



Paper No. 15

MAGINOT, MOORE & BECK LLP
CHASE TOWER
111 MONUMENT CIRCLE, SUITE 3250
INDIANAPOLIS, IN 46204-5109

MAILED

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OFFICE OF PETITIONS

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| In re Patent of | : | |
| Richard H. Wagner | : | |
| Patent No. 6085224 | : | |
| Issue Date: 07/04/2000 | : | |
| Application No.: 08/818788 | : | DECISION |
| Filing or 371(c) Date: 03/11/1997 | : | ON PETITION |
| Title of Invention: | : | |
| METHOD AND SYSTEM FOR | : | |
| RESPONDING TO HIDDEN DATA AND | : | |
| PROGRAMS IN A DATASTREAM | : | |

This is a decision on the Petition for Reconsideration Under 37 CFR 1.378(e),” filed June 4, 2009, to reinstate the above-identified patent based upon unavoidably and unintentionally delayed payments of maintenance fees respectively.

The petition is **DENIED**.

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

Background

The patent issued July 4, 2000. Patentee could have paid the three and one half (3½) year maintenance fee between July 4, 2003, and January 4, 2004, without a surcharge, or within the six (6) month grace period between January 5, 2004 and July 4, 2004. Patentee failed to do so; accordingly, the patent became expired on midnight of July 4, 2004.

Patentee also petitions to accept the delayed payment of the seven and one half (7½) year maintenance fee; however, the patent previously expired for failure to timely pay the three and one half (3½) year maintenance fee.

The December 29, 2008 petition

Patentee/Petitioner filed a petition on December 29, 2008, wherein petitioner provided that the patentee and Owner’s predecessor in interest, Intracpt, Inc., reasonably relied upon the

docketing system of Morris, Manning & Martin LLP (“MMM or Firm”) for reminders regarding deadlines for filing maintenance fees for the present patent. Mr. Richard H. Wagner is the inventor, and president of Intracept, Inc., the assignee of the present patent. Mr. Wagner is also the president and owner of Datascape, Inc. Datascape received a show cause order in reissue patent application 10/184507, a reissue of the present patent.

Petitioner provided that MMM deleted the maintenance fee reminders from its docketing system, an action that petitioner stated could not have been reasonably anticipated. The patent owner averred that MMM placed the patent file into storage and deleted the maintenance fee reminders from its docketing system without giving notice to the patent owner. This despite MMM having provided reminders to petitioner for trademark deadlines and registrations owned by the patent owners predecessor in interest during the same time frame. Petitioner was therefore unaware that the maintenance fee reminders were removed from the Firm’s docketing system. Upon becoming aware of the expiration of the present patent, the patent owner took action to ascertain the facts and file the present petition.

In support of petitioner’s assertions, a copy of a letter from Jon M. Jurgovan of MMM was enclosed. The letter, from the Firm to Mr. Wagner at Intracept, Inc., and dated September 10, 2000, informed Mr. Wagner that the present patent was granted on July 4, 2000. The letter also stated that

The U.S. Patent and Trademark Office requires maintenance fees to keep a patent in effect for its full term. The first maintenance fee is due 3½ years after the date of this grant given above. The second and third fees are due 7½ and 11½ years, respectively, thereafter the date of grant. The patent will expire if a maintenance fee is not paid. We have docketed those dates and will attempt to notify you before each maintenance fee payment is due. However, the patent owner bears the ultimate responsibility for timely payment of these maintenance fees. Please inform us of any change in address or change in ownership of this patent.

After you have received and reviewed this letter and attachment, please sign for completion of our file a copy of this letter in the space as provided below indicating receipt of the original patent.

Patentee also provided a copy of a letter from the Firm to Datascape, Inc., dated June 29, 2000, reminding the patentee of a 3½ year maintenance fee due date for another patent, patent no. 5,541,582, and a copy of two letters regarding the filing of Trademark renewal declarations; one from the Firm to Intracept, Inc., dated February 23, 2004, and one from the Firm to Datascape, Inc., dated May 3, 2004.

It was noted that the correspondence address for both Intracept, Inc., and Datascape, Inc., were the same.

In further support of the present petition, Patentee cited to California Medical Products, Inc. v. Tecnol Medical Products, Inc., 921 F. Supp. 1219, 1258-1260 (D.Del. 1995). Patentee argued that in Tecnol, a maintenance fee reminder had been erroneously entered in the law firm

docketing system because the clerk based the maintenance fee deadline on the reissue date, rather than the issue date of the original patent. As a result, the docketing system did not generate a maintenance fee reminder until after the payment window for the maintenance fee for the original patent had expired. Petitioner noted the court's agreement with this Office's conclusion, that the maintenance fee was unavoidably delayed even though the otherwise reliable docketing system did not timely generate the reminder, and the patent attorney had failed to supervise the entry of reminders for the maintenance fee due date for the reissue patent.

Patentee asserted that Mr. Wagner's reliance upon the Firm for reminders was reasonable, and the Firm's attorneys need not supervise every docketing system entry and deletion in order to be able to rely upon the docketing system for its intended use. Petition at p.5. Deadlines in MMM's docketing system, Patentee provided, were the responsibility of trained paralegals, just as they were in the Tecnol case. Id. Thus, Patentee averred, MMM's attorneys' acted reasonably in relying on the docketing system even though deadline deletions by paralegals were possible, and the deletion of the maintenance fee reminder, Patentee asserted, was not foreseeable. The sole cause for Mr. Wagner's ignorance of the deadline for timely payment of the 3½ year maintenance fee was the disabled ability of the Firm's docketing system to generate the maintenance fee reminder.

As to the Firm actions, Patentee filed the Declaration of John M. Harris ("Harris Declaration"), senior partner of MMM. Mr. Harris confirmed that Jon Jurgovan sent the issued patent to Mr. Harris, but that Mr. Jurgovan ceased to be employed by MMM on or about November 30, 2002. Mr. Harris provided that the maintenance fee deadlines for the present patent were entered into the Firm's docketing system. Mr. Harris further provided generally that the paralegals responsible for entering and reporting deadlines in the docketing system were trained how to enter and report the deadlines generated by the docketing system to the Firm's attorneys.

Mr. Harris stated that in response to a request from Mr. Wagner, the file, which had been sent to storage in 2003, was located. In reviewing the file, Mr. Harris learned that the maintenance fee deadlines had been turned off in the Firm's docketing system as of October 23, 2003, and that according to the Firm's records, no maintenance fee reminders were generated or reported to Mr. Wagner.

Petitioner also included a copy of an email exchange between Mr. Harris and Mr. Wagner. Mr. Harris explained to Mr. Wagner that in the letter from Mr. Jurgovan to Mr. Harris, Mr. Jurgovan noted that the patent owner bears the responsibility for paying maintenance fees. Mr. Harris further noted that the file was closed a long time ago and that the Firm took the maintenance fee reminders off of their docket. The last correspondence in the file, Mr. Harris provided, was a letter sent to Scott Horstemeyer at the Thomas Kayden firm on or about July 9, 2001, sending him a copy of the file history.

The March 27, 2009 Decision dismissing the petition

The petition was dismissed in a Decision mailed March 27, 2009. The Decision dismissing the petition noted Petitioner's assertion, that the sole cause for Mr. Wagner's ignorance of the deadline for timely payment of the 3½ maintenance fee, was the disabled ability of the Firm's

docketing system to generate the maintenance fee reminder. Petitioner provided that it reasonably relied upon the docketing system of MMM for reminders regarding deadlines for filing maintenance fees for the present patent.

