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**PATENTS**

The authors argue that there is nothing wrong with interferences in which the interferents' effective filing dates straddle the effective date of the America Invents Act of 2011.

## Straddle Interferences



BY CHARLES L. GHOLZ AND DANIEL J. PEREIRA

The authors have found two academic articles dealing with the propriety of an interference in which one interferent is at least arguably entitled to a pre-America Invents Act of 2011 (AIA) filing date and the other or another interferent is not. One article says that there is nothing wrong with such an interference, and the other article says that there is.

In addition, the authors have found one pending interference in which the parties have been authorized to file motions which, depending on how they are decided, may result in such an interference and another pending

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*The views expressed herein are those of the authors and are not necessarily shared by their employer or its clients.*

interference which is a straddle interference as declared.

### Prof. Donald Chisum's Take on the Issue

In "Priority Among Competing Patent Applicants Under the American Invents Act," § II.A. iii.c., "Claims of Interfering Opponents; An Example" (Dec. 5, 2011), available at [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1969592](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1969592), Prof. Chisum asserts that:

"Subsection 3(n)(2) [of the AIA] dictates that the pre-trigger versions of Section 102(g), Section 135 and Section 291 apply to 'each claim' that meets the specified conditions.

"The result of the subsection may be that in a given interference, one party may rely on Section 102(g), that is, a pre-filing invention date, while the other party may not.

\* \* \*

"In the interference, [one] inventor . . . , with a post-March 15, 2013, filing date will not have the benefit of Section 102(g) and thus cannot show a pre-filing invention date. \* \* \* On the other hand, [the other] inventor can rely on Section 102(g) to prove a . . . [pre-filing invention date.]" [Footnote omitted.]

While Prof. Chisum treats the overall constitutionality of the switch from first inventor to first-inventor-to-file as an open question, he apparently sees no issue with straddle interferences under either the Constitution or the AIA.

### Blake Holt's Take on the Issue

In a student note later submitted to the U.S. Patent and Trademark Office as a comment on the office's AIA implementation, entitled "America Invents Act: Comment on First-Inventor-to-File" (March 29, 2012) pub-

lished at [https://www.uspto.gov/sites/default/files/patents/law/comments/xx\\_f-holt\\_20120329.pdf](https://www.uspto.gov/sites/default/files/patents/law/comments/xx_f-holt_20120329.pdf), Blake L. Holt saw numerous practical problems with straddle interferences. According to him, in straddle interferences, “inevitable conflicts and nonsensical results may arise . . . .” He reasoned that a straddle interference would be equivalent to the situation in which “an inventor files on [invention] X after March 16, 2013, but uses a CIP [continuation-in-part] application in order to include claims on an *unrelated* invention in order to ‘reach back’ so as to fall under the pre-AIA interference provisions. Because inventors could easily manipulate their applications to achieve this effect . . . [.] the resolution of the issues presented herein is of one [sic] of major concern.”

Mr. Holt’s major concerns appear to be that (1) under the AIA, neither interferent’s application (or patent that matured from that application) would be prior art against the other interferent’s application (or patent that matured from that application), and (2) it would be unfair to allow one interferent to rely on pre-AIA law but preclude the other from doing the same thing. Although he explicitly posits a situation in which the two interferents are independent inventors, he reasons that the necessary result is that “both filers are awarded the patent” (by which we think he means that *each* inventor is awarded a patent on the single invention, not that the two independent inventors are awarded a single patent naming both).

Mr. Holt was well aware of Prof. Chisum’s contrary view and dealt with it forthrightly (if ineffectively, in our view):

“Chisum’s view leads to problematic results. . . . Importantly, a patent application filed after the trigger date [of the AIA] with a *single claim* that can trace priority back before the trigger date would provide the applicant the ability to use an interference offensively against any other applicant on any claim whatsoever in the patent. Even more troubling is that there is no requirement in the statute that the single ‘reach back’ claim be related whatsoever to the other claims in the application. For instance, an inventor may file a post-trigger date CIP application including the original disclosure of any of the inventor’s inventions filed before the trigger date – and then include the disclosure of the new invention – with one claim supported by the original disclosure and the remaining claims supported by the new matter. Under Chisum’s view, the new Act creates [a] bizarre and surely unintended difference between post-trigger date filers who do (‘armed party’) and do not (‘unarmed party’) include a claim that can trace priority back before the trigger date. Perhaps even more bizarre, Chisum assumes that while the armed party ‘can rely on Section 102(g)’ when challenging an unarmed party, he contends that the unarmed party does ‘not have the benefit of Section 102(g)’ even after the armed party has asserted an interference. Thus the unarmed party could not assert the usual defenses of the senior filer in an interference proceeding, but would be limited solely to claims of derivation.

“Chisum’s perfunctory conclusion is not only an incorrect reading of Section 3(n)(2) [of the AIA], but like the proper reading, it produces results that are nonsensical.” [Footnotes omitted.]

We think that, by “the usual defenses of the senior filer in an interference proceeding,” Mr. Holt meant priority. Mr. Holt was apparently unaware that judgment

is entered in most interferences at the end of the first phase based on patentability issues.

## The First Real-Life Straddle Interference

The first real-life straddle interference may be *Agilent Technologies, Inc. v. Dionex Softron GMBH*, Int. No. 106,073, declared on April 17, 2017, by Administrative Patent Judge Richard E. Schafer. The facts that are relevant to this article are:

- Agilent’s tentatively accorded benefit date: June 3, 2009
- Dionex’s tentatively accorded benefit date: Jan. 7, 2009
- However, Agilent sought and was granted authorization to file a motion to deny Dionex its tentatively accorded benefit date. Dionex’s “fall back date” (i.e., the date to which it will be automatically entitled if it loses the benefit it was initially tentatively accorded) is the Aug. 17, 2014, filing date of its application in interference.
- Dionex did not seek authorization to file a motion to deny Agilent its tentatively accorded benefit date. However, Dionex did seek and was granted authorization to file a motion for the benefit of the Jan. 25, 2008, filing date of a German application which had not been referenced in the declaration of the interference.
- Agilent sought and was granted authorization to file other motions.
- Dionex sought authorization to file other motions, but authorization to file those other motions was denied.
- Agilent filed its authorized motion to deny Dionex its accorded benefit date, as well as its other authorized motions.
- Dionex filed its authorized motion for the benefit of the filing date of its German application.
- Dionex opposed Agilent’s motion to deny it its tentatively accorded benefit date without making an issue of the fact that, (1) if Agilent’s motion to deny Dionex the benefit of its originally tentatively accorded benefit date is granted, and (2) if Dionex’s motion to be accorded the benefit of its German application is denied, the interference will become a straddle interference.
- Agilent opposed Dionex’s motion for the benefit of the filing date of its German application, also without making an issue of the fact that that this may become the first straddle interference.

Neither party suggested that, if the interference becomes a straddle interference, there is any reason why the panel should not go ahead and decide the other pending motions.

Finally, and perhaps most tellingly, Judge Schafer did not avail himself of the labor-saving stratagem adopted by APJ Sally Gardner Lane in *Fenniri v. Webster*, Int. No. 106,085. The order setting the motion times in that interference contains the following passage:

“This interference is based on an inventorship dispute. USPTO records indicate that Webster filed its involved application prior to Fenniri filing its involved application. Webster has been designated senior party.

“Each party has proposed to file a number of motions. However, in the interest of securing the just, speedy, and inexpensive resolution of the interference, we proceed directly to the inventorship issue. *See* Bd. R. 1(b). Resolution of this issue is likely to determine who will prevail in the interference. In particular[,] if junior party Fenniri cannot show that the Webster inventorship is incorrect[,] then it cannot prevail in the interference. If a decision on the inventorship issue does not resolve the interference[,] then each party may renew its requests to file the motions on the lists that are not authorized below.”

If Judge Schafer had agreed with Mr. Holt’s analysis (i.e., if he had believed that deciding a straddle interference was for any reason improper), he could have similarly proceeded directly to resolution of the two benefit motions, noting that, if the decisions on those motions did not resolve the interference, each party could renew its requests to file the other motions on its list.

## The Second Real-Life Straddle Interference

*Sauer v. Taylor*, Int. No. 106,093, declared on Jan. 18, 2018, by APJ Lane, is a straddle interference as declared. The facts relevant to this article are:

- Sauer’s tentatively accorded benefit date: June 16, 2014.
- Taylor’s tentatively accorded benefit date: Aug. 12, 2010.
- Judge Lane’s declaration of the interference contains the following passage:

“In this interference the primary issue before the Board appears to involve an inventorship dispute.

Thus it is likely that the Board will proceed directly to resolving issues related to this dispute. The parties should be prepared to explain why any additional motions, if listed, would be necessary to resolving the inventorship dispute.”

Judge Lane’s declaration of the interference makes no mention of the fact that the interference, as declared, is a straddle interference.

The parties have not yet filed their lists of proposed motions, so we observers cannot tell whether either party will attempt to rely on Mr. Holt’s logic to make an issue of that fact.

## Comments

(1) Now we add two perhaps crucial facts. Judge Schafer retired on Dec. 31, 2017, and *Agilent Technologies, Inc. v. Dionex Softron GmbH* was transferred to Judge Lane. Will she consider herself bound by what Judge Schafer did and/or did not do prior to his retirement? That seems unlikely to us.

(2) Finally, no matter what the panel of Article I APJs does, the panel of Article III judges that gets this interesting interference on appeal will not be bound by either what the Article I judges said and did or by the apparent desire of the parties to get the other issues decided in this interference. On the latter point, see *Xitronix Corp. v. KLA-Tencor Corp.*, No. 2016-2746, 2018 BL 44542 (Fed. Cir. Feb. 9, 2018) (transferring the appeal to the otherwise applicable regional circuit court in the face of the desire expressed by both parties to get the patent fraud issues in a *Walker Process* antitrust case decided by the Federal Circuit).