

INTERFERENCE TRIAL SECTION PRECEDENTIAL OPINION

Section "1" of this opinion in support of the decision being entered today, discussing a miscellaneous motion under 37 CFR § 1.635 to add an additional patent to the interference under 37 CFR § 1.642, is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise not binding precedent. The decision was entered on November 1, 1999.

Paper No. 55

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JD

Junior Party
(Application 08/XXX,XXX)

v.

SH

Senior Party
(Patent No. 5,YYY,YYY)

Patent Interference No. 104,044

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

LEE, Administrative Patent Judge.

**Opinion in Support of
Decision on Preliminary
and Miscellaneous Motions**

Interference No. 104,044
AD v. SH

This interference was declared on February 26, 1999. Time Period 8 for taking action during the preliminary motion phase of the interference (Paper Nos. 38 and 45) expired on October 31, 1999. Preliminary and miscellaneous motions have been filed by the parties. Section 1 of this opinion concerns a miscellaneous motion under 37 CFR § 1.635 for a patent to be added to the interference under 37 CFR § 1.642, and is adopted as binding precedent of the Interference Trial Section. The entire opinion will be posted in due course at the Website address:
(<http://www.uspto.gov/web/offices/dcom/bpai/its/104044.pdf>).

In this opinion, the names of the parties and their corresponding application and patent numbers have been changed to preserve the confidentiality of the involved parties and their cases.

Senior party SH has filed the following three motions:

1. Miscellaneous motion 1 under 37 CFR § 1.635 to have junior party's Patent 5,XXX,XXX added to this interference under 37 CFR § 1.642;

DENIED

2. Preliminary motion 2 for judgment against claims 1 and 5-7 of junior party's Patent 5,XXX,XXX; and

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DISMISSED

3. Preliminary motion 3 to redefine the count by adopting claim 2 of Patent 5,XXX,XXX as the count.

DISMISSED

Junior party AD filed a single motion and a request for oral argument:

4. Miscellaneous motion 1 (Paper No. 49) to suppress the declaration of Mr. R.B. (SH's Exhibit 2005) which was relied on by the senior party in connection with senior party's miscellaneous motion 1 and preliminary motions 2 and 3.

DENIED

5. Request (Paper No. 50) for oral argument on senior party's miscellaneous motion 1 and senior party's preliminary motions 2 and 3, and junior party's miscellaneous motion 1.

DENIED

1.

Senior party patentee's motion filed under 37 CFR § 1.635 to add junior party's uninvolved patent to this interference under 37 CFR § 1.642

Senior party SH filed a miscellaneous motion (Paper No. 34) under 37 CFR § 1.635 to have an uninvolved junior party patent added to this interference under 37 CFR § 1.642. The patent

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sought to be added issued from the parent application of the junior party's involved application, names the same inventors as the junior party's involved application, and is assigned to the same real party in interest as is the junior party's involved application. At the time of declaration of this interference, the junior party was already accorded benefit of the earlier filing date of this parent application.

This motion is joined by the junior party. See the junior party's responsive submission in Paper No. 42.

As declared, this interference is between the junior party's involved application and the senior party's involved patent. The U.S. Patent and Trademark Office issues only a single patent for the same patentable invention. See 35 U.S.C. § 102(g).

The Patent Statute (35 U.S.C. § 135(a)) provides for interferences as follows:

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be.

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The purpose of having interferences is to assist an examiner in the examination of a patent application. When two applicants claim the same patentable invention, a patent is issued only to the applicant who is the first inventor. When an applicant claims the same patentable invention as a patent, the examiner cannot issue a patent to the applicant until interference proceedings are conducted and it is determined that the applicant is the first inventor vis-a-vis the patentee. An "interference" is defined in the rules. 37 CFR § 1.601(i). The definition permits an interference with two patents under limited circumstances. The following appears in the Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48419 (col. 2) (Dec. 12, 1984):

The definition of "interference" permits an interference between one or more applications and one or more patents. Thus, these new rules follow the policy of Wilson v. Yakel, 1876 Dec. Comm'r. Pat. 245 (Comm'r. Pat. 1876) and, to the extent inconsistent therewith, do not follow the policy announced in Touval v. Newcombe, 194 USPQ 509 (Comm'r. Pat. 1976). However, in view of the statutory requirement for the presence of at least one application in an interference, if an applicant were to concede priority or otherwise be terminated from an interference

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involving only one application and more than one patent, the interference would have to be terminated for lack of subject matter jurisdiction unless one or more of the patentees filed an application for reissue which could be added to the interference under § 1.633(h).

When a patentee loses the interference, the Commissioner may issue a patent to the applicant notwithstanding the prior issuance of a patent to the patentee. Section 135(a) states:

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 ***.

After an interference is concluded, the examiner knows which applicant among interfering applicants is entitled to a patent. Likewise, the examiner knows, when an applicant defeats a patentee, that a patent may be issued to an applicant.

Section 135(a) does not authorize the Commissioner to declare an interference between interfering patents. Compare 35 U.S.C. § 291, which authorizes a civil action to resolve priority between interfering patents.

Rule 642 (37 CFR § 1.642) authorizes an administrative patent judge to add an applicant or patent to an interference:

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

There may be a situation where an application and two patents (not owned by the applicant) claim the same patentable invention. If so, an examiner cannot issue a patent to the applicant until the applicant establishes that it is the first inventor vis-a-vis both patentees. If the interference was initially declared as an application versus patent interference, the second patent may be added to the interference. But, the interference is still one where the applicant seeks to establish priority vis-a-vis both patentees. If the applicant were to drop out of the interference, there no longer would be jurisdiction to resolve any priority dispute between the patents.

In the case before us, the interference was declared between the JD application and the SH patent. The interference was necessary for the examiner to know whether a patent may be issued to JD. An attempt is now made to add a JD patent, one issuing

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from the parent application of the involved JD application, to the interference. But, the board does not have jurisdiction under 35 U.S.C. § 135(a) to resolve priority as between the JD patent and the SH patent. Moreover, the uninvolved JD patent does not have to be added to the interference to determine priority between the involved JD application and the involved SH patent.

The additional patent of junior party JD sought to be added to this interference does not stand in the way of the issuance of anyone's application except perhaps JD's own involved application on the ground of double patenting. That, of course, does not present an interference situation since there is no adverse party. The case might be different if there were a second SH patent which stands in the way of issuing a patent based on the JD application. If it were necessary for JD to establish priority vis-a-vis two SH patents claiming the same patentable invention, addition of a second SH patent to the interference may well be justified.

Rule 642 gives the board discretion to add newly discovered patents to an interference. However, where the board would lack jurisdiction to resolve an interference between two patents, discretion should be exercised to deny addition of the patent to

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the interference. Since the board lacks subject matter jurisdiction to resolve priority between the additional JD patent sought to be added to this interference and the already involved SH patent, the joint request to add the additional JD patent to the interference is **denied**.

Contrary to the argument of SH, denial of the request to add the Davis patent is not inconsistent with Schultze v. Green, 136 F.3d 786, 45 USPQ2d 1769 (Fed. Cir. 1998). The issue in Schultze was one over which the board had jurisdiction. The same is not true in this case.

2.

Senior party SH's preliminary motion 2

This motion (Paper No. 32) is contingent upon the granting of senior party's miscellaneous motion 1 to add junior party's Patent 5,XXX,XXX to this interference. Because senior party's miscellaneous motion 1 has been denied and junior party JD's Patent 5,XXX,XXX has not been added to this interference, senior party SH's preliminary motion 2 for judgment against claims 1 and 5-7 of junior party's Patent 5,XXX,XXX, is **dismissed**.

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3.

Senior party SH's preliminary motion 3

This motion (Paper No. 33) is contingent upon the granting of senior party's miscellaneous motion 1. Because senior party's miscellaneous motion 1 has been denied and junior party's additional Patent 5,XXX,XXX has not been added to this interference, senior party SH's preliminary motion 3 to redefine the count as claim 2 of junior party's patent 5,XXX,XXX is **dismissed**.

4.

Junior party AD's miscellaneous motion 1

By this motion (Paper No. 49), junior party AD seeks to suppress the declaration of Mr. R.B. (senior party's Exhibit 2005). According to junior party AD, the declarant is a long-time employee of senior party's assignee and thus has a conflict of interest problem. According to the junior party AD, it is not clear whether the declarant has any experience in examining and construing patent claims. Further according to the junior party AD, the opinions of the declarant are merely conclusory and lack a substantial basis in the facts.

All of the objections of junior party AD relate to the credibility and persuasiveness of the declarant's testimony

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rather than technical admissibility. Furthermore, junior party AD has not demonstrated how it has complied with the requirement in ¶ No. 33 of the Notice Declaring Interference (Paper No. 1) that:

Any objection to the admissibility of evidence, including evidence filed with any motion, opposition or reply shall be filed within **five (5) working days** of service of the evidence to which the objection is made, including evidence presented in connection with a preliminary motion. (Emphasis in original.)

For the foregoing reasons, junior party's miscellaneous motion is **denied**.

5.

Junior party AD requests oral argument with regard to senior party's miscellaneous motion 1 and senior party's preliminary motions 2 and 3, and junior party's miscellaneous motion 1. Since we do not consider an oral argument to be necessary for deciding these motions, the request is **denied**.

6.

Priority Testimony

In light of the foregoing decision on miscellaneous and preliminary motions, the case will proceed to the priority

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testimony phase of the proceedings. The time periods for taking
priority testimony will be set in a separate paper in due course.

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