



PATENTS ACT 1977

APPLICANT Ibrahim Ghulam Murad Ali, Jamal
Kashani, Mehdi Farzpourmachiani and
Ali Farzpourmachiani

ISSUE Whether the request to reinstate patent
application number
GB0225836.6 has been filed in time
under rule 36A(2) and if so should it then
be reinstated under Section 20A.

HEARING OFFICER Mrs. C. A. Farrington

DECISION

Introduction

- 1 This decision concerns whether the application to reinstate patent application GB0225836.6 was filed in time and if it was, should it then be reinstated.
- 2 Patent application GB0225836.6 for an image display system was filed on 6th November 2002 with a priority date of 29th July 2002. The four applicants – Ibrahim Ghulam Murad Ali, Jamal Kashani, Mehdi Farzpourmachiani and Ali Farzpourmachiani - were represented by the firm of Marks & Clerk, Manchester.
- 3 The application proceeded normally and was published as patent number GB 2391414 A on 4th February 2004. A request for substantive examination was filed on 3rd August 2004 and a first report under s.18 (3) was issued on 29th April 2005 to which a reply was received on 25th October 2005.
- 4 A further s.18 (3) report was issued on 30th November 2005 with a reply date of 30th January 2006. The reply date was subsequently extended at the request of the applicants to 2nd May 2006.

- 5 No reply was received by the date of 2nd May 2006 specified by the examiner, or to the reminder subsequently issued by the Intellectual Property Office (“the Office”) on 14th December 2006. That reminder warned of refusal of the application if no reply was received by 29th January 2007 (the date of expiry of the period prescribed by rule 34 of the Patents Rules 1995 for putting the application in order (now rule 30 of the Patent Rules 2007)). No reply was received by 29th January 2007, so consequently, the application was treated as refused under section 20(1) of the Patents Act 1977.
- 6 On 26th July 2007 a Form 14 was filed to request reinstatement of the application. Evidence to support the request in the form of two witness statements from one of the applicants (Mr Ibrahim Ghulam Murad Ali) was filed on 20th December 2007 and 7th January 2008 respectively.
- 7 An official letter of 11th March 2008 requested further information and a third witness statement from Mr Ali was filed on 2nd May 2008. Further evidence was requested on 12th August 2008 and a fourth witness statement from Mr Ali was filed on 17th September 2008 together with a witness statement from Mr Mark Lloyd Kenrick of Marks and Clerk (“M&C”).
- 8 After consideration of all the evidence filed the applicants were informed that it was the preliminary view of the Office that the conditions for reinstatement had not been met. The Office’s view was that the request for reinstatement was filed outside the time permitted by rule 36A (2) - now rule 32(2). The applicants did not accept this view and in lieu of a hearing, requested a decision be taken based on the papers on file.
- 9 It now falls to me to decide, from the papers on file, whether the request for reinstatement has been made in time. If after consideration of all the evidence I find against the applicants, I will refuse this request for reinstatement. However, if I find that it has been filed correctly in time, given that the original application for reinstatement and the evidence supplied addressed the full requirements of section 20A of the Act, I will go on to make a decision based on the full provisions of the law.

The law

- 10 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:

20A.-(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.

- 11 The relevant rule when the request for reinstatement was made was rule 36A of the Patents Rules 1995 (as amended), (now rule 32 of the Patent Rules 2007) which states:

(1) Any request under section 20A for the reinstatement of an application shall be made before the end of the relevant period.

....(2) The relevant period shall be 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.

The evidence

- 12 The evidence submitted is in the form of four witness statements from Mr Ibrahim Ali and one from M&C. In his evidence Mr Ali states that he is authorised to act for all the applicants.

- 13 His statement explains that in early 2005 he decided to deal directly with M&C and dispense with the Iranian law firm he had used for filing of the application in suit.
- 14 Initially all correspondence from M&C was copied to all four applicants and, on 24th March 2006, Mr Ali received a facsimile message from M&C indicating that in the absence of instructions they were treating the application as abandoned. Mr. Ali states in his evidence that he did not intend for this application to lapse, but he was unable to respond at that time as he had business commitments including meetings in Switzerland and Vietnam. He therefore asked his co-applicant Mr Mehdi Farzpourmachiani to instruct M&C to seek an extension of time to respond. Mr Farzpourmachiani did this and M&C obtained the extension to 2nd May 2006.
- 15 Mr Kendrick of M&C then wrote directly to Mr Farzpourmachiani on 30th March 2006 advising him that the new deadline was 2nd May 2006 but that without a further payment on the applicants' account they could not take any further action on their behalf. Mr Ali himself received no further correspondence about the application at that time. The statement from Mr Kendrick of M&C confirms that his letter of 30th March 2006 was sent solely to Mr Farzpourmachiani because he was the only one of the four applicants who had responded to his earlier letter of 24th March 2006.
- 16 In his second witness statement Mr Ali makes reference to the serious illness of his father during 2006 and that much of his time was occupied in caring for his father therefore he had had significantly less time to devote to his business interests. This contributed to his failure to provide instructions in respect of the response to the examination report. Mr Ali's father died on 29th December 2006 and a copy of the death certificate is on file.
- 17 On 29th May 2007, whilst in correspondence with M&C about another application Mr Ali enquired as to the status of the application in suit. He was informed by M&C in a letter dated 4th June 2007 that it had been treated as abandoned. Mr Ali immediately instructed M&C to initiate reinstatement action on the application.
- 18 Mr Ali was asked by the Office to explain what action Mr Farzpourmachiani took on receipt of the 30th March 2006 letter from M&C. In his third witness statement Mr Ali states that it was difficult to communicate with Mr Farzpourmachiani as he was based in Iran where his activities were restricted; neither was it possible for Mr Farzpourmachiani to make a payment to M&C as the Iranian banking system is not connected to the International Monetary System and the transfer of funds to the UK is not possible.
- 19 Mr Ali also states that Mr Farzpourmachiani sent him a fax on 1st May 2006. The fax advised Mr Ali that Mr Farzpourmachiani had received notification from M&C advising of a deadline of 2nd May 2006 to *"pay cost of patent related to British Patent Application no. 0225836.6 I cannot succeed to speak with you so I will send this fax for you"* The message ends *'Notice: our time is limited and our opportunity is until tomorrow'*. A copy of the fax accompanied the fourth witness statement as Exhibit IGMA1.

20 Although this fax was sent on 1st May 2006 (one day before the expiry of the extended time period for responding to the s.18 (3) examination report issued on 30th November 2005), Mr Ali states that he did not have access to it until 5th May 2006 due to his absence on business. He therefore did nothing in response to the fax as it seemed to him that it was by then too late to respond to the examination report.

The Arguments

21 The Office's view, set out in a letter dated 17th December 2008, is that Mr Ali received the fax from Mr Farzpourmachiani on 5th May 2006 and was therefore fully aware of the position regarding the application and therefore the date of the removal of the cause of non compliance was in fact 5th May 2006. But Mr Ali took no action. He only enquired about the status of the application more than a year later in May 2007 and at that point the situation was the same as it had been in May 2006. He was in possession of no further information at that point and therefore the date of the removal of the cause of non compliance had to be 5th May 2006. As such the request for reinstatement was filed outside the time permitted by rule 36A(2)(b).

22 M&C's response on behalf of the applicants argues that the cause of non compliance with the 2nd May 2006 deadline was Mr Ali's preoccupation with his father's illness. Only receiving the fax from Mr Farzpourmachiani on 5th May 2006, he believed he was already out of time to respond to that deadline. At that point he was still distracted by his father's serious illness and was only properly able to consider the status of this patent application and his various business matters some time after his father's death in late December 2006. Therefore, M&C argue that the removal of the cause of non-compliance did not actually occur until 4th June 2007 when Mr Ali received a response from M&C following his enquiry on 29th May 2007 about the status of the application.

23 In a further official letter dated 17th August 2009 the Office's preliminary view is restated. This view is that Mr Ali's fourth witness statement suggests an acceptance that at 5th May 2006 it was "too late to respond to the examination report". Whilst there is considerable sympathy with his family circumstances Mr Ali was in possession of the full facts at that point and was in a position to take some action but he chose not to.

Issues to be decided

What was the failure to comply?

24 In order to make a judgement under s. 20A, there are several issues I need to be address. The first is to identify the specific failure by the applicant to comply with a requirement of the Act or rules within a specified period, which had the direct consequence that the application was either refused or treated as having been refused or withdrawn.

25 This is very clear. The chronology of events is summarised above and the applicants do not deny that their failure was to not comply with (i.e. not reply within) the period specified under s.18(3) of the Act for replying to the examination report of 30th November 2005.

Was the request filed in time?

26 The second issue to determine is that given the failure to comply, whether the request for reinstatement complies with the requirement of rule 36A(2) to be filed in time. This is of course the main point in dispute between the Office and the applicants. Rule 36A sets the “relevant period” for a request under s.20A for the reinstatement of an application. Rule 36A(2) states