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OFFICE OF PETITIONS

In re Application of	:	
Tsang	:	
Application No. 09/779,541	:	
Patent No. 6,437,311	:	DECISION ON RENEWED PETITION
Filed: February 6, 2001	:	PURSUANT TO 37 C.F.R.
Issue Date: August 20, 2002	:	§ 1.378(E)
Attorney Docket No.:	:	
CMSI.002US2	:	
Title: PHOTODETECTOR AND DEVICE	:	
EMPLOYING THE PHOTODETECTOR FOR	:	
CONVERTING AN OPTICAL SIGNAL	:	
INTO AN ELECTRICAL SIGNAL	:	

This is a decision on the renewed petition filed on February 11, 2010, pursuant to 37 C.F.R. § 1.378(e), requesting reconsideration of a prior decision pursuant to 37 C.F.R. § 1.378(b), which refused to accept the delayed payment of maintenance fees for the above-referenced patent.

This renewed petition pursuant to 37 C.F.R. § 1.378(e) is **DENIED.**¹

THERE WILL BE NO FUTHER RECONSIDERATION OF THIS MATTER BY THE OFFICE.

Receipt of the \$400 fee that is associated with the filing of this renewed petition is acknowledged.

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of seeking judicial review. See MPEP § 1002.02.

Background

The patent issued on August 20, 2002. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on August 20, 2006, with no payment received. Accordingly, the patent expired on August 20, 2006 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

An original petition pursuant to 37 C.F.R. § 1.378(b) was filed on October 21, 2009, along with the 3½-year maintenance fee, the surcharge that is associated with the filing of a petition pursuant to 37 C.F.R. § 1.378(b), and a statement of facts. The petition pursuant to 37 C.F.R. § 1.378(b) was dismissed via the mailing of a decision on December 15, 2009, which indicated that the first and second requirements of Rule 1.378(b) have been satisfied.

The standard

35 U.S.C. § 41(c)(1) states:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay² is shown to the satisfaction of the Director to have been unavoidable. Rule 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is

² This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business³.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable⁴." See also Commissariat a L'energie Atomique et al. v. Watson, 274 F2d 594, 124 USPQ 126 (D.C. Cir. 1960) (35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was unavoidable, but only to explain why the applicant's petition was unavailing).

The burden of showing the cause of the delay is on the person seeking to revive the application.⁵

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.⁶

Application of the standard to the current facts and circumstances

Petitioner has explained that the previous patent owner, "Capella Microsystems, Inc." assigned this patent to the current patent owner, "Capella Microsystems Corp." on September 29,

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

⁴ Haines v. Quigg, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

⁵ Id.

⁶ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

2009.⁷ With this renewed petition, Petitioner has explained that he represents the latter, that the two companies are "related," and that as such, "the statements in the original petition and in this renewed petition are those of both the current owner and the prior owner."⁸

In the original petition, Petitioner indicated that he believes that the attorney who handled the prosecution of this application maintains a "docket patent system" which is used for tracking maintenance fees.⁹ Neither the original nor this renewed petition contains any basis for having this belief, and no statement from the attorney who allegedly maintained a docketing system has been included with either petition. Petitioner has added that the former patent owner received no notification from the attorney that the 3½-year maintenance fee was due, and as such, "assumed that all patent maintenance fees for this patent had been paid and that no patent maintenance fees were due."^{10, 11} However, neither the original petition nor this renewed petition contains a statement from the previous patent owner, the current patent owner, or any documentation which would establish that the former attorney had agreed to track the 3½-year maintenance fee for the previous patent owner.

Moreover, Petitioner has asserted that the former patent owner "decided to...sell all the patent rights to its subsidiary (the current patent owner)...when being forced to face with corporate reorganization in 2003."¹² The decision on the original petition indicated that the record does not indicate why this patent was not assigned to the current patent owner until six years had passed from the decision to assign this patent to the same. This issue has not been addressed on renewed petition.

It is noted that with the original petition, Petitioner indicated the date and the manner in which Patentee became aware of the expiration of the patent, along with the steps taken to file the petition promptly.

7 Original petition, page 1. See also "Master Assignment," recorded in the Office at Reel 023319 and Frame 0016.

8 Renewed petition, page 2.

9 Original petition, page 1.

10 Id.

11 Petitioner has not revealed why the former patent owner would believe that another entity would assume the expense of submitting a maintenance fee on its behalf.

12 Original petition, page 3.

The period for paying the 3½-year maintenance fee without the surcharge extended from August 20, 2005 to February 21, 2006 and for paying with the surcharge from February 22, 2006 to August 20, 2006. Thus, the delay in paying the 3½-year maintenance fee extended from August 20, 2006 at midnight to the filing of this renewed petition on February 11, 2010.

As a preliminary matter, Petitioner has indicated that he represents both the original and the current patent owners. However, while these two corporate entities might be "related," it is not clear if they exist as two distinct corporate entities, and the exact relationship between the prior and the current patent owner is unclear. Petitioner has not alleged that the same employees work for both corporations simultaneously. On the second page of this renewed petition, Petitioner has described these two companies as "related," with the prior patent owner being a subsidiary of the current owner, which suggests that the two companies are two distinct corporate entities. However, on this same page, Petitioner refers to a "restructuring" and a "merger," which suggests that the two companies have merged into one corporate entity. Moreover, a statement from a representative of either company has not been provided with either the original or the renewed petition. Furthermore, this patent expired more than three years before the current patent owner assumed ownership of this patent, and as such, Petitioner is not in possession of firsthand knowledge of the events which resulted in the failure to submit the maintenance fee in a timely manner. It is not clear if the current patent owner possesses firsthand knowledge of these events. It appears that this patent expired on August 20, 2006, three years passed before the current patent owner assumed ownership of this patent,¹³ and the current patent owner filed the original petition shortly after the acquisition.

Petitioner has not carried the burden of showing on the record that the entire period of delay in providing the maintenance fee was unavoidable, for the following reasons.

First, the record does not establish that steps were in place for monitoring the timely payment of the maintenance fees for this patent.

¹³ The assignment occurred on September 29, 2009. See original petition, page 1.

An adequate showing that the delay in payment of the maintenance fee at issue was unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

Petitioner has indicated that he believes that the representative of the former patent owner had steps in place to track the maintenance fee, but has not produced a statement from either of these two entities. Moreover, Petitioner has indicated that the former patent owner utilized an "original U.S. agent"¹⁴ to track the maintenance fees, however the prior patent owner forgot to inform this U.S. agent of the merger.¹⁵ The record is silent as to what steps this unnamed U.S. agent might have had in place to track the maintenance fee, and no statement from this individual has been included with either the original or this renewed petition.

Second, the decision on the original petition indicated that Petitioner has given two conflicting reasons for the failure of the former patent owner to submit the maintenance fee in a timely manner:

On the first page of this (original) petition, Petitioner alleges that the former patent owner expected its attorney to provide notification in advance of the due date of the first maintenance fee, and when none was received, the former patent owner assumed that the patent maintenance fee had been paid. However, on the third page of this petition, it has been set forth that "the complicated reorganization process (of the former patent owner) and the personnel transaction led to the innocent omission of the maintenance fee payment for the subject patent." It is not clear how a corporate reorganization would have caused the former patent owner to miss the maintenance fee payment, if the former patent owner believed that the maintenance fee had been paid.

Decision on original petition, pages 5-6.

With this renewed petition, this issue has not been addressed.

¹⁴ Renewed petition, page 2.

¹⁵ Id.

Conclusion

The prior decision which refused to accept, under 37 C.F.R. § 1.378(b), the delayed payment of a maintenance fee for the above-identified patent, has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b).

Both the surcharge that is associated with the filing of a petition pursuant to 37 C.F.R. § 1.378(b) and the 3½-year maintenance fee will be refunded to patentee's credit card in due course. The \$400 fee that is associated with the filing of this renewed petition cannot be refunded.

It is noted that the address listed on the petition differs from the address of record. A "Revocation of Prior Power of Attorney with New Power of Attorney and Change of Correspondence Address" was included with this petition, but the request cannot be entered. The request has been signed by the CEO of Capella Microsystems, Inc. (USA) (the prior patent owner), and as developed on pages 3-4 and footnote seven of this renewed petition, Office records show that on September 29, 2009, Capella Microsystems, Inc. (USA) assigned its interest in this patent to Capella Microsystems Corp. As such, Capella Microsystems, Inc. (USA) is not in a position to change either the correspondence address or the power of attorney.¹⁶

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

The application will be forwarded to Files Repository.



Anthony Knight
Director
Office of Petitions

cc: Thomas W. Tolpin
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¹⁶ See 37 C.F.R. §§ 3.71(b) and (c) and 3.73(b) and (c).