signed the response. An inmate who is not satisfied with the Regional Director's response may submit an Appeal on the appropriate form (BP–11) to the General Counsel within 30 calendar days of the date the Regional Director signed the response. When the inmate demonstrates a valid reason for delay, these time limits may be extended. Valid reasons for delay include those situations described in § 542.14(b) of this part. Appeal to the General Counsel is the final administrative appeal.

(b) *Form.* (1) Appeals to the Regional Director shall be submitted on the form designed for regional Appeals (BP–10) and accompanied by one complete copy or duplicate original of the institution Request and response. Appeals to the General Counsel shall be submitted on the form designed for Central Office Appeals (BP–11) and accompanied by one complete copy or duplicate original of the institution and regional filings and their responses. Appeals shall state specifically the reason for appeal.

(2) An inmate may not raise in an Appeal issues not raised in the lower level filings. An inmate may not combine Appeals of separate lower level responses (different case numbers) into a single Appeal.

(3) An inmate shall complete the appropriate form with all requested identifying information and shall state the reasons for the Appeal in the space provided on the form. If more space is needed, the inmate may use up to one letter-size (8½"×11") continuation page. The inmate shall provide two additional copies of any continuation page and exhibits with the regional Appeal, and three additional copies with an Appeal to the Central Office (the inmate is also to provide copies of exhibits used at the prior level(s) of appeal). The inmate shall date and sign the Appeal and mail it to the appropriate Regional Director, if a Regional Appeal, or to the National Inmate Appeals Section, Office of General Counsel, if a Central Office Appeal (see 28 CFR part 503 for addresses of the Central Office and Regional Offices).

§ 542.16 Assistance.

(a) An inmate may obtain assistance from another inmate or from institution staff in preparing a Request or an Appeal. An inmate may also obtain assistance from outside sources, such as family members or attorneys. However, no person may submit a Request or Appeal on the inmate's behalf, and obtaining assistance will not be considered a valid reason for exceeding a time limit for submission unless the delay was caused by staff.

(b) Wardens shall ensure that assistance is available for inmates who are illiterate, disabled, or who are not functionally literate in English. Such assistance includes provision of reasonable accommodation in order for an inmate with a disability to prepare and process a Request or an Appeal.

§ 542.17 Resubmission.

(a) *Rejections.* The Coordinator at any level (CCM, institution, region, Central Office) may reject and return to the inmate without response a Request or an Appeal that is written in a manner that is obscene or abusive, or does not meet any other requirement of this part.

(b) *Notice.* When a submission is rejected, the inmate shall be provided a written notice, signed by the Administrative Remedy Coordinator, explaining the reason for rejection. If the defect on which the rejection is based is correctable, the notice shall inform the inmate of a reasonable time extension within which to correct the defect and resubmit the Request or Appeal.

(c) *Appeal of rejections.* When a Request or Appeal is rejected and the inmate is not given an opportunity to correct the defect and resubmit, the inmate may appeal the rejection, including a rejection on the basis of an exception as described in § 542.14(d), to the next appeal level. The Coordinator at that level may affirm the rejection, may direct that the submission be accepted at the lower level (either upon the inmate's resubmission or direct return to that lower level), or may accept the submission for filing. The inmate shall be informed of the decision by delivery of either a receipt or rejection notice.

§ 542.18 Response time.

If accepted, a Request or Appeal is considered filed on the date it is logged into the Administrative Remedy Index as received. Once filed, response shall be made by the Warden or CCM within 20 calendar days; by the Regional Director within 30 calendar days; and by the General Counsel within 40 calendar days. If the Request is determined to be of an emergency nature which threatens the inmate's immediate health or welfare, the Warden shall respond not later than the third calendar day after filing. If the time period for response to a Request or Appeal is insufficient to make an appropriate decision, the time for response may be extended once by 20 days at the institution level, 30 days at the regional level, or 20 days at the Central Office. Staff shall inform the inmate of this extension in writing. Staff shall respond in writing to all filed Requests or Appeals. If the inmate does not receive a response within the time allotted for reply, including extension, the inmate may consider the absence of a response to be a denial at that level.

§ 542.19 Access to indexes and responses.

Inmates and members of the public may request access to Administrative Remedy indexes and responses, for which inmate names and Register Numbers have been removed, as indicated below. Each institution shall make available its index, and the indexes of its regional office and the Central Office. Each regional office shall make available its index, the indexes of all institutions in its region, and the index of the Central Office. The Central Office shall make available its index and the indexes of all institutions and regional offices. Responses may be requested from the location where they are maintained and must be identified by Remedy ID number as indicated on an index. Copies of indexes or responses may be inspected during regular office hours at the locations indicated above, or may be purchased in accordance with the regular fees established for copies furnished under the Freedom of Information Act (FOIA).

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket No. 940968–4268]

RIN 0651–AA71

Patent Appeal and Interference Practice

AGENCY: Patent and Trademark Office, Commerce..

ACTION: Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office proposes to amend the rules of practice in patent cases, part 1 of title 37, Code of Federal Regulations, relating to patent appeal and interference proceedings. The proposed changes include amendments to conform the interference rules to 35 U.S.C. 104 as amended by Public Law 103–182, 107 Stat. 2057 (1993) (North American Free Trade Agreement Implementation Act) and a number of clarifying and housekeeping amendments.

DATES: Written comments must be submitted no later than November 30, 1994. A public hearing will be held on

December 7, 1994. Requests to present oral testimony must be received no later than December 2, 1994.

ADDRESSES: Address written comments to Board of Patent Appeals and Interference, P.O. Box 15647, Arlington, Virginia 22215, marked to the attention of Fred E. McKelvey. Written comments will be available for public inspection in the interference copy room, which is located on the 10th floor of Crystal Gateway 2, 1225 Jefferson Davis Highway, Arlington, Virginia.

FOR FURTHER INFORMATION CONTACT: Fred E. McKelvey by telephone at (703) 603–3320 or by mail marked to the attention of Fred E. McKelvey at P.O. Box 15647, Arlington, Virginia 22215.

SUPPLEMENTARY INFORMATION:

I. Amendments Responsive to Adoption of Public Law 103–182

Several of the proposed amendments to the interference rules (i.e., 37 CFR 1.601 *et seq.*) are responsive to Public Law 103–182, 107 Stat. 2057 (1993) (North American Free Trade Agreement Implementation Act), which amended 35 U.S.C. 104 to permit reliance on activities occurring in a "NAFTA country" to prove a date of invention. Paragraph (b) of § 104 as amended states that "the term 'NAFTA country' has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act." That section of Public Law 103–182 has been codified at 19 U.S.C. 3301(4), which reads:

(4) NAFTA Country

Except as provided in section 3332 of this title, the term "NAFTA country" means—

(A) Canada for such time as the [North American Free Trade] Agreement is in force with respect to, and the United States applies the Agreement to, Canada; and

(B) Mexico for such time as the Agreement is in force with respect to, and the United States applies the Agreement to, Mexico.

Accordingly, it is proposed to amend 37 CFR 1.601 by adding a new paragraph (r) defining the term "NAFTA country" and "non-NAFTA country" and to amend the following interference rules, which set forth the requirements for preliminary statements, so as to permit reliance on activities occurring in a NAFTA country: §§ 1.622(b), 1.623(a), 1.624(a) and 1.628(b)(2).

37 CFR 1.684, which relates to the taking of testimony in a foreign country, is proposed to be deleted and reserved in view of proposed amendments to §§ 1.671 and 1.672. Section 1.671 is proposed to be amended by redesignating paragraph (h) as paragraph (i) and adding new paragraphs (h) and (j). New paragraph (h) would set forth the requirements for a motion § 1.635 to compel testimony or the production of documents or things in a foreign country. New paragraph (j) would provide that the weight to be given testimony taken in a foreign country will be determined on a case-by-case basis. Little, if any, weight would be given to testimony taken in a foreign country unless the party taking the testimony proves by clear and convincing evidence (1) that giving false testimony in an interference proceeding is punishable as perjury under the laws of the foreign country where the testimony is taken and (2) that the punishment in a foreign country for giving such false testimony is similar to the punishment for perjury committed in the United States. The proposed amendments to § 1.672 include amending paragraphs (a) and (b), redesignating current paragraphs (c) through (f) as paragraphs (e) through (h) and adding new provisions identified as paragraphs (c) and (d). Paragraph (a) as proposed to be amended would limit a party's case-in-chief testimony to affidavits, except where testimony is to be compelled under 35 U.S.C. 24 or compelled from a party or in a foreign country. New paragraph (c) would provide that where an opponent objects to the admissibility of any evidence contained in or submitted with an affidavit, the opponent must file and serve objections stating with particularity the nature of the objection, to which the party may respond by filing supplemental affidavits and supplemental official records and printed publications. New paragraph (c) further would provide that any objections to the admissibility of any evidence contained in or submitted with a supplemental affidavit shall be by a motion to suppress under § 1.656(h). New paragraph (d) of § 1.672 would require any cross-examination of affiants to be by deposition within the United States, which is defined in current § 1.601(p) as the United States of America, its territories and possessions. New paragraph (d) of § 1.672 would require that the party whose witness is to be cross-examined notice the deposition under § 1.673(e), obtain a court reporter and provide a translator of the witness will not testify in English. Although not set forth in the proposed rules, any party attending the deposition can bring its own translator or the parties can agree to share the cost of single mutually agreeable translator. Paragraphs (g) and (h) of § 1.671 as proposed to be amended would provide that a party seeking to compel testimony or production of documents or things pursuant to 35 U.S.C. 24 or to compel testimony or production from a party or in a foreign country would have to first file a § 1.635 motion to obtain permission from an administrative patent judge. A motion to compel testimony or the production of documents or things in a foreign country would have to show that the witness has been asked to testify in the United States and has refused to do so or that the individual or entity having possession, custody, and control of the document or thing has refused to produce the document or thing in the United States, even though the moving party has offered to pay the expenses involved in bringing the witness or the document or thing to the United States. When permission has been obtained from the administrative patent judge, the party, after also complying with the current requirements for an oral conference (§ 1.673(g)) and service of documents and a proffer of access to things (§ 1.673(b)), would be required to notice the deposition under § 1.673(a).

Section 1.616 is proposed to be amended by adding a paragraph (c) stating that to the extent that any information under the control of an individual or entity located in a NAFTA country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has been ordered to be produced by an administrative patent judge or the Board (§ 1.671(h)), but is not produced for use in the interference to the same extent as such information could be made available in the United States, the administrative patent judge or the Board shall draw such adverse inferences as may be appropriate under the circumstances, or take such other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the interference, including imposition of appropriate sanctions under § 1.616(a).

Section 1.647, which currently requires a party who relies on a non-English language document to provide an English-language translation and an affidavit attesting to its accuracy, is proposed to be amended to extend these requirements to non-English language documents that a party is required to produce via discovery (see § 1.671(h)).

II. Attorney Fees and Expenses

Section 1.616 is proposed to be amended by redesignating current paragraphs (a) through (e) as paragraphs (a)(1) through (a)(4) and (a)(6) and adding new paragraphs (a)(5) and (b). New paragraph (a)(5) would authorize the award of compensatory (as opposed to punitive) expenses and/or attorney

fees as a sanction for failing to comply with the rules or an order, since there are occasions when such a sanction would be more commensurate in scope with the infraction than the sanctions that are currently authorized. New paragraph (b) would authorize the imposition of a sanction, including a sanction in the form of compensatory expenses and/or attorney fees, against a party for taking or maintaining a frivolous position.

III. Certificates of Prior Consultation

Paragraph (b) of § 1.637 currently requires that a miscellaneous motion under § 1.635 contain a certificate stating that the moving party has conferred with all opponents in a good faith effort to resolve by agreement the issues raised by the motion and indicating whether any other party plans to oppose the motion. It is proposed to amend paragraph (b) to extend the requirement for such a certificate to motions filed under §§ 1.633 and 1.634 and also to require the certificate to indicate that the reasons and facts in support of the motion were discussed with each opponent and, if an opponent has indicated that it will oppose the motion, to identify the issues and/or facts believed to be in dispute. The proposed requirement for consultation should result in a reduction in the number of issues raised by motions under § 1.633 and 1.634 as well as a reduction in the number of motions filed under those rules.

IV. Service of a "Developing Record"

In addition to the amendments to § 1.672 discussed above under the heading "Amendments responsive to adoption of Public Law 103–182," it is proposed to amend §§ 1.672, 1.682, 1.683 and 1.688 to require each party to serve on each opponent a "developing record" that will evolve into the record required to be filed under § 1.653. Specifically, in § 1.672, it is proposed to amend paragraph (b) to provide that a party presenting testimony of a witness by affidavit shall, no later than the time set by the administrative patent judge for serving affidavits, file (which includes serve) the affidavit, whether it is a new affidavit or an affidavit that was previously filed by that party during *ex parte* prosecution of an application or under § 1.608 or 1.639(b).

Sections 1.682, 1.683 and 1.688 are proposed to be amended to parallel the proposed amendments to § 1.672. Specifically, paragraph (a) of § 1.682 as proposed to be amended would provide that a party may introduce into evidence, if otherwise admissible, an official record or printed publication not identified in an affidavit or on the record during an oral deposition of a witness, by filing (which includes serving) a copy of the official record or publication no later than the time set for filing affidavits under § 1.672(b), thereby dispensing with the current requirement to file a notice of intent to rely on the official record or printed publication. In § 1.683, paragraph (a) as proposed to be amended would provide that a party may introduce into evidence, if otherwise admissible, testimony by affidavit or oral deposition from another interference, proceeding, or action involving the same parties by filing (which includes serving) a copy of the affidavit or a copy of the deposition transcript no later than the time set for filing affidavits under § 1.672(b), thereby dispensing with the current requirement for a party to file a motion under § 1.635 for leave to rely on such testimony. Section 1.688 as proposed to be amended would provide that, if otherwise admissible, a party may introduce into evidence an answer to a written request for an admission or an answer to a written interrogatory obtained by discovery under § 1.687 by filing a copy of the request for admission or the written interrogatory and the answer no later than the time set for filing affidavits under § 1.672(b). Thus, all evidence filed under §§ 1.672, 1.682, 1.683 and 1.688 that relates to a party's case-in-chief should be filed together no later than the date set by an administrative patent judge for the party to serve affidavits under § 1.672(b) for its case-in-chief and all evidence under those sections that relates to the party's rebuttal should be filed no later than the date set for the party to serve affidavits under § 1.672(b) for its case-in-rebuttal.

The pages of all affidavits and deposition transcripts would be required to have sequential numbers that would also serve as the record page numbers for the affidavits and transcripts in the party's record when it is filed under § 1.653. Likewise, the exhibits identified in the affidavits and deposition transcripts and any official records and printed publications served under § 1.682(a) would be required to have sequential numbers which would serve as the exhibit numbers when the exhibits are filed with the party's record. Affidavits and § 1.683(a) testimony would have to be accompanied by an index giving the name of each witness and the number of the page where the testimony of each witness begins. The exhibits would have to be accompanied by an index briefly describing the nature of each exhibit and giving the number of the page of affidavit or § 1.683(a) testimony where each exhibit identified in an affidavit or during an oral deposition is first identified and offered into evidence.

An opponent who objects to the admissibility of any evidence filed under §§ 1.672(b), 1.682(b), 1.683(a) and 1.688(a) would have to file objections under §§ 1.672(c), 1.682(c), 1.683(b) and 1.688(b) no later than the date set by the administrative patent judge for filing objections to affidavits under paragraph § 1.672(c). An opponent who fails to challenge the admissibility of the evidence on a ground that could have been raised in a timely objection under §§ 1.672(c), 1.682(c), 1.683(b) or 1.688(b) would not be permitted to move under § 1.656(h) to suppress the evidence on that ground. If an opponent timely files an objection to evidence filed under §§ 1.672(b), 1.682(b), 1.683(a) or 1.688(a), the party may respond by filing supplemental affidavits and, in the case of objections to evidence filed under §§ 1.672(b), 1.682(b) and 1.683(a), may also file supplemental official records and printed publications. No objection to the admissibility of supplemental evidence shall be made, except as provided by § 1.656(h). The page numbers of the supplemental affidavits would be sequentially numbered beginning with the number following the last page number of the testimony served under §§ 1.672(b), 1.683(a) and 1.688(a). Likewise, any additional exhibits identified in the supplemental affidavits and any supplemental official records and printed publications would be given sequential numbers beginning with the number following the last number of the previously identified exhibits. After the time expires for filing objections and supplemental affidavits, or earlier when appropriate, the administrative patent judge would set a time within which any opponent may file a request to cross-examine an affiant on oral deposition.

If any opponent requests cross-examination of an affiant, the party shall notice a deposition at a reasonable location within the United States under § 1.673(e) for the purpose of cross-examination. Any redirect and recross shall take place at the deposition. Within 45 days of the close of the period for taking cross-examination (§ 1.678 is proposed to be amended to change the time for filing certified transcripts from 45 days to 30 days), the party would serve (but not file) a copy of each deposition transcript on each opponent together with copies of any additional documentary exhibits identified by a witness during a deposition. The pages of the transcripts served under this

paragraph and the accompanying exhibits would be sequentially numbered in the manner discussed above. The deposition transcripts would be accompanied by an index of the names of the witnesses, giving the number of the page where cross-examination, redirect and recross of each witness begins, and an index of exhibits of the type specified in § 1.672(b). At this point in time, the opponent will have been served with all of the testimony that will appear in the party's record (with the same page numbers) as well as all of the documentary exhibits that will accompany the record (with the same exhibit numbers).

Since the proposed amendments to § 1.672 would require a party, during its testimony period, to file all affidavits on which it intends to rely at final hearing, it is proposed to delete as unnecessary paragraph (e) of § 1.671, which requires a party to give notice of intent to rely on an affidavit filed by that party during *ex parte* prosecution of an application or an affidavit under § 1.608 or 1.639(b).

V. Withdrawal of Previous Notices

Some of the clarifying and housekeeping amendments proposed in part VI below originally appeared in the same or similar form in two previous notices of proposed rulemaking, which are hereby withdrawn:

(a) RIN: 0651–AA53—"Patent Interference Practice—Notice of Proposed Rulemaking," 57 Fed. Reg. 2698 (Jan. 23, 1992), reprinted in 1135 Off. Gaz. Pat. Office 37 (Feb. 11, 1992); and

(b) RIN:0651–AA66—"Patent Interference Practice—Separate Patentability of Claims," 58 FR 39704 (July 26, 1993), reprinted in 1153 Off. Gaz. Pat. Office 59 (Aug. 17, 1993).

VI. Miscellaneous Amendments

Throughout the rules, the term "examiner-in-chief" has been replaced by "administrative patent judge" to reflect the change in the title of the members of the Board. See Commissioner's Notice of October 13, 1993, published as "New Title for Examiners-in-Chief," 1156 Off. Gaz. Pat. Office 332 (Nov. 9, 1993).

In § 1.11, it is proposed to amend paragraph (e) to allow access to the file on an interference involving a reissue application once the interference has terminated or an award of priority or judgment has been entered as to all counts. Although it was intended that the public have access to any interference that involves a case which is open to the public and § 1.11(b) provides that a reissue application is open to the public, interferences involving reissue applications were inadvertently not included in current § 1.11(e).

In § 1.192, which specifies the contents of the brief of an appellant for final hearing in an *ex parte* appeal, it is proposed to amend paragraph (a) in three respects. The first proposal is to simplify the language used to refer to a brief filed by an applicant who is not represented by a registered practitioner. The second is to delete the requirement that such a brief be in substantial compliance with the requirements of paragraphs (c) (1), (2), (6) and (7), because experience has shown that it is better to evaluate such briefs on a case-by-case basis. The third is to codify the "good cause" standard that is currently used to determine whether the Board will consider any arguments or authorities not included in the brief. It is proposed to make clarifying amendments to paragraphs (c), (c)(5) and (c)(5)(ii), to redesignate current paragraphs (c)(1) through (c)(7) as paragraphs (c)(3) through (c)(9), and to add new paragraphs (c)(1) and (c)(2) that would require an appellant who has filed an appeal to the Board to identify the real party in interest and any related appeals and interferences. The proposed requirement to identify the real party in interest is derived from Federal Circuit Rule 47.4 and Federal Circuit Form 7. For some time, it has been necessary to know the identity of the real party in interest. This information would permit members of the Board to comply with ethics regulations associated with working on matters in which the member has an interest. The proposed requirement to identify related appeals and interferences is derived in part from Federal Circuit Rule 47.5 and, if adopted, would prevent the Board from entering inconsistent decisions in related cases.

Section 1.601 is proposed to be amended in several ways. Paragraph (f) as proposed to be amended would specify that a count should be sufficiently broad as to encompass the broadest corresponding patentable claim of each of the parties without being so broad as to be unpatentable over the prior art and also to indicate that a phantom count is unpatentable to all parties under the written description requirement of the first paragraph of 35 U.S.C. 112. Paragraph (g) as proposed to be amended would broaden the definition of "effective filing date" to mean the actual filing date when the involved application or patent is not entitled to the benefit of the filing date of an earlier application. Specifically, paragraph (g) would provide that the effective filing date of an application is the filing date of an earlier application accorded to the application under 35 U.S.C. 119, 120, 121 or 365, or, if no benefit is accorded, the filing date of the application. The effective filing date of a patent would be defined as the filing date of an earlier application accorded to the patent under 35 U.S.C. 120, 121, or 365(c) or, if no benefit is accorded, the filing date of the application which matured into the patent. The reference to 35 U.S.C. 121 is included to eliminate any doubt that a divisional application may be entitled to an earlier filing date in accordance with 35 U.S.C. 121.

Paragraph (j) is proposed to be amended by changing "which" to "that." Paragraph (l) is proposed to be amended by changing "assignee" to "assignee of record in the Patent and Trademark Office." Paragraph (q) is proposed to be amended by deleting "a panel of" as superfluous.

Section 1.602 is proposed to be clarified by changing "within 20 days of" to "within 20 days after."

Sections 1.603 and 1.606 are proposed to be amended by deleting the third sentence ("Each count shall define a separate patentable invention.") as redundant in view of the identical sentence in § 1.601(f). In addition, it is proposed to clarify §§ 1.603 and 1.606 by amending them to require each application to contain, or be amended to contain, at least one patentable claim which corresponds to each count.

In section 1.604, it is proposed to amend paragraph (a)(1) by changing "his or her" to "its."

In § 1.605, it is proposed to amend paragraph (a) for clarification.

Section 1.606 is also proposed to be amended to note that the claim in the application need not be, and most often will not be, identical to a claim in the patent.

In § 1.607, it is proposed to amend paragraph (a)(4) by changing "his or her" to "its" and to add a new paragraph (a)(6) requiring an applicant seeking an interference with a patent to demonstrate compliance with 35 U.S.C. 135(b) which provides:

> A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Requiring an applicant to show compliance with § 135(b) before an interference is declared will prevent an interference from being declared where the applicant cannot satisfy § 135(b) with respect to any claim alleged to correspond to the proposed count.

In § 1.608, it is proposed to amend paragraphs (a) and (b) in several respects. First, both paragraphs are proposed to be amended to delete the information about effective filing dates, which would appear instead in § 1.601(g) as proposed to be amended. Second, it is proposed to relax the current requirement of paragraph (a) for an affidavit filed by the applicant. Paragraph (a) as proposed to be amended would permit a statement to be filed by the applicant or a practitioner of record. Third, it is proposed to change "sufficient cause" in paragraph (b) and in other interference rules to "good cause" in order to make it clear that only one "cause" standard is intended. Fourth, it is proposed to change "8½ x 11 inches (21.8 by 27.9 cm.)" to "21.8 by 27.9 cm. (8½ x 11 inches)."

In § 1.609, it is proposed to amend paragraphs (b)(2) and (b)(3) to require the examiner's statement (i.e., the form PTO–850, also known as the initial interference memorandum) to explain why each claim designated as corresponding to a count is directed to the same patentable invention as the count and why each claim designated as not corresponding to a count is not directed to the same patentable invention as the count. The proposed amendment, if adopted, would provide the Board and the parties with the benefit of the examiner's reasoning and would provide a better foundation for considering preliminary motions to designate claims as corresponding or as not corresponding to a count.

In § 1.610, it is proposed to amend paragraph (a) by deleting the language "a panel consisting of at least three members of" as superfluous and by deleting the reference to § 1.640(e), which is proposed to be amended to allow a request for reconsideration under § 1.640(c) to be decided by an individual administrative patent judge rather than by the Board. It is further proposed to amend paragraph (b) by deleting "Unless otherwise provided in this section," as unnecessary in light of the proposed amendment to paragraph (a).

Section 1.611 is proposed to be amended by redesignating paragraph (a)(8) as paragraph (a)(9) and adding a new paragraph (a)(8) requiring that a notice of declaration of interference indicate why each claim designated as corresponding to a count is directed to the same patentable invention as the count and why each claim designated as not corresponding to a count is not directed to the same patentable invention as the count. This information should assist the parties in deciding whether to move to have claims designated as corresponding or not corresponding to the count. An administrative patent judge can satisfy this requirement by enclosing a copy of the examiner's statement with the parties' copies of the declaration notice. It is also proposed to capitalize the first word in each of paragraphs (d)(2) and (d)(3).

In § 1.612, it is proposed to amend paragraph (a) to change "opposing party's" to "opponent's" and to add a sentence referring to § 1.11(e) concerning public access to interference files.

In § 1.614, it is proposed to clarify the meaning of paragraph (a) by changing "the Board shall assume jurisdiction" to "the Board acquires jurisdiction."

In § 1.616, in addition to authorizing an award of compensatory attorney fees and expenses in appropriate circumstances, as discussed above, it is proposed to amend current paragraph (b) (which is proposed to be redesignated as paragraph (a)(2)) to permit a party to be sanctioned for failing to comply with the rules or an order by entering an order precluding the party from filing any type of paper. Paragraph (b) currently permits entry of an order precluding the filing of a motion or a preliminary statement.

Section 1.617 is proposed to be amended to authorize a party against whom a § 1.617(a) order to show cause has been issued to respond with an appropriate preliminary motion under § 1.633(c), (f) or (g). A preliminary motion under § 1.633(c) to redefine the interference, under § 1.633(f) for benefit of the filing date of an earlier application or under § 1.633(g) attacking the benefit accorded a patentee may be appropriate where the count set forth in the notice declaring the interference is not the same as the count proposed in the applicant's showing under § 1.608(b). A preliminary motion under § 1.633(f) or (g) may also be appropriate where the count set forth in the notice delcaring the interference is the same as the count proposed in the applicant's showing under § 1.608(b), but the notice either fails to accord the applicant the benefit of the filing date of an earlier application whose benefit was requested in the § 1608(b) showing or accords the parentee the benefit of the filing date of an earlier application whose benefit the § 1.608(b) showing argued should not be accorded the patentee.

In § 1.618, it is proposed to amend paragraph (a) for clarification and to state that a paper that has been returned as unauthorized will not thereafter be considered in the interference. Paragraph (a) currently states that a paper that has been returned as unauthorized will not thereafter be considered by the Patent and Trademark Office.

In § 1.625, it is proposed to simplify paragraph (a) by deleting "the invention was made in the United States or abroad and" as surplusage.

Section 1.626 is proposed to be simplified by changing "earlier application filed in the United States or aboard" to "earlier filed application." The same change is proposed for §§ 1.630, 1.633(f), 1.633(g), 1.637(c)(1)(vi), 1.637(e)(1)(viii), 1.637(e)(2)(vii) and 1.637(h)(4).

In § 1.628, it is proposed to amend paragraph (a) by changing "ends of justice" to "interest of justice" to be consistent with the language used in §§ 1.628(a) and 1.687(c), since a single standard is intended. Paragraph (a) of § 1.628 is also proposed to be amended to apply the "interest of justice" requirement only to corrected preliminary statements that are filed on or after the due date for serving preliminary statements. Where the moving party has not yet seen the opponent's statement, an opponent will not normally be prejudiced by the filing of a corrected statement.

In § 1.629, it is proposed to amend paragraphs (a), (c)(1) and (d) to make them consistent with the proposed amendment of the definition of "effective filing date" in § 1.601(g).

In § 1.631, it is proposed to amend paragraph (a) to delete "by the examiner-in-chief" (second occurrence) as superfluous.

Section 1.632 is proposed to be amended to more precisely state that a notice of intent to argue abandonment, suppression or concealment must be filed "within ten days after," rather than "within ten days of," the close of the testimony-in-chief of the opponent.

In § 1.633, it is proposed to amend paragraph (a) to specify that a claim shall be construed in light of the specification of the application or patent in which it appears. This amendment would administratively set aside the judicially created rule of *In re Spina*, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992), to the extent it held that the interference rules require that an ambiguous claim copied from a patent for interference purposes be construed in light of the disclosure of the patent. A claim that has been added to a pending application for any purpose, including to provoke an interference, would be given the broadest reasonable interpretation consistent with the disclosure of the application to which it is added, as are claims which are added during *ex parte*

would be reviewed based on the contents of the paper and the response. If the paper fails to show good cause, the Board would enter judgment against the party against whom the order issued.

Section 1.641 currently indicates that an administrative patent judge who, during the pendency of an interference, becomes aware of a reason why a claim designated to correspond to a count may not be patentable should notify the parties of the reason and set a time within which each party may present its views, which the administrative patent judge will consider in determining how the interference shall proceed. It is proposed to amend § 1.641 to indicate that a party's views may include argument or appropriate preliminary motions under § 1.633(c), (d) and (h), including any supporting evidence.

In § 1.643, it is proposed to amend paragraph (b) for clarification and also to change "ends of justice" to "interest of justice" to be consistent with the language used in other interference rules, including §§ 1.628(a) and 1.687(c).

In § 1.644, it is proposed to simplify paragraph (a) by changing "a panel consisting of more than one examiner-in-chief" to "the Board." Paragraphs (a)(1), (b) and (c) are proposed to be amended by changing both occurrences of "panel" to "Board." Paragraphs (a)(2) and (b) are proposed to be changed to provide that a petition seeking to invoke the supervisory authority of the Commissioner shall not be filed prior to the party's brief for final hearing; these paragraphs currently provide that such a petition shall not be filed prior to a decision of the Board awarding judgment.

Paragraph (b) of § 1.644 is proposed to be clarified by amending it to state that a petition under § 1.644(a) shall be considered timely if it is made as part of, or simultaneously with, a proper motion under § 1.633, 1.634, or 1.635 when granting the motion would require waiver of a rule. In other words, a petition under § 1.644(a)(2) must seek waiver of a rule prospectively rather than retroactively.

Paragragh (d) of § 1.644 is proposed to be amended to provide that the statement of facts in a petition preferably should be in numbered paragraphs and also to delete the second sentence as unnecessary. Paragraph (f) is proposed to be amended to change the "15 days" in which to request reconsideration of a decision by the Commissioner to "14 days." In paragraph (g), it is proposed to delete the quotation marks around "Express Mail."

Section 1.645, which in its current form permits consideration of a belatedly filed paper only if accompanied by a motion under § 1.635 which shows sufficient cause (§ 1.645(b)) why the paper was not timely filed, is proposed to be amended in several respects. First, it is proposed to change "sufficient cause" to "good cause" in order to use a single "cause" standard throughout the interference rules. Second, it is proposed to amend paragraph (b) to permit consideration of a belatedly filed paper if an administrative patent judge or the Board, sua sponte, is of the opinion that it would be in the interest of justice to consider the paper. An example would be where the delay is short (e.g., one day) and there is no prejudice to an opponent. For purposes of the sections other than § 1.645, a belatedly filed paper is considered "timely filed" if accompanied by a motion under § 1.635 which is granted.

Paragraph (d) of § 1.645 is proposed to be amended by deleting "In an appropriate circumstance" as superfluous in view of the language "may stay proceedings," which indicates that the administrative patent judge has the discretion to stay an interference.

In § 1.646, it is proposed to amend paragraph (a)(2) by deleting the reference to § 1.684, which is proposed to be deleted. It is proposed to amend paragraph (c)(1) by inserting "or causing a copy of the paper to be handed" after "By handing a copy of the paper" to make it clear that the paper need not be personally delivered by the party, i.e., that delivery by hand can be effected by a commercial courier, for example. In paragraph (c)(4), it is proposed to change "mail" (second occurrence) to "first class mail" to make it clear that the service date specified in that paragraph applies only to first class mail. It is also proposed to redesignate paragraph (c)(5) as paragraph (c)(6) and to add a new paragraph (c)(5) which clarifies that a party may serve by Express Mail and that when service is effected by Express Mail, the date of service is considered to be the date of deposit with the U.S. Postal Service. Paragraph (d) is proposed to be amended to delete the quotation marks around "Express Mail." Paragraph (e) is proposed to be amended to state that the due date for serving a paper is the same as the due date for filing the paper in the Patent and Trademark Office.

In § 1.651, it is proposed to amend paragraph (a)(2) by deleting "(testimony includes testimony to be taken abroad under § 1.684)" in order to be consistent with the proposal to delete § 1.684. Paragraphs (c)(2) and (c)(3) are proposed to be amended to be consistent with the proposed amendment to the definition of "effective filing date" in § 1.601(g). In paragraph (d), it is proposed to change "abroad under § 1.684" to "in a foreign country."

In § 1.653, it is proposed to amend paragraph (a) in several ways. The first is to change the references to paragraphs of § 1.672 to be consistent with the proposed redesignation of certain paragraphs of § 1.672, discussed below. The second is to delete "of fact" in the clause "agreed statements of fact under § 1.672(f)" (proposed to be redesignated as § 1.672(h)), because agreed statements under § 1.672(f) can set forth either (1) how a particular witness would testify if called or (2) the facts in the case of one or more of the parties. The third is to delete "under § 1.684(c)," since § 1.684 is proposed to be deleted. A fourth proposed amendment to § 1.653(a) is to indicate that in addition to the types of testimony already set forth in paragraph (a), testimony includes copies of written interrogatories and answers and written requests for admissions and answers, which might be obtained where a motion for additional discovery under § 1.687(c) is granted.

Paragraph (b) of § 1.653 is proposed to be amended to be consistent with the proposed redesignation of certain paragraphs of § 1.672, to delete the reference to § 1.684(c), which is proposed to be cancelled, and for clarity. Paragraphs (c)(1) and (c)(4) of § 1.653 are proposed to be amended to make it clear that the only testimony to be included in a party's record is testimony submitted on behalf of the party. Having copies of the same testimony appear in both parties' records unnecessarily encumbers the records and is confusing in that a given page of testimony will have different page numbers in the different records, with the result that the briefs of the parties will refer to different record pages for the same testimony.

It is proposed that paragraph (c)(5) of § 1.653 be deleted and reserved. Paragraph (c)(5) currently requires that the record filed by each party include each notice, official record and printed publication relied upon by the party and filed under § 1.682(a). This requirement is considered unnecessary because such notices, official records and printed publications are in the nature of exhibits under § 1.653(i), which are submitted with but not included in the record. The inclusion of exhibits in the record merely increases the size of the record without serving any useful purpose.

Paragraph (g) of § 1.653 is proposed to be amended and paragraphs (f) and (h) deleted and reserved to eliminate the current distinction between typewritten and printed records. Paragraph (g) is also proposed to be amended to change "8½ x 11 inches (21.8 by 27.9 cm.)" to "21.8 by 27.9 cm. (8½ x 11 inches)" and to delete the requirement for justified margins and to require that the records be bound with covers at their left edges in such manner as to lie flat when open to any page and in one or more volumes of convenient size (approximately 100 pages per volume is suggested) and that when there is more than one volume, the numbers of the pages contained in each volume must appear at the top of the cover for each volume. Paragraph (i) is proposed to be amended to state that exhibits include documents and things identified in affidavits or on the record during the taking of oral depositions as well as official records and publications submitted pursuant to § 1.682(a).

In § 1.654, it is proposed to amend paragraph (a) by changing "shall" in the second sentence to "may" for clarity and also to reduce the time for oral argument by a party from 60 minutes to 30 minutes, because most hearings have required no more than 30 minutes per side and a panel has the discretion to grant more time at the hearing, where necessary.

In § 1.655, it is proposed to amend paragraph (a) by changing the standard of review from "erroneous or an abuse of discretion" to "an abuse of discretion." The recitation of a separate "error" standard is unnecessary, because an abuse of discretion may be found when (1) the decision of an administrative patent judge is clearly unreasonable, arbitrary or fanciful, (2) the decision is based on an erroneous conclusion of law, (3) the findings of the administrative patent judge are clearly erroneous, or (4) the record contains no evidence upon which the administrative patent judge rationally could have based the decision. See, *e.g.*, Heat and Control Inc. v. Hester Industries, Inc., 785 F.2d 1017, 228 USPQ 926 (Fed. Cir. 1986); Western Electric Co. v. Piezo Technology, Inc. v. Quigg, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988).

It is proposed to amend paragraph (b) of § 1.655 to clarify which matters a party is not entitled to raise for consideration at final hearing. As proposed to be amended, paragraph (b) would provide that a party shall not be entitled to raise for consideration at final hearing a matter which properly could have been raised by a motion under § 1.633 or 1.634 unless (1) the matter was properly raised in a motion that was timely filed by the party under § 1.633 or 1.634 and the motion was denied or deferred to final hearing, (2) the matter was properly raised by the party in a timely filed opposition to a motion under § 1.633 or 1.634 and the motion was granted over the opposition or deferred to final hearing, or (3) the party shows good cause why the issue was not properly raised by a timely filed motion or opposition. It is also proposed to amend paragraph (b) of § 1.655 to state that a change of attorneys during the interference generally does not constitute good cause for failing to file a timely motion or opposition.

It is further proposed, in response to *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), to amend paragraph (b) of § 1.655 by adding a sentence explaining that a party who fails to contest, by way of a timely filed preliminary motion under § 1.633(c), the designation of a claim as corresponding to a count may not subsequently argue the separate patentability or the lack of separate patentability of claims designated as corresponding to the count. The Patent and Trademark Office conducts interference proceedings to determine who, as between two or more applicants for patent or one or more applicants for patent and one or more patentees, is the first inventor of a patentable invention. A primary examiner determines in the first instance whether the claims in a pending application interfere with the claims in another pending application or unexpired patent. When the examiner is of the view that an interference exists, the Board is notified (§ 1.609). The interference is assigned to an administrative patent judge (§ 1.610), who issues a notice declaring the interference (§ 1.611). Each separately patentable invention involved in the interference is defined by a count, which is merely a vehicle for contesting priority of invention (i.e, who made the invention defined by the count first) and determining the evidence relevant to the issue of priority. A preliminary determination is made by the Patent and Trademark Office as to which claims should be designated to correspond to the count. The claims that are initially determined to define the same patentable invention are designated as corresponding to the count. All other claims are designated as not corresponding to the count. The designation of claims provides a starting point in an interference. There is a presumption that the designation of a claim as corresponding or as not corresponding to a count is correct.

The interference rules authorize a party to file a preliminary motion to redefine an interference by designating a claim as corresponding (§ 1.633(c)(3)) or not corresponding (§ 1.633(c)(4)) to a count. Prior to Van Geuns, the Patent and Trademark Office interpreted the interference rules as requiring a party to file a preliminary motion under § 1.633(c)(4) to designate a claim as not corresponding to the count as a condition for arguing at final hearing that a claim designated as corresponding to the count is patentably distinct from another claim designated as corresponding to the count. *See* Brooks v. Street, 16 USPQ2d 1374, 1377 (Bd. Pat. App. & Int. 1990); Flehmig v. Geisa, 13 USPQ2d 1052, 1054 (Bd. Pat. App. & Int. 1989); Kwon v. Perkins, 6 USPQ2d 1747, 1750 (Bd. Pat. App. & Int. 1988), aff'd on other grounds, 885 F.2d 325, 12 USPQ2d 1308 (Fed. Cir. 1989); see also Lamont v. Berguer, 7 USPQ2d 1580, 1582 (Bd. Pat. App. & Int. 1988). However, in Van Geuns the Federal Circuit interpreted the rules differently, stating:

> [T]he position of the Commissioner that claims designated as corresponding to a count stand or fall with the patentability of the subject matter of the count is overboard.

