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Patent and Trademark Office  
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Paper No. 12

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In re Patent No. 4,386,584  
Issue Date: June 7, 1983  
Application No. 06,411,891  
Filed: August 26, 1982  
Inventor: Noel C. Calkins

DECISION ON PETITION

This is a decision on the petition for reconsideration filed under 37 CFR 1.378(e) via facsimile transmission on December 31, 1998. The petition seeks reconsideration of a prior decision which refused to accept the delayed payment of a maintenance fee for the above-identified patent.

The request to accept the delayed payment of the maintenance fee is **denied**.

#### BACKGROUND

The patent issued June 7, 1983. Accordingly, the third maintenance fee could have been paid during the period from June 7, 1994 (a Tuesday) through December 7, 1994 (a Wednesday) or with a surcharge during the period from December 8, 1994 (a Thursday) through June 7, 1995 (a Wednesday). Since no maintenance fee was forthcoming during these periods, this patent expired pursuant to 37 CFR 1.362(g) at midnight on June 7, 1995 for failure to timely pay the maintenance fee.

The first petition to accept the late payment of the third maintenance fee was filed on June 22, 1998 under the unavoidable provisions of 37 CFR 1.378(b) or alternatively under the unintentional provisions of 37 CFR 1.378(c). In this petition, petitioner Noel C. Calkins, contended that the first two maintenance fees were sent to the Patent and Trademark Office (Office) prior to the due dates but that "these payments were not recorded as received until after the due date." Petitioner added that "the second fee was accepted by the Office around July 1991" and that at this time "[t]he Maintenance Fee Department did not take the information (petitioner does not specify what this information entails) and put the patent back on a maintenance schedule." *Attachment to Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent under 37 CFR*

1.378(b) (June 22, 1998). With this statement, petitioner intimated that it was due to this unidentified failure by the Maintenance Fee Department that a timely Maintenance Fee Reminder was not sent out by the Office for the third maintenance fee. Petitioner added that the following address was maintained in order to ensure that patent correspondence would not be a problem: P.O. Box 416, Los Alamos, NM 87544. Lastly, petitioner stated that during 1996 and 1997 he was being treated for cancer and was in treatment in California for several months. Petitioner explained that during this time several people were handling his mail and that as of the filing date of this first petition, no Maintenance Fee Reminder was found amongst his mail. *Id.*

This first petition was dismissed both under 37 CFR 1.378(b) and 37 CFR 1.378(c) in a decision mailed November 2, 1998. In this decision, the Office informed petitioner that the showing presented was insufficient to establish unavoidable delay or unintentional delay under 37 CFR 1.378(b) or (c), respectively. The Office also explained to petitioner that a third Maintenance Fee Reminder was never sent out for this patent and that the Office has no duty to mail Maintenance Fee Reminders. Petitioner was informed that the duty to pay maintenance fees rests solely with the patentee and that a reasonably prudent patentee must implement procedures to ensure the timely payment of the maintenance fees. *Decision on Petition, page 2 (November 2, 1998).*

Based upon these well established principles of law and policy with respect to the payment of maintenance fees, petitioner was directed to provide the Office with information as to whether or not petitioner was aware of the need to pay the third maintenance fee and if so, whether or not any steps were taken to ensure the timely payment of the maintenance fee. In the decision, petitioner was instructed that all causes which contributed to the failure to timely pay the maintenance fee must be presented and supported with appropriate evidence. *Id. at 3.*

As a closing note in the November 2, 1998 Decision on Petition, the Office explained to petitioner that the unfortunate circumstances of Mr. Calkins' cancer treatment were not relevant to the delayed payment of the third maintenance fee. Specifically, because unavoidable delay under 37 CFR 1.378(b) must encompass the **entire** period during which the maintenance fee could have been paid, unaccounted periods of time have a deleterious impact upon the requisite showing. Accordingly, petitioner's medical treatments, which took place in 1996 and 1997, have no bearing on the delay in payment of the maintenance fee during all of 1995, a period of time which must be accounted for under the highly stringent provisions of 37 CFR 1.378(b).

With respect to the petition for the unintentionally delayed payment of the maintenance fee under 37 CFR 1.378(c), the Office explained to petitioner that the petition filed under this provision on June 22, 1998 was not timely and therefore moot. *Id. at 3.* Specifically, to have been timely, the petition under the unintentional provisions of 37 CFR 1.378(c) must

have been filed within 24 months after the expiration of the six month grace period for the third maintenance fee or by June 7, 1997. 35 USC 41(c). Accordingly, the June 22, 1998 filing date for the petition under 35 CFR 1.378(c) was too late and consequently petitioner was informed that the only available remedy for reinstatement of this application is a reconsideration under the unavoidable provisions of 37 CFR 1.378(b). 37 CFR 1.378(e).

In accordance with the provisions of 37 CFR 1.378(e), the November 2, 1998 Decision on Petition provided instructions on the procedures necessary for a timely petition for reconsideration on the front page of the decision:

**"If a reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b)...The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted above, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner." *Id. at 1* [emphasis added].**

The instant petition for reconsideration under the unavoidable provisions of 37 CFR 1.378(b) was timely filed via facsimile transmission on December 31, 1998 and signed by Dale Thomson. Mr. Thompson, who is not a practitioner registered to practice before the Patent and Trademark Office, does not provide any evidence of his interest in the subject patent. Despite this procedural defect, the Office is considering Mr. Thompson's petition, however, any further communication must include a showing of interest by Mr. Thompson.

The showing which Mr. Thompson presents with the petition for reconsideration consists of copies of the first and second Maintenance Fee Reminders and copies of the checks used to pay the first and second maintenance fees. In addition to these copies, Mr. Thompson includes a copy of a facsimile transmission cover sheet from himself to Stephanie Graham, an employee of the Office, dated April 10, 1998, which does not explain very much other than the fact that Mr. Thompson had maintained the address at P.O. Box 416, Los Alamos, NM 87544 for purposes of patent correspondence.<sup>1</sup> In addition to the foregoing, Mr. Thompson provides the following statement in the petition for reconsideration:

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<sup>1</sup> It is important to note that Mr. Thompson states the following in this facsimile transmission: "I have maintained P.O. Box 416, Los Alamos, NM. 87544 because I thought all patent correspondence would go there." Because Mr. Thompson has demonstrated no interest in the subject patent, this statement is meaningless with respect to this patent; only Mr. Calkins and his registered attorney and/or agent have the right to change or maintain any correspondence address for this patent.

"Enclosed are documents that were sent to Stephanie Graham (Patent Office 703-308-5068) so she could correct the error made by the Patent and Trademark Office in 1991.<sup>2</sup> This error was corrected by the Patent and Trademark Office in 1998.

This error kept Mr. Calkins from receiving normal Patent Office correspondence which could have prevented problems with the third maintenance fee. Time consideration by the Patent Office should start with this date of correction."

A review of the records for this application file indicate that the first Maintenance Fee Reminder was mailed on January 9, 1987 to the following address: Noel C. Calkins, 352 Boyce (or Box 416), Los Alamos, NM 87544.<sup>3</sup> This first Maintenance Fee Reminder was received by Mr. Calkins and returned to the Office on January 27, 1987 after the termination of the six month "window period" and twenty days into the six month "grace period"<sup>4</sup> with an indication to change the correspondence address to: O.D. Thompson, Box 190, Los Alamos, NM 87544. The first maintenance fee was paid with a negotiable instrument dated on or about March 27, 1987, two and one half months before the termination of the six month "grace period" which ended at midnight on June 7, 1987. Accordingly, this maintenance fee was paid after the 3.5 year due date for the first maintenance fee and therefore subject to the "grace period" surcharge. The second

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<sup>2</sup> Mr. Thompson does not specify what the "error" is, however, it can be inferred from a reading of the petition and a review of the official record for this patent that the alleged Office error has something to do with a change of correspondence address for this patent which Mr. Calkins attempted to enter at the time the first maintenance fee was paid. See *Maintenance Fee Reminder (January 27, 1987)*.

<sup>3</sup> The address on the Maintenance Fee Reminder was written as noted above including the parenthetical P.O. Box 416.

<sup>4</sup> Once a utility patent issues, a patentee is required to pay a maintenance fee at 3.5, 7.5, and 11.5 years after the patent issues in order to maintain exclusive rights to the patent. These time periods are considered the due dates for the maintenance fees. 37 CFR 1.362(d) and (e) explains the "window" and "grace" periods for payment of the maintenance fees as follows:

Pursuant to 37 CFR 1.362(d), there exists a six month period prior to the due dates where the maintenance fee can be paid without a surcharge; this six month period is referred to as the "window period." In the instant case, the window period for the first maintenance fee was June 7, 1986 through December 7, 1986; for the second maintenance fee it was June 7, 1990 through December 7, 1990; and for the third maintenance fee it was June 7, 1994 through December 7, 1994.

