Chapter 1100 Interference

This chapter relates only to interference matters before the examiner.

The interference practice is based on 35 U.S.C. 135.

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, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose 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 from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed 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.

37 CFR 1.201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

37 CFR 1.201 sets forth the definition of an interference.

37 CFR 1.201 Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent, or for reissue, of different parties when such applications contain claims for substantially the same invention, which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent and Trademark Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

1101 Preliminaries to an Interference

An interference is often an expensive and time-consuming proceeding. Yet, it is necessary to determine priority when two applicants before the Office are claiming the same subject matter and their filing dates are close enough together that there is a reasonable possibility that the first applicant to file is not the first inventor.

The greatest care must therefore be exercised both in the search for interfering applications and in the determination of the question as to 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 hereinafter noted, but each instance must be carefully considered if serious errors are to be avoided.

In determining whether an interference exists 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 made the count of an interference it should be allowable and in good form. No pending claim which is indefinite, ambiguous or otherwise defective should be made the 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.

(e) Since an interference between cases having a common assignee is not normally instituted, all cases must be submitted to the Assignment Division for a title report.

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

1101.01 Between Applications

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 cases 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 appropriate 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 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 declared, all applications having the same interfering subject matter should be included.

Before taking any steps looking to the formation of an interference, it is very essential that the examiner make certain that each of the prospective parties is claiming the same patentable invention and that the claims that are to constitute the counts of the interference are clearly readable upon the disclosure of each party and allowable in each application.

It is to be noted that while the claims of two or more applicants may vary in scope and in immaterial details, yet if directed to the same invention, an interference exists. But mere disclosure by an applicant of an invention which he is not claiming does not afford a ground for suggesting to that applicant claims for the said invention copied 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 in every instance.

When 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 1.201(b) that the conflicting applications shall contain claims for substantially the same invention which are allowable in each application 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 when 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 case having allowed 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 responded 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 response to a re-

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quirement 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 cancelled.

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.

The allowability of generic claims in the first case is not a condition precedent to setting up interference.

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 indicative 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.

1101.01(a) In Different Groups

An interference between applications assigned to different groups is declared by the group where the controlling interfering claim would be classified. Appropriate transfer of one of the applications is made. After termination of the interference, further transfer may be necessary depending upon the outcome.

1101.01(b) Common Ownership

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

I. Interference therebetween is normally not instituted since there is no conflict of interest. Elimination of conflicting claims from all except one case 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 § 804.03.

II. Where an interference with a third party is found to exist, the owner should be required to elect which one of the applications shall be placed in interference.

Whenever a common assignee of applications by different inventors is called upon to eliminate conflicting claims from all except one application under the provisions of 37 CFR 1.78(c), a copy of the Office action making this requirement must be sent directly to each of the applicants.

Whenever a common assignee is required under 37 CFR 1.201(c) to elect one of the conflicting commonly-owned applications for purpose of interference with a third party, a copy of the Office action making this requirement must be sent to the applicants in each of the commonly assigned applications.

An assignee may not change an election after an interference has been declared.

1101.01(c) The Interference Search [R–23]

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

ence, this book may include notes as to why prospective interferences were not declared.

In determining whether an interference exists, the primary examiner must decide the question. The patent interference examiner 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.

1101.01(d) Correspondence Under 37 CFR 1.202

Correspondence under 37 CFR 1.202 may be necessary but is seldom required under present practice.

37 CFR 1.202. Preparation for interference between applications; preliminary inquiry of junior applicant. In order to ascertain whether any question of priority arises between applications which appear to interfere and are otherwise ready to be prepared for interference, any junior applicant may be called upon to state in writing under oath or declaration the date and the character of the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration for the purpose of establishing priority of invention. The statement filed in compliance with this rule will be retained by the Patent and Trademark Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than thirty days, or if the earliest date alleged is subsequent to the filing date of the senior party, the interference ordinarily will not be declared.

Under 37 CFR 1.202 the Commissioner may require an applicant junior to another applicant to state in writing under oath or by mak the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration. Such affidavit or declaration does not become a part of the record in the application, nor does any correspondence relative thereto. The affidavit or declaration, however, will become a part of the interference record, if an interference is formed.

1101.01(e) Correspondence Under 37 CFR 1.202, How Conducted

In preparing cases for submission to the associate solicitor for 37 CFR 1.202 correspondence and in subsequent treatment of the cases involved, attention should be given to the following points:

(1) The name of the examiner to be called for a conference should be given as indicated on the form.

(2) It should be stated which of the applications, if any, is ready for allowance.

(3) If an application is a division or continuation of an earlier one, this fact should be stated. If it is a continuation-in-part, this should be indicated along with a statement whether or not the application is entitled to the benefit of the filing date of the earlier application for the conflicting subject matter.

(4) If two or more applications are owned by the same assignee, or are presented by the same attorney, it should be so stated.

(5) Only the broadest claim proposed for interference or, if various aspects of an invention are claimed, the broadest claim to each feature, need be identified but if the claims are not present in either of the applications, a proposed count should be set out in this letter.

(6) Any other points which have a bearing on the declaration of the interference should be stated.

(7) Amendments or other papers filed in cases held by the associate solicitor bearing on the question of interference should be promptly forwarded to him.

(8) Letters of submission should be in duplicate.

1101.01(f) Correspondence Under 37 CFR 1.202, Not an Action on the Case

Correspondence under 37 CFR 1.202 is not an action on the case. Hence, it cannot serve to extend the statutory period if the case is awaiting action by the applicant.

1101.01(g) Correspondence Under 37 CFR 1.202, When and When Not Needed

After July 1, 1964, correspondence under 37 CFR 1.202 was greatly curtailed since interferences between pending applications with more than six months difference in effective filing dates were not to be declared unless approved by the Commissioner in exceptional situations.

1101.01(h) Correspondence Under 37 CFR 1.202, Approval or Disapproval by Associate Solicitor

The associate solicitor will stamp the letters from the examiner either "Approved" or "Dis-

approved," as the case may require, and return the carbon copy to the examining group.

If the earliest date alleged by the junior party under 37 CFR 1.202 fails to antedate the filing date of the senior applicant, the associate solicitor disapproves the proposed interference and the examiner then follows the procedure outlined in the next section. When a "Disapproved" letter is returned to the examining group it is accompanied by a note to be attached to the senior party's case requesting the Patent Issue Division to return the case to the associate solicitor after the notice of allowance is sent.

Where the junior party, as required by 37 CFR 1.202, states under oath or declaration a date of a fact or an act, susceptible of proof, which would establish that the claimed invention had been conceived prior to the filing date of the senior applicant, the associate solicitor approves the examiner's proposal to suggest claims and the examiner may then proceed with the preparation of the cases for interference.

SEALING STATEMENT

When an interference is to be declared involving applications which had previously been submitted to the associate solicitor for correspondence under 37 CFR 1.202, before forwarding the files to the Board of Patent Interferences, the examiner should ascertain from the associate solicitor if any such statement has been filed and, if so, get this statement and forward it with the files.

The oath or declaration under § 1.202 becomes a part of the interference file in contradistinction to the application file as in the case of an affidavit or declaration under 37 CFR 1.131 or 37 CFR 1.204 but, like them, is subject to inspection on the opening of the preliminary statements.

When the formation of an interference between two parties is necessary, all other applicants claiming the contested invention should be placed in the interference irrespective of their filing dates or of any dates alleged under § 1.202, provided there is no statutory bar to the allowance of the claims in the other applications.

1101.01(i) Correspondence Under 37 CFR 1.202, Failure of Junior Party To Overcome Filing Date of Senior Party

If the earliest date alleged by a junior party in his affidavit or declaration under 37 CFR 1.202 fails to overcome the filing date of the senior party and if the interference is not to be declared (note that an interference might be necessary for other reasons), the senior party's application will be sent to issue as speedily as possible and the conflicting claims of the junior applicant will be rejected on the patent when granted. A shortened period for response may be set in the senior party's case. (See § 710.02(b).)

After the senior applicant's application has been passed for issue, the application is sent to the associate solicitor by the Patent Issue Division in accordance with a note to that effect attached to the application and he writes a letter to that applicant urging him to promptly pay the issue fee, this being done to the end that prosecution of the junior application may be promptly resumed, the senior party's disclosure then being available as prior art in treating the claims of the junior application. The examiner may make a supplemental action on the junior applicant's case when the senior applicant's patent issues.

INTERIM PROCEDURE

In the meantime the junior party's application will be treated in accordance with the following:

Where a junior party after correspondence under 37 CFR 1.202 fails to overcome the filing date of the senior party, the examiner when he reaches the case for action will write a letter substantially as follows:

> "In view of 37 CFR 1.202, action on this case is suspended for six months to determine whether an interference will be declared (unless these claims are canceled). At the end of the six months applicant should call up the case for action."

The examiner's letter is a suspension of action on the entire case. The case should be noted on the examiner's calendar at the date marking the end of the six months period and on the docket clerk's cards. If applicant does not call up the case, the examiner should do so unless the senior party's patent will soon issue, since there is no period for response running against the applicant and the case should not be permitted to remain indefinitely among the files in the examining group.

It sometimes happens that the application of the junior party is not amended and nothing else occurs to bring it to the attention of the examiner, and that the patent to the senior party issues and is not promptly cited to the junior party. This works an unnecessary hardship upon the junior applicant and the Office should make every effort to give him action in view of this reference at the earliest possible

date. To this end, the examiner should keep informed as to the progress of the senior application and cite the patent with appropriate comment to the junior applicant immediately after its issue.

If, at the end of the six months' suspension, it appears likely that the senior application will be passed to issue within the next six months, action on the conflicting claims and claims not patentable over the senior party's case should again be suspended for a period of six months.

If, at the end of the first six months' suspension, there is no likelihood of the senior party's application being put in condition for allowance within the next six months and the only unsettled question in the junior party's case is the disposition of the claims on which action was suspended, then the interference should be declared.

If the junior application is in issue when the interference is discovered and, in correspondence under 37 CFR 1.202, the junior applicant fails to make the date of the senior party, the junior application should be withdrawn from issue (see "Letter Forms Used in Interferences," § 1112.04) and a letter sent informing him that action is suspended for six months, the examiner noting the expiration date on his calendar and advising applicant to call the case up for action at the end of the six months. Thereafter, procedure should be as above.

1101.01(j) Suggestion of Claims

37 CFR 1.203. Preparation for interference between applications; suggestion of claims for interference. (a) Before the declaration of interference, it must be determined by the examiner that there is common subject matter in the cases of the respective parties, patentable to each of the respective parties, subject to the determination of the question of priority. Claims in the same language, to form the counts of the interference, must be present or be presented, in each application; except that, in cases where, owing to the nature of the disclosures in the respective applications, it is not possible for all applications to properly include a claim in identical phraseology to define the common invention, an interference may be declared, with the approval of the Commissioner, using as a count representing the interfering subject matter a claim differing from the corresponding claims of one or more of the interfering applications by an immaterial limitation or variation.

(b) When the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall, if it has been determined that an interference should be declared, suggest to the parties such claims as are necessary to cover the common invention in the same language. The parties to whom the claims are suggested will be required to make those claims (i. e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared. The failure or refusal of any applicant to make any claim suggested within the time specified, shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended.

(c) The suggestion of claims for purpose of interference will not stay the period for response to an Office action which may be running against an application, unless the claims are made by the applicant within the time specified for making the claims.

(d) When an applicant presents a claim in his application (not suggested by the examiner as specified in this section) which is copied from some other application, either for purpose of interference or otherwise, he must so state, at the time he presents the claim and identify the other application.

Although the subject of suggesting claims is treated in detail at this point in the discussion of a prospective interference between applications, some of the practice here outlined is also applicable to a prospective interference with a patent.

If the applications contain identical claims covering the entire interfering subject matter the examiner proceeds under 37 CFR 1.207 to form the interference; otherwise, proper claims must be suggested to some or all of the parties.

It should be noted at this point that if an applicant copies a claim from another application without suggestion by the examiner, § 1.203(d) requires him to "so state, at the time he presents the claim and identify the other application."

The question of what claims to suggest to the interfering applications 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.

While it is much to be desired that the claims suggested (which are to form the issue of the interference) should be claims already present in one or the other of the applications, yet if claims cannot be found in the applications which satisfactorily express the issue it may be necessary to frame a claim or claims reading on all the applications and clearly expressing the interfering subject matter and suggest it or them to all parties. Whether selecting a claim already presented or framing one for suggestion to all parties, the examiner should keep in mind that where one application has a less detailed disclosure than others there is less chance for error in finding support in all applications if language is selected from the application with the less detailed disclosure. The suggested claim

must be allowable to the party to whom it is suggested.

It is not necessary that all the claims of each party that read on the other party's case be suggested. The counts of the issue should be representative claims and should be materially different. Stated another way, the difference between counts should be one not taught by the prior art, and should have a significant effect in the subject matter involved. In general, the broadest patentable claim which is allowable in each case should be used as the interference count and additional claims should not be suggested unless they are sufficiently different that they may properly issue in separate patents Becker v. Patrick, 47 USPQ 314 (Comm. Pats. 1939). In determining the broadest patentable count the examiner should avoid the use of specific language which imposes an unnecessary limitation. Claims not patentably different from counts of the issue are rejected in the application of the defeated party after termination of the interference.

The claims to form the issue of the interference are suggested to all parties who have not already made those claims.

Where necessitated by the respective disclosures, one or more applications may be involved on a claim which differs from that of another application, with the approval of the group director. Note 37 CFR 1.203(a). In such a case the principles set out in detail in § 1101.02 should be applied.

However, a phantom count should not be used where one of the applications supports the broadest aspects of all limitations of the common invention. If a claim commensurate with the disclosure of the broadest application is not present, one should be drafted and suggested. The application with the narrower disclosure should be involved in the interference with a corresponding claim with one or more narrower limitations so that it defines the common invention with the greatest breadth disclosed in that application. If a suitable claim is not present in the application with the narrower disclosure, one should be drafted and suggested by the examiner. A phantom count cannot be allowed to either party.

1101.01(k) Conflicting Parties Have Same Attorney

37 CFR 1.208. Conflicting parties having same attorney. Whenever it shall be found that two or more parties whose interests appear to be in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and the attorney or agent of this fact, and shall also call the matter to the attention of the Commissioner. If conflicting interests exist, the same attorney or agent or his associates will not be recognized to represent either of the parties whose interests are in conflict without the consent of the other party or in the absence of special circumstances requiring such representation, in further proceedings before the Patent and Trademark Office involving the matter or application or patent in which the conflicting interests exist.

Notification 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. (See § 1112.03.) The attention of the Commissioner is not called to the fact that two conflicting parties have the same attorney until an actual interference is set up and then it is done by notifying the examiner of interferences as explained in § 1102.01(a).

1101.01(l) 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 cases. In this way possible motions under § 1.231(a) (2) and (3) may be forestalled. That is, the action on the new or amended case may bring to light patentable claims that should be included as counts 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 should copy one or more claims for interference, the examiner should state which of the claims already in the case are, in his or her opinion, unpatentable over the claims suggested. This statement does not constitute a formal rejection of the claims, but, if the applicant copies the suggested claim but disagrees with the examiners' statement, the applicant should so state on the record, not later than the time the claims are copied. *In re Bandel*, 146 USPQ 389 (CCPA 1955). If the applicant does not copy the suggested claims by the expiration of the period fixed for their presentation, the examiner should then reject those claims which were previously stated as being unpatentable over the suggested claims on the basis that the failure to copy constituted a concession that the subject matter of those claims is the prior invention of another in this country under § 102(g) and thus

prior art to the applicant under § 103. *In re Oguie*, 186 USPQ 227 (CCPA 1975). If the applicant does copy the suggested claims but loses the interference, when the case is returned to the examiner, the examiner should then reject those claims which were previously stated as being unpatentable over the suggested claims on the basis that the determination of priority constituted a holding that the subject matter of those claims is the prior invention of another in this country under § 102(g) and thus prior art to the applicant under § 103. *In re Risse*, 154 USPQ 1 (CCPA 1967).

1101.01(m) Time Limit Set for Making Suggested Claims

Where claims are suggested for interference, a limited period determined by the examiner, not less than 30 days, is set for reply. See § 710.02(c).

Should any one of the applicants fail to make the claim or claims suggested to him, within the time specified, all his claims not patentable thereover are rejected on the ground that he has disclaimed the invention to which they are directed. If applicant makes the suggested claims later they will be rejected on the same ground unless the delay is satisfactorily explained. (See § 706.03(u).)

1101.01(n) Suggested Claims Made After Period for Response Running Against Case

If suggested claims are made within the time specified for making the claims, the applicant may ignore other outstanding rejections in the application. Even if claims are suggested in an application near the end of the period for response running against the case, and the time limit for making 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 response (usually a three month shortened statutory period) and even though no amendment was made responsive to the Office action outstanding against the case at the time of suggesting the claims. No portion of the case is abandoned provided the applicant makes the suggested claims within the time specified. However, if the suggested claims are not thus made within the specified time, the case becomes abandoned in the absence of a responsive amendment filed within the period for response. 37 CFR 1.203(c)

1101.01(o) 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 is pending before the examiner which contains one or more claims, which may be made in a case in issue, the examiner may write a letter suggesting such claims to the applicant whose case is in issue, stating that if such claims be made within a certain specified time the case 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 copied 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 copy the suggested claims, using form at § 1112.04.

When the examiner suggests one or more claims appearing in a case in issue to an applicant whose case is pending before him or her, the case in issue will not be withdrawn for the purpose of interference unless the suggested claims shall be made 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 Patent Issue Division should be notified when the claim is suggested, so that in case the issue fee is paid during the time in which the suggested claims may be made, proper steps may be taken to prevent the issue fee from being applied.

The examiner should borrow the allowed application from the Patent Issue Division and hold the file until the claims are made or the time limit expires. This avoids any possible issuance of the application as a patent should the issue fee be paid. To further insure against the issuance of the application, the examiner may pencil in the blank space labeled "Date paid" in the lower right-hand corner of the file wrapper the initialled 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 Patent Issue Division requesting that issue of the patent be deferred for a period of three months due to a possible interference. This allows a period of two months to complete any action needed. At the end of this two month period, the application must either be released to the Patent Issue Division or be withdrawn from issue, using form at § 1112.04.

When an application is found having claims to be suggested to other applications already involved in interference, to form another interference, the primary examiner borrows the last named applications from the Service Branch of the Board of Patent Interferences by leaving a charge card. In case the application is to be added to the existing interference, the primary examiner need only send the application and form PTO–850 (illustrated in § 1112.05) properly filled out as to the additional application and identifying the interference, to the Patent Interference Examiner who will take the appropriate action. Also see § 1106.02.

1101.02 With a Patent

37 CFR 1.204, 1.205 and 1.206 quoted below deal with interference involving patents.

37 CFR 1.204. Interference with a patent; affidavit or declaration by junior applicant. (a) The fact that one of the parties has already obtained a patent will not prevent an interference. Although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who, in the interference, proves himself to be the prior inventor.

(b) When the effective filing date of an applicant is three months or less subsequent to the effective filing date of a patentee, the applicant, before the interference will be declared, shall file an affidavit or declaration that he made the invention in controversy in this country before the effective filing date of the patentee, or that his acts in this country with respect to the invention were sufficient to establish priority of invention relative to the effective filing date of the patentee.

(c) When the effective filing date of an applicant is more than three months subsequent to the effective filing date of the patentee, the applicant, before the interference will be declared, shall file two copies of affidavits or declarations by himself, if possible, and by 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 him to an award of priority with respect to the effective filing date of the patent. This showing must be accompanied by an explanation of the basis on which he believes that the facts set forth would overcome the effective filing date of the patent. Failure to satisfy the provisions of this rule may result in summary judgment against the applicant under section 1.228. Upon a showing of sufficient cause, an affidavit or declaration on information and belief as to the expected testimony of a witness whose testimony is necessary to overcome the filing date of the patent may be accepted in lieu of an affidavit or declaration by such witness. If the examiner finds the case to be otherwise in condition for the declaration of an interference he will consider this material only to the extent of determining whether a date prior to the effective filing date of the patent is alleged, and if so, the interference will be declared. (See also § 1.228)

The extensive discussion of modified patent claims below should not be misinterpreted. Most interferences between applications and patents have the exact patent claim as a count.

As a patentee may not alter the claims (except by reissue) an applicant must make one or more claims of the patent or a claim corresponding substantially to a claim of the patent and differing therefrom by an immaterial variation or by the exclusion of an immaterial limitation to invoke an interference as stated in 37 CFR 1.205(a), either because of lack of support in the application for the omitted limitation, or because justified by a showing as set out in the rule. An example of the latter might be where the showing submitted by the applicant demonstrates that his best proofs do not satisfy the omitted limitation. This practice is less restrictive than that which was followed prior to adoption of 37 CFR 1.205(a) in its present form.

Where a patent claim is modified, the count of the interference should be the broader claim as between the patentee and the applicant. Thus, if an immaterial limitation is excluded, the count of the interference should be a copy of the *modified* patent claim as made in the application following the practice as explained in Bonine v. Bliss, 1919 C.D. 75, 265 O.G. 306.

In addition, it should be carefully noted that in an interference between an applicant and a patentee, the count must be either the patent claim or a broader claim; *it cannot be a narrower claim.* Morehouse v. Armbruster, 183 USPQ 182 (1973)

It is improper to base a plurality of interference counts upon a single claim of a patent. If one count of the interference corresponded exactly to the claim of the patent, and another count corresponded substantially to the same claim, the question would arise, in the case of a split decision on priority, as to who had obtained the favorable judgment. Slepian v. Bennett, 85 USPQ 44.

It has been found that the practice set forth in Ex parte Card and Card, 112 O.G. 499, 1904 C.D. 383, does not adequately take care of all situations where there is an interference in fact between a patent and an application but there are obstacles to the applicant making the exact patent claim.

In those cases where the claim of the patent contains an immaterial limitation which can be wholly eliminated or suitably modified so as to broaden the claim, the practice set forth in

Ex parte Card and Card should continue to be followed.

A. APPLICATION DISCLOSURE NARROWER THAN PATENT CLAIM

In some cases, the disclosure in the application, although for the same generic invention in fact as the patent claim, is somewhat narrower than the claim of the patent. Under such circumstances, the applicant should be permitted to copy the claim of the patent as exactly as possible, modifying it only by substituting language based upon his own narrower disclosure for the limitation in the patent claim which he can not make, see Tolle et al. v. Starkey, 1958 C.D. 359, 118 USPQ 292. In declaring the interference, the exact patent claim should be used as the count of the interference and it should be indicated that the claim in the application corresponds substantially to to the interference count.

Examples of the practice outlined in the preceding paragraph:

I. PATENT CLAIMS A RANGE OF 10 TO 90.

Application discloses a range of 20 to 80, there being no distinction in substance between the two ranges.

Application may be permitted to copy the patent claim, modifying it by substituting his range of 20 to 80 for the range of 10 to 90 in the patent claim.

Interference should be declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

II. PATENT CLAIMS A MARKUSH GROUP OF 6 MEMBERS.

Application discloses a Markush group of 5 of the same 6 members, there being no distinction in substance between the two groups.

Applicant may be permitted to copy the patent claim, modifying it by substituting his 5-member group for the 6-member group in the patent claim.

Interference should be declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

B. APPLICATION DISCLOSURE BROADER THAN PATENT CLAIM

In some cases, the disclosure in the application, although for the same invention in fact as the patent claim, is somewhat broader than the claim of the patent. If the applicant presents a corresponding broader claim, the application claim should be used as the count of the interference and it should be indicated on form PTO–850 that the count is a modification of the patent claim. The applicant should not be permitted to copy the exact patent claim if any limitation thereof is not disclosed in the application. If the application discloses every limitation of the patent claim, and the applicant copies the exact patent claim, the patent claim is used as the count of the interference. In the latter circumstance, if the applicant presents a timely motion under 37 CFR 1.231 to substitute a broader count and accompanies the motion with a satisfactory showing, as by asserting that his best evidence lies outside the exact limits of the patent claim, the applicant may be permitted to substitute a count wherein language based upon his slightly broader disclosure replaces the corresponding limitation in the patent claim. In redeclaring the interference, the application claim is used as the count of the interference and it is indicated in the redeclaration papers that the claim in the patent is modified.

EXAMPLES

The following are examples of the above practice in which THE SAME PATENTABLE INVENTION IS CLAIMED BY THE APPLICANT AND PATENTEE ALTHOUGH THE DISCLOSURE IN THE APPLICATION DIFFERS IN BREADTH FROM THE PATENT CLAIMS.

I. PATENT CLAIMS A RANGE OF 20 TO 80: *Application discloses a range of 10 to 90.*

If the application supports the exact patent claim and the applicant elects to copy the exact patent claim, the interference should be declared with the patent claim as the count. However, the interference may be declared having as a count the patent claim modified by substituting applicant's range of 10 to 90 for the range of 20 to 80 in the patent claim. 37 CFR 1.205(a)

Similarly, the applicant may seek such substitution after the interference is declared on the exact patent claim by filing a motion to substitute a count with the broader range supported by a similar showing as indicated above.

Where the application claim is accepted as a count, it should be indicated in the interference notices and declaration sheet that the count is a modification of the patent claim.

II. PATENT CLAIMS A MARKUSH GROUP OF 5 MEMBERS.

Application discloses a Markush group of 6 members, including the 5 claimed in the patent.

The interference is declared with the application claim having the 6-member group as the

count and it should be indicated that the count is a modification of the patent claim.

If the applicant elects to copy the exact patent claim, the interference should be declared with the patent claim as the count.

If, in connection with a motion to substitute, the applicant makes a satisfactory showing (Wheelock v. Wolinski, 175 USPQ 216) of the necessity for including the sixth member in the interference count, the applicant may be permitted to present the patent claim modified by substituting his 6-member group for the 5-member group in the patent claim.

The interference will be redeclared with the application claim as the count and it will be indicated that the count is a modification of the patent claim.

C. APPLICATION DISCLOSURE BROADER IN SOME ASPECTS AND NARROWER IN SOME ASPECTS THAN PATENT CLAIMS

Some cases may include aspects of both A and B, above. Such cases should be appropriately treated by the same general principles outlined above.

Examples of cases involving mixed aspects:

I. Patent Claims a Range of 10 to 80.

Application discloses a range of 20 to 90, there being no distinction in substance between the two ranges.

The applicant may be permitted to present a claim which includes the range of 20–90, and the interference should be declared with a count covering the range of 10–90, and it should be indicated that the count is a "phantom" count by writing the word "phantom" beside the number of the patent claim and the application claim on form PTO–850. In such circumstances, the examiner must attach a copy of the count to the form PTO–850.

II. Patent Claims a Markush Group of 6 Members.

Application discloses a Markush group of 5 of the same 6 members, plus another member not claimed in the patent, there being no distinction in substance between the two groups.

(a) Initially, applicant may be permitted to copy the patent claim, modifying it by substituting the 5 members of the patent claim which he discloses for the 6-member group in the patent claim.

Interference should in such case be declared initially with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

However, if the applicant has a claim drawn to the 6 members disclosed in his application, the interference may initially be declared with a "phantom" count including a Markush group of all 7 members and this should be indicated on form PTO–850 by writing "phantom" beside the number of the corresponding patent and application claims. A copy of the count must be attached to form PTO–850.

(b) If the interference is declared with the exact patent claim as the count, the applicant may subsequently, if a satisfactory showing is made, move under § 1.231 to substitute a count which includes the 6 member group which he discloses.

The interference is redeclared with a "phantom" count including a Markush group of all 7 members and this should be indicated in the decision on motion by calling attention to the fact that the count is a "phantom" count. The redeclaration papers will have the word "phantom" next to the number of the corresponding claim. Care should be taken to be sure that the corresponding application claim contains only the 6 member group disclosed in the application.

This count is established only for interference purposes and thus provides a situation which does not restrict either party as to any testimony or exhibits offered as to the disclosed members included in the count. Such a "phantom" count is only for interference purposes and cannot otherwise appear as a claim in either of the cases since it has no basis therein. Further, such a "phantom" count must be patentable over the prior art. A "phantom" count cannot be allowed in any of the applications in the interference.

The practice outlined in A, B, and C above should be restricted to situations where the inventions claimed in the patent and disclosed in the application are clearly the same, so that there is truly an interference in fact.

D. FORMULATION OF TABLE OF COUNTS

Where one or more claims of a patent are not copied identically, the table of counts and claims in form PTO–850 (see §§ 1102.01(a) and 1112.05) should be formulated on the basis of the principles set out below.

(1) Where the application claim omits an immaterial limitation or otherwise broadens the corresponding patent claim, indicate by writing (modified), (mod.) or (m) *beside the number of the patent claim.*

(2) Where the application claim is narrower than the corresponding patent claim, indicate

by writing (substantially), (subst.) or (s) *beside the number of the application claim.*

(3) Where the application claim is broadened in at least one respect but is narrower in another respect than the corresponding patent claim, a "phantom" count, to be the issue as to the claims concerned, must be drafted incorporating the broadest expressions from both claims and must be indicated by writing (phantom), (phant.) or (p) beside the number of *both* corresponding claims. In this case a copy of the "phantom" count must be attached to the form.

The result of (1) and (2) will be that any count, other than a phantom count, will be identical to the claims in the cases beside it on form PTO–850 having no indicator.

For rejection of copied patent claims see § 1101.02(f).

37 CFR 1.205. Interference with a patent; copying claims from patent. (a) Before an interference will be declared with a patent, the applicant must present in his application, copies of all the claims of the patent which also define his invention and such claims must be patentable in the application. However, an interference may be declared after copying the claims excluding an immaterial limitation or variation if such immaterial limitation or variation is not clearly supported in the application or if the applicant otherwise makes a satisfactory showing in justification thereof.

(b) Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office. The examiner will call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent.

(c) A notice that one or more claims of a patent have been copied or substantially copied by an applicant will be placed in the file of the patent, and a copy of said notice will be sent to the patentee. However, the identity of the applicant will not be disclosed to the patentee unless an interference is declared. If a final decision is made not to declare an interference, a notice to that effect will also be placed in the file of the patent and sent to the patentee.

Effective August 1, 1978, 37 CFR 1.205(c) requires that patentees be twice notified regarding applicants copying their claims for interference purposes. First, the patentee must be notified that patented claims have been copied. Second, the patentee must be informed by either a notice that a final decision has been made *not* to declare an interference or a notice of declaration of interference from the interference examiner that an interference will be declared. This regulation provides a patentee with notice as soon as a claim is copied from 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 copier.

The properly completed multipurpose form is sent to the patentee each time a notice is necessary under 37 CFR 1.205(c). This multipurpose form is sent the first time to notify the patentee that at least one claim has been copied from the patent. Once a final decision has been made that *no* declaration of interference will be made, a second copy of the multipurpose form is sent notifying patentee of this fact. This second notification should not be sent until all controversies, relative to the decision against declaring an interference, are finally resolved in the ex parte prosecution with the applicant copying the patented claims. However, if an interference is to be instituted, a declaration of interference notice will be sent by an interference examiner (37 CFR 1.207(b)) rather than sending a second multipurpose form.

These forms will be made of record in the patented file by the Group having responsibility for the application copying claims and will be sent to the correspondence address on the face of the patented file.

It is anticipated that patentees may make inquiries as to the status of the copied claims after the first notification has been received. Since the group having responsibility for the application copying claims will be indicated on the form and the form will *not* contain any information pertaining to that application, it will be necessary for each Patent 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 copying the claims or the patented file whose claims have been copied in order to provide adequate information for patentee inquiries relative to non-receipt 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 both the appropriate patent number and the serial number of the application copying the patent claims. This record could be a separate group file for 1.205(c) notices sent to patentees having appropriate identification of the patent and application copying the patent claims.

In summary, a 1.205(c) notice form is completed by a person in the group having jurisdiction over the application copying claims from

a patent. The form is completed by marking the top box and signing at the location marked "By ——————". This first notice need not be signed by an examiner. 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 1.205(c) notices. If a final decision is made that no interference will be declared, a primary examiner will complete a 1.205(c) notice form by marking the second or bottom box and signing at the location marked "Examiner ——————". The original of this form 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 1.205(c) notices. If an interference is to be instituted, the declaration of interference notice will be sent by an interference examiner and no additional form will be sent by the examiner.

ALTHOUGH THE PERMANENT RECORD FOR SECTION 1.205(c) NOTICES INCLUDES IDENTIFICATION BOTH OF THE PATENT AND APPLICATION, THE PATENTEE CANNOT AND SHOULD *NOT* BE GIVEN ANY INFORMATION CONCERNING THE PARTY OR APPLICATION IN WHICH CLAIMS WERE COPIED UNLESS AND UNTIL AN INTERFERENCE IS DECLARED.

37 CFR 1.206. Interference with a patent; claims improperly copied. (a) Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion the applicant cannot make the other claims and state further that the interference will be promptly declared. The applicant may proceed under § 1.231, if he desires to further contest his right to make the claims not included in the declaration of the interference.

(b) Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond 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.

When an interference with a patent is proposed it should be ascertained before any steps are taken whether there is common ownership. Note § 804.03. A title report must be placed in both the application and the patented file when the papers for an interference between an application and a patent are forwarded. To this end the examiner, before initiating an interference involving a patent, should refer both the application and the patented file to the Assignment Division for notation as to ownership.

PATENT IN DIFFERENT GROUP

Where claims are copied from a patent classified in another group, the propriety of declaring the interference (if any) is decided by and the interference is initiated by the group where the copied claims would be classified. In such a case, it may be necessary to transfer the application, including the drawings, temporarily to the group which will declare the interference. A print of the drawings should be made and filed in the group originally having jurisdiction of the application in place of the original drawings. When classified in different groups, the question of which group should initiate the interferences should be resolved by agreement between the examiners of the groups concerned, possibly in consultation with the directors involved.

1101.02(a) Copying Claims From a Patent

A large proportion of interferences with a patent arise through the initiative of an applicant in copying claims of a patent which has come to his attention through citation in an Office action or otherwise.

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

However, in some instances the examiner observes that certain claims of a patent can be made in a pending application and, if the patent is not a statutory bar, he must take steps to avoid the issuance of a second patent claiming the same invention without an interference. The practice set forth hereinbelow applies when an issued patent and a pending application are not commonly assigned. If there is a common assignment, a requirement for election under § 1.78(c) should be required as outlined in § 804.03.

A patent claiming the same invention as that being claimed in an application can be overcome only through interference proceedings. Where the effective filing date of the application is prior to that of the patented application, no affidavit or declaration is required.

If the effective filing date of the applicant is three months or less later than that of the patented application, the applicant must submit an affidavit or declaration that the applicant made the invention prior to the filing date of the patent, even though there was copendency between the two applications, § 1.204(b). The affidavit

or declaration may be made by persons other than the applicant. See § 715.04.

If the effective filing date of the applicant is more than three months later than that of the patented application, the applicant is required by § 1.204(c) to submit a showing by affidavits or declarations including at least one by a corroborating witness, and documentary exhibits setting forth acts and circumstances which if proven by testimony taken in due course would provide sufficient basis for an award of priority to him with respect to the effective filing date of the patent application. In connection with a requirement for a showing under § 1.204 (b) or (c), or in examining such a showing submitted voluntarily, the examiner must determine whether or not the patentee is entitled to the filing date of an earlier domestic application. A determination that a divisional or continuation relationship is acknowledged in the heading of the patent is sufficient for this purpose as to a parent application thus mentioned. Where the benefit of such earlier application is then accorded the patentee, this fact should be noted on the form PTO–850 and will be stated in the notices of interference.

In the situation where an application contains subject matter which would interfere with any unexpired patent which has perfected a claim of foreign priority under 35 USC 119, the effective filing date of the patent for the purpose of instituting and declaring the interference will be the effective United States filing date of the patent. This practice is consistent with the holding in In re Hilmer, 149 USPQ 480 (CCPA 1966) to the effect that the effective date of a United States patent is not affected by the foreign filing date to which the patentee may be entitled under 35 USC 119, and will minimize the type of anomalous results which were reached in In re McKellin et al., 188 USPQ 428 (CCPA 1976) by permitting an interference to be declared in situations where it might not otherwise occur.

The examiner will examine the showing to determine whether it includes the two copies of affidavits or declarations and exhibits as well as an explanation of the pertinency of the showing as required by the rule. If duplicate copies of any of the affidavits, declarations, or exhibits are omitted, the examiner will notify the applicant by letter of such omission and state that because of it the application cannot be forwarded for declaration of the interference. Lack of an explanation should be treated similarly except that if there are accompanying remarks, with the amendment or in a separate paper, which appear to be an explanation (see paragraph numbered 5 below) their sufficiency should not be questioned. A period of twenty days should be set within which to correct the omission.

The substance of the showing will be considered by the examiner only to the extent of determining that it includes at least one allegation of an act relating to priority prior to the effective filing date of the patentee. Absent such a date, the deficiency should be pointed out and the copied claims rejected on the patent with a time limit for response under § 1.203. If such an allegation is present and the interference is otherwise proper, the examiner will forward the application and the patented file with form PTO–850 for declaration of the interference. The Board of Patent Interferences will consider the sufficiency of the showing prior to declaration of the interference (37 CFR 1.228).

Although, aside from dates, the examiner will not normally attempt any evaluation of the sufficiency of the showing, an exception may be made where it is clear beyond any argument that the showing relates to an invention of a different character from that of the copied claims. In such a case, the examiner may refuse to accept the showing and reject the copied claims on the patent.

If the filing date of the patent precedes the filing date of the application and the patent is not a statutory bar against the application, the claims of the application should be rejected on the patent. If it appears that the applicant is claiming the same invention as is claimed in the patent and that the applicant is able to make one or more claims of the patent, 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, 2d par. and § 1101.02(f). If the applicant controverts this statement and presents an affidavit or declaration under 37 CFR 1.131, the case should be considered special, one claim of the patent which the applicant clearly can make should be selected, and an action should be made refusing to accept the affidavit or declaration under § 1.131 and requiring the applicant to make the selected claim as well as any other claims of the patent which the applicant believes find support in the application. If necessary, the applicant should be required to file the affidavit or declaration and showing required by 37 CFR 1.204. In making this requirement, where applicable, the applicant should be notified of the fact that the patentee has been accorded an earlier effective filing date by virtue of an earlier patent application. A time limit for response should be set under 37 CFR 1.203. In any case where an applicant attempts to overcome a patent by means of affida-

vit or declaration under § 1.131, even though the examiner has not made a rejection on the ground that the same invention is claimed in the patent, the claims of the patent should be examined and, if applicant is claiming the same invention as is claimed in the patent and can make one or more of the claims of the patent, the affidavit or declaration under § 1.131 should be refused, and an action such as outlined in the preceding part of this paragraph should be made. If necessary, the requirements of § 1.204 should be specified and a time limit for response should be set under § 1.203.

Applicants, in preparing affidavits or declarations under § 1.204(c) to secure interference contests with patentees whose filing dates antedate their own by more than three months, should have in mind the provisions of § 1.228, and especially the following facts:

1. That after these affidavits or declarations are forwarded by the primary examiner for the declaration of an interference they will be examined by a Board of Patent Interferences.

2. If the affidavits or declarations fail to establish with adequate corroboration acts and circumstances which would prima facie entitle applicant to an award of priority relative to the effective filing date of the patentee, an order will be issued concurrently with the notice of interference, requiring applicant to show cause why summary judgment should not be rendered against him.

3. Additional affidavits or declarations in response to such order will not be considered unless justified by a showing under the provisions of § 1.228, and if the applicant responds the patentee will receive from the applicant a copy of the response (§ 1.247) and from the Patent and Trademark Office a copy of the original showing (§ 1.228), and will be entitled to present his views with respect thereto.

4. It is the position of the Board of Patent Interferences that all affidavits or declarations submitted must describe acts which the affiant performed or observed or circumstances observed, such as structure used and results of use or test, except on a proper showing as provided in § 1.204(c). 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 are not self-proving and require explanation 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 USC 102(g).

5. The explanation required by § 1.204(c) 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.

Published decisions of the 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 1.228, second sentence, include Kistler v. Weber, 162 USPQ 214 (CCPA 1969); Schwab v. Pittman, 172 USPQ 69 (CCPA 1971); Murphy v. Eiseman, 166 USPQ 149 (BOPI 1970); Golota v. Strom, 180 USPQ 396 (CCPA 1974); Horvitz v. Pritchard, 182 USPQ 505 (BOPI 1974); Azar v. Burns, 188 USPQ 601 (BOPI 1975) and Wetmore v. Quick, 190 USPQ 223 (CCPA 1976).

1101.02(b) Copying Claims From a Patent, Examiner Cites Patent Having Filing Date Later Than That of Application

If a patent, having a filing date later than the filing date of an application, discloses the same subject matter as disclosed in that application and if the application claims the same invention as that claimed in the patent so that a second patent could not be granted without interference proceedings, the patent should be cited and one claim of the patent which applicant clearly can make should be selected and the applicant should be required to make the selected claim as well as any other claims of the patent which he believes find support in his application.

If an application claims an invention patentably different from that claimed in a patent, which discloses the same subject matter as that disclosed in the application but which has a filing date later than the filing date of the application, so that a distinct patent could be granted to the applicant without interference

proceedings, the patent should be only cited to the applicant. Thus, it is left to the applicant to determine whether he wishes to and can copy the claims of the patent.

1101.02(c) Difference Between Copying Patent Claims and Suggesting Claims of an Application

The practice of an applicant copying claims from a patent differs from the practice of suggesting claims for a prospective interference involving only applications in the following respects:

(1) No correspondence under 37 CFR 1.202 is conducted with a junior applicant who is to become involved in an interference with a patent but, instead, an affidavit or declaration under 37 CFR 1.204 is required.

(2) When a question of possible interference with a patent arises, the patent should be cited, whereas no information concerning the source of the claim should be revealed when a claim is suggested for a prospective interference involving only applications.

(3) All claims of a patent which an applicant can make should be copied.

(4) Claims copied by an applicant from a patent may differ from the patent claims by the exclusion of an immaterial limitation or variation which the applicant can not make *or* upon a satisfactory showing (37 CFR 1.205(a)), whereas claims suggested for an interference between applications must normally be identical though 37 CFR 1.203(a) permits an exception with the approval of the Commissioner.

1101.02(d) Copied Patent Claims Not Identified

37 CFR 1.205(b) requires that "where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office."

The requirement of § 1.205(b) applies to claims copied in an application at the time of filing as well as to claims copied in an amendment to a pending application. If an applicant, attorney, or agent presents a claim copied or substantially copied from a patent without complying with § 1.205(b) the examiner may be led into making an action different from what he would have made had he been in possession of all the facts. Therefore, failure to comply with § 1.205(b), when submitting a claim copied from a patent, may result in the issuance of a requirement for information as to why an identification of the source of the copied patent claims was not made. If a satisfactory answer is not filed within the period set in the requirement, it may be necessary to take further action which may result in the striking of the application under 37 CFR 1.56. Therefore, the examiner is required to "call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to the fact and identifying the patent" under 37 CFR 1.205(b).

1101.02(e) Making of Patent Claims Not a Response to Last Office Action

The making of claims from a patent when not required by the Office does not constitute a response 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.

Under 37 CFR 1.212, upon declaration of an interference, ex parte prosecution of an application is suspended and any outstanding Office actions are considered as withdrawn by operation of the rule. *Ex parte Peterson*, 49 USPQ 119 (Commissioner of Patents, 1941). Upon termination of the interference, the examiner will reinstate the action treated as withdrawn by operation of 37 CFR 1.212 and set a statutory period for response. The formats set forth in §§ 1109.01 and 1109.02 may be followed.

1101.02(f) Rejection of Copied Patent Claims

Rejection Not Applicable to Patent

When claims from a patent are made, the application is taken up at once and the examiner may reject such claims in the application if the ground of rejection is not also applicable in the case of the patent. Examples of such a ground of rejection are insufficient disclosure in the application, a reference whose date is junior to that of the patent, or because the claims copied from a patent are barred to applicant by the second paragraph of 35 U.S.C. 135, which reads:

"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." The anniversary date of the issuance of a patent is "prior to one year

from the date on which the patent was granted", Switzer v. Sockman, 142 USPQ 226 (CCPA 1964).

It should be noted that an applicant is permitted to copy a patent claim outside the year period if he has been claiming substantially the same subject matter within the year limit. See Thompson v. Hamilton, 1946 C.D. 70, 68 USPQ 161; In re Frey, 1950 C.D. 362, 86 USPQ 99; Andrews v. Wickenden, 1952 C.D. 176, 93 USPQ 27; In re Tanke, 1954 C.D. 212, 102 USPQ 93; Emerson v. Beach, 1955 C.D. 34, 103 USPQ 45; Rieser v. Williams, 118 USPQ 96; Stalego v. Haymes, 120 USPQ 473.

As is pointed out in 37 CFR 1.206, where more than one claim is copied from a patent, and the examiner holds that one or more of them are not patentable to applicant and at least one other is, the examiner should at once initiate the interference on the claim or claims considered patentable to applicant, rejecting the others, leaving it to applicant to proceed under 37 CFR 1.231(a)(2) in the event that he does not acquiesce in the examiner's ruling as to the rejected claims.

Where all the claims copied from a patent are rejected on a ground not applicable to the patentee the examiner sets a time limit for reply, not less than thirty days, and all subsequent actions, including action of the Board on appeal, are special in order that the interference may be declared as promptly as possible. Failure to respond 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 copied patent claim is usually set under the provisions of § 1.206, where the remainder of the case is ready for final action, it may be advisable to set a shortened statutory period for the entire case in accordance with 37 CFR 1.136.

The distinction between a limited time for reply under § 1.206 and a shortened statutory period under § 1.136 should not be lost sight of. The penalty resulting from failure to reply within the time limit under § 1.206 is loss of the claim or claims involved, on the doctrine of disclaimer, and this is appealable; while failure to respond within the set statutory period (§ 1.136) results in abandonment of the entire application. That is not appealable. Further, a belated response after the time limit set in accordance with § 1.206 may be entered by the examiner, if the delay is satisfactorily explained (except that the approval of the Commissioner is required where the situation described in the next paragraph below exists); but one day late under § 1.136 period, no matter what the excuse, results in abandonment. However, if asked for in advance, one extension of either period may be granted by the examiner, provided that extension does not go beyond the six month statutory period.

Copied Outside Time Limit

Where a patent claim is suggested to an applicant by the examiner for the purpose of establishing an interference and is not copied within the time limit set or a reasonable extension thereof, an amendment presenting it thereafter will not be entered without the approval of the Commissioner. The Commissioner has delegated this authority to the group directors, § 1003, item 9.

The rejection of copied patent claims sometimes creates a situation where two different periods for response are running against the application—one, the statutory period dating from the last full action on the case; the other, the limited period set for the response to the rejection (either first or final) of the patent claims. This condition should be avoided where possible as by setting a shortened period for the entire case, 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 patent claims will not stay the running of the regular statutory period if there is an unanswered Office action in the case at the time of reply or appeal, nor does such reply or appeal relieve the examiner from the duty of acting on the case if it is up for action, when reached in its regular order.

Where an Office action is such as requires the setting of a time limit for response 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 § 710.04.

Rejection Applicable to Patent and Application

If the ground of rejection is applicable to both the claims in the application and the claims in the patent, any letter including the rejection must have the approval of the appropriate group director.

An interference will not be declared where the examiner is aware of a reference for the copied claims, even if it would also be applicable to the patent. However, if such a reference is discovered while an interference involving a patent is before the examiner for decision on motions, the examiner should proceed under 37 CFR 1.237, last sentence. If a reference is dis-

covered at any other time during the course of an interference, the examiner proceeds in accordance with 37 CFR 1.237 and § 1105.50. The group director's approval must be obtained before forwarding the form letter of § 1112.08 and before mailing the decision on motion. See § 1003, item 10.

The decision on such a motion should avoid any comment on the patentability of the claims already granted to the patentee. See Noxon v. Halpert, 128 USPQ 481.

1101.02(g) Copying Claims From a Patent, After Prosecution of Application Is Closed or Application Is Allowed

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

An interference may result when an applicant copies claims from a patent which provided the basis for final rejection. Where this occurs, if the rejection in question has been appealed, the Board of Appeals 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 copied patent claims relate to an invention distinct from that claimed in the application, entry of the amendment may be denied (Ex parte Shohan, 1941 C.D. 1, 522 O.G. 501.) Admission of the amendment may very properly be denied in a closed application, if prima facie, the claims are not supported by applicant's disclosure. An applicant may not have recourse to asserting a patent claim which he long the prosecution of his case. See § 714.19(4). has no right to make as a means to reopen or pro-

After Notice of Allowance

When an amendment which includes one or more claims copied or substantially copied from 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, he should prepare a letter [see Letter Form § 1112.04], 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 amendment, should be sent to the group director.

When an amendment is received after Notice of Allowance, which includes one or more claims copied or substantially copied from a patent 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 copied claims) is refused. The following or equivalent language should be employed to express the adverse recommendation as to the entry of the copied or substantially copied patent claims:

"Entry of claims _____ is not recommended because (brief statement of basic reasons for refusing interference). Therefore withdrawal of the application from issue is not deemed necessary."

1101.03 Removing of Affidavits or Declarations Before Interference

When there are of record in the file affidavits or declarations under 37 CFR 1.131, 1.204 (b) or 1.204(c), they should not be sealed but should be left in the file for consideration by the Board of Interference Examiners. If the interference proceeds normally, these affidavits or declarations will be removed and sealed up by the Service Branch of the Board of Patent Interferences and retained with the interference.

In the event that there had been correspondence under 37 CFR 1.202, this should be obtained from the associate solicitor and left (unsealed) in the file.

Affidavits or declarations under § 1.131 and § 1.204, as well as an affidavit or declaration under § 1.202 (which never becomes of record in the application file) are available for inspection by an opposing party to an interference when the preliminary statements are opened. Ferris v. Tuttle, 1940 C.D. 5, 521 O.G. 523.

The now opened affidavits or declarations filed under §§ 1.131 and 1.204 may then be returned to the application files and the affidavits or declarations filed under § 1.202 filed in the interference file.

1102 Preparation of Interference Papers and Declaration

37 CFR 1.207. Preparation of interference papers and declaration of interference. (a) When an interference is found to exist and the applications are in condition therefor, the primary examiner shall forward the files to the Board of Patent Interferences together with a statement indicating the claims of each appli-

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cant or patentee which are to form the respective counts of the interference and also indicating whether any party is entitled to the benefit of the filing date of any prior application as to the subject matter in issue, and, if so, identifying such application.

(b) A patent interference examiner will institute and declare the interference by forwarding notices to the several parties to the proceeding. Each notice shall include the name and residence of each of the other parties and those of his attorney or agent, and of any assignee, and will identify the application of each opposing party by serial number and filing date, or in the case of a patentee by the number and date of the patent. The notices shall also specify the issue of the interference, which shall be clearly and concisely defined in only as many counts as may be necessary to define the interfering subject matter (but in the case of an interference with a patent all the claims of the patent which can be made by the applicant should constitute the counts), and shall indicate the claim or claims of the respective cases corresponding to the count or counts. If the primary examiner has indicated that the patent or application of any party included in the interference is entitled to the benefit of the filing date of any prior applications as to the subject matter in issue, the notices shall so state and shall specify such prior applications. Except as noted in paragraph (e) of this section, the notices shall also set a schedule of times for taking various actions as follows:

(1) For filing the preliminary statements required by § 1.215 and serving notice of such filing, not less than 2 months from the date of declaration.

(2) For each party who files a preliminary statement to serve a copy thereof on each opposing party who also files a preliminary statement as required by § 1.215(b), not less than 15 days after the expiration of the time for filing preliminary statements.

(3) For filing motions under § 1.231, not less than 4 months from declaration.

(c) The notices of interference shall be forwarded by the patent interference examiner to all the parties, in care of their attorneys or agents; a copy of the notices will also be sent the patentees in person and, if the patent in interference has been assigned, to the assignees.

(d) When the notices sent in the interest of a patent are returned to the Office undelivered, or when one of the parties resides abroad and his agent in the United States is unknown, additional notice may be given by publication in the Official Gazette for such period of time as the Commissioner may direct.

(e) In a case where the showing required by § 1.204(c) is deemed insufficient (§ 1.228) the notice of interference will not set the time schedule specified in paragraph (b) of this section but will be accompanied by an order to show cause by the Board of Patent Interferences as provided by § 1.228.

1102.01 Preparation of Papers

The only paper prepared by the examiner is the Initial Memorandum (Form PTO-850) addressed to the Board of Patent Interferences which provides authorization for preparation of the Notices of Interference and the Declaration Sheet. The latter papers are prepared in the Service Branch of the Board of Patent Interferences.

In declaring or redeclaring an interference the following should be borne in mind:

(1) That no party should be made junior as to some counts and senior to others.

(2) That no interference should be declared in which each party to the interference is not involved on every count.

(3) That where an applicant puts identical claims in two applications by virtue of one of which he will be the senior party and of the other the junior the latter application should be placed directly in the interference, leaving the applicant to gain such benefit as he may from the senior application either by motion to shift the burden of proof or by introducing the senior into the interference as evidence." (In re Redeclaration of Interference Nos. 49,635; 49,636; 49,866; 1926 C.D. 75, 350 O.G. 3.)

The Initial Memorandum and the files to be involved are forwarded to the Interference Service Branch, including prior applications or patent files benefit of which is being accorded. Any correspondence under 37 CFR 1.202 should be obtained from the associate solicitor and forwarded with the other papers. See § 1101.03. This same practice obtains in the case of affidavits or declarations of this nature in earlier applications the benefits of which is accorded a party by the examiner in the initial memorandum. Such cases will be acknowledged in the declaration papers.

37 CFR 1.207(b) requires inclusion of the name and residence of any assignee in the declaration notice. Therefore, a recent title report on all the applications and patents involved should be obtained by the examiner and forwarded with the other papers to the Board of Patent Interferences.

The information to be included in the initiating memorandum is set forth in § 1102.01(a).

1102.01(a) Initial Memorandum to the Board of Patent Interferences

The initial memorandum to the Board of Patent Interferences is written on Form PTO-850, shown in § 1112.05 and is signed by the primary examiner. Since the files will be available, information found on the file wrapper

is unnecessary and is not desired except as indicated on the form. The form is designed to require a minimum of effort by the examiner and typing should not be used unless the counts are not found verbatim in any file as provided in the last sentence of 37 CFR 1.203 (a). In this case copies of the counts should be supplied at the end of the form using additional plain sheets if needed. The files to be included in the interference should be listed by last name (of first listed inventor if application is joint), serial number, and filing date irrespective of whether an application or a patent is involved. The sequence of the listed applications 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 all 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 applications necessary to provide continuity of pendency to the earliest application to which a party is entitled. The date of abandonment or patenting of a prior application should be indicated by checking the appropriate box and writing the date. The word "pending" should be written if a prior application is still pending. An applicant will be accorded the benefit of a foreign application on the form PTO–850 and declaration notices only if he has filed the papers required by 37 CFR 1.55, including a sworn translation, and the primary examiner has determined that he 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 has complied with the requirements of 37 CFR 1.55, has filed a sworn translation, and the primary examiner has determined that the patented claims involved in the interference are supported by the disclosure of the foreign application. This should be noted on form PTO–850 (see § 1101.02(a)). The claims in each case which are unpatentable over the issue should be indicated in the blanks provided for that purpose. The examiner must also complete the table showing the relation of the counts to the claims of the respective parties in the area provided in the form.

The indication of claims in each case which are regarded as unpatentable over the issue is based on the decisions in Votey v. Wuest v. Doman, 1904 C.D. 323, 111 O.G. 1627 and Earll v. Love, 1909 C.D. 56, 140 O.G. 1209. When an interference is declared and the examiner is of the opinion that the application or applications contain claims not patentably different from the issue of the interference, he should specify them by number on form PTO–850 so that they will be held subject to the decisions in the interference.

Such a specifying of claims gives the parties notice as to what claims the examiner considers unpatentable over the issue, it avoids the inadvertent granting of claims to the losing party which are not patentable over the issue, but which are not included therein, and will probably result in fewer motions under 37 CFR 1.231(b).

In carrying out the provisions of 37 CFR 208 examiners, when forwarding the Initial Memorandum to the Board of Patent Interferences, will in a separate memorandum, call their attention to cases in which two of the parties are represented by the same attorney, in lieu of calling the matter directly to the attention of the Commissioner. The patent interference examiner when mailing out the notices to the parties and their attorney will advise the parties and the attorney that the attorney will not be recognized further as representing either party in the interference or in the interfering cases unless he shows that he is entitled to continue to represent either or both parties as provided by 37 CFR 1.208. The patent interference examiner will also call to the attention of the parties and the attornev the requirement of the second sentence of 37 CFR 1.201(c).

In an interference involving a patent, if the primary examiner discovers a reference which, in his opinion, renders a count obviously unpatentable, action should be taken in accordance with § 1101.02(f).

In situations where exactly corresponding claims are not present in the applications and patent considered to be interfering, see the guides and examples set forth in § 1101.02 under the heading D. FORMULATION OF TABLE OF COUNTS as to the proper designation of the relationship of the claims to the counts. If an application was merely in issue and did not become a patent, the original claim numbers of the application, prior to revision for issue, should be used.

A certificate of correction in a patent should not be overlooked. For the best practice in interference between applications, dependent counts should be avoided and each count should be independent. This avoids confusion in language and disputes as to the meaning of the counts. When dependent counts cannot be avoided, as in the case of an interference with a patent where one of the counts is a dependent claim, the count may likewise be dependent on the count corresponding to the claim on which the dependent claim is founded. If necessary a dependent claim may be the sole count of an interference.

1102.02 Declaration of Interference

The papers necessary in declaring an interference are prepared in the Interference Service Branch. The notices to the parties and the declaration sheet are signed by a patent interference examiner, who institutes and declares the interference by mailing the notices to the several parties to the proceeding. Thereafter the applications and interference files are kept in the Service Branch where they are also recorded in a card index.

If an application that has been made special by the Commissioner becomes involved in an interference, the interference will be made special, provided the prosecution of such application has been diligent on the part of the applicant. See § 708.01.

1103 Suspension of Ex Parte Prosecution, Full or Partial

37 CFR 1.212. Suspension of ex parte prosecution. On declaration of the interference, ex parte prosecution of an application is suspended, and amendments and other papers received during the pendency of the interference will not be entered or considered without the consent of the Commissioner, except as provided by this part. Proposed amendments directed toward the declaration of an interference with another party will be considered to the extent necessary. Ex parte prosecution as to specified matters may be continued concurrently with the interference, on order from or with the consent of the Commissioner.

The treatment of amendments filed during an interference is considered in detail in §§ 1108 and 1111.05.

Ex parte prosecution of an appeal under 37 CFR 1.191 may proceed concurrently with an interference proceeding involving the same application 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.

For treatment of other applications by the same inventor or assignee having overlapping claims with the application being put into interference see §§ 709.01 and 1111.03.

1104 Jurisdiction of Interference

37 CFR 1.211. Jurisdiction of interference. (a) Upon the institution and declaration of the interference, as provided in § 1.207, the Board of Patent Interferences will take jurisdiction of the same, which will then become a contested case.

(b) The primary examiner will retain jurisdiction of the case until the declaration of interference is made.

The declaration of interference is made when the patent interference examiner mails the notices of interference to the parties. The interference is thus technically pending before the Board of Patent Interferences from the date on which the letters are mailed, and from that date the files of the various applicants are opened to inspection by other parties, 37 CFR 1.226.

Throughout the interference, the interference papers and application files involved are in the keeping of the Service Branch except at such times that action is required as for decision on motions, final hearings, appeals, etc., when they are temporarily in possession of the tribunal before whom the particular question is pending.

If, independent of that interference, action as to one or more of the applications becomes necessary, the examiner charges out the necessary application or applications from the Service Branch by leaving a charge card. It is not foreseen that the primary examiner will need to take action for which he requires jurisdiction of the entire interference. However, if circumstances arise which appear to require it, the primary examiner should request jurisdiction from the Board of Patent Interferences.

The examiner merely borrows a patent file, if needed, as, where the patent is to be involved in a new interference.

1105 Matters Requiring Decision by Primary Examiner During Interference

37 CFR 1.231. Motions before the primary examiner. (a) Within the period set in the notice of interference for filing motions any party to an interference may file a motion seeking:

(1) To dissolve as to one or more counts, except that such motion based on facts sought to be established by affidavits, declarations, or evidence outside of office records and printed publications will not normally be considered, and when one of the parties to the interference is a patentee, no motion to dissolve on the ground that the subject matter of the count is unpatentable to all parties or is unpatentable to the patentee will be considered, except that a motion to dissolve as to the patentee may be brought which is limited to such matters as may be considered at final hearing (§ 1.258). Where a motion to dissolve is based on prior art, service on opposing parties must include copies of such prior art. A motion to dissolve on the ground that there is no interference in fact will not be considered unless the interference involves a design or plant patent or application or unless it relates to a count which differs from the corresponding claim of an involved patent or of one or more of the involved applications as provided in §§ 1.203(a) and 1.205(a).

(2) To amend the issue by addition or substitution of new counts. Each such motion must contain an explanation as to why a count proposed to be added is necessary or why a count proposed to be substituted is preferable to the original count, must demonstrate patentability of the count to all parties and must apply the proposed count to all involved applications except an application in which the proposed count originated.

(3) To substitute any other application owned by him as to the existing issue, or to declare an additional interference to include any other application owned by him as to any subject matter other than the existing issue but disclosed in his application or patent involved in the interference and in an opposing party's application or patent in the interference which should be made the basis of interference with such other party. Complete copies of the contents of such other application, except affidavits or declarations under §§ 1.131, 1.202, and 1.204, must be served on all other parties and the motion must be accompanied by proof of such service.

(4) To be accorded the benefit of an earlier application or to attack the benefit of an earlier application which has been accorded to an opposing party in the notice of declaration. See § 1.224.

(5) To amend an involved application by adding or removing the names of one or more inventors as provided in § 1.45. (See paragraph (d) of this section.)

(b) Each motion must contain a full statement of the grounds therefor and reasoning in support thereof. Any opposition to a motion must be filed within 20 days of the expiration of the time set for filing motions and the moving party may, if he desires, file a reply to such opposition within 15 days of the date the opposition was filed. If a party files a timely motion to dissolve, any other party may file a motion to amend within 20 days of the expiration of the time set for filing motions. Service on opposing parties of an opposition to a motion to amend which is based on prior art must include copies of such prior art. In the case of action by the primary examiner under § 1.237, such motions may be made within 20 days from the date of the primary examiner's decision on motion wherein such action was incorporated or the date of the communication giving notice to the parties of the proposed dissolution of the interference.

(c) A motion to amend under paragraph (a)(2) of this section or to substitute another application or declare an additional interference under paragraph (a)(3) of this section must be accompanied by an amendment adding claims corresponding to the proposed counts to the application concerned if such claims are not already in that application. The motion must also request the benefit of a prior application as provided for under paragraph (a)(4) of this section if the party concerned expects to be accorded such benefit.

(d) All proper motions as specified in paragraph (a) of this section, or of a similar character, will be transmitted to and considered by the primary examiner without oral argument, except that consideration of a motion to dissolve will be deferred to final hearing before a Board of Patent Interferences where the motion urges unpatentability of a count to one or more parties which would be reviewable at final hearing under § 1.258(a) and such unpatentability is urged against a patentee or has been ruled upon by the Board of Appeals or by a court in ex parte proceedings. Also consideration of a motion to add or remove the names of one or more inventors may be deferred to final hearing if such motion is filed after the times for taking testimony have been set. Requests for reconsideration will not be entertained.

(e) In the determination of a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file may be referred to for the purpose of construing the issue.

(f) Upon the granting of a motion to amend and the adoption of the claims by the other parties within a time specified, or upon the granting of a motion to substitute another application, and after the expiration of the time for filing any new preliminary statements, a patent interference examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include said claims. A preliminary statement as to the added claims need not be filed if a party states that he intends to rely on the original statement and such a declaration as to added claims need not be signed or sworn to by the inventor in person. A second time for filing motions will not be set and subsequent motions with respect to matters which have been once considered by the primary examiner will not be considered.

An interference may be enlarged or diminished both as to counts and applications involved, or may be entirely dissolved, by actions taken under § 1.231 "Motions before the primary examiner" or under § 1.237 "Dissolution at the request of examiner". The action may be a substitution of one or more counts, the addition of counts or dissolution as to one or more counts or as to all counts, a change in the application by addition, substitution, or dissolution a shifting of the burden of proof, or a conversion of an application by changing the number of inventors. See § 1111.07. Decisions on questions arising under this rule are made under the personal supervision of the primary examiner.

Examiners should not consider *ex parte*, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party an interest. See § 1111.01.

Occasionally the entire subject matter of the interference may have been transferred to another group between the time of declaring the interference and the time that motions are transmitted for consideration. If this has occurred, after the second group has agreed to take the

case, the Interference Service Branch should be notified so that appropriate changes may be made in their records.

1105.01 Briefs and Consideration of Motions

A party filing a motion is expected to incorporate any reasons with the motion so that an initial brief is not contemplated although if an initial brief is filed with the motion, it would not be objectionable. Under § 1.231(b) other parties have twenty days from the expiration of the time for filing motions for filing an opposition to a motion, and the moving party may file a reply brief within fifteen days of the date such opposition is filed. If a motion to dissolve is filed by one party the other parties may file a motion to amend within 20 days from the expiration of the time set for filing motions and the same times for opposition and reply brief are allowed with respect to the filing date of the latter motion.

After the expiration of the time for filing a reply brief, motions filed under § 1.231 are examined by a Patent Interference Examiner who, if he finds them to be proper motions, will transmit the case to the primary examiner for consideration of the motions with an indication of such motions as are improper under the rules and which should not be considered if there be any such. No oral hearing will be set. The primary examiner should render a decision within two months on each motion transmitted by the Patent Interference Examiner. The decision must include the basis for any conclusions arrived at by the primary examiner. Care must be taken to specifically identify which limitations of a count are not supported, or the portions of the specification which do provide support for the limitations of the count when necessary to decide a motion. The examiner should not undertake to answer all arguments presented.

In motions of the types specified below the primary examiner must consult with and obtain the approval of a member of the Board of Patent Interferences before mailing the decision. Motions requiring such consultation and approval are:

Motions to amend where the matter of support for a count is raised in opposition or the examiner decides to deny the motion for that reason,

Motions relating to the benefit of a prior application,

Motions to dissolve on the ground that one or more parties have no right to make the counts,

Motions to dissolve on the ground of no interference in fact,

Motions to convert an application to a different number of inventors,

Motions to substitute or involve another application in interference where the matter of support for a count is raised in opposition or the examiner decides to deny the motion for that reason,

Motions to amend involving modified or "phantom" counts,

Motions to amend seeking to broaden a patent claim and an issue is raised with respect to the showing in justification.

Requests should be made to the secretary of the Chairman of the Board for the assignment of the Board member to be consulted. The consultation will normally be at the offices of the Board of Patent Interferences. The primary examiner should arrange a convenient time by telephone. In the case of motions to amend or to involve another application the Patent Interference Examiner will examine any opposition which may have been filed and if the question of right to make the proposed counts as to any party is raised thereby, the Patent Interference Examiner will indicate in the letter transmitting motions the necessity for consultation. If such indication is not made there will be no necessity for consultation unless the primary examiner, after consideration, concludes that one or more parties cannot make one or more of the proposed counts. In this case the primary examiner should inquire of the Patent Interference Examiner as to which member to consult.

1105.02 Decision on Motion To Dissolve

By the granting of a motion to dissolve, one or more parties may be eliminated from the interference; or certain of the counts may be eliminated Where the interference is dissolved as to one or more of the parties but at least two remain, the interference is returned to the primary examiner prior to resumption of proceedings before the Patent Interference Examiner for removal of the files of the parties who are dissolved out. *Ex parte* action is resumed as to those applications and the interference is dissolved as to a count, any appeal from The *ex parte* action then taken in each rejected application should conform to the practice set forth hereinafter under the heading "Action After Dissolution" (§ 1110). See § 1302.12 with respect to listing references discussed in motion decision.

With respect to a motion to dissolve on the ground that one or more parties does not have

the right to make one or more counts it should be kept in mind that once the interference is dissolved as to a count, any appeal from a rejection based thereon is ex parte and the views of other parties in the interference will not be heard. In order to preserve the *inter parties* forum for consideration of this matter a motion to dissolve on this ground should not be granted where the decision is a close one but only where there is clear basis for it.

It should be noted that if all parties agree upon the same ground for dissolution, which ground will subsequently be the basis for rejection of the interference count to one or more parties, the interference should be dissolved *pro forma* upon that ground, without regard to the merits of the matter. This agreement among all parties may be expressed in the motion papers, in the briefs, or in papers directed solely to that matter. See Buchli v. Rasmussen, 339 O.G. 223, 1925 C.D. 75; Tilden v. Snodgrass, 1923 C.D. 30, 309 O.G. 477; and Gelder v. Henry, 77 USPQ 223.

Affidavits or declarations relating to the disclosure of a party's application as, for example, on the matter of operativeness or right to make should not be considered (In re Decision dated Aug. 12, 1968, 160 USPQ 154 (Comm. of Pats., 1968)), but affidavits or declarations relating to the prior art may be considered by analogy to 37 CFR 1.132. In addition, affidavits or declarations submitted to establish the existence or non-existence of an interference in fact may also be considered.

If there is considerable doubt as to whether or not a party's application is operative and it appears that testimony on the matter may be useful to resolve the doubt, a motion to dissolve may be denied so that the interference may continue and testimony taken on the point. See Bowditch v. Todd, 1902 C.D. 27, 98 O.G. 792 and Pierce v. Tripp v. Powers, 1923 C.D. 69 at 72, 316 O.G. 3.

Where the effective date of a patent or publication (which is not a statutory bar) is antedated by the effective filing dates or the allegations in the preliminary statements of all parties, then the anticipatory effect of that patent or publication should not be considered by the examiner at this time, but the reference should be considered if at least one party fails to antedate its effective date by such party's own filing date or the allegations in such party's preliminary statement. See Forsyth v. Richards, 1905 C.D. 115, 115 O.G. 1327 and Simons v. Dunlop, 103 USPQ 237.

In deciding motions under 37 CFR 1.231(a)(1), the examiner should not be misled by citation of decisions of the Court of Customs and Patent Appeals to the effect that only priority and matters ancillary thereto will be considered and that patentability of the counts will not be considered. These court decisions relate only to the final determination of priority, after the interference has passed the motion stage; in the ordinary case a motion to dissolve may attack the patentability of the count and need not be limited to matters which are ancillary to priority.

Where a motion to dissolve is based on a contention of no interference in fact, the question to be decided is whether claims presented by respective parties as corresponding to the count or counts in issue claim the same invention even though a claim of one party differs from the corresponding claim of another party through omission of limitations or variation in language under 37 CFR 1.203(a) or 1.205(a). See § 1101.02. Since the claims were found allowable prior to declaration, granting of a motion to dissolve on this ground would normally result in issuance of the respective claims to each party concerned in separate patents. The question to be decided then, is whether one or more limitations in the claim of one party which are omitted or broadened in the claim of another party are material. Whether or not they are material depends primarily on whether they were regarded as significant in allowing the claim in the first instance. That is, the prosecution should be examined to determine if the limitation in question was relied upon to distinguish from cited prior art, or if it was essential to obtaining the desired result. See Mabon v. Sherman, 34 CCPA 991, 73 USPQ 378, 161 F.2d 255, 1947 C.D. 325 (1947); Brailsford v. Lavet, 50 CCPA 1367, 138 USPQ 28, 318 F.2d 942, 1963 C.D. 723 (1963); and Knell v. Muller, 174 USPQ 460 (Comm. of Pats., 1971).

1105.03 Decision on Motion To Amend or To Add or Substitute Another Application

Motions by the interfering parties may be made under 37 CFR 1.231(a)(2) and (3) to add or substitute counts to the interference and also to substitute or involve in interference other applications owned by them. It should be noted that, if the examiner grants a motion of this character, a time will be set by the Board of Interferences for the nonmoving parties to present the allowed proposed counts in their applications, if necessary, and also a time will be set for all parties to file preliminary statements as to the allowed proposed counts. Note that the spaces for the dates on the decision letter are left blank by the examiner, § 1105.06. An illustrative form for these requirements is given at § 1105.06. If the claims are made by some or

all of the parties within the time limit set, the interference is reformed or a new interference is declared by the Patent Interference Examiner.

Also, it should be noted that in an interference which involves *only applications*, a motion to add a count should not be granted unless the proposed count so differs from the original counts that it could properly issue in a separate patent. Becker v. Patrick, 47 USPQ 314, 315 (Comm. Pat. 1939). See also § 1101.01(j). The counts of any additional interferences should likewise differ in the same manner from the counts of the first interference and from each other.

When the interference involves a patent, the question of whether the proposed additional counts differ materially from the original counts does not apply, since in that case all of the patent claims which the applicant can make should be included as counts of the interference.

It will be noted that 37 CFR 231(a)(3) does not specify that a party to the interference may bring a motion to include an application or patent owned by him as to subject matter, in addition to the existing issue, which is not disclosed both in his application or patent already in the interference and in an opposing party's application or patent in the interference. Consequently the failure to bring such a motion will not be considered by the examiner to result in an estoppel against any party to an interference as to subject matter not disclosed in his case in the interference. On the other hand, if such a motion is brought during the motion period, secrecy as to the application named therein is deemed to have been waived, access thereto is given to the opposing parties and the motion may be transmitted by the Patent Interference Examiner; if so transmitted, it will be considered and decided by the primary examiner without regard to the question of whether the moving party's case already in the interference discloses the subject matter of the proposed claims.

Concurrence of All Parties

Contrary to the practice which obtains when all parties agree upon the same ground for dissolution, the concurrence of all parties in a motion to amend or to substitute or add an application does not result in the automatic granting of the motion. The mere agreement of the parties that certain proposed counts are patentabe does not relieve the examiner of the duty to determine independently whether the proposed counts are patentable and allowable in the applications involved. Even though no references have been cited against proposed counts by the parties, it is the examiner's duty to cite such references as may anticipate the proposed counts, making a search for this purpose if necessary.

The examiner should also be careful not to refuse acceptance of a count broader than original counts solely on the ground that it does not differ materially from them. If that is in fact the case, and the proposed count is patentable over the prior art, the examiner should grant the motion to the extent of substituting the proposed count for the broadest original count so that the parties will not be limited in their proofs to include one or more features which are unnecessary to patentability of the count. Where there is room for a reasonable difference of opinion as to whether two claims are materially different (or patentably distinct) it is advisable to add the proposed claim to the issue rather than to substitute it for the original count. This will allow the parties to submit priority evidence as to both counts.

Affidavits or declarations are occasionally offered in support of or in opposition to motions to add or substitute counts or applications. The practice here is the same as in the case of affidavits or declarations concerning motions to dissolve that is, affidavits or declarations relating to disclosure of a party's application as, for example, on the matter of operativeness or right to make, should not be considered, but affidavits or declarations relating to the prior art, or relating to patentable distinctness of the proposed counts from the existing issue or from each other, may be considered by anology to 37 CFR 1.132.

If a motion under 37 CFR 1.231(a)(2) or (3) is denied because it is unpatentable on the basis of a reference which is not a statutory bar, and which is cited for the first time by the examiner in the decision, the decision may be modified and the motion granted upon the filing of proper affidavits or declarations under 37 CFR 1.131 in the application file of the party involved. This is by analogy to 37 CFR 1.237, although normally, request for reconsideration of decisions on motions under 37 CFR 1.231 will not be entertained. Section 1.231 (d). These affidavits or declarations should not be opened to the inspection of opposing parties and no reference should be made to the dates of invention set forth therein other than the mere statement that the effective date of the reference has been overcome. As in the case of other affidavits or declarations under § 1.131, they remain sealed until the preliminary statements for the new counts are opened.

A member of the Board of Patent Interferences must be consulted in connection with motions to add or substitute one or more counts or applications where the matter of right to

make one or more counts is raised in an opposition to the motion or the primary examiner wishes to deny a motion for that reason although it has not been raised by a party. In the event the consultation ends in disagreement, the the matter will be resolved by the Deputy Assistant Commissioner for Patents.

1105.04 Decision on Motion Relating to Benefit of a Prior Application Under 37 CFR 1.231(a)(4)

The primary examiner also decides motions under 37 CFR 1.231(a)(4) relating to the benefit of a prior U.S. or foreign application under 35 U.S.C. 119 or 120. These may involve granting the moving party the benefit of a prior application, or denying the opponent the benefit of a prior application which was accorded to him when the interference was declared.

In deciding a motion of this nature, it is usually advisable to decide any other motions first. See § 1105.06. When the counts are changed as the result of a motion to amend under 37 CFR 1.231(a)(2), or a new interference is to be declared as the result of a motion under 37 CFR 1.231(a)(3), the parties should be accorded the benefit of any prior applications as to the new counts. However, the moving party will not be accorded the benefit of any prior applications as to the new counts unless the moving party has specifically requested it. 37 CFR 1.231(c).

In accordance with present practice a party may be accorded the benefit of a prior application with respect to a generic count if the prior application discloses a single species within the genus in such a manner as to comply with the first paragraph of 35 U.S.C. 112. See In re Kirchner, 134 USPQ 324; Wagoner v. Barger, 175 USPQ 85; Kawai v. Metlesics, 178 USPQ 158; Weil v. Fritz, 196 USPQ 600. If the prior application is a U.S. application, continuity of disclosure must have been maintained between the prior application and the involved application either by copendency or by a chain of successively copending applications. See 35 U.S.C. 120. If the prior application is foreign, it must have been filed not more than twelve months prior to the earliest U.S. application to which the party is entitled. See 35 U.S.C. 119 and §§ 201.14, 201.15.

If the primary examiner has a reasonable doubt as to whether a party should be accorded the benefit of a prior application, the benefit of that application should not be granted. The examiner's decision on the question of benefit is not final, since the granting or denying of a motion under 37 CFR 1.231(a)(4) is a matter which may be considered by the Board of Patent Interferences at final hearing. 37 CFR 1.258(b).

As a result of the decision on motions it may be necessary for the primary examiner to change the order of the parties, which determines the order of taking testimony. The parties will be listed in the inverse order of their effective filing dates, with the party having the latest effective filing date being listed first. If a party is accorded the benefit of a prior application for less than all the counts, the filing date of that application will not be considered as his effective filing date when determining the order of the parties. Note that the burden of proof as to each count is specified by 37 CFR 1.257(a), so that even though a party who is senior as to some counts and junior as to others may be designated as junior party for procedural purposes and required to take his testimony first, he or she has the burden of proof only as to those counts for which he or she has the later effective filing date.

1105.05 Dissolution on Primary Examiner's Own Request Under 37 CFR 1.237

37 CFR 1.237. Dissolution at the request of examiner. If, during the pendency of an interference, a reference or other reason be found which, in the opinion of the primary examiner, renders all or part of the counts unpatentable, the attention of the Board of Patent Interferences shall be called thereto. The interference may be suspended and referred to the primary examiner for consideration of the matter, in which case the parties will be notified of the reason to be considered. Arguments of the parties regarding the matter will be considered if filed within 20 days of the notification. The interference will be continued or dissolved in accordance with the determination by the primary examiner. If such reference or reason be found while the interference is before the primary examiner for determination of a motion, decision thereon may be incorporated in the decision on the motion, but the parties shall be entitled to reconsideration if they have not submitted arguments on the matter.

37 CFR 1.237 covers dissolution of an interference on the primary examiner's own motion if he or she discovers a reference or other reason which renders any count unpatentable.

The following procedures are available under the provisions of 37 CFR 1.237:

A. If the primary examiner becomes aware of a reference or other reason for dissolving the interference as to any count when the interference is before him or her for determination of a motion, decision on this newly discovered matter "may be incorporated in the decision on the motion, but the parties shall be entitled to re-

consideration if they have not submitted arguments on the matter" (37 CFR 1.237). This same practice obtains when the primary examiner discovers a new reason for holding counts proposed under 37 CFR 231(a) (2) or (3) unpatentable. Under this practice, the primary examiner should state that reconsideration may be requested within the time specified in 37 CFR 1.243(d).

B. If the primary examiner becomes aware of a reference or other reason for dissolving the interference as to any count when the interference is not before the examiner for determination of a motion, the primary examiner should call the attention of the Patent Interference Examiner to the matter. The primary examiner should include in his or her letter to the Patent Interference Examiner a statement applying the reference or reason to each of the counts of the interference which he or she deems unpatentable and should forward with the original signed letter a copy thereof for each of the parties of the interference. Form at § 1112.08.

The Patent Interference Examiner then may suspend the interference and forward a copy of the letter to each of the parties together with the following communication:

> The attached communication from the primary examiner has been forwarded to the Patent Interference Examiner. Inasmuch as the primary examiner has chosen to act under 37 CFR 1.237 this proceeding is suspended. Reconsideration can be requested in accordance with 37 CFR 1.237.

It is improper for party to an interference to bring a reference or any other reason for dissolution to the attention of the primary examiner except by a motion to dissolve under 37 CFR 1.231 or, after the motion period has closed, by an inter partes letter calling attention to the reference or reason. See § 1111.01. In the latter case, consideration of the reference or reason is discretionary with the primary examiner. The Patent Interference Examiner may upon receipt of such a letter submit it to the primary examiner, who will follow the procedure set forth in paragraph B above if he or she considers that the subject matter corresponding to the count in issue is unpatentable over a reference or for any other reason.

On the other hand, if the primary examiner considers said subject matter to be patentable, under the circumstances, he or she will notify the Patent Interference Examiner informally of his or her conclusion. The Patent Interference Examiner will then send a letter to the parties to the effect that the primary examiner has considered the reference or other reason, etc. and still considers the subject matter corresponding to the count to be patentable. No reason or basis for the conclusion of the primary examiner will be stated in this letter, since the parties have no right to be heard on this question. See, Hageman v. Young, 1898 CD 18 (Comm. Dec.).

In cases involving a patent and an application, where the primary examiner acts under 37 CFR 1.237, the practice enunciated in Noxon v. Halpert, 128 USPQ 481 (Com. Dec. 1953) should be followed. See § 1101.02(f).

If, in an interference involving an applicant and a patent, the *applicant* calls attention to a reference which the applicant states anticipates the issue of the interference or makes an admission that applicant's claim corresponding to the count is unpatentable because of a public use or sale, 35 USC 102(b), the Patent Interference Examiner will forthwith dissolve the interference, and the primary examiner will thereupon reject the claim or claims to the applicant on his own admission of nonpatentability without commenting on the pertinency of the reference. Such applicant is of course also estopped from claiming subject matter not patentable over the issue.

If preliminary statements have become open to all parties, 37 CFR 1.227, or if not and a party authorizes the primary examiner to inspect his preliminary statement, effect may be given thereto in considering the applicability of a reference to the count under 37 CFR 1.237. See § 1105.02.

1105.06 Form of Decision Letter

In order to reduce the pendency of applications involved in interference proceedings, primary examiners are directed to render decisions on motions within 30 days of the date of transmittal to them.

The decision should separately refer to and decide each motion which has been transmitted by a statement of decision as granted or denied. *The decision must include the basis for any conclusions arrived at by the primary examiner.* Care must be taken to specifically identify which limitations of a count are not supported, or the portions of the specification which do provide support for the limitations of the count when necessary to decide a motion. Different grounds urged for seeking a particular action, such as dissolution for example, should be referred to and decided as separate motions. When a motion to dissolve on the ground of no right to make urges lack of support for more than one portion of a count and is granted, the examiner should indicate which portions of the count he or she considered not to be disclosed in the application in question. The same practice applies in denying a party the benefit of prior application.

Motions to amend or to substitute an application, if unopposed, do not require any statement of conclusion if granted, but a denial should be supplemented by a statement of the conclusion on which denial is based. If such a motion is granted over opposition, the reason for overruling the opposition should be given. If an application is to be added or substituted and the examiner has determined that it is entitled to the filing date of a prior application by virtue of a divisional, continuation or continuation-in-part relationship, the decision should so state.

It is advisable to decide motions to dissolve first, then motions to amend or to substitute an application, and finally motions to shift the burden of proof or relating to benefit of an earlier application taking into account any changes in the issue or the parties which may have been effected by the granting of other motions. If a motion to shift the burden of proof is granted the change in the order of parties should be stated.

If a motion to dissolve is granted as to all counts, no decision should be rendered on any motion for benefit that is before the Primary Examiner for determination. Furukawa v. Garty, 151 USPQ 110, (Comm. Pats. 1965).

If a motion to amend is granted the decision should close with paragraphs setting times for nonmoving parties to present claims corresponding to the newly admitted counts and for all parties to file preliminary statements as to them. Such paragraphs should take the following form:

"Should the parties Smith and Brown desire to contest priority as to proposed count 2, they should assert it by amendment to their respective applications on or before _____, and failure to so assert it within the time allowed will be taken as a disclaimer of the subject matter thereof.

On or before _____, the statements demanded by 37 CFR 1.215 *et seq.* with respect to proposed count 2 must be filed in a sealed envelope bearing the name of the party filing it and the number and title of the interference. See also 37 CFR 1.231(f), second sentence. The time for serving preliminary statements, as required by 37 CFR 1.215(b), is set to expire on _____."

If a motion to substitute another commonly owned application by a different inventor is granted, the decision should include a paragraph setting a time for the substituted party to file a preliminary statement in the following form:

"The party _____ to be substituted for the party _____ must file on or before _____, a preliminary statement as required by 37 CFR 1.215 *et seq.* in a sealed envelope bearing his name and the number and title of the interference."

The decision should close with a warning statement such as the following:

"No reconsideration (37 CFR 1.231(d) last sentence)."

The spaces provided in the above paragraphs for the dates for copying allowed proposed counts and for filing and serving preliminary statements should be left blank. The appropriate dates will be inserted in the blank spaces by the Service Branch of the Board of Patent Interferences before the decision is mailed.

Where there has been consultation with a member of the Board of Patent Interferences as required by § 1105.01, the word "APPROVED" and spaced below this the Board member's name who was consulted should be typed at the lower left hand corner of the last page. The Board member will sign in the space below "APPROVED." If less than all of the motions decided required consultation, under § 1105.01, the word "APPROVED" should be followed by an indication of matters requiring such approval. For example,

"Approved as to the motion to shift the burden of proof."

After the decision is signed by the primary examiner and the proper clerical entry made, the complete interference file is forwarded to the Service Branch of the Board of Patent Interferences for dating and mailing or for the Board member's signature if there has been a consultation.

The motion decision is entered in the index of the interference file; it should include the following information and be set forth in this order:

Date_____ "Dec. of Pr. Exr." _____Granted.

If some of the motions have been granted and others denied, the last entry will be "Granted and Denied", and of course, if all the motions have been denied, the last entry will be "Denied." If a date for copying allowed proposed counts and for filing preliminary statements has been set, this should also be indicated at the end of the line by

"Amendment and Statement due_____."

Below are examples of entries which should be made in the interference brief in the section entitled "Decisions on Motion" (Form PTO-222) in each case involved in the interference:

Dissolved
Dissolved as to counts 2 and 3
Dissolved as to Smith
Counts 4 and 5 admitted

These entries should be verified by the primary examiner.

Determination of the next action to be taken is made by the Service Branch of the Board. Examples of such action may be redeclaration, entry of judgment, or setting of time for taking testimony and for filing briefs for final hearing.

1105.07 Petition for Reconsideration of Decision [R–4]

Petitions or requests for reconsideration of a decision on motions under 37 CFR § 1.231 or § 1.237 will not be given consideration § 1.231 (d). An exception is the case where under 37 CFR 1.237 the primary examiner for the first time takes notice of a ground for dissolution while the interference is before the examiner for consideration of motions by the parties and incorporates this matter in his decision so that the parties have had no opportunity to present arguments thereon. In this case the examiner's decision should include a statement to the effect that reconsideration may be requested within the time specified in 37 CFR 1.243(d). See § 1105.05.

1106 Redeclaration of Interferences and Additional Interferences

Redeclaration of interferences where necessitated by a decision on motions under 37 CFR 1.231 will be done by a patent interference examiner, the papers being prepared by the Interference Service Branch. The decision signed by the primary examiner will constitute the authorization. The same practice will apply to the declaration of any new interference which may result from a decision on motions.

1106.01 After Decision on Motion

Various procedures are necessary after decision on a motion. The following general rules may be stated:

(1) If the total result of the motion decision consists solely in the elimination of counts, the elimination of parties or a shifting of the burden of proof, no redeclaration is necessary. The motion decision itself constitutes the paper deleting counts or parties and is likewise adequate notice of the shifting of the burden of proof.

(2) If the motion decision results in any addition or substitution of parties or applications or the addition or substitution of counts, then redeclaration is necessary. If redeclaration is necessary, the information falling within category (1) is also included in the redeclaration papers. The old counts should retain their old numbers for ease of identification.

(3) Since all of the necessary information concerning an application to be added or substituted should appear in the motion decision or on the face of the application file no separate communication from the primary examiner to the patent interference examiner is necessary or desired.

