



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 12

MAILED

JOSEPH N BREAUX
10630 N OAK HILLS PKWY
SUITE A
BATON ROUGE LA 70810

JUN 01 2010

OFFICE OF PETITIONS

In re Application of	:
Sigsworth	:
Application No. 09/187,972	:
Patent No. 6,085,765	:
Filed: November 6, 1998	:
Issue Date: July 11, 2000	:
Attorney Docket Number: 98- 10670	:
Title: FOREARM CRUTCH CUSHION SYSTEM	:

This is a decision on the renewed petition filed on December 28, 2009, pursuant to 37 C.F.R. § 1.378(e), requesting reconsideration of a prior decision pursuant to 37 C.F.R. § 1.378(b), which refused to accept the delayed payment of maintenance fees for the above-referenced patent.

This renewed petition pursuant to 37 C.F.R. § 1.378(e) is **DENIED.¹**

THERE WILL BE NO FUTHER RECONSIDERATION OF THIS MATTER BY THE OFFICE.

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of seeking judicial review. See MPEP § 1002.02.

Background

The patent issued on July 11, 2000. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on July 11, 2004, with no payment received. Accordingly, the patent expired on July 11, 2004 at midnight.

A petition pursuant to 37 C.F.R. § 1.378(b) was filed on October 5, 2009, and was dismissed via the mailing of a decision on November 24, 2009.

A renewed petition pursuant to 37 C.F.R. § 1.378(e) was filed on December 28, 2009, and a Request for more Information was mailed on February 3, 2010.

A letter was received on March 2, 2010 in response to the request for more information from an individual who has asserted that he is the son of the sole inventor. The patentee's income tax returns for the tax years of 2004 - 2008 were included with this letter.

The standard

35 U.S.C. § 41(c)(1) states, in pertinent part:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay² is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay 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

² This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

is generally used and observed by prudent and careful men in relation to their most important business.³

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."⁴

The burden of showing the cause of the delay is on the person seeking to revive the application.⁵

Application of the standard to the current facts and circumstances

Petitioner has not provided the \$400 fee that is associated with the filing of a renewed petition pursuant to 37 C.F.R. § 1.378(e). A review of the record does not support a finding that patentee's explanation of the delay meets the standard for acceptance of a late payment of the maintenance fee and surcharge, as discussed below.

The period for paying the 3½-year maintenance fee without the surcharge extended from July 11, 2003 to January 11, 2004 and for paying with the surcharge from January 12, 2004 to July 11, 2004. Thus, the delay in paying the 3½-year maintenance fee extended from July 11, 2004 at midnight to the filing of the response to the request for more information on March 2, 2010.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;

³ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

⁴ Haines v. Quigg, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

⁵ Id.

- (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.

The Request for More information posted three inquiries:

1. What steps, if any, did Petitioner have in place to ensure the timely submission of the maintenance fees?
2. What relation are Mr. William Sigsworth, Jr. and Cassie Hunter to Petitioner?
3. What was Petitioner's complete financial condition during the entire period between July 11, 2004 and October 5, 2009? Petitioner should strongly consider providing her income, expenses, tax return statements, bank records, assets, credit and obligations for this entire period of time.

Regarding the first inquiry, the response to the request for more information is silent as to any steps that might have been in place for ensuring the timely submission of maintenance fees. The response indicates that the inventor intended to procure the funds required for the maintenance fees through the sale of the subject matter of this patent, but it does not reveal any steps which she might have had in place to ensure the timely submission of the same.

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 C.F.R. § 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b). Due to the fact that the record fails to disclose that the patentee took reasonable steps to ensure the timely submission of the maintenance fee, the record supports a finding that this petition must be denied.

Regarding the second inquiry, Petitioner has indicated that Mr. William Sigsworth, Jr. is the patentee's tax advisor and Cassie Hunter is the patentee's accountant. This appears to be in direct contravention to the information which appears in the tax returns that were provided with this response to the request for more information, which indicate that William Sigsworth, Jr. is the spouse of the patentee.

Regarding the third inquiry, both the decision on the original petition and the request for more information indicated that an assertion of financial hardship must be supported by a *complete and thorough showing* of the patentee's financial condition during the entire period between July 11, 2004 and October 5, 2009, and both mailings indicated that "income, expenses, tax return statements, bank records, assets, credit and obligations" for this time period would need to be provided. With this response to the request for more information, Petitioner has indicated that the patentee "had no resources of any earned income," however the tax returns indicate that the patentee and her spouse had an adjusted gross income of \$62,096 in 2004, \$68,086 in 2005, \$68,086 in 2006, \$64,621 in 2007, and \$84,831 in 2008. The record is silent as to patentee's expenses, bank records, assets, credits and obligations during the relevant period of time. As such, patentee has not established that her expenses exceeded her income, and patentee has not established that financial hardship precluded her from submitting the maintenance fee in a timely manner.

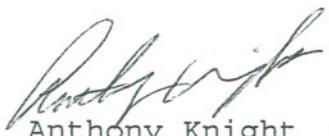
Conclusion

The prior decision which refused to accept, under 37 C.F.R. § 1.378(b), the delayed payment of a maintenance fee for the above-identified patent, has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b).

The surcharge that is associated with the filing of a petition pursuant to 37 C.F.R. § 1.378(b), less the \$400 fee that is associated with the filing of this request for reconsideration of the prior decision, will be refunded to patentee in due course via the mailing of a Treasury check for the amount of \$2430.

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

The application will be forwarded to Files Repository.



Anthony Knight
Director
Office of Petitions

cc: Joanne D. Sigsorth
4713 Dreyfous Ave
Metairie, LA 70006