



PATENTS ACT 1977

APPLICANT Rytons Building Products Limited

ISSUE Whether rule 107 can be used to un-revoke
GB2588834 due to the conditions of Section 73(1C)
not being fulfilled

HEARING OFFICER Andrew Bushell

DECISION

Introduction

- 1 This decision concerns whether a procedural error caused patent number GB2588834 to be revoked and whether the provisions of rule 107 can be used to cancel the revocation and bring the patent back into force.
- 2 Application GB1916812.9 was submitted by Rytons Buildings Products Limited on 9 December 2019, claiming priority from the applicant's earlier application GB1916157.9 filed on 6 November 2019. This latest application was entitled "A cavity weep hole duct made of metal" and was subsequently granted on 6 April 2022.
- 3 On the 5 July 2022 the comptroller issued an opinion concluding the patent was invalid. A letter was subsequently e-mailed to the proprietor's attorney on 9 February 2023 warning them that their patent may be revoked under section 73(1A) of the Patents Act if they did not file amendments or submit observations within a month. No response was received, so the comptroller issued a decision on 29 March 2023 revoking the patent. A copy of the decision was sent to the applicant's attorney by e-mail and by post.
- 4 It is claimed by the applicant that neither the letter dated 9 February 2023, nor the decision dated 29 March 2023 were received by their representatives. As a result, they have since contacted the IPO to explore what options are available to cancel the revocation.
- 5 The provisions relating to reinstatement, restoration and communication failure were considered, but could not be used in this scenario. The applicant has therefore claimed that as the conditions set out in Section 73(1C) were not fulfilled a procedural error took place and the comptroller should use his powers under rule 107 to un-revoke the patent.

The Law

- 6 Section 73(1A) of the Patents Act 1977 sets out certain conditions under which the comptroller may revoke a patent on their own initiative.

s73(1A) Where the comptroller issues an opinion under section 74A that section 1(1)(a) or (b) is not satisfied in relation to an invention for which there is a patent, the comptroller may revoke the patent.

- 7 Section 73(1C) of the same Act provides further parameters.

s73(1C) The comptroller shall not exercise the power under subsection (1A) without giving the proprietor of the patent an opportunity to make any observations and to amend the specification of the patent without contravening section 76.

- 8 Rule 107 of the Patents Rules 2007, which relates to the correction of irregularities of Office procedures states:

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)

(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.

Arguments

- 9 At the hearing the attorney argued that rule 107 should be used to cancel the revocation of the patent as the conditions set out in section 73(1C) had not been met. They argued that as the applicant failed to receive both the letter dated 9 February 2023 and the decision dated 29 March 2023, they did not have the opportunity to make any observations or amendments afforded to them under s73(1C), and as such the patent should not have been revoked. They claim the revocation was therefore a procedural error which should be cancelled using the provisions set out under rule 107, so the Office may consider the post grant amendments submitted on 8 December 2023.
- 10 Prior to the hearing the Office investigated whether it had erred when issuing either the letter dated 9 February 2023, or the decision dated 29 March 2023. In both cases no errors could be found. Our patents e-mailing tool confirmed that both the letter and decision were delivered to the correct e-mail address provided by the attorney. The Office also has evidence the decision was delivered by Royal Mail special delivery, as this was signed for by the reception area used by the attorney firm. At the hearing the attorney accepted the decision had been received by their reception area but was unable to explain what had happened to it from this point onwards. It seemed likely that as the reception was shared by many other offices it may have been misplaced when sorting the mail. They mentioned that the location at which

their Office was based is also prone to internet outages which may explain why they failed to receive both communications sent by e-mail.

- 11 Whilst I have sympathy with the attorney firm not receiving either piece of correspondence, any procedural errors which caused these discrepancies lay with them rather than with the IPO. Therefore, the question is whether rule 107 can be used to correct irregularities in procedures at an attorney firm, or alternatively those which are caused by communication failure.
- 12 Neither I, nor the attorney could find any previous case law where rule 107 had been used under such circumstances. Therefore, I need to interpret the rule myself to understand whether the provision can be used in this way.

Analysis

- 13 Rule 107(1) allows the comptroller to correct any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner, or the Patent Office. However, rule 107(3) only permits the comptroller to extend any period set out in the Act, or in Parts 1 to 3 of Schedule 4 of the Rules, if the irregularity is attributable, wholly or in part, to the Office.
- 14 There are two issues here. One, the deadline in the 9 February 2023 letter is a time period specified by the Office, which isn't prescribed in the Act or Rules. This appears to prevent me using rule 107 to extend the period under s73(1C) for filing observations or saving amendments to prevent the s73(1A) action. However, even if I am wrong on this the use of rule 107(3) does not appear to be applicable under these circumstances as the irregularity discussed above cannot be attributed to the Office in any way.
- 15 In addition to this there are specific provisions in our legislation to help attorneys when they have made an error, e.g., rule 108, or when there has been a failure in a communication system, e.g., rule 111. The fact we have these provisions lends me to think that rule 107 should not be used for these same purposes, otherwise their would-be little point in these specific provisions existing.
- 16 The final point to consider is whether s73(1C) can be used by itself to cancel the revocation of this patent. From the Office's perspective, it met its obligations under s73(1C) by sending the warning letter and subsequent decision to the attorney. In doing so it provided the applicant with an opportunity to file observations and/or amendments, therefore it is difficult to argue the conditions under s73(1C) were not met. Even if I were to be persuaded the IPO's obligations weren't met on this occasion s73(1C) of the Act does not appear to contain the vires to allow me to cancel the revocation. Such a remedy can only be carried out using the rules referred to earlier in this decision, none of which appear to be applicable here.

Conclusion

- 17 Whilst I am sympathetic to the applicant's position, I do not believe section 73(1C) or rule 107 can or should be used to cancel the revocation of GB2588834 and extend the period for filing saving amendments. To do so would make many of our specific provisions such as rule 108 and rule 111 redundant and provide applicants with a

relatively easy remedy to rely upon when they have erred in the processing of future applications or patents.

- 18 The patent should therefore remain revoked.

Appeal

- 19 Any appeal must be lodged within 28 days after the date of this decision.

ANDREW BUSHELL

Deputy Director, acting for the Comptroller