From: JIngerman@fishneave.com
Sent: Monday, 25 September 2000 11:47
To: Interference.Rules@uspto.gov
Subject: Interference Simplification

The undersigned hereby comments on the September 15, 2000 Interim Rule on "interference simplification." While the undersigned is a partner in the New York intellectual property firm of Fish & Neave, these comments represent the undersigned's personal views and not necessarily those of Fish & Neave.

These comments are directed to the portions of the interim rulemaking relating to 37 CFR §§ 1.671, 1.682, 1.683 and 1.688, and particularly to Sections 1.671 and 1.682.

The undersigned understands the desire of the Board of Patent Appeals and Interferences ("the Board") to have all documents relied on in an interference introduced as an exhibit in that interference. That is what the undersigned gathers from the current practices of the Board and from the comment in the interim rulemaking that Section 1.671 is being amended "to provide that all evidence is presented in the form of an exhibit." With respect, however, the undersigned suggests that the amendment of Section 1.671 does not accomplish that objective, as it says nothing about the manner of submitting evidence, but merely defines what qualifies as evidence. If the Board wants Section 1.671 to mean that each item of evidence must be submitted as a numbered exhibit, then that is what the rule should say.

In addition, the sections that are being deleted, including the portions of Section 1.671(a) that are being deleted, do more than merely set forth procedures -- as suggested in the rulemaking -- that are unnecessary if everything is submitted as an exhibit under Section 1.671(a). Rather, they define certain classes of evidence that can be introduced without the need to have a witness testify about them. Thus, for example, under Section 1.682 a motion can rely on a printed publication (properly given an exhibit number as desired by the Board) without the need for a declaration introducing it into evidence. Without Section 1.682, the undersigned sees no way around all those additional declarations (each of which is itself yet another exhibit), even if counsel has to be the declarant (as is done in District Court litigation), and yet the undersigned does not believe the Board intends this result. The deletions of Sections 1.683 and 1.688 seem less of a problem in this regard, but problems may lurk there as well. Also, the deletion of Section 1.682 as to official records, at least if they are records of the PTO, seems less of a problem than its deletion as to publications, in view of Section 1.671(d). Therefore, the undersigned suggests that at least part, if not all, of the first sentence of Section 1.682 be retained, possibly as part of Section 1.671.

Respectfully submitted,

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New York