

# Using A Suggestion Of Interference To Undermine A Competitor's U.S. Patent Application

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## Introduction

This article is in response to Robinson and Haq, "Current and Potential Methods to Undermine a Competitor's U.S. Patent Application," 81 PTCJ 770 (April 8, 2011). In that article, the authors discussed four currently available methods for undermining a competitor's U.S. patent application (namely, 37 CFR 1.99 third-party submissions, 37 CFR 1.291 protests, 37 CFR 1.292 petitions for public use proceedings, and letters to opposing counsel designed to trigger a 37 CFR 1.56 obligation on the opposing counsel to submit adverse information to the PTO) and the additional pre-issuance submission by third parties that would become available if Section 7 of the Patent Reform Act of 2011 (aka the America Invents Act) becomes law. The article states, that, "Currently, there are at least four options available for a third party to provide prior art or other information in a competitor's *ex parte* patent prosecution,"<sup>1</sup> but it concludes that, "Under current law, the options are limited"<sup>2</sup> and that, "In the average case, by the time a third party finds out about a patent application, it is too late to use the current PTO procedures."<sup>3</sup>

The purpose of this article is to suggest a fifth technique that is currently available, that may often be used substantially later in the competitor's *ex parte* prosecution, and that, when available, may be used with devastating impact on the competitor's prosecution. That method is the suggestion of an interference with the competitor's application.

## The Requirements for Suggesting an Interference

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<sup>1</sup> 81 PTCJ at 771; emphasis supplied.

<sup>2</sup> 81 PTCJ at 770.

<sup>3</sup> 81 PTCJ at 770.

37 CFR 41.202, “**Suggesting an interference,**” provides, in relevant part, that “An applicant, including a reissue applicant, may suggest an interference with another application or a patent.” Notably, unlike the methods discussed by Messrs. Robinson and Haq, there is no time limit for the filing of such a suggestion expressly stated in 37 CFR 41.202. Of course, there is at least one very important time limit implicit in the entire interference process. That is, because the PTO will not declare an interference unless an examiner has determined that the applicant’s claim is in condition for allowance but for the existence of the interference, a company seeking to use this technique must initiate the process (by filing an appropriate patent application, domestic or foreign) before the competitor’s published application or patent becomes a statutory bar. Similarly, a company seeking to use this technique must initiate the process before any other statutory bar comes into existence.

Another implicit limitation on the use of this technique is that the company must have filed or be in a position to file a patent application containing at least one interfering claim. That is, the company must have made an invention that is close enough to its competitor’s invention that an examiner can be persuaded that the company has at least one claim that interferes with at least one claim in the competitor’s application.<sup>4</sup> In the vernacular of the interference bar, the company must have “a ticket to ride.”

### **Practical Problems With the Use of This Technique**

In many cases, the most significant practical problem with using this technique is that, particularly in comparison to the techniques discussed by Messrs. Robinson and Haq, it is

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<sup>4</sup> Or patent. However, this article is focusing on what Messrs. Robinson and Haq call “imped[ing]” a competitor’s application, not on “taking down” a competitor’s patent.

expensive.<sup>5</sup> Thus, the company should carefully consider the competitive significance of the competitor's application before embarking on the use of this technique.

A less obvious practical problem with using this technique is that, the PTO's classification system being what it is, the competitor's application and the company's application are unlikely to be pending before the same examiner, at least initially. If that situation is allowed to persist, the odds are that the competitor's application will have matured into a patent (and the company will have been sued for infringement of that patent) before the examiner handling the company's application has been persuaded to recommend the declaration of an interference.<sup>6</sup>

One promising technique to deal with this situation is to try to get the two applications assigned to the same examiner.<sup>7</sup> This usually entails bringing the situation to the attention of a common supervisor, whether the common supervisor is an SPE or a group director. In extreme cases, where the applications are pending in two different groups, this entails bringing the situation to the attention of John Leguyader, the groups director who has been given responsibility (as an extra duty, which he seems to relish) of trying to mediate pre-interference problems that either involve different groups or that, for one reason or another, haven't been resolved satisfactorily within a group. In either case, the argument to be made is that it would be much more efficient for the PTO to have the two applications pending before a single examiner,

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<sup>5</sup> It is, however, far less expensive than waiting for the competitor's patent to issue and then defending an infringement action based on that patent—and, of course, if the company has a decent invalidity or unenforceability defense, it is probably preferable to argue it to the tech-savvy APJs in a motion for a judgment of unpatentability than it is to argue it to a lay jury as an invalidity defense. Not only are the APJs more likely to understand the argument, but the company's burden of proof in the interference is only the preponderance of the evidence, not clear-and-convincing evidence.

<sup>6</sup> Regrettably, many examiners are extremely reluctant to recommend the declaration of an interference. Some employ techniques to avoid recommending the declaration of an interference ranging from simply not acting on the suggestion of interference to imposing a lengthy series of increasingly weak rejections.

<sup>7</sup> See Gholz, Prosecution of Targeting and Targeted Applications Before the Same Examiner, 17 Intellectual Property Today No. 2 at page 22 (2010).

since, by definition (or, at least, according to the argument of the company's counsel), they involve very similar subject matter.

Of course, the company's counsel has the normal 37 CFR 1.56 obligation to apprise the examiner of information material to the patentability of the claims in the company's application. Assuming that the claims in the company's application do in fact define subject matter that is very close to (if not identical to) the subject matter defined by the claims in the competitor's application, information that is material to the patentability of the claims in the company's application is likely to be material to the patentability of the claims in the competitor's application. That means that, by bringing that information to the attention of the examiner in connection with the company's application, one will have effectively brought that information to the attention of the examiner in connection with the competitor's application.

Moreover, if the company has a patent or published application corresponding to the application in which it has suggested an interference that is available as a 35 USC 102(e) reference against the competitor's claims, the examiner is likely to become aware of that fact even if one does not explicitly point it out to him or her and may use that 35 USC 102(e) reference against the competitor. If the examiner employs that 35 USC 102(e) reference, and if the competitor is unable to overcome that reference (by antedating it, by arguing over it, or by amending its claims to distinguish the reference), that can solve the problem at minimum cost to the company.

Finally, there is a very important practical problem that is unlikely to be immediately apparent to the reader. The PTO takes a dim view of any registered practitioner's "interfering" with the prosecution of an application in which that practitioner does not have a power of attorney except by a method expressly authorized by its rules. That PTO view is discussed at

length in 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). Because of that PTO view, a practitioner employing the technique discussed in this article must be very careful not to say (either orally or in writing) anything to the common examiner that could be construed by opposing counsel<sup>8</sup> as an attack on the competitor's application by an unauthorized means.

### **Concluding Comment**

The technique discussed in this article can sometimes be used to undermine a competitor's U.S. patent application—even to the extent of preventing its issuance altogether. That can happen either in the pre-interference stage (by inducing the examiner handling the competitor's application to enter rejections of the claims in the competitor's application which the competitor's counsel is unable to overcome) or in the interference itself (by obtaining a judgment that the competitor's claims are unpatentable on any ground that would be available as a defense in patent infringement litigation—including, but not limited to, priority).

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<sup>8</sup> Opposing counsel could attempt to so construe what one has done in employing the technique discussed in this article either in the interference, if one is ultimately declared, or, perhaps more importantly, in a complaint filed with the Office of Enrollment and Discipline.