

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

KHAVARI,

Junior Party,

v.

D.T.,

Senior Party.

Patent Interference No. 104,696

ORDER

(RETURNING PAPER)

INTRODUCTION

In Paper No. 20, the administrative patent judge returned Paper No. 19 for formal and substantive reasons. Copies of Paper No. 19 that cure the formal problems arrived on 11 July 2001. Nevertheless, the order in Paper No. 20 is maintained.

DISCUSSION

On 9 July 2001, the parties were obligated to file their motions lists and did so. D.T.'s motion list was returned for two reasons. The first reason was a series of formal problems. Formal problems are generally curable and, in any case, the order returning the paper noted D.T.'s listed motions. The order was also based on a second ground, however, that the list

included additional matter that was argumentative. The newly arrived D.T. motions list (no paper number assigned) appears to cure the formal problems at the cost of timeliness. Like formal problems, untimeliness is often excusable if there is no prejudice. In the present case, however, the substantive problems and timeliness may be linked.

The parties were required to submit motions lists on fairly short notice.¹ In filing the motions lists, the parties were required to provide detail (Paper No. 16). The requirement for specificity is not unique to this interference. Motions lists are used to determine the motions schedule that the administrative patent judge must set, 37 C.F.R. § 1.636(a). If the lists are cryptically brief, then there is no reasonable basis on which to tailor a schedule that will ensure the proceeding is fast, fair, and inexpensive as required under 37 C.F.R. § 1.601. In the present case, it was particularly important, since Khavari had identified a threshold issue,² that D.T. provide sufficient information for the administrative patent judge to see if D.T. had any motions inextricably intertwined with Khavari's no interference-in-fact motion.³ It was also important since, given the short time until motions were due, a decision would likely be made without further discussion with the parties.

D.T.'s detailed "motion list" ran to sixty-nine pages, including exhibits. As a consequence, it could not be filed by facsimile and likely took until close to the filing deadline to

¹ The short notice arose from the parties request to put off the filing of the lists to avoid prejudicing ongoing settlement discussions (Paper No. 14). The parties had months to prepare for the eventuality of filing these lists and both indicated that they could comply with the deadline (Paper No. 16 at 2). Ordinarily such lists are rather simple affairs amounting to a few pages. Hence, the parties have no cause to complain about prejudice resulting from the short notice.

² No interference-in-fact.

³ For instance, if D.T. were planning to add claims that more closely interfered with Khavari's claims, addressing that motion could have mooted Khavari's no interference-in-fact motion, thus meeting the goal of reducing costs and inefficiencies related to the interference.

complete. Both of these factors probably contributed to the untimeliness of the formally correct filing.⁴ Moreover, D.T.'s "motions list" remains argumentative. Argument is improper in a motions list because, inter alia, issues for preliminary motions must be raised during the motions period set by the administrative patent judge, not whenever and however a party chooses to raise them. This is not simply a control issue (although that is significant since it would be unfair to permit one party to control the interference and chaotic for both to control it). Rather it works an actual prejudice against Khavari since the record would contain arguments that Khavari may never have a chance to address.

ORDER

Upon consideration of D.T.'s newly arrived paper, it is

ORDERED that the unnumbered paper entitled "D.T. LIST OF PRELIMINARY MOTIONS", along with the working copy of the same paper, be returned to D.T.

RICHARD TORCZON
Administrative Patent Judge

⁴ The formal requirements are somewhat relaxed for facsimile filings, mainly because facsimiles are limited to five pages. The support staff at the Board can meet some of the formal requirements for facsimile filings without undue burden because such filings are so short.