



PATENTS ACT 1977

APPLICANT Ms Aisha Kasim

ISSUE Whether the period in which to request substantive examination on patent application GB2518906 can be extended under rule 107 or rule 111

HEARING OFFICER Mr. G. J. Rose'Meyer

DECISION

Introduction

- 1 This decision concerns whether a request to extend the period for requesting substantive examination on patent application number GB1320239.5, published as number GB2518906 can be allowed under the terms of rule 107 or rule 111.

Background and evidence

- 2 Patent application number GB1320239.5 was filed on 15 November 2013 in the name of Aisha Kasim ("the applicant").
- 3 Following routine processing of the application, on 30 January 2014 a Search Report under section 17 of the Act was issued to the applicant to her then address for service in Clepington Road, Dundee. That report, amongst other things, detailed the results of the official search conducted on the application and explained the subsequent processes of Publication (including an estimation that this will occur "soon after 3 March 2015") and Substantive Examination (including the fee and time period for requesting it) if the applicant chose to continue with the application.
- 4 On 18 November 2014 the applicant sent an email to the patent examiner in this case notifying the office that she had changed her address for service from the Dundee address to an address in Sherwood Gardens, London.
- 5 On 9 March 2015, the IPO issued the Notice of Publication on the application in suit to the applicant at her Sherwood Gardens address in London. That notice stated at paragraph 1 that the publication date of the application will be 8 April 2015, and at paragraph 3 that if the applicant wants the application to be considered for grant, she must request substantive examination on a Patents Form 10 (fee £100) within six

months of the publication date , i.e.by 8 October 2015. Paragraph 4 of the notice stated that if the request and fee for substantive examination are not received in time, the application will be treated as withdrawn and no further reminders about requesting substantive examination will be issued.

- 6 No request for substantive examination or any further communications on this application occurred before 8 October 2015 and the application was terminated with effect from 9 October 2015 under the terms of section 18(1) of the Act.
- 7 On 2 May 2018 a letter was received from the applicant requesting reinstatement of the application. It was not accompanied by the relevant official form for requesting reinstatement, a Patents Form 14.
- 8 The applicant's letter of 2 May 2018 explained that as her application for a patent had been "self-filed", she was not familiar with the patent process and despite her best intentions and efforts she had only recently discovered that her application had a status of "Terminated before grant". This had come as surprise to her because after all the time that had elapsed, it was her understanding that the application was either still pending or might even have been granted. She had only recently been advised whilst phoning the IPO that the case had been terminated because of her failure to file the Patents Form 10 and relevant fee. She said she was genuinely unaware of this.
- 9 In that same letter, Ms Kasim acknowledged she had become confused during the processing of the application due to her unfamiliarity with procedures and because of concurrent applications for another patent and a trade mark. However she stated that she felt the main reason why she had mistakenly not filed the Form 10 and fee on time was because she had moved address twice in the period from filing the patent application and the time the Form 10 and fee was due, and any notifications from the IPO reminding her of the need to complete the process may have "slipped through the net and [got] lost in the mail redirection".
- 10 The IPO wrote back to the applicant on 4 May 2018 informing her that it was now too late to reinstate the application. The letter said that the Search Report dated 30 January 2014 had been sent to the Dundee address for service, which was the correct address for service at that time. The letter also confirmed that following notification on 18 November 2014 of the applicant's change of address for service to the London address, the Notification of Publication dated 9 March 2015 was sent to that correct London address for service.
- 11 The official letter went on to say that as the Form 10 had not been filed by of 8 October 2015, the application had accordingly been terminated. As reinstatement under section 20A of the Act is only available within 12 months of termination, it was unfortunately too late to reinstate the application.
- 12 The applicant replied to the official letter by email on 11 May 2018. In that letter she stated that the last document she received [from the IPO] regarding this application was the Search Report dated 30 January 2014. She stated she had not received any letter from the IPO dated 9 March 2015 (the Notification of Publication).

