

## **PATENTS ACT 1977**

**IN THE MATTER OF** an application  
under section 28 by Simon Paul Carrington  
for the restoration of Patent GB2261136

### **DECISION**

1. The renewal fee in respect to the sixth year for the patent fell due on 7 June 1996. The fee was not paid by that date or during the six months allowed under section 25(4) upon the payment of the prescribed additional fees. The patent therefore lapsed on 7 June 1996. The application for restoration of the patent was filed on 19 June 1997 within the 19 months prescribed under rule 41(1)(a) for applying for restoration. After considering the evidence filed in support of the application for restoration an official letter issued on 10 December 1997 informing the proprietor that the Office was not satisfied that the requirements for restoration, as laid down in section 28(3), had been met.

2. In a letter dated 16 December 1997 Tunnard Crosfield, solicitors acting for Mr Carrington, informed the Patent Office that Mr Carrington wished to be heard in the matter. However, after agreeing to a hearing date of 6 March 1998 Mr Carrington wrote to the Office on 26 February 1998 stating that because of a severe electric shock he sustained in 1996, which continued to affect his concentration, he did not wish to attend the hearing as he could not focus enough to answer questions. He also informed the Office that he did not intend sending anyone to represent him at the hearing in his absence. In the circumstances, it will be necessary for me to consider the application for restoration on the basis of the evidence Mr Carrington has filed.

3. The evidence consists of two statutory declarations by Mr Carrington dated 10 March 1997 and 1 October 1997.

4. In his statutory declaration of 10 March 1997 Mr Carrington confirmed that on 6 July 1996 he received the official renewal reminder notice, which the Patent Office is obliged to issue in

accordance with rule 39(4) of the Patents Rules 1995 (rule 39(4) reminder notice), informing him that the renewal fee on the subject patent was overdue. He then goes on to say *"As a result of an error the letter was misfiled and payment of the fee was consequently overlooked."*

5. The Patent Office subsequently wrote to Mr Carrington on 18 August 1997 seeking a further sworn statement explaining the detailed arrangements he had established for reminding himself when the renewal fee fell due and the circumstances under which the rule 39(4) reminder notice was mislaid and payment of the renewal fee overlooked. In reply to that letter Mr Carrington filed his second statutory declaration dated 10 October 1997. In that statutory declaration he says that he relied on the rule 39(4) reminder notice to remind him when to pay the renewal fee. After receiving the reminder notice dated 6 July 1997, which he attached as an exhibit to his statutory declaration, he says he *"used it to make notes of a telephone conversation ..... as it was the only paper available at the time of that conversation to make those notes."* He goes on to say *"The pieces torn from it relate to other messages"* and then concludes by saying *"The Letter was thereafter submerged among the other papers on my desk, and its significance was lost"*.

6. Those then are the salient parts of the evidence. What I now have to decide is whether or not the proprietor has met the requirements for restoration as set out in section 28(3) which provides:

*"If the comptroller is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee."*

7. In determining whether or not Mr Carrington has met this requirement I need to be satisfied that he took active steps to ensure that the sixth year renewal fee was paid. As a first step he should, at the very least, have established arrangements to remind himself when to pay the renewal fee. Having been reminded, he then has to take active steps to see that the fee is paid in time.

8. It is generally held that it is reasonable for an individual in a small way of business, who has

taken upon himself to pay renewal fees without professional assistance, to rely on rule 39(4) reminder notices. I am satisfied, therefore, that Mr Carrington took reasonable care to be reminded when to pay the sixth year renewal fee on the patent. However, to rely on that single reminder means that it was imperative that he treated it with care and took decisive action. If he chose not to pay the renewal fee immediately on receipt of the reminder he should at least have placed it in a safe place where he knew it would receive his attention or have made some kind of diary note to act on it later.

9. There is no evidence that Mr Carrington had established any arrangements for dealing with rule 39(4) reminder notices. Moreover his action in using it as note paper is a clear indication that he failed to respect its significance and to act upon it by taking positive steps to see that the renewal fee was paid.

10. I do not believe that Mr Carrington's failure to act on the official reminder notice can be put down to an isolated error as it is apparent from looking at the reminder that he did not use it to record just one telephone conversation but used it to record numerous messages and rough notes both on the front and reverse as well as on the two pieces he tore off. I have little doubt that Mr Carrington's action in using the official reminder as scrap paper contributed to him mislaying it and so failing to ensure that the renewal fee was paid in time. Indeed, it was almost inevitable that the reminder would be mislaid and not acted upon after being used in this way, particularly after Mr Carrington turned it over to make notes on the blank reverse side. His action falls well short of what could be regarded as taking reasonable care.

11. In conclusion, I am not persuaded that the proprietor took reasonable care to see that the sixth year renewal fee was paid and, therefore, I am not satisfied that the requirements of section 28(3) have been met. Accordingly, I must refuse the application for restoration. Any appeal against this decision must be lodged within six weeks of the date of this decision.

Dated this 12<sup>th</sup> Day of March 1998

**M C Wright**

Senior Legal Adviser, acting for the Comptroller

**THE PATENT OFFICE**