



Mail Stop Interference
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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FRANCIS **BARANY**,
GEORGE BARANY, ROBERT P. HAMMER,
Junior Party
(Application 09/986,527),

v.

GLENN H. **McGALL**,
CHARLES G. MIYADA, MAUREEN T. CRONIN,
JENNIFER D. TAN, and MARK S. CHEE
Senior Party
(Patent 6,156,501).

Patent Interference No. 105,351
(Technology Center 1600)

1 **Decision - Interlocutory Motion**

2 Barany seeks reconsideration of the oral decision that this interference
3 will proceed to the priority phase. The request is denied.

4 **History**

5 During the prosecution of its Application 09/986,527, Junior Party
6 Barany requested that an interference be set up with Senior Party McGall's
7 Patent 6,156,501. Application 09/986,527, Showing by Applicant under 37
8 CFR § 1.608(b), filed January 28, 2002. At that time, the application had
9 not been examined. After lengthy prosecution before the examiner, this

1 should be entered against McGall because (1) since McGall's claims are
2 unpatentable there no longer is an interference-in-fact between the parties;
3 (2) 35 U.S.C. § 102(g) is not a legal impediment to the issuance of Barany's
4 patent and (3) McGall has not actively participated in the interference.

5 **Analysis**

6 The board has broad discretion to decide how an interference will
7 proceed. Thus 37 CFR § 41.104(a) provides:

8 (a) The Board may determine a proper course of conduct
9 in a proceeding for any situation not specifically covered
10 by this part and may enter non-final orders to administer
11 the proceeding.

12 The board also decides which motions may be filed and the order in which
13 the motions will be decided. 37 CFR §§ 41.121 and 41.125(a). Ultimately
14 what issues will be decided depends on a case-by-case analysis.

15 There are circumstances where an interference will be terminated
16 without reaching priority. The board's rules identify three narrow threshold
17 issues that may result in termination of the interference without reaching
18 priority: (1) no interference-in-fact; (2) where a party-applicant's interfering
19 claims are barred by the opponent's patent claims under 35 U.S.C. § 135(b)
20 and (3) where an applicant adds claims to provoke an interference and the
21 added claims do not have written descriptive support. 37 CFR § 41.201.

22 Each of these situations provide a strong reason to stop the
23 interference without reaching priority. A holding of no interference-in-fact
24 says the parties are claiming patentably distinct subject matter. Since the
25 parties are not claiming the same invention, who is first to invent is
26 irrelevant.

27 A holding that that a party-applicant's claims are barred by the party-
28 patentee's claims under § 135(b) says because of applicant's tardiness in

1 claiming interfering subject matter, he will not be permitted to challenge the
2 patentee's right to the patent claims by means of an interference. Between
3 the two parties, who is the first inventor simply does not matter.

4 When claims added to provoke the interference do not have written
5 descriptive support, the provoking party, in effect, got into the interference
6 under false pretenses. Since the applicant's original specification never
7 conveyed possession of the interfering subject matter, it is inappropriate and
8 manifestly unfair to allow the applicant to attempt to challenge the
9 patentee's rights.

10 There are of course, additional situations where it would be
11 appropriate to exercise discretion to terminate the interference without
12 reaching priority. For example, where all of a Junior Party patentee's claims
13 are held to be unpatentable, there would appear to be little reason to evaluate
14 priority. A patent versus application interference may be considered as a
15 proceeding to assist the examiner in deciding whether the patent stands in
16 the way of allowing the application to issue. The fact that the patent claims
17 are unpatentable and the patentee is presumptively the second inventor
18 would seem to provide the examiner with the answer that the patent is not an
19 impediment to allowing the application to issue. On the other hand, it is
20 possible that the patentee might be able to present a convincing factual story
21 that priority should be determined notwithstanding unpatentability of the
22 claims and the presumption that the patentee is the second inventor.¹

¹ Interferences have been resolved on the basis of unpatentability without deciding priority (*Berman v. Housey*, 291 F.3d 1345 (Fed. Cir. 2002)); on the basis of the patentability of less than all of the claims (*Noelle v. Lederman*, 355 F.3d 1343 (Fed. Cir. 2004)); on the basis of priority without deciding patentability (*In re Sullivan*, 362 F.3d 1324 (Fed. Cir. 2004)) and on the basis

1 Barany argues that since McGall’s claims are unpatentable there is no
2 interference-in-fact.

3 Barany’s argument misapprehends the meaning and purpose
4 “interference-in-fact.”

5 The determination of an interference-in-fact involves a comparison of
6 the parties’ claimed subject matter to determine if they are claiming
7 patentably indistinct subject matter. The interference-in-fact question is “are
8 the parties claiming the same invention?” As defined in 37 CFR § 41.203(a)
9 the parties claim interfering inventions when “the subject matter of a claim
10 of one party would, if prior art, have anticipated or rendered obvious the
11 subject matter of a claim of the opposing party and vice versa.” The
12 existence of an interference-in-fact under the rule, however, does not depend
13 on patentability over the prior art or under 35 U.S.C. § 112. The holding
14 that McGall’s claims are unpatentable does not mean that the subject matter
15 claimed by the parties’ is not directed to the same invention. And Barany,
16 having suggested the interference, is not in a position to argue that its claims
17 do not interfere with McGall’s.

18 Patentability of the claims is important, not for the existence of
19 interfering subject matter, but as a prerequisite to an evaluation of whether
20 there is interfering subject matter. Prior to initiating an interference,
21 examination must be complete and each party must have an allowable claim.
22 37 CFR § 41.102. Whether an interference in fact exists is simply not
23 considered until after examination is complete and the claims are allowable.

24 The holding that McGall’s claims are unpatentable does not establish
25 no interference-in-fact.

of both priority and patentability (*Perkins v. Kwon*, 886 F.2d 325 (Fed. Cir. 1989)).

1 Barany also argues that McGall is no longer an impediment to the
2 issuance of a patent to Barany under 35 U.S.C. § 102(g).

3 Section 102(g) in relevant part states:

4 A person shall be entitled to a patent unless - . . . (g)(1)
5 during the course of an interference . . . another inventor
6 involved therein establishes. . .that before such person's
7 invention thereof the invention was made by such other
8 inventor and not abandoned, suppressed, or
9 concealed,

10
11 McGall's benefit application is a conception and constructive reduction to
12 practice of everything described and enabled in the specification. *See*
13 *Stevens v. Tamai*, 366 F.3d 1325,1330-31 (Fed. Cir. 2004); *Hyatt v. Boone*,
14 146 F.3d 1348, 1352 (Fed. Cir. 1998); *Kawai v. Metlesics*, 480 F.2d 880,
15 885-86 (CCPA 1973). McGall's accorded benefit date is earlier than
16 Barany's effective filing date. Thus, McGall is the presumptive first
17 inventor of the subject matter described and enabled in McGall's patent.
18 37 CFR § 207(a).

19 Barany has not established, in this interference proceeding, that it
20 made the invention of the count before McGall's date of invention, i.e.,
21 McGall's accorded filing date, as required by 35 U.S.C. § 102(g). Barany's
22 ex parte submissions under 37 CFR § 1.608(b) (2002) (Application
23 09/986,527, Showing by Applicant under 37 CFR § 1.608(b), filed January
24 28, 2002) were sufficient to have the interference declared and avoid
25 summary judgment under 37 CFR § 1.617 (2002). However, Barany has not
26 yet submitted proofs that meet the requirements of the current interference
27 rules. Additionally, McGall has not had an opportunity to cross examine
28 Barany's witnesses or to submit proofs of his own.

1 On or before March 9, 2009, or within fourteen days of the filing of
2 Barany's motion for priority, which ever is later, McGall shall file a paper
3 advising the board if it intends do any of the following: (1) cross-examine
4 Barany's witnesses; (2) file its own motion for priority or (3) file an
5 opposition to Barany's priority motion.

/Richard E. Schafer/
Administrative Patent Judge

cc (via electronic filing):

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