

THE EFFECT OF THE INTERFERENCE RULE REVISIONS ENACTED IN RESPONSE TO NAFTA AND GATT

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I. INTRODUCTION

On December 8, 1993, 35 U.S.C. § 104 [n.1] was amended to provide that the date of invention could be proved by reliance on activities occurring in countries that are bound by the North American Free Trade Agreement (NAFTA). [n.2] On September 27, 1994, Congress passed the General Agreement on Tariffs and Trade (GATT) which becomes effective on January 1, 1996. To implement GATT, § 104 has been further amended to provide that the date of a claimed invention in a patent application filed on or after January 1, 1996, can be proved by reliance on activities occurring not just in the United States, Canada and Mexico, but also on activities occurring in any World Trade Organization (WTO) member country. [n.3] Consequently, several rules of patent practice, particularly the rules that control the conduct of interferences, have been significantly revised to accommodate the amendments to § 104. [n.4]

Accordingly, this article reviews the revisions to the interference rules and focuses on the effect that these revisions will have on foreign *20 inventors. Although the revisions of the interference rules reviewed by this article and the analysis of the effect of the rule revisions on foreign inventors is presently applicable only to inventive activities in Canada and Mexico, the rule revisions and this analysis will also be applicable after January 1, 1996, to activities occurring in each of the WTO member countries.

In the second part of this article, comments on the evidence or records that can be used in interference proceedings in order to prove the date of invention are provided. The required records will be particularly important for foreign inventors who desire to take advantage of the first-to-invent system of the United States. In addition, practical tips are provided for recording and maintaining complete and accurate records to prove a date of invention.

II. OVERVIEW OF INTERFERENCE PROCEEDINGS

An interference proceeding is conducted by the U.S. Patent and Trademark Office (PTO) to determine priority of invention between two or more parties claiming patentably indistinct subject matter. An interference proceeding can be conducted between two or more patent applicants, or between one or more patent applicants and one or more patentees. In either instance, the PTO attempts to determine which of the parties is the first to invent the patentably indistinct subject matter. The first inventor is generally the first party to conceive of the claimed invention so long as that party was diligent in reducing the invention to practice from a date at least as early as the opposing party's date of conception of the invention.

To declare an interference, the primary Patent Examiner must first determine whether the claims of a pending application "interfere" with the claims of another pending application or an unexpired patent. A general test for whether claims "interfere" is if the claims define the same patentable invention. [n.5] If the Examiner believes that an interference exists, the Board of Patent Appeals and Interferences (the Board) is notified and the interference is assigned to an Administrative Patent Judge who issues a notice declaring the interference. [n.6]

Each separately patentable invention involved in the interference is defined by a "count" [n.7] which, in turn, defines the evidence relevant to the issue of priority, i.e., which party was first to invent the claimed *21 subject matter. A preliminary determination is made by the PTO as to which claims should be designated as corresponding to the count. [n.8] Claims that are initially determined to define the same patentable invention are designated as corresponding to the same count; all other claims are designated as not corresponding to the count.

Once the counts have been defined, the respective parties attempt to prove their date of invention and to investigate the other party's claimed date of invention by submitting evidence in their respective case-in-chief and case-in-rebuttal periods. Based on the submitted evidence, the Board will determine the parties' respective dates of invention, and, consequently, the priority of invention of the parties such that the party that was the first to invent is awarded the patent for the subject matter defined by the claims in question.

III. REVISIONS TO THE INTERFERENCE RULES

In response to the amendments of § 104, which now provides that the date of invention can be proved by reliance on activities occurring in any NAFTA country, and, for applications filed on or after January 1, 1996, on activities occurring in any WTO member country, a number of amendments were made to the interference rules. [n.9] These revisions range from substantive changes relating to the type of evidence and the manner in which it is presented, to clarifying and housekeeping amendments. [n.10] While the revisions of substance are discussed in detail below, the housekeeping amendments are not, for the most part, discussed in this article.

We have categorized the revisions of substance as: (A) revisions that have particular significance to foreign inventors or foreign activities; (B) significant procedural rule revisions; and (C) other revisions of substance. Each category of revision will be separately discussed below.

*22 A. Revisions of Particular Significance for Foreign Inventors or Relating to Foreign Activities

Rule 616 [n.11] outlines the sanctions that the Board can levy during an interference proceeding. As a result of the NAFTA and GATT, Rule 616 was amended to provide the Board with more severe penalties to enforce the Board's orders. In particular, the revisions provide that if any information is under the control of an individual or entity in a NAFTA or WTO country concerning the knowledge, use, or other activity related to proving or disproving a date of invention and has been ordered to be produced by the Board, but has not been produced to the same extent as if such information was in the United States, the Administrative Patent Judge or the Board shall draw any appropriate adverse inferences or take other actions as deemed necessary.

Thus, the Administrative Patent Judge or the Board would have little discretion if a party does not comply with an order to produce information located in a NAFTA or WTO country. Instead, the Administrative Patent Judge or the Board must draw the appropriate adverse inferences and may take other necessary actions.

The revisions to Rule 616 also require a party who relies upon a document, or a party which is ordered to produce a document, to file a translation of the document in English if the document is in another language. In addition, an affidavit attesting to the accuracy of the translation must be filed along with the document. Thus, documents located in Mexico, for example, which are in Spanish, must be translated into English and filed along with a verifying affidavit with the PTO in order for a party to rely upon the document.

The interference rule revisions appear to favor testimony or the production of documents and things in the United States. However, if certain conditions are met, the revisions provide for the compulsion of testimony and the production of documents in a foreign country. In particular, testimony can be compelled in a foreign country if the moving party demonstrates "that the witness has been asked to testify in the United States and has refused to do so even though the party has offered to pay the expenses of the witness to travel to the United States." [n.12] Likewise, the production of a document can be compelled in a foreign country if the moving party demonstrates "that the individual or entity having possession, custody or control of the document or thing will not produce the document or thing in the United States even though the *23 party has offered to pay the expenses of producing the document or thing in the United States." [n.13] Accordingly, the moving party must have offered to have paid the reasonable travel expenses of a foreign witness or the related expenses of producing documents located in a foreign country prior to moving to compel the testimony or the production of documents.

Even though the rule revisions provide for the compulsion of testimony and the production of documents in a foreign country, the weight that the Administrative Patent Judge or the Board will assign to the testimony taken in the foreign country is limited. In particular, the rule revisions provide that the weight to be given testimony taken in a foreign country will be determined on a case-by-case basis. However, the revisions specifically state that little, if any, weight may be given to testimony taken in the foreign country unless the party taking the testimony proves by clear and convincing evidence: (1) that giving false testimony in an interference proceeding is punishable as perjury under the laws of the foreign country where the testimony is taken, and (2) that the punishment in the foreign country for giving such false testimony is similar to or greater than the punishment for perjury committed in the United States.

Thus, if the testimony taken in a foreign country is to be given any significant weight, the party taking the testimony must clear several hurdles. The party must prove by clear and convincing evidence that the punishment for perjury under the laws of the foreign country, and, more specifically, the punishment for perjury in interference proceedings, is similar to the punishment provided for perjury in the United States. In particular, the penalties for perjury in an interference proceeding, like any civil or criminal proceeding, can include fines of up to \$10,000, imprisonment for up to five years, or both. [n.14] Thus, the testimony in foreign countries must at least be taken in accordance with a penal code that provides for fines or imprisonment or both as a penalty for perjury, and may not simply be taken by agreement between the parties. Accordingly, parties are likely to continue to attempt to obtain testimony in the United States, even of foreign witnesses for whom the parties must pay the reasonable travel expenses, since the perjury standards and resulting penalties are unclear in many foreign countries.

The revision to Rule 672 [n.15] provides that a party noticing a deposition shall be responsible for providing a translator if the deponent does not testify in English. In addition, the party noticing the deposition *24 must also obtain a court reporter and file a certified transcript of the deposition. However, the rule revisions do not address and, therefore, apparently do not restrict the party defending the deposition from obtaining their own translator to ensure that the translation provided by the opposing party's translator is complete and accurate.

Finally, the revision to Rule 673 [n.16] requires a party that requests cross-examination of an affiant to notice a deposition at a reasonable location in the United States. If the parties wish to conduct the deposition at any place outside the United States, the parties must obtain the approval of the Administrative Patent Judge. Further, re-direct and recross of the affiant must be conducted at the noticed deposition, thereby reducing the inconvenience to the deponent.

As the rule revisions illustrate, testimony and documents can be relied upon in an interference proceeding even if the witnesses and documents are located in a foreign country. However, the weight accorded to the testimony and documents and the ease of using the evidence in the interference appear to be significantly enhanced if the testimony

is obtained in the United States. The party seeking to obtain the testimony or the production of the documents must be prepared to pay for the reasonable travel expenses for the witness or for the reasonable expenses of production in order to obtain the requested evidence. The rule revisions also toughen the penalties available to the Administrative Patent Judge or the Board in order to further encourage parties to comply with the Board's orders, such as orders compelling the production of documents.

