

Questions Submitted in Advance of the Patent Inter Partes Proceedings Committee Meeting of the ABA, April 1, 2009, for Response at the Meeting by the Panel of APJs

By Rick Neifeld, Neifeld IP Law, PC¹

Much of Board practice is still not transparent, particularly with respect to inter partes matters. I post the questions below to let practitioner know about the issues I see respecting inter partes Board practice. I will post the answers if they become available.

Q1. (Rick Neifeld). The USPTO web site contains an "Interference Portal" which purports to provide access to papers in public interferences. It states in part "View Public Interference Documents" and provides fields to search by interference number, application number, patent number, inventor last name, and real party in interest. This web site suggests that all public interferences are available from this web portal. However careful inspection of this database indicates it only provides documents from 35 interferences. Presumably there are for more public interferences than that!

When will the Board correct the web site so that it is no longer misleading as to content?

When will the Board have the web portal updated so that it in fact provides access to papers in public interferences?

When will the Board upgrade the web portal so that interferences are available from date of declaration, as is the case for the corresponding TTAB's Oppositions portal?

Have there been any FOIA requests for a list of "public" interferences and/or copies of their contents? If so, what result?

How can a member of the public identify the existence of recently declared interferences by number, party, patent, application, or otherwise, on an ongoing basis?

Q2. (Rick Neifeld). When will the USPTO promulgate a regulation or change guidance with respect to the Priority Statement so that regulation and guidance thereon are consistent? Specifically regarding any requirement to allege derivation therein?

Q3. (Rick Neifeld). The existing scope of interference estoppel is counterproductive to both the BPAI and the interference bar, in that it motivates practitioners to raise and pursue all issues that could be decided in the interference, to preserve those issues for subsequent litigation, which also eats up BPAI resources. Moreover, a decision in at least one recent 146 case further confuses the issue regarding how far an interferent need go to preserve an issue, in view of the practice of the BPAI of requiring a list of proposed motions and deciding which of those motions are allowed. What if anything can the BPAI do via regulation, test case, or otherwise, that will address interference estoppel problem to either clarify how far an interferent must go in the BPAI proceeding so that interference estoppel will not apply in subsequent litigation or set up a case to test that issue in subsequent litigation?

Q4. (Rick Neifeld). At the February 7, 2007 Interference Workshop hosted by the PTC section of the Bar Association of DC, the APJS present (including CAPJ Fleming) generally admitted that the Standard Order limitations on Statements of Material Facts and responses thereto, were a failure, and indicated that those limitations would be revised. (See "Advice From the Interference Bench and my Comments," Neifeld, April 24, 2007, posted on

<http://www.neifeld.com/advidx.html>.) However, the 2006 Standing Order still prevails. When will these limitations be revised?

Q5. (Rick Neifeld). At the February 7, 2007 meeting, APJ Spiegel noted that support charts in interferences were wanting. In response, I suggested, and the APJ's appeared to agree that it would be a good idea for the APJS to review the annotated claims and support charts upon receipt, to see if they met the laugh test, before burdening opposing counsel. Do any APJS now do that?

Q6. (Rick Neifeld). 37 CFR 41.121 defines motions, specifically, as something filed on paper. Will the USPTO revise the rules of practice to define a request to file a motion to in fact be a motion, specifically in view of the fact that such requests must by rule be made via teleconference? 37 CFR 41.123(b)(1)(ii)?

ran

Date/time: January 28, 2009 (1:31pm)

Y:\Library\LAW\FirmPublicationsAndPresentationsAndLectureMaterials\RickNeifeld\articles\Questions Submitted in Advance of the Patent Inter Partes Proceedings Committee Meeting_1-28-2009.wpd

1. I can be reached via telephone at 703-415-0012 or via the firm's web site, www.Neifeld.com.