Mr. Harris had stated in an email to Mr. Wagner, that the last correspondence in the file was a letter sent to Scott Horstemeyer at the Thomas Kayden firm on or about July 9, 2001, sending him a copy of the file history. Thereafter, as of October 23, 2003, MMM closed the file, turned off the maintenance fee deadlines and took the maintenance fee reminders off of their docket. The Decision noted that Patentee had not provided an explanation as to any possible contact between Mr. Wagner and the Thomas Kayden firm. However, in reviewing the email and Harris Declaration, and absent any explanation, the petition invited the conclusion that the MMM firm sua sponte sent a copy of the file history to the Thomas Kayden firm.

In order to determine whether the Patentee's reliance upon MMM was reasonable, Petitioner was required to explain whether Mr. Wagner had any contact with the Thomas Kayden firm after the patent issued, and what the contact entailed.

In addition, as to the disabled ability of the Firm's docketing system to generate the maintenance fee reminder, The Decision noted that Patentee had failed to provide (1) the identity of the employee who was in the performance of the clerical function that caused the delay; (2) the error the employee made that was the cause of the delay at issue; (3) evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and, (4) evidence concerning the training and experience of the person responsible for the error with regard to the function and routine for its performance such that reliance upon such employee represented the exercise of due care.

Patentee had asserted only that the Firm deleted the maintenance fee reminders from its docketing system. Patentee had not identified the clerical employee that was involved in the clerical function that caused the delay. Nor had Patentee identified the error that the employee committed that led to the deletion of the maintenance fee reminder from the docketing system. Petitioner had not provided evidence of the business routine for docketing maintenance fee due dates that could reasonably be relied upon to avoid errors in its performance, and Petitioner had not provided evidence, save a statement from Mr. Harris that that the paralegals responsible for entering and reporting deadlines in the docketing system, were trained how to enter and report the deadlines generation by the docketing system to the Firm's attorneys.

Petitioner cited to Tecnol for the proposition that that a delayed maintenance fee payment may be found to have been unavoidable even though the otherwise reliable docketing system did not timely generate the reminder, and the patent attorney had failed to supervise the entry of reminders for the maintenance fee due date for the reissue patent. However, the Decision, in a review of the Tecnol decision, showed that the evidence before the PTO included (1) identification of the employee who was in the performance of the clerical function that caused the delay - Ms. Eveleth Thurber, the attorney's secretary and patent docket clerk; (2) identified the error that the employee made that was the cause of the delay at issue - Ms. Thurber mistakenly docketed the reissue patent by its issue date and not by the issue date of the original patent. "This mistake caused the incorrect calculation of the maintenance fee due dates on the

docket sheet” Tecnol at 1258. (Emphasis supplied); (3) provided evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance – the case states that “Thurber maintained a docket on an office personal computer in order to track maintenance fees. The general practice in Strauss’s office was to docket the patents by the issue date on the face of the patent. In accordance with this usual practice, Thurber mistakenly docketed the ‘219 patent by its issue date and not by the issue date of the parent.” Id.

Patentee was required to identify the employee who made the docketing error; and identify the error that led to the removal of the maintenance fee due date from MMM’s docket. A statement from the person who committed the error, identifying and attesting to the error, was required. Patentee was required to explain the business routine for docketing maintenance fee due dates at the Firm that could reasonably be relied upon to avoid errors in its performance, and provide evidence concerning the training and experience of the person responsible for the error with regard to the function and routine for its performance such that reliance upon such employee represented the exercise of due care. A statement from the person who trained/supervised the clerical employee attesting to the training and experience of the employee, such that reliance upon such employee represented the exercise of due care, was required.

The present renewed petition

Petitioner files the present renewed petition and reiterates that Mr. Wagner was reasonable in relying upon MMM’s docketing system to generate maintenance fee reminders and to communicate those reminders to Mr. Wagner. “Regardless of whether MMM’s understanding is correct, Mr. Wagner’s reliance remains prudent because Georgia Bar Rule 1.16(d) requires attorneys to minimize damage to clients in matters in which representation of the client has been terminated.” Petition at p.3. Petitioner provides that such damage minimization includes the return of at least a copy of the file, and in this case neither a copy of the file or the original file was returned to Mr. Wagner, despite the inactive status of the file having been noted at the time that the maintenance fee reminder was generated. Id. The return of the file, Petitioner avers, would have put Mr. Wagner on notice that the patent required a maintenance fee payment.

Petitioner does not state affirmatively that the attorney’s at the MMM firm are members of the Georgia Bar, but avers that Mr. Wagner was prudent in relying upon the MMM attorneys to meet the obligations of the Georgia Bar Rule 1.16(d) because the MMM law firm is a law firm practicing law in the state of Georgia, and if its attorneys are not members of the Georgia Bar, then they would be conducting the unauthorized practice of law in Georgia. Therefore, petitioner concludes, Mr. Wagner was reasonable in relying upon the docketing system of MMM and on MMM’s attorneys to notify Mr. Wagner of maintenance fee reminders generated by MMM’s docketing system or, alternatively, expecting notification of the inactive status of the ‘224 patent file or the return of the file to Mr. Wagner.

Regarding the error that was the cause of the delay, petitioner reiterates that Mr. Wagner was informed shortly after issuance of the present patent that the maintenance fee dates were docketed and that MMM would attempt to notify Mr. Wagner before each maintenance fee payment was due. Petitioner supports this assertion with copies of an email dated September 4,

2003 from Ms. Elizabeth Herbener, an MMM paralegal who petitioner avers was responsible for the MMM docketing system, to Gloria Miller, an employee of MMM who had previously been the legal assistant for Attorney Jon Jurgovan, who had left the employ of MMM in November, 2002. Petitioner avers that the email indicates that the maintenance fee was coming due, and that no attempt to notify Mr. Wagner of this generated notice ever occurred, in contravention of the assertion presented in Mr. Jurgovan's letter of September 10, 2003.

Petitioner asserts that "Mr. Wagner could not have foreseen this negation of MMM's assertion 'to attempt to notify [him] before each maintenance fee payment is due' because MMM corresponded with him and billed him for services related to the '224 patent." Petition at p.6. Moreover, petitioner avers, the assertion that MMM had docketed the maintenance fee dates and would attempt to notify Mr. Wagner before each maintenance payment was due, led to a good faith belief by Mr. Wagner that MMM would notify him before the maintenance fee was due, and Mr. Wagner was reasonable in relying upon MMM until otherwise put on notice that MMM would no longer notify him of maintenance fee due dates. Id.

Petitioner avers that Mr. Wagner's good faith belief was further demonstrated by MMM as indicated by a letter dated July 9, 2001 from Jon Jurgovan to Scott Horstmeyer of Thomas, Kayden, Horstmeyer & Riley, LLP, indicating that a copy of the patent file was sent to Mr. Horstmeyer, which, according to Mr. Wagner, he authorized in order for Mr. Horstmeyer to evaluate in contemplation of litigation. Id., at p.p. 6-7.

Petitioner argues that the failure to return the patent file to Mr. Wagner caused the unavoidable delay in paying the maintenance fee, in contravention of the Georgia Bar Rule as iterated supra. Petitioner asserts that because MMM failed to notify Mr. Wagner of the maintenance fee reminder and disabled the docket system from generating future reminders, Mr. Wagner was unaware that a maintenance fee was due. Mr. Wagner's other avenue of notification, petitioner avers, was negated by the failure of MMM to send Mr. Wagner notice of the inactive status of the patent or at least a copy of the file. Id., at p.8. Without notice of MMM's belief that it no longer represented Mr. Wagner or his companies in the matter, petitioner argues that Mr. Wagner did not know that MMM was no longer willing to perform its offer to notify Mr. Wagner of the maintenance fee payments before they came due, and thus, Mr. Wagner could not have foreseen the imperfections that caused MMM to withhold notice of the inactive status of the patent and Mr. Wagner was consequently without knowledge that the maintenance fee was due until the Show Cause Order issued. Id.

