

PARTICIPATION BY A VICTORIOUS INTERFERENT IN THE LOSING
INTERFERENT'S
POST-INTERFERENCE PROSECUTION ⁱ

By Charles L. Gholzⁱⁱ

I. Introduction

When the new interference rules adopted in 1984 were under discussion, I suggested that victorious interferents be given automatic access to and the right to participate in the losing inferents' post-interference prosecution in order to present their views on the application of interference estoppel to that prosecution. At the time, the powers that be in the Office indicated some receptiveness to my suggestion. However, when I actually tried to put my idea into practice, I was squelched firmly. In re Temple, 231 USPQ 492 (Special Programs Examiner 1986).

Many years have passed, and the interference rules have been amended many additional times. Notably, the vast majority of prosecution files are no longer "maintained in confidence" by the PTO. However, the problem remains. Examiners do not do a good job of enforcing interference estoppel.

II. What I Argued in Temple

As quoted in Special Programs Examiner Lazarus's opinion, I argued as follows:

It is respectfully submitted that the present situation includes "special circumstances" of the type referred to in 35 USC 122. First, 37 CFR 1.658(c) is a new and complicated provision in the rules. It is reasonably predictable that many examiners will not fully understand it -- or even be aware of its existence. Accordingly, the participation of the prevailing party in the interference in post-interferences ex parte prosecution is likely to be particularly helpful to the examiners at this time. Second, the status of Temple et al.'s claims 16-19 themselves may

be unclear to the examiner in this case, since they were not expressly included in the board's judgment. And, third, several of the grounds on which Sittig et al. relies raise fairly sophisticated legal issues. No disrespect to the examiner is intended, of course, but it is believed that the participation of Sittig et al. might be particularly helpful in the event that Temple et al. respond further to those contentions. Accordingly, petitioners respectfully request (1) access to the Temple et al. application and (2) authorization to comment on all papers filed by the applicants before the examiner acts on those papers."ⁱⁱⁱ

III. What Special Programs Examiner Lazarus Wrote

Special Programs Examiner Lazarus treated my petition for access as a petition for the right to file supplemental protests (I had previously filed one protest) and ruled (absolutely correctly) that "current office practice does not permit continuing protestor participation in pending applications."^{iv} As for my policy arguments, he ruled that:

The issues remaining for consideration are properly before the primary examiner[,] and the examiner may now proceed to consider the application with the benefit of petitioner's remarks in the protest. However, additional participation by protestor could hinder examination since[,] as stated at Section 1901.07(b) of the M.P.E.P.

"Previously, the filing of multiple papers by either the applicant and/or protestor(s) with respect to a specific issue(s) has created problems in that the application files became unduly expanded and unnecessary delays in the examination were encountered."^v

* * *

The argument that petitioner by virtue of participation in the interference proceedings has information which would aid the examiner in the forthcoming prosecution is negated by the presentation of such arguments in the protest. The PTO now has the benefit of petitioner's views on the remaining issues (as presented in the protest) and further participation by petitioner would likely cause additional delays and could unduly expand the application file. These

drawbacks are not overcome by protestor's continued comments on the remaining issues. The examiners in the PTO have the requisite training and can deal with the issues in prosecution in an ex parte manner.^{vi}

III. Comments

The PTO has often rejected offers of outside help on the ground that “The examiners in the PTO have the requisite training and can deal with the issues in prosecution in an ex parte manner.”^{vii}

The major problem with that argument is that the examiners don't have the requisite time to deal with complicated issues in prosecution in an ex parte manner. When an invention is commercially important, outside counsel sometimes have effectively unlimited budgets and can almost always spend more attorney time on an issue than any examiner would spend.

Moreover, coming off the interference playing field, the victorious interferent is likely to have a great deal more emotional capital invested in blocking issuance of post-interference claims to the losing interferent than the examiner will.

With all due respect, I believe that what is really going on here and in similar situations is that the PTO doesn't want to invest the examiner resources which would be necessary to deal with victorious interferents' arguments. That is, what the PTO is really worried about is that participation of victorious interferents in post-interference prosecution will cause the application files to “become unduly expanded.”

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ⁱⁱⁱ 231 USPQd 492.

^{iv} 231 USPQd 493.

^v 231 USPQd 493.

^{vi} 231 USQPd 493.

^{vii} 231 USPQd 493. See, e.g., Gholz & Pike, Targeting Applicants Should Be Expressly Authorized to File 37 CFR 1.313 Petitions to Withdraw Target Applications From Issuance for Consideration of a Possible Interference, 10 Intellectual Property Today No. 11 at page 12 (2003).