

How Detailed Does Your List of Proposed Motions Have to Be?¹

by

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Introduction

In Gholz, A Critique of Recent Opinions in Patent Interferences, 89 JPTOS 1 (2007)

§X.E.3, “A Proposed Motions List Must Be Complete, but It Needn’t Be Precise,” I wrote:

Some of the APJs are cracking down vigorously on the tendency of some practitioners to file motions that expand upon the motions listed in their list of proposed motions without obtaining advance authorization to do so.³

Since then, there have been a number of related developments.

Karim v. Jobson

Karim v. Jobson, 82 USPQ2d 1018 (PTOBPAI 2006) (non-precedential) (opinion by SAPJ McKelvey for a panel that also consisted of APJs Torczon and Tierney), continues this trend.

After the scheduling conference call, Jobson had moved for leave to file two additional substantive motions. In an unusually stinging opinion, the panel turned Jobson down--on two separate and independent grounds.

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³ 89 JPTOS at 24.

First, there was no evidence (in the form of declarations or documents) supporting various material allegations concerning why the motions in question hadn't been proposed in Jobson's list of proposed motions. According to the panel:

Because Jobson did not present any evidence in support of some of its material factual allegations which are legitimately contested by Karim, and since the relief Jobson requests is bottomed on those allegations, it follows that Jobson has failed to present a record which would justify the relief it requests.⁴

Second, and more substantively, the allegations contained in the motion were found to be woefully deficient even if they had been proven. Jobson's principal "excuse" for not having listed the two additional motions in its list of proposed motions was that it had not "conducted its first meeting with its technical expert in this proceeding"⁵ until after the scheduling conference. That "excuse" clearly infuriated the SAPJ. After setting forth a very helpful (but non-exhaustive) list of eleven factors to be considered in deciding whether or not to grant such motions, the opinion finds that each factor was either neutral or weighed against Jobson. That discussion can be summarized as follows:

A motions list is not an evolving document which can be expanded at the whim of party....⁶

Papayannopoulou v. Masinovsky

In Papayannopoulou v. Masinovsky, 82 USPQ2d 1147 (PTOBPAI 2006) (non-precedential) (opinion by APJ Tierney for a panel that also consisted of SAPJ McKelvey and APJ Torczon), the panel applied the standards set forth in Karim v. Jobson and actually granted a

⁴ 82 USPQ2d at 1022.

⁵ 82 USPQ2d at 1021.

⁶ 82 USPQ2d at 1021.

motion to substitute a new motions list!

The Papayannopoulou's patent was assigned to the University of Washington and licensed to Biogen Idec Inc. Papayannopoulou's first two lead counsels were nominated by Biogen; its third lead counsel was nominated by the University. Papayannopoulou's claims read on two things, while Masinovsky's claims read on one thing--which Papayannopoulou alleged was "separately patentable" relative to Papayannopoulou's two things. The APJ originally authorized (1) Papayannopoulou to file (a) motion for judgment of no-interference-in-fact and (b) a motion for judgment that Masinovsky's claims were invalid for lack of written description and/or enablement and (2) Masinovsky to file a motion to deny Papayannopoulou the benefit of the filing date of an earlier filed U.S. application. At that time, Papayannopoulou was represented by one of the lead counsels nominated by Biogen.

The lead counsel nominated by the University sought leave to substitute a list of proposed motions that included only a motion to substitute a new count, which he explained would "limit the Count to the common subject matter sought by the parties..."⁷ He also indicated that, if the motion to substitute were granted, he wouldn't file the two motions originally authorized. Judge Tierney explained Papayannopoulou's change of position as follows:

The Board is of the understanding that the assignee of Papayannopoulou '438 patent, the University of Washington, believes that its corresponding claims encompass two distinct antibody inventions and was concerned that counsel for the licensee would not take sufficient steps to protect the University of Washington's interest in the antibody that was not the subject of the interference.⁸

Masinovsky opposed Papayannopoulou's motion, arguing that:

⁷ 82 USPQ2d at 1150.

⁸ 82 USPQ2d at 1150.

allowing Papayannopoulou to file its motion to substitute a count is prejudicial to Masinovsky as Papayannopoulou was able to reformulate its motions list based upon a review of Masinovsky's list.⁹

The panel granted Papayannopoulou's motion. As explained by Judge Tierney:

Unlike Karim's list, Papayannopoulou's revised list of motions simplifies the issues to be decided in this interference. *** Papayannopoulou's proposed motions raise issues similar to those in its original list while avoiding a debate over whether or not Masinovsky's involved specification provides suitable §112, 1st paragraph written descriptive support and/or enables Masinovsky's involved claims.

Additionally, the issues raised by Papayannopoulou's proposed motions are similar to those previously raised by Papayannopoulou's authorized motion for no interference-in-fact and by Masinovsky's motion attacking Papayannopoulou's accorded priority benefit. Further, Masinovsky would remain entitled to oppose the motions on their merits. Accordingly, granting Papayannopoulou authorization to file its proposed motions and not those originally authorized does not unduly prejudice Masinovsky.

Finally, and perhaps most interestingly, Judge Tierney offered the following comment on Papayannopoulou's change of counsel:

Papayannopoulou has twice changed its designated counsel in this interference. (Paper Nos. 4, 17 and 23). The fact that Papayannopoulou changed its counsel after it had already received authorization from the Board to file its 1) motion for no interference-in-fact, and 2) motion attacking Masinovsky's patentability, did not factor into the analysis of whether Papayannopoulou's revised motions list would be authorized. Specifically, where a party in interference changes counsel, the party remains responsible for the previous acts of its lawyer-agent. *Huston v. Ladner*, 973 F.2d 1564, 1566, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992).

Judge McKelvey's Solution

⁹ 82 USPQ2d at 1150.

Judge McKelvey came up with a characteristically innovative solution to the problem of knowing how much one has to put into a list of proposed motions.¹⁰ In a declaration that I recently received in Ohsumi v. Yamagishi, Int. No. 105,612, he specified that:

The following shall be included in motions lists.

(1) Proposed motion for benefit (i.e., to be accorded an earlier constructive reduction to practice) must identify the application(s) for which benefit will be sought.

(2) Proposed motion to attack benefit must identify the application(s) to be attacked.

(3) Proposed motion seeking judgment against an opponent based on alleged unpatentability must identify the statutory basis for the alleged unpatentability and:

(a) if based on prior art, identify the prior art;

(b) if based on the first paragraph of 35 U.S.C. § 112, (i) identify whether written description, enablement or best mode will be the basis for the motion, and (ii) briefly identify the basis for any alleged unpatentability;

(c) if based on an alleged failure to comply with 35 U.S.C. § 135(b), briefly identify the reason;

(d) if based on the second paragraph of 35 U.S.C. §112, identify the limitation which is believed to be indefinite.

(4) Proposed motion based on no interference-in-fact shall briefly identify the reason no interference-in-fact is believed to exist.

(5) Proposed motion to designate additional claims as corresponding to a count or as not corresponding to a count shall identify the claims involved.

(6) Proposed motion to add or substitute a new count shall explain why the added or substitute count is necessary.

¹⁰ I am assuming that you want to put as little as possible into your list of proposed motions-- particularly if you're trying to settle the interference.

Comments

(1) Judge McKelvey's solution requires more information than I would like to give, but it requires information that I would like to receive!

(2) Billings in interferences have been front end loaded for years, and this development exacerbates that fact. You have to have your case well developed (not merely outlined) before filing your list of proposed motions. That means that you have to have retained your expert witness, done at least a first draft of the expert witness's declaration, found out whether or not the expert witness is willing to say what you want him or her to say, and, if not, either lowered your expectations or gone through the same routine with another expert witness.

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