

<b>Memorandum</b>	
<i>Finnegan, Henderson, Farabow, Garrett &amp; Dunner, L.L.P.</i>	
To:	<a href="mailto:Interference.Rules@uspto.gov">Interference.Rules@uspto.gov</a>
From:	Jerry D. Voight - Registration No. 23,020 Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. Washington, D.C.
Date:	February 28, 2001
Subject:	Interference-in-Fact

The following constitutes comments in response to the Notice published in the Federal Register, Volume 65, No. 245, page 79809 (Wednesday, December 20, 2000). The notice pertains to the practice recently adopted by the Trial Section of the Board of Appeals and Interferences (Board) of the United States Patent and Trademark Office (PTO), of applying a two-way patentability analysis to determine if an interference-in-fact exists.

Although not expressly stated in the Notice, the primary effect of the recently adopted practice will be to eliminate many interferences where a first party has secured broad claims and a second party asserts only narrow claims, including claims subsumed within, and dominated by, the broad claim of the first party. A common example is a genus-species relationship. It is illogical, unfair, and inconsistent with at least 70 years of practice to refuse to proceed with interferences in all such circumstances, without regard to relative filing dates, showings under 37 C.F.R. § 1.608, and burdens of proof of the parties. Moreover, no persuasive reason is set forth for adoption of a two-way patentability test, and a two-way analysis is inconsistent with the commentary that accompanied the present interference rules at the time the final rules were first published in the Federal Register on December 12, 1984. Patent Interference Proceedings, 49 Fed. Reg. 48,416 (1984).

**I. A Two-Way Test is Inconsistent with Precedent**

Concluding that an interference is not proper when a first party has broad dominant claims that subsume claims of a second party is impossible to reconcile with the clear definition of an interference-in-fact set forth in 37 C.F.R. § 1.601(j) and (n). Moreover, such a conclusion is inconsistent with case law.

There is ample precedent for the proposition that a single species provides a basis for an interference with a generic claim covering that species, even though the species is not disclosed in the application or patent containing the generic subject matter. As is stated by the court in *Den Beste v. Martin*, 116 USPQ 584, 586 (CCPA 1958):

... [T]he discovery of a single species or example clearly falling within the count constitutes a support of all its limitations, so far as the issue of priority is concerned. Manifestly, if Martin reduced to practice one example satisfying the count before Den Beste entered the field, then Beste cannot be the first inventor of a broad claim embracing that example. If Martin failed to recognize that his example formed part of a broader invention, that fact might preclude him from obtaining broad claims, but it should not constitute Den Beste being the first inventor of any claim reading on said example.

*Den Beste* is supported by numerous cases cited therein, which cases go back to at least 1933.

Neither the *Den Beste* case, nor any of the numerous other cases holding that an embodiment falling within a generic claim provides a basis for interference with the generic claim, suggests that this principle is limited to situations where the genus renders the species unpatentable. Indeed, in many of the cases, it appears clear that the narrower subject matter would be patentable over the broad interference count. See, for example, *Loukomsky v. Gerlich*, 121 USPQ 213 (CCPA 1959).

It is recognized that *Den Beste* was clarified and overruled in part in *Squires v. Corbett*, 194 USPQ 513 (CCPA 1997). However, *Squires* overruled *Den Beste* only to the extent *Den Beste* suggests a party's application did not need to support the full scope of a claim presented for interference purposes. As stated by the PTO Board of Interferences, in *Mori et al. v. Costain*, 214 USPQ 295, 297 (Bd. Intf. 1981):

The *Squires* decision overruled the *Den Beste* principle only as to the involved application for purposes of "right to make" by requiring a party to support in his involved application the full scope of his claim corresponding to the count. However, for purposes of benefit, the *Den Beste* principle still applies [that a single species falling within a genus constitutes a reduction to practice of that genus], is noted [in] *Weil v. Fritz*, 572 F.2d 856, 196 USPQ 600 (CCPA 1978), fn. 16.

Indeed, in *Squires*, the court expressly noted that a prior reduction to practice with a single species provides a basis for prevailing in an interference directed toward a generic invention. 194 USPQ at 519.

II. ***A Two-Way Test is Inconsistent with the Commentary That Accompanied the Present Interference Rules at the Time They Were Implemented***

At the time the final version of the present interference rules was first published in 1984, the rules were accompanied by a lengthy commentary, intended "to provide guidance on the procedures the Office will be following in conducting interference cases before the Board of Patent Appeals and Interferences." Patent Interference Proceedings, 49 Fed. Reg. 48,416 (1984). This commentary expressly addressed at length the meaning of "same patentable invention" and "separate patentable invention" as set forth in 37 C.F.R. § 1.601(n). Specifically, the commentary notes:

Comments were received regarding § 1.601(n) which defines "same patentable invention" and "separate patentable invention." One written comment suggested that § 1.601(n) be deleted. . . . The suggestion is not being adopted. In view of the nature of the comment and the importance of the definitions in § 1.601(n), the written comment is reproduced in its entirety:

*Comment:* The paragraph to be deleted contains an explicit definition of both "same patentable invention" and "separate patentable invention". It requires application of a two-prong test for determining "sameness" or "separateness". Two inventions are considered to be the "same patentable invention" when they are the same under 35 U.S.C. 102 or obvious variants under 35 U.S.C. 103 when one is considered as "prior art" with respect to the other. . . .

(1) If the standard of separate patentability as between two counts is applied on a mutual basis (i.e., *Invention A must be separately patentable from Invention B* considered as prior art and *Invention B must be separately patentable from Invention A* considered as prior art), then the conduct of interferences with separate counts directed to both a generic invention and an included specific embodiment thereof (i.e., a species) are [sic] frustrated. . . .

49 Fed. Reg. at 48,432, emphasis supplied.

The Office responded to this comment by stating:

With respect to paragraph (1) of the comment, the standard of patentability will *not* be applied "on a mutual basis."

49 Fed. Reg. at 48,433, emphasis in original.

Because the comment received by the PTO on the previously published draft rules is very lengthy, the response to the comment is separated from the relevant portion by a substantial amount of text. Thus, it is necessary to read the commentary carefully. However, when the commentary is read carefully, the PTO stated unequivocally that a two-way patentability test was *not* contemplated by 37 C.F.R. § 1.601(n)!

### III. ***No Persuasive Reason is Advanced for Adoption of a Two-Way Test***

From the Notice, it is not clear why a two-way patentability test has been adopted. The Notice seems to recognize that in many circumstances a narrowly claimed invention may constitute interfering subject matter with regard to a broadly claimed invention (i.e., a species falling within a genus), even though the narrowly claimed invention is not rendered obvious by the broadly defined invention. The rationale for not declaring an interference under such circumstances seems to be that the Director has discretion to declare interferences and may exercise that discretion to exclude interferences involving certain categories of subject matter. The justification for this is that interferences consume a vastly disproportionate amount of the PTO's resources.

While undoubtedly interferences consume a disproportionate amount of the PTO's resources, this is an extremely poor reason for applying a two-way patentability test of interference-in-fact. If the PTO needs to curtail the number of interferences declared, it would make as much sense to decline to declare interferences in e.g., the biotech field, an area in which there are many interferences. Indeed, if there is a persuasive case for the proposition that interferences consume too much of the PTO resources, and the Director has the authority asserted, do away with all interferences.

### IV. ***A Two Way Test is Illogical and Unfair***

Broad generic claims of a first party encompassing a second party's narrow species claims cannot be patentable over the narrow species claims of the second party (assuming the species claims are prior art to the generic claims), but the narrow claims of the second party often will be patentable over the broad claims of the first party. Therefore, under a two-way patentability test, an interference will often be foreclosed in these circumstances. However, if the second party invented the narrow subject matter before the first party's date of invention, what is the logic of allowing the late comer to receive a dominant patent? Yet that is the clear result, in many cases, of a two-way patentability analysis to determine the existence of an interference-in-fact.

Interferences are often viewed as proceedings to determine which of two or more applications filed at about the same time is prior art against the other or others. If a two-way patentability test is applied, this determination often will not be made in genus-species situations, even though the party asserting the generic claim is not legally entitled to such a claim if the party asserting the narrow claim is the first inventor.

Presumably the PTO would not intentionally allow a broad dominant claim over a narrower subsumed claim if the narrower subsumed claim was prior art under 35 U.S.C. § 102(b). Why then should the PTO allow a broad claim without determining if narrower subject matter constitutes prior art under 35 U.S.C. § 102(g)?

That a two-way test of unpatentability is illogical is further illustrated by a few examples. As a first example, suppose two parties have disclosures that are commensurate and, therefore, both are able to present broad claims that meet a two-way (un)patentability test. One of the parties actually reduced to practice 100 different embodiments within the genus, while the disclosure of the other party is largely prophetic and is based on actual reduction to practice of merely a single embodiment. But, if

that single embodiment was conceived and reduced to practice prior to any of the other party's 100 embodiments, priority will be awarded to the party who actually reduced to practice only a single embodiment. *Mikus v. Wachtel*, 183 USPQ 752, 753 (CCPA 1974); *Kondo v. Martel*, 220 USPQ 47, 50 (PO Bd Pat Inter 1983). Assuming the party who reduced to practice 100 embodiments does not show that some of the embodiments are separately patentable over the common genus, that party will not obtain patent claims covering any of the embodiments, while the other party will obtain generic claims.

If a single species falling within a generic count constitutes a reduction to practice of the count, the conclusion is inescapable that the species constitutes subject matter that interferes with a genus. But, with a two-way patentability test, if the party that reduced to practice but a single embodiment files a very narrow application directed only to that embodiment, likely there will be no interference, or there will be an interference directed only to that embodiment. Moreover, in these circumstances, instead of not receiving any claims, the other party, though second to invent, receives generic claims.

I have great difficulty in seeing why the party that reduced to practice but a single embodiment should be foreclosed from an interference merely because, instead of filing a broad prophetic application, it filed an application that covered only the single embodiment actually reduced to practice. Yet with a two-way test, there is no interference and the second inventor is awarded a broad generic claim.

As another example, suppose Party A has an application with an early filing date but discloses only a single species. A patent with a later filing date issues to Party B, which patent contains broad claims embracing the species of Party A's application. Party A then files a CIP application containing adequate disclosure to permit the first party to present exactly the same broad generic claims that were issued to Party B. Under these circumstances, assuming Party A's CIP can avoid the prior art effect under 35 U.S.C. § 102(e) of Party B's patent, presumably an interference will be declared and Party A will be given the benefit of the filing date of his first application disclosing but a single species. See, e.g. *Weil v. Fritz*, 196 USPQ 600, 608, n. 16, (CCPA 1978); *De Nora v. Ives*, 209 USPQ 1121, 1127 (CCPA 1980).

Why should an interference be permitted merely because a CIP with an enhanced disclosure is filed, but no interference permitted without filing the CIP? All the two-way patentability rule has done is motivate Party A to file a CIP application with an expanded disclosure; none of the important operative facts change.

The unfairness of a two-way patentability test can also be illustrated by the following example. Suppose two parties file substantially identical disclosures at about the same time and one receives, improperly, relatively broad generic claims because highly pertinent prior art was not found during prosecution. This same highly pertinent prior art is found during prosecution of the other party's case, with the result that the other party only receives very narrow claims that are, of course, patentably distinct from the broad claims allowed to the other party. It is highly inequitable to preclude an interference in such a case, yet an interference is foreclosed by a two-way patentability test.

In the preceding example, an unfair result could occur even if the pertinent prior art is cited in both cases. Assume the first party to file accepts narrow claims in view of the pertinent prior art and a patent issues to that party while the substantially identical application of the second party to file is still pending. Further assume the second party can antedate the first party's filing date, under 37 C.F.R. § 1.131, but only by a few days, and therefore, the second party realizes it is not likely to prevail in an interference. Accordingly, rather than accepting narrow claims like the first party, the second party pursues only broad claims. If the second party ultimately obtains such broad claims, the narrow claims obtained by the first party are likely patentable over the broad claims (since the narrow claims were readily found patentable over prior art used to reject the broad claims), and thus, under a two-way patentability test, no interference would be declared. This result seems very unsatisfactory; clearly, the parties have made the same invention, yet the second party to file, who was unlikely to prevail in an interference, receives the broad dominant claims. Moreover, such an outcome tends to discourage parties from accepting narrower claims, hardly a result the PTO should want to foster.

As a last example, what if the first party has claims to a broad generic invention, a second party has claims to a species falling within the broad generic invention, and the second party admits that his claim is not patentable over the genus (even though the cognizant examiner and the Board think it is)? It is well settled that an admission may be used to render claims unpatentable. *In re Nomiya*, 184 USPQ 607, 611 (CCPA 1975). In this case, wouldn't it be necessary to proceed with an interference under a two-way test? Should the existence of interfering subject matter depend merely on whether a party is willing to make such an admission?

V. ***The Appropriate Test of Interference-in-Fact***

The appropriate test for determining interference-in-fact, consistent with 37 C.F.R. § 1.601(n) and the case law, is a one-way patentability test, but the burden of proof must be properly assigned. Specifically, a party arguing for an interference-in-fact should have the burden of showing that its claims render the other party's claims unpatentable. The party cannot provoke or maintain an interference by showing its opponent's claims render the party's claims unpatentable.

Moreover, a party arguing there is no interference-in-fact should have the burden of showing that its claims are separately patentable from the other party's claims. Thus, by providing "directionality" to the test of 37 C.F.R. § 1.601(n) for determining the presence of interference-in-fact, in any given interference, arguments of interference-in-fact and no interference-in-fact present substantially the same issues.

37 C.F.R. § 1.601(i) and (n) appear to establish a one-way patentability test for both interference-in-fact and no interference-in-fact. A possible problem with a one-way test for both interference-in-fact and no interference-in-fact in the absence of directionality, is that one party theoretically could establish the existence of an interference-in-fact while the other party simultaneously establishes no interference-in-fact.

Assume, for example, that Party A claims a species within a genus claimed by Party B. Party A can argue that Party B's genus is not patentable over the species of Party A, and thus a one-way test of interference-in-fact is met. Simultaneously, Party B can argue that there is no interference-in-fact because Party A's species is patentably distinct from the genus of Party B. If Party B's argument is well taken, the parties have simultaneously shown that both the test of interference-in-fact and the test of no interference-in-fact have been met.

I am not aware of such a situation ever arising or that this possibility has presented any problems in actual practice. Nevertheless, any potential for such a paradox is avoided by applying directionality to the test of 37 C.F.R. § 1.601(n). If, in the example set forth above, directionality is applied, Party B must argue there is no interference-in-fact because its claim is patentably distinct from Party A's claim. Therefore, the parties are required to address the opposite side of the same question, and may not address two different questions that may lead to an illogical and incompatible result.

Another problem that has been suggested from use of a one-way patentability test is that a holder of a generic claim will use that claim to prevent latter applicants from obtaining claims to patentably distinct species. I am not aware of any situations where a holder of an early patent containing a generic claim has used that claim to provoke interferences with latter applicants claiming patentably distinct species. In any event, the one-way directional test proposed would foreclose any such potential abuse.

Another problem of a one-way test that has been suggested is that a party claiming a species can assert that the species renders a genus claimed by another unpatentable, and therefore, provides a basis for an interference, while simultaneously asserting that the species is patentable over the genus, and therefore, even if the party claiming the species loses the interference, that party is still entitled to receive claims to his species. 37 C.F.R. § 1.601(n) appears to permit such a result, and the directionality test proposed herein would not prevent the result. However, I see nothing wrong with it.

If a party is first to invent a species, a late comer is not entitled to claim a genus embracing that species. On the other hand, the inventor of a patentably distinct species is entitled to a patent on that species over a prior art genus embracing the species. Why shouldn't an inventor of a species be able to prevent a late comer from receiving a dominant claim without having to forego the right to a species claim if the other party proves not to be a late comer?

The view has been expressed by members of the Trial Section that interferences are not intended to be opposition proceedings or used merely as a vehicle for attacking the patent of another. The one-way directional test proposed herein is not believed to be incompatible with such a view. Moreover, not conducting interferences between species and genus inventors is inconsistent with a basic function of the PTO -- to evaluate pending claims in light of relevant prior art and issue valid patents. Any time non-statutory bar prior art is applied to reject claims, the possibility exists that subsequent events will require a determination of whether the "prior art" is in fact prior art. Why should interferences be any different?

Finally, it is recognized that since cases such as *Den Beste* were decided, there has been significant development in the law governing patentability of a species over a genus. Nevertheless, there has been no change in the basic principle underlying *Den Beste*. If a party is first to invent a species, then a later inventor is not entitled to patent a genus covering that species.

## VI. **Specific Questions**

The Federal Register's Notice raises a number of specific questions and additional questions have since been posed by various members of the Trial Section of the Board. These questions are set forth and addressed below.

### **If a 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?**

As set forth in Example 4, two counts are appropriate; a first count directed to an engine and a second count directed to an engine with a platinum piston. Moreover, in a case such as Example 4, two counts would be appropriate even if Application H claimed *only* an engine with a platinum piston. Why shouldn't the species provide a basis for an interference with a generic count to an engine as well as to a specific count to an engine with a platinum piston (assuming an engine with a platinum piston is separately patentable over the generally claimed engine)?

In determining how an interference should be structured where one party claims a genus and another discloses and claims only a species, the Board should, as it normally does, place the burden on the party requesting a particular result. For example, assume Party H claims only an engine with a platinum piston, but desires a two-count interference with Party G, one count to an engine and a second count to an engine with a platinum piston. Party H should bear the burden of showing that an engine with a platinum piston is separately patentable from the generically claimed engine and that Party H's species claim renders unpatentable (assuming it is prior art) both Party G's claims to an engine and to an engine with a platinum piston.

### **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)?**

A more appropriate question might be "How would not having an interference between Claim 1 of Application G and Claim 15 of Application H of Example 4 square with the holding of *Mori et al. v. Constain*, 214 USPQ 295 (Bd. Intf. 1981); *Squires v. Corbett*, 194 USPQ 513 (CCPA 1977); *Loukomsky v. Gerlich*, 121 USPQ 213 (CCPA 1959), *Den Beste v. Martin*, 116 USPQ 584 (CCPA 1958), and numerous other cases establishing that a species provides a basis for an interference with a genus?"

Moreover, in *Nitz*, Count 1 was based on a claim presented by Ehrenreich which contained the limitation "further characterized by up to *about 48%* by weight friction modifier." The corresponding claim in the *Nitz* patent contained the limitation "further characterized by *up to 12%* by weight friction modifier."

In concluding that there was no interference-in-fact with regard to Claim 1, the court stated:

Though *Nitz* is not precise on the critical upper limit of friction modifier that could be effectively used, it is abundantly clear [from the *Nitz* specification] that at least eighty percent carbon by weight is considered to be critical for his "friction article." Therefore, the friction modifier could never exceed twenty weight percent even with all other material (hydrogen and oxygen) driven off. *Nitz* discloses that "other material" cannot be driven off and that it amounts to about 8% by weight. We hold, therefore that the claim language "up to 12% by weight" by modifier sets forth a material limitation.

190 USPQ at 417.

The *Nitz* holding, thus, appears to be totally consistent with the proposed directional test discussed above. It was Ehrenreich who desired to be in an interference on the basis of a generic disclosure (about 48 weight percent friction modifier) with the narrow subject matter of *Nitz* (up to 12 percent by weight friction modifier). Thus, the burden should be on Ehrenreich to show that his broad subject matter was the same as (i.e., patentably indistinct from) the narrow subject matter of *Nitz*. This Ehrenreich could not do because the 12 percent by weight upper limitation of *Nitz* was "critical." Thus, *Nitz* is an example of a species-genus situation where an interference should not be proper because the party trying to provoke the interference cannot show that its claims render the opposing party's claims unpatentable.

**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?**

This question has been answered above. If the party advocating no interference-in-fact can establish that its claims designated as corresponding to the count would not be rendered unpatentable by its opponent's claims (assuming the opponent's claims were prior art), then there is no interference-in-fact. Conversely, there is an interference-in-fact if the party advocating the presence of interfering subject matter can show that its claims, assuming they are prior art, render its opponent's claims unpatentable. When each party addresses the patentability question from the standpoint of its own claims, the same patentability question is presented whether it is raised by a party advocating that an interference is proper or by a party advocating there is no interference-in-fact. When directionality is applied, a one-way patentability analysis works fine for both determination of interference-in-fact and no interference-in-fact (although directionality does not prohibit a party claiming a species from arguing both that it is entitled to an interference, because its species anticipates the other party's genus, and that it is entitled to receive a patent on its species claims even if it loses the priority contest, because the species is patentable over the genus).

**In a species-genus contest, what should be the count?**

The proper count in a species-genus interference may depend upon the facts of a particular case. However, in the case of a genus totally subsuming a species (which species may or may not be patentably distinct from the genus), the answer appears to be set forth at 49 Fed. Reg. 48,416, 48,421 (1984), example 19. Example 19 provides in pertinent part:

Patent J contains claim 1 (method of mixing, grinding and heating). Application AC contains patentable claim 8 (method of mixing and heating) and does not disclose or claim a grinding step. In the context of the inventions disclosed in patent J and application AC, a method of mixing, grinding and heating is the same patentable invention as a method of mixing and heating. . . . Under § 1.606, the fact that application AC does not disclose grinding would not preclude an interference. If an interference is

declared, there would be one count (method of mixing and heating). Claim 1 of patent J and claim 8 of application AC would be designated as corresponding to the count.

Thus, in the case of a narrow (species) claim that is totally subsumed within a broad (generic) claim, the initial count can merely comprise the broader claim. As an aside, example 19 provides further support for the proposition that the commentary published with the present interference rules at the time they were adopted supports the definition of interference-in-fact as including interferences between generic and species inventions.

While a count corresponding to the broadest (generic) claim will normally work, in some circumstances an alternative type count may be better, i.e., "the [generic] invention of claim X of party A or the [species] invention defined by claim Y of party B." Such counts may be particularly appropriate if the broad claim does not totally subsume the narrower claim, as will be the case in many situations.

In addition, while the broad generic claim (or a combination of the broad generic claim with a narrower species claim) should be suitable as the initial count, it is entirely possible that the count will be narrowed during the motion period. Specifically, if the holder of the broad claim wishes to narrow the count, and can show that subject matter within the broad generic count is patentably distinct from the other party's species, that party should be entitled to have the count narrowed. To do this may require inserting subgeneric claims if they are not already in the application or patent involved in the interference.

Of course, if the count is narrowed, the party having the broad generic claim will not be entitled to the broad claim at the end of the interference unless that party prevails on the narrower count. Moreover, if the count is narrowed, neither party can rely on activity within the broad original count that is not also within the narrow count, for purposes of establishing priority.

#### **Under what circumstances are both parties to an interference entitled to their claims?**

The only circumstances I can think of where both parties to an interference would be entitled to receive their claims are when (1) the interference involves a genus and a subsumed species, (2) the party involved in the interference on the basis of the generic claim establishes priority, and (3) the party in the interference on the basis of a species claim establishes that the species is patentably distinct from the genus even though the species anticipates the genus.

I see nothing wrong with such a result. While I think such a result is perfectly logical, this issue nevertheless is separate from the issue of whether a species constitutes interfering subject matter with a genus. Specifically, I would find it perfectly acceptable for the Board to adopt a directional one-way patentability test of interference-in-fact and leave to another day the issue of whether both parties to a species-genus interference may, under appropriate circumstances, receive their claims.

#### **Is a one-way test of patentability compatible with the holding in *Aelony v. Arni*?**

A one-way patentability test is compatible with *Aelony v. Arni*, 547 F.2d 566, 192 USPQ 486 (CCP 1997). The *Aelony* case does not involve a species-genus interference, but rather involves an interference between parties asserting mutually (but not patentably) distinct subject matter. Specifically, in a particular process *Aelony* claimed the use of one compound while *Arni* claimed the use of 8 compounds, none of which was the same as the compound claimed by *Aelony*. The court held that an interference was proper in this case because the subject matter claimed by the two parties was not patentably distinct and "there is ample precedent from this court for framing the test of interference-in-fact in terms of whether two sets of claims are patentably distinct from each other." 192 USPQ at 490.

As is apparent from the above discussion, the *Aelony* case does not involve a genus-species relationship, but rather claims directed to non-overlapping subject matter. More significantly, although the court in *Aelony* makes reference to the claims not being "patentably distinct from each other," the



case simply does not address the issue of whether a one-way lack of patentability provides a basis for an interference. Indeed, *Aelony* is totally compatible, both factually and philosophically, with a one-way patentability test. Specifically, in *Aelony*, a one-way patentability test would be met (because if a two-way test is met, of necessity so is a one-way test). Moreover, the principle underlying the *Aelony* decision was that

. . . phantom count practice is a proper procedural tool established by the PTO in order to ensure, where necessary, what the statute intends, vis., that only one patent should issue for one inventive concept.

192 USPQ at 490.

Failure to employ a one-way patentability test for determining interference-in-fact is totally at odds with this concept. Specifically, if interferences are not conducted between a genus and a subsumed patentably distinct species, two patents will issue where there should be only one if priority resides in the party asserting the subsumed species.

The various cases cited in *Aelony* are also consistent with a one-way test. Specifically, *Moore v. McGrew*, 170 USPQ 149 (Bd. Pat. Inter. 1971) and *Dewild v. Leigh*, 191 USPQ 256 (Bd. Pat. Inter. 1976) are both like *Aelony* in that they involve mutually exclusive, but not patentably distinct, subject matter and do not address whether a one-way patentability test of interference-in-fact is appropriate under certain circumstances. Moreover, like *Aelony*, both cases are totally compatible with a one-way test. *McCabe v. Cramblet*, 18 USPQ 71 (CCPA 1993) is similar to *Aelony*, but merely seems to stand for the proposition that claim limitations having no patentable significance may be ignored in determining the presence of interfering subject matter.

Finally, *Brailsford v. Lavet*, 138 USPQ 28 (CCPA 1963) is exactly like *Nitz*. In *Brailsford*, as in *Nitz*, the party desiring the interference held the generic claims while the party holding narrow claims asserted there was no interference-in-fact because its narrow claims were patentably distinct from the other party's broad claims. Thus, *Brailsford* is merely another example of a broad versus narrow situation where an interference would not be proper under a directional one-way test because the party trying to provoke the interference cannot show that its claims render the opposing party's claims unpatentable.

\* \* \*

I would like to thank the Trial Section of the Board of Appeals and Interferences for the opportunity to provide these comments.

Respectfully submitted,

---

Jerry D. Voight