Chapter 1100 Interference (Old Practice)

[See Chapter 2300 for New Practice]

This chapter relates only to interference matters before the examiner. The provisions in this chapter do NOT apply to interferences declared on or after February 11, 1985, except in special circumstances, such as (1) Interferences which are declared as a result of a motion made in another interference which was pending before the Board before February 11, 1985 (e.g., an interference declared as a result of a motion under 37 CFR 1.231 to declare an additional interference); (2) an interference related to another interference declared prior to February 11, 1985 (e.g., an interference involving a method of using a compound where an interference involving the same parties and the compound was declared prior to February 11, 1985); and (3) an interference reinstituted after having been dissolved under the old rules (37 CFR 1.201 - 1.288) (e.g., an interference reinstituted after having been dissolved as a result of a motion under 37 CFR 1.231 to dissolve on the grounds of unpatentability where the applicant has obtained allowance of the claims held unpatentable in the decision on motions).

For interferences declared on or after February 11, 1985, except those indicated in (1) - (3) of the previous paragraph, see Chapter 2300 of this Manual.

The interference practice is based on 35 U.S.C. 135 as it read prior to February 11, 1985.

35 U.S.C. 135. Interferences.

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent and Trademark Office.

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

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

>(d) Parties to a patent interference, within such time as may be specified by the Commissioner by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Commissioner, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such

notice is given. Nothing in this subsection shall preclude the Commissioner from determining patentability of the invention involved in the interference.<

37 CFR 1.201 sets forth the definition of an interference prior to February 11, 1985.

Former now deleted 37 CFR 1.201. Definition, when declared.

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

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

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

1101 Preliminaries to an Interference [R-2]

>Since no new interference will be declared under the procedures set forth in this chapter unless it is related to an interference declared prior to February 11, 1985, the procedures relating to activities prior to the declaration of an interference set forth in this chapter have been deleted. See Chapter 2300 for current procedures.<

1104 Jurisdiction of Interference [R-14]

The declaration of interference is made when the notices of interference are mailed to the parties. The interference is thus technically pending before the Board of Patent Appeals and Interferences from the date on which the letters are mailed, and from that date the files of the various applicants are opened to inspection by other parties.

Throughout the interference, the interference papers and application files involved are in the keeping of the Service Branch except at such times that action is required as for decision 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 charges out the necessary application or applications from the Service Branch**. It is not foreseen that the primary examiner will need to take action for which he or she requires jurisdiction of the entire interference. However, if circumstances arise which appear to require it, the primary examiner should request jurisdiction from the Board of Patent Appeals and Interferences.

The examiner merely borrows a patent file, if needed, as, where the patent is to be involved in a new interference.

1105 Matters Requiring Decision by Primary Examiner During Interference [R-14]

Former now deleted 37 CFR 1.231. Motions before the primary examiner.

(a) Within the period set in the notice of interference for filing motions any party to an interference may file a motion seeking:

(1) To dissolve as to one or more counts, except that such motion based on facts sought to be established by affidavits, declarations, or evidence outside of official records and printed publications will not normally be considered. A motion to dissolve an interference in which a patentee is a party on the ground that the claims corresponding to the counts are unpatentable to the patentee over patents or printed publications will be considered through reexamination if it complies with the requirements of § 1.510(b) and is accompanied by the fee for requesting reexamination set in § 1.20(c). Otherwise, a motion to dissolve an interference in which a patentee is a party will not be considered if it would necessarily result in the conclusion that the claims of the patent which correspond to the counts are unpatentable to the patentee on a ground which is not ancillary to priority. Where a motion to dissolve is based on prior art, service on opposing parties must include copies of such prior art. A motion to dissolve on the ground that there is no interference in fact will not be considered unless the interference involves a design or plant patent or application or unless it relates to a count which differs from the corresponding claim of an involved patent or of one or more of the involved applications as provided in §§ 1.203(a) and 1.205(a).

(2) To amend the issue by addition or substitution of new counts. Each such motion must contain an explanation as to why a count proposed to be added is necessary or why a count proposed to be substituted is preferable to the original count, must demonstrate patentability of the count to all parties and must apply the proposed count to all involved applications except an application in which the proposed count originated.

(3) To substitute any other application owned by him as to the existing issue, or to declare an additional interference to include any other application owned by him as to any subject matter other than the existing issue but disclosed in his application or patent involved in the interference and in an opposing party's application or patent in the interference which should be made the basis of interference with such other party. Complete copies of the contents of such other application, except affidavits or declarations under §§ 1.131, 1.202, and 1.204, must be served on all other parties and the motion must be accompanied by proof of such service.

(4) To be accorded the benefit of an earlier application or to attack the benefit of an earlier application which has been accorded to an opposing party in the notice of declaration. See § 1.224.

(5) To amend an involved application by adding or removing the names of one or more inventors as provided in § 1.45. (See paragraph (d) of this section.)

(b) Each motion must contain a full statement of the grounds therefor and reasoning in support thereof. Any opposition to a motion must be filed within 20 days of the expiration of the time set for filing

motions and the moving party may, if he desires, file a reply to such opposition within 15 days of the date the opposition was filed. If a party files a timely motion to dissolve, any other party may file a motion to amend within 20 days of the expiration of the time set for filing motions. Service on opposing parties of an opposition to a motion to amend which is based on prior art must include copies of such prior art. In the case of action by the primary examiner under § 1.237, such motions may be made within 20 days from the date of the primary examiner's decision on motion wherein such action was incorporated or the date of the communication giving notice to the parties of the proposed dissolution of the interference.

(c) A motion to amend under paragraph (a)(2) of this section or to substitute another application or declare an additional interference under paragraph (a)(3) of this section must be accompanied by an amendment adding claims corresponding to the proposed counts to the application concerned if such claims are not already in that application. The motion must also request the benefit of a prior application as provided for under paragraph (a)(4) of this section if the party concerned expects to be accorded such benefit.

(d) All proper motions as specified in paragraphs (a) and (b) of this section, or of a similar character, will be transmitted to and considered by the primary examiner without oral argument, except that consideration of a motion to dissolve on a ground other than no interference in fact will be deferred to final hearing before a Board of Patent Interference where the motion raises a matter which would be reviewable at final hearing under § 1.258(a) and such matter is raised against a patentee or has been ruled upon by the Board of Appeals or by a count in ex parte proceedings. Also consideration of a motion to add or remove the names of one or more inventors may be deferred to final hearing if such motion is filed after the times for taking testimony have been set. Requests for reconsideration will not be entertained.

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

(f) Upon the granting of a motion to amend and the adoption of the claims by the other parties within a time specified, or upon the granting of a motion to substitute another application, and after the expiration of the time for filing any new preliminary statements, a patent interference examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include said claims. A preliminary statement as to the added claims need not be filed if a party states that he intends to rely on the original statement and such a declaration as to added claims need not be signed or sworn to by the inventor in person. A second time for filing motions will not be set and subsequent motions with respect to matters which have been once considered by the primary examiner will not be considered.

Whether a motion should be transmitted to the Primary Examiner is a matter that rests largely within the discretion of the examiner-in-chief, and any party may by petition challenge a decision of the examiner-in-chief to transmit or not to transmit a motion. A decision refusing to transmit a motion is scrutinized more thoroughly on petition than a decision transmitting a motion, "as it is considered desirable to submit all matters raised by motion under 37 CFR 1.231 to the primary examiner for decision on the merits where possible." *Gutman v. Beriger*, 200 USPQ 596, 597 (**>Comm'r Pat.< 1978). The rights of the parties are deemed to be adequately protected by limiting review of the transmission or dismissal of a motion under *>37 CFR< 1.231 to a request for reconsideration and/or petition under **>37 CFR< 1.243(d) and 1.244, respectively.

An interference may be enlarged or diminished both as to counts and applications involved, or may be entirely dissolved, by actions taken under *>37 CFR< 1.231 "Motions before the primary examiner" or under *>37 CFR< 1.237 "Dissolution at the request of examiner". The action may be a substitution of one or more counts, the addition of counts or dissolution as to one or more counts or as to all counts, a change in the application by addition, substitution, or dissolution, a shifting of the burden of proof, or a conversion of an application by changing the number of inventors. See >MPEP< § 1111.07. Decisions on questions arising under this rule are made under the personal supervision of the primary examiner.

*>37 CFR< 1.231(a)(1) provides for a motion that a patent claim is unpatentable in an interference proceeding where reexamination thereof has also been requested. See also >MPEP< § 2284.

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 an interest. See >MPEP< § 1111.01.

Occasionally the entire subject matter of the interference may have been transferred to another group between the time of declaring the interference and the time that motions are transmitted for consideration. If this has occurred, after the second group has agreed to take the case, the Interference Service Branch should be notified so that appropriate changes may be made in their records.

1105.01 Briefs and Consideration of Motions [R-14]

A party filing a motion is expected to incorporate any reasons with the motion so that an initial brief is not contemplated although if an initial brief is filed with the motion, it would not be objectionable. Under *>37 CFR< 1.231(b) other parties have twenty days from the expiration of the time for filing motions for filing an opposition to a motion, and the moving party may file a reply brief within fifteen days of the date such opposition is filed. If a motion to dissolve is filed by one party the other parties may file a motion to amend within 20 days from the expiration of the time set for filing motions and the same times for opposition and reply brief are allowed with respect to the filing date of the latter motion.

After the expiration of the time for filing a reply brief, motions filed under *>37 CFR< 1.231 are examined by an examiner-in-chief who, if he or she finds them to be proper motions, will transmit the case to the primary examiner for consideration of the motions with an indication of such motions as are improper under the rules and which should not be considered if there be any such. No oral hearing will be set. The primary examiner should render a decision within two months on each motion transmitted by the examiner-in-chief. The decision must include the basis for any conclusions arrived at by the primary examiner. Care must be taken to specifically identify which limitations of a count are not supported, or the portions of the specification which do provide support for the limitations of the count when necessary to decide a motion. The

examiner should not undertake to answer all arguments presented.

In motions of the types specified below the primary examiner must consult with an obtain the approval of an examiner-in-chief before mailing the decision. Motions requiring such consultation and approval are:

Motions to amend where the matter of support for a count is raised in opposition or the examiner decides to deny the motion for that reason,

Motions relating to the benefits of a prior application;

Motions to dissolve on the ground that one or more parties have no right to make the counts,

Motions to dissolve on the ground of no interference in fact,

Motions to convert an application to a different number of inventors,

Motions to substitute or involve another application in interference where the matter of support for a count is raised in opposition or the examiner decides to deny the motion for that reason,

Motions to amend involving modified or "phantom" counts,

Motions to amend seeking to broaden a patent claim and an issue is raised with respect to the showing in justification.

Consultation will normally be with the examiner-in-chief who transmitted the motions. The consultation will normally be at the offices of the Board of Patent Appeals and Interferences. The primary examiner should arrange a convenient time by telephone. In the case of motions to amend or to involve another application the examiner-in-chief will examine any opposition which may have been filed and if the question of right to make the proposed counts as to any party is raised thereby, the examiner-in-chief will indicate in the letter transmitting motions the necessity for consultation. If such indication is not made there will be no necessity for consultation unless the primary examiner, after consideration, concludes that one or more parties cannot make one or more of the proposed counts. In this case the primary examiner should inquire of the examiner-in-chief.

1105.02 Decision on Motion To Dissolve [R-14]

By the granting of a motion to dissolve, one or more parties may be eliminated from the interference; or certain of the counts may be eliminated. Where the interference is dissolved as to one or more of the parties but at least two remain, the interference is returned to the primary examiner prior to resumption of proceedings before the examiner-in-chief for removal of the files of the parties who are dissolved out. *Ex parte* action is resumed as to those applications and the interference is continued as to the remaining parties. The *ex parte* action then taken in each rejected application should conform to the practice set forth hereinafter under >MPEP< § 1109(a). See >MPEP< § 1302.12 with respect to listing references discussed in motion decision.

With respect to a motion to dissolve on the ground that one or more parties does not have the right to make one or more counts it should be kept in mind that once the interference is dissolved as to a count, any appeal from a rejection based thereon is ex parte and the views of other parties in the interference will not be heard. In order to preserve the *inter partes* forum for consideration of this matter a motion to dissolve on this ground should not be granted where the decision is a close one but only where there is clear basis for it.

It should be noted that if all 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 formâ* upon that ground, without regard to the merits of the matter. This agreement among all parties may be expressed in the motion papers, in the briefs, or in papers directed solely to that matter. See *Buchli v. Rasmussen*, 339 O.G. 223 1925 C.D. 75 >(Comm'r Pat. 1925)<; *Tilden v. Snodgrass*, 1923 C.D. 30, 309 O.G. 477 >(Comm'r Pat. 1922)<; and *Gelder v. Henry*, 77 USPQ 223 >(Comm'r Pat. 1940)<.

Affidavits or declarations relating to the disclosure of a party's application as, for example, on the matter of operativeness or right to make should not be considered (*In re Decision dated Aug. 12, 1968*, 160 USPQ 154 (**>Comm'r Pat.< 1968)), but affidavits or declarations relating to the prior art may be considered by analogy to 37 CFR 1.132. In addition, affidavits or declarations submitted to establish the existence or non-existence of an interference in fact may also be considered.

If there is considerable doubt as to whether or not a party's application is operative and it appears that testimony on the matter may be useful to resolve the doubt, a motion to dissolve may be denied so that the interference may continue and testimony taken on the point. See *Bowditch v. Todd*, 1902 C.D. 27, 98 O.G. 792 >(Comm'r Pat. 1901)< and *Pierce v. Tripp v. Powers*, 1923 C.D. 69 at 72, 316 O.G. 3 >(Comm'r Pat. 1923)<.

Where the effective date of a patent or publication (which is not a statutory bar) is antedated by the effective filing dates or the allegations in the preliminary statements of all parties, then the anticipatory effect of that patent or publication should not be considered by the examiner at this time, but the reference should be considered if at least one party fails to antedate its effective date by such party's own filing date or the allegations in such party's preliminary statement. See *Forsyth v. Richards*, 1905 C.D. 115, 115 O.G. 1327 >(Comm'r Pat. 1905)< and *Simons v. Dunlop*, 103 USPQ 237 >(Comm'r Pat. 1949)<.

In deciding motions under 37 CFR 1.231(a)(1), the examiner should not be misled by citation of decisions of the Court of Customs and Patent Appeals to the effect that only priority and matters ancillary thereto will be considered and that patentability of the counts will not be considered. These court decisions relate only to the final determination of priority, after the interference has passed the motion stage; in the ordinary case a motion to dissolve may attack the patentability of the count and need not be limited to matters which are ancillary to priority.

Where a motion to dissolve is based on a contention of no interference in fact, the question to be decided is whether claims

presented by respective parties as corresponding to the count or counts in issue claim the same invention even though a claim of one party differs from the corresponding claim of another party through omission of limitations or variation in language under 37 CFR 1.203(a) or 1.205(a). Since the claims were found allowable prior to declaration, granting of a motion to dissolve on this ground would normally result in issuance of the respective claims to each party concerned in separate patents. The question to be decided then, is whether one or more limitations in the claim of one party which are omitted or broadened in the claim of another party are material. Whether or not they are material depends primarily on whether they were regarded as significant in allowing the claim in the first instance. That is, the prosecution should be examined to determine if the limitation in question was relied upon to distinguish from cited prior art, or if it was essential to obtaining the desired result. See *Mabon v. Sherman,* **161 F.2d 255, >73 USPQ 378 (CCPA 1947)<; *Brailsford V. Lavet,* **>318 F.2d 942<, 138 USPQ 28 **>(CCPA 1963)<; and *Knell v. Muller,* 174 USPQ 460 (**>Comm'r Pat.< 1971).

