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Patent and Trademark Office
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BRIAN C. SEDGWICK
235 E. COLORADO BLVD.
SUITE 261
PASADENA, CA 91101

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**OFFICE OF PETITIONS
A/C PATENTS**

In re Patent No. 4,982,907 :
Issue Date: January 8, 1991 :
Application No. 07/187,286 : ON PETITION
Filed: April 28, 1988 :
Patentee: Brian C. Sedgwick et al. :

This is a decision on the petition under 37 CFR 1.378(e), filed June 26, 1997, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378 the delayed payment of a maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378 to accept the delayed payment of the maintenance fee for the above-identified patent is **DENIED**.

BACKGROUND

The above-identified patent issued on January 8, 1991. Therefore, the first maintenance fee could have been paid during the period from January 10, 1994 (January 8, 1994 being a Saturday) through July 8, 1994, or with a surcharge during the period from July 9, 1994 through January 9, 1995 (January 8, 1995 being a Sunday). The first maintenance fee for the above-identified patent, however, was not timely submitted. Accordingly, the six-month grace period in 35 U.S.C. § 41(b) ended and the above-identified patent expired at midnight on January 8, 1995.¹

¹ While the decision of April 3, 1997 indicates that the above-identified patent expired on January 10, 1995, MPEP 2506 clarifies that while 35 U.S.C. § 21(a) operates to carry-over the last day for payment of a maintenance fee, when such day falls on a Saturday, Sunday, or federal holiday, it does not operate to carry-over the last day a patent is in force when the maintenance fee is not timely paid. Therefore, the above-identified patent expired at midnight on January 8, 1995.

A petition under 37 CFR 1.378 to accept the delayed payment of the maintenance fee for the above-identified patent was filed on March 3, 1997 (copy filed by facsimile on August 13, 1997). The petition under 37 CFR 1.378 was treated as a petition under 37 CFR 1.378(b),² and dismissed in the decision of April 3, 1997 (remailed on April 25, 1997).

STATUTE AND REGULATION³

35 U.S.C. § 21 provides that:

(a) The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

² The petition of March 3, 1997 failed to indicate whether it was to be treated as a petition under 37 CFR 1.378(b) ("unavoidable" delay) or 1.378(c) ("unintentional" delay). As 35 U.S.C. § 41(c)(1) requires that a petition to accept the delayed payment of a maintenance fee for a patent based upon "unintentional" delay to be filed within twenty-four months of the expiration of the patent, and the petition of March 3, 1997 was not filed within twenty-four months of the expiration of the above-identified patent, the petition of March 3, 1997 was treated as a petition under 37 CFR 1.378(b) ("unavoidable" delay).

³ Chapter 2500 of the Manual of Patent Examining Procedure (6th Ed. Rev. 2) (Sept. 1996) provides a discussion of maintenance fees. A copy of MPEP chapter 2500 is enclosed with this decision.

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 1.6(e) provides that:

Interruptions in U.S. Postal Service.

If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in § 10.1(r) of this chapter.

37 CFR 1.378 provides that:

(a) The Commissioner 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 Commissioner 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 Commissioner 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).

(b) 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.

(c) 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)-(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.

(d) Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. Such petition must be in the form of a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the

maintenance fee is determined to result from an error by the Patent and Trademark Office.

OPINION

Petitioners request that the maintenance fee for the above-identified patent be accepted under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b) as unavoidably delayed. Petitioners alternatively request that the maintenance fee for the above-identified patent be accepted under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c) as unintentionally delayed.

The Commissioner may accept the payment of a maintenance fee required by 35 U.S.C. § 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 Commissioner to have been unintentional." 35 U.S.C. § 41(c)(1).

As discussed above, the six-month grace period in 35 U.S.C. § 41(b) ended and the above-identified patent expired at midnight on January 8, 1995. The maintenance fee was not submitted for the above-identified patent, however, until March 3, 1997 (*i.e.*, it was not filed within twenty-four months after the six-month grace period in 35 U.S.C. § 41(b)). Therefore, 35 U.S.C. § 41(c)(1) precludes acceptance of the delayed maintenance fee for the above-identified patent in the absence of a showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c)(1). That is, 35 U.S.C. § 41(c)(1) precludes acceptance of the delayed maintenance fee for the above-identified patent solely on the basis of a showing of unintentional delay.

37 CFR 1.183 does not authorize the waiver of a requirement of the patent statute. See In re Katrapat, AG, 6 USPQ2d 1863, 1866 (Comm'r Pats. 1988); see also In re Patent No. 4,409,763, 7 USPQ2d 1798, 1802 (Comm'r Pat. 1988) (the statutory requirements of 37 CFR 1.378 cannot be waived), *aff'd sub nom., Ryden 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). Thus, the PTO lacks the authority to waive twenty-four month filing period in 35 U.S.C. § 41(c)(1) and accept the delayed maintenance fee for the above-identified patent solely on the basis of a showing of unintentional delay.

Accordingly, the delayed maintenance fee for the above-identified patent may not be accepted under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c) (*i.e.*, in the absence of a showing that the delay was "unavoidable").

The Commissioner may accept the payment of a maintenance fee required by 35 U.S.C. § 41(b) "at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable." 35 U.S.C. § 41(c)(1).

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. Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting Patent No. 4,409,763, 7 USPQ2d at 1800). 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). 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).

Petitioners have failed to carry their burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3).

Petitioners assert that the delay in payment of the first maintenance fee for the above-identified patent was due to:

(1) the misfiling of numerous documents by petitioners' secretary; (2) petitioners not receiving any notice from the Patent and Trademark Office (PTO) that a maintenance fee was due for the above-identified application; (3) petitioners not receiving any notice from John J. Posta, Jr. (Posta), their representative of record, that a maintenance fee was due for the above-identified application; and (4) the January 1994 earthquake, which the PTO recognized as causing a service interruption in United States Postal Service (USPS) in the greater Los Angeles area.

Petitioners acknowledge that the original Letters patent was discovered in a "paid accounts receivable file" in their Pasadena office. See petition of June 26, 1997 at 2 (¶6). While petitioners assert that the Letters patent was misfiled by their secretary, who was suffering from Alzheimer disease at the time, the instant petition contains no showing that their secretary was instructed to docket, calendar, or otherwise track the maintenance fee due dates, or take any steps to ensure timely payment of the maintenance fees for the above-identified patent. Rather, it appears that petitioners were either unaware of the requirement for the payment of maintenance fees to maintain the above-identified patent in force, or simply relied upon notification from the PTO (or Posta) of the due dates for payment of such maintenance fees. *Id.* at 4 (¶4). In the absence of an adequately corroborated showing that petitioners gave their secretary specific instructions concerning the tracking of the maintenance fee due dates for the above-identified patent,⁴ the misfiling of the Letters patent by petitioners' secretary does not render "unavoidable" petitioners' failure to timely submit the maintenance fee for the above-identified patent.

As discussed in the decision of April 3, 1997, 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

⁴ It is noted that the instant petition lacks: (1) an explanation of what, if any, instructions were given to petitioners' former secretary concerning the filing of the Letters patent or the tracking of the maintenance fee due dates for the above-identified patent; (2) a statement from petitioners' former secretary setting forth whether such instructions were given, and, if so, why such instructions were not followed (or an adequate explanation as to why such a statement could not be obtained); or (3) any probative evidence (e.g., a statement from a medical professional) of their secretary's medical condition during the relevant period.

unavoidable delay.⁵ See Patent No. 4,409,763, 7 USPQ2d at 1800-01; see also Final Rule "Final Rules for Patent Maintenance Fees," 49 Fed. Reg. 34716, 34722-23 (Aug. 31, 1984), reprinted in 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). As stated in MPEP 2540:

Under the statutes and regulations, 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) [citations omitted].

See also MPEP 2575 and 2590.

