

§ 1.635

provided by §1.48 or (b) correct inventorship of its patent involved in an interference as provided in §1.324. See §1.637(a).

§ 1.635 Miscellaneous motions.

A party seeking entry of an order relating to any matter other than a matter which may be raised under §1.633 or §1.634 may file a motion requesting entry of the order. See §1.637 (a) and (b).

§ 1.636 Motions, time for filing.

(a) A preliminary motion under §1.633 (a) through (h) shall be filed within a time period set by an administrative patent judge.

(b) A preliminary motion under §1.633 (i) or (j) shall be filed within 20 days of the service of the preliminary motion under §1.633 (a), (b), (c)(1), or (g) unless otherwise ordered by an administrative patent judge.

(c) A motion under §1.634 shall be diligently filed after an error is discovered in the inventorship of an application or patent involved in an interference unless otherwise ordered by an administrative patent judge.

(d) A motion under §1.635 shall be filed as specified in this subpart or when appropriate unless otherwise ordered by an administrative patent judge.

[60 FR 14524, Mar. 17, 1995]

§ 1.637 Content of motions.

(a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full statement of the reasons why the relief requested should be granted. If a party files a motion for judgment under §1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the

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

motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party.

(b) Unless otherwise ordered by an administrative patent judge or the Board, a motion under §1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all opponents in an effort in good faith to resolve by agreement the issues raised by the motion. The certificate shall indicate whether any opponent plans to oppose the motion. The provisions of this paragraph do not apply to a motion to suppress evidence (§1.656(h)).

(c) A preliminary motion under §1.633(c) shall explain why the interfering subject matter should be redefined.

(1) A preliminary motion seeking to add or substitute a count shall:

(i) Propose each count to be added or substituted.

(ii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the application.

(iii) Identify all claims in an opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claims to the opponent and apply the terms of the claims to the disclosure of the opponent's application.

(iv) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(v) Show that each proposed count defines a separate patentable invention from every other count proposed to remain in the interference.

(vi) Be accompanied by a motion under §1.633(f) requesting the benefit of the filing date of any earlier filed application, if benefit of the earlier filed