THIS OPINION IS A PRECEDENTIAL OPINION
The opinion in support of the decision being entered today is binding precedent of the Board of Patent Appeals and Interference. The decision was enterd December 2, 1998.

Paper No. 10

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2 December 1998

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

A.S.

Junior Party,

v.

B.R.,

Senior Party.

Patent Interference No. 104,___

Before: STONER, Chief Administrative Patent Judge, HARKCOM, Vice-Chief Administrative Patent Judge, McKELVEY, Senior Administrative Patent Judge, and SCHAFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION AND ORDER

A. Findings of fact

1. The interference was declared on 13 November 1998.

See NOTICE DECLARING INTERFERENCE (Paper 1).

2. On 20 November 1998, at approximately 7:19 a.m., counsel for the senior party sent the following e-mail (Paper 8) to an administrator assigned to the Trial Section of the Board of Patent Appeals and Interferences:

> There is an obvious bozo error in the count of this newly declared interference. Do we need a conference call with the judge in order to correct it, or can I just tell you and have you (or the judge) take care of correcting it via a supplemental order?

3. The e-mail identified the interference number of this interference.

4. There is no indication in the e-mail that the e-mail was sent electronically to, or otherwise served on, counsel for the junior party.

5. Upon becoming aware of the existence of the e-mail, the administrative patent judge designated to handle this interference determined, reluctantly, that a telephone conference call was an appropriate manner in which to address the e-mail.

6. Pursuant to his determination, personnel assigned to the Trial Section arranged for a telephone conference call to take place.

7. On Monday, November 30, 1998, at approximately 10:00 a.m., a telephone conference call was held involving:

(1) Counsel for the junior party;

(2) Counsel for the senior party; and

(3) the Administrative Patent Judge designated to handle this interference.

8. During the conference call, counsel for the senior party explained the error in Count 1.

9. Counsel for the junior party agreed that Count 1 contained an error.

10. Counsel for the junior party also confirmed that he had not received a copy of the e-mail.

11. The administrative patent judge designated to handle this interference determined that Count 1 as set out in the NOTICE DECLARING INTERFERENCE contained an error.

12. An ORDER REDECLARING INTERFERENCE (Paper 9) is being entered simultaneously with this MEMORANDUM OPINION AND ORDER. The ORDER REDECLARING INTERFERENCE substitutes Count 2 for Count 1.

B. Discussion

We take this opportunity to comment on ex parte communications in interference cases with administrative patent judges, administrators and other personnel at the Board, including those assigned to the Trial Section.

1. Ex parte communications in interference cases

a. Canons and rules applicable to practitioners before the Patent and Trademark Office

The Code of Professional Responsibility of the Patent and Trademark Office provides as follows (37 CFR § 10.93(b)):

> In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner[1] shall not communicate,[2] or cause another to communicate, as to the merits of the cause with a judge,[3] official, or Office employee[4] before whom the proceedings is pending, except:
>
> (1) In the course of the official proceedings in the cause.
>
> (2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel ***.
>
> (3) Orally upon adequate notice to opposing counsel ***.
>
> (4) As otherwise authorized by law.

The interference rules require that a copy of each paper filed in the Patent and Trademark Office in an interference shall be served upon all opponents. 37 CFR § 1.646. As noted earlier, there is no indication on the face of the e-mail of 20 November 1998, that the e-mail had been served by counsel for the senior party on opposing counsel.

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[1] A "practitioner" includes an attorney registered to practice before the Patent and Trademark Office in patent cases. 37 CFR § 10.1(r). Counsel for the senior party is a "practitioner."

[2] A communication in the form of an e-mail falls within the meaning of the word "communicate" in §10.93(b).

[3] An administrative patent judge is a "judge" within the meaning of 37 CFR § 10.93(b).

[4] Administrative patent judges, administrators and other individuals employed at the Board are "Office employees."

b. Canons relevant to administrative patent judges

There are no canons of judicial ethics, as such, directly applicable to administrative patent judges. However, regulations of the Department of Commerce provide the following (15 CFR § 0.735-10a (1997)):

> An employee [of the Patent and Trademark Office, a unit of the Department of Commerce,] shall avoid any action, whether or not specifically prohibited by this subpart, which might result in, or create the appearance of:
>
> ***
>
> (b) Giving preferential treatment to any person;
>
> ***
>
> (d) Losing complete independence or impartiality;
>
> (e) Making a government decision outside official channels; or
>
> (f) Affecting adversely the confidence of the public in the integrity of the Government.

Likewise, the Standards of Conduct of the Office Personnel Management provide (5 CFR § 2635.101(b)(8) (1997)):

> Employees [of the U.S. Government] shall act impartially and not give preferential treatment to any private organization or individual.

The Code of Conduct for United States Judges is not directly applicable to administrative patent judges. Nevertheless, the functions performed by a United States Judge and an administrative patent judge are similar. Both decide cases and

concrete controversies between adverse parties on a record based on the admissible evidence. Accordingly, the Code of Conduct for United States Judges can provide meaningful guidance as to what conduct might be viewed as (1) giving, or appearing to give, preferential treatment to a particular person, (2) losing, or appearing to lose, impartiality, (3) making, or appearing to make, decisions outside official channels, and/or (4) affecting, or appearing to affect, the confidence of the public in the integrity of the board within the meaning of 15 CFR § 0.735-10a (1997) and 5 CFR § 2635.101(b)(8) (1997).

The Code of Conduct for United States Judges provides in Canon 2(A) (1997) as follows:

> A judge *** should act at all times in a manner that promotes public confidence in the integrity and impartiality of the judiciary.

Canon 2(b) provides:

> A judge should not *** convey or permit others to convey the impression that they are in a special position to influence the judge.

Canon 3(A)(4) provides:

> A judge should *** neither initiate nor consider ex parte communications on the merits, or procedures affecting the merits, of a pending or impending proceeding.

The Canons of Judicial Ethics of the American Bar Association, as long ago as 1971, provided in Section 17 that:

> A judge should not permit private interviews, arguments or communications designed to influence *** judicial action, where interests to be affected thereby are not represented before *** [the judge], except in cases where provision is made by law for ex parte communications.[5]
>
> While the conditions under which briefs of argument are to be received are largely matters of local rule or practice, *** [a judge] should not permit the contents of such brief *** to be concealed from opposing counsel. Ordinarily all communications of counsel to the judge intended or calculated to influence action should be made known to opposing counsel.

In adjudications required by law to be conducted before an administrative law judge (ALJ), "an ex parte communication relevant to the merits of the proceeding" (emphasis added) cannot be made by counsel to the ALJ. 5 U.S.C. § 557(d)(1)(A). Likewise, the ALJ is not to initiate an ex parte communication relevant to the merits of the proceeding. 5 U.S.C. § 557(d)(1)(B). Something which is "relevant" to the merits includes the merits and the procedure to be followed in

[5] Insofar as we are aware, there are no provisions made by law for ex parte communications with an administrative patent judge. Administrative patent judges do not issue temporary restraining orders or other emergency orders. Hence, there is no practical reason for an ex parte communication relevant to the merits of a case.

establishing a record upon which a decision on the merits will be based.

2. Past practice at the Board of Patent Appeals and Interferences

It is our understanding that in the past there probably have been two types of ex parte communications in connection with interference cases between counsel and personnel of the Board, including judges.

One type of ex parte communication has been for general information. General information would include, for example, (1) a call to the Clerk's Office to determine the hours the office is open; (2) after notice to an opponent, a call to an administrator to arrange for a conference call with a judge, (3) a call to an administrator to determine whether papers and files had arrived at the board which were sent by an examiner to the board for declaration of an interference and (4) a call to an administrator concerning general procedure apart from any particular interference (not included would be a so-called "hypothetical" when the person making the call has a particular interference in mind).

A second type of ex parte communication which unfortunately may have occurred in the past is one to an administrative patent judge to determine procedure to be followed in a particular

interference pending before that judge or the board,[6] or perhaps to discuss the merits of a particular interference pending before that judge or the board.

We encourage the former and cannot condone the latter.

When, if ever, is an ex parte communication in connection with a particular interference proper? To the extent there is any difficulty determining whether a proposed ex parte communication is proper, the solution to any difficulty is easy: if there is any doubt, do not make the ex parte communication. Instead, counsel can file a paper and serve the paper on opposing counsel. Alternatively, counsel can communicate with opposing counsel so that a mutual time can be agreed upon for placing a telephone conference call to an administrator or the administrative patent judge.

A good first general rule would be that if a practitioner is communicating ex parte with an administrative patent judge for the purpose of changing, or determining how to change, the status quo of an interference, there is probably a 100% chance that the ex parte communication is not proper. This first general rule is consistent with Canon 3(A)(4) of the Code of Conduct for United States Judges which provides that there should be no ex parte communications "on the merits, or procedures affecting the

[6] Evidence of this fact is apparent from an e-mail sent to the Chief Judge on 1 December 1998 (16:01 hours) by counsel for the senior party which states in part "In the old days [prior to establishment of the Trial Section], you called an APJ directly ***."

merits, of a pending *** proceeding" (emphasis added). Compare also 5 U.S.C. § 557(d)(1)(A), supra.

A good second general rule would be that if a practitioner is communicating ex parte with an administrator the purpose of changing the status quo of an interference, there is probably a 100% chance that the ex parte communication is not proper. On the other hand, questions of a procedural nature, such as those discussed earlier in this opinion, are acceptable.

In our view, the e-mail of 20 November 1998 was an improper ex parte communication. Superficially, the e-mail might be viewed as a question of a procedural nature to an administrator. In other words, what may have been intended by counsel for the senior party was the following:

> There is an obvious *** error in the count of this newly declared interference. Do we need a conference call with the judge in order to correct it ***?

