

Demystifying The “I” Word

AN INTRODUCTION TO PATENT INTERFERENCE PRACTICE

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What's a word that typically creates anxiety for a patent prosecutor – or indeed for his corporate client? Many would say that “interference” is such a word.

And why is that the reaction? The widely held perception of patent interferences – in large part justified – is that they are slow, complicated, and expensive proceedings. Beyond having that general perception, many practitioners don't fully understand how an interference arises and what can and cannot be decided in it. So,

with that background, let's have a look at some of the basics.

In every country other than the United States, when two or more rival inventors contest the right to a patent, the dispute is resolved very simply – the first inventor to file a patent application wins. But in the United States, the Patent and Trademark Office (USPTO) must determine who was the first to actually invent the disputed subject matter – *not* simply the first to file a patent application.

A patent interference – a creature of 35 U.S.C. §135 – is a trial-like, administrative proceeding by which the first to invent is determined by the Board of Patent Appeals and Interferences (the Board). The first to invent is either (1) the first to “conceive” and the first to “reduce to practice,” or (2) the first to conceive and the last to reduce to practice, if, and only if, he or she worked on the invention with “reasonable diligence” from a date just prior to the other party's conception to the date of his or her own reduction to practice.

An interference arises when two or more pending applications, or at least one pending application and an unexpired patent, contain claims covering the same or substantially the same subject matter. An important point here is that an interference is appropriate only when both inventors *claim* the same invention. It's not enough that they *describe* the same subject matter. The determination of who is the first to

invent the claimed subject matter is commonly referred to as a determination of “priority.”

The Board conducts the interference under the rules appearing at 37 C.F.R. §§1.601 – 1.690. An interference usually includes motions, depositions, briefing, and an oral hearing before a panel of three Administrative Patent Judges. The Board is empowered to decide not only priority of invention but also the patentability of that invention. In some cases the Board will decide that the invention is not patentable to either party and will enter judgment that neither is entitled to a patent.

HOW DOES IT BEGIN?

An interference can be initiated in two ways: by suggestion of the Examiner, or by request of the applicant. When an Examiner determines that an invention claimed by an applicant is patentable, **and** that it is the “same patentable invention” [37 C.F.R. § 1.601(n)] as that claimed in an unexpired patent or another pending patent application, the Examiner may then forward the application to the Board for declaration of an interference.

To seek an interference, an applicant must file a request addressed to the Examiner that satisfies specific requirements of 37 C.F.R. § 1.607. Such a request must suggest one or more “counts,” present or identify at least one claim “corresponding” to the count (see box, Terms of Art: “Count” and “Correspond”), identify the other patent application or unexpired patent that claims the same or substantially the same invention, and explain why an interference should be declared. Under 35 U.S.C. §135(b), the applicant must have presented the claims for interference within one year of the issue date of the opponent's patent, or within one year of the publication of the opponent's application.

Once an Examiner determines that an interference might exist, the Examiner forwards the application file to the Board with a memorandum of prescribed form and con-

TERMS OF ART: “COUNT” AND “CORRESPOND”

To say that a claim “corresponds” to a count means that the claim is at risk of being lost during the interference because the invention it defines would not be separately patentable in view of the invention defined by the count.

A “count” looks like a patent claim, but its function is quite different – it defines the subject matter as to which “priority” (first inventorship) will be decided. One of its important functions is to define what evidence will be considered by the Board in deciding which party was the first inventor.

tent. Whether the interference will be declared in accordance with the Examiner's memorandum – or declared at all – is for the Board to decide. If the Board is satisfied that an interference exists, a notice will be mailed to each involved party “declaring” an interference.

The notice identifies the subject matter in dispute and sets a schedule for certain required actions by the parties. Among other things, the notice identifies one of the parties as “senior” and all others as “junior.” The “senior party” is the applicant or patentee who is entitled to rely on the earliest filing date and is therefore presumed – subject to contrary proof – to be the first inventor.

WHAT DOES IT DECIDE?

An inventor under U.S. law is a person who contributed to the conception of the subject matter defined by at least one claim in a patent or application. Showing that you are the first to invent requires proving that you were the first to possess the complete invention. As already mentioned, a complete invention consists of two elements: “conception” (i.e., the idea) and “reduction to practice” (i.e., putting the idea into a workable form). So, proving priority of invention (i.e., that you are the first inventor) requires proof of the earliest dates for both conception and, in most cases, reduction to practice.

A complete conception is not simply the inventor's idea, but an idea that is so clearly defined that a person of ordinary skill in the field of the invention would be able to reduce the invention to practice without undue experimentation. Thus, to prove a date of conception of a new molecule, for example, an inventor must present evidence that he, on a certain date, had not

only the idea of the structure of that molecule but also of an operative method of synthesizing it and of a practical use for it.

As for the other part of invention, a reduction to practice can take one of two forms: actual or constructive. An *actual* reduction to practice is a physical demonstration that the invention works for its intended purpose. It might be proved by evidence, for example, that a molecule was synthesized, analyzed to establish its identity, and tested in a recognized manner to prove its utility. A *constructive* reduction to practice is the filing of a patent application that describes the invention and how to make and use it.

All testimony is initially submitted in affidavit form, but witnesses might be cross-examined in a deposition. Any documentary evidence, such as copies of research records, correspondence, and analytical or other test data, must be filed with an affidavit. An inventor's testimony, the documents he creates, and any other evidence based entirely on information obtained from an inventor must be independently corroborated to prevent fraud. Testimony and records of others (technicians, analysts, and others who didn't contribute to the conception of the invention) need not be independently corroborated.

It is possible (though perhaps difficult) to win an interference if you were the first to conceive but the last to reduce to practice. Under 35 U.S.C. §102(g) an inventor has an opportunity to win the priority contest by proving that he had the earliest conception and showing that he exercised “reasonable diligence” during the “critical period” — a period beginning just prior to the other party's conception and continuing up to his own reduction to practice. One can prove diligence by submitting evidence

of reasonably continuous activity toward a reduction to practice (actual or constructive) and/or evidence of an acceptable excuse for any periods of inactivity. Acceptable excuses may be, for example, reasonable delays in obtaining materials or personnel, or delays due to the need for regulatory clearance for the needed activity. A purely business reason for a delay (e.g., postponing work on a project because of market conditions) is not an acceptable excuse for inactivity.

Even an inventor who shows that he was the first to invent can still lose the priority contest if the Board decides that the completed invention was abandoned, suppressed, or concealed. That can happen if the evidence shows that the inventor (or his employer) did not take steps within a reasonable time to make the invention public by filing a patent application, commercializing the invention, or using other means.

WHERE DOES IT END?

The interference proceeding ends with a judgment of the Board stating which party (if any) is – and is not – entitled to a patent containing claims covering the disputed invention. A party not satisfied with the Board's judgment can request reconsideration or can pursue either of two routes of appeal – directly to the U.S. Court of Appeals for the Federal Circuit or, alternatively, to a U.S. District Court.

If you haven't had prior experience in patent interferences, perhaps you'll have a bit less anxiety when an Examiner suggests that your application may become involved in an interference. **IPT**