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In re Patent No. 6,502,046 :
Issued: December 31, 2002 :
Application No. 09/476,452 : ON PETITION
Filed: December 30, 1999 :
Title: Laplace Transform :
Impedance Spectrometer and Its :
Measurement Method :

This is a decision on the petition under 37 CFR 1.378(e), filed June 1, 2009.¹

The petition is DENIED².

BACKGROUND

The patent issued December 31, 2002. The 3.5 year maintenance fee could have been paid from December 31, 2005 to June 29, 2006, or with a surcharge during the period from June 30, 2006 to December 31, 2006. Petitioner did not do so. Accordingly, the patent expired at midnight on December 31, 2006.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed January 30, 2009. A decision dismissing the petition under 37 CFR 1.378(b) was mailed March 27, 2009 and is hereby incorporated by reference.

Petitioner asserts that the delay was unavoidable because it was based on the docketing error made by Magnolia Almonte, the former docketing clerk at Davidson, Davidson & Kappel, LLC ("DDK"). Petitioner states that from April 13, 2005 to August 1, 2008, annuities were handled solely by Ms. Almonte with the usage of the IP Master docketing system. Petitioner contends the maintenance fee was not submitted because the policy used by DDK was not followed.

¹ The required petition fee of \$400.00 has been received.

² 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.

Petitioner states that the system, which was utilized to track maintenance fee due dates, involved notifying Dennemeyer & Co. Ltd. ("Dennemeyer") of information for the patent. Thereafter Dennemeyer would send DDK quarterly lists of annuities, which were coming due, three months in advance. Petitioner has provided a copy of the quarterly list dated January 10, 2006, which includes the instant patent. Upon receipt of the quarterly list from Dennemeyer, DDK policy requires that the docketing department contact the client in this instance K.N.K. International Patent Law Office ("KNK"), and requests instructions regarding the payment of annuities and to pay the maintenance fees if so instructed.

Attorney Kappel of DDK concludes that an error was made by Ms. Almonte because a search of the physical file associated with the above referenced patent at DDK and search of e-mail correspondence available from Ms. Almonte's DDK e-mail account indicates there is no record of a written reminder being sent by DDK to KNK regarding the due date of the 3.5 year maintenance fee. Further, KNK states they have no record of having received a request for instruction.

STATUTES AND REGULATIONS

35 U.S.C. § 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.

A petition under 37 CFR 1.378(b) to accept an unavoidably delayed payment of a maintenance fee 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 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.

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."³ 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" delay⁴. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable⁵. Further, decisions on revival are made on a "case-by-case basis, taking all the fact and circumstances into account⁶." 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 delay⁷.

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).

³ 35 U.S.C. 41(c)(1).

⁴ 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)).

⁵ 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).

⁶ See, Smith v. Mossinghoff, 671 F.2d 533, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁷ See, Haines v. Quigg, 673 F.Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioners have failed to establish that the docketing error complained of was the requisite cause of the failure to timely remit the maintenance fee. Petitioner makes certain conclusions based upon the lack of written evidence that Ms. Almonte failed to send a reminders to KNK. However, such conclusions without sufficient evidence do not establish that the failure to submit the maintenance fee was due to clerical error. Petitioner has failed to provide a copy of the physical file to establish the reminder was not sent to KNK. It is acknowledged that petitioner indicates that Ms. Almonte no longer is employed by DDK and thus a statement from Ms. Almonte has not been provided on petition. However, since the burden is on petitioner to establish that the failure to submit the maintenance fee was unavoidable, the failure to submit or attempt to obtain a statement from the person who petitioner alleges made a docket error goes to the failure to make an adequate showing of unavoidable delay.

Although the petition provides a description of the system utilized to track maintenance fee due dates, the petition fails to establish there was a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in the performance of the clerical function. Petitioner has failed to state whether reminders were only conveyed in writing. Petitioner has also failed to indicate whether the business routine included a review of the maintenance fee or annuities indicated prior to the due date of February 22, 2006 as indicted on the Dennemeyer quarterly report dated January 10, 2006.

Petitioner has failed to provide evidence that Ms. Almonte was sufficiently trained. The statement provided by attorney Kappel indicates that based upon Ms. Almonte's prior experience as a docketing clerk at various law firms handling maintenance fees and annuities for 8.5 years, there was no required need to further train Ms. Almonte in the use of the IP Master system because there were no peculiarities associated with the IP Master system utilized by DDK. However, the lack of training does not allow for the Office to determine that Ms. Almonte was properly trained. Although Ms. Almonte worked at other firms, a review of her resume does not show that Ms. Almonte previously used IP Master. Further, any evidence of training should have also included evidence of training on following the procedures of DDK for tracking and paying maintenance fees beyond the usage of IP Master.

The failure to train Ms. Almonte on the procedures used at DDK and usage of IP Master does not demonstrate reliance on Ms. Almonte was reasonable. Petitioner contends the fact the maintenance fee due dates for this patent were properly docketed in the docketing system as evidence that additional training was not required. However, the docketing system as described by attorney Kappel and outlined in the letter dated January 17, 2003 from DDK to KNK, involved more than entry of the due date into the IP Master system. The system used for tracking and paying the maintenance fee also required sending reminders to clients and obtaining instruction as to whether the maintenance fee should be paid. Further the fact that at least three patents listed on the Dennemeyer quarterly report dated January 10, 2006 expired and required petitions to accept delayed maintenance fee payments, demonstrates the system utilized may have not been reliable and thus not reasonable to rely on the system/ clerical functions in place.

Beyond the statement that attorney Kappel was one of the attorneys having the responsibility to oversee the docketing section at DDK, petition has failed to provide evidence to establish that Ms. Almonte's clerical duties were ever reviewed or supervised and thus there appears to be no checks in place to ensure proper execution of the payment of maintenance fees. To the extent Ms. Almonte neglected to send a reminder to KNK for the instant patent a review by a supervisor may have revealed that a reminder notice was not sent or received by KNK.

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

DECISION

The prior decision dismissing petition under 37 CFR 1.378(b) to accept the 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 as 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.

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

This file is being forwarded to files repository.

Telephone inquiries concerning this matter may be directed to the Petitions Attorney Charlema Grant at 571-272-3215.

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

Charles Pearson
Director
Office of Petitions