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JAN 28 2008

**OFFICE OF PETITIONS**

In re Application of :  
Michael La Veau and Janet :  
Tlapek : RESPONSE TO REQUEST FOR  
Application No. 08/794,562 : RECONSIDERATION OF  
Patent No. 5,857,959 : FINAL AGENCY ACTION  
Filed: February 3, 1997 : PURSUANT TO  
Issue Date: January 12, 1999 : 37 C.F.R. § 1.378(E)  
Attorney Docket Number: 2089- :  
000004 :  
Title: CONCEPTION KIT :

This decision is in response to the submission of November 12, 2007, which is properly treated as a request for reconsideration of the denial of the renewed petition filed March 31, 2006, pursuant to 37 C.F.R. § 1.378(e), which refused to accept the delayed payment of a maintenance fee for the above-referenced patent. This submission is being treated as a petition pursuant to 37 C.F.R. § 1.183, requesting the waiver of Rule § 1.378(e).

The patent issued on January 12, 1999. The grace period for paying the 3½-year maintenance fee provided in 37 CFR § 1.362(e) expired at midnight on January 12, 2003, with no payment received. Accordingly, the patent expired on January 12, 2003 at midnight.

On December 19, 2005, Petitioner filed a petition pursuant to 37 C.F.R. § 1.378(b), which was dismissed via the mailing of a decision on February 3, 2006.

A renewed petition pursuant to 37 C.F.R. § 1.378(e) was received on March 31, 2006.

In a final agency action within the meaning of 35 U.S.C. § 704, mailed March 30, 2007, the petition under 37 C.F.R. § 1.378(e) and the included request to accept the delayed payment of the maintenance fee was denied.

It was concluded for reasons set forth in the decision that Applicant had failed to establish that the entire period of delay was unavoidable. Office records show that the payments of the maintenance fee and the associated surcharge have been refunded to Applicant.

With the present submission, Petitioner has submitted all fees, including the fee associated with the present petition, and has requested reconsideration of the agency's final decision of March 30, 2007. While Petitioner does not dispute the relevant facts on which the Office based its final decision, Petitioner urges that the Patentee "believes that all of the requirements (set forth in the decision on the original petition) were met (with the filing of the renewed petition) save for a formal declaration setting forth facts similar to those recited in the petition filed March 31, 2006<sup>1</sup>."

This assertion does not appear to be accurate. The decision on the original petition set forth a plurality of grounds that were not satisfied on renewed petition:

- The decision on the original petition indicated that Petitioner had not identified the error that was the cause of the delay at issue. This matter does not appear to have been addressed in either the renewed petition, or the present filing.
- The decision on the original petition indicated that Petitioner asserted that the failure to submit the maintenance fee in a timely manner was unavoidable, however Petitioner did not appear to be in a position to have firsthand knowledge of this assertion. Statements from an Officer of the Veos Corporation (or Mr. Hofer<sup>2</sup>) were not provided with the renewed petition.

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<sup>1</sup> Response to Final Agency Action, paragraph 16.

<sup>2</sup> A copy of an e-mail from Mr. Hofer was included, but no statement from the same was provided.

- The decision on the original petition indicated that Petitioner had not provided a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. This matter does not appear to have been addressed in either the renewed petition or the present filing: during the relevant time period, Mr. Hofer worked at three different law firms, and Petitioner has not shown that any of these firms had steps in place that could have been reasonably relied upon for ensuring that the maintenance fee was submitted in a timely manner.
- On the eleventh page of the decision on the original petition, it was indicated that the entire period of delay did not appear to be unavoidable - "even if it could be established that the delay was unavoidable for the period up until his discovery that the patent had expired, it is not clear what precluded the submission of the maintenance fee for another 5 months." With the renewed petition, Petitioner set forth that he was incapacitated, due to an injury, between the time of October 10, 2005 and November of 2006; however, it does not appear that he is a sole practitioner, and it has not been made clear why another member of his law firm could not have handled the matter during his period of incapacitation.

With this request for reconsideration, the fact remains that Petitioner does not appear to be able to:

- discern the cause of the error that was the cause of the delay at issue;
- provide a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent, or;
- establish that the entire period of delay was unavoidable.

Petitioner has blamed the failure to submit the maintenance fee on the actions/inactions of Mr. Hofer<sup>3</sup>, however Petitioner still has not provided the necessary showing to establish that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b). It is well settled that a patent holder's reliance upon an attorney does not provide an absolute defense, but rather shifts the focus to whether the attorney

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<sup>3</sup> Id. at paragraphs 5-9.

acted reasonably and prudently<sup>4</sup>. A patent holder is bound by any errors that may have been committed by his attorney<sup>5</sup>. The Office must rely on the actions or inactions of a duly authorized and voluntarily chosen representative of the applicant, and the applicant is bound by the consequences of those actions or inactions.<sup>6</sup> Specifically, Petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133<sup>7</sup>.

Ultimately, the actions of the attorney are imputed to the client, for when a Petitioner voluntarily chooses an attorney to represent him, the Petitioner cannot later distance himself from his attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney<sup>8</sup>."

Furthermore, courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions<sup>9</sup>."

Moreover, Link sets forth:

"[I]f an attorney's conduct falls substantially below what is reasonable under the circumstances, the client's remedy is against the attorney in a suit for malpractice. But keeping [a] suit alive merely because plaintiff should not be penalized for the omissions of his own attorney would be visiting the sins of plaintiff's lawyer upon the defendant<sup>10</sup>."

<sup>4</sup> California Medical Products v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

<sup>5</sup> Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Wabash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734 (1962)).

<sup>6</sup> Link v. Wabash, 370 U.S. 626, 633-634 (1962).

<sup>7</sup> Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; 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. 103, 131 (Comm'r Pat. 1891).

<sup>8</sup> Link at 633-634.

<sup>9</sup> Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983). See also, Wei v. State of Hawaii, 763 F.2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983).

<sup>10</sup> Link at 634. See also Mekdeci v. Merrell Nat'l. Laboratories, 711 F.2d 1510, 1522-23 (11th Cir. 1983) ("There is no constitutional or statutory right to effective assistance of counsel on a civil case." . . . [A] 'party' . . . does not have any right to a new trial in a civil suit because of

Finally, as was set forth on the tenth page of the decision on renewed petition, a docketing error cannot be considered to have been unavoidable when the error was made by an attorney: "Mr. Hofer's alleged failure to keep his docketing system up to date, or the alleged failure to include the present patent in the list of Veos patents cannot be characterized as 'unavoidable'."

As such, Petitioner's request for reconsideration of the final agency action which pursuant to 37 C.F.R. § 1.378(e), which refused to accept the delayed payment of a maintenance fee for the above-referenced patent is DENIED. Each of the fees, but for the fee associated with the filing of the present petition, will be refunded to Petitioner's Deposit Account in due course.

**There will be no further reconsideration of this matter by the Office.**

After the mailing of this decision, the application file will be forwarded to Files Repository.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225<sup>11</sup>.



Charles Pearson  
Director  
Office of Petitions

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inadequate counsel, but has as its remedy a suit against the attorney for malpractice.'" (quoting *Watson v. Moss*, 619 F.2d 775, 776 (8th Cir. 1980)) and *Kushner v. Winterthur Swiss Ins. Co.*, 620 F.2d 404, 408 (3rd Cir. 1980) ("An aggrieved party in a civil case, involving only private litigants unlike a defendant in a criminal case, does not have a constitutional right to the effective assistance of counsel. The remedy in a civil case, in which chosen counsel is negligent, is an action for malpractice.").

<sup>11</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.