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In re Patent No. 5,390,462 :  
Issued: February 21, 1995 :  
Application No. 07/549,522 : ON PETITION  
Filed: July 6, 1990 :  
Docket No.: 17407-74457 :

**OFFICE OF PETITIONS**

This is a decision on the petition under 37 CFR 1.378(e), filed July 14, 2005.

The petition is **DENIED**<sup>1</sup>.

**BACKGROUND**

The patent issued February 21, 1995. The 3.5-year maintenance fee could have been paid from February 21, 1998 to August 21, 1998 without a surcharge or from August 22, 1998 to February 21, 1999 with a surcharge. The maintenance fee, however, was not submitted. Accordingly, the patent expired February 22, 1999 for failure to timely submit the 3.5-year maintenance fee.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed November 12, 2004 and dismissed May 12, 2005.

Robert A. Stanczuk, Executive Vice President for assignee, acted as a liaison with outside patent counsel and attended to patent related correspondence. Mr. Stanczuk received correspondence and the letters patent for the instant patent from patent counsel Leland P. Schermer in a letter dated February 23, 1995. Mr. Stanczuk was aware of the requirement to submit maintenance fee. Mr. Stanczuk communicated his receipt of the patent via telephone to Mr. Schermer wherein he informed Mr. Schermer to "note his files and records, to attend to the payment of any fees that would become due on the subject patent, in order to maintain it in force."

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

Mr. Stanczuk regularly verbally instructed patent counsel without engaging in written follow-up correspondence as it was not uncommon for he and patent counsel to refrain from written correspondence for extended periods. Thus, once instruction had been given to patent counsel, it would not be uncharacteristic for Mr. Stanczuk to hear nothing further regarding the instruction from patent counsel for extended periods of time.

Mr. Stanczuk became aware that the patent was expired after having engaged new patent counsel at which time, an investigation was undertaken and the instant petition submitted.

#### STATUTE AND REGULATION

35 U.S.C. 41(c)(1) states that:

"The Director may accept the payment of any maintenance fee required by subsection (b) of this section ... 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 C.F.R. § 1.378(b)(3) states that any petition to accept the delayed payment of a maintenance fee must include:

"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."

37 C.F.R. § 1.378(e) states in pertinent that:

"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(f). After the decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director."

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable."<sup>2</sup> Moreover, a late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, i.e., "unavoidable" delay<sup>3</sup>. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable<sup>4</sup>. Further, decisions on revival are made on a "case-by-case basis, taking all the fact and circumstances into account"<sup>5</sup>. Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay<sup>6</sup>.

The petition for reconsideration under 37 CFR 1.378(e) is not accompanied by any supporting documentation to establish that the entire period of time from the time that the maintenance fee was due until the filing of a grantable petition was unavoidable. Instead, petitioner advises of an intent to subsequently submit supporting documentation. To date, no such supplemental documentation has been submitted. As petitioner has failed to advance any additional arguments, and the petitioner's previously arguments were found unpersuasive, the holding on petition mailed May 12, 2005 must stand.

Accordingly, the record fails to establish that patentee took adequate steps to ensure timely payment of the maintenance fee as required by 37 CFR 1.378(b)(3). Since adequate steps were not taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee. Petitioner may request a refund of the surcharge and maintenance fee submitted with the instant petition by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

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<sup>2</sup> 35 U.S.C. 41(c)(1).

<sup>3</sup> See, Ray v. Lehman, 55 F3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

<sup>4</sup> See, Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "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 re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912), Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>5</sup> See, Smith v. Mossinghoff, 671 F.2d 533, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>6</sup> See, Haines v. Quigg, 673 F.Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

DECISION

The prior decision dismissing petition under 37 CFR 1.378(b) to accept delayed payment of maintenance fee has been reconsidered. For the reasons set forth herein the delay in payment of the maintenance fee cannot be regarded a unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b). Accordingly, the offer to pay the delayed maintenance fee will not be accepted and this patent will not be reinstated.

Petitioner may request a refund of the previously submitted fee of \$2,245.00 by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

This file is being forwarded to files repository.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Alesia M. Brown at 571-272-3205.

A handwritten signature in cursive script, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson  
Director  
Office of Petitions