

If claim A is a **separate** patentable invention from claim B, then claims A and B cannot define the **same** patentable invention. For the purposes of 37 CFR 1.601(i), the separate patentable invention test of 37 CFR 1.601(n) trumps the same patentable invention test. There is no inconsistency between 37 CFR 1.601(n) and the holding of *Winter v. Fujita*, 53 USPQ2d 1234, 1243 (BPAI 1999), *reh'g denied*, 53 USPQ2d 1478 (BPAI 2000), that there must be two-way patentability analysis.

When a species is patentably distinct from a genus, the species is always patentable (separately or otherwise) from the genus, regardless of the respective filing dates or dates of invention.

If "interfere" within the context of 35 USC 135(a) is construed to mean to cause harm by interfering with legitimate rights of an applicant or patentee, then a one-way same patentable distinction test is unjustified in many situations.

When an application claims a patentably distinct species encompassed within a patented genus, the application does not interfere with any rights which legitimately flow from the patent. The grant of the patent to the patentee does not empower the patentee to stop others from getting patents to patentably distinct species encompassed within the genus claimed in the patent. Thus, no legitimate rights of the patentee are interfered with by granting a second patent to the applicant claiming a patentably distinct species.

When an application claims a genus encompassing the patentably distinct species of a patentee, the genus/application may (or may not) be construed to interfere with the species/patent. In such a situation, however, the applicant has nothing to gain by having an interference. The species/patent should always survive regardless of whether the species or the genus was invented first. Furthermore, it is primary job of the Commissioner to attend to the rights of an applicant, who pays for the costs of examination, as opposed to the rights of a patentee. In the case of the patentee, all fees have been paid, examination has been terminated, and all procedures before the Patent and Trademark Office are over and done with.

If the genus/applicant is prior (first to invent) with respect to the species/patentee, the claims of the respective parties do not interfere with one another. Both the genus and species would be patentable with respect to one another.

If the species/patentee is prior (first to invent) with respect to the genus/applicant, granting of the genus to the applicant could be construed to interfere with the rights of the species/patentee. However, prior to declaring the interference, the Commissioner could only speculate as to which party would ultimately be entitled to priority. This situation is different from the situation when the claims of both parties are claiming the same patentable invention. When both parties claim the same patentable invention, regardless of which party is prior, the claims of one party interfere with the claims of the other.

If the patentably distinct species and the encompassing genus are both claimed in applications, the Commissioner can only speculate as to whether one application interferes with the other. To declare an interference under 35 USC 135(a), the Commissioner must form an opinion that the applications actually interfere. Such an opinion should not be based on speculation. Furthermore, when the Commissioner forms an opinion as to whether one application interferes with another application, according to 35 USC 135(a), the Commissioner may (or may not) require an interference to be declared. In a situation where the Commissioner can only speculate as to whether a requisite interference exists, the Commissioner can exercise the discretion of not requiring an interference to be declared, especially when the resources of the Patent and Trademark Office (PTO) are strained.

It is noted that the primary patent function of the (PTO) is to process applications, that is, to accept applications for patent, to subject them to the scrutiny of *ex parte* prosecution and to reject applications or to issue patents. Once applicants survive this process and successfully win the prize of being issued a patent, it is unsettling for the patentee to be put to the test yet again, especially in an interference context with a potentially aggressive and relentless opponent. Subjecting a patentee to unnecessary further scrutiny is also contrary to the primary function of the PTO.