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**FEDERAL CIRCUIT PATENT LAW CASE UPDATE**

**Stevens v. Tamai, 03-1479 (Fed. Cir. May 4, 2004) (Clevenger, J.)**

The court reversed the Board’s grant of priority to Tamai in an interference proceeding. The Board erred in allowing Tamai the benefit of a Japanese application because the Board had ruled that Tamai could not rely on an intervening PCT application. The PCT application linked the chain of priority from the Japanese application to Tamai’s application involved in the interference. Tamai filed neither a copy nor a translation of the PCT application in the interference preliminary motion for priority benefit of an earlier application. Thus, Tamai could not rely on either the PCT application nor the Japanese application to obtain a priority date earlier than Stevens’ date.

Under Rules 637 and 647, a party relying on a non-English document for priority must file “a translation of the document into English and an affidavit attesting to the accuracy of the translation.”

The interference involved Stevens’ patent, and he moved for a priority date of February 10, 1993, based on some European applications. His patent was to a “correction tape dispenser.”

Tamai relied on a Japanese application and a PCT application for his priority motion. However, he failed to supply a copy of the Japanese application (but he provided a translation), and failed to provide a copy and a translation of the PCT application.

The Board gave Tamai the benefit of the Japanese application, but not the PCT application. This caused Tamai himself to raise for reconsideration the following request: “that the Board explain how Tamai is entitled to the benefit of the [Japanese ‘371 application] without the linking PCT application in the chain of priority.” The Board was not receptive to this question. On appeal, Stevens pressed the same point.

The court agreed with Stevens that the Japanese application cannot support Tamai’s priority date without the intervening PCT application. To do so would violate § 119(a)’s one year limit for foreign priority.

Tamai, on appeal, argued that his “motion for benefit was unnecessary, or alternatively that his motion for benefit was sufficient.” The court did not agree with either argument.

Tamai’s argument that a motion for benefit was unnecessary in this interference rests on the premise that a motion for benefit cannot be required for non-English applications where the applicant has satisfied U.S. filing requirements for prosecution purposes.

In its most favorable light, Tamai is stating that there is a conflict between Subpart E—Interferences, 37 C.F.R. §§ 1.601-1.690, which “governs the procedure in patent interferences in the Patent and Trademark Office,” 37 C.F.R. § 1.601, and sections 363 and 371(c)(2) of title 35, as they provide authority for national stage applications.

The conflict Tamai suggests simply does not exist . . . in the context of this case, sections 363 and 371(c)(2), and 37 C.F.R. §§ 1.601-1.690, have little to do with one another.

The court also noted that the relevant interference rules were a permissible exercise of the PTO’s authority.

On his alternative argument, Tamai argued that the translation of the Japanese application was also a translation of the PCT application. The Board was correct in rejecting this because the Japanese translation was never identified as such.