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OFFICE OF PETITIONS

In re Patent No. 6,347,610 :  
Issue Date: February 19, 2002 :  
Application No. 09/446,401 : ON PETITION  
Filed: February 29, 2000 :  
Attorney Docket No: **NORC-101** :

This is a decision on the "PETITION FOR RECONSIDERATION OF DECISION REFUSING TO ACCEPT DELAYED PAYMENT OF MAINTENANCE FEE UNDER 37 CFR § 1.378(e) MAILED FEBRUARY 24, 2009", filed May 7, 2009 for the above-identified patent.

The petition under 37 CFR 1.378(e) is **DENIED**.<sup>1</sup>

BACKGROUND

The patent issued on February 19, 2002. The first maintenance fee due could have been paid during the period from February 22, 2005 to August 21, 2005 or, with a surcharge during the period from August 22, 2005 to February 19, 2006. Accordingly, this patent expired on February 19, 2006 for failure to timely remit the first maintenance fee.

In a petition filed May 22, 2008, petitioners asserted that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely. Specifically, petitioner argued that the firm responsible for prosecution of the application associated with the instant patent, Marks & Clerk, incorrectly entered an address for the patentee when giving instructions to Computer Patent Annuities (CPA) regarding payment of the maintenance fees. Upon realizing the error, Marks and Clerk communicated corrected contact information for the patentee but CPA never updated the system, never properly communicated with the patentee and thus,

<sup>1</sup>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 1002.02.

the patent lapsed because CPA never received instructions from the patentee to pay the maintenance fee when due.

The petition was dismissed in a decision mailed February 24, 2009 because it was not indicated what if any procedures CPA had in place, other than to mail repeated reminder notices, when no response was received regarding the payment or non-payment of the maintenance fee. As well, no arguments or supporting documentation was provided to show why CPA's system was not updated with the correct address information for the patentee as provided by Marks and Clerk and therefore why that address was not used. Neither was there any evidence to show what additional efforts were employed by Marks and Clerk to ensure that the address information sent to CPA was correctly entered.

Thus, no evidence was provided to establish that the delay by the firm charged with payment of the maintenance fee was unavoidable. The decision reminded that in the absence of an adequate showing of the diligence of their representatives in this matter throughout the period in question, the actions or inactions of their agents will remain imputed to the assignees.<sup>2</sup>

The instant petition under 37 CFR 1.378(e) purports to provide additional explanations as to why petitioners believe the payment of the first maintenance fee was delayed and why that delay was unavoidable.

#### STATUTE AND REGULATION

35 USC 41(c)(1) states that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section 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 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. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

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<sup>2</sup>See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

### 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". 35 USC 41(c)(1).

Acceptance of a late maintenance fee on the basis of unavoidable delay 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. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912)("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"); 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).

On reconsideration, petitioner submits a declaration from Andrew Shanks (Petitioner's EU patent attorney) and relies on previously submitted declarations from Robert Walker (patent attorney with Computer Patent Annuities (CPA)) and C. Andrew Norton (Patentee) and renews the argument that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely.

Petitioner argues that CPA tracks the maintenance fee due dates, issues reminders to the patent proprietor, receives instructions from the patent proprietor, pays or instructs payment of the maintenance fees, and invoices the patent proprietor. In this instance, however, petitioner argues that an erroneous association in the docketing software used by Marks & Clerk, between the proprietor's cases and the Marks & Clerk client code, therefore caused the contact information in the CPA system to be erroneously recorded and as a result, a series of maintenance fee reminders were sent by CPA to an erroneous address for the proprietor, though not returned by the UK postal service. Thus, the proprietor/patentee never received the maintenance fee reminders for the instant patent.

Petitioner's arguments and the evidence presented have been considered but are not persuasive.

The failure of CPA in not updating the contact information for the proprietor, Mr. Norton, is a suggestion of an error on the part of CPA but is not supported by sufficient evidence as to why the error was not detected and/or corrected. This amounts to supposition and conjecture and a failure to show therefore that CPA exercised diligence as it relates to this matter.

Further, the failure to send a reminder to Mr. Norton is tantamount to a miscommunication between CPA and Mr. Norton and is not unavoidable delay. As stated in *In re Kim*, 12 USPQ2d 1595, 1603 (Comm'r Pat 1988):

A "failure of communication" which occurs because a party fails to clearly communicate their intentions does not constitute unavoidable delay. See, *Ex Parte Wright*, 1 Gour. 84:16 (Comm'r Pat. Nov. 23, 1889),

The failure of CPA to detect that no response was received to the series of reminders sent to Mr. Norton, is the cause of the delay and thus, that error is binding on petitioner. As indicated in the previous decision, the system of mailing a reminder from CPA to the patentee was not reliable as it did not prevent the patent from lapsing for failure to pay the maintenance fees.

Irrespective of the reminder notices sent to Mr. Norton, the evidence provided also establishes that CPA was aware of the imminent lapse of the patent and in 2005 notified Marks & Clerk. Having received no response or advice to make a payment, the maintenance fees were not paid, which is apparently within the standard practice for CPA. It appears therefore that since there were no instructions to pay the maintenance fees either from Marks & Clerk or from Mr. Norton, there was no intention to have the maintenance fees paid.

No additional evidence has been provided to refute the claim that due care was not exercised by CPA, nor that the failure to pay the maintenance fees was not intentional. Since such an error could have been avoided by the exercise of the ordinary care and diligence that is observed by prudent and careful persons with respect to their most important business, petitioner has failed to show the delay in payment of the maintenance fee is unavoidable.

Petitioner is again reminded that in the absence of an adequate showing of the diligence of their representatives in this matter throughout the period in question, the actions or inactions of their agents will remain imputed to the patentee.

#### 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, however, petitioner has not carried the burden of proof to establish to the satisfaction of the Director that the delay was unavoidable and thus the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b). In view thereof, this patent will not be reinstated.

Since this patent will not be reinstated, the maintenance fee paid in the amount of \$465 and the surcharge fee in the amount of \$700 submitted with the petition filed May 22, 2008 will be credited back to the credit card provided.

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

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Anthony Knight  
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Office of the Deputy Commissioner