



BL O/084/06

24<sup>th</sup> March 2006

## PATENTS ACT 1977

APPLICANT	Byron Roy Best and Vernon Lewis
ISSUE	Whether patent number GB2353752 should be restored under section 28
HEARING OFFICER	B Micklewright

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## DECISION

### Background

- 1 The renewal fees in respect of the sixth year of the patent fell due on 3 September 2004. The renewal fee was not paid by that date or during the six months allowed under section 25(4) upon payment of prescribed additional fees. The patent therefore lapsed on 3 September 2004. The application for restoration of the patent was filed on 22 April 2005, within the nineteen months prescribed under rule 41(1)(a) for applying for restoration.
- 2 After consideration of the evidence filed in support of the application for restoration, the applicant was informed 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. The applicant did not accept this preliminary view and requested a hearing.
- 3 The matter came before me at a hearing on 25 January 2006 at which the applicant was represented by Byron Roy Best, the co-proprietor of the patent.

### The evidence

- 4 The evidence filed in support of the application consists of:
  - a) A witness statement from Vernon Lewis dated 20 April 2005
  - b) A witness statement from Byron Roy Best dated 20 April 2005
  - c) A witness statement from Joanne Charnley dated 3 June 2005

## **The Facts**

- 5 Mr. Best moved from 79 Milton Crescent, Pill, Milford Haven, Pembrokeshire to 131 Glebelands, Hakin, Milford Haven, Pembrokeshire on 2 June 2002. He did not at the time inform the Patent Office of his change of address. He set up a verbal agreement with the new tenant, Joanne Charnley, at his old address concerning forwarding mail. Ms. Charnley agreed to forward any mail addressed to Mr. Best to his new address. Mr. Best did however cancel the gas, electricity and TV license payments for 79 Milton Crescent and also changed his bank details over to his new address.
- 6 Subsequent to changing address, Mr. Best paid the fifth year renewal fee on 5 September 2003 but failed to pay the sixth year renewal fee due on 3 September 2004. Patent Office records indicate that a reminder letter was sent out to Mr. Lewis addressed to 79 Milton Crescent, Mr. Best's old address, on 17 September 2004. Mr. Best first contacted the Office with a view to restoring the patent on 9 April 2005 and at that time informed the Office of his change of address. Mr. Lewis, the other co-proprietor of the patent, did not receive any Office reminders concerning the patent as his address was not the primary address for the patent.
- 7 Ms. Charnley stated in her witness statement that the only mail she received associated with Mr. Best was junk mail. She did not recall receiving any mail of importance.

## **The Applicant's case**

- 8 Mr. Best said that at the time he moved house he was going through a lot of turmoil and was working away from home. He stated that he often works away from home in his occupation as a welder and has only recently been working locally. Mr. Best indicated that he was sometimes only home for a couple of days a month. When he changed address he asked the new occupant to forward any mail to his new address. The new occupant agreed and Mr. Best therefore left the arrangements at that. He did though occasionally call in at his old address to enquire if there was any mail. He also commented at the hearing that he had to inform the bank of his change of address to ensure his bank details were correct so that wages were correctly paid.
- 9 Mr. Best also commented that he was not an office worker and that he found it difficult to keep track of matters such as this on his own, even with his partner, Mr. Lewis, particularly because they do not live in the same area and both often work away from home. He did not at the time realise the seriousness of the failure to pay this renewal fee.
- 10 Mr. Best's case is therefore in essence that he felt he had taken as much care as was reasonable in his circumstances to pay the renewal fee by putting in place the mail forwarding arrangements that he did with a view to relying on Patent Office reminders to pay the fee.

## The Patent Office's case

- 11 The Office had taken the view that the arrangement Mr. Best made with the incoming tenant was an informal one and that such an informal arrangement did not demonstrate that reasonable care had been exercised, particularly given the length of time involved between the change of address on 2 June 2002 and the issue of the reminder on 17 September 2004. The Office referred to previous restoration cases where a proprietor failed to notify the Patent Office of a change of address. In such cases, the Office argued, the failure to receive the renewal reminder would be the fault of the proprietor. In reaching this decision the Office took account of the fact that Mr. Best did inform his bank of his change of address.

## Assessment

- 12 Section 28(3) states:

*If the comptroller is satisfied that-*

*(a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that the 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."*

- 13 In accordance with section 28(3), I have to determine whether or not the applicants took reasonable care to see that the sixth year renewal fees were paid on the patent in suit. In deciding the matter it is helpful to bear in mind the following direction given by Aldous J in *Continental Manufacturing and Sales Inc's Patent* [1994] RPC 535:

"The words "reasonable care" do not need explanation. The standard is that required of the particular patentee acting reasonably to ensure that the fee is paid."

- 14 In *Ling's Patent and Wilson's and Pearce's Patent* [1981] RPC 85, Whitford J held that it was reasonable for an individual in a small way of business who has taken it upon himself to pay renewal fees without professional assistance to rely on the reminder issued by the Office. Mr. Best and Mr. Lewis clearly fall within this category. Whitford J however also gave the following hypothetical example of when, in such cases, reasonable care would not be deemed to have been taken:

"There can be no doubt I think that if you get ... the case of a patentee rather than setting up any machinery electing to rely upon the notice and accepting the payment of the additional fee, then ... failing to take adequate care if he changes his address to send a notification of that, the failure to receive the statutory notice undoubtedly would be his fault..."

- 15 I therefore have to decide whether Mr. Best took reasonable care in the arrangements he set up following his change of address to ensure he received the Office reminder. Although this case is similar to the hypothetical case referred to above in that Mr. Best did not notify the Office of his change of address, he did make some effort to ensure he continued to receive mail sent to his old address. There are however two factors which I need to take into account. The first of these is that Mr. Best elected to rely on an informal arrangement with the new tenant rather than setting up a formal forwarding arrangement with the Post Office, a service the Post Office offers for a small charge. Such a formal arrangement would have been much more reliable than the informal arrangement he set up and would have provided more persuasive evidence that Mr. Best did take adequate care to ensure he received the Office reminders. During the hearing Mr. Best stated that he did not recall ever having received any mail forwarded to him by Ms. Charnley. He also said that although he knew of Ms. Charnley and saw her occasionally locally, he did not know her as a friend. Even though Mr. Best did call in occasionally to see if there was any mail for him, both these elements add further to the informality and therefore the unreliability of the arrangement. The second factor is the length of time that had elapsed between Mr. Best changing his address on 2 June 2002 and the date of the Office reminder of 17 September 2004. Even if the new tenant had been diligent in forwarding any mail at the beginning of this period, as time elapsed it is likely she would have considered it less and less likely that any mail addressed to Mr. Best would have been of any importance.
- 16 It is possible that the reminder never reached Mr. Best's old address and that, had it been delivered there, it would have been forwarded to his new address. The witness statement from Joanne Charnley provides some support for this possibility as she states that the only mail she received associated with Mr. Best was junk mail, and that she does not recall receiving any such mail of importance. This argument would carry more weight if only a short period of time had elapsed since Mr. Best changed address. Patent Office records however show that a renewal letter was drafted, signed and dated 17 September 2004. I am satisfied that this letter was sent out by the Patent Office. Given the length of time that had elapsed since Mr. Best changed his address. It is my view that, on the balance of probabilities, it is more likely that the reminder was delivered to Mr. Best's old address and not forwarded on to him than that the reminder was lost in the post and was never delivered. This therefore adds weight to the argument that the system for forwarding mail set up by Mr. Best was not sufficiently robust to be relied on for receiving Office reminders concerning the payment of renewal fees.
- 17 I asked Mr. Best what had prompted him to remember to pay the fifth year renewal fee, a fee he paid subsequent to changing his address. Mr. Best explained that at that time he was paying considerable attention to his patent. This attention though did not continue through to the time when the sixth year renewal fee became due. I therefore conclude that Mr. Best and Mr. Lewis did not have a suitably robust alternative system in place to that of relying on Office reminders for reminding them to pay the sixth year renewal fee.
- 18 I appreciate the difficulties Mr. Best had in keeping track of when renewal fees

were due for his patent. It must be difficult to keep track of such matters in a profession such as his where he is required to work away from home for significant periods. It is precisely for these reasons that individuals in a small way of business are able to rely on Office reminders to pay their renewal fees. It is however necessary for any person, when they change their address, to put in place adequate provisions to ensure that mail of importance reaches them at their new address. In my view the provisions put in place by Mr. Best would at best have been adequate only for a short period of time following his change of address and certainly would not be adequate more than two years later.

- 19 Taking all the above factors into account, I consider that the system Mr. Best set up to receive Office reminders, namely the informal forwarding arrangement with Ms. Charnley, was not sufficiently robust to be relied on for the payment of renewal fees for the patent. The arrangement was only informal, Ms. Charnley recalled receiving no mail at all of importance for Mr. Best, and a considerable amount of time had elapsed since the system was set up. Reliance on such a system does not in my view satisfy the statutory requirement that the proprietors of a patent take reasonable care to ensure that a renewal fee is paid within the prescribed period or within six months immediately following that period. Moreover neither Mr. Best nor Mr. Lewis set up any other system for reminding themselves to pay the renewal fees for their patent.

### **Conclusion**

- 20 I have considerable sympathy with Mr. Best and Mr. Lewis as to the difficulties they have found in complying with the requirements for keeping their patent in force. It is apparent to me that they never intended to let the patent lapse, but intended to pay the renewal fee within the necessary time limit. But it was also apparent that Mr. Best was aware of the importance of maintaining the patent. In not informing the Patent Office of the change of address or setting up a suitably robust system for ensuring the Office reminders reached them, and as they did not set in place an alternative reminder system, the proprietors of the patent, Mr. Best and Mr. Lewis, have failed to take reasonable care to see that the renewal fee for the sixth year was paid within the prescribed period or that the fee and any prescribed additional fee were paid in the six months immediately following the end of that period. I therefore refuse this application for restoration.

### **Appeal**

- 21 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

### **B MICKLEWRIGHT**

Senior Legal Adviser acting for the Comptroller