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**OFFICE OF PETITIONS**

In re Patent of :  
Gunderson et al. :  
Patent No. 5,439,000 :  
Issue Date: 08/08/1995 : DECISION  
Application No.: 08/154289 : ON PETITION  
Filing or 371(c) Date: 11/18/1993 :  
Title of Invention: :  
METHOD OF DIAGNOSING TISSUE :  
WITH GUIDEWIRE :

This is a decision on the petition under 37 CFR § 1.378(b), to reinstate the above-identified patent, filed May 26, 2007, and on the responses to requirements for information filed July 11, 2008 and June 21, 2010.

The petition is **DENIED**.

This decision is a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review.

Background

The patent issued August 8, 1995. Patentee could have paid the seven and one half (7½) year maintenance fee between August 8, 2002, and February 8, 2003, without a surcharge, or within the six (6) month grace period between February 9, 2003 and August 8, 2003. Patentee failed to do so; accordingly, the patent became expired on August 9, 2003.

The May 25, 2007 petition

Petitioner/Patentee filed a petition to reinstate the above-identified patent on May 26, 2007, and explained that the assignee of the patent was in bankruptcy proceedings at the time the payment of the maintenance fee was due. Patentee asserted that the bankruptcy court appointed a Trustee who had the duty to pay the maintenance fee, and that the Trustee represented to the bankruptcy court that the maintenance fee had indeed been paid. In support of this assertion, Patentee filed copies of what are putatively a Trustee's Disclosure Statement and Exhibits. None of the

documents were executed, and none of the documents contained any indicia that they were actually filed with the bankruptcy court (i.e. date-stamped as received by the court).

#### The September 25, 2007 Decision dismissing the petition

The petition was dismissed in a Decision mailed September 25, 2007. The Decision noted that a review of the copy of the "Trustees Disclosure Statement" revealed that the document was unexecuted and contained no indication that the document was filed with the court or otherwise accepted by the court. Also, the copy of the "Trustees Disclosure Statement" provided specifically disclaimed its use "for any other purpose other than to determine whether to vote in favor of or against the Plan, and nothing contained herein shall constitute an admission of any fact or liability of any party, or be admissible in any proceeding involving the debtor or any other party...."

Moreover, Petitioner failed to prove that the delay in paying the maintenance fee was unavoidable. Petitioner had not presented any evidence to support a finding that 1) the patent was found to have sufficient value to justify payment of the maintenance fee; 2) a decision was made to pay the maintenance fee, and the failure to timely pay the maintenance fee was unavoidable. The decision noted that 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 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent, and where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

The Decision explained that an adequate showing that the delay in paying the maintenance fee was unavoidable requires a showing that 1) the patent was found to have sufficient value to justify payment of the maintenance fee; 2) a decision was made to pay the maintenance fee, and the failure to timely pay the maintenance fee was unavoidable.

The Decision required statements of fact from persons with firsthand knowledge of the facts surrounding the decision to pay the maintenance fee. The Decision noted that Court documents evidencing intent to pay the maintenance fee may suffice. Petitioner was reminded that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable.

#### The renewed petition filed March 25, 2008

Petitioner/Patentee filed a renewed petition on March 25, 2008 and reiterated that the bankruptcy trustee represented to the bankruptcy court that the seven and one half (7½) year maintenance fee had been paid. Petitioner stated that the Trustee provided the bankruptcy court with a Disclosure Statement that indicated that the Trustee had paid the seven and one half (7½) year maintenance fee, which indicates that the patent was found to have sufficient value to justify payment of the maintenance fee.



As evidence that the Trustee Disclosure Statement was filed with the court, Petitioner filed the Declaration of Jim Hitchin ("the Hitchin Declaration"), Chief Executive Officer and President of Spectrascience, Inc., assignee of the present patent. A review of the Hitchin Declaration revealed that Mr. Hitchin stated that to his knowledge, the Trustee Disclosure Statement was filed with and accepted by the court. Declaration at p.2.

### Analysis

A review of the copy of the Trustee Disclosure Statement filed with the petition on May 25, 2007, revealed that the present patent was listed in Exhibit "C," dated February 13, 2004. A review of Exhibit "C" revealed that it is a spreadsheet, the header of which reads "Mackall, Crouse & Moore, PLC." As such, it appears that the copy of the Trustee Disclosure Statement, filed as evidence that the Trustee provided the bankruptcy court with a Disclosure Statement that indicated that the Trustee had paid the seven and one half (7½) year maintenance fee, was prepared by Mackall, Crouse & Moore, PLC. The Trustee Disclosure Statement stated that both the three and one half (3½) and the seven and one half (7½) year maintenance fees were paid.

Petitioner had provided evidence that putatively indicates that the Trustee was responsible for payment of the maintenance fee after the filing of the bankruptcy August 9, 2002; however, the evidence was unexecuted, and appears to have been prepared by a party to the proceedings. There was no evidence from the bankruptcy court that the Trustee accepted the Trustee Disclosure Statement. Moreover, Petitioner has not provided any evidence that 1) the patent was found (by the Trustee) to have sufficient value to justify payment of the maintenance fee; 2) that a decision was made (by the trustee) to pay the maintenance fee, and the failure to timely pay the maintenance fee was unavoidable.

### Requirement for Information mailed May 8, 2008

A requirement for information was mailed May 8, 2008. The Office required 1) clarification by Petitioner as to whether the copy of the Trustee Disclosure Statement filed with the petition on May 25, 2007 was prepared by counsel representing the assignee in the bankruptcy proceeding. What was also required was a showing that 1) the patent was found to have sufficient value to justify payment of the maintenance fee, and that a decision was made to pay the maintenance fee, and the failure to timely pay the maintenance fee was unavoidable.

As stated in the Decision dismissing the petition, mailed September 25, 2007, statements of fact from persons with firsthand knowledge of the facts surrounding the decision to pay the maintenance fee are required. Court documents that evidence the intent to pay the maintenance fee may suffice. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. (Emphasis supplied).

### Petitioner's Reply to Required Information mailed May 8, 2008

Petitioner filed a reply to the requirement for information on July 11, 2008, and included an executed copy of the Joint Disclosure Statement that was filed with the United States Bankruptcy Court. Petitioner provided that the Joint Disclosure Statement was prepared by counsel for

SpectraScience, the assignee of the present patent. Also attached was a copy of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004.

Petitioner reiterated that the delay in paying the maintenance fee was unavoidable since the assignee took reasonable care to ensure that the maintenance fee would be timely paid. Patentee again averred that the Trustee had the duty to preserve SpectraScience's intellectual property rights, which included payment of the maintenance fee. Petitioner reiterated that because the present patent was explicitly included in the list of patents owned by the debtor SpectraScience and the Trustee's list of duties included the preservation of these patents, it could reasonably be inferred that a decision was made that the present patent was found to have sufficient value to justify payment of the maintenance fee.

### Analysis

On August 9, 2003, the present patent expired for failure to pay the 7.5 year maintenance fee. The Bankruptcy Court's Order and Notice, approving the Joint Disclosure Statement, was executed on May 18, 2004. Petitioner provided that Mr. Jim Hitchin was appointed Chief Executive Officer and President of SpectraScience, as evidenced by the Trustee's Disclosure Statement, page 25. Original Petition at p.3. Petitioner provided further that pursuant to the opening of the 11.5 year fee window, Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, and that "Mr. Hitchin then discovered that the '000 patent was abandoned for failure to pay the 7.5 year maintenance fee."

In view of the disclosure that the Joint Disclosure Statement was prepared by counsel for SpectraScience, the assignee of the present patent, and to determine whether the entire delay, from the time the maintenance fee payment was due, to the filing of a grantable petition was unavoidable, a second requirement for information was mailed

### Requirement for Information mailed April 21, 2010

A second requirement for information was mailed April 21, 2010. Petitioner was reminded that a grantable petition pursuant to 37 CFR 1.378(b) must be accompanied by a showing that the entire delay, from the time the patent expired, to the filing of a grantable petition, was unavoidable.

The Office required information as to the following:

- 1) When did Mr. Hitchin begin investigating the process for payment of the 11.5 year maintenance fee??
- 2) Who was the party responsible for payment of the 7.5 year maintenance fee from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to the time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee?



3) What steps did the person responsible for payment of the 7.5 year maintenance fee from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, take to ensure timely payment of the maintenance fee?

4) What steps did SpectraSciences, Inc. have in place to ensure timely payment of the 7.5 year maintenance fee?

Petitioner's Reply to Required Information mailed April 21, 2010

Petitioner files the present reply to the second requirement for information and in response to the question as to when Mr. Hitchin began investigating the process for paying the maintenance fee, Petitioner provides that Mr. Hitchin began the process in February 2007.

In response to the question of who was responsible for paying the 7.5 year maintenance fee, from the time of the fee from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to the time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, Petitioner provides that the responsible party was SpectraScience, Inc.

In response to the question of what steps did SpectraSciences, Inc. have in place to ensure timely payment of the 7.5 year maintenance fee, from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, take to ensure timely payment of the maintenance fee, Petitioner provides that SpectraScience retained the intellectual property law firm of Fish & Richardson to manage its patent portfolio, including due dates for maintenance fees, and that Fish & Richardson notified SpectraScience of the opening of the payment window for the 11.5 year maintenance fee.

In response to the question of what steps did SpectraSciences, Inc. have in place to ensure timely payment of the 7.5 year maintenance fee, Petitioner provides that the Trustee of the bankruptcy proceedings was responsible for payment of the 7.5 year maintenance fee.

**Applicable Law, Rules and MPEP**

35 U.S.C. § 41(c)(1) states:

The Commissioner may accept the payment of any maintenance fee required subsection (b) of this section which is made within twenty-four months after the six-month grace period if this delay is shown to the satisfaction of the Commissioner to have been unintentional, or at any time 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) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) 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.

37 CFR 1.378(b)/(C) requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required 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. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As 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)). *See* MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788.

That is, 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 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was unavoidable, but only an explanation as to why petitioner has failed to carry the burden to establish that the delay was unavoidable. *Cf. Commissariat A. L’Energie Atomique v. Watson*, 274 F. 2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960) (35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was unavoidable, but only to explain why applicant’s petition was unavailing). Petitioner is reminded that it is the patentee’s burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee



is unavoidable. See, 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); Ray v. Lehman, supra.

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, supra. See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). 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, evidence 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, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). 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 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, Petitioner should note that a breakdown of communication between the party responsible for payment of the maintenance fee and their client is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

### Opinion

Petitioner's arguments and evidence have been considered.

### Review of the record

The patent became expired on August 9, 2003 for failure to pay the 7.5-year maintenance fee.



Petitioner, however, reiterated that the delay in paying the maintenance fee was unavoidable since the assignee took reasonable care to ensure that the maintenance fee would be timely paid. Petitioner again averred that the Trustee had the duty to preserve SpectraScience's intellectual property rights, which included payment of the maintenance fee. Petitioner reiterated that because the present patent was explicitly included in the list of patents owned by the debtor SpectraScience and the Trustee's list of duties included the preservation of these patents, it could reasonably be inferred that a decision was made that the present patent was found to have sufficient value to justify payment of the maintenance fee.

In response to Petitioner's assertions, and in an effort to determine what, if any, steps Petitioner undertook to pay the maintenance fee after receiving the Bankruptcy Court's Order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, and to determine whether the entire delay, from the time the maintenance fee payment was due, to the filing of a grantable petition was unavoidable, a second requirement for information was mailed.

In response to the second requirement for information, Petitioner provides that the responsible party for paying the 7.5 year maintenance fee, from the time of the fee from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to the time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee was SpectraScience, Inc. Jim Hitchin was Chief Executive Officer and President of SpectraScience, Inc., assignee of the present patent.

Mr. Hitchin, however, did not begin investigating the process for paying the maintenance fee until February 2007. Pursuant to the opening of the 11.5 year fee window, Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, and that "Mr. Hitchin then discovered that the '000 patent was abandoned for failure to pay the 7.5 year maintenance fee." Original Petition at p.3.

In response to the question of what steps did SpectraScience, Inc. have in place to ensure timely payment of the 7.5 year maintenance fee, from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to the time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, take to ensure timely payment of the maintenance fee, Petitioner provides that SpectraScience retained the intellectual property law firm of Fish & Richardson to manage its patent portfolio, including due dates for maintenance fees, and that Fish & Richardson notified SpectraScience of the opening of the payment window for the 11.5 year maintenance fee.

### Analysis

Petitioner's initial assertion was that the Trustee represented to the bankruptcy court that the maintenance fee had indeed been paid, was putatively evidenced by the Trustee's Disclosure Statement and Exhibits. However, it is worth noting at this point that the Trustee's Disclosure Statement "constitutes the Debtor's Plan of Reorganization, pursuant to which the Debtor proposes to be bound upon court approval of same." Trustee's Disclosure Statement Article X, Conclusion. Moreover, as Petitioner provided, it was counsel representing SpectraScience, the



assignee of the present patent, who prepared the Trustee's Disclosure Statement, which stated that the seven and one half (7½) year maintenance fee had been paid.

Petitioner fails to account for this misstatement. Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. Here, the Trustee's Disclosure Statement, prepared by counsel representing Petitioner herein, stated to the Bankruptcy Trustee that the seven and one half (7½) year maintenance fee had been paid.

In response to this disclosure, Petitioner reiterated that the delay in paying the maintenance fee was unavoidable since the assignee took reasonable care to ensure that the maintenance fee would be timely paid. Petitioner again averred that the Trustee had the duty to preserve SpectraScience's intellectual property rights, which included payment of the maintenance fee. Petitioner reiterated that because the present patent was explicitly included in the list of patents owned by the debtor SpectraScience and the Trustee's list of duties included the preservation of these patents, it could reasonably be inferred that a decision was made that the present patent was found to have sufficient value to justify payment of the maintenance fee.

However, it is not reasonable to expect the Bankruptcy Trustee to preserve SpectraScience's intellectual property rights regarding the present patent, which SpectraScience represented to the Bankruptcy Trustee had been preserved.

Moreover, the September 25, 2007 Decision noted that 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 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent, and where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In response to the question of what steps did SpectraSciences, Inc. have in place to ensure timely payment of the 7.5 year maintenance fee, from the time of the Bankruptcy Court's Order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, take to ensure timely payment of the maintenance fee, Petitioner provides that SpectraScience retained the intellectual property law firm of Fish & Richardson to manage its patent portfolio, including due dates for maintenance fees, and that Fish & Richardson notified SpectraScience of the opening of the payment window for the 11.5 year maintenance fee.

Petitioner does not state when SpectraScience retained the intellectual property law firm of Fish & Richardson to manage its patent portfolio. Again it is noted that Petitioner bears the burden of proof that the entire delay in paying the maintenance fee was unavoidable.

Further to this, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962);

Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a).

Petitioner represented that the 7.5-year maintenance fee had been paid, however, as stated supra, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

As to Petitioner's accounting for the entire delay, Petitioner was reminded in the second requirement for information that a grantable petition pursuant to 37 CFR 1.378(b) must be accompanied by a showing that the entire delay, from the time the patent expired, to the filing of a grantable petition, was unavoidable.

In response to the second requirement for information, Petitioner provides that the responsible party for paying the 7.5 year maintenance fee, from the time of the fee from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to the time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee was SpectraScience, Inc. Jim Hitchin was Chief Executive Officer and President of Spectrascience, Inc., assignee of the present patent.

Mr. Hitchin, however, did not begin investigating the process for paying the maintenance fee until February 2007. Pursuant to the opening of the 11.5 year fee window, Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee, and Petitioner provided that "Mr. Hitchin then discovered that the '000 patent was abandoned for failure to pay the 7.5 year maintenance fee." Original Petition at p.3.

Petitioner has, in addition to failing to explain why the Patentee's representative stated to the Bankruptcy Trustee that the 7.5-year maintenance fee for the present patent had been paid when in fact the maintenance fee had not been paid, has also failed to account for the delay from the time of the Bankruptcy Court's order and Notice, approving the Joint Disclosure Statement, executed on May 18, 2004, to the time Mr. Hitchin began investigating the process for payment of the 11.5 year maintenance fee in February of 2007.

As stated supra, 35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was unavoidable, but only an explanation as to why petitioner has failed to carry the burden to establish that the delay was unavoidable, and where, as here, the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).



**Decision**

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of March 25, 2008 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight  
Director  
Office of Petitions