Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

KRAMER AND FISHER, JUNIOR PARTY PETITIONERS
v.
BALLARD, SENIOR PARTY RESPONDENT
Interference No. 101,884
February 6, 1989

Attorney for Petitioners

Anthony S. Volpe

Attorney for Respondent

Donald J. Bobak

Donald J. Quigg

Commissioner of Patents and Trademarks

DECISION ON PETITION

***1** Petitioners have filed a petition to the Commissioner pursuant to 37 CFR § 1.644(a)(1).

Proceedings on Petition

In this case, petitioners filed the petition and respondent opposed on the merits. A panel of the board thereafter entered an order which states:

On December 30, 1988, Kramer et al. filed a Petition (Paper No. 60) to the Commissioner and a request (Paper No. 63) for certification. On January 13, 1989, Kramer et al. filed a supplemental petition (Paper No. 66). Ballard has filed an opposition to the petition.

For the reasons stated therein and in the absence of an opposition, the request for certification is granted.

Section 1.644(a)(1) requires an examiner-in-chief or a panel of the board to reach two conclusions before a petition may be certified to the Commissioner. First, the examiner-in-chief or panel must be of the opinion that the petition raises a controlling question of procedure or an interpretation of a rule as to which there is a substantial ground for a difference of opinion. Second, the examiner-in-chief or panel must be of the opinion that an immediate decision on petition may materially advance the ultimate termination of the interference.

These two "opinions" are necessary to prevent "interlocutory" petitions to the Commissioner thus disrupting the orderly prosecution

of the interference. Compare 37 CFR § 1.644(a)(2), which permits a petition only after entry of a final decision in the interference. The notice of final rule makes clear that the standard under § 1.644(a)(1) is the same as that under 28 U.S.C. § 1292(b). 49 Fed.Reg. 48416, 48425 col. 3 (Dec. 12, 1984). In this case, the order of the board certifying the questions expresses no opinion on either point required by § 1.644(a)(1). The mere fact that a "respondent" does not oppose a petition is not per se a reason for certifying a question raised in a petition. It will be assumed that the panel believes the requirements of § 1.644(a)(1) are present in this case. [FN1]

When a petition is certified by an examiner-in-chief or the board, the Commissioner will initially decide whether to decide the certified questions on the merits or defer a decision until after a final decision is rendered by the board. In this case, the questions certified, particularly Question No. 1, raise issues which ought to be resolved at this point in the interference. In view of the above, the "certification" is accepted and the petition is granted to the extent that the two questions will be considered on the merits.

QUESTION NO. 1

A. Background

***2** This interference involves:

(1) an application which names petitioners Kramer and Fisher as joint inventors and

(2) a patent which names respondent Ballard as sole inventor.

Petitioners timely filed a "preliminary motion" under 37 CFR § 1.633(a) contending that the respondent's claims corresponding to the count are not patentable to respondent. The specific ground of unpatentability alleged, while unusual, is not without precedent. In particular, petitioners Kramer and Fisher contend that respondent Ballard is not the inventor of the subject matter claimed in the Ballard patent. Rather petitioners contend that the subject matter was jointly invented by petitioners Kramer and Fisher and respondent Ballard. [FN2]

The examiner-in-chief dismissed the preliminary motion. Petitioners then sought reconsideration by a panel of the board. In its opinion in support of a decision denying reconsideration, the panel states in relevant part:

[T]he request [for reconsideration] states that the [preliminary] motion challenged the patentability of the senior party's claims on the basis of non-inventorship, i.e., that Ballard is not the inventor, but is, at most, a joint inventor with the junior party. The request [for reconsideration] contends that the question of non-inventorship is a "distinctly different issue from priority of invention and/or derivation" and that the dismissal of the motion as being proscribed by 37 CFR 1.633(a) is in error. The request states that patents have been held invalid under 35 U.S.C. 102(f) ...

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In our view, the [preliminary] motion insofar as it raises the issue of "non-inventorship" was properly dismissed as not complying with 37 CFR 1.633(a). Clearly, the motion raises an issue of priority because nowhere does the motion contend that a third person other than Kramer, Fisher (Kramer's co-inventor) or Ballard is the inventor of the Ballard patent. Even if the inventive entity of the Ballard patent were incorrect as alleged, Ballard would be permitted to correct the inventorship under the provisions of 35 U.S.C. 116, which are to be given a liberal construction in favor of applicants....

B. The question certified

Petitioners state that the question which should be certified to the Commissioner is:

Is a preliminary motion challenging the inventorship of the Senior Party's patent claims proper under 37 CFR § 1.633(a) where the Junior Party asserts that the Senior Party is at most a joint inventor with the Junior Party and the third party jointinventive entity is not a party to the interference?

The question presented would be more properly phrased as follows:

Does 37 CFR § 1.633(a) authorize a junior party to move for judgment on the ground that the claims of the senior party are unpatentable under 35 U.S.C. § 102(f) because the invention defined by the senior party's claims corresponding to the count is the joint invention of the junior and senior party?

***3** The question is answered in the affirmative. Accordingly, the decision of the panel to the contrary is set aside [FN3] and the matter will be remanded to the examiner-in-chief for further proceedings consistent with the views expressed in this opinion.

C. Discussion

Section 1.633(a) authorizes the filing of a preliminary motion for judgment based on patentability. There are two exceptions stated in the rule. First, the preliminary motion cannot be based on "priority." 37 CFR § 1.633(a)(1). This simply means that a party cannot establish priority through a § 1.633 motion. Second, a preliminary motion cannot be based on "derivation." [FN4]

Neither exception precludes a preliminary motion for judgment on the ground that the inventive entity named in a patent or application "did not ... invent the subject matter sought to be patented...." 35 U.S.C. § 102(f); Chisum, Patents, § 2.03 n. 1 and § 2.03[1] n. 1 (1988).

The issue presented in petitioners' preliminary motion is not one of priority. Bloom v. Furczyk, 144 USPQ 678, 1965 Dec.Comm'r Pat. 81 (Bd.Int.1955). Bloom involved two applications:

(1) the junior party's application named Bloom and Hovis as joint inventors and

(2) the senior party's application named Furczyk and Henwood as joint inventors.

Upon consideration of all the evidence, the Board of Patent Interferences found that the junior party had failed to establish priority. Accordingly, it entered an award of priority in favor of the senior party. [FN5] However, the award of priority did not end the matter. Based on its assessment of the evidence, the Board of Patent Interferences concluded that the invention defined by the count was the joint invention of Bloom, Hovis, Furczyk, and Henwood. This conclusion, however, could not support an "award of priority" against the senior party. Rather, the Board of Patent Interferences made a recommendation to the Commissioner "that claims corresponding to the counts be rejected in the application of ... Furczyk and ... Henwood on the ground of nonjoinder of co- inventors...." 144 USPQ at 686, 1965 Dec.Comm'r Pat. at 94. [FN6]

The rejection which the Board of Patent Interferences recommended [FN7] in Bloom involves the same issue of "patentability" which petitioners' preliminary motion sought to raise in this case. [FN8] The preliminary motion did not contend that petitioners Kramer and Fisher "made" the invention prior to respondent Ballard. Rather, it contended that an inventive entity (e.g., Kramer, Fisher, and Ballard) not named in any application or patent involved in the interference made the invention. If the allegations in the preliminary motion are ultimately proved and correction of inventorship cannot be achieved, judgment would be entered against both parties based on unpatentability--not priority.

***4** An important aspect of the "new" interference rules was to insure that all issues would be raised at an earlier stage during the interference. As noted in the notice issuing the final rules,:

the issues which will be raised and decided by the Board at final hearing are made known during the interlocutory stage through:

(a) The preliminary statement,

(b) motions under § 1.633 and decisions thereon, and

(c) notices under § 1.632 of a party's intent to argue abandonment.

49 Fed.Reg. at 48439, paragraph bridging cols. 1-2. The board's decision does not explain how the issue petitioners are attempting to raise with their § 1.633(a) preliminary motion would be raised in the interference. As noted above, Bloom demonstrates that the issue can arise in an interference and that the issue does not involve "priority."

The board correctly observed that the law provides a means for correcting improperly named inventive entities. See 35 U.S.C. § 116, third paragraph, as to applications, and 35 U.S.C. § 256, first paragraph, as to patents. Moreover, the board correctly observed that correction of inadvertent misnaming of inventors should be liberally granted. Patterson v. Hauck, 341 F.2d 131, 144 USPQ 481 (CCPA 1965). However, at this point the board's statement that "Ballard would be permitted to correct the inventorship" is manifestly premature.

Petitioners are entitled to a ruling on the merits of their preliminary motion. Petitioners and respondent are entitled to attempt to correct inventorship if they can comply with the statutory provisions. [FN9] The examiner-in-chief in the first instance, and the

board at final hearing, are empowered to consider both the motion and any attempt to correct inventorship. On the other hand, if the evidence shows that there was deceptive intent on the part of the parties in misnaming inventors, it may enter judgment against both parties.

QUESTION NO. 2

Question No. 2, simply put, is whether a party is entitled to file a "reply" to an "opposition" [FN10] to a "request for reconsideration" filed pursuant to 37 CFR § 1.640(c). The answer in equally simple terms is "no." Accordingly, the examiner-in-chief correctly refused to enter petitioners' reply and properly returned the reply to petitioners.

Petitioners rely on 37 CFR § 1.638(b), which provides for a reply to an opposition to a motion. Section 1.638(b), however, does not authorize a reply to an opposition to a request for reconsideration. Rather, it only authorizes a reply to an opposition to a motion. 49 Fed. Reg. at 48425, col. 1, first full paragraph and 48442, col. 3, second full paragraph. The word "opposition" in § 1.638(b) is limited to the "opposition" mentioned in § 1.638(a). The term "motion" in § 1.638(a), however, does not include the "request for reconsideration" mentioned in § 1.640(c).

Additional Matter

***5** Petitioners have filed a "second reply" in these proceedings which warrants discussion. The "second reply" is in response to respondent's opposition to the petition and is styled RULE 638(b) REPLY TO THE OPPOSITION OF SENIOR PARTY TO JUNIOR PARTY'S PETITION TO THE COMMISSIONER PURSUANT TO 37 CFR § 1.644 (received by the board on January 23, 1989).

Section 1.644 provides for a petition. It also provides for an opposition. It does not authorize any "reply." Petitioners' reliance on § 1.638(b) for filing the "second reply" is misplaced. The word "opposition" in § 1.638 does not refer to an opposition filed under § 1.644(b), last sentence. Accordingly, the "second reply" to the opposition to the petition will be returned as an unauthorized paper. 37 CFR § 1.618.

Decision

Question No. 1 is answered in the affirmative.

Question No. 2 is answered in the negative.

The petition is granted-in-part.

FN1. Nothing in § 1.644(a)(1) or any other rule precludes an examiner-in- chief or a panel from certifying, sua sponte, at any time during an

interference, and without a petition by a party, any question which the examiner-in-chief or the panel believes should be determined by the Commissioner.

FN2. Petitioners' preliminary motion would appear to concede that the proper inventors are not named in the Kramer and Fisher application involved in the interference. This fact does not render petitioners' preliminary motion improper. See Collins, Current Patent Interference Practice, § 2.6[a], p. 29 (1987) (a motion for judgment under § 1.633 on the grounds of unpatentability could be made with respect to all parties, including the moving party). See also Lamont v. Berguer, 7 USPQ 2d 1580 (Bd.Pat.App. & Int.1988).

FN3. The "decision" being set aside is found in that part of the board's opinion which appears in Section II of Paper No. 58, pp. 2-3 (Bd.Pat.App. & Int. Dec. 15, 1988).

FN4. In view of recent notices, there is a third ground which cannot be raised with a preliminary motion under § 1.633(a), viz., "fraud" and "inequitable conduct." See Commissioner's Notice of Sept. 8, 1988, Patent and Trademark Office Implementation of 37 CFR 1.56, reprinted in 1095 Off.Gaz.Pat.Office 16 (Oct. 11, 1988) and Commissioner's Notice of October 17, 1988, Further Clarification on Patent and Trademark Office Implementation of 37 CFR 1.56, reprinted in 1096 Off.Gaz.Pat.Office 19 (Nov. 8, 1988).

FN5. The "award of priority" was in reality a final decision by the Patent Office that the junior party was not entitled to a patent containing any claim corresponding to the count.

FN6. Bloom should be distinguished from Linkow v. Linkow and Edelman, 517 F.2d 1165, 186 USPQ 223 (CCPA 1975). In Linkow the issue was whether the invention defined by the count was the sole invention of senior party inventive entity Linkow or junior party inventive entity Linkow and Edelman. In Bloom, no application involved in the interference named the proper inventive entity. If petitioners' preliminary motion is correct, the same is true in this interference.

FN7. Sheffner v. Gallo, 515 F.2d 1169, 185 USPQ 726 (CCPA 1975), establishes that the Board of Interferences acted properly in making a recommendation and not awarding priority against Furczyk.

FN8. In this case it would not be necessary for the board to make a recommendation under 37 CFR 1.659. Since the "new" interference rules permit the board to consider issues of patentability, the "new" rules eliminate the need for the board to make the kind of recommendation which the Board of Patent Interferences was required to make in Bloom under the "old" rules.

FN9. See also 37 CFR § 1.48(a) and 37 CFR § 1.324.

FN10. An opposition to a request for reconsideration cannot be filed as a matter of course. It may be filed only if an examiner-in-chief of the board requests an opposition. In this case, the board requested an opposition.

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