



BL O/374/06

27 December
2006

PATENTS ACT 1977

APPLICANT Bernard Edgar Anning

ISSUE Whether patent application number GB
0028762.3 should be reinstated under
section 20A

HEARING OFFICER R C Kennell

DECISION

Introduction

- 1 The application in suit relates to apparatus for dispensing beverages and was filed on 24 November 2000. It proceeded normally up to the issue of the first substantive examination report on 21 April 2004, having in the meantime been published under serial no. GB 2369347 A.
- 2 No reply was received to that report by the date of 21 October 2004 specified by the examiner, or to the reminder subsequently issued by the Patent Office on 13 April 2005 warning of refusal if no reply was made by 24 May 2005 (the date of expiry of the period prescribed by rule 34 of the Patents Rules 1995 for putting the application in order). In consequence, the application was treated as refused under section 20(1) of the Patents Act 1977.
- 3 The applicant filed a request for reinstatement under section 20A of the Act on 22 May 2006. This was refused by the Office and the matter therefore came before me at a hearing on 30 November 2006. Dr Geoffrey Pritchard, advised by Dr Michael Hutchins of patent attorneys M R Hutchins & Co, appeared for the applicant, Mr Anning, who was also present. Andrew Rees attended on behalf of the Office. (The patent attorneys Fry Heath Spence, hereinafter "FHS", who originally prosecuted the application, including the request for reinstatement, on behalf of Mr Anning have withdrawn their representation because of a conflict of interest for the reasons explained below.)

The law and its interpretation

- 4 Section 20A of the Act entered into force on 1 January 2005, consequent upon amendment of the Act by the Regulatory Reform (Patents) Order 2004, and applies to applications filed both before and after that date. The relevant parts are subsections (1) and (2) (the exceptions in subsection (3) are not in issue in the present case); these read:

“(1) Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is –

- (a) set out in this Act or rules, or
- (b) is specified by the comptroller

(2) Subject to subsection (3) below, the comptroller shall reinstate the application if, and only if –

- (a) the applicant requests him to do so;
- (b) the request complies with the relevant requirements of rules; and
- (c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.”

5 The relevant rule is rule 36A of the Patents Rules 1995 (as amended). Rule 36A(1) requires a request for reinstatement to be made before the end of the relevant period, defined by rule 36A(2) as

“.... the first to expire of –

- (a) the period of twelve months starting on the date on which the application was terminated, or
- (b) the period of two months starting on the date on which the removal of the cause of non-compliance occurred.”

6 I am not aware of, and my attention was not drawn to, any authorities directly bearing on the interpretation of section 20A, but paragraph 20A.13 of the Office’s “Manual of Patent Practice” states:

“There is no definition in the Act or rules as to what is meant by “unintentional” as it applies for determining whether to allow the reinstatement of a patent application. However, a similar standard has been applied by the Office in deciding whether to exercise discretion favourably in allowing a period of time to be extended under rule 110 (see 123.37). In general, for discretion to be exercised to allow a period of time to be extended there must have been a continuing underlying intention to proceed with the application or patent. It was held by the Hearing Officer in *Heatex Group Ltd’s Application* ([1995] RPC 546) that a change of mind by the applicant as to whether to proceed was not a legitimate reason for allowing an extension. The same principle will be applied by the Office in deciding whether to allow reinstatement of applications under section 20A.”

7 However in *Sirna Therapeutics Inc’s Application* (BL O/240/05) the hearing officer was faced with a similar test in relation to a request under section 5(2B) for permission to make a late declaration of priority. This provision was also introduced by the 2004 Order and, similarly to requests for reinstatement,

section 5(2C) requires the comptroller to be satisfied that the failure to file the application within the period normally allowed was unintentional. It seemed to me that I would need to have regard to the hearing officer's comments in *Sirna* in reaching my decision, and I therefore gave Dr Pritchard an opportunity to make submissions on the case at the hearing.

The facts of the case

- 8 The request for reinstatement was accompanied by a statement of case from FHS and a witness statement from Mr Anning. FHS say that they reported the examination report to Mr Anning on 18 August 2004 but that he telephoned on 4 October 2004 and "stated that he had sometime previously abandoned his patent applications" (it is not disputed that he had already advised FHS that he did not wish to pursue a parallel international application). Having received no reply to their letter of 18 October 2004 in which they asked Mr Anning for written confirmation of this, failing which the application would be taken to be abandoned, FHS saw no reason to reply to the Office's reminder of 13 April 2005 or to notify Mr Anning of the impending deadline for putting the application in order.
- 9 FHS say that the situation came to light when Mr Anning called at their offices on 15 August 2005 to enquire what scope remained for protecting features of his invention which had not been objected to during examination of the international application and the UK application. They say they advised him at that meeting that the latter would need to be reinstated, but subsequent discussions were directed more to the product itself than the fate of the patent application: accordingly it was not until a further meeting on 23 March 2006 that Mr Anning appreciated that there was a problem stemming from his failure to address the examination report. FHS go on to say that Mr Anning wrote to them on 9 May 2006 stating that it had not been made clear to him before the 23 March meeting that he might have obtained a patent had a timely reply and suitable amendments been filed in response to the examination report.
- 10 The statement puts forward a number of factors in mitigation, principally that from sometime in 2002 until, at the earliest, the end of 2004, Mr Anning was under considerable personal pressure. This was because of him having to work away from home for 5 days a week for considerable periods and also having to take his wife's elderly and sick parents into the family home to care for them, necessitating considerable rebuilding work: however the parents died in close succession. FHS suggest that during this period Mr Anning's mind was not particularly focused on the progress of his patent applications and that he might well have mistaken correspondence on the UK application as relating to the abandoned international application. They also accept that the situation was not helped by the facts that the attorney originally handling the case left in mid 2003, and that the new attorney was not familiar with all the history of the case and saw no reason to question Mr Anning's apparent decision to abandon the UK application.
- 11 Mr Anning's witness statement confirms this account. He accepts that FHS believed he had abandoned his UK application, but states that it had always

been his intention to obtain patent protection in the UK and that the failure to address the communications from the Patent Office was due to misunderstandings and miscommunications between himself and FHS.

- 12 In its letter of 31 July 2006, the Office did not accept that Mr Anning's failure to reply to the examination report within the specified period was unintentional since the applicant appeared to have informed FHS that he had abandoned the application. The Office did not accept that the above-mentioned mitigating factors showed the failure to be unintentional and observed that even after the cessation of his personal problems, the applicant still took no action with regard to the application until August 2005, around eight months later.
- 13 Mr Anning sought to address these points in a second, much fuller, witness statement filed for my consideration at the hearing. (As Dr Pritchard explained, because of the clear misunderstandings which had come to light between Mr Anning and FHS, it had been thought better that FHS should not be involved in preparing this further evidence.) In the new statement Mr Anning explains that following a largely negative international preliminary examination report (IPER) on the international application he was extremely pessimistic about his chances of getting worthwhile protection; he therefore decided not to proceed with *the international application* and informed FHS accordingly. However, he is emphatic that he did not at the same time instruct FHS to abandon *the UK application*, and states that he wanted, so far as possible, to put it on hold until he was in a better position to demonstrate practically how the system worked and how it differed from known inventions. He says that the receipt of the UK examination report along the same lines as the earlier IPER confirmed his view that he should leave the UK application dormant for the time being.
- 14 Mr Anning states that his telephone call to FHS on 4 October 2004 arose from concern on his part that they were effectively asking him to pay again for essentially the same work as had been done on the now abandoned international application. I think it will be helpful for me to quote paragraph 6 of Mr Anning's statement in full:

“Although the word ‘abandon’ is used in the Statement of Case, I do not recall using the word ‘abandon’ in relation to my UK patent application during the telephone call of 4th October 2004. For the reasons stated above, during that conversation, I believe that I said that I had previously asked Dr Acham to put the UK application on hold. I was under the misapprehension that I could go back to it later if need be. I cannot now recall precisely what was said during the conversation but I accept that Fry Heath Spence thought that I had abandoned the application even though this was not my intention. I may well have suggested that I was giving up on the current attempt to obtain a patent, but this was because I genuinely thought that once I had paid the Patent Office fees and received an application number from the Patent Office, that number was mine until either a patent was granted or the application was finally refused and that I could go back and try again with the application once I had gathered some further evidence that it worked. I now fully accept that I was labouring under a serious misapprehension in this respect.”

- 15 Mr Anning says that he does not recall, and has no record of, the letter of 18 October 2004 in which FHS asked for confirmation that the application was being abandoned (Exhibit D to the witness statement). However he has no reason to believe that it was not sent.
- 16 He then explains that, not being aware of any need for urgency, he waited until the attorney now handling the case returned from maternity leave to arrange the meeting of 15 August 2005 mentioned above. He refers to receipt in September 2005 of a consequential letter dated 13 September 2005 (Exhibit E to the witness statement) in which FHS state

“... A deadline for replying to the latest examination report on your UK patent application expired 21st October 2004. In accordance with your instructions no reply was filed and no request was made for an extension of the time limit. Accordingly your application was deemed withdrawn.” ;

they refer to the refusal of the application at the expiry of the 4 ½ year rule 34 period and suggest that any application to reinstate ought to be made within two months of the date of the letter as being the date on which the cause of non-compliance (see rule 36A(2)(b) above) was removed. Mr Anning says that he does not recall any previous advice that there was such a 4 ½ year period.

- 17 Mr Anning says that he did not respond to the letter because he still thought his prospects for obtaining worthwhile protection were poor, and not until the New Year did he think he had the evidence he needed to show what he was trying to protect. He therefore arranged the 23 March 2006 meeting and maintains that not until the discussion at that meeting did he realize that he had allowed the deadline for reply to the examination report to pass without appreciating that worthwhile amendments could have been made to rescue the application.

Arguments and analysis

- 18 For the avoidance of doubt I think it is desirable to be clear as what is the “failure to comply” in the present case. Dr Pritchard’s skeleton argument filed for the hearing refers to non-compliance with the rule 34 period for putting the application in order. However, it seems to me that this is consequent upon the previous failure under section 18(3) to comply with the specified period for replying to the examination report, and I think it is this earlier failure that I should address. In practice I do not think this affects Dr Pritchard’s argument that the cause of non-compliance was the applicant’s failure to appreciate that there was an opportunity to overcome objections raised by the examiner in his report.
- 19 The two issues that then remain are whether the request for reinstatement was filed in time in accordance with rule 36A(2) and whether the failure to reply to the examination report within the specified period was unintentional in accordance with section 20A(2)(c).

Was the request filed in time?

- 20 The request was filed on 22 May 2006 and so is clearly within the period of 12 months prescribed by rule 36A(2)(a), the application having been terminated after the expiry of the rule 34 period on 24 May 2005.
- 21 However, this will not avail Mr Anning if the rule 36A(2)(b) period of 2 months from the date of “the removal of the cause of non-compliance” expired earlier. In a case like this, where the applicant has been labouring under a misapprehension about the courses of action open to him, it may be difficult to decide at what point the misapprehension was sufficiently removed. In Mr Anning’s case I do not think the date of removal of the cause can be later than 23 March 2006 when, as Dr Pritchard put it at the hearing, the scales fell from Mr Anning’s eyes and he realised that he should have filed amendments in order to save the application. At the latest therefore the 2 month period expired on 23 May 2006, before the 12 month period of (a).
- 22 If the relevant date is 23 March 2006, then the request was filed in time. However, I think it is at the least arguable that that the cause of non-compliance was removed when Mr Anning received FHS’ letter of 13 September 2005 pointing out that the application had been withdrawn in consequence of the failure to reply to the examination report and that it would be necessary to request its reinstatement, *within 2 months of the date of the letter*. If this is the relevant date, then the 2 month period would have expired in November 2005 and the request would not have been filed in time.
- 23 Dr Pritchard emphasised that although that letter had raised the possibility of reinstatement of the application, it did not overcome Mr Anning’s fundamental misapprehension that the examination reports on the international and then the UK applications made it very difficult to get the protection he wanted and that he had to do more work on his invention. Thus, not until the meeting on 23 March 2006 did the penny finally drop that he could have got somewhere by replying to the examination report and submitting amendments. Dr Pritchard urged me to look at Mr Anning’s actual state of mind rather than what he perhaps ought to have understood from the letter.
- 24 Although I have some misgivings on this point given the very clear steer towards requesting reinstatement in the letter of 13 September 2005, I am prepared to give Mr Anning the benefit of any doubt. I therefore accept that he did not finally realize that reinstatement should not be postponed to await further work until the meeting of 23 March 2006, and that this should be regarded as the point at which the cause for non-compliance was removed. I therefore consider the application to have been filed in time.

Was the failure unintentional?

- 25 Dr Pritchard’s skeleton argument took up the *Heatex* line of argument in the “Manual of Patent Practice” which I have mentioned above. Accordingly he sought to distinguish *Heatex* and a line of decisions of the comptroller deriving

from it – *Meunier’s International Application* (BL O/031/01), *Pilat’s International Application* [2003] RPC 13 and *MacMullen’s Application* (BL O/307/03) – in order to show that Mr Anning had not manifested any positive intention to abandon the UK application and had maintained a continuing underlying intention to proceed with the application.

- 26 I do not think that I need to go into these in any detail (they are summarized adequately for the present purposes in paragraph 123.37 of the Manual). I accept on the evidence before me that Mr Anning had always intended to keep the UK application in being, even though (as Dr Pritchard euphemistically put it), there was a considerable amount of “fog” between attorney and client as to what options were open to Mr Anning.
- 27 However, Dr Pritchard referred me to the comment of the hearing officer in *Pilat* that he was not bound by the views expressed in *Heatex* and that each case had to be decided on its merits. As he correctly reminded me, the test is whether the failure to comply was unintentional and I should therefore avoid looking beyond this and inadvertently adding a “gloss” to the wording of section 20A.
- 28 Notwithstanding the comments in the Manual about the application of the “continuing underlying intention” test of *Heatex* to requests for reinstatement, they are not binding on me and I think that if they are uncritically applied there is indeed a danger of going beyond the clear meaning of the statute. As Dr Pritchard pointed out, the *Heatex* test stresses continuing intention throughout the life of an application, whereas section 20A hinges on failure at a particular point in time. I agree, and I think this chimes with the observations of the hearing officer in the *Sirna* case, to which I drew Mr Pritchard’s attention just before the hearing.
- 29 In *Sirna*, the hearing officer pointed out that although something similar to an “unintentional” test had developed via *Heatex* when deciding whether the comptroller’s discretion should be exercised to extend time limits under rule 110(4), this was not the same as the statutory test in section 5(2C) concerning whether failure to file an application within the normal priority period was unintentional. In his view the body of case law built up under rule 110(4) could not be applied to section 5(2C) unless common threads emerged, eg if the intentions of the applicant were not clear and detailed analysis of evidence was required. I think the same considerations apply to the “unintentional” test in section 20A.
- 30 Dr Pritchard accepted that *Sirna* was a better foundation than *Heatex* on which to proceed and indeed urged me to interpret “unintentional” according to its normal English meaning – although he thought that reinstatement could be justified on either basis on the arguments that he had put forward. I agree that I should interpret the statute in this way. However, although I accept Dr Pritchard’s argument that Mr Anning has manifested a continuing underlying intention to proceed with the UK application, I do not think it necessarily follows that his failure to reply to the examination report in time was unintentional.

- 31 Indeed, it seems clear to me from the evidence, and particularly paragraph 6 of his second witness statement, that Mr Anning fully intended not to reply to the examination report in question. This was because he had made a conscious decision, albeit based on a misunderstanding of the options open to him, to delay any response until he had done some more work on his invention. He failed to reply, not because he had abandoned the application but because he had put it “on hold” for the time being. However, on the clear meaning of the term, I do not see how his failure can be considered “unintentional”.
- 32 I do not think it is relevant that the failure occurred because of a mistake on his part, even though it might have arisen because of misunderstandings between himself and FHS or because he was preoccupied with what I accept were very distressing personal circumstances. Adopting the reasoning in *Sirna*, it seems to me that, although in most cases a request for reinstatement will be based on a mistake having occurred at some point, it does not follow that a mistake will of itself satisfy the requirements of section 20A. Such an interpretation would in my view go beyond the clear wording of section 20A and substitute a different test from that intended by the legislation.

Conclusion

- 33 I sympathise with the difficulties which Mr Anning has faced and accept that he has devoted considerable effort and resources to the development of his invention (as explained in his second witness statement). However, I conclude that his failure to comply with the period specified in the examination report was not unintentional as required by section 20A(2). I therefore refuse his request to reinstate the application.

Appeal

- 34 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

R C KENNEL

Deputy Director acting for the Comptroller