The patent interference examiner will determine whether or not the nonmoving parties have copied the proposed counts which have been admitted within the time allowed and if they have, he will proceed with the redeclaration. If a party fails so to copy a proposed count and thus will not be included in interference as to such count the application will be returned to the primary examiner by the patent interference examiner with a memorandum explaining the circumstances, unless the original interference will continue as to one or more counts. In the latter case the application concerned will be retained with the original interference and a new interference will be declared (assuming at least one other nonmoving party asserts the proposed count) on the new count and including only those parties who have asserted it in their applications.

In declaring a new interference as a result of a motion decision the notices to the parties and the declaration sheet will include a statement to the following effect:

"This interference is declared as the result of a decision on motions in Interference No. _____."

In this case also, no times for filing preliminary statements or motions will be set.

1106.02 By Addition of New Party by Examiner

37 CFR 1.238. Addition of new party by examiner. If during the pendency of an interference, another case appears, claiming substantially the subject matter in issue, the primary examiner should notify the Board of Patent Interferences and request addition of such case to the interference. Such addition will be done as a matter of course by a patent interference examiner, if no testimony has been taken. If, however, any testimony may have been taken, the patent interference examiner shall prepare and mail a notice for the proposed new party, disclosing the issue in interference and the names and addresses of the interferants and of their attorneys or agents, and notices for the interferants disclosing the name and address of the said party and his attorney or agent, to each of the parties, setting a time for stating any objections and at his discretion a time of hearing on the question of the admission of the new party. If the patent interference examiner be of the opinion that the new party should be added, he shall prescribe the conditions imposed

upon the proceedings, including a suspension if appropriate.

Section 1.238 states the procedure to be followed when the examiner finds, or there is filed, other or new applications interfering as to some or as to all of the counts. The procedure when any testimony has been taken differs considerably from the procedure when no testimony has been taken. However, the difference does not involve the primary examiner but rather affects the action taken by the patent interference examiner.

The primary examiner forwards Form PTO–850 accompanied by the additional application to the Interference Service Branch, giving the same information regarding the additional application as in connection with an original declaration (§ 1102.01) and also including the number of the interference. If no testimony has been taken, the patent interference examiner will as a matter of course suspend the interference and redeclare it to include the additional party setting such times for the new party or all parties as is consistent with the stage of proceedings at that point. If the additional party is to be added as to only some of the counts, the patent interference examiner will declare a new interference as to those counts and reform the original interference omitting the counts which are included in the new one. In this case the fact that the issue was in another interference should be noted in all letters in the new interference.

1106.03 After Resumption of Ex Parte Prosecution Subsequent to the Termination of an Interference by Dissolution Under 37 CFR 1.231 or 1.237

If the examiner finds upon further consideration that the position taken in a decision on motion dissolving an interference was incorrect and that the interference should be reinstituted, the following procedures should be followed:

1. The examiner should upon allowance of the claims in the application which were previously denied, corresponding to the former counts in the interference clearly indicate in the action to the applicant, the reasons for the change in position as compared to the position taken in the decision on motions.

2. This action to the applicant allowing such claims should have the approval of and bear the approval of the Group Director.

3. The application(s) and patent(s) involved in the reinstituted interference should be forwarded together with the necessary forms PTO–850 and the old terminated interference files to the Board of Patent Interferences.

4. At the top of the form PTO–850, in the legend "Interference-Initial Memorandum", the word "Initial" should be stricken and the word "Reinstatement" should be substituted therefor in red ink.

5. The forms PTO–850 must bear the approval of the Group Director.

1107 Examiner's Entry in Interference File Subsequent to Interference

An interference is terminated either by dissolution or by an award of priority to one of the parties. In either case the interference is returned with the entire record to the examiner as soon as the decision or judgment has become final.

After the files have been returned to the examining group the primary examiner is required to make an entry on the index in the interference file on the next vacant line that the decision has been noted, such as by the words "Decision Noted" and the primary examiner's initials. The interference file is returned to the Service Branch of the Board of Patent Interferences when the examiner is through with it. There it will be checked to see that such note has been made and initialed before filing away the interference record.

1108 Entry of Amendments Filed in Connection With Motions

This section is limited to the disposition of amendments filed in connection with motions in an application involved in interference, after the interference has terminated.

The manner of treating other amendments which are filed in an application during the course of the interference, is discussed in a separate section (§ 1111.05).

Under 37 CFR 1.231(c) an applicant is required to submit with his motion to amend the issue or to substitute an application, as a separate paper, and 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 counts to an interference must be accompanied by the claim or claims to be added and with the appropriate fees, if any, which would be due if the amendments were to be entered, it may be that the amendments will never be entered. Only upon the granting of the motion is it necessary for the other party or

parties to present the claims, but the fees must be paid whenever presented. Claims which have been submitted in response to a suggestion by the Office for inclusion in an application must be accompanied by the fee due, 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 1.266.)

In each instance the applicant is informed of the disposition of the amendment in the first action in the case following the termination of the interference. If the case is otherwise ready for issue, applicant is notified that the application is allowable 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 under § 1.231(a)(2). The interference proceeding was not such an Office action as relieved the case from its condition as the doctrine of Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

It should be noted at this point that, under the provisions of § 1.262(d), the termination of an interference on the basis of a disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest filed by an applicant operates without further action as a direction to cancel the claims involved from the application of the party making the same.

1109 Action After Award of Priority

Under 35 U.S.C. 135, the Commissioner may at once issue a patent to the applicant who is adjudged by the Board of Patent Interferences to be the prior inventor, without waiting for appeal by any loser. However, in ordinary cases it is the policy of the Office not to issue a patent to the winning party during the period within which appeal may be taken to the Court of Customs and Patent Appeals, or during the pendency of such appeal. Therefore, the files are not returned to the examining group until after the termination of the appeal period, or the termination of the appeal, as the case may be. 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, even though, where no appeal to the Court of Customs and Patent Appeals was filed, the losing party to the interference may file a suit under 35 U.S.C. 146. In a case where a patentee is the losing party, and the Office is notified that a civil action under 35 U.S.C. 146 has been initiated, the files will not be returned to the examining group until after that action has been terminated. The date when the priority decision becomes final does not mark the beginning of a statutory period for response by the applicant. See Ex parte Peterson, 1941 C.D. 8, 525 O.G. 3.

If an application had 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 a notation will be relied upon by the Patent Issue Division as showing that the application is intended to be passed for issue and make it possible to screen out those applications which are mistakenly forwarded to the Patent Issue Division during the pendency of the interference.

See § 1302.12 with respect to listing references discussed in motion decisions.

1109.01 The Winning Party

The winning party may be sent to issue despite the filing of a suit under 35 U.S.C. 146 by his opponent in an interference solely involving pending applications. Monaco v. Watson, 106 U.S. App. D.C. 142, 270 F. 2d 335, 122 USPQ 564. In an interference involving a patent where the winning party is an applicant, the Office will not send the application to issue while a suit is pending under 35 U.S.C. 146. Monsanto v. Kamp et al., 146 USPQ 431.

If the winning party's application was not in allowable condition when the interference was formed and has since been amended, or if it contains an unanswered amendment, or if the rejection standing against the claims at the time the interference was formed was overcome by reason of the award of priority, as an interference involving the application and a patent which formed the basis of the rejection, the examiner forthwith takes the application up for action.

If, however, the application of the winning party contains an unanswered Office action, the examiner at once notifies the applicant of this fact and requires response to the Office action within a shortened period of two months running from the date of such notice. See Ex parte Peterson, 1941 C.D. 8, 525 O.G. 3. This procedure is not to be construed as requiring the reopening of the case if the Office action had closed the prosecution before the examiner.

The following language is suggested for notifying the winning party that his application contains an unanswered Office action:

[1] "Interference No. _____ has been terminated by a decision favorable to applicant. Ex parte prosecution is resumed.

However, this application contains an unanswered Office action.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO SUCH ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS LETTER."

If the prosecution of the winning party's case 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., Etc., 1943 C.D. 338, 57 USPQ 111, 30 CCPA 927.) The winning party of the interference is not denied anything he or she was in possession of prior to the interference, nor has he or she acquired any additional rights as a result of the interference. His or her case 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 to 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 two months within which to file an appeal or cancel the finally rejected claims.

1109.02 The Losing Party

The application of each of the losing parties following an interference terminated by a judgment of priority is acted on at once. The judgment is examined to determine the basis therefor and action is taken accordingly.

If the judgment is based on a disclaimer, concession of priority, or abandonment of the invention filed by the losing applicant, such disclaimer, concession of priority, or abandonment of the invention operates "without further action as a direction to cancel the claims involved from the application of the party making the same" (37 CFR 1.262(d)). Abandonment of the contest has a similar result. See § 1110. The interference counts thus disclaimed, conceded, or abandoned are accordingly canceled from the application of the party filing the document which resulted in the adverse judgment.

If the judgment is based on grounds other than those referred to in the preceding paragraph, the claims corresponding to the interference counts in the application of the losing party should be treated in accordance with 37 CFR 1.265, which provides that such claims "stand finally disposed of without further action by the examiner and are not open to further ex parte prosecution." Accordingly, a pencil line should be drawn through the claims as to which a judgment of priority adverse to applicant has been rendered, and the notation "37 CFR 1.265" 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 case is otherwise ready for issue, these notations should be replaced by a line in red ink and the notation "37 CFR 1.265" in red ink before passing the case 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 be informed that "Claims (designated by numerals), as to which a judgment of priority adverse to applicant has been rendered, stand finally disposed of in accordance with 37 CFR 1.265."

If, as the result of one or both of the two preceding paragraphs all the claims in the application are eliminated, a letter should be written informing the applicant that all the claims in his case 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 appeal or review by civil action was due if no appeal or civil action was filed.

Except where judgment is based solely on ancilliary matters, any remaining claims in each defeated party's case should be reviewed in connection with the winning party's disclosure.

An interference settles not only the rights of the parties under the issues or counts of the interference but also settles every question of the rights to any claim which might have been presented and determined in the interference proceeding. The doctrine of estoppel has been applied where a party has neglected or refused to contest priority of patentable subject matter

which is clearly common to his application and the application of his opponent in interference.

Claims which the winning party could not make, for lack of disclosure, cannot be denied to the loser on the ground of interference estoppel, if they distinguish patentably from the counts.

The distinction which should be borne in mind is that, with regard to interference estoppel, the losing party is only estopped to obtain claims which read directly on disclosures of subject matter clearly common to both the winning party's application and that of the losing party; but that, with regard to prior art (including prior invention), the losing party cannot obtain claims to subject matter which is either barred under 35 U.S.C. 102(g), or rendered obvious under 35 U.S.C. 103, by the invention defined in the interference counts. In re Risse et al., 154 USPQ 1, 54 CCPA 1495.

Where the winning party is an applicant, reference should be made only to the application of _____ (Name), the winning party in Interference _____ No., but the serial number or the filing date of the other case should not be included in the Office Action. However, a losing applicant may avoid a rejection based on *unclaimed* disclosure of a winning *patentee*. When notice is received of the filing of a suit under 35 U.S.C. 146, further action is withheld on the application of the party filing the suit. No letter to that effect need be sent.

When the award of priority is based solely upon ancillary matters, as right to make, and is in favor of the junior party, the claims of the senior party, even though the award of priority was to the junior party, are not subject to rejection on the ground of estoppel, through failure to move under 37 CFR 1.231(a)(2) or on the disclosure of the junior party as prior art (37 CFR 1.257).

If the losing party's case 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, rejections as unpatentable over the issue, unpatentable over the winning party's disclosure, or any other suitable rejections 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, he may order a copy thereof to enable him to respond to a rejection based on the successful party's disclosure. Such order is referred to the Patent Interference Examiner who has authority to approve orders of this nature.

Where the rejection is based on the issue of the interference, there is no need for the applicant to have a copy of the winning party's drawing, for the issue can be interpreted in the light of the applicant's own drawing as well as that of the successful party.

It may be added that rejection on estoppel through failure to move under 37 CFR 1.231(a)(2) and (3) may apply where the interference terminates in a judgment of priority as well as where it is ended by dissolution. See § 1110. However, 37 CFR 1.231(a)(3) now limits the doctrine of estoppel to subject matter in the cases involved in the interference. See § 1105.03.

1110 Action After Dissolution

After dissolution of an interference any amendments which accompanied motions to dissolve are entered to the extent that the motions were not denied. See § 1108. See § 1302.12 with respect to listing references discussed in motion decisions. If the grounds for dissolution are also applicable to the nonmoving parties, e.g., unpatentability of the subject matter of the interference, the examiner should, on the return of the files to the group, reject in each of the applications of the nonmoving parties the claims corresponding to the counts of the interference on the grounds stated in the decision. It is proper to refer to the "application of _____ (Name), an adverse party in Interference _____ No.," but neither the Serial number nor the filing date of such application should be included in the Office action.

If an application was in condition for allowance or appeal prior to the declaration of the interference, the matter of reopening the prosecution after dissolution of the interference should be treated in the same general manner as after an award of priority. (See §§ 1109.01 and 1109.02.)

1110.01 Action after Dissolution—By Termination Paper Filed Under 37 CFR 1.262(b)

Dissolution of an interference on the basis of an abandonment of the contest operates as a direction to cancel the involved claims from that party's application (37 CFR 1.262(d)).

If all the claims in an application are eliminated, see the fourth paragraph of § 1109.02 for the action to be taken.

37 CFR 1.262(b) reads in part:

> Upon the filing of such abandonment of the contest or of the application, the interference shall be dissolved as to that party, but such dissolution shall in subsequent proceedings have the same effect with respect to the party filing the same as an adverse award of priority.

Under these circumstances, it should be noted that, pursuant to the last sentence of 37 CFR 1.262(b), supra, the party who abandons the contest or the application *stands on the same footing as the losing party* referred to in § 1109.02.

1110.02 Action After Dissolution Under 37 CFR 1.231 or 1.237

If, following the dissolution of the interference under 37 CFR 1.231 or 1.237, any junior party files claims that might have been included in the issue of the interference such claims should be rejected on the ground of estoppel. The senior of the parties, in accordance with 37 CFR 1.237, is exempted from such rejection. Where it is only the junior parties to the interference that have common subject matter additional to the subject matter of the interference, the senior one of this subgroup is free to claim this common subject matter. 37 CFR 1.231(a)(3) now limits the doctrine of estoppel to subject matter in the cases involved in the interference. See §§ 1105.03 and 1109.02.

1111 Miscellaneous

1111.01 Interviews

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 right of each of the parties to make the claims in issue or any claim suggested to be added to the issue and the question of the patentability of the claims.

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 partes* questions.

1111.02 Record in Each Interference Complete

When there are two or more interferences pending in this Office relating to the same subject matter, or in which substantially the same applicants or patentees are parties thereto, in order that the record of the proceedings in each particular interference may be kept separate and distinct, all motions and papers sought to be filed therein must be titled in and relate only to the particular interference to which they belong, and no motion or paper can be filed in any interference which relates to or in which is joined another interference or matter affecting another interference.

The examiners are also directed to file in each interference a distinct and separate copy of their actions, so that it will not be necessary to examine the records of several interferences to ascertain the status of a particular case.

This will not, however, apply to the testimony. All papers filed in violation of this practice will be returned to the parties filing them.

1111.03 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 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 § 709.01.

Where an application involved in 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.

1111.04 "Secrecy Order" Cases

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

> (b) An interference will not be declared involving applications under secrecy order. However, if an application under secrecy order copies claims from an issued patent, a notice of that fact will be placed in the file wrapper of the patent.

Since declaration of an interference gives immediate access to applications by opposing parties, no interference will be declared involving an application which has a security status therein (See §§ 107 and 107.02). Claims will be suggested so that all parties will be claiming

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substantially identical subject matter. When all applications contain the claims suggested. the following letter will be sent to all parties:

"Claims 1, 2, etc., (indicating the conflicting claims and claims not patentable over the application under security status) conflict with those of another application. However, the security status (of the other application) or (of your application) does not permit the declaration of an interference. Accordingly, action on the applications is suspended for so long as this situation continues.

"Upon removal of the security status 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 copied from a patent in a "security type" application should be placed in the patented file. Also, in accordance with 37 CFR 1.205(c), the patentee should be notified. The question of an interference is taken up upon termination of the "security status" of the application in which patent claims are copied. 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.

1111.05 Amendments Filed During Interference

The disposition of amendments filed in connection with motions in applications involved in an interference, after the interference has been terminated, is treated in § 1108. If the amendment is filed pursuant to a letter by the primary examiner, after having gotten jurisdiction of the involved application for the purpose of suggesting a claim or claims for interference with another party and for the purpose of declaring an additional interference, the examiner enters the amendment and takes the proper steps to initiate the second interference.

Other Amendments

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 and on the serial and docket cards. After the 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 case.

If the amendment is one filed in a case where *ex parte* prosecution of an appeal to the Board of Appeals is being conducted concurrently with an interference proceeding (see § 1103), and if it relates to the appeal, it should be treated like any similar amendment in an ordinary appealed case.

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.

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.

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. See form at § 1112.10. Where the amendment copies claims of a patent not involved in the interference and which the examiner believes 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 limit for response. If reconsideration is requested and rejection made final a time limit 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 copied patent claims or where copied patent claims 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. See letter form in § 1112.10.

1111.06 Notice of Rule 37 CFR 1.231 (a)(3) Motion Relating to Application Not Involved in Interference

Whenever a party in interference brings a motion under 37 CFR 1.231(a)(3) affecting an application not already included in the interference, the Examiner of Interferences should at once 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 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 group should be ascertained and the notice forwarded to that Group.

This notice serves several useful and essential purposes, and due attention must be given to it 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. See form in § 1112.04. Third, if the application contains an affidavit or declaration under 37 CFR 1.131, this must be sealed because the opposing parties have access to the application.

1111.07 Conversion of Application From Joint to Sole or Sole to Joint

Although, for simplicity, the subject of this section is titled "Conversion of Application from Joint to Sole or Sole to Joint," it includes all cases where an application is converted to decrease or increase the number of applicants. See § 201.03.

If conversion is attempted after declaration of an interference but prior to expiration of the time set for filing motions, the matter is treated as an *inter partes* matter, subject to opposition. That is, the filing of conversion papers during this period whether or not accompanied by a formal motion will be treated as a motion under 37 CFR 1.231(a)(5) and will be transmitted to the primary examiner for decision after expiration of the time within which reply briefs may be filed, along with any other motions which may have been filed. If conversion is permitted, redeclaration will be accomplished as in other cases on the basis of the decision on motions.

If conversion is attempted after the close of the motion period but prior to the taking of any testimony, the Interference Examiner may, at his discretion, either transmit the matter to the primary examiner for determination or defer consideration thereof to final hearing for determination by the Board of Patent Interferences. If transmitted to the primary examiner, the matter is treated as outlined in the preceding paragraph.

If conversion is attempted after the taking of testimony has commenced, the Interference Examiner will generally defer consideration of the matter to final hearing for determination by the Board of Patent Interferences.

In any case where the examiner must, when deciding the question of converting an application, determine whether the legal requirements for such conversion have been satisfied, just as in the ordinary *ex parte* treatment of the matter. Also as in *ex parte* situations the examiner should make of record the formal acknowledgment of conversion as required by § 201.03.

A party may occasionally seek to substitute an application with a lesser or greater number of applicants for the application originally involved in the interference. Such substitution is treated in the same manner as the conversion of an involved application as described above.

1111.08 Reissue Application Filed While Patent Is in Interference

Care should be taken that a reissue of a patent should not be granted while the patent is involved in an interference without approval of the Commissioner.

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the examiner is taken thereon.

Such applications are normally forwarded by the Application Division to the Office of the Solicitor. A letter with titling relative to the interference is placed in the interference file by the Commissioner and copies thereof are placed in the reissue application and mailed to the parties to the interference. This letter gives notice of the filing of the reissue application and generally includes a paragraph of the following nature:

The reissue application will of course be open to inspection by the opposing party during the interference and may be separately prosecuted during the interference, but will not be passed

to issue until the final determination of the interference, except upon the approval of the Commissioner.

Should an application for reissue of a patent which is involved in an interference reach the examiner without having a copy of the letter by the Commissioner attached, it should be promptly forwarded to the Office of the Solicitor with an appropriate memorandum.

1111.09 Suit Under 35 U.S.C. 146 By Losing Party

35 U.S.C. 146. Civil action in case of interference. Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

When a losing party to an interference gives notice in his application that he has filed a civil action under the provisions of 35 U.S.C. 146, relative to the interference, that notice should be called to the attention of the Interference Service Branch in order that a notation thereof can be made on the index of the interference.

When notice is received of the filing of a suit under 35 U.S.C. 146, further action is withheld on the application of the party filing the suit. No letter to that effect need be sent.

1111.10 Benefit of Foreign Filing Date

If a request for the benefit of a foreign filing date under 35 U.S.C. 119 is filed while an application is involved in interference, the papers are to be placed in the application file in the same manner as amendments received during interference, and appropriate action taken after the termination of the interference.

A party will be given the benefit of a foreign filing date in the declaration notices only under the circumstances set out in § 1102.01(a). A party having a foreign filing date which is not accorded him in the declaration papers should file a motion to shift the burden of proof or for benefit of that filing date under 37 CFR 1.231 (a) (4) and the matter will be considered on an *inter partes* basis.

1111.11 Patentability Reports

The question of Patentability Reports rarely arises in interference proceedings but the proper occasion therefor may occur in deciding motions. If appropriate, Patentability Report practice may be utilized in deciding motions and the procedure should follow as closely as possible the *ex parte* Patentability Report practice.

1111.13 Consultation With Interference Examiner

In addition to the consultation required in connection with certain motion decisions in § 1105.01, the examiner should consult with a Patent Interference Examiner or a member of the Board of Patent Interferences 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 case.

1111.14 Correction of Error in Joining Inventor

Requests for certificates correcting the misjoinder or nonjoinder of inventors in a patent are referred to the Office of the Solicitor for

consideration. If the patent is involved in interference when the request is filed, the matter will be considered *inter partes*. Service of the request on the opposing party will be required and any paper filed by an opposing party addressed to the request will be considered if filed within 20 days of service of a copy of the request on the opposing party. Following this 20 days, the associate solicitor will consider the matter to the extent of determining whether the request *prima facie* conforms to applicable law and policy. During the interference, a copy of any decision concerning the request will be sent to the opposing party as well as to the requesting party. Issuance of the certificate will be withheld until the interference is terminated since evidence adduced in the interference may have a bearing on the question of joinder. See also § 1402.01.

1112 Letter Forms Used in Interferences

Forms are found in Chapter 600 of the Manual of Clerical Procedure which gives details as to the stationery to be used, number of copies, typing format and handling.

1112.02 Letter Suggesting Claims for Interference

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

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Z. Green A.U. 123
Serial No. 999,999 7/3/79
Richard A. Green

Paper No. 4

Charles A. White
123 Main Street
Dayton, Ohio 65497

Please find below a communication from the the EXAMINER in this case.

Commissioner of Patents and Trademarks

The following claim(s) found allowable, is (are) suggested for the purpose of interference:

APPLICANT SHOULD MAKE THE CLAIM(S) BY _____ (allow not less than 30 days, usually 45 days). FAILURE TO DO SO WILL BE CONSIDERED A DISCLAIMER OF THE SUBJECT MATTER INVOLVED UNDER THE PROVISIONS OF 37 CFR 1.203.

Z. Green:ns
(703) 557-2804

PTO45-105 (REV. 2-77) (FORMERLY PTOL-75A)

1112.03 Same Attorney or Agent in Applications of Conflicting Interests

The following sentence 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.

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.

1112.04 Letter Requesting Withdrawal From Issue

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Date _____

Reply to
Attn of: _____, Primary Examiner

Subject: Withdrawal from Issue: S.N. _____

Filed _____

Sent to Issue _____

To : Patent Interference Division

Via: Mr. _____ Director, Group _____

It is requested that the above-entitled application be withdrawn from issue for the purpose of (Examiner provides necessary reason, or designates one of the phrases a-e below)

The issue fee has (or has not) been paid.

Respectfully,

Approved

_____ _____

Group Director Examiner

a. . . . interference, another party having made claims suggested to him from this application.
b. . . . interference, on the basis of claims _____ copied from Pat. No. _____.
c. . . . interference, applicant having made claims suggested to him.
d. . . . rejecting claims _____ on the implied disclaimer resulting from failure to make the claims suggested to him under 37 CFR 1.203.
e. . . . deciding a motion under rule 37 CFR 1.231 (a) (3) involving this application, the issue fee having been paid, or, the motion cannot be decided prior to the ultimate date for paying the issue fee.

1112.05 Initial Interference Memorandum

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

INTERFERENCE – INITIAL MEMORANDUM

PAGE NO. 1

EXAMINERS INSTRUCTIONS – Please do not have this form typewritten. Complete the items below by hand (pen and ink) and forward to the Group Clerk with all files including those benefit of which has been accorded. The parties need not be listed in any specific order.

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

1. LAST NAME OF FIRST LISTED "APPLICANT": SMITH et al (Pat.)

SERIAL NUMBER: 930,658 — FILED (MO., DAY, YEAR): JUNE 19, 1965

* Accorded benefit of

SERIAL NUMBER: 816,322 — DATE FILED: MAY 15, 1965 — DATE PATENTED ☐ OR ABANDONED ☐ PENDING

THROUGH INTERVENING APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ OR ABANDONED ☐

If applicable, check and/or fill in appropriate paragraphs from M.P.E.P. 1102.01(a)

☐ After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims _____ will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

AND APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ OR ABANDONED ☐

2. LAST NAME OF FIRST LISTED "APPLICANT": PARKER

SERIAL NUMBER: 668,512 — FILED (MO., DAY, YEAR): MARCH 12, 1965

* Accorded benefit of

SERIAL NUMBER: 365,321 — DATE FILED: JULY 3, 1961 — DATE PATENTED ☒ DEC. 8, 1963 OR ABANDONED ☐

THROUGH INTERVENING APPLICATION SERIAL NO.: 457,123 — DATE FILED: NOV. 22, 1963 — DATE PATENTED ☐ OR ABANDONED ☒ APRIL 13, 1964

If applicable, check and/or fill in appropriate paragraphs from M.P.E.P. 1102.01(a)

☑ After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims 5, 7, 12 will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

AND APPLICATION SERIAL NO.: 589,762 — DATE FILED: APR. 10, 1964 — DATE PATENTED ☐ OR ABANDONED ☒ 3/15/65

3. LAST NAME OF FIRST LISTED "APPLICANT": GRAY

SERIAL NUMBER: 765,432 — FILED (MO., DAY, YEAR): APRIL 1, 1964

* Accorded benefit of UNITED KINGDOM

SERIAL NUMBER: 11,222/63 — DATE FILED: MAY 15, 1963 — DATE PATENTED ☐ OR ABANDONED ☐

THROUGH INTERVENING APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ OR ABANDONED ☐

If applicable, check and/or fill in appropriate paragraphs from M.P.E.P. 1102.01(a)

☑ After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims _____ will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

AND APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ OR ABANDONED ☐

THE RELATION OF THE COUNTS TO THE CLAIMS OF THE RESPECTIVE PARTIES (INDICATE THOSE MODIFIED).

COUNTS	NAME OF PARTY SMITH et al	NAME OF PARTY PARKER	NAME OF PARTY GRAY	NAME OF PARTY
1	8 (m)	4	5	
2	1	9	6	
3	4	3 (s)	7	
4	5 (p)	6 (p)	8 (p)	
5				
6				

Have modified counts not appearing in any application typed on a separate sheet and attach to this form.

* The serial 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.

GROUP	DATE	SIGNATURE OF PRIMARY EXAMINER
330	JUNE 18, 1969	Andrew Jones

Clerk's Instructions:

1. Obtain a title report for all cases and include a copy.
2. Return transmittal slip PO–261 or PO–262 to the Board of Appeals.
3. Forward all files including those benefit of which is being accorded.

FORM PO–850
Revised 1/71

USCOMM–DC 50674 P–71

1112.08 Primary Examiner Initiating Dissolution of Interference, 37 CFR 1.237 (a)

This form is to be used in all cases except when the interference is before the primary examiner for determination of a motion. Sufficient copies of this form should be prepared and sent to the Patent Interference Examiner so that he may send a copy to each party.

PATENTEE INVOLVED

If one of the parties is a patentee, no reference should be made to the *patent* claims nor to the fact that such claims correspond to the counts, and the group director's approval is required if the ground of rejection would also be applicable to the patent claims. See § 1101.02(f), last paragraph. However, this restriction does not apply to claims of the application. Language such as the following is suggested: "Applicant's claims—are considered anticipated by (or unpatentable over) the—reference."

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

In re Interference No. 98,000

John Willard
v.
Luther Stone

Under the provisions of 37 CFR 1.237, your attention is called to the following patents:

197,520	Jolien	1-1897	214-26
1,637,468	Moran	4-1950	214-26

Counts 1 and 2 are considered anticipated by either of these references under 35 U.S.C. 102 for the following reasons:

(The Examiner discusses the references.)

MMWard:cch

Copies to:

John Jones
133 Fifth Avenue
New York, New York 11346

Leonard Smith
460 Munsey Building
Washington, D.C. 20641

1112.10 Letter Denying Entry of Amendment Seeking Further Interference

(With application or patent not involved in present interference)

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

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Z. Green A.U. 123
Serial No. 999,999 7/3/79
Richard A. Green

Paper No. 4

Charles A. White
123 Main Street
Dayton, Ohio 65497

Please find below a communication from the the EXAMINER in this case.

Commissioner of Patents and Trademarks

The amendment filed _____ has not now been entered since it does not place the case in condition for another interference.

(Follow with appropriate paragraph, e.g., (a) or (b) below:)

(a) Applicant has no right to make claims _____ because (state reason briefly). (Use where applicant cannot make claims for interference with another application or where applicant clearly cannot make claims of a patent.)

(b) Claims _____ are directed to a species which is not presently allowable in this case.

Z. Green:ns
(703) 557-2802

PTO46-105 (REV. 2-77) (FORMERLY PTOL-78A)