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In re Patent No. 5,127,543
 Issue Date: July 7, 1992
 Application No. 07/577,441
 Filed: September 04, 1990
 Inventor: Cheskel Meisels

SPECIAL PROGRAMS OFFICE
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 ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.378(e), filed September 5, 1997, and subsequent facsimile transmission received December 31, 1997, requesting reconsideration of a prior decision which refused to accept, under 37 C.F.R. § 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 C.F.R. § 1.378(b) is **DENIED**¹.

BACKGROUND

The patent issued July 7, 1992. The first maintenance fee could have been paid during the period from July 7, 1995 through January 11, 1996 (the Office was closed on January 8 through January 10, 1996 due to snow), or with a surcharge during the period from January 16, 1996 (the Office was closed on January 12, 1996 due to snow and Monday January 15, 1996 was a holiday) through July 8, 1996. Accordingly, this patent expired on midnight of July 8, 1996 for failure to timely pay the maintenance fee.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the first maintenance fee was filed on April 9, 1997, and was dismissed in the decision of July 7, 1997.

The instant petition under 37 C.F.R. § 1.378(e) was filed on September 5, 1997.

¹A denial of a petition under 37 C.F.R. § 1.378(e), requesting reconsideration of a prior decision which refused to accept the delayed payment of the maintenance fee as unavoidable, under 37 C.F.R. § 1.378(b), is not a final agency action with respect to filing a petition under 37 CFR § 1.378(c) stating that the delay in payment of the maintenance fee was unintentional. Public Law 102-444, effective October 23, 1992, provides for the reinstatement of an "unintentionally" expired patent. Final rules implementing this change were published at 58 *Federal Register* 44277 (August 20, 1993) and 1154 *Official Gazette* 35 (September 14, 1993).

On December 31, 1997, petitioner sent a facsimile transmission responsive to a Requirement for Information mailed November 20, 1997.

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 C.F.R. § 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 C.F.R. § 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 December. 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 Application. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 December. 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 has not carried his burden of proof to establish to the satisfaction of the Commissioner that the delay was 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 C.F.R. § 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. See Ray, at 608-609, 34 USPQ2d at 1787. It is solely the responsibility of the patent holder to ensure that the maintenance fee is timely paid. See, Wende v. Horine, 191 F. 620, 621 (C.C.N.D. Ill. 1911).

In the Requirement for Information, mailed November 20, 1997, petitioner was urged to provide a copy of petitioner's records showing that the due date for paying the maintenance fee was docketed on a calendar or other record keeping means. In response thereto, petitioner's facsimile of December 31, 1997 included a list of petitioner's patents and due dates. However, a list cannot be constructed for purposes of satisfying a requirement to show what steps were in effect, at the time the patent expired, to schedule, monitor and ensure timely payment of the maintenance fee. As such, the list cannot be construed as a copy of petitioner's records showing that the due date for paying the maintenance fee was docketed on a calendar or other record keeping means as was required. A reasonably prudent person, exercising due care and diligence, would have taken steps to ensure the timely payment of such maintenance fees of their patents. Ray, supra. Failure to act cannot be construed as unavoidable delay within the meaning of 37 C.F.R. § 1.378(b) and 35 USC 41(c).

Petitioner has provided two statements from James Halper, MD (Hapler) as evidence of unavoidable delay due to petitioner's mental incapacitation during the time period from July 1995 to August 1996. However, the evidence is not sufficient to establish unavoidable delay in paying the maintenance fee as petitioner timely paid maintenance fees for another of petitioner's patents (Patent No. 5,103,501) during this time period (see Requirement for Information, mailed November 20, 1997, ¶ 3). The record does not provide an adequate showing as to why petitioner was precluded from paying the maintenance fee for the above-identified patent when petitioner was well enough to pay maintenance fees for Patent No. 5,103,501. Further, there is no showing as to why petitioner's failure to pay the maintenance fee for the above-identified patent should be considered as unavoidable delay in view of these facts. The record clearly establishes that petitioner was able to pay maintenance fees during the period from July 1995 to August 1996. As such, the delay caused by petitioner's failure to pay the maintenance fee for above-identified patent cannot be construed as unavoidable within the meaning of 37 CFR § 1.378(b) and 35 USC 41(c).

The record fails to establish that the petitioner took adequate steps to ensure timely payment of the maintenance fee as required by 37 C.F.R. § 1.378(b)(3). Since adequate steps were not taken by patentee, 37 C.F.R. § 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

CONCLUSION

The prior decision which refused to accept under 37 C.F.R. § 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 C.F.R. § 1.378(b).

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

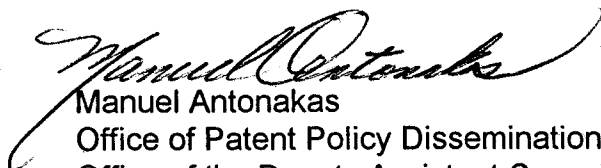
Petitioner should consider filing a petition stating that the delay in payment of the maintenance fee was unintentional under 37 CFR § 1.378(c). Public Law 102-444, effective October 23, 1992, provides for the reinstatement of an "unintentionally" expired patent. Final rules implementing this change were published at 58 *Federal Register* 44277 (August 20, 1993) and 1154 *Official Gazette* 35 (September 14, 1993). The surcharge due for a petition under 37 CFR § 1.378(c) is \$1,640. However, should petitioner pursue this venue, petitioner may apply the \$680.00 unavoidable surcharge,

received April 9, 1997, to the unintentional surcharge leaving a balance due of \$960.00. Enclosed is a petition form for petitioner's convenience.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (e.g., the expiration date of the patent and be accompanied by (1) a statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the \$1640.00 surcharge set forth in 37 CFR 1.20(i)(2). However, a petition under 37 CFR § 1.378(c) cannot be intentionally delayed and therefore should be filed promptly.

If petitioner does not wish to pursue a petition under 37 CFR § 1.378(c) then it is appropriate to refund the maintenance fee (\$510.00) and surcharge fee (\$680.00) submitted by petitioner since the patent will not be reinstated. Petitioner may request a refund of the fees submitted by writing to the Office of Finance. A copy of this decision should accompany petitioner's request.

Telephone inquiries relevant to this decision should be directed to John W. Cabeza or the staff at the Office of Petitions, at (703) 305-9282.


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

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Enclosure: Unintentional petition form under 37 CFR § 1.378(c).