APJ Richard Torczon
BOX INTERFERENCE
WASHINGTON DC 20231
Tel: 703-308-9797
Fax: 703-305-0942

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

NOELLE
(0*/***,***),

Junior Party,

v.

ARMITAGE,
(0*/***,***),

Senior Party.

Patent Interference No. 104,724

ORDER
(CHANGE IN ASSIGNED ADMINISTRATIVE PATENT JUDGE;
CONSIDERATIONS IN SEEKING SUSPENSION)

INTRODUCTION

This case was transferred to avoid a prospective conflict of interest. The parties also wanted to explore options for suspending the interference.

DISCUSSION

The parties initiated a telephone conference to discuss scheduling issues. At the time, they noted that the case had been transferred to a different administrative patent judge. The original administrative patent judge became aware of press reports that one real party-in-interest was pursuing a merger that might have created a conflict of interest for that administrative patent

judge. This event illustrates how important it is for parties to ensure that the statements of real party-in-interest are both complete and up-to-date. It is difficult for administrative patent judges to avoid conflicts that they do not know about.

The parties noted that because of the merger, as well as an appeal in a related interference, there would be some merit in suspending the interference. Both parties are applicants. Hence, a suspension would effectively be an extension of any resulting patent term.[1] Ordinarily, the agency regards suspensions with extreme disfavor. In view of this sentiment, the parties inquired about the possibility of terminally disclaiming their applications for a period equivalent to the duration of the suspension. They both indicated that they would discuss this possibility with their respective clients.

Terminal disclaimers have been permitted as a condition for suspending an interference, although permission is not automatic. Two of the additional factors to consider are:

1. Duration. The "progress of the useful arts" rationale underlying the patent system means that a suspension in the publication of an invention disclosure works a policy harm. Even when the disclosures are available through other publications the extended withholding of information about what is claimed could be injurious to the public. Consequently, long suspensions are likely to be denied even when a terminal disclaimer is offered.[2]

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[1] Assuming neither party is subject to a terminal disclaimer over a patent.

[2] Long suspensions can cause practical problems as well. For instance, a suspension and terminal disclaimer can converge on each other such that the suspension is still in effect when the terminal disclaimer eliminates all remaining potential term.

2. Other proceedings. A disruption or term extension in another proceeding is not cured by a terminal disclaimer in the suspended proceeding.

ORDER

It is

ORDERED that the heading on all future papers the parties file in this interference be modified to show that the papers are directed to the undersigned.

Entered: 26 April 2002

RICHARD TORCZON
Administrative Patent Judge