The opinion in support of the decision being
entered today is not binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JOHN ONDEYKA, OTTO HENSENS and JERROLD LIESCH
Junior Party,
(Patent 5,091,389),

v.

PETER R. SHELLEY and RHONA BANKS
Senior Party,
(Application 08/311,290).

Patent Interference No. 104,709

Before: SCHAFER, TORCZON and TIERNEY, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

ORDER TERMINATING INTERFERENCE

A. Background

This interference was declared on June 1, 2001 between a Shelley application and an Ondeyka patent. In their list of intended preliminary motions, Ondeyka has drawn the Board s attention to the following highly material information:

> Ondeyka notes that their patent (U.S. Patent No. 5,091,389) expired on February 25, 1996, due to non-payment of maintenance fees.

(Ondeyka List of Intended Preliminary Motions, Paper No. 13, p. 3 and 35 U.S.C. § 41(b)). At the time the interference was declared, the Board was unaware that Ondeyka s patent had expired.

B. Discussion

The patent interference statute, 35 U.S.C. § 135(a) does not authorize an interference between an ***expired*** patent and a pending application. Specifically, 35 U.S.C. § 135(a) provides in part:

> 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 applicants and patentee, as the case may be.

(Emphasis added). As the Ondeyka patent had expired as of the date the interference was declared, the Board lacks subject matter jurisdiction over the interference. *Petrie v. Welsh,* 21 USPQ2d 2012 (BPAI 1991)*; Waterman v. Birbaum*, 53 USPQ 2024 (BPAI (ITS) 2000).

While recognizing that its patent has expired, Ondeyka seeks to file the following preliminary motions: (1) One or more motions under 37 CFR § 1.633(a) on the grounds that Shelly s claims are unpatentable; (2) a motion under 37 CFR § 1.633(g) attacking the priority benefit accorded to Shelly s claims; and (3) a motion under 37 CFR § 1.635 authorizing full third-party participation by Ondeyka in the examination of Shelley s U.S. application or any continuing application thereof. (Paper No. 13, pages 2-3). Moreover, Ondeyka states:

In declining to pay the required maintenance fee for U.S. Patent No. 5,091,389, Ondeyka

> affirmatively dedicated the claims of their patent to the public. Ondeyka has a continuing interest in ensuring that this subject matter is fully accessible to all members of the public, including Ondeyka. Due to the unique circumstances presented by this case there exists an extraordinary situation which requires a waiver of the provisions of 37 C.F.R. § 1.291 to the extent that they would preclude full participation by Ondeyka in any protest in the Shelley application and further to the extent that Ondeyka should be permitted to fully participate in proceedings before the Primary Examiner and before the Board, if an appeal is taken.

(Paper No. 13, p. 3).

Ondeyka s request to file motions attacking Shelley s accorded priority benefit and patentability is ***denied***. Specifically, the Board lacks subject matter jurisdiction to resolve priority of invention or patentability in this interference. Moreover, as to Ondeyka s request to fully participate in the prosecution of Shelley s application:

> It is well-settled that an individual does not have a right to intervene in the prosecution of a particular application to prevent issuance by the Patent and Trademark Office of a patent sought by another. *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1692 (Fed. Cir. 1991); *Godtfredsen v. Banner*, 503 F. Supp. 642, 646, 207 USPQ 202, 207 (D.D.C. 1980) (individual lacks standing to challenge a decision by PTO to issue a patent to another).

Petrie, 21 USPQ2d at 2013. Our decision, however, is without prejudice to Ondeyka s rights under the protest provisions of 37 CFR § 1.291.

In light of our decision today, the conference call set for 10:00 am on July 25, 2001 is cancelled.

C. Order

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

ORDERED that the interference is **TERMINATED**.

FURTHER ORDERED that a copy of this Order Terminating Interference shall be placed and given a paper number in the file of Ondeyka, U.S. Patent No. 5,091,389 and Shelley, U.S. Patent Application 08/311,290.

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