



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. 17

WILLIAM L CHAPIN
8732 SQUIRES CIRCLE
HUNTINGTON BEACH CA 92646

MAILED

NOV 10 2010

OFFICE OF PETITIONS

DECISION ON PETITION

In re Patent No. 5,900,996 :
Issue Date: May 4, 1999 :
Application No. 08/708,290 :
Filed: September 4, 1996 :
Title: Variable Magnification Mirror :

This is a decision on the renewed petition under 37 CFR 1.378(b), filed December 22, 2009, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

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. See MPEP 1002.02.

Procedural History:

- The above-identified patent issued on May 4, 1999.
- The second maintenance fee could have been timely paid during the period from May 4, 2006 through November 4, 2006, or with a late payment surcharge during the period from November 5, 2006 through May 4, 2007.
- No maintenance fee having been received, the patent expired on May 5, 2007.
- The twenty-four month period for filing a petition to accept the unintentionally delayed payment of the maintenance fee expired on May 4, 2009.
- Patentee filed a petition to accept the unavoidably delayed payment of the maintenance fee under 37 CFR 1.378(b) on June 15, 2009.
- The petition was dismissed in a decision mailed on October 26, 2009.
- Patentee filed the instant request for reconsideration on December 22, 2009.

Relevant Statutes, Rules and Regulations:

35 U.S.C. §41(c)(1) states that:

The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. §1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in §1.20(e) through (g);
- (2) The surcharge set forth in §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.

Opinion:

§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 35 U.S.C. 133. 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. In addition, decisions are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute “unavoidable” delay. See id.; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); 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 (1891).

June 15, 2009 Petition and October 26, 2009 Dismissal:

In the petition filed June 15, 2009, petitioner attributed the unavoidable delay to a computer crash that occurred in January of 2007. Petitioner used a spreadsheet that tracks the due date of maintenance fees for patents issued to the inventor based on the issue date of the patent. However, the petition was dismissed in a decision mailed on October 26, 2009. The decision pointed out that there was no explanation as to how the spreadsheet works or the procedure by which a person ensures the timely payment of the maintenance fee through the information provided by the spreadsheet. In addition, the decision requested that petitioner discuss any back-up systems in place, or if no back-up system existed, why the use of one computer based system constituted reasonable care. Lastly, the decision noted that the inventor timely paid maintenance fees in other patents during the period between May 4, 2007 and May 10, 2009. The decision requested that petitioner explain how he was able to timely pay the maintenance fees in these patents, and why the delayed payment of the maintenance fee in the instant patent was unavoidable.

Instant Renewed Petition:

With the instant request for reconsideration, petitioner explains that the spreadsheet is maintained by petitioner's executive assistant, but is stored on a shared drive to facilitate access by both parties. According to petitioner, each party would access the spreadsheet on a monthly basis, and whoever first observed on the spreadsheet the opening of a maintenance fee payment window for a patent would note the opening date, and generate a tickler file that continued to flag the due date on a monthly basis until payment was made. With respect to a back-up system, petitioner notes he added the maintenance fee payment schedule data to his Microsoft Outlook calendar. However, petitioner did not become aware of the expiration of the instant patent until May 11, 2009, when he called his attorney to discuss a possible infringement.

With respect to petitioner's explanation as to how he was able to timely pay maintenance fees in other patents between May 4, 2007 and May 10, 2009, petitioner explains that the computer crash of the type that occurred in this instance is “inherently a stochastic event”, and “therefore which data is lost as a consequence of such a crash is random and unpredictable.” Petitioner states that because of the random nature of such a computer crash, “it is impossible to ascertain with certitude why the maintenance fee data for six patents was recovered while that for [the instant patent] was lost”. Petitioner has not shown that he has exercised the due care of a reasonable and prudent person with respect to his most important business, his patent. Petitioner has not carried the burden of proof with respect to the showing of unavoidable delay. Petitioner, further, is not

able to provide an explanation as to why he was able to timely pay the maintenance fee data for the six other patents, but not the instant patent. Furthermore, when petitioner's computer crashed in January of 2007, such an event would have prompted a prudent person to make sooner inquiry of the status of his patents and fee payment schedules from the USPTO. The record does not disclose that such an inquiry took place in this instance.

Conclusion:

The prior decision which refused to accept under 37 C.F.R. § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b). As stated in 37 C.F.R. § 1.378(e), no further reconsideration or review of this matter will be undertaken.

Since this patent will not be reinstated, the \$2005 submitted by petitioner for the maintenance fee and surcharge are being refunded under separate cover. The \$400 fee for requesting reconsideration is not refundable.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this communication should be directed to Petitions Attorney Cliff Congo at (571)272-3207.



Anthony Knight
Director
Office of Petitions

cc: Zlatko Zadro
5422 Argosy Dr
Huntington Beach, CA 92649