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In re Patent No. 6,406,076 :
Issue Date: June 18, 2002 :
Application No. 09/481,061 :
Filed: January 11, 2000 :
Attorney Docket No. ADF-0006 :

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.378(e), filed January 23, 2008 requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent.

The petition to accept the delayed payment of the maintenance fee and reinstate the above-identified patent is **DENIED**.

BACKGROUND

The above-identified patent issued on June 18, 2002. The first maintenance fee could have been paid during the period from June 18, 2005 through December 18, 2005, or with a surcharge during the period from December 19, 2005 through June 18, 2006. The first maintenance fee for the above-identified patent was not timely paid. Accordingly the above-identified patent expired at midnight on June 18, 2006.

A petition under 37 CFR 1.378(c) was filed January 9, 2007 and was dismissed in the decision of June 22, 2007. A petition under 37 CFR 1.378(e) was then filed on August 23, 2007 and was dismissed in the decision mailed November 23, 2007. The instant renewed petition under 37 CFR 1.378(e) was filed on January 23, 2008. The instant petition under 37 CFR 1.378(e) requests reconsideration of the decision of November 23, 2007, and acceptance of the delayed payment of a maintenance fee for and reinstatement of the above-identified patent. Petitioner, Vincent Zarzycki, Jr., contends that it was a miscommunication between petitioner's counsel and petitioner's father, Vincent Zarzycki, Sr. that caused the non-payment of the first maintenance. Mr. Zarzycki, Jr. contends that at all times he desired for the patent to remain in force.

Petitioner requests reconsideration in that Mr. Zarzycki, Sr., who made the decision to not pay the maintenance fee, was not a person who had the right or authority to make the decision to pay or not pay the maintenance fee.

STATUTE AND REGULATIONS

35 U.S.C. 41(c)(1) provides that:

The 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.

37 CFR 1.378(a) provides that:

The Director may accept the payment of any maintenance fee due on a patent after the expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by 37 CFR 1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the condition set for the in 35 U.S.C. 41(c)(2).

37 CFR 1.378(c) provides that:

- (c) Any petition to accept 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 provide in §1.362(e) and must include:
- (1) The required maintenance fee set forth in §1.20(e)-(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.

OPINION

Petitioner asserts that the decision to not pay the first maintenance fee was made by a person who did not have the authority to make such a decision (Zarzycki, Jr. Dec. Pet of 1/23/08, para. 9). In December of 2005, a paralegal at the firm of Woodcock Washburn LLP (WW) attempted to contacted petitioner for permission to pay the first Patent

maintenance fee. Instead of talking to the petitioner, Vincent Zarzycki, Jr., the paralegal talked to his father, Vincent Zarzycki, Sr. Mr. Zarzycki, Sr. instructed the paralegal not to pay the maintenance fee (Pet. 8/23/07, page 3, first two full paragraphs). A follow up email to Mr. Zarzycki was sent by the paralegal to an e-mail address used by petitioner's company, American Door and Frame, Inc. (ADF). (No distinction was made in the e-mail greeting to indicate that there was more than one Mr. Zarzycki.) This e-mail address was open and available for use by other individuals at ADF (Zarzycki, Jr. Dec. 8/22/07, para. 12).

Mr. Zarzycki, Sr. is the founder of ADF and he and two of his sons operate the business. Vincent Zarzycki, Jr. is one of those two sons (Zarzycki, Sr. Dec. Pet. 8/22/07, para. 1-3). Mr. Zarzycki, Jr. indicates he was never contacted or told about the phone call or email concerning payment of the maintenance fee (Zarzycki, Jr. Dec. Pet. 8/22/07, para. 11). Petitioner's argument is that when Mr. Zarzycki, Sr. gave instructions by telephone to not pay the maintenance fee, he was not authorized to make such decisions and thus was not the party having the right or authority to reply. Petitioner cites M.P.E.P. §711.03(c)II.E for support for this position. Petitioner asserts that the decision to not pay the maintenance fee was made by a person with no authority to make such decisions and thus the delay in paying the maintenance fee was, in fact, unintentional. Petitioner therefore asserts that he is entitled to reinstatement of the above-identified patent pursuant to 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c).

