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

ORIKASA ET AL., PETITIONERS
v.
OONISHI ET AL., RESPONDENTS
Interference No. 101,617
January 18, 1989

Donald J. Quigg

Commissioner of Patents and Trademarks

DECISION ON PETITION

***1** Orikasa et al. (Orikasa--hereinafter "Junior Party") have filed a "PETITION UNDER 37 CFR 1.644(a)(2) or (3)" seeking review of a decision redeclaring Interference No. 101,617. Oonishi et al. (Oonishi--hereinafter the "Senior Party") have not filed a response.

Timeliness of petition

The Junior Party seeks to invoke the supervisory authority of the Commissioner to review a decision redeclaring an interference. 37 CFR § 1.644(a)(2). Alternatively, the Junior Party seeks relief under 37 CFR § § 1.183 and 1.644(a)(3), although it is not clear from the petition which rule the Junior Party wants waived.

A petition in an interference seeking to invoke the supervisory authority of the Commissioner is properly filed only after entry of a final decision by the board. The Junior Party's petition was filed on November 30, 1988, after entry of the board's final decision entered August 29, 1988. The rules also provide, however, that any petition filed more than fifteen (15) days after entry of the decision sought to be reviewed may be dismissed as untimely. 37 CFR § 1.644(b). The period for filing a response to a petition is also fifteen (15) days. Id. The purpose of the two 15-day periods is to permit a petition to be filed, responded to, and decided prior to expiration of the 60-day period for seeking judicial review. 35 U.S.C. § 142; 37 CFR § 1.304(a). If a petition cannot be decided within the 60-day period, an extension of time to seek judicial review may be granted by the Commissioner, sua sponte or on request of a party.

In this case, the petition was filed after a notice of appeal had been filed to the U.S. Court of Appeals for the Federal Circuit. A review of the petition, in light of the application and interference files, demonstrated that some relief might well be appropriate in this particular case. Accordingly, in the interest of conserving judicial resources, the Commissioner filed a motion to intervene in the Federal Circuit. The Commissioner also moved to vacate the August 29, 1988, decision of the board and to remand the matter to the Patent and Trademark Office for such action as might be appropriate. The Federal Circuit granted both motions. Orikasa v. Oonishi, No. 89-1105 (Fed.Cir.

Jan. 4, 1989).

In this case, the 15-day period for filing a petition will be excused in view of the unique interference record, the fact that this is one of the first petitions under 37 CFR § 1.644(a)(2), and for the purpose of conserving judicial resources. Parties in interferences are advised, however, that in the future, the 15-day periods of 37 CFR § 1.644(b) will be strictly enforced and untimely filed petitions may be dismissed.

Background

***2** This is an interference between two pending applications. Both parties rely exclusively on the filing dates of their respective Japanese applications. 35 U.S.C. § 119.

At the time the interference was declared, the Senior Party's application contained four claims which the examiner found allowable--subject to resolution of the interference. Claims 1 and 2 are directed to a copolymer. Claims 3 and 4 are directed to a method of making a copolymer. Claims 1 and 3 are representative and read as follows:

Senior Party's Claim 1:

An ethylene copolymer for use as electrical insulation derived from ethylene and an ethylenically a,B-unsaturated acid halogenated phenyl ester represented by the formula (1):

TABULAR OR GRAPHIC MATERIAL SET FORTH ATTHIS POINT IS NOT DISPLAYABLE (wherein R is hydrogen or a methyl group, X is fluorine, chlorine, bromine, or iodine, Y is an alkyl group having 4 to 18 carbon atoms, n is 0 or 1, m is an integer of 1 to 5, and L is 0 or an integer of 1 to 4), wherein the halogenated phenyl ester group unit content is about 0.005 to about 10 mol%.

Senior Party's Claim 3:

A process for producing an ethylene copolymer which comprises copolymerizing ethylene and about 0.005 to about 10 mol% (based on the total amount) of an ethylenically a,B-unsaturated acid halogenated phenyl ester at a temperature of about 120 <<degrees>> C. or more and a pressure of about 500 kg/cm2 or more by the use of a free radical group releasing initiator.

It should be noted that the ethylenically a,B-unsaturated monomer is defined broader in method claim 3. The definition in claim 3 would appear to be broader than the description of the process in the Senior Party's specification. Page 4, lines 14-19 of the Senior Party's specification states:

"In another embodiment, the present invention relates to a process for producing an ethylene copolymer which comprises copolymerizing ethylene and about 0.005 to about 10 mol% ... of an ethylenically a,B-unsaturated acid halogenated phenyl ester of the formula (1)...."

Formula (1) is the formula in the Senior Party's claim 1. Whether the subject matter of the Senior Party's claim 3 is "described" [FN1] in the specification is a matter which the parties may raise inter partes with a preliminary motion [FN2] or the examiner can re-evaluate after the interference is concluded.

The Junior Party's application contains fifteen (15) claims. The precise subject matter sought to be covered by claims 1-14 is not entirely clear. Claims 2-14 depend from "independent" claim 1, which reads:

Junior Party's Claim 1: [FN3]

A method for improving impulse destructive strength of an electrical insulating material which is characterized by employing, as said electrical insulating material, an ethylene copolymer prepared by subjecting, to a high- pressure radical polymerization, ethylene or a mixture of ethylene and another monomer in the presence of at least one compound selected from the group consisting of one-to three-ring aromatic compounds (except styrene and substituted styrenes each having a single ring) each having one carbon-carbon double bond in one molecule, at a polymerization pressure of 500 to 4,000 kg/cm 2 at a polymerization temperature of 50 to 400 <<degrees>> C., with said ethylene copolymer containing 0.005 to 1 mol% of a unit derived from said aromatic compound as a polymeric component.

***3** The Junior Party's dependent claims 2, 13, and 14 read as follows:

Junior Party's Claim 2:

A method according to Claim 1 wherein said aromatic compound is an aromatic hydrocarbon. [FN4]

Junior Party's Claim 13:

A method according to claim 1 wherein said aromatic compound is selected from the group consisting of:

allyl benzene,
phenylbutene,
benzyl methacrylate,
benzylacrylate,
indene,
beta-methyl styrene,
phenylcyclohexene,
methoxybeta-methyl styrene,
chlorophenyl cyclohexene and
phenylvinyl ether.

Junior Party Claim 14:

A method according to claim 1 wherein said aromatic compound is selected from the group consisting of

allylbiphenyl,

diphenylethylene,
phenyl styrylethane,
diphenyl methylpentene,
phenylbenzyl methacrylate,
phenylbenzylacrylate,
isopropenyl biphenyl,
vinyl naphthalene,
phenylisopropenyl phenylmethane and
vinylanthracene.

The breadth of the "copolymer" of the Junior Party's claim 1 is broader than the corresponding scope of the "copolymer" of the Senior Party's claim 1. The Junior Party's specification reveals that the copolymer can be a copolymer of ethylene and any number of a,B-ethylenically unsaturated monomers, including those specified in the Junior Party's claims 13 and 14.

The Junior Party's claims 1-14 stand rejected under 35 U.S.C. § 103 as unpatentable over U.S. patents to Schrott [FN5] and Vollkommer. [FN6] While it is not the purpose of this opinion to review any rejection of claims 1-14, it will be noted that Schrott describes copolymers of ethylene and olefins having the formula:

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where:

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is a phenyl radical containing up to 5 halogen atoms and
-(alkylene)-
is a hydrocarbon radical having 1-16 carbon atoms. See generally, col. 2, lines 18-38 and col. 3, 55-57. Thus, Schrott provides a colorable basis for the examiner's present view that some of the subject matter claimed by the Junior Party may not be patentable. Nevertheless, in view of the examiner's conclusion that the Junior Party's claim 15 defines patentable subject matter, it is also apparent that at least the Junior Party's claims 1 and 3-12 include, i.e., "read on," some subject matter which is patentable under 35 U.S.C. § § 102 and 103, even if they may also include subject matter which may not be patentable.

In order to set up an interference, the examiner gave the Junior Party an opportunity to copy a claim to a copolymer. Claim 15 was timely presented by the Junior Party and reads:

Junior Party Claim 15:

An ethylene copolymer for use as electrical insulation derived from ethylene and an ethylenically a,B-unsaturated acid halogenated phenyl ester represented by the formula:

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wherein R is hydrogen or a methyl group, wherein the halogenated phenyl ester group unit content is about 0.005 to 1 mole percent.

***4** Following presentation of the Junior Party's claim 15, the examiner completed Form PTO-850, an "Interference--Initial Memorandum"

used for forwarding cases to the board for declaration of an interference under the "new" rules, viz., 37 CFR § 1.601 et seq. The Form PTO-850, as completed by the examiner, specifies that there should be one count. The examiner designated claims 1-4 of the Senior Party and claim 15 of the Junior Party to correspond to the count. The count was to be based essentially on the Senior Party's claim 1. The examiner indicated on Form PTO-850 that the Junior Party's claims 1-14 were not to correspond to the count.

When Form PTO-850 reached the board, a change was made to designate the Junior Party's claims 1-15 to correspond to the count. Consultation with the examiner in the course of deciding this petition, reveals that the examiner did not make the change.

On July 25, 1986, an interference was declared with a single count. Count 1 reads:

An ethylene copolymer for use as electrical insulation derived from ethylene and an ethylenically a,B-unsaturated acid halogenated phenyl ester represented by the formula (1):

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(wherein R is hydrogen or a methyl group, X is fluorine, chlorine, bromine, or iodine, Y is an alkyl group having 4 to 18 carbon atoms, n is 0 or 1, m is an integer of 1 to 5, and L is 0 or an integer of 1 to 4), wherein the halogenated phenyl ester group unit content is about 0.005 to about 10 mol%.

The Junior Party's claims 1-15 and the Senior Party's claims 1-4 were designated by the examiner-in-chief to correspond to the count.

During the interference, the Junior Party filed a motion to redefine the interference. Specifically, the Junior Party sought entry of an order seeking to designate the Junior Party's claims 2, 13, and 14 as not corresponding to the count. Such a motion is authorized by 37 CFR § 1.633(c)(4). See also 37 CFR § 1.637(c)(4). The Junior Party pointed out that the count was directed to copolymers made from ethylene and a monomer having an ester group, i.e.,

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and a halogen group, i.e., fluoro (-F), chloro (-Cl), bromo (-Br), or iodo (-I). Based on this difference between the subject matter of the Junior Party's claim 2 and the count, it was argued that the subject matter of claim 2 was not the same patentable invention as that defined by the count (sic--the other claims corresponding to the count). See 37 CFR § 1.601(n).

With respect to the Junior Party's claim 13, it was argued that copolymer of ethylene and the monomers recited in the Markush group of claim 13 would not constitute the same patentable invention as the copolymer of the count. While the Junior Party conceded that two monomers were "esters," [FN7] it argued that neither is halogenated. The Junior Party also conceded that one monomer was halogenated, [FN8] but argued that it was not an "ester." Similar arguments were made with respect to the monomers listed in the Markush group of the Junior Party's claim 14. The Junior Party also argued that:

***5** (a) none of the subject matter of claims 2, 13, or 14: (i) overlapped the subject matter of the count [FN9] or

(ii) was described in the Senior Party's application and
(b) the Senior Party's application "will not be prior art to ... [the Junior Party] as to any non-overlapping subject matter ... [in view of] In re McKellin, [529 F.2d 1324,] 188 USPQ 428 (CCPA 1976)." [FN10]

The Senior Party did not oppose the motion.

The examiner-in-chief denied the Junior Party's motion to redefine the interference. The examiner-in-chief indicated that the examiner had determined that claims 1-4 of the Senior Party interfered with claims 1-15 of the Junior Party. [FN11] Based on this fact, the examiner-in-chief held that there is a presumption that the parties are claiming the same patentable invention, i.e., that an interference-in-fact exists. See Case v. CPC Int'l Inc., 730 F.2d 745, 750, 221 USPQ 196, 200 [headnote 9] (Fed.Cir.), cert. denied, 469 U.S. 872 (1984). The examiner-in-chief, citing 37 CFR § 1.637(c)(4)(ii), also noted that the Junior Party had presented no evidence to establish that the invention defined by the Junior Party's claims 2, 13, and 14 was patentably distinct from the other claims of both parties corresponding to the count. [FN12]

The Junior Party did not allege a date of invention prior to the effective date of the Senior Party. Accordingly, the examiner-in-chief issued an order to show cause why judgment should not be entered against the Junior Party. In response to the order, the Junior Party requested review of the motion decision at a final hearing. See 37 CFR § 1.640(e) and Commissioner's Notice of Dec. 8, 1986, 1074 Off.Gaz.Pat.Off. 4 (Jan. 6, 1987).

In due course, the Junior Party timely filed a brief. The Senior Party did not file a brief.

On May 18, 1988, a panel of the board entered an order holding that the interference had not been properly declared. In effect, the board held that the "issue [FN[13]] of the interference as presently formulated is not broad enough to encompass the subject matter of ... [the Junior Party's] claims 13 and 14. Count 2 was proposed to replace count 1 [indentation added]:

An ethylene copolymer for use as electrical insulation derived from ethylene and
(i) an aromatic compound selected from the group consisting of
allyl benzene,
phenylbutene,
benzyl methacrylate,
benzylacrylate,
indene,
betamethyl styrene,
phenylcyclohexene,
methoxybeta-methyl styrene,
chlorophenyl cyclohexene
phenylvinyl ether,
allylbiphenyl,
diphenylethylene,
phenyl styrylethane,
diphenyl methylpentene,

phenylbenzyl methacrylate,
phenylbenzylacrylate,
isopropenyl biphenyl,
***6** vinyl naphthalene,
phenylisopropenyl phenylmethane and
vinylanthracene or

(ii) an ethylenically alpha,beta-unsaturated acid halogenated phenyl ester represented by the formula (1):

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(wherein R is hydrogen or a methyl group, X is fluorine, chlorine, bromine, or iodine, Y is an alkyl group having 4 to 18 carbon atoms, n is 0 or 1, m is an integer of 1 to 5, and L is 0 or an integer of 1 to 4), wherein the halogenated phenyl ester group unit content is about 0.005 to about 10 mol%.

The board stated that Count 2 was specifically drawn narrow enough not to encompass the subject matter of the Junior Party's rejected claim 2. The reason given was that the Junior Party's claim 2 had been held unpatentable by the examiner.

The parties were given 30 days to state any objection to redeclaration of the interference. The Junior Party timely filed an objection. The Junior Party continued to insist that the subject matter of its claims 2, 13, and 14 was patentably distinct from the subject matter of the remaining claims of both parties involved in the interference. The Junior Party made several observations, some of which were:

1. No one, whether expert or not, has testified that species [of claims 2, 13, or 14] were patentably indistinct. There is no documentation, extensive or otherwise, in support of ... a conclusion [that the subject matter of claims 2, 13, and 14 is the same patentable invention as the remaining claims of the parties involved in the interference]. (Paper No. 21, page 2, lines 2- 24).

2. Proposed Count 2 in effect equates a halogenated ester with a halogenated non-ester. No basis for doing so is proposed. (Paper No. 21, page 3, lines 8-9).

3. Proposed Count 2 in effect equates a halogenated ester with a non- halogenated ester. No basis for doing so is advanced. (Paper No. 21, page 3, lines 10-11).

4. No reason has been proposed or evidence advanced in support of the proposition that those skilled in this art would recognize one could substitute the aromatic compound (i) of proposed Count 2 for the halogenated ester of the count in interference. The only disclosure of such a possibility is in the application of the Junior Party ... and reliance thereon is clearly improper. In re Grabiak, [769 F.2d 729,] 226 USPQ 870 (Fed.Cir.1985). (Paper No. 21, page 3, lines 12-18).

The Senior Party did not respond. On August 29, 1988, the board enteredits final decision. It found the Junior Party's arguments unpersuasive. In response to the Junior Party's arguments, the board made the following observations:

A. The primary examiner failed to cause this interference to be declared [FN14] with a count sufficiently broad so as to encompass the broadest corresponding patentable [FN15] claim of each party. (Page 2, lines 13-19).

B. When the interference was declared, all of the Junior Party's

claims as well as all of the Senior Party's claims were designated [FN16] as corresponding to count 1 and presumptively [FN17] all the parties' claims define the same patentable invention. (Page 2, line 34--page 3, line 5).

***7** C. "We merely proposed to correct a clerical [FN18] error with respect to the scope of the count." (Page 3, lines 5-6).

D. "When an examiner causes an interference to be declared [sic--forwards applications to the board for declaration of an interference], he is authorized to designate a claim under rejection as corresponding to a count as long as he deems that the claim defines the same patentable invention as the count." [FN19] (Page 3, lines 28-32).

E. "[The Junior Party] ... has the burden of establishing with sufficient evidence his contention that his claims 2, 13, and 14 do not define the same patentable invention as any other claim designated ... as corresponding to the count." (Page 5, lines 14-17).

F. "We hold that ... [the Junior Party's] claims 2, 13, and 14 define the same patentable invention as that defined by any other claim designated as corresponding to count 2." (Page 6, lines 18-20).

G. "[The Junior Party] has not submitted any evidence to show, for example, that benzyl methacrylate of his claim 13 defines a separate patentable invention from the corresponding halogenated benzyl methacrylate of ... [the Senior Party's] claim 1 or that phenylbenzyl methacrylate of his claim 14 defines a separate patentable invention from the corresponding halogenated phenylbenzyl methacrylate of ... [the Senior Party's] claim 1. (Page 7, line 29-page 8, line 3).

The board's final decision

Based on its review of the record, the board concluded that the interference should be redeclared with Count 2 and that the Junior Party's claims 1-15 and the Senior Party's claims 1-4 should be designated to correspond to the count.

The board declined to grant the Junior Party's motion to designate claims 2, 13, or 14 as not corresponding to the count--now Count 2. The board's "judgment" was that the Junior Party is not entitled to a patent containing claims 1-15 [FN20] and that the Senior Party was entitled to a patent containing claims 1-4. [FN21]

Opinion

A review of the application files and the interference file reveals several problems.

The first problem which readily surfaces in these files is the fact that Count 2 is directed to a copolymer and the claims corresponding to the count are directed to copolymers, methods of making copolymers, and arguably a use of the copolymer as insulation for an electrical conductor.

A second problem is the meaning and scope of the Junior Party's claims 1-14. Are they directed to a method or to an electrical conductor insulated with a copolymer?

A third problem is the manner in which the board in this case applied the presumption that all claims designated to correspond to a count are directed to the same patentable invention.

These problems will be discussed seriatim.

I.

Depending on the facts of any particular case, it is possible, although highly unlikely, that a method of making a material and the material are directed to the same patentable invention. Likewise, it is possible that a material and a use of the material are directed to the same patentable invention. Finally, it is possible that a method of making a material, the material, and use of the material could be the same patentable invention. More likely, however, the method of making the material, the material, and a use of the material are separate patentable inventions.

***8** In those cases where a method of making a material and the material are the same patentable invention, the count must be drawn in language to include, in the alternative, both the material and the method for making the material. For example, if the material is a copolymer of ethylene and styrene and the method is copolymerizing ethylene and styrene, then the count should read:

A copolymer of ethylene and styrene

or

A method of making a copolymer of ethylene and styrene comprising copolymerizing ethylene and styrene.

All claims of both parties directed to either the copolymer or the method of making the copolymer may then be designated to correspond to the count. The important fact is that proof of priority with respect to an embodiment within the scope of the count will suffice to establish priority of the "patentable" invention in question. Thus:

> The "count" ... is merely the vehicle for contesting priority which, in the opinion of the Commissioner, effectively circumscribes the interfering subject matter, thereby determining what evidence will be regarded as relevant on the issue of priority.

Squires v. Corbett, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977).

The same rationale applies to a material and a use of the material. Thus, if a copolymer of ethylene and styrene and an electrical conductor insulated with the copolymer are a single patentable invention, then the count should be drawn as follows:

A copolymer of ethylene and styrene

or

an electrical conductor insulated with a copolymer of ethylene and styrene.

Obviously, if the method of making the material, the material and a use of the material define a single patentable invention the count should read as follows:

A copolymer of ethylene and styrene

or

A method of making a copolymer of ethylene and styrene comprising copolymerizing ethylene and styrene

or

an electrical conductor insulated with a copolymer of ethylene and styrene.

As indicated above, it should be rare that a method of making a material and the material or the material and a method of using the material are a single patentable invention. Consultation with the examiner assigned to examine the Junior Party's and the Senior Party's applications reveals that in this case he regards the method of making the copolymer, the copolymer and the use of the copolymer as an electrical insulator to be three separate patentable inventions. Since both the Junior Party and the Senior Party disclose all three inventions, there should have been three counts in this interference.

In view of the examiner's opinion, further proceedings in this interference will be ordered.

Junior Party Orikasa is given one (1) month from the date of this decision to copy the following claims for purposes of further proceedings in the interference:

Suggested Claim 16:

A process for producing a copolymer of ethylene and an a,B-unsaturated monomer having the formula:

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***9** wherein R is hydrogen or a methyl group and wherein the halogenated phenyl ester group unit content is about 0.005 to 1 mole percent, comprising copolymerizing ethylene and the a,B-unsaturated monomer at a temperature of 50 <<degrees>> to 400 <<degrees>> C. and a pressure of 500 to 4,000 kg/cm2 in the presence of a free radical catalyst.

Suggested Claim 17:

An electrical conductor insulated with a material comprising a copolymer of ethylene and an a,B-unsaturated monomer having the formula:

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wherein R is hydrogen or a methyl group and wherein the halogenated phenyl ester group unit content is about 0.005 to 1 mole percent.

Senior Party Oonishi is given one (1) month from the date of this decision to copy the following claim for purposes of further proceedings in the interference:

Suggested Claim 5:

An electrical conductor insulated with a material comprising a copolymer of ethylene and an a,B-unsaturated monomer having the formula:

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wherein R is hydrogen or a methyl group, X is fluorine, chlorine, bromine, or iodine, Y is an alkyl group having 4 to 18 carbon atoms, n is 0 or 1, m is an integer of 1 to 5, and L is 0 or an integer of 1 to 4 and wherein the halogenated phenyl ester group unit content is about 0.005 to about 10 mol%.
Failure of a party to timely copy the suggested claims in its respective application will be considered a disclaimer by that party of the subject matter of the suggested claims under the provisions of 37 CFR § 1.605(a).

Assuming the Junior Party and the Senior Party timely copy the suggested claims, the interference shall be redeclared by substituting for Count 2 the following Counts 3, 4, and 5.

Count 3

A copolymer of ethylene and an a,B-unsaturated monomer having the formula:

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wherein:

R is hydrogen or methyl;

n is 0 or 1;

X is fluoro, chloro, bromo, or iodo;

Y is an alkyl group having 4 to 18 carbon atoms;

L is 0 or an integer of 1 to 4; and

m is 1-5; and
further wherein the a,B-unsaturated monomer unit content is about 0.005 to about 10 mole percent of the copolymer.

Count 4

A process for producing a copolymer of ethylene and an ethylenically a,B- unsaturated acid halogenated phenyl ester wherein the a,B-unsaturated ester content is about 0.005 to about 10 mole percent of the copolymer, comprising copolymerizing ethylene and the a,B-unsaturated ester at a temperature of 50 << degrees>>> C. to 400 <<degrees>> C. and a pressure of at least about 500 kg/cm 2 in the presence of a free radical catalyst.

Count 5

An electrical conductor insulated with a material comprising a copolymer of ethylene and an a,B-unsaturated monomer having the formula:

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wherein:

R is hydrogen or methyl;

n is 0 or 1;

X is fluoro, chloro, bromo, or iodo;

Y is an alkyl group having 4 to 18 carbon atoms;

L is 0 or an integer of 1 to 4; and

m is 1-5; and
further wherein the a,B-unsaturated monomer unit content is about 0.005 to about 10 mole percent of the copolymer.

***10** The claims of the parties will be designated to correspond to Counts 3, 4, and 5 as follows:

Count	Junior Party Orikasa	Senior Party Oonishi
3	15	1-2
4	16	3-4
5	3-12 and 17	5

The Junior Party's claims 2, 13, and 14 will not be designated to correspond to any count.

The examiner-in-chief is authorized to reopen proceedings by setting a new period for filing preliminary motions and to continue renewed proceedings from that point.

II.

A second problem is the meaning of the Junior Party's claims 1-14. As discussed above, it is not apparent what "method" is being claimed. To "infringe" the claims, one would have to use the copolymer as an

insulator on an electrical conductor. Such a use would necessarily include the "step" of "improving [the] impulse destructive strength" of the material used to insulate the electrical conductor. While further ex parte prosecution after the interference may clear up any ambiguity, for the purpose of further interference proceedings, the Junior Party claims 1-14 may be construed to cover an electrical conductor insulated with a copolymer. Hence, the Junior Party's claims 3-12 should be designated to correspond to Count 5.

III.

The starting point for declaring an interference is Form PTO-850 as filled out by the examiner. Thus, in the first instance, the examiner indicates the count and the claims which correspond to the count. See Manual of Patent Examining Procedure, § 2309.02 [5th Ed., Rev. 9, Sept. 1988]. Subsequent events in the interference, such as a preliminary motion, may convince an examiner-in- chief or a panel of the board that an interference was not properly declared in the first instance.

Upon reviewing the application and/or patent files involved and the Form PTO- 850, as completed by the examiner, an examiner-in-chief may have reason to believe that the count is not correct, that there are not a sufficient number of counts, or that claims have not been properly initially designated to correspond to a count. If so, the examiner-in-chief should consult with the examiner with the view to declaring the interference with proper counts and a proper designation of claims to counts. If the original Form PTO-850 submitted by the examiner has to be changed, it should be re-signed by the examiner. When the examiner and the examiner-in-chief agree that a proper Form PTO-850 has been prepared, that form becomes part of the record in the interference file.

It is important that the interference be carefully declared in the first instance. One important reason is the presumptions which attach to the declaration of an interference. Thus, when an interference is declared, there is a rebuttable presumption that:

***11** (1) different counts define separate patentable inventions;

(2) each claim designated to correspond to a count defines the same patentable invention as all other claims designated to correspond to the count; and

(3) a claim which is not designated to correspond to the count is not directed to the same patentable invention as the claims designated to correspond to the count.

These presumptions are necessary in order to give the parties a "starting point" and for establishing who has the burden of persuasion and proof when a preliminary motion is filed under 37 CFR § 1.633. Time is conserved by all involved, both parties and PTO personnel, when the interference is declared properly in the first instance.

Decision

The petition is granted to the extent indicated and the interference is remanded to the jurisdiction of the examiner-in-chief for further proceedings consistent with the views expressed in this opinion.

FN1. Compare In re DiLeone, 436 F.2d 1033, 168 USPQ 598 (CCPA 1971) (claim 11 held to be broader than written description of the invention in specification).

FN2. 37 CFR § 1.633(a)--motion for judgment on ground claim corresponding to count is not patentable.

FN3. There are two obvious problems with the language of Claim 1. First, the claim seemingly is broad enough to call for polymerizing ethylene alone. Note the language "ethylene or a mixture of ethylene and another monomer." On the other hand, the claim seemingly is limited to preparing a "copolymer." Second, it is not apparent what "method" is being claimed. In point of fact, the claim seems to call for using a copolymer as an insulating material. Thus, the claim is perhaps directed to an electrical conductor insulated with a copolymer. Any "indefiniteness" (35 U.S.C. § 112, second sentence) in the Junior Party's claims can be corrected in ex parte prosecution after the interference is concluded.

FN4. An "aromatic hydrocarbon" is a compound which contains only carbon and hydrogen atoms. Thus, an aromatic hydrocarbon cannot have an ester group or a halogen atom.

FN5. U.S. patent 3,741,947 issued June 26, 1973.

FN6. U.S. patent 4,211,730 issued July 8, 1980.

FN7. Benzyl methacrylate and benzyl acrylate.

FN8. Chlorophenyl cyclohexene.

FN9. As will appear later in this opinion, a count should be drawn broad enough to include all patentable subject matter falling within all claims designated to correspond to the count.

FN10. Arguments (a)(ii) and (b) made by the Junior Party did not--and could not--persuade either the examiner-in-chief or the board to grant the motion. There is no requirement that the subject matter claimed by one party be described in the specification of the other party. The only question is whether the subject matter claimed by one party is the

same patentable invention as the subject matter claimed by the other party. See Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977), where the subject matter claimed by the respective parties was not disclosed in the opponent's application. For this same reason, McKellin is not relevant. After the CCPA's decision in McKellin, a second interference was declared between McKellin and Maltha. McKellin won the second interference, thereby taking away from Maltha the subject matter Maltha thought he had won in the first interference. See Ex parte Tytgat, 225 USPQ 907, 911-912 (Bd.App.1985). Thus, whereas McKellin involved proceedings after an interference, here we are concerned with proceedings during an interference. One object of an interference should be to avoid a second interference, as unfortunately occurred in McKellin.

FN11. The statement by the examiner-in-chief is only partially correct. The examiner determined that an interference existed only between the subject matter of the Junior Party's claim 15 and the Senior Party's claims 1-4.

FN12. A motion to redefine an interference does not necessarily have to be supported by "evidence." Thus, 37 CFR § 1.637(c)(4)(ii) requires the moving party to "[s]how the claim [sought to be designated as not corresponding to the count] does not define the same patentable invention as any other claim designated ... as corresponding to the count." A party may be able to make a necessary showing with argument. However, where the moving party is in possession of the necessary evidence, there is no legitimate reason why it should not be presented with the motion. If the motion is not accompanied by then available proof of a material fact, no further evidence should be received in the interference in connection with the issue raised in the motion. 37 CFR § 1.639. It was not the intention of the "new" rules to permit routine requests to take testimony in lieu of presenting timely affidavits and other available proof of material facts with the motion.

FN13. The use of the word "issue" should be avoided in interference papers to mean "count." Confusion will be minimized if parties and the board use the terms defined in 37 CFR § 1.601 when possible. The term "count" is defined in the rules; the term "issue" is not.

FN14. The examiner does not declare an interference. Only an examiner-in-chief can declare an interference.

FN15. The examiner has never determined that the subject matter of the Junior Party's claims 2, 13, or 14 is patentable. In fact, claims 2, 13, and 14 stand rejected.

FN16. The examiner did not make this designation. Apparently, the designation was made by the examiner-in-chief. The basis for the examiner-in-chief's decision, contrary to the examiner, that claims 2, 13, and 14 define the same patentable invention as the rest of the parties' claims is not apparent on the record.

FN17. The initial presumption that claims designated to correspond to a count define the same patentable invention is one that rests on a decision by an examiner in the first instance. In this case, consultation at the petition level reveals that the examiner did not designate the Junior Party's claims 2, 13, or 14 to correspond to the count, because he does not regard the subject matter of those claims to define the same patentable invention as the subject matter of the Senior Party's claims 1-4 and the Junior Party's claim 15.

FN18. The "error" corrected was something more than a mere "clerical" error.

FN19. An examiner may designate a rejected claim as corresponding to a count provided:

(1) the claim covers both patentable and unpatentable subject matter;

(2) the patentable subject matter of the claim is to the same patentable invention as the count; and

(3) the unpatentable subject matter of the claim is not to the same patentable invention as the count.

The reason the rejected claim is designated as corresponding to the count is to cause cancellation of the claim in the event the party loses the interference.

FN20. The "judgment" constitutes a final agency decision that the losing party is not entitled to a patent with claims corresponding to a lost count.

FN21. This is a decision authorizing the examiner to issue a patent to the Senior Party containing claims 1-4 unless it should develop, based on additional evidence, that those claims are not patentable to the Senior Party. It should be rare, indeed, that a reason should develop after an interference for rejecting claims which the board has found patentable to the winning party in an interference.

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