As 35 U.S.C. § 41(c)(1) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the PTO 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

⁵ As a patentee may not reply upon a Maintenance Fee Reminder for notification of a maintenance fee due date, assertions that the USPS service interruption in January of 1994 resulted in petitioners' failure to receive a Maintenance Fee Reminder for the above-identified patent, or that the examiner was advised that petitioners would be taking over prosecution of the application for the above-identified patent, are immaterial. Nevertheless, a Maintenance Fee Reminder is not mailed until the grace period (*i.e.*, the date the maintenance fee must be submitted with a surcharge under 37 CFR 1.20(h)), which would have been well after the end of the USPS service interruption caused by the January 1994 earthquake.

maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for the above-identified patent. Id.

Petitioners submit a statement by Posta, in which Posta states that: (1) Posta has no records of any file or correspondence concerning the above-identified patent, the application from which it issued, or any maintenance fee documentation; (2) his firm has a double check system, including both a manual and computer entry calendar follow-up system for all patents to ensure timely payment of any maintenance fee, and that it is standard office practice to provide maintenance fee notices approximately six months prior to the due date; (3) his firm experienced significant damage during the January 1994 earthquake, which damaged or destroyed records and computer data; (4) Posta has no recollection and cannot verify whether any maintenance fee notice was ever sent to petitioners.

While it is possible that the above-identified patent was entered into Posta's maintenance fee due date docketing system and, due to the January 1994 earthquake or otherwise, these steps failed to result in a notice being mailed to (or received by) petitioners concerning the first maintenance fee due for the above-identified patent, it is also possible that Posta never sent petitioners a notice concerning the first maintenance fee due for the above-identified patent because the above-identified patent was never entered (or intended to be entered) into Posta's maintenance fee due date docketing system or was entered and subsequently deleted from Posta's maintenance fee due date docketing system (e.g., because petitioners took over prosecution of the application for the above-identified patent from Posta (see petition of June 26, 1997 at 2 (¶5)). That is, petitioners have not provided adequate evidence that it is more likely than not that: (1) the above-identified patent was actually entered (or even intended to be entered) into Posta's maintenance fee due date docketing system; and (2) the above-identified patent was not deleted from Posta's maintenance fee due date docketing system prior to January of 1994. The Posta statement simply fails to provide an adequate explanation as to why Posta's docketing systems failed to result in Posta notifying petitioners that a maintenance fee was due for the above-identified patent. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132 (declaration of petitioner's representative that the representative has no files or current recollection of the events in question is not an explanation of the delay, much less a showing that the delay was unavoidable).

In any event, petitioners' reliance upon Posta to assume the responsibility for docketing the maintenance fee due dates for the above-identified patent does not represent the actions of reasonably prudent persons. First, there is no evidence of any agreement or arrangement between petitioners and Posta for Posta to assume the responsibility for docketing the maintenance fee due dates for the above-identified patent.⁶ Second, petitioners indicate that they took over prosecution of the application for the above-identified patent from Posta, and expected to PTO to deal directly with petitioners concerning the above-identified patent (and the application for such patent). See petition of June 26, 1997 at 2 (¶5). Therefore, petitioners simply had no reasonable basis to expect Posta to notify petitioners of the due dates for payment of the maintenance fees for the above-identified patent, or to act in any representative capacity for petitioners in regard to the above-identified patent.

The PTO recognized that the January 1994 earthquake caused a service interruption in USPS in the greater Los Angeles area.

⁶ To the contrary, a Memorandum dated February 6, 1997 to File of Business Products International (Sophie Cutler) states, in part, that:

Finally I spoke with the secretary of the attorney of record, John J. Posta, Jr. 5850 Canoga Avenue #400 Woodland Hills 91367 (818)348-1088. The secretary informed me that Mr. Posta notified Mr. Sedgwick that the maintenance fee would be due 3.5 years after the patent's date of issuance (i.e., July 8, 1994). After that point, the secretary said that Mr. Posta has nothing to do with the payment of the maintenance fee. Often, the inventor will pay the fee on their own without Mr. Posta's assistance. Therefore, Mr. Posta is not able to furnish us with any written documentation regarding Mr. Sedgwick's failure to pay the maintenance fee.

