What To Do If The Target Patent Has Expired[1]

by

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## Introduction

According to 35 USC 41(b):

> Unless payment of…[an] applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period.

However, 35 USC 41(c)(1) says that:

> The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

Suppose that you are considering suggesting an interference with a patent that is within its six-month grace period or that has expired pursuant to 35 USC 41(b), either after the expiration of the grace period but prior to expiration of the twenty-four month period, or after the expiration of the twenty-four month period. What should you do?

## Does the PTO Have the Authority to Declare an Interference with an Expired Patent?

This is not as easy a question as you might suppose!

The key case here is Petrie v. Welsh[4] in which an expanded panel of the board consisting of Commissioner Manbeck, Chairman Serota, Vice Chairman Calvert, and Examiner-in-Chief Metz terminated an interference for lack of subject matter jurisdiction after discovering that the patent of one of the interferents had expired *prior to the declaration of the interference* for failure to pay a maintenance fee. More recently, the panel in Waterman v. Birbaum[5] "terminated [the interference] for lack of subject matter jurisdiction"[6] because it discovered that one of the interferents had filed an express abandonment of its application in interference *prior to the declaration of the interference.* According to the board:

> The Patent Statute (35 U.S.C. § 135(a)) does not authorize an interference between an abandoned application and an unexpired patent.[7]

As support for its holding, the panel cited Petrie v. Welsh.

Thus, one might think that, if the target patent has expired for failure to pay a maintenance fee at the time that you are considering suggesting an interference with it, there is nothing to be done (at least unless and until the patent is subsequently revived)--because the BPAI would have no jurisdiction to declare an interference anyway. However, in Mobil Oil Corp. v. Dann,[8] Judge Sirica (of Watergate fame) ordered the PTO to reconsider its decision on a petition requesting a retroactive extension of time to file an appeal in order to set up an interference between a patent and a then-abandoned application. On reconsideration, the PTO granted the petition (i.e., it revived the abandoned application and put the revived application into an interference) on the condition that the applicants agree not to seek a patent.[9]

In addition, Lorenz v. Finkl[10] must be considered. In that case the court affirmed the board's decision that awarded priority to Finkl on the ground that Lorenz's application in interference was abandoned (Rich, J. dissenting). Lorenz had not taken a timely appeal from the final rejection. That is, the Lorenz interference was set up on an application that *was* abandoned (for lack of prosecution) when the interference was declared, but the board awarded priority to the opposing party instead of terminating it for lack of jurisdiction. Curiously, the board in Waterman did not distinguish, discuss, or even mention Lorenz.

**The Problem**

"Maximum John" Sirica has gone to his reward, and, in any event, the facts in Mobil Oil were truly exceptional. Moreover, Lorenz can be distinguished on the ground that the BPAI no longer awards priority.[11] Thus, we think that, if a potential target patent is truly dead, one can safely forgo filing a suggestion of interference with it. The problem is telling when a potential target patent is truly dead--for a patent that expired for failure to pay a maintenance fee can, like a zombie, rise from the grave. Since suggestions of interferences are available on Public PAIR, and since head-to-head competitors frequently monitor the progress of each other's applications, these facts can give rise to some delicate tactical considerations.

**Suppose that the Potential Target Patent is in the Grace Period**

All that the target patentee has to do to prevent its patent from expiring pursuant to 35 USC 41(b) is to pay the "surcharge," which 37 CFR 1.20(h) currently sets at $65 for a small entity and $130 for "other than a small entity." Since this fee is trivial, and since, if an interference is declared, the target patentee will have something to sell for more than that fee no matter how hopeless its situation is,[12] the applicant's instinctive response may be to "let sleeping dogs lie" by not filing its suggestion of interference until after the grace period has run. However, there may be significant risk to adopting that strategy.

If the targeting application has not yet been filed and the targeting applicant needs to establish classical diligence running from just prior to the target patentee's "entry into the field" to its own subsequent reduction to practice date, the BPAI is hardly likely to accept a desire to "lie in the weeds" as constituting an acceptable excuse for a break in classical diligence.[13]

Similarly, if the targeting application has not yet been filed and the targeting applicant needs to establish Peeler diligence[14] running from the actual reduction to practice date that it will rely on to its own constructive reduction to practice date,[15] we believe that, even under the incredibly relaxed standards of Fujikawa v. Wattanasin,[16] "lying in the weeds" is unlikely to be counted as activity rebutting an inference of suppression or concealment arising from a "too long" period between the actual reduction to practice and the constructive reduction to practice.

Finally, even if the filing date or effective filing date of the targeting application is senior to the filing date or the effective filing date of the potential target patent, we think that Their Honors are likely to look askance at a targeting applicant "lying in the weeds" for this purely personal reason, since they are inclined to think that the interference system is designed to protect the public rather than to be used by the PTO's customers to advance their own business ends.

Each of those considerations provides an incentive to file one's targeting application and/or the suggestion of interference promptly--even at the risk of alerting the target patentee.[17]

**Suppose that the Potential Target Patent Has Been Expired for Failure to Pay a Maintenance Fee for Less Than Twenty-Four Months**

37 CFR 1.378(c) reads as follows:

> Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:
>
> (1) The required maintenance fee set forth in § 1.20 (e) through (g);
>
> (2) The surcharge set forth in § 1.20(i)(2); and
>
> (3) A statement that the delay in payment of the maintenance fee was unintentional.

The surcharge set forth in 37 CFR 1.20(i)(2) is currently $1,640 (whether the petitioner is a small entity or "other than small entity"), and the Petitions Office normally accepts without question a patentee's "statement that the delay in payment of the maintenance fee was unintentional." While this surcharge is significantly more than the surcharge for paying the maintenance fee "as of right" during the grace period, it is still very small relative to the potential "shakedown" value of the patent to the target patentee. Thus, the real deterrent here is the fact that, if the interference is declared, or if the target patent becomes involved in infringement litigation, either in a district court or in the ITC, the truthfulness of the target patentee's statement that its failure to pay the maintenance fee was unintentional will inevitably be placed in issue.[18]

The same "unintentional" standard that is used for reviving expired patents due to non-payment of maintenance fees is used under 37 CFR 1.137(b) to revive unintentionally abandoned applications.[19] Accordingly, the PTO's statements on the scope of 37 CFR 1.137(b) are instructive for our purposes:

> It is well established that where applicant deliberately permits an application to become abandoned, the abandonment of such application is considered a deliberately chosen course of action, and the resulting delay cannot be considered "unintentional" within the meaning of § 1.137(b). See Application of G, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to either seek or persist in seeking the revival of an abandoned application, the resulting delay in seeking revival of the application cannot be considered "unintentional" within the meaning of § 1.137(b). The intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to § 1.137. See Maldague, 10 USPQ2d at 1478."[20]

In litigation, the truthfulness of the patentee's statement, submitted to revive an expired patent or an abandoned application, can only properly be challenged through an inequitable conduct claim or counterclaim.[21] It is insufficient for a challenger merely to allege as an affirmative defense that the PTO improperly revived an abandoned application or an expired patent.[22, 23]

Unlike target patents addressed in the previous section that are within their grace period, target patents that have passed their grace periods without payment of maintenance fees expire at the end of the grace period. This raises the possibility of intervening rights for the targeting applicant (and any other potential infringer of the target patent) if the target patent is revived.

35 USC 41(c)(2) reads, in part:

> A patent, the term of which has been maintained as a result of the acceptance of a payment of a maintenance fee under this subsection, shall not abridge or affect the right of any person or that person's successors in business who made, purchased, offered to sell, or used anything protected by the patent within the United States, or imported anything protected by the patent into the United States after the 6-month grace period but prior to the acceptance of a maintenance fee under this subsection, to continue the use of, to offer for sale, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported.

An applicant considering whether to submit a suggestion of interference with an expired patent in this situation might take solace in the above statute's provision that, even if an expired patent were revived, the applicant could continue using or selling a product covered by the target patent to the extent such product was acquired, made, or used during the target patent's lapse period. However, the Federal Circuit in <u>Fonar Corp.</u> v. <u>General Electric Co.</u>[24] suggested that such intervening rights are much more limited and that they would not apply to those who made, used, or sold the subject matter of a patent "as part of a continuing commercial effort begun before the lapse [of the patent]."[25] Indeed, the <u>Fonar</u> court additionally suggested that reliance on the lapse was required for intervening rights.[26] In other words, if <u>any</u> commercial efforts preceded the lapse of the target patent, <u>no</u> intervening rights may be available, even for activities that occurred during the lapse period.

Although the remainder of 35 USC 41(c)(2)[27] provides for equitable remedies at a court's discretion to recoup investments made during the lapse period, the rationale stated in Fonar might similarly limit the availability of such equitable intervening rights to an accused infringer. Accordingly, a targeting applicant should not assume that intervening rights will protect the applicant, should the target patent be revived.

**Suppose that the Potential Target Patent Has Been Expired for Failure to Pay a Maintenance Fee for More Than Twenty-Four Months**

37 CFR 1.378(b) reads as follows:

> Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:
>
> (1) The required maintenance fee set forth in § 1.20 (e) through (g);
>
> (2) The surcharge set forth in § 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 aware of the expiration of the patent, and the steps taken to file the petition promptly.[28]

The surcharge set forth in 37 CFR 1.20(i)(1) is only $700 (whether the petitioner is a small entity or "other than a small entity"). However, that is really not the point. The point is that substantially everything would have been avoidable if only you'd known back then what you know now. Hence, this standard (as applied by at least some Petitions Examiners) is very nearly insuperable.[29]

Neither 37 CFR 1.378(b) nor 35 USC 41(c)(1) recites a maximum amount of time that may pass before reviving a patent for delayed payment of maintenance fees under the "unavoidable" standard. Nonetheless, the underlying legislative history indicates that, "After the expiration of a reasonable period of time, the patentee would bear a heavy burden of proof that the delay was unavoidable."[30]

A court recently summarized the standard for determining whether a maintenance fee payment was unavoidably delayed as follows:

> The key question is, as the Federal Circuit has held, "whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person," Ray v. Lehman, 55 F.3d 606, 609 (Fed. Cir. 1995). In this context, the "reasonably prudent person" has been interpreted to mean that the patent owner must exercise the diligence "generally used and observed by prudent and careful men in relation to their most important business." R.R. Donnelley, 123 F. Supp. 2d at 459 (quoting In re Mattullath, 1912 Dec. Comm'r Pat. 490, 38 App. D.C. 497 (1912)).[31]

Not surprisingly, cases rarely find that maintenance fee payments were unavoidably delayed.[32] The most common scenario for the few cases that find unavoidable delay arise from docketing errors by clerical staff and/or systems that were previously shown to be reliable. The PTO routinely holds that, under those circumstances, it was reasonable to rely upon them.[33]

Commonly argued excuses for delay that were not found "unavoidable" include: ignorance of the need to pay maintenance fees and/or relying upon the PTO's maintenance fee reminder notices,[34] which are sent as a courtesy, and relying upon third parties (including lawyers) to pay the fees who in turn fail to do so, when neither the patentee nor those third parties engaged in reasonably prudent practices to pay the maintenance fees.[35]

## Risks v. Rewards

Before submitting a suggestion of interference in any of the foregoing situations, one should weigh (i) the risk of making potentially unnecessary embarrassing statements in the suggestion of an interference that may never be declared against (ii) the potential benefit that an interference may be declared if the patentee maintains or revives the target patent during prosecution of the targeting application. If an interference is never declared and the targeting application matures into a patent, an alleged infringer of that patent might rely upon statements in the suggestion for interference to argue, among other things, that the expired target patent nonetheless represents 102(g)(2) prior art.

To minimize that risk, one possible strategy might be (1) to ensure that one's targeting application is filed promptly (for purposes of establishing both Peeler diligence and classical diligence), (2) to submit the minimum information necessary regarding the target patent, (3) to monitor the target patent, and (4) to delay filing one's suggestion of interference until the patentee has either paid the surcharge or revived the target patent.

## Conclusion

While applicants in this situation may be tempted to "let sleeping dogs lie," it is essential that the targeting application at least be promptly filed to minimize any possible future diligence issues. Subsequent requests for interference against a target patent might be postponed until after there is some indication that the surcharge is being paid or that the target patent is getting revived, both to avoid making potentially unnecessary embarrassing statements during prosecution and to avoid encouraging a target patentee to pay the surcharge or to revive an expired patent--particularly during a time period that involves the lower "unintentional delay" standard, rather than the more stringent "unavoidable delay" standard. However, that course of conduct is also hazardous, since the APJs and the courts may look unkindly upon an applicant who "lay in the weeds" for that purpose.

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[4] 21 USPQ2d 2012 (PTO BPAI 1991).

[5] 53 USPQ2d 2024 (PTO BPAI 2000) (per curiam) (non-precedential) (expanded panel consisting of SAPJ McKelvey and APJs Schafer, Lee, and Torczon), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 83 JPTOS 161 (2001) at § X.D., "The Board Will Terminate an Interference in Which It Lacked Subject Matter Jurisdiction as of the Date the Interference Was Declared."

[6] 53 USPQ2d at 2024.

[7] 53 USPQ2d at 2024. Contrast Guinn v. Kopf, 96 F.3d 1419, 40 USPQ2d 1157 (Fed. Cir. 1996), discussed in Gholz, A Critique of Recent Opinions of the Federal Circuit in Patent Interferences, 80 JPTOS 321 (1998), at § X.A., "The Board Has Authority to Enter Judgment Against a Patentee Interferent Despite the Fact That It Disclaimed All of Its Claims Designated as Corresponding to the Count." In that case, the court held that the board *does* have authority to enter judgment against a patentee interferent despite the fact that it had disclaimed all of its claims designated corresponding to the count *after the declaration of the interference*.

[8] 421 F. Supp. 995, 197 USPQ 59 (D.D.C. 1976).

[9] For the subsequent history of this case, see In re Krambeck, 198 USPQ 253 (Comm'r 1976), 198 USPQ 255 (Comm'r 1977) (on reconsideration). The Commissioner's decision was upheld by Judge Sirica. Mobil Oil Corp. v. Dann, 448 F. Supp. 487, 198 USPQ 347 (D.D.C. 1978).

[10] 333 F.2d 885, 142 USPQ 26 (CCPA 1964).

[11] The BPAI now enters judgments rather than awards of priority based on its findings concerning priority, and the estoppel consequences of a post-1982 judgment based on priority and a pre-1982 award of priority may well be different.

[12] Even if the target patentee's probability of prevailing in the interference is assumed to be zero, the target patentee can reasonably demand payment of a peppercorn less than the present discounted value of the targeting applicant's anticipated costs in litigating the interference--and, if the targeting applicant is in a hurry for a patent, much more than that.

[13] See generally Gholz and Wilcox, What Excuses for Inactivity During a Classical Diligence Period Are (and Are Not) Good?, 15 Intellectual Property Today No. 3 at page 36 (2008).

[14] So called after Peeler v. Miller, 535 F.2d 647, 653-54, 190 USPQ 117, 122 (CCPA 1976) (Rich, J.). Peeler diligence is diligence during the period from one's own actual reduction to practice to one's own constructive reduction to practice, and it is really the absence of 35 USC 102(g) suppression or concealment. The standards for Peeler diligence are very low.

[15] See generally, Gholz and Wilcox, Proving Peeler Diligence is Unnecessarily Difficult -- and Unnecessarily Costly, 14 Intellectual Property Today No. 9 at page 35 (2007), and Should the Prima Facie Case Include a Showing of the Lack of Suppression Or Concealment?, 14 Intellectual Property Today No. 11 at page 20 (2007).

