Summary of the Meeting of the Interference Committed Meeting of the AIPLA on 5-10-2007

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This is a report on the information provided at the May 10, 2007 meeting of the Interference Committee in Boston.

Both CAPJ Fleming and APJ Moore spoke and provided some guidance to the interference bar. As usual, CAPJ Fleming spoke on global issues including policy initiatives and management, and APJ Moore spoke on suggestions from the interference bar for changes to the rules and the standing order, and where the BPAI stood on those proposals.

CAPJ Fleming first provides statistics relevant to the Board. Statistics relevant to the interference bar were that, in 2007, the average pendency of an interference was 10.8 months, that all interferences had terminated within 2 years of their date of declaration, and that 35 interferences had been declared so far this year.

Working towards distributed work environment so that APJs can reside anywhere. Upcoming ex parte appeals rules changes to improve efficiency and timeliness of appeals proceedings. He noted that all papers in virtually all interferences are now available via the BPAI web site's interference portal. CAPJ Fleming noted the following opinions on the BPAI "Informative Opinions" list as addressing the noted issues.

Ex Parte Mathias, No. 2005-1851 (10 August 2005) - addressing what constitutes non functional descriptive material;

Ex Parte Bilski, No. 2002-2257 (26 September 2006) - addressing the requirements for support; and

Ex Parte Kraus, No. 2005-0841 Supplement (21 September 2006) (Paper 52) - addressing criteria for the reissue recapture rule.

Finally, CAPJ Fleming suggested that inter partes reexaminations may be a viable alternative to an interference in certain situations.

APJ Moore spoke on procedural issues and responded to suggested submitted by the interference bar. I list sequentially below each issue raised by the interference bar upon which APJ Moore spoke.

1.   Regarding Statements of material fact (SMF), see page 42 of Standing Order (SO), how should a party respond to a SMF that actual contains multiple assertions of fact? APJ Moore indicated the SO needs to be revised to provide page limits on SMFs, and the BPAI will surely impose limitations in a revised SO. Probably, the revised SO will limit SMF to the same page limits as the substantive paper. APJ Moore suggested caution when considering not responding to an apparently improper SMF since panel my disagree. However, the BPAI is considering some form of revision allowing respondent to not respond to improperly formatted SMFs.

2.   What should a party do in their priority statement if they want to argue derivation? APJ Moore indicated that the member of the Trial section consider derivation a component of priority. He acknowledged that the current rules do not specify that elements of derivation must be alleged in a priority statement, and he indicated that the rules (or the SO; he was not clear on this point) should be revised to specify that elements of derivation must be presented in the priority statement.

3.   How can a party contest an APJ's decision to deny authorization to file a motion? APJ Moore stated that the members of the trial section considered the motions list to be a

miscellaneous motion, which therefore is subject to reconsideration under 37 CFR 41.125.

He also noted that the standard for obtaining a reversal of an interlocutory decision was abuse of discretion, and indicated that the chance of reversal of such a decision, given the standard, was therefore low.

4.   Should the time for a party to object to evidence be delayed to when the motion relying upon the evidence is filed? APJ Moore indicate that the BPAI had no intention of changing procedure along this line.

5.   Should a party file objections to evidence? APJ Moore indicated that they should not be filed, and pointed out that the BPAI does not want paper overload.

6.   Can a party file several motions to exclude? APJ Moore acknowledged that no rule prevents filing several such motions. However, in practice, a single motion should be filed. APJ Moore indicated that the SO will likely be revised to specify a limitation on the number of motions to exclude.

7.   When does a party have to give notice of judicial review; 20 days from what date? APJ Moore indicated that a party has to give notice of judicial review 20 days from the date a notice of appeal is filed in a Court seeking such review, not from the date the BPAI decision is issued from which a party eventually seeks the judicial review.

9.   Where are the members of the merits section of the Trial Division of the BPAI? That is, why do only members of the trial section appear to be sitting on merits panels? APJ Moore indicated that most members of the merits section have been assigned to ex parte appeals work. In addition, there are only 2 electrical engineer APJs on the trial section, and therefore those APJs will sit on most merits panel hearings on electrical cases.

10.   Regarding SO 208, if a party file a reissue application for claims corresponding to the count and a reissue application for claims not corresponding to the count, should not that party be required to serve copies of both application on the opponent in the interference?   APJ Moore agreed, noting the BPAI would consider amending the rules to make that a requirement. However, he also noted that estoppel will apply anyway to the non served reissue application.

11.   Regarding 35 USC 135(c) settlement agreement filing requirements, should the rules specify that the this settlement agreements occurring during judicial review must be filed? APJ Moore indicated that interferences were considered terminated by the BPAI after judicial review ends. Therefore, there was no need to file such agreements until the time the BPAI terminated the interference.

12.   Can the BPAI waive the 1 MEG file size limitation for efiling a pleading in an interference? APJ Moore indicated that the Interference web portal will handle large uploads.

1.I can be reached via the firm web site www.Neifeld.com.