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

JONAS, [FN1] JUNIOR PARTY
v.
ABILDSKOV, [FN2] SENIOR PARTY
Interference No. 102,086
April 19, 1990

Richard W. Hanes, Esq. for Jonas, Junior Party

Calvin E. Thorpe, Esq. of Thorpe, North & Western for Abidskov, Senior Party

Harry F. Manbeck, Jr.

Assistant Secretary and Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND ORDER

***1** Jonas has filed a petition to the Commissioner (Paper No. 15), seeking to (1) stay the interference, (2) waive rules, and (3) set aside an order to show cause entered by an Examiner-in-Chief. For reasons hereinafter given, all requested relief is denied.

Background

The interference was declared between Jonas' patent and Abildskov's application on March 8, 1989.

The Examiner-in-Chief entered a decision on preliminary motions on July 20, 1989 (Paper No. 11).

A testimony period for Junior Party Jonas was set to close on October 15, 1989 (Paper No. 11, page 3).

Based on the interference record in the Patent and Trademark Office, no testimony was taken by Jonas. Accordingly, on January 23, 1990, the Examiner- in-Chief entered an order requiring Jonas to show cause why judgment should not be entered against him (Paper No. 14). A period of twenty (20) days was set within which Jonas could respond.

Jonas did not respond within the twenty-day period, which expired on February 12, 1990.

On February 20, 1990, Jonas filed the petition (Paper No. 15). Exhibits A through J accompanied the petition.

On February 27, 1990, a panel of the Board of Patent Appeals and Interferences (Board) entered judgment (Paper No. 16) against Jonas on the grounds that he had failed to timely respond to the order to show cause (Paper No. 14). The Board gave no weight to the petition since it

was not filed within the time set to respond to the order to show cause.

On March 14, 1990, Jonas caused to be forwarded to the Patent and Trademark Office a request (Paper No. 17) that the Board reconsider its decision. The request was served by first-class mail on counsel for Abildskov. A stamped certificate on the last page of the request states:

I hereby certify that this correspondence is being deposited with the Federal Express as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on March 14, 1990, Richard W. Hanes Richard W. Hanes, Reg. 19530 Date 3/14/90.

The underscored portion of the quoted material is in handwriting. The request was received in the Mail Room of the Patent and Trademark Office on March 15, 1990.

The Petition

The petition (Paper No. 15) seeks at least the following relief:

(1) a stay of the interference pending a decision in Edo Corp. v. Beech Aircraft Corp., Appeal No. 88-2816, in the U.S. Court of Appeals for the Tenth Circuit;

(2) waiver of the "rules" to permit the taking of testimony, if needed, after the Tenth Circuit enters its decision; and

***2** (3) setting aside the order to show cause entered by the Examiner-in- Chief on January 23, 1990.

Several exhibits accompanied the petition which had not previously been submitted to the Examiner-in-Chief. A petition in an interference, however, is decided on the record made before the Examiner-in-Chief. 37 CFR § 1.644(d). Since Exhibits B, E, F, I, and J were not presented to the Examiner-in-Chief, they will not be considered and are returned to Jonas as improper papers. 37 CFR § 1.618(a). Exhibit H is also returned to Jonas, inasmuch as it is a copy of a paper already of record in the file of the interference. 37 CFR § 1.618(b).

Discussion

The petition is denied for several independent and dispositive reasons.

First, the record does not reveal that Jonas asked the Examiner-in-Chief to stay the interference pending a decision by the Tenth Circuit. It is not appropriate in an interference to seek a stay from the Commissioner in the first instance. Compare Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982); Swanson v. Price, 215 USPQ 970 (Comm'r Pat. 1981).

Second, the record likewise does not reveal that Jonas asked the Examiner-in- Chief to accept any testimony which might be taken following litigation in the Tenth Circuit.

Third, it is not clear how priority of invention can be resolved in

the litigation in the Tenth Circuit. Compare Gutman v. Beriger, 200 USPQ 596 (Comm'r Pat. 1978), and English v. Heredero, 211 USPQ 1143, 1143-1144 (Comm'r Pat. 1980).

Fourth, Jonas does not specify which rule he seeks to have waived. Moreover, as Myers v. Feigelman, 455 F.2d 596, 601, 172 USPQ 580, 584 (CCPA 1972) reveals, waiver of rules on routine basis would defeat the purpose of the rules and substantially confuse interference practice.

Jonas' Request for Reconsideration

The request (Paper No. 17) transmitted to the Patent and Trademark Office on March 14, 1990, and received in the Mail Room on March 15, 1990, was not timely filed. The Board's decision was entered on February 27, 1990. The period for seeking reconsideration is fourteen (14) days. 37 CFR § 1.658(b). The fourteen-day period expired on March 13, 1990. The request was transmitted to the Patent and Trademark Office by Federal Express on March 14, 1990. A document transmitted to the Patent and Trademark Office by Federal Express is filed on the day it is received. The request was received in the Mail Room on March 15, 1990. Hence, the request was not timely filed.

The request will not be considered by the Board unless Jonas, within ten (10) days, shows sufficient cause why the request was not timely filed. 37 CFR § 1.645(b).

***3** The period for seeking judicial review continues to run from entry of the Board's final decision (Paper No. 16). Thus, proceedings in this interference will be terminated on April 30, 1990 (35 U.S.C. § 141; 37 CFR § 1.304), unless:

(1) a timely motion to extend the time for seeking reconsideration is filed and the Board determines that the motion should be granted, in which case the Board will render a decision on reconsideration; or

(2) on or before April 30th, an appeal is taken to the Federal Circuit or a civil action is commenced under 35 U.S.C. § 146.

ORDER

Upon consideration of the petition (Paper No. 15) filed by Jonas, it is

ORDERED, for the reasons given above, that the petition is denied.

FN1. Assignor to Beech Aircraft Corporation of Wichita, Kansas, a corporation of Delaware.

FN2. Assignor to Edo Corporation of College Point, New York, a corporation of New York.

16 U.S.P.Q.2d 1459

END OF DOCUMENT