- 13 In her email, the applicant also stated that the Search Report made reference to a further letter in which she would be notified of the exact date of publication and a publication number. She says it was her practice at that time to ring the IPO to clarify anything she did not fully understand, so she rang the office around the time she received the Search Report and was told she had done all she needed to at that stage and that further documents would follow to instruct her further. Although the Search Report had told her that she should hear something after 3 March 2015, as that was a long time away from 30 January 2014 (the date of the Search Report), she trusted she would be advised further as had been confirmed to her in her phone call and in writing.
- 14 In her email Ms Kasim stated that she only became aware of the termination of her application at the start of May 2018 and questioned why she was not notified of this either.
- 15 The IPO replied to Ms Kasim by email on 16 May 2018 saying that the request for reinstatement was made outside the year allowed for such requests and that this was a non-extendable period. The email suggested she seeks further legal advice.
- 16 Ms Kasim replied on the same date via email stating that she was not willing to accept losing her IP rights when she felt she had not been entirely at fault during the prosecution of the patent application and had not received the further notifications she had been told about verbally and in writing. She asked what other options were available to her.
- 17 The official electronic case records show at this point that the case officer then referred the case to senior officials in the IPO. The applicant's case was considered under the terms of rule 107 (Correction of irregularities) and rule 111 (Delays in communication services) because the issues raised by the applicant clearly went to these provisions, but given Ms Kasim is an unrepresented applicant, not surprisingly, she made no specific references to those provisions.
- 18 The outcome of these internal deliberations were erroneously never specifically communicated to the applicant in writing, but she was offered the option of presenting her case at a hearing because it was felt by the IPO that a sufficient case under either ground had not been made by the applicant.
- 19 On 23 May 2018 Ms Kasim requested a hearing and she appeared before me at a hearing on 28 June 2018 via a video conference link.

The relevant law

- 20 There appears to have been some confusion during the prosecution of this case over the provisions of the law under which this case is being considered. This confusion may have arisen from the point at which Ms Kasim sent in her request received 2 May 2018 requesting "reinstatement" of this application. The IPO reacted to that letter by saying it was too late to reinstate this application and subsequent correspondence concentrated on the circumstances behind why the application was terminated. No official application for reinstatement on Patents Form 14 was ever sought by the IPO or filed by the applicant (in fact until 2 July 2018 – after the

hearing) and the case proceeded on the basis of an application to extend the time period for filing the Form 10 under Section 18(1) and rule 28(2).

- 21 The case was then eventually referred by the case officer to senior IPO officials who concentrated on the evidence and submissions of the applicant focussing on the arguments she had made and crystallising them as references under rule 107 (Correction of irregularities) and rule 111 (Delays in communication services) and whether these provisions could be used to extend the time period prescribed for Section 18(1), which is rule 28 (2).
- 22 The applicant was offered a hearing on the basis of the rejection of her arguments under these grounds.
- 23 For clarity, these are the grounds under which I have considered these proceedings and not under the reinstatement provisions of Section 20A.
- 24 For convenience I have reproduced the provisions of rule 107 and rule 111 below:

Correction of irregularities

107.—(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.

Rule 111 – Delays in a communication service.

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.

(2) Any extension 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) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

The Hearing

- 25 At the hearing I told Ms Kasim that there were two areas of the law under which I could consider this case. One is rule 107 (Correction of irregularities) and rule 111 (Delays in communication services). Judging by her evidence and submissions to date, these are the two grounds under which the IPO has considered her case, but rejected her arguments and that is why the hearing was offered. I heard her submissions not specifically limited to those grounds as this would have been unfair to her given she is not a patents professional, but I considered them with that focus and I will summarise her submissions briefly under each ground.
- 26 Under rule 107 Ms Kasim questioned the general level of customer service she received when e.g. ringing the office, trying to fax information to the office and quality of some of the advice and information she received. She wondered if her address changes had been correctly made on her patent applications, because although she has received correspondence from the IPO Trade Mark department to her London address in this period, she had received nothing from the patents department. She also questioned how it could be that she only found out very recently that this patent application had been terminated by ringing the office and not through being notified in writing. She was very annoyed by this lack of a duty of care, as she described it. She stated that she had received no letters or notices from the IPO about this patent application, including the Notification of Publication dated 9 March 2015 as referred to in the official letter of 4 May 2018.
- 27 I told her that whereas I could not explain the lack of customer service she had experienced, there was no requirement in the patent rules to send a notification of termination to applicants, so even though she clearly felt this was wrong, it was not in fact a procedural irregularity.
- 28 Under rule 111 Ms Kasim restated what she had submitted in writing in that she stressed she had received absolutely nothing in the post to her London address. All she had received had been the Search Report dated 30 January 2014 at her Dundee address. I asked her to describe to me what the postal arrangements at her London address were at the time. She said that there were a number of flats at that address, she was number 8 and that each flat had a separate letter box through which the postman would deliver mail. Each flat holder had a key with which they could collect their own personal mail. She was clear that the system worked well, but that she had not received any post relating to the patent in suit to that address. Whilst she attributed that initially to the possibility that the IPO had not updated her address records, it was possible that this was down to a failure of postal services. She was absolutely certain she never received the Notice of Publication on which she was advised she should wait after receiving the Search Report. She clearly asserted that

her intention was always to prosecute this application to grant and her actions during the process up to awaiting the publication of the application, including researching the patent process by reading relevant information, attending patent clinics at the IPO in London and engaging fully with preliminary IPO procedures etc shows this. She asserted that she would have filed the Form 10 and requisite fee of £100 within the time limits set in the Notice of Publication had she received that notice.

The arguments

- 29 The IPO's arguments were not clearly stated in writing to the applicant prior to the hearing this case which is highly unsatisfactory. However, as explained above, officials considered Ms Kasim's case as going to rule 107 and rule 111 and were rejected under those grounds. The hearing focussed entirely on those two grounds.
- 30 The applicant's case under rule 107 and rule 111 has been summarised above in this decision using the evidence she has filed in writing and by her submissions at the hearing.

Decision

Rule 107

- 31 Starting with the rule 107 ground, the applicant argues very strongly throughout her evidence and submissions that she found it difficult at times communicating satisfactorily with the IPO and that the advice she received was not always consistent. She claimed that the IPO had not always fulfilled its duty of care as it should have done. She also asserts that she felt her changes of address may not have been recorded properly and that she had not been notified of what to do next after the Search Report as she had been led to expect or even when her application was due to be terminated, she received no notification of that crucial event, so had no way of knowing what she needed to do and by when in order to attempt to save her patent application.
- 32 From her submissions and the accounts in her written evidence, it does appear that Ms Kasim has received advice and customer service less than the standard she should have expected. The question is whether any of this amounted to "...any irregularity of procedure..." as required by rule 107.
- 33 Alleged poor customer service can certainly lead to irregularities in procedure, but in this case, looking at all the evidence and internal procedures, I cannot point to any specific irregularity in procedure up to the point where the applicant should have been sent the Notice of Publication. Although Ms Kasim alluded to a failure to record her changes of address correctly or on time, this in fact was not the case and all official records were updated correctly and quickly. This meant that all correspondence was sent to the right address for service at the right time. This includes the Notice of Publication. As for being notified of the termination of the application, there is no requirement in patent law to do this and the office does not do so. Therefore no irregularity in procedure occurred here either.
- 34 So up to the point at which Notice of Publication was issued by the IPO, I find no irregularity in procedure and as such I find that the rule 107 ground fails.

Rule 111

- 35 I now turn to the rule 111 ground. I have taken account of all the arguments, evidence and submissions, including Ms Kasim's submissions at the hearing.
- 36 Trying to satisfy the evidential burden in rule 111 cases is always difficult because the applicant is required to provide evidence of a negative – i.e. that something did not happen.
- 37 So what evidence is sufficient to satisfy the comptroller that the failure (in this case) to file the Form 10 on time, was wholly or mainly attributable to a delay in, or failure of, a communication service as required by rule 111?
- 38 In my view the evidential burden on the applicant should be judged on the balance of probabilities and not beyond reasonable doubt. In the *Matsushita Electric Industrial Co. v Comptroller General of Patents [2008] EWHC 2071 (Pat), [2008] RPC 35*, Mr. Justice Mann established that there is an evidential burden beyond mere assertion of the requirement of the law (albeit Section 28 restoration provisions in that case) and in my view in this case the applicant has certainly crossed that threshold, but is the evidence sufficient to satisfy me that the terms of rule 111 have been met?
- 39 The evidence shows that the Notice of Publication was sent correctly by the office. The evidence and submissions by Ms Kasim clearly states that the notice did not arrive at her address and she was very clear on what action she would have taken had that notice been received by her. That action would have been to file the Form 10 and requisite fee in good time.
- 40 Ms Kasim struck me as an entirely honest, serious and credible witness and I have no reason to doubt her evidence and submissions.
- 41 If I believe her and believe she would have acted in the way she asserted she would act if she had received the Notice of Publication, then this begs the question why didn't she act in this way? The answer must logically be that, on the balance of probabilities, she never received the notice.
- 42 So whilst I am satisfied the Notice of Publication was sent out correctly by the IPO and I am satisfied that it was never received by the applicant, I still have no evidence as to what happened in between those two scenarios – i.e. the failure of the postal service, which is of course the crux of the argument if it is to succeed under this ground. Is evidence of the non-receipt of the Notice of Publication enough to cross the evidential burden to satisfy the comptroller that rule 111 is applicable in this case?
- 43 After careful consideration, I believe that the applicant has submitted all the evidence it is reasonably possible for her to have provided proving the Notice of Publication was not where it should have been given it was posted correctly. On the balance of probabilities, it must be logical to conclude that something went wrong in the postal system for it not to have arrived at the address of the applicant. Further, it is clear from the evidence that if this is not the *whole* reason, it was at least the *main* reason for the failure to file the Form 10 and fee on time. This of course is a requirement of rule 111.

- 44 As such I must conclude the rule 111 ground succeeds.
- 45 Rule 111 allows me to extend any time period specified in the Act and rules. In this case the period I need to extend is the period prescribed for Section 18(1), which is rule 28 (2)

The rights of potentially affected third parties

- 46 However, before I can order that the period in which the request for substantive examination can be made is extended, there is one other important point I should consider and that is whether the fact the application was terminated and shown as such on the public register since 9 October 2015 and advertised as such in the Patents Journal at the time might have affected the legitimate rights of others.
- 47 Third parties may have innocently begun to work this patent thinking they were free to do so and were protected from prosecution by the law. I should stress that in such situations, there is usually no evidence that any third party has actually begun to work the patent, and there is no evidence to that effect in this case, but the Patent law protects the rights of these potential third parties in several places. The Comptroller acts on these cases by often imposing what are known as ‘third party terms’ as a condition of any ‘resurrection’ of a patent or application that has lapsed for a number of possible reasons.
- 48 As I have alluded to above, these third party terms exist in several places in the Act, for example in the context of reinstatements under sections 20A and 20B and restorations under section 28 and 28A. They also appear in the context of corrections of errors in patents or patent applications (rule 107) and circumstances such as this under rule 111 (2) (b) which states:
- (2) Any extension under paragraph (1) shall be made –
- (a) after giving the parties such notice; and
- (b) subject to such conditions,
- as the comptroller may direct.
- 49 There is a clear intention by the legislator to protect third parties who act in good faith whenever a change to the status of a patent or patent application is made which could impact on their freedom to work the invention.
- 50 The question of whether to impose third party terms when a patent or patent application is reinstated, restored or ‘resurrected’ following a patent or application being advertised as terminated, refused or ceased has arisen in previous cases. In *Coal Industry (Patents) Ltd’s Application* [1986] RPC 57 the issue related to a failure by the Office to issue an examination report under section 18(3) which resulted in the patent application being advertised as refused in the Patents Journal. In rectifying the error, the Office sought to impose third party terms but the applicant disagreed and appealed. In his judgment Falconer J said:

“The matter, however, cannot rest there. As a consequence of the announcement of the refusal of the application any member of the public would have been free to take advantage of the disclosure and to exploit the invention. Resuscitation would be a serious blow to such a person and I must have regard to his interest. Rule 100 [predecessor to rule 107] allows that the rectifying of the irregularity be subject to such terms as the Comptroller may direct. It seems reasonable to me that protection for third parties should be along the same lines as is provided in restoration proceedings under section 28.” [my note in parenthesis]

- 51 It can be seen (above at paragraph 24) that rule 107 has an analogous provision to rule 111 (2) (b) and as I have found that the application in suit does satisfy the requirements of rule 111, the question of third party terms needs consideration. As Falconer J concluded in *Coal Industry*, the comptroller must therefore also have regard to the interest of such parties when exercising discretion, in that instance under the predecessor to rule 107. The principal remains that the resurrection of the patent or application should not adversely impact on any third parties who may have acted in good faith once the patent or application was publicly shown as no longer being in force. In this case it is my view that third party terms are necessary to provide such third parties with appropriate protection.

Conclusions

- 52 In these circumstances, it is my considered view that the failure to file the request for substantive examination on time via the filing of a Form 10 and the official fee of £100 was wholly or mainly attributable to a failure in the communication service, in this case the postal service.
- 53 However, before I can order that the period in which the request for substantive examination can be made is extended, I remit the application back to the Office so that the applicant can consider the following third party terms as a condition of that extension:

Third part terms

1. As the application has been published under Section 16 before its termination, if after the termination with effect from 9 October 2015 and before publication of the decision allowing the period in which the Form 10 requesting substantive examination of this application be extended was issued i.e. 29 August 2018, a person -

- (a) *began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or*
- (b) *made in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the reinstatement of the application and the grant of the patent; but this does not extend to granting a licence to another person to do the act.*

2. If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-paragraph (1) above may -

(a) authorise the doing of that act by any partners of his for the time being in that business, and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

3. Where a product is disposed of to another in the exercise of the rights conferred by sub-paragraph (1) or (2) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant.

54 The office should write to Ms Kasim within two weeks of the date of this decision and allow her one month from the official letter in which to either agree the above third party terms or to submit any comments in writing.

Mr G J Rose'Meyer
Hearing Officer Acting for the Comptroller