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Paper No. 12

PEARNE, GORDON, McCOY & GRANGER  
 1200 LEADER BLDG.  
 CLEVELAND, OH 44114

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**APR 28 1998**

**OFFICE OF PETITIONS  
 A/C PATENTS**

In re Patent No. 4,919,695	:	
Issue Date: April 24, 1990	:	
Application No. 07/342,161	:	ON PETITION
Filed: February 23, 1989	:	
Patentee: Pierre Trepaud	:	

This is a decision on the petition filed February 2, 1998, requesting a refund of the \$1,025 maintenance fee payment submitted on September 30, 1997.

The petition is **DENIED**.

BACKGROUND

The above-identified patent (U.S. Patent No. 4,919,695) issued on April 24, 1990. The first maintenance fee was timely paid. Therefore, the second maintenance fee became payable on April 24, 1997, and was due on October 24, 1997. The second maintenance fee was paid on September 30, 1997.

Petitioner (Pearne, Gordon, McCoy & Granger) asserts that: (1) on July 18, 1997, petitioner requested instructions from Cabinet Flechner by letter on whether to pay the second maintenance fee for the above-identified patent and advised Cabinet Flechner that the second maintenance fee for the above-identified patent would be paid unless instructions to the contrary were received by September 15, 1997;<sup>1</sup> (2) on July 23, 1997, Cabinet Flechner advised petitioner by letter not to pay the second maintenance fee for the above-identified patent unless Cabinet Flechner provided instructions to the contrary, but this letter was never received by petitioner; and (3) on September 30,

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<sup>1</sup> The instant petition lacks of a copy of this letter.

1997, petitioner paid the second maintenance fee for the above-identified patent. Petitioner argues that the second maintenance fee for the above-identified patent was paid by mistake on September 30, 1997, and requests a refund of this maintenance fee payment under 37 CFR 1.26.

STATUTE AND REGULATION

35 U.S.C. § 6(a) provides, in part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 41(b) provides that:

The Commissioner shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

- (1) 3 years and 6 months after grant, \$650 [\$1,020]<sup>2</sup>.
- (2) 7 years and 6 months after grant, \$1,310 [\$2,050].
- (3) 11 years and 6 months after grant, \$1,980 [\$3,080].

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period. The Commissioner may require the payment of a surcharge as a condition of accepting within such 6-month grace period the late payment of the applicable maintenance fee. No fee will be established for maintaining a design or plant patent in force.

35 U.S.C. § 42(d) provides that:

The Commissioner may refund any fee paid by mistake or any amount paid in excess of that required.

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<sup>2</sup> As in effect on September 30, 1997. See 37 CFR 1.20(e)-(g). These fees are subject to adjustments pursuant to 35 U.S.C. § 41(f), and are reduced by one-half for small entities pursuant to 35 U.S.C. § 41(h). Thus, the second maintenance fee payable for the above-identified patent on September 30, 1997 was \$1,025.

37 CFR 1.26(a) provides that:

Any fee paid by actual mistake or in excess of that required will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account.

37 CFR 1.362(d) provides that:

Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

- (1) 3 years through 3 years and 6 months after grant for the first maintenance fee,
- (2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and
- (3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

#### DISCUSSION

35 U.S.C. § 42(d) permits a refund of "any fee paid by mistake or any amount paid in excess of that required." Thus, the Patent and Trademark Office (PTO) may refund: (1) a fee paid when no fee is required (a fee paid by mistake); or (2) any fee paid in excess of the amount of fee that is required. See Ex parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment). In the situation in which an applicant or patentee takes an action "by mistake" (e.g., files an application "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application) is not a "fee paid by mistake" within the meaning of 35 U.S.C. § 42(d).

35 U.S.C. § 41(b) requires that the Commissioner charge a fee of \$1,025 to maintain the above-identified patent in force after eight years from its date of grant. 37 CFR 1.362(d)(2) provides that this \$1,025 maintenance fee was payable on or after April 24, 1997, and was due (without a surcharge) on October 24, 1997.

Thus, the \$1,025 maintenance fee paid on September 30, 1997 was not a fee paid when no fee was required, and was not paid in any amount in excess of that required. That petitioner now consider it to have been a "mistake" for action to have been taken to maintain the above-identified patent in force does not cause the maintenance fee submitted on September 30, 1997 to be a "fee paid by mistake" within the meaning of 35 U.S.C. § 42(d).

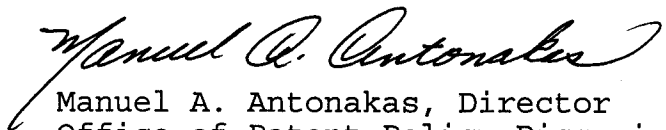
In addition, petitioner engaged in a course of action by which it would submit the second maintenance fee for the above-identified patent in the absence of instructions to the contrary (*i.e.*, petitioner chose not to wait for affirmative instructions from Cabinet Flechner prior to submitting the second maintenance fee for the above-identified patent). Petitioner also chose to submit the second maintenance fee for the above-identified patent prior to its due date (October 24, 1997), presumably to avoid the Fiscal Year 1998 fee increases. Having chosen a course of action by which fees would be submitted on the patentee's behalf without obtaining express instructions from the patentee to do so, petitioner must bear risk that the patentee did not desire petitioner to take such action.

#### CONCLUSION

For the reasons stated above, the petition to refund the \$1,025 maintenance fee payment submitted on September 30, 1997 is **DENIED**.

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.



Manuel A. Antonakas, Director  
Office of Patent Policy Dissemination  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

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