

Consolidated Board Rules

**Submission of Comments regarding
“Rules of Practice Before the
Board of Patent Appeals and Interferences”,
Proposed Rule (re 37 CFR Parts 1, 5, and 41),
68 Fed. Reg. 66648 (November 26, 2003)**

Due Date: January 26, 2004

Attn.: Administrative Patent Judge Richard Torczon
Mail Stop Interference
Director of the U.S. Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

The following are comments regarding the above-referenced
Proposed Rule:

1. Proposed § 41.106(a)(2)(ii)

It is suggested that tables of contents should be permitted to be
single-spaced.

2. Proposed § 41.106(d)

It is suggested that the references to Express Mail® be clarified to
expressly state that overnight delivery is required. It is also suggested that

hand carrying to either the Board or the mailroom of the U.S. Patent and Trademark Office be expressly listed as authorized modes of filing.

3. Proposed § 41.106(e)

It is suggested that the references to Express Mail® and “means at least as fast and reliable as Express Mail®” be clarified to expressly state that overnight delivery is required.

It is also suggested that the rule expressly state that the date of service is the date that the paper is deposited with the overnight delivery provider, or sent via facsimile.

In Proposed § 41.106(e)(4), it is suggested that the expression “The date service is received does not count in computing the time for responding” be changed to “The date of service does not count in computing the time for responding” or that further clarification be provided as to whether facsimile and overnight courier service toll different periods for response.

4. Proposed § 41.106

The rule states that a single certificate may accompany any group of

exhibits submitted together. It is suggested that each exhibit have its own certificate of service. In the past some practitioners have served a first set of exhibits as their priority case upon opposing counsel, and then filed a second, different set of exhibits with the Board. Requiring that each exhibit have its own certificate of service should help to discourage such a practice, and should also assist Board personnel in handling exhibits.

5. Proposed § 41.108

The rule refers only to “counsel” and not to “agent”. It is suggested that the rule be revised to refer to “counsel or agent”, to encompass the case where a party is represented by an agent rather than an attorney.

It is also suggested that the term “promptly” in Proposed § 41.108(c) be replaced with “within 14 days”.

6. Proposed § 41.109

It is suggested that the Board permit the requesting of certified copies of the Office records in question. Under present practice, only uncertified copies are provided, whether or not certification is requested. Certified copies are preferable because they are less likely to have missing papers or pages.

7. Proposed § 41.110

It is suggested that the clean copy of claims include all claims, not just involved claims. In the event that a motion is filed to designate an uninvolved claim as corresponding to the count, it is helpful to the parties and to the Office to have the text of that claim set forth without any underlining or strikethrough.

Proposed § 41.110(c) requires a clean set of claims when amending a claim or adding a reissue claim, but does not mention adding a non-reissue claim. It is suggested that such mention be included.

8. Proposed § 41.121(a)(2)

It is suggested that a party not be authorized to move to cancel a claim. Under current practice, such a motion is not permitted, and it is not understood that such a motion would serve to simplify consideration of a priority contest. Furthermore, it would give an unfair advantage to an applicant, who can cancel a claim, whereas a patentee cannot.

9. Proposed § 41.121(c)

It is suggested that a requirement be added along the lines of Rule 639 to require that proof of any fact alleged in a motion, opposition, or reply

must be filed and served or at least served with the paper.

It is also suggested that in Proposed § 41.121(c)(1)(ii) each numbered paragraph be limited to one sentence to simplify consideration of the alleged material fact by the parties and the Administrative Patent Judge.

It is also suggested that Proposed § 41.121(c)(1)(iii) state that the “detailed explanation of the significance of the evidence” may cite to the evidence either by reference to the numbered paragraphs required by Proposed § 41.121(c)(1)(ii) or by repeating the specific citations to the portions of the record. The purpose of this suggestion is to relieve the parties of the burden of repeating in the “detailed explanation” section the full record citations that have already been set forth in the “material facts” section.

It is also suggested that Proposed § 41.121(c)(2) expressly require that any motion to add a claim to a reissue application be accompanied by a reissue declaration or supplemental reissue declaration addressing that claim.

It is suggested that Proposed § 41.121(c)(4) be omitted. That rule states, inter alia, that “Any material fact not specifically denied will be considered admitted”. It is suggested that this sentence be deleted. A senior party, confident in its priority case, should not be required to file any

substantive papers in an interference beyond, e.g., a preliminary statement or the like. This sentence requires such a senior party to file an opposition to each and every junior party motion, whether or not the relief requested is opposed, to deny inaccurately alleged facts. In the alternative, it is suggested that the opponent be permitted to respond to an alleged fact by stating “Not Admitted” or the like, to cover the case where a movant alleges a fact but does not provide record proof of the same.

10. Proposed § 41.122

It is suggested that this proposed rule be significantly modified. This proposed rule states that an opposition may raise “new arguments, but only in response to arguments made in the corresponding motion”. Under current practice, there are no limitations on what arguments may be raised in an opposition, and it is not understood why any such limitation should now be imposed, especially where the scope of the expression “only in response to arguments made in the corresponding motion” may be subject to debate.

Meanwhile, the proposed rule further states that a reply “may only respond to arguments raised in the corresponding opposition”. This requirement removes the former prohibition of Rule 1.638(b) which limited replies to addressing “new” points raised in an opposition. In view of the

foregoing, it is respectfully submitted that the proposed rule encourages movants to “sandbag” and withhold critical arguments and evidence until the filing of a reply to shield them from opposition. Consider, for example, a movant who alleges that a claim is unpatentable as anticipated but fails to address a limitation of the claim. When the opposition points out this deficiency, the proposed rule would appear to authorize the replying party to remedy the deficiency by way of reply, leading to patchwork prosecution of the interference, an unfair second bite at the apple, and inefficient administration of justice. It is suggested that the rule be revised to permit replies only by leave of the Board, and in the alternative to permit replies only if they contain an explanation as to why the argument and any new evidence accompanying the reply were not necessary to establish the underlying motion’s prima facie basis for relief.

11. Proposed § 41.123

This rule states that an opposition to a miscellaneous motion may not be filed without authorization and must be filed within 5 business days of service. It is respectfully suggested that the requirement for authorization be deleted, and the amount of time be increased to at least 14 days. It often can be difficult to arrange an inter partes telephone conference with the

Administrative Patent Judge on short notice, and 5 business days provides little time to schedule such a conference. Furthermore, 5 business days is generally manifestly too little time to respond. The subsection further requires that replies be filed within 3 business days, which is also far too little time.

12. Proposed § 41.125

It is suggested that the parties be given a chance to file position papers containing a suggested order for the Board to take up motions for decisions, and containing an explanation as to why a motion should or should not be deferred until a later point in the proceeding. The purpose of this suggestion is to assist the Board in selecting a course of action that is most just, speedy, and inexpensive in nature.

Furthermore, it is suggested that Proposed § 41.125(c)(3)(ii) be modified. That proposed rule requires that the party identify “the place where the matter was previously addressed in a motion, opposition, or reply”. It is suggested that this sentence be modified to address the instances where the Board sua sponte decides a matter without a party having moved, or where the Board, in deciding a motion, adopts a position not advanced by either party.

13. Proposed § 41.127

Subsection (a) refers to a “losing party” and to “contested subject matter for which that party was awarded a favorable judgment”.

Clarification is requested as to whether estoppel applies against a party who prevails on priority (i.e., who does not lose on priority), but all of whose claims are found to be unpatentable.

In subsection (d), the rule requires that the party identify “the place where the matter was previously addressed in a motion, opposition, or reply”. It is suggested that this sentence be modified to address the instances where the Board sua sponte decides a matter without a party having moved, or where the Board adopts a position not advanced by either party.

The rule also states that the Board “may” toll the time for seeking judicial review for the pendency of the rehearing. It is suggested that the period automatically be tolled, inasmuch as the request for rehearing may obviate the need for judicial review.

14. Proposed § 41.150

The rule requires that the requesting party must show that additional discovery is “in the interests of justice”. It is suggested that the rule

expressly state that the “interests of justice” must include, inter alia, (i) a showing that the evidence requested in discovery is not available to the movant and (ii) a showing as to why the evidence requested in discovery is necessary to establish a prima facie basis for relief, so as to preclude discovery fishing expeditions.

15. Proposed § 41.155

First, the proposed rule is listed as “1.155” and should read “41.155”.

Secondly, the proposed rule permits the filing of supplemental evidence within 10 days of an objection, but should be revised to clarify that no further evidence may be filed to cure objections to supplemental evidence.

Thirdly, under current practice an objection not made on the record is deemed waived, a protection not expressly stated in the proposed rule. It is suggested that this practice be preserved in the proposed rule, viz, by having the proposed rule state that no motion to exclude evidence where an objection was not made on the record shall be brought without authorization of the Board. The purpose of this modification is to obviate the need for the opponent to expend its resources responding substantively to a waived objection.

16. Proposed § 41.156

It is suggested that the relationship between this rule and Proposed § 41.150 be clarified, and that this rule be modified to include the requirements proposed above for Proposed § 41.150.

17. Proposed § 41.157

Some practitioners have used “errata” for deposition transcripts to make substantive changes to deposition testimony. It is suggested that the rule expressly state that any such “errata” must accurately reflect the questions posed and answers provided, as opposed to that which the practitioner wishes had been said.

18. Proposed § 41.201

As an initial matter, it is suggested that each definition be given a subsection letter (i.e., “(a)”, “(b)”, etc.) to make reference to the same easier.

“Accord benefit” is defined with respect to 35 U.S.C. § 102(g). As that subsection refers to “in this country”, clarification is requested as to whether “accord benefit” is intended to cover foreign priority applications, especially those filed prior to the critical dates for NAFTA (in 1994) and WTO (January 1, 1996). See In re Hilmer.

The definition of “Count” refers to “patentably distinct” as the requirement for the existence of plural counts. Under existing practice, the definition of interfering subject matter is used (i.e., the “separate patentable invention” test of 37 C.F.R. § 1.601(n)). To avoid confusion about the scope of the term “patentably distinct”, it is suggested that the proposed rule be modified to expressly employ a definition along the lines of Proposed § 41.203. For example, it could be stated: two counts define “patentably indistinct” inventions if each anticipates or renders the other obvious; otherwise, they define “patentably distinct” inventions. This statement would make clear that it is acceptable to have a “genus” count and a “species” count, since although the species would anticipate the genus, it might be possible for the species to be non-obvious over the genus, for example, because of secondary considerations of non-obviousness. Clarification is requested, however, as to what date should be taken into account in deciding such non-obviousness.

The definition of “Earliest constructive reduction to practice” states that for the chain to be continuous, “each subsequent application must have been copending under 35 U.S.C. § 120....” It is suggested that “copending under” be changed to “meet the requirements of”. The purpose of this change to ensure that the statutory cross-reference requirement is met. See

Ex parte Sampson. For example, consider the case where the involved application, Application 4, contains a cross-reference as follows: “This application is a continuation of Application 3 filed June 7, 1995, which is a continuation of Application 2 filed June 7, 1993, which is a continuation of Application 1 filed June 7, 1990.” Under the doctrine mentioned above, Application 3 must contain a cross-reference to Applications 2 and 1, and Application 2 must contain a cross-reference to Application 1. In other words, copendency is not the only requirement of 35 U.S.C. § 120, and it is suggested that the proposed rule reflect this fact.

In the definition for “threshold issue”, the proposed rule refers to a claim first made “after the publication of the movant’s application or issuance of the movant’s patent”. It is suggested that the language be revised throughout the rule and subpart to reflect the actual language of 35 U.S.C. § 135(b), i.e., (1) to delete the term “movant” as such is not a statutory requirement and (2) to make clear that publication is relevant only if the claim being attacked is in an application filed after publication per 35 U.S.C. § 135(b)(2). In addition, it is suggested that the “written description” issue be changed from “2(i)” to --(3)--. Furthermore, clarification is requested as to why is “written description” is a threshold issue, whereas, for example, unpatentability under 35 U.S.C. § 102(b) or 35

U.S.C. § 112, 1st paragraph, non-enablement are not? What is the statutory basis for drawing a distinction between these issues?

19. Proposed § 41.202(a)(6)

This proposed rule requires that the party show where the disclosure provides enabling written description of an embodiment within the scope of the interfering subject matter. It is suggested such is a sufficient but not necessary condition for achieving constructive reduction to practice, and that the proposed rule be so revised, i.e., the proposed rule should state that the party must provide a chart showing where the disclosure provides enabling description of the count or of an embodiment within the scope of the interfering subject matter.

20. Proposed § 41.203

This proposed rule states that an interference exists if the subject matter of one party would anticipate or render obvious the subject matter of a claim of the opposing party and vice versa. It is suggested that this rule be revised to expressly state the position of the Board as to whether unpatentable claims should be considered, especially claims that are unpatentable with respect to the threshold issues of Proposed § 41.201.

Subsection (b) refers to the Notice of declaration. It is suggested that the notice should include a statement setting forth the factual basis upon which the Office has concluded that benefit should be accorded or a claim correspond to a count. See Zurko.

Subsection (d) refers to suggesting the addition of a patent or application to the interference or the declaration of an additional interference. It is suggested that guidance be provided in the rule as to when such a motion can be brought, and when it would be untimely. Also, what has happened to the former practice of “substituting” found in Rule 633(d)?

21. Proposed § 41.204

It is suggested that the proposed rule be modified to divest the senior party of the considerable burden of preparing a priority statement in the case where the junior party does not file any statement or fails to file a “sufficient” statement in the sense of the rule. In other words, the junior party should be required to prepare its priority statement long before the senior party.

It is also suggested that the rule be modified to explain how and in what form the “documentary support” must be provided, i.e., must

declarations be provided?

It is also suggested that the priority statement, like the old preliminary statement, be binding on the party, i.e., no dates earlier than those alleged may be proven (if earlier evidence is submitted only the alleged date at best will be proven).

22. Proposed § 41.207

Proposed subsection (a) states that if two parties are accorded the same date, then neither party is entitled to a presumption of priority. The problem with this rule is that it implies that if both parties stand on their dates, they will both lose, which is outside the scope of 35 U.S.C. § 102(g), i.e., a party should not lose unless someone else is prior — the same date is not prior. Of course, the Office does not wish to issue the same patent to two parties, but if 35 U.S.C. § 102(g) does not preclude that result, then the Office has no choice but to issue the patents unless 35 U.S.C. § 102(g) is amended to address the situation where there is a tie.

Proposed subsection (b)(2) states a claim corresponds to a count if the subject matter of the count would have anticipated or rendered obvious the subject matter of the claim. It is strongly suggested that this proposed rule not be adopted. This is a major change from existing practice and is

believed to be contrary to 35 U.S.C. § 102(g). Under existing practice, a claim corresponds to a count only if each anticipates or renders obvious the other. Consider the following hypothetical example (hereinafter “Hypothetical #1”): Count 1 recites a genus; Count 2 recites a species within the genus (“Species X”), which has been found to be non-obvious over the genus because of unexpectedly improved results; Parties A and B each have a claim to the genus and a claim to Species X; Party A proves that it has actually reduced to practice, on January 1, 1990, without abandoning, suppressing, or concealing Species Y falling within the genus, and that it has actually reduced to practice, on January 3, 1990, without abandoning, suppressing, or concealing Species X; Party B proves that it has actually reduced to practice, on January 2, 1990, without abandoning, suppressing, or concealing Species X. Now Party A should prevail as to Count 1, because it was the first to reduce to practice a species falling within the count, i.e., Species Y. Meanwhile, Party B should prevail as to Count 2, because it was the first to reduce to practice the species of the count, i.e., Species X. Under existing practice, the genus claims would correspond only to the genus count, and the species claims would correspond only to the species count. 37 C.F.R. § 1.601(n). So Party A would keep its genus claim, and lose its species claim. And Party B would lose its genus claim,

but keep its species claim. Under the proposed rule, the genus claims would correspond to both counts, and Party A would lose its genus claim even though it was the first to invent a species within that genus. For a party to lose a claim in an interference, the opposing party must create prior art under 35 U.S.C. § 102(g). The proposed rule does not appear to be consonant with the statute. The comments accompanying the proposed rule assert that “only a one-way test is required” citing In re Saunders for the proposition that a generic claim is unpatentable in view of a lost count to a species. This assertion is respectfully believed to be mistaken. That case was an appeal from an ex parte case. Furthermore, there was no determination that the species and genus defined separate patentable inventions. Also, the appellant failed to demonstrate ex parte that he made the generic invention prior to the species that he lost in the interference. But what if he had? Let us return to Hypothetical #1 above. Under current practice, if after the interference, the Examiner rejected Party A's genus claim over the “lost count” citing Saunders, then Party A could, ex parte, show that he conceived of the entire scope of the genus claim prior to Party B's invention of Species X, a showing that Party A was not required to make during the interference, where a single embodiment is enough to obtain priority as to the genus count. In other words, it is not automatic that a party

who loses the species count but wins the genus count should be denied the genus claim. In this regard, the Board's attention is respectfully directed to Ex parte Hardman, 142 U.S.P.Q. 329 (Bd. Pat. App. & Int. 1964), wherein the Board, reversing an ex parte rejection, stated, inter alia: “priority as to the generic invention by applicant is not necessarily disproved by his not being the first inventor of one species, which species is specifically claimed by the patentee, when it has been fully established that applicant in fact was the first to possess the generic aspects of the invention. In re Saunders, 1955, 104 USPQ 394 . There is no indication of record that either of the two species was invented by the other party prior to the time that appellant made any one of the other species, or prior to the time that it may be considered appellant made the generic invention.” In view of the foregoing, it is respectfully submitted that the proposed rule is inconsistent with 35 U.S.C. § 102(g). Reconsideration of the proposed rule therefore earnestly is solicited.

Proposed subsection (d) introduces the presumption that a party has abandoned, suppressed, or concealed the interfering subject matter if the accorded date of constructive reduction to practice is more than one year after the party's actual reduction to practice. It is suggested that 18 to 24 months would be more in keeping with the majority position found in

existing case law. Also, the requirement that a party prove that it did not abandon, suppress, or conceal requires that the party prove a negative, and it is difficult to tell if a party has presented sufficient proof to prove a negative.

23. Proposed § 41.208

Proposed subsection (a)(2) refers to changing the scope of the count, but makes no mention of adding additional counts. It is suggested that the rule be modified to encompass that possibility. Also there is no mention of substituting an application.

Regarding proposed subsection (c)(1), please see the comment above regarding Proposed § 41.203.

Regarding proposed subsection (c)(2), please see the comment regarding “threshold issues” under 35 U.S.C. § 135(b)(2) above regarding Proposed § 41.201.

Regarding proposed subsection (c)(4)(i), the rule appears to require that when moving to substitute a count, the movant may not substitute a count that defines the same invention. This appears to be a major change from existing practice, where a party might move to make a minor patentably indistinct change in a count so as to encompass its best proofs. It

therefore is suggested that the proposed rule be modified to address adding a count, and not substituting a count.

Regarding proposed subsection (c)(4)(ii), the rule requires that the party prove a negative, i.e., that the proposed count does not include prior art subject matter. It is proposed that the burden of showing a negative be removed from the claim for the reasons set forth above. The rule also requires that the additional subject matter interfere with an opponent's involved claim. It is not clear what is meant by “additional subject matter”. Also, it is not clear why the subject matter must be shown to interfere with an opponent's involved claim. What about a claim of the movant? Or a claim proposed to be added to the movant's or opponent's application?

Regarding proposed subsection (c)(5), please see the comment above regarding Proposed § 41.207(b)(2).

Regarding proposed subsection (d), it is suggested that the content and format of the claim charts be specified, as well as an indication as to whether they count against any page or word limits.

Favorable consideration hereof is earnestly solicited.