



Paper No. 9

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**OFFICE OF PETITIONS**

In re Patent No. 5951364 :  
Issue Date: 09/14/1999 :  
Application Number: 09/067265 :  
Filing Date: 04/27/1998 : ON PETITION  
For: BRASSIERE :

This is a decision on the petition filed on February 27, 2008, which is treated as a petition under 37 CFR 1.378(e) requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b)<sup>1</sup> the delayed payment of a maintenance fee for the above-referenced patent.

The request to accept the delayed payment of the maintenance fee is **DENIED**.<sup>2</sup>

BACKGROUND

The patent issued on September 14, 1999. The first maintenance fee could have been paid during the period from September 16, 2002, through March 16, 2003, or, with a surcharge, during the period from March 17 through September 14, 2003. Accordingly,

<sup>1</sup> A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be 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.

<sup>2</sup> This 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 patent expired at midnight on September 14, 2003, for failure to timely pay the first maintenance fee.

On June 12, 2007, a petition under 37 CFR 1.378(b) was filed. On January 3, 2008, the petition was dismissed. On February 27, 2008, the present request under 37 CFR 1.378(e) was filed.

#### 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.

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 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

The Director may accept late payment of the maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) if the delay is shown to the satisfaction of the Director to have been "unavoidable."<sup>3</sup>

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.<sup>4</sup> Decisions reviving abandoned applications have adopted the reasonably prudent person standard in

<sup>3</sup>35 U.S.C. § 41(c)(1).

<sup>4</sup>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)).

determining if the delay was unavoidable.<sup>5</sup> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>6</sup> 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.<sup>7</sup>

Petitioner Rosie M. Brown asserts, in pertinent part

I was married and was living on two incomes. My spouse lost his job. For some time, this put stress on the relationship. This resulted in a separation and eventually divorce. So that left me with a daughter in college and a mortgage to pay. I also have an aging mom who was staying in a second piece of property that I was responsible for along with taxes. During the year of 2003, things were particularly challenging due to a work related injury I had. During this time, I only received only a percentage of my income. I almost lost both properties due to foreclosure...I have just begun to pay off some debts. I would like to try and work on my patent.

In support, petitioner Rosie M. Brown has provided a copy of the Petition for Dissolution of Marriage, and summons therefore, dated September 28, 1998, as well as copies of credit reports from 2003 and 2004, various documentation relating to the tax delinquencies, sale, and redemption of the real properties she owned, covering the period from 2002 through 2004, as well as various documentation of her work-related injury sustained on July 11, 2003.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

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<sup>5</sup> Ex 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).

<sup>6</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>7</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.<sup>8</sup> 35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing. Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.<sup>9</sup>

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.<sup>10</sup> That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.<sup>11</sup>

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.<sup>12</sup>

At the outset, the showing is not persuasive with regards to items (1) and (2). Petitioners have not provided any explanation as to how and when they learned that the subject patent had become expired. Additionally, although the subject patent

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<sup>8</sup> See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

<sup>9</sup> See 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); Ray v. Lehman, supra.

<sup>10</sup> Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

<sup>11</sup> Id.

<sup>12</sup> See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

expired on September 14, 2003, no petition was filed until over three and one-half (3 ½) years later, however, on June 12, 2007. Petitioners have offered no explanation as to this delay, save that petitioner Rosie M. Brown is now "trying to pay off debts," and, presumably, has recently decided to pursue reinstatement of the subject patent.

The showing of record is that rather than unavoidable delay, petitioners were preoccupied with other matters during the time the maintenance fees on the present patent were due. Petitioners' preoccupation with other matters which took precedence over timely payment of the maintenance fee in the present patent does not constitute unavoidable delay.<sup>13</sup>

Turning to petitioners' assertion of financial hardship, petitioners are reminded that a showing of unavoidable delay based upon financial condition must establish that the financial condition of the responsible party during the entire period of the delay was such as to excuse the delay.<sup>14</sup> A complete showing is required of petitioners', or the party responsible for payment of the maintenance fee's, financial condition including all income, expense, assets, credit, and obligations which made the delay from September 14, 2003, until the filing of a grantable petition must be filed.