The above-identified memorandum was not submitted by petitioners to the PTO; rather, a copy of the above-identified memorandum was apparently submitted by petitioners (with other correspondence concerning the above-identified patent) to the Honorable Dianne Feinstein. A copy of the correspondence concerning the above-identified patent (enclosed) submitted by petitioners to the Honorable Dianne Feinstein was subsequently submitted to the PTO for reply.

The *Official Gazette* notice concerning the USPS service interruption in January of 1994 provides:

The January 17, 1994, Los Angeles earthquake has caused a service interruption in United States Postal Service (USPS) in the greater Los Angeles area. Normal postal delivery and collection operations of the USPS were impacted by the earthquake throughout the greater Los Angeles area to varying degrees from January 17, 1994 through January 21, 1994.

The Patent and Trademark Office (PTO) is designating the interruption in the service of the greater Los Angeles area and the overall destruction caused by the earthquake as a postal service interruption and an emergency within the meaning of 35 U.S.C. § 21(a). Any request to accept a paper or fee delayed by the emergency should be directed to Jeffrey Nase, Director, Office of Petitions, (703) 305-9285, PK3-704, for patent-related matters, and to Lynne G. Beresford Trademark Legal Administrator, (703) 305-9464, PK2-910, for trademark-related matters.

See Official Gazette Notice entitled "United States Service Interruption and Emergency in Los Angeles," at 1160 *Off. Gaz. Pat. Office* 39 (March 8, 1994).

Nevertheless, petitioners' reliance upon the USPS service interruption in January of 1994 is misplaced. There is no showing that Posta attempted to notify petitioners of the due date for the first maintenance fee for the above-identified patent in January of 1994 via the USPS, or that petitioners attempted to submit the first maintenance fee for the above-identified patent to the PTO in January of 1994 via the USPS, but that the USPS failed to deliver the notification to petitioners or maintenance fee to the PTO due to the January 1994 earthquake. There is simply no adequate showing that: (1) Posta had undertaken the responsibility for notifying petitioners of the maintenance fee due dates for the above-identified patent; or (2) petitioners were aware that the first maintenance fee for the above-identified patent was payable in January of 1994. Thus, there is simply no adequate showing of a causal relationship between petitioners' delay in payment of the first maintenance fee for the above-identified patent and the January 1994 earthquake.

Assuming, *arguendo*, that there was some causal relationship between petitioners' delay in payment of the first maintenance

fee for the above-identified patent and the January 1994 earthquake, petitioners failed to request that the PTO treat the first maintenance fee for the above-identified patent as submitted in January of 1994 in compliance with 37 CFR 1.6(e). While 37 CFR 1.6(e) provides that the PTO will consider as filed on a particular date correspondence delayed due to interruptions or emergencies in the USPS which have been so designated by the Commissioner, 37 CFR 1.6(e) requires, *inter alia*, that such correspondence be "[p]romptly filed after the ending of the designated interruption or emergency [January 21, 1994]." See 37 CFR 1.6(e)(1). The thirty-seven month delay (between January of 1994 and February of 1997) in submitting the first maintenance fee for the above-identified patent does not constitute the prompt filing of such maintenance fee after and the January 1994 earthquake under 37 CFR 1.6(e). Therefore, petitioners are precluded from relying upon USPS service delays caused by the January 1994 earthquake as the cause of the delay in payment of the first maintenance fee for the above-identified patent.

Assuming, *arguendo*, that petitioners are entitled to notice that maintenance fees must be timely submitted to maintain the above-identified patent in force, the PTO provided more than adequate notice to that effect.

The Letters patent contained a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980.⁷ A reasonably prudent patentee would have inquired to see if the patent was subject to maintenance fees, and, if subject to maintenance fees, would have taken steps to ensure the timely payment of the maintenance fees. See *Ray*, 55 F.3d at 610, 34 USPQ2d at 1788 (the Maintenance Fee Notice on the inside cover of the patent is notice to a patentee that maintenance fees are due).

