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14/253,204	04/15/2014	Christopher P. Ricci	51263-00180	7690
153965	7590	12/22/2022	EXAMINER	
Patent Ventures, LLC			DUNN, ALEX C	
1655 Delano Street, 32			ART UNIT	PAPER NUMBER
Milpitas, CA 93035			3667	
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			12/22/2022	ELECTRONIC

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. 9,147,296 :
Issued: September 29, 2015 :
Application No. 14/253,204 :
Filed: 15 Apr 2014 : **DECISION ON PETITION**
For: CUSTOMIZATION OF VEHICLE :
CONTROLS AND SETTINGS BASED ON :
USER PROFILE DATA :

This is a decision on the petition under 37 CFR 1.378(b), filed August 2, 2022, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) 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. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The petition for reconsideration must include the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

This patent expired on September 1, 2019 for failure to pay 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; (3) payment of the petition fee forth in 37 CFR 1.17(m).

The petition fails to satisfy requirement (1) set forth above as the petition does not satisfy 37 CFR 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.

With respect to the delay, the declaration of Gregg Hershenson asserts *inter alia*:

- He the Chief Executive Officer of AutoConnect Holdings, LLC.
- Petitioner has been responsible for ensuring that maintenance fees have been paid on AutoConnect's patent portfolio, which includes Patent Nos. 9,140,560; 9,142,071; 9,142,072; 9,147,296; 9,147,297; 9,147,298; 9,153,084; 9,159,232; 9,173,100; 9,176,924; and 9,183,685 ("the Subject Patents").
- 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. Effective May 5, 2019, the agreement required IP Optimum to pay any maintenance fees due and payable on the Subject Patents. In view of the purchase agreement, AutoConnect's understanding that IP Optimum was required to pay maintenance fees for the Subject Patents.
- AutoConnect had a reversionary right to reacquire the patents for no compensation if certain conditions were not satisfied.
- On March 27, 2020, AutoConnect exercised its right to reacquire the patents, including the Subject Patents.
- 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.
- 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.
- At no point in time, either before or after execution of the PPA, did AutoConnect intend, or otherwise elect, to abandon the Subject Patents. At all times it was AutoConnect's belief and understanding that all maintenance fees had been paid and the Subject Patents (as with all other patents that were the subject of the PPA) remained in full force and effect.
- Recently, it was brought to our attention that, despite our belief that the Subject Patents remained in full force and effect, that they had expired due to failure to pay maintenance fees. After learning that the Subject Patents had expired, I promptly undertook efforts to confirm that this was not an intentional decision.
- My investigation included discussions with my AutoConnect colleagues, who confirmed there was never any decision or intent to allow the Subject Patents to expire. The investigation also included discussions with AutoConnect's patent counsel to confirm there was never an instruction to let the Subject Patents expire. In addition, working with

our legal counsel, we received confirmation from persons associated with IP Optimum, including those responsible for the payment of maintenance fees, that IP Optimum was not aware the Subject Patents had expired and never made any decisions to allow any patents, including the Subject Patents, to expire. This was further confirmed by IP Optimum's patent counsel.

- The expiration of all the Subject Patents during the September through November 2019 time frame is consistent with the fact the neither AutoConnect nor IP Optimum intended for the Subject Patents to expire. Instead, upon information and belief, it appears that the failure to pay maintenance fees was an accident resulting from a misunderstanding between AutoConnect and IP Optimum about who was responsible for paying the maintenance fees for the assigned patents during the September to November 2019 time frame under the PPA.
- Petitioner's declaration was prepared immediately upon completion of his investigation.

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). Therefore, additional information that provides an 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.

Hershenson asserts that AutoConnect was responsible for timely submitting the maintenance fee for the instant patent. The petition, however, provides no explanation for why AutoConnect did not timely submit the maintenance fee. Accordingly, it cannot be found that the entire period of time, from the time that the maintenance fee was due until the filing of a grantable petition, was unintentional.

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.

Any request for reconsideration of this decision must establish that the failure to timely submit the maintenance, from the time that the maintenance fee was due until the filing of a grantable petition, has been unintentional.

The second period of delay petitioner must address on renewed petition is the delay in filing the initial petition pursuant to 37 CFR 1.78. Petitioner must explain why the initial petition was not filed until August 2, 2022.

Hershenson declares that it was “recently” brought to his attention that the patent was expired. Hershenson does not set forth the circumstances surrounding the discovery that the patent was expired.

The petitioner does not indicate when it was discovered that the patent was expired or indicate who made the discovery that the patent was expired. The petition has provided no details of the circumstances surrounding the discovery that the patent was expired. It is noted that Hershenson references an investigation into the circumstances surrounding the expiration of various patents, including that which is the subject of the instant petition. However, neither petitioner nor Hershenson indicate when this investigation commenced and ended.

As it is not known when or how it became known that the patent was expired and when and what action commenced thereafter to seek reinstatement of the patent, it cannot be found that the filing of the instant petition has been unintentionally delayed.

Any request for further consideration of this matter must establish that the delay in filing the initial petition to reinstate the patent was unintentional.

The third period of delay petitioner must address on renewed petition is the delay in filing a *grantable* petition pursuant to 37 CFR 1.378(b). Petitioner is reminded that the burden of establishing that the entire period of delay, from the time that the maintenance fee was due until the filing of a grantable petition, remains with patentee.

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).

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

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Via EFS-Web

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