INTERFERENCE TRIAL SECTION PRECEDENTIAL OPINION

The opinion in support of the decision being entered today is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise not binding precedent. The decision was entered on 26 April 1999.

Paper 34

Filed by: Trial Section Motions Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

Entered
26 April 1999

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

B. M.,

Junior Party,
(Patent 5,xxx,xxx),

v.

H.G.,

Senior Party
(Application 08/yyy,yyy).

Patent Interference No. 104,CCC

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE and TORCZON, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

ORDER
DENYING REQUEST FOR EXTENSION OF TIME

A. Introduction

The parties, through a conference call, sought an extension of time to take action during the preliminary motion phase of this interference. Events which transpired in connection with the attempt to obtain an extension of time raise important issues with respect to the administration of justice in connection with interferences. We take this opportunity to discuss those issues with the view to assisting those who practice before the PTO in interference matters.

B. Background and findings of fact

Trial Section practice

1. In an effort to improve the administration of interferences in the PTO, the Chief Administrative Patent Judge determined that a Trial Section should be created. Notice of the Chief Administrative Patent Judge of November 6, 1998, "Interference Practice--New Procedures for Handling Interferences Cases at the Board of Patent Appeals and Interferences," 1217 Off. Gaz. Pat. & Tm. Office 18 (Dec. 1, 1998).

2. Consistent with the objectives sought to be accomplished by the Chief Judge, the Trial Section has developed procedures for handling interferences. Those procedures include the use of standard forms for (1) declaring interferences, (2) taking action during the preliminary motion phase of an

interference and (3) taking action during the priority testimony and final hearing phase of the interference.

3. Times for taking action are almost always set during a conference call after counsel have previously submitted a list of proposed preliminary motions to be filed by the party each represents.

4. Through the use of a conference call, times for taking action can be set which avoid conflicts, such as (1) other obligations of counsel and the judge in other cases and (2) matters, such as scheduled vacations and other obligations of a personal nature.

5. The following times for taking action are set during the preliminary motion phase of an interference:

a. TIME PERIOD 1--for filing and serving preliminary motions (37 CFR § 1.636(a))

b. TIME PERIOD 2--for filing and serving preliminary motions pursuant to 37 CFR § 1.633(i) and (j) responsive to a preliminary motion filed by an opponent (37 CFR § 1.636(b)).

c. TIME PERIOD 3--for filing and serving oppositions to all preliminary motions, including preliminary motions filed pursuant to 37 CFR § 1.633(i) and (j).

d. TIME PERIOD 4--for filing replies to all oppositions.

e. TIME PERIOD 5--for filing:

   (1) a request for a hearing;

   (2) motions to suppress evidence relied upon by an opponent in connection with preliminary motions; and

   (3) observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies.

f. TIME PERIOD 6--for filing:

   (1) oppositions to an opponent's motion to suppress and

   (2) a response to observations by a cross-examining party with respect to cross-examination of an opponent's affiants following filing of replies.

g. TIME PERIOD 7--for filing replies to oppositions to motions to suppress.

h. TIME PERIOD 8--for filing the record upon which preliminary motions will be decided[1].

6. Counsel for the parties are expressly authorized to stipulate different times (earlier or later) for TIME PERIODS 1 through 6. Counsel are expressly precluded from stipulating an extension of TIME PERIOD 7.

7. The order setting times for taking action during the preliminary motion phase does not authorize counsel to stipulate any extension of TIME PERIOD 8.

Events in this interference

8. The interference was declared on November 25, 1998, by an administrative patent judge assigned to the Trial Section.

9. A conference call with counsel to set dates for taking action during the preliminary motion phase of the interference took place on January 15, 1999. Participating in the conference call were counsel for B.M., counsel for H.G. and

[1] The record includes (1) an original and three copies of each exhibit, including affidavits, and deposition transcript; (2) three copies of preliminary motions, oppositions and replies previously filed should be filed with the board, with each copy of each motion, its opposition and its reply any observations and any response to observations being filed in a separate folder and (3) any ZIP® disk and/or CD-ROM which a party elects to file.

the administrative patent judge designated to handle the interference.

10. A summary of the conference call is set out in an order entered the day of the conference call (Paper 26, page 2):

> The conference call was for the purpose of setting times for taking action during the preliminary motion phase of the interference. In view of the posture of the case, the issue of priority of invention will be resolved when preliminary motions are filed. Hence, at the time preliminary motions are decided, the board will enter a final decision. Accordingly, if the parties wish oral argument, they should ask for a hearing on preliminary motions. <u>See</u> TIME PERIOD 5, <u>infra</u>.
>
> B.M. indicated an intent to file a preliminary motion for benefit (37 CFR § 1.633(f)) of an earlier filed *** [foreign] application. H.G. will oppose.
>
> H.G. indicated an intent to file a preliminary motion to add two (possibly more) claims to the H.G. application involved in the interference and to designate at least one of those claims as corresponding to the count (37 CFR § 1.633(c)(2)). Understandably at this point, B.M. could not indicate whether it would oppose.
>
> B.M. is advised that its list of issues was timely received.
>
> As currently advised, the parties do not expect to rely on testimony, although it was recognized that neither had seen the other's preliminary motion. If there comes a time when testimony is relied on<u>and</u> an opponent wishes to cross-examine, counsel should place a conference call so that the dates set herein may be appropriately adjusted.

11. The following dates were set for taking action:

a. TIME PERIOD 1--February 16, 1999.

b. TIME PERIOD 2--Not needed[2].

c. TIME PERIOD 3--March 17, 1999.

d. TIME PERIOD 4--April 16, 1999.

e. TIME PERIOD 5--April 16, 1999 (for the sole purpose of requesting an oral hearing.

f. TIME PERIOD 6--Not needed.

g. TIME PERIOD 7--Not needed.

h. TIME PERIOD 8--April 29, 1999[3].

12. It should be emphasized that these times for taking action were set based on representations of, and agreement between, counsel during a telephone conference call.

13. There came a time during the interference when counsel stipulated changes in some of the times for taking action. See the NOTICE OF STIPULATION OF DIFFERENT TIMES (Paper 31, filed March 17, 1999).

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[2] A truism of interference practice is that no two interferences are substantively or procedurally the same. Hence, it is not always necessary to set dates for each of TIME PERIODS 1 through 8. One of the benefits of a conference call, after parties submit lists of proposed preliminary motions to be filed, is that times can be set which accomplish in any given interference the goal of just, speedy and inexpensive interferences as set out in 37 CFR § 1.601.

[3] Originally the date was set at April 23, 1999, but was reset during a conference call to April 29, 1999.

14. Based on the stipulation, the times for taking action became (differences shown in **bold**):

a. TIME PERIOD 1--February 16, 1999.

b. TIME PERIOD 2--Not needed.

c. TIME PERIOD 3--**April 17, 1999**.

d. TIME PERIOD 4--**May 16, 1999**.

e. TIME PERIOD 5--**May 16, 1999**.

f. TIME PERIOD 6--Not needed.

g. TIME PERIOD 7--Not needed.

h. TIME PERIOD 8--April 29, 1999.

15. A curious aspect of the stipulation is that it has TIME PERIOD 8 expiring prior to TIME PERIOD 5. In other words, filing of the record and other documents (which includes replies) is to take place before the reply is filed!

16. Judges, like attorneys, must manage cases. In the case of interferences before the Trial Section, judges assigned to the Trial Section docket cases for action based on TIME PERIOD 8. When TIME PERIOD 8 arrives, the case is taken up for action. Hence, there may be little, if any, need to review stipulated extensions of time.

17. Nevertheless, in this particular case, the stipulation was approved, but only as to TIME PERIOD 3. It could not be otherwise approved given that TIME PERIOD 5 was stipulated

to be after TIME PERIOD 8 and, as noted earlier, there is nothing in the order setting times which authorizes counsel to stipulate a change to TIME PERIOD 8.

C. Discussion

The Trial Section practice, as outlined above, was adopted with the view to (1) having counsel participate in the setting of times, (2) allowing counsel the flexibility to change certain times for taking action and (3) permit the Trial Section to know when a case can be taken up for action. The times are set taking into consideration whether the Trial Section can reach the matter if and when TIME PERIOD 8 actually comes to pass.[4]

The Trial Section counts on the interference bar to make things happen by TIME PERIOD 8. Understandably when there may be as many as eight separate actions which are authorized to occur, there may come a time when a change in a date for taking action is necessary. For this reason, counsel are allowed to change dates. But, counsel cannot change the dates of TIME PERIOD 7 or TIME PERIOD 8. TIME PERIOD 7 cannot be changed by stipulation because the order setting the times specifically says that TIME PERIOD 7 cannot be changed. TIME PERIOD 8 cannot be changed by

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[4] In a large number of interferences, TIME PERIOD 8 never arrives because the parties settle before TIME PERIOD 8.

stipulation, because nothing in the order authorizes a stipulated change to TIME PERIOD 8.

If the Trial Section, consistent with the objectives of the Chief Judge's notice of November 6, 1998, is to accomplish a just, speedy and inexpensive resolution of interferences, the Trial Section must have control over its docket. Compare Rosemount, Inc. v. Beckman Instruments, Inc. 727 F.2d 1540, 1549-50, 221 USPQ 1, 10 (Fed. Cir. 1984) (discussing a need for the exercise of discretion by a tribunal in carrying out its duty of managing the administrative process, the business of the tribunal and the administration of justice in a fair and even-handed manner).

It may be true that in the recent past there have been certain delays in the resolution of issues in interferences, both at the preliminary motion and final hearing stages. The Chief Judge has designed, and is taking action to implement, a program which hopefully will minimize delays in resolution of interferences, But, the Chief Judge, Trial Section and the board cannot do it alone. Making the interference process work in a just, speedy and inexpensive manner (37 CFR § 1.601) requires the assistance of the interference bar. As a general proposition, the Trial Section can report that the interference bar has been of considerable assistance in implementing the Chief Judge's program. Furthermore, under the practice adopted by the Trial

Section, interferences have been more or less running themselves in an efficient manner during the preliminary motion phase, in large measure due to effective lawyering by the interference bar.

If, however, it becomes apparent that a particular interference or a particular attorney requires "special attention," then the Trial Section is prepared to take whatever action is necessary to give special attention. The costs are likely to go up for the party or parties requiring special attention.

The Trial Section appreciates the effort being made by the interference bar to help the Chief Judge achieve the objectives of his program. Hopefully, the information contained in this opinion will serve to assist the bar in understanding how the Trial Section is attempting to implement the Chief Judge's program. In particular, a stipulation cannot extend TIME PERIODS 1 through 6 beyond TIME PERIOD 7 or TIME PERIOD 8.

D. Order

Upon consideration of the oral request for an extension of time made during a conference call on April 20, 1999, it is, for the reasons given,

ORDERED that the request is denied.

FURTHER ORDERED that the time for complying with all remaining TIME PERIODS, including TIME PERIOD 8 is **April 29, 1999**.

FURTHER ORDERED that all papers due on April 29, 1999, must reach the Office of the Clerk by **noon on April 29, 1999**.

FURTHER ORDERED that the opinion in support of this order shall be published on the PTO Web Page without identification of the parties, counsel, application numbers or the interference number.

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FRED E. McKELVEY, Senior)
Administrative Patent Judge)
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RICHARD E. SCHAFER)
Administrative Patent Judge)
)
) BOARD OF PATENT
______________________________) APPEALS AND
JAMESON LEE) INTERFERENCES
Administrative Patent Judge)
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RICHARD TORCZON)
Administrative Patent Judge)

26 April 1999
Arlington, VA