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OFFICE OF PETITIONS

Patent No.: 6,047,420 :
Issue Date: April 11, 2000 : On Petition
Application No. 08/977,850 :
Filed: November 25, 1997 :
For: Axillary Prone Position Support System :

This is a decision on the petition under 37 CFR 1.378(e), filed on July 20, 2007, requesting reconsideration of a prior decision refusing to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(e) is **DENIED**.¹

BACKGROUND

The patent issued April 11, 2000. The 3.5 year maintenance fee could have been paid from April 11, 2003 to October 10, 2003, or with a surcharge during the period from October 11, 2003 to April 11, 2004. The maintenance fee was not submitted within this period. Accordingly, the patent expired at midnight on April 11, 2004.

A petition to accept the delayed payment of the maintenance fee pursuant to 37 CFR 1.378(b) was filed on November 29, 2006 and dismissed on May 22, 2007.

The petition filed July 20, 2007 requests reconsideration of the decision of May 22, 2007. The request for reconsideration is accompanied by a supplemental declaration of Roger Gehri.

Pursuant to petitioner's request, deposit account no. 50-2468 will be charged the \$400.00 petition fee.

STATUTES AND REGULATIONS

35 U.S.C. § 41 (c)(1) states that:

The Director may accept the payment of any maintenance fee

¹This 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.

required by subsection (b) of this section...after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

A petition under 37 CFR 1.378(b) 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 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

A petition under 37 CFR 1.378(b) for the acceptance of an unavoidably delayed payment of maintenance fee is considered under the same standard as that for reviving an application unavoidably abandoned under 37 CFR 1.137(a) because 35 U.S.C. § 41(c)(1) uses identical language, *i.e.*, "unavoidable" delay.² Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.³ In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."⁴ Finally, a petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁵

²Ray 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)).

³Ex 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 man in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁴Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982)(citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute unavoidable delay); Vincent v. Mossinghoff, 1985 U.S. Dist. Lexis 23119, 13 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs through their counsel's actions or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications).

⁵Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

The general standard applied by the Office requires petitioner to establish that the patentee or his successor in interest treated the patent the same as a reasonable and prudent person would treat his or her most important business.⁶ However, “[t]he question of whether an applicant’s delay in prosecuting an application was unavoidable [will] be decided on a case by case basis, taking all of the facts and circumstances into account.”⁷ Lack of knowledge of the content of, or misunderstanding of the patent statutes, rules, or the MPEP does not constitute unavoidable delay.⁸ The statute requires a “showing” by petitioner. Therefore, petitioner has the burden of proof.

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.⁹

PETITIONER’S ARGUMENT

Lou Priester III, the co-inventor/president of assignee corporation Proper Position, Inc., learned of the expiration of the above-identified patent on March 27, 2006. Throughout the prosecution of the patent application, Mr. Priester was the contact for attorney Veal. Upon receipt of maintenance fee reminders, attorney Veal attempted to contact Mr. Priester on January 28, 2003 and March 26, 2004. The final reminder notice was returned to attorney Veal’s office. After a search for an updated address for Mr. Priester was conducted, the final reminder was re-mailed to an address located via an Internet search. When attorney Veal failed to receive a reply from the three reminder letters, he assumed that there was no interest in maintaining the above-identified patent. Mr. Priester maintains that he never utilized the P.O. Box nor the address where the reminders were mailed.

Co-inventor Robert Morris assumed that the administrator for Reyina and Vitereous Associates of Alabama, LLC, Roger Gehri and attorney Veal would ensure that the maintenance fees would be timely submitted. Morris believed because Gehri served as the contact person for law firms handling other patent applications affiliated with inventor, he would also be responsible for the above-identified patent. Mr. Morris gave Mr. Gehri the patent and a copy of the Veal letter (April 18, 2000). Gehri traditionally had the responsibility to respond to all law firm correspondence and pay law firm invoices. However, Mr. Gehri maintains he did not have any contact with attorney Veal during the prosecution of this application. Nor did Mr. Gehri maintain

⁶ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard 35 U.S.C. 41(c)(1) states, “The Commissioner may accept the payment of any maintenance fee...at any time...if the delay is shown to the *satisfaction of the Commissioner* to have been unavoidable (emphasis added).

⁷ Smith, 671 F.2d at 538.

⁸ *Id.*

⁹ 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 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff’d, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913).

any corporate documents related to Proper Position, Inc., the assignee of record for the above-identified patent.

The supplemental declaration of Mr. Gehri provided on renewed petition seeks to show that Mr. Veal customarily mailed reminder notices with language that advised the client that they should maintain their own docketing system. Mr. Gehri says that he relied on Mr. Veal to send reminder notices and that Mr. Veal's docketing system worked without fail as evidenced by the fact that other patents remain in force because reminders to pay maintenance fees were sent by attorney Veal. Further Mr. Gehri insists the address for Proper Position, Inc was not the address where reminders were mailed and has remained the same since 1997.

