

## “Good Cause” Under 37 CFR 41.202(d)(2)<sup>1</sup>

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### **Introduction**

37 CFR 41.202(d) requires an applicant seeking an interference with a patent or published application that has an earlier claimed priority date to “show [in its suggestion of interference] why it would prevail on priority,” at least as against the patent’s or published application’s earliest constructive reduction to practice. Ordinarily that showing is made as a part of the 37 CFR 41.202(a) suggestion of interference. If the APJ to whom the suggestion of interference is assigned for initial review decides that the showing makes a case which, if unrebutted, would entitle the applicant to an invention date prior to the presumptive invention date of the senior party, the APJ declares the interference, and the interference goes forward in the normal manner.

However, 37 CFR 41.202(d)(2) provides that, “[i]f 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.” In response to the order to show cause, the applicant has three options. First, it can argue that its initial showing was, in fact, good enough. Second, it can ask the APJ to authorize the filing of either a motion to “redefine the interfering subject matter [e.g., to designate as not corresponding to a count one or more of its claims that was or were initially designated as corresponding to the count in order to remove it from harm’s way] or

[a motion] to change the benefit accorded to the parties” (either to take away a benefit accorded the target patent or published application or to give the applicant the benefit of a filing date that is earlier than the filing date tentatively accorded to the target patent or published application). 37 CFR 41.202(d)(2). And, third, it can submit additional evidence in support of its priority showing—but only “on a showing of good cause.” Id. Under the third option, the applicant can get a “mulligan,”<sup>4</sup> but only if it has a darn good excuse for why it didn’t make a proper showing in the first place.

This paper discusses only the third option.

### **Pre-1985 Opinions Don’t Count!**

It has been said that interference practitioners are inordinately fond of citing old opinions—the older, the better. However, in this case, the pre-1985 opinions simply don’t count. That is because the 1984 amendments to the interference rules (effective Feb. 11, 1985) considerably jacked up the standards for obtaining a mulligan in this situation. Prior to 1985, the comparable rule said that, in response to an order to show cause, supplemental evidence could be submitted on a “showing in excuse of . . . [the] omission [of the supplemental evidence] from the original showing.” 37 CFR 1.228 (1984). Although even back then the board required some sort of excuse, the truth was that it was pretty easy to get the supplemental evidence in.

No more. The Notice of Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48,416, 48,423 (Dec. 12, 1984), makes it clear that the new language was deliberately chosen to impose a higher standard, the APJs have said so repeatedly,<sup>5</sup> and the Federal Circuit blessed the higher standard in Hahn v. Wong, 892 F.2d 1028, 1032, 13 USPQ2d 1313, 1316 (Fed. Cir. 1989).<sup>6</sup>

### **Excuses That Haven’t Been Accepted**

Perhaps the clearest teaching of the post-1985 opinions is that “I was busy” is not an acceptable excuse. As stated in Holmwood v. Cherpeck, 2 USPQ2d 1942, 1944 (PTOBPAI 1986) (opinion by EIC Sofocleous for an expanded panel that also consisted of EICs Calvert, Urynowicz, Torchin, and Boler), “We do not consider that the ‘press of time’ excuse constitutes a sufficient showing of ‘good cause’ within the meaning of 37 CFR 1.617(b)<sup>7</sup> as to why the additional evidence could not have been and was not presented with the original showing.”<sup>8</sup>

The second clearest teaching is that ignorance of counsel is no excuse. The leading opinions on that point are Hahn v. Wong, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989)(opinion by Senior Circuit Judge Friedman for a panel that also consisted of Senior Circuit Judge Baldwin and Circuit Judge Mayer),<sup>9</sup> and Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992)(majority opinion by Circuit Judge Lourie, joined by Circuit Judge Plager; dissent by Circuit Judge Newman).<sup>10</sup>

In Hahn v. Wong, the court emphatically approved the board’s holding that the proffered excuse that counsel “did not fully appreciate the kind of corroboration required to demonstrate a *prima facie* case for a complete reduction to practice before the filing date of the Party Wong”<sup>11</sup> failed “under the ‘strict standard’ of the new rules that ignorance of the ‘rules or the substantive requirements of the law’ does not constitute good cause.”<sup>12</sup>

In Huston v. Ladner, Huston argued unsuccessfully that its supplemental evidence should be considered because its prior counsel had “misrepresented to . . . [Huston’s assignee] his competence and ability to present Huston’s *prima facie* showing under 37 C.F. R. § 1.608(b) and because he acted in a reckless and grossly negligent manner in filing the original evidence.”<sup>13</sup> That argument failed at least in part on the ignorance-of-counsel-is-no-excuse ground. However, it is notable that neither the panel of the board nor the majority of the panel of the court ruled that

an attorney's misrepresentation of his or her competence to handle an interference and/or an attorney's acting in a reckless and grossly negligent manner, if proved, could not constitute good cause permitting an initial 37 CFR 1.618(b) showing to be supplemented. Instead, "The Board specifically found that Huston's claim of misrepresentation by the attorney as to his ability to make a *prima facie* showing of priority was unsupported by the evidence,"<sup>14</sup> and the majority of the panel of the court held that it could not say that that finding was an abuse of discretion.<sup>15</sup>

In dissent, Circuit Judge Newman asserted that the board had indeed abused its discretion because "[t]here was no reasonable support for the Board's summary finding that there was no attorney misrepresentation."<sup>16</sup> However, the fact that the majority of the court apparently based its decision on the rather surprising holding of the board that the prior counsel had not misrepresented his or her competence to handle the interference by consenting to be designated as lead counsel in the interference<sup>17</sup> led Mr. Gholz to conclude his 1993 write-up of Huston v. Ladner with the comment that:

It is unusual for a client to ask an attorney to represent specifically and in writing that he or she is competent to handle a matter. However, after *Huston* it might be a good idea for an interferent (or house counsel shopping for outside counsel) to do just that.<sup>18</sup>

Next, it is clear that, whatever the excuse, the underlying facts must be established in detail. Gaps in the evidence will not be excused, and ambiguities will not be resolved in the applicant's favor. As stated in Surabian v. Brecher, 16 USPQ2d 1312 (PTOBPAI 1990)(opinion by EIC Sofocleous for a panel that also consisted of EICs Tarring and Caroff):

With respect to the newly presented declaration of Surabian, the response [to the order to show cause] does not urge any reason why this declaration was not initially presented. With respect to the remaining declarants, the response merely states that they were not previously available; however, insufficient facts were submitted to substantiate this unavailability. With respect to Fuller, the response does not state what efforts were made to locate

him during the aforesaid five month period. With respect to Harold Surabian, Harold Surabian Jr. and DerSarkissian, the response states that these declarants are, respectively, Surabian's husband, son and sister and that the declarants were "out of town" or "away at school." We agree with Brecher that it seems incredible that Surabian could not have located these declarants in the five month period prior to the submission of the original declarations and have them present the declarations now being submitted. The response does not explain where these declarants were, how long they were gone[,] and [sic; or?] what attempts were made to locate any of them prior to the submission of the original showing. Indeed, if Surabian believed at the time of the submission of the original evidence under 37 CFR 1.608(b) that the declarations now presented from these declarants were necessary, she could have filed an affidavit based on information and belief. 37 CFR 1.608(b). Cf. *Golota v. Strom*, 489 F.2d 1287, 180 USPQ 396, 400 (CCPA 1974). Of course, Surabian would have had to show why any declarant was unavailable.<sup>19</sup>

After that, things become less clear.

Chaffee v. Skulnick, Int. No. 105,125, paper no. 34 at 17 (PTOBPAI 2004)(non-precedential)(opinion by APJ Lee for a panel that also consisted of APJs Schafer and Torczon), states (as an alternative holding) that the panel "reject[ed] Chaffee's argument . . . to the effect that the interference should be allowed to proceed because additional evidence [i.e., evidence not contained in Chaffee's initial showing] . . . is in the possession of Skulnick and can only be obtained through testimony [sic; discovery?]." According to the panel, Chaffee's argument:

amounts to a complete disregard of the requirements of 37 CFR § 1.608(b). In effect, Chaffee is saying that[,] while he does not have sufficient evidence to make out at least a prima facie case that he is entitled to priority relative to Skulnick, the interference should be allowed to proceed because he believes that[,] eventually[,] during the production of testimony during the interference[,] evidence in his favor will be revealed. We are without authority to relieve Chaffee from the requirements of 37 CFR § 1.608(b), and[,] even if we do have that authority, we can see no reason to apply 37 CFR § 1.608(b) to other junior party applicants who attempt to provoke an interference with a patentee but not to Chaffee.<sup>20</sup>

We disagree that the panel was “without authority” to give Chafee relief. It seems to us that 37 CFR 1.610(e), which empowered the APJ to whom an interference was assigned, to “determine a proper course of conduct in an interference for any situation not specifically covered by this part,” would have authorized the APJ to permit discovery designed to support Chafee’s allegation if Chafee had made an adequate showing that such evidence was indeed likely in the possession of Skulnick.<sup>21</sup>

### **Excuses That Have Been (or Might Be) Accepted**

In contrast to the number of cases in which proffered excuses under 37 CFR 41.202(d)(2) have been rejected, we have only been able to find three actual holdings accepting a proffered excuse and one opinion discussing two excuses that might be accepted.

The first opinion that we have found that actually accepts a proffered excuse as constituting “good cause” under 37 CFR 41.202(d)(2) is Holmwood v. Cherpeck, 2 USPQ2d 1942 (PTOBPAI 1986)(non-precedential)(opinion by EIC Sofocleous for an expanded panel that also consisted of EICs Calvert, Urynowicz, Torchin, and Boler). That case involved a question of whether an inference of “suppression or concealment” had been rebutted by an adequate showing of “Peeler diligence.”<sup>22</sup> According to the opinion:

Assuming that the compounds were useful as fungicides, then the evidence [submitted with the initial showing], which relates to testing prior to November 23, 1981, would establish, prima facie, actual reduction to practice at that time. Applicants, however, have not submitted any evidence of activity from that date until the filing of their patent application on August 28, 1984. The hiatus in time between the asserted date for reduction to practice and applicants’ filing date could be at least 33 months. This hiatus is sufficiently long to raise an inference of suppression or concealment by applicants. Cf. *Shindelar v. Holdeman*, 628 F.2d 1337, 207 USPQ 112 (CCPA 1980); *Klug v. Wood*, 212 USPQ 767 (Bd.Pat.Int. 1981). Thus, since *Holmwood et al.* have not submitted sufficient evidence to establish, prima facie, that they

made the invention prior to Cherpeck and that they have not abandoned, suppressed or concealed it as required by 35 USC 102(g), their showing is insufficient to prima facie entitle them to an award of priority with respect to the filing date of patentee Cherpeck. Accordingly, the showing is insufficient to meet the requirements of 37 CFR 1.608(b).<sup>23</sup>

Based on that 33-month hiatus, the EIC had issued an order to show cause why judgment should not be entered against Holmwood, and, in response, Holmwood had submitted additional evidence purporting to show Peeler diligence during the hiatus.<sup>24</sup> Cherpeck apparently argued that Holmwood should not have been permitted to submit the additional evidence because it had not shown “good cause” excusing its failure to submit that evidence with its initial showing. The panel rejected that argument, reasoning as follows:

As we noted above, Holmwood et al. were not necessarily required by 37 CFR 1.608(b) to present any evidence in their original showing on the question of suppression or concealment; however, the Examiner-in-Chief has the authority to raise sua sponte that question and to issue a show cause order thereon. Balancing the requirement of 37 CFR 1.608(b) vis-a-vis the Examiner-in-Chief’s issuance of a show cause order on that question, we must determine what constitutes a showing of “good cause” within the meaning of 37 CFR 1.617(b) to permit the consideration of additional evidence submitted for the purpose of overcoming the inference of suppression [or concealment]. In our view, only a minimal showing is required under those circumstances; in fact, the mere fact that an Examiner-in-Chief issues an order to show cause on a question of suppression or concealment is in itself normally a sufficient reason to permit an applicant to file such additional evidence in response thereto.<sup>25</sup>

Holmwood (and similar opinions) led the interference bar to request repeatedly that the rules be modified to explicitly require showings of Peeler diligence in the initial showings of priority filed to provoke an interference with an earlier filed patent or published application where the hiatus is longer than a given length (e.g., one year).<sup>26</sup> However, the PTO has not seen fit to act favorably on those requests. So, the two-step, totally unnecessary process exemplified by Holmwood v. Cherpeck still takes place from time to time.<sup>27</sup>

The second opinion that we have found that actually accepts a proffered excuse as constituting “good cause” under 37 CFR 41.202(d)(2) is Nathans v. Greene, 82 USPQ2d 1600 (PTOBPAI 2006)(non-precedential)(SAPJ McKelvey, not joined by any other APJ).<sup>28</sup> While the facts are not entirely clear from the opinion, apparently what had happened was that the examiner had forwarded the files to the BPAI with a recommendation that an interference be declared after Nathans had filed two 37 CFR 1.131 declarations in an attempt to overcome the Greene patent without ever expressly requiring Nathans to put it in a 37 CFR 41.202(d)(2) showing. An interference was then declared, and Nathans was put under an order to show cause why judgment should not be entered against it on the ground that its two 37 CFR 1.131 declarations were inadequate to make a 37 CFR 41.202(d)(2) showing. However, on the ground that “the examiner never explicitly offered [Nathans the opportunity to present a showing under 37 CFR § 41.202(d)] or required Nathans to present a showing under 37 CFR § 41.202(d)(2),”<sup>29</sup> SAPJ McKelvey gave Nathans a mulligan—along with a short tutorial on what he should do in response.

Nathans v. Greene is unusual for two reasons.

First, the examiner had forwarded the files to the board with a recommendation that an interference be declared without that applicant’s having initiated consideration of the possibility of declaring an interference by filing a 37 CFR 41.202(d)(2) suggestion of interference. While MPEP ¶ 2304.04(a) authorizes examiners to do that, and while it used to be fairly common for examiners to do that, it has become very uncommon in recent years for examiners to do that.

Second, when SAPJ McKelvey was originally assigned to decide whether or not to declare an interference, he didn’t remand the files to the examiner with instructions to take action under 37 CFR 41.202(c) and MPEP ¶ 2304.04, which would have authorized the examiner to



require Nathans to add an appropriate claim to its application and to file a proper 37 CFR 41.202(d)(2) suggestion of interference. The APJs have authority to issue such remands, and they frequently do so--in order, inter alia, to avoid situations such as the one that occurred here.

The third opinion that we have found that actually accepts a proffered excuse as constituting “good cause” under 37 CFR 41.202(d)(2) is Edwards v. Strazzabosco, 58 USPQ2d 1836 (PTOBPAI 2001)(non-precedential)(opinion by APJ Medley for a panel that also consisted of SAPJ McKelvey and APJ Lee). Edwards is analogous to Nathans in that it also involved giving an applicant a mulligan at least in part because of a mistake made by an APJ. Specifically, the APJ to whom the interference was assigned issued a second show cause order, replacing a first order to show cause, thereby giving the applicant a second opportunity to make a showing of 37 CFR 41.202(d)(2) good cause and to proffer additional evidence. She explained that she did so because the first order to show cause “did not make clear that Edwards’ provisional application was not a reduction to practice (constructive or actual).”<sup>30</sup> That is, the panel at oral argument on Edwards’s response to the first order to show cause decided that the first order to show cause was sufficiently off base so that it decided to start over.

In response to the second order to show cause, Edwards submitted additional evidence supported by a showing of good cause why that evidence had not been submitted initially. Unfortunately, the opinion does not indicate what the good cause showing was. All that it says on that score is that:

Upon review of the entire record, and while the question is close, we are of the view that Edwards has shown good cause why the [additional] evidence could not have been submitted with the initial Rule 608(bb) showing. Accordingly, we exercise our discretion to consider the additional evidence.

Notwithstanding the insufficiency of the original Rule 608(b) showing, upon consideration of the supplemental evidence, we hold that Edwards has established a *prima facie* case of priority

(not derivation) vis-à-vis the filing date of the Strazzabosco patent. Accordingly, the interference will be allowed to proceed.<sup>31</sup>

However, we have examined Edwards's response to the second order to show cause, and Edwards's argument was that, "As a result of continued diligence in connection with discovery in . . . [a] contemporaneous [infringement] litigation, additional evidence was eventually discovered by Edwards, including prototypes of the invention."<sup>32</sup>

The opinion that we found discussing excuses that might be accepted is SAPJ McKelvey's splendid, lengthy, didactic opinion in Basmadjian v. Landry, 54 USPQ2d 1617 (PTOBPAI 1997)(precedential)(opinion by SAPJ McKelvey for a panel that also consisted of CAPJ Stoner and APJ Hanlon).<sup>33</sup> According to it:

"good cause" might be shown if evidence first comes into existence after a Rule 608(b) showing is filed. Huston v. Ladner, 973 F.2d 1564, 1566, 23 USPQ2d 1910, 1912-13 (Fed. Cir. 1992)("if the evidence was not available when the original showing was filed, this would have been a valid excuse for not filing the evidence"). Another basis upon which "good cause" might be established would be where a diligent effort to find evidence was unsuccessful prior to filing the Rule 608(b) showing, but continued diligence ultimately succeeded in locating the evidence after the showing was filed.<sup>34</sup>

## **Comments**

There are two overall take-home points that should come from this review of the case law on "good cause" under 37 CFR 41.202(d)(2) and its predecessors.

First, don't cite pre-1985 opinions. They won't do you any good, and citing them may lead to the APJs making unkind comments about your knowledge of the law.

Second, it is vastly preferable to get it right the first time. While 37 CFR 41.202(d)(2) does permit the occasional mulligan, mulligans are few and far between.

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<sup>4</sup> For a discussion of the leading opinion on the use of mulligans in interference practice, see Charles L. Gholz and Robert C. Nissen, The Board Must Afford Interferents Due Process!, 16 Intellectual Property Today No. 10 at page 8 (2009).

<sup>5</sup> Rhodes v. Goldenberg, 230 USPQ 355, 356 (PTOBPAI 1985)(non-precedential)(opinion by EIC Torchin for a panel that also consisted of EICs Calvert and Smith)(describing the new rule as a “stricter standard”); and Holmwood v. Cherpeck, 2 USPQ2d 1942, 1944 (PTOBPAI 1986)(non-precedential)(opinion by EIC Sofocleous for an expanded panel that also consisted of EICs Calvert, Urynowicz, Torchin, and Boler)(“The showing of ‘good cause’ under 37 CFR 1.617(b) necessary to have additional evidence considered is a much stricter standard than was required under the prior practice with respect to 37 CFR 1.228.”).

<sup>6</sup> This aspect of Hahn v. Wong is discussed in Charles L. Gholz, A Critique of Recent Opinions of the Federal Circuit in Patent Interferences, 73 JPTOS 700 (1991) § III.B., “‘Good Cause’ Excusing Failure to Present Evidence With an Initial Showing Under 37 CFR 1.608(b).”

<sup>7</sup> 37 CFR 1.617(b) is the predecessor of 37 CFR 41.202(d)(2). Nickles v. Montgomery, 78 USPQ2d 1410, 1410 (PTOBPAI 2005)(non-precedential)(opinion by APJ Lee for a panel that also consisted of APJs Schafer and Lane)(“The showing of good cause requirement [in 37 CFR

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41.202(d)(2)] is the same as that under 37 CFR § 1.617(b), superceded by 37 CFR § 41.202(d)(2), which applied to submissions under 37 CFR § 1.608(b), superceded by 37 CFR § 41.202(d).”). Nickles v. Montgomery is discussed in Charles L. Gholz, A Critique of Recent Opinions in Patent Interferences, 89 JPTOS 1 (2007) § X.J.1., “Being Pushed by the Examiner is Not an Excuse.”

<sup>8</sup> Cf. Edwards v. Strazzabosco, 58 USPQ2d 1836, 1841 (PTOBPAI 2001)(non-precedential)(opinion by APJ Medley for a panel that also consisted of SAPJ McKelvey and APJ Lee)(“Edwards further argues that it did not have enough time before the examiner to properly prepare and respond to the Rule 608(b) requirement. . . . Edwards’ argument is not persuasive. Edwards was given three months to respond to the examiner’s request that Edwards submit a Rule 608(b) showing.”). Edwards v. Strazzabosco is discussed in Charles L. Gholz, A Critique of Recent Opinions in Patent Interferences, 84 JPTOS 163 (2002) § X.K., “The Trial Section Is Not Absolutely Bound by the Rules.”

<sup>9</sup> See also Gholz, supra n. 6, at § III.B (discussing Hahn v. Wong).

<sup>10</sup> Huston v. Ladner is discussed in Charles L. Gholz, A Critique of Recent Opinions of the Federal Circuit in Patent Interferences, 75 JPTOS 448 (1993) § III.B., “‘Good Cause’ Excusing Failure to Present Evidence With an Initial Showing Under 37 CFR 1.608(b).”

See also Jeon v. Cupps, Int. No. 104,241, paper no. 14 at 37 (PTOBPAI 2000)(non-precedential)(opinion by APJ Metz for a panel that also consisted of APJs Caroff and Hanlon)(“To the extent that Jeon et al.’s argument is in reality an argument that they were unaware of the legal requirements for proving an actual reduction to practice, the commentary to the new rules and the cases interpreting the new rules make it clear [that] ignorance of the substantive requirements of the law does [sic; not!] constitute ‘good cause’ under the rule.”).

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<sup>11</sup> 892 F.2d at 1035, 13 USPQ2d at 1316.

<sup>12</sup> Id.

<sup>13</sup> 973 F.2d at 1566, 23 USPQ2d at 1912.

<sup>14</sup> Id.

<sup>15</sup> 973 F.2d at 1567, 23 USPQ2d at 1913.

<sup>16</sup> 973 F.2d at 1570, 23 USPQ2d at 1916.

<sup>17</sup> According to 37 CFR 10.77, “**Failing to act competently**”: “A practitioner [before the Patent and Trademark Office] shall not...[h]andle a legal matter which the practitioner knows or should know that the practitioner is not competent to handle, without associating with the practitioner another practitioner who is competent to handle it.”

<sup>18</sup> Gholz, supra n. 10, 75 JPTOS at 466.

<sup>19</sup> 16 USPQ2d at 1314. See also Tomita v. Godil, Int. No. 105,313, paper no. 12 at 6 (PTOBPAI 2005)(non-precedential)(opinion by APJ Lee for a panel that also consisted of APJs Moore and Poteate)(“If the evidence in the record [i.e., in the initial showing] is inadequate for whatever reason, whether or not the inadequacy is in the form of a missing explanation, it is too late to submit further testimony to support a missing explanation, in the absence of a showing of good cause.”).

<sup>20</sup> Chaffee, paper no. 34 at 17.

<sup>21</sup> Cf. 37 CFR 41.202(e)(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

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- (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 [expected] response to the question of priority.

<sup>22</sup> So called after Peeler v. Miller, 535 F.2d 647, 653-54, 190 USPQ 117, 122 (CCPA 1976) (Rich, J.). Peeler diligence is diligence during the period from one's own actual reduction to practice to one's own constructive reduction to practice, and it is really the absence of 35 USC 102(g) suppression or concealment after an actual reduction to practice.

<sup>23</sup> 2 USPQ2d at 1943.

<sup>24</sup> Id.

<sup>25</sup> Id. at 1945-46.

<sup>26</sup> See, e.g., Charles L. Gholz and Kenneth D. Wilcox, Should the Prima Facie Case Include a Showing of the Lack of Suppression or Concealment?, 14 Intellectual Property today No. 11 at page 20 (2007).

<sup>27</sup> See, e.g., Kundu v. Rangunathan, 73 USPQ2d 1180 (PTOBPAI 2002)(non-precedential)(opinion by APJ Torczon for a panel that also consisted of APJs Schafer and Lee), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 88 JPTOS 217 (2006) § V.A., "Being Busy Isn't Enough."

<sup>28</sup> Nathans v. Greene is discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 90 JPTOS 9 (2008) § X.C.1., "The Fact That the Examiner Had Never Explicitly Requested the Junior Party Applicant to Present a Showing Under 37 CFR 41.202(d) Justified Giving the Applicant a 'Do Over'."

<sup>29</sup> 82 USPQ2d at 1603.

<sup>30</sup> 58 USPQ2d at 1840.

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<sup>31</sup> 58 USPQ2d at 1841.

<sup>32</sup> Edwards Response to Second Order to Show Cause at page 6.

<sup>33</sup> Basmdjian v. Landry is discussed in Charles L. Gholz, A Critique of Recent Opinions in Patent Interferences, 83 JPTOS 161 (2001) § X.E., “37 CFR 1.617 Practice Explained and Clarified.”

<sup>34</sup> 54 USPQ2d at 1621. Notably, the latter is the excuse that the panel accepted in Edwards v. Strazzabosco, which was briefed and decided after Basmdjian v. Landry was published.