

**SUPPLEMENT TO “INTERFERENCE PRACTICE STRATEGIES,”  
85 JPTOS 529 (2003)<sup>1</sup>**

By

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## I. **Introduction**

When I delivered my paper entitled “Interference Practice Strategies” to the 18<sup>th</sup> Annual Intellectual Property Law Conference of the Intellectual Property Law Section of the American Bar Association on April 4, 2003 and when I submitted that paper for publication to this journal, we were operating under the 20 September 2000 version of the Trial Section’s Standing Order. However, on 1 May 2003 the Trial Section promulgated a new Standing Order.<sup>3</sup> This article comments briefly on the new Standing Order.

## II. **Transitional Problems**

The new Standing Order does not address the transitional problems created by the fact that there are now two Standing Orders in effect. However, the interference bar has been advised informally (1) that the new Standing Order governs all interferences declared on or after 1 May 2003 and (2) that the APJs in the Trial Section will be making portions of the new Standing Order applicable to pending interferences and sections of the old Standing Order inapplicable to pending interferences on a case-by-case and section-by-section basis.

## III. **No Ex Parte Contacts With the Trial Section**

According to Section 1.1 of the new Standing Order:

Communications with an administrative patent  
judge relating to an interference shall be *inter partes* in  
which at least one counsel for each party shall participate.

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<sup>3</sup> The new Standing Order can be found on the PTO’s web site at [uspto.gov/web/offices/dcom/bpai/standing.pdf](http://uspto.gov/web/offices/dcom/bpai/standing.pdf)

Any attempt to initiate an *ex parte* telephone call, e-mail, or other form of communication to an administrative patent judge in connection with an interference may result in sanctions.

The trouble with that is that occasionally opposing counsel refuse to participate in a conference call with the APJ. However, when that situation has arisen in the past, I have simply explained it, either to one of the members of the Trial Section's support staff or to the APJ, and the conference call has proceeded in the absence of opposing counsel—with the APJ duly noting the reason for the absence of opposing counsel in his or her summary of the conference call.

#### IV. **Real Party in Interest**

Section 5 of the new Standing Order reads as follows:

Within **fourteen (14) days** of the date of the NOTICE DECLARING INTERFERENCE, each party shall notify the board in a separate paper of any and all right, title, and interest in any application or patent involved in the interference (37 CFR § 1.602(b)).

All parties are continually obligated to promptly update changes of the real party in interest.

Note that section 5 still does not track the language of 37 CFR 1.602(b) which reads as follows:

The parties, within 20 days after an interference is declared, shall notify the Board of any and all right, title, and interest in any application or patent involved or relied upon in the interference unless the right, title, and interest is set forth in the notice declaring the interference.

The latter but not the former requires interferences to notify the board of any and all right, title, and interest “in any application...relied upon in the interference...” Is the language of 37 CFR 1.602(b) no longer operative?

Also, section 5 still does not make it clear whether or not the board deems a license (whether exclusive or non-exclusive) to be a “right...[or an] interest” in an application or patent.

**V. Citation to the Commissioner’s Decisions**

Section 11.2 of the new Standing Order says that court reporters other than West Publishing Company’s Supreme Court Reporter, the second and third series of West’s Federal Reports, and the first and second series of the USPQ “are not available at the board.” However, I think that we can rest assured that the members of the Trial Section have access to a set of the Commissioner’s Decisions.

**VI. Request for Leave to Take Testimony to Supplement a Motion, Opposition, or Reply**

Section 13.4.3 of the new Standing Order says that “a request...for leave to take testimony...to support a 37 CFR § 1.633 preliminary motion, opposition or reply...shall be made by a 37 CFR § 1.635 miscellaneous motion filed sufficiently before the 37 CFR §1.633 preliminary motion, opposition or reply is due so the testimony (i.e., affidavit or

transcript of any deposition) can be served with the 37 CFR 1.633 preliminary motion, opposition or reply.” Of course, that is not possible if the opponent opposes the 37 CFR 1.635 motion and the APJ has to rule on that motion after the normal briefing.

Accordingly, this section must be read in conjunction with section 13.10.1, which requires the proponent of a contested 37 CFR 1.635 motion to “arrange a conference call to [sic; with?] the administrative patent judge designated to handle the interference.” The APJ will normally rule on the contested motion during the conference call and, if necessary, set the periods for the taking of the testimony.

#### **VII. Preliminary Motions to Designate Claims As Corresponding to a Count**

Section 13.4.7 of the new Standing Order says that a 37 CFR 1.633(c) motion seeking to have one of the movant’s claims designated as corresponding to a count shall establish that the claim covers the same patentable invention “as an opponent’s claim that the party [i.e., the movant] agrees corresponds to the count.” Why isn’t it enough to establish that the movant’s claim covers the same patentable invention as one of the movant’s claims already designated as corresponding to the count that the movant agrees corresponds to the count? Since 37 CFR 1.633(c)(3) motions to designate as corresponding to a count a claim that stands designated as not corresponding to that count normally are addressed to an opponent’s claim, I think that this section should also cover what must be shown to support a 37 CFR 1.633(c) motion seeking to have one of the movant’s opponent’s claims designated as corresponding to the count.

In addition to the foregoing, my colleague retired APJ Rollins pointed out to me that that section 13.4.7 of the new Standing Order is inconsistent with both 37 CFR 1.637(c)(2), which states that “A preliminary motion seeking to amend an application

claim corresponding to a count or [to] add[] a claim to be designated to correspond to a count shall... Show that the claim proposed to be amended or added defines the same patentable invention AS THE COUNT” (emphasis supplied), and 37 CFR 1.637(c)(3), which states that “A preliminary motion seeking to designate an application or patent claim to correspond to a count shall... Show [that] the claim defines the same patentable invention as ANOTHER CLAIM [in either or any party’s case in interference] WHOSE DESIGNATION AS CORRESPONDING TO THE COUNT THE MOVING PARTY DOES NOT DISPUTE.” (Emphasis supplied.) Are both of these sections of the CFR now inoperative?

**VIII. A Preliminary Motion Asking for a Judgment that There Is No Interference in Fact**

Section 13.4.8 of the new Standing Order sets forth the requirements for a motion alleging that there IS an interference-in-fact, but most interference-in-fact motions request a judgment that there ISN’T an interference-in-fact. In fact, since by definition an interference is already pending when one files one’s preliminary motions, would one **ever** need to file the type of motion apparently contemplated by this section?

**IX. Length of Motions, Oppositions, and Replies**

Section 13.5 of the new Standing Order states the maximum lengths of motions, oppositions, and replies “not including any certificate of service.” I suggest that the Trial Section should also exclude the lengths of the tables of contents in its very short maximum lengths—since the failure of Section 13.5 to do so discourages parties from including tables of contents, which is a shame.

## X. **New Issues in Replies**

Section 13.7 of the new Standing Order indicates that we cannot include with our replies “new evidence that...could have been included with the motion.” I think that that is a mistake. Sometimes a movant will not include with its motion evidence that is physically available to it because that evidence is not necessary to make out a prima facie case in support of the motion but still will want to appropriately rely on that evidence in response to an opponent’s argument in its opposition.

## XI. **Motions to Add Another Case Owned by an Opponent to an Interference**

Section 13.10.3.1 of the new Standing Order (governing 35 CFR 1.635/1.642 motions) incorporates by reference the procedures applicable to garden variety 35 CFR 1.635 motions, including the very stringent time limits. However, since oppositions to such motions often require serious thought and the support of declarations from expert witnesses, and since such motions are, in essence, 37 CFR 1.633(c) motions in disguise, I submit that the time periods for such motions should be the same as the time periods for 37 CFR 1.633(c) motions—as several of the APJs have recognized by individual orders.

## XII. **Depositions Outside the U.S.**

Section 14.4 of the new Standing Order still recites that cross-examination shall take place at a reasonable location “within the United States.” Not only is that requirement contrary to the CFR, it does a disservice to the Trial Section’s “customers.” It is sometimes more convenient for interferences to take cross-examination abroad than it is to truck the witnesses to the United States. See Gholz, “Producing Witnesses in an Interference for Cross-Examination Abroad,” 7 Intellectual Property Today No. 5 at page 6 (2000).



### **XIII. Submission of Entire Application Files as a Single Exhibit**

Section 14.8 of the new Standing Order states “Do **not** submit an entire application file as a single exhibit.” (Emphasis in the original.) However, not only is it far more convenient for counsel and witnesses to have entire application files as single exhibits during depositions, but one of the APJs told me that it is also more convenient for her to have entire application files as single exhibits.

### **XIV. Settlement Conferences**

Section 15.2 of the new Standing Order states that, “Prior to initiating any conference call required by this section, the parties are required to file (preferably by facsimile) a joint statement indicating that a good faith effort has been made to settle the interference.” However, not only is it sometimes difficult to get a recalcitrant opposing counsel to sign a joint statement, but this paper is an utter waste of file space. If the counsel have talked but not reached settlement, it should be enough to so inform one of the Trial Section’s support staff, at which point the APJ will normally dispense with the otherwise obligatory time-wasting conference call.

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