



Paper 18

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In re REISSUE PATENT NO. RE36,715 :
Issue Date: May 30, 2000 :
Application No. 08/856,600 : **ON PETITION**
Filed: May 15, 1997 :
Attorney Docket No: 920476-105893 :

This is a decision on the "PETITION FOR RECONSIDERATION UNDER 37 C.F.R. §1.378(E) OF PETITION PURSUANT TO 37 C.F.R. §1.378(A) TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE", filed February 1, 2008, in response to a prior decision mailed December 3, 2007, 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

At the outset, maintenance fees must be paid according to the schedule set by the issue date of the original patent (5,416,626), and not the issue date of the reissue patent.

The original patent issued May 16, 1995. The second maintenance fee due could have been paid during the period from May 16, 2002 through November 18, 2002 or with a surcharge during the period from November 19, 2002 through May 16, 2003. Additionally, the third maintenance fee due could have been paid during the period from May 16, 2006 through November 15, 2006 or with a surcharge during the period from November 16, 2006 through May 16, 2007. This patent expired on May 16, 2003 for failure to timely remit the second maintenance fee.

In a petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee, filed on July 30, 2007, petitioner asserted that the delay in timely payment of the maintenance fees was unavoidable due to conflicting instructions to pay the second maintenance fee and an inadvertent deletion of the instruction to pay the maintenance fee from the docketing system. Petitioners claimed further that the error was not

¹This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

discovered until after the patent had expired when payment of the third and final maintenance fee was attempted.

The petition was dismissed in a decision mailed December 3, 2007 because it was not demonstrated that proper instructions for the payment of the maintenance fee had been given, that procedures were in place to cross reference systems where reissue patents are concerned and finally because no supporting documentation was provided to support the allegations that the delay in paying the maintenance fees was because of an error due to conflicting instructions or that reasonable care in the duties of the person who deleted the instruction to pay was exercised to prevent the delay in the payment of the maintenance fees.

Finally, based on the information provided on petition, it was assumed that petitioners were arguing that the delay was based on clerical error. The decision dismissing the petition therefore required a documented showing, how the failure to pay the maintenance fee was due to a clerical error.

The instant petition under 37 CFR 1.378(e) purports to provide additional explanations as to why petitioners believe the payment of the second maintenance fee was delayed and why that delay was unavoidable.

STATUTE AND REGULATION

35 USC 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.

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

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". 35 USC 41(c)(1). Acceptance of a late maintenance fee on the basis of unavoidable delay is considered under the same standard as that for reviving an abandoned application under 35 USC

133 because 35 USC 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 was unavoidable. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912)("The word '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"); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). 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, 5 USPQ2d 1130 (N.D. Ind. 1987).

On reconsideration petitioner argues that a supplement was filed November 8, 2007 to the July 30, 2007 petition and that it is not clear that the December 3, 2007 decision took that information in consideration when rendering the decision. A review of the record reveals that a DECLARATION OF IN SUPPORT OF PETITION PURSUANT TO 37 C.F.R. §1.378(a) TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE by Stephen Henry Miller, Managing Director of Dennemeyer & Co., Ltd., the company employed by Nortel Networks Limited for the renewal of this patent was filed on November 8, 2007.

While the Miller declaration is of record, the Miller declaration filed November 8, 2007 explained how the error occurred which led to the delay in payment of the maintenance fee and referred to the exhibits filed with the petition on July 30, 2007 to support the argument that the delay was unavoidable. The Miller declaration did not offer any additional arguments or substantiate the arguments made in the petition filed July 30, 2007. The burden of establishing that the delay was unavoidable was not met with the evidence provided in the petition filed July 30, 2007 or with the Miller declaration filed November 8, 2007.

On reconsideration, petitioner renews the argument that the delay was unavoidable and argues that the declarations by Jeanette Munro employed by Nortel Networks Limited ("Nortel"), Gill Lennon employed by Dennemeyer & Co., Ltd., Gillian Gascoigne employed by Dennemeyer & Co., Ltd., and Stephen Henry Miller, Managing Director of Dennemeyer & Co., Ltd., demonstrate, as required by the Patent and Trademark Office, that:

- A. The error was the cause of the delay at issue;
- B. There was in place a business routine for performing the clerical functions that

could reasonably be relied upon to avoid errors in its performance;

C. The employees involved were sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such an employee represented the exercise of due care.

A review of Exhibits C, D and E, all referenced in the Munro, Lennon, Gascoigne and Miller declarations, are consistent with petitioner's argument that Nortel (Ms. Munro) in its instructions to Dennemeyer & Co., Ltd. ("Dennemeyer"), identified Patents Nos. 5,416,626 and RE 36,715 as two separate entities, that per the instructions received from Nortel, Dennemeyer, Ms. Lennon, therefore, canceled the renewal instruction against Patent No. 5,416,626 while, per the instructions received from Nortel, Dennemeyer, Ms. Gascoigne, added additional renewals, including Patent No RE 36,715.

The evidence does not support a conclusion that the instruction from Nortel was a clerical error neither does the evidence support a conclusion that Dennemeyer's adherence to the instructions from Nortel was a clerical error.

Rather, Ms. Munro was specific in her September 20, 2002 instructions to not pay the maintenance fee on the original patent. As has previously been indicated, the maintenance fee was due on the original patent which issued May 16, 1995. If maintenance fees were to be paid on the "Reissue" patent which issued May 30, 2000, they would have been due with a surcharge not later than May 30, 2004, May 30, 2008 and May 30, 2012. Instructions to pay the maintenance fee on the "Reissue" patent would therefore have been premature however, those were the instructions and Nortel annotated their records appropriately as instructed.

The Miller declaration notes that "Nortel identified Patents Nos. 5,416,626 and RE 36,715 as two separate entities". This supports a conclusion that no clerical error existed, contrary to Mr. Miller's assertion that it was the combined actions of Munro, Lennon and Gascoigne that brought about a failure to pay the maintenance fee that no one of them could have either foreseen or prevented.

Failure to understand the distinction between when the maintenance fees were to be paid and failure to issue proper instructions on payment of the maintenance fees is not a basis for unavoidable delay.

As the petition indirectly avers that clerical error was the reason for the delay and since no evidence of clerical error has been presented, no further discussion of this issue is

warranted.²

Further, referring to both the original patent and the reissue patent with the same docket or reference number, "Taylor 1", as is indicated in the Gascoigne declaration, contributed to the failure to detect that two seemingly conflicting instructions were given with respect to the payment of maintenance fees. No evidence has been provided to show that either Nortel or Dennemeyer had a system in place to timely associate the payment of the maintenance fee of the original patent with that with the reissue such that they are one file, and as such, instructions were given to not pay the maintenance fee and the instructions were followed.

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, however, petitioner has not carried the burden of proof to establish to the satisfaction of the Director that the delay was unavoidable and thus the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b). In view thereof, this patent will not be reinstated.

Since this patent will not be reinstated, the maintenance fee in the amount of \$2300 the surcharge in the amount of \$700 submitted with the petition filed July 30, 2007 will be credited back to deposit account no. 12-0913.

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

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner

²See 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).