STATEMENT ON BEHALF OF DIVISION 14
PATENT, TRADEMARK AND COPYRIGHT LAW
DISTRICT OF COLUMBIA BAR* REGARDING
THE PROPOSED PATENT AND TRADEMARK OFFICE RULE
CONCERNING ARBITRATION OF PATENT INTERFERENCE CASES

To the Commissioner of Patents and Trademarks

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*MANDATORY DISCLAIMER

The views expressed herein represent only those of Division 14 (Patent, Trademark and Copyright Law) of the District of Columbia Bar and not those of the D.C. Bar or of its Board of Governors.

To the Board of Governors and Division Chairpersons:

Summary of the Statement on Behalf of Division 14,
Patent, Trademark and Copyright Law,
Regarding the Proposed Patent and Trademark Office
Rules Concerning Arbitration of Patent Interference Cases

Attached hereto is the statement of Division 14 (Patent, Trademark and Copyright Law) recommending modifications in the above-captioned proposed rules. Specifically, proposed 37 C.F.R. 1.690(d) provides little useful guidance regarding the scope of issues that can be decided in an arbitration of a patent interference. Division 14 recommends amending the rule to provide useful guidance to the bar and to make explicit what we believe to be the Office's intent.

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Division 14 (Patent, Trademark, and Copyright Law) of the District of Colubmia Bar submits the following comment in response to the advance notice of proposed rulemaking concerning arbitration of patent interference cases.

Proposed 37 CFR 1.690, "Arbitration of Interferences," provides very little guidance beyond that already found in 35 USC 135(d). This is in sharp contrast to the recently adopted new rules for patent interferences before the Board of Appeals and Patent Interferences, which provide a great deal of useful guidance lacking in the old rules.

In particular, proposed 37 CFR 1.690(d) merely states broadly that "An arbitration award shall not preclude the Office from determining patentability of any invention involved in the interference." This critical portion of the proposed rule adds little or nothing to the statutory language, which is that "Nothing in this subsection shall preclude the Commissioner from determining patentability of the invention involved in the interference."

In order to provide useful guidance to the bar, and in order to make explicit what we believe (but are not sure) to be the Office's intent with respect to 37 CFR 1.690(d), we propose that it be changed to read as follows:

(d) **Unless otherwise ordered by an examiner-in-chief, an arbitration award shall not decide:**

(i) a motion for judgment on the ground that an opponent's claim corresponding to a count is not patentable to an opponent;

(ii) a motion for judgment on the ground that there is no interference-in-fact;

(iii) a motion to redefine the interfering subject matter by (1) adding or substituting a count, (2) amending an application claim corresponding to a count or adding a claim in the moving party's application to be designated to correspond to a count;

(iv) a motion to substitute a different application owned by a party for an application involved in the interference; or

(v) a motion to declare an additional interference (1) between an additional application not involved in the interference and owned by a party and an opponent's application or patent involved in the interference.

We believe that the motions listed in subparagraphs (i) through (v) present the issues which the Office in fact does not intend to be decided conclusively by arbitration, since they are patentability issues which potentially effect parties not party to the interference, and it would be useful to so state. If, on the other hand, the Office either (1) does intend some of these issues to be decided conclusively by arbitration or (2) does not intend to permit other issues to be decided conclusively by arbitration, it would also be extremely useful to so state in the rule.

It should be noted that the proposed new paragraph (d) begins "Unless otherwise ordered by an examiner-in-chief." This is to reflect Judge Davis's suggestion at the conference on practice under the new interference rules that there may be situations where the examiner-in-chief would like to have the benefit of the arbitrator's views concerning the patentability issues listed in the proposed new paragraph (d) even though the arbitrator's views would not be binding on the examiner-in-chief.

Statement/2005
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