



Paper No. 19

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In re Patent No. 4,789,433	:	OFFICE OF PETITIONS
Issue Date: December 6, 1988	:	A/C PATENTS
Application No. 07/007,909	:	ON PETITION
Filed: October 31, 1986	:	
Inventor: Karl-Dieter Fuchs	:	

This is a decision on the petition, filed October 17, 1996, under 37 CFR 1.378(b) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$130 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified 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, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

The patent issued December 6, 1988. The first maintenance fee could have been paid during the period from December 6, 1991, through June 6, 1992, or with a surcharge during the period from June 7, 1992 through December 6, 1992. Accordingly, this patent expired December 7, 1992, for failure to timely pay the maintenance fee.

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

Petitioner asserts that the delay in paying the maintenance fee was unavoidable, due to counsel's error in translating petitioner's payment instruction letter, with the result that counsel then instructed his firm's docket department not to pay the maintenance fee for this patent. Petitioner also asserts that the error may have arisen due to an inadvertent cross-annotation, as several letters of instruction regarding maintenance fees for different patents were processed at the same time by counsel. The petition is accompanied by a verified statement by counsel Peter Felfe(Felfe), and four exhibits.

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 USC 133 because 35 USC 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).

The showing of record is that the delay in payment is due to counsel's asserted error in translation of his letter of instructions from the client, or his confusion with another letter of instruction from the client to permit another patent to lapse, with the result that this patent was permitted to lapse.

However, delay resulting from a failure in communication between a client and his registered practitioner is not unavoidable delay. In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). Specifically, delay resulting from a lack of proper communication between a patent holder and his representative as to payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). Ray, at 610, 34 USPQ2d at 1789. Moreover, the Office is not the proper forum for resolving a dispute between a patent holder and his representative as to communications therebetween regarding the payment of a maintenance fee. Id.

The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). It follows that, under the facts of this case, the delay resulting from counsel's error is chargeable to petitioner. Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5

USPQ2d 1130 (D. Ind. 1987); 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). Furthermore, the showing of record is that counsel's error exacerbated the delay in payment of the maintenance fee, in that the Notice of Patent Expiration was not duly forwarded to petitioner, as a direct result of either the error in translation, or confusion of instructions with respect to another patent (Felfe declaration, ¶ 12- 13). Consequently, any renewed petition should clearly establish why the entire delay resulting from counsel's error should reasonably be considered to be unavoidable. This would include a statement from the patentee explaining the failure to inquire for a period in excess of four years as to why patentee was not billed for the maintenance fee for the patent in question.

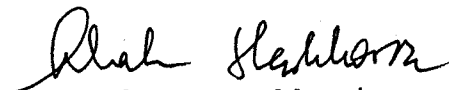
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