

**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 The opinion is otherwise not binding precedent.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 10 March 1999.

Paper No. 40

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Entered  
10 March 1999

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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S. J.,

Junior Party,

v.

R. B.,

Junior Party,

v.

F. M.,

Senior Party

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Patent Interference No. 104,DDD

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

McKELVEY, Senior Administrative Patent Judge.

## ORDER--NON-RECEIPT OF FILES

### A. Findings of fact

The record supports the following findings by a preponderance of the evidence.

1. The interference was declared on 21 December 1998.
2. The NOTICE DECLARING INTERFERENCE (Paper 1) set a period of fourteen (14) days within which the parties were to order involved and benefit files. See Paragraph 9. The NOTICE also set a 2 March 1999 conference call to set dates for taking action in the interference.
3. R.B. placed an order for copies of files on 4 January 1999 (Paper 10).
4. F.M. placed an order for copies of files on 5 January 1999 (Paper 4).
5. S.J.'s original counsel placed an order for copies of files on 4 January 1999 (Paper 15).
6. S.J. designated new lead counsel on 19 January 1999 (Paper 17).
7. On 22 January 1999, an ORDER (Paper 23) was entered by the Trial Section notifying counsel that the requests for copies of files were being forwarded to the Office of Public Records of the Patent and Trademark Office.

8. The ORDER entered 22 January 1999 states in part (page 2):

**FURTHER ORDERED** that, if within eighteen (18) days, a party does not receive a copy of the requested files, the party should notify the Trial Section via fax (703-305-0942) that the files have not been received.

9. S.J.'s new counsel placed a second order for copies of files on 26 January 1999 (Paper 25).

10. Eighteen (18) days after entry of the ORDER (Paper 23) by the Trial Section was 9 February 1999.

11. As of the close of business on 9 February 1999, no fax had been received suggesting that a party had not received all files ordered.

12. On 18 February 1999, R.B. filed a paper (Paper 30) indicating that some material in certain files had not been received.

13. A COMMUNICATION and ORDER entered 25 February 1999 (Paper 32) responded to the R.B. paper (Paper 30).

14. On 26 February 1999, S.J. notified the board that certain material had not been received (Paper 34).

15. During a conference call held on 2 March 1999, the judge designated to handle the interference was further advised that certain files had not been received. See also

- a. R.B. LIST OF PRELIMINARY MOTIONS (Paper 36, page 3) and
- b. S.J.'s LIST OF PRELIMINARY MOTIONS (Paper 35, page 2, first paragraph).

16. Times for taking action during the preliminary motion phase of the interference have been set. See ORDER-- FILING OF PRELIMINARY MOTIONS AND STATEMENTS entered 2 March 1999 (Paper 38).

#### **B. Discussion**

The Trial Section was created in October 1998. Notice of the Chief Administrative Patent Judge of 6 November 1998, Interference Practice--New Procedures for Handling Interference Cases at the Board of Patent Appeals and Interferences, 1217 Off. Gaz. Pat. & Tm. Office 18 (1 December 1998).

One purpose for creating the Trial Section was to make the interlocutory phase of interferences more efficient. One problem expressed by the interference bar prior to creation of the Trial Section was delay in receiving orders of files of involved and benefit files in interferences. To remedy the delay, the Trial Section adopted a policy of requiring orders for files to be placed with the Trial Section. No files are released to any person by the Clerk's Office until all parties have filed requests for files or the Trial Section determines that a party

will not file a request. The files and requests are then forwarded to the Office of Public Records (OPR), which has fourteen (14) days to fill orders. An ORDER is entered in the interference advising the requestors that the files and requests have been sent to OPR. All orders are transmitted to a requester by OPR via an overnight delivery service.

It is always the responsibility of parties, normally through counsel, to obtain copies of the involved and benefit files. The Trial Section--to a point--will help counsel obtain the needed copies of files. As can be readily appreciated from the practice adopted by the Trial Section, it is committed to timely filling of orders. Hence, as a matter of policy, the Trial Section requires that it be notified of non-receipt of copies of files within eighteen (18) days of the ORDER notifying the requestors that files have been transmitted to OPR. If no notice is received, the interference proceeds with a scheduled conference call to set dates.

Despite the Trial Section's establishment of a practice designed to help the interference bar expeditiously receive its requests for files, counsel in this case did not timely notify the Trial Section of non-receipt of files. The Trial Section, like the Trademark Trial and Appeal Board, cannot be expected to

act on matters not timely raised by counsel. Cf. Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989) (prescience is not a required characteristic of the board and the board need not divine all possible afterthoughts of counsel).

As noted earlier, if counsel do not assume their responsibility of notifying the Trial Section within the eighteen (18) day period, then there is little the Trial Section can do to see that counsel timely obtain copies of needed files. Rather, the interference proceeds as though the files have been received. Moreover, times for taking action are not delayed due to (1) an untimely request for files or (2) a failure to timely notify the Trial Section that a timely request has not been timely filed. So it is in this case.

**C. Order**

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

ORDERED that the failure of the parties to timely notify the Trial Section within the eighteen (18) days required by the ORDER entered 22 January 1999 shall not be a basis for changing the time periods for set for taking action in this interference.

FURTHER ORDERED that this opinion shall be published on the PTO Web Page without identification of the names of the parties, their counsel, the applications and/or patents involved or the interference number.

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