Chapter 1100 Interference

The interference practice is based on 35 U. S. C. 135 here set forth:

35 U. S. C. 135. Interferences. 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, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner 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 from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Rule 201 sets forth the definition of an interference and is here reproduced.

Rule 201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent or for reissue of different parties when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

1101 Preliminaries to an Interference

An interference is often an expensive and time-consuming proceeding. Yet, it is necessary to determine priority when two applicants before the Office are claiming the same subject matter and their filing dates are close enough together that there is a reasonable possibility that the first applicant to file is not the first inventor.

The greatest care must therefore be exercised both in the search for interfering applications and in the determination of the question as to whether an interference should be declared. Also the claims in recently issued patents, especially those used as references against the application claims, should be considered for possible interference.

The question of the propriety of initiating an interference in any given case is affected by so many factors that a discussion of them here is impracticable. Some circumstances which render an interference unnecessary are hereinafter noted, but each instance must be carefully considered if serious errors are to be avoided.

In determining whether an interference exists a claim should be given the broadest interpretation which it reasonably will support, bearing in mind the following general principles:

(a) The interpretation should not be strained.

(b) Express limitations in the claim should not be ignored nor should limitations be read therein to meet the exigencies of a particular situation.

(c) The doctrine of equivalents which is applicable in questions of patentability is not applicable in interferences, i. e., no application should be placed in interference unless it discloses clearly the structure called for by the count and the fact that it discloses equivalent structure is no ground for placing it in interference.

(d) Before a claim (unless it is a patented claim) is made the count of an interference it should be allowable and in good form. No pending claim which is indefinite, ambiguous or otherwise defective should be made the count of an interference.

(e) A claim copied from a patent, if ambiguous, should be interpreted in the light of the patent in which it originated.

(f) If doubts exist as to whether there is an interference, an interference should not be declared.

1101.01 Between Applications see change 5-19

Where two or more applications are found to be claiming the same patentable invention they may be put in interference, dependent on the status of the respective cases and the difference between their filing dates. Before taking any steps looking to the formation of an interference, it is very essential that the Examiner make certain that each of the prospective parties is claiming the same patentable invention and that the claims that are to constitute the counts of the interference are clearly readable upon the disclosure of each party and allowable in each application. Failure to observe this practice results in time-consuming and burdensome proceedings to dissolve or redeclare the interference and, if the interference be not dissolved or redeclared, very serious difficulties may be created in connection with the trial of the cause and the award of priority.

It is to be noted that while the claims of two or more applicants may vary in scope and in immaterial details, yet if directed to the same invention, an interference exists. But mere disclosure by an applicant of an invention which he is not claiming does not afford a ground for suggesting to that applicant claims for the said invention copied from another application that is claiming the invention. The intention of the parties to claim the same patentable invention, as expressed in the summary of the invention or elsewhere in the disclosure, or in the claims, is an essential in every instance.

When the subject matter found to be allowable in one application is disclosed and claimed in another application, but the claims therein to such subject matter are either nonelected or subject to election, the question of interference should be considered. The requirement of Rule 201 (b) that the conflicting applications shall contain claims for substantially the same invention which are allowable in each application should be interpreted as meaning generally that the conflicting claimed subject matter is sufficiently supported in each application and is patentable to each applicant over the prior art. The statutory requirement of first inventorship is of transcendent importance and every effort should be made to avoid the improvident issuance of a patent when there is an adverse claimant.

Following are illustrative situations where the examiner should take action toward instituting interference, including correspondence under Rule 202, if necessary:

A. Application filed with claims to divisible inventions I and II. Before action requiring restriction is made, examiner discovers another case having allowed claims to invention I.

The situation is not altered by the fact that a requirement for restriction had actually been made but had not been responded to. Nor is the situation materially different if an election of noninterfering subject matter had been made without traverse but no action given on the merits of the elected invention.

B. Application filed with claims to divisible inventions I and II and in response to a requirement for restriction, applicant traverses the same and elects invention I. Examiner gives an action on the merits of I. Examiner subsequently finds an application to another containing allowed claims to invention II and which is ready for issue.

The situation is not altered by the fact that the election is made without traverse and the nonelected claims possibly cancelled.

C. Application filed with generic claims and claimed species a, b, c, d, and e. Generic claims rejected and election of a single species required. Applicant elects species a but continues to urge allowability of generic claims. Examiner finds another application claiming species b which is ready for issue.

The allowability of generic claims in the first case is not a condition precedent to setting up interference.

D. Application filed with generic claims and claims to five species and other species disclosed but not specifically claimed. Examiner finds another application the disclosure and claims of which

are restricted to one of the unclaimed species and have been found allowable.

The prosecution of generic claims is taken as indicative of an intention to cover all species disclosed which come under the generic claim.

In all the above situations, the applicant has shown an intention to claim the subject matter which is actually being claimed in another application. These are to be distinguished from situations where a distinct invention is claimed in one application but merely disclosed in another application without evidence of an intent to claim the same. The question of interference should not be considered in the latter instance. However, if the application disclosing but not claiming the invention is senior, and the junior application is ready for issue, the Primary Examiner should discuss the matter with the Supervisory Examiner to determine the action to be taken. (Memorandum of August 5, 1949, Revised.)

1101.01 (a) In Different Divisions

An interference between applications assigned to different divisions is declared by the division where the controlling interfering claim would be classified. After correspondence under Rule 202, if necessary, appropriate transfer of one of the applications is made. After termination of the interference, further transfer may be necessary depending upon the outcome.

1101.01 (b) Common Ownership

Where applications by different inventors but of common ownership claim the same subject matter or subject matter that is not patentably different:—

I. Interference therebetween is normally not instituted since there is no conflict of interest. Elimination of conflicting claims from all except one case should usually be required, Rule 78 (b). The common assignee must determine the application in which the conflicting claims are properly placed. Treatment by rejection is set forth in Section 305.02 (a).

II. Where an interference with a third party is found to exist, the owner should be required to elect which one of the applications shall be placed in interference.

1101.01 (c) The Interference Search

The search for interfering applications which is always made when preparing an application for allowance, but may be made at any time after a case has been found to contain allowable subject matter, must not be limited to the class or subclass in which it is classified, but must be extended to all classes in or out of the Examiner's division which it has been necessary to search in the examination of the application. (Notice of August 2, 1909, Revised.)

Moreover, the possibility of the existence of interfering applications should be kept in mind throughout the prosecution of each application and every indication of the existence of interfering matter noted in such a way that it will not be overlooked, should it be decided not to declare the interference forthwith.

In connection with the subject of interference search, it is to be noted that, where the Examiner at any time finds that two or more applications are claiming the same invention and he does not deem it expedient to institute interference proceedings at that time, he should make a record of the possible interference as, on the face of the file wrapper in the space reserved for class and subclass designation. His notations, however, if made on the file wrapper or drawings, must not be such as to give any hint to the applicants, who may inspect their own applications at any time, of the date or identity of a supposedly interfering application. Serial numbers or filing dates of conflicting applications must never be placed upon drawings or file wrappers. The examining division should keep a book of "Prospective Interferences" containing complete data concerning possible interferences and the page and line of this book should be referred to on the respective file wrappers or drawings. For future reference, this book may include notes as to why prospective interferences were not declared.

In determining whether an interference exists, the Examiner in charge of the division must personally review and decide the question. The Law Examiner may, however, be consulted to obtain his advice and he will have charge of such correspondence with junior parties as is provided for in Rule 202 (Order 2687, Revised).

1101.01 (d) Correspondence Under Rule 202

After the Primary Examiner has determined that a conflict exists in the claimed patentable subject matter of two or more applications, he considers the question of correspondence under Rule 202. The rule follows:

Rule 202. Preparation for interference between applications; preliminary inquiry of junior applicant. In order to ascertain whether any question of priority arises between applications which appear to interfere and are otherwise ready to be prepared for interference, any junior applicant may be called upon

to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration for the purpose of establishing priority of invention. The statement filed in compliance with this section will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than thirty days, or if the earliest date alleged is subsequent to the filing date of the senior party, the interference ordinarily will not be declared.

Under Rule 202 the Commissioner may require an applicant junior to another applicant "to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration." Such affidavit does not become a part of the record in the application, nor does any correspondence relative thereto. The affidavit, however, will become a part of the interference record, if an interference is formed.

1101.01 (e) Correspondence Under Rule 202, How Conducted

The Rule 202 correspondence is conducted by the Law Examiner on receipt from the Primary Examiner of notice of the proposed interference set forth in a letter modeled after the form found under "Letter Forms Used in Interferences" (1112.01).

This letter and a carbon copy thereof, both signed by the Primary Examiner, together with the files are forwarded to the Law Examiner. The files, however, are not retained by the Law Examiner, but are returned to the examining division where they are held separate from other files while the correspondence is being conducted.

In preparing cases for submission to the Law Examiner and in subsequent treatment of the cases involved attention should be given to the following points:

(1) The name of the Examiner to be called for a conference should be given as indicated on the form.

(2) It should be stated which of the applications, if any, is ready for allowance.

(3) If an application is a division, continuation or continuation-in-part of an earlier one (and the parent application discloses the conflicting subject matter), this fact should be stated.

(4) If two or more applications are owned by the same assignee, or are presented by the same attorney, it should be so stated.

(5) In the suggestion of counts only claims which are necessary to determine the question of priority should be selected; claims which are not patentable over the proposed claims should be omitted. Claims are not patentably distinct unless they differ sufficiently to sustain separate patents.

(6) Any other points which have a bearing on the declaration of the interference should be stated.

(7) Amendments or other papers filed in cases held by the Law Examiner bearing on the question of interference should be promptly forwarded to him.

(8) Letters of submission should be in duplicate. (Extract from Notice of April 18, 1919, Revised.)

1101.01 (f) Correspondence Under Rule 202, Not an Action on the Case

Correspondence under Rule 202 is not an action on the case. Hence, it cannot serve to extend the statutory period if the case is awaiting action by the applicant.

1101.01 (g) Correspondence Under Rule 202, When and When Not Needed

Ordinarily where there is a difference between the dates of applications of the senior and junior parties of about six months to two years the Law Examiner will require from the junior party a verified statement relating to his date of conception. (Extract from Notice of April 18, 1919.)

The following cases need not be submitted to the Law Examiner:

(1) Where any junior applicant may be entitled to a foreign filing date at least as early as the senior applicant's filing date in this country.

(2) Where any junior applicant is entitled to a filing date in this country which is within six months of the senior applicant's filing date. (Order 2750, Revised.)

In general it may be stated that this correspondence is confined to those cases having a difference in effective U. S. filing dates within the range of six months to two years. By "effective" filing date is meant the filing date to which the application is entitled, i. e., its own filing date if it be an "original" application, or the filing date of a parent application, as in the case of a "divisional" or "continuation" or "continuation-in-part" application (and the parent application discloses the conflicting subject matter).

Exceptions to the above general rule are the following: (a) If the invention is of simple character, thereby requiring but a short time to be perfected, correspondence is usually not had if the senior party's case is ready for issue, and the difference in dates exceeds one year. (b) Where the senior party's case is not ready for issue, or where the junior party's claims would form the counts of the interference, or where the embodiments of the invention in the two applications are substantially identical, correspondence is had even though the difference in dates exceeds two years.

In other cases where the senior party's application is ready for issue and the difference in effective filing dates exceeds two years, or if it be a simple case, one year, it is assumed that there is no question of priority involved and the senior application is forthwith sent to issue.

In summary, correspondence under Rule 202 is not had in the following cases:

(1) Where the effective date of the senior party is less than six months prior to the date to which another case is entitled, as by its own filing date or that of a prior application of which the instant case is a division, continuation, or continuation-in-part (conflicting subject matter is disclosed in parent application), including situations where there are three or more applications claiming the same invention and the oldest two are less than six months apart in effective filing dates.

(2) Where any junior applicant has an available foreign filing date at least as early as the U. S. filing date of the senior applicant.

(3) Where there is a difference in effective U. S. filing dates of more than two years (or in a simple case, one year), and the application of the senior party is ready for issue unless (a) the claims of the junior party would constitute the counts of the interference or (b) the disclosures of the claimed invention in the two cases are substantially identical.

(4) Where one of the parties to the prospective interference is a patentee. If the application is junior to the effective date of the patent, an affidavit under Rule 204 is required.

Where the case falls into category (1) or (2) an interference is forthwith formed and this is true also as to (4) unless a Rule 204 affidavit is required. If the case falls in the principal portion of category (3), the senior application is passed to issue, it being assumed that there is no question of priority to be determined; but if the senior party's application is not ready for issue or if conditions (a) or (b) of category (3) obtains, then correspondence under Rule 202 is conducted.

1101.01 (h) Correspondence Under Rule 202, Approval or Disapproval by Law Examiner

The Law Examiner will stamp the letters from the Examiner either "Approved" or "Disapproved," as the case may require, and return the carbon copy to the examining division.

If the earliest date alleged by the junior party under Rule 202 fails to antedate the filing date of the senior applicant, the Law Examiner disapproves the proposed interference and the Examiner then follows the procedure outlined in the next section. When a "Disapproved" letter is returned to the examining division it is accompanied by a note to be attached to the senior party's case requesting the Issue and Gazette Branch to return the case to the Law Examiner after the notice of allowance is sent.

Where the junior party, as required by Rule 202, states under oath a date of a fact or an act, susceptible of proof, which would establish that he had conceived the claimed invention prior to the filing date of the senior applicant, the Law Examiner approves the Examiner's proposal to suggest claims and the Examiner may then proceed with the preparation of the cases for interference.

When an interference is to be declared involving applications which had previously been submitted to the Law Examiner for correspondence under Rule 202, before forwarding the files to the Interference Division, the Examiner should ascertain from the Law Examiner if any such statement has been filed and, if so, seal this statement and forward it with the files to the Interference Division. (Order 3380, Revised.)

The oath under Rule 202 becomes a part of the interference file in contradistinction to the application file as in the case of an affidavit under Rule 131 or Rule 204 but, like them, is subject to inspection on the opening of the preliminary statements.

When the formation of an interference between two parties is necessary, all other applicants claiming the contested invention should be placed in the interference irrespective of their filing dates or of any dates alleged under Rule 202, provided there is no statutory bar to the allowance of the claims in the other applications.

1101.01 (i) Correspondence Under Rule 202, Failure of Junior Party To Overcome Filing Date of Senior Party

If the earliest date alleged by a junior party in his affidavit under Rule 202 fails to overcome the filing date of the senior party and if the interference is not to be declared (note that an interference might be necessary for other reasons), the senior party's application will be sent to issue as speedily as possible and the conflicting claims of the junior applicant will be rejected on the patent when granted. A shortened period for response may be set in the senior party's case. (See 710.02 (b).)

After the senior applicant's application has been passed for issue, the application is sent to the Law Examiner by the Issue and Gazette Branch in accordance with a note to that effect attached to the application and he writes a letter to that applicant urging him to promptly pay the final fee, this being done to the end that prosecution of the junior application may be promptly resumed, the senior party's disclosure then being available as prior art in treating the claims of the junior application. The examiner may make a supplemental action on the junior applicant's case when the senior applicant's patent issues.

In the meantime the junior party's application will be treated in accordance with the following:

Where a junior party after correspondence under Rule 202 fails to overcome the filing date of the senior party, the Examiner when he reaches the case for action will write a letter substantially as follows:

> In view of Rule 202, action on this case (or on claims 1, 2, 4, etc., indicating the conflicting claims and claims not patentable over the senior party's case) is suspended for six months to determine whether an interference will be declared (unless these claims are canceled). At the end of the six months applicant should call up the case for action.

The letter should include the usual action on the remaining claims in the case, indicating what, if any, claims are allowable. (Order 2913, Revised.)

If the Examiner's letter is a suspension of action on the entire case, the Examiner should also note the case on his calendar at the date marking the end of the six months' period, and, if applicant does not call up the case, the Examiner should do so unless the senior party's patent will soon issue, since there is no period for response running against the applicant and the case should not be permitted to remain indefinitely among the files in the examining division.

It sometimes happens that the application of the junior party is not amended and nothing else occurs to bring it to the attention of the Examiner, and that the patent to the senior party issues and is not promptly cited to the junior party. This works an unnecessary hardship upon the junior applicant and the Office should make every effort to give him action in view of this reference at the earliest possible date. To this end, the Examiner should keep informed as to the progress of the senior application and cite the patent with appropriate comment to the junior applicant immediately after its issue. (Notice of February 15, 1921, Revised.)

If, at the end of the six months' suspension, it appears likely that the senior application will be passed to issue within the next six months, action on the conflicting claims and claims not patentable over the senior party's case should again be suspended for a period of six months. Of course, if the first suspension was directed to certain claims only and the usual action was given on other claims, it is necessary for the applicant to make such response as is required to the action on the other claims.

If, at the end of the first six months' suspension, there is no likelihood of the senior party's application being put in condition for allowance within the next six months and the only unsettled question in the junior party's case is the disposition of the claims on which action was suspended, then the interference should be declared.

