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APR 29 2009

OFFICE OF PETITIONS

In re Patent No. 6,641,138 :
Issue Date: November 4, 2003 :
Application No. 10/117,403 : ON PETITION
Filed: April 8, 2002 :
For: ORIGINAL JAKE AND THE PANCAKE :
GAME :

This decision is in response to the written inquiries concerning the above-identified patent received May 15, 2008, May 23, 2008, June 3, 2008, June 5, 2008, June 6, 2008, and June 9, 2008. These inquiries are being treated as a petition under 37 CFR 1.378(e).

The petition is DENIED¹.

BACKGROUND

This patent expired on November 4, 2007 for failure to pay the 3.5 year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

A petition under 37 C.F.R. § 1.378(c) to accept late payment of the maintenance fee was filed January 14, 2008. A decision dismissing the petition under 37 CFR 1.378(c) was mailed March 28, 2008. The petition submitted January 14, 2008 was dismissed for failure to submit the required surcharge of \$1,640.00. Petitioner submitted a surcharge in the amount of \$65.00. Petitioner was advised that any request for reconsideration must include the required \$400.00 petition fee and the required \$1,640.00 surcharge.

Petitioner did not include the required petition fee or surcharge with any of the multiple inquiries referenced above.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. *See*, MPEP 1002.02.

In accordance with 35 USC 41(c)(1), “[t]he Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.”

In accordance with 37 CFR 1.378(c), “[a]ny petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include: (1) The required maintenance fee set forth in § 1.20 (e) through (g); (2) The surcharge set forth in § 1.20(i)(2); and (3) A statement that the delay in payment of the maintenance fee was unintentional.”

FACTS

Petitioner asserts that he was unaware that he was required to pay the maintenance fee. Petitioner further asserts that he did not receive notice from the USPTO that the maintenance fee was due. Petitioner asserts that he was told verbally by USPTO personnel that the surcharge was \$65.00. Petitioner further asserts that he was verbally told by USPTO personnel that he did not have to pay the \$400.00 petition fee. Petitioner further asserts that he cannot afford to pay the required surcharge of \$1,640.00.

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been “unavoidable.”² Moreover, a late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, i.e., “unavoidable” delay³. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable⁴. Further, decisions on revival are made on a “case-by-case basis, taking all the fact and circumstances into account⁵.” Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petition has failed to meet his or her burden of establishing the cause of the unavoidable delay⁶.

² 35 U.S.C. 41(c)(1).

³ See, Ray v. Lehman, 55 F3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988)).

⁴ See, 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), Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (Comm’r Pat. 1913).

⁵ See, Smith v. Mossinghoff, 671 F.2d 533, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁶ See, Haines v. Quigg, 673 F.Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner asserts he did not know that he had to pay a maintenance fee. In general, the Letters Patent itself discloses the maintenance fee requirement. Moreover, notice of the requirement to submit maintenance fees is well publicized and is provided in 37 CFR 1.362 which states in pertinent part that "(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."

Petitioner asserts non-receipt of a USPTO maintenance fee reminder. Under the statutes and rules, the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. Failure to receive the reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. The Office will attempt to assist patentees through the mailing of a Maintenance Fee Reminder in the grace period. However, the failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b)⁷.

Petitioner is further advised that a delay caused by an patentee's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to reliance upon oral advice from USPTO employees⁸.

While the Office is sympathetic to petitioner, who asserts he cannot afford the required surcharge of \$1,640.00, the surcharge, nevertheless, is a prerequisite prior to reinstatement of a patent that expired unintentionally.

DECISION

The prior decision dismissing petition under 37 CFR 1.378(c) to accept delayed payment of maintenance fee has been reconsidered. For the reasons set forth herein, specifically, failure to submit the required surcharge and the required petition fee, the delay in payment of the maintenance fee cannot be regarded as unintentional within the meaning of 35 USC 41 and 37 CFR 1.378(c). Accordingly, the offer to pay the delayed maintenance fee without the required surcharge and petition fee will not be accepted and this patent will not be reinstated.

Petitioner may request a refund of the previously submitted maintenance fee of \$465.00 by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund. It is noted that the previously submitted surcharge of \$65.00 was previously refunded.

⁷See, *In re Patent No. 4,409,763*, 7 USPQ2d 1798 (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).

⁸See, *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985)

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Telephone inquiries concerning this matter may be directed to the Petitions Attorney Alesia M. Brown at 571-272-3205.

A handwritten signature in dark ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson
Director
Office of Petitions