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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for Christopher P. Ricci and examiner information for MEHRMANESH, AMIR.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Patent No.:9,173,100 :
Issue Date: October 27, 2015 :
Application No.:13/828,960 : ON PETITION
Filed: March 14, 2013 :
Attorney Docket No. 51263-00062

This is a decision on the petition, filed August 3, 2022, to reinstate the above-cited patent pursuant to 37 CFR 1.378(b)¹.

The petition is DISMISSED.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of this two-month time limit can be granted under 37 CFR 1.136(a). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified patent issued on October 27, 2015. Therefore, the grace period in 35 U.S.C. § 41(b) for paying the 3.5-year maintenance fee expired at midnight on October 27, 2019.

The petition does not satisfy 1.378(b)(3). Petitioner has submitted the required statement of unintentional delay. However, this petition was filed more than two years after the patent expired for nonpayment of a maintenance fee.

The USPTO requires additional information concerning whether a delay in seeking acceptance of a delayed maintenance fee payment was unintentional where the petition to accept such maintenance fee payment was filed more than two years after the date the patent expired for nonpayment. *See Clarification of the Practice for Requiring Additional Information in Petitions*

¹ (a) The Director 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 Director to have been unintentional. If the Director 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 unintentionally delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in § 1.20(e) through (g);

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in payment of the maintenance fee was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) Any petition under this section must be signed in compliance with § 1.33(b).

Filed in Patent Applications and Patents Based on Unintentional Delay, 85 FR 12222 (March 2, 2020). Therefore, additional information, beyond the “Declaration of Gregg Hershenson In Support Of Petition Under 37 CFR 1.378” filed on August 3, 2022, is required that provides a further explanation of the circumstances surrounding the delay that establishes the entire delay was unintentional is required.

The USPTO is concerned with three periods of delay. Petitioner is reminded the burden of proof to establish that the delay from the due date for the payment of the maintenance fee until the filing of a grantable petition was unintentional within the meaning of 35 U.S.C. 41(c)(1) and 37 CFR 1.378 rests with the petitioner.

The first period of delay petitioner must address on renewed petition is the delay in payment of the maintenance fee that resulted in the expiration of this patent. Petitioner must explain the delay between when the maintenance fee was due and when the maintenance fee was paid. As to this first period of delay, petitioner states:

3. On May 15, 2019, AutoConnect entered into a Patent Purchase Agreement (“PPA”) with IP Optimum Limited, under which title to AutoConnect’s patent portfolio, including the Subject Patents, was assigned to IP Optimum. The agreement included provisions governing the payment of maintenance fees and, specifically, required that IP Optimum pay any maintenance fees due and payable on the Subject Patents for the period commencing after the closing date for the PPA on May 15, 2019. Based on this provision, it was AutoConnect’s understanding that IP Optimum was required to pay maintenance fees for the Subject Patents.

4. The PPA was structured so that AutoConnect had various ongoing interests in the assigned patents, including the Subject Patents. Specifically, AutoConnect had a reversionary right to reacquire the patents for no compensation if certain conditions were not satisfied.

5. On March 27, 2020, AutoConnect exercised its right to reacquire the patents, including the Subject Patents.

6. The Subject Patents all expired during the period between September 23, 2019, and November 12, 2019. This was several months after the execution of the PPA and before AutoConnect reacquired the patents. Maintenance fees for AutoConnect patents that were due after this time frame were timely paid and those patents remain in effect.

7. IP Optimum never requested nor did AutoConnect ever authorize, IP Optimum to abandon any patents for any reason, including through a failure to pay maintenance fees.

“Declaration of Gregg Hershenson In Support Of Petition Under 37 CFR 1.378” filed on August 3, 2022, pp.1-2.

Petitioner should note that the party whose delay is relevant is the party having the right or authority to make the timely maintenance fee payment in the above-identified patent. When the entire right, title, and interest in patent have been assigned to a third party (and thus does not retain any legal or equitable interest in the invention), the delay of the patentee to whom the patent was issued is irrelevant in evaluating whether the delay was unintentional. *See Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). *See* MPEP 711.03(c)(II)(C)-(F) for additional guidance on the information required to establish that the entire delay was unintentional. The declaration of Mr. Hershenson makes clear that, at the time the subject patent expired, it was the responsibility of IP Optimum to pay the 3.5-year maintenance fee. On renewed petition, a statement from the authorized representative of IP Optimum is required in which the representative informs as to their understanding of why the 3.5-year maintenance fee for the subject patent was not timely paid.

The second period of delay petitioner must address on renewed petition is the delay in filing the initial petition pursuant to 37 CFR 1.378(b). Petitioner must explain why the initial petition was not filed until August 3, 2022, including, but not limited to informing, how petitioner discovered that the 3.5-year maintenance fee was not paid and the approximate date on which petitioner discovered that the maintenance fee was not paid. The renewed petition must also explain petitioner's diligent efforts to promptly file the petition under 37 CFR 1.378(b) once petitioner discovered the subject patent was expired.

The third period of delay petitioner must address on renewed petition is any undue delay in filing a *grantable* petition pursuant to 37 CFR 1.378(b).

When addressing each of these three periods of delay, petitioner is reminded that an intentional course of action is not rendered unintentional when, upon reconsideration, the petitioner changes his or her mind as to the course of action that should have been taken. *See In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). Petitioner's failure to carry the burden of proof to establish that the "entire" delay was "unintentional" may lead to the denial of a petition under 37 CFR 1.378, regardless of the circumstances that originally resulted in the failure to timely pay the maintenance fee.

When seeking reinstatement of an expired patent, a petitioner should not make a statement that the delay in payment of the maintenance fee was unintentional unless the entire delay was unintentional, including the period from discovering the maintenance fee was not timely paid until payment of the maintenance fee. For example, a statement that the delay in payment of the maintenance fee was unintentional would not be proper when the petitioner becomes aware of an unintentional failure to timely pay the maintenance fee and then intentionally delays filing a petition for reinstatement of the patent under 37 CFR 1.378. *See* MPEP 2590(I).

The renewed petition is not required to be accompanied by a fee under 37 CFR 1.17(m).

In re Patent No. 9,173,100 Application No. 13/828,960

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 United States Patent and Trademark Office
 Box 1450
 Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
 Attn: Office of Petitions

By Internet: EFS-Web or Patent Center

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

/KENYA A THORNTON MCLAUGHLIN/
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