As to a business routing in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and the employee's training and experience with regard to the function, petitioner refers to the September 4, 2003 email from Ms. Elizabeth Herbener, the MMM paralegal who petitioner avers was responsible for the MMM docketing system, to Gloria Miller, an employee of MMM who had previously been the legal assistant for Attorney Jon Jurgovan, and to the Declaration of Mr. Harris, senior partner at MMM, wherein Mr. Harris stated that he believed Ms. Herbener was trained and capable of handling any issues in the docketing system competently, and trained to document attorney instructions to close a matter in docketing. Mr. Harris provides that 'Ms. Herbener would not have turned off the maintenance fee reminder for the '224 patent in docketing had she not received such a

confirmation either directly from an attorney or indirectly from an attorney via Ms. Miller.” Petition at p.10, citing to Harris II Declaration para. 21. Mr. Harris also states that he would have advised Ms. Herbener or Ms. Miller to send a letter to the client to confirm the closing of the file and/or the inactive status. Id., citing to Harris II Declaration p. 23.

No statement from Ms. Herbener or Ms. Miller has been filed.

Applicable Law, Rules and MPEP

35 U.S.C. § 41(c)(1) states:

The Commissioner may accept the payment of any maintenance fee required subsection (b) of this section which is made within twenty-four months after the six-month grace period if this delay is shown to the satisfaction of the Commissioner to have been unintentional, or at any time 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) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) 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 required 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. Furthermore, an adequate showing requires *a statement by all persons with direct knowledge of the cause of the delay*, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See 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), aff’d sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff’d, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a

reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, 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. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, supra. See also Final Rule entitled “Final Rules for Patent Maintenance Fees,” published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee’s agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

An error in a docketing system could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2).

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. See 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).

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). 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 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, Petitioner should note that a breakdown of communication between the party responsible for payment of the maintenance fee and their client is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Opinion

Petitioner avers that Mr. Wagner's good faith belief that MMM would notify him before each maintenance payment was due, was further demonstrated by MMM as indicated by a letter dated July 9, 2001 (a year after the patent had issued), from Jon Jurgovan to Scott Horstmeyer of Thomas, Kayden, Horstmeyer & Riley, LLP, indicating that a copy of the patent file was sent to Mr. Horstmeyer, which, according to Mr. Wagner, he authorized in order for Mr. Horstmeyer to evaluate in contemplation of litigation. Id., at p.p. 6-7.

The March 27, 2009 Decision noted that in reviewing the email and Harris Declaration, and absent any explanation, the petition invited the conclusion that the MMM firm sua sponte sent a copy of the file history to the Thomas Kayden firm. Petitioner was required to explain whether Mr. Wagner had any contact with the Thomas Kayden firm after the patent issued, and what the contact entailed. With the present renewed petition, Petitioner states that Mr. Wagner authorized the sending of the file to Mr. Horstmeyer for evaluation of a contemplated litigation.

The evidence presented, however, in addition to being viewed as MMM's continued involvement with the patent, could also be viewed as MMM's response to a request by Mr. Wagner regarding contemplated litigation, wherein MMM, having closed the file, was no longer involved in the present patent. This conclusion is buttressed by the November 26, 2008 email from Mr. Harris at MMM to Mr. Wagner, wherein Mr. Harris stated to Mr. Wagner that "[o]n September 10, 2000, Jon Jurgovan (no longer with our firm) transmitted the original patent grant to you, noting that

the patent owner bears the responsibility for paying the maintenance fees. [MMM] closed the file a long time ago and took the maintenance fee reminders off our docket.” The conclusion is further buttressed by the second Declaration of Mr. Wagner, which confirms that he has not used the law firm of Thomas, Kayden, Horstmeyer & Riley, LLP, for any patent application or prosecution or patent maintenance matters. Wagner II, at para.3. Of note is that Mr. Wagner failed to explain, as requested in the Decision mailed March 27, 2009, whether he had any contact with the Thomas Kayden firm after the patent issued, and what the contact entailed.

