



PATENTS ACT 1977

APPLICANTS Jiri George Frank Krizek and Jan David Krizek

ISSUE Whether the request to reinstate patent application
 number GB0901538.9 has been filed in time under
 Rule 32(1) and if so should it then be reinstated
 under Section 20A

HEARING OFFICER A. R. Bushell

DECISION

Introduction

- 1 Patent application GB0901538.9 entitled 'Electromagnetic Imaging Analyser' was filed on 30 January 2009 in the names of Jiri George Frank Krizek and Jan David Krizek.
- 2 On 14 October 2009 the application was published as GB2459005. Following publication, on 20 November 2009, the applicants filed a Form 51 to remove Brookes Batchellor as their address for service. It was from this date they took responsibility for processing the application themselves.
- 3 The request for substantive examination was filed on 12 April 2010 and the examiner issued her first examination report on 31 January 2012 raising a number of objections against the application.
- 4 The applicants filed their response by e-mail on 29 March 2012 to which the examiner responded by e-mail on 02 April 2012. In her response the examiner gave an informal view but asked the applicants to re-file their submissions by letter so she could respond formally.
- 5 On 21 May 2012 the applicants filed their formal response. Following consideration of the points raised in this response the examiner issued a further examination report on 11 February 2013 maintaining her objections to the application. The examination report informed the applicants that due to the delay in issuing her report the compliance period for putting their application in order for grant had been extended to 30 April 2013.
- 6 No response was received from the applicants either by the date given in the examination report or by the extended compliance period. Therefore the application was terminated on 01 May 2013 for not being in order for grant. A letter was sent to

the applicants informing them of this on 22 July 2013 which prompted them to respond on 21 August 2013.

- 7 The response from the applicants included a request for more time to put their application in order as they had been busy with other work. They informed the Office they would be busy until mid September with a tender preparation and would appreciate more time to 're-phrase the patent so that it is acceptable'.
- 8 The Office wrote to the applicants on 28 August 2013 confirming that the application had been terminated and explained the process for applying for reinstatement. The letter outlined the possible timescales in which the applicants needed to apply for reinstatement.
- 9 No further communication was filed by the applicants until they e-mailed the examiner directly on 29 April 2014. In their e-mail the applicants explained the late response to the examination report was due to illness but they were now in a position to respond. They also asked the examiner to confirm whether the 01 May 2014 deadline given in the previous official letter was the deadline for responding to her latest report.
- 10 In her response the examiner clarified that the 01 May 2014 was the final date by which the applicant could apply to reinstate their patent application. She explained that no response to the examination report could now be considered unless the application was successfully reinstated.
- 11 According to the Office, the application for reinstatement was not received until 06 May 2014, so an official letter was sent to the applicants on 12 June 2014 informing them that they were too late to apply for reinstatement under the provisions of rule 32(1)(b) and that this date is not extendable. The applicants were given the opportunity to request a hearing on this matter.
- 12 A hearing was requested and held before me via telephone on 07 August 2014. Prior to the hearing the applicants filed skeleton arguments which focused on *restoring* their patent under section 28 of the Patents Act rather than *reinstating* it under section 20A. At the hearing I explained they needed to make a case for reinstatement rather than restoration and gave them the opportunity to adjourn the hearing for seven days to reconsider their case. I informed them that not only did they need to prove the failure to put the application in order for grant was unintentional, but before that, they would also need to make submissions on why they believed the application for reinstatement was filed in time, as the Office had deemed it to have been filed late. The applicants welcomed the opportunity to adjourn for seven days and the hearing recommenced on 14 August 2014.

The evidence

- 13 The evidence filed by the applicant in support of the application for reinstatement comprised of the following:
 - Section 4 of the Form 14 was completed explaining why the applicant failed to respond to the examination report on time. The reason cited was the medical problems experienced by Jiri Krizek. Mr Krizek was a managing director of a

small company and whilst he was ill there was little financial or personnel buffer in place to ensure the work of the company was carried out and that his other interests, e.g. the patent application was attended to.

- As mentioned earlier in this decision, evidence was filed in the form of the applicants' original skeleton arguments submitted before the hearing on 07 August 2014. Although the skeleton arguments were based on applying for restoration, I considered part of the accompanying evidence to be applicable for supporting the applicants' case for reinstatement as it addressed the test of 'unintentional', which applies to both restoration and reinstatement applications. The evidence submitted included a letter from Jiri Krizek explaining the reason they did not respond to the examination report was because of his ill health. He had initially hoped his wife Hana Krizek could prosecute the application as the co-applicant Jan Krizek, was not skilled enough to do so. However, between January 2013 and July 2014 Jiri Krizek's health deteriorated again which required Hana Krizek to take care of him and also look after his business. It was at this point where the business suffered financial difficulties and Hana Krizek spent the majority of her time securing funds for the company. Along with the letter, Jiri Krizek filed further evidence of his health problems. This included several letters from various medical professionals confirming that Mr Krizek suffered from a heart problem which in turn led to a severe sleep disorder.
- In preparation for the reconvened hearing on 14 August 2014 the applicants filed skeleton arguments on the issue of whether the application for reinstatement was filed on time. The applicants claimed they were incorrectly informed by a member of the Office's staff by telephone that it would be acceptable to file the Form 14 before 01 May 2014 and then pay the £150.00 fee sometime afterwards. The applicants provided dates and times of these phone calls but could not recall the name of the IPO member of staff who actually gave them this alleged information. It is stated in the evidence filed that the Form 14 was e-mailed and posted to the Office on 30 April 2014 and the applicants specifically instructed their bank to make the relevant payment of £150.00 on 06 May 2014. Various transactional records from the bank and an e-mail from their bank manager have been filed as supporting evidence of this.
- At the hearing Jiri Krizek confirmed the failure to respond to the examination report was due to his ill health and it was only around the time they filed their application for reinstatement did he feel well enough to continue with this patent application. He reiterated that he felt he was misguided by IPO staff regarding the date they had to make the payment for the application for reinstatement. He alluded that as this was a procedural irregularity made by the Office then their reinstatement application should be deemed to have been filed on time. Mr Krizek could not remember which member of staff gave him this incorrect information, but when I presented him with two names from the official case dossier with whom I could see he had previously spoken, he said it may have been one of them, but could not be certain.

The law

- 14 The provisions for reinstatement of patent applications are set out in Section 20A of the Act and Rule 32 of the rules. The relevant parts of Section 20A state:

Section 20A. – (1)

Subsection (2) below 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

(2).....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

(3) – (9)

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 a 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.

The issues

- 15 In effect the first determination to be made under s.20A is whether the reinstatement request complies with the requirements of Rule 32.

- 16 In order to do this, the first issue I need to determine is to identify the applicants' specific failure to comply with a requirement of the Act or rules within a time limit which had the direct consequence that the application was either refused or treated as having been refused or withdrawn.
- 17 Having established this, I then need to determine whether the request for reinstatement complies with the requirement of rule 32(1) to be filed within the time periods prescribed by that rule.
- 18 Only if I determine it was, do I then need to decide whether the failure to comply was unintentional under s.20A (2) (c).

The arguments

What was the failure to comply?

- 19 The application was terminated on 01 May 2013 as a consequence of the applicants' failure to put the application in order for grant by the end of the compliance period set by rule 30(2). In this case the compliance period expired on 30 April 2013 and the application was held not to be in order on this date.
- 20 These facts have not been disputed by the applicants although they have provided mitigating factors in their written evidence and also orally at the hearing on 14 August 2014. Therefore my finding here is that the failure of the applicants was in not putting their application in order for grant by the due date of 30 April 2013.

Was the request for reinstatement filed in time?

- 21 At the hearing the applicants claim to have filed their Form 14 on 30 April 2014, but did not pay the £150.00 fee until 06 May 2014. Following the hearing it has come to my attention that the Office does not have any record of the Form 14 being received by e-mail on 30 April 2014. The only form that appears to be on the file is the Form 14 received by the Office on 02 May 2014. As the fee was not paid until 06 May 2014 the application was therefore deemed by the Office to have been filed on that date.. The issue of whether this meets the requirements of rule 32(2) has to be established before I can go any further.
- 22 Rule 32(1) prescribes that the request must be made before the end of the relevant period. Rule 32(2) then sets out the relevant period as the first to expire of two possible options. These are:
 - Rule 32 (2)(a) which prescribes that the request shall be made before the end of 'two months beginning with the date on which the removal of the cause of non compliance occurred' and
 - Rule 32 (2)(b) which prescribes that the request shall be made before the end of 'the period of twelve months beginning with the date on which the application was terminated' if that period expires earlier.
- 23 All the evidence the applicants presented points to the fact that the cause of their non-compliance was Jiri Krizek's medical problems. At the hearing Jiri Krizek confirmed that he was still experiencing these problems and it was only at around

the time of filing his application for reinstatement did he feel well enough to continue with the patent application.

- 24 If I were to take the evidence at face value, and I have no reason not to, then 30 April 2014 is the date of the removal of the cause of the non-compliance, as this is the date the applicants posted their Form 14 to the Office. Under rule 32(2)(a) the request for reinstatement must then be made within two months of this date. This would put the date referred to in rule 32(2)(a) by which the request had to be made by as 30 June 2014. The request in this case was deemed by the Office to have been made on 06 May 2014 which is clearly within the time period referred to in that rule.
- 25 However, the relevant date must be the *earlier* of the two options prescribed in rule 32 and rule 32(2)(b) sets out the relevant period as 'the period of twelve months beginning with the date on which the application was terminated'. In this case the application was terminated on 01 May 2013 which means that under rule 32(2)(b) any application had to be made by 01 May 2014. As this is earlier than the date I have found under rule 32(2)(a) above, I find that 01 May 2014 is the deadline by which the application for reinstatement needed to have been filed.

The Office's view

- 26 The Office's view is that the application for reinstatement has been filed late. Although the Form 14 was posted to the Office on 30 April 2014 according to official records it was not received until 02 May 2014. In addition to this the £150.00 fee was not received until 06 May 2014. The Office therefore deemed the effective date of the form being filed as 06 May 2014.
- 27 As the 06 May 2014 falls outside the time period for filing reinstatement under rule 32(2)(b) then if the Office is correct, the application must be deemed to have been filed late.

The applicant's view

- 28 At the hearing the applicants claimed that they e-mailed and posted the form to the Office on 30 April 2014 but waited until 06 May 2014 to pay the £150.00 fee.
- 29 In their evidence the applicants claim they were informed by someone at the IPO that provided they filed their Form 14 before the 01 May 2014 they could pay their fee sometime after and still be deemed to have filed their application for reinstatement on time.
- 30 They provided dates and times of the telephone conversations they claim to have been given this information (i.e. on either 29 or 30 April 2014) but they cannot recall which member of IPO staff they spoke with. At the hearing I suggested two names they had spoken with previously regarding their patent application and asked if it could be either of them. The response was inconclusive. Although they stated that it could possibly have been one of them, they were not 100% sure.
- 31 Their argument was that the Office was guilty of a procedural irregularity by incorrectly informing them that they could pay their fee after the 01 May 2014 and

that because of this irregularity the Office should deem their application for reinstatement to be filed on time. This argument in effect goes to rule 107.

Analysis

- 32 Clearly the first thing I need to determine is what date was the application for reinstatement of the patent in suit actually filed? The two possible options as argued by the Office and the applicants are set out above.
- 33 In my view the answer is very clear. Under the Patents (Fees) Rules 2007 (as amended) rule 2 states:

Use of a form

2.—(1) Except where any of rules 3 to 7 apply, the fees to be paid in respect of any matters arising under the Act are those specified in Schedule 1.

(2) Where a form—

(a) is required to be used by the 2007 Rules; and

(b) is specified in Schedule 1 as the corresponding form in relation to any matter,

that form must be accompanied by the fee specified in respect of that matter.

[Emphasis added]

- 34 The applicant claims that the form was filed by e-mail on 30 April 2014, prior to the 01 May 2014 deadline, whereas the Office claims to have only received the posted copy of the form on 02 May 2014 which falls after the deadline.
- 35 In either case the law clearly establishes that whether the Form 14 arrived in the Office on 30 April 2014, or the 02 May 2014, the form must be taken to have been filed on 06 May 2014 when the £150.00 fee was filed.. As such it does not comply with the requirement of the Patents (Fees) Rules 2007 (as amended) under rule 2(2).
- 36 As such I find that the application for reinstatement was filed on 06 May 2014 and as such outside the period set by rule 32, specifically rule 32 (2)(b).
- 37 As stated in the official letter dated 12 June 2014, that period is not extendable. That is prescribed in Schedule 4 in the Patent Rules 2007:

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)
[Emphasis added]

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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38 However, the applicants' arguments regarding being misinformed as to how and when to file their Form 14 and fee go to rule 107 as stated above. That rule says:

r107.—(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.

39 It can be seen that under rule 107 (3) offers an exception to the non-extendable periods listed in Part 1 of Schedule 4 (rule 32(1) is one of those listed), but "...if, and only if –" the provisions of rule 3 (a) and (b) are met.

Has a procedural irregularity occurred?

40 Although the applicants provided verbal evidence to support their argument they were unable to provide any other evidence showing that the Office informed them they could pay their £150.00 fee late.

- 41 The applicants have provided telephone records and when prompted gave an indication of the names of two people who may have been the person who gave them the wrong information. However, these conversations occurred over 17 months ago and after investigations, I have found the Office does not have a record of what was said during those calls. This is not unusual in that the Office does not routinely record all telephone calls.
- 42 It seems to me that two key documents in this argument are the official letter sent to the applicants on 28 August 2013 and the examiner's response to the applicants' e-mail enquiry dated 29 April 2014.
- 43 The Office's letter dated 28 August 2013 categorically states that as a condition for applying for reinstatement you must meet a number of key criteria. One of the criteria listed in this letter under point iv) is that "the request must be made on a Patents Form 14 (enclosed) which you should complete and return to this Office *with a fee of £150*" [emphasis added].
- 44 The other important document is the examiner's response to the applicant's e-mail dated 29 April 2014. The applicant had e-mailed the examiner to enquire what they needed to do in relation to the 01 May 2014 deadline. The examiner's response advised them to visit the IPO online document inspection site ("Ipsum") where they could once again view the letter sent to them on 28 August 2013.
- 45 It is my view that by reading the first of these letters it should have been clear that the applicants needed to file the fee with the form for the application for reinstatement to be deemed to have been filed. However, in the circumstances described to me at the hearing and in evidence regarding Jiri Krizek's illness and the time lapsed after that letter was sent, I can understand how that important piece of information may have been forgotten. However, I am less sympathetic to the circumstances surrounding the examiner's reply to the applicant's e-mail dated 29 April 2014. The applicant had specifically asked the examiner a question about the significance of the date of 01 May 2014 deadline and the examiner had clearly replied to that question and clarified that that was the date by which the application for reinstatement had to be filed. The examiner had further included a link to the patent via the IPO Ipsum web pages and referred specifically to the "the letter outlining the conditions for reinstatement".
- 46 It is unclear from the evidence whether the applicants visited that web site or not, but it is clear that all the information they required to file the reinstatement on time was within the official records. Given that the applicants had made a specific enquiry to the examiner, it is reasonable to expect that they will have noted the examiners response to their question.
- 47 The applicants argue that they were given the wrong advice via a telephone call made to the Office on 29 or 30 April 2014, but unfortunately for the applicants the only concrete evidence I have to make my judgement on whether a procedural irregularity has occurred is the letter dated 28 August 2013 and the examiners reference to it via her email of 29 April 2014. Whilst I have much sympathy with the circumstances the applicants were in, on balance I simply have not been presented with sufficient evidence to support their arguments about being misinformed about the date for filing the fee for reinstatement in the face of the official documentation

the applicant was sent and reminded about. This documentation set out the position very clearly.

- 48 It is because of this that I must conclude that no procedural irregularity has occurred and the application for reinstatement was therefore filed out of time.

Conclusion

- 49 As I have said, I have considerable sympathy with the applicants in this case both with respect to their patent application and Jiri Krizek's ongoing health problems. However, in waiting until the very last minute to file their reinstatement application they only gave themselves a small window of time to provide the Office with both the form and fee required. By not paying the fee until 5 days after the deadline the applicant fell outside the time period prescribed by rule 32(2)(b) for filing their application for reinstatement.
- 50 I must therefore conclude that the application for reinstatement does not comply with the requirement of the rules in being filed on time, therefore the application is refused.
- 51 In these circumstances, I do not therefore need to consider whether the failure to comply was unintentional.

Appeal

- 52 Any appeal must be lodged within 28 days.

Mr A. R. Bushell
Hearing Officer acting for the Comptroller