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INTERFERENCE

The interference practice is based on Sec 4904, R.S. here set forth:

Sec 4904 R.S. 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, and shall direct a board of three Examiners of Interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

Rule 23.1 set forth the definition of an interference and is here reproduced:

Rule 23.1 Definition--When declared. 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.

An interference will be declared between pending applications of different parties for patent or for reissue 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.

Interferences will not be declared between applications or applications and patents owned by the same party unless good cause is shown therefor, nor will interferences be continued between such applications. The parties shall

make full disclosure of all right, title and interest in any application or patent involved when an interference is declared, or at any other time when requested to do so.

13-1. Preliminaries to An Interference

An interference is often an expensive and time-consuming proceeding, yet it is important that a patent be not granted to any one applicant when other applicants before the Office are claiming the same invention, without a determination of the question of priority where under the tests as to difference in filing dates a question of priority is seen to exist.

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.

13-1-1. Between Applications

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 in fact 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 objects of the invention or elsewhere in the disclosure, or in the claims is an essential in every instance.

If in preparing an application for issue it appears that an interference should be instituted between it and an application assigned to some other division, the Examiner having the allowable case will ask for the transfer of said second application to his division and take the necessary steps toward initiating the interference. After the termination of the interference he will transfer the application back to the division from which it came.

Applications made by the same applicant are of course not put into interference with each other. This holds for applications having the same assignee to the extent that if a plurality of applications containing claims to the same patentable subject matter are found to have common assignee the Examiner informs the common assignee or its counsel that the claims to that subject matter must be placed in one application in the absence of good and sufficient reasons why this may not be done.

13-1-1.1

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. 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 and, since relative order of filing dates may be determined therefrom, references to the exact location of the conflicting case in the division's register should likewise be avoided.

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 23.2. (Order 2687.)

13-1-1.2. Correspondence under Rule 23.2

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 23.2. The rule follows:

Rule 23.2 Preparation for interference between applications. Preliminary inquiry of junior applicant. In order to ascertain whether any question of priority arises between several 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. The statement filed in compliance with this rule 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 twenty days, or if the earliest date alleged is subsequent to the filing date of the senior party, the interference might not be declared.

Under Rule 23.2 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.

Correspondence under Rule 23.2 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.

The Rule 23.2 correspondence is conducted by the Law Examiner on receipt from the primary examiner of a notice of the proposed interference set forth in a letter modeled after the form found under "Letter Forms Used in Interferences" (13-9-1).

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 is ready for allowance.
- (3) If an application is a division, continuation or continuation-in-part of an earlier one, this fact should be stated.
- (4) If one or more applications are owned by the same assignee, or are presented by the same attorney, it should be so stated. Where cases are prosecuted by the same attorney or are owned by the same assignee, ordinarily the claims of one application are restricted to potentially distinguish from the claims of the other and no interference will be suggested.
- (5) In the suggestion of counts only counts which are necessary to determine the question of priority should be selected, and as which are

not patentable over the proposed claims should be omitted and the applicants should be advised when the interference is declared that such claims are not patentable over the issue and will be held subject to the outcome of the interference. Claims are not patentably distinct unless they differ sufficiently to sustain separate patents. Where doubt exists as to patentable distinction the doubtful claims should be included.

- (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.

Where there is a difference between the dates of applications of the senior and junior parties of about six months or more, the Law Examiner will require from the junior party a verified statement relating to his date of conception.

As a result of said correspondence 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 23.2 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.

Where the junior party, as required by Rule 23.2, 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 declaring the interference.

Before forwarding the files to the Interference Division, the Examiner should ascertain if any such statement has been filed and if so, seal this statement and forward it with the files to the Docket Branch (Order 3380).

The oath under Rule 23.3 becomes a part of the interference file in contradistinction to the application file as

In the case of an affidavit under rule 12.1 or rule 27.4 but, like this, is subject to inspection on the ground of being a "prior art statement".

When the date of an interference is not a date of discovery, all other applicants claiming priority in the invention must file in the interference a copy of their filing or date of any other date of discovery.

The following cases need not be brought to the attention of the Board:

(1) A junior applicant is entitled to a priority filing date at least as early as the senior applicant's filing date (rule 27.4).

(2) A junior applicant is entitled to a priority date in this country which is at least as early as the senior applicant's filing date (former 27.50).

It is not to be stated that this correspondence is sufficient to have caused a difference in effective filing dates within the range of six months to two years (exclusive filing date is meant, the filing date to which the application is entitled, i.e., the "filing date" of a "provisional" application, or the filing date of a "substantive" or "in part" application).

Exceptions to the above general rule are the following: (a) If the invention is of simple character, thereby requiring a short time to be put into commercial practice, and if the senior party's case is ready for filing, and the difference in dates exceeds one year. (b) If the senior party's case is not ready for filing, or if the junior party's claims arise from the counts of the interference, or there are embodiments of the invention in the two applications are substantially identical, or are, in fact, identical, even though the difference in dates exceeds two years.

When there is a case where the senior party's application is ready for filing and the difference in effective filing dates exceeds two years, or if it be a simple case, and the Board is satisfied that there is no question of priority involved and the junior application is forthwith sent to issue.

13-1-1.3. Failure of Junior Party to Overcome
Filing Date of Senior Party
Under Rule 23.2

If the earliest date alleged by a junior party in his affidavit under Rule 23.2 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 because another junior party has overcome the senior party's filing date), the senior party's application will be sent to patent 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 with the approval of a Supervisory Examiner.

After the senior applicant's application has been passed for issue, the Law Examiner should be notified 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.

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

Where a junior party after correspondence under Rule 23.2 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:

FORM In view of Rule 23.2, action on this case (or on claims 1, 2, 4, etc., indicating the conflicting claims) 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)

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 failure of applicant to call up the case does not work abandonment, and the case should not be permitted to remain indefinitely among the files in the examining division.

It sometimes happens that the applicant of a junior party is not advised 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 imposes an unnecessary hardship upon the junior applicant and it is believed that the Office should make every effort to give him notice 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.

If the junior applicant fails to call his case up for action at the end of the six months' period and there is no likelihood of the senior application being put in a condition for allowance, the Examiner should of his own motion take the junior case up for action, and reject the claims that are unpatentable over the senior application on the ground that correspondence under Rule 22.2 discloses the fact that the junior applicant is not the first inventor of the claimed invention. If there be other subject matter in the junior application that is patentable over the senior party's disclosure, the allowance of claims on such subject matter may result in the cancellation of the claims to the interfering subject matter and the consequent final disposal of the junior application.

If, however, there is nothing in the junior application that is patentable over the senior application, the rejection just stated will at least have the effect of establishing a statutory period running against the junior application, which, in the continued neglect of the case by the applicant, will result in abandonment. If, on the other hand, the applicant objects to such rejection on the ground that he cannot intelligently withdraw his case from prosecution with a view to reworking it, since he has not seen the disclosures of the senior applicant, the interference should then be formed, provided there is no subject of the senior's disclosure allowable over the junior's invention.

If the junior applicant objects to such rejection, the interference should be continued until it is determined whether or not the junior applicant is entitled to the patent. The senior applicant should be notified of the date of the junior's objection and should be given an opportunity to file a response. If the junior applicant's objection is sustained, the senior applicant should be notified of the date of the junior's objection and should be given an opportunity to file a response. If the junior applicant's objection is sustained, the senior applicant should be notified of the date of the junior's objection and should be given an opportunity to file a response.

Suggestion of Claims

Rule 23.3 Same. Suggestion of claims for interference. Before the declaration of interference, it must be determined 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.

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 Examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. 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 20 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 upon a proper showing.

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.

Rule 23.4 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 appear the attorney or agent will not

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 some advantage 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 claim, 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.

If claims are suggested in an application near the end of the statutory period running against the case, and the time limit for making the claims extends 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.

13-1-1.41. Suggestion of Claims Involving
 An Application in Issue

If claims are suggested to a party whose application is in issue, the procedure is as follows:

The 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 a claim 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 embodied and the interference declared. Such letters must have the approval of the Commissioner.

When the Examiner suggests a claim 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.

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)

It is advisable for the Examiner to examine the claims applied for from the limits and bracket brackets and to do so same until the claims are made or the time limit expires. This avoids any possible error in the application of the final fee. To further insure against the application of the final fee the Examiner may place in the blank space following "Final Fee" on the file jacket the initialed comment "Do not apply fee". Should the final fee have been paid steps should be taken to immediately withdraw the application from issue, using Form 13-1-2.

When an application is found having claims to be suggested to other applications already involved in interference and to form another interference, the primary Examiner requests jurisdiction of the last named applications. To this end a separate letter, (see Form at 13-9-7) addressed to the Commissioner is written for each file, referring only to that file and is placed therein. This letter goes to the Examiner of interferences for his approval before being forwarded to the Commissioner. In case the application is to be added to the same interference, the primary Examiner requests jurisdiction of the interference. In this case Form at 13-9-7 is used. This is addressed to the Examiner of interferences.

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

13-1-2

With A Patent

Rules 23, 24, 25 and 26, quoted below deal with interferences involving patents.

Interference with a patent
Applicant by joint applicant. The fact that one of the joint applicants of a patent and applicant will not prosecute an interference and thereby forfeit his right to have his patent for granted is not sufficient to prevent another patent for the same invention from being granted to the other applicant, provided himself to be the primary inventor.

When the 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; and, when required, the applicant shall file an affidavit (of the nature specified in Rule 18.1) setting forth facts showing that he completed the invention in controversy in this country, before the filing date of the patentee.

Rule 23.5 Same. Copying claims from patent. 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.

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 an attorney or agent filing an application or presenting an amendment copying claims from a patent without calling attention to that fact and identifying the patent.

Rule 23.6 Same. Same. Claims improperly copied. 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 and that the applicant may proceed under Rule 25.3, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where the Examiner is of the opinion that none of the claims can be made, he should state in his action why the applicant can not make the claims and set a time limit, not less than twenty days, for reply. If, after reply by the applicant, the rejection is made final, a similar time limit should 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.

When an interference with a patent is proposed it should be ascertained before any steps are taken whether there is common ownership. An abstract of title 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.

Where an application is under Dual Prosecution, and claims are copied therein from a patent classified in the second division, the propriety of declaring the interference (if any) is decided by and the interference is declared by the second division. In such a case, it is usually advisable to transfer the application including the drawings temporarily to second division. A print of the drawings should be made and filed in the first division in place of the original drawings.

13-1-2.1

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 takes steps toward declaration of an interference. After having the title report of the patent prepared to be certain that there is no common ownership, his next step is the suggestion of claims from the patent to the applicant.

The procedure to be followed in suggesting claims from a patent to an applicant is generally the same as in the case of a prospective interference between applications and is discussed in detail under the heading of "Suggestion of Claims" under interferences "Between Applications" (13-1-1.4). However, the following differences must be observed.

- (1) No correspondence under Rule 23.2 is conducted with a junior applicant to whom a claim from a patent is suggested but, instead, an affidavit under Rule 23.4 is required.
- (2) In suggesting a claim from a patent, the patent should be cited and the source of the claim given, 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 are suggested to him, whereas only patentably distinct claims are suggested for an interference involving only applications.
- (4) Claims suggested to 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.

As a patentee may not alter his claims (unless by disclaimer) an applicant must make one or more claims of the patent, or substantial equivalents thereof, to invoke an interference, as stated in Rule 23.5.

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 23.5 therefore requires the Examiner to "call the Commissioner's attention to any instance of an attorney or agent filing an application or presenting an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent."

The making of claims from a patent when not suggested 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.

When claims from a patent are made, the application is taken up at once, and the examiner may reject such claims to the applicant if the ground of rejection is not also applicable in the case of the patent, as, insufficient disclosure in the

the Supervisory Examiner. The penalty resulting from failure to reply within the time limit under Rule 23.6 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 19.2) results in abandonment of the entire application. That is not appealable. Further, belated amendment after the time limit set in accordance with Rule 23.6, may be excused by the Examiner, if satisfactorily explained, but one day late under the Rule 19.2 period, no matter what the excuse, results in abandonment. However, if asked for in advance, extension of the period may be granted by the Examiner, provided the extension does not go beyond the six month period. Otherwise the amendment will not be entered without the approval of the Commissioner.

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 emphasized in the Examiner's letter.

In this connection it is to be noted that 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 appeal is taken, nor does such 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 the response to or appeal from that action or to 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.

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, the applicant may no longer demand entry of such amendment. 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, Ex parte Shohan, 1941 C D 1, 522 O.G. 501. Admission of the amendment may very properly be denied in a closed application, in 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.

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 may exist, he should prepare a letter (see Letter Form 100) requesting that the application be withdrawn from prosecution 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 Commissioner.

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 cause for refusing the interference on any ground, he should prepare an adverse report (Form 201 b) stating only briefly the basic reasons for refusing the interference, e.g., not readable on the disclosure or, if construed to read on the disclosure, not patentable over the prior art, etc. The Examiner should also prepare an informal memorandum setting forth in detail his reasons for refusing the requested interference. This memorandum is for use by the Commissioner's office and will not become a part of the record. These papers with the file and amendment should be forwarded as in the previous case.

A patent containing the same invention as that being claimed in an application may be asserted only through an interference proceeding. Where the effective filing date of the application is prior to that of the patented applicant, an oath is required, as hereinbefore applied, and a declaration or affidavit that the invention was made by the applicant on the date of the patent, even though there are no competing claims, the two applications being within the time period of the Examiner to require the same showing of facts in an affidavit under Rule 201. It is required to an affidavit under Rule 201.

Where the date of receipt of the file in an affidavit under Rule 201 is not a date of fact, the affidavit should be made in a separate envelope and the envelope properly labeled and filed before entering the file in the Docket Book. The affidavit should be filed in the Docket Book. Early treatment of the affidavit should be returned to the division in which the interference is pending.

After the date of receipt of the file in an affidavit under

affidavits under Rule 23.2 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. 543. The now opened affidavits filed under Rules 18.1 and 23.4 may then be returned to the application files and the affidavits filed under Rule 23.2 filed in the interference jacket.

13-2

Preparation of Interference
Papers and Declaration

The rules pertinent to this subject are set forth below.

Rule 23.7 Preparation of Interference
Notices and Statements When an interference
is found to exist and the applications are in
condition therefore, the Primary Examiner shall
forward the files to the Examiners of Inter-
ference, together with notices of interference
to be sent to all the parties (as specified in
Rule 23.9) 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 pat-
entee, the date and number of the patent. The
notices shall also specify the nature of the
interference which shall be clearly and con-
cisely defined in view of any ambiguity, 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 be stated in the
notice) and shall indicate the claims or claims
of the respective cases corresponding to the
count or counts.

The Primary Examiner shall file a formal
statement for the Examiners of Interference
disclosing the applications involved and inter-
ference, fully identified, contained in the in-
volved applications, and of the claims of the
applicant applied to, and also disclosing
the count or counts in issue and the grounds
of the corresponding claims, the name and
residence of any assignee, and the name and
residence of all attorneys or agents, both
principal and associate.

Rule 23 9 Declaration of interference

Mailing of notices. 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 24 1 must be filed, and shall, pro forma, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

The notices of interference shall be forwarded by the examiner of interferences to all the parties, in care of their attorneys or agents, and, if the application or patent in interference has been assigned to the assignees when one of the parties has received a patent, a notice shall be sent to the patentee as well as to his attorney or agent of record.

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.

13-2-1

Preparation of Papers

The procedure to be followed in setting up an interference is set forth in rule 23 7. Further information is given in the preceding 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.

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

13-2-1 1

Letter to Examiner of Interferences

The letter to the Examiner of interferences is written upon the blank forms for that purpose. (See Letter Forms 13-9-5 and 13-9-6 1.) 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, when there are a plurality of counts, 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	10	1	2
2	5	1	3
3	9	15	5
4	4	11	6

If reference is made to a divisional, continuation or continuation-in-part application, that application should without any doubt support a count of the interference.

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 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 filing date of each party with respect to all the counts in issue has been given.

As evidence that the Examiner has considered the matter and has decided that all the counts in issue are clearly supported by the earlier application, he must initial the margin of Form No. 251 opposite the entry relating to the earlier application. Alternatively, a positive statement may be added at the end of Form No. 251 to the following effect, after making the proper entry and modification in the line "Division or continuation of":

"All the counts in issue are supported by Serial No. ____."
or "Counts numbered _____ and _____ in issue are supported by Serial No. _____"

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.

If a reissue application or patent is involved in an interference, complete information concerning it should be given on Form 251, including reissue patent number and date, reissue application number and filing date, original patent 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 23 1); 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. If the interference counts are modified claims of the 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 251) must include copies of the counts. A certificate of correction in a patent should not be overlooked. For the best practice in interference 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 25 3 and 25 4 in a prior interference, a statement should be added to Form 251 to the following effect:

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

This insures against the setting of a new motion period in the newly declared interference. (See Rule 25 3, last sentence.)

13-2 1 2

Letters to Parties

The letters to the different parties are written upon the blanks for that purpose. See Letter Form at 13 9-6. After the printed matter upon said blank, there shall appear

first, 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 counts, the letter to X would read:

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

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

(c) An application (patent) for Bicycle Saddle 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	16	3	2
2	5	1	3
3	9	15	5
4	4	11	6

Special precautions to be observed in filling out the interference notice to the parties (Form 213 or POL-76) will now be discussed.

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 which the opposing party may otherwise have obtained. No statement as to parent applications of the patent should be made.

In filling out Form 213 or POL-76 the blanks to the right of the address box should be completely filled out. If the case in interference is a division, continuation, or continuation-in-part of an earlier application and, further, that party has been given the benefit of the earlier application in the letter to the Examiner of Interferences (Form 251), corresponding information should be included in the letter to that party as, by adding after the identification to the right of the address box, "Division (or continuation or continuation-in-part) of Serial No. _____, filed _____."

Notation of the persons to whom Form 213 or POL-76 is mailed should be made on all copies.

The counts of the interference are ordinarily no longer 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 modification of a patent, the letter to the patentee must include a copy of the count. Similarly, if the interference count is a rewritten dependent claim, copies of the rewritten claim should be included in the letters to all parties who do not have the claim in their respective cases in rewritten form. Also, at the entry of a particular amendment in a party's case, it should be the interference notice to that party should include another copy of the count 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. Wheat v. Damon*, 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 applicant's or applicants' claims not patentably different from the issue of the interference, he should append to the declaration 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 given 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, and which are not recited therein, and will probably lessen the motions under Rule 25.

When parties to an interference have the same attorney this fact should be stated at the bottom of each interference notice and in this case a copy of the interference notice should be sent to each inventor personally in addition to his attorney or agent of record. Retention of the original of this additional copy should be made on all copies. 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 is not to be repeated. This rule also applies also to copies of the affidavits of the parties, which have not been previously furnished.

In no case should a letter or in 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 "Re: *_____* in the *_____* of Interferences, *_____*

Div. _____ (date) _____," at the upper left hand corner, and also when there is an assignee or a patentee, it should be stated on all letters that a copy has been sent such party or parties.

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.

13-2-1.3 The Interference Brief Card

Interference brief cards Form No. 079 are placed in the files of the respective parties. The names only of the 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.

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

- (1) No party should be made junior as to some counts and senior as to others, but two interferences should be set up making the party with two applications junior in one interference and senior in the other.
- (2) No interference should be declared unless each party to the interference is involved on every count.
- (3) Where an applicant puts identical claims in two applications by virtue of which he will be the junior party and by virtue of the other the senior, the later application only should be placed 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 application into the interference as evidence (In re Redeclaration of interferences Nos. 49,635; 49,636; 1926 C.D. 75; 350 O.G. 3.)

Summarizing, in preparing the cases for interference, Forms 251, 213 or FOL-76, and 079 should be filled out.

Any correspondence under Rule 23.2 should be obtained from the Law Examiner, sealed, and forwarded with the other

papers. Affidavits under rule 18.1 and those affidavits under rule 23.4 which reveal facts of the nature of those included in an affidavit under rule 18.1 should be removed from application (not patent) files sealed, and returned to the examining division until called for or until the interference is terminated. And, if a patent is involved in the interference, a recent title report on the patent should be forwarded with the other papers.

13-2-2. Declaration of Interference

The papers necessary in declaring an interference having been prepared in the examining division are sent to the Docket Branch, the Examiner filing in his own division a copy of the letter to the Examiner of Interferences. In the Docket Branch the files and interference letters are put in an envelope or box and given an interference number which, together with full data of the interference is placed on said envelope or box. These data are also recorded in a card index.

The Docket Branch then forwards the files with the interference letters and the envelope or box to the Interference Division where the files and letters are inspected to see that the notices are in proper form. If not, the files and notices are returned to the primary Examiner for correction. When all the papers are correct, the Examiner of Interferences, under the provisions of rule 23.9 adds to the notices a designation of the time within which the preliminary statements required by rule 24.1 must be filed and pro forma institutes and declares the interference by forwarding the notices to the several parties to the proceeding. After the notices are mailed, the application and interference files are returned to the Docket Branch, where the date set for filing the preliminary statements is noted on the interference envelope or box and in the interference register.

13-3. Suspension of Ex Parte Prosecution

Rule 23.11 (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 the 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 thereof with the consent of the Commissioner.

The treatment of amendments filed during an interference is considered in detail in sections 13-7-1 and 13-8-5.

13-4. Jurisdiction of interference

Rule 23.10 Jurisdiction of interference.

Upon the institution and declaration of the interference, as provided in Rule 23.9, 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.

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. The parties, however, are not committed to the contest until the preliminary statements have been received and approved, and the files of the various parties opened to the inspection of their opponents. The preliminary statements are not thus opened at this stage of the interference proceedings.

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.

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 13-9-8.

If, however, the interference is between a patent and an application, a subsequent disclaimer by the patentee of a portion of the claim, or other modification thereof that renders the claim not readable on the application disclosure will not enable the Examiner to withdraw the interference.

For the consideration of any fact, such as here presented affecting the continuance of the interference, procedure must be had in accordance with Rule 25.2 or Rule 25.7.

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 Examiner of Interferences through the Docket Branch for his approval. See Form at 13-9-7.

If after the interference has passed the pro forma stage, action by the Primary Examiner becomes necessary relative to the entire interference, he requests jurisdiction of the interference from the Examiner of Interferences forwarding the request through the Docket Branch. See form at 13-9-7.

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.

13-5. Matters Requiring Decision by Primary Examiner During Interference

Rule 25.7 Motions to dissolve 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 claims, or (4) that there is no interference in fact. If the interference involves a design or plant put out or application, or if the interference involves a patent, the claims of which have been copied in modified form.

When one of the parties to the interference is a petitioner, motions to dissolve on the ground that the counts are unpatentable may not be brought.

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).

Rule 25.3 Motions to amend. 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 23.5). 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.

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 motion may be made within thirty days from the filing of the motion to dissolve.

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 before the transmission date as fixed under Rule 25.6.

The proposed claims must be indicated to be patentable in the opinion of the moving party in each of the applications involved 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 patentably from each other and why each proposed count is necessary to the interference. The proposed claims must also be

applied to the disclosure of such application involved in the motion, except as to an application in which the claims already appear and the claims identified as only including said claim.

On the granting of such action and the adoption of the claims by the other parties within a time specified and the filing of any preliminary statement, the Primary Examiner shall refer to the evidence or other material which is necessary or may be necessary to resolve the said claims. A second action period is not set and the motion with respect to such matters as could have been raised during the motion period will not be considered.

Rule 40.4. Motion to add or substitute other application. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to exclude an application or patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties.

Such motions are subject to the same conditions and the procedure in connection therewith as the same, so far as applicable as hereinafter set forth, for motion to amend.

Rule 40.5. Motion 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 invention. Such motion shall be heard and determined by the Primary Examiner, and any party to an interference may bring a motion to amend.

Rule 40.6. Interference on basis of invention. If, prior to the granting of an interference, a determination is made by the Primary Examiner, or other person in charge, which is based on the evidence, that an invention is entitled to the benefit of the filing date of an earlier invention, the Primary Examiner shall refer to the evidence or other material which is necessary or may be necessary to resolve the said claims. A second action period is not set and the motion with respect to such matters as could have been raised during the motion period will not be considered.

suspended, the case referred to the Primary Examiner for his determination of the question of patentability, and 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 25.6.)

Prior to the approval of the preliminary statements and notification of the parties thereof, an interference may be withdrawn at the request of the Primary Examiner.-

An interference may be enlarged or diminished both as to counts and applications involved, or may be entirely dissolved, by actions taken under Rules 25.2, 25.3, 25.4 and 25.7. The burden of proof may be shifted by action taken under Rule 25.5. Decisions on questions arising under these rules are made by the Primary Examiner personally.

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.

If a motion under Rules 25.2, through 25.5 is filed, it is examined by the Examiner of Interferences who, if he finds it to be proper in form, will later transmit it to the Primary Examiner for determination. The Examiner of Interferences sets a date and time of transmission of the interference file to the Examiner, and, if oral hearing is to be held, also the place of hearing.

Oral hearing is not held unless requested by the moving party in his motion or by another party at least twenty days before the date of transmission of the motion. If an oral hearing is to be held, a copy of the Examiner's letter to the parties indicating that fact 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 and his 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 impracticable 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 since 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 decide the motions by "dual prosecution" procedure. If this is the case the concurrence of the second division in the dual prosecution procedure should be secured as soon as possible so that the Primary Examiner of the second division and his assistant may likewise attend the hearing.

If no oral hearing is to be held, the Examiner is not notified of the filing of a motion until the transmission date has passed, when the complete file of the interference is forwarded to him for decision through the Docket Branch.

13-5-1.

Briefs on Motion

Concerning briefs on motions, rule 25.6 requires that any briefs in support of a motion must accompany the motion, and that "any answer to the motion must be filed ten days before the transmission date." If a party opposes the addition of counts under Rules 25.3 and 25.4 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 before the transmission date. If such a notice has been given, then the moving party may, under the provisions of rule 25.6, file a reply ten days before the transmission date.

13-5-2.

Oral Hearing

Rule 26.3 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 transmitted by the Interference Examiner and matters relating thereto, as, for example, a motion to strike a brief on one of the transmitted 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 25.2 through 25.5 or notice under the third paragraph of Rule 25.3, but failed to do so.

13-5-3.

Decision on Motion to Dissolve Under Rule 25.2

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 25.2 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" (13-7-3).

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 an action paper, in the order, or orally at the hearing.

Affidavits submitted with disclosure of a party's application as, for example, on the matter of operability or right to make, should not be considered but affidavits relating to the prior art may be considered by analogy to Rule 18 2.

If there is considerable doubt as to whether or not a party's application is relevant to 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 introduce 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 overcome by the effective filing date or preliminary statement of all the parties, then the anticipatory character of that patent or publication need not be considered by the Examiner, but the reference should be considered if at least one party fails to overcome its effective date by his own filing date or his preliminary statement. A party's assertion that the date alleged in his preliminary statement antedated 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 revealed against inspection by any opposing party and no reference must be made to the exact date of invention alleged therein beyond the mere statement that the date of the patent or publication is overcome.

In deciding motions under Rule 25 2 the Examiner should not be misled by citation of decisions of the Board 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. The 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 affect the patentability of the count and need not be limited to matters which are ancillary to priority.

14-574

Decision on Motion to Grant or
Substitute other Application
under Rules 25 3 and 25 6

Motions by the interfering parties may be made under Rules 25 3 and 25 6 to seek consent for the interference and also to add or substitute other applications owned by them. Should any such motion be granted and the claims made by one party within the time limit set, the interference may be

formed by the Primary Examiner.

If a motion under Rule 25.4 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.

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.

Contrary to the practice which obtains when all parties agree upon the same ground for dissolution under Rule 25.2, the concurrence of all parties in a motion under Rules 25.3 or 25.4 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 set a time within which the parties may request rehearing and file briefs on such new ground.

Also care should be exercised in deciding motions under Rules 25.3 and 25.4 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 25.3 and 25.4. The practice here is the same as in the case of 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 13.5.

If a motion under rules 25.3 or 25.4 is denied on the basis of a reference which is not a patent in law, the motion may be modified and the motion granted upon the filing of proper affidavits under rule 13.1 in the application files of the parties involved. These affidavits should not be opened to the inspection of opposing parties and no reference should be made to the date of invention set forth therein other than the date of filing. The effective date of the reference in the present case is the same as of other affidavits under rule 13.1. Affidavits are accepted until the reference is withdrawn or amended.

13-5-5. Motion as to Burden of Proof

The rule is described also under the heading "Burden of Proof" in the Manual on file 29.5.

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 25.5 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; 356 O.G. 7.

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. In other words, shifting the burden of proof as to some counts will lead to the same confusion that is brought about by declaring the interference with the burden of proof different as to different counts. A party should not be given the benefit of an earlier application if there is doubt on the matter.

13-5-6. Dissolution on Primary Examiner's Own Motion under Rule 25.7

Rule 25.7 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 interference, requesting that the interference

be withdraw. 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 13-9-8.

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 25.7). This same practice obtains when the Primary Examiner discovers a new reason for holding counts proposed under Rules 25.3 or 25.4 unpatentable. Under this practice, the Primary Examiner should set a time within which the parties may request reconsideration or rehearing and file new briefs on such new ground.

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 13-9-8 1.

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 25.2. Briefs may be filed as in the case of a motion under Rule 25.2 and a hearing may be held if requested by one or more parties. Decision is prepared and mailed by the Primary Examiner as in the case of a motion to dissolve.

1., 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 25.7

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

13-5-7.

Form of Decision Letter

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 succinct 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 general 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 transmitted for decision 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 Interference Examiners 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 subject to inter partes review.

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 reserve decision on a motion to shift the burden of proof until after motions under Rules 25.2, 25.3, and 25.4 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 8 is granted on grounds 1 and 2 and is denied on ground 3.

Jones motion under Rule 25.3 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 Rule 24.1 with respect to proposed counts 6 and 7 must be sealed up and filed with the name of the party filing it, and the number and title of the interference, endorsed on the envelope.

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 25.2 through 25.5 and 25.7 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 sheet (Form 210). 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 "Amtd. and Statement due _____." Appropriate entries should be made on the interference brief in the section entitled "Decisions of Motion" (Form 079) in each case involved in the interference. In making this entry the line "Ex'r. of Interferences" on the old forms should be corrected to read Primary Ex'r. 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 25.2 through 25.5 and 25.7, the Examiner should forward the complete interference file to the Docket Branch, where the date of the decision is recorded on the interference register.

Special facilities are also 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.

13-5-8. Petition for Reconsideration of Decision

Any petition for reconsideration, rehearing, or modification must be filed within twenty days from the date of the decision (Rules 25.6 and 26.3) and, unless this time has been extended (see rule 26.4), any such petition filed more than twenty days after the date of the decision should be dismissed.

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 sheet (Form 210) of the interference file and the complete interference file should be forwarded immediately to the Docket Branch.

13-6. Redeclaration of interferences and Additional Interferences

Redeclaration of interferences after decision on motions involves such a variety of factual situations that it is impossible to reproduce a single letter form which will cover all cases.

13-6-1. 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 interferences as to some but not all of the counts, it will be necessary to redeclare the interference. See 13-6-2

- (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"x12 $\frac{1}{2}$ ") 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 13-9-9.
- (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 FOL-90 with the same number of carbon copies as the original declaration papers. Properly addressed envelopes must be provided. Form at 13-9-1, 13-9-2.
- (5) Redecoration papers must never be mailed by the examining division but must always be forwarded, along with the complete interference file, to the Docket Branch.

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 Examiner, 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 to make the claims, within the time set, 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 251) in the new interference to the following effect:

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

13-6-2. By Addition of New Party by Examiner

Rule 25.8 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 13-9-10 to 13-9-11.2.

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, 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.

13-7. Examiner's Action 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 sheet (Form 210) 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 Docket Branch will see that such note has been made and initialed before filing away the Interference record. (Order 1813)

13-7-1.

Entry of Amendments Filed in
Connection with Motions

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

The manner of treating amendments which are filed in an application during the course of the interference, is discussed in a separate section (13-8-5).

The last paragraph of Rule 25.2 reads as follows:

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 25.2 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 25.2 motion is not entered and it is so indicated by striking out the portion in pencil.

Under Rule 25.3 an applicant is required to submit with his motion a separate paper or 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 25.3 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 25.3 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 in pencil as in the treatment of an amendment under Rule 25.2 that is only partly acceptable.

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 said additional claims, presented under Rule 25.3, had been admitted and entered in the application. 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.

It should be noted at this point that, under the provisions of the last paragraph of Rule 28.2, 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.

11-7-2. Action after Award of Priority

Under R.S. 4904 the Commissioner may at once issue a patent to the applicant who is adjudged by the Board of Interference Examiners 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 was filed, the losing party to the interference may at a later date within the six months' period file a suit under R.S. 4915. In this event, the Examiner, if the patent to the winning party has not issued, should take steps to withhold his application

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.

The winning party if the prosecution of the case had not been closed, may be allowed additional and broader claims to the common patentable subject matter. 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.

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 invention 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 28.2). The interference counts thus disclaimed, conceded, or aban-

done 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 losing applicant is notified that, in accordance with the provisions of Rule 28.5 the claims (designated by numerals) "which constituted the issue stand finally rejected and are not open to further ex parte prosecution." The expression, "stand finally rejected" as used in Rule 28.5 is not to be confused with the more usual final rejection. It is not such a final rejection as to cut the applicant off from his right to amend the claims in question with a view to patentably differentiating from the winning party's disclosure.

With the exception of the situation referred to in the next paragraph (when the judgment of priority is based solely upon ancillary matters), the remaining claims, if any, in the case of each defeated party should be reviewed in connection with the disclosure of the winning party which disclosure, as a result of the interference, has the status of prior art. Any claim in a losing party's case not patentable over the disclosure of the winning party, taken either by itself or in conjunction with other references, should be rejected.

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 (Rule 27.7).

If the losing party's case was under final rejection or ready for issue when the interference was formed, 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 during the interference, he may order a print 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 25.3 and 25.4 may apply where the interference terminates in a judgment of priority as well as where it is ended by dissolution.

In the rare instance where the winning party abandons his application and a losing party learning of this fact seeks to overcome the interference judgment, see *Joliffe v. Waldo*, 1917 C.D. 15; 235 O.G. 671; *Fanslow v. Whitney*, 1919 C.D. 93; 266 O.G. 742; and *Nash v. Reeder v. Ryan*, 1920 C.D. 72; 280 O.G. 589 for statement of the procedure to be taken.

13-7-3.

Action after Dissolution

The last paragraph of Rule 25.2 reads as follows:

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).

Accordingly, after dissolution of an interference any amendments which accompanied motions to dissolve are entered to the extent that the motions were not denied. 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.

Under former Rule 122 it was not necessary for the moving party to file a proposed amendment cancelling the claims of his application corresponding to the interference counts if the grounds for dissolution applied to his own claims. Accordingly, if an interference is dissolved as the result of a motion under former Rule 122, it is necessary for the examiner, after dissolution, to also reject the claims in the moving party's application corresponding to the interference counts on the grounds stated in the decision. Additionally, the claims of the moving party corresponding to the interference counts are further rejected on an estoppel because of his own concession of non-patentability embodied in his motion.

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 27.7, 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 sub-group is free to claim this common subject matter.

While the Court of Appeals of the District of Columbia does not recognize the doctrine of estoppel resulting from interference proceedings except as it applies to the issues involved in the interference counts (International Cellucotton Products Co. v. Coe, 1936 C.D. 40; 471 O.G. 243), the Patent Office follows the ruling of the Court of Customs and Patent Appeals as its appellate court (Ex parte Graham, 49 U.S.P.Q. 34; Ex parte Peterson and Daley, 60 U.S.P.Q. 500) to the effect that failure to move under Rules 25.3 and 25.4 work estoppel as to all issues that could have been made the basis of interference between two or more of the parties of interest involved, except as relieved by the second paragraph of Rule 27.7.

13-8. Miscellaneous

13-8-1. 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. See also 10-15.

13-8-2. Records 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)

13-8-3

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 can not be avoided.

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.

13-8-4.

Secret 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 2). 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. Since modification or rescission of the secrecy orders may not come to the attention of the Examiner of Interferences, it is vitally important that he be immediately notified of any such modification or rescission so that the interference proceedings may be promptly resumed, if proper.

13-8-5. 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 (13-7-1).

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 which 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 in the division register. After the termination of the interference, these temporary notations should be erased and the amendments permanently entered and considered as in the case of ordinary amendments filed during the ex parte prosecution of the case. (Order 1759)

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 do so. If it does, he obtains from the Commissioner jurisdiction of the application for the purpose of setting up the new interference, unless such course will unduly disturb the condition of the application with respect to the pending interference. To make certain on this point the Examiner first submits his request for jurisdiction to the Interference Examiner for recommendation, assuming of course that the existing interference is still pending before the Board of Interference Examiners.

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 13-9-13. 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 non-elected invention, the amendment will not be entered and the applicant will be so informed giving very briefly the reason for the non-entry of the amendment. See Letter form 13-9-13.

13-8-6 Notice of Rule 25.4 Motion Relating
to Application Not Involved in Interference

Whenever a party in interference brings a motion under Rule 25.4 affecting an application not already included in the interference, the examiner of interferences should at the time of transmitting the motion for determination send the primary examiner a written notice of such motion and the primary examiner should place this notice in said application file. (Order 3244)

The notice is sent to the primary Examiner at the time the parties are notified that the Rule 25.4 motion will be transmitted for determination. 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. When the correct division should be ascertained, the notice forwarded to that division.

This notice serves several useful and essential purposes, and the 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 interference. Second, if the application which is the subject of the motion is in issue and the last date for making the final fee will not permit determination of the motion, it will be necessary to withdraw the application from issue. Third, if the application contains an affidavit under Rule 18.1, this must be sealed because the opposing parties have access to the application.

13-8-7. Conversion of Joint Application to Sole

Although, for simplicity, the subject of this section is titled "Conversion of Joint Application to Sole," it also includes cases where an application filed by three or more co-applicants is converted to an application with a lesser number of co-applicants.

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 Docket Branch.

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 Docket Branch.

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 Interference Examiners. If transmitted to the Primary Examiner, the matter is treated as outlined in the preceding paragraph. For forms see 13-9-12 to 13-9-12.2.

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 Interference Examiners.

In any case where the Examiner must decide the question of converting a joint application to a sole 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 joint party may occasionally seek to substitute a sole application or a joint application with a lesser number of co-applicants for the joint 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 25.4.

13-8-8. 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.

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. (Order 3193)

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."

13-8-9. Suit under Section 4915 R.S. by
Losing Party

When a losing party to an interference gives notice in his application that he has filed a bill in equity under the provisions of Sec. 4915 R.S., relative to the interference, that notice should be called to the attention of the District Branch in order that a notation thereof can be made on the index of the interference.

13-8-10.

Public Law 690

If a request 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 a request under Section 1 of Public Law 690 has been granted. The party having a foreign filing date may therefore find it desirable or necessary to file a motion under rule 25.5 and the matter is then considered on an inter partes basis.

13-8-11.

Dual Prosecution

The question of dual prosecution rarely arises in interference proceedings but the proper occasion therefor may occur in deciding motions. If appropriate, dual prosecution practice may be utilized in deciding motions and the procedure to be followed in the preparation and mailing of the decisions should follow as closely as possible the ex parte dual prosecution practice.

13-8-12. 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.

13-9. 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.

13-9-1. Letter to Law Examiner Submitting Proposed Interference for Correspondence Under Rule 25.2

Form 603 or short (8"x10½") plain paper.
Original and carbon copy, both signed.
Forward both to Law Examiner.

(Date).

Mr. H. S. Miller,
Law Examiner.

Sir:

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

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

The application of Jones is ready for allowance.

Respectfully,

Green,
Asst. Exr.

Examiner

(Cont'd)

Jones	Smith	Brown
	10-13-33	
	Div. of	
3-15-32	11-21-32	2-12-33
3 -----yes*	-----	yes
55 -----no*	-----	yes
yes ----- 1	-----	no
yes ----- 2	-----	yes
no -----yes	-----	3

*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.

13-9-2. Letter Suggesting Claims for Interference
 (Form POL 90)

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

(To be mailed by examining division)

The following claims, found allowable, are suggested for purpose of interference. Applicant should make same by _____ (allow 20 days, plus holidays and time for transit in mail) _____ under the provisions of Rule 23.4; failure to do so will be considered a disclaimer of the subject matter involved:

(Copy claims, without numerals.)

Examiner

Copies to:
 Applicant
 Assignee

13-9-3. Same Attorney or Agent in Applications
of Conflicting Interests

(Form PCH 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.)

Under the provisions of Rule 24.0 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. In further accord-
ance with Rule 23.0, this matter is being called to the
attention of the Commissioner.

Examiner.

Copies to:
Applicant
Assignee

13-9-4. Letter Requesting Withdrawal from Issue

Form 603 or short (8"x10 $\frac{1}{2}$ ") plain paper
Original for application file.
Forward to Commissioner.

(Date)

Application of	:	
John Doe	:	
Ser. No. 85,967	:	
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), (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) rejecting claims (specify claims) on the implied disclaimer resulting from failure to make the claims suggested to him, under Rule 23.3.
- (d) informing applicant that the claims cannot be allowed him because correspondence under Rule 23.2 has developed the fact that applicant is not the first inventor of their subject matter.
- (e) deciding a motion under Rule 25.4 involving this application, the date set for transmitting the motion being subsequent to the ultimate date for paying the final fee.

13-9-5.

Declaration Papers

Letter to Examiner of Interference

(Form 251)

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

(Forward to Docket Branch)

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 the various parties. The counts should be checked against the original claims and the words "Counts compared" placed at the end of the letter at the lower left hand corner of the table to show that the counts had been compared with the claims.

13-9-5.1. 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 251) 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		4
4	9		7

This identification is copied in each of the letters to the parties (Form 213 or POL-76), being certain to arrange the parties in alphabetical order. The identification "Jones" is added to the right of the address box in the letter (Form 213 or POL-76) for the application of Smith and that letter, after the printed portion, reads as follows:

... presented in claims 5 and 6 of this application.

The identification "Counts" is added to the right of the address box in the letter (Form 213 or 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 the Smith application is involved in the interference and by all parties in title of the invention should be indicated.

13-9-6 Letter to Each Party (Interference Notice)

(Form 213 or POL-76)

(Original for application or patent file, copies only for attorney or agent (applicant, inventor, assignor, attorney or agent), assignee and patentee (if party to a patent).)

(DO NOT GIVE SERIAL NUMBER OR FILING DATE OF ANY OTHER PARTY.)

(Forward to Docket Branch.)

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 23 and 24 of this application (or patent).

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

((Typist: the first alphabetical name))

A Hand Flow, filed by/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))

Agricultural Implement, filed by/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 ((Typist:	
1	3	23	8	note al-
2	4	24	10	phabeti-
				cal ar-
				rangement
				of par-
				ties))

Counts compared.

(Insert appropriate paragraph or paragraphs, hereinafter.)

Copies to:

Assignee

Patentee

Examiner

(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 28.6."
- (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.

13-9-7.

Request for Jurisdiction of
Application Involved in Interference

(Form 005 or short (8"x10") plain paper)
(Original for application filed.)
(Forward to Pocket Branch for interference
Examiner's recommendation.)

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

(Date)

Application of)
John Smith)
Ser. No. 85,903) Request for Jurisdiction
Spraying Machine)
Filed Feb. 14, 1935)

Hon. Commissioner of Patents,

Sir:

Jurisdiction of the above entitled application, now involved in interference No. 44,544, Andrews v. Smith, is requested for the purpose of (a), (b), (c), (d), or (other reason).

(State briefly any further necessary information.)

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 remains in interference.

13-9-7.1. Request for Jurisdiction of Interference

(Form 605 or sheet (8x10 $\frac{1}{2}$ ") plain paper)
(Original for interference file)
(Forward to Socket Branch)

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

(Date)

Interference No. 15,278)
Henry Brown) Request for Jurisdiction
v.)
John Smith and Edward Green)

Examiner of Interferences,

Sir:

Jurisdiction of the above entitled interference is requested for the purpose of (a), (b), or (c).

Respectfully,

Examiner

(a) adding, under the provisions of Rule 25.8, 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 25.8.)

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

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

(May be used only prior to the approval of the preliminary statements. Thereafter, this matter must be raised and disposed of as a motion.)

13-9-8. Withdrawal of Interference Under Rule 25.7

(Form 604 or short (8"x10 1/2") 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 the first paragraph of Rule 25.7. (See "Letter Forms Used in Interferences," 12-7-9.)

(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

13-9-8.1. Primary Examiner Initiating Dissolution of Interference (Rule 25.7)

(Form 604 or short (8"x10 1/2") 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 second paragraph of Rule 25.7) and need not be used if the interference is before the Primary Examiner for determination of a motion.

