

**From:** [Steve@Hoffberg.org](mailto:Steve@Hoffberg.org)

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**To:** [Interference.Rules@uspto.gov](mailto:Interference.Rules@uspto.gov)

**Subject:** Interference-in-fact

In response to the PTO Notice on "One-Way" Interferences:

Statement of Interest:

I am a patent attorney, as well as inventor. On behalf of myself and clients, I have filed applications which I believe "Interfere" under 35 USC 135 with other US patent applications or patents.

Comments:

In general, an interference arises if it is undetermined which inventive entity has priority of invention, and therefore if both patents issued, one inventor would not be entitled to the patent. This ensures the public interest in preventing duplicative patents and the inter partes right to hold a sole monopoly to an invention.

The PTO must monitor patent applications to determine whether there are validity issues known to it during pendency, and investigate them. Under a one-way interference test, if a later filed application includes disclosure (but not identical claims) which could invalidate claims of an earlier-filed patent application, the PTO does not investigate the date of conception of the later application, which might be prior to the conception of the earlier filed application. This is a head-in-the-sand approach.

This is the case in many one-way interferences, including the examples provided on the Notice. On the other hand, if the earlier patent application results in a patent or 18 month publication, it may be used as a reference against the later application. Thus, if an interference were declared under these one-way circumstances, the earlier filed patent application would be deemed unpatentable. In the absence of a declared interference, this defect is not investigated, and there is significant risk of issuance of an invalid patent, which nevertheless is accompanied by a presumption of validity. Any time the PTO fails to use due diligence to investigate whether a patent meets all requirements of patentability, including whether the invention was invented prior to applicant by another, the credibility of the PTO is impaired and the patent system as a whole degraded. Since the PTO has the opportunity prior to issuance to investigate and resolve this issue, procedures should be put into effect.

I suggest an ex parte procedure for dealing with this issue. In the proposed scheme, applications filed up to one year AFTER an application may be cited in a provisional rejection. The applicant may amend the application to avoid the problem, copy the claim or otherwise meet the two-way test (noting the 35 USC 135(b) limits), provide unilateral evidence of prior conception coupled with evidence, in the form of an absolute and unequivocal bar to the competing application, for example a sec. 102(b) event, or argue that the claims do not meet the one-way test. This unilateral process forces the applicant to assert a position on the record. If both applications remain pending, the entire issue may be resolved ex parte, with the first inventor awarded the patent.

Interference searching by Examiners must extend beyond informally reviewing the figures of prior applications. This is a poor practice, and does not comply with a requirement for due diligence. (Would merely reviewing figures meet an applicant's rule 56 obligation?). Examiners must actually review all applications which include potentially interfering subject matter, including restricted claims of pending applications.

Steven M. Hoffberg

Reg. 33,511

Milde, Hoffberg & Macklin, LLP

Suite 460

10 Bank Street

White Plains, NY 10606

(914) 949-3100 tel.

(914) 949-3416 fax

[Steve@Hoffberg.Org](mailto:Steve@Hoffberg.Org) e-mail

[intprop@aol.com](mailto:intprop@aol.com) alt. e-mail