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In re Patent No. 5,018,230 :  
Issue Date: May 28, 1991 :  
Application No. 07/508,165 :  
Filed: April 12, 1990 :  
Patentee: Paul Steberger :

ON PETITION

This is a decision on the petition under 37 CFR 1.378(e), filed October 24, 1997, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee and reinstate the above-identified patent.

The request to accept the delayed payment of the maintenance fee and reinstate the above-identified patent is **DENIED**.

#### BACKGROUND

The above-identified patent (U.S. Patent No. 5,018,230) issued on May 28, 1991. Therefore, the first maintenance fee could have been paid during the period from May 31, 1994 (May 28, 1994 being a Saturday and May 30, 1994 being a federal holiday) through November 28, 1994, or with a surcharge during the period from November 29, 1994 through May 30, 1995 ((May 28, 1995 being a Sunday and May 29, 1995 being a federal holiday). The first maintenance fee for the above-identified patent, however, was not timely paid. Accordingly, the above-identified patent expired at midnight on May 28, 1995.<sup>1</sup>

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<sup>1</sup> While 35 U.S.C. § 21 and 37 CFR 1.7 operate to extend the period during which the maintenance fee (and any required surcharge) may be timely paid, they do not operate to extend the expiration date of the patent when the maintenance fee (and any required surcharge) is not timely paid. See MPEP 2506.

A petition under 37 CFR 1.378(b) was filed on July 15, 1997, and was dismissed in the decision of August 25, 1997. The instant petition was filed on October 24, 1997, and requests reconsideration of the decision of August 25, 1997, and acceptance of the delayed payment of a maintenance fee for and reinstatement of the above-identified patent.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) provides that:

The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable. The Commissioner may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Commissioner accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 CFR 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

(1) The required maintenance fee set forth in § 1.20 (e)-(g);

(2) The surcharge set forth in § 1.20(i)(1); and

(3) 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

Petitioner originally (in the petition of July 15, 1997) asserted that the delay in payment of the maintenance fee for the above-identified patent was due to the failure of petitioner's representative of record, Robert Ferb (Ferb), to receive notice from the Patent and Trademark Office (PTO) that a maintenance fee was due for the above-identified patent. Petitioner now additionally asserts, *inter alia*, that: (1) Ferb never advised petitioner of the need to timely pay maintenance fees to maintain a patent in force; (2) Ferb relocated approximately one year after the above-identified patent was issued; and (3) an attempt to automate the manual docketing system resulted in a combination of errors in setting up the system and making docket entries.

As the language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (*i.e.*, "unavoidable" delay), a delayed maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133. See 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), aff'd, Rydeen v. Ouigg, 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)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word '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. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (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 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Ouigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner has failed to carry his burden of proof to establish to the satisfaction of the Commissioner that the delay in payment of the maintenance fee for the above-identified patent was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).

With regard to petitioner's arguments concerning his lack of knowledge of the need to timely pay maintenance fees to maintain a patent in force or his (or his representative's) non-receipt of a Maintenance Fee Reminder, neither a lack of knowledge of the need to pay maintenance fees nor a failure to receive a Maintenance Fee Reminder constitute unavoidable delay under 35 U.S.C. § 41(c) and 37 CFR 1.378(b). See Patent No. 4,409,763, 7 USPQ2d at 1800-01. Under the statutes and regulations, the PTO has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the PTO. Id.

In any event, petitioner was given three (3) notices of the need to timely pay maintenance fees to maintain the above-identified patent in force. First: The Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. Accordingly, a reasonably prudent patentee would have inquired to see if his patent was subject to maintenance fees. See Ray, 55 F.3d at 610, 34 USPQ2d at 1788. Second: A notice that the maintenance fee due at three years and six months from the issue date was now payable for utility patents having patent numbers between 5,018,220 through 5,020,155 was published in the Official Gazette at 1162 Off. Gaz. Pat. Office 94 (May 31, 1994). See Patent No. 4,409,763, 7 USPQ2d at 1801. Third: A Maintenance Fee Reminder was mailed to the correspondence address then and still of record (P.O. Box 8109,

15 West High Street, Somerville, NJ 08876) on January 3, 1995. See Ray, 55 F.3d at 610, 34 USPQ2d at 1788.<sup>2</sup>

As 35 U.S.C. § 41(b) 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. The record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee.

A showing of unavoidable delay based upon docketing error requires a petitioner to establish that: (1) his or her representative was justified in relying upon the docketing system in place (*i.e.*, the docketing system was sufficiently trustworthy); and (2) the docketing error was the cause of the delay in taking action. See In re Egbers, 6 USPQ 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Ouigg, 10 USPQ 1787 (D.D.C. 1988). Thus, to meet the burden of establishing unavoidable delay based upon docketing error, petitioner must provide: (1) a thorough explanation of the docketing and call-up system in use with an identification of the type of records kept, as well as a showing of the training and experience of the persons responsible for maintaining the docket; (2) an indication as to why the system failed in this instance to provide adequate notice that action was due; (3) copies of docket sheets, docket printouts and such other records as may exist which would substantiate the asserted docketing error and that the docket system was otherwise sufficiently trustworthy that petitioner's (or petitioner's representative's) reliance on such system was

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<sup>2</sup> While petitioner indicates that the Maintenance Fee Reminder is not in petitioner's file, there is no adequate showing that the Maintenance Fee Reminder was not properly delivered to P.O. Box 8109, 15 West High Street, Somerville, NJ 08876. Cf. Withdrawing the Holding of Abandonment When Office Actions Are Not Received; Notice, 1156 Off. Gaz. Pat. Office 53 (November 16, 1993) (notice setting forth the evidence necessary to establish nonreceipt of a PTO notice).

reasonably prudent; and (4) statements by all persons with direct knowledge of why the docket system failed in this instance, setting forth the facts as they know them.

The instant petition fails to set forth, with any degree of particularity, the docketing system (manual or automated) used to track the maintenance fee due dates for the above-identified patent. Specifically, there is no reasonably specific showing as to: (1) how patent maintenance fee due dates are docketed in this system; (2) whether this system could reasonably be relied upon to provide notice that a maintenance fee payment was due (i.e., there is no showing that the system routinely provided timely notice of upcoming maintenance fee payment due dates for other patents); or (3) whether the above-identified patent was even intended to be entered into this docket system. The instant petition also lacks any documentary evidence that would corroborate that the docket system was otherwise sufficiently trustworthy that petitioner's (or petitioner's representative's) reliance on such system was reasonably prudent, or even corroborate the existence of such docketing system. Finally, the instant petition fails to identify the persons tasked with installing the automated docketing system, entering patent due date information into the manual or automated docketing system, or checking action due dates using this docket system, much less provide statements from such persons setting forth their training or experience, as well as their explanation of why (or that) the docket system failed in this instance to provide notice that a maintenance fee payment was due.

In summary, petitioner has failed to specify, in any reasonable detail, the docket system employed to track the maintenance fee due dates for the above-identified patent, the experience and training of the persons who set-up and maintained the docket system, or why the docket system failed to provide notice in this instance that a maintenance fee payment was due. Therefore, petitioner has failed to establish either that: (1) the docketing system in place was sufficiently trustworthy that his representative (Ferb) was justified in relying upon it; or (2) the docketing error was the cause of the delay in paying the maintenance fee for the above-identified patent. Accordingly, the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee.

#### CONCLUSION

For the above stated reasons, petitioner has failed to carry his burden of proof to establish to the satisfaction of the

Commissioner that the delay in payment of the maintenance fee for the above-identified patent was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b). Therefore, 35 U.S.C. § 41(c) and 37 CFR 1.378(b) preclude acceptance of the delayed payment of the maintenance fee for the above-identified patent.


The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of August 25, 1997 has been reconsidered; however, the request to accept the delayed payment of the maintenance fee for the above-identified patent is **DENIED**.

Since the above-identified patent will not be reinstated, the \$510.00 maintenance fee and the \$680.00 surcharge fee submitted by petitioner will be refunded.

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

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9282.

The patent file is being returned to Files Repository.



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