

§ 1.640

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

(f) If the opponent is to be called, or if evidence in the possession of the opponent is necessary, explain the evidence sought, what it will show, and why it is needed.

(g) When inter partes tests are to be performed, describe the tests stating what they will be expected to show.

[49 FR 48455, Dec. 12, 1984, as amended at 58 FR 49434, Sept. 23, 1993; 60 FR 14525, Mar. 17, 1995]

§ 1.640 Motions, hearing and decision, redeclaration of interference, order to show cause.

(a) A hearing on a motion may be held in the discretion of the administrative patent judge. The administrative patent judge shall set the date and time for any hearing. The length of oral argument at a hearing on a motion is a matter within the discretion of the administrative patent judge. An administrative patent judge may direct that a hearing take place by telephone.

(b) Unless an administrative patent judge or the Board is of the opinion that an earlier decision on a preliminary motion would materially advance the resolution of the interference, decision on a preliminary motion shall be deferred to final hearing. Motions not deferred to final hearing will be decided by an administrative patent judge. An administrative patent judge may consult with an examiner in deciding motions. An administrative patent judge may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action which will secure the just, speedy, and inexpensive determination of the interference. A matter raised by a party in support of or in opposition to a motion that is deferred to final hearing will not be entitled to consideration at final hearing unless the matter is raised in the party's brief at final hearing. If the administrative patent judge determines that the interference shall proceed to final hearing on the issue of priority or derivation, a time shall be set for each party to file a paper identifying any decisions on motions or on matters raised sua sponte by the administrative patent judge that the party wishes to have reviewed at final hearing as well as identifying any deferred motions that the party

wishes to have considered at final hearing. Any evidence that a party wishes to have considered with respect to the decisions and deferred motions identified by the party or by an opponent for consideration or review at final hearing shall be filed or, if appropriate, noticed under § 1.671(e) during the testimony-in-chief period of the party.

(1) When appropriate after the time expires for filing replies to oppositions to preliminary motions, the administrative patent judge will set a time for filing any amendment to an application involved in the interference and for filing a supplemental preliminary statement as to any new counts which may become involved in the interference if a preliminary motion to amend or substitute a count has been filed. Failure or refusal of a party to timely present an amendment required by an administrative patent judge shall be taken without further action as a disclaimer by that party of the invention involved. A supplemental preliminary statement shall meet the requirements specified in § 1.623, 1.624, 1.625, or 1.626, but need not be filed if a party states that it intends to rely on a preliminary statement previously filed under § 1.621(a). At an appropriate time in the interference, and when necessary, an order will be entered re-declaring the interference.

(2) After the time expires for filing preliminary motions, a further preliminary motion under § 1.633 will not be considered except as provided by § 1.645(b).

(c) When a decision on any motion under § 1.633, 1.634, or 1.635 or on any matter raised sua sponte by an administrative patent judge is entered which does not result in the issuance of an order to show cause under paragraph (d) of this section, a party may file a request for reconsideration within 14 days after the date of the decision. The request for reconsideration shall be filed and served by hand or Express Mail. The filing of a request for reconsideration will not stay any time period set by the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. No

opposition to a request for reconsideration shall be filed unless requested by an administrative patent judge or the Board. A decision ordinarily will not be modified unless an opposition has been requested by an administrative patent judge or the Board. The request for reconsideration normally will be acted on by the administrative patent judge or the panel of the Board which issued the decision.

(d) An administrative patent judge may issue an order to show cause why judgment should not be entered against a party when:

(1) A decision on a motion or on a matter raised sua sponte by an administrative patent judge is entered which is dispositive of the interference against the party as to any count;

(2) The party is a junior party who fails to file a preliminary statement; or

(3) The party is a junior party whose preliminary statement fails to overcome the effective filing date of another party.

(e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which shows good cause why judgment should not be entered in accordance with the order.

(1) If the order was issued under paragraph (d)(1) of this section, the paper may:

(i) Request that final hearing be set to review any decision which is the basis for the order as well as any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at final hearing or

(ii) Fully explain why judgment should not be entered.

(2) Any opponent may file a response to the paper within 20 days of the date of service of the paper. If the order was issued under paragraph (d)(1) of this section and the party's paper includes a request for final hearing, the opponent's response must identify every decision of the administrative patent judge that the opponent wishes to have reviewed by the Board at a final hearing. If the order was issued under paragraph (d)(1) of this section and the paper does not include a request for

final hearing, the opponent's response may include a request for final hearing, which must identify every decision of the administrative patent judge that the opponent wishes to have reviewed by the Board at a final hearing. Where only the opponent's response includes a request for a final hearing, the party filing the paper shall, within 14 days from the date of service of the opponent's response, file a reply identifying any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at a final hearing.

(3) The paper or the response should be accompanied by a motion (§1.635) requesting a testimony period if either party wishes to introduce any evidence to be considered at final hearing (§1.671). Any evidence that a party wishes to have considered with respect to the decisions and deferred motions identified for consideration or review at final hearing shall be filed or, if appropriate, noticed under §1.671(e) during the testimony period of the party. A request for a testimony period shall be construed as including a request for final hearing.

(4) If the paper contains an explanation of why judgment should not be entered in accordance with the order, and if no party has requested a final hearing, the decision that is the basis for the order shall be reviewed based on the contents of the paper and the response. If the paper fails to show good cause, the Board shall enter judgment against the party against whom the order issued.

[49 FR 48455, Dec. 12, 1984; 50 FR 23124, May 31, 1985, as amended at 60 FR 14525, Mar. 17, 1995]

§ 1.641 Unpatentability discovered by administrative patent judge.

(a) During the pendency of an interference, if the administrative patent judge becomes aware of a reason why a claim designated to correspond to a count may not be patentable, the administrative patent judge may enter an order notifying the parties of the reason and set a time within which each party may present its views, including any argument and any supporting evidence, and, in the case of the party whose claim may be unpatentable, any