# HOW TO REDACT AN EXHIBIT FOR USE IN AN INTERFERENCE

By

Charles L. Gholz[1, 2]

## I. Introduction

Neither the rules nor the Trial Section's standing order provide any guidance concerning how to redact an exhibit for use in an interference. In my experience, the parties have simply done it, and nobody has made an issue of it--until recently.

In Ginter v. Benson, interference No. 105,193,[3] Ginter submitted a number of redacted exhibits. For reasons that I will not go into, we suspected that the redacted portions of those exhibits contained statements that would support our arguments. Accordingly, we submitted two motions[4] asking for an order compelling Ginter to

---

[1] Partner in and head of the Interference Section of Oblon, Spivak, McClelland, Maier & Neustadt. My direct dial telephone number is 703/412-6485, and my email address is CGHOLZ@OBLON.COM.



[3] In the exercise of candor, I disclose that my colleagues Michael Casey, Todd Baker, Kurt Berger, and I represent Benson in this interference. Linda Thayer, Megan Sugiyama, and Jerry Voight of Finnegan, Henderson Farabow, Garrett & Dunner's Palo Alto office represent Ginter.

[4] The first motion was a 37 CFR 1.687(c) discovery motion. The second motion was a 37 CFR 1.635 motion asking for production of the unredacted copies before cross-examination of the relevant witnesses pursuant to 37 CFR 1.687(b) as "interpreted" in Rivier v. Coy, 12 USPQ2d 1231 (PTOBPAI 1989).

produce unredacted copies of those exhibits. In the course of a conference call discussing those motions, APJ Jameson Lee had some very interesting things to say about the proper way to go about redacting an exhibit for use in an interference.

## II. What Judge Lee Said and Did

According to a statement by Judge Lee during a conference call in Ginter v. Benson,[5] an exhibit cannot be redacted unless, prior to submitting the exhibit, either (1) the opposing party has stipulated to its submission in redacted form or (2) the unredacted exhibit and the proposed redacted exhibit have been submitted to the APJ in camera and the APJ has ruled that the exhibit can be submitted in redacted form.

Subsequently, in Cone v. Kain, interference No. 105,236,[6] a similar issue arose (except that this time it was my client who wished to use a redacted copy of an exhibit). During a conference call Judge Lee ordered me to submit to him for in camera inspection copies of the unredacted exhibit and the exhibit with the proposed redactions. He indicated that, if the only redactions were the ones that I described during the conference call, he would authorize the filing of the redacted exhibit.

---

[5] He made this statement during a conference call in Ginter v. Benson.

[6] In the exercise of candor, I disclose that my colleague Todd Baker and I represent Cone in this interference. Richard Lazarus, Mark Newman, and Perry Palan of Barnes & Thornburg's Washington office represent Kain.

However, he subsequently indicated that he was putting the proposed redacted exhibit in the file immediately--where, of course, opposing counsel could see it.[7] When I sent him an email (copy to opposing counsel) asking him to:

> Please instruct your staff that, despite the fact that you are entering Cone's proposed exhibit in the file, Kain is not entitled to see that proposed exhibit until after the actual exhibit has been filed and a copy served on Kain.

Judge Lee responded (also by email) as follows:

> That is going to be too tall an order for us to fill, based on our track record for keeping 608(b) statements secure until the proper time. I cannot make a promise that I'm quite certain can be easily broken.
>
> If you insist on keeping the proposed exhibit undisclosed, call me and we will have to work it out. The issue, as I see it, is that party Kain has to have some way of knowing that the redacted exhibit you will eventually file

[7] The exhibit is a bill from the attorney who prepared the application setting forth the dates on which and the amounts of time he spent preparing the patent application. Since we have not yet served our priority evidence, including our evidence with respect to attorney diligence, we did not want opposing counsel to see even the redacted version of that bill.

(assuming that I will approve the redaction) is the same thing as the proposed exhibit that I supposedly will review some time today. They have no way of knowing whether that is true unless your redacted version is placed on file today so that it can be compared with what you will ultimately file later. While I have no reason whatsoever to think that any counsel or party would make a "switch," the Board should not approve a process with such vulnerabilities.

Unless you come up with a reasonable alternative that takes care of the problem for the opposing party, you may have to disclose the redacted version now, or live with "unredaction." The choice is yours.

Or, if you will live with representation from opposing counsel that they will not attempt to see your redacted exhibit before it is served on the opposing party, that might work. What do you think, Mr. Lazarus?

I responded that:

I would be perfectly willing to live with a representation from opposing counsel that they will not attempt to see the proposed exhibit until after they are

> served with the actual exhibit--at which time they can check the two documents to verify that they are the same.

And Judge Lee responded that:

> Note that the representation would be from counsel to counsel, not one to the board or the APJ. Whatever form it should take, oral or written, is per your own agreement that I need not know about. There also is no need to file the representation. The board will simply enter the proposed exhibit, when you let me know it is O.K.
>
> I do not want to know about your agreements. Just let me know if and when to enter the proposed redacted exhibit.

In this case Mr. Lazarus and I were able to work things out to our mutual satisfaction.

III. Comments

I think that what Judge Lee said in Ginter v. Benson makes perfect sense. I only regret that he did not put it in a publishable (or, at least, quotable) order--or, better yet, get it put in the standing order.

However, I am unhappy with how he implemented his policy in Cone v. Kain. Why did he rule that "the representation would be from counsel to counsel, not one to the board or the APJ?" His email did not say, and I strongly believe that the representation should have been to the APJ, acting on behalf of the board.

In this connection, I invite the reader's attention to the holding in Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) (Rich, J.):

> although other courts would be the proper tribunals in which to litigate a cause of action for enforcement or breach of the contract here involved, that is not sufficient reason for the board to decline to consider the agreement, its construction, or its validity if necessary to decide the issues properly before it in this cancellation proceeding, including the issue of estoppel.[8]

However, the reader should also review Goodsell v. Shea, 651 F.2d 765, 210 USPQ 612 (CCPA 1981), which I think is irreconcilable with Selva & Sons. Of course, Goodsell, being a unanimous CCPA decision, theoretically remains the law despite its inconsistency with Selva & Sons.[9] However, I believe that Selva & Sons is much the better reasoned opinion and that, ultimately, the Federal Circuit will resolve the conflict in favor of Selva & Sons.

[8] 705 F.2d at 1324, 217 USPQ at 647.

[9] South Corp. v. United States, 690 F.2d 1368, 215 USPQ 657 (Fed. Cir. 1982) (in banc).