

the filing of an agreement under paragraph (a) of this section up to six months after termination upon petition and a showing of good cause for the failure to file prior to termination.

(c) *Request to keep separate.* Any party to an agreement under paragraph (a) of this section may request that the agreement be kept separate from the interference file. The request must be filed with or promptly after the agreement is filed.

(d) *Access to agreement.* Any person, other than a representative of a Government agency, may have access to an agreement kept separate under paragraph (c) of this section only upon petition and on a showing of good cause. The agreement will be available to Government agencies on written request.

#### **§ 41.206 Common interests in the invention.**

An administrative patent judge may decline to declare, or if already declared the Board may terminate, an interference between an application and another application or patent that are commonly owned.

#### **§ 41.207 Presumptions.**

(a) *Priority.*—(1) *Order of invention.* Parties are presumed to have invented interfering subject matter in the order of the dates of their accorded benefit for each count. If two parties are accorded the benefit of the same earliest date of constructive reduction to practice, then neither party is entitled to a presumption of priority with respect to the other such party.

(2) *Evidentiary standard.* Priority may be proved by a preponderance of the evidence except a party must prove priority by clear and convincing evidence if the date of its earliest constructive reduction to practice is after the issue date of an involved patent or the publication date under 35 U.S.C. 122(b) of an involved application or patent.

(b) *Claim correspondence.* (1) For the purposes of determining priority and derivation, all claims of a party corresponding to the count are presumed to stand or fall together. To challenge this presumption, a party must file a timely substantive motion to have a corresponding claim designated as not corresponding to the count. No presumption based on claim correspondence regarding the grouping of claims exists for other grounds of unpatentability.

(2) A claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have

anticipated or rendered obvious the subject matter of the claim.

(c) *Cross-applicability of prior art.* When a motion for judgment of unpatentability against an opponent's claim on the basis of prior art is granted, each of the movant's claims corresponding to the same count as the opponent's claim will be presumed to be unpatentable in view of the same prior art unless the movant in its motion rebuts this presumption with supporting evidence.

(d) *Abandonment, suppression, or concealment.* A party is presumed to have abandoned, suppressed, or concealed the interfering subject matter if the accorded date of the party's earliest constructive reduction to practice is more than one year after the party's actual reduction to practice. A party subject to this presumption must show in its motion for priority that it did not abandon, suppress, or conceal its invention.

#### **§ 41.208 Content of substantive and responsive motions.**

The general requirements for motions in contested cases are stated at § 41.121(c).

(a) In an interference, substantive motions must:

- (1) Raise a threshold issue,
- (2) Seek to change the scope of the count or the correspondence of claims to the count,
- (3) Seek to change the benefit accorded for the count, or
- (4) Seek judgment on derivation or on priority.

(b) To be sufficient, a motion must provide a showing, supported with appropriate evidence, such that, if un rebutted, it would justify the relief sought. The burden of proof is on the movant.

(c) *Specific motions* that may be authorized, along with necessary content for each, include:

(1) *No interference-in-fact.* A party moving for judgment because the involved claims do not, in fact, claim interfering subject matter must, for each of its involved claims, show that the subject matter of the claim does not interfere within the meaning of § 41.203(a) with the subject matter of any involved claim of an opponent.

(2) *Repose under 35 U.S.C. 135(b).* A party moving for repose under 35 U.S.C. 135(b) must:

- (i) Identify the claims of the movant's United States patent or published application claiming the same or substantially the same invention as is claimed in an opponent's involved claim, and
- (ii) Show the opponent did not make such a claim prior to one year from the

grant of the patent or the publication of the application.

(3) *Unpatentability of a claim.* A party moving for a decision that an opponent's claim is not patentable to the opponent must:

- (i) Identify the legal basis for unpatentability,
- (ii) Show why each claim alleged to be unpatentable fails to satisfy the substantive requirements of the legal basis identified, and
- (iii) For arguments involving prior art, explain why the movant's claims corresponding to the same count as the opponent's claim are not unpatentable in view of the prior art.

(4) *Adding or substituting a count.* (i) The movant must show why the proposed count does not define the same invention within the meaning of § 41.203(a) as any other count, including the count it would replace.

(ii) *To broaden a count* to include subject matter not in the current count, the movant must:

(A) Show that the proposed count does not include prior art subject matter,

(B) Show that the additional subject matter interferes within the meaning of § 41.203(a) with subject matter in an opponent's involved claim, and

(C) Show why the change is necessary to a priority determination. If the change is necessary to include the movant's best proof of priority, the movant must proffer that proof with an explanation of why it does not fall within the scope of the current count.

(5) *Changing claim correspondence.*—

(i) *To add a claim.* A party moving to add a claim to an involved patent or application must show that the subject matter of the count would have anticipated or rendered obvious the subject matter of the added claim and that the added claim would be patentable in the patent or application. The showing of patentability must include a showing of where the disclosure of the patent or application provides written description of the subject matter of the claim.

(ii) *To designate a claim as corresponding to a count.* A party moving to have a claim designated as corresponding to a count must show that the subject matter of the count would have anticipated or rendered obvious the subject matter of the claim.

(iii) *To designate a claim as not corresponding to a count.* A party moving to have a claim designated as not corresponding to a count must show that:

(A) The subject matter of the count would not have anticipated or rendered