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Subject: Proposed Rule Change Concerning the Standards for Declaring and Maintaining Interferences

These are my responses to the two questions that you posed to the members of the AIPLA's Interference Committee during the meeting of that committee on February 2nd.

(1) Question: When one party has a single generic claim and the other party has a single species claims subordinate to the first party's generic claims, what should the count be?

Answer: The count should be a McKelvey count consisting of the first party's generic claim OR the second party's species claim.

(2) Question: Under what circumstances are both parties entitled to their claims?

Answer: Each party is entitled to its claim if (1) the first party proves that it invented subject matter within the scope of its generic claim before the second party invented subject matter within the scope of its species claims (that is, I don't think that the second party should be allowed to prevail by proving that it made subject matter within the scope of the first party's generic claim but outside the scope of the second party's species claim, although Vice-Chairman Calvert once said in an opinion that that was an open question) and (2) the second party proves that the subject matter defined by its species claims is patentably distinct from (patentable over) the subject matter defined by the first party's generic claim.

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