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In re Patent No. 5,012,148
Issue Date: April 30, 1991
Application No. 07/407,211
Filed: September 14, 1989
Inventor: Joseph Vithayathil

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ON PETITION

This is a decision on the petition under 37 CFR 1.378(e), filed May 28, 1998, 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 the delayed payment of the maintenance fee under 37 CFR 1.378(b) is DENIED.

BACKGROUND

The patent issued April 30, 1991. The first maintenance fee could have been paid during the period from May 2, 1994 (April 30, 1994 being a Saturday), through October 31, 1994 (October 30, 1994 being a Saturday), or with a surcharge during the period from November 1, 1994 through May 1, 1995 (April 30, 1995 being a Sunday). The patent expired at midnight on April 30, 1995 for failure to pay the first maintenance fee.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on January 15, 1997, and was dismissed in the decision of March 30, 1998.

The instant petition under 37 CFR 1.378(e) was filed on May 28, 1998.

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).

Petitioner urges that the decision of March 30, 1998, be reconsidered, given that the delay was unavoidable in that "[t]he personal tragedies of the loss of [Petitioner's] father, serious sickness of [Petitioner's] mother, the loss of employment and the preoccupations cause by the repeated changes in residence disrupted [Petitioner's] plans and [Petitioner] lost track of the date of payment of the maintenance fee for the patent."

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

Acceptance of late payment of a 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 in responding to an Office action 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, 514-515 (D.C. Cir. 1912); and 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). 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. Ouigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In the previous decision (at 3), Petitioner was advised for any renewed petition that "if it is Petitioner's contention that the stress of his life incapacitated him to the point that late payment of the first maintenance fee was unavoidable, evidence of such by a health care provider will have to be provided. Such evidence would include a showing that Petitioner was incapacitated to the point the he could not carry out his day to day affairs during the entire [time period]." However, no adequate reply to this requirement has been provided.

Although Petitioner's personal situation as recounted in the petitions is unfortunate, it is noted the death of Petitioner's father and Petitioner's loss of employment occurred more than two and one half years before the expiration of the patent. Regarding Petitioner's own period of hospitalization, it is noted that this period was approximately two and one half years after expiration of the patent. As the record fails to adequately document that petitioner was incapacitated to the point that he could not carry out his day to day affairs during the entire time period from April 30, 1995 until December 29, 1997, it has not been established that the delay in paying the maintenance fee was unavoidable. Likewise, while petitioner has provided some documentation pertaining to the medical expenses arising from his heart surgery in 1997, such fails to demonstrate that the entire delay in paying the first maintenance fee was unavoidable. Rather, the decision of March 30, 1998 required (at 3) that petitioner provide a documented showing as to records of any assets, credit, and obligations, which made the entire delay unavoidable.

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 the previous decision (at 3), Petitioner was advised that "any renewed petition must include copies of any documents establishing that Petitioner had, in place, steps to ensure timely payment of the maintenance fee". No sufficient reply to this requirement has been provided.

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). Since adequate steps were not taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee. 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.

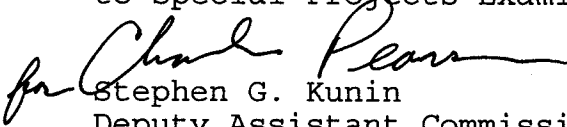
CONCLUSION

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 this patent will not be reinstated, the \$525 maintenance fee and the \$700 surcharge fee submitted by petitioner are refundable. The \$130 fee for requesting reconsideration filed with the instant petition is not refundable. Accordingly, \$1225 will be refunded by Treasury Check in due course.

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 Special Projects Examiner Brian Hearn at (703) 305-9282.


Stephen G. Kunin
Deputy Assistant Commissioner
for Patent Policy and Projects

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