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14/253,371	04/15/2014	Christopher P. Ricci	51263-00215	2967
153965	7590	11/08/2022	EXAMINER	
Patent Ventures, LLC			DUNN, ALEX C	
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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. 9,123,186

Issue Date: 2015 Sep 1

Application No. 14/253,371

Filing or 371(c) Date: 15 Apr 2014

Attorney Docket No. 6583-588

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DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed June 15, 2022, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

Any request for reconsideration under 37 CFR 1.378(d) may be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. This is not a final agency action within the meaning of 5 USC 704.

A maintenance fee payment is required in a patent at 3.5 years, 7.5 years, and 11.5 years from the date of issuance. A petition may be filed to accept the unintentionally delayed payment of a maintenance fee in the event that a maintenance fee is not timely paid.

The subject patent expired September 4, 2019 for failure to timely submit the 3.5 year maintenance fee.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(b) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; and (3) payment of the petition fee set forth in 37 CFR 1.17(m). Where there is a question as to whether the delay in payment of the maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(b) was unintentional, the Director may require additional information. This change went into effect on December 18, 2013, the effective date of the Patent Law Treaties Implementation Act, and applies to this petition. The petition lacks items (1) above regarding the 3.5 year maintenance fee.

Regarding item (1), 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 Filed in Patent Applications and Patents Based on Unintentional Delay, 85 FR 12222 (March 2, 2020).

In this instance, a petition under 37 CFR 1.378(b) was filed more than two years after the patent expired for nonpayment of a maintenance fee. Therefore, petitioner must provide sufficient information of the facts and circumstances surrounding the entire delay to support a conclusion that the entire delay was unintentional. *Id.* at 12223. Details regarding the cause of petitioner's nonpayment of a maintenance fee that resulted in expiration of the patent, when the expiration of the patent was discovered, and the delay between discovery of the expiration of the patent and filing of the petition under 37 CFR 1.378(b) are of particular relevance. Petitioner should provide relevant dates and identify responsible parties where appropriate.

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)-(H) and 2590(I) for additional guidance on the information required to establish that the entire delay was unintentional.

Petitioner asserts that the petition fee and 3.5 year maintenance fee were paid January 17, 2020, after learning that the patent had expired, but that the patent was not reinstated. Petitioner states that it recently discovered that the patent was not reinstated because of a failure to submit form SB66.

There are three periods to be evaluated in the review of a petition to accept a delayed maintenance fee: (1) the period which lead to the initial delay in the payment of the maintenance fee; (2) the period of delay in filing an initial petition to accept the delayed maintenance fee payment, and (3) the filing of a grantable petition to accept the delayed maintenance fee payment.

A review of the record reveals that the 3.5 year maintenance fee and petition fee were received January 17, 2020. However no petition form or other request for a petition was filed with the payment. In view of the circumstances, petitioner must explain in more specificity when it was learned that, despite the previous submission of the petition fee and maintenance fee, a petition to accept the delayed maintenance fee had not been filed and accepted. If any delay occurred between petitioner's discovery that a proper petition had not been previously filed and the filing of the subject petition, an adequate explanation of that delay must be provided.

It is further noted that the window for acceptance of the 7.5 year maintenance fee opened September 1, 2022. The 7.5 year maintenance fee is due with a surcharge March 2, 2023. The last day to timely pay the 7.5 year maintenance fee is September 1, 2023.

Further correspondence with respect to this decision should be delivered through one of the following mediums:

By mail: Mail Stop PETITIONS
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By fax: (571)273-8300
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By internet: EFS-Web¹

Any questions concerning this decision may be directed to the undersigned at (571)272-3231.

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¹ www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197).