The "unavoidable" standard in 35 U.S.C. §41(c)(1) is identical to the "unavoidable" standard in 35 U.S.C. § 133 for reviving an abandoned application because 35 U.S.C. § 41(c)(1) uses the same language (i.e., "unavoidable" delay). See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787, (Fed. Cir. 1995) (citing In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988) aff'd, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990)). Likewise, the "unintentional" standard in 35 U.S.C. §41(c)(1) is the same as the "unintentionally" standard in 35 U.S.C. §41(a)(7) because 35 U.S.C. §41(c)(1) uses the same word ("unintentional"), albeit in a different part of speech (i.e., the adjective "unintentional" rather than the adverb "unintentionally"). With regard to the "unintentional" delay standard:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b).... An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office, or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59, 1203 Off. Gaz. Pat. Office 63, 86 (discussing the meaning of unintentional" delay in the context of the revival of an abandoned application). Whether the extant situation involves an application that is abandoned or a patent that has lapsed is not significant since the standards of review in each situation are the same as set forth above.

35 U.S.C. § 41(c)(1) authorizes the Director to accept a delayed maintenance fee payment "if the delay is shown to the satisfaction of the Director to have been unintentional." 35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was intentional, but only an explanation as to why the petitioner has failed to carry the burden to establish that the delay was unintentional. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F. 2d 594, 597, 124 USPQ 126, 128 (D.C. cir. 1960) (35 U.S.C. §133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing); see also In re Application of G, 11 USPQ2d 1378, 1380 (comm'r Pat. 1989) (petition under 37 CFR 1.137(b) denied because the applicant failed to carry the burden of proof to establish that the delay was unintentional).

Petitioner has failed to carry its burden of proof to establish to the satisfaction of the Director that the delay in payment of the first maintenance fee for the above-identified patent was unintentional within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(c).

The decision to not pay the maintenance fee that was due was made by petitioner's counsel, WW. WW contacted the person they thought had authority to make decisions with respect to the maintenance fee and permission was not granted. Based on that information, WW intentionally did not pay the maintenance fee.

WW was petitioner's attorney at the time the maintenance fee could have been paid. WW was a party with authority to make this decision. Petitioner has attempted to show that the decision was made by Mr. Zarzycki, Sr. but as indicated by petitioner, Mr. Zarzycki, Sr. did not have authority to make any decisions regarding the patent. The fact that WW made an intentional decision based on information given by someone who was allegedly not in a position to make such decisions is not relevant to the issue here. In fact, it would appear that Mr. Zarzycki, Sr. would be such a person given his previous communications with WW on his son's behalf. Mr. Zarzycki, Sr. had communicated instructions to WW before and there appears to be no reason for WW to doubt the veracity of Mr. Zarzycki, Sr.'s statement that the maintenance fee should not be paid. Given that all contact information such as phone number and email address went to a location that was accessible by both by Mr. Zarzycki, Sr. and Jr. and Mr. Zarzycki, Sr. has acted as a conduit for instructions to WW, there is no persuasive showing that the delay in payment of the maintenance fee was unintentional.

DECISION

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of November 23, 2007 has been reconsidered; however, the petition to accept under 37 CFR 1.378(c) the delayed payment of a maintenance fee and reinstate the above identified patent is **DENIED**.

Since the above identified patent will not be reinstated, the \$450 maintenance fee and \$1,640 surcharge submitted by petitioner have been refunded to counsel's deposit account No. 23-3050.

As stated in 37 CFR1.378(e), no further reconsideration or review of this matter will be undertaken.

This patent file is being forwarded to the Files Repository.

Telephone inquires concerning this matter may be directed to Petitions Examiner Carl Friedman at (571) 272-6842.

A handwritten signature in black ink, appearing to read "Charles A. Pearson". The signature is written in a cursive style with a long horizontal flourish at the end.

Charles A. Pearson
Director, Office of Petitions