

contested case. The authorization requirement in proposed § 41.121(a)(2) would also provide a mechanism for limiting abusive practices, such as moving to add many more claims than are necessary to cure a problem. Proposed § 41.121(a)(3) would provide for miscellaneous motions, which would offer a mechanism for requesting relief on procedural issues and other issues tangential to patentability and priority. See proposed § 41.104. A miscellaneous motion would not be considered a petition; hence, no petition fee is required. See proposed § 41.3(b). Panel review of a decision on a miscellaneous motion would apply an abuse of discretion standard. See proposed § 41.125(c)(5); Rule 655(a).

Proposed § 41.121(b) would place the burden of proof on the moving party, following Rule 637(a). Since priority would be presented as a motion, this paragraph would change the allocation of burden of proof established in Rule 657(a). Cf. *Brown v. Barbacid*, 276 F.3d 1327, 1332, 61 USPQ2d 1236, 1239 (Fed. Cir. 2002) (construing Rule 657(a) to require the ultimate burden of proof on priority to remain on the junior party). A motion that fails to justify relief on its face could be dismissed or denied without regard to subsequent briefing.

Proposed § 41.121(c)(1) would follow Rule 637(a) regarding the general contents of motions, but would also codify the current practice of requiring a separate paper for each motion. The separate paper requirement would reduce the chances that an argument will be overlooked and would generally reduce the complexity of any given paper. The numbered paragraphs stating material facts in proposed § 41.121(c)(1)(ii) should be short, ideally just a sentence or two, to permit the opposing party to admit or deny each fact readily. Under proposed § 41.121(c)(1)(iii), sloppy motion drafting would be held against the moving party. A vague argument or citation to the record creates inefficiencies for the Board and is fundamentally unfair to the opposing party. Cf. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1351, 53 USPQ2d 1580, 1589 (Fed. Cir. 2000) (declining to scour the record to make out an argument for a party).

Proposed § 41.121(c)(2) would require the movant to make showings ordinarily required for the requested relief in other parts of the Office. Many actions, particularly corrective actions like changes in inventorship, filing reissue applications, and seeking a retroactive foreign filing license, are governed by other rules of the Office. By requiring

the same showings, the proposed rule would keep practice uniform throughout the Office. The Board could temporarily release the affected file to the part of the Office usually responsible for administering the rule to ensure consistency or otherwise take advantage of that entity's expertise. See proposed § 41.103.

Proposed § 41.121(d) would provide authority comparable to Rule 641, which allows an administrative patent judge to raise questions of patentability. The proposed rule would be broader because it would permit the Board to inquire into other issues that may arise, such as whether there continues to be an interference-in-fact in view of a claim construction reached in deciding a motion. In this regard, it would be akin to an order to show cause under Rule 640(d)(1).

Proposed § 41.122 would address the perennial problem of new arguments or requests for relief creeping in at inappropriate times. The proposed rule would largely adopt the present practice in Standing Order ¶ 13.7, but would extend the practice to oppositions as well. Note that a movant need not anticipate all possible bases for opposition, but may be held accountable for positions apparently inconsistent with those taken by the movant during prosecution of an application. For instance, a motion to add a broad claim to an application in which the claims have been narrowed to avoid prior art should explain why the new claim is patentable, not only in terms of written description in the specification but also in terms of the previously applied prior art. The Board could expunge improper papers. See proposed § 41.7(a); *Winter v. Fujita*, 53 USPQ2d 1234, 1250 (BPAI 1999).

Proposed § 41.123(a) would maintain the practice of having the Board set the times for filing motions found in Rule 636, but would eliminate the default times provided in that rule. Proposed § 41.123(a)(1)–(3) would provide default times for filing an opposition, a reply, and a responsive motion, but would not themselves authorize the filing of an opposition, a reply, or a responsive motion.

Proposed § 41.123(b) would provide requirements for miscellaneous motions. A conference call would be required before the motion is filed because most relief requested in such motions can be granted (or denied) in a conference call. In other cases, the call would permit the setting of a schedule to accommodate full briefing of the issue. This telephone practice has greatly increased speed and reduced

costs associated with miscellaneous motion practice.

A party is not entitled to an oral argument. In *re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985). Hence, a party could request an oral argument under proposed § 41.124(a), but requests would not be automatically granted. Factors considered in setting an oral argument might include the usefulness of an oral argument to the administrative patent judge or panel and the burden on an opponent of attending an oral argument. A corollary is that not all requested issues would necessarily be heard. Under proposed § 41.124(b), the parties would be required to file three working copies of the papers to be considered for the panel if the hearing is set for a panel. This requirement would be comparable to Rule 656(e) and Federal Circuit Rule 31(b).

Proposed § 41.124(c) would provide a default time of 20 minutes per party for oral arguments at the Board because they are not evidentiary hearings. This default time would be comparable to the 15 minutes typically provided for oral argument at the Court of Appeals for the Federal Circuit. Fed. Cir. R. 34, practice note (2001).

Proposed § 41.124(d) would permit the use of demonstrative exhibits. Visual aids requiring special equipment would be discouraged since the argument time would be short and cumbersome exhibits would tend to detract from the user's argument. The use of a compilation with each demonstrative exhibit separately tabbed would be encouraged, particularly when a court reporter is transcribing the oral argument because the tabs provide a convenient way to record which exhibit is being discussed. It is helpful to provide a copy of the compilation to each member of the panel hearing the argument.

Proposed § 41.124(e) would permit the transcription of the argument. The transcription would become part of the record and could be helpful to the panel in reaching its decision. See *Okajima v. Bourdeau*, 261 F.3d 1350, 1356, 59 USPQ2d 1795, 1798 (Fed. Cir. 2001) (noting the role of the transcript in the Board's decision). To be helpful, however, the transcript would have to be filed promptly.

Proposed § 41.125(a) would maintain the practice under Rule 640(b) of addressing issues in a manner that is both fair and efficient. Noted with approval in *Berman v. Housey*, 291 F.3d 1345, 1352, 63 USPQ2d 1023, 1028 (Fed. Cir. 2002). A decision on a motion might be logically contingent on the outcome of another motion even though