



Paper No. 14

BURTON A. AMERNICK  
CONNOLLY BOVE LODGE & HUTZ LLP  
1990 M STREET, N.W.  
WASHINGTON, DC 20036-3425

**COPY MAILED**

FEB 11 2003

**OFFICE OF PETITIONS**

In re Patent No. 4,868,542  
Michael L. Thompson  
Issue Date: September 19, 1989  
Application No. 07/234,620  
Filed: August 22, 1998  
Title: AUTOMOTIVE BRAKE LIGHT AND  
COMMUNICATION SYSTEM

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.378(e), filed December 14, 2001.

This decision may be considered a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See 37 CFR 1.378(e); MPEP 1002.02.

The request to accept the late payment of the maintenance fee is **DENIED**.

**BACKGROUND**

The patent issued September 19, 1989. The six-month grace period for paying the 7 1/2 year maintenance fee expired at midnight on September 19, 1997, with no payment received. Accordingly, the patent expired on September 19, 1997.

The initial petition filed March 19, 2001 under 37 CFR 1.378(c) was dismissed under 37 CFR 1.378(c) as untimely. This petition was also dismissed under 37 CFR 1.378(b) for failure to make an adequate, verified showing that the delay in paying the 7 1/2 (and 11 1/2) year maintenance fees was unavoidable. Since the patent was not being reinstated, the maintenance fees and surcharge were refunded to patentee Thompson. (Decision mailed July 27, 2001). A request for reconsideration of petition under § 1.378, timely filed September 25, 2001, by John A. Myers on behalf of inventor Michael L. Thompson was not accepted as Mr. Myers is neither an attorney or agent registered to practice before the United States Patent and Trademark Office, or by the patentee, the assignee or other party in interest. See 37 CFR 10.5; 35 U.S.C. 33. (Decision mailed December 6, 2001).

**STATUTE, REGULATION AND PROCEDURE**

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

"The Commissioner 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 Commissioner 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."

A late maintenance fee 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. 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, 514-15 (D.C. Cir. 1912); 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).

MPEP 2540 provides, in pertinent part, that

Under the statutes and rules, the Office 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 ensure that the maintenance fee is paid timely to prevent expiration of the patent. The failure to receive the reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. The Office will attempt to assist patentees through the mailing of a Maintenance Fee Reminder in the grace period. However, the failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b). See In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd sub nom. 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).

#### OPINION

On instant renewed petition, petitioner maintains that:

the failure to pay the 7 ½ year maintenance fee ... was in no way due to the action or inaction of the patentee. Moreover, the patentee has exhibited diligence in connection with this matter.

Petitioner submits as evidence of diligence that:

- as stated in his declaration, in February 1993 while he was away on a teaching exchange in the UK, the Ade & Company firm (the firm handling his patent matters) sent him a letter advising that the 7 ½ year maintenance fee would be due no later than March 19, 1997. However, he never received this letter as it was sent to a former address in England;
- patentee first learned March 1999, that the 7 ½ year maintenance fee had not been paid. He then took immediate steps to have the patent reinstated. However, his representative failed to file a petition to accept the late payment of the maintenance fee. In support thereof, petitioner submits a copy of the customer's copy of a bank draft purportedly given to his representative to file with the petition. Petitioner does not submit a copy of the purported petition.

Petitioner's arguments and evidence have been considered, but not found persuasive to make an adequate showing of unavoidable delay in paying the maintenance fee within the meaning of § 1.378.

The lack of knowledge of the requirement to pay maintenance fees would not be sufficient to show unavoidable delay. In this instance, in his declaration, petitioner acknowledges that he was aware that in order to maintain his patent in force for the full 17 year period, the USPTO required renewal fees to be paid on the anniversary dates of 3 ½, 7 ½ and 11 ½ years from the date of issue. However, despite this knowledge, he argues that his failure to receive a reminder letter from his representative led to the unavoidable delay in paying the maintenance fee. Just as the failure to receive a reminder letter from the Office does not constitute unavoidable delay, the failure to receive a letter from one's agent does not constitute unavoidable delay. It did not require a letter for patentee to be aware that the window for paying the 7 ½ maintenance fee would open on September 19, 1996 and close for paying it with the surcharge on September 19, 1997. The due dates for the maintenance fees were set on issuance of the patent.

Patentee did not have a system in place to ensure timely payment of the maintenance fee. The facts as set forth by patentee indicate that the system required further action on his part to have the maintenance fee paid. It appears that when Mr. Thrift of Ade & Company did not hear from patentee he took no action in regards to the 7 ½ year maintenance fee. Patentee offers no evidence of diligence during the period the fee was due in contacting his agent to verify that the fee was paid. Having received a Statement of Account after the 3 ½ year maintenance fee was paid, it is unclear how exhibiting diligence patentee could have believed the 7 ½ year fee had been paid without speaking to his agent during the period for making the payment or having received a Statement of Account verifying payment. According to his own account, patentee first learned of the nonpayment of the 7 ½ year fee in March of 1999, one and one-half years after the grace period for paying the fee had expired.

The payment having not been made patentee continued to have the same agent represent him in this matter. Patentee argues that on or about April 16, 1999, he had his representative file a petition to accept the unintentionally delayed payment of the maintenance fee. Patentee does not submit a copy of the petition, but rather submits a copy of the non-negotiable customer copy of the bank draft for the fees for such a petition. However, this purported petition was never received by the

Office. Patentee's representative does not support his claim that the petition was filed. Patentee's representative does not acknowledge filing such a petition. Specifically, ADE & Company states by letter dated February 28, 2001 and submitted on initial petition that:

Mr. Thrift has stated that he does recall that your 7 ½ year maintenance fee payment was missed because you were out of the country. He also recalls discussing with you what steps would need to be taken to reinstate your US Patent. However, he does not recall receiving the aforementioned money from you or receiving your instructions to revive the patent.

Ade & Company, patentee's representative, states that there is no record of the petition or the bank draft in the files for this patent, and had such documents been prepared or received such records would be in the files. On instant renewed petition, patentee offers no further facts from Ade & Company or agent Thrift on this matter. Even if, Ade & Company failed to file a petition as instructed, petitioner has not provided persuasive evidence that he should not be bound by the actions or inactions of his voluntarily chosen representative. Furthermore, patentee exhibits a further lack of diligence in that not until 2001, per patentee's statement on initial petition, was he aware that the purported petition was never filed.

Patentee certainly has not shown that he exhibited the level of diligence and that his actions or inactions should be excused as in In re Lonardo. Repeatedly during the term of this patent, patentee has failed to take action to maintain the patent. Patentee left the country and did not contact his representative to ensure that the maintenance fee had been paid. Having not received a verification of payment by Statement of Account as previously received, patentee has not shown that he took any steps to verify the status of the patent while out of the country. Upon his return, it took patentee more than a year to discover that the 7 ½ year maintenance fee had not been paid. Then, patentee purportedly took steps to file a petition to accept the unintentionally delayed payment of the maintenance fee. Yet, given his prior experience, patentee did not verify that such a petition was filed and granted. Another year passed before patentee was aware that his patent continued to be considered lapsed. Patentee has not shown that he was under any infirmity, or otherwise unavoidably delayed in taking action to maintain and then reinstate his patent.

The record fails to adequately evidence that the patentee exercised the due care observed by prudent and careful men, in relation to their most important business, to establish unavoidable delay, Pratt supra.

#### CONCLUSION

The prior decision which refused to accept under § 1.378(b) the delayed payment of a 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 and 37 CFR 1.378(b).

Since this patent will not be reinstated, the maintenance fee and the surcharge fee authorized to Deposit Account No. 22-0185 will not be charged. The fees previously submitted directly by patentee have previously been refunded.

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

The revocation of attorney and change of correspondence address, filed December 14, 2001, is acknowledged and made of record.

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.



Beverly Flanagan  
Supervisory Petitions Examiner  
Office of Petitions