



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 17

Calvin J. Laiche
138 Westbank Expwy.
Westwego, LA 70094

COPY MAILED

JUN 25 1997

**OFFICE OF PETITIONS
AND PATENTS**

ON PETITION

In re Patent No. 4,881,661 :
Issue Date: November 21, 1989 :
Application No. 07/177,424 :
Filed: April 1, 1988 :

This is a decision on the petition under 37 CFR 1.378(e), filed January 16, 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 and a decision on the letter filed November 21, 1994, and supplemented on May 14, 1997 and June 11, 1997, which is being treated as a petition to accept, under 37 CFR 1.378(c), 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.

The request to accept the delayed payment of the maintenance fee under 37 CFR 1.378(c) is GRANTED. The first maintenance fee in this case is hereby accepted pursuant to 37 CFR 1.378(c) and the above-identified patent is hereby reinstated as of the mail date of this decision.

BACKGROUND

The patent issued November 21, 1989. Accordingly, the first maintenance fee due could have been paid during the period from November 23, 1992 (November 21, 1992 being a Saturday), through May 21, 1993 or with a surcharge during the period from May 22, 1992, through November 22, 1993 (November 21, 1993 being a Sunday). Accordingly, the patent expired at midnight on November 21, 1993 for failure to pay the first maintenance fee. See MPEP 2506.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on September 27, 1996 and was dismissed in the decision of December 13, 1996.

The instant petition under 37 CFR 1.378(e) was filed on January 16, 1997.

The instant petition under 37 CFR 1.378(c) was filed on January 16, 1997, and supplemented on May 14, 1997 and June 11, 1997.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) provides 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 1.183 states that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

- (1) The required maintenance fee set forth in § 1.20(e)-(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 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.

37 CFR 1.378(c) provides that:

Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:

- (1) The required maintenance fee set forth in § 1.20(e)-(g);
- (2) The surcharge set forth in § 1.20(i)(2); and
- (3) A statement that the delay in payment of the maintenance fee was unintentional.

OPINION

With respect to the petition under 37 CFR 1.378(b):

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 urges that the decision of December 13, 1996 be reconsidered, given that he has made an exhaustive showing of all persons involved in the attempted notification of the patentee with respect to timely submission of the maintenance fees. Petitioner further asserts that steps were in place to ensure payment of the maintenance fee and that a check in the amount of \$400 was sent to the U.S. Patent and Trademark Office (Office) on November 1, 1993. Petitioner provides a copy of a personal check ledger as a showing that the check was written and copies of bank statements which support that the check was not processed by the Office. In the alternative, petitioner asserts that the delay in payment of the maintenance fee was unintentional.

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

Petitioner alleges that adequate steps were in place to ensure timely payment of the maintenance fee. Petitioners' allegation is not fully supported by the showing of record. Petitioner now alleges that he had the maintenance fee due dates recorded in a pocket calender and that Mary Ellen (bookkeeper) set up a memory system to pay the maintenance fees. However, in the petition of November 21, 1994, petitioner asserted that "as far as he (Mr. Jones) can tell from his records, he has not paid any maintenance fees" and in the petition of September 27, 1996, petitioner again asserts that "(T)he inventor cannot recall ... if he has paid or instructed others to pay any such fee." One must question whether the steps which were allegedly in place were adequate to ensure timely payment of the maintenance fee. It is not clear how the alleged steps could be considered to be adequate to notify the patentee of the need to pay the maintenance fee, when petitioner could not even find evidence of the existence of the step on two separate occasions. Since petitioner was not able to even find what steps were allegedly in place, it is not clear how petitioner believed that such steps were adequate to notify him of the need to pay the maintenance fee when petitioner was not specifically looking for the steps.

Petitioner now asserts that not only were adequate steps in place to ensure timely payment of the maintenance fee, but that a check for the maintenance fee was actually sent to the U.S. Patent and Trademark Office on November 1, 1993 in the amount of \$400. The file record does not show a check being received in the PTO on or about November 1, 1993. Petitioner has not complied with the requirement to establish non-receipt of a response by the Office. Petitioner has failed to (1) inform the Office of the previous mailing of the correspondence or fee promptly after becoming

aware of the non-receipt, (2) supply an additional copy of the previously mailed correspondence or fee, or (3) include a declaration under 37 CFR 1.68 or 37 CFR 2.20 which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing. Petitioner provides a copy of a personal check ledger showing check number 1237 with a date of November 1, 1993 to U.S. Pat. Office and copies of bank statements which support that check #1237 was not processed. The showing of record does not provide direct evidence of the submission of the maintenance fee. The check ledger shows, at best, an intent to file the maintenance fee. The burden is on petitioner to supply, under the rules of practice, sufficient evidence to establish that the maintenance fee payment asserted to have been submitted to the Office was actually mailed. The check ledger fails to provide any direct evidence of what date the maintenance fee was sent to the Office. A showing of direct evidence is needed to prove that the delay was unavoidable.

Even if the Office had received the alleged check or if petitioner can prove receipt of the alleged check, the maintenance fee payment would not have been accepted. 37 CFR 1.366(b) requires that the maintenance fee payment be submitted in the amount due including any applicable surcharges. The proper amount for the maintenance fee due, if paid on November 1, 1993, would have been \$465 and a \$65 surcharge would have been applicable. The \$400 check would therefore have been deficient by \$130.

Petitioner has failed to establish that he exercised due care and diligence in ensuring that adequate steps were taken to ensure the timely payment of such maintenance fee. Accordingly, the late payment of the maintenance fee cannot be accepted under 37 CFR 1.378(b).

With respect to the petition under 37 CFR 1.378(c):

"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." 35 U.S.C. § 41(c)(1).

While 37 CFR 1.378(c) requires that a petition thereunder including the required maintenance fee set forth in 37 CFR 1.20(e) through (g), the surcharge set forth in 37 CFR 1.20(i)(2), and a statement that the delay in payment of the maintenance fee was unintentional be filed within twenty-four months after the six-month grace period provided in 35 U.S.C. § 41(b) and 37 CFR 1.362(e), 35 U.S.C. § 41(c)(1) provides that the "Commissioner may accept the payment of any maintenance fee required by

[35 U.S.C. § 41(b)] 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." That is, 35 U.S.C. § 41(c)(1) requires only that "any maintenance fee required by [35 U.S.C. § 41(b)] subsection (b) of this section" be submitted "within twenty-four months after the six-month grace period" as a condition of accepting a delayed maintenance on the basis of unintentional, but not unavoidable, delay.

The showing of record is that the Office received a check in an amount sufficient to pay the maintenance fee within two years after expiration of the patent, as required by 35 U.S.C. § 41(c)(7) and 37 CFR 1.378(c). Furthermore, while the check was captioned with an incorrect patent number, papers accompanying the check identified the correct Application Number and inventor name for the above-identified patent. Unfortunately, the Office returned the papers and check uncashed. Had the Office discovered its mistake, petitioner would have been apprised in a timely manner of the need to proceed further under 37 CFR 1.378(c). Under the circumstances of the above-identified patent, it is appropriate to *sua sponte* waive the requirement in 37 CFR 1.378(c) that the surcharge set forth in 37 CFR 1.20(i)(2), and the statement that the delay in payment of the maintenance fee was unintentional be filed within twenty-four months after the six-month grace period provided in 35 U.S.C. § 41(b) and 37 CFR 1.362(e).

The record adequately supports petitioner's assertion in the petition filed May 14, 1997, that the delay in payment of the maintenance fee was unintentional. Accordingly, late payment of the maintenance fee can be accepted under 37 CFR 1.378(c).

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).

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

The first maintenance fee in this case is hereby accepted pursuant to 37 CFR 1.378(c) and the above-identified patent is hereby reinstated as of the mail date of this decision.

This patent file is being returned to the files repository.

Telephone inquiries relevant to this decision should be directed to Marc Hoff at (703) 305-9285.

A handwritten signature in cursive script, appearing to read "Charles Pearson".

Charles Pearson
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

msh