

purpose of claim correspondence. The Federal Circuit recently reached a similar conclusion regarding the use of a count in the context of interfering patents in 35 U.S.C. 291 proceedings. *Slip-Track Sys. v. Metal-Lite, Inc.*, 304 F.3d 1256, 1264, 64 USPQ2d 1423, 1428 (Fed. Cir. 2002) (requiring the use of a count). Note that the requirement that counts be separately patentable preserves the current practice of having genus and species counts in appropriate cases, e.g., *Hester v. Allgeier*, 687 F.2d 464, 215 USPQ 481 (CCPA 1982) because a generic invention and a specific invention are often patentably distinct.

The definition of "involved claim" would be based on a similar definition in Rule 601(f). This definition would be consistent with the definition of "involved" for contested cases in proposed § 41.100 because only claims that correspond to the count are at risk in an interference, except to the extent a question is raised as to whether a claim that does not correspond should.

The definition of "senior party" would depart from the current definition in Rule 601(m) by focusing on the earliest constructive reduction to practice to determine which party, if any, is senior. Identification of the senior party is important because a presumption of priority attaches to the senior party under proposed § 41.207(a)(1).

The phrase "threshold issue" would be defined to include three specific issues that affect the standing of a party to participate in an interference. All three are of particular interest to the Board because they have been subject to abuse by parties using interferences as a type of opposition proceeding. An adverse decision on these issues with respect to all of a party's claims would ordinarily end the interference. The list would be open-ended and thus admit the possibility that another issue might qualify as a threshold issue on the particular facts of a specific case. Note that these threshold issues would exist in addition to the possibility that a junior party has failed to allege a prima facie sufficient case of priority. See proposed §§ 41.202(d) and 41.204(a).

The first identified threshold issue would be no interference-in-fact. Without an interference-in-fact, there would be no reason to place either party's claim in jeopardy in the context of an interference proceeding.

The other two specifically identified issues, the bar under 35 U.S.C. 135(b) and lack of written description under 35 U.S.C. 112[1], would be directed to the prevention of spuriously provoked interferences and would consequently

be limited to motions from a party with a patent or published application against a party with an involved application. Note that the section 135(b) bar and lack of written description address complementary problems: Under section 135(b) a claim may be supported but untimely, while a claim lacking written description may be timely but is unsupported. For the purposes of the proposed rule, provocation of an interference would be inferred from the circumstances, such as entry of a claim after publication of the movant's application or issuance of the movant's patent. It would not require any determination that the opponent had an intent to provoke the interference.

Proposed § 41.202(a) would restate the requirements of Rules 604, 607, and 608 for applicants provoking an interference. A showing of priority need not anticipate all possible bases for opposing the showing. For instance, when the applicant's earliest constructive reduction to practice of the interfering subject matter occurred before the apparent earliest constructive reduction to practice of a targeted patent, it would typically suffice for the applicant to show precisely where its earliest constructive reduction to practice was disclosed.

Proposed § 41.202(a)(5) would continue the practice under Rule 633(a) of looking at the applicant's specification to determine the meaning of a copied claim, not the specification from which the claim was copied. See *Rowe v. Dror*, 112 F.3d 473, 479, 42 USPQ2d 1550, 1554 (Fed. Cir. 1997) (explaining the change in practice). It would also set forth a mechanism for weeding out frivolous attempts to provoke an interference. A protester under Rule 291 hoping to prompt an examiner to propose an interference could improve its chances of success by satisfying the requirements of proposed § 41.202(a)(1)–(a)(4) in its protest.

Proposed § 41.202(c) would restate the practice under Rule 605 of requiring an applicant to add a claim to provoke an interference. This requirement is an effective and sometimes necessary method for determining whether an interference actually exists between two parties. In re Ogiue, 517 F.2d 1382, 1390, 186 USPQ 227, 235 (CCPA 1975). The requirement may be used to obtain a clearer definition of the interfering subject matter or to establish whether the applicant will pursue claims to the interfering subject matter. While an applicant must add the claim or forfeit the subject matter of the claim, the applicant may contest the requirement and the examiner may withdraw the

requirement. Where the requirement is based on a patent or a published application, the examiner should note the patent or application in making the requirement. In challenging the requirement, the applicant may point to another claim in the application that already claims the subject matter of the required claim. The applicant may also propose an alternative claim with an explanation of why the alternative claim would be better for the purpose of determining the interference. A common reason for proposing an alternative claim is that the applicant believes the required claim to be unpatentable at least to the applicant.

Proposed § 41.202(d) would set forth the basis for a summary proceeding when an applicant does not appear to be able to show it would prevail on priority. Proposed § 41.202(d)(1) would restate Rule 608, but would eliminate the distinction between Rule 608(a) and Rule 608(b). The requirement could be made under 35 U.S.C. 132 even when a rejection is not available. Failure to comply with the requirement would result in abandonment of the application under 35 U.S.C. 133. Proposed § 41.202(d)(2) would restate Rule 617 by providing a basis for a summary proceeding on priority when the applicant fails to make a sufficient showing of priority. To be sufficient, under proposed § 41.202(e), the showing would by itself, if un rebutted, have to warrant a determination of priority.

Proposed § 41.203(a) would state the standard for declaring a patent interference. The Director uses a two-way unpatentability test to determine whether claimed inventions interfere because, while a one-way test is only sufficient for rejecting a claim under 35 U.S.C. 102(g), a two-way test is necessary to ensure that the claims of both parties are directed to the same invention.

The case law provides that there is no interference-in-fact when there is patentable distinctness between the claims of the parties (e.g., *Case v. CPC Int'l, Inc.*, 730 F.2d 745, 221 USPQ 196 (Fed. Cir.1984); *Aelony v. Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); *Nitz v. Ehrenreich*, 537 F.2d 539, 190 USPQ 413 (CCPA 1976)). Consequently, to declare an interference, the Director requires patentable indistinctness between the claimed subject matter of the parties. *Eli Lilly & Co. v. Bd. of Regents of Univ. of Washington*, 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003). In practice this means that a claim of A and a claim of B interfere if the subject matter of A's claim would, if treated as prior art, have anticipated or rendered obvious (alone or in