(Date)

Examiner of Interferences,

Sir:

Under the provisions of Rule 25.7 your attention is called to the following patents:

Chambers	109,530	Nov. 2, 1875	91-18
Meyers	248,764	Jan. 11, 1912	91-74

Counts 1 and 2 of Interference No. 45,670, 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

15-9-9. 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 certain 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 redeclaration 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.

Letter to Examiner of Interferences

(Long (8" x 12") plain sheet)
(Original for interference file, carbon may be prepared for retention in examining division)
(Forward to Docket Branch)

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, counts 3 and 4 are renumbered as counts 2 and 3, respectively, and the following counts are added:

Count 4 (Copy count)

Count 5 (Copy count)

The application of Thomas W. Green for a Hand Flow, Serial No. 333,433, filed October 19, 1936 (division of Serial No. 222,222, filed June 27, 1935, patented November 14, 1937, No. 2,147,704), whose Post Office address is Municipal Building, Akron, Ohio, whose attorney is Jas. Robb, 45 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 to 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	3	2	11
2	4	4	15
3	24	6	29
4	20	19	47
5	27	20	43

Counts compared.

Examiner

15-9-9.1 Letter to Each Retained Party

(Form PCL 90)

(Original for application or patent file, carbon copies for attorney or agent (applicant if there is no attorney or agent), assignee, and patentee if party is a patentee.)
(Forward to pocket branch.)

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

Count 2 is stricken out, counts 3 and 4 are renumbered as counts 2 and 3, respectively, 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, for a Hand Plow, 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 Jarden 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*	Jones*	Smith*
1	23	11	2
2	24	15	4
3	25	29	8
4	26	42	19
5	27	43	20

Counts compared

Examiner

Counts	Green*	Jones*	Smith*
1	23	11	2
2	24	15	4
3	25	29	8
4	26	42	19
5	27	45	20

Counts Compared.

Copies to:
Assignee
Patentee

Examiner

*Note alphabetical arrangement.

An interference brief (Form 079) 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 079) of his case indicates that he was eliminated from the interference.

13-9-10. Adding a Party to an Interference Under Rule 25.8

If no testimony has been taken it is necessary to first request the Examiner of Interferences for jurisdiction of the interference (see 13-7-b); thereafter the interference may be redeclared as follows:

Letter to Examiner of Interferences

(Long (8"x12½") plain sheet)
(Original for interference file, carbon copy may be prepared for retention in examining division.)
(Forward to Docket Branch.)

Examiner of Interferences,

Sir:

In accordance with the provisions of Rule 25.8, 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, 1976, No. 45,676.

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.

15-9-10.1 Letter to Each Original Party

(Form POL 90)

(Original for application or patent file, carbon copies for attorney or agent (applicant if there is no attorney or agent), assignee, and patentee if party is a patentee.)

(Forward to Docket Branch.)

In accordance with the provisions of Rule 25.6 application for _____ 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. 45,676, Brown v. Smith to which you are a party. The claims of the Jones application corresponding to the issue are:

Counts	Jones
1	5
2	4

The new party is given until _____ within which to file the preliminary statement required by Rule 24.1.

The issue of the interference remains unchanged.

Examiner

Counts compared.

Copies to:
Assignee
Patentee

14-9-10.2

Letter to New Party

(Form 10L 90)

(Original for application or patent file,
carbon copies for attorney or agent (ap-
plicant if there is no attorney or agent),
assignee, and patentee if party is pat-
entee.)

(Forward to Docket Branch)

In accordance with the provisions of Rule 25.8 your
case above identified is hereby added to Interference No.
45,670 in which no testimony has been taken.

The preliminary statement required by Rule 24.1 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 for _____, filed by _____

The application for _____, filed by _____ (etc)

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

Counts	Brown	Jones	Smith
1	5	3	6
2	6	4	9

Counts compared.

Copies to:
Assignee
Patentee

Examiner

13-9-11.

Adding A Party (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:

Letter to Examiner of Interferences

(Long (8"x12 $\frac{1}{2}$ ") plain sheet)

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

(Forward to Docket Branch.)

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, 1930, No. 45,070, 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	Claims
1	3
2	4

Respectfully,

Counters Compared.

Examiner

13-9-11.1

Letter to Each Original Party

(Form POL 90)

(Original for each application file, carbon copies for attorney or agent in each application (applicant if there is no attorney or agent), assignee, and patentee if party is a patentee.)

(Forward to Docket Branch.)

An application for patent for _____ 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 v. Smith, 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.

Counts compared.
Copies to:
Assignee
Patentee

Examiner

13-9-11.2

Letter to New Party

(Form POL 90)

(Original for application file, carbon copy for attorney or agent (applicant if there is no attorney or agent), assignee, and patentee if party is a patentee.)

(Forward to Docket Branch.)

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, whose post office address is _____ whose attorney is _____, whose assignee is Roe Manufacturing Company of _____ and whose application is entitled _____, and

John Smith _____ etc.

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

Counts	Brown	Jones	Smith
1	5	6	8
2	6	7	9

Counts 1, 2, 3, 4
applied to:
applicant
interferer

EXAMINER

11-9-12 Conversion of Joint Application to Sole
Darin; Interference

Letter to Examiner of Interferences

(Long (8"x12") plain sheet)
(Original for interference file.)
(Forward to Pocket Branch.)

Examiner of Interferences,

Sir:

Interference No. 24,819, Wheat and Todlin v. Butler, is hereby converted by changing the party Wheat and Todlin as joint inventors to Wheat as sole inventor.

The example remains the same.

Respectfully

EXAMINER

13-9-12.1

Letter to Remaining Sole Party

(Form PCL 90)

(Original for application file, carbon copies for attorney or agent (applicant if there is no attorney or agent) and assignee.)
(Forward to Docket Branch.)

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. 74,619, Butler v. Wheat 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:
Assignee

13-9-12.2

Letter to Other Party

(Form PCL 90)

(Original for application or patent file, carbon copies for attorney or agent (applicant if there is no attorney or agent), assignee and patentee if party is a patentee.)
(Forward to Docket Branch.)

Interference No. 74,619, Butler v. Wheat 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:
Assignee
Patentee

15-9-13. Letter Denying Entry of Amendment Seeking
Further Interference

(With application or patent not involved in present
interference)

(Form PCL 90)

(Original for application file
and carbon copy for attorney)
(To be mailed by examining
division)

The amendment filed has not now been entered since it
does not place the case in condition for another inter-
ference.

(Follow with appropriate paragraph such as (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.