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In re Patent No.:4,815,415
 Issue Date: March 28, 1989
 Application No. 07/147,311
 Filed: March 28, 1988
 Attorney Docket No.: ZAPF378.1

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 ON PETITION

This is a decision on the petition, filed by facsimile June 9, 1997, under 37 CFR §1.378(e) requesting reconsideration of a prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

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

BACKGROUND

The patent issued March 28, 1989. Accordingly, the first maintenance fee due could have been paid during the period from March 30, 1992 (March 28, 1992 being a Saturday) through September 28, 1992, or with a surcharge during the period from September 29, 1992 through March 29, 1993 (March 28, 1993 being a Sunday). Accordingly, this patent expired after midnight on March 28, 1993 for failure to timely pay the maintenance fee. 37 C.F.R. 1.378(g).

A petition requesting acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b) was filed January 10, 1997, which petition was dismissed in the decision mailed April 7, 1997.

The instant petition was filed June 9, 1997 and is accompanied by a declaration from Peter Sommerkamp (Sommerkamp), patent director for the assignee.

STATUTE AND REGULATION

35 USC 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 if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable"; 35 USC 41(c)(1).

Petitioner requests reconsideration of the decision mailed April 7, 1997 in that petitioner asserts that his representatives Felfe & Lynch (Felfe) and the assignee via Sommerkamp acted reasonably and with due care of a prudent person.

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

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, 608-09, 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).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id.

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 solely the responsibility of the patentee to ensure that the maintenance fee is timely paid.

The showing of record is that the patent holder had originally engaged Felfe to schedule and pay the maintenance fee, and in due course, timely instructed Felfe to submit the payment, which in turn, Felfe docketed for payment. The showing of record is further that, prior to the time of payment by Felfe, patent holder requested of Felfe a listing of all of patent holder's patents that Felfe had docketed for maintenance fee payment, and moreover, instructed Felfe that patent holder wished to transfer that responsibility to another representative, Dennemeyer & Co. (Dennemeyer), on or about "September 1992, the end of the fiscal year 91/92." (exhibit 2).

The record also shows that patent holder and Felfe came to an agreement that Felfe would continue to pay maintenance which were due prior to September 1, 1992 (exhibits 2 and 3). Nevertheless, the showing is that Felfe did not pay the fee, believing that Dennemeyer was responsible, and Dennemeyer did not pay the fee, believing Felfe bore that responsibility.

The record fails to establish that petitioner, Felfe, or Dennemeyer, took adequate steps to ensure timely payment of the maintenance fee as required by 37 CFR 1.378(b)(3). Since adequate steps were not taken by any party, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee. As such, there is no need in this case to determine the obligation between petitioner, Felfe and/or Dennemeyer, since the record fails to show that petitioner, or any other party, took adequate steps to ensure timely payment of the maintenance fee. In re Patent No. 4,461,759, 16 USPQ2d 1883, 1884 (Comm'r Pat. 1990).

Assuming, *arguendo*, that Felfe and/or Dennemeyer had been properly appointed to conduct petitioner's matters subsequent to the grant of the instant patent, including matters pertaining to the payment of the maintenance fee, then petitioner remains bound by the decisions, actions, or inactions, of Felfe and/or Dennemeyer, including the decisions, actions, or inactions, which resulted in the lack of timely payment of the maintenance fees for this patent. See, Winkler v. Ladd, 221 F. Supp 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the patent holder, and petitioner is bound by the consequences of

those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, petitioners' delay caused by mistakes or negligence of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, *id.*; Smith v. Diamond, *id.*; Potter v. Dann, 201 USPQ 574 (D.D.C. 1978). Consequently, the delay caused by the failure of either Felfe, or Dennemeyer, to timely remit the maintenance fee does not constitute unavoidable delay. Specifically, while petitioner chose to rely upon Felfe and Dennemeyer, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c). See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259. (D.Del. 1995). Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether Felfe/Dennemeyer acted reasonably and prudently. *Id.* Nevertheless, petitioner is bound by any errors that may have been committed by Felfe/ Dennemeyer. California, *supra*.

The showing of record is that neither petitioner, Felfe, nor Dennemeyer, had timely reached an adequate and clear understanding as to the obligation of each in this matter, which is not grounds for a finding of unavoidable delay in submission of the maintenance fee, within the meaning of 35 USC 41(c) and 37 CFR 1.378(b).

Delay resulting from a lack of proper communication between a patentee and that patentee's representative(s) as to the responsibility for scheduling and payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). See, In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). Specifically, delay resulting from a failure in communication between a representative and his client regarding a maintenance fee payment is not unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). Ray, 55 F.3d at 610, 34 USPQ2d at 1789. That all parties failed to take adequate steps to ensure that each fully understood the other party's meaning, and thus, their own obligation in this matter, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business within the meaning of Pratt, *supra*. It is further brought to petitioner's attention that the Office is not the proper forum for resolving a dispute between a patentee and that patentee's representative(s) regarding the scheduling and payment of maintenance fees. Ray, *supra*.

The request for reconsideration, although including the declaration of Mr. Sommerkamp and attorney analysis of the events, does not provide a new showing of substantive facts which would alter the holding in the previous decision on petition mailed April 7, 1997.

The showing of record is that petitioner erroneously believed that payment would be made in response to his letter of February 10, 1992 which did not request a specific payment date, but merely requested that the maintenance fee be paid "well in advance of the due date." Unaware of Felfe's practice of docketing payment only one week in advance of the due date, petitioner permitted a one month lapse in coverage between petitioner's maintenance fee payment contracts. Petitioner's belief that the maintenance fee had been paid prior to the Sommerkamp letter of March 2, 1992 and the Felfe confirmation of March 17, 1992 is

unavailing because all of this occurred before the opening of the window for payment. Furthermore, the Felfe confirmation of March 17, 1992 clearly states that the attached docket reports show "maintenance fees that are due now through 2003;" therefore, the assignee, via Sommerkamp, was on notice that the maintenance fee for the patent in question had not been paid. Petitioner's failure to note that the above-captioned patent still had, as of March 17, 1992, an outstanding due date, or to request clarification of this matter, does not reflect the due care and diligence of a prudent and careful person with respect to their most important business, withing the meaning of Pratt, supra. Furthermore, since petitioner asserts that petitioner was reasonable in believing that Felfe had been, and remained, obligated to pay the maintenance fee for this patent, petitioner has also failed to demonstrate why petitioner's failure to monitor Felfe's performance under the putative contract can reasonably be considered to constitute unavoidable delay. See Futures Technology Ltd. v. Quigg, 684 F.Supp. 430, 7 USPQ2d 1588 (E.D. Va. 1988). That is, petitioner's failure to observe that petitioner had never been billed for Felfe's allegedly obligated services for this patent with respect to payment, much less the maintenance fee itself, does not reflect the due care and diligence employed by a prudent and careful person with respect to their most important business. See Id. Rather, a prudent person takes diligent action to ensure that contracted services are timely performed as specified. Id. However, the record lacks any showing that petitioner was monitoring Felfe's performance, viz, payment of the necessary fees to maintain this patent in force, under the contract asserted to have been in effect between petitioner and Felfe.

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, the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b).

As authorized in the request for reconsideration, petitioner's deposit account 06-0530 has been charged the \$130 fee for requesting reconsideration.

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

Telephone inquiries related to this decision should be directed to Howard Williams at (703) 308-6713 or the Office of Petitions staff at (703) 305-9282.

A handwritten signature in cursive script, reading "Manuel Antonakas".

Manuel Antonakas
Director, Office of Patent Policy Dissemination
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

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