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SEP 25 2008

In re Patent No. 5,917,913	:	OFFICE OF PETITIONS
Issue Date: June 29, 1999	:	
Application No. 08/759,555	:	DECISION ON PETITION
Filed: December 4, 1996	:	UNDER 37 CFR 1.378(b)
Attorney Docket No. WANGP001	:	
Patentee(s): Wang	:	

This is a decision on the petition under 37 CFR 1.378 (e), filed on April 19, 2007 requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The request to accept the delayed payment of the maintenance fee is **DENIED**.¹

BACKGROUND

The patent issued June 29, 1999. The 3.5 year maintenance fee could have been paid from June 29, 2002 to December 29, 2002, or with a surcharge during the period from December 30, 2002 to June 29, 2003. Petitioner did not do so. Accordingly, the patent expired at midnight June 29, 2003. A petition filed under 37 CFR 1.378(b) filed November 15, 2006 was dismissed on February 20, 2007.

The instant petition requests reconsideration of the decision of February 20, 2007. The request for reconsideration is also accompanied by declarations of Susan R. McCormack, a docketing clerk with Patterson and Sheridan, Kenneth Haass, director of IT services at Patterson and Sheridan and a supplemental declaration from attorney Sheridan. Petitioner has also provided a copy of IPMaster patent manual.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate 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,

¹This decision may be viewed 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 expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks item (1).

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 U.S.C. § 41(c)(1).

Petitioner contends that Mr. Ynjun P. Wang the owner and Officer of Assignee eSignX Corporation ordered that all cases owned by eSignX be transferred to Thomason, Moser and Patterson ("herein after Thomason") on December 28, 2000. The files were transferred on January 3, 2001. A letter from Fleher, Hohbach, Test Albritton and Herbert LLP ("hereinafter Fleher") dated January 3, 2001 confirmed the transfer and also provided a list of the cases being transferred. The list included patent 5,971,913 (case number A-68940). Petitioner states that Thomason entered all of the transferred files into the IPMaster docketing system utilized with the exception of the present patent. Thus, no docket entry requiring payment of the maintenance fees for the patent in question was created. It is noted that related applications including a continuation and continuation -in- part were entered into the docketing system.

The status of the patent was not discovered until Mr. Wang was informed by a third party on August 15, 2006 that the patent has lapsed.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 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 in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. 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, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment. In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were employed by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, *supra*.

A. Petitioner has failed to establish that the delay in submitting the maintenance fee was due to docket or clerical error.

In the original petition, petitioner stated that the docketing personnel in the New Jersey office of the receiving firm, Thomason entered all the relevant information into the firm docketing system. In the request for reconsideration, the statement of Susan McCormack indicates that she was handling the docketing for the New Jersey and California office of Thomason. The procedure involved attorney Sheridan's secretary mailing or faxing copies of items to be docketed. Ms. McCormack input the information in the docket system and proofread the information that was entered after the record was saved. Petitioner insists that Ms. McCormack was the beneficiary of intensive training by the docketing supervisor and received four days of training.

The facts and evidence provided do not establish that the failure to submit the 3.5 year maintenance fee was due to, docket error. The record fails to demonstrate that either attorney Sheridan or Tina Hall, Mr. Sheridan's former assistant ever directed or requested that the patent be entered into the docketing system. It is further noted that it is not clear whether Ms. McCormack was the only docket clerk and if all docket clerks received the training provided to Ms. McCormack.

As set forth in MPEP 711.03(c), a delay resulting from an 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 :

A) the error was the cause of the delay;

B) there was in place a business routine for performing the clerical function which 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.

The record is not clear that the error was caused by a docket error. Assuming the error was caused by docket error, petitioner has failed establish that there was a business routine for performing the clerical function which could reasonably be relied upon to avoid errors. Nor has petitioner provided evidence that this employee was sufficiently trained or experienced.

An adequate showing of unavoidable delay due to docket/clerical error may include but not limited to:

- 1) statements by all parties with direct knowledge of the circumstances surrounding the delay;*
- 2) a through explanation of the docketing system in use;*
- 3) identification of the types of records kept;*
- 4) identification of the persons responsible for the maintenance of the system, copies of mail ledger, docket sheets, file wrappers;*
- 5) information regarding the training provided to the clerk(s) responsible for the docketing error, the degree of supervision of their work; and*
- 6) an indication why the system failed.*

Petitioner has failed to provide statements by all parties. Specifically statements from Tina Hall (attorney Sheridan's assistant), Kathy Faughnan (former docket supervisor) and Nancy Goodwin (current docketing supervisor). Although petitioner has provided an explanation for the failure to submit statements from all parties with direct knowledge, petitioner has the burden of proof to establish the delay was unavoidable. The failure to procure the statements goes to the failure to make an adequate showing of unavoidable delay.

Petitioner has also failed to provide sufficient information regarding the training provided beyond the manual provided. Although petitioner indicated that Ms. McCormack received four days of training, what the training consisted of was not provided.

The record is also devoid of any information regarding the degree of supervision Ms. McCormack received. To the extent Ms. McCormack neglected to include the patent in the docket system a review by a supervisor may have revealed the parent application had not been included in the docketing system.

Based on the lack of information and evidence, the Office is unable to make a determination that the docket clerk caused the delay and that reliance on the docket clerk was reasonable.

B. Petitioner failed to demonstrate the owner inquired as to the Status of the Application

The December 23, 2003 letter sent in reply to assignee's request demonstrates that assignee or the law firm should have had a second opportunity to note that the parent application/ present patent had not been included in the docketing system. It is further noted the enclosure associated

with letter which presumably would have shown what patent applications were included in the docket system as of December 2003 was not included.

CONCLUSION

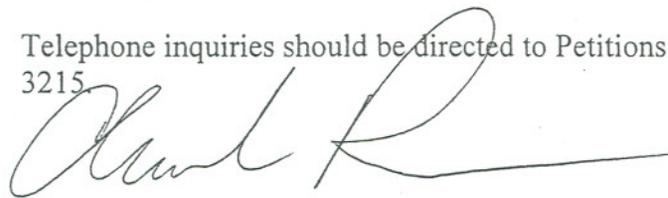
The prior decision which refused to accept under §1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

Since this patent will not be reinstated, a refund covering the maintenance fee and surcharge fee will be forwarded to petitioner.

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

The application is being forwarded to Files Repository.

Telephone inquiries should be directed to Petitions Attorney Charlema R. Grant at (571) 272-3215.

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