



Paper 22

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OFFICE OF PETITIONS

In re Patent No. 5,813,987	:	
Issue Date: September 29, 1998	:	
Application No. 08/778,039	:	ON PETITION
Filed: December 24, 1996	:	
Title of Invention: SPECTRAL VOLUME	:	
MICROPROBE FOR ANALYSIS OF	:	
MATERIALS	:	

This is a decision on the Request for Reconsideration, filed April 12, 2007 under 37 CFR 1.378(e), of a prior decision mailed February 12, 2007, refusing to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(e) is **DENIED**.¹

BACKGROUND

The patent issued on September 29, 1998. The first maintenance fee due could have been paid during the period from October 1, 2001 to March 31, 2002 or, with a surcharge during the period from April 1, 2002 to September 29, 2002. Additionally, the second maintenance fee due could have been paid during the period from September 29, 2005 to March 28, 2006 or, with a surcharge during the period from March 29, 2006 to September 29, 2006. Accordingly, this patent expired on September **30**, 2002 for failure to timely remit the first maintenance fee.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on May 12, 2006 in which petitioner asserted that the delay was unavoidable because when the case was transferred from Foley Hoag & Eliot L.L.P. to Testa, Hurwitz & Thibault, while the sending firm properly included the instant patent in the list of transferred files, through clerical error, the due date entry for the maintenance fee was not transferred into the computerized docketing system of Testa, Hurwitz & Thibault, the receiving firm.

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

The petition was dismissed in a decision mailed February 12, 2007 for failure to provide a sufficient showing that the delay in paying the maintenance fee was unavoidable. Unfortunately, the documentation provided to support the allegations that the delay in paying the maintenance fees was unavoidable or that the receiving firm exercised reasonable care in their duties with respect to this patent was not sufficient. Petitioner's only claim was that Testa, Hurwitz & Thibeault had been dissolved and that it is unknown why the due date for the instant patent was not properly copied over in the Testa, Hurwitz & Thibeault system.

The evidence presented included the July 23, 2000 letter transferring the instant patent and other patents from Foley Hoag & Eliot L.L.P. to Testa, Hurwitz & Thibeault, the case list, of which the instant patent is included, a weekly docket list and Client Status report generated by Foley Hoag & Eliot L.L.P., as well as a docket list from current Patent Counsel, GOODWIN | PROCTER LLP to show that the transfer from Testa, Hurwitz & Thibeault did not include the instant patent.

Petitioners had not demonstrated what if any measures were in place as a back-up having this patent placed in the docketing system of the receiving firm and thus for the payment of the maintenance fees.

Specifically, the decision dismissing the petition noted that assuming the failure to submit the maintenance fee payment to the USPTO was a clerical error, a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.²

The decision further noted that an adequate showing as it relates to an error on the part of an employee requires:

(1) Statements by all persons with direct knowledge of the circumstances surrounding the

²See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

delay, setting forth the facts as they know them;

(2) Petitioner must supply a thorough explanation of how they came to be responsible for matters related to this patent including the ultimate responsibility for payment of maintenance fees and how it is that this matter was not placed in their docketing system; and

(3) Petitioner must supply information regarding the training provided to the personnel responsible for the creation and transfer of the patent records and must describe the work which was used to assure proper execution of assigned tasks.

Petitioners were required to show the circumstances surrounding the transfer to and docketing of this patent and advised that a showing of unavoidable delay would include a statement from the principals responsible for payment of the maintenance fees as to why action was not taken to timely submit the required maintenance fee while the patent was under their control.

The instant petition under 37 CFR 1.378(e) provides additional explanation as to why petitioners believe the payment of the maintenance fee was delayed and why that delay was unavoidable.

STATUTE AND REGULATION

35 USC 41(c)(1) states that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 USC 41(c)(1).

Acceptance of a late maintenance fee on the basis of unavoidable delay is considered under

the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay. Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912)("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 business"); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The instant request for reconsideration establishes by way of a statement from Thomas C. Meyers, former partner with the law firm of Testa, Hurwitz & Thibeault that there was an established protocol for file intake at Testa, Hurwitz & Thibeault. The protocol required a member of the docketing staff to enter data from each of the files received into a computerized database (Computer Packages Inc. Patent Management System (CPI)). The protocol, according to Mr. Meyers, also required the creation of a hard file (file wrapper) with file cover, for every file received. By way of a statement from Paula Gallagher, Patent Administrator for Testa, Hurwitz & Thibeault, the Docketing Staff at Testa, Hurwitz & Thibeault was made up of five individuals each of whom had approximately one year or more of relevant experience as a legal secretary, paralegal or equivalent, prior to joining the Docketing Staff.

To the extent the error may have been caused by any one of the five members of the Testa, Hurwitz & Thibeault Docketing Staff, petitioner failed to provide any information regarding the length of time the members of the staff were in the Docketing Department or the training provided to the staff responsible for the docketing error and the degree of supervision received. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function of docketing. It is not sufficient to merely state the areas of training the staff members received prior to working in the Docketing Department. Neither can it be assumed that because a person is a legal secretary or a paralegal that they are proficient at docketing. To establish an employee was sufficiently trained, specifics as to the training and supervision received should have been provided. The training and supervision of the Docketing Staff help establish whether it was an exercise of due care to rely upon them.

Furthermore, petitioner has failed to identify the members of the staff and or demonstrate which employee(s) at Testa, Hurwitz & Thibeault was responsible for entering the

information into computerized database using the CPI software.

As the petition notes that the protocol also included the creation of a hard file (file wrapper) with file cover, for every file received, no evidence has been presented to establish that such a hard file was created, which if it had could have served as a back up and would have avoided the delay in payment of the maintenance fee.

Sufficient evidence to substantiate the allegations of clerical error has not been provided.

CONCLUSION

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

Since this patent will not be reinstated, the maintenance fee and the surcharge fee submitted by petitioner will be refunded in due course.

As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Charles Pearson
Director
Office of Petitions