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ELMAN TECHNOLOGY LAW, P.C.  
P. O. BOX 209  
SWARTHMORE PA 19081

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**OFFICE OF PETITIONS**

In re Patent No. 6,073,409 :  
Issue Date: 06/13/2000 :  
Application Number: 09/182,793 : DECISION ON PETITION  
Filing Date: 10/30/1998 :  
For: FLOORING CONSTRUCTION WITH :  
CAPACITY FOR DEFLEXURE :  
ADJUSTMENT :

This is a decision on the petition, filed on March 29, 2011, under 37 CFR 1.378(e) requesting reconsideration of a prior decision which refused to accept under § 1.378(b)<sup>1</sup> the delayed payment of a maintenance fee for the above-referenced patent.

The petition under 37 CFR 1.378(e) is **DENIED**.<sup>2</sup>

**BACKGROUND**

The patent issued June 13, 2000. The first maintenance fee was timely paid. The second maintenance fee could have been paid from June 13, 2007, through December 12, 2007, or, with a

<sup>1</sup> A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);  
(2) the surcharge set forth in § 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.

<sup>2</sup> As stated in 37 CFR 1.378(e), no further reconsideration or review of the decision refusing to accept the delayed payment of the maintenance fee under § 1.378(b) will be undertaken. This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1001.02.

surcharge during the period from December 13, 2007 through June 13, 2008. Accordingly, the patent expired at midnight on June 13, 2008, for failure to timely submit the second maintenance fee.

The petition under 37 CFR 1.378(b) filed on August 17, 2010, was dismissed on January 31, 2011.

The subject request for reconsideration was filed on March 29, 2011.

In the original decision, petitioner, via his current registered patent practitioner, stated that his prior patent attorney, Anthony J. McNulty, informed him of when the first maintenance fee was due. Attorney McNulty apparently proffered payment of the first maintenance fee on behalf of petitioner.

Petitioner further stated that he learned that attorney McNulty passed away on February 12, 2005. Petitioner states that he obtained the patent files from McNulty's office, but was unaware of the due date for the second maintenance fee.

Petitioner further averred that in June, 2007, he received a letter from the "United States Patent Renewal Service" (hereinafter "USPRS") requesting payment of \$175.00 in connection with the renewal of the patent. Petitioner states that he believed that the USPRS document was an official letter from the USPTO, and that, by responding to the USPRS letter, he "believed that this was all that would be needed to handle in a timely manner any fees then coming due for the above-identified patent." Petitioner has provided a copy of the letter from USPRS, as well as a copy of the \$175.00 check he submitted as payment to USPRS. Petitioner averred that no further communication was received from the USPRS or the USPTO.

Lastly, petitioner stated that he learned on June 22, 2010, that the patent had expired. The original petition was then filed on August 17, 2010.

On January 31, 2011, the original petition was dismissed.

On March 29, 2011, the subject request for reconsideration was filed. Petitioner asserts, via his registered patent practitioner, that the delay was unavoidable because petitioner believed the letter from USPRS was an official Government document, and that payment of the \$175.00 would satisfy the obligation to pay the maintenance fee. Petitioner again avers

that since no further communication was received from the USPTO, or USPRS, he believed that no further payments were due. Petitioner further avers that the USPRS document constitutes an intentional deception or practitioner's concealment of error which would constitute an unavoidable delay, analogous to the circumstances in *In Re Lonardo*, 7 USPQ2d 1455, 1990 WL 354576 (Comm'r Pat. 1990).

#### STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) states that:

The Director may accept the payment of any maintenance fee required subsection (b) of this section which is made within twenty-four months after the six-month grace period if this 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.

37 CFR 1.378(b)(3) states that any petition to accept an unavoidably delayed payment of a maintenance fee must include:

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.

#### OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".<sup>3</sup> A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if

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<sup>3</sup> 35 U.S.C. § 41(c)(1).

the patent owner "exercised the due care of a reasonably prudent person."<sup>4</sup> This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>5</sup> Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.<sup>6</sup> Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.<sup>7</sup> However, 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.<sup>8</sup> In view of In re Patent No. 4,409,763,<sup>9</sup> this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

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

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.<sup>10</sup> That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b) (3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.<sup>11</sup>

35 U.S.C. § 41(c) (1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the

<sup>4</sup> Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

<sup>5</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>6</sup> In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

<sup>7</sup> 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).

<sup>8</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

<sup>9</sup> 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

<sup>10</sup> Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

<sup>11</sup> Id.

petitioner has failed to carry his or her burden to establish that the delay was unavoidable.<sup>12</sup> Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.<sup>13</sup>

In *In Re Lonardo*,<sup>14</sup> the Commissioner found that the delay in prosecution of an application was unavoidable when the applicant's counsel had assured applicant's wife, on multiple occasions, that counsel was prosecuting the application, when in fact counsel had failed to diligently prosecute the application, and had concealed from applicant counsel's failure to diligently prosecute the application.

