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AUG 23 2011

OFFICE OF PETITIONS

In re Patent No. 5,420,107	:	
Issue Date: May 30, 1995	:	
Application No. 08/279,829	:	DECISION ON PETITION
Filed: July 25, 1994	:	
Attorney Docket No. 01098-32767	:	

This is a decision in response to the letters filed July 25, 2011 and April 1, 2011, which are being treated as a renewed petition under 37 C.F.R. § 1.378(b).

The petition under 37 C.F.R. § 1.378(b) is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

**Procedural History:**

- The above-identified patent issued on May 30, 1995.
- The third maintenance fee could have been timely paid during the period from May 30, 2006 through November 30, 2006, or with a late payment surcharge during the period from December 1, 2006 through May 30, 2007.

- No maintenance fee having been received, the patent expired on May 31, 2007.
- The 2 year time period for filing a petition under 37 C.F.R. § 1.378(c) expired on May 30, 2009.
- Patentee filed a petition to accept the unavoidably delayed payment of the maintenance fee pursuant to 37 C.F.R. 1.378(b) on July 26, 2010.
- The petition was dismissed in a decision mailed on February 4, 2011.
- Patentee filed a letter in response on April 1, 2011, together with the \$400 fee for requesting reconsideration.
- In reply, the Office mailed a "Request for Information" on May 13, 2011.

**Relevant Statutes and Regulations:**

35 U.S.C. § 41(c)(1) states that:

The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. § 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must 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.

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word '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 addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32 (N.D. Ind. 1987).

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 his or her burden to establish that the delay was unavoidable. 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). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, 55 F. 3d 606, 608 - 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

**July 26, 2010 Petition and February 4, 2011 Decision:**

With his petition filed July 26, 2010, petitioner stated that he was not reminded by his counsel of the twelve year maintenance fee. According to petitioner, his counsel not only prosecuted the application, but tracked and payed the four year and eight year maintenance fees for petitioner.

On or about May 30, 2002, petitioner filed another patent application through his counsel. However, on or about

May 20, 2003, petitioner informed his counsel that he would prosecute the application pro-se. In support, petitioner included a copy of an e-mail from his counsel, confirming the cessation of representation. It was petitioner's understanding that his counsel would continue to track and monitor the payment of the maintenance fees for the instant patent.

The February 4, 2011 decision explained that petitioner had not demonstrated unavoidable delay within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. § 1.378(b). The decision noted that while it was unfortunate that petitioner's counsel did not remind him of the twelve year maintenance fee when it became due, petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962). Petitioner's recourse lies against his counsel.

**Renewed Petition filed April 1, 2011 and July 25, 2011:**

On renewed petition filed April 1, 2011, petitioner presented no new arguments as to why the delayed payment of the maintenance fee was unavoidable. Rather, petitioner argued in favor of acceptance of delayed payment of maintenance fees by alluding to the commercial value and efficacy of his patent. However, under the "unavoidable" standard, the PTO cannot apply the patent statutes and rules selectively, based on commercial success or efficacy of a patent. It would be appropriate, however, for petitioners or those acting on their behalf to exercise extraordinary care to insure that so valuable a property not be lost through failure to follow laws and regulations. Similarly, evidence establishing the commercial value of the patent, and investment of resources towards commercialization of the invention, while potentially probative of whether a delay was unintentional, is simply not probative of whether the delay was unavoidable. See In re Patent No. 4,409,763, at 1800.

In addition, petitioner argued for "fair treatment" and "protection" from the PTO after he was harmed by the inaction of his prior counsel. However, the Office is not the proper forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. Ray, 55 F.3d at 610, 34 USPQ2d at 1789. In any event, delay resulting from a failure of communication between a patent owner and his representative as to the responsibility for 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 id. That both parties failed to take adequate steps to

ensure that each fully understood the other party's meaning, and thus their own obligation in the matter of payment of maintenance fees, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business.

In the "Request for Information" mailed May 13, 2011, the Office requested that patentee states which party (patentee or patentee's counsel) was responsible for tracking and paying the maintenance fee. In addition, patentee was requested to supply evidence that the instant patent was entered into a system for tracking and paying the maintenance fee.

With his response filed July 25, 2011, patentee states that his counsel was the responsible party for tracking and paying the maintenance fee. Moreover, patentee has explained that he has no evidence to show that the instant patent was entered into his counsel's system for tracking and paying the maintenance fee.

As there has been no showing of the steps taken by patentee's counsel to ensure timely payment of the maintenance fee, the petition must be dismissed. Petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962).

**Conclusion:**

The prior decision which refused to accept under 37 C.F.R. § 1.378(b) the delayed payment of a maintenance fee for the patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b). As stated in 37 C.F.R. § 1.378(e), no further reconsideration or review of this matter will be undertaken.

Since this patent will not be reinstated, the \$2055 maintenance fees and the \$700 surcharge fee submitted by petitioner on July 26, 2010 are being refunded to petitioner under separate cover. The \$400 fee for requesting reconsideration is not refundable.

Telephone inquiries concerning this communication should be directed to Petitions Attorney Cliff Congo at (571)272-3207.



Anthony Knight  
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