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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,357	03/11/2008	7210744	PAS 07097	4783

7590 06/23/2010

James J. Prizzi
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P.O. BOX 231
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/23/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,357	03/11/2008	7210744	PAS 07097

JAMES RAY & ASSOCATES
2640 PITCAIRN ROAD
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EXAMINER

DAWSON, GLENN

ART UNIT PAPER

3993

DATE MAILED:

06/23/10

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



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MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

In re Montgomery
Inter Partes Reexamination Proceeding
Control No.: 95/000,357
Request Deposited: March 11, 2008
For: U.S. Patent No.: 7,210,744

:
: **DECISION**
: **DENYING**
: **PETITION**
:
:

This is a decision on the April 20, 2010 Third Party Requester, ("Petitioner" or "Sollami"); petition, entitled PETITION TO THE DIRECTOR filed under 37 C.F.R. § 1.183.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office for consideration.

The petition to waive the timeliness requirement (of 37 C.F.R. § 41.66(a)) is denied for the reasons set forth below.

FEES

The requisite petition fee for a petition under 37 C.F.R. § 1.183 is \$400.00 pursuant to 37 C.F.R. § 1.17(f), and the \$400.00 fee has been charged to petitioner's credit card.

REVIEW OF FACTS

1. U.S. Patent No. 7,210,744 (the '744 patent) was granted to Robert H. Montgomery Jr. on May 1, 2007, based on an application for patent filed on December 3, 1998. The patent is assigned to Kennametal Inc.
2. On March 3, 2008, third party requester, The Sollami Company ("Sollami"), filed an original request for *inter partes* reexamination of the '744 patent, which request was assigned reexamination control no. 95/000,357 ("the '357 proceeding").
3. On May 8, 2008, the March 3, 2008 request for *inter partes* reexamination of the '744 patent was denied.

4. On June 10, 2008, Sollami filed a petition for review of the May 8, 2008 denial of the request for *inter partes* reexamination.
5. On September 18, 2008, the United States Patent and Trademark Office (“USPTO”) granted the June 10, 2008 petition, and ordered *inter partes* reexamination of the ‘744 patent in the ‘357 proceeding.
6. On January 7, 2009, the USPTO issued an action closing prosecution, confirming all claims of the ‘744 patent.
7. On May 11, 2009, the USPTO issued a right of appeal notice.
8. On June 10, 2009, Sollami filed a notice of appeal.
9. On October 12, 2009, Sollami untimely filed an appellant’s brief.
10. On February 23, 2010, the USPTO issued a notice of intent to issue *inter partes* reexamination certificate (NIRC) stating that Sollami’s October 12, 2009 appellant’s brief was late and was not considered.
11. On April 20, 2010, Sollami filed the present petition.
12. On May 4, 2010, the *inter partes* reexamination certificate for the ‘744 patent issued.

RELEVANT STATUTES, REGULATIONS AND PROCEDURES

37 C.F.R. § 1.183 states, “[i]n 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).”

37 C.F.R. § 41.66(a) states, “[a]n appellant’s brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant’s brief or an amended appellant’s brief may not be extended.”

DECISION

Because the present petition was not timely submitted and failed to request waiver of any particular rule without any factual basis, the petition requesting the USPTO to “waive the timeliness requirement and accept the [fee] filed with the brief and [that] the brief be accepted,” is denied. Additionally, because the USPTO lacks jurisdiction over a patent in a reexamination proceeding where the certificate of *inter partes* reexamination has issued, the petition is denied.

I. The Petition Requesting Waiver Fails to State a Basis for Which Relief Can be Granted

Patent owner filed the present petition requesting that the Director waive “the timeliness requirement” and accept their late filed brief. Even if the petition had been addressed prior to issuance of the certificate, the petition to accept the late filed appellant’s brief would not be grantable.

In order for grant of any petition under 37 C.F.R. § 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm’r Pat. 1985). Petitioner has not shown that either condition exists in this case. Petitioners’ failure to timely file an acceptable reply brief is not an extraordinary situation which, where justice requires, waiver of the rules. Circumstances resulting from petitioners’, or petitioners’ counsel’s, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See *In re Tetrafluor, Inc.*, 17 USPQ2d 1160, 1162 (Comm’r Pats. 1990); *In re Bird & Son, Inc.* 195 USPQ 586, 588 (Comm’r Pats. 1977). In this instance, the following three considerations are to be noted:

First, an appellant’s brief in an *inter partes* reexamination proceeding is required to be filed, “not later than two months from the latest filing date of the last-filed notice of appeal or cross appeal.... The time for filing an appellant’s brief or an amended appellant’s brief may not be extended.” See 37 C.F.R. § 41.66(a). In the *inter partes* proceeding for the ‘744 patent, requester failed to timely file its appellant’s brief. It appears that requester attempted to extend the period for filing the appellant’s brief by submitting a petition fee under 37 C.F.R. § 1.17(g); the fee worksheet submitted October 12, 2009 refers to “Petition fee - 37 CFR 1.17(g) (Group II)” at page 2.¹ Such a submission is clearly inappropriate, since 37 C.F.R. § 41.66(a) specifically excludes any extension of time provisions for filing an appellant’s brief during *inter partes* reexamination proceedings, and any petition for extension of time would have needed to be filed under 37 C.F.R. § 1.183 for waiver of 37 C.F.R. § 41.66(a). Additionally, even if the “petition” had been filed under 37 C.F.R. § 1.183 for waiver of 37 C.F.R. § 41.66(a), 37 C.F.R. § 1.956 requires, for an extension in *inter partes* reexamination:

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only **for sufficient cause and for a reasonable time specified**. Any request for such extension **must be filed on or before the day on which action by the patent owner is due**, but in no case will the mere filing of a request effect any extension.

No detailed reason was given in the “petition” for extension for the delay in filing the brief (see MPEP 2665), and the “petition” was not filed “on or before the day on which action by the patent owner is due.” It is to be noted that 35 U.S.C. § 314(c) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” (37 C.F.R. § 1.937).

Thus, it appears from the record that that petitioners’ counsel lacked the knowledge of, and failed to properly apply the patent rules of practice. As pointed out above, such does not constitute

¹ The USPTO has refunded the miscellaneous petition fee which was processed along with the appellant’s brief submission on October 12, 2009.

extraordinary circumstances where the interests of justice require the granting of relief.

Second, upon learning in the February 23, 2010 communication that the appellant's brief was not timely submitted and that the '357 proceeding was to be concluded by a Notice regarding the USPTO's intent to issue an *inter partes* reexamination certificate for the '744 patent, requester waited nearly two months to submit the present petition, only two weeks before the reexamination certificate issued. This permitted the certificate to issue, divesting the USPTO of jurisdiction over the proceeding. Requester has not provided any compelling evidence for the delay in filing the 37 C.F.R. § 1.183 petition to waive the "timeliness requirement" to, after the certificate has issued, accept the untimely filed appellant's brief nearly 8 months after the appellant's brief was due. In the present circumstance, even if the USPTO had jurisdiction, the present petition is not grantable, as it appears from the record that that petitioners' counsel failed to exercise due care in prosecuting the proceeding. As pointed out above, such does not constitute extraordinary circumstances where the interests of justice require the granting of relief.

Third, 37 C.F.R. § 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts which justify considering timely an appellant's brief filed two months late, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 C.F.R. § 41.66(a).

For all of the reasons set forth above, patent owner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of the timeliness requirements for file an appellant's brief, and the April 20, 2010 petition under 37 C.F.R. § 1.183 is denied.

II. USPTO Lacks Jurisdiction to Grant Petition Under 37 C.F.R. § 1.183

The petition was filed with only two weeks remaining until the issuance of the reexamination certificate, which was insufficient time remaining to process and match the petition with the proceeding prior to issuance of the Certificate.² The present reexamination proceeding concluded with the issuance of *Inter Partes* Reexamination Certificate (0157th), US 7,210,744 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '744 patent. Therefore, the petition to accept the late filed appellant's brief is not authorized by statute. Accordingly, the petition is denied.

III. Alternative Relief Requested

In the last sentence of the petition, it is stated:

In the alternative, Petitioner requests that the Director issue an order *sua sponte* to reexamine the Montgomery '744 patent claims 1-4.

Pursuant to 37 C.F.R. § 1.4(c), "each distinct subject, inquiry or order must be contained in a

² No reason is given in the petition for the almost 2-months delay in filing this petition after receipt of the NIRC.

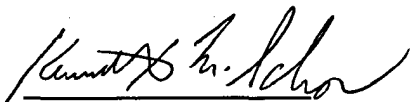
separate paper to avoid confusion and delay in answering papers dealing with different subjects.” Requester would need to submit a 37 C.F.R. § 1.182 petition for a Director initiated reexamination separately from the present 37 C.F.R. § 1.183 petition. However, it is to be noted that, as pointed out in MPEP 2239, “[t]he Director of the USPTO will not normally consider requests to order reexamination at the Director’s initiative received from members of the public.”

CONCLUSION

1. The third party requester’s petition filed April 20, 2010 for waiver of the timeliness requirement for filing an appellant’s brief is **denied**.
2. This decision is designated a **final agency action** within the meaning of 5 U.S.C. § 704.
3. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

4. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at (571) 272-7755.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
United States Patent and Trademark Office

6-23-10
Kiva/jurisdiction