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OFFICE OF PETITIONS

In re Patent No. 5,819,874 :
Issue Date: October 13, 1998 :
Application No. 08/863,224 : **DECISION ON PETITION**
Filed: May 27, 1997 :
Title: Foot Platform Device :
:

This is a decision on the "PETITION FOR RECONSIDERATION OF A DECISION REFUSING PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEES", filed October 4, 2005, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Procedural History:

- The above-identified patent issued on October 13, 1998.
- The first maintenance fee could have been timely paid during the period from October 13, 2001 through April 13, 2002, or

with a late payment surcharge during the period from April 14, 2002 through October 13, 2002.

- No maintenance fee was received, and as such, the patent expired on October 14, 2002.
- The 2 year time period for filing a petition under 37 C.F.R. § 1.378(c) expired on October 13, 2004.
- Patentee filed a petition to reinstate under 37 C.F.R. § 1.378(b) on May 4, 2005.
- The petition was dismissed in a decision mailed on August 18, 2005.

Evidence Presented on Petition:

A review of the petition and renewed petition reveals the following events giving arise to petitioner's assertion of unavoidable delay. Petitioner's house was burglarized on May 6, 2001. Among the items stolen was petitioner's computer. In addition, petitioner states that the thieves appeared to have gone through petitioner's file cabinets. Petitioner states that after the theft of his computer, his life went into a "tailspin".¹ Finally, at the end of January, 2005, petitioner remembered his Patent, and decided to take a look at it as he believed a maintenance fee was soon due. Petitioner searched his file cabinets for his folder with his patent information but could not find it. On February 20, 2005, petitioner retrieved information on his patent from the internet, and discovered it had expired.

Relevant Statutes, Rules and Regulations:

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 which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 C.F.R. § 1.378(b) provides that:

¹ Petitioner explains that from the middle of 2002 until January 2005 he was preoccupied with issues surrounding his father's health and as well as other matters.

Any 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(i)(1); and
- (3) 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:

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

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. It permits them in the exercise of this care to rely upon the 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, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (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 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay. See id.; 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).

On renewed petition, petitioner has demonstrated that he acted as a prudent and careful person in relation to his most important business by having a system in place to track and monitor the payment of the maintenance fee. However, a prudent and careful man, upon the destruction of that system (the theft of his computer), would have been diligent in reconstructing a tracking and monitoring system for maintenance fees. Petitioner's computer was stolen in May 6, 2001, five months before the one year maintenance fee payment window opened (October 13, 2001 - October 13, 2002). Petitioner has not shown why he was unavoidably prevented from calling the Patent and Trademark Office to inquire about the maintenance fee due date for his patent. In fact, the record does not show that petitioner took any activity or interest in this patent for an extended period of time.

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(c)(1) 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.

Since this patent will not be reinstated, the \$450 maintenance fee and the \$700 surcharge fee submitted by petitioner are being refunded under separate cover. The \$400 fee for requesting reconsideration is not refundable.

Telephone inquiries concerning this communication should be directed to Petitions Attorney Cliff Congo at (571)272-3207.



Charles Pearson
Director
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