

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE DIRECTOR

*IpVenture, Inc. v. FedEx Corp.* )  
Inter Partes Reexamination ) Decision on Request  
Control No. 95/001,896 ) under 37 C.F.R. § 1.304(a)(3)(ii)  
U.S. Patent No. 7,212,829 )  
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MEMORANDUM AND ORDER

On July 5, 2016, IpVenture, Inc. (owner of the involved '829 patent) filed a "Petition to Proceed with CAFC Appeal or to Reissue Board Decision" (Request). The Request seeks, among other relief, an extension of time under 37 C.F.R. § 1.304(a)(3)(ii) (Jul. 2012)<sup>1</sup> to file a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit in Inter Partes Reexamination Control No. 95/001,896. For the reasons given below, IpVenture's request is denied without prejudice to refile a time-extension request under 37 C.F.R. § 1.304(a)(3)(ii) if the need exists at a future date.

This case has a complicated procedural history. In relevant part, on September 29, 2015, the Patent Trial and Appeal Board (Board) issued its decision in the '896 reexamination, affirming the rejections of claims 1-183 in IpVenture's '829 patent. Under 37 C.F.R. § 41.79(a), IpVenture had one month from September 29, 2015, in which to file a request for rehearing with the Board; such a rehearing request was due on or before October 29, 2015. Alternatively, under 37 C.F.R. § 1.304(a)(1), IpVenture had two months from September 29, 2015, to file a notice of

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<sup>1</sup> 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. Because this Request arises in an inter partes reexamination requested under pre-AIA 35 U.S.C. § 311, the prior regulations govern. *See* 37 C.F.R. § 90.1. The July 2012 edition of Title 37 of the Code of Federal Regulations is cited herein for the prior regulations. Substantively, however, the

appeal to the Federal Circuit; such an appeal notice was due on or before November 30, 2015.<sup>2</sup>  
*See also* 37 C.F.R. § 41.81; 37 C.F.R. § 1.983.

IpVenture did not take either action by its respective deadline. Instead, on November 24, 2015, IpVenture filed a request for rehearing of the September 29, 2015 Board Decision. On April 1, 2016, the Board issued a paper titled “Decision on Request for Rehearing,” explaining that the request was untimely and that the Board did not have authority to address the paper. On May 26, 2016, IpVenture filed a notice of appeal to the Federal Circuit, seeking review of the September 29, 2015, and April 1, 2016 decisions.

On May 27, 2016, the Federal Circuit docketed IpVenture’s appeal as Appeal Number 2016-2139. On June 8, 2016, the USPTO filed a “Notice of Non-Filing of Certified List,” explaining that IpVenture’s appeal notice was untimely. *See IpVenture, Inc. v. FedEx Corp.*, Appeal No. 16-2139, ECF No. 2 (Jun. 8, 2016). On June 16, 2016, the Federal Circuit issued an order staying briefing and directing IpVenture to show cause within 30 days “why this appeal should not be dismissed as untimely.” *See id.*, ECF No. 17 (Jun. 16, 2016) (Taranto, J.). The order also permitted third-party requester FedEx Corp. to respond. *See id.* Both parties filed responses on July 18, 2016. *See id.*, ECF Nos. 18 & 19 (Jul. 18, 2016). On July 28, 2016, the Federal Circuit issued an order based on those responses, maintaining the stay in the briefing schedule and directing the parties to inform the Court regarding the disposition of the underlying Request within 14 days of the Director’s decision. *See id.*, ECF No. 20 (Jul. 28, 2016) (Bryson, J.)

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old and new time extension rules are effectively equal.

<sup>2</sup> The two-month date—November 29, 2015—was a Sunday, making the next day the filing due date.

As an initial matter, the Director observes that IpVenture's July 5, 2016 Request seeks different relief under various regulatory provisions, including 37 C.F.R. §§ 1.304, 41.79, 41.77, 1.181, and/or 1.183. IpVenture's Request runs afoul of 37 C.F.R. § 1.4(c), which requires that each distinct basis for relief be raised in a separate filing. The USPTO typically treats a paper violating Rule 4(c) as one raising the basis for relief articulated therein that makes the most sense to address. Given the timing of the July 5, 2016 filing, the parties' responses to the Federal Circuit's June 16, 2016 show cause order, and the Federal Circuit's July 28, 2016 order, the USPTO will treat IpVenture's July 5, 2016 filing as a request for additional time to seek judicial review pursuant to 37 C.F.R. § 1.304.

The Director may extend the time for filing an appeal after the expiration of the period for filing an appeal "upon a showing that the failure to act was the result of excusable neglect." 37 C.F.R. § 1.304(a)(3)(ii) (Jul. 2012). The authority to decide such requests has been delegated to the Solicitor. *See* MPEP § 1002.02(k)(3). In determining excusable neglect, the USPTO applies the standard used by the Federal Courts. *See* MPEP § 1216; *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P'ship*, 507 U.S. 380, 395 (1993); *see, e.g., Rambus, Inc. v. Nvidia, Corp.*, Memorandum and Order on 37 C.F. R. § 1.304(a)(3)(ii) Request (*Inter Partes* Reexam Control No. 95/001,169) (Jul. 11, 2013) ("*Rambus Order*").

