Training Module for Chapter 23 of the MPEP

(Revised August 16, 2018)

Summary

Chapter 23: Interference Proceedings

Note: All Interference proceedings have been eliminated for patent applications covered by the AIA's First-Inventor-to-File provision. So, the materials covered in Chapter 23 are applicable only to Pre-AIA.

Specifically, an interference proceeding is to determine which party is entitled to an invention that they both claim. Post-AIA, the resolution is simple, the prevailing party is the first-inventor-to-file.

Section 3201 – Introduction

- An interference may be suggested by an applicant or independently initiated by the USPTO.

  NOTE: The patentee cannot suggest an interference for someone else's patent application – but may alert the examiner of an application claiming interfering subject matter.

- An interference is a proceeding before the Board of Patent Appeals and Interferences (the "Board") to determine priority of invention. That is, which party first invented the commonly claimed invention.

- An interference begins when either (1) an applicant "suggests" an interference or (2) the examiner requires the applicant to provoke an interference by adding a claim that will conflict with another's patent

or application.

- Once a patent or application becomes involved in an interference, the Board has jurisdiction over the matter. [The examiner may not act except as the Board authorizes.]

- The priority of invention is determined by the following two rules:

  (1) The first to conceive ***and*** reduce to practice the invention always wins.

  (2) The first to conceive and the last to reduce to practice wins only if he worked on the invention with reasonable diligence from the date just prior to the other party's conception to the date of his own reduction to practice.

- During the interference, the party who first files a patent application covering the invention is called the "senior" party, while all other applicants are called "junior" parties.

  NOTE: Reduction to practice can be either "constructive" or "actual" and the act of filing a patent application is considered a "constructive" reduction to practice. THUS, ONCE AN APPLIANT HAS FILED AN APPLICATION COVERING AN INVENTION HE HAS BOTH ***CONCEIVED*** AND ***REDUCED IT TO PARCTICE.***

- So, a guy who conceives of an invention but has not yet reduced it to practice could loose his rights if he tells someone else who then rushes off to file a patent application for the invention. However, the inventor could prevail if he can show that the other guy did not conceive of the invention.

Section 2304.02 – Applicant Suggestion|

- When an applicant suggests an interference, the examiner only reviews the suggestion for formal sufficiency. If the requirements have been met, the matter proceeds to the Board for a

determination of priority.

- An applicant's suggestion for an interference must:

  (1) Provide information to identify the application or patent with which the applicant seeks an interference.
  (2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to the one or more counts.
  (3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere.
  (4) Explain in detail while the applicant will prevail on priority.
  (5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification.
  (6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering matter.

Section 2304.03 – Patentee Suggestion

- A patentee cannot suggest an interference but may alert the examiner of an application claiming interfering subject matter.

- But, the patentee can alert the examiner through a third-party submission (Rule 99) or a protest (Rule 291).

- In a perfect world, the examiner would uncover the issued patent during his examination of the application. However, this is not always the case.

Section 2304.04 – Examiner Suggestion

- The final way an interference may be initiated is by the examiner.

- The examiner may require an applicant to provoke an interference by adding a claim that will conflict with another application or patent. This usually occurs when the examiner realizes that another application he/she is examining is directed towards the invention or an obvious variation thereof. (Generally, the filing dates of the applications are within 6 months for a proper interference.) For dates outside of 6 months, the examiner may issue a provisional Section 102(e) rejection of claims in the application with the later filing date [with the earlier application serving as prior art.]

Selected Questions and Answers for Chapter 23

Question 23-1 Pre-AIA Question

Brian and Kevin conceived of an identical system for shuffling and automatically dealing playing cards. Kevin conceived of the system on January 15th while Brian conceived of the system one month later. On January 30th, Kevin actually reduced the system to practice. Brian filed a patent application covering the system on February 1st while Kevin waited until December 1st to file a patent application covering the invention. Who is entitled to priority?

****

ANSWER: Kevin. Don't be fooled by the facts. Kevin was first to conceive of the invention and first to reduce the invention to practice. Thus, he automatically wins priority according to Rule 1 above. Kevin's delay in filing a patent application is of no consequence. Remember that there are two types of reduction to practice, actual and constructive. In this question, Kevin actually reduced the invention to practice, which requires a physical embodiment that works for its intended purpose. Brian was the first to constructively reduce the invention to practice because he filed a patent application covering the invention before Kevin.

[**Doug's Comment:** The above answer to the question was correct Pre-AIA. However, with the AIA provision of First-Inventor-to-File, Brian would get the patent.]

In-Depth Review of Chapter 23

Chapter 23 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with

the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are highlighted in yellow.

Chapter 23, MPEP