

The opinion in support of the decision being entered today is binding precedent of the Trial Section

Paper 4

Filed by: Trial Section Merits Panel  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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PAUL S. WATERMAN,

Junior Party,  
(Application 09/049,225),

v.

JEAN-LUC BIRBAUM, JEAN RODY, MARIO SLONGO,  
ANDREAS VALET and ROLAND A. E. WINTER

Senior Party  
(Patent 5,736,597).

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Patent Interference No. 104,500

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Before: MCKELVEY, Senior Administrative Patent Judge, and  
SCHAFFER, LEE and TORCZON, Administrative Patent Judges.

PER CURIAM.

**ORDER TERMINATING INTERFERENCE**

**A. Background**

The interference was declared 9 February 2000 and involves a Waterman application and a Birbaum patent. Unknown to the board at the time the interference was declared, was an express abandonment of the Waterman application which had been filed by Waterman on 18 January 2000. By virtue of a JOINT COMMUNICATION

(Paper 3), the parties have notified the board of the abandoned status of the Waterman application.

An interference may be declared between a pending application and an unexpired patent when the Commissioner is of the opinion that the application and patent claim the same patentable invention. 35 U.S.C. § 135(a); 37 CFR § 1.606.

#### **B. Discussion**

The Patent Statute (35 U.S.C. § 135(a)) does not authorize an interference between an abandoned application and an unexpired patent.

Since the Waterman application was abandoned as of the date the interference was declared, it follows that the board lacked subject matter jurisdiction over the interference. Compare Petrie v. Welsh, 21 USPQ2d 2012 (Bd. Pat. App. & Int. 1991) (patent versus application interference terminated for lack of subject matter jurisdiction where it was discovered patent had expired prior to declaration of interference).

In light of the board's lack of subject matter jurisdiction in this interference, and notwithstanding the ORDER entered 9 February 2000 (Paper 2), there will be no further evaluation of the Rule 608(b) showing which has been presented by Waterman.

The board appreciates the prompt manner in which counsel have called our attention to the abandoned status of the Waterman application.

**C. Order**

Upon consideration of the record, and for the reasons given,  
it is

ORDERED that the interference is terminated for lack of  
subject matter jurisdiction.

<u>FRED E. MCKELVEY, Senior</u>	)	
Administrative Patent Judge	)	
	)	
	)	
<u>RICHARD E. SCHAFER</u>	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
<u>JAMESON LEE</u>	)	
Administrative Patent Judge	)	
	)	
	)	
<u>RICHARD TORCZON</u>	)	
Administrative Patent Judge	)	

cc (via First Class Mail):

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