Interference
A Brief Primer

First-to-Invent:

Not the first to file, but the first to invent, will be awarded a patent for his/her invention. The first-to-invent concept is deeply rooted in U.S. Patent Law. In order to allow a later filer to prove his earlier invention, the Patent Office provides for a so-called Interference. Let us assume that a two patent applications are currently before the Patent Office and they both claim the same invention.

Before an interference can be declared, the respective applications must be in condition for allowance.

Date of Invention:

The party who can prove that they are the "first to invent" in the interference proceeding will receive an "award of priority." To receive this award, a party must establish an earlier "date of invention" than the opposing party. When determining this date, the Patent Office will consider two aspects of the invention, namely, "conception" and "reduction to practice."

Conception:

"Conception" is the primary act of an invention, the point in time when the inventive idea first pops into the inventor's head, often likened to the light bulb turning on above the inventor's head. This is the mental part of the inventive act, the idea for the invention. But a conception that is relevant to the "date of invention," must be more than just a general idea. In interference practice, an invention is conceived of when the inventor has in mind a complete idea of the invention of the count (i.e., the subject matter which is the "invention" over which the interference is declared).

Reduction to Practice:

After conception, the inventor must reduce the invention to practice. This can be done in one of two ways:

- *Actual Reduction:* the inventor actually makes, builds, and/or uses the invention. To achieve actual reduction to practice, the inventor must actually make a tangible embodiment and demonstrate a practical utility. In the instant case, we may be able to show that the inventor actually made a proximity/touch switch, tested the switch, and showed that it actually operated in the way he had intended. A successful reduction to practice requires a showing that the device is operative and has practical utility. The device need not necessarily operate perfectly and it may remain in the laboratory stage of development.

- *Constructive Reduction*: the inventor files a patent application covering the invention and satisfying the disclosure requirements of 35 U.S.C. § 112.

Priority – Diligence:

Where the first party to conceive of the invention constructively reduces the invention to practice after the other party, priority will still be awarded to the first party, if he is able to prove "diligence" from just before the conception date of the other party to his reduction to practice. In order to prevail in the matter at hand, the first inventor must prove a reasonably diligent effort to reduce the invention to practice from just before the later inventor's date of conception. The parties do not know each others' dates in the beginning (they must guess for quite some time).

Proving Diligence:

To establish diligence between conception and reduction to practice typically is the most difficult part of the interference proceeding. The guidelines established by the *Patent Office Board of Patent Appeals and Interferences* allow many different types of proof. Most important, however, is the requirement that the "diligence" cover virtually the entire time period from conception to reduction, i.e., the efforts to reduce must be "reasonably continuous."

It is not sufficient for the inventor, or his colleagues, to state and swear to the diligence. In addition, corroborating evidence must be submitted.

Corroborating evidence may take many forms, and it may include laboratory logs, telephone logs, e-mail logs, meetings, dated drawings, etc. It is recommended that the various items of proof be carefully reviewed and that a diagram of the pertinent time line be established, as well as the corresponding evidence be investigated, prior to entering into the full-fledged proceedings.