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In re Patent No. 4,844,135
Issue Date: July 4, 1989
Application No. 07/261,716
Filed: October 24, 1988
Inventor: Bradley R. Witt

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: ON PETITION
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This is a decision on the petition, filed July 21, 2000, 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 under 37 CFR 1.378(b) is **DENIED**.¹

BACKGROUND

The patent issued July 4, 1989. The first maintenance fee was timely paid. The second maintenance fee was due January 6, 1997 (January 4, 1997 being a Saturday), and could have been paid during the period from July 5, 1996, through January 6, 1997, or with a surcharge during the period from January 7, 1997, through July 7, 1997 (July 4, 1997 being a holiday and July 5, 1997 being a Saturday). The above-identified patent expired as of midnight, July 4, 1997, for failure to pay the maintenance fee. 35 USC 41(b).

A petition under 35 USC 41(c)(1) and 37 CFR 1.378(b) was filed November 29, 1999, and was dismissed in the decision of May 9, 2000, which was remailed May 24, 2000.

¹ 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. No further consideration or reconsideration of this matter will be given. See 37 CFR 1.378(e).

STATUTE AND REGULATION

35 U.S.C. § 41(b) states in pertinent part that:

"The Commissioner shall charge the following fees for maintaining in force all patents based on applications filed on or after December 1, 1980:

- (1) 3 years and 6 months after grant, \$940².
- (2) 7 years and 6 months after grant, \$1,900.
- (3) 11 years and 6 months after grant, \$2910.

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent shall expire as of the end of such grace period."

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."

² Maintenance fees in effect as of the date the first petition was filed on November 29, 1999. The fees may be subject to an annual adjustment on October 1, see 35 USC 41(f), and are reduced by 50% for, as here, a small entity, see 35 USC 41(h)(1).

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 USC 41(c)(1).

Petitioner (inventor Bradley Witt (Witt) on behalf of the Witt Family Partnership LLP(WFP), the successor in title to Witt since January 1, 1997) requests reconsideration in that, while the first maintenance fee was paid, the delay in payment of the second fee is unavoidable since petitioner again asserts that its predecessor in title was unaware of the need to schedule and pay the second maintenance fee, and further, its predecessor failed to receive any Reminder from the USPTO regarding the second fee payment.

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay in payment of the second maintenance fee was unavoidable.

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 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), *cert. denied*, 516 U.S. 916 (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 in responding to an Office action 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, 514-515 (D.C. Cir. 1912); and 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, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the

patentee's³ burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See 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); Ray v. Lehman, supra.

As 35 USC § 41(b) 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 USC § 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 by the responsible party to ensure the timely payment of the second maintenance fee for this patent. Id.

When the issue of reinstatement is addressed, the focus must be on the rights of the parties as of the time of expiration, so as to ascertain the responsible person. See Kim v. Quigg, 718 F.Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va. 1989). As noted above, as WFP became the successor in title on January 1, 1997, WFP owned the rights to this patent when the fee fell due on January 4, 1997, as well as some six months later when this patent expired by operation of law. As WFP owned the entire interest in the patent at the time of expiration, it is the actions or inactions of WFP, as the responsible party, that are material. Id. As the patent holder at the time of expiration, it was incumbent on WFP to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance *per se* does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

³ Pursuant to 35 USC 100(d), the Witt Family Partnership LLP, as the successor in the entire rights, title and interest to Witt as of January 1, 1997, is the patentee. See petition of November 29, 1999, at Tab 10.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of WFP, upon assumption of its ownership, to schedule or pay the second maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for WFP's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of WFP, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

There is no showing that WFP, as a prudent and careful person with respect to its most important business, upon its acquisition of a valuable business asset such as this patent, even enquired of its predecessor in title or even the USPTO whether this patent had been maintained in force, or whether maintenance fees fell due.⁴ That WFP's failure to take any steps itself, or obligate another, in this matter may have been based upon WFP's lack of knowledge of, or misunderstanding of, the need to pay the second maintenance fee does not excuse the delay in payment, or show that the delay herein was unavoidable within the meaning of 35 USC 41(c) and 37 CFR 1.378(b)(3). Unfortunately for petitioner, delay resulting from a lack of awareness (by Witt or WFP or both) of the need to pay maintenance fees, or delay resulting from petitioner's (or Witt's) lack of receipt of any maintenance fee reminder(s), does not constitute "unavoidable" delay. See In Re Patent No. 4,409,763, 7 USPQ2d 1798 (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). 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. Rydeen, Id.

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 to pay a maintenance fee, 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.

⁴ This patent apparently was or is the subject of some twelve licenses, see petition of November 29, 1999, Tab 11, and two actions for infringement, see Voorhees' suppl. decl. filed February 8, 2000, ¶ 4.

Furthermore, the instant 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. While the record is not clear as to whether Witt or WFP ever read the Maintenance Fee Notice, Witt's, or WFP'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. The mere publication of the statute was sufficient notice to WFP and Witt. Rydeen, supra.

WFP seeks to avoid the consequences of its failure to show that it had taken any steps within the meaning of 37 CFR 1.378(b)(3) to pay the maintenance fee by relying upon its predecessor in title: Witt. Witt, in turn, contends that the delay was unavoidable in that he, Witt, was not aware of the need to schedule or pay the second maintenance fee, that he "has not ever had an attorney of record who represented him in the '135 patent," and that he was prudent in relying on Witt's letter of September 18, 1992 (petition of November 29, 1999, Tab 6) to the USPTO seeking information regarding whether a maintenance fee was due and requesting a change of correspondence address regarding the patent such that he would receive any communications regarding this patent. Witt complains that the USPTO did not act on his letter and change the address, with the result that Witt also complains that he never received any reminder from the USPTO regarding the second maintenance fee.

Initially, as Witt asserts that he was unaware of the need for a second maintenance fee payment (Witt decl. of November 29, 1999, ¶ 4) any contention that Witt had taken steps to pay the second maintenance fee must be regarded as untenable. Since Witt cannot reasonably show the steps in place required by 37 CFR 1.378(b)(3) for the second maintenance fee payment, Witt likewise seeks to avoid the consequences of his failure to take any steps by relying upon the alleged failure of the USPTO to act on his communication of September 18, 1992.

While Witt maintains that he was prudent in relying upon the USPTO for a Reminder regarding the second maintenance fee in view of Witt's letter of September 18, 1992, this is simply an attempt to shift the patentee's burden of tracking the second maintenance fee payment back to the USPTO, and further, makes the unfounded assumption that as Witt or WFP had a right to notice from the USPTO, a finding of unavoidable delay is warranted. But see Rydeen, 748 F.Supp at 905, 16 USPQ2d at 1882. As noted above, the patentee's 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.

Further, a review of the events surrounding Witt's letter fail to demonstrate that Witt acted as a prudent and careful person with respect to his most important business in this matter.

