

*United States Patent and Trademark Office
Board of Patent Appeals and Interferences
Trial Section*

CONTESTED CASE PRACTICE GUIDE



Selected General Board Rules
Contested Case Rules
Patent Interference Rules
Standing Order
Practice Notes
Forms
Cross Examination Guidelines
Index of Times

5 November 2004
Alexandria, Virginia

Amendments and revisions contained in this edition

- The Standing Order has been comprehensively revised in view of the new rules published at 69 Fed. Reg. 49960 (12 August 2004), 1286 Official Gaz. 21 (USPTO 7 September 2004), as amended at 69 Fed. Reg. 58260 (30 September 2004).
- Gary V. Harkcom has (in an acting capacity) replaced Bruce H. Stoner, Jr., as the Chief Administrative Patent Judge.
- Standing Order ¶ 4 provides the Alexandria, Virginia address and the telephone and facsimile numbers.
- Standing Order ¶ 3.2 provides additional guidance on the requirements for the notice of related proceedings.
- Tables of content and authority are added to the list of exemptions from page limits in Standing Order ¶¶ 13.2 and 14.2.

**United States Patent and Trademark Office
Board of Patent Appeals and Interferences**

Chief Administrative Patent Judge

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Vice Chief Administrative Patent Judge

Gary V. Harkcom

Trial Section

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FOREWORD

Preface

This Standing Order governs contested cases assigned to the Trial Section of the Board of Patent Appeals and Interferences. Parties are expected to be familiar with it. The rules reproduced in this Order are current as of the issue date of the Order, but are subject to change. In the event of a change to a rule, the changed rule will control, this order notwithstanding.

Board Rules

Board Rules are found in 37 C.F.R. part 41. A section may be cited as Bd. R. x in lieu of 37 C.F.R. § 41.x. For example, § 41.1 may be cited as Bd. R. 1.

Standing Order

The Standing Order is set forth in shaded boxes, presented in parallel with the Board Rules and numbered in paragraphs. The Standing Order may be cited as SO ¶ x.

Practice Notes

Practice Notes are set forth in ruled boxes. The notes are advisory rather than binding.

Appendix of forms

Forms used in contested cases are presented in appendices to this Standing Order. The forms include the standard caption for papers, the caption for exhibits, the file order form, a preliminary motions schedule, and a priority motions schedule.

Appendix: Cross examination guidelines

Guidelines for use in all cross examinations in the contested case as required in the Standing Order.

Inquiries

Telephone inquiries about this Standing Order or the rules may be directed to a paralegal assistant in the Trial Section, 571-272-9797. A telephone inquiry to staff is not a proper method for seeking a modification of a rule or an order.

PART 41--PRACTICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Subpart A--General Provisions

§ 41.1 Policy.

(a) *Scope.* Part 41 governs proceedings before the Board of Patent Appeals and Interferences. Sections 1.1 to 1.36 and 1.181 to 1.183 of this title also apply to practice before the Board, as do other sections of part 1 of this title that are incorporated by reference into part 41.

(b) *Construction.* The provisions of Part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board.

(c) *Decorum.* Each party must act with courtesy and decorum in all proceedings before the Board, including interactions with other parties.

§ 41.2 Definitions.

Unless otherwise clear from the context, the following definitions apply to proceedings under this part:

Affidavit means affidavit, declaration under § 1.68 of this title, or statutory declaration under 28 U.S.C. 1746. A transcript of an ex parte deposition may be used as an affidavit in a contested case.

Board means the Board of Patent Appeals and Interferences and includes:

(1) For a final Board action:

(i) In an appeal or contested case, a panel of the Board.

(ii) In a proceeding under § 41.3, the Chief Administrative Patent Judge or another official acting under an express delegation from the Chief Administrative Patent Judge.

(2) For non-final actions, a Board member or employee acting with the authority of the Board.

Board member means the Under Secretary of Commerce for Intellectual

STANDING ORDER

This Order is promulgated by and for the Trial Section under Bd. R. 104 for use in contested cases.

Subpart A

Property and Director of the United States Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.

Contested case means a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an inter partes reexamination is not a contested case.

Final means, with regard to a Board action, final for the purposes of judicial review. A decision is final only if:

(1) *In a panel proceeding*. The decision is rendered by a panel, disposes of all issues with regard to the party seeking judicial review, and does not indicate that further action is required; and

(2) *In other proceedings*. The decision disposes of all issues or the decision states it is final.

Hearing means consideration of the issues of record. *Rehearing* means reconsideration.

Office means United States Patent and Trademark Office.

Panel means at least three Board members acting in a panel proceeding.

Panel proceeding means a proceeding in which final action is reserved by statute to at least three Board members, but includes a non-final portion of such a proceeding whether administered by a panel or not.

Party, in this part, means any entity participating in a Board proceeding, other than officers and employees of the Office, including:

- (1) an appellant;
- (2) a participant in a contested case;
- (3) a petitioner; and
- (4) counsel for any of the above, where context permits.

Practice Notes

Trial Section. The Chief Administrative Patent Judge has designated a subset of Board personnel, identified as the Trial Section, to administer most contested cases. Decisions in contested cases may be entered by a panel of any Board members.

Action by Board staff. Board staff other than administrative patent judges may administer some tasks during contested cases. For instance, Trial Section paralegal assistants authorize access to files under Bd. R. 109 or authorize the filing of facsimile transmissions in excess of the five pages permitted under SO ¶ 4.5 of this Order. Such actions are controlling unless countermanded by an administrative patent judge or a panel of Board members.

§ 41.3 Petitions.

(a) *Deciding official.* Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope.* This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

- (1) Issues committed by statute to a panel, and
- (2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

* * * * *

Practice Notes

Petitions are rare in pending contested cases. Once a contested case is initiated, most issues in a pending contested case are reserved to the Board. 35 U.S.C. 6(b). A request for a procedural remedy should be made in the form of a miscellaneous motion. Bd. R. 121(a)(3). Occasionally, a petition may be appropriate, as when the remedy sought is waiver of a rule that cannot be waived under Bd. R. 104(b). An administrative patent judge or a Board panel must certify a petition for consideration before it will be decided. Bd. R. 3(a). Petitions based on 35 U.S.C. 135(c) are not part of the contested case and

Subpart A

Practice Notes - continued

should be filed directly with the Chief Administrative Patent Judge. Bd. R. 3(b) and Bd. R. 205.

No fee. There is no fee for filing a miscellaneous motion. No fee is required for a question that is certified to the Chief Administrative Patent Judge for decision.

§ 41.4 Timeliness.

(a) *Extensions of time.* Extensions of time will be granted only on a showing of good cause except as otherwise provided by rule.

(b) * * *.

(c) *Scope.* This section governs all proceedings before the Board, but does not apply to filings related to Board proceedings before or after the Board has jurisdiction, such as:

(1) Extensions during prosecution (see § 1.136 of this title),

(2) * * *, or

(3) Seeking judicial review (see §§ 1.301 to 1.304 of this title).

Practice Note

Good cause requirement. A request for an extension of time under Bd. R. 4(a) requires a showing of good cause. Whatever a party's experience may have been in other proceedings, in contemporary practice in contested cases before the Board the standard for showing good cause under Bd. R. 4(a) is high. Times are set to facilitate the rendering of timely decisions. There are few, if any, circumstances where good cause can be based on the press of other business arising after a time is set by a Board order, particularly where a time period is set or maintained after a conference with counsel.

Settlement. An attempt to settle will rarely constitute good cause. Settlement is encouraged, and the administrative patent judge designated to handle a contested case is available to assist in settlement efforts where appropriate, but parties should expect either to settle the contested case or, in the absence of settlement, to meet the deadline.

§ 41.5 Counsel.

While the Board has jurisdiction:

(a) *Appearance pro hac vice.* The

Board may authorize a person other than a registered practitioner to appear as counsel in a specific proceeding.

(b) *Disqualification.* (1) The Board may disqualify counsel in a specific proceeding after notice and an opportunity to be heard.

(2) A decision to disqualify is not final for the purposes of judicial review until certified by the Chief Administrative Patent Judge.

(c) *Withdrawal.* Counsel may not withdraw from a proceeding before the Board unless the Board authorizes such withdrawal. See § 10.40 of this title regarding conditions for withdrawal.

(d) *Procedure.* The Board may institute a proceeding under this section on its own or a party in a contested case may request relief under this section.

(e) *Referral to the Director of Enrollment and Discipline.* Possible violations of the disciplinary rules in part 10 of this title may be referred to the Office of Enrollment and Discipline for investigation. See §10.131 of this title.

Practice Note

Pro hac vice. Contested cases can be technically, legally, and procedurally complex. Consequently, a motion to appear pro hac vice will rarely be granted unless the counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the contested case.

§ 41.6 Public availability of Board records.

(a) *Publication*—(1) *Generally.* Any Board action is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § 1.11 of this title or in an application that has been published in accordance with §§ 1.211 to 1.221 of this title. The Office may independently publish any Board action that is available for public inspection.

¶ 1 Notice of confidential information

Some opinions are selected for publication to promote public understanding of Trial Section practice or to create uniform practices. If a party believes that its application contains information not otherwise publicly available that should be redacted from any opinion, the party must **within two (2) months** of the initiation of the contested case file as a separate paper a notice specifically identifying such information.

Subpart A

(2) *Determination of special circumstances.* Any Board action not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not, within two months after being notified of the intention to make the action public, object in writing on the ground that the action discloses the objecting party's trade secret or other confidential information and states with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from the public to protect such information, the party must explain why. The party will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of the action is made public over its objection.

(b) *Record of proceeding.*

(1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § 1.11 of this title or an involved application is or becomes published under §§ 1.211 to 1.221 of this title.

If additional information not otherwise publicly available is introduced into a contested case that a party believes should be redacted from any opinion, the party must promptly file a notice specifically identifying the information.

If, after filing such notice, specifically identified information becomes publicly available (for example, through publication of a collateral application), the party shall promptly notify the Board of this change in the status of the information.

Practice Note

Streamlining publication of opinions. Under Bd. R. 6(a)(1), most opinions in

Practice Note - continued

contested cases will be available for publication during the proceeding and virtually all become available at the end of the proceeding under Bd. R. 6(b). The recent experience in interferences is that redactions are rarely requested. Consequently, to streamline publication, SO ¶ 1 requires any party wishing to preserve confidential information to notify the Trial Section of that wish in advance.

§ 41.7 Management of the record.

(a) The Board may expunge any paper directed to a Board proceeding, or filed while an application or patent is under the jurisdiction of the Board, that is not authorized under this part or in a Board order, or that is filed contrary to a Board order.

(b) A party may not file a paper previously filed in the same Board proceeding, not even as an exhibit or appendix, without Board authorization or as required by rule.

¶ 2 Record management

¶ 2.1 Letters between counsel not to be filed

No letter between counsel may be filed unless it is filed as an exhibit cited in a motion, opposition, or reply, or during cross-examination.

¶ 2.2 No duplicate papers

A party may not file (not even as an appendix or exhibit) a copy of a paper previously filed in the same contested case.

Practice Note

Unnecessary papers. Filing unnecessary papers unduly burdens both the Board and one's opponent. The Board has limited storage space and the Office must maintain public records for considerable periods of time at a cost that is ultimately borne by patent applicants and patentees. A party referring to an earlier filed paper should identify the paper by title and paper number or, if the paper number is not known, by the filing date.

§ 41.8 Mandatory notices.

(a) [A]t the initiation of a contested case (§ 41.101), and within 20 days of any change during the proceeding, a party must identify:

- (1) Its real party-in-interest, and
- (2) Each judicial or administrative proceeding that could affect, or be affected by, the Board proceeding.

(b) For contested cases, a party seeking judicial review of a Board proceeding must file a notice with the Board of the judicial review within 20 days

¶ 3 Mandatory notices

¶ 3.1 Real party-in-interest

Within **fourteen (14) days** of the date of the Declaration, each party must file as a separate paper a notice of any and all right, title, or interest in any application or patent involved in the contested case.

¶ 3.2 Related proceedings

Within **fourteen (14) days** of the initiation of a contested case, each party must file and serve as a separate paper a notice identifying the application or patent number of every United States application

Subpart A

of the filing of the complaint or the notice of appeal. The notice to the Board must include a copy of the complaint or notice of appeal. See also §§ 1.301 to 1.304 of this title.

or patent claiming, or which may claim, the benefit of priority of the filing date of the party's involved patent or application. If there are no such applications or patents the notice must state this fact. If, during the course of the proceeding, a party files an application claiming, or which may claim, the benefit of the filing date of an involved application or patent, a notice of the filing, including the application number, must be promptly served and filed.

Practice Notes

Related cases. The Board may order a party to serve a copy of any application or patent identified under SO ¶ 3.2 on their opponent.

Notice of judicial review. After a contested case ends, administrative tasks remain for the Office generally and for the Board particularly. Files need to be distributed, applications need to be allowed or abandoned, and notices of patent claim cancellation need to be published. Moreover, the time for filing a settlement agreement under 35 U.S.C. 135(c) has been defined in Bd. R. 205(a) to include the period of judicial review. If the Board does not receive effective notice that a judgment is undergoing judicial review, it proceeds on the assumption that no review has been sought. While notice of appeals to the United States Court of Appeals for the Federal Circuit [Federal Circuit] have generally been effective, notices of suit under 35 U.S.C. 146 have generally not been effective. One consequence is that litigants are surprised to receive notices of abandonment or the like. At best, this leaves the litigant with a problem to correct. If it appears deliberate misconduct was involved, additional sanctions are possible under Bd. R. 128.

§ 41.9 Action by owner.

(a) *Entire interest.* An owner of the entire interest in an application or patent involved in a Board proceeding may act in the proceeding to the exclusion of the inventor (see § 3.73(b) of this title).

(b) *Part interest.* An owner of a part interest in an application or patent involved in a Board proceeding may petition to act in the proceeding to the exclusion of an inventor or a co-owner. The petition must show the inability or refusal of an inventor or co-owner to

prosecute the proceeding or other cause why it is in the interest of justice to permit the owner of a part interest to act in the proceeding. An order granting the petition may set conditions on the actions of the parties during the proceeding.

§ 41.10 Correspondence addresses.

Except as the Board may otherwise direct,

* * * * *

(b) *Contested cases.* Mailed correspondence in contested cases (subpart D of this part) shall be sent to Mail Stop INTERFERENCE, Board of Patent Appeals and Interferences, United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450.

¶ 4 Communications with the Board

¶ 4.1 Default mode

Mail is the default mode of communication.

¶ 4.2 Filing by hand

Hand delivery to the Board must occur between the hours of 8:30 a.m. and 5:00 p.m at:

Madison Building East, 9th Floor
600 Dulany Street
Alexandria, Virginia 22313

Any paper hand-delivered directly to the Board before 10:00 a.m. is deemed to have been filed the previous business day provided the paper was properly served the previous business day.

¶ 4.3 Overnight delivery services

Papers filed using an overnight delivery service must be addressed:

Board of Patent Appeals and Interferences
Madison Building East, 9th Floor
600 Dulany Street
Alexandria, Virginia 22313

Properly addressed papers filed are deemed filed on the date they are delivered to the overnight delivery service.

¶ 4.4 Telephone calls

Telephone calls to the Board regarding a contested case must be placed to 571-272-9797. A telephone call requesting a conference call must be directed to Trial Section support staff.

¶ 4.5 Facsimile

The facsimile number for contested cases is 571-273-0042. Do not send papers exceeding five (5) pages in length without prior permission from Trial Section

Subpart A

support staff.

Practice Notes

Ex parte communications. All communications with the Board regarding a contested case must include all parties to the contested case. For further information, see Bd. R. 11 and the associated practice notes.

Hand delivery. Hand delivery directly to the Board as provided in SO ¶ 4.2 is encouraged where practicable because it reduces the time (1) to process a paper and (2) to decide any request made in the paper. The ability to deliver a paper directly to the Board by 10:00 a.m. should eliminate any need to hand-deliver papers to the United States Patent and Trademark Office (Office) Mail Room after business hours.

Telephone. Calls about contested cases directed to Board staff outside the Trial Section are unduly burdensome for such staff and may result in inaccurate advice.

Arranging a conference call. When arranging a conference call, be prepared to discuss with a Trial Section paralegal why the call is needed and what materials should be before the Board participant during the call.

Facsimile. When filing by facsimile, do not file a confirmation copy because such copies tend to lead to duplicate entries (in violation of Bd. R. 7(b)) among other problems.

§ 41.11 Ex parte communications in inter partes proceedings.

An ex parte communication . . . about a contested case (subparts D and E of this part) with a Board member, or with a Board employee assigned to the proceeding, is not permitted.

Practice Notes

Papers. Papers should not result in an ex parte communication if they have been properly served.

Other forms of communication. Improper communications typically arise in telephone calls, electronic mail messages, or meetings. Telephone calls should be conference calls with the opposing party included. Electronic mail messages, when authorized, should include the opposing party in the "To" line or the "Cc" line. Discussion of pending contested cases should not occur at

Practice Notes - continued

meetings.

Permissible contacts. Contacts (1) of a ministerial nature directed to support staff, (2) of a general nature directed to Board management, or (3) under a rule requiring reference to a different contested case are not *ex parte* communications, provided the contact does not involve the merits of the contested case. A call to a Trial Section paralegal to arrange a telephone conference is a typical example of a ministerial contact with support staff. A general comment, made apart from a particular contested case, on a Board rule with examples drawn from actual experiences is an example of the second kind of permissible contact. Identification of a related case pursuant to Bd. R. 8(b) is an example of the third kind of contact.

Refusal to participate. The Board has the discretion to permit a hearing or conference call to take place even if a party refuses to participate. In such instances, the Board may require additional safeguards, such as the recording of the communication and the entry of the recording into the record.

§ 41.12 Citation of authority.

(a) Citations to authority must include:

(1) *For any United States Supreme Court decision*, a United States Reports citation.

(2) *For any decision other than a United States Supreme Court decision*, parallel citation to both the West Reporter System and to the United States Patents Quarterly whenever the case is published in both. Other parallel citations are discouraged.

(3) *Pinpoint citations* whenever a specific holding or portion of an authority is invoked.

(b) Non-binding authority should be used sparingly. If the authority is not an authority of the Office and is not reproduced in one of the reporters listed in paragraph (a) of this section, a copy of the authority should be filed with the first paper in which it is cited.

¶ 5 Copies of authority cited

If a party files a paper citing an authority that is not reported in (1) United States Reports or West Publishing Company's Supreme Court Reporter, (2) the second or third series of West's Federal Reports, or (3) the first or second series of the Bureau of National Affairs' United States Patents Quarterly, then the party must file and serve a copy of the authority.

Subpart A

Practice Notes

Examples of proper parallel citation.

Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977).
In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

Binding authority. Binding precedent is the following:

- Decisions of the United States Supreme Court.
 - Decisions of the Federal Circuit, the former Court of Customs and Patent Appeals [CCPA] and the former Court of Claims announced before the close of business on 30 September 1982. *South Corp. v. United States*, 690 F.2d 1368, 1370-71, 215 USPQ 657, 657-58 (Fed. Cir. 1982) (en banc), and *In re Gosteli*, 872 F.2d 1008, 1011, 10 USPQ2d 1614, 1616-17 (Fed. Cir. 1989) (where there is a conflict between two or more decisions of the former CCPA, the later CCPA decision controls).
 - Decisions of the Director of the United States Patent and Trademark Office (formerly the Commissioner of Patents and Trademarks).
 - Decisions of the Board of Patent Appeals and Interferences that have been determined to be binding precedent in accordance with established Board procedures. *Reitz v. Inoue*, 39 USPQ2d 1838 (BPAI 1995).
 - Trial Section decisions that have been designated as precedential.
- Decisions of the regional courts of appeals and the district courts may be cited, but are not binding precedent. Non-precedential decisions of the Board may be cited, but are not binding.

Trial Section opinions. Trial Section binding precedents and other selected Trial Section opinions are available through the internet at:

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

Less commonly cited authorities. Occasionally it is necessary to cite an authority not reported in the Supreme Court Reporter, the Federal Reports, or the USPQ. A party should not assume that its opponent or the Board has access to such authorities.

Cite only primary authority. Primary authority includes: (1) the United States Code, (2) the Code of Federal Regulations, (3) notices published in the Federal Register or the Official Gazette, and (4) binding precedent. The Manual of Patent Examining Procedure, a guide for patent examiners prepared by the Office of the Commissioner for Patents, is not itself primary authority except of patent examining practices.

§ 41.20 Fees.

* * * * *

Subpart D--Contested Cases

§ 41.100 Definitions.

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart:

Business day means a day other than a Saturday, Sunday, or Federal holiday within the District of Columbia.

Involved means the Board has declared the patent application, patent, or claim so described to be a subject of the contested case.

§ 41.101 Notice of proceeding.

(a) Notice of a contested case will be sent to every party to the proceeding. The entry of the notice initiates the proceeding.

(b) When the Board is unable to provide actual notice of a contested case on a party through the correspondence address of record for the party, the Board may authorize other modes of notice, including:

(1) Sending notice to another address associated with the party, or

(2) Publishing the notice in the Official Gazette of the United States Patent and Trademark Office.

Practice Notes

Declaration. The notice initiating a contested case is called a Declaration. Cf. 35 U.S.C. 135(a) ("an interference may be declared").

Maintaining a proper address. While the Board is authorized to provide notice by means other than mailing to the correspondence address of record, it is ultimately the responsibility of the application or patent owner to maintain a proper correspondence address. *Ray v. Lehman*, 55 F.3d 606, 610, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).

Subpart D

§ 41.102 Completion of examination.

Except as the Board may otherwise authorize, before a contested case is initiated, for each involved application and patent, subject to judgment in the contested case:

(a) Examination or reexamination must

be completed, and

(b) There must be at least one claim that:

(1) Is patentable, and

(2) Would be involved in the contested case.

§ 41.103 Jurisdiction over involved files.

The Board has jurisdiction over any involved file from the time the Board initiates a contested case until the termination of the contested case. Other proceedings for the involved file within the Office are suspended except as the Board may order.

§ 41.104 Conduct of contested case.

(a) The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.

(b) An administrative patent judge may waive or suspend in a proceeding the application of any rule in this subpart, subject to such conditions as the administrative patent judge may impose.

(c) Times set in this subpart are defaults. In the event of a conflict between a time set by rule and a time set by order, the time set by order is controlling. Action due on a day other than a business day may be completed on the next business day unless the Board expressly states otherwise.

¶ 6 Modification of the Standing Order

An administrative patent judge may modify the terms of this Order.

Practice Notes

Setting dates and times. Dates for action may be set after a conference call.

Times for motions phases. The Board generally initiates a conference call to set times for the motion periods. A date and time for the conference call typically appears in Part D of the Declaration. A list of proposed motions must typically be filed no later than **two business days** prior to the conference call to set dates. This requirement improves the administration of justice by (1) helping the Board and counsel arrive at an appropriate schedule for taking action, (2) permitting the Board to determine whether the listed motions are both necessary and sufficient to resolve the issues raised, and (3) revealing the possibility that there may be a dispositive motion. A party may be permitted to file an unlisted motion, but the set times are not likely to be changed to accommodate the unlisted motion.

A copy of standard orders setting times for the preliminary motion and priority motion phases of an interference are reproduced in the Appendix of Forms. Counsel should discuss the appropriate order prior to the conference call and to come to an agreement on dates for taking action.

Additional discovery. If additional discovery will be needed to support a proposed motion, the movant should include a miscellaneous motion for such discovery in the list of proposed motions. Bd. R. 121(a)(3).

§ 41.106 Filing and service.

(a) *General format requirements.*

(1) The paper used for filings must be durable and white. A party must choose to file on either A4-sized paper or 8½ inch × 11 inch paper except in the case of exhibits that require a larger size in order to preserve details of the original. A party may not switch between paper sizes in a single proceeding. Only one side of the paper may be used.

(2) In papers, including affidavits, created for the proceeding:

(i) The ink must be black or must otherwise provide an equivalently permanent, dark, high-contrast image on the paper. The quality of the printing must be equivalent to the quality produced by a laser printer. Either a proportional or monospaced font may be used, but the proportional font must be 12-point or larger and a monospaced font must not

¶ 7 Paper format

¶ 7.1 Footnotes

The use of footnotes is discouraged. Footnotes must be double-spaced.

¶ 7.2 Cover sheet for papers other than exhibits

¶ 7.2.1 Caption

The heading shown in Part G of the Declaration shall be used in all papers other than exhibits. Form 1 in the Appendix of Forms shows a standard caption for an interference.

¶ 7.2.2 Style

The style of each paper must appear on a single line and must not use the words "et al". Styles for papers other than motions, oppositions, and replies should be simple and descriptive.

¶ 7.2.3 Color of cover sheet

The first page of all papers filed in an contested case must be **pink** similar to the pink first page of the Declaration.

Subpart D

contain more than 4 characters per centimeter (10 characters per inch). Case names must be underlined or italicized.

(ii) Double spacing must be used except in headings, tables of contents, tables of authorities, indices, signature blocks, and certificates of service. Block quotations may be single-spaced and must be indented. Margins must be at least 2.5 centimeters (1 inch) on all sides.

(b) *Papers other than exhibits*—(1) *Cover sheet* (i) The cover sheet must include the caption the Board specifies for the proceeding, a header indicating the party and contact information for the party, and a title indicating the sequence and subject of the paper. For example, "JONES MOTION 2, For benefit of an earlier application".

(ii) If the Board specifies a color other than white for the cover sheet, the cover sheet must be that color.

(2) Papers must have two 0.5 cm ($\frac{1}{4}$ inch) holes with centers 1 cm ($\frac{1}{2}$ inch) from the top of the page and 7 cm ($2\frac{3}{4}$ inch) apart, centered horizontally on the page.

(3) *Incorporation by reference; combined papers*. Arguments must not be incorporated by reference from one paper into another paper. Combined motions, oppositions, replies, or other combined papers are not permitted.

(4) *Exhibits*. Additional requirements for exhibits appear in § 41.154(c).

(c) *Working copy*. Every paper filed must be accompanied by a working copy marked "APJ Copy".

(d) *Specific filing forms*—(1) *Filing by mail*. A paper filed using the EXPRESS MAIL® service of the United States Postal Service will be deemed to be filed as of "date-in" on the EXPRESS MAIL® mailing label; otherwise, mail will be deemed to be filed as of the stamped date of receipt at the Board.

(2) *Other modes of filing*. The Board may authorize other modes of filing, including electronic filing and hand filing,

¶ 7.3 Combined oppositions and replies not to be filed

An opposition shall respond to only a single motion and a reply shall respond to only a single opposition.

¶ 7.4 Copy for the administrative patent judge

A party must file (1) an original and (2) a copy of each paper filed. The copy shall be marked at the top:

APJ COPY

¶ 8 Papers in electronic form

¶ 8.1 Only a copy of a paper may be filed in electronic form

Parties may file a copy of a paper in electronic form. (A facsimile is not a paper in electronic form.) The required number of paper copies must also be filed with the Board and served on all opponents.

¶ 8.2 Format

The Board can accept electronic copies in the following PC-compatible media:

- A compact disc,
- $3\frac{1}{4}$ inch diskette,
- A 100 MB Zip® disk, or
- A 2 GB Jaz® disk.

The electronic copy must be capable of:

- (a) Operating on a computer running WINDOWS XP.
- (b) Displaying on a monitor set to display at 256 colors on an 800 x 600 pixel screen setting.
- (c) Opening and being word searched in ADOBE ACROBAT READER, WORDPERFECT 9, or MICROSOFT WORD 2000.

Parties use other formats at their own risk.

The file name of each electronic document must concisely identify the content of the document (e.g., Jones PM1.wpd, Smith Opp1.doc; Ex1038.pdf). If a hearing is requested, four copies of the electronic media should be filed with the Board and one copy served on each opponent.

and may set conditions for the use of such other modes.

(e) *Service*. (1) Papers filed with the Board, if not previously served, must be served simultaneously on every opposing party except as the Board expressly directs.

(2) If a party is represented by counsel, service must be on counsel.

(3) Service must be by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®. Electronic service is not permitted without Board authorization.

(4) The date of service does not count in computing the time for responding.

(f) *Certificate of service*.

(1) Papers other than exhibits must include a certificate of service as a separate page at the end of each paper that must be served on an opposing party.

(2) Exhibits must be accompanied by a certificate of service, but a single certificate may accompany any group of exhibits submitted together.

(3) A certificate of service must state:

- (i) the date and manner of service,
- (ii) the name and address of every

person served, and

(iii) for exhibits filed as a group, the name and number of each exhibit served.

(4) A certificate made by a person other than a registered patent practitioner must be in the form of an affidavit.

¶ 9 Service

¶ 9.1 Alternatives to EXPRESS MAIL®

Any other mode of service that accomplishes a same-day or overnight delivery of the paper (e.g., by hand, facsimile, or a commercial overnight delivery service) may be substituted for EXPRESS MAIL® service.

¶ 9.2 Papers served but not filed

The following papers must be served on an opponent, but should not be filed with the Board at the time of service:

- (a) An objection to the admissibility of evidence.
- (b) A notice requesting cross-examination.
- (c) Automatic discovery pursuant to Bd. R. 150(b)(1).

Such papers may be filed later as an exhibit if a dispute arises with respect to the paper served.

¶ 9.3 Transmittal sheets

Do not file a transmittal sheet listing papers being filed except an exhibit list may be filed when more than one exhibit is being filed.

Practice Notes

8½" x 11" paper preferred. The Board's facilities for creating and maintaining administrative records are designed to work best with 8½" x 11" paper. Occasionally an exhibit must be reproduced on a larger paper size to preserve detail. In such instances, a larger paper format is permitted, but the paper should be folded to permit entry as a 8½" x 11" paper.

Two holes at top of paper. Two holes punched at the top of each paper are required to aid entry of papers in files and to reduce the risk that a page will be inadvertently separated or misplaced.

Subpart D

Practice Notes - continued

Standardized captions and styles. The use of standard captions and paper styles is necessary for efficient processing of papers at the Board and for effective communications with the parties. Examples for papers other than motions, oppositions and replies include:

- JONES DESIGNATION OF LEAD ATTORNEY
- SMITH DESIGNATION OF REAL PARTY IN INTEREST
- JONES REQUEST FOR FILE COPIES
- SMITH PRELIMINARY STATEMENT
- JONES SERVICE OF REFERENCES
- SMITH CLEAN COPY OF CLAIMS
(with drawing numerals)
- SMITH CLEAN COPY OF CLAIMS
(means-plus-function annotation)

Incorporation by reference and combined papers are prohibited to reduce the chance risk of overlooking an argument and to improve the efficiency of decision making. Incorporation of arguments by reference amounts to a self-help increase in the length of the brief and a pointless imposition on the Board's time. A motion must make all arguments accessible to readers, rather than ask them to play archaeologist with the record. *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir 1999).

Papers appropriate for electronic filing. The Trial Section encourages the filing of text-searchable electronic copies of specifications; claims; any motion, opposition or reply; affidavit testimony; any exhibit; and any transcript of a cross-examination deposition.

Requirement for EXPRESS MAIL® service. Ordinary postal service inherently produces variable delivery times. Use of EXPRESS MAIL® reduces the variability and thus places all parties on a level playing field. Alternative modes of service that are at least as fast and reliable as EXPRESS MAIL® achieve the same end. To be an effective substitute, the opponent must be able (e.g., have the necessary equipment) to receive service in the alternative mode. That ability should be determined before service is due.

Papers served but not filed. An objection to the admissibility of evidence should only be filed as an attachment to a motion to exclude. Bd. R. 155(c).

Certificate of service. Each paper (other than an exhibit) has a separate certificate of service, incorporated as the last page of the paper, to make it easier for the Board to verify that each paper has been served. The certificate can also provide notice to the opponent that the paper has been filed.

Transmittal sheets. Additional papers itemizing the papers filed complicate the entry of papers into files. A party may, of course, create transmittal sheets for its own purposes, but must not file them.

§ 41.108 Lead counsel.

(a) A party may be represented by counsel. The Board may require a party to appoint a lead counsel. If counsel is not of record in a party's involved application or patent, then a power of attorney for that counsel for the party's involved application or patent must be filed with the notice required in paragraph (b) of this section.

(b) Within 14 days of the initiation of each contested case, each party must file a separate notice identifying its counsel, if any, and providing contact information for each counsel identified or, if the party has no counsel, then for the party. Contact information must, at a minimum, include:

- (1) a mailing address;
- (2) an address for courier delivery when the mailing address is not available for such delivery (for example, when the mailing address is a Post Office box);
- (3) a telephone number;
- (4) a facsimile number; and
- (5) an electronic mail address.

(c) A party must promptly notify the Board of any change in the contact information required in paragraph (b) of this section.

§ 41.109 Access to and copies of Office records.

(a) *Request for access or copies.* Any request from a party for access to or copies of Office records directly related to a contested case must be filed with the Board. The request must precisely identify the records and in the case of copies include the appropriate fee set under § 1.19(b) of this title.

(b) *Authorization of access and copies.* Access and copies will ordinarily only be authorized for the following records:

- (1) The application file for an involved patent;
- (2) An involved application; and

¶ 10 Lead and backup counsel

The notice identifying counsel under Bd. R. 108(b) must identify both a lead counsel and a backup lead counsel, and must provide for each the contact information specified in Bd. R. 108(b)(1)-(b)(5).

If lead counsel or backup counsel are not counsel of record (37 CFR § 1.34(b)) in the involved application or patent, then a power of attorney must be filed with the Board for entry in the involved patent or application file within the **fourteen (14) day** period of Bd. R. 108(b).

¶ 11 Request for file copies

A party seeking copies of an involved or benefit file mentioned in the Declaration must, within **fourteen (14) days** of the date of the Declaration, file with the Board (not another part of the Office) a separate paper styled [Name of party] REQUEST FOR FILE COPIES to which is attached a completed FILE COPY REQUEST. See Form 4 in the Appendix of Forms.

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(3) An application for which a party has been accorded benefit under subpart E of this part.

(c) *Missing or incomplete copies.* If a party does not receive a complete copy of a record within 21 days of the authorization, the party must promptly notify the Board.

Practice Notes

Involved and benefit files are separate. The record for the contested case does not include any involved application or patent or any benefit files, all of which are maintained as separate files. Ordering the record for the contested case will not result in receipt of copies of the involved files. There should rarely be any need for a party to order the record for the contested case during the pendency of the contested case before the Board.

Facsimile orders of file requests are encouraged to ensure timely delivery. Such orders should be transmitted as provided in SO ¶ 4.5.

Failure to request copies of files at the beginning of the contested case will rarely constitute a basis for granting an extension of time (Bd. R. 4(a)). Thus, an extension of time should not be expected based on non-receipt of requested files where a party did not timely place an order for copies or timely advise the Board of non-receipt of a file.

Within twenty-one days of the date of the Declaration, the Board will forward all requests timely received and all necessary files to the Office of Public Records (OPR). An order will be entered by the Trial Section notifying the parties that their respective orders have been forwarded to OPR. OPR will make the copies, which will be shipped via overnight commercial courier within fourteen days of receipt of the order. The transmittal order instructs parties to advise the Board promptly if complete copies are not received consistent with this schedule.

Access to files maintained in paper. During the pendency of a contested case, involved files (other than files that are maintained as Image File Wrapper records) may be inspected only at the Board. Moreover, paper files are unavailable while OPR is making copies.

§ 41.110 Filing claim information.

(a) *Clean copy of claims.* Within 14 days of the initiation of the proceeding, each party must file a clean copy of its involved claims and, if a biotechnology

¶ 12 Later presented or contested claims

If a party moves to involve a new (or uninvolved) claim in the contested case, the movant must comply with the

Subpart D

material sequence is a limitation, a clean copy of the sequence.

(b) *Annotated copy of claims.* Within 28 days of the initiation of the proceeding, each party must:

(1) For each involved claim having a limitation that is illustrated in a drawing or biotechnology material sequence, file an annotated copy of the claim indicating in bold face between braces ({}) where each limitation is shown in the drawing or sequence.

(2) For each involved claim that contains a means-plus-function or step-plus-function limitation in the form permitted under 35 U.S.C. 112(6), file an annotated copy of the claim indicating in bold face between braces ({}) the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.

(c) Any motion to add or amend a claim must include:

(1) A clean copy of the claim,
(2) A claim chart showing where the disclosure of the patent or application provides written description of the subject matter of the claim, and

(3) Where applicable, a copy of the claims annotated according to paragraph (b) of this section.

requirements of Bd. R. 110(a) and (b) for the new claim.

Practice Notes

Clean copies of claims and of biotechnology sequences are required because claims and sequences are often spread throughout an application file. In patents, there are often certificates of correction. The filing also provides an early opportunity to identify any divergence between what the party believes its claims to be and what the record actually shows.

Subpart D

Practice Note - continued

Annotated copies of the involved claims allow all parties and the Board to understand the precise meaning of limitations in the claims. An example follows:

An apparatus comprising
a first valve { **Fig. 2, item 25** },
means for printing { **page 5, line 8 through page 6, line 1; Fig. 3, items 45 and 46** }, and
a second valve { **Fig. 3, item 98** } * * * .

§ 41.120 Notice of basis for relief.

(a) The Board may require a party to provide a notice stating the relief it requests and the basis for its entitlement to relief. The Board may provide for the notice to be maintained in confidence for a limited time.

(b) *Effect.* If a notice under paragraph (a) of this section is required, a party will be limited to filing substantive motions consistent with the notice. Ambiguities in the notice will be construed against the party. A notice is not evidence except as an admission by a party-opponent.

(c) *Correction.* A party may move to correct its notice. The motion should be filed promptly after the party becomes aware of the basis for the correction. A correction filed after the time set for filing notices will only be entered if entry would serve the interests of justice.

Practice Note

Examples. The principal types of notices under Bd. R. 120 are priority statements (formerly "preliminary statements") in interferences and motions lists. More detail is provided in Bd. R 204 and SO ¶ 26. The Trial Section will continue to be more flexible in accepting changes in the motions list than in the priority statement; however, the practice under Bd. R. 120 is intended to be more rigorous than past motions-list practice. An accurate motions list is necessary to provide the Board and the opposing parties adequate notice to plan for the proceeding. Patently inadequate motions lists can no longer be cured by filing whatever motion a party may please whether it was listed or not.

§ 41.121 Motions.

(a) *Types of motions.* (1) *Substantive motions.* Consistent with the notice of requested relief, if any, and to the extent the Board authorizes, a party may file a motion:

- (i) to redefine the scope of the contested case,
- (ii) to change benefit accorded for the contested subject matter, or
- (iii) for judgment in the contested case.

(2) *Responsive motions.* The Board may authorize a party to file a motion to amend or add a claim, to change inventorship, or otherwise to cure a defect raised in a notice of requested relief or in a substantive motion.

(3) *Miscellaneous motions.* Any request for relief other than a substantive or responsive motion must be filed as a miscellaneous motion.

(b) *Burden of proof.* The party filing the motion has the burden of proof to establish that it is entitled to the requested relief.

(c) *Content of motions; oppositions and replies.* (1) Each motion must be filed as a separate paper and must include:

- (i) a statement of the precise relief requested,
- (ii) a statement of material facts (see paragraph (d) of this section), and
- (iii) a full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence and the governing law, rules, and precedent.

(2) *Compliance with rules.* Where a rule in part 1 of this title ordinarily governs the relief sought, the motion must make any showings required under that rule in addition to any showings required in this part.

(3) The Board may order additional showings or explanations as a condition for filing a motion.

¶ 13 Motions

¶ 13.1 Numbering motions

Each motion of each party must be numbered consecutively, starting with one, regardless of the type of motion.

¶ 13.2 Page limits in motions

A motion is limited to twenty-five (25) pages, not including a table of contents, a table of authorities, and the certificate of service.

¶ 13.3 Format

Each motion shall set out in the following order:

- (a) The precise relief requested.
- (b) The evidence (i.e., a list in numerical order of all exhibits) the movant cites in support of the motion with a brief description of the exhibit (e.g., "Exhibit 1038, Second Declaration of Jones").
- (c) A statement of facts in separately numbered paragraphs sufficient to establish entitlement to the requested relief, with citations to the evidence.
- (d) An argument setting out the reasons why relief should be granted.

¶ 13.4 Statement of material facts

Facts should be set out as short, numbered declaratory sentences that are capable of being admitted or denied.

Citation to the evidence must be specific, e.g., (1) by column and line of a patent, (2) page, column and paragraph of a journal article and (3) page and line of a cross-examination deposition transcript.

Subpart D

(d) *Statement of material facts.*

(1) Each material fact shall be set forth as a separate numbered sentence with specific citations to the portions of the record that support the fact.

(2) The Board may require that the statement of material facts be submitted as a separate paper.

(e) *Claim charts.* Claim charts must be used in support of any paper requiring the comparison of a claim to something else, such as another claim, prior art, or a specification. Claim charts must accompany the paper as an appendix. Claim charts are not a substitute for appropriate argument and explanation in the paper.

(f) The Board may order briefing on any issue that could be raised by motion.

¶ 13.5 Claim chart alternative

As an alternative to a claim chart, a party may reproduce the complete claim in the appendix. Following each limitation in the claim, and within braces { }, insert in bold a specific citation to the information to be compared to the limitation (such as where a prior art reference describes the limitation). Braces { } must be used instead of brackets [] because brackets are used to indicate amended portions of claims in reissue applications.

Practice Notes

Titles of motions. The title of a motion may include a second line specifying the nature of the motion. For example:

- JONES MISCELLANEOUS MOTION 1
(for additional discovery)
- JONES SUBSTANTIVE MOTION 2
(for judgment based on prior art)
- JONES RESPONSIVE MOTION 3
(to correct inventorship)
- JONES SUBSTANTIVE MOTION 4
(for judgment based on lack of enablement)

Burden of proof. In addition to complying with any procedural requirements of the rules and this Order, when a substantive issue is raised by a motion, a party bears a burden to establish its right to any substantive relief requested in the motion. *Hillman v. Shyamala*, 55 USPQ2d 1220, 1221-22 (BPAI 2000). A motion that fails to comply with applicable procedural requirements may be dismissed without reaching the merits, in which case the issue sought to be raised by the motion is deemed not to have been properly presented for decision by the Board. A motion that, while complying with applicable procedural requirements, nevertheless fails to make out a substantive case may be denied on the merits. A motion may be dismissed or denied without considering any opposition, or may be granted without considering a reply.

Practice Note - continued

Precise statement of relief. Two examples:

- Jones moves to be accorded the benefit of the filing date of application X, filed 22 January 1993.
- Jones moves for judgment against Smith on the ground that Smith's claims 1, 2 and 5 corresponding to the count are unpatentable under 35 U.S.C. 103 over the combined disclosures of U.S. Patent No. Y (Yee) and French Patent Z (Zola).

Statement of material facts. A motion may be denied if the facts alleged are insufficient to state a claim for which relief may be granted. Facts set out in an argument portion of a motion may be overlooked and may result in a motion being denied. Citations to an entire document or numerous pages of a cross-examination deposition transcript do not comply with the requirement for a specific citation to the record. *Biotec Biologische Naturverpackungen v. Biocorp., Inc.*, 249 F.3d 1341, 1353, 58 USPQ2d 1737, 1746 (Fed. Cir. 2001). The Board will not take on the role of advocate for a party, trying to make out a case the party has not adequately stated. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000).

§ 41.122 Oppositions and replies.

(a) Oppositions and replies must comply with the content requirements for motions and must include a statement identifying material facts in dispute. Any material fact not specifically denied shall be considered admitted.

(b) All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition.

¶ 14 Oppositions and replies

¶ 14.1 Numbering oppositions and replies

Each opposition and reply must use the number of the motion to which it corresponds.

¶ 14.2 Page limits in oppositions and replies

An opposition is limited to twenty-five (25) pages, and a reply is limited to ten (10) pages, not including a table of contents, a table of authorities, and any certificate of service.

¶ 14.3 Opposition format

Each opposition shall set out in the following order:

- (a) The evidence (i.e., a list in numerical order of all exhibits by number) the opponent cites in support of the opposition.
- (b) For each material fact alleged in the motion, a concise statement admitting, denying, or stating that the opponent is unable to admit or deny the fact.

Subpart D

- (c) Any additional material fact upon which the opposition relies, with a citation to the evidence. Any additional material fact must be consecutively numbered beginning with the next number after the last numbered material fact.
- (d) An argument stating the reason why relief is opposed shall be made in the following manner:
 - On page x, lines y-z of the motion, it is argued (or stated factually) that __. The response is __.

¶ 14.4 Reply format

Each reply shall set out in the following order:

- (a) The evidence (i.e., a list in numerical order of all exhibits by number) the movant cites for the first time in support of the reply.
- (b) For each material fact alleged in the opposition, a concise statement admitting, denying, or stating that

the movant is unable to admit or deny the fact.
- (c) Any additional material fact upon which the movant relies to rebut the opposition, with a citation to the evidence and an explanation as to why each additional material fact was not set out in the motion. Any additional material fact must be consecutively numbered beginning with the next number after the last numbered material fact.
- (d) The argument responsive to statements in the opposition shall be made in the following manner:
 - On page x, lines y- z of the opposition, it is argued (or stated factually) that __. The response is __.

Practice Notes

Titles of oppositions and replies. An opposition will bear the same number as the motion it opposes (skipping the number of any motion not opposed), but does not need a descriptive second line. For example:

SMITH OPPOSITION 1

A reply to an opposition will bear the same number as the opposition to which it replies (again, skipping the number of any opposition for which no reply is filed). For example:

JONES REPLY 1

New issues in replies. A reply that raises a new issue or belatedly presented evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply. Examples of indications that a new issue has been raised in a reply include:

- new evidence that is necessary to make out a *prima facie* case for the relief requested in the motion,
- new evidence that could have been included with the motion, and
- a reply that is longer than the corresponding motion or opposition.

§ 41.123 Default filing times.

(a) A *motion*, other than a miscellaneous motion, may only be filed according to a schedule the Board sets. The default times for acting are:

(1) An *opposition* is due 30 days after service of the motion.

(2) A *reply* is due 30 days after service of the opposition.

(3) A *responsive motion* is due 30 days after the service of the motion.

(b) *Miscellaneous motions.* (1) If no time for filing a specific miscellaneous motion is provided in this part or in a Board order:

(i) The opposing party must be consulted prior to filing the miscellaneous motion, and

(ii) If an opposing party plans to oppose the miscellaneous motion, the movant may not file the motion without Board authorization. Such authorization should ordinarily be obtained through a telephone conference including the Board and every other party to the proceeding. Delay in seeking relief may justify a denial of the motion.

¶ 15 Miscellaneous motions

¶ 15.1 Mandatory conference call

Before filing a miscellaneous motion, a party must:

- (a) confer with all opponents and,
- (b) if agreement cannot be reached, arrange a conference call to the Board official administering the contested case.

¶ 15.2 Timeliness

The movant must explain why the motion is timely.

Subpart D

(2) An opposition may not be filed without authorization. The default times for acting are:

(i) An *opposition* to a miscellaneous motion is due five business days after service of the motion.

(ii) A *reply* to a miscellaneous motion opposition is due three business days after service of the opposition.

(c) *Exhibits*. Each exhibit must be filed and served with the first paper in which it is cited except as the Board may otherwise order.

Practice Note

Recording conference calls. The parties, at their expense, may retain the services of a court reporter to record any conference call. A written record is often desirable inasmuch as an oral decision may be made with respect to issues raised during the conference call.

§ 41.124 Oral argument.

(a) *Request for oral argument*. A party may request an oral argument on an issue raised in a paper within five business days of the filing of the paper. The request must be filed as a separate paper and must specify the issues to be considered.

(b) *Copies for panel*. If an oral argument is set for a panel, the movant on any issue to be argued must provide three working copies of the motion, the opposition, and the reply. Each party is responsible for providing three working copies of its exhibits relating to the motion.

(c) *Length of argument*. If a request for oral argument is granted, each party will have a total of 20 minutes to present its arguments, including any time for rebuttal.

(d) *Demonstrative exhibits* must be served at least five business days before the oral argument and filed no later than the time of the oral argument.

(e) *Transcription*. The Board encourages the use of a transcription

¶ 16 Oral argument

¶ 16.1 Demonstrative exhibits

Four copies (one for the record and one for each judge) of each demonstrative exhibit must be filed or be presented at oral argument. Demonstrative exhibits must be served in advance. Bd. R. 124(d).

Any special equipment needed for oral argument is the responsibility of the party needing the equipment.

¶ 16.2 Transcript of oral argument

When an argument is to be transcribed, the party should notify Trial Section support staff personnel at least one business day prior to oral argument so that arrangements may be made in the hearing room for the reporter.

The court reporter shall use a stenography machine and may also use a tape recording device as a backup. Microphones at individuals' locations are not authorized.

The party requesting transcription must arrange for the transcription and pay the

service at oral arguments but, if such a service is to be used, the Board must be notified in advance to ensure adequate facilities are available and a transcript must be filed with the Board promptly after the oral argument.

costs. Parties are encouraged to share the costs.

Practice Notes

The time for requesting an oral hearing on substantive and responsive motions is normally specifically set in an order, which will control over the five days set in Bd. R. 124(a). See Bd. R. 104(c).

Special equipment or needs. A party should advise the Board as soon as possible before an oral hearing of any special need. Examples of such needs include additional space for a wheel chair or for a stenographer, an easel for posters, or an overhead projector. Parties should not make assumptions about the equipment the Board may have on hand. Such requests should be directed in the first instance to a Trial Section paralegal at 571-272-9797.

Demonstrative exhibits. Elaborate demonstrative exhibits are more likely to impede than help an oral argument. The most effective demonstrative exhibits tend to be a handout or binder containing the demonstrative exhibits. The pages of each exhibit should be numbered to facilitate identification of the exhibits during the hearing, particularly if the hearing is recorded.

§ 41.125 Decision on motions.

(a) *Order of consideration.* The Board may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action appropriate to secure the just, speedy, and inexpensive determination of the proceeding. A decision on a motion may include deferral of action on an issue until a later point in the proceeding.

(b) *Interlocutory decisions.* A decision on motions without a judgment terminating the proceeding is not final for the purposes of judicial review. A panel decision on an issue will govern further proceedings in the contested case.

(c) *Rehearing—(1) Time for request.* A request for rehearing of a decision must be filed within fourteen days of the decision.

¶ 17 Request for rehearing

¶ 17.1 Form for request

A request for rehearing of decision must set out in the following order:

- (a) The evidence (i.e., a list in numerical order of all exhibits by number) that the party believes was overlooked or misapprehended.
- (b) The argument responsive to the decision shall be made with particularity in the following manner:

On page __, lines __-__, the decision states __. The decision is believed to have overlooked [or misapprehended] __. This point was set forth in __ Motion [or Opposition or Reply] __ at page __, lines __-__.

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(2) *No tolling*. The filing of a request for rehearing does not toll times for taking action.

(3) *Burden on rehearing*. The burden of showing a decision should be modified lies with the party attacking the decision. The request must specifically identify:

(i) All matters the party believes to have been misapprehended or overlooked, and

(ii) The place where the matter was previously addressed in a motion, opposition, or reply.

(4) *Opposition; reply*. Neither an opposition nor a reply to a request for rehearing may be filed without Board authorization.

(5) *Panel rehearing*. If a decision is not a panel decision, the party requesting rehearing may request that a panel rehear the decision. A panel rehearing a procedural decision will review the decision for an abuse of discretion.

¶ 17.2 Number of requests

A party may file no more than one request for rehearing per motion decision.

Practice Note

New evidence on rehearing. Evidence not already of record at the time of the decision will not be admitted absent a showing of good cause for the belated submission (Bd. R. 4(a)).

§ 41.126 Arbitration.

(a) Parties to a contested case may resort to binding arbitration to determine any issue in a contested case. The Office is not a party to the arbitration. The Board is not bound and may independently determine questions of patentability, jurisdiction, and Office practice.

(b) The Board will not authorize arbitration unless:

(1) It is to be conducted according to Title 9 of the United States Code.

(2) The parties notify the Board in writing of their intention to arbitrate.

(3) The agreement to arbitrate:

(i) Is in writing,

¶ 18 Settlement discussions required

¶ 18.1 Last-named party initiates

The party named last on in the caption set in the declaration is responsible for (1) initiating any settlement discussions, (2) initially drafting any document and (3) initiating any conference call required by this paragraph. The parties may agree to permit another party to undertake the obligations placed upon the last-named party.

¶ 18.2 Initial conference

Within **three (3) months** of the date of the Declaration, the parties must conduct a settlement conference and must initiate a conference call with the Board official

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- (ii) Specifies the issues to be arbitrated,
 - (iii) Names the arbitrator, or provides a date not more than 30 days after the execution of the agreement for the selection of the arbitrator, and
 - (iv) Provides that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board.
- (4) A copy of the agreement is filed within 20 days after its execution.
- (5) The arbitration is completed within the time the Board sets.
- (c) The parties are solely responsible for the selection of the arbitrator and the conduct of proceedings before the arbitrator.
- (d) Issues not disposed of by the arbitration will be resolved in accordance with the procedures established in this subpart.
- (e) The Board will not consider the arbitration award unless it:
- (1) Is binding on the parties,
 - (2) Is in writing,
 - (3) States in a clear and definite manner each issue arbitrated and the disposition of each issue, and
 - (4) Is filed within 20 days of the date of the award.
- (f) Once the award is filed, the parties to the award may not take actions inconsistent with the award. If the award is dispositive of the contested subject matter for a party, the Board may enter judgment as to that party.

assigned to the case. During the call, the parties should be prepared to report:

- (a) the outcome of the settlement discussion;
- (b) whether the parties are actively engaged in settlement negotiations and, if so, what steps have already been taken toward settlement;
- (c) whether any settlement negotiations are directed toward obviating the need for filing motions;
- (d) any issues that are not subject to settlement negotiations; and
- (e) the status of any settlement negotiations, including how much time might be needed to conclude those negotiations.

¶ 18.3 Subsequent conferences

Unless a different time is set in an order, within **two (2) months** after a panel decision on substantive motions, the parties must conduct another settlement conference and initiate another conference call with the Board on the conference as provided in the preceding paragraph of this order.

¶ 18.4 Filing notice of conferences

Prior to initiating any conference call required by this paragraph, the parties must file (preferably by facsimile) a joint statement indicating that a good faith effort has been made to settle the contested case.

Practice Note

Policy. The Office encourages settlement of contested cases. The practice under SO ¶ 18 is designed to facilitate the process of reaching settlement. For instance, the last named party in the contested case is required to initiate the mandatory settlement discussion to avoid the perception that initiation of talks indicates weakness. The Board official assigned to the contested case is available to facilitate settlement discussions.

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§ 41.127 Judgment.

(a) *Effect within Office—(1) Estoppel.* A judgment disposes of all issues that were, or by motion could have properly been, raised and decided. A losing party who could have properly moved for relief on an issue, but did not so move, may not take action in the Office after the judgment that is inconsistent with that party's failure to move, except that a losing party shall not be estopped with respect to any contested subject matter for which that party was awarded a favorable judgment.

(2) *Final disposal of claim.* Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently.

(b) *Request for adverse judgment.* A party may at any time in the proceeding request judgment against itself. Actions construed to be a request for adverse judgment include:

- (1) abandonment of an involved application such that the party no longer has an application or patent involved in the proceeding,
- (2) cancellation or disclaiming of a claim such that the party no longer has a claim involved in the proceeding,
- (3) concession of priority or unpatentability of the contested subject matter, and
- (4) abandonment of the contest.

(c) *Recommendation.* The judgment may include a recommendation for further action by the examiner or by the Director. If the Board recommends rejection of a claim of an involved application, the examiner must enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(d) *Rehearing.* A party dissatisfied with the judgment may file a request for rehearing within 30 days of the entry of

the judgment. The request must specifically identify all matters the party believes to have been misapprehended or overlooked, and the place where the matter was previously addressed in a motion, opposition, or reply.

Practice Note

Rehearing. The practice under SO ¶ 17 regarding requests for rehearing of motions applies to rehearing of judgments as well. A judgment that implements a decision is not the basis for a second attack on the underlying decision.

§ 41.128 Sanctions.

- (a) The Board may impose a sanction against a party for misconduct, including:
- (1) Failure to comply with an applicable rule or order in the proceeding;
 - (2) Advancing a misleading or frivolous request for relief or argument; or
 - (3) Engaging in dilatory tactics.
- (b) Sanctions include entry of:
- (1) An order holding certain facts to have been established in the proceeding;
 - (2) An order expunging, or precluding a party from filing, a paper;
 - (3) An order precluding a party from presenting or contesting a particular issue;
 - (4) An order precluding a party from requesting, obtaining, or opposing discovery;
 - (5) An order excluding evidence;
 - (6) An order awarding compensatory expenses, including attorney fees;
 - (7) An order requiring terminal disclaimer of patent term; or
 - (8) Judgment in the contested case.

§ 41.150 Discovery.

- (a) *Limited discovery.* A party is not entitled to discovery except as authorized in this subpart. The parties may agree to discovery among themselves at any time.
- (b) *Automatic discovery.* (1) Within 21 days of a request by an opposing party, a party must:

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(i) Serve a legible copy of every requested patent, patent application, literature reference, and test standard mentioned in the specification of the party's involved patent or application, or application upon which the party will rely for benefit, and, if the requested material is in a language other than English, a translation, if available, and

(ii) File with the Board a notice (without copies of the requested materials) of service of the requested materials.

(2) Unless previously served, or the Board orders otherwise, any exhibit cited in a motion or in testimony must be served with the citing motion or testimony.

(c) *Additional discovery.* (1) A party may request additional discovery. The requesting party must show that such additional discovery is in the interests of justice. The Board may specify conditions for such additional discovery.

(2) When appropriate, a party may obtain production of documents and things during cross examination of an opponent's witness or during testimony authorized under § 41.156.

Practice Notes

Purpose. Automatic discovery (1) places the parties on a level playing field and (2) reduces any difficulty authenticating documents when a party would like to rely on a document cited in an opponent's specification. A party should have access to documents cited in its opponent's specification, but it may be difficult for the party to locate those documents.

Filing automatic discovery materials. The parties should be prepared to promptly file copies of the materials served under Bd. R. 150(b).

Requesting additional discovery. A request for additional discovery must be in the form of a miscellaneous motion. Bd. R. 121(a)(3). The standard for granting such requests is high and requires specific bases for expecting the discovery will be productive. Typical situations in which additional discovery may be required include proving an on-sale or public-use bar and proving inequitable conduct intent.

§ 41.151 Admissibility.

Evidence that is not taken, sought, or filed in accordance with this subpart shall not be admissible.

§ 41.152 Applicability of the Federal Rules of Evidence.

(a) *Generally.* Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to contested cases.

(b) *Exclusions.* Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.

(c) *Modifications in terminology.* Unless otherwise clear from context, the following terms of the Federal Rules of Evidence shall be construed as indicated:

Appellate court means United States Court of Appeals for the Federal Circuit or a United States district court when judicial review is under 35 U.S.C. 146.

Civil action, civil proceeding, action, and trial mean contested case.

Courts of the United States, U.S. Magistrate, court, trial court, and trier of fact mean Board.

Hearing means:

(i) In Federal Rule of Evidence 703, the time when the expert testifies.

(ii) In Federal Rule of Evidence 804(a)(5), the time for taking testimony.

Judge means the Board.

Judicial notice means official notice.

Trial or hearing means, in Federal Rule of Evidence 807, the time for taking testimony.

(d) The Board, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

§ 41.153 Records of the Office.

Certification is not necessary as a condition to admissibility when the evidence to be submitted is a record of

¶ 19 Admissibility of specification

A specification of an involved application or patent is admissible as evidence only to prove what the specification or patent describes. If there is data in the specification upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated (i.e., the individual who performed an experiment reported as an example in the specification) must be filed. This individual may be cross examined.

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the Office to which all parties have access.

§ 41.154 Form of evidence.

(a) Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be submitted in the form of an exhibit.

(b) *Translation required.* When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.

(c) An exhibit must conform with the requirements for papers in § 41.106 of this subpart and the requirements of this paragraph.

(1) Each exhibit must have an exhibit label with a unique number in a range assigned by the Board, the names of the parties, and the proceeding number in the following format:

JONES EXHIBIT 2001
Jones v. Smith
Contested Case 104,999

(2) When the exhibit is a paper:

(i) Each page must be uniquely numbered in sequence, and

(ii) The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.

(d) *Exhibit list.* Each party must maintain an exhibit list with the exhibit number and a brief description of each exhibit. If the exhibit is not filed, the exhibit list should note that fact. The Board may require the filing of a current exhibit list prior to acting on a motion.

¶ 20 Form of evidence

¶ 20.1 Papers in a patent or application file

¶ 20.1.1 Reliance on a portion of a file

If a motion relies on any paper in the file of an involved or benefit patent or application (including a specification or drawings), a copy of the entire paper shall be made an exhibit in the contested case. Do not submit an entire application file as a single exhibit.

¶ 20.1.2 No exception for affidavits

An affidavit filed during *ex parte* prosecution of an involved or benefit application or patent is not automatically in evidence. A party seeking to have such an affidavit considered must place the affidavit in evidence. Each opponent will have an opportunity to object to the admissibility of the evidence and may cross examine the affiant. The party submitting the evidence will have an opportunity to supplement the evidence following a timely objection by an opponent. Bd. R. 155(b)(2).

¶ 20.2 Exhibit labels

¶ 20.2.1 Unique and consecutive

Each exhibit from a party must be uniquely and consecutively numbered within the range the Board assigns to the party for the proceeding.

Unless otherwise provided in an order, the party named last in the caption set in the declaration is assigned the range 1001-1999, while the first-named party is assigned 2001-2999.

¶ 20.2.2 Material covered on first page

If an exhibit label covers important material on the first page of an exhibit, a copy of the first page of the exhibit must be reproduced and presented as page 1-a of the exhibit.

¶ 20.3 Filing of exhibits

A set of original exhibits must be filed in a box, an accordion folder, or a comparable folder containing the exhibits

in numerical order, separated by a divider that conspicuously identifies each exhibit by number.

If any party requests oral argument, three (3) separate additional sets of exhibits must also be filed; otherwise, one (1) additional set of exhibits must be filed.

¶ 20.4 Exhibit list

A current list shall be served whenever evidence is served.

The exhibit list shall be filed with the exhibits.

Practice Note

Multiple copies of the same exhibit with different exhibit numbers from the same party are prohibited. Bd. R. 7(b).

§ 41.155 Objection; motion to exclude; motion in limine.

(a) *Deposition.* Objections to deposition evidence must be made during the deposition. Evidence to cure the objection must be provided during the deposition unless the parties to the deposition stipulate otherwise on the deposition record.

(b) *Other than deposition.* For evidence other than deposition evidence:

(1) *Objection.* Any objection must be served within five business days of service of evidence, other than deposition evidence, to which the objection is directed.

(2) *Supplemental evidence.* The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.

(c) *Motion to exclude.* A miscellaneous motion to exclude evidence must be filed to preserve any objection. The motion must identify the objections in the record in order and must explain the objections.

¶ 21 Objections

¶ 21.1 Objecting to served evidence

An objection to the admissibility of evidence should not be filed except as part of a motion to exclude.

¶ 21.2 Serving supplemental evidence

Supplemental evidence responding to an objection to the admissibility of evidence should not be filed until it is used as an exhibit.

¶ 21.3 Motion to exclude evidence

(a) A motion to exclude evidence shall:

- (1) identify where in the record the objection was originally made,
- (2) identify where in the record the evidence to be excluded was relied upon by an opponent, and
- (3) address objections to exhibits (in whole or in part) in exhibit numerical order.

(b) When a timely objection has been made (see SO ¶ 21.1), no conference call is necessary to file a motion to exclude.

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(d) *Motion in limine*. A party may file a miscellaneous motion in limine for a ruling on the admissibility of evidence.

Practice Notes

Form of motion. A motion to exclude and a motion in limine are miscellaneous motions. Bd. R. 121(a)(3).

Time to file objections and motions to exclude. Times for filing objections and for filing and serving motions to exclude are set in the order setting times for motions. Generally, the order will set a later date for filing of objections and motions to exclude than the default time for a miscellaneous rule because supplemental evidence may cure any defect in the evidence.

Waiver of untimely objections. The practice under SO ¶ 21 has been effective in facilitating consideration of objections to exclude evidence. If an objection could have been made before the filing of supplemental evidence and an objection was not made, the objection is waived.

Responding to an objection. No immediate response to an objection is required other than the filing of supplemental evidence in response to the objection if the proponent of the evidence chooses to do so. Any attack on the correctness of an objection must come in response to a motion to exclude based on the objection. Any other response to an objection is neither necessary nor desirable.

§ 41.156 Compelling testimony and production.

(a) *Authorization required*. A party seeking to compel testimony or production of documents or things must file a miscellaneous motion for authorization.

The miscellaneous motion must describe the general relevance of the testimony, document, or thing and must:

- (1) In the case of testimony, identify the witness by name or title, and
- (2) In the case of a document or thing, the general nature of the document or thing.

(b) *Outside the United States*. For testimony or production sought outside the United States, the motion must also:

- (1) *In the case of testimony*. (i) Identify the foreign country and explain why the

party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and

(ii) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the expenses of the witness to travel to and testify in the United States.

(2) *In the case of production of a document or thing.* (i) Identify the foreign country and explain why the party believes production of the document or thing can be compelled in the foreign country, including a description of the procedures that will be used to compel production of the document or thing in the foreign country and an estimate of the time it is expected to take to obtain production of the document or thing; and

(ii) Demonstrate that the party has made reasonable efforts to obtain the agreement of the individual or entity having possession, custody, or control of the document to produce the document or thing in the United States but has been unsuccessful in obtaining that agreement, even though the party has offered to pay the expenses of producing the document or thing in the United States.

Practice Notes

Form and timing of request. A miscellaneous motion under Bd. R. 156(a) must comply with the requirements for a miscellaneous motion, Bd. R. 121(a)(3), and must be filed sufficiently in advance that any authorized testimony can be served with the motion, opposition or reply it is intended to support.

Alternative procedures for compelled testimony. If a motion to compel testimony is granted, testimony may be (1) *ex parte*, subject to subsequent

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Practice Note - continued

cross examination, or (2) *inter partes*. *Therriault v. Garbe*, 53 USPQ2d 1179, 1184 (BPAI 1999). In moving for, or opposing, such testimony, the parties should discuss which procedure is appropriate.

§ 41.157 Taking testimony.

(a) *Form*. Direct testimony must be submitted in the form of an affidavit except when the testimony is compelled under 35 U.S.C. 24, in which case it may be in the form of a deposition transcript.

(b) *Time and location*—(1) *Uncompelled direct testimony* may be taken at any time; otherwise, testimony may only be taken during such time period as the Board may authorize.

(2) *Other testimony*.

(i) Except as the Board otherwise orders, authorized testimony may be taken at any reasonable time and location within the United States before any disinterested official authorized to administer oaths at that location.

(ii) Testimony outside the United States may only be taken as the Board specifically directs.

(c) *Notice of deposition*. (1) Prior to the taking of testimony, all parties to the proceeding must agree on the time and place for taking testimony. If the parties cannot agree, the party seeking the testimony must initiate a conference with the Board to set a time and place.

(2) Cross-examination should ordinarily take place after any supplemental evidence relating to the direct testimony has been filed and more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used. A party requesting cross-examination testimony of more than one witness may choose the order in which the witnesses are to be cross-examined.

¶ 22 Cross examination

¶ 22.1 Time for cross examination

The party relying on an affiant must make the affiant available for cross examination during the time required by this Order. The parties must confer to reach agreement on dates and times for cross examination of witnesses.

¶ 22.1.1 Start date

Unless the parties otherwise agree, cross examination of an affiant may begin no earlier than twenty-one (21) days after service of the affidavit.

¶ 22.1.2 End date

- Unless the parties otherwise agree,
- (1) Cross examination of affiant relied upon in a motion other than a miscellaneous motion must occur at least ten (10) days before the opposition to the motion is due.
 - (2) Cross examination of an affiant relied upon in an opposition to a motion other than a miscellaneous motion shall take place at least ten (10) days before a reply is due.

¶ 22.2 Notice

A notice requesting cross examination shall be served (but need not be filed).

¶ 22.3 Proponent responsible

The party relying on an affiant is responsible for securing the services of a court reporter and providing a copy of any transcript to every opponent.

¶ 22.4 Order of cross examination

While a party requesting cross examination may choose the order of the witnesses, Bd. R. 157(c)(2), order must be reasonable.

¶ 22.5 Filing transcript

An uncertified copy of each deposition transcript must be filed as an exhibit. A

(3) In the case of direct testimony, at least three business days prior to the conference in paragraph (c)(1), the party seeking the direct testimony must serve:

- (i) A list and copy of each document under the party's control and on which the party intends to rely, and
- (ii) A list of, and proffer of reasonable access to, any thing other than a document under the party's control and on which the party intends to rely.

(4) Notice of the deposition must be filed at least two business days before a deposition. The notice limits the scope of the testimony and must list:

- (i) The time and place of the deposition,
- (ii) The name and address of the witness,
- (iii) A list of the exhibits to be relied upon during the deposition, and
- (iv) A general description of the scope and nature of the testimony to be elicited.

(5) *Motion to quash*. Objection to a defect in the notice is waived unless a miscellaneous motion to quash is promptly filed.

(d) *Deposition in a foreign language*. If an interpreter will be used during the deposition, the party calling the witness must initiate a conference with the Board at least five business days before the deposition.

(e) *Manner of taking testimony*. (1) Each witness before giving a deposition shall be duly sworn according to law by the officer before whom the deposition is to be taken. The officer must be authorized to take testimony under 35 U.S.C. 23.

(2) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer, or by some other disinterested person in the presence of the officer, unless the presence of the officer is waived on the record by agreement of all parties.

certified transcript of testimony need not be filed unless required by the Board.

¶ 22.6 Cross examination guidelines

The cross examination guidelines appended to this Order apply to all cross examination in this contested case.

¶ 22.7 Observations on cross examinations

Cross examination may occur after a party has filed its last substantive paper on an issue (e.g., after the reply) and result in testimony that should be called to the Board's attention but does not merit a motion to exclude. The Board may authorize the filing of observations to identify such testimony and responses to observations.

An observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit (including another part of the same testimony). Any response should be equally concise. An observation (or response) is not an opportunity to raise new issues, to re-argue issues, or to pursue objections. Each observation should be in the following form:

In exhibit __, on page __, lines __, the witness testified __. This testimony is relevant to the __ on page __ of __. The testimony is relevant because

__.
The entire observation should not exceed one short paragraph.

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(3) Any exhibits relied upon must be numbered according to the numbering scheme assigned for the contested case and must, if not previously served, be served at the deposition.

(4) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, and any other objection to the proceeding shall be noted on the record by the officer. Evidence objected to shall be taken subject to a ruling on the objection.

(5) When the testimony has been transcribed, the witness shall read and sign (in the form of an affidavit) a transcript of the deposition unless:

- (i) The parties otherwise agree in writing,
- (ii) The parties waive reading and signature by the witness on the record at the deposition, or
- (iii) The witness refuses to read or sign the transcript of the deposition.

(6) The officer shall prepare a certified transcript by attaching to the transcript of the deposition a certificate in the form of an affidavit signed and sealed by the officer. Unless the parties waive any of the following requirements, in which case the certificate shall so state, the certificate must state:

- (i) The witness was duly sworn by the officer before commencement of testimony by the witness;
- (ii) The transcript is a true record of the testimony given by the witness;
- (iii) The name of the person who recorded the testimony and, if the officer did not record it, whether the testimony was recorded in the presence of the officer;
- (iv) The presence or absence of any opponent;
- (v) The place where the deposition was taken and the day and hour when the deposition began and ended;

(vi) The officer has no disqualifying interest, personal or financial, in a party; and

(vii) If a witness refuses to read or sign the transcript, the circumstances under which the witness refused.

(7) The officer must promptly provide a copy of the transcript to all parties. The proponent of the testimony must file the original as an exhibit.

(8) Any objection to the content, form, or manner of taking the deposition, including the qualifications of the officer, is waived unless made on the record during the deposition and preserved in a timely filed miscellaneous motion to exclude.

(f) *Costs.* Except as the Board may order or the parties may agree in writing, the proponent of the testimony shall bear all costs associated with the testimony, including the reasonable costs associated with making the witness available for the cross-examination.

Practice Notes

Live testimony. Cross-examination may be ordered to take place in the presence of an administrative patent judge. Examples of where such testimony has been ordered include contested cases where inventorship, derivation, or inequitable conduct has been an issue or where testimony has been given through an interpreter.

Observations. Filing of observations is infrequent in practice. The Board might refuse entry of excessively long or argumentative observations (or responses).

§ 41.158 Expert testimony; tests and data.

(a) Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. Testimony on United States patent law will not be admitted.

(b) If a party relies on a technical test or data from such a test, the party must provide an affidavit explaining:

¶ 23 Expert testimony on patent law

Affidavits of patent law experts on issues of law generally will not be admitted in evidence.

¶ 24 Explaining tests and data

Any explanation should take place through affidavit testimony of a witness, preferably accompanied by citation to relevant pages of standard texts (which should be filed as exhibits).

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- (1) Why the test or data is being used,
- (2) How the test was performed and the data was generated,
- (3) How the data is used to determine a value,
- (4) How the test is regarded in the relevant art, and
- (5) Any other information necessary for the Board to evaluate the test and data.

Practice Notes

Basis for testimony must be provided. Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based. See Fed. R. Evid. 705 and 37 CFR §§ 41.158. Opinions expressed without disclosing the underlying facts or data may be given little, or no, weight. *Rohm and Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness).

Tests and data. Parties often rely on scientific tests and data, both in the preliminary motion phase and during the priority testimony phase. Examples include infra-red spectroscopy graphs, high-performance liquid-chromatography data, etc. In addition to providing the explanation required in Bd. R. 158(b), the party relying on the test should provide any other information the party believes would assist the Board in understanding the significance of the test or the data.

Subpart E--Patent Interferences

§ 41.200 Procedure; pendency.

(a) A patent interference is a contested case subject to the procedures set forth in subpart D of this part.

(b) A claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears.

(c) Patent interferences shall be administered such that pendency before the Board is normally no more than two years.

§ 41.201 Definitions.

In addition to the definitions in §§ 41.2 and 41.100, the following definitions apply

to proceedings under this subpart:

Accord benefit means Board recognition that a patent application provides a proper constructive reduction to practice under 35 U.S.C. 102(g)(1).

Constructive reduction to practice means a described and enabled anticipation under 35 U.S.C. 102(g)(1) in a patent application of the subject matter of a count. *Earliest constructive reduction to practice* means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent. For the chain to be continuous, each subsequent application must have been co-pending under 35 U.S.C. 120 or 121 or timely filed under 35 U.S.C. 119 or 365(a).

Count means the Board's description of the interfering subject matter that sets the scope of admissible proofs on priority. Where there is more than one count, each count must describe a patentably distinct invention.

Involved claim means, for the purposes of 35 U.S.C. 135(a), a claim that has been designated as corresponding to the count.

Senior party means the party entitled to the presumption under § 41.207(a)(1) that it is the prior inventor. Any other party is a *junior party*.

Threshold issue means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

(1) No interference-in-fact, and
(2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:

(i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or

(ii) Unpatentability for lack of written description under 35 U.S.C. 112(1) of an involved application claim where the

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applicant suggested, or could have suggested, an interference under § 41.202(a).

§ 41.202 Suggesting an interference.

(a) *Applicant.* An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

(1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,

(2) Identify all claims the applicant believes interfere, propose one or more counts, and show how the claims correspond to one or more counts,

(3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),

(4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter.

(b) *Patentee.* A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.99 and § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an interference.

(c) *Examiner.* An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. If the interference would be with a patent, the

applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g):

- (1) Be patentable to the applicant, and
- (2) Be drawn to patentable subject matter claimed by another applicant or patentee.

(d) *Requirement to show priority under 35 U.S.C. 102(g).* (1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

(e) *Sufficiency of showing.* (1) A showing of priority under this section is not sufficient unless it would, if un rebutted, support a determination of priority in favor of the party making the showing.

(2) When testimony or production necessary to show priority is not available without authorization under § 41.150(c) or § 41.156(a), the showing shall include:

- (i) Any necessary interrogatory, request for admission, request for production, or deposition request, and
- (ii) A detailed proffer of what the response to the interrogatory or request would be expected to be and an explanation of the relevance of the response to the question of priority.

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§ 41.203 Declaration.

(a) *Interfering subject matter.* An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.

(b) *Notice of declaration.* An administrative patent judge declares the patent interference on behalf of the Director. A notice declaring an interference identifies:

- (1) The interfering subject matter;
- (2) The involved applications, patents, and claims;
- (3) The accorded benefit for each count; and
- (4) The claims corresponding to each count.

(c) *Redeclaration.* An administrative patent judge may redeclare a patent interference on behalf of the Director to change the declaration made under paragraph (b) of this section.

(d) A party may suggest the addition of a patent or application to the interference or the declaration of an additional interference. The suggestion should make the showings required under § 41.202(a).

§ 41.204 Notice of basis for relief.

(a) *Priority statement.* (1) A party may not submit evidence of its priority in addition to its accorded benefit unless it files a statement setting forth all bases on which the party intends to establish its entitlement to judgment on priority.

(2) The priority statement must:

- (i) State the date and location of the party's earliest corroborated conception,
- (ii) State the date and location of the party's earliest corroborated actual reduction to practice,
- (iii) State the earliest corroborated date on which the party's diligence began, and
- (iv) Provide a copy of the earliest document upon which the party will rely to show conception.

¶ 25 Adding an application or patent

A suggestion to add an application or patent to an interference must be in the form of a miscellaneous motion. Bd.

R. 121(a)(3). The motion must:

- (a) identify the application or patent to be added;
- (b) certify that a complete copy of the file wrapper for the application or patent has been served on all opponents;
- (c) indicate which claims of the patent or application should be designated as corresponding to the count; and
- (d) explain whether there are alternative remedies; if so, why alternative remedies are not adequate; and what attempts, if any, have been made to have the examiner recommend declaration of another interference involving the application or patent sought to be added to the interference.

¶ 26 Motions list

All substantive and anticipated responsive motions must be listed on the motions list. No other substantive motions may be filed without prior Board authorization obtained during a conference call.

(3) If a junior party fails to file a priority statement overcoming a senior party's accorded benefit, judgment shall be entered against the junior party absent a showing of good cause.

(b) *Other substantive motions.* The Board may require a party to list the motions it intends to file, including sufficient detail to place the Board and the opponent on notice of the precise relief sought.

(c) *Filing and service.* The Board will set the times for filing and serving statements required under this section.

Practice Note

Prior Board authorization is required for all substantive motions. Such authorization is best obtained during the conference call to set times for filing motions listed on the motions list. If the need for an unlisted motion arises, the movant should request authorization for the unlisted motion soon as possible to minimize any disruption to the proceeding. For instance, an unlisted successful threshold motion would mean that the cost and effort associated with the other filed motions was wasted.

§ 41.205 Settlement agreements.

(a) *Constructive notice; time for filing.* Pursuant to 35 U.S.C. 135(c), an agreement or understanding, including collateral agreements referred to therein, made in connection with or in contemplation of the termination of an interference must be filed prior to the termination of the interference between the parties to the agreement. After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had. If an appeal to the U.S. Court of Appeals for the Federal Circuit (under 35 U.S.C. 141) or a civil action (under 35 U.S.C. 146) has been filed the interference is considered terminated when the appeal or civil action is terminated. A civil action is terminated

¶ 27 Notice under 35 U.S.C. 135(c)

Notice is hereby given of the requirement of 35 U.S.C. 135(c) for filing in the Office a copy of any agreement "in connection with or in contemplation of the termination of the interference."

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when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

(b) *Untimely filing.* The Chief Administrative Patent Judge may permit the filing of an agreement under paragraph (a) of this section up to six months after termination upon petition and a showing of good cause for the failure to file prior to termination.

(c) *Request to keep separate.* Any party to an agreement under paragraph (a) of this section may request that the agreement be kept separate from the interference file. The request must be filed with or promptly after the agreement is filed.

(d) *Access to agreement.* Any person, other than a representative of a Government agency, may have access to an agreement kept separate under paragraph (c) of this section only upon petition and on a showing of good cause. The agreement will be available to Government agencies on written request.

§ 41.206 Common interests in the invention.

An administrative patent judge may decline to declare, or if already declared the Board may issue judgment in, an interference between an application and another application or patent that are commonly owned.

§ 41.207 Presumptions.

(a) *Priority—(1) Order of invention.* Parties are presumed to have invented interfering subject matter in the order of the dates of their accorded benefit for each count. If two parties are accorded the benefit of the same earliest date of constructive reduction to practice, then neither party is entitled to a presumption of priority with respect to the other such party.

(2) *Evidentiary standard.* Priority may be proved by a preponderance of the evidence except a party must prove priority by clear and convincing evidence if the date of its earliest constructive reduction to practice is after the issue date of an involved patent or the publication date under 35 U.S.C. 122(b) of an involved application or patent.

(b) *Claim correspondence.*

(1) For the purposes of determining priority and derivation, all claims of a party corresponding to the count are presumed to stand or fall together. To challenge this presumption, a party must file a timely substantive motion to have a corresponding claim designated as not corresponding to the count. No presumption based on claim correspondence regarding the grouping of claims exists for other grounds of unpatentability.

(2) A claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim.

(c) *Cross-applicability of prior art.*

When a motion for judgment of unpatentability against an opponent's claim on the basis of prior art is granted, each of the movant's claims corresponding to the same count as the opponent's claim will be presumed to be unpatentable in view of the same prior art unless the movant in its motion rebuts this presumption.

§ 41.208 Content of substantive and responsive motions.

The general requirements for motions in contested cases are stated at § 41.121(c).

(a) In an interference, substantive motions must:

- (1) raise a threshold issue,
- (2) seek to change the scope of the definition of the interfering subject matter

¶ 28 Specific substantive motions

¶ 28.1 Obviousness

When obviousness (35 U.S.C. 103) is the basis for a motion for judgment, if a reference does not teach or suggest a limitation, that fact must be explicitly identified as a difference in the statement of material facts. The argument portion of the motion must account for the difference.

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or the correspondence of claims to the count,

(3) seek to change the benefit accorded for the count, or

(4) seek judgment on derivation or on priority.

(b) To be sufficient, a motion must provide a showing, supported with appropriate evidence, such that, if unrebutted, it would justify the relief sought. The burden of proof is on the movant.

(c) *Showing patentability.* (1) A party moving to add or amend a claim must show the claim is patentable.

(2) A party moving to add or amend a count must show the count is patentable over prior art.

An explanation must be made in the body of the motion (not an appendix) why the subject matter of the claim, as a whole, would have been obvious to a person having ordinary skill in the art notwithstanding any difference.

¶ 28.2 Inequitable conduct

A motion alleging inequitable conduct must make out a *prima facie* case of inequitable conduct or fraud. Additional discovery (Bd. R. 150(c)) or a request to take testimony (Bd. R. 156), asserted to be necessary to make out a *prima facie* case, will rarely be authorized. An allegation of inequitable conduct or fraud that fails to make out a *prima facie* case may result in sanctions or a referral to the Office of Enrollment and Discipline.

¶ 28.3 Adding a reissue application

A movant seeking to add its own reissue application must stipulate that every added or amended claim (compared to the original patent) corresponds to a count in the interference. If the reissue application has not been filed in the Office, it must be filed directly with the Board.

Practice Notes

Estoppel. A substantively or procedurally inadequate motion does not avoid estoppel under Bd. R. 127(a)(1).

Reissue applications. The reasons for requiring all new or amended reissue claims to correspond to a count are set forth in *Winter v. Fujita*, 53 USPQ2d 1234 (BPAI 1999), *reh'g denied*, 53 USPQ2d 1478 (BPAI 1999). The reissue application should be filed directly with the Board to avoid processing delays that might prevent consideration of the motion to add the reissue application.

Timing of priority motions. Issues of priority and derivation are now raised in motions. The Trial Section will continue to administer most interferences in two phases. The first phase will continue to address issues preliminary to priority (e.g., threshold issues, the scope of the count, claim correspondence, and the accordancy of constructive reduction to practice dates), while the second phase will usually address priority issues.

APPENDIX OF FORMS

APPENDIX OF FORMS

Form 1. Standard caption for an interference

Filed on behalf of:

By: [Name of filing party]
[Name of lead counsel]
[Name of backup counsel]
[Street address]
[City, State, and ZIP Code]
[Telephone number]
[Facsimile number]

Paper No. [leave blank]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

(Administrative Patent Judge [Surname of administrative patent judge])

[Name of junior party]
([Involved application or patent number])
Junior Party,

v.

[Name of Senior party]
([Involved application or patent number])
Senior Party.

Patent Interference No. [interference number]

[TITLE OF PAPER]

Form 2. Typical schedule for motions

----- <i>These times typically can be changed by stipulation</i> -----	
TIME PERIOD 1	6 weeks
File substantive motions	
File (but serve one week later) priority statements	
TIME PERIOD 2	3 weeks
File responsive motions to motions filed in TIME PERIOD 1	
TIME PERIOD 3	6 weeks
File oppositions to all motions	
TIME PERIOD 4	6 weeks
File replies	
TIME PERIOD 5	6 weeks
File request for oral argument	
File motions to exclude	
File observations	
TIME PERIOD 6	3 weeks
File oppositions to motions to exclude	
File response to observations	
----- <i>These times cannot be changed by stipulation</i> -----	
TIME PERIOD 7	2 weeks
File replies to oppositions to motions to exclude	
TIME PERIOD 8	1 week
File exhibits	
File sets of motions	
TIME PERIOD 9	2 weeks
Present oral argument	

APPENDIX OF FORMS

Form 3. Typical schedule for priority motions in an interference

These times typically can be changed by stipulation

TIME PERIOD 11	6 weeks
Junior party only file priority brief and serve (but do not file) priority evidence	
TIME PERIOD 12	6 weeks
Senior party only file priority brief and serve (but do not file) priority evidence	
TIME PERIOD 13	6 weeks
File opposition to priority briefs Serve (but do not file) opposition evidence	
TIME PERIOD 14	6 weeks
File reply Serve (but do not file) reply evidence	
TIME PERIOD 15	6 weeks
Request hearing File list of issues to be considered File observations File motion to exclude	
TIME PERIOD 16	3 weeks
File response to observations File opposition to motion to exclude	

The last time cannot be changed by stipulation

TIME PERIOD 17	2 weeks
File reply to opposition to motion to exclude	
TIME PERIOD 18 (Last Time)	1 week
File and serve the exhibits File sets of priority motions	
TIME PERIOD 19	2 weeks
Present oral argument	

Form 4. File copy request

FILE COPY REQUEST
Contested Case No. [Contested Case number]

Attach a copy of section E of the DECLARATION to this REQUEST. On the copy, circle each patent and application that you are requesting.

Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. _____
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box because file copies are sent by commercial overnight courier).

3. Telephone, including area code: _____

APPENDIX:
CROSS EXAMINATION GUIDELINES

CROSS EXAMINATION GUIDELINES

Introduction

Cross examination can be a useful tool for determining the facts in a case. In contested cases, direct testimony is usually presented by affidavit, Bd. R. 157(a), while cross examination occurs by oral deposition. Bd. R. 157(b).

Cross examination should be a question-and-answer conversation between the examining lawyer and the witness. The defending lawyer must not act as an intermediary, interpreting questions, deciding which questions the witness should answer and helping the witness formulate answers. The witness comes to the cross examination to be questioned. It is the witness, and not the lawyer, who is testifying.

The cross-examination guidelines below are essentially the deposition guidelines set out in *Hall v. Clifton Precision*, 150 F.R.D. 525 (E.D. Pa. 1993) (Gawthrop, J.) The only significant difference, which results from Bd. R. 157(e)(4), is that certain objections must be noted on the record.

Failure to adhere strictly to these guidelines may be a basis for a sanction under Bd. R. 128, which could include a requirement that the witness, on very short notice may be directed to appear before the Board or elsewhere, as may be appropriate, coupled with any appropriate award of compensatory damages under Bd. R. 128(b)(6). In addition, cross examination undertaken contrary to these guidelines may result in exclusion of an affidavit from evidence or in the assignment of little, if any weight, to the direct testimony of a witness who was cross examined.

Guideline [1]

At the beginning of a cross examination, the party conducting the cross examination must instruct the witness on the record to ask deposing counsel, rather than the witness's own counsel, for clarifications, definitions or explanations of any words, questions or documents presented during the cross examination. The witness must follow these instructions.

Guideline [2]

A party may not direct or request that a witness not answer a question unless:

- (a) a party has objected to the question on the ground that the answer would:
 - (1) reveal privileged material or
 - (2) violate a limitation the Board has imposed and
- (b) counsel immediately places a conference call to the Board official assigned to the contested case asking for a ruling on the objection.

Under these circumstances, (i) the cross examination shall be suspended, (ii) the conference call immediately shall be placed to the Board official assigned to the contested case, and (iii) all counsel must be prepared to explain their respective positions during the call. The court reporter for the cross examination shall be available to record the conference call and to read back questions to which an objection has been made.

If the Board cannot be reached, then the party directing a witness not to answer shall, within **two (2) business days**, deliver by hand (SO ¶ 4.2), overnight service (SO ¶ 4.3), or facsimile (SO ¶ 4.5) directly to the Board, and not to the Office Mail Room or any other part of the Office, a miscellaneous motion seeking relief. Bd. R. 121(a)(3). Any opposition must be hand delivered to the Board within **two (2) business days** of service of the motion. While a reply can be filed, the motion is likely to be decided before it is filed.

Guideline [3]

Counsel must not make objections or statements that even remotely suggest an answer to a witness. Any objection to evidence during cross examination must be stated concisely and in a non-argumentative and non-suggestive manner and must include the legal basis for the objection. Examining counsel must not address the correctness of an objection, but may instead continue with questions to the witness, the objection having been noted on the record as required under Bd. R. 157(e)(4).¹

Guideline [4]

Counsel and their witness-clients shall not engage in private, off-the-record conferences during cross examinations or during breaks or recesses, except for the purpose of deciding whether to assert a privilege.²

Guideline [5]

Any conferences that occur pursuant to, or in violation of, guideline [4] are a proper subject for inquiry by deposing counsel to ascertain whether there has been any witness-coaching and, if so, the nature of that coaching.

Guideline [6]

Any conferences that occur pursuant to, or in violation of, guideline [4] shall be noted on the record by the counsel who participated in the conference. The purpose and outcome of the conference shall also be noted on the record.

Guideline [7]

Counsel taking cross-examination shall provide to defending counsel a copy of all documents shown to the witness during the cross examination. The copies shall be provided either before the cross examination begins or contemporaneously with the

¹ With respect to this guideline, the following observation by Judge Gawthrop, 150 F.R.D. at 530 n.10, is highly relevant:

I also note that a favorite objection or interjection of lawyers is, "I don't understand the question; therefore the witness doesn't understand the question." This is not a proper objection. If the witness needs clarification, the witness may ask the deposing lawyer for clarification. A lawyer's purported lack of understanding is not a proper reason to interrupt a deposition. In addition, counsel are not permitted to state on the record their interpretations of questions, since those interpretations are irrelevant and often suggestive of a particularly desired answer.

By way of example, the following comments by defending counsel generally are viewed as suggesting an answer to a witness:

- (a) Objection, vague.
- (b) Objection to the form of the question.
- (c) Take your time in answering the question.
- (d) Look at the document before you answer.
- (e) Counsel, do you want to show the witness the document?

² The term "witness-clients" in the context of this guideline includes all witnesses who are employed by, or otherwise under the control of, the real party-in-interest, including retained expert witnesses, as well as the individual or individuals named in the caption of the contested case. With respect to this guideline, the following observation by Judge Gawthrop, 150 F.R.D. at 528, is highly relevant:

The fact that there is no judge in the room to prevent private conferences does not mean that such conferences should or may occur. The underlying reason for preventing private conferences is still present: they tend, at the very least, to give the appearance of obstructing the truth.

CROSS EXAMINATION GUIDELINES

showing of each document to the witness. The witness and defending counsel do not have a right to discuss documents privately before the witness answers questions about the documents.

APPENDIX:
INDEX OF TIMES

Index of Times

Times running from initiation/declaration

Notice of lead and backup counsel (Bd. R. 108(b))	14 days
Clean copy of claims (Bd. R. 110(a))	14 days
Notice of real party-in-interest (SO ¶ 3.1)	14 days
Notice of related proceedings (SO ¶ 3.2)	14 days
Request for file copies (SO ¶ 11)	14 days
Annotated copy of claims (Bd. R. 110(b))	28 days
Notice of confidential information (SO ¶ 1)	2 months
Initial settlement conference (SO ¶ 18.2)	3 months

Default times before a triggering event

Service of demonstrative exhibit for oral argument (Bd. R. 124(d))	5 business days
Notice of transcription of oral argument (SO ¶ 16.2)	1 business day
End of cross examination before opposition or reply (SO ¶ 22.1.2)	10 days
List of documents and things for cross examination before conference call (Bd. R. 157(c)(3))	3 business days
Notice of deposition (Bd. R. 157(c)(4))	2 business days
Conference call regarding interpreter for deposition (Bd. R. 157(d))	5 business days

Default times after a triggering event

Notice of change in real party-in-interest (Bd. R. 8(a)(1)) 20 days

Notice of change in related proceedings (Bd. R. 8(a)(2)) 20 days

Notice of missing or incomplete copies (Bd. R. 109(c)) 21 days

Notice of change in counsel (SO ¶ 10) 14 days

Service of requested automatic discovery materials (Bd. R. 150(b)(1)) 21 days

Objection to admissibility of evidence (Bd. R. 155(b)(1)) 5 business days

Service of supplemental evidence (Bd. R. 155(b)(2)) 10 business days

Start of cross examination of affiant (SO ¶ 22.1.1) 21 days

Opposition to motion (other than miscellaneous motion) (Bd. R. 123(a)(1)) 30 days

Reply to opposition (other than miscellaneous motion) (Bd. R. 123(a)(2)) 30 days

Responsive motion (Bd. R. 123(a)(3)) 30 days

Opposition to miscellaneous motion (Bd. R. 123(b)(2)(i)) 5 business days

Reply to opposition to miscellaneous motion (Bd. R. 123(b)(2)(ii)) 3 business days

Request oral argument (Bd. R. 124(a)) 5 business days

Request for rehearing of decision (Bd. R. 125(c)(1)) 14 days

Identification of arbitrator after arbitration agreement (Bd. R. 126(a)(3)(iii)) 30 days

Copy of executed arbitration agreement (Bd. R. 126(b)(4)) 20 days

Arbitration award after date of award (Bd. R. 126(d)(4)) 20 days

Settlement conference after substantive motions decision (SO ¶ 18.3) 2 months

Request for rehearing of judgment (Bd. R. 127(d)) 30 days

Notice of judicial review (Bd. R. 8(b)) 20 days