If the junior application is in issue when the interference is discovered and, in correspondence under Rule 202, the junior applicant fails to make the date of the senior party, the junior application should be withdrawn from issue (see "Letter Forms Used in Interferences," 1112.04) and a letter sent informing him that the interfering claim or claims and claims not patentable over the senior party's case cannot be allowed him as his date of invention indicates he is not the first inventor. Action should be suspended for six months, the Examiner noting the expiration date on his calendar and advising applicant to call the case up for action at the end of the six months. Thereafter, procedure should be as above.

1101.01 (j) Suggestion of Claims

Rule 203. Preparation for interference between applications; suggestion of claims for interference. (a) Before the declaration of interference, it must be de-

termined that there is common patentable subject matter in the cases of the respective parties, patentable to each of the respective parties, subject to the determination of the question of priority. Claims in the same language, to form the counts of the interference, must be present or be presented, in each application.

(b) When the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall, if it has been determined that an interference should be declared, suggest to the parties such claims as are necessary to cover the common invention in the same language. The parties to whom the claims are suggested will be required to make those claims (i. e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared. The failure or refusal of any applicant to make any claim suggested within the time specified, shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended.

(c) The suggestion of claims for purpose of interference will not stay the period for response to an Office action which may be running against an application, unless the claims are made by the applicant within the time specified for making the claims.

(d) When an applicant presents a claim in his application (not suggested by the examiner as specified in this rule) which is copied from some other application, either for purpose of interference or otherwise, he must so state, at the time he presents the claim and identify the other application.

Although the subject of suggesting claims is treated in detail at this point in the discussion of a prospective interference between applications, some of the practice here outlined is also applicable to a prospective interference with a patent.

If the applications contain identical claims covering the entire interfering subject matter the Examiner proceeds under Rule 207 to form the interference; otherwise, proper claims must be suggested to some or all of the parties.

It should be noted at this point that if an applicant copies a claim from another application without suggestion by the Examiner, Rule 203 (d) requires him to "so state, at the time he presents the claim and identify the other application."

The question of what claims to suggest to the interfering applications is one of great importance, and failure to suggest such claims as will define clearly the matter in issue leads to confusion and to prolongation of the contest.

While it is much to be desired that the claims suggested (which are to form the issue of the interference) should be claims already present in one or the other of the applications, yet if claims cannot be found in the applications which satisfactorily express the issue it may be necessary to frame a claim or claims reading on all the applications and clearly expressing the interfering subject matter and suggest it or them to all parties.

It is not necessary that all the claims of each party that read on the other party's case be suggested. This would lead in some instances to a needless multiplication of counts of the issue and a consequent complication of the proceedings to no good purpose. The counts of the issue should be patentably different. The test in an interference for patentably distinct counts is not whether they may appear in the same patent but whether they differ sufficiently to sustain separate patents. In general, the broadest patentable claim which is allowable in each case should be used as the interference count and additional claims should not be suggested unless they meet the foregoing test as to patentable distinction. The same precaution should be observed in the declaration of companion interferences involving several common parties. Claims not patentably different from counts of the issue are rejected in the application of the defeated party after termination of the interference.

The claims to form the issue of the interference are suggested to all parties who have not already made those claims. (See "Letter Forms Used in Interferences," 1112.02.)

1101.01 (k) Suggestion of Claims, Conflicting Parties Have Same Attorney

Rule 208. Conflicting parties having same attorney. Whenever it shall be found that two or more parties whose interests appear to be in conflict are represented by the same attorney or agent, the examiner shall

notify each of said principal parties and the attorney or agent of this fact, and shall also call the matter to the attention of the Commissioner. If conflicting interests exist, the same attorney or agent or his associates will not be recognized to represent either of the parties whose interests are in conflict without the consent of the other party or in the absence of special circumstances requiring such representation, in further proceedings before the Patent Office involving the matter or application or patent in which the conflicting interests exist.

This notification should be given to both parties at the time claims are suggested even though claims are suggested to only one party. Notation of the persons to whom this letter is mailed should be made on all copies. (See "Letter Forms Used in Interferences," 1112.03.) The attention of the Commissioner is not called to the fact that two conflicting parties have the same attorney until an actual interference is set up and then it is done by notifying the Examiner of Interferences as explained in 1102.01 (b).

1101.01 (l) Suggestion of Claims, Action To Be Made at Time of Suggesting Claims

At the same time that the claims are suggested an action is made on each of the applications that are up for action by the Examiner, whether they be new or amended cases. In this way possible motions under Rules 233 and 234 may be forestalled. That is, the action on the new or amended case may bring to light patentable claims that should be included as counts of the interference, and, on the other hand, the rejection of unpatentable claims will serve to indicate to the opposing parties the position of the Examiner with respect to such claims.

The Examiner is required to inform each applicant when the interference is declared what claims in his application are unpatentable over the issue. There would seem to be no objection to, and many advantages in, giving this information when suggesting claims.

Where in a letter suggesting claims to an applicant for interference, the Examiner states that none of the claims in the case is patentable over the claims suggested, this statement does not constitute a formal rejection of the claims, so that after the expiration of the period fixed for presenting the suggested claims, if no amendment has been filed, the Examiner should make a definite action on the claims then in the application.

1101.01 (m) Suggestion of Claims, Time Limit Set for Making Suggested Claims

Where claims are suggested for interference, a limited period determined by the Examiner, not less than 30 days, is set for reply. See 710.02 (c).

Should any one of the applicants fail to make the claim or claims suggested to him, within the time specified, all his claims not patentable thereover are rejected on the ground that he has disclaimed the invention to which they are directed. If applicant makes the suggested claims later they will be rejected on the same ground unless the delay is satisfactorily explained. (706.03 (u).)

1101.01 (n) Suggestion of Claims, Suggested Claims Made After Statutory Period Running Against Case

If claims are suggested in an application near the end of the statuory period running against the case, and the time limit for making the claims extend beyond the end of the period, such claims will be admitted if filed within the time limit even though outside the six months' period and even though no amendment was made responsive to the Office action outstanding against the case at the time of suggesting the claims. However, if the suggested claims are not thus made within the specified time, the case becomes abandoned in the absence of a responsive amendment filed within the six months' period. Rule 203 (c).

1101.01 (o) Suggestion of Claims, Application in Issue or in Interference

An application will not be withdrawn from issue for the purpose of suggesting claims for an interference. When an application is pending before the Examiner which contains one or more claims, which may be made in a case in issue, the Examiner may write a letter suggesting such claims to the applicant whose case is in issue, stating that if such claims be made within a certain specified time the case will be withdrawn from issue, the amendment entered and the intereference declared. Such letters must be submitted to the Supervisory Examiner. If the suggested claims are not copied in the application in issue, it may be necessary to withdraw it from issue for the purpose of rejecting other claims on the implied disclaimer resulting from the failure to copy the suggested claims, using form at 1112.04.

When the Examiner suggests one or more claims appearing in a case in issue to an applicant whose case is pending before him, the case in issue will not be withdrawn for the purpose of interference unless the suggested claims shall be made in the pending application within the time specified by the Examiner. The letter suggesting claims should be submitted to the Supervisory Examiner for approval.

In either of the above cases the Issue and Gazette Branch should be notified when the claim is suggested, so that in case the final fee is paid during the time in which the suggested claims may be made, proper steps may be taken to prevent the final fee from being applied. (Order 1365, Revised.)

The Examiner should borrow the allowed application from the Issue and Gazette Branch and hold the file until the claims are made or the time limit expires. This avoids any possible issuance of the application as a patent should the final fee be paid. To further insure against the issuance of the application, the Examiner may pencil in the blank space following "Final Fee" on the file jacket the initialled request: "Defer for interference." When notified that the final fee has been received, the Examiner shall prepare a memo to the Issue and Gazette Branch requesting that issue of the patent be deferred for a period of 90 days due to a possible interference. This allows a period of 60 days to complete any action needed. At the end of this 60 day period, the application must either be released to the Issue and Gazette Branch or be withdrawn from issue, using form at 1112.04.

When an application is found having claims to be suggested to other applications already involved in interference, to form another interference, the Primary Examiner requests jurisdiction of the last named applications. To this end a separate letter (see form at 1112.06 (a)), addressed to the Commissioner is written for each file, referring only to that file, and is placed therein. This letter goes to the Supervisory Examiner for his approval. In case the application is to be added to the existing interference, the Primary Examiner requests jurisdiction of the interference. In this case, form at 1112.06 (b) is used. This is addressed to the Examiner of Interferences.

1101.02 With a Patent

Rules 204, 205 and 206 quoted below deal with interference involving patents.

Rule 204. Interference with a patent; affidavit by junior applicant. (a) The fact that one of the parties has already obtained a patent will not prevent an interference. Although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who, in the interference, proves himself to be the prior inventor.

(b) When the filing date or effective filing date of an applicant is subsequent to the filing date of a patentee, the applicant, before an interference will be declared, shall file an affidavit that he made the invention in controversy in this country, before the filing date of the patentee, or that his acts in this country with respect to the invention were sufficient under the law to establish priority of invention relative to the filing date of the patentee; and, when required, the applicant shall file an affidavit (of the nature specified in rule 131) setting forth facts which would prima facie entitle him to an award of priority relative to the filing date of the patentee.

As a patentee may not alter his claims (except by reissue) an applicant must make one or more claims of the patent, or substantial equivalents thereof, to invoke an interference as stated in Rule 205. For the practice to be followed where an interference in fact exists between a patent and an application but, because of overlapping numerical ranges or differences in Markush groups, priority cannot be properly determined on the basis of a patent claim, see the following Notice:

It has been found that the practice set forth in Ex parte Card and Card, 112 O. G. 499, 1904 C. D. 383, does not adequately take care of all situations where there is an interference in fact between a patent and an application but there are obstacles to the applicant making the exact patent claim.

In those cases where the claim of the patent contains an immaterial limitation which can be wholly eliminated or suitably modified so as to broaden the claim, the practice set forth in Ex parte Card and Card should continue to be followed.

A. In some cases, the disclosure in the application, although for the same invention in fact as the patent claim, is somewhat narrower than the claim of the patent. Under such circumstances, the applicant should be permitted to copy the claim of the patent as exactly as possible, modifying it only by substituting language based upon his own slightly narrower disclosure for the limitation in the patent claim which he can not make. In declaring the interference, the exact patent claim should be used as the count of the interference and it should be indicated that the claim in the application corresponds substantially to the interference count.

Examples of the practice outlined in the preceding paragraph:

I. PATENT CLAIMS A RANGE OF 10 TO 90.

Application discloses a range of 20 to 80, there being no distinction in substance between the two ranges.

Applicant may be permitted to copy the patent claim, modifying it by substituting his range of 20 to 80 for the range of 10 to 90 in the patent claim.

Interference should be declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

II. PATENT CLAIMS A MARKUSH GROUP OF 6 MEMBERS.

Application discloses a Markush group of 5 of the same 6 members, there being no distinction in substance between the two groups.

Applicant may be permitted to copy the patent claim, modifying it by substituting his 5-member group for the 6-member group in the patent claim.

Interference should be declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

B. In come cases, the disclosure in the application, although for the same invention in fact as the patent claim, is somewhat broader than the claim of the patent. Under such circumstances, in initially declaring the interference the applicant should be required to make the exact patent claim and the interference should be declared on that claim. However, if the applicant presents and prosecutes a motion to substitute a broader count and, in connection with such a motion, makes a satisfactory showing, as by demonstrating that his best evidence lies outside the exact limit of the patent claim, the applicant may be permitted to substitute a count wherein language based upon his slightly broader disclosure replaces the corresponding limitation in the patent claim. In redeclaring the interference, the application claim should be used as the count of the interference and it should be indicated that the claim in the patent corresponds substantially to the interference count.

Examples of the practice outlined in the preceding paragraph:

I. PATENT CLAIMS A RANGE OF 20 TO 80.

Application discloses a range of 10 to 90, there being no distinction in substance between the two ranges.

Applicant should be required initially to copy the exact patent claim.

Interference should be declared initially with the exact patent claim as the count.

If, in connection with a motion to substitute, the applicant makes a satisfactory showing of the necessity for including the ranges of 10 to 20 and 80 to 90 in the interference count, he may be permitted to present the patent claim modified by substituting his range of 10 to 90 for the range of 20 to 80 in the patent claim.

Interference should be redeclared with the application claim as the count and it should be indicated that the claim in the patent corresponds substantially to the interference count.

II. PATENT CLAIMS A MARKUSH GROUP OF 5 MEMBERS.

Application discloses a Markush group of 6 members, including the 5 claimed in the patent, there being no distinction in substance between the two groups.

Applicant should be required initially to copy the exact patent claim.

Interference should be declared initially with the exact patent claim as the count.

If, in connection with a motion to substitute, the applicant makes a satisfactory showing of the necessity for including the sixth member in the interference count, he may be permitted to present the patent claim modified by substituting his 6-member group for the 5-member group in the patent claim.

Interference should be redeclared with the application claim as the count and it should be indicated that the claim in the patent corresponds substantially to the interference count.

C. Some cases may include aspects of both A and B, above. Such cases should be appropriately treated by the same general principles outlined above.

Examples of cases involving mixed aspects:

I. PATENT CLAIMS A RANGE OF 10 TO 80.

Application discloses a range of 20 to 90, there being no distinction in substance between the two ranges.

(a) Initially, applicant may be permitted to copy the patent claim, modifying it by substituting the range of 20 to 80 for the range of 10 to 80 in the patent claim.

Interference should be initially declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

(b) If, in connection with a motion to substitute, the applicant makes a satisfactory showing of the necessity for including the range of 80 to 90 in the interference count, he may be permitted to present the patent claim modified by submitting his range of 20 to 90 for the range of 10 to 80 in the patent claim.

Interference should be redeclared with a count covering the range of 10 to 90 and it should be in-

dicated that both the claim in the patent and the claim in the application correspond substantially to the interference count.

II. PATENT CLAIMS A MARKUSH GROUP OF 6 MEMBERS.

Application discloses a Markush group of 5 of the same 6 members, plus another member not claimed in the patent, there being no distinction in substance between the two groups.

(a) Initially, applicant may be permitted to copy the patent claim, modifying it by substituting the 5 members of the patent claim which he discloses for the 6-member group in the patent claim.

Interference should be declared initially with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

(b) If, in connection with a motion to substitute, the applicant makes a satisfactory showing of the necessity for including his additional member of the group, he may be permitted to present the patent claim modified by substituting the 6-member group which he discloses for the 6-member group in the patent claim.

Interference should be redeclared with a count including in a Markush group all 7 members claimed in the patent and disclosed in the application and it should be indicated that both the claim in the patent and the claim in the application correspond substantially to the interference count.

The practice outlined above should be restricted to situations where the inventions claimed in the patent and disclosed in the application are clearly the same, so that there is truly an interference in fact.

Until further notice, interferences declared or redeclared in accordance with this practice should be submitted to the Supervisory Examiners.

All prior decisions, orders, and notices are hereby overruled to the extent that they may be inconsistent with the said practice. (Notice of April 5, 1954.)

Rule 205. Interference with a patent; copying claims from patent. **(a) Before an interference will be declared with a patent, the applicant must present in his application copies of all the claims of the patent which also define his invention and such claims must be patentable in the application. If claims cannot be properly presented in his application owing to the inclusion of an immaterial limitation or variation, an interference may be declared after copying the claims excluding such immaterial limitation or variation.**

(b) Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office. The examiner will call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent.

Rule 206. Interference with a patent; claims improperly copied. **(a) Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied,**

he shall notify the applicant to that effect, state why he is of the opinion the applicant cannot make the other claims and state further that the interference will be promptly declared. The applicant may proceed under rule 233, if he desires to further contest his right to make the claims not included in the declaration of the interference.

(b) Where the examiner is of the opinion that none of the claims can be made, he shall state in his action why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

For rejection of copied patent claims see 1101.02 (f).

When an interference with a patent is proposed it should be ascertained before any steps are taken whether there is common ownership. A title report must be placed in the patented file when the papers for an interference between an application and a patent are forwarded. To this end the Examiner, before initiating an interference involving a patent, should refer the patented file to the Assignment Branch for notation as to ownership.

PATENT IN DIFFERENT DIVISION

Where claims are copied from a patent classified in another division, the propriety of declaring the interference (if any) is decided by and the interference is declared by the division where the copied claims would be classified. In such a case, it may be necessary to transfer the application, including the drawings, temporarily to the division which will declare the interference. A print of the drawings should be made and filed in the division originally having jurisdiction of the application in place of the original drawings.

1101.02 (a) Copying Claims From a Patent

A large proportion of interferences with a patent arise through the initiative of an applicant in copying claims of a patent which has come to his attention through citation in an Office action or otherwise.

However, in some instances the Examiner observes that certain claims of a patent can be made in a pending application and, if the patent is not a statutory bar, he must take steps to avoid the issuance of a second patent claiming the same invention without an interference. The practice set forth hereinbelow applies when an issued patent and a pending application are not commonly assigned. If there is a common assignment, a rejection as outlined in 305 should be made if an attempt is made to claim in the pending application the same invention as is claimed in the patent.

