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**OFFICE OF PETITIONS
A/C PATENTS**

ON PETITION

In re Patent No. 4,858,763
Issue Date: August 22, 1989
Application No. 07/180,238
Filed: April 11, 1988
Patentee: Ronnie E. Scott

This is a decision on the petition filed August 26, 1996, which is being treated as a petition under 37 CFR 1.183 to waive the two (2) month filing period requirement in 37 CFR 1.378(e), and under 37 CFR 1.378(b), or, in the alternative, 1.378(c), to accept late payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378 to accept late payment of the maintenance fee for the above-identified patent is **DENIED**.

BACKGROUND

The above-identified patent issued on August 22, 1989. Therefore, the first maintenance fee could have been paid during the period from August 24, 1992 (August 22, 1992 being a Saturday) through February 22, 1993, or with a surcharge during the period from February 23, 1993 through August 23, 1993 (August 22, 1993 being a Sunday). The first maintenance fee for the above-identified patent, however, was not timely submitted. Accordingly, the above-identified patent expired at midnight on August 22, 1993. See MPEP 2506.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee for the above-identified patent was filed on June 27, 1995. The petition under 37 CFR 1.378(b) of June 27, 1995 was dismissed in the decision of September 28, 1995, which decision advised petitioner that any petition for reconsideration under 37 CFR 1.378(e) must be filed within two (2) months of the mail date of the decision of September 28, 1995. The instant

petition was filed on August 26, 1996, and requests waiver of two (2) month filing period requirement in 37 CFR 1.378(e) pursuant to 37 CFR 1.183, and acceptance of a late payment of maintenance fee for the above-identified patent pursuant to 37 CFR 1.378.

STATUTE AND REGULATION

35 U.S.C. § 6 provides, in part, that

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C § 41(c (1 provides that

The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the 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 Commissioner to have been unavoidable. The Commissioner may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Commissioner accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 CFR 1.183 states that:

In an extraordinary situation, when justice requires any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)

37 CFR 1.378 provides that:

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the

maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

(1) The required maintenance fee set forth in § 1.20(e)-(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.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:

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

(2) The surcharge set forth in § 1.20(i)(2); and

(3) A statement that the delay in payment of the maintenance fee was unintentional.

(d) Any petition under this section 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. Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two-months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any

such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

OPINION

With regard to the petition under 37 CFR 1.183 to waive the two (2) month filing period requirement in 37 CFR 1.378(e):

Petitioner asserts, as an "extraordinary situation" in which "justice requires" a waiver of the two-month period in 37 CFR 1.378(e), that: (1) petitioner is a *pro se* patentee lacking a familiarity with patents and patent practice; (2) petitioner contacted the Patent and Trademark Office (PTO) in June of 1995 to obtain information concerning the procedures for reinstating an expired patent; (3) upon receipt of such information, petitioner filed a petition under 37 CFR 1.378(b) (*i.e.*, an "unavoidable" petition) to reinstate the above-identified patent, which was dismissed in the decision of September 28, 1995; (4) petitioner was advised by the PTO during a discussion of the decision of September 28, 1995 that there was little chance that the above-identified patent would be reinstated; and (5) petitioner was advised by the PTO during a discussion in May of 1996 that a petition under 37 CFR 1.378(c) (*i.e.*, an "unintentional" petition) filed in June of 1995 would have been granted.

The circumstances set forth by petitioner do not constitute an "extraordinary situation" in which "justice requires" a waiver of the two-month period in 37 CFR 1.378(e). The decision of September 28, 1995 specifically advised petitioner that:

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such

petition for reconsideration must be accompanied by the petition fee of \$130 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted above, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

While a lack of familiarity with patents and patent practice on the part of a *pro se* patentee might excuse a lack of knowledge of the requirement in 37 CFR 1.378(e) that any reconsideration of a decision refusing to accept a maintenance fee must be filed within two-months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee, the decision of September 28, 1995 specifically advised petitioner of this requirement of 37 CFR 1.378(e). Thus, petitioner's lack of familiarity with patents and patent practice cannot excuse petitioner's failure to request reconsideration of the decision of September 28, 1995 within the period expressly stated in such decision.¹

Petitioner's argument that a petition under 37 CFR 1.378(c) (*i.e.*, an "unintentional" petition) filed in June of 1995 may have been granted is likewise irrelevant. Petitioner acknowledges receipt in June of 1995 of information concerning the procedures for reinstating an expired patent, and does not contend that such information failed to advise petitioner of the procedures or time period requirement for filing a petition under 37 CFR 1.378(c) to reinstate an expired patent. It was petitioner who chose to file only a petition under 37 CFR 1.378(b) (*i.e.*, an "unavoidable" petition), rather than a timely petition under 37 CFR 1.378(c) (*i.e.*, an "unintentional" petition), in June of 1995 to reinstate the above-identified patent. Thus, petitioner must accept the consequences of his decision to not timely file a petition under 37 CFR 1.378(c) to reinstate the above-identified patent, and petitioner's failure to file a timely petition under 37 CFR 1.378(c) to reinstate the

¹ The PTO's failure to promptly refund the maintenance fee and surcharge upon the expiration of the two-month period in 37 CFR 1.378(e) for requesting reconsideration of the decision of September 28, 1995 is regretted. There is, however, no causal relationship between the PTO's failure to promptly refund the maintenance fee and surcharge upon the expiration of the two-month period in 37 CFR 1.378(e) for requesting reconsideration of the decision of September 28, 1995 and petitioner's failure to file a timely request for reconsideration of the decision of September 28, 1995.

above-identified patent does not constitute an "extraordinary situation" in which "justice requires" a waiver of the two-month period in 37 CFR 1.378(e).

It appears that the delay in filing the instant petition for reconsideration was due to petitioner's decision to discontinue seeking reinstatement of the above-identified patent, in that subsequent to petitioner's discussion of the decision of September 28, 1995 with the PTO, petitioner's interests turned to obtaining a refund of the maintenance fee and surcharge submitted with the petition of June 27, 1995 (declaration of Ronnie F. Scott (Scott) at 3). It is argued that "it would be an injustice to prevent [petitioner] from presenting his petition for reconsideration" (petition of August 26, 1996 at 3). The PTO (or 37 CFR 1.378(e)), however, did not "prevent" petitioner from filing a timely petition under 37 CFR 1.378(e) for reconsideration of the decision of September 28, 1995. Petitioner simply chose not to file a timely petition under 37 CFR 1.378(e) for reconsideration of the decision of September 28, 1995.

It is brought to petitioner's attention that a delay caused by a deliberate decision not to either seek or persist in seeking the reinstatement of an expired patent cannot be considered an "unintentional" delay within the meaning of 37 CFR 1.378(c) or an otherwise excusable delay under 37 CFR 1.183. Cf. Notice of Proposed Rulemaking "1996 Changes to Patent Practice and Procedure," 61 Fed. Reg. 49819, 49833 (September 23, 1996), reprinted in 1191 Off. Gaz. Pat. Office 105, 116 (October 22, 1996) ("where the applicant deliberately chooses not to either seek or persist in seeking the revival of an abandoned application, the resulting delay in seeking revival of the application cannot be considered "unintentional" within the meaning of 37 CFR 1.137" and "[t]he correctness or propriety of the rejection, or other objection, requirement, or decision, by the Office, the appropriateness of the applicant's decision to abandon the application or to not seek or persist in seeking revival, or the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival, are immaterial to such intentional delay caused by the deliberate course of action chosen by the applicant"). Assuming, *arguendo*, that the circumstances at issue otherwise justified waiver of the two-month period in 37 CFR 1.378(e), the delay resulting from petitioner's decision to discontinue seeking reinstatement of the above-identified patent would militate against granting such waiver.

With regard to the petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee for the above-identified patent:

As the language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133. 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*, 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)). Decisions on reviving abandoned applications 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. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)); see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). The requirement in 35 U.S.C. § 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive. See In re Application of Takao 17 USPQ2d 1155 (Comm'r Pat. 1990).² Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay

² See also the PTO *Official Gazette* at 1124 *Off. Gaz. Pat Office* 33 (March 19, 1991).

was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Assuming, ~~arguendo~~, that the circumstances at issue justified -- waiver of the two-month period in 37 CFR 1.378(e), petitioner has not carried his burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

As discussed in the decision of September 28, 1995, a 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 "Final Rules for Patent Maintenance Fees," 49 Fed. Reg. 34716, 34722-23 (Aug. 31, 1984), reprinted in 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and regulations, the PTO 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 PTO.

As 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. The record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee. In fact, the record indicates that no steps were taken by patentee to ensure timely payment of the maintenance fee. Since no steps were taken by patentee, 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee for the above-identified patent under 37 CFR 1.378(b).

With regard to the petition under 37 CFR 1.378(c) to accept late payment of the maintenance fee for the above-identified patent:

Assuming, *arguendo*, that the circumstances at issue justified waiver of the two-month period in 37 CFR 1.378(e), the salient point remains that no petition under 37 CFR 1.378(c) was filed within the twenty-four (24) month period specified in 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c). That is, the filing of a petition under 37 CFR 1.378(b) does not toll the twenty-four month period set forth in 37 CFR 1.378(c). Therefore, the fact that a petition under 37 CFR 1.378(b) was filed within the twenty-four (24) month period specified in 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c), and a petition under 37 CFR 1.378(c) was filed within the period set forth in 37 CFR 1.378(e) for requesting reconsideration of an adverse decision on the petition under 37 CFR 1.378(b) does not make the petition under 37 CFR 1.378(c) timely under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c).

The instant petition under 37 CFR 1.378(c) was filed more than thirty-six (36) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) and more than ten (10) months after a decision on the previous petition 37 CFR 1.378 to reinstate the above-identified patent. Assuming, *arguendo*, the petition filed on June 27, 1995 could be construed as an informal petition under 37 CFR 1.378(c),³ to first construe a petition clearly designated as a petition under 37 CFR 1.378(b) as a petition under 37 CFR 1.378(c), and then to accept it without the required surcharge under 37 CFR 1.20(i)(2) would operate as an abuse of the twenty-four (24) month period specified in 35 U.S.C. § 41(c)(1).

The instant petition under 37 CFR 1.378(c) was not filed within the twenty-four (24) month period specified in 35 U.S.C. § 41(c)(1). Therefore, the instant petition under 37 CFR 1.378(c) to accept the delayed payment of a maintenance fee for the above-identified patent is untimely. See 37 CFR 1.378(c).

³ While the petition of June 27, 1995 was filed using a standard PTO petition form, the PTO provides standard forms for both petitions under 37 CFR 1.378(b) (*i.e.*, an "unavoidable" petitions) and petitions under 37 CFR 1.378(c) (*i.e.*, an "unintentional" petitions), and it was petitioner who chose to file a petition using only the form for a petition under 37 CFR 1.378(b). In addition, there is nothing in the petition of June 27, 1995 that would otherwise indicate that petitioner was requesting reinstatement of the above-identified patent on any basis other than "unavoidable" delay (37 CFR 1.378(b)).

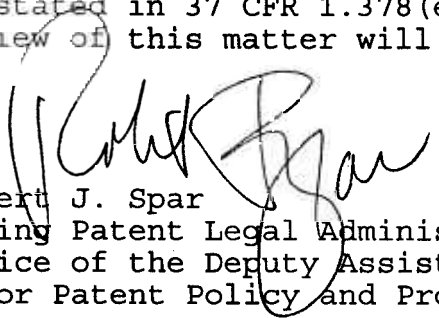
CONCLUSION

For the above stated reasons: (1) the petition under 37 CFR 1.183 is **DENIED** as there is no showing of an "extraordinary situation" in which "justice requires" a waiver of the two-month period in 37 CFR 1.378(e); (2) the petition under 37 CFR 1.378(b) is **DENIED** as the delay in payment of the maintenance fee for the above-identified patent cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41 and 37 CFR 1.378(b); and (3) the petition under 37 CFR 1.378(c) is **DENIED** as the petition under 37 CFR 1.378(c) is untimely under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c).

Since this patent will not be reinstated, the maintenance fee (\$495) and the surcharge fee (\$1550) submitted by petitioner will be refunded.

Telephone inquiries regarding this decision should be directed to the Office of Petitions Staff at (703) 305-9282.

As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.



Robert J. Spar
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