The situation at hand is not analogous to that which occurred in *Lonardo*. In this regard, petitioner concedes that he did not appoint new patent counsel to track and pay the maintenance fee after the death of attorney McNulty. In pertinent part, petitioner states "I did not see any need for further legal advice nor to incur any additional expenses for the above-identified patent, as Mr. McNulty's advice seemed to remain applicable to the above-identified patent following his death." As such, petitioner had no reasonable basis to believe that the maintenance fee for the subject patent was being tracked or would be paid by counsel.

Rather, in this case, petitioner asserts that he believed that the letter from USPRS constituted a letter from the USPTO, or another Government agency, and that response to that letter constituted payment of the maintenance fee.

In this regard, while it is unfortunate that petitioner believed that response to the USPRS letter constituted payment of the maintenance fee, petitioner's mistaken belief does not rise to the level of unavoidable delay. At the outset, unlike the situation in *Lonardo*,<sup>15</sup> petitioner has not demonstrated that USPRS, or any persons associated with USPRS, were appointed as petitioner's patent counsel. Further, the lower portion of the USPRS letter states, in pertinent part: "THIS SERVICE HAS NOT

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<sup>12</sup> 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 Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing).

<sup>13</sup> See *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); *Ray v. Lehman*, *supra*.

<sup>14</sup> 17 USPQ2d 1455 (Comm'r Pat. 1990).

<sup>15</sup> See Note 14 *supra*.

BEEN APPROVED OR ENDORSED BY THE FEDERAL GOVERNMENT AND THIS OFFER IS NOT BEING MADE BY AN AGENCY OF THE FEDERAL GOVERNMENT. THE FEE FOR THIS SERVICE IS NOT REQUIRED TO BE PAID BY OR TO ANY GOVERNMENTAL AGENCY. THIS IS NOT A BILL." As such, while the USPRS letter has been formatted to appear similar to Office letters, a quick reading of the USPRS letter reveals that it is not a letter from the USPTO, and was not sent on behalf of the USPTO.

Further in this regard, assuming, *arguendo*, that the letter from USPRS was, in fact, deceptive in implying that the maintenance fee would be paid by USPRS, the rule in *Lonardo*<sup>16</sup> would not apply because the deception or concealment was not practiced by petitioner's attorney, but by a third party. Reliance upon third party prosecution of a patented file without an express contractual obligation does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.<sup>17</sup> Assuming, *arguendo*, such a contract existed, petitioner would have had to show what steps were taken by petitioner to inquire as to the third party's reasonably diligent efforts to timely pay the maintenance fees.<sup>18</sup> Petitioner has neither provided evidence that a third party was contractually obligated to pay the maintenance fees for the present patent nor shown petitioner had maintained inquiry with that third party as to the steps taken to timely pay the maintenance fee. Petitioner has not shown what steps were taken by petitioner to ensure timely payment of the maintenance fee.

Petitioner has provided no evidence that USPRS was contractually obligated to pay the maintenance fee in the present patent. In this regard, the USPRS letter states simply that USPRS would send "the necessary documents for you to renew your Patent" to petitioner. While, again, it is unfortunate that petitioner did not receive any such documentation from USPRS, petitioner, by his own admission, did not maintain inquiry with USPRS to ensure that steps were taken to timely pay the maintenance fee. In fact, at the time the maintenance fee fell due, the showing of record is that neither USPRS nor petitioner had any steps in place to ensure payment of the maintenance fee. Delay resulting from the failure of the patent holder to have any steps in place to pay the fee by either obligating a third party to track and pay the

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<sup>16</sup> See Note 14, *supra*.

<sup>17</sup> See *Futures Tech. Ltd. v. Quigg*, 7 USPQ2d 1588 (E.D. Va. 1988).

<sup>18</sup> See *Winkler v. Ladd*, 138 USPQ 666 (Comm'r Pat. 1963).

fee, or by itself assuming the obligation to track and pay the fee, is not unavoidable delay.<sup>19</sup>

In summary, the showing of record is inadequate to establish unavoidable delay. Petitioner has not shown that it had docketed the patent for payment of the first maintenance fee in a reliable tracking system. Rather, than unavoidable delay, the showing of record is that petitioner failed to take adequate precautions to ensure that maintenance fees were timely paid. As petitioner has not shown that he exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be denied.<sup>20</sup>

### CONCLUSION

The prior decision which refused to accept under § 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, or unintentional, within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

Since this patent will not be reinstated, the maintenance fee(s) and surcharge fee(s) submitted by petitioner will be refunded to counsel's deposit account. The \$400.00 fee for reconsideration will not be refunded, and will be deducted from the amount refunded.

As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.

Telephone inquiries should be directed to Senior Petitions Attorney Douglas I. Wood at 571-272-3231.



Anthony Knight  
Director, Office of Petitions

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<sup>19</sup> See R.R. Donnelley & Sons Co. v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244, 1247 (N.D. Ill. 2000); Ray, supra; California, supra; Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007).

<sup>20</sup> See note 7, supra.