



## **Background**

- 7 This case will initially centre around the time periods in which to file a legitimate application for restoration of a patent. Only if I find in favour of the applicant on this matter will I then go on to consider the facts and circumstances surrounding the failure to pay the renewal fees in order to make a determination as to whether the failure to pay the renewal fee on time was “unintentional” (as required by section 28(3) of the Act). If I do not find in favour of the applicant under the first matter, there will be no legitimate restoration application therefore the second issue becomes irrelevant.

## **The issues**

- 8 The essential point at issue in this case is that the Patent Rules 2007 stipulate a specific period for an application for restoration under section 28 of the Act to be made. The Office contends that this application was made about one month outside this period and that this is a non-extendable period by law and as such there is no legitimate application for restoration.
- 9 The applicant does not dispute that the application was filed outside the period allowed, but he claims he was misinformed as to when that period ended hence the late filing of the application for restoration. This in effect was an irregularity of procedure and ought to be remedied under the provisions of rule 107 of the Patent Rules 2007.

## **The Evidence**

- 10 The evidence in this case comprises of a number of documents from Mr. Smith which were usually filed in response to official IPO correspondence, which I have also considered as part of the decision making process. Below I list the dates documents from Mr Smith were received in the IPO and a brief synopsis of the main points made in the document and the official correspondence they were in reply to:
  - a) 29<sup>th</sup> April 2008 – Patents Form 16 and a Statement supporting the application for restoration. In this Mr. Smith apologises for the delay in making the application, states it was never his intention to allow the delay but that this was because of much disruption over the last two years caused by a breakdown three years ago due to exhaustion. He required lengthy medical attention and all his problems had a worsening effect on his family.
  - b) 1<sup>st</sup> July 2008 – letter in reply to an official letter which had notified him that his application for restoration was a month too late. Mr Smith states that he was told on many occasions by the Office that the cut off date was 30<sup>th</sup> April 2008. He claimed to have documentation on which he had scribbled notes of advice he was given by an official of the IPO called “Gareth” regarding how much to pay, the correct Form to file and a date of 30<sup>th</sup> April 2008 by which to file these. He says this was not the first time he had been given that date by IPO officials.

- c) 18<sup>th</sup> September 2008 – this was a covering letter to an attachment which was the documentation on which he had scribbled notes referred to in his letter of 1<sup>st</sup> July 2008. This had been requested in an official letter of 8<sup>th</sup> September 2008. The attachment was a copy of a letter dated 28 February 2007 from the Finance Section of the IPO. The letter contained a number of manuscript notes, including notations saying “2<sup>nd</sup> April phoned Gareth”, “5<sup>th</sup> April” and “30 April” and “30 April 2008”. The paragraph from the official letter referring to this patent (under reference to its original application number of GB0218986.8) read: *“My colleague Steve Gittings has spoken to you regarding the renewal of this Patent as the renewal fee (along with late payment fees) needed to be paid by today[28<sup>th</sup> February 2007]. After discussing it with Steve, you have decided not to pay for this renewal now but will look into the Restoration process at a later date”*.
- d) 7<sup>th</sup> November 2008 – this was in reply to an official letter dated 10<sup>th</sup> October 2008 in which the office acknowledged that according to the notes on the copy of the official letter of 28 February 2007, it seemed that Mr Smith had rung the IPO on the 2<sup>nd</sup> and 5<sup>th</sup> April 2008 and had on both occasions been misinformed of the date by which the application for restoration had to be made. He had been told the 30<sup>th</sup> April 2008 and not the correct date of 31<sup>st</sup> March 2008. However, the official letter noted that that the calls had taken place on the 2<sup>nd</sup> and 5<sup>th</sup> April 2008, i.e. after the 31<sup>st</sup> March 2008, so in fact had made no material difference to the filing of the restoration as the final deadline of 31<sup>st</sup> March 2008 had already been missed. Based on this, the office had not made any error which had prevented Mr Smith from applying for restoration on time. Mr Smith in his reply drew attention to the fact that he had had plenty of previous experience of the office, that he understood that it operates under legal rules and that he had not ever made a mistake in front of the office before. He also states that on top of the two conversations in which he was misinformed of the correct deadline for filing his restorations, he had many months before this spoken to a female official in the Finance Department, who had confirmed the expiry dates. That is why he had left things so long, as he only did things as and when they were needed.
- e) 16<sup>th</sup> December 2008 – this was a long letter in reply to an official letter of 26<sup>th</sup> November 2008. The official letter notified Mr Smith that the IPO was minded to refuse the application for restoration essentially for the reasons outlined in the official letter of 10<sup>th</sup> October 2008 (summarised above). It also drew Mr Smith’s attention to and enclosed a copy of an official letter of 5<sup>th</sup> April 2007, addressed to Mr Smith which had stated that the office *“must receive any application for restoration of this patent by 31 March 2008”*. Mr Smith’s reply agreed that he was aware of the earlier dates in 2007 when he could have paid the renewal fees and reiterated the health and personal problems he had gone through which had led him to prioritize things in the order when they were needed. He had been informed he could restore the patent at a later date and had been led to believe there would be no problem with this

