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COCHRAN FREUND & YOUNG LLC
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SUITE 201
FORT COLLINS CO 80525

In re Application of	:	
Keith T. Carron	:	
Application No. 08/514,667	:	
Patent No. 5,693,152	:	DECISION ON RENEWED PETITION
Filed: August 14, 1995	:	UNDER 37 C.F.R. § 1.378(E)
Issue Date: December 2, 1997	:	
Title: MOLECULAR SPECIFIC DETECTOR FOR SEPARATION SCIENCE USING SURFACE ENHANCED RAMAN SPECTROSCOPY	:	

This is a decision on the renewed petition under 37 C.F.R. § 1.378(e), filed on April 5, 2006[1], requesting reconsideration of a prior decision pursuant to 37 C.F.R. §1.378(b)[2], which refused to accept the delayed payment of maintenance fees for the above-referenced patent.

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1 It is noted that subsequent to the filing of this petition, the paper file was marked as lost within the Office. Only recently has the file been reconstructed. The Office regrets the period of delay in issuing this decision.

2 Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. §1.378(b) must include:

(1) The required maintenance fee set forth in 37 C.F.R. §1.20 (e) - (g);
(2) The surcharge set forth in 37 C.F.R. §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

The request to accept the delayed payment of the maintenance fee is **DENIED AS UNTIMELY**[3].

The patent issued on December 2, 1997. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. §1.362(e) expired at midnight on December 2, 2001, with no payment received. Accordingly, the patent expired on December 2, 2001 at midnight.

On November 17, 2004, Petitioner filed a petition under 37 C.F.R. § 1.378(b), which was dismissed via the mailing of a decision on June 21, 2005.

With the original petition, Petitioner submitted the 3½-year maintenance fee, the surcharge associated with a petition to accept late payment of a maintenance fee as unavoidable, and a statement of facts.

With the present petition pursuant to 37 C.F.R. §1.378(e), Petitioner has submitted, *inter alia*, two declarations of facts and the surcharge that is required for the submission of a renewed petition pursuant to 37 C.F.R. § 1.378(e).

Petitioner has again failed to meet the showing requirement under 37 C.F.R. §1.378(b)(3). A discussion follows.

The decision on the original petition was mailed on June 21, 2005, and set a two-month non-extendable period for response. As such, the last day that this petition could have been submitted was August 21, 2005. This renewed petition was filed on April 5, 2006[4]. It follows that **this submission was not timely made, and as such, it cannot be accepted.**

Assuming arguendo that this renewed petition was timely filed, a discussion follows:

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aware of the expiration of the patent, and the steps taken to file the petition promptly.

3 This decision may be regarded as a final agency action within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

4 It is noted that the petition does not appear to contain a certificate of mailing, however the following text appears next to the signature at the terminal portion of the petition: "Dated this 5th day of April 2006."

The standard

35 U.S.C. §41(c)(1) states:

The Director may accept the payment of any maintenance fee… after the six-month grace period if the delay[5] is shown to the satisfaction of the Director to have been unavoidable. 37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay 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[6].

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[7]."

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 C.F.R. § 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b).

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5 This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. §1.378(b).
6 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 Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).
7 Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

The burden of showing the cause of the delay is on the person seeking to revive the application[8].

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[9].

Portion of the Code of Federal Regulations that is relevant to the abandonment of this application

37 C.F.R. § 1.362 Time for payment of maintenance fees.

(a) Maintenance fees as set forth in §§ 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.
(b) Maintenance fees are not required for any plant patents or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.
(c) The application filing dates for purposes of payment of maintenance fees are as follows:
(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.
(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.
(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.
(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original non-reissue application on which the patent reissued is based.
(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.
(d) 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.
(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:

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8 Id.
9 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

(1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.
(2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and
(3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.
(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.
(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.
(h) The periods specified in §§1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.
[49 FR 34724, Aug. 31, 1984, added effective Nov. 1, 1984; paras. (a) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (c)(4) and (e) revised and para. (h) added, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994]

Application of the standard to the current facts and circumstances

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge, as set by 35 U.S.C. 41(c) and 37 C.F.R. § 1.378(b)(3). The period for paying the 3½-year maintenance fee without the surcharge extended from December 2, 2000 to June 2, 2001 and for paying with the surcharge from June 3, 2001 to December 2, 2001. Thus, the delay in paying the 3½-year maintenance fee extended from December 2, 2001 at midnight to the filing of the original petition on November 17, 2004.

The underlying facts are summarized as such:

- The patent was assigned to the University of Wyoming on August 11, 1995[10].

