

# WRITE-UPS OF THE MOST INTERESTING INTERFERENCE OPINIONS OF 2007

Prepared for the Winter 2008 Meeting of the  
Interference Committee of the AIPLA

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# In re Garner

1. Appeal by losing interferent.
2. Garner's corroborating witness testified that he had seen the device, but not that he had seen it operate.

## Held:

No Good. “[C]orroboration of the existence of the device is not sufficient in this case to establish corroboration of reduction to practice.”

# In re Garner

## Comment:

There have been cases involving extremely simple inventions where an ARP was found without proof of successful testing. However, that was then, and this is now. I think that now you would, at a minimum, need an expert's declaration saying that no actual testing was necessary to be confident that the device would work for its intended purpose.

# Santarsiero v. DeLucas

1. Most 35 USC 135(b) cases involve pre-bar date claims in the case in interference or a parent.
2. This case involved pre-bar date claims presented in a sister application.

## Held:

OK. Nothing contrary in the statute and consistent with the underlying policy.

# Santarsiero v. DeLucas

## Comment:

In families of related applications, claims get bounced around from application to application. This holding will be useful.

# Ding v. Singer

- 35 USC 135(b)(2) states: “a claim which is the same as, or for ... substantially the same subject matter as, a claim of a published application ... may be made in an application *filed* after the application is published only if the claim is made before 1 year after the date on which the application is published.
- Unclear in 35 USC 135(b)(2) whether “filed” means the effective filing date under 35 USC 119 and 120 or the actual filing date of the application.

# Ding v. Singer

## Held

“filed” means the effective filing date of the application.

## Comment

The decision of the Ding panel is not binding on the rest of the Board. Should “copy” claims as a matter of precaution regardless of the effective filing date of the application.

# Karim v. Jobson

1. Why does the Trial Division regularly relegate patentability issues to post-interference ex parte prosecution?
2. According to the SAPJ, it is not because the APJs are trying to avoid work. It's because:  
Examiners have expertise in examining patent applications.  
The Board has expertise in handling interferences.



## Karim v. Jobson

### Comment:

The parties being remanded to the examiner love to be thrown back into the briar patch! Your chance of having the examiner find allowable subject matter vastly exceed your chance of having the APJs find allowable subject matter.

## Karim v. Jobson

### Question:

Is this consistent with Perkins v. Kwon, Wu v. Wang, and Schulze v. Green? It is high time that one of us takes this issue up!

# Brand v. Miller

1. The CAFC reviews factual findings of the BPAI and the TTAB for support by “substantial evidence” under § 706(2)(E) of the APA. Other circuits review such decisions by administrative agencies under the more deferential “arbitrary or capricious” standard of § 706(2)(A).

## Brand v. Miller

2. The distinction is whether the administrative agency has made a “formal adjudication.” To be a formal adjudication within the meaning of the APA, the parties must have the right to present evidence live before a judicial officer. The Trial Division occasionally takes evidence live, but it is discretionary.

## Brand v. Miller

### Comment:

This makes a difference! The chance that a panel of APJs will make a factual finding that is “arbitrary or capricious” is very low. The chance that they will make a factual finding that is “unsupported by substantial evidence” is much higher.

# Meritor Transmission Corp. v. Eaton Corp.

1. Patent infringement action based on a patent that had been involved in an interference between the same two parties.
2. The party that lost the interference had numerous theories of invalidity which differed in greater or lesser extent from the theories that it argued to the board.

# Meritor Transmission Corp. v. Eaton Corp.

3. Coakwell v. United States had held that collateral estoppel applies to administrative decisions in interferences. (No court review required.)
4. The party that won the interference argued successfully that the party that lost the interference was barred from raising any validity issue in the infringement litigation.

# Meritor Transmission Corp. v. Eaton Corp.

## Comment:

There is no CAFC opinion squarely on point. If this holding is generally accepted, the value of the services of interference counsel should increase!