



BoxInterferences@uspto.gov
Telephone: 571-272-4863

Paper 99
Entered: 24 April 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

Patent Interference 105,801 (JL)
Technology Center 2100

C. DOUGLASS **THOMAS** and ALAN E. THOMAS
Junior Party
U.S. Patent 5,752,011

v.

JACK D. PIPPIN
Senior Party
Application 10/464,482

Before: JAMES DONALD SMITH, *Chief Administrative Patent Judge*,
JAMES T. MOORE, *Deputy Chief Administrative Patent Judge*,
FRED E. McKELVEY, JAMESON LEE, SALLY GARDNER LANE,
MICHAEL R. ZECHER and JUSTIN T. ARBES, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

DECISION ON REHEARING
Pippin Miscellaneous Motion 1

1 **Introduction**

2 Thomas seeks rehearing of our decision entered 6 March 2013 (Paper 97)
3 granting-in-part relief requested in Pippin Miscellaneous Motion 1 (Paper 80).
4 37 CFR § 41.125(c). The Pippin Motion sought entry of an order by the PTAB

1 accepting for filing in the interference file a request to convert the involved Pippin
2 application to a SIR (Statutory Invention Registration—35 U.S.C. § 157).

3 The Pippin SIR request accompanied the motion. **Ex 1011.**

4 **Points raised on rehearing**

5 Timeliness of Pippin Miscellaneous Motion 1

6 As Thomas did in the Opposition (Paper 95), in the Rehearing Request
7 Thomas repeats its argument that Pippin Miscellaneous Motion 1 was not timely
8 filed (Paper 98, pages 4-6).

9 Thomas maintains that ¶ 123.2 of our Standing Order requires a movant to
10 explain why a motion is timely. According to Thomas, Pippin made no showing of
11 timeliness. Accordingly, Pippin is said not to have complied with ¶ 123.2.

12 In seeking to file a SIR request, Pippin was seeking to exercise a then
13 available statutory remedy. *See* 35 U.S.C. § 157 (now repealed). Section 157 did
14 not specify a time for filing a SIR. Consistent with § 157 and the fact that filing a
15 SIR request makes sense only during pendency of an application, the Director’s
16 § 157 implementing rule provides that an applicant “may request [conversion of an
17 application to a SIR], at any time during the pendency of [its] . . . application”.
18 37 CFR § 1.293 (Rule 293). Nothing in Rule 293 provides that an applicant
19 involved in an interference cannot file a SIR request after entry of a judgment in
20 the interference. Nor is there any provision of § 157 or Rule 293 which prohibits
21 filing a SIR request after an appeal from a final judgment in an interference. It is
22 true that no action by the USPTO on the Pippin SIR request can take place until
23 after the Director receives a Federal Circuit mandate. However, an inability of the
24 USPTO to act on the Pippin SIR request pending receipt of a mandate does not
25 mean the SIR request was not timely filed.

26 Pippin had a right under § 157 and Rule 293 to file its SIR request when it
27 did; accordingly, the excusable neglect provisions of 37 CFR §41.4(b)(2) do not

1 apply. Further, assuming *arguendo* that excusable neglect is a consideration, we
2 would be inclined to invoke the interest of justice exception and hold that it is in
3 the interest of justice to permit the filing, particularly because a SIR request could
4 not have been filed after 16 March 2013.

5 Thomas seemingly is concerned with Pippin’s motive in filing its SIR
6 request when it did and argues that the motive is relevant to timeliness. Nothing in
7 § 157 or Rule 293 requires an applicant to state the “reason” a SIR request is filed.
8 In our view, Pippin’s motive for filing its SIR request is not controlling on any
9 timeliness issue. As motive is not controlling, we see no need for Pippin to justify
10 why a SIR request should have been earlier filed.

11 Permission to file its SIR request

12 According to Thomas, all that Pippin requested in Pippin Miscellaneous
13 Motion 1 was “permission to file” a SIR request. Thomas acknowledges that
14 **Ex 1011** accompanied Pippin Miscellaneous Motion 1. Paper 98, page 7:9-10.
15 But, further according to Thomas, “an exhibit to a motion in an interference
16 proceeding is not a filing of the exhibit itself.” *Id.* at page 7:10-11. Thomas
17 continues, “[t]hus a SIR request has not yet been filed in the interference
18 proceeding or elsewhere.” *Id.* at page 7:11-12.

19 **Ex 1011** is a SIR request. It accompanied Pippin Miscellaneous Motion 1
20 and was filed in the USPTO (albeit in the interference file) when Pippin
21 Miscellaneous Motion 1 was filed. To say that Pippin did not file a SIR request in
22 the USPTO places form over substance. In this case, the Pippin SIR request was
23 properly addressed to, and filed with, the PTAB because the PTAB has jurisdiction
24 over the involved Pippin application.

25 Action on the Pippin SIR request cannot take place at this time. When a
26 Federal Circuit mandate is received, the PTAB can then transmit the filed SIR
27 request to the proper USPTO unit for processing and action.

1 SIR relief available to Pippin

2 Thomas presents an argument that SIR relief is no longer available to Pippin.
3 Paper 98, pages 8-9. Two reasons are set out in support of the Thomas argument.

4 *First*, Thomas maintains that a SIR request has not been filed. For the
5 reasons addressed above, we disagree.

6 *Second*, “the requested relief of Pippin [Miscellaneous] [M]otion [1] is now
7 unavailable and thus [the relief requested in] Pippin’s motion is moot.” Paper 98,
8 page 8:11-12. Relying on 37 CFR § 1.4(b) (Rule 1.4(b)), Thomas reasons that the
9 Pippin SIR request had to be filed in the Pippin application—not the interference.
10 It is true that Rule 1.4(b) requires that “a separate copy of every paper to be filed in
11 a patent application . . . must be furnished for each file to which the paper
12 pertains.” However, when an interference has been declared, Rule 1.4(b) must be
13 read together with 37 CFR § 41.103 (Rule 41.103). Rule 41.103 vests the PTAB
14 with jurisdiction over an involved application. A party is not authorized to file a
15 paper in an involved application without leave of the PTAB. Our decision
16 granting-in-part Pippin Miscellaneous Motion 1 authorizes filing of the SIR
17 request in the interference. The SIR request will be added to the involved Pippin
18 application only upon receipt of the Federal Circuit mandate.

19 Consequently, the relief requested in Pippin Miscellaneous Motion 1 has not
20 been rendered moot due to the filing of the Pippin SIR request in the interference.

21 Thomas may be suggesting that, after 16 March 2013, the USPTO may
22 not be able to act on a SIR request filed prior to 16 March 2013. Paper 98,
23 page 8:21-23. We decline at this time to address that suggestion. Whether a SIR
24 request filed prior to 16 March 2013 can be acted upon by the USPTO after
25 16 March 2013 is a decision not yet ripe. Upon receipt of the Federal Circuit
26 mandate, the Director may elect to determine whether the repeal of § 157 is
27 retroactive or prospective only.

1 Impact on Federal Circuit appeal

2 *Introduction*

3 Thomas maintains that filing the Pippin SIR request will have an impact on
4 its appeal to the Federal Circuit. Paper 98, pages 9-10. Accordingly, Thomas
5 “believes that the Board misapprehended the scope of [the Federal Circuit]
6 appeal.” *Id.* at page 9:19-20.

7 *Factual background*

8 We have had some difficulty understanding the precise basis for the position
9 taken by Thomas. We therefore set out the factual basis of our understanding.

10 There came a time during the interference when Thomas filed what is
11 referred to in an interference as a “motions list.” Paper 26. The purpose of the
12 motions list is to present a list of motions a party seeks *authorization* to file.
13 37 CFR § 41.120(a); Standing Order ¶ 104.2.1. After receipt of motions lists from
14 both parties, a conference call with a single judge is held to discuss what motions
15 should be authorized. Standing Order ¶ 104.2. Thereafter, an order is entered
16 indicating which listed motions are authorized.

17 Judge Lee was assigned to manage this particular interference. An “Order—
18 Authorizing Motions—Bd. R. 121” (Paper 31) was entered on 16 June 2011
19 following a conference call on 15 June 2011 with Judge Lee. The “Order” sets out
20 which motions requested by Thomas are authorized and which motions are “not
21 authorized.” The “Order” is a single-judge interlocutory order. A single-judge
22 order is not a panel order.

23 It appears that Thomas listed a motion for judgment based on alleged
24 unpatentability due to double patenting. Paper 26 (page 2: listed Motion 3; page 2:
25 listed contingent Motion 4; page 3: listed Motion 5). Judge Lee declined to
26 authorize any of Thomas listed Motions 3-5. Paper 31, pages 4-5.

1 Order is entered in every interference and is transmitted to the parties along with
2 the Declaration of the interference. *See* Papers 1 and 2.

3 A decision by a single judge is not a decision of a three-judge panel of the
4 PTAB and therefore is not a “final” decision within the meaning of § 141. In order
5 to make an “interlocutory” order a final decision of a three-judge panel of the
6 PTAB, a party must seek further review before a three-judge panel of the PTAB.
7 Otherwise, the PTAB will not have entered a PTAB decision which is “final for the
8 purposes of judicial review” within the meaning of the rules. 37 CFR § 41.2
9 (definition of “final”).

10 Why is review before a three-judge panel necessary? Judge Lee’s Order
11 declining to authorize motions based on double patenting became operative as of
12 the date it was entered (16 June 2011). The interference proceeded on the basis
13 that certain motions were not authorized. The Director has determined that there is
14 a public interest in timely resolution of interferences. 37 CFR § 41.200(c). By not
15 promptly seeking review within the PTAB, Thomas gave an impression to both
16 Pippin and the PTAB that it was not dissatisfied with Judge Lee’s decision. It is
17 for this reason that the rules require review, and entry of a decision, by a three-
18 judge panel before any decision entered in an interference becomes “final” for the
19 purpose of judicial review.

20 Under the circumstances, we do not see why the Federal Circuit would
21 consider an argument on appeal that Judge Lee erroneously declined to authorize
22 motions because there is no “final” PTAB decision to review. The rule seeks to
23 correct single-judge errors before a case becomes involved in judicial review. As
24 we do not understand how the scope of the appeal can be affected, we decline to
25 grant rehearing based on Thomas’ argument that filing the Pippin SIR request will
26 have some negative impact on the appeal. We continue to be of the view that the
27 mere filing of the Pippin SIR request is a ministerial action.

1 *Permission to petition*

2 Thomas asks the PTAB to give permission to file a petition prior to
3 permitting Pippin to “submit [i.e., file,] its request for conversion to a SIR.”
4 Paper 95, page 10:4-5.

5 The mere filing of the Pippin SIR request in the interference is a procedural
6 matter. The rules do not authorize the filing of a petition in a contested case on a
7 procedural matter. 37 CFR § 41.3(b)(2). In interferences, former petition practice
8 under pre-1984 rules was replaced by motions practice.

9 Thomas has had an opportunity to seek administrative redress from our
10 decision granting-in-part Pippin Miscellaneous Motion 1 via its Rehearing
11 Request. In considering the Rehearing Request, we have not imposed the normal
12 restrictions applicable to requests for rehearing. Rather, we have considered the
13 Rehearing Request on its merits without limiting our consideration to
14 misapprehension of or overlooked facts or argument.

15 **Decision**

16 Upon consideration of the Thomas Rehearing Request (Paper 98), and for
17 the reasons given, it is

18 **ORDERED** that the Thomas Rehearing Request is *denied*.

19
20
21
22
23
24
25
26
27

1 By Electronic Transmission:

2

3 To Junior Party Thomas:

4

5 Richard A. Neifeld, Esq.

6 Robert W. Hahl, Esq.

7 Neifeld IP Law, PC

8 rneifeld@neifeld.com

9 rhahl@neifeld.com

10

11 To Senior Party Pippin:

12

13 R. Danny Huntington, Esq.

14 William H. Hughet, Esq.

15 Rothwell, Figg, Ernst & Manbeck, PC

16 dhuntington@rothwellfigg.com

17 whughet@rothwellfigg.com