988 F.2d at 1185, 26 USPQ2d at 1060. The Court further stated:

> [W]e conclude that a party to an interference, who has failed to timely contest the designation of claims as corresponding to a count, has not conceded that claims corresponding to a count are anticipated or made obvious [i.e., are unpatentable] by the prior art when the subject matter of account is determined to be unpatentable for obviousness. The PTO must determine, based on the actual prior art reference or references, whether claims not [designated as] corresponding exactly to the count are unpatentable.
>
> * * * The interference rules do not specify whether a party may argue the patentability of claims separately to the EIC [examiner-in-chief, now administrative patent judge] and the board.

Id. at 1186, 26 USPQ2d at 1060 (bracketed material added by the Commissioner). The proposed amendment to § 655(b) is designed to overcome the Federal Circuit's interpretation of the rules and to create a presumption that all claims designated as corresponding to a count are directed to the same patentable invention.

It is proposed to amend paragraph (c) of § 1.655 by changing "To prevent manifest injustice" to "In the interest of justice" to be consistent with the language used in other interference rules.

In § 1.656, it is proposed to redesignate paragraphs (b)(1) through (b)(6) as paragraphs (b)(3) through (b)(8), respectively, and to add new paragraphs (b)(1) and (b)(2) requiring the brief to

include (1) a statement of interest identifying every party represented by the attorney in the interference and the real party in interest if the party named in the caption is not the real party in interest and (2) a statement or related cases indicating whether the interference was previously before the Board for final hearing and identifying any related appeal or interference which is pending before, or which has been decided by, the Board, or which is pending before, or which has been decided by, the Court of Appeals for the Federal Circuit or a district court in a proceeding under 35 U.S.C. 146. A related appeal or interference is one which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending interference. Appeals are mentioned because related issues may be present before the board simultaneously in an ex parte appeal and an interference. It is also proposed to amend current paragraph (b)(3) (proposed to be redesignated as paragraph (b)(5)) to specify that statements of fact preferably should be presented in numbered paragraphs.

Current paragraph (b)(4) of § 1.656 (proposed to be redesignated as paragraph (b)(6)) requires that the opening brief of the junior party contain the contentions of the party with respect to the "issues to be decided," which has been construed to include the matter of whether some of the senior party's evidence of conception was inadmissible hearsay. Suh v. Hoefle, 23 USPQ2d 1321, 1323 (Bd. Pat. App. & Int. 1991). As support, the Board relied on Fisher v. Bouzard, 3 USPQ2d 1677 (Bd. Pat. App. & Int. 1987), and Moller v. Harding, 214 USPQ 730 (Bd. Pat. Int. 1982). Both of these cases concern interferences declared under the "old" interference rules (i.e., § 1.201 *et seq.*) of which § 1.254 specified that the opening brief of the junior party shall "present a full, fair statement of the questions involved, including his position with respect to the priority evidence on behalf of other parties." Current § 1.656(b)(4) does not expressly require, and was not intended to imply, that the opening brief of the junior party must address the evidence of any other party with respect to the issue of priority or any other issue. In order to clarify that the opening brief of a junior party need not address the evidence of the other parties, it is proposed to amend current paragraph (b)(4) to require that the junior party's opening brief contain the contentions of the party "with respect to the issues it is raising for consideration at final hearing." These issues would include the junior party's case-in-chief for priority with respect to an opponent or derivation by an opponent as well as matters raised in any denied or deferred motions of the junior party that are to be reviewed or considered at final hearing. Where the reply brief of the union party includes a new argument in response the case-in-chief of the senior party as presented in the senior party's opening brief, the senior party may move under § 1.635 for leave to file a reply to the junior party's reply brief, which motion must be accompanied by a copy of the senior party's reply.

Paragraph (d) of § 1.656 is proposed to be amended to state that unless ordered otherwise by an administrative patent judge, briefs shall be double-spaced (except for footnotes, which may be single-spaced) and shall comply with the requirements of § 1.653(g) for records except the requirement for binding. As a result, the current distinction between printed and typewritten briefs would be eliminated.

Paragraphs (e), (g) and (h) of § 1.656 are proposed to be amended to require an original and *four* copies (currently an original and three copies are required) of each brief, any proposed findings of fact and conclusions of law, any motion under 37 CFR 1.635 to suppress evidence and any opposition to a motion to suppress evidence.

Paragraph (g) of § 1.656, which permits a party to file proposed findings of fact and conclusions of law, is further proposed to be amended to require paragraph numbers for the findings of fact and conclusions of law.

Paragraph (h) is further proposed to be amended to state that a party's failure to challenge the admissibility of the evidence of an opponent on a ground that could have been raised in a timely objection under §§ 1.672(c), 1.682(c), 1.683(b) or 1.688(b) constitutes a waiver of the right to move under § 1.656(h) to suppress the evidence on that ground at final hearing.

Paragraph (i) of § 1.656 currently provides that if a junior party fails to file an opening brief for final hearing, an order may be issued by the administrative patent judge requiring the junior party to show cause why the failure to file a brief should not be treated as a concession of priority and further provides that judgment may be rendered against the junior party if the junior party "fails to respond" within a time period set in the order. The expression "fails to respond" has been misinterpreted by some junior parties as meaning that the mere filing of a response of any kind to the order to show cause should be sufficient to avoid the entry of judgment. Such an interpretation was not intended and if adopted would effectively negate § 1.656(i). The term "respond" is proposed to be changed to "show good cause" in order to make it clear that a junior party's failure to file a timely opening brief will not be excused unless good cause is shown to explain or justify the failure to file a brief. The language of the rule will then be consistent with the other interference rules concerning orders to show cause, e.g., §§ 1.640(c) and 1.652.

Section 1.657 is proposed to be amended to be consistent with the proposed changes to the definition of "effective filing date" in § 1.601(g) to state that in an interference involving an application and a patent where the effective filing date of the application is after the date the patent issued, a junior party has the burden of establishing priority by clear and convincing evidence, and that in other interferences the junior party has the burden of establishing priority by a preponderance of the evidence. The proposed amendment would codify the holding of Price v. Symsek, 988 F.2d 1187, 19990–91, 26 USPQ2d 1031, 1033 (Fed. Cir. 1993), as clarified by Bosies v. Benedict, 27 F.3d 539, 541–42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994).

In § 1.658, it is proposed to amend paragraph (a) to state that when the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision for the purpose of judicial review (35 U.S.C. 141–144, 146) unless a request for reconsideration under paragraph (b) of this section is timely filed. In paragraph (b), third sentence, it is proposed to delete the phrases "[w]here reasonably possible" and "such that delivery is accomplished" as unnecessary and to add a sentence specifying that a decision on reconsideration is a final decision for the purpose of judicial review (35 U.S.C. 141–144, 146). It is also proposed to amend paragraph (b) by changing "reply to a request for reconsideration" to be consistent with the terminology employed in § 1.640(c) regarding requests for reconsideration of decisions on preliminary motions.

Section 1.660 is proposed to be amended by adding a new paragraph (e) explaining that the failure of a party to comply with the notice provisions of § 1.660 may result in sanctions under § 1.616, that knowledge by, or notice to, an employee of the Office other than an employee of the Board, of the existence of the reexamination, application for reissue, protest, or litigation shall not be sufficient, and that the notice contemplated by this section is notice addressed specifically to an

administrative patent judge or the Board.

In § 1.662, it is proposed to amend paragraph (a) by changing "filing by an applicant or patentee" in the second sentence to "filing by a party" to make it clear that the terminal disclaimer can be signed by the party's attorney or agent of record. For the same reason, it is proposed to change "by an applicant" to "by a party" in the third sentence of paragraph (a), which concerns abandonment of an involved application.

In paragraph (b) of § 1.662, the first sentence is proposed to be amended to change "omits all claims of the patent corresponding to the counts of the interference for the purpose of avoiding the interference" to "does not include a claim that corresponds to a count" in order to make it clear that judgment may not be entered where the reissue application includes a new or amended claim that should be designated as corresponding to a count, even if the patentee argues that it should be designated as not corresponding to a count. Similarly, it is proposed to change "reissue other than for the purpose of avoiding the interference" to "reissue which includes a claim that corresponds to a count."

In § 1.671, it is proposed to amend paragraph (a) by changing "*evidence* from another interference, proceeding, or action filed § 1.683" to "*testimony* from another interference, proceeding, or action filed under § 1.683" in order to be consistent with the terminology of § 1.683. It is proposed to amend paragraphs (c)(6) and (c)(7) of § 1.671 to change "by oral deposition or affidavit" to "by affidavit or oral deposition." Paragraph (f) is proposed to be amended to clarify that the requirement for the significance of documentary and other exhibits to be discussed with particularity by a witness applies only to documentary and other exhibits identified by a witness in an affidavit or during oral deposition. Paragraph (f) does not apply to official records and printed publications submitted into evidence pursuant to § 1.682(a).

In § 1.672, in addition to the proposed amendments discussed above under the heading "Amendments responsive to adoption of Public Law 103–182," it is proposed to amend paragraph (b) by deleting the third sentence, which specifies the type of paper to be used for affidavits, as being superfluous in view of § 1.677(a). In paragraph (d), it is proposed to delete the fifth sentence ("A party electing to present testimony of a witness by deposition shall notice a deposition of the witness under § 1.673(a).") as superfluous in view of the second sentence of § 1.672(d).

In § 1.673, it is proposed to amend paragraph (b) by changing the time for service of evidence to be relied on at an oral deposition from "at least three days" prior to the conference required by § 1.673(g) when service is by hand or by Express Mail to "at least three working days" prior to the conference. It is also proposed to amend paragraph (b) to change the time for service by any other means from 10 days to 14 days prior to the conference.

It is proposed to amend paragraph (d) of § 1.673 by deleting the second sentence as unnecessary, since all depositions for a case-in-chief would have to be approved by an administrative patent judge. It is also proposed to delete the quotation marks around "Express Mail" in paragraph (b).

Also in § 1.673, it is proposed to clarify paragraph (e) by changing "party electing to present testimony by affidavit" to "party who has presented testimony by affidavit."

In paragraph (a) of § 1.674, which specifies before whom depositions may be taken, it is proposed to delete the reference to "United States or a territory or insular possession of the United States" in order to make this paragraph applicable to depositions for testimony compelled in foreign countries.

In § 1.675, it is proposed to amend paragraph (d), which concerns reading and signing of a transcript by the witness, to take into account that the witness might refuse to read and/or sign the transcript of the deposition, in which case the circumstances under which the witness refused to sign must be noted on the certificate by the officer who prepared the certified transcript (§ 1.676(c)).

In § 1.676, it is proposed to amend paragraph (a)(4) by changing "opposing party" to "opponent."

Section 1.677, which in its current form specifies the required form for transcripts of depositions, is proposed to be amended to also apply to affidavits. Furthermore, it is proposed to delete the reference to "typewritten" matter, to change "pica-type" to "11 point type" and to change "8½ × 11 inches (21.8 by 27.9 cm.)" to "21.8 by 27.9 cm. (8½ × 11 inches)."

In § 1.678, it is proposed to change the section heading from "Transcript of deposition must be filed" to "Time for filing transcript of deposition" for clarity and to amend the text by changing the time for filing the certified transcript from 45 days to 30 days.

In § 1.679, it is proposed to change "transcript" to "transcript of a deposition" for clarity and also to delete "for printing (§ 1.653(g))" as unnecessary.

In § 1.682, in addition to the proposed amendments discussed above under the heading "service of a 'developing record,'" it is proposed to amend paragraph (a) by changing "identified during the taking of testimony of a witness" to "identified in an affidavit or on the record during an oral deposition of a witness" for clarity. It is also proposed to delete and reserve paragraph (a)(4) ("where appropriate, be accompanied by a certified copy of the official record or a copy of the printed publication (§ 1.671(d))") as superfluous in view of Rules 901 and 902 of the Federal Rules of Evidence, which apply to interference proceedings (§ 1.671(b)) and require authentication of evidence that is not self-authenticating. Finally, it is proposed to capitalize the first word in each of paragraphs (a)(2), (a)(3) and (a)(4).

In § 1.685, it is proposed to amend paragraph (d) for clarification.

In § 1.687, it is proposed to amend paragraph (c) to refer to § 1.647 concerning translations of documents in a foreign language.

Other Considerations

These proposed rules conform with the requirements of the Regulatory Flexibility Act, 5 U.S.C. 601 *et seq.*, Executive Order 12866, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* The Office of Management and Budget has determined that these proposed rules are not significant for the purposes of Executive Order 12866.

The Assistant Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that the proposed rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)), because the changes clarify existing rules setting forth the procedures used in patent appeals and interferences.

The Patent and Trademark Office has determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

These rule changes will not impose any additional burden under the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et.seq.*, since no record keeping or reporting requirements within the coverage of the Act are placed upon the public.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Inventions and patents.

For the reasons set out in the preamble, it is proposed to amend 37 CFR Part 1 wherein removals are indicated by brackets ([ ]) and additions by arrows (►◄) as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 would continue to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Section 1.11 is proposed to be amended by revising paragraph (e) to read as follows:

§ 1.11 Files open to the public.

* * * * *

(e) The file of any interference involving a patent, a statutory invention registration, ►a reissue application, ◄ or an application on which a patent has been issued or which has been published as a statutory invention registration, is open to inspection by the public, and copies may be obtained upon paying the fee therefor, if: (1) The interference has terminated, or (2) an award of priority or judgment has been entered as to all parties and all counts.

3. In § 1.192, it is proposed to revise paragraphs (a), (c), (c)(5) and (c)(5)(ii), redesignate current paragraphs (c)(1) through (c)(7) as paragraphs (c)(3) through (c)(9) and add new paragraphs (c)(1) and (c)(2) to read as follows:

§ 1.192 Appellant's brief.

(a) [The appellant] ►Appellant◄ shall, within 2 months from the date of the notice of appeal under § 1.191 [in an application, reissue application, or patent under reexamination,] or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in § 1.17(f) and must set forth the authorities and arguments on which [the] appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief ►will◄ [may] be refused consideration by the Board of Patent Appeals and Interferences ►, unless good cause is shown◄.

* * * * *

(c) The brief shall contain the following items under appropriate headings and in the order [here] indicated ►below◄ unless ►the brief is filed by an applicant who is not represented by a registered practitioner◄ [there is no attorney or agent of record in the application or reexamination proceeding, the brief was not prepared by a registered practitioner, and the brief was not signed by a registered practitioner, wherein the brief will be accepted as complying with this paragraph provided it is at least in substantial compliance with the requirements of paragraphs (c)(1), (2), (6) and (7)]:

►(1) *Real Party in Interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest, and the parent companies, subsidiaries (except wholly owned subsidiaries) and affiliates that have issued shares to the public of the real party in interest.

(2) *Related Appeals and Interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.◄

[(1)] ►(3)◄ *Status of Claims.* A statment of the status of all the claims, pending or cancelled, and identifying the claims appealed.

[(2)] ►(4)◄ *Status of Amendments.* A statment of the status of any amendment filed subsequent to final rejection.

[(3)] ►(5)◄ *Summary of Invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

[(4)] ►(6)◄ *Issues.* A concise statement of the issues presented for review.

[(5)] ►(7)◄ *Grouping of Claims.* For each ground of rejection which appellant contests and which applies to more than one claim, [it will be presumed that] the rejected claims ►shall◄ stand or fall together ►with the broadest claim, and only the broadest claim will be considered by the Board of Patent Appeals and Interferences◄ unless:

►(i)◄ a statement is included that the rejected claims do not stand or fall together, and

►(ii)◄ in [the appropriate part or parts of] the argument under subparagraph ►(c) (8)◄ [(c) (6)] of this section appellant presents reasons as to why appellant considers the rejected claims to be separately patentable ►from the broadest claim. Merely pointing out what a claim covers is not an argument as to why the claim is separately patentable from the broadest claim◄.

[(6)] ►(8)◄ *Argument.* The contentions of [the] appellant with respect to each of the issues presented for review in subparagraph ►(c) (6)◄ [(c) (4)] of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

* * * * *

(v) For any rejection other than those referred to in paragraphs ►(c) (8) (i)◄ [(6) (6) (i)] to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

[(7)] ►(9)◄ *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, [the] appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If [the] appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons from non-compliance stated in the notification, the appeal will ►stand◄ [be] dismissed.

4. Section 1.601 is proposed to be amended by revising paragraphs (f), (g), (j), (k), (l), and (q) and adding a new paragraph (r) to read as follows:

§ 1.601 Scope of rules, definitions.

* * * * *

(f) A *count* defines the interfering subject matter between (1) two or more applications or (2) one or more applications and one or more patents. ►A count should be broad enough to encompass the broadest corresponding patentable claim of each of the parties. A count may not be so broad as to be unpatentable over the prior art.◄ When there is more than one count, each count shall define a separate patentable invention. Any claim of an application or patent [which] ►that is designated to◄ correspond[s] to a count is a claim involved in the interference within the meaning of 35 U.S.C. 135(a). A claim of a patent or application ►designated to correspond to a count that◄ [which] is identical to a count is said to "correspond exactly" to the count. A claim of a patent or application ►designated to correspond to a count that◄ [which] is not identical to a count [, but which defines the same patentable invention as the count,] is

said to "correspond substantially" to the count. When a count is broader in scope than all claims which correspond to the count, the count is a "phantom count." A phantom count is [not patentable to any party] ►unpatentable to all parties under the written description requirement of the first paragraph of 35 U.S.C. 112◄.

(g) The *effective filing date* of an application [or a patent] is the filing date of an earlier application accorded to the application [or patent] under 35 U.S.C. 119, 120, ►121,◄ or 365 ►or, if no benefit is accorded, the filing date of the application. The *effective filing date* of a patent is the filing date of an earlier application accorded to the patent under 35 U.S.C. 120, 121, or 365(c) or, if no benefit is accorded, the filing date of the application which issued as the patent.◄

* * * * *

(j) An *interference-in-fact* exists when at least one claim of a party [which] ►that◄ corresponds to a count and at least one claim of an opponent [which] ►that◄ corresponds to the count define the same patentable invention.

(k) A *lead* attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an interference on behalf of a party and is the attorney or agent whom an ►administrative patent judge◄ [examiner-in-chief] may contact to set times and take other action in the interference.

(l) A *party* is (1) an applicant or patentee involved in the interference or (2) a legal representative or an assignee ►of record in the Patent and Trademark Office◄ of an applicant or patentee involved in an interference. Where acts of a party are normally performed by an attorney or agent, "party" may be construed to mean the attorney or agent. An "inventor" is the individual named as inventor in an application involved in an interference or the individual named as inventor in a patent involved in an interference.

* * * * *

(q) A *final decision* is a decision awarding judgment as to all counts. An *interlocutory order* is any other action taken by an ►administrative patent judge◄ [examiner-in-chief] or [a panel of] the Board in an interference, including the notice declaring an interference.

►(r) *NAFTA country* means NAFTA country as defined in section 2(4) of the North American Free Trade Agreement Implementation Act. A "non-NAFTA country" is a country other than the United States or a NAFTA country.◄

5. Section 1.602 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.602 Interest in applications and patents involved in an interference.

* * * * *

(c) If a change of any right, title, and interest in any application or patent involved or relied upon in the interference occurs after notice is given declaring the interference and before the time expires for seeking judicial review of a final decision of the Board, the parties shall notify the Board of the change within 20 days ►after◄ [of] the change.

6. Section 1.603 is proposed to be revised to read as follows:

§ 1.603 Interference between applications; subject matter of the interference.

Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant subject to a judgment in the interference. The interfering subject matter shall be defined by one or more counts. [Each count shall define a separate patentable invention.] Each application must contain, or be amended to contain, at least one ►patentable◄ claim which corresponds to each count. All claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count.

