

Interference Rules

(118) Interference Practice - Interference Rules
Which Require a Party to
"Show the Patentability" of a Claim

Certain preliminary motions require a party in an interference to "show the patentability" of claims. For example, a preliminary motion under 37 CFR 1.633(c)(2) to amend or add a claim to an application involved in an interference, requires the moving party to:

Show the patentability to the applicant of each claim proposed to be amended or added and apply the terms of the claim proposed to be amended or added to the disclosure of the application***.

37 CFR 1,637(c)(2)(iii). Similar requirements appear in

(1) 37 CFR 1,637(c)(1)(ii) [preliminary motion to add or substitute a count];

(2) 37 CFR 1,637(c)(1)(iii) [preliminary motion to add or substitute a count];

(3) 37 CFR 1.637(c)(5)(ii) [preliminary motion to have an opponent add a claim to its application];

(4) 37 CFR 1.637(d)(3) [preliminary motion to substitute a party's different application];

(5) 37 CFR 1.637(e)(1)(iv) [preliminary motion to declare an additional interference];

(6) 37 CFR 1.637(e)(1)(v) [preliminary motion to declare an additional interference];

(7) 37 CFR 1,637(e)(2)(iii) [preliminary motion to declare an additional interference];

(8) 37 CFR 1.637(e)(2)(iv) [preliminary motion to declare an additional interference]; and

(9) 37 CFR 1.637(h)(3) [preliminary motion to add reissue application to interference].

The requirement of the rules that a party "show the patentability" of a claim may have led to some confusion as to precisely what is required to comply with the rules. This notice provides guidance with respect to the requirement to "show the patentability."

The requirement that a party "show the patentability" of a claim should not be construed as requiring a party to prove a negative, i.e., that there is no prior art which would anticipate the claim under 35 U.S.C. 102 or render the claim unpatentable under 35 U.S.C. 103. In this respect, the burden of establishing that a claim is not patentable generally falls on the party or individual alleging unpatentability. See, e.g., 35 U.S.C. 102 which provides that an applicant is "entitled to a patent unless ***." See also, *Horton v. Stevens*, 7 USPQ2d 1245, 1246-47 (Bd. Pat. App. & Int. 1988). Consistent with 37 CFR 1,601, which provides that the rules should be construed to secure the just, speedy and inexpensive determination of interferences, the rules requiring a party to "show the patentability" of a claim normally should be interpreted as requiring that a party establish that the subject matter of the claim is described in the specification in the manner required by the first paragraph of 35 U.S.C.

112. See also 37 CFR 1.75(d)(1). The requirement can most effectively be met by reproducing the claim, and following each element recited in the claim, and within braces { } and in bold, inserting a specific reference to the column and line and/or drawing figure and numeral where the element is described in the specification.

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An exception would be a situation where a party files a preliminary motion under 37 CFR 1.633(i) in response to an opponent's preliminary motion under 37 CFR 1.633(a) for judgment. Since the party knows the basis for the opponent's preliminary motion for judgment, the party should also "show the patentability" of the claims proposed to be added by the preliminary motion under 37 CFR 1.633(i) vis-a-vis the opponent's basis in the preliminary motion under 37 CFR 1.633(a). Compare 37 CFR 1.111(c) and 1.119.

The precise basis upon which a party is required to "show the patentability" necessarily will vary on a case-by-case basis.

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