UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR

Tony W. Ho et al. Junior Party (Appl. Nos. 10/251,685 & 09/960,244)) v. **Leo T. Furcht et al.** Senior Party (Patent Nos. 7,659,118 & 7,015,037) (Application No. 11/084,256)	)	Interference No. 105,953(SGL) Decision on Request under 37 C.F.R. § 1.304(a)(3)(i)

MEMORANDUM AND ORDER

On November 20, 2014, Senior Party Leo T. Furcht, et. al. (Furcht) filed a "Request For Extension Of Time Pursuant To 37 CFR 1.304(a)(3)(i) And/Or 90.3(c)(1)(i)" (Request), seeking a one-month extension of time "for filing an appeal of the Decision and Judgement" of the Patent Trial and Appeal Board (Board) decision in Interference No. 105,953. Req. at 1. The Board issued its Decision on September 26, 2014. Per § 1.304(a)(1), any Notice of Appeal to the Federal Circuit was due on or before November 26, 2014. Because this Request was filed before the expiration of the period for seeking judicial review, this Request falls under the "good cause" standard of 37 C.F.R. § 1.304(a)(3)(i).[1]

Furcht explains that the additional month is necessary to assess "whether and where an appeal is taken," which turns on at least four issues. Req. at 2. Furcht represents that it needs

[1] On September 16, 2012, the existing USPTO regulations went into effect; the current regulations at 37 C.F.R. §§ 90.1-90.3 replaced those at 37 C.F.R. §§ 1.301-304. But per 37 C.F.R. § 90.1, "where available, judicial review of decisions arising out of interferences declared pursuant to 35 U.S.C. 135 continue to be governed by the pertinent regulations in effect on July 1, 2012." Thus, the previous regulations at § 1.304 apply here. Note that the standards governing additional time are the same in either set of regulations.

time to assess the merits of the issues reached by the Board Decision, and the impact of any judicial review on "other pending applications" held by it and Junior Party Tony W. Ho, et. al., (Ho). Req. at 2. Additionally, Furcht asks for additional time to determine whether Ho's claims "may be unpatentable on a basis other than that set forth in the decision." Req. at 2. Ho opposes[2] the Request, arguing that "good cause" does not exist because Furcht has failed to explain why the two months already afforded it to assess the merits of the Board's decision was inadequate for that task. Opp. at 2. Similarly, Ho argues that Furcht does not need time to assess whether Ho's claims are unpatentable for additional reasons because any judicial review here is limited to an appeal at the United States Court of Appeals for the Federal Circuit, and the Federal Circuit "reviews decisions of the Board on the record and will not review issues not raised." Opp. at 2-3 (citations omitted); *see generally Biogen Idec Ma, Inc. v. Japanese Found. for Cancer Research*, Civil Action No. 13-13061-FDS, 2014 WL 2167677 (D. Mass. May 22, 2014). Ho further argues prejudice in granting any additional time to Furcht given the length of time already elapsed in Ho's application, in part caused by Furcht. Opp. at 3. For its part, Furcht replies that *Biogen* does not "bind" Furcht. Reply at 2. And Furcht argues that the question of whether a district court action under 35 U.S.C. § 146 is available—which, Furcht maintains, permit Furcht to raise new grounds of unpatentability for Ho's claims—is unsettled because the

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[2] Ho filed an "Opposition" to Furcht's Request, who, in turn, filed a "Reply" to the Opposition. Because this matter involves private parties, and the papers were all filed within five (5) days of each other, the Director has exercised her discretion to consider them. But such filings should be avoided in the future. Neither the applicable regulations (37 C.F.R. § 1.301-304 (2012)), nor the current regulations (37 C.F.R. § 90.1-90.3), contemplate filing an "opposition" to a time extension request, nor a subsequent "reply." And because a time extension request can be acted upon immediately upon filing, parties should not contemplate the opportunity to even file subsequent papers in the future.

Biogen decision is currently before the Federal Circuit. Reply at 2-3.

The Director may extend the time for filing an appeal notice "[f]or good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action." 37 C.F.R. § 1.304(a)(3)(i).[3] Furcht's request breaks down along two lines, arguing that additional time is needed to both assess the merits of the Board Decision and the merits to any additional patentability issues outside the Board Decision that Furcht might attempt to raise about Ho's claims in a subsequent § 146 action.

The latter basis is troubling. In essence, Furcht asks for additional time to investigate whether there are patentability issues that it could have raised during the underlying interference proceeding with an eye to raising them in district court under 35 U.S.C. § 146. Furcht has not explained why he could not have analyzed "whether the Ho claims may be unpatentable on a basis other than that set forth in the [Board] decision" (Req. at 2) until after it received the Board decision. Furcht did not need the Board Decision to know what patentability issues had been raised with the Board; it is worth noting that, according to the interference file, undersigned counsel on the Request represented Furcht during the interference. *See* Intfr. No. 105,953 Paper # 4 (dated Jul. 10, 2013). Put differently, Furcht's basis for "good cause" to justify additional time to pursue judicial review of the Board decision has nothing to do with the Board Decision, let alone the merits of that Decision. The "good cause" standard does not contemplate condoning a parties' failure to diligently pursue the administrative procedures available to it and already conducted. Whether any new issues can be raised in a subsequent § 146 action does not speak to

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[3] Decisions on requests for additional time to seek judicial review of Board decisions are delegated to the Solicitor. MPEP § 1002.02(k)(3).

whether Furcht has adequately explained why he should receive additional time to determine whether he should pursue such an action. Reply at 3. Further, Section 146 is not available to Furcht in light of the statutory review scheme now in place, which permits review of final Board interference decisions in proceedings instituted after September 16, 2012—which includes this interference—only at the Federal Circuit under § 141. Thus, Furcht's request for additional time to investigate new issues to raise in district court cannot form the basis for the additional time sought. That the current scope of judicial review under that scheme does not include an action under § 146 is further confirmed by the *Biogen* decision. *See Biogen*, 2014 WL 2167677, at * 5. Furcht's protest that *Biogen* does not bind him (Reply at 2) is true only to the extent that the ruling does not bind a district court in another jurisdiction should Furcht file elsewhere. But even in that scenario, the district court's analysis in *Biogen* of whether a district court has subject matter jurisdiction under the statute to hear § 146 actions arising out of interferences instituted after September 16, 2012 will certainly carry great weight with a sister court confronted with the same issue. And ultimately, Furcht's argument is moot because the Federal Circuit is currently reviewing the district court decision in *Biogen*, and its decision will apply to all § 146 actions. For all these reasons, Furcht has failed to show "good cause" for the requested additional time premised upon this basis.

Nonetheless, Furcht has shown "good cause" exists to grant additional time in which to seek judicial review of the Board decision based upon Furcht's representation that such time is needed to assess the merits of the issues reached in the Board decision. While additional information as to why the two months already provided for by the rules was insufficient for that purpose would have strengthened Furcht's request (*see* Opp. at 2), Furcht's statement that he has

been "diligently considering" the merits of the Board Decision, but requires additional time to complete his review, suffices. Req. at 3. That "good cause" has been shown here is particularly true because the additional time sought—one month—is not disproportionate with this basis for the Request.

ORDER

Upon consideration of the Request for an extension of time under 37 C.F.R. § 1.304(a)(3)(i), it is ORDERED that the Request is granted.

Furcht's time for seeking judicial review of the Board decision in the underlying interference here under 37 C.F.R. § 1.304(a)(1) is extended for one (1) month from November 26, 2014, to December 29, 2014[4].

MICHELLE K. LEE
DEPUTY UNDERSECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND
DEPUTY DIRECTOR OF THE UNITED STATES
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DATE: December 12, 2014
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[4] By Executive Order, the Federal Government will be considered closed on December 26, 2014, pushing the extension date to the next business day, December 29, 2014.