



Paper No. 27

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OFFICE OF PETITIONS

Patentee: Bosque et al.	:	
Patent No. 5,830,135	:	
Application No. 08/220,544	:	
Filed: March 31, 1994	:	
Issue Date: November 3, 1998	:	ON PETITION
Title of Invention: Fuzzy Logic Alarm System for Pulse Oximeters	:	

This is a decision on the petition under 37 CFR 1.378 (e) filed May 19, 2006, 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 November 3, 1998. The 3.5 year maintenance fee could have been paid from November 3, 2001 to May 3, 2002, or with a surcharge during the period from May 4, 2002 to November 3, 2002. Petitioner did not do so. Accordingly, the patent expired at midnight on November 4, 2002.

A petition to accept the delayed payment of the maintenance fee pursuant to 37 CFR 1.378(b) was filed on February 28, 2006 and dismissed on March 20, 2006.

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

The instant petition requests reconsideration of the decision of March 20, 2006.

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...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

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)).

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 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 petitioner treated the payment of the maintenance fee as her most important business. Petitioner further contends the failure to receive forwarded mail prevented petitioner from paying the maintenance fees. The request for reconsideration contends the original petition was filed promptly and patentee was not motivated by the commercial value of the patent. The instant petition is accompanied by additional statements from Attorney Dergosits and Patentee.

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. THE PETITION FAILED TO ENUMERATE THE STEPS TAKEN TO ENSURE TIMELY PAYMENT OF THE MAINTENANCE FEE.

A review of the record shows that petitioner has failed to provide any evidence of the steps taken to make certain that the maintenance fee was timely submitted. Attorney Degrosits has only indicated upon receipt of the reminder notice, a letter was drafted reminding petitioner of

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 apply to continuation applications).

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

the requirement to pay the first maintenance fee.⁶ Five months after not receiving a reply from patentee, attorney Dergosits instructed his staff to remove subsequent dates and reminders from the firm's internal docket system.⁷ A grantable petition requires that petitioner make a showing that steps were in place for the timely submission of the maintenance fee payment. Sole reliance on reminder notices is not demonstrative of the steps required to establish unavoidable delay.⁸

B. THE DELAY WAS CAUSED IN PART DUE TO FAILURE TO COMMUNICATE WITH ATTORNEY OF RECORD.

A review of the evidence confirms that the Dergosits Firm was and continues to be the correspondence address of record. Any reminder notices and the notice of expiration were properly mailed to the correspondence address of record. The correspondence address of record was held by the Dergosits firm. The Dergosits firm was not aware that patentee⁹ moved. Further the attorney of record was not aware of how to contact anyone upon the receipt of the Notice of Expiration. Patentee waited over six years from the time she moved to Canada before she contacted attorney Dergosits. A party treating their patent as their most important business would ensure that they could be contacted and make sure that the Patent Office would have a current address where any notices that may have been mailed could have been received. It is well established that a failure in communication between a client and his or her attorney does not constitute unavoidable delay.¹⁰

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

⁶Petition February 23, 2006, para7.

⁷ Id, para 11

⁸ The mailing of maintenance fee reminders is completely discretionary and not a requirement imposed by Congress. See Rydeen v. Quigg, 748 F. Supp. 900, 907 (1990).

⁹ It is noted the petition and declarations provided focus solely on the actions of one of the patentees. A review of the record shows there are two additional patentees.

¹⁰ In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988)

seeks to reinstate the patent under 37 CFR 1.378(b). See MPEP 2590. A delay for failure to provide the Patent and Trademark Office with a current correspondence address does not constitute an unavoidable delay.¹¹ It follows that patentee's failure to receive a reminder notice from their legally chosen representative is not deemed to be unavoidable.

The fact that patentee cannot recall whether she notified her legal representative of her change of correspondence address does not reflect the actions of a person who is treating her patent as her most important business.¹² As such, petitioner is unable to overcome the burden to establish that she timely notified counsel of her change in address. It is well established that a failure to communicate between a client and an attorney is not unavoidable delay.¹³

C. THE DELAY WAS CAUSED IN PART BY FAILURE TO MONITOR ACTIONS OF ATTORNEY DERGOSITS.

Petitioner had a responsibility to monitor Attorney Dergosits and/or 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 until May of 2004, almost four years after the patent expired. 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. Patentee sent a letter to her legal representative May 6, 2004, yet apparently did not hear from counsel until she followed-up with a phone call until over a year later on September 28, 2005. A person treating their patent as their most important business would not have waited over a year to hear from counsel. It is further noted the record is devoid of any information as to why Attorney Dergosits failed to respond to Petitioner's 2004 letter.

D. DELAY WAS CAUSED IN PART BY PATENTEE EVALUATION OF THE VALUE OF THE PATENT.

Petitioner contends she was not motivated by the commercialization of the patented

¹¹ See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

¹² Reconsideration petition pgs 3-4, para 3.

¹³ In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988)

technologies.¹⁴ However, patentee's contention is not convincing. Even though the patentee states that she was made aware that maintenance fees were required to maintain a patent, the record shows petitioner did not inquire about the status of the patent until there was interest in the patent.¹⁵ Delaying the reinstatement of an expired patent, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *Maldague*, 10 USPQ2d at 1478.¹⁶

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.

¹⁴Second declaration of Elena Bosque, para. 10.

¹⁵ Petition February 23, 2006, paras. 15 and 16

¹⁶See MPEP 711.03(c) and MPEP 2590. As language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. See *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), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)).

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

A handwritten signature in black ink, appearing to read "Charles Pearson". The signature is written in a cursive style with a long horizontal flourish extending to the right.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy