INTERFERENCE TRIAL SECTION PRECEDENTIAL OPINION

The opinion in support of the decision being entered today is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The decision was entered on 24 February 1999.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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EUGENE S. GRIGGS, JR., AND JOANNE HAYES

Junior Party,
(Application 08/585,485)

v.

HOWARD L ROSE

Senior Party.
(Patent No. 5,492,077)

_____

Patent Interference No. 103,729

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Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE, and TORCZON, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON PRELIMINARY MOTION

This interference is before a merits panel for a decision on preliminary motions. Party Rose has filed a single preliminary motion under 37 C.F.R. § 1.633(a) for judgment against claims 19,

20, 27 and 28 of Griggs involved application on the ground that they are unpatentable to party Griggs.

FINDINGS OF FACT

1. This interference was declared on October 3, 1997, with a single count.

2. At the time of declaration of this interference, patent claims 1-17 of party Rose were designated as corresponding to the count.

3. At the time of declaration of this interference, application claims 1-6, 8, 9, 11, and 13-31 of junior party Griggs were designated as corresponding to the count.

4. Party Griggs application claims 19, 20, 27, and 28 are identical to party Rose patent claims 7, 8, 15 and 16.

5. Griggs application claims 19, 20, 27 and 28 are copied from claims 7, 8, 15 and 16 of Rose involved patent, subsequent to the filing of Griggs involved application.

6. On the Form 850 accompanying the notice declaring this interference, the examiner has indicated that claims 19, 20, and 27 and 28 of junior party Griggs s involved application are unpatentable.

7. In the examiner s initial interference memorandum or statement under 37 C.F.R. § 1.609(b), on page 11, the examiner stated:

> However, claims 19-20 and 27-28 [of junior party Griggs involved application] are unpatentable pending claims in the application 08/585,485, as there is no support for these claims in the specification, and therefore these claims would be rejected under 35 U.S.C. § 112, first paragraph.

8. Neither party has filed a preliminary motion under 37 C.F.R. § 1.633(c) to redefine this interference by adding or substituting a count, or by designating different claims as corresponding or not corresponding to the count.

9. Junior party Griggs has filed no preliminary motion.

10. Senior party Rose has filed a single preliminary motion under 37 C.F.R. § 1.633(a) alleging that application claims 19, 20, 27 and 28 of the junior party Griggs involved application are unpatentable to junior party Griggs under 35 U.S.C. § 112.

11. Both parties have filed a preliminary statement.

DISCUSSION

Party Rose s motion for judgment is**dismissed**.

It is axiomatic that an interference cannot be conducted for subject matter that is unpatentable. On this record, through the supervisory patent examiner whose signature appears on the examiner s initial interference memorandum and on the PTO Form

850, the Commissioner has already determined that party Griggs application claims 19, 20, and 27 and 28 are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification of Griggs involved application as filed.

Until that determination of the examiner is overcome in ex parte prosecution or otherwise reversed on appeal, those claims do not belong in this interference except to be carried forward to termination for further action in ex parte examination. In that sense, they are "dead claims" during the interference even if they have been designated as corresponding to the count. As such, they cannot form the battleground for or be the targets of patentability attacks which do not involve the other claims.

If an opposing party wishes to add to or otherwise further support the examiner s determination of unpatentability, a protest may be filed under 37 C.F.R. § 1.291. For that purpose, a motion for judgment under 37 C.F.R. § 1.633(a) is inappropriate. If party Griggs disagrees with the examiner s determination, the matter may be taken up with the examiner at the conclusion of this interference, if party Griggs prevails on priority. If party Griggs does not prevail on priority, then those claims are in any event unpatentable to party Griggs on priority grounds.

Party Griggs claims 19, 20, 27 and 28 have been determined by the examiner as unpatentable under 35 U.S.C. § 112, first paragraph, prior to the declaration of this interference. For the foregoing reasons, party Rose s motion for judgment on the ground that claims 19, 20, 27 and 28 of Griggs are unpatentable under 35 U.S.C. § 112 is not an appropriate motion in this interference and thus will not be considered.

A blank scheduling order for the testimony and briefing schedule is enclosed. The parties shall review the same and confer with each other to stipulate to an agreed schedule according to which the junior party s main brief will be filed no later than August 31, 1999.

It is

ORDERED that preliminary statements are now opened and the parties shall serve their preliminary statements to each other within seven (7) days of the date of this communication;

ORDERED that within twenty (20) days of this communication, the parties shall contact the administrative patent judge in a joint telephone conference to present the stipulated testimony and briefing schedule; and

FURTHER ORDERED that a copy of this opinion shall be published without identifying the parties or their counsel or their involved application and patent numbers.

Fred E. McKelvey, Senior Administrative Patent Judge	
Richard E. Schafer Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
Jameson Lee Administrative Patent Judge	
Richard Torczon Administrative Patent Judge	

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