10 Renewed petition, paragraph 1.

- The Research Products Center of the University of Wyoming opened in October of 1999. Prior to that time, from 1995 - 1999, the Office of Research of the University of Wyoming tracked patents owned by the University[11]. When the Research Center was opened, all documents from the Office of Research were transferred to the Research Products Center[12].

- John Nevshemal is the Director of the Research Products Center, and has been since July of 2003[13].

- In the Spring of 2004, Nevshemal commissioned a law firm to identify the patents that are assigned to the University for which maintenance fees were due[14]. Nevshemal first learned of the expiration of the present patent in September of 2004[15].

- The Research Products Center began the construction of a database that served as a tracking system for maintenance fee due dates[16].

- In the Spring of 2004, Mr. Nevshemal noted that the database had problems tracking maintenance fees for patents that issued prior to October 1999, such as the present patent[17].

- Prior to the opening of the Research Products Center, the attorneys who were in charge of prosecuting the present application notified the Office of Research that Maintenance Fees were due on this patent[18].

- The University permitted the inventor, Professor Carron, to choose the attorney who would be responsible for the

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11 Nevshemal declaration of facts, submitted with renewed petition, paragraphs 3 and Nevshemal declaration of facts submitted with original petition, paragraph 9.
12 Nevshemal declaration of facts submitted with original petition, paragraph 10.
13 Nevshemal declaration of facts submitted with renewed petition, paragraphs 1 and 2.
14 Nevshemal declaration of facts submitted with original petition, paragraph 5.
15 Id. at 6.
16 Id. at 11.
17 Id. at 12.
18 Id. at 14.

prosecution of this application[19]. The attorney then directed all correspondence not to the University, but rather to the inventor at his home address[20].

- The attorney informed the inventor that maintenance fees would be required[21]. It appears that the attorney charged the inventor for "docket due date for payment of first maintenance fee[22]."

- The inventor was under the understanding that he would be responsible for the payment of all maintenance fees[23]. It is noted that this is in direct contravention to the inventor's assertion that he "did not understand" that a maintenance fee was due[24], which was presented on original petition.

- In August of 1998, the inventor moved, and failed to apprise his attorney of his change in address[25]. The inventor filed a change of address order with the United States Postal Service (USPS)[26]. The inventor's phone number remained the same[27].

- The inventor was not aware that the USPS only forwards mail for a period of one year, and believed that "mail would be forwarded to my new home address for an indefinite

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19 Nevshemal declaration of facts submitted with original petition, paragraph 15. See also enclosure submitted with original petition labeled as "Appendix A," letter dated April 18, 1995 and Carron declaration of facts, paragraph 10.
20 Nevshemal declaration of facts submitted with original petition, paragraph 17 and Carron declaration of facts submitted with original petition, paragraph 12.
21 Nevshemal declaration of facts submitted with original petition, paragraph 18. See also enclosure submitted with original petition labeled as "Appendix B," letter dated August 10, 1995 and Carron declaration of facts submitted with original petition, paragraph 13.
22 Nevshemal declaration of facts submitted with original petition, paragraph 19. See also enclosure submitted with original petition labeled as "Appendix C," statement dated August 11, 1997 and Carron declaration of facts submitted with original petition, paragraph 14).
23 Carron declaration of facts submitted with renewed petition, paragraph 6.
24 Carron declaration of facts submitted with original petition, paragraph 21.
25 Id. at 15-16.
26 Carron declaration of facts submitted with renewed petition, paragraph 14.
27 Id. at 17.

period[28]." Pursuant to this belief, the inventor did not apprise his attorney of the change of address[29].

- The inventor believed that his attorney would notify him of the due date for the maintenance fee in question, in advance of the due date for the same[30].

- The inventor's attorney has in place a docketing system which tracks the due dates for the maintenance fee payments that are associated with his clients' patents[31].

- The attorney sent a letter to the inventor on January 16, 2001, informing him that the first maintenance fee was due on June 2, 2001[32]. This mailing was returned to him on January 29, 2001, with the notation "Attempted/Not Found[33]."

- The attorney made no further attempt at contacting the inventor[34].

- Neither Mr. Nevshemal nor Mr. Carron ever received either the maintenance fee reminder or the notice of patent expiration[35].

- Neither counsel nor the inventor ever told Nevshemal that maintenance fees were due[36].

- No parties at the Research Products Center were aware that a maintenance fee was due for this patent prior to September of 2004[37].

It appears that the petition was filed promptly after the assignee became aware of the expiration of the patent, however

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28 Id. at 16.
29 Id.
30 Id. at 25.
31 Hein declaration of facts, paragraph 9.
32 Id. at 7.
33 Id. at 11.
34 Id. at 13.
35 Nevshemal declaration of facts submitted with original petition, paragraph 21 and Carron declaration of facts submitted with original petition, paragraph 20.
36 Nevshemal declaration of facts submitted with original petition, paragraph 25.
37 Id. at 26.

Petitioner has failed to establish that the entire period of delay was unavoidable.

As set forth above, **where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b).**

It has not been shown that **reasonable care** was taken to ensure that the maintenance fee would be paid timely.

The inventor was responsible for the submission of the maintenance fees, and as such, he contracted with counsel to track the due dates for the same. As such, it appears that the inventor relied on the receipt of a notice from his attorney. However, the inventor then moved without apprising his attorney of the change of address.

A reasonable man, similarly situated and acting in relation to his most important business, would not have put into place a system which relied on the receipt of a reminder notice from his attorney, and then changed his address without apprising his attorney of the move. A similarly situated reasonable man would not have enacted steps to ensure the timely payment of the maintenance fee, and then taken actions which hampered the ability of these steps to function properly: the notification of a due date was a step that was no less important than the actual tracking of the maintenance fee due date.

The inventor has set forth that he believed that the USPS would forward his mail indefinitely, however this is not a reasonable belief. Additionally, there is no evidence that the USPS ever represented that it would forward mail ad infinitum.

Moreover, the receipt of a reminder from his attorney was absolutely crucial to the maintenance of this patent. It does not appear that a reasonable man would have entrusted the delivery of a communication that was crucial to the maintenance of his most important business to an indirect source of delivery such as a forwarding order. A reasonable man would have ensured the maintenance of his most important business by instead apprising his chosen representative of his move, so that he could receive the mailing directly.

Additionally, it is Petitioner's burden to prove the delay was unavoidable[38]

Similarly, while the University of Wyoming was the assignee and it obligated Mr. Carron to track and pay the fee, and Mr. Carron did this via his counsel, this does not relive the University of it obligation to implement a series of steps so as to ensure the timely submission of the maintenance fee. It was incumbent on the patent holder to have docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his or her most important business, or to have engaged another for that purpose[39]. However, even if one relies on another to pay the maintenance fees, such asserted reliance *per se* does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 C.F.R. § 1.378(b) and 35 U.S.C. § 41(c)[40]. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently[41]. Nevertheless, patent holder is bound by any errors that may have been committed by the obligated party[42].

Mr. Carron did not take care of his own obligation in this matter, and this does not reflect the due care and diligence of a prudent and careful person with respect to his most important business within the meaning of Pratt, supra. However, delay resulting from Mr. Carron's failure to keep his attorney apprised of a current correspondence address for receiving communications from counsel regarding maintenance fee payments is not unavoidable delay[43]. Mr. Carron's failure to provide Hein with a current correspondence address does not excuse the resultant failure to timely submit the maintenance fee for this patent, nor does the delay resulting from Carron's failure to provide Hein with a current address constitute unavoidable delay[44].

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38 Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982). See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.
39 See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995).
40 Id.
41 Id.
42 Id.
43 Ray v. Lehman, 55 F. 3d 606 at 610, 34 USPQ2d 1786 at 1789 (Fed Cir.
44 Id.

Furthermore there is no showing that Mr. Carron was diligent in checking with either Mr. Hein or the USPTO regarding whether the maintenance fee was owed, or had been, paid, or that he was "unavoidably" prevented from contacting his counsel or even the USPTO as to whether the fee had been paid[45]. As such, Mr. Carron failed to treat either this maintenance fee payment, or the earlier reinstatement of this patent, as a prudent and careful person would treat his most important business., particularly as Mr. Carron was not led to believe that the fee had been paid or that the patent had been retained in force[46].

Petitioner has failed to fully comply with the provisions of this title. It follows that the present petition must be **DISMISSED**.

Conclusion

Petitioner has not met the requirements of 37 C.F.R. § 1.378(b)(3), as discussed at length above. For the reasons enumerated in this decision, Petitioner has not established that the entire period of delay has been unavoidable.

The prior decision which refused to accept, under 37 C.F.R § 1.378(b), the delayed payment of a maintenance fee for the above-identified patent, has been reconsidered.

For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b).

Since this patent will not be reinstated, the petitioner is entitled to a refund of the surcharge and the 3½-year maintenance fee, but not the $400 fee associated with the filing of the present renewed petition under 37 C.F.R. § 1.378(e). The money will be refunded to Petitioner's Deposit Account in due course.

After the mailing of this decision, the application file will be forwarded to Files Repository.

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45 Burandt v. Dudas 496 F.Supp.2d 643 at 651 (E.D.va 2007).
46 Id.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

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