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JAN 16 2009

**OFFICE OF PETITIONS**

In re Application of	:	
Gladwin S. Das	:	
Application No. 08/756,776	:	
Patent No. 6,077,291	:	DECISION ON PETITION
Filed: November 26, 1996	:	PURSUANT TO 37 C.F.R.
Issue Date: June 20, 2000	:	\$ 1.182 AND RENEWED
Attorney Docket Number:	:	PETITION PURSUANT TO
16848.11.7	:	TO 37 C.F.R. § 1.378(E)
Title: SEPTAL DEFECT CLOSURE	:	
DEVICE	:	

This is a decision on the renewed petition filed July 21, 2008, pursuant to 37 C.F.R. § 1.378(e), requesting reconsideration of a prior decision pursuant to 37 C.F.R. § 1.378(b), which refused to accept the delayed payment of maintenance fees for the above-referenced patent. On July 24, 2008, Petitioner submitted a petition pursuant to 37 C.F.R. § 1.182, requesting expedited handling of the renewed petition pursuant to 37 C.F.R. § 1.378(e).

On August 12, 2008, the Office attempted to mail a Request for More Information. Although this communication is viewable in both Private Pair and the electronic record, due to the fact that this paper does not contain a date stamp, it does not appear that this document was properly mailed. Nevertheless, Petitioner viewed this document in Private Pair, prepared a response, and submitted the same electronically on September 11, 2008. This submission of September 11, 2008 is being treated as a supplement to the renewed petition.

The petition pursuant to 37 C.F.R. § 1.182 is **GRANTED**. The petition pursuant to 37 C.F.R. § 1.378(b) has been accorded expedited handling.

The renewed petition pursuant to 37 C.F.R. § 1.378(b) is **DENIED**.<sup>1</sup>

The patent issued on June 20, 2000. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R.

§ 1.362(e) expired at midnight on June 20, 2004, with no payment received. Accordingly, the patent expired on June 20, 2004 at midnight.

It is noted that on June 20, 2002, Application No. 10/175,669 was filed for reissue of U.S. Patent No. 6,077,291.

An original petition was filed on March 26, 2008, along with, *inter alia*, the surcharge associated with a petition to accept late payment of a maintenance fee as unavoidable, along with the 3½-year maintenance fees and numerous declarations of fact. The original petition was dismissed via the mailing of a decision on May 21, 2008.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) The required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) The surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that 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.

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

Petitioner has met the first and second requirements of 37 C.F.R. § 1.378(c). The third requirement has not been met. A discussion follows.

### The standard

35 U.S.C. § 41(c)(1) states:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>2</sup> is shown to the satisfaction of the Director to have been unavoidable.

Rule 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

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<sup>3</sup>.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>4</sup> Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>5</sup>

An adequate showing that the delay in payment of the maintenance fee at issue was unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee

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<sup>2</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

<sup>3</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>4</sup> Smith v. Mossinghoff, 671 F.2d at 538, 213 U.S.P.Q. at 982.

<sup>5</sup> Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b).

Furthermore, under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, in support of an argument that the delay in payment was unavoidable, evidence is required that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid.<sup>6</sup>

Even if the Office were required to provide notice to applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.<sup>7</sup>

#### Docketing error

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.

Such a showing should identify the specific error,<sup>8</sup> the individual who made the error, and the business routine in place

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<sup>6</sup> See MPEP 2590 (Manual of Patent Examining Procedure, Rev, Aug. 1, 2001).

<sup>7</sup> See Ray v. Lehman, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, Petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

<sup>8</sup> Petitioner must identify the error that caused the delay. If the specific error cannot be identified, the petitioner must identify any and all possible causes and prove that any of them, if they were the true cause, constitute unavoidable delay. A full and complete discussion for each possible error must be presented. Petitioner is reminded that a petitioner has the burden of proof.

for performing the action that resulted in the error. The showing must establish that the individual who erred 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. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

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:

- (1) the error was the cause of the delay at issue,
- (2) a business routine was in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and;
- (3) 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 M.P.E.P. § 711.03(c) (III) (C) (2).

An adequate showing should include (when relevant):

- (1) statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them;
- (2) a thorough explanation of the docketing and call-up system in use;
- (3) identification of the type of records kept;
- (4) identification of the persons responsible for the maintenance of the system;
- (5) copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing;
- (6) include an indication as to why the system failed in this instance, and;
- (7) information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described

work which were used to assure proper execution of assigned tasks.

Portions of the Code of Federal Regulations and the M.P.E.P. relevant to the abandonment of this application

37 C.F.R. § 1.362 sets forth, *in pertinent part*:

(a) Maintenance fees as set forth in §§1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

- (1) 3 years through 3 years and 6 months after grant for the first maintenance fee,
- (2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and
- (3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:

- (1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.
- (2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and
- (3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

M.P.E.P. 2515 sets forth, *in pertinent part*:

If a patent expires because the maintenance fee and any necessary surcharge have not been paid in the manner required by 37 C.F.R. 1.366, the patentee could proceed under 37 C.F.R. 1.378 (see MPEP § 2590), if appropriate, or could file a petition under 37 C.F.R. 1.377 (see MPEP § 2580) within the

period set therein seeking to have the maintenance fee accepted as timely even though not all of the required identifying data was present prior to expiration of the grace period.

### Application of the standard to the current facts and circumstances

With the original petition, Petitioner submitted, *inter alia*, a plurality of declarations of fact and affidavits from two University employees, two attorneys who are not of record, and two attorneys of record. With this renewed petition, Petitioner has submitted, *inter alia*, additional declarations of facts.

Petitioner has asserted that the Regents of the University of Minnesota (University) are the patent holder,<sup>9</sup> however Office records do not appear to indicate that an assignment has been recorded with the Office. However, the Regents of Minnesota are listed on the face of the patent as the assignee.

The Office for Technology Commercialization (OTC) is a department within the University that is responsible for intellectual property, as well as the licensing and technology transfer thereof.<sup>10</sup> Mr. Strauss served as the director of the OTC from 1999 - 2006<sup>11</sup>, Mr. Moore served as the Director of Health Technologies for OTC from 1999 - 2007,<sup>12</sup> and Mses. Figg Garrison and Corgard are both employees of the OTC.<sup>13</sup>

The OTC utilizes a computer data base entitled the "Technology Information Management System" (TIMS). Information pertaining to an application/patent is placed into this system by Mses. Figg Garrison and Ms. Corgard. If Computer Packages Inc. (CPI) is to track the maintenance fees for a particular patent, the flag "to CPI" is placed in the flag field of the TIMS database.<sup>14</sup>

Data Update Reports are prepared, and are submitted to CPI on a monthly basis, informing the same of any additional patents for

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9 Original petition, page 7.

10 Figg Garrison declaration provided with original petition, paragraph 3.

11 Strauss declaration provided with original petition, paragraph 5.

12 Moore declaration provided with original petition, paragraph 2.

13 Figg Garrison declaration provided with original petition, paragraphs 2-3 and Corgard declaration provided with original petition, paragraphs 2-3.

14 Figg Garrison declaration provided with original petition, paragraphs 3-4, 6, and 9-10. See also Strauss declaration provided with original petition, paragraph 8 and Corgard declaration provided with original petition, paragraphs 4-5.

which CPI is to monitor, or changes to patents for which CPI has already assumed responsibility. CPI uses the information contained in these monthly reports to monitor the University's patents.<sup>15</sup>

Ms. Figg Garrison has set forth that a Ms. Barbara Pledge of CPI informed her that this patent was

added to CPI's system in December 2001, but was deleted from CPI's system after it was marked 'abandoned' by someone at CPI on July 29, 2002.

Figg Garrison declaration, paragraph 12.

It is noted that with this renewed petition, Petitioner has explained the reason that CPI assumed responsibility for this patent in the absence of an OTC Data Inquiry report.

The OTC is a member of the Association of University Technology Managers (AUTM), which appears to be a trade organization. AUTM conducts annual surveys of its members, and one of the inquiries that is posed to its members is the number of issued patents that are held by each AUTM member.<sup>16</sup> In January of 2001, Mr. Strauss spoke with Ms. Corgard, and expressed his desire to ensure that OTC was "accurately counting for AUTM statistics the number of issued patents owned by the University."<sup>17</sup> Mr. Strauss has no recollection of this particular discussion.<sup>18</sup>

The precise instructions that Mr. Strauss gave to Ms. Corgard so as to ensure that the University would not double-count reissue applications have not been made clear, however a copy of the "contemporaneous notes taken during (her) conversation with Tony Strauss"<sup>19</sup> has been provided, and it is clear that she wrote:

per TS - 1-2-01

Reissued Patents replace (emphasis included) the last one. Mark the parent patent abandoned as soon as the Reissue app is filed. Do include it in the counts of active issued patents. (per AUTM instructions) - e-mailed VW 1-10-01

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<sup>15</sup> Figg Garrison declaration, paragraph 10.

<sup>16</sup> See AUTM survey of 2007 provided with original petition, Figg Garrison declaration provided with original petition, paragraph 26, Strauss declaration provided with original petition, paragraphs 18-19, and Corgard declaration provided with original petition, paragraph 26 .

<sup>17</sup> Corgard declaration provided with original petition, paragraph 26.

<sup>18</sup> Strauss declaration provided with original petition, paragraph 18.

<sup>19</sup> Corgard declaration provided with original petition, paragraph 27.

Consequently, when reissue application 10/175,669 was filed, Ms. Corgard updated the file in TIMS that is associated with patent number 6,077,291, and entered the word "abandoned" in the "status" field for this patent.<sup>20</sup>

Ms. Corgard has set forth that this entry "may have resulted in someone at CPI thinking the University wanted to abandon the '291 patent and therefore not pay further maintenance fees."<sup>21</sup>

Petitioner has included a copy of a facsimile transmission that was sent from the University to CPI on July 26, 2002, which lists this patent, and includes the text "Status Abandoned." With this renewed petition, Petitioner has indicated that this facsimile transmission constitutes a Data Update Report.<sup>22</sup>

Ms. Wing is the Director of Client Services for CPI.<sup>23</sup> She has set forth that the "journal page...shows that on July 29, 2002, CPI marked the '291 patent 'ABND PER FAX 7/29/02.'"<sup>24</sup>

The decision on the original petition indicated that this patent expired due to three docketing errors: Mr. Strauss' erroneous instruction to Ms. Corgard, Ms. Corgard's erroneous characterization of this patent as abandoned, and CPI's erroneous interpretation of this characterization.

This decision on the renewed petition will address each docketing error separately.

Regarding the Strauss-Corgard Meeting and Notes:

The decision on the original petition set forth, *in pertinent part*:

Ms. Corgard has set forth that on January 2, 2001, she had a conversation with Mr. Strauss, and Mr. Strauss has indicated that he has no recollection of this particular conversation. The notes that she took contemporaneously with this discussion read, *in pertinent part*, "mark the parent patent abandoned as soon as the Reissue app is filed."

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<sup>20</sup> Corgard declaration, paragraph 24.

<sup>21</sup> Corgard declaration provided with original petition, paragraph 25.

<sup>22</sup> Garrison declaration provided with original petition, paragraph 8.

<sup>23</sup> Wing declaration provided with original petition, paragraph 2.

<sup>24</sup> Wing declaration provided with original petition, paragraph 7. See also Wing exhibit 1 provided with original petition, page 2.

This strongly suggests that she was explicitly instructed by Mr. Strauss to mark the parent patent abandoned upon the filing of a reissue application. There does not appear to be any alternate credible explanation that would explain why Ms. Corgard wrote what she did.

Mr. Strauss is an attorney, experienced in the practice of intellectual property development and licensing.<sup>25</sup> Yet it appears that he instructed Ms. Corgard to list this patent as "abandoned" in the TIMS database; the same database that contains the information that is provided to CPI via the monthly Data Update Reports.

Section 711.03(c)(II)(C)(2) of the M.P.E.P. sets forth a method where a similar mistake can be characterized as unavoidable, but only when the actor was an employee such as a docket clerk or a paralegal. When the actor is an (sic) attorney, he is held to a higher standard than one of these aforementioned employees. As such, Mr. Strauss' erroneous instruction cannot be characterized as unavoidable.

Decision on original petition, pages 9-10.

With this renewed petition, Petitioner has asserted

...the record simply fails to provide a basis for concluding that Mr. Strauss made any error—much less a clerical error - in this matter.

Renewed petition, page 6.

Due to the fact that this documentation was made prior to the filing of this reissue application, it appears that this statement was directed generally towards reissue applications,<sup>26</sup> and not towards this particular application.

Mr. Strauss has asserted that these contemporaneous notes should "not be treated as an accurate record of the exact conversation we had relative to ensuring a correct count of the University's patent portfolio,"<sup>27</sup> and that the notes are "logical...only if the word 'filed' is replaced with the word 'issued.'"<sup>28</sup> As such, Mr. Strauss is asserting that Ms. Corgard, an employee he has characterized as "an excellent employee who always carried out her assigned tasks in a reliable manner,"<sup>29</sup> did not accurately record the conversation that took place.

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25 Strauss declaration provided with original petition, paragraphs 1-5.

26 See renewed petition, page 7.

27 Strauss declaration provided with original petition, paragraph 16.

28 Id.

29 Id. at 14.

Yet Mr. Strauss has conceded "I no longer recall the exact words I used."<sup>30</sup> There is much confusion and speculation as to what occurred at this meeting and it is not established by the evidence presented that this statement can definitively be attributed to Mr. Strauss.

Ms. Corgard has been described as "well-trained, conscientious and detail-oriented (emphasis added),"<sup>31</sup> as well as a "reliable and dependable OTC employee of long standing," held in the "highest regard" by her co-workers.<sup>32</sup> Ms. Corgard has asserted that she has "always received favorable reviews for [her] work,"<sup>33</sup> an assertion that is confirmed in the tenth paragraph of the Garrison declaration that was provided with the renewed petition. Moreover, Ms. Garrison was Ms. Corgard's supervisor, and she has added that Ms. Corgard's reports were "reliable," her work was of a "characteristically accurate nature (emphasis added)," and her work was "consistently rated..as outstanding."

Ms. Corgard has provided a supplemental declaration with this renewed petition, and she has commented that "unless he misspoke, I may have misunderstood Mr. Strauss or may have written one word incorrectly<sup>34</sup>." As such, Ms. Corgard has alleged that it is possible that she misunderstood Mr. Strauss's instructions.

Therefore, with this renewed petition, Petitioner has placed the Office in the position where a decision must be made as to which alternate scenario is more likely: Mr. Strauss's interpretation of a recordation of a directive that he issued during a conversation which he has no recollection of, or the possibility that Ms. Corgard's contemporaneous recordation accurately records the words of Mr. Strauss. Determining which statement is accurate is difficult at best. It must be noted that Petitioner only argues for one possibility (that the notes of Ms. Corgard are inaccurate) and does not address the other possibility. Even accepting this most favorable interpretation of the facts, this petition must still be denied, as set forth below.

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30 Id. at 16.

31 Moore declaration provided with renewed petition, paragraph 9.

32 Garrison declaration provided with renewed petition, paragraph 10.

33 Corgard declaration provided with renewed petition, paragraph 23.

34 Id. at 12.

Regarding Ms. Corgard's docketing error:

With the original petition, Petitioner identified the error that was the cause of the delay at issue, and established that a business routine was in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. Petitioner further provided a thorough explanation of the docketing and call-up system in use, identification of the type of records kept, identification of the persons responsible for the maintenance of the system, an indication as to why the system failed in this instance, that Ms. Corgard was experienced in regards to the use of TIMS, and examples of other work functions carried out by her.

It is noted that with this renewed petition, a statement from Ms. Pledge has been provided. Moreover, Petitioner has established that Ms. Corgard is a trusted employee and that her work is not typically reviewed and she was not typically supervised,<sup>35</sup> has provided examples of other work functions carried out,<sup>36</sup> and has established that annual reviews serve as checks on the described work that were used to assure proper execution of assigned tasks.<sup>37</sup>

However, the decision on the original petition indicated that Petitioner would need to describe the training that was provided to Ms. Corgard. With this renewed petition, it is been set forth that she has worked at the University for more than 20 years,<sup>38</sup> and it is clear that she received instructions regarding the TIMS database "from time to time,"<sup>39</sup> but the specific training provided to her has not been revealed.

Moreover, the decision on the original petition inquired

[I]f Ms. Corgard was sufficiently trained in the usage of the TIMS database, why did she not appreciate the fact that the entry of "abandoned" in the status field would signal to CPI that the University was no longer interested in maintaining this patent?

Decision on original petition, page 10.

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35 Garrison declaration provided with renewed petition, paragraph 10. See also Renewed petition, page 14.

36 Renewed petition, page 12.

37 Garrison declaration provided with renewed petition, paragraph 10.

38 Moore declaration provided with renewed petition, paragraph 9. Moore declaration provided with renewed petition, paragraph 9.

