

New Standing Order (March 8, 2011)
Summary of Revisions

A. Main Revisions:

¶ 8.2 – Related Proceedings

Within fourteen (14) days of the initiation of a contested case, each party must file and serve as a separate paper a notice identifying the application or patent number of every United States application or patent claiming, or which may claim, the benefit of priority of the filing date of the party's involved patent or application. If there are no such applications or patents the notice must state this fact. If, during the course of the proceeding, a party files an application claiming, or which may claim, the benefit of the filing date of an involved application or patent, a notice of the filing, including the application number, must be promptly served and filed. ~~The Board may order a party to serve on an opponent a copy of any application or patent identified under this paragraph.~~

¶ 10.1 – Default mode – Interference Web Portal

[Instructions for electronic filing were deleted and replaced by instructions for filing through the web portal. Facsimile filing instructions were also deleted. Within 10 days from the date of a declaration, each party must email to the BoxInterferences@uspto.gov the name of counsel, registration number, and email address associated with each counsel].

¶ 10.3 – Hand filing and boxes

[Instructions for hand-filing were revised so that both papers and boxes are now being deposited at the same place, i.e., Room 9B55-A of Madison East Building].

¶ 12 – Citation of authority

[No need to submit a copy of authority posted on the Board's website; requirement for parallel citation was deleted].

¶ 105.2.1 – Time to file

A paper must be filed no later than 5:00 p.m. (Eastern Time, SO ¶ 100.2) on the day the paper is due. The parties may stipulate to a time no later than 5:00 p.m. Pacific Time.

¶ 105.3 – Service

[Papers filed through the web portal are considered served and they may additionally be served via e-mail. Time for service but be no later than 6:00 pm Eastern Time, and the parties may stipulate to a time no later than 6:00 pm Pacific Time].

¶ 105.5.1 – Papers other than exhibits

A paper other than an exhibit must be signed using an S-signature (*see* 37 C.F.R. §

1.4(d)(2)). ~~Board papers will only be signed using an S-signature.~~

¶ 105.6 – Exhibits

An exhibit with a handwritten signature in the exhibit must be scanned to preserve the appearance of the signature even if other portions of the exhibit are converted to a text-searchable format. An affidavit must have an original signature. The signed original need not be filed, but must be retained and available on demand.

¶ 106.4.3 – Papers served but not filed

[For papers being served but not filed (such as objections to evidence, notices requesting cross-examination...), time for service must be no later than 5:00 pm Eastern Time or 5:00 pm Pacific Time by stipulation].

¶ 120 – Types of notices of basis for requesting relief

The principal types of notices under Bd.R. 120 in interferences are priority statements and motions lists. More detail is provided in Bd.R. 204 and SO ¶ 204. ~~The Trial Procedures Section will be more flexible in accepting changes in the motions list than in the priority statement; however, the practice under Bd.R. 120 is intended to be more rigorous than it was prior to the adoption of the current rules on 13 September 2004. An accurate motions list is necessary to provide the Board and the opposing parties adequate notice to plan for the proceeding. Facially inadequate motions lists can no longer be cured by filing whatever motion a party may please whether it was listed or not.~~

¶ 121.2 – Page limits in motions

[25 pages (substantive)/15 pages (miscellaneous)/50 pages (priority) including the required SOF].

¶ 122.2.1 – Opposition

[25 pages (substantive)/15 pages (miscellaneous)/50 pages (priority) including the required SOF (but not include the listing of facts identified in corresponding motion and responses thereof)].

¶ 122.2.2 – Reply

[10 pages (substantive)/5 pages (miscellaneous)/15 pages (priority) including the required SOF (but not include the listing of facts identified in corresponding motion and opposition and responses thereof)].

¶ 121.4.1 and ¶ 122.3.3 – References to Facts [Newly added]

[References to Facts in body of a motion, opposition, or reply must also include cites to the underlying evidence].

¶ 122.5 – New issues in replies

A reply that raises a new issue ~~or belatedly presents evidence~~ will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply. ~~Examples of indications that a new issue has been raised in a reply include —~~

~~# new evidence that is necessary to make out a prima facie case for the relief requested in the motion, # new evidence that could have been included with the motion, and # a reply that is longer than the corresponding motion or opposition.~~

¶ 122.6 – Declaration evidence in support of a reply [Newly added]

Unless authorized by the Board, declaration evidence shall not be submitted with a reply. Authorization may be obtained through a conference call. Depending on the nature of a particular request, a motion in limine may be authorized to resolve any question of whether reply declaration testimony is appropriate.

¶ 123.2 – Recording conference calls

[If there is a court reporter on a call, the Board must be informed at the outset of the call].

¶ 124.3 – Demonstrative exhibits

[Demonstrative exhibit must be filed through web portal and a copy of the exhibit must be provided to each of the judges at the oral argument].

¶ 124.4 – Transcript of oral argument

[The Board will provide transcription service for oral argument].

¶ 126 – Settlement discussions required

[Settlement discussions are required after 3 month of the declaration, then 10 days after filing date of responsive motion, and 2 months after a panel decision on substantive motions. No need to have a call to report, but a settlement discussion statement must be filed. If needed, a call can be requested in lieu of filing a statement].

¶ 150.2 – Requesting additional discovery

Discovery before the Board is significantly different than discovery under the Federal Rules of Civil Procedure. A request for additional discovery must be in the form of a miscellaneous motion. Bd.R. 121(a)(3); SO ¶ 123. The standard for granting such requests is high and requires specific bases for expecting that the discovery will be productive. Bd.R. 150(a) & (c)(1). Additional discovery is rarely authorized because in contested cases, the party usually has equal or better access to relevant information compared to any other source. ~~Additional discovery is most commonly authorized in the context of cross examination. Bd.R. 150(e)(2).~~ Other situations in which additional discovery might be required include proving an on-sale or public-use bar and proving inequitable conduct intent, but these situations require a solid basis for believing the discovery will be productive.

¶ 151 – Challenging admissibility

As with other procedural remedies, a party may seek to prevent the entry of evidence (motion in limine) or to exclude submitted evidence by filing a miscellaneous motion. See Bd.R. 121(a)(3); SO ¶¶ 123 & 155. Motions to exclude are presumptively opposed. Where a timely objection was made to the evidence (See BR 155(a) and (b)(1)), no further authorization is required to file the motion.

¶ 155.1.4 – Filing supplemental evidence

[Supplemental evidence must be served but not filed until it is used as an exhibit. However, a notice of service of the supplemental evidence must be filed].

¶ 155.2.2 – Content [of a motion to exclude evidence]

[A motion to exclude evidence must be limited to explaining why the evidence is not admissible (*e.g.*, relevance or hearsay). It's not a place to challenge the sufficiency of the evidence to prove a particular fact].

¶ 205.1.1 – Filing of Settlement Agreement [Newly added]

[Settlement agreement can be requested to be kept separately from the interference file. When such a request is made, the agreement will not be filed through the web portal, but shall be emailed to BoxInterferences@uspto.gov].

¶ 208.1 – Obviousness

[When proving subject matter is not obvious, a party may be able to satisfy its burden of production with testimony from a knowledgeable witness certifying that there is no known prior art that would have overcome the differences between the subject matter of the count and the subject matter of the claim and that the differences were not merely routine or conventional in the art].

¶ 208.5.1 – Adding a claim

[If a claim is added to overcome a patentability problem raised in a motion, the motion to add the claim must explain why the proposed claim would overcome the problem, including why there would still be an interference-in-fact].

B. Main Deletions:

~~**¶ 121.6 Claim chart alternative**~~

~~As an alternative to a claim chart, a party may reproduce the complete claim in an appendix. Following each limitation in the claim, and within braces { }, insert in bold a specific citation to the information to be compared to the limitation (such as where a prior art reference describes the limitation). Braces { } must be used instead of brackets [] because brackets are used to indicate amended portions of claims in reissue applications.~~

~~**¶ 200.1 Patent claim scope**~~

~~Every claim before the Board, including a patent claim, is given the broadest reasonable scope consistent with the disclosure with which the claim appears.~~

~~**¶ 208.6 Priority**~~

~~[Example of a diligence chart was deleted].~~

C. The following paragraphs were deleted:

~~¶ 2.1 – Trial Division~~

- ¶ 2.2 – Trial Procedures Section
- ¶ 2.3 – Trial Merits Section
- ¶ 10.6 – Facsimile
- ¶ 12.2 – Parallel citation
- ¶ 105.2.3 – Papers as an attachment no greater than 1 megabyte
- ¶ 105.2.4 – Sender
- ¶ 105.2.5 – Papers larger than 1 megabyte; collections of exhibits
- ¶ 105.3.1 – Simultaneous filing and service
- ¶ 105.4.1 – Portable document format required
- ¶ 121.6 – Claim chart alternative
- ¶ 124.3 – Security; access
- ¶ 200.1 – Patent claim scope

D. The following paragraphs were added:

- ¶ 2.1 – Administrative Patent Judges
- ¶ 121.4.1 – References to Facts
- ¶ 122.6 – Declaration evidence in support of a reply
- ¶ 205.1.1 – Filing of Settlement Agreement