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. 16

THOMAS L. ADAMS
10 PARK PLACE
MORRISTON NJ 07960

COPY MAILED

SEP 3 0 2003

OFFICE OF PETITIONS

In re Application of
David L. Brock
Application No. 07/521,400
Patent No. 5,000,683
Filed: May 10, 1990
Issue Date: March 19, 1991
Attorney Docket No.: DLB101A
Title: PERIODONTAL PROBE

DECISION ON PETITION
PERSUANT TO
37 C.F.R. §1.378(e)

This is a decision on the petition filed on June 26, 2003, under 37 C.F.R. §1.378(e), requesting reconsideration of a prior decision pursuant to 37 C.F.R. §1.378(b)[1], which refused to accept the delayed payment of two maintenance fees for the above-referenced patent.

The request to accept the delayed payment of the maintenance fee is **DENIED**[2].

---

[1] 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) 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.

2 This decision may be regarded as a final agency action withing the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

Background

The patent issued March 19, 1991. The grace period for paying the 7½ year maintenance fee provided in 37 CFR 1.362(e) expired at midnight on March 19, 1999, with no payment received. Accordingly, the patent expired on March 19, 1999.

With the original petition, petitioner, submitted the necessary surcharge, as well as payment in the amount of $1,025.00 and $1,575.00 for the delayed payment of the required 7 ½ and 11 ½ year maintenance fees, respectively. To establish unavoidable delay, petitioner submitted a statement of facts where petitioner places the blame for the failure to submit the maintenance fee on his attorney. A decision was mailed on May 12, 2003 which dismissed this petition.

In response, the present petition under 37 C.F.R. §1.378(e) was filed on June 26, 2003.

Petitioner has failed to meet the third requirement set forth above.

The standard

35 U.S.C. §41(c)(1) states that:

> The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay[3] is shown to the satisfaction of the Director to have been unavoidable.

§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 is generally used and observed by prudent and careful men in relation to their most important business[4].

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."[5] Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."[6]

---

3 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).

4 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).

5 Smith v. Mossinghoff, 671 F.2d at 538, 213 U.S.P.Q. at 982.

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. 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 CFR 1.378(b).

Furthermore, 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, in support of an argument that the delay in payment was unavoidable, evidence is required 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.[7]

Even if the Office were required to provide notice to applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.[8]

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions[9]. Specifically, petitioner's delay caused by the mistakes of negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133[10].

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney[11]."

---

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

7 See MPEP 2590 (Manual of Patent Examining Procedure, Rev, Aug. 1, 2001).

8 See Ray v. Lehman, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, Petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

9 Link v. Wabash, 370 U.S. 626, 633-634 (1962).
10 Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; 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. 103, 131 (Comm'r Pat. 1891).
11 Link at 633-634.

Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions[12]."

The portions of the MPEP relevant to the facts as presented

2504 Patents Subject to Maintenance Fees

37 CFR 1.362. Time for payment of maintenance fees.

(a) Maintenance fees as set forth in § § 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(b) Maintenance fees are not required for any plant patents or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:
  (1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.
  (2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.
  (3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.
  (4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original non-reissue application on which the patent reissued is based.
  (5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:
  (1) 3 years through 3 years and 6 months after grant for the first maintenance fee,
  (2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and
  (3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:
  (1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.
  (2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and
  (3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the

---

12 Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983). See also, Wei v. State of Hawaii, 763 F.2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983).

same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

(h) The periods specified in § § 1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

Maintenance fees are required to be paid on all patents based on applications filed on or after December 12, 1980, except for plant patents and design patents. Furthermore, maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees. Application filing dates for purposes of determining whether a patent is subject to payment of maintenance fees are as follows:

(A) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(B) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119(a)-(d), the actual United States filing date of the application.

(C) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(D) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original nonreissue application on which the patent reissued is based.

(E) For an international application that has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

2506 Times for Submitting Maintenance Fee Payments

37 CFR 1.362(d) sets forth the time periods when the maintenance fees for a utility patent can be paid without surcharge. Those periods, referred to generally as the "window period," are the 6-month periods preceding each due date. The "due dates" are defined in 35 U.S.C. 41(b). The window periods are (1) 3 years to 3 1/2 years after the date of issue for the first maintenance fee payment, (2) 7 years to 7 1/2 years after the date of issue for the second maintenance fee payment, and (3) 11 years to 11 1/2 years after the date of issue for the third and final maintenance fee payment. A maintenance fee paid on the last day of a window period can be paid without surcharge. The last day of a window period is the same day of the month the patent was granted 3 years and 6 months, 7 years and 6 months, or 11 years and 6 months after grant of the patent. 37 CFR 1.362(e) sets forth the time periods when the maintenance fees for a utility patent can be paid with surcharge. Those periods, referred to generally as the "grace period," are the 6-month periods immediately following each due date. The grace periods are (1) 3 1/2 years and through the day of the 4th anniversary of the grant of the patent, (2) 7 1/2 years and through the day of the 8th anniversary of the grant of the patent and, (3) 11 1/2 years and through the day of the 12th anniversary of the grant of the patent. A maintenance fee may be paid with the surcharge on the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant to prevent the patent from expiring. Maintenance fees for a reissue patent are due based upon the schedule established for the original utility patent. The filing of a request for ex parte or inter partes reexamination and/or the publication of a reexamination certificate does not alter the schedule of maintenance fee payments of the original patent. If the day for paying a maintenance fee falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee may be paid on the next succeeding day that is not a Saturday, Sunday, or Federal holiday. For example, if the window period for paying a maintenance fee without a surcharge ended on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee can be paid without surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia. Likewise, if the grace period for paying a maintenance fee with a surcharge ended on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee can be paid with surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia. In the latter situation, the failure to pay the maintenance fee and surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia will result in the patent expiring on a date (4, 8, or 12 years after the date of grant) earlier than the last date on which the maintenance fee and surcharge could be paid. This situation results from the provisions of 35 U.S.C. 21, but those provisions do not extend the expiration date of the patent if the maintenance fee and any required surcharge are not paid when required. For example, if the grace

period for paying a maintenance fee with a surcharge ended on a Saturday, the maintenance fee and surcharge could be paid on the next succeeding business day, e.g., Monday, but the patent will have expired at midnight on Saturday if the maintenance fee and surcharge were not paid on the following Monday. Therefore, if the maintenance fee and any applicable surcharge are not paid, the patent will expire as of the end of the grace period as listed above. A patent that expires for failure of payment will expire on the anniversary date the patent was granted in the 4th, 8th, or 12th year after the grant.

2575 Notices

Under the statutes and the regulations, the Office has no duty to notify patentees when their maintenance fees are due. It is the responsibility of the patentee to ensure that the maintenance fees are paid to prevent expiration of the patent. The Office will, however, provide some notices as reminders that maintenance fees are due, but the notices, errors in the notices or in their delivery, or the lack or tardiness of notices will in no way relieve a patentee from the responsibility to make timely payment of each maintenance fee to prevent the patent from expiring by operation of law. The notices provided by the Office are courtesies in nature and intended to aid patentees. The Office's provision of notices in no way shifts the burden of monitoring the time for paying maintenance fees on patents from the patentee to the Office.

Application of the standard to the current facts and circumstances

In the decision on the previous petition, the reasons for dismissal were set forth as:

Petitioner has set forth that he submitted payment to his attorney for the 7 ½ year maintenance fee along with the associated legal fee, and that his attorney failed to tender this payment to the Office. After receiving a letter from the attorney informing him that the patent had expired for failure to pay the 7 ½ year maintenance fee, petitioner contacted the attorney and was assured that the matter would be taken care of at the expense of the attorney. The next year, petitioner contacted the attorney, and was assured that the matter was taken care of. Three years later, petitioner contacted the Office and discovered that the patent had expired for failure to submit the 7 ½ year maintenance fee.

As is stated above, it is solely the responsibility if the patentee to ensure that maintenance fees are paid in a timely manner; the patent itself states that maintenance fees are due, and, as unfortunate as the result may be; petitioner cannot choose to be represented by counsel and then distance himself from the actions of said counsel.

Even if petitioner could distance himself from the actions of his chosen representative, the granting of this petition would be precluded by the fact that a patentee is charged with the responsibility of assuring that the maintenance fee is timely paid. After being made aware that the 7 ½ maintenance fee was not paid in a timely manner, a similarly situated reasonable man, acting in relation to his most important business, would have checked for himself to see if the maintenance fee had been submitted, and if the patent had been reinstated.

For these reason, acceptance of the delayed payment of the maintenance fee is precluded.

With the instant petition, the petitioner has submitted a statement that "the idea that a reasonable man cannot rely upon the representations of his attorney for assurance that the maintenance fee was paid, is itself extreme and not reasonable[13]". Petitioner is directed to the cases cited in both the decision on the original petition and above in footnotes 9 – 12, which establish that this view is both well settled in case law, commonly accepted, and reasonable.

A statement from the former attorney of record (Mr. Glynn) has also been submitted, which explains that Mr. Glynn contacted the inventor at the time when the first maintenance fee was

13 Petition, page 2.

due, and was told that the inventor had retained alternate counsel. In September of 1998, the inventor sent a check to Mr. Glynn to pay the second maintenance fee. Mr. Glynn assigned this task to an associate in his law firm[14], who waited until the penalty period to handle the matter[15].

In May of 1999 (after the patent had expired for failure to submit the second maintenance fee by March 19, 1999), the inventor contacted Mr. Glynn, regarding the submission of the second maintenance fee. This task was delegated to an associate[16]. The associate then informed Mr. Glynn that the petition had been filed, and the matter had been taken care of when in fact, neither had occurred[17]. Petitioner does not mention any effort to confirm that the matter had been resolved, although he states that he had no way of knowing that the fees had not been paid[18].

Mr. Glynn states that the associate retired with an erroneous statement that his tasks had been completed[19].

Petitioner then places the blame for the abandonment of this patent for failure to submit the maintenance fee partly on "the attorney of record [for] not following through as long as he was (is) of record, and partly because the associate who said that he handled this matter, did not[20]."

Regarding the first assertion, that it is the current attorney of record, and not Mr. Glynn, who is to blame: it was Mr. Glynn, and not the current attorney of record, who accepted money from the inventor, as well as the responsibility (and perhaps a fee) to submit the funds to the Office so as to satisfy the requirement of the 7 ½ year the maintenance fee[21]. Mr. Glynn, thereby, acted as the agent of the principal (the inventor), and then promptly delegated that duty to a sub-agent (the associate). As such, it was not the current attorney of record's duty to ensure that Mr. Glynn had met his accepted responsibility.

Regarding the second assertion, the law of agency governs the relationship between an lawyer and his client[22]. When the inventor retained the petitioner to represent him, an agency was created when the inventor manifested an intention that the other should act on his behalf, and the petitioner consented to represent him[23]. The action of delegating the authority from the agent to a sub-agent constitutes actual authority on the part of the sub-agent to bind the principal. Furthermore, principals are bound by the actions which a subagent does within his or her authority,[24] and the agent is liable for any injury done to the principal by a subagent of the agent[25].

---

14 Petition, page 2, paragraph 4.
15 Id.
16 Id. at paragraph 5.
17 Id.
18 Id.
19 Id.
20 Id.
21 Glynn's declaration, page 2, paragraphs 4-5.
22 Harold Gill Reuschlein & William A. Gregory, The Law of Agency and Partnership §21, at 53 (2d ed. 1990).
23 The Law of Agency and Partnership §12, at 32.
24 The Law of Agency and Partnership §22, at 56, citing McKinnon v. Vollmar, 75 Wis. 82, 43 N.W. 800 (1889). See also The Law of Agency and Partnership §7, at 17 for a general discussion on sub-agency.
25 The Law of Agency and Partnership §22, at 56, citing Klein v. May Stern & Co., 144 Pa. Super. 470, 19 A.2d

Petitioner asserts that the failure was unavoidable because the associate failed to handle the matter, but petitioner is reminded that an agent bears absolute liability to the principal for breaches committed by a sub-agent, as it is the agent who granted authority to the sub-agent to bind the principal. An agent cannot establish a sub-agency, and then assert non-culpability for the errors of the sub-agent.

Furthermore, the actions of an agent are imputed upon the principal. Thus, the actions of the sub-agent flow through the agent and are attributed directly to the principal, as if he himself had committed the action (or in this case, non-action). As such, it follows that a patentee cannot distance himself from the actions of his chosen counsel, even when his chosen counsel delegates his accepted task to a subordinate. Petitioner is, of course, free to label his view as both extreme and not reasonable, but this view flows necessarily from well-settled tenets of agency law.

Furthermore, the failure to submit the maintenance fee was not unavoidable. The failure could have easily been avoided if the associate filed the petition and properly remitted the funds to the Office, the associate did not falsely tell Mr. Glynn that the associate had taken care of the matter, Mr. Glynn looked into the matter to confirm that it had been taken care of, or the inventor contacted the Office to confirm that the maintenance fee had been accepted.

Additionally, Petitioner has not submitted any statements from the associate who handled the matter[26].

Finally, men, acting in relation to their most important business, would have confirmed that the maintenance fee had been accepted, would have confirmed the allegation that the matter had been taken care of, would have taken care of the matter, and would not have falsely indicated that the matter had been taken care of when it had in fact not been handled.

In summary, the showing of record fails to establish that the expiration of the patent was not avoidable, and due care of a reasonably prudent patentee has not been shown. As such, a finding that the delay was unavoidable is precluded.

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).

Since this patent will not be reinstated, the petitioner is entitled to a refund of the surcharge, the 7 ½ year maintenance fee, and the 11 ½ year maintenance fee. If the petitioner wishes to have

---

566 (1941). See also The Law of Agency and Partnership §80, at 135 (an agent is liable to the principal for injury caused the principal by a sub-agent).

26 In paragraph 5 of his declaration, Mr. Glynn indicates that an associate handled the matter, and incorrectly represented to the declarant that the matter had been handled.

these monies refunded, he should submit a request for refund to the Office of Finance[27]. A copy of this decision should accompany any such request.

As stated in 37 C.F.R. §1.378(e), no further reconsideration or review of this matter will be undertaken.

Telephone inquiries should be directed to Attorney Paul Shanoski at (703) 305-0011.

Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

cc: David L. Brock
3 Noble Court
Long Valley, NJ 07853

27 The Refund Branch processes all customer requests for refunds. It generally takes four to six weeks for a request to be processed and a check generated. All requests for refund should be sent to: Mail Stop 16, Director of the US Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450. Office hours are Monday - Friday from 8:30 AM to 5:00 PM. To check the status of a request that has been filed please contact the Refund Branch directly at 703-305-4229.