Pursuant to 37 CFR 1.362(e), there exists a six month period subsequent to the due dates where the maintenance fee can be paid with a surcharge; this six month period is referred to as the "grace period." In the instant case, the grace period for the first maintenance fee was December 8, 1986 through June 7, 1987; for the second maintenance fee it was December 8, 1990 through June 7, 1991; and for the third maintenance fee it was December 8, 1994 through June 7, 1995 .

Maintenance Fee Reminder was mailed to Mr. Calkins on January 9, 1991 at the following address: Calkins R & D, Inc., Box 416, Los Alamos, NM 87544. Indeed, petitioner received this Maintenance Fee Reminder and paid the second maintenance fee with a negotiable instrument dated or about June 4, 1991, two days before the termination date of the six month "grace period" which ended at midnight on June 7, 1991. Accordingly, this maintenance fee was paid after the 7.5 year due date for the second maintenance fee and therefore subject to the "grace period" surcharge. There is no indication in the official records for this file that a third Maintenance Fee Reminder was mailed at any time for this patent.

### STATUTE AND REGULATIONS

#### Practice Before the Patent and Trademark Office

35 USC 31 provides as follows:

The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons, valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

The statute's promulgating rule, 37 CFR 1.31, provides as follows:

An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the Patent and Trademark Office in patent cases.

The statute's promulgating rule, 37 CFR 10.9(a) provides as follows:

Any individual not registered under § 10.6 may, upon a showing of circumstances which render it necessary or justifiable, be given limited recognition by the Director to prosecute as attorney or agent a specified application or specified applications, but limited recognition under this paragraph shall not extend further than the application or applications specified.

Payment of Maintenance Fees

35 USC 41(c)(1) provides as follows:

"The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section... at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable."

The statute's promulgating rule, 37 CFR 1.378(b)(3) provides that any petition to accept the 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

Petitions for the delayed payment of maintenance fees under 35 USC 41(c)(1) are treated under the same standard as petitions for revival of abandoned applications under 35 USC 133 because both statutory provisions use the same 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)). Consequently, the Commissioner may revive an abandoned application or reinstate an expired patent if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 USC 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

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. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)); see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. 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). The requirement in 35 USC 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive. See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990). Finally, a petition under 35 USC 133 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable" within the meaning of 35 USC 133. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

As 35 USC 41(c) 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. Consequently, under 35 USC 41(c), a reasonably prudent person in the exercise of due care and diligence takes steps to ensure the timely payment of all maintenance fees during the course of a patent's term. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. An adequate showing that the delay in payment of a maintenance fee was "unavoidable" within the meaning of 35 USC 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fee for the subject patent. Id. Where the record fails to disclose that the patentee took reasonable steps or discloses that the patentee took no steps to ensure timely payment of the maintenance fee, 35 USC 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee.

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, a patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, *supra*; see also "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Hence, under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due; it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

In the November 2, 1998 Decision on Petition, Mr. Calkins, the petitioner for the first petition, was instructed that the petition for reconsideration should include "an exhaustive

attempt to provide the lacking items" noted in that dismissal. The items referred to in the decision included any attempts made by the patentee to ensure the timely payment of the maintenance fee such as a reminder system set up by Mr. Calkins and/or his agents. Additionally, Mr. Calkins was instructed to provide a reason as to why the maintenance fee was not timely paid. *Decision on Petition, page 3*. However, rather than provide the Office with the requested information, Mr. Thompson, the petitioner for the petition for reconsideration, responded to the November 2, 1998 Decision on Petition with a statement that the Office's alleged "error" in failing to change Mr. Calkins' correspondence address in 1991 prevented Mr. Calkins "from receiving normal Patent Office correspondence which could have prevented problems with the third maintenance fee." *Petition for Reconsideration, page 1 (December 31, 1998)*. Mr. Thompson followed this statement with a supplication to the Office that "[t]ime consideration by the Patent Office should start with this date of correction." *Id.* The "date of correction" which Mr. Thompson seeks is sometime in 1998 when the correspondence address was supposedly corrected. *See Attachment to Petition for Reconsideration.*

