



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK NY 10112-4498

MAILED

AUG 27 2009

In re Patent No. 6,071,156 : OFFICE OF PETITIONS
Issued: June 6, 2000 :
Application No. 09/183,455 : ON PETITION
Filed: October 30, 1998 :
Title: Surface Vessel with A :
Fully Submerged Waterjet :
Propulsion System :

This is a decision on the petition under 37 CFR 1.378(e), filed December 4, 2008.¹

The petition is DENIED².

BACKGROUND

The patent issued June 6, 2000. The 3.5 year maintenance fee could have been paid from June 6, 2003 to December 5, 2003, or with a surcharge during the period from December 6, 2003 to June 6, 2004. Petitioner did not do so. Accordingly, the patent expired at midnight on June 6, 2004.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed July 10, 2008. A decision dismissing the petition under 37 CFR 1.378(b) was mailed September 26, 2008 and is hereby incorporated by reference.

Petitioner asserts that the delay was unavoidable because it was based on docket error. Petitioner states that review of the record shows that Counsel for Rolls-Royce, Daniel Barbieri, has determined that the maintenance fee was not timely submitted because the above-identified patent was not properly entered into the docketing system. Petitioner contends the patent due dates were not entered because attorney Barbieri's former

¹ 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.

administrative assistant, Valerie Gold, failed to provide the patent due dates to Dennemeyer & Company, LTD ("Dennemeyer").

Petitioner states that the system, which was utilized to track maintenance fee due dates, involved notifying Dennemeyer of the particulars of a patent file via electronic communication. Thereafter attorney Barbieri would receive a periodic report, which asked whether to pay a maintenance fee. Attorney Barbieri would provide written instruction to Dennemeyer, who in turn paid the maintenance fee.

Despite the fact that Rolls-Royce's records indicate that a Notice of Expiration with a docket entry of July 20, 2004 was located in the file and a Notation that the maintenance fee had been paid by a third party, both petitioner and his assistant Cynthia Baxter state they do not recall receiving the Notice of Patent Expiration. Krieg Devault, current outside counsel, mailed two letters on October 2, 2006 and December 4, 2006 notifying attorney Barbieri that the patent was expired.

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

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).

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 administrative assistant Valerie Gold failed to inform Dennemeyer of the need to include the above-identified patent in their docketing system. Thus, the patent was not included on the periodic reports received from Dennemeyer. However, petitioner has failed to provide any evidence to support that conclusion.

On renewed petition, attorney Barbieri confirms that he instructed Valerie Gold to set up relevant patent files for payment of the maintenance fees. The letter dated September 3, 2002 to Baker Botts from attorney Barbieri demonstrates that the patent in question was included on a list of patents for which Dennemeyer was going to be responsible for the payments. However, a letter or electronic correspondence sent directly to Dennemeyer has not been provided. Nor is there evidence that Ms. Gold was told by attorney Barbieri to notify Dennemeyer of the particulars of the above-identified patent. Attorney Barbieri's recollection of events, which took place some six years earlier are not sufficient to establish that the instant patent was included in any directive to Ms. Gold.

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

Although the petition provides a brief 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. The petition states that the administrative assistant was responsible for setting up the Rolls-Royce Naval Marine patents on the Dennemeyer annuity database. Beyond the fact that this information was to be conveyed by electronic mail no other information was provided. Petitioner has failed to state what type of information was conveyed and how frequently the information was conveyed. Petitioner has also failed to indicate whether the business routine included some sort of receipt of confirmation from Dennemeyer. The petition decision mailed on September 29, 2008, required an explanation of the business routine for performing the clerical function. The failure to submit this information does not allow for an evaluation as to whether it was reasonable to rely on the clerical routine in place.

Petitioner has failed to provide evidence about the training the firm provides to administrative assistants. On reconsideration attorney Barbieri states that he trained Ms. Baxter in the handling of administration of maintenance fees, correspondence with outside counsel, select patent prosecution matters and general record keeping associated with Rolls-Royce. The statement provided does not include any specificity as to the training provided. Further, petitioner has failed to provide any evidence regarding the training received by Ms. Gold, the person who purportedly caused the docket error.

Further, insufficient evidence was provided to establish that Ms. Gold'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. Gold neglected to include the patent in the docket system a review by a supervisor may have revealed the '156 patent had not been included in the docketing system. It is further noted that a statement from Ms. Gold has not been provided. The failure to procure the statement goes to the failure to make an adequate showing of unavoidable delay.

Although attorney Barbieri and Ms. Baxter state they don't recall receiving a copy of the Notice of Expiration, the records maintained by petitioner demonstrate that the Notice of Expiration was mailed to patentee. Thus the record shows that petitioner was or should have been aware that the patent expired

based on the Notice of Expiration located in the patent file. The break down in communication between Rolls-Royce and Baker Botts which increased the delay in seeking reinstatement was not unavoidable. Delay resulting from a lack of proper communication between an applicant and his representative as to the responsibility for timely filing a communication with the USPTO does not constitute unavoidable delay. See In re Kim, 12 USPQ2d 1595 (Comm'r Pat 1988); Ray v. Lehman 55 F.3d 606 at 610, 34 USPQ2d 1786 at 1789. Further, as the September 3, 2002 letter to Baker Botts illustrates, Baker Botts was no longer responsible for the above-identified patent. Thus, a prompt change of address filed with the office may have resulted in the Notice of Expiration being mailed directly to Rolls Royce or Dennemeyer, potentially allowing for a reinstatement of the patent.

Lastly, the submission of this petition was untimely. A request for reconsideration was due two months from September 26, 2008. The delay in submitting a timely renewed petition further demonstrates that a finding of unavoidable delay is not warranted. The language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. See 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), 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)). As set forth in MPEP 711.03(c), an applicant who deliberately chooses to delay the filing of a petition under 37 CFR 1.137 (as in Application of S, 8 USPQ2d at 1632) will not be able to show that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable" or even make an appropriate statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional."

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.



Charles Pearson
Director
Office of Petitions

CC: John H. Allie
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, IN 46204-2079