

PATENTS ACT 1977

IN THE MATTER OF applications by
David Johnson Burns for the restoration
of Patents Nos 2227224 and 2227469

01527/95

DECISION

Patent No 2227224 is dated 15 September 1988 and was granted to Mr Burns with effect from 31 March 1993. Patent No 2227469 has the same date but was granted with effect from 9 December 1992. Both patents lapsed for failure to pay the renewal fee in respect of the sixth year by the due date of 15 September 1993 or in the following six months as allowed under section 25(4) upon payment of an additional fee. The applications for restoration were filed on 20 July 1994 within the period allowed under rule 41(1). The Office did not consider that a case for restoration had been made out, and the matter came before me at a hearing on 17 March 1995, the proprietor being represented by counsel Mr Guy Tritton.

Evidence in the form of statutory declarations by Messrs Campbell and Goutcher of Fitzpatricks, Chartered Patent Agents, Ms Jones of Fitzpatrick & Cie, an associated renewal specialist firm based in Monaco, and Mr Burns himself were filed before the hearing. I also admitted a second statutory declaration by Mr Burns which was handed to me at the hearing.

Mr Burns was informed by Fitzpatricks in October 1992 that '469 would be granted on 9 December, that the renewal fee for the fifth year would be due by 9 March 1993, and that for the sixth year the renewal fee would be due on 15 September 1993. Fitzpatricks similarly informed Mr Burns in February 1993 that '224 would be granted on 31 March 1993, that the renewal fee for the fifth year would be due by 30 June 1993, and that for the sixth year the

renewal fee would be due on 15 September 1993. This information was repeated in further letters to Mr Burns from Fitzpatricks dated 15 December 1992 and 6 April 1993 in relation to '469 and '224 respectively. Mr Burns received each of these letters but neither of the fifth year renewal fees was paid by the respective due date.

Mr Burns received another reminder dated 24 May 1993 in respect of the renewal fee payable on '469 (which was overdue from 9 March 1993) and in respect of the renewal fee payable on '224 (which was due on 30 June 1993). Mr Burns was advised to pay the fee on '469 by 9 June 1993 in order to avoid extra charges, and the fee was in fact paid on 9 June. Two more reminders dated 24 June 1993 and 6 August 1993 were received by Mr Burns in respect of the fifth year renewal fee on '224 (overdue from 30 June), the latter reminder also clearly stating that the renewal fee for the sixth year of this patent would fall due on 15 September 1993 and that Fitzpatrick & Cie would be seeking instructions from him. Mr Burns was also advised to pay the fees for the fifth and sixth years together to save cost. The payment of the fifth year renewal fee on '224 was completed on 28 September 1993 and on the following day Fitzpatricks wrote to Mr Burns confirming that the fee had been paid and advising him in these terms:

"Your patent (ie '224) has now been renewed up to 15 September 1993 so the Year 6 renewal fee is now outstanding and overdue. Our sister company Fitzpatrick & Cie of Monaco has already contacted you with regard to the Year 6 renewal fee, so please instruct Fitzpatrick & Cie at the earliest so that they can attend to payment of the Year 6 renewal fee and keep the cost of extension fees to a minimum."

At this point I do not believe Mr Burns can have been in any doubt that the sixth year renewal fee on '224 was overdue or that there was a limited period during which the fee could still be paid.

When a patent is granted after the fourth anniversary of the filing date, as happened with each of the present patents, it was the practice of Fitzpatricks to handle the payment of the

first renewal fee due after grant themselves and to pass on the necessary information to Fitzpatricks & Cie in Monaco for them to handle the subsequent renewal fees due on the anniversary date of the patent. The transfer of information for these patents took place in July 1993, but Mr Burns had not received any communication from Fitzpatricks & Cie up to the time the 29 September letter had been sent and, I accept, never did receive anything from them.

