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DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

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OFFICE OF PETITIONS

In re Patent of :
Scott Pullen :
Application No. 09/795,184 : DECISION
Filed: February 27, 2001 : ON PETITION
Patent No. RE 37,824 :
Issued: September 3, 2002 :
Title of Invention: :
POWER OPERATED TAPE MEASURE :

This is a decision on the Petition for Reconsideration Under 37 C.F.R. § 1.378(b), to reinstate the above-identified patent, filed April 17, 2006, and on the "Reply to Requirement for Information Regarding Petition for Reconsideration Under 37 C.F.R. § 1.378(b)", filed August 8, 2006. The petition and Reply to Requirement for Information are properly treated as a petition under 37 C.F.R. § 1.378(e).

The petition under 37 CFR 1.378(e) is **DENIED**.

Background

The patent is a reissue of Patent Number 5,875,987, issued March 2, 1999. The three and one-half (3½) year maintenance fee could have been paid from March 2, 2002, through September 2, 2002, or with a surcharge during the period from September 3, 2002, to March 2, 2003. Petitioner did not do so. Accordingly, the patent expired March 3, 2003.

The December 9, 2005 Petition

Patentee filed a petition on December 9, 2005, and asserted that the maintenance fee reminder was never received. Patentee (A.K.A. "Petitioner") also asserted that he used a computer software program's electronic calendar to manage appointments, reminders and various notifications, including the setting of automatic reminders of the maintenance fee payment dates;

however, Patentee's software crashed on more than one occasion, causing the patentee to lose the previously set automated reminders. Patentee asserted that his reliance upon the automated reminder system showed reasonable care and steps were taken by the Patentee. Patentee also asserts that the loss of data due to the computer crashes and the failure to receive maintenance fee payment notifications from this Office led to the expiration of the patent, and he immediately undertook steps to pay the maintenance fee upon learning that the patent was expired.

February 15, 2006 Corrected Decision Dismissing the Petition

The petition was dismissed in a Decision mailed February 15, 2006. The Decision dismissing the petition informed Patentee that the lack of knowledge of the need to pay maintenance fees and the failure to receive courtesy Maintenance Fee Reminders does not constitute unavoidable delay. The Decision also informed Patentee that his reliance upon a computer system that he knew on more than one occasion, had crashed, causing the Patentee to lose data, failed to demonstrate the actions of a prudent and careful person in relation to their most important business. See February 15, 2006 Decision.

The April 17, 2006 Petition for Reconsideration

Patentee filed a petition for reconsideration on April 17, 2006, and explained that there were two computer crashes. Patentee asserted that before and after the first computer crash Patentee took appropriate precautions; however, despite prudent and careful steps to rely upon an automated system, including reasonable reliance on backup files stored off-machine, the pertinent data regarding the maintenance fee payment dates was lost after the first computer crash. See Petition for Reconsideration at p.2.

More specifically, Patentee asserted that he used the Microsoft Calendar feature of Windows 98SE Operating system to track and provide maintenance fee reminders. Patentee stated that he also backed-up his maintenance fee reminder data onto a floppy disk. Patentee asserted that he initially verified the successful exportation of data onto the floppy disk. Thereafter he had no indication that any data was not successfully exported to the backup disk. Id., at pp.3, 4. Further, Patentee did not periodically check or verify whether data was actually exported and saved to his backup disk.

Patentee filed a copy of the exterior of the disk putatively used to export data, as Exhibit A, and noted that the dates that backups were performed were written on the disk label.

Patentee stated that in mid-November, 2001, the computer system experienced its first crash. Patentee averred that he was able to restore the computer to operational status after the crash, but his attempts to import data from the backup floppy disk failed.

Patentee thereafter resorted to manually entering data from his personal memory. Patentee stated that the fourth year maintenance fee payment was entered into the computer on or about two and a half years before the first crash (mid-November, 2001), or around July, 1999¹. Petition for Reconsideration at p.5. Patentee, through hindsight, now realizes that it was at this time (the first crash), that the maintenance fee reminders were dropped (or lost) from his system².

Patentee asserts that he first learned of his failure to pay the maintenance fee from a letter sent by the sole licensee of his reissue patent on December 7, 2005, and refers back to the December 9, 2005 petition for more details on how the Patentee became aware of the expiration of the patent. Petition for Reconsideration at p.9.

A second review of the December 9, 2005 petition reveals that Patentee therein averred that he first learned that the payment window for the first maintenance fee closed when he received a letter from his licensee dated December 7, 2005. The letter was directed to Paul Cervelli, Esq., and was forwarded that day to the Patentee. See, December 9, 2005 Petition at p.5.

Patentee alleges that he reasonably relied upon his personal computer's electronic calendar to inform him of the due dates for the maintenance fee payments, and his reliance on that calendar to prompt action was also reasonable. Patentee asserts that the facts support a finding that the Patentee, a *Pro Se* patentee, had only a basic understanding of the maintenance fee requirements and therefore had no basis to consider the matter

¹The original patent application, 09/795,184, of which this patent is a reissue, issued in March 2, 1999.

