

**DO YOU HAVE TO WRITE YOUR MOTIONS BEFORE YOU SUBMIT YOUR LIST
OF PROPOSED MOTIONS?¹**

By

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INTRODUCTION

One of the first things that a neophyte interference lawyer learns is that decision on the innumerable discretionary procedural issues decided by the APJs is very much dependent on the temperament of the APJ deciding the issue.³ In few areas is that principal more true than in the APJs treatments of lists of proposed motions.

WHAT THE RULES AND THE STANDING ORDER SAY

According to 37 CFR 41.120, “**Notice of basis for relief**”:

- (a) The Board may require a party to provide a notice stating the relief it requests and the basis for its entitlement to relief. The Board may provide for the notice to be maintained in confidence for a limited time.
- (b) *Effect.* If a notice under paragraph (a) of this section is required, a party will be limited to filing substantive motions consistent with the notice. Ambiguities in the notice will be construed against the party. A notice is not evidence except as an admission by a party-opponent.
- (c) *Correction.* A party may move to correct its notice. The motion should be filed promptly after the party becomes aware of the basis for the correction. A correction filed after the time set for filing notices^[4] will only be entered if entry would serve the interests of justice.

Paragraph 120 of the Standing Order, “**Types of notices of basis for requesting relief,**”

then provides that:

The principal types of notices under Bd.R. 120 in interferences are priority statements and motions lists. More detail is provided

in Bd.R. 204 and SO ¶ 204. An accurate motions list is necessary to provide the Board and the opposing parties adequate notice to plan for the proceeding.

37 CFR 41.204(a) deals with priority statements, which are not the subject of this article.

However, 37 CFR 41.204(b) and (c) are relevant here:

- (b) *Other substantive motions.* The Board may require a party to list the motions it intends to file, including sufficient detail to place the Board and the opponent on notice of the precise relief requested.
- (c) *Filing and service.* The Board will set the times for filing and serving statements required under this section.

Finally, SO ¶ 204, “**Motions list**,” reads as follows:

The motions list is a tool for planning the course of the proceeding, eliminating unnecessary costs and delay, and avoiding abusive practices. All substantive and anticipated responsive motions must be listed on the motions list. No substantive motions or responsive motions may be filed without prior Board authorization. If the need for an unlisted motions arises, the movant should initiate a conference call to obtain such authorization.

In summary, the rules and the Standing Order say that the motions list must “provide the Board and the opposing parties adequate notice to plan for the proceeding,” but only in “sufficient detail to place the Board and the opponent on notice of the precise relief requested” and to allow the APJ responsible for issuing the scheduling order to “eliminat[e] unnecessary costs and delay” and to “avoid[] abusive practices.”

WHAT VARIOUS APJS HAVE WRITTEN IN THE PAST

I will start this discussion with Judge Lane’s opinion in Sehgal v. Revel, 78 USPQ2d 1639 (PTOBPAI 2005), which I wrote up in Gholz, A Critique of Recent Opinion in Patent Interferences, 89 JPTOS 5 (2007) § X.E.3., under the title “A Proposed Motions List Must Be Complete, but It Needn’t Be Precise.” There Judge Lane dealt very mercifully with a motion

which we argued went well beyond what had been authorized in the scheduling order.⁵ She permitted that motion on the ground that what Sehgal argued in its motion was “implicit” in its list of proposed motions and, “Thus, it does not appear that Revel is asking to amend its motions list by very much, if at all.”⁶

The next opinion in the series is Senior Administrative Patent Judge McKelvey’s opinion for a panel that also consisted of APJs Torczon and Tierney in Karim v. Jobson, 82 USPQ2d 1018 (PTOBPAI 2006), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 90 JPTOS 9 (2008) § X.D.2., “Lists of Proposed Motions Must Be Drawn With Care.” It will surprise no interference practitioner that Judge McKelvey was less merciful. In fact, I described that opinion as “unusually stinging.”⁷ The errant counsel’s principal sin was that he had not obtained and consulted with an expert witness before filing his list of proposed motions, which led him to seek to enlarge upon his initial list after he had obtained and consulted with an expert witness.⁸ Judge McKelvey concluded his excoriation of the hapless attorney with the dictum that “A motions list is not an evolving document which can be expanded at the whim of a party....”⁹

However, another opinion that very same year indicates that even Judge McKelvey can be persuaded to be merciful. The opinion is Papayannopoulou v. Masinovsky, 82 USPQ2d 1147 (PTOBPAI 2006)(opinion by APJ Tierney for a panel that also consisted of SAPJ McKelvey and APJ Torczon), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 90 JPTOS 9 (2008) § X.D.3., “But Sometimes They [i.e., lists of proposed motions] Can Be Changed.” That opinion, which cites and discusses the same panel’s previous opinion in Karim v. Jobson, distinguishes it on the ground that:

Unlike Karim’s list, Papayanopoulou’s revised list of motions simplifies the issues to be decided in this interference. *** [and]

raise[s] 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.¹⁰

* * *

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.¹¹

In Papayannopoulou, the restructuring of the desired motions strategy accompanied a second change of counsel. However, Judge Tierney went out of his way to indicate that the change of counsel had not "factor[ed] into the analysis of whether Papayannopoulou's revised motions list would be authorized."¹²

WHAT JUDGE LEE HAS JUST WRITTEN IN RADA V. SHTROM¹³

In a miscellaneous order issued sua sponte after the two parties had filed their lists of proposed motions, Judge Lee wrote as follows:

Each party has filed its list of proposed motions for discussion and authorization in the initial telephone conference call scheduled for March 14, 2012. However, for deficiencies noted below, some of the items in the lists are herein dismissed.

In Item 1 of Rada's list, it is suggested that Shtrom's provisional application lacks an enabling disclosure of certain claim elements. However, Rada does not explain why it believes that one with ordinary skill in the art could not figure out [sic; could not have figured out], based on basic skill possessed by one with ordinary skill in the art [during the relevant timeframe] and just ordinary experimentation, how to make and use at least one embodiment within the claimed invention. It is unexplained what experimentation is deemed necessary and why that level of experimentation is deemed undue. It is not certain why the elements pointed out by Rada are complex or not known to one

with ordinary skill in the art. A summary conclusion in that regard is not helpful for discussion in the scheduled telephone conference call. Rada also refers only to portions of Shtrom's disclosure in the involved application which have been cited by Shtrom as supporting its claims. That is inadequate. Rada must address the entirety of the disclosure in Shtrom's provisional application.

For Item 3 of Rada's list, Rada does not explain the level of ordinary skill in the art with respect to the identified claim elements. Rada does not present anything meaningful for the opposing party and the Board to consider with regard to whether to allow filing of the motion. It is unexplained to what extent is each identified claim element known to one with ordinary skill in the art, and[,] if so, in what context. Rada does not identify the closest prior art known to Rada in connection with each claim element relied upon for patentable distinction. What Rada has presented is a mere conclusion that it desires to establish.

Shtrom desires to file a motion for judgment alleging that all of Rada's claims are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of written description. However, Shtrom does not reveal which claim feature is at issue for which claim. Such a general submission is not meaningful for consideration either by the opposing party or the Board for the purposes of determining which motions should be authorized, and is not helpful for the discussion now scheduled for March 14, 2012.¹⁴

COMMENTS

(1) According to 37 CFR 41.204(b) and SO ¶ 204, the purpose of the list of proposed motions is (a) to give the responsible APJ and the opponent "notice of the precise relief requested" and (b) to permit the responsible APJ to plan the course of the proceedings so as to "eliminat[e] unnecessary costs and delay" and to "avoid[] abusive practices." However, IMHO, requiring a list of proposed motions to contain the level of detail required by Judge Lee's order in Rada v. Shtrom is utterly unnecessary to give either the responsible APJ or the opponent "notice of the precise relief requested," to "eliminate unnecessary costs and delay," or to "avoid[] abusive practices." (In fact, as I comment below, I think that requiring a list of proposed motions to contain that level of detail actually adds unnecessary costs.) What Judge Lee seems

to be requiring is that a party's list of proposed motions make out a prima facie case for the granting of each proposed motion!

(2) In the past, some of the APJs have accepted lists of proposed motions that simply listed the types of motions--e.g., a motion for a judgment that all of the opponent's claims (or selected ones of the opponent's claims) are unpatentable for lack of 35 USC 112 ¶ 1 enablement. That has certainly given both the APJ and the opponent "notice of the precise relief requested." As for "avoiding abusive practices," that has been accomplished by declining to authorize motions that sought to raise issues that were irrelevant to interference practice.¹⁵

(3) Most importantly, I think that requiring a list of proposed motions to contain the level of detail required by Judge Lee's order in Rada v. Shtrom adds substantially to the cost of litigating the interference. I have no problem with the implicit requirement of the previous case law (particularly Karim v. Jobson) that, prior to filing their lists of proposed motions, interferences have retained their expert witnesses and discussed what they would like to prove with those expert witnesses in sufficient detail so that they know what motions they can propose with reasonable confidence that their expert witnesses will support their positions. However, I think that requiring interferences to "explain the level of ordinary skill in the art with respect to the identified claim elements" is asking for an expensive undertaking that does the APJ no good and that is wasted effort if a given proposed motion is not authorized. Specifically, in view of SAPJ McKelvey's repeated admonitions that what we need to put in the expert's declaration is an explanation of what would have been in the "tool box" of a person of ordinary skill in the art in the relevant timeframe, interferences need to spend considerable time with their expert witnesses coming up with such a list. However, they don't list a complete inventory of the contents of such a tool box. Rather, the list typically contains only the tools necessary to accomplish the task at

hand. Accordingly, preparation of the list and the motion(s) is an interactive project. As the substantive arguments in each motion are developed, the attorney and the expert witness jointly put into the tool box the tools necessary to accomplish whatever that motion says that the person of ordinary skill in the art in the relevant timeframe could have accomplished. By requiring the list of proposed motions to detail what is in the toolbox, the order effectively requires at least a first draft of the motion that the expert's declaration will support.

(4) More generally, Judge Lee's order seems to require the interferences to put enough detail into their lists of proposed motions to persuade him that it is more likely than not that the motion is grantable--absent an effective opposition. Hence the title of this article: Do you have to write your motions before you submit your list of proposed motions?

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³ See, e.g., my letter to the editor of the Journal of the Patent and Trademark Office Society published at 89 JPTOS 339 (2007) in which I bemoaned the fact that, during a conference call, Judge Tierney distinguished what I thought was a dead-on precedent by saying "That opinion was written by Judge McKelvey. I'm Judge Tierney."

⁴ This sequence doesn't make sense. If a party becomes aware that a draft notice that it hasn't filed yet contains an error, surely the party will correct the notice before filing it!

⁵ As suggested by the text, I was co-counsel for the party that sought to prevent the movant from going beyond precisely what had been authorized to argue in the scheduling order.

⁶ 78 USPQ2d at 1640.

⁷ 90 JPTOS at 24.

⁸ See Gholz, A Critique of Recent Opinion in Patent Interferences, 88 JPTOS 305 (2006) § X.G.2., “Ya Gotta Have an Expert”; Id. at § X.G.3., “Ya Gotta Have an Expert – Take Two”; and 90 JPTOS 9 (2008) § X.G.1., “Ya Gotta Have an Expert – Take Three.”

⁹ 82 USPQ2d at 1021.

¹⁰ 82 USPQ2d at 1151.

¹¹ 82 USPQ2d at 1152.

¹² 82 USPQ2d at 1153.

¹³ Interference No. 105,870, Paper 21. I am co-counsel for Rada.

¹⁴ Pages 2-3. See also Judge Lee’s Order Authorizing Motions, Paper 22 in Voglewede v. Lee, Interference No. 105,711.

¹⁵ As examples, motions that sought to introduce issues of trade secret or trademark law or that sought money damages.