

TIERNEY INTERFERENCES¹

By

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I. **Introduction**

Louis v. Okada, 57 USPQ2d 1430 (PTOBPAI 2000) (opinion by APJ Lee for an expanded panel that also consisted of CAPJ Stoner, SAPJ McKelvey, and APJ's Schafer, Torczon, Gardner-Lane, and Medley)(discussed in Gholz, "A Critique of Recent Opinions in Patent Interferences," 84 JPTOS 165 (2002) at §X.E.), was an interference between a Louis patent and an Okada application. My colleague Todd Baker and I represented Louis. We filed a motion to add two Okada patents to the interference. The expanded panel denied the motion on the ground that the board does not have jurisdiction under 35 USC 135(a) to conduct patent verses patent interferences.³

II. **How Judge Tierney Got Around Louis v. Okada**

Stampa v. Jackson, 74 USPQ2d 1702 (PTOBPAI 2004) (non-precedential) (opinion by APJ Tierney, not joined by any other APJ), was an interference between a Stampa patent and an application to reissue the Stampa patent on one side and a Jackson patent and a Jackson application (apparently not an application to reissue the Jackson patent) on the other. As Judge

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³ Thus the expanded panel did not consider Louis's evidence that the claims in the two Okada patents that Louis sought to add to the interference were not patentably distinct from the parties' claims already designated as corresponding to the count. Since the expanded panel denied Louis's motion, the two Okada patents are still out there -- notwithstanding that fact that Louis won the interference on the merits.

Tierney conceded at the onset, “Superficially one might reach a conclusion that this interference somehow involves at least one patent versus at least a [sic; one] patent of another”⁴ – which, Judge Tierney noted, would be contrary to the holding of the expanded panel in Louis.⁵

Not to worry, however. Judge Tierney, who was not on the expanded panel in Louis, found that there was a simple solution to the problem: change the one interference as declared into two interference, one between the Stampa patent and application on one side and the Jackson application on the other side and one between the Stampa application on one side and the Jackson patent and application on the other. Accordingly to Judge Tierney, his solution to the pesky statutory and precedential problem:

will mean very little extra work on the part of the parties or the board because the board has a wide discretion on how it consolidates interferences and conducts proceedings in consolidated interferences. For example, two interferences can be declared on the same day and the times for taking action during both the preliminary motions phase and the priority phase can be set to run concurrent[ly]. All papers could be filed in the file of the first interference. The file of the second interference could contain as little as (1) the notice declaring interference, (2) an order consolidating [the] interference[s], (3) a decision on preliminary motions, (4) a decision on priority and (5) a judgment, all of which would be entered by the board. The same administrative patent

⁴ 74 USPQ at 1702

⁵ However, see Gholz, “Sometimes the Trial Section **Does** Handle Patent-Patent Interferences After All!”, 10 Intellectual Property Today No. 8 at page 32 (2003)

judge could handle both interferences and all panel decisions in both interferences could be made by a panel of the same judges.⁶

III. Comments

So, would Todd and I have been able to take down the other two Okada patents in Louis if we had filed two applications to reissue the Louis patent adding a harmless (and pointless!) claim or two to each, moved to add those reissue applications to the existing interference, and then asked to have the one existing interference redeclared as three separate interferences, giving the APJ three counters, the PTO three filing fees, and costing counsel and the real parties in interest (what the PR folks at the PTO are fond of calling the PTO's "customers") only a modest amount of additional work and additional expense, respectively?

Among other things, the obvious problem with using this technique with any APJ other than Judge Tierney is that some of his colleagues may deny the motion to add the reissue application to the interference and then defend that denial on the ground that he or she has discretion to refuse to add the reissue application to the interference even if it plainly claims the same patentable invention as the cases already in the interference.

I propose that, by analogy to McKelvey counts, interferences of the type that APJ Tierney set up in this case hereinafter be referred to as "Tierney interferences."

⁶ 74 USPQ at 1703.