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**Subject:** Standard for Declaring a Patent Interference

I am writing to enthusiastically endorse the proposal "that the nature of interferences should be expanded beyond the current practice" by expressly providing that "a one-way patentability analysis is sufficient to establish an interference-in-fact"--i.e., both to declare an interference and to continue an interference. That is, I think that, once an interference has been declared, it should be continued so as to give both or all parties the opportunity to have all of the issues that the parties raise in a timely and proper fashion decided--including but not limited to allegations that there is no interference-in-fact.

I do not agree that the "current standard" set forth in *Winter v. Fujita*, 53 USPQ2d 1234, 1242 (PTOBPAI 1999)(expanded panel), reh'g denied, 53 USPQ2d 1478 (PTOBPAI 2000)(expanded panel), is correct. However, whether or not the *Winter* standard was correct when enunciated will, no doubt, be decided eventually by the Federal Circuit, and that question need not impact on the question of whether the interference rules should be amended to specifically provide that a one-way patentability analysis is enough.

The notice states that "Any decision to expand the nature of interference proceedings will have a resource consequence for [the] USPTO and for applicants and patentees involved in interferences." I recognize and accept that. However, the PTO's current policy of refusing to declare or maintain interferences in situations where one party has only dominant claims and the other party has only subordinate claims has a "resource consequence" for the PTO's customers--that is, for users of the patent system. That "resource consequence" is that, in such situations, they cannot get questions of patentability and priority resolved in interferences (which are relatively inexpensive, quick, and accurate). Instead, in such situations they have to get those questions resolved (if at all) in district court litigations (which are relatively expensive, slow, and inaccurate). Hence, to the extent that the PTO wishes to serve its customers, it should adopt the proposal put forward in the notice.

The notice asks "How would having an interference between claim 1 of application G and claim 15 of application H of Example 4 square with the holding of *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416-17 (CCPA 1976)?" My response is that nothing in *Nitz* forbids such an interference. *Nitz* held that "the question of interference in fact presented in this case [and in every case in which such a question is "presented"--i.e., raised] is one ancillary to priority and may be properly considered by this court [and, of course, by the board]." Hence, in any interference between one party having only dominant claims and another party having only subordinate claims, the party having only subordinate claims will have the opportunity to argue that, even though it made its invention after the other party, it is entitled to its claims because they are patentably distinct from the other party's dominant claims.

Finally, the notice asks, "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?" My response is that it would take the same kind of evidence that is required to overcome an obviousness-type double patenting rejection without filing a terminal disclaimer. That is, the question of whether one interferent's subordinate claims are patentably distinct from another interferent's dominant claims is exactly the same, conceptually, as the question of whether a single party's subordinate claims in one patent or application are patentably distinct from its own dominant claims in another patent or application.

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