



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MARILYN J. MARSHALL
5757 WESTHEIMER RD.
#3-91
HOUSTON TX 77057-5749

MAILED

AUG 24 2011

OFFICE OF PETITIONS

In re Patent No. 6,502,951
Issue Date: January 7, 2003
Application No. 09/727,419
Filed: December 1, 2000
Attorney Docket No. 99-1930
For: LIGHTED AND CONTENT-
ORGANIZING CARRYING CASE

:
:
: DECISION ON PETITION
: UNDER 37 CFR 1.378(b)
:
:

This is a decision on the reconsideration petition under 37 CFR 1.378(e), filed March 30, 2011 and supplemented on May 31, 2011, to reinstate the above-identified patent.

The petition is **DENIED**.¹

Background

The patent issued January 7, 2003. The first maintenance fee could have been paid from January 7, 2006 through July 7, 2006, or with a surcharge during the period from July 8, 2006 through January 7, 2007. Accordingly, the patent expired at midnight on January 8, 2007, for failure to timely submit the first maintenance fee.

A petition under 37 CFR 1.378(b) was filed on August 23, 2010 (certificate of mailing date August 17, 2010). The petition was dismissed in a decision mailed December 3, 2010.

Petitioner filed papers on February 4, 2011. However, the papers were not accompanied by the reconsideration fee. Therefore, the Office mailed a Request for Information on February 28, 2011.

The content of the prior decision on petition, mailed December 3, 2010, is incorporated by reference into the present decision.

¹ This decision may be viewed as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP 1002.02. The terms of 37 C.F.R. 1.137(d) *do not apply* to this decision.

Applicable Statute and Regulation

35 U.S.C. 41(c)(1) states 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.”

37 CFR 1.378(b) states that:

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

- (1) the required maintenance fee set forth in §1.20 (e)-(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.

Opinion

Petitioner asserts that the delay in payment of the first maintenance fee was unavoidable because petitioner was involved in Chapter 13 bankruptcy proceedings in December of 2005 and Hurricane Katrina destroyed Houston, Texas in August of 2005.

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 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, i.e., "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat 1898)). 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 by prudent and careful men in relation to their most important business"); In Re Mattullath, 38 App. D.C. 497, 514-515 (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).

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. Consequently, a reasonably prudent person in the exercise of due care and diligence will take steps to ensure the timely payment of maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. Thus, it follows that an adequate showing of unavoidable delay in payment of a maintenance fee, 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 the patent. Id. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee.

Petitioner has the burden of proof and must supply the evidence to show that she was unavoidably delayed from paying the first maintenance fee.

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 unavoidable." 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 petitioner has failed to carry the burden to establish that the delay was unavoidable. See 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).

37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

The showing of record does not adequately establish that petitioner's entire delay in paying the first maintenance fee from January 7, 2007, until the first petition was filed on or about certificate of mailing date August 17, 2010, was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).

Petitioner has not explained how she personally was impacted by Hurricane Katrina, which decimated Houston, Texas in August 2005. The fact that the city was, in petitioner's words, "shut down" does not necessarily mean that petitioner's home or place where she conducts her patent business was damaged to the extent that her system for monitoring and paying maintenance fees was rendered inoperable. It is noted that the first maintenance fee was due on January 7, 2007, and that date is almost 2 ½ years after Hurricane Katrina hit Houston, Texas. Petitioner has not provided documentary proof of her maintenance fee tracking system, the entry of this patent in that system and an explanation of how the system worked.

Similarly, the fact that petitioner was involved in bankruptcy proceedings in December 2005 does not establish that the failure to pay a maintenance fee by January 7, 2007 was unavoidable. A showing of unavoidable delay based upon financial condition must establish that the financial condition of the petitioner during the entire period of the delay was such as to excuse the delay. See Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Petitioner has not provided a complete showing of her financial condition from January 7, 2007, until the first petition was filed on or about certificate of mailing date August 17, 2010.

In short, petitioner has failed to carry her 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 unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).

Decision

The prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the reasons herein and stated in the previous decision, the entire delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. 41(c)(1) and 37 CFR 1.378(b). Therefore, the petition is **denied**.

As stated in 37 CFR 1.378(e), the Office will not further consider or review the matter of the reinstatement of the patent.

In due course, the Office will refund \$2,430.00, which corresponds to the maintenance fees and surcharge paid via a U.S. Treasury check. The reconsideration fee of \$400.00 will be retained.

The patent file is being forwarded to Files Repository.

Telephone inquiries may be directed to Petitions Attorney Shirene Willis Brantley at (571) 272-3230.


Anthony Knight
Director
Office of Petitions