



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER OF  
PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Paper No. 24

Dority & Manning, Attorneys at Law, P.A.  
PO Box 1449  
Greenville SC 29602-1449

**COPY MAILED**

**MAR 31 1998**

OFFICE OF PETITIONS  
A/C PATENTS

In re Patent No. 4,901,387 :  
Issue Date: February 20, 1990 :  
Application No. 07/170,819 :  
Filed: March 21, 1988 :  
Attorney Docket No: SAM-MISC :

ON PETITION

This is a decision on the petition under 37 CFR 1.378(e), filed October 24, 1997, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The request to accept the delayed payment of the maintenance fee under 37 CFR 1.378(b) is DENIED.

#### BACKGROUND

The patent issued February 20, 1990. Accordingly, the first maintenance fee due could have been paid during the period from February 20, 1993, through August 20, 1993, or with a surcharge during the period from August 21, 1993 through February 20, 1994. Since the maintenance fee was not timely paid, the patent expired on February 21, 1994.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on May 30, 1997, and was dismissed in the decision of August 25, 1997.

The instant petition under 37 CFR 1.378(e) was filed on October 24, 1997. The eight-year maintenance fee was paid on August 18, 1997.

#### STATUTE AND REGULATION

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 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."

Manual of Patent Examining Procedure, Section 2542, Revision 1 (September, 1995) states, in part:

Unless a fee address has been designated, all notices, receipts, refunds, and other communications relating to the patent will be directed to the correspondence address used during the prosecution of the application...The correspondence address should be updated or changed as necessary to ensure that all communications are received in a timely manner.

In addition, MPEP Section 2560 states, in part:

It should be noted that an assignment does not act as a revocation of power of attorney for authorization previously given.

#### OPINION

The Commissioner may accept late payment of the maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. § 41(c)(1).

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" 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 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, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). 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, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner urges that the decision of August 25, 1997 be reconsidered, arguing that the actions of the prior assignee, American Health Systems, Inc. (AHS) absolves Span-America Medical Systems (Span-America) of the late payment of the maintenance fee. Specifically, Petitioner argues that the deliberate decision of the attorney for AHS not to pay the maintenance fee in response to a reminder notice because AHS no longer owned the patent requires any non-payment by Span-America to be excused as unavoidable. Furthermore, Petitioner questions whether the attorney for AHS knew that the patent had been assigned to Span-America years before the maintenance fee was due because such assignment was part of a confidential settlement agreement.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Assuming, *arguendo*, that AHS did not pay the maintenance fee because it was not their patent and did not forward the reminder notice to Span-America because they hoped that the patent would lapse, as apparently argued by petitioner, these facts are immaterial to whether the delay in payment of the maintenance fee was unavoidable. Span-America, not AHS or their attorney, had the obligation to pay the maintenance fee and to ensure that the necessary steps were taken to ensure timely payment of the fee. An assignment does not act as a revocation of a power of attorney. See Manual of Patent Examining Procedure (MPEP), Section 2560. Span-America should have changed the fee address with the PTO for the above-identified patent at the time that the assignment was recorded. See MPEP, Section 2542. More importantly, however, Span-America should have considered who would be paying the maintenance fee for the patent at the time it acquired the patent. Clearly any newly acquired patent should be treated differently than a patent which had been prosecuted by Span-America's patent counsel and it should have been expected that the recipients of mail in regard to the patent may not have

known the proper party to contact on behalf of Span-America, even if the recipient was inclined to forward a reminder notice. A reminder notice, is after all, simply a courtesy letter from the PTO, and only communicates information of which a patent owner should already be aware.

Accordingly, Span-America's lack of receipt of any maintenance fee reminder does not constitute "unavoidable" delay. See Patent No. 4,409,763, supra, aff'd, 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 also "Final Rules for Patent Maintenance Fees," 49 Fed. Reg. 34716, 34722-23 (Aug. 31, 1984), reprinted in 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). It is solely the responsibility of the owner of the patent to assure that the maintenance fee is timely paid to prevent expiration of the patent.

As 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.

The record fails to establish that the assignee Span-America took any steps to ensure timely payment of the maintenance fee as required by 37 CFR 1.378(b)(3). In fact, the record indicates that no steps were taken to ensure timely payment of the maintenance fee. Since no steps were taken by the assignee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

#### CONCLUSION

The prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41 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, it is appropriate to refund the 4 and 8-year maintenance fees and surcharge fee

submitted by petitioner. Petitioner may obtain a refund of these fees by submitting a request, accompanied by a copy of this decision, to the Office of Finance,

Telephone inquiries relevant to this decision should be directed to Karin Tyson at (703) 305-9282.



Manuel A. Antonakas, Director  
Office of Patent Policy Dissemination  
Office of the Deputy Assistant Commissioner  
For Patent Policy and Projects

kt/ah