

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHONGQING YANMEI TECHNOLOGY CO., LTD.,
Petitioner,

v.

TERVES, LLC,
Patent Owner.

IPR2023-00521
Patent 10,689,740 B2

Before MICHAEL P. TIERNEY, *Vice Chief Administrative Patent Judge*.

DECISION ON PETITION

This is a decision dismissing Petitioner’s Petition Under 37 C.F.R. § 1.181(a)(3), 1.182, and/or 41.3 to Invoke Supervisory Authority of the Director and/or Consideration of Question not Specifically Provided for,” filed July 27, 2023 (Paper 9, “Petition”). In the Petition, Petitioner requests “review and reversal of the decision of the Board to deny authorization under 37 CFR 42.20(b) to file a Motion and Reply to the Patent Owner preliminary response.” Petition 4. For the reasons explained below, the Petition is dismissed because 37 C.F.R. §§ 1.181(a)(3), 1.182, and 41.3 do not apply to this proceeding.

PROCEDURAL HISTORY

1. On January 24, 2023, Chongqing Yanmei Technology Co., Ltd. (“Petitioner”) filed a petition requesting an inter partes review (“IPR”) of claims 1–81 of U.S. Patent No. 10,689,740. Paper 2.
2. On June 5, 2023, Patent Owner filed a Preliminary Response to the Petition. Paper 7.
3. On July 20, 2023, in an email to Trials@uspto.gov, Petitioner requested authorization to file a Reply to the Preliminary Response. Ex. 3001.
4. On July 21, 2023, the Board denied Petitioner’s request to file a Reply to the Preliminary Response. *Id.*
5. On July 27, 2023, Petitioner filed the instant Petition, along with a proposed motion seeking authorization to file a Reply to the Preliminary Response, and a proposed Reply. Papers 9–11.

RELEVANT AUTHORITY

37 C.F.R. § 1.181 provides in pertinent part:

(a) Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
- (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

...

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 C.F.R. § 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.1(a) provides:

(a) *Scope.* Part 41 governs appeals and interferences before the Patent Trial and Appeal Board. Sections 1.1 to 1.36 and 1.181 to 1.183 of this title also apply to practice before the Board, as do other sections of part 1 of this title that are incorporated by reference into part 41.

37 C.F.R. § 41.3 provides:

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action.

(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

37 C.F.R. § 42.1(a) provides:

(a) *Scope*. Part 42 governs proceedings before the Patent Trial and Appeal Board. Sections 1.4, 1.7, 1.14, 1.16, 1.22, 1.23, 1.25, 1.26, 1.32, 1.34, and 1.36 of this chapter also apply to proceedings before the Board, as do other sections of part 1 of this chapter that are incorporated by reference into this part.

37 C.F.R. § 42.2 provides in pertinent part:

The following definitions apply to this part:

...

Proceeding means a trial or preliminary proceeding.

37 C.F.R. § 42.5(b) provides:

(b) The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.

DISCUSSION

On June 5, 2023, Patent Owner filed a Preliminary Response. Paper 7. On July 20, 2023, Petitioner requested authorization to file a motion for leave to file a Reply to the Preliminary Response. Ex. 3001. On July 21, 2023, the Board denied Petitioner's request, stating that "requests to file a Reply to a Preliminary Response must be made promptly" and that "[i]n this case, a delay of 45 days between the filing of the Preliminary Response and the request for authorization to file a Reply leaves insufficient time to complete briefing and draft the Institution Decision." *Id.*

In the instant Petition, Petitioner asserts that "[t]he Board's claim that waiting 45 days in requesting authorization" in the 3-month period for rendering an institution decision "is not reasonable and appears arbitrary." Petition 7. Petitioner also argues that Patent Owner's Preliminary Response contains numerous unforeseeable arguments to which the Petitioner should have the right to respond. *Id.* at 7.

Petitioner contends that the Chief Administrative Patent Judge has the authority to review the Board's decision to deny authorization under 37 CFR § 42.20(b). *Id.* at 4–6. Specifically, Petitioner argues the following:

A petition to the director to invoke the supervisory authority of the director under 37 CFR 1.181(a)(3) for matters involving the Board is delegated to the Chief Administrative Patent Judge under 37 CFR 41.3(a). Further a request for review of a denial of authorization under 37 CFR 42.20(b) is not specifically provided for in 37 CFR 41.3. Therefore, the matter should be decided as a petition not specially provided for under 37 CFR 1.182. Under MPEP 1002(f)(6)(e) the authority to decide petitions under 37 CFR 1.182 rests with the Chief Administrative Patent Judge of the Patent Trial and Appeal Board.

Id. at 6.

Supervisory review of the Board's decision to deny authorization under 37 C.F.R. § 42.20(b) is not available under 37 C.F.R. §§ 1.181(a)(3), 1.182, or 41.3. Title 37, Chapter I, Subchapter A, Part 42 of the Code of Federal Regulations governs trial and preliminary proceedings before the Board. 37 C.F.R. §§ 42.1(a), 42.2.¹ Part 42 incorporates certain sections of Part 1. *Id.* § 42.1(a). Specifically, Part 42 states that "Sections 1.4, 1.7, 1.14, 1.16, 1.22, 1.23, 1.25, 1.26, 1.32, 1.34, and 1.36 of this chapter also apply to proceedings before the Board, as do other sections of [P]art 1 of this chapter that are incorporated by reference into this part." *Id.* Part 42, however, does not incorporate Sections 1.181, 1.182, or 41.3. *See id.*

Moreover, in contrast to Part 42, Part 41 "governs appeals and interferences" before the Board and expressly incorporates Sections 1.181 to 1.183. 37 C.F.R. § 41.1(a). Section 41.3 expressly references Part 41, stating that "[t]his section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205)." In other words, 37 C.F.R. § 41.3 applies to appeal and interference proceedings under Part 41, not trial

¹ Section 42.1(a) refers to "proceedings," and Section 42.2 defines "[p]roceeding" as "a trial or preliminary proceeding."

and preliminary proceedings before the Board under Part 42. Accordingly, Sections 1.181, 1.182, and 41.3 do not apply to trial and preliminary proceedings before the Board.

Part 42 allows the Board to “waive or suspend a requirement of parts 1, 41, and 42.” *Id.* § 42.5(b). But, here, Petitioner does not explain persuasively why the Board should waive or suspend the limitations of Section 42.1(a) and allow Petitioner to petition under Sections 1.181(a)(3) or 1.182 in this proceeding.

In sum, Petitioner’s Petition has been considered; however, relief is not available under 37 C.F.R. §§ 1.181(a)(3), 1.182, and/or 41.3. Accordingly, Petitioner’s Petition is **dismissed**.

CONCLUSION

In view of the foregoing, Petitioner’s Petition Under 37 C.F.R. § 1.181(a)(3), 1.182, and/or 41.3 to Invoke Supervisory Authority of the Director and/or Consideration of Question not Specifically Provided for is DISMISSED.

/Michael P. Tierney/
Michael P. Tierney
Acting Deputy Chief Administrative Patent Judge

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