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Paper No. 14

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JUL - 8 1997

**OFFICE OF PETITIONS
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ON PETITION**

In re Patent No. 4,789,433
Issue Date: December 6, 1988
Application No. 07/007,909
Filed: October 31, 1986
Inventor: Karl-Dieter Fuchs

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This is a decision on the petition under 37 CFR 1.378(e), filed February 12, 1997, 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 December 6, 1988. The first maintenance fee could have been paid from December 6, 1991, through June 8, 1992 (June 6, 1992 being a Saturday), or with a surcharge during the period from June 9, 1992 through December 7, 1992 (December 6, 1992 being a Sunday). Accordingly, the patent expired at midnight on December 6, 1992, for failure to timely submit the maintenance fee. See MPEP 2506.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on October 17, 1996, and was dismissed in the decision of December 18, 1996.

The instant petition under 37 CFR 1.378(e) requesting reconsideration of the decision of December 17, 1996 was filed on February 12, 1997. Accompanying the petition were: copies of several pieces of correspondence between patentee and patentee's counsel Peter F. Felfe (Felfe), and a verified statement from Felfe.

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 asserts that the delay in payment of the maintenance fee was unavoidable due to an error in translation of a letter from patentee to Felfe, which instructed Felfe to submit the payment.

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b)(3).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 608-609, 34 USPQ2d at 1787. It is the actions or inactions of the responsible party which are relevant to determining whether the maintenance fee payment was unavoidably delayed. It is solely the responsibility of the patentee to ensure that the maintenance fee is timely paid. However, the record shows that patentee delegated the responsibility of tracking and scheduling payment of the maintenance fee to the law firm of Felfe and Lynch.

Petitioner asserts that patentee sent a letter written in German to counsel on May 22, 1992 (Exhibit 1). Counsel, Peter Felfe, incorrectly translated the letter to read that the maintenance fee was not to be paid and wrote on the front of the letter "OK to abandon" and "don't pay June 6 fee." The letter actually advised counsel to pay the maintenance fee. Petitioner further asserts that, under the agreement in effect between Felfe and petitioner, the presence of a communication regarding a maintenance fee payment would ordinarily signify instructions from petitioner not to make the payment. Nevertheless, the showing of record is that petitioner had instructed counsel to make the payment, counsel received the letter, and either failed to properly translate, or to have properly translated, the aforementioned instructions. Such does not reflect that counsel exercised the due care and diligence generally used and observed by prudent and careful men in relation to their most important business within the meaning of Pratt, supra.

Since petitioner was represented by a registered practitioner, the Patent and Trademark Office (Office) must rely on the actions or inactions of the duly authorized and voluntarily chosen representatives of the patentee, and patentee is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). 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). Moreover, the Office is not the proper forum for resolving a dispute between patentee and his representative regarding the payment of maintenance fees. Ray, 55 F.3d at 610, 34 USPQ2d at 1789.

Rather, the showing of record is that counsel consciously and deliberately choose to allow the patent to expire. A delay caused by a deliberate decision not to take those actions indicated as necessary within a given time period cannot be viewed as constituting an "unavoidable delay" or an "unintentional delay" within the meaning of 35 U.S.C. §41(c)(1), 37 CFR 1.378(b) and 37 CFR 1.378(c). In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Such intentional action or inaction precludes a finding of unavoidable delay. In re Maldaque, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). Moreover, the delay resulting from such a deliberate decision by counsel, even when that decision is made in error, is not unavoidable delay. Id.

The record fails to adequately evidence the delay was unavoidable since reasonable care was not taken to ensure that the maintenance fee would be timely submitted.

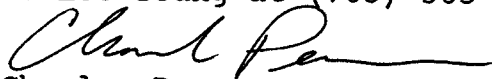
CONCLUSION

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 no fees other than the \$130 fee for the instant request for reconsideration have been charged, no refund is due.

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

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
for Patent Policy and Projects

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