UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

SEP 01 2009

OFFICE OF PETITIONS

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION
SEARS TOWER
CHICAGO, IL 60606-1080

Paper No. 12

In re Patent No. 6,785,519	:	
Issue Date: August 31, 2004	:	
Application No. 10/034,407	:	ON PETITION
Filed: December 27, 2001	:	
Inventor: Junichi TOYODA et al.	:	
Attorney Docket No. 09792909-5280		

This is a decision on the renewed petition, filed April 14, 2009, under 37 CFR 1.378(e) requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(c) the unintentionally delayed payment of a maintenance fee and reinstate the above-identified patent.

The petition to accept the delayed payment of the maintenance fee and reinstate the above-identified patent is **DENIED**.

BACKGROUND

The patent issued August 31, 2004. The first maintenance fee due could have been paid during the period from August 31, 2007, through March 3, 2008, or with a surcharge during the period from March 4, 2008, through August 31, 2008. The patent expired at midnight August 31, 2008. Therefore, since this petition was filed within twenty-four months after the six-month grace period, this petition was timely filed under the provisions of 37 CFR 1.378(c).

A petition under 37 CFR 1.378(c) was filed December 8, 2008 and was dismissed in the decision of March 9, 2009. The instant petition under 37 CFR 1.378(e) was filed April 14, 2009 and includes a series of statements claiming that although the Sony Corporation on December 1, 2005 informed its U.S. Patent counsel, David R. Metzger (Metzger) and SONNENSCHEIN NATH & ROSENTHAL LLP to not maintain the above-identified patent, that by August 31, 2008 Chisato Numaoka, (Numaoka) of the Sony Corporation

determined that the above-identified patent should be maintained. Further, once Numaoka determined the patent should be maintained, the funding for payment of the maintenance fee was not communicated to Sony's United States patent counsel, Metzger until November 4, 2008.

Further, the renewed petition claims that the situation in the above-identified patent "is similar to or the same as" that involving U.S Patent No. 6,066,511 which resulted in a granting of the petition to reinstate.

STATUTE AND REGULATION

35 USC 41(c)(1) provides that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 CFR 1.378(a) provides that:

The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

37 CFR 1.378(c) provides that:

Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:
(1) The required maintenance fee set forth in § 1.20 (e) through (g);
(2) The surcharge set forth in § 1.20(i)(2); and
(3) A statement that the delay in payment of the maintenance fee was unintentional.

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to been "unintentional"; see 35 USC 41(c)(1) and its promulgating regulation 37 CFR 1.378(a). That is, the plain language of the statute permits reinstatement of an expired patent, provided the delay in payment of the maintenance fee was "unintentional." See Centigram Communication Corp. v. Lehman, 862 F. Supp. 113, 118, 32 USPQ2d 1346, 1350 (E.D. Va. 1994), *appeal dismissed,* 47 F. 3d 1180 (Fed. Cir. 1995). Nevertheless, the congressional intent is that USPTO acceptance of a delayed maintenance fee is discretionary, and contingent upon a showing satisfactory to the Director, that the delay was "unintentional." Id. at 116, 32 USPQ2d at 1348.

The showing of record is that, when the maintenance fee was due there was no compelling reason to continue this patent in force. Petitioner asserts that a decision was made, on August 31, 2008, prior to the ministerial act of obtaining funding to maintain the patent. Despite petitioner's contention to the contrary it is not the decision of August 31, 2008 that must be relied upon to determine whether or not the patent expired unintentionally, rather, it is the decision on December 1, 2005 to not maintain the patent which caused expiration of the patent. This intentional act cannot be overcome by the decision by the party responsible for paying the fee due to now pay the fee and keep the patent in force which occurred on or about November 4, 2008, which is a decision after the expiration of the patent, to pay the maintenance fee due.

The discovery of additional information after making a deliberate decision to withhold a timely action is not the "mistake in fact" that might form the basis for acceptance of a maintenance fee pursuant to 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c), under the reasoning of Maldague. The discovery of additional, other information is simply a change in circumstances that occurred subsequent to the expiration of the patent. That such other additional information was discovered subsequent to the expiration of this patent does not cause the delay resulting from the previous deliberate decision to become" unintentional" Id.

As for petitioner's contention that a standard was applied incorrectly in the above-identified patent, but correctly in U.S. Patent 6,066,511 see In re Boulevard Entertainment Inc., 334 F3d 1336, 1342 (Fed. Cir. 2003)(Merely, because a standard was applied incorrectly in a particular case does not make it the new standard); Butz v. Glover Livestock Commission Co., 411 U.S. 182,185, 93 S.Ct. 1455, 1457 (1973) (Mere unevenness in the application of the sanction does not render its application in a particular case unwarranted in law); Cox v. USDA, 925 F.2d 1102, 1107 (8th Cir. 1991) (A sanction not invalid because it is more severe than that imposed in other cases); Lawrence v. CFTC, 759 F.2d 767, 776 (9th Cir. 1985); Villela v. Air Force, 727 F.2d

1574, 1577 (Fed. Cir. 1984); Sartain v. SEC, 601 F.2d 1366, 1374-1375 (9th Cir. 1979) (Absent discriminations based on invidious classifications or in retaliation for an assertion of rights, difference sanctions for similarly situated violators will be upheld).

The Director may accept the payment of any maintenance fee required by 35 USC 41(b) which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional. See 35 USC 41(c)(1).

The "unavoidable" standard in 35 USC 41(c)(1) is identical to the "unavoidable" standard in 35 USC 133 for reviving an abandoned application because 35 USC 41(c)(1) uses the same language (*i.e.,* "unavoidable" delay). See Ray v. Lehman, 55 F. 3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(citing In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd*, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990)). Likewise, the "unintentional" standard in 35 USC 41(c)(1) is the same as the "unintentionally" standard in word ("unintentional"), albeit in a variant (*i.e.,* the adjective "unintentional" rather than the adverb "unintentionally"). With regard to the "unintentional" delay standard:

Where the applicant deliberately permits an application to become abandoned (*e.g.,* due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

See Changes to Patent Practice and Procedure; Final Rule Notice, 61 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(discussing the meaning of "unintentional" delay in the context of the revival of an abandoned application).

35 USC 41(c)(1) authorizes the Director to accept a delayed maintenance fee payment "if the delay is shown to the satisfaction of the Director to have been "unintentional." 35 USC 41(c)(1) does not require an affirmative finding that the delay was intentional, but only an explanation as to why the petitioner has failed to carry his or her burden to

establish that the delay was unintentional. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 USC 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); see also In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989)(petition under 37 CFR 1.137(b) denied because the applicant failed to carry the burden of proof to establish that the delay was unintentional).

Petitioner has failed to carry its burden of proof to establish to the satisfaction of the Director that the delay in payment of the maintenance fee for the above-identified patent was unintentional within the meaning of 35 USC 41(c) and 37 CFR 1.378(c).

Petitioner seeks to avoid the consequences of the deliberate decision of Sony Corporation by contending that it was the "unintentional mistake of Sony Corporation" in failing to alert Metzger concerning the instant patent. Manifestly, this argument must fall of its own weight, as Sony Corporation on December 1, 2005, not Numaoka or Metzger, made the deliberate decision not pay the maintenance fee. That is, Sony Corporation, not Numaoka or Metzger, was the responsible party. Moreover, to the extent that Sony Corporation may have erred, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the patent holder, and petitioner is bound by those actions or inactions. See California Medical Products v. Technol. Med. Prod., 921 F. Supp. 1219, 1259 (D.Del. 1995); Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 976 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

Additionally, there is no evidence of record that Sony Corporation misstated any material fact to anyone concerning the non-payment of the maintenance fee. The record supports a finding that Sony Corporation exercised its business judgement in regard to whether the maintenance fee for the instant patent should be paid or not paid. Therefore, Sony Corporation's decision in exercising its business judgment on whether or not to pay the maintenance fee are binding on the patent holder. See Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963).

35 USC 41(c)(1) authorizes the Director to accept the delayed payment of a maintenance fee under 35 USC 41(b) if, *inter alia,* "the delay is shown to the satisfaction of the Director to have been unintentional." In this case, petitioner has failed to carry its burden to establish that the delay in paying the maintenance fee payment for the above-identified patent was unintentional on the part of Sony Corporation. Obviously, a delay resulting from a deliberate decision by the relevant party (Sony Corporation) not to pay a maintenance fee cannot reasonably be characterized as an "unintentional" delay within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(c). Moreover, no reason has been

given or is apparent as to why Sony Corporation's decision and subsequent action (or inaction) should not be binding on petitioner.

CONCLUSION

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

Since the above-identified patent will not be reinstated, the $980 maintenance fee and the $1640 surcharge submitted by petitioner have been refunded to counsel's deposit account No. 19-3140. The $400 fee for requesting reconsideration has been charged to the same account.

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

This patent file is being forwarded to the Files Repository.

Telephone inquiries regarding this decision should be directed to Petitions Examiner Joan Olszewski at (571) 272-7751.

Charles Pearson
Director, Office of Petitions