

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

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**GLUCKMAN,**  
Junior Party,

v.

**LEWIS,**  
Senior Party.

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Patent Interference No. 104,553

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ORDER  
(RESETTING PRELIMINARY MOTIONS PERIOD)

INTRODUCTION

On 11 May 2001 at about 11 a.m., there was a telephone conference involving--

1. Danny Huntington, Sharon Crane, and Tony Zupcic for Gluckman,
2. Doreen Yatko Trujillo and Paul Legaard for Lewis, and
3. Richard Torczon for the Board of Patent Appeals and Interferences.

As a result of the conference, it has become necessary to reset the preliminary motions period schedule.

At an earlier conference, junior party Gluckman had indicated that it did not intend to file any preliminary motions. Senior party Lewis had indicated that it intended to file motions alleging unpatentability of Gluckman claims based on prior art and on failure to comply with 35 U.S.C. 112[1], as well as a motion for benefit of an earlier application. Based on the limited number of motions indicated, a somewhat truncated motions period was set (Paper No. 14).

At the time this interference was declared, Gluckman was junior by more than two years. Given Gluckman's indication that it did not intend to file any preliminary motions, the parties were ordered to file their preliminary statements two weeks before the earliest filing date for the preliminary motions. If Gluckman had not pled a case for prevailing on priority, the remaining schedule would have been

suspended and Gluckman would have been placed under an order to show cause why the interference should continue.

Gluckman has now informed the Board that it intends to file a preliminary motion alleging no interference-in-fact, as well as a motion for benefit and a motion alleging unpatentability of Lewis claims based on prior art. The planned preliminary motion alleging no interference-in-fact creates a new set of facts that must be considered in administering this interference.

## DISCUSSION

An administrative patent judge is charged with administering the rules "to secure the just, speedy, and inexpensive determination of every interference." 37 C.F.R. § 1.601. Among other things, this means that where a junior party does not plead a case for prevailing on priority in its preliminary statement, the interference may be terminated with a judgment against the junior party without reaching other issues. 37 C.F.R. § 1.640(d)(3). A similar situation arises when there is no interference-in-fact. The existence of an interference-in-fact is a predicate for conducting an interference. 35 U.S.C. 135(a).<sup>(1)</sup> Where the lack of an interference is apparent early in the proceedings, prudence will ordinarily counsel a schedule that focuses on the allegation of no interference-in-fact before the other issues for at least two reasons. First, just administration counsels that such quasi-jurisdictional issues be resolved before a party's claims are placed in jeopardy. Otherwise, there might be an incentive<sup>(2)</sup> for a party to engineer a thin pretext for an interference, knowing that the pretext will fail under scrutiny, simply to obtain an inter partes opposition or a more liberal inter partes reexamination, or for other reasons unrelated to the Board's mission under § 135(a). Such pretexts should be avoided as contrary to Congressional intent, see, e.g., 35 U.S.C. 311-318 and the Domestic Publication of Foreign Filed Patent Applications Act of 1999, Pub. L. No. 106-113, App. I, sec. 4502(c), 113 Stat. 1501-A561, 1501A-562 (2000). Second, inexpensive administration counsels early resolution of quasi-jurisdictional issues before the parties have expended resources briefing issues that should never have been raised given the lack of an underlying interference.<sup>(3)</sup> Where it is possible to identify and address such issues early in the proceeding, it should ordinarily be done. Cf. 37 C.F.R. § 1.617 (providing a summary proceeding for entering judgment against an applicant who fails to provide a prima facie basis for judgment).

The present interference presents two such potentially dispositive issues. First, if there is no interference-in-fact, then neither party should ordinarily have its claims placed in jeopardy or be faced with the expense of litigating other issues. Second, if there is an interference-in-fact, but Gluckman cannot plead an early enough date for conception, then Lewis should not have its claims placed in jeopardy and the parties should not be faced with the expense of litigating other issues.<sup>(4)</sup>

As discussed in the conference call, some practical considerations flow from the change in schedule. First, the filing of the preliminary statements is delayed one month. Second, a status call has been scheduled to see if Lewis will oppose Gluckman's motion alleging no interference-in-fact and whether it will need to file a motion under 37 C.F.R. § 1.633(i). Given the late arising issue of no interference-in-fact, the motions period will be extended a month. This extension is not ideal, see 37 C.F.R. § 1.610(c) (setting a goal for completion), and high-lights the importance of early identification of all of the motions a party intends to file. On other facts, an extension might not be forthcoming. Counsel are commended, however, for drawing these issues to the Board's attention and for cooperating in designing a schedule that will fairly and efficiently resolve the threshold issues of this interference proceeding.

## CONCLUSION

In view of these considerations, the preliminary motions schedule is reset to allow early filing of

Gluckman's motion alleging no interference-in-fact and of preliminary statements.

ORDER

Upon consideration of the record of this interference, it is--

ORDERED that the preliminary motions schedule set in the appendix to Paper No. 14 be reset as provided in the attached appendix; and

FURTHER ORDERED that the provisions of Paper No. 14 apply to the schedule set in the appendix to this order; and

FURTHER ORDERED that any opposition, reply, or other paper relating to Gluckman's motion alleging be filed at the time provided for such papers relating to other motions;

FURTHER ORDERED that each party provide counsel for a telephone conference to be initiated by the Board on **6 June 2001** at **10 a.m.** (Eastern).

RICHARD TORCZON  
Administrative Patent Judge

Counsel for Gluckman: R. Danny Huntington and Sharon E. Crane, Burns, Doane, Swecker & Mathis, L.L.P.; and Robert L Baechtold, Fitzpatrick, Cella, Harper & Scinto.

Counsel for Lewis: Doreen Yatko Trujillo and Paul K. Legaard, Woodcock Washburn Kurtz Mackiewicz & Norris LLP.

TIME PERIOD A (Cannot be moved)	<b>25 May 2001</b>
Filing motion for no interference-in-fact	
TIME PERIOD B (Cannot be moved later)	<b>15 June 2001</b>
Filing preliminary statements	
TIME PERIOD 1 (Cannot be moved earlier)	<b>29 June 2001</b>
Filing preliminary motions	
TIME PERIOD 2	
Filing Rule 633(i) and	<b>27 July 2001</b>
Rule 633(j) preliminary motions	
TIME PERIOD 3	<b>31 August 2001</b>
Filing of oppositions to all preliminary motions	
TIME PERIOD 4	<b>5 October 2001</b>
Filing of replies	

TIME PERIOD 5

Filing of request for hearing; motions to suppress and observations with respect to cross-examination

**9 November  
2001**

TIME PERIOD 6

Filing of oppositions to motions to suppress and any response to observations with respect to cross-examination

**7 December  
2001**

TIME PERIOD 7

Filing replies to oppositions to motions to suppress

**25 January  
2002**

TIME PERIOD 8

Filing the record

**31 January  
2002**

1. The Board may, of course, reach other issues that have been fully developed even though no interfering subject matter remains. E.g., *Wu v. Wang*, 129 F.3d 1237, 1242, 44 USPQ2d 1641, 1645 (Fed. Cir. 1997).
2. This order is not intended to impugn Lewis' motives for initiating this interference. There are, of course, many legitimate reasons to provoke an interference.
3. This order is not the place to resolve whether such briefing creates a "sweat equity" in having those issues resolved despite the lack of an underlying interference.
4. Nor should the United States Patent and Trademark Office blindly administer its proceedings such that it always resolves issues (for instance, the patentability of Lewis' application claims) in an interference, arguably its most expensive proceeding, when such issues can often more cost-effectively be resolved in other proceedings.