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ATLANTA, GA 30339

In re Application of:	:	
Benjamin G. Davis et al.	:	
Application No. 14/991,281	:	DECISION ON PETITION
Filed: January 8, 2016	:	
Title: ANTIBODY CONJUGATES AND	:	
METHODS OF MAKING THE ANTIBODY	:	
CONJUGATES	:	

This is a supplemental decision on the petitions filed January 31, 2020, under 37 CFR 1.181 or in the alternative under 37 CFR 1.183, requesting that the Director exercise supervisory authority and overturn the decision of December 2, 2019, by the Director of Technology Center 1600 (Technology Center Director), which Technology Center Director decision refused to withdraw the finality of the Office action of June 14, 2019 or to enter the amendment filed on October 15, 2019.

The petition to withdraw the finality of the Office action of June 14, 2019 is **DENIED**.

The petition concerning the amendment filed on October 15, 2019 is **GRANTED only** to the extent that the Technology Center Director will consider the petition to enter the amendment filed on October 15, 2019 on the merits.

The petition under 37 CFR 1.183 to waive or suspend any requirement of the regulations concerning the petition to withdraw the finality of the Office action of June 14, 2019 is **DENIED**.

The petition under 37 CFR 1.183 to waive or suspend any requirement of the regulations concerning the petition to enter the amendment filed on October 15, 2019 is **DISMISSED** as premature.

RELEVANT BACKGROUND

The above-identified application was filed on January 8, 2016.

Prosecution of the above-identified application resulted in a final Office action being issued on June 14, 2019. Claims 1 through 5 and 9 through 22 are currently pending, and claims 1 and 12 through 15 are withdrawn from consideration under 37 CFR 1.142. The final Office action of June 14, 2019 included: (1) a rejection of claims 2 through 5 and 16 under 35 U.S.C. § 102(a)(1)¹ as being anticipated by Huang et al., J. Am. Chem. Soc., 2012,134,12308-12318 (Huang); and (2) a rejection of claim 2 through 5, 9 through 11, and 16 through 22 under 35 U.S.C. § 103 as being unpatentable over Huang and Van Delft et al., WO2014/065661A1 (Van Delft).

A response to the final Office action of June 14, 2019 was filed on October 15, 2019. The response of October 15, 2019 included a request to review and withdraw the finality of the Office action of June 14, 2019 and a proposed amendment to the claims.

Petitioners were notified that the proposed amendment of October 15, 2019 would not be entered in an advisory action issued on November 5, 2019.

A petition under 37 CFR 1.181 or in the alternative under 37 CFR 1.183 was filed on November 13, 2019, requesting entry of proposed amendment of October 15, 2019, and renewing the request to withdraw the finality of the Office action of June 14, 2019.

The petition filed on November 13, 2019 was dismissed as untimely in a decision by the director of Technology Center 1600 (Technology Center Director) issued on December 2, 2019.

A notice of appeal and request for a pre-brief appeal conference were filed on November 14, 2019. Petitioners were notified in a pre-brief appeal conference issued on December 12, 2019 that the above-identified application remains under appeal, and that claim 22 would be allowable if amended to include the limitations of claim 16, the independent claim from which it directly depends.

A petition under 37 CFR 1.181 or in the alternative under 37 CFR 1.183 was filed on January 31, 2020, again requesting entry of proposed amendment of October 15, 2019, and a petition under 37 CFR 1.181 or in the alternative under 37 CFR 1.183 was filed on January 31, 2020, again requesting withdrawal of the finality of the Office action of June 14, 2019.

An appeal brief was filed on March 16, 2020.

¹ Section 3 of the Leahy-Smith America Invents Act (AIA) revised 35 U.S.C. §§ 102 and 103, effective as to applications ever having a claim with an effective filing date on or after March 16, 2013, or ever having a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any patent or application that ever contained such a claim with an effective filing date on or after March 16, 2013. See Pub. L. No. 112-29, § 3, 125 Stat. at 285-293. The above-identified application was filed on January 8, 2016, and does not claim priority to or the benefit of any application filed before March 16, 2013. Therefore, this decision refers to the AIA version of 35 U.S.C. §§ 102 and 103.

The petition filed on January 31, 2020 was dismissed as untimely in a decision by the Office of Petitions issued on August 5, 2020.

STATUTE AND REGULATION

35 U.S.C. § 131 provides that:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefore.

35 U.S.C § 132 provides that:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1).

37 CFR 1.181(f) provides that:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

OPINION

Petitioners assert *inter alia* that the final Office action of June 4, 2019 (and the prior non-final Office action) does not comply with 37 CFR 1.104 and section 707.07 of the Manual of Patent Examining Procedure (MPEP), and that the final Office action of June 4, 2019 does not satisfy the conditions of MPEP § 706.07(a) to be made final. Petitioners also assert *inter alia* that the amendments to claims 2, 4, 10, 11, 17, 18, 21, and 22 in the proposed amendment of October 15, 2019 involve features that have already been searched and cannot raise new issues or require further search or consideration. Petitioners request withdrawal of the finality of the Office action of June 14, 2019 and entry of the amendment of October 15, 2019.

A first petition or other request to withdraw the finality of the Office action of June 14, 2019 was not filed until October 15, 2019, four months after the date of the final Office action of June 14, 2019. 37 CFR 1.181(f) provides “[a]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided” and that “[t]his two-month period is not extendable.” See 37 CFR 1.181(f). Therefore, there is no showing of error in the Technology Center Director’s decision to dismiss the petition to withdraw the finality of the Office action of June 14, 2019 as untimely.

The petition to enter the amendment of October 15, 2019 was filed on November 13, 2019, within two months of the date petitioners were notified of the non-entry of the amendment of October 15, 2019 in the advisory action of November 5, 2019. Therefore, the petition to enter the amendment of October 15, 2019 filed on November 13, 2019 is timely under 37 CFR 1.181(f).

With respect to the petition under 37 CFR 1.183, the waiver of a requirement of the regulations pursuant to 37 CFR 1.183 is, by the terms of the rule, limited to: (1) an “extraordinary situation”; (2) in which “justice requires” the requested waiver. See *Issidorides v. Ley*, 4 USPQ2d 1861, 1961-62 (Comm’r Pat. 1987).

As to the petition to withdraw of the finality of the Office action of June 14, 2019, petitioners present no basis for why their situation is an “extraordinary situation” in which “justice requires” the requested waiver other than their arguments concerning the completeness and finality of the Office action of June 14, 2019. Such arguments may be a reason for filing a timely petition to withdraw the finality of the Office action of June 14, 2019, but are not a justification for the failure to file a timely petition to withdraw the finality of the Office action of June 14, 2019. Rather, the avoidable failure to follow regulations or meet filing deadlines are not considered an “extraordinary situation” within the meaning of 37 CFR 1.183. See *Nitto Chemical Industry Co., Ltd. v. Comer*, 37 USPQ2d 1778 (1994); *In re Sivertz*, 227 USPQ 255, 256 (Comm’r Pat. 1985); see also *Williams v. Five Platters, Inc.*, 510 F.2d 963, 964-65 (CCPA 1975) (a party’s failure to meet a time period requirement does not justify waiver of the period requirement).

In addition, petitioners may obtain withdrawal of the finality of the Office action of June 14, 2019 (and entry of the amendment filed on October 15, 2019) under the provisions of 37 CFR

1.114. The USPTO does not usually consider an applicant's situation to be an "extraordinary situation" in which "justice requires" a waiver of a requirement of the regulations when the regulations already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664, 664 (Comm'r Pat. 1982).

As to the petition to enter the amendment of October 15, 2019, it is premature to consider whether petitioners' situation is an "extraordinary situation" in which "justice requires" waiver or suspension of a requirement of the regulations prior to a decision by the Technology Center Director on whether petitioners' are entitled to entry of the amendment of October 15, 2019 under 37 CFR 1.116. *See id.*

DECISION

For the reasons stated previously, the petitions filed January 31, 2020 under 37 CFR 1.181 or in the alternative under 37 CFR 1.183, requesting that the Director exercise supervisory authority and withdraw the finality of the Office action of June 14, 2019 and enter the amendment of October 15, 2019 are—

DENIED with respect to withdrawing the finality of the Office action of June 14, 2019;

GRANTED with respect to the amendment filed on October 15, 2019 **only** to the extent that the Technology Center Director will consider the petition to enter the amendment filed on October 15, 2019 on its merits;

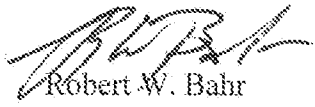
DENIED with respect to waiving or suspending any requirement of the regulations concerning the petition to withdraw the finality of the Office action of June 14, 2019; and

DISMISSED as premature with respect to waiving or suspending any requirement of the regulations concerning the petition to enter the amendment filed on October 15, 2019.

This constitutes a final decision on these petition with respect to: (1) withdrawing the finality of the Office action of June 14, 2019; and (2) waiving or suspending any requirement of the regulations concerning the petition to withdraw the finality of the Office action of June 14, 2019. No further request for reconsideration of these issues will be entertained. Judicial review of this petition decision may be available upon entry of a final agency action adverse to the petitioners in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). *See* MPEP § 1002.02.

Telephone inquiries concerning this decision should be directed to Alesia Brown at 571-272-3205.

This application is being forwarded to Technology Center 1600 for consideration of the petition to enter the amendment filed on October 15, 2019 on the merits and for appropriate action in response to the appeal brief filed on March 16, 2020.

A handwritten signature in black ink, appearing to read 'RWB', is written over the printed name.

Robert W. Bahr
Deputy Commissioner
for Patents