

Ex Parte Smart Expands the Agilent Doctrine

By Rick Neifeld, Neifeld IP Law, PC¹

Ex parte Smart, Appeal No. 2009-015036, application 10/818,920 (03 January 2011), was published by the USPTO as an "informative" BPAI opinion on Saturday 4/2/11. See <http://www.uspto.gov/ip/boards/bpai/decisions/inform/fd09-015036.pdf>. Smart is precedential in the sense that it is the first published Board decision on an appeal dealing with the Agilent Technologies, Inc. v. Affymetrix, Inc., 567 F.3d 1366, 91 USPQ2d 1161 (Fed. Cir. 2009) claim construction doctrine for copied claims (herein after, the Agilent doctrine). And Smart significantly expands the Agilent doctrine into ex parte pre-interference prosecution, as explained below.

By way of background, the Agilent doctrine requires that, during an interference proceeding, claims that have been copied from the target case be construed based upon the disclosure of the target case for purposes of determining whether the copier has written description support, instead of being construed based upon the disclosure of the copier.

In Smart, the panel quoted from Robertson v. Timmermans, 603 F.3d 1309, 1312 (Fed. Cir. 2010)(Robertson was a follow on to Agilent) for the proposition that, during an interference proceeding, for purposes of determining written description support, the "originating disclosure provides the meaning of the pertinent claim language," and for the proposition that, during an interference proceeding, for purposes of determining invalidity over prior art, "the claims should be interpreted in light of their host disclosure.

The Smart panel noted the following facts relevant to whether to apply the Agilent doctrine:

Appellant filed a preliminary amendment to draft "claims 100-169 . . . in view of three published application [sic]" filed by Sun [footnote 2 omitted] and asserted that these "new claims are directed to the same or substantially the same subject matter as at least some of the published claims of the published application [sic]" (Preliminary Amendment 16, filed Dec. 9, 2004). Appellant asserts that his assignee is entitled to an interference with the assignee of Sun's three applications (Second Preliminary Amendment 17, filed Jan. 6, 2006). [Page 2; underlining added for emphasis.]

Based upon those factual assertions, the Smart panel applied the Agilent doctrine to Smart's claims on appeal. Specifically, with respect to the written description rejections, the Smart panel stated that:

For the purpose of determining whether Appellant's Specification provides adequate written description, we look to the meaning of the pertinent claim language as set forth in Sun's originating disclosures. See Robertson, 603 F.3d at 1312.

Smart is an ex parte appeal in an application in which no interference proceeding had been declared. The only facts relied upon in the Smart opinion that could be the basis for

applying the Agilent doctrine were that the appellant asserted that (1) their claims were "directed to the same or substantially the same subject matter" (the 135(b) test) as Sun's claims and the appellant asserted that (2) the appellant was "entitled" to an interference with Sun. Significantly, the Smart panel made no findings of fact supporting the existence of an interference in fact between Smart and Sun, and the Smart panel contains no conclusion of law that there is an interference in fact between Smart and Sun. That is, the panel relied upon the appellant's (somewhat confused) legal assertions that there existed an interference in fact, as its basis to conclude that the Agilent doctrine applied.

A troubling aspect of Smart is that it contains no analysis of specifically why it applied the Agilent doctrine. This is troubling because the facts the Smart panel stated that relate to the Agilent doctrine were legally insufficient to demonstrate that Smart's claims interfere, in fact, with Sun's claims. The existence of interference in fact, is a prerequisite for an interference proceeding, and it is only in an interference proceeding that the holding in Agilent requires application of the Agilent doctrine. Accordingly, Smart expanded the Agilent doctrine, without explaining exactly how or why. This leaves open the question of exactly what will trigger application of the Agilent doctrine, during ex parte prosecution.

Smart's assertion that its claims were directed to substantially the same subject matter as Sun's claims is not the relevant legal criteria for determining whether interference in fact exists. Winter v. Fujita, 53 U.S.P.Q.2d 1234, 1243 (Bd. Pat. App. & Int. Nov. 16, 1999) and its progeny define the two-ways patentability test for existence of interference in fact, not the 135(b) "substantially the same subject matter" test. Since these two tests are different, it is unclear what weight the panel accorded Smart's "substantially the same subject matter" assertion in deciding to apply the Agilent doctrine. Moreover, the Smart decision cites no actual proof of Smart's "substantially the same subject matter" assertion.

Smart's bare legal assertion that Smart is "entitled to an interference " with Sun does not define any legal criteria. Moreover, the Smart decision cites no actual proof of Smart's entitlement assertion. Thus, exactly what actions by an ex parte applicant trigger application of the Agilent doctrine, are unclear.

What is clear, is that it can be applied ex parte, in certain circumstances.²

1. I can be reached via the firm web site <http://www.Neifeld.com>
2. While the file history of Smart may contain additional assertions relevant to the Agilent doctrine, they were not cited in Smart. The Smart decision should explain why the facts and law it cited led to a conclusion that the Agilent doctrine applied, so that the BPAI guidance provided by Smart on this point is clear, both to the examiner corps and the interference bar.