

**Targeting Applicants Should Be Expressly Authorized to File
37 CFR 1.313 Petitions to Withdraw Target Applications
From Issuance for Consideration of a Possible Interference¹**

By

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and

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I. Introduction

A recurrent situation is that the owner of a patent or an application becomes aware of the existence of an application that it believes to interfere with its own patent or application, which application is owned by another company, after the other company's application has been allowed. At that point the first company can, of course, file a 37 CFR 1.604 request for an interference with the target application.³ (If the first company

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³ 37 CFR 1.604 reads as follows:

- (a) An applicant may seek to have an interference declared with an application of another by,
 - (1) Suggesting a proposed count and presenting at least one claim corresponding to the proposed

owns a patent rather than an application, it will have to file an application to reissue that patent before or concurrently with its 37 CFR 1.604 request, but that is not a problem.) However, that request is extremely unlikely to lead to the immediate declaration of the desired interference unless the first company can get the target application withdrawn from issue. Obviously, that is a particular problem if the first company suspects that, if the second company's application matures into a patent, the second company will promptly sue it for infringement of that patent. Accordingly, in this article we propose a solution to this recurrent problem.

count or identifying at least one claim in its application that corresponds to the proposed count,

(2) Identifying the other application and, if known, a claim in the other application which corresponds to the proposed count, and

(3) Explaining why an interference should be declared.

(b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Director of any instance where it appears an applicant may have failed to comply with the provision of this paragraph.

The obvious solution to the first company's problem is to file a 37 CFR 1.313 petition to withdraw the target application from issue for consideration of the 37 CFR 1.604 request, perhaps accompanied by a 37 CFR 1.99 third-party submission. However, 37 CFR 1.313 and 37 CFR 1.99 read as follows (with the problematic language emphasized):

37 CFR 1.313

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims;

or

(4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one or more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application.

Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from

issue after payment of the issue fee may not be effective to avoid publication of application information.

37 CFR 1.99

(a) A submission by a member of the public of patents or publications relevant to a pending published application may be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner.

(b) A submission under this section must identify the application to which it is directed by application number and include:

(1) The fee set forth in § 1.17(p);

(2) A list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent^[4] or publication;

(3) A copy of each listed patent or publication in written form or at least the pertinent portions; and

⁴ We suggest that the filing date of at least the U.S. patents submitted for consideration is usually more important than the publication date!

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section shall not include any explanation of the patents or publications, or any other information. The Office will not enter such explanation or information if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of the public to a pending published application that does not comply with the requirements of this section will not be entered.

(f) A member of the public may include a self-addressed postcard with a submission to receive an acknowledgment by the Office that the submission has been received. A member of the public filing a submission under this section will not receive any communications from the Office relating to the submission other than the return of a self-addressed postcard. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section.

More troubling is a recent notice⁵ by the Deputy Commissioner for Patent Examination Policy (Stephen G. Kunin) that improper 37 CFR 1.99 submissions may expose the submitting party to “appropriate action” in the Office of Enrollment and Discipline (“OED”). According to the interpretation set out in the Notice, 35 USC 122 *requires*, rather than merely empowers, the PTO to prohibit improper submissions in published applications.

II. What Actually Happens in Practice

Undeterred by the language of 37 CFR 1.313 and 37 CFR 1.99, the senior author of this article has several times filed 37 CFR 1.313 petitions on behalf of a targeting applicant seeking to have a target application withdrawn from issue for consideration of a

⁵ US PTO OG Notices: 22 April 2003, “Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application.”

concurrently filed 37 CFR 1.604 request.⁶ The results have not been what you might expect.

The Petitions Office has a form (the petitions examiners call it a “template”) denial of such petitions on the grounds that only the owner of an application can file a grantable 37 CFR 1.313 petition. That form denial comes back promptly, and of course one must prepare the client (which one has billed for preparing the petition) for the receipt of that form denial.⁷

However, what has repeatedly happened is that the PTO has “sua sponte” withdrawn the target application from issue and sent it back to the examiner for consideration of the 37 CFR 1.604 request. (Of course, there is no more guarantee that the 37 CFR 1.604 request will be granted than in any other case.) Thus, the result has pleased our clients, but the mechanism by which the result has been achieved is the kind of thing that causes reasonable people to mutter, “The law is an ass.” Put otherwise, the present situation is a transparent legal fiction.

⁶ In light of Mr. Kunin’s Notice, the senior author points out that he did so before the date of Mr. Kunin’s Notice!

⁷ On the most recent occasion on which the senior author filed such a petition, the Petitions Office simply mailed it back to us with a stamped notation which read: “Cancelled.” However, the result was the same as that discussed in the next paragraph of the text.

III. Our Suggested Changes to 37 CFR 1.313 and 37 CFR 1.99

The present odd situation would be changed, and the rule would be brought into conformity with what appears to be the reality, if 37 CFR 1.313 and 37 CFR 1.99 were amended as follows:

37 CFR 1.313 (Amended)

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by [the applicant] any interested party. To request that the Office withdraw an application from issue, [applicant] the interested party must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims;

or

(4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one or more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application.

Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from

issue after payment of the issue fee may not be effective to avoid publication of application information.

37 CFR 1.99 (Amended)

(a) A submission by a member of the public of patents [or], publications, or other information relevant to a pending published application may be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner.

(b) A submission under this section must identify the application to which it is directed by application number and include:

(1) The fee set forth in § 1.17(p);

(2) A list of the patents [or], publications, or other information submitted for consideration by the Office, including the date of publication of each patent or publication and, if a patent is a U.S. patent or a publication is a U.S. published application, its filing date;

(3) A copy of each listed patent or publication in written form or at least the pertinent portions; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section that is limited to patents and publications shall not include any explanation of the patents or publications[, or any other information]. The Office will not enter such explanation [or information] if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section that is limited to patents and publications must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any such submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). [A] Such a submission by a member of the public to a pending published

application that does not comply with the requirements of this section will not be entered.

(f) A member of the public may include a self-addressed postcard with a submission to receive an acknowledgment by the Office that the submission has been received. A member of the public filing a submission under this section will not receive any communications from the Office relating to the submission other than the return of a self-addressed postcard. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section.

IV. Our Rationale for Our Proposed Changes to 37 CFR 1.313 and 37 CFR 1.99

Besides preventing (or at least reducing the frequency of) clients sniggering at the PTO, we submit that there is a strong public interest in deciding whether two applications interfere before either application matures into a patent—particularly when the target application is at least prima facie junior to the targeting application. If the target application matures into a patent and the owner of that patent then sues the owner of the targeting application for patent infringement, the owner of the targeting application will usually move to stay the infringement action pending the outcome of the interference, and that motion is usually granted.⁸ However, that motions practice in a district court is

⁸ See Gholz, Parallel District Court and ITC Patent Infringement Actions and PTO Interferences, 83 JPTOS 607 (2001) at 612-16, “Stay of District Court Patent Infringement Actions Pending Disposition of PTO Interferences.”

normally a complete waste of time and money—and an annoyance to the Article III judge assigned to the patent infringement action.

Moreover, we respectfully (oh, so respectfully!) submit that Mr. Kunin’s Notice doesn’t make much sense, as evidenced by the following passage in the Notice:

Finally, the provisions of 35 U.S.C. 122(c) and 37 CFR 1.99, 1.291, and 1.292 limit a third party’s ability to protest, oppose the grant of, or have information entered and considered in an application pending before the USPTO. However, these provisions (and this notice) do not limit the USPTO’s authority to independently re-open the prosecution of a pending application on the USPTO’s own initiative and consider information deemed relevant to the patentability of any claim in the application. See *Blacklight v. Dickinson*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002). [Emphasis added.]

Thus, in accordance with the Notice, counsel for a targeting applicant could find himself or herself in the OED defending an allegedly improper 37 CFR 1.99 submission, while the PTO is lauded for “independently” reopening prosecution on its “own initiative”!⁹ One can hear the wink from across the room.

Our permissive definition of submission in our proposed amended 37 CFR 1.99 finds is not a radical innovation. It finds precedent in 37 CFR 1.291, which relates to

⁹ That is, this Notice publicly endorses the subterfuge that we described at the outset!

third party submissions in pending (unpublished) applications.¹⁰ And, although less relevant, our permissive definition of submission is also consistent with that term as it is used in the context of a Request for Continued Examination.¹¹

¹⁰ 37 CFR § 1.291 Protests by the public against pending applications [underlines added for emphasis].

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:

(1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and

(2) The protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

(b) Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office. A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner and it includes:

(1) a listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each listed item;

We see no reason why an interested party should be limited to submitting only patents and publications in a published application, but not so limited in an unpublished

(3) A copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

(c) A member of the public filing a protest in an application under paragraph (a) of this section will not receive any communications from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

¹¹ 37 CFR § 1.114 Request for continued examination, reproduced in relevant part:

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability.

application. There is a valid policy interest in apprising the PTO of applications that interfere, regardless of whether the target application is published or unpublished.

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