While the PTO has no obligation to mail or otherwise give notice of a maintenance fee due date, the PTO has adopted a practice of mailing a Maintenance Fee Reminder during the grace period. See

⁷ The misfiling of the Letters patent does not vitiate the notice provided to petitioners in such Letters patent. Assuming, *arguendo*, that due process even entitles petitioners to such a notice, due process does not ensure against the adverse effects of a mistaken response to (misfiling) a timely received notice. See *Brenner v. Ebbert*, 398 F.2d 762, 765, 157 USPQ 609, 611-12 (D.C. Cir.), cert. denied, 393 U.S. 926, 159 USPQ 799 (1968).

Id. PTO records indicate that a Maintenance Fee Reminder was mailed to John J. Posta, Jr. at 5850 Canoga Ave., Suite 400, Woodland Hills, CA 91367⁸ for the above-identified patent on August 16, 1994, more than six months after the end of the USPS service interruption caused by the January 1994 earthquake. There is no adequate showing⁹ that the USPS failed to promptly deliver this Maintenance Fee Reminder for the above-identified patent to 5850 Canoga Ave., Suite 400, Woodland Hills, CA 91367. See Id. at 610, 34 USPQ2d 1788-89 (the Maintenance Fee Reminder mailed to the address of record in the PTO is a second notice to a patentee that maintenance fees are due).

Finally, the *Official Gazette* notice at 1158 *Off. Gaz. Pat. Office* 339-40 (January 11, 1994) (enclosed) gave further notice that a maintenance fee was due for patents having a patent number between 4,982,447 and 4,984,289 (i.e., the above-identified patent). See Patent No. 4,409,763, 7 USPQ2d at 1801.

The record fails to disclose that either petitioners or Posta took reasonable steps to ensure timely payment of the maintenance fee for the above-identified patent. In fact, the record fails to disclose that what, if any, specific steps were taken by either petitioners or Posta to ensure timely payment of the

⁸ Unless a "fee address" is provided, a notices concerning the payment of maintenance fees are directed to the correspondence address of record. See 37 CFR 1.363(a). While petitioners submitted a change of correspondence address on July 17, 1997, the correspondence address for the above-identified patent in August of 1994 was: John J. Posta, Jr., 5850 Canoga Ave., Suite 400, Woodland Hills, CA 91367. Petitioners failed to advise the PTO, either through their counsel of record or otherwise, until July of 1997 that maintenance fee information was to be directed to any address other than to correspondence address then of record for the above-identified patent. Therefore, that the addresses of each of the patentees is printed on the first page of the above-identified patent (or was otherwise among the records of the PTO) is immaterial.

⁹ The showing required to establish non-receipt of an Office communication is set forth in the *Official Gazette* at 1156 *Off. Gaz. Pat. Office* 53 (November 16, 1993). As Posta indicates that he has no file or correspondence concerning the above-identified patent, Posta has no record where the non-received Office communication would have been entered had it been received and docketed.

maintenance fee for the above-identified patent. In the absence of an adequate showing that either petitioners or Posta took reasonable steps to ensure timely payment of the maintenance fee for the above-identified patent, 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 under 37 CFR 1.378(b).

Therefore, petitioners have failed to carry their burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b)(3). Accordingly, the delayed maintenance fee for the above-identified patent may not be accepted under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

CONCLUSION

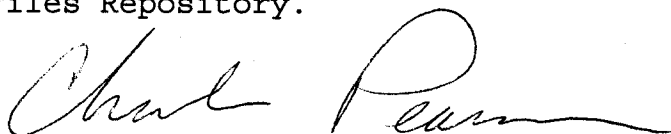
For the above stated reasons, the petition under 37 CFR 1.378(b) is **DENIED** as the delay in payment of the maintenance fee for the above-identified patent cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b). As discussed above, the alternative petition under 37 CFR 1.378(c) is **DENIED** as untimely under 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c).

Since the above-identified patent will not be reinstated, the maintenance fee (\$510) and the surcharge fee (\$680) submitted by petitioners will be refunded.

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9285.

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

The file of the above-identified patent is being forwarded to Files Repository.



Charles A. Pearson
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

rwb

Enclosure: MPEP 2500
Memorandum dated February 6, 1997 to File of
Business Products International
Official Gazette Notice at 1160 Off. Gaz. Pat.
Office 39
Official Gazette Notice at 1158 Off. Gaz. Pat.
Office 339-40