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 The opinion is otherwise not binding precedent. The decision was entered on 13 April 1999

Paper 23

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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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BARBARA A. WOLF and FLORENCE SYNDER,

Junior Party,
(Patent 5,449,519),

v.

DONALD A. TOMALIA, WILLIAM J. KRUPER, ROBERTA C. CHENG, IAN A. TOMLINSON, MICHAEL J. FAZIO, DAVID M. HEDSTRAND, LARRY R. WILSON and DONALD A. KAPLAN,

Senior Party
(Application 08/711,571).

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Patent Interference No. 104,274

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

McKELVEY, Senior Administrative Patent Judge.

JUDGMENT AGAINST WOLF AND SYNDER

Arguably this interference reveals a tension between the law and regulations applicable to interference proceedings and the law and regulations application to reexamination proceedings.

A. Findings of fact

The parties

1. The interference involves a junior party patentee and a senior party applicant.

2. The junior party applicant is Barbara A. Wolf and Florence Synder (**Wolf**).

3. Wolf is involved in the interference on the basis of U.S. Patent 5,449,519, issued September 12, 1995, which matured from application 08/228,098, filed August 9, 1994 (hereinafter **Wolf patent**).

4. The real junior party in interest is Revlon Consumer Products Corporation.

5. The senior party patentee is Donald A. Tomalia, William J. Kruper, Roberta C. Cheng, Ian A. Tomlinson, Michael J. Fazio, David M. Hedstrand, Larry R. Wilson, Donald A. Kaplan, (**Tomalia**).

6. Tomalia is involved in this interference on the basis of application 08/711,571, filed September 10, 1996 (hereinafter **Tomalia application**).

7. Tomalia has been accorded the benefit for the purpose of priority of:

a. Application 08/036,644, filed March 24, 1993, and

b. Application 07/654,851, filed February 13, 1991, now U.S. Patent 5,338,532, issued August 16, 1994 (hereinafter **Tomalia patent**).

8. The real senior party in interest is The Dow Chemical Co.

The interference

9. For the purpose of resolving the outcome of the interference it is not important to understand the subject matter of the sole count (Count 1) and/or the claims.

10. The claims of the parties are:

Wolf: 1-20

Tomalia: 27, 62, 103 and 104

11. The claims of the parties which have been designated as corresponding to Count 1 are:

Wolf: 1-7 and 11-12

Tomalia: 27, 62, 103 and 104

12. Since Wolf patent claims 1-7 and 11-12 have been designated as corresponding to the count (NOTICE DECLARING INTERFERENCE (Paper 1, page 42)), those claims are "involved" in the interference within the meaning of 35 U.S.C. § 135(a).

13. The claims of the parties which have been designated as not corresponding to Count 1 are:

Wolf: 8-10 and 13-20

Tomalia: None

14. Since Wolf patent claims 8-10 and 13-20 have been designated as not corresponding to the count (NOTICE DECLARING INTERFERENCE (Paper 1, page 42)), those claims are not "involved" in the interference.

The Wolf reexamination proceeding

15. The interference was declared on December 16, 1998.

16. On October 1, 1998, prior to the time the interference was declared, Wolf had filed a request for reexamination. Reexamination Control Number 90/005,134.

17. There have been two telephone conference calls in this interference. See ORDER TO SHOW CAUSE (Paper 19).

18. It was noted during the second conference call, and the reexamination file will reveal, that when Wolf filed the request for reexamination, no amendment was proposed to be made to Wolf patent claims 1-7 and 11-12.[1]

19. In a patent owner's statement timely filed in the reexamination, Wolf now has requested that Wolf patent claims 1-7 and 11-12 be amended (see **Exhibit 1**, pages 1-3 attached to the ORDER TO SHOW CAUSE (Paper 19)).

20. As readily conceded during the conference call, Wolf does not seek a reexamined patent containing Wolf patent claims 1-7 or 11-12.

[1] Wolf did amend Wolf patent claims 16 and 18--neither of which has been designated as corresponding to Count 1.

