

A Practitioners View of Ethical Considerations Before the Board in Interferences

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Richard A. Neifeld

Neifeld IP Law, PC - www.Neifeld.com

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I. Introduction

- 1) While practitioners face many of the same ethical issues in interferences and other proceedings, there are also substantial differences.
- 2) This paper primarily identifies potential ethical pitfalls peculiar to interference practice.

II. The Duty of Disclosure in Interferences

- 1) What is the extent to which the duty of disclosure applies in interferences?
- 2) No specific rule; 37 CFR 1.56 relates to applications.
- 3) However, see 37 CFR 10.1, first sentence and 37 CFR 10.18(b)(1) (“whoever ... knowingly and willfully ... conceals, or covers up by any trick, scheme, or device a material fact ... shall be subject to penalties....”)

III. New Frivolous Arguments are Subject to Sanctions

- 1) Leveen v. Edwards, Interference No. 104,290, paper No. 351 (PTOBPAI 2002)(non-precedential) – Impropriety of changing arguments on review
- 2) “However, we choose to use this opinion as notice to practitioners not to change the thrust of arguments previously made when review of an interlocutory order is sought at final hearing. We do this in the interest of providing an "abundance of fairness" to parties who somehow might not have appreciated the impropriety of changing arguments on review.”

III. New Frivolous Arguments are Subject to Sanctions

- 3) The Leveen changing arguments on review opinion was in response to a hearing requested in response to an order to show cause re sanctions.
- 4) Principle – The Board will not tolerate a low ethical standard of conduct including non-compliance with rules and orders.
- 5) Conclusion - Know the rules and policy in interference practice to stay out of trouble.

IV. A Laundry List of Pitfalls

A. Avoid Ex Parte Communications "as to the merits of the cause." See 37 CFR 10.93(b); A.S. v. B.R., Interference No. 104,AAA, paper No. 10 (PTOBPAI December 03, 1998)(precedential)(e-mail without service); and F.M.W v. D.A.T., Interference No. 104, BBB, paper No. 4 (PTOBPAI December 23, 1998)(precedential to the Trial Section of the Board) (e-mail without service).

IV. A Laundry List of Pitfalls

A. – Cont.

Advice - Avoid communicating ex parte with any APJ on any matter arguably touching on the merits of any inter partes proceeding handled by any APJ.

Advice – Educate junior attorneys as to this issue.

IV. A Laundry List of Pitfalls

B. Notify the Office When You Copy Claims. 37

CFR 10.23(c)(7) states that "[k]nowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied" is misconduct. Also 37 CFR 1.604(b) and 607(c). See Bovard v. Respondent, Office of Enrollment and Discipline ("OED") Proceeding D96-01 (1997) (practitioner sanctioned for lack of compliance).

IV. A Laundry List of Pitfalls

C. Comply with 35 USC 135(b). See Housey v. Berman, Docket No. 01-1311 (Fed. Cir. May 29, 2002)(135(b) bar exists based upon claim in any issued patent, not just patent in interference); and In re Berger, 61 USPQ2d 1523, 279 F.3d 975, 2002 U.S. App. LEXIS 1186. (Fed. Cir. 2002) (applying a “material limitation” test).

IV. A Laundry List of Pitfalls

D. Be aware of the bar on former examiners as it relates to an interference in which your firm may become involved. 37 CFR 10.10(b)(2) provides a two year bar on preparation or prosecution of any application in technology in areas in which a former examiner examined. 37 CFR 10.10(b)(1) provides a *temporally unlimited bar* on all matters pending in the former examiner's group while the former examiner was an examiner.

IV. A Laundry List of Pitfalls

E. Avoid Conflicts - Attorneys

See University of New Mexico v. Fordham,
Interference No. 104,761, paper No. 47
(PTOBPAI 2002)(non-precedential)(Pennie &
Edmonds not disqualified; but the panel noting
that “To the extent that P&E may have harmed
UNM in a way unrelated to this interference,
UNM can seek redress through the Office of
Enrollment and Discipline or a relevant State
Bar.”).

IV. A Laundry List of Pitfalls

E. Avoid Conflicts - APJs

Promptly notify ownership interests in the involved applications. The initial and continuing notification duties of 602(b) and (c) are mandatory, and practitioners need to comply with them so that the APJs can avoid conflicts of interest. See Noelle v. Armitage, Interference No. 104,724, paper No. 33 (PTOBPAI April 26, 2002).

IV. A Laundry List of Pitfalls

F. Avoid Being the Attorney and a Witness. 37

CFR 10.63 provides that when "it is obvious that [any practitioner] ... in the practitioner's firm ... [may be asked to sign an affidavit or become a witness other than on behalf of the practitioner's client] ... the practitioner shall withdraw."

IV. A Laundry List of Pitfalls

G. – Miscellaneous

Consider having a court reporter make a transcript of any conference call.

Prepare to manage the paper production, volume of work, and reporting requirements in an interference; keep your client timely informed.

V. Provide Competent Advice and Know What You Need to Know

- A) Practitioners have a duty to act competently. 37 CFR 10.77.
- B) Know the substantive law and procedure relating to interferences, and the facts of your case.
- C) If you advise on possible outcomes, do not be overly optimistic *or* overly pessimistic.

V. Provide Competent Advice and Know What You Need to Know (cont. 1)

- 1) Know whether to advise requesting an interference.
- 2) Know the consequences of case law and rule estoppel.
- 3) Know the anticipated time line for an interference.
- 4) Know the potential for subsequent collateral attack.
- 5) Understand the consequences and duties relating to a settlement or common assignment.
- 6) Know your case's priority proofs ahead of time.

V. Provide Competent Advice and Know What You Need to Know (cont. 2)

- 7) Know the weaknesses of your case.
- 8) Know the consequences of 608(b) showings that do not make a prima facie case.
- 9) Know the legal effect and ethical duties relating to a preliminary statement.
- 10) Know the limitations on raising issues belatedly, and what constitutes an “issue.”
- 11) Recognize post interference rule 56 duties.
- 12) *Join “patentInterference” at www.YahooGroups.com .*

VI. Conclusion

Be familiar with the ethical issues in interferences if you are representing in an interference.

THANK YOU

THE END