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In re Patent No. 4,721,121 :
Issue Date: January 26, 1988 :
Application No. 06/829,503 : ON PETITION
Filed: February 14, 1986 :
Patentee: Charles R. Adams :

This is a decision on the petition under 37 CFR 1.378(e), filed July 26, 1996, 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 petition to accept the delayed payment of the maintenance fee is **DENIED**.

BACKGROUND

The patent issued on January 26, 1988. Accordingly, the first maintenance fee due could have been paid during the period from January 28, 1991 (January 26, 1991 being a Saturday) through July 26, 1991, or with a surcharge during the period from July 27, 1991 through January 27, 1992 (January 26, 1992 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 January 26, 1992. See MPEP 2506.

A petition under 37 CFR 1.183 and 1.378(c) to accept the delayed payment of the maintenance fee was filed on June 16, 1995, and was dismissed in the decision of September 11, 1995. A petition under 37 CFR 1.378(b) to accept the delayed payment of the maintenance fee was filed on February 12, 1996, and was dismissed in the decision of May 31, 1996. The instant petition under 37 CFR 1.378(e) requests reconsideration of the decision of May 31, 1996, and acceptance of the delayed payment of the maintenance fee for the above-identified patent.

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 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 1.378(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 if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." See 35 U.S.C. § 41(c)(1).

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). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner asserts that all documents and files related to petitioner's business and patents were kept in a briefcase, and that such briefcase was stolen in the latter part of 1991.

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3).

As discussed in the decision of May 31, 1996, 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, and, as such, 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 either petitioner or petitioner's representative took reasonable (or any) steps to ensure timely payment of the maintenance fee. 37 CFR 1.378(b)(3) precludes acceptance of the delayed payment of the maintenance fee in the absence of a showing that reasonable steps were taken to ensure timely payment of the maintenance fee.

That petitioner's briefcase (containing any documents or files related to the above-identified patent) was stolen in the latter part of 1991 does not establish unavoidable delay within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3). There is no evidence that petitioner maintained any calendar or other tracking system to alert petitioner of the maintenance fee due dates for the above-identified patent, much less that documents concerning or related to such a calendar or tracking system were among the documents in the briefcase at issue. Thus, there is no evidence that the theft of such briefcase deprived petitioner of any docketing or tracking system to ensure timely payment of the maintenance fees for the above-identified patent. Since there is no evidence that the documents in the briefcase at issue included any docketing or tracking system to ensure timely payment of the maintenance fees for the above-identified patent, the theft of such briefcase does not bear an adequate causal relationship to the petitioner's failure to timely submit the maintenance fee for the above-identified patent to establish unavoidable delay within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3).

The requirement for a showing that the "delay" was "unavoidable" is regarded as requiring a showing of unavoidable delay until the filing of a grantable petition. See In re Application of Takao 17 USPQ2d 1155 (Comm'r Pat. 1990). Assuming, *arguendo*, the existence of a causal relationship between the theft of the briefcase at issue and petitioner's failure to timely submit the maintenance fee for the above-identified patent, the theft still does not justify a delay until June of 1995 in submitting the maintenance fee for the above-identified patent.¹ That is, upon the theft of documents (or all of the documents) related to one's most important business, a reasonably prudent person in the exercise of due care would immediately take action to inventory any outstanding business matters (e.g., any patent for which a maintenance fee was required) to ensure that such matters would

¹ Likewise, the record lacks an adequate explanation of the five (5) month delay between the dismissal of September 11, 1995 and the filing of the petition of February 12, 1996 under 37 CFR 1.378(b) to accept the delayed payment of the maintenance fee for the above-identified patent.

be treated in regular course or with minimal delay. Petitioner's failure to ascertain whether any maintenance fees were due for the above-identified patent for over three (3) years after the theft of the briefcase at issue is not consistent with the actions of a reasonably prudent person in the exercise of due care.

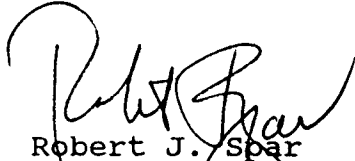
Finally, a patentee's lack of knowledge of the need to pay the maintenance fee or failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, supra; see also "Final Rules for Patent Maintenance Fees," 49 Fed. Reg. 34716, 34722-23 (Aug. 31, 1984), reprinted in 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and regulations, the Patent and Trademark Office (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. In any event, it appears that petitioner's failure to receive any PTO notices for the above-identified patent was due to a failure on the part of petitioner (or petitioner's representative) to provide the PTO with a current correspondence address. A delay caused by the failure on the part of petitioner, or petitioner's representative, to provide the PTO with a current correspondence address does not constitute an "unavoidable" delay. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

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, the maintenance fee and the surcharge fee submitted by petitioner will be refunded.

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



Robert J. Spar
Acting Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

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