

BLO/121/84

PATENTS ACT, 1977

IN THE MATTER OF an application
by Satoshi Nakamura for the
Restoration of Patent No 1513967

DECISION

Patent No 1513967 in the name of Satoshi Nakamura expired on 8 August 1982 on failure to pay the renewal fee for the eighth year. The six month grace period in which renewal was still possible by the payment of extra fees expired on 8 February 1983 without such payment, and an application for restoration was filed on 27 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 10 July 1984 at which Mr R Chinnery appeared as Agent for the proprietor.

Mr Chinnery explained that the proprietor is resident in Japan and the 1979 and 1980 renewal fees had been paid through the proprietor's Japanese patent agent, Mr Ishida, using the services of Computer Patent Annuities (CPA). The sum due to CPA for 1980 was not paid and when they failed to get instructions from Mr Ishida in respect of the 1981 renewal they obtained the proprietor's address from the UK patent agents, Edward Evans & Co, who had acted for him when the patent was being prosecuted to grant. CPA wrote direct to Mr Nakamura in April 1981 explaining the need to pay the renewal fee by 8 August 1981 and mentioning the question of the outstanding debt. It is not clear from the evidence when this letter reached Mr Nakamura but he replied to CPA by cable dated 3 August 1981, just in time for them to pay the 1981 fee. In his first declaration he states that "I understood that they (CPA) would send me reminders for future years, and I would respond to those reminders to obtain renewal of the patent" and Mr Chinnery confirmed that it was his understanding that CPA should deal directly with Mr Nakamura in the future. Although in my opinion the cable does not clearly indicate that this was the intention of the proprietor, I am prepared to accept for the purposes of these proceedings that CPA regarded it in that manner, because in May 1983 a final reminder from CPA in respect of the fee due in August 1982 was received by Mr Nakamura. That reminder bears the date 23.12.82 and if delivered promptly would have enabled

Mr Nakamura to have responded before 8 February 1983, ie the end of the grace period allowed by Section 25(4).

Unfortunately, as he states, when he received the reminder he did not realise it related to the 1982 fee but believed it to be in connection with the 1983 fee. In fact three previous reminders had been sent by CPA and not received by him and the final reminder had taken five months to reach him. He attributes these occurrences to the fact that in 1978 the authorities in his home town, Kumagaya City, had introduced new ways of indicating postal addresses, including his own. Before that time his postal address had been 556 Oaza Hakoda, Kumagaya City, and this was the address he gave in the cable sent in August 1981 to CPA who, understandably, sent their reminders to that address. In reality his correct postal address since November 1978 had been 4-18, Hakoda 2-chome, Kumagaya City but he states that he did not regard the precise form of his address to be very serious because he had not in fact moved his home and other mail was getting through even though addressed to the former address, and of course he had received CPA's letter of April 1981 sent to his old address.

The reasons for the changes are described in a declaration from a Mr Masami Kasai who is a member of the Municipal Assembly of Kumagaya City. He explains that although they refrained from imposing penalties in order to enforce the use of the new addresses, the citizens were told they "must use the new postal address themselves and they must be thoroughgoing in instructing this change to all of their business or private associates". He states that after about two years he became aware of complaints of mail going astray but there is no evidence to show that Mr Nakamura was aware of this.

Nevertheless in spite of this advice from the authorities, Mr Nakamura failed to use the new address when he communicated with CPA and he states in his declaration No 2 that "I must admit part of responsibilities that I was not strictly thoroughgoing in instructing this change to all of my business associates and customers including CPA immediately after enforcement." However in a declaration No 4 he suggests that he believes he intended to give his new address to CPA in the 1981 cable but accidentally gave them the old address. Such a mistake would have been more understandable if it had occurred in the early days after the change in 1978 but the cable was sent nearly 3 years afterwards and I find the proprietor's belief hard to credit. Mr Chinnery sought to compare the use

of the old address with the omission of postcodes in this country but as I indicated at the hearing I do not regard the two situations as analogous in that the postcode is intended to supplement and form part of the address, whereas it is clear that the new address in Japan was intended to replace the old address.

It is well established that it is regarded as reasonable for a proprietor to rely upon reminders from a professional adviser or from the Patent Office and that it is not necessary for him to establish diary records. In the present case, I accept that Mr Nakamura's reliance upon the receipt of reminders from CPA was reasonable and satisfies the requirements of Section 28(3)(a). However in Ling's Patent and Wilson's and Pearce's Patent [1981] RPC 85 at page 96, Mr Justice Whitford observed that "If the proprietor were to fail to take adequate care to notify the Patent Office of a change of his address, then failure to receive the statutory notice would undoubtedly be his fault."

It seems clear in the present proceedings that CPA issued reminders to Mr Nakamura and that he failed to receive them because of his admitted failure to inform them of his new address. It is difficult to appreciate the problems of a lone proprietor in a distant land faced with the maintenance of a patent in the UK, and I appreciate that he may have been lulled into a sense of false security by the fact that some post was getting through to him. Nevertheless, whilst I have every sympathy for Mr Nakamura in the situation in which he finds himself, I consider that the failure to pay cannot be said to be due to circumstances beyond his control.

Accordingly the application is refused.

Dated this 31st day of July 1984

D C L BLAKE

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

