

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR

In re Ian M. Robertson, et al.)
Application No. 11/359,581) Decision on Request
BPAI Final Decision: May 29, 2014) under 37 C.F.R. § 90.3(c)(1)(ii)

MEMORANDUM AND ORDER

On December 23, 2014, Applicant Ian M. Robertson (“Robertson”) filed a request denominated “Request for Extension of Time under 37 C.F.R. 90.3(c).” Req. at 1. Robertson’s request relates to the decision issued May 29, 2014 by the Patent Trial and Appeal Board (“Board”), affirming the Examiner’s rejection of all pending claims as obvious under 35 U.S.C. § 103 in Application No. 11/359,581 (“581 application”). The Request confirms that Robertson’s counsel (the law firm of Smart & Biggar) received electronic notice of the Board decision on the same day. Req. at 2 (¶ 5). Robertson explains that “[t]hrough inadvertance,” Robertson’s counsel did not follow its normal procedure upon receiving notice of a communication from the USPTO, which entails having a paralegal print out the document and “examine the communication to determine if any deadline needs to be docketed.” Req. at 2-3 (¶¶ 6-7). Because the Board decision was neither printed nor forwarded to the docketing department, “Smart & Biggar took no action in relation to the Decision.” *Id.*

Robertson explains that it was not until August 7, 2014—when the USPTO mailed a courtesy notice to Robertson that the USPTO considered the ’581 application abandoned because Robertson had failed to take timely action on the May 29, 2014 Board decision—that Smart & Biggar became aware of the Board decision. Req. at 3 (¶ 8). The responsible Smart & Biggar

attorney was on vacation at the time; he was made aware of the decision on August 25, 2014, the first day that he returned to the office. Req. at 3 (¶ 8). Robertson states that the decision and Notice of Abandonment was passed onto in-house counsel at BlackBerry Limited (assignee of the '581 application) via email the same day. Req. at 2 (¶ 3) & 3 (¶ 8). Robertson expressly states:

From August 25, 2014 until the filing of this Request, (i) the application was reviewed culminating in a decision that a continuation application with different claims was desired and (ii) research was conducted to determine what options might be available to recover from the abandonment so that the continuation application could be filed.

Req. at 3 (¶ 9).

In the first paragraph of the Request, Robertson states that he seeks “an extension of the time period specified in 37 CFR 90.3(a)(3)(i) for filing a civil action under 35 U.S.C. 145.” Req. at 1 (¶ 1). Such a request is consistent with 37 C.F.R. § 90.3(c)(1).¹ However, in the section titled “Relief Sought,” Robertson expressly states that he seeks the additional time in order to file a continuation application:

The Director is requested to extend the time period specified in 37 CFR 90.3(a)(3)(i) to a date that is 30 days after the issuance of a decision regarding the present request so that a continuation application may be filed.

Req. at 4. That Robertson seeks such relief is consistent with the body of the Request, which indicates that the period between August 25, 2014 (when Robertson became aware of the Board

¹ On September 16, 2012, various changes to title 37 of the Code of Federal Regulations took effect. These included replacing the previous regulations governing the seeking of judicial review of Board decisions at 37 C.F.R. §§ 1.301-304, with the provisions at 37 C.F.R. §§ 90.1-90.3. Since the Board decision here was issued after the September 16, 2012 effective date, the new rules would govern any time extension request. Substantively, however, the rules are effectively equal.

decision) and December 23, 2014 (when the Request was filed) was spent trying to figure out how to file a continuation application in light of the abandonment, which resulted in the underlying Request. 37 CFR § 90.3 neither contemplates nor permits the Director to extend the time to seek judicial review of a Board decision for the entirely different purpose of filing a continuation application. To wit, a civil action under 35 U.S.C. § 145 is not a “continuation application.” Granting the relief sought here by Robertson would be tantamount to reviving Robertson’s abandoned application, which is governed by a different regulation and standard. *See* 37 C.F.R. § 1.137; MPEP § 711.03. Thus, because Robertson’s Request seeks additional time under § 90.3(c) to file a continuation application, the Request is denied as improper. Robertson may pursue the proper mechanism for reviving his application and filing a continuation application if that is the relief he desires. *See, e.g.*, 37 C.F.R. § 1.137.

Moreover, given the above-referenced text and requested relief, it is impossible to treat Robertson’s request as one properly made for additional time to pursue judicial review under Rule 90.3. This denial is without prejudice to Robertson to filing a properly-styled request for additional time under the “excusable neglect” standard of 37 C.F.R. § 90.3(c)(1)(ii) if he desires to seek judicial review of the Board decision in the ’581 application. Any subsequently-filed request under Rule 90.3(c)(1)(ii) relating to the May 29, 2014 Board decision here must, of course, be consistent with the facts already described in the underlying Request.

Robertson should be aware that in determining excusable neglect, the USPTO applies the standard used by the Federal Courts. MPEP § 1216. The determination of whether failing to properly file a civil action or appeal within the prescribed time period is the result of “excusable neglect” is

an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include . . . [1] the danger of prejudice to [another party], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

Pioneer Inv. Servs. v. Brunswick Assocs. Ltd. P'ship, 507 U.S. 380, 395 (1993) (brackets added).

Excusable neglect "is understood to encompass situations in which the failure to comply with a filing deadline is attributable to negligence." *Id.* at 394. However, while "excusable neglect" is a "somewhat 'elastic concept,'" it is generally recognized that "inadvertence, ignorance of the rules, or mistakes construing the rules do not usually constitute 'excusable neglect.'" *Id.* at 392 (citations omitted). The third *Pioneer* factor—inquiring into the "reasons for the delay" in ultimately complying with the missed deadline—is generally considered the most important factor in the analysis. *See, e.g., Firsthealth of the Carolinas, Inc. v. Carefirst of Maryland, Inc.*, 479 F.3d 825 (Fed. Cir. 2007); *Graphic Commc'ns Int'l Union, Local 12-N v. Quebecor Printing Providence, Inc.*, 270 F.3d 1, 5-6 (1st Cir. 2001) ("the excuse given for the late filing must have the greatest import") (citations omitted); *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1587 n.7 (TTAB 1997) (cited with approval in *Firsthealth*).

An attempt to demonstrate entitlement to relief under Rule 90 and the *Pioneer* factors here should include the reasons given for late filing, which include the reasons why Robertson missed the original deadline for seeking judicial review and why it took until December 23, 2014 to take any action on the application.² Robertson should be aware that the sole reason given here for missing the original filing deadline—a law firm clerical error—is generally considered to be

² The Director recognizes that no formal action has been taken by Robertson in the '581 application during the pendency of the underlying Request here.

“wholly within the reasonable control” of the movant, which, in turn, is generally not understood to constitute “excusable neglect.” *See, e.g., Pioneer*, 507 U.S. at 398 (giving “little weight to the fact that counsel was experiencing upheaval in his law practice at the time” of the missed deadline); *Firsthealth*, 479 F.3d at 829-30 (upholding USPTO denial under “excusable neglect” standard where “reasons given for [the] delay were wholly within” movant’s control, including firm docketing error); *Pumpkin*, 43 USPQ2d at 1587-88 (same) (cited with approval in *Firsthealth*, 479 F.3d at 829).

Further, any subsequently-filed request under Rule 90.3(c)(1)(ii) for time to seek judicial review of the Board decision in the ‘581 application should also explain the basis for Robertson’s conclusion at the end of December, 2014 that filing a request for additional time to seek judicial review was the proper course of action to “recover from the abandonment” (Req. at 3 [¶ 9]) in order to file a continuation application. That inquiry is relevant to the reasons for the delay, and the length of the delay, at a minimum, under *Pioneer*. Robertson here does not cite to any authority supporting his conduct. Moreover, no rationale basis is apparent for concluding that a request for additional time to seek judicial review was the appropriate course of conduct after reviewing the governing regulations and guidance regarding how to “recover from abandonment.” Those regulations and guidance—in particularly, 37 C.F.R. § 1.137 and MPEP § 711.03—make clear that the appropriate mechanism for the outcome Robertson sought is a petition for revival. Even the Notice of Abandonment that Robertson received in August, 2014, and the triggered the events leading up to the filing of the underlying Request here, makes clear that a petition under 37 C.F.R. § 1.137 is the correct course to pursue for reviving an abandoned application. *See* ‘581 Application Notice of Abandonment (Aug. 7, 2014) (“Petitions to revive

under 37 CFR 1.137, or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.”). The law generally recognizes that a failure to appreciate governing rules does not amount to “excusable neglect.” See, e.g., *Pioneer*, 507 U.S. at 392; *In re Pettie*, 410 F.3d 189, 192 (5th Cir. 2005) (holding, in context of applying *Pioneer* to Fed. R. Civ. P. 60(b), that when delay is “attributable solely to counsel’s carelessness with or misapprehension of the law or the applicable rules of court,” it would have been an abuse of discretion for court to reopen case); *Graphic Commc’ns*, 270 F.3d at 5-6 (counsel’s ignorance of rules is not excusable neglect, applying *Pioneer*); *In re Rebel Rents, Inc.*, 326 B.R. 791 (C.D. Cal. 2005) (“reason for delay” factor weighed against “excusable neglect” where based on failure to read and understand relevant regulations). See also *Anheuser-Busch, Inc. v. Mambo Seafood #1, Inc.*, TTAB Opp. # 91160250 (Entry #76) (Aug. 31, 2009) (denying request for time extension under “excusable neglect” standard where parties’ explanation was not based upon a “reasonable or plausible” reading of relevant regulations). Any future request for additional time under Rule 90 should thus address these considerations.

ORDER

Upon consideration of Robertson's request under 37 C.F.R. § 90.3, it is ORDERED that the request is denied. This denial is without prejudice to Robertson to pursue a proper remedy regarding his abandoned application (*e.g.*, petition to revive under 37 C.F.R. § 1.137), or to file a Request under 37 C.F.R. § 90.3(c)(1)(ii) per this Order.

MICHELLE K. LEE
UNDERSECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND
ACTING DIRECTOR OF THE UNITED STATES
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DATE: March 11, 2015

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