²Patentee also now, with the filing of the December 9, 2005 petition to reinstate the patent, specifically recalls setting maintenance fee reminders for dates on or about March 2, 2002, March 2, 2006 and March 2, 2010, because he had not previously set a date in his electronic calendar that far into the future. Pullen Declaration at p.5.

of maintenance fees any further, after initially docketing the maintenance fee dates in his computer. Upon learning of the expiration of the patent on December 7, 2005, Patentee asserts that he acted with great speed to file his petition.

A review of the December 9, 2005 petition and exhibits reveal that Patentee attempted to license his patent throughout 2002 and 2003 and entered into a licensing agreement (Exhibit J4), in March 2004, approximately one year after his patent had expired, and approximately 20 months before filing his petition to reinstate the patent.

Patentee alleges that he reasonably relied on automated mechanisms to assist in the conduct of his daily business, and should be entitled to rely on such automated systems and procedures to supply the necessary reminders.

The June 23, 2006 Requirement for Information

In response to the April 17, 2006 Petition for Reconsideration, this Office mailed a Requirement for Information on June 23, 2006. The Requirement for information required Patentee to explain any other measures that were taken to retrieve the data outside of Patentees personal memory. Patentee was also asked to provide evidence from the disk that the maintenance fee data was entered onto the disk. While Patentee had provided a copy of what he had alleged to be the disk, with dates entered on the disk label; he failed to provide a copy of the contents of the disk, or evidence from a computer professional that the contents of the disk were irretrievable.

Patentee's Reply to Requirement for Information

Patentee filed a reply to the Requirement for Information on August 8, 2006, and reiterated that "[b]ased on his personal knowledge and experience of verifying that data could be restored from the floppy disk, the patentee had no prior notice or reason to believe that the periodic backups that he conducted would not provide any retrievable data." Reply at p.2.

Patentee also alleged that he had no reason to believe that there would ever come a time when it would be necessary for him to rely on his naked memory to restore his maintenance fee reminder notifications. Id. Patentee further provided that additional steps to retrieve the data from the disk included using a different computer to access the data files and using a Norton Utility Computer Program. Further, once Patentee was

unsuccessful in his attempts to retrieve the data, he reformatted the disk³.

In response to the Requirement for Information, Patentee has taken the floppy disk to a computer professional who was unable to recover any data files from the disk.

Applicable Law Under 37 CFR 1.378(b)

UNAVOIDABLE DELAY

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) 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.

Most recently the court in Ray v. Lehman, provided that

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. Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard.... In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."

In re Patent No. 4,461,759, 16 U.S.P.Q.2D (BNA) 1883, 1884 (Dep. Ass't Comm'r Pat. 1990) (quoting Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977, 982 (D.C. Cir. 1982)). Thus, 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. See Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 U.S.P.Q.2D (BNA) 1697, 1700 (E.D. Pa. 1991), aff'd

³ Reformatting results in erasing all data on a disk.

975 F.2d 869 (Fed. Cir. 1992) (table); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912).

Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions 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. Quigg, 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). 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. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, a "delay (in responding) resulting from the lack of knowledge or improper application of the patent statute, rules of practice, or [Manual of Patent Examining Procedure], does not constitute unavoidable delay." See, Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added). See, Also, MPEP 711.03(c).

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a

reasonable and prudent person would treat his or her most important business.⁴ However, "The question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁵ Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.⁶ The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. An adequate showing that the delay at issue was unavoidable requires a showing of the steps taken to ensure the timely payment. A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c),

⁴ The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee ... at any time ... if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." (emphasis added).

37 CFR 1.137(a) (3) requires a showing to the satisfaction of the Director of the USPTO that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Therefore, the Office will require the applicant in every petition under 37 CFR 1.137(a) to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unavoidable. See Haines, 673 F. Supp. at 316-17, 5 USPQ2d at 1131-32.

⁵ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

⁶ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

subsection II.C.2. In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The Office has no duty to notify patentees

As provided in the Manual of Patent Examining Procedure (MPEP), the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. MPEP § 2590, See, also, In Re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. 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, MMTC v. Rogan, 369 F. Supp. 2d 675 (ED. VA 2004) (failure to receive courtesy reminder notices from PTO does not relieve Patentee from obligation to pay maintenance fees).

