From: wberridge@oliff.com

Sent: Monday, 26 February 2001 23:36

To: Interference.Rules@uspto.gov

Subject: The Two-Way Test

The following comments reflect my own opinions.

With reference to the request for comments on the above matter, I strongly believe that the two-way test for interfering subject matter should not be changed.

Converting to a one-way test would mean that improvement patents could always be in interference with the broader patents on which they improve, patents containing combination claims could always be in interference with patents containing broader subcombinations, patents containing species claims could always be in interference with patents containing broader genus claims, etc. As Judge Markey aptly pointed out several years ago, it is the rare patent that is not directed to an improvement over some prior existing technology.

The result of converting to a one-way test would be a wide open pre- and post-grant opposition practice, regardless of the fact that in each instance the narrower claim could well be patentable over the broader one. This would not appear to comport with 35 USC 135(a). The two-way test avoids this problem by ensuring that patents are only included in an interference if they have claims to the same invention, but not included in an interference if one has claims that are patentably distinct from the other.

Please feel free to contact me at 703-836-6400 (wberridge@oliff.com) if you have any questions or if I can be of any assistance.

William P. Berridge