The evidence of Ms Jones is that the records of Fitzpatricks & Cie indicate that reminders about the sixth year fees due for both patents on 15 September 1993 were sent out in July 1993 (there is some inconsistency in the evidence of Ms Jones as to the exact date) and 12 August 1993, with a final reminder being sent on 1 October 1993 - just two days after the last letter from Fitzpatricks relating to '224. Mr Burns seems to have made adequate arrangements for his mail to be dealt with properly and, if he was away on business, as he frequently was, to be handed to him on his return. There had been some problems with mis-delivery of mail by the Post Office, and that may be the reason why this series of reminders went astray. Whatever the reason, and although Mr Burns says that if he had received these reminders he is sure that he would have taken the matter up with Fitzpatricks to ensure that the two patents remained in force, their non-delivery does not appear to me to be of any importance in relation to the failure to pay the fee on '224 because they closely overlapped the series of letters from Fitzpatricks which Mr Burns clearly did receive.

Fitzpatricks sent two final letters dated 20 October 1993 enclosing the official overdue reminders for '224 and '469 issued by the Office and again I accept that these were not received by Mr Burns. This was the only correspondence which should have arrived noticeably later than the 29 September letter which Mr Burns received for '224, but even so it would only have been three weeks later. He had been told more than once when the sixth year fee on '224 was due, and had been warned that the fee was overdue less than a month before the official overdue reminder should have reached him. In my view Mr Burns had received ample warning that the fee on '224 was due to be paid by 15 September, and I do not consider that the non-receipt of the official overdue reminder was a factor of any

significance in his failure to pay the fee because it would have followed so closely upon the 29 September letter and because it would not have told him anything he did not already know.

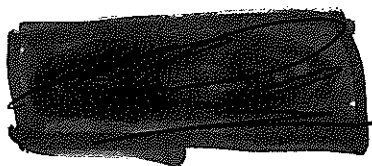
The letter dated 29 September from Fitzpatrick's stated that Fitzpatrick's & Cie had already contacted Mr Burns about the overdue sixth year renewal fee, yet he did not take up the matter of the missing correspondence with either firm at the time or when he visited the offices of Fitzpatrick's later in 1993 or in the months which followed during which he still heard nothing. For their part Fitzpatrick's would have assumed that the matter of the sixth year fee was in the hands of Fitzpatrick's & Cie. Given that Mr Burns was well aware that the renewal fee on '224 was overdue, his failure to make sure the fee was paid and his failure to take any steps to ascertain why he had not received any mail from Fitzpatrick's & Cie convince me that he did not exercise reasonable care as required by section 28(3). I do not accept, as Mr Burns suggests, that it would have been necessary for him to have received the reminders from Fitzpatrick's & Cie so that he would know the correct amount to pay. It would have been a simple matter for him to find out the amount if it had not already been made clear to him in precise terms. If Mr Burns nevertheless felt that he needed the correspondence before he could pay the fee, then that would be all the more reason why he should have made enquiries about its non-arrival.

As far as '469 is concerned, Mr Burns had not been reminded of the need to pay the sixth year renewal fee since December 1992. If it had been only the failure to pay that particular fee which needed to be considered, I might have been able to accept that the failure to pay the fee had been entirely due to the failure in an otherwise perfectly reasonable system which was in place for the payment of the fee. However, under the circumstances I do not believe it would be proper for me to consider what happened in relation to '469 in isolation. Mr Burns must have been aware that the two patents had the same date and the same anniversary date on which the renewal fee for the sixth and subsequent years fell due. If any doubt had existed in his mind over this he could easily have resolved it by reference to the correspondence he had to hand. He had received several reminders on '224 running up to and

beyond the due date, yet he did not question why he had not received any further communications regarding the sixth year renewal for '469. I do not consider that, by this inaction, Mr Burns exercised the degree of care which would have been reasonable under the circumstances.

In conclusion, I am not satisfied that Mr Burns took reasonable care to see that the renewal fee in question was paid on either patent and in both cases I refuse to order restoration.

Dated this 5 day of APRIL 1995



K E PANCHEN
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE