

No. 2008-1352

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

TRIANTAFYLLOS TAFAS,

Plaintiff-Appellee,

and

SMITHKLINE BEECHAM CORPORATION
(doing business as GlaxoSmithKline),
SMITHKLINE BEECHAM PLC, and GLAXO GROUP LIMITED
(doing business as GlaxoSmithKline),

Plaintiffs-Appellees,

v.

JOHN J. DOLL, Acting Under Secretary of Commerce for Intellectual Property
and Acting Director of the United States Patent & Trademark Office, and
UNITED STATES PATENT AND TRADEMARK OFFICE,

Defendants-Appellants.

Appeal from the United States District Court For the Eastern District of Virginia
in Consolidated Case Nos. 1:07-CV-846 and 1:07-CV-1008,
Senior Judge James C. Cacheris

**JOINT CONSENT MOTION FOR A STAY
OF EN BANC PROCEEDINGS**

Appellants John J. Doll and the United States Patent and Trademark Office (collectively “USPTO”), Appellee Triantafyllos Tafas (“Tafas”), and Appellees SmithKline Beecham Corporation d/b/a GlaxoSmithKline, SmithKline Beecham plc, and Glaxo Group Limited d/b/a GlaxoSmithKline (collectively, “GSK”), hereby jointly and respectfully move this Court for an immediate stay of the en banc briefing and oral argument schedule in the above-captioned matter, until 60 days after the Senate confirms the pending nomination of the new Under Secretary of Commerce for Intellectual Property and Director of the United States Patent & Trademark Office.

Appellants’ en banc brief is currently due August 5, 2009. Appellees’ responsive brief would be due 20 days thereafter, and Appellants’ reply seven days after that. Oral argument is scheduled for October 7, 2009. No party has previously sought or received any extension of time or stay relating to the en banc briefing and oral argument schedule. All parties consent to the relief requested in this motion. The reasons for this motion are set forth below.

BACKGROUND

1. On August 21, 2007, USPTO issued major new regulations governing patent prosecution. See “Changes To Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of

Claims in Patent Applications,” 72 Fed. Reg. 46,717 (Aug. 21, 2007).

2. Appellees GSK and Tafas brought suit in the United States District Court for the Eastern District of Virginia, challenging the validity of those new regulations. The district court granted summary judgment in favor of Appellees, found Rules 75, 78, 114, and 265 to be null and void, and enjoined the Office from enforcing them. See Tafas v. Dudas, 541 F. Supp.2d 805 (E.D. Va. 2008).

3. USPTO appealed to this Court. On March 20, 2009, this Court issued an opinion affirming in part and reversing in part the decision of the district court. This Court agreed with the district court that USPTO’s Rule 78 was invalid. This Court upheld the other three rules promulgated by USPTO against certain of Appellees’ challenges and remanded the remaining challenges and the case as a whole to the district court for further proceedings.

4. On July 6, 2009, this Court granted Appellees’ petitions for rehearing en banc. The Court ordered Appellants to file within 30 days an *en banc* brief discussing the issues addressed in the panel opinions. Appellees were ordered to file their brief 20 days thereafter, and Appellants’ reply brief seven days after that. The Court subsequently ordered oral argument on October 7, 2009.

ARGUMENT

For the reasons set forth below and in the accompanying declaration, Appellants and Appellees GSK and Tafas jointly and respectfully move this Court to stay all matters before the en banc court, including the briefing schedule and oral argument date.

On June 18, 2009, the President of the United States nominated David Kappos as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent & Trademark Office. See McIntosh Decl. ¶ 3. The Senate Judiciary Committee has scheduled a hearing on the nomination on July 29, 2009. *Id.* A stay of proceedings before the en banc court is requested to give the new Director, if confirmed, an opportunity to examine the rules at issue in this case and determine what course the USPTO should take in the future with respect to those rules, including whether to rescind the rules. Depending on how the Director decides to proceed, the legal issues currently before the *en banc* Court may be significantly altered or may even be rendered moot, making it unnecessary for the Court to take further action.

All the parties jointly and respectfully request that this Court immediately stay all proceedings in the above-captioned matter, to continue until 60 days after the Senate confirms the new Director of the USPTO. See McIntosh Decl. ¶ 7.

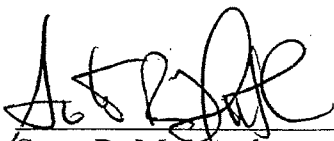
Such a stay should provide sufficient time for the USPTO's new leadership to determine an appropriate course of action. No party would be prejudiced by the requested stay, and the status quo would remain during the duration of the stay. The challenged rules at issue are not currently being enforced by the USPTO, which is enjoined from implementing them, and the Office will not implement them during the requested stay. See McIntosh Decl. ¶ 5.

Upon the expiration of the stay, if briefing remains necessary in light of any intervening actions by the USPTO regarding the rules, the parties jointly request that Appellants be given 30 days from the expiration of the stay to file their brief to the en banc court; that Appellees be given 20 days thereafter to file their brief; and that Appellants be given 7 days after that to file their reply brief.

CONCLUSION

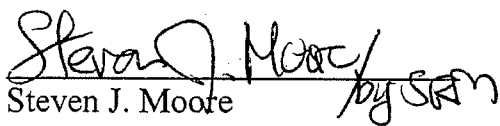
For the foregoing reasons and those set forth in the accompanying declaration, this Court should stay all en banc proceedings in this case, including briefing and oral argument, until 60 days after the nominated Under Secretary of Commerce for Intellectual Property and Director of the United States Patent & Trademark Office has been confirmed.

Respectfully submitted,



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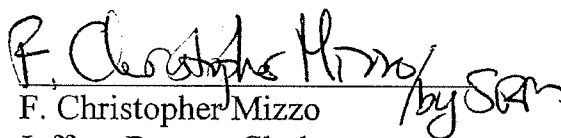
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**DECLARATION OF SCOTT R. McINTOSH IN SUPPORT OF
JOINT CONSENT MOTION FOR A STAY
OF EN BANC PROCEEDINGS**

I, Scott R. McIntosh, declare as follows, pursuant to Federal Circuit Rule 26(b)(5):

1. On March 20, 2009, the United States Court of Appeal for the Federal Circuit issued a decision in the above-captioned matter, reversing in part and affirming in part.

2. On July 6, 2009, this Court granted Appellees' petitions for rehearing en banc. The Court ordered Appellants to file within 30 days an *en banc* brief discussing the issues addressed in the panel opinions. Appellees were ordered to file their brief 20 days thereafter, and Appellants' reply brief seven days after that. The Court subsequently ordered oral argument on October 7, 2009.

3. On June 18, 2009, the President of the United States nominated David Kappos as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent & Trademark Office. The Senate Judiciary Committee has scheduled a hearing on the nomination on July 29, 2009. See <http://judiciary.senate.gov/nominations/111thCongressExecutiveNominations/CommerceUnderSecretary-DavidKappos.cfm>.

4. Appellants respectfully request that this Court immediately stay all en banc proceedings, including the briefing and oral argument schedule, until 60 days after the nominated Director has been confirmed by the Senate. A stay of

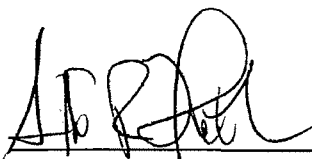
proceedings before the en banc court is requested to give the new Director, if confirmed, an opportunity to examine the rules at issue in this case and determine what course the USPTO should take in the future with respect to those rules.

5. The requested stay would not prejudice any party. The rules that are at issue in this case are not currently being implemented by Appellants, and Appellants would not seek to implement the rules during the pendency of the requested stay.

6. Neither Appellants nor Appellees have previously requested or been granted any extension of time or stay relating to the en banc briefing or oral argument schedule.

7. Counsel for Appellees Tafas and GSK have consented to the requested stay.

I declare under penalty of perjury that the foregoing is true and correct.

A handwritten signature in black ink, appearing to read 'S. R. McIntosh', written over a horizontal line.

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July 24, 2009

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**ORDER GRANTING JOINT CONSENT MOTION FOR A STAY
OF EN BANC PROCEEDINGS**

Upon consideration of the Joint Consent Motion for a Stay of En Banc Proceedings, which is unopposed, and for good cause shown;

IT IS SO ORDERED THAT:

The Joint Consent Motion for a Stay of En Banc Proceedings is GRANTED, and the en banc proceedings shall be stayed until 60 days after the current nominee for Under Secretary of Commerce for Intellectual Property and Director of the United States Patent & Trademark Office is confirmed by the United States Senate.

Dated: July __, 2009 _____