



PATENTS ACT 1977

APPLICANT Clifton Packaging Group Ltd

ISSUE Whether patents GB2543038 and GB2545050 can
 be restored under section 28

HEARING OFFICER Charles Jarman

DECISION

Introduction

- 1 This decision concerns whether the two patents in suit can be restored under the provisions of section 28 of the Patents Act 1977 ('the Act') following a failure to pay renewal fees on the patents in the required time frames.
- 2 Application GB1517379.2, titled 'Antibacterial packaging', was filed on 1st October 2015 in the name of Clifton Packaging Group Ltd, and subsequently granted as patent GB2543038 on 22nd May 2018. The patent was last renewed on 6th October 2020 with no renewal payment then being made on the next renewal date of 1st October 2021, nor within the subsequent six months within which late payments can be made under section 25(4). The patent was therefore then deemed to have ceased on 1st October 2021.
- 3 Application GB1616802.3, titled 'Packaging with an antibacterial coating', was filed on 3rd October 2016 as a divisional application of GB1517379.2 and thus also in the name of Clifton Packaging Group Ltd. The application was granted as patent GB2545050 on 5th March 2019 and an initial renewal payment was made on 6th October 2020. However, no renewal payment was made on the next due date of 3rd October 2021 nor in the following 6 months, such that the patent was deemed to have ceased on 3rd October 2021.
- 4 The matter came before me at a hearing on 9th January 2024, with Clifton Packaging Group Ltd being represented Shane D'Souza and Chavvi Rajpal, who are the Chief Operating Officer and Office Manager, respectively, at the company. I confirm that I have also reviewed the correspondence on file and taken into account the arguments provided therein in reaching my decision.

Background

- 5 It is initially worth setting out the timing of various actions in full as they are important to the outcome of this decision. Having been filed on 1st October 2015, GB1517379.2 proceeded to grant as GB2543038 on 22nd May 2018, with renewal payments being made up until a final payment on 6th October 2020. The subsequent date for a renewal payment was 1st October 2021, and as a result of no payment being made a renewal reminder letter was issued on 16th November 2021 to the address for service on file, the attorney firm Adamson Jones. A notice of cessation letter was then sent on 8th June 2022, also to Adamson Jones, at which point the patent was deemed to have ceased on 1st October 2021.
- 6 There is a similar history of events for GB1616802.3 which, having been filed on 3rd October 2016, proceeded to grant as GB2545050 on 5th March 2019. While an initial renewal payment was made on 6th October 2020, no renewal payment was received in relation to the next due renewal date of 3rd October 2021. This resulted in a renewal reminder letter being issued on 16th November 2021, again to Adamson Jones as the address for service. As this did not result in a renewal payment being made, a notice of cessation letter was then issued on 8th June 2022, at which point the patent was deemed to have ceased on 3rd October 2021.
- 7 The Intellectual Property Office was then contacted on 25th October 2023 by the patent proprietors who were seeking to restore the two patents with which this decision is concerned along with a third patent, GB1711094.1/GB2564445, which had also lapsed. Due to having a slightly different timeline, it was subsequently possible to restore this third patent. However, the proprietors were informed in letters issued by the Office on 31st October 2023 that the requests to restore GB2543038 and GB2545050 were filed outside of the period set out in rule 40(1) of the Patent Rules 2007 ('the Rules') within which such requests must be made. The proprietors therefore requested that the matter before us be heard.

The Law

- 8 Section 28 of the Act sets out the requirements for the restoration of a lapsed patent:

28(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the prescribed period.

(2)...

*(3) If the comptroller is satisfied that the failure of the proprietor of the patent –
(a) to pay the renewal fee within the prescribed period; or
(b) to pay that fee and any prescribed additional fee within the period ending with the sixth month after the month in which the prescribed period ended,*

was unintentional, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

9 Section 25 of the Act states:

25(1)...

25(2)...

25(3) Where any renewal fee in respect of a patent is not paid by the end of the period prescribed for payment (the 'prescribed period') the patent shall cease to have effect at the end of such day, in the final month of that period, as may be prescribed.

25(4) If during the period ending with the sixth month after the month in which the prescribed period ends the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly –

(a) anything done under or in relation to it during that further period shall be valid;

(b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and

(c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.

10 Rule 40 of the Patents Rules 2007 ('the Rules') states:

40(1) An application under section 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in section 25(4) ends.

(2) The application must be made on Patents Form 16.

11 Rule 107 of the Rules, which relates to the correction of irregularities of Office procedures, states:

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)...

(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 of the Patent Office; and

(b) it appears to the comptroller that the irregularity should be rectified.

12 Rule 111 of the Rules, which relates to delays in communication services, 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.

(2)...

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

Arguments

- 13 As was explained in the Office letters of 31st October 2023, the Act and Rules provide only a set period within which a patent proprietor may seek to restore a patent which has lapsed. This period, set out in rule 40, taking into account section 25 and section 28, equates to a deadline set at the end of the 19th month after the month in which the renewal fee was originally due. The original renewal dates of 1st and 3rd of October 2021, for GB2543038 and GB2545050, respectively, are such that the latest date on which a request to restore either patent could have been made under rule 40 was 31st May 2023. As set out in Part 1 of Schedule 4 of the Rules, the period set by rule 40(1) in which to request the restoration of a patent cannot be extended, such that there is no scope of restoring the patents in the normal run of things.
- 14 As I explained at the hearing, there are therefore only two possible routes via which the patents in question might potentially be restored. The first relates to the Comptroller’s powers to correct errors arising from irregularities in Office procedures, as per rule 107, and the second relates to the Comptroller’s powers to extend time periods in response to delays in communication services, as per rule 111.
- 15 At the hearing Mr D’Souza provided an explanation of the series of events which led to the patents lapsing. He has acted as COO for Clifton Packaging for three years, having taken over from the previous Director, Mr Shahid Sheikh, who had needed to step down from his role due to health reasons. Due to the unfortunate circumstances, it was not possible to arrange a proper handover of the role between Mr D’Souza and Mr Sheikh, nor was it possible for Mr Sheikh to be readily contacted during this period. Mr Sheikh had been the sole point of contact at the company for Adamson Jones. Correspondence with Adamson Jones was sent via email to an email address belonging to Mr Sheikh, and the emails were not forwarded on or otherwise available to the company due to Mr Sheikh’s absence. As a result of the emails sent to Mr Sheikh not being responded to, the patents were not renewed and thus eventually lapsed.
- 16 Mr D’Souza did query during the hearing if this failure to respond to the emails which were sent to Mr Sheikh could be deemed to equate to an office error that might enable rule 107 to be made use of. However, any use of rule 107 in relation to rule 40(1) would have to be made under rule 107(3), and as such it is necessary that the error or irregularity of procedure which resulted in some sort of failure was made by the Intellectual Property Office. Errors made by an patent proprietor or a third party

would not enable rule 107 to be used in this particular situation. I did ask Mr D'Souza and Ms Rajpal if they could identify any error which had been made by the Office but they were not able to identify any. Furthermore, I have not been able to identify any errors or irregularities made by the Office when reviewing the file history of the patents.

- 17 In order for rule 111 to potentially be applied, it is necessary for the failure to do something under the Act or Rules to be wholly or mainly attributable to a delay in, or failure of, a communication service involved in the sending or delivery of documents. Such communication services include both physical services, such as the postal service or couriers, and electronic services, such as email and other such systems. Effectively, something must have arisen which prevented a document which was sent from being received at its intended destination, with that failure of communication in turn resulting in a failure to meet a requirement under the Act or Rules.
- 18 While in the present case the failure to renew the patents was at least in part due to emails which were not responded to, there has not been any noted failure in the communication services themselves. There has been no suggestion that any email which was sent from Adamson Jones to Mr Sheikh's email account was not received there, nor that any correspondence between the Office and Adamson Jones was not received or otherwise went astray. At the hearing, Mr D'Souza and Ms Rajpal were not able to identify any general breakdowns or irregularities in communication services that might meet the requirements of rule 111.

Conclusion

- 19 I have genuine sympathy for the patent proprietors who clearly did not intend for their patents to lapse, which occurred as a result of an unfortunate set of circumstances. As soon as the proprietors became aware that the patents had lapsed they acted in a timely manner to try to restore them. At the hearing I found the proprietors to be honest, helpful, and constructive and there is no doubt that these patents are of genuine value to the company.
- 20 However, in relation to the restoration of the patents in suit I am obliged to follow the legislation which I have set out above. The Act and Rules are clear in providing only a limited time within which lapsed patents can be restored, as third parties must have some certainty as to when they can work a previously patented invention. The application to restore the patents was made outside of the period set out by rule 40(1) within which such requests must be made. I have not been able to identify any errors or irregularities by the Office which might enable the use of rule 107. Similarly, there have not been any delays or failures noted in any communication service which might enable the use of rule 111.
- 21 As such, which I am sympathetic to the position of the patent proprietors, I must conclude that the application to restore the patents does not meet the requirements of the law and I therefore refuse the application for restoration.

Appeal

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

CHARLES JARMAN

Senior Legal Advisor, acting for the Comptroller