

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re *Inter Partes* Reexamination of:

David W. BARRY *et al.*

Control No.: 95/001,088

Patent in Reexamination: 6,188,988

Group Art Unit: 3992

Filed: March 10, 2000

Examiner: Deandra M. Hughes

For: SYSTEMS, METHODS, AND  
COMPUTER PROGRAM  
PRODUCTS FOR GUIDING  
THE SELECTION OF  
THERAPEUTIC TREATMENT  
REGIMENS

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**PETITION UNDER 37 C.F.R. § 1.182 FOR RELIEF NOT OTHERWISE PROVIDED  
FOR UNDER THE RULES – REQUEST FOR DISMISSAL OF APPEAL**

MAIL STOP *INTER PARTES* REEXAM  
ATTN: CENTRAL REEXAMINATION UNIT  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

Pursuant to 37 C.F.R. § 1.182, the Patent Owner, Advanced Biological Laboratories, S.A. (hereinafter, “Patent Owner”), hereby petitions the United States Patent and Trademark Office (“USPTO”) for relief not otherwise provided for under the rules. Specifically, Patent Owner petitions the Director of the Central Reexamination Unit (“Director”) to refuse consideration of the appellant’s brief filed on April 2, 2010 (“Appeal Brief”) by third-party requester Dr. Robert Shafer (“Requester”) as untimely, and to dismiss the pending appeal of the above-identified *inter partes* reexamination of U.S. Patent No. 6,188,988 (“the ‘988 Patent”) for Requester’s failure to file an appellant’s brief within the time allowed under 37 C.F.R. § 41.66(a).

Patent Owner also files herewith (i) an accompanying Petition under 37 C.F.R. § 1.182 requesting that, in the alternative, should the present Petition be dismissed, Requester’s arguments in the Appeal Brief relating to rejections that were not previously proposed by Requester should be refused consideration by the Board of Patent Appeals and Interferences; and (ii) a Petition under 37 C.F.R. § 1.183 to request waiver of the prohibition of an extension of

time for filing a respondent's brief under 37 C.F.R. § 41.66(b), and to request an extension of the period for the Patent Owner to file a respondent's brief until 30 days after a decision on the present Petition under 37 C.F.R. § 1.182 and/or the accompanying Petition under 37 C.F.R. § 1.182 is rendered. Patent Owner understands that if the present Petition under 37 C.F.R. § 1.182 is granted, the accompanying Petition under 37 C.F.R. § 1.182 will be rendered moot.

### **STATEMENT OF FACTS**

1. On October 10, 2008, Requester filed a request in the USPTO for *inter partes* reexamination of the '988 Patent.
2. On January 7, 2009, the Examiner issued an order granting reexamination.
3. On March 19, 2009, a Decision to Merge Reexamination Proceedings was issued, merging the pending *inter partes* reexamination with concurrent *ex parte* reexamination 90/009,213.
4. On June 11, 2009, the Examiner issued an Action Closing Prosecution, confirming the patentability of all claims of the '988 Patent.
5. On December 22, 2009, the Examiner issued a Right of Appeal Notice (RAN), confirming the patentability of all claims of the '988 Patent.
6. On January 21, 2010, Requester filed a Notice of Appeal.
7. On April 2, 2010, Requester filed the Appeal Brief.

### **REMARKS**

Patent Owner seeks relief under Rule 1.182 to have the pending appeal dismissed for Requester's failure to file an appellant's brief within the time allowed under Rule 41.66(a). Because all claims of the '988 Patent were confirmed as patentable in the Action Closing Prosecution and the subsequent Right of Appeal Notice, Patent Owner was not entitled to file a cross appeal. Accordingly, under Rule 41.66(a), the deadline for Requester to file an appellant's brief was two months from the filing of its Notice of Appeal (or March 21, 2010), not two months from the expiration of the time for Patent Owner to file a notice of cross appeal. Requester's Appeal brief, however, was not filed until April 2, 2010. Moreover, Requester's delay in filing the Appeal Brief is not attributable to any claim of extraordinary circumstances

justifying a suspension of Rule 41.66(a), but rather is merely the result of Requester's attempt to exploit an extension of time to which it was not entitled. Consequently, Patent Owner respectfully requests that the Appeal Brief be refused consideration, and that the pending appeal be dismissed.

**A. Patent Owner Was Not Entitled to File a Cross Appeal**

Section 315(b) of the patent statute provides that “[t]he patent owner involved in an *inter partes* reexamination ... may appeal under the provisions of section 134 ... with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.” 35 U.S.C. § 315(b). Under Section 134(b), “[a] patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner ...” 35 U.S.C. § 134(b) (emphasis added). Rule 41.61(b)(1) echoes Section 134(b) in providing that “an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent ...” 37 C.F.R. § 41.61(b)(1) (emphasis added). Rule 41.61(d) further specifically provides, in relevant part, that “[a]n appeal or cross appeal, when taken, **must** be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest ...” 37 C.F.R. § 41.61(d) (emphasis added). Sections 315(b) and 134 and Rule 41.61 provide for no other grounds for a cross appeal by the patent owner. Accordingly, in order for a patent owner to be entitled to file a notice of cross appeal in an *inter partes* reexamination, one or more claims of the patent under reexamination must have been finally rejected by the Examiner, or there must exist some other decision adverse to the patentability of one or more of the claims. Where there are no final rejections of any claims of the patent under reexamination and no other decisions adverse to the patentability of any of the claims, the patent owner is not entitled to file a notice of cross appeal.

In the above-identified *inter partes* reexamination, the RAN issued by the Examiner on December 22, 2009, confirmed the patentability of all of the claims of the ‘988 Patent. As a result, there were no final rejections or other decisions adverse to patentability from which Patent Owner was entitled to cross appeal.

**B. The Alternate Extended Deadline Provided by Rule 41.66(a) Is Inapplicable**

Rule 41.66(a) provides for two possible deadlines for filing an appellant’s brief in an *inter partes* reexamination proceeding. The default deadline is “no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal.” 37 C.F.R. § 41.66(a). Alternatively, “if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so,” then the deadline is extended to “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.” 37 C.F.R. § 41.66(a). In other words, under Rule 41.66(a), both of the following prerequisites must be met in order for the alternate extended deadline to apply: (1) a party to the proceeding must be entitled to file an appeal or cross appeal; and (2) the party must fail to timely do so. If either of these prerequisites are not satisfied, then the default deadline applies. This deadline may not be extended. 37 C.F.R. § 41.66(a).

As noted above, in the present *inter partes* reexamination, Patent Owner was not entitled to file a cross appeal because the RAN that issued on December 22, 2009, did not include any final rejections of any claims of the ‘988 Patent or any other decisions adverse to the patentability of any claims of the ‘988 Patent. There are no other parties involved in the *inter partes* reexamination the ‘988 Patent that were entitled to file an appeal or cross appeal but that failed to do so. Under Rule 41.66(a), therefore, the alternate extended deadline is inapplicable, and the default deadline – “no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal” – is controlling. The last-filed notice of appeal is Requester’s Notice of Appeal, which was filed on January 21, 2010. Consequently, the deadline for filing an appellant’s brief was March 21, 2010.

**C. The Appeal Brief Is Untimely, and the Appeal Should Be Dismissed**

The rules governing *inter partes* reexaminations are very clear with respect to the consequences of failure to timely file an appellant’s brief. “If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.” 37 C.F.R. § 1.957(a). Moreover, Rule 41.67(b) instructs that “[a]n appellant’s appeal shall stand dismissed upon failure of that appellant to file an appellant’s brief ... within the time allowed under § 41.66(a).” 37 C.F.R. § 41.67(b).

Requester failed to file the Appeal Brief until April 2, 2010. Accordingly, the Appeal Brief is untimely under Rule 41.66(a), and should be refused consideration per Rule 1.957(a). Furthermore, because Requester failed to file the Appeal Brief within the time allowed by Rule 41.66(a), the present appeal should be dismissed in accordance with Rule 41.67(b).

**D. No Extraordinary Circumstances Justify Waiving the Deadline Imposed by Rule § 41.66(a)**

Patent Owner recognizes that Rule 1.183 provides for the suspension or waiver of the regulations “[i]n an extraordinary situation, when justice requires.” 37 C.F.R. § 1.183. However, “[i]t is not the policy of the Patent and Trademark Office ... to routinely waive rules.” *Issidorides v. Ley*, 4 U.S.P.Q.2d 1861, 1862 (Comm. of Patents 1987). “[T]he rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183.” *Myers v. Feigelman*, 172 U.S.P.Q. 580, 584 (C.C.P.A. 1972).

Patent Owner respectfully submits that, in the present case, no such circumstances justifying the suspension or waiver of Rules 41.66(a), 41.67(b), and 1.957(a) are present. Requester’s Appeal Brief makes no mention whatsoever of any extraordinary circumstances to justify its untimely filing; indeed, Requester’s own statements in the Appeal Brief indicate that Requester simply proceeded as though the alternate extended deadline under Rule 41.66(a) automatically provided an extension in the present (and, presumably, every) appeal. *See* Appeal Brief, page 6 (“Patent Owner ABL did not file a cross-appeal, but if it had it would have been due on February 4, 2010. This Appeal Brief is timely filed under 37 C.F.R. § 41.66(a) on April 2, 2010, less than ‘two months from the expiration of the time for filing’ of the notice of cross-appeal.”). Requester does not even address the determination at the heart of Rule 41.66(a) – *i.e.*, whether Patent Owner was entitled to file a cross-appeal. Under Requester’s interpretation of Rule 41.66(a), the default deadline would never apply at all, which would render that provision of Rule 41.66(a) superfluous.

Requester possessed the power to avoid the application of Rules 41.66(a), 41.67(b), and 1.957(a), but instead attempted to avail itself of an extension of time to which it was not entitled. This is not a case where the deadline was missed by mere hours; rather, Requester waited a full 12 days beyond the effective deadline before filing the Appeal Brief. Requester had every

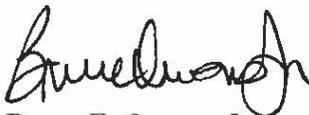
opportunity to present its appeal in a timely fashion, but failed to do so. Thus, because there were no circumstances preventing the timely filing of the Appeal Brief, there exists no extraordinary situation justifying a suspension of Rule 41.66(a), 41.67(b), or 1.957(a), and Requester should not be heard to argue that such a suspension is warranted under Rule 1.183.

### CONCLUSION

The Director is hereby authorized to charge the undersigned's Deposit Account No. 50-0220 for the amount of \$400 in accordance with 37 C.F.R. §§ 1.182 and 1.17(f). If any other fee is due, please charge such fee occasioned by this Petition to the undersigned's Deposit Account No. 50-0220.

April 12, 2010

Respectfully submitted,



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## CERTIFICATE OF SERVICE

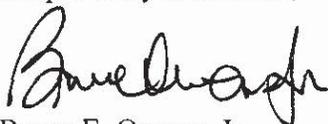
I hereby certify that on April 12, 2010, I served a true and correct copy of the foregoing **PETITION UNDER 37 C.F.R. § 1.182 FOR RELIEF NOT OTHERWISE PROVIDED FOR UNDER THE RULES – REQUEST FOR DISMISSAL OF APPEAL** via U.S. First Class Mail to the *Ex Parte* Requester and the *Inter Partes* Requester as follows:

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April 12, 2010

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