

A SUGGESTION FOR SAVING TREES--AND FILE SPACE
AT THE BOARD

By

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I. Introduction

The current acting CAPJ and his predecessor have complained publicly about the burden that the voluminous papers that members of the interference bar sometimes file places upon the board's limited file space. In fact, I seem to remember one of them ascribing the draconian limits that the Trial Section has placed on the lengths of motions, oppositions, and replies to a shortage of file space at the board.

However, notwithstanding whatever shortage of file space may exist at the board, I respectfully submit that one of the board's own policies (a policy which it could change!) enormously exacerbates the problem.

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II. **LeVeen v. Edwards**

LeVeen v. Edwards, 57 USPQ2d 1406, 57 USPQ2d 1416 (PTOBPAI 2000) (expanded panel) (per curiam; panel consisting of SAPJ McKelvey and APJs Schafer, Lee, Torczon, Gardner-Lane, and Medley),³ held that putting one's arguments in the declaration(s) of one's expert witness(es), which are not subject to a page limitation, is impermissible.

According to the panel, putting the anticipation and obviousness arguments into the declaration of the expert witnesses was contrary to the Trial Section's ban on incorporation by reference:

Edwards, contrary to ¶ 13 of the NOTICE DECLARING INTERFERENCE, has incorporated "arguments" from the Siperstein and Sheehan declarations (Exs 5010 and 5015) into Edwards preliminary motion 1. Edwards misperceives the role of motions and evidence. Declarations are evidence. A motion is supposed to (1) lay out all relevant facts, with reference to the evidence which supports the facts, and (2) present an argument why the facts justify any relief requested in the motion.⁴

³ In the interest of complete candor, I note that my colleagues James R. Boler, W. Todd Baker, and I represented Edwards. LeVeen was represented by Edward J. Keeling of Townsend and Townsend and Crew LLP.

⁴ 57 USPQ2d at 1412.

The panel also explained that putting the arguments into the expert witnesses' declarations required it to "scour the record"⁵ and permitted Edwards to "avoid page limitations applicable to motions."⁶

III. Comments

(1) In requests for reconsideration of the decisions with respect to both motions, we argued that the references in the motions to the declarations of the expert witnesses were not incorporations by reference as that term has been used in the case law, citing In re de Seversky, 474 F.2d 671, 674, 171 USPQ 144, 146 (CCPA 1973) (Rich, J.) ("a mere reference to another application, or patent, or publication, is not an incorporation of anything therein into the application containing such reference for the purposes of the disclosure required by 35 U.S.C. 112"; emphasis in the original). In an unreported opinion, the expanded panel rejected that argument for two reasons. First, it said that "Edwards should look to the Notice of Declaration, not the case law, to understand what was meant." Second, it said (a) that de Seversky "provid[es] that incorporation by reference requires a statement 'clearly identifying the subject matter which is incorporated and where it is to be found'" and (b) that:

⁵ 57 USPQ2d at 1412. The panel also asserted that "Edwards' effort totally sandbagged its opponent." 57 USPQ2d at 1412. However, LeVeen had not complained that Edwards's putting its arguments into its expert witnesses' declarations had caused it any inconvenience, and, in fact, it put its own arguments into the declaration of its own expert witness--where Edwards's counsel had no difficulty finding and responding to them.

⁶ 57 USPQ2d at 1412.

Edwards' specific reference to Section IV of the declarations and the fact that the arguments on unpatentability are supplied by the declarations rather than the motion, indicates that Section IV of the declaration was to become part of the motion "as if it were fully set out therein."

(2) Interestingly, in another opinion that we received subsequently from a pre-Trial Section panel of the board, the panel complained about the fact that arguments contained in the declarations of the expert witness were repeated verbatim in the motion, thereby requiring the panel to read the arguments twice.

IV. **The Effect of LeVeen v. Edwards**

In comparison to what has ensued, the imposition on its time that the pre-Trial Section panel of the board complained about was nothing! When the holding in LeVeen v. Edwards is coupled with the Trial Section's profound aversion to "mere attorney argument," what I have been seeing is the same arguments repeated three times--once in the expert witness (or witnesses) declaration (or declarations), once in the statement of material facts, and once in the argument. This is ridiculous--but arguably compelled by the Trial Section's policies.⁷

⁷ I personally only repeat my arguments twice--once in the declaration or declarations of my expert witness or witnesses and once in my statement of material facts. However, I have great respect for one of my more verbose opponents, and readily acknowledge that

V. My Suggestion for Dealing with the Problem

My suggestion for dealing with the problem is to overrule LeVeen v. Edwards. As I previously pointed out, what I did in that case did not confuse my opponent in the least, and I'll be darned if I see how it required Their Honors to "scour the record." Moreover, putting the technical arguments only where, I submit, they belong (that is, in the declarations of the expert witnesses) would save Their Honors (and counsel) time, would save shelf space at the board--and would even save a tree or two a year!

her practice may prove to be correct (in the view of one or more members of the Trial Section) and that my practice may prove to be wrong.

I do note, however, that the 250-page priority brief which she recently filed clearly annoyed the APJ to whom she submitted it.