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MAILED

MAY 10 2010

OFFICE OF PETITIONS

In re Patent of	:	
Eum et al.	:	
Patent No. 6,265,672	:	
Issue Date: 07/24/2001	:	
Application No 09/274290	:	ON PETITION
Filing or 371(c) Date: 03/22/1999	:	
Title of Invention:	:	
MULTIPLE LAYER MODULE STRUCTURE	:	
FOR PRINTED CIRCUIT BOARD	:	

This is a decision on the renewed petition to accept unavoidably delayed payment of maintenance fee in an expired patent (37 CFR § 1.378(e)), filed December 8, 2009.

The petition is **DENIED**.

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

**Background**

The patent issued July 24, 2001. Patentee could have paid the three and one half (3½) year maintenance fee between July 24, 2004, and February 24, 2005, without a surcharge, or within the six (6) month grace period between February 25, 2005 and July 24, 2005. Patentee failed to do so; accordingly, the patent expired on July 25, 2005.

**The October 17, 2007 petition**

Petitioner, registered patent attorney Nathan Kallman, filed the October 17, 2007 petition and explained that the attorney representing the inventor is Eun Sup Won. Statement of Mr. Kallman accompanying petition at p.1. Mr. Won stated in an affidavit that he requested that registered patent attorney Nathan Kallman file the application which issued as the above-identified U.S. Patent. Affidavit of Mr. Won at p.1. Mr. Kallman stated as the U.S. Attorney who prosecuted the present application to issue, he kept listings of U.S. patents issued to his clients, which included issue dates and the dates due for payment of the maintenance fees. Id. Mr. Kallman

stated that his clients are notified accordingly about one month in advance of the due date and authorization for payment is requested if the patent in question is to be maintained. Letters were sent to Mr. Won regarding payment of the maintenance fee. Mr. Kallman next stated that in those cases where no reply was received, a follow-up letter was mailed. In the absence of any response, an assumption had to be made that the patent was allowed to lapse. Mr. Kallman did not state whether a follow-up letter was sent to Mr. Won, but only asserted generally that in those cases where no reply was received, a follow-up letter was mailed, and that in the absence of any response, an assumption had to be made that the patent was allowed to lapse. Statement of Mr. Kallman accompanying petition at p.1.

Mr. Kallman provided that it is his practice not to pay a maintenance fee without proper written authorization. A practice that has been effective and worked well over the years. Mr. Kallman stated his belief that the inventor should not be penalized for circumstances beyond his control. Statement of Mr. Kallman accompanying petition at p.2.

Mr. Won provided that in December 2004, he moved his Office to Seoul, Korea. Mr. Won further provided that “[u]nfortunately, mail which was addressed to the vacated Office was not forwarded. And as a matter of fact, mail to [his] Office and in general often is not delivered.” Affidavit of Mr. Won at p.1. Also, Mr. Won stated, “it is likely that some mail which may have been received by [h]is office during the move was misfiled, misplaced and lost.” Id. Mr. Won stated that he did not receive any notices from Mr. Kallman that the maintenance fee for the present patent was to be paid.

Mr. Won averred that “the circumstances that led to the inadvertent lapse of the patent include the ingredient of human error, when, in the normal course of event[s], is unavoidable.” Finally, Mr. Won asserted that steps have been taken in office procedures to ensure that all payments due, including payments for maintenance fees, are listed and scheduled on a calendar to avoid missing payments when due. Affidavit of Mr. Won at p.2.

### **The March 16, 2009 Requirement for Information**

In response to the petition, this Office mailed a Requirement for Information on March 16, 2009. The Requirement for Information required the surcharge for the petition, and the identification of the party responsible for payment of the maintenance fee. Petitioner was required to clarify whether Mr. Kallman or Mr. Won represented the patent owner at the time the payment of the maintenance fee was due, and was thus responsible to the patent owner for the timely payment of the maintenance fee.

### **Petitioner’s April 17, 2009 response to the Requirement for Information**

In response to the Requirement for Information, Petitioner, Mr. Kallman, stated that the inventors were clients of Mr. Won. Mr. Kallman was engaged by Mr. Won to handle filing and prosecution of the case, and at no time did Mr. Kallman communicate with the inventors. Petitioner stated that authorization for timely payment of the maintenance fee needed to come from the inventors to Mr. Won and then from Mr. Won to Petitioner herein, Mr. Kallman.

**The August 13, 2009 Decision dismissing the petition**

A Decision dismissing the petition was mailed August 13, 2009. The Decision initially noted that Mr. Won was the attorney responsible for ensuring timely payment of the maintenance fee. Prior to the due date for the maintenance fee, Mr. Won stated that in December 2004, he moved his Office to Seoul, Korea. Mr. Won provided that “[u]nfortunately, mail which was addressed to the vacated Office was not forwarded. And as a matter of fact, mail to [his] Office and in general often is not delivered.” Affidavit of Mr. Won at p.1. Also, Mr. Won stated, “it is likely that some mail which may have been received by [h]is office during the move was misfiled, misplaced and lost.” Id. Mr. Won did not provide any information as to what, if any, steps were taken to ensure timely payment of the maintenance fee from the time the maintenance fee was due just prior to expiration of the patent, on July 24, 2005, to the filing of the petition. In this instance, Mr. Kallman had iterated steps that he had in place; however, Mr. Kallman was unable to receive instructions from the person responsible for ensuring timely payment of the maintenance fee - Mr. Won - as to whether to pay the maintenance fee, and Mr. Kallman stated that it is his practice not to pay a maintenance fee without proper written authorization. Mr. Won provided that steps have been taken in office procedures to ensure that all payments due, including payments of maintenance fees, are listed and scheduled on a calendar to avoid missing payments when due; however, what is required is to have had steps in place to ensure timely payment of the maintenance fee. The Decision noted that petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay.

Finally, the Decision noted that a breakdown of communication between the party responsible for payment of the maintenance fee and their client is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard. *See, Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). Petitioner is also advised that, as noted supra, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay.

**The present renewed petition**

Petitioner, attorney Grant D. Kang, files the present renewed petition and for the first time provides that Simm Tech Co., Ltd. (KR) is the assignee of the present patent. Petitioner notes that Eun Sup Won is a registered Korean patent attorney representing the assignee, who in turn retained Mr. Kallman to represent the assignee before this Office to file and prosecute the application.

Petitioner further avers that both Mr. Won and the assignee were clients of Mr. Kallman, and that it was Mr. Won's practice to rely upon due date notices from local attorneys with regard to timely payment of maintenance fees. Petitioner states his belief that by relying upon due date notices from Mr. Kallman, the assignee and Mr. Won exercised reasonable care to ensure that the maintenance fee would be timely paid.

Regarding the breakdown in communication between Mr. Won and Mr. Kallman, petitioner provides that in order to ensure that communication would not break down, Mr. Won promptly sent a notice of his change of address to Mr. Kallman in early January 2005. In addition, Mr.

Won informed the janitor of the building of the previous address to set aside all mailings addressed to his firm, and that Mr. Won visited the building from time to time to pick-up the set-aside mailings. Despite this, petitioner states that for “an unknown reason, the due date notice mail that Mr. Kallman says he sent to Mr. Won was not actually delivered to the old address.” Petition at p. 5. Petitioner avers that “this is obviously a typical example of ‘unexpectedly, or through the unforeseen fault or imperfection’ of the ‘ordinary and trustworthy agencies and instrumentalities of the mail.’” Id.

As to *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995), where the court stated that a breakdown of communication between the party responsible for payment of the maintenance fee and their client is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard, petitioner provides that the patentee in *Ray* voluntarily broke down the communication with the attorney, mistakenly believing that no maintenance fee should be paid, and in *Ray*, no unexpected or unforeseen delivery of mails was involved.

### Applicable Law, Rules and MPEP

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) 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.

37 CFR 1.378(b)/(C) requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required 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. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See 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), *aff’d sub nom. 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 MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) 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 U.S.C. § 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 to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, 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 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was unavoidable, but only an explanation as to why petitioner has failed to carry the 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 Director to affirmatively find that the delay was unavoidable, but only to explain why 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*.

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. *See Patent No. 4,409,763*, *supra*. *See also* Final Rule entitled “*Final Rules for Patent Maintenance Fees*,” published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee’s agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962); *Huston v. Ladner*, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); *see also Haines v. Quigg*, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner’s delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). *Haines*

v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). 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 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

### **Opinion**

Initially, the Office notes that Office records contain no assignment records for the application or for the issued patent.

As to the maintenance fee, Petitioner avers that Eun Sup Won is a registered Korean patent attorney representing the assignee, who in turn retained Mr. Kallman to represent the assignee before this Office to file and prosecute the application. However, there is no documentary evidence to support the assertion that Mr. Kallman was retained to represent the inventors (or putative assignee) before this Office. The record heretofore is that Mr. Won retained Mr. Kallman, and Mr. Kallman was responsible to Mr. Won, and not to the inventors (or putative assignee). Moreover, Petitioner admits that it is a fact that Mr. Kallman did not communicate with the inventors or the assignee, but always with Mr. Won. Petitioner further provides that it was Mr. Won who, on behalf of the assignee and with authorization to do so on behalf of the assignee, communicated with Mr. Kallman. Petition at p.2. Thus the record supports a conclusion that it was Mr. Won who was responsible for the payment of the maintenance fee.

Petitioner further avers that both Mr. Won and the assignee were clients of Mr. Kallman, and that it was Mr. Won's practice to rely upon due date notices from local attorneys with regard to timely payment of maintenance fees. Petitioner states his belief that by relying upon due date notices from Mr. Kallman, the assignee and Mr. Won exercised reasonable care to ensure that the maintenance fee would be timely paid. However, due date notices from Mr. Kallman were received through the mail, and Mr. Won has previously stated in his affidavit filed with the petition on October 17, 2007, that "[u]nfortunately, mail which was addressed to the vacated Office was not forwarded. As a matter of fact, mail to [his] Office and in general often is not delivered." Affidavit of Mr. Won at p.1. Moreover, Mr. Won stated, "it is likely that some mail which may have been received by [h]is office during the move was misfiled, misplaced and lost." Id. As such, reliance upon the mail that is often not delivered, or which may have been received and misfiled, misplaced or lost, for receipt of due date notices from Mr. Kallman fails to demonstrate the exercise of reasonable care to ensure that the maintenance fee would be timely paid.

Regarding the breakdown in communication between Mr. Won and Mr. Kallman, petitioner provides that in order to ensure that communication would not break down, Mr. Won promptly sent a notice of his change of address to Mr. Kallman in early January 2005. In addition, Mr. Won informed the janitor of the building of the previous address to set aside all mailings addressed to his firm, and that Mr. Won visited the building from time to time to pick-up the set-aside mailings. Despite this, petitioner states that for "an unknown reason, the due date notice mail that Mr. Kallman says he sent to Mr. Won was not actually delivered to the old address."

Petition at p. 5. Petitioner avers that “this is obviously a typical example of ‘unexpectedly, or through the unforeseen fault or imperfection’ of the ‘ordinary and trustworthy agencies and instrumentalities of the mail.’” Again, however, it is noted that Mr. Won previously stated in his affidavit filed with the petition on October 17, 2007, that “[u]nfortunately, mail which was addressed to the vacated Office was not forwarded. As a matter of fact, mail to [his] Office and in general often is not delivered.” Affidavit of Mr. Won at p.1. Moreover, Mr. Won stated, “it is likely that some mail which may have been received by [h]is office during the move was misfiled, misplaced and lost.” Id.

In view of the foregoing, the fact that the maintenance fee reminder may not have been delivered to the old address, or may have been lost, misfiled or misplaced, may not be said to have been unexpected or unforeseen, and reliance upon delivery of the mail when patentee admits that mail to his office is often not delivered, may not be said to have been reasonable.

Petitioner has not proven to the satisfaction of the Director the cause of the delay in payment of the maintenance fee was unavoidable. Petitioner has not established that reliance upon a janitor to forward the mail was reasonable. No showing has been made that the janitor was a trustworthy and reliable employee of Mr. Won who could be relied upon to transact business for Mr. Won. Furthermore, it would appear from the record that it is equally likely that correspondence from Mr. Kallman was misfiled, misplaced or lost by Mr. Won’s office. Such actions do not show that the delay in payment of the maintenance fee was unavoidable.

As to *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995), where the court stated that a breakdown of communication between the party responsible for payment of the maintenance fee and their client is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard, petitioner provides that the patentee in Ray voluntarily broke down the communication with the attorney, mistakenly believing that no maintenance fee should be paid, and in *Ray*, no unexpected or unforeseen delivery of mails was involved. However here, the failure of the delivery of the mail was expected and foreseen, and petitioner’s reliance upon receipt of mail from Mr. Kallman in order to ensure timely payment of the maintenance fee represents a failure to exercise reasonable care to ensure timely payment of the maintenance fee.

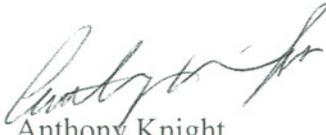
Moreover, in *Ray*, the patentee, Ray, said that he knew of no reason to keep in contact with his representative. Here, while petitioner has not shown any steps that Mr. Won made to attempt to communicate with Mr. Kallman regarding the maintenance fee notice, there appears to have been ample reason for Mr. Won to keep in contact with Mr. Kallman. Unlike Ray, Mr. Won was armed with the knowledge that the mail to his office was not forwarded, and that mail which may have been received by his office during the move was misfiled, misplaced and lost. Mr. Won’s failure to attempt to contact Mr. Kallman regarding the maintenance fee reminder notice that was expected to arrive via the mail, despite Mr. Won’s knowledge of failure of the delivery of the mail, may not be said to demonstrate reasonable care.

**Decision**

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of August 13, 2009 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek Woods at (571) 272-3232.



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