

B. L. O. / 044 / 184

IN THE MATTER OF an application
for the Restoration of Patent
No 1467044

DECISION

Patent No 1467044 dated 10 July 1974 was sealed on 13 July 1977 to Peter Maurice Whiteside. It lapsed on 10 July 1982 on failure to pay the renewal fee for the ninth year. The six month grace period in which renewal was still possible by the payment of extra fees expired on 1 January 1983 without such payment and application for restoration under Section 28 was filed on 7 July 1983. The Office expressed the view that it was not satisfied that, as required by Section 28(3), the proprietor had taken reasonable care to see that the renewal fee was paid within the prescribed period and that the fee was not paid because of circumstances beyond his control. A hearing was requested which took place before me on 9 February 1984 and at which Mr H N Matthews appeared as Agent for the proprietor.

The evidence shows that Mr Whiteside, who resided in Australia, assigned a number of patents, including the one in suit, to his wife, Sylvia Marion Letitia Whiteside, on 10 June 1980 shortly before his death on 14 June 1980. The renewal fees due in July 1980 and 1981 were paid without any hitch following reminders sent to Mrs Whiteside by the Australian Patent Attorney, Mr Wray, who deposes that he sent reminders concerning the 1982 renewal fee to Mrs Whiteside on 19 April 1982 and 26 May 1982.

Having received no instructions, Mr Wray made enquiries after an unspecified delay and discovered that Mrs Whiteside was in the United States of America. Accordingly he states that he was unable to instruct his British Associates to pay the renewal fee. It was not until June 1983 that Mrs Whiteside made enquiries of Mr Wray as to the status of the patent, whereupon this application for restoration was initiated.

Mr Matthews submitted that whereas the application for restoration may be made under Section 28(2) by the "proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect", it was the proprietor of the patent who was mentioned in

Section 28(3). He went on to argue that this must mean the registered proprietor who was Mr Whiteside, and because he had died at the time when renewal was due in 1982, the fees were not paid because of circumstances beyond his control. He drew my attention to the (unreported) decision of the Assistant Comptroller in the application of Border ES (Design and Development) Ltd for restoration of Letters Patent No 1437122, (Science Reference Library O/157/79), in which Mr Fergusson considered the question of what was meant by the reference to 'any other person' in Section 28(2). Having had his attention drawn to the Encyclopedia of United Kingdom and European Patent Law by Blanco White et al, which, at 6-123, note 76, equates the expression with "prospective proprietor", Mr Fergusson said "In my opinion, the reference to any other person who would have been entitled to the patent if it had not ceased to have effect is someone to whom the patent might have been assigned after the date of lapsing in ignorance of the fact of lapsing" (emphasis added). It is to be noted also that Sections 28(2) and (3) refer only to the proprietor and not to the registered proprietor, within the meaning of Section 33. I conclude therefore that Section 28 is referring to the proprietor in the sense of being the person who owns the rights to the invention or is the prospective owner of such rights, whether or not a claim to such rights has been registered with the Comptroller under Section 33. In the present case, the registered proprietor is Mr P M Whiteside but in my view the proprietor in the sense of being the owner of the rights to the invention has been Mrs Whiteside since the assignment of 10 June 1980. Certainly, the payment of the 1980 and 1981 renewal fees must, I consider, be taken to have been in response to her instructions, and accordingly I hold that for the purposes of Section 28 she was the proprietor at the relevant date in 1982.

That being so, I have to consider whether her actions are such as to meet the stringent requirements of Section 28(3). Mr Matthews argued that payment of patent renewal fees could be likened to payment of normal domestic bills but in Ling's Patent [1981] RPC 85 at page 88 Mr Fergusson indicated that he did not regard this comparison as valid, patent renewal fees being in respect of a valuable property, non-payment of which would entail serious loss of rights, and a bill entailing a payment which it is in the creditor's interest to pursue. Mr Matthews also suggested that she could not be expected to set up a special system to ensure payment of a single patent, but in fact the schedules of the assignment show that she acquired the rights to two patent applications and six granted patents, some of which appear to involve the payment of renewal fees. Moreover, at the relevant time in 1982 she was

abroad in the United States of America and had evidently not thought to inform her Attorney, Mr Wray, of her movements. The evidence does not show when she left Australia but even if she was still in that country at the time she clearly did not respond to the reminders issued by Mr Wray in April and May 1982, and there is no indication that such reminders were not received.

In the aforementioned Ling's Patent 1981 RPC 85 at page 96 Mr Justice Whitford suggested that a failure to notify a change of address would not be indicative of taking reasonable care, and it could be argued, I suppose, that absence abroad without notification can be regarded as a similar lack of care.

If this had been the first renewal fee due since her husband's death, Mrs Whiteside might possibly have been excused for being unaware of the results of the failure to pay the fee. However, as I have explained the 1980 and 1981 fees were paid in response to reminders from Mr Wray, and if his letter of 19 April 1982 (Exhibit RCW3) is worded in similar terms to those sent in the earlier years, she will have had the warning "if it is not renewed the patent will lapse."

In my opinion, her departure to the United States of America without notice to Mr Wray and without instructing him to renew in the absence of instructions from her, is not compatible with the taking of reasonable care; nor can it be pleaded that the 1982 fee was not paid because of circumstances beyond her control. Accordingly, this application is refused.

Dated this 6th day of March 1984



D C L BLAKE
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

