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In re Patent No. 5,095,675 :
Issue Date: March 17, 1992 :
Application No. 07/482,175 : ON PETITION
Filed: February 20, 1990 :
For: RAISED ACCESS PANEL :

This is a decision on the petition, filed July 10, 2000, under 37 CFR 1.378(e) requesting reconsideration of a prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The request to accept the delayed payment of the maintenance fee under 37 CFR 1.378(b) is DENIED.[1]

BACKGROUND

The patent issued March 17, 1992. The first maintenance fee due could have been paid during the period from March 17, 1995 through September 17, 1995, or with a surcharge during the period from September 18, 1995 through March 17, 1996. The above-identified patent expired as of midnight, March 17, 1996.

A petition under 35 USC 41(c)(1) and 37 CFR 1.378(c) was filed October 21, 1999, and was dismissed as time barred in the decision of February 2, 2000.

A petition under 37 CFR 1.378(b) to accept late payment of the first maintenance fee was filed March 2, 2000, and was dismissed in the decision of May 8, 2000.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) states that:

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[1] This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. No further consideration or reconsideration of this matter will be given. See 37 CFR 1.378(e).

> "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 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

The Commissioner may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable"; 35 USC 41(c)(1).

Petitioner requests reconsideration in that the delay is asserted to be unavoidable since petitioner instructed counsel not to pay the maintenance fee for this patent in the mistaken belief that counsel's maintenance fee reminder letter pertained to petitioner's design patent having similar drawings.

Petitioner has not carried the burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable.

Acceptance of late payment of a 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 in responding to an Office action 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, 514-515 (D.C. Cir. 1912); and 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). 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, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See 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); Ray v. Lehman, supra.

In this regard, the transmittal letter for the Letters Patent from counsel to petitioner dated March 20, 1992 specifically and correctly identified the above-captioned patent and also put petitioner on notice of the need to pay maintenance fees for this patent. Furthermore, petitioner appears to have been unaware of 35 USC 41(b), which provides in pertinent part that: "No fee will be established for maintaining a design or plant patent in force." See also 37 CFR 1.362(b) which states in pertinent part: "Maintenance fees are not required for any plant patents or design patents." As such, any communication from counsel pertaining to maintenance fees simply had no relationship to petitioner's design patent. That petitioner may have confused his two patents, while unfortunate, is not a reasonable basis for asserting--or finding-- that the delay herein was unavoidable. Petitioner's misapplication or unawareness of the patent statutes or rules of practice before the PTO is not a basis for asserting unavoidable delay. See, Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985) (misapplication of certified mailing rule does not constitute unavoidable delay); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978) (unawareness of the rule(s) applicable to reissue applications is not a basis for finding unavoidable delay).

Furthermore, the instant Letters Patent contains 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. While the record is not clear as to whether petitioner ever read the Maintenance Fee Notice, petitioner's failure to read or remember the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice

establish unavoidable delay. Ray, 55 F.3d at 610, 34 USPQ2d at 1789. The mere publication of the statute was sufficient notice to petitioner. Rydeen, supra.

Further, in the interval from June 22, 1995 until October 9, 1995 counsel sent four communications to petitioner that specifically and correctly identified the above-captioned patent, and specifically and correctly identified the need for a maintenance fee payment to maintain this patent in force. Nevertheless, on or about October 3, 1995 petitioner returned a fee reminder and advised counsel, in writing, that "we are not interested in pursuing this matter further," which was memorialized in the communication from counsel to petitioner dated October 9, 1995. Thus, petitioner was diligently given by counsel four opportunities, all prior to expiration, to review the correct patent and make his decision to pay the fee *vel non* in the correct patent. As noted in Brenner v. Ebbert, 398 F.2d. 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799:

> The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioner's mistaken response to counsel's four timely reinforcements of petitioner's awareness of the need to pay the maintenance fee for *this* patent is not unavoidable delay. Brenner, supra. Petitioner knew, or should have known, after counsel's four timely warnings, counsel's transmittal letter for the Letters Patent, and the caveat in the Letters Patent itself, notwithstanding the publication of the statute, that the maintenance fee had to be paid in *this* patent for *this* patent to be maintained in force. The issue is solely whether the maintenance, or reinstatement, of *this* patent was actually conducted with the care or diligence that is generally used and observed by a prudent and careful persons in relation to his most important business. The analysis above indicates that *this* patent was not considered by petitioner as his most important business until October 21, 1999, and, consequently, the prosecution (*i.e.*, maintenance and reinstatement) of *this* patent was conducted with significantly less care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business between 1995 and 1999.

Petitioner is advised that, under the circumstances of this case, delay resulting from a deliberate decision not to take a timely action in a proceeding before the PTO is not considered to be "unintentional" delay, much less "unavoidable" delay, which is a more stringent standard. See In re Application of S, 8 USPQ2d 1630 (Comm'r Pat. 1988). A delay caused by the deliberate decision not to take appropriate action within a statutorily prescribed period does not constitute an unintentional, much less unavoidable, delay within the meaning of 35 U.S.C. § 41. In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Such intentional action or inaction precludes a finding of unintentional, much less unavoidable, delay. In re Maldague, 10 USPQ2d 1477, 1478

(Comm'r Pat. 1988). As such, the delay resulting from petitioner's deliberate decision not to pay the maintenance fee is not unintentional, much less unavoidable, delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. In deciding whether to maintain such a valuable property right as a patent in force, a prudent and careful person with respect to his most important business would ensure that his consideration and decision pertained to the correct patent. In this regard, inspection of USPTO records reveals that petitioner has but two U.S. patents, which is not seen to constitute such a large portfolio that would have precluded a prudent and careful person with respect to his most important business from giving each member of his portfolio reasonable care and due deliberation. Even assuming that petitioner was preoccupied with other matters, such preoccupation with other matters does not excuse the delay in payment of the maintenance fee herein. See, Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). The record does not show that petitioner was "unavoidably" prevented from ensuring that the correct patent was maintained in force, or that his decision was directed to the correct patent.

The delay was not unavoidable, because had petitioner exercised the due care of a reasonably prudent person, petitioner would have been able to act to pay the fee or seek reinstatement in a timely fashion. Haines v. Quigg, supra; Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992). The record fails to adequately evidence that petitioner exercised the due care observed by prudent and careful men, in relation to their most important business, which is necessary to establish unavoidable delay. Pratt, supra.

DECISION

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(c) and 37 CFR 1.378(b).

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

Since this patent will not be reinstated, maintenance fees and the surcharges submitted by petitioner totaling $3125, have been credited to counsel's deposit account No. 25-0115. The $130 fee for waiver is not refundable, and the $130 fee under 37 CFR 1.17(h) for requesting reconsideration has been charged to the same account.

The patent file is being returned to the Files Repository.

Telephone inquiries regarding this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

Manuel A. Antonakas, Director,
Office of Petitions