



Paper No. 14

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OFFICE OF PETITIONS

Patentee: Ulf Moren
Patent No. 5,544,489
Application No. 08/378,540
Filed: January 26, 1995
Issue Date: August 13, 1996
Title of Invention: DISPENSING APPARATUS
FOR A COOLED LIQUID WITH
THERMOELECTRIC PROBE

ON PETITION

This is a decision on the petition under 37 CFR 1.378 (e), filed on April 4, 2003 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 is **Denied**.

BACKGROUND

The patent issued August 13, 1996. The 3.5 year maintenance fee could have been paid from August 13, 1999 to February 13, 2000, or with a surcharge during the period from February 14, 2000 to August 13, 2000. Since the maintenance fee was not paid during these periods, the patent expired on August 14, 2000.

A petition to accept the delayed payment of the maintenance fee pursuant to 37 CFR 1.378(b) was filed on October 22, 2002 and dismissed on February 5, 2003.

The instant petition requests reconsideration of the decision of February February 5, 2003. The request for reconsideration is accompanied by the declarations of Gerry L. Ginsburg, David Fink, Brian Rabe and Ulf Moren.

STATUE 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.

Any petition under 37 CFR 1.378(b) a petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in §1.20 (e) through (g);
- (2) The surcharge set forth in §1.20(l)(1); and

- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure 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

A petition under 37 CFR 1.378(b) for the acceptance of an unavoidably delayed payment of maintenance fee is considered under the same standard as that for reviving an application unavoidably abandoned under 37 CFR 1.137(a) because 35 U.S.C. § 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."³ 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.⁴

Petitioner asserts computer malfunction as the reason for the failure to timely pay the maintenance fee.

Petitioner has failed to sufficiently establish that the delay in timely payment of the maintenance fee was unavoidable.

A review of the evidence submitted by petitioner reveals petitioner relocated his office from Stamford, Connecticut (the PTO address of record) to Houston, Texas. However, petitioner maintained his Connecticut address to receive correspondence. Petitioner relied upon his former tenant Gerry L. Ginsburg to forward any mail received at petitioner's Connecticut address. Petitioner states based upon his years of experience he believed he was capable of maintaining reliable records of due dates and maintain a docket on his computer using Microsoft Outlook. In September 1997, petitioner had a computer consultant transfer data and computer programs from petitioner's old computer to a new computer because the old computer started operating erratically after the relocation.

¹Ray 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)).

²Ex 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 man in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

³Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁴Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner assumed all of the data was successfully transferred to his new computer. Petitioner did not print out a docket of due dates. In March of 2000, petitioner again used the services of a consultant to transfer data and replace his computer. It was during the second transfer that petitioner states he was informed by the consultant that petitioner should not depend entirely on the computer because one could experience the loss of portions of data. After the second transfer, petitioner reviewed the data and did not notice missing data. Petitioner contends it is likely the data regarding the above-identified patent was likely lost prior to the first transfer of data. Petitioner did not become aware the patent was expired until August 21, 2002, when he was notified by Brian Rabe President of Coolworks, Inc. the assignee of the above-identified patent.

The facts stated in the declaration of Mr. Ginsburg, as to the manner in which mail was handled once it was received at the Connecticut address, does not aid in establishing the delay in paying the maintenance fee payment was unavoidable. The mailing of maintenance fee reminders is completely discretionary and not a requirement imposed by Congress.⁵ Under the statutes and rules, the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. 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 Office. The Office will attempt to assist patentees through the mailing of a Maintenance Fee Reminder in the grace period. However, the failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fees to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b). See MPEP 2590. Secondly, the fact that petitioner failed to provide a change of correspondence address and relied upon Mr. Ginsburg to forward any incoming mail illustrates petitioner assumed the risk that correspondence forwarded from Mr. Ginsburg to petitioner could be mishandled or become lost in the mail. A delay for failure to provide the Patent and Trademark Office with a current correspondence address does not constitute an unavoidable delay.⁶

Petitioner's argument of unavoidable delay based upon computer malfunction fails because it has not been established the maintenance fee due date was ever correctly entered into the docketing system.⁷ Petitioner yet again makes no mention of any backup

⁵ See Rydeen v. Quigg, 748 F. Supp. 900, 907 (1990).

⁶ See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

⁷ Since petitioner states he as the attorney of record was responsible for maintaining any due dates, petitioner can not rely upon docket error arguments to establish unavoidable delay. Docketing errors can only be attributed to an employee not to an attorney or agent of record. See MPEP 711.03(c).

system that may have been in place (paper or otherwise). Assuming the maintenance fee due dates were entered in the docketing system, a reasonably prudent person would know that a computer can be subject to loss of data, viruses, theft and crashes. A reasonably prudent person would not have relied solely on a computer system that was without benefit of backup and had demonstrated a propensity to act erratically. In essence it was foreseeable that a computer system which had demonstrated unreliability could fail to maintain trustworthy records.⁸ A reasonably prudent person would have maintained a hard copy of maintenance fee due dates. Once petitioner was on notice that the computer was acting erratically prior to the first replacement of the computer a reasonably prudent person would have made backups of data and checked before and after the transfer of the data to the new computer to verify whether any data was lost. What petitioner has presented is mere speculation as to what may have happened to the maintenance fee due dates which may or may not have been entered into a docket system which was kept on an unreliable computer system without benefit of a backup.

In summary, petitioner has not made a sufficient showing of unavoidable delay in timely paying the maintenance fee.

CONCLUSION

The prior decision which refused to accept under §1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, the 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).

Since this patent will not be reinstated, a refund check covering, the maintenance fees (\$440.00) and surcharge fee (\$700.00) for the present request for reconsideration, as been scheduled.

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

The application is being forwarded to Files Repository.

⁸ A person exercising prudent and reasonable care can rely upon 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. *In Re Mattullah*, 38 App. D.C. 497, 514-515 (D.C. Cir 1912) quoting *Ex Parte Pratt* (39 Off. Gaz. 1549; 1887 C.D. 31).

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