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MAILED

APR 29 2009

OFFICE OF PETITIONS

In re Patent No. 6,154,959 :
Issued: December 5, 2000 :
Application No. 09/375,124 : ON PETITION
Filed: August 16, 1999 :
For: CGT-083 :

This is a decision on the petition under 37 CFR 1.378(e), filed April 29, 2008.

The petition is DENIED¹.

BACKGROUND

The patent issued December 5, 2000. The 3.5 year maintenance fee could have been paid from December 5, 2003 to June 5, 2004 without a surcharge or from June 6, 2004 to December 5, 2004 with a surcharge. The maintenance fee, however, was not submitted. Accordingly, the patent expired December 5, 2004 for failure to timely submit the 3.5-year maintenance fee.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed July 18, 2007. A decision dismissing the petition under 37 CFR 1.378(b) was mailed March 24, 2008 and is hereby incorporated by reference.

Petitioner under 37 CFR 1.378(e) in seeking reconsideration of the decision under 37 CFR 1.378(b) attribute the failure to timely pay the maintenance fee to docketing error.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

In accordance with 35 USC 41(c)(1), “[t]he Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director 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. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.”

¹ This 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.

In accordance with 37 CFR 1.378(b), “[a]ny petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include: (1) The required maintenance fee set forth in § 1.20 (e) through (g); (2) The surcharge set forth in § 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.”

FACTS

Petitioner continues to attribute the failure to timely pay the maintenance fee to docketing error. As petitioner previously explained, when a patent issues, the patent clerks make a copy of the coversheet of the patent; the maintenance fee due dates are manually noted at the top of the copy of the coversheet; and the copy of the coversheet is placed into a three-ring binder in a sequence according to maintenance fee due date. The binder serves as the docketing system for, *inter alia*, maintenance fee due dates. Each month the binder is checked. If a maintenance fee is due, a notice is sent to the business group or division requesting permission to pay the maintenance fee. The maintenance fee is paid upon receipt of consent from the business group.

Petitioner became aware that the patent had expired upon notice from outside corporate counsel in July 2007. Upon this notice, petitioner checked the binder for a coversheet for the instant patent. The binder did not contain a coversheet for the instant patent.

The petition and accompanying declarations assert that the maintenance fee for the instant patent was not paid because a coversheet for the patent was not entered into the binder. The petition and accompanying declarations further assert that it is not known if the coversheet for the patent was inadvertently and improperly removed from the binder, or if the coversheet for the patent was inserted in the binder at the time that the patent issued.

Petitioner asserts that a docketing error was the cause of the failure to timely submit the maintenance fee. Specifically, because a copy of the coversheet of the patent was not present in the binder used to docket maintenance fee due dates, patentee was unaware that the maintenance fee was due.

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.”² Moreover, a late 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” delay³.

² 35 U.S.C. 41(c)(1).

³ See, Ray v. Lehman, 55 F3d 606, 608-609, 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 unavoidable⁴. Further, decisions on revival are made on a “case-by-case basis, taking all the fact and circumstances into account⁵.” Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petition has failed to meet his or her burden of establishing the cause of the unavoidable delay⁶.

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 care⁷.

Petitioner along with Emily Lang and Amy Herrman were responsible for the docket system between 2000 and the present. Petitioner states that as of December 2000, patent clerk Emily Lang “had over seven years experience and the patent clerk, Amy Herrmann, had eight years experience in operating under SEQUA’s the docket system.”

Petitioner states that he trained the patent clerks in the docket system, including how to enter information in and retrieve information from the docketing system. The experience of the patent clerks was not described with specificity, nor does petitioner provide examples of their work. Petitioner states that while being trained, the supervision of the patent clerks was more extensive and included spot checks for accuracy. Petitioner further states that eventually, the supervision of the patent clerks became minimal as there were no previous problems with maintenance fees.

It cannot be found that reliance on employees whose supervision at the time the patent issued and at the time the maintenance fee was due was minimal represented the exercise of due care. While petitioner states he continued to “spot check” the accuracy of the patent clerks’ work, petitioner has provided no evidence or specific details of such spot checks. The patent clerks do not give any indication that petitioner provided any attorney oversight of their work or conducted any “spot checks” for accuracy.

Neither petitioner nor the patent clerks are able to indicate if, upon receipt of the patent, a copy of the coversheet of the patent was ever made and placed in the binder. There is no explanation for why the business routine of entering the patent into the docket system by making a copy of the coversheet of the patent and placing it in a binder may not have been followed. Neither petitioner nor the patent clerks are able to indicate if a copy of the coversheet of the patent was

⁴ See, 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), Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (Comm’r Pat. 1913).

⁵ See, Smith v. Mossinghoff, 671 F.2d 533, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁶ See, Haines v. Quigg, 673 F.Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁷ 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).

placed in the binder and subsequently removed. Neither petitioner nor the patent clerks are able to indicate why a copy of coversheet, if ever placed in the binder may have been removed subsequent to the time the maintenance fee was due.

There is no evidence that a docketing error occurred. At best, upon receipt of the patent, petitioner and the patent clerks neglected to follow the established business routine of making a copy of the coversheet of the patent with the maintenance fee due dates written thereon and placing the copy of the coversheet in the docketing binder. Accordingly, it cannot be found that the patent clerks committed a docketing error which was the requisite cause of the failure to timely submit the maintenance fee.

Petitioner asserted non-receipt of a USPTO maintenance fee reminder. Under the statutes and rules, the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. Failure to receive the reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. The Office will attempt to assist patentees through the mailing of a Maintenance Fee Reminder in the grace period. However, the failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b)⁸.

Petitioner further asserts non-receipt of a USPTO notice expiration of patent. Petitioner is reminded that a notice will appear in each issue of the Official Gazette which will indicate which patents have been granted 3, 7, and 11 years earlier, that the window period has opened, and that maintenance fee payments will now be accepted for those patents. Another Official Gazette notice published after expiration of the grace period will indicate any patent which has expired due to nonpayment of maintenance fees and any patents which have been reinstated. An annual compilation of such expirations and reinstatements will also be published.

Further, the Office mails a Notice of Patent Expiration to the fee address as set forth in 37 CFR 1.363 when Office records indicate that a patent has expired for failure to pay a required maintenance fee. The fee address indicated in the record (Chromalloy Gas Turbine Corporation Intellectual Property Department, 330 Blaisdell Road, Orangeburg NY 10962) differs from petitioner's address. Thus, there could be no reasonable expectation of receipt of such a notice where petitioner fails to advise the USPTO of their current address.

In view of the totality of evidence of record, including the exhibits of record, it cannot be found that the entire period of time, from the time that the maintenance fee was due until the filing of the instant petition, was unavoidable.

DECISION

⁸ See, *In re Patent No. 4,409,763*, 7 USPQ2d 1798 (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).

The prior decision dismissing petition under 37 CFR 1.378(b) to accept delayed payment of maintenance fee has been reconsidered. For the reasons set forth herein the delay in payment of the maintenance fee cannot be regarded a unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b). Accordingly, the offer to pay the delayed maintenance fee will not be accepted and this patent will not be reinstated.

Petitioner may request a refund of the previously submitted fee of \$1,600.00 by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

This file is being forwarded to files repository.

Telephone inquiries concerning this matter may be directed to the Petitions Attorney Alesia M. Brown at 571-272-3205.

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

Charles Pearson
Director
Office of Petitions