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MAILED

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OFFICE OF PETITIONS

In re Patent No. 6,109,265	:	
Issue Date: August 29, 2000	:	
Application No. 08/958,550	:	
Filed: October 29, 1997	:	ON PETITION
Title. Elastic Mandibular	:	
Advancement Appliance	:	

This is a decision on the petition under 37 CFR 1.378(e), filed November 24, 2008.

The petition is DENIED<sup>1</sup>. No further consideration of this matter will be undertaken by the Office.

BACKGROUND

The patent issued August 29, 2000. The 3.5 year (first) maintenance fee could have been paid from August 29, 2003 through February 27, 2004 or with a surcharge during the period from February 28, 2004 through August 28, 2004. Accordingly, the patent expired at midnight August 28, 2004, for failure to timely submit the 3.5 year maintenance fee.

A petition under 37 C.F.R. § 1.378(b) to accept late payment of the maintenance fee was filed August 15, 2008. A decision dismissing the petition under 37 CFR 1.378(b) was mailed September 22, 2008 and is hereby incorporated by reference.

On renewed petition, petitioner states that attorney Marvin B. Eichenroht of Browning Bushman paid the maintenance fees for the portfolio owned by patentees Don Frantz and Michael Frantz. On or about March 2003, prior to attorney Eichenroht's retirement, Dr. Don Frantz told attorney Eichenroht to forward the files of the portfolio including patent 6,109,265 to Craig Bohn of the Keeling and Hudson law firm. The Keeling and Hudson received the portfolio files from Browning Bushman after attorney Bohn left

<sup>1</sup> This 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.

to start the Law Office of Craig Bohn in Montana. Browning and Bushman claimed to divest all responsibility of the Frantz portfolio to attorney Bohn. Petitioner maintains no letter requesting divestiture of the responsibility was received or acknowledged by any party. Attorney Bohn received the Frantz portfolio in April 2003. Petitioner maintains that Dr. Frantz reasonably relied on the transfer of files to attorney Bohn's Office in 2003 and reasonably understood the maintenance fees for all patents were being properly managed.

Attorney Bohn states that he received the Frantz portfolio on or about March/April 2003. The docketing system used by attorney Bohn was Abacas law. The '265 patent was entered into the docketing system on September 5, 2006. Upon entry of a patent into the docketing system, the system always prompts the user to accept or reject creation of standard reminders, which includes maintenance fee reminders. Attorney Bohn states "for an unknown reason, which can only be attributed to a breakdown in the docket input and management system" reminders were generate for the other Frantz patents but not for the instant patent. (Exhibit 4). The petition indicates, when attorney Bohn informed Dr. Frantz of maintenance fee due dates, Dr. Frantz authorized payment of the maintenance fees even where there were no licensing opportunities. Petitioner insists that the evidence shows that Dr. Frantz retained the services of attorneys and that due diligence was taken to preserve his patents. Further petitioner contends that reminders were not generated due to a computer malfunction.

Lastly, petitioner argues there were unavoidable family needs during the time period of the transfer of responsibilities to attorney Bohn.

#### STATUTES 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...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(i)(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

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."<sup>2</sup> Moreover, 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>3</sup>. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable<sup>4</sup>. Further, decisions on revival are made on a "case-by-case basis, taking all the fact and circumstances into account<sup>5</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>6</sup>.

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<sup>2</sup> 35 U.S.C. 41(c)(1).

<sup>3</sup> See, Ray v. Lehman, 55 F3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

<sup>4</sup> See, 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 men in relation to their most important business"; In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912), Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>5</sup> See, Smith v. Mossinghoff, 671 F.2d 533, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>6</sup> See, Haines v. Quigg, 673 F.Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987); 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 (Comm'r Pat. 1891).

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due. In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787.

The facts presented shows that the Frantz portfolio was in the possession of attorney Bohn on or before April 2003 before the window for payment of the first maintenance fee was open. This fact in conjunction with the letter to Browning and Bushman from attorney Bohn dated April 9, 2003, which Bohn acknowledges that his services have been retained to manage the intellectual property of patentees establishes that attorney Bohn was responsible for the payment of the maintenance fees. The record does not show that Browning Bushman retained any responsibilities for the Frantz portfolio. Accordingly, the actions and inactions of attorney Bohn and patentees Don Frantz and Michael Frantz are those, which will be reviewed.

The record shows that petitioner was aware of the need to pay maintenance fees. However, petitioner has failed to demonstrate that a reliable docketing system was implemented. Petitioner states that the Abacas Law docketing system was utilized to track maintenance fee due dates. Petitioner has provided snapshots of the docketing screens for the patents. Although the files for the patent portfolio were received by attorney Bohn on or about March or April 2003 the above-identified patent was not entered into the docketing system until September 5, 2006 over three years after receipt into attorney Bohn's Office. It should further be noted that the entry date of the patent into the docketing system was well after the patent expired on August 29, 2004. Thus, to the extent the docketing system could be deemed as reliable, the fact that the patent was not entered until after the patent expired shows the system was not used to track the first maintenance fee due date for the above-identified patent. Nor can the Office rely on claims of malfunction of the docketing system where petitioner is unable to identify the breakdown. To the extent the breakdown was due to docket input, petitioner has failed to indicate who was responsible for the docket input or management of the docketing system. Thus, the Office is unable to state that the patent was entered into a

reliable docketing system. Entry into the docketing after expiration is not reliable.

The delay or mistake of petitioner's voluntarily chosen counsel is not unavoidable. The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions.<sup>8</sup> Petitioner had a responsibility to monitor 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. 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. The record lacks any showing that attorney Bohn ever represented to petitioner that the maintenance fee had been paid, much less that petitioner ever paid the attorney for services rendered with respect to the maintenance fee payment. A delay resulting from an attorney's preoccupation with other legal matters or with the attorney's inadvertence or mistake is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 USC 151 and 37 CFR 1.137(a). Mossinghoff, 671 F.2d at 536. Case law is clear that the mistakes of an attorney do not rise to the level of unavoidable delay and that the actions of a patentee's representative are imputed onto patentee.<sup>9</sup>

It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. The Office looks to the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant/patentee and their successors, and the applicant/patentee and their successors are bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). A petitioner who is treating his patent as his most important business would have attempted to contact attorney Bohn to ensure that appropriate action had been taken

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<sup>8</sup> Link v. Wabash, 370 U.S. 626, 633-34 (1962).

<sup>9</sup> See. California v. Medical Products, Inc. v. Tecnol Medical Products, Inc, 921 F. Supp 1219 and Haines v. Quigg 673 F. Supp 314,

on petitioner's behalf. If it was determined Bohn had not handled the application as petitioner desired, it is then petitioner's responsibility to either timely seek other counsel or submit the maintenance fee on petitioner's own behalf.

Petitioner also contends that diligence was used to maintain the patent taking into consideration the illness and death of Dr. Frantz' daughter. In support, the petition is accompanied by a schedule of various procedures and time spent with Dr. Frantz's daughter and grandchildren. While the Office is sympathetic to Dr. Frantz' loss, the petition fails to state why patentee Michael Frantz was unable to monitor the actions of attorney Bohn. Further, the actions of attorney Bohn are imputed on the patentees.

In view of the totality of the evidence of record, including the exhibits submitted herewith, it cannot be found that the entire time, from the time that the maintenance fee was due until the filing of the instant petition, was unavoidable.

#### DECISION

The prior decision dismissing petition under 37 CFR 1.378(b) to accept the delayed payment of maintenance fee has been reconsidered. For the reasons set forth herein the delay in payment of the maintenance fee cannot be regarded as unavoidable within the meaning of 35 USC 41 and 37 CFR 1.378(b). Accordingly, the offer to pay the delayed maintenance fee will not be accepted and this patent will not be reinstated.

Since this patent will not be reinstated, a refund covering the maintenance fee (3.5 year) and surcharge fee will be forwarded to petitioner.

This file is being forwarded to files repository.

Telephone inquiries concerning this matter may be directed to the Petitions Attorney Charlema Grant at 571-272-3215.



Charles Pearson  
Director  
Office of Petitions