

disqualifying an officer from administering a deposition. The use of financial interest as a disqualification, however, would be broader than the employment interest currently barred. Payment for ordinary services rendered in the ordinary course of administering the deposition and preparing the transcript would not be a disqualifying financial interest. An interest acknowledged by the parties on the record without objection would not be a disqualifying interest.

Proposed § 41.157(e)(7) would require the proponent of the testimony to file the transcript of the testimony. If the original proponent of the testimony declined to file the transcript (for instance, because that party no longer intended to rely on the testimony), but another party wished to rely on the testimony, that party becomes the proponent and could file the transcript as its own exhibit.

Proposed § 41.157(f) would codify the existing practice of requiring the proponent of testimony to pay the reasonable costs associated with making the witness available for cross examination, including the costs of the reporter and transcript.

Proposed § 41.158 would codify the practice under Standing Order ¶¶ 14.9 and 14.10 regarding expert testimony and scientific tests and data. Opinions expressed without disclosing the underlying facts or data may be given little, if any, weight. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997). United States patent law is not an appropriate topic for expert testimony before the Board.

Proposed subpart E would provide rules specific to patent interferences. Proposed § 41.200(a) would specifically identify patent interferences as contested cases subject to the rules in proposed subpart D.

Proposed § 41.200(b) would continue the practice under Rule 633(a) of looking at the applicant's specification to determine the meaning of a copied claim, not the specification from which the claim was copied. See *Rowe v. Dror*, 112 F.3d 473, 479, 42 USPQ2d 1550, 1554 (Fed. Cir. 1997) (explaining the change in practice). Claims in interferences are not to be treated any differently than any other claim before the Office. In this regard, the proposed rule would also clarify that claims are given their broadest reasonable interpretation in light of the associated specification. In *re Van Geuns*, 988 F.2d 1181, 1185, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (application claim in interference); In *re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir.

1989) (application claim after interference); In *re Etter*, 756 F.2d 852, 858–59, 225 USPQ 1, 5–6 (Fed. Cir. 1985) (en banc) (patent claim in reexamination). The court in *Etter* noted that a patentee in reexamination can amend its claim, while a patentee in litigation ordinarily may not. A patentee in an interference can contingently narrow its claim by filing a reissue application. 35 U.S.C. 251; Rule 633(h) and (i); proposed § 41.121(a)(2). Indeed, a patentee may face an estoppel if it does not seek to amend its claim when necessary. Rule 658(c); proposed § 41.127(a)(1).

Proposed § 41.200(c) would set forth the policy now found in Rule 610(c) setting two years as the maximum normal pendency for patent interferences. New procedures adopted since October 1998 have permitted the Board to meet or exceed this goal in most interferences declared since that time. The cooperation of the parties has been a critical factor in this success. The proposed rules would build on this success by codifying procedures that have facilitated efficiency, removing procedures that delayed proceedings, and creating new opportunities for improvement.

Proposed § 41.201 would set forth definitions specific to patent interferences. The phrase “accorded benefit” would be defined as an act by the Board with regard to priority. Specifically, it would be the Board's recognition of an application as providing a proper constructive reduction to practice for a party. This recognition would create a presumption that is important for setting the burdens for proving priority. “Accorded benefit” in this proposed subpart would be a term of art limited to priority determinations under 35 U.S.C. 102(g). In this regard accorded benefit should be understood to be distinct from benefit under 35 U.S.C. 119, 120, 121, or 365(a), which impose additional requirements not directly relevant to a priority determination under section 102(g).

A definition would be set forth for the phrase “constructive reduction to practice” because this phrase would be used in the proposed rules instead of “earliest effective filing date” to explain more precisely how benefit would be accorded for the purpose of determining priority. “Earliest effective filing date” has proved confusing because the same term is used to discuss compliance with the disclosure requirements of 35 U.S.C. 119, 120, 121, and 365. Compliance with these statutes is important when considering most questions of patentability, but the question of benefit

for priority under 35 U.S.C. 102(g) is narrower than full compliance with the disclosure statutes. Sections 119, 120, 121, and 365 focus on whether the full scope of a claim is adequately disclosed, while an interference is focused on whether at least one embodiment anticipates the interfering subject matter as defined in a count.

The phrase “constructive reduction to practice” would focus consideration on the value of a disclosure as a potentially anticipating reference under section 102(g). Only a single enabled embodiment is necessary for anticipation of the count. Note that abandonment of an application without a co-pending (section 120 and 121) or timely filed (sections 119 and 365) successor application can render an otherwise anticipating disclosure under section 102(g) “inoperative for any purpose, save as evidence of conception.” In *re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 391 (Fed. Cir. 1983). The phrase “earliest constructive reduction to practice” would reflect this requirement for continuity in the disclosure of the anticipating embodiment under section 102(g).

The term “count” would be redefined to emphasize the relationship of the count to admissible proofs of priority under section 102(g). *Eaton v. Evans*, 204 F.3d 1094, 1097, 53 USPQ2d 1696, 1698 (Fed. Cir. 2000) (priority cannot be established with a reduction to practice outside the count). There has been a theoretical debate in the interference bar about whether a count is necessary. Opponents hold that a count is an artificial construct that imposes significant administrative costs. It is true that the use of a count is the principal reason why interferences almost always proceed in two phases: a first phase to examine issues related to the scope of the count and a second phase to determine priority for the count. Moreover, use of a count might in some cases obscure the relationship between the priority proofs and the patentability of claims said to correspond to the count. Proponents, however, note that addressing the separate unpatentability of claims without the benefit of a count to focus the analysis also imposes extensive costs and uncertainties.

While a count may be theoretically unnecessary, experience with the current rules suggests that a count is desirable. The costs associated with the count are outweighed by the advantages flowing from having a single description of the interfering subject matter both for the purpose of determining priority and, perhaps more importantly, for the