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01/10/92

PATENTS ACT 1977

IN THE MATTER OF an application for
restoration of Patent No EP(UK) 0066099 in
the name of Egon Turba

DECISION

Patent No EP(UK) 0066099 ceased on 30 April 1990 through non-payment of the renewal fee in respect of the 9th year which was due on that date. An application for restoration was filed on 24 January 1991, within the period allowed under Section 28(1), accompanied by a statutory declaration by the German proprietor Herr Egon Turba giving evidence that the failure to renew the patent was caused by Herr Turba's medical incapacity at a critical time.

The Office was not satisfied that a prima facie case in favour of restoration had been made out and accordingly issued a letter on 7 March 1991 indicating that medical evidence to clearly substantiate the proprietor's claim was required. On 4 May 1991 the Office received a sworn statement from the proprietor's doctor. The Office considered however that the evidence was insufficient for the application for restoration to succeed and informed the proprietor in a letter dated 25 June 1991 that the application would be refused pursuant to Rule 41(2) unless a request to be heard was made within one month from the date of that letter.

A request to be heard was received on 19 July 1991 and accordingly the date for a hearing was set at 16 January 1992. A further letter dated 6 January 1992 was received informing the Office that the hearing would not be attended. It therefore falls to me to decide the matter on the basis of the evidence on file.

In his statutory declaration the proprietor states that during 1990, financial difficulties led him to consider whether or not to authorise payment of the renewal fee which fell due on 30 April 1990. Knowing that it was possible to delay paying the renewal fee (but incurring an additional fee) until the end of the six month extension period, expiring 30 October 1990,

Herr Turba decided towards the end of October to instruct his Patent Attorneys in Germany to arrange for the fee and additional fee to be paid.

A letter dated 22 January 1991 from the UK patent agents representing the proprietor throws a little more light on the situation. It explains that during those six months Herr Turba was actively seeking a licence for the patent to help overcome his financial difficulties. He apparently expected to finalise a licence agreement with a particular company in early November 1990, shortly after the expiry of the extension period. He wanted therefore to maintain the patent.

Herr Turba states that he had prepared letters of instruction to his German attorneys to pay the renewal and additional fees but he was prevented from sending them, and indeed from even telephoning his instructions, by reason of a slipped disc which immobilised him on 29 and 30 October. His wife was apparently not at home at the time to assist.

It is incumbent on an applicant for restoration under section 28 in its unamended form relevant to this application to satisfy the comptroller (a) that he has taken reasonable care to ensure 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.

There is no doubt from the proprietor's declaration, as supported by the UK patent agents' accompanying explanation, that a conscious decision, whatever the ultimate intention, was taken by the proprietor to delay payment of the renewal fee and additional fee until the end of the six month extension period. This, to my mind, places a heavy burden on the proprietor to ensure, if he intends to maintain the patent, that he has made careful arrangements to secure payment of the necessary fees on time.

It seems to me that in this instance the proprietor had laid himself open to perilous risk. By his own admission, the only preparatory measures he had taken were to arrange for letters of instruction to be prepared for despatch to his German attorneys. It seems that Herr Turba's intention was to have despatched the letters on 29 or 30 October, the last two

days of the extension period. Even if he had not suffered the back injury which apparently prevented him from actually despatching those letters, I cannot accept that Herr Turba had exercised reasonable care in expecting letters of instruction to be despatched on 29 or 30 October to guarantee reaching his attorneys in Germany with sufficient time in hand for them to instruct the patent agents in the United Kingdom and for them, in turn, to pay the necessary fees at the UK Patent Office by 30 October, which was the last possible day for payment. A breakdown, or even a temporary hitch, in any one of those links in the chain of communication between the proprietor in Germany and the Patent Office in the UK could have led to disaster.

There is nothing before me to indicate how Herr Turba could have had such faith and confidence in the communication chain as to have entrusted last minute renewal of the patent by a route which appears so manifestly vulnerable to the possibility of failure.

At the very least in my view it would be reasonable to expect the proprietor to have given his German attorney advance warning of the possibility of a last-minute renewal instruction. There is no evidence, however, that Herr Turba had taken any precautionary measures whatsoever to forewarn his attorney of the possibility of any such instruction or that he even tried to find out how much time was required to act on the instruction.

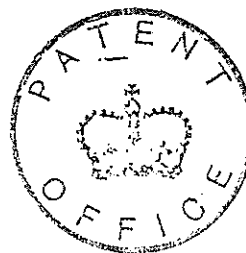
Furthermore, if Herr Turba had expected to finalise the licence agreement in early November, he must have known in advance of 29 October that he was going to have to pay the fees by 30 October. I see no reason why, once that knowledge had been gained, payment needed to be delayed any further. Rather I would have expected him to ensure that his endeavours to negotiate the licence over the preceding six months would not be wasted by failure to keep the patent in force. There is, however, no evidence before me to show that Herr Turba had ever contemplated issuing his instructions to pay the fees any sooner than 29 or 30 October.

I am not satisfied, therefore, that the proprietor took reasonable care to see that the necessary renewal and additional fees were paid within the prescribed period.

I turn now to consider whether or not the failure to pay the fees was because of circumstances beyond the proprietor's control. The fact that Herr Turba decided deliberately to leave payment of the fees until the last two days of the extension period plainly indicates to me that failure to pay because of circumstances beyond the proprietor's control could only be pleaded in connection with his back injury preventing him from despatching letters or using the telephone on 29 and 30 October to instruct payment of the fees. I note that, although the proprietor has supplied in support of his case a sworn statement from his doctor, that statement does not provide independent, medical corroboration of the proprietor's physical condition on the pertinent dates, ie 29 and 30 October. Rather, it simply postulates that Herr Turba's condition could lead to "acute restrictions and deteriorations of movement" but not necessarily that it did so on those dates, and merely reiterates Herr Turba's own statement that he was unable to go on a trip and was confined to bed. There is no direct evidence to substantiate that Herr Turba was left alone and completely immobilised for two whole days on 29 and 30 October 1990 to the extent that he was prevented from despatching the letters or using the telephone to instruct fee payment. The proprietor has therefore not discharged to my satisfaction the burden of proof necessary to show that condition (b) of section 28(3) has been met.

I find therefore that the proprietor has failed to satisfy the requirements of section 28(3) and the application for restoration is accordingly refused.

Dated this 5 day of February 1992



K E Panchen
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE