

# PROSECUTION OF TARGETING AND TARGETED APPLICATIONS BEFORE THE SAME EXAMINER

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By

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## **Introduction**

This article is a follow-on to 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). In that article, we argued 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.<sup>3</sup>

This article deals with a related, but different issue: Petitions to have a targeting application (i.e., an application in which a suggestion of interference has been filed) and a target application (i.e., the application with which the targeting applicant has sought an interference) assigned to the same examiner for ex parte prosecution.

## **What the MPEP Says**

Section 2304.01(b), "Obtaining Control Over Involved Files," says that:

Ordinarily applications that are believed to interfere should be assigned to the same examiner. [Emphasis supplied.]

Moreover, in language that emphasizes the importance of that policy, the section continues as follows:

If the interference would be between two applications,

and the applications are assigned to different Technology Centers (TCs), then one application must be reassigned [from one TC to the other]. Ordinarily the applications should both be assigned to the TC where the commonly claimed invention would be classified.

Since reassigning applications from one TC to another is apparently an administrative problem, the MPEP would presumably not state that one of the two applications must be reassigned unless the PTO considered its policy of having two applications “that are believed to interfere” assigned to the same examiner an important policy.

#### **The Problem with MPEP § 2304.01(b)**

The problem with MPEP § 2304.01(b) is that it does not specify who must believe that two applications interfere in order for that paragraph to be operative. However, it seems to me (1) that the fact that the targeting applicant has submitted a suggestion of interference with the targeted application clearly means that the targeting applicant’s assignee believes that the two applications interfere and (2) that the fact that a suggestion of interference between two applications has been filed means that the two applications should be examined by the same examiner. Otherwise, the probability that the two examiners will take inconsistent positions is unacceptably high.

If the two examiners do take inconsistent positions, that is not only frustrating to the prospective interferences (each of which is often well aware of and monitoring what is going on in its prospective opponent’s prosecution), it is inefficient from the perspective of the PTO—since inconsistent examination results are very likely to lead to unnecessary appeals. Moreover, the unnecessary appeals are likely to lead to delays in issuance of one or both of the applications, which is a highly socially dysfunctional result.

## **MPEP § 2304.01(b) in Practice**

Notwithstanding the apparently very clear mandate of MPEP § 2304.01(b), I have experienced difficulties in obtaining its implementation in practice. In one recent case, I was moved to solicit help from John LeGuyader, a Director in TC 1600 who has been given the additional duty of helping with pre-interference and post-interference prosecution problems. He is, in effect, an ombudsman at large for such problems. While he has no direct authority outside his Technology Center, the interference bar has found him extremely helpful in dealing with such problems.

In that case, however, I didn't get the two applications assigned to a single examiner. Moreover, I found his explanation for why they were not to be assigned to a single examiner extremely troubling. In essence, he was concerned that I (and, I presume, counsel for my prospective opponent) might try to influence how the single examiner handled the other fellow's application.

In an email to me, Mr. Leguyader explained:

In certain situations we do try to bring certain cases under the examination of the same examiner, if for no other reason than to ensure consistent examination. However, there are certain situations when this is not always practical.

Regarding the specific situations concerning potential interferences and third party input, our Patent policy staff brought to my attention a few points.

37 CFR 1.99 sets forth the limits of what information a third party may bring to the attention of an examiner that may be used in considering the patentability of the claims in a "target" application to another that has been published under the eighteen-month publication provisions of 35 USC 122(b). Specifically, 35 USC 122(c) provides that "[t]he Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application<sup>[4]</sup> may be initiated

after publication of the application without the express written consent of the applicant.”

The position taken by the USPTO in the Official Gazette notice published in 2003<sup>[5]</sup> [which is discussed in the article I co-authored cited at the outset of this article] is based upon the provisions of 35 USC 122(c), and cannot be changed to permit the process you suggest absent a change to or elimination of the provisions of 35 USC 122. The USPTO notes that the Patent Reform Act pending before Congress (S.515) contains a provision that (if enacted) would permit the parties to submit documents with a concise description of the relevance of each submitted document to the USPTO for use in considering the patentability of the claims in a “target” application to another that has been published under the eighteen-month publication provisions of 35 USC 122(b).

## Comments

I certainly appreciate that the PTO is bound by what is mandated in 35 USC 122(c). However, I do not think that that justified refusal to transfer the applications of the two potential interferences to the same examiner. In my opinion, all that compliance with 35 USC 122(c) would require is that, upon transfer of the two applications to the same examiner, the examiner issue a paper instructing counsel for the two applicants that neither is entitled to interfere with prosecution of the other or to “protest or...[submit a] pre-issuance opposition to the grant of a patent...[to the other].”

In the article cited at the outset of this article, we quoted the following passage from the OG Notice cited in endnote 4, supra:

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 supplied.]

We then commented that:

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”! One can hear the wink from across the room.<sup>6</sup>

Similarly in this case, the PTO is apparently to be lauded if it believes, on its own initiative, that two applications interfere and accordingly assigns them to the same examiner without telling either applicant what it is doing, but there is something at least potentially nefarious about one of the applicants suggesting that the two applications be assigned to the same examiner. However, practically speaking, if counsel for the two applicants are monitoring each other’s prosecution, the possibility of one or both transgressing 35 USC 122(c) is identical regardless of whether it was the PTO sua sponte or counsel for one of the prospective interferences that initiated the process of getting the two application before the same examiner.

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<sup>3</sup> 10 Intellectual Property Today No. 11 at page \_\_\_\_.

<sup>4</sup> While the phrase “or other form of pre-issuance opposition to the grant of a patent on an application” is extremely broad, so far as I am aware it has never been suggested that it bars an applicant from suggesting an application-application interference.

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

<sup>6</sup> 10 Intellectual Property Today No. 11 at \_\_\_\_; footnote omitted.