



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 21

CHARLES E. ROHRER
P.O. BOX 20067
BOULDER, CO 80308

COPY MAILED

FEB 26 1998

OFFICE OF PETITIONS
A/C PATENTS

In re Patent No. 5,004,404 :
Issue Date: April 2, 1991 :
Application No. 07/305,810 :
Filed: February 3, 1989 :
Inventor(s): Michel Pierrat :

ON PETITION

This is a decision on the petition, filed July 29, 1997, 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 below, 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 April 2, 1991. The first maintenance fee could have been paid during the period from April 4, 1994 (April 2, 1994 being a Saturday), through October 3, 1994, (October 2, 1994 being a Sunday) or with a surcharge during the period from

October 4, 1994 through April 3, 1995 (April 2, 1995 being a Sunday). Accordingly, this patent expired on midnight of April 2, 1995 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 asserts that a misunderstanding between the assignee of the patent, VAIREX, and the attorney of record E.T. Barret, (Barret) as to who was to pay the maintenance fee and Barret's long period of illness was resulted in the failure to pay the first maintenance fee.

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).

Petitioner states that during the period between 1990 and 1993 the attorney of record, Barret, was responsible for paying all patent costs due the Office, and was to be subsequently reimbursed by VAIREX, as VAIREX was able to do so. On October 18, 1993, Barret notified VAIREX, (Exhibit 1) that the responsibility for the docketing of maintenance fees and their payment would be shifted to VAIREX, and provided detailed information as to the time when such

payments were due. At the same time, Barret notified the Office that future maintenance fee correspondence should be directed to VAIREX. Petitioner indicates (exhibit 5) that various Office notices were thereafter received by VAIREX. Apparently, (although with one exception petitioner does not explicitly state) these notices included maintenance fee reminders and notices of expiration of various patents. Petitioner states that copies of such notices would have been forwarded to Barret and then filed. On June 26, 1997, petitioner learned of the expiration of the patent after a conversation with a potential licensee. On July 29, 1997 the instant petition was filed.

The showing of record indicates that petitioner was put on notice in the October 18, 1993 letter that Barret would no longer be responsible for maintaining a docket for maintenance fees, or for making their payment. Barret put VAIREX on notice that it would henceforth need to maintain its own maintenance fee docket. As such, it fell to VAIREX at that time to either familiarize itself with the maintenance fee requirements, or retain new counsel. See California Medical Products v. Tecnol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). The showing of record, however, is that VAIREX failed to take either prudent course of action. Pursuant to 37 CFR 1.378(b)(3) VAIREX is required to make a showing as to what, if any, steps were taken by VAIREX to docket, or obligate another to docket, the maintenance fee payment subsequent to Barret's October 18, 1993 letter.

35 USC 41(c) requires the payment of fees at specified intervals to maintain a patent in force. A reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. The PTO expects that patentees will maintain their own record and docketing systems to pay the maintenance fees. MPEP 2575. Furthermore, 37 CFR 1.378(b)(3) requires an enumeration of the steps taken to ensure timely payment of the maintenance fee. As such, any renewed petition must include copies of any documents establishing that petitioner had, in place, steps to ensure timely payment of the maintenance fee.

Petitioner states that miscommunication between VAIREX and Barret led VAIREX to believe that Barret would continue to look after maintenance fee payments. Delay resulting from a lack of proper communication between a patentee and that patentee's representative(s) as to the responsibility for scheduling and payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). See, In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). Specifically, delay resulting from a failure in communication between a representative and his client regarding a maintenance fee payment is not

unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). Ray, 55 F.3d at 610, 34 USPQ2d at 1789. That all parties failed to take adequate steps to ensure that each fully understood the other party's meaning, and thus, their own obligation in this matter, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business within the meaning of Pratt, supra. It is further brought to petitioner's attention that the Office is not the proper forum for resolving a dispute between a patentee and that patentee's representative(s) regarding the scheduling and payment of maintenance fees. Ray, supra.

Regardless, based on Barret's October 18, 1993 letter it is hard to fathom as to what miscommunication there could have been. The facts as currently set forth clearly indicate that the burden was on petitioner to track maintenance fee payments. In any renewed petition petitioner will have to elaborate on this particular argument.

Moreover, VAIREX apparently received a number of notices from the Office indicating, in fact, that maintenance fees were due and had not been paid. Even if VAIREX was under the impression that Barret was responsible for such payments, a reasonable and prudent course of action would dictate that the reason for the non-payment be investigated and rectified. Petitioner was on notice over three years prior to the filing of this petition that the first of the patents which it presumed to be maintained by Barret had expired, and was apparently on notice as to the instant patent's expiration over two years prior to the instant petition. Again as Ray, supra, applies the same unavoidable delay standard to expired patents, in view of the inordinate period of time between the expiration of the patent and the first petition to accept late payment, petitioner must show diligence between the time of becoming aware of the expiration of this patent and the filing of an petition to accept late payment. In re Application of S, 8 USPQ2d 1630 (Comm'r Pats. 1988). Specifically, there is a requirement of a showing of unavoidable delay from the time petitioner became aware of the expiration of the patent to the filing of a grantable petition. In re application of Takeo, 17 USPQ2d 1155, 1158 (Comm'r Pat. 1990); 1124 Official Gazette 33 (March 19, 1991).

Should petitioner not renew this petition, or if such is renewed and not granted, then petitioner may request a refund of the maintenance fee and post-expiration surcharge if such can be shown to have been paid. The \$130 for requesting reconsideration is not refundable.

Further correspondence with respect to this matter should be

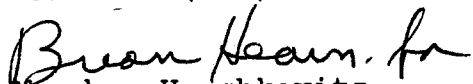
addressed as follows:

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