



Paper 12

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OFFICE OF PETITIONS

In re Patent No. 6,018,530 :
Issue Date: January 25, 2000 :
Application No. 08/874,303 :
Filed: June 19, 1997 :
Attorney Docket No: 059631-0019 :

ON PETITION

This is a decision on the Renewed Petition filed November 29, 2006, in response to a prior decision mailed September 29, 2006, refusing to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent. The response is treated as a petition under 37 CFR 1.378(e).

The petition under 37 CFR 1.378(e) is DENIED.¹

BACKGROUND

The patent issued on January 25, 2000. The first maintenance fee due could have been paid during the period from January 27, 2003 to July 27, 2003 or, with a surcharge during the period from July 28, 2003 to January 26, 2004. Accordingly, this patent expired on January 26, 2004 for failure to timely remit the first maintenance fee.

A petition under 37 CFR 1.378(b) to accept late payment of the maintenance fee was filed on May 18, 2006 in which petitioner asserted that a misunderstanding concerning who was responsible for paying the maintenance fees caused the maintenance fee not to be paid and further argues therefore that the delay on the part of the assignees to pay the maintenance fee when it was due was unavoidable.

The evidence provided included declarations from Sham Chakravorty, the inventor and assignor, and David Chew and Dan Daly, members of the Board of Directors of Signafor, Inc., the assignee. The declaration of Mr. Chakravorty indicates that he assumed but did not confirm that the assignee had paid the maintenance fee and further that he never

¹This 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.

received notifications from the PTO that the maintenance fee was due. The declarations of Mr. Chew and Mr. Daly indicate that they both made assumptions that the maintenance fee had been paid. However, the petition was dismissed in a decision mailed September 29, 2006 for failure to provide a sufficient showing that the delay in paying the maintenance fee was unavoidable. Neither Mr. Chakravorty, Mr. Chew nor Mr. Daly, in their declarations, provided any evidence of who the responsible party was, why any of them assumed the maintenance fee had been paid and none provided evidence that a system for paying maintenance fees had been established which would have led them to conclude that the maintenance fee had been paid.

The decision dismissing the petition suggested that a showing of unavoidable delay would include a statement from the principals responsible for payment of the maintenance fee as to what steps were in place for ensuring timely payment of the maintenance fee and why action was not taken to timely submit the required maintenance fee while the patent was under the control of the parties charged with the responsibility of payment of the maintenance fee.

The instant petition under 37 CFR 1.378(e) purports to provide additional explanations as to why petitioners believe the payment of the first maintenance fee was delayed and why that delay was unavoidable.

STATUTE AND REGULATION

35 USC 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. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 USC 41(c)(1). Acceptance of a late maintenance fee on the basis of unavoidable delay is considered under the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay. 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)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912)("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"); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 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 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. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner's request for reconsideration supplements the declarations of David Chew and Dan Daly. Mr. Chew and Mr. Daly add that they were both unaware that a maintenance fee was required for the enforceability of a Patent and didn't learn of such until January 25, 2006.

The petition filed May 18, 2006 was dismissed because the only evidence provided to show unavoidable delay was declarations that had one declarant claiming that he never received a Maintenance Fee Reminder and the other two declarants disclaiming responsibility for payment of the maintenance fee. The additional evidence provided with the instant renewed petition introduces new arguments that the declarants were not even aware that maintenance fees were required. The showing of record therefore has been considered, and no evidence has still been provided to support a finding of unavoidable delay. Petitioner has not carried the burden of proof to establish to the satisfaction of the Director that the delay was unavoidable.

Petitioner asserts that the mail may have been misdelivered to another address. While such a suggestion is mere speculation, even if the maintenance fee reminder was misrouted, the failure to receive such a notice would not amount to unavoidable delay since the USPTO has no obligation to send such reminders.

The fact that Mr. Chakravorty didn't receive a maintenance fee reminder and the fact that Messers Chew and Daly were not aware that maintenance fees were required is equivalent to a lack of knowledge of the need to pay a maintenance fee, neither of which rises to the

level of unavoidable delay.² Under the statutes and regulations, the U.S. Patent and Trademark Office (USPTO) has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. It is solely the responsibility of the patentee to assure that the maintenance fee is paid timely to prevent expiration of the patent. Under the statutes and regulations, the lack of knowledge of the requirement to pay the maintenance is not unavoidable. The requirement to pay maintenance fees is printed on the face of the patent and even in the absence of being told or even reminded of the need to pay the maintenance fees to maintain the patent in full force and effect, if the principals of the assignee had read the patent, they would have known of the maintenance fee requirements.

The failure to receive a reminder notice and the lack of knowledge of the requirement to pay the maintenance fee will not shift the burden of monitoring the time for payment a maintenance fee from the patentee to the USPTO.

There is a distinct difference between an unavoidable delay which, had there been reasonable care exercised, could not have been prevented and one that was the result of a mistake or negligence. In view of the above and since petitioner has not provided enough information to determine that reasonable care was in fact exercised to ensure that the maintenance fee would be paid timely and that therein the delay was unavoidable, the arguments fail.

The fact remains that neither the patentee and assignor nor the assignee was diligent about the matters related to the instant patent and thus the patent expired. On the other hand, had the principals been diligent about the matters related to the instant patent, specifically the payment of the maintenance fee, expiration of the patent would have been avoided.

Finally, 37 CFR 1.378(b)(3) requires that "[t]he showing must enumerate the steps in place to ensure timely payment of the maintenance fee." In the present case, the patentee was apparently unaware that maintenance fees were due, and has not enumerated any steps that were in place, much less any steps that would have ensured payment of the maintenance fee.

CONCLUSION

The prior decision which refused to accept under § 1.378(b) the delayed payment of a

²See In Re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990); aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 60 U.S.L.W. 3520 (January 27, 1992). See also "Final Rules for Patent Maintenance Fees," 49 Fed. Reg. 34716, 34722-23 (Aug. 31, 1984).

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 USC 41(c)(1) and 37 CFR 1.378(b). In view thereof, this patent will not be reinstated.

The maintenance fee and the surcharge submitted with the petition on May 18, 2006 was refunded on July 27, 2007.

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

Finally, as was indicated in the decision mailed September 29, 2006, there is no indication that petitioner herein was ever empowered to handle matters related to this patent. If petitioner desires to receive future correspondence regarding this patent, the appropriate power of attorney documentation must be submitted. If the new power of attorney and/or change of address is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b). This decision will be mailed to petitioner, however, all future correspondence will be mailed solely to the correspondence address of record.

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

A handwritten signature in cursive script, appearing to read "Charles Pearson", followed by a long horizontal line extending to the right.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner