

threshold determination of whether the Director is of the opinion that an interference exists.

Proposed § 41.208(c)(1) would set forth guidance on filing a motion for judgment of no interference-in-fact. The proposed rule would require a showing that the test for an interference under proposed § 41.203(a) is not met. The showing must be for all claims because a single claim of each party is sufficient to support the Director's opinion that an interference exists in fact.

Proposed § 41.208(c)(2) would set forth guidance on filing a motion for judgment that a patentee is entitled to repose under 35 U.S.C. 135(b). Section 135(b) has two aspects. It is a statute of repose, *Berman v. Housey*, 291 F.3d 1345, 1351, 63 USPQ2d 1023, 1027 (Fed. Cir. 2002), and a statutory bar, *In re McGrew*, 120 F.3d 1236, 1238–39, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997). As a statute of repose, it presents a threshold issue; otherwise, it is simply an attack on patentability. To be a threshold issue, the motion must satisfy two conditions. First, the party moving for repose must be the patentee or published applicant entitled to repose under the statute. Second, it must apply (possibly in combination with other threshold issues) to all of an opponent's involved claims; otherwise, the interference would continue whether the motion is granted or not. If either condition is not met, the motion would be treated as a motion for unpatentability, but not as a threshold issue.

Proposed § 41.208(c)(3) would set forth general guidance for attacking patentability. This guidance would apply to a non-threshold motion alleging unpatentability under 35 U.S.C. 135(b) in view of non-party's patent or published application. A motion attacking patentability could be a threshold issue (e.g., an attack on the written description of a copied claim), an effort to change the count (by showing that claims within the scope of the count are not patentable over prior art), or a priority issue, depending on the claims attacked and the basis for the attack. Note that because counts would continue to be used, the Board would continue the practice of ordinarily either not authorizing the filing of, or deferring any decision on, a patentability motion that raises questions of priority or derivation during the first part of the interference. Generally motions attacking patentability under 35 U.S.C. 102(a), 102(e), 102(f), or 102(g) will be deferred, in whole or in part. This practice does not, however, relieve a party of its

obligation to state these grounds as bases for relief when required.

The second set of substantive questions would involve changes to the scope of the count, claim correspondence, and accorded benefit. Motions under proposed § 41.208(c)(3) attacking the patentability of claimed subject matter within the scope of the count might also fall within this category if they have the effect of narrowing the count.

Proposed § 41.208(c)(4) would set forth guidance for some common motions to change the count. If the count changes, no change in accorded benefit will be presumed; it would have to be established in a contingent motion to change benefit. Proposed § 41.208(c)(4)(i) would restate the requirement of Rule 637(c)(1)(v) to show that counts are separately patentable. Proposed § 41.208(c)(4)(ii)(C) would codify the practice in *Louis v. Okada*, 59 USPQ2d 1073, 1076 (BPAI 2001), which required a movant seeking to broaden a count to cover its best proof of priority to proffer that proof so the Board could evaluate the merits of the motion.

Proposed § 41.208(c)(5) would set forth guidance for parties moving to change claim correspondence. Proposed § 41.208(c)(5)(i) would require that any added claim be patentable and correspond to the count. A motion to add a claim that did not correspond to the count would in effect be a request for an advisory action, which the Board would not ordinarily give. A patentee could not use a reissue application to circumvent this requirement that all claims in an interference must correspond to the count. *Winter v. Fujita*, 53 USPQ2d 1234, 1249 (BPAI 1999). The proposed rule could be used to compel an opponent to add a claim to its involved application or patent. Note that patentee cannot be literally compelled to file a reissue application for any reason, including to add a claim. *Green v. Rich Iron Co.*, 944 F.2d 852, 854, 20 USPQ2d 1075, 1076–77 (Fed. Cir. 1991). The consequence of an opponent's refusal to add a claim, however, may be a concession of priority with respect to the subject matter that the patentee refuses to add. See Rule 605(a); cf. *In re Ogiue*, 517 F.2d at 1390, 186 USPQ at 235 (an applicant surrenders the subject matter of a claim it refuses to copy); proposed § 41.202(c). The remainder of proposed § 41.208(c)(5) would restate the correspondence test in terms of a one-way test for patentability in which the subject matter of the count is used as the primary reference.

Proposed § 41.208(c)(6) would restate the test for according benefit of an

application in terms of recognition for a constructive reduction to practice. In doing so, the test would avoid confusion with the related, but distinct, tests for benefit of a disclosure for the purposes of 35 U.S.C. 119, 120, 121, and 365. Note that a constructive reduction to practice relates to the count, not a claim. Moreover, the showing for a constructive reduction to practice would generally be narrower because only a single embodiment is necessary to anticipate a count. By contrast, § 120 incorporates the requirements of 35 U.S.C. 112[1], which include disclosure of sufficient embodiments to support the full scope of a claim. See *Cromlish v. D.Y.*, 57 USPQ2d 1318 (BPAI 2000) (discussing this difference).

Proposed § 41.208(c)(7) would permit the Board to require additional showings. For example if a party had copied a claim and during the interference proposed to argue that its opponent's claim was indefinite under 35 U.S.C. 112[2], the Board could require the movant to explain why its copied claim was not also indefinite.

Proposed § 41.208(d) would require the use of claim charts whenever a claim is being compared to something else. Claim charts are often the most effective way to present the comparison convincingly. Claim charts would not, however, be a substitute for argument since the comparison would generally require additional explanation. The proposed rule would refer to a "paper" rather than a "motion" because such comparisons can arise in oppositions and even replies.

Regulatory Flexibility Act

The Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration under the provisions of section 605(b) of the Regulatory Flexibility Act that this proposed rule making will not have a significant economic impact on a substantial number of small entities.

Executive Order 13132

This rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Executive Order 12866

This rule making has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

Paperwork Reduction Act

This proposed rule involves information collection requirements