[16] 93 F.3d 1559, 39 USPQ2d 1895 (Fed. Cir. 1996), discussed in Gholz, A Critique of Recent Opinions of the Federal Circuit in Patent Interferences, 79 JPTOS 271 (1997), at § V.A., "Fitful Activity is Enough to Rebut an Inference of Suppression or Concealment."

[17] See the section entitled **Risks v. Rewards**, infra. If a suggestion of interference is submitted during the grace period and an interference is declared prior to the expiration of the target patent, the target patentee is likely to have much greater difficulty reviving the expired patent (even under the relatively relaxed "unintentional" standard) due to the inter partes nature of interferences. See Lee v. Dryja, 79 USPQ2d 1614, 1620 (PTO BPAI 2005) ("[I]n addition to meeting the requirements of 37 CFR §1.378, Lee must show by a preponderance of the evidence that the delay in payment of the maintenance fee for its now expired ′424 patent was unintentional."), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 88 JPTOS 217, 305 (2006), at § X.B.9. "The APJs Assume Authority to Decide 'Executive Branch' Petitions."

[18] As to infringment litigation, see Ferguson Beauregard v. Mega Systems, LLC, 350 F.3d 1327, 1343-44, 69 USPQ2d 1001, 1013 (Fed. Cir. 2003) (The USPTO had stated that the third-party declarant did not appear to have personal knowledge to support a petition for unintentional delay, but it granted the petition nonetheless. Both the trial and the appellate courts acknowledged that "such a conclusion [of inequitable conduct] would be relatively easy based on the present record," but the Federal Circuit affirmed the district court's refusal to address the inequitable conduct issue because that issue "was not properly raised."). As to interferences, cf. Lee v. Dryja, 79 USPQ2d 1614 (PTO BPAI 2005) (but note that the patentee did not try to revive the patent until after the interference was declared).

[19] That fact that the terms "unintentional" and "unavoidable" are used in the statutes governing revival of both abandoned applications and expired patents makes much of the discussion in this article of expired target patents equally applicable to abandoned target applications.

[20] Department of Commerce, Patent and Trademark Office, Changes to Patent Practice and Procedure, 62 Fed. Reg. 53132, 53162 (Oct. 10, 1997).

[21] Ferguson Beauregard v. Mega Systems, LLC, 350 F.3d 1327, 1343-44, 69 USPQ2d 1001, 1013 (Fed. Cir. 2003).

[22] See id.; and see Laerdal Medical Corp. v. Ambu, Inc., 877 F. Supp. 255, 260, 34 USPQ2d 1140, 1145 (D. Md. 1995) ("[T]here simply does not exist any indication…that Congress intended to make available an affirmative defense in a patent infringement action of the type before this Court, so as to enable a party …to escape liability for infringement of a patent by asserting that the PTO has unlawfully revived an expired patent.")

[23] In both infringement litigation and interferences, the burden to prove inequitable conduct is clear and convincing evidence, and that burden is on the party asserting inequitable conduct. As to interferences, see Ginter v. Benson, 79 USPQ2d 1234, 1241 (PTO BPAI 2005). Note, however, that, as stated earlier, if the patentee attempts to revive a patent during an interference, it is the patentee who will have the burden to show by a preponderance of the evidence that the delay in maintenance fee payment(s) was unintentional (or unavoidable). Lee v. Dryja, 79 USPQ2d 1614, 1620 (PTO BPAI 2005).

[24] 107 F.3d 1543, 41 USPQ2d 1801 (Fed. Cir. 1997).

[25] 107 F.37 at 1554, 41 USPQ2d at 1809 ("We interpret the language 'who made, purchased or used' to mean 'who first began to make, purchase, or use anything protected by the patent during the lapse period.'")

