

cases are generally much more expensive than ex parte proceedings. Consequently, it makes little sense to initiate a contested case before all patentability issues (other than those that are the subject of the contested case) have been resolved. *Brenner v. Manson*, 383 U.S. 519, 528 n.12 (1966) (rejecting the proposition that an interference must be declared when the applicant's interfering claims are unpatentable). The main exceptions would be title contests under 42 U.S.C. 2182 and 2457(d), where control of the examination may itself be a consideration.

Proposed § 41.103 would follow the file jurisdiction practice in Rules 614 and 615 except to generalize the temporary transfer of jurisdiction to include parts of the Office other than the examining corps, including, for example, the Office of Public Records. Such transfers of jurisdiction will generally be for short periods and for limited purposes.

Proposed § 41.104(a) would follow the practice of Rule 610(e), which permits an administrative patent judge wide latitude in administering interferences. The waiver provision of proposed § 41.104(b) would be modeled on Rule 183 and would balance the ideal of precise rules for most proceedings against the need for flexibility to achieve reasonably fast, inexpensive, and fair proceedings. The decision to waive a procedural requirement would be committed to the discretion of the administrative patent judge. This provision would eliminate the need for repeatedly stating exceptions throughout proposed subpart D. For instance, the current rules have many instances where a time is set in a rule, but the rule also permits an administrative patent judge to adjust the time. Proposed § 41.104(c) would make clear that any default times set by rule may be changed by order. "Times" in paragraph (c) would include both dates and durations.

Proposed § 41.105 would codify existing practice prohibiting ex parte communications about a contested case with an official actually conducting the proceeding. Initiation of an ex parte communication might result in sanctions against the initiating party. The prohibition would include communicating with any member of a panel acting in the proceeding or seeking supervisory review in a proceeding without including the opposing party in the communication. In general, it is wisest to avoid substantive discussions of a pending contested case with a Board official. The prohibition on ex parte communications

would not extend to (1) ministerial communications with support staff (for instance, to arrange a conference call), (2) hearings in which opposing counsel declines to participate, (3) informing the Board in one proceeding of the existence or status of a related Board proceeding, or (4) reference to a pending case in support of a general proposition (for instance, citing a published opinion from a pending case or referring to a pending case to illustrate a systemic problem).

Proposed § 41.106 would provide guidance for the filing and service of papers. Under proposed § 41.106(a), papers to be filed would be required to meet standards very similar to those required in patent prosecution, Rule 52(a), and in filings in the Court of Appeals for the Federal Circuit, Fed. R. App. P. 32. Proposed § 41.106(a)(1) would permit a party to file papers in either A4 format or 8½-inch × 11-inch format, but not to alternate between formats. *See* Standing Order ¶ 3.3. At present, the Board prefers papers to be filed in 8½-inch × 11-inch format because the present filing system is best adapted to this paper format. Electronic filing might eventually render this preference moot.

Proposed § 41.106(b) would provide guidance specific to papers other than exhibits. Proposed § 41.106(b)(1) would codify current practices for the cover sheet of a paper. Standing Order ¶¶ 3.1, 3.5 and 3.6; cf. Fed. R. App. P. 32(a)(2). The caption aids in the prompt matching of the paper to its file. The header expedites communications between the Board staff and the party in the event that some prompt action, such as the correction of a filing defect, is necessary. The current practice of requiring a pink cover sheet aids in the processing and filing of papers at the Board and facilitates use of the administrative record by clearly indicating the beginning of each paper.

Proposed § 41.106(b)(2), which would require holes at the top of the paper, would codify the practice under Standing Order ¶ 3.4, which is based on Local Civil Rule 5.1(f) (1999) of the United States District Court for the District of Columbia. The proposed rule would facilitate entry of the paper in the administrative record.

The bar in proposed § 41.106(b)(3) against incorporation by reference and combination of papers would minimize the chance that an argument will be overlooked and would eliminate abuses that arise from incorporation and combination. In *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir 1999), the court rejected "adoption by reference" as "a self-help increase in the length of

the * * * brief" and noted that "incorporation is a pointless imposition on the court's time. A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record." The same rationale applies to Board proceedings.

Proposed § 41.106(b)(4) would provide rules for the citation of authority. Parallel citation to a West Company reporter and to the United States Patents Quarterly, particularly for patent decisions of Federal courts, is the norm in patent law. *See* Federal Circuit Rule 28(e). Pinpoint citations, also called "jump citations", are the norm in legal practice. *See* The Bluebook: A Uniform System of Citation § 3.3(a) (Columbia L. Rev. Ass'n *et al.* 17th ed. 2000). The citation of secondary authority would be discouraged whenever primary authority exists. For instance, a citation to the MPEP is unhelpful if the MPEP itself is merely summarizing binding case law.

Proposed § 41.106(d) would provide additional guidance for special modes of filing. Proposed § 41.106(d)(1) would provide a mailing address. Note that the proposed rule would encourage the use of the EXPRESS MAIL® service of the United States Postal Service. Mail sent by other means would not be considered to have been filed until it is actually received. Cf. proposed § 41.106(e)(3), which would permit service by methods at least as fast and reliable as EXPRESS MAIL®. Proposed § 41.106(d)(2) would permit other modes of filing. For instance, the Board is currently working on a pilot program for electronic filing in contested cases. The diversity of possible filing forms and the varying ability of parties to cope with electronic filing requires a case-by-case determination of whether to place a proceeding in the pilot program. Practitioners permitted to file electronically are encouraged to agree to do so.

Proposed § 41.106(e)(1) would require papers to be served when they are filed if they have not already been served. Under current practice, the usual instance in which filing before service is authorized is the case of preliminary statements where prior filing is a mechanism for ensuring that a party states its priority case based on what it knows about its own proofs rather than on what it knows about what the other party intends to prove. Proposed § 41.106(e)(3) would provide for expedited service, which would place the parties on an equal footing by reducing the disparities that can arise from the use of different forms of delivery.