Petitioner’s argument that Mr. Wagner was reasonable to rely upon MMM because of Georgia Bar Rule 1.16(c) is not well received. From the evidence presented it has not been shown that Mr. Wagner was aware of Georgia Bar Rule 1.16(c) at the time that the maintenance fee was due, and thus could not be said to be in reliance of some unknown rule. Furthermore, the fact that the matter was made inactive by MMM without a copy of the file being sent to Mr. Wagner represents a failure of communication between attorney and client. It is well established that failure in communication between a client and his attorney does not constitute unavoidable delay. In re Kim, 12 USPQ 2d 1595 (Comm’r Pat 1988); Ray v. Lehman, 34 USPQ 2d 1786 (Fed. Cir. 1995). Moreover, the USPTO is not the proper forum for resolving a dispute between a patent owner and his representative as to who bore responsibility for paying the maintenance fee. Ray, at 1789.

Regarding docketing error, Petitioner was required to identify the employee who made the docketing error, and identify the error that led to the removal of the maintenance fee due date from MMM’s docket. A statement from the person who committed the error, identifying and attesting to the error, was required. Patentee was required to explain the business routine for docketing maintenance fee due dates at the Firm that could reasonably be relied upon to avoid errors in its performance, and provide evidence concerning the training and experience of the person responsible for the error with regard to the function and routine for its performance such that reliance upon such employee represented the exercise of due care. A statement from the person who trained/supervised the clerical employee attesting to the training and experience of the employee, such that reliance upon such employee represented the exercise of due care, was required.

With the present renewed petition, as to the error that was the cause of the delay, petitioner reiterates that Mr. Wagner was informed shortly after issuance of the present patent that the maintenance fee dates were docketed and that MMM would attempt to notify Mr. Wagner before each maintenance fee payment was due. Petitioner supports this assertion with copies of an email dated September 4, 2003 from Ms. Elizabeth Herbener, an MMM paralegal who petitioner avers was responsible for the MMM docketing system, to Gloria Miller, an employee of MMM who had previously been the legal assistant for Attorney Jon Jurgovan, who had left the employ of MMM in November, 2002. Petitioner avers that the email indicates that the maintenance fee was coming due, and that no attempt to notify Mr. Wagner of this generated notice ever occurred, in contravention of the assertion presented in Mr. Jurgovan’s letter of September 10, 2003.

However, as stated in the Decision mailed March 27, 2009, the TecnoI decision showed that the evidence before the PTO included (1) identification of the employee who was in the performance

of the clerical function that caused the delay - Ms. Eveleth Thurber, the attorney's secretary and patent docket clerk; (2) identified the error that the employee made that was the cause of the delay at issue - Ms. Thurber mistakenly docketed the reissue patent by its issue date and not by the issue date of the original patent. "This mistake caused the incorrect calculation of the maintenance fee due dates on the docket sheet" Tecnol at 1258. (Emphasis supplied). (3) provided evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance - the case states that "Thurber maintained a docket on an office personal computer in order to track maintenance fees. The general practice in Strauss's office was to docket the patents by the issue date on the face of the patent. In accordance with this usual practice, Thurber mistakenly docketed the '219 patent by its issue date and not by the issue date of the parent." Id.

Petitioner has failed to identify the error that was the cause of the delay at issue. Petitioner notes that the maintenance fee reminder was removed from MMM's docketing system; however, petitioner has not described the error that led to the removal of the maintenance fee reminder, or provide an employee who made an error. Mr. Harris provides that 'Ms. Herbener would not have turned off the maintenance fee reminder for the '224 patent in docketing had she not received such a confirmation either directly from an attorney or indirectly from an attorney via Ms. Miller. Mr. Harris also states that he would have advised Ms. Herbener or Ms. Miller to send a letter to the client to confirm the closing of the file and/or the inactive status. However, there is no assertion by Mr. Harris that an error was made, nor is there a statement from Ms. Herbener or Ms. Miller, identifying the error.

Petitioner has also failed to identify the employee who was in the performance of the clerical function that caused the delay. As noted supra, Mr. Harris has provided that Ms. Herbener would not have turned off the maintenance fee reminder for the '224 patent in docketing had she not received such a confirmation either directly from an attorney or indirectly from an attorney via Ms. Miller. Mr. Harris also states that he would have advised Ms. Herbener or Ms. Miller to send a letter to the client to confirm the closing of the file and/or the inactive status. Neither Mr. Harris, senior partner at MMM, nor any attorney an employee who was in the performance of the clerical function that caused the delay, has been identified as making an error. Mr. Harris does not aver that Ms. Herbener or Ms. Miller made a clerical error, and no statement attesting to the error, from Ms. Herbener or Ms. Miller, has been provided.

Having failed to identify the employee who was in the performance of the clerical function that caused the delay, and having failed to identify the error that the employee made that was the cause of the delay, Petitioner has also failed to provide evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. In this regard, petitioner refers to (1) the September 4, 2003 email from Ms. Elizabeth Herbener, the MMM paralegal who petitioner avers was responsible for the MMM docketing system, to Gloria Miller, an employee of MMM who had previously been the legal assistant for Attorney Jon Jurgovan, and to (2) the Declaration of Mr. Harris, senior partner at MMM, wherein Mr. Harris stated that he believed Ms. Herbener was trained and capable of handling any issues in the docketing system competently, and trained to document attorney instructions to close a matter in docketing. Mr. Harris provides that 'Ms. Herbener would not have turned off the maintenance fee reminder for the '224 patent in docketing had she not

received such a confirmation either directly from an attorney or indirectly from an attorney via Ms. Miller. Mr. Harris also states that he would have advised Ms. Herbener or Ms. Miller to send a letter to the client to confirm the closing of the file and/or the inactive status.

While this speaks to the training of Ms. Herbener, and that she turned off the maintenance fee reminder (upon confirmation, either directly or indirectly, from an attorney), it does not provide evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. Petitioner relies upon the email of September 4, 2003, and the second Declaration of Mr. Harris (Harris II), to conclude that a business routine was in place that could have been reasonably relied upon to avoid errors in the clerical function of closing a matter in docketing, however, and returning to Technol, no business routine at MMM as to how patents were docketed at MMM has been provided: only the specifics as to what the email indicates, and the assertion that “authorization from a responsible attorney and/or documentation in the file is required to close a matter in docketing,” is the policy at MMM. In Technol, regarding evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance – the case stated that “Thurber maintained a docket on an office personal computer in order to track maintenance fees. The general practice in Strauss’s office was to docket the patents by the issue date on the face of the patent. In accordance with this usual practice, Thurber mistakenly docketed the ‘219 patent by its issue date and not by the issue date of the parent.” Tecnol at 1258. Here, petitioner has not provided the business routine at MMM for performing the clerical function that could reasonably be relied upon to avoid errors in its performance.

Having failed to identify the employee who was in the performance of the clerical function that caused the delay, and having failed to identify the error that the employee made that was the cause of the delay, Petitioner has also failed to provide evidence of the business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance.

Mr. Harris, senior partner of MMM, has stated that ‘Ms. Herbener would not have turned off the maintenance fee reminder for the ‘224 patent in docketing had she not received such a confirmation either directly from an attorney or indirectly from an attorney via Ms. Miller. As noted supra, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). 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 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Decision

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of March 14, 2007 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson
Director
Office of Petitions