

PATENTS ACT 1977

BLO/152/87

IN THE MATTER OF an application
by CHI-CHEN HO and TSUNG-HUEI WANG
for the restoration of Patent No 2070305

DECISION

Patent No 2070305 lapsed on 19 February 1986 on failure to pay the renewal fee for the sixth year. The six months additional period during which renewal was still possible upon payment of further fees expired on 19 August 1986 without such payment being made, and an application for restoration was filed on 19 February 1987. The office expressed the view that the evidence filed in support of the application contained insufficient information to satisfy the Comptroller that the requirements of Section 28(3) had been complied with. A hearing was requested and took place before me on 28 August 1987 when Dr I A Stuart of Mewburn Ellis and Co (Mewburn) appeared as agent for the proprietors and Mr S Nead attended on behalf of the office.

In this particular case there are two joint proprietors both of whom are resident in Taiwan: Mr Ho who is one of the two inventors, and Mr Wang who derives his proprietorship from the other inventor by virtue of an assignment dated 6 April 1983.

The evidence is in the form of a statutory declaration by Dr Stuart. The proprietors employed professional advisers, Asian Pacific International Patent and Trademark Office (Asian) in Taiwan, and they in turn dealt with Mewburn who operate a well-established renewals reminder system. This system appears to have functioned normally in the present case in that several reminders were sent by Mewburn to Asian, including an overdue reminder on 27 June 1986 and a final reminder on 22 July 1986. No response to any of the reminders was received by Mewburn. A sworn statement by Mr Wang, attached to Dr Stuart's declaration as exhibit C, makes it clear that Mr Wang took no part in the renewal arrangements for the patent and in fact left all matters concerning the patent entirely in the hands of Mr Ho, including the responsibility for production and marketing.

There is no evidence to indicate with certainty what happened to the reminders which were issued by Mewburn prior to the due date for renewal in accordance with customary practice. At the hearing Dr Stuart stated that Asian were unable to contact Mr Ho during the renewal period running up to the due date. An attested certificate attached to Dr Stuart's declaration as exhibit D shows that Mr Ho was in prison from 25 February 1986 to 31 May 1986, and Dr Stuart submitted that Asian's failure to contact Mr Ho prior to the due date may be explained by the disruption to Mr Ho's personal affairs which must have occurred while imprisonment was impending. In the absence of any evidence to support this conjecture however, Dr Stuart sought to persuade me that the period of imprisonment had such a disruptive effect on Mr Ho that even after his release he was unable to attend to his normal affairs and did not function rationally.

A sworn statement by Mr Ho attached to Dr Stuart's declaration as exhibit E explains that from 1 June 1986 to 26 January 1987 Mr Ho led the life of a casual labourer doing temporary jobs around Taiwan and apparently finding it impossible to settle down with a permanent address. As a consequence, Mr Ho completely lost touch with his patent agent in Taiwan and did not receive any correspondence concerning the patent until he returned to his home town for Chinese New Year, whereupon he was informed by Asian that the patent had lapsed.

Whether or not Mr Ho was denied communication with the outside world during his imprisonment does not emerge from the evidence. As for the period covering 1 June 1986 until 19 August 1986, the final date on which the patent might have been renewed with payment of additional fees, there is nothing in the evidence which in my view clearly establishes that Mr Ho was unavoidably prevented either from returning to his home or from contacting his home address, his patent agent in Taiwan or his co-proprietor Mr Wang. The failure of the reminders from Asian to reach Mr Ho during this period was of course the natural consequence of Mr Ho effectively cutting himself off from all contact with Asian.

Dr Stuart also urged me to view Mr Ho's circumstances in this period as being similar to those which pertained in the case of Mead's

Patent 1980 RPC 146, but the evidence does not satisfy me that following Mr Ho's release from prison and for the remainder of the period during which the patent might have been renewed, Mr Ho was incapable of resuming control of his business and patent affairs.

Finally I should consider the position of Mr Wang. In my view, when it comes to considering whether the reasonable care required by Section 28(3) has been exercised, it is not sufficient for one of two co-proprietors to have left matters entirely in the hands of the other co-proprietor as Mr Wang has done. Although the system arranged by Mr Ho and Asian would appear to have been basically satisfactory, Mr Ho was required to play his part for the system to operate successfully. As far as I can see there was no safeguard whatsoever against the possibility of Mr Ho failing to discharge his responsibilities, for example as a result of absence abroad, illness or sudden death, and no regular communication between Mr Ho and Mr Wang. Furthermore, it would appear that Asian were not informed of Mr Wang's address, as a result of which they were unable to contact Mr Wang when they failed to reach Mr Ho. I find this apparent lack of interest by Mr Wang all the more surprising in view of the assertions, made by both proprietors in their statements, regarding the commercial importance of the patent to them.

In the result therefore I am not satisfied from the evidence before me that the proprietors have met the requirements of Section 28(3) and I must refuse the application for restoration.

Dated this 14th day of September 1987

K E Panchen
Superintending Examiner, acting for the Comptroller

PATENT OFFICE

