The opinion in support of the decision being
entered today is binding precedent of the Trial Section

Paper 147

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Entered
22 May 2000

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID E. CHARLTON,

Junior Party,
(Application 08/465,675),

v.

ROBERT W. ROSENSTEIN,

Senior Party
(Patent 5,591,645
Reissue Application 09/167,028).

Patent Interference 104,148

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER, LEE and TORCZON,[1] Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
(Decision on Rosenstein request for reconsideration)

[1] Judge Torczon joins in Part B(3) of the opinion, which is binding precedent of the Trial Section; Judge Torczon otherwise did not participate in deciding the request for reconsideration.

A. Introduction

Rosenstein has filed ROSENSTEIN REQUEST FOR RECONSIDERATION (Paper 137) seeking reconsideration of portions of our MEMORANDUM OPINION and ORDER--decision on preliminary and other motions (Paper 127) entered 8 March 2000. Charlton was invited to respond (Paper 138) and has timely filed a response (Paper 140).

B. Discussion

1.

Rosenstein seeks reconsideration of that part of our decision on preliminary motions which

(1) granted Charlton Preliminary Motion 1 and

(2) denied Rosenstein Preliminary Motion 7.

2.

Charlton opposes, raising three issues. Specifically, Charlton argues that the request for reconsideration

(1) is untimely;

(2) raises new issues; and

(3) should be denied on the merits.

a. Rules

The rules authorize a party to file a request for reconsideration of a decision on preliminary motions. 37 CFR § 1.640(c). The party must file the request for reconsideration within 14 days of the date after entry of the decision sought to be reconsidered. Id.

The rules, however, do not preclude the board from reconsidering, sua sponte, at any time any order entered in the interference. Stated in other terms, a tribunal has inherent authority unless precluded by its rules to reconsider orders entered in cases before it while the case is before the tribunal.

b. Facts

In this interference, a MEMORANDUM OPINION and ORDER deciding preliminary motions was entered on 8 March 2000 (Paper 127).

The time for either party to request reconsideration under the 14-day limit of Rule 640(c) expired on 22 March 2000.

In a communication entered on 3 April 2000 (Paper 134), the board authorized the parties to file requests for reconsideration if they be so advised.

A time period of 14 days was set for filing requests for reconsideration.

Rosenstein thereafter filed its request for reconsideration on 17 April 2000 (Paper 137).

Charlton was invited to respond to the request in an ORDER INVITING RESPONSE TO REQUEST FOR RECONSIDERATION entered 19 April 2000 (Paper 138).

Charlton timely filed an opposition on 5 May 2000 (Paper 140).

c. Discussion

A review of the facts outlined above demonstrates that the Rosenstein request for reconsideration was filed at the express authorization of the board. Had the board not authorized the request for reconsideration, then Rosenstein's request for reconsideration would have been untimely under the rules. Compare Miller v. Chester, 13 USPQ2d 1387, 1388 col. 2 (Bd. Pat. App. & Int. 1989). Thus, Rosenstein itself could not extend the time for filing a request for reconsideration. Rosenstein is bound by the 14-day time period of Rule 640(b). The rule, however, does not preclude the board from exercising discretion to authorize--at its request--the filing of a request for reconsideration beyond the 14-day period. 37 CFR § 1.610(c). As noted earlier, a tribunal has inherent authority to exercise discretion to correct, sua sponte, at any time errors it discovers in the record.

There is a reason why discretion was exercised sua sponte to give the parties an opportunity to file a request for reconsideration beyond the 14-day period of Rule 640(c). To fully appreciate the reason, a full understanding of certain aspects of the rules is necessary.

Under the rules, an administrative patent judge (APJ) is designated to handle an interference. 37 CFR § 1.610(a). The APJ is authorized to enter all interlocutory orders. Id. A decision on preliminary motions is an interlocutory order. 37 CFR § 1.601(q). A party is authorized to seek reconsideration of an interlocutory order. 37 CFR § 1.640(c). The party may also ask for review of an interlocutory order at final hearing before a 3-judge panel. 37 CFR § 1.655.

