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

PETRIE ET AL. [FN1] JUNIOR PARTY
v.
WELSH ET AL. [FN2] SENIOR PARTY
Patent Interference No. 102,636
September 30, 1991

For: Ureido-Containing Wet Adhesion Monomers and Latexes Derived Therefrom

***1** Application of Brian C. Petrie et al., Serial No. 07/655,272, filed February 13, 1991.

Patent granted to David A. Welsh et al. on December 30, 1986, Patent No. 4,632,957, filed September 4, 1984, Serial No. 06/646,733.

TERMATION ORDER

James V. Tura, Robert E. McDonald and Steven W. Tan for Petrie et al.

Barbara J. Park and William J. Uhl for Welsh et al.

Before Manbeck

Commissioner

Serota

Chairman

Calvert

Vice Chairman

Metz

Examiner-in-Chief

Metz

Examiner-in-Chief

FINAL ORDER TERMINATING INTERFERENCE

Introduction

The following papers are before the Board:

(1) JUNIOR PARTY'S MOTION TO TERMINATE THE INTERFERENCE FOR LACK OF STATUTORY BASIS, OR ALTERNATIVELY, FOR ENTRY OF JUDGMENT IN FAVOR OF JUNIOR PARTY, filed July 26, 1991 (Paper No. 9).

(2) BRIEF IN SUPPORT OF JUNIOR PARTY'S MOTION TO TERMINATE THE INTERFERENCE FOR LACK OF STATUTORY BASIS, OR ALTERNATIVELY, FOR ENTRY OF JUDGMENT IN FAVOR OF JUNIOR PARTY, filed July 26, 1991 (Paper No. 10).

(3) SENIOR PARTY'S RESPONSE TO JUNIOR PARTY'S MOTION TO TERMINATE THE INTERFERENCE FOR LACK OF STATUTORY BASIS OR ALTERNATELY FOR ENTRY OF JUDGMENT IN FAVOR OF JUNIOR PARTY AND SENIOR PARTY'S MOTION FOR EXAMINER-IN-CHIEF TO REJECT JUNIOR PARTY'S APPLICATION AS BEING UNPATENTABLE OVER THE PRIOR ART, filed September 3, 1991 (Paper No. 15).

Background

This interference was declared on June 27, 1991, between

(a) application, Serial No. 07/655,272, filed on February 13, 1991, naming Brian C. Petrie and Joseph G. Nasser (Petrie) as inventors and

(b) U.S. patent 4,632,957, issued to David A. Welsh and Rostylaw Dewbenko (Welsh) on December 30, 1986. The patent is based on application, Serial No. 06/646,733, filed on September 4, 1984.

The Petrie application is assigned to The Sherwin-Williams Company. The Welsh patent is assigned to PPG Industries, Inc.

Based on the respective filing dates of the parties, Petrie was designated as the junior party. At the time the interference was declared, Petrie was placed under an order to show cause why judgment should not be entered against him. The basis for the order to show cause was an Examiner-in-Chief's determination that a showing made by Petrie under 37 CFR 1.608(b) (1990) was insufficient.

Subsequent to the declaration of the interference, it came to the attention of the Board of Patent Appeals and Interferences that Welsh's patent had expired on December 30, 1990, for failure by Welsh's assignee to pay the maintenance fee required by 35 U.S.C. § 41(b)1. The parties were then asked to address the authority of the Patent and Trademark Office to continue the interference (Paper No. 8).

Opinion

I.

***2** The patent statute (35 U.S.C. § 135(a)) provides in part:

> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the

Commissioner shall give notice of such declaration to the applicants, or applicants and patentee, as the case may be. (Emphasis added) See also 37 CFR 1.601(i) (1990), which implements § 135(a) and provides for interferences only between (a) pending applications or (b) one or more pending applications and an unexpired patent.

Upon review of the facts, it is manifest that the Commissioner did not have statutory authority to declare this interference even if he was of the opinion that the Petrie application claims and the claims of Welsh's expired patent claim the same patentable invention. Since Welsh's patent had already expired when the interference was declared and § 135(a) does not authorize the declaration of an interference between a pending application and an expired patent, the Board of Patent Appeals and Interferences does not have subject matter jurisdiction to resolve priority of invention or patentability in this interference. Accordingly, the interference is hereby TERMINATED.

II.

We wish to make clear that termination of this interference without a judgment under 37 CFR 1.658(a) (1990) is based on the unique fact that the Welsh patent had expired prior to declaration of the interference. Nothing contained in this opinion should be construed as suggesting that an interference declared between a pending application and an unexpired patent will be terminated by any means other than a judgment under § 1.658(a). Nor do we reach the issue of how an interference will be resolved between an application and a patent when the patent expires for failure to pay a maintenance fee during pendency of the interference.

III.

Welsh has alternatively requested that we deny Petrie's request for judgment in favor of Petrie. Welsh's request, as well as Petrie's request for entry of judgment in his favor, is rendered moot by the termination of this interference. Further, Welsh's request is actually an attempt to oppose the grant of a patent to Petrie. It is well-settled that an individual does not have a right to intervene in the prosecution of a particular application to prevent issuance by the Patent and Trademark Office of a patent sought by another. Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1692 (Fed.Cir.1991); Godtfredsen v. Banner, 503 F.Supp. 642, 646, 207 USPQ 202, 207 (D.D.C.1980) (individual lacks standing to challenge a decision by PTO to issue a patent to another). Welsh may wish to take advantage of the "protest" provisions of 37 CFR 1.291 (1990). We express no views on the merits of Welsh's contention that Petrie's claims corresponding to the count are unpatentable over the prior art.

Decision

***3** Upon consideration of the entire file, and all arguments presented

by the parties, it is

ORDERED that Petrie's motion to terminate the interference is granted and it is

FURTHER ORDERED that the interference is terminated.

Harry F. Manbeck, Jr.

Commissioner

Saul I. Serota

Chairman

Ian A. Calvert

Vice Chairman

Andrew H. Metz

Examiner-in-Chief

FN1. Assignor to The Sherwin-Williams Co.

FN2. Assignor to PPG Industries, Inc.

Filed: Feb. 13, 1991

Harry F. Manbeck, Jr.

Commissioner of Patents and Trademarks

ORDER AUTHORIZING THIRD-PARTY PARTICIPATION IN EXAMINATION OF PATENT APPLICATION

In an order entered today, the Board of Patent Appeals and Interferences is terminating the above-identified interference. In its opinion, the Board notes that Welsh may wish to file a protest pursuant to 37 CFR 1.291.

Since the facts of this most unique case establish that there exists an extraordinary situation where justice requires waiver of a rule, it is, sua sponte,

ORDERED that the provisions of 37 CFR 1.291 are waived to the extent that they would preclude full participation by Welsh or his assignee in any protest filed by Welsh or his assignee in the Petrie application and it is

FURTHER ORDERED that if Welsh or his assignee files a protest under 37 CFR 1.291 in the Petrie application (or any continuing application filed by Petrie), Welsh and his assignee shall be permitted to fully participate in proceedings before the Primary Examiner and, in the event an appeal is taken, before the Board.

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