But, the "or can I just tell you and have you (or the judge) take care of correcting it via a supplemental order" plausibly can be construed as an ex parte request seeking sua sponte action by the administrative patent judge to correct the "obvious" error. After all, if the error is as "obvious" as the e-mail suggested, then it is an error which the administrative patent judge designated to handle the interference could have readily appreciated and changed without any input from counsel.

Interestingly enough, during the conference call, counsel for the senior party was not able to readily state the precise change which needed to be made to the count. Rather, the suggested change to be made came from counsel for the junior party.

Independently, it was both (1) the "or can I just tell you and have you (or the judge) take care of correcting it via a supplemental order" and (2) the lack of any indication of notice to opposing counsel that gave pause to personnel of the Board. So that the record be entirely clear, we make known that the administrator receiving the e-mail, as well as numerous administrative patent judges, at least upon initial reading of the e-mail, concluded that the e-mail was an improper ex parte attempt to change the status quo in this interference through "sua sponte" action by the administrative patent judge designated to handle this interference.

The error uncovered by counsel for the senior party could have been called to the attention of the Trial Section by way of a paper served on counsel for the junior party. Alternatively, a conference call could have been sought through the administrator by counsel for the senior party, after notice to counsel for the

junior party.[7] The difficulty with the e-mail, as a whole, is that if the Trial Section had corrected the "obvious" error sua sponte, counsel for the junior party may not have learned of the ex parte communication to the Trial Section. Even if counsel for the junior party had eventually learned of the ex parte communication, the overall impression counsel for the junior party may have been left with is that counsel for the senior party somehow has an "in" with the Trial Section.

The public, the inventors and their assignees involved in interferences, counsel for the inventors and their assignees and our reviewing courts are entitled to assume that cases before the Patent and Trademark Office are conducted with impartiality and without improper ex parte communications. Improper ex parte communications (1) undermine the administration of justice in cases before the Patent and Trademark Office, (2) undermine the

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[7] It has come to our attention that there have been situations where

(1) counsel for a party calls an administrator to arrange for a telephone conference call (the administrator has presumed that the call was being made after notice to opposing counsel);

(2) the administrator advises counsel when the conference call is to be placed; and

(3) counsel then "announces" to counsel for the opponent that "the judge will receive our call at 3:00 p.m."

All telephone calls by counsel to schedule a telephone conference call with an administrative patent judge should be made only after opposing counsel is notified that the call will be placed to the administrator and opposing counsel (a) agrees that counsel may place an ex parte call to the administrator or (b) declines to cooperate or participate in a telephone conference call unless ordered by the judge. If opposing counsel indicates that the telephone conference call itself to the administrator should be by way of an inter partes conference call, then the call to the administrator must be by way of a conference call.

public's confidence in the impartiality of officials of the government whose duty it is to decide in an even-handed manner cases and controversies between adversary parties and (3) erode the very foundation upon which the American system of deciding cases and controversies is based.

In this particular case, we give the author of the e-mail the benefit of any doubt. However, through this opinion we announce that, in the future, practitioners in interference cases should adhere strictly to the well-established principles that most ex parte communications with a judge are improper and that improper ex parte communications will not be condoned. We would be remiss if we did not note that it is just as bad for a judge to receive and act in any manner on an improper ex parte communication as it is for an attorney to make the improper ex parte communication in the first place.

As noted in Finding 5, the administrative patent judge designated to handle this interference, with some reluctance, determined that a telephone conference call was an appropriate manner to respond to the improper ex parte communication. His reluctance was bottomed on (1) the failure of the e-mail to contain any indication that it has been "served" on counsel for the junior party and (2) the fact any response to the e-mail might have the appearance of giving special treatment to counsel who sent the e-mail to the administrator. The conference call

took place essentially to determine whether counsel for the junior party had received the e-mail.

In the future, any e-mail received by the Trial Section plausibly related to a particular interference will be returned unanswered if it does not on its face indicate "service" by e-mail upon opposing counsel. Moreover, e-mail cannot take the place of pleadings which are to be filed in the manner required by the rules. Any e-mail sent to the Trial Section must also be sent by e-mail to opposing counsel. If opposing counsel does not have e-mail, then a party may not communicate inter partes with the Board through e-mail in a specific interference.

C. Order

Upon consideration of the record, it is

ORDERED that a copy of this opinion without identifying the parties or counsel shall be published.

FURTHER ORDERED that the Clerk shall mail a copy of this MEMORANDUM OPINION AND ORDER to counsel of record.

BRUCE H. STONER, JR, Chief Administrative Patent Judge	
GARY V. HARKCOM, Vice Chief Administrative Patent Judge	
FRED E. McKELVEY, Senior Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD E. SCHAFER, Administrative Patent Judge	
JAMESON LEE, Administrative Patent Judge	