as long as he explained the reasons why. He said he had discussed this situation at length with many IPO staff prior to the two times when the office acknowledges he had been misinformed.

- f) 27<sup>th</sup> January 2009 – Mr Smith wrote saying that 90% of his dealings with the IPO over many years had been via the telephone because he had always found the office willing, polite and helpful. However in this case it seems he had received the wrong information, not just on the 2<sup>nd</sup> and 5<sup>th</sup> April 2008, but previously too. Mr Smith asked “if one man can quote the wrong dates on two separate occasions, despite my enquiry being late anyway, would it be too much to accept that those two calls were not in fact the only calls I made to the patent office?”. Mr Smith also requested a hearing.
- g) 17<sup>th</sup> April 2009 – Mr Smith presented me with a 5 page document at the hearing which I accepted into the proceedings. This turned out to be a helpful aggregation of all the history, background, arguments, etc contained in the previous evidence summarised above. The main points of the document were:
- He was told on many occasions that the final date for applying for restoration was 30<sup>th</sup> April 2008
  - He had had serious medical and personal issues over a number of years, but throughout that period he had kept in contact with the IPO to monitor his patents
  - He admits that this application was filed out of time, but this was because he had been misinformed of the date and that his reputation of previous dealings with the office shows that he should be trusted and that this was an unfortunate mistake, but not of his making
  - His patent is very important to him, but because of the personal difficulties facing him over a number of years, his policy was to deal with things only when he needed to. He had had dealings with the IPO for some ten years and had contacted the Office many times over the years. He had always found IPO staff helpful and had always given him good service, thus when he was told he could restore this patent up to the 30<sup>th</sup> April 2008, that is what he decided to do.
  - He was clearly misinformed on the 2<sup>nd</sup> and 5<sup>th</sup> April 2008 of the final date for filing the application for restoration and it should therefore not be too much to expect the office to reasonably conclude that he had been given these wrong dates previously.
  - He provided details of the benefits of the patent and efforts he was making to progress the patent to manufacture

## **Provisions of the Act and Rules governing restoration of a patent**

- 11 The date of lapse of the patent was 15<sup>th</sup> August 2006. Rule 37 (2) provides that the renewal period is three months ending with the last day of the month in which that renewal date falls i.e. the 31<sup>st</sup> August 2006 in this case.
- 12 Section 25(4) allows a period of grace of a further six months in which to pay the renewal fees, with additional fees. Therefore the period specified in section 25(4) ended on 28<sup>th</sup> February 2007.
- 13 Section 28(1) states:

28 - (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller *within the prescribed period* [my emphasis]
- 14 The “prescribed period” is stipulated in rule 40(1) which states:

40.—(1) An application under section 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in section 25(4) ends.
- 15 In this case the period specified in section 25(4) ended on 28<sup>th</sup> February 2007 and therefore the last date that the application for restoration could have been filed was the last day of the thirteenth month after that – i.e. the 31<sup>st</sup> March 2008.
- 16 Rule 108(1) gives the comptroller the discretion to extend certain time periods within the Rules, except for those stipulated in Schedule 4 Part 1 and 2 of the Rules. Rule 40(1) is amongst those listed in Schedule 4 Part 1. The relevant references are reproduced below:

### **Extension of time limits**

108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4. [My emphasis]

## SCHEDULE 4

### EXTENSION OF TIME LIMITS

#### PART 1

#### PERIODS OF TIME THAT CANNOT BE EXTENDED

rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)

rule 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority)

rule 32(1) (application to reinstate a terminated application)

rule 37 and 38 (renewal of patents)

**rule 40(1) (application to restore a lapsed patent) [My emphasis]**

rule 43(4) (application to cancel entry that licence available as of right)

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### **The arguments**

- 17 Mr Smith's main argument is that he has been consistently misinformed as to the final date for filing the application for restoration. Not just on the two occasions on 2<sup>nd</sup> and 5<sup>th</sup> April 2008 when he accepts it was too late to be of any material effect on this case, but on other occasions before these dates. He argues that in effect these procedural errors caused him to miss the crucial deadline and had it not been for this incorrect advice it would have been possible for him to file the restoration on time and he would have done so. He had certainly not intended for the patent to lapse.
- 18 This is the crux of the issues in these proceedings. If I accept the applicant's arguments, I potentially have the remedy of Rule 107 which would allow me to correct a procedural irregularity. However, before doing so, I need to assess whether such an irregularity had indeed taken place.
- 19 Rule 107 states:

#### **Correction of irregularities**

107.—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and

(b) it appears to the comptroller that the irregularity should be rectified.

- 20 Mr. Smith argued strongly at the hearing and in the documents he filed that his experience before the office was such and his reputation was so good, that he felt he should be given the benefit of doubt over this failure, which he claims was not of his making. He asked that if one IPO official had misinformed him twice in quick succession, was it not reasonable to think others could equally have made the same mistake over the crucial date for filing his restoration application?
- 21 Mr Smith fulsomely praises IPO staff throughout his evidence and he puts the errors of misinforming him of the correct date down to unfortunate and untypical mistakes. He stresses time and again in his evidence the great difficulties he was facing personally at the time the renewal was due. His medical problems were very severe and his whole life had been affected in every aspect. However, he makes it clear that in spite of all the turmoil in his life, he continued to contact the IPO frequently throughout this period because he knew the importance of his patents. While he did allow certain of his patents to lapse in this period, they were all with his knowledge. But the patent in suit was not one he wanted to give up, hence his frequent calls to the IPO to check relevant dates. It was within these calls that he was given the incorrect date of 30<sup>th</sup> April 2008 in which to finally file his restoration application. He says it was his policy to pay things only when he needed to, even though he was made aware by IPO officials that it would cost him significantly more doing it this way.

### **Reasoning and decision**

- 22 On the evidence before me, I do not doubt that Mr. Smith has had a very difficult time throughout the relevant periods concerning the renewal and restoration of this patent. However, the evidence also shows that he still took this and his other patents very seriously because of his frequent calls to the IPO to check and double check various deadlines and details. The evidence is clear too that in the difficult personal circumstances he was facing, he chose not to renew this patent on time or within the 6 months grace period allowed him under Section 25(4) – i.e. by the 28<sup>th</sup> February 2007. He took a concerted decision it seems not to renew it, relying on what he took from his discussions with IPO officials regarding potential restoration of the patent to continue his policy of only paying things as and when they absolutely needed to be paid, i.e. at the last minute.
- 23 To my mind this is always a risky strategy when applied to making sure deadlines are met. In the circumstances Mr Smith found himself in I can fully sympathise with why he chose this approach. However, in Mr Smith's claims it is not the strategy which caused the late filing of the restoration application, but the wrong advice he was given as to the final date for filing. Does the evidence support this?

