

PATENTS ACT 1977Pat / Linda
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IN THE MATTER OF an application by
Robert Saunders (Chigwell) Ltd for
restoration of UK Patent 2148967.

DECISION

The renewal fee in respect of the 11th year of the patent fell due on 4 November 1993. The fee was not paid by that date or during the further six months allowed under Section 25(4). The patent therefore lapsed on 4 November 1993. The application for restoration was filed on 1 June 1995, that is within the 19 months prescribed under Rule 41(1)(a). After consideration of the evidence filed in support of the application for restoration, an official letter issued on 24 October 1996 informing the proprietor that the Office was not satisfied that the requirement for restoration laid down in Section 28(3)(a) had been met. The matter came before me at a hearing held on 28 February 1997. Mr H R Saunders of Robert Saunders (Chigwell) Ltd was accompanied by his representative Mr Michael Jaques of Nicholas Morris (Solicitors). Mr Ian Sim attended on behalf of the Patent Office.

The evidence filed before the Office consisted of three statutory declarations: one from the then agent Keith Wilfred Nash of K W Nash and Co attesting that reminders had been sent and enclosing copies of these reminders; one from Mrs Saunders, who dealt with Mr Nash on behalf of the company, attesting that she was in hospital over part of the period when the reminders were sent and had seen nothing from the Patent Office; and one from Mr H R Saunders attesting that any letters addressed to his wife were not opened by himself but were forwarded to her, and implying that Mrs Saunders has acted to damage the company and himself. The Office took the view on the basis of these affidavits that there is no evidence to show that Mrs Saunders made any attempt to pay the renewal fees, though she was the individual responsible for so doing, that in all probability the reminders had been sent, and that Mr Saunders had not taken any action at all regarding the payment of the renewal fee. At the hearing Mr Saunders took a different

approach and alleged that the duty to exercise reasonable care had been carried out by the appointment of Mr Nash as an agent but that the agent had failed in his duty of care and had not reminded the company of the need to renew the patent, and had not sent out the reminders. Mr Saunders stated that he had been in regular communication with Mr Nash about licensing the patent and that at no time had Mr Nash mentioned the need for renewal. Although Mr Saunders was in contact with Mr Nash concerning the licensing of the patent, it was not until 28 November 1994 that the need for renewal was raised by Mr Nash when he wrote that he had been unaware of the renewal situation because the handling of renewals was the responsibility of the firm's renewal department.

The circumstances surrounding this case are unfortunate. During the time when renewal was possible communication between Mr and Mrs Saunders was not good, and there has been a breakdown of communication within K W Nash & Co. I have every sympathy with Mr Saunders and the predicament in which he finds himself. However, Section 28 does require me to establish whether reasonable care was taken to see that the renewal fee was paid. On the totality of evidence before me, the system of renewal was that K W Nash & Co would send reminders to the company; the company, Mrs Saunders probably, would confirm that the renewal should be paid; and K W Nash & Co would then pay the renewal. This system worked up until the 11th year and I am not persuaded that the reminders were not sent for that year. Mr Saunders' evidence changes from not knowing whether the reminders were sent, by stating that anything addressed to his wife was passed on (though it is not clear that these reminders were in fact addressed to his wife rather than addressed to the company for the attention of Mrs Saunders) to a definite statement that the reminders were not sent. Here, however, there is some ambiguity. During the hearing Mr Saunders stated that one of the reminders had been received, but that this was too late. It is not clear whether by this "reminder" Mr Saunders means one sent in 1993 or the 1994 letter. Mr Saunders admits to being thoroughly confused at that time and not really knowing what he saw. It is clear from the evidence that prior to May 1994, K W Nash & Co were in correspondence concerning licensing of the patent and, presumably, Mr Nash was in correspondence with Mr Saunders. Mr Saunders says that because of this, he assumed there would be no problem with the patent and thus, by his own admission, took no steps to renew it. The breakdown in communication within K W Nash & Co is regrettable but cannot, in my view, absolve the proprietor from his responsibilities. On the basis of the evidence, I believe that the

letters were sent and delivered but that in the confused circumstances of the time no action upon them was taken. Whilst it would have been wise for Mr Nash to check the situation, it was not incumbent upon him to do so.

In conclusion, I am not convinced that the proprietor took reasonable care to see that the renewal fee was paid and therefore I am not satisfied that the requirement of Section 28(3) has been met. Accordingly I refuse the application. Any appeal against this decision must be lodged within six weeks of the date of this decision dated this 18th day of March 1997.



R J MARCHANT
Assistant Comptroller
Acting for the Comptroller



THE PATENT OFFICE