1105.03 Decision on Motion To Amend or To Add or Substitute Another Application [R-14]

Motions by the interfering parties may be made under 37 CFR 1.231(a) (2) and (3) to add or substitute counts to the interference and also to substitute or involve in interference other applications owned by them. It should be noted that, if the examiner grants a motion of this character, a time will be set by the Board of Patent Appeals and Interferences for the nonmoving parties to present the allowed proposed counts in their applications, if necessary, and also a time will be set for all parties to file preliminary statements as to the allowed proposed counts. Note that the spaces for the dates on the decision letter are left blank by the examiner, >MPEP< § 1105.06. >Form paragraphs< for these requirements *>are< given at >MPEP< § 1105.06. If the claims are made by some or all of the parties within the time limit set, the interference is reformed or a new interference is declared by the examiner-in-chief.

Also, it should be noted that in an interference which involves *only applications,* a motion to add a count should not be granted unless the proposed count so differs from the original counts that it could properly issue in a separate patent. *Becker v. Patrick,* 47 USPQ 314, 315 (Comm'r Pat. 1939). The counts of any additional interferences should likewise differ in the same manner from the counts of the first interference and from each other.

When the interference involves a patent, the question of whether the proposed additional counts differ materially from the original counts does not apply, since in that case all of the patent claims which the applicant can make should be included as counts of the interference.

It will be noted that 37 CFR 1.231(a)(3) does not specify that a party to the interference may bring a motion to include an application or patent owned by said party as to subject matter, in addition to the existing issue, which is not disclosed both in said party's application or patent already in the interference and in an opposing party's application or patent in the interference. Consequently>,< the failure to bring such a motion will not be considered by the examiner to result in an estoppel against any party to an interference as to subject matter not disclosed in his case in the interference. On the other hand, if such a motion is brought during the motion period, secrecy as to the application named therein is deemed to have been waived, access thereto is given to the opposing parties and the motion may be transmitted by the examiner-in-chief; if so transmitted, it will be considered and decided by the primary examiner without regard to the question of whether the moving party's case already in the interference disclosed the subject of the proposed claims.

CONCURRENCE OF ALL PARTIES

Contrary to the practice which obtains when all parties agree upon the same ground for dissolution, the concurrence of all parties in a motion to amend or to substitute or add an application 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 the 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.

The examiner should also be careful not to refuse acceptance of a count broader than original counts solely on the ground that it does not differ materially from them. If that is in fact the case, and the proposed count is patentable over the prior art, the examiner should grant the motion to the extent of substituting the proposed count for the broadest original count so that the parties will not be limited in their proofs to include one or more features which are unnecessary to patentability of the count. Where there is room for a reasonable difference of opinion as to whether two claims are materially different (or patentably distinct) it is advisable to add the proposed claim to the issue rather than to substitute it for the original count. This will allow the parties to submit priority evidence as to both counts.

Affidavits or declarations are occasionally offered in support of or in opposition to motions to add or substitute counts or applications. The practice here is the same as in the case of affidavits or declarations concerning motions to dissolve that is, affidavits or declarations 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 or declarations relating to the prior art, or relating to patentable distinctness of the proposed counts from the existing issue or from each other, may be considered by analogy to 37 CFR 1.132.

If a motion under 37 CFR 1.231(a)(2) or (3) is denied because it is unpatentable on the basis of a reference which is not a statutory bar, and which is cited for the first time by the examiner in the decision, the decision may be modified and the

motion granted upon the filing of proper affidavits or declarations under 37 CFR 1.131 in the application file of the party involved. This is by analogy to 37 CFR 1.237, although normally, request for reconsideration of decisions on motions under 37 CFR 1.231 will not be entertained. 37 CFR 1.231(d). These affidavits or declarations should not be opened to the inspection of opposing parties and no reference should be made to the dates of invention set forth therein other than the mere statement that the effective date of the reference has been overcome. As in the case of other affidavits or declarations under 37 CFR 1.131, they remain sealed until the preliminary statements for the new counts are opened.

A member of the Board of Patent Appeals and Interferences must be consulted in connection with motions to add or substitute one or more counts or applications where the matter of right to make one or more counts is raised in an opposition to the motion or the primary examiner wishes to deny a motion for that reason although it has not been raised by a party. In the event the consultation ends in disagreement, the matter will be resolved by the **>Patent Policy and Projects Administrator<.

1105.04 Decision on Motion Relating to Benefit of a Prior Application Under 37 CFR 1.231(a)(4) [R-14]

The primary examiner also decides motions under 37 CFR 1.231(a)(4) relating to the benefit of a prior U.S. or foreign application under 35 U.S.C. 119 or 120. These may involve granting the moving party the benefit of a prior application, or denying the opponent the benefit of a prior application which was accorded to him when the interference was declared.

In deciding a motion of this nature, it is usually advisable to decide any other motions first. See >MPEP< § 1105.06. When the counts are changed as the result of a motion to amend under 37 CFR 1.231(a)(2), or a new interference is to be declared as the result of a motion under 37 CFR 1.231(a)(3), the parties should be accorded the benefit of any prior applications as to the new counts. However, the moving party will not be accorded the benefit of any prior applications as to the new counts unless the moving party has specifically requested it. 37 CFR 1.231(c).

In accordance with present practice a party may be accorded the benefit of a prior application with respect to a generic count if the prior application discloses a single species within the genus in such a manner as to comply with the first paragraph of 35 U.S.C. 112. See *In re Kirchner*, 134 USPQ 324 >(CCPA 1962)<; *Wagoner v. Barger*, 175 USPQ 85 >(CCPA 1972)<; *Kawai v. Metlesics*, 178 USPQ 158 >(CCPA 1973)<; *Weil v Fritz*, 196 USPQ 600 >(CCPA 1978)<. If the prior application is a U.S. application, continuity of disclosure must have been maintained between the prior application and the involved application either by copendency or by a chain of successively copending applications. See 35 U.S.C. 120. If the prior application is foreign, it must have been filed not more than twelve months prior to the earliest U.S. application to which the party is entitled. See 35 U.S.C. 119**>, MPEP< § 201.14* >and §< 201.15.

If the primary examiner has a reasonable doubt as to whether a party should be accorded the benefit of a prior application, the benefit of that application should not be granted. The examiner's decision on the question of benefit is not final, since the granting or denying of a motion under 37 CFR 1.231(a)(4) is a matter which may be considered at final hearing. 37 CFR 1.258(b).

As a result of the decision on motions it may be necessary for the primary examiner to change the order of the parties, which determines the order of taking testimony. The parties will be listed in the inverse order of their effective filing dates, with the party having the latest effective filing date being listed first. If a party is accorded the benefit of a prior application for less than all the counts, the filing date of that application will not be considered as his effective filing date when determining the order of the parties. Note that the burden of proof as to each count is specified by 37 CFR 1.257(a), so that even though a party who is senior as to some counts and junior as to others may be designated as junior party for procedural purposes and required to take his or her testimony first, he or she has the burden of proof only as to those counts for which he or she has the later effective filing date.

1105.05 Dissolution on Primary Examiner's Own Request Under 37 CFR 1.237 [R-14]

Former, now deleted 37 CFR 1.237. Dissolution at the request of examiner.

If, during the pendency of an interference, a reference or other reason be found which, in the opinion of the primary examiner, renders all or part of the counts unpatentable, the attention of the Board of Patent Interferences shall be called thereto. The interference may be suspended and referred to the primary examiner for consideration of the matter, in which case the parties will be notified of the reason to be considered. Arguments of the parties regarding the matter will be considered if filed within 20 days of the notification. The interference will be continued or dissolved in accordance with the determination by the primary examiner. 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 if they have not submitted arguments on the matter.

37 CFR 1.237 covers dissolution of an interference on the primary examiner's own motion if he or she discovers a reference or other reason which renders any count unpatentable.

The following procedures are available under the provisions of 37 CFR 1.237:

A. If the primary examiner becomes aware of a reference or other reason for dissolving the interference as to any count when the interference is before him or her 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 if they have not submitted arguments on the matter" (37 CFR 1.237). This same practice obtains when the primary examiner discovers a new reason for holding counts proposed under 37 CFR 231(a)(2) or (3) unpatentable. Under this practice, the primary examiner should

state that reconsideration may be requested within the time specified in 37 CFR 1.243(d).

B. If the primary examiner becomes aware of a reference or other reason for dissolving the interference as to any count when the interference is not before the examiner for determination of a motion, the primary examiner should call the attention of the examiner-in-chief to the matter. The primary examiner should include in his or her letter to the examiner-in-chief a statement applying the reference or reason to each of the counts of the interference which he or she deems unpatentable and should forward with the original signed letter a copy thereof for each of the parties of the interference. Form at >MPEP< § 1112.08.

The examiner-in-chief then may suspend the interference and forward a copy of the letter to each of the parties together with the following communication:

> The attached communication from the primary examiner has been forwarded to the examiner-in-chief. Inasmuch as the primary examiner has chosen to act under 37 CFR 1.237 this proceeding is suspended. Reconsideration can be requested in accordance with 37 CFR 1.237.

It is improper for a party to an interference to bring a reference or any other reason for dissolution to the attention of the primary examiner except by a motion to dissolve under 37 CFR 1.231 or, after the motion period has closed, by an inter partes letter calling attention to the reference or reason. See >MPEP< § 1111.01. In the latter case, consideration of the reference or reason is discretionary with the primary examiner. The examiner-in-chief may upon receipt of such a letter submit it to the primary examiner, who will follow the procedures set forth in paragraph B above if he or she considers that the subject matter corresponding to the count in issue is unpatentable over a reference or for any other reason.

On the other hand, if the primary examiner considers said subject matter to be patentable, under the circumstances, he or she will notify the examiner-in-chief informally of his or her conclusion. The examiner-in-chief will then send a letter to the parties to the effect that the primary examiner has considered the reference or other reason, etc. and still considers the subject matter corresponding to the count to be patentable. No reason or basis for the conclusion of the primary examiner will be stated in this letter, since the parties have no right to be heard on this question. See, *Hageman v. Young*, 1898 CD 18 (**>Comm'r Pat. 1898<).

In cases involving a patent and an application, where the primary examiner acts under 37 CFR 1.237, the practice enunciated in *Noxon v. Halpert*, 128 USPQ 481 (**>Comm'r Pat.< 1953) should be followed.

If, in an interference involving an application and a patent, the *applicant* calls attention to a reference which the applicant states anticipates the issue of the interference or makes an admission that applicant's claim corresponding to the count is unpatentable because of a public use or sale, **>35 U.S.C. 102(b)<, the examiner-in-chief will forthwith dissolve the interference, and the primary examiner will thereupon reject the claim or claims in the application over applicant's 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.

If preliminary statements have become open to all parties, 37 CFR 1.227, or if not and a party authorizes the primary examiner to inspect his or her preliminary statement, effect may be given thereto in considering the applicability of a reference to the count under 37 CFR 1.237. See >MPEP< § 1105.02.

1105.06 Form of Decision Letter [R-14]

In order to reduce the pendency of applications involved in interference proceedings, primary examiners are directed to render decisions on motions within 30 days of the date of transmittal to them.

The decision should separately refer to and decide each motion which has been transmitted by a statement of decision as granted or denied. *The decision must include the basis for any conclusions arrived at by the primary examiner.* Care must be taken to specifically identify which limitations of a count are not supported, or the portions of the specification which do provide support for the limitations of the count when necessary to decide a motion. Different grounds urged for seeking a particular action, such as dissolution for example, should be referred to and decided as separate motions. When a motion to dissolve on the ground of no right to make urges lack of support for more than one portion of a count and is granted, the examiner should indicate which portions of the count he or she considered not to be disclosed in the application in question. The same practice applies in denying a party the benefit or prior application.

Motions to amend or to substitute an application, if unopposed, do not require any statement of conclusion if granted, but a denial should be supplemented by a statement of the conclusion on which denial is based. If such a motion if granted over opposition, the reason for overruling the opposition should be given. If an application is to be added or substituted and the examiner has determined that it is entitled to the filing date of a prior application by virtue of a divisional, continuation or continuation-in-part relationship, the decision should so state.

It is advisable to decide motions to dissolve first, then motions to amend or to substitute an application, and finally motions to shift the burden of proof or relating to benefit of an earlier application taking into account any changes in the issue or the parties which may have been effected by the granting of other motions. If a motion to shift the burden of proof is granted the change in the order of parties should be stated.

If a motion to dissolve is granted as to all counts, no decision should be rendered on any motion for benefit that is before the Primary Examiner for determination. *Furukawa v. Garty*, 151 USPQ 110, (**>Commr. Pat.< 1965).

If a motion to amend is granted the decision should close with Form Paragraph 11.07 setting times for nonmoving parties to present claims corresponding to the newly admitted counts and for all parties to file preliminary statements as to them.

11.07 Decision on Motion, New Counts Added

Should the part [1] desire to contest priority as to proposed count

[2], a claim corresponding to such count should be submitted by amendment to the respective application(s) on or before ____. Failure to submit such an amendment within the time allowed will be taken as a disclaimer of the subject matter of the proposed count. The statements demanded by 37 CFR 1.215 et seq. with respect to proposed count [3] must be filed in a sealed envelope bearing the name of the party filing it and the number and title of the interference on or before ____. See also 35 CFR 1.231(f), second sentence. The time for serving preliminary statements, as required by 37 CFR 1.215(b), is set to expire on ___.

Examiner Note:

1. In bracket 1, insert "y" and the name of the party or the plural "ies" if more than one party.

2. In brackets 2 and 3, insert the count number(s).

3. The date blanks will be filled in by the examiner-in-chief.

If a motion to substitute another commonly owned application by a different inventor is granted, the decision should include Form Paragraph 11.08 setting a time for the substituted party to file a preliminary statement.

11.08 Decision on Motion, Party Substituted

The party [1] to be substituted for the party [2] must file on or before ___, a preliminary statement as required by 37 CFR 1.215 et seq. in a sealed envelope bearing the party's name and the number and title of the interference on or before ___.

Examiner Note:

The date blank will be filled in by the examiner-in-chief.

The decision should close with the warning statement in Form Paragraph 11.09.

11.09 Decision on Motion, Closing Statement

No request for reconsideration will be entertained. 37 CFR 1.231(d).

The spaces provided in the above paragraphs for the dates for copying allowed proposed counts and for filing and serving preliminary statements should be left blank. The appropriate dates will be inserted in the blank spaces by the Service Branch of the Board of Patent Appeals and Interferences before the decision is mailed.

Where there has been consultation with a member of the Board of Patent Appeals and Interferences as required by >MPEP< § 1105.01, the word "APPROVED" and spaced below this the Board member's name who was consulted should be typed at the lower left hand corner of the last page. The Board member will sign in the space below "APPROVED." If less than all of the motions decided required consultation, under >MPEP< § 1105.01, the word "APPROVED" should be followed by an indication of matters requiring such approval. For example,

"Approved as to the motion to shift the burden of proof."

After the decision is signed by the primary examiner and the proper clerical entry made, the complete interference file is forwarded to the Service Branch of the Board of Patent Appeals and Interferences for dating and mailing or for the Board member's signature if there has been a consultation.