[26] 107 F.37 at 1554, 41 USPQ2d at 1809 ("This provision was intended to protect the rights of those who, in reliance on the lapse, first began using the claimed invention or who first took steps to begin using it during the lapse period."); see also, Utrecht v. Olson, 84 F.Supp.2d 1039, 1042-43, 54 USPQ2d 1101, 1105 (D. Minn. 2000)("Based on the Fonar decision, the Court concludes that intervening rights under Section 41(c)(2) are not absolute, but depend instead on which of the allegedly infringing activity was undertaken in reliance on the lapse period.")

[27] The remainder of 35 USC 41(c)(2) states:

> The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, or used within the United States, or imported into the United States, as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, and the court may also provide for the continued practice of any process that is practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of a maintenance fee under this subsection.

[28] The MPEP at section 2590 adds: "Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in the statement should be furnished as exhibits to the statement."

[29] Indeed, Congress in 1992 added the less burdensome "unintentional delay" standard due to its perception that the "unavoidable delay" standard was too stringent. See Laerdal Medical Corp. v. Ambu, Inc., 877 F. Supp. 255, 257 n.5, 34 USPQ2d 1140, 1143 n.5 (D. Md. 1995), citing H.R. Rep. No. 993, 102nd Cong., 2d Sess., at 2 (1992).

[30] H.R. Rep. No. 97-542, 97th Cong., 2d Sess. at 8 (1982). Not only is this a possible indication that the burden increases with the passage of time, but courts have found this passage to confirm that the "unavoidable" standard is strict. See Burandt v. Dudas, 496 F. Supp. 2d 643, 649 (E.D. Va. 2007) ("Congress intended the 'unavoidable' delay standard to be strict. As Congress has written, '[a]fter the expiration of a reasonable period of time, the patentee would bear a heavy burden of proof that the delay was unavoidable.'"), aff'd, 528 F.3d 1329 (Fed. Cir. 2008).

[31] Burandt v. Dudas, 496 F. Supp. 2d at 649.

[32] Additional guidance on the "unavoidable delay" standard can be gleaned from cases addressing the revival of an abandoned application under 35 USC 133, which likewise uses an "unavoidable delay" standard. See, e.g., In re Patent No. 4,461,759, 16 USPQ2d 1883, 1884 (Dep. Ass't Comm'r Pat. 1990), and In re Katrapat, 6 USPQ2d 1863, 1866 (Comm'r Pat. & Trademarks 1988):

> [The word `unavoidable'] is applicable to ordinary human affairs, and requires no more or greater care than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

[33] Laerdal Medical Corp. v. Ambu, Inc., 877 F. Supp. 255, 259, 34 USPQ2d 1140, 1144 (D. Md. 1995) (Nonpayment delay was unavoidable when, through a patent attorney's secretary's "docketing error," the first maintenance fee due day was set at 3 1/3 years from reissue of a patent rather than from its original issue); see also, California Medical Products, Inc. v. Tecnol Medical Products, Inc., 921 F. Supp. 1219, 1260 (D. Del. 1995) ("[The attorney] had never

before encountered a docketing error….It is not reasonable to expect a docket clerk, or a lawyer, to question and recalculate the information on a docket sheet every time the docket sheet is used, for that would completely negate its effectiveness.”).

[34] See, e.g., MMTC, Inc. v. Rogan, 369 F.Supp.2d 675 (E.D. Va. 2004); In re Patent No. 4,461,759, 16 USPQ2d 1883, 1885 (Dep. Ass't Comm'r Pat. 1990) (“[F]ailure to receive the Maintenance Fee Reminder and the lack of knowledge of the need to pay maintenance fees does not constitute unavoidable delay….[T]he PTO has no duty to notify a patentee of the requirement to pay maintenance fees or to notify a patentee when the maintenance fee is due.”)

[35] See, e.g., R.R. Donnelley & Sons Co. v. Dickinson, 123 F. Supp.2d 456, 461, 57 USPQ2d 1244, 1248 (N.D. Ill. 2000) (“Other than blindly leaving the maintenance fees for the ‘031 patent to [the first party] (even after [the first party] was purchased by a different company), [the second party-assignee] has not established that any steps were taken to ensure timely payment.”)