



PATENTS ACT 1977

APPLICANT	Derrick Norman Green
ISSUE	Whether patent number GB2525098 B should be revoked under section 73(1) and whether a request for reinstatement of patent application number GB1120247.0 under section 20A should be allowed.
HEARING OFFICER	B Micklewright

DECISION

Background

- 1 This decision concerns two patent applications. The first, GB 1120247.0, was filed on 23 November 2011 and published on 29 May 2013 as GB 2496873 A (“GB’873”). The second, GB1507654.0, was filed on 22 May 2013 under the provisions of the PCT, published as WO 2014/188144 A1 and granted on 28 December 2016 as GB 2525098 B (“GB’098”). The GB’873 application was subsequently treated as withdrawn and therefore terminated on 12 December 2013 for a failure to file Patents Form 10 requesting substantive examination of the application. The applicant requested reinstatement of this application on 27 September 2016 but this request was refused by the Office. Both applications were filed by Derrick Green (GB’873 in the name of “Derrick Norman Green” and GB’098 in the name of “Derrick Green”) and both are entitled “Equipment for use when sitting and when walking, skiing or the like”. Critically the later GB’098 application was filed after the expiry of the period for claiming priority from the earlier application and hence no priority was claimed.
- 2 Shortly after sending GB’098 on for grant the examiner discovered the earlier GB’873 application and took the view that this showed exactly the same invention as that of GB’098. Moreover she considered that the GB’873 application formed part of the state of the art under section 2(3) of the Patents Act 1977 (“the Act”). Once the application had been granted she subsequently initiated proceedings under section 73(1) to revoke the patent.
- 3 The applicant’s attorney, Mr Neville Walker, requested a hearing on the matter of the section 73 revocation and the matter was referred to myself and a hearing arranged for 20 June 2017. Shortly prior to the hearing he however filed submissions, including a witness statement from himself dated 13 June 2017 and an email dated 20 June 2017, which were more relevant to the request for reinstatement of the GB’873 application. At the hearing itself Mr Walker requested that I also consider the

matter of reinstatement of the earlier GB'873 application and I agreed to do so. It however emerged at the hearing that further supporting evidence may be relevant to this matter. I provided the applicant with an opportunity to file any such evidence or submissions within two weeks of the date of the hearing and further submissions in the form of a witness statement from Mr Green dated 3 July 2017 and a letter from Mr Walker dated 7 July 2017 were received on 7 July. Although this is slightly outside the period I specified for filing such evidence I will nevertheless consider this evidence in my decision. Although never explicitly argued, this evidence is also relevant to the question as to whether it is possible to extend the period for requesting substantive examination and I will also address that point.

The invention

- 4 Although, for reasons which will become apparent, the nature of the invention is not relevant to this case, I will however provide a brief summary. The invention claimed in claim 1 of both the GB '098 patent and the GB'873 application involves a pair of walking sticks whose top ends include seat members which may be attached together to form a seat which, together with the two sticks, forms a two-legged stool.

The law

- 5 Section 2 of the Act sets out when an invention can be taken to be new. The relevant provisions to the present case are:

2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.

...

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say –

(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.

- 6 Section 73(1) relates to the comptroller's power to revoke a patent when the invention for which the patent has been granted formed part of the state of the art by virtue only of section 2(3) above, and states:

73.-(1) If it appears to the comptroller that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 2(3) above, he may on his own initiative by order revoke the patent, but shall not do so without giving the proprietor of the patent an opportunity of making any observations and of amending the specification of the patent so as to exclude any matter which formed part of the state of the art as aforesaid without contravening section 76 below.

- 7 The law governing reinstatement is set out in Section 20A of the Act:

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) Subject to subsection (3) below, 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 rules; and

(c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.

- 8 The period for applying for reinstatement is prescribed by Rule 32 of the Patents Rules 2007. The provisions of Rule 32 changed on 1 October 2016 and it is the provisions prior to this date which are relevant in this case. Prior to 1 October 2016, Rule 32 stated:

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.