The motion decision is entered in the index of the interference file; it should include the following information and be set forth in this order:

Date __ "Dec. of Pr. Exr." __ Granted. If some of the motions have been granted and others denied, the last entry will be "Granted and Denied", and of course, if all the motions have been denied, the last entry will be "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

"Amendment and Statement due __." Below are examples of entries which should be made in the interference brief in the section entitled "Decisions on Motion" (Form PTO-222) in each case involved in the interference:

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.

Determination of the next action to be taken is made by the Service Branch of the Board. Examples of such action may be redeclaration, entry of judgment, or setting of time for taking testimony and for filing briefs for final hearing.

1105.07 Petition for Reconsideration of Decision [R-14]

Petitions or requests for reconsideration of a decision on motions under 37 CFR * 1.231 or * 1.237 will not be given consideration *>37 CFR< 1.231(d). An exception is the case where under 37 CFR 1.237 the primary examiner for the first time takes notice of a ground for dissolution while the interference is before the examiner for consideration of motions by the parties and incorporates this matter in his decision so that the parties have had no opportunity to present arguments thereon. In this case the examiner's decision should include a statement to the effect that reconsideration may be requested within the time specified in 37 CFR 1.243(d). See >MPEP< § 1105.05.

1106 Redeclaration of Interferences and Additional Interferences [R-2]

Redeclaration of interferences where necessitated by a decision on motions under 37 CFR 1.231 will be done by >an examiner-in-chief<**, the papers being prepared by the Interference Service Branch. The decision signed by the primary examiner will constitute the authorization. The same practice will apply to the declaration of any new interference which may result from a decision on motions.

1106.01 After Decision on Motion [R-2]

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.

(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) is also included in the redeclaration papers. The old counts should retain their old numbers for ease of identification.

(3) Since all of the necessary information concerning an application to be added or substituted should appear in the motion decision or on the face of the application file no separate communication from the primary examiner to the >examiner-in-chief<** is necessary or desired.

The >examiner-in-chief<** will determine whether or not the nonmoving parties have copied the proposed counts which have been admitted within the time allowed and if they have,> the examiner-in-chief<** will proceed with the redeclaration. If a party fails so to copy a proposed count and thus will not be included in interference as to such count the application will be returned to the primary examiner by >the examiner-in-chief<** with a memorandum explaining the circumstances, unless the original interference will continue as to one or more counts. In the latter case the application concerned will be retained with the original interference and a new interference will be declared (assuming at least one other nonmoving party asserts the proposed count) on the new count and including only those parties who have asserted it in their applications.

In declaring a new interference as a result of a motion decision the notices to the parties and the declaration sheet will include a statement to the following effect:

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

In this case also, no times for filing preliminary statements or motions will be set.

1106.02 By Addition of New Party by Examiner [R-2]

>Former, now deleted< 37 CFR 1.238. Addition of new party by examiner.

If during the pendency of an interference, another case appears, claiming substantially the subject matter in issue, the primary examiner should notify the Board of Patent Interferences and request addition of such case to the interference. Such addition will be done as a matter of course by a patent interference examiner, if no testimony has been taken. If, however, any testimony may have been taken, the patent interference examiner shall prepare and mail a notice for the proposed new party, disclosing the issue in interference and the names and addresses of the interferants and of their attorneys or agents, and notices for the interferants disclosing the name and address of the said party and his attorney or agent, to each of the parties, setting a time for stating any objections and at his discretion a time of hearing on the question of the admission of the new party. If the patent interference examiner be of the opinion that the new party should be added, he shall prescribe the conditions imposed upon the proceedings, including a suspension if appropriate.

37 CFR 1.238 states the procedure to be followed when the examiner finds, or there is filed, other or new applications interfering as to some or as to all of the counts. The procedure when any testimony has been taken differs considerably from the procedure when no testimony has been taken. However, the difference does not involve the primary examiner but rather affects the action taken by the examiner**>-in-chief<.

The primary examiner forwards Form PTO-850 accompanied by the additional application to the Interference Service Branch, giving the same information regarding the additional application as in connection with an original declaration and also including the number of the interference. If no testimony has been taken, the >examiner-in-chief<** will as a matter of course suspend the interference and redeclare it to include the additional party setting such times for the new party or all parties as is consistent with the stage of proceedings at that point. If the additional party is to be added as to only some of the counts, the >examiner-in-chief<** will declare a new interference as to those counts and reform the original interference omitting the counts which are included in the new one. In this case the fact that the issue was in another interference should be noted in all letters in the new interference.

1106.03 After Resumption of *Ex Parte* Prosecution Subsequent to the Termination of an Interference by Dissolution Under 37 CFR 1.231 or 1.237 [R-14]

If the examiner finds upon further consideration that the position taken in a decision on motion dissolving an interference was incorrect and that the interference should be reinstituted, the following procedures should be followed:

1. The examiner should upon allowance of the claims in the application which were previously denied, corresponding to the former counts in the interference clearly indicate in the action to the applicant, the reasons for the change in position as compared to the position taken in the decision on motions.

2. This action to the applicant allowing such claims should have the approval of and bear the approval of the Group Director.

3. The application(s) and patent(s) involved in the reinstituted interference should be forwarded together with the necessary forms PTO-850 (see >MPEP< § 1112.05) and the old terminated interference files to the Board of Patent Appeals and Interferences.

4. At the top of the form PTO-850, in the legend "Interference-Initial Memorandum", the word "Initial" should be stricken and the word "Reinstatement" should be substituted therefor in red ink.

5. The forms PTO-850 must bear the approval of the Group Director.

1107 >Action Following Termination of<** Interference [R-2]

>The action to be taken by the examiner following termination of the interference depends upon how the interference was terminated, and in some instances, the basis of the termination. Interferences conducted under 37 CFR 1.201 - 1.288 may be terminated either by dissolution or by an award of priority.

After the Board of Patent Appeals and Interferences has rendered a final decision in an interference, the losing party may either appeal to the Court of Appeals for the Federal Circuit, under 35 U.S.C. 141, or file a civil action in a United States district court, under 35 U.S.C. 146. Upon the filing of an appeal to the Court of Appeals for the Federal Circuit, the opposing party may elect to have the proceeding conducted in a district court. In either event, the files will be retained at the Board until the court proceeding has terminated. (The PTO may, but normally does not, issue the application of a winning party in an interference involving only applications, notwithstanding the filing of a civil action under 35 U.S.C. 146 by the losing party. See *Monaco v. Watson*, 270 F.2d 335, 122 USPQ 564 (D.C. Cir. 1959).<**

*>When< the files >are<** returned to the examining group >after termination of the interference,< the primary examiner is required to make an entry on the index in the interference file on the next vacant line that the decision has been noted, such as by the words "Decision Noted" and the primary examiner's initials. The interference file is returned to the Service Branch of the Board of Patent >Appeals and< Interferences when the examiner is through with it. There it will be checked to see that such note has been made and initialed before filing away the interference record.

1108 Entry of Amendments Filed in Connection With Motions [R-14]

Under 37 CFR 1.231(c) a moving party is required to submit with his or her motion as a separate paper, an amendment embodying the proposed claims if the claims are not already in the application concerned. In the case of an application involved in the interference, this amendment is not entered at that time but is placed in the application file.

An amendment filed in connection with a motion to add or substitute counts to an interference must include any claim or claims to be added and be accompanied by the appropriate fees (or fee authorization), if any, which would be due if the amendments were to be entered, even though it may be that the amendments will never be entered. Only upon the granting of the motion may it be necessary for the other party or parties to present the claims, but the fees (or fee authorization) must be paid whenever claims are presented. Claims which have been submitted in response to a suggestion by the Office for inclusion in an application must be accompanied by the fee due (or fee authorization), if any. Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment.

If the motion is granted the amendment is entered at the time decision on the motion is rendered. If the motion is not granted, the amendment, though left in the file, is not entered and is so marked.

If the motion is granted only in part and denied as to another part, only so much of the amendment as is covered in the grant of the motion is entered, the remaining part being indicated and marked "not entered" in pencil. (See 37 CFR 1.266.)

In each instance the applicant is informed of the disposition of the amendment in the first action in the case following the termination of the interference. If the case is otherwise ready for issue, the applicant is notified that the application is allowed and the Notice of Allowance will be sent in due course, that prosecution is closed and to what extent the amendment has been entered.

As a corollary to this practice, if 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 through additional claims had been presented in connection with a motion in the interference.

It should be noted at this point that, under the provisions of *>37 CFR< 1.262(d), the termination of an interference on the basis of a disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest filed by an applicant operates without further action as a direction to cancel the claims involved from the application of the party making the same.

1109(a) Interference Terminated by Dissolution [R-14]

If the interference was dissolved, the action to be taken by the examiner depends on the basis for the dissolution.

A. Common ownership: If the interference was dissolved because the involved applications were commonly assigned (37 CFR 1.202(c)), the examiner should proceed as indicated in >MPEP< § 804.03.

B. No interference in fact: A holding of no interference in fact means that the claims of the parties which correspond to the counts are drawn to patentably different inventions. Therefore, if the interference is dissolved on the ground of no interference in fact, either as a result of the granting of a motion to dissolve under 37 CFR 1.231(a)(1), or by the Commissioner pursuant to a recommendation by the Board of Patent Appeals and Interferences under 37 CFR 1.259, the parties may each be issued a patent on their corresponding claims assuming that those claims are otherwise patentable. *Knell v. Muller*, 174 USPQ 460 (*>Comm'r Pat.< 1971).

C. Unpatentability: The interference may be dissolved on the ground of unpatentability either as a result of the granting of a motion to dissolve under 37 CFR 1.231(a)(1) (on a ground other than no interference in fact) or on the examiner's own motion under 37 CFR 1.237 (see >MPEP< § 1105.05). In either

case, the application or applications to which the ground of dissolution applies must be rejected on that ground. For example, if the interference is dissolved on the ground that the claims of A which correspond to the counts are unpatentable to A (under 35 U.S.C. 112, 102, 103, etc.), A's claims should be rejected as unpatentable on that ground in the next Office action. The rejection may of course also be made as to any other claims of A as well as to any claims of A's opponent to which it applies, if the opponent is an applicant. See >MPEP< § 1302.12 with respect to listing references discussed in motion decisions. It is proper to refer to the "application of (name), an adverse party in interference (No.)," but neither the Serial Number nor the filing date of such application should be included in the Office action.

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

The examiner should also reject on the ground of estoppel any claims of the junior party which could have formed the basis of a new or amended count of the interference, i.e., by a motion under 37 CFR 1.231(a)(2) or 1.231(b). (37 CFR 1.257(b) specifically provides that this ground of estoppel does not apply to the senior party.) For example, if the interference was dissolved on the ground that the junior party did not support a limitation of his claim corresponding to the count, and the limitation was an immaterial limitation, a claim later presented by the junior party omitting that limitation should be rejected on the ground of estoppel, in that the junior party could have moved in the interference to substitute it for the involved claim. *Ex parte Peabody*, 1927 C.D. 83 (*>Comm'r Pat.< 1926). Likewise, if the junior party claims an invention which was commonly disclosed in the applications of the junior and senior parties, the claims to that invention should be rejected on the ground that the junior party is estopped for failing to move to add that invention to the issue of the interference. *Meitzner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Note that if the senior party was a patentee, the junior party applicant cannot be estopped for failing to move to add claims to commonly-disclosed subject matter which was not claimed in the patent, since the PTO cannot require a patentee to file a reissue application. However, the junior party's claims to such subject matter may be rejected over the patent under 35 U.S.C. 102(e)/103, leaving the possibility that the junior party may antedate the patent by a showing under 37 CFR 1.131.

D. Dissolution under 37 CFR 1.262(b): With certain exceptions specified in 37 CFR 1.262(b) an applicant may obtain voluntary dissolution of the interference by filing an abandonment of the contest or abandonment of the application. The abandonment of the contest operates as a direction to cancel the involved claims from that party's application (37 CFR 1.262(d)). If as a result all claims of the application are eliminated, see the fourth paragraph of >MPEP< § 1109.02 for the action to be taken. Even though an abandonment of the contest or of the application operates to dissolve the interference, 37 CFR 1.262(b) provides that "...such dissolution shall in subsequent proceedings have the same effect with respect to the party filing the same as an adverse award of priority." Accordingly, in any subsequent prosecution, the party who filed the abandonment stands in the same position as the losing party referred to in >MPEP< § 1109.02.

E. Statutory Disclaimer: 37 CFR 1.263 provides that if a patentee files a statutory disclaimer of patent claims involved in an interference, the interference will be dissolved *pro forma* as to these claims. After dissolution, the application of the opponent may still be rejected over the patent, if the patent constitutes a reference under 35 U.S.C. 102(e)/103. However, if the disclaimer has removed from the patent all claims to the rejected invention, the applicant would be free to attempt to antedate the patent by a showing under 37 CFR 1.131.

F. *Pro Forma* Dissolution: The interference may have been dissolved *pro forma* by the patent interference examiner or examiner-in-chief because the parties agreed on a ground of dissolution (see >MPEP< § 1105.02, third paragraph), or because an applicant in interference with a patent admitted that the application claims corresponding to the counts are unpatentable over a reference, or prior public use or sale (see >MPEP< § 1105.05, second-to-last paragraph). In these instances the claims should be rejected on the agreed ground, or on the admission, without regard to the merits of the matter. *Ex parte Grall*, 202 USPQ 701 (Bd. App. 1978).

1109(b) Interference Terminated by Judgment [R-14]

The interference may be terminated by the Board of Patent Appeals and Interferences awarding a judgment of priority of invention to a party as to all of the counts, or to one party as to some of the counts, and to the other party as to the rest of the counts (a "split award of priority").

After the Board's decision, including any decision on reconsideration, the losing party may appeal to the Court of Appeals for the Federal Circuit, or file a civil action in United States district court. In an interference involving only applications, the PTO may send the winning party's case to issue notwithstanding the filing of a civil action, see *Monaco v. Watson*, 270 F.2d 335, 122 USPQ 564 (D.C. Cir. 1959), but normally does not do so. *>Martin v. Clevenger*, 11 USPQ2d 1399 (Comm'r Pat. 1989).<

If an appeal or civil action is not filed, the interference is terminated as of the date the time for filing an appeal or civil action expired. *Tallent v. Lemoine*, 204 USPQ 1058 (Comr. 1979). If an appeal is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO. *In re Jones*, 542 F.2d 65, 191 USPQ 249 (CCPA 1976). If a civil action is filed, and the decision of the district court is not appealed, the interference terminates on the date >the time for filing an appeal from<* the court's decision >expires. *Hunter v. Beissbarth*, 15 USPQ2d 1343 (Comm'r Pat. 1990)<.

The files are not returned to the examining group until after termination of the interference. 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. The date when the priority decision becomes final does not mark the beginning of a statutory period for response by the applicant. See *Ex parte Peterson*, >49 USPQ 119,< 1941 C.D. 8 (Comm'r Pat. >1941<).

If an application has been withdrawn from issue for interference and is again passed to issue, a notation "Re-examined and passed for issue" is placed on the file wrapper together with a new signature of the primary examiner in the box provided for this purpose. Such a notation will be relied upon by the Patent Issue Division as showing that the application is intended to be passed for issue and makes it possible to screen out those applications which are mistakenly forwarded to the Patent Issue Division during the pendency of the interference.

See >MPEP< § 1302.12 with respect to listing references discussed in motion decisions.

Form Paragraph 11.02 may be used to resume ex parte prosecution.

11.02 Ex Parte Prosecution is Resumed

Interference No. [1] has been terminated by a decision [2] to applicant. Ex parte prosecution is resumed.

Examiner Note:

In bracket 2, insert whether favorable or unfavorable.

1109.01 The Winning Party [R-14]

If the winning party's 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 judgment in favor of the applicant, (as for example where the interference involved the 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 period of two months running from the date of such notice. See *Ex parte Peterson*, >49 USPQ 119,<1941 C.D. 8 **>(Comm'r Pat. 1941)<. 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.

Form Paragraph 11.03 is suggested for notifying the winning party that the application contains an unanswered Office action:

¶ 11.03 Office Action Unanswered

This application contains an unanswered Office action mailed on [1]. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO SUCH ACTION IS SET TO EXPIRE [2] FROM THE DATE OF THE LETTER.

Examiner Note:

This paragraph must be preceded by paragraph 11.02.

If the prosecution of the winning party's case had not been closed, the winning party generally may be allowed additional and broader claims to the common patentable subject matter. (Note, however, *In re Hoover Co.*,* 1943 C.D. 338, 57 USPQ 111 **>(CCPA 1943).< The winning party of the interference is not denied anything he or she was in possession of prior to the interference, nor has he or she acquired any additional rights as a result of the interference. His or her 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 of two months within which to file an appeal or cancel the finally rejected claims.

1109.02 The Losing Party [R-14]

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" (37 CFR 1.262(d)). Abandonment of the contest has a similar result. See >MPEP< § 1109(a). The claims corresponding to the interference counts thus disclaimed, conceded, or abandoned are accordingly canceled from the application of the party filing the document which resulted in the adverse judgment.

If the judgment is based on grounds other than those referred to in the preceding paragraph, the claims corresponding to the interference counts in the application of the losing party should be treated in accordance with 37 CFR 1.265, which provides that such claims "stand finally disposed of without further action by the examiner and are not open to further ex parte prosecution." Accordingly, a pencil line should be drawn through the claims as to which a judgment of priority adverse to applicant has been rendered, and the notation "37 CFR 1.265" should be written in the margin to indicate the reason for the pencil line. If these claims have not been canceled by the applicant and the case is otherwise ready for issue, these notations should be replaced by a line in red ink and the notation "37 CFR 1.265" in red ink before passing the case to issue, and the applicant notified of the cancellation by an Examiner's Amendment. If an action is necessary in the application after the interference, the applicant should be informed that "Claims (designated by numerals), as to which a judgment of priority adverse to applicant has been rendered, stand finally disposed of in accordance with 37 CFR 1.265."

If, as the result of one or both of the two preceding paragraphs all the claims in the application are eliminated, a letter

should be written informing the applicant that all the claims in the application have been disposed of, indicating the circumstances, that no claims remain subject to prosecution, and that the application will be sent to the abandoned files with the next group of abandoned applications. Proceedings are terminated as of the date the interference terminates. See >MPEP< § 1109(b), third paragraph.

Any remaining claims in each losing party's application should be reviewed to determine whether they should be rejected as unpatentable over the lost counts, or on the ground of interference estoppel.

1. Lost Counts: The losing party's claims which are not patentable over the subject matter of the counts which were awarded to the winning party should be rejected as unpatentable over the lost counts, under 35 U.S.C. 102(g)/103. *In re Yale*, 347 F.2d 995, 146 USPQ 400 (CCPA 1965); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976).

2. Interference Estoppel: Claims which are not unpatentable over the lost counts, but which are drawn to subject matter which is common to the disclosures of the losing party and winning party and therefore could have been made counts of the interference if the losing party had filed a motion to amend under 37 CFR 1.231(a)(2) or to declare an additional interference under 37 CFR 1.231(a)(3), should be rejected on the ground of interference estoppel. Note, however, that interference estoppel does not apply:

A. Where the losing party was the senior party, and the award of priority (judgment) was based solely on a ground or grounds ancillary to priority. 37 CFR 1.257(b).

B. Where the losing party's claims do not read directly on the common disclosure of the losing and winning parties. *In re Risse*, 378 F.2d 948, 154 USPQ 1 (CCPA 1967); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976).

C. Where the winning party was a patentee, and the losing party's claims are drawn to subject matter not claimed by the patentee. In such a case, the losing applicant cannot be estopped for failing to move to add claims to commonly-disclosed subject matter which was not claimed in the patent, since the PTO cannot require a patentee to file a reissue application. However, if the losing party-applicant's effective filing date is later than the winning patentee's effective U.S. filing date, the losing party's claims to such subject matter may be rejected over the patent under 35 U.S.C. 102(e)/103, leaving the possibility that the junior party may antedate the patent by a showing under 37 CFR 1.131.

If the only reason the losing party lost the interference was the inability to overcome the filing date of the winning party's prior foreign application, see *Ex parte Tytgat*, 225 USPQ 907 (Bd. *>App.< 1985).

Where the winning party is an applicant, reference should be made only to the application of (Name), the winning party in Interference (No.), but the serial number or the filing date of the other case should not be included in the Office Action.

If the losing party's case was under rejection at the time the interference was declared, such rejection is ordinarily repeated (either in full or by reference to the previous action), along with any rejections on the grounds of unpatentability over the counts or interference estoppel, as described above.

If the losing party's application was under final rejection or ready for issue, his or her 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 the opponent's drawing or specification during the interference, the losing party may order a copy thereof to enable said party to respond to a rejection based on the successful party's disclosure. Such order is referred to the examiner-in-chief 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 37 CFR 1.231(a) (2) and (3) may apply where the interference terminates in a dissolution as well as where it is ended by a judgment. See >MPEP< § 1109(a). However, 37 CFR 1.231(a)(3) limits the doctrine of estoppel to subject matter in the cases involved in the interference. See >MPEP< § 1105.03.

1111.01 Interviews

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

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.

1111.02 Record in Each Interference Complete

When there are two or more interferences pending in this Office relating to the same subject matter, or in which substantially the same applicants or patentees are parties thereto, in order that the record of the proceedings in each particular interference may be kept separate and distinct, all motions and papers sought to be filed there in 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.

1111.03 Overlapping Applications [R-14]

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 the counts of the interference and by insisting on proper lines of division or distinction between the applications. In some instances suspension of action by the Office cannot be avoided. See >MPEP< § 709.01.

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

1111.05 Amendments Filed During Interference [R-14]

The disposition of amendments filed in connection with motions in applications involved in an interference, after the interference has been terminated, is treated in >MPEP< § 1108. If the amendment is filed pursuant to a letter by the primary examiner, after having gotten jurisdiction of the involved application for the purpose of suggesting a claim or claims for interference with another party and for the purpose of declaring an additional interference, the examiner enters the amendment and takes the proper steps to initiate the second interference.

OTHER AMENDMENTS

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

If the amendment is one filed in a case where *ex parte* prosecution of an appeal to the Board of Patent Appeals and Interferences is being conducted concurrently with an interference proceeding, and if it relates to the appeal, it should be treated like any similar amendment in an ordinary appealed case.

When an amendment filed during interference purports to put the application in condition for another interference either with a pending application or with a patent, the primary examiner must personally consider the amendment sufficiently to determine whether, in fact, it does so.

If the amendment presents allowable claims directed to an invention claimed in a patent or in another pending application in issue or ready for issue, the examiner borrows the file, 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 >MPEP< § 1112.10. Where the amendment copies claims of a patent not involved in the interference and which the examiner believes are not patentable to the applicant, and where the application is open to further *ex parte* prosecution, 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 nonentry of the amendment. See letter form in >MPEP< § 1112.10.

1111.06 Notice of Rule 37 CFR 1.231(a)(3) Motion Relating to Application Not Involved in Interference [R-2]

Whenever a party in interference brings a motion under 37 CFR 1.231(a)(3) affecting an application not already included in the interference, the >examiner-in-chief<** should at once send the primary examiner a written notice of such motion and the primary examiner should place this notice in said application file.

The notice is customarily sent to the group which declared the interference since the application referred to in the motion is generally examined in the same group. However, if the application is not being examined in the same group, then the correct group should be ascertained and the notice forwarded to that Group.

This notice serves several useful and essential purposes, and due attention must be given to it when it is received. First, the examiner is cautioned by this notice not to consider *ex parte*, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party in interest.

Second, if the application which is the subject of the motion is in issue and the last date for paying the issue 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 or declaration under 37 CFR 1.131, this must be sealed because the opposing parties have access to the application.

1111.07 Conversion of Application [R-14]

Although, for simplicity, the subject of this section is titled "Conversion of Application," it includes all cases where an application is converted to change the applicant. See >MPEP< § 201.03.

If conversion is attempted after declaration of an interference but prior to expiration of the time set for filing motions, the matter is treated as an *inter partes* matter, subject to opposition. That is, the filing of conversion papers during this period whether or not accompanied by a formal motion will be treated as a motion under 37 CFR 1.231(a)(5) and will be transmitted to the primary examiner for decision after expiration of the time within which reply briefs may be filed, along with any other motions which may have been filed. If conversion is permitted, redeclaration will be accomplished as in other cases on the basis of the decision on motions.

If conversion is attempted after the close of the motion period but prior to the taking of any testimony, the examiner-in-chief may, at his discretion, either transmit the matter to the primary examiner for determination or defer consideration thereof to final hearing for determination by the Board of Patent Appeals and Interferences. If transmitted to the primary examiner, the matter is treated as outlined in the preceding paragraph.

If conversion is attempted after the taking of testimony has commenced, the examiner-in-chief will generally defer consideration of the matter to final hearing for determination by the Board of Patent Appeals and Interferences.

In any case the examiner must, when deciding the question of converting an application, determine whether the legal requirements for such conversion have been satisfied, just as in the ordinary *ex parte* treatment of the matter. Also as in *ex parte* situations the examiner should make of record the formal acknowledgment of conversion as required by >MPEP< § 201.03.

A party may occasionally seek to substitute an application with a lesser or greater number of applicants for the application originally involved in the interference. Such substitution is treated in the same manner as the conversion of an involved application as described above.

1111.08 Reissue Application Filed While Patent Is in Interference [R-2]

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

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the examiner is taken thereon.

Such applications are normally forwarded by the Application Division to the Office of the >Assistant Commissioner for Patents<**. A letter with titling relative to the interference is placed in the interference file by the >Assistant< 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 of course 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."

Should an application for reissue of a patent which is involved in an interference reach the examiner without having a copy of the letter by the >Assistant< Commissioner attached, it should be promptly forwarded to the Office of the >Assistant Commissioner for Patents<** with an appropriate memorandum.

1111.10 Benefit of Foreign Filing Date [R-2]

If a request for the benefit of a foreign filing date under 35 U.S.C. 119 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 having a foreign filing date which is not accorded benefit in the declaration papers should file a motion to shift the burden of proof or for benefit of that filing date under 37 CFR 1.231(a)(4) and the matter will be considered on an *inter partes* basis.

1111.13 Consultation With Examiner-in-Chief [R-14]

In addition to the consultation required in connection with certain motion decisions in >MPEP< § 1105.01, the examiner should consult with a member of the Board of Patent Appeals and Interferences in any case of doubt or where the practice appears to be obscure or confused. In view of their specialized experience they may be able to suggest a course of action which will avoid considerable difficulty in the future treatment of the case.

1111.14 Correction of Error in Joining Inventor [R-14]

Requests for certificates correcting the misjoinder or nonjoinder of inventors in a patent are referred to the **>exam-

ining group< for consideration except where the patent is involved in an interference. If the patent is involved in interference when the request is filed, the matter should be referred to the Board of Patent Appeals and Interferences and will be considered *inter partes*. Service of the request on the opposing party will be required and any paper filed by an opposing party addressed to the request will be considered if filed within 20 days of service of a copy of the request on the opposing party. Following this 20 days, the Chairman of the Board of Patent Appeals and Interferences will consider the matter to the extent of determining whether the request *prima facie* conforms to applicable law and policy. During the interference, a copy of any decision concerning the request will be sent to the opposing party as well as to the requesting party. Issuance of the certificate will be withheld until the interference is terminated since evidence adduced in the interference may have a bearing on the question of joinder. See also >MPEP< § 1481.

1112.05 Initial Interference Memorandum [R-15]

Form PTO-[illegible] U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

INTERFERENCE—INITIAL MEMORANDUM

EXAMINERS INSTRUCTIONS— (See MPEP 2309.02) This form need not be typewritten. Complete the items below and forward to the Group Clerk with all files including those benefit of which has been accorded. The parties need not be listed in any specific order. Use a separate form for each count.

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following count:

This is count 1 of 1 count(s)

1. NAME	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Smith et al.	06/123,456	5-22-82	4,567,890

The claims of this party which correspond to this count are:	The claims of this party which do not correspond to this count are:
(1) 2, 3, 4, 9/1	5-8, 9/2

*Accorded benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY

2. NAME	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Jones	06/345,678	12-1-82	

The claims of this party which correspond to this count are:	The claims of this party which do not correspond to this count are:
11, 12 (allowable)	3-6 (not allowable) 7-10 (allowable)

*Accorded benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
U.S.	05/987,654	8-8-78	4,456,789
U.S.	06/012,345	11-11-81	

3. NAME	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Watanabe et al.	06/456,789	5-10-83	

The claims of this party which correspond to this count are:	The claims of this party which do not correspond to this count are:
1, 2 (not allowable) 3-5 (allowable)	6 (allowable)

*Accorded benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Japan	57-12345	5-10-82	

If a claim of any party to exactly the same as this count, it should be stated above. If not, type the count in this space (attach additional sheet if necessary):

*The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application necessary for continuity.

DATE	PRIMARY EXAMINER	TELEPHONE NO.	ART UNIT
2-11-85	Mary Johnson	557-1000	101

NOTE: Forward all files including those benefit of which is being accorded.

GROUP DIRECTOR SIGNATURE (if required)

1112.08 Primary Examiner Initiating Dissolution of Interference, 37 CFR 1.237(a) [R-14]

This form is to be used in all cases except when the interference is before the primary examiner for determination of a motion. Sufficient copies of this form should be prepared and sent to the Examiner-in-chief so that he >or she< may send a copy to each party.

PATENTEE INVOLVED

If one of the parties is a patentee, no reference should be made to the *patent* claims nor to the fact that such claims correspond to the counts, and the group director's approval is required if the ground of rejection would also be applicable to the patent claims. However, this restriction does not apply to claims of the application. Language such as the following is suggested: "Applicant's claims — are considered anticipated by (or unpatentable over) the — reference."

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

In re Interference No. 98,000

John Willard
v.
Luther Stone

Under the provisions of 37 CFR 1.237, your attention is called to the following patents:

197,520	Jolien	1-1897	214-26
1,637,468	Moran	4-1950	214-26

Counts 1 and 2 are considered anticipated by either of

these references under 35 U.S.C. 102 for the following reasons: (The Examiner discusses the references.) MMWard:cch

Copies to:
John Jones
133 Fifth Avenue
New York, New York 11346

Leonard Smith
460 Munsey Building
Washington, D.C. 20641

1112.10 Letter Denying Entry of Amendment Seeking Further Interference

(With application or patent not involved in present interference)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No _____.

Z. Green A.U. 123

Serial No. 999,999 7/3/79
Richard A. Green
PIPE CONNECTOR

Charles A. White
123 Main Street
Dayton, Ohio 65497

The amendment filed_____ has not now been entered since it does not place the case in condition for another interference.

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

(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 notpresently allowable in this case.

Z. Green:ns
(703) 557-2802