Opinion

The record discloses the following:

- 1) Patentee was responsible for payment of the maintenance fee;
- 2) Patentee entered a maintenance fee reminder in a computer database on or about July, 1999;
- 3) Patentee backed-up the maintenance fee reminder on a floppy disk as a backup to the computer;
- 4) Patentee failed to verify that the maintenance fee data was successfully entered onto the floppy disk;
- 5) Patentee thereafter forgot about the maintenance fee requirement;
- 6) Patentee's computer crashed and the maintenance fee data was lost;
- 7) Patentee made no effort to seek assistance outside of Patentee's personal knowledge to recover the data from his personal computer;
- 8) The backup computer disk failed to record the maintenance fee data and patentee was unable to recover the maintenance fee data from the disk;
- 9) Patentee made no effort to seek assistance outside of Patentee's personal knowledge to recover the backup data from the disk until after a request from this Office;
- 10) Patentee sought, throughout 2002 and 2003, to license the patent (within the two (2) year period after expiration);

- 11) Patentee, represented by counsel, licensed the patent in March 2004 (within the two (2) year period after expiration);
 - 12) Patentee received a letter from the licensee in December 2005 informing Patentee that the patent had expired for failure to pay the maintenance fee;
 - 13) Patentee now for the first time, with the filing of his December 9, 2005 petition to reinstate the patent, specifically recalls setting maintenance fee reminders for dates on or about March 2, 2002, March 2, 2006 and March 2, 2010, because he had not previously set a date in his electronic calendar that far into the future.
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Analysis

Petitioner has failed to provide an adequate showing of unavoidable delay. The record reflects that the Patentee was responsible for payment of the maintenance fee. The record further shows that the Patentee initially took no steps outside of Patentee's personal memory to recover the data - his most important business - from the computer after the crash in November, 2001. Patentee also failed to verify that the maintenance fee data - his most important business - was properly copied onto the backup disk. After Patentee became aware that the data on his backup disk could not be recovered, he failed to seek outside assistance to recover the data - his most important business - until after receiving a requirement to do so from this Office. Petition for Reconsideration at p.5; Declaration of Scott Pullen at p. 4. Patentee, represented by counsel, licensed the patent in March, 2004, approximately one year after the patent had expired, and more than 18 months prior to filing the Petition to Reinstate his expired Patent.

The Office finds that had Patentee acted with the due care of a reasonable and prudent person in relation to their most important business, he would have sought assistance from computer professionals to recover data from his computer or backup disk, and not rely solely upon his memory. Patentee would have also taken steps to ensure that the maintenance fee data was successfully copied to the backup disk.

Further, by forgetting he had maintenance fees due on his patent, Patentee failed to act with diligence regarding his most important business. Winkler v. Ladd, 221 F.Supp 550, 552 (D.D.C. 1962)) (A showing of unavoidable delay requires diligence). Patentee asserts that the computer failed and that Patentee, only after receiving the December 7, 2005 letter from

his licensee, realized that the maintenance fee was not paid. However, Patentee sought to license the Patent in 2002 and 2003, and in 2004 was successful in licensing his patent, and throughout this process failed to verify that the patent was valid, and failed to recall any information regarding the payment of maintenance fees. Yet now, with the filing of the December 9, 2005 petition, specifically recalls setting maintenance fee reminders for dates on or about March 2, 2002, March 2, 2006 and March 2, 2010, because he had not previously set a date in his electronic calendar that far into the future. Pullen Declaration at p.5. Here, Patentee simply forgot⁷ about his most important business; has no record of the maintenance fee payment reminder in his files, and did nothing for over two and a half years after his patent had expired to address the patent maintenance fee. The test for diligence of a prudent and careful person is not whether the Patentee knew that the patent was expired, but whether he conducted a reasonably diligent inquiry to find out and correct the problem. See, Winkler v. Ladd, 221 F. 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).

Moreover, Patentee has failed to substantiate his assertions with documentary evidence. Here, Patentee asserts that he entered the maintenance fee reminder into a computer database on or about July 1999, an event that he now specifically recalls with the filing of December 9, 2005 petition; however, after November, 2001 and until December 7, 2005, he completely forgot about, notwithstanding his continual efforts to license the patent during 2002 and 2003, and his successful licensing thereof in 2004. However, the only evidence Patentee has submitted to substantiate his assertion - that the maintenance fee reminder was ever entered into his computer - is a copy of the label of a disk with dates written thereon. This evidence fails to substantiate Patentee's assertion, that he entered the maintenance fee reminder(s) into his computer.

Conclusion

It is the conclusion of this Office that Patentee has not established that his conduct after the computer crashed demonstrates the care and diligence that reasonably prudent

⁷In Haines v. Quigg, 673 F.Supp 314, 317 (N.D. Ill. 1987), the Plaintiff's attorney was responsible for prosecuting Plaintiff's application. The attorney failed to respond to a final Office action and "had no memory of the events surrounding such failure". Id., at 317. "[The attorney] also had no record of those events as his files [had] since been destroyed." Id.

persons exhibit in relation to their most important business. Moreover, Patentee's assertion - that he entered the maintenance fee reminder into his computer - is unsubstantiated by the record. Patentee has failed to demonstrate to the satisfaction of the Director that the delay in paying the maintenance fee was unavoidable.

A handwritten signature in cursive script, appearing to read 'Charles Pearson', with a long horizontal flourish extending to the right.

Charles Pearson
Director
Office of Petitions