



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

Paper No. 14

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

COPY MAILED

JUL 11 2008

OFFICE OF PETITIONS

In re Application of :
Tohru Sugihara :
Application No. 08/432,901 :
Patent No. 5,493,296 : DECISION ON PETITION
Filed: May 2, 1995 : UNDER 37 C.F.R. §1.377
Issue Date: February 20, 1996 :
Title: NOISE SHAPING CIRCUIT :
AND NOISE SHAPING METHOD :

This is a decision on the renewed petition under 37 C.F.R. §1.378(e), requesting reconsideration of a prior decisions pursuant to 37 C.F.R. §1.378(b), which is properly treated as a petition under 37 C.F.R. §1.377.

The present patent issued on February 20, 1996. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. §1.362(e) expired at midnight on February 20, 2000, with no payment received. Accordingly, the patent expired on February 20, 2000 at midnight. A petition under 37 C.F.R. §1.378(b) was filed on September 20, 2005, which was dismissed via the mailing of a decision on December 14, 2005. A renewed petition was timely filed on February 16, 2005.

With the present renewed petition, Petitioner's representative has included declarations from Messrs. Dunham and Phillips, Mses. Farnacci and Larmon, along with a plurality of exhibits.

It is noted that the declaration of Mr. Phillips does not appear to be associated with the present patent, in that the header indicates that it is associated with patent numbers 4,875,044 (07/127,279), 4,882,732 (07/116,208), 4,953,031 (07/447,078), 5,151,941 (07/588,715), and 5,181,195 (07/700,866).

Similarly, the declaration of Ms. Larmon does not appear to be associated with the present patent, in that the header indicates that it is associated with patent numbers 4,805,129 (07/110,452), 5,181,193 (07/430,132), 5,165,070 (07/556,443), 5,068,363 (07/597,332), 5,181,248 (07/641,681), 5,194,961 (07/795,791), and 5,493,296 (08/432,901).

It is noted that with the declaration of Ms. Farnacci, Petitioner's representative has included personal information for Meses. Hogan, Voss, and Ahmed (Barbee), including their social security numbers and their dates of birth. Petitioner's representative is reminded that since this is an issued patent, the file wrapper is not treated confidentially, and is available for inspection by the public. As such, Petitioner's representative has placed this confidential information into the public domain, for anyone to see. Petitioner's representative is advised to file a petition to expunge this information, requesting that the offending page be removed from the file and replaced with a copy of the same, less the offending material.

It is noted that Petitioner's representative has filed substantially similar petitions in the patents which are associated with application numbers 07/110,452, 07/116,208, 07/127,279, 07/430,134, 07/447,078, 07/556,443, 07/588,715, 07/597,332, 07/641,681, 07/691,817, 07/700,866, 07/789,448, 07/795,791, and 08/432,901.

The request to accept the delayed payments of the maintenance fees associated with this patent is DENIED¹.

Portions of the Code of Federal Regulations relevant to the abandonment of this application

37 C.F.R. § 1.362 Time for payment of maintenance fees.

(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.

(b) Maintenance fees are not required for any plant patents or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

¹ 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.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original non-reissue application on which the patent reissued is based.

(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(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.

(h) The periods specified in §§1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

[49 FR 34724, Aug. 31, 1984, added effective Nov. 1, 1984; paras. (a) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (c)(4) and (e) revised and para. (h) added, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994]

37 C.F.R. § 1.362 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.

(b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

Application of the standard to the current facts and circumstances

As set forth in the original petition under 37 C.F.R. §1.378(b), Petitioner's representative uses an index-card based system of tracking the maintenance fees for the patents for which it is responsible for. From the time this patent issued, Mr. Maioli has been the attorney responsible for the payment of the maintenance fees for this patent².

Petitioner's representative has no centralized department for ensuring the timely submission of maintenance fees - instead, it is up to each attorney to ensure that the maintenance fees are timely submitted for each of the patents that he/she is responsible for³.

When a Notice of Allowance and Issue Fee due is received in the law firm, a docket clerk opens a computer program and inputs the issue date. The computer program then calculates the due dates for the 3 maintenance fees, and generates 3 maintenance fee prompts for each maintenance fee due date - 3 months after the

² Original petition, page 3.

³ Dunham declaration, submitted with the renewed petition on 07/116,208, 07/556,443, 07/588,715, 07/597,332, 07/789,448 and 07/761,817, paragraph 8, page 4.

payment window opens, on the date the maintenance fee is due, and when the window closes. The docket clerk handwrites the 3 maintenance fee due dates on the Notice of Allowance and Issue Fee due, and forwards the Notice to the responsible attorney.

When the letters patent arrives at the firm, the docket clerk will open the same computer program and double-check to make sure that the data was entered and computed correctly. The letters patent is then forwarded to the responsible attorney.

Once the letters patent is received, an index card is prepared for each patent. Each patent is listed on an individual index card. The index card is then filed in a drawer, and Petitioner's representative has a series of drawers arranged which correspond to particular dates. The index card is filed in a portion of a drawer which is assigned a date according to 3 years from the issue date.

When the 3-year period expires, the card is removed from the drawer and a letter is sent to the client, along with a list of all of the patent numbers for which maintenance fees are due. If no instructions are received to the contrary, payment is submitted to the Office. When payment is sent, the date on which the maintenance fee was submitted is indicated on the card along with a checkmark, and the card is moved to the file which corresponds to the time period during which the subsequent maintenance fee will be due.

With the original petition, Petitioner's representative submitted a copy of the card which is associated with the present patent, and it bears a checkmark next to the 3½ year indicator, even though this maintenance fee was not submitted. It contains the following information:

7216/44327-A	5,493,296
S93P713US01	2/20/96
08/432,901	
5/2/95	
3 2-20-99 3½	8-20-99 8/17/99 ✓
7 2-20-03 7½	8-20-03 ✓ 7/2/03
11 2-20-07	11½ 8-20-07

The second maintenance fee was submitted to the Office on July 7, 2003⁴. Office records indicate that the submission of \$2050 was subsequently refunded to Petitioner's representative's Deposit Account. It is clear that the 7½-year maintenance fee was not accepted since the 3½ year maintenance fee was not submitted. The 7½-year maintenance fee has been charged to Petitioner's representative's Deposit Account, as authorized in the petition. With the original petition, Petitioner's representative included a declaration of facts from one Menez Ahmed, the individual who submitted the 7½-year maintenance fee⁵, and it was clear that at the time of the submission, this individual was not aware that the 3½ year maintenance fee had not been submitted.

The entire period of delay cannot be considered to have been "Unavoidable"

In light of the dismissal of his petition, on January 26, 2006, Petitioner's representative submitted a request for a refund of the submitted maintenance fees and surcharges he had filed associated with the present patent⁶. The request was signed by Mr. Maioli. The Office, as requested, refunded the fees associated with the filing of the petition under Rule §1.378(b) on March 7, 2006. Petitioner's representative subsequently filed the present petition, seeking the revival of this expired patent. Due to the request for a refund of the maintenance fees, at least a portion of the period of delay was intentional.

Petitioner's representative has now asserted that the payment was timely submitted

With the original petition, Petitioner's representative asserted that the 3-½ year maintenance fee was not submitted. Petitioner's representative now asserts that the payment was indeed submitted, however due to a clerical error on the maintenance fee transmittal form, the maintenance fee was applied to the incorrect patent - as such, Petitioner's representative would have the Office treat this renewed petition as a petition under 37 C.F.R. §1.377⁷.

4 Original petition, page 5.

5 Exhibit C.

6 Petitioner's representative made similar requests with the patents associated with application numbers 07/110,452, 07/430,132, 07/641,681..

7 Renewed petition under 37 C.F.R. §1.377 for 08/432,901, pages 2-3.

Petitioner's representative has included a copy of the maintenance fee transmittal form which was included with the 3-½ year submission, and the patent number, which should have been listed as 5493296, was listed as 5,493,901. Therefore, the maintenance fee was applied to the wrong patent, per the instructions of Cooper and Dunham. Petitioner's representative asserts that the 3-½ year maintenance fee was received by the Office on August 20, 1999, and refunded to Cooper and Dunham's deposit account on August 23, 1999. Petitioner's representative has further included a copy of the August 1999 deposit account statement which was mailed by the Office, and the refund appears associated with patent number 5,493,901.

