

78. The Board also abused its discretion by accepting Revel's allegations regarding the statements allegedly made during the conference call over Sehgal's denials of those allegations.

79. Contrary to the Board's determination, the recitation of the circumstances surrounding abandonment in the Motion for Benefit proves that Mr. Schulman did indeed conduct a thorough investigation to support the required statement under 37 C.F.R. §1.137(b).

80. The Board's decision (Exhibit 16) failed to accord any weight to Mr. Schulman's statement in the Petition to Revive.

81. The Board's failure to accord any weight to Mr. Schulman's statement in the Petition to Revive is contrary to both the PTO's regulations and the long established policy of the PTO.

82. The Board's failure to accord any weight to Mr. Schulman's statement in the Petition to Revive is unsupported by substantial evidence and an abuse of discretion in view of the recitation of circumstances regarding the cause of abandonment and the copies of relevant correspondence provided with the Motion for Benefit that accompanied the Petition to Revive.

F. Plaintiff has met its burden of establishing its entitlement to the benefit of the '215 application

83. The file histories of the '215 and '998 applications prove that the abandonment of the '215 application was unintentional.

84. Sehgal's Motion for Benefit (which accompanied the Petition to Revive) recited the circumstances surrounding the abandonment in detail and provided substantial supporting documentation.

85. The file history of the '215 application shows that the Examiner mailed a final rejection on January 27, 1984 (Exhibit 6).

86. The file history of the '215 application shows that in response to the final rejection, Sehgal filed a request for continuation application under 37 C.F.R. § 1.60 on July 27, 1984 (Exhibit 14), within the six month statutory period for filing a response.

87. The file history of the '998 application shows that the request for a continuation application provided a true copy of the '215 patent application as well as a copy of the original declaration (Exhibit 19).

88. The file history of the '998 application shows that the specification was amended to claim the benefit of the '215 parent application (Exhibit 11, page 2, no. 8).

89. The file history of the '998 application shows that there were pending claims in the '215 patent application as filed. (Exhibit 19)

90. The file history of the '998 application shows that the submission of papers in the continuation filing included authorization to charge a deposit account for the filing fee as well as any other fees which might be required. (Exhibit 11, page 2, no. 4)

91. The file history of the '998 application shows that the PTO accepted Sehgal's request for a continuation application and accorded Sehgal the benefit of the '215 parent application filing date. This is evident from the notation on the front cover of the file wrapper of the '998 continuation application (Exhibit 14) and the PTO Filing Receipt (Exhibit 15).

92. In view of the acceptance by the PTO of Sehgal's '998 continuation application, prosecution of the '998 application proceeded with no delay as shown by issuance of a first official action on the merits on February 9, 1987. (Exhibit 20).

93. The Sehgal file histories reflect that over the course of the next 20 years, the PTO continued to accord Sehgal the benefit of its '215 application in both the '998 continuation and in

the subsequently filed applications, and Sehgal relied upon the benefit accorded by the PTO in continuing to prosecute the applications. (Exhibit 29).

94. The PTO specifically recognizes receipt of an Official Filing Receipt giving an applicant benefit of an earlier filed application as a “positive documented act and official act” on which an applicant may rely in concluding that applicant has satisfied the copendency requirements of Rule 60 (OG Notice, Exhibit 21).

95. In view of the PTO’s recognition that an applicant may rely on receipt of the Official Filing Receipt, Sehgal’s belief that the copendency requirement for the ‘998 application was satisfied was reasonable.

96. Until receipt of Revel’s List of Motions (Exhibit 5), Sehgal received no notification that its ‘215 application may have been technically abandoned before Sehgal filed its ‘215 continuation application.

97. The Motion for Benefit included the relevant correspondence regarding the abandonment of the ‘215 application, including a copy of Sehgal’s express request to abandon the ‘215 application at the time that the continuation was filed. (Exhibit 11, page 2, no. 11)

98. Such a request is entirely inconsistent with the notion that the application was intentionally abandoned prior to that time.

99. The filing of a continuation application and the inclusion of an express request to abandon the parent application when the continuation was filed evidences that the earlier abandonment of the ‘215 application was unintentional.

100. There was no delay in the prosecution of the ‘998 application or any of the succeeding Sehgal applications caused by the untimely abandonment of the ‘215 application.

101. The grant of Sehgal's Petition to Revive for revival of the '215 parent application will provide the needed copendency between the '215 application and the '998 application.

102. Once copendency is established, Sehgal is entitled to the benefit of the '215 parent application filing date since the provisions of 35 U.S.C. § 120 are satisfied with respect to the request for priority compliance with the provisions of 35 U.S.C. § 112.

103. Upon grant of the Petition to Revive, the lapse in copendency between the '215 application and the '998 application would be eliminated and Sehgal would be afforded the benefit of the '215 application.

II. Plaintiff has exhausted all administrative remedies

104. On August 16, 2005, Sehgal requested a rehearing pursuant to 37 C.F.R. § 41.125(c) of the Board's decision of August 2, 2005 denying the Motion for Benefit. (Exhibit 22)

105. On August 16, 2005, Sehgal also filed a petition under 37 C.F.R. § 41.3 (Exhibit 23) requesting that the Chief Administrative Patent Judge instruct the Board to withdraw its decision on Sehgal's Motion for Benefit and to expunge from the interference record all of the Board's findings of fact and holdings related to the merits of the Petition to Revive. Sehgal further requested that the Board be instructed to submit Sehgal's Petition to Revive, as well as the accompanying petition under 37 C.F.R. § 1.183 to waive the requirement for a terminal disclaimer, to the Office of the Deputy Commissioner for Patent Examination Policy for a decision on the merits thereof.

106. On December 21, 2005, the Board denied Sehgal's request for rehearing and dismissed Sehgal's petition to have the Petition to Revive forwarded to the Office of the Deputy Commissioner for Patent Examination Policy.

107. On January 1, 2006, Sehgal filed a request for reconsideration of the Board's decision dismissing the petition filed under 37 C.F.R. § 41.3 on August 16, 2005 (Exhibit 24).

108. The Board rejected Sehgal's request for reconsideration on January 12, 2006 (Exhibit 25).

109. In a conference call held on April 14, 2006, Sehgal indicated that it would request adverse judgment in the interference solely on the basis of the unpatentability of Sehgal's claims over the prior art (i.e., Sehgal's own publication) in view of the denial of the Motion for Benefit.

110. Sehgal indicated that it would seek review of the decision denying the Motion for Benefit of the '215 parent application.

111. Sehgal indicated that it was not conceding priority and might wish to continue a priority determination if the Board's decision denying its Motion for Benefit is reversed (Exhibit 26).

112. The request for adverse judgment did not concede priority and was only filed to provide an opportunity to appeal the Board's decision denying Sehgal the benefit of the '215 application (Exhibit 26).

113. On May 2, 2006, the Board entered Judgment in the interference in response to Sehgal's request for adverse judgment (Exhibit 27).

114. Although the Board's order entered judgment on priority against Sehgal, the Board noted that if the decision denying Sehgal's Motion for Benefit was reversed on appeal, then a new priority phase might become necessary.

III. The Director has Unreasonably Withheld or Delayed Action on Plaintiff's 183 Petition and the Petition to Revive

115. On April 12, 2006, Sehgal filed a Petition under 37 C.F.R. § 1.183 ("the 183 Petition", Exhibit 28) urging that the Board had abused its discretion and requesting that the Chief

Administrative Judge or the Director [actually styled Commissioner] instruct the Board to withdraw its decision denying the Motion for Benefit, expunge from the interference record all of the Board's findings of fact and holdings related to the merits of the Petition to Revive, and to instruct the Board to submit the Sehgal Petition to Revive to the Office of the Deputy Commissioner for Patent Examination Policy for decisions on the merits thereof in accordance with the PTO's regulations.

116. Defendant Director has not decided either the 183 Petition or the Petition to Revive.

117. Plaintiff must appeal the decision of the Board by two months from the date of the Board's decision.

118. The records of the Interference are made of record in the present action in their entirety.

COUNT I

(The Board abused its discretion in deciding the Petition to Revive)

119. Paragraphs 1 through 118 are incorporated by reference as if fully restated herein.

120. The Board's decision denying Plaintiff's Motion for Benefit represents an abuse of discretion and is unsupported by substantial evidence.

