

TRIAL SECTION NOTICE
(new forms)

9 April 1999

Effective immediately, the Trial Section will begin using three revised forms for

- (1) declaring an interference (NOTICE DECLARING INTERFERENCE)(version DECLARE5),
- (2) setting times for taking action during the preliminary motion phase of the interference (ORDER--FILING OF PRELIMINARY MOTIONS AND STATEMENTS) (version ORDERPM4) and
- (3) setting times for taking action during the priority testimony phase of the interference (ORDER--TESTIMONY AND FILING OF THE RECORD and BRIEFING SCHEDULE) (version ORDERTE4).

Various minor changes have been made to improve language of the forms. The significant changes are as follows.

I.

NOTICE DECLARING INTERFERENCE
(DECLARE5 which replaces DECLARE4)

1. Paragraph 2, dealing with telephone calls to the board, has been revised to call attention to two Trial Section opinions in Interferences 104,AAA and 104,BBB, both of which appear on the PTO web page.

2. Paragraph 3, dealing with filing papers with the board, has been revised to call attention to the fact that a certificate of service must be made a part of each paper filed with the board and that a single certificate of service shall not be used for multiple papers. The purpose for this requirement is to make it easier for the Office of the Clerk to verify that each paper in an interference has been served. Also Paragraph 3 discourages, but does not prohibit, the use of transmittal sheets. The use of transmittal sheets unduly complicates docketing of papers in the Office of the Clerk.

3. Paragraph 9, dealing with requests for copies of files, has been revised to call attention to the fact that an order will be entered in the file notifying counsel that their requests for files have been forwarded to the Office of Public

Records. The revision makes explicit in Paragraph 9 a practice of the Trial Section adopted after issuance of DECLARE4.

Paragraph 9 also notifies parties that failure to timely order a copy of a file will not be considered a basis upon which an extension of time to take action may be based.

The order currently entered by the Trial Section upon transmittal of files to the Office of Public Records provides as follows:

ORDER
**(Notifying parties that request for copy of files
has been sent to the PTO Office of Public Records)**

Upon consideration of the receipt of requests for files (see Paragraph 9 of the NOTICE DECLARING INTERFERENCE), it is

ORDERED that the parties are notified that the requests together with the files have been forwarded to the Office of Public Records of the Patent and Trademark Office.

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. If a party does not receive files within the eighteen (18) day period and fails to notify the Trial Section of non-receipt of files, no extension of time (37 CFR § 1.645(a)) will be granted based on non-receipt of files and times for taking further action in the interference will not be delayed due to non-receipt of files.

4. Paragraph 15, dealing with copies of precedent relied upon, has been revised to require submission of copies of certain precedent and to request submission of other precedent. The rationale for the requirement and request are set out in footnote 9.

5. Paragraph 17, dealing with conference calls to set dates, makes explicit the fact that the documents required by the second paragraph must be served. The experience of the Trial Section has been that submission of lists of proposed preliminary motions significantly reduces the amount of work for counsel and the board in the preliminary motion phase.

6. Paragraph 21, dealing with applications and patents with drawings, has been revised (see footnote 15) to make clear certain instances in which a party need not file a paper pursuant to Paragraph 21. Where the drawing is nothing more than a graph or a table, and where it would not make sense to read the drawing on the claimed invention, a party need not comply with that part of Paragraph 21 which requires clean copies of claims with reference to drawing numerals.

7. Paragraph 26, dealing with the manner of presenting motions, opposition and replies, has been revised to include headings. In addition, footnote 23 calls attention to the fact that a statement of facts should be complete.

Subparagraph (f) is new and requires that a request to take testimony in support of a preliminary motion must be made in a Rule 635 motion separate from the preliminary motion itself. In addition, the motion may be filed before a preliminary motion is filed.

Subparagraph (g) is new and makes the provisions of Paragraph 32 of the NOTICE DECLARING INTERFERENCE applicable any preliminary motion seeking judgment based on inequitable conduct.

Subparagraph (h) is new and makes clear that a motion to change inventorship (37 CFR § 1.634) may be filed at any time. Appropriate steps will be taken to avoid prejudice to an opponent where the motion is filed late in the proceedings. For example, if the motion is filed after the time for cross-examination of a party's priority case has passed and it would be fair to reopen cross-examination in light of the motion,

additional time may be set for an opponent to take cross-examination.

8. Paragraph 36, dealing with cross-examination, in the second paragraph provides that cross-examination will take place in the U.S. at a reasonable location and if the parties cannot agree on a reasonable location, a conference call shall be placed to the administrative patent judge. What constitutes a reasonable place for taking cross-examination is a matter which is to be decided on a case-by-case basis.

9. Paragraph 39, dealing with manner of labelling exhibits, has been changed to provide that the exhibit numbers of the senior party will begin with 5001. The juniormost party will continue to label exhibits beginning with Exhibit 1001. Exhibit numbers in the 2000, 3000 and 4000 series are reserved for those interferences where there are more than two parties.

10. Paragraph 45, dealing with requirements for settlement negotiations, in footnote 31 permits the parties to agree to allow the junior party to assume obligations initially placed on the senior party with respect to settlement matters.

11. Paragraph 48 is new and contains a list of papers which need not be filed when served on an opponent.

12. Paragraph 49 is new and calls attention to where counsel may find binding precedent of the Trial Section.

II.

ORDER--FILING OF PRELIMINARY MOTIONS AND STATEMENTS (ORDERPM4 which replaces ORDERPM3)

The following language has been added in Part C(1) dealing with Time Period 1 for filing preliminary motions:

If no party files a preliminary motion, the parties should place a conference call to the administrative patent judge so that a time for taking testimony or other appropriate action may be set.

Attention is directed to Paragraph 26(f) of the NOTICE DECLARING INTERFERENCE (Paper 1) if a request is made for leave to take testimony to support a preliminary motion. Attention is directed to Paragraph 26(g) of the NOTICE DECLARING INTERFERENCE (Paper 1) with respect to any

preliminary motion for judgment (37 CFR § 1.633(a)) based on inequitable conduct and/or fraud.

III.

ORDER--TESTIMONY AND FILING OF THE RECORD
and BRIEFING SCHEDULE
(ORDERTE4 which replaces ORDERTE3)

There are no significant changes.