



Paper No. 14

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Patentee: Andrezej Bobel
Patent No. 5,801,492
Application No. 08/657,647
Filed: May 30, 1996
Issue Date: September 1, 1998
Title of Invention: Electronic Ballast For Gas
Discharge Lamp Having Primary and Auxilliary
Resonant Circuits

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ON PETITION

This is a decision on the petition under 37 CFR 1.378 (e) filed October 8, 2005, 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 petition under 37 CFR 1.378(e) is **DENIED**.¹

BACKGROUND

The patent issued September 1, 1998. The 3.5 year maintenance fee could have been paid from September 1, 2001 to March 1, 2002, or with a surcharge during the period from March 2, 2002 to September 1, 2002. Petitioner did not do so. Accordingly, the patent expired at midnight on September 1, 2002.

A petition to accept the delayed payment of the maintenance fee pursuant to 37 CFR 1.378(b) was filed on June 27, 2005 and dismissed on August 17, 2005.

The instant petition requests reconsideration of the decision of August 17, 2005.

STATUTE AND REGULATION

¹This 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

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...after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

A petition under 37 CFR 1.378(b) 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.² Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.³ To meet this standard, petitioner must establish that he or she treated the patent the same as a reasonably prudent person would treat his or her most important business. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."⁴ Finally, a petition to revive an application as

²Ray 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)).

³Ex 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).

⁴Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute unavoidable delay); Vincent v. Mossinghoff, 1985 U.S. Dist. Lexis 23119, 13 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs through their counsel's actions or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not

unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was unavoidable.⁵

The instant petition asserts that "human errors" caused a filing or docketing error, correspondence from the U.S. Patent and Trademark Office (USPTO) did not reach the patentee. It is noted the argument presented in this request for reconsideration varies from the argument presented in the Petition filed on June 27, 2005 which argued that patentee's legal representative failed to pay the maintenance fee.

The petition under 37 CFR 1.378(e) has been considered. However, the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b). A showing of unavoidable delay requires a showing that the **entire** delay in filing a grantable petition under 37 CFR 1.378(b) was unavoidable. In re Application of Takao, 17 USPQ2d 1155, 1158 (Comm'r Pat. 1990). For reasons below, the record fails to establish that the entire delay was unavoidable.

A. Petitioner has failed to establish that the delay in submitting the maintenance fee was due to docket or clerical error.

Petitioner states that an office clerk was responsible to file and care for all documents and patent files, as well as communicating all documents to the outside law firm for docketing and tracking the maintenance fee payments. Petitioner insists this process was working well because all other maintenance fees have been paid timely. The error was not detected.

The fact that a delay was caused by "human error" does not, *ipso facto*, establish unavoidable delay. For example, "human error" in the form of careless mistakes or the result of a lack of knowledge of USPTO practices and procedures would not establish unavoidable delay.⁶ As set forth in MPEP 711.03(c), a delay resulting from an error on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown :

A) the error was the cause of the delay;

B) there was in place a business routine for performing the clerical function which could reasonably be relied upon to avoid errors in its performance; and

apply to continuation applications).

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

⁶ See, e.g., Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

The record is not clear that the error was caused by a docket error. Petitioner has also previously argued that the error was caused by attorney error. Assuming the error was caused by docket error, petitioner has failed establish that there was a business routine for performing the clerical function which could reasonably be relied upon to avoid errors. Nor has petitioner provided evidence that this employee was sufficiently trained or experienced.

An adequate showing of unavoidable delay due to docket/clerical error may include but not limited to:

- 1) statements by all parties with direct knowledge of the circumstances surrounding the delay;*
- 2) a through explanation of the docketing system in use;*
- 3) identification of the types of records kept;*
- 4) identification of the persons responsible for the maintenance of the system, copies of mail ledger, docket sheets, file wrappers;*
- 6)an indication why the system failed; and*
- 5)information regarding the training provided to the clerk(s) responsible for the docketing error, the degree of supervision of their work.*

Petitioner has failed provide any evidence which would allow for a finding that the delay in submitting the maintenance fee was due to docket/ clerical error. The fact that petitioner has hired a new clerk with "[s]kills of detail work and responsibility to track all his issued patents..."⁷ implies that the previous clerk may have not received the proper training and supervision. As such reliance upon the clerk was not reasonable.

B. The delay was caused by failure to receive correspondence from the USPTO.

Petitioner states that correspondence from the USPTO was not received by patentee and the law firm. Petitioner acknowledges that he moved from the residential address which was the correspondence address of record. Petitioner states that he was under the impression that the correspondence address of record was that of the attorney Mattson because that was the address for his other patents.

Petitioner was under a duty to promptly notify the Office of any change of correspondence address or revocation of power of attorney. See MPEP 711.03 (c)(III)(c)(2).

It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely

⁷Renewed petition , page 2.

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. The fact that petitioner was not aware that the correspondence address of record was his outdated residential address and as such did not receive any mail which the Office may have mailed is not unavoidable. Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Petitioner had a responsibility to monitor the law firm's performance under an alleged contract or diligently inquire of the attorney or the USPTO into the status of the patent. No evidence has been provided that any inquiry was made as to the status of the patent. Failure to monitor the status of a patent, does not reflect the due care and diligence employed by a prudent and careful person with respect to their most important business and as such cannot demonstrate that the delay was unavoidable delay. The record lacks any showing that the attorney ever represented to petitioner that the maintenance fee had been paid, much less that petitioner ever paid the attorney for services rendered with respect to the maintenance fee payment. It is well established that a failure to communicate with between a client and an attorney is not unavoidable delay.⁸

C. Petitioner failed to exercise due diligence.

Petitioner states that as of June 2005 he has implemented a new tracking system and a new clerk with skills of detail work and responsibility to track his patents and patent applications. The remedial steps petitioner has taken to ensure such a delay does not occur again are commendable. Unfortunately, such steps do not aid in establishing the delay in submitting the maintenance fee for the above-identified patent was unavoidably delayed. The patent was abandoned for nearly three years before the first petition had been filed. Petitioner had a duty to exercise due diligence, and this duty was not discharged by the alleged negligence of a clerk or attorney. See *Douglas v. Manbeck*, 21 U.S.P.Q.2D (BNA) 1697 (E.D. Pa. 1991), *aff'd* 24 F.3d 1318, 24 USPQ2d 1318 (Fed. Cir. 1992) (applicant's lack of due diligence "overcame and superseded any negligence by the attorney. The delay was not unavoidable, because had the plaintiff exercised the due care of a reasonably prudent person, he would have been able to act to correct the situation in a timely fashion.").

⁸ *In re Kim*, 12 USPQ2d 1595 (Comm'r Pat. 1988)

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 fee and surcharge fee will be forwarded to petitioner.

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.

Telephone inquiries should be directed to Petitions Attorney Charlema R. Grant at (571) 272-3215.



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