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In re Patent No. 5,136,904 :
Issued: August 11, 1992 :
Application No. 07/697,595 : ON PETITION
Filed: May 9, 1991 :
For: MEANS AND METHODS OF :
CUTTING PATTERNS WITH POWERED :
COPING SAWS :

OFFICE OF PETITIONS

This is a decision on the renewed petition under 37 CFR 1.378(e), filed May 26, 2004.

The petition is DENIED¹.

No further reconsideration or review of this matter will be undertaken.

BACKGROUND

The patent issued August 11, 1992. The 3.5-year maintenance fee was timely paid December 20, 1995. The 7.5-year maintenance fee could have been paid from August 11, 1999 to February 11, 2000 without a surcharge or from February 12, 2000 to August 11, 2000 with a surcharge. Accordingly, the patent expired August 11, 2000 for failure to timely submit the 7.5-year maintenance fee.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed December 30, 2002 and dismissed March 26, 2004.

The instant petition under 37 C.F.R. § 1.378(e) requesting reconsideration of the decision mailed March 26, 2004 was filed May 26, 2004. Accompanying the petition was the required petition fee, copy of a letter from James R. Brown dated March 16, 2000, copies of maintenance fee statements, copy of letter

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See, MPEP 1002.02.

from Morris Wiseman dated June 23, 2003, and a change of correspondence form².

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 ... 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 C.F.R. § 1.378(b) (3) states that any petition to accept the 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."

37 C.F.R. § 1.378(e) states in pertinent that:

"After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director."

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable."³ Moreover, 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" delay⁴. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay

² The requested change of correspondence address has been entered into the record.

³ 35 U.S.C. 41(c) (1).

⁴ See, Ray v. Lehman, 55 F3d 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. 1988)).

was unavoidable⁵. Further, decisions on revival are made on a "case-by-case basis, taking all the fact and circumstances into account⁶." Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petition has failed to meet his or her burden of establishing the cause of the unavoidable delay⁷.

Petitioner attributes the delay in timely submission of the required maintenance fee to prior counsel Laurence Brown's failure to advise petitioner that the maintenance fee was due. Petitioner requests reconsideration in that (1) petitioner took reasonable care to ensure that maintenance fee would be timely paid by arranging for his attorney Laurence Brown to receive maintenance fee notices and notify petitioner of same; (2) that, unknown to petitioner, Mr. Brown retired and closed his practice, turning files over to the law firm of Brenner & Breiner in March, 2000; (3) that James R. Brown, office manager for Laurence Brown & Associates, mailed letters to some of Mr. Brown's clients giving notice of the closure and transfer of files⁸; and (4) that petitioner never received notice of maintenance fee due from Mr. Brown and thus was unaware of the need to pay the 7.5-year maintenance fee.

Petitioner has failed to satisfy his burden of proof that the delay in payment of the maintenance fee was unavoidable.

To the extent that petitioner relied upon Mr. Brown for payment of the maintenance fees, such reliance does not per se provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c)⁹. Rather, such reliance merely shifts the focus on the inquiry from petitioner to whether Mr. Brown acted reasonably and prudently¹⁰. Nevertheless, petitioner is bound by the errors that may have been committed by Mr. Brown¹¹. As such, assuming petitioner

⁵ See, 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), Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁶ See, Smith v. Mossinghoff, 671 F.2d 533, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁷ See, Haines v. Quigg, 673 F.Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁸ Petitioner has included a copy of this letter, allegedly obtained from a former client of Mr. Brown on May 21, 2004.

⁹ See, California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259. (D.Del. 1995).

¹⁰ Id.

¹¹ Id.

engaged Mr. Brown to pay the maintenance fee, then it was incumbent upon petitioner to have demonstrated via documented showing that Mr. Brown had docketed this patent for payment of the maintenance fee in a reliable docketing system¹². Petitioner has failed to show that Mr. Brown employed such a docketing system. Moreover, delay in timely submission of the requirement fee payment resulting from failure in communication between client and attorney is not unavoidable within the meaning of 37 CFR 1.378(b)¹³.

Furthermore, 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, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Douglas v. Manbeck, 21 USPQ2d (BNA) (1697) (E.D. PA Nov. 7, 1991). Consequently, the delay allegedly caused by the failure of Mr. Brown to issue a maintenance fee reminder to patentee in accordance with what patentee believed to be Mr. Brown's duties, does not constitute unavoidable delay. Moreover, that delay is imputed to patentee.

DECISION

The prior decision dismissing petition under 37 CFR 1.378(b) to accept delayed payment of maintenance fee has been reconsidered. For the reasons set forth herein the delay in payment of the maintenance fee cannot be regarded a unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b). Accordingly, the offer to pay the delayed maintenance fee will not be accepted and this patent will not be reinstated.

A refund of the previously submitted surcharge of \$700.00 and maintenance fee of \$1,010.00 has been requested from the Finance Office, Refund Section.

This file is being forwarded to files repository.

¹² Id.

¹³ In Re Kim, 12 USPQ2d 1595.

Telephone inquiries concerning this matter may be directed to
Petitions Attorney Alesia M. Brown at 571-272-3205.



Charles Pearson
Director
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