- 24 My study of the evidence shows that Mr Smith filed at least some documentary evidence to show that he was given the incorrect date on two occasions by the IPO, albeit after the date when he could have filed the restoration on time. All other references from Mr Smith about being given incorrect dates on earlier occasions when he could still have filed the application on time are however unsubstantiated, either with documentary evidence or by reference to specific dates or names of IPO officials. Mr Smith says that he often contacted the office by phone about not only this, but his other patents but he did not keep complete records of these calls. However, he argues that his long reputation before the Office should count in his favour.
- 25 I do not doubt Mr Smith's reputation and integrity before the Office for one minute. At the hearing I found Mr Smith to be understandably nervous, but he seemed to me to be an honest witness who was doing his best to recall events truthfully.
- 26 However, on careful consideration of all the evidence, I do not find it to demonstrate that, on the balance of probabilities, the reason he filed the application for restoration late was because of consistently wrong advice from IPO officials. Mr Smith was clearly wrongly advised by one official twice in quick succession. But there is no evidence to show that on other occasions when he had been in contact with IPO officials about this patent that he had been given consistently incorrect information. Indeed there is no evidence to show that (other than the belated wrong advice) at a time when he could still have filed the application for restoration on time, that he had ever been given the incorrect date. That is not to say I don't believe Mr Smith when he suggests this to be the case as this is his honest recollection, but there is no evidence to this effect other than his unsubstantiated claims. For me to conclude otherwise in the absence of firm evidence would seem to me to be entering into the realms of mere speculation.
- 27 Mr Smith asks me quite reasonably to consider the question that if it happened twice, could it not have happened before? Reasonable though this question is, I conclude I can find no evidence to support that contention. Indeed one document - described above at paragraph 10 e) – shows that the IPO issued a letter with clear reference to the correct final date for filing a restoration application of 31<sup>st</sup> March 2008. Mr Smith does not comment on that official letter, but it would seem to me that if the IPO issued that document with the correct date on it, IPO officials would certainly have had the means to advise Mr Smith of the correct date prior to the crucial deadline. Those means clearly did not help the official who belatedly gave Mr Smith wrong advice on that crucial date, but on the balance of probabilities, I cannot conclude that IPO officials did, or would have given consistently wrong information.
- 28 So I conclude that there was no procedural irregularity to correct and Rule 107 cannot be invoked
- 29 Other than that, the provisions governing the renewal of a patent and the filing of an application for restoration are set out above at paragraphs 11-16 inclusive.



- 30 It seems to me that those provisions are very clear. In short, a proprietor has several chances to maintain the lifespan of a patent. It can be renewed up to three months before the due date and failing that it can be renewed up to six months later (with excess fees). Failing that restoration can still be applied for up to a further period of thirteen months. The period is *twenty two months* in total.
- 31 That is a generous amount of time it seems to me and once that twenty two month period finally ends, that is the end of the ability to resuscitate a lapsed patent. Mr Smith chose the strategy of leaving the filing of the application for restoration late. As I have said, in my view that is a risky strategy. Due to reasons unknown or at best due to unfortunate misunderstandings, the restoration missed its final deadline and was filed late. It is quite clear from Schedule 4 Part 1 of the 2007 Rules that this period cannot be extended. It is by law a non-extendable period and the comptroller is given no discretion under the law to operate outside this specific provision in any circumstances other than those considered above and dismissed under Rule 107.

### **Conclusions**

- 32 It is not without generous statutory opportunity to maintain existing rights that the Act finally terminates those rights. Whilst the 3<sup>rd</sup> party rights of possible infringers are protected up until publication of the notice of the application for restoration (s.28A (4) refers), it is always in the general public interest that the correct status of a patent is known. It is for this reason that eventually the Act finitely terminates the patent in the public interest for the legal certainty this brings if renewal or restoration have not been affected.
- 33 I am very aware that this decision is very unfortunate for Mr Smith and I come to it with personal sympathy for his situation. It is clear that he has suffered great personal difficulty throughout the relevant periods in this case and is himself very unhappy about the failure to file the application for restoration on time. But I can find no way on the evidence put before me to conclude in his favour.
- 34 I must therefore refuse the application for restoration.

### **Appeal**

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

**G J Rose'Meyer**  
Hearing Officer  
Acting for the Comptroller