On page 9 of this renewed petition, Petitioner's representative has asserted that this petition was filed in a timely manner, but such is not the case. Petitioner's representative has asserted that the Office's failure to accept the 7-½ year maintenance fee did not - and would not in the ordinary course of business - come to the firm's attention, as debits and credits to the firm's Deposit Account are reported in monthly statements, are entered by the firm's accounting department, and nobody reviews these charges and refunds⁸.

It is unfortunate that no member of the law firm reviews these statements, for petitions under 37 C.F.R. §1.377 must be filed within **two months** of the action complained of, pursuant to section (b) of this portion of the C.F.R. As the maintenance fee submission was refunded to the law firm on August 23, 1999, Petitioner's representative had until October 23, 1999 to submit this petition. Therefore, Petitioner's representative's request is not timely, and **cannot be considered by this Office.**

Petitioner's representative has asserted that it had no way of knowing which patent this refund was associated with. On page 9 of the petition, Petitioner's representative states:

Charges and refunds to the firm's deposit account are reported by the USPTO to the firm's accounting department in lengthy monthly statements and are simply entered by the accounting department as charges and credits in the computerized billing records of the clients to whom they pertain. Accounting department personnel are not trained, nor is the accounting department procedure

⁸ Renewed petition under 37 C.F.R. §1.377 for 08/432,901, page 9.

structured to provide information regarding deposit account refunds to the docket system or other firm employees for non-accounting purposes.

In short, the firm's employees did not realize the significance of this refund, because nobody examines the monthly statements. On page 4 of this petition, Petitioner's representative explains that "consultation with docket department personnel is conducted solely for the purpose of obtaining information by the accounting department as to client and docket numbers." If this is an accurate statement, it seems that when the accounting department came across a refund associated with a patent number they did not recognize, and there is no docket number listed, standard protocol would have directed the accounting department to consult with the docket department personnel. Petitioner's representative has not addressed why this office procedure was not implemented in the present situation.

On page 2 of this petition, Petitioner's representative states "in consequence of the aforementioned clerical error it was impossible for the firm's accounting department to associate the refund with any client file or patent for which the firm was responsible." It is noted that the maintenance fee transmittal form has a certificate of mailing dated August 17, 1999, and the account statement which contains the refund information has a mail date of just two weeks later - August 31, 1999. Petitioner's representative has not explained what prevented the firm from going back and checking the maintenance fee transmittal forms which had been submitted that month, to determine the origin of this unknown docket number.

In paragraph 5 of her statement which accompanied this petition, Ms. Farnacci adds that since the docket number does not appear on the monthly statement, "it was not possible to correlate that (docket) number with any client or docket number; hence the credit was never entered on any billable record."

Had Petitioner's representative taken the time to review the transmittal forms to determine the origin of this docketing number, it is probable that this docket number would have been correlated with the present patent, and this petition would have been filed in 1999. But such is not the case.

Summary

At least a portion of the period of delay was intentional.

The present petition was not submitted in a timely manner, and as such, cannot be considered by this Office.

Conclusion

The prior decision which refused to accept, under 37 C.F.R. §1.378(b), the delayed payment of the maintenance fees for this patent, was based on Petitioner's representation that a maintenance fee had not been timely proffered to the Office. With this renewed petition, Petitioner has asserted that the payment was timely submitted, however this renewed petition cannot be considered. For the above stated reasons, the delay in these cases 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's representative is entitled to a refund of the surcharge and maintenance fees, but not the \$400 fee associated with the filing of the present renewed petition under 37 C.F.R. §1.378(e). These fees will be refunded to Petitioner's representative's Deposit Account in due course.

Telephone inquiries regarding *this decision* should be directed to the Senior Attorney Paul Shanoski at (571) 272-3225⁹. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office

⁹ Petitioner's representative 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's representative is reminded that no telephone discussion may be controlling or considered authority for Petitioner's representative's further action(s).