The showing must also enumerate the date and the manner in which patentees became aware of the expiration of the patent, and the steps taken to file the petition promptly. Statements from all persons who contributed to the delay are also required, and must be verified by including a declaration according to 37 CFR 1.68. Furthermore, petitioners should identify the party responsible for making the payment.

In the decision mailed on January 3, 2008, petitioners were advised to include an exhaustive attempt to provide the information required, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The showing of record, however, includes no discussion of petitioners' income, expenses or assets. Rather, petitioner has simply provided credit reports dated December 10, 2003, and May 28, 2004, respectively, as well as real estate tax lien documents which cover a period up to 2004. Furthermore, the documentation

<sup>13</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>14</sup> See Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

provided is insufficient because it does not cover a period extending beyond mid-2004. Simply put, petitioners have shown neither that they lacked the funds to pay the maintenance fee at the time it was due, nor whether they had sufficient funds to more timely submit a petition to reinstate the patent in during the period from late 2004 through the filing of the initial petition on June 12, 2007.

In this regard, a showing of diligence in matters before the USPTO is essential to support a finding of unavoidable delay herein.<sup>15</sup> There is no "sliding scale" based upon the priority given to this maintaining this patent in force, or more diligently seeking reinstatement, *vis-a-vis* other matters by petitioner; the issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. The delay was not unavoidable, because had petitioner exercised the due care and diligence of a reasonably prudent person, petitioner would have been able to act to pay the fee or seek reinstatement in a timely fashion. The record fails to adequately evidence that petitioners exercised the due care and diligence observed by prudent and careful persons, in relation to their most important business, which is necessary to establish unavoidable delay.<sup>16</sup>

With regard to petitioner Rosie Brown's assertion that she was injured at work, and received only a portion of her salary, it is noted that the physician's letter submitted states that the injury occurred on July 11, 2003. This date is prior to the expiration of the patent. Petitioner has not provided a showing of when she resumed her regular work schedule and salary. As stated above, petitioners have not provided documentation showing her income or expenses, assets or liabilities from the time the maintenance fee was due until the filing of the original petition in July, 2007. In the absence of such a showing, a determination cannot be made that the delay was unavoidable.

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<sup>15</sup> See Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988) (applicant's diligent inquiry into the status of the application is required to show unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his counsel).

<sup>16</sup> Pratt, supra.

Further, with regard to period (2), petitioners have failed to provide an adequate explanation as to the delay in filing the present petition. As stated above, the showing of record is that rather than unavoidable delay, petitioners were preoccupied with other matters.

Lastly, it is noted that the showing and statement provided relate only to patentee Rosie M. Brown. Petitioners have not provided any showing of unavoidable delay with regard to patentee Tonya Brown, or explained whether she could have more timely paid the maintenance fee or filed a petition to reinstate the patent.

The Office is mindful of petitioners' predicament and is aware of the difficult circumstances petitioners have encountered. Nevertheless, the Office is unable to grant the requested relief because petitioners have not provided a showing that the delay was unavoidable.

In summary, the showing of record has been considered, but does not rise to the level of unavoidable delay. Rather, the showing of record is of a lack of diligence on the part of petitioners.

#### CONCLUSION

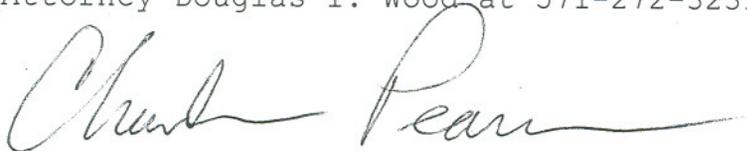
The prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

The petition under 37 CFR 1.378(e) is **DENIED**. As stated in 37 CFR 1.378(e), no further reconsideration or review of the decision refusing to accept the delayed payment of the maintenance fee under § 1.378(b) will be undertaken. This 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 1001.02.

Since this patent will not be reinstated, a refund check covering, the maintenance fee and surcharge fee, less the \$400.00 fee for the present request for reconsideration, has been scheduled.

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

Telephone inquiries should be directed to Senior Petitions  
Attorney Douglas I. Wood at 571-272-3231.

A handwritten signature in cursive script that reads "Charles A. Pearson". The signature is written in dark ink and is positioned above the typed name.

Charles A. Pearson  
Director, Office of Petitions