21. In the patent owner's statement, Wolf also suggests that reexamination may be appropriate in view of the Tomalia patent.

22. The reexamination is pending before the Primary Examiner.

Order to show cause

23. As the record will reveal, and as noted above, there have been two telephone conference calls during the pendency of the interference.

24. Upon consideration of the discussion during those conference calls, it became apparent that Wolf had no objection to entry of a judgment on priority against it as to the Wolf patent claims designated as corresponding to Count 1.

25. Tomalia, on the other hand, maintained that a judgment should not be entered. According to Tomalia, whether the amended claims in the Wolf reexamination should be designated to correspond to Count 1 is an issue which should be resolved inter partes in this interference.

26. Since the parties were unable to come to an agreement as to a judgment, an ORDER TO SHOW CAUSE (Paper 19) was entered in which a proposed judgment was set out.

27. Tomalia has been given an opportunity to present its views with respect to the proposed judgment. See TOMALIA RESPONSE TO ORDER TO SHOW CAUSE (Paper 20).

The amended claims in the Wolf reexamination

28. Wolf maintained during the telephone conference calls, in particular the second telephone conference call, that the Wolf claims, as amended in the reexamination proceedings, are patentably distinct from the subject matter of Count 1, as well as the Wolf patent claims designated as corresponding to Count 1.

29. Tomalia, on the other hand, maintains that the Wolf amended reexamination claims are directed to the same patentable invention as Count 1.

30. Wolf does not maintain that the Tomalia patent is not prior art. Hence, for any reexamination certificate to issue, the Primary Examiner will have to be of the opinion that claims in the reexamination proceeding are patentable when considered in light of the Tomalia patent.

Tomalia's response to the ORDER TO SHOW CAUSE

31. Tomalia has timely responded to the ORDER TO SHOW CAUSE. See TOMALIA RESPONSE TO ORDER TO SHOW CAUSE (Paper 20).

32. Tomalia takes the position that this interference should be stayed pending outcome of the reexamination proceeding.

33. According to Tomalia, if a reexamination certificate issues, then Tomalia should have an opportunity to file a preliminary motion to have any surviving reexamined claims designated as corresponding to Count 1.

B. Opinion

1. Interference proceedings

An interference is an inter partes proceeding.

An interference is declared when the Commissioner is of the "opinion" that claims in a pending application "interfere" with claims in another pending application or a patent. 35 U.S.C. § 135(a). Ewing v. U.S. ex rel. Fowler Car Co., 244 U.S. 1, 11 (1917) (it is the Commissioner "who is to judge (be of opinion) whether an application will interfere with a pending one").

Claims "interfere," and there is an interference-in-fact, when they are directed to the same patentable invention. 37 CFR §§ 1.601(j) and 1.601(n); Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977) (a method of using cyclopentadiene held to be the same patentable invention as a method using butadiene, isoprene, dimethylbutadiene, piperylene, anthracene, perylene, furan and sorbic acid).

An applicant may ask that an interference be declared between its application and an unexpired patent. 37 CFR § 1.607. The applicant may also ask for declaration between its application and a patent which has been reexamined.

The Commissioner has delegated authority to the Primary Examiner, in the first instance, and the Administrative Patent Judge, in the second instance, to determine whether an interference exists. In other words, the Commissioner exercises his "opinion" authority within the meaning of 35 U.S.C. § 135(a) through the Primary Examiners and the Administrative Patent Judges. An Administrative Patent Judge does not in the first instance determine that an interference exists. Rather, the Administrative Patent Judge acts (37 CFR § 1.610) on

recommendations (37 CFR § 1.609) forwarded to the board by the Primary Examiner after the Primary Examiner becomes of the opinion that there is interfering subject matter (37 CFR § 1.603). If the recommendations by the Primary Examiner are found by the Administrative Patent Judge to comply with the rules, the latter declares an interference (37 CFR § 1.610). On the other hand, if the recommendations are found wanting, the Administrative Patent Judge issues a "missing parts" report in effect remanding the matter to the Primary Examiner for further action consistent with the "missing parts" report.

Once an interference is declared, a party may file a preliminary motion to have an opponent's claim designated as corresponding to the count. 37 CFR § 1.633(c)(3). It is also possible for the Administrative Patent Judge to add another application and/or patent to the interference. 37 CFR § 1.642.

2. Reexamination proceedings

The Congress has authorized a patent owner or a third party to file a request for reexamination of an issued patent. 35 U.S.C. § 302.

Third-party participation in a reexamination is strictly limited. Thus, a third-party may file a request for reexamination (35 U.S.C. § 302; 37 CFR § 1.510(a)) asking the Commissioner (i.e., the Primary Examiner) to determine that a substantial new question of patentability exists.

If the Primary Examiner determines that there is no substantial new question of patentability, the third-party may

petition administratively to the Commissioner for review. 37 CFR § 1.515(c). However, there is no judicial review of a decision of the Commissioner holding that there is not substantial new question of patentability. 35 U.S.C. § 303(c).

If the Primary Examiner determines that a substantial new question of patentability exists, then reexamination proceeds ex parte with no further input by the third-party. 35 U.S.C. § 305; 37 CFR § 1.550(e)(1). A third-party cannot seek judicial review of a decision to issue a reexamination certificate (35 U.S.C. § 307(a)). Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office, 882 F.2d 1570, 11 USPQ2d 1866 (Fed. Cir. 1989) (third-party requester not entitled to judicial review of decision favorable to patent owner despite assertion that PTO did not properly carry on reexamination proceeding).

3. Discussion

Under the facts of this case, there is an obvious interplay between an ongoing interference and an ongoing reexamination proceeding involving a patent in the interference. But, one fact which is not in dispute in this interference is that Wolf agrees that a judgment on the question of priority may be entered against it as to Wolf patent claims 1-7 and 11-12. As a result of an adverse judgment with respect to those claims, the estoppel provisions of 37 CFR § 1.658(c) operate against Wolf. Hence, Wolf readily concedes that any claims which survive reexamination must be directed to subject matter which is patentable over Count 1. And, the more practical reason that those claims must

be patentable over Count 1 is that the Tomalia patent is prior art. Therefore, any claims surviving reexamination, at least in the opinion of the Primary Examiner, must be patentable over the Tomalia patent. Otherwise, a reexamination certificate will issue which simply cancels all relevant claims from the Wolf patent.

The reexamination statute provides that "[a]ny person at any time may file a request for reexamination ***." 35 U.S.C. § 302. Any person includes Wolf as applied to the Wolf patent. Accordingly, in filing a request for reexamination, Wolf has not engaged in activity precluded by law. What Tomalia seeks, in effect, is to be able to "protest" inter partes through this interference proceeding any decision of the Primary Examiner to authorize issuance of a reexamination certificate. But, reexamination proceedings are conducted ex parte. Moreover, we are unaware of any provision of law which would authorize incorporation of a reexamination proceeding into this particular interference, because to do so would (1) probably run afoul of the "special dispatch" provisions of the reexamination statute given the lengthy nature of interference proceedings and (2) shift responsibility for conducting the reexamination away from the Primary Examiner to the board.

Tomalia is not without a remedy. If a reexamination certificate issues, then Tomalia can file a request before the Primary Examiner seeking to provoke an interference between the Tomalia application and the reexamined Wolf patent. Any request

would be considered on its merits by the Primary Examiner, because Tomalia is not a party to the reexamination proceeding. Thus, Tomalia could base a request for an interference on arguments and evidence which might not have been considered in the reexamination proceeding. If the Primary Examiner be of the opinion that there is interfering subject matter between the Tomalia application and the reexamined Wolf patent, another interference can be declared. However, whether an interference exists between any reexamined Wolf patent claim and any Tomalia application claim is manifestly premature, because at this point it is not known if any claim will survive reexamination.

Tomalia might argue, "but what if my application issues as a patent before reexamination proceedings are concluded, now what?" It is true that the Commissioner does not have authority to declare an interference solely between patents. Apart from the fact that Tomalia might have relief in a patent-patent interference civil action under 35 U.S.C. § 291, there would be nothing extra from preventing Tomalia from filing an application to reissue its patent and requesting an interference between a Tomalia reissue application and a reexamined Wolf patent.

