

Ordinarily in proceedings before the Office, a determination of the invention must be based on what is claimed. 35 U.S.C. 112[2]. A claim is not a prerequisite for a rejection under section 102(g), however (*e.g.*, *Apotex USA, Inc. v. Merck & Co., Inc.*, 254 F.3d 1031, 59 USPQ2d 1139 (Fed. Cir. 2001) (prior invention of another not based on a claim)). It has long been the practice to determine priority in an interference based on a count, which might not even be fully supported by the disclosure of either party, *Aelony v. Arni*, although other patentability determinations must be based on claims, *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The count is understood to be the common inventive concept of the parties.

Both claim-based and count-based correspondence rest on the assumptions that the claim or count on which correspondence is based defines a single inventive concept and that any obviousness relationship between the proof of priority and a corresponding claim is not too attenuated. Either of these problems can be addressed by filing an appropriate motion regardless of the basis on which correspondence is determined.

In cases where the count is closely based on actual claims and where the number of claims is small, there is generally very little practical difference between claim-based and count-based correspondence. In cases involving very large numbers of claims, however, claim-based correspondence places a huge burden on a party seeking to have a claim designated as not corresponding because a comparison must be made with every single corresponding claim. Count-based correspondence would make analysis of claim correspondence easier by providing a single point of reference—the count—for determining correspondence. Moreover, by basing correspondence exclusively on the count, the proposed rule would make the basis for claim correspondence consistent with the basis for the priority determination.

The presumption in proposed § 41.207(c) would restate the presumption in Rule 637(a) that prior art cited against an opponent is presumed to apply against the movant's claims. Note that the proposed rule would clarify the current practice by not triggering the presumption unless the motion is granted with respect to an opponent's claim. Although the proposed rule would omit the reference to priority statements, a party could not rely on its notice of requested relief as evidence, see proposed § 41.120(b), so

the repetition in this section would not be necessary.

The presumption of abandonment after one year in proposed § 41.207(d) would be new. It is modeled after the one-year statutory bars (*e.g.*, 35 U.S.C. 102(b), 102(d), and 135(b)) and other incentives for prompt filing (*e.g.*, 35 U.S.C. 119(a) and 273(b)(1)). The presumption is intended to encourage prompt filing of patent applications and to help parties facing the issue by simplifying the analysis of an apparent abandonment, suppression, or concealment. An invention, though completed, is deemed abandoned, suppressed, or concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known. For example, failure to file a patent application, to describe the invention in a publicly disseminated document, or to use the invention publicly, has been held to constitute abandonment, suppression, or concealment. *Correge v. Murphy*, 705 F.2d 1326, 1330, 217 USPQ 753, 756 (Fed. Cir. 1983). The case law does not give definitive guidance on when abandonment, suppression, or concealment has occurred. This uncertainty makes it harder to determine what evidence to present in order to show an abandonment, suppression or concealment; and to determine in close cases whether abandonment, suppression, or concealment has occurred. Although this presumption is designed to encourage prompt filing, it does not exclude rebuttal proofs of continuing activity other than filing, such as those listed in the *Correge* decision.

Proposed § 41.208(a) would focus substantive motions on the core questions of priority.

Proposed § 41.208(b) would place the burden of proof on the movant and would provide guidance on how to satisfy the burden of going forward.

Proposed § 41.208(c) would set forth some guidance to parties about specific motions, but would not attempt to list all possible substantive requirements for each motion, nor would it exhaustively list all possible kinds of motions. In practice, interference practice has proved too varied to permit an exhaustive list. The specific requirements of the analogous Rule 637 have proved both over-inclusive, see Chief Admin. Pat. J., "Interference Practice—Interference Rules Which Require a Party to 'Show the Patentability' of a Claim", 1217 Official Gaz. 17 (USPTO 1998) (limiting the scope of showings), and under-inclusive, see *Hillman v. Shyamala*, 55 USPQ2d 1220, 1221 (BPAI 2000)

(holding the required showings to be insufficient). Ultimately, the movant would have to justify the relief sought substantively, which means compliance with statutes, rules, and case law that could never be fully replicated in a rule governing the content of motions.

Substantive motions in an interference essentially ask three questions. First, should the proceeding reach the question of priority at all? Second, what is the scope of the proofs necessary and proper for proving priority and what claims must be cancelled in the event of an adverse judgment? Third, which party will lose the determination of priority? While final judgment is possible on a wide array of issues, the fundamental purpose of an interference is to determine priority. Consequently, substantive motions without some nexus to an ultimate question of priority would not ordinarily be considered. For example, a motion that a claim is unpatentable might be dismissed if it does not affect a party's standing, the scope of the count, or the accorded benefit.

The first question implicates the three "threshold issues" that are ordinarily taken up early because they affect a party's standing in an interference. *Berman v. Housey*, 291 F.3d 1345, 1352, 63 USPQ2d 1023, 1028 (Fed. Cir. 2002) (endorsing the Board practice of early determination of threshold issues). These threshold issues are no interference-in-fact, repose under 35 U.S.C. 135(b), and lack of written description supporting claims added to provoke an interference. Threshold issues present a movant with an opportunity to escape the burdens of a full-scale interference. A party that failed to request such relief early would not ordinarily receive an early determination. The practice of deciding threshold issues early evolved to address abuses on the part of some applicants provoking interferences.

An attack on standing must necessarily be effective with respect to all of an opponent's claims on which the determination of interference-in-fact depends; otherwise, it would really be some other type of motion, such as a motion to change the count, claim correspondence, or accorded benefit. Occasionally, more than one threshold issue might need to be raised (in separate motions) to address all involved claims. For instance, an opponent's copied claims might lack written description, while its other corresponding claims would not in fact interfere. Issues other than threshold issues could also affect standing, but would rarely be taken up early because they have less connection with the