

AN INFORMAL DISCUSSION REGARDING BPAI PRACTICE WITH SOME NUGGETS OF USEFUL INFORMATION

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OUTLINE

1. THE LIMITS OF INTERFERENCE
ESTOPPEL
2. CAN YOU SUBMIT NEW 'EVIDENCE'
DURING AN APPEAL TO THE
BPAI? ANSWER: IT DEPENDS!
3. APPEAL STATISTICS PROCEDURAL
'MISERY'
4. IS THE PTO MISINTERPRETING 37 CFR
1.704(C)(7)?
... AND WHY YOU SHOULD CARE

1. THE LIMITS OF INTERFERENCE ESTOPPEL

- WHAT ARE THE CONSEQUENCE OF LOSING AN INTERFERENCE AS TO RELATED PROPERTY RIGHTS?
- MOST PEOPLE UNDERESTIMATE THE IMPACT (THEY CAN BE DEVASTATING)
- LETS LOOK AT A REAL SITUATION

Guthrie v. Espiau – AN INTERFERENCE

The dispute - Derivation and priority

The USPTO proceeding

Guthrie applicant – Espiau patentee

ONE COUNT

Procedure: Motions list, allowed motions, filed motions, decided motions, priority contest and priority motions, final hearing, final decision.

Guthrie's motions list:

- inventorship
- priority
- derivation
- To add one Espiau patent
- etc.

Guthrie withdrew inventorship assertion at the hearing on motions lists

- Guthrie *withdrew* inventorship assertion at the motions list hearing; and was not authorized to file an inventorship motion
- Guthrie lost on motion to add patent
- Guthrie lost on priority (the count)

In the 146 action Guthrie placed at issue 7 more patents.

Count 1: priority of the count

Count 2: Correction of inventorship (naming Guthrie as inventors in Espiau involved patent, Espiau's other patent, and 7 Espiau patents not attacked in the interference)

Count 3: Declaration of correction of inventorship – Same as count 2.

Is Guthrie barred from raising any of those issues?

Is Guthrie barred from action in the USPTO?

Time to look at the law

RELEVANT LAW IN THE PTO

“Consistent with the general principles of res judicata and estoppel announced in Pritchard, sound judicial and administrative policy dictates that an interference should settle all issues which are decided *or which could have been decided*”, Ex parte Tytgat (BPAI)

That is the PTO’s position. Can’t raise such issues in other PTO proceedings.

But in an interference proceeding, one can contest inventorship, move to bring in other patents, and declare spin off interferences. Guthrie did not do that. To the extent that Guthrie had disclosure supporting claims interfering with the other Espiau patents, Tytgat applies in the USPTO.

No subsequent USPTO interferences for Guthrie! No claims allowable to Guthrie if they arguably interfere with any claim in the other 7 Espiau patents!

ASIDE - ISSUE PRECLUSION IN THE COURTS

Adverse decision on validity or enforceability (as to opponent, such that the opponent's claims are found not invalid or not unenforceable) in an interference have preclusive effect in subsequent court action. Coakwell v. United States, 292 F.2d 918, 130 USPQ 231 (Ct. Cl. 1961).

But you have to read between the lines in Coakwell to get to this conclusion.

At least on District Court followed Coakwell:

“Eaton's claims of prior inventorship and invalidity *have been determined adversely to Eaton by the Board of Patent Appeals and Interferences* (Board). 1

Memorandum and Order, filed September 27, 2006. Thus, that portion of the relief sought in the complaint has already been adjudicated. *Id.*” Meritor Transmission Corp. v. Eaton Corp., 2007 U.S. Dist. LEXIS 13166 (W.D.N.C 2007)

146 ISSUES LIMITED TO THOSE FOR WHICH A PARTY “*INSISTED*” *ON A DECISION*

"Short of such compliance with the regulations, issues may only be deemed raised for section 146 purposes if the record clearly demonstrates that the issue was undeniably placed before the examiner-in-chief, and one or more parties *insisted that the issue be resolved in the process of deciding which of the parties was entitled to priority.*" General Instrument Corporation v. Scientific-Atlanta, Inc. (Fed. Cir. 1993)

146 ISSUES LIMITED TO THOSE FOR WHICH A PARTY “INSISTED” ON A DECISION

“In order for an issue to have been raised adequately so that it qualifies for consideration in a § 146 proceeding, the issue should *have been raised as specified in the PTO's interference rules, for example, through preliminary motions, motions to correct inventorship, miscellaneous motions, belated motions delayed for good cause, or opposition to these motions.*” See *General Instrument, 995 F.2d at 214, 27 USPQ2d at 1148.* CONSERVOLITE, INC V. WIDMAYER (Fed, Cir. 1994)

SO WHERE DOES THIS LEAVE
GUTHRIE?

On Espiau's involved patent?

On Espiau's other patent?

On Espiau's 7 new patents?

Guthrie has some BIG problems

MORAL OF THE STORY

ONE NEEDS TO UNDERSTAND THE CONSEQUENCES OF LOSING AN INTERFERENCE.

IN AN INTERFERENCE, THE MOTIONS CONFERENCE IS CRITICAL.

BE PREPARED TO JUSTIFY EACH MOTION REQUESTED THEREIN.

IF YOU THINK A MOTION ISSUE MAY BE CRITICAL, YOU MAY HAVE TO ***INSIST***...

2. CAN YOU SUBMIT NEW
'EVIDENCE' DURING AN APPEAL
TO THE BPAI? ANSWER: IT
DEPENDS!

IT DEPENDS ON HOW YOU
PRESENT IT.

YOU OFTEN NEED NEW
EVIDENCE

The BPAI rules provide different standards for authority as opposed to evidence. Cases are “authority” and can be cited and copied in the appeal. Evidence cannot.

The BPAI rules apply a no new evidence standard. New evidence causes *bad things* to happen to your appeal.

The 90/006,707 reexamination Dictionary definitions attached to the reply brief resulted in the reply brief being excluded from the appeal. They were considered “evidence”.

Petition Decision, Dpty Comm.
Love

The 09/401,939 application

Brief included a quotation of the definition and a cite (to the URL at which the definition could be found)

“The merits panel to which this appeal is assigned for decision is authorized to consider, to the extent it may be relevant” Pet Dec., CAPJ Fleming

CONCLUSIONS

BRIEFS CONTAINING *QUOTE AND CITE* SHOULD BE ACCEPTED
BASED UPON THIS PRECEDENT

SAME EFFECT AS ATTACHED
EVIDENCE

- CITES TO DICTIONARIES
- CITES TO OTHER EVIDENCE

3. APPEAL STATISTICS PROCEDURAL 'MISERY'

BUSINESS METHODS CASES

APPEALS TACTIC, STARTING
CIRCA 2000 (ALWAYS APPEAL)

STATISTICS AS OF SPRING
2008

- IN 15 APPLICATIONS, 17 APPEALS, AND *42 APPEAL BRIEFS* (SUPPLEMENTAL, AND IN RESPONSE TO EXAMINER REOPENING PROSECUTION)
- 7 EXAMINER REQUIREMENTS TO CORRECT BRIEFS, 10 BPAI ADMINISTRATIVE REMANDS, (BLACK HOLE)

- 4 OFFICE ACTION REJECTIONS
AFTER BPAI OR CAFC DECISION
- BASIS FOR EXAMINER TO REQUIRE
CORRECTED BRIEF MORE THAN
NOT ERRONEOUS; IMPOSING
REQUIREMENT NOT IN THE RULES
- APPEALS WITHDRAWN ONLY TO
IMPOSE RESTRICTION
REQUIREMENTS

BPAI REMAND BECAUSE OF

- UNDECIDED PETITIONS, SUCH AS AGAINST THE RESTRICTION REQUIREMENT IMPOSED UPON INITIAL WITHDRAWAL OF THE APPEAL
- UNCONSIDERED IDSs

APPEAL STATISTICS POINT

EVEN UNDER NEW RULES, EXPECT MORE THAN APPEAL BRIEF, EXAMINER ANSWER, AND REPLY BRIEF, WHEN APPEALING

REVIEW FILE FOR ENTRY OF PAPERS BEFORE OR DURING APPEAL AND TRY TO GET THEM ENTERED AND DECIDED.

4. IS THE PTO MISINTERPRETING 37 CFR 1.704(C)(7)?

37 CFR 1.704(c)(7) reduces PTA by the period between "[s]ubmission of a *reply* having an *omission*" and [the date the reply or other paper correcting the omission was filed].

***PTO POSITION* ON 1.704(c)(7)**

**1.704(c)(7) DOES NOT APPLY
TO A DEFECTIVE BRIEF AN
SUBSEQUENT BRIEF
CORRECTING THE DEFECT,
KERY FRIES, USPTO**

PTO POSITION ON 1.704(c)(7)

PTO DOES **NOT** CONSIDER
AN APPEAL BRIEF TO BE A
"***REPLY***" WITHIN THE
MEANING OF 37 CFR
1.704(C)(7). (KERY FRIES,
USPTO)

Why?

“The submission of the appeal brief is not considered a reply to the Office. Rather the submission of an appeal brief is necessary to perfect appeal.”

BUT PTO CURRENT
REASONING THAT: “The
submission of the appeal brief is
not considered a reply to the
Office.” IS **CONTRARY TO PTO
PRIOR *WRITTEN*
INTERPRETATION**

ANTECEDENT FOR 1.704(C)(7) 'S
“*REPLY*” IS 1.704(b) WHICH STATES:

“an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to *any notice or action by the Office making any rejection, objection, argument, or other request,*”

IN THE COMMENTS ON § 1.704(c)(7)
IN PUBLICATION PRMULGATING THIS
RULE:

“The reference to “§ 1.135(c)” is
parenthetical because § 1.704(c)(7) is
not limited to Office actions under §
1.135(c) but *applies when the Office
issues **any** action or notice indicating
that a reply has an omission which must
be corrected....,*” 65 FR 56366

CONCLUSION

- THE PTO IS NOT REDUCING PTA BY THE DELAY CAUSED BY DEFECTIVE APPEAL BRIEFS. BUT ITS DETERMINATION IS NOT CONCLUSIVE...
- THIS IS AN ISSUE THAT WILL BE DECIDED IN SOME FUTURE LITIGATION.

ADVICE RE 1.704(c)(7)

- ***PETITION AGAINST* IMPROPER NOTICES REQUIRING A CORRECTED BRIEF INSTEAD OF CONCEDED – TO POTENTIALLY SAVE PATENT TERM**
- **AND FILE COMPLIANT BRIEFS!**

THE END THANK YOU!

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