**INTERFERENCE TRIAL SECTION PRECEDENTIAL OPINION**

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 The opinion is otherwise not binding precedent.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 23 December 1998.

Paper No. 4

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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F.M.W.,

Junior Party,
(Patents A,AAA,AAA and B,BBB,BBB),

v.

D.A.T.,

Senior Party
(Application CC/DDD,DDD).

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Patent Interferences 104,BBB and 104,CCC

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

McKELVEY, Senior Administrative Patent Judge.

**MEMORANDUM OPINION AND ORDER**

**A. Discussion**

A Trial Section of the Board of Patent Appeals and Interferences was established in October of this year for the purpose of handling interference cases up to final hearing. 1217 Off. Gaz. Pat. & Tm. Office 18 (Dec. 1, 1998). Immediately upon its establishment, the Trial Section set out to eliminate a backlog of approximately 80 proposed interferences which had been forwarded to the board by the Technology Centers, but which had not been declared.[1] As of the date of this MEMORANDUM OPINION AND ORDER, the backlog has essentially been eliminated through declarations of interferences or remands with a "missing parts report"[2] to the Technology Centers for corrective action.[3]

When an interference is declared, the Trial Section uses a standardized NOTICE DECLARING INTERFERENCE.[4] The notice requires

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[1] We are aware that members of the bar have referred to a "black hole" from which "undeclared interferences" are unable to "escape." The "black hole" time period begins when an examiner signs a Form PTO 850 and ends when an interference is declared. The time period consists of two time periods. The first begins when the examiner signs the 850 and ends when the papers reach the board. The second time period begins when the papers reach the board and ends when the interference has been declared. Creation of the Trial Section has essentially eliminated the second time period. We understand that the Patent Corps is making every effort to essentially eliminate the first time period. In the future, the period between the signing of the 850 and declaration of the interference hopefully will be minimal.

[2] Interferences declared: 27. Missing parts reports issued: 70. The number of missing parts reports and interferences declared do not add to 80 because proposed interferences have been received since the creation of the Trial Section.

[3] It is the standard practice of the Trial Section to notify the practitioners of record when a proposed interference is returned to a Technology Center with a missing parts report for corrective action.

[4] Use of a standardized NOTICE DECLARING INTERFERENCE is in response to complaints by practitioners (including the second practitioner mentioned hereinafter) that different administrative patent judges used different

that certain ministerial acts be taken within standardized established time periods. For example, the notice requires a party within fourteen (14) days to (1) identify a lead and backup counsel,[5] (2) identify the real party in interest[6] and (3) place an order for copies of files.[7]

These two interferences were declared on December 16, 1998.

The administrative patent judge who entered the NOTICE DECLARING INTERFERENCE on behalf of the board overlooked the fact that the due dates were going to fall during a holiday period when using the standard NOTICE DECLARING INTERFERENCES.

On December 23, 1998, documents styled JUNIOR PARTY NOTICE #1 (Paper 3) were received by facsimile for each of Interference 104,BBB and Interference 104,CCC. The fax documents were sent by a first practitioner associated with the patent department of the assignee of the junior party.

The junior party fax documents point out that (1) the certain periods for taking action set out in the NOTICE DECLARING INTERFERENCE make numerous documents due fourteen days after the interferences were declared, which turns out to be December 30, 1998, and (2) December 30, 1998, falls during a holiday period during which practitioners are said not to be present in the

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declaration notices.

[5] NOTICE DECLARING INTERFERENCE, Paragraph 7.

[6] NOTICE DECLARING INTERFERENCE, Paragraph 8.

[7] NOTICE DECLARING INTERFERENCE, Paragraph 9.

patent department of the assignee of the junior party. The administrative patent judge who declared the interference would have had no way of knowing that no practitioner would be available in the rather large patent department[8] of the assignee of the junior party.

The junior party fax documents also point out that the junior party "appears to have no vital interest in this interference, as far as *** [the first practitioner submitting the documents] is presently informed, and thus [the junior party] does not presently intend to respond ***" (Paper 3, page 3).

Under the circumstances, we believe that it would be appropriate to reset the time for complying with those requirements of the NOTICE DECLARING INTERFERENCE which presently make papers due on December 30, 1998. The interference rules are to "be construed to secure the just, speedy, and inexpensive determination of every interference." 37 CFR § 1.601. In addition, and in particular to save the senior party applicant any unnecessary expense, we will set a time period for the junior party to determine whether it wishes to file a request for entry of an adverse judgment. 37 CFR § 1.662(a). Papers otherwise due can be filed after the junior party determines whether it wishes to file requests for entry of adverse judgment. A time will also

[8] According to a publication of the PTO, there were over 20 registered practitioners giving as their address the address of the assignee of the junior party. Attorneys and Agents Registered to Practice before the U.S. Patent and Trademark Office (1996).

be set for filing preliminary statements--the effective filing date difference between the senior and junior party is over 4 years.

**B. Observation**

The tone of the fax documents (Paper 3) is emotional, as opposed to objective. The facts manifestly could have been set out in a straightforward, non-emotional manner, and an extension of time could have been requested. 37 CFR § 1.645.

The times set in the NOTICE DECLARING INTERFERENCE were set in good faith--a fact which we would hope the first practitioner would have understood. However, the tone of the fax documents suggest that the first practitioner feels otherwise. The documents required to be filed by December 30, 1998, are ministerial in nature and in no way involve any substantive issue. Hence, we are truly surprised by the tone of the fax documents. The first practitioner's attention is directed to 37 CFR § 1.3 which provides that practitioners are to conduct business with the Patent and Trademark Office "with decorum ***."

**C. Ex parte e-mail communication**

We also make of record an e-mail communication sent to the administrative patent judge designated to handle these interferences by a second practitioner associated with the patent department of the assignee junior party. We note that the e-mail

communication was sent to the personal e-mail address, and not the USPTO e-mail address, of the administrative patent judge designated to handle the interference. The e-mail communication also was copied to Chief Administrative Patent Judge Stoner at his USPTO e-mail address. Insofar as we can tell from the record, the e-mail communication was not forwarded to the attorney of record for the senior party, thus making the e-mail communication an ex parte communication.

The e-mail communication can be viewed as supplementing arguments made in the electronic copies of the documents (Paper 3), in which case the e-mail communication is an improper ex parte communication in an interference. On the other hand, it is possible to review the e-mail communication as calling attention to a general problem in interference cases.

We will give the second practitioner the benefit of the doubt. We will assume that the second practitioner was attempting to call attention to a general problem associated with the use of the Trial Section's standard NOTICE DECLARING INTERFERENCE in such a manner as to make papers, albeit papers ministerial in nature, due during a holiday period. Nevertheless, in light of the ex parte nature of the e-mail communication, we call attention to A.S. v. B.R., Interference 104,AAA (Paper 10) (Bd. Pat. App. & Int. Dec. 2, 1998), which is available on the PTO web page at

http://www.uspto.gov/web/offices/dcom/bpai/its.htm.

**D. Order**

Upon consideration of the record, and for the reasons given, it is

ORDERED that the junior party shall have until **January 14, 1999**, within which to file a request for entry of adverse judgment (if the junior party be so advised).

FURTHER ORDERED that if the junior party does not file a request for entry of adverse judgment on or before January 14, 1999, then both parties shall have until **January 22, 1999**, within which to comply with the requirements of the NOTICE DECLARING INTERFERENCE which would otherwise be due before January 22, 1999.

FURTHER ORDERED that preliminary statements shall be filed, and notices that a preliminary statement has been filed shall be filed and served, on or before **March 11, 1999**, subject to the time and date being further changed by the administrative patent judge designated to handle these interferences.

FURTHER ORDERED that the telephone conference call scheduled for 2:30 p.m. on February 17, 1999, is rescheduled for **2:30 p.m. on March 16, 1999** (the call will be initiated from the PTO), subject to the time and date being further changed by the

administrative patent judge designated to handle these interferences.

FURTHER ORDERED that a copy of this opinion without identifying the parties or practitioners shall be published.

FURTHER ORDERED that the Clerk shall mail a copy of this MEMORANDUM OPINION AND ORDER to the attorney of record for the senior party and to both the first and second practitioners associated with the junior party.

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| FRED E. McKELVEY, Senior<br>Administrative Patent Judge | ) |
| RICHARD E. SCHAFER<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND<br>) INTERFERENCES |
| JAMESON LEE<br>Administrative Patent Judge | ) |

cc (via Fax and First Class Mail):

Attorney for F.M.W.

Attorney for D.A.T.

Enc: E-mail communication mentioned in the opinion