

PATENTS ACT 1977

IN THE MATTER OF an application
by Dr Michel Hechmati for the
restoration of Patent EP(UK) 0116579

DECISION

Patent EP(UK) 0116579 is dated 28 July 1983 and was granted on 10 May 1989. The renewal fee which fell due on 28 July 1989 was not paid by that date or within the six months grace period allowed under section 25(4) on payment of an additional fee. The patent accordingly lapsed on 28 July 1989. The application for restoration was made on 6 June 1990, within the period prescribed by section 28(1).

Rule 41(1) requires the statements made in an application for restoration under section 28 to be supported by evidence. Initially only an application form 16/77 containing four short statements was filed, though the application form was affirmed before a solicitor empowered to take oaths. There then ensued an exchange of correspondence between the office and Mr Ebrahim Heshmati, who was handling the application on behalf of the proprietor, on the subject of the requirement under rule 103(1) for evidence in the prescribed form of statutory declarations or affidavits. This exchange ended with Mr Heshmati filing a letter, dated 6 February 1991, with accompanying written reasons for the failure to pay the renewal fee in question and photocopies of various documents.

Meanwhile, the office had expressed the view, based on the statement made on the application form, that a prima facie case for restoration had not been made out, and arrangements had been put in hand for the appointment of a hearing to decide the matter. At the hearing, which took place before me on 19 February 1991, Mr Heshmati represented the proprietor and Mr M C Wright attended on behalf of the office. I exercised the comptroller's discretion under rule

103(2) to take oral evidence from Mr Heshmati in lieu of written evidence by statutory declaration or affidavit.

According to Mr Heshmati, who is Dr Michel Hechmati's brother, Dr Hechmati normally lives in the South of France at Cannes, but during 1989 he was involved in lengthy legal proceedings in California, USA in connection with divorce formalities. The divorce had such adverse affects on his health that he had to stay under close medical supervision for depression and heart trouble for a very long period, and when he returned to France he had to undergo an operation in hospital. All of this kept Dr Hechmati away from his normal activities and he was not in a condition to devote due care and attention to his affairs.

Mr Heshmati had agreed to look after Dr Hechmati's interests in the UK. After the office had written to Dr Hechmati on 15 June 1989 requesting an address for service in the UK, as required by rule 30, Dr Hechmati nominated Mr Heshmati at the latter's London address, this being supplied to the office on 21 July 1989.

The office had also informed Dr Hechmati of the need to file a verified translation of the patent, but in response to this request Dr Hechmati only filed a copy of the corresponding US patent. The office wrote to Mr Heshmati in July 1989 (he was by that time the registered address for service), explaining that the copy of the US patent filed by Dr Hechmati was not acceptable as a verified translation and repeating the requirement for a suitable translation to be filed by 10 August 1989 for the patent to be effective in the UK. Having received no reply by 26 September 1989, the office wrote again, this time to Dr Hechmati (though I believe a copy was sent to Mr Heshmati), repeating the need to file a verified translation and extending the deadline for filing it to 31 October 1989. In addition to this correspondence, the office had sent the statutory reminder, that the renewal fee in question was overdue, to Mr Hechmati's London address on

25 August 1989.

Mr Heshmati is an Iranian citizen, and although he has an address in the UK, he is absent from the UK for lengthy periods of up to four months at a time and has to obtain permission from the Home Office to reside in the UK.

Mr Heshmati had left the UK for Iran on 11 July 1989 and did not return to the UK until 1 October 1989. He was apparently unaware that his brother had nominated him as address for service in the UK until he discovered the official correspondence waiting for him upon his return to this country in October, and his absence from the UK between July and October would explain his failure to respond to the first office request for a verified translation.

Mr Heshmati says that on his return visit to London he saw the letters dated 25 August 1989 (the renewal overdue reminder) and 26 September 1989 (the last request for a verified translation) but assumed that they both referred to the same subject. He immediately took action on the more recent letter and visited the Patent Office to request an extension to mid-November in which to file a verified translation. This extension was granted, and the translation was filed on 6 November 1989 with the appropriate form and fee. Mr Heshmati was then notified by the office that the necessary formalities had been completed and that the patent would be published on 20 December 1989.

Because of his mistaken assumption that the official letters of 25 August and 26 September referred to the same subject, Mr Heshmati thought that no further action was necessary on his part in relation to the patent, and it was not until he received the official notice that the patent had ceased, issued on 21 February 1990, that Mr Heshmati suspected that something had gone wrong.

Before offering restoration of a lapsed patent the comptroller must be satisfied that the requirements of

section 28(3) have been met ie.

- (a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, and
- (b) those fees were not so paid because of circumstances beyond his control.

As far as I have been able to ascertain, there was no procedure set up by Dr Hechmati to ensure that either he or Mr Heshmati would receive a timely reminder of when the renewal fee was due or would be in a position to receive the official overdue reminder, to find out how much to pay, and to send off the fee in sufficient time. Dr Hechmati apparently expected Mr Heshmati to deal with any matter that came up in connection with the patent, knowing, as I think he must have done, that Mr Heshmati had no knowledge of patent matters and would be absent from the UK for long periods of time.

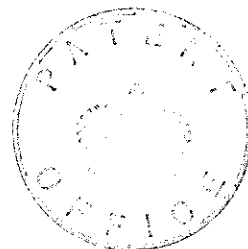
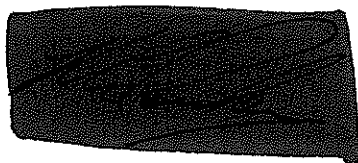
Having had the opportunity to question Mr Heshmati under oath, I am satisfied that he is an intelligent and responsible person who did his conscientious best to look after his brother's interests, but without any instruction in patent matters, and with the likelihood of him being out of the country during the critical period, in my view there was always a serious danger that the opportunity for paying the renewal fee would be missed, and therefore I do not consider that the proprietor can be said to have satisfied the reasonable care requirement of section 28(3)(a).

Dr Hechmati was away from his home address for much of 1989 and was subject to a number of personal difficulties, but as I understood Mr Heshmati, the two brothers remained in

contact with each other throughout, at least on family matters. If there were difficulties in communication on business matters, as seems to have been the case, then that seems to me to underline the lack of reasonable care by the proprietor in imposing upon Mr Heshmati the burden of looking after the patent.

Accordingly I must refuse the application for restoration.

Dated this 12 day of MARCH 1991



K E PANCHEN

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE