Interferences

To some extent, every legal proceeding involves strategy. However, the specialized IP law practice of interferences is one of the most strategy-intensive undertakings in the United States legal system. With over 40 years of experience and literally hundreds of interference proceedings to their credit, the Rothwell Figg Interference team is one of the nation's premier resources for clients faced with this unusual and high-stakes situation.

A patent interference occurs when multiple pending patent applications or patents make claims covering essentially the same subject matter. If a decision is made in an initial stage that both parties are entitled to a patent except for the existence of the other party, the dispute is resolved by deciding who was the first to invent. Because there is essentially no discovery in interference proceedings, they are in some respects poker games with millions (or hundreds of millions) of dollars at issue. They're the ultimate example of, when dealing with a dispute, the importance of experience. Highly complex and procedurally intricate, interferences demand both in-depth knowledge and the intellectual ability to play a kind of three-dimensional chess.

At Rothwell Figg, we have managed interference proceedings for technologies ranging from noninvasive prenatal testing, to digital sound in Hollywood blockbusters, to detergent compositions, to methods for assessing the severity of rheumatoid arthritis. Because our attorneys often have graduate degrees in scientific fields, firsthand industry experience, or both, we're skilled at both understanding the science underlying a matter, and the research process by which it came into being. In a legal field where that is becoming rarer and rarer, we're one of a handful of firms that has deep experience.

We are also highly skilled at negotiation, a crucial skill in managing interferences. Since the passage of the America Invents Act in 2012, the interference process has been replaced, and the number of matters will continue to dwindle until around 2033. We are one of the few firms that still has expertise to handle the remaining interferences that will continue to be declared. Similarly, we are also leaders in handling derivative proceedings, which involve similar issues of priority.

Our approach to interference strategy is really twofold. In addition to building a strong argument for or against ownership of a patent – i.e., making a case – an essential, often-overlooked element of an interference practice is determining whether an interference is appropriate at all. By thinking strategically, it's often possible to win the battle without firing a shot, so to speak. Our ability to think and act strategically and creatively is one of the things that sets us apart.

As one example, clients faced with competing claims are often better served by means other than asking for an interference. Sometimes, of course, that is the right thing to do. Alternatively, in some cases, merely having an interference declared brings an opposing party to the table to negotiate. The complexity and risk of the proceeding can do that. This kind of proactive approach can also convince a potential opponent that contesting an interference proceeding would be a bad idea. Another approach, which can be very effective, is to simply send information to the other side to start negotiations prior to even requesting an interference. By doing this, when appropriate, we can reduce the cost to the client by

demonstrating to a potential opponent the strength of the case they would be up against. In certain situations, a third approach is to amend a claim to avoid overlap, and sidestep the interference proceeding altogether.

In addition, deciding whether to request an interference typically has to be made without much information about the opponent's position of priority. Accordingly, it is essential to have experience that will allow a reasonable prediction of the opponent's position, drawn from other information. Interference strategy then, involves much more than simply assembling an argument. It requires practitioners to discuss with the client the full range of approaches, with a high degree of candor, as well as providing an estimate of the likelihood of success for each, to allow a decision to be made about the best approaches given all the factors.

Thanks to changes in the law, interferences are gradually waning as a legal specialty. However, when they are appropriate, there is no substitute for the deep knowledge and strategic capability that arises from decades of hands-on experience. Rothwell Figg's Interference practice's track record is unmatched, and increasingly, neither are our results.