

March 28, 2001

Mr. Nicholas Godici

Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

United States Patent and Trademark Office
BOX INTERFERENCE
Washington, D.C. 20231

ATTN: Interference-in-Fact

Re:AIPLA Comments on the Notice and Request for Comments Entitled "Standard for Declaring a Patent Interference" 65 Fed. Reg. 79809 (December 20, 2000)

Dear Acting Under Secretary:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the notice and request for comments entitled "Standard for Declaring a Patent Interference" published in the *Federal Register* on December 29, 2000.

The AIPLA is a national bar association of more than 12,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

The AIPLA Board of Directors passed the following Resolution on March 15, 2001, which reflects the support of the AIPLA for the one-way patentability analysis:

RESOLVED, that the American Intellectual Property Law Association is in favor of a one-way patentability analysis for the Director to be of the opinion, within the meaning of 35 USC 135(a), that an interference-in-fact exists. That the resource consequence to the USPTO, to applicants, and to patentees resulting from the USPTO's applying a one-way patentability analysis in determining when an interference exists would be outweighed by the benefit to the public generally in preventing invalid claims from issuing and canceling improperly issued invalid claims.

AIPLA supports the use of the one-way patentability analysis by the Director in determining that an interference-in-fact exists in order to reduce the possibility of the USPTO issuing invalid patents. It is acknowledged that a one-way test may have resource consequences for the USPTO. However, the relatively small cost associated with an interference for the USPTO pales in comparison to the significant commercial value involved in most interferences and the significant value to the public and to the U.S. patent system in guarding against invalid patents.

As to the three questions posed in the *Federal Register* notice, the following answers are offered:

First Question - If one-way patentability analysis is sufficient to establish an interference-in-fact, would it be possible to have an interference with two counts as set out in Example 4, reproduced above?

Example 4 reads:

Example 4: Application G contains patentable claims 1 (engine), 2 (6-cylinder engine), and 3 (engine with a platinum piston). Application H contains patentable claims 11 (engine) and 15 (engine with a platinum piston). Claims 1 and 2 of application G and claim 11 of application H define the same patentable invention. Claim 3 of

application G and claim 15 of application H define a separate patentable invention from claims 1 and 2 of application G and claim 11 of application H. If an interference is declared, there would be two counts: Count 1 (engine) and Count 2 (engine with a platinum piston). Claims 1 and 2 of application G and claim 11 of application H would be designated to correspond to Count 1. Claim 3 of application G and claim 15 of application H would be designated to correspond to Count 2.

The answer to this question is, yes, as explained below. In addressing the questions posed in the notice regarding Example 4, the AIPLA assumes that an engine containing a platinum piston would not have been obvious in view of either an engine or an engine containing six cylinders.

37 CFR 1.601(f) specifies that "each count shall define a separate patentable invention," and the test for "separate patentable invention" appears in 37 CFR 1.601(n). Applying the test in 37 CFR 1.601(n) for "separate patentable invention" to the claim to an engine with a platinum piston, and assuming that the claim to an engine with a platinum piston is non-obvious in view of the claim to the engine or the engine with six cylinders, leads to the conclusion that the claim to the engine with a platinum piston is a separate patentable invention from the claim to an engine. Since, the claim to an engine with a platinum piston is a separate patentable invention from the claim to an engine, the claim to an engine with a platinum piston can constitute a second count.

Second Question - How would having an interference between claim 1 of application G and claim 15 of application H of Example 4 square with the holding in *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416-17 (CCPA 1976)?

AIPLA submits that *Nitz* is not relevant since the Commissioner's opinion (within the meaning of 35 USC 135(a) regarding what constituted an interference) in year 1976 is different from the Director's opinion in year 2001 as now specified in 37 CFR 1.601(n). Rule 601(n) was implemented in 1984, after *Nitz*. *Nitz* was an interpretation of the Commissioner's (now Director's) opinion within the meaning of 35 USC 135(a) regarding the definition of an interference.

Third Question - If a one-way patentability analysis is sufficient, what would it take to establish that there is no interference-in-fact in a given case?

In reply, there would be no interference-in-fact in two situations.

In the first situation, (1) the claim of the first party would not have been obvious in view of the subject matter defined by the claim of the second party and (2) the claim of the second party would not have been obvious in view of the subject matter defined by the claim of the first party. There is no interference-in-fact because the subject matter claimed by neither party is unpatentable based upon the subject matter claimed by the other party.

In the second situation, (1) the claim of the first party would have been obvious in view of the claim of the second party but the first party has priority for its claim, and (2) the claim of the second party would not have been obvious in view of the claim of the first party. As in the first situation, there is no interference-in-fact because the subject matter claimed by neither party is unpatentable based upon the subject matter claimed by the other party.

The answer to the second question posed in the notice is that establishing no interference-in-fact in a particular case would take showings of fact supporting the conclusions of obviousness, non-obviousness, and priority as required in either one of the two foregoing situations.

We appreciate the opportunity to provide our comments on the standard for declaring an interference and look forward to continuing to work with you as this effort proceeds.

Sincerely,

Michael K. Kirk