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APR 16 2012

OFFICE OF PETITIONS

In re Patent No. 6,891,191 :
Issue Date: May 10, 2005 :
Application No. 10/652,959 : DECISION ON PETITION
Filed: September 2, 2003 : UNDER 37 CFR 1.378(b)
Title: ORGANIC SEMICONDUCTOR :
DEVICES AND METHODS OF :
FABRICATION :
Patentee(s): Xiao et al.

This is a decision on the renewed petition under 37 CFR 1.378(b), filed January 4, 2012, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DENIED**.

BACKGROUND

The patent issued May 10, 2005. The 3.5-year maintenance fee could have been paid from May 10, 2008, through November 10, 2008, or with a surcharge during the period from November 11, 2008 through May 10, 2009. Accordingly, the patent expired at midnight May 10, 2009, for failure to timely submit the first maintenance fee.

On October 3, 2011, petitioner Steven Shuyong Xiao (Xiao) filed a first petition to accept an unavoidably delayed payment of the maintenance fee under 37 C.F.R. 1.378(b). Non-payment of the maintenance fee was allegedly unavoidable due to the recent purchase of the patent from the bankrupted company, Organic Vision, Inc.

This petition was dismissed on December 8, 2011 and required that any petition for reconsideration explain with a documented showing the steps in place by patentee(s) to ensure that the fee would be timely paid, and how the system failed in this instance.

The request for reconsideration, filed January 4, 2012, attempted to address this request through the presentation of a Recordation of Assignment from Xiao.

The instant petition from Xiao explains, "As you can see from the enclosed Recordation of Assignment, this patent was purchased from the trustee of the bankruptcy company. I have not received any history about this patent from the trustee of the bankruptcy company at the time of purchasing dated September 30, 2011. Realizing the maintenance fee was overdue, I filed the

petition for unavoidable delayed payment along with the payment of the maintenance fee and payment of surcharge immediately on the same day I purchased this patent, which was the earlier legible date for me to do so.”

The Request for Reconsideration has been considered and the Petition of October 3, 2011 has been reconsidered.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § (2)(B)(2) provides, in part, that:

The Office-- may, establish regulations, not inconsistent with law, which

(A) shall govern for the conduct of proceedings in Office.

35 U.S.C. § 41(c)(1) provides that:

The Director 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 Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director 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 Director 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 1.378(b) provides that:

(b) 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) through (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.

OPINION

Petitioner request reconsideration of the previous adverse decision on the petition filed under 37 CFR 1.378(b) and submits that due to having only recently purchased the patent from a bankrupt company, the expiry of the instant patent is unavoidable.

Petitioner has not met the burden of proving to the satisfaction of the Director that the delay in payment of the maintenance fee was unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b)(3).

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.”

A late 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)(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. Cf. 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's 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 maintenance fee for this patent. Id.

Unfortunately, the record does not show that petitioner Xiao or the previous owner, Organic Vision, Inc., had any steps in place to ensure payment of the maintenance fee at the time it fell due. Rather, the record only shows that petitioner Xiao recently purchased an expired patent from Organic Vision, Inc. No explanation of a docketing and call up system in use, the types of records kept, or any personnel responsible for such a system was provided by petitioner. It has also not been shown that petitioner Xiao has attempted to contact Organic Vision, Inc. to inquire about any steps they may have had in place.

Petitioner Xiao has not demonstrated that Organic Vision, Inc. had any means of tracking and paying the maintenance fee. Delay resulting from the failure of the patent holder to have any

steps in place to pay the fee by either obligating a third party to track and pay the fee, or by itself assuming the obligation to track and pay the fee, is not unavoidable delay. See R.R. Donnelley & Sons Co. v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244, 1247 (N.D. Ill. 2000); Ray, supra; California, supra; Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007).

DECISION

Petitioner has failed to meet the burden of proving to the satisfaction of the Director that the entire delay in submission of the maintenance fee herein was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b). Accordingly, the maintenance fee will not be accepted, this patent will not be reinstated, and this patent remains expired. The petition is **denied**.

The USPTO will not further consider or reconsider this matter. See 37 CFR 1.378(e).

Petitioner should note that the maintenance fees and post expiration surcharge are refundable. Petitioner may request a refund of the fees submitted on September 30, 2011. Please send all requests for refunds to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

Any inquiries concerning this communication may be directed to Petitions Examiner Liana Walsh at (571) 272-3206.



Anthony Knight
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cb/db

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CANADA

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