



Paper No. 13

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In re Patent No. 4,785,936
Issue Date: November 22, 1988
Application No. 07/049,731
Filed: May 13, 1987
Inventor: David Shpigelman

OFFICE OF PETITIONS
AND PATENTS
ON PETITION

This is a decision on the petition under 37 CFR 1.378(e), filed December 5, 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 request to accept delayed payment of the maintenance fee under 37 CFR 1.378(b) is DENIED.

BACKGROUND

The patent issued November 22, 1988. The first maintenance fee could have been paid during the period from November 22, 1991 through May 22, 1991, or with a surcharge during the period from May 23, 1991, through November 22, 1992. Accordingly, the patent expired at midnight on November 22, 1992 for failure to timely submit the first maintenance fee. See MPEP 2506.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on March 25, 1996, and was dismissed in the decision of September 30, 1996.

The instant petition under 37 CFR 1.378(e) requesting reconsideration of the decision of March 25, 1996 was filed on December 5, 1996. Accompanying the petition were: various correspondence between petitioner, petitioners' foreign counsel, and petitioners' domestic counsel relating to the expiration of the present patent and the preparation of the petition filed March 25, 1996, a showing of the docketing system used by petitioners' domestic counsel, and declarations by petitioner, petitioners' foreign counsel, and Alexander Janowski (businessman/potential licensee).

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... after the six-month grace period if the delay is shown to the satisfaction of the Commissioner 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 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 under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. § 41(c)(1).

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, 608-09, 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. 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). 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).

Petitioner urges that the decision of September 30, 1996 be reconsidered because petitioner's medical condition precluded him from notifying his foreign counsel of his change of address.

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable.

The record fails to establish that petitioner took adequate steps to ensure timely payment of the maintenance fee as required by 37 CFR 1.378(b)(3). As no adequate steps were taken by petitioner, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

Petitioner asserts that the law firm of Renner, Otto, Boisselle & Sklar (domestic counsel) had been engaged to schedule and pay the maintenance fee for this patent, but payment was only to be made upon the express authorization of petitioner. Petitioner has shown that the domestic counsel had a reliable system in place to ensure timely payment of the maintenance fee. Domestic counsel notified the law firm of Cohen Zedek and Rapaport (foreign counsel) of the need to pay the maintenance fee on December 2, 1988, March 10, 1992, and June 1, 1992 (exhibits 1, 3, and 4). Domestic counsel further notified foreign counsel of the patent expiration on March 8, 1993 (exhibit 5). Foreign counsel had been instructed by petitioner to forward all communications to petitioner before taking any action (exhibit 10, ¶ 2). Consequently, foreign counsel attempted to notify petitioner of the need to pay the maintenance fee on March 17, 1992 and April 6, 1992. Petitioner asserts non-receipt of the payment notifications from Cohen, Zedek and Rapaport due to petitioners' change of address in mid-1989, which was not reported to the aforementioned foreign counsel. Petitioner acknowledges that petitioner failed to notify foreign counsel of his change of address, and further, that petitioner did not attempt to contact his foreign counsel until December of 1994.

Petitioner asserts that his failure to notify foreign counsel of his change in address was unavoidable, due to petitioner's medical condition(s). Petitioner's assertion is not adequately supported by the showing of record. Petitioner asserts that at the beginning of 1990 he began to suffer from high blood pressure which resulted in nose bleeds and balance problems, and further,

that petitioner suffered from temporary amnesia during the period from 1989-1995 (Shpigelman declaration ¶ 4, exhibit 11). Petitioner also alleges that he was hospitalized twice during the time period of 1990-1995. Nevertheless, petitioner has failed to present competent medical evidence reasonably establishing the extent of his incapacitation and the dates in which petitioner was incapacitated, such that petitioner was incapable of communicating his new address to foreign counsel during the time period in question. Petitioner has failed to establish he was medically incapacitated to such an extent that he was unable to exercise the due care observed by prudent and careful men, in relation to their most important business. Specifically, the showing of record fails to demonstrate that petitioner was medically incapable, from his relocation in mid-1989, until the expiration of the patent, of contacting foreign counsel (cf. petition at 4). However, a failure to adequately demonstrate the cause of the delay precludes a finding of unavoidable delay. Haines, Id.

Under the agreement in force, and acquiesced to by petitioner, it was petitioner's obligation to ensure that he could receive maintenance fee reminders from his foreign representative. The failure to provide petitioner's foreign counsel with a current correspondence address for receiving maintenance fee communications does not excuse patentee's failure to timely submit the first maintenance fee for this patent, nor does the delay resulting from patentee's failure to provide counsel with a current address constitute unavoidable delay. Ray, 55 F.3d at 610, 34 USPQ2d at 1789; 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). Furthermore, delay resulting from a lack of communication between a patentee and his counsel does not constitute unavoidable delay. Id.

Petitioner asserts that he became aware of the expiration of the instant patent in December 1994. Petitioner has not adequately demonstrated that the entire delay from December 1994, until the filing of the first petition to reinstate in March 25, 1996, was unavoidable. While petitioner contends that part of the delay was due to his services as a caretaker for his ailing parent, the showing of record is that petitioner's mother was in the care of a hospital from May 1995 until her death in April 1996 (Shpigelman declaration ¶ 5).

Petitioner further asserts that the diligence shown by Alexander Janowski (Janowski) after Janowski's obtention of rights in this patent in December 1994 (Janowski declaration ¶ 1, Exhibit 9), should be considered *vis-a-vis* seeking reinstatement of the patent. In view of the fifteen month delay in filing the first petition to reinstate the above-captioned patent, the assertion

of diligence on behalf of Janowski, or any other party, is questionable. In any event, any diligence on the part of Janowski, subsequent to expiration of the patent, is immaterial to the delay that resulted in the expiration of the patent. Since Janowski had no legal or equitable interest in this patent prior to its date of expiration, whether Janowski, subsequent to December 1994, exercised the care and diligence that is generally used and observed by prudent and careful persons in relation to their most important business is immaterial. See, Kim v. Quigg, 781 F. Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989).

The record fails to adequately evidence the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition to accept late payment of the maintenance fee was filed promptly after patentee became aware of the expiration of the patent.

CONCLUSION

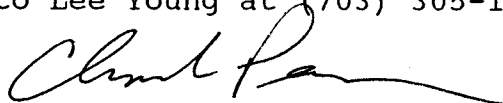
The prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41 and 37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

Since current counsel has not submitted any maintenance fees or surcharge fees, no refund is due.

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

This patent file is being returned to the Files Repository.

Telephone inquiries related to this decision should be directed to Lee Young at (703) 305-1820.



Charles Pearson
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
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bh/ah