

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 3

Filed by: Trial Section Merits Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MICHAEL W. J. WEST

Junior Party,
(Application 08/467,241),

v.

PADMANABHAN SUNDARARAMAN, JAMES A. CLAAR
and CHARLES M. KANIA,

Senior Party
(Patent 5,105,010).

Patent Interference No. 104,511

ORDER TERMINATING INTERFERENCE FOR LACK OF JURISDICTION

A. Discussion

The interference was declared on 15 March 2000. At the time the interference was declared, it was the board's belief that a maintenance fee had been paid in connection with the Sundararaman patent involved in the interference.

On Monday, 20 March 2000, counsel for Sundararaman (William J. Uhl, Esq.) had discussion with Administrator Sally C. Medley in which he advised that the maintenance fee had not been paid and the Sundararaman's assignee PPG Industries, Inc., had no

intention of paying any maintenance fee. A further review of the records of the Patent and Trademark Office confirm Mr. Uhl's representation that a maintenance fee has not been paid in connection with the Sundararaman patent involved in the interference.

On Monday, 20 March 2000 Administrator Medley also had a telephone conversation with counsel for West (Gerald E. Deitch, Esq.) wherein counsel was advised that there would be no need for West to respond to the ORDER SETTING TIMES FOR TAKING CERTAIN ACTION (Paper 2) entered 15 March 2000.

Under the circumstances, the Sundararaman patent was an expired patent at the time the interference was declared. Under 35 U.S.C. § 135(a), the board has jurisdiction to institute an interference only with an unexpired patent. Since the Sundararaman patent was expired as of 15 March 2000, it follows that the board lacked subject matter jurisdiction and that the interference should be terminated.

Upon resumption of ex parte prosecution, the examiner should treat the Sundararaman patent as an expired patent. West may properly antedate the Sundararaman patent with a Rule 131 showing because the Sundararaman patent, as an "expired patent," does not "claim" the same invention as West within the meaning of Rule 131.

B. Order

Upon consideration of the record, it is

ORDERED that the interference is terminated because the board lacked subject matter jurisdiction at the time the interference was declared.

FURTHER ORDERED that West need not respond to the ORDER SETTING TIMES FOR TAKING CERTAIN ACTION (Paper 2).

FURTHER ORDERED that the West application involved in the interference shall be returned to the examiner for such further ex parte prosecution as may be appropriate.

FURTHER ORDERED that a copy of this order shall be placed in the files of the Sundararaman patent and the West application.

<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)	

104,511
cc (via First Class Mail):

Attorney for West
(real party in interest
E. I. duPont de Nemours & Co., Inc.):

Gerald E. Deitch, Esq.
DuPont Legal
BMP17-2120
Route 48 & Route 141
Wilmington, DE 19805-1522

Tel: 302-992-5090
Fax: 302-892-7925
E-mail: None

Attorney for Sundararaman
(real party in interest
PPG Industries, Inc.):

William J. Uhl, Esq.
Patent Department
PPG Industries, Inc.
One PPG Place
Pittsburgh, PA 15272

Tel: 412-434-2881
Fax: 412-434-4292
E-mail: uhl@ppg.com