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EDITOR'S NOTE:

An article appeared in last month's bulletin reporting on a speech given by Robert J. Webster on patent interference. Because of the brevity of the article and the length and complexity of Mr. Webster's lecture, some of his views were not accurately reflected in the article. Accordingly, since the subject of patent interference is both complex and important to patent attorneys, we are reprinting as a service to our members a "Patent Interference Practice Update" which was prepared by Mr. Webster.

A. DEFINITION, PREPARATION, DECLARATION

(37 CFR 1.201 through 1.212)

(1) A patent interference proceeding may be declared only when the claims of each party which correspond to the counts are allowable in their involved applications. *McNally v. Mossinghoff*, 213 USPQ 281 (CCPA 1982)

(2) A count is merely the vehicle for contesting priority and a phantom count need not be supported as to all limitations by the disclosure of either party. [All limitations of a modified count need not be supported by the disclosure of at least one party]. *Mori v. Costain*, 214 USPQ 295 (Bd. Pat. Int. 1981).

(3) Party A was designated as the junior party in a two party interference because his effective filing date was earlier than that of the party B designated as senior party only with respect to 7 out of 8 counts. *DeNora v. Ives*, 209 USPQ 1121 (Bd. Pat. Int. 1980)

B. PRELIMINARY STATEMENT, SUMMARY JUDGMENT

(37 CFR 1.215 through 1.228)

(1) A motion to change inventorship from joint to sole should have been accompanied by a motion under 37 CFR 1.222 to amend the preliminary statement as well as an amended preliminary statement. *Taylor v. Brackman*, 208 USPQ 275 (Bd. Pat. Int. 1979).

(2) Summary judgment may not be granted if material issues of fact remain. *Houston v. The Polymer Corp.*, 209 USPQ 31 (9th Cir. 1980).

(3) Joint inventors may submit preliminary statement in form of two separate statements each signed by one of the two joint inventors provided the statements indicate the joint inventorship. [This format was used presumably to avoid delays involved in forwarding one paper to two people in different locations]. *Willis v. Suppa v. Koehler*, 209 USPQ 406 (Bd. Pat. Int. 1980)

(4) Summary judgment was issued against junior party under 37 CFR 1.228 because the original showing under 37 CFR 1.204(c) was held insufficient and the excuse presented to justify the belatedness in filing a supplemental showing was determined insufficient to explain why the additional showing was

not presented originally. *Weber v. Kunz*, 209 USPQ 864 (Bd. Pat. Int. 1980). See also, *Weber v. Comely*, 211 USPQ 637 (Bd. Pat. Int. 1980).

(5) Allegations made in a party's preliminary statement must be made with respect to "each count". However, if the allegations therein pertain to all counts in issue, the preliminary statement may merely refer to "the invention". *Issidorides v. Ley*, 209 USPQ 860 (Comr. Pats. & TM 1980).

(6) Neither a party's preliminary statement nor its attachments are required to prove the allegations in the statement by the Rules of Practice (37 CFR) in general or 37 CFR 1.216 in particular. *Issidorides v. Ley*, supra.

(7) A party may not be precluded from making allegations in its preliminary statement as to subject matter which falls within the counts but not within the party's disclosure or claims. *Lengere v. Compton*, 211 USPQ 917 (Comr. Pats. & TM 1980).

(8) The filing of a reissue application by a junior party patentee to avoid conflicting subject matter in the interference and to thereby avoid the interference by termination under 37 CFR 1.264 as a response to an order to show cause issued against patentee under 37 CFR 1.225 why judgment should not be entered against it did not show sufficient cause to avoid summary judgment. *Brian v. Ferris*, 211 USPQ 274 (Bd. Pat. Int. 1981).

(9) Summary judgment under 37 CFR 1.228 was avoided because the excuse presented by the junior party applicant to justify the omission of supplemental affidavits from original showing under 37 CFR 1.204(c) were considered sufficient but the supplemental affidavits did not make showing under 37 CFR 1.204(c) sufficient so that the interference could go to the preliminary statement and remaining stages. *Choi v. Godfrey*, 212 USPQ 286 (Bd. Pat. Int. 1980).

C. MOTION PERIOD, DISSOLUTION, REFORMATION

(37 CFR 1.231 through 1.238)

(1) 37 CFR 1.231(a)(5) applies only to involved patent applications. [Patentees must petition for certificate of correction to change inventorship]. *Taylor v. Brackman*, 208 USPQ 275 (Bd. Pat. Int. 1979).

(2) An attempt to change the inventive entity of patent which was involved in a patent interference proceeding from joint to sole where certain patent claims were decided to have been a joint invention but certain others were decided to have been invented by just one of the jointly listed inventor/applicants required the filing of two reissue applications based on the same patent, one joint and the other sole. The party then moved to add the sole reissue application to the interference contending that the subject matter in issue was invented by the sole reissue applicant. *Willis v. Suppa et al v. Koehler et al*, 209 USPQ 406 (Bd. Pat. Int. 1980).

(3) It is proper to deny a motion for benefit where there is reasonable doubt as to whether the accordation of benefit when the interference was declared was proper. *Googin v. Mahdjuri*, 209 USPQ 699 (Comr. Pats. & TM 1980). M.P.E.P. Section 1105.04, 4th para.

(4) A prior application need only support one species within the count for a party to be accorded

NEWS FROM THE NYPLA BOARD OF DIRECTORS

The Board of Directors of The New York Patent Law Association, Inc. ("NYPLA") has adopted a resolution favoring amendment of its Bylaws (and Certificate of Incorporation) to change its name to The New York Patent, Trademark and Copyright Law Association, Inc. Among the reasons given by those favoring the change were the following:

1) The object of NYPLA, according to Article II of the Bylaws relates to "the profession of the law of patents, trademarks and copyrights."

2) While a "patent law association" is understood by those experienced in the field to encompass trademark and copyright law, its scope is not so understood by others.

3) NYPLA will be better able to attract trademark and copyright lawyers as members and to be considered an authoritative source in these areas of the law if its name were changed to include specific reference to trademarks and copyrights.

4) The section of the American Bar Association and the sections or committees of most state and local bar associations have "Trademark and Copyright" as well as "Patent" in their names.

Among the reasons given by those opposing the change were:

1) The New York Patent, Trademark and Copyright Law Association, Inc. is too cumbersome a name. (It should be noted that the Board considered both "The New York Intellectual Property Law Association, Inc." and "The New York Industrial Property Law Association, Inc." as less cumbersome names, but both these names were rejected as not having a clear meaning, even among the Board).

2) The term "patent law" is generally considered as designating a branch of law relating to intellectual property and to include patents, trademarks, copyrights, trade secrets and unfair competition.

3) The names of the American Patent Law Association and of almost all other state and local associations includes only the term "Patent Law Association."

benefit of a prior application. See MPEP Section 1105.04. *Googin v. Mahdjuri*, supra. & M.P.E.P. Sec. 1105.04, para 3.

(5) A motion to dissolve on the question of right to make should not be granted if the question is a close one. *Googin v. Mahdjuri*, 209 USPQ 667 (Comr. Pats. & TM 1980). M.P.E.P. Sec. 1105.02, 2nd para.

(6) Motion to amend by adding counts, where it has been denied by the Primary Examiner [or dismissed by the Patent Interference Examiner] is not "ancillary to priority" in the sense that it is not before the Board for consideration. However, when a motion to amend is granted, the new counts placed in issue as a result thereof serve as a basis for the Board to consider any issue which is ancillary to priority and which was raised in the motion seeking to place the new counts in issue or in an opposition thereto at final hearing. *Smith v.*

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Hayashi, 209 USPQ 754 (Bd. Pat. Int. 1980).

(7) A reply to an opposition to a motion to dissolve was treated by the patent interference examiner as a motion to withdraw the motion to dissolve. *Chenot v. Piper*, 209 USPQ 862 (Comr. Pats. & TM 1980).

(8) A motion for benefit under 37 CFR 1.231(a) (4) not properly dismissed for failure to comply with 37 CFR 1.231(b). *Ley v. Issidorides*, 209 USPQ 858 (Comr. Pats. & TM 1980).

(9) There is no reconsideration of, or appeal from, a Primary Examiner's decision on a motion under 37 CFR 1.231 - see 37 CFR 1.231(d). Petitions will be considered only on the basis of clear error or abuse of discretion - see 37 CFR 1.244. *Cseh v. Forter*, 209 USPQ 118 (Comr. Pats. & TM 1980); *Jadwin v. Sadamatsu*, 211 USPQ 349 (Comr. Pats. & TM 1979).

(10) Motion to dissolve based on which party to the interference is the prior inventor or whether a party has conceded priority cannot be transmitted to the Primary Examiner for decision since he has no authority to decide those issues. *Morgan v. Hirsch*, 210 USPQ 303 (Comr. 1979).

(11) Duty of Patent Interference Examiner is to determine which motions under 37 CFR 1.231 and papers relating thereto are proper to be transmitted to a Primary Examiner for decision on the merits of the motion. *Morgan v. Hirsch*, supra.

(12) Petition to waive the requirement of 37 CFR 1.231(a)(1) which precludes basing motions to dissolve on facts sought to be established by affidavits, declarations or other evidence outside of official records and printed publications is denied. *Nicholas v. Scymon*, 210 USPQ 301 (Comr. Pats. & TM 1979).

(13) A motion to dissolve may be based on an affidavit if the grant of the motion would not result in a rejection based on the affidavit. *Kaufman v. DeVito*, 211 USPQ 906 (Comr. Pats. & TM 1980); *Matsuda v. Haberman*, 210 USPQ 423 (Comr. Pats. & TM 1979).

(14) A motion to dissolve brought by patentee with respect to a number of counts on the basis that they are not patentably distinct is improper and not proper to transmit to the primary examiner for decision because of such action were permitted a patentee could remove his claims corresponding to those counts from the interference and avoid cancellation of them under 35 USC 135(a) if final judgment is adverse to the patentee. *Nelson v. Drabek*, 212 USPQ 98 (Comr. Pats. & TM 1979).

(15) Motions that are relevant to questions of the parties' relative seniority should be decided by the Primary Examiner even though a motion to dissolve is proper to grant or the interference is to be otherwise dissolved. The rationale of *Furukawa v. Garty*, 151 USPQ 110 (Comr. Pats. 1965) which indicates that under certain circumstances, such determinations may be moot, is distinguished in this interference. *Matsuda v. Haberman*, 210 USPQ 423 (Comr. Pats. & TM 1979).

(16) Motion to amend brought under 37 CFR 1.231(b) was properly dismissed when the motion to dissolve with respect to which it was brought was dismissed. *Pearson v. Wolfe*, 210 USPQ 686 (Comr. Pats. & TM 1979).

(17) Interference will not be dissolved pro forma based on agreement of the parties that a party's disclosure does not support the full scope of a modified count where the basis of lack of support will not support a rejection of that party's claim corresponding to the modified count. *Pearson v. Wolfe*, supra.

(18) Plain import of 37 CFR 1.231(c), second sentence, is that the accordation of benefit of a prior application to a party who does not move for it under 37 CFR 1.231(a)(4) and was not accorded benefit when the interference was declared, is prohibited. *Safford v. Schaar*, 210 USPQ 273 (Comr. Pats. & TM 1979).

(19) Benefit of a prior application accorded in the interference declaration papers is only with respect to counts listed in those declaration papers. Benefit with respect to counts sought to be added or substituted must be sought as required by 37 CFR 1.231(c). *Safford v. Schaar*, supra.

(20) It is improper to substitute a count narrower than the claim of a patentee which corresponds to the existing count. *Jadwin v. Sadamatsu*, 211 USPQ 349 (Comr. Pats. & TM 1979).

(21) It is improper to amend by substituting or adding six counts, each of which corresponds to a single patent claim and is narrower in scope than the corresponding patent claim was properly dismissed. Neither proposition is proper. *Sonnenberg v. Cyba*, 211 USPQ 398 (Comr. Pats. & TM 1979).

(22) Motion seeking dismissal of motion to dissolve based on patentability over prior art so that derivation allegation can be resolved and priority decided is improper. Unpatentability is a threshold question, i.e., is fundamental to existence of any question of priority. *Walsh v. Eustace*, 212 USPQ 286 (Bd. Pat. Int. 1980).

(23) Motion to dissolve on ground that party cannot make a phantom count is treated as a motion to dissolve on the ground that the party cannot make his claim corresponding to the phantom count where both the count and his claim contain the limitation which he allegedly cannot make. *Comstock v. Kroekel*, 212 USPQ 866 (Bd. Pat. Int. 1980).

(24) Motion to dissolve based on unpatentability must be based on a ground which will serve as the basis for rejection of a party's claim corresponding to the count in ex parte prosecution subsequent to dissolution of the interference. *Moncada v. Johnson*, 212 USPQ 824 (Comr. Pats. & TM 1980).

(25) Motion to dissolve based on non statutory bar prior art where the dates in a party's preliminary statement antedate the effective date of the prior art, is dismissed. *Moncada v. Johnson*, supra.

(26) If a motion to dissolve based on no interference in fact is granted, i.e. if the parties' claims are patentably distinct, and are otherwise allowable, it is proper for each party to obtain a patent based on its involved claims. *Daniels v. Daum*, 214 USPQ 911 (Bd. Pat. Int. 1982).

(27) It is inappropriate to seek dissolution on the ground that one party to the interference derived the invention in issue from another party to the interference. Such an issue relates to priority and should be addressed to the Board of Patent Interferences. *Hamer v. Barron*, 215 USPQ 743 (Comr. Pats. & TM 1981).

(28) Primary Examiner properly considered affidavits and declarations which formed the basis of his decision on the issue of patentable distinctness. *Hester v. Allgier*, 215 USPQ 481 (CCPA 1982).

(29) A motion to substitute a number of counts in an interference involving only applications [i.e., no patentee] must demonstrate that the proposed counts could properly issue in separate patents, i.e., that they are patentably distinct from each other. There must be a "de minimis" showing of patentable distinctness contained in the motion before it will be transmitted to the Primary Examiner for a decision on the merits. *Foulks v. Isa*, 214 USPQ 466 (Comr. Pats. & TM 1979).

(30) Motion to amend by adding new counts must demonstrate the patentability of the subject matter to all parties in whose applications the proposed counts did not originate. This means that if there are no claims in the application of a non-moving party corresponding to the proposed counts, the moving party should propose claims in the motion to amend that the other party can support which correspond to the proposed counts. *Foulks v. Isa*, supra.

(31) Vagaries of phantom and modified count practice are such that parties should be liberally permitted to correct errors and deficiencies in

motions under 37 CFR 1.231 and related papers that result from a failure to comply with the requirements of that practice. *Foulks v. Isa*, 214 USPQ 466 (Comr. Pats. & TM 1979).

(32) A contingent motion to dissolve alleging unpatentability over prior art of a proposed count is proper to be transmitted to Primary Examiner for decision where the effective date of the prior art reference on which the motion is based is not antedated by an affidavit or declaration under 37 CFR 1.31 or its equivalent presented to show that opposing party completed the invention in issue in this country prior to the effective date of the prior art. *Aross v. Fujino*, 214 USPQ 468 (Comr. Pats. & TM 1980).

Statement in opposition to motion to dissolve that opposer completed the invention in the U.S. prior to the effective date of the prior art on which the motion is based is sufficient to permit opposer to file affidavit to swear behind the art under the circumstances of this case. *Aross v. Fujino*, supra.

D. MISCELLANEOUS PROVISIONS

(37 CFR 1.242 through 1.248)

(1) The Commissioner of Patents and Trademarks has the authority to settle how a Patent Interference Examiner should handle a request for extension of time when both the request and an alleged agreement of the parties regarding the extension are before the Examiner. *Morris v. Diamond*, 208 USPQ 202 (CCPA 1980).

(2) Notwithstanding the clear statement in the last sentence of 37 CFR 1.287(c), parties in interference cases continue to seek review by the Commissioner of orders of the Board denying additional discovery. Review of an order denying additional discovery can be had along with judicial review of a decision on the question of priority. Accordingly, a party to an interference case should not file a petition to the Commissioner seeking review of an interlocutory order of the board denying additional discovery. The filing of such a petition only serves to delay the ultimate disposition of interferences on the merits. *Price v. Folsom et al*, 208 USPQ 56 (Comr. Pats. & TM 1980).

(3) Copies of various papers previously filed in the interference are attached to a petition to the Commissioner and the opposition thereto. Such copies are neither required nor desired, as the original papers are available to the person deciding the petition. Since they serve no useful purpose and unnecessarily increase the size of the file, their submission is discouraged. *Chenot v. Piper*, 209 USPQ 862 (Comr. Pats. & TM 1980); *Safford v. Schaar*, 210 USPQ 273 (Comr. Pats. & TM 1979).

(4) A reply to an opposition to a petition to the Commissioner is given no consideration pursuant to Commissioner's Notice of November 9, 1976, 953 O.G. 2, since 37 CFR 1.244 does not provide for such replies. *Ley v. Issidorides*, 209 USPQ 858 (Comr. Pats. & TM 1980).

(5) An extension of time to serve a preliminary statement on the other party to the interference did not amount to a waiver of the rule but, in any event, a Patent Interference Examiner has the authority to waive a requirement to serve any particular paper under particular circumstances presented as per 37 CFR 1.247. *Langere v. Compton*, 211 USPQ 917 (Comr. Pats. & TM 1980).

(6) Petition the Commissioner was the correct approach here by petitioner since the Board could not waive the requirements of the rules. The Commissioner permitted the petitioner to have his testimony considered by giving him time to have it properly signed before the officer in whose presence it was taken and then filed with the PTO. *Wentworth v. Schena*, 212 USPQ 231 (Comr. Pats. & TM 1980).

(7) A reply to an opposition to a request for reconsideration of decision pursuant to 37 CFR 1.243(a) is given no consideration since it is not provided for in the rules of practice and pursuant to

37 CFR Commissioner's Notice of November 9, 1976, 953 O.G. 2. *Safford v. Schaar*, 211 USPQ 295 (Comr. Pats. & TM 1979); *Dreikom v. Barlow*, 214 USPQ 632 (Comr. Pats. & TM 1981).

(8) It is not the practice to hold oral hearings on petitions, and no reason is found for departing from the established practice in this case. *Walsh v. Eustace*, 212 USPQ 285 (Comr. Pats. & TM 1980).

(9) Board of Patent Interferences has no authority to dissolve and reinstate interference. Its jurisdiction is limited under 35 USC 135(a), to determine question of priority or matters that have been determined to be ancillary to priority. *Beale v. Schuman*, 212 USPQ 291 (Bd. Pat. Int. 1980).

(10) The PTO is merely the repository for copies of agreements filed under 35 USC 135(c) and do not undertake to rule on whether the statute requires that a particular agreement be filed. Only concern of the PTO is if copy filed with it is within the time limit prescribed by the statute. *Nelson v. Bowler*, 212 USPQ 760 (Bd. Pat. Int. 1981).

E. TRIAL

(37 CFR 1.251 through 1.259)

(1) The provision of supplemental briefs is within the discretion of the Board of Patent Interferences and will not be considered unless they have been approved by the Board. *Willis v. Suppa et al v. Koehler et al*, 209 USPQ 406 (Bd. Pat. Int. 1980).

(2) The issue of whether an inventor has failed to disclose in his application for a patent the best mode contemplated by him for practicing his invention as required by 35 USC 112, first paragraph, presents an issue which is ancillary to priority and is within the jurisdiction of the board and this court to determine. When raised by a party it must be resolved before the issue of priority is addressed. *Tofe v. Winchell*, 645 F.2d 58, 209 USPQ 379 (CCPA 1981).

(3) We hold that the issue of whether species count 2 is patentably distinct from genus count 1, although arising from the addition of count 2 [added to the interference by the Primary Examiner on his own motion] is ancillary to priority. To the extent that *Gotfredsen v. Banner* [598 F.2d 589, 202 USPQ 7 (CCPA 1979)] conflicts with this holding, it is overruled. *Hester v. Allgeier*, 646 F.2d 513, 209 USPQ 370 (CCPA 1981).

(4) A motion to amend by adding counts, when denied by a Primary Examiner, is not ancillary to priority in the sense that it is not before the Board of Patent Interferences for consideration. However, when such a motion is granted, new counts are placed in issue and any matters which are ancillary to priority and were raised in connection with the motion (including the opposition to the motion) may be reviewed at final hearing. *Smith v. Hayashi*, 209 USPQ 754 (Bd. Pat. Int. 1980); *Mori v. Costain*, 214 USPQ 295 (Bd. Pat. Int. 1981).

(5) Since party A has been accorded an earlier filing date than party B as to all but one count, party A is presumed to be the first inventor of the subject matter of those counts, under 37 CFR 1.257(a); however, for procedural purposes they are designated the junior party since they do not have the earlier filing date as to all the counts. *DeNora v. Ives*, 209 USPQ 1121 (Bd. Pat. Int. 1980).

(6) Whether or not a party may establish prior invention based on work which falls within the counts, but not within his disclosure and/or claims, seems to be somewhat of an open question at this time and is not so well settled to preclude a party on that ground alone from asserting it in an amended preliminary statement. *Langere v. Compton*, 211 USPQ 917 (Comr. Pats. & TM 1980).

(7) Dismissal of request seeking an order issued prior to final hearing that Board would refuse certain arguments made by opposing party in his brief was proper. It is the longstanding policy of the PTO in

patent interference cases to avoid piecemeal prosecution. Unauthorized delays would result if Board ruled prior to final hearing what arguments be considered at final hearing, as Board would thereby consider the case twice, once to insure that the briefs are in proper form and a second time on the merits. The Board in its discretion may always ask the parties to brief such additional matters as it may deem appropriate. *D'Silva v. Drabek*, 211 USPQ 902 (Comr. Pats. & TM 902), *aff'd w/o pub. op.*, 691 F.2d 513 (CCPA 1982).

(8) Deferral by Commissioner or his representative of three motions which raise issues which are ancillary to priority to final hearing is a decision as to when such a decision on the merits should be made, is solely a matter of timing which does not determine what is admissible, is not logically related to the outcome of a patent interference proceeding and is not ancillary to priority. *Morris v. Tegtmeyer*, 210 USPQ 693 (CCPA 1981).

(9) 37 CFR 1.253(g), which states that the testimony of any party failing to supply copies thereof as specified may be refused consideration, does not give the Board of Patent Interferences discretionary or waiver authority with regard to 37 CFR 1.271 et seq., which may only be waived by the Commissioner, 37 CFR 1.183. *Seward v. Cochran*, 212 USPQ 543 (Bd. Pat. Int. 1981).

(10) Senior party, relying solely on the benefit of a foreign filed patent application under 35 USC 119 was assigned only a rebuttal testimony period. No time was assigned for taking testimony-in-chief. Senior party did not ask that a testimony-in-chief time be set for him. However, the senior party took testimony in the form of inter partes tests to show than an oven of his own choosing allegedly built in accordance with the disclosure of his priority document, benefit of which had been accorded to him pursuant to 35 USC 119 inherently satisfied the functional requirements of the counts. Board gave this testimony no weight, concluding that it was testimony-in-chief taken improperly during his rebuttal testimony period. *Osepchuk v. Hosokawa*, 212 USPQ 827 (Bd. Pat. Int. 1981).

(11) A response to a reply to a request for reconsideration filed pursuant to 37 CFR 1.256(b) will be given no consideration as per the Commissioner's Notice of November 9, 1976, 953 O.G. 2 (Dec. 7, 1976). *Moller v. Harding*, 214 USPQ 730 (Bd. Pat. Int. 1982).

A party cannot have a particular issue which is ancillary to priority considered at final hearing where he did not move to dissolve the interference on that ground and did not raise it in his main brief but only raised it in his reply brief, and his reasons why it was not raised earlier are not convincing. New material does not belong in a reply brief. *Moller v. Harding*, 214 USPQ 730 (Bd. Pat. Int. 1982).

A document attached to party's request for reconsideration filed pursuant to 37 CFR 1.256(b) is given no consideration since it was not submitted in accordance with 37 CFR 1.251(b), last sentence, 37 CFR 1.271 or 37 CFR 1.282(a). *Moller v. Harding*, 214 USPQ 730 (Bd. Pat. Int. 1982).

(12) Question of derivation is one of priority and where parties are involved in a patent interference proceeding and the derivation alleged is of the subject matter in issue by one party from another party, exclusive jurisdiction to decide that issue lies with the Board of Patent Interferences. *Hamer v. Barron*, 215 USPQ 743 (Comr. Pats. & TM 1981).

(13) A party who filed a preliminary statement alleging dates of invention in the United States prior to the effective filing date of the senior party, even if only with respect to one of the counts, is entitled as a matter of right to have a testimony-in-chief period accorded to him. *Boyd v. Hounsfeld*, 215 USPQ 57 (Comr. Pats. & TM 1981).

(14) 37 CFR 1.258(a) limits our jurisdiction to consideration of the issue of priority pursuant to 35 USC 102(g) and to such matters as are ancillary thereto. We are thus proscribed from ruling on such

"other matters" which are not ancillary to priority and are performed reluctant to expand our jurisdiction to such matters as are not clearly ancillary to priority. *Magdo v. Peltzer v. Kooi*, 212 USPQ 831 (Bd. Pat. Int. 1980).

F. TERMINATION

(37 CFR 1.261 through 37 CFR 1.267)

(1) Termination of patent interference proceeding involving a patent on grounds of common ownership is by judgment, not dissolution. An order to show cause is issued against the junior party since the senior party is presumed to be the first inventor, 37 CFR 1.257(a). The fact that a final hearing has been held and the record is over 2200 pages in length and there are 288 exhibits does not constitute sufficient cause to avoid the issuance of an order to show cause or to continue the interference so that the Board will render a decision on priority. The showing is not so extraordinary so as to justify suspension or waiver of 37 CFR 1.201(c). *Morehouse v. Armbuster*, 209 USPQ 514 (Comr. Pats. & TM 1980).

(2) A patent was issued to junior party in this interference after termination of previous interference between the same parties on, inter, alia, claims which were not patentably distinct from subject matter of count with respect to which concession of priority was made and judgment rendered in favor of opposing party. Under the circumstances, reinstatement of a second interference between the same parties is warranted despite the provisions of 37 CFR 1.267. *Hirzel v. Pease*, 209 USPQ 582 (Comr. Pats. & TM 1980).

(3) The filing of a reissue application by a patentee who is under an order to show cause issued pursuant to 37 CFR 1.225 why judgment should not be entered against him, does not constitute, per se, good and sufficient cause for withholding the entry of judgment. *Brian v. Ferris*, 211 USPQ 274 (Bd. Pat. Int. 1981).

(4) Senior party's assignee filed a disclaimer under 35 USC 253 with respect to all claims in the senior party's patent. Dissolution of the interference on that ground, i.e., pursuant to 37 CFR 1.263, was proper. A statutory disclaimer under 35 USC 253 cannot be treated as a disclaimer under 37 CFR 1.262(a) because it was not signed by the inventors in person as required by that rule. Dissolution under 37 CFR 1.263 causes no uncertainty in subsequent ex parte prosecution of Smith's application, Smith being junior party, since the disclaimer removed the claims from the senior party's patent and presumably the patent may be overcome as a reference in the same manner as any other reference which does not claim the invention. *Smith v. Beil*, 212 USPQ 383 (Comr. Pats. & TM 1981).

(5) Argument that a disclaimer filed by a party to this interference in a separate interference with respect to a count which is alleged to be not patentably distinct from the count in this interference can operate as a disclaimer in this copending interference is not convincing and we are aware of no authority for that proposition. *Magdo v. Peltzer v. Kooi*, 212 USPQ 831 (Bd. Pat. Int. 1980).

(6) An interference proceeding is not terminated under 37 CFR 1.264 unless and until the reissue application is granted. Suspension of interference pending final disposition of the reissue application is normal procedure. However, a suspension is not warranted here since the reissue was filed for purposes other than for terminating the interference as provided by this rule. *Gilberg, v. Orte*, 211 USPQ 900 (Comr. Pats. & TM 1980).

G. TESTIMONY AND DISCOVERY

(37 CFR 1.271 through 1.288)

(1) Since motion for extension of time filed in interference proceeding stated that both parties agreed to extension of time for service of docu-

ments and lists under 37 CFR 1.287(a), motion was dismissed as moot because the time was extended by reason of the parties' agreement thereto, 37 CFR 1.287(e). Commissioner, by his Deputy, stated that motion should not have been dismissed but should have been granted. *Morris v. Diamond*, 208 USPQ 202 (CCPA 1980).

Commissioner ruled that testimony taken by junior party despite refusal of senior party to attend may be considered unless senior party indicated that he wanted to attend and cross-examine witnesses. In such an event, Bd. was directed to reset testimony times. *Morris v. Diamond*, supra.

Senior party has not irreparably lost any rights by reason of Commissioner having allowed the admission of the junior party's testimony by refusing to suppress it under 37 CFR 1.287(d)(1). The admissibility of this testimony is still appealable to this court after a final decision by the board. *Morris v. Diamond*, supra.

(2) Patent Rule 286 (37 CFR 1.286) provides that the established rules of evidence will be applied strictly in the PTO. *Spaite v. Marsh*, 208 USPQ 145 (Bd. Pat. Int. 1981). But see application of the exclusionary powers under 37 CFR 1.286 by the Board disapproved on appeal in *U.S. Dept. of Energy v. White*, 210 USPQ 425 (CCPA 1981) at p. 435, with respect to disposition of question of what to do with evidence given by witness present while other witness was testifying.

(3) Motion under 37 CFR 1.287(d)(1) for admission of an exhibit introduced during the taking of deposition by movant of his witness but not timely served on the opposing party under 37 CFR 1.287(a) was granted in this case since little lead time would be required to study the exhibit and the opposing party would not be prejudged by its admission. *Spaite v. Marsh*, 208 USPQ 145 (Bd. Pat. Int. 1981).

(4) Second motion for additional discovery under 37 CFR 1.287(c) which was filed after the period for preparation for testimony closed was belated and showing presented to excuse the belatedness was insufficient because movant had access to his opponent's application pursuant to 37 CFR 1.226 when the interference was declared and the motion seeks only discovery of events which occurred during ex parte prosecution of the opponent's involved application. *Price v. Folsom*, 208 USPQ 56 (Comr. Pats. & TM 1980).

(5) Two documentary exhibits which were not served timely under 37 CFR 1.287(a) in response to the other party's timely request for such service, and were not made the subject of a motion under 37 CFR 1.287(d)(1) are denied consideration. *Eckels v. Brown*, 209 USPQ 154 (Bd. Pat. Int. 1980).

An unsigned carbon copy of a document which does not bear the letterhead thereof or date received stamp thereof and has no signature, as does the original document, does not constitute a "copy" of an exhibit within the meaning of 37 CFR 1.287(a)(1)(i). *Eckels v. Brown*, supra.

(6) Ordinarily testimony in patent interference cases is by deposition, 37 CFR 1.272(a). However, if the parties stipulate, they may file testimony in the form of an affidavit by the witness, they may stipulate what a particular witness would testify to if called, or they may stipulate the facts in a case. Petitioner submitted testimony in the form of 37 CFR 1.272(c) but submitted declarations, which per se are not authorized under that rule. Petitioner's declarations were also prepared prior to the commencement of the testimony period accorded him, which period commences the day after the period of preparation of testimony closes. *DiGiulio v. Murty*, 209 USPQ 403 (Comr. Pats. & TM 1980).

Petitioner's declarations cannot be introduced pursuant to 37 CFR 1.272(c) absent stipulation by all parties to the interference that they constitute what a particular witness or witnesses would testify to if called. *DiGiulio v. Murty*, supra.

(7) Board of Patent Interferences was justified in refusing to reopen the testimony periods as longstanding, well established conditions required to be met in order to obtain reopening are not met by petitioner. However, this is an extraordinary situation where testimony relates to subject matter within the scope of a phantom count but which falls outside the scope of the disclosure of the patent and the claim of the patent corresponding thereto, and Bd. is directed to reopen the testimony period. *Jacob v. Bersin*, 210 USPQ 333 (Comr. Pats. & TM 1980).

(8) Parties to this interference agreed, on the record, to exchange evidence between themselves and, if they could not agree on the issue of priority, to submit the evidence exchanged among themselves by the date set therefor to the Board for decision, the decision of the Board to be accepted as final and each party waived any and all rights of appeal, but did remain the right to request reconsideration. Junior party failed to timely file in the PTO the evidence which he had exchanged with the senior party by the date they had agreed to on the record but attempted to file material which did not come within the exchanged evidence. Board issued judgment against Goodsell for failure to file a properly stipulated evidentiary record by the date set therefor. Junior party (Goodsell) by appealing to the CCPA was held bound by the record in the PTO and thereby had, in effect, stipulated dismissal of the appeal to the CCPA. *Goodsell v. Shea*, 210 USPQ 612 (CCPA 1981).

(9) Board of Patent Interferences, stating that it had no power to waive the rules of practice (37 CFR), denied consideration of petitioner's testimony for failure to comply with 37 CFR 1.276(e) as it was not signed by the witness in the presence of the officer who took the testimony and there was no waiver of this requirement on the record by agreement of the parties. Commissioner, upon petition, permitted petitioner to resubmit the testimony provided that it was properly signed in the presence of officer who took it, allowing 20 days from the date of his decision to permit this to be accomplished. *Wentworth v. Schena*, 212 USPQ 231 (Comr. Pats. & TM 1980).

(10) Party who introduced four exhibits into evidence during his rebuttal testimony period, having timely listed and served only two of them under 37 CFR 1.287(a), and who failed to comply with the provisions of 37 CFR 1.287(d)(1) because he did not attempt to do so before his rebuttal testimony closed, and therefore did not "promptly" move under 37 CFR 1.287(d)(1), may only rely on the two exhibits which were properly served pursuant to 37 CFR 1.287(a). *U.S. Dept. of Energy v. White*, 210 USPQ 425 (CCPA 1981), and see *Moller v. Harding*, 214 USPQ 724 (Bd. Pat. Int. 1982).

(11) Junior party was put on notice that he might be accused of suppression and concealment by the brief of the party Wood. The belated attempt by the junior party to introduce evidence to rebut that contention was brought after final hearing and was properly dismissed as belated. The board will not accept statements in briefs as substitutes for evidence properly adduced pursuant to 37 CFR 1.272, ff. *Klug v. Wood*, 212 USPQ 767 (Bd. Pat. Int. 1981).

(12) Affidavits filed under 37 CFR 1.204(c) cannot be used to establish priority absent the consent of the parties. The board correctly gave no consideration to the junior party's preliminary statement and its attachments as part of his proofs of priority. Non-participation by the senior party in the interference does not relieve the junior party of his customary burden of proof to establish priority of invention by a preponderance of the evidence under the established rules of practice. During the depositions the witnesses were asked to affirm the accuracy of their affidavits marked as exhibits but were not asked to read them into the record. *Wiesner v. Weigert*, 212 USPQ (CCPA 1981).

(13) Board of Patent Interferences reopened the

testimony period, nunc pro tunc, for one day to permit a paper, which complied with 37 CFR 1.282, to be admitted into evidence. *Magdo v. Kooi v. Peltzer*, 212 USPQ 838 (Bd. Pat. Int. 1980).

(14) In order to be entitled to receive service of another party's documents and lists of witnesses and things on which that party intends to rely, a party must request service by the time set by the PTO or the time which the parties may extend pursuant to 37 CFR 1.287(e). The junior party did not file such a request and therefore is deemed to have waived service under 37 CFR 1.287(a). *Cushman v. Eberle*, 213 USPQ 579 (Bd. Pat. Int. 1981).

Senior party failed to move timely under 37 CFR 1.283 to rely on testimony in a related co-pending interference and is precluded from doing so inasmuch as the junior party has had no opportunity to recall the witnesses or to otherwise take testimony in rebuttal as provided by that rule. *Cushman v. Eberle*, supra.

(15) The Court of Customs and Patent Appeals will not ignore file histories of patent applications or a patent which are involved in an interference on appeal before it simply because those files have not been referred to in a stipulation of testimony under 37 CFR 1.272(c). *McNally v. Mossinghoff*, 213 USPQ 281 (CCPA 1982).

(16) Statements in a party's reply brief to explain why certain actions did not tend to indicate that the party abandoned, suppressed or concealed the invention in issue do not take the place of testimony. *Reid v. Engelskirchen*, 213 USPQ 59 (Bd. Pat. Int. 1980).

Board encourages a senior party to file a motion for additional discovery under 37 CFR 1.287(C), if one is going to be filed, during the period of preparation for testimony instead of later, because it benefits the entire proceeding. It apprises the junior party of the line of attack to be taken and being so apprised, junior party can present evidence pertinent to this issue during his testimony in chief. [Note that sufficient cause must be shown to excuse the belatedness of any motion for additional discovery filed after the close of the period of preparation for testimony, 37 CFR 1.287(c) and 1.246]. *Reid v. Engelskirchen*, supra.

(17) Timely filing of a motion raising an objection for a notice under 37 CFR 1.282 will minimize delays, permit proper correction of technical errors and minimize delays and inconvenience to the parties and the board. Failure to timely file such a motion here resulted in waiver of any objection to the authenticity or sufficiency of the noticing party's general statement of relevance, required by the rule. *Dreikorn v. Barlow*, 214 USPQ 632 (Comr. Pats. & TM 1981).

An uncertified copy of a U.S. Patent is a self authenticating document. *Dreikorn v. Barlow*, supra.

(18) Exhibits ordinarily do not speak for themselves. They must be attested to and explained by a competent witness. Attorney argument does not constitute competent evidence. *Kanoki-kis v. Land*, 214 USPQ 636 (Bd. Pat. Int. 1982).

(19) Belated opposition to a motion under 37 CFR 1.287(d)(1) is dismissed. Thus, the motion stands unopposed and is granted because the failure to timely oppose the motion is tantamount to a tacit agreement under 37 CFR 1.287(e), which provides that the parties may by agreement among themselves modify any of the foregoing requirements (set forth in the rule) setting times, consistent with the times set for testimony. *Jacobs v. Lawson*, 214 USPQ 907 (Bd. Pat. Int. 1982).

(20) In interference proceeding where counsel advises witness not to answer and witness acts on counsel's advice, parties should request Bd. of Patent Interferences to rule in the first instance on whether question should be answered. Board can immediately

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determine if question should be answered. If the witness still refuses to answer, parties can then go to Federal District Court for appropriate order pursuant to 35 USC 24. *Goodbar v. Klein*, 215 USPQ 539 (Comr. Pats. & TM 1981).

(21) The purpose of 37 CFR 1.287(a)(1)(i) is to afford each party prior to the taking of testimony adequate notice of the documents to be relied upon by the other parties to the interference [whether those documents speak for themselves or not]. The purpose of 37 CFR 1.282 is to allow a party to intro-

duce copies of official records and printed publications into evidence. Such documents speak for themselves and the party does not intend to take testimony regarding such documents. 37 CFR 1.282 and a notice issued thereunder cannot be used in lieu of timely service under 37 CFR 1.287(a) or a proper motion under 37 CFR 1.287(d)(1) where a party expects to take testimony with respect to the noticed documents. A motion to deny consideration of documents noticed under 37 CFR 1.282, whether it is characterized as an opposition to the Notice or a motion to deny consideration thereof must be promptly filed following

presentation of the documents objected to. *Bey v. Kollonitsch*, 215 USPQ 455 (Bd. Pat. Int. 1981).

(22) Although 37 CFR 1.283 does not expressly contain a time deadline, a motion based thereon must be filed within the time set for the moving party to take testimony in order to be seasonably filed. Otherwise the setting of testimony times would be meaningless. Evidence sought to be introduced via 37 CFR 1.283 must be submitted during the times set for taking testimony. *Smith v. Crivello*, 215 USPQ 443 (Bd. Pat. Int. 1981).

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