A patent claiming the same invention as that being claimed in an application can be overcome only through interference proceedings. Where the effective filing date of the application is prior to that of the patented application, no oath is required. Otherwise the applicant must submit an affidavit that he made the invention prior to the filing date of the patent, even though there was copendency between the two applications. It is within the discretion of the Examiner to require the same showing of facts in an affidavit under Rule 204 as is required in an affidavit under Rule 131. This discretion should be governed by the circumstances of the case, such as the difference in filing dates, complexity of the invention, etc.

If the filing date of the patent precedes the filing date of the application and the patent is not a statutory bar against the application, the claims of the application should be rejected on the patent. If it appears that the applicant is claiming the same invention as is claimed in the patent and that the applicant is able to make one or more claims of the patent, a statement should be included in the rejection that the patent cannot be overcome by an affidavit under Rule 131 but only through interference proceedings. Note, however, 35 U. S. C. 135, 2d par. If the applicant controverts this statement and presents an affidavit under Rule 131, the case should be considered special, one claim of the patent which the applicant clearly can make should be selected, and an action should be made refusing to accept the affidavit under Rule 131 and requiring the applicant to make the selected claim as well as any other claims of the patent which he believes find support in his application. If necessary, the applicant should be required to file the affidavit and showing required by Rule 204. A shortened period for response should be set under Rule 203. In any case where an applicant attempts to overcome a patent by means of affidavit under Rule 131, even though the examiner has not made a rejection on the ground that the same invention is claimed in the patent, the claims of the patent should be examined and, if appli-

cant is claiming the same invention as is claimed in the patent and can make one or more of claims of the patent, the affidavit under Rule 131 should be refused, and an action such as outlined in the preceding part of this paragraph should be made. If necessary, the requirements of Rule 204 should be specified and a shortened period for response should be set under Rule 203.

1101.02 (b) Copying Claims From a Patent, Examiner Cites Patent Having Filing Date Later Than That of Application

If the patent discloses the same subject matter as disclosed in an application but the filing date of the patent is later than the filing date of the application, the patent should be cited to the applicant. If the invention claimed by the applicant is different from that claimed in the patent so that a distinct patent could be granted to the applicant without interference proceedings, nothing further need be done at this time, leaving it to the applicant to determine whether he wishes to and can copy the claims of the patent. If the invention claimed by the applicant is the same as that claimed in the patent so that a second patent could not be granted without interference proceedings, one claim of the patent which the applicant clearly can make should be selected and the applicant should be required to make the selected claim as well as any other claims of the patent which he believes find support in his application. No affidavit under Rule 204 is required but a shortened period for response should be set under Rule 203.

1101.02 (c) Copying Claims From a Patent, Difference Between Copying Patent Claims and Suggesting Claims of an Application

The practice of an applicant copying claims from a patent differs from the practice of suggesting claims for a prospective interference involving only applications in the following respects:

(1) No correspondence under Rule 202 is conducted with a junior applicant who is to become involved in an interference with a patent but, instead, an affidavit under Rule 204 is required.

(2) When a question of possible interference with a patent arises, the patent should be cited, whereas no information concerning the source of the claim should be revealed when a claim is suggested for a prospective interference involving only applications.

(3) All claims of a patent which an applicant can make should be copied, whereas only patentably distinct claims are suggested for an interference involving only applications.

(4) Claims copied by an applicant from a patent may differ from the patent claims by the exclusion of an immaterial limitation or variation which the applicant cannot make, whereas claims suggested for an interference between applications must be identical in all cases.

1101.02 (d) Copying Claims From a Patent, Copied Patent Claims Not Identified

If an attorney or agent presents a claim copied or substantially copied from a patent without indicating its origin he may be deemed to be seeking, obviously improperly, to obtain a claim or claims to which the applicant is not entitled under the law without an interference, or the Examiner may be led into making an action different from what he would have made had he been in possession of all the facts. Rule 205 (b) therefore requires the Examiner to "call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to the fact and identifying the patent."

1101.02 (e) Copying Claims From a Patent, Making of Patent Claims Not a Response to Last Office Action

The making of claims from a patent when not required by the Office does not constitute a response to the last Office action and does not operate to stay the running of the statutory period dating from the unanswered Office action.

1101.02 (f) Copying Claims From a Patent, Rejection of Copied Patent Claims

REJECTION NOT APPLICABLE TO PATENT

When claims from a patent are made, the application is taken up at once and the Examiner may reject such claims in the application if the ground of rejection is not also applicable in the case of the patent. Examples of such a ground of rejection are insufficient disclosure in the application, a reference whose date is

junior to that of the patent, or because the claims copied from a patent are barred to applicant by the second paragraph of 35 U. S. C. 135, which reads:

"A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted."

It should be noted that an applicant is permitted to copy a patent claim outside the year period if he has been claiming substantially the same subject matter within the year limit. See Thompson v. Hamilton, 1946 C. D. 70, 585 O. G. 177; In re Frey, 1950 C. D. 362, 639 O. G. 5; Andrews v. Wickenden, 1952 C. D. 176, 659 O. G. 305; In re Tanke et al., 102 U. S. P. Q. 83; —— C. D. ——, 687 O. G. 677; Emerson v. Beach, 103 U. S. P. Q. 45, —— C. D. ——, 691 O. G. 170.

As is pointed out in Rule 206, where more than one claim is copied from a patent, and the Examiner holds that one or more of them are not patentable to applicant and at least one other is, the Examiner should at once set up the interference on the claim or claims considered patentable to applicant, rejecting the others, leaving it to applicant to proceed under Rule 233 in the event that he does not acquiesce in the Examiner's ruling as to the rejected claims.

Where all the claims copied from a patent are rejected on a ground not applicable to the patentee the Examiner sets a time limit for reply, not less than thirty days, and all subsequent actions, including action of the Board on appeal, are special in order that the interference may be declared as promptly as possible. Failure to respond or appeal, as the case may be, within the time fixed, will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

While the time limit for an appeal from the final rejection of a copied patent claim is usually set under the provisions of Rule 206, where the remainder of the case is ready for final action, it may be advisable to set a shortened statutory period for the entire case in accordance with Rule 136. Such a letter must have the approval of the Supervisory Examiner.

The distinction between a limited time for reply under Rule 206 and a shortened statutory period under Rule 136 should not be lost sight of. The one is set by the Primary Examiner, while the other requires the approval of the Supervisory Examiner. The penalty resulting from failure to reply within the time limit under Rule 206 is loss of the claim or claims involved, on the doctrine of disclaimer, and this is appealable; while failure to respond within the set statutory period (Rule 136) results in abandonment of the entire application. That is not appealable. Further, a belated response after the time limit set in accordance with Rule 206 may be entered by the Examiner, if the delay is satisfactorily explained (except that the approval of the Commissioner is required where the situation described in the next paragraph below exists); but one day late under Rule 136 period, no matter what the excuse, results in abandonment. However, if asked for in advance, one extension of either period may be granted by the Examiner, provided that extension does not go beyond the six months' period.

Where a patent claim is suggested to an applicant by the Examiner for the purpose of establishing an interference and is not copied within the time limit set or a reasonable extension thereof, an amendment presenting it thereafter will not be entered without the approval of the Commissioner. (Notice of September 27, 1933, Revised.)

The rejection of copied patent claims sometimes creates a situation where two different periods for response are running against the application—one, the statutory period dating from the last full action on the case; the other, the limited period set for the response to the rejection (either first or final) of the patent claims. This condition should be avoided where possible as by setting a shortened period for the entire case with the approval of the Supervisory Examiner, but where unavoidable, it should be emphasized in the Examiner's letter.

In this connection it is to be noted that a reply to a rejection or an appeal from the final rejection of the patent claims will not stay the running of the regular statutory period if there be an unanswered Office action in the case at the time of reply or appeal, nor does such reply or appeal relieve the Examiner from the duty of acting on the case if up for action, when reached in its regular order.

Where an Office action is such as requires the setting of a time limit for response to or appeal from that action or a portion thereof, the Examiner should note at the end of the letter the date when the time limit period ends and also the date when the statutory period ends. (Notice of June 29, 1938, Revised.) See 710.04.

Rejection Applicable to Patent and Application

If the ground of rejection is applicable to both the claims in the application and the claims in the patent, any letter including the rejection must have the approval of the Super-

visory Examiner. However, if an interference would be proper except for such ground of rejection, the interference nevertheless may be declared.

The Primary Examiner should forward a memorandum with the declaration papers requesting the Examiner of Patent Interferences to notify him of the setting of the motion period and, as soon as such notification is received, the Primary Examiner should proceed promptly in accordance with the provisions of Rule 237 (a) and Section 1105.05 of the Manual, employing the form letter of Section 1112.08 of the Manual. Promptness of action by the Examiner is important as notification to the parties early in the motion period will permit a hearing on the Examiner's proposal to dissolve under Rules 237 (a) to be included with hearings on motions.

If such a reference is discovered while an interference involving a patent is before the Examiner for his decision on motions, he should proceed under Rule 237 (a), last sentence. If the reference is discovered after decision on motions has been rendered, the Examiner proceeds in accordance with Rule 237 (a) and Section 1105.05 of the Manual. The Supervisory Examiner's approval must be obtained before forwarding the form letter of Sec. 1112.08 and before mailing the decision on motion. (Notice of March 15, 1950, Revised.)

1101.02 (g) Copying Claims From a Patent, After Prosecution of Application Is Closed or Application Is Allowed

While an amendment presenting a patent claim in an application not in issue is usually admitted and promptly acted on whatever may be the stage of prosecution—final rejection, appeal, interference, or what-not—yet, if the case had been closed to further prosecution before the Primary Examiner, as, by final rejection or allowance of all of the claims, or by appeal, such amendment is not entered as a matter of right. Where the prosecution of the application is closed before the Primary Examiner and the copied patent claims relate to an invention distinct from that claimed in the application entry of the amendment may be denied. (Ex parte Shohan, 1941 C. D. 1; 522 O. G. 501.) Admission of the amendment may very properly be denied in a closed application, if, prima facie, the claims are not supported by applicant's disclosure. An applicant may not have recourse to asserting a patent claim which he has no right to make as a means to reopen or prolong the prosecution of his case. See 714.19 (4).

When an amendment is received after notice of allowance, which includes one or more claims copied or substantially copied from a patent and the Examiner, after consideration of the proposed amendment, finds one or more of the claims patentable to the applicant and an interference to exist, he should prepare a letter [see Letter Form 1112.04], requesting that the application be withdrawn from issue for the purpose of interference. This letter, which should designate the claims to be involved, should be forwarded, together with the file and the proposed amendment, to the Supervisory Examiner.

When an amendment is received after notice of allowance, which includes one or more claims copied or substantially copied from a patent and the Examiner finds basis for refusing the interference on any ground he should make an oral report to the Supervisory Examiner of the reasons for refusing the requested interference. Notification to applicant is made on Form POL–105 if the entire amendment is refused or on Form POL–103 if a portion of the amendment (including all the copied claims) is refused. The following or equivalent language should be employed to express the adverse recommendation as to the entry of the copied or substantially copied patent claims:

"Entry of claims _____ is not recommended because (brief statement of basic reasons for refusing interference). Therefore withdrawal of the application from issue is not deemed necessary." (Notices of December 9, 1943 and January 6, 1953, Revised.)

1101.03 Removing of Affidavits Before Interference

Where there is of record in the file an affidavit under Rule 204 making a showing of facts, the affidavit should be sealed in an envelope and the envelope properly labeled as to its contents before sending the file to the Interference Division. Affidavits under Rule 131 should be similarly treated. These envelopes should be retained in the examining division during the interference. (Notice of October 15, 1940, Revised.)

This same practice applies in case of affidavits under Rule 131 and Rule 204 in earlier applications (not patents) which are to be included in the declaration papers.

Any correspondence under Rule 202 should be obtained from the Law Examiner, sealed, and

forwarded with the other papers to the Interference Division.

Affidavits under Rules 131 and 204, as well as an affidavit under Rule 202, which never becomes a paper in the application file, are available for inspection by an opposing party to an interference when the preliminary statements are opened. Ferris v. Tuttle, 1940 C. D. 5; 521 O. G. 523. (Notice of October 15, 1940, Revised.)

The now opened affidavits filed under Rules 131 and 204 may then be returned to the application files and the affidavits filed under Rule 202 filed in the interference jacket.

1102 Preparation of Interference Papers and Declaration

The rules pertinent to this subject are set forth in Rule 207 quoted below and in Rule 209 in 1102.02.

Rule 207. Preparation of interference notices and statements. (a) When an interference is found to exist and the applications are in condition therefor, the primary examiner shall forward the files to the Examiner of Interference, together with notices of interference to be sent to all the parties (as specified in rule 209) disclosing the name and residence of each party and those of his attorney or agent, and of any assignee, and, if any party be a patentee, the date and number of the patent. The notices shall also specify the issue of the interference, which shall be clearly and concisely defined in only as many counts as may be necessary to define the interfering subject matter (but in the case of an interference with a patent all the claims of the patent which can be made by the applicant should constitute the counts), and shall indicate the claim or claims of the respective cases corresponding to the count or counts. If the application or patent of a party included in the interference is a division or continuation of a prior application and the examiner has determined that it is entitled to the filing date of such prior application, the notice to such party shall so state.

(b) The primary examiner shall also forward a statement for the Examiners of Interferences disclosing the applications involved in interference, fully identified, arranged in the inverse chronological order of the filing of the completed applications, and also disclosing the count or counts in issue and the ordinals of the corresponding claims, the name and residence of any assignee, and the names and addresses of all attorneys or agents, both principal and associate.

1102.01 Preparation of Papers

The procedure to be followed in setting up an interference is set forth in Rule 207. Further information is given in the following sections, and in In re Redeclaration of Interferences, Nos. 49,635; 49,636; 49,866; 1926 C. D. 75; 350 O. G. 3. The forms used by the Examiner in setting up an interference give the details of all letters to be written.

"In declaring or redeclaring an interference the following should be borne in mind:

(1) That no party should be made junior as to some counts and senior as to others, but that two interferences should be set up making the party with two applications junior in one interference and senior in the other.

(2) That no interference should be declared in which each party to the interference is not involved on every count.

(3) That where an applicant puts identical claims in two applications by virtue of one of which he will be the senior party and of the other the junior the later application should be placed directly in the interference, leaving the applicant to gain such benefit as he may from the senior application either by motion to shift the burden of proof or by introducing the senior into the interference as evidence." (In re Redeclaration of Interferences Nos. 49,635; 49,636; 49,866; 1926 C. D. 75; 350 O. G. 3.)

Briefly, in preparing cases for interference, Forms PO–221, POL–76, and PO–222 should be filled out.

Any correspondence under Rule 202 should be obtained from the Law Examiner, sealed, and forwarded with the other papers. Affidavits under Rule 131 and those affidavits under Rule 204 which reveal facts of the nature of those included in an affidavit under Rule 131 should be removed from application (not patent) files, sealed, and retained in the examining division until called for or until the interference is terminated. See 1101.03. This same practice obtains in the case of affidavits of this nature in earlier applications which have been referred to in the declaration papers. And, if a patent is involved in the interference, a recent title report on the patent should be forwarded with the other papers.

To make the practice in declaring interferences uniform the procedure to be followed is set forth below:

1102.01 (a) Letter to Examiner of Interferences

The letter to the Examiner of Interferences is written upon the blank (Form PO–221) for that purpose. See 1112.05 (a). This letter should contain, first the information as to the parties required by the rules, the parties being arranged in inverse chronological order of filing of the applications directly involved in the interference, second, the counts of the interference, and third, a table showing the relationship of the counts with the respective claims made by the parties. For example, in an interference involving X, Y, and Z, in which Z is the senior party and Y junior to both X and Z:

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	Y	X	Z
1	16	3	2
2	5	1	3
3	9	15	5
4	4	11	6

(Extract from Order 1514, Revised.)

Reference is made to a divisional or continuation application only if the Primary Examiner considers that the earlier application clearly supports all the counts. If there is any doubt upon this question, no reference should be made to an eariler application, the matter being left for determination upon motion to shift the burden of proof. (Notice of April 22, 1922, Revised.)

If the case in interference is a division or continuation of an earlier application, the parent application should be completely identified by application number and filing date and including a patent number and date if it has matured into a patent. Also, if the parent application is, in turn, a division or continuation of a still earlier application, the earlier application should also be completely identified and its relationship stated. This procedure should be followed to the point where the earliest effective U. S. filing date of each party with respect to all the counts in issue has been given. Ignore any earlier application of which the case in interference is a continuation-in-part.

The letter to the Examiner of Interferences should not include any reference to foreign filing dates, even though the Examiner may have acted favorably on a request under Sec. 1 of Public Law 690. (See 1111.10.)

If a reissue application or patent is involved in an interference, complete information concerning it should be given on Form PO–221, including reissue patent number and date, reissue application number and filing date, original patent number and date, and original application number and filing date.

In preparing the papers for an interference which involves a patent, the numeral of the patent claim should be used rather than the original numeral of that claim when the patent was a pending application. The interference is between the application which has copied the patent claim and the patent—not the patented application (Rule 201); and the interference papers should be prepared accordingly. Observance of this practice is important, since if the patentee loses the interference, this fact specifying the patent claims involved as obtained from the interference papers is published in the Official Gazette and endorsed on copies of the patent.

(Notice of November 1, 1943, Revised.)

In an interference involving a patent, if the Primary Examiner discovers a reference which, in his opinion, renders a count obviously unpatentable, a memorandum should be forwarded to the Examiner of Interferences as set forth in 1101.02 (f).

If the interference counts are modified claims of a patent, the word "modified" or "substantially" should appear in parentheses after the corresponding claim numbers of the patent in the table of claims. If an application was merely in issue and did not become a patent, the original claim numbers of the application, prior to revision for issue, should be used.

The letter to the Examiner of Interferences (Form PO–221) must include copies of the counts. A certificate of correction in a patent should not be overlooked. For the best practice in interference between applications, dependent counts should be avoided and each count should be independent. This avoids confusion in language and disputes as to the meaning of the counts. When dependent counts cannot be avoided, as in the case of an interference with a patent and one of the counts is a dependent claim, the count may likewise be stated as dependent on the count corresponding to the claim on which the dependent claim is founded. In the rare instance where a dependent claim is the sole count of an interference and the basic claim is not included, the count should be copied as a dependent claim and immediately thereunder, in brackets, the basic claim should be copied.

If an interference is declared as the result of a decision on motions under Rules 233 and 234 in a prior interference, a statement should be added to Form PO–221 to the following effect:

"This interference is declared as the result of the Primary Examiner's decision on motions in Interference No. _____."

This insures against the setting of a new motion period in the newly declared interference. (See Rule 233 (e), last sentence.)

The counts should be checked against the original claims and the words "counts compared" placed at the end of the letter to the Examiner of Interferences as evidence that the copies of the counts had been compared with the original claims. (Order 1537, Revised.)

If parties to an interference have the same attorney, the attention of the Examiner of Interferences should be called to this as set forth in 1102.01 (b).

1102.01 (b) Letters to Parties

The letters to the different parties are written upon the blanks for that purpose. See Letter Form at 1112.05 (c). After the printed matter upon said blank, there shall appear first, the ordinals of the claims of the application corresponding to the counts of the interference, second, the information pertaining to the other parties, as required by the rules,

arranged strictly in accordance with alphabetical order, and third, the counts and claims of the parties tabulated strictly in accordance with alphabetical order. For example, after the identification of the counts, the letter to X would read:

(a) The interference involves your application above identified, and

(b) An application filed by Y, of 282 Broadway, New York, whose attorney is _____, of _____ and whose assignee is _____, of _____.

(c) An application (patent) filed by Z, of 1205 Chestnut Street, Philadelphia, Pennsylvania, whose attorney is _____, of _____, and whose assignee is _____ of _____.

(d) The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	X	Y	Z
1	3	16	2
2	1	5	3
3	15	9	5
4	11	4	6

(Extract from Order 1514, Revised.)

Special precautions to be observed in filling out the interference notice to the parties (Form POL–76) will now be discussed.

First and foremost, the letters to the parties must never include the serial numbers or filing dates of opposing applications or reveal the relative order of filing of the respective applications. If the interference involves a patent, the letter to any opposing party includes complete information concerning the patent, since this is public information which is available to anyone and the applicant knows the patent from which he copied claims. No statement as to parent applications of the patent should be made.

In filling out Form POL–76 the blanks to the right of the address box should be completely filled out.

If an application or patent of a party is a division or continuation of a prior application and the Examiner has determined that the party is entitled to the filing date of the prior application, the Examiner should, in addition to including that information on Form PO–221, inform the party of that fact in the letter which is sent to him, as by including a notation to the following effect:

"Your application (or patent), above identified, is a division (or continuation) of Serial No. _____, filed _____ (see Rule 207 (a))."

Ignore any earlier application of which the case in interference is a continuation-in-part.

Notation of the persons to whom Form POL–76 is mailed should be made on all copies.

The interference number and date for filing the preliminary statement must be left blank.

The counts of the interference are ordinarily not copied in the letters to the parties unless a particular party's case does not include an exact copy of the interference counts. Thus, if the interference count is a modified claim of a patent the letter to the patentee must include a copy of the count. (Notice of January 2, 1947, Revised.) Similarly, if the interference count is a dependent claim of a patent rewritten as an independent claim, the rewritten claim should be copied in the letter to the patentee. Also, if the entry of a particular amendment in a party's case is in doubt, the interference notice to that party should indicate whether the count is in the form as amended or prior to the amendment or the exact count may be copied in that party's letter.

The attention of the Examiners is called to the decisions in Votey v. Wuest v. Doman, 1904 C. D. 323; 111 O. G. 1627 and Earl v. Love, 1909 C. D. 56; 140 O. G. 1209 in which it is held that when an interference is declared involving a patentee and the Examiner is of the opinion that the application or applications contain claims not patentably different from the issue of the interference, he should append to the letter to the applicant a statement that such claims, specifying them by number, will be held subject to the decision in the interference. The reason for making such statement applies equally well to an interference involving only applications.

The practice announced in these decisions should be followed. Such a statement gives the parties notice as to what claims the Examiner considers unpatentable over the issue, it avoids the liability of granting claims to the losing party which are not patentable over the issue, but which are not included therein, and will probably lessen the motions under Rule 233. (Notice of May 11, 1917, Revised.)

When parties to an interference have the same attorney this fact should be stated at the bottom of each interference notice. In the case of conflicting applications it is a repetition of information given at the time of suggesting claims; but where the interference is between a patent and an application, such information has not heretofore been given. This matter should also be called to the attention of the Examiner of Interferences, in accordance with the following notice:

In carrying out the provisions of Rule 208, Examiners, when forwarding interference notices and statements to the Examiners of Interferences, will call their attention to cases in which two of the parties are represented by the same attorney, in lieu of calling the matter directly to the attention of the Commissioner. The Examiner of Interferences when mailing out the notices to the parties

and their attorney will advise the parties and the attorney that the attorney will not be recognized further as representing either party in the interference or in the interfering cases unless he shows that he is entitled to continue to represent either or both parties as provided by Rule 208. The Examiner of Interferences will also call to the attention of the parties and the attorney the requirement of the second sentence of Rule 201 (c). (Notice of April 14, 1949.)

In no case should a letter with the exception of the letter to the Examiner of Interferences be dated. All letters except that to the Examiner of Interferences should contain the words "Forwarded to the Examiner of Interferences from Div. _____ (date) _____," at the upper left-hand corner, and it should be stated on all copies that a copy has been sent to the patentee and, if the patent has been assigned, to the assignee.

All the letters, both those for the files and those to be mailed are forwarded as required by the rules, the originals separate from the files, and the carbon copies to be mailed preferably attached to their respective envelopes, but, in no case to be folded or placed within the envelopes. (Extract from Order 1514, Revised.)

1102.01 (c) The Interference Brief Card

Interference brief cards Form No. PO–222 are placed in the files of the respective parties. The names only of the other interfering parties arranged strictly in alphabetical order shall be inserted after "Interference with." The patent number, if any, should be inserted after its corresponding serial number.

1102.02 Declaration of Interference

Rule 209. Declaration of interference; mailing of notices. (a) When the notices of interference are in proper form, an examiner of interferences shall assign a number to the interference and add to the notices a designation of the time within which the preliminary statements required by rule 215 must be filed, and shall, pro forma, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

(b) The notices of interference shall be forwarded by the Examiner of Interferences to all the parties, in care of their attorneys or agents; a copy of the notices will also be sent to the patentees in person and, if the patent in interference has been assigned, to the assignees.

(c) When the notices sent in the interest of a patent are returned to the Office undelivered, or when one of the parties resides abroad and his agent in the United States is unknown, additional notice may be given by publication in the Official Gazette for such period of time as the Commissioner may direct.

The papers necessary in declaring an interference having been prepared (see 1102 to 1102.01 (c)) in the examining division are sent to the Interference Division, the Examiner filing in his own division a copy of the letter to the Examiner of Interferences.

In the Interference Division the interference is given a number and the files and letters are inspected to ascertain whether the issues between the parties have been clearly defined, and whether they are otherwise correct. If the notices are ambiguous or are defective in any material point, the objections are transmitted to the Primary Examiner, who shall promptly notify the Examiner of Interferences of his decision to amend or not to amend them. In case of a material disagreement between the Examiner of Interferences and the primary examiner, the points of difference shall be referred to the Commissioner for decision.

When all the papers are correct, the Examiner of Interferences, under the provisions of Rule 209, adds to the notices a designation of the time within which the preliminary statements required by Rule 215 must be filed and *pro forma* institutes and declares the interference by mailing the notices to the several parties to the proceeding. After the notices are mailed, the application and interference files are sent to the Docket Branch, where the files and interference letters are put in an envelope or box with full data of the interference placed on said envelope or box. These data are also recorded in a card index. The date set for filing the preliminary statements is noted on the interference envelope or box and in the interference register.

If an application that has been made special by the Commissioner becomes involved in an interference, the interference will be made special, provided the prosecution of such application has been diligent on the part of the applicant. See 708.01.

1103 Suspension of Ex Parte Prosecution

Rule 212. Suspension of ex parte prosecution. On declaration of the interference, ex parte prosecution of an application is suspended, and amendments and other papers received during the pendency of the interference will not be entered or considered without the consent of the Commissioner, except as provided by these rules. Proposed amendments directed toward the declaration of an interference with another party will be considered to the extent necessary. Ex parte

prosecution as to specified matters may be continued concurrently with the interference, on order from or with the consent of the Commissioner.

The treatment of amendments filed during an interference is considered in detail in sections 1108 and 1111.05.

For treatment of other applications by the same inventor or assignee having overlapping claims with the application being put into interference see 709.01 and 1111.03.

1104 Jurisdiction of Interference

Rule 211. Jurisdiction of interference. Upon the institution and declaration of the interference, as provided in rule 209, the Examiners of Interferences will take jurisdiction of the same, which will then become a contested case.

The primary examiner will retain jurisdiction of the case until the declaration of interference is made. See rule 237 (b).

The declaration of interference is made when the Examiner of Interferences mails the letters forwarded to him by the Primary Examiner. The interference is thus technically pending before the Examiner of Interferences from the date on which the letters are mailed. However, the files of the various applicants are not opened to the inspection of their opponents until the time for filing preliminary statements has expired and the statements are approved, or an order to show cause is issued.

During the period from the mailing of the notices until the receipt and approval of the preliminary statements and the ensuing opening up of the files to the opposing parties, the interference may be withdrawn at the discretion of the Primary Examiner if he discovers facts that existed at the time the notices were mailed that would have forestalled declaration of the interference, such as a reference for the interference claims applicable to one or to both parties (Rule 237 (b)).

When withdrawing an interference prior to the opening up of the files to the opposing parties the Examiner writes a letter to the Examiner of Interferences requesting the withdrawal of the interference, whereupon the Examiner of Interferences advises the parties that the interference has been withdrawn and returns the files to the Primary Examiner. The Primary Examiner then acts upon the applications as though no interference had been declared. For form see 1112.07.

Throughout the interference, the interference papers and application files involved are in the keeping of the Docket Branch except at such times as hearings on motions, final hearings, appeals, etc., when they are temporarily in possession of the tribunal before whom the particular question is pending.

If, independent of that interference, action as to one or more of the applications becomes necessary, the Examiner requests jurisdiction of the necessary file or files from the Commissioner but first forwards the letter (or letters) to the Supervisory Examiner for approval. See 1111.05 and Form at 1112.06 (a).

If, after the interference has passed the *pro-forma* stage, action by the Primary Examiner becomes necessary relative to the entire interferences, he requests jurisdiction of the interference from the Examiner of Interferences, forwarding the request through the Docket Branch. See form at 1112.06 (b).

The Examiner never asks jurisdiction of a patent file, but merely borrows it if needed, as, where the patent is to be involved in a new interference.

1105 Matters Requiring Decision by Primary Examiner During Interference

An interference may be enlarged or diminished both as to counts and applications involved, or may be entirely dissolved, by actions taken under Rule 232 "Motions to dissolve", Rule 233 "Motions to amend", Rule 234 "Motions to include another application" and Rule 237 "Dissolution on motion of examiner". The burden of proof may be shifted by action taken under Rule 235 "Motions relating to burden of proof". Decisions on questions arising under these rules are made under the personal supervision of the Primary Examiner or the Examiner in charge of the division.

Examiners should not consider *ex parte*, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party in interest. See 1111.01.

If a motion under Rules 232 through 235 is filed, it is examined by the Examiner of Interferences who, if he finds it to be proper in form, will set it for hearing before the Primary Examiner.

A copy of the Interference Examiner's letter to the parties setting the motion for hearing is sent to the examining division wherein the interference originated. The Examiner in charge, Clerk, Typist, or other responsible person in the division is requested to sign a receipt for this notice of hearing. It then becomes the responsibility of the Primary Examiner and

the Clerk of the division to see that the hearing date is not overlooked, since no other notice is given before the hearing. Prior to the time of the hearing the complete file of the interference should be obtained from the Docket Branch and the Primary Examiner or the Examiner in charge of the division and the assistant in charge of the case must be present for the hearing at the set time and place. If their attendance at the indicated time is not feasible the matter should be brought to the attention of the Examiner of Interferences (this may be done orally) at the earliest possible time so that, if a change in the hearing date is necessary, the parties may be given adequate advance notice.

It is advisable to examine the motions which will be heard at least several days prior to the hearing in order to review the subject matter of the interference and to become familiar with the motions which are to be heard.

Occasionally the entire subject matter of the interference has been transferred to another division between the time of declaring the interference and the time of hearing the motion. If this has occurred, after the second division has agreed to take the case, the Docket Branch and Interference Division should be notified so that appropriate changes may be made on their records. Also, the notice of the motion hearing should be returned to the Examiner of Interferences so that it may be forwarded to the new division and the receipt therefor signed.

A further reason for examining the motions prior to the hearing is that it may be desirable to utilize Patentability Report procedure in deciding the motions. If this is the case, the concurrence of the reporting division in the procedure should be secured as soon as possible so that it may be determined whether it is advisable to have the Examiner in charge of the reporting division and his assistant attend the hearing.

1105.01 Briefs and Hearings on Motion

Rule 236. Hearing and determination of motions. (a) The motions specified must contain a full statement of the grounds therefor, and any briefs or memoranda in support thereof or in opposition thereto shall, except as hereinafter provided, be filed in the Patent Office not less than ten days prior to the date of hearing and, if not so filed, consideration thereof may be refused.

(b) If, in the opinion of an examiner of interferences, such motions, and motions of a similar character, be in proper form, they will be set for hearing before the primary examiner, due notice of the day of hearing being given by the Office to all parties. Appearance at the hearing is not required; any party may waive oral hearing and, in lieu of appearance at the hearing, file a reply brief no later than three days following the date of the hearing in addition to his principal brief referred to in paragraph (a). If, in the opinion of the examiner of interferences, the motion be not in proper form or if it be not brought within the time specified and no satisfactory reason given for the delay, it will not be considered and the parties will be so notified. Consideration of matters raised by motion which can be considered at final hearing may, as directed by the Commissioner, be deferred to final hearing.

(c) Setting a motion brought under the provisions of rules 231 to 235 for hearing will act as a stay of proceedings pending the determination of the motion.

(d) In the determination of a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file may be referred to for the purpose of construing the issue.

Concerning briefs on motions, Rule 236 (a) requires that any briefs in support of or in opposition to a motion shall "be filed in the Patent Office not less than ten days prior to the date of hearing". If a party opposes the addition of counts under Rules 233 and 234 "in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing" (Rule 233 (c)). Under Rule 236 (b) "any party may waive oral hearing and, in lieu of appearance at the hearing, file a reply brief no later than three days following the date of the hearing provided he has filed the principal brief referred to in paragraph (a)." Accordingly, if all parties were not represented at the hearing, the Examiner should, before deciding the motions, be certain that he has received any reply briefs which may have been filed.

Rule 244 states that in oral hearings on motions, the moving parties shall have the right to make the opening and closing arguments. It further states that unless otherwise ordered before the hearing begins, oral arguments will be limited to one-half hour for each party. This means that each party has a total of one-half hour to argue all the motions which are to be heard in the interference. Although the moving parties have the right to make the opening and closing arguments, the total time available for each party is only one-half hour and that time must be so apportioned by the moving parties as to leave time for rebuttal arguments, if they care to do so.

The hearing on motions is conducted in a formal manner and, prior to the initial arguments, it is well to advise the parties of the available time and to have the order of the arguments clearly fixed. It may be stated as a general rule that arguments must be limited to those motions which were set for hearing by the Interference Examiner and matters relating thereto, as, for example, a motion to strike a brief on one of those motions. No party has a right to be heard on a motion which was dismissed or deferred to final hearing by the Examiner of Interferences, nor does any party have a right to be heard on a matter which he should have presented by way of a timely motion under Rules 232 through 235 or notice under Rule 233 (c), but failed to do so.

1105.02 Decision on Motion To Dissolve Under Rule 232

Rule 232. Motions to dissolve. (a) Motions to dissolve an interference may be brought on the ground (1) that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) that the claims forming the counts of the interference are not patentable, or are not patentable to a particular applicant, while being patentable to another party, or (3) that a particular party has no right to make the claim, or (4) that there is no interference in fact if the interference involves a design or plant patent or application, or if the interference involves a patent, a claim of which has been copied in modified form.

(b) When one of the parties to the interference is a patentee, no motion to dissolve may be brought by any party on the ground that the subject matter of a count is unpatentable to all parties or is unpatentable to the patentee, except that a motion to dissolve as to the patentee may be brought which is limited to such matters as may be considered at final hearing (rule 258).

(c) Motions to dissolve on the ground that the counts are unpatentable, or are unpatentable to the party bringing the motion, must be accompanied by a proposed amendment to the application of the moving party canceling the claims forming the counts of the interference, which amendment shall be entered by the primary examiner to the extent the motion is not denied, after the interference is terminated.

The Primary Examiner hears and decides motions to dissolve as to some or all of the counts. One or more parties may thus be entirely eliminated from the interference as a result of a decision on a Rule 232 motion; or certain of the counts may be eliminated. Where the interference is dissolved as to one or more of the contestants only, *ex parte* action as to such cases is resumed after the time for requesting reconsideration has expired, while the interference as to the remaining parties continues. The *ex parte* action then taken in each rejected application should conform to the practice set forth hereinafter under the heading "Action After Dissolution" (1110).

It should be noted that if all the parties agree upon the same ground for dissolution, which ground will subsequently be the basis for rejection of the interference count to one or more parties, the interference should be dissolved *pro forma* upon that ground, without regard to the merits of the matter. This agreement among all parties may be expressed in the motion papers, in the briefs, or orally at the hearing. See Buchli v. Rasmussen, 339 O. G. 223; 1925 C. D. 75, and Tilden v. Snodgrass, 1923 C. D. 30; 309 O. G. 477.

Affidavits relating to the disclosure of a party's application as, for example, on the matter of operativeness or right to make, should not be considered but affidavits relating to the prior art may be considered by analogy to Rule 132.

If there is considerable doubt as to whether or not a party's application discloses the subject matter in issue or is operative and it appears that testimony on the matter may be useful to resolve the doubt, a motion to dissolve may be denied so that the interference may continue and testimony taken on the point.

Where the effective date of a patent or publication is antedated by the effective filing dates or the allegations in the preliminary statements of all parties, then the anticipatory effect of that patent or publication need not be considered by the Examiner at this time, but the reference should be considered if at least one party fails to antedate its effective date by his own filing date or the allegations in his preliminary statement. A party's assertion that the date alleged in his preliminary statement antedates the effective date of a patent or publication should be considered authorization for the Primary Examiner to inspect his statement but it must be promptly resealed against inspection by any opposing party and no reference must be made to the exact dates of invention alleged therein beyond the mere statement that the date of the patent or publication is antedated by the allegations in the preliminary statement.

In deciding motions under Rule 232 the Examiner should not be misled by citation of decisions of the Court of Customs and Patent Appeals to the effect that only priority and matters ancillary thereto will be considered and that patentability of the counts will not be considered. These court decisions relate only to

the final determination of priority, after the interference has passed the motion stage; in the ordinary case a motion to dissolve may attack the patentability of the count and need not be limited to matters which are ancillary to priority.

1105.03 Decision on Motion To Amend or To Add or Substitute Other Application Under Rules 233 and 234

Rule 233. Motions to amend. (a) Motions may be brought to amend the interference to put in issue any claims which should be made the basis of interference between the moving party and any other party. When a patent is involved, such claims must be claims of the patent (as provided by rule 205). If the claims are not already in the application of the moving party, the motion must be accompanied by a proposed amendment adding the claims to the application. The preliminary statement for the proposed counts may be required before the motion is considered.

(b) Such motions must, if possible, be made within the time set, but if a motion to dissolve the interference has been brought by another party, such motions may be made within thirty days from the filing of the motion to dissolve. In case of action by the primary examiner under rule 237 (a), such motions may be made within thirty days from the date of the primary examiner's decision on motion wherein an action under rule 237 (a) was incorporated or the date of the communication giving notice to the parties of the proposed dissolution of the interference.

(c) Where a party opposes the addition of such claims in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of the hearing.

(d) The proposed claims must be indicated to be patentable in the opinion of the moving party in each of the applications involved in the motion and must, unless they stand allowed, be distinguished from the prior art of record or sufficient other reason for their patentability given. The reason why an additional count is necessary must be stated and when more than one count is proposed, the motion must point out wherein they differ materially from each other and why each proposed count is necessary to the interference. The proposed claims must also be applied to the disclosure of each application involved in the motion, except as to an application in which the claims already appear and the claims identified as originating therein.

(e) On the granting of such motion and the adoption of the claims by the other parties within a time specified, and after the expiration of the time for filing any new preliminary statements, the Primary Examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include said claims. A preliminary statement as to the added claims need not be filed if a party states he intends to rely on the original statement and such a declaration as to added claims need not be signed or sworn to by the inventor in person. A second motion period will not be set and subsequent motions with respect to such matters as could have been raised during the motion period will not be considered.

Rule 234. Motion to include another application. (a) Any party to an interference may bring a motion to add (subject to the provisions of rule 201 (c)) or substitute any other application owned by him, as to the existing issue; or to include any other application or patent owned by him as to any subject matter disclosed in his application or patent involved in the interference and in an opposing party's application or patent in the interference which should be made the basis of interference between himself and such other party.

(b) Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as set forth in rule 233 for motions to amend.

Motions by the interfering parties may be made under Rules 233 and 234 to add counts to the interference and also to add or substitute other applications owned by them. It should be noted that, if the Examiner grants a motion under Rule 233 and/or Rule 234, he sets a time for the nonmoving parties to present the allowed proposed counts in their applications, if necessary, and also sets a time for all parties to file preliminary statements as to the allowed proposed counts. An illustrative form for these requirements is given at 1105.06. If the claims are made by all parties within the time limit set, the interference is reformed or a new interference is declared by the Primary Examiner.

If a motion under Rule 234 relates to an application in issue, the application should be withdrawn from issue only if the date set for hearing the motion is close to or subsequent to the ultimate date for paying the final fee. For form see 1112.04.

The case should be withdrawn from issue even though the Examiner may be of the opinion that the motion will probably be denied, but this withdrawal does not reopen the case to further ex parte prosecution and if the motion is denied the case is returned to issue with a new notice of allowance.

It will be noted that Rule 234 does not specify that a party to the interference may bring a motion to include an application or patent owned by him as to subject matter, in addition to the existing issue, which is not disclosed both in his application or patent already in the interference and in an opposing party's application

or patent in the interference. Consequently the failure to bring such a motion will not be considered by the Examiner to result in an estoppel against any party to an interference as to subject matter not disclosed in his case in the interference. On the other hand, if such a motion is brought, it may be set for hearing by the Interference Examiner; if so set, it will be considered and decided by the Primary Examiner without regard to the question of whether the moving party's case already in the interference discloses the subject matter of the proposed claims.

Contrary to the practice which obtains when all parties agree upon the same ground for dissolution under Rule 232, the concurrence of all parties in a motion under Rules 233 or 234 does not result in the automatic granting of the motion. The mere agreement of the parties that certain proposed counts are patentable does not relieve the Examiner of his duty to determine independently whether the proposed counts are patentable and allowable in the applications involved. Even though no references have been cited against proposed counts by the parties, it is the Examiner's duty to cite such references as may anticipate the proposed counts, making a search for this purpose if necessary. However, if the decision includes a new ground for holding a proposed count unpatentable, the Examiner should state that reconsideration or rehearing may be requested within the time specified in Rule 244 (c). (Notice of May 29, 1937, Revised.)

Also, care should be exercised in deciding motions under Rules 233 and 234 that any counts to be added to the existing interference are patentably distinct from the original counts and from each other and that counts of additional interferences are likewise patentably distinct from the counts of the first interference and from each other. This practice is not followed when the counts are claims of a patent, since all the patent claims which an applicant can properly make must be included as counts of the interference. The phrase "patentably distinct," as used herein, means sufficiently distinct to support separate patents in the event of a split award of priority.

Affidavits are occasionally offered in support of or in opposition to motions under Rules 233 and 234. The practice here is the same as in the case of affidavits concerning Rule 232 motions, that is, affidavits relating to disclosure of a party's application as, for example, on the matter of operativeness or right to make, should not be considered, but affidavits relating to the prior art may be considered by analogy to Rule 132.

If a motion under Rule 233 or 234 is denied on the basis of a reference which is not a statutory bar, the decision may be modified and the motion granted upon the filing of proper affidavits under Rule 131 in the application file of the party involved. These affidavits should not be opened to the inspection of opposing parties and no reference should be made to the dates of invention set forth therein other than the mere statement that the effective date of the reference has been overcome. As in the case of other affidavits under Rule 131, they remain sealed until the preliminary statements are opened.

1105.04 Decision on Motion Relating to Burden of Proof Under Rule 235

Rule 235. Motions relating to burden of proof. Any party may bring a motion to shift the burden of proof on the ground that he is entitled to the benefit of the filing date of an earlier domestic or foreign application, or on the ground that an opposing party is not entitled to the benefit of an earlier application of which he has been given the benefit in the declaration. (See rule 224.)

The Primary Examiner also decides motions relating to burden of proof under Rule 235.

In deciding a motion of this nature, it is usually advisable first to determine exactly which counts will be involved in the final redeclaration of the interference. The practice in deciding the motion under Rule 235 should then follow that set forth in the case of In re Redeclaration of Interferences Nos. 49,635; 49,636; 49,866; 1926 C. D. 75; 350 O. G. 3.

With respect to the shifting of the burden of proof it should be noted that the order of taking testimony should be placed upon the applicant last to file unless all the counts of the interference read upon an earlier application which antedates that of the other party. A party should not be given the benefit of an earlier application if there is doubt on the matter.

For proving of foreign filing for "Normal" Priority see 201.14, 201.15 and for the determination of rights under Public Law 690 see 201.16.

1105.05 Dissolution on Primary Examiner's Own Motion Under Rule 237

Rule 237. Dissolution on motion of examiner. (a) If, during the pendency of an interference, a reference or other reason be found which, in the opinion of the primary examiner, renders all or part of the counts

unpatentable, the attention of the examiners of interferences shall be called thereto unless the interference is before the primary examiner for determination of a motion. The interference may be suspended and referred to the primary examiner for his determination of the question of patentability, in which case the interference shall be dissolved or continued in accordance with such determination. The consideration of such reference or reason by the primary examiner shall be inter partes as in the case of a motion to dissolve. If such reference or reason be found while the interference is before the primary examiner for determination of a motion, decision thereon may be incorporated in the decision on the motion, but the parties shall be entitled to reconsideration or rehearing if they have not been heard on the matter. (See rule 236)

(b) Prior to the approval of the preliminary statements and notification of the parties thereof (rule 226), an interference may be withdrawn at the request of the primary examiner, in which event the interference shall be considered as not having been declared.

Rule 237 covers dissolution of an interference on the Primary Examiner's own motion if he discovers a reference or other reason which renders all or part of the counts unpatentable. Three procedures are available under this rule:

First, prior to the approval of the preliminary statements the interference may be withdrawn. This is accomplished by a letter from the Primary Examiner to the Examiner of Interferences requesting that the interference be withdrawn. This letter is forwarded to the Docket Branch. The Interference Examiner then sends a letter to the parties informing them that the interference has been withdrawn and that the proceeding is terminated. The Primary Examiner then acts upon the applications as though no interference had been declared. Form at 1112.07.

Second, if the Primary Examiner finds a reference or other reason for terminating the interference in whole or in part while the interference is before him for determination of a motion, decision on this newly discovered matter "may be incorporated in the decision on the motion, but the parties shall be entitled to reconsideration or rehearing if they have not been heard on the matter" (Rule 237). This same practice obtains when the Primary Examiner discovers a new reason for holding counts proposed under Rules 233 or 234 unpatentable. Under this practice, the Primary Examiner should state that reconsideration or rehearing may be requested within the time specified in Rule 244 (c). (Notice of May 29, 1937, Revised.)

Third, if the Primary Examiner finds a reference or other reason for terminating the interference in whole or in part after the preliminary statements have been approved but not while the interference is before him for determination of a motion, he should call the attention of the Examiner of Interferences to the matter. The Primary Examiner should include in his letter to the Interference Examiner a statement applying the reference or reason to each of the counts of the interference which he deems unpatentable and should forward with the original signed letter a copy thereof for each of the parties of the interference. Form at 1112.08. (Notice of June 14, 1938, Revised.)

The Interference Examiner may suspend the interference and refer the case to the Primary Examiner for his determination of the question of patentability, which is *inter partes* as in the case of a motion to dissolve under Rule 232. Briefs may be filed as in the case of a motion under Rule 232 and a hearing will be set. Decision is prepared and mailed by the Primary Examiner as in the case of a motion to dissolve.

If, in an interference involving two or more applications, a reference is brought to the attention of the Examiner by one of the parties to the interference, that fact should be made of record by the Examiner in his letter to the Examiner of Interferences under Rule 237.

If, in an interference involving an application and a patent, the *applicant* calls attention to a reference which he states anticipates the issue of the interference, the Examiner of Interferences will forthwith dissolve the interference, and the Primary Examiner will thereupon reject the claim or claims to the applicant on his own admission of nonpatentability without commenting on the pertinency of the reference. Such applicant is of course also estopped from claiming subject matter not patentable over the issue. A reference cited by the *patentee* will be ignored. A reference newly discovered by the *Primary Examiner* is treated in accordance with 1101.02 (f), Notice of March 15, 1950.

1105.06 Form of Decision Letter

In order to reduce the pendency of applications involved in interference proceedings, Primary Examiners are directed to render decisions on motions within sixty days of the date of hearing. (Extract from Notice of October 23, 1952.)

The decision is prepared on Form POL–78, with carbon copies for the parties on Form POL–78a. Sufficient carbon copies are prepared so that each party or his attorney or agent as indicated on the back of the interference file may be mailed a copy. At the right of the address box should be typed the identification consisting of the interference number and

the last names of the parties, juniormost first. For example: Interference No. 68,561, Smith v. Jones v. Brown.

The decision should be divided into three parts, the heading, the body, and the summary.

The heading should commence with a concise statement of each motion which has been set for hearing. For example:

> The party Brown moves to dissolve on the grounds:
>
> (1) that the counts (or counts 1 and 2) are unpatentable to all parties over the prior art cited;
>
> (2) that the party Jones has no right to make the counts;
>
> (3) that the party Smith is estopped to make the counts.
>
> The party Jones moves to add proposed counts 6, 7, and 8 to the issue.
>
> The party Smith moves to shift the burden of proof.

Next should appear a brief description of the invention at issue in general terms, followed by copies of a representative count or counts and proposed counts. The references cited in the motions may then be listed, particularly those relied upon by the Examiner in his decision.

In the body of the decision each motion which has been set for hearing should be discussed in detail. Decisions on such matters as right to make, operativeness, estoppel, and burden of proof should be particularly complete, since they are often reviewed by the Board of Patent Interferences at final hearings and by the Court of Customs and Patent Appeals on appeal, whereas decisions on matters of patentability over prior art are not subpect to *inter partes* review. Each motion which has been set for hearing must be decided on its merits, except that when a motion to dissolve is granted only the one point resulting in dissolution need be decided if detailed decision on other matters is unduly burdensome.

The arrangement of the body of the decision must be determined by the good judgment of the Examiner. In general, the arguments pro and con should be referred to briefly and disposed of succinctly. The grounds for the decision should be stated clearly. It is usually advisable to make the decision on a motion relating to burden of proof last, after motions under Rules 232, 233, and 234 have been disposed of, since it is easiest to determine burden of proof after the counts finally admitted to the interference have been decided upon.

The summary should state the action taken on every motion set for hearing, being sure that every count put in question and every proposed count is mentioned, and should offer, under penalty, the allowed proposed counts to such of the parties as have not asserted them in their applications, and set the time for filing preliminary statements as to any allowed proposed counts. For example:

> Brown's motions to dissolve as to counts 1 and 2 is granted on grounds 1 and 2 and is denied on ground 3.
>
> Jones' motion under Rule 233 is granted as to proposed counts 6 and 7 and is denied as to proposed count 8.
>
> Smith's motion to shift the burden of proof is granted and the order of the parties is changed to: Jones v. Brown v. Smith.
>
> Should the parties Smith and Brown desire to contest priority as to proposed counts 6 and 7, they should assert them by amendment to their respective applications on or before _____, and failure to so assert them within the time allowed will be taken as a disclaimer of the subject matter thereof.
>
> On or before _____, the statements demanded by Rules 215 *et seq.* with respect to proposed counts 6 and 7 must be filed in a sealed envelope bearing the name of the party filing it and the number and title of the interference. See also Rule 233 (e), second sentence.
>
> No appeal (Rule 244 (d)).

The time periods fixed in the decision for copying allowed proposed counts and for filing preliminary statements should ordinarily be the same and a period of thirty days should suffice in most cases. However, where mailing time is materially longer, as to the West Coast or foreign countries, or when an attorney and inventor are widely separated, this time may be increased to as much as sixty days.

Decisions under Rules 232 through 235 and 237 are signed, dated, and mailed by the Primary Examiner in the same way as *ex parte* cases.

The Clerk of the division makes the entry of the decision in the interference file on the next vacant line of the index. The entry should be, first, the date, followed by "Dec. of Pr. Exr." and "Granted" if all the motions have been granted, "Denied" if all the motions have been denied, or "Granted and Denied" if some motions have been granted and others denied. If a date for copying allowed proposed counts and for filing preliminary statements has been set, this should also be indicated at the end of the line by "Amdt. and Statement due _____."

Appropriate entries should be made on the interference brief in the section entitled "Decisions on Motion" (Form PO–222) in each case involved in the interference. Examples of entries are:

Dissolved.
Dissolved as to counts 2 and 3.
Dissolved as to Smith.
Counts 4 and 5 admitted.

These entries should be verified by the Primary Examiner.

Immediately upon mailing a decision under Rules 232 through 235 and 237 the Examiner should forward the complete interference file to the Interference Division, where special facilities are maintained to insure that the interference is promptly called up for the next step, which may be a redeclaration or the taking of testimony. The complete interference file will be returned to the Examiner for redeclaration at the proper time if such action is necessary. (Notice of January 11, 1935, Revised.)

1105.07 Petition for Reconsideration of Decision

Any petition for reconsideration, rehearing, or modification must be filed within twenty days from the date of the decision (Rule 244 (c)) and, unless this time has been extended (see Rule 245), any such petition filed more than twenty days after the date of the decision should be dismissed.

In the case of requests for reconsideration, decisions thereon should be rendered within thirty days of the filing of such requests. (Extract from Notice of October 23, 1952.)

Action on a petition for reconsideration, rehearing, or modification is similar to the original decision and is likewise signed, dated, and mailed by the Primary Examiner. Appropriate entry should be made on the index of the interference file and the complete interference file should be forwarded immediately to the Interference Division.

1106 Redeclaration of Interferences and Additional Interferences

1106.01 After Decision on Motion

Various procedures are necessary after decision on a motion. The following general rules may be stated:

(1) If the total result of the motion decision consists solely in the elimination of counts, the elimination of parties or a shifting of the burden of proof, no redeclaration is necessary. The motion decision itself constitutes the paper deleting counts or parties and is likewise adequate notice of the shifting of the burden of proof. Where there is no motion decision or other record in the interference, as when jurisdiction of the interference had been requested in order to declare an interference between a new party and the interferants as to some but not all of the counts, it will be necessary to redeclare the interference. For this last purpose the forms at 1112.09 (b) and 1112.09 (c), suitably modified, may be used. See 1106.02.

(2) If the motion decision results in any addition or substitution of parties or applications or the addition or substitution of counts, then redeclaration is necessary. If redeclaration is necessary, the information falling within category (1) should also be included in the redeclaration papers. The old counts should retain their old numbers for ease of identification.

(3) In redeclaring an interference the letter to the Examiner of Interferences should be written on a long (8″ x 12½″) plain sheet of paper and should include in detail all pertinent information and data relating to the redeclaration. Added or substituted counts should be copied. For form see 1112.09 (b).

(4) In redeclaring an interference the letters to the parties should give all proper information relating to the redeclaration, omitting, however, all serial numbers of opposing applications. Parties should be arranged in alphabetical order. Although this precaution may appear to be unnecessary because the parties already have complete information concerning the opposing cases, yet it is essential that it be observed because a third party may properly have access to one of the application files and must not be given any information relative to the other application involved in the interference. New counts need not be copied in the letters to the parties except under such circumstances as would necessitate copying the counts in original declaration letters to the parties. The letters to the parties should be prepared on Form POL–90 with the same number of carbon copies as the original declaration papers. Properly addressed envelopes must be provided. Forms at 1112.09 (c) and 1112.09 (d).

(5) Redeclaration papers must never be mailed by the examining division but must always be forwarded, along with the complete interference file, to the Interference Division.

When the time arrives for redeclaring an interference or declaring a new interference as the result of a motion decision, the Interference Examiner will forward to the Primary Ex-

aminer, through the Docket Branch, the complete file of the interference. If the allowed proposed counts have been copied by the parties to whom they have been suggested in the motion decision, the Examiner proceeds to prepare the redeclaration papers. If one party fails, within the time set, to make the claims which are to be added to the interference issue, the Examiner puts a statement to that effect in a letter to the Examiner of Interferences.

In some instances it may be necessary to declare a new interference as the result of a decision on motions. In such cases a statement should be added to the letter to the Examiner of Interferences (Form PO–221) in the new interference to the following effect:

"This interference is declared as the result of a decision on motions in Interference No. _____."

1106.02 By Addition of New Party by Examiner

Rule 238 states the procedure to be followed when the Examiner finds, or there is filed, other or new applications interfering as to some or as to all of the counts. The procedure when any testimony has been taken differs considerably from the procedure when no testimony has been taken, and this distinction must be observed. Forms at 1112.09 (e) to 1112.09 (l).

If no testimony has been taken and the additional application interferes as to all counts, the Examiner requests jurisdiction of the interference and if granted, adds the new party. If the additional application interferes as to some of the counts only, the Examiner requests jurisdiction of the interference and, on the granting thereof, reforms the interference omitting the counts made by the proposed new party, using the forms at 1112.09 (b) and 1112.09 (c) suitably modified, and forms another interference including the new party, with said omitted counts as the issue. In the latter instance the fact that the issue was in a former interference should be noted in all letters in the new interference. Such action should not be taken, however, if the new application is owned by the assignee of one of the parties already in the interference.

1107 Examiner's Entry in Interference File Subsequent to Interference

An interference is terminated either by dissolution or by an award of priority to one of the parties. In either case the interference is returned with the entire record to the Examiner as soon as the decision or judgment has become final.

After the files have been returned to the examining division the Primary Examiner is required to make an entry on the index in the interference file on the next vacant line that the decision has been noted, such as by the words "Decision Noted" and initialed by him. The interference file is returned to the Docket Branch when the examiner is through with it. The Docket Branch will see that such note has been made and initialed before filing away the interference record. (Order No. 1883, Revised.)

1108 Entry of Amendments Filed in Connection With Motions

This section is limited to the disposition of amendments filed in connection with motions in an application involved in interference, after the interference has terminated.

The manner of treating other amendments which are filed in an application during the course of the interference, is discussed in a separate section (1111.05).

Rule 232 (c) reads as follows:

(c) Motions to dissolve on the ground that the counts are unpatentable, or are unpatentable to the party bringing the motion, must be accompanied by a proposed amendment to the application of the moving party cancelling the claims forming the counts of the interference, which amendment shall be entered by the primary examiner to the extent the motion is not denied, after the interference is terminated.

An amendment accompanying a motion under Rule 232 is placed in the application file but is not entered while the interference continues. After the interference has been terminated, this amendment is entered "to the extent the motion is not denied." Any portion of the amendment corresponding to a denied portion of the Rule 232 motion is not entered and it is so indicated by striking out the portion in pencil.

Under Rule 233 an applicant is required to submit with his motion as a separate paper an amendment embodying the proposed claims if the claims are not already in his application. This amendment is placed in the application file whether the motion is granted or not.

If the motion under Rule 233 is granted the amendment is of course entered. If the motion is not granted, the amendment, though left in the file, is not entered and is so marked.

If the motion under Rule 233 is granted in part and denied in other part, only so much of the amendment as is covered in the grant of the motion is entered, the remaining part being marked "not entered" in pencil as in the treatment of an amend-

ment under Rule 232 that is only partly acceptable. (See Rule 266.)

In each instance the applicant is informed of the disposition of the amendment in the first action in the case following the termination of the interference. If the case is otherwise ready for issue the notice of allowance is sent out concurrently with the letter informing applicant as to the disposition of the amendment.

As a corollary to this practice, it follows that where prosecution of the winning application had been closed prior to the declaration of the interference, as by being in condition for issue, that application may not be reopened to further prosecution following the interference, even though additional claims had been presented under Rule 233. The interference proceeding was not such an Office action as relieved the case from its condition as subject to the doctrine of Ex parte Quayle, 1935 C. D. 11; 453 O. G. 213. (Circular of February 20, 1936, Revised.)

It should be noted at this point that, under the provisions of Rule 262 (d), the termination of an interference on the basis of a disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest filed by an applicant operates without further action as a direction to cancel the claims involved from the application of the party making the same.

1109 Action After Award of Priority

Under 35 U. S. C. 135, the Commissioner may at once issue a patent to the applicant who is adjudged by the Board of Patent Interferences to be the prior inventor, without waiting for appeal by any loser. However, in ordinary cases it is the policy of the Office not to issue a patent to the winning party during the period within which appeal may be taken to the Court of Customs and Patent Appeals, or during the pendency of such appeal. Therefore, the files are not returned to the examining division until after the termination of the appeal period, or the termination of the appeal, as the case may be. Jurisdiction of the Examiner is automatically restored with the return of the files, and the cases of all parties are subject to such ex parte action as their respective conditions may require, even though, where no appeal to the Court of Customs and Patent Appeals, was filed the losing party to the interference may file a suit under 35 U. S. C. 146. The date when the priority decision becomes final does not mark the beginning of a statutory period for response by the applicant. See Ex parte Peterson, 1941 C. D. 8, 525 O. G. 3.

1109.01 The Winning Party

The winning party may be sent to issue despite the filing of a suit under 35 U. S. C. 146 by his opponent.

In the case of the winning party, if his application was not in allowable condition when the interference was formed and has since been amended, or if it contains an unanswered amendment, or if the rejection standing against the claims at the time the interference was formed was overcome by reason of the award of priority, as an interference involving the application and a patent which formed the basis of the rejection, the Examiner forthwith takes the application up for action.

If, however, the application of the winning party contains an unanswered Office action, the Examiner at once notifies the applicant of this fact and requires response to the Office action within a shortened statutory period (40 days) running from the date of such notice. See Ex parte Peterson, 1941 C. D. 8; 525 O. G. 3. This procedure is not to be construed as requiring the reopening of the case if the Office action had closed the prosecution before the Examiner. (See Notice of April 14, 1941, 710.02 (b).)

The winning party, if the prosecution of his case had not been closed, generally may be allowed additional and broader claims to the common patentable subject matter. (Note, however, In re Hoover Co., Etc., 1943 C. D. 338; 553 O. G. 365.) Having won the interference, he is not denied anything he was in possession of prior to the interference, nor has he acquired any additional rights as a result of the interference. His case thus stands as it was prior to the interference. If the application was under final rejection as to some of its claims at the time the interference was formed, the institution of the interference acted to suspend, but not to vacate, the final rejection. After termination of the interference a letter is written the applicant, as in the case of any other action unanswered at the time the interference was instituted, setting a shortened period (with the approval of the Supervisory Examiner) within which to file an appeal or cancel the finally rejected claims.

1109.02 The Losing Party

The application of each of the losing parties following an interference terminated by a judgment of priority is acted on at once. The judgment is examined to determine the basis therefor and action is taken accordingly.

If the judgment is based on a disclaimer, concession of priority, or abandonment of the in-

vention filed by the losing applicant, such disclaimer, concession of priority, or abandonment of the invention operates "without further action as a direction to cancel the claims involved from the application of the party making the same" (Rule 262 (d)). Abandonment of the contest has a similar result. See 1110. The interference counts thus disclaimed, conceded, or abandoned are accordingly cancelled from the application of the party filing the document which resulted in the adverse judgment.

If the judgment is based on grounds other than those referred to in the preceding paragraph, the claims corresponding to the interference counts in the application of the losing party should be treated in accordance with Rule 265, which provides that such claims "stand finally disposed of without further action by the examiner and are not open to further ex parte prosecution." Accordingly, a pencil line should be drawn through the claims as to which a judgment of priority adverse to applicant has been rendered, and the words "Rule 265" should be written in the margin to indicate the reason for the pencil line. If these claims have not been cancelled by the applicant and the case is otherwise ready for issue, these notations should be replaced by a line in red ink and the words "Rule 265" in red ink before passing the case to issue, and the applicant notified of the cancellation by an Examiner's Amendment. If an action is necessary in the application after the interference, the applicant should be informed that "Claims (designated by numerals), as to which a judgment of priority adverse to applicant has been rendered, stand finally disposed of in accordance with Rule 265."

If, as the result of one or both of the two preceding paragraphs all the claims in the application are eliminated, a letter should be written informing the applicant that all the claims in his case have been disposed of, indicating the circumstances, that no claims remain subject to prosecution, and that the application will be sent to the abandoned files with the next group of abandoned applications. Proceedings are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

Except as noted in the next paragraph (judgment based solely on ancillary matters), any remaining claims in each defeated party's case should be reviewed in connection with the winning party's disclosure. Any claim in a losing party's case not patentable over the winning party's disclosure, either by itself or in conjunction with art, should be rejected. However, a losing applicant may avoid a rejection based on *unclaimed* disclosure of a winning *patentee*. When notice is received of the filing of a suit under 35 U. S. C. 146, further action is withheld on the application of the party filing the suit. No letter to that effect need be sent.

When the award of priority is based solely upon ancillary matters, as right to make, and is in favor of the junior party, the claims of the senior party, even though the award of priority was to the junior party, are not subject to rejection on the ground of estoppel, through failure to move under Rule 233 or on the disclosure of the junior party as prior art (Rule 257).

If the losing party's case was under rejection at the time the interference was declared, such rejection is ordinarily repeated (either in full or by reference to the previous action). If it was under final rejection or ready for issue, his right to reopen the prosecution is restricted to subject matter related to the issue of the interference.

Where the losing party failed to get a copy of his opponent's drawing or specification during the interference, he may order a copy thereof to enable him to respond to a rejection based on the successful party's disclosure. Such order is referred to the Chief of the Docket Branch who has authority to approve orders of this nature.

Where the rejection is based on the issue of the interference, there is no need for the applicant to have a copy of the winning party's drawing, for the issue can be interpreted in the light of the applicant's own drawing as well as that of the successful party.

It may be added that rejection on estoppel through failure to move under Rules 233 and 234 may apply where the interference terminates in a judgment of priority as well as where it is ended by dissolution. See 1110. However, Rule 234 now limits the doctrine of estoppel to subject matter in the cases involved in the interference. See 1105.03.

1110 Action After Dissolution

After dissolution of an interference any amendments which accompanied motions to dissolve are entered to the extent that the motions were not denied. See 1108. If the grounds for dissolution are also applicable to the non-moving parties, e. g., unpatentability of the subject matter of the interference, the Examiner should,

on the return of the files to his division, reject in each of the applications of the non-moving parties the claims corresponding to the counts of the interference on the grounds stated in the decision.

Dissolution of an interference on the basis of an abandonment of the contest operates as a direction to cancel the involved claims from that party's application (Rule 262 (d)).

If all the claims in an application are eliminated in accordance with the practice described in the foregoing paragraphs, see the fourth paragraph of 1109.02 for the action to be taken.

Such claims as are unpatentable over the issue of the interference are rejected on that ground.

If following the dissolution of the interference any junior party files claims that might have been included in the issue of the interference such claims should be rejected on the ground of estoppel. The senior of the parties, in accordance with Rule 257, is exempted from such rejection. Where it is only the junior parties to the interference that have common subject matter additional to the subject matter of the interference, the senior one of this subgroup is free to claim this common subject matter. Rule 234 now limits the doctrine of estoppel to subject matter in the cases involved in the interference. See 1105.03.

If an application was in condition for allowance or appeal prior to the declaration of the interference, the matter of reopening the prosecution after dissolution of the interference should be treated in the same general manner as after an award of priority. (See 1109.01 and 1109.02.)

1111 Miscellaneous

1111.01 Interviews

Where an interference is declared all questions involved therein are to be determined *inter partes*. This includes not only the question of priority of invention but all questions relative to the right of each of the parties to make the claims in issue or any claim suggested to be added to the issue and the question of the patentability of the claims.

The Examiners are admonished that *inter partes* questions should not be discussed *ex parte* with any of the interested parties and that they should so inform applicants or their attorneys if any attempt is made to discuss *ex parte* these *inter partes* questions. (Notice of March 2, 1935.)

1111.02 Record in Each Interference Complete

When there are two or more interferences pending in this Office relating to the same subject matter, or in which substantially the same applicants or patentees are parties thereto, in order that the record of the proceedings in each particular interference may be kept separate and distinct, all motions and papers sought to be filed therein must be titled in and relate only to the particular interference to which they belong, and no motion or paper can be filed in any interference which relates to or in which is joined another interference or matter affecting another interference.

The Examiners are also directed to file in each interference a distinct and separate copy of their actions, so that it will not be necessary to examine the records of several interferences to ascertain the status of a particular case.

This will not, however, apply to the testimony. All papers filed in violation of this practice will be returned to the parties filing them. (Order 453, Revised.)

1111.03 Overlapping Applications

Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference, the prosecution of all the cases not in the interference should be carried as far as possible, by treating as prior art not only the counts of the interference, but also the disclosures of all the adverse parties and by forcing the drawing of proper lines of division. In some instances suspension of action by the Office cannot be avoided. See 709.01.

Where an application involved in interference includes, in addition to the subject matter of the interference, a separate and divisible invention, prosecution of the second invention may be had during the pendency of the interference by filing a divisional application for the second invention or by filing a divisional application for the subject matter of the interference and moving to substitute the latter divisional application for the application originally involved in the interference. However, the application for the second invention may not be passed to issue if it contains claims broad enough to dominate matter claimed in the application involved in the interference.

1111.04 "Secrecy Order" Cases

Applications having a secrecy order therein are treated in the same manner as the other applications up to and including the declaration of the interference (see 107). However, after the time for filing preliminary statements has passed the Examiner of Interferences suspends proceedings until modification or rescission of the secrecy order permits access by the parties to the respective applications.

After the declaration of the interference the applications involved are returned to the examining division for safekeeping. It is vitally important that the Examiner of Interferences be immediately notified of any modification or rescission of the secrecy orders so that the interference proceedings may be promptly resumed, if proper.

1111.05 Amendments Filed During Interference

The disposition of amendments filed in connection with motions in applications involved in an interference, after the interference has been terminated, is treated in a separate section (1108).

The manner of treating other amendments which are filed in an application during the course of the interference, is discussed in this section.

When an amendment to an application involved in an interference is received, the Examiner inspects the amendment and, if necessary, the application, to determine whether or not the amendment affects the pending or any prospective interference. If the amendment is an ordinary one properly responsive to the last regular ex parte action preceding the declaration of the interference and does not affect the pending or any prospective interference, the amendment is marked in pencil "not entered" and placed in the file, a corresponding entry being endorsed in ink in the contents column of the wrapper and on the serial and docket cards. After the termination of the interference, the amendment may be permanently entered and considered as in the case of ordinary amendments filed during the ex parte prosecution of the case. (Order 1759, Revised.)

When an amendment filed during interference purports to put the application in condition for another interference either with a pending application or with a patent, the Primary Examiner must personally consider the amendment sufficiently to determine whether, in fact, it does so. If it does, he obtains from the Commissioner jurisdiction of the application for the purpose of setting up the new interference. The Examiner submits his request for jurisdiction to the Supervisory Examiner for approval, assuming of course that the existing interference is still pending before the Board of Patent Interferences. Form at 1112.06 (a).

If the amendment presents allowable claims directed to an invention claimed in a patent or in a pending application in issue or ready for issue, the Examiner requests jurisdiction of the file, as above, setting forth in his request the reason why immediate jurisdiction of the file is required by him, and when the file is received, enters the amendment and takes the proper steps to initiate the second interference.

Where in the opinion of the Examiner, the proposed amendment does not put the application in condition for interference with another application not involved in the interference, the amendment is placed in the file and marked "not entered" and the applicant is informed why it will not be now entered and acted upon. See form at 1112.10. Where the amendment copies claims of a patent not involved in the interference and which the Examiner believes are not patentable to the applicant, and where the application is open to further *ex parte* prosecution, jurisdiction of the file should be obtained, the amendment entered and the claims rejected, setting a time limit for response. If reconsideration is requested and rejection made final a time limit for appeal should be set. Where the application at the time of forming the interference was closed to further *ex parte* prosecution and the disclosure of the application will, *prima facie*, not support the copied patent claims or where copied patent claims are drawn to a nonelected invention, the amendment will not be entered and the applicant will be so informed, giving very briefly the reason for the nonentry of the amendment. See Letter Form 1112.10.

1111.06 Notice of Rule 234 Motion Relating to Application Not Involved in Interference

Whenever a party in interference brings a motion under Rule 234 affecting an application not already included in the interference, the Examiner of Interferences should at the time of setting the motion for hearing send the Primary Examiner a written notice of such motion and the Primary Examiner should place this notice in said application file. (Order 3244, Revised.)

The notice is sent to the Primary Examiner at the time the parties are notified that the Rule 234 motion is set for hearing. The notice is customarily sent to the division which declared the interference since the application referred to in the motion is generally examined in the same division. However, if the application is not being examined in the same division, then the correct division should be ascertained and the notice forwarded to that division.

This notice serves several useful and essential purposes, and due attention must be given to it when it is received. First, the Examiner is cautioned by this notice not to consider *ex parte*, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party in interest. Second, if the application which is the subject of the motion is in issue and the last date for paying the final fee will not permit determination of the motion, it will be necessary to withdraw the application from issue. Form at 1112.04. Third, if the application contains an affidavit under Rule 131, this must be sealed because the opposing parties have access to the application.

1111.07 Conversion of Application From Joint to Sole or Sole to Joint

Although, for simplicity, the subject of this section is titled "Conversion of Application from Joint to Sole or Sole to Joint," it includes all cases where an application is converted to decrease or increase the number of applicants. See 201.03.

If the conversion papers are filed before the preliminary statements are approved and conversion is sought at that time, the Primary Examiner may request jurisdiction of the interference for purpose of effecting the desired conversion or jurisdiction of the interference may be conferred on the Primary Examiner on the Interference Examiner's own initiative. In either event, the matter of effecting the conversion is treated as an *ex parte* matter at this stage and no papers are prepared for the interference file until the conversion is completed and the interference is in condition for redeclaration. If necessary at this time, an *ex parte* letter may be written to the party seeking conversion pointing out any curable defects in the conversion papers and interviews, limited to this matter alone, may also be held. After conversion has been completed, the proper redeclaration papers are prepared and forwarded to the Interference Division.

If conversion is attempted during the motion period, the matter is treated as an *inter partes* matter, subject to opposition, and the Interference Examiner may transmit it to the Primary Examiner for determination, *inter partes*. If conversion is permitted at this stage, redeclaration of the interference is necessary and the proper papers for this purpose are forwarded to the Interference Division.

If conversion is attempted after the close of the motion period but prior to the taking of any testimony, the Interference Examiner may, at his discretion, either transmit the matter to the Primary Examiner for determination or defer consideration thereof to final hearing for determination by the Board of Patent Interferences. If transmitted to the Primary Examiner, the matter is treated as outlined in the preceding paragraph. Forms for converting a joint application to a sole are given at 1112.09 (m) to 1112.09 (p) and these forms may be suitably modified to apply to the situation where an application with three or more applicants is converted to a joint application with a lesser number of applicants or where an application is converted to increase the number of applicants.

If conversion is attempted after the taking of testimony has commenced, the Interference Examiner will generally defer consideration of the matter to final hearing for determination by the Board of Patent Interferences.

In any case where the Examiner must decide the question of converting an application he must, of course, determine whether the legal requirements for such conversion have been satisfied, just as in the ordinary *ex parte* treatment of the matter.

A party may occasionally seek to substitute an application with a lesser or greater number of applicants for the application originally involved in the interference. If this is attempted before the preliminary statements are approved, then the matter may be treated in the same manner as an attempted conversion at this stage. If substitution is attempted during the motion period, then it should be treated as a motion under Rule 234.

1111.08 Reissue Application Filed While Patent Is in Interference

Care should be taken that a reissue of a patent should not be granted while the patent is involved in an interference without approval of the Commissioner.

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the Examiner is taken thereon. (Extract from Order 3193.)

Such an application should be promptly forwarded to the Office of the Solicitor with an appropriate memorandum. A letter with titling relative to the interference is placed in the interference file by the Commissioner and copies thereof are placed in the reissue application and mailed to the parties to the interference. This letter gives notice of the filing of the reissue application and generally includes a paragraph of the following nature:

The reissue application will be open to inspection by the opposing party during the interference and may be separately prosecuted during the interference, but will not be passed to issue until the final determination of the interference, except upon the approval of the Commissioner.

1111.09 Suit Under 35 U. S. C. 146 by Losing Party

When a losing party to an interference gives notice in his application that he has filed a civil action under the provisions of 35 U. S. C. 146, relative to the interference, that notice should be called to the attention of the Docket Branch in order that a notation thereof can be made on the index of the interference. (Notice of January 29, 1930, Revised.)

When notice is received of the filing of a suit under 35 U. S. C. 146, further action is withheld on the application of the party filing the suit. No letter to that effect need be sent.

1111.10 Benefit of Foreign Filing Date

If a request for the benefit of a foreign filing date under 35 U. S. C. 119 or under Section 1 of Public Law 690 is filed while an application is involved in interference, the papers are to be placed in the application file in the same manner as amendments received during interference, and appropriate action taken after the termination of the interference.

A party is not given the benefit of a foreign filing date in the original declaration of an interference, even though favorable action had been stated in previous ex parte prosecution. The party having a foreign filing date may therefore find it desirable or necessary to file a motion to shift the burden of proof under Rule 235 and the matter is then considered on an *inter partes* basis.

1111.11 Patentability Reports

The question of Patentability Reports rarely arises in interference proceedings but the proper occasion therefor may occur in deciding motions. If appropriate, Patentability Report practice may be utilized in deciding motions and the procedure should follow as closely as possible the *ex parte* Patentability Report practice.

1111.12 Certified Copies of Part of an Application

Rule 241. Copies of part of application. **When an application is involved in an interference in which a part only of the invention is included in the issue, the applicant may file certified copies, one for the record and one for each opposing party, of the part or parts of the specification and drawings, and other papers in the file, which exclude merely the noninterfering disclosure, and such copies may be used in the proceedings in place of the complete application.**

The Primary Examiner or Examiner in charge of the division certifies the copies referred to in the preceding rule. This rule applies to earlier applications relied upon by a party as well as applications directly involved in the interference.

Certification should be withheld if the party requesting it does not order the number of copies required by the rule. In order to be eligible for certification, the partial copies must include the file wrapper of the application, all of the original specification, claims, and drawings which bears directly or indirectly on the invention involved in the interference, or is in any way necessary to an understanding thereof, and also all of the Office actions and amendatory papers which fall in this category. Only separate, distinct, and independent matter which does not in any way relate to the subject matter of the interference and is unnecessary to an understanding thereof may be excluded from a copy under Rule 241. Of course, affidavits under Rule 131 and amplified affidavits under Rule 204 of the same character are not included in the Rule 241 copy. See Ex parte Donald W. Kaiser, 1952 C. D. 3; 661 O. G. 10.

When the interference has terminated, any copies under Rule 241 should be returned to the Docket Branch together with the interference file, to be disposed of by the Docket Branch. See 1107.

1111.13 Consultation With Interference Examiner

In doubtful cases, or where the practice appears to be obscure or confused, the Examiner should consult with the Interference Examiner,

since the latter may be able to suggest a course of action which will avoid considerable difficulty in the future treatment of the case.

1112 Letter Forms Used in Interferences

It is obviously impossible to include forms illustrative of every situation which may arise in connection with an interference and this section is necessarily limited to those forms which are used most frequently in interference practice.

For convenience in the preparation and forwarding of the letter forms, under each title the following information is given:

Form No. or type of paper for preparation of form.

Number of copies to be prepared.

Person to whom papers are to be forwarded.

If papers are to be sent to the applicant, patentee, or assignee, and there are joint applicants or patentees or several assignees, copies should be prepared for each of the joint applicants or patentees and each of the several assignees. Also, if two copies are to be sent to attorneys in government-owned cases, two copies should be prepared for such attorneys.

1112.01 Letter to Law Examiner Submitting Proposed Interference for Correspondence Under Rule 202

(Short (8″ x 10½″) letterheads.)
(Original and carbon copy, both signed.)
(Forward both to Law Examiner.)

(Date.)

SIR: Conflict is found to exist between the following applications and it is proposed to suggest claims as indicated below:

268,554	J. L. Brown.
307,819, division of 203,503	T. A. Smith.
165,202	F. A. Jones.

The application of Jones is ready for allowance. (If no application is ready for allowance, indicate that fact.)

Respectfully,

_____ _____,
Examiner.

GREEN,
Assistant Examiner.

Brown 2-12-33	*Smith* 10-13-33 Div. of 11-21-32	*Jones* 3-15-32
Yes	Yes [1]	3.
Yes	No [1]	55.
No	1	Yes.
Yes	2	Yes.
3	Yes	No.

[1] In using the above form, type the word "yes" opposite each claim under the name of each applicant who can make the claim and "no" under each who cannot.

1112.02 Letter Suggesting Claims for Interference

(Form POL 90)

(Original for application file, carbon copy for attorney or agent of record.)

(To be mailed by examining division)

The following claims, found allowable, are suggested for purpose of interference. Applicant should make same by _____ (allow not less than 30 days) under the provisions of Rule 203; failure to do so will be considered a disclaimer of the subject matter involved:

(Copy claims, without numerals.)

_____ _____,
Examiner.

1112.03 Same Attorney or Agent in Applications of Conflicting Interests

(Form POL 90)

(Original for each application file, carbon copies for attorney or agent of record, each applicant, and each assignee)

(To be mailed by examining division)

Attention is called to the fact that the attorney (or agent) in this case is also the attorney (or agent) in an application of another party and of different ownership claiming substantially the same patentable invention as claimed in the above identified application.

_____ _____,
Examiner.

Copies to:
Applicant.
Assignee.

1112.04 Letter Requesting Withdrawal From Issue

(Short (8″ x 10½″) letterhead or plain paper.)
(Original for application file.)
(Forward to Supervisory Examiner.)
Application of) (Date)
John Doe)
Serial No. 85,963)
Washing Machine) Withdrawal from Issue
Filed Feb. 14, 1933)
Allowed Mar. 6, 1935)

Hon. Commissioner of Patents:

SIR: It is requested that the above-entitled application be withdrawn from issue for the purpose of (a), (b), (c), (d), (e), (f), (see below), or (other stated reason).

The final fee has not (or has) been paid.

Respectfully,

_____ _____,
Examiner.

(a) Interference, another party having made claims suggested to him from this application.

(b) Interference, applicant having made the claims suggested to him.

(c) Interference on the basis of claims _____ (Specify claims) _____ copied from Pat. No. _____.

(d) Rejecting claims _____ (specify claims) _____ on the implied disclaimer resulting from failure to make the claims suggested to him, under Rule 203.

(e) Informing applicant that the claims cannot be allowed him because correspondence under Rule 202 has developed the fact that applicant is not the first inventor of their subject matter.

(f) Deciding a motion under Rule 234 involving this application, the date set for hearing the motion being subsequent to the ultimate date for paying the final fee.

1112.05 Declaration Papers

1112.05 (a) Letter to Examiner of Interference

(Form PO–221)

(Original for interference file, carbon copy may be prepared for retention in examining division)

(Forward to Interference Division)

Prepared by properly filling in the blanks on this form, setting forth all of the counts and adding a table showing the relationship of the counts to claims of the various parties. The counts should be checked against the original claims and the words "Counts compared" placed at the end of the letter to show that the counts had been compared with the claims. See 1102.01 (a).

1112.05 (b) Declaration Papers Where One of the Parties Has Two Applications. Both Junior or Both Senior (In Effective Filing Dates) to the Other Party

In the letter to the Examiner of Interference (Form PO–221) the complete information of all applications should be given, designating the two applications of the common inventor by letter. The tabulation of the counts should be in the following form:

Counts:	*Jones*	*Smith (A)*	*Smith (B)*
1	5	5	-------
2	7	6	-------
3	8	------	3
4	9	------	7

This same tabulation is copied in each of the letters to the parties (Form POL–76), being certain to arrange the parties in alphabetical order. The identification "Case A" is added to the right of the address box in the letter (Form POL–76) for that application of Smith and that letter, after the printed portion, reads as follows:

Presented in claims 5 and 6 of this application.

The identification "Case B" is added to the right of the address box in the letter (Form POL–76) for Smith's other application and that letter, after the printed portion, reads as follows:

Presented in claims 3 and 7 of this application.

The letters to the parties must clearly indicate that two Smith applications are involved in the interference and any differences in the two cases should be indicated.

1112.05 (c) Letter to Each Party (Interference Notice)

(Form POL–76)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

Do not give serial number or filing date of any other applicant

(Forward to Interference Division)

The interference number and date for filing the preliminary statement will be filled in by the Examiner of Interferences.

After printed matter reading, "The subject matter involved in the interference is" continue as follows: presented in claims 8 and 10 of this application (or patent).

Your application, above identified, is a division (or continuation) of Serial No. ------, filed ------. (See Rule 207 (a).)