121. As the Director's designate, the Office of the Deputy Commissioner for Patent Examination Policy has the sole authority for deciding petitions to revive. M.P.E.P. 1002.02(b).

122. The Board failed to forward the Petition to Revive to the Office of the Deputy Commissioner for Patent Examination Policy prior to deciding the Motion for Benefit.

123. By effectively deciding the Petition to Revive, the Board failed to follow the PTO's own regulations and acted outside its statutory authority pursuant to 35 U.S.C. §6.

124. Plaintiff is entitled to have the Board's denial of benefit of the '215 parent application withdrawn and its Petition to Revive decided by the Office of the Deputy Commissioner for Patent Examination Policy.

125. On remand, the Board should be required to forward the Petition to Revive to the Office of the Deputy Commissioner for Patent Examination Policy for a timely decision on the merits.

126. Upon receipt, the Office of the Deputy Commissioner should grant the Petition to Revive because it meets all of the requirements of 37 C.F.R. § 1.137(b).

127. Once the Petition to Revive is granted, copendency will be established so that Sehgal will be entitled to the benefit of the '215 application and further proceedings in the Interference to determine priority between the parties may take place.

COUNT II

(The Board's decisions should be withdrawn as unsupported by substantial evidence and an abuse of discretion)

128. Paragraphs 1 through 127 are incorporated by reference as if fully restated herein.

129. The Board's decision denying Plaintiff's Motion for Benefit is unsupported by substantial evidence and represents an abuse of discretion.

130. The Board abused its discretion by failing to accord any weight to the statements of counsel in the Petition to Revive contrary to the PTO's own regulations and well established practice.

131. The Board abused its discretion by applying an arbitrary evidentiary standard requiring an affidavit to support counsel's statement in the Petition to Revive when, in fact, the PTO's regulations not only require no such affidavit, but rather induce reliance otherwise by indicating that the PTO accepts the statement of counsel in the vast majority of cases and otherwise will request additional information.

132. The Board's factual determinations are unsupported by substantial evidence because the Board overlooked or misconstrued the extensive facts cited in the Motion for Benefit and the

documents provided therewith that conclusively establish that the abandonment of the '215 application was unintentional.

133. The Board's factual determinations regarding an inquiry to support counsel's statement in the Petition to Revive are unsupported by substantial evidence because the detailed recitation of the facts in the record regarding the circumstances surrounding the abandonment of the '215 application in the Motion for Benefit, as well as the relevant documents provided with the Motion, demonstrate that an inquiry sufficient to satisfy the duty of candor and good faith in executing the Petition to Revive must have been conducted by counsel.

134. Plaintiff's Petition to Revive satisfies the burden of establishing that the untimely abandonment of the '215 application was unintentional.

135. Plaintiff's Motion for Benefit satisfies the burden of establishing that Plaintiff's application in the Interference is entitled to the benefit of the '215 application based upon copendency with the '998 continuation upon grant of the Petition to Revive.

COUNT III
(Violation of Administrative Procedure Act, 5 U.S.C. § 706)

136. Paragraphs 1 through 135 are incorporated by reference as if fully restated herein.

137. Defendant Director has unlawfully withheld and/or unreasonably delayed a decision on the 183 Petition and the Petition to Revive.

138. Defendant Director has failed to decide the 183 Petition, which was filed on April 12, 2006 to request that Defendant Director order the Board to forward the Petition to Revive to the Office of the Deputy Commissioner for Patent Examination Policy for a decision on the merits in accordance with M.P.E.P. 1002.02(b), and consequently has failed to decide the Petition to Revive.

139. Plaintiff must appeal the Board's Judgment on the Interference by July 3, 2006, two months from the date of the Board's decision, in accordance with 37 C.F.R. § 1.304(a)(1).
140. Defendant Director's failure to decide the 183 Petition prior to the expiration of Plaintiff's deadline for appeal constitutes agency action unlawfully withheld and unreasonably delayed in violation of the Administrative Procedure Act (APA).
141. Defendant Director's failure to decide the 183 Petition constitutes agency action pursuant to the APA because "agency action" includes the failure to act. 5 U.S.C. § 551(13).
142. Defendant Director's failure to timely decide the 183 Petition is arbitrary, capricious, an abuse of discretion, unsupported by substantial evidence, not in accordance with law and without observance of procedure required by law, all in violation of the APA.
143. Defendant Director's wrongful conduct has caused Plaintiff to be adversely affected and suffer irreparable harm resulting from the loss of the ability to pursue patent rights for the invention claimed in the application of the junior party Sehgal in the Interference.
144. Defendant Director's wrongful conduct has furthermore caused Plaintiff to suffer irreparable harm resulting from Plaintiff's loss of the ability to appeal any decision by the Director on the Petition to Revive in the same suit as its appeal of the Board's denial of the Motion for Benefit.
145. Defendant Director's failure to decide the 183 Petition constitutes final agency action because Plaintiff's time for appealing the Judgment in the Interference will expire on July 3, 2006.
146. Defendant Director's failure to decide the 183 Petition is ripe for review because the issues tendered are appropriate for legal resolution and Plaintiff will suffer hardship if relief is denied.

147. Plaintiff is entitled to Defendant Director's prompt decision on the 183 Petition and consequently a timely decision on the Petition to Revive by the Office of the Deputy Commissioner for Patent Examination Policy to allow further administrative proceedings to determine priority between the parties in the Interference.

COUNT IV
(Petition for Writ of Mandamus)

148. Paragraphs 1 through 147 are incorporated by reference as if fully restated herein.

149. Plaintiff is entitled to have its Petition to Revive decided by the Office of the Deputy Commissioner for Patent Examination Policy.

150. Defendant Director's review of 183 Petitions is a ministerial function.

151. Defendant Director's review of Petitions to Revive is a ministerial function of the Office of the Deputy Commissioner for Patent Examination Policy as the designee of the Defendant Director.

152. Plaintiff will have no adequate alternative relief if the relief sought under Counts I, II or III is not granted.

153. Defendant's wrongful conduct has caused Plaintiff to suffer irreparable harm resulting from the loss of the ability to pursue its patent rights for the invention claimed in its application in the Interference.

154. Defendant's wrongful conduct has furthermore caused Plaintiff to suffer irreparable harm resulting from Plaintiff's loss of the ability to appeal any decision of the Petition to Revive in the same suit as its appeal of the Board of Patent Appeals and Interferences' denial of Plaintiff's Motion for Benefit of the '215 parent application.

155. Plaintiff is entitled to a writ of mandamus to compel a timely decision by the Defendant Director on the 183 Petition and consequently a timely decision on the Petition to Revive by the

Office of the Deputy Commissioner for Patent Examination Policy to allow further administrative proceedings to determine priority between the parties in the Interference.

PRAAYER FOR RELIEF

WHEREFORE, Plaintiff prays for judgment against Defendants, granting Plaintiff the following relief:

- A. That this Court reverse the decision of the Board of Patent Appeals and Interferences in the Interference and instruct the Board to withdraw its decision denying the Motion for Benefit.
- B. That this Court expunge from the record of the Interference all of the Board's findings of fact and holdings relating to the merits of the Petition to Revive.
- C. That this Court remand this case to the Board for further administrative proceedings directing the Board to forward the Petition to Revive to the Office of the Deputy Commissioner for Patent Examination Policy for a decision on the merits.
- D. That this Court order the Director to decide the 183 Petition.
- E. That this Court order the Office of the Deputy Commissioner for Patent Examination Policy to promptly decide the Petition to Revive.
- F. That this Court, in the alternative to relief granted under the Administrative Procedure Act, grant the writ of mandamus to compel the Director to decide the 183 Petition and exercise its authority to order the Board to forward the Petition to Revive to the Office of the Deputy Commissioner for Patent Examination Policy to promptly decide the Petition to Revive.
- G. That this Court grant such other and further relief as this Court may deem appropriate and just.

Dated:

July 3, 2006

By:

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