39 Corgard declaration provided with renewed petition, paragraph 6.

With this renewed petition, **this question has not been answered.** It has been explained that Ms. Corgard did not appreciate the ramifications of marking a patent as "abandoned,"<sup>40</sup> however this does not answer the question that was posed. As such, this omission must be interpreted as an admission that **Ms. Corgard was not sufficiently trained in this docket system** (particularly when viewed in light of the fact that Petitioner has not described the training provided to her), and as a consequence of this insufficient training, she did not appreciate the consequences of marking a patent as "abandoned." In this regard, the facts further show that Ms. Corgard was not adequately supervised since the marking of a file as "abandoned" was left to her without any type of review of her work. There does not appear to be any type of check within the docketing system to prevent the error.

Additionally, the decision on the original petition indicated that Petitioner had failed to **provide copies of records that exist that would substantiate an error in docketing**, in that:

...the notes which Ms. Corgard took contemporaneously with her conversation with Mr. Strauss, she wrote "e-mailed VW 1-10-01." A copy of this e-mail should be provided on renewed petition.

Decision on original petition, page 11.

With this renewed petition, Ms. Corgard has indicated that this e-mail concerned having the University's IT person "modify the query for future AUTM licensing surveys."<sup>41</sup> As such, this e-mail is highly relevant to the issue of the failure to timely submit the 3½-year maintenance fee, as the modification of patent records for the purposes of obtaining accurate information for AUTM licensing surveys is precisely what resulted in the failure to submit the 3½-year maintenance fee in a timely manner. However, a copy of this e-mail has not been provided, due to the fact that it has not been located.

Regarding the docketing error made by an employee of CPI:

With the original petition, Petitioner identified the error that was the cause of the delay at issue, identified the type of

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<sup>40</sup> See renewed petition, page 4, section 4, and pages 13-14. See also Corgard declaration provided with renewed petition, paragraph 12.

<sup>41</sup> Corgard declaration provided with renewed petition, paragraph 22.

records kept and provided a copy of the same.

With this renewed petition, it has been established that CPI has an established policy that the word "abandoned" is

commonly used throughout CPI and by many of our clients worldwide to mean that a maintenance fee was not be paid.

Wing declaration provided with renewed petition, paragraph 10.

However, Petitioner has failed to provide statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

The decision on the original petition set forth:

Petitioner has asserted that an employee of CPI misconstrued the entry "abandoned" to represent an assertion that the University no longer wished for CPI to monitor this patent on its behalf, however it does not appear that Petitioner has identified this CPI employee. On renewed petition, Petitioner will need to both identify this employee and provide a statement from this individual.

Decision on original petition, page 11.

As such, the decision on the original petition expressly indicated that this individual would need to be identified, and a statement would be required from the same. With this renewed petition, this person has been identified as an individual by the name of Matt Howe. However, a statement from Mr. Howe has not been provided, due to the fact that he "left the employ of CPI some time (sic) in 2003."<sup>42</sup> The petition is silent as to any search that was performed for Mr. Howe, and as such, it does not appear that any effort was made to locate this individual.

Moreover, the decision on the original petition set forth:

...Petitioner has failed to establish that a business routine was in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, in that a thorough explanation of the business system has not been provided.

Decision on original petition, page 11.

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<sup>42</sup> Wing declaration provided with renewed petition, paragraph 9. See also renewed petition, page 15.

With this renewed petition, Petitioner has not explained how CPI operates or how it tracks the due dates for maintenance fees. Consequently, it follows that Petitioner has failed to enumerate the steps taken to ensure timely payment of the maintenance fee, as is required by 37 C.F.R. § 1.378(b)(3).

Moreover, it is noted that Ms. Wing has explained that all data entries made by Mr. Howe were checked by a "verify team," that was comprised of "highly skilled, long term CPI employees."<sup>43</sup> Consequently, the degree of supervision of his work has been established, and it is clear that checks were made on Mr. Howe's work so as to assure proper execution of assigned tasks.

However, although Ms. Wing has asserted that "Mr. Howe was sufficiently trained and experienced for his type of work,"<sup>44</sup> she has not described the specific training provided to him, and as such, Petitioner has not provided information regarding the training provided to Mr. Howe. Moreover, while it has been set forth that he worked in a "different office" from Ms. Wing from "2001-2002,"<sup>45</sup> Ms. Wing has not revealed how long Mr. Howe had performed the specific task of data entry, and as such, Petitioner has not established that Mr. Howe was sufficiently experienced in this role. As such, Petitioner has not established that Mr. Howe 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.

Furthermore, the petition is silent as to examples of other work functions carried out by Mr. Howe.

