

BLO/115/90-

PATENTS ACTS 1949 AND 1977

IN THE MATTER OF an application  
for the restoration of patent  
No. 1400096 in the name of  
Alexander Svetislava Jovanovic

DECISION

Patent No 1400096 dated 10 September 1973 was sealed on 12 November 1975. The patent lapsed on 10 September 1977 owing to failure by the proprietor, Mr A S Jovanovic, to pay the first renewal fee which fell due on that date and which was in respect of the fifth year of the patent.

The application for restoration which has been made by Mr V A Jovanovic, the patentee's son, was initially filed under Section 28 of the Patents Act 1977 on 27 September 1989. However, because the patent had lapsed before 1 June 1978, the date on which the Patents Act 1977 came into effect, the application for restoration, if it is to be considered at all, falls to be considered under section 27 of the Patents Act 1949. Section 27(1) of the Patents Act 1949 reads as follows:-

"27. - (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section twenty-two of this Act, and the comptroller is satisfied, upon application made within three years from the date on which the patent ceased to have effect, that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall by order restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent."

The reference in that section to the period for paying the

renewal fee being extended under section 22 relates only to an extension of a matter of a few months upon request being made to the comptroller and is not of any significance as far as the present application is concerned.

It is apparent therefore that there is embodied in the relevant statute a limitation of 3 years as the maximum period during which an application for restoration could be made following the lapse of a patent. The present application is well outside that limit, but it cannot be rejected out of hand because rule 100 of the Patents (Amendment) Rules 1987 has a bearing on time limits specified under the 1949 Act.

The relevant parts of the rule are:-

"100. - (1) Subject to paragraph (2) below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.

(2) Where the irregularity in procedure consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968(b), as they continue to apply, the comptroller may direct that the time or period in question shall be altered if the irregularity is attributable wholly or in part to an error, default or omission on the part of the Patent Office, but not otherwise."

The office was not satisfied, from the evidence filed by Mr V A Jovanovic, that there was a case under Rule 100(2) for extending the period for paying the renewal fee, and so the matter came before me at a hearing on 24 September 1990 at which Mr V A Jovanovic appeared in person and the office was represented by Mr M Wright.

The crux of Mr Jovanovic's case is that his father, the patentee, had not received any official letter of reminder or warning or intimation of the costs of the annuities either before or after the sealing fee was paid. To the best of his knowledge and belief, no official letter of reminder was ever received by his father who remained convinced, until the day he died in April 1989, that the patent was fully in force and would remain so until 10 September 1989 when a renewal fee would become due.

At the hearing Mr V A Jovanovic argued that the fact that his father had exhibited and gained an award for his invention, the subject of the patent, supported the contention that his father was convinced that the patent was in force. He laid stress on the fact that this was the first patent which his father had applied for, and that a mass of paperwork was involved in making parallel applications in a large number of foreign countries.

As I understand it, what this submission comes down to is that somehow, perhaps due to the patentee's inexperience in patent matters and the complexity of dealing with a number of foreign applications, he mistakenly thought that all the necessary fees had been paid at the correct time, and the extra information from the office needed to put the patentee back on the right track was missing.

For my part I do not consider that the office was under any obligation to take steps to ensure that the proprietor of a patent was made aware of the cost of renewing his patent or to vary its standard procedures to take account of the particular circumstances of an individual patentee about which circumstances it could have little or no knowledge.

The form of letters patent issued at the relevant time included on the reverse side a series of notes making it quite clear that renewal fees had to be paid from the fourth anniversary of the patent onwards if the patent was to remain

in force. These notes were present on the form of letters patent issued by the office to the patentee in this case. I do not think that there was any statutory requirement for the office to issue warning notes of this kind, but it had become a standard procedure and was adhered to in this instance.

