



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Slip Track Sys.,
Inc.
v.
Metal-Lite, Inc.***

Nos. 01-1187,
-1196
Federal Circuit
Sept. 11, 2002

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On September 11, 2002, the Federal Circuit, *inter alia*, vacated the district court’s summary judgment awarding Metal-Lite priority of invention in a contest between interfering U.S. Patents No. 5,127,760 and No. 5,127,203, which both related to a slotted header that prevents dry wall from cracking during earthquakes by permitting the wallboard to move up and down. The Federal Circuit stated:

Most interferences arise in the PTO, involve an interference between two applications or an application and one or more patents, and begin with the creation of a “count.” The count defines the interfering subject matter and corresponds to a patentable invention. The count may be identical to a single claim at issue or may be broader than the particular claims at issue. This case, however, is one of a handful where the interference is between issued patents and arises in district court, where PTO procedures do not govern. Nonetheless, in order to provoke an interference in district court under § 291, the interfering patents must have the same or substantially the same subject matter in similar form as that required by the PTO pursuant to 35 U.S.C. § 135.

This court has not yet had occasion to determine whether district courts handling interfering patent suits under § 291 must define this interfering subject matter in a way similar to a count. [H]ighlighting the import of having a single textual description of the invention for the assessment of priority, [we have] assumed that even in district court proceedings under § 291 a description of the interfering subject matter analogous to a count would be developed. [G]iven interfering patents, a single description of the interfering subject matter is necessary for a determination of priority.

[T]he district court did not define the bounds of the interfering subject matter. There is no dispute that the patents interfere. “[T]he PTO issued two patents for the same invention on the same day.” There is only a dispute about whether the interfering subject matter includes the wallboard limitation. As the parties in this case dispute only whether one limitation is part of the interfering subject matter, and determination of this issue is dependent upon issues of law alone, we will resolve this issue on appeal.

As with a count in the administrative interference process before the PTO, the description of interfering subject matter must be broad enough to encompass the common subject matter of the claims in both patents, in this case, the claims of the ‘760 patent and the claims of the ‘203 patent. “[I]nterfering patents are patents that claim the same subject matter,” and “[i]t is thus correct, and necessary, to compare claims, not disclosures, when comparing issued patents under section 291.” Since the claims of the ‘760 patent do not include a wallboard, and . . . the specification is not relevant to the determination of an interference, the wallboard cannot be an element of the interfering subject matter in this case, even though it is a limitation in the claims of the ‘203 patent.

In sum, we agree with the district court that Slip Track is entitled to a conception date of September 18, 1989. The drawings that Mr. Harris made for Mr. Brady indicate that they had at that time a definite and permanent idea of the invention.