Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

KELLENBERGER ET AL., [FN1] JUNIOR PARTY
v.
DUENK ET AL., [FN2] SENIOR PARTY
Interference No. 102,172
March 14, 1991

Harry F. Manbeck, Jr.

Commissioner of Patents and Trademarks

MEMORANDUM AND ORDER

***1** Kellenberger et al. (Kellenberger) petition (Paper No. 84) pursuant to 37 CFR § 1.644(a)(3) seeking waiver of a rule. See also 37 CFR § 1.183. The petition is denied.

Background

On January 11, 1991, an Examiner-in-Chief entered an order (Paper No. 71) dismissing Kellenberger's motion for additional discovery (Paper No. 52) holding that Kellenberger failed to comply with 37 CFR § 1.637(b). Section 1.637(b) requires a certificate stating that the moving party has conferred in good faith with the opposing party to resolve by agreement the issues raised by the motion.

The interference rules provide that a request for reconsideration may be filed within 14 days of entry of an order. 37 CFR § 1.640(c). Accordingly, a timely request for reconsideration of the Examiner-in-Chief's order was due on or before January 25, 1991.

On February 1, 1991, Kellenberger mailed a request for reconsideration (Paper No. 78) to the Patent and Trademark Office. The request was received at the Board of Patent Appeals and Interferences on February 6, 1991. In the request, Kellenberger specifically refers to the provisions of 37 CFR § 1.640(c); indeed, Kellenberger notes that he is under an obligation to discuss the points which he believes the Examiner-in-Chief misapprehended or overlooked in dismissing the motion. Kellenberger did not explain why the request was filed out-of-time. In particular, Kellenberger did not state when the Examiner-in-Chief's order was received.

On February 12, 1991, a panel of the Board entered an order (Paper No. 80) dismissing the request for reconsideration as untimely filed, citing 37 CFR § 1.640(c).

On February 25, 1991, Kellenberger mailed a petition (Paper No. 84) to the Patent and Trademark Office. It was received at the Board on February 28, 1991. Petitions in interference cases are governed by 37 CFR § 1.644. Section 1.644(d) provides that a "petition will be decided on the basis of the record made before the examiner-in-chief or

the [Board] panel and no new evidence will be considered by the Commissioner in deciding the petition" (emphasis added). Notwithstanding § 1.644(d), Kellenberger's petition is accompanied by Exhibits A and B, neither of which was presented to the Examiner-in-Chief or the panel of the Board which considered Kellenberger's request for reconsideration.

Exhibit A is a copy of the Examiner-in-Chief's order of January 11, 1991. The exhibit is date-stamped "received" on Jan. 28, 1991--which is 17 days after the date of the Examiner-in-Chief's January 11, 1991, order. Exhibit B is a declaration of Kellenberger's counsel authenticating Exhibit A.

***2** Kellenberger maintains that relief should be granted because counsel received the Examiner-in-Chief's order after the 14-day time period for seeking reconsideration expired.

Opinion

The rules governing petitions in interferences specifically provide that the Commissioner does not consider evidence not first presented to the Examiner-in- Chief or a Board panel. 37 CFR § 1.644(d). There are practical reasons for § 1.644(d). If an Examiner-in-Chief or a panel of the Board considers evidence in the first instance, a petition may be unnecessary. "Petitions in interferences have been the source of substantial delay. Section 1.644 attempts to minimize those delays." Notice of Final Rule, 49 Fed.Reg. 48416, 48425 (Dec. 12, 1984), reprinted in, 1050 Off.Gaz.Pat. Office 385, 394 (Jan. 29, 1985). One way to minimize delay is to have evidence considered by the Board in the first instance.

Apart from the fact Kellenberger did not submit Exhibits A and B to the Board with his request for reconsideration, he likewise did not tell the Board in the request why it was being filed out-of-time. In fact, insofar as the Board was concerned, the record simply showed a late-filed request. Clearly, there was no error in dismissing the request. Compare Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 1388, 9 U.S.P.Q.2d 1736, 1738 (Fed.Cir.1989) (Markey) (since Keebler failed to tell the TTAB it was interested in Murray's "intent," it could not use intent as a basis for showing "error" by the TTAB; prescience is not a required characteristic of the board and the board need not divine all possible afterthoughts of counsel that might be asserted for the first time on appeal). Kellenberger's failure to advise the Board in the request why it was not being timely filed does not create an "extraordinary circumstance" within the meaning of 37 CFR § 1.183. Nor can it be argued that Kellenberger, through counsel, was unaware of § 1.640(c)--it was cited in his request. In any event, counsel's unfamiliarity with the 14-day provision would not create an "extraordinary circumstance." Compare Potter v. Dann, 201 USPQ 574 (D.D.C.1978) (registered attorney's unawareness of PTO rules does not constitute unavoidable delay).

ORDER

Upon consideration of Kellenberger's PETITION TO THE COMMISSIONER UNDER 37 C.F.R. § 1.183 (Paper No. 84), it is

ORDERED that the petition is denied and it is

FURTHER ORDERED that Exhibits A and B are returned as improper papers under 37 CFR § 1.618, since they were not first presented to the Examiner-in-Chief or the Board.

FN1. The notice declaring the interference did not list an assignee for Kellenberger et al. Nor has any document been submitted pursuant to 37 CFR § 1.602(b) or (c) indicating an assignee. However, a paper appointing lead counsel is signed by a registered practitioner giving an address at the Kimberly-Clark Corporation. It is assumed, therefore, that Kimberly-Clark Corporation is the assignee. Within twenty (20) days of the date of this order, Kellenberger et al. should identify the assignee, if any, of the Kellenberger et al. patent involved in this interference.

FN2. Assignor to The Proctor & Gamble Company, a corporation of Ohio.

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