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DANIEL H. GOLUB
REED SMITH SHAW & MCCLAY
2500 ONE LIBERTY PLACE
PHILADELPHIA, PA 19103-7301

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OFFICE OF PETITIONS

In re Patent No. 5,788,583 :
Issued: August 4, 1998 :
Application No. 08/752,721 : ON PETITION
Filed: November 19, 1996 :
For: 96-40212-US :

This is a decision on the petition under 37 CFR 1.378(e), filed December 4, 2006.¹

The petition is DENIED².

BACKGROUND

The patent issued August 4, 1998. The 3.5-year maintenance fee could have been paid from August 4, 2001 to February 4, 2002 without a surcharge or from February 5, 2002 to August 4, 2002 with a surcharge. The maintenance fee, however, was not submitted. Accordingly, the patent expired 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 March 2, 2006. A decision dismissing the petition under 37 CFR 1.378(b) was mailed December 2, 2006 and is hereby incorporated by reference.

Petitioners assert that reasonable care was taken to ensure that the maintenance fee would be timely paid because patentees retained counsel to prosecute the patent. Petitioners 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.

Petitioners state that prior to 2004, Reed Smith LLP, patentees voluntarily chosen legal representative, utilized the CPI Patent

¹ The required petition fee, while referenced in the petition was not received. Therefore, the required petition fee of \$400.00 has been charged to petitioners' deposit account as authorized.

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.

Management System (CPI) docketing system. Petitioners further state that Reed Smith LLP employs at least one docketing manager who, "[u]nder the supervision of attorneys at the firm, receives extensive training on properly docketing dates in the docketing system as well as preparing dockets for the attorney in the law firm."

Petitioners assert that the docketing system was reliable, but that an "unforeseen docketing circumstance occurred." Petitioners further state that Reed Smith LLP took reasonable care to ensure that the maintenance fee due date for the instant patent would be would be timely addressed by employing a docketing manager to oversee the docketing system and process. ~~Petitioners further state that by employing the docketing~~ manager, Reed Smith LLP took care to ensure the docketing system was properly used and maintained by training the docketing manager in proper use of the docketing system, properly docketing dates, and properly alerting attorneys in the law firm of errors, problems, and issues with the docketing system.

Petitioners further state that some time after the application was allowed, the docketing system was modified to reflect that the action item to pay the first maintenance fee was "taken." Docket action items that reflect "taken" in the docketing system do not appear on an attorney's docket because attorney dockets only inform attorneys of items yet to be done.

Thus, because the docketing system reflected that the action item to pay the first maintenance fee was "taken," the action to actually pay the maintenance fee did not appear on any attorney's docket. As a result of the docketing system failing to alert an attorney that the maintenance fee was due, no action was taken to ensure that the maintenance fee would be timely paid.

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.

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)).

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 petition 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).

Petitioners have failed to establish that the docketing error complained of was the requisite cause of the failure to timely remit the maintenance fee. Petitioners state that the maintenance fee due date for the instant patent was not docketed for action because sometime after the patent was allowed, all action items in the Reed Smith LLP CPI docketing system for this patent were incorrectly entered as "taken."

The supplemental petition under 37 CFR 1.378(b) submitted March 13, 2006 indicates that docketing errors occur due to non-entry or improper entry by single attorneys, or by loss of data due to a docketing system change over, such as that performed by the law firm in June 2004. No other reasonable explanation has been offered that would explain the docketing error complained of, i.e., the maintenance fee due dates for this patent having been modified in the CPI docketing system to reflect "taken."

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).

The delay in timely payment of the maintenance fee cannot be attributed to a docketing system change over in June of 2004 as the patent was already expired by this point in time.

Thus, it can only be found that attorney error was responsible for the improper docketing error at issue as petitioners have stated that docketing errors are believed to occur due to docketing system change overs or when an attorney makes an improper entry or a non-entry in the CPI docketing system.

Thus, petitioners are again advised that the United States Patent & Trademark Office must rely on the actions or inactions of duly ~~authorized and voluntarily chosen representatives of the patent~~ holder. When an attorney voluntarily chosen by patentees causes a non-entry or improper entry into a docketing system, patentees are, in fact, bound by the consequences of the acts and omissions of this freely selected agent. Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, the delay caused by mistakes or negligence of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Douglas v. Manbeck, 21 USPQ2d (BNA) (1697) (E.D. PA Nov. 7, 1991).

Assuming arguendo that the docketing error complained of was not caused by a "single attorney," as previously suggested by petitioners, petitioners have not identified the employee responsible for the docketing error or how the docketing error is believed to have occurred. Petitioners have not established when, or if, the employee entered the patent maintenance fee due date into the CPI docketing system. Petitioners have not established when the employee modified the docketing system to reflect that all due dates for the patent were "taken." The level of supervision this employee received is unknown. The employee's training and experience is also unknown.

Petitioners have not presented any statements of facts from anyone having first hand knowledge of the docketing system or the error complained of. For instance, the docketing managers referenced by petitioners would, perhaps, have been able to shed some light into why or when the due dates for the patent maintenance fee were modified to reflect "taken."

Petitioners have failed to establish that there was a business routine in place for performing the clerical function of docketing that could reasonably be relied upon to avoid an error in its performance.

Petitioners state that Reed Smith LLP utilized the CPI docketing system at the time the maintenance fee for the instant patent was due to instruct attorneys to take action on outstanding due dates, such as maintenance fee due dates, provided the docketing system did not indicate that the outstanding due date was "taken."

Petitioners state that Reed Smith LLP employs at least one docketing manager who, under supervision of attorneys at Reed Smith LLP, receives extensive training on properly docketing dates in the docketing system and preparing dockets for attorneys at Reed Smith LLP. Other than generally disclosing that docketing managers receive training and supervision, the docketing managers' exact duties are not disclosed.

Moreover importantly, petitioners have not established that a business routine existed for entering maintenance fee due dates into the CPI docketing system after a patent issued. It is unknown how employees charged with entering maintenance fee due dates into the CPI docketing system received instruction to do so. It is unclear what systems, if any, were in place to ensure that the maintenance fee due data entered into the CPI docketing system was properly entered and maintained to avoid improper modifications, as alleged to have occurred in this instance.

Petitioners have failed to establish that employees were sufficiently trained and experienced with regard to the docketing function and business routine for its performance that reliance upon such employees represented the exercise of due care. Details concerning the specific training and experience of employees were not disclosed. The business route for entering maintenance fee due dates is unknown. Further, the level of supervision given employees charged with entering maintenance fee due dates and modifications for patents into CPI docketing system is also unknown. Accordingly, it cannot be found that reliance on employees whose qualifications and degree of supervision are unknown represented the exercise of due care.

In view of the totality of evidence of record, including the exhibits submitted herewith, 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

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 \$1,150.00 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.



Charles Pearson
Director
Office of Petitions