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In re Patent No. 4,563,981 :  
Issue Date: January 14, 1986 :  
Application No. 06/670,054 : ON PETITION  
Filed: November 9, 1984 :  
Patentee: Roy L. Kramer :

This is a decision on the petition under 37 CFR 1.378(e), filed October 20, 1997, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee and reinstate the above-identified patent.

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

#### BACKGROUND

The above-identified patent (U.S. Patent No. 4,563,981) issued on January 14, 1986. The first maintenance fee was timely paid. Therefore, the second maintenance fee could have been paid during the period from January 14, 1993 through July 14, 1993, or with a surcharge during the period from July 15, 1993 through January 14, 1994. The second maintenance fee for the above-identified patent, however, was not timely paid. Accordingly, the above-identified patent expired at midnight on January 14, 1994.

A petition under 37 CFR 1.378(b) was filed on June 21, 1997, and was dismissed in the decision of August 22, 1997. The instant petition was filed on October 20, 1997, and requests reconsideration of the decision of August 22, 1997, and acceptance of the delayed payment of a maintenance fee for and reinstatement of the above-identified patent.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) provides that:

The Commissioner 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 Commissioner to have been unintentional, or 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 Commissioner 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 Commissioner 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(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

- (1) The required maintenance fee set forth in § 1.20 (e)-(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.

OPINION

Petitioner asserts as causes of the delay in payment of the second maintenance fee for the above-identified patent:

- (1) petitioner's medical condition in May of 1993 (gall bladder) and May of 1994 (brain scan due to hearing loss); and
- (2) petitioner's lack of sufficient financial resources due to the strain such medical condition placed upon petitioner's financial resources. Petitioner submits, *inter alia*, medical documents concerning his condition in May of 1993 and May of

1994, and documents showing petitioner's loan histories between September of 1993 and October of 1995.

As the language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a delayed maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133. See 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), aff'd, 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)). 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 (1887)); see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (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). The requirement in 35 U.S.C. § 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 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner has failed to carry his burden of proof to establish to the satisfaction of the Commissioner that the entire delay in payment of the maintenance fee for the above-identified patent was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3).

As 35 U.S.C. § 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 U.S.C. § 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. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. 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 to ensure the timely payment of the maintenance fees for this patent. Id.

Petitioner was questioned in the decision of August 22, 1997 as to what steps were taken to ensure timely payment of the maintenance fees for the above-identified patent. See decision of August 22, 1997 at 3-4. There is, however, no showing that petitioner took any steps to docket, calendar, schedule, or otherwise track the due dates of the maintenance fees for the above-identified patent. As the record fails to disclose that the patentee took any steps to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee for the above-identified patent.

As discussed in the decision of August 22, 1997 (at 2-3), an adequate showing of unavoidable delay requires a showing of unavoidable delay until the filing of a petition to reinstate the expired patent. The showing of record does not establish that petitioner's incapacity in May of 1993 and May of 1994 disrupted petitioner's ability to conduct business or pay bills<sup>1</sup> during the entire period between July of 1993 (when the second maintenance fee was due) and June of 1997 (when the second maintenance fee was paid). Specifically, there are no statements by petitioner's treating physicians that petitioner was unable to conduct business for the entire period between July of 1993 and June of 1997, and there is no evidence that petitioner's medical condition resulted in petitioner's failure to pay other bills which were due until June of 1997. To the contrary, the record

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<sup>1</sup> Paying a maintenance fee requires no legal evaluation or judgment, but simply the knowledge and awareness necessary to pay a bill that is due.

indicates that: (1) petitioner regularly made payments on his medical bills in 1994 and 1995; and (2) petitioner was engaged in selling a house sometime between July of 1993 and June of 1997. Therefore, the showing of record is inadequate to establish that petitioner's incapacity in 1993 and 1994 is the cause of the delay until June of 1997 in payment of the second maintenance fee for the above-identified patent.

Petitioner was advised in the decision of August 22, 1997 that a showing of unavoidable delay based upon financial condition required a showing of all income, expenses, assets, credit, and obligations for the period between January of 1993 (when the second maintenance fee was payable) and June of 1997, with any documentation that would support petitioner's contentions. See decision of August 22, 1997 at 3-4. The instant petition includes only information and documentation related to petitioner's medical condition; it does not include any information related to petitioner's sources of income, assets, credit, or other obligations or expenses (e.g., bank statements) for any period. In addition, the instant petition does not include any information concerning petitioner's financial condition between November of 1995 and June of 1997. Therefore, the showing of record is inadequate to establish that petitioner's financial condition is the cause of the delay until June of 1997 in payment of the second maintenance fee for the above-identified patent.

#### CONCLUSION

For the above stated reasons, petitioner has failed to carry his burden of proof to establish to the satisfaction of the Commissioner that the delay in payment of the maintenance fee for the above-identified patent was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b). Therefore, 35 U.S.C. § 41(c) and 37 CFR 1.378(b) preclude acceptance of the delayed payment of the maintenance fee for the above-identified patent.

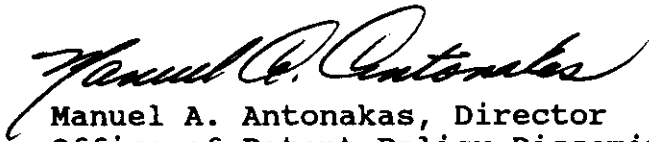
The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of August 22, 1997 has been reconsidered; however, the request to accept the delayed payment of the maintenance fee for the above-identified patent is **DENIED**.

Since the above-identified patent will not be reinstated, the \$1,025.00 maintenance fee and the \$680.00 surcharge fee submitted by petitioner will be refunded.

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

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9282.

The patent file is being returned to Files Repository.



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