



Paper 11

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OFFICE OF PETITIONS

In re Patent No. 5,683,295 :
Issue Date: November 4, 1997 :
Application No. 08/662,636 :
Filed: June 13, 1996 :
Title of Invention: **ELECTRONIC BINGO** :
GAME SYSTEM WITH AUTOMATIC SCORING :

ON PETITION

This is a decision on the Renewed Petition filed December 27, 2007, in response to a prior decision mailed February 12, 2007, refusing to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent. The response is treated as a petition under 37 CFR 1.378(e).

The petition under 37 CFR 1.378(e) is **DENIED**.¹

BACKGROUND

The patent issued on November 4, 1997. The first maintenance fee due could have been paid during the period from November 6, 2000 to May 6, 2001 or, with a surcharge during the period from May 7, 2001 to November 4, 2001. Additionally, the second maintenance fee could have been paid during the period from November 4, 2004 to May 3, 2005 or, with a surcharge during the period from May 4, 2005 to November 4, 2005. Accordingly, this patent expired on November 5, 2001 for failure to timely remit the first maintenance fee.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on July 5, 2006 in which petitioner asserted that he did not receive the February 19, 2001 Maintenance Fee Reminder from his representative, that he was seriously ill from August 1994 until November 4, 2001 and thus the delay in paying the maintenance fee was unavoidable. The petition further argued that since no response was filed to the reminder letter of February 19, 2001 regarding the first maintenance fee and since the patent had lapsed, the patentee's representative did not send a reminder letter regarding the second maintenance fee due. Finally, the petition argued that petitioner did not learn that the patent had lapsed until June 6, 2006 when he contacted his representative about the possibility of filing an application for an improvement on the patent.

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

The evidence provided included a copy of the letter sent February 19, 2001 as a reminder that the second Maintenance Fee (letter incorrectly characterized the maintenance fee as the second Maintenance Fee) was due.

The decision dismissing the petition noted that since the system of maintenance fee reminders failed, a showing of unavoidable delay would have to include evidence that back up measures were in place that also failed. Absent such a showing, petitioner was not diligent with respect to the payment of the maintenance fees.

The instant petition under 37 CFR 1.378(e) purports to provide additional evidence as to why petitioners believe the payment of the first maintenance fee was delayed and why that delay was unavoidable.

STATUTE AND REGULATION

35 USC 41(c)(1) states that:

The Director 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 Director to have been unavoidable.

37 CFR 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. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

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". 35 USC 41(c)(1).

Acceptance of a late maintenance fee on the basis of unavoidable delay is considered under the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 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. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C.

Cir. 1912)("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"); 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).

It should be noted that even though the maintenance fee reminder letter was sent to the Patentee at a New York address as well as a Florida address, the original petition argued non-receipt as the cause of the unavoidable delay. The original petition also argued that the petitioner's ill health was the cause of the unavoidable delay, however, no evidence regarding petitioner's health conditions during the relevant periods was provided. The request for reconsideration only provides evidence regarding petitioner's health and thus the argument varies as no additional evidence regarding non-receipt has been provided.

Petitioner's request for reconsideration filed by the patentee and not his representative supplements the evidence filed with the original petition by providing medical records covering a time period of August 17, 1994 to July 11, 2007, to support his argument that because of the seriousness of his illness and his preoccupation with his health, he had not realized that the patent had lapsed for failure to pay the first maintenance fee.

There is no showing that petitioner took any steps to docket, calendar, schedule, or otherwise track the due dates of the maintenance fees for the above-identified patent. As the record fails to disclose that the patentees took any steps to ensure timely payment of the maintenance fees, 35 USC 41(c)(1) and 37 CFR 1.378(b)(3) preclude the acceptance of the delayed payment of the maintenance fee for the above identified patent. The fact that petitioner may have failed to receive the maintenance fee reminder is immaterial.

As indicated above, an adequate showing of unavoidable delay requires a showing of unavoidable delay until the filing of a petition to reinstate the expired patent. Assuming petitioner's illness left him incapacitated, the showing of record does not establish that petitioner's condition left him incapacitated for the entire period or that the incapacitation disrupted petitioner's ability to conduct business or pay bill's such as the maintenance fee during the entire period between November 6, 2000 and the date the petition was filed July 5, 2006. Specifically, there are no statements by petitioner's treating physicians that petitioner was unable to conduct business for the entire period between November 6, 2000 and July 5, 2006, and there is no evidence that petitioner's medical condition resulted in petitioner's failure to conduct other business or to manage his affairs during that period.

To the contrary, petitioner spent part of the time in question in Florida and a Consultation

Report dated August 14, 2002 noted that "The patient is extremely active physically and plays tennis on a regular basis...He works part time in New York..." Therefore, the showing of record is inadequate to establish that petitioner's medical condition was such that he could not attend to the payment of the maintenance fee when due and thus the cause of the unavoidable delay in the payment of the maintenance fee for the above-identified patent.

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

- (1) The delay in reply that originally resulted in expiration;
- (2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and
- (3) The delay in filing a *grantable* petition pursuant to § 1.378(b) to revive the application.²

Petitioner has not shown unavoidable delay with regards to periods (1) (2) or (3) and thus, failed to carry his burden of proof to establish to the satisfaction of the Director that the entire delay in payment of the maintenance fee for the above-identified patent was unavoidable with the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b)(3).

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, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b). In view thereof, this patent will not be reinstated.

As the decision mailed February 12, 2007 set a two month period for the filing of a request for reconsideration under 37 CFR 1.378(e), the maintenance fee and the surcharge submitted with the petition on July 5, 2006 were refunded to petitioner's representative's deposit account on September 24, 2007. As a supplement to the instant petition, petitioner has submitted fees in the amount of \$2345 to cover the first and second maintenance fee and the surcharge. Since this patent will not be reinstated, the maintenance fee and the surcharge submitted by petitioner will be refunded in due course.

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

²See Changes to Patent Practice and Procedure: Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

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