

§ 1.624

37 CFR Ch. I (7-1-02 Edition)

(1) The date on which the first drawing of the invention was made.

(2) The date on which the first written description of the invention was made.

(3) The date on which the invention was first disclosed by the inventor to another person.

(4) The date on which the invention was first conceived by the inventor.

(5) The date on which the invention was first actually reduced to practice. If the invention was not actually reduced to practice by or on behalf of the inventor prior to the party's filing date, the preliminary statement shall so state.

(6) The date after the inventor's conception of the invention when active exercise of reasonable diligence toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with §1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See §1.628(b) when a copy of the first drawing or written description cannot be filed with the preliminary statement.

[49 FR 48455, Dec. 12, 1984, as amended at 60 FR 14522, Mar. 17, 1995]

§ 1.624 Preliminary statement; invention made in a place other than the United States, a NAFTA country, or a WTO member country.

(a) When the invention was made in a place other than the United States, a NAFTA country, or a WTO member country and a party intends to rely on introduction into the United States, a NAFTA country, or a WTO member country, the preliminary statement must state the following facts as to the invention defined by each count:

(1) The date on which a drawing of the invention was first introduced into

the United States, a NAFTA country, or a WTO member country.

(2) The date on which a written description of the invention was first introduced into the United States, a NAFTA country, or a WTO member country.

(3) The date on which the invention was first disclosed to another person in the United States, a NAFTA country, or a WTO member country.

(4) The date on which the inventor's conception of the invention was first introduced into the United States, a NAFTA country, or a WTO member country.

(5) The date on which an actual reduction to practice of the invention was first introduced into the United States, a NAFTA country, or a WTO member country. If an actual reduction to practice of the invention was not introduced into the United States, a NAFTA country, or a WTO member country, the preliminary amendment shall so state.

(6) The date after introduction of the inventor's conception into the United States, a NAFTA country, or a WTO member country when active exercise of reasonable diligence in the United States, a NAFTA country, or a WTO member country toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with §1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was introduced into the United States, a NAFTA country, or a WTO member country, a copy of that drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was introduced into the United States, a NAFTA country, or a WTO member country, a copy of that written description shall be filed with and identified in the preliminary statement. See §1.628(b) when a copy of the first drawing or first written description introduced in the United States, a NAFTA country, or a WTO

member country cannot be filed with the preliminary statement.

[49 FR 48455, Dec. 12, 1984; 50 FR 23124, May 31, 1985, as amended at 60 FR 14523, Mar. 17, 1995]

§ 1.625 Preliminary statement; derivation by an opponent.

(a) When a party intends to prove derivation by an opponent from the party, the preliminary statement must state the following as to the invention defined by each count:

- (1) The name of the opponent.
- (2) The date on which the first drawing of the invention was made.
- (3) The date on which the first written description of the invention was made.
- (4) The date on which the invention was first disclosed by the inventor to another person.
- (5) The date on which the invention was first conceived by the inventor.
- (6) The date on which the invention was first communicated to the opponent.

(b) If a party intends to prove priority, the preliminary statement must also comply with § 1.623 or § 1.624.

(c) When a party alleges under paragraph (a)(2) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(3) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a first drawing or first written description cannot be filed with the preliminary statement.

[49 FR 48455, Dec. 12, 1984, as amended at 60 FR 14523, Mar. 17, 1995]

§ 1.626 Preliminary statement; earlier application.

When a party does not intend to present evidence to prove a conception or an actual reduction to practice and the party intends to rely solely on the filing date of an earlier filed application to prove a constructive reduction to practice, the preliminary statement

may so state and identify the earlier filed application with particularity.

[60 FR 14523, Mar. 17, 1995]

§ 1.627 Preliminary statement; sealing before filing, opening of statement.

(a) The preliminary statement and copies of any drawing or written description shall be filed in a sealed envelope bearing only the name of the party filing the statement and the style (e.g., Jones v. Smith) and number of the interference. The sealed envelope should contain only the preliminary statement and copies of any drawing or written description. If the preliminary statement is filed through the mail, the sealed envelope should be enclosed in an outer envelope addressed to the Commission of Patents and Trademarks in accordance with § 1.1(e).

(b) A preliminary statement may be opened only at the direction of an administrative patent judge.

[49 FR 48455, Dec. 12, 1984, as amended at 60 FR 14523, Mar. 17, 1995]

§ 1.628 Preliminary statement; correction of error.

(a) A material error arising through inadvertence or mistake in connection with a preliminary statement or drawings or a written description submitted therewith or omitted therefrom may be corrected by a motion (§ 1.635) for leave to file a corrected statement. The motion shall be supported by an affidavit stating the date the error was first discovered, shall be accompanied by the corrected statement and shall be filed as soon as practical after discovery of the error. If filed on or after the date set by the administrative patent judge for service of preliminary statements, the motion shall also show that correction of the error is essential to the interest of justice.

(b) When a party cannot attach a copy of a drawing or written description to the party's preliminary statement as required by § 1.623(c), § 1.624(c) or § 1.625(c), the party shall show good cause and explain in the preliminary statement why a copy of the drawing or written description cannot be attached to the preliminary statement and shall attach to the preliminary