

Proposed § 41.106(f) would provide rules for certificates of service. Proposed § 41.106(f)(1) would require the certificate to be incorporated into each paper other than exhibits. The filing of additional papers like certificates of service and transmittal letters as separate papers places a file maintenance burden on the Board. The filing of transmittal letters is strongly discouraged. Exhibits constitute the exception to the rule since the current practice permits the filing of most or all exhibits at one time. When the exhibits are filed at the same time, the certificate may be incorporated into the exhibit list. See proposed § 41.154(d).

Section 41.107 of proposed subpart D would be reserved. It is likely that rules for electronic filing and service will evolve in the next few years. When they are ready for codification, § 41.107 would be the natural place for them to appear.

Proposed § 41.108 would require each party to identify its counsel, if any. The proposed rule would also follow Rule 613(a), which permits the Board to require the appointment of a lead counsel.

Proposed § 41.109 would follow Rule 612 in permitting parties to obtain copies of certain Office files directly related to the contested case. Current practice is to make the necessary files available for copying immediately after the Board initiates the proceeding. Standing Order ¶ 6. After that initial opportunity passes, files typically become less available because they are often required in other parts of the Office. Proposed § 41.109(c) would require a party that has not received copies of a requested file to notify the Board of the problem promptly. A delay in receiving a file resulting from a failure to order a file promptly, or to notify the Board promptly that a file has not been received, would not justify a delay in the proceeding.

The proposed rule would depart from Rule 612 by eliminating the requirement for withholding declarations under Rule 131 and statements under Rule 608. One reason for withholding such papers is that they give the opponent an advanced view of the applicant's priority case, which is said to be unfair (and can enable fraud by the other party in stating its priority case). This practice, however, is asymmetric because the withholding only applies to applicants while a patentee's Rule 131 declaration is publicly available. Moreover, to the extent the applicant has relied on the declaration to obtain allowable claims, it is an important element in the prosecution history. On balance, the goals of examination are better served

by permitting early access to such statements. Nothing in the proposed rule would prevent the Board from authorizing the withholding of such declarations on a showing of good cause.

Proposed § 41.110(a) would require a single clean set of the claims, analogous to the requirement for amendments "in clean form" in Rule 121. The annotated copy required in proposed § 41.110(b) would provide the opposing party and the Board with a clear understanding of how the party construes its own claim. The clean and annotated copies would provide everyone in the proceeding with a convenient reference and help to identify mistakes, such as amendments that were not entered or portions of the disclosure that were not printed, before the proceeding begins in earnest. Cf. *Southwest Software, Inc. v. Harlequin, Inc.*, 226 F.3d 1280, 1296, 56 USPQ2d 1161, 1173 (Fed. Cir. 2000) (critical portion of disclosure missing). Moreover, identically worded claims in separate applications claims can, when properly construed in view of the specification, have patentably distinct scopes. This possibility is particularly important for claims written in the form permitted under 35 U.S.C. 112[6], where identically worded means or steps might not correspond to equivalent structures, materials, or acts in the respective disclosures. For instance, a limitation requiring "means for fastening" might refer to rivets in one specification and glue in another, which on the facts of the case might not prove to be equivalent. Here is an example of the annotation that would be required (except the bracketed portion should also be shown in bold face): ". . . means for fastening {Fig. 6, item 3; also page 17, lines 9–22} . . ."

Proposed § 41.120 would provide for notice of requested relief and the basis for that relief in contested cases. Similar notices are already common in patent interferences, e.g., a preliminary statement, a statement under Rule 608, and a motions list currently required at the first status conference. These notices can be effective mechanisms for administering cases efficiently and for placing opponents on notice. Interferences suggested under proposed § 41.202(a) would already include a notice from at least one party, although the Board could require more detail.

Proposed § 41.120(b) would apply present Rule 629(e) regarding the effect of preliminary statements to notices generally. Preliminary statements are binding on the submitting party. The proposed rule would make other such notices presumptively binding because compliance with current notice

practices is highly variable and can have the effect of prejudicing the party that complies most completely with a notice requirement. The filing party should not be allowed to hide behind an ambiguous notice. For instance, a notice that alleges a date of conception "no later than 20 June 2000" would be construed as limiting the submitting party to proving a date no earlier than 20 June 2000. Note that a notice is not evidence except to the extent it qualifies as a party-opponent admission. See Federal Rule of Evidence 801(d)(2). Proposed § 41.120(c) would permit correction of a notice after the time set for filing the notice, but would set a high threshold for entry of the correction.

Proposed § 41.121(a)(1) would redefine motions practice under Rule 633(a), (b), (c)(2), (c)(3), (c)(4), (f) and (g) to focus more specifically on the central issue in the contested case. Current practice often permits motions that have little to do with the point of the contest. For instance, a motion for unpatentability in an interference is not helpful if it does not result in a loss of standing, a change in the scope of the count, or a change in the accorded benefit.

Proposed § 41.121(a)(1)(iii) would permit a motion for judgment in the contest, which can include an attack on standing as well as a motion for relief on the central issue of the contest. For instance, priority in interferences would be raised through motions. This departure from current practice would address a potential disadvantage to the senior party, which currently may have to make decisions about the junior party's priority case after the junior party has provided its evidence but before it explains the evidence. The prohibition on motions directed to priority and derivation in Rule 633(a) would be removed, although a decision on such motions would likely be contingent on decisions regarding the scope of the interference. Consequently, the Board might not authorize the filing of a priority or derivation motion until after scope issues have been resolved.

Proposed § 41.121(a)(2) and (a)(3) would modify the responsive motion and miscellaneous motion practice under Rules 633(i) and (j), 634, and 635 to ensure that the proceeding remains focused. For instance, current practice allows a motion to correct inventorship at any time (Rule 634). Under the proposed rules, a motion to correct inventorship could be an appropriate responsive motion in the face of a patentability attack or in view of a priority statement, but would not be permitted without some connection to an issue that must be resolved in the