



## PATENTS ACT 1977

APPLICANT                      Gareth James Humphreys

ISSUE                          Whether the request to restore patent number  
GB2462487 has been filed in time under Section 28  
and Rule 40(1)

HEARING OFFICER    Mr. G. J. Rose'Meyer

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### DECISION

#### Introduction

- 1    This decision concerns whether an application to restore the patent number GB2462487 can be considered as having being correctly filed in time so as to go on to consider whether it can be restored under the full terms of section 28 of the Act.
- 2    The application for the patent in suit was filed on 12 August 2008 in the name of Gareth James Humphreys. The application was granted with effect from 19 September 2012 and the applicant paid annual renewal fees up to and including the seventh year.
- 3    The renewal fees in respect of the eighth year of this patent fell due on 12 August 2015, payable until the end of that month under rule 38(2). The renewal fees were not paid by that date or during the extended period of six months allowed under section 25(4) upon payment of the prescribed additional fees.

#### Background

- 4    An application for restoration of the patent was filed on 16 May 2017, outside the thirteen months prescribed under rule 40(1) of the Patents Rules 2007 for applying for restoration. The date by which the application should have been filed was 31 March 2017.
- 5    The application was accompanied by a hand written document entitled "Evidence" stating "*I missed my payment reminders due to a change of address...*" and then detailing the old and the new address details. Nothing further was filed at that time.
- 6    In an official letter dated 17 May 2017 the applicant was informed that the application for restoration had been filed late as it should have been made by 31 March 2017 as

set out by rule 40(1) and that as rule 40(1) is a non extendable period, there is no other way of restoring the patent. The applicant was offered one month in which to make any comments or to request a hearing and told that if there was no response within this period, a refund of the £135 fee paid would be arranged.

- 7 On 18 May 2017 Mr Humphreys requested a hearing via an email and in that email said the following:

*“Please could I request a hearing in front of a senior officer?”*

*I know it may not help my case, but what with the house move and the birth of my daughter (now 13 months old), I didn’t keep on top of my administration. I also know that it’s no excuse, but I’m not a company or business. I’m just a guy who luckily came up with a good idea, and this is my only chance to make something of my idea.*

*I don’t know if you’ve had a look at the patent itself, but it’s an energy saving device, a green energy device, that, given the right development, could change how we power our homes, which could have a massive impact on the world! (Ok I may be dreaming big, but I have to believe that it’s possible)*

*I would request that this be made an exception to the rule given its possible impact on the world, and that I’m just a guy, who got a good idea, but took his eye off the ball...*

*This is probably the only thing I’ll ever achieve, and to lose it, would severely impact my life. I can’t stress enough how important getting this patent protected again means to me.*

*I apologise for the sob story, I guess you must hear them all the time, but I can only prey [sic] that you give me a chance, so I can go and do something significant with my idea.”*

- 8 Arrangements for the hearing to be held via the telephone between Mr Humphreys and myself were made for 17 July 2017.

### **The arguments**

- 9 The IPO’s position has been set out above at paragraph 6.
- 10 The only written submissions filed on behalf of the applicant are reproduced above at paragraphs 5 and 7.
- 11 At the hearing, Mr Humphreys added to his previous submissions by saying that his move of house, the birth of his child and being made redundant all meant that he did not change his address on his patent in good time and as result the official notifications and reminders had been sent to his old address. By the time he realised this he was too late to pay his renewal fees or to file his application for restoration on time.
- 12 Mr Humphreys was very clear, earnest and honest in his submissions that he had simply made mistakes managing the renewal of his patent and he acknowledged

that he was in the wrong, but requested that if at all possible I make an exception to the rules in his case. He went on to explain how important his patent was to him and expanded a little on his plans for the patent in the future.

- 13 I had much sympathy for Mr Humphreys' position but explained to him I could only reach a decision based on the law and that I would consider his arguments very carefully on this basis.

### **The relevant law**

- 14 The patent lapsed on the 12 August 2015. Rule 38 (2) provides that the renewal fee can be paid up until the final day of the month of the lapse, so the renewal could have been paid on time up until the 31 August 2015.

- 15 Section 25(4) allows a period of grace of a further six months in which to pay the renewal fees, with additional fees. Therefore the period specified in section 25(4) ended on 28 February 2016.

- 16 Section 28(1) states:

*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.*

- 17 The "prescribed period" here is given in rule 40(1) which 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.*

- 18 Therefore the last date that the application for restoration could have been filed was 31 March 2017.

### **Decision**

- 19 None of the above deadlines in so far as they relate to the eighth year renewal of the patent in suit were met. This is not a matter of dispute in these proceedings.

- 20 The applicant has requested restoration of the patent but has not specified any legal grounds under which I should consider his request in relation to the IPO's contention that the application for restoration in effect was not properly made because it was filed outside the prescribed period allowed for doing so.

- 21 I have had the benefit of Mr Humphreys' submissions in writing and at the hearing, but I cannot interpret these as falling under any particular provisions of the law.

- 22 This leaves the IPO's arguments that the application was filed out of time and this period cannot be extended. This is not strictly true and I shall go on to explain this later, but below are the provisions on which the IPO has based its arguments.

- 23 Rule 108(1) gives the comptroller the discretion to extend certain time periods within the Rules, except for those stipulated in Schedule 4 Part 1 and 2 of the Rules. Rule 40(1) is amongst those listed in Schedule 4 Part 1, so is at face value a non-extendable period. The relevant references are reproduced below:

***Extension of time limits***

*108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4. [Emphasis added]*

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)rule 37 and 38 (renewal of patents)*

***rule 40(1) (application to restore a lapsed patent) [Emphasis added]***

*rule 43(4) (application to cancel entry that licence available as of right)*

- 24 However, there are two possible exceptions to the above which have sometimes been argued in other applications for restoration before the comptroller. These are rule 107 (Correction of irregularities) and rule 111 (Delays in communication services). I will set these out below for completeness:

**Correction of irregularities**

***Rule 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.*

### ***Delays in communication services***

***Rule 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.*

- 25 Both these rules potentially allow the comptroller to extend the period in which to file an application for restoration under rule 40(1), but convincing evidence to prove an applicant's case under either provision must always be submitted in order for them to be successful.
- 26 Mr Humphreys is a private individual and I would not expect him to have necessarily referred me to these provisions, but for the sake of completeness I have considered whether any of Mr Humphreys' arguments go to either of these provisions. Regrettably I cannot find that they do. There is certainly no suggestion or evidence that the IPO made any kind of procedural irregularity in the processing of the renewal of this patent, so rule 107 does not apply.
- 27 While Mr Humphreys' submissions told me that the official notifications about the renewal and lapse of his patent were sent to his old address, he admits this was because he had failed to notify the office of his new address in good time. This means that neither rule 107 nor rule 111 can apply.
- 28 It seems to me that the matter before me is very clear. The applicant has regrettably but clearly failed to meet any of the prescribed deadlines he needed to meet in order to renew the patent on time or within the period of grace for paying those fees late and having failed to do these things, he has then missed the deadline for filing an application to restore the patent. I understand very clearly why that was and sympathise with the very difficult circumstances Mr Humphreys found himself in at the time.

- 29 However, the proprietor of a patent due for renewal has several chances to complete that process. It can be renewed up to three months before the due date, it can then be renewed with late fees for a further period of six months and failing that it can still be restored, so long as the application for such is made within thirteen months. In total, that is a period of twenty two months in which to keep a patent in force.
- 30 That is a generous amount of time and once that twenty two month period finally expires, that is the end of the ability to resuscitate a lapsed patent. It is quite clear from Schedule 4 Part 1 of the 2007 Rules that the period for filing a restoration is a non-extendable period and the comptroller is given no discretion under the law to operate outside this provision except in certain circumstances under rule 107 (Correction of irregularities) or rule 111 (Delays in communication services) as has been explained.
- 31 No evidence or submissions have been put to me under any grounds which enable me to consider whether the requirements of rule 40(1) should be reconsidered. As such I find that the attempt to file an application for restoration of the patent in suit was not made in time and does not constitute a legitimate application for restoration.
- 32 It follows that I need give no further consideration under section 28 as to whether the patent can be restored.

### **Conclusion**

- 33 It is not without generous statutory opportunity to maintain existing rights that the Act finally after twenty two months terminates those rights. Whilst the third party rights of possible infringers of the lapsed patent are protected up to a point (s.28A (4) refers), it is always in the general public interest that the correct status of a patent is known. It is for this reason that the Act finally terminates the ability to resuscitate a lapsed patent in the public interest for the legal certainty this brings if renewal or restoration have not been completed.
- 34 In this case the attempt to restore the patent in suit took place relatively soon after the period to do so finally expired, but in effect no case with a legal basis was presented to me to enable me to consider if I should extend the normally non-extendable provisions of rule 40(1).
- 35 As sympathetic as I am to the applicant's plight, under the terms of the law I must refuse the application for restoration.

### **Appeal**

- 36 Any appeal must be lodged within 28 days

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