- 9 Rule 108 provides for the extension of certain time periods in certain circumstances. Rule 32(1) is however listed in Part 1 of Schedule 4 of the rules as one of the periods of time that cannot be extended under rule 108. The period for requesting substantive examination of an application is prescribed in rule 28 and may be extended under rule 108 but such an extension must be made within two months of the expiry of the period, or the expiry of the period as previously extended.

- 10 Rule 111 concerns delays in communication services and rule 111(1) states:

111.—(1) The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

Assessment

Revocation of the GB'098 patent

- 11 The contents of the GB'098 patent are word-for-word identical to those of the earlier GB'873 application with the exception that the GB'098 patent does not have an omnibus claim which was present in the GB'873 application. Moreover the GB'873 application clearly falls within the definition of the state of the art provided in section 2(3) of the Act in relation to the GB'098 patent, being published after the priority date of the patent but with an earlier priority date. Mr Walker conceded these points at the hearing.
- 12 It is therefore apparent that, in accordance with section 2(3) of the Act, patent application GB'873 forms part of the state of the art in the case of the invention to which GB'098 relates. The invention to which the patent relates cannot therefore be taken to be new. Section 73(1) of the Act gives the comptroller powers to revoke such patents on his own initiative. I note that in her letter dated 5 January 2017 the examiner provided the proprietor with an opportunity to make any observations or to amend the specification of the patent (in fact the examiner gave a similar opportunity prior to the grant of the patent in her letter dated 22 July 2016) and the proprietor has had a further opportunity to do so at the hearing.
- 13 Given the similarity between the specification of the prior art document and the specification in suit it is apparent that the whole disclosure of the patent in suit formed part of the state of the art and therefore no amendment is possible to exclude such matter. I therefore conclude that the patent should be revoked.

Reinstatement of the GB'873 application

- 14 I now turn to the question of whether the request to reinstate GB'873 should be allowed. In order to allow the request I must be satisfied that the request for reinstatement was filed within the relevant period prescribed by rule 32 and that the failure to request substantive examination of the application within the period prescribed by the rules was unintentional.
- 15 Starting with the question of whether the request for reinstatement was filed within the relevant period, I note that rule 32 in the form it was in on 27 September 2016, the date reinstatement was requested, specifies the relevant period as two months beginning with the date on which the removal of the cause of non compliance occurred or, *if it expires earlier*, the period of twelve months beginning with the date on which the application was terminated.
- 16 Mr Walker sought to convince me that the definition of the time limit in the rule should be interpreted as defining the limit as the *greater* of 12 months from termination and 2 months from the removal of the cause of the failure to comply, or at least that the rule was ambiguous on this point. The cause of the failure, he argued, was Mr Green becoming unaware that that the Form 10 had not been filed on GB'873, the usual reminder letters having been sent to his original attorney who by that date was deceased. Mr Green was effectively made aware of the situation by the Examiner's letter of 22 July 2016, received 27 July 2016 according to Mr Walker's witness statement, and so 27 July 2016 should be considered the date on which the cause of not compliance was removed. The request for reinstatement via Form 14 filed on 27 September 2016 should, Mr Walker argues, therefore be considered to have been filed within the period prescribed by rule 32(2).

17 Unfortunately, I cannot agree with this line of reasoning. In my view the rule is very clear that when the twelve month period from when the application is terminated expires earlier than the two-month period following the removal of the cause of noncompliance, the request for reinstatement must be filed within that twelve month period. The application was terminated on 30 November 2013, nearly three years before the date reinstatement was requested. If I take Mr Walker's submission on the date of the removal of the cause of non compliance being 27 July 2016 then it is therefore the twelve month period which is relevant here. The request for reinstatement was clearly made outside this period. Even if I concluded that Mr Walker was wrong as to the date of the removal of the cause of non compliance there is no possibility that the request for reinstatement could have been filed within the period prescribed by rule 32, whatever date I concluded that the removal of the cause of non compliance may be.

18 Mr Walker submitted that the request for reinstatement should be allowed because Mr Green never received the Office's letter of 12 November 2013 reminding him of the need to request substantive examination. This letter is more relevant to the failure to request substantive examination and I will consider this in my decision as well as the request for reinstatement. In his witness statement Mr Green said:

"I met Mr Walker again on 01 July 2017. Mr Walker showed me a copy of a letter dated 12 November 2013 from the UK IPO (item 4), and asked me if I recalled seeing it. I told him that I had never seen it."

19 Mr Walker said in his letter of 7 July 2017:

"I have no way of knowing whether the failure to file Patents Form 10 was a consequence of "failure in the communication service" between the IPO and the previous agent; or was due to a "failure in the communication service" between the previous agent and the Applicant."

20 The provisions of rule 108 cannot be used to extend either the period for requesting reinstatement or, in the present circumstances, the period for requesting substantive examination. The only possibility for extending either period is that Mr Green did not receive the Office's letter of 12 November 2013 because there was some delay in, or failure of, a communication service in accordance with rule 111, and that the failure to do that thing was "wholly or mainly attributable" to the failure of this communication service. The letter was addressed to Mr Green's former attorney who, according to Mr Green's witness statement, passed away in September 2014. In an email dated 29 April 2013 Mr Green's former attorney discussed the PCT application (which had not at that point been filed) and also said that "Because of my health problems, I am trying to wind down my patents practice." In an email dated 20 November 2012 his former attorney said:

"Then, if you wish to proceed further with your application, it will be necessary to request substantive examination and pay an examination fee within six months after the publication date, so provisionally by 23 November 2013. The cost at this stage will be £250. Please make a note in your diary about this for 23 October 2013."

21 I have some sympathy for Mr Walker's point of view in terms of the difficulty in determining what happened to the letter of 29 April 2013 given the circumstances. But it seems to me to be more likely than not, given his former attorney's

circumstances at the time, that the letter was delivered to the address listed as the address for service for the application but that it was never passed on to Mr Green, rather than it not being received because of some failure of a communication service. Moreover it is not clear that the failure to request substantive examination was “wholly or mainly attributable” to the failure to receive this letter. Mr Green was made aware of the deadline for filing the form in an email from his former attorney dated 20 November 2012 and was even asked to make a note in his diary. I therefore conclude that, on the balance of probabilities, the failure to request substantive examination for the application within the prescribed period was not “wholly or mainly attributable to a delay in, or failure of, a communication service”. Rule 111 cannot therefore be applied in the present case to extend the period prescribed for requesting substantive examination. These arguments also apply to the period for requesting reinstatement. In addition I would add that at the time the official letter of 12 November 2013 was sent the application was still live and the letter did not mention reinstatement at all, adding to the argument that the failure to request reinstatement was not wholly or mainly attributable to the failure to receive this letter.

- 22 There are no further provisions available by which to extend either the deadline for requesting substantive examination or the deadline for requesting for reinstatement. The request for reinstatement cannot therefore be allowed.
- 23 In reaching this conclusion I make no finding as to whether the removal of the cause of non-compliance did in fact occur on 27 July 2016 as it is not necessary to resolve this question in order to decide whether the request for reinstatement was filed within the relevant period. I also note that the change to rule 32 made on 1 October 2016 simplified the relevant period to a single requirement of 12 months from the date of termination of the application. In the present case the request for reinstatement would also have failed had it been considered under the revised version of the rule.
- 24 Since I have found that the request for reinstatement was made outside of the prescribed period I need not consider whether the failure to request substantive examination was unintentional. Mr Green seems to suggest in his witness statement dated 3 July 2017 that he intended to continue with the application and pay the fee for substantive examination, but I do not decide this point.

Conclusion

- 25 I have found that the invention claimed in patent GB 2525098 B (the GB’098 patent) and all subject matter disclosed in the patent forms part of the state of the art by virtue of section 2(3) of the Act. The invention cannot therefore be taken to be new and, in accordance with the provisions of section 73(1) of the Act, I therefore order that the patent be revoked.
- 26 I have also found that the request for reinstatement of patent application GB 1120247.0 (the GB’873 application) was not made within the period prescribed by rule 32, and that it is not possible to extend this period. I therefore refuse this request for reinstatement.

Appeal

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

Ben Micklewright

Deputy Director, acting for the Comptroller