B. Significant Procedural Rule Revisions

A number of other procedural rule revisions have been made which would produce substantive changes in interference proceedings. For example, in addition to the adverse inferences that an Administrative Patent Judge or the Board must infer for noncompliance with the Board's order to produce documents located in the foreign country, the revisions to Rule 616 also provide that an Administrative Patent Judge can award sanctions for failure to comply with the rules or for taking or maintaining a frivolous position. The sanctions can include compensatory expenses or compensatory attorney fees, or both.

In addition, Rule 640 [n.17] has been amended to provide that the Administrative Patent Judge shall defer decisions on preliminary motions *25 until the final hearing unless the Administrative Patent Judge determines that the decision would materially advance the resolution of the interference. Prior to its enactment, this revision drew much criticism during the public hearings since it appears to sharply limit the summary relief available to parties in an interference proceeding. Since interference proceedings are often costly and time consuming to all parties, it was argued at the public hearings that summary relief should be available and encouraged in appropriate circumstances in order to dispense with portions, if not all, of an interference.

In addition, the revisions to Rule 640 provide that a matter raised by a party in support of or in opposition to a preliminary motion that is deferred to final hearing will not be entitled to consideration at the final hearing unless the matter is raised in the party's brief at the final hearing. Thus, merely because a matter raised by a party in a preliminary motion is deferred until the final hearing does not mean that the matter will be automatically considered at the final hearing. Instead, the matter must again be raised in the party's brief at the final hearing. In particular, the rule revisions provide that if the interference proceeds to a final hearing on the issue of priority or derivation, a time will be set for each party to file a paper identifying any deferred decisions on motions or on matters raised sua sponte (for the first time) by the Administrative Patent Judge, that the party wishes to have considered at the final hearing. By requiring the parties to specify which of the motions or matters that had been deferred to the final hearing should be ruled on, the Administrative Patent Judge and the Board are attempting to avoid considering matters rendered moot by the course of the interference proceeding.

It is also noted that the rule revisions provide that any evidence that a party wishes to have considered with respect to the deferred motions at the final hearing shall be served on the opponent during the testimony-in-chief of the party. Accordingly, the party cannot

wait until rebuttal, the final hearing or until submitting its brief for the final hearing to attach or submit the evidence in support of the deferred motions, but must serve the evidence during their testimony-in-chief period.

In addition, the revisions to Rule 672 require that all testimony, except cross-examination and compelled testimony, will be taken by affidavit, and not by oral deposition. The revisions to Rule 672 also provide that any objections to the admissibility of the evidence contained in or submitted with the affidavit must be filed with the PTO no later than a date set by the Administrative Patent Judge. However, compelled testimony will still be taken by oral deposition. If any party requests cross-examination of an affiant, however, the requesting party shall notice a deposition at a reasonable location within the United States.

*26 C. Other Rule Revisions

Several additional procedural rule revisions have been enacted that formally state existing interference law. For example, the definition of a count has been revised to provide that the count should be broad enough to encompass the broadest corresponding patentable claim of each of the parties, but should not be so broad as to be unpatentable over the prior art. In addition, Rule 609 [n.18] has been amended to state that during the initial stages of an interference, the Examiner must not only list the claims that correspond to each count, but must also explain why each claim designated as corresponding to a count is directed to the same patentable invention as another claim. Likewise, Rule 609 requires that the Examiner must also list the claims that do not correspond to the count and must also explain why each claim designated as not corresponding to each count is not directed to the same patentable invention as the count. The Examiner's explanations as to why certain claims may conflict with certain counts can be used to support a party's motion to strike or add claims.

The rule revisions also specifically overrule *In re Spina*. [n.19] Here, the court held that an ambiguous claim copied from a patent for purposes of instigating an interference would be construed in light of the disclosure of the patent from which it was copied. In contrast, the revisions to Rule 633 [n.20] provide that, in considering a motion for judgment against an opponent's claim on the ground that the claim is not patentable by the opponent, the claim will be construed in light of the specification of the opponent's application or patent. Accordingly, a claim, such as a claim that has been copied for purposes of invoking an interference, will be construed in light of the specification of the application or patent in which the claim appears, and not from the application or patent from which the claim was copied.

