
Patent Interferences May Not Involve Pure AIA Patent

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The Patent Office is not supposed to issue separate patents for the same invention to competing inventors. Several statutory provisions empower the Office to reject pre-AIA patent application claims of the later inventor. But sometimes it's not clear who is the later inventor. Those provisions are therefore unhelpful. So, the Patent Trial and Appeal Board administers an increasingly rare proceeding called an "interference" to assess which inventor was the last to invent. Through this proceeding, the Office cancels as unpatentable (under pre-AIA 35 USC § 102(g)) the claims of the inventor the Board determines was last to invent.

Contested interferences, though rare, are time-consuming, complex, and expensive. For these and other reasons, Congress eliminated interferences for applications (and patents issuing therefrom) filed on or after the March 16, 2013, AIA effective date, but not for such applications effectively filed before that date. So, what is the Patent Office supposed to do when a pre-AIA application is claiming the same invention as an AIA patent? The Patent Office recently confronted this question, declared an interference, and eventually canceled over 140 claims of five AIA patents as they were presented by the later inventor. This is only part of a story that began over ten years ago.

Background

In February 2013, scientists at The Rockefeller University filed a provisional patent application describing methods of modifying bacterial genomes. A year later, they filed a non-provisional application, which WIPO published in August 2014. A later continuation application Rockefeller filed in 2016 claimed what its provisional application

earlier disclosed. Around the same time in 2016, scientists at SNIPR Technologies Limited filed a patent application claiming the same methods. SNIPR had not, however, previously filed applications on these methods.

Through the vagaries of examination and expedited-examination requests SNIPR filed, the Patent Office issued SNIPR five patents on these methods between November 2019 and March 2020. Meanwhile, Rockefeller's application was still being examined. Upon realizing this, the Rockefeller applicants—who apparently disclosed the same invention three years earlier (!)—persuaded the Board to declare an interference between their pre-AIA application and these SNIPR patents.

What did the Board do?

The Board's declaration of interference designated Rockefeller as the senior party and SNIPR as the junior party. This designation was based on the Board's assessment that Rockefeller's first application, filed in 2013, disclosed an embodiment of the interfering invention, earlier than SNIPR's first application, filed in 2016. SNIPR moved to terminate the interference, arguing that the Board lacked authority to conduct the interference and cancel its AIA patents. The Board has previously declared several interferences each involving a pure AIA patent and a pre-AIA patent application, yet refused to address this jurisdictional argument. In those interferences, the Board addressed different jurisdictional arguments.¹ But now forced to address the issue, the Board denied SNIPR's motion.

The Board reasoned that the Patent Office must examine Rockefeller's pre-AIA application for compliance with pre-AIA § 102(g), which requires an interference between Rockefeller's application claims and SNIPR's patent claims. Continuing, the Board said that once it declares an interference, pre-AIA 35 USC § 135(a) requires the Board to assess priority of invention. Here, because SNIPR alleged no invention date before the Rockefeller 2013 application's filing date, the Board entered judgment against SNIPR. The Board also dismissed (perhaps, improvidently) as moot SNIPR's motion that argued Rockefeller's applications do not describe the

claimed invention in compliance with the first paragraph of 35 USC § 112. *SNIPR Tech. Ltd. v. The Rockefeller Univ.*, No. 106,123 (PTAB Nov. 19, 2021) (Decision and Judgment). Based on the Board’s decision and judgment, the Office was poised to cancel SNIPR’s involved claims in five patents.

Rockefeller’s windfall

Consider what Rockefeller accomplished. Expending little more than the attorney fees in requesting the interference—a ministerial filing here given the parties’ wildly disparate filing dates—and later opposing SNIPR’s jurisdictional motion, Rockefeller persuaded the Board to cancel five patents, which collectively included more than 140 claims. In doing so, Rockefeller paid and owed no fees to the Patent Office for the proceeding. How so, you may ask? Well, the Office collects no fees for declaring or administering interferences. So, historically, for applicants claiming the same invention as one recited in a competitor’s patent, interferences offer a *free* opportunity not only to cancel the competitor patent but also obtain a patent. Contrast the filing fee-free interference with the filing fees Rockefeller would have incurred had it challenged the SNIPR patents in five post-grant review proceedings—fees exceeding \$300,000!

Furthermore, based on the interference declaration, the Board summarily determined the 140+ SNIPR patent claims (and Rockefeller’s fourteen application claims) to be presumptively obvious variants of the interference count. That is an exceptionally important determination unique to interferences because each party’s claims stand and fall together with the Board’s conclusion on priority. SNIPR did not meaningfully contest that aspect of the declaration (beyond unsuccessfully complaining a few claims of its patents were not obvious variants of the count). Consequently, when the Board denied SNIPR’s jurisdictional motion, the Board also concluded that the 140+ SNIPR claims were unpatentable to SNIPR because SNIPR had alleged no invention date earlier than Rockefeller’s 2013 provisional application filing date. If the filing fee-savings are not impressive enough, consider the expenses—attorney fees, expert witness fees, court reporter fees, etc.—Rockefeller would have incurred in challenging the 140+ claims over printed publication prior art (e.g., the Rockefeller 2014 published parent application) in five separate PGR proceedings.

Federal Circuit reverses

Following the Board’s judgment, Rockefeller’s application was likely to be allowed and issued, while SNIPR’s

patents were set to be cancelled. But all Board judgments are appealable. And on SNIPR’s appeal, this story took a dramatic turn. SNIPR’s basic argument on appeal was the same as before the Board. But, unlike the Board, the Federal Circuit sided with SNIPR and reversed the Board’s decision. *SNIPR Techs. Ltd. v. The Rockefeller Univ.*, Appeal 2022-1260 (Fed. Cir. July 14, 2023).

At the outset, the court stated “[t]he AIA’s effective date provision, AIA § 3(n), makes clear that interferences and other first-to-invent aspects of pre-AIA law do not apply to patents exclusively governed by the AIA and issued under the new first-inventor-to-file regime.” Slip Op. at 2. The court then explained its decision, recounting the text, purpose, and history of the AIA before concluding that SNIPR’s AIA patents cannot be subject to an interference.

- *Statutory Text:* The court noted that section 3(n) states that the AIA’s amendments to the Patent Act “shall apply” to any patents that have ever contained a claim with an effective filing date on or after the AIA’s March 16, 2013, effective date. *Id.* at 11–12. For all other patents, the pre-AIA statutory sections apply. The court acknowledged the one statutory exception which would still subject a small subset of AIA patents and applications (that claim an invention disclosed in a pre-March 16, 2013, application), a “mixed” patent or application, to interferences. In doing so, the court explained that this single exception was “strong evidence that Congress did not wish to further open the interference door to pure AIA patents and applications,” such as SNIPR’s patents. *Id.* at 13.
- *Statutory Purpose and History:* “Congress,” the court said, “was dead set on eradicating interferences for new applications, criticizing [interferences] as lengthy, expensive, and requiring companies to maintain extensive documentation and systems to prove the date of their inventions.” That purpose and history, the court concluded, “further supports” the court’s reading of section 3(n) as prohibiting the Office from administering interferences involving pure AIA patents, like SNIPR’s. *Id.* at 14.

Whereas the Board focused on resolving for Rockefeller’s examiner the potential impediment (SNIPR’s AIA patents posed) to allowing and issuing Rockefeller a patent on the same invention, the court focused on whether the AIA version of the Patent Act permits a re-examination (through interference) of the SNIPR patent claims for compliance with pre-AIA §§ 102(g) and 135(a). Pre-AIA § 135(a) “authorizes the [Board] to declare an interference between an application that would interfere with ‘any unexpired patent,’

wherein the Board ‘shall determine questions of priority of the inventions.’” *Id.* at 15 (quoting the statute). But the court explained the reference to “any unexpired patent” does not include pure AIA patents, such as SNIPR’s patents. The purpose and history of the AIA, along with the express and controlling text in section 3(n) foreclose a contrary conclusion, according to the court. *Id.* at 15–16. “Because pure AIA patents may not be part of interferences, the Director erred by subjecting the SNIPR Patents to an interference.” *Id.* at 19.

Pure AIA patents may not be part of interferences.

So, what is the Patent Office supposed to do?

The court’s decision makes clear that the Patent Office may not declare an interference when a pre-AIA application is claiming the same invention as an AIA patent. But the Office can do a lot of other things. In examining SNIPR’s AIA applications the Patent Office issued, the Office could have been more diligent in its prior art searching and review. The Office could have noticed that in 2014 WIPO published Rockefeller’s parent application. And it could have examined the SNIPR applications in view of that publication, potentially rejecting SNIPR’s claims as unpatentable under AIA-35 USC § 102. (After all, by declaring Rockefeller the senior party in the interference, the Board concluded the Rockefeller application had an effective filing date for at least one disclosed embodiment nearly three years before the SNIPR patents’ effective filing date.) Of course, that may be easier said than done. Patent examination is hardly an easy task. And the complications here were no doubt compounded by SNIPR’s requests that the examiner expedite examination of four of the five applications that the Office issued.

The Patent Office’s Director may order reexamination of the AIA patent to reassess the patentability of the claims under AIA-§§ 102 and 103. Here, the SNIPR patents may be vulnerable to printed publication prior art including Rockefeller’s 2014 published application. If that reexamination results in amendments to the claims

or cancellation of the claims, Rockefeller’s competing pre-AIA application may have a clearer path to allowance and issuance that should not present the potential of separate patents on the same invention owned by competing inventors. Director-ordered reexamination is rare but may be sensible in situations like this which, after all, arose through the actions of the Patent Office—occasioned by granting SNIPR’s expedited (Track One) examination requests.

Incredibly, in view of the Federal Circuit’s decision—and particularly its comment that pre-AIA § 135(a)’s reference to “any unexpired patent” does not include pure AIA patents—there seems to be no statutory impediment to the Patent Office issuing a patent on the pre-AIA application, such as Rockefeller’s, claiming the same invention as the otherwise interfering patents. But that does the public no good service. Recall, the Patent Office is not supposed to issue separate patents for the same invention to competing inventors. For good reason. Those competing inventors would be free to enforce their patents on the same infringers who would be potentially liable to each for the same act of infringing patentably indistinct claims. Whenever practical and possible, that potential should be avoided. And, as explained above, through more diligent examination, the Patent Office can minimize that potential.

The story isn’t over

Aside from the above options, of course, is a potential that a pre-AIA applicant is no more deserving of a patent than the pure AIA patentee. In resuming examination of the Rockefeller application, the examiner may conclude that SNIPR’s § 112(a) attack of the Rockefeller claims—an attack the Board deemed “moot” during the interference—is sufficiently compelling to warrant a rejection. Near the end of its decision, the court footnotes that the § 112(a) issue remains unresolved. Sometimes a footnote is where the fun is because this 10-year-old story will continue in view of the court’s decision ... with the potential that whenever the story ends, neither party will have a patent on the contested invention.

1. Half-way through these interferences, the Board terminated them as having been improvidently declared because, for example, there was no interference-in-fact or one party’s application did not contain written description support for its involved claims. *See, e.g., Mirexus Biotechnologies, Inc. v. Purdue Res. Found.*, Interference No. 106,101, Paper 211 (PTAB 2020) (Decision on Motions) (granting AIA patentee’s no interference-in-fact motion and dismissing the jurisdictional motion as moot); *see also, Gopinath v. Arling*, Interference No. 106,114, Paper 57 (PTAB 2020) (Decision on Motions)

(same); *Gopinath v. Arling*, Interference 106,113, Paper 74 (PTAB 2020) (Decision on Motions) (same); *Jantz v. Galetto*, Interference No. 106,118, Paper 206 (PTAB 2020) (Decision on Motions) (granting AIA patentee’s motion that the opponent’s involved application lacks written description and dismissing the jurisdictional motion as moot). In each, however, the AIA patentees were forced to expend resources in defending their patents. And in each, the Board refused to address the AIA patentee’s jurisdictional motion.