Petitioner contends it was reasonable to rely upon attorney Veal to remind assignee when maintenance fees were due. The letters from attorney Veal which state that he would try and track maintenance fee reminders, but recommended setting up their own docketing system were just liability disclaimers. Petitioner maintains attorney Veal nonetheless sent reminders to petitioner, which were promptly paid through attorney Veal. It was reasonable for assignee to rely upon the docket system of attorney Veal.

APPLICATION OF THE UNAVOIDABLE STANDARD TO THE PRESENT FACTS

In general a grantable petition under 37 CFR 1.378 (b) must show 1) petitioner knew of the need to make the maintenance fee payment, 2) implemented a reliable docketing system to track the relevant dates 3) treated the payment of the maintenance fee (and later the filing of a petition to reinstate) as his most important business 4) was prevented from making the payment and 5) must show the entire delay in making the payment and submitting a grantable petition was unavoidable.

As previously indicated, petitioner has failed to establish that a reliable docketing system was implemented to track relevant dates. Petitioner insists that the docketing system utilized by attorney Veal was reliable. As evidence, petitioner contends three patents were in force as a result of reminder notices mailed by attorney Veal. The Office is not convinced that it was reasonable to rely upon attorney Veal, where he clearly informed assignee, he was not responsible for tracking maintenance fees. The fact that attorney Veal said he would make a good faith, reasonable effort to notify when the maintenance fee was due, does not supersede the statement that attorney Veal was not assuming responsibility for tracking the maintenance fees. Nor does the fact that attorney Veal provided reminder letters in other patents make the reliance solely on attorney Veal reasonable. Even if the statement provided in the maintenance fee reminders by attorney Veal was to avoid liability, assignee was on notice that responsibility to monitor the maintenance fees remained with the assignee. It appears, any reminders forwarded to the assignee from attorney Veal were courtesy notices not a reliable docketing system.

Assuming it was reasonable for the assignee to rely on the docketing system of attorney Veal, very little information has been provided about the docketing system in place. The declaration of attorney Veal provided with the first petition, stated that the docket system in place consisted of his docket paralegal reviewing reminders received from the USPTO or from Computer Patent Annuities ("CPA"). In the instant petition, attorney Veal states the docket paralegal, determined

the maintenance fee was due and this was confirmed by the reminder from CPA. There is no indication of the system, which would have informed attorney Veal the maintenance fee was due. A grantable petition requires an explanation of the docket system in place, such that a determination can be made as to whether the system was reliable and whether it was reasonable to rely on such system.

In addition, there was some confusion as to who was the contact person for attorney Veal. Mr. Morris believed Mr. Gehri was responsible for tracking and contacting attorney Veal. Whereas, Mr. Priester states that he was the contact person for this patent. Petitioner insists that the reminders mailed by attorney Veal were mailed to the incorrect address.

Nonetheless it is well established that a failure in communication between a client and his or her attorney does not constitute unavoidable delay. Petitioner Priester states in his declaration dated November 16, 2006 that the reminders were sent to an address that was not his. "I never had Post Office Box 70425 as an address in Montgomery, Alabama. In fact I never had any Post Office Box in Montgomery". This fact is not controverted by any other information of record. Therefore, it is considered that the reminders were incorrectly addressed. Such an error in the mailing of communications between attorney and client is not considered to be unavoidable error. Delay resulting from a lack of proper communication between an applicant and his representative as to the responsibility for timely filing a communication with the USPTO does not constitute unavoidable delay. See In re Kim, 12 USPQ2d 1595 (Comm'r Pat 1988); Ray v. Lehman 55 F.3d 606 at 610, 34 USPQ2d 1786 at 1789. Moreover, the USPTO is not the proper forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. A petitioner who is treating his patent as his most important business would have attempted to contact attorney Veal and/or administrator Gehri to ensure that appropriate action had been taken on petitioner's behalf. If it was determined attorney Veal had not handled the patent as petitioner desired, it is then petitioner's responsibility to either timely seek other counsel or submit the maintenance fee on petitioner's own behalf.

To the extent that attorney Veal failed to mail the reminders to the proper address, such mistake would not be deemed unavoidable delay. A delay resulting from an attorney's preoccupation with other legal matters or with the attorney's inadvertence or mistake is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 USC 151 and 37 CFR 1.378 Mossinghoff, 671 F.2d at 536. The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions.⁵ Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 or 37 CFR 1.137(a).⁶ Furthermore, petitioner is reminded that the Patent and

⁵Link v. Wabash, 370 U.S. 626, 633-34 (1962).

⁶Haines 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).

Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative.⁷

CONCLUSION

The prior decision which refused to accept under §1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

Since this patent will not be reinstated, a refund check covering the maintenance fees (\$455.00) and surcharge fee (\$700.00) will be forwarded to petitioner.

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

The application is being forwarded to Files Repository.

Telephone inquiries should be directed to Petitions Attorney Charlema R. Grant at (571) 272-3215.



Charles Pearson
Director
Office of Petitions

⁷Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).