The interference involves your application (or patent) above identified and applications filed by:

(Typist: the first alphabetical name)

John Brown, of Akron, Ohio, whose Post Office address is Municipal Building, Akron, Ohio, whose attorney is Jas. Robb, 36 Euclid Avenue, Cleveland, Ohio, whose associate attorney is Robert Horn, Press Building, Washington, D. C., and whose assignee is the Garden Implement Company, of Cleveland, Ohio.

(Typist: the second alphabetical name)

Thomas Smith, ------ etc. ------.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	*Brown*	*Smith*	*Taylor*
1	3	23	8
2	4	24	10

(Typist: note alphabetical arrangement of parties.)

Counts compared.

(Insert appropriate paragraph or paragraphs hereinafter.)

——— ———,
Examiner.

Copies to:

(See Rule 209 (b).)

(A) To party or parties not otherwise ready for allowance add:

(1) "After termination of the interference this application will be held subject to further examination under Rule 266."

(2) "Claims ------ will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant."

(B) To party ready for allowance, and if applicable, add:

Paragraph (A) (2), above.

1112.06 Requests for Jurisdiction

1112.06 (a) Request for Jurisdiction of Application Involved in Interference

(Short (8″ x 10½″) Letterhead or plain paper.)

(Original for application file.)

(Forward to Supervisory Examiner.)

This form is used when it is desired to take action solely on an application involved in an interference, without disturbing the existing interference.

Application of John Smith
Serial No. 85,963
Spraying Machine
Filed Feb. 14, 1933

(Date)

Request for Jurisdiction

Hon. Commissioner of Patents:

SIR: Jurisdiction of the above-entitled application, now involved in Interference No. 44,444, Andrews [1] v. Smith,[1] is requested for the purpose of (a), (b), (c), (d), or (other reason).

(State briefly any further necessary information.)

Respectfully,

——— ———,
Examiner.

(a) Suggesting claims thereto for interference with another party and of entering such claims if made, and of declaring such additional interference.

(b) Entering an amendment which puts the application in condition for another interference, and of declaring such other interference.

(c) Declaring another interference, another party having made claims suggested to him from this application.

(d) Entering and taking action on claims copied from Patent No. ------ to ------, with which applicant requests an interference.

1112.06 (b) Request for Jurisdiction of Interference

(Short (8″ x 10½″) Letterhead or plain paper.)

(Original for interference file.)

(Forward to Docket Branch.)

This form is used when it is desired to take action in the interference which will result in alteration of the existing interference.

[1] Note alphabetical arrangement.

Interference No. 45,678, Henry Brown v. John Smith and Edward Green

Request for Jurisdiction

Examiner of Interferences:

SIR: Jurisdiction of the above-entitled interference is requested for the purpose of (a), (b), (c), or (other reason).

Respectfully,

_____ _____,
Examiner.

(a) Adding, under the provisions of Rule 238, a new party who has made the claims which are the issue of the above interference.

(May be used only prior to the taking of testimony. If any testimony has been taken, see Rule 238, and forms at 1112.09 (j) to 1112.09 (l).)

(b) Striking out count 2 which will form the basis of a new interference.

(c) Converting the joint application of Smith and Green to a sole application of Smith (or substituting a sole application of Smith for the joint application of Smith and Green; or converting the sole application of Smith to a joint application of Smith and Green; or substituting a joint application of Smith and Green for the sole application of Smith).

(May be used only prior to the approval of the preliminary statements. If conversion or substitution is attempted at a later date see 1111.07.)

1112.07 Withdrawal of Interference Under Rule 237 (b)

(Short (8″ x 10½″) letterhead or plain paper.)

(Original for interference file.)

(Forward to Docket Branch.)

This form may be used only prior to the approval of the preliminary statements and must not be used thereafter. Thereafter proceedings must be in accordance with Rule 237 (a). (See "Letter Forms Used in Interferences," 1112.08.)

(Date.)

Interference No. ____)
Henry Brown)
v.) Withdrawal
John Smith)

Examiner of Interferences:

SIR: The above identified interference, in which preliminary statements have not been approved, is hereby withdrawn in view of a newly discovered reference which anticipates all the counts in issue.

Respectfully,

_____ _____,
Examiner.

1112.08 Primary Examiner Initiating Dissolution of Interference Rule 237 (a)

(Short (8″ x 10½″) letterhead or plain paper.)

(Original for interference file, carbon copy for each party.)

(Forward to Docket Branch.)

This form is to be used after the approval of the preliminary statements (if preliminary statements have not been approved, interference should be withdrawn—see Rule 237 (b) and form at 1112.07) and need not be used if the interference is before the Primary Examiner for determination of a motion.

This form is also to be used when a reference is found for a claim of a patent involved in interference. See 1101.02 (f).

(Date.)

Examiner of Interferences:

SIR: Under the provisions of Rule 237 your attention is called to the following patents:

Chambers	169,520	Nov. 2, 1875	91–18
Meyers	248,764	Jan. 11, 1912	91–24

Counts 1 and 2 of Interference No. 45,678, Brown v. Smith, are considered unpatentable over either of these references.

(Apply the references to the affected counts in sufficient detail to enable the parties to argue the matter properly.)

Respectfully,

_____ _____,
Examiner.

1112.09 Redeclaration

1112.09 (a) Redeclaring an Interference Pursuant to a Decision on Motions

A greater variety of letters falls within this category than any other group. It is impossible to reproduce letter forms which will cover every situation and it will therefore frequently be necessary for the Examiner to compose his own letters. In the following forms a relatively complex redeclaration is illustrated, with cer-

tain counts stricken out, other counts added, an application substituted, and the burden of proof shifted. Simpler redeclarations will necessitate deletion of portions of these forms; more complex redeclarations will require longer letters. The general rule should be observed of giving the Examiner of Interferences complete information in detail of any change in the interference and giving the parties the same information except that all reference to serial numbers or relative filing dates must be omitted.

1112.09 (b) Redeclaration After Decision on Motion, Letter to Examiner of Interferences

(Long (8" x 12½") plain sheet.)
(Original for interference file, carbon copy may be prepared for retention in examining division.)

(Forward to Interference Division)

IN RE INTERFERENCE No. ____,
JONES v. BROWN v. SMITH

Examiner of Interferences:

SIR: Pursuant to the motion decision of the Primary Examiner dated _____, (Date) the above entitled interference is hereby redeclared as follows:

Count 2 is stricken out, and the following counts are added:

Count 4 (Green's proposed count B) (Copy count).

Count 5 (Smith's proposed count 9) (Copy count).

The application of Thomas W. Green for a Hand Plow, Serial No. 333,333, filed October 19, 1936, (division of Serial No. 222,222, filed June 23, 1935, patented November 14, 1937, No. 2,142,794), whose Post Office address is Municipal Building, Akron, Ohio, whose attorney is Jas. Robb, 36 Euclid Avenue, Cleveland, Ohio, whose associate attorney is Robert Horn, Press Building, Washington, D. C., and whose assignee is the Garden Implement Company, of Cleveland, Ohio, is substituted for the application of Brown formerly involved in the interference.

In view of the granting of the motion to shift the burden of proof by the party Jones, the order of the parties is now Green v. Smith v. Jones.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	*Green*	*Smith*	*Jones*
1	23	2	11
3	25	8	29
4	26	19	42
5	27	20	43

Counts compared.

_____ _____,
Examiner.

1112.09 (c) Redeclaration After Decision on Motion, Letter to Each Retained Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

Pursuant to the motion decision of the Primary Examiner dated _____, (Date) Interference No. _____ is hereby redeclared as follows:

Count 2 is stricken out, and counts 4 and 5, which are presented in claims 19 and 20 (or 42 and 43 in the case of the other retained application) of this application are added.

The application of Thomas W. Green, whose Post Office address is Municipal Building, Akron, Ohio, whose attorney is Jas. Robb, 36 Euclid Avenue, Cleveland, Ohio, whose associate attorney is Robert Horn, Press Building, Washington, D. C., and whose assignee is the Garden Implement Company, of Cleveland, Ohio, is substituted for the application of Brown formerly involved in the interference.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	*Green* [1]	*Jones* [1]	*Smith* [1]
1	23	11	2
3	25	29	8
4	26	42	19
5	27	43	20

Counts compared.

_____ _____,
Examiner.

Copies to:
(See Rule 209 (b).)

[1] Note alphabetical arrangement.

1112.09 (d) Redeclaration After Decision on Motion, Letter to New Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

Pursuant to the motion decision of the Primary Examiner dated _____ (Date), your application above identified is hereby substituted in Interference No. _____ for the application of Brown formerly involved therein.

The subject matter of the interference is presented in claims 23, 25, 26, and 27 of this application.

Your application, above identified, is a division of Serial No. 222,222, filed June 23, 1935, patented November 14, 1937, No. 2,142,794 (See Rule 207 (a).)

The interference involves your application above identified and applications filed by:

John Jones,[1] whose Post Office address is _____, whose attorney is _____ whose associate attorney is _____, and whose assignee is _____,

William Smith [1] _____ etc. _____

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	*Green* [1]	*Jones* [1]	*Smith* [1]
1	23	11	2
3	25	29	8
4	26	42	19
5	27	43	20

Counts compared.

_____ _____,
Examiner.

Copies to:
(See Rule 209 (b).)

An interference brief (Form PO–222) must also be prepared for the application file of the new party.

It is unnecessary to prepare a letter for the party who is being eliminated from the interference, since the motion decision is adequate notice to him and the entry on the interference brief (Form PO–222) of his case indicates that he was eliminated from the interference.

[1] Note alphabetical arrangement.

1112.09 (e) Adding a Party Under Rule 238, No Testimony Taken

If *no testimony has been taken* it is necessary to first request the Examiner of Interferences for jurisdiction of the interference (see 1112.06 (b)); thereafter the interference may be redeclared as follows:

1112.09 (f) Adding a Party (No Testimony Taken), Letter to Examiner of Interferences

(Long (8″ x 12½″) plain sheet.)
(Original for interference file, carbon copy may be prepared for retention in examining division.)

(Forward to Interference Division)

Examiner of Interferences:

SIR: In accordance with the provisions of Rule 238, the application of Andrew Jones, Serial No. _____ filed _____ for _____, whose Post Office address is _____, whose attorney is _____ and whose assignee is the X. Y. Z. Company of _____ is hereby added to the Interference Brown v. Smith, declared March 5, 1936, No. 45,678.

The order of the parties is now as follows: Jones v. Brown v. Smith.

The issue of the interference remains the same.

The claims of the Jones application corresponding to the issue are:

Counts:	*Jones*
1	3
2	4

Respectfully,

_____ _____,
Examiner.

Counts compared.

1112.09 (g) Adding a Party (No Testimony Taken), Letter to Each Original Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

In accordance with the provisions of Rule 238 the application filed by Andrew Jones, whose

Post Office address is _____, whose attorney is _____, and whose assignee is the X. Y. Z. Company of _____, is hereby added to Interference No. 45,678, Brown[1] v. Smith[1] to which you are a party. The claims of the Jones application corresponding to the issue are:

Counts:	*Jones*
1	3
2	4

The new party is given until _____ within which to file the preliminary statement required by Rules 215 *et seq.*

The issue of the interference remains unchanged.

_____ _____,
Examiner.

Counts compared.
Copies to:
(See Rule 209 (b).)

1112.09 (h) Adding a Party (No Testimony Taken), Letter to New Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

In accordance with the provisions of Rule 238 your case above identified is hereby added to Interference No. 45,678 in which no testimony has been taken.

The preliminary statement required by Rules 215 *et seq.* must be filed on or before _____.

The subject matter of the interference is presented in claims 3 and 4 of this application.

The interference involves your case above identified, and

The application filed by Henry Brown,[1] whose Post Office address is _____, whose attorney is _____, and whose assignee is _____.

The application filed by William Smith,[1] _____ etc.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	*Brown*[1]	*Jones*[1]	*Smith*[1]
1	5	3	8
2	6	4	9

_____ _____,
Examiner.

Counts compared.
Copies to:
(See Rule 209 (b).)

[1] Note alphabetical arrangement.

1112.09 (i) Adding a Party Under Rule 238, Testimony Taken

If *testimony has been taken*, it is not necessary for the examiner to first request jurisdiction of the interference and the forms used are different, as follows:

1112.09 (j) Adding a Party (Testimony Taken), Letter to Examiner of Interferences

(Long (8" x 12½") plain sheet)

(Original for interference file, carbon copy may be prepared for retention in examining division.)

(Forward to Interference Division)

Examiner of Interferences:

SIR: It is requested that the application of Andrew Jones, Serial No. _____, filed _____, for _____, whose Post Office address is _____, whose attorney is _____ and whose assignee is the X. Y. Z. Company of _____ be added to the interference of Brown v. Smith, declared Jan. 5, 1936, No. 45,678, in which testimony has been taken.

The order of the parties will then be as follows: Jones v. Brown v. Smith.

The issue of the interference remains unchanged.

The claims of the Jones application corresponding to the issue are:

Counts:	*Jones*
1	3
2	4

Respectfully,

_____ _____,
Examiner.

Counts compared.

1112.09 (k) Adding a Party (Testimony Taken), Letter to Each Original Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

An application for patent has been filed by Andrew Jones, whose Post Office address is

_____, whose attorney is _____, and whose assignee is the X. Y. Z Company of _____, claiming the subject matter of interference No. 45,678, Brown [1] v. Smith,[1] to which you are a party. The claims of Jones' application corresponding to the counts of the issue are:

Counts:	*Jones*
1	3
2	4

Written objections to the admission of the above entitled application to the interference, with proof of service on the proposed new party as well as the present parties, will be considered if filed on or before _____.

The issue of the interference remains unchanged.

_____ _____,
Examiner.

Counts compared.
Copies to:
(See Rule 209 (b).)

1112.09 (l) Adding a Party (Testimony Taken), Letter to New Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

Your case, above identified, is adjudged to interfere with others, hereinafter specified, which are now involved in an Interference No. 45,678, in which testimony has been taken.

Written objections of the present parties to your admission to the interference, with proof of service upon you, will be considered if filed on or before _____.

The subject matter of the interference is presented in claims 3 and 4 of this application.

The parties to the interference are:

Henry Brown,[1] whose Post Office address is _____ whose attorney is _____, whose assignee is Roe Manufacturing Company of _____, and

John Smith [1] _____ etc.

[1] Note alphabetical arrangement.

The relation of your claims and of the claims of the parties to the counts of the issue is as follows:

Counts:	*Brown* [1]	*Jones* [1]	*Smith* [1]
1	5	3	8
2	6	4	9

_____ _____,
Examiner.

Counts compared.
Copies to:
(See Rule 209 (b).)

1112.09 (m) Conversion of Joint Application to Sole During Interference

The following letter forms, 1112.09 (n) to 1112.09 (p), may be suitably modified to be used in connection with other conversions decreasing or increasing the number of applicants in an application.

1112.09 (n) Letter to Examiner of Interferences

(Long (8" x 12½") plain sheet.)
(Original for interference file.)
(Forward to Interference Division.)

Examiner of Interferences:

SIR: Interference No. 74,819, Wheat and Tomlin v. Butler, is hereby reformed by changing the party Wheat and Tomlin as joint inventors to Wheat as sole inventor.

The counts remain the same.

Respectfully,

_____ _____,
Examiner.

1112.09 (o) Changing Joint to Sole, Letter to Resulting Sole Party

(Form POL 90)

(Original for application file, carbon copies in accordance with Rule 209 (b).)

(Forward to Interference Division)

The amendment with new oath and a disclaimer identifying this application as the sole invention of Wheat formerly having status as a joint inventor in the case, has been entered.

Interference No. 74,819, Butler [1] v. Wheat [1] and Tomlin, involving the above identified application is hereby reformed, the party Wheat

and Tomlin being changed from Wheat and Tomlin as joint inventors to Wheat as sole inventor. The counts remain the same.

_____, *Examiner.*

Copies to:
(See Rule 209 (b).)

1112.09 (p) Changing Joint to Sole, Letter to Other Party

(Form POL 90)

(Original for application or patent file, carbon copies in accordance with Rule 209 (b))

(Forward to Interference Division)

Interference No. 74,819, Butler[1] v. Wheat[1] and Tomlin, involving the above identified application is hereby reformed, the party Wheat and Tomlin as joint inventors being changed to Wheat as sole inventor.

The counts remain the same.

_____, *Examiner.*

Copies to:
(See Rule 209 (b).)

[1] Note alphabetical arrangement.

1112.10 Letter Denying Entry of Amendment Seeking Further Interference

(With application or patent not involved in present interference)

(Form POL 90)

(Original for application file and carbon copy for attorney)

(To be mailed by examining division)

The amendment filed _____ (Date) has not now been entered since it does not place the case in condition for another interference.

(Follow with appropriate paragraph, e. g., (a) or (b).)

(a) Applicant has no right to make claims _____ because (state reason briefly). (Use where applicant cannot make claims for interference with another application or where applicant clearly cannot make claims of a patent.) (b) Claims _____ are directed to a species which is not presently allowable in this case.