On balance, the better course is to terminate this interference with entry of a judgment against Wolf--a judgment to which Wolf has no objection. Whether another interference might be declared is not ripe for determination at this point. There may not even be a reexamined Wolf patent. On the other hand, if there is, then based on any Wolf claims which survive

reexamination, an intelligent decision can be made as to whether another interference is appropriate. While not wishing to express any views on the merits, it will observed that if the Primary Examiner determines that any reexamined Wolf patent claim is patentable over the Tomalia patent, then at least prima facie it is unlikely that there be "interfering" subject matter. After all, if reexamined Wolf claims are patentable over the Tomalia patent, it is difficult to image how there might be interfering subject matter. However unlikely, we wish to make clear that we are not foreclosing that possibility.

The alternative suggested by Tomalia, at least indirectly, allows a third-party to seek "review" inter partes within the Patent and Trademark Office of what is supposed to be an ex parte reexamination proceeding. On the other hand as noted earlier, Tomalia is not without further available administrative remedies if a reexamined Wolf patent issues.

Lastly, we would note that reexamination proceedings are carried out with "special dispatch" (35 U.S.C. § 305). Ethicon, Inc. v. Quigg, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Accordingly, a possibility exists that any stay here might be brief. On the other hand, even proceedings carried out with special dispatch can take time if the patent owner finds it necessary to take appeals to the board and/or our reviewing courts. Apart from special dispatch, there is no reason on this record for delaying the day when a patent will issue to Tomalia based on the Tomalia application involved in the interference.

Compare Pritchard v. Loughlin, 361 F.2d 483, 486, 149 USPQ 841, 844 (CCPA 1966) (involving a reissue application).

For the reasons given, we will exercise discretion to enter a judgment against Tomalia without prejudice to further interference proceedings in the event the Commissioner, through the Primary Examiner, be so advised.

C. Order

Upon consideration of the record, and for the reasons given, it is

ORDERED that judgment on priority as to Count 1, the sole count in the interference, is awarded against junior party BARBARA A. WOLF and FLORENCE SYNDER.

FURTHER ORDERED that judgment on priority as to Count 1 is awarded in favor of senior party DONALD A. TOMALIA, WILLIAM J. KRUPER, ROBERTA C. CHENG, IAN A. TOMLINSON, MICHAEL J. FAZIO, DAVID M. HEDSTRAND, LARRY R. WILSON and DONALD A. KAPLAN.

FURTHER ORDERED that, on the record before the Board of Patent Appeals and Interferences, senior party DONALD A. TOMALIA, WILLIAM J. KRUPER, ROBERTA C. CHENG, IAN A. TOMLINSON, MICHAEL J. FAZIO, DAVID M. HEDSTRAND, LARRY R. WILSON and DONALD A. KAPLAN is entitled to a patent containing claims 27, 62, 103 and 104 (corresponding to Count 1) of application 08/711,571, filed September 10, 1996.

FURTHER ORDERED that junior party BARBARA A. WOLF and FLORENCE SYNDER is not entitled to a patent containing claims 1-7 and 11-12 (corresponding to Count 1) of application/patent

U.S. Patent 5,449,519, issued September 12, 1995, based on application 08/228,098, filed August 9, 1994.

FURTHER ORDERED that entry of this JUDGMENT AGAINST WOLF AND SYNDER shall be without prejudice to Tomalia requesting another interference at some future time in the event a reexamination certificate in connection with the Wolf patent is issued and Tomalia can convince the Primary Examiner that any reexamined Wolf patent contains claims which are directed to the same patentable invention as that claimed in the Tomalia application involved in the interference.

FURTHER ORDERED that if there is a settlement agreement, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

FRED E. McKELVEY, Senior Administrative Patent Judge	)
RICHARD E. SCHAFER Administrative Patent Judge	) BOARD OF PATENT
JAMESON LEE Administrative Patent Judge	) APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	)

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