Whether IpVenture has adequately demonstrated "excusable neglect" cannot be decided, however, because IpVenture filed its time-extension request after filing its notice of appeal with the Federal Circuit. The USPTO loses jurisdiction over the administrative proceedings to perform anything but "purely ministerial" functions once a party files a notice of appeal. *See In*

*re Graves*, 69 F.3d 1147, 1149-50 (Fed. Cir. 1995); *Barbacid v. Brown*, 223 F. App'x 972 (Fed. Cir. 2007) (nonprecedential); *Loshbough v. Allen*, 359 F.2d 910, 912 (C.C.P.A. 1966); *In re Grier*, 342 F.2d 120, 123 (C.C.P.A. 1965). Only ministerial tasks like correcting obvious record errors can be performed by the USPTO once the notice of appeal has been filed. *See, e.g., Grier*, 342 F.2d at 123. Providing *nunc pro tunc* relief in the form of additional time in which to seek judicial review does not appear to fall within the limited functions that can be performed after jurisdiction has passed to the Federal Circuit.<sup>3</sup> *See id.*

Ultimately, whether an appeal notice was timely filed is a question of jurisdiction, and only the Federal Circuit can decide its own jurisdiction. *See Barbacid*, 223 F. App'x at 973; *see also Bowles v. Russell*, 551 U.S. 205, 214 (2007) (“[T]he timely filing of a notice of appeal in a civil case is a jurisdictional requirement”). Thus, Federal Circuit Rule 15(a)(1) indicates that the only function the USPTO serves once an appeal notice is filed is to “promptly advise the clerk of court that the notice is or is not timely”; it does not contemplate that the USPTO will adjust the time period for filing that notice or otherwise decide whether the notice was timely. Here, the USPTO advised the Court on June 8, 2016 that it believed IpVenture’s notice of appeal to be untimely.

The Director acknowledges that in *Graves*, the Federal Circuit explained that jurisdiction passes to the Federal Circuit upon filing of a notice of appeal from an “appealable decision” and indicated that an appeal notice filed outside the appeal window was not such a filing. *See* 69 F.3d at 1150. But IpVenture has taken the position that its May 26, 2016 Notice of Appeal was indeed

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<sup>3</sup> The USPTO would seemingly lack jurisdiction to reach any of the substantive arguments raised

timely, both before the Federal Circuit and the USPTO. *See, e.g., IpVenture, Inc. v. FedEx Corp.*, Appeal No. 16-2139, ECF No. 19, at 2 (Jul. 18, 2016); Request at 4-5. And governing precedent indicates that once the filing deadline passes, additional time must be sought from the USPTO before filing a notice of appeal. *See Barbacid*, 223 F. App'x at 973-74; *Loshbough*, 359 F.2d at 912; *see also Rambus Order* at 5-6, and citations therein. Thus, the Director has previously stated that a time-extension request is not available to “back-date” an already-filed notice of appeal; rather, an untimely appeal must first be dismissed to pass jurisdiction back to the USPTO before a time-extension request can be considered by the Director. *See e.g., Rambus Order; In re Ishii*, Memorandum and Order on Request for Additional Time to File Federal Circuit Appeal (U.S. Application Serial No. 09/655,847) (Feb. 6, 2009).

In short, while the USPTO is mindful that the Federal Circuit has stayed the appellate proceedings in this reexamination pending resolution of IpVenture’s time-extension Request (*see IpVenture, Inc. v. FedEx Corp.*, Appeal No. 16-2139, ECF No. 20 (Jul. 28, 2016) (Bryson, J.)), the Director feels constrained to deny the Request for lack of jurisdiction under governing precedent and rules. Obviously, nothing prevents the Federal Circuit from deciding whether it has jurisdiction over IpVenture’s appeal. The Court may decide that IpVenture’s notice of appeal was timely filed, which would moot the need for any time extension under 37 C.F.R. § 1.304. And if the Federal Circuit decides that the appeal should be dismissed as untimely, this Order is without prejudice to IpVenture reasserting its arguments for why it satisfies the “excusable

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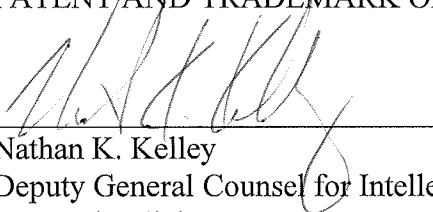
by IpVenture’s July 5, 2016 “Petition” under governing precedent.

neglect” standard based on all the facts in this case once the proceedings are returned to the USPTO.

ORDER

Upon consideration of the request for an extension of time under 37 C.F.R. § 1.304(a)(3)(ii), it is ORDERED that the request is denied without prejudice to IpVenture refiling a time-extension request if the Federal Circuit dismisses Appeal No. 2016-2139 as untimely filed.

MICHELLE K. LEE  
UNDERSECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

By:   
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DATE: August 19, 2016

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