



**PATENTS ACT 1977**

APPLICANT Adam Brooks Clifford

ISSUE Whether patent application number  
GB0919324.4 should be reinstated under  
Section 20A

HEARING OFFICER Mr. G.J. Rose'Meyer

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**DECISION**

**Background**

- 1 On 26 October 2009, Mr Adam Clifford (the applicant) made an enquiry to the Intellectual Property Office (IPO) about entering his PCT application PCT/GB2007/004701 into the UK national phase.
- 2 The IPO advised Mr Clifford that he was out of time for doing so and as no extension was available to him, the only course of action now was to file an application for reinstatement under Section 20A of the Act.
- 3 Mr Clifford duly filed a reinstatement Form 14 with relevant fee on the same day (26 October 2009). He also filed a letter as evidence in support of his application.
- 4 However, on 4 November 2009, the IPO realised that no National Phase Application Form (Form NP1) had yet been filed, and even though it was too late to enter the national phase, no reinstatement action could be launched unless such an application existed.
- 5 Mr Clifford duly filed a Form NP1 on 4 November 2009 in the name of Adam Brooks Clifford and was allocated patent application no. GB0919324.4. The application was filed under Section 89A (3) of the Patents Act 1977, requesting entry to the UK national phase for international application PCT/GB2007/004701.
- 6 The period prescribed by Rule 66(1) (b) for entry into the National Phase is thirty one months from the earliest declared priority date. The international application PCT/GB2007/00470 has an international filing date of 7 December 2007 and an

earliest priority date of 7 December 2006. The prescribed period for entry to the National Phase therefore expired on 7 July 2009.

- 7 A Form 52 requesting an extension to that prescribed time limit was also filed on 4 November 2009. However, as the applicant had failed to comply with the requirements of Rule 66(1) (b) and the extension of time had not been filed in the time prescribed by Rule 108(3) (i.e. 7 September 2009), arrangements were made to refund the associated fee to the applicant.
- 8 On 27 November 2009 the IPO wrote to Mr Clifford expressing the view that based on the evidence he had supplied in the form of his letter of 26 October 2009, the office was minded to refuse the application for reinstatement. After further evidence and argument from Mr Clifford, the IPO on 22 January 2010 notified Mr Clifford that it was the preliminary view of the Office that the arguments and evidence filed to date were insufficient to allow the request for reinstatement. He was offered the right to a hearing, which he duly accepted.
- 9 Mr Clifford appeared before me at a hearing on 8 April 2010.

### **Evidence**

- 10 The evidence filed by Mr Clifford in support of the application for reinstatement comprised of the following:
  - A five page letter dated 26 October 2009
  - A nineteen page email dated 7 December 2009 with attachments comprising various emails, text documents, a cheque stub and a photocopy of the photograph page of Mr Clifford's UK passport
  - A four page letter dated 2 February 2010
  - A four page skeleton argument document filed on 7 April 2010

### **The Law**

- 11 The provisions for reinstatement are Section 20A and Rule 32. Section 20A(1) states that reinstatement applies –

*“where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is-*  
*(a) set out in this Act or rules, or*  
*(b) specified by the Comptroller”*

- 12 The application was treated as withdrawn on 7 July 2009 as a consequence of the applicant's failure to comply with the time period prescribed by Rule 66(1) (b) for requesting entry to the National Phase.

Section 20A(2) states that –

*“.....the Comptroller shall reinstate the application if, and only if –*

- (a) *the applicant requests him to do so;*
- (b) *the request complies with the relevant requirements of the rules; and*
- (c) *he is satisfied that the failure to comply referred to in subsection (1) above was unintentional”*

Rule 32 states -

- “32. (1) A request under section 20A for the reinstatement of an application must be made before the end of the relevant period.*
- (2) For this purpose the relevant period is—*
- (a) two months beginning with the date on which the removal of the cause of non compliance occurred; or*
  - (b) if it expires earlier, the period of twelve months beginning with the date on which the application was terminated.*
- (3) The request must be made on Patents Form 14.*
- (4) Where the comptroller is required to publish a notice under section 20A(5), it must be published in the journal.*
- (5) The applicant must file evidence in support of that request.*

13 I have taken the date of the removal of the cause of non compliance - Rule 32(1) and (2) (a) - to be on 4 November 2009 when the request to enter the National Phase on Form NP1 was filed. The request for reinstatement was therefore correctly filed within two months of that date.

