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**OFFICE OF PETITIONS
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ON PETITION

In re Patent No. 4,629,607
Issue Date: December 16, 1986
Application No. 06/686,993
Filed: December 27, 1984
Patentee: Michel Gueguin

This is a decision on the petition under 37 CFR 1.378(e), filed July 24, 1996,¹ and supplemented on August 19, 1996, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The petition to accept the delayed payment of the maintenance is **DENIED**.

BACKGROUND

The patent issued on December 16, 1986. Accordingly, the first maintenance fee due could have been paid during the period from December 16, 1989 through June 18, 1990 (June 16, 1990 being a Saturday), or with a surcharge during the period from June 19, 1990 through December 17, 1990 (December 16, 1990 being a Sunday). Accordingly, the above-identified patent expired at midnight on December 16, 1990. See MPEP 2506.

A petition under 37 CFR 1.378(b) to accept the delayed payment of the maintenance fee was filed on January 2, 1996, and was dismissed in the decision of May 21, 1996. The instant petition under 37 CFR 1.378(e) requests reconsideration of the decision of

¹ On September 16, 1996, a copy of a petition for reconsideration under 37 CFR 1.378(e) and a stamped postcard receipt which acknowledges receipt of, *inter alia*, a petition for reconsideration on July 24, 1996 was filed by facsimile. Thus, the evidence is convincing that a petition for reconsideration under 37 CFR 1.378(e) was filed on July 24, 1996 (certificate of mailing dated July 22, 1996, July 21, 1996 being a Sunday).

May 21, 1996, and acceptance of the delayed payment of the maintenance fee for the above-identified patent.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) states that:

The Commissioner 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 Commissioner to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable. The Commissioner may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Commissioner accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

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 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 Commissioner may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." See 35 U.S.C. § 41(c)(1).

As the language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (*i.e.*, "unavoidable" delay), a late maintenance fee is considered under the same standard as that for reviving an

abandoned application under 35 U.S.C. § 133. 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), *aff'd*, 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)). Decisions on reviving abandoned applications 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. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)); see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. 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). The requirement for a showing of unavoidable delay requires a showing of unavoidable delay until the filing of a petition to revive an abandoned application (or reinstate an expired patent). See In re Application of Takao 17 USPQ2d 1155 (Comm'r Pat. 1990).² Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987)

Petitioner has not carried his burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3).

As discussed *supra*, the requirement in 35 U.S.C. § 41(c)(1) for a showing that the "delay" "have been unavoidable" requires not

² See also 1124 *Off. Gaz. Pat Office* 33 (March 19, 1991).

only a showing that the initial delay in payment of the maintenance fee that resulted in the expiration of the patent was unavoidable, but also a showing of unavoidable delay until payment of the appropriate maintenance fee with a petition under 37 CFR 1.378 to accept such delayed payment. See Application of Takao, supra. A patentee seeking to reinstate a patent due to an "unavoidable" delay in payment of a maintenance fee is expected to cause a petition under 37 CFR 1.378 to be filed without delay (i.e., promptly upon being notified of, or otherwise becoming aware of, the expiration of the patent). Therefore, 37 CFR 1.378(b)(3) requires that any petition to accept delayed payment of a maintenance fee include: (1) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely, which must enumerate the steps taken to ensure timely payment of the maintenance fee, and (2) a showing that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, which must enumerate the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Regardless of whether the initial delay in payment of the maintenance fee that resulted in the expiration of the above-identified patent was unavoidable, the instant petition under 37 CFR 1.378 lacks a showing that such petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The showing of record is that Alphonso Grau (Grau) of QIT-Fer et Titane, Inc. (QIT), the assignee of the above-identified patent, was notified by Wayne Porter (Porter), then of Benesch, Friedlander, Coplan & Aronoff (Benesch et al.), in a letter dated February 8, 1994 that the above-identified patent expired in 1990 for failure to timely submit a maintenance fee.³ QIT, however, did not cause a petition under 37 CFR 1.378 to be filed until January 2, 1996, over twenty-two (22) months later. This delay of over twenty-two (22) months in filing a petition under 37 CFR 1.378 does not meet the requirement that a petition under 37 CFR 1.378(b) be "filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent." Cf. In re Application of S., 8 USPQ2d 1630, 1632 (Comm'r Pats 1988) (nine (9) month delay between becoming aware of the abandoned status of an application and filing a petition to revive under 37 CFR 1.137 does not meet the requirement that a petition under 37 CFR 1.137(a) be "promptly filed after the

Petition of January 2, 1996 at 8 (Exhibit "I").

applicant is notified of, or otherwise becomes aware of the abandonment").

With regard to this delay, petitioner asserts: (1) QIT inquired of Benesch et al. as to the charges to be incurred in reinstating the above-identified patent in July of 1994;⁴ (2) QIT instructed Benesch et al. to take action to reinstate the above-identified patent (so long as the cost did not exceed \$5,000.00) in October of 1994;⁵ (3) Porter left Benesch et al. for Rankin, Hill, Lewis & Clark (Rankin et al.) in November of 1994;⁶ (4) shortly before Porter left Benesch et al., Porter determined that the above-identified patent could not be reinstated under 37 CFR 1.378(c) due to its twenty-four (24) month deadline and that there were no grounds for reinstatement of the above-identified patent under 37 CFR 1.378(b);⁷ (5) QIT advised (again) Porter (now of Rankin et al.) to take action to reinstate the above-identified patent in January of 1995;⁸ (6) Porter was involved with infringement litigation between February of 1995 and May of 1995;⁹ (7) QIT instructed Porter to transfer QIT's files to Goudreau, Gage, Dubuc, & Martineau Walker (Goudreau et al.) of Canada in May of 1995, and that such files were transferred in June of 1995;¹⁰ (8) Goudreau et al. contacted Nilles & Nilles concerning the reinstatement of the above-identified patent, and Nilles & Nilles requested authorization of QIT to reinstate the above-identified patent, in July of 1995;¹¹ and (9) QIT authorized Goudreau et al. to reinstate the above-identified patent in October of 1995.¹²

The showing of record is that: (1) QIT authorized and instructed Porter (then of Benesch et al.) to take action to reinstate the above-identified patent in July of 1994; (2) Porter (and Benesch

⁴ Id at 10 (Exhibit "N").

⁵ Id at 10 (Exhibit "O").

⁶ Petition of July 24, 1996 (Porter declaration (§12)).

⁷ Id.

⁸ Petition of January 2, 1996 at 11 (Exhibit "R").

⁹ Petition of July 24, 1996 (Porter declaration (§13)).

Petition of January 2, 1996 at 11-12.

Id. at 12-13

et al. and later Rankin et al.) was responsible for filing a petition under 37 CFR 1.378 until May of 1995; (3) Porter (and Benesch et al. and later Rankin et al.) failed to file a petition under 37 CFR 1.378. It is well established that a party is bound by the consequences of the actions or inactions of its voluntarily chosen representatives. See Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, petitioner's delay caused by the inaction of its voluntarily chosen representative does not constitute an "unavoidable" delay. See Haines, supra; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

That Porter delayed the filing of a petition under 37 CFR 1.378 for the above-identified patent due to involvement with infringement litigation does not constitute "unavoidable" delay. It is well established that preoccupation with other legal matters which took precedence over the above-identified patent does not constitute "unavoidable" delay. See Smith v. Mossinghoff, supra. It follows that Porter's failure to file a petition under 37 CFR 1.378 for the above-identified patent prior to May of 1995, notwithstanding that Porter was authorized and instructed to take action to reinstate the above-identified patent in July of 1994, does not meet the requirement for a showing the "petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent."

Petitioner's argument¹³ with regard to Porter's lack of knowledge of the absence of information concerning the above-identified patent in the 1989 and 1990 preliminary tax lists sent to BP America from Master Data Center is likewise immaterial. Whether Porter's (or Susan Mizer's) conclusion concerning the feasibility of the reinstatement of the above-identified patent under 37 CFR 1.378(b) would have been different had they been aware of other information is sheer speculation.

In addition, it appears that Porter's conclusion that there was no basis for reinstatement of the above-identified patent under 37 CFR 1.378(b) was a significant contribution to Porter's delay (at least between October of 1994 and February of 1995) in filing a petition under 37 CFR 1.378 to reinstate the above-identified patent. The delay resulting from a deliberate decision to defer action (or not take action), when such decision is based upon a legal conclusion that such action is unfeasible, is not

¹³ Petition of July 24, 1996 at 15.

considered either an "unintentional" or "unavoidable" delay. Cf. In re Maldaque, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).¹⁴

Nevertheless, the showing of record is that QIT was advised of the expiration of the above-identified patent in February of 1994, but did not instruct Porter to reinstate such patent until October of 1994 (or even inquire of Porter as to the charges for reinstating such patent until July of 1994). In addition, in January of 1995, QIT had no reason to believe that Porter (or Benesch et al. or Rankin et al.) took any action to reinstate the above-identified patent, when QIT again requested that Porter (then at Rankin et al.) make sure that the above-identified patent was reinstated, but QIT did not then take other action (engage other counsel to promptly file such a petition or file such a petition *pro se*) to cause a petition under 37 CFR 1.378 to be filed without further delay, but again relied upon Porter to promptly file such a petition for the above-identified patent. Finally, even when QIT transferred the responsibility for the above-identified patent from Porter to Goudreau et al. in May and June of 1995, QIT did not provide the necessary authorization to Goudreau et al. to reinstate the above-identified patent until October of 1995. Thus, QIT is considered not only to have accepted and ratified the delay by Porter (or Benesch et al. or Rankin et al.) until May of 1995, but also to have contributed (without regard to the inactions of Porter, Benesch et al. or Rankin et al.) to the further delay until January of 1996 (or at least October of 1995) in taking action to reinstate the above-identified patent.

Whatever the rationale for the failure on the part of QIT or Porter (or Benesch et al. or Rankin et al.) to promptly file a petition under 37 CFR 1.378 to reinstate the above-identified patent upon becoming aware of its expiration in February of 1994, the salient point remains that a petition under 37 CFR 1.378 was not "filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent" in the above-identified patent as required by 37 CFR 1.378(b).

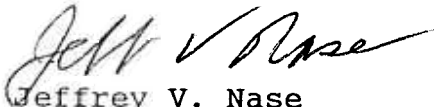
¹⁴ In any event, in rendering a opinion on the feasibility of reinstating a patent under 37 CFR 1.378(b) (or 1.378(c)), a registered practitioner is expected to promptly make a thorough investigation of the facts surrounding the delay in payment of the maintenance fee, and a further delay caused by the lack of such an investigation does not meet the requirement for a showing the "petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent."

CONCLUSION

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 above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41 and 37 CFR 1.378(b).

Telephone inquiries regarding this decision should be directed to the Office of Petitions Staff at (703) 305-9282.

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



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