

PATENTS ACT 1977

IN THE MATTER OF an application
by Raws Sharif bin B M Sharif
for the restoration of Patent No
2195060

DECISION

Patent No 2195060 dated 30 August 1986 was granted on 16 January 1991. The first renewal fee fell due on 16 April 1991 but was not paid by that date or in the following six months as allowed under section 25(4) upon payment of an additional fee. The patent accordingly lapsed on 16 April 1991. The application for restoration was filed on 28 July 1992 within the period prescribed by Rule 41(1), though without full supporting evidence at that time.

Mr Sharif had telephoned the Office on 23 July 1992 about his patent, presumably from Malaysia where he has his home, and in response the same day the Office transmitted by facsimile a copy of a Form 16/77 on which to make an application for restoration. He was also given the name and telephone number of an officer to contact if he wanted further advice. The completed form was received in the Office on 28 July accompanied by the required fee, and a certified copy of a letter dated 3 December 1990 from Mr Sharif's employer notifying him that he had been selected to undertake survey work in Indonesia for an unspecified period commencing on 2 January 1991. The covering letter which Mr Sharif sent with the application explained that the reason why the renewal fee had not been paid was because his mail had not been opened while he was away on the Indonesian assignment.

The Office responded to this on 30 July 1992 by faxing Mr Sharif copies of the relevant sections of the Act and Rules together with a letter explaining what was required in an application for restoration in the way of evidence and asking for an address for service in the UK as required by Rule 30. A copy of the letter was also posted to the patent agents registered as address for service, though it was clear from Mr Sharif's covering letter that he would not be using a patent agent.

On 16 September 1992 the Office received a sworn affidavit from Mr Sharif and, in the accompanying letter (wrongly dated 12 July 1992), the name and address of a person who would act as address for service in the UK. On 19 October 1992 the Office wrote to Mr Sharif via the UK address for service requesting further evidence to expand on and clarify that already provided. This further evidence was received by the Office on 21 December 1992, an advance copy having been faxed and received on 15 December.

After considering all the evidence, the Office sent an official letter to Mr Sharif on 27 January 1993 expressing the view that Mr Sharif had failed to make adequate arrangements to deal with his correspondence while he was away from home and had failed to contact his patent agent so that a *prima facie* case for restoration of the patent had not been made out. The customary warning was given that the application would be refused unless a hearing was requested within one month of the date of the official letter.

No reply having been received in the specified time, the Office wrote again on 19 March 1993 (this time sent direct to Mr Sharif's address in Malaysia as well as to his address for service in the UK), allowing a further six weeks in which to request a hearing. A request to be heard was contained in a letter from Mr Sharif dated 24 April 1993 and received on 29 April. Official letters attempting to carry the appointment of a hearing forward were then issued on 14 May, 7 September and 21 October 1993, the latter warning that, since no reply to the previous letters had been received, unless within one month Mr Sharif proposed a date for the hearing, a date would be appointed at fourteen days notice. All three letters were sent direct to Malaysia as well as to the UK address for service.

By 25 November 1993 still no reply had been received from Mr Sharif and so an official letter was issued appointing a hearing on 15 December 1993. Mr Sharif sent a message on 9 December saying that he would not be able to attend a hearing on that date and requesting that it be postponed until after 15 March 1994. The Office acceded to this request and on 15 December 1993 allowed Mr Sharif one month in which to propose a date subsequent to March 15, but as no reply was received within that time, by an official letter dated 8 February 1994, the date of 18 March 1994 was appointed for a hearing.

In the event, Mr Sharif or his representative did not appear at the appointed time and place, and I make this decision on the basis of the evidence provided, though I have taken careful note of everything that Mr Sharif has said in the somewhat protracted correspondence in these proceedings.

Mr Sharif's assignment in Indonesia ran from 2 January 1991 until 13 July 1992. During that time mail, including a letter dated 15 April 1991 from his patent agent enclosing the certificate of grant and notifying him that the first renewal fee would be due on 16 April 1991, was delivered to his home address but remained unopened and unread until Mr Sharif's return in mid-July 1992. The agent's letter would have been delivered on or after the due date, but it may be safely assumed that it arrived within the six months grace period during which the renewal fee could still be paid. It is clear that it would have been impossible for this particular letter to have been sent prior to Mr Sharif's departure. Moreover, it is doubtful if any prior notice of grant could have reached him before the beginning of 1991 as the notification under section 18(4) that the patent application complied with the Act and Rules was not issued by the Office until 21 November 1990. The official overdue reminder PREN5 was issued on 15 May 1991 so its apparent non-receipt by Mr Sharif is of no significance to this application for restoration.

I have given careful consideration to the fact that Mr Sharif is a foreign national who was not conversant with patent applications and patents, that he says that his extended stay in Indonesia was not planned and that he was heavily engaged in field work deep in the jungle with a wireless set as his only means of communication, but I do not consider that his action in going off to such a remote and inaccessible place for an unspecified length of time (that much was spelled out in his letter of appointment) without making any arrangements whatsoever for someone to look into his mail during his absence showed the reasonable care required by section 28(3)(a).

Even if Mr Sharif was unable to entrust his business affairs to members of his own family during his absence, there must surely have been someone to whom he could turn for assistance or some arrangement he could have made with his employer to have his mail delivered to him along with the supplies of food and equipment which must have been ferried

to him from time to time during his eighteen months in Indonesia even if he was in the jungle for all of that period.

Mr Sharif left for Indonesia unaware that his patent had been granted and apparently thinking that the sums of money he had paid to his patent agent included the renewal fee, but whilst I can make some allowance for his confusion in thinking that he had already paid all the fees he needed to, it has become well-established that one of the prime needs in the exercise of reasonable care to see that renewal fees are paid is to make sure that anyone who might be sending important letters requiring a response or action is kept informed of any change of address. In Mr Sharif's case it would not have been straightforward to provide a forwarding address, but not impossible in my view, and I am sure that some alternative arrangement by which important correspondence would be dealt with during Mr Sharif's absence could have been organised.

In conclusion therefore I am not satisfied that the strict requirement of section 28(3)(a) that reasonable care is taken to see that the renewal fee was paid was met in this case and accordingly I refuse to make an order restoring the patent.

Dated this 11 day of APRIL 1994



K E PANCHEN

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE