



PATENTS ACT 1977

APPLICANT	Peter David Hurley
ISSUE	Whether the request to reinstate patent application number GB1205845.9 has been filed in time under Rule 32(1) and if so should it then be reinstated under Section 20A
HEARING OFFICER	Mr G. J. Rose'Meyer

DECISION

Background

- 1 Patent application GB1205845.9 entitled 'Multiple Material Removal Devise' was filed on 31 March 2012 in the name of Peter David Hurley ("the applicant").
- 2 On 14 April 2012 the IPO ("the Office") issued a preliminary examination report notifying the applicant that the search fee must be paid and an abstract must be filed on the application by 2 April 2013. This report was issued to the applicant's registered address and address for service on the application of '118-119 Stafford Street, Walsall, WS2 8DX'. This address is important to these proceedings as will become apparent later in this decision.
- 3 The abstract was filed by the applicant on 27 September 2012 and the Patents Form 9A requesting search on the application and its relevant fee was submitted on 29 January 2013.
- 4 On 20 May 2013 the patent examiner issued a Search Report under section 17 of the Act. This too was sent to applicants registered address of '118-119 Stafford Street, Walsall, WS2 8DX'.
- 5 The applicant was notified by the Office on 2 September 2013 that his application would be published on 2 October 2013. This letter was also addressed to the same Walsall address.
- 6 The next event recorded on the official electronic case file for this application occurred on 18 March 2014 when the office wrote to Mr Hurley, again at the Walsall address, reminding him that he had not filed a Form 10 to request substantive examination of the application and that if he still wished to, he should do so by 2 April 2014. He was also told of the arrangements to extend that date if he so wished by filing a Form 52 and requisite fee.

- 7 The applicant, Mr Hurley, filed the Form 10 and paid the fee of £80.00 on 14 April 2014. Two days later the office wrote to Mr Hurley (to the same Walsall address) notifying him that unfortunately the Form and fee had been submitted too late as it was due by 2 April 2014 and as such if he wished to continue with the application, he would need to file a Form 52 and its fee in order to extend the period to file the Form 10 by two months. He was told he had until 2 June 2014 in which to file the extension of time request. No Patents Form 52 was received by the deadline of 2 June 2014.
- 8 The application was terminated with effect from of 2 April 14.
- 9 The office then wrote to Mr Hurley at his Walsall address in October 2015 notifying him that the office will be issuing a refund of £80.00 to his credit or debit card for the Form 10 he had filed because it had been filed too late and he had not filed a Patents Form 52 to request an extension of time on that period.
- 10 On 1 April 2016 Mr Hurley filed an application for reinstatement of the application on a Form 14.
- 11 After several rounds of correspondence between the office and the applicant, on 5 August 2016 the office notified Mr Hurley that having considered all the evidence and arguments he had submitted, a sufficient case for reinstatement had not been made and as such the office was minded to refuse the application on the grounds that it had been filed too late.
- 12 Mr Hurley originally requested a hearing on the matter, but subsequently changed his mind and asked that a decision from the papers filed on this case be made in lieu of a hearing.

The evidence and the facts

- 13 The evidence filed by the applicant in support of the application for reinstatement and the official responses relating to it revealed the following facts:
 - Mr Hurley had moved from his '118-119 Stafford Street, Walsall, WS2 8DX' address on 8 October 2012 to a new address of 'Flat 28, Lord Cromwell Court, Bradford Street, Hednesford, Staffordshire, WS11 5JT'.
 - He had asked the Hostel Manager at his previous address to forward any mail to his new address, but no mail relating to the patent application in suit was forwarded to the Hednesford address. Mr Hurley had also previously submitted his email address to the office. He said he had intended to notify the Office of his new address the next time he wrote to it after his move.
 - Responding to the preliminary examination report of 14 April 2012, Mr Hurley had filed his Form 9A with its fee on 29 January 2013 and had written his new (Hednesford) address on the Form FS2 (the fee sheet accompanying the Form 9A). He received official receipts (copies submitted) to both the Form 9A and the FS2 on 1 February and 6 February 2013 respectively, both addressed to the Hednesford address he had supplied on the FS2.

- After the preliminary examination report of 14 April 2012, Mr Hurley did not receive any of the official correspondence listed in the 'Background' to this decision. The only official correspondence he did receive were the two receipts in February 2013 for the FS2 and Form 9A.
- Mr Hurley reviewed the application "... in the winter of 2013". He found that the application had been published and subsequently filed his request for substantive examination by filing a Form 10 on 14 April 2014, which he thought was in time.
- Although Mr Hurley did not receive the letter of October 2015 notifying him of the refund against his late filed Form 10, he did receive an email to that effect on 27 October 2015. The £80.00 refund was transferred to Mr Hurley on 5 November 2015.
- Whilst in the process of finalising claims for the application, Mr Hurley noticed the case had been withdrawn and he requested reinstatement on 1 April 2016.

The arguments

The Office's view

- 14 The Office's view is that the application for reinstatement has been filed too late under the provisions of rule 32(2) and there is no ability under the law to extend that period for filing a reinstatement except if it can be proved that there has been an irregularity in procedure which can be attributed to the Office (rule 107 refers).
- 15 Through the evidence filed by Mr Hurley, the Office accepts he never received any of the official correspondence referred to in the 'Background' above which would have notified him of significant dates and time periods, but argues this was because he had not requested that his change of address from 8 October 2014 (to the Hednesford address) be officially recorded as his address for all official correspondence to be sent.
- 16 Although two receipts relating to a Form 9A and accompanying fee sheet (Form FS2) were sent to Mr Hurley's new address in February 2013, this was merely because he had written his new address on the FS2, but this did not amount to a request to change his address for all correspondence.
- 17 As such, the Office argues there had been no irregularity in procedure which can be corrected under the provisions of rule 107 and as such the objection to the late filing of the Form 14 to request reinstatement of the patent application in suit stands.

The applicant's view

- 18 Mr Hurley's view is that an irregularity attributable to the office had occurred because official correspondence was being sent to his old address when he had notified the Office of his new address by writing it on his FS2 on 29 January 2013.

- 19 His view was that given the Office had issued two separate receipts for the FS2 and the Form 9A to his new address, he had taken it that that the new address had been logged to his account number and application number, therefore giving a new permanent address for service.

The law

- 20 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 to be decided

- 21 In effect the first determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32.
- 22 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.
- 23 Having established this, I then need to determine whether the request for reinstatement complies with the requirement of rule 32 to be filed within the time periods prescribed by that rule and any other provisions which may impact on that rule. In this case Schedule 4 in the Patent Rules 2007, rule 107 and rule 49 need to be analysed too.
- 24 Only if I determine the application for reinstatement was filed in time, do I then need to decide whether the failure to comply was unintentional under s.20A (2) (c).

Analysis

What was the failure to comply?

- 25 The application was terminated with effect from 2 April 2014 as a consequence of the applicant's failure to file the Form 10 by 2 April 2014 or to file an extension of that period by filing a Form 52 by 2 June 2014.
- 26 These facts have not been disputed by the applicant.

Was the request for reinstatement filed in time?

- 27 The applicant filed his Form 14 requesting reinstatement on 1 April 2016.
- 28 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.
- 29 Looking at Rule 32 (2)(a), all the evidence points to the fact that the cause of non-compliance was clearly Mr Hurley's ignorance to the fact that his address for service was still recorded as the original Walsall address he had filed with his application on 31 March 2012.
- 30 While this led to the dispute over whether the change of address had indeed been requested or not (given it had been written on the FS2 accompanying the Form 9A

and both officially receipted to the new address), it is clear Mr Hurley was not aware that the official record of his address/address for service still reflected the Walsall address at the time he applied for reinstatement.

- 31 So if that was the cause of non-compliance, what rule 32(2)(a) requires is that I determine when the cause of that non compliance was removed.
- 32 It is clear from the evidence that Mr Hurley did not know his address/address for service was still recorded on the application as his Walsall address until after he filed his Form 14 requesting reinstatement on 1 April 2016. He was notified of this by an official letter dated 26 May 2016 which followed correspondence between the Office and Mr Hurley trying to establish the facts of the case before determining the application for reinstatement. That letter notified Mr Hurley that given he had moved from Walsall to Hednesford from 8 October 2012 and, in the Office's view, had never requested the Office to change official records to his new Hednesford address, the Office had correctly issued all correspondence to the Walsall address supplied on the original patent application filed on 31 March 2012.
- 33 The evidence points to the official letter of 26 May 2016 being the first time Mr Hurley was aware of the address situation. I therefore find that date to be the date the removal of the cause of non compliance occurred. It follows that in order to meet the requirements of rule 32(2)(a) Mr Hurley had to file his application for reinstatement within two months of that date. Given he had in fact filed it prior to 26 May 2016, on the face of it Mr Hurley has met the deadline in rule 32(2)(a).
- 34 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 'if it expires earlier, the period of twelve months beginning with the date on which the application was terminated'. Rule 32(2)(b) sets the maximum period by which an application for reinstatement must be filed.
- 35 In this case the application was terminated with effect from 2 April 2014 which means that under rule 32(2)(b) any application had to be made by 2 April 2015. As this is earlier than the date I have found under rule 32(2)(a) above, I find that 2 April 2015 is the deadline by which the application for reinstatement needed to have been filed.
- 36 Clearly it was not filed by that date, so does not meet the requirements of rule 32(2)(b).
- 37 But that is not the end of the story.
- 38 The period prescribed in rule 32 is not extendable. Schedule 4 in the Patent Rules 2007 says:

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)
.....

39 However, the applicant's arguments regarding the office sending official correspondence to the wrong address, thus causing him to file the Form 10 outside the permitted period go to rule 107. It is this rule that was tacitly referred to in the official letter dated 26 May 2016 when it was said "If this Office has made an error in the processing of your application which could have contributed to your failure to file the request for substantive examination [file the Form 10] within the time permitted it may have been possible to reinstate the application..." . That is one possible means by which the rule 32 period might be able to be extended.

40 Rule 107 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) 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.

- 41 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.

Was there any procedural irregularity in the way the Office dealt with this application?

- 42 As can be seen from my summary of the evidence above, the argument centres around whether Mr Hurley’s inclusion of his new address in Hednesford on the Form FS2 he filed in late January 2013 amounted to requesting the Office to change his address. Mr Hurley points to the fact that he did receive two official receipts in early February at his Hednesford address, suggesting to him that the address had been changed. The Office argued that writing an address on the Form FS2 accompanying the Form 9A did not amount to requesting it to be changed permanently. Because of this it was taken that Mr Hurley only wanted the receipts of his Form 9A sent to the address he had included with the filing of that form.
- 43 It is helpful at this point to explain what the Office’s procedures are on the filing a Form 9A with its fee. A Form 9A does not require an address to be entered on it. It asks for a reference number (“Your reference”) at Box 1, the patent application number (“if you know it”) at Box 2 and the name of the applicant or of each applicant at Box 3. The reason for noting these points is because it is not a requirement for *the applicant* themselves to pay the fee on a Form 9A. Any party can pay that fee. It is for this reason, amongst those of pragmatism and practicality that the IPO Finance Section issue receipts to the address supplied on the accompanying FS2 at the time the fee is paid. The FS2 does require an address to be supplied. That FS2 asks for “Your name and address...” [my emphasis] i.e. the party making the payment, not that of the applicant. Of course often this is one and the same, but not always.
- 44 The IPO Finance Section issues thousands of receipts a month, so does not as a matter of practice check or cross reference the names and addresses supplied on FS2 with applicants’ names and addresses on official records and also because any party can pay the fee on a Form 9A, there would be little point in doing so.
- 45 This explains why Mr Hurley, having written his new Hednesford address on the FS2 filed with his Form 9A 29 January 2013, received receipts for those two documents to that Hednesford address.
- 46 It should be noted that there is no compunction on a person to notify the Office of a change of address. Rule 49 says:

Correction or change of name or address; correction of address for service

r.49.—(1) Any person may request that a correction be entered in the register or made to any application or other document filed at the Patent Office in respect of any of the following—

- (a) his name;*
- (b) his address;*
- (c) his address for service.*

(2) A request under paragraph (1)(a) to correct a name must be made on Patents Form 20.

(3) Any other request under paragraph (1) must be made in writing.

(4) If the comptroller has reasonable doubts about whether he should make the correction—

(a) he must inform the person making the request of the reason for his doubts; and

(b) he may require that person to file evidence in support of the request.

.....

- 47 The use of the word ‘*may*’ makes this a discretionary provision, but if a person wishes to record that a change or address/address for service has occurred on the register, it is clear that a ‘request’ has to be made and in the case of a change of address or address for service, that has to be made in writing - rule 49 (3).
- 48 It is not in dispute that Mr Hurley wrote his new address on the FS2 he filed in January 2013 with his Form 9A, but in my view on a simple, everyday common interpretation of the word, that can in no way be described as a ‘request’ to change his address or address for service on the application. There was no covering letter or email asking the Office to regard the address on the Form FS2 as his new permanent address/address for service. There was not even a manuscript note on the Form FS2 to that effect. As such all the Finance Section had was a standard submission of the Form 9A, accompanied by a standard Form FS2 containing all the details they would normally look for to process payment on that Form 9A. They followed their normal and long established practice.
- 49 As a result of this, the address and address for service recorded against the patent application in suit remained as that submitted when the application was filed on 31 March 2012 i.e. ‘118-119 Stafford Street, Walsall, WS2 8DX’. As such, official correspondence continued to be sent to that address.
- 50 I have explained why the Finance Section replied to Mr Hurley at the address supplied on the FS2 and as a result of this I can see why he might have thought the IPO were aware of the change and had changed his address/address for service accordingly.
- 51 However it had not and I can find no reason why it should have been. It follows then that I can find no irregularity of procedure on the part of the Office.

Conclusion

- 52 Whilst I can see why Mr Hurley might have thought the Office had changed his address details, I also believe Mr Hurley might have realised this was not the case. I don’t say this by way of criticism of Mr Hurley, but merely to state some facts of how this position might have been avoided and perhaps may be in future. For example, when reviewing his application in the winter of 2013, the evidence shows that Mr

Hurley found (via the Espacenet service) that the application had been published on 2 October 2013. It is clear that he examined at least some of his application's publication details because he refers to the citations raised by the Office against it. The publication also carried the applicant's name and address details, which were published as 'Peter David Hurley, 118-119 Stafford Street, Walsall, WS2 8DX'.

- 53 Mr Hurley may not have noted these details and again I am not suggesting in any way that he was deficient in not doing so, but the details were there on public display and had he have spotted them, the failure to file the Form 10 on time may not have occurred.
- 54 He was also aware that having filed his Form 9A search request in January 2013, that other than the receipt for it, he had not received the search report itself. The first he knew of the search results was when he discovered the case had been published. It appears Mr Hurley was not caused to make any further enquiries about his application despite not receiving any communication about it at that stage.
- 55 When Mr Hurley investigated the status of his application in the winter of 2013, there was in fact still plenty of time to file the Form 10 by the deadline of 2 April 2014. However, he did not file the Form 10 until 14 April 2014, outside the permitted period for doing so.
- 56 He then received no correspondence about his application until an email from the Office dated 27 October 2015 notifying him of a refund on the Form 10 he had filed. This too did not appear to cause Mr Hurley to make any enquiries about why a refund had been issued against a request for substantive examination which he still wanted and on which he had received no correspondence.
- 57 He only filed the application for reinstatement on 1 April 2016 after he was finalising claims for this application, but as can be concluded from the above, that while I have some sympathy with the applicant in this case, I can find no irregularity of procedure on the part of the Office under the provisions of r.107 and as such I must conclude that the application for reinstatement was filed outside the period prescribed in r.32(1).
- 58 It follows therefore that I do not need to consider whether the failure to comply was unintentional under s.20A of the Act.

Appeal

- 59 Any appeal must be lodged within 28 days.

Mr G.J. Rose'Meyer
Hearing Officer acting for the Comptroller