PATENTS ACT 1977 BL O/142/96 Pat / Linda 3Y60

IN THE MATTER OF an application
under section 28 for restoration of
patent EP (UK) 0244376
in the name of Martin Ivanov Denev

PRELIMINARY DECISION

EP (UK) patent no. 0244376 ceased on 16 March 1993 through failure to pay the renewal fee which was due by that date, and the fee was not received in the ensuing six months extension period, provided for in section 25(4) of the Patents Act 1977, that expired on 16 September 1993. Although the Patent Office received a telephone enquiry from Mr Denev on 20 September 1993 on the subject of restoring his patent, the nineteen month period allowed in rule 41(1) of the Patents Rules 1990 for filing an application for restoration elapsed on 16 October 1994, and it was not until 4 July 1995 that the present application for restoration was filed, with a request that the Comptroller exercise his discretion under rule 100 to permit the late filing. Mr Denev's patent agent filed supporting arguments but the Office indicated that it was not prepared to invoke rule 100. A hearing was requested, and was held on 26 July 1996 when the applicant was represented by Ms Jacqueline Reid, instructed by Mr A Luckhurst of Marks & Clerk, and Mr I Sim represented the Office.

It will be appropriate to consider the rule 100 issue as a preliminary to any consideration of the allowability of the section 28 application. To put the issue in context the terms of rule 100 that are relied on here should be set out:

> **Correction of irregularities**
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> **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.
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> (2) In the case of an irregularity or prospective irregularity-
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> (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.

Where the alleged irregularity involves non-compliance with a time limit, here the failure to file the application for restoration within the period set in rule 41(1), the provisions of sub-paragraph (2) of the rule clearly apply, and I would observe that the three limbs of that sub-paragraph must each be separately satisfied before the comptroller may direct that the period be extended. The major hurdle that the rule presents to the applicant is set out in limb (b), that of showing that the Patent Office has made an error, default or omission to which the failure to comply with the time limit was wholly or partly attributable.

The applicant's case on this turns on the advice that the Office gave Mr Denev in September 1993 and it will therefore be necessary to describe the events that happened around that time. Mr Denev telephoned the Office on 20 September 1993, some four days after the expiry of the six month period during which he might still have renewed his patent, subject to payment of additional fees. He spoke to a restorations officer who subsequently placed a full record of the conversation on the file of this restoration application; this record indicates that Mr Denev was concerned to discover that his patent had just lapsed since he was under the impression that he had until the end of September to make his payments, in line with what happens in certain other European countries. The restorations officer explained to him in outline how he could however apply to restore the patent, and undertook to send him relevant restorations advice; the record does not however indicate that the nineteen-month time limit for filing a restoration application was mentioned. A letter dated 21 September 1993 was then despatched to Mr Denev at his address in Austria explaining in detail the procedures for restoration, and

enclosing a pamphlet which the Office had prepared on the same subject. The letter mentions the time limit applicable in the following terms:

> In essence . . . applications for restoration must be filed within 19 months from the ceasing date.

The pamphlet mentions the time limit in rather plainer terms:

> You can apply to have your patent restored within 19 months of the date the patent ended - this is the date that the renewal fee you did not pay was due.

Mr Denev, in so dealing with the Office directly, by-passed his patent agents, Marks & Clerk of London, whose address was (and is) recorded on the Patents Register as the address for service. The office letter of 21 September 1993 in response was not sent or copied to Marks & Clerk and that fact is argued, for the applicant, to constitute the "error, default or omission" on the part of the Office which led to the time limit in question being exceeded. In particular it was argued that Marks & Clerk were at that time ignorant of the telephone call and of Mr Denev's wish to keep the patent alive, and had they been alerted, on receiving the letter of 21 September 1993, to the fact that the patent had lapsed unintentionally, they could have explained the situation to Mr Denev and, most importantly, they could have ensured that he understood the significance of the final date for making the restoration application

It is unfortunate that communications difficulties have apparently prevented Mr Denev from providing evidence as to his side of the story: the only formal evidence in this application is a statutory declaration from his agent, Mr Luckhurst. It is there stated that Mr Denev has advised Mr Luckhurst that he did not in fact receive the office letter of 21 September 1993. If this was the case it means that Mr Denev had only the information imparted to him in the telephone conversation of 20 September 1993 to rely upon, and as I have mentioned this conversation did not, according to the record, mention the 19-month period allowed for applying for restoration. Mr Luckhurst also declares that, even if Mr Denev had received the letter, his knowledge of English would not have allowed him to understand terms such as "ceasing date".

In support of these arguments on rule 100, Ms Reid referred me to two precedent cases. The

first was *Deforeit's Patent* [1986] RPC 142 in which the proprietor also failed to receive an office letter, in that case a letter asking for an address for service in the United Kingdom to be provided. No address for service having been provided, argument turned *inter alia* on how the Office could fulfil its statutory obligation under section 25(5) and rules 39(4) and (5) to notify the proprietor that a renewal fee was overdue. The Hearing Officer concluded that there was a requirement for the Office to send reminder notices and ceasing notices to the address for service, but if no such address had been provided the Office could take no other action. Ms Reid argued from this that it was at least implicit in the rules that correspondence, as well as statutory notifications, ought to be sent to the address for service since this was the only manner in which the patentee has set out that he can be contacted.

It is convenient at this point to look at the rule relating to addresses for service, which at the time in question was rule 30 of the Patents Rules 1990:

> Every person concerned in any proceedings to which these Rules relate and every proprietor of a patent shall furnish to the comptroller an address for service in the United Kingdom; and that address may be treated for all purposes connected with such proceedings or patent (as appropriate) as the address of the person concerned in the proceedings or of the proprietor of the patent.

I draw attention to the verb "may be" in the second phrase of the rule and conclude that the intention of the rule appears to me to provide a single channel of communication to the proprietor which the office can utilise and be sure that it has met its obligations, particularly where the issue of statutory notifications is concerned. I do not regard the rule as constraining the office to use only the address for service, or even obliging the office to ensure that all correspondence is copied to the address for service: the rule is not that prescriptive, either explicitly or implicitly. I do not therefore accept that the rule provides a basis for the legitimate expectation, referred to by Ms Reid, that the Office would have sent correspondence to the address for service as well as to Mr Denev. I think there may be a legitimate expectation, in the light of Deforeit's Patent, that statutory notices would be sent to the address for service, but I distinguish that from the present case of advisory correspondence issued in response to a direct approach from the proprietor.

Ms Reid went on to refer to *Mills' Application* [1985] RPC 339 in order to argue that a

legitimate expectation may be founded, not only in a rule or matter of law, but alternatively in the practice of the Patent Office, and that an "omission" in the meaning of rule 100 may result when the Office departs from an accepted practice. It was certainly the case in Mills' Application that the failure by the Office to perform a specific promise given in accordance with a well-established and generally well-known practice was held to constitute an "omission": see the judgment of Slade LJ at page 360 lines 16 to 20. What Ms Reid has however failed to do in the present case is to demonstrate that anything amounting to a well-established practice existed governing the sending or copying of correspondence to the address for service. She offered no evidence on that point and I have to add from my own knowledge of office practice that I am not aware of any general undertaking, promise or arrangement on the part of the Office, sufficiently widely promulgated to be regarded as "well-established", which would be effective to ensure that the address for service received copies of correspondence with the proprietor.

With hindsight one can see that such a practice would be desirable. I accept the probability that if there had been such a practice in place, Mr Luckhurst would have been alerted to the situation and would have been able to advise Mr Denev accordingly and in good time, and the necessity for invoking rule 100 would not have arisen. I therefore have sympathy with the applicant's case. However, the fact that the Office did not do something that was later shown to be material to the survival of the patent does not mean that an "omission" in the terms of rule 100 has taken place, since it is clear from the precedents that the actions of the Office must in that context be judged against legitimate expectations founded either on statute or on well-established practice. Accordingly I do not consider, on the basis of the case put to me, that the Office omitted to do anything it was required or expected to do; the proprietor or his agent thus had no justification for expecting that the agent, as address for service, would receive as a matter of course copies of advisory correspondence elicited directly by the proprietor from the Office.

I therefore find that the present case does not fall within the terms of rule 100(2)(b) and it is therefore not appropriate to exercise the discretion allowed by rule 100(2) to extend the period for filing the application for restoration. Ms Reid also addressed me on the application proper under section 28, but it is not necessary for me to decide that matter in view of my conclusion under rule 100.

This being a procedural matter any appeal must be lodged within 14 days after the date of this decision in accordance with R.S.C. Order 104, rule 19(2)(a).

Dated this 24 day of September 1996

H J EDWARDS
Principal Examiner, acting for the Comptroller

THE PATENT OFFICE