



Paper No. 20

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OFFICE OF PETITIONS

ON PETITION

In re Patent of Chari :
Patent No. 5,076,302 :
Application No. 07/489,326 :
Filed: March 5, 1990 :
Issued: December 31, 1991 :
For: APPARATUS FOR AND METHOD OF :
DISPENSING DENTAL FLOSS :

This is a decision on the renewed petition under 37 CFR § 1.378(e), filed December 18, 2002, to reinstate the above-identified patent.

The petition is **DENIED**.¹

Since this patent will not be reinstated, a refund of the maintenance fees and surcharges submitted by petitioner will be scheduled. The \$130 fee for requesting reconsideration is not refundable. Therefore the Office will refund \$3,700.²

Background

The patent issued December 31, 1991. The 3.5 year maintenance fee could have been paid from December 31, 1994 through June 30, 1995, or with a surcharge during the period from July 1, 1995 to December 31, 1995. Petitioner did not do so. Accordingly, the patent expired January 1, 1996.

A petition under 35 USC 41(c)(1) and 37 CFR 1.378(b) was filed September 4, 2002, and was dismissed in the decision of November 4, 2002.

Applicable Statutes and Regulation

35 U.S.C. § 41(b) states in pertinent part that, "Unless payment of the applicable maintenance fee is received . . . 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 . . . after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added)

¹ This decision may be viewed as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP 1002.02.

² \$440 - 3.5 year maintenance fee, \$1,010 - 7.5 year fee, \$1,550 - 11.5 year fee, surcharge - \$700

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

A showing that . . . reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee . . . 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.

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.³ However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁴ The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Application of the unavoidable standard to the present facts

Facts:

The patent issued on December 31, 1991.

Petitioner was aware of the need to make maintenance fee payments to maintain the patent. Petitioner made note of the fees in a paper calendar and in an electronic calendar.

The paper calendar and patent file were kept in petitioner's basement. During May of 1992, the paper calendar and file were lost due to flooding.

Petitioner did not take steps to reconstruct the paper calendar or file. Instead, petitioner relied on the electronic calendar to notify petitioner when fees became due.

On or about March of 1993, data was lost from the electronic calendar due to an unknown reason such as a virus or software malfunction. Petitioner was able to recover what petitioner believed was the entire contents of the electronic calendar. However, data related to the instant patent, if it had been entered, was lost.

The 3.5 year maintenance fee could have been paid from December 31, 1994 through June 30, 1995, or with a surcharge during the period from July 1, 1995 to December 31, 1995. Petitioner did not do so. Accordingly, the patent expired January 1, 1996.

³ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee ... at any time ... if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

⁴ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

Petitioner discovered the expiration of the patent from a third party on August 12, 2002.

Analysis:

The prior decision stated,

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

Petitioner has failed to provide sufficient evidence to prove the entire delay in the submission of the maintenance fees was unavoidable.

Upon loss of the paper file and calendar, petitioner chose to rely on the electronic calendar.

Petitioner has not proven that data related to the instant patent was ever entered into the electronic calendar. Petitioner's assertion of such entry is based on recollection of an event which occurred more than ten years ago. Even if data regarding the instant patent was entered, petitioner has not proven that such data was correctly entered. Petitioner has not proven that, but for the computer virus, the fees would have been timely paid.

The prior decision stated,

Petitioner has failed to prove that the electronic calendaring system was reliable and trustworthy. How many times had the calendar correctly worked before? Had petitioner ever had any other problems with the calendar? What other data did petitioner believe was recovered even though the data was not in fact recovered?

In response, petitioner states, "To the best of my recollection, there have been no defaults on my part in knowing or acting upon any important matter due to malfunction or failure of my calendar/date keeping system either before or after the computer virus accident of March 1994." If this statement is construed as a statement that the maintenance fee data was the only data lost at any time, such a statement would imply that the data had never been entered. Petitioner has provided no reason why all data but the maintenance fee data would be recovered. If the statement is a statement that errors or loss of data has occurred before, but not in a way to cause petitioner to timely act on an "important matter," then petitioner has failed to address the following issues presented in the previous decision:

Petitioner has failed to prove that the electronic calendaring system was reliable and trustworthy. How many times had the calendar correctly worked before? Had petitioner ever had any other problems with the calendar? . . . What other data did petitioner believe was recovered even though the data was not in fact recovered? On what date did petitioner first discover that some data had not been recovered?

The previous decision stated,

Petitioner is responsible for treating the patent the same as his most important business. As the years passed, why did petitioner not wonder why his calendar had yet to notify

him of the need to make a maintenance fee payment? It should be noted that petitioner did not discover the expiration of the patent until 10 years and 8 months after the patent issued. Petitioner learned of the expiration from a third party. During this entire time, what actions did petitioner take regarding the patent?

Petitioner states that the patent was of utmost importance to petitioner. However, petitioner did not discover the expiration of the patent until, during marketing of the patent, a third party notified petitioner of the expiration. The fact that petitioner does not routinely engage in patent matters or did not assert the patent against anyone does not absolve petitioner from taking steps to maintain the patent and verifying such steps when significant time has passed. Petitioner has not proven that a reasonable and prudent person, with knowledge of the need to pay maintenance fees and treating the patent as his or her most important business, would not have noticed that a significant amount of time had passed without petitioner having paid any maintenance fees. In addition, petitioner has not proven that, upon beginning to market the patent, failing to check into the status of the patent was reasonable and prudent.

Petitioner has not proven that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

Decision

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

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

The patent file is being forwarded to Files Repository.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



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