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Paper No. 41

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COPY MAILED

MAR 11 2009

OFFICE OF PETITIONS

In re Patent of :
STANLEY ROKICKI :
Patent No.: 5647172 :
Issue Date: 07/15/1997 :
Application No. 08/048590 :
Filing or 371(c) Date: 04/19/1993 :
Title of Invention: :
PULTRUDED FIBERGLASS FRAMING :
SECTIONS :

ON PETITION

This is a decision on the petition under 37 CFR § 1.378(b), filed July 8, 2008, to reinstate the above-identified patent.

The petition is **DENIED**.

Background

The patent issued July 15, 1997. Petitioner/Patentee could have paid the seven and one half (7½) year maintenance fee between July 15, 2004, and January 15, 2005, without a surcharge, or within the six (6) month grace period between January 16, 2005 and July 15, 2005. Petitioner/Patentee failed to do so; accordingly, the patent became expired on July 16, 2005.

The July 8, 2008 petition

Petitioner filed a petition to reinstate the present patent on July 8, 2008, wherein Petitioner asserted that the reason for the delay in payment of the maintenance fee was because he never received any statement from the USPTO for the maintenance fee amount due, and that the lawyer who represented the Petitioner for the patent no longer represented Petitioner for this service.

The September 4, 2008 Decision dismissing the petition

The petition was dismissed in a Decision mailed September 4, 2008. The Decision dismissing the petition noted initially that the patentee's lack of knowledge of the need to pay the

maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay.

The Decision also informed Petitioner that 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. As such, Petitioner may not rely upon the failure to receive a maintenance fee reminder to justify unavoidable delay in paying the maintenance fee. The Decision noted that 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 does not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. The Decision informed Petitioner that 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 that did not include receipt of maintenance fee reminders from this Office.

As to the second reason given for failing to timely pay the maintenance fee - the lawyer who represented the Petitioner for the patent no longer represented Petitioner for this service - The Decision advised Petitioner that a delay caused by the actions or inactions of a duly authorized and voluntarily chosen representative, does not constitute unavoidable delay. Petitioner therefore, was unable to rely upon a delay caused by the actions or inactions of its attorney to support an assertion that payment of the maintenance fee was unavoidable. While Petitioner may have an issue with his attorney, the Decision noted that this Office is not the proper venue for resolving such issues.

Finally, the Decision stated that the law requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. With the July 8, 2008 petition, Petitioner stated that he was unaware of the need to pay the maintenance fee, and had not demonstrated that any steps were taken to ensure timely payment of the maintenance fee. The Decision reiterated that 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).

The present request for reconsideration

Petitioner files the present request for reconsideration and states that the law firm previously responsible for payment of the maintenance fee withdrew from representation of Petitioner in a letter dated March 7, 2003. The letter also informed Petitioner that the due date for the second maintenance fee was January 15, 2005. Petitioner emphasizes that the request to withdraw from representation of Petitioner included instructions for this Office to forward all future correspondence regarding the present patent to Petitioner herein.

Petitioner also notes that he is unfamiliar with the rules of practice, and believed that reminders to pay the maintenance fee would be sent to him by this Office. *Petition* at p.2. Petitioner admits that neither he nor his company docketed or maintained any calendar system for the January 15, 2005 due date for payment of the maintenance fee. *Id.* Petitioner provides that it was a licensee who informed Petitioner that the present patent had expired, and Petitioner thereafter immediately filed the petition to reinstate the present patent.

Applicable Law, Rules and MPEP**Petition to reinstate under 37 CFR 1.378(b)**

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.

The applicable law 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.

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).

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

Petitioner emphasizes that the request to withdraw from representation of Petitioner included instructions for this Office to forward all future correspondence regarding the present patent to Petitioner herein. Petitioner notes that he is unfamiliar with the rules of practice, and believed that reminders to pay the maintenance fee would be sent to him by this Office. *Petition* at p.2.

Regarding Petitioner's stated unfamiliarity with the rules of practice, a review of the copy of the letter sent to petitioner dated March 7, 2003, wherein the law firm withdrew from representation of Petitioner, reveals that the law firm withdrew from representation due to Petitioner's failure to pay his outstanding accounts for services rendered up to the date of the mailing of the letter. Petitioner is advised that it is his responsibility to either retain counsel to prosecute his application, or to familiarize himself with the laws, rules of practice and MPEP. An Applicant who elects to proceed in prosecuting his application without an attorney steps into the shoes of the attorney. The rules of practice do not diverge depending upon whether one is an attorney or an applicant appearing before this Office in proper person. It is Applicant's obligation to inform himself about the obligations associated with prosecuting his application. See, California Med. Prods. V. Tecnol Med., 921 F.Supp 1219 (D. Del. 1995).

Moreover, and as stated above, 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). 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.

The standard requires Petitioner to demonstrate that he took steps to ensure timely payment of the maintenance fee. Petitioner admits, and as confirmed by the copy of the letter he received from his former representatives, that he was made aware of the due date for the maintenance fee. However, Petitioner, by his own admission, did not take any steps to ensure timely payment of the maintenance fee. Petitioner, in fact, admits that despite being informed of the maintenance fee due date, neither he nor his company docketed or maintained any calendar system for the January 15, 2005 due date for payment of the maintenance fee. Instead, Petitioner relied upon this Office to remind Petitioner of the maintenance fee due date. Under the statutes and rules, however, 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.

Petitioner stated that he believed that reminders to pay the maintenance fee would be sent to him by this Office. This belief was based upon instructions included in the letter to this Office requesting permission to withdraw as attorney. The letter included instructions for this Office to forward all future correspondence regarding the present patent to Petitioner. However, 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). Moreover, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence. Finally, 37 CFR 1.4(c) admonishes that since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Here, the instructions for this Office to forward all future correspondence regarding the present patent to Petitioner were included in the letter to this Office requesting permission to withdraw as attorney.

As stated in the Decision dismissing the July 8, 2008 petition, 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).

Decision

The present petition under 37 CFR 1.378(e) is granted to the extent that the decision of November 20, 2007 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.

A handwritten signature in black ink, appearing to read "Charles Pearson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Charles Pearson
Director
Office of Petitions