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OFFICE OF PETITIONS

Patentee: Ronald Wiley	:
Patent No. 5,398,696	:
Issue Date: March 21, 1995	:
Application No. 08/091,645	: Petition Decision
Filed: July 14, 1993	:
Title of Invention: Isometric Exercise Method	:
For Lowering Resting Blood Pressure and Grip	:
Dynamometer Useful Therefor	:

This is a decision on the petition under 37 CFR 1.378(e), filed on August 29, 2005, requesting reconsideration of a prior decision 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 March 21, 1995. The 7.5 year maintenance fee could have been paid from March 21, 2002 to September 21, 2002, or with a surcharge during the period from September 22, 2002 to March 21, 2003. The maintenance fee was not paid. Accordingly, the patent expired at midnight on March 21, 2003.

A petition to accept the delayed payment of the maintenance fee pursuant to 37 CFR 1.378(b) was filed on April 11, 2005 and dismissed on August 16, 2005.

The instant petition requests reconsideration of the decision of August 16, 2005. The request for reconsideration is accompanied by supplemental declarations of Gail James and Jerry Mueller.

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

STATUTE AND REGULATION

35 U.S.C. § 41 (c)(1) states:

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

A petition under 37 CFR 1.378(b) for the acceptance of an unavoidably delayed payment of maintenance fee is considered under the same standard as that for reviving an application unavoidably abandoned under 37 CFR 1.137(a) because 35 U.S.C. § 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.² Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.³ To meet this standard, petitioner must establish that he or

² 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)).

³ 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 man in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

she treated the patent the same as a reasonably prudent person would treat his or her most important business. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."⁴ 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 that the delay was unavoidable.⁵

The instant petition asserts that petitioner took reasonable and prudent care in attending to the payment of maintenance fees; that the docketing system used by counsel was reliable; and that Ms. James, the office manager responsible for attending to the payment of maintenance fees, was sufficiently trained and experienced.

The petition under 37 CFR 1.378(e) has been considered. However, the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b). A showing of unavoidable delay requires a showing that the **entire** delay in filing a grantable petition under 37 CFR 1.378(b) was unavoidable. *In re Application of Takao*, 17 USPQ2d 1155,1158 (Comm'r Pat. 1990). For reasons below, the record fails to establish that the entire delay was unavoidable.

A. The delay caused by the failure to properly docket the maintenance fee due date and the Notice of Expiration has not been shown to be unavoidable.

Petitioner states that the failure to pay the 7.5 year maintenance fee was the result of two docketing/clerical errors.⁶ Specifically, petitioner states:

First, two files were inadvertently docketed with the same number. Because of this error, we were unaware that that the maintenance fee was due, the appropriate notices were not sent out, and the fee was not paid. Second, a Notice of Abandonment [sic, Patent

⁴ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute unavoidable delay); *Vincent v. Mossinghoff*, 1985 U.S. Dist. Lexis 23119, 13 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs through their counsel's actions or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications).

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

⁶ April 11, 2005 petition, page 2.

Expiration] was received but not properly docketed. Thus, appropriate remedial action could not be taken.⁷

With regard to the first admitted docketing error, petitioner explains that the standard procedure for docketing a client matter involves entering data into counsel's docketing system (referred to as "PATSY"). PATSY maintains records in three categories, i.e., patent records, trademark records, and miscellaneous records. A file number consists of a client identifier, the file type (patent files are indicated by the number 2, trademark files are indicated by the number 5, and miscellaneous files are indicated by the number 0), and a consecutive matter number.⁸ When a new matter is entered into PATSY, it is assigned a file number. A docketing notebook is maintained with printouts of all existing files and their corresponding file numbers. When an attorney creates a new record in PATSY, the attorney looks up the client's existing files in the docketing notebook and determines the next consecutive matter number. The attorney then creates the docket record in the proper category using the client identifier, file type and next consecutive matter number.⁹ In this instance, attorneys Jerry Mueller and Gerald Smith were both working on different matters for MD Systems (then the assignee of the '696 patent). The two MD Systems' files associated with these matters were inadvertently docketed with the same consecutive matter number, i.e., WIL 2-001 and WIL 0-001. The first docket record corresponded to the file of the '696 patent and the second docket record corresponded to a general file.

With regard to the second admitted docketing error, petitioner states:

[t]he second docketing error that occurred involves a Notice of Patent Expiration. Although the Patent Office records do not indicate that such a notice was mailed, there is such a notice in WIL 2-002. Exhibits 6 and 8. The Notice, however, was not properly docketed. When a Notice of Patent Expiration is received, Mr. Mueller changes the file's status from "Issued" to "Abandoned" or "Expired". Declaration of Jerry K. Mueller, Jr., ¶ 19. A printout of the file information from WIL001 indicates that the status identifier was not changed. Exhibit 5. As such, there was no trigger for any remedial action to be taken.¹⁰

⁷ Id.

⁸ First declaration by Jerry K. Mueller, ¶ 9-10.

⁹ Id. at ¶10-12

¹⁰ April 11, 2005 petition at page 4.

The record indicates that attorney Mueller has been the firm's docketing clerk since March of 1998.¹¹

The record suggests, and petitioner does not contend otherwise, that either attorney Mueller or attorney Smith erred in the creation of the next file number in PATSY and that attorney Mueller, acting as the firm's docketing clerk, failed to properly docket the Notice of Patent Expiration. Whether the attorneys' errors were the result of failing to follow the established procedure of checking the docketing notebook prior to creation of a file number, error in inputting the number into PATSY, oversight in failing to docket the Notice of Expiration, etc., is unclear from the record. The burden rests upon petitioner to establish that the entire delay in paying the maintenance fee was "unavoidable" within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b). Petitioner has not met this burden.

Petitioner asserts, "while the actions of an attorney are attributable to the patentee, the standard for determining whether the failure to pay the maintenance fee was unavoidable is the same, namely, whether the party responsible for payment of the fee acted reasonably prudently." Petitioner insists that the actions of attorneys Mueller and Smith were unavoidable because they acted in a reasonable and prudent manner notwithstanding the admitted docketing errors. Petitioner requests reconsidering in light of California v. Medical Products, Inc. v. Tecnol Medical Products, Inc, 921 F. Supp 1219 (D. Del. 1995), In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988), and Laerdal Medical Corp. v. Ambu Inc., 34 U.S.P.Q.2d 1140 (D. Md. 1995).

Petitioner's argument is not persuasive. The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions.¹² Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a).¹³ A delay resulting from an attorney's preoccupation with other legal matters or with the attorney's inadvertence or mistake is not

¹¹ Mueller Declaration at ¶ 6.

¹² Link v. Wabash, 370 U.S. 626, 633-34 (1962); In re Patent No. 4,409,763, 7 USPQ 2d 1798 (Comm'r Pat. 1988).

¹³ 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).

sufficient to establish that the delay was unavoidable within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a). Mossinghoff, 671 F.2d at 536.

The cases cited by petitioner, i.e., California v. Medical Products, Inc. v. Tecnol Medical Products, Inc, 921 F. Supp 1219, In re Kaptrapat 6 USPQ2d 1863, and Laerdal Medical Corp. v. Ambu Inc., 34 U.S.P.Q.2d 1140, are readily distinguishable in that these cases involved errors made by the attorneys' employees, not by the attorneys themselves. As indicated above, the case law is clear that delays caused by the inadvertent mistakes of an attorney do not rise to the level of unavoidable delay and that the actions of patentee's representatives are imputed onto patentee. Accordingly, petitioner's contention that the delay caused by the docketing errors of attorneys Mueller and Smith was unavoidable is not persuasive.

It is further noted that the record indicates that additional errors were made in the instant case. For example, the second maintenance fee due date was admittedly docketed.¹⁴ Yet, there is no explanation as to who removed this entry from the docket report, or what investigation of the matter was made prior to its removal. The procedures set forth in Mr. Mueller's second declaration suggests that Mr. Mueller would have been responsible for removing this due date from the report.¹⁵ The docketing of the second maintenance fee due date in PATSY, presumably by Mr. Mueller,¹⁶ should have warranted a more thorough investigation of the matter prior to dismissing the docketing entry as an error.¹⁷

In addition, the record indicates that the file number assigned to the physical file for the '696 patent was changed at some point but PATSY was not updated. Petitioner provides no explanation as to who failed to update PATSY. As such, petitioner leaves open the question of whether this failure was the result of attorney error, inadequate procedures, and/or inadequate training of counsel's employees.

B. The Training and Experience of Office Manager James does not overcome the avoidable docket error of Attorneys Mueller and Smith.

The request for reconsideration provides evidence of the training and experience of Office Manager James in what is an apparent attempt to

¹⁴ Exhibit 1, page 4, of first Mueller Declaration.

¹⁵ See ¶ 6-10 of second Mueller Declaration.

¹⁶ First Mueller declaration, ¶ 14.

¹⁷ It would appear that merely entering in the docket number in PATSY under the "patent" category would have readily produced the docket record shown in Exhibit 5 of the original petition, which identifies, inter alia, the patent number and issue date.

establish unavoidable delay. As the original decision indicates, the training and experience of Ms. James would only be relevant where petitioner sought to argue that a clerical error by Ms. James caused the patent's expiration. Petitioner has not argued that Ms. James' action or inaction caused the expiration. Clearly, the two declarations by Ms. James do not admit to error on her part. Instead, petitioner reiterates that the actions of attorneys Mueller and Smith were reasonable and prudent. As such the training and experience of Ms. James is immaterial.

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 check 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.



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