The rules also authorize, at the discretion of the APJ designated to handle an interference, entry of interlocutory orders by a 3-judge motions panel. 37 CFR § 1.610(b). Since the creation of the Trial Section,[2] it has been standard practice to have a 3-judge motions panel decide essentially all preliminary motions. In the opinion of the Trial Section, entry of 3-judge decisions is more efficient and establishes the law of the case.

[2] See Notice of the Chief Administrative Patent Judge of Nov. 6, 1998, Interference Practice--New Procedures for Handling Interference Cases at the Board of Patent Appeals and Interferences, 1217 Off. Gaz. Pat. & Tm. Office 18 (Dec. 1, 1998).

What is the difference between review at final hearing of a single-judge interlocutory order versus a 3-judge interlocutory order?

When a single-judge order is reviewed at final hearing by a 3-judge panel, it first must be determined whether the order involves a substantive issue (e.g., patentability) or a procedural issue (e.g., granting discovery). As to procedural issues, the standard of review is abuse of discretion. 37 CFR § 1.655(a). On the other hand, as to a substantive issue, the two additional judges have not previously cast a vote on the issue and need not defer to the substantive decision of the single-judge. In short, the two remaining judges consider the substantive issue de novo and need not defer to the views of the APJ who entered the interlocutory order.

When there is review at final hearing by a 3-judge panel of an interlocutory order entered by a 3-judge panel (which will almost always be the same three judges), the case takes on a different posture. All three judges previously considered the record and cast their votes. Any review at final hearing will be on the same record and new arguments are not authorized. It should be apparent that when a 3-judge panel reviews its previous decision, the 3-judge panel, in effect, is reconsidering its earlier decision. There is no de novo consideration. Hence, it will be necessary for a party asking for review to establish that

the 3-judge panel overlooked or misapprehended something in entering the order sought to be reviewed.

The manifest benefit of a 3-judge decision on preliminary motions is that the count becomes fixed, at least insofar as the board is concerned, before priority testimony is presented. Parties do not have to (1) guess whether the count might be changed at final hearing and (2) present alternative priority cases during the priority testimony phase to meet each possible count which otherwise might be urged at final hearing.

In this case, based on activity in a related interference, it came to the attention of the APJ designated to handle this interference, that Rosenstein planned to, or could, seek review of the 3-judge decision on preliminary motions at final hearing. The parties were advised, however, that the review, in effect, would be a request for reconsideration. The parties were also advised that it would be better to correct any errors at this time, rather than after a case on priority is presented.[3] Since the Trial Section is relatively new, it was believed that the parties might not have fully understood the implications of a 3-judge interlocutory decision on preliminary motions, and in

[3] In this interference, the priority case will be subject to arbitration or priority proof under the rules depending on the outcome of Carter-Wallace, Inc. v. Becton Dickinson and Company, Civil Action 00-1883 (KSH) in the U.S. District Court for the District of New Jersey, where Charlton's assignee is seeking an order to enforce what it believes to be an agreement to arbitrate the priority issues in this (and possibly other) interferences.

particular its law of the case status insofar as the board is concerned. Accordingly, the board sua sponte set a time for filing requests for reconsideration.[4]

For the reasons given, we hold that the Rosenstein request for reconsideration is timely filed.

4.

We have considered Rosenstein's arguments in its request for reconsideration, in light of Charlton's comments in opposition thereto, and we conclude that Rosenstein has not shown that we misapprehended or overlooked any fact or argument which would cause us to change our decision or opinion. We find it unnecessary to reach Charlton's argument that Rosenstein has raised new issues in presenting its request for reconsideration.

C. Order

Upon consideration of the Rosenstein request for reconsideration, and for the reasons given, it is

ORDERED that the Rosenstein request for reconsideration is deemed to be timely filed.

[4] Independent of the rational otherwise set forth in this opinion, we are of the view that it is in the interest of justice to consider Rosenstein's request for reconsideration even if it is considered to be belated. See 37 CFR § 1.645(b).

FURTHER ORDERED that the Rosenstein request for reconsideration is otherwise denied.

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