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Paper No. 11

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**OFFICE OF PETITIONS**

In re Patent of Zumbuhl :  
Patent No. 5,107,998 :  
Issue Date: April 28, 1992 :  
Application No. 07/715,610 :  
Filing Date: June 14, 1991 :  
Attorney Docket No. 13559.001 :

Decision on Petition

This is a decision on the reconsideration petition under 37 CFR 1.378(e) filed October 24, 2007 and supplemented on November 27, 2007, to reinstate the above-identified patent.

The petition is **DENIED**.<sup>1</sup>

**Background**

The patent issued April 28, 1992. The 11.5 year maintenance fee could have been paid between April 28, 2003, through October 28, 2003, or with a surcharge during the period from October 29, 2003, through April 28, 2004. The fee was not timely paid. Accordingly, the patent expired as of midnight on April 28, 2004.

A petition under 37 CFR 1.378(b) was filed on April 9, 2007. The petition was dismissed in a decision mailed August 15, 2007.

The contents of the prior decision on petition, mailed August 15, 2007, is incorporated by reference into the present decision.

It is noted that a reconsideration petition under 37 CFR 1.378(e) has been filed in application no. 09/184,119. The inventor/patentee of Application No. 09/184,119/Patent No. 5,992,661 and the present application/patent is the same person – Bruno Zumbuhl. The arguments for reinstatement of the patents are the same. Therefore, the petitions and the decisions in both applications/patents will be considered.

<sup>1</sup> This decision may be viewed as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP 1002.02. The terms of 37 C.F.R. 1.137(d) *do not apply* to this decision.

**Applicable Statute and Regulation**

35 U.S.C .41(c)(1) states that:

“The Director 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 Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.”

37 CFR 1.378(b) states 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.

**The Burden of Proof**

The statute requires a “showing” by petitioner. Specifically 35 U.S.C. 41(c)(1) states, "The Director may accept the payment ... if the delay is shown to the satisfaction of the Director to have been unavoidable." Therefore, petitioner has the burden of proof.

**Opinion**

Petitioner asserts that the delay in payment of the third maintenance fee was unavoidable because:

- 1 his attorney, Mr. Charles Temko, failed to notify him of a maintenance fee due date;
2. he did not receive correspondence from the Office that a maintenance fee was due; and
3. his health difficulties.

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 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, 608-609, 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).

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. Consequently, a reasonably prudent person in the exercise of due care and diligence will take steps to ensure the timely payment of maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. Thus, it follows that an adequate showing of unavoidable delay in payment of a maintenance fee, 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 the patent. Id. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

The record is silent as to whether or not petitioner kept Mr. Temko informed as to a current mailing address. At the time the patent issued, patentee was represented by attorney Charles Temko. The address of record was the address for Mr. Temko. Petitioner has not shown that relying on Mr. Temko for notification that a maintenance fee was due was reasonable, given that Mr. Temko was not notified of petitioner's change of address.

Per the April 9, 2007 petition: On or about May 11, 1995, Mr. Temko notified patentee of the need to pay the 3.5 year maintenance fee. As a result, the fee was timely paid. On or about July 22, 1999, Mr. Temko notified patentee of the need to pay the 7.5 year maintenance fee. As a result, the fee was timely paid.

It is noted that the decision on petition, mailed August 15, 2007, specifically asked petitioner to inform the Office if the address for the patentee changed at any time between July 22, 1999 and April 28, 2004. (decision p.3). Patentee did not respond to this request in any of the reconsideration petitions.

Even if Mr. Temko had been informed of patentee's correct address, reliance *per se* on a third party for tracking a maintenance fee does not provide a patent holder with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. 41(c). Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether that third party acted reasonably and prudently. In any event, petitioner is bound by any errors that may have been committed by petitioner's representatives. See California Medical Products v. Technology Med. Prod., 921 F. Supp. 1219 (D.Del. 1995).

Petitioner argues that patentee was incapacitated from early 2003 to the present and that patentee relied on his daughter to assist him in staying current on everyday events, including his common debts, utilities and rent. (Affidavit of Bruno Zumbuhl, November 15, 2007) Patentee also relied upon his attorney to advise him when a maintenance fee was due, rather than tracking the maintenance fees himself. His daughter would not know a maintenance fee was due unless Attorney Temko mailed some sort of reminder notice.

If petitioner was represented by a registered practitioner the Office must rely on the actions or inactions of the duly authorized and voluntarily chosen representative, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). If the attorney made any errors, petitioner is bound by such errors.<sup>1</sup>

The attorney must act reasonably and prudently.

If [the] attorney somehow breach[es] his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [the attorney's] action or inaction with regard to the patent application. He hired the [attorney] to represent him. [The attorney's] actions must be imputed to him.<sup>2</sup>

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<sup>1</sup> See California Med. Products v. Technol Med. Products, 921 F. Supp. 1219, 1259 (D. Del. 1995) (citing Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962))).

<sup>2</sup> Haines v. Quigg, 673 F. Supp. 314, 317, 5 U.S.P.Q. 2d (BNA) 1130 (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962) ("Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'" (emphasis added); Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983) ("Courts hesitate to punish a client for its lawyers gross negligence, especially when the lawyer affirmatively misled the client" but "if the client freely chooses counsel, it should be bound to counsel's actions."); see also Wei v. State of Hawaii, 763 F. 2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983)). See also Smith v. Diamond, 209 U.S.P.Q. (BNA) 1091 (D. D.C. 1981).

The Seventh Circuit has stated,

The other assumption is that, if the complainants failed in their application through the negligence of their attorney, the delay would be unavoidable, which is wholly unwarranted in the law. It is of the very nature of negligence that it should not be unavoidable, otherwise it would not be actionable. The negligence of the attorney would be the negligence of the [client]. The purpose of the statute was to put an end to such pleas, and there would be no limit to a renewal of these applications if every application, however remote, could be considered under the plea of negligence of attorneys, by whom their business is generally conducted.<sup>3</sup>

The United States Court of Appeals for the Federal Circuit has stated,

If we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.<sup>4</sup>

Petitioner stands in the shoes of his chosen representative. Petitioner has not provided documentary evidence that the attorney allegedly responsible for the maintaining of the patent acted as a reasonable and prudent person in relation to his most important business. Petitioner has provided no showing as to the attorney's steps in place to monitor and maintain the patent at issue.

Petitioner is advised that delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay. *In Re Kim*, 12 U.S.P.Q.2d 1595 (Comm'r Pat. 1988). Delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. 1.378(b). See *Ray*, at 610, 34 U.S.P.Q.2d at 1789.

With respect to petitioner's argument that the delay was unavoidable because he did not receive a Reminder Notice from the Office: In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, a patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See *Patent No. 4,409,763, supra*; see also "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), reprinted in 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office's mailing of Maintenance Fee Reminders is carried out strictly as a courtesy.

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<sup>3</sup> *Lay v. Indianapolis Brush & Broom Mfg. Co.*, 120 F. 831, 836 (1903).

<sup>4</sup> *Huston v. Ladner*, 973 F.2d 1564, 1567, 23 U.S.P.Q.2d (BNA) 1910 (Fed. Cir. 1992).

due. The Office's mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, 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/or the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Rydeen v. Quigg, 748 F. supp. at 900.

With respect to petitioner's argument that the delay was unavoidable because he was suffering from health difficulties: The Affidavit of Dr. Glenn Tindell establishes that patentee was battling cancer from August 2002 through at least April 2005

The degree of incapacitation of patentee is of secondary importance to the analysis at hand because patentee relied upon his attorney to inform him of maintenance fee due dates. The issue of the degree of incapacitation would not come up until patentee was aware a maintenance fee was due. The threshold issue is that patentee's attorney did not advise him when a maintenance fee was due.

The USPTO is sympathetic to petitioner's health issues. However, petitioner has not shown that but for his health issues, he would have paid the maintenance fee. While he was in treatment for cancer his daughter handled his finances. If she had been aware that a maintenance fee was due, it presumably would have been paid. Petitioner and his daughter did not know the maintenance fee was due because Attorney Temko failed to inform petitioner of the due date. Thus, petitioner's health issues are not the proximate cause of the delay.

The record, as it stands now, fails to show that patentee or his representative took the due care of a reasonably prudent and careful person, in relation to his most important business. Pratt, supra.

### Decision

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 reasons herein and stated in the previous decision, the entire delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. 41(c)(1) and 37 CFR 1.378(b). Therefore, the petition is **denied**.

As stated in 37 CFR 1.378(e), the Office will not further consider or review the matter of the reinstatement of the patent.

In due course, the Office will schedule a Treasury check refund of \$2,600.00, which corresponds to the maintenance fee and surcharge paid. The reconsideration fee of \$400.00 will be retained.

The patent file is being forwarded to Files Repository.

Telephone inquiries may be directed to Petitions Attorney Shirene Willis Brantley at (571) 272-3230.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson  
Director  
Office of Petitions