a claim to "toluene" could properly have been added and designated to correspond to the count. See 37 CFR 1.633(c)(2).

The following two examples illustrate the application of estoppel against an applicant who lost the interference based solely on the fact that the applicant was unable to establish a date of invention prior to the opponent's foreign filing date (see *Ex parte Tytgat*, 225 USPQ 907 (Bd. App. 1985)):

Example 9. Application AV discloses engines in general and in particular a 6–cylinder engine. Application AV contains only claim 1 (engine). Application AW discloses engines in general, but does not specifically disclose a 6–cylinder engine. Application AW contains only a single claim 3 (engine). The U.S. "filing date" (37 CFR 1.601(h) of the AV application is prior to the U.S. filing date of the AW application, but the AW application claims a foreign priority date under 35 U.S.C. 119 based on an application filed in a foreign country prior to the filing date of the AV application. An interference is declared. The sole count of the interference is to "an engine." Claim 1 of the AV application and claim 3 of the AW application are designated to correspond to the count. During the interference, applicant AV does not move under 37 CFR 1.633(c)(2) to add a claim to a 6–cylinder engine and to designate the claim to correspond to the count. Applicant AW is awarded a judgment in the interference based on the earlier filing date of the foreign application. After the interference, applicant AV adds claim 2 (6–cylinder engine) to the AV application. Whether AV would be entitled to a patent containing a claim to a 6–cylinder engine will depend solely on whether a 6–cylinder engine is a "separate patentable invention" from "engine" – the subject matter of the count. If a 6–cylinder engine is a "separate patentable invention" within the meaning of 37 CFR 1.601(n), applicant

AV could not have successfully moved under 37 CFR 1.633(c)(2) to add claim 2 and to designate it to correspond to the count. Therefore applicant AV could obtain a patent containing claim 2. If, on the other hand, a 6–cylinder engine is not a "separate patentable invention," claim 2 of the AV application would be rejected on the basis of interference estoppel because claim 2 could have been added by a motion under 37 CFR 1.633(c)(2). See 37 CFR 1.658(c).

Example 10. This example is basically the same as Example 9, except that application AV initially contains claim 1 (engine) and claim 2 (6–cylinder engine). When the interference is declared, both claims 1 and 2 of application AV are designated to correspond to the count. During the interference, applicant AV does not move under 37 CFR 1.633(c)(4) to designate claim 2 as not corresponding to the count. A judgment in the interference is entered for applicant AW based on the earlier filing date of the foreign patent application. After the interference, applicant AV would not be able to obtain a patent containing claim 2, because the claim was designated to correspond to a count and entry of the judgment constitutes a final decision by the PTO refusing to grant applicant AV a patent containing claim 2.

ALLOWANCE OF LOSING PARTY'S APPLICATION

Before allowing a losing party's application, the examiner should carefully consider whether the grounds of estoppel have been fully applied. In order to promote uniform application of the doctrines of lost counts and estoppel, the examiner must consult the administrative patent judge who was in charge of the interference before allowing the losing party's application.

2364 Entry of Amendments

Under 37 CFR 1.637(c)(1) and (2), (d)(3), (e)(1) and (2), or (h), a moving party is required to submit with his or her motion as a separate paper, an amendment embodying the proposed claims if the claims are not already in the application concerned. In the case of an application involved in the interference, this amendment is not entered at that time but is placed in the application file.

An amendment filed in connection with a motion to add or substitute counts in an interference must include any claim or claims to be added and be accompanied by the appropriate fees (or fee authorization), if any, which would be due if the amendment were to be entered, even though it may be that the amendment will never be entered. Only upon the granting of the motion may it be necessary for the other party or parties to present claims, but the fees (or fee authorization) must be paid whenever claims are presented. Claims which have been submitted in reply to a suggestion by the Office for inclusion in an application must be accompanied by the fee due (or fee authorization), if any. Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment.

If the motion is granted, the amendment is entered at the time decision on the motion is rendered. If the motion is not granted, the amendment, though left in the file, is not entered and is so marked.

If the motion is granted only in part and denied as to another part, only so much of the amendment as is covered in the grant of the motion is entered, the remaining part being indicated and marked "not entered" in pencil. See 37 CFR 1.644.

In each instance, the applicant is informed of the disposition of the amendment in the first action in the application following the termination of the interference. If the application is otherwise ready for issue, the applicant is notified that the application is allowed and the Notice of Allowance will be sent in due course, that prosecution is closed, and to what extent the amendment has been entered.

As a corollary to this practice, it follows that where prosecution of the winning application had been closed prior to the declaration of the interference, as by being in condition for issue, that application may not be reopened to further prosecution following the interference, even though additional claims had been presented in connection with a motion in the interference.

It should be noted at this point that, under 37 CFR 1.663, the entry of an adverse judgment against a party who requests same pursuant to 37 CFR 1.662(a) finally disposes of all claims of that party's application which are designated as corresponding to the count.

2364.01 Amendments Filed During Interference

When an amendment to an application involved in an interference is received, the examiner inspects the amendment and, if necessary, the application, to determine whether or not the amendment affects the pending or any prospective interference. If the amendment is an ordinary one properly responsive to the last regular *ex parte* action preceding the declaration of the interference and does not affect the pending or any prospective interference, the amendment is marked in pencil "not entered" and placed in the file, a corresponding entry being endorsed in ink in the contents column of the wrapper. After termination of the interference, the amendment may be permanently entered and considered as in the case of ordinary amendments filed during the *ex parte* prosecution of the application.

Under 37 CFR 1.615(a), amendments related to an application involved in a pending interference will not be entered without the consent of an administrative patent judge. See MPEP § 2315. Therefore, the examiner should receive the approval of the administrative patent judge in charge of an interference before entering any amendments in any of the cases involved in the interference (see MPEP § 2309).

If the amendment is filed in reply to a letter by the primary examiner, suggesting a claim or claims for interference with another party and for the purpose of declaring an additional interference, the examiner, after obtaining the consent of the administrative patent judge, enters the amendment and takes the proper steps to initiate the second interference.

If the amendment is one filed in an application where the administrative patent judge has consented to *ex parte* prosecution of an appeal to the Board of Patent Appeals and Interferences being conducted concurrently with the interference proceeding (see MPEP § 2315) and if it relates to the appeal, it should be treated like any similar amendment in an ordinary appealed application.

When an amendment filed during interference purports to put the application in condition for another interference either with a pending application or with a patent, the primary examiner must personally consider the amendment sufficiently to determine whether, in fact, it does so, and should then consult with the administrative patent judge. With the consent of the administrative patent judge, one of the following three actions may be appropriate.

(A) If the amendment presents allowable claims directed to an invention claimed in a patent or in another pending application in issue or ready for issue, the examiner borrows the file, enters the amendment, and takes the proper steps to initiate the second interference.

(B) Where in the opinion of the examiner, the proposed amendment does not put the application in condition for interference with another application not involved in the interference, the amendment is placed in the file and marked "not entered" and the applicant is informed why it will not be now entered and acted upon.

(C) When the amendment seeks to provoke an interference with a patent not involved in the interference and the examiner believes that the claims presented are not patentable to the applicant, and where the application is open to further *ex parte* prosecution, the file should be obtained, the amendment entered, and the claims rejected, setting a time period for reply. If reconsideration is requested and rejection made final, a time period for appeal should be set. Where the application at the time of forming the interference was closed to further *ex parte* prosecution and the disclosure of the application will *prima facie*, not support the claim presented, or where the claims presented are drawn to a nonelected invention, the amendment will not be entered and the applicant will be so informed giving very briefly the reason for the nonentry of the amendment.

2365 Second Interference

37 CFR 1.665. Second interference.

A second interference between the same parties will not be declared upon an application not involved in an earlier interference for an invention defined by a count of the earlier interference. See § 1.658(c).