As a further response to existing case law, the revisions to Rule 633 provide that when claims are presented in "means plus function" format, it may be possible for the opponents' claims in an interference proceeding to define different patentable inventions even though the claims contain the same literal wording. As noted in the comments to the rule provisions provided by the PTO, this rule revision was drafted in response to *In re*

Donaldson Co., [n.21] which provided that "means plus *27 function" claim language is to be interpreted as covering the corresponding structure provided in the specification and equivalents thereof.

In addition, the revisions to Rule 637 [n.22] provide that if a party files a preliminary motion alleging unpatentability of an opponent's claimed invention over the prior art, and if the dates of the cited prior art are such that the prior art appears to be applicable to the movant, it will now be presumed that the cited prior art is applicable to the movant. In particular, this presumption applies without regard to the date of invention alleged in the preliminary statement of the movant. In order to preclude this presumption, the movant must include, with the motion, an explanation and appropriate evidence as to why the prior art is inapplicable. If the motion fails to include a sufficient explanation or to contain appropriate evidence, the movant will not be permitted to later rely on any such explanation or evidence in the interference. Thus, the movant must be particularly careful when alleging unpatentability of its opponent's claims. The movant must provide an explanation and sufficient evidence as to why that prior art does not apply to the movant so as not to be later precluded from using such evidence to establish their date of invention.

Finally, the revisions to Rule 657 [n.23] provide that a rebuttable presumption shall exist that the inventors made their inventions in the chronological order of their effective filing dates and that the burden of proof shall be upon a party who contends otherwise. This revision also merely formalizes the existing case law. The revisions continue to provide that in an interference involving co-pending applications or an interference involving a patent and an application having an effective filing date on or before the date that the patent issued, the junior (later) party shall have the burden of establishing priority by a preponderance of the evidence. Alternatively, in an interference proceeding involving an application and a patent in which the effective filing date of the application is after the date on which the patent issued, the junior party shall have the burden of establishing priority by clear and convincing evidence (a higher standard than preponderance of evidence). Accordingly, the junior party's burden increases significantly if their effective filing date is after the date of issuance of the senior party's patent.

*28 IV. RECORD KEEPING

For a party to establish its date of invention, the party must submit evidence during its testimony-in-chief and testimony-in-rebuttal periods that demonstrates that it was the first to invent the invention as defined by the count. As described above, § 104 of the patent statute has been amended to provide that this evidence can pertain, not only to activities in the United States, but to activities in any NAFTA (as of January 1, 1994) or WTO member country (as of January 1, 1996).

Regardless of the location of the activity, it is imperative that parties to an interference record their inventive activities and maintain those records in a manner that allows the

records to be produced and relied upon in an interference proceeding, thereby proving the party's date of invention. While such record keeping is essential for every party to an interference, regardless of their nationality, foreign inventors should pay particular attention since the importance of records increases tremendously in the United States' first-to-invent system which awards patent rights not upon the respective filing dates of the party's patent application in its home country, but rather upon the order in which the parties invented the claimed subject matter.

A. Particularly Important Events Which Should be Recorded

While records can be introduced in interference proceedings for a number of purposes and to support a number of contentions, there are several key events that substantiating records should establish in order to thereby prove the party's date of invention. In particular, the records should substantiate the party's conception and reduction to practice of the claimed invention, as well as the party's diligence in reducing the conceived invention to practice.

Conception is typically defined as the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention as it is to thereafter be applied in practice. More particularly, conception has been defined as:

[T]he complete performance of the mental part of the inventive act. All that remains to be accomplished, in order to perfect the act or instrument, belongs to the department of construction, not invention. It is therefore the formation, in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is *29 thereafter to be applied in practice, that constitutes an available conception, within the patent law. [n.24]

Following conception, the inventor can reduce the invention to practice in one of two manners, namely, constructive and actual reduction to practice. In particular, a constructive reduction to practice occurs when a patent application is filed. [n.25] Alternatively, an actual reduction to practice occurs when the inventor constructs a product or performs a process that includes every essential limitation of the invention as defined by the claim and demonstrates that the invention can achieve its intended purposes. [n.26]

In addition, 35 U.S.C. § 102(g) [n.27] requires that a party who is first to conceive, but last to reduce an invention to practice, must prove that they were diligent from a time immediately preceding a second party's conception of the invention. This diligence can include not only the activities of the inventor, but also the activities of a patent attorney in preparing and filing a patent application directed to the claimed invention.

An inventor's proof of date of conception and reduction to practice as well as the inventor's diligence in reducing the conceived invention to practice must be corroborated. That is, evidence independent of the inventor, must corroborate the inventor's story with respect to date of conception and reduction to practice and the acts of diligence.

Corroboration is subject to a "rule of reason," however, which provides that all pertinent evidence, including records, which corroborate the inventor's activities should be evaluated. [n.28]

B. Practical Record Keeping Advice

In order to record and maintain sufficient corroborating records to prove the party's dates of conception and reduction to practice and *30 the party's diligence in reducing the conceived invention to practice, thorough records should be recorded and maintained. Although various types of records can be recorded and maintained, the following discussion describes practical tips for recording and maintaining accurate records.

First, all records should be signed and dated by the inventor and by at least one, preferably two witnesses. The witnesses should understand the disclosure provided by the record that they are witnessing, but should not be a co-inventor of the disclosed technology and should not have participated in any of the recorded experiments.

To provide a convenient record for their research, a number of companies provide laboratory notebooks to their research personnel. These notebooks generally include consecutively numbered pages on which the research personnel record their various activities. These entries should be made daily in permanent ink and should be dated and witnessed as described above. In addition, no erasures should be made in the laboratory notebooks and all related materials should be clearly cross-referenced in laboratory notebooks for future reference. Once the laboratory notebooks have been completed, the company should provide a secure archival system for maintaining the completed laboratory notebooks in an orderly fashion.

In addition to handwritten notations, photographs, and computer printouts, other evidence can be employed to prove the date of an invention. These types of evidence should also be signed and dated by the inventor and several witnesses. In addition, an explanation of the relevance of the photograph or computer printout should be provided, such as in the inventor's laboratory notebook with appropriate cross-referencing to the photograph or computer printout such that the significance of the photograph or computer printout can later be readily determined.

In recording their activities or efforts, inventors should accurately record their experiments, but should avoid categorical statements regarding the worthlessness or lack of utility of a product or process, since these statements may be used in the future as evidence of the inventor's lack of appreciation of the work performed. [n.29] Instead, unsuccessful experiments should be recorded in precise and factual statements with little editorializing.

In addition, although written records, including photographs and computer printouts, are the principal types of records relied upon to prove the date of invention in an interference proceeding, it is recognized that much modern record keeping is maintained on computer

systems. *31 Still, it is strongly recommended that records of the key dates and activities in an invention process, such as the dates of conception and reduction to practice and the acts of diligence in reducing the conceived idea to practice, should be maintained in conventional written records as described above and, if desired, supplemented by computer records.

If computer records are maintained, several steps should be taken to ensure that the computer records meet the established evidentiary standards. [n.30] In particular, the computer records should be accurately and contemporaneously entered and stored by the computer system. Thus, the party submitting the computer records may also be required to submit evidence establishing the accuracy of computer record entry. Such evidence can include evidence of the experience and training of the computer operators. In addition, the party submitting the computer records may have to also provide evidence establishing the time frame in which the records were entered in the computer following the actual events. Typically, the less time that elapses between the actual event and the entry of the records in the computer provides for additional weight to be given the records since there is also less time for mental lapses or other errors.

Once entered, the computer records should be securely protected against loss or revision, either intentionally or unintentionally. Accordingly, evidence may be submitted regarding the protection of computerized data, including the computer security system and any back up methods. The computer security system can include, for example, the user's passwords and any associated security classifications for removing the access of former employees to the computer system. In addition, evidence may be required which explains the procedure by which a computer revises an existing record. For example, certain types of modern computer software allow records to be revised, but still maintain the original document in its unmodified form in another file for archival purposes.

In any event, care should be taken to ensure that the entry of computer records is witnessed, if possible, to provide the necessary corroboration of the records. Alternatively, the computer records can be entered by a witness of the inventive acts and may, therefore, serve as corroboration under the rule of reason for other evidence provided by the inventor regarding date of invention.

Although the integrity of the computerized records can be increased as described above, all important computerized records should be *32 printed. Those printed records should then be signed, dated and witnessed to serve as a written record of the events. In addition, the relevance of such computer records should be provided, such as in a laboratory notebook, in which the computer records are referenced and their relevance explained.

By consistently taking and maintaining records throughout the invention process, a party, including a foreign party, will be able to substantiate their claimed date of invention in an interference proceeding. In particular, the rule revisions allow such evidence to be relied upon even though such written records are maintained in a NAFTA or a WTO member country.

V. CONCLUSIONS

In response to NAFTA and GATT, the patent rules, and, in particular, the interference rules have been significantly revised to allow testimony and documents to be relied upon to prove the date of invention even though they relate to inventive activities in foreign countries. To ensure that foreign witnesses and evidence are available to the parties, the ability of the Administrative Patent Judge or the Board to compel and enforce its orders has been expanded by the patent rule amendments. In addition, since the date of invention can be proved by activities or records located in the NAFTA countries (presently) and WTO member countries (after January 1, 1996), foreign inventors must begin to accurately take and maintain records of their inventive process, i.e., their conception, reduction to practice, and diligence, to prove their priority of invention and to take advantage of the first-to-invent system of the United States.

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[n.1]. 35 U.S.C. § 104 (1994).

[n.2]. NAFTA countries include: the United States, Mexico, and Canada. Prior to the amendment of § 104, the date of invention could be proved by reliance on activities only if those activities occurred within the United States.

[n.3]. WTO member countries are defined in § 2(10) of the Uruguay Round Agreements Act and include, for example, Japan.

[n.4]. See J. Pegram, U.S. Legislation Implementing Recent International Patent Law Agreements, 4-6 (1994).

[n.5]. See 37 C.F.R. § 1.601(i) (1994).

[n.6]. See 37 C.F.R. §§ 1.609-1.611 (1994).

[n.7]. See 37 C.F.R. § 1.601(f) (1994).

[n.8]. See 37 C.F.R. § 1.611 (1994).

[n.9]. Patent Appeal and Interference Practice, 60 Fed. Reg. 14,488 (1995) (These amendments became effective April 21, 1995).

[n.10]. One such clarifying revision has changed the title of the Patent Examiner charged with conducting the interference from Examiner-in-Chief to Administrative Patent Judge.

[n.11]. 37 C.F.R. § 1.616 (1994).

[n.12]. 60 Fed. Reg. 14,488 (1995) (to be codified in 37 C.F.R. § 1.671(h)(1)(iv) (1995)).

[n.13]. 60 Fed. Reg. 14,488 (1995) (to be codified in 37 C.F.R. § 1.671(h)(2)(iii) (1995)).

[n.14]. See 18 U.S.C. § 1001 (1994).

[n.15]. 37 C.F.R. § 1.672 (1994).

[n.16]. 37 C.F.R. § 1.673 (1994).

[n.17]. 37 C.F.R. § 1.640 (1994).

[n.18]. 37 C.F.R. § 1.609 (1994).

[n.19]. 975 F.2d 854, 856, 24 U.S.P.Q.2d (BNA) 1142, 1145 (Fed. Cir. 1992).

[n.20]. 37 C.F.R. § 1.633 (1994).

[n.21]. 16 F.3d 1189, 29 U.S.P.Q.2d (BNA) 1845 (Fed. Cir. 1994).

[n.22]. 37 C.F.R. § 1.637 (1994).

[n.23]. 37 C.F.R. § 1.657 (1994).

[n.24]. *Coleman v. Dines*, 754 F.2d 353, 359, 224 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1985) (emphasis in original)(citing *Mergenthaler v. Scudder*, 11 App. D.C. 264, 267 (D.C. Cir. 1897)).

[n.25]. *Hazeltine Corp. v. U.S.*, 820 F.2d 1190, 1196, 2 U.S.P.Q.2d (BNA) 1744, 1749 (Fed. Cir. 1987).

[n.26]. *Newkirk v. Lulejan*, 825 F.2d 1581, 1582, 3 U.S.P.Q.2d (BNA) 1793, 1794 (Fed. Cir. 1987); *UMC Electronics Co. v. U.S.*, 816 F.2d 647, 2 U.S.P.Q.2d (BNA) 1465 (Fed. Cir. 1987).

[n.27]. 35 U.S.C. § 102(g) (1994).

[n.28]. *Holmwood v. Balasubramanyan Sugavanam*, 948 F.2d 1236, 1238-39, 20 U.S.P.Q.2d (BNA) 1712, 1714 (Fed. Cir. 1991).

[n.29]. R. CALVERT, *THE ENCYCLOPEDIA OF PATENT PRACTICE AND INVENTION MANAGEMENT*, 683-85 (1964).

[n.30]. See COMMITTEE ON PATENTS AND RELATED MATTERS OF THE AMERICAN CHEMICAL SOCIETY, *ELECTRONIC RECORD-KEEPING FOR PATENT PURPOSES, CAUTIONS AND PITFALLS*, 1-3 (1990).