7. Section 1.604 is proposed to be amended by revising paragraph (a)(1) to read as follows:

§ 1.604 Request for interference between applications by an applicant.

(a) * * *

(1) Suggesting a proposed count and presenting at least one claim corresponding to the proposed count or identifying at least one claim in [his or her] ►its◄ application that corresponds to the proposed count.

* * * * *

8. Section 1.605 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.605 Suggestion of claim to applicant by examiner.

(a) ►If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the ◄ [The] examiner may suggest that an applicant present a claim [in an application] ►drawn to an invention claimed in another application or patent◄ for the purpose of an interference with another application or a patent. The applicant to whom the claim is suggested shall amend the application by presenting the suggested claim within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim. At the time the suggested claim is presented, the applicant may also (1) call the examiner's attention to other claims already in the application or which are presented with the suggested claim and (2) explain why the other claims [would be more appropriate to] ►should◄ be included in any interference which may be declared.

* * * * *

9. Section 1.606 is proposed to be revised to read as follows:

§ 1.606 Interference between an application and a patent; subject matter of the interference.

Before an interference is declared between an application and an unexpired patent, an examiner must determine that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference. The interfering subject matter will be defined by one or more counts. [Each count shall define a separate patentable invention.] ►The◄ [Any] application must contain, or be amended to contain, at least one ►patentable◄ claim which corresponds to each count. ►The claim in the application need not be, and most often will not be, identical to a claim in the patent.◄ All claims in the application and patent which define the same patentable invention as a count shall be designated to correspond to the count. At the time an interference is initially declared (§ 1.611), a count shall not be narrower in scope than any patent claim which corresponds to the count and any single patent claim will be presumed, subject to a motion under § 1.633(c), not to contain separate patentable inventions.

10. Section 1.607 is proposed to be amended by revising paragraph (a)(4) and adding a new paragraph (a)(6) to read as follows:

§ 1.607 Request by applicant for interference with patent.

(a) * * *

(4) Presenting at least one claim corresponding to the proposed count or identifying at least one claim already pending in [his or her] ►its◄ application that corresponds to the proposed count, and, if any claim of the patent or application identified as corresponding to the proposed count

does not correspond exactly to the proposed count, explaining why each such claim corresponds to the proposed count, and

(5) * * *

►(6) Explaining how the requirements of 35 U.S.C. 135(b) are met, if the claim presented or identified under paragraph (a)(4) of this section was not present in the application until more than one year after the issue date of the patent.◄

* * * * *

11. Section 1.608 is proposed to be amended by revising paragraphs (a) and (b) thereof to read as follows:

§ 1.608 Interference between an application and a patent; prima facie showing by applicant.

(a) When the [earlier of the filing date or] effective filing date of an application is three months or less after the [earlier of the filing date or] effective filing date of a patent, [the applicant,] before an interference will be declared, ►either the applicant or the applicant's attorney or agent of record◄ shall file [an affidavit] ►a statement◄ alleging that there is a basis upon which ►the◄ applicant is entitled to a judgment relative to the patentee.

(b) When the [earlier of the filing date or the] effective filing date of an application is more than three months after the [earlier of the filing date or the] effective filing date [under 35 U.S.C. 120] of a patent, the applicant, before an interference will be declared, shall file (1) evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and (2) an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment. Where the basis upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would *prima facie* entitle the applicant to judgment on priority with respect to the [earlier of the filing date or] effective filing date of the patent. To facilitate preparation of a record (§ 1.653 (g) and (h)) for final hearing, an applicant should file affidavits on paper which is ►21.8 by 27.9 cm. (8½ x 11 inches)◄ [8½ x 11 inches (21.6 by 27.9 cm.)]. The significance of any printed publication or other document which is self-authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the explanation. Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of ►good◄ [sufficient] cause, an affidavit may be based on information and belief. If an examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

12. Section 1.609 is proposed to be amended by revising paragraph (b)(2) and (b)(3) to read as follows:

§ 1.609 Preparation of interference papers by examiner.

* * * * *

(b) * * *

(2) The claims of any application or patent which correspond to each count, stating whether the claims correspond exactly or substantially to each count ►and an explanation why each claim designated as corresponding to a count is directed to the same patentable invention as the count◄;

(3) The claims in any application ►or patent◄ which [are deemed by the examiner to be patentable over any] ►do not correspond to each◄ count ►and an explanation why each claim designated as not corresponding to a count is not directed to the same patentable invention as the count◄; and

* * * * *

13. Section 1.610 is proposed to be amended by revising the section heading and paragraphs (a) through (e) to read as follows:

§ 1.610 Assignment of interference to ►administrative patent judge◄ [examiner-in-chief], time period for completing interference.

(a) Each interference will be declared by an ►administrative patent judge◄ [examiner-in-chief] who may enter all interlocutory orders in the interference, except that only [a panel consisting of at least three members of] the Board shall (1) hear oral argument at final hearing, (2) enter a decision under §§ 1.617, ►1.640(e)◄ [1.640(c) or (e)], 1.652, 1.656(i) or 1.658 or (3) enter any other order which terminates the interference.

(b) As necessary, another ►administrative patent judge◄ [examiner-in-chief] may act in place of the one who declared the interference. [Unless otherwise provided in this section, at] ►At◄ the discretion of the examiner-in-chief assigned to the interference, a panel consisting of two or more members of the Board may enter interlocutory orders.

(c) Unless otherwise provided in this subpart, times for taking action by a party in the interference will be set on a case-by-case basis by the ►administrative patent judge◄ [examiner-in-chief] assigned to the interference. Times for taking action shall be set and the ►administrative patent judge◄ [examiner-in-chief] shall exercise control over the interference such that the pendency of the interference before the Board does not normally exceed two years.

(d) An ►administrative patent judge◄ [examiner-in-chief] may hold a conference with the parties to consider: (1) Simplification of any issues, (2) the necessity or desirability of amendments to counts, (3) the possibility of obtaining admissions of fact and genuineness of documents which will avoid unnecessary proof, (4) any limitations on the number of expert witnesses, (5) the time and place for conducting a deposition (§ 1.673(g)), and (6) any other matter as may aid in the disposition of the interference. After a conference, the ►administrative patent judge◄ [examiner-in-chief] may enter any order which may be appropriate.

(e) The ►administrative patent judge◄ [examiner-in-chief] may determine a proper course of conduct in an interference for any situation not specifically covered by this part.

14. Section 1.611 is proposed to be amended by redesignating paragraph (c)(8) as paragraph (c)(9), adding a new paragraph (c)(8) and revising paragraphs (b), (c)(6) and (d) to read as follows:

§ 1.611 Declaration of interference.

* * * * *

(b) When a notice of declaration is returned to the Patent and Trademark Office undelivered, or in any other circumstance where appropriate, an ►administrative patent judge◄ [examiner-in-chief] may (1) send a copy of the notice to a patentee named in a patent involved in an interference or the patentee's assignee of record in the Patent and Trademark Office or (2) order publication of an appropriate notice in the *Official Gazette*.

(c) * * *

(7) The claim or claims of any application or any patent which correspond to each count; [and]

(8) ►Why each claim designated as corresponding to a count is directed to the same patentable invention as the count and why each claim designated as not corresponding to a count is not directed to the same patentable invention as the count; and

(9) ◄The order of the parties.

(d) The notice of declaration may also specify the time for: (1) Filing a preliminary statement as provided in § 1.621(a); (2) ►Serving◄ [serving] notice that a preliminary statement has been filed as provided in § 1.621(b); and (3) ►Filing◄ [filing] preliminary motions authorized by § 1.633, oppositions to the motions, and replies to the oppositions.

* * * * *

15. Section 1.612 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.612 Access to applications.

(a) After an interference is declared, each party shall have access to and may obtain copies of the files of any application set out in the notice declaring the interference, except for affidavits filed under § 1.131 and any evidence and explanation under § 1.608 filed separate from an amendment. A party seeking access to any abandoned or pending application referred to in the [opposing party's] ►opponent's◄ involved application or access to any pending application referred to in the [opposing party's] ►opponent's◄ patent must file a motion under § 1.635. ►See § 1.11(e) concerning public access to interference files.◄

* * * * *

16. Section 1.613 is proposed to be amended by revising paragraphs (c) and (d) to read as follows:

§ 1.613 Lead attorney, same attorney representing different parties in an interference, withdrawal of attorney or agent.

* * * * *

(c) An ►administrative patent judge◄ [examiner-in-chief] may make necessary inquiry to determine whether an attorney or agent should be disqualified from representing a party in an interference. If an ►administrative patent judge◄ [examiner-in-chief] is of the opinion that an attorney or agent should be disqualified, the ►administrative patent judge◄ [examiner-in-chief] shall refer the matter to the Commissioner. The Commissioner will make a final decision as to whether any attorney or agent should be disqualified.

(d) No attorney or agent of record in an interference may withdraw as attorney or agent of record except with the approval of an ►administrative patent judge◄ [examiner-in-chief] and after reasonable notice to the party on whose behalf the attorney or agent has appeared. A request to withdraw as attorney or agent of record in an interference shall be made by motion (§ 1.635).

17. Section 1.614 is proposed to be amended by revising paragraphs (a) and (c) to read as follows:

§ 1.614 Jurisdiction over interference.

(a) The Board ►acquires◄ [shall assume] jurisdiction over an interference when the interference is declared under § 1.611.

* * * * *

(c) The examiner shall have jurisdiction over any pending application until the interference is declared. An ►administrative patent judge◄ [examiner-in-chief], where appropriate, may for a limited purpose restore jurisdiction to the examiner over any application involved in the interference.

18. Section 1.615 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.615 Suspension of ex parte prosecution

(a) When an interference is declared, ex parte prosecution of an application involved in the interference is suspended. Amendments and other papers related to the application received during pendency of the interference will not be entered or considered in the interference without the consent of an ►administrative patent judge◄ [examiner-in-chief].

(b) Ex parte prosecution as to specified matters may be continued concurrently with the interference with consent of the ►administrative patent judge◄ [examiner-in-chief].

19. Section 1.616 is proposed to be amended by revising the section heading, introductory text and paragraphs (a) through (e) to read as follows and by adding new paragraphs (b) and (c) to read as follows:

§ 1.616 Sanctions for failure to comply with rules or order ►or for taking or maintaining a frivolous position◄.

►(a)◄ An ►administrative patent judge◄ [examiner-in-chief] or the Board may impose an appropriate sanction against a party who fails to comply with the regulations of this part or any order entered by an ►administrative patent judge◄ [examiner-in-chief] or the Board. An appropriate sanction may include among others entry of an order:

►(1)◄ [(a)] Holding certain facts to have been established in the interference;

►(2)◄ [(b)] Precluding a party from filing a ►paper◄ [motion or a preliminary statement];

►(3)◄ [(c)] Precluding a party from presenting or contesting a particular issue;

►(4)◄ [(d)] Precluding a party from requesting, obtaining, or opposing discovery; [or]

►(5)◄ [(e)] ►Awarding compensatory expenses and/or compensatory attorney fees; or

(6)◄ Granting judgment in the interference.

►(b) An administrative patent judge or the Board may impose a sanction, including a sanction in the form of compensatory expenses and/or compensatory attorney fees, against a party for taking or maintaining a frivolous position.

(c) To the extent that any information under the control of an individual or entity located in a NAFTA country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has been ordered to be produced by an administrative patent judge or the Board (§ 1.671(h)), but has not been produced for use in the interference to the same extent as such information could be made available in the United States, the administrative patent judge or the Board shall draw such adverse inferences as may be appropriate under the circumstances, or take such other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the interference, including imposition of appropriate sanctions under paragraph (a) of this section.◄

20. Section 1.617 is proposed to be amended by revising paragraphs (a), (b), (d), (e), (g) and (h) to read as follows:

§ 1.617 Summary judgment against applicant.

(a) An ►administrative patent judge◄ [examiner-in-chief] shall review any evidence filed by an applicant under § 1.608(b) to determine if the applicant is *prima facie* entitled to a judgment relative to the patentee. If the ►administrative patent judge◄ [examiner-in-chief] determines that the evidence shows the applicant is *prima facie* entitled to a judgment relative to the patentee, the interference shall proceed in the normal manner under the regulations of this part. If in the opinion of the ►administrative patent judge◄ [examiner-in-chief] the evidence fails to show that the applicant is *prima facie* entitled to a judgment relative to the

patentee, the ►administrative patent judge◄ [examiner-in-chief] shall, concurrently with the notice declaring the interference, enter an order stating the reasons for the opinion and directing the applicant, within a time set in the order, to show cause why summary judgment should not be entered against the applicant.

(b) The applicant may file a response to the order ►, which may include an appropriate preliminary motion under § 1.633(c), (f) or (g),◄ and state any reasons why summary judgment should not be entered. Any request by the applicant for a hearing before the Board shall be made in the response. Additional evidence shall not be presented by the applicant or considered by the Board unless the applicant shows good cause why any additional evidence was not initially presented with the evidence filed under § 1.608(b). At the time an applicant files a response, the applicant shall serve a copy of any evidence filed under § 1.608(b) and this paragraph.

* * * * *

(d) If a response is timely filed by the applicant, all opponents may file a statement ►and may oppose any preliminary motion filed under § 1.633(c), (f) or (g) by the applicant◄ within a time set by the ►adminsitrative patent judge◄ [examiner-in-chief]. The statement may set forth views as to why summary judgment should be granted against the applicant, but the statement shall be limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the ►administrative patent judge◄ [examiner-in-chief] for issuing the order to show cause. ►Except as required to oppose a motion under § 1.633(c), (f) or (g) by the applicant, evidence◄ [Evidence] shall not be filed by any opponent. An opponent may not request a hearing.

(e) Within a time authorized by the ►administrative patent judge◄ [examiner-in-chief], an applicant may file a reply to any statement ►or opposition◄ filed by any opponent.

* * * * *

(g) If a response by the applicant is timely filed, the ►administrative patent judge◄ [examiner-in-chief] or the Board shall decide whether the evidence submitted under § 1.608(b) and any additional evidence properly submitted under ►paragraphs◄ [paragraph] (b) ►and (e)◄ of this section shows that the applicant is *prima facie* entitled to a judgment relative to the patentee. If the applicant is not *prima facie* entitled to a judgment relative to the patentee, the Board shall enter a final decision granting summary judgment against the applicant. Otherwise, an interlocutory order shall be entered authorizing the interference to proceed in the normal manner under the regulations of this subpart.

(h) Only an applicant who filed evidence under § 1.608(b) may requests a hearing. If that applicant requests a hearing, the Board may hold a hearing prior to entry of a decision under paragraph (g) of this section. The ►administrative patent judge◄ [examiner-in-chief] shall set a date and time for the hearing. Unless otherwise ordered by the ►administrative patent judge◄ [examiner-in-chief] or the Board, the applicant and any opponent will each be entitled to no more than 30 minutes of oral argument at the hearing.

21. Section 1.618 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.618 Return of unauthorized papers.

(a) ►An administrative patent judge or the Board shall enter an order directing the◄ [The Patent and Trademark Office shall] return to a party ►of◄ any paper presented by the party when the filing of the paper is not authorized by, or is not in compliance with the requirements, this subpart. Any paper returned will not thereafter be considered [by the Patent and Trademark Office] in the interference. A party may be permitted to file a corrected paper under such conditions as may be deemed appropriate by an ►administrative patent judge◄ [examiner-in-chief].

* * * * *

22. Section 1.621 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.621 Preliminary statement, time for filing, notice of filing.

* * * * *

(b) When a party files a preliminary statement, the party shall also simultaneously file and serve on all opponents in the interference a notice stating that a preliminary statement has been filed. A copy of the preliminary statement need not be served until ordered by the ►administrative patent judge◄ [examiner-in-chief].

23. Section 1.622 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.622 Preliminary statement, who made invention, where invention made.

* * * * *

(b) The preliminary statement shall state whether the invention was made in the United States ►, a NAFTA country (and, if so, which NAFTA country),◄ or [abroad] ►in a non-NAFTA country◄. If made ►in a non-NAFTA country◄ [abroad], the preliminary statement shall state whether the party is entitled to the benefit of the second sentence of 35 U.S.C. 104.

24. Section 1.623 is proposed to be amended by revising the section heading and paragraph (a) to read as follows:

§ 1.623 Preliminary statement; invention made in United States ►or a NAFTA country◄.

(a) When the invention was made in the United States ►or a NAFTA country,◄ or a party is entitled to the benefit of the second sentence of 35 U.S.C. 104, the preliminary statement must state the following facts as to the invention defined by each count:

* * * * *

25. Section 1.624 is proposed to be amended by revising the section heading and paragraphs (a), (a)(1) through (a)(6) and (c) to read as follows:

§ 1.624 Preliminary statement; invention made [abroad] ►in a non-NAFTA country◄.

(a) When the invention was made ►in a non-NAFTA county◄ [abroad] and a party intends to rely on introduction of the invention into the United States ►or a NAFTA country◄, the preliminary statement must state the following facts as to the invention defined by each count:

(1) The date on which a drawing of the invention was first introduced into the United States ►or a NAFTA country◄.

(2) The date on which a written description of the invention was first introduced into the United States ►or a NAFTA country◄.

(3) The date on which the invention was first disclosed to another person in the United States ►or a NAFTA country◄.

(4) The date on which the inventor's conception of the invention was first introduced into the United States ►or a NAFTA country◄.

(5) The date on which an actual reduction to practice of the invention was first introduced into the United States ►or a NAFTA country◄. If an actual reduction to practice of the invention was not introduced into the United States ►or a NAFTA country◄, the preliminary amendment shall so state.

(6) The date after introduction of the inventor's conception into the United States ►or a NAFTA country◄ when active exercise of reasonable diligence in the United States ►or a NAFTA

country◄ toward reducing the invention to practice began.

* * * * *

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was introduced into the United States ►or a NAFTA country,◄ a copy of that drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was introduced into the United States ►or a NAFTA country,◄ a copy of that written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or first written description introduced in the United States ►or a NAFTA country◄ cannot be filed with the preliminary statement.

26. Section 1.625 is proposed to be amended by revising paragraph (a) introductory text to read as follows:

§ 1.625 Preliminary statement; derivation by an opponent.

(a) When [the invention was made in the United States or abroad and] a party intends to prove derivation by an opponent from the party, the preliminary statement must state the following as to the invention defined by each count:

* * * * *

27. Section 1.626 is proposed to be revised to read as follows:

§ 1.626 Preliminary statement; earlier application.

When a party does not intend to present evidence to prove a conception or an actual reduction to practice and the party intends to rely solely on the filing date of an earlier ►filed◄ application [filed in the United States or abroad] to prove a constructive reduction to practice, the preliminary statement may so state and identify the earlier ►filed◄ application with particularity.

28. Section 1.627 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.627 Preliminary statement; sealing before filing, opening of statement.

* * * * *

(b) A preliminary statement may be opened only at the direction of an ►administrative patent judge◄ [examiner-in-chief].

29. Section 1.628 is proposed to be amended by revising paragraphs (a) and (b)(2) to read as follows:

§ 1.628 Preliminary statement; correction of error.

(a) A material error arising through inadvertence or mistake in connection with (1) a preliminary statement or (2) drawings or a written description submitted therewith or omitted therefrom, may be corrected by a motion (§ 1.635) for leave to file a corrected statement. The motion shall be supported by an affidavit ►stating the date the error was first discovered,◄ [and shall show that the correction is essential to the ends of justice and] shall be accompanied by the corrected statement [. The motion] ►and◄ shall be filed as soon as practical after discovery of the error. ►If filed on or after the date set by the administrative patent judge for service of preliminary statements, the motion shall also show that correction of the error is essential to the interest of justice.◄

(b) * * *

(2) shall attach to the preliminary statement the earliest drawing or written description made in or introduced into the United States ►or a NAFTA country◄ which is available. The party shall file a motion (§ 1.635) to amend its preliminary statement promptly after the first drawing, first written description, or drawing or written description first introduced into the United States ►or a NAFTA country◄ becomes available. A copy of the drawing or written description may be obtained, where appropriate, by a motion (§ 1.635) for additional discovery under § 1.687 or during a testimony period.

30. Section 1.629 is proposed to be amended by revising paragraphs (a), (c)(1) and (d) to read as follows:

§ 1.629 Effect of preliminary statement.

(a) A party shall be strictly held to any date alleged in the preliminary statement. Doubts as to (1) definiteness or sufficiency of any allegation in a preliminary statement or (2) compliance with formal requirements will be resolved against the party filing the statement by restricting the party to [the earlier of] its [filing date or] effective filing date or to the latest date of a period alleged in the preliminary statement [,] as may be appropriate. A party may not correct a preliminary statement except as provided by § 1.628.

* * * * *

(c) * * *

(1) Shall be restricted to the [earlier of the] party's [filing date or] effective filing date and

* * * * *

(d) If a party files a preliminary statement which contains an allegation of a date of first drawing or first written description and the party does not file a copy of the first drawing or written description with the preliminary statement as required by § 1.623(c), § 1.624(c), or § 1.625(c), the party will be restricted to the [earlier of the] party's [filing date or] effective filing date as to that allegation unless the party complies with § 1.628(b). The content of any drawing or written description submitted with a preliminary statement will not normally be evaluated or considered by the Board.

* * * * *

31. Section 1.630 is proposed to be revised to read as follows:

§ 1.630 Reliance on earlier application.

A party shall not be entitled to rely on the filing date of an earlier ►filed◄ application [filed in the United States or abroad] unless (a) the earlier application is identified (§ 1.611(c)(5)) in the notice declaring the interference or (b) the party files a preliminary motion under § 1.633 seeking the benefit of the filing date of the earlier application.

32. Section 1.631 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.631 Access to preliminary statement, service of preliminary statement.

(a) Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief] on preliminary motions filed under § 1.633, any preliminary statement filed under § 1.621(a) shall be opened to inspection by the senior party and any junior party who filed a preliminary statement. Within a time set by the ►administrative patent judge◄ [examiner-in-chief], a party shall serve a copy of its preliminary statement on each opponent who served a notice under § 1.621(b).

* * * * *

33. Section 1.632 is proposed to be revised to read as follows:

§ 1.632 Notice of intent to argue abandonment, suppression or concealment by opponent.

A notice shall be filed by a party who intends to argue that an opponent has abandoned, suppressed ►,◄ or concealed an actual reduction to practice (35 U.S.C. 102(g)). A party will not be permitted to argue abandonment, suppression, or concealment by an opponent unless the notice is timely filed. Unless authorized otherwise by an ►administrative patent judge◄ [examiner-in-chief], a notice is timely when filed within ten (10) days ►after◄ [of] the close of the testimony-in-chief of the opponent.

34. Section 1.633 is proposed to be amended by revising paragraphs (a),

(a)(1), (a)(2), (b)(2), (f), (g) and (i) to read as follows:

§ 1.633 Preliminary motions.

* * * * *

(a) A motion for judgment ►against◄ [on the ground that] an opponent's claim corresponding to a count ►on the ground that the claim◄ is not patentable to the opponent. In ►deciding an issue raised in◄ [determining] a motion filed under this paragraph, a claim [may] ►will◄ be construed [by reference to the prior art of record] ►in light of the specification of the application or patent in which it appears◄. A motion under this paragraph shall not be based on:

(1) Priority of invention [of the subject matter of a count] by the moving party as against any opponent or

(2) ►Derivation◄ [derivation] of the ►invention◄ [subject matter of a count] by an opponent from the moving party. See 1.637(a).

(b) * * *

(2) no claim of a party which corresponds to a count is identical to any claim of an opponent which corresponds to that count. See § 1.637(a). ►When claims of opponents are presented in "means plus function" format, it may be possible for the claims of the opponents not to define the same patentable invention even though the claims contain the same literal wording.◄

* * * * *

(f) A motion to be accorded the benefit of the filing date of an earlier ►filed◄ application [filed in the United States or abroad]. See § 1.637 (a) and (f).

(g) A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier ►filed◄ application [filed in the United States or abroad]. See § 1.637 (a) and (g).

* * * * *

(i) When a motion is filed under paragraph (a), (b), or (g) of this section, an opponent, in addition to opposing the motion, may file a motion to redefine the interfering subject matter under paragraph (c) of this section [or] ►,◄ a motion to substitute a different application under paragraph (d) of this section ►, or a motion to add a reissue application to the interference under paragraph (h) of this section◄.

* * * * *

35. Section 1.636 is proposed to be amended by revising paragraphs (a) through (d) to read as follows:

§ 1.636 Motions, time for filing.

(a) A preliminary motion under § 1.633 (a) through (h) shall be filed within a time period set by an ►administrative patent judge◄ [examiner-in-chief].

(b) A preliminary motion under § 1.633 (i) or (j) shall be filed within 20 days of the service of the preliminary motion under § 1.633 (a), (b), (c)(1), or (g) unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief].

(c) A motion under § 1.634 shall be diligently filed after an error is discovered in the inventorship of an application or patent involved in an interference unless otherwise ordered buy an ►administrative law judge◄ [examiner-in-chief].

(d) A motion under § 1.635 shall be filed as specified in this subpart or when appropriate unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief].

36. Section 1.637 is proposed to be amended by revising paragraphs (a), (b), (c)(1)(v), (c)(1)(vi), (c)(2)(ii), (c)(2)(iii), (c)(3)(ii), (c)(4)(i), (c)(4)(ii), (d) introductory text, (e)(1)(viii), (e)(2)(vii), (f)(2), (h)(3), (h)(4) to read as follows, deleting paragraphs (c)(2)(iv), (c)(3)(iii), (d)(4) and redesignating them as "Reserved." and adding paragraphs (c)(1)(vii), (e)(1)(ix), (e)(2)(viii) to read as follows:

§ 1.637 Content of motions.

(a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. ►Each◄ [Every] motion shall include (1) a statement of the precise relief requested, (2) a statement of the material facts in support of the motion ►preferably in numbered paragraphs◄, and (3) a full statement of the reasons why the relief requested should be granted. ►If a party files a motion for judgment under § 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party. If the motion fails to include a sufficient explanation or evidence, the party will not be permitted to rely on any such explanation or evidence in response to or in any subsequent action in the interference.◄

(b) A motion under [§] ►§§ 1.633, 1,634 or◄ 1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all [opposing parties] ►opponents◄ in an effort in good faith to resolve by agreement the issues raised by the motion. ►The certificate shall indicate that the reasons and facts in support of the motion were discussed with each opponent and, if an opponent has indicated that it will oppose the motion, identify the issues and/or facts believed to be in dispute.◄ [A moving party shall indicate in the motion whether any other party plans to oppose the motion.] The provisions of this paragraph do not apply to a motion to suppress evidence (§ 1.656(h)).

(c) * * *

(1) * * *

(v) Show that each proposed count ►is patentable over the prior art and◄ defines a separate patentable invention from every other count ►proposed to remain◄ in the interference.

(vi) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier ►filed◄ application [filed in the United States or abroad] ►, if benefit of the earlier filed application is desired with respect to a proposed count◄.

►(vii) If an opponent is accorded the benefit of the filing date of an earlier filed application in the notice of declaration of the interference, show why the opponent is not entitled to benefit of the earlier filed application with respect to the proposed count. Otherwise, the opponent will be presumed to be entitled to the benefit of the earlier filed application with respect to the proposed count.◄

(2) * * *

(ii) Show that the ►claim◄ proposed ►to be amended◄ or added [claim] defines the same patentable invention as the count.

(iii) Show the patentability to the applicant of each ►claim proposed to be◄ amended or added [claim] and apply the terms of the ►claim proposed to be◄ amended or added [claim] to the disclosure of the application; when necessary a moving party applicant shall file with the motion [an] ►a proposed◄ amendment [making the amended] ►to the application amending the claim corresponding to the count◄ or [added] ►adding the proposed additional◄ claim to the application.

(iv) ►Reserved.◄ [Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.]

(3) * * *

(ii) Show the claim defines the same patentable invention as ►another claim whose designation as corresponding

to◄ the count ►the moving party does not dispute◄.

(iii) ►Reserved.◄ [Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier application filed in the United States or abroad.]

(4) * * *

(ii) Show ►(A) that◄ the claim does not define the same patentable invention as any other claim [designated] ►whose designation◄ in the notice declaring the interference as corresponding to the count ►the party does not dispute and (B) that the claim cannot serve as the basis for a motion under § 1.633(c)(1) to add a new count◄.

* * * * *

(d) A preliminary motion under § 1.633(d) to substitute a different application ►of the moving party◄ shall:

* * * * *

(4) ►Reserved.◄ [Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier application filed in the United States or abroad].

(e) * * *

(1) * * *

(viii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier ►filed◄ application [filed in the United States or abroad] ►, if benefit is desired with respect to a proposed count◄.

►(ix) If an opponent is accorded the benefit of the filing date of an earlier filed application in the notice of declaration of the interference, show why the opponent is not entitled to benefit of the earlier filed application with respect to the proposed count. Otherwise, the opponent will be presumed to be entitled to the benefit of the earlier filed application with respect to the proposed count.◄

(2) * * *

(vii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier ►filed◄ application [filed in the United States or abroad] ►, if benefit is desired with respect to a proposed count◄.

►(viii) If an opponent is accorded the benefit of the filing date of an earlier filed application in the notice of declaration of the interference, show why the opponent is not entitled to benefit of the earlier filed application with respect to the proposed count. Otherwise, the opponent will be presumed to be entitled to the benefit of the earlier filed application with respect to the proposed count.◄

(f) * * *

(2) When the earlier application is an application filed in the United States, certify that a complete copy of the file of the earlier application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents. When the earlier application is an application filed ►in a foreign country◄ [abroad], certify that a copy of the application [filed abroad] has been served on all opponents. If the earlier ►filed◄ application [filed abroad] is not in English, the requirements of § 1.647 must also be met.

* * * * *

(h) * * *

(3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue; when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue. ►A patentee may not move under § 1.633(h) to add a reissue application that includes new or amended claims to be designated as not corresponding to a count.◄

(4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier ►filed◄ application [filed in the United States or abroad] ►, if benefit is desired◄.

37. Section 1.638 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.638 Opposition and reply, time for filing opposition and reply.

(a) Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], any opposition to any motion shall be filed within 20 days after service of the motion. An opposition shall (1) identify any material fact set forth in the motion which is in dispute and (2) include an argument why the relief requested in the motion should be denied.

(b) Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], ►any◄ [a] reply shall be filed within 15 days after service of the opposition. A reply shall be directed only to new points raised in the opposition.

38. Section 1.639 is proposed to be amended by revising paragraphs (a), (c), and (d)(1) to read as follows:

§ 1.639 Evidence in support of motion, opposition, or reply.

(a) ►Except as provided in paragraphs (c) through (g) of this section, proof◄ [Proof] of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

* * * * *

(c) If a party believes that additional evidence in the form of testimony that is unavailable to the party is necessary to support or oppose a preliminary motion under § 1.633 or a motion to correct inventorship under § 1.634, the party shall describe the nature of any proposed testimony as specified in paragraphs (d) through (g) of this section. If the ►administrative patent judge◄ [examiner-in-chief] finds that testimony is needed to decide the motion, the ►administrative patent judge◄ [examiner-in-chief] may grant appropriate interlocutory relief and enter an order authorizing the taking of testimony and deferring a decision on the motion to final hearing.

(d) * * *

(1) Identify the person whom it expects to [call] ►use◄ as an expert;

* * * * *

39. Section 1.640 is proposed to be amended by revising paragraphs (a), (b), (b)(1), (b)(2), (c), (d), (d)(1), (d)(3) and (e) to read as follows:

§ 1.640 Motions, hearing and decision, redeclaration of interference, order to show cause.

(a) A hearing on a motion may be held in the discretion of the ►administrative patent judge◄ [examiner-in-chief]. The ►administrative patent judge◄ [examiner-in-chief] shall set the date and time for any hearing. The length of oral argument at a hearing on a motion is a matter within the discretion of the ►administrative patent judge◄ [examiner-in-chief]. An ►administrative patent judge◄ [examiner-in-chief] may direct that a hearing take place by telephone.

(b) ►Unless an administrative patent judge or the Board is of the opinion that a decision on a preliminary motion would materially advance the resolution of the interference, decision on a preliminary motion shall be deferred to final hearing.◄ Motions ►otherwise◄ will be decided by an ►administrative patent judge◄ [examiner-in-chief]. An ►administrative patent judge◄ [examiner-in-chief] may consult with an examiner in deciding motions involving a question of patentability. An ►administrative patent judge◄ [examiner-in-chief] ►may take up motions for decision in any order and◄ may grant or deny any motion or take

such other action which will secure the just, speedy, and inexpensive determination of the interference. ►A matter raised by a party in support of or in opposition to a motion that is deferred to final hearing will not be entitled to consideration at final hearing unless the matter is raised in the party's brief at final hearing. If the administrative patent judge determines that the interference shall proceed to final hearing on the issue of priority or derivation, a time shall be set for each party to file a paper identifying any decisions on motions or on matters raised sua sponte by the administrative patent judge that the party wishes to have reviewed at final hearing as well as identifying any deferred motions that the party wishes to have considered at final hearing. Any evidence that a party wishes to have considered with respect to the decisions and motions identified by the party or by an opponent for consideration or review at final hearing, including any affidavit filed by the party under § 1.608 or 1.639(b), shall be served on the opponent during the testimony-in-chief period of the party.◄

(1) ►When appropriate after the time expires for filing replies to oppositions to preliminary motions◄ [When preliminary motions under § 1.633 are decided], the ►administrative patent judge◄ [examiner-in-chief] will [, when necessary,] set a time for filing any amendment to an application involved in the interference and for filing a supplemental preliminary statement as to any new counts ►which may become◄ involved in the interference ►if a preliminary motion to amend or substitute a count has been filed◄. Failure or refusal of a party to timely present an amendment required by an ►administrative patent judge◄ [examiner-in-chief] shall be taken without further action as a disclaimer by that party of the invention involved. A supplemental preliminary statement shall meet the requirements specified in § 1.623, § 1.624, § 1.625, or § 1.626, but need not be filed if a party states that it intends to rely on a preliminary statement previously filed under § 1.621(a). ►At an appropriate time in the interference, and when necessary◄ [After the time expires for filing any amendment and supplemental preliminary statement], ►an order will be entered redeclaring [the examiner-in-chief will, if necessary, redeclare] the interference.

(2) After ►the time expires for filing preliminary motions◄ [a decision is entered on preliminary motions filed under § 1.633], a further ►preliminary◄ motion under § 1.633 will not be considered except as provided by § [1.655(b)] ►1.645(b)◄.

(c) When a decision on any motion under § 1.633, § 1.634, or § 1.635 ►or on any matter raised sua sponte by an administrative patent judge◄ is entered which does not result in the issuance of an order to show cause under paragraph (d) of this section, a party may file a request for reconsideration within 14 days after the date of the decision. ►The request for reconsideration shall be served by hand or Express Mail.◄ The filing of a request for reconsideration will not stay any time period set by the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. ►An opponent may file an opposition within 14 days after service of the request for reconsideration.◄ [No opposition to a request for reconsideration shall be filed unless requested by an examiner-in-chief or the Board. A decision of a single examiner-in-chief will not ordinarily be modified unless an opposition has been requested by an examiner-in-chief or the Board. The request for reconsideration shall be acted on by a panel of the Board consisting of at least three examiners-in-chief, one of whom will normally be the examiner-in-chief who decided the motion].

(d) An ►administrative patent judge◄ [examiner-in-chief] may issue an order to show cause why judgment should not be entered against a party when:

(1) A decision on a motion ►or on a matter raised sua sponte by an administrative patent judge◄ is entered which is dispositive of the interference against the party as to any count;

* * * * *

(3) The party is a junior party whose preliminary statement fails to overcome the [earlier of the filing date or] effective filing date of another party.

(e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which shows good cause why judgment should not be entered in accordance with the order.

►(1) If the order was issued under paragraph (d)(1) of this section, the paper may (i) request that final hearing be set to review any decision which is the basis for the order as well as any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at final hearing, or (ii) fully explain why judgment should not be entered.

(2)◄ Any other party may file a response to the paper within 20 days of the date of service of the paper. ►If the order was issued under paragraph (d)(10 of this section and the paper includes a request for final hearing, the response must identify every decision of the administrative patent judge that the responding party wishes to have reviewed by the Board at a final hearing. If the order was issued under paragraph (d)(1) of this section and the paper does not include a request for final hearing, the response may include a request for final hearing, which must identify every decision of the administrative patent judge that the responding party wishes to have reviewed by the Board at a final hearing. Where only the response includes a request for a final hearing, the party that filed the paper has 14 days from the date of service of the response in which to file a supplemental paper identifying any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at a final hearing.

(3) The paper or the response thereto should be accompanied by a motion (§ 1.635) requesting a testimony period if a party wishes to introduce any evidence to be considered at final hearing (§ 1.671). A request for a testimony period shall be construed as including a request for final hearing.

(4) If the paper contains an explanation of why judgment should not be entered in accordance with the order and no party has requested a final hearing, the decision that is the basis for the order shall be reviewed based on the contents of the paper and the response. If the paper fails to show good cause, the Board shall enter judgment against the party against whom the order issued.◄ [If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party. If a party wishes to take testimony in response to an order to show cause, the party's response should be accompanied by a motion (§ 1.635) requesting the testimony period. See § 1.651(c)(4).]

40. Section 1.461 and the section heading are proposed to be revised to read as follows:

§ 1.641 Unpatentability discovered by ►administrative patent judge◄ [examiner-in-chief].

◄(a)► During the pendency of an interference, if the ◄administrative patent judge► [examiner-in-chief] becomes aware of a reason why a claim ◄designated to correspond► [corresponding] to a count may not be patentable, the ◄administrative patent

judge► [examiner-inc-chief] may ◄enter an order notifying► [notify] the parties of the reason and set a time within which each party may present its views◄, which may include argument and any appropriate preliminary motions under § 1.633(c), (d) or (h), including any supporting evidence►.

►(b) If a party timely files a preliminary motion in response to the order of the administrative patent judge, any opponent may file an opposition pursuant to § 1.638(a). If an opponent files an opposition, the party may reply pursuant to § 1.638(b).

(c)◄ After considering any timely filed views, ►including any timely filed preliminary motions under § 1.633,◄ the ►administrative patent judge◄ [examiner-in-chief] shall decide how the interference shall proceed.

41. Section 1.642 is proposed to be revised to read as follows:

§ 1.642 Addition of application or patent to interference.

During the pendency of an interference, if the ►administrative patent judge◄ [examiner-in-chief] becomes aware of an application of a patent not involved in the interference which claims the same patentable invention as a count in the interference, the ►administrative patent judge◄ [examiner-in-chief] may add the application or patent to the interference on such terms as may be fair to all parties.

42. Section 1.643 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.643 Prosecution of interference by assignee.

* * * * *

(b) An assignee of a part interest in an application or patent involved in an interference may file a motion (§ 1.635) for entry of an order authorizing it to prosecute the interference. The motion shall show (1) the inability or refusal of the inventor to prosecute the interference or (2) other cause why ►it is in the interest of◄ [the ends of] justice ►to permit◄ [require that] the assignee of a part interest [be permitted] to prosecute the interference. The ►administrative patent judge◄ [examiner-in-chief] may allow the assignee of a part interest to prosecute the interference upon such terms as may be appropriate.

43. Section 1.644 is proposed to be amended by revising paragraphs (a), (a)(1), (a)(2), (b), (c), (d), (f) and (g) to read as follows:

§ 1.644 Petitions in interferences.

