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Paper 97
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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*, and FRED E. McKELVEY, JAMESON LEE, SALLY GARDNER LANE, MICHAEL R. ZECHER and JUSTIN T. ARBES, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

DECISION ON PIPPIN MISCELLANEOUS MOTION 1

Pippin Miscellaneous Motion 1 (Paper 80) seeks entry of an order by the Board accepting for filing in the interference file a request to convert the involved Pippin application to a SIR (Statutory Invention Registration—35 U.S.C. § 157).

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

Thomas has timely opposed. Paper 95.

Pippin has timely replied. Paper 96.

Background

The facts are straightforward.

The interference was declared on 11 April 2011. Paper 1.

There came a time when Thomas filed Thomas Motion 1 seeking entry of an order designating some (but not all) of the involved Thomas claims as *not* corresponding to the count. Paper 36.

Thomas also advised the Board that it would *not* be filing (1) a priority statement [formerly referred to as a preliminary statement] or (2) a motion for judgment based on priority. Paper 31.

In its Decision on Motions, a merits panel (Judges Lee, Zecher and Arbes) held that Thomas was not entitled to the relief requested in Thomas Motion 1. Paper 76. Accordingly, Thomas Motion 1 was denied. Paper 76, page 21.

Since Thomas as junior party had advised the Board that a motion for judgment based on priority would not be filed, the Board entered a judgment against Thomas as to Count 1. Paper 77. If the Board's judgment becomes final, the result will be cancellation of all claims in the involved Thomas patent which correspond to Count 1.

Thomas filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit. Paper 78.

Upon filing of the notice of appeal from a final decision of the Board, jurisdiction over an interference transferred from the Board to the Federal Circuit. *Loshbough v. Allen*, 359 F.2d 910 (CCPA 1966) (jurisdiction attaches in strict sense when notice of appeal is filed; nevertheless a PTO board may exercise a purely ministerial function after filing of the notice of appeal).

Discussion

Issue 1: Whether the Board has authority in an interference to grant a party leave to file in an interference file a request to convert an involved application to a SIR *after* the filing of a notice of appeal to the Federal Circuit seeking review of a *final decision* by the Board in the interference?

Issue 2: Assuming the Board has authority to grant leave to file the request, should the Board exercise its discretion and grant leave?

Why is there a need to determine at this time whether Pippin should be granted leave to file a SIR? At the present time, a prevailing applicant in an interference is free to file a request to convert its application to a SIR. 35 U.S.C. § 157; 37 CFR § 1.293(a) ("An applicant for an original patent may request, *at any time* during the pendency of applicant's pending complete application, that the specification and drawings be published as a . . . [SIR]." (italics added)). However, effective 16 March 2013, § 157 will be repealed. Filing of a SIR after 16 March 2013 will no longer be possible. Leahy-Smith America Invents Act, Pub. L. 112-29, 125 Stat. 284, § 3(e) (2011):

> (e) Repeal of Statutory Invention Registration-
>
> (1) IN GENERAL -- Section 157 of title 35, United States Code, and the item relating to that section in the table of sections for chapter 14 of title 35, United States Code, are repealed.
>
> (2) REMOVAL OF CROSS REFERENCES -- Section 111(b)(8) of title 35, United States Code, is amended by striking "sections 115, 131, 135, and 157" and inserting "sections 131 and 135".
>
> (3) EFFECTIVE DATE -- The amendments made by this subsection shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act

> [16 September 2012], and shall apply to any request for a statutory invention registration filed on or after that effective date.

Subsection (e) takes effect on 16 March 2013.

Accordingly, Pippin cannot file a SIR request on or after 16 March 2013.

The mere filing of a SIR request with the Board related to an application involved in an interference while the interference is before the Federal Circuit is believed to involve a mere ministerial act within the meaning of *Loshbough v. Allen*. Pippin is not asking the Board (or for that matter the Patent Corps) to act on its proposed SIR request. At the present time, since the involved Pippin application is involved in the interference, we see no reason not to permit the ministerial filing of the SIR request in the interference file itself. 37 CFR § 41.103 (within the agency, the Board acquires jurisdiction over any involved application file upon initiation of a contested case). A declared interference is a contested case. 37 CFR § 41.203(b).

Any action before the Board which would interfere with proceedings in the Judicial Branch would not be consistent with precedent and needed comity between the Executive and Judicial Branches while each attends to its respective statutory assigned duties. Those duties include (1) resolution of the interference by the Board in the first instance (35 U.S.C. § 135(a)[1]) and (2) resolution of an appeal from the Board by the Federal Circuit in the second instance (35 U.S.C. § 141[2]).

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[1] *Hyatt v. Boone*, 146 F.3d 1348, 1351 (Fed. Cir. 1998) (determination of priority of invention is resolved *in the first instance* in administrative proceedings before the Board in accordance with *35 U.S.C. § 135(a)* ("The Board . . . shall determine questions of priority of the inventions and may determine questions of patentability.")

[2] "A party to an interference dissatisfied with the decision of the Board . . . on the interference may appeal the decision to the . . . Federal Circuit . . . ." 35 U.S.C.

We perceive of no legitimate reason why authorizing the mere filing of a SIR request in the interference file would interfere in any manner with proceedings and deliberations by the Federal Circuit with respect to the presently pending appeal or the Pippin application involved in that appeal. If we felt otherwise, we would deny the motion.

Because the filing of the SIR request is viewed as a ministerial action, we hold that we have authority to authorize Pippin to file its SIR request.

Because at this time Pippin has not asked the Board to take any action on its SIR request we see no reason not to exercise our discretion, consistent with 37 CFR § 1.293(a), to authorize Pippin to file its SIR request at this time.

Nothing in this opinion should be construed as suggesting what action ultimately will or should be taken on the Pippin SIR request after conclusion of proceedings before the Federal Circuit.

Thomas timely filed an opposition. Paper 95.

According to Thomas, Pippin Miscellaneous Motion 1 is not timely filed. Paper 95, page 2. The involved Pippin application is a complete application within the meaning of 37 CFR § 1.293(a). Rule 293(a) provides that a request to convert the application to a SIR may be filed *at any time* during pendency of an application. Pippin's filing of a request (**Ex 1011**) to convert its application to a SIR is therefore timely. It may be true that Pippin might have elected to file its request at some earlier time. However, under § 157 and Rule 293(a), an applicant may decide when within pendency of its application to file a request for a SIR.

Thomas maintains that the Board lacks jurisdiction to accept the Pippin request to convert its application to a SIR. Paper 95, page 4-6. According to

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§ 141. The Federal Circuit's mandate and opinion "shall govern the further proceedings in the case." 35 U.S.C. § 144.

Thomas, granting Pippin's motion is more than just permitting a request for a SIR to be filed. Rather, maintains Thomas, "it is the effect of those papers." Paper 95, page 5:19-20. Thomas apparently views the mere filing of a request for a SIR as "a conversion" of an application to a SIR. Paper 95, page 6:2.

Upon the filing of a request for a SIR, an examination takes place. 37 CFR § 1.294(a). Applicant will be notified of the results of any examination. 37 CFR § 1.294(b). Upon successful completion of any examination, applicant is notified of an intent to publish a SIR. 37 CFR § 1.294(c). An examination of Pippin's SIR request cannot take place at this time before an examiner because jurisdiction within the agency over the Pippin application is with the Board. 37 CFR § 41.103. At the present time, however, the Board lacks jurisdiction to engage in any action on the merits because an appeal has been taken to the Federal Circuit. *Loshbough v. Allen*, *supra*. The earliest time that any action on the merits of the Pippin SIR request can occur in the agency would be *after* the Federal Circuit issues its mandate. 35 U.S.C. § 144. Until the mandate is received, the Pippin application remains an application. Thus, the status of the Pippin application as a pending application as opposed to any potential SIR remains unchanged until Federal Circuit proceedings are concluded.

Both Pippin (Paper 80, page 8) and Thomas (Paper 95, pages 7-9) discuss *Hyatt v. Boone*, 146 F.3d 1348 (Fed. Cir. 1998). *Hyatt v. Boone* does not involve facts where Boone sought leave to file a request for a SIR during pendency of a Federal Circuit appeal. The relevant precedent is *Loshbough v. Allen*, *supra*.

Order

Upon consideration of Pippin Miscellaneous Motion 1 (Paper 80), and for the reasons given, it is

ORDERED that Pippin Miscellaneous Motion 1 is *granted* to the extent that the Board accepts for filing only in the interference file (and not at this

time in the involved Pippin application file) the Pippin SIR request (**Ex 1011**) which accompanied the motion.

FURTHER ORDERED that Pippin Miscellaneous Motion 1 is otherwise *denied*.

By Electronic Transmission

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