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14/253,251	04/15/2014	Christopher P. Ricci	51263-00236	6723
153965	7590	02/15/2023	EXAMINER	
Patent Ventures, LLC			DUNN, ALEX C	
1655 Delano Street, 32				
Milpitas, CA 93035				
			ART UNIT	PAPER NUMBER
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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 :
Flextronics AP, LLC : **DECISION ON PETITION**
Application No. 14/253,251 :
Filed: 15 Apr 2014 :
Patent No. 9,147,297 :
Issued: 29 Sep 2015 :
Docket No. 51263-00236

This is a decision on the petition to accept an unintentionally delayed payment of the maintenance fee in an expired patent under 37 CFR 1.378(b), filed August 2, 2022.

The petition under 37 CFR 1.378(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled “Renewed Petition under 37 CFR 1.378(b).” This is **not** a final agency action within the meaning of 5 U.S.C. § 704. No further petition fee or maintenance fee is required.

The above-identified patent issued September 29, 2015. Accordingly, the three and a half year maintenance fee could have been paid during the period from September 29, 2018 through March 29, 2019 without surcharge, or with a 6 month late payment surcharge during the period from March 30, 2019 through September 29, 2019. No three and a half year maintenance fee having been received, the patent expired on September 30, 2019.

37 CFR 1.378(b) provides that:

Any petition to accept an unintentionally delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in 37 CFR 1.20(e) through (g);
- (2) The petition fee set forth in 37 CFR 1.17(m); and
- (3) A statement that the delay in payment of the maintenance fee was unintentional.

The instant petition has not met requirement (3) above.

Petitioner has submitted the required statement of unintentional delay. However, the Director may require additional information where there is a question whether the delay was unintentional.

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.

Here, the petition has included a declaration of Gregg Hershenson, CEO of Assignee AutoConnect Holdings, LLC (the assignment was recorded with the Office on August 28, 2015). Hershenson states that on May 15, 2019, AutoConnect entered into a Patent Purchase Agreement with IP Optimum Limited, under which title to the instant patent was assigned to IP Optimum. The agreement required that IP Optimum pay any maintenance fees due. The agreement was also structured so that AutoConnect had ongoing interests in the patent, including a reversionary right to reacquire the patent for no compensation if certain conditions were not satisfied. Hershenson further states that failure to pay the maintenance fee in the instant patent appears to have resulted from a misunderstanding between AutoConnect and IP Optimum about who was responsible for paying the maintenance fee.

However, as set forth above, the party whose delay is relevant is the party having the right or authority to make the timely payment of the maintenance fee. Accordingly, on renewed petition, Petitioner must provide a verified statement from an authorized representative of IP Optimum concerning their failure to timely pay the maintenance fee. In addition, the renewed petition

should explain how AutoConnect became aware of the expiration of the patent, as well as explain when and how AutoConnect reacquired the patent.

Receipt of the \$1050 petition fee and \$1000 maintenance fee is acknowledged. No further fees are due on renewed petition.

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

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By internet: EFS-Web or Patent Center

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

/Cliff Congo/

Cliff Congo
Attorney Advisor – Office of Petitions