

PATENTS ACT 1977

Pat/Linda
3Y60

IN THE MATTER OF an application
under section 28 by Alec Reginald Carruthers
for the restoration of Patent GB2261277

DECISION

1. The renewal fee in respect to the sixth year for the patent fell due on 12 September 1996. The fee was not paid by that date or during the six months allowed under section 25(4) upon the payment of the prescribed additional fees. The patent therefore lapsed on 12 September 1996. The application for restoration of the patent was filed on 22 May 1997 within the 19 months prescribed under rule 41(1)(a) for applying for restoration. After considering the evidence filed in support of the application for restoration an official letter issued on 16 September 1997 informing the proprietor that the Office was not satisfied that the requirements for restoration, as laid down in section 28(3), had been met. The matter came before me at a hearing on 29 October 1997. The applicant Mr Alec Reginald Carruthers attended in person and Mr Ian Sim attended on behalf of the Patent Office.

2. The evidence filed in support of the application for restoration consists of single affidavit by Mr Carruthers dated 11 August 1997.

3. At the hearing Mr Carruthers said that he had experience in dealing with patents for British Gas but had been granted only two patents in his own name, one of which was patent GB2261277. The system he used to remind himself when to pay the renewal fees on his patents was to rely on the official overdue notice the Office issues in accordance with rule 39(4). When he received the notice he said that he would put it in his diary and record the date in the diary unless he happened to have the envelope in which he kept the papers relating to the patent on his desk at the time, in which case he would place the notice in that envelope rather than put it in his diary and record the date in the diary.

4. Mr Carruthers paid the fifth year renewal fees for both his patents. However he then decided that he would pay the sixth year renewal fee for patent GB2261277 only and allow his other patent to lapse. When he received the rule 39(4) notice for patent GB2261277 he decided to place it in the envelope rather than in his diary. Unfortunately he inadvertently placed it in the envelope for the patent he had decided to abandon which had a similar patent number. He then put the envelope in his filing cabinet and as a consequence, the renewal fee for patent GB2261277 remained unpaid.

5. That then is the background. What I now have to decide is whether or not the proprietor has met the requirements for restoration as set out in section 28(3) which provides:

"If the comptroller is satisfied that 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, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee."

6. The words "took reasonable care to see that" implies that the proprietor must take active steps rather than simply wait for something to happen. The first step he must take is to ensure that he is reminded when to pay the renewal fee. It has been held that an individual proprietor working on his own in a small way of business is entitled to rely on the rule 39(4) notices to remind him when to pay a renewal fee rather than set up his own reminder system. However, being alerted by that official notice is not enough in itself. The proprietor must then take some positive steps to see that the fee is actually paid.

7. At the hearing Mr Carruthers indicated that he usually paid everything straight away though he also said that he did not scrutinise everything and would put things to one side for future reference if he was busy. Clearly, if payment is deferred there should be a mechanism for ensuring that payment of the fee is not forgotten.

8. Mr Carruthers' practice of placing the rule 39(4) notice in the appropriate envelope was not

in itself a guarantee that he would be prompted to pay the fee as it is possible that other papers might then be placed on top of the notice which might then remain unactioned. At the hearing Mr Carruthers admitted himself that the notice could well have got mixed up with other papers in the envelope. His comment that he "dropped it in" the envelope also seems to me to indicate a rather haphazard way of dealing with an important document that requires action, with an increased possibility of it becoming mixed up with other papers.

9. There is no evidence that Mr Carruthers had any system for bringing the renewal notice to his attention after putting it in the envelope. He simply relied on the fact that because the envelope was on his desk he was likely to come across the notice when dealing with other papers in the envelope. It is possible that, had he placed the notice in the correct envelope, he might not have referred back to the envelope until it was too late to pay the fee, particularly as he was busy at the time. There was no mechanism for checking the correct envelope to ensure timely payment of the fee.

10. In my view, therefore, this is not a case where the proprietor has made an isolated error causing an otherwise satisfactory system to fail but it is one where the system itself was flawed and where insufficient care was taken in the operation of the system.

11. In conclusion, I am not satisfied that Mr Carruthers exercised the degree of care which would have been reasonable under the circumstances to see that the renewal fee was paid. I am, therefore, not satisfied that the requirements in section 28(3) of the Patents Act 1977 have been met and refuse to order restoration. Any appeal against this decision must be lodged within six weeks of the date of this decision.

Dated this 2nd day of December 1997



M C Wright

Grade 7, acting for the Comptroller

THE PATENT OFFICE

