



PATENTS ACT 1977

APPLICANT Carol Ann Smith, Daniel John Cooper

ISSUE Whether an application to restore patent GB2518913
can be made under section 28

HEARING OFFICER Nick Smith

DECISION

Introduction

- 1 This decision concerns whether an application to restore patent GB2518913 can be made under section 28 of the Patents Act 1977 (“the Act”).
- 2 Application GB1401095.3, titled “A wearable item”, was filed on 23 January 2014 in the name of Strong Trend Development Limited. The application was subsequently granted on 19 August 2015 as patent GB2518913 B.
- 3 The renewal fee in respect of the 7th year of the patent was due on 23 January 2020, with no fee paid by that date or during the subsequent six months in which a late renewal can be made under section 25(4). The patent therefore ceased on 23 January 2020.
- 4 An application to restore the patent was made on 10 September 2020, and subsequently allowed on 25 January 2022, subject to payment of outstanding renewal fees by 25 March 2022. The outstanding fees were not paid, and the application for restoration was refused in an official decision dated 13 October 2022.
- 5 A further application to restore the patent was made by the current proprietors (Carol Ann Smith and Daniel John Cooper) on 11 October 2024. The proprietors were informed, in an official letter dated 16 October, that the application had been filed outside the period prescribed by rule 40(1) of the Patents Rules 2007 (“the Rules”) and so could not be accepted.
- 6 This matter was presented before me at a hearing on 31 January 2025, with Carol Ann Smith appearing on behalf of both proprietors. In making this decision, I have carefully considered the evidence presented at the hearing and the correspondence on file in relation to this matter, including skeleton arguments filed 27 January 2025 for which I am grateful.

Background

- 7 After patent GB2518913 had ceased on 23 January 2020, an application to restore the patent was made by the filing of a Patents Form 16 on 10 September 2020. This form was filed by Carol Ann Smith, with the proprietors listed as Tung Hoi Lam, Carol Ann Smith and Daniel John Cooper. On 29 June 2021, Carol Ann Smith was informed that to continue with the restoration application, a Patents Form 21 needed to be filed to record the proprietor of GB2518913 as Tung Hoi Lam, Carol Ann Smith and Daniel John Cooper, as the patent stood in the name of Strong Trend Development Limited. This letter also requested written evidence explaining why the 7th year renewal fee was not paid in the period of 23 October 2019 to 31 July 2020.
- 8 A Patents Form 21 signed on 1 October 2021 requested the recording of a transfer of ownership by assignment from Strong Trend Development Limited to Carol Ann Smith and Daniel John Cooper. The date of transfer of ownership in section 6 of the Form 21 was noted as being on 10 September 2020. This transfer of ownership was confirmed as being recorded on 19 January 2022. In the period between 1 October 2021 and 19 January 2022, there were several email exchanges between Carol Ann Smith and the Intellectual Property Office, dealing with the Formalities requirements for the recordal of the transfer of ownership, and the evidence requirements to support the application for restoration. It was in an email from Carol Ann Smith on 12 October 2021, that evidence was provided to show that the failure to pay the renewal fee was unintentional.
- 9 In a letter dated 25 January 2022, Carol Ann Smith and Daniel John Cooper (“the proprietors”) were informed that the application for restoration of patent GB2518913 had been allowed. Restoration of the patent was conditional on the payment of the outstanding renewal fees for the 7th, 8th and 9th years, each with a separate Patents Form 12, by 25 March 2022. The fees were not paid, and two letters reminding the proprietors of the requirement to pay outstanding renewal fees were sent on 27 April 2022 and 28 June 2022. As the reminder letters were sent after the deadline of 25 March 2022, the proprietors were informed they would need to request an extension of time to pay the outstanding renewal fees. The fees remained unpaid, and on 13 October 2022, a decision was issued refusing the application for restoration of patent GB2518913 as the requirements laid down in section 28(4) had not been met.
- 10 A further Patents Form 16 was filed by the proprietors Carol Ann Smith and Daniel John Cooper on 11 October 2024 to apply for restoration of GB2518913. This restoration application was filed outside of the period set in Rule 40(1) of the Patents Rules 2007. A letter informing the proprietors that their restoration application could not be considered was sent on 16 October 2024. This letter stated that a period of one month from the date of the letter was allowed for a hearing to be requested. On 11 November 2024, Carol Ann Smith contacted the Intellectual Property Office to request a hearing.

The Law

- 11 Section 25 of the Act defines the term of a patent, including the consequences of non-payment of renewal fees:

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.

- 12 Section 28 of the Act sets out the requirements for the restoration of a patent which has lapsed due to non-payment of a renewal fee:

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.

- 13 Rule 40 of 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.

Arguments

The first restoration decision

- 14 At the hearing, I explained that I would not be reconsidering the initial determination made by the Office on 25 January 2022 to allow the first restoration application

(subject to payment of outstanding renewal fees), on the basis that failure to pay the renewal fees was unintentional.

- 15 I did however invite observations and arguments concerning the events following 25 January 2022 which led to the decision of 13 October 2022, refusing the first restoration application. While the appropriate route to contest that decision would have been an appeal to the Patents Court, I nevertheless wanted to ensure that Mrs Smith had an opportunity to fully explain the circumstances which led to the failure to pay the outstanding renewal fees on time, in case relevant to this decision.
- 16 During the hearing, Mrs Smith provided an explanation of the difficult circumstances she and the co-proprietors of the patent experienced during the Covid pandemic, including financial pressures during the years 2021 and 2022. She explained that, while there was always a desire to maintain the patent, their financial position made it impossible to pay the money to do so, and the patent went onto the “back burner”.
- 17 Mrs Smith also revealed that she could not find any evidence of having received the reminder letter of 28 June 2022, or the decision letter of 13 October 2022, suspecting this was because she stopped using a particular email account around that time. Even though the reminder letter of 28 June 2022 was not received, Mrs Smith confirmed during the hearing that the letter of 22 January 2022 allowing the first restoration application (subject to payment of outstanding renewal fees), and the first reminder letter of 27 April 2022, were both received.
- 18 While providing helpful context, I do not believe the events between the letter of 22 January 2022 and the decision to refuse the application for restoration on 13 October 2022 are relevant to the present case. As mentioned above, the appropriate route to contest that decision would have been an appeal to the Patents Court, and the procedure and deadline for doing so were set out in the letter which accompanied that decision. Even if the decision and letter of 13 October 2022 were not received, the refusal of the application for restoration is a matter of public record, having been entered into the register of patents and published in the journal. The deadline for lodging an appeal to that decision has long since passed, and in any event is a matter for the courts.

The second application for restoration

- 19 During the hearing, Mrs Smith indicated that once things had settled down following the difficult period during the Covid pandemic, the proprietors felt regret at having let the patent lapse and once again sought to restore it. This second application for restoration, filed on 11 October 2024, was prompted at least in part by renewed third party interest in the products covered by the lapsed patent in May 2024, and a review of the patent documentation in September 2024, as noted in the skeleton arguments.
- 20 Rule 40(1) of the Rules allows an application for restoration to be made with the period ending with the thirteenth month after the end of the sixth month period provided for in section 25(4) of the Patents Act 1977. The 7th year renewal fee for patent GB2518913 was due by 23 January 2020. The end of the sixth month period specified in section 25(4) was 31 July 2020. The thirteen-month period allowed by

Rule 40, within which an application for restoration could be made, started on 1 August 2020 and ended on 31 August 2021.

- 21 The prescribed period under section 28(1) and rule 40(1) is non-extendable and cannot be altered. Unfortunately, as the second application for restoration made on 11 October 2024 was filed significantly later than 31 August 2021, it cannot be allowed.
- 22 I note that the skeleton arguments point to the financial and operational hardships faced by the proprietors during the pandemic and note the relief measures put in place by IP offices – including the IPO – during this period. Unfortunately, those measures were time-limited and do not provide any assistance in respect of the second application for restoration under consideration here.

Conclusion

- 23 It is unfortunate that even though the first restoration application was allowed, on the basis that the first application was filed on time and the applicant had shown that failure to renew was unintentional, a set of difficult circumstances resulted in the first application ultimately being refused for failure to comply with the conditions for restoration.
- 24 Whilst I have genuine sympathy for the circumstances faced by the patent proprietors, I conclude that the second application to restore patent GB2518913 was filed outside the period allowed in law, and therefore I must refuse the application for restoration.

Appeal

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

Nick Smith

Head of Legal Section, acting for the Comptroller