

► No prize for being second

An introduction to U.S. patent interference practice.

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What happens when two or more researchers have separately applied for patent protection for the same (or substantially the same) molecule, assay, or other invention? Simple, right? Someone wins the right to obtain a patent and someone does not. Not so simple, however, is the way in which the winner and loser(s) are determined—through an involved legal proceeding called a “patent interference”, or “interference” for short.

In every country other than the United States, when two or more rival inventors contest the right to a patent, the dispute is resolved very simply—the first inventor to file a patent application wins. The result is applicants racing to the appropriate patent office to get their applications on file first.

But in the United States, resolving a dispute over the right to a patent is not so straightforward. The reason is that the U.S. Patent and Trademark Office (USPTO) must determine who was the first to actually invent the disputed subject matter—not simply the first to file a patent application.

Generally, a patent interference is a trial-like, administrative proceeding by which the first to invent is determined by the Board of Patent Appeals and Interferences (the Board). Using patent lawyer lingo, the “first to invent” is either

- (1) the first to “conceive” and the first to “reduce to practice”, or
- (2) the first to conceive and the last to reduce to practice, if, and only if, he or she worked on the invention with “reasonable diligence” from a date just prior to the other party’s conception to the date of his or her own reduction to practice.

An interference arises when two or

more pending applications, or at least one pending application and an unexpired patent, contain claims covering the same or substantially the same subject matter. An important point here is that an interference is appropriate only when both inventors *claim* the same invention. It’s not enough that they *describe* the same subject matter, because it is the claims that define the scope of the patent rights. The



determination of who is the first to invent the claimed subject matter is commonly referred to as a determination of “priority”.

The Board conducts the interference under a complex set of rules found in Title 37 of the *Code of Federal Regulations*, Part 1. An interference usually includes motions, depositions, briefings, and an oral hearing before a panel of three Administrative Patent Judges. The Board is empowered to decide not only priority of invention but also the patentability of that invention. In some cases, the Board will decide that the invention is not patentable

to either party and will enter judgment that neither is entitled to a patent.

How it begins

An interference can be initiated in two ways: by suggestion of the Examiner or by request of the applicant. When an Examiner determines that an invention claimed by an applicant is patentable, and that it is the same invention as that claimed in an unexpired patent or another pending patent application, the Examiner may then forward the application to the Board for declaration of an interference.

To seek an interference, an applicant must file a request addressed to the Examiner that satisfies specific requirements set out in the USPTO rules. Such a request must suggest one or more “counts”, present or identify at least one claim “corresponding” to the count (see box, “Terms of art: ‘Count’ and ‘correspond’”), identify the other patent application or unexpired patent that claims the same or substantially the same invention, and explain why an interference should be declared. By statute, the applicant must have presented the claims for interference within one year of the issue date of the opponent’s patent, or within one year of the publication of the opponent’s application.

Once an Examiner determines that an interference might exist, the Examiner forwards the application file to the Board with a memorandum of prescribed form and content. Whether the interference will be declared in accordance with the Examiner’s memorandum—or declared at all—is for the Board to decide. If the Board is satisfied that an interference exists, a notice will be mailed to each involved party “declaring” an interference.

The notice identifies the subject matter in dispute and sets a schedule for certain required actions by the parties. Among other things, the notice identifies one of

the parties as “senior” and all others as “junior”. The “senior party” is the applicant or patentee who is entitled to rely on the earliest filing date and is therefore presumed—subject to contrary proof—to be the first inventor.

What it decides

An inventor under U.S. law is a person who contributed to the conception of the subject matter defined by at least one claim in a patent or application. Showing that you are the “first” to invent requires proving that you were the first to possess the complete invention. As already mentioned, a complete invention consists of two elements: “conception” (i.e., the idea) and “reduction to practice” (i.e., putting the idea into a workable form). So, proving priority of invention (i.e., that you are the first inventor) requires proof of the earliest dates for both conception and, in most cases, reduction to practice.

A complete conception is not simply the inventor’s idea, but an idea that is so clearly defined that a person of ordinary skill in the field of the invention would be able to reduce the invention to practice without undue experimentation. Thus, to prove a date of conception of a new molecule, for example, an inventor must present evidence that she, on a certain date, had not only the idea of the structure of that molecule but also of an operative method of synthesizing it and of a practical use for it.

As for the other part of invention, a reduction to practice can take one of two forms: actual or constructive. An *actual* reduction to practice is a physical demonstration that the invention works for its intended purpose. This might be proved, for example, by evidence that a molecule was synthesized, analyzed to establish its identity, and tested in a recognized manner to prove its utility. A *constructive* reduction to practice is the filing of a patent application that describes the invention and how to make and use it.

All testimony is initially submitted in affidavit form, but witnesses might be cross-examined in a deposition. Any documentary evidence, such as copies of research records, correspondence, and analytical or other test data, must be filed

with an affidavit. An inventor’s testimony, the documents he creates, and any other evidence based entirely on information obtained from an inventor must be independently corroborated to prevent fraud. Testimony and records of others (technicians, analysts, and others who didn’t contribute to the conception of the invention) need not be independently corroborated.

It is possible (though perhaps difficult), however, to win an interference if you were

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the first to conceive but the last to reduce to practice. The patent statute allows an inventor an opportunity to win the priority contest by proving that he had the earliest conception and showing the exercise of “reasonable diligence” during what is known as the “critical period”; that is, a period beginning just prior to the other party’s conception and continuing up to his own reduction to practice. One can prove diligence by submitting evidence of reasonably continuous activity toward a reduction to practice (actual or constructive) and/or evidence of an acceptable excuse for any periods of inactivity. Acceptable excuses may be, for example, reasonable delays in obtaining materials or personnel, or delays due to the need for regulatory clearance for the needed activity. A purely business reason for a delay (e.g., postponing work on a project because of market conditions) is not an acceptable excuse for inactivity.

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pressed, or concealed. That can happen if the evidence shows that the inventor (or his employer) did not take steps within a reasonable time to make the invention public by filing a patent application, commercializing the invention, or using other means.

Where it ends

The interference proceeding ends with a judgment of the Board stating which party (if any) is—and is not—entitled to a patent containing claims covering the disputed invention. A party not satisfied with the Board’s judgment can request reconsideration or can pursue either of two routes of appeal—directly to the U.S. Court of Appeals for the Federal Circuit or, alternatively, to a U.S. District Court.

All in all, a patent interference is a complex proceeding, but its complexity has a purpose—making a fair determination of which inventor is entitled to a patent for what may prove to be a very valuable invention.

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Terms of art: “Count” and “correspond”

The terms *count* and *correspond* require a bit more explanation in the context of interferences at this point. To say that a claim corresponds to a count means that the claim is at risk of being lost during the interference because the invention it defines would not be separately patentable in view of the invention defined by the count.

Technically speaking, a count looks like a claim in a patent or an application, but its function is quite different—the count defines the subject matter as to which “priority” (first inventorship) will be decided. One important function of the “count”, therefore, is to define what evidence will be considered by the Board in deciding which party was the first inventor.