Additional considerations:

Petitioner has established why CPI assumed responsibility for this patent in the absence of an OTC Data Inquiry report.<sup>46</sup> Petitioner has further established why no one in the OTC noticed that CPI had ever asked for money to submit towards the maintenance fee: the accountant never reviewed the bills that were sent by CPI.<sup>47</sup> Mr. Moore has further

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43 Wing declaration provided with renewed petition, paragraph 9.

44 Id.

45 Id.

46 Petition, page 10. See also Garrison declaration provided with renewed petition, paragraph 11.

47 Taneja declaration, paragraph 9.

explained that he never inquired as to the validity of this patent,<sup>48</sup> however this does not answer the question that appears on page 12 of the decision on original petition:

Moreover, it is not clear why during all of the aforementioned reissue, licensing, and enforcement activities, this fact was overlooked by all interested parties at OTC. Prior to engaging in reissue, licensing, or enforcement activities, why didn't anyone check to ensure that this patent was valid?

Similarly, Petitioner has explained that the University was unaware of the expiration of this patent prior to being informed of the same by the opposing side in litigation due to the incorrect assumption that CPI had timely paid the maintenance fee.<sup>49</sup> As such, it appears that they never attempted to ascertain the validity of this patent.

It is noted that with the supplement to the renewed petition, received on September 11, 2008, Petitioner has asserted that when filing a petition pursuant to 37 C.F.R. § 1.378(b), a petitioner is not required to establish that the entire period of delay was unavoidable - only the period of delay subsequent to the patentee actually becoming aware of the expiration of the patent is relevant.<sup>50</sup> Moreover, Petitioner has taken issue with the proposition that publication of the expiration of a patent in the *Official Gazette* places a patentee on notice of the same.<sup>51</sup> Petitioner has also suggested that patentees have no duty to review the *Official Gazette*.<sup>52</sup>

Petitioner has further provided a statement from Ms. Wing, where she has established that on June 1, 2004 (19 days before the expiration of this patent), CPI ceased reviewing maintenance fee statements received from the Office. Prior to this date, maintenance fee statements received from the Office were bundled together and sent to the client.<sup>53</sup> Ms. Wing has also indicated that CPI does not review the list of expired patents that published in the *Official Gazette*.<sup>54</sup>

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48 Moore declaration provided with renewed petition, paragraph 21.

49 Renewed petition, page 16, sub-paragraph (1).

50 Supplement to the renewed petition, pages 2, 10-11, and 16.

51 *Id.* at 3-4.

52 *Id.* at 5.

53 Wing declaration provided with the supplement to the renewed petition, paragraphs 5-6.

54 *Id.* at 7-8.

Petitioner has also established that OTC employees do not enter maintenance fee statements into TIMS.<sup>55</sup> These maintenance fee statements are not reviewed,<sup>56</sup> and neither are the list of expired patents that are published in the Official Gazette.<sup>57</sup>

#### CONCLUSION

The prior decision, which refused to accept, under 37 C.F.R. § 1.378(b), the delayed payment of the maintenance fee for the above-identified patent, has been reconsidered. For the above stated reasons, the delay cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b).

Since this patent will not be reinstated, Petitioner is entitled to a refund of the surcharge and maintenance fees, but not the \$400 fee associated with the filing of this renewed petition pursuant to 37 C.F.R. § 1.378(e). These fees will be refunded to Petitioner's Deposit Account in due course.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of

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55 Corgard declaration provided with the supplement to the renewed petition, paragraph 6. See also Garrison declaration provided with the supplement to the renewed petition, paragraph 6.

56 Corgard declaration provided with the supplement to the renewed petition, paragraph 5. See also Garrison declaration provided with the supplement to the renewed petition, paragraphs 5 and 7 and Strauss declaration provided with the supplement to the renewed petition, paragraph 8.

57 Corgard declaration provided with the supplement to the renewed petition, paragraph 9. See also Garrison declaration provided with the supplement to the renewed petition, paragraph 8 and Strauss declaration provided with the supplement to the renewed petition, paragraph 9.

Correspondence Address, Patent Form (PTO/SB/123), may be found here: <http://www.uspto.gov/web/forms/sb0123.pdf>. A blank fee address form may be found here: <http://www.uspto.gov/web/forms/sb0047.pdf>.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanowski at (571) 272-3225.<sup>58</sup>



Charles Pearson  
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<sup>58</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).