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

MERVIN G. MARTIN, SENIOR PARTY PETITIONER
v.
JAMES T. CLEVENGER, JR., JUNIOR PARTY RESPONDENT
Interference No. 101,121
April 3, 1989

Donald J. Quigg

Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND ORDER

***1** The above-identified interference involves an application of Junior Party Clevenger and an application of Senior Party Martin.

On February 16, 1988, the Board of Patent Appeals and Interferences entered a final decision (Paper No. 147) in which it "awarded" priority to Martin. Clevenger, through his assignee, then sought judicial review by civil action under 35 U.S.C. § 146. The civil action was filed on April 18, 1988 (Paper No. 151) and is currently pending as Ford New Holland, Inc. v. Gehl Co., Civil Action No. 88-0578 (M.D.Pa.).

On March 6, 1989, Martin filed a request (Paper No. 156) asking that a patent be issued to him notwithstanding the pendency of judicial review in the Middle District of Pennsylvania. Clevenger has opposed (Paper No. 157).

Under applicable precedent, when (1) only applications are involved in an interference, (2) the board has entered a final decision, and (3) the losing party seeks judicial review by civil action under 35 U.S.C. § 146, the PTO may issue a patent to the winning party notwithstanding pendency of judicial review. Monaco v. Watson, 270 F.2d 335, 122 USPQ 564 (D.C.Cir.1959). [FN1]

PTO has discretion to issue a patent to a winning party in an interference involving only applications where judicial review has been sought under 35 U.S.C. § 146. However, as made clear in Section 1107 of the Manual of Patent Examining Procedure [5th ed., Rev. 10, Jan. 1989], the "normal" practice is not to issue a patent when judicial review is sought under 35 U.S.C. § 146.

While there may be unusual circumstances where it would be appropriate to issue a patent notwithstanding judicial review under 35 U.S.C. § 146, the winning party has a heavy burden of demonstrating that a patent should issue. Manifestly, petitioner has not sustained that burden in this case. In his request (Paper No. 156), Martin gives no reason why a patent should issue apart from the fact he "won" the interference. The mere fact Martin "won" the interference is not sufficient to justify issuance of a patent to Martin at this time.

Upon consideration of Martin's request (Paper No. 156), Clevenger's opposition (Paper No. 157), and for the reasons given herein, it is

ORDERED that Martin's request is denied and it is

FURTHER ORDERED that the Board of Patent Appeals and Interferences shall maintain control over the interference file, the Martin application file, and the Clevenger application file until judicial review under 35 U.S.C. § 146 is complete.

FN1. There are two situations where PTO will not issue a patent to a winning party in an interference. First, if the interference involves a patent and an application, the board holds that the applicant is entitled to prevail, and the patentee seeks judicial review by civil action under 35 U.S.C. § 146, a patent is not issued to the winning party. Monsanto Co. v. Kamp, 349 F.2d 389, 146 USPQ 431 (D.C.Cir.1965). Second, if judicial review is sought in the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. § 141, a patent is not issued to the winning party.

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