14 The main issue to be decided therefore is whether the failure to comply with s. 89A(3) and the time period prescribed by rule 66(1) (b) was unintentional.

### **The Arguments**

#### The Office’s view

15 The IPO has taken the view that Mr Clifford’s failure to comply with the requirements of Section 20A of the Act was not unintentional because the evidence shows that he clearly knew the date by which he needed to file the request for entry of his patent into the UK national phase. It also shows he took the decision not to file the request because he believed the cost of doing so was too high for him to afford at that time. Despite many attempts to secure funding from several different sources, Mr Clifford was aware when that deadline was and that subsequently it passed in the knowledge that he did not have the funds to make the necessary request on time. As such, it was a conscious decision and cannot be said to be unintentional.

#### The applicant’s argument

16 In his skeleton argument Mr Clifford categorises his arguments into three “strands”. These are:

- His state of mind
- Lack of funds
- Previous case law

17 Mr Clifford made long submissions in his evidence and at the hearing, often reiterating his points. I shall briefly summarise his arguments under each of his three strands.

*State of mind:*

18 Mr Clifford is a sole inventor who has committed a huge amount of time, effort and resources into the invention the subject of this patent application. He is not an expert on the patenting process and all this has been done through his own efforts, without the financial ability to hire the specialist skills of a patent professional. Throughout his evidence Mr Clifford attests to the all encompassing affects these efforts have had on him, his wife, his family and his friends and associates. All aspects of his life have been seriously affected by his passionate commitment to the project.

19 He describes how he has through various periods of the project raised and endeavoured to raise finance from a range of different sources, including his wife and family, educational institutions and grant schemes in Northern Ireland where he lives. All of this is documented and verified by the attachments to Mr Clifford's nineteen page email dated 7 December 2009. Much of his endeavours resulted in very little actual assistance.

20 Mr Clifford in his evidence and at the hearing vividly and eloquently described how all of this effort had taken its toll on him. Constant attempts to keep the project moving forward and in particular to finance it through the necessary formal stages of the patenting process, had left him at various times (in his own words) "*in a "state of anxiety", "befuddled" "crippled by desperation" and with a "sense of dread...about anything to do with the patenting procedure"*. He explained how all of this led him to "*inflate perceived difficulties and obstacles*" and "*anticipating and frequently thinking, often wrongly, the worst and misconstruing*".

21 It was a lack of expertise of the patenting system which led him to choose the PCT route, which in retrospect Mr Clifford later realised may not have best served his requirements, but it was his general state of mind which caused him to inflate his perceived costs beyond what he later found them to be.

22 Throughout all of these difficulties however, Mr Clifford acknowledges that from January 2009, he was aware about the date by which he needed to file his request for entry into the UK national phase i.e. 7 July 2009.

*Lack of funds:*

23 Mr Clifford describes throughout his evidence how he had to make strenuous efforts to finance his invention throughout the patenting process, applying for funding through various means and by e.g. borrowing money from his wife.

24 At the time when entry into the UK national phase became due (7 July 2009), his state of mind arguments showed that his perception of what the costs of that would be became inflated significantly beyond the reality (as it transpired), to the

point where he was convinced he simply could not afford it. It was essentially this which led to his failure to apply for entry into the UK national phase.

- 25 The evidence shows that Mr Clifford believed the cost of applying to enter both the US and UK national phases would be about £1400. He felt that he would have realistically been able to approach his wife and family for sums up to hundreds of pounds, but due to their view on the likely success of this venture, he felt that £1400 would not have been too much to ask of them. Several other attempts to secure finances from various different sources also failed around the time when Mr Clifford needed to apply to enter the UK national phase.
- 26 However, Mr Clifford only found out during the prosecution of the application for reinstatement that the actual cost of entry into the UK national phase was in fact £30. Mr Clifford was surprised at this and states unequivocally that although he had found great difficulty in financing his project throughout the development and patenting stages, he was always able to afford £30 and had he have known this was the true cost, he certainly would have paid it.
- 27 His relative lack of funds meant he could not afford to hire the patent professional who would undoubtedly have helped clarify these costs to him, but his finances were never in such a state that he could not afford £30. In Mr Clifford's view this was another illustration of his state of mind.

*Previous case law:*

- 28 Mr Clifford is not a patent professional but he researched the issues surrounding his application for reinstatement largely by reference to the IPO website at [www.ipo.gov.uk](http://www.ipo.gov.uk). In his submissions in writing and at the hearing, he referred to and made detailed submissions on a number of previous decisions of the comptroller and reported cases and references from the IPO Manual of Patent Practice he had come across. These are listed below:

- Ian A Ferguson (BL O/272/09)
- Jean Francois Meunier (BL O/013/01)
- Paul MacMullen (BL O/307/03)
- The Matsushita Electrical Industrial Company Limited (BL O/029/08)
- Bernard Edgar Anning (BL O/374/06)
- The Heatex Group Limited [1995] RPC 546
- Derek Norman Green (BL O/087/09)
- Carl Anderson Griffith (BL O/394/09)

- 29 A number of these were discussed at the hearing but for brevity I will only deal in summary with those parts of Mr Clifford's submissions I deem to be most relevant.
- 30 Mr Clifford quite rightly deduced that these cases each contained elements which resembled the circumstances of the application in suit e.g. financial difficulties being faced by Mr Ferguson, Mr MacMullen, Mr Griffith and Mr Green and that even though not all of these cases were decided under s.20A of the Act, some at least were considered under equivalent "unintentional" criterion to that in s.20A.

- 31 However, Mr Clifford makes a number of submissions based on misunderstandings within his reading of some of the cases he brought before me. The most serious of these is his misunderstanding of the role of the Comptrollers discretionary powers.
- 32 He states in his evidence “*My understanding is that the comptroller’s discretion acts as a safety net for understandable failings in procedure, but it’s emphasis is on establishing that the priority of carrying out the required procedure was uppermost in the subscriber’s mind, or that a flaw in procedure was not due to careless or flagrant disregard for procedure and principle.*”
- 33 I understand this to be the Mr Clifford’s interpretation of how to approach the question of an unintentional failure to comply with a requirement of the Act or rules.
- 34 His arguments contend that the Act in some way bestows a general discretion upon the comptroller to overcome failures on the part of applicants to comply with a requirement of the Act or rules. This is not the case. Where there is a statutory requirement, the Act does not bestow any general discretionary ability on the comptroller to overlook a failure to meet that statutory requirement.
- 35 Section 20A states that the comptroller “*shall reinstate the application*” but only “*if*” the applicant can satisfy him that the failure to comply was unintentional. Here the comptroller is asked to judge on the strength of the evidence provided by the applicant, whether he is satisfied or not.
- 36 Mr Clifford is right to assess that there is a judgement to be made so that the comptroller can arrive at the determination as to whether the failure to comply was unintentional or not and that some of the cases he refers to specifically illustrate the development of how the comptroller has done that. But that determination has been made on the basis of the facts and how they apply to the law. The comptroller has no powers to use his discretion to overlook a failure to meet statutory requirements.

### **The analysis**

- 37 The essential determination to be made under Section 20A (2) of the Act therefore is that the Comptroller shall reinstate the application if he is “satisfied that the failure to comply [with s. 89A(3) in this case] ...was unintentional”.
- 38 It is important that the meaning of this requirement is read and understood in totality.
- 39 It is tempting to merely look at the word “unintentional” and decide whether the evidence demonstrates that the circumstances surrounding the facts of the case were unintentional. This is not the test. The determination is not to be reached by examining the general surrounding circumstances of a case, but rather what the reasons were in specific relation to the *failure to comply* (in this case by not

entering the UK national phase on time) and then whether that failure was unintentional.

