

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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BOX INTERFERENCE

Commissioner of Patents and Trademarks

Washington, DC 20231

Attn: Administrative Patent Judge Richard Torczon

Re: "Consideration of Interlocutory Rulings at Final Hearings in Interference Proceedings" - Interim Rule with Request for Comments - 64 Fed. Reg. 12900 (March 16, 1999)

Dear Judge Torczon:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the interim amendment to 37 CFR § 1.655, as published in the Federal Register on March 17, 1999.

The AIPLA supports the effort to clarify PTO rules, including the clarification of the burden of proof to be applied in reviewing, at final hearings in interferences, interlocutory orders entered previously in the interference. The AIPLA agrees with the clarifications made in the subject rule change. In particular, the AIPLA believes that it is appropriate (1) that a panel of the Board of Patent Appeals and Interferences deciding an interference after final hearing resolve the merits of the interference proceeding as a panel, without deference to any interlocutory order; (2) that the abuse of discretion standard be applied by the panel only for procedural matters; and (3) that 37 CFR § 1.655 be amended to clarify that these rules apply. Item (2) is explicitly stated in the new Rule, and Item (1) is explicitly stated in the comments explaining the rule change.

We think that 37 CFR § 1.655 would be clearer if the Rule itself stated, as the comments explaining it, that "A panel of the Board of Patent Appeals and Interferences deciding an interference after final hearing shall resolve the merits of the interference proceeding as a panel, without deference to any interlocutory order." This sentence could be inserted immediately before the last, newly inserted sentence in 37 CFR § 1.655(a), i.e., "The abuse of discretion standard shall apply only to procedural matters."

We appreciate the opportunity to provide comments on rule changes.

Sincerely,

<signed>

Margaret A. Boulware  
President