

Strategies ... to Prepare for an Interference

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I. The Benefits of Timely Recognizing a Potential Interference

1. Avoids the 135(b) Bar to an Interference
2. Avoids the 135(b) Bar to getting a Patent
3. Prevents Opponent from Getting a Patent
4. Avoids Prejudicial Burden of Proof
5. Increases chances of getting related litigation stayed
6. Per Contra, Per Contra

II. Obtain and Use Competitive Intelligence

1. Periodic watch and special searches:
 - i. Database service providers
 - ii. AIP, SCIP, SLA, and PIUG organizations
2. Consider including in IP agreements terms defining the right to pursue inter partes administrative actions.

III. Patent Procedures Relating to Competitive Intelligence

1. 37 CFR 1.59 petition to expunge information
2. TEST - not "important to a reasonable examiner in deciding whether to allow the application to issue as a patent"
3. Useful for IDS related applications statements vis-à-vis both unpublished applications and eventually abandoned unpublished applications

III. Patent Procedures Relating to Competitive Intelligence

4. See form PTO/SB/68 box 1B – The PTO will provide access to any file if it is referred to in *any* paper in a publicly available file.
5. Continuity link in PAIR provides parent and child data.

III. Patent Procedures Relating to Competitive Intelligence

6. IB in Zurich will provide published PCT priority documents upon request.
7. USPTO's PCT Legal Office will tell you (in response to a written request) if a 371 of a PCT has been filed.
8. All papers listed in PAIR available online.

IV. The Law Relevant to Requesting an Interference

1. 35 USC 102(g)(1) - Procedural limitations on Secret Prior Art prejudice foreign companies; interference is their only recourse.
2. 35 USC 135(a) - Criteria for an Interference is (currently) a two-ways obviousness test.
3. PTO currently has an anti interference attitude.

IV. The Law Relevant to Requesting an Interference

4. 35 USC 135(b) - The Statutory Bar “Triple Whammy”
 - i. Bars an interference
 - ii. Bars patent claims to 135(b) subject matter
 - iii. Precludes claims subsequently rejected under 102(g) (But see In re Eichmeyer)

IV. The Law Relevant to Requesting an Interference

5. 135(b)(2) applies to PCT applications' claims *in any language*.

Note: Due diligence search should include PCT applications published in all languages. Automated translation web sites available to reduce this burden.

Note: Effect of 135(b) on PTO examination has been small. That may change as effects of publication kick in.

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

- A. **37 CFR 1.604(a)** specifies the requirements for requesting an interference *with a pending application*, which are:
1. Propose a count
 - i. Count defines who will win on priority
 - ii. Count should read on your earliest conception and RTP and be supported by your specification
 - iii. *Propose the right count.*

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

2. Present a claim that corresponds to the proposed count
3. Identify a target application and, if known, its corresponding claims
4. *Explain why an interference should be declared:*
 - i. “Purpose of an interference” dicta
 - ii. 3/6 month rule - MPEP 2303
 - iii. Patent impact on business considerations?

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

B. **37 CFR 1.607(a)** specifies the requirements for requesting an interference with an *issued patent*. These requirements include the following:

1. Explain why your claims correspond to the proposed count - this is the Winter trap! Requires an admission of obviousness in view of target claims. Reserve the right to argue otherwise.

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

2. Show compliance with 35 USC 135(b) for late presented claims - only claims presented within 1 year count for 135(b)! (In re Berger's (material limitations test) is misleading.)

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

C. 37 CFR 1.608(a):

1. Applies when your effective filing date is 0 – 3 months after effective filing date of a target patent.
2. Requires you to allege that there is a basis upon which you are entitled to a judgment relative to the patentee.
3. Requires you to conduct an investigation.
CYA – Memorialize your investigation!

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

D. 37 CFR 1.608(b)/617:

1. 608(b) applies when your effective filing date is > 3 months after effective filing date of a target patent.

608(b) requires you to submit evidence and explanations demonstrating prima facie entitlement to a judgment relative to the patentee.

Avoid the 608(b)/617 “Catch 22”! - See Basmadjian v. Landry

V. Requesting an Interference - 37 CFR 1.604, 1.607, 1.608/617

E. Interference Request Tip:

Prove entitlement to any earlier filing dates in your interference request.

VI. 37 CFR 1.658(c) Interference Estoppel and Issue Preclusion

1. 658(c) applies against losing party as to all issues that were or could have been raised in the interference.
2. 658(c) includes issues for claims to *commonly disclosed* subject matter.
3. Issue decided in an interference may be accorded *issue preclusion* effect in subsequent litigation.

VII. 37 CFR 1.657 - Burden of Proof on Priority

1. Burden *remains* on the party with the later effective filing date as to a count. Brown
2. Burden increases from preponderance to clear and convincing when effective filing date of the application is after the issue date of a target patent.

VIII. Respond to Published Applications – US and PCT

1. Preserve rights in view of 35 USC 135(b)(2) by “copying” claims as they publish.
2. Notify the PTO when copying from *both* US *and* PCT applications.
3. *Failure to notify the PTO is sanctionable attorney misconduct - 37 CFR 10.23(b)(7). See Bovard v. Respondent.*

VIII. Respond to Published Applications – US and PCT

4. Do not file request for interference with PCT application. Just copy claims and notify.
5. Determine when 371 filed, and then *promptly* file interference request with 371 application.
6. Keep in mind the average delay from request to interference is about 2 years.

VIII. Respond to Published Applications – US and PCT

7. Use periodic inquiries to PAIR and PCT Legal Office to track target applications.
8. Consider filing “interference issue” public protests in target application’s family.
9. File 37 CFR 1.59 petition to expunge, where applicable, with your “related applications” IDS in the application containing your interference request.

IX. Whether to Split Subject Matter Between Applications in View of Potential Interferences

- A. Do you place claims allowable and arguably not interfering in the same application or a separate application from the application you use for an interference?**
- B. Do you segment inventive disclosures between applications in view of potential interference estoppel?**

IX. Whether to Split Subject Matter Between Applications in View of Potential Interferences

FACTORS TO CONSIDER:

- 1. Median time line for an interference:**
 - i. From request to interference – 2 years**
 - ii. Interference – 2 years**
 - iii. Judicial review – 2 years**
- 2. The USPTO will issue no patent until after interference and all judicial review terminates. Martin v. Clevenger**

IX. Whether to Split Subject Matter Between Applications in View of Potential Interferences

- 3. Interference does not substantially affect duration of patent protection (term extension)**
- 4. Interference does impact the actual dates of patent protection.**
- 5. Your related applications will probably issue prior to interfering application (but may be suspended; MPEP 2315.01)**

IX. Whether to Split Subject Matter Between Applications in View of Potential Interferences

Answer:

Whether to split subject matter depends upon assessments of timing of maturity of the relevant market, risk due to interference, impact of existence of the interference on the relevant market, impact of the existence of the interference on related litigation.

X. Count Formulation

Proposing a count is one of the easiest ways to influence the outcome of an interference.

- 1. Likely to be adopted in the declaration of the interference.**
- 2. Burden of proof to change count during the interference is on the movant.**

X. Count Formulation

- 3. Tailor the count to (1) require proof of elements for which you have a winning priority case and (2) be non-obvious over prior art.**
- 4. Include a claim identical in scope to the count.**
- 5. Be careful with claim correspondence in view of Winter.**

X. Count Formulation

- 6. If you are confident of winning on priority, propose a “McKelvey” count (Claim 1 or Claim 2 or Claim 3 or) and propose designating all claims as corresponding.**
- 7. McKelvey count is more difficult for an opponent to “wiggle around.”**

VI. Conclusion

Apply Strategies to Prepare for Interferences in Conjunction with Your Other Due Diligence Activities

THANK YOU

THE END