Witt's letter was returned to Witt by the USPTO (petition of November 29, 1999, Tab 6) along with a USPTO communication dated October 6, 1992 (petition of November 29, 1999, Tab 7) asserting that Witt was being provided with copies of (1) the rules of practice relevant to maintenance fees (37 CFR 1.362 through 1.378)⁵, (2) an approved Maintenance Fee Transmittal Form, and (3) a "Fee Address indication Form." Witt was not informed by the communication of October 6, 1992, that the requested address change had been effectuated; rather, he was informed that he was being provided with a "Fee Address Indication Form." Additionally, Witt was provided with both a telephone number and mailing address for seeking further USPTO assistance on maintenance fee matters. There is no showing that Witt failed to receive the referenced materials, or if so, that Witt diligently requested the referenced materials or further information or assistance. There is no showing, and Witt does not contend, that Witt ever filled out and returned the Fee Address Indication Form, with the result that the correspondence address remained that of Gordon *et al.*, Witt's counsel of record. Further, while the record is not clear as to whether Witt employed the USPTO supplied maintenance fee transmittal form (which clearly requires the payee to insert the application number in addition to the Patent Number pursuant to 37 CFR 1.366(c)) when Witt submitted the first maintenance fee, the record clearly does show that Witt did not heed the instructions and failed to include the application number when he submitted the payment. This, in turn, resulted in an additional notice from the USPTO, which notified Witt that his submission of the first maintenance fee was defective for failure to comply with the rules of practice before the USPTO. See petition of November 29, 1999, Tab 8. This latter notice also included information about the second and third maintenance fees, as noted above. Witt's failure to heed, or read, or both, the information and instructions that he was given, or seek additional assistance or clarification does not reflect the due care and diligence of a prudent and careful person with respect to his most important business. In any event, no amount of artful pleading by Witt or on behalf of WFP will serve to shift the patentee's burden of tracking the second maintenance fee payment back to the USPTO, nor is such pleading persuasive of unavoidable delay.

Witt's complaint that he did not receive a Reminder from the USPTO is likewise not persuasive that the delay was unavoidable. Petitioner appears to overlook that a Reminder is only mailed out as a courtesy after the fee due date has passed with no payment made, which mailing itself is after more than one half of the entire year to pay the maintenance fee has transpired. Petitioner is reminded that neither Witt nor WFP had a right to personalized notice that this patent would expire if the second maintenance fee

⁵ The requirement for second and third maintenance fee payments to maintain a patent in force is also set forth in 37 CFR 1.362.

was not paid, as the publication of the statute was sufficient notice. See Rydeen 749 F.Supp at 907, 16 USPQ2d at 1882. Rather, the ultimate responsibility for keeping track of maintenance fee due dates lies with the patentee, not the USPTO. Id. Since the inception of maintenance fees, the USPTO has maintained that it has no duty to notify patentees when their maintenance fees are due, and that the lack of any USPTO notice will in no way shift the burden of monitoring the time for paying the maintenance fees from the patentee to the USPTO. Further, such lack of notice will not constitute unavoidable delay under the statute. Rydeen, 748 F.Supp at 905, 16 USPQ2d at 1880. Accordingly, petitioner's and Witt's attempt, by way of artful pleading, to shift the burden of monitoring the second maintenance fee payment back to the USPTO is not persuasive of unavoidable delay. Rather, the requirement for notice is only set forth in 35 USC 133 (and § 151), and is not, as petitioner apparently would have the USPTO believe, found in 35 USC 41(c)(1) or 37 CFR 1.378(b)(3). Ray, 55 F.3d at 609, 34 USPQ2d at 1788; Rydeen, supra.

Witt's contention that he was unaware of the need to pay the second maintenance fee is not persuasive that the delay is unavoidable. First, the record (Voorhees suppl. decl., ¶ 9 filed February 8, 2000) shows that Witt had received prior to 1994, the letter dated September 25, 1989, from Witt's patent counsel Mr. Gordon to Richard Byrom⁶, which transmitted the above-captioned letters patent, noted some errors warranting a request for a Certificate of Correction, and, most importantly, at ¶ 3, noted that maintenance fees for the above-identified patent fell due in the third, seventh, and eleventh years after grant. Indeed, Witt (suppl. Witt decl. filed February 8, 2000) acknowledges that such was in "my file" at the time of the "Byrom litigation." Inspection of this patent file reveals two Notices, pursuant to 35 USC 290, from the Northern District of Ohio, Eastern Division, Byrom International Corp et al. [Witt] v. Choice Precision Tools, No. 1:89CV01284 I. The action was filed July 5, 1989, transferred to the District Court for the Middle District of Florida, and the action dismissed and terminated in the Ohio court on April 16, 1990. This was

⁶ Witt apparently engaged Byrom International Corp. (BIC) to underwrite various expenses, including the cost of prosecution of this application, in exchange for a license to BIC. See petition of November 29, 1999, Tab 2 ("Agreement"). Notwithstanding a statement in the Agreement regarding assignment of this patent to BIC, Witt contends that he was the patent owner until Witt assigned title to WFP on January 1, 1997. Richard Byrom styled himself as the president and owner of BIC in the small entity statement under 37 CFR 1.9 of record. It is not clear if BIC declined to pay the first maintenance fee, which led to Witt's effort, or what was the business relationship between BIC and Witt regarding maintenance fees. Witt's assertion of his ownership until January 1, 1997 is accepted.

hardly a fleeting notice, as it remained with Witt until 1994, when Witt's files were sent to Voorhees in support of Witt's second suit to assert this patent. Second, the record shows that Witt admits receipt of the USPTO notice of informal maintenance fee payment mailed November 3, 1992 (petition of November 29, 1999, Tab 8), sent in reply to Witt's flawed initial attempt to pay the first maintenance fee *pro se*, which, on the reverse, clearly set forth the fact that maintenance fees fell due at 3½, 7½, and 11½ years.

As such, Witt knew, or should have known, notwithstanding the publication of 35 USC 41, that a second (and third) maintenance fee was required to maintain this patent in force. Rydeen, supra. As with the Notice on the patent itself, Witt's professed failure to read--or now recall-- these two additional notices does not vitiate the notice(s). See Ray, 55 F.3d at 610, 34 USPQ2d at 1789. Since Witt, as did the plaintiff in Ray, concedes that Witt had in his possession the September 25, 1989 letter from Gordon, as well as the November 3, 1992, communication from the USPTO, both of which referenced the need for a second maintenance fee in the seventh year, whether the USPTO had an obligation to provide notice is simply not an issue in this case. Ray, Id. Even accepting Witt's contention(s) that he did not read or does not recall any of the notices; rather than this being an issue as to whether the notices to Witt were sufficient, this contention(s) simply does not prove to the satisfaction of the Commissioner that the attendant delay in payment of the second maintenance fee was unavoidable. See Ray, at 610, 34 USPQ2d at 1788-89.

While Witt also asserts that he was not represented by counsel in the '135 patent, such is not persuasive that the delay in payment of the second maintenance fee was unavoidable. Rather, it is well settled that "all persons are charged with knowledge of the provisions of the statutes and must take note of the procedure adopted by them." Rydeen, 748 F.Supp. at 907, 16 USPQ2d at 1881 (quoting North Laramie Land Co. v. Hoffman, 268 U.S. 276, 285, 69 L.Ed. 953, 45 S. Ct. 491 (1925)). Contrary to the assertion in the petition of July 21, 2000 (at 3), petitioner appears to have overlooked that the declaration under 37 CFR §§ 1.33, 1.63 in the above-identified application appointed Charles S. Gordon (Gordon) *et al.* of the firm of Pearne, Gordon, McCoy & Granger as Witt's representative(s). See declaration under 37 CFR 1.63 executed by Witt on October 28, 1988. Witt did not reply to the offer of Gordon *et al.* in the letter of September 9, 1992 (petition of November 29, 1999, Tab 3) as amplified and forwarded to Witt by way of the letter from patent counsel Robert Richardson (petition of November 29, 1999, Tab 4) to represent Witt before the USPTO with respect to submission of the first maintenance fee. Instead, Witt made the business decision to forego legal representation and deal directly with the USPTO regarding maintenance fees. As such, Witt voluntarily assumed the risk of representing himself and must bear the consequences of his actions or inactions (petition of November 29, 1999, Tabs 5,6). Whatever may have been the

relationship among Witt, Gordon *et al.* and Byrom⁷, the power of attorney was from Witt to Gordon *et al.*, not from Bryom to Gordon *et al.* If Gordon *et al.*'s letter of September 25, 1989 (which was addressed and directed to Byrom), did not serve to adequately advise Witt as to the need for the second maintenance fee payment, that may be an issue between Witt and Gordon *et al.*, but that is manifestly not an issue before the USPTO. See Rydeen, 748 F.Supp at 906 n.9, 16 USPQ2d at 1881 n.9. The USPTO is not the proper forum for resolving a dispute between a patentee and his representative as to who bore the responsibility for tracking and paying a maintenance fee. See Ray, 55 F.3d at 610, 34 USPQ2d at 1789. Delay resulting from a failure of communication between a patent owner and his representative as to the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). Id.

A review of the record also reveals that on December 23, 1998, Witt, through Gordon *et al.* successfully petitioned for special accelerated processing and examination of the application within the USPTO due to an asserted actual infringement. Subsequent to issuance on July 4, 1989, Witt asserted this patent against two putative infringers in 1989 and 1994 (see Voorhees suppl. decl. of February 8, 2000, ¶ 4), and prior to Witt's transfer of title to WFP on January 1, 1997, had obtained some ten licenses (see petition of November 29, 1999, Tab 11), whereupon WFP then obtained two more licenses. This suggests that Witt and WFP gave priority to asserting this patent and to obtaining licenses, at the expense of taking adequate steps to ensure that this apparently valuable business asset would be, or had been, maintained in force. The record unfortunately does not show that Witt, or WFP, exhibited the same care and diligence regarding taking steps to ensure maintenance fee payments, that was exhibited in asserting this patent, as well as in licensing this patent (see *e.g.* petition of November 29, 1999, Tab 9). However, a showing of diligence in matters before the USPTO is essential to support a finding of unavoidable delay herein. See Future Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988)(applicant's diligent inquiry into the status of the application is required to show unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one

⁷ There is no need in this case to determine the obligation among Gordon *et al.* Witt, Richard Byrom, BIC, or petitioner, regarding payment of the second maintenance fee, since the record fails to show that any party took adequate steps to ensure timely payment of the second maintenance fee. See In re Patent No. 4,461,759, 16 USPQ2d 1883, 1884 (Comm'r Pat. 1990).

half years overcame and superseded any omissions by his counsel). Witt, and petitioner, have not shown adequate diligence in this matter, notwithstanding Witt's communication of September 18, 1992. However, there is no "sliding scale" based upon the priority given to this maintaining this patent in force, or more diligently seeking reinstatement, *vis-a-vis* other matters by Witt and petitioner; the issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. The delay was not unavoidable, because had Witt, or WFP, exercised the due care and diligence of a reasonably prudent person, Witt or petitioner would have been able to act to pay the fee or seek reinstatement in a timely fashion. The record fails to adequately evidence that Witt or petitioner exercised the due care and diligence observed by prudent and careful men, in relation to their most important business, which is necessary to establish unavoidable delay. Pratt, supra.

Thus, even construed in a light most favorable to petitioner, Witt's contentions do not establish that Witt's and WFP's delay in payment was unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b)(3). As such, WFP, as the successor in title to Witt, and lacking any steps taken on its own behalf, is bound by the business decisions, actions or inactions of its predecessor in title, such that the entire delay in payment of the second maintenance fee has not been shown to be unavoidable. See, Winkler v. Ladd, 221 F.Supp 550, 552, 138 USPQ 666, 667 (D.D.C. 1963)(delay caused by a failure to act by the party in interest at the time the action needs to be taken is binding on the successor in title, and is not unavoidable delay); Kim v. Quigg, supra (whether successor in title to a patent application acted diligently upon acquisition of its interest is immaterial to and does not overcome the delay resulting from the actions or inactions of the predecessor in title).

DECISION

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 reasons herein and stated above, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b). The petition is **denied**.

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

Since this patent will not be reinstated, maintenance fees and surcharges submitted by petitioner totaling \$2255, have been credited to counsel's deposit account No. 26-0084. The \$130 for requesting reconsideration is not refundable.

The patent file is being returned to the Files Repository.

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



Manuel A. Antonakas, Director,
Office of Petitions