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**OFFICE OF PETITION  
A/C PATENTS**

In re Patent No. 4,513,451 :  
Issue Date: April 30, 1985 :  
Application No. 06/468,584 : ON PETITION  
Filed: February 22, 1983 :  
Inventor: Michael A. Brown :

This is a decision on the petition under 37 CFR 1.378(e), filed February 21, 1997, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The request to accept delayed payment of the maintenance fee under 37 CFR 1.378(b) is DENIED.

BACKGROUND

The patent issued April 30, 1985. The first maintenance fee could have been paid from May 2, 1988 (April 30, 1988 being a Saturday), through October 31, 1988 (October 30, 1988 being a Sunday), or with a surcharge during the period from November 1, 1988, through May 1, 1989 (April 30, 1989 being a Sunday). Accordingly, the patent expired at midnight on April 30, 1989, for failure to timely submit the maintenance fee. See MPEP 2506.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on August 29, 1996, and was dismissed in the decision of December 17, 1996.

The instant petition under 37 CFR 1.378(e) requesting reconsideration of the decision of December 17, 1996 was filed on February 21, 1997. Accompanying the petition were: declarations by Michael A. Brown (petitioner) and James J. Brown (former counsel).

#### STATUTE AND REGULATION

35 U.S.C. § 41(c) (1) states that:

"The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section... after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable."

37 CFR 1.378(b) (3) states that any petition to accept 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."

#### OPINION

The Commissioner may accept late payment of the maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) if the delay is shown to the satisfaction of the Commissioner to have been

"unavoidable." 35 U.S.C. § 41(c)(1).

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. 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)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. 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, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). 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). 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. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner asserts that the delay in payment of the maintenance fee was unavoidable due to (1) petitioner's lack of awareness of the need to schedule and pay maintenance fees, (2) petitioner never received the letters patent from his registered practitioner, James J. Brown (JJBrown) (which letters patent includes a Notice regarding the need to pay maintenance fees), or the maintenance fee reminder letter from JJBrown, which, if mailed, was mailed to petitioner's former address, (3) about the time the patent issued, petitioner moved to a new location, and petitioner remains uncertain that petitioner provided JJBrown with petitioner's new address, (4) at about the same time, JJBrown changed his address, and (5) subsequent to issuance, petitioner had further communications with JJBrown with respect to obtaining a "soft copy" of the patent, and potential infringement of the patent, but the issue of maintenance fees was

not discussed. The petition is accompanied by exhibits and verified statements by petitioner, patentee Michael A. Brown (MABrown); petitioner's former counsel, JJBrown; and two exhibits.

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b)(3).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 608-609, 34 USPQ2d at 1787. It is the actions or inactions of the responsible party which are relevant to determining whether the maintenance fee payment was unavoidably delayed. It is solely the responsibility of the patentee to ensure that the maintenance fee is timely paid. However, the record shows that JJBrown had assumed the responsibility of tracking and scheduling payment of the maintenance fee, notwithstanding the asserted lack of awareness of petitioner of the need for maintenance fee payments. MABrown states "I relied completely on Mr. James J. Brown for attending to all aspects of the patent application and the patent" (February 27, 1997 declaration of MABrown, ¶ 1). JJBrown concurs that he was responsible for tracking and scheduling payment of the maintenance fee (February 27, 1997 declaration of JJBrown, ¶ 1). JJBrown asserts, and includes documents in support of his assertion, that he had in fact tracked the maintenance fee payment, and mailed a reminder letter to petitioner.

Nevertheless, the record lacks adequate documentation to support the contentions that JJBrown had mailed a timely reminder letter to MABrown, and that MABrown failed to receive the aforementioned reminder. Assuming, *arguendo*, the letter was in fact mailed and not received by petitioner, the showing of record is also that petitioner failed to duly apprise JJBrown of petitioner's new correspondence address, with the consequence that the letter was mailed to petitioner's obsolete correspondence address, and never received by petitioner. However, delay resulting from a patentee's failure to apprise his representative of his current address for receiving communications related to a maintenance fee

payment, is not unavoidable delay. See Ray, supra; 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).

Petitioner complains that he was never advised by his registered representative, JJBrown, of the need to schedule and pay maintenance fees and further, that he never received the letters patent from his representative (and thus remained unaware of the Notice regarding maintenance fees in the letters patent). However, delay resulting from petitioner's being unaware of the need for maintenance fee payments, does not constitute "unavoidable" delay. See Patent No. 4,409,763, supra, 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). See also "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 Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. The failure to receive a reminder does not relieve the patentee of the obligation to timely pay the maintenance fee, nor will it constitute unavoidable delay if the patentee seeks reinstatement under the regulation. Rydeen, Id. Moreover, a patentee who is required by 35 USC 41(c)(1) to pay a maintenance fee within 3 years and six months (or 7 years and 6 months), of the patent grant, or face expiration of the patent, is not entitled to any notice beyond that provided by publication of the statute. Id.

Even further assuming that petitioner was not advised by JJBrown of the need to schedule and pay maintenance fees, such is insufficient to warrant a finding of unavoidable delay. Rydeen, supra. Since petitioner was represented by a registered practitioner, the Patent and Trademark Office (Office) must rely on the actions or inactions of the duly authorized and voluntarily chosen representatives of the patentee, and patentee is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). 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 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). The Office is not the proper forum for resolving a dispute between patentee and his representative regarding the scheduling and payment of maintenance fees. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

Furthermore, petitioner was constructively aware of the issuance of the patent in that petitioner's counsel JJBrown had received the letters patent, and thus, the Notice regarding maintenance fee payment. See Rosenberg v. Carr Fastener Co., 51 F.2d 1014, 10 USPQ 106 (2nd Cir. 1931), cert. denied, 284 U.S. 652 (notice to applicant's attorney is notice to applicant).

The record fails to adequately establish that the delay was unavoidable in that reasonable care was taken to ensure that the maintenance fee would be paid timely.

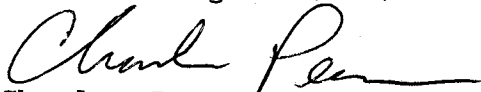
#### CONCLUSION

The prior decision which refused to accept under 37 CFR 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 and 37 CFR 1.378(b).

Since this patent will not be reinstated, fees totaling \$2150 have been refunded to deposit account No. 23-0650.

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

Telephone inquiries related to this decision should be directed to Lee Young at (703) 305-1820.



Charles Pearson

Patent Legal Administrator

Office of the Deputy Assistant Commissioner

for Patent Policy and Projects

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