

reduction to practice under 35 U.S.C. 102(g).

*Constructive reduction to practice* means description and enablement of an embodiment within the scope of the interfering subject matter in a patent application.

*Count* means the Board's description of the interfering subject matter that sets the scope of admissible proofs on priority. Where there is more than one count, each count must describe a patentably distinct invention.

*Earliest constructive reduction to practice* means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications culminating in the involved application or patent. For the chain to be continuous, each subsequent application must have been co-pending under 35 U.S.C. 120 or 121, or timely filed under 35 U.S.C. 119 or 365(a).

*Involved claim* means, for the purposes of 35 U.S.C. 135(a), a claim that has been designated as corresponding to the count.

*Senior party* means the party entitled to the presumption under § 41.207(a)(1) that it is the prior inventor. Any other party is a *junior party*.

*Threshold issue* means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

- (1) No interference-in-fact, and
- (2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:
  - (i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or
  - (ii) Unpatentability for lack of written description under 35 U.S.C. 112[1] of an involved application claim.

#### § 41.202 Suggesting an interference.

(a) *Applicant*. An applicant, including a reissue applicant, may suggest an interference with another application or a patent. The suggestion must:

- (1) Provide sufficient information to identify the application or patent with which the applicant seeks an interference,
- (2) Identify all claims the applicant believes interfere and show how they should correspond to one or more counts,
- (3) For each count, provide a claim chart comparing at least one claim of each party corresponding to the count and show why the claims interfere within the meaning of § 41.203(a),
- (4) Explain in detail why the applicant will prevail on priority,

(5) If a claim has been added or amended to provoke an interference, provide a claim chart showing the written description for each claim in the applicant's specification, and

(6) For each constructive reduction to practice for which the applicant wishes to be accorded benefit, provide a chart showing where the disclosure provides enabling description of an embodiment within the scope of the interfering subject matter.

(b) *Patentee*. A patentee cannot suggest an interference under this section, but may file a protest to the extent permitted under § 1.291 of this title to draw the examiner's attention to a potential interference.

(c) *Examiner*. An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim. The claim the examiner proposes to have added must, apart from the question of priority under 35 U.S.C. 102(g):

- (1) Be patentable to the applicant and
- (2) Be drawn to patentable subject matter claimed by another applicant or patentee.

(d) *Requirement to show priority under 35 U.S.C. 102(g)*. (1) When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

(2) If an applicant fails to show priority under paragraph (d)(1) of this section, an administrative patent judge may nevertheless declare an interference to place the applicant under an order to show cause why judgment should not be entered against the applicant on priority. New evidence in support of priority will not be admitted except on a showing of good cause. The Board may authorize the filing of motions to redefine the interfering subject matter or to change the benefit accorded to the parties.

(e) *Sufficiency of showing*. A showing of priority under this section is not sufficient unless it would, if un rebutted, support with adequate evidence a determination of priority in favor of the party making the showing.

#### § 41.203 Declaration.

(a) *Interfering subject matter*. An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered

obvious the subject matter of a claim of the opposing party and vice versa.

(b) *Notice of declaration*. An administrative patent judge declares the patent interference on behalf of the Director. A notice declaring an interference identifies:

- (1) The interfering subject matter;
- (2) The involved applications, patents, and claims;
- (3) The accorded benefit for each count; and
- (4) The claims corresponding to each count.

(c) *Redeclaration*. An administrative patent judge may redeclare a patent interference on behalf of the Director to change the declaration made under paragraph (b) of this section.

(d) *Additional patent, application, or interference*. A party may suggest the addition of a patent or application to the interference or the declaration of an additional interference. The suggestion should make the showings required under § 41.202(a).

#### § 41.204 Notice of basis for relief.

(a) *Priority statement*. Each party that will submit evidence of its priority apart from its accorded benefit must file a statement alleging with particularity facts that, if proved, would be sufficient for it to establish an earlier date of conception or an earlier actual reduction to practice. The statement must include all bases on which the party intends to establish its entitlement to a judgment on priority and must include documentary support for each basis when the documentary support is a unique record under the control of the party or its real party-in-interest. Failure of a junior party to file a sufficient priority statement will be treated as an abandonment of contest absent a showing of good cause.

(b) *Other substantive motions*. For each substantive motion that a party will file, the Board may require a statement of basis for the relief the party seeks.

(c) *Filing and service*. The Board will set the times for filing and serving statements required under this section.

#### § 41.205 Settlement agreements.

(a) *Constructive notice; time for filing*. Pursuant to 35 U.S.C. 135(c), an agreement or understanding, including collateral agreements referred to therein, made in connection with or in contemplation of the termination of an interference must be filed prior to the termination (§ 41.128) of the interference between the parties to the agreement.

(b) *Untimely filing*. The Chief Administrative Patent Judge may permit