Chapter 2300 Interference Proceedings under Public Law 98–622

§ 2300.01 Introduction [R–2]

Title II of the Patent Law Amendments Act of 1984 (Public Law 98–622) combined the Patent and Trademark Office Board of Appeals and Board of Patent Interferences into a new board, the Board of Patent Appeals and Interferences (Board), and amended 35 U.S.C. 135(a) to provide that in an interference the jurisdiction of the new Board would extend not only to priority of invention, but also to questions of patentability. These provisions took effect on February 8, 1985. On the next working day, February 11, 1985, the former interference rules, 37 CFR 1.201 to 1.288, were replaced with a new set of rules, 37 CFR 1.601 to 1.688. With a few exceptions, the new rules apply to all interferences declared on or after the date of their adoption; interferences declared prior to that date will continue to be governed by the old rules covered in Chapter 1100.

The notice promulgating the new rules, which was published in the Federal Register on December 12, 1984 (49 F.R. 48416) and in the Official Gazette on January 29, 1985 (1050 O.G. 385), included not only the text of the rules, but also a discussion of the rules and analysis of the comments received, which serve as the "legislative history" of the rules. A practitioner who is or may become involved in an interference under the new rules would be well advised to study this notice closely.

Attention is also directed to the correction notice published in the Federal Register on May 31, 1985 (50 F.R. 23122) and in the Official Gazette on October 22, 1985 (1059 O.G. 27).

It is believed that the statutory changes, and the new rules, will result in a more rapid determination of the rights of the parties, and avoid the lengthy proceedings which have characterized some interferences in the past. Since the Board has been given jurisdiction to decide patentability, it will no longer be necessary to decide whether or not an issue is "ancillary to priority"; the Board can now decide all patentability issues in the interference, if properly raised by the parties, without the necessity for dissolving the interference and pursuing patentability questions *ex parte* (in which case a reversal of the *ex parte* rejection would require reinstatement of the interference). Each interference under the new rules is assigned to an examiner-in-chief, who is expected to exercise such control over the interference that it will not normally be pending before the Board more than two years (37 CFR 1.610). 37 CFR 1.616 provides that appropriate sanctions may be imposed by an examiner-in-chief against a party who fails to comply with the interference rules or an order of the examiner-in-chief or Board. The ultimate sanction, entry of adverse judgment against the party, may be imposed by the Board in an extreme case.

The interference practice is based on 35 U.S.C. 135, as amended by P.L. 98–622

35 U.S.C. 135. Interferences. (a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Commissioner shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination of the filing requirement of this section. If the Commissioner gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Commissioner under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Commissioner by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Commissioner, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Commissioner from determining patentability of the invention involved in the interference.

The Patent and Trademark Office (PTO) conducts interference proceedings to determine who as between two or more applicants for patent or one or more applicants and one or more patentees is the first inventor of a patentable invention. Prior to February 11, 1985, the determination was made by a Board of Patent Interferences. The Patent Law Amendments Act of 1984, Public Law 98–622, §§ 201–202 combined the Board of Appeals and the Board of Patent Interferences into a single Board of Patent Appeals and Interferences (Board) and authorized the Board to consider priority and patentability in interference cases.

In view of the discretion given the Board under 35 U.S.C. 135(a), as amended by Public Law 98–662 ("The Board . . . . may determine questions of patentability . . . ."), the rules set forth in this chapter will apply to all interferences declared on or after February 11, 1985, except in special circumstances, such as: (1) interferences which are declared as a result of a motion made in another interference which was pending before the Board before February 11, 1985, (e.g., an interference declared as a result of a motion under 37 CFR 1.231 to declare an additional interference); (2) an interference related to another interference declared prior to February 11, 1985 (e.g., an interference involving a method of using a compound where an interference involving the same parties and the compound was declared prior to February 11, 1985); and (3) an interference reinstituted after having been dissolved under the old rules (37 CFR

§§ 1.201–1.288) (e.g., an interference reinstituted after having been dissolved as a result of a motion under 37 CFR 1.231 to dissolve on the grounds of unpatentability where the applicant has obtained allowance of the claims held unpatentable in the decision on motions). For these interferences the provisions of Chapter 1100 remain in effect.

Through the rules and provisions of this chapter, the PTO seeks to improve interference procedure so that the rights of parties in interferences are determined at an early date and the overall process of examining patent applications which become involved in interferences is simplified.

The new rules for interferences are set forth herein in §§ 1.601 through 1.688. The new rules replace entirely the previous interference rules (37 CFR 1.201 through 1.288). A "six hundred" number series is used for the new rules. The use of a six hundred number series for the new rules will permit interested individuals to research published decisions (e.g., F.2d, USPQ) or computerized legal research services (e.g., LEXIS) citing the new rules.

An index of the headings of §§ 1.601–1.688 and a table correlating 37 CFR §§ 1.201 through 1.288 (former rules) to §§ 1.601 through 1.688 (revised rules) appears below.

Rule Correlation Table

Former Rule	Revised Rule
1.201(a)	1.601(i)
1.201(b)	1.601(i)
1.201(c)	1.602
1.202	none
1.203(a)	1.603
1.203(b)	1.605(a)
1.203(c)	1.605(b)
new	1.604 (a)
1.203(d)	1.604(b)
1.204(a)	none
1.204(b)	1.608(a)
1.204(c)	1.608(b)
1.205(a)	1.606
1.205(b)	1.607(a), (c)
1.205(c)	1.607(d)
new	1.608 (a)
1.206(a)	1.607(b)
1.207(a)	1.609
new	1.610
1.207(b)	1.611
1.208	1.613(b)
1.211	1.614
1.212	1.615
new	1.616
1.228	1.617
new	1.618
1.215(a)	1.621(a)
1.215(b)	1.621(b)
1.215(c)	1.629(c)
1.216(a)	1.622(a), (b)
1.216(a) (1)–(6)	1.623(a)
1.216(b)	1.623(c), 1.624(c) 1.625(c)
1.216(c)	1.666

Rule Correlation Table—Continued

Former Rule	Revised Rule
1.217(a)	1.624(a), 1.625(a)
1.217(b)	1.623(a)
1.218	1.621(a)
1.219	1.627
1.222	1.628
1.223	1.629
1.224	1.630
1.225	1.640(d), (e), and 1.651(c)(4)
1.226	1.612
1.227	1.631
new	1.632
1.231	1.633, 1.634
1.237	1.641
1.238	1.642
1.242	1.643
1.243	1.635, 1.636, 1.637(b) 1.638 through 1.640
1.244	1.644
1.245	1.645(a)
1.246	1.645(b)
1.247	1.646
1.248	1.646
new	1.647
1.251	1.651
1.252	1.652
1.253	1.653
1.254	1.656
1.255	1.656(c)
1.256	1.654
1.257 (a)	1.657
1.257 (b)	1.658(c)
1.258	1.655
1.259	1.659
new	1.660
1.262	1.662(a)
1.263	1.622(c)
1.264	1.662(b)
new	1.662(e)
1.265	1.663
1.266	1.664
1.267	1.665
1.268	1.666
1.271	1.671(h)
new	1.671(g)
1.272(a)	1.672(a), (b)
1.272(b)	1.672(d)
1.272(c)	1.672(e), (f)
1.273(a)	1.673(a), (c), (d),
new	1.673(e)
1.273(b)	1.673(f)
1.274	1.674
1.275	1.675
1.276	1.676
1.277	1.677
1.278	1.678
1.279	1.679
1.281	1.645(a)
1.282	1.682
1.283	1.683
1.285	1.685
1.286	eliminated
1.287(a)(1)(i),(ii)	1.673(b)
1.287(a)(1)(iii)	1.673(a)
1.287(a)(2), (3)	eliminated
1.287(b)	1.687(b)
1.287(c)	1.687(c)

Rule Correlation Table—Continued

Former Rule	Revised Rule
1.287(d)(1)	1.673(c)
1.287(d)(2)	1.616
1.287(e)	1.687(d)
1.288	1.688

2300.02 Outline of Interference Procedure [R-2]

The following statement appears in a "section-by-section" analysis submitted for the Record by Representative Kastenmeier during discussion of H.R. 6286 (Pub. L. 98-622) on the floor of the House (130 Cong. Rec. H10528, columns 2 and 3):

> "It is expected that interferences will become simpler, more expeditious, and less costly. Under the bill, all issues of patentability and priority which arise in an interference can be decided in a single proceeding rather than in a series of complicated *inter partes* and *ex parte* proceedings."

Under the revised rules, interferences are decided by the Board. The Board has jurisdiction to determine (1) priority of invention, (2) patentability of any claim corresponding to a count both as to applicants and patentees, (3) any issue of interference-in-fact as to any count, and (4) any other issue necessary to resolve the interference. The rules permit an interference to be declared on the basis of a single count defining one patentable invention in interferences involving patents as well as applications. The Board also has jurisdiction to determine whether counts are patentably distinct.

When an interference is declared, an examiner-in-chief is assigned to handle the interlocutory stages of the interference. An examiner having full signatory authority determines when one or more applications or one or more applications and a patent claim the same patentable invention. When the examiner makes such determination, the examiner will forward any involved applications or patents to the Board. The examiner will designate, at the time the involved applications or patents are sent to the Board, the claims of any application and patent which correspond to each count. The examiner-in-chief can subsequently designate additional claims to correspond to a count. The examiner-in-chief assigned to handle the interference will issue a notice to the parties declaring the interference.

The object of the interference will be to resolve all controversies as to all interfering subject matter defined by one or more counts. A final decision in the interference will determine who, if anyone, is entitled to claims which correspond to a count. Any decision adverse to an applicant by the Board will constitute a final refusal by the PTO to that applicant of the claims involved. Any decision adverse to a patentee constitutes cancellation from the patent of the claims involved.

Any decision by the Board on any issue is binding on the examiner and would govern further proceedings in the PTO.

The designation of a single examiner-in-chief to handle the interlocutory phases of an interference will permit better management of, and control over, interference proceedings. The rules provide that times be set and the examiner-in-chief exercise control over proceedings in the interference such that pendency of the interference before the Board from declaration to final decision will not normally exceed 24 months. The examiner-in-chief should be familiar with the history of the interference and will be accessible to counsel for the parties. For example, an examiner-in-chief, where appropriate, may conduct telephone conference calls to obtain agreement of the parties on the setting of schedules. The rules also permit the examiner-in-chief to hold hearings in the PTO or by conference telephone call in order to expedite or settle interlocutory issues in interferences. Any hearing can be transcribed by a court reporter under such conditions as an examiner-in-chief or the Board deems appropriate. The examiner-in-chief, where appropriate, will be available by phone to rule on the admissibility of evidence in the event parties encounter unusual problems during the taking of depositions. The examiner-in-chief will also be available to rule on requests for production of documents which take place during cross-examination. Oral orders given by phone will be followed by written orders.

At the time an interference is declared, the examiner-in-chief will set a time for filing preliminary motions. The preliminary motions can include:

(1) A motion for judgment on the ground that a claim corresponding to the count is not patentable to an opponent under 35 U.S.C. §§ 102, 103, 112, or any other provision of law.

(2) A motion for judgment on the ground that there is no interference-in-fact between the claims of the opponents in the interference.

(3) A motion to add or to substitute new counts, to amend a claim corresponding to a count, to designate an application or patent claim to correspond to a count, to designate an application or patent claim as not corresponding to a count, or to require an applicant to present a claim to be designated to correspond to a count.

(4) A motion to substitute another application for the application involved in the interference or to add an application for reissue to the interference.

(5) A motion to declare another interference.

(6) A motion to be accorded the benefit of an earlier application or to attack the benefit of an earlier application which has been accorded to an opponent.

Other motions are permitted as necessary, such as a motion to amend the count and/or a claim corresponding to the count in response to a preliminary motion for judgment.

Oppositions to motions are permitted if filed within a time set by the examiner-in-chief. Replies are also authorized. Papers which are not authorized by the

rules or requested by the examiner-in-chief can be returned unfiled.

A preliminary statement will be filed prior to or concurrently with the preliminary motions outlined above.

Motions will be decided by an examiner-in-chief, who may consult with an examiner on questions of patentability which have not previously been decided by the examiner. The examiner-in-chief may grant a motion, deny a motion, defer consideration on the merits of a motion to final hearing, or take such other action with respect to a motion as may be appropriate, e.g., dismiss an entirely inappropriate motion.

At the time preliminary motions are decided, the preliminary statements will be opened. If a decision on a motion or an inspection of the preliminary statement results in entry of an order to show cause why a judgment should not be entered, the party against whom judgment might be entered can request a hearing before the examiner-in-chief and two additional examiners-in-chief. The decision will govern further proceedings. If adverse, the decision will constitute a final agency action. If favorable, the interference will proceed before the examiner-in-chief.

After preliminary motions are decided and assuming judgment does not result, a period may be set for the parties to file motions for additional discovery. The scope of the additional discovery would be the same as under current practice.

When a time period is set for filing discovery motions, or after discovery has closed, the examiner-in-chief will set a period for taking testimony. Any party wishing to take the testimony of a witness can elect to have the testimony of the witness taken by deposition or presented by affidavit. A transcript of an *ex parte* deposition can be used as an affidavit. If an affidavit is presented, the opposing party may then cross-examine on oral deposition. Any redirect will take place at the deposition. The party calling the witness is responsible for securing a court reporter and filing the transcript and record associated with cross-examination of its witness.

In the event a party needs testimony from a third-party who will not appear unless a subpoena is issued, including a hostile witness, direct and cross-examination testimony may be taken on oral deposition. The rules provide that prior authorization of a examiner-in-chief is required before a party can take testimony by issuance of a subpoena under 35 U.S.C. § 24. The revised rule thus adopts the policy of *Sheehan* v. *Doyle,* 513 F.2d 895, 898, 185 USPQ 489, 492 (1st Cir.), *cert. denied,* 423 U.S. 874 (1975), and *Sheehan* v. *Doyle,* 529 F.2d 38, 40, 188 USPQ 545, 546 (1st Cir.), *cert. denied,* 429 U.S. 870 (1976), *rehearing denied,* 429 U.S. 987 (1976), and rejects the policy announced in *Brown* v. *Braddick,* 595 F.2d 961, 967, 203 USPQ 95, 101–102 (5th Cir. 1979). Testimony obtained in other proceedings, e.g., another interference or an infringement action, may be used if otherwise admissible.

Under the rules, the Federal Rules of Evidence are made applicable to interferences, except for those portions which relate to criminal actions, juries, and other matters not relevant to interferences. Those portions include:

(1) Rule 103(e).

(2) Rule 104 (c), (d), and (e)

(3) The language in Rule 105 which reads "and instruct the jury accordingly."

(4) Rule 201(g).

(5) The language in Rule 403 which reads "or misleading the jury."

(6) Rule 404(a) (1) and (2).

(7) The word "charge" in Rule 405(b).

(8) The language "or criminal" and proviso (ii) in Rule 410.

(9) Rule 412.

(10) Rule 606.

(11) The language "whether by an accused" and "other" in the last sentence of Rule 607.

(12) The provisions of the first sentence of Rule 611(c) relating to leading questions on direct examination do not apply to statements made in an affidavit authorized to be filed under the rules.

(13) The language "Except as otherwise provided in criminal proceedings by section 3500 of title 18, United States Code" and "except that in criminal cases when the prosecution elects not to comply, the order shall be one striking the testimony or, if the court in its discretion determines that the interests of justice so require, declaring a mistrial" in Rule 612.

(14) Rule 614.

(15) Rule 706.

(16) The language "excluding, however, in criminal cases matters observed by police officers and other law enforcement personnel" and "and against the Government in criminal cases" in Rule 803(8).

(17) The language "but not including, when offered by the Government in a criminal prosecution for purposes other than impeachment, judgments against persons other than the second" in Rule 803(22).

(18) The language "prosecution for homicide or in a" in Rule 804(b)(2).

(19) The language "A statement tending to expose the declarant to criminal liability and offered to exculpate the accused is not admissible unless corroborating circumstances clearly indicate the trustworthiness of the statement" in Rule 804(b)(3).

(20) Rule 1101 (a), (b), (d)(3), and (e).

The examiner-in-chief will set a period for filing the record and briefs. Oral hearings normally will be held before a panel consisting of the examiner-in-chief assigned to the interference and two other examiners-in-chief. The panel will render a final decision in the interference. Requests for reconsideration are permitted.

In rendering its decision, the Board will consider only that evidence which can be made available to the public under § 1.11(a). Accordingly, the Board will not consider evidence which is submitted under a protective order issued by a court if release of that evidence under § 1.11(a) would be inconsistent with the terms of the court's order.

A final decision of the Board is reviewable in the U.S. Court of Appeals for the Federal Circuit or an appropriate U.S. district court. Any reviewing court can review all aspects of the decision including patentability, priority, and all relevant interlocutory orders, such as denials of discovery.

Except as noted above, the revised rules are applicable to all interferences declared on or after February 11, 1985. Interferences declared prior to February 11, 1985, continue to be governed by the prior rules (37 CFR §§ 1.201–1.288 (July 1, 1984)) and will be decided by personnel of the Board of Patent Appeals and Interferences. Actions previously taken by a patent interference examiner or examiners of interferences will be taken by an examiner-in-chief.

An anticipated time schedule for a two-party interference follows:

Event in Interference	Time from last event in the interference	Total time in interference
Interference declared (1.611)		
Filing of preliminary statements (1.621) and preliminary motions (1.633).	3 months	3 months
Filing oppositions of preliminary motions (1.638(a)).	½ month	3½ months
Filing replies to oppositions (1.638(b))	½ month	4½ months
Decision on preliminary motions (1.640(b)(1)), open preliminary statements (1.631), set times for filing motions for discovery (1.687(c) and testimony (1.651(a)).	1 month	5½ months
Filing of motions of discovery (1.635, 1.651(a), 1.687(c)).	1 month	6½ months
Filing of opposition to motion for discovery (1.638(a)).	½ month	7 months
Filing reply to opposition to motion for discovery (1.638(b)).	½ month	7½ months
Decision on motion for discovery	½ month	8½ months
Time for compliance with any discovery.	½ month	9 months
Junior party testimony (case-in-chief; 1.672(b)):		
Testimony	2 months	11 months
Senior party cross-examination of affiants if needed.	1 month	12 months
Senior party testimony (case-in-chief and case-in-rebuttal, 1.672(b)):		
Testimony	1½ months	13½ months
Junior party cross-examination of affiants if needed	1 month	14½ months
Junior party testimony (case-in-rebuttal):		
Testimony	½ month	16 months
Senior party cross-examination of affiants if needed.	½ month	16½ months
Filing of record (1.653(c))	1½ months	18 months
Brief for junior party (1.656)	1 month	19 months
Brief for senior party (1.656)	1 month	20 months
Reply brief for junior party (1.656)	½ month	20½ months
Final hearing (1.654)	1 month	21½ months
Decision (1.658)	2 months	23½ months

2301.01 Preliminaries to an Interference [R–2]

An interference is often an expensive and time-consuming proceeding. Yet, it is necessary to determine priority when two applicants, or an applicant and a patentee, are claiming the same patentable subject matter and their filing dates are close together that there is a reasonable possibility that the first to file is not the first inventor. The fact that an application is a reissue application does not preclude it from being involved in an interference.

The greatest care must therefore be exercised both in the search for interfering applications and in determining whether an interference should be declared. Also the claims in recently issued patents, especially those used as references against the application claims, should be considered for possible interference.

The question of the propriety of initiating an interference in any given case is affected by so many factors that a discussion of them here is impracticable. Some circumstances which render an interference unnecessary are hereinafter noted, but each instance must be carefully considered if serious errors are to be avoided.

In determining whether an interference is necessary, a claim should be given the broadest interpretation which it reasonably will support, bearing in mind the following general priniciples:

(a) The interpretation should not be strained.

(b) Express limitations in the claim should not be ignored nor should limitations be read therein.

(c) Before a claim (unless it is a patented claim) is considered as the basis for the count of an interference the claim should be allowable and in good form. No pending claim which is indefinite, ambiguous or otherwise defective should be the basis for a count of an interference.

(d) A claim copied from a patent, if ambiguous, should be interpreted in the light of the patent in which it originated.

(e) Since an interference between cases having a common assignee is not normally instituted, all cases must be submitted to the Assignment Division for a title report.

(f) If doubts exist as to whether there is an interference, an interference should not be declared.

2301.01(a) In Different Groups [R–2]

An interference between applications assigned to different groups is declared by the group where the controlling interfering claim would be classified. Appropriate transfer of one of the applications is made. After termination of the interference, further transfer may be necessary depending upon the outcome.

2301.01(b) The Interference Search [R–2]

The search for interfering applications must not be limited to the class or subclass in which the application is classified, but must be extended to all classes, in or out of the examining group, which it has been necessary to search in the examination of the application. See § 1302.08.

Moreover, the possibility of the existence of interfering applications should be kept in mind throughout the prosecution. Where the examiner at any time finds that two or more applications are claiming the same invention and the examiner does not deem it expedient to institute interference proceedings at that time, the examiner should make a record of the possible interference as on the face of the file wrapper in the space reserved for class and subclass designation. Such notations, however, if made on the file wrapper or drawings, must not be such as to give any hint to the applicants, who may inspect their own applications at any time, of the date or identity of a sup-

posedly interfering application. Serial numbers or filing dates of conflicting applications must never be placed upon drawings or file wrappers. A book of "Prospective Interferences" should be maintained containing complete data concerning possible interferences and the page and line of this book should be referred to on the respective file wrappers or drawings. For future reference, this book may include notes as to why prospective interferences were not declared.

In determining whether an interference exists, the primary examiner must decide the question. An examiner-in-chief may, however, be consulted for advice.

The group director should be consulted if it is believed that the circumstances justify an interference between applications neither of which is ready for allowance.

2301.02 Definitions [R-2]

37 CFR 1.601 Scope of rules, definitions. This subpart governs the procedure in patent interferences in the Patent and Trademark Office. This subpart shall be construed to secure the just, speedy, and inexpensive determination of every interference. For the meaning of terms in the Federal Rule of Evidence as applied to interferences, see §1.671(c). Unless otherwise clear from the context, the following definitions apply to this subpart:

(a) "Additional discovery" is discovery to which a party may be entitled under § 1.687 in addition to discovery to which the party is entitled as a matter of right under § 1.673(a) and (b).

(b) "Affidavit" means affidavit, declaration under § 1.68, or statutory declaration under 28 U.S.C. §1746. A transcript of an *ex parte* deposition may be used as an affidavit.

(c) "Board" means the Board of Patent Appeals and Interferences.

(d) "Case-in-chief" means that portion of a party's case where the party has the burden of going forward with evidence.

(e) "Case-in-rebuttal" means that portion of a party's case where the party presents evidence in rebuttal to the case-in-chief of another party.

(f) A "count" defines the interfering subject matter between (1) two or more applications or (2) one or more applications and one or more patents. When there is more than one count, each count shall define a separate patentable invention. Any claim of an application or patent which corresponds to a count is a claim involved in the interference within the meaning of 35 U.S.C. § 135(a). A claim of a patent or application which is identical to a count is said to "correspond exactly" to the count. A claim of a patent or application which is not identical to a count, but which defines the same patentable invention as the count, is said to "correspond substantially" to the count. When a count is broader in scope than all claims which correspond to the count, the count is a "phantom count." A phantom count is not patentable to any party.

(g) The "effective filing date" of an application or a patent is the filing date of an earlier application accorded to the application or patent under 35 U.S.C. §§ 119, 120, or 365.

(h) In the case of an application, "filing date" means the filing date assigned to the application. In the case of a patent, "filing date" means the filing date assigned to the application which issued as the patent.

(i) An "interference" is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. An interference may be declared between two or more pending applications naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention. An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an examiner, any application and any unexpired patent contain claims for the same patentable invention.

(j) An "interference-in-fact" exists when at least one claim of a party which corresponds to a count and at least one claim of an opponent which corresponds to the count define the same patentable invention.

(k) A "lead" attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an interference on behalf of a party and is the attorney or agent whom an examiner-in-chief may contact to set times and take other action in the interference.

(l) A "party" is (1) an applicant or patentee involved in the interference or (2) a legal representative or an assignee of an applicant or patentee involved in an interference. Where acts of a party are normally performed by an attorney or agent, "party" may be construed to mean the attorney or agent. An "inventor" is the individual named as inventor in an application involved in an interference or the individual named as inventor in a patent involved in an interference.

(m) A "senior party" is the party with earliest effective filing date as to all counts or, if there is no party with the earliest effective filing date as to all counts, the party with the earliest filing date. A "junior party" is any other party.

(n) Invention "A" is the "same patentable invention" as an invention "B" when invention "A" is the same as (35 U.S.C. § 102) or is obvious (35 U.S.C. §103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a "separate patentable invention" with respect to invention "B" when invention "A" is new (35 U.S.C. § 102) and non-obvious (35 U.S.C. § 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

(o) "Sworn" means sworn or affirmed.

(p) "United States" means the United States of America, its territories and possessions.

Under § 1.601, the rules shall be construed to secure the just, speedy, and inexpensive determination of interferences. Section 1.601 defines various terms used in Subpart E of the Rules of Practice including "additional discovery," "affidavit," "case-in-chief," "case-in-rebuttal," "count," "effective filing date," "filing date," "interference," "interference-in-fact," "junior party," "lead" attorney, "party," "phantom count," "same patentable invention," "separate patentable invention," "senior party," "sworn," and "United States." "Affidavits" include declarations under 35 U.S.C. § 25 amd 37 CFR § 1.68 as well as statutory declarations under 28 U.S.C. §1746. The definition "United States" is the same as the definition of United States in 35 U.S.C. § 100(c).

The definition of "interference" permits an interference between one or more applications and one or more patents. Thus, the revised rules follow the policy of *Wilson* v. *Yakel*, 1876 *C.D. 245 (Comm'r. Pat.* 1876) and, to the extent inconsistent therewith, do not follow the policy announced in *Touval* v. *Newcombe*, 194 USPQ 509 (Comm'r. Pat. 1976). However, in view of the statutory requirement for the presence of at least one application in an interference, if an applicant were to concede priority or otherwise be terminated from an interference involving only one application and more than one patent, the interference would have to be terminated for lack of subject matter jurisdiction unless one or more of the patentees filed an application for reissue which could be added to the interference under § 1.633(h).

A "count" defines interfering subject matter. An interference may have two counts only if the second count defines a "separate patentable invention" from the first count. The reason the second count must define a separate patentable invention is to permit the

PTO to lawfully issue separate patents to different parties in an interference when a single party does not prevail as to all counts. A "separate patentable invention" is defined in § 1.601(n):

> Invention (A) is a 'separate patentable invention' with respect to invention (B) when invention (A) is new (35 U.S.C. § 102) and non-obvious (35 U.S.C. §103) in view of invention (B) assuming invention (B) is prior art with respect to invention (A).

§ 2302 Ownership of Applications and Patents Involved in an Interference [R-2]

37 CFR 1.602 Interest in applications and patents involved in an interference. (a) Unless good cause is shown, an interference shall not be declared or continued between (1) applications owned by a single party or (2) applications and an unexpired patent owned by a single party.

(b) The parties, within 20 days after an interference is declared, shall notify the Board of any and all right, title, and interest in any application or patent involved or relied upon in the interference unless that right, title, and interest is set forth in the notice declaring the interference.

(c) If a change of any right, title, and interest in any application or patent involved or relied upon in the interference occurs after notice is given declaring the interference and before the time expires for seeking judicial review of final decision of the Board, the parties shall notify the Board of the change within 20 days of the change.

Section 1.602(a) continues the previous PTO practice (37 CFR § 1.201(c)) of not declaring or continuing an interference between (1) two or more applications owned by the same party or (2) an application and a patent owned by a single party unless good cause is shown. A corporation and its wholly-owned subsidiary are considered a "single party" within the meaning of § 1.602(a). Under prior rules, when a patent and an application involved in an interference became commonly owned, the interference was not "dissolved." Rather, the PTO required that the interference be terminated with a judgment. *Chillas* v. *Weisberg,* 1928 C.D. 24 (Comm'r. Pat. 1928); *Malone* v. *Toth,* 202 USPQ 397 (Comm'r. Pat. 1978); and *Morehouse* v. *Armbruster,* 209 USPQ 514 (Comm'r. Pat. 1980). Under the revised rules, all interferences, including those involving only applications, will be terminated with a judgment. As noted in *Chillas* v. *Weisberg, supra* at 25 "the common owner can allow a judgment against the junior party to be rendered by default or it can file a concession of priority from one party to the other." Paragraphs (b) and (c) of § 1.602 continue the previous PTO practice (37 CFR § 1.201(c)) of requiring a party to notify the PTO of any real party in interest not apparent on the face of the notice declaring the interference (see § 1.611) or of any change in the real party in interest after the interference is declared. The PTO needs to know the identity of any real party in interest to properly enforce § 1.602(a) and to enable an examiner-in-chief to determine whether refusal is necessary or appropriate. A new requirement in paragraph (b) and (c), of §1.602, not present in 37 CFR § 1.201(c), is a 20-day time period for advising the PTO of the identity of, or any change in, the real party in interest.

Common Ownership

Where applications by different inventive entities but of common ownership claim the same subject matter or subject matter that is not patentably different:

I. Interference therebetween is normally not instituted since there is no conflict of interest. Elimination of conflicting claims from all except one case should usually be required, 37 CFR 1.78(c). The common assignee must determine the application in which the conflicting claims are properly placed. Treatment by rejection is set forth in § 804.03.

II. Where an interference with a third party is found to exist, the commonly-owned application having the earliest effective filing date will be placed in intereference with the third party. The common assignee may move during the interference under 37 CFR 1.633(d) to substitute the other commonly-owned application, if desired.

§ 2303 Interference Between Applications [R-2]

1.603 Interference between applications; subject matter of the interference. Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant subject to a judgment in the interference. The interfering subject matter shall be defined by one or more counts. Each count shall define a separate patentable invention. Each application must contain, or be amended to contain, at least one claim which corresponds to each count. All claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count.

Where two or more applications are found to be claiming the same patentable invention they may be put in interference, dependent on the status of the respective applications and the difference between their filing dates. One of the applications should be in conditions for allowance. Unusual circumstances may justify an exception to this if the approval of the group director is obtained.

Interferences will not be declared between pending applications if there is a difference of more than 3 months in the effective filing dates of the oldest and next oldest applications, in the case of inventions of a simple character, or a difference of more than 6 months in the effective filing dates of the applications in other cases, except in exception situations, as determined and approved by the group director. One such exceptional situation would be where one application has the earliest effective filing date based on foreign priority and the other application has the earliest effective United States filing date. If an interference is declared, all applications having the same interfering subject matter should be included.

Before taking any steps looking to the formation of an interference, it is essential that the examiner make certain that each of the prospective parties is claiming the same patentable invention (as defined in 37 CFR 1.601(n)) and that at least one claim of each party corresponds to each count of the interference and is clearly readable upon the disclosure of that party and allowable in its application.

It is to be noted that while the claims of two or more applicants may not be identical, yet if directed to the same patentable invention, an interference exists. But mere disclosure by an applicant of an invention which he or she is not claiming does not afford a ground for suggesting to that applicant a claim for the said invention based upon claims from another application that is claiming the invention. The intention of the parties to claim the same patentable invention, as expressed in the summary of the invention or elsewhere in the disclosure or in the claims, is an essential in every instance.

When the subject matter found to be allowable in one application is disclosed and claimed in another application, but the claims therein to such subject matter are either nonelected or subject to election, the question of interference should be considered. The requirement of 37 CFR 1.601(i) that the conflicting applications shall contain claims for the same patentable invention should be interpreted as meaning generally that the conflicting claimed subject matter is sufficiently supported in each application and is patentable to each applicant over the prior art. The statutory requirement of first inventorship is of transcendent importance and every effort should be made to avoid the improvident issuance of a patent when there is an adverse claimant.

Following are illustrative situations where the examiner should take action toward instituting interference:

A. Application filed with claims to divisible inventions I and II. Before action requiring restriction is made, examiner discovers another case having allowed claims to invention I.

The situation is not altered by the fact that a requirement for restriction had actually been made but had not been responded to. Nor is the situation materially different if an election of noninterfering subject matter had been made without traverse but no action given on the merits of the elected invention.

B. Application filed with claims to divisible inventions I and II and in response to a requirement for restriction, applicant traverses the same and elects invention I. Examiner gives an action on the merits of I. Examiner subsequently finds an application to another containing allowed claims to invention II and which is ready for issue.

The situation is not altered by the fact that the election is made without traverse and the nonelected claims possibly cancelled.

C. Application filed with generic claims and claimed species a, b, c, d, and e. Generic claims rejected and election of a single species required. Applicant elects species a, but continues to urge allowability of generic claims. Examiner finds another application claiming species b which is ready for issue.

The allowability of generic claims in the first case is not a condition precedent to setting up interference.

D. Application filed with generic claims and claims to five species and other species disclosed but not specifically claimed. Examiner finds another application the disclosure and claims of which are restricted to one of the unclaimed species and have been found allowable.

The prosecution of generic claims is taken as indicative of an intention to cover all species disclosed which come under the generic claim.

In all the above situations, the applicant has shown an intention to claim the subject matter which is actually being claimed in another application. These are to be distinguished from situations where a distinct invention is claimed in one application but merely disclosed in another application without evidence of an intent to claim the same. The question of interference should not be considered in the latter instance. However, if the application disclosing but not claiming the invention is senior, and the junior application is ready for issue, the matter should be discussed with the group director to determine the action to be taken.

§ 2304 Applicant Requests Interference Between Applications [R-2]

37 CFR 1.604 Request for interference between applications by an applicant. (a) An applicant may seek to have an interference declared with an application of another by (1) suggesting a proposed count and presenting a claim corresponding to the proposed count, (2) identifying the other application and, if known, a claim in the other application which corresponds to the proposed count, and (3) explaining why an interference should be declared.

(b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where it appears an applicant may have failed to comply with the provisions of this paragraph.

§ 2305 Examiner Suggests Claim to Applicant [R-2]

37 CFR 1.605 Suggestion of claim to applicant by examiner. (a) The examiner may suggest that an applicant present a claim in an application for the purpose of an interference with another application or a patent. The applicant to whom the claim is suggested shall amend the application by presenting the suggested claim within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim. At the time the suggested claim is presented, the applicant may also (1) call the examiner's attention to other claims already in the application or which are presented with the suggested claim and (2) explain why the other claims would be more appropriate to be included in any interference which may be declared.

(b) The suggestion of a claim by the examiner for the purpose of an interference will not stay the period for response to any outstanding Office action. When a suggested claim is timely presented, *ex parte* proceedings in the application will be stayed pending a determination of whether an interference will be declared.

Although the subject of suggesting claims is treated in detail at this point in the discussion of a prospective interference between applications, essentially the same practice here outlined is also applicable to a prospective interference with a patent.

If the applications contain claims covering the entire interfering subject matter the examiner proceeds under 37 CFR 1.609 to form the interference; otherwise, proper claims must be suggested to some or all of the parties.

Under § 1.605, timely filing of an amendment presenting a claim suggested by the examiner for purposes of an interference would stay *ex parte* proceedings in the application in which the claim is presented pending a determination by the examiner of whether an interference will be declared. Also under § 1.605(a), when an examiner suggests a claim, the applicant will be required to copy verbatim the suggested claim. At the time the suggested claim is copied, however, the applicant may also (1) call the examiner's attention to other claims already in the application or which are presented with the copied claim and (2) explain why the other claims would be more appropriate to be included in any interference which may be declared.

It should be noted at this point that if an applicant presents a claim which corresponds exactly or substantially to a claim in another application or patent without suggestion by the examiner, 37 CFR 1.604(b) and 1.607(c) require him or her to identify the other application or patent. See § 2308.

The question of what claim or claims to suggest in the interfering applications is one of great importance, and failure to suggest such claims as will define clearly the matter in issue leads to confusion and to prolongation of the contest.

Before deciding what claim or claims to suggest to an applicant, the examiner should decide what the count or counts of the prospective interference will be, keeping in mind that the count must be patentable over the prior art and define the parties' common invention (see § 2309 regarding the formulation of counts). The claim suggested to the applicant need not be identical to the prospective count, but rather should be the broadest claim within the scope of the prospective count which the applicant's disclosure will support, and which is otherwise patentable to the applicant.

A response to the examiner's suggestion of a claim is not complete unless it includes an amendment adding the *exact* claim suggested to the application. Even though the applicant may consider the suggested claim unpatentable, too narrow, or otherwise unsuitable, it must be presented; otherwise, the invention defined by the suggested claim is considered to be disclaimed. The applicant must make known any such objections to the examiner, and may at the same time present other claims, or call the examiner's attention to other claims already in the application, and explain why those claims would be more appropriately included in the interference.

If, in copying a suggested claim, an error is introduced by the applicant, the examiner should correct the applicant's claim to correspond to the suggested claim.

Notification of the fact that the parties have the same attorney should be given to both parties at the time claims are suggested event though claims are suggested to only one party. See also § 2313.01. Notation of the persons to whom this letter is mailed should be made on all copies.

The following sentence is usually added to the letter suggesting claims where the same attorney or agent is of record in applications of different ownership which have conflicting subject matter:

> Attention is called to the fact that the attorney (or agent) in this application is also the attorney (or agent) is an application of another party and of different ownership claiming substantially the same patentable invention as claimed in the above-identified application.

The attention of the Commissioner is not called to the fact that two conflicting parties have the same attorney until an actual interference is set up and then it is done by notifying the examiner-in-chief as explained in § 2308.01.

Form Paragraphs 11.04 and 11.05 may be used to suggest claims for purposes of interference to applicants.

Form Paragraph 11.04

SUGGESTION OF CLAIM

The following allowable claim is suggested for the purpose of an interference:

[1]

The suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

APPLICANT SHOULD MAKE THE SUGGESTED CLAIM WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. FAILURE TO DO SO WILL BE CONSIDERED A DISCLAIMER OF THE SUBJECT MATTER OF THIS CLAIM UNDER THE PROVISIONS OF 37 CFR 1.605(a). THE PROVISIONS OF 37 CFR 1.136(a) DO NOT APPLY TO THIS TIME PERIOD.

Claim [2] considered unpatentable over the above suggested claim.

Examiner Note:

1. In bracket 1, insert the suggested claim.
2. In bracket 2, list *all* claims pending in the application not considered to be patentably distinct from the suggested claim.
3. Only one claim should be suggested unless claims to a separate patentably distinct invention are present. 37 CFR 1.601(n). To suggest an additional claim to a separate distinct invention, form paragraph 11.05 should follow this paragraph.
4. If the Office action addresses other issues, such as a rejection of other claims, paragraph 11.06 should be included at the end of the action.

Form Paragraph 11.05

SUGGESTION OF ADDITIONAL CLAIM FOR A DISTINCT INVENTION

The following claim is considered allowable and directed to a separate patentable invention from the claim suggested above:

[1]

The additionally suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

APPLICANT MUST ALSO MAKE THIS ADDITIONALLY SUGGESTED CLAIM WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. FAILURE TO DO SO WILL BE CONSIDERED A DISCLAIMER OF THE SUBJECT OF THIS CLAIM UNDER THE PROVISIONS OF 37 CFR 1.605(a). THE PROVISIONS OF 37 CFR 1.136(a) DO NOT APPLY TO THIS TIME PERIOD.

Claim [2] considered unpatentable over this additionally suggested claim.

Examiner Note:

This paragraph must be preceded by paragraph 11.04 and should only be used to suggest a patentably distinct claim from the one suggested in paragraph 11.04.

Form Paragraph 11.06

SUGGESTION OF CLAIMS—PROSECUTION SUSPENDED

Applicant need not respond to the remaining issues in this action if a suggested claim is copied for the purpose of an interference within the time limit specified above. 37 CFR 1.605(b).

Examiner Note:

This paragraph should be used at the end of any Office action where claims are suggested using either paragraph 11.04 or 11.08 and where additional issues (e.g., a rejection of other claims) are addressed in the action that will be suspended should applicant copy the suggested claim.

2305.01 Action To Be Made at Time of Suggesting Claims [R-2]

At the same time that the claims are suggested an action is made on each of the applications that are up for action by the examiner, whether they be new or amended cases. In this way possible motions under 37 CFR 1.633 (c) and (d) may be forestalled. That is, the action on the new or amended case may bring to light patentable claims that should be included as corresponding to the count of, or as forming the basis for an additional count of the interference, and, on the other hand, the rejection of unpatentable claims will serve to indicate to the opposing parties the position of the examiner with respect to such claims.

When an examiner suggests that an applicant present a claim for interference, the examiner should state which of the claims already in the case are, in his or her opinion, unpatentable over the claim suggested. This statement does not constitute a formal rejection of the claims, but if the applicant presents the suggested claim but disagrees with the examiner's statement, the applicant should so state on the record, not later than the time the claim is presented. *In re Dandel,* 348 F.2d 563, 146 USPQ 389 (CCPA 1965). If the applicant does not present the suggested claim by the expiration of the period fixed for its presentation, the examiner should then reject those claims which were previously stated as being unpatentable over the suggested claim on the basis that the failure to present constituted a concession that the subject matter of those claims is the prior invention of another in this country under 35 U.S.C. 102(g) and thus prior art to the applicant under § 103. *In re Oguie,* 517 F.2d 1382, 186 USPQ 227 (CCPA 1975). If the applicant does present the suggested claim, when the interference is declared, the claims stated to be unpatentable over the suggested claim will be designated as corresponding to the count.

2305.02 Time Limit Set for Presenting Suggested Claims [R-2]

Where claims are suggested for interference, a limited period determined by the examiner, not less than one month, is set for reply. See § 710.02(c).

Should any one of the applicants fail to present the claim or claims suggested within the time specified, all claims not patentable to that applicant thereover are rejected on the ground that the applicant has disclaimed the invention to which they are directed. If the applicant presents the suggested claims later they will be rejected on the same ground. (See § 706.03(u).)

2305.03 Suggested Claims Presented After Period for Response Running Against Case [R-2]

If suggested claims are presented within the time specified for making the claims, the applicant may ignore any outstanding rejections in the application. Even if claims are suggested in an application near the end of the period for response running against the case, and the time limit for presenting the claims extends beyond the end of the period, such claims will be admitted if filed within the time limit even though outside the period for response to the rejection (usually a three month shortened statutory period) and even though no amendment was filed responsive to the Office action outstanding against the case at the time of suggesting the claims. No portion of the case is abandoned provided the applicant presents the suggested claims within the time specified. However, if the suggested claims are not thus presented within the specified time, the case becomes abandoned in the absence of a responsive amendment filed within the period for response to the rejection. 37 CFR 1.605(b).

2305.04 Suggestion of Claims, Application in Issue or in Interference [R-2]

An application will not be withdrawn from issue for the purpose of suggesting claims for an interference. When an application pending before the examiner contains one or more claims defining an invention to which claims may be presented in a case in issue, the examiner may write a letter suggesting such claims to the applicant whose case is in issue, stating that if such claims be presented within a certain specified time the case will be withdrawn from issue, the amendment entered and the interference declared. Such letters must be submitted to the group director. If the suggested claims are not presented in the application in issue, it may be necessary to withdraw it from issue for the purpose of rejecting other claims on the implied disclaimer resulting from the failure to present the suggested claims.

When the examiner suggests one or more claims for the purpose of interference with a case in issue to an applicant whose case is pending before him or her, the case in issue will not be withdrawn for the purpose of interference unless the suggested claims shall be presented in the pending application within the time specified by the examiner. The letter suggesting claims should be submitted to the group director for approval.

In either of the above cases the Publishing Division should be notified when the claims are suggested, so that in case the issue fee is paid during the time in which the suggested claims may be presented, proper

steps may be taken to prevent the issue fee from being applied.

The examiner should borrow the allowed application from the Publishing Division and hold the file until the claims are presented or the time limit expires. This avoids any possible issuance of the application as a patent should the issue fee be paid. To further insure against the issuance of the application, the examiner may pencil in the blank space labeled, "Date paid" in the lower right-hand corner of the file wrapper the initialled request: "Defer for interference." The issue fee is not applied to such an application until the following procedure is carried out.

When notified that the issue fee has been received, the examiner shall prepare a memo to the Publishing Division requesting that issue of the patent be deferred for a period of three months due to a possible interference. This allows a period of two months to complete any action needed. At the end of this two month period, the application must either be released to the Publishing Division or be withdrawn from issue.

When an application is found claiming an invention for which claims are to be suggested to other applications already involved in interference, to form another interference, the primary examiner borrows the last named applications from the Service Branch of the Board of Patent Appeals and Interferences. In case the application is to be added to an existing interference, the primary examiner need only send the application and Form PTO-850 (illustrated in § 2309.02), properly filled out as to the additional application and identifying the interference, to the examiner-in-chief in charge of the interference who will determine the action to be taken. Also see § 2342.

Form Paragraph 11.07

SUGGESTION OF CLAIMS-APPLICATION IN ISSUE

This application has been withdrawn from issue for consideration of a potential interference based on the claims suggested in this action.

Examiner Note:

1. If a conflicting application is in issue, it should be withdrawn using paragraphs 10.01 or 10.02 *prior* to suggesting claims for interference.
2. Either paragraph 11.04 or 11.08 must be used in conjunction with this paragraph.

Form Paragraph 11.08

REQUIREMENT TO COPY PATENT CLAIM

The following claim number [1] from U.S. patent no. [2] is suggested to applicant under 35 U.S.C. 135(a) for the purpose of an interference:

[2]

The suggested claim must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a).

APPLICANT MUST COPY THE PATENT CLAIM WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. THE EXTENSION OF TIME PROVISIONS OF § 1.136(a) DO NOT APPLY TO THIS TIME PERIOD. FAILURE TO COPY THE CLAIM WILL BE TAKEN AS A CONCESSION THAT THE SUBJECT MATTER OF THIS CLAIM IS THE PRIOR INVENTION OF ANOTHER UNDER 35 U.S.C. 102(g) AND THUS ALSO PRIOR ART UNDER 35 U.S.C. 103. *In re* Ogiue, 186 U.S.P.Q. 227 (CCPA 1975).

Examiner Note:

1. In bracket 1, insert the number from the patent of the suggested claim.
2. In bracket 2, insert a copy of the patent claim.
3. Only one claim from the patent should be suggested for interference unless other claims to a separate patentably distinct invention are claimed in the patent and can be made by the applicant. To suggest an additional claim, paragraph 11.09 should follow this paragraph.
4. If the Office action addresses other issues, such as a rejection of other claims, paragraph 11.06 should be included at the end of the Office action.

Form Paragraph 11.09

COPYING ADDITIONAL PATENT CLAIM FOR A DISTINCT INVENTION

Claim number [1] from U.S. patent no. [2] is suggested under 35 U.S.C. 135(a) in addition to claim [3] of the patent, suggestd above. The inventions defined by these patent claims are considered to be "separate patentable inventions" under 37 CFR 1.601(n) that could form the basis for plural counts in an interference.

The suggested patent claim, reproduced below, must be copied exactly, although other claims may be proposed under 37 CFR 1.605(a):

[4]

APPLICANT MUST COPY THE ADDITIONAL PATENT CLAIM WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. THE EXTENSION OF TIME PROVISIONS OF 37 CFR 1.136(a) DO NOT APPLY TO THIS TIME PERIOD. FAILURE TO COPY THIS ADDITIONAL CLAIM WILL BE TAKEN AS A CONCESSION THAT THE SUBJECT MATTER OF THIS CLAIM IS THE PRIOR INVENTION OF ANOTHER UNDER 35 U.S.C. 102(g).

Examiner Note:

1. In bracket 1 insert the number of the patent claim that is patentably distinct from the claim specified in paragraph 11.08.
2. This paragraph must follow paragraph 11.08 and should only be used in those rare instances where both the patent and the application claim distinct, interfering inventions.

Form Paragraph 11.11

FAILURE TO APPLY TERMS OF COPIED CLAIM TO THE DISCLOSURE

Claim [1] of this application has been copied from U.S. patent [2] for the purpose of an interference.

Applicant has failed to specifically apply the terms of the copied claim to the disclosure of the application, as required under 37 CFR 1.607(a)(3).

APPLICANT IS REQUIRED TO CORRECT THIS DEFICIENCY WITHIN ONE MONTH FROM THE DATE OF THIS LETTER. THE EXTENSION OF TIME PROVISIONS OF 37 CFR 1.136(a) DO NOT APPLY TO THIS TIME PERIOD.

Form Paragraph 11.18

FOREIGN PRIORITY NOT SUBSTANTIATED

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119 prior to declaration of an interference, a sworn translation of the foreign application should be submitted under 37 CFR 1.55 in response to this action.

Examiner Note:

This paragraph may be used when claims are suggested to applicant from either an application or a patent and applicant has a claim for priority not substantiated by a sworn translation.

2306 Interference Between an Application and a Patent [R-2]

37 CFR 1.606 Interference between an application and a patent; subject matter of the interference. Before an interference is declared between an application and an unexpired patent, an examiner must determine that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference. The interfering subject matter will be defined by one or more counts. Each count shall define a separate patentable invention. Any application must contain, or be amended to contain, at least one claim which corresponds to each count. All claims in the application and patent which define the same patentable invention as a count shall be designated to correspond to the count. At the time an interference is initially declared (§ 1.611), a count shall not be narrower in scope than any patent claim which corresponds to the count any any single patent claim will be presumed, subject to a motion under § 1.633(c), not to contain separate patentable inventions.

An interference may be declared between an application and a patent if the application and patent are claiming the same patentable invention, and at least one of the applicant's claims to that invention are patentable to the applicant. Since at least one of the applicant's claims must be patentable, an interference between an application and a patent cannot be declared if:

1. The patent is a statutory bar against the application under 35 U.S.C. 102(b);

2. The applicant's claims are not supported by the application disclosure, or otherwise do not comply with 35 U.S.C. 112;

3. The applicant was not claiming the same or substantially the same invention as claimed in the patent within one year after the date on which the patent was issued (35 U.S.C. 135(b));

4. The patent is a reference against the application under 35 U.S.C. 102(e), unless the applicant has filed a showing under 37 CFR 1.608. See § 2307 concerning the rejection of claims in an application which correspond to claims of a patent.

Since the claims of a patent may not be altered (except by reissue or reexamination), the applicant must claim the same patentable invention as is claimed in one or more claims of a patent in order to provoke an interference with the patent. The fact that the patent may disclose subject matter claimed by the applicant is not a basis for interference if the patent does not claim that subject matter.

The practice followed prior to the adoption of 37 CFR 1.606, wherein each patent claim formed the basis for a separate count of the interference, no longer applies. Under present practice, the counts of the interference are formulated in essentially the same manner regardless of whether a patent is involved. As stated in 37 CFR 1.606, each count "shall define a separate patentable invention." Therefore, instead of having the same number of counts as copied patent claims, the examiner determines how many separate patentable inventions are claimed by the applicant and the patentee. When the interference is declared, there will be one count for each separate patentable invention, with all the claims of the applicant and of the patentee which claim each invention designated as corresponding to the count for that invention. See § 2309 for a more detailed discussion of the formulation of counts.

An interference between an application and a patent may arise in one of the following ways:

1. During examination of an application, the examiner may determine that the application contains one or more allowable claims which are drawn to the same invention as claimed in a patent. In that event, the examiner may proceed to initiate the interference as described in § 2305.

2. The examiner may discover a patent which claims an invention which is disclosed by the applicant and to which the applicant could present patentable claims. In that event, the examiner may suggest to the applicant a claim which would define the same invention and would be patentable to the applicant. See § 2305.

3. The applicant may provoke an interference with a patent by presenting a proposed count and a claim corresponding thereto.

The requirement that the claims of the application and of the patent define the same patentable invention in order for an interference to exist does not mean that the application claim or claims must necessarily be identical to the corresponding claim or claims of the patent. All that is required under present practice is that a claim of the application be drawn to the same patentable invention as a claim of the patent. An application claim is considered to be drawn to the same patentable invention as a patent claim if it recites subject matter which is the same as (35 U.S.C. 102), or obvious in view of (35 U.S.C. 103), the subject matter recited in the patent claim. 37 CFR 1.601(n). The test is analogous to that applied for double patenting, i.e., if the applicant's claim would have been subject to a double patenting rejection of the "same invention" or "obviousness" type (see § 804) if the patent and application were by the same inventive entity, then the application and patent claim are directed to the same invention. In all cases the examiner should keep in mind the fundamental principle that the issuance of two patents for inventions which are either identical to or not patentably distinct from each other must be avoided. *Aelony* v. *Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977).

37 CFR 1.601(i) includes the possibility that an interference may include more than one unexpired patent. The PTO does not have jurisdiction to determine interferences involving only patents, since 35 U.S.C. 291 grants that jurisdiction to the courts. However, if the examiner discovers two or more patents which are claiming the same invention as an application, an interference may be instituted between

the application and the patents. The group director's approval must be obtained before an interference involving multiple patents will be declared.

When an interference with a patent is proposed it should be ascertained before any steps are taken whether there is common ownership. Note § 804.03. A title report must be placed in both the application and the patented file when the papers for an interference between an application and a patent are forwarded. To this end the examiner, before initiating an interference involving a patent, should refer both the application and the patented file to the Assignment Division for notation as to ownership.

PATENT IN DIFFERENT GROUP

When an applicant seeks to provoke an interference with a patent classified in another group, the propriety of declaring the interference is decided by and the interference is initiated by the group where the patent is classified. In such a case, it may be necessary to transfer the application, including the drawings, temporarily to the group which will initiate the interference.

Under § 1.606, at the time an interference is declared a *rebuttable* presumption will exist that any patent claim designated to correspond to a count does not embrace separate patentable inventions. Moreover, at the time the interference is declared, no count will be narrower in scope than the broadcast patent claim designated to correspond to that count. The presumption is *rebuttable* and may be challenged and overcome by a motion under § 1.633(c).

2307 Applicant Requests Interference With a Patent [R-2]

37 CFR 1.607 Request by applicant for interference with patent. (a) An applicant may seek to have an interference declared between an application and an unexpired patent by (1) presenting a proposed count and a claim corresponding to the proposed count and, if any claim of the patent or application does not correspond exactly to the proposed count, explaining why an interference should be declared, (2) identifying the patent and indicating which claim in the application and which claim or claims of the patent correspond to the proposed count, and (3) applying the terms of the application claim corresponding to the count to the disclosure of the application.

(b) When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office. The examiner shall determine whether there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in an interference. If the examiner determines that there is any interfering subject matter, and interference will be declared. If the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared and otherwise act on the application.

(c) When an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where an applicant fails to identify the patent.

(d) A notice that an applicant is seeking to provoke an interference with a patent will be placed in the file of the patent and a copy of the notice will be sent to the patentee. The identity of the applicant will not be disclosed unless an interference is declared. If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

2307.01 Presentation of Claims Corresponding to Patent Claims Not a Response to Last Office Action [R-2]

The presentation of claims corresponding to claims of a patent when not suggested by the Office does not constitute a response to the last Office action unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

Under 37 CFR 1.615, upon declaration of an interference, ex parte prosecution of an application involved in the interference is suspended and any outstanding Office actions are considered as withdrawn by operation of the rule. *Ex parte Peterson,* 49 USPQ 119 (Com'r. 1941). Upon termination of the interference, the examiner will reinstate the action treated as withdrawn by operation of 37 CFR 1.615 and set a statutory period for response.

2307.02 Rejection of Claims Corresponding to Patent Claims [R-2]

REJECTION NOT APPLICABLE TO PATENT

When claims corresponding to claims of a patent are presented, the application is taken up at once and the examiner may reject such claims in the application if the ground of rejection would not also be applicable to the patent. Examples of such grounds of rejection are insufficient disclosure in the application, a reference whose date is junior to that of the patent, or because the claims are barred to applicant by the second paragraph of 35 U.S.C. 135, which reads: "(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted." See *Ex parte Fine,* 217 USPQ 76 (Bd. App. 1981). The anniversary date of the issuance of a patent is "prior to one year from the date on which the patent was granted", *Switzer* v. *Sockman,* 333 F.2d 935, 142 USPQ 226 (CCPA 1964).

It should be noted that an applicant is permitted to copy a patent claim outside the year period if he has been claiming substantially the same subject matter within the year limit. See *Thompson* v. *Hamilton,* 152 F.2d 994, 68 USPQ 161 (CCPA 1946); *In re Frey,* 182 F.2d 184, 86 USPQ 99 (CCPA 1950); *Andrews* v. *Wickenden,* 194 F.2d 729, 93 USPQ 27 (CCPA 1952); *In re Tanke,* 213 F.2d 551, 102 USPQ 93 (CCPA 1954); *Emerson* v. *Beach,* 215 F.2d 290, 103 USPQ 45 (CCPA 1955); *Rieser* v. *Williams,* 255 F.2d 419, 118 USPQ 96 (CCPA 1958); *Stalego* v. *Heymes,* 263 F.2d 334, 120 USPQ 473 (CCPA 1959); *Corbett* v. *Chisholm,* 568 F.2d 759, 196 USPQ 337 (CCPA 1977).

As long as one of the presented claims is patentable to the applicant and is claiming the same invention as at least one claim of the patent, an interference should be declared.

37 CFR 1.607(b) requires that "When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office." Therefore, when all the claims presented are rejected on a ground not applicable to the patentee the examiner sets a time limit for reply, not less than thirty days, and all subsequent actions, including action of the Board on appeal, are special. Failure to respond or appeal, as the case may be, within the time fixed, will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

While the time limit for an appeal from the final rejection of a claim corresponding to a patent claim is usually set under the provisions of 37 CFR 1.607(b), where the remainder of the case is ready for final action, it may be advisable to set a shortened statutory period for the entire case in accordance with 37 CFR 1.134.

The distinction between a limited time for reply under 37 CFR 1.607(b) and a shortened statutory period under 37 CFR 1.134 should not be lost sight of. The penalty resulting from failure to reply within the time limit under 37 CFR 1.607(b) is loss of the claim or claims involved, on the doctrine of disclaimer, and this is appealable; while failure to respond within the set statutory period (37 CFR 1.134) results in abandonment of the entire application. That is not appealable.

The rejection of claims presented for interference with a patent sometimes creates a situation where two different periods for response are running against the application—one, the statutory period dating from the last full action on the case; the other, the limited period set for the response to the rejection (either first or final) of the presented claims. This condition should be avoided where possible as by setting a shortened period for the entire case, but where unavoidable, it should be emphasized in the examiner's letter.

In this connection it is to be noted that a reply to a rejection or an appeal from the final rejection of the presented claims will not stay the running of the regular statutory period if there is an unanswered Office action in the case at the time of reply or appeal, nor does such reply or appeal relieve the examiner from the duty of acting on the case if it is up for action, when reached in its regular order.

Where an Office action sets a time limit for response to or appeal from that action or a portion thereof, the examiner should note at the end of the letter the date when the time limit period ends and also the date when the statutory period ends. See § 710.04.

Rejection Applicable to Patent and Application

If the ground of rejection is applicable to both the claims in the application and the claims in the patent, any letter including the rejection must have the approval of the group director. See § 1003, item 10.

An interference will not be declared where the examiner is aware of a reference for the claims which correspond to the patent claims, even if it would also be applicable to the patent. If such a reference is discovered while an interference involving a patent is pending, the examiner should call the reference to the attention of the examiner-in-chief in charge of the interference, for possible action under 37 CFR 1.641.

Form Paragraph 11.12

REJECTION OF CLAIM CORRESPONDING TO PROPOSED COUNT

Claim [1] of this application has been copied by the applicant from U.S. patent No. [2]. This claim is not patentable to the applicant because [3].

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

Examiner Note:

This paragraph must be preceded by a rejection of the claim.

Form Paragraph 11.13

CLAIMS NOT COPIED WITHIN ONE YEAR

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S patent [2] was granted.

Form Paragraph 11.14

COPIED CLAIMS DRAWN TO DIFFERENT INVENTION

Claim [1] of this application is asserted by applicant to correspond to claims of U.S. patent [2].

The examiner does not consider this claim to be directed to the same invention as that of U.S. patent [3] because [4]. Accordingly, an interference cannot be initiated based upon this claim.

§ 2307.03 Presentation of Claims for Interference With a Patent, After Prosecution of Application is Closed [R–2]

An amendment presenting a claim to provoke an interference in an application not in issue is usually admitted and promptly acted on. However, if the case had been closed to further prosecution as by final rejection or allowance of all of the claims, or by appeal, such amendment is not entered as a matter of right.

An interference may result when an applicant presents claims to provoke an interference with a patent which provided the basis for final rejection. Where this occurs, if the rejection in question has been appealed, the Board of Patent Appeals and Interferences should be notified of the withdrawal of this rejection so that the appeal may be dismissed as to the involved claims.

Where the prosecution of the application is closed and the presented claims relate to an invention distinct from that claimed in the application, entry of the amendment may be denied (*Ex parte Shohan*, 1941 C.D. 1 (Comr. 1940)). Admission of the amendment may very properly be denied in a closed application, if *prima facie*, the claims are not supported by applicant's disclosure. An applicant may not have recourse to presenting a claim corresponding to a patent claim

which applicant has no right to make as a means to reopen or prolong the prosecution of his case. See § 714.19(4).

AFTER NOTICE OF ALLOWANCE

When an amendment which includes one or more claims presented to provoke an interference with a patent is received after the Notice of Allowance and the examiner finds one or more of the claims patentable to the applicant and an interference to exist, the examiner should prepare a letter, requesting that the application be withdrawn from issue for the purpose of interference. This letter, which should designate the claims to be involved, together with the file and the proposed amendment, should be sent to the group director.

When an amendment which includes one or more claims presented to provoke an interference with a patent is received after Notice of Allowance, and the examiner finds basis for refusing the interference on any ground, the examiner should make an oral report to the supervisory primary examiner of the reasons for refusing the requested interference. Notification to applicant is made on Form PTOL-271 if the entire amendment or a portion of the amendment (including all the presented claims) is refused. Form Paragraph 11.01 should be employed to express the adverse recommendation as to the entry of the presented claims.

§ 2307.04 Presentation of Claims For Interference With a Patent Involved in a Reexamination Proceeding [R-2]

An interference will not be declared with a patent which is involved in a reexamination proceeding except upon specific authorization from the Office of the Assistant Commissioner for Patents. When an amendment is filed in a pending application presenting claims for the purpose of interference with a patent involved in a reexamination proceeding, the owner of the patent must be notified (see 37 CFR 1.607(d). The applicant must identify the patent under reexamination with which interference is sought. The claims may be rejected on any applicable ground, including, if appropriate, the prior art cited in the reexamination proceeding. Prosecution of the application should continue as far as possible, but if the application is placed in condition for allowance and still contains claims which interfere with the patent under reexamination, further action on the application should be suspended until the reexamination proceeding is terminated. See also § 2284.

Form Paragraph 11.15.

PATENT CLAIMS UNDERGOING REEXAMINATION

This application contains claims which conflict with the claims of U.S patent No. [1], now involved in a reexamination proceeding.

Prosecution in this application is SUSPENDED UNTIL TERMINATION OF THE REEXAMINATION PROCEEDING.

Applicant should inquire as to the status of this application six months from the date of this letter.

Examiner Note:

This paragraph should only be used when the application is otherwise in condition for allowance.

2307.05 Corresponding Patent Claims Not Identified [R-2]

37 CFR 1.607(c) requires that "when an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner."

This requirement of 37 CFR 1.607(c) applies to claims presented in an application at the time of filing as well as to claims presented in an amendment to a pending application. If an applicant, attorney, or agent presents a claim corresponding exactly or substantially to a patent claim without complying with 37 CFR 1.607(c) the examiner may be led into making an action different from what would have been made had the examiner been in possession of all the facts. Therefore, failure to comply with 37 CFR 1.607, when presenting a claim corresponding to a patent claim, may result in the issuance of a requirement for information as to why an identification of the source of the claim was not made.

The examiner should require the applicant to supply a full identification of the copied patent claims by using Form Paragraph 11.10.

Form Paragraph 11.10.

FAILURE TO IDENTIFY SOURCE OF PATENT CLAIMS

Claim ( ) of this application has apparently been copied from a U.S. patent without being suggested by the examiner. The patent number and the number of the copied claim have not been properly identified. 37 CFR 1.607(c).

Applicant is required to identify the patent and claim numbers and supply information explaining why a complete identification of the copied patent claim(s) has not been presented. Following applicant's response to this requirement or the abandonment thereof, the application will be forwarded by the examiner to the Office of the Assistant Commissioner for Patents for appropriate review as noted under 37 CFR 1.607(c).

APPLICANT IS REQUIRED TO RESPOND TO THIS REQUIREMENT WITHIN ONE MONTH FROM THE DATE OF THIS LETTER TO AVOID ANY QUESTION OF ABANDONMENT.

Examiner Note:

The primary examiner must refrain from commenting as to the reasons for applicant's failure to disclose the U.S. patent identification.

After the applicant's response or abandonment of the application, the examiner is required to "notify the Commissioner of any instance where an applicant fails to identify the patent" under 37 CFR 1.607(c). The examiner's notification should be in the form of a memorandum directed to the Office of the Assistant Commissioner for Patents. The memorandum must be accompanied by the application and a copy of the patent from which the claim(s) was copied.

2307.06 Presentation of Claims for Interference With a Patent, Patentee Must be Notified [R–2]

When an applicant seeks to provoke an interference with a patent, 37 CFR 1.607(d) requires that the patentee be notified (1) when the attempt to provoke the interference is first made, and (2), if an interference is not declared, of the final decision not to declare an interference.

This regulation provides a patentee with notice as soon as an applicant attempts to provoke an interference with the patent so that the patentee can preserve the invention records from the moment the notice is received until the time, in some instances many years later, when the interference is ultimately declared between the patentee and the applicant.

Form Paragraphs 11.19 and 11.20 should be used to notify the patentee.

Form Paragraph 11.19

NOTICE TO PATENTEE, INTERFERENCE SOUGHT

You are hereby notified under 37 CFR 1.607(d) that an applicant is seeking to provoke an interference with your patent No. [1].

The identity of the applicant will not be disclosed unless an interference is declared.

If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

If an interference is declared, notice thereof will be made under 37 CFR 1.611.

Form Paragraph 11.20

NOTICE TO PATENTEE, INTERFERENCE NOT DECLARED

Notice was communicated to you under 37 CFR 1.607(d) on [1] that an applicant was seeking to provoke an interference with your U.S. patent No. [2].

A final determination of this issue has resulted in a decision not to declare an interference.

No inquiries regarding the identity of the applicant will be entertained.

Examiner Note:

In bracket 1, insert the date of mailing of the earlier notice that claims had been copied from that patent.

It is anticipated that patentees may make inquiries as to the status of the application after the first notification has been received. Since the group having responsibility for the application will be indicated on the letter and the letter will not contain any information pertaining to that application, it will be necessary for each patent examining group to establish and maintain some type of permanent record. The type of permanent record is left to the discretion of the group director. This permanent record must be independent of the application file and the patented file in order to provide adequate information for patentee inquiries relative to non-receipt of either a second notice or a notice of declaration of interference either before or after either is mailed from the Patent and Trademark Office. Additionally, the permanent record must associate both the appropriate patent number and the serial number of the application. This record could be a separate group file for 1.607(d) notices sent to patentees having appropriate identification of the patent and application.

In summary, a 37 CFR 1.607(d) notice (Form paragraph 11.19) is prepared by a person in the group having jurisdiction over the application attempting to provoke an interference with a patent. The original is placed of record in the patented file, one copy is sent to the patentee, and an entry is made in the permanent group record for 37 CFR 1.607(d) notices. If a final decision is made that no interference will be declared, a primary examiner will prepare and sign a 37 CFR 1.607(d) notice (Form paragraph 11.20).

The original of this notice is entered of record in the patented file, one copy is sent to the patentee, and another entry is made in the permanent record for 37 CFR 1.607(d) notices. If an interference is to be instituted, the declaration of interference notice will be sent by an examiner-in-chief and no additional form will be sent by the examiner.

ALTHOUGH THE PERMANENT RECORD FOR SECTION 1.607(d) NOTICES INCLUDES IDENTIFICATION BOTH OF THE PATENT AND APPLICATION, THE PATENTEE CANNOT AND SHOULD NOT BE GIVEN ANY INFORMATION CONCERNING THE PARTY OR APPLICATION ATTEMPTING TO PROVOKE AN INTERFERENCE UNLESS AND UNTIL AN INTERFERENCE IS DECLARED. 35 U.S.C. 122.

2308 Interference Between an Application and a Patent; Prima Facie Showing by Applicant [R–2]

37 CFR 1.608 Interference between an application and a patent; prima facie showing by applicant. (a) When the earlier of the filing date or effective filing date of an application is three months or less after the earlier of the filing date or effective filing date of a patent, the applicant, before an interference will be declared, shall file an affidavit alleging that there is a basis upon which applicant is entitled to a judgment relative to the patentee.

(b) When the earlier of the filing date or the effective filing date of an application is more than three months after the earlier of the filing date or the effective filing date under 35 U.S.C. § 120 of a patent, the applicant, before an interference will be declared, shall file (1) evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and (2) an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment. Where the basis upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would *prima facie* entitle the applicant to judgment on priority with respect to the earlier of the filing date or effective filing date of the patent. To facilitate preparation of a record (§ 1.653 (g) and (h)) for final hearing, an applicant should file affidavits on paper which is 8½ x 11 inches (21.8 by 27.9 cm.). The significance of any printed publication or other document which is self-authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the

explanation. Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of sufficient cause, an affidavit may be based on information and belief. If a examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the applicant would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

Under § 1.608, the PTO will continue the previous practice under deleted 37 CFR § 1.204(c) of requiring an applicant seeking to provoke an interference with a patent to submit evidence which demonstrates that the applicant is *prima facie* entitled to a judgment relative to the patentee. Evidence would be submitted only when the earlier of the filing date or effective filing date of the application is more than three months after the earlier of the filing date or effective filing date under 35 U.S.C. § 120 of the patent. The evidence may relate to patentability and need not be restricted to priority. When the evidence (1) consists of prior printed publications and patents and (2) shows that the claims of the application are not patentable, the claims in the application would be rejected and the applicant could file a request for reexamination of the patent.

2308.01 Patent Has Filing Date Earlier than Application [R-2]

When an applicant attempts to provoke an interference with a patent, the examiner must determine the effective filing dates of the application and of the patent. In determining the effective filing date of the patent, only the patent's effective United States filing date will be considered. Any claim of foreign priority by the patentee under 35 U.S.C. 119 will not be taken into account when determining whether or not an interference should be declared, in order to be consistent with the holding in *In re Hilmer,* 359 F.2d 859, 149 USPQ 480 (CCPA 1966) to the effect that the effective date of a United States patent *as a reference* is not affected by the foreign filing date to which the patentee may be entitled under 35 U.S.C. 119. If the patentee is determined to be entitled to the benefit of a prior United States application as to claimed subject matter involved in the interference, that application must be listed on the PTO-850 form (see § 2309).

If the effective date of the applicant is three months or less later than that of the patented application, the applicant must submit an affidavit or declaration alleging that there is a basis upon which applicant is entitled to a judgment relative to the patentee, 37 CFR 1.608(a). The affidavit or declaration may be made by persons other than the applicant. See § 715.04.

If the effective filing date of the application is more than three months after the effective filing date of the patent, 37 CFR 1.608(b) requires that the applicant must file (1) evidence, such as patents, publications and other documents, and one or more affidavits or declarations which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee, and (2) an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment.

If an applicant is claiming the same invention as a patent which has an earlier effective United States filing date but is not a statutory bar against the application, and the applicant has not submitted the items required by 37 CFR 1.608 (a) and (b), (as appropriate), the application should be rejected under 35 U.S.C. 102(e)/103. A statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under 37 CFR 1.131 but only through interference proceedings. Note, however, 35 U.S.C. 135(b) and § 2307.02. The applicant should also be advised that an affidavit under 37 CFR 1.608(a) or evidence *and* an explanation under 37 CFR 1.608(b) (as appropriate) must be submitted and it should be stated, if applicable, that the patentee has been accorded the benefit of an earlier U.S. application.

If the applicant does not agree that he or she is claiming the same invention as the patent, and files an affidavit under 37 CFR 1.131, the rejection should be repeated and made final. The rejection should specify what the count or counts of the interference between the application and the patent would be. If the applicant still disagrees with the examiner, the rejection may be appealed to the Board of Patent Appeals and Interferences, and the question of whether the application and the reference patent are claiming the same invention may be argued on appeal, inasmuch as the 37 CFR 1.131 affidavit cannot be considered unless the applicant is found to be claiming an invention which is patentably distinct from that claimed in the patent. See *In re Hidy,* 303 F.2d 954, 133 USPQ 650 (CCPA 1962) and *In re Clark,* 457 F.2d 1004, 173 USPQ 359 (CCPA 1972).

2308.02 Showing Under 37 CFR 1.608(b) [R-2]

The showing under 37 CFR 1.608(b) must be such as to show that the applicant is *prima facie* entitled to a judgment relative to the patentee. Since 35 U.S.C. 135(a), as amended by Public Law 98-622, now gives the Board of Patent Appeals and Interferences jurisdiction in an interference proceeding over questions of both priority and patentability, the 37 CFR 1.608(b) showing need not attempt to show prior invention by the applicant, but may instead demonstrate that the applicant would be entitled to a judgment against the patentee on a ground of unpatentability (as, for example, that the claims of the patent which will correspond to the count or counts are unpatentable over prior art or prior public use, or that the patent does not comply with 35 U.S.C. 112).

An applicant in preparing affidavits or declarations under 37 CFR 1.608(b) to provoke an interference with a patentee whose effective U.S. filing date antedates the applicant's by more than three months, should have in mind the provisions of 37 CFR 1.617, and especially the following:

1. That after these affidavits or declarations are forwarded by the primary examiner for the declara-

tion of an interference they will be examined by an examiner-in-chief.

2. If the affidavits or declarations fail to establish that applicant would *prima facie* be entitled to a judgment relative to the patentee, an order will be issued concurrently with the notice of interference, requiring applicant to show cause why summary judgment should not be entered against the applicant.

3. Additional evidence in response to such order will not be considered unless justified by a showing under the provisions of 37 CFR 1.617(b). If the applicant responds, the applicant must serve the patentee and any other opponents with a copy of the original showing under 37 CFR 1.608(b) and of the response, and they will be entitled to present their views with respect thereto (37 CFR 1.617(d)).

4. All affidavits or declarations submitted must describe acts which the affiants performed or observed or circumstances observed, such as structure used and results of use or test, except on a proper showing as provided in 37 CFR 1.608(b). Statements of conclusion, for example, that the invention of the counts was reduced to practice, are generally considered to be not acceptable. It should also be kept in mind that documentary exhibits which are not self-authenticating must be authenticated and discussed with particularity by an affiant having direct knowledge of the matters involved. However, it is not necessary that the exact date of conception or reduction to practice be revealed in the affidavits, declarations, or exhibits if the affidavits or declarations aver observation of the necessary acts and facts, including documentation when available, before the patentee's effective filing date. On the other hand, where reliance is placed upon diligence, the affidavits or declarations and documentation should be precise as to dates from a date just prior to patentee's effective filing date. The showing should relate to the essential factors in the determination of the question of priority of invention as set out in 35 U.S.C. 102(g).

5. The explanation required by 37 CFR 1.608(b) should be in the nature of a brief or explanatory remarks accompanying an amendment, and should set forth the manner in which the requirements of the counts are satisfied and how the requirements for conception, reduction to practice or diligence are met, or otherwise explain the basis on which the applicant is *prima facie* entitled to a judgment.

6. Published decisions of the Court of Customs and Patent Appeals and the Board of Patent Interferences concerning the quantum of proof required by an applicant to make out a *prima facie* showing entitling the applicant to an award of priority with respect to the filing date of a patent so as to allow the interference to proceed, 37 CFR 1.617(a), second sentence, include *Kistler* v. *Weber,* 412 F.2d 280, 162 USPQ 214 (CCPA 1969); *Schwab* v. *Pittman,* 451 F.2d 637, 172 USPQ 69 (CCPA 1971); *Murphy* v. *Eiseman,* 166 USPQ 149 (Bd.Pat.Int. 1970); *Golota* v. *Strom,* 489 F.2d 1287, 180 USPQ 396 (CCPA 1974); *Horvitz* v. *Pritchard,* 182 USPQ 505 (Bd.Pat.Int. 1974); *Azar* v. *Burns,* 188 USPQ 601 (Bd.Pat.Int. 1975) and *Wetmore* v. *Quick,* 536 F.2d 937, 190 USPQ 223 (CCPA 1976).

As noted above, the evaluation of a showing under 37 CFR 1.608(b) is made by an examiner-in-chief. However, when a showing under 37 CFR 1.608(b) is filed, the examiner must inspect it to determine whether the applicant is relying upon prior invention or unpatentability as a basis for the showing. If the applicant alleges prior invention, the examiner should merely determine that at least one date prior to the effective filing date of the patent is alleged; if so, the examiner should proceed to institute the interference as described in § 2309. If the showing is based on alleged unpatentability of the patent claim or claims, the examiner should determine whether any ground of unpatentability alleged is such that it would also apply to the applicant; for example, if the applicant alleges that the claims of the patent are statutorily barred by a reference which would also be a bar to the applicant. If the examiner finds that an alleged ground of unpatentability would also apply to the applicant, the interference should not be declared and the applicant's claims which are drawn to the same invention as the claims of the patent should be rejected on this admission of unpatentability, without regard to the merits of the matter. Compare *Ex parte Grall,* 202 USPQ 701 (Bd.App. 1978). Although the applicant may wish to contest the question of whether the common invention is patentable to the patentee, an interference cannot be declared unless the common invention is patentable to the applicant. *Hilborn* v. *Dann,* 546 F.2d 401, 192 USPQ 132 (CCPA 1976). If the alleged unpatentability is based on patents or printed publications, the applicant may still be able to file a request for reexamination of the patent under 35 U.S.C. 302.

2308.03 Patent has Filing Date Later Than Application [R-2]

Although a patent which has an effective U.S. filing date later than the effective filing date of an application is not prior art against that application, the application should not be issued if the application and patent contain claims to the same patentable invention. In order to avoid the issuance of two patents to the same patentable invention, the examiner should take steps to institute an interference between the application and the patent.

If the application contains at least one allowable claim drawn to the same patentable invention as at least one patent claim, the examiner may initiate the interference by proceeding as described in § 2309. If the application does not contain such an allowable claim, such a claim should be suggested to the applicant, as described in § 2305.

If the application discloses, but does not claim, an invention claimed in the patent, so that a patent could be granted to the applicant without an interference proceeding, the patent should only be cited to the applicant. The applicant can then determine whether to

present claims to provoke an interference with the patent.

2309 Preparation of Interference Papers by Examiner [R-2]

37 CFR 1.609 Preparation of interference papers by examiner. When the examiner determines that an interference should be declared, the examiner shall forward to the Board:

(a) All relevant application and patent files and

(b) A statement identifying:

(1) The proposed count or counts;

(2) The claims of any application or patent which correspond to each count, stating whether the claims correspond exactly or substantially to each count;

(3) The claims in any application which are deemed by the examiner to be patentable over any count; and

(4) Whether an applicant or patentee is entitled to the benefit of the filing date of an earlier application and, if so, sufficient information to identify the earlier application.

Section 1.609 sets forth what an examiner shall forward to the Board when an interference is declared. For the most part, § 1.609 continues previous practice. However, under § 1.609(b)(3), the examiner must identify all claims in an application which the examiner believes are patentable over the proposed counts. Thus, a claim in an application will either correspond to a count or will be indicated as being patentable over the count. For instance, in Example 3, § 2309.01, the examiner must indicate that (1) claims 1 and 2 of application E and claims 11 and 12 of application F correspond to the count and (2) claim 3 of application E defines a separate patentable invention from the count.

2309.01 Formulation of Counts [R-2]

Before preparing the "Interference-Initial Memorandum" (Form PTO-850), the examiner must determine precisely what the count or counts of the interference will be. Unlike previous practice, under the revised rules (37 CFR 1.601-1.688) the question of whether the interference involves a patent is essentially irrelevant to the formulation of the counts.

In formulating the count or counts, the examiner must decide two interrelated questions: (1) how many counts will there be, and (2) what will the scope of each count be. The following principles should be kept in mind:

1. Each count must be drawn to a separate patentable invention, that is to say, the invention defined in each count must not be the same as, or obvious over, the invention defined in any other count. However, a count may properly be included if it is unobvious over another count, even though the reverse might not be true. For example, a count to a species and a count to a genus might properly both be included in the interference if the species is patentable over the genus, even though the genus might not be patentable, given the species.

It is expected that most interferences will involve only one count or a very small number of counts, in view of the requirement of separate patentability.

2. A count should normally be sufficiently broad as to encompass the broadest corresponding patentable claim of each of the parties. However, a situation may arise where the examiner considers that an applicant's corresponding claim includes not only the common invention, but also another invention; in that case, the count should be limited to the common invention, and may be narrower than the corresponding claim which recites the additional invention. Note that 37 CFR 1.606 provides that a count may not *initially* be narrower in scope than any *patent* claim which corresponds to it; this does not preclude later substitution of a count which is narrower than the patent claim, as the result of a preliminary motion under 37 CFR 1.633(c).

3. A count may not be so broad as to be unpatentable over prior art. If a count cannot be made sufficiently broad in scope as to embrace the broadest corresponding patentable claims of the parties without being unpatentable, that would indicate either that the parties' corresponding claims are unpatentable or perhaps, if the parties' claims do not overlap, that they are drawn to two separately patentable inventions and there is no interference in fact between them.

The following examples illustrate how counts should be formulated. An examiner-in-chief should be consulted in unusual situations which do not fit any of the examples.

Example 1: Application A contains patentable claim 1 (engine). Application B contains patentable claim 8 (engine). If an interference is declared, there will be one count (engine). Claim 1 of application A and claim 8 of application B would be designated to correspond to the count.

Example 2: Application C contains patentable claims 1 (engine) and 2 (6-cylinder engine). Application D contains patentable claim 8 (engine). An engine and a 6-cylinder engine define the same patentable invention. If an interference is declared, there will be one count (engine). Claims 1 and 2 of application C and claim 8 of application D would be designated to correspond to the count.

Example 3: Application E contains patentable claims 1 (engine), 2 (6-cylinder engine), and 3 (engine with a platinum piston). Application F contains patentable claims 11 (engine) and 12 (8-cylinder engine). Claims 1 and 2 of application E and claims 11 and 12 of application F define the same patentable invention. Claim 3 of application E defines a separate patentable invention from claims 1 and 2 of application E and claims 11 and 12 of application F. If an interference is declared, there will be one count (engine). Claims 1 and 2 of Application E and claims 11 and 12 of application F would be designated to correspond to the count. Claim 3 of application E would not be designated to correspond to the count.

Example 4: Application G contains patentable claims 1 (engine), 2 (6-cylinder engine), and 3 (engine with a platinum piston). Application H contains patentable claims 11 (engine) and 15 (engine with a platinum piston). Claims 1 and 2 of application G and claim 11 of application H define the same patentable invention. Claim 3 of application G and claim 15 of application H define a separate patentable invention from claims 1 and 2 of application G and claim 11 of application H. If an interference is declared, there will be two counts: Count 1 (engine) and Count 2 (engine with a platinum piston). Claims 1 and 2 of application G and claim 11 of application H would be designated to correspond to Count 1. Claim 3 of application G and claim 15 of application H would be designated to correspond to Count 2.

Example 5: Application J contains patentable claims 1 (engine), 2 (combination of an engine and a carburetor) and 3 (combination of an engine, a carburetor, and a catalytic converter). Application K contains patentable claims 31 (engine), 32 (combination of an engine and a carburetor), and 33 (combination of an engine, a carburetor, and an air filter). The engine, combination of an

engine and carburetor, and combination of an engine, carburetor, and air filter define the same patentable invention. The combination of an engine, carburetor, and catalytic converter define a separate patentable invention from engine. If an interference is declared, there will be one count (engine). Claims 1 and 2 of application J and claims 31, 32 and 33 of application K would be designated to correspond to the count. Claim 3 of application J would not be designated as corresponding to the count.

Example 6: The PTO will continue to follow *Waldeck* v. *Lewis*, 120 USPQ 88 (Comm'r.Pat. 1955). Application L contains patentable claims 1 (Markush group of benzene or toluene), 2 (benzene), and 3 (toluene). Application M contains patentable claims 11 (benzene). Benzene and toluene define the same patentable invention. If an interference is declared, there will be one count (Markush group of benzene or toluene). Claims 1, 2 and 3 of application L and claim 11 of application M would be designated to correspond to the count.

Example 7: Application N contains patentable claim 1 (benzene). Application P contains patentable claim 11 (xylene). Benzene and xylene define the same patentable invention. If an interference is declared, there will be one count (benzene or xylene). Claim 1 of application N and claim 11 of application P would be designated to correspond to the count.

Example 8: Application Q contains patentable claims 1 (Markush group of benzene or chloroform), 2 (benzene), and 3 (chloroform). Application R contains patentable claim 33 (benzene). If benzene and chloroform define the same patentable invention and an interference is declared, there will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of application Q and claim 33 of application R would be designated to correspond to the count. If chloroform defines a separate patentable invention from benzene and an interference is declared, there will be one count (benzene). Claims 1 and 2 of application Q and claim 33 of application R would be designated to correspond to the count. Claim 3 of application Q would not be designated to correspond to the count.

Example 9: Application S contains patentable claims 1 (Markush group of benzene or chloroform), 2 (benzene), and 3 (chloroform). Application T contains patentable claims 11 (Markush group of benzene or chloroform), 12 (benzene), and 13 (chloroform). If benzene and chloroform define the same patentable invention and an interference is declared, there will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of application S and claims 11, 12 and 13 of application T would be designated to correspond to the count. The PTO will continue to adhere to *Becker* v. *Patrick*, 47 USPQ 314 (Comm'r.Pat. 1939). An interference can have two counts only if one count defines a separate patentable invention from another count. If chloroform defines a separate patentable invention from benzene and an interference is declared, there will be two counts: Count 1 (benzene) and Count 2 (chloroform). Claims 1 and 2 of application S and claims 11 and 12 of application T would be designated to correspond to Count 1. Claims 1 and 3 of application S and claims 11 and 13 of application T would be designated to correspond to Count 2.

Example 10: Patent A contains claim 1 (engine). Application U contains patentable claim 11 (engine). If an interference is declare, there will be one count (engine). Claim 1 of patent A and claim 11 of application U would be designated to correspond to the count.

Example 11: Patent B contains claims 1 (engine) and 2 (6-cylinder engine). Application V contains patentable claim 8 (engine). An engine and a 6-cylinder engine define the same patentable invention. If an interference is declared, there will be one count (engine). Claims 1 and 2 of patent B and claim 8 of application V would be designated to correspond to the count.

Example 12: Patent C contains claims 1 (engine) 2 (6-cylinder engine), and 3 (engine with a platinum piston). Application W contains patentable claims 11 (engine) and 12 (8-cylinder engine). Claims 1 and 2 of patent C and claims 11 and 12 of application W define the same patentable invention. Claim 3 of patent C defines a separate patentable invention from claims 1 and 2 of patent C and claims 11 and 12 of application W. If an interference is declared, there will be one count (engine). Claims 1 and 2 of patent C and claims 11 and 12 of application W would be designated to correspond to the count. Claim 3 of patent C would not be designated to correspond to the count.

Example 13: Patent D contains claims 1 (engine), 2 (6-cylinder engine), and 3 (engine with a platinum piston). Application X contains patentable claims 11 (engine) and 15 (engine with a platinum piston). Claims 1 and 2 of patent D and claim 11 of application X define the same patentable invention. Claim 3 of patent D and claim 15 of application X define a separate patentable invention from claims 1 and 2 of patent D and claim 11 of application X. If an interference is declared, there will be two counts: Count 1 (engine) and Count 2 (engine with a platinum piston). Claims 1 and 2 of patent D and claim 11 of application X would be designated to correspond to Count 1. Claim 3 of patent D and claim 15 of application X would be designated to correspond to Count 2.

Example 14: Patent E contains claims 1 (Markush group of benzene or toluene), 2 (benzene), and 3 (toluene). Application Y contains patentable claim 11 (benzene). Benzene and toluene define the same patentable invention. If an interference is declared, there will be one count (Markush group of benzene of toluene). Claims 1, 2 and 3 patent E and claim 11 of application Y would be designated to correspond to the count.

Example 15: In this example, the claims of patent E and application Y in Example 14 are reversed. Patent E contains claim 1 (benzene). Application Y contains patentable claims 11 (Markush group of benzene or toluene), 12 (benzene), and 13 (toluene). If an interference is declared, the count will be the same as the count in Example 14—(Markush group of benzene or tolulene). Claim 1 of patent E and claims 11, 12 and 13 of application Y would be designated to correspond to the count.

Example 16: The PTO will continue to follow cases such as *Case* v. *CPC International Inc.*, 730 F.2d 745, 221 USPQ 196 (Fed. Cir. 1984), *cert. denied*, 105 S.Ct. 233, 224 USPQ 736 (1984); *Aelony* v. *Arni*, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); and *Nitz* v. *Ehrenreich*, 537 F.2d 539, 190 USPQ 413 (CCPA 1976), and declare interferences where interfering patent and application claims are mutually exclusive provided the claims define the same patentable invention. Patent F contains claim 1 (benzene). Application Z contains patentable claim 11 (xylene). Benzene and xylene define the same patentable invention. If an interference is declared, there will be one count (benzene or xylene). Claim 1 of patent F and claim 11 of application Z would be designated to correspond to the count.

Example 17: It will be the practice of the PTO under 37 CFR 1.606 to initially declare interferences with counts which are identical to or broader than patent claims which correspond to the counts. A single patent claim would be presumed, subject to a motion under 37 CFR 1.633(c), not to define separate patentable inventions. Patent G contains claims 1 (Markush group of benzene or chloroform), 2 (benzene), and 3 (chloroform). Application AA contains patentable claim 33 (benzene). If an interference is declared, initially it will be presumed by the PTO, subject to a later motion under 37 CFR 1.633(c), that benzene and chloroform define the same patentable invention. There will be one count (Markush group of benzene or chloroform). Claims 1, 2 and 3 of patent G and claim 33 of application AA would be designated to correspond to the count. If a party believes benzene and chloroform define separate patentable inventions, that party could file a motion under 37 CFR 1.633(c) to redefine the count and the claims corresponding to the counts.

Example 18: Patent H contains claim 1 (Markush group of benzene or chloroform), 2 (benzene), and 3 (chloroform). Application AB contains patentable claims 11 (Markush group of benzene of chloroform), 12 (benzene), and 13 (chloroform). Benzene and chloroform initially would be presumed, subject to a motion under 37 CFR 1.633(c), to define the same patentable invention, because they are recited as a Markush group in a single patent claim. If an interference is declared, there will be one count (Markush group of benzene of chloroform). Claims 1, 2 and 3 of patent H and claims 11, 12 and 13 of application AB would be designated to correspond to the count. If a party believes benzene and chloroform define separate patentable inventions, the party could move under 37 CFR 1.633(c) to substitute a count

(benzene) for (Markush group of benzene or chloroform) and to add a count (chloroform).

Example 19: Under 37 CFR 1.606, the PTO will continue to follow the practice announced in *Ex parte Card and Card*, 1904 C.D. 383 (Com'r). Patent J contains claim 1 (method of mixing, grinding, and heating). Application AC contains patentable claim 8 (method of mixing and heating) and does not disclose or claim a grinding step. In the context of the inventions disclosed in patent J and application AC, a method of mixing, grinding, and heating is the same patentable invention as a method of mixing and heating. Under current practice, it would be said that "grinding" is an "immaterial" limitation in claim 1 of patent J. Under 37 CFR 1.606, the fact application AC does not disclose grinding would not preclude an interference. If an interference is declared, there will be one count (method of mixing and heating). Claim 1 of patent J and claim 8 of application AC would be designated to correspond to the count.

Example 20: The facts in this example are the same as Example 18. Assume that applicant AB believes that benzene and choloroform define separate patentable inventions. Applicant AB would file a motion under § 1.633(c)(1) to substitute Count 2 (benzene) for Count 1 (Markush group of benzene or chloroform) and add Count 3 (chloroform). If the examiner-in-chief grants the motion, the interference would be redeclared by deleting Count 1 and substituting in its place Counts 2 and 3. Claims 1 and 2 of the patent H and claims 11 and 12 of application AB will be designated to correspond to Count 2. Claims 1 and 3 of patent H and claims 11 and 12 of application AB will be designated to correspond to Count 3. If one party proves priority with respect to both benzene and choloroform, that party would be entitled to all claims in its application or patent corresponding to Counts 2 and 3. The other party would not be entited to a patent containing any claim corresponding to Counts 2 and 3. If patentee H proves priortiy with respect to benzene and applicant AB proves priority with respect to choloroform (assuming there was no issue raised at final hearing with respect to the patentable distinctness of benzene and chloroform), the judgment will provide that patentee H is not entitled to a patent with claims 1 and 3, but is entitled to a patent with claim 2 and that applicant AB is not entitled to a patent with claims 11 and 12, but is entitled to a patent with claim 13. If an issue is properly raised at final hearing as to whether benzene and chloroform are the same patentable invention and the Board holds that they are the same patentable invention, the party proving the earlisest priority as to either benzene or chloroform would prevail as to all claims. Thus, if patentee H invented benzene before applicant AB invented benzene or chloroform, patentee H would be entitled to a patent containing claims 1 through 3 even if applicant AB invented chloroform before patentee H invented chloroform. Applicant AB would not be entitled to a patent with claims 11 through 13.

2309.02 Preparation of Papers—Initial Memorandum [R-2]

The only paper prepared by the examiner is the Initial Memorandum (Form PTO-850 Revision ⅛₅ or later) addressed to the Board of Patent Appeals and Interferences which provides authorization for preparation of the declaration notices. The latter papers are prepared in the Service Branch of the Board.

A sample of a filled-out Form PTO-850 is shown below.

A separate form is used for each count of the interference. The form need not be typed unless the count is not identical to any claim of any of the parties. If the count is identical to a claim of one of the parties, the number of that claim is circled. If the count is not identical to any claim of any the parties, the count should be typed in the space provided on the form (an additional plain sheet may be attached if needed).

The files to be included in the interference should be listed by last name (of first listed inventor if application is joint), serial number, and filing date irrespective of whether an application or a patent is involved. The sequence of the listed applications is completely immaterial. If the examiner has determined that a party is entitled to the benefit of the filing date of one or more applications (or patents) as to the counts, the blanks provided on the form for indicating this fact should be filled in as to all such applications. It is particularly important to list all intermediate applications necessary to provide continuity of pendency to the earliest benefit application to which a party is entitled.

An applicant will be accorded the benefit of a foreign application on the Form PTO-850 and declaration notices only if the papers required by 37 CFR 1.55, including a sworn translation, have been filed and the primary examiner has determined that the applicant is in fact entitled to the benefit of such application. A patentee may be accorded the benefit of the filing date of a foreign application in the notice of interference provided he has complied with the requirements of 37 CFR 1.55, has filed a sworn translation, and the primary examiner has determined that at least one species within the count involved in the interference is supported by the disclosure of the foreign application. Note, however, that a patentee should not be accorded the benefit of a foreign application if an application in the interference has an effective filing date subsequent to the filing date of the foreign application. See § 2308.01.

The claims in each party's case which correspond and do not correspond to the count must be listed in the spaces provided on the form. A claim corresponds to a count if, considering the count as prior art, the claim would be unpatentable over the count under 35 U.S.C. 102 or 103. If the examiner is in doubt as to whether a party's claim does or does not correspond to a count, it should be listed as corresponding to the count. If the party disagrees with this listing, a motion may be filed under 37 CFR 1.633(c)(4) during the interference to designate the claim as not corresponding to the count.

Note that for *each* count, *every* claim in a party's application or patent must be designated as either corresponding or not corresponding to the count. The fact that a claim may be under rejection does not mean that it should not be designated. For every claim of an application which is listed on the form, the examiner must indicate whether or not that claim is allowable by writing "(allowable)" or "(not allowable)" next to the claim number(s). At least one of the claims designated as corresponding to the count must be allowable.

If an involved case contains multiple dependent claims, the examiner should be careful to indicate which embodiments of each multiple dependent claim correspond or do not correspond to each count. An embodiment of a multiple dependent claim should not be circled on form PTO-850 as being the count, but rather, the embodiment should be written out in independent form in the space provided.

After a Form PTO-850 is filled out for each count of the proposed interference, it must be signed by the primary examiner in the space provided. The form must also be signed by the group director, if the director's approval is required (as when the interference involves two applications whose effective filing dates are more than 6 months apart).

When the form or forms are signed, they are forwarded to the Board of Patent Appeals and Interferences, together with:

1. The file of each U.S. application or patent listed on the form(s), including all applications or patent of which benefit is being accorded.

2. A recent title report for each of the involved application(s) and patent(s).

If two of the parties have the same attorney or agent, the examiner will in a separate memorandum call the attention of the Board to that fact when the Initial Memorandum is forwarded. The examiner-in-chief, when the interference is declared, can then take such action as may be appropriate under 37 CFR 1.613(b).

FORM PTO-850 (REV 1-93) — U.S. DEPARTMENT OF COMMERCE, PATENT AND TRADEMARK OFFICE

INTERFERENCE—INITIAL MEMORANDUM

EXAMINERS INSTRUCTIONS—This form need not be typewritten. Complete the items below and forward to the Group Clerk with all files including those benefit of which has been accorded. The parties need not be listed in any specific order. Use a separate form for each count. (See MPEP 2300.02)

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

This is count 1 of 1 count(s).

1. NAME	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Smith et al	123,456	5-22-82	4,567,890

The claims of this party which correspond to this count are:	The claims of this party which do not correspond to this count are:
0, 2, 3, 4, 9/1	5-8, 9/2

* Accorded benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY

2. NAME	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Jones	345,678	12-1-82	

The claims of this party which correspond to this count are:	The claims of this party which do not correspond to this count are:
11, 12 (allowable.)	3-6 (not allowable.) 7-10 (allowable)

* Accorded benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
U.S.	987,654	8-8-78	4,456,789
U.S.	012,345	11-11-81	

3. NAME	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
WATANABE et al	456,789	5-10-83	

The claims of this party which correspond to this count are:	The claims of this party which do not correspond to this count are:
1, 2 (not allowable) 3-5 (allowable)	6 (allowable.)

* Accorded benefit of:

COUNTRY	SERIAL NO.	FILING DATE	PATENT NO., IF ANY
Japan	10.000/82	5-10-82	

If a claim of any party is exactly the same as this count, it should be circled above. If not, type the count in this space (attach additional sheet if necessary):

* The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

DATE	PRIMARY EXAMINER	TELEPHONE NO.	ART UNIT
2-11-85	Mary Johnson	557-1000	101

Clerk's instructions:
1. Obtain a title report for all cases and include a copy.
2. Forward all files including those benefit of which is being accorded.

GROUP DIRECTOR SIGNATURE (if required)

2309.03 Affidavits and Declarations Retained in File [R-2]

When there are of record in the file of the application affidavits or declarations under 37 CFR 1.131 or 1.608, they should not be sealed but should be left in the file for consideration by the Board of Patent Appeals and Interferences. If the interference proceeds normally, these affidavits or declarations will be removed and sealed up by the Service Branch of the Board of Patent Appeals and Interferences and retained with the interference.

Affidavits or declarations under 37 CFR 1.131 and 1.608 are available for inspection by an opposing party to an interference after the preliminary motions under 37 CFR 1.633 are decided. See 37 CFR 1.612(b).

Affidavits or declarations in the file of a patent are not removed, inasmuch as they have been available to the public since the date the patent issued.

2309.04 Record in Each Interference Complete [R-2]

When there are two or more related interferences pending in the Patent and Trademark Office, in order that the record of the proceedings in each particular interference may be kept separate and distinct, all motions and papers sought to be filed therein must be titled in and relate only to the particular interference to which they belong, and no motion or paper can be filed in any interference which relates to, or in which is joined, another interference or matter affecting another interference.

2309.05 Consultation With Examiner-in-Chief [R-2]

The examiner should consult with one of the examiners-in-chief in any case of doubt or where the practice appears to be obscure or confused. In view of their specialized experience they may be able to suggest a course of action which will avoid considerable difficulty in the future treatment of the case.

2309.06 Interfering Subject Matter in "Secrecy Order" Cases [R-2]

37 CFR 5.3 Prosecution of application under secrecy order; withholding patent. (b) An interference will not be declared involving national applications under secrecy order. However, if an applicant whose application under secrecy order copies claims from an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.205(c)).

Since declaration of an interference gives immediate access to applications by opposing parties, no interference will be declared involving an application which has a security status therein (See §§ 107 and 107.02). Claims will be suggested so that all parties will be claiming substantially identical subject matter. When all applications contain the claims suggested, the following letter will be sent to all parties:

> "Claims 1, 2, etc. (indicating the conflicting claims and claims not patentable over the application under security status) conflict with those of another application. However, the security status (of the other application/ of your application) does not permit the declaration of an interference. Accordingly, action on the applications is suspended for so long as this situation continues.
>
> "Upon removal of the security status from all applications, an interference will be declared."

The letter should also indicate the allowability of the remaining claims, if any.

A notice that claims have been presented in a "security type" application for the purpose of interference with a patent should be placed in the patented file. Also, in accordance with 37 CFR 1.607(d), the patentee should be notified. The question of an interference is taken up upon termination of the "security status" of the application in which patent claims are presented. The suggested notices should be modified accordingly.

The notices should be signed by the primary examiner. The copy of the notice retained separately in the examining group should, in addition, contain the identification of the applications and patents involved and the interfering claims.

2310 Handling by Examiner-in-Chief [R-2]

37 CFR 1.610 Assignment of interference to examiner-in-chief, time period for completing interference. (a) Each interference will be declared by an examiner-in-chief who may enter all interlocutory orders in the interference, except that only a panel consisting of at least three members of the Board shall (1) hear oral argument at final hearing, (2) enter a decision under §§ 1.617, 1.640(c) or (e), 1.652, 1.656(i) or 1.658 or (3) enter any other order which terminates the interference.

(b) As necessary, another examiner-in-chief may act in place of the one who declared the interference. Unless otherwise provided in this section, at the discretion of the examiner-in-chief assigned to the interference, a panel consisting of two or more members of the Board may enter interlocutory orders.

(c) Unless otherwise provided in this subpart, times for taking action by a party in the interference will set on a case-by-case basis by the examiner-in-chief assigned to the interference. Times for taking action shall be set and the examiner-in-chief shall exercise control over the interference such that the pendency of the interference before the Board does not normally exceed two years.

(d) An examiner-in-chief may hold a conference with the parties to consider: (1) simplification of any issues, (2) the necessity or desirability of amendments to counts, (3) the possibility of obtaining admissions of fact and genuineness of documents which will avoid unnecessary proof, (4) any limitations on the number of expert witnesses, (5) the time and place for conducting a deposition (§ 1.673(g)), and (6) any other matter as may aid in the disposition of the interference. After a conference, the examiner-in-chief may enter any order which may be appropriate.

(e) The examiner-in-chief may determine a proper course of conduct in an interference for any situation not specifically covered by his part.

Under § 1.610, each interference will be declared by an examiner-in-cheif. The examiner-in-chief enters all interlocutory orders in the interference. As necessary, another examiner-in-chief may act in place of the examiner-in-chief assigned to the interference. At the discretion of the examiner-in-chief assigned to the interference, a panel of two or more examiners-in-chief may enter an interlocutory order. The examiner-in-chief will set times and control proceedings such that pendency of the interference normally will not exceed 24 months. Under § 1.610(d), the examiner-in-chief is authorized to hold conferences. Any confer-

ence can be by a telephone conference call. Under § 1.610(e), an examiner-in-chief is authorized to determine a proper course of conduct for any situation not specifically covered by the rules.

2311 Declaration of Interference [R-2]

37 CFR 1.611 Declaration of interference. (a) Notice of declaration of an interference will be sent to each party.

(b) When a notice of declaration is returned to the Patent and Trademark Office undelivered, or in any other circumstance where appropriate, an examiner-in-chief may (1) send a copy of the notice to a patentee named in a patent involved in an interference or the patentee's assignee of record in the Patent and Trademark Office or (2) order publication of an appropriate notice in the *Official Gazette*.

(c) The notice of declaration shall specify:

(1) the name and residence of each party involved in the interference;

(2) the name and address of record of any attorney or agent of record in any application or patent involved in the interference;

(3) the name of any assignee of record in the Patent and Trademark Office;

(4) the identity of any application or patent involved in the interference;

(5) where a party is accorded the benefit of the filing date of an earlier application, the identity of the earlier application;

(6) the count or counts;

(7) the claim or claims of any application or any patent which correspond to each count; and

(8) the order of the parties.

(d) The notice of declaration may also specify the time for: (1) filing a preliminary statement as provided in § 1.621(a); (2) serving notice that a preliminary statement has been filed as provided in § 1.621(b); and (3) filing preliminary motions authorized by § 1.633, oppositions to the motions, and replies to the oppositions.

(e) Notice may be given in the *Official Gazette* that an interference has been declared involving a patent.

Upon receipt of the Interference Initial Memorandum (Form PTO-850) and the case files from the primary examiner, the interference is assigned to an examiner-in-chief, who is thereafter responsible for handling it during its pendency before the PTO. Under the revised rules, the examiner-in-chief has wide discretion as to what actions he or she may take, particularly with regard to the setting of times, and in studying the rules it will be noted that many of their provisions are modified by a qualification such as "unless otherwise ordered by an examiner-in-chief." Therefore, it may well be that different examiners-in-chief will follow somewhat different procedures in the interferences assigned to them.

Preparation of Declaration Notice

The papers necessary in declaring an interference are prepared at the Board of Patent Appeals and Interferences. The notices to the parties and the declaration sheet are signed by the examiner-in-chief, who declares the interference by mailing the notices to the several parties to the proceeding. Thereafter the applications and interference files are kept at the Board where they are also recorded in a card index.

The fact that an application that has been made special by the Commissioner becomes involved in an interference does not entitle that interference to be taken up out of turn. *Strickland* v. *Glaser*, 214 USPQ 549 (Comr. 1980). The parties may expedite the proceeding by taking action promptly when times are set, and by requesting that certain time periods be reduced or eliminated.

Under § 1.611(a), the PTO will normally notify each party at its correspondence address (37 CFR 1.33(a)) that an interference is declared.

Under § 1.611(a), the PTO could, in an appropriate circumstance, also send a notice to a patentee or an assignee. An appropriate circumstance for sending an additional notice would be a situation where a patent was issued on the basis of an application filed under 37 CFR 1.47. The matters to be specified in a notice declaring an interference are set out in § 1.611(c). One item to be set out is the "order of the parties," meaning the order in which the parties will take testimony. The "order of the parties" is a procedural tool. It indicates the "style" of the case—which practitioners are encouraged to use. If there are two counts and one party is "senior" as to one count and "junior" as to another count, the party has the burden as proof as to that count to which the party is "junior." See § 1.657. Appropriate testimony periods will be set (§ 1.651(b)) to accommodate differing burdens of proof in cases where a party is "senior" on one count and "junior" on another count.

If Jones is the junior party and Smith is the senior party, the order of the parties is: *Jones* v. *Smith*. The order of the parties may change as a result of the granting of a motion under § 1.633 (d), (f), or (g). Under § 1.611(d), the notice declaring the interference may also set dates for filing preliminary statements, notices that preliminary statements have been filed, motions under § 1.633, oppositions to those motions, and replies to the oppositions.

In setting the times for filing preliminary statements and preliminary motions, the examiners-in-chief may follow different procedures. Some may hold a telephone conference with the lead attorneys to work out times acceptable to all parties, while others may specify times in the declaration notices and state that those times will be final unless a lead attorney requests by a certain date that they be changed. In either event, the times, once finally set, will not be changed except for good cause shown. Any motion to extend time must reach the examiner-in-chief before expiration of the time period to be extended, and may not be granted even if it is unopposed. Note that 37 CFR 1.645 specifically provides that "The press of other business arising after an examiner-in-chief sets a time for taking action will not normally constitute good cause."

Once an interference is declared involving an application, *ex parte* prosecution of the application is suspended and the applicant need not respond to any PTO action outstanding as of the date the interference is declared.

2312 Access to Applications in Interference [R-2]

37 CFR 1.612 Access to applications. (a) After an interference is declared, each party shall have access to and may obtain copies of the files of any application set out in the notice declaring the interference, except for affidavits filed under § 1.131 and any evidence and explanation under § 1.608 filed separate from an amendment.

(b) After preliminary motions under § 1.633 are decided (§ 1.640(b)), each party shall have access to and may obtain copies

of any affidavit filed under § 1.131 and any evidence and explanation filed under § 1.608 in any application set out in the notice declaring the interference.

(c) Any evidence and explanation filed under § 1.608 in the file of any application identified in the notice declaring the interference shall be served when required by § 1.617(b).

(d) The parties at any time may agree to exchange copies of papers in the files of any application identified in the notice declaring the interference.

Under § 1.612, except for affidavits under § 1.131 and any evidence and explanation under § 1.608(b) filed separate from an amendment, each party has access to the file of every other party after an interference is declared. The files of applications and patents involved in an interference are maintained in the Service Branch of the Board of Patent Appeals and Interferences for inspection and copying. Any explanation which is filed as part of an amendment or an amendment which discusses details contained in an affidavit under § 1.131 is not to be sealed under § 1.612(a). Thus, § 1.612(a) continues the practice discussed in *Moorman* v. *Martin*, 103 USPQ 273 (Comm'r. Pat. 1950) and Calvert, *An Overview of Interference Practice*, 62 J. Pat. Off. Soc'y. 209, 293 (1980). Under § 1.612(b), each party has access to an opponent's affidavit under § 1.131 or an opponent's evidence and explanation under § 1.608(b) when a decision is rendered on motions under § 1.633. Under § 1.612(c), a party is required to serve any evidence and explanation under § 1.608(b) if an order to show cause is issued under § 1.617(a) and the party responds to the order under § 1.617(b). Under § 1.612(d), the parties may agree to exchange copies of their respective files.

2313 Lead Attorney or Agent [R-2]

37 CFR 1.613 Lead attorney, same attorney representing different parties in an interference, withdrawal of attorney or agent. (a) Each party may be required to designate one attorney or agent of record as the lead attorney or agent.

(b) The same attorney or agent or members of the same firm of attorneys or agents may not represent two or more parties in an interference except as may be permitted under this Chapter.

(c) An examiner-in-chief may make necessary inquiry to determine whether an attorney or agent should be disqualified from representing a party in an interference. If an examiner-in-chief is of the opinion that an attorney or agent should be disqualified, the examiner-in-chief shall refer the matter to the Commissioner. The Commissioner will make a final decision as to whether any attorney or agent should be disqualified.

(d) No attorney or agent of record in an interference may withdraw as attorney or agent of record except with the approval of an examiner-in-chief and after reasonable notice to the party on whose behalf the attorney or agent has appeared. A request to withdraw as attorney or agent of record in an interference shall be made by motion (§ 1.635).

Under § 1.613(a), when a party has appointed more than one attorney or agent of record, the party may be required to designate a "lead" attorney or agent. A "lead" attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an interference on behalf of a party and is the individual whom an examiner-in-chief can contact to set times and take other action in the interference. Section 1.613(b) continues the practice of not permitting the same attorney or agent to represent two or more parties in an interference except as permitted by Chapter 1, see e.g., § 1.344. Under § 1.613(c), an examiner-in-chief can make an appropriate inquiry to determine whether an attorney or agent should be disqualified from representing a party. A final decision to disqualify an attorney or agent is made by the Commissioner under 35 U.S.C. § 32.

2314 Jurisdiction Over Interference [R-2]

37 CFR 1.614 Jurisdiction over interference. (a) The Board shall assume jurisdiction over an interference when the interference is declared under § 1.611.

(b) When the interference is declared the interference is a contested case within the meaning of 35 U.S.C. § 24.

(c) The examiner shall have jurisdiction over any pending application until the interference is declared. An examiner-in-chief, where appropriate, may for a limited purpose restore jurisdiction to the examiner over any application involved in the interference.

Section 1.614 specifies when the Board gains jurisdiction over an interference. The section also indicates when an interference becomes a contested case within the meaning of 35 U.S.C. § 24. A remand to the examiner is authorized and may be useful in certain situations, such as, when a party moves under § 1.633(c) to add a proposed count which is broader than any count in an interference. Alternatively, an examiner-in-chief can obtain informal opinions from examiners during the course of an interference. Nothing in the rules, however, is intended to authorize informal conferences between an examiner-in-chief and an examiner with respect to the merits of an application before the Board in an *ex parte* appeal from an adverse decision of the examiner.

Where an interference is declared all questions involved therein are to be determined *inter partes*. This includes not only the question of priority of invention but all questions relative to the patentability to each of the parties of the claims in issue or of any claim suggested to be added to the issue.

Examiners are admonished that *inter partes* questions should not be discussed *ex parte* with any of the interested parties and that they should so inform applicants or their attorneys if any attempt is made to discuss *ex parte* these *inter partes* questions.

The interference is declared when the examiner-in-chief mails the notices of interference to the parties. The interference is thus technically pending before the Board of Patent Appeals and Interferences from the date on which the notices are mailed, and from that date the files of the various applications set out in the notices are opened to inspection by the other parties to the extent provided in 37 CFR 1.612.

Obvious minor errors in the counts or corresponding claims of an application may be corrected by the examiner-in-chief before the declaration notices are mailed. The changes will be made in red ink and initialled in the margin by the examiner-in-chief.

Throughout the interference, the interference and application files involved are in the keeping of the Service Branch of the Board except at such times that action is required, such as for concurrent prosecution,

when they are temporarily in possession of the tribunal before whom the particular question is pending.

If, independent of the interference, action as to one or more of the applications becomes necessary, the examiner should consult the examiner-in-chief in charge of the interference.

The examiner merely borrows a patent file, if needed, as where the patent is to be involved in a new interference.

2315 Suspension of Ex parte Prosecution [R-2]

37 CFR 1.615 Suspension of ex parte prosecution. (a) When an interference is declared, *ex parte* prosecution of an application involved in the interference is suspended. Amendments and other papers related to the application received during pendency of the interference will not be entered or considered in the interference without the consent of an examiner-in-chief.

(b) *Ex parte* prosecution as to specified matters may be continued concurrently with the interference with the consent of the examiner-in-chief.

The treatment of amendments filed during an interference is considered in detail in § 2364.

Ex parte prosecution of an appeal under 37 CFR 1.191 may proceed concurrently with an interference proceeding involving the same application with the consent of the examiner-in-chief provided the primary examiner who forwards the appeal certifies, in a memorandum to be placed in the file, that the subject matter of the interference does not conflict with the subject matter of the appealed claims. The approval of the examiner-in-chief in charge of the interference must be obtained before undertaking any concurrent prosecution of the application.

2315.01 Suspension—Overlapping Applications [R-2]

Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference, the prosecution of all the cases not in the interference should be carried as far as possible, by treating as prior art the counts of the interference and by insisting on proper lines of division or distinction between the applications. In some instances suspension of action by the Office cannot be avoided. See § 709.01.

Where an application involved in an interference includes, in addition to the subject matter of the interference, a separate and divisible invention, prosecution of the second invention may be had during the pendency of the interference by filing a divisional application for the second invention or by filing a divisional application for the subject matter of the interference and moving to substitute the latter divisional application for the application originally involved in the interference. However, the application for the second invention may not be passed to issue if it contains claims broad enough to dominate matter claimed in the application involved in the interference.

From Paragraph 11.16

REJECTION BASED ON COUNT OF AN INTERFERENCE

The rejection of claim [1] above based upon count [2] of Interference No. [3], to which applicant is a party, is a provisional rejection for the purpose of resolving all remaining issues in this application. The provisional assumption that the count is prior art under 35 U.S.C. 102(g) against this application may or may not be true, and prosecution in this case will be suspended pending final determination of priority in the interference if and when no other issues remain.

Examiner Note:

1. This paragraph must follow all rejections under 35 U.S.C. 102 or 103 using the count of an interference as prior art.
2. This paragraph is applicable only to an application that is commonly owned by a party in the interference but is *not* involved in the interference.

Form Paragraph 11.17

SUSPENSION OF PROSECUTION PENDING OUTCOME OF INTERFERENCE

The outcome of interference No. [1] has a material bearing on the patentability of the claims in this application. Prosecution in this application is SUSPENDED pending a final judgment in the interference.

Applicant should call this case up for action upon termination of the interference.

Examiner Note:

This paragraph should only be used in an application that is not in the interference but is commonly owned by one of the parties thereto.

2316 Sanctions For Failure to Comply With Rules or Order [R-2]

37 CFR 1.616 Sanctions for failure to comply with rules or order. An examiner-in-chief or the Board may impose an appropriate sanction against a party who fails to comply with the regulations of this part or any order entered by an examiner-in-chief or the Board. An appropriate sanction may include among others entry of an order:

(a) Holding certain facts to have been established in the interference;

(b) Precluding a party from filing a motion or a preliminary statement;

(c) Precluding a party from presenting or contesting a particular issue;

(d) Precluding a party from requesting, obtaining, or opposing discovery; or

(e) Granting judgment in the interference.

Section 1.616 permits an examiner-in-chief or the Board to impose appropriate sanctions against a party who fails to comply with the rules or with an order entered in the interference. Paragraphs (a) through (e) of § 1.616 set forth some of the possible sanctions which can be entered. The particular sanction to be entered will depend on the facts of a given case and ordinarily will not be entered prior to giving the affected party an opportunity to present its views. An individual examiner-in-chief cannot impose a sanction granting judgment inasmuch as entry of a judgment requires action by the Board. See § 1.610(a). A party desiring sanctions imposed against an opponent can move under § 1.635 for entry of an order imposing sanctions.

For examples of cases where sanctions are warranted, see *Woods* v. *Tsuchiya,* 207 USPQ 228 (Comm'r. Pat. 1979) and *Tezel* v. *Bellantoni,* 188 USPQ 688 (Bd.Pat.Int. 1975).

2317 Summary Judgment Against Applicant [R-2]

37 CFR 1.617 Summary judgment against applicant. (a) An examiner-in-chief shall review any evidence filed by an applicant under § 1.608(b) to determine if the applicant is *prima facie* entitled to a judgment relative to the patentee. If the examiner-in-chief determines that the evidence shows the applicant is *prima facie* entitled to a judgment relative to the patentee, the interference shall proceed in the normal manner under the regulations of this part. If in the opinion of the examiner-in-chief the evidence fails to show that the applicant is *prima facie* entitled to a judgment relative to the patentee, the examiner-in-chief shall, concurrently with the notice declaring the interference, enter an order stating the reasons for the opinion and directing the applicant, within a time set in the order, to show cause why summary judgment should not be entered against the applicant.

(b) The applicant may file a response to the order and state any reasons why summary judgment should not be entered. Any requests by the applicant for a hearing before the Board shall be made in the response. Additional evidence shall not be presented by the applicant or considered by the Board unless the applicant shows good cause why any additional evidence was not initially presented with the evidence filed under § 1.608(b). At the time an applicant files a response, the applicant shall serve on each opponent a copy of any evidence filed under § 1.608(b) and this paragraph.

(c) If a response is not timely filed by the applicant, the Board shall enter a final decision granting summary judgment against the applicant.

(d) If a response is timely filed by the applicant, all opponents may file a statement within a time set by the examiner-in-chief. The statement may set forth views as to why summary judgment should be granted against the applicant, but the statement shall be limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the examiner-in-chief for issuing the order to show cause. Evidence shall not be filed by an opponent. An opponent may not request hearing.

(e) Within a time authorized by the examiner-in-chief, an applicant may file a reply to any statement filed by any opponent.

(f) When more than two parties are involved in an interference, all parties may participate in summary judgment proceedings under this section.

(g) If a response by the applicant is timely filed, the examiner-in-chief or the Board shall decide whether the evidence submitted under § 1.608(b) and any additional evidence properly submitted under paragraph (b) of this section shows that the applicant is *prima facie* entitled to a judgment relative to the patentee. If the applicant is not *prima facie* entitled to a judgment relative to the patentee, the Board shall enter a final decision granting summary judgment against the applicant. Otherwise, an interlocutory order shall be entered authorizing the interference to proceed in the normal manner under the regulations of this subpart.

(h) Only an applicant who filed evidence under § 1.608(b) may request a hearing. If that applicant requests a hearing, the Board may hold a hearing prior to entry of a decision under paragraph (g) of this section. The examiner-in-chief shall set a date and time for the hearing. Unless otherwise ordered by the examiner-in-chief or the Board, the applicant and any opponent will each be entitled to no more than 30 minutes of oral argument at the hearing.

Section 1.617 provides for summary judgment proceedings in those cases where a junior party applicant is required to file evidence and an explanation under § 1.608(b). To avoid summary judgment, the junior party applicant must establish that it is *prima facie* entitled to judgment relative to the senior party patentee. For the most part, practice under § 1.617 will be the same as the previous practice under 37 CFR 1.228. The major changes from the previous practice are the following:

(1) A *prima facie* case can be based on patentability as well as priority.

(2) A stricter standard will be imposed for presenting additional evidence after entry of an order to show cause. Under previous practice (37 CFR § 1.228, now deleted), additional evidence could be submitted with a response to an order to show cause "when a showing in excuse of . . . [its] omission from the original" showing is made. The "good cause" showing required by § 1.617(b) imposes a stricter standard than was required under the prior rules. The stricter standard is considered necessary in order to encourage applicants copying claims from a patent to better prepare their initial showings under § 1.608(b). Under previous practice, the Board of Patent Interferences found that substantial time was lost in issuing orders to show cause based on an inadequate initial showing only to have an adequate showing made with the response to the order to show cause. Under the "good cause" standard, ignorance by a party or counsel of the provisions of the rules or the substantive requirements of the law will not constitute good cause.

(3) When an interference involves more than two parties, all opponents are permitted to participate in summary judgment proceedings. Thus, the revised rules overrule *Chan* v. *Akiba* v. *Clayton,* 189 USPQ 621 (Comm'r. Pat. 1975).

(4) Previously, an applicant had to file two copies of its initial showing under 37 CFR § 1.204(c). Under § 1.608(b), a party need only file one copy of the showing. However, any party responding to an order to show cause must serve a copy of its initial showing under § 1.608(b) with any response to the order to show cause.

(5) A single examiner-in-chief may order an interference to proceed after issuance of an order to show cause under § 1.608(b) and the filing of a response by an applicant under § 1.617(b). Only the Board, however, may enter a summary judgment. See § 1.617(b).

Any opponent may attack the sufficiency of an applicant's showing under § 1.608(b) when that showing is presented as evidence under § 1.672. In summary judgment proceedings, all an applicant need do is make out a *prima facie* case. If the interference is allowed to proceed in the normal manner, the applicant must prove priority by a preponderance of evidence (when the application and the patent are copending) or beyond a reasonable doubt (when the application was filed after the patent issued). Manifestly, the burden in summary judgment proceedings is not as strict as the burden in proceedings following summary judgment. *Breuer* v. *DeMarinis,* 558 F.2d 22, 28, 194 USPQ 308, 313 (CCPA 1977) and *Schwab* v. *Pittman,* 451 F.2d 637, 640, 172 USPQ 69, 71 (CCPA 1971).

The second sentence of § 1.617(d) is intended to make clear that opponents may file statements in response to an applicant's "response," but the statement "shall be limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the examiner-in-chief for issuing the order to show cause." The PTO does not intend to expand summary judgment proceedings into a "mini-

interference." An applicant presents evidence under § 1.608(b). If the examiner-in-chief finds that evidence insufficient, an order to show cause stating reasons for the insufficiency is issued. An applicant may respond and, if appropriate, file "additional evidence." The PTO intends to be rather strict in permitting the filing of new evidence. After the applicant responds (with or without additional evidence), any opponent may file a statement. In the statement, the opponent should be free to comment on all the evidence (original and additional) which the applicant presents. Compare *In re Plockinger,* 481 F.2d 1327, 179 USPQ 103 (CCPA 1973). Under § 1.617(d) the opponent may not urge a rationale for summary judgment which does not appear in the order to show cause issued by the examiner-in-chief. However, it is not the PTO's intent to interpret § 1.617(d) in the narrow manner the Court of Customs and Patent Appeals interpreted 37 CFR § 1.204(c) in *Kahl* v. *Scoville,* 609 F.2d 991, 995–996, 203 USPQ 652, 656 [headnote 6] (CCPA 1979). An example will illustrate how the PTO intends to interpret § 1.617(d).

Example. An applicant copies claims from a patent and is required to submit a showing under § 1.608(b). Upon review of the showing under § 1.608(b), the examiner-in-chief concludes that the showing fails to make out a *prima facie* case of priority, because applicant has failed to show an actual reduction to practice. Applicant files a response and includes additional evidence which purports to show an actual reduction to practice. The patentee then files a statement in which two arguments are made. *First,* patentee argues that the additional evidence has not been properly authenticated. *Second,* patentee argues that even if applicant has shown an actual reduction to practice, summary judgment is nevertheless appropriate because applicant suppressed and concealed after the actual reduction to practice. The first argument is proper, but the second argument is not. A patentee may comment on the sufficiency of the applicant's evidence. Fairness, however, dictates that summary judgment be granted only after fair notice in the order to show cause. Accordingly, summary judgment will not be based on a rationale raised by a patentee in a statement which does not correspond to the rationale used by the examiner-in-chief in the the order to show cause.

Once summary judgment proceedings have concluded, an interference will proceed "in the normal manner." The change is intended to codify the decisions in *Walsh* v. *Sakai,* 167 USPQ 465 (Comm'r.Pat. 1967) and *Ing* v. *Chiou,* 207 USPQ 321 (Comm'r.Pat. 1979).

2318 Return of Unauthorized Papers [R–2]

37 CFR 1.618 Return of unauthorized papers. (a) The Patent and Trademark Office shall return to a party any paper presented by the party when the filing of the paper is not authorized by, or is not in compliance with the requirements of, this subpart. Any paper returned will not thereafter be considered by the Patent and Trademark Office in the interference. A party may be permitted to file a corrected paper under such conditions as may be deemed appropriate by an examiner-in-chief.

(b) When presenting a paper in an interference, a party shall not submit with the paper a copy of a paper previously filed in the interference.

Under § 1.618, the PTO has authority to return to a party any paper presented in an interference which is not authorized by, or is not in compliance with the requirements of, Subpart E of the Rules of Practice. When an improper paper is filed, a party may be given an opportunity to file a proper paper under such conditions as an examiner-in-chief may deem appropriate. Two examples of improper papers are: (1) replies to replies which are not authorized by the rules and (2) papers presented which have attached thereto a paper previously filed in the interference.

2312 Preliminary Statement. Time for Filing [R–2]

37 CFR 1.621 Preliminary statement, time for filing, notice of filing. (a) Within the time set for filing preliminary motions under § 1.633, each party may file a preliminary statement. The preliminary statement may be signed by any individual having knowledge of the facts recited therein or by an attorney or agent of record.

(b) When a party files a preliminary statement, the party shall also simultaneously file and serve on all opponents in the interference a notice stating that a preliminary statement has been filed. A copy of the preliminary statement need not be served until ordered by an examiner-in-chief.

Sections 1.621 through 1.629 govern preliminary statements which continue to be required in interference cases.

Under § 1.621, a preliminary statement can be signed by any individual having knowledge of the facts (e.g., the inventor) or by an attorney or agent of record. Permitting an attorney or agent of record to sign a preliminary statement eliminates unnecessary mailing of papers between parties and their attorney or agent.

A preliminary statement serves several useful purposes in an interference: (1) it serves to limit a party's proofs as to time, (2) it serves as a vehicle for permitting the examiner-in-chief or the Board to issue orders to show cause in those cases where it would be futile to take testimony, and (3) it serves as notice to an opponent of the case which is alleged by a party. Under the rules the issues which will be raised and decided by the Board at final hearing are made known during the interlocutory stage through (a) the preliminary statement, (b) motions under § 1.633 and decisions thereon, and (c) notices under § 1.632 of a party's intent to argue abandonment, suppression, or concealment.

The preliminary statements must be filed within the time set for filing preliminary motions, and the opposing parties notified of their filing. However, they are not served until ordered by the examiner-in-chief, after preliminary motions (if any) have been decided.

2322 Preliminary Statement, Invention Made by Who and Where [R–2]

37 CFR 1.622 Preliminary statement, who made invention, where invention made. (a) A party's preliminary statement must identify the inventor who made the invention defined by each count and must state on behalf of the inventor the facts required by paragraph (a) of §§ 1.623, 1.624, and 1.625 as may be appropriate. When an inventor identified in the preliminary statement is not an inventor named in the party's application or patent, the party shall file a motion under § 1.634 to correct inventorship.

(b) The preliminary statement shall state whether the invention was made in the United States or abroad. If made abroad, the preliminary statement shall state whether the party is entitled to the benefit of the second sentence of 35 U.S.C. § 104.

Under § 1.622, the preliminary statement must identify the inventive entity who made the invention defined by each count. If one of the inventors included in the inventive entity identified in the preliminary statement is not an inventor named in the application or patent involved in the interference, a motion under § 1.634 must be diligently filed to correct inventorship.

2323 Preliminary Statement, Invention Made in United States [R-2]

37 CFR 1.623 Preliminary statement; invention made in United States. (a) When the invention was made in the United States or a party is entitled to the benefit of the second sentence of 35 U.S.C. § 104, the preliminary statement must state the followng facts as to the invention defined by each count:

(1) The date on which the first drawing of the invention was made.

(2) The date on which the first written description of the invention was made.

(3) The date on which the invention was first disclosed by the inventor to another person.

(4) The date on which the invention was first conceived by the inventor.

(5) The date on which the invention was first actually reduced to practice. If the invention was not actually reduced to practice by or on behalf of the inventor prior to the party's filing date, the preliminary statement shall so state.

(6) The date after the inventor's conception of the invention when active excercise of reasonable diligence toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with § 1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or written description cannot be filed with the preliminary statement.

Sections 1.623, 1.624, and 1.625 respectively set out the allegations which should be made in, and the attachments which should accompany, a preliminary statement when (1) the invention was made in the United States, (2) the invention was made abroad and was introduced into the United States, and (3) derivation by an opponent from a party is to be an issue.

2324 Preliminary Statement, Invention Made Abroad [R-2]

37 CFR 1.624 Preliminary statement; invention made abroad. (a) When the invention was made abroad and a party intends to rely on introduction of the invention into the United States, the preliminary statement must state the following facts as to the invention defined by each count:

(1) The date on which a drawing of the invention was first introduced into the United States.

(2) The date on which a written description of the invention was first introduced into the United States.

(3) The date on which the invention was first disclosed to another person in the United States.

(4) The date on which the inventor's conception of the invention was first introduced into the United States.

(5) The date on which an actual reduction to practice of the invention was first introduced into the United States. If an actual reduction to practice of the invention was not introduced into the United States, the preliminary statement shall so state.

(6) The date after introduction of the inventor's conception into the United States when active exercise of reasonable diligence in the United States toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with § 1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was introduced into the United States a copy of that drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was introduced into the United States a copy of that written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or first written description introduced in the United States cannot be filed with the preliminary statement.

Breuer v. *DeMarinis*, 558 F.2d 22, 194 USPQ 308 (CCPA 1971), illustrates a case where an actual reduction to practice abroad was introduced into the United States.

2325 Preliminary Statement, Derivation by an Opponent [R-2]

37 CFR 1.625 Preliminary statement; derivation by an opponent. (a) When the invention was made in the United States or abroad and a party intends to prove derivation by an opponent from the party, the preliminary statement must state the following as to the invention defined by each count:

(1) The name of the opponent.

(2) The date on which the first drawing of the invention was made.

(3) The date on which the first written description of the invention was made.

(4) The date on which the invention was first disclosed by the inventor to another person.

(5) The date on which the invention was first conceived by the inventor.

(6) The date on which the invention was first communicated to the opponent.

(b) If a party intends to prove priority, the preliminary statement must also comply with § 1.623 or § 1.624.

(c) When a party alleges under paragraph (a)(2) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(3) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a first drawing or first written description cannot be filed with the preliminary statement.

A party does not have to allege derivation in a preliminary statement where the party does not know derivation occurred until the testimony period. Section 1.625 requires a party to file a preliminary statement when derivation is an issue. If derivation is not known or discovered prior to the date the preliminary statement is due, a party must move to amend the preliminary statement and allege derivation promptly after existence of derivation is discovered.

2326 Preliminary Statement, Earlier Application [R-2]

37 CFR 1.626 Preliminary statement; earlier application. When a party does not intend to present evidence to prove a conception or an actual reduction to practice and the party intends to rely solely on the filing date of an earlier application filed in the United States or abroad to prove a constructive reduction to practice, the preliminary statement may so state and identify the earlier application with particularity.

Section 1.626 permits a party to file a preliminary statement which states that the party only intends to rely on the filing date of an earlier United States or

foreign application. Ordinarily, a junior party who fails to file a preliminary statement is not entitled to access to any other preliminary statement filed (see § 1.631(b)). Section 1.626 permits a junior party who only intends to rely on an earlier application to have access to any opponent's preliminary statement.

2327 Preliminary Statement, Sealing and Opening [R-2]

37 CFR 1.627 Preliminary statement, sealing before filing, opening of statement. (a) The preliminary statement and copies of any drawing or written description shall be filed in a sealed envelope bearing only the name of the party filing the statement and the style (e.g., *Jones* v. *Smith*) and number of the interference. The sealed envelope should contain only the preliminary statement and copies of any drawing or written description. If the preliminary statement is filed through the mail, the sealed envelope should be enclosed in an outer envelope addressed to the Commissioner of Patents and Trademarks in accordance with § 1.1(e).

(b) A preliminary statement may be opened only at the direction of an examiner-in-chief.

2328 Preliminary Statement, Correction of Error [R-2]

37 CFR 1.628 Preliminary statement, correction of error. (a) A material error arising through inadvertence or mistake in connection with (1) a preliminary statement or (2) drawings or a written description submitted therewith or omitted thereform, may be corrected by a motion (§ 1.635) for leave to file a corrected statement. The motion shall be supported by an affidavit and shall show that the correction is essential to the ends of justice and shall be accompanied by the corrected statement. The motion shall be filed as soon as practical after discovery of the error.

(b) When a party cannot attach a copy of a drawing or a written description to the party's preliminary statement as required by §§ 1.623(c), 1.624(c), or 1.625(c), the party (1) shall show good cause and explain in the preliminary statement why a copy of the drawing or written description cannot be attached to the preliminary statement and (2) shall attach to the preliminary statement the earliest drawing or written description made in or introduced into the United States which is available. The party shall file a motion (§ 1.635) to amend its preliminary statement promptly after the first drawing, first written description, or drawing or written description first introduced into the United States becomes available. A copy of the drawing or written description may be obtained, where appropriate, by a motion (§ 1.635) for additional discovery under § 1.687 or during a testimony period.

Section 1.628 sets out how an error in a preliminary statement may be corrected.

Section 1.628(b) covers the possibility that a drawing might not be available, e.g., a drawing destroyed in "a fire." Section 1.628(b) permits a party to allege a date when a first drawing or first written description was made in those circumstances where the first drawing or first written description is not available. The party is required (1) to show good cause and explain in the preliminary statement why a copy of the drawing or written description cannot be attached to the preliminary statement and (2) attach to the preliminary statement the earliest drawing or written description made in or introduced into the United States which is available. The party is also required to file a motion to amend its preliminary statement promptly after the drawing or written description becomes available. It is the PTO's intent by the amendment to § 1.628(b) to overrule the holding of headnote [1] of *Reddy* v. *Davis*, 187 USPQ 386, 388 (Comm'r Pat. 1975).

2329 Preliminary Statement, Effect of [R-2]

37 CFR 1.629 Effect of preliminary statement. (a) A party shall be strictly held to any date alleged in the preliminary statement. Doubts as to (1) definiteness or sufficiency of any allegation in a preliminary statement or (2) compliance with formal requirements will be resolved against the party filing the statement by restricting the party to the earlier of its filing date or effective filing date or to the latest date of a period alleged in the preliminary statement as may be appropriate. A party may not correct a preliminary statement except as provided by § 1.628.

(b) Evidence which shows that an act alleged in the preliminary statement occurred prior to the date alleged in the statement shall establish only the act occurred as early as the date alleged in the statement.

(c) If a party does not file a preliminary statement, the party:

(1) shall be restricted to the earlier of the party's filing date or effective filing date and

(2) will not be permitted to prove that:

(i) the party made the invention prior to the party's filing date or

(ii) any opponent derived the invention from the party.

(d) If a party files a preliminary statement which contains an allegation of a date of first drawing or first written description and the party does not file a copy of the first drawing or written description with the preliminary statement as required by § 1.623(c), § 1.624(c), or § 1.625(c), the party will be restricted to the earlier of the party's filing date or effective filing date as to that allegation unless the party complies with § 1.628(b). The content of any drawing or written description submitted with a preliminary statement will not normally be evaluated or considered by the Board.

(e) A preliminary statement shall not be used as evidence on behalf of the party filing the statement.

Section 1.629 sets out the effect of a preliminary statement. A party who fails to file a preliminary statement will not be permitted to prove (1) that the party made the invention defined by a count prior to the party's filing date or (2) that an opponent derived the invention from the party.

2330 Reliance on Earlier Application [R-2]

37 CFR 1.630 Reliance on earlier application. A party shall not be entitled to rely on the filing date of an earlier application filed in the United States or abroad unless (a) the earlier application is identified (§ 1.611(c)(5)) in the notice declaring the interference or (b) the party files a preliminary motion under § 1.633 seeking the benefit of the filing date of the earlier application.

2331 Preliminary Statement Access [R-2]

37 CFR 1.631 Access to preliminary statement, service of preliminary statement. (a) Unless otherwise ordered by an examiner-in-chief, concurrently with entry of a decision by the examiner-in-chief on preliminary motions filed under § 1.633, any preliminary statement filed under § 1.621(a) shall be opened to inspection by the senior party and any junior party who filed a preliminary statement. Within a time set by the examiner-in-chief, a party shall serve a copy of its preliminary statement on each opponent who served a notice under § 1.621(b).

(b) A junior party who does not file a preliminary statement shall not have access to the preliminary statement of any other party.

(c) If an interference is terminated before the preliminary statements have been opened, the preliminary statements will remain sealed and will be returned to the respective parties who submitted the statements.

Under § 1.631, preliminary statements normally will be opened for inspection when an examiner-in-chief decides preliminary motions filed under § 1.633. A junior party who does not file a preliminary statement is not entitled to access to a preliminary statement of any other party. When an interference is terminated

before preliminary statements are opened, any preliminary statement which has been filed will be returned unopened to the party who submitted the statement. The rules do not require all parties to file a preliminary statement. If a junior party does not file a preliminary statement, it will be denied access to any other preliminary statement which is filed. A senior party, however, is always entitled to access to any preliminary statement filed by a junior party. See e.g., § 1.631(b). However, a junior party is only required to serve a senior party who files a statement.

2332 Abandonment, Suppression or Concealment to be Argued [R-2]

37 CFR 1.632 Notice of intent to argue abandonment, suppression or concealment by opponent. A notice shall be filed by a party who intends to argue that an opponent has abandoned, suppressed, or concealed an actual reduction to practice (35 U.S.C. § 102(g)). A party will not be permitted to argue abandonment, suppression, or concealment by an opponent unless the notice is timely filed. Unless authorized otherwise by an examiner-in-chief, a notice is timely when filed within ten (10) days of the close of the testimony-in-chief of the opponent.

Under § 1.632, a notice must be filed by a party who intends to argue that an opponent abandoned, suppressed, or concealed an actual reduction to practice. 35 U.S.C. 102(g). A party will not be permitted to brief (§ 1.656) or argue at final hearing (§ 1.654) that an opponent abandoned, suppressed, or concealed an actual reduction to practice unless the notice is timely filed. A notice is timely if filed within ten (10) days after the close of the testimony-in-chief period of an opponent. While a party has the burden of proving that an opponent abandoned, suppressed, or concealed, the burden may be discharged on the basis of the opponent's evidence alone. *Shindelar* v. *Holdeman,* 628 F.2d 1337, 207 USPQ 112 (CCPA 1980). See also *Correge* v. *Murphy,* 705 F.2d 1326, 217 USPQ 753 (Fed. Cir. 1983); *Horwath* v. *Lee,* 564 F.2d 948, 195 USPQ 701 (CCPA 1977); and *Peeler* v. *Miller,* 535 F.2d 647, 190 USPQ 117 (CCPA 1976). Under previous practice where notice was not required, it was possible that a party might learn for the first time that abandonment, suppression, or concealment was an issue when the party received an opponent's brief at final hearing. See *Klug* v. *Wood,* 212 USPQ 767, 771 n. 2 (Bd.Pat.Int. 1981). At that point, it was often too late to reopen proceedings in the interference. The purpose of requiring the notice under § 1.632 is to make the parties and the Board aware during the interlocutory stage of an interference that abandonment, suppression, or concealment may be an issue in the interference. Early notice permits the parties to ask for and the examiner-in-chief to set appropriate testimony periods for a party to present evidence related to abandonment, suppression, and concealment, particularly in those cases where long unexplained delays tend to prove the allegation of suppression or concealment. Early notice also eliminates the need for the party moving to reopen the testimony period. *Klug* v. *Wood, supra.*

2333 Preliminary Motions [R-2]

37 CFR 1.633 Preliminary Motions. A party may file the following preliminary motions:

(a) A motion for judgment on the ground that an opponent's claim corresponding to a count is not patentable to the opponent. In determining a motion filed under this paragraph, a claim may be construed by reference to the prior art of record. A motion under this paragraph shall not be based on: (1) priority of invention of the subject matter of a count by the moving party as against any opponent or (2) derivation of the subject matter of a count by an opponent from the moving party. See § 1.637(a)

(b) A motion for judgment on the ground that there is no interference-in-fact. A motion under this paragraph is proper only if: (1) the interference involves a design application or patent or a plant application or patent or (2) no claim of a party which corresponds to a count is identical to any claim of an opponent which corresponds to that count. See § 1.637(a)

(c) A motion to redefine the interfering subject matter by (1) adding or substituting a count, (2) amending an application claim corresponding to a count or adding a claim in the moving party's application to be designated to correspond to a count, (3) designating an application or patent claim to correspond to a count, (4) designating an application or patent claim as not corresponding to a count, or (5) requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count. See § 1.637(a) and (c).

(d) A motion to substitute a different application owned by a party for an application involved in the interference. See § 1.637 (a) and (d).

(e) A motion to declare an additional interference (1) between an additional application not involved in the interference and owned by a party and an opponent's application or patent involved in the interference or (2) when an interference involves three or more parties, between less than all applications and any patent involved in the interference. See § 1.637 (a) and (e).

(f) A motion to be accorded the benefit of the filing date of an earlier application filed in the United States or abroad. See § 1.637 (a) and (f).

(g) A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier application filed in the United States or abroad. See § 1.637 (a) and (g).

(h) When a patent is involved in an interference and the patentee has on file or files an application for reissue under § 1.171, a motion to add the application for reissue to the interference. See § 1.637 (a) and (h).

(i) When a motion is filed under paragraph (a), (b), or (g) of this section, an opponent, in addition to opposing the motion, may file a motion to redefine the interfering subject matter under paragraph (c) of this section or a motion to substitute a different application under paragraph (d) of this section.

(j) When a motion is filed under paragraph (c)(1) of this section an opponent, in addition to opposing the motion, may file a motion for benefit under paragraph (f) of this section as to the count to be added or substituted.

Under § 1.633, a party may file preliminary motions for judgment, to redefine the interference, to substitute a different application in the interference, to declare an additional interference, to be accorded the benefit of an earlier application, to attack benefit previously accorded an opponent, or to add a reissue application to the interference. The motions are called "preliminary motions" in order to distinguish the motions from other motions which might be filed during the course of an interference. The preliminary motions replace motions authorized by former 37 CFR § 1.231, now deleted.

It was particularly important, under previous practice, to review one's proofs in advance and bring such motions under 37 CFR 1.231 as might be necessary to

conform the counts to the proofs and to avoid post-interference estoppel. See Torchin, *The Pitfall of Interference Practice: 37 CFR 1.231*, 60 J.P.O.S. 579 (1978). Close attention to the preliminary motions is even more necessary under the new rules, in view of the more stringent estoppel provisions imposed by 37 CFR 1.658(c), discussed below in the "Final Hearing" section.

Under § 1.633(a), a party can file a motion for judgment on the ground that an opponent's *claim* corresponding to a count is unpatentable to the opponent. With two exceptions, unpatentability can be based on prior art (35 U.S.C. 102, 103), insufficiency of disclosure (35 U.S.C. 112, first paragraph), indefiniteness of claims (35 U.S.C. 112, second paragraph), double patenting, estoppel, or any other ground which would support a holding that claims corresponding to a count are not patentable. The two exceptions are (1) priority of invention of the subject matter of a count by the moving party as against any opponent and (2) derivation of the subject matter of a count by the opponent from the moving party. The two exceptions are directed to issues which are traditional "priority" issues, e.g., which inventor made the invention defined by a count first or, when derivation is an issue, who made the invention. Resolution of those "priority" issues almost always requires the taking of testimony. A motion for judgment, however, is proper when a party believes an individual not involved in the interference made the invention defined by the count prior to an opponent in the interference, but subsequent to the moving party. Thus, a patentability issue, such as that raised under 35 U.S.C. § 102(g) in *Sutter Products Co.* v. *Pettibone Mulliken Corp.*, 428 F.2d 639, 166 USPQ 100 (7th Cir. 1970), can properly be raised with a motion for judgment under § 1.633(a). Derivation by an opponent from an individual not involved in the interference can also be raised under § 1.633(a).

Under § 1.633(b), a party can move for a judgment when the party believes there is no interference-in-fact. A motion for judgment on the ground of no interference-in-fact is only proper under one of three conditions: (1) when an interference involves designs, (2) when the interference involves plant applications or a plant application and plant patent, or (3) when no claim of a party which corresponds to a count is identical to any claim of an opponent which corresponds to that count. An example illustrates when a motion under § 1.636(b) is proper.

Example 1. Application AD contains patentable claim 1 (6-cylinder engine). Application AE contains patentable claim 3 (8-cylinder engine). An interference is declared with a single count (6- or 8-cylinder engine). Claim 1 of application AD and claim 3 of application AE are designated to correspond to the count. Applicant AD believes that a 6-cylinder engine is a "separate patentable invention" (see § 1.601(n)) from an 8-cylinder engine. Applicant AD can file a motion under § 1.633(b) for a judgment on the ground of no interference-in-fact stating why a 6-cylinder engine is patentably distinct from an 8-cylinder engine. If the Board ultimately agrees with applicant AD, a patent can issue to AD containing claim 1 of application AD and a second patent can issue to AE containing claim 3 of application AE.

Under § 1.633(c), a party may move to redefine interfering subject matter. One way to redefine interfering subject matter is to add or substitute a count. When a party seeks to add a count, the party is required to demonstrate that the proposed count to be added is directed to a "separate patentable invention" from every other count in the interference.

A motion may be filed to amend an application claim which has already been designated to correspond to a count. See § 1.633(c)(2). Such a motion may be filed when a party believes an application claim designated to correspond to a count is unpatentable and the amended claim is believed to be patentable.

An applicant may move to add a claim to the applicant's application and to designate the claim to be added to correspond to a count. See § 1.633(c)(2). Such a motion may be filed when the applicant discloses specific subject matter which is not claimed, wants to claim the subject matter, and have the subject matter involved in the interference.

Another way to redefine interfering subject matter is to designate a claim as corresponding or not corresponding to a count. See § 1.633(c)(3) and (c)(4). The following examples illustrate this latter point.

Example 2. Application AF contains patentable claim 1 (engine). Patent K contains claims 3 (engine) and 5 (6-cylinder engine). Claim 1 of application AF and claim 3 of patent K are designated to correspond to the count. Applicant AF believes a 6-cylinder engine is the "same patentable invention" (see § 1.601(n)) as engine. Applicant AF can file a motion under § 1.633(c)(3) to designate claim 5 of patent K as corresponding to the count. If the motion is granted and applicant AF prevails in the interference, judgment will be entered against patentee K and both claims 3 and 5 of patent K will be cancelled under 35 U.S.C. § 135(a).

Example 3. Application AG contains patentable claim 1 (engine). Patent L contains claims 3 (engine) and 5 (8-cylinder engine). An interference is declared with one count (engine). Claim 1 of application AG and claims 3 and 5 of patent L are designated to correspond to the count. Patentee L believes that an 8-cylinder engine defines a "separate patentable invention" (see § 1.601(n)) from engine. Patentee L should file a motion under § 1.633(c)(4) to designate claim 5 of patent L as "not corresponding" to the count. If the motion is granted and an adverse judgment is entered against patentee L, only claim 3 will be cancelled from the patent pursuant to 35 U.S.C. § 135(a).

A motion to redefine the interfering subject matter may also request that an opponent who is an applicant be required to add a claim to the opponent's application and to designate the claim to correspond to a count. See § 1.633(c)(5). Such a motion may be filed when a party sees that the opponent discloses, but does not claim, subject matter which the party believes should be involved in the interference.

Section 1.633(i) continues the previous practice (from 37 CFR § 1.231) of allowing a party to move to redefine the subject matter of the interference or substitute a different application when an opponent moves for judgment (see § 1.633(a) and (b)) or to attack benefit (see § 1.633(g)).

Paragraph (j) of § 1.633 permits an opponent to move for benefit when a party moves to add or substitute a count. Thus, when a motion to add a count is

filed by a party and an opponent wants benefit of an earlier application in the event the motion to add is granted, the opponent should file a motion under § 1.633(j) to be accorded benefit. The mere fact that the opponent had been accorded benefit of an earlier application when the interference was declared does not mean the opponent will be accorded benefit as to some other count which may be added on motion of some other party.

Section 1.633(e) adopts the estoppel rule approved by the Court of Customs and Patent Appeals in *Avery* v. *Chase*, 101 F.2d 205, 40 USPQ 343 (CCPA 1939), *cert. denied*, 307 U.S. 638 (1939).

The following comment by the CCPA in its opinion in *In re Shimer*, 69 F.2d 556, 558, 21 USPQ 161, 163 (CCPA 1934), accurately expresses the intent of the PTO in promulgating §§1.633(e) and 1.658(c):

> "It may be stated that this rule works no hardship to him who is diligent in pursuit of his rights. When an interference is declared, the files of his contestants are open to him. He has full cognizance of their disclosures and claims. So advised, it becomes his duty to put forward every claim he has. [Rule 1.633(e)] . . . affords him this opportunity. If the rule be not enforced or enforceable, then delays and litigation are greatly increased. It is quite obvious that the doctrine of estoppel, as applied in these cases, results in the better conduct of the business of the Patent [and Trademark] Office and in the public good."

If a party believes that an opponent has committed "fraud" or has engaged in "inequitable conduct," the party may file a motion under § 1.633(a) for judgment. Obviously, a motion for judgment on the basis of "fraud" or "inequitable conduct" must make out a case by clear and convincing evidence. The examiner-in-chief has sufficient authority under the rules to preclude a party from proceeding in an interference on a baseless charge of "fraud" or "inequitable conduct." See also 37 CFR 10.23(c)(18).

2333.01 Preliminary Motions—Related to Application Not Involved in Interference [R-2]

Whenever a party in interference brings a motion under 37 CFR 1.633(d) or (e) concerning an application not already included in the interference, the examiner-in-chief should at once send the primary examiner a written notice of such motion and the primary examiner should place this notice in said application file.

The notice is customarily sent to the examining group which declared the interference since the application referred to in the motion is generally examined in the same group. However, if the application is not being examined in the same group, then the correct examing group should be ascertained and the notice forwarded to that group.

This notice serves useful and essential purposes, and due attention must be given to it by the examiner when it is received. First, the examiner is cautioned by this notice not to consider *ex parte*, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party in interest. Second, if the application which is the subject of the motion is in issue and the last date for paying the issue fee will not permit determination of the motion, it will be necessary to withdraw the application from issue. Third, if the application contains an affidavit or declaration under 37 CFR 1.131 or 1.608, this must be sealed because the opposing parties have access to the application.

2333.02 Preliminary Motions—Benefit of Foreign Filing Date [R-2]

If a request for the benefit of a foreign filing date under 35 U.S.C. 119 is filed while an application is involved in interference, the papers are to be placed in the application file in the same manner as amendments received during interference, and appropriate action taken after the termination of the interference.

A party who desires to be accorded the benefit of a foreign filing date which was not accorded in the declaration papers should file a motion for benefit of that filing date under 37 CFR 1.633(f) and the matter will be considered on an *inter partes* basis.

2334 Motion to Correct Inventorship [R-2]

37 CFR 1.634 Motion to correct inventorship. A party may file a motion to (a) amend its application involved in an interference to correct inventorship as provided by § 1.48 or (b) correct inventorship of its patent involved in an interference as provided in § 1.324. See § 1.637(a).

Section 1.634 authorizes a motion to correct inventorship in an application (see § 1.48) or a patent (see § 1.324) involved in an interference.

A party who wishes to change the named inventive entity of its application or patent involved in an interference must do so by way of a motion under 37 CFR 1.634. Such a motion must be accompanied by the items required by 37 CFR 1.48 (in the case of an application) or 37 CFR 1.324 (in the case of a patent), and is decided by the examiner-in-chief. If the primary examiner becomes aware that papers under 37 CFR 1.48 or 1.324 have been filed in an application or patent, respectively, involved in an interference, the examiner should call them to the attention of the examiner-in-chief in charge of the interference.

2335 Miscellaneous Motions [R-2]

37 CFR 1.635 Miscellaneous motions. A party seeking entry of an order relating to any matter other than a matter which may be raised under §§ 1.633 or 1.634 may file a motion requesting entry of the order. See § 1.637(a) and (b).

Section 1.635 authorizes the filing of motions other than those specified in §§ 1.633 or 1.634. Motions filed under § 1.635 will be referred to as "miscellaneous motions" to distinguish from "preliminary motions" under § 1.633. Instances where a miscellaneous motion can be filed include motions to correct an error in a preliminary statement, to extend time for taking action or to seek judicial review, to obtain permission to proceed under 35 U.S.C. § 24, or to obtain additional discovery.

2336 Time for Filing Motions [R-2]

37 CFR 1.636 Motions, time for filing. (a) Preliminary motion under § 1.633(a) through (h) shall be filed within a time period set by an examiner-in-chief.

(b) A preliminary motion under § 1.633(i) or (j) shall be filed within 20 days of the service of the preliminary motion under § 1.633(a), (b), (c)(1), or (g) unless otherwise ordered by an examiner-in-chief.

(c) A motion under § 1.634 shall be diligently filed after an error is discovered in the inventorship of an application or patent involved in an interference unless otherwise ordered by an examiner-in-chief.

(d) A motion under § 1.635 shall be filed as specified in this subpart or when appropriate unless otherwise ordered by an examiner-in-chief.

Section 1.636 sets out the times within which a motion can be filed.

A party must exercise diligence in correcting inventorship. *Van Otteren* v. *Hafner*, 278 F.2d 738, 126 USPQ 151 (CCPA 1960).

2337 Motion Content [R-2]

37 CFR 1.637 Content of motions. (a) Every motion shall include (1) a statement of the precise relief requested, (2) a statement of the material facts in support of the motion, and (3) a full statement of the reasons why the relief requested should be granted.

(b) A motion under § 1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all opposing parties in an effort in good faith to resolve by agreement the issues raised by the motion. A moving party shall indicate in the motion whether any other party plans to oppose the motion. The provisions of this paragraph do not apply to a motion to suppress evidence (§1.656(h)).

(c) A preliminary motion under §1.633(c) shall explain why the interfering subject should be redefined.

(1) A preliminary motion seeking to add or substitute a count shall:

(i) Propose each count to be added or substituted.

(ii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the application.

(iii) Identify all claims in an opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claims to the opponent and apply the terms of the claims to the disclosure of the opponent's application.

(iv) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(v) Show that each proposed count defines a separate patentable invention from every other count in the interference.

(vi) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.

(2) A preliminary motion seeking to amend an application claim corresponding to a count or adding a claim to be designated to correspond to a count shall:

(i) Propose an amended or added claim.

(ii) Show that the proposed or added claim defines the same patentable invention as the count.

(iii) Show the patentability to the applicant of each amended or added claim and apply the terms of the amended or added claim to the disclosure of the application; when necessary a moving party applicant shall file with the motion an amendment making the amended or added claim to the application.

(iv) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.

(3) A preliminary motion seeking to designate an application or patent claim to correspond to a count shall:

(i) Identify the claim and the count.

(ii) Show the claim defines the same patentable invention as the count.

(iii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.

(4) A preliminary motion seeking to designate an application or patent claim as not corresponding to a count shall:

(i) Identify the claim and the count.

(ii) Show the claim does not define the same patentable invention as any other claim designated in the notice declaring the interference as corresponding to the count.

(5) A preliminary motion seeking to require an opponent who is an applicant to add a claim and designate the claim as corresponding to count shall:

(i) Proposes a claim to be added by the opponent.

(ii) Show the patentability to the opponent of the claim and apply the terms of the claim to the disclosure of the opponent's application.

(iii) Identify the count to which the claim shall be designated to correspond.

(iv) Show the claim defines the same patentable invention as the count to which it will be designated to correspond.

(d) A preliminary motion under § 1.633(d) to substitute a different application shall:

(1) Identify the different application.

(2) Certify that a complete copy of the file of the different application, except for documents filed under § 1.131 or § 1.608(b), has been served on all opponents.

(3) Show the patentability to the applicant of all claims in, or proposed to be added to, the different application which correspond to each count and apply the terms of the claims to the disclosure of the different application; when necessary the applicant shall file with the motion an amendment adding a claim to the different application.

(4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

(e) A preliminary motion to declare an additional interference under § 1.633(e) shall explain why an additional interference is necessary.

(1) When the preliminary motion seeks an additional interference under § 1.633(e)(1), the motion shall:

(i) Identify the additional application.

(ii) Certify that a complete copy of the file of the additional application, except for documents filed under § 1.131 of § 1.608(b), has been served on all opponents.

(iii) Propose a count for the additional interference.

(iv) Show the patentability to the applicant of all claims in, or proposed to be added to, the additional application which correspond to each proposed count for the additional interference and apply the terms of the claims to the disclosure of the additional application; when necessary the applicant shall file with the motion an amendment adding a claim to the additional application.

(v) When the opponent is an applicant, show the patentability to the opponent of any claims in, or proposed to be added to, the opponent's application which correspond to the proposed count and apply the terms of the claims to the disclosure of the opponent's application.

(vi) When the opponent is a patentee, designate the claims of the patent which define the same patentable invention defined by the proposed count.

(vii) Show that each proposed count for the additional interference defines a separate patentable invention from all counts of the interference in which the motion is filed.

(viii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

(2) When the preliminary motion seeks an additional interference under § 1.633(e)(2), the motion shall:

(i) Identify any application or patent to be involved in the additional interference.

(ii) Propose a count for the additional interference.

(iii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the applicant.

(iv) Identify all claims in any opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claims to the opponent and apply the terms of the claims to the disclosure of the opponent's application.

(v) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(vi) Show that each proposed count for the additional interference defines a separate patentable invention from all counts in the interference in which the motion is filed.

(vii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

(f) A preliminary motion for benefit under § 1.633(f) shall:

(1) Identify the earlier application.

(2) When the earlier application is an application filed in the United States, certify that a complete copy of the file of the earlier application, except for documents filed under § 1.131 or § 1.608(b), has been served on all opponents. When the earlier application is an application filed abroad, certify that a copy of the application filed abroad has been served on all opponents. If the earlier application filed abroad is not in English, the requirements of § 1.647 must also be met.

(3) Show that the earlier application constitutes a constructive reduction to practice of each count.

(g) A preliminary motion to attack benefit under § 1.633(g) shall explain, as to each count, why an opponent should not be accorded the benefit of the filing date of the earlier application.

(h) A preliminary motion to add an application for reissue under § 1.633(h) shall:

(1) Identify the application for reissue.

(2) Certify that a complete copy of the file of the application for reissue has been served on all opponents.

(3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue; when necessary a moving applicant for reissue shall file with the motion an amendment adding a claim to the application for reissue.

(4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad.

Section 1.637 sets out the content of motions. In prior interference practice, parties and their counsel have had difficulty meeting all the "unwritten" requirements for motions under former 37 CFR § 1.231. Section 1.637 is quite specific in setting out the requirements for each type of motion, particularly the preliminary motions. By setting out with specificity the requirements for each type of motion, it is intended to minimize disposition of motions on technicalities.

Section 1.637 sets out the requirements of a motion under § 1.633(c)(5). Those requirements are: the moving party must (1) propose a claim to be added to the opponent's application, (2) show the patentability of the claim to the opponent and apply the terms of the claim to the disclosure of the opponent's application, (3) identify the count to which the proposed claim shall be designated to correspond, and (4) show that the proposed claim defines the same patentable invention as the count to which it will be designated to correspond. The following example illustrates how practice under §§ 1.633(c)(5) and 1.637(c)(5) is expected to occur.

Example. Application AV discloses engines and in particular a 6-cylinder engine. Application AV contains only claim 1 (engine). Application AW discloses engines in general, but does not specifically disclose a 6-cylinder engine. Application AW contains only a single claim 3 (engine). Seeing that application AV specifically discloses a 6-cylinder engine and believing that a 6-cylinder engine is the same patentable invention as "engine," AW could move under § 1.633(c)(5) to require applicant AV to add a claim (6-cylinder engine) and to have the claim designated to correspond to the count (engine). Applicant AV could oppose on the ground that a 6-cylinder engine is not the "same patentable invention" as "engine." If the motion is granted, applicant AV would be required to add a claim to 6-cylinder engine and the claim would be designated to correspond to the count. If applicant AV loses the interference, the judgment would preclude applicant AV from obtaining a patent with claims to "engine" or "6-cylinder engine." If the motion is denied on the basis that a 6-cylinder engine is not the same patentable invention, applicant AV would not be required to present a claim to 6-cylinder engine and would be able to pursue such a claim *ex parte* even if applicant AV loses the interference.

If an applicant is ordered by an examiner-in-chief to file an amendment to present a claim and the applicant fails or refuses to timely present the amendment, the failure or refusal will be taken without further action as a disclaimer by the applicant of the subject matter of the claim. See the second sentence of § 1.640(b)(1).

Under the rules, it is not the intent of the PTO to allow a senior party to test the sufficiency of the case-in-chief of a junior party prior to final hearing. Thus, a "motion for a directed verdict" (see Rule 50(a) of the Federal Rules of Civil Procedure) at the conclusion of the junior party's case-in-chief and prior to a senior party's case-in-chief is not authorized under the rules. If a senior party believes the case-in-chief of the junior party is insufficient as a matter of law, the senior party may *elect* to proceed immediately to final hearing. If the senior party is incorrect, however, the senior party will have waived any right to present any case-in-chief or rebuttal. See e.g., *Comstock* v. *Kroekel,* 200 USPQ 548, 550 n. 4 (Comm'r. Pat. 1978); *Lorenian* v. *Winstead,* 127 USPQ 501, 508 (Bd.Pat. Int. 1959); and, more recently, *Burson* v. *Carmichael,* 731 F.2d 849, 221 USPQ 664 (Fed. Cir. 1984) ("There is no support in law for repeated bites at the apple"). This would be true even if the only evidence relied upon by the junior party is a showing under § 1.608(b). In this respect, the rules codify the decision in *Walsh* v. *Sakai,* 167 USPQ 465 (Comm'r. Pat. 1970).

2338 Opposition and Reply [R-2]

37 CFR 1.638 Opposition and reply, time for filing opposition and reply. (a) Unless otherwise ordered by an examiner-in-chief, any opposition to any motion shall be filed within 20 days after service of the motion. An opposition shall (1) identify any material fact set forth in the motion which is in dispute and (2) include an argument why the relief requested in the motion should be denied.

(b) Unless otherwise ordered by an examiner-in-chief, a reply shall be filed within 15 days after service of the opposition. A reply shall be directed only to new points raised in the opposition.

Section 1.638 authorizes oppositions to motions. Any opposition must identify any material fact in dispute. A reply to an opposition is authorized for all motions. A reply to a reply is not authorized.

2339 Evidence in Support of Motion, Opposition, or Reply [R-2]

37 CFR 1.639 Evidence in support of motion, opposition, or reply. (a) Proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

(b) Proof may be in the form of patents, printed publications, and affidavits.

(c) When a party believes that testimony is necessary to support or oppose a preliminary motion under § 1.633 or a motion to correct inventorship under § 1.634, the party shall describe the nature of the testimony needed. If the examiner-in-chief finds that testimony is needed to decide the motion, the examiner-in-chief may grant appropriate interlocutory relief and enter an order authorizing the taking of testimony and deferring a decision on the motion to final hearing.

Section 1.639 sets forth the evidence which may accompany a motion, opposition, or reply. Every material fact alleged in a motion, opposition, or a reply must be supported by proof. Section 1.639(b) authorizes affidavits to be used as proof for any motion. The affidavit may later be used by a party during the testimony period (see §§ 1.671(e) and 1.672(b)). When a party believes that testimony is necessary to decide a motion under § 1.633 or § 1.634, the party must describe the nature of the testimony needed. If an examiner-in-chief agrees that testimony is needed, appropriate interlocutory relief will be granted and testimony will be ordered.

It should be noted that if affidavits cannot be timely prepared to be filed with a motion, the moving party may wish to take advantage of paragraph (c) of § 1.639 which requires a party to specify any testimony needed to resolve a motion. A moving party or an opponent may describe any testimony needed to resolve a motion under either § 1.633 or § 1.634. Often, testimony is needed to resolve inventorship disputes. Accordingly, a party may describe testimony needed to resolve motions to correct inventorship under § 1.634. It should be noted that if a party relies solely on affidavits in support of a motion (under § 1.633 or § 1.634) and the issue raised in the motion is to be considered at final hearing, the party must comply with § 1.671(e).

Example. An interference is declared with one count between application AH and application AJ. Applicant AH files a preliminary motion under § 1.633(c)(1) to redefine the interference by adding a second count. In order to succeed, applicant AH must show that the proposed count to be added is directed to a "separate patentable invention" (see § 1.601(n)) from the count already in the interference. In the motion, applicant AH sets forth in detail the testimony which will be required to prove that the subject matter of the proposed count is to a separate patentable invention from the subject matter of the count in the interference. Applicant AJ opposes the motion on the ground that the proposed and present counts define the "same patentable invention" (see § 1.601(n)). An examiner-in-chief determines that a material fact is in dispute and that applicant AH has established testimony is needed to properly rule on the motion. Under the circumstances, the motion will be deferred to final hearing and a testimony period will be ordered. The question of (1) whether the proposed and present counts define the same patentable invention and (2) priority will be decided at final hearing.

2340 Motions, Hearing and Decision [R-2]

37 CFR 1.640 Motions, hearing and decision, redeclaration of interference, order to show cause. (a) A hearing on a motion may be held in the discretion of the examiner-in-chief. The examiner-in-chief shall set the date and time for any hearing. The length of oral argument at a hearing on a motion is a matter within the discretion of the examiner-in-chief. An examiner-in-chief may direct that a hearing take place by telephone.

(b) Motions will be decided by an examiner-in-chief. An examiner-in-chief may consult with an examiner in deciding motions involving a question of patentability. An examiner-in-chief may grant or deny any motion or take such other action which will secure the just, speedy, and inexpensive determination of the interference.

(1) When preliminary motions under § 1.633 are decided, the examiner-in-chief will, when necessary, set a time for filing any amendment to an application involved in the interference and for filing a supplemental preliminary statement as to any new counts involved in the interference. Failure or refusal of a party to timely present an amendment required by an examiner-in-chief shall be taken without further action as a disclaimer by that party of the invention involved. A supplemental preliminary statement shall meet the requirements specified in §§ 1.623, 1.624, 1.625, or 1.626, but need not be filed if a party states that it intends to rely on a preliminary statement previously filed under § 1.621(a). After the time expires for filing any amendment and supplemental preliminary statement, the examiner-in-chief will, if necessary, redeclare the interference.

(2) After a decision is entered on preliminary motions filed under § 1.633, a further motion under § 1.633 will not be considered except as provided by § 1.655(b).

(c) When a decision on any motion under § 1.633, 1.634, or 1.635 is entered which does not result in the issuance of an order to show cause under paragraph (d) of this section, a party may file a request for reconsideration within 14 days after the date of the decision. The filing of a request for reconsideration will not stay any time period set by the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. No opposition to a request for reconsideration shall be filed unless requested by an examiner-in-chief or the Board. A decision of single examiner-in-chief will not ordinarily be modified unless an opposition has been requested by an examiner-in-chief or the Board. The request for reconsideration shall be acted on by a panel of the Board consisting of at least three examiners-in-chief, one of whom will normally be the examiner-in-chief who decided the motion.

(d) An examiner-in-chief may issue an order to show cause why judgment should not be entered against a party when:

(1) A decision on a motion is entered which is dispositive of the interference against the party as to all counts;

(2) The party is a junior party who fails to file a preliminary statement; or

(3) The party is a junior party whose preliminary statement fails to overcome the earlier of the filing date or effective filing date of another party.

(e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter a judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which shows good cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 20 days of the date of service of the paper. If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party. If a party wishes to take testimony in response to an order to show cause, the party's

response should be accompanied by a motion (§ 1.635) requesting the testimony period. See § 1.651(c)(4).

Under § 1.640, an examiner-in-chief will decide all motions. A hearing (in person or by telephone) may be held on a motion in the discretion of an examiner-in-chief. Where appropriate, an examiner-in-chief may consult with an examiner on a question of patentability which arises in the first instance in the interference. For example, a party may allege unpatentability over a reference not previously considered, or may attempt to add a count drawn to subject matter which was not previously examined. Consultation will not be necessary where the examiner had already ruled on the patentability question which comes before the examiner-in-chief or the Board.

The extent of the consultation will be determined by the examiner-in-chief; the examiner may be consulted merely on one point of patentability, or may be asked to conduct a search of newly-presented counts or claims. The consultation may be informal, as by a telephone call, or may be by a more formal written memorandum to the examiner.

It should be noted that nothing in § 1.640 authorizes conferences between examiners-in-chief and examiners in *ex parte* appeals under 35 U.S.C. 134 from an adverse decision of an examiner.

In rendering a decision, the examiner-in-chief is not limited to granting or denying a motion, but is also empowered to "take such other action which will secure the just, speedy, and inexpensive determination of the interference." 37 CFR 1.640(b).

A party is entitled to request reconsideration of a decision on a motion by a single examiner-in-chief. An opposition to a request for reconsideration may not be filed unless ordered by an examiner-in-chief or the Board, but the decision by the single examiner-in-chief will not normally be modified unless an opposition has been requested. The request for reconsideration will be acted on by a panel of the Board consisting of at least three examiners-in-chief, one of whom will normally be the examiner-in-chief who decided the motion. It is believed that parties in interference cases will feel that their requests for reconsideration are being more fully considered if more than one person considers their request. The two additional examiners-in-chief can consult with the examiner-in-chief most familiar with the case, but can control the decision on reconsideration by a majority vote. Use of the examiner-in-chief who decided the motion and two additional examiners-in-chief (1) minimizes delay which would occur if three new examiners-in-chief were used who were unfamiliar with the record and (2) minimizes the possibility that reversible error occurred if only the examiner-in-chief who decided the motion also individually decided the request for reconsideration.

After the decision on motions is rendered, the interference may take a number of different courses. If a motion for judgment is granted, the examiner-in-chief will issue an order to show cause against the party or parties to whom the motion applies. Judgment will be entered against the party or parties by the Board if they do not respond to the order. If a motion for judgment is not granted an order to show cause will be issued against a junior party who did not file a preliminary statement, or whose statement fails to overcome another party's effective filing date; otherwise, the interference proceeds to the testimony stage.

The former rules (37 CFR 1.231(d)) provided that a request for reconsideration of a decision on § 1.231 motions would not be entertained; however, a party could petition the Commissioner under 37 CFR 1.244 for the exercise of supervisory authority with respect to a motion decision. The revised rules effectively reverse this arrangement by providing that a party may request that the Board reconsider an examiner-in-chief's decision on any motion, except a decision granting a motion for judgment (37 CFR 1.640(c)). On the other hand, the ability to petition a decision on motions is sharply curtailed by the provision of 37 CFR 1.644(a)(2) that petitions seeking to invoke the supervisory authority of the Commissioner may not be filed prior to a decision by the Board awarding judgment.

2341 Unpatentability Discovered [R-2]

37 CFR 1.641 Unpatentability discovered by examiner-in-chief. During the pendency of an interference, if the examiner-in-chief becomes aware of a reason why a claim corresponding to a count may not be patentable, the examiner-in-chief may notify the parties of the reason and set a time within which each party may present its views. After considering any timely filed views, the examiner-in-chief shall decide how the interference shall proceed.

If the examiner, while the interference is pending, discovers a reference or other reason which he or she believes would render one or more of the parties' claims corresponding to the count(s) unpatentable, the reference or other reason should be brought to the attention of the examiner-in-chief in charge of the interference. The examiner-in-chief will determine what action, if any, should be taken in the interference.

2342 Addition to Interference [R-2]

37 CFR 1.642 Addition of application or patent to interference. During the pendency of an interference, if the examiner-in-chief becomes aware of an application or a patent not involved in the interference which claims the same patentable invention as a count in the interference, the examiner-in-chief may add the application or patent to the interference on such terms as may be fair to all parties.

Section 1.642 permits an examiner-in-chief to add a newly discovered patent, as well as newly discovered applications, to an interference since 35 U.S.C. 135(a) authorizes interferences between applications and patents.

Examiner Discovers Another Application or Patent During Interference

If, during the pendency of an interference, the examiner discovers another application or patent claiming subject matter which is the same as, or not patentably distinct from, the invention defined in a count of the interference, the examiner should bring the application or patent to the attention of the examiner-in-chief in charge of the interference. The examiner-in-

chief will determine what action, if any, should be taken in the interference.

If the application in question is for reissue of a patent involved in the interference, see § 2360.

2343 Prosecution by Assignee [R-2]

37 CFR 1.643 Prosecution of interference by assignee. (a) An assignee of record in the Patent and Trademark Office of the entire interest in an application or patent involved in an interference is entitled to conduct prosecution of the interference to the exclusion of the inventor.

(b) An assignee of a part interest in an application or patent involved in an interference may file a motion (§ 1.635) for entry of an order authorizing it to prosecute the interference. The motion shall show (1) the inability or refusal of the inventor to prosecute the interference or (2) other cause why the ends of justice require that the assignee of a part interest be permitted to prosecute the interference. The examiner-in-chief may allow the assignee of a part interest to prosecute the interference upon such terms as may be appropriate.

2344 Petitions [R-2]

37 CFR 1.644 Petitions in interferences. (a) There is no appeal to the Commissioner in an interference from a decision of an examiner-in-chief or a panel consisting of more than one examiner-in-chief. The Commissioner will not consider a petition in an interference unless:

(1) The petition is from a decision of an examiner-in-chief or a panel and the examiner-in-chief or the panel shall be of the opinion (i) that the decision involves a controlling question of procedure or an interpretation of a rule as to which there is a substantial ground for a difference of opinion and (ii) that an immediate decision on petition by the Commissioner may materially advance the ultimate termination of the interference;

(2) The petition seeks to invoke the supervisory authority of the Commissioner and is not filed prior to the decision of the Board awarding judgment and does not relate to (i) the merits of priority of invention or patentability or (ii) the admissibility of evidence under the Federal Rules of Evidence; or

(3) The petition seeks relief under § 1.183.

(b) A petition under paragraph (a)(1) of this section filed more than 15 days after the date of the decision of the examiner-in-chief or the panel may be dismissed as untimely. A petition under paragraph (a)(2) of this section shall not be filed prior to decision by the Board awarding judgment. Any petition under paragraph (a)(3) of this section shall be timely if it is made as part of, or simultaneously with, a proper motion under §§ 1.633, 1.634, or 1.635. Any opposition to a petition shall be filed within 15 days of the date of service of the petition.

(c) The filing of a petition shall not stay the proceeding unless a stay is granted in the discretion of the examiner-in-chief, the panel, or the Commissioner.

(d) Any petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support of the petition or opposition shall accompany or be embodied therein. The petition will be decided on the basis of the record made before the examiner-in-chief or the panel and no new evidence will be considered by the Commissioner in deciding the petition. Copies of documents already of record in the interference shall not be submitted with the petition or opposition.

(e) Any petition under paragraph (a) of this section shall be accompanied by the petition fee set forth in § 1.17(h).

(f) Any request for reconsideration of a decision by the Commissioner shall be filed within 15 days of the decision of the Commissioner and must be accompanied by the fee set forth in § 1.17(h). No opposition to a request for reconsideration shall be filed unless requested by the Commissioner. The decision will not ordinarily be modified unless such an opposition has been requested by the Commissioner.

(g) Where reasonably possible, service of any petition, opposition, or request for reconsideration shall be such that delivery is accomplished within one working day. Service by hand or "Express Mail" complies with this paragraph.

(h) An oral hearing on the petition will not be granted except when considered necessary by the Commissioner.

(i) The Commissioner may delegate to appropriate Patent and Trademark Office employees the determination of petitions under this section.

Under § 1.644, petitions to the Commissioner are authorized in interference cases under certain restricted conditions. Petitions in interferences have in the past been the source of substantial delay. Section 1.644 attempts to minimize those delays. Section 1.644 authorizes a petition to the Commissioner from a decision of an examiner-in-chief or a panel when the examiner-in-chief or the panel shall be of the opinion (1) that the decision involves a controlling question of procedure or an interpretation of a rule as to which there is a substantial ground for a difference of opinion and (2) that an immediate decision on petition would materially advance the ultimate termination of the interference. The standard is intended to be analogous to that of a district court certifying a question to a court of appeals under 28 U.S.C. § 1292(b). A petition can be filed seeking to invoke the supervisory authority of the Commissioner. However, the petition cannot be filed prior to entry of judgment and cannot relate to the merits of priority or patentability or the admissibility of evidence under the Federal Rules of Evidence. A petition may also be filed seeking waiver of a rule. A fee as set forth in 37 CFR 1.17(h) is charged for each petition and for each request for reconsideration of a decision on petition. Any petition will be decided on the record made before the examiner-in-chief or the Board and additional evidence cannot by submitted with the petition. An opposition cannot be filed unless ordered by the Commissioner. Where reasonably possible, service of a petition must be such that delivery is accomplished within 1 day. Service by hand or "Express Mail" complies with this requirement.

When a PTO employee is granted authority to decide a petition under § 1.644(i) in an interference case, the employee will not be the examiner-in-chief handling the interference or an employee on a panel of the Board deciding the petition. It is expected that an employee deciding a petition by delegation of authority will be one who could exercise independent judgment on the petition bearing in mind that a petition will be decided on the record made before the examiner-in-chief or the panel. In connection with this latter point, findings of fact by an examiner-in-chief or the Board will be presumed to be correct unless shown to be clearly erroneous. Discretionary action by an examiner-in-chief or the Board will not be overturned unless it is shown that an abuse of discretion occurred.

A petition under § 1.644(a)(2) cannot be filed until after the Board has entered judgment and the petition cannot relate to the merits of priority of invention or patentability or a question of whether evidence is admissible under the Federal Rules of Evidence.

The provisions of § 1.644(g) apply only to petitions filed under § 1.644; those provisions do not apply to oppositions under § 1.638.

The CCPA has stated that, "in performing his duties, the Commissioner cannot usurp the functions or impinge upon the jurisdiction of the Board . . . established by 35 U.S.C. 135." *In re Dickinson*, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962). See also *Myers* v. *Feigelman*, *supra*, 455 F.2d at 599 n. 8, 172 USPQ at 583 n. 8. However, it is also true that the Commissioner "shall superintend or perform all duties required by law respecting the granting and issuing of patents . . . ." 35 U.S.C. § 6; *Kingsland* v. *Carter Carburetor Corp.*, 83 U.S. App. D.C. 266, 168 F.2d 565, 77 USPQ 499 (D.C. Cir. 1948); *In re Staeger*, 189 USPQ 284, 285 n. 2 (Comm'r. Pat. 1974). The Commissioner, subject to approval of the Secretary of Commerce, establishes the procedure by which the examiner-in-chief and the Board will consider interference cases. 35 U.S.C. 6. See also 35 U.S.C. 23 relating to affidavits and depositions.

Under the rules, the Commissioner will not determine on petition either "priority of invention" or "patentability." See § 1.644(a)(2). Likewise, the Commissioner will not consider whether evidence should have been admitted or excluded under the Federal Rules of Evidence. The PTO believes that the Federal courts, which routinely rule on admissibility under the Federal Rules, are in a better position to determine whether the Board properly interpreted the Federal Rules of Evidence.

While the Commissioner will not decide "priority of invention" or "patentability" under 35 U.S.C. 135(a), it does not follow that the Commissioner is precluded from interpreting PTO rules on procedural matters, including procedural matters related to the admissibility of evidence on some basis other than the Federal Rules of Evidence, e.g., whether a party has complied with a PTO rule such as § 1.671(e) (procedure for relying on affidavits) or § 1.671(g) (permission required for obtaining evidence by subpoena).

2345 Extension of Time [R-2]

37 CFR 1.645 Extension of time, late papers, stay of proceedings. (a) A party may file a motion (§ 1.635) seeking an extension of time to take action in an interference, to file a notice of appeal (§§ 1.302, 1.304), or to commence a civil action (§§ 1.303, 1.304). The motion shall be filed within sufficient time to actually reach the examiner-in-chief before expiration of the time for taking action, filing the notice, or commencing the civil action. A moving party should not assume that the motion will be granted even if there is no objection by any other party. The motion will be denied unless the moving party shows good cause why an extension should be granted. The press of other business arising after an examiner-in-chief sets a time for taking action will not normally constitute good cause. A motion seeking additional time to take testimony because a party has not been able to procure the testimony of a witness shall set forth the name of the witness, any steps taken to procure the testimony of the witness, the dates on which the steps were taken, and the facts expected to be proved through the witness.

(b) Any paper belatedly filed will not be considered except upon motion (§ 1.635) which shows sufficient cause why the paper was not timely filed.

(c) The provisions of § 1.136 do not apply to time periods in interferences.

(d) In an appropriate circumstance, an examiner-in-chief may stay proceedings in an interference.

Section 1.645 permits a party to file a motion to seek an extension of time to take action in an interference or to seek judicial review. The motion must be filed within sufficient time to actually reach an examiner-in-cheif prior to expiration of the time for taking action. Under § 1.645, a moving party cannot assume that a motion for an extension of time will be granted. Under § 1.610(d)(6), a request for an extension of time can be made orally and an appropriate order will then be entered thus eliminating considerable paper work. The order will be the written record of the request and decision. See 37 CFR 1.2. Extensions of time have in the past caused numerous delays in interference cases. Under previous interference practice, some delays were caused because attorneys and agents on many occasions, unexpectedly received orders setting times. Under the revised practice, attorneys and agents can expect times to be set for filing preliminary statements, preliminary motions, motions for additional discovery, testimony, and briefs after a conference call. It is expected that use of conference calls will permit an examiner-in-chief and attorneys or agents for parties to set a time schedule which is mutually satisfactory. A motion to extend time will not be granted unless a party shows good cause. The use of conference calls will allow schedules to be set before orders setting time are entered and therefore the press of other business which arises after the examiner-in-chief and attorneys and agents agree to times will not normally be considered good cause.

Section 1.645(a) specifies the procedure to be used when a written motion is filed. It should be noted that an examiner-in-chief may require a written motion notwithstanding a conference call.

When counsel and an examiner-in-chief agree to a schedule and times are set, the parties are expected to adhere to the schedule unless there are unusual circumstances. Apart from work that counsel may have in an interference, an examiner-in-chief has a docket and must manage not only the interference involving counsel, but numerous other interferences. The U.S. Court of Appeals for the Federal Circuit recently said the following in *Rosemount, Inc.* v. *Beckman Instruments, Inc.*, 727 F.2d 1540, 1549–1550, 221 USPQ 1, 10 (Fed. Cir. 1984):

> "The conduct of a trial, granting of continuances and the like, is not, however, solely or entirely a matter of balancing conveniences of the parties. The Federal Rules of Civil Procedure recognize another consideration—the need for the exercise of discretion by the trial court in carrying out its duty of managing the judicial process, the business of the court, and the administration of justice."

However, the rules recognize the need for the exercise of discretion of an examiner-in-chief in carrying out his or her duty of managing the interference (§ 1.610), the business of the PTO (§ 1.610), and the administration of justice (§ 1.601).

2346 Service of Papers [R-2]

37 CFR 1.646 Service of papers, proof of service. (a) A copy of every paper filed in the Patent and Trademark Office in an interference or an application or patent involved in the interference shall be served upon all other parties except:

(1) Preliminary statements when filed under § 1.621; preliminary statements shall be served when service is ordered by an examiner-in-chief.

(2) Certified transcripts and exhibits which accompany the transcripts filed under §§ 1.676 or 1.684; copies of transcripts shall be served as part of a party's record under § 1.653(c).

(b) Service shall be on an attorney or agent for a party. If there is no attorney or agent for the party, service shall be on the party. An examiner-in-chief may order additional service or waive service where appropriate.

(c) Unless otherwise ordered by an examiner-in-chief, or except as otherwise provided by this subpart, service of a paper shall be made as follows:

(1) By handing a copy of the paper to the person served.

(2) By leaving a copy of the paper with someone employed by the person at the person's usual place of business.

(3) When the person served has no usual place of business, by leaving a copy of the paper at the person's residence with someone of suitable age and discretion then residing therein.

(4) By mailing a copy of the paper by first class mail; when service is by mail the date of mailing is regarded as the date of service.

(5) When it is shown to the satisfaction of an examiner-in-chief that none of the above methods of obtaining or serving the copy of the paper was successful, the examiner-in-chief may order service by publication of an appropriate notice in the *Official Gazette*.

(d) An examiner-in-chief may order that a paper be served by hand or "Express Mail".

(e) Proof of service must be made before a paper will be considered in an interference. Proof of service may appear on or be affixed to the paper. Proof of service shall include the date and manner of service. In the case of personal service under paragraph (c)(1) through (c)(3) of this section, proof of service shall include the names of any person served and the person who made the service. Proof of service may be made by an acknowledgment of service by or on behalf of the person served or a statement signed by the party or the party's attorney or agent containing the information required by this section. A statement of an attorney or agent attached to, or appearing in, the paper stating the date and manner of service will be accepted as *prima facie* proof of service.

2347 Translations [R-2]

37 CFR 1.647 Translation of document in foreign language. When a party relies on a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

Under § 1.647, when a party relies on a document in a non-English language, an English language translation of the document and an affidavit attesting to the accuracy of the translation will be required. The rule applies to any document, including evidence submitted with motions, foreign applications for which a party seeks benefit, testimony, and exhibits introduced in evidence during testimony.

2351 Times for Discovery and Testimony [R-2]

37 CFR 1.651 Setting times for discovery and taking testimony, parties entitled to take testimony. (a) At an appropriate stage in an interference, an examiner-in-chief shall set (1) a time for filing motions (§ 1.635) for additional discovery under § 1.687 (c) and (2) testimony periods for taking any necessary testimony.

(b) Where appropriate, testimony periods will be set to permit a party to:

(1) present its case-in-chief and/or case-in-rebuttal and/or

(2) cross-examine an opponent's case-in-chief and/or a case-in-rebuttal.

(c) A party is not entitled to take testimony to present a case-in-chief unless:

(1) The examiner-in-chief orders the taking of testimony under § 1.639(c);

(2) the party alleges in its preliminary statement a date of invention prior to the earlier of the filing date or effective filing date of the senior party;

(3) a testimony period has been set to permit an opponent to prove a date of invention prior to the earlier of the filing date or effective filing date of the party and the party has filed a preliminary statement alleging a date of invention prior to that date; or

(4) a motion (§ 1.635) is filed showing good cause why a testimony period should be set.

(d) Testimony shall be taken during the testimony periods set under paragraph (a) of this section.

Under § 1.651, after a decision is entered on preliminary motions, an examiner-in-chief sets times for filing motions for additional discovery and for taking testimony. Any motion for additional discovery will be to obtain answers to interrogatories, requests for admissions, and documents and things necessary for a party to prepare its case-in-chief.

2352 Judgment for Failure To Take Testimony or File Record [R-2]

37 CFR 1.652 Judgment for failure to take testimony or file record. If a junior party fails to timely take testimony authorized under § 1.651, or file a record under § 1.653(c), an examiner-in-chief, with or without a motion (§ 1.635) by another party, may issue an order to show cause why judgment should not be entered against the junior party. When an order is issued under this section, the Board shall enter judgment in accordance with the order unless, within 15 days after the date of the order, the junior party files a paper which shows goods cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 15 days of the date of service of the paper. If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party.

2353 Record and Exhibits [R-2]

37 CFR 1.653 Record and exhibits. (a) Testimony shall consist of affidavits under §§ 1.672 (b) and (e), transcripts of depositions under §§ 1.672 (b) and (c), agreed statements of fact under § 1.672(f), and transcripts of interrogatories, cross-interrogatories, and recorded answers under § 1.684(c).

(b) An affidavit shall be filed as set forth in § 1.672 (b) or (e). A certified transcript of a deposition including a deposition cross-examining an affiant, shall be filed as set forth in § 1.676. An original agreed statement shall be filed as set forth in § 1.672(f). A transcript of interrogatories, cross-interrogatories, and recorded answers shall be filed as set forth under § 1.684(c).

(c) In addition to the items specified in paragraph (b) of this section and within a time set by an examiner-in-chief each party shall file three copies and serve one copy of a record consisting of:

(1) An index of the names of each witness giving the pages of the record where the direct testimony and cross-examination of each witness begins.

(2) An index of exhibits briefly describing the nature of each exhibit and giving the page of the record where each exhibit is first identified and offered into evidence.

(3) The count or counts.

(4) Each (i) affidavit, (ii) transcript, including transcripts of cross-examination of any affiant, (iii) agreed statement relied upon by the party, and (iv) transcript of interrogatories, cross-interrogatories, and recorded answers filed under paragraph (b) of this section.

(5) Each notice, official record, and publication relied upon by the party and filed under § 1.682(a).

(6) Any evidence from another interference, proceeding, or action relied upon by the party under § 1.683.

(f) Each request for an admission and the admission and each written interrogatory and the answer upon which a party intends to rely under § 1.688.

(d) The pages of the record shall be consecutively numbered.

(e) The name of each witness shall appear at the top of each page of each affidavit or transcript.

(f) The record may be typewritten or printed.

(g) When the record is printed, it may be produced by standard typographical printing or by any process capable of producing a clear black permanent image. All printed matter except on covers must appear in at least 11 point type on opaque, unglazed paper. Margins must be justified. Footnotes may not be printed in type smaller than 9 point. The page size shall be 8½ by 11 inches (21.8 by 27.9 cm.) with type matter 6½ by 9½ inches (16.5 by 24.1 cm.). The record shall be bound to lie flat when open.

(h) When the record is typewritten, it must be clearly legible on opaque, unglazed, durable paper approximately 8½ by 11 inches (21.8 by 27.9 cm.) in size (letter size). Typing shall be double-spaced on one side of the paper in not smaller than pica-type with a margin of 1½ inches (3.8 cm.) on the left-hand side of the page. The pages of the record shall be bound with covers at their left edges in such manner to lie flat when open in one or more volumes of convenient size (approximately 100 pages per volume is suggested). Multigraphed or otherwise reproduced copies conforming to the standards specified in this paragraph may be accepted.

(i) Each party shall file its exhibits with the record specified in paragraph (c) of this section. One copy of each documentary exhibit shall be served. Documentary exhibits shall be filed in an envelop or folder and shall not be bound as part of the record. Physical exhibits, if not filed by an officer under § 1.676(d), shall be filed with the record. Each exhibit shall contain a label which identifies the party submitting the exhibit and an exhibit number, the style of the interference (e.g., Jones v. Smith), and the interference number. Where possible, the label should appear at the bottom right-hand corner of each documentary exhibit. Upon termination of an interference, an examiner-in-chief may return an exhibit to the party filing the exhibit. When any exhibit is returned, the examiner-in-chief shall enter an appropriate order indicating that the exhibit has been returned.

(j) Any testimony, record, or exhibit which does not comply with this section may be returned under § 1.618(a).

Section 1.653 sets out what shall be in the record to be considered by the Board at final hearing. The record continues to be printed or typed on paper 8½ inches by 11 inches in size. Accordingly, when a party files an affidavit, the party should use 8½ by 11 inch paper for the affidavit.

2354 Final Hearing [R–2]

37 CFR 1.654 Final hearing. (a) At an appropriate stage of the interference, the parties will be given an opportunity to appear before the Board to present oral argument at a final hearing. An examiner-in-chief shall set a date and time for final hearing. Unless otherwise ordered by an examiner-in-chief or the Board, each party will be entitled to no more than 60 minutes of oral argument at final hearing.

(b) The opening argument of a junior party shall include a fair statement of the junior party's case and the junior party's position with respect to the case presented on behalf of any other party. A junior party may reserve a portion of its time for rebuttal.

(c) A party shall not be entitled to argue that an opponent abandoned, suppressed, or concealed an actual reduction to practice unless a notice under § 1.632 was timely filed.

(d) After final hearing, the interference shall be taken under advisement by the Board. No further paper shall be filed except under § 1.658(b) or as authorized by an examiner-in-chief or the Board. No additional oral argument shall be had unless ordered by the Board.

Section 1.654 continues the practice or holding a final hearing where oral argument may be presented by all parties. No fee is charged for appearing at oral argument at final hearing in an interference.

2355 Final Decision, Matters Considered [R–2]

37 CFR 1.655 Matters considered in rendering a final decision. (a) In rendering a final decision, the Board may consider any properly raised issue including (1) priority of invention, (2) derivation by an opponent from a party who filed a preliminary statement under § 1.625, (3) patentability of the invention, (4) admissibility of evidence, (5) any interlocutory matter deferred to final hearing, and (6) any other matter necessary to resolve the interference. The Board may also consider whether any interlocutory order was manifestly erroneous or an abuse of discretion. All interlocutory orders shall be presumed to have been correct and the burden of showing manifest error or an abuse of discretion shall be on the party attacking the order.

(b) A party shall not be entitled to raise for consideration at final hearing a matter which properly could have been raised by a motion under §§ 1.633 or 1.634 unless (1) the motion was properly filed, (2) the matter was properly raised by a party in an opposition to a motion under §§ 1.633 or 1.634 and the motion was granted over the opposition, or (3) the party shows good cause why the issue was not timely raised by motion or opposition.

(c) To prevent manifest injustice, the Board may consider an issue even though it would not otherwise be entitled to consideration under this section.

Section 1.655 specifies the matters which can be considered in rendering a final decision. Patentability is an issue which may be raised. The Board can also consider whether any interlocutory order was manifestly erroneous or an abuse of discretion, although any interlocutory order will be presumed to be correct and the burden of showing error shall be on the party attacking the order. This last procedural provision permits the Board to correct any manifest error before a party seeks judicial review of an interlocutory order along with judicial review of the Board's final decision.

Patentability will initially be determined by a single examiner-in-chief. See §§ 1.610(a) and 1.640(b). If the examiner-in-chief determines that a claim of a party is unpatentable to that party, an order to show cause why judgment should not be entered as to that claim will be issued to that party. See § 1.640(d). If a response to the order to show cause is filed, a decision will be entered by the Board. See §§ 1.610(a) and 1.640(e). If the Board determines that the claim is not patentable to the party, a final decision and judgment will be entered holding the claim to be unpatentable. Review of the final decision and judgment is by judicial review under 35 U.S.C. 141 or 146. It should be noted, however, that if there are other claims in the party's application or patent which are deemed to be patentable, an interlocutory order will be entered holding only that certain claims are unpatentable. A final order holding those claims unpatentable will be entered after final hearing on other issues. Such a practice will avoid piecemeal judicial review.

2356 Briefs for Final Hearing [R–2]

37 CFR 1.656 Briefs for final hearing. (a) Each party shall be entitled to file briefs for final hearing. The examiner-in-chief shall determine the briefs needed and shall set the time and order for filing briefs.

(b) The opening brief of a junior party shall contain under appropriate headings and in the order indicated:

(1) A table of contents, with page references, and a table of cases (alphabetically arranged), statutes, and other authorities cited, with references to the pages of the brief where they are cited.

(2) A statement of the issues presented for decision in the interference.

(3) A statement of the facts relevant to the issues presented for decision with appropriate references to the record.

(4) An argument, which may be preceded by a summary, which shall contain the contentions of the party with respect to the issues to be decided, and the reasons therefor, with citations to the cases, statutes, other authorities, and parts of the record relied on.

(5) A short conclusion stating the precise relief requested.

(6) An appendix containing a copy of the counts.

(c) The opening brief of the senior party shall conform to the requirements of paragraph (b) of this section except:

(1) a statement of the issues and of the facts need not be made unless the party is dissatisfied with the statement in the opening brief of the junior party and

(2) an appendix containing a copy of the counts need not be included if the copy of the counts in the opening brief of the junior party is correct.

(d) Briefs may be printed or typewritten. If typewritten, legal-size paper may be used. The opening brief of each party in excess of 50 legal-size double-spaced typewritten pages or any other brief in excess of 25 legal-size double-space typewritten pages shall be printed unless a satisfactory reason be given why the brief should not be printed. Any printed brief shall comply with the requirements of § 1.653(g). Any typewritten brief shall comply with the requirements of § 1.653(h), except legal-size paper may be used and the binding and covers specified are not required.

(e) An original and three copies of each brief must be filed.

(f) Any brief which does not comply with the requirements of this section may be returned under § 1.618(a).

(g) Any party, separate from its opening brief, but filed concurrently therewith, may file an original and three copies of concise proposed findings of fact and conclusions of law. Any proposed findings of fact shall be supported by specific references to the record. Any proposed conclusions of law shall be supported by citation of cases, statutes, or other authority. Any opposing party, separate from its opening or reply brief, but filed concurrently therewith, may file a paper accepting or objecting to any proposed findings of fact or conclusions of law; when objecting, a reason must be given. The Board may adopt the proposed findings of fact and conclusions of law in whole or in part.

(h) If a party wants the Board in rendering its final decision to rule on the admissibility of any evidence, the party shall file with its opening brief an original and three copies of a motion (§ 1.635) to suppress the evidence. The provisions of § 1.637(b) do not apply to a motion to suppress under this paragraph. Any objection previously made to the admissibility of an opponent's evidence is waived unless the motion required by this paragraph is filed. An original and three copies of an opposition to the motion may be filed with an opponent's opening brief or reply brief as may be appropriate.

(i) When a junior party fails to timely file an opening brief, an order may issue requiring the junior party to show cause why the Board should not treat failure to file the brief as a concession of priority. If the junior party fails to respond within a time period set in the order, judgment may be entered against the junior party.

Once the parties have filed their evidentiary records, times will be set for filing briefs, and then the case will be set for hearing. 37 CFR 1.656 is specific as to the contents of the briefs.

In large measure, § 1.656 follows the requirements of Rule 28 of the Federal Rules of Appellate Procedure. An original and three copies of a brief are required. Under § 1.656(h), if a party wants the Board in rendering its final decision to rule that any evidence is inadmissible, the party must file with its opening brief an original and three copies of a motion to suppress the evidence. Any previous objection to the admissibility of evidence is waived unless the motion to suppress is filed. This procedural provision makes clear that an objection to the admissibility of evidence must be renewed at final hearing and will be considered by the Board in rendering its final decision.

If a junior party fails to timely file an opening brief, an order to show cause may be issued against the party, in accordance with 37 CFR 1.656(i).

2357 Burden of Proof [R-2]

37 CFR 1.657 Burden of proof as to date of invention. A rebuttable presumption shall exist that, as to each count, the inventors made their invention in the chronological order of the earlier of their filing dates or effective filing dates. The burden of proof shall be upon a party who contends otherwise.

2358 Final Decision [R-2]

37 CFR 1.658 Final decision. (a) After final hearing, the Board shall enter a decision resolving the issues raised at final hearing. The decision may (1) enter judgment, in whole or in part, (2) remand the interference to an examiner-in-chief for further proceedings, or (3) take further action not inconsistent with law. A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. When the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision.

(b) Any request for reconsideration of a decision under paragraph (a) of this section shall be filed within 14 days after the date of the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. Any reply to a request for reconsideration shall be filed within 14 days of the date of service of the request for reconsideration. Where reasonably possible, service of the request for reconsideration shall be such that delivery is accomplished by hand or "Express Mail." The Board shall enter a decision on the request for reconsideration. If the Board shall be of the opinion that the decision on the request for reconsideration significantly modifies its original decision under paragraph (a) of this section, the Board may designate the decision on the request for reconsideration as a new decision.

(c) A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under § 1.633 (a) through (d) and (f) through (j) or § 1.634 and (3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). A losing party who could have properly moved, but failed to move, under §§ 1.633 or 1.634, shall be estopped to take *ex parte* or *inter partes* action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move, except that a losing party shall not be estopped with respect to any claims which correspond, or properly could have corresponded, to a count as to which that party was awarded a favorable judgment.

In its final decision, the Board can (1) enter judgment, in whole or in part, (2) remand the interference to an examiner-in-chief, or (3) take further action not inconsistent with law. A judgment as to a count will state whether or not each party is entitled to a patent containing claims which correspond to the count. When judgment is entered as to all counts, the decision of the Board is considered final for the purpose of judicial review. Section 1.658(c) defines the doctrine of interference estoppel as it is to be applied in the PTO after an interference is terminated. The definition of interference estoppel is designed to encourage parties in interference cases to settle as many issues as possible in one proceeding. Section 1.658(c) creates an estoppel both as to senior and junior parties unlike the previous practice (37 CFR § 1.257) which limited estoppel in some instances to junior parties.

An estoppel will *not* apply with respect to any claims which correspond, or which properly could have corresponded, to a count as to which the party is awarded a favorable judgment.

After the Board of Patent Appeals and Interferences has rendered a final decision in an interference, the losing party may either appeal to the Court of Appeals for the Federal Circuit, under 35 U.S.C. 141, or file a civil action in a United States district court, under 35 U.S.C. 146. Upon the filing of an appeal to the Court of Appeals for the Federal Circuit, the opposing party may elect to have the proceeding conducted in a district court. In either event, the files will be retained at the Board until the court proceeding has terminated. (The PTO may, but normally does not, issue the application of a winning party in an interference involving only applications, notwithstanding the filing of a civil action under 35 U.S.C. 146 by the losing party. See *Monaco* v. *Watson*, 270 F.2d 335, 122 USPQ 564 (D.C. Cir. 1959).)

2359 Board Recommendation [R-2]

37 CFR 1.659 Recommendation. (a) Should the Board have knowledge of any ground for rejecting any application claim not involved in the judgment of the interference, it may include in its decision a recommended rejection of the claim. Upon resumption of *ex parte* prosecution of the application, the examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(b) Should the board have knowledge of any ground for reexamination of a patent involved in the interference as to a patent claim not involved in the judgment of the interference, it may include in its decision a recommendation to the Commissioner that the patent be reexamined. The Commissioner will determine whether reexamination will be ordered.

(c) The Board may make any other recommendation to the examiner or the Commissioner as may be appropriate.

Under § 1.659, the Board can make recommendations to examiners and the Commissioner, including recommendations that application claims not involved in the interference be rejected and that a patent be reexamined as to patent claims not involved in the interference.

When a patent is involved in an interference each claim of the patent will be designated to (1) correspond to a count *or* (2) not correspond to a count. All claims which are *ultimately* determined to correspond to a count will be "involved in the judgment of the interference." Inasmuch as they are involved in the judgment of the interference, there is no need to recommend reexamination of those claims. The claims involved in the interference are either patentable or unpatentable based on the final decision of the Board. Section 1.659(b) merely authorizes the Board to recommend reexamination of patent claims which (1) are *not* involved in the judgment and (2) for one reason or another neither party saw fit to move to designate as corresponding to a count.

2360 Notice of Reexamination, Reissue, Protest or Litigation [R-2]

37 CFR 1.660 Notice of reexamination, reissue, protest, or litigation. (a) When a request for reexamination of a patent involved in an interference is filed, the patent owner shall notify the Board within 10 days of receiving notice that the request was filed.

(b) When an application for reissue is filed by a patentee involved in an interference, the patentee shall notify the Board within 10 days of the day the application for reissue is filed.

(c) When a protest under § 1.291 is filed against an application involved in an interference, the applicant shall notify the Board within 10 days of receiving notice that the protest was filed.

(d) A party in an interference shall notify the Board promptly of any litigation related to any patent or application involved in an interference, including any civil action commenced under 35 U.S.C. § 146.

Under § 1.660, a party is required to notify the Board when the party's patent or application becomes involved in other PTO proceedings (reexamination, reissue, or protest) or litigation. The requirements of § 1.660 are designed to keep the PTO and a party's opponent informed of activity which is relevant to an interference. These rules attempt, to the extent possible, to eliminate procedural surprise. Inasmuch as mail delays occur and the PTO cannot react instantaneously to every paper filed in connection with every application or patent, the provisions of § 1.660 are believed helpful in preventing surprise on the part of opponents and unnecessary work by examiners-in-chief or the Board due to a lack of knowledge of relevant activity which may be taking place in the PTO.

Reissue Application Filed While Patent is in Interference

37 CFR 1.660(b) requires the patentee involved in the interference to notify the Board of Patent Appeals and Interferences of the filing of the reissue application within 10 days of its filing date.

The reissue application may be the subject of a motion under 37 CFR 1.633(h), or may have been filed under 37 CFR 1.662(b) for the purpose of avoiding the interference. Before taking any action on the reissue, the primary examiner should consult the examiner-in-chief in charge of the interference. It is particularly important that the reissue application not be granted without the approval of the examiner-in-chief.

2361 Termination of Interference After Judgment [R-2]

37 CFR 1.661 Termination of interference after judgment. After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had.

Section 1.661 sets forth when an interference is considered terminated after a judgment is entered in the interference. For the purpose of filing copies of settlement agreements under 35 U.S.C. 135(c), if an appeal or civil action is not filed, the interference is considered terminated as of the date the time for filing an appeal or civil action expired. 37 CFR 1.661; *Tallent* v. *Lemoine*, 204 USPQ 1058 (Comr. 1979). See also *Nelson* v. *Bowler*, 212 USPQ 760 (Comm'r. Pat. 1981). If an appeal is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO. *In re Jones*, 542 F.2d 65, 191 USPQ 249 (CCPA 1976). If a civil action is filed, and the decision of the

district court is not appealed, the interference terminates on the date of the court's decision.

2362 Request for Entry of Adverse Judgment [R-2]

37 CFR 1.662 Request for entry of adverse judgment; reissue filed by patentee. (a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. The filing by an applicant or patentee of a written disclaimer of the invention defined by a count, concession of priority or unpatentability of the subject matter of a count, abandonment of the invention defined by a count, or abandonment of the contest as to a count will be treated as a request for entry of an adverse judgment against the applicant or patentee as to all claims which correspond to the count. Abandonment of an application by an applicant, other than an applicant for reissue having a claim of the patent sought to be reissued involved in the interference, will be treated as a request for entry of an adverse judgment against the applicant as to all claims corresponding to all counts. Upon the filing by a party of a request for entry of an adverse judgment, the Board may enter judgment against the party.

(b) If a patentee involved in an interference files an application for reissue during the interference and omits all claims of the patent corresponding to the counts of the interference for the purpose of avoiding the interference, judgment may be entered against the patentee. A patentee who files an application for reissue other than for the purpose of avoiding the interference shall timely file a preliminary motion under § 1.633(h) or show good cause why the motion could not have been timely filed.

(c) The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.

Section 1.662 provides that a party may request that an adverse judgment be entered. The section also provides that when a written disclaimer (not a statutory disclaimer), concession of priority or unpatentability, abandonment of the invention, abandonment of an application, or abandonment of the contest is filed, the disclaimer, concession, or abandonment will be treated as a request for entry of an adverse judgment. Section 1.662(b) provides that when a patentee files a reissue application and omits all claims of a patent corresponding to the counts of an interference for the purpose of avoiding the interference, judgment will be entered against the patentee. Under §1.662(c), the filing of a statutory disclaimer will not be treated as a request for entry of an adverse judgment unless all patent claims corresponding to a count are disclaimed. Under § 1.662(d), if after entry of a judgment or after filing of a statutory disclaimer no interference exists, the interference will be terminated as to any party against whom judgment has not been entered and any further prosecution of any application involved in the interference will be *ex parte* before the examiner.

When some of the patent claims corresponding to a count are disclaimed, the interference proceeds on the basis of the remaining claims which correspond to the count. If all patent claims corresponding to a count are disclaimed, judgment will be entered. The third sentence of § 1.662(a) does not apply to an application which is *not* involved in an interference. If an applicant files a continuation-in-part application and successfully moves (§ 1.633(d)) to substitute the continuation-in-part for the application involved in the interference, abandonment of the application originally involved in the interference would have no bearing on the interference.

2363 Action After Interference [R-2]

37 CFR 1.664 Action after interference. (a) After termination of an interference, the examiner will promptly take such action in any application previously involved in the interference as may be necessary. Unless entered by order of an examiner-in-chief, amendments presented during the interference shall not be entered, but may be subsequently presented by the applicant subject to the provisions of this subpart provided prosecution of the application is not otherwise closed.

(b) After judgment, the application of any party may be held subject to further examination, including an interference with another application.

The files are not returned to the examining group until after termination of the interference. Jurisdiction of the examiner is automatically restored with the return of the files, and the cases of all parties are subject to such ex parte action as their respective conditions may require. The date when the priority decision becomes final does not mark the beginning of a statutory period for response by the applicant. See *Ex parte Peterson*, 1941 C.D. 8 (Com'r).

The action to be taken by the examiner following termination of the interference depends upon how the interference was terminated, and in some instances, the basis of the termination. All interferences conducted under rules 37 CFR 1.601–1.688 will be terminated by judgment.

When the files are returned to the examining group after termination of the interference, the primary examiner is required to make an entry on the index in the interference file on the next vacant line that the decision has been noted, such as by the words "Decision Noted" and the primary examiner's initials. The interference file is then returned to the Service Branch of the Board of Patent Appeals and Interferences when the examiner is through with it. There it will be checked to see that such note has been made and initialed before filing away the interference record.

If an application has been withdrawn from issue for interference and is again passed to issue, a notation "Re-examined and passed for issue" is placed on the file wrapper together with a new signature of the primary examiner in the box provided for this purpose. Such a notation will be relied upon by the Publishing Division as showing that the application is intended to be passed for issue and makes it possible to screen out those applications which are mistakenly forwarded to the Publishing Division during the pendency of the interference.

See § 1302.12 with respect to listing references discussed in motion decisions, and § 2364 concerning the entry of amendments.

Form Paragraph 11.02 may be used to resume ex parte prosecution.

Form Paragraph 11.02

EX PARTE PROSECUTION IS RESUMED

Interference No. [1] has been terminated by a decision [2] to applicant. Ex parte prosecution is resumed.

Examiner Note:

In bracket [2] insert whether favorable or unfavorable.

2363.01 No Interference In Fact [R-2]

The Board may, if it finds that there is no interference in fact, award judgment to both parties. In such a case, each party-applicant may be granted a patent on the claims of the application designated as corresponding to the count, if those claims are otherwise patentable.

2363.02 The Winning Party [R-2]

If the prosecution of the winning party's case had not been closed, the winning party generally may be allowed additional and broader claims to the common patentable subject matter. (Note, however, *In re Hoover Co., Etc.*, 134 F.2d 624, 57 USPQ 111, 1943 C.D. 338 (CCPA).) The winning party of the interference is not denied anything he or she was in possession of prior to the interference, nor does he or she acquire and additional rights as a result of the interference. His or her case thus stands as it was prior to the interference. If the application was under final rejection as to some of its claims at the time the interference was formed, the institution of the interference acted to suspend, but not to vacate, the final rejection. After termination of the interference a letter is written the applicant, as in the case of any other action unanswered at the time the interference was instituted, setting a shortened period of 2 months within which to file an appeal or cancel the finally rejected claims.

Form Paragraph 11.03

OFFICE ACTION UNANSWERED

This application contains an unanswered Office action mailed on [1]. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO SUCH ACTION IS SET TO EXPIRE [2] FROM THE DATE OF THIS LETTER.

Examiner Note:

This paragraph must be preceded by paragraph 11.02.
In bracket [2] insert date, days, or months.

2363.03 The Losing Party [R-2]

37 CFR 1.663 Status of claim of defeated applicant after interference. Whenever an adverse judgment is entered as to a count against an applicant from which no appeal (35 U.S.C. § 141) or other review (35 U.S.C. § 146) has been or can be taken or had, the claims of the application corresponding to the count stand finally disposed of without further action by the examiner. Such claims are not open to further *ex parte* prosecution.

The Board's judgment in an interference conducted under 37 CFR 1.601--1.688 will state that the losing party is not entitled to a patent containing the claims corresponding to the count or counts. Under 37 CFR 1.663, such claims "stand finally disposed of without further action by the examiner." See also 35 USC 135(a). When the files are returned to the examining group after termination of the interference, a pencil line should be drawn through the claims as to which a judgment of priority adverse to an applicant has been rendered, and the notation "37 CFR 1.663" should be written in the margin to indicate the reason for the pencil line. If these claims have not been canceled by the applicant and the case is otherwise ready for issue, these notations should be replaced by a line in red ink and the notation "37 CFR 1.663" in red ink before passing the case to issue, and the applicant notified of the cancellation by an Examiner's Amendment. If an action is necessary in the application after the interference, the applicant should also be informed that "Claims (designated by numerals), as to which a judgment adverse to applicant has been rendered, stand finally disposed of in accordance with 37 CFR 1.663."

If all the claims in the application are eliminated, a letter should be written informing the applicant that all the claims in the application have been disposed of, indicating the circumstances, that no claims remain subject to prosecution, and that the application will be sent to the abandoned files with the next group of abandoned applications. Proceedings are terminated as of the date the interference terminated. See § 2361 third paragraph of text.

If the losing party's case was under rejection at the time the interference was declared, such rejection is ordinarily repeated (either in full or by reference to the previous action) and, in addition, any other suitable rejections, as discussed below, are made. If the losing party's application was under final rejection or ready for issue, his or her right to reopen the prosecution is restricted to subject matter related to the issue of the interference.

Where the losing party failed to get a copy of the opponent's drawing or specification during the interference, the losing party may order a copy thereof to enable said party to respond to a rejection based on the successful party's disclosure. Such order is referred to the examiner-in-chief who has authority to approve orders of this nature.

In addition to repeating any outstanding rejection, the examiner should consider whether any remaining claims in the losing party's application should be rejected on the ground of unpatentability under 35 U.S.C. 102/103, or on the ground of estoppel.

1. UNPATENTABILITY UNDER 35 U.S.C. 102/103

The examiner should determine from the Board's decision the basis on which judgment was rendered against the applicant. If the judgment was that applicant was not the first inventor of the subject matter in issue, the application claims may be rejected under 35 U.S.C. 102(g)/103 as unpatentable over the lost counts. If the judgment was based on a holding that applicant derived the invention from another, a rejection of claims as unpatentable over the lost counts under 35 U.S.C. 102(f)/103 may be in order. Where the Board rendered judgment against the applicant because his or her claims were unpatentable over prior art, under 35 U.S.C. 112, or on other grounds, the other claims in the application should be reviewed to

determine whether any of those grounds may be applicable to them.

2. ESTOPPEL

Claims which cannot be rejected as unpatentable over the lost counts may still be subject to rejection on the ground of estoppel. As stated in 37 CFR 1.658(c), a losing party who could have properly moved under 37 CFR 1.633 or 1.634, but failed to do so, is estopped to take subsequent action in the PTO which is inconsistent with the party's failure to properly move. However, in the event of a "split award," the losing party is not estopped as to claims which corresponded, or properly could have corresponded, to a count which he or she won.

The following examples illustrate the application of estoppel to the losing party:

Example 1. Junior party applicant AL and senior party applicant AK both disclose separate patentable inventions "A" and "B" and claim only invention A in their respective applications. An interference is declared with a single count to invention A. Neither party files a motion under 37 CFR 1.633(c)(1) to add a count to invention B. Judgment as to all of AL's claims corresponding to the sole count is awarded to junior party applicant AL. Senior party applicant AK will be estopped to thereafter obtain a patent containing claims to invention B, because applicant AK failed to move to add a count to invention B in the interference. Junior party applicant AL will not be estopped to obtain a patent containing claims to invention B.

Example 2. In this example, the facts are the same as in Example 1 except that judgment is awarded as to all AK's claims corresponding to the count to senior party applicant AK. Junior party applicant AL will be estopped to obtain a patent containing claims to invention B in the interference. Senior party applicant AK will not be estopped to obtain a patent containing claims to invention B.

Example 3. Junior party applicant AM and senior party applicant AP both disclose separate patentable inventions "C", "D", and "E" and claim inventions C and D in their respective applications. An interference is declared with two counts. Count 1 is to invention C and Count 2 is to invention D. Neither party files a preliminary motion to add a proposed Count 3 to invention E. Judgment as to all AM's claims corresponding to Counts 1 and 2 is awarded to junior party applicant AM. Senior party applicant AP will be estopped to thereafter obtain a patent containing claims to invention E, because applicant AP failed to move to add a count to invention E in the interference. Junior party applicant AM will not be estopped to obtain a patent containing claim to invention E.

Example 4. In this example, the facts are the same as in Example 3 except that judgment is awarded as to all AP's claims corresponding to Counts 1 and 2 to senior party applicant AP. Junior party applicant AM will be estopped to obtain a patent containing claims to invention E, because applicant AM failed to move to add a count to invention E in the interference. Senior party applicant AP will not be estopped to obtain a patent containing claims to invention E.

Example 5. In this example, the facts are the same as in Example 3 except that judgment is awarded on all of AM's claims corresponding to Count 1 to junior party applicant of AM and judgment is awarded to all AP's claims corresponding to Count 2 to senior party applicant AP. Both parties will be estopped to obtain a patent containing claims to invention E, because neither moved to add a count to invention E during the interference. Assume that junior party AM could have properly moved under 37 CFR 1.633(f) to be accorded the benefit of an earlier application, but did not do so during the interference. Junior party AM will not be estopped in subsequent *ex parte* prosecution from asking for benefit of the earlier application as to the invention defined by Count 1. Accordingly, if the examiner were to reject junior party AM's claim corresponding to Count 1 on the basis of some newly discovered prior art, junior party AM could properly antedate the prior art by seeking the benefit under 35 U.S.C. 120 of the earlier application. Thus, even though junior party AM was a "losing party" as to Count 2 (an adverse judgment as to junior party AM's claims corresponding to Count 2 having been entered), junior party AM was awarded a favorable judgment (37 CFR 1.658(c)) as to Count 1. Junior party AM will be estopped in subsequent *ex parte* prosecution from attempting to be accorded the benefit of the earlier application as to the invention of Count 2.

Example 6. Applicant AQ discloses and claims invention "F." Applicant AR discloses and claims separate patentable inventions "F" and "G." The assignee of applicant AQ also owns an application AS which discloses and claims invention "G." An interference is declared between applicant AQ and applicant AR. The sole count is directed to invention F. No motion is filed by applicant AQ or its assignee to declare an additional interference between applicant AR and applicant AS with a count to invention G. A judgment as to all of AR's claims corresponding to the sole count is awarded to applicant AR. Applicant AS and the assignee will be estopped to obtain a patent containing claims to invention G, because applicant AR and the assignee failed to move to declare an additional interference with a count to invention G.

Example 7. The facts in this example are the same as the facts in Example 6 except that judgment as to all of AQ's claims corresponding the sole count is awarded to applicant AQ. Applicant AS and the assignee would not be estopped, because applicant AQ was not a "losing party" (37 CFR 1.658(c)).

Example 8. Applicant AT discloses a generic invention to "solvent" and a species to "benzene." Application AT contains a patentable claim 1 (solvent) and no other claims. Applicant AU discloses the generic invention to "solvent" and species to "benzene" and "toluene." Application AU contains patentable claim 3 (solvent) and no other claims. An interference is declared with a single count (solvent). Claim 1 of application AT and claim 3 of application AU are designated to correspond to the count. No preliminary motions are filed. A judgment is entered in favor of applicant AT on the claim corresponding to the sole count. Applicant AU would be estopped to obtain a patent containing a claim to benzene, because applicant AU failed to file a preliminary motion under 37 CFR 1.633(c)(1) seeking to add a count to benzene and benzene was disclosed in winning party AT's application. Applicant AU would also be estopped to obtain a patent containing a claim to toluene, unless "toluene" defines a "separate patentable invention" from "solvent." A basis for interference estoppel (37 CFR 1.658(c)) exists if toluene" and "solvent" define the "same patentable invention," because a claim to "toluene" could properly have been added and designated to correspond to the count. See 37 CFR 1.633(c)(2).

The following two examples illustrate the application of estoppel against an applicant who lost the interference based solely on the fact that the applicant was unable to establish a date of invention prior to the opponent's foreign filing date (see *Ex parte Tytgat*, 225 USPQ 907 (Bd. App. 1985)):

Example 9. Application AV discloses engines in general and in particular a 6-cylinder engine. Application AV contains only claim 1 (engine). Application AW discloses engines in general, but does not specifically disclose a 6-cylinder engine. Application AW contains only a single claim 3 (engine). The U.S. "filing date" (37 CFR 1.601(h)) of the AV application is prior to the U.S. filing date of the AW application, but the AW application claims a foreign priority date under 35 U.S.C 119 based on an application filed in a foreign country prior to the filing date of the AV application. An interference is declared. The sole count of the interference is to "an engine." Claim 1 of the AV application and claim 3 of the AW application are designated to correspond to the count. During the interference, applicant AV does not move under 37 CFR 1.633(c)(2) to add a claim to a 6-cylinder engine and to designate the claim to correspond to the count. Applicant AW is awarded a judgment in the interference based on the earlier filing date of the foregin patent application. After

the interference, applicant AV adds claim 2 (6-cylinder engine) to the AV application. Whether AV would be entitled to a patent containing a claim to a 6-cylinder engine will depend solely on whether a 6-cylinder engine is a "separate patentable invention" from "engine"—the subject matter of the count. If a 6-cylinder engine is a "separate patentable invention" within the meaning of 37 CFR 1.601(n), applicant AV could not have successfully moved under 37 CFR 1.633(c)(2) to add claim 2 and to designate it to correspond to the count. Therefore applicant AV could obtain a patent containing claim 2. If, on the other hand, a 6-cylinder engine is not a "separate patentable invention," claim 2 of the AV application would be rejected on the basis of interference estoppel because claim 2 could have been added by a motion under 37 CFR 1.633(c)(2). See 37 CFR 1.658(c).

Example 10. This example is basically the same as Example 9, except that application AV initially contains claim 1 (engine) and claim 2 (6-cylinder engine). When the interference is declared, both claims 1 and 2 of application AV are designated to correspond to the count. During the interference, applicant AV does not move under 37 CFR 1.633(c)(4) to designate claim 2 as not corresponding to the count. A judgment in the interference is entered for applicant AW based on the earlier filing date of the foreign patent application. After the interference, applicant AV would not be able to obtain a patent containing claim 2, because that claim was designated to correspond to a count and entry of the judgment constitutes a final decision by the PTO refusing to grant applicant AV a patent containing claim 2.

Allowance of Losing Party's Application

Before allowing a losing party's application, the examiner should carefully consider whether the grounds of estoppel have been fully applied. In order to promote uniform application of the doctrines of lost counts and estoppel, the examiner must consult the examiner-in-chief who was in charge of the interference before allowing the losing party's case.

2364 Entry of Amendments [R-2]

Under 37 CFR 1.637(c) (1) and (2), (d)(3), (e) (1) and (2), or (h), a moving party is required to submit with his or her motion as a separate paper, an amendment embodying the proposed claims if the claims are not already in the application concerned. In the case of an application involved in the interference, this amendment is not entered at that time but is placed in the application file.

An amendment filed in connection with a motion to add or substitute counts in an interference must include any claim or claims to be added and be accompanied by the appropriate fees (or fee authorization), if any, which would be due if the amendment were to be entered, even though it may be that the amendment will never be entered. Only upon the granting of the motion may it be necessary for the other party or parties to present claims, but the fees (or the fee authorized) must be paid whenever claims are presented. Claims which have been submitted in response to a suggestion by the Office for inclusion in an application must be accompanied by the fee due (or fee authorization), if any. Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment.

If the motion is granted the amendment is entered at the time decision on the motion is rendered. If the motion is not granted, the amendment, though left in the file, is not entered and is so marked.

If the motion is granted only in part and denied as to another part, only so much of the amendment as is covered in the grant of the motion is entered, the remaining part being indicated and marked "not entered" in pencil. (See 37 CFR 1.664.)

In each instance the applicant is informed of the disposition of the amendment in the first action in the case following the termination of the interference. If the case is otherwise ready for issue, the applicant is notified that the application is allowed and the Notice of Allowance will be sent in due course, that prosecution is closed and to what extent the amendment has been entered.

As a corollary to this practice, it follows that where prosecution of the winning application had been closed prior to the declaration of the interference, as by being in condition for issue, that application may not be reopened to further prosecution following the interference, even though additional claims had been presented in connection with a motion in the interference.

It should be noted at this point that, under 37 CFR 1.663, the entry of an adverse judgment against a party who requests same pursuant to 37 CFR 1.662(a) finally disposes of all claims of that party's application which are designated as corresponding to the count.

2364.01 Amendments Filed During Interference [R-2]

If the amendment is filed in response to a letter by the primary examiner, suggesting a claim or claims for interference with another party and for the purpose of declaring an additional interference, the examiner enters the amendment and takes the proper steps to initiate the second interference.

Other Amendments

When an amendment to an application involved in an interference is received, the examiner inspects the amendment and, if necessary, the application, to determine whether or not the amendment affects the pending or any prospective interference. If the amendment is an ordinary one properly responsive to the last regular *ex parte* action preceding the declaration of the interference and does not affect the pending or any prospective interference, the amendment is marked in pencil "not entered" and placed in the file, a corresponding entry being endorsed in ink in the contents column of the wrapper and on the serial and docket cards. After the termination of the interference, the amendment may be permanently entered and considered as in the case of ordinary amendments filed during the *ex parte* prosecution of the case.

If the amendment is one filed in a case where *ex parte* prosecution of an appeal to the Board of Patent Appeals and Interferences is being conducted concurrently with an interference proceeding (see § 2314), and if it relates to the appeal, it should be treated like any similar amendment in an ordinary appealed case.

When an amendment filed during interference purports to put the application in condition for another

interference either with a pending application or with a patent, the primary examiner must personally consider the amendment sufficiently to determine whether, in fact, it does so.

If the amendment presents allowable claims directed to an invention claimed in a patent or in another pending application in issue or ready for issue, the examiner borrows the file, enters the amendment and takes the proper steps to initiate the second interference.

Where in the opinion of the examiner, the proposed amendment does not put the application in condition for interference with another application not involved in the interference, the amendment is placed in the file and marked "not entered" and the applicant is informed why it will not be now entered and acted upon.

When the amendment seeks to provoke an interference with a patent not involved in the interference and the examiner believes that the claims presented are not patentable to the applicant, and where the application is open to further *ex parte* prosecution, the file should be obtained, the amendment entered and the claims rejected, setting a time limit for response. If reconsideration is requested and rejection made final a time limit for appeal should be set. Where the application at the time of forming the interference was closed to further *ex parte* prosecution and the disclosure of the application will *prima facie*, not support the claims presented, or where the claims presented are drawn to a non-elected invention, the amendment will not be entered and the applicant will be so informed giving very briefly the reason for the non-entry of the amendment.

2365 Second Interference [R-2]

37 CFR 1.665 Second interference. A second interference between the same parties will not be declared upon an application not involved in an earlier interference for an invention defined by a count of the earlier interference. See § 1.658(c).

2366 Interference Settlement Agreement [R-2]

37 CFR 1.666 Filing of interference settlement agreements. (a) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, must be in writing and a true copy thereof must be filed before the termination of the interference (§ 1.661) as between the parties to the agreement or understanding.

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(i) and on a showing of good cause.

(c) Failure to file the copy of the agreement or understanding under paragraph (a) of this section will render permanently unenforceable such agreement or understanding and any patent of the parties involved in the interference or any patent subsequently issued on any application of the parties so involved. The Commissioner may, however, upon petition accompanied by the fee set forth in § 1.17(h) and on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

Section 1.666 sets out the procedure for filing settlement agreements in interference cases. The PTO is merely a repository for copies of agreements filed under 35 U.S.C. § 135(c) and does not undertake to rule on whether the statute requires that a copy of any particular agreement be filed. *Nelson* v. *Bowler*, 212 USPQ 760 (Comm'r.Pat. 1981).

2371 Evidence [R-2]

37 CFR 1.671 Evidence must comply with rules. (a) Evidence consists of testimony and exhibits, official records and publications filed under § 1.682, evidence from another interference, proceeding, or action filed under § 1.683, and discovery relied upon under § 1.688, and the specification (including claims) and drawings of any application or patent:

(1) Involved in the interference.

(2) To which a party has been accorded benefit in the notice declaring the interference or by a preliminary motion granted under § 1.633.

(3) For which a party has sought, but has been denied, benefit by a preliminary motion under § 1.633.

(4) For which benefit was rescinded by a preliminary motion granted under § 1.633.

(b) Except as otherwise provided in this part, the Federal Rules of Evidence shall apply to interference proceedings. Those portions of the Federal Rules of Evidence relating to criminal actions, juries, and other matters not relevant to interferences shall not apply.

(c) Unless the context is otherwise clear, the following terms of the Federal Rules of Evidence shall be construed as follows:

(1) "Courts of the United States," "U.S. Magistrate," "court," "trial court," or "trier of fact" means examiner-in-chief or Board as may be appropriate.

(2) "Judge" means examiner-in-chief.

(3) "Judicial notice" means official notice.

(4) "Civil action," "civil proceeding," "action," or "trial," means interference.

(5) "Appellate court" means United States Court of Appeals for the Federal Circuit or a United States district court when judicial review is under 35 U.S.C. § 146.

(6) "Before the hearing" in Rule 703 means before giving testimony by oral deposition or affidavit.

(7) "The trial or hearing" in Rules 803(24) and 804(5) means the taking of testimony by oral deposition.

(d) Certification is not necessary as a condition to admissibility when the record is a record of the Patent and Trademark Office to which all parties have access.

(e) A party may not rely on an affidavit filed by that party during *ex parte* prosecution of an application, an affidavit under § 1.608(b), or an affidavit under § 1.639(b) unless (1) a copy of the affidavit is or has been served and (2) a written notice is filed prior to the close of the party's relevant testimony period stating that the party intends to rely on the affidavit. When proper notice is given under this paragraph, the affidavit shall be deemed filed under § 1.672(b). A copy of the affidavit shall be included in the record (§ 1.653).

(f) The significance of documentary and other exhibits shall be discussed with particularity by a witness during oral deposition or in an affidavit.

(g) A party must file a motion (§ 1.635) seeking permission from an examiner-in-chief prior to taking testimony or seeking documents or things under 35 U.S.C. § 24. The motion shall describe the general nature and the relevance of the testimony, document, or thing.

(h) Evidence which is not taken or sought and filed in accordance with this subpart shall not be admissible.

Section 1.671 sets out what will be considered evidence.

37 CFR 1.671 (b) and (c) provide that the Federal Rules of Evidence apply to interference proceedings to the extent indicated in the rule. It should be noted that this provision does not eliminate the well-settled

requirement for independent corroboration of prior inventive acts performed by a party.

Under § 1.671(e), a party cannot rely on a previously filed affidavit such as an affidavit under 37 CFR 1.131, 1.132, 1.608(b) or 1.639(b) unless the affidavit is served and notice is given that the party intends to rely on the affidavit. The purpose for the notice is to permit an opponent to determine whether a deposition for cross-examination is necessary (see §§ 1.672(b) and 1.673(e)).

Section 1.671(e) is intended to overrule prior construction of PTO rules in *Holmes* v. *Kelly*, 586 F.2d 234, 237 n. 7, 199 USPQ 778, 782 n. 7 (CCPA 1978) and *Brecker* v. *Jennings*, 204 USPQ 663 (Bd.Pat.Int. 1978), which considered a Rule 1.132 affidavit in the file of an involved application to be part of the "record" in an interference. Under § 1.671(e), a party intending to rely on such an affidavit must give notice and serve a copy of the affidavit on the opponent.

Even though the affidavit may have been considered by the examiner-in-chief in deciding a preliminary motion, it may *not* be considered by the Board at final hearing unless § 1.671(e) has been complied with. Similarly, while § 1.671(a) provides that the specification (including claims) and drawings of the involved and certain other cases are in evidence, other papers in those files are *not* in evidence unless specifically introduced as exhibits.

Under § 1.671(f), the significance of documentary and other exhibits must be discussed with particularity by a witness during oral deposition or in an affidavit. Section 1.671(f) sets out in the regulations an evidentiary requirement imposed by precedent. See *Popoff* v. *Orchin*, 144 USPQ 762 (Bd.Pat.Int. 1963) (unexplained experimental data should not be considered); *Chandler* v. *Mock* 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless), and *Smith* v. *Bousquet*, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in stipulated testimony are entitled to little weight). See also *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974) and *Triplett* v. *Steinmayer*, 129 F.2d 869, 54 USPQ 409 (CCPA 1942). Under § 1.671(g), a party is required to obtain permission from an examiner-in-chief prior to proceeding under 35 U.S.C. § 24. This requirement insures that a subpoena is necessary (e./g., a subpoena ordinarily should not be necessary where testimony of an opponent is sought) and that testimony sought through a § 24 subpoena is relevant before a subpoena is issued. The motion seeking permission to proceed under § 24, any opposition thereto, and the order of an examiner-in-chief authorizing the moving party to proceed under § 24 will be of assistance to a federal court in the event a party is required to resort to a court to enforce the subpoena or to compel answers to questions propounded at any deposition where a witness is appearing pursuant to a subpoena. See *Sheehan* v. *Doyle*, 529 F.2d 38, 188 USPQ 545 (1st Cir.), *cert. denied*, 429 U.S. 870 (1976), *rehearing denied*, 429 U.S. 987 (1976).

Under § 1.671(h), any evidence which is not taken or sought and filed in accordance with the regulations will not be admissible.

The courts have articulated a rule of law which the PTO will continue to apply in determining admissibility of laboratory notebooks under the "shop book" Rule 803(b)(6) of the Federal Rules of Evidence. See e.g., *Alpert* v. *Slatin*, 305 F.2d 891, 134 USPQ 296 (CCPA 1962) and *Elliott* v. *Barker*, 461 F.2d 1337, 179 USPQ 100 (CCPA 1973).

Ordinarily, the examiner-in-chief can order a party to produce an individual for a deposition as long as the individual is a party or is under the control of the party, e.g., an employee of an assignee. Where so-called "third parties" are concerned, however, issuance of a subpoena may be necessary, because the PTO has no authority to compel attendance of third parties.

2372 Manner of Taking Testimony [R-2]

37 CFR 1.672 Manner of taking testimony. (a) Testimony of a witness may be taken by oral deposition or affidavit in accordance with this subpart.

(b) A party wishing to take the testimony of a witness whose testimony will not be compelled under 35 U.S.C. § 24 may elect to present the testimony of the witness by affidavit or deposition. A party electing to present testimony of a witness by affidavit shall, prior to the close of the party's relevant testimony period, file and serve an affidavit of the witness or, where appropriate, a notice under § 1.671(e). To facilitate preparation of the record (§ 1.653(g) and (h)), a party should file an affidavit on paper which is 8½ by 11 inches (21.8 by 27.9 cm). A party shall not be entitled to rely on any document referred to in the affidavit unless a copy of the document is filed with the affidavit. A party shall not be entitled to rely on any thing mentioned in the affidavit unless the opponent is given reasonable access to the thing. A thing is something other then a document. After the affidavit is filed and within a time set by an examiner-in-chief, any opponent may file a request to cross-examine the witness on oral deposition. If any opponent requests cross-examination of an affiant, the party shall notice a deposition under § 1.673(e) for the purpose of cross-examination of any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness whose testimony is presented by affidavit, the party shall not be entitled to rely on any document or thing not mentioned in one or more of the affidavits filed under this paragraph, except to the extent necessary to conduct proper redirect. A party electing to present testimony of a witness by deposition shall notice a deposition of the witness under § 1.673(a). The party who gives notice of deposition shall be responsible for obtaining a court reporter and for filing a certified transcript of the deposition as required by § 1.676.

(c) A party wishing to take the testimony of a witness whose testimony will be compelled under 35 U.S.C. § 24 must first obtain permission from an examiner-in-chief under § 1.671(g). If permission is granted, the party shall notice a deposition of the witness under § 1.673 and may proceed under 35 U.S.C. § 24. The testimony of the witness shall be taken on oral deposition.

(d) Notwithstanding the provisions of this subpart, if the parties agree in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions.

(e) If the parties agree in writing, the testimony of any witness may be submitted in the form of an affidavit without opportunity for cross-examination. The affidavit of the witness shall be filed in the Patent and Trademark Office.

(f) If the parties agree in writing, testimony may be submitted in the form of an agreed statement setting forth (1) how a particular witness would testify if called or (2) the facts in the case of one or more of the parties. The agreed statement shall be filed in the Patent and Trademark Office. See § 1.653(a).

Section 1.672 sets forth the manner in which testimony shall be taken. Testimony can be taken by deposition or affidavit at the election of the party presenting the testimony. A party presenting testimony by affidavit must file and serve the affidavit. If the party presents testimony by affidavit and an opponent elects to cross-examine the affiant, the party is required to notice a deposition for the purpose of cross-examination. Re-direct and re-cross will take place at the deposition. Where the parties agree, testimony can be presented by affidavit without opportunity for cross-examination (see § 1.672(e)) or by stipulated testimony or an agreed statement of facts (see § 1.672(f)).

An affidavit may be used only when a witness agrees to sign the affidavit. If an individual refuses to sign an affidavit or voluntarily appear at a deposition the party calling the witness will have to compel attendance at a deposition by a subpoena under 35 U.S.C. 24 after receiving permission from an examiner-in-chief.

Before setting the times for discovery, taking testimony, and filling the record, the examiner-in-chief in charge of the interference will in all likelihood hold a pre-trial conference with the parties' lead attorneys. At this conference, the attorneys should be prepared to discuss whether they intend to take testimony, and whether the testimony will be by oral deposition, by affidavit or otherwise; the issues to be determined; the time which will be required; and other matters relevant to the conduct of the testimony. Following the conference the examiner-in-chief will normally issue an order setting the times for discovery, taking testimony, and filing the record, and making such other rulings as may be necessary in the particular case.

Former rule 37 CFR 1.287(a) required that a party provide discovery by serving copies of documents and lists within a specified time before taking his testimony. The essence of this requirement is carried forward in 37 CFR 1.673 where the testimony of a witness is to be by deposition. If a witness' testimony will be by affidavit, prior service of documents and lists is not required, but copies of documents referred to in the affidavit must be filed and served therewith, and the opponent must be given reasonable access to any thing mentioned therein. 37 CFR 1.672(b).

2373 Notice of Examination of Witness [R-2]

37 CFR 1.673 Notice of examination of witness. (a) A party electing to take testimony of a witness by deposition shall, after complying with paragraphs (b) and (g) of this section, file and serve a single notice of deposition stating the time and place of each deposition to be taken. Depositions may be noticed for a reasonable time and place in the United States. Unless the parties agree in writing, a deposition may not be noticed for any other place without approval of an examiner-in-chief (see § 1.684). The notice shall specify the name and address of each witness and the general nature of the testimony to be given by the witness. If the name of a witness is not known, a general description sufficient to identify the witness or a particular class or group to which the witness belongs may be given instead.

(b) Unless the parties agree otherwise, a party shall serve, but not file, at least three days prior to the conference required by paragraph (g) of this section, if service is made by hand or "Express Mail," or at least ten days prior to the conference if service is made by any other means, the following:

(1) A list and copy of each document in the party's possession, custody, or control and upon which the party intends to rely at any deposition and

(2) A list of and a proffer of reasonable access to things in the party's possession, custody, or control and upon which the party intends to rely at any deposition.

(c) A party shall not be permitted to rely at any deposition on any witness not listed in the notice, or any document not served or any thing not listed as required by paragraph (b) of this section, (1) unless all opponents agree in writing or on the record to permit the party to rely on the witness, document, or thing or (2) except upon a motion (§ 1.635) promptly filed which is accompanied by any proposed notice, additional documents, or lists and which shows sufficient cause why the notice, documents, or lists were not served in accordance with this section.

(d) Each opposing party shall have a full opportunity to attend a deposition and cross-examine. If an opposing party attends a deposition of a witness not named in a notice and cross-examines the witness or fails to object to the taking of the deposition, the opposing party shall be deemed to have waived any right to object to the taking of the deposition for lack of proper notice.

(e) A party electing to present testimony by affidavit and who is required to notice depositions for the purpose of cross-examination under § 1.672(b), shall, after complying with paragraph (g) of this section, file and serve a single notice of deposition stating the time and place of each cross-examination deposition to be taken.

(f) The parties shall not take depositions in more than one place at the same time or so nearly at the same time that reasonable opportunity to travel from one place of deposition to another cannot be had.

(g) Before serving a notice of deposition and after complying with paragraph (b) of this section, a party shall have an oral conference with all opponents to attempt to agree on a mutually acceptable time and place for conducting the deposition. A certificate shall appear in the notice stating that the oral conference took place or explaining why the conference could not be had. If the parties cannot agree to a mutually acceptable place and time for conducting the deposition at the conference, the parties shall contact an examiner-in-chief who shall then designate the time and place for conducting the deposition.

(h) A copy of the notice of deposition shall be attached to the certified transcript of the deposition filed under § 1.676(a).

Section 1.673 sets out how a deposition must be noticed. A deposition can be noticed for any reasonable place in the United States. The extent to which parties, witnesses, and attorneys or agents have to travel may be considered in determining whether a place is reasonable. Prior to serving a notice for a deposition, a party is required to take two procedural steps. Under § 1.673(b), a party is required to serve a copy of the documents and a list of the things in its possession, custody, and control upon which it intends to rely. Under § 1.673(g), the party is required to have an oral conference (in person or by telephone) with all opponents to attempt to agree on a mutually acceptable time and place for taking the deposition. An examiner-in-chief may set the time and place if agreement is not reached. A single notice listing all the witnesses and the general nature of their expected testimony is then served. Under § 1.673(c) and except as provided, a party can not rely on any witness not mentioned in the notice, any document not served, or any thing not listed. Under § 1.673(h), a copy of any notice must be attached to the certified transcript of each deposition filed.

2374 Persons Depositions Taken Before [R-2]

37 CFR 1.674 Persons before whom depositions may be taken. (a) Within the United States or a territory or insular possession of the United States a deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held.

(b) Unless the parties agree in writing, the following persons shall not be competent to serve as an officer: (1) a relative or employee of a party, (2) a relative or employee of an attorney or agent of a party, or (3) a person interested, directly or indirectly, in the interference either as counsel, attorney, agent, or otherwise.

Section 1.674 sets out the persons before whom depositions can be taken.

2375 Examination of Witness [R-2]

37 CFR 1.675 Examination of witness, reading and signing transcript of deposition. (a) Each witness before giving an oral deposition shall be duly sworn according to law by the officer before whom the deposition is to be taken.

(b) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer or by some other person, who shall be subject to the provisions of § 1.674(b), in the presence of the officer unless the presence of the officer is waived on the record by agreement of all parties.

(c) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, or any other objection to the proceeding shall be noted on the record by the officer. Evidence objected to shall be taken subject to any objection.

(d) Unless the parties agree in writing or waive reading and signature by the witness on the record at the deposition, when the testimony has been transcribed a transcript of the deposition shall be read by the witness and then signed by the witness in the form of (1) an affidavit in the presence of any notary or (2) a declaration.

Section 1.675 sets out how a deposition is to be taken.

2376 Filing Transcript of Deposition [R-2]

37 CFR 1.676 Certification and filing by officer, marking exhibits. (a) The officer shall prepare a certified transcript of the deposition by attaching to a transcript of the deposition a copy of the notice of deposition, any exhibits to be annexed to the certified transcript, and a certificate signed and sealed by the officer and showing:

(1) The witness was duly sworn by the officer before commencement of testimony by the witness.

(2) The transcript is a true record of the testimony given by the witness.

(3) The name of the person by whom the testimony was recorded and, if not recorded by the officer, whether the testimony was recorded in the presence of the officer.

(4) The presence or absence of any opposing party.

(5) The place where the deposition was taken and the day and hour when the deposition began and ended.

(6) The officer is not disqualified under § 1.674.

(b) If the parties waived any of the requirements of paragraph (a) of this section, the certificate shall so state.

(c) The officer shall note on the certificate the circumstances under which a witness refuses to sign a transcript.

(d) Unless the parties agree otherwise in writing or on the record at the deposition, the officer shall securely seal the certified transcript in an envelope endorsed with the style of the interference (e.g., Smith v. Jones), the interference number, the name of the witness, and the date of sealing and shall promptly forward the envelope to BOX INTERFERENCE, Commissioner of Patents and Trademarks, Washington, D.C. 20231. Documents and things produced for inspection during the examination of a witness, shall, upon request of a party, be marked for identification and annexed to the certified transcript, and may be inspected and copied by any party, except that if the person producing the documents and things desires to retain them, the person may (1) offer copies to be marked for identification and annexed to the certified transcript and to serve thereafter as originals if the person affords to all parties fair opportunity to verify the copies by comparison with the originals or (2) offer the originals to be marked for identification, after giving to each party an opportunity to inspect and copy them, in which event the documents and things may be used in the same manner as if annexed to the certified transcript. The exhibits shall then be filed as specified in § 1.653(i). If the weight or bulk of a document or thing shall reasonably prevent the document or thing from being annexed to the certified transcript, it shall, unless waived on the record at the deposition by all parties, be authenticated by the officer and forwarded to the Commissioner in a separate package marked and addressed as provided in this paragraph.

Section 1.676 sets out how a court reporter should prepare and file a certified transcript of a deposition. Section 1.676(d) sets out how exhibits are to be marked for identification, used at depositions, and filed. Provisions similar to those of Rule 30(f)(1) (A) and (B) of the Federal Rules of Civil Procedure are applicable to interferences.

2377 Form of Transcript of Deposition [R-2]

37 CFR 1.677 Form of a transcript of deposition. (a) A transcript of a deposition must be typewritten on opaque, unglazed, durable paper approximately 8½ by 11 inches (21.8 by 27.9 cm.) in size (letter size). Typing shall be double-spaced on one side of the paper in not smaller than pica-type with a margin of 1½ inches (3.8 cm.) on the left-hand side of the page. The pages must be consecutively numbered throughout the entire record of each party (§ 1.653(d)) and the name of the witness must be typed at the top of each page (§1.653(e)). The questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used and each question must be followed by its answer.

(b) Exhibits must be numbered consecutively and each must be marked as required by § 1.653(i).

Section 1.677 sets out the form of a transcript of a deposition.

2378 Time for Filing Transcript of Deposition [R-2]

37 CFR 1.678 Transcript of deposition must be filed. Unless otherwise ordered by an examiner-in-chief, a certified transcript of a deposition must be filed in the Patent and Trademark Office within 45 days from the date of the deposition. It a party refuses to file a certified transcript, the examiner-in-chief or the Board may take appropriate action under § 1.616. If a party refuses to file a certified transcript, any opponent may move for leave to file the certified transcript and include a copy of the transcript as part of the opponent's record.

Under § 1.678, a transcript of a deposition must be filed in the PTO within 45 days of the date of the deposition.

2379 Inspection of Transcript [R-2]

37 CFR 1.679 Inspection of transcript. A certified transcript filed in the Patent and Trademark Office may be inspected by any party. The certified transcript may not be removed from the Patent and Trademark Office for printing (§ 1.653(g)) unless authorized by an examiner-in-chief upon such terms as may be appropriate.

2382 Official Records and Printed Publications [R-2]

37 CFR 1.682 Official records and printed publications. (a) A party may introduce into evidence, if otherwise admissible, any official record or printed publication not identified on the record during the taking of testimony of a witness, by filing a notice offering the official record or publication into evidence. If the evidence relates to the party's case-in-chief, the notice shall be filed prior to close of testimony of the party's case-in-chief. If the evidence relates to rebuttal, the notice shall be filed prior to the close of testimony of the party's case-in-rebuttal. The notice shall (1) identify the official

record or printed publication, (2) identify the portion thereof to be introduced in evidence, (3) indicate generally the relevance of the portion sought to be introduced in evidence, and (4), where appropriate, be accompanied by a certified copy of the official record or a copy of the printed publication (§ 1.671(d)).

(b) A copy of the notice, official record, and publication shall be served.

(c) Unless otherwise ordered by an an examiner-in-chief, any written objection to the notice or to the admissibility of the official record or printed publication shall be filed within 15 days of service of the notice. See also § 1.656(h).

Section 1.682 sets out how a party may introduce in evidence, if otherwise admissible, official records or printed publications. When a notice is served, a party is also required to serve (but not file) copies of the official records and printed publications. Any objection to the notice or to the admissibility of any official record or publication must be filed within 15 days of the date of service of the notice.

If an official record or printed publication is made an exhibit during a deposition or in an affidavit, it need not be submitted under § 1.682. Section 1.682 permits a party to make an official record or printed publication part of the evidence being considered at final hearing without calling a witness. The official record or printed publication must, however, be self-authenticating. On the other hand, a party may present the official record or printed publication as an exhibit during testimony. When this latter course is followed, there is no need to take advantage of the provisions of § 1.682.

2383 Testimony From Another Interference or Proceeding [R-2]

37 CFR 1.683 Testimony in another interference, proceeding, or action. (a) Prior to close of a party's appropriate testimony period or within such time as may be set by an examiner-in-chief, a party may file a motion (§ 1.635) for leave to use in an interference testimony of a witness from another interference, proceeding, or action involving the same parties, subject to such conditions as may be deemed appropriate by an examiner-in-chief. The motion shall specify with particularity the exact testimony to be used and shall demonstrate its relevance.

(b) Any objection to the admissibility of the testimony of the witness shall be made in an opposition to the motion. See also § 1.656(h).

Section 1.683 sets out how a party may use testimony from another interference or proceeding.

2384 Testimony in a Foreign Country [R-2]

37 CFR 1.684 Testimony in a foreign country. (a) An examiner-in-chief may authorize testimony of a witness to be taken in a foreign country. A party seeking to take testimony in a foreign country shall, prior to the close of the party's appropriate testimony period or within such time as may be set by an examiner-in-chief, file a motion (§ 1.635):

(1) Naming the witness.

(2) Describing the particular facts to which it is expected that the witness will testify.

(3) Stating the grounds on which the moving party believes that the witness will so testify.

(4) Demonstrating that the expected testimony is relevant.

(5) Demonstrating that the testimony cannot be taken in this country at all or cannot be taken in this country without hardship to the moving party greatly exceeding the hardship to which all opposing parties will be exposed by the taking of the testimony in a foreign country.

(6) Accompanied by an affidavit stating that the motion is made in good faith and not for the purpose of delay or harassing any party.

(7) Accompanied by written interrogatories to be asked of the witness.

(b) Any opposition under § 1.638(a) shall state any objection to the written interrogatories and shall include any cross-interrogatories to be asked of the witness. A reply under § 1.638(b) may be filed and shall be limited to stating any objection to any cross-interrogatories proposed in the opposition.

(c) If the motion is granted, the moving party shall be responsible for obtaining answers to the interrogatories and cross-interrogatories before an officer qualified to administer oaths in the foreign country under the laws of the United States or the foreign country. The officer shall prepare a transcript of the interrogatories, cross-interrogatories, and recorded answers to the interrogatories and cross-interrogatories, and shall transmit the transcript to BOX INTERFERENCE, Commissioner of Patents and Trademarks, Washington, D.C. 20231, with a certificate signed and sealed by the officer and showing:

(1) The witness was duly sworn by the officer before answering the interrogatories and cross-interrogatories.

(2) The recorded answers are a true record of the answers given by the witness to the interrogatories and cross-interrogatories.

(3) The name of the person by whom the answers were recorded and, if not recorded by the officer, whether the answers were recorded in the presence of the officer.

(4) The presence or absence of any party.

(5) The place, day, and hour that the answers were recorded.

(6) A copy of the recorded answers was read by or to the witness before the witness signed the recorded answers and that the witness signed the recorded answers in the presence of the officer. The officer shall state the circumstances under which a witness refuses to read or sign recorded answers.

(7) The officer is not disqualified under § 1.674.

(d) If the parties agree in writing, the testimony may be taken before the officer on oral deposition.

(e) A party taking testimony in a foreign country shall have the burden of proving that false swearing in the giving of testimony is punishable as perjury under the laws of the foreign country. Unless false swearing in the giving of testimony before the officer shall be punishable as perjury under the laws of the foreign country where testimony is taken, the testimony shall not be entitled to the same weight as testimony taken in the United States. The weight of the testimony shall be determined in each case.

Section 1.684 sets out how a party may take testimony in a foreign country.

Section 1.684 does not apply to cross-examination. If a party submits an affidavit under § 1.672(b) or intends to rely on an affidavit under § 1.617(e), the party must make the affiant available for cross-examination at a deposition. See § 1.673(e). A deposition may be noticed only "for a reasonable time and place in the United States." See § 1.673(a). Accordingly, it is not expected that § 1.684(a) will be used to cross-examine affiants residing in foreign countries. The party filing the affidavit will be required to make the affiant available for cross-examination in the United States.

2385 Errors in Deposition [R-2]

37 CFR 1.685 Errors and irregularities in depositions. (a) An error in a notice for taking a deposition is waived unless a motion (§ 1.635) to quash the notice is filed as soon as the error is, or could have been, discovered.

(b) An objection to a qualification of an officer taking a deposition is waived unless:

(1) The objection is made on the record of the deposition before a witness begins to testify.

(2) If discovered after the deposition, a motion (§ 1.635) to suppress the deposition is filed as soon as the objection is, or could have been discovered.

(c) An error or irregularity in the manner in which testimony is transcribed, a certified transcript is signed by a witness, or a certified transcript is prepared, signed, certified, sealed, indorsed, forwarded, filed, or otherwise handled by the officer is waived unless a motion (§ 1.635) to suppress the deposition is filed as soon as the error or irregularity is, or could have been, discovered.

(d) An objection to the competency of a witness, admissibility of evidence, manner of taking the deposition, the form of questions and answers, any oath or affirmation, or conduct of any party at the deposition is waived unless an objection is made on the record at the deposition stating the specific ground of objection. Any objection which a party wishes considered by the Board at final hearing shall be included in a motion to suppress under § 1.656(h).

(e) Nothing in this section precludes taking notice of plain errors affecting substantial rights although they were not brought to the attention of an examiner-in-chief or the Board.

Section 1.685 sets out how objections during the taking of depositions must be raised. Under § 1.685(a), an error in a notice of deposition is waived unless a motion to quash the notice is filed as soon as the error is, or could have been, discovered. Under § 1.685(b), any objection to the qualifications of an officer is waived unless (1) the objection is noted on the record of the deposition before a witness begins to testify or (2) if discovered after the deposition, a motion to suppress is filed as soon as the objection is, or could have been, discovered. Under § 1.685(c), any error in the manner in which testimony is transcribed, the transcript is signed by a witness, or the transcript is prepared or otherwise handled by the court reporter is waived unless a motion to suppress is filed as soon as the error is, or could have been, discovered. Under § 1.685(d), any objection on the merits to the admissibility of evidence (e.g., under the Federal Rules of Evidence) is waived unless an objection is made on the record at the deposition stating the specific ground of objection. Often objections are cured by subsequent testimony. Accordingly, any objection which a party wants the Board to consider at final hearing must also be made the subject of a motion under § 1.656(h).

Section 1.685(d) requires an objection to be stated on the record. An objection to the admissibility of evidence must be stated on the record *and* a motion under § 1.656(h) renewing the objection at final hearing must be filed. No longer will a party be permitted to attend a deposition and fail to enter an objection only to raise the objection at final hearing.

A single examiner-in-chief may rule on admissibility of evidence "where appropriate" and in "unusual" circumstances. There are times during interferences where a motion *in limine* can be helpful. For example, a junior party during its case-in-chief may wish to examine a witness on a document which was *not* served as required by § 1.673(b)(1). The senior party objects and realizes that if the junior party is permitted to examine the witness on the document, extensive cross-examination using numerous documents would be necessary. In order to avoid wasting considerable time, the parties could contact the examiner-in-chief by phone for a determination *in limine* on whether the junior party should be able to examine the witness on the document. Under the circumstances outlined the examiner-in-chief in his or her discretion could enter an order excluding the document from evidence. The order would be subject to a request for reconsideration. See § 1.640(c). Ordinarily, however, it would be expected that parties would present evidence subject to objection. See § 1.675(c), last sentence. It is not envisioned that a single examiner-in-chief will routinely rule on the admissibility of evidence.

2387 Additional Discovery [R-2]

37 CFR 1.687 Additional Discovery. (a) A party is not entitled to discovery except as authorized in this subpart.

(b) Where appropriate, a party may obtain production of documents and things during cross-examination of an opponent's witness or during the testimony period of the party's case-in-rebuttal.

(c) Upon a motion (§ 1.635) brought by a party within the time set by an examiner-in-chief under § 1.651 or thereafter as authorized by § 1.645 and upon a showing that the interest of justice so requires, an examiner-in-chief may order additional discovery, as to matters under the control of a party within the scope of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery.

(d) The parties may agree to discovery among themselves at any time. In the absence of an agreement, a motion for additional discovery shall not be filed except as authorized by this subpart.

Section 1.687 sets out how a party could seek and obtain additional discovery. "Additional discovery" is defined in § 1.601(a). Section 1.687(c) does not change the standard ("interest of justice") for obtaining discovery.

Additional discovery obtained under a protective order issued by either the PTO or a district court will not be admitted in evidence in the PTO in determining the interference. All evidence submitted in an interference must be made available to the public under the provisions of § 1.11(a). Accordingly, any protective orders have to be vacated before a document could be admitted in evidence in the PTO which is subject to a protective order. The following example illustrates how the practice would work.

Example. An interference involves party X and party Y. During the interference, party X files a motion for additional discovery under § 1.687(c) asking that party Y be required to produce certain documents. Party Y opposes on the sole ground that the documents contain trade secret and confidential information. Party Y indicates that it has no objection to producing the documents for inspection by counsel for party X, but insists that party X not be permitted to inspect the documents. Accordingly, party Y asks the examiner-in-chief to authorize the discovery subject to entry of a protective order. Party Y argues, however, that the sanctions of § 1.616 are not sufficient in the event of a violation of the protective order. An examiner-in-chief concludes that additional discovery should be ordered, that a protective order is appropriate, and that the sanctions of § 1.616 are not sufficient in the event of a violation of the protective order. Under the circumstances, the examiner-in-chief would enter an order directing party Y to produce the documents for inspection by counsel of party X on the condition that party X seek production of the documents by a subpoena *duces tecum* under 35 U.S.C. 24. Upon issuance of any subpoena, party Y could move the district court for entry of a protective order. If the district court enters the protective order, party Y can produce the documents to counsel for party X. If the protective order of the examiner-in-chief is violated, an appropriate sanction up to and including judgment may be entered by the Board. In addition, party Y would be in a position to seek contempt or other sanctions in the district court.

The documents produced for inspection by counsel for party X could not be admitted in evidence in the interference (until the protective order is vacated), because those documents are not documents which can be made available to the public under § 1.11(a).

2388 Use of Discovery [R-2]

37 CFR 1.688 Use of Discovery. (a) If otherwise admissible a party may introduce into evidence, an answer to a written request for an admission or an answer to a written interrogatory obtained by discovery under § 1.687 by filing a copy of the request for admission or the written interrogatory and the answer. If the answer relates to a party's case-in-chief, the answer shall be filed prior to the close of testimony of the party's case-in-chief. If the answer relates to the party's rebuttal, the admission or answer shall be filed prior to the close of testimony of the party's case-in-rebuttal. Unless otherwise ordered by an examiner-in-chief, any written objection to the admissibility of an answer shall be filed within 15 days of service of the answer.

(b) A party may not rely upon any other matter obtained by discovery unless it is introduced into evidence under this subpart.

Section 1.688 sets out how a party can introduce into evidence admissions and answers to interrogatories obtained as a result of additional discovery.

☆U.S. GOVERNMENT PRINTING OFFICE: 1986—491-097—52551