

the date allowed by rule 40(1) and that that period was not extendable. The IPO attached two office decisions to that email by way of information. Those two decisions were:

- BL 0/305/08 – concerning patent no. GB2378695 in the name of Gradco (Japan) and KRDC Co. Ltd
- BL 0/166/09 – concerning patent no. GB2387536 in the name of Mr Edwin Smith

- 8 The email concluded by inviting the applicant to file further submissions if it was felt there had been any procedural irregularities under rule 107, or to confirm their request for a hearing.
- 9 The IPO Hearing records show the attorney confirmed the continued requirement for a hearing on the matter by telephone and arrangements for the hearing were made for 20 October 2015. However, on 16 October 2015 a letter was received from Bryers confirming that the applicant would not be attending the hearing and requesting “...a decision on the basis of the file as it stands”.
- 10 So it is on this basis that I issue this decision.

The applicant’s arguments

- 11 The IPO’s position has been set out already in this decision.
- 12 The only written submission filed on behalf of the applicant was the Statement of Grounds and two annexes which accompanied the application form for applying for the restoration of the patent (Form 16) filed on 26 May 2015.
- 13 That Statement of Grounds gave a short chronological account of the history of the patent in suit and that of its renewal up until its lapse on 17 May 2009, when its eighth year renewal fees fell due. The Statement of Grounds states that this failure to pay the requisite renewal fees was ‘unintentional’ and refers to Annex A, a declaration of Richard Nathan, CEO of the applicant company, which supports this submission.
- 14 The Statement of Grounds goes on to say that it has not been possible to establish from the IPO whether the renewal reminder notice required by rule 39(1) was sent to the applicant by the IPO as no file history is available and supplies at Annex B a copy of a letter from the IPO to this effect.
- 15 The Statement of Grounds ends with a request that the “comptroller grants the application for restoration of European (UK) Patent Number 1395152” or in the event of a refusal, a hearing was requested.

The relevant law

- 16 The patent lapsed on the 17 May 2009. As this was not the first renewal of this patent, rule 38 (2) provides that the renewal period is three months ending with the last day of the month on which the renewal date falls, so the renewal in this case could have been paid on time up until the 31 May 2009.

17 Section 25(4) allows a period of grace of a further six months in which to pay the renewal fees, with additional fees dependent on when within that six months the fees are paid. The period specified in section 25(4) for this patent ended on 30 November 2009.

18 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.

19 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.

20 As I have said, the period specified in section 25(4) in this case ended on 31 November 2009 and therefore the last date that the application for restoration could have been filed was the last day of the thirteenth month after that – i.e. the 30 December 2010.

Decision

21 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.

22 The applicant has requested restoration of the patent but has not based this request on any specific grounds 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 filing an application for restoration.

23 I have not had the benefit of any further submissions at a hearing.

24 From the papers available to me, I might assume that there are two possible avenues the applicant might want me to consider. The first argument seems to go to the consideration under section 28 (3) that the failure to pay the renewal fee on time for the eighth year renewal of the patent in suit was unintentional (Annex A).

25 The other might go to an argument that as no IPO records were available to them to show that the renewal reminder required by rule 39(1) was issued, that this was an irregularity under rule 107 (Correction of irregularities).

26 Dealing with the first matter, this is not a determination I should make until I establish whether an application for restoration was properly made in the first place, so I will come back to this if necessary.

27 On the second point, the Statement of Grounds itself at paragraph 10 merely states that it was not possible to establish whether the reminder letter was issued. This may go to rule 107, but in the absence of any further elaboration I am not inclined to, neither should I, speculate on what applicant’s arguments are here.

- 28 For completeness I should explain that the IPO's practice is not to open an electronic file on a EP(UK) patent (as in the present case) unless and until an action (such as the filing of an assignment to record subsequent proprietors or a restoration application etc) requires it. Routine renewals of EP (UK) patents are kept as records within the IPO's Finance Department and do not result in the creation of an electronic case file. Renewal actions for years 2006, 2007, 2008 were all routinely paid in time (as adduced in the Statement of Grounds) for the patent in suit. This explains why no case records existed in the present case when requested by the attorneys. Further, the IPO Finance records show that the renewal reminder mentioned in paragraph 10 of the Statement of Grounds was indeed issued in accordance with rule 39, dated 16 June 2009 and addressed to the applicant at their registered address for service at the time (Lucas & Co., 135 Westhall Road, Warlingham, Surrey, CR6 9HJ).
- 29 As such, other than acknowledging that the applicant was not able to find any file information relating to this patent from IPO records (I have explained why above), I find it impossible to comment further on this matter.
- 30 This leaves the IPO's arguments that the application was filed out of time and this period cannot be extended.
- 31 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. 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)

.....

.....

- 32 It seems to me that the matter before me is very clear. The applicants have failed to meet any of the prescribed deadlines they needed to meet in order to renew the patent in suit on time or within the period of grace allowed for paying those fees late with fines. Having failed to do these things, they have then missed the deadline for filing an application to restore the patent. Not only have they missed it, but they have missed it by the best part of four and a half years.
- 33 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 after the six months period of grace. In total, that is a period of twenty two months in which to keep a patent in force.
- 34 That is a generous amount of time it seems to me and once that twenty two month period finally ends, 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 this period cannot be extended and the comptroller is given no discretion under the law to operate outside this provision except in certain specific circumstances provided for under rule 107 (Correction of irregularities).
- 35 No evidence, submissions or arguments have been put to me under any grounds which enable me to consider whether the provisions 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.
- 36 It follows that I need give no further consideration under section 28 as to whether the patent can be restored.

Conclusion

- 37 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 are protected up until publication of the notice of the application for restoration (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 eventually the Act terminates the ability to renew or restore a patent in the public interest for the legal certainty this brings.
- 38 In this case the attempt to restore the patent in suit took place nearly four and a half years after the statutory provision for such expired and in effect no case was presented to me to enable me to consider if I should extend the normally non-extendable provisions of rule 40(1) in order to accept the attempted application to restore the patent as a legitimate one.

39 As such I must refuse the application for restoration.

Appeal

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

Mr. G J Rose'Meyer

Hearing Officer
Acting for the Comptroller