

In re Reexamination 90/006,707: Late Reexamination “Evidence”

In re Reexamination 90/006,707, 2008 Westlaw 2938366 (PTO Off. Deputy Comm’r)(J. Love, Deputy Comm’r), manifests the difficulty that patentees are facing in reexamination where they have failed to present necessary evidence. The patentee today who runs the gauntlet of patent reexamination is facing a much stricter road to sustain patentability than many have thought.

One of the nuances of reexamination practice is the desirability for the early submission of any evidence that the patentee wishes to have considered in any eventual appeal proceeding. In the wake of *KSR*, various forms of evidence including objective evidence of nonobviousness as well as expert definitions may be critical to a patentee’s success.

Yet, it is easy for a patentee to fall into a trap of an advanced stage of prosecution *without* evidence necessary to prevail. After Final Rejection and particularly after an Appeal has been taken, it may be difficult to have evidence considered.

Late Submission of Dictionary Definition: In *In re Reexamination 90/006,707*, the patentee sought to challenge the definitions of certain terms in an Examiner’s Answer by citation of dictionary definitions in his Reply Brief.

The Patent Examiner refused to consider the Reply Brief on the basis that the introduction of dictionary definitions was the introduction of “evidence”, and that by the time of the Reply Brief this was an unexcused late filing.

On petition to the Technology Center Director, the Examiner’s denial of entry of the Reply Brief was affirmed.

Abuse of Discretion Standard on Petition to the Director: On further petition to the Deputy Commissioner in *In re Reexamination 90/006,707*, the decision denying entry of the Reply Brief was sustained in all respects under an abuse of discretion standard:

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“A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of February 29, 2008. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion. In addition, petitioner has not shown the existence of an extraordinary situation in which justice requires, waiver of the rules to consider the proffered reply brief or a redacted version of the reply brief which omits all substantive references to the exhibits and definitions.”

Permanently Shutting the Door on the Patentee: For evidence essential to the patentee’s case, he may have effectively lost everything to the extent that entry of the evidence is shut out through the procedural mechanism of *In re Reexamination 90/006,707*.

Doors Open in Other Proceedings are Closed in Reexamination: Unlike a regular prosecution of an application where denial of entry of evidence is simply overcome through filing a RCE or continuation application to start the procedure anew, refiling is not an option in reexamination.

Previously, the patentee might have considered seeking a trial *de novo* under 35 USC § 145, but in 1999, in a little noticed amendment to the statute at the time, the trial *de novo* route has been abolished for reexamination proceedings: Only a direct appeal to the Federal Circuit remains open.

A copy of *In re Reexamination 90/006,707* is attached.

Regards,
Hal

**UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR PATENTS**

In re Reexamination Proceeding 90/006,707
For: Minimum Dead Volume Fitting

2008 Westlaw 2938366

Decision dated: June 2, 2008
Reexamination filed: July 11, 2003

[Responsive to definitions of terms that were interpreted by the Patent Examiner in his Examiner's Answer, Appellant filed a Reply Brief that included dictionary definitions to rebut the Primary Examiner's interpretation.

The Primary Examiner denied entry of the Reply Brief on the ground that the newly cited dictionary definitions constituted "new evidence". From the denial of a Petition to the Director of the Technology Center, the instant Petition followed:]

JOHN J. LOVE, Deputy Commissioner for Patent Examination Policy.

ON PETITION

This is a decision on Patent Owner's petitions filed April 25, 2008, (1) under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated February 29, 2008, which refused to compel the entry of the reply brief filed March 30, 2007 and October 25, 2007, and (2) under 37 CFR 1.183 requesting waiver of the rules which prohibit entry of affidavits or other evidence filed after the date of filing an appeal, or permit entry of the reply brief or the redacted reply brief.

The petition to overturn the decision of the Technology Center Director dated February 29, 2008 and the petition requesting waiver of the rules are **DENIED**.^[1]

^[1] This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

BACKGROUND

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A reply brief was [timely] filed on March 30, 2007.

On June 4, 2007, a letter was mailed indicating the reply brief was not considered because it contained new evidence and thus, was not in compliance with 37 CFR 41.41(a).

On June 21, 2007, a petition requesting entry of the reply brief was filed.

On September 28, 2007, a decision denying the June 21, 2007 petition was mailed.

On October 25, 2007, a request for reconsideration of the petition decision of September 28, 2007 was filed along with a request to enter a redacted reply brief.

On February 29, 2008, a decision denying the October 25, 2007 request for reconsideration was mailed.

The instant petition was filed April 25, 2008.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.181(f) states:

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 states:

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).

37 CFR 41.33(c)(2) states:

All other affidavits or other evidence filed after the date of filing an appeal pursuant to §41.31 (a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 CFR 41.41 states:

(a)(1)Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2)A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b)A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c)Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

37 CFR 41.152 states:

(a)Generally. Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to contested cases.

(b)Exclusions. Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.

37 CFR 1.550(c) states:

The time for taking any action by a patent owner in an *ex parte* 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. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g).

MPEP 1208 I states:

Any reply brief must also be in compliance with requirements set forth in 37 CFR 41.41. New or non-admitted affidavits, and/or other evidence are not permitted in a reply brief.

MPEP 2273 states:

The normal *ex parte* appeal procedures set forth at 37 CFR 41.31 through 37 CFR 41.54 apply in *ex parte* reexamination, except as pointed out in this Chapter.

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of February 29, 2008, on the grounds that the dictionary definitions cited in the reply brief were in response to new arguments first raised in the Examiner's Answer and are appropriate and that dictionary definitions are not considered to be "evidence" in patent matters but are rather considered as authority similar to legal citations. Accordingly, petitioner further contends that the reply brief filed March 30, 2007 should be entered and if not entered then a redacted copy of the reply brief which redacted copy was filed October 25, 2007 should be entered.

Petitioner argues that the reply brief of March 30, 2007 should be entered, as it did not present evidence filed after the date of filing an appeal, in that dictionary definitions are not evidence. Specifically, petitioner states: (1) the term "evidence" is vague and ambiguous and not defined by the rule; (2) Federal Circuit authority holds that dictionary definitions may be considered by the federal courts *sua sponte* and, as such, dictionaries are not characterized as "evidence" because dictionaries are not introduced into the respective evidentiary records; and (3) the USPTO has expressly adopted the Federal Rules of Evidence in reexamination and interference proceedings. Firstly the term "evidence," under the Federal Rules of Evidence, is information having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the information. Accordingly, dictionary definitions would be considered evidence. In addition, the instant reexamination proceeding is currently under appeal to the Board of Patent Appeals and Interferences and the normal *ex parte* appeal procedures set forth at 37 CFR 41.31

through 37 CFR 41.54 apply in *ex parte* reexamination; 37 CFR 41.152, which addresses the Federal Rules of Evidence, only applies to the “Contested Cases” subpart of Part 41, which does not include either *ex parte* or *inter partes* reexamination. Even further, to the extent 37 CFR 41.152 addresses the Federal Rules of Evidence, they only apply if not otherwise provided for in the “Contested Cases” Subpart of Part 41; see 37 CFR 41.152, *supra*. The present situation is governed by 37 CFR 41.33(c)(2), and 37 CFR 41.41, *supra*, and it is the interpretation of those regulations that applies. As explained in MPEP 1208 I, new or non-admitted affidavits, and/or other evidence are not permitted in a reply brief. Therefore, the entry of a reply brief with any new or non-admitted dictionary definitions is not permitted.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' request to compel the entry of the reply briefs filed March 30, 2007 and October 25, 2007 is not shown to be in clear error.

Petitioner further requests suspension of the rules to consider the reply brief or a redacted version of the reply brief which omits all substantive references to the exhibits and definitions.

The issue at hand is not whether petitioner in good faith followed the rules as he interpreted them; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence in this instance. In the instant case, petitioner filed a reply brief with new or non-admitted evidence therein and then, after receiving a decision dismissing a petition requesting entry of the reply brief, attempted to file a redacted version of the reply brief. As the Technology Center Director correctly noted in his decision of February 29, 2008 the redacted reply brief was filed after the time period for filing a reply brief had expired. No extension of time under 37 CFR 1.550(c) or 41.41 was timely filed. In order for grant of any petition under 37 CFR 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, when 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).

For the reasons set forth above, the petition will not be granted as to the request for waiver of the rules.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of February 29, 2008. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion. In addition, petitioner has not shown the existence of an extraordinary situation in which justice requires, waiver of the rules to consider the proffered reply brief or a redacted version of the reply brief which omits all substantive references to the exhibits and definitions.

The petition is granted to the extent that the decision of the Technology Center Director of February 29, 2008 has been reviewed, but is denied with respect to making any change therein. As such, the decision of February 29, 2008 will not be disturbed. The refusal to enter the reply briefs of March 30, 2007 and October 25, 2007, will not be disturbed, and the rules will not be waived to provide for such entry. The petition is **denied**.

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