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Allegretti & Witcoff, Ltd.
10 South Wacker Drive
Chicago, IL 60606

In re Patent No. 4,977,718
Issue Date: December 18, 1990
Application No. 07/352,756
Filed: May 16, 1989
Inventor: Dennis Hoffman, Sr.

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: SPECIAL PROGRAMS OFFICE
: DAC FOR PATENTS
: ON PETITION
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This is a decision on the petition, filed April 22, 1998 and supplemented on May 29, 1998, under 37 CFR 1.378(e) requesting reconsideration of a prior decision which refused to accept under § 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 is DENIED.

BACKGROUND

The patent issued December 18, 1990. Accordingly, the first maintenance fee due could have been paid during the period from December 20, 1993 (December 18, 1993 being a Saturday) through June 20, 1994 (June 18, 1994 being a Saturday), or with a surcharge during the period from June 21, 1994 through December 19, 1994 (December 18, 1994 being a Sunday). The above identified patent expired as of midnight, December 18, 1994.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on September 19, 1997, and was dismissed in the decision of February 18, 1998.

The instant petition under 37 CFR 1.378(e) requesting reconsideration of the decision of February 18, 1998 was filed April 22, 1998 and supplemented May 29, 1998. Accompanying the instant petition were: a change of name and correspondence address (which is unacceptable as detailed later in this decision); a file jacket record of the instant patented file from Baker & McKenzie; an explanation of the docketing system of David Roche (Roche); the listing of information docketed in the old system of Baker & McKenzie; the agreement between Computer Packages, Inc (CPI) and Baker & McKenzie; the CPI Patent System User Manual; a listing of clients which use CPI patent systems;

and the new (i.e. CPI) docketing system of Baker & McKenzie which illustrates the docketing of the instant patent for second and third maintenance fees. The supplement to the petition, filed May 29, 1998, includes a letter from Ann Rafferty of CPI to Roche indicating that CPI does not have the diskettes of the original data to be transferred to the new (i.e. CPI) docketing system.

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."

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).

Acceptance of late payment of a 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).

Petitioner continues to assert that the switching of docketing systems in 1994 caused the instant patented application to have been erroneously removed from its first maintenance fee docketing. Further, petitioner asserts that it failed to receive the Reminder to Pay Maintenance Fee and the Notice of Patent Expiration due to the failure of petitioner's counsel, Baker & McKenzie (Baker), to file a power of attorney and change of correspondence address.

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable.

With regard to the failure of Baker to file a power of attorney and change of correspondence address, it is the duty of the applicant or his duly authorized representative to keep the Patent and Trademark Office (PTO) apprised of the current correspondence address. MPEP 601.03. Hence, Baker's failure to timely notify the PTO of the change in correspondence address and power of attorney is not a cause for unavoidable delay. Further, the power of attorney submitted with the instant petition is not acceptable, particularly since it was not authorized by the assignee in accordance with 37 CFR 3.73(b). As such, the change of correspondence address has not been changed.

The record reflects that the patentee relied upon Baker for the payment of the maintenance fees of the above identified patent. However, such reliance per se does not provide patentee with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c). See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259. (D.Del. 1995).

Rather, such reliance merely shifts the focus of the inquiry from patentee to whether his duly appointed attorneys had acted reasonably and prudently. *Id.* Nevertheless, patentee is bound by any errors that may have been committed by his duly appointed representatives. *California, supra.* As such, assuming that patentee had engaged Baker for payment of the maintenance fees of the above identified patented file, then it is incumbent upon patentee to demonstrate, via a documented showing, that Baker had docketed this patent for the first maintenance fee payment in a reliable tracking system. *Id.* However, the showing of record is insufficient to establish that the above identified patent was docketed in a reliable tracking system for payment of the first maintenance fee, particularly since critical documents, which were requested in the previous decision of February 18, 1998, have not been provided in the instant petition.

Of particular note, petitioner has not provided proof that Baker had provided to CPI data regarding the first maintenance fee for the above identified patent for input into the new system. That is, there is no proof that the original docketing system included an entry for the payment of the first maintenance fee of the above identified patent when this old system was given to CPI. While Exhibit C has established that the above identified patent was docketed for second and third maintenance fees under the old system, the exhibit fails to indicate if the patent was originally docketed for the first maintenance fee. Further, petitioner has not provided an explanation of the procedure employed to ensure that data was completely and accurately transferred or, in the alternative, explain why no procedures were employed.

Also of interest, petitioner has asserted that in about September of 1994, CPI was provided with a complete and correct copy of the WordPerfect database (declaration of Susan Leo at ¶ 6). Presumably, petitioner was still operating under the old (i.e. WordPerfect) system in December of 1993, when the first maintenance fee could have been paid, and June of 1994, when payment of the first maintenance fee with a surcharge was due. As such, if the above identified patent was docketed for payment of the first maintenance fee in the old system, then the old system should have shown that the maintenance fee could have been paid in December of 1993, or paid with a surcharge in June of 1994. However, no records to that effect have been provided. Assuming the CPI system was in use in November of 1994, petitioner should have also provided docket reports from the CPI system from December of 1994 to show that the above identified patent was not docketed for payment of the first maintenance fee.

The record fails to adequately evidence that Baker exercised the due care observed by prudent and careful men, in relation to their most important business, to establish unavoidable delay. Pratt, supra.

CONCLUSION

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 the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b).

Since this patent will not be reinstated, the maintenance fee and the surcharge fee submitted by petitioner on September 15, 1997 (i.e. \$1,255) will be refunded to deposit account 02-0400. Further, deposit account 02-0400 has been charged the \$130 fee under 37 CFR 1.17(h) which is required for consideration of the renewed petition pursuant to 37 CFR 1.378(e). As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.

Further correspondence will be directed to the address of record; 37 CFR 1.33(d). Accordingly, a new power of attorney or change of address from the assignee should be submitted. The assignee must comply with the requirements of 37 CFR 3.73(b).

Telephone inquiries regarding this decision should be directed to Mike Peffley at (703) 305-9176 or, in his absence, to Brian Hearn at (703) 305-1820.



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

cc: David I. Roche
Baker & McKenzie
130 E. Randolph Drive
Chicago, IL 60601