There was a statutory requirement under rule 68 of the Patents (Amendment No 2) Rules 1971, for the office to issue an official notice not later than six weeks after a renewal fee fell due on a patent, reminding the patentee that payment was overdue and of the consequences of non-payment. Mr Jovanovic maintains that his father never received such an official reminder. He has made a careful search and has found nothing. It is not altogether surprising that there is now no trace of a letter which, if received at all, would have been received more than 13 years ago. The fact that Mr V A Jovanovic has been unable to find such a letter after that length of time is not strong evidence in my view that the letter was never received by his father, still less is it proof that no such letter was issued by the office.

Unfortunately, despite having made a thorough search, the office itself can throw no light on the matter of whether the official reminder letter in respect of this patent was issued or not, because renewal records that far back are no longer available. Taking into account the many thousands of reminder notices sent out by the office annually, the overall probability that a notice was not issued in respect of this particular patent must be very small, but that does not mean that the possibility of failure by the office to issue the notice can be disregarded altogether.

There is more to it than that however. Any failure by the office to issue the statutory reminder notice must be shown to have played an active causative part in the failure to pay the renewal fee within the prescribed period, extended or otherwise, if the comptroller is to be empowered to alter the time limit for making this application for restoration.

It is not at all clear to me how it was that the patentee gained the mistaken conviction that the patent would remain in force for a 16-year term without the payment of annual renewal fees. Mr V A Jovanovic himself concedes on the application Form 16/77 that he cannot be sure of the reason why annual payments were not made. At the time in question, it was not possible to pay patent renewal fees for more than one year in advance, though it had previously been possible to do so up until 20 June 1975 - the Patents (Amendment No.2) Rules 1975. Also, I do not think it likely that the patentee could have mistaken the payment of the £17 sealing fee, paid on a form specific to sealing a patent, as payment of renewal fees for sixteen years in advance.

Nevertheless, and despite the wording of the notes on the reverse side of the issued letters patent, the evidence is that the patentee had gained that conviction. If that was the case, the patentee could not have been relying on the receipt of a reminder notice to alert him when payment was overdue. The more difficult question is "would receipt of the reminder notice have shaken that conviction sufficiently for him to have made the appropriate enquiries and taken the appropriate action?", bearing in mind that, as Mr V A Jovanovic has said, his father would not have taken the notes on the letters patent form as a warning because of his conviction that all necessary fees had been paid.

It seems to me that all that can be concluded with reasonable certainty is that, if no reminder notice was received by the patentee, that non-receipt could not have been the primary cause of the mistaken conviction that the patent would remain in force for sixteen years without payment of further fees.

Hence it has not been established to my satisfaction that the statutory reminder notice under rule 68 was not issued by the office or that any failure to receive such notice played a substantial part in the failure to pay the first renewal fee. Because of his conviction that all necessary fees had been

paid the patentee made no attempt or preparation to pay the fee, despite the clear warning which had been transmitted to him upon sealing of the patent, and I do not believe that it was the intention that rule 100 should be used to provide relief under such circumstances.

In the result therefore I find that there is insufficient justification for me to be able to apply rule 100 of the Patents (Amendment) Rules 1987 to alter the time limit prescribed under section 27 of the Patents Act 1949 for the making of an application for the restoration of the patent. Accordingly the application is not entertained and the patent remains lapsed.

For completeness I should add that the application of rule 100 is at the discretion of the comptroller. The matter of delay in seeking relief would be a factor to be considered in deciding whether or not that discretion should be exercised. Furthermore, consideration of delay in seeking restoration is mandatory under section 27 of the 1949 Act. It could well be argued that the patentee ought to have realised at some time during the lengthy period which elapsed after the patent was sealed that annual renewal fees were payable, for example when he started to pay annual renewal fees on another patent which he obtained in 1986, if not from the date when the letters patent were received by him. This is notwithstanding the fact that Mr V A Jovanovic acted very promptly once he had checked the status of the patent following a certain amount of commercial interest being shown in the patented device during 1989.

Dated this 15 day of October 1990

K E PANCHEN  
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE  
KP4AAK