

PATENT ACT 1977

IN THE MATTER OF an application
under section 28 for restoration of
patent GB2314263 in the name of
Margaret Fleming Somner

DECISION

Background

1. The renewal fee in respect of the sixth year of the patent fell due on 5 February 2002. The fee was not paid by that date or during the six months allowed under section 25(4) upon payment of the prescribed additional fees. The patent therefore lapsed on 5 February 2002. The application for restoration of the patent was filed on 12 September 2002, within the 19 months prescribed under rule 41(1)(a) for applying for restoration. After considering the evidence filed in support of the application for restoration an official letter was sent to the proprietor, Mrs Margaret Fleming Somner, on 25 March 2003 informing her that it was the preliminary view of the Patent Office that the requirements for restoration, as laid down in section 28(3), had not been met. Mrs Somner did not accept this preliminary view and requested a hearing. The matter came before me at a hearing on 24 April 2003.
2. Mrs Somner attended the hearing in person. Mr Ian Sim attended on behalf of the Patent Office.
3. The evidence filed in support of the application consists of four witness statements by Mrs Somner dated 10 September 2002, 21 November 2002, 27 January 2003 and 7 February 2003. Mrs Somner also gave evidence under oath at the hearing.

The Facts

4. Mrs Somner says she used an entry in a diary to remind herself when to pay the renewal fee. From what she said at the hearing, the entry was not written on a particular date in the diary but was included among a number of notes that she would periodically review. However, during the period the sixth year renewal fee could have been paid, it would appear that Mrs Somner did not review the diary because it had been mislaid.
5. On 19 February 2002, the Patent Office sent Mrs Somner a reminder notice in accordance with rule 39(4) informing her that the fee was overdue but that she could still pay it with extension fees up to 5 August 2002. The reminder notice was sent to 73 Cox's End, Over, Cambridgeshire, CBA 5TY which was the latest address the Office had for her. However, she had moved from that address in May 2001 but had omitted to inform the Office. Although she had instructed the Royal Mail to redirect mail to her new address at 22 Queen's Close, Over, Cambridgeshire, the redirection order was only for six months and was not extended. Consequently, the rule 39(4) reminder notice never reached Mrs Somner and was returned to the Patent Office with a Royal Mail sticker attached explaining that it could not be delivered.

Assessment

6. Section 28(3) provides:

“If the comptroller is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee”

7. In assessing this case, I am mindful of the following comment by Aldous J in *Continental Manufacturing & Sales Inc.’s Patent* [1994] RPC pages 535 to 545: “The words ‘reasonable care’ do not need explanation. The standard is that required of the particular patentee acting reasonably in ensuring that the fee is paid.” Therefore, it is important to take into account all the surrounding circumstances and decide in light of those circumstances whether reasonable care has been taken.
8. The diary system Mrs Somner used could be improved. Nevertheless, it worked in the case of the fifth year fee, which was of course, paid, and so there is no reason to believe it would not have worked for the sixth year fee. However, for this simple reminder system to operate effectively, Mrs Somner had to review her diary notes regularly. If, as appears to be the case, she lost the diary, she should have taken care to reestablish a reminder system, for instance by obtaining a new diary and inserting appropriate entries. There is no evidence that she endeavoured to take such action.
9. Had Mrs Somner received the rule 39(4) reminder notice it would no doubt have prompted her to pay the renewal fee. That notice effectively provides patentees with a safety net should, for any reason, their own reminder system breaks down, as in this case. However, for that safety net to work, it was incumbent on Mrs Somner to ensure that the Patent Office was provided with a reliable and up-to-date address to which the reminder should be sent. Failing that, she should at least have made arrangements to have mail redirected to her new address or established other arrangements to ensure she received mail delivered to her old address, for instance by arranging to collect it from that address. Although Mrs Somner did instruct the Royal Mail to redirect mail to her new address, she did not renew the redirection when it expired in October 2001. Nor did she make any other arrangements to ensure she received mail delivered to her previous address.
10. The reason Mrs Somner gives for losing her diary and not endeavouring to reconstitute it and for not notifying the Patent Office of her new address is that she was under considerable stress and depression at the time. This was caused by an accumulation of events following a traumatic marriage which resulted in her divorce and the strain of having to rebuild her life with her two teenage children. Among the many difficulties she faced was looking after her teenage son who was suffering from a serious health problem requiring surgery, finding and refurbishing her new home, seeking new employment after losing her full time job and coping with sales problems relating to her invention.

11. The pressure Mrs Somner was under at the time must have been considerable. However, I cannot ignore the fact that during the period in which she could have paid the renewal fee, including the period in which she could have paid it with additional fees she was able to undertake numerous other demanding tasks. In addition to renovating her home, finding new employment and working as a part time nurse, she was also able to undertake work relating to her product which included finding a new manufacturer and paying a deposit for retooling. This suggests that she was far from incapable of reestablishing her renewal reminder system and notifying the Patent Office of her change of address. The note she has provided from her doctor, whilst confirming that she was suffering from stress does not suggest that she was incapable of carrying out normal business activities. What this suggests to me is that while she may not have been at her full efficiency she was nevertheless in control and still able to function in a reasonable manner. It appears that her preoccupation with her other endeavours contributed to her failing to see that action was taken to ensure that her patent was renewed.
12. Whilst I appreciate the problems Mrs Somner was experiencing at the time, I am not convinced that they were such as to excuse her from taking reasonable care to pay the sixth year renewal fee on her patent. I am not therefore satisfied that she has discharged the burden of proof necessary to show that the requirement in section 28(3) has been met.
13. That said, as I have indicated above, the situation could have been recovered had Mrs Somner received the Office's rule 39(4) reminder notice. Although, Mrs Somner's failure to inform the Office of her change of address was the cause of that notice not reaching her, the fact remains that it was returned unopened to the Patent Office with a Royal mail sticker indicating that it could not be delivered to the address shown on the envelope. Mr Sim says that on receiving the envelope the Office would have checked that the address was correct and that no notification had been received to indicate that the address had been changed. However, having established that no such notification had been received, no attempt had then been made to locate a telephone number on the case file which could have been used to contact Mrs Somner.
14. On inspecting the file I note that there is in fact a day time telephone number on the Patents Form 1/77. Moreover, that same number is shown on a letter Mrs Somner sent from the address to which the rule 39(4) reminder notice had been sent. At the hearing Mrs Somner said that she still used the same telephone number and that had anyone contacted her on that number at the time the rule 39(4) reminder had been returned to the Patent Office they would have got through to her.
15. I am surprised that no attempt was made by the Office to obtain Mrs Somner's telephone number from the patent file and to contact her on that number. The fact that the address on the envelope, which had been returned, tallied with that on the register of patents should have prompted the Office to try other means to contact Mrs Somner, the obvious one being to telephone her. I believe that should have been done as a matter of course as part of the Office's procedure when a rule 39(4) reminder is returned as undelivered, particularly in the case of a private applicant who could have been relying on it as a reminder to pay the fee. Had the Office made a reasonable attempt to contact Mrs Somner by telephone using the number shown on the

documentation in the file but been unable to get through to her then it would have discharged what I would regard, in the circumstances, as a general obligation to try and contact her. In my view not making any attempt to contact her by telephone when a telephone number was available amounts to an "omission" within the meaning of rule 100 which reads as follows:

"(1) Subject to paragraph (2) below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity-

(a) which consists of a failure to comply with any limitation as to times or period specified in the Act or the 1949 Act or prescribed in the Rules or the Patents Rules 1968 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;

(b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and

(c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 or 111."

16. I am therefore prepared to apply the provisions in rule 100 to extend the prescribed period for paying the renewal fee on the grounds that the failure to pay within that period was attributable at least in part to an omission by the Patent Office. Accordingly, subject to the terms set out in the following paragraph, I hereby extend the period for paying the fee so that it shall now expire on 16 June 2003. Reinstatement of the patent will therefore be subject to Mrs Somner paying the outstanding sixth year renewal fee within that extended period.
17. Rule 100(1) provides that any rectification of an irregularity may be subject to such terms as the Comptroller may direct. In view of the fact that the patent has been advertised as ceased and will be reinstated when the renewal fee is paid, I believe that my decision to extend the period for paying the renewal fee should be subject to the following terms.
- (a) If between 25 September 2002, which is the date the patent was advertised in the Patents and Designs Journal as having ceased, and 9 October 2002, which is the date on which the request for restoration was advertised in that Journal, a person:

- (i) began in good faith to do an act which would have constituted an infringement of patent GB2314263, or
- (ii) made in good faith effective and serious preparation to do such an act,

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding that the patent continues in force; but this right does not extend to granting a licence to another person to do the act.

- (b) If the act was done, or the preparations were made, in the course of business, the person entitled to the right conferred by paragraph (a) above may:
 - (i) authorise the doing of that act by any partner of his for the time being in that business, and
 - (ii) assign that right or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquired that part of the business in the course of which the act was done or the preparations were made.
- (c) Where a product is disposed of to another in exercise of the right conferred by paragraphs (a) and (b) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.
- (d) The above provisions apply in relation to the use of the patent for the services of the Crown as they apply in relation to infringement of the patent.

Appeal

18. As the reinstatement of the patent is subject to the imposition of terms, which Mrs Somner may not consider acceptable, it is appropriate that I allow her the opportunity to appeal this decision. Under rule 52 of the Civil Procedure Rules the appeal period is 14 days unless I direct a different period. I see no reason to do so in the present case, and accordingly any appeal must be lodged within 14 days from the date of this decision.

Dated this 16th day of May 2003

M C Wright
Assistant Director, acting for the Comptroller

THE PATENT OFFICE