- 40 Mr Clifford has given an eloquent and at times harrowing description of the lot of the passionate and driven sole inventor. His single minded commitment to his invention is beyond question.
- 41 He has argued passionately that his intention throughout the whole process of trying to obtain a granted patent in the UK is quite clear. Why after all the struggles he describes so well would it be anything else? He asked at one point in his submissions on some of the previous case law he referred me to “*why if the proprietors are not intent on prosecuting their patent applications, why have they bothered to go to all the time, trouble and expense of attorneys, preparations, applications etc?*”.
- 42 It is a fair question, but not one which delivers the answer with regard to the outcome of the correct consideration of s.20A.
- 43 What Mr Clifford’s question goes to in fact is an assessment of the surrounding circumstances to those cases he refers to and which resonate with him so much. In many of the cases he refers to, the surrounding circumstances – as they are in his own case – are highly unfortunate, often beyond the control of the applicants and clearly unintentional.
- 44 However, as I have said, it is not the unintentional nature of the surrounding circumstances, but whether the *failure to comply* in each case was unintentional.
- 45 The facts in this case are clear. The effects of the circumstances Mr Clifford has described obviously had a debilitating effect on him and his ability to prosecute his patent application. However, Mr Clifford has always been clear, unequivocal and honest in his evidence that since January 2009, he knew that the date by which he had to apply for entry of his patent into the UK national phase was 7 July 2009.
- 46 Despite everything, he knew that was the date and he knew what he had to do by that date. Mr Clifford argues that although he accepts in other decided cases this knowledge has led to a finding that the failure to comply was unintentional, his case is distinguished by the fact that because of his confused mental state, he never found out that the actual cost of entry into the UK national phase was only £30.
- 47 This was never beyond his means and had he have known, he would certainly have paid it.
- 48 I asked him at the hearing that given the time and effort he has clearly spent in researching e.g. whether the PCT route was best for him in applying for a patent and in researching this application for reinstatement, why he didn’t find out the cost of entry into the UK national phase? There were several accessible ways he could have done this. Mr Clifford’s response was that in hindsight he can see

that this would have saved everything, but this was another illustration of his state of mind at that crucial time.

49 Nevertheless, the fact remains that Mr Clifford did not find out that vital piece of information and the fact remains he failed to comply because he believed he could not pay. Mr Clifford's submissions about the actual cost of entry into the UK national phase are therefore hypothetical and as such cannot inform my judgment.

50 Following *Anning* (BL O/374/06) it is established that a demonstration of underlying intention will not necessarily be followed by a finding that the failure to comply was unintentional. I have no doubt that Mr Clifford had a deep underlying intention to prosecute his patent to grant. As he argued, why would he have put himself through all the pain and heartache if he did not have that intention? Why would he have applied for reinstatement if that wasn't still his intention?

51 I appreciate sentiment behind the question, but if that were the determining factor, a mere application for reinstatement (or restoration under s.28) would serve to satisfy the statutory tests. That clearly cannot be the case.

52 What was the reason behind the *failure to comply* in not requesting entry into the UK national phase on time? It is clear. It was a lack of funds. Albeit as it transpired a perceived lack of funds, it led directly to the failure.

53 By the time the deadline for payment of 7 July 2009 was upon him and worn down by the mental maelstrom of his experiences of trying to obtain sufficient funding and trying to negotiate the unfamiliar patenting procedure etc, Mr Clifford believed he could not pay the fee for UK national phase entry and he did not pay.

54 Mr Clifford argues that because of the stress he was under, his state of mind was such that this was "*not a conscious decision, it was a non action couched in desperation*". However, the evidence is clear that nonetheless this fatal non-action was based on a knowledge of what he had to do and by when.

55 Having carefully considered all the arguments, I find that despite his underlying intention to enter the patent application in suit into the UK national phase and despite his on-going attempts to secure finances to do this, Mr Clifford's final decision not to comply with the deadline set under Section 89A(3) and Rule 66(1)(b) was a conscious one based albeit on his ill-informed knowledge of his inability to pay the necessary fee. As such the failure to comply was not unintentional.

## **Conclusions**

56 I genuinely have much sympathy with Mr Clifford, but of course I have to make a determination based on the facts and how they apply to the law. I cannot take into consideration what he might have done had he availed himself of the true fact of the cost of entry into the UK national phase.



57 This makes this decision all the more unfortunate. Mr Clifford made passionate pleas about the devastating effects the loss of this patent would have on him, but he stated in his evidence and at the hearing that he fully appreciates the reason behind the necessity for statutory procedures he and every other patent applicant has to operate under.

58 I found Mr Clifford to be a highly intelligent, resourceful and passionately driven man who has the ability to learn from the lessons of this unfortunate experience. He also told me that he has many other inventions in the pipeline.

59 I conclude with regret that because Mr Clifford was fully aware of his inability to comply with the requirements of Section 89A(3) and Rule 66(1)(b) because of his lack of funds, that his decision not to comply was *not unintentional* as required by Section 20A(2) of the Act. I therefore refuse his request to reinstate his application.

### **Appeal**

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

**G J Rose'Meyer**

Hearing Officer acting for the Comptroller