(a) There is no appeal to the Commissioner in an interference from a decision of an ►administrative patent judge◄ [examiner-in-chief] or ►the Board◄ [a panel consisting of more than one examiner-in-chief]. The Commissioner will not consider a petition in an interference unless:

(1) The petition is from a decision of an ►administrative patent judge◄ [examiner-in-chief] or [a panel] ►the Board◄ and the ►administrative patent judge◄ [examiner-in-chief] or the [panel] ►Board◄ shall be of the opinion

* * * * *

(2) The petition seeks to invoke the supervisory authority of the Commissioner [and is not filed prior to the decision of the Board awarding judgment] and does not relate to

* * * * *

(3) * * *

(b) A petition under paragraph (a)(1) of this section filed more than 15 days after the date of the decision of the ►administrative patent judge◄ [examiner-in-chief] or the [panel] ►Board◄ may be dismissed as untimely. A petition under paragraph (a)(2) of this section shall not be filed prior to ►the party's brief for final hearing (see § 1.656)◄ [the decision by the Board awarding judgment]. Any petition under paragraph (a)(3) of this section shall be timely if it is made as part of, or simultaneously with, a proper motion under § 1.633, § 1.634, or § 1.635 ►when granting the motion would require waiver of a rule◄. Any opposition to a petition shall be filed within 15 days of the date of service of the petition.

(c) The filing of a petition shall not stay the proceeding unless a stay is granted in the discretion of the ►administrative patent judge◄ [examiner-in-chief, the panel], ►the Board,◄ or the Commissioner.

(d) Any petition must contain a statement of the facts involved ►, preferably in numbered paragraphs,◄ and the point or points to be reviewed and the action requested. [Briefs or memoranda, if any, in support of the petition or opposition shall accompany or be embodied therein.] The petition will be decided on the basis of the record made before the ►administrative patent judge◄ [examiner-in-chief] or the [panel] ►Board◄ and no new evidence will be considered by the Commissioner in deciding the petition. Copies of documents already of record in the interference shall not be submitted with the petition or opposition.

* * * * *

(f) Any request for reconsideration of a decision by the Commissioner shall be filed within ►14◄ [15] days of the decision of the Commissioner and must be accompanied by the fee set forth in § 1.17(h). No opposition to a request for reconsideration shall be filed unless requested by the Commissioner. The decision will not ordinarily be modified unless such an opposition has been requested by the Commissioner.

(g) Where reasonably possible, service of any petition, opposition, or request for reconsideration shall be such that delivery is accomplished within one working day. Service by hand or ["] Express Mail ["] complies with this paragraph.

* * * * *

44. Section 1.645 is proposed to be amended by revising paragraphs (a), (b) and (d) to read as follows:

§ 1.645 Extension of time, late papers, stay of proceedings.

(a) Except to extend the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action, a party may file a motion (§ 1.635) seeking an extension of time to take action in an interference. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action. The motion shall be filed within sufficient time to actually reach the ►administrative patent judge◄ [examiner-in-chief] before expiration of the time for taking action. A moving party should not assume that the motion will be granted even if there is no objection by any other party. The motion will be denied unless the moving party shows good cause why an extension should be granted. The press of other business arising after an ►administrative patent judge◄ [examiner-in-chief] sets a time for taking action will not normally constitute good cause. A motion seeking additional time to take testimony because a party has not been able to procure the testimony of a witness shall set forth the name of the witness, any steps taken to procure the testimony of the witness, the dates on which the steps were taken, and the facts expected to be proved through the witness.

(b) Any paper belatedly filed [.] will not be considered except upon motion (§ 1.635) which shows ►good◄ [sufficient] cause why the paper was not timely filed [.] ►or an administrative patent judge or the Board, sua sponte, is of the opinion that

it would be in the interest of justice to consider the paper.◄ See § 1.304(a) for exclusive procedures relating to belated filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or belated commencement of a civil action.

* * * * *

(d) [In an appropriate circumstance, an] ►An administrative patent judge◄ [examiner-in-chief] may stay proceedings in an interference.

45. Section 1.646 is proposed to be amended by revising paragraphs (a)(1), (a)(2), (b), (c), (c)(1), (c)(4), (d) and (e), redesignating paragraph (c)(5) as (c)(6) and revising it, and adding a new paragraph (c)(5) to read as follows:

§ 1.646 Service of papers, proof of service.

(a) * * *

(1) Preliminary statements when filed under § 1.621; preliminary statements shall be served when service is ordered by an ►administrative patent judge◄ [examiner-in-chief].

(2) Certified transcripts and exhibits which accompany the transcripts filed under § [§] 1.676 [or 1.684]; copies of transcripts shall be served as part of a party's record under § 1.653(c).

(b) Service shall be on an attorney or agent for a party. If there is no attorney or agent for the party, service shall be on the party. An ►administrative patent judge◄ [examiner-in-chief] may order additional service or waive service where appropriate.

(c) Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], or except as otherwise provided by this subpart, service of a paper shall be made as follows:

(1) By handing a copy of the paper ►or causing a copy of the paper to be handed◄ to the person served.

* * * * *

(4) By mailing a copy of the paper by first class mail; when service is by ►first class◄ mail the date of mailing is regarded as the date of service.

(5) ►By mailing a copy of the paper by Express Mail; when service is by Express Mail the date of deposit with the U.S. Postal Service is regarded as the date of service.

(6) ◄When it is shown to the satisfaction of an ►administrative patent judge◄ [examiner-in-chief] that none of the above methods of obtaining or serving the copy of the paper was successful, the ►administrative patent judge◄ [examiner-in-chief] may order service by publication of an appropriate notice in the *Official Gazette*.

(d) An ►administrative patent judge◄ [examiner-in-chief] may order that a paper be served by hand or ["]Express Mail["].

(e) ►The due date for serving a paper is the same as the due date for filing the paper in the Patent and Trademark Office.◄ Proof of service must be made before a paper will be considered in an interference. Proof of service may appear on or be affixed to the paper. Proof of service shall include the date and manner of service. In the case of personal service under paragraphs (c)(1) through (c)(3) of this section, proof of service shall include the names of any person served and the person who made the service. Proof of service may be made by an acknowledgment of service by or on behalf of the person served or a statement signed by the party or the party's attorney or agent containing the information required by this section. A statement of an attorney or agent attached to, or appearing in, the paper stating the date and manner of service will be accepted as *prima facie* proof of service.

46. Section 1.647 is proposed to be revised to read as follows:

§ 1.647 Translation of document in foreign language.

When a party relies on a document ►or is required to produce a document◄ in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

47. Section 1.651 is proposed to be amended by revising paragraphs (a), (a)(2), (c)(1), (c)(2), (c)(3) and (d) to read as follows:

§ 1.651 Setting times for discovery and taking testimony, parties entitled to take testimony.

(a) At an appropriate stage in an interference, an ►administrative patent judge◄ [examiner-in-chief] shall set

* * * * *

(2) Testimony periods for taking any necessary testimony [(testimony includes testimony to be taken abroad under § 1.684)].

* * * * *

(c) * * *

(1) The ►administrative patent judge◄ [examiner-in-chief] orders the taking of testimony under § 1.639(c);

(2) The party alleges in its preliminary statement a date of invention prior to the [earlier of the filing date or] effective filing date of the senior party;

(3) A testimony period has been set to permit an opponent to prove a date of invention prior to the [earlier of the filing date or] effective filing date of the party and the party has filed a preliminary statement alleging a date of invention prior to that date; or

* * * * *

(d) Testimony, including any testimony to be taken ►in a foreign country◄ [abroad under § 1.684], shall be taken and completed during the testimony periods set under paragraph (a) of this section. A party seeking to extend the period for taking testimony must comply with § 1.635 and § 1.645(a).

48. Section 1.652 is proposed to be revised to read as follows:

§ 1.652 Judgment for failure to take testimony or file record.

If a junior party fails to timely take testimony authorized under § 1.651, or file a record under § 1.653(c), an ►administrative patent judge◄ [examiner-in-chief], with or without a motion (§ 1.635) by another party, may issue an order to show cause why judgment should not be entered against the junior party. When an order is issued under this section, the Board shall enter judgment in accordance with the order unless, within 15 days after the date of the order, the junior party files a page which shows good cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 15 days of the date of service of the paper. If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party.

49. Section 1.653 is proposed to be amended by deleting paragraphs (c)(5), (f) and (h) and redesignating them as "Reserved" and by revising paragraphs (a), (b), (c), (c)(1), (c)(4), (g) and (i) to read as follows:

§ 1.653 Record and exhibits.

(a) Testimony shall consist of affidavits under [§] ►§§◄ 1.672(b) ►, (c)◄ and [(e)] ►(g), 1.682(c), 1.683(b) and 1.688(b)◄, transcripts of depositions under §§ [1.672(b) and (c)] ►1.671(g) and 1.672(a) when a deposition is authorized by an administrative patent judge, transcripts of depositions under §§ 1.672(d), 1.682(d), 1.683(c) and 1.688(c)◄, agreed statements [of fact] under § [1.672(f)] ►1.672.(h)◄, [and] transcripts of interrogatories, cross-interrogatories, and recorded answers ►and copies of written interrogatories and answers and written requests for admissions and answers◄ under § [1.684(c)] ►1.688(a)◄.

(b) An affidavit shall be filed as set forth in § [1.672(b)] ►1.677◄. A certified transcript of a deposition ►,◄ including a deposition cross-examining

an affiant, shall be filed as set forth in [§] ►§§◄ 1.676►, 1.677 and 1.678◄. An original agreed statement shall be filed as set forth in ►§ 1.672(h)◄ [§ 1.672(f). A transcript of interrogatories, cross-interrogatories, and recorded answers shall be filed as set forth under § 1.684(c)].

(c) In addition to the items specified in paragraph (b) of this section and within a time set by an ►administrative patent judge,◄ [examiner-in-chief] each party shall file three copies and serve one copy of a record consisting of:

(1) An index of the names of [each witness] ►the witnesses for the party,◄ giving the pages of the record where the direct testimony and cross-examination of each witness begins.

* * * * *

(4) Each (i) affidavit ►by a witness for the party◄, (ii) transcript, including transcripts of cross-examination of any affiant ►who testified for the party and transcripts of compelled deposition testimony by a witness for the party◄, (iii) agreed statement relied upon by the party, and (iv) transcript of interrogatories, cross-interrogatories and recorded answers [filed under paragraph (b) of this section].

(5) ►Reserved.◄ [Each notice, official record, and publication relied upon by the party and filed under § 1.682(a).]

* * * * *

(f) ►Reserved.◄ [The record may be typewritten or printed.]

(g) [When the] ►The◄ [is printed, it] may be produced by standard typographical printing or by any ►other◄ process capable of producing a clear black permanent image◄. All printed matter except on covers must appear in at least 11 point type on opaque, unglazed paper. [Margins must be justified.] Footnotes may not be printed in type smaller than 9 point. The ►pages◄ [pages] size shall be ►21.8 by 27.9 cm. (8½ by 11 inches) (letter size)◄ [8½ by 11 inches (21.8 by 27.9 cm.)] with [type] ►printed◄ matter ►16.5 by 24.1 cm. (6½ by 9½ inches)◄ [6½ by 9½ inches (16.5 by 24.1 cm.)]. The record shall be bound ►with covers at their left edges in such manner as◄ to lie flat when open ►to any page and in one or more volumes of convenient size (approximately 100 pages per volume is suggested). When there is more than one volume, the numbers of the pages contained in each volume shall appear at the top of the cover for each volume◄.

(h) ►Reserved.◄ [When the record is type written, it must be clearly legible on opaque, unglazed, durable paper approximately 8½ by 11 inches (21.8 by 27.9 cm.) in size (letter size). Typing shall be double-spaced on one side of the paper in not smaller than pica-type with a margin of 1½ (3.8 cm.) on the left-hand side of the page. The pages of the record shall be bound with covers at their left edges in such manner to lie flat when open in one or more volumes of convenient size (approximately 100 pages per volume is suggested). Multigraph or otherwise reproduced copies conforming to the standards specified in this paragraph may be accepted.]

(i) Each party shall file its exhibits with the record specified in paragraph (c) of this section. ►Exhibits include documents and things identified in affidavits or on the record during the taking of oral depositions and official records and publications filed by the party under § 1.682(a).◄ One copy of each documentary exhibit shall be served. Documentary exhibits shall be filed in an envelope or folder and shall not be bound as part of the record. Physical exhibits, if not filed by an officer under § 1.676(d), shall be filed with the record. Each exhibit shall contain a label which identifies the party submitting the exhibit and an exhibit number, the style of the interference (e.g., Jones v. Smith), and the interference number. Where possible, the label should appear at the bottom right-hand corner of each documentary exhibit. Upon termination of an interference, an ►administrative patent judge◄ [examiner-in-chief] may return an exhibit to the party filing the exhibit. When any exhibit is returned, [the examiner-in-chief] ►an order◄ shall ►be entered◄ [enter an appropriate order] indicating that the exhibit has been returned.

* * * * *

50. Section 1.654 is proposed to be amended by revising paragraphs (a) and (d) to read as follows:

§ 1.654 Final hearing.

(a) At an appropriate stage of the interference, the parties will be given an opportunity to appear before the Board to present oral argument at a final hearing. An ►administrative patent judge may◄ [examiner-in-chief shall] set a date and time for final hearing. Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief] or the Board, each party will be entitled to no more than ►30◄ [60] minutes or oral argument at final hearing. ►A party who does not file a brief for final hearing (§ 1.656(a)) shall not be entitled to appear at final hearing.◄

* * * * *

(d) After final hearing, the interference shall be taken under advisement by the Board. No further paper shall be filed except under § 1.658(b) or as authorized by an ►administrative patent judge◄ [examiner-in-chief] or the Board. No additional oral argument shall be had unless ordered by the Board.

51. Section 1.655 is proposed to be amended by revising paragraphs (a), (b) and (c) to read as follows:

§ 1.655 Matters considered in rendering a final decision.

(a) In rendering a final decision, the Board may consider any properly raised issue including (1) priority of invention, (2) derivation by an opponent from a party who filed a preliminary statement under § 1.625, (3) patentability of the invention, (4) admissibility of evidence, (5) any interlocutory matter deferred to final hearing, and (6) any other matter necessary to resolve the interference. The Board may also consider whether ►entry of◄ any interlocutory order was [erroneous or] an abuse of discretion. All interlocutory orders shall be presumed to have been correct and the burden of showing [error or] an abuse of discretion shall be on the party attacking the order. When two or more interlocutory orders involve the same issue, the last entered order shall be presumed to have been correct.

(b) A party shall not be entitled to raise for consideration at final hearing a matter which properly could have been raised by a motion under §§ 1.633 or 1.634 unless (1) the ►matter was properly raised in a◄ motion ►that◄ was [properly] ►timely◄ filed ►by the party under §§ 1.633 or 1.634 and the motion was denied or deferred to final hearing◄, (2) the matter was properly raised by [a] ►the◄ party in [an] ►a timely filed◄ opposition to a motion under §§ 1.633 or 1.634 and the motion was granted over the opposition ►or deferred to final hearing◄, or (3) the party shows good cause why the issue was not [timely] ►properly◄ raised by ►a timely filed◄ motion or opposition. ►A change of attorneys during the interference generally does not constitute good cause. A party who fails to contest, by way of a timely filed preliminary motion under § 1.633(c), the designation of a claim as corresponding to a count may not subsequently argue to an administrative patent judge or the Board the separate patentability or lack of separate patentability of claims designated to correspond to the count.◄

(c) ►In the interest of justice◄ [To prevent manifest injustice], the Board may ►exercise its discretion to◄

consider an issue even though it would not otherwise be entitled to consideration under this section.

52. Section 1.656 is proposed to be amended by revising paragraphs (a), (d), (e), (g), (h) and (i), redesignating paragraphs (b)(1) through (b)(6) as (b)(3) through (b)(8), revising newly designated paragraphs (b)(5) and (b)(6), and adding new paragraphs (b)(1) and (b)(2) to read as follows:

§ 1.656 Briefs for final hearing.

(a) Each party shall be entitled to file briefs for final hearing. The ►administrative patent judge◄ [examiner-in-chief] shall determine the briefs needed and shall set the time and order for filing briefs.

(b) * * *

(1) ►A statement of interest indicating:

(i) The full name of every party represented by the attorney in the interference.

(ii) The name of the real party in interest if the party named in the caption is not the real party in interest.

(2) A statement of related cases indicating:

(i) Whether the interference was previously before the Board for final hearing.

(ii) The name and number of any related appeal or interference which is pending before, or which has been decided by, the Board, or which is pending before, or which has been decided by, the U.S. Court of Appeals for the Federal Circuit or a district court in a proceeding under 35 U.S.C. 146. A related appeal or interference is one which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending interference.

(3)◄ * * *

►(4)◄ [(2)] A statement of the issues presented for decision in the interference.

►(5)◄ [(3)] A statement of the facts ►, preferably in numbered paragraphs,◄ relevant to the issues presented for decision with appropriate references to the record.

►(6)◄ [(4)] An argument, which may be preceded by a summary, which shall contain the contentions of the party with respect to the issues ►it is raising for consideration at final hearing◄ [to be decided], and the reasons therefor, with citations to the cases, statutes, other authorities, and parts of the record relied on.

►(7)◄ [(5)] A short conclusion stating the precise relief requested.

►(8)◄ [(6)] An appendix containing a copy of the counts.

* * * * *

(d) ►Unless ordered otherwise by an administrative patent judge, briefs shall be double-spaced (except for footnotes, which may be single-spaced) and shall comply with the requirements of § 1.653(g) for records except the requirement for binding.◄ [Briefs may be printed or typwritten. If typewritten, legal-size paper may be used. The opening brief of each party in excess of 50 legal-size double-spaced typewritten pages or any other brief in excess of 25 legal-size double spaced typewritten pages shall be printed unless a satisfactory reason be given why the brief should not be printed. Any printed brief shall comply with the requirements of § 1.653(g). Any typewritten brief shall comply with the requirements of § 1.653(h), except legal-size paper may be used and the binding and covers specified are not required.]

(e) An original and ►four◄ [three] copies of each brief must be filed.

* * * * *

(g) Any party, separate from its opening brief, but filed concurrently therewith, may file an original and ►four◄ [three] copies of concise proposed findings of fact and conclusions of law. Any proposed findings of fact shall be ►in numbered paragraphs and◄ supported by specific references to the record. Any proposed conclusions of law shall be ►in numbered paragraphs and◄ supported by citation of cases, statutes, or other authority. Any [opposing party] ►opponent◄, separate from its opening or reply brief, but filed concurrently therewith, may file a paper accepting or objecting to any proposed findings of fact or conclusions of law; when objecting, a reason must be given. The Board may adopt the proposed findings of fact and conclusions of law in whole or in part.

(h) If a party wants the Board in rendering its final decision to rule on the admissibility of any evidence, the party shall file with its opening brief an original and ►four◄ [three] copies of a motion (§ 1.635) to suppress the evidence. The provisions of § 1.637(b) do not apply to a motion to suppress under this paragraph. Any objection previously made to the admissibility of ►the evidence of an opponent◄ [an opponent's evidence] is waived unless the motion required by this paragraph is filed. ►A party that failed to challenge the admissibility of the evidence of an opponent on a ground that could have been raised in a timely objection under § 1.672(c), 1.682(c), 1.683(b) or 1.688(b) may not move under this paragraph to suppress the evidence on that ground at final hearing.◄ An original and ►four◄ [three] copies of an opposition to the motion may be filed with an opponent's opening brief or reply brief as may be appropriate.

(i) When a junior party fails to timely file an opening brief, an order may issue requiring the junior party to show cause why the Board should not treat failure to file the brief as a concession of priority. If the junior party fails to ►show good cause◄ [respond] within a time period set in the order, judgment may be entered against the junior party.

53. Section 1.657 is proposed to be revised to read as follows:

§ 1.657 Burden of proof as to date of invention.

►(a)◄ A rebuttable presumption shall exist that, as to each count, the inventors made their invention in the chronological order of the earlier of their [filing dates or] effective filing dates. The burden of proof shall be upon a party who contends otherwise.

►(b) In an interference involving copending applications or involving a patent and an application having an effective filing date on or before the date the patent issued, a junior party shall have the burden of establishing priority by a preponderance of the evidence.

(c) In an interference involving an application and a patent and where the effective filing date of the application is after the date the patent issued, a junior party shall have the burden of establishing priority by clear and convincing evidence.◄

54. Section 1.658 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.658 Final decision.

(a) After final hearing, the Board shall enter a decision resolving the issues raised at final hearing. The decision may (1) enter judgment, in whole or in part, (2) remand the interference to an ►administrative patent judge◄ [examiner-in-chief] for further proceedings, or (3) take further action not inconsistent with law. A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. When the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision ►for the purpose of judicial review (35 U.S.C. 141–144, 146) unless a request for reconsideration under paragraph (b) of this section is timely filed◄.

(b) Any request for reconsideration of a decision under paragraph (a) of this section shall be filed within one month after the date of the decision. The

request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. Any [reply] ►opposition◄ to a request for reconsideration shall be filed within 14 days of the date of service of the request for reconsideration. [Where reasonably possible, service] ►Service◄ of the request for reconsideration shall be [such that delivery is accomplished] by hand or ["]Express Mail.["] The Board shall enter a decision on the request for reconsideration. If the Board shall be of the opinion that the decision on the request for reconsideration significantly modifies its original decision under paragraph (a) of this section, the Board may designate the decision on the request for reconsideration as a new decision. ►A decision on reconsideration is a final decision for the purpose of judicial review (35 U.S.C. 141–144, 146).◄

* * * * *

55. Section 1.660 is proposed to be amended by adding paragraph (e) to read as follows:

§ 1.660 Notice of reexamination, reissue, protest or litigation.

* * * * *

►(e) The notice required by this section is designed to assist the administrative patent judge and the Board in efficiently handling interference cases. Failure of a party to comply with the provisions of this section may result in sanctions under § 1.616. Knowledge by, or notice to, an employee of the Office other than an employee of the Board, of the existence of the re-examination, application for reissue, protest, or litigation shall not be sufficient. The notice contemplated by this section is noticed addressed specifically to an administrative patent judge or the Board.◄

56. Section 1.662 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.662 Request for entry of adverse judgment; re-issue filed by patentee.

(a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. The filing by ►a party◄ [an applicant or patentee] of a written disclaimer of the invention defined by a court, concession of priority or unpatentability of the subject matter of a count, abandonment of the invention defined by a count, or abandonment of the contest as to a count will be treated as a request for entry of an adverse judgment against the applicant or patentee as to all claims which correspond to the count. Abandonment of an application [by an applicant], other than an [applicant] ►application◄ for re-issue having a claim of the patent sought to be reissued involved in the interference, will be treated as a request for entry of an adverse judgment against the applicant as to all claims corresponding to all counts. Upon the filing by a party of a request for entry of an adverse judgment, the Board may enter judgment against the party.

(b) If a patentee involved in an interference files an application for reissue during the interference and ►the reissue application does not include a claim that corresponds to a count◄ [omits all claims of the patent corresponding to the counts of the interference for the purpose of avoiding the interference], judgment may be entered against the patentee. A patentee who files an application for re-issue ► which includes a claim that corresponds to a count◄ [other than for the purpose of avoiding the interference] shall ►, in addition to complying with the provisions of § 1.660(b),◄ timely file a preliminary motion under § 1.663(h) or show good cause why the motion could not have been timely filed or would not be appropriate.

* * * * *

57. Section 1.664 is proposed to be amended by revising paragraphs (a) and (b) to read as follows:

§ 1.664 Action after interference.

(a) After termination of an interference, the examiner will promptly take such action in any application previously involved in the interference as may be necessary. Unless entered by order of an ►administrative patent judge◄ [examiner-in-chief], amendments presented during the interference shall not be entered, but may be subsequently presented by the applicant subject to the provisions of this subpart provided prosecution of the application is not otherwise closed.

(b) After judgment, the application of any party may be held subject to further examination, including an interference with another application.

58. Section 1.671 is proposed to be amended by revising paragraphs (a), (c)(1), (c)(2), (c)(6), (c)(7), (f) and (g) to read as follows, deleting paragraph (e) and redesignating it as "Reserved", redesignating current paragraph (h) as (i), and adding new paragraphs (h) and (j) to read as follows:

§ 1.671 Evidence must comply with rules.

(a) Evidence consists of testimony and exhibits, official records and publications filed under § 1.682, [evidence] ►testimony◄ from another interference, proceeding, or action filed under § 1.683, and discovery relied upon under § 1.688, and the specification (including claims) and drawings of any application or patent:

* * * * *

(c) * * *

(1) *Courts of the United States, U.S. Magistrate, court, trial court,* or *trier of fact* means ►administrative patent judge◄ [examiner-in-chief] or Board as may be appropriate.

(2) *Judge* means ►administrative patent judge◄ [examiner-in-chief].

* * * * *

(6) *Before the hearing* in Rule 703 means before giving testimony by ►affidavit or◄ oral deposition [or affidavit].

(7) *The trial or hearing* in Rules 803(24) and 804(5) means the taking of testimony by ►affidavit or◄ oral deposition [or affidavit].

* * * * *

(e) ►Reserved.◄ [A party may not rely on an affidavit filed by that party during *ex parte* prosecution of an application, an affidavit under § 1.608, or an affidavit under § 1.639(b) unless: (1) A copy of the affidavit is or has been served and (2) a written notice is filed prior to the close of the party's relevant testimony period stating that the party intends to rely on the affidavit. When proper notice is given under this paragraph, the affidavit shall be deemed filed under § 1.672(b). A copy of the affidavit shall be included in the record (§ 1.653).]

(f) The significance of documentary and other exhibits ►identified by a witness in an affidavit or during oral deposition◄ shall be discussed with particularity by [a] ►the◄ witness [during oral deposition or in an affidavit].

(g) A party must file a motion (§ 1.635) seeking permission from an ►administrative patent judge◄ [examiner-in-chief] prior to ►compelling◄ [taking] testimony or ►production of◄ [seeking] documents or things under 35 U.S.C. 24 ►or from a party◄. The motion shall describe the general nature and the relevance of the testimony, document, or thing. ►If permission is granted, the party shall notice a deposition under § 1.673 and may proceed to take testimony. The testimony of the witness shall be taken on oral deposition.◄

►(h) A party must file a motion (§ 1.635) seeking permission from an administrative patent judge prior to compelling testimony or production of documents or things in a foreign country.

(1) In the case of testimony, the motion shall:

(i) Describe the general nature and relevance of the testimony;

(ii) Identify the witness by name or title;

(iii) State why the party believes the witness can be compelled to testify in the foreign country; and

(iv) Demonstrate that the witness has been asked to testify in the United States and has refused to do so even though the party has offered to pay the expenses of the witness to travel to the United States.

(2) In the case of production of a document or thing, the motion shall:

(i) Describe the general nature and relevance of the document or thing;

(ii) State why the party believes production of the document or thing can be compelled in the foreign country; and

(iii) Demonstrate that the individual or entity having possession, custody, and control of the document or thing will not produce the document or thing in the United States even though the party has offered to pay the expenses of producing the document or thing in the United States.◄

►(i)◄ [(h)] Evidence which is not taken or sought and filed in accordance with this subpart shall not be admissible.

►(j) The weight to be given testimony taken in a foreign country will be determined on a case-by-case basis. Little, if any, weight may be given to testimony taken in a foreign country unless the party taking the testimony proves by clear and convincing evidence (1) that giving false testimony in an interference proceeding is punishable as perjury under the laws of the foreign country where the testimony is taken and (2) that the punishment in a foreign country for giving such false testimony is similar to the punishment for perjury committed in the United States.◄

59. Section 1.672 is proposed to be amended by revising paragraphs (a), (b), (c) and (d), redesignating paragraphs (c), (d), (e) and (f) as paragraphs (e), (f), (g) and (h), respectively, and by adding new paragraphs (c) and (d) to read as follows:

§ 1.672 Manner of taking testimony.

(a) ►Unless testimony must be compelled under 35 U.S.C. 24 or compelled from a party or in a foreign country, testimony◄ [Testimony] of a witness ►shall◄ [may] be taken by [oral deposition or] affidavit in accordance with this subpart. ►Testimony which must be compelled under 35 U.S.C. 24 or compelled from a party or in a foreign country shall be taken by oral deposition.◄

(b) [A party wishing to take the testimony of a witness whose testimony will not be compelled under 35 U.S.C. 24 may elect to present the testimony of the witness by affidavit or deposition.] A party [electing to present] ►presenting◄ testimony of a witness by affidavit shall, prior to the [close of the party's relevant testimony period, file and serve] ►time set by the administrative patent judge for serving affidavits, file a copy of the◄ [an] affidavit [of the witness or, where appropriate, a notice under § 1.671(e). To facilitate preparation of the record (§ 1.653 (g) and (h)), a party should file an affidavit on paper which is 8½ by 11 inches (21.8 by 27.9 cm)]. ►If the affidavit relates to a party's case-in-chief, it shall be filed no later than the date set by an administrative patent judge for the party to file affidavits for its case-in-chief. If the affidavit relates to a party's case-in-rebuttal, it shall be filed no later than the date set by an administrative patent judge for the party to file affidavits for its case-in-rebuttal.◄ A party shall not be entitled to rely on any document referred to in the affidavit unless a copy of the document is filed with the affidavit. A party shall not be entitled to rely on any thing mentioned in the affidavit unless the opponent is given reasonable access to the thing. A thing is something other than a document. ►The pages of affidavits filed under this paragraph and of any other testimony filed therewith under §§ 1.683(a) and 1.688(a) shall be given sequential numbers which shall also serve as the record page numbers for the affidavits and other testimony in the party's record to be filed under § 1.653. Exhibits identified in the affidavits or in any other testimony filed under §§ 1.683(a) and 1.688(a) and any official records and printed publications filed under § 1.682(a) shall be given sequential exhibit numbers which shall also serve as the exhibit numbers when the exhibits are filed with the party's record. The affidavits, testimony filed under §§ 1.683(a) and 1.688(a) exhibits shall be accompanied by an index of the names of the witnesses, giving the number of the page where the testimony of each witness begins, and by an index of the exhibits briefly describing the nature of each exhibit and giving the number of the page where each exhibit is first identified and offered into evidence.

(c) If an opponent objects to the admissibility of any evidence contained, in or submitted with an affidavit filed under paragraph (b) of this section, the opponent must, no later than the date set by the administrative patent judge for filing objections under this paragraph, file objections stating with particularity the nature of each objection. An opponent that fails to challenge the admissibility of the evidence contained in or submitted with an affidavit on a ground that could have been raised in a timely objection under this paragraph will not be entitled to move under § 1.656(h) to suppress the evidence on that ground. If an opponent timely files objections, the party may, within 20 days of the due date for filing objections, file supplemental affidavits and supplemental official records and printed publications to overcome the objections. No objection to the admissibility of the supplemental evidence shall be made, except as provided by § 1.656(h). The pages of supplemental affidavits filed under this paragraph shall be sequentially numbered beginning with the number following the last page number of the party's testimony submitted under paragraph (b) of this section. The page numbers assigned to the supplemental affidavits shall also serve as the record page numbers for the supplemental affidavits in the party's record filed under § 1.653. Additional exhibits identified in supplemental affidavits and any supplemental official records and printed publications shall be given sequential numbers beginning with the number following the last number of the exhibits submitted under paragraph (b) of this section. The exhibit numbers shall also serve as the exhibit numbers when the exhibits are filed with the party's record. The supplemental affidavits shall be accompanied by an index of the names of the witnesses and an index of exhibits of the type specified in paragraph (b) of this section.

(d)◄ After the ►time expires for filing objections and supplemental affidavits, or earlier when appropriate,◄ [affidavit is filed and within a time set by an examiner-in-chief,] ►the administrative patent judge shall set a time within which◄ any opponent may file a request to cross-examine [the witness] ►an affiant◄ on oral deposition. If any opponent requests cross-examination of an affiant, the party shall notice a deposition ►at a reasonable location within the United States◄ under § 1.673(e) for the purpose of cross-examination by any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness [whose testimony is presented by affidavit], the party shall not be entitled to rely on any document or

thing not mentioned in one or more of the affidavits filed under [this paragraph] ►paragraphs (b) and (c) of this section◄, except to the extent necessary to conduct proper redirect. [A party electing to present testimony of a witness by deposition shall notice a deposition of the witness under § 1.673(a).] The party who gives notice of a deposition shall be responsible ►for providing a translator if the witness does not testify in English,◄ for obtaining a court reported and for filing a certified transcript of the deposition as required by § 1.676. ►Within 45 days of the close of the period for taking cross-examination, the party shall serve (but not file) a copy of each transcript on each opponent together with copies of any additional documentary exhibits identified by the witness during the deposition. The pages of the transcripts served under this paragraph shall be sequentially numbered beginning with the number following the last page number of the party's supplemental affidavits submitted under paragraph (c) of this section. The numbers assigned to the transcript pages shall also serve as the record page numbers for the transcripts in the party's record fled under § 1.653. Additional exhibits identified in the transcripts shall be given sequential numbers beginning with the number following the last number of the exhibits submitted under paragraphs (b) and (c) of this section. The exhibit numbers assigned to the additional exhibits shall also serve as the exhibit numbers when those exhibits are filed with the party's record. The deposition transcripts shall be accompanied by an index of the names of the witnesses, giving the number of the page where cross-examination, redirect and recross of each witness begins, and an index of exhibits of the type specified in paragraph (b) of this section.

(e) Reserved.◄ [(c) A party wishing to take the testimony of a witness whose testimony will be compelled under 35 U.S.C. 24 must first obtain permission from an examiner-in-chief under § 1.671(g). If permission is granted, the party shall notice a deposition of the witness under § 1.673 and may proceed under 35 U.S.C. 24. The testimony of the witness shall be taken on oral deposition.]

►(f)◄ [(d)] ►When a deposition is authorized under◄ [Notwithstanding the provisions of] this subpart, if the parties agree in writing, ►the◄ [a] deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions.

►(g)◄ [(e)] If the parties agree in writing, the testimony of any witness may be submitted in the form of an affidavit without opportunity for cross-examination. The affidavit of the witness shall be filed in the Patent and Trademark Office.

►(h)◄ [(f)] If the parties agree in writing, testimony may be submitted in the form of an agreed statement setting forth: (1) How a particular witness would testify if called or (2) the facts in the case of one or more of the parties. The agreed statement shall be filed in the Patent and Trademark Office. See § 1.653(a).

60. Section 1.673 is proposed to be amended by revising paragraphs (a), (b), (c), (c)(2), (d), (e) and (g) to read as follows:

§ 1.673 Notice of examination of witness ►when deposition testimony is authorized◄.

(a) A party [electing] ►authorized◄ to take testimony of a witness by deposition shall, after complying with paragraphs (b) and (g) of this section, file and serve a single notice of deposition stating the time and place of each deposition to be taken. Depositions ►to be taken in the United States◄ may be noticed for a reasonable time and place in the United States. [Unless the parties agree in writing, a] ►A◄ deposition may not be noticed for any other place without approval of an ►administrative patent judge◄ [examiner-in-chief (see § 1.684)]. The notice shall specify the name and address of each witness and the general nature of the testimony to be given by the witness. If the name of a witness is not known, a general description sufficient to identify the witness or a particular class or group to which the witness belongs may be given instead.

(b) Unless the parties agree ►or an administrative patent judge or the Board determine◄ otherwise, a party shall serve, but not file, at least three ►working◄ days prior to the conference required by paragraph (g) of this section, if service is made by hand or ["]Express Mail,["] or at least ►14◄ [ten] days prior to the conference if service is made by any other means, the following:

* * * * *

(c) A party shall not be permitted to rely [at any deposition] on any witness not listed in the notice, or any document not served or any thing not listed as required by paragraph (b) of this section:

(1) * * *

(2) except upon a motion (§ 1.635) promptly filed which is accompanied by any proposed notice, additional documents, or lists and which shows [sufficient] ►good◄ cause why the notice, documents, or lists were nit served in accordance with this section.

(d) Each [opposing party] ►opponent◄ shall have a full opportunity to attend a deposition and cross-examine. [If an opposing party attends a deposition of a witness not named in a notice and cross-examines the witness or fails to object to the taking of the deposition, the opposing party shall be deemed to have waived any right to object to the taking of the deposition for lack of proper notice.]

(e) A party ►who has presented◄ [electing to present] testimony by affidavit and [who] is required to notice depositions for the purpose of cross-examination under § 1.672(b), shall, after complying with paragraph (g) of this section, file and serve a single notice of depsotion stating the time and place of each cross-examination deposition to be taken.

* * * * *

(g) Before serving a notice of deposition and after complying with paragraph (b) of this section, a party shall have an oral conference with all opponents to attempt to agree on a mutually acceptable time and place for conducting the deposition. A certificate shall appear in the notice stating that the oral conference took place or explaining why the conference could not be had. If the parties cannot agree to a mutually acceptable place and time for conducting the deposition at the conference, the parties shall contact an ►administrative patent judge◄ [examiner-in-chief] who shall then designate the time and place for conducting the deposition.

* * * * *

61. Section 1.674 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.674 Persons before whom depositions may be taken.

(a) ►A◄ [Within the United States or a territory or insular possession of the United States a] deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held.

* * * * *

62. Section 1.675 is proposed to be amended by revising paragraph (d) to read as follows:

§ 1.675 Examination of witness, reading and signing transcript of deposition.

* * * * *

(d) Unless the parties agree in writing or waive reading and signature by the witness on the record at the depsotion,

when the testimony has been transcribed a transcript of the deposition shall ►, unless the witness refuses to read and/or sign the transcript of the depsotion,◄ be read by the witness and then signed by the witness in the form of: (1) An affidavit in the presence of any notary or (2) a declaration.

63. Section 1.676 is proposed to be amended by revising paragraph (a)(4) to read as follows:

§ 1.676 Certification and filing by officer, marking exhibits.

(a) * * *

(4) The presence or absence of any [opposing party] ►opponent◄.

* * * * *

64. Section 1.677 is proposed to be amended by revising the section heading and paragraph (a) to read as follows:

§ 1.677 Form of ►affidavit or◄ a transcript of deposition.

(a) ►An affidavit or a◄ [A] transcript of a deposition must be [typewritten] on opaque, unglazed, durable paper approximately ►21.8 by 27.9 cm. (8½ by 11 inches)◄ [8½ by 11 inches (21.8 by 27.9 cm.)] in size (letter size). [Typing] ►The printed matter◄ shall be double-spaced on one side of the paper in not smaller than ►11 point type◄ [pica-type] with a margin of ►3.8 cm. (1½ inches)◄ [1½ inches (3.8 cm.)] on the left-hand side of the page. The pages must be consecutively numbered throughout the entire record of each party (§ 1.653(d)) and the name of the witness [must be typed] ►shall appear◄ at the top of the each page (§ 1.653(e)). ►In transcripts of depositions, the◄ [The] questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used and each question must be followed by its answer.

* * * * *

65. Section 1.678 and the section heading are proposed to be revised to read as follows:

§ 1.678 ►Time for filing transcript◄ βTranscriptα of deposition βmust be filedα.

Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], a certified transcript of a deposition must be filed in the Patent and Trademark Office within [45] ►30◄ days from the date of deposition. If a party refuses to file a certified transcript, the ►administrative patent judge◄ [examiner-in-chief] or the Board may take appropriate action must § 1.616. If a party refuses to file a certified transcript, any opponent may move for leave to file the certified transcript and include a copy of the transcript as part of the opponent's record.

66. Section 1.679 is proposed to be revised to read as follows:

§ 1.679 Inspection of transcript.

A certified transcript ►of a desposition◄ filed in the Patent and Trademark Office may be inspected by any party. The certified transcript may not be removed from the Patent and Trademark Office [for printing (§ 1.653(g)(1)] unless authorized by an ►administrative patent judge◄ [examiner-in-chief] upon such terms as may be appropriate.

67. Section 1.682 is proposed to be amended by deleting paragraphs (a)(4) and (b) and redesignating them as "Reserved," revising paragraphs (a), (a)(2), (a)(3), and (c) and adding a new paragraph (d) to read as follows:

§ 1.682 Official records and printed publications.

(a) A party may introduce into evidence, if otherwise admissible, [any] ►an◄ official record or printed publication not identified ►in an affidavit or◄ on the record during ►an oral deposition◄ [the taking of testimony] of a witness, by filing [a notice offering] ►a copy of◄ the official record or ►printed◄ publication [into evidence]. If the ►official record or printed publication◄ [evidence] relates to the party's case-in-chief, ►it shall be filed together with any affidavits filed by the party under § 1.672(b) for its case-in-chief or, if the party does not serve any affidavits under § 1.672(b) for its case-in-chief, no later than the date set by an administrative patent judge for the party to file affidavits under § 1.672(b) for its◄ [the notice shall be filed prior to close of testimony of the party's] case-in-chief. If the ►official record or printed publication◄ [evidence] relates to rebuttal, ►it shall be filed together with any affidavits filed by the party under § 1.672(b) for its case-in-rebuttal or, if the party does not file any affidavits under § 1.672(b) for its case-in-rebuttal, no later than the date set by an administrative patent judge for the party to file affidavits under § 1.672(b) for its◄ [the notice shall be filed prior to close of testimony of the party's] case-in-rebuttal. [The notice] ►Official records and printed publications filed under this paragraph shall be assigned sequential exhibits numbers by the party in the manner set forth in § 1.672(b). The official record and printed publications shall be accompanied by a paper which◄ shall:

(1) * * *

(2) ►Identify◄ [identify] the portion thereof to be introduced in evidence, ►and◄

(3) ►Indicate◄ [indicate] generally the relevance of the portion sought to be introduced in evidence ►.◄ [, and]

(4) ►Reserved.◄ [where appropriate, be accompanied by a certified copy of the official record or a copy of the printed publication (§ 1.671(d)).]

(b) ►Reserved.◄ [A copy of the notice, official record, and publication shall be served.]

(c) Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], any written objection ►by an opponent◄ to the [notice] ►paper◄ or to the admissibility of the official record or printed publication shall be filed [within 15 days of service of the notice] ►no later than the date set by the administrative patent judge for the opponent to file objections under § 1.672(c) to affidavits submitted by the party under § 1.672(b). An opponent who fails to challenge the admissibility of the official record or printed publication on a ground that could have been raised in a timely objection under this paragraph will not be entitled to move under § 1.656(h) to suppress the evidence on that ground. If an opponent timely files an objection, the party may respond by filing supplemental affidavits and supplemental official records and printed publications, which must be filed together with any supplemental evidence filed by the party under § 1.672(c) or, if the party does not file any supplemental evidence under § 1.672(c), no later than the date set by an administrative patent judge for the party to file supplemental affidavits under § 1.672(c). No objection to the admissibility of the supplemental evidence shall be made, except as provided by◄◄ [See also] § 1.656(h). ►The pages of supplemental affidavits and the exhibits filed under this section shall be sequentially numbered by the party in the manner set forth in § 1.672(c). The supplemental affidavits and exhibits shall be accompanied by an index of witnesses and an index of exhibits of the type required by § 1.672(b).

(d) Any request by an opponent to cross-examine on oral deposition the affiant of a supplemental affidavit submitted under paragraph (c) of this section shall be filed no later than the date set by the administrative patent judge for the opponent to file a request to cross-examine an affiant with respect to an affidavit served by the party under § 1.672 (b) or (c). If any opponent

requests cross-examination of an affiant, the party shall file notice of a deposition for a reasonable location within the United States under § 1.673(e) for the purpose of cross-examination by any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness, the party shall not be entitled to rely on any document or thing not mentioned in one or more of the affidavits filed under this paragraph, except to the extent necessary to conduct proper redirect. The party who gives notice of a deposition shall be responsible for providing a translator if the witness does not testify in English, for obtaining a court reporter and for filing a certified transcript of the deposition as required by § 1.676. Within 45 days of the close of the period for taking cross-examination, the party shall serve (but not file) a copy of each deposition transcript on each opponent together with copies of any additional documentary exhibits identified by the witness during the deposition. The pages of deposition transcripts and exhibits served under this paragraph shall be sequentially numbered by the party in the manner set forth in § 1.672(d). The deposition transcripts shall be accompanied by an index of the names of the witnesses, giving the number of the page where cross-examination, redirect and recross of each witness begins, and an index of exhibits of the type specified in § 1.672(b).◄

68. Section 1.683 is proposed to be amended by revising paragraphs (a) and (b) and adding a new paragraph (c) to read as follows:

§ 1.683 Testimony in another interference, proceeding, or action.

(a) ►A party may introduce into evidence, if otherwise admissible,◄ [Prior to close of a party's appropriate testimony period or within such time as may be set by an examiner-in-chief, a party may file a motion (§ 1.635) for leave to use in an interference] testimony ►by affidavit or oral deposition◄ [of a witness] from another interference, proceeding, or action involving the same parties [, subject to such conditions as may be deemed appropriate by an examiner-in-chief.] ►by filing a copy of the affidavit or a copy of the transcript of the oral deposition. If the testimony relates to the party's case-in-chief, it shall be filed together with any affidavits served by the party under § 1.672(b) for its case-in-chief or, if the party does not file any affidavits under § 1.672(b) for its case-in-chief, no later than the date set by an administrative patent judge for the party to file affidavits under § 1.672(b) for its case-in-chief. If the testimony relates to rebuttal, it shall be filed together with any affidavits served by the party under § 1.672(b) for its case-in-rebuttal or, if the party does not file any affidavits under § 1.672(b) for its case-in-rebuttal, no later than the date set by an administrative patent judge for the party to file affidavits under § 1.672(b) for its case-in-rebuttal. Pages of affidavits and deposition transcripts served under this paragraph and any new exhibits served therewith shall be assigned sequential numbers by the party in the manner set forth in § 1.672(b).◄ The [motion] ►testimony shall be accompanied by a paper which specifies◄ [shall specify] with particularity the exact testimony to be used and ►demonstrates◄ [shall demonstrate] its relevance.

(b) [Any objection to the admissibility of the testimony of the witness shall be made in an opposition to the motion. See also] ►Unless otherwise ordered by an administrative patent judge, any written objection by an opponent to the paper or the admissibility of the testimony filed under this section shall be filed no later than the date set by the administrative patent judge for the opponent to file any objections under § 1.672(c) to affidavits submitted by the party under § 1.672(b). An opponent who fails to challenge the admissibility of the testimony on a ground that could have been raised in a timely objection under this paragraph will not be entitled to move under § 1.656(h) to suppress the evidence on that ground. If an opponent timely files an objection, the party may respond with a supplemental affidavit and supplemental official records and printed publications, which must be filed together with any supplemental evidence filed by the party under § 1.672(c) or, if the party does not file any supplemental evidence under § 1.672(c), no later than the date set by an administrative patent judge for the party to file supplemental evidence under § 1.672(c). No objection to the admissibility of the evidence contained in or submitted with a supplemental affidavit shall be made, except as provided by◄ § 1.656(h). ►The pages of supplemental affidavits and the exhibits filed under this section shall be sequentially numbered by the party in the manner set forth in § 1.672(c). The supplemental affidavits and exhibits shall be accompanied by an index of witnesses and an index of exhibits of the type required by § 1.672(b).

(c) Any request by an opponent to cross-examine on oral deposition the affiant of an affidavit or supplemental affidavit submitted under paragraph (a) or (b) of this section shall be filed no later than the date set by the administrative patent judge for the opponent to file a request to cross-examine an affiant with respect to an affidavit filed by the party under § 1.672 (b) or (c). If any opponent requests cross-examination of an affiant, the party shall file a notice of deposition for a reasonable location within the United States under § 1.673(e) for the purpose of cross-examination by any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness, the party shall not be entitled to rely on any document or thing not mentioned in one or more of the affidavits filed under this paragraph, except to the extent necessary to conduct proper redirect. The party who gives notice of a deposition shall be responsible for providing a translator if the witness does not testify in English, for obtaining a court reporter and for filing a certified transcript of the deposition as required by § 1.676. Within 45 days of the close of the period for taking cross-examination, the party shall serve (but not file) a copy of each deposition transcript on each opponent together with copies of any additional documentary exhibits identified by the witness during the deposition. The pages of deposition transcripts and exhibits served under this paragraph shall be sequentially numbered by the party in the manner set forth in § 1.672(d). The deposition transcripts shall be accompanied by an index of the names of the witnesses, giving the number of the page where cross-examination, redirect and recross of each witness begins, and an index of exhibits of the type specified in § 1.672(b).◄

69. Section 1.684 is proposed to be deleted and redesignated as "Reserved," as follows:

§ 1.684 ►Reserved.◄ [Testimony in a foreign country]

(a) An examiner-in-chief may authorize testimony of a witness to be taken in a foreign country. A party seeking to take testimony in a foreign country shall, promptly after the testimony period is set, file a motion (§ 1.635):

(1) Naming the witness.

(2) Describing the particular facts to which it is expected that the witness will testify.

(3) Stating the grounds on which the moving party believes that the witness will testify.

(4) Demonstrating that the expected testimony is relevant.

(5) Demonstrating that the testimony cannot be taken in this country at all or cannot be taken in this country without hardship to the moving party greatly exceeding the hardship to which all opposing parties will be exposed by the taking of the testimony in a foreign country.

(6) Accompanied by an affidavit stating that the motion is made in good faith and not for the purpose of delay or harassing any party.

(7) Accompanied by written interrogatories to be asked of the witness.

(b) Any opposition under § 1.638(a) shall state any objection to the written interrogatories and shall include any cross-interrogatories to be asked of the witness. A reply under § 1.638(b) may be filed and shall be limited to stating any objection to any cross-interrogatories proposed in the opposition.

(c) If the motion is granted, taking of the testimony abroad must be completed within the testimony period set under § 1.651 or within such time as may be set by the Examiner-in-Chief. The moving party shall be responsible for obtaining answers to the interrogatories and cross-interrogatories before an officer qualified to administer oaths in the foreign country under the laws of the United States or the foreign country. The officer shall prepare a transcript of the interrogatories, cross-interrogatories, and recorded answers to the interrogatories and cross-interrogatories and shall transmit the transcript to Box Interference, Commissioner of Patents and Trademarks, Washington, D.C. 20231, with a certificate signed and sealed by the officer and showing:

(1) The witness was duly sworn by the officer before answering the interrogatories and cross-interrogatories.

(2) The recorded answers are a true record of the answers given by the witness to the interrogatories and cross-interrogatories.

(3) The name of the person by whom the answers were recorded and, if not recorded by the officer, whether the answers were recorded in the presence of the officer.

(4) The presence or absence of any party.

(5) The place, day, and hour that the answers were recorded.

(6) A copy of the recorded answers was read by or to the witness before the witness signed the recorded answers and that the witness signed the recorded answers in the presence of the officer. The officer shall state the circumstances under which a witness refuses to read or sign recorded answers.

(7) The officer is not disqualified under § 1.674.

(d) If the parties agree in writing, the testimony may be taken before the officer on oral deposition.

(e) A party taking testimony in a foreign country shall have the burden of proving that false swearing in the giving of testimony is punishable as perjury under the laws of the foreign country. Unless false swearing in the giving of testimony before the officer shall be punishable as perjury under the laws of the foreign country where testimony is taken, the testimony shall not be entitled to the same weight as testimony taken in the United States. The weight of the testimony shall be determined in each case.]

70. Section 1.685 is proposed to be amended by revising paragraphs (d) and (e) to read as follows:

§ 1.685 Errors and irregularities in depositions.

* * * * *

(d) An objection to the ►deposition on any grounds, such as the◄ competency of a witness, admissibility of evidence, manner of taking the deposition, the form of questions and answers, any oath or affirmation, or conduct of any party at the deposition ►,◄ is waived unless an objection is made on the record at the deposition stating the specific ground of objection. Any objection which a party wishes considered by the Board at final hearing shall be included in a motion to suppress under § 1.656(h).

(e) Nothing in this section precludes taking notice of plain errors affecting substantial rights although they were not brought to the attention of an ►administrative patent judge◄ [examiner-in-chief] or the Board.

71. Section 1.687 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.687 Additional discovery.

* * * * *

(c) Upon a motion (§ 1.635) brought by a party within the time set by an ►administrative patent judge◄ [examiner-in-chief] under § 1.651 or thereafter as authorized by § 1.645 and upon a showing that the interest of justice so requires, an ►administrative patent judge◄ [examiner-in-chief] may order additional discovery, as to matters under the control of a party within the scope of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery. ►See § 1.647 concerning translations of documents in a foreign language.◄

* * * * *

72. Section 1.688 is proposed to be amended by revising paragraphs (a) and (b) and adding a new paragraph (c) to read as follows:

§ 1.688 Use of discovery.

(a) If otherwise admissible a party may introduce into evidence, an answer to a written request for an admission or an answer to a written interrogatory obtained by discovery under § 1.687 by filing a copy of the request for admission or the written interrogatory and the answer. If the answer relates to a party's case-in-chief, the answer shall be [filed prior to the close of testimony of the party's] ►served together with any affidavits served by the party under § 1.672(b) for its case-in-chief or, if the party does not serve any affidavits under § 1.672(b) for its case-in-chief, no later than the date set by an administrative patent judge for the party to serve affidavits under § 1.672(b) for its◄ case-in-chief. If the answer relates to the party's rebuttal, the [admission or] answer shall be [filed prior to the close of testimony of the party's] ►served together with any affidavits served by the party under § 1.672(b) for the its case-in-rebuttal or, if the party does not serve any affidavits under § 1.672(b) for its case-in-rebuttal, no later than the date set by an administrative patent judge for the party to serve affidavits under § 1.672(b) for its◄ case-in-rebuttal.

►(b)◄ Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], any written objection to the admissibility of an answer shall be filed [within 15 days of service of the answer.] ►no later than the date set by the administrative patent judge for the opponent to file any objections under § 1.672(c) to affidavits submitted by the party under § 1.672(b). An opponent who fails to challenge the admissibility of an answer on a ground that could have been raised in a timely objection under this paragraph will not be entitled to move under § 1.656(h) to suppress the evidence on that ground. If an opponent timely files an objection, the party may respond with supplemental affidavits, which must be filed together with any supplemental evidence filed by the party under § 1.672(c) or, if the party does not file any supplemental evidence under § 1.672(c), no later than the date set by an administrative patent judge for the party to file supplemental affidavits under § 1.672(c). No objection to the admissibility of the evidence contained in or submitted with a supplemental affidavit shall be made, except as provided by◄ § 1.656(h). ►The pages of supplemental affidavits and the

exhibits filed under this section shall be sequentially numbered by the party in the manner set forth in § 1.672(c). The supplemental affidavits and exhibits shall be accompanied by an index of witnesses and an index of exhibits of the type required by § 1.672(b).

(c) Any request by an opponent to cross-examine on oral deposition the affiant of a supplemental affidavit submitted under paragraph (b) of this section shall be filed no later than the date set by the administrative patent judge for the opponent to file a request to cross-examine an affiant with respect to an affidavit filed by the party under § 1.672(b) or (c). If any opponent requests cross-examination of an affiant, the party shall file a notice of deposition for a reasonable location within the United States under § 1.673(e) for the purpose of cross-examination by any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness, the party shall not be entitled to rely on any document or thing not mentioned in one or more of the affidavits filed under this paragraph, except to the extent necessary to conduct proper redirect. The party who gives notice of a deposition shall be responsible for providing a translator if the witness does not testify in English, for obtaining a court reporter and for filing a certified transcript of the deposition as required by § 1.676. Within 45 days of the close of the period for taking cross-examination, the party shall serve (but not file) a copy of each deposition transcript on each opponent together with copies of any additional documentary exhibits identified by the witness during the deposition. The pages of deposition transcripts and exhibits served under this paragraph shall be sequentially numbered by the party in the manner set forth in § 1.672(d). The deposition transcripts shall be accompanied by an index of the names of the witnesses, giving the number of the page where cross-examination, redirect and recross of each witness begins, and an index of exhibits of the type specified in § 1.672(b).◄

[(b)] ►(d)◄ A party may not rely upon any other matter obtained by discovery unless it is introduced into evidence under this subpart.

73. Section 1.690 is proposed to be amended by revising paragraphs (a), (b) and (c) to read as follows:

§ 1.690 Arbitration of Interferences.

(a) Parties to a patent interference may determine the interference or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of Title 9, United States Code. The parties must notify the Board in writing of their intention to arbitrate. An agreement to arbitrate must be in writing, specify the issues to be arbitrated, the name of the arbitrator or a date not more than thirty (30) days after the execution of the agreement for the selection of the arbitrator, and provide that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board. A copy of the agreement must be filed within twenty (20) days after its execution. The parties shall be solely responsible for the selection of the arbitrator and the rules for conducting proceedings before the arbitrator. Issues not disposed of by the arbitration will be resolved in accordance with the procedures established in 37 CFR, Subpart E of Part 1, as determined by the ►administrative patent judge◄ [examiner-in-chief].

(b) An arbitration proceeding under this section shall be conducted within such time as may be authorized on a case-by-case basis by an ►administrative patent judge◄ [examiner-in-chief].

(c) An arbitration award will be given no consideration unless it is binding on the parties, is in writing and states in a clear and definite manner (1) the issue or issues arbitrated and (2) the disposition of each issue. The award may include a statement of the grounds and reasoning in support thereof. Unless otherwise ordered by an ►administrative patent judge◄ [examiner-in-chief], the parties shall give notice to the Board of an arbitration award by filing within twenty (20) days from the date of the award a copy of the award signed by the arbitrator or arbitrators. When an award is timely filed, the award shall, as to the parties to the arbitration, be dispositive of the issue or issues to which it relates.

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Dated: September 23, 1994.

Bruce A. Lehman,

Assistant Secretary of Commerce, and Commissioner of Patents and Trademarks.

[FR Doc. 94-24203 Filed 9-30-94; 8:45 am]

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ENVIRONMENTAL PROTECTION AGENCY

40 CFR Part 52

[MA-29-01-6537; A-1-FRL-5083-5]

Approval and Promulgation of Air Quality Implementation Plans; Massachusetts; Amendment to Massachusetts' SIP (for Ozone and for Carbon Monoxide) for Establishment of a South Boston Parking Freeze

AGENCY: Environmental Protection Agency (EPA).

ACTION: Proposed rule.

SUMMARY: EPA is proposing to approve a State Implementation Plan (SIP) amendment submitted by the Commonwealth of Massachusetts. The intent of the SIP amendment is to effect a decrease in vehicle miles travelled (VMT) and motor vehicle emissions by controlling the growth of parking spaces in the South Boston neighborhood of Boston and holding automobile usage to levels within the practical capacity of the local street network. Vehicular emissions of carbon monoxide, hydrocarbons and nitrogen oxides will be reduced compared with their expected levels if parking is not constrained. These pollutants contribute to the carbon monoxide and ozone air pollution problems in the Boston urbanized area. This SIP revision adds the South Boston Parking Freeze Area to ongoing parking management plans in the Metropolitan Boston Area. The intended effect of this action is to propose approval of the changes to Massachusetts' SIP. This action is being taken under section 110 of the Clean Air Act.

DATES: Comments must be received on or before November 2, 1994.

ADDRESSES: Comments may be mailed to Linda M. Murphy, Director, Air, Pesticides and Toxics Management Division, U.S. Environmental Protection Agency, Region I, JFK Federal Bldg., Boston, MA 02203. Copies of the State submittal and EPA's technical support document are available for public inspection during normal business hours, by appointment at the Air, Pesticides and Toxics Management Division, U.S. Environmental Protection Agency, Region I, One Congress Street, 10th floor, Boston, MA and Division of Air Quality Control, Department of Environmental Protection, One Winter Street, 8th floor, Boston, MA 02108.

FOR FURTHER INFORMATION CONTACT: Donald O. Cooke, (617) 565-3227.

SUPPLEMENTARY INFORMATION: On July 30, 1993, the Massachusetts Department