

count, each count must describe a patentably distinct invention.

*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 where the applicant suggested, or could have suggested, an interference under § 41.202(a).

#### § 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, propose one or more counts, and show how the claims 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 a constructive reduction to practice within the scope of the interfering subject matter.

(b) *Patentee*. A patentee cannot suggest an interference under this section but may, to the extent permitted under § 1.99 and § 1.291 of this title, alert the examiner of an application claiming interfering subject matter to the possibility of an 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. If the interference would be with a patent, the applicant must also comply with paragraphs (a)(2) through (a)(6) of this section. 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*. (1) A showing of priority under this section is not sufficient unless it would, if un rebutted, support a determination of priority in favor of the party making the showing.

(2) When testimony or production necessary to show priority is not available without authorization under § 41.150(c) or § 41.156(a), the showing shall include:

(i) Any necessary interrogatory, request for admission, request for production, or deposition request, and

(ii) A detailed proffer of what the response to the interrogatory or request would be expected to be and an explanation of the relevance of the response to the question of priority.

#### § 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) 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) of this part.

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

(a) *Priority statement.* (1) A party may not submit evidence of its priority in addition to its accorded benefit unless it files a statement setting forth all bases on which the party intends to establish its entitlement to judgment on priority.

(2) The priority statement must:

(i) State the date and location of the party's earliest corroborated conception,

(ii) State the date and location of the party's earliest corroborated actual reduction to practice,

(iii) State the earliest corroborated date on which the party's diligence began, and

(iv) Provide a copy of the earliest document upon which the party will rely to show conception.

(3) If a junior party fails to file a priority statement overcoming a senior party's accorded benefit, judgment shall be entered against the junior party absent a showing of good cause.

(b) *Other substantive motions.* The Board may require a party to list the motions it intends to file, including sufficient detail to place the Board and the opponent on notice of the precise relief sought.

(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 of the interference between the parties to the agreement. After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had. If an appeal to the U.S. Court of Appeals for the Federal Circuit (under 35 U.S.C. 141) or a civil action (under 35 U.S.C. 146) has been filed the interference is considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

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