

PATENT ACT 1977Pat / Linda
3Y60

IN THE MATTER OF an application
under section 28 for restoration
of patent GB2219102
in the name of Shakar Zargar Mohmand

PRELIMINARY DECISION

1. The renewal fee in respect of the sixth year of the patent fell due on 24 May 1994. The fee was not paid by the due date or during the six months allowed under section 25(4) upon payment of the prescribed additional fee. The patent therefore lapsed on 24 May 1994. The nineteen month period allowed under rule 41(1) of the Patents Rules 1990 for filing an application for restoration under section 28 expired on 24 December 1995 but it was not until 24 June 1996 that the proprietor Mr Mohmand filed his application for restoration with a request that he be given a "final chance to restore the patent".
2. The period prescribed in rule 41(1) for filing restoration applications is not extendable under rule 110, which deals with alteration of time limits, by virtue of the fact that rule 41(1) is listed in paragraph (2) of rule 110 as one of the excluded rules. In view of this, and the argument put forward by Mr Mohmand, the Patent Office considered whether there was a case for the Comptroller to exercise discretion under rule 100 to extend the period prescribed in rule 41(1). However, after considering the evidence the Office informed Mr Mohmand that it was not prepared to invoke rule 100.
3. Mr Mohmand, who currently resides in the USA, asked to be heard in the matter but informed the Office that because of immigration difficulties he would not be able to attend a hearing nor would he be sending a representative. In the circumstances, it will be necessary for me to consider the rule 100 issue on the basis of the evidence Mr Mohmand has submitted to the Office as a preliminary to any consideration of the request for restoration under section 28.

4. It would be useful to start by setting out rule 100 in its entirety in order to appreciate the extent of the discretion that is available to the Comptroller:

“Correction of irregularities

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) In the case of an irregularity or prospective irregularity-

(a) which 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 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;

(b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and

(c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller’s power to extend any times or periods under rule 110 or 111.”

5. Of relevance to the present case is paragraph (2) of the rule, bearing in mind that what is being considered is Mr Mohmand's failure to file the application for restoration within the time period prescribed in rule 41(1).

6. The evidence filed by Mr Mohmand consists of two sworn statements dated 14 June and 30 August 1996. In referring to his patent in his statement of 14 June 1996 Mr Mohmand says: "I would lose it because I have no complete information from the Patent Office". He goes on to say: "I was sure that you [the Patent Office] gave me a nineteen months from 24 November 1994, and not from 24 May 1994." Therefore, Mr Mohmand appears to be asserting that his failure to file his restoration application in time arose because of incomplete and/or misleading information from the Patent Office with regard to the date the 19 months allowed for filing such an application commenced.

7. Mr Mohmand was sent the same package of information that is sent to patentees who pay their renewal fee too late. This consisted of a letter dated 5 December 1994 which informed him that although the Patents Form 12/77 he filed was received before the end of the 6 months period for paying the sixth year renewal fee with extension fees, the fee itself was not received until after that period. As a consequence Mr Mohmand was informed that the patent had ceased and that the fee he had paid would be refunded. The letter concluded by referring Mr Mohmand to papers that accompanied the letter which set out the procedure for applying for restoration and advised him to contact one of the officers listed in those papers. The papers themselves included an "advice sheet" which contained the following passage:

"Attached to this advice sheet are copies of the relevant sections of the Patents Act 1977 and Rules governing restoration procedures from the Patents Rules 1990.

In essence these items say that applications for restoration must be filed within 19 months from the ceasing date."

8. The documents attached to the advice sheet consisted of copies of the pages of the Act that covered sections 28 and 28A and copies of the pages from the Rules covering rules 41 and 110.

9. Paragraph (1) of section 28 provides:

"Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the

prescribed period.”

10. Paragraph (1) of rule 41 commences:

“An application under section 28 for the restoration of a patent-

(a) may be made at any time within the period of nineteen months beginning on the day on which it ceased to have effect

11. Mr Mohmand was also sent a standard letter on 23 December 1994, c/o Frank B Dehn & Co, which was issued in accordance with rule 42 notifying him that the patent had ceased. That letter again drew attention to the provisions of section 28 and rule 41(1) for filing a restoration application and also mentioned the period for filing such an application as being: “nineteen months from the date on which the patent ceased to have effect.” However, in his sworn statement dated 30 August 1996 Mr Mohmand says his agent Frank B Dehn & Co did not send that letter to him.

12. From the information the Patent Office sent to Mr Mohmand on 5 December 1994 he should have been left in no doubt that the nineteen month period prescribed in rule 41 commenced from the date the patent “ceased to have effect”. Subsection 3 of section 25 of the Patents Act 1977 explains that “a patent shall cease to have effect at the end of the period prescribed for the payment of any renewal fee if it is not paid within that period.” The period for paying a renewal fee (as opposed to a prescribed additional fee) on a UK patent is prescribed in paragraph (1) of rule 39 as being the 3 months ending with the fourth or, as the case may be, succeeding anniversary of the date of filing. In the case of the sixth year renewal fee due on the patent this anniversary date was 24 May 1994 which meant that the nineteen month period expired on 24 December 1995. Copies of section 25 of the Act and rule 39 of the Rules are not included as part of the standard package of information such as that sent to Mr Mohmand.

13. That then is the background. What I now have to decide, in accordance with paragraph (2)(b) of rule 100, is whether or not Mr Mohmand’s failure to file his application for restoration in time was attributable wholly or in part to an error, default or omission on the part of the Patent Office.

14. In the case of an "error" I do not believe that the information supplied to Mr Mohmand was in any way erroneous. Indeed, much of it consisted of extracts taken from the Act and Rules.

15. A "default" or "omission" by the Office, as used in the context of paragraph (2) of rule 100, should be judged against an action the Office would be expected to take under the Act or Rules or in accordance with established practice and which applicants for and proprietors of patents have come to rely on. This should not, in my view, be judged against any other action which if it had been taken may have lead to Mr Mohmand filing his application for restoration within the 19 month period prescribed in rule 41(1).

16. The letter and accompanying papers that the Patent Office sent Mr Mohmand on 5 December 1994 were issued in accordance with the Office's standard practice in the circumstances. The information sheet reflected the terminology used in the Act and Rules including the reference to the nineteen month period allowed for filing a restoration application as commencing on the date the patent "ceased to be in force". The Office's letter of 23 December 1994 was also issued in accordance with the obligation placed on the Comptroller under rule 42 which again included standard information about applying for restoration. The Patent Office cannot be held responsible for any failure by Mr Mohmand's agent to pass that letter on to him.

17. Therefore, the standard information the Office sent to Mr Mohmand was correct and fully consistent with its obligations under the Act and Rules and established practice. I also understand that the information has not been subject to misinterpretation up to now and so the Office has had no cause to consider any changes. Therefore, the Patent Office cannot be held to have made a default or omission that lead to Mr Mohmand's failure to file his application for restoration within the period prescribed in rule 41(1)(a). If Mr Mohmand had any doubts he had the opportunity to contact the Patent Office as he was advised to do in the Office's letter of 5 December 1994.

18. In conclusion, I am not satisfied that there is any justification for me to apply rule 100 to extend the time period prescribed in rule 41 for filing his application to restore the patent. Accordingly, the application is out of time and the patent remains lapsed. An appeal against this decision must be lodged within six weeks of the date of this decision.

Dated this 16th day of April 1997

M C WRIGHT

Grade 7, acting for the Comptroller



THE PATENT OFFICE