

## **PATENT ACT 1977**

IN THE MATTER OF applications  
under section 28 for restoration of  
European patent (UK) 0223850 in the name of  
Dr Wilhelm Hoerrmann

### **DECISION**

#### **Background**

1. The renewal fee in respect of the fourteenth year of the patent fell due on 20 May 1999. The fee was not paid by that date or during the six months allowed under section 25(4) upon payment of the prescribed additional fees. The patent therefore lapsed on 20 May 1999. The application for restoration of the patent was filed on 20 December 2000, 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 a letter was sent to the proprietor, Dr Wilhelm Hoerrmann, on 26 July 2001 informing him that the Patent Office was not satisfied that the requirements for restoration, as laid down in section 28(3), had been met.

2. Dr Hoerrmann, who lives in Germany, indicated to the Office that he wished to be heard in the matter but, because of the poor state of his health, he was unable to attend a hearing in person and would not be sending anyone to represent him. The Office subsequently wrote to Dr Hoerrmann on 30 November 2001 explaining that it intended proceeding on the understanding that he wished to be heard and was content for the Hearing Officer to consider the matter and issue a decision based on papers on the Office's file.

3. The evidence filed in support of the application consists of a single witness statement by Dr Hoerrmann dated 16 March 2001. There are also several letters from Dr Hoerrmann on the Office file.

#### **The Facts**

4. In his witness statement Dr Hoerrmann says that he kept an almanac (calender) on which he entered the dates when renewal fees fell due on the patent. He says this worked effectively in previous years. However, in the year 1999 he says he was often not in his office due to the fact that he had especially heavy and lasting attacks of a disease he had been suffering from for many years. As a result, he says "the essential facts concerning the patent escaped me."

5. In a letter dated 6 April 2001 the Office invited Dr Hoerrmann to provide further evidence covering the following matters.

- (a) Independent testimony confirming the severity of his disease/illness and that he was personally incapable of paying the fourteenth year renewal fee during the whole of the nine-month period in which it could be paid or paid with additional fees, ie, 20 February to 20 November 1999 and was not in a position to arrange for someone else

to pay on his behalf.

- (b) Why he was able to pay on 11 November 1999 the renewal fee on his other patent GB2171302 but not the fee on the subject patent?
- (c) Further information about his diary system and why it failed to prompt him to pay the renewal fee.
- (d) Why the official reminder letter the Office sent him on 3 June 1999 (c/o his UK address for service: J E Martin, 170 Park Road, Wallsend, Tyne-Wear, United Kingdom), in accordance with rule 39(4), did not alert him to the fact that the fourteenth year renewal fee was due?

6. Dr Hoerrmann was asked to provide this information in the form of a sworn statement, such as a witness statement. Unfortunately, he did not provide any further sworn statements but instead responded by letter.

7. With regard to point (a) above, Dr Hoerrmann has not said what disease he suffers from but has said that it is rare. Moreover, he says that he had never consulted another doctor as, being a physician himself, he preferred to treat himself. Therefore, he could not provide any independent testimony by another doctor to corroborate his statement and confirm that the disease he was suffering from was such as to severely undermine his ability to recognise that the fourteenth year renewal fee needed to be paid and to ensure it was paid in time.

8. In response to point (b) above, Dr Hoerrmann says "The fact that GB2171302 was paid in time and EP(UK)0223850 was not, only shows that I was aware of the one and not the other at that time."

9. Dr Hoerrmann has not responded to point (c) and (d) above other than to say that over periods of time he was not able to work in his office which is where I assume he kept his diary and to which the rule 39(4) reminder notice would have been forwarded.

### **Assessment**

10. What I now have to decide is whether or not Dr Hoerrmann 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."*

11. In deciding this matter I shall bear in mind the following direction given by Aldous J in *Continental Manufacturing & Sales Inc's Patent* [1994] RPC pages 535 to 545:

"The words 'reasonable care' do not need explanation. The standard is that required

of the particular patentee acting reasonably in ensuring that the fee is paid.”

12. The system Dr Hoerrmann’s used to remind him when to pay renewal fees on his patent was simple yet effective up to and including the thirteenth year renewal fee. The question is, was the reason it broke down in respect to the fourteenth year due to a failure by him to take reasonable care?

13. It is unfortunate that Dr Hoerrmann is unable to provide independent evidence from another doctor which could confirm that his state of health, at the time he could have paid the renewal fee, was so severe as to impair his ability to manage his affairs and, in particular, to see that the fee was paid. However, the fact that he was able to pay the renewal fee due on another patent, at a time when he could have paid the renewal fee on the subject patent, indicates that he was capable of knowing when a patent renewal fee was due and seeing that it was paid in time. He has not supplied any explanation as to why the essential facts concerning the subject patent should escape his mind while those for his other patent did not.

14. Dr Hoerrmann’s statement that he was not able to attend his office for periods of time suggests that he did attend some times. The fact that he paid the fee on another patent on 11 November 1999 indicates that he visited the Office around that time and must have checked his calendar and realised that the fee on that other patent had to be paid.

15. Dr Hoerrmann has not denied receiving the rule 39(4) reminder letter and has offered no explanation as to why it did not prompt him to pay the fee. I can only infer from this that the reminder, which made it clear that the renewal fee could still be paid with extension fees, was forwarded to his Office via his UK address for service but that for some unexplained reason he did not take appropriate action following its receipt.

## **Conclusion**

16. I have no doubt that Dr Hoerrmann was suffering from ill health at the time the fourteenth year renewal fee could have been paid and I have considerable sympathy for him. However, I have seen no independent medical evidence to corroborate his assertion that his condition throughout the nine-month period in 1999, in which he could have paid the fee, was severe enough to impair his ability to pay and excuse his failure to do so. He has not therefore discharged to my satisfaction the burden of proof I believe is necessary in this regard. To the contrary, the fact that during that period he paid the fee on another patent is a clear indication that he was aware of the need to pay patent renewal fees and was capable of ensuring that they were paid in time.

17. As for the Office’s rule 39(4) reminder letter, in the absence of any statement to the contrary, I can only assume that he received that letter and failed to take the necessary action.

18. I find it difficult to accept that Dr Hoerrmann exercised reasonable care in the operation of the renewal system to see that the fourteenth year renewal fee was paid, even if, as he says, the essential facts escaped his mind. I am not, therefore, satisfied that the requirements for restoration, as set out in section 28(3), have been met and accordingly must refuse the application for restoration.

19. Any appeal against this decision must be lodged within six weeks of the date of this decision.

Dated this 10<sup>th</sup> day of January 2002

M C Wright  
Assistant Director, acting for the Comptroller

**THE PATENT OFFICE**