



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

Paper No. 14

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**OFFICE OF PETITIONS
A/C PATENTS**

In re Patent No. 4,722,689 :
Issue Date: February 2, 1988 :
Application No. 06/811,103 : **ON PETITION**
Filed: December 20, 1985 :
Inventor: Jack A. Corbett :

This is a decision on the petition, filed July 16, 1997 under 37 CFR 1.378(e) requesting reconsideration of a prior decision which refused to accept under 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The request to accept the delayed payment of the maintenance fee is **DENIED**.

BACKGROUND

The patent issued February 2, 1988. Accordingly, the first maintenance fee could have been paid from February 2, 1991, through August 2, 1991, or with a surcharge during the period from August 3, 1991 through February 2, 1992. Accordingly, this patent expired February 2, 1992, for failure to timely pay the maintenance fee.

STATUTE AND REGULATION

35 USC 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 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:

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 (D.C. Cir. 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 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) patentee not receiving: (a) a Payor Number in response to a request mailed to the Patent and Trademark Office on September 20, 1988; (b) a Maintenance Fee Reminder; and (c) a Notice of Abandonment of the patent; (2) patentee's lack of: (a) familiarity with the maintenance fee procedures; (b) a reminder procedure in his office for maintenance fees; and (c) a subscription to the *Official Gazette*; and (3) reliance on the request for a Payor Number for adequate information on how to pay the maintenance fees.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

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).

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 establish that the patentee took adequate steps to ensure timely payment of the maintenance fee as required by 37 CFR 1.378(b)(3). Patentee admits that he did not have a reminder procedure in his office for maintenance fees. Since adequate steps were not taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

Delay resulting from petitioner's lack of receipt of any maintenance fee reminder(s), or 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. While the Office mails maintenance fee reminders strictly as a courtesy, it is solely the responsibility of the patentee to ensure that the maintenance fee is timely paid to prevent expiration of the patent. The failure to receive the 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 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. at 900, 16 USPQ2d at 1876.

Furthermore, the Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. The record is not clear as to whether petitioner read the Maintenance Fee Notice. However, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

Petitioner asserts that it was petitioner's belief that filing a request for Payor Number would result in petitioner receiving adequate information on how to pay the maintenance fees. In this petitioner was mistaken. The purpose of a Payor Number, as

quoted by petitioner, is "to facilitate the data input and subsequent changes in the 'fee address'...". Obtaining a Payor Number would not result in the receipt of information on how to pay the maintenance fee. Petitioner's mistaken belief that obtaining a Payor Number would result in petitioner receiving adequate information on how to pay the maintenance fee did not discharge patentee from his responsibility of ensuring that the maintenance fee be timely paid in order to prevent expiration of the patent.

Petitioner asserts that he never received a response from the Patent and Trademark Office to his request for assignment of a Payor Number. A review of the file wrapper indicates that an informal request for assignment of a Payor Number was received on September 26, 1988. While the lack of a response from the Office is regretted, the failure to receive such a response did not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Petitioner asserts that a Maintenance Fee Reminder was not received. Although a response from the Office to patentee's request may have resulted in patentee receiving a Maintenance Fee Reminder, the Office has no duty to notify patentee when the maintenance fee is due. While the Office mails Reminders strictly as a courtesy, a failure to receive a Reminder does not relieve the patentee of the obligation to timely pay the maintenance fee.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for paying the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 608-609, 34 USPQ2d at 1787. Although petitioner mailed a request for assignment of a Payor Number to the Patent and Trademark Office on September 20, 1988, there is no showing that petitioner took any additional steps regarding payment of the maintenance fee prior to September 1996, a period of eight years. A reasonably prudent person would have inquired as to the status of the request for a payor Number if no response from the Office was received in a reasonable period of time.

Petitioner argues that the "interests of justice" favors acceptance of this petition and requests that a "reasonably prudent person would have expected to be judged from both my action as well as the Patent and Trademark Office." This argument is not convincing because the Office must follow the precedents cited above where lack of action by the Office does not relieve the patentee of the duty to pay the maintenance fees.

That petitioner chose, or permitted himself to remain ignorant of the circumstances surrounding the maintenance fee payment militates against a finding that the delay in this case reasonably can be considered to have been unavoidable.

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 by a Treasury Check in due course.

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

Telephone inquiries relevant to this decision should be directed to Brian Hearn at (703) 305-1820.



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