



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. 47

FINNEGAN, HENDERSON, FARABOW,
GARRETT AND DUNNER
1300 I ST., N.W.
WASHINGTON DC 20005-3315

COPY MAILED

FEB 29 2008

OFFICE OF PETITIONS

In re Application of	:	
Maurice Moncany et al.	:	
Application No. 08/160,465	:	
Patent No. 5,688,637	:	DECISION ON RENEWED PETITION
Filed: December 2, 1993	:	PURSUANT TO 37 C.F.R.
Issue Date: November 18, 1997	:	§ 1.378(E)
Attorney Docket No.:	:	
2356.006201	:	
Title: NUCLEOTIDE SEQUENCES	:	
DERIVED FROM THE GENOME OF	:	
RETROVIRUSES OF THE HIV-1, HIV-	:	
2 AND SIV TYPE, AND THEIR USES	:	
IN PARTICULAR FOR THE	:	
AMPLIFICATION OF THE GEMOMES OF	:	
THESE RETROVIRUSES AND FOR THE	:	
IN VITRO DIAGNOSIS OF THE	:	
DISEASE DUE TO THESE VIRUSES	:	

This is a decision on the renewed petition filed on May 11, 2007, pursuant to 37 C.F.R. § 1.378(e)¹ requesting

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

reconsideration of a prior decision pursuant to 37 C.F.R. §1.378(b), which refused to accept the delayed payment of maintenance fees for the above-referenced patent.

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

The patent issued on November 18, 1997. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on November 18, 2001, with no payment received. Accordingly, the patent expired on November 18, 2001 at midnight.

An original petition pursuant to 37 C.F.R. § 1.378(b) was submitted on July 10, 2006, and was dismissed via the mailing of a decision on March 13, 2007.

With this renewed petition, the requirements of 37 C.F.R. § 1.378(b)(3) have not been satisfied.

A discussion follows.

The standard

35 U.S.C. §41(c)(1) states:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay³ 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 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:

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 within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

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).

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 business⁴.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account⁵." 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

Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client⁷ in the absence of evidence that the attorney/agent has acted to deceive the client.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 inactions⁹. Specifically, Petitioner's delay caused by the mistakes of negligence of his

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.

6 Haines v. Quigg, 5 USPQ2d 1130 (N.D. Ind. 1987), 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

7 The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

8 When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

9 Link v. Wabash, 370 U.S. 626, 633-634 (1962).

voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133¹⁰. 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 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."

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."

Docketing error

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay.

Such a showing should identify the specific error¹³, the individual who made the error, and the business routine in place for performing the action that resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions

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.

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).

13 Petitioner must identify the error that caused the delay. If the specific error cannot be identified, Petitioner must identify any and all possible causes and prove that any of them, if they were the true cause, constitute unavoidable delay. A full and complete discussion for each possible error must be presented. Petitioner is reminded that the burden of proof rests with Petitioner.

carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (1) the error was the cause of the delay at issue,
- (2) a business routine was in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and;
- (3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See MPEP 711.03(c)(III)(C)(2).

An adequate showing should include (when relevant):

- (1) statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them;
- (2) a thorough explanation of the docketing and call-up system in use;
- (3) identification of the type of records kept;
- (4) identification of the persons responsible for the maintenance of the system;
- (5) copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing;
- (6) an indication as to why the system failed in this instance, and;
- (7) information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

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 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.

Application of the standard to the current facts and circumstances

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge.

The period for paying the 3½-year maintenance fee without the surcharge extended from November 18, 2000 to May 18, 2001 and for paying with the surcharge from May 19, 2001 to November 18,

2001. Thus, the delay in paying the 3½-year maintenance fee extended from November 18, 2001 at midnight to the filing of the original petition pursuant to 37 C.F.R. § 1.378(b) on July 10, 2006.

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 C.F.R. 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 C.F.R. §§1.378(b) and/or (e).

With the original petition, Petitioner identified the error that was the cause of the delay at issue, the persons responsible for the maintenance of the system, and a copy of the record that would substantiate an error in docketing.

In the original petition, Petitioner indicated that she is an attorney at the law firm of Finnegan, Henderson, Farabow, Garrett and Dunner, LLP (Finnegan), and that the present patent is assigned to a French entity by the name of Institut Pasteur (Assignee). The Assignee uses the French firm of Ernest Gutmann-Yves Plasseraud S.A.S. (Gutmann) as French counsel, and the firm of Finnegan as U.S. counsel.

Finnegan commonly receives Institut Pasteur applications both from Gutmann and from the Assignee directly. The patent issued on November 18, 1997, and the three maintenance fees were docketed in the Finnegan docketing system. On March 6, 2001, Ms. Eastwood sent a maintenance fee reminder letter to Ms. Moysan of Gutmann, requesting instructions on how the maintenance fee should be handled. On April 17, 2001, Mr. Montuclard of Gutmann responded to the latter mailing via facsimile transmission - the fax consisted of a copy of the latter, with a stamp placed thereon, signed by Mr. Montuclard and containing the following text:

Annuity/Maintenance fee is to be handled by computer annuity service. Please remove from your annuity calendar. Thank you.
ERNEST GUTMANN - YVES PLASSERAUD S.A. (emphasis included) DATE:
APR 17, 2001.

See Exhibit 4 and Eastwood declaration, paragraph 5.

In reliance on this communication, Ms. Eastwood followed the directions contained therein, and removed the payment deadlines from Finnegan's docketing system. Consequently, Finnegan did not send a reminder letter, and the maintenance fee was not paid in a timely manner.

Petitioner has asserted that Mr. Montuclard sent the response and erroneously instructed Finnegan to remove the present patent from the Finnegan docketing system, because one of his assistants was suffering from an unspecified medical condition and she had fallen behind in her work, creating a large backlog in the annuities department, and due to this backlog, the letter of March 6, 2001 was not "handled properly"¹⁴.

In short, Petitioner asserted that due to Ms. Duval's illness, she was not able to carry out her job duties, and consequently, the maintenance fee was not submitted in a timely manner due to Mr. Montuclard's erroneous instruction for Petitioner to remove the present patent from Finnegan's docketing system.

Petitioner's submission on renewed petition has been considered, and it does not appear that the requirements of 37 C.F.R. § 1.378(b)(3) have been satisfied.

First, Petitioner has not sufficiently identified the reason why Mr. Montuclard erroneously instructed Petitioner to refrain from submitting the maintenance fee. Petitioner has determined why the maintenance fee was not timely submitted, and has identified the responsible party - however neither Petitioner nor the responsible party has not been able to discern **why** this erroneous instruction was issued.

On page 38 of the renewed petition, Petitioner sets forth that Mr. Montuclard "may have inadvertently placed the stamp saying the maintenance fee was to be handled by a computer annuity service," "it is possible" that he issued this erroneous instruction because he thought that Gutmann would handle the annuities, and that "he may have made this error because" most of the maintenance fees for this assignee were handled by an entity other than Petitioner (emphasis added).

¹⁴ Renewed petition, page 11.

Mr. Montuclard has set forth "...my signature is shown below the stamp. It appears that I handled this correspondence¹⁵" and that "I really have no recollection today of what really happened in this matter¹⁶."

In other words, neither Petitioner nor Mr. Montuclard can identify the reason why this erroneous instruction was made. Both she and Mr. Montuclard are able to proffer mere supposition and conjecture as to the reason why Petitioner was instructed to forego the submission of the maintenance fee.

Secondly, the decision on the original petition indicated:

Petitioner has failed to provide statements by all persons with direct knowledge of the circumstances surrounding the delay. The failure to submit the maintenance fee in a timely manner, as set forth by Petitioner, stems from the alleged medical incapacitation of Ms. Duval. However, it does not appear that a statement from Ms. Duval has been provided.

...

Similarly, it does not appear that any medical documentation has been provided which would substantiate the alleged medical incapacitation of Ms. Duval; e.g., it does not appear that a statement has been provided from Ms. Duval's treating physician, providing the nature and degree of the incapacitation during the relevant time period. As such, the allegation of a medical incapacitation amounts to mere supposition and conjecture.

On renewed petition, Petitioner has asserted "because Ms. Duval's illness only had an indirect effect on the error in question, it is not believed necessary to provide her direct testimony herein." Petitioner has thus established that the primary reason that the maintenance fee was not submitted in a timely manner was Mr. Montuclard's erroneous instruction to Finnegan for them to remove the present patent from their docketing system, however as developed above, the reason for this erroneous instruction has not been identified.

The decision on the original petition indicated that Petitioner would need to describe Ms. Duval's function in Gutmann's Annuities Department. The decision set forth "it is not clear what actions she may or may not have taken, which led to Mr. Montuclard placing this stamp on the facsimile transmission."

¹⁵ Montuclard declaration of facts, paragraph 5.

¹⁶ Id. at 11.

On renewed petition, Petitioner has set forth that this requirement cannot be met. Due to French law, Petitioner is unable to "provide a declaration from Ms. Duval relating to the circumstances surrounding Ms. Duval's work¹⁷." Additionally, Petitioner has set forth that Ms. Duval and Gutmann entered into a contract which mandates that the latter "cannot render public by declaration the detailed circumstances surrounding Ms. Duval's work¹⁸." As such, Petitioner has set forth that Ms. Duval's function within the Annuities Department must be kept secret.

In short, it has been repeatedly asserted that Ms. Duval's illness reduced the amount of work that she was generating for the Annuities Department, and this created a backlog in the entire department. However, since Petitioner has not revealed precisely what role Ms. Duval played in the workings of the Annuities Department, the Office cannot discern why her falling behind could have resulted in Mr. Montuclard's erroneous instruction for Finnegan to refrain from submitting the maintenance fee payment. Consequently, causation between these two events has not been established, and it follows that Petitioner is not in a position to adequately explain the reason why this patent became expired.

Third, the decision on the original petition indicated that Petitioner had failed to provide a thorough explanation of the docketing and call-up system in use. The Assignee relied on Gutmann to track the maintenance fee, which in-turn relied on Finnegan to track the maintenance fee. However, the docketing system of Finnegan does not appear to have been explained in either the original petition or this renewed petition. On renewed petition, Petitioner has asserted that Finnegan has a docketing system in place, however this docketing system has not been adequately explained. Petitioner has not provided a thorough explanation of Finnegan's docketing and call-up system, or identified the type of records kept or the persons responsible for the maintenance of this system.

Fourth, the decision on the original petition indicated that it has not been established that Gutmann failed to receive the Maintenance Fee Reminder sent by Finnegan, and as such, it is

17 Renewed petition, page 19 and Andral-Ziurys supplemental declaration, paragraphs 29-31.

18 Renewed petition, page 19 and Andral-Ziurys supplemental declaration, paragraph 31.

not clear why the receipt of the Maintenance Fee Reminder failed to apprise Gutmann that something was amiss. With this renewed petition, Petitioner has characterized this requirement as an "undue burden," and has indicated that Gutmann does not keep a mail log of "all incoming mail received in its office¹⁹." Contrary to Petitioner's assertion, this is not an undue burden. The PTO has a well-established and well-publicized practice of providing a method for applicants and patent holders to establish the non-receipt of a particular piece of communication. This method is delineated in both M.P.E.P. § 503 and Delgar v. Schuyler, 172 USPQ 513 (D.D.C. 1971). Due to the fact that Gutmann does not maintain the requisite mail log, it is clear that Petitioner will not be able to meet the Delgar requirements, and therefore will not be able to establish that this correspondence was not received.

Conclusion

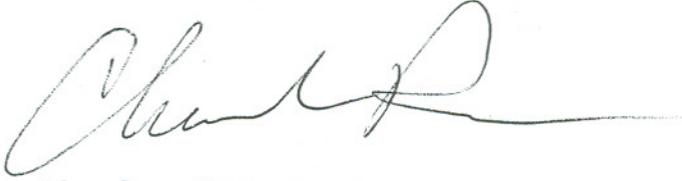
The requirements of 37 C.F.R. § 1.378(b)(3) have not been satisfied. The burden of establishing that the entire period of delay was unavoidable rests with Petitioner, and this showing has not been made. Consequently, the Office cannot accept the delayed payment of the 3½ and the 7½-year maintenance fees, and this petition cannot be granted.

The prior decision that refused to accept, pursuant to 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, Petitioner is entitled to a refund of the surcharge and both the 3½ and the 7½-year maintenance fees, but not the \$400 fee associated with the filing of a renewed petition under 37 C.F.R. § 1.378(e). These fees will be refunded to Petitioner's Deposit Account in due course.

¹⁹ Renewed petition, page 41.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225²⁰.

A handwritten signature in cursive script, appearing to read 'Charles Pearson', written in dark ink.

Charles Pearson
Director
Office of Petitions

²⁰ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.