

circumstance. Parties should note that disagreement with a holding is not an appropriate basis for challenging a special circumstance determination. Moreover, a party not entitled to confidentiality under section 122(a) would not have the standing to challenge publication under this paragraph. For instance, an involved patentee could not assert an opposing applicant's confidences as the basis for blocking a publication.

Proposed § 41.6(b) would generalize to all Board proceedings the practice under Rule 11(e) of making the record of most interference proceedings publicly available eventually, although that availability might not occur until an involved patent application becomes available. It also recognizes pre-grant publication as a basis for making a file publicly available.

Proposed § 41.7 would adopt the current practice of Rule 618 regarding duplicate papers and the expunging of papers, but would generalize it to all Board proceedings. In recent decades, the typical size of files has increased significantly. The increase imposes burdens on the Office in managing the records and on users of the record. This rule would provide a tool for managing the size and complexity of the record and for preventing abuses that can occur in filing.

Proposed § 41.8(a) would reflect the current practice under Rules 192(c)(1) and 602 regarding disclosure of the real parties-in-interest. Federal officials must meet high ethical standards. A principal ethical concern is the avoidance of conflicts of interest for the officials, including even the appearance of a conflict. See *e.g.*, *Stanek v. Dep't of Transp.*, 805 F.2d 1572, 1577 (Fed. Cir. 1986) (affirming dismissal of employee for appearance of a conflict of interest). In the case of the Board, a conflict would typically arise when an official has an investment in a company with a direct interest in a Board proceeding. Such conflicts could only be avoided if the parties promptly provide the information necessary to identify potential conflicts. The identity of a real party-in-interest might also affect the credibility of evidence presented in a proceeding. For instance, testimony from a source related to a real party-in-interest may be seen as misleading or self-serving compared to evidence from a completely independent source (*e.g.*, *Refac Int'l, Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576, 1581–82, 38 USPQ2d 1665, 1669 (Fed. Cir. 1996) (failure to identify declarants as former co-workers was inequitable conduct)). Finally, in a contested case, the presence of a common real party-in-interest might

reflect a lack of genuine adversity between the parties. Common ownership would ordinarily result in prompt termination of any proceeding between the commonly owned parties. *Barton*, 162 F.3d at 1143, 49 USPQ2d at 1131 (recognizing the practice while noting an exception). See proposed § 41.206.

The notice of judicial proceedings required in proposed § 41.8(b) would be important because a judicial decision in another case might be binding on the Board or a party. The Board might also use such information to determine the best pacing for a Board proceeding. Notice of other administrative proceedings might also be relevant. In the case of other Office proceedings, particularly other Board proceedings, notice might allow the Board to more efficiently allocate its limited resources and to avoid inconsistent outcomes. In *re Berg*, 140 F.3d 1428, 1435 nn.7&8, 46 USPQ2d 1226, 1231 nn.7&8 (Fed. Cir. 1998) (calling failure to identify a related application relevant to a double-patenting analysis “misleading”). The “affect or be affected by” standard in proposed § 41.8(b) is derived from Federal Circuit Rule 47.5(b). The proposed rule would also follow Rule 660(d) in requiring notice to the Board of judicial review of the proceeding itself. In the absence of such timely notice, the Board would usually distribute records associated in the proceeding to other parts of the Office for further action. Failure to provide a timely mandatory notice under proposed § 41.8 might result in sanctions including disqualification of counsel and adverse judgment.

Proposed § 41.9 would follow Rule 643 regarding action by an assignee to the exclusion of an inventor, but would generalize it to all Board proceedings. Orders permitting an assignee of a partial interest to act to the exclusion of an inventor or co-assignee would rarely be granted outside of contested cases. Even in contested cases, such orders would typically issue only when the partial assignee was in a proceeding against its co-assignee. *Ex parte Hinkson*, 1904 Comm'r. Dec. 342.

Proposed § 41.20 would consolidate the rules on fees associated with Board practice. Rules 22, 23, and 25–28, which govern fee practice before the Office generally, would continue to apply in Board proceedings. Proposed paragraph (a) would set forth the petition fee, while proposed paragraph (b) would set forth appeals-related fees.

Proposed subpart B would set forth rules for the *ex parte* appeal under 35 U.S.C. 134 of a rejection in either a national application for a patent, an

application for reissue of a patent, or an *ex parte* reexamination proceeding to the Board.

The preamble to proposed § 41.30 would be based on a similar provision in the preamble of Rule 601. The term “proceeding” would set forth a generic term for a national application for a patent, an application for reissue of a patent, and an *ex parte* reexamination proceeding. The term “applicant” would set forth a generic term for either the applicant in a national application for a patent or the applicant in an application for reissue of a patent. The term “owner” would set forth a shorthand reference to the owner of the patent undergoing *ex parte* reexamination under Rule 510.

Proposed § 41.31 would generally incorporate the requirements of current Rule 191(a)–(d). Paragraph (a) would be subdivided into three parts to improve readability. Paragraph (d) would be amended to refer only to the time periods referred to in paragraphs (a)(1)–(a)(3) of this section, while the current extension of time requirements for Rules 192, 193, 194, 196 and 197, now provided in Rule 191(e), would be relocated to proposed §§ 41.37, 41.41, 41.47, 41.50 and 41.52.

Proposed § 41.33(a) and (b) would replace the requirements of current Rule 116 with a prohibition of amendments submitted after the date the proceeding has been appealed pursuant to proposed § 41.31(a)(1)–(a)(3), except amendments canceling claims or rewriting dependent claims into independent form and as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). A dependent claim is rewritten into independent form by including all of the limitations of the base claim and any intervening claims. Thus, no limitation of a dependent claim can be excluded in rewriting that claim into independent form. Proposed § 41.33(c) would replace the requirements of Rule 195 with a prohibition on the admission of affidavits and other evidence submitted after the case has been appealed pursuant to proposed § 41.31(a)(1)–(a)(3), except as permitted by proposed §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). This would replace the current practice of permitting such evidence based on a showing of good and sufficient reasons why such evidence was not earlier presented. The Office believes that prosecution of an application should occur before the examiner prior to an appeal being filed, not after the case has been appealed pursuant to proposed § 41.31(a)(1)–(a)(3).

Proposed § 41.35 would generally incorporate the requirements of current