nor a lack of proper communication between petitioner and his legal representative, constituted unavoidable delay.

The instant petition was filed May 1, 2000.

STATUTE AND REGULATION

35 U.S.C. § 41(b) states in pertinent part that:

> The Commissioner shall charge the following fees for maintaining in force all patents based on applications filed on or after December 1, 1980:
>
> (1) 3 years and 6 months after grant, $940[2].
>
> (2) 7 years and 6 months after grant, $1,900.
>
> (3) 11 years and 6 months after grant, $2910.
>
> Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent shall expire as of the end of such grace period.

35 U.S.C. § 41(c)(1) states that:

> "The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section... after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable."

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

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[2] Maintenance fees in effect as of the date the first petition was filed on April 26, 1999. The fees may be subject to an annual adjustment on October 1, see 35 USC 41(f), and are reduced by 50% for, as here, a small entity, see 35 USC 41(h)(1).

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

The Commissioner may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable"; 35 USC 41(c)(1).

Petitioner (Karl King, president and CEO of WNCK, who became successor in title after payment of the first maintenance fee) requests reconsideration, asserting that the delay is unavoidable since petitioner was unaware of the need to pay maintenance fees, and that while his former counsel Lee G. Meyer had docketed the patent for payment of the fee, Meyer did not act on the information. That is, Meyer assumed that since petitioner's subsequently hired litigation counsel Kenneth E. Kuffner had the file, Kuffner had therefore taken the obligation, and, as such, Meyer deleted this patent from his docket.

Petitioner has not met his burden of proving to the satisfaction of the Commissioner 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).

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.

Petitioner, as patent holder, was ultimately responsible for payment of the maintenance fee. As such, it was incumbent upon petitioner to implement steps to schedule and pay the fee, or obligate another to make the payment. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Since petitioner admittedly remained unaware of the need to track maintenance fee payments, it is clear that petitioner could not have directly obligated Meyer in this matter, or that petitioner himself had any steps in place. However, in the absence of any steps taken, 37 CFR 1.378(b)(3) precludes acceptance of the belated maintenance fee. Ray, supra. That Meyer may have continued to track the maintenance fee due dates for this patent is not seen to inure to the benefit of petitioner. In this regard, Meyer was both a registered practitioner and the president of the former assignee of the entire interest. However, Meyer's interest in this patent ended with the transfer of title to petitioner. There is no evidence that Meyer was tracking the payment on behalf of petitioner, or that Meyer realized that he might have been relied upon by petitioner for that purpose. It follows that petitioner was not prudent in assuming that Meyer had been obligated in this matter. See R.R. Donnelley & Sons v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244 (N.D. Il. 2000). As such, petitioner has not shown the diligence of a prudent and careful person with respect to payment of the maintenance fee, which now precludes its acceptance on petition. Id. That petitioner's failure to have any steps in place or obligate another in this matter may have been due to petitioner's lack of knowledge of the need to pay the maintenance fee does not excuse the delay, or render the delay unavoidable. Rather, it is well settled that "all persons are charged with knowledge of the provisions of the statutes and must take note of the procedure adopted by them." Rydeen, 748 F.Supp at 907, 16 USPQ2d at 1881(quoting North Laramie Land Co. v. Hoffman, 268 U.S. 276, 285, 69 L.Ed. 953, 45 S.

Ct. 491 (1925)).

Furthermore, the instant 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 the record is not clear as to whether petitioner read the Maintenance Fee Notice upon gaining his ownership 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. Ray, 55 F.3d at 610, 34 USPQ2d at 1789. The mere publication of the statute was sufficient notice to petitioner. Rydeen, supra.

However, while Meyer asserts that he had in fact docketed this patent for payment in his docketing system, this does not provide petitioner with a showing of unavoidable delay. Id. Rather, this merely shifts the inquiry from petitioner to whether Meyer acted reasonably and prudently. Id. However, petitioner is bound by any mistakes that Meyer may have made. Id. In this case, Meyer nullified any steps that were in place, by deleting this patent from his docketing system, in his belief that he was no longer obligated in this matter. If Meyer overlooked any duty that he may have owed petitioner in this matter, then petitioner is reminded that the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner 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); California, supra. Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133. Haines v. Quigg, supra; 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). Thus, even if Meyer's steps should, or would, inure to the benefit of petitioner, Meyer's decision that he was not operating on behalf of petitioner and thus, to delete the fee payment from his docketing system, is likewise binding on petitioner.[3]

Petitioner is advised that the Office is not the proper forum for resolving a dispute between a patentee and that patentee's representative as to who bore the responsibility for scheduling and payment of maintenance fees. Ray, 55 F.3d at 610, 34 USPQ2d at 1789. Nevertheless, delay resulting from a lack of proper communication between a patentee and that patentee's representative as to the responsibility for scheduling and payment of a maintenance fee does not constitute unavoidable delay within the meaning

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[3] Petitioner and litigation counsel Kuffner are in agreement that petitioner did not engage Kuffner to track the maintenance fee for this patent.

of 35 USC 41(c) and 37 CFR 1.378(b). See, In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). Specifically, delay resulting from a failure in communication between a registered practitioner and his client regarding a maintenance fee payment is not unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). Ray, Id. That any or all of Meyer, Kuffner, and petitioner may have failed to take adequate steps to ensure that each fully understood the other party's meaning, and thus, their own obligation in this matter, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business.

Even assuming *arguendo* that petitioner should not be bound by the mistakes of his representative, the record does not support a finding of unavoidable delay, as petitioner has not shown adequate diligence in this matter. That is, a showing of diligence in matters before the USPTO on the part of the party in interest is essential to support a finding of unavoidable delay herein. See Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988)(applicant's diligent inquiry into the status of the application is required to show unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his duly appointed representative); Donnelley, supra (failure of successor in title to the patent to exercise diligence for a period of seven years precluded acceptance of the maintenance fee). The delay was not unavoidable, because had petitioner exercised the due care of a reasonably prudent person, petitioner would have been able to act to correct the situation in a more timely fashion. Haines v. Quigg, supra; Douglas, supra; Donnelley, supra..

While petitioner notes that Meyer did not receive any correspondence from the USPTO regarding this patent, petitioner is reminded that a party does not have had a right to personalized notice that this patent would expire if the maintenance fee was not paid, as the publication of the statute was sufficient notice. See Rydeen 749 F.Supp at 907, 16 USPQ2d at 1882. Rather, the ultimate responsibility for keeping track of maintenance fee due dates lies with the patentee, not the USPTO. Id. Since the inception of maintenance fees, the USPTO has maintained that it has no duty to notify patentees when their maintenance fees are due, and that the lack of any USPTO notice will in no way shift the burden of monitoring the time for paying the maintenance fees from the patentee to the USPTO. Further, such lack of notice will not constitute unavoidable delay under the statute. Rydeen, 748 F.Supp at 905, 16 USPQ2d at 1880. Rather, the requirement for notice is only set forth in 35 USC 133 (and § 151), and is not found in 35 USC 41(c)(1) or 37 CFR 1.378(b)(3). Ray, 55 F.3d at 609, 34 USPQ2d at 1788; Rydeen, supra.

DECISION

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

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

Since this patent will not be reinstated, the maintenance fee, surcharge, and excess fees remitted by petitioner totaling $1800 will be refunded by Treasury check in due course. The $130 fee under 37 CFR 1.17(h) for requesting reconsideration is not refundable.

The patent file is being returned to the Files Repository.

Telephone inquiries regarding this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

M. C. Antonakas

Manuel A. Antonakas, Director,
Office of Petitions