Mr. Thompson's statements with regard to the correspondence address for this patent tend toward the equivocal for two reasons: First, as the patentee, Mr. Calkins himself stated in the attachment to the original June 22, 1998 petition that the address at P.O. Box 416, Los Alamos, New Mexico 87544 was "maintained...so that patent correspondence would not be a problem." This address is in fact the same address which the Office had on file prior to the alleged "correction." *See Issue Fee Transmittal (January 28, 1983) (address noted as Noel C. Calkins, 352 Boyce (or Box 416), Los Alamos, NM 87544)*. Curiously, however, in the facsimile transmission by Mr. Thompson to Stephanie Graham of the Office, Mr. Thompson states that the "address on the patent did not exist until [July 9, 1992]," yet, despite the nonexistence of this address prior to July 9, 1992, Mr. Calkins was nevertheless able to receive the second Maintenance Fee Reminder at this very address on January 9, 1991. *Attachment to Petition for Reconsideration*. Second, in the petition for reconsideration, Mr. Thompson intimates that the Office failure to change the correspondence address from P.O. Box 416, Los Alamos, NM 87544 to Box 190, Los Alamos, NM 87544, as indicated on the first Maintenance Fee Reminder, resulted in the failure to place the patent on a maintenance fee schedule. Yet, as mentioned above, the second Maintenance Fee Reminder for this patent was successfully sent to the P.O. Box 416, Los Alamos, NM address on January 9, 1991. Moreover, a review of the record for this patent reveals that numerous correspondences received from the patentee as well as from Mr. Thompson bear the P.O. Box 416, Los Alamos, NM address. *See Petition for Reconsideration (December 31, 1998); Petition to Accept the Delayed Payment of a Maintenance Fee (June 22, 1998); Maintenance Fee Reminder (January 1, 1991); Maintenance Fee Reminder (January 27, 1987); Issue Fee Transmittal Form (January 28, 1983)*. Accordingly, the fact that a Maintenance Fee Reminder was never sent out for this patent has no relation to any Office actions or omissions with respect to the correspondence address for this patent.



In addition to the foregoing, Mr. Calkins was also advised in the November 2, 1998 Decision on Petition that Maintenance Fee Reminders sent out by the Office are a courtesy and that the Office has no duty to send out these reminders. *Decision on Petition, page 2.* Indeed, the fact that the Office has no duty to send out these reminders makes it clear that the Maintenance Fee Reminders should not operate as a reminder system. However, the statements presented in the first petition to accept the delayed payment of the third maintenance fee and reiterated in the instant petition for reconsideration demonstrate that Mr. Calkins was in fact relying upon the Office mailing of Maintenance Fee Reminders for the payment of the maintenance fees for this patent. This reliance on the part of Mr. Calkins as the petitioner in the June 22, 1998 petition is demonstrated with the following statement: "The following are the events which caused the maintenance fee for Patent 4,386,548 to not be paid in a timely manner...The Maintenance Fee did not take this information and put the patent back on a Maintenance Fee schedule and therefore did [not] sent out timely reminders (sic)." *Attachment to June 22, 1998 Petition under 37 CFR 1.378(b).* Mr. Thompson expounds upon Mr. Calkins' statements in the petition for reconsideration with his statement that the Office "error kept Mr. Calkins from receiving normal Patent Office correspondence which could have prevented problems with the third maintenance fee." *Petition for Reconsideration, page 1.*

From these statements, it can be inferred that Mr. Calkins was relying upon the Office to send out timely reminders for the Maintenance Fees. As stated in the November 2, 1998 Decision on Petition and again here, a reasonable and prudent patentee must not rely upon the Office for the timely payment of maintenance fees, rather, a reasonable and prudent patentee must establish a reminder system to ensure the timely payment of the maintenance fees.


### CONCLUSION

Petitioner has provided no evidence to demonstrate that reasonable steps were taken to ensure the timely payment of the patentee's maintenance fees. Petitioner's failure to demonstrate any degree of diligence on the part of the patentee with respect to the timely payment of the third maintenance fee precludes a finding of unavoidable delay under 35 USC 41(c) and 37 CFR 1.378(b). Because petitioner has not carried his burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable, the petition for reconsideration must be denied and the delayed payment of the maintenance fee will not be accepted. As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be assumed.

Since it is unclear which correspondence address the patentee desires for this patent file, this decision is being mailed to Mr. Thompson at the address indicated on the petition for reconsideration. To ensure proper delivery, a courtesy copy is being mailed to the correspondence address of record for this patent file.

As this patent will not be reinstated, the \$1,580.00 maintenance fee and the \$1640.00 surcharge fee submitted on June 22, 1998 may be refunded. Petitioner may request a refund of these fees by writing to the United States Patent and Trademark Office, Office of Finance, Refund Branch, Washington D.C. 20231. A copy of this decision should accompany petitioner's request. The \$130.00 petition fee for the reconsideration is not refundable.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Karen Canaan at (703) 306-3313.

  
for Stephen G. Kunin  
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