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Paper No. 15

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OFFICE OF PETITIONS

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| In re Application of | : | |
| QUENTIN G. MONTE, JR. | : | |
| Application No. 08/354,472 | : | DECISION ON RENEWED PETITION |
| Patent No. 5,508,685 | : | PURSUANT TO |
| Filed: December 12, 1994 | : | 37 C.F.R. § 1.378(E) |
| Issued: April 16, 1996 | : | |
| Attorney Docket Number: M9401 | : | |
| Title: VEHICLE AND DEVICE | : | |
| ADAPTED TO REVIVE A FATIGUED | : | |
| DRIVER | : | |

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.378(b), filed by the sole inventor on October 1, 2008, to reinstate the above-identified patent.

This renewed petition pursuant to 37 C.F.R. § 1.378(e) is **DENIED.**¹

Alternate Method of Seeking Relief

Petitioner may wish to consider filing a petition under the unintentional standard, 37 CFR §1.378(c),² along with the

¹ 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.

² A grantable petition pursuant to 37 CFR §1.378(c) must be accompanied by:
(1) The maintenance fee as set forth in 37 CFR §§1.362(e) and 1.20
(2) The surcharge for accepting a maintenance fee after expiration of a patent for non-timely payment of a maintenance fee, as set forth in 37 CFR § 1.20;

11½-year maintenance fee (currently set at \$2,055 for a small entity) and the surcharge (currently set at \$1640, with no reduction for small entity status). Petitioner should be made aware that the standard associated with a petition filed under this section is far less stringent than the standard associated with a delay asserted to be "unavoidable". As the requirements of 37 CFR § 1.378(b) are more exacting than the corresponding requirements of 37 CFR § 1.378(c), a petition under the former is significantly less likely to be grantable as filed than is a petition under the latter. A blank form which can be used in filing a petition under 37 CFR § 1.378(c) may be found at: <http://www.uspto.gov/web/forms/sb0066.pdf>.

DECISION

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 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.

The patent issued on April 16, 1996. The grace period for paying the 11½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on April 16, 2008, with no payment received. Accordingly, the patent expired on April 16, 2008 at midnight.

An original petition pursuant to 37 C.F.R. § 1.378(b) was filed on June 12, 2008, and was dismissed via the mailing of a decision on July 14, 2008. The decision indicated that neither

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- (3) A statement that the delay was unintentional from a proper party in interest, and;
 - (4) The petition must be filed within 24 months of the date of expiration.

the surcharge that is associated with the filing of a petition pursuant to 37 C.F.R. § 1.378(b), nor the maintenance fee had been received.

A renewed petition pursuant to 37 C.F.R. § 1.378(e) was filed on August 25, 2008, along with the surcharge that is associated with the filing of a petition pursuant to 37 C.F.R. § 1.378(b), the 1½-year maintenance fee, and the surcharge that is associated with the filing of a renewed petition pursuant to 37 C.F.R. § 1.378(e). A request for more information was mailed on September 10, 2008.

A response to the request for more information was received on October 1, 2008.

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. Rule 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is 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:

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 business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁴

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).

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.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable⁵."

The burden of showing the cause of the delay is on the person seeking to revive the application.⁶

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.⁷

The portion of the MPEP that is relevant to the present petition is contained in the attached Appendix.

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, as set by 35 U.S.C. § 41(c) and 37 CFR § 1.378(b)(3).

The period for paying the 11½-year maintenance fee without the surcharge extended from April 16, 2007 to October 16, 2007, and for paying with the surcharge from October 17, 2007 to April 16, 2008. Thus, the delay in paying the 11½-year maintenance fee extended from April 16, 2008 at midnight to the filing of the response to the request for more information on October 1, 2008.

The request for more information set forth the following inquiries:

1. The renewed petition does not contain a description of the steps Petitioner had in place for tracking the due date for the 11½-year maintenance fee. What steps, if any, did Petitioner have in place?

Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

5 Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

6 Id.

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

2. Petitioner has indicated that in 2007 and 2008, his wife suffered from various health problems. The causality between his wife's health problems and his failure to timely submit the maintenance fee is not readily apparent. How are these health problems relevant to Petitioner's failure to timely submit the 11½-year maintenance fee?

Regarding the first point above, the response to the request for more information has been reviewed, and it is silent as to any steps that were in place that would ensure the timely submission of the 11½-year maintenance fee.

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). As such, the record does not support a finding that the entire period of delay was unavoidable.

Regarding the second point above, with the response to the request for more information, Petitioner has indicated that his "wife's condition was more critical than [his],"⁸ and has indicated that he suffered from a plurality of medical conditions during the relevant time period, which included "some memory loss."^{9, 10} While the U.S. Patent and Trademark Office is not unmindful of Petitioner's condition, the response does not establish a causal link between the health problems of Petitioner's wife to Petitioner's failure to timely submit the 11½-year maintenance fee.

In accordance with the provisions of 37 C.F.R. § 1.378(e), no further consideration of this matter will be made under 37 C.F.R. § 1.378(b); Petitioner may petition under the unintentional standard of 37 C.F.R. § 1.378(c).

8 Response to request for more information, page 2.

9 Id. See also medical documentation included with the response to the request for more information, numbered page 14 (it is noted that this documentation predates the relevant time period).

10 No statement from Petitioner's attending physician has been provided that would establish that Petitioner suffered from memory loss during the relevant time period.

Conclusion

The prior decision that refused to accept, under 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 both the \$1955 maintenance fee and the \$700 surcharge that were submitted with the original petition, but not the \$400 fee associated with the filing of a renewed petition pursuant to 37 C.F.R. § 1.378(e). A treasury check will be issued in due course.

Telephone inquiries should be directed to Senior Attorney Paul Shanowski at (571) 272-3225.

The application will be forwarded to Files Repository.

A handwritten signature in cursive script, appearing to read 'Charles Pearson', followed by a long horizontal flourish.

Charles Pearson
Director
Office of Petitions

APPENDIX

The portion of the MPEP relevant to the facts as presented

MPEP 2575 sets forth, *in pertinent part*:

Under the statutes and the regulations, the Office has no duty to notify patentees when their maintenance fees are due. It is the responsibility of the patentee to ensure that the maintenance fees are paid to prevent expiration of the patent. The Office will, however, provide some notices as reminders that maintenance fees are due, but the notices, errors in the notices or in their delivery, or the lack or tardiness of notices will in no way relieve a patentee from the responsibility to make timely payment of each maintenance fee to prevent the patent from expiring by operation of law. The notices provided by the Office are courtesies in nature and intended to aid patentees. The Office's provision of notices in no way shifts the burden of monitoring the time for paying maintenance fees on patents from the patentee to the Office.