

PATENTS ACT 1977

IN THE MATTER OF an application  
by Soldek Systems Ltd for the  
restoration of Patent No 2091311

DECISION

Patent No 2091311 is dated 19 January 1982 and was granted to Soldek Systems Ltd on 12 September 1984. The renewal fee in respect of the ninth year of the patent which fell due on 19 January 1990 was not paid by that date or within the six months grace period allowed under section 25(4) on payment of the renewal fee and the prescribed additional fee. The patent accordingly lapsed on 19 January 1990. The application for restoration was made on 22 August 1990, within the period prescribed by section 28(1).

The office having expressed the view that a prima facie case for restoration had not been made out, the matter came before me at a hearing held on 23 April 1991 at which the proprietor was represented by Mr P D Jenkins of Page White & Farrer, Chartered Patent Agents, and Mr M C Wright attended on behalf of the office.

Evidence in support of the application has been filed in the form of statutory declarations by Mr John Moore, the managing director of Soldek Systems Ltd the proprietor company, and Mr James O'Neill a solicitor and partner in a firm of solicitors O'Neill, Dempsey & Co engaged by the proprietor.

Renewal of the patent up to and including the 8th year was effected successfully by an arrangement involving firms of Irish and UK patent agents (Kelly and Page respectively) acting on instructions from a licensee company (Soldek International) which was responsible for maintaining the patent. Mr Moore was the managing director of Soldek International until 1988 when his business and travel

commitments left him with insufficient time to be involved in the day-to-day management of the licensee company, though he remained a non-executive director of that company.

Soldek International ceased trading in March 1989 and vacated their premises in Dun Laoghaire, County Dublin. Renewal reminders sent by Kelly to that address subsequently that year were not received by the proprietor Soldek Systems.

Soldek Systems is essentially a one-man, non-trading company, run by Mr Moore without any deputy or employees, and has no offices; hence an arrangement was made for using the address of the company's solicitors (O'Neill) as the company's registered office for the communication and collection of the small amount of mail directed to the company. The arrangement with O'Neill was that they would simply hold mail sent to Soldek Systems until Mr Moore called in to collect it, and this he did, apparently quite frequently, between March 1989 and November 1989. Any mail directed to O'Neill's address during that period did not include any reminders in respect of the approaching renewal date. That was because it was not until December 1989 that Mr Moore notified Kelly by telephone that reminders should be sent to Soldek Systems at O'Neill's address following the demise of the licensee.

During this same telephone conversation Mr Moore was made aware that renewal of the patent fell due in early 1990, but he did not take any action on this advice, apparently because he was not conscious of there being any immediate urgency in payment and because he had to arrange for Kelly to be re-imbursed for the payment of the 1989 renewal fee, which account had not been settled by the licensee.

There is no doubt that, for the renewal which fell due on 19 January 1990, Mr Moore was the person responsible for seeing that the fee was paid; for all practical purposes he must be regarded as the proprietor of the patent. He was dependent on receiving reminders from Kelly because he did

not keep a diary of patent renewals.

During the latter part of 1989 and on into 1990 Mr Moore's business commitments necessitated him being abroad, so that circumstances changed in that he was no longer able to collect the company mail in person from O'Neill. In fact Mr Moore paid no further visits to O'Neill's offices until the end of July 1990.

Mr Moore says that his omission to pay the 9th year renewal fee was discovered when he reviewed the company patent portfolio with a view to entering into licence negotiations with a Swiss company. It would seem likely that it was this discovery which prompted Mr Moore to visit the offices of O'Neill on 31 July 1990 and which led to him seeing for the first time a reminder dated 18 December 1989 and a subsequent reminder dated 30 January 1990 sent by Kelly to Soldek Systems at the address of O'Neill. By then it was too late to renew the patent, the extended period for payment of the renewal fee having expired some 12 days previously.

The reminder dated 30 January 1990 contained the warning that the deadline for renewing the patent and a corresponding Irish patent had passed and that, in the absence of immediate instructions, Kelly would presume that the patents had been allowed to lapse.

On 26 March 1990 Page, who are the UK address for service, forwarded to Kelly the official reminder, that the renewal of the patent was overdue. The reminder had been issued on 17 February 1990 in accordance with rule 39(4). Kelly replied to this by requesting Page not to pay the renewal fee unless specifically instructed to do so. The reason for this was that Kelly had not received any instructions to renew from Mr Moore.

I accept the submission made to me by Mr Jenkins that Mr Moore, who had been involved in renewing the patent over a

number of years, was aware of the availability of the six months extension of the period in which a renewal fee could be paid, and that the system set up in December 1989 was a reasonable one under the circumstances which had prevailed in the preceding few months.

However, in my opinion Mr Moore did not exercise reasonable care to see that the renewal fee due in January 1990 was paid because he failed to make alternative arrangements when it became apparent that he would be unable to play his part in the system he had set up, including collecting company mail at reasonably frequent intervals. There is nothing in the evidence which suggests to me that it would not have been possible for Mr Moore to keep in touch with the company solicitor or patent agent or to give them alternative instructions during the period of December 1989 to July 1990. By failing to do so Mr Moore effectively cut himself off from the final reminders sent out in January and March 1990.

Mr Jenkins referred me to Frazer's Patent [1981] RPC 53 where restoration was allowed on appeal to the Patents Court. In that case a lone proprietor entrusted the care of his patent to his solicitors and the failure to renew the patent was due to their failure to carry out instructions. There was no such failure in the present case, the patent agents and solicitors involved in the system played their parts exactly, and the failure to renew is to be laid firmly at the door of the proprietor.

The application for restoration is therefore refused.

Dated this

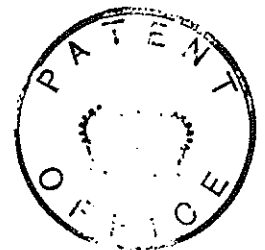
26<sup>th</sup> day of May

1991



K E PANCHEN

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE