THIS OPINION WAS WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise not binding precedent. The decision was entered on 14 April 1999

Paper 62

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Entered
30 April 1999

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

HEINZ NAU and CIARAN M. REGAN,

Junior Party,
(Application 08/446,481),

v.

SHUICHI OHUCHIDA, KAZUO KISHIMOTO,
NARITO TATEISHI and HIROYUKI OHNO,

Senior Party
(Application 08/681,482).

Patent Interference No. 104,258

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

ORDER GRANTING REQUEST FOR RECONSIDERATION

A. Introduction

Before us is NAU REQUEST FOR RECONSIDERATION (Paper 61) in which Nau requests that we modify our ORDER DECIDING NAU MISCELLANEOUS MOTION 2 (Paper 57) to permit Nau to file a renewed opposition.

B. Discussion

Nau notes that, as a result of our ORDER DECIDING NAU MISCELLANEOUS MOTION 2, it just recently became aware that it may have a de facto burden of proof with respect to certain issues raised by Ohuchida Preliminary Motion 1. Reasoning that had it known that it had a de facto burden, Nau now says that it would have filed an opposition with arguments and evidence in addition to the argument and evidence presented in NAU OPPOSITION 1 (Paper 45).

Under the circumstances of this case, and given that we announced essentially for the first time that, under certain unusual circumstances, there may be a de facto burden of proof on a party opposing a preliminary motion, we agree with Nau that the fair thing to do is to allow Nau to file an opposition and evidence which Nau feels may best satisfy any de facto burden which it may have.

Normally, we would be inclined to request a response from Ohuchida with respect to the NAU REQUEST FOR RECONSIDERATION

before granting the request. However, there can be no prejudice to Ohuchida in allowing Nau to file a renewed opposition with all arguments and evidence deemed appropriate by Nau, given that Ohuchida has been authorized to file a reply responding to any and all arguments presented by Nau. Rule 601 contemplates a just, speedy and inexpensive interference. In short, whatever procedure is used in an interference ought to be as fair as possible. Perceiving no prejudice to Ohuchida if the NAU REQUEST FOR RECONSIDERATION is granted without any views being submitted by Ohuchida, we believe it is appropriate to enter a decision on the reconsideration request at this time.

C. Additional observation

In this case, Nau could not have been aware of a new practice announced in our ORDER DECIDING NAU MISCELLANEOUS MOTION 2 (Paper 57). Since both the ORDER DECIDING NAU MISCELLANEOUS MOTION 2 and the opinion entered today will appear on the Web Page of the PTO, in the future parties will be on notice that there are cases where in filing an opposition a party may be under a de facto burden of proof in connection with arguments made in the opposition. In future oppositions, counsel should take into consideration the practice announced in the orders which have been entered in this particular interference.

D. Order

Upon consideration of the NAU REQUEST FOR RECONSIDERATION, and for the reasons given, it is

ORDERED that the request is granted to the extent that the NAU OPPOSITION 1 (Paper 45) shall be returned.

FURTHER ORDERED times will be set for filing a new Nau opposition, an Ohuchida reply and a further Nau reply.

FURTHER ORDERED that this ORDER shall be published on the PTO Web Page.

FRED E. McKELVEY, Senior Administrative Patent Judge	
RICHARD E. SCHAFER Administrative Patent Judge	
JAMESON LEE Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD TORCZON Administrative Patent Judge	

30 April 1999
Arlington, VA