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MARSHALL, O'TOOLE, GERSTEIN, MURRAY & BORUN
6300 SEARS TOWER
233 SOUTH WACKER DRIVE
CHICAGO, IL 60606-6402

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OFFICE OF PETITIONS
A/C PATENTS

In re Patent No. 4,897,600 :
Issue Date: January 30, 1990 :
Application No. 07/122,201 :
Filed: November 13, 1987 :
Inventor(s): Hagmann et al. :

ON PETITION

This is a decision on the petition, filed January 30, 1998 and resubmitted February 9, 1998, under 37 CFR 1.378(b) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$130 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted above, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

The patent issued January 30, 1990. The first maintenance fee could have been paid during the period from February 1, 1993 (January 30, 1993 being a Saturday), through July 30, 1993, or

with a surcharge during the period from August 2, 1993 (July 31 being a Saturday) through January 31, 1994 (January 30, 1994 being a Sunday). Accordingly, this patent expired at midnight of January 30, 1994 for failure to timely pay the maintenance fee. 37 CFR 1.362(g).

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).

Petitioner states that he had retained Harry W. Barron (Barron) to handle all matters regarding the patent including docketing and paying the maintenance fees. When petitioner learned in late 1997 that Barron had been disbarred, and was unable to make contact with Barron, petitioner hired current counsel who determined that the patent had lapsed for failure to timely pay the first maintenance fee. Based on these facts, petitioner states that the delay in payment of the first maintenance fee was unavoidable. Declarations by petitioner and their current counsel, and a copy of Barron's disbarment notice, have been supplied to support petitioner's statement. No other evidence to support petitioner's position has been provided.

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

A late 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 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).

While petitioner states that Barron was to provide general representation in the area of patent law including the docketing and payment of maintenance fees, no evidence of such an agreement has been submitted. In any further petition, petitioner must submit evidence of such an agreement in order to show that Barron was responsible for tracking and paying maintenance fees.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, at 608-609, 34 USPQ2d at 1787. A reasonably prudent patent holder would have exercised due care and diligence to ensure that adequate steps were taken to timely submit the maintenance fee. The record fails to adequately evidence that petitioner exercised the due care and diligence observed by prudent and careful persons, in relation to their most important business. Pratt, supra. This failure precludes a finding of unavoidable delay. The showing of record fails to indicate that petitioner took any steps to set up a maintenance fee docketing and payment system, or that an agreement was reached with Barron to do so. The fact that Barron's address was the correspondence address of record is not dispositive on the issue of who was responsible for maintenance fee payments. In any renewed petition petitioner must include copies of any documents establishing that petitioner had, in place, steps to ensure timely payment of the maintenance fee.

Petitioner should note, however, that any renewed petition must establish with a documented showing: (1) who was responsible for maintenance fee payment, and (2) what steps were emplaced by that party to ensure timely payment. Currently, the showing of record fails to document that petitioner had engaged anyone to track and pay the maintenance fee payment.

If petitioner had reached an agreement with Barron to establish a maintenance fee docketing and payment system petitioner must submit evidence of such. If such an arrangement can be established by petitioner, it must be shown that Barron acted as a reasonable and prudent person in maintaining a maintenance fee docket. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the client, and client is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable

delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Ouigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). If petitioner actually relied on Barron, evidence that prudent and adequate steps were taken by Barron to schedule and timely submit the maintenance fee must be provided. California, supra. Petitioner should ask Barron to provide declarations and evidence pertaining to the maintenance fee docketing and payment system in place regarding the patent. Accordingly, petitioner should send a copy of this decision by registered or certified mail (return receipt requested) to Barron, with a transmittal letter stating that the Patent and Trademark Office is requesting a statement in this matter, and setting a ONE (1) MONTH period for him to reply. If Barron cannot be reached, or declines to make a statement, then documentary proof of service on Barron is required for any renewed petition.

Delay resulting from petitioner's lack of receipt of any maintenance fee reminder(s), or petitioner's being unaware of the need for maintenance fee payments, does not constitute "unavoidable" delay. See Patent No. 4,409,763, supra, aff'd, Rydeen v. Ouigg, 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). Under the statutes and regulations, 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. While the Office mails maintenance fee reminders strictly as a courtesy, it is solely the responsibility of the patentee to ensure that the maintenance fee is timely paid to prevent expiration of the patent. The Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While the record is not entirely clear as to whether or not petitioner ever received the letters patent, or read the Notice, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

Further, petitioner has not shown diligence as required for a showing of unavoidable delay under Pratt, supra. Petitioner has asserted that Barron did not act prudently and failed in those matters entrusted to him by petitioner, and has provided evidence of Barron's eventual disbarment. However, the fact that almost

four years passed from the time the first maintenance fee could last have been paid with a surcharge, until petitioner's discovery of Barron's failure, indicates that petitioner did not demonstrate diligence or act as a reasonably prudent person. Further, any negligence of Barron did not discharge the duty of petitioner to exercise diligence, and diligence on the part of petitioner is essential to show unavoidable delay. See, Douglas v. Manbeck, 21 USPQ2d 1697, 1700 (E.D. Pa 1991) (petitioner's lack of diligence over a two and one half year period overcame and superseded any negligence on the part of his registered practitioner). Likewise, petitioner's unsubstantiated assertion that Barron had been obligated to ensure that the maintenance fees were paid cannot be said to show that petitioner acted as a reasonably prudent person. Specifically, while petitioner chose to rely upon Barron, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c). See California, supra. Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether Barron acted reasonably and prudently. Id. Nevertheless, petitioner is bound by any errors that may have been committed by Barron. California, supra.

In any renewed petition, petitioner must provide evidence of any action taken to ensure that Barron was fulfilling his obligations to petitioner with regard to patent matters, and in particular the payment of maintenance fees. Petitioner states that he received billings from Barron. Copies of these billings and in particular copies of any billings for maintenance fee payments should be provided in any renewed petition. It is brought to petitioner's attention, however, that the Office is not the proper forum for resolving disputes between patentees and their representatives. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

Petitioner's address is different from the address of record in this file. As a one-time courtesy, this decision is being mailed to petitioner's current address as it is apparent that Barron no longer acts for petitioner. However, all further correspondences will be directed solely to the address of record; 37 CFR 1.33(d). Accordingly, a change of address should be submitted. If the submission is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b).

Should petitioner not renew this petition, or if such is renewed and not granted, then petitioner may request a refund of the maintenance fees and post-expiration surcharge. The \$130 for requesting reconsideration is not refundable.

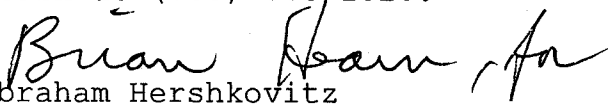
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA

Telephone inquiries should be directed to Mark S. Graham at (703) 305-9177, or in his absence, to Special Projects Examiner Brian Hearn at (703) 305-1820.


Abraham Hershkovitz
Director, Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects