Chapter 2300 Interference Proceedings

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2301 Introduction [R-4]

An interference is a contest under 35 U.S.C. 135(a) between an application and either another application or a patent. An interference is declared to assist the Director of the United States Patent and Trademark Office in determining priority, that is, which party first invented the commonly claimed invention within the meaning of 35 U.S.C. 102(g)(1). See MPEP § 2301.03. Once an interference has been suggested under 37 CFR 41.202, the examiner refers the suggested interference to the Board of Patent Appeals and Interferences (Board). An administrative patent judge declares the interference, which is then administered at the Board. A panel of Board members enters final judgment on questions of priority and patentability arising in an interference.

Once the interference is declared, the examiner generally will not see the application again until the interference has been terminated. Occasionally, however, the Board may refer a matter to the examiner or may consult with the examiner on an issue. Given the very tight deadlines in an interference, any action on a consultation or referral from the Board must occur with special dispatch.

The application returns to the examiner after the interference has been terminated. Depending on the nature of the judgment in the case, the examiner may need to take further action in the application. For instance, if there are remaining allowable claims, the application may need to be passed to issue. The Board may have entered a recommendation for further action by the examiner in the case. If the applicant has lost an issue in the interference, the applicant may be barred from taking action in the application or any subsequent application that would be inconsistent with that loss.

Given the infrequency, cost, and complexity of interferences, it is important for the examiner to consult immediately with an Interference Practice Specialist (IPS) in the examiner's Technology Center, see MPEP § 2302, once a possible interference is identified. It is also important to complete examination before the possible interference is referred to the Board. See MPEP § 2303.<

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2301.01 Statutory Basis [R-4]

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

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(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or

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35 U.S.C. 104. Invention made abroad.

(a) IN GENERAL.—

(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) RIGHTS.—If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) USE OF INFORMATION.—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) DEFINITIONS.—As used in this section—

(1) The term "NAFTA country" has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term "WTO member country" has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

35 U.S.C. 135. Interferences.

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

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2301.02 Definitions [R-4]

37 CFR 41.2. Definitions.

Unless otherwise clear from the context, the following definitions apply to proceedings under this part:

Affidavit means affidavit, declaration under § 1.68 of this title, or statutory declaration under 28 U.S.C. 1746. A transcript of an ex parte deposition may be used as an affidavit in a contested case.

Board means the Board of Patent Appeals and Interferences and includes:

(1) For a final Board action:

(i) In an appeal or contested case, a panel of the Board.

(ii) In a proceeding under § 41.3, the Chief Administrative Patent Judge or another official acting under an express delegation from the Chief Administrative Patent Judge.

(2) For non-final actions, a Board member or employee acting with the authority of the Board.

Board member means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.

Contested case means a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an inter partes reexamination is not a contested case.

Final means, with regard to a Board action, final for the purposes of judicial review. A decision is final only if:

(1) *In a panel proceeding.* The decision is rendered by a panel, disposes of all issues with regard to the party seeking judicial review, and does not indicate that further action is required; and

(2) *In other proceedings*. The decision disposes of all issues or the decision states it is final.

Hearing means consideration of the issues of record. *Rehearing* means reconsideration.

Office means United States Patent and Trademark Office.

Panel means at least three Board members acting in a panel proceeding.

Panel proceeding means a proceeding in which final action is reserved by statute to at least three Board members, but includes a

non-final portion of such a proceeding whether administered by a panel or not.

Party, in this part, means any entity participating in a Board proceeding, other than officers and employees of the Office, including:

(1) An appellant;

(2) A participant in a contested case;

(3) A petitioner; and

(4) Counsel for any of the above, where context permits.

37 CFR 41.100. Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart:

Business day means a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia.

Involved means the Board has declared the patent application, patent, or claim so described to be a subject of the contested case.

37 CFR 41.200. Procedure; pendency.

(a) A patent interference is a contested case subject to the procedures set forth in subpart D of this part.

(b) A claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears.

(c) Patent interferences shall be administered such that pendency before the Board is normally no more than two years.

37 CFR 41.201. Definitions.

In addition to the definitions in §§ 41.2 and 41.100, the following definitions apply to proceedings under this subpart:

Accord benefit means Board recognition that a patent application provides a proper constructive reduction to practice under 35 U.S.C. 102(g)(1).

Constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. 102(g)(1) in a patent application of the subject matter of a count. *Earliest constructive reduction to practice* means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent. For the chain to be continuous, each subsequent application must have been co-pending under 35 U.S.C. 120 or 121 or timely filed under 35 U.S.C. 119 or 365(a).

Count means the Board's description of the interfering subject matter that sets the scope of admissible proofs on priority. Where there is more than one count, each count must describe a patentably distinct invention.

Involved claim means, for the purposes of 35 U.S.C.135(a), a claim that has been designated as corresponding to the count.

Senior party means the party entitled to the presumption under § 41.207(a)(1) that it is the prior inventor. Any other party is a *junior party*.

Threshold issue means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

(1) No interference-in-fact, and

(2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:

(i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or

(ii) Unpatentability for lack of written description under 35 U. S.C. 112(1) of an involved application claim where the applicant suggested, or could have suggested, an interference under § 41.202(a).<

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2301.03 Interfering Subject Matter [R-4]

37 CFR 41.203. Declaration.

(a) *Interfering subject matter*. An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.

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A claim of one inventor can be said to interfere with the claim of another inventor if they each have a patentable claim to the same invention. The Office practice and the case law define "same invention" to mean patentably indistinct inventions. *Case v. CPC Int'l, Inc.*, 730 F.2d 745, 750, 221 USPQ 196, 200 (Fed. Cir. 1984); *Aelony v. Arni*, 547 F.2d 566, 570, 192 USPQ 486, 489-90 (CCPA 1977); *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416 (CCPA 1976); *Ex parte Card*, 1904 C.D. 383, 384-85 (Comm'r Pats. 1904). If the claimed invention of either party is patentably distinct from the claimed invention of the other party, then there is no interference-in-fact. *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416 (CCPA 1976). 37 CFR 41.203(a) states the test in terms of the familiar concepts of obviousness and anticipation. Accord *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wa.*, 334 F.3d 1264, 1269-70, 67 USPQ2d 1161, 1164-65 (Fed. Cir. 2003) (affirming the Office's interpretive rule).

Identical language in claims does not guarantee that they are drawn to the same invention. Every claim must be construed in light of the application in which it appears. 37 CFR 41.200(b). Claims reciting means-plus-function limitations, in particular, might have different scopes depending on the corresponding structure described in the written description.

When an interference is declared, there is a description of the interfering subject matter, which is called a "count." Claim correspondence identifies claims that would no longer be allowable or patentable to a party if it loses the priority determination for the count. To determine whether a claim corresponds to a count, the

subject matter of the count is assumed to be prior art to the party. If the count would have anticipated or supported an obviousness determination against the claim, then the claim corresponds to the count. 37 CFR 41.207(b)(2). Every count must have at least one corresponding claim for each party, but it is possible for a claim to correspond to more than one count.

Example 1

A patent has a claim to a compound in which R is an alkyl group. An application has a claim to the same compound except that R is n-pentyl, which is an alkyl. The application claim, if prior art to the patent, would have anticipated the patent claim. The patent claim would not have anticipated the application claim. If, however, in the art n-pentyl would have been an obvious choice for alkyl, then the claims define interfering subject matter.

Example 2

An application has a claim to a boiler with a novel safety valve. A patent has a claim to just the safety valve. The prior art shows that the need for boilers to have safety valves is well established. The application claim, when treated as prior art, would have anticipated the patent claim. The patent claim, when treated as prior art and in light of the boiler prior art, can be shown to render the application claim obvious. The claims interfere.

Example 3

An application has a claim to a reaction using platinum as a catalyst. A patent has a claim to the same reaction except the catalyst may be selected from the Markush group consisting of platinum, niobium, and lead. Each claim would have anticipated the other claim when the Markush alternative for the catalyst is platinum. The claims interfere.

Example 4

Same facts as Example 3, except the applicant has a Markush group for the catalyst consisting of platinum, osmium, and zinc. Each claim would have anticipated the other claim when the Markush alternative for the catalyst in each claim is platinum. The claims interfere.

Example 5

An application has a claim to a protein with a specific amino acid sequence shown in SEQ ID NO:1. A patent has a claim to the genus of polynucleotides defined as encoding the same amino acid sequence as the applicant's SEQ ID NO:1. The patent claim would have anticipated the application claim since it expressly describes an amino acid sequence identical to the protein of the application. The application claim would have rendered the patent claim obvious in light of a well-established relationship between nucleic acids for encoding amino acids in protein sequences. The claims interfere.

Example 6

A patent has a claim to a genus of polynucleotides that encode a protein with a specific amino acid sequence. An application has a claim to a polynucleotide that encodes a protein with the same amino acid sequence. The application claim is a species within the genus and thus would have anticipated the patent claim. The patent claim would not have anticipated or rendered the application claim obvious without some explanation of why a person having ordinary skill in the art would have selected the applicant's species from the patentee's genus. Generally the explanation should include citation to prior art supporting the obviousness of the species. Without the explanation, the claims do not interfere.

Example 7

A patent and an application each claim the same combination including "means for fastening." The application discloses glue for fastening, while the patent discloses a rivet for fastening. Despite otherwise identical claim language, the claims do not interfere unless it can be shown that in this art glue and rivets were considered structurally equivalent or would have rendered each other obvious.

Example 8

A patent claims a formulation with the surfactant sodium lauryl sulfate. An application claims the same formulation except no specific surfactant is described. The application discloses that it is well known in the art to use sodium lauryl sulfate as the surfactant in these types of formulations. The claims interfere.

Example 9

An applicant has a claim to a genus and a species within the genus. The interference is declared with two counts, one directed to the genus and one directed to the species. The species claim would correspond to the species count because the count would have anticipated the claimed subject matter. The genus count would not ordinarily have anticipated the species claim, however, so the species claim would only correspond to the genus count if there was a showing that the genus count would have rendered the claimed species obvious. The genus claim, however, would have been anticipated by both the genus count and the species count and thus would correspond to both counts.<

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2302 Consult an Interference Practice Specialist [R-4]

Every Technology Center (TC) has at least one Interference Practice Specialist (IPS), who must be consulted when suggesting an interference to the Board of Patent Appeals and Interferences (Board).

Less than one percent of all applications become involved in an interference. Consequently, examiners are not expected to become experts in interference practices. Instead, examiners are expected to be proficient in identifying potential interference and to consult with an IPS in their TC on interference matters. The IPS, in turn, is knowledgeable about when and how to suggest interferences, how to handle inquiries to and from the Board before and during interferences, and how to handle applications after interferences are completed.

An IPS must approve any referral of a suggested interference to the Board. The referral must include a completed Form PTO-850, which either an IPS or a Director of the examiner's TC must sign.

IPSs consult with administrative patent judges (APJs) that declare interferences to stay current in interference practice. When necessary, an IPS may arrange for a consultation with an APJ to discuss a suggested interference or the effect of a completed interference. Examiners must promptly address inquiries or requests from an IPS regarding a suggested interference.

Form PTO-850-(Rev. 09-30-2005)

DO NOT SCAN - PREDECISIONAL MEMORANDUM
SUGGESTED INTERFERENCE REFERRAL

Count #_____

To the Board of Patent Appeals and Interferences:

An interference is suggested involving the following (insert number) ____ parties—

PARTY	APPLICATION NO.* ☐	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If the involved case is a patent, have its maintenance fees been paid? Yes ☐ No ☐			Not due yet ☐	In grace period ☐
The claim(s) of this party corresponding to this count:			Claim(s) NOT corresponding to this count:	

Proposed priority benefit (list all intervening applications necessary for continuity)

COUNTRY Translation?	APPLICATION NO.*	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
☐	☐			
☐	☐			
☐	☐			
☐	☐			
☐	☐			

PARTY	APPLICATION NO.* ☐	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If the involved case is a patent, have its maintenance fees been paid? Yes ☐ No ☐			Not due yet ☐	In grace period ☐
The claim(s) of this party corresponding to this count:			Claim(s) NOT corresponding to this count:	

Proposed priority benefit (list all intervening applications necessary for continuity)

COUNTRY Translation?	APPLICATION NO.*	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
☐	☐			
☐	☐			
☐	☐			
☐	☐			
☐	☐			

INSTRUCTIONS *(Check off each step, if applicable)*

- ☐ 1. Obtain all files listed above. IFW files should be messaged to the mailbox **BPAI.Inbox**.
- ☐ 2. Confirm that the proposed involved claims are still active and all corrections and entered amendments have been considered. The patents must not be expired for, among other things, failure to pay a maintenance fee (Check RAM File History).
- ☐ 3. If one of the involved or benefit files is a published application or a patent, check for compliance with 35 U.S.C. 135(b).
- ☐ 4. Obtain a certified translation of any non-English language benefit or PCT document (37 CFR 1.55(a)) if not already in file.
- ☐ 5. Attach an explanation of why the claims interfere.
- ☐ 6. Discuss the proposed interference with an Interference Practice Specialist in your Technology Center.

DATE	PRIMARY EXAMINER (name & signature)	ART UNIT	TELEPHONE NO.
DATE	INTERFERENCE PRACTICE SPECIALIST or TC DIRECTOR (name & signature)		TELEPHONE NO.

*For each application listed, check the box if a paper file or artifact file is associated with the application.

Page_____of _____

GENERAL PRACTICES

Practice 1. Consult an Interference Practice Specialist.

In an effort to maximize uniformity, when an examiner first becomes aware that a potential interference exists or any other interference issue arises during prosecution of an application, the examiner should bring the matter to the attention of an IPS in the examiner's TC.

The IPS in turn will consult with an APJ designated from time to time by the Chief Administrative Patent Judge.

A plan of action will be developed on a case-by-case basis.

Practice 2. Party not in condition for allowance.

When:

(A) a first application and a second application claim the same patentable invention; and

(B) a first application is in condition for allowance; and

(C) the second application is not in condition for allowance,

then generally a notice of allowance should be entered in the first application and it should become a patent.

Without suspending action in the first application and after consultation consistent with Practice 1 above, the examiner may wish to give the second applicant a very brief period of time within which to put the second application in condition for allowance, e.g., by canceling rejected claims thereby leaving only allowable claims which interfere with the claims of the first application.

When examination of the second application is complete, an application versus patent interference may be appropriate.

Practice 3. Both in condition for allowance; earliest effective filing dates within six months.

When two applications are in condition for allowance and the earliest effective filing dates of the applications are within six months of each other, an application versus application interference may be suggested, provided the applicant with the later filing date makes the showing required by 37 CFR 41.202(d). Note that if the earliest filed application is available as a reference (for example, as a published application under 35 U.S.C. 102(e)) against the other application, then a rejection should be made against the other application. Ideally, the rejection would be made early in the prosecution, but if it is not and as a result the junior application is not in condition for allowance, then the senior application should be issued. In light of patent term adjustments it is no longer appropriate to suspend an application on the chance that an interference might ultimately result.

Practice 4. Both in condition for allowance; earliest effective filing dates not within six months.

If the applications are both in condition for allowance and earliest effective filing dates of the applications are not within six months of each other, the application with the earliest effective filing date shall be issued. The application with the later filing date shall be rejected on the basis of the application with the earliest effective filing date. Further action in the application with the later filing date will be governed by prosecution in that application. If the applicant in the application with the later filing date makes the showing required by 37 CFR 41.202(d), an application versus patent interference may be declared. If no rejection is possible over the patent issuing from the application with the earliest effective filing date, then the applicant must still be required under 35 U.S.C. 132 to make the priority showing required in 37 CFR 41.202(d).

Practice 5. Suspension discouraged.

Suspension of prosecution pending a possible interference should be rare and should not be entered prior to the consultation required by Practice 1 above.<

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2303 Completion of Examination [R-4]

37 CFR 41.102. Completion of examination.

Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:

(a) Examination or reexamination must be completed, and

(b) There must be at least one claim that:

(1) Is patentable but for a judgment in the contested case, and

(2) Would be involved in the contested case.

An interference should rarely be suggested until examination is completed on all other issues. Each

pending claim must be allowed, finally rejected, or canceled. Any appeal from a final rejection must be completed, including any judicial review. Any petition must be decided.

Example 1

An applicant has one allowed claim directed to invention A, which is the same invention of another inventor within the meaning of 35 U.S.C. 102(g)(1), and has rejected claims directed to different invention B. If the rejection is contested, the application is not yet ready for an interference. Restriction of the application to invention A, followed by cancellation of the claims directed to invention B would remove this impediment to declaring an interference.

Example 2

A patent has a claim to a species. An applicant has claims to the species and to a genus that includes the species. The examiner has allowed the species claim, but rejected the genus claim. The applicant suggests an interference with the patent. The interference will generally not be declared until the applicant resolves the status of the genus claim by, for example, appealing the rejection or canceling the rejected claim. An applicant may expedite the process of having the interference declared by canceling the genus claim from the application.

Two grounds of unpatentability receive particularly close scrutiny before an interference is declared. Enforcement of the written description requirement under 35 U.S.C. 112, first paragraph and the late claiming bars under 35 U.S.C. 135(b) are important to preserve the efficiency and integrity of interferences. 37 CFR 41.201, "Threshold issue." See, e.g., *Berman v. Housey*, 291 F.3d 1345, 1354, 63 USPQ2d 1023, 1029 (Fed. Cir. 2002).

RESTRICTION IN APPLICATIONS WITH INTERFERING CLAIMS

Ordinarily restrictions are limited to situations where (A) the inventions are independent or distinct as claimed, and (B) there would be a serious burden on the examiner if restriction is not required (see MPEP § 803). Potential interferences present an additional situation in which a restriction requirement may be appropriate. Specifically, restriction of interfering claims from non-interfering claims, or from unpatentable claims whose further prosecution would unduly delay initiation of an interference, can be an appropriate use of restrictions under 35 U.S.C. 121. An Interference Practice Specialist (IPS) should be consulted in making and resolving restrictions under this heading. An applicant may, of course, also choose to cancel claims and refile them in a continuation application without waiting for the restriction requirement.

A. Non-Interfering Claims

Patent term adjustments are available for patents whose issuance has been delayed for an interference. 35 U.S.C. 154(b)(1)(C)(i). A claim that does not interfere, by definition, is directed to a patentably distinct invention compared to a claim that does interfere. Leaving a non-interfering claim in an application going into an interference creates an unwarranted delay in the issuance of claims to the non-interfering subject matter. As far as the public and the Office are concerned, there is no justification for not issuing the non-interfering claims promptly. An exception exists if the claims are already term limited, as would be the case for an application subject to a terminal disclaimer or a reissue application (see 35 U.S.C. 154(b)(1)(C) (referring to issuance of the original patent)).

If an application contains both interfering and non-interfering claims, a restriction requirement should be made between the two. If the applicant traverses the restriction requirement, depending on the reasons for the traversal, the restriction may be maintained or the traversal may be treated as a concession that the non-interfering claims should be designated as corresponding to the count.

B. Unpatentable Claims

Ordinarily restriction of claims simply because they are not patentable would not be appropriate. If, however, (A) prosecution of the unpatentable claims to completion would unduly delay initiation of the interference and (B) the delay would create prejudice to another stakeholder, such as another applicant or the public, a restriction requirement may be appropriate. Approval of an IPS is required before this restriction requirement may be made.

Example

An applicant has both broad and narrow claims. The narrow claims are plainly supported, but the support for the broad claims is contested. A patent with claims to the narrow invention issues to another inventor with a much later earliest effective filing date. Delay of the interference until the patentability of the broader claims is resolved may unduly prejudice the patentee and the public by leaving a cloud of doubt hanging over the patent claims.

If the unpatentable application claims are eventually prosecuted to allowance, the examiner should consult with the IPS regarding the status of the interference in case the claims would be affected by the outcome of the interference.

C. Reissue Applications

As explained above, reissue applications are not subject to patent term adjustments. Applicants sometimes, however, file reissue applications to amend patent claims in response to events occurring in the interference. To maintain parity with other applicants, the Board does not permit reissue applicants to add claims that would not correspond to a count. *Winter v. Fujita*, 53 USPQ2d 1234, 1249 (Bd. Pat. App. & Inter. 1999). Since the burden lies with the reissue applicant to comply with *Winter*, the examiner need not require restriction of the non-interfering claims. Practice under *Winter*, however, may explain why some reissue applicants file more than one reissue application for the same patent.

Form paragraph 23.01 may be used to acknowledge a request for interference that is premature since examination of the application has not been completed.

¶ *23.01 Request for Interference Premature; Examination Not Completed*

The request for interference filed **[1]** is acknowledged. However, examination of this application has not been completed as required by 37 CFR 41.102(a). Consideration of a potential interference is premature. See MPEP § 2303.

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2303.01 Issuance and Suspension [R-4]

Since applicants may be eligible for patent term adjustments to offset delays in examination, 35 U.S.C. 154(b)(1), it is important that suspensions should rarely, if ever, be used and that applications with allowed claims be issued to the greatest extent possible.

Example 1

A claim of patent A and a claim of application B interfere. Examination of application B is completed. An interference may not be declared between two patents. 35 U.S.C. 135(a). Consequently, the interfering claim in application B should not be passed to issue, even if it has an earlier effective filing date than patent A. Instead, an interference should be suggested.

Example 2

Two applications, C and D, with interfering claims are pending. Examination of application C is completed and all claims are allowable. Examination of application D is not completed. Application C should be issued promptly. If application C has an earlier effective U.S. filing date when issued as patent C, or when published as application publication C, it may be available as prior art under 35 U.S.C. 102(e) against application D. However, even if application C's effective filing date is later than application D's effective filing date, application C should issue. Until examination of application D is completed, it is not known whether application D should be in interference with application C, so suspension of application C will rarely, if ever, be justified.

Example 3

Two applications, E and F, with interfering claims are pending. Both are ready to issue. (Such ties should be extremely rare; suspensions must not be used to create such ties.) If the applications have their earliest effective filing dates within six months of each other, then an interference may be suggested. If, however, application E's earliest effective filing date is more than six months before application F's earliest effective filing date, then application E should issue. If application E (or the resulting patent E) is available as prior art (under 35 U.S.C. 102(a) or 102(e)) against application F, then a rejection should be made. If not, a requirement under 37 CFR 41.202(d) to show priority should be made. See MPEP § 2305.<

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2303.02 Other Outstanding Issues with Patents [R-4]

Patents that are undergoing reexamination or reissue are subject to the requirement of 37 CFR 41.102 that examination be completed. Patents may, however, be the subject of other proceedings before the Office. For instance, a patent may be the subject of a petition to accept a late maintenance fee, 35 U.S.C. 41(c), or a request for disclaimer or correction. 35 U.S.C. 253 to 256. Such issues must be resolved before an interference is suggested because they may affect whether or how an interference may be declared.

Example 1

A patent maintenance fee has not been timely paid. By operation of law, 35 U.S.C. 41(b), the patent is considered to be expired. An interference cannot be declared with an expired patent. 35 U.S.C. 135(a). Consequently, if a petition to accept delayed payment is not granted, 37 CFR 1.378, then no interference can be declared.

Example 2

A disclaimer under 35 U.S.C. 253, is filed for the sole patent claim directed to the same invention as the claims of the applicant. Since the patentee and applicant must both have claims to the same invention, 35 U.S.C. 102(g)(1), no interference can be declared.

Example 3

Similar to Example 2, a request for correction under 35 U.S.C. 254 or 255, is filed that results in a change to the sole patent claim such that it is no longer directed to the same invention as any claim of the applicant. Again, since the patentee and applicant must both have claims to the same invention, 35 U.S.C. 102(g)(1), no interference can be declared.

Example 4

Inventorship is corrected such that the inventors for the patent and the application are the same. Since 35 U.S.C. 102(g)(1) requires the interference to be with "another inventor," the correction eliminates the basis for an interference. Other rejections, such as a double-patenting rejection may be appropriate.<

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2304 Suggesting an Interference [R-4]

The suggestion for an interference may come from an applicant or from an examiner. Who suggests the interference determines what must be done and shown prior to declaration of an interference. In either circumstance, the examiner must consult with an Interference Practice Specialist (IPS), who may then refer the suggested interference to the Board of Patent Appeals and Interferences.<

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2304.01 Preliminaries to Referring an Interference to the Board [R-4]

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2304.01(a) Interference Search [R-4]

When an application is in condition for allowance, an interference search must be made by performing a text search of the "US-PGPUB" database in EAST or WEST directed to the comprehensive inventive features in the broadest claim. If the application contains a claim directed to a nucleotide or peptide sequence, the examiner must submit a request to STIC to perform an interference search of the sequence. If the search results identify any potential interfering subject matter, the examiner will review the application(s) with the potential interfering subject to determine whether interfering subject matter exists. If interfering subject matter does exist, the examiner will follow the guidance set forth in this chapter. If there is no interfering subject matter then the examiner should prepare the application for issuance. A printout of only the database(s) searched, the query(ies) used in the interference search, and the date the interference search was performed must be made of record in the application file. The results of the interference search must not be placed in the application file.

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

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2304.01(b) Obtaining Control Over Involved Files [R-4]

Ordinarily applications that are believed to interfere should be assigned to the same examiner.

I. IN DIFFERENT TECHNOLOGY CENTERS

If the interference would be between two applications, and the applications are assigned to different Technology Centers (TCs), then one application must be reassigned. Ordinarily the applications should both be assigned to the TC where the commonly claimed invention would be classified. After termination of the interference, further transfer may be appropriate depending on the outcome of the interference.

II. PAPERS NOT CONVERTED TO IMAGE FILE WRAPPER FILES

Although the official records for most applications have been converted into Image File Wrapper (IFW) files, some records exist only in paper form, particularly older benefit application files. Even IFW files may have artifact records that have not been converted. Complete patent and benefit files are necessary for determining whether benefit should be accorded for purposes of 35 U.S.C. 102(g)(1). A suggested interference must not be referred to the Board of Patent Appeals and Interferences (Board) if all files, including benefit files, are not available to the examiner in either IFW format or paper.

If a paper file wrapper has been lost, it must be reconstructed before the interference is referred to the Board.

III. PATENT COOPERATION TREATY APPLICATION FILES

Generally, a separate application file for a Patent Cooperation Treaty (PCT) application is not required for according benefit because the PCT application is included in a national stage application file that is itself either the application involved in the interference or a benefit file. Occasionally, however, the PCT application file itself is required for benefit. For instance, if benefit is claimed to the PCT application, but not to a national stage application in which it is included, then the PCT application file must be obtained.<

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2304.01(c) Translation of Foreign Benefit Application [R-4]

A certified translation of every foreign benefit application or Patent Cooperation Treaty (PCT) application not filed in English is required. 35 U.S.C. 119(b)(3) and 372(b)(3) and 37 CFR 1.55(a)(4). If no certified translation is in the official record for the application, the examiner must require the applicant to file a certified translation. The applicant should provide the required translation if applicant wants the application to be accorded benefit of the non-English language application. Any showing of priority that relies on a non-English language application is *prima facie* insufficient if no certified translation of the application is on file. 37 CFR 41.154(b) and 41.202(e).

Form paragraph 23.19 may be used to notify applicant that a certified English translation of the priority document is required.

¶ *23.19 Foreign Priority Not Substantiated*

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action, 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

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2304.01(d) Sorting Claims [R-4]

An applicant may be entitled to a day-for-day patent term adjustment for any time spent in an interference. If an applicant has several related applications with interfering claims intermixed with claims that do not interfere, the examiner should consider whether the interfering claims should be consolidated in a single application or whether an application should be restricted to claims that do not interfere. This way examination can proceed for any claims that do not interfere without the delay that will result from the interference.

Interfering claims of an applicant are “conflicting claims” within the meaning of 37 CFR 1.78(b). The

examiner may require consolidation of such claims into any disclosure of the applicant that provides support for the claims. 35 U.S.C. 132(a).

Similarly, the examiner should require an applicant to restrict an application to the interfering claims, 35 U.S.C. 121, in which case the applicant may file a divisional application for the claims that do not interfere.

Sorting of claims may not be appropriate in all cases. For instance, a claim should not be consolidated into an application that does not provide support under 35 U.S.C. 112, first paragraph for the claim.<

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2304.02 Applicant Suggestion [R-4]

37 CFR 41.202. Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

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(d) *Requirement to show priority under 35 U.S.C. 102(g).* (1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

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When an applicant suggests an interference under 37 CFR 41.202(a), an examiner must review the suggestion for formal sufficiency. As explained in MPEP § 2304.02(c), the examiner is generally not responsible for determining the substantive adequacy of any priority showing. The examiner may, however, offer pertinent observations on any showing when the suggested interference is referred to the Board of Patent Appeals and Interferences. The observations may be included as an attachment to the Form PTO-850.

Form paragraphs 23.06 to 23.06.06 may be used to acknowledge applicant's suggestion for interference under 37 CFR 41.202(a) that failed to comply with one or more of paragraphs (a)(1) to (a)(6) of 37 CFR 41.202.

¶ *23.06 Applicant Suggesting an Interference*

Applicant has suggested an interference pursuant to 37 CFR 41.202(a) in a communication filed **[1]**.

Examiner Note:

1. Use this form paragraph if applicant has suggested an interference under 37 CFR 41.202(a) and applicant has failed to comply with one or more of paragraphs (a)(1) to (a)(6) of 37 CFR 41.202.

2. In bracket 1, insert the date of applicant's communication.

3. This form paragraph must be followed by one or more of form paragraphs 23.06.01 to 23.06.03 and end with form paragraph 23.06.04.

¶ *23.06.01 Failure to Identify the Other Application or Patent*

Applicant failed to provide sufficient information to identify the application or patent with which the applicant seeks an interference. See 37 CFR 41.202(a)(1) and MPEP § 2304.02(a).

¶ *23.06.02 Failure to Identify the Counts and Corresponding Claims*

Applicant failed to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims correspond to one or more counts. See 37 CFR 41.202(a)(2) and MPEP § 2304.02(b).

¶ *23.06.03 Failure to Provide Claim Chart Comparing At Least One Claim*

Applicant failed to provide a claim chart comparing at least one claim of each party corresponding to the count. See 37 CFR 41.202(a)(3) and MPEP § 2304.02(c).

¶ *23.06.04 Failure to Explain in Detail Why Applicant Will Prevail on Priority*

Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c).

¶ *23.06.05 Claim Added/Amended; Failure to Provide Claim Chart Showing Written Description*

Claim **[1]** has been added or amended in a communication filed on **[2]** to provoke an interference. Applicant failed to provide a claim chart showing the written description for each claim in the applicant's specification. See 37 CFR 41.202(a)(5) and MPEP § 2304.02(d).

¶ *23.06.06 Time Period for Reply*

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to correct the deficiency(ies). THE PROVISIONS OF 37 CFR 1.136 DO **NOT** APPLY TO THE TIME SPECIFIED IN THIS ACTION.

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2304.02(a) Identifying the Other Application or Patent [R-4]

37 CFR 41.202. Suggesting an interference.

(a) *Applicant*. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

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Usually an applicant seeking an interference will know the application serial number or the patent number of the application or patent, respectively, with which it seeks an interference. If so, providing that number will fully meet the identification requirement of 37 CFR 41.202(a)(1).

Occasionally, an applicant will believe another interfering application exists based only on indirect evidence, for instance through a journal article, a "patent pending" notice, or a foreign published application. In such cases, information about likely named inventors and likely assignees may lead to the right application. The applicant should be motivated to help the examiner identify the application since inadequate information may prevent the declaration of the suggested interference.<

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2304.02(b) Counts and Corresponding Claims [R-4]

37 CFR 41.202. Suggesting an interference.

(a) *Applicant*. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

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(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

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The applicant must identify at least one patentable claim from every application or patent that interferes for each count. A count is just a description of the interfering subject matter, which the Board of Patent Appeals and Interferences uses to determine what evidence may be used to prove priority under 35 U.S.C. 102(g)(1).

The examiner must confirm that the applicant has (A) identified at least one patentable count, (B) identified at least one patentable claim from each party for each count, and (C) has provided a claim chart comparing at least one set of claims for each count. The examiner need not agree with the applicant's suggestion. The examiner's role is to confirm that there are otherwise patentable interfering claims and that the formalities of 37 CFR 41.202 are met.<

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2304.02(c) Explaining Priority [R-4]

37 CFR 41.202. Suggesting an interference.

(a) *Applicant*. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

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(4) Explain in detail why the applicant will prevail on priority,

*****

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

*****

(d) *Requirement to show priority under 35 U.S.C. 102(g)*. (1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may never-

theless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

*****

A description in an application that would have anticipated the subject matter of a count is called a constructive reduction-to-practice of the count. One disclosed embodiment is enough to have anticipated the subject matter of the count. If the application is relying on a chain of benefit disclosures under any of 35 U.S.C. 119, 120, 121 and 365, then the anticipating disclosure must be continuously disclosed through the entire benefit chain or no benefit may be accorded.

If the application has an earlier constructive reduction-to-practice than the apparent earliest constructive reduction-to-practice of the other application or patent, then the applicant may simply explain its entitlement to its earlier constructive reduction-to-practice. Otherwise, the applicant must (A) antedate the earliest constructive reduction-to-practice of the other application or patent, (B) demonstrate why the other application or patent is not entitled to its apparent earliest constructive reduction-to-practice, or (C) provide some other reason why the applicant should be considered the prior inventor.

The showing of priority may look similar to showings under 37 CFR 1.130-1.132, although there are differences particularly in the scope of what must be shown. In any case, with the exception discussed below, the examiner is not responsible for examining the substantive sufficiency of the showing.

I. REJECTION UNDER 35 U.S.C. 102(a) or 102(e)

If an application claim is subject to a rejection under 35 U.S.C. 102(a) or 102(e) and the applicant files a suggestion under 37 CFR 41.202(a) rather than a declaration under 37 CFR 1.130-1.132, then the examiner must review the suggestion to verify that the applicant's showing, taken at face value, is sufficient to overcome the rejection. If the examiner determines that the showing is not sufficient, then the examination is not completed, 37 CFR 41.102, the rejection should be maintained and the suggestion should not be referred to the Board of Patent Appeals and Interferences (Board) for an interference.

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

If an application claim interferes with a claim of a patent or published application, and the claim was added to the application by an amendment filed more than one year after issuance of the patent, or the application was not filed until more than one year after issuance of the patent (but the patent is not a statutory bar), then under the provisions of 35 U.S.C. 135(b), an interference will not be declared unless at least one of the claims which were in the application, or in a parent application, prior to expiration of the one-year period was for "substantially the same subject matter" as at least one of the claims of the patent.

If the applicant does not appear to have had a claim for "substantially the same subject matter" as at least one of the patent claims prior to the expiration of the one-year period, the examiner may require, 35 U.S.C. 132, that the applicant explain how the requirements of 35 U.S.C. 135(b) are met. Further, if the patent issued from an application which was published under 35 U.S.C. 122(b), note the one year from publication date limitation found in 35 U.S.C. 135(b)(2) with respect to applications filed after the date of publication.

The obviousness test is not the standard for determining whether the subject matter is the same or substantially the same. Rather the determination turns on the presence or absence of a different material limitation in the claim. These tests are distinctly different. The analysis focuses on the interfering claim to determine whether all material limitations of the interfering claim necessarily occur in a prior claim. *In re Berger*, 279 F.3d 975, 61 USPQ2d 1523 (Fed. Cir. 2002). If none of the claims which were present in the application, or in a parent application, prior to expiration of the one-year period meets the "substantially the same subject matter" test, the interfering claim should be rejected under 35 U.S.C. 135(b). *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997). Note that the expression "prior to one year from the date on which the patent was granted" in 35 U.S.C. 135(b) includes the one-year anniversary date of the issuance of a patent. *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964).

Form paragraph 23.14 may be used to reject a claim as not being made prior to one year of the patent issue date. Form paragraph 23.14.01 may be used to reject a claim as not being made prior to one year from the application publication date.

¶ *23.14 Claims Not Copied Within One Year of Patent Issue Date*

Claim **[l]** rejected under 35 U.S.C. 135(b)(1) as not being made prior to one year from the date on which U.S. Patent No. **[2]** was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that 35 U.S.C. 135(b) may be used as a basis for *ex parte* rejections.

¶ *23.14.01 Claims Not Copied Within One Year Of Application Publication Date*

Claim **[l]** rejected under 35 U.S.C. 135(b)(2) as not being made prior to one year from the date on which **[2]** was published under 35 U.S.C. 122(b). See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that 35 U.S.C. 135(b) may be used as a basis for *ex parte* rejections.

Examiner Note:

1. In bracket 2, insert the publication number of the published application.

2. This form paragraph should only be used if the application being examined was filed after the publication date of the published application.

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2304.02(d) Adequate Written Description [R-4]

37 CFR 41.202. Suggesting an interference.

(a) *Applicant*. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

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(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

*****

An applicant is not entitled to an interference simply because applicant wants one. The interfering claim must be allowable, particularly with respect to the written description supporting the interfering claim.

Historically, an applicant provoked an interference by copying a claim from its opponent. The problem this practice created was that differences in the underlying disclosures might leave the claim allowable to one party, but not to the other; or despite identical claim language differences in the disclosures might require that the claims be construed differently.

Rather than copy a claim literally, the better practice is to add (or amend to create) a fully supported claim and then explain why, despite any apparent differences, the claims define the same invention. 37 CFR 41.203(a). The problem of inadequate written description in claims added or amended to provoke an interference is so great that the issue has been singled out for heightened scrutiny early in the course of an interference. 37 CFR 41.201, under "Threshold issue."<

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2304.03 Patentee Suggestion [R-4]

37 CFR 41.202. Suggesting an interference.

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(b) Patentee. A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.99 and § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an interference.

*****

A patentee may not suggest an interference unless it becomes an applicant by filing a reissue application. A patentee may, however, to the limited extent permitted under 37 CFR 1.99 and 1.291, alert an examiner to the existence of interfering claims in an application. See MPEP § 1134 and § 1901.<

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2304.04 Examiner Suggestion [R-4]

37 CFR 41.202. Suggesting an interference.

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(c) *Examiner*. An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102 (g):

(1) Be patentable to the applicant, and

(2) Be drawn to patentable subject matter claimed by another applicant or patentee.

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2304.04(a) Interfering Claim Already in Application [R-4]

If the applicant already has a claim to the same subject matter as a claim in the application or patent of another inventor, then there is no need to require the applicant to add a claim to have a basis for an interference.

The examiner may invite the applicant to suggest an interference pursuant to 37 CFR 41.202(a). An applicant may be motivated to do so in order to present its views on how the interference should be declared.

If the applicant does not suggest an interference, then the examiner should work with an Interference Practice Specialist (IPS) to suggest an interference to the Board of Patent Appeals and Interferences (Board). The suggestion should include an explanation of why at least one claim of every application or patent defines the same invention within the meaning of 37 CFR 41.203(a). See MPEP § 2301.03 for a discussion of interfering subject matter. The examiner must also complete Form PTO-850.

The examiner should be prepared to discuss why claims interfere, whether the subject matter of other claims would have been anticipated or rendered obvious if the interfering claims are treated as prior art, and whether an applicant or patentee is entitled to claim the benefit of an application as a constructive reduction-to-practice. The IPS may require the examiner to prepare a memorandum for the Board on any of these subjects. The IPS may require the examiner to participate in a conference with the Board to discuss the suggested interference.<

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2304.04(b) Requiring a Claim [R-4]

35 U.S.C. 132. Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

*****

The examiner may, pursuant to 35 U.S.C. 132(a), require an applicant to add a claim that would interfere with the claim of another application or patent. For example, the requirement may be made to obtain a clearer definition of the interfering subject matter or to establish whether the applicant will pursue claims to the interfering subject matter. When the requirement is based on a published application with allowed claims or a patent, the examiner must identify the published application or the patent in making the requirement.

Given the cost and complexity of interferences, a requirement to add a claim under 37 CFR 41.202(c) should not be lightly made. Before making the requirement, the examiner should consult with an Interference Practice Specialist (IPS). The following principles should guide the examiner in exercising discretion to make this requirement:

(A) An interference should generally not be suggested if examination of the application is not otherwise completed.

(B) The required claim must not encompass prior art or otherwise be barred.

(C) The application must provide adequate support under 35 U.S.C. 112, first paragraph for the subject matter of the required claim.

(D) A claim should not be required when the applicant expressly states that the commonly described subject matter is not the applicant's invention.

(E) A claim based on a claim from a published application should not be required unless the claim from the published application has been allowed.

Example 1

A patent is 35 U.S.C. 102(b) prior art against any possible interfering claim. No interfering claim should be required.

Example 2

The patent issued more than one year ago and the applicant did not previously have a claim to the

same subject matter. Any added claim would most likely be time barred under 35 U.S.C. 135(b)(1). No interfering claim should be required.

Example 3

An application describes work that attributes to another inventor, but also describes and claims an improvement. The other inventor has received a patent for original work. The applicant may in some sense have 35 U.S.C. 112, first paragraph support for an interfering claim to the other inventor's work. Nevertheless, the applicant has indicated that the commonly described subject matter is not the applicant's invention. No interfering claim should be required.

Example 4

An application has support for both a generic claim G and a species claim G1. The applicant only claims the genus G. A patent discloses and claims only G1. Under the facts of this example, there is no evidence that genus G would have rendered the species G1 obvious. If for some reason the patent is not available as a reference against the application, the examiner may require the applicant to add a claim to species G1 after consulting with an IPS.

Example 5

Published application H and application I both support a claim to H1. Published application H contains a claim to H1, but application I does not. The claim to H1 in the published application is under rejection. Applicant I should not ordinarily be required to add the claim.

Form paragraph 23.04 may be used to require applicant to add a claim to provoke interference.

¶ *23.04 Requiring Applicant to Add Claim to Provoke Interference*

The following allowable claim from **[1]**is required to be added for the purpose of an interference:

[2]

The claim must be copied exactly.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to add the claim. Refusal to add a required claim will operate as a concession of priority for the subject matter of the required claim, but will **not** result in abandonment of this application. See 37 CFR 41.202(c) and MPEP § 2304.04(b). THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

If the interference would be with a patent, applicant must also comply with 37 CFR 41.202(a)(2) to (a)(6).

Examiner Note:

1. In bracket 1, insert the published application number if the claim is an allowed claim from a U.S. application publication or the patent number if the claim is from a U.S. patent.
2. In bracket 2, insert the claim which applicant is required to add to provoke an interference.

APPLICANT MUST ADD THE CLAIM

If required to add a claim under 37 CFR 41.202(c), the applicant must do so. Refusal to add a required claim will operate as a concession of priority for the subject matter of the required claim. The applicant would then be barred from claiming, not only the subject matter of the required claim, but any subject matter that would have been anticipated or rendered obvious if the required claim were treated as prior art. *In re Ogiue*, 517 F.2d 1382, 1390, 186 USPQ 227, 235 (CCPA 1975).

While complying with the requirement to add a claim, an applicant may also express disagreement with the requirement several ways, including:

(A) Identifying a claim already in its application, or another of its applications, that provides a basis for the proposed interference;

(B) Adding an alternative claim and explaining why it would provide a better basis for the proposed interference (such as having better support in the applicant's disclosure); or

(C) Explaining why the required claim is not patentable to the applicant.

The examiner may withdraw the requirement if persuaded by the reasons the applicant offers.<

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2304.05 Common Ownership [R-4]

37 CFR 41.206. Common interests in the invention.

An administrative patent judge may decline to declare, or if already declar ed the Board may issue judgment in, an interference between an application and another application or patent that are commonly owned.

An interference is rarely appropriate between two applications or an application and patent that belong to the same owner. The owner should ordinarily be able to determine priority and is obligated under 37 CFR 1.56 to inform the examiner about which application or patent is entitled to priority. The examiner

may require an election of priority between the application and other application or patent. 35 U.S.C. 132(a).

In making the election, the owner must eliminate the commonly claimed subject matter. This may be accomplished by canceling the interfering application claims, disclaiming the interfering patent claims, amending the application claims such that they no longer interfere, or filing a reissue application to amend the patent claims such that they no longer interfere.

Example 1

Two corporations have applications that claim the same invention. After a merger of the corporations, the resulting corporation owns both applications. The new corporation is obligated to investigate priority. Once the corporation has had an opportunity to determine which application is entitled to priority, the corporation must elect between the applications or otherwise eliminate the need for an interference.

Example 2

J files an application in which J is the sole inventor and assignee. K files an application in which J and K are named as inventors and co-assignees. Although J is an owner of both applications, an interference may nevertheless be necessary if J and K disagree about which application is entitled to priority.<

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2305 Requiring a Priority Showing [R-4]

37 CFR 41.202. Suggesting an interference.

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(d) *Requirement to show priority under 35 U.S.C. 102(g).* (1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

*****

(e) *Sufficiency of showing.* (1) A showing of priority under this section is not sufficient unless it would, if unrebutted, support a determination of priority in favor of the party making the showing.

(2) When testimony or production necessary to show priority is not available without authorization under § 41.150(c) or § 41.156(a), the showing shall include:

(i) Any necessary interrogatory, request for admission, request for production, or deposition request, and

(ii) A detailed proffer of what the response to the interrogatory or request would be expected to be and an explanation of the relevance of the response to the question of priority.

*****

Whenever the application has an earliest constructive reduction-to-practice that is later than the earliest constructive reduction-to-practice of a published application having allowed claims or a patent with which it interferes, the applicant must make a priority showing under 37 CFR 41.202(d)(1).

There are two typical situations in which a showing under 37 CFR 41.202(d)(1) is filed without a requirement from the examiner. First, the applicant may be complying with 37 CFR 41.202(a)(2) in order to suggest an interference under 37 CFR 41.202(a) or as part of complying with a requirement under 37 CFR 41.202(c). Second, the applicant may file the showing to overcome a rejection based on 35 U.S.C. 102(a) or 102(e) when an affidavit is not permitted under 37 CFR 1.131(a)(1) because the applicant is claiming interfering subject matter.

If no showing has been filed, and the application's earliest constructive reduction-to-practice is later than the earliest constructive reduction-to-practice of a patent or published application, then the examiner must require a showing of priority. This showing is necessary because an insufficient showing (including no showing at all) can trigger a prompt judgment against the applicant in an interference. 37 CFR 41.202(d)(2). The applicant may choose to comply with a requirement under 37 CFR 41.202(d)(1) by suggesting an interference under 37 CFR 41.202(a).

Example

Application L has claims that interfere with claims of patent M. Application L was filed in June 2001. The application that resulted in patent M was filed in November 2001, but has an earliest constructive reduction-to-practice in a foreign application filed in December 2000. Assuming no rejection is available under 35 U.S.C. 102(e), the examiner must require a showing under 37 CFR 41.202(d)(1) in application L.

I. RELATIONSHIP TO 37 CFR 1.131 AFFIDAVIT

Ordinarily an applicant may use an affidavit of prior invention under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 102(a) or 102(e). An exception to the rule arises when the reference is a patent or application published under 35 U.S.C. 122(b) and the reference has claims directed to the same patentable invention as the application claims being rejected. 37 CFR 1.131(a)(1). The reason for this exception is that priority is determined in an interference when the claims interfere. 35 U.S.C. 135(a). In such a case, the applicant must make the priority showing under 37 CFR 41.202(d) instead. In determining whether a 37 CFR 1.131 affidavit is permitted or not, the examiner should keep the purpose of the exception in mind. If an interference would not be possible at the time the affidavit would be submitted, then the affidavit should be permitted. This situation could arise two ways.

First, the claims that matter for the purposes of 37 CFR 1.131 are not the published claims but the currently existing claims. For example, if the claims that were published in a published application have been significantly modified during subsequent examination, they may no longer interfere with the rejected claims. Similarly, the patent claims may have been subsequently corrected or amended in a reissue application or a reexamination. Since an interference no longer exists between the current claims in the patent or published application and the rejected claims, an affidavit under 37 CFR 1.131 may be submitted.

Similarly, if a published application contains claims to the same invention, but the claims in the published application are not in condition for allowance, then no interference is yet possible. 37 CFR 41.102. Since the claims in the published application might never be allowed in their present form, it is not appropriate to proceed as though an interference would be inevitable. Consequently, an affidavit under 37 CFR 1.131 may be submitted.

II. NOT A PRIORITY STATEMENT

A priority showing under 37 CFR 41.202(d)(1), which is presented during examination, is not the same as a priority statement under 37 CFR 41.204(a), which is filed during an interference. A priority statement is a notice of what a party intends to prove on the issue of priority during an interference. A priority showing under 37 CFR 41.202(d)(1) must, however, actually prove priority assuming that the opposing party did not oppose the showing. 37 CFR 41.202(e)(1). Generally speaking, while a priority statement might be more detailed in some respects, it will not be sufficient to make the necessary showing of priority for the purposes of 37 CFR 41.202.

An applicant presenting a priority showing must establish through the showing that it would prevail on priority if an interference is declared and the opponent does not oppose the showing. The requirement for a priority showing is intended to spare a senior party patentee the burden of an interference if the junior party applicant cannot establish that it would prevail in an interference even if the senior party does nothing. *Kistler v. Weber*, 412 F.2d 280, 283-85, 162 USPQ 214, 217-19 (CCPA 1969) and *Edwards v. Strazzabosco*, 58 USPQ2d 1836 (Bd. Pat. App. & Inter. 2001).

The consequence of an inadequate showing may be serious for the applicant. If an interference is declared and the Board of Patent Appeals and Interferences (Board) finds the priority showing insufficient (thereby issuing an order to show cause why judgment should not be entered against the applicant), the applicant will not be allowed to present additional evidence to make out a priority showing unless the applicant can show good cause why any additional evidence was not presented in the first instance with the priority showing before the examiner. 37 CFR 41.202(d)(2); *Huston v. Ladner*, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992); *Hahn v. Wong*, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989); *Edwards v. Strazzabosco*, 58 USPQ2d 1836 (Bd. Pat. App. & Inter. 2001). The principles which govern review of a priority showing are discussed in *Basmadjian v. Landry*, 54 USPQ2d 1617 (Bd. Pat. App. & Inter. 1997) (citing former 37 CFR 1.608(b)).<

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2306 Secrecy Order Cases [R-4]

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

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(b) An interference will not be declared involving a national application under secrecy order. An applicant whose application is under secrecy order may suggest an interference (§ 41.202(a) of

this title), but the Office will not act on the request while the application remains under a secrecy order.

*****

Once an interference is declared, an opposing party is entitled to access to the application and benefit applications. 37 CFR 41.109. See MPEP § 2307.02. Consequently, an interference should not be suggested for an application under a secrecy order. See MPEP § 120 and § 130. When a secrecy order expires or is rescinded, if the examination is otherwise completed, 37 CFR 41.102, then the need for an interference may be reconsidered.

If an application not under a secrecy order has allowable claims that interfere with allowable claims of an application that is under a secrecy order, then the application that is not under the secrecy order should be passed to issue as a patent. An interference may be suggested with the application and the patent (unless the patent has expired) once the secrecy order has been lifted.

Example

Application L discloses and claims a transistor that is useful in a commercial context. Application M discloses the same transistor in the context of a missile control circuit, but claims only the transistor. A secrecy order is placed on application M. Once examination of application L is completed and the transistor claim is allowable, application L should pass to issue.<

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2307 Action During an Interference [R-4]

37 CFR 41.103. Jurisdiction over involved files.

The Board acquires jurisdiction over any involved file when the Board initiates a contested case. Other proceedings for the involved file within the Office are suspended except as the Board may order.

Once a patent or application becomes involved in an interference, the Board of Patent Appeals and Interferences (Board) has jurisdiction over the file. The examiner may not act on an involved patent or application except as the Board may authorize.

The Board may occasionally consult with the examiner, for instance, on a question regarding the technology at issue in an involved application or patent.

The Board retains jurisdiction over the interference until the interference is terminated. The Director has defined termination to occur after a final Board judgment in the interference and the period for seeking judicial review has expired or, if judicial review is sought, after completion of judicial review including any further action by the Board. 37 CFR 41.205(a).<

>

2307.01 *Ex Parte* Communications [R-4]

37 CFR 41.11. Ex parte communications in inter partes proceedings.

An ex parte communication about an inter partes reexamination (subpart C of this part) or about a contested case (subparts D and E of this part) with a Board member, or with a Board employee assigned to the proceeding, is not permitted.

Since an interference involves two or more parties, the integrity of the process requires the opportunity for the opposing party to participate in communications or actions regarding any involved application or patent. Once an interference is declared, any attempt by a party to communicate with the Board of Patent Appeals and Interferences (Board) through the examiner or to have the examiner act in an involved patent or application without Board authorization should be promptly reported to the Board. Board action may include a sanction in the interference or referral of a patent practitioner to the Office of Enrollment and Discipline.<

>

2307.02 Access to Related Files [R-4]

37 CFR 41.109. Access to and copies of Office records.

(a) *Request for access or copies*. Any request from a party for access to or copies of Office records directly related to a contested case must be filed with the Board. The request must precisely identify the records and in the case of copies include the appropriate fee set under § 1.19(b) of this title.

(b) *Authorization of access and copies.* Access and copies will ordinarily only be authorized for the following records:

(1) The application file for an involved patent;

(2) An involved application; and

(3) An application for which a party has been accorded benefit under subpart E of this part.

*****

In addition to any access permitted to a member of the public under 37 CFR 1.11 and 1.14 (see MPEP § 103), an opposing party may be authorized under 37 CFR 41.109 to have access to or a copy of the record for any involved patent or application, and for any

application for which benefit has been accorded. The availability of a file to an opposing party under 37 CFR 41.109 has no bearing on whether a file is otherwise available under 37 CFR 1.11 or 1.14.<

>

2307.03 Suspension of Related Examinations [R-4]

Although the examiner may not act in a patent or an application directly involved in an interference, 37 CFR 41.103, examination may continue in related cases, including any benefit files. Once examination is completed, the examiner should consult with an Interference Practice Specialist (IPS) to determine whether and how further action should proceed. The IPS may consult with the Board of Patent Appeals and Interferences (Board) to determine whether the application claims would be barred in the event the applicant loses the interference.

Suspension may be necessary if the claims would be barred by a loss in the interference. Steps should be considered to minimize the effect of any patent term adjustment that would result from the suspension. For instance, the examiner could require restriction, 35 U.S.C. 121, of the application to only the claims that do not interfere so that they can be issued. The applicant may then file a divisional application with the interfering claims, which may be suspended.<

>

2307.04 Additional Parties to Interference [R-4]

During the course of an interference, the examiner may come across applications or patents of parties that claim the same invention, but are not already involved in the interference. If so, the examiner should consult with an Interference Practice Specialist (IPS) and prepare a referral of the suggested interference to the Board of Patent Appeals and Interferences in the same way that a referral is prepared in the first instance.<

>

2307.05 Board Action on Related Files [R-4]

Occasionally, the Board may order that a paper be filed in a related application. Generally, the paper will notify the examiner of a fact, such as a party admission or prior art, that may be relevant to examination of the related case.<

>

2307.06 Action at the Board [R-4]

Action at the Board of Patent Appeals and Interferences (Board) during an interference is beyond the scope of this Chapter. For further information, see 37 CFR part 41, subparts A, D, and E; see also the Board's Contested Case Practice Guide. A Standing Order and other orders, which further direct the conduct of the parties, are also entered in each interference.<

>

2308 Action After an Interference [R-4]

37 CFR 41.127. Judgment.

(a) *Effect within Office*—(1) *Estoppel*. A judgment disposes of all issues that were, or by motion could have properly been, raised and decided. A losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(2) *Final disposal of claim*. Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently.

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(c) *Recommendation*. The judgment may include a recommendation for further action by the examiner or by the Director. If the Board recommends rejection of a claim of an involved application, the examiner must enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

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Jurisdiction over an application returns to the examiner once the interference has terminated. If there is a recommendation for further action in the application, the examiner must reopen prosecution to consider the recommendation. The examiner must enter any recommended rejection, and must maintain the rejection unless the applicant by amendment or submission of new evidence overcomes the rejection to the examiner's satisfaction.

If there is no recommendation in the judgment, the examiner should update the search and may, but is not

required to, reopen prosecution for any claim not disposed of in the judgment.

An interference judgment simply resolves any question of priority between the two parties to the interference. The judgment does not prevent the examiner from making a rejection in further examination in the same application or a different application. If a party loses on an issue in the interference, the examiner should reject any claim for which allowance would be inconsistent with the interference judgment.

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

¶ *23.02 Ex Parte Prosecution Is Resumed*

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

Examiner Note:

1. In bracket 1, insert the interference number.
2. In bracket 2, insert whether favorable or unfavorable.

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2308.01 Final Disposal of Claims [R-4]

Judgment against a claim in an interference, including any judgment on priority or patentability, finally disposes of the claim. No further action is needed from the examiner on that claim. If no claim remains allowable to the applicant, a notice of abandonment should be issued.<

>

2308.02 Added or Amended Claims [R-4]

An applicant may file a motion during the interference to add or amend a claim. A patentee may file a reissue application in support of a motion to add or amend a claim. A copy of the paper adding or amending the claim will be placed in the official record of the application, but not entered. A decision on the motion is entered in the official record of the application. The examiner may enter the added claim or amended claim into the application only if, and only to the extent, authorized by the Board of Patent Appeals and Interferences, typically in the decision on the motion. The decision authorizing entry of the added or amended claim does not prevent the examiner from rejecting the claim during further prosecution.<

>

2308.03 Estoppel Within the Office [R-4]

If a party loses on an issue, it may not re-litigate the issue before the examiner or in a subsequent Board of Patent Appeals and Interferences (Board) proceeding. The time for the party to make all pertinent arguments is during the interference, unless the Board expressly prevented the party from litigating the issue during the interference.

There are two main types of interference estoppel. First, a losing party is barred on the merits from seeking a claim that would have been anticipated or rendered obvious by the subject matter of the lost count. *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992); *Ex parte Tytgat*, 225 USPQ 907 (Bd. Pat. App. & Inter. 1985). Second, a losing party is procedurally barred from seeking from the examiner relief that could have been--but was not--sought in the interference. 37 CFR 41.127(a)(1); *Ex parte Kimura*, 55 USPQ2d 1537 (Bd. Pat. App. & Inter. 2000) (reissue applicant estopped to claim compound when patentability of that compound could have been put in issue in interference where opponent's application also described compound).

The examiner should consult with an Interference Practice Specialist (IPS) before allowing a claim to a losing party that was added or amended during post-interference examination.

Example 1

The applicant lost on priority for a count drawn to subject matter X. The Board's judgment automatically disposed of all of the applicant's claims corresponding to the count. The applicant files a continuing application with a claim to subject matter X. The claim must be rejected as estopped on the merits by the applicant's loss in the interference.

Example 2

Same facts as Example 1 except the applicant files a continuing application with a claim generic to subject matter X. Since the generic claim encompasses subject matter lost in the interference, the generic claim must be rejected as estopped on the merits by the loss in the interference.

Example 3

Same facts as Example 1 except the applicant files a continuing application with a claim to subject matter that would have been obvious in view of subject matter X. The claim must be rejected as estopped on the merits by the applicant's loss in the interference, but the examiner must demonstrate why the claim would have been obvious if subject matter X is assumed to be prior art.

Example 4

Same facts as Example 1 except the applicant files a continuing application with a claim identical to a claim that corresponded to the count of the interference. The applicant also files a showing of why the claim should not have corresponded to the count. The claim should be rejected as procedurally estopped. Whether the showing is adequate or not, it is too late. The time to make the showing was during the interference.

Example 5

Same facts as Example 4 except that during the interference the applicant timely requested, but was not permitted, to show the claim did not correspond to the count. The examiner may determine in light of the new showing whether the lost count would have anticipated or rendered obvious the subject matter of the claim. The procedural estoppel does not apply if, through no fault of the applicant, the Board prevented the applicant from seeking relief during the interference.

Example 6

The applicant's claim 1 was held unpatentable during the interference. The applicant could have moved, but did not move, to amend the claim. The applicant files a continuing application with an amended claim 1. If the subject matter of the amended claim would have been anticipated or obvious in view of a count of the interference, it must be rejected as procedurally estopped. Whether the amendment is sufficient to overcome the ground for unpatentability or not, the time to have amended the claim was during the interference.

Example 7

Same situation as Example 6 except the applicant did move to amend the claim, but the motion was denied. The result is the same as in Example 6. If the subject matter of the amended claim would have been anticipated or obvious in view of a count of the interference, it must be rejected as procedurally estopped. The applicant's lack of success on the motion does not prevent the estoppel from applying to the claim.

Example 8

Same facts as Example 6 except the applicant filed a late request during the interference to amend the claim to overcome the basis for unpatentability. The request was denied as untimely. The claim must be rejected as procedurally estopped. Even though the applicant was not permitted to amend the claim during the interference, the estoppel still applies because the applicant's inability to obtain relief in the interference was the result of the applicant's failure to seek timely relief.<

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2308.03(a) Losing Party [R-4]

A party is barred (estopped) from raising an issue if the party lost on the issue during the interference. A party may lose on one issue, yet not lose on a different issue.

Example

The applicant lost the interference on a count drawn to a compound, but the opponent lost on a count drawn to methods of using the compound. The applicant may continue to pursue claims to the method of using the compound, but not claims to the compound itself.<

>

2308.03(b) No Interference-in-Fact [R-4]

A judgment of no interference-in-fact means that no interference is needed to resolve priority between the parties. Neither party has lost the interference for the purpose of estoppel, 37 CFR 41.127(a)(1), even if one of the parties suggested the interference.

A judgment of no interference-in-fact bars any further interference between the same parties for claims to the same invention as the count of the interference.<

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2308.03(c) No Second Interference [R-4]

No second interference should occur between the same parties on patentably indistinct subject matter. If the Board of Patent Appeals and Interferences held that there is no interference-in-fact between the parties for the subject matter of the count, that holding may not be reopened in further examination. If a party that lost the earlier interference is again claiming the same invention as the count, the interfering claims should be rejected as estopped.<

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2309 National Aeronautics and Space Administration or Department of Energy [R-4]

Ownership of an invention made pursuant to a U.S. government contract may be vested in the contracting government agency. The Board of Patent Appeals and Interferences (Board) determines two such ownership contests using interference procedures: for the National Aeronautics and Space Administration (NASA), 42 U.S.C. 2457 (inventions having significant utility in aeronautical or space activity), and for the Department of Energy (DoE), 42 U.S.C. 2182 (inventions relating to special nuclear material or atomic energy).

An applicant with an application covered by these Acts must file a statement regarding the making or conception of the invention and any relation to a contract with NASA or DoE. See MPEP § 150 and § 151. The examiner should work in coordination with Licensing and Review and one of the Technology Centers Interference Practice Specialists in suggesting these cases to the Board. Although these cases are not interferences, the interference practices in this chapter generally apply to NASA and DoE ownership contests as well.<

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