

## Advice From the Interference Bench and my Comments

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This paper present my notes and analysis of the interference workshop held February 7, 2007, in Washington, DC.<sup>2</sup> The meeting included presentations from the Chief Administrative Patent Judge (CAPJ) Fleming, and Administrative Patent Judges (APJs) Siegel, Lee, and Torzcon. The presentations were interspersed with questions and comments from members of the interference bar and answers from the APJs. I reproduce here points relevant to the interference bar.

Chief APJ Fleming provided updates on administrative matters. He described the creation of a body of citable published BPAI opinions classified as one of: (1) precedential; (2) informative; (3) all others. I asked how those thousands of opinions could effectively be searched. CAPJ Fleming noted that the USPTO was working on a Web search engine designed to search that body of case law on the USPTO's web site.

Comment: There are less than ten opinions on the BPAI portion of the USPTO's web site listed as precedential. Everyone knows about those. What most patent practitioners don't know about are the informative practice points in certain non precedential opinions, such as Pevarello v. Lan, interference 105,394, paper 85 (Expanded panel including CAPJ Fleming, SAPJ McKelvey, and APJs Schaffer, Hanlon, Lane, and Tierney explaining the standards for cross examination and motions to exclude). One would be hard pressed to find that opinion at this point in time. Therefore, the anticipated informative decisions database and search engine will be valuable services.

APJ Spiegel provided motions practice tips. During her presentation, I asked whether benefit for the count also required 120 benefit to the application. After some discussion of the difference between benefit for a count and 120 benefit to an application, the APJs seemed to be of a consensus that benefit for a count also required 120 benefit to the application.

APJ Spiegel indicated that the time periods specified in the order on motions are not stayed when some motion is accelerated. I asked for a typical accelerated motions time schedule. APJ Spiegel indicated that typical scheduling for an accelerated motion is 2 weeks/2 weeks/1 week (motion/opposition/reply). APJ Torczon pointed out that the due date for an accelerated motion is likely to be what the requesting party asks for.

APJ Spiegel noted that the BPAI follows the FREs regarding objections to evidence. However, the APJs will consider almost any evidence, absent a motion to exclude.

Note: You can put in whatever evidence you want, so long as your opponent does not object. If they do object, the objection triggers a response to objections period, in which you have a second bite at the apple to show why the evidence is admissible. Most admissibility issues therefore never make it into a motion to exclude.

APJ Spiegel noted that many of the motions contain statements of material facts in which each numbered statement contains more than a single demonstrative statement; some running on for pages. She also noted that the responses to those material facts were equally lengthy, and that lengthy facts and responses to facts were of little utility. The other APJs, including the Chief APJ chimed in, admitting that the current rules regarding statements of material facts (which

appear in the Standing Order) were a failure, and that they intended to revise those rules. APJ Torczon likened the asserted material facts as requests for admissions, requiring only an admit, deny, or unable to admit or deny response.

Danny Huntington and Chico Gholz asserted that they thought it was helpful to the APJs for counsel to explain, when denying an asserted material fact, why that assertion was false. I pointed out that not explaining why counsel denied a numbered assertion actually containing many assertions of fact, one of which might be true, could leave counsel open to sanctions. I also asked APJ Torczon why we had to state all material facts providing the basis for our relief, if the only goal for such assertions was to obtain admissions from our opponent, and if so, why not require a section entitled requests for admissions. APJ Torczon admitted that we did still have to list all facts in support of our motion, regardless of his request for admissions analogy

Comment: The APJs appear intent on addressing the requirements for material facts so that they serve a more useful purpose. The obvious answer is to have them enforce the existing rules. They should require that each numbered assertion contain only a single demonstrative fact. They should require that a response to an assertion of material fact to contain only an admit, deny, or unable to admit or deny response. To enforce compliance, they should briefly review pleadings upon receipt at the board and promptly require correction of non compliant pleadings.

APJ Spiegel noted that many motion claim charts are unclear, with ambiguous and vague references to support for limitations. At that point, I noted that the same problem exists in the annotated claims filings, motions claim charts, and material facts, and I suggested that the APJs perform a laugh test on incoming papers and bounce those failing compliance, - - before opposing counsel is burdened with reviewing and responding to incomprehensible papers. All of the APJs seemed very receptive to that idea.

APJ Spiegel addressed the proposed motions list. The guidance APJ Spiegel provides is that the motions list should cite with enough specificity the legal theory (such as 112, first paragraph, written description; or the unpatentability under 35 USC 103, and specifically identifying the prior art evidence) to identify to opposing counsel the legal issues they face. Listed proposed motions that lacked that amount of specificity were more likely to not be authorized for filing.

Comment: I consider the proposed motions list the make or break point in most interferences, because it sets the case in stone.

APJ Spiegel also reiterated long standing advice that the APJs are very likely to know the relevant law, and therefore suggested that parties not waste their limited motions space with case citations, citing at most only two cases.

APJ Lee provided oral arguments tips. During this presentation, APJs Lee and Torczon both indicated that oral hearings were in fact critical to the APJs decisions, one of them calling oral hearings "pivot points" in the proceeding.

APJ Lee noted the following.

Counsel's failure to respond to a question at oral hearing may be a factor in a decision.

If counsel believes an APJs question is not relevant, better to address the question, and then assert its irrelevance.

Do not fail to answer the question actually asked.

If there is no valid argument to support a proposition, concede the point and move on.

Expect to be asked hypothetical questions in which the facts vary from the actual. Expect to be challenged on competing stories and know the record.

The best demonstratives are key exhibits; such as the involved specifications.

Counsel should be sufficiently familiar with the technology to answer technology background questions and explain the effect of hypothetical variations on the actual limitations of the counts/claimed inventions.

APJ Torczon discussed the rules, the standing order, and the practice guide. He noted the heavy burden on the USPTO in promulgating 37 CFR rules, and the reduced burden of implementing changes in the standing order. He indicated that the standing order would likely be revised no more frequently than once per year.

Several members of the bar asked the APJs how one could obtain relief from an APJ's decision not to authorize the filing of a motion. I asked the same question, but with respect to an opposed miscellaneous motion because, under current practice, no written record of the request to file the miscellaneous motion exists (all such requests are, by rule, made verbally in a teleconference). Thus, at least for miscellaneous motions, there may be no written record on which to request reconsideration. APJ Torczon responded by stating that a request to file a motion was in fact a miscellaneous motion, and that the rules provided for preserving the issue by filing a written request for reconsideration of APJ's decision not authorizing the filing of the requested motion.

Comment: This is an important issue because, if the rules do not provide for review in the interference proceeding of an APJ's denial of authorization to file a motion, then that denial of authorization should preserve the issue for subsequent litigation. If the rules do provide for review in the interference proceeding, of an APJ's decision not to authorize filing of a motion, then failure to request review waives the right to subsequently raise the issue, such as in a follow on district court action. To clarify this point, I review the relevant authority below. Copied in below are the relevant rules from the CFR and the current version of the Standing Order.

37 CFR § 41.121 Motions. \*\*\*

(c) Content of motions; oppositions and replies.

(1) Each motion must be filed as a separate paper and must include:

(i) A statement of the precise relief requested,

(ii) A statement of material facts (see paragraph

(d) of this section), and

(iii) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence and the governing law, rules, and precedent.

37 CFR § 41.123 Default filing times. \*\*\* (b) Miscellaneous motions. (1)

If no time for filing a specific miscellaneous motion is provided in this part or in a Board order: (i) *The opposing party must be consulted prior to filing the miscellaneous motion, and (ii) If an opposing party plans to oppose the miscellaneous motion, the movant may not file the motion without Board authorization. Such authorization should ordinarily be obtained through a*

*telephone conference including the Board and every other party to the proceeding. Delay in seeking relief may justify a denial of the motion. \*\*\**

(c) Exhibits. Each exhibit must be filed and served with the first paper in which it is cited except as the Board may otherwise order. [Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004][Italics added for emphasis.]

The standing order sections 123-125 state:

¶ 123 Miscellaneous motions

¶ 123.1 Mandatory conference

*Before filing a miscellaneous motion, a party must confer with all opponents and, if agreement cannot be reached, arrange a conference call to the Board official administering the contested case.*

¶ 125 Rehearing of decisions ¶ 125.1 Time for filing

*A request for rehearing must be filed within fourteen (14) days of the decision, Bd.R. 125(c)(1), unless a judgment accompanies the decision in which case the request must be filed within thirty (30) days of the judgment, Bd.R. 127(d).*

¶ 125.2 Format for request for rehearing

*A request for rehearing is, in form, a miscellaneous motion, but no prior conference call is required.* The argument responsive to the decision must be made with particularity in the following manner:

On page \_\_, lines \_\_-\_\_, the opinion states \_\_. The opinion is believed to have overlooked [or misapprehended] \_\_. This point was set forth in \_\_ Motion [or Opposition or Reply] \_\_ at page \_\_, lines \_\_-\_\_.

The request must include as an appendix an evidence list setting forth a list (in numerical order by exhibit number) of each exhibit that the party believes was overlooked or misapprehended.

¶ 125.3 Number of requests

A party may file no more than one request for rehearing per motion decision.

¶ 125.4 New evidence on rehearing

Evidence not already of record at the time of the decision will not be admitted absent a showing of excusable neglect for the belated submission. Bd.R. 4(a). [Italics added for emphasis.]

37 CFR § 41.121 defines a motion as a paper filed in the case containing a statement of the precise relief requested, facts, and argument. Neither a party's proposed motions list nor a verbal request for authorization to file a miscellaneous motion meets that definition. Moreover, 37 CFR 41.123 and the standing order section ¶¶ 123.1 and 125.2 distinguish an APJ's denial of authorization to file a miscellaneous motion from a miscellaneous motion. Thus, the rules do not indicate that a party's request to file a miscellaneous motion *is* a miscellaneous motion. Therefore, the rules do not indicate that the APJ's decision on authorization to file a motion is a

decision subject to review in the interference proceedings. However, APJ Torczon (with the tacit agreement of the other APJs present) indicated that the APJs believe the rules mean otherwise.

By way of background, at interference bar meetings in years past, the bar had noted to APJs that the estoppel effect of interferences drove parties to raise and brief all issues possibly subject to estoppel, thereby raising the cost of interferences. In that light, the practice thereafter introduced by the Board of requiring the parties to obtain the APJs authorization to file a motion, without review of the APJs decision on authorization, appeared to address the bar's estoppel concerns. The APJs authority to operate in the newer fashion of generally deciding how to conduct interferences was tested and affirmed in In re Sullivan, 84 Fed. Appx. 86 (Fed. Cir. 2003)(unpublished); Rehearing denied by, Rehearing, en banc, denied by Sullivan v. Bingel, 2004 U.S. App. LEXIS 2195 (Fed. Cir. 2004). Sullivan does not address the specific issue of a right in the interference proceeding to challenge an APJs decision not to authorize a motion. However, it is indicative of the broad discretion accorded the Board in conducting interference proceedings. There remains after Sullivan the issue whether a lack of a review mechanism in an interference proceeding of an APJs decision to not authorize a motion would have survived a constitutional due process challenge.

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Date/time: April 24, 2007 (8:24am)

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1.I can be reached at 703-415-0012 or via the firm web site [www.neifeld.com](http://www.neifeld.com). My thanks to my colleagues Robert Hahl and Bruce Margulies for their review and comments.

2.This workshop was sponsored by the Patent, Trademark, and Copyright section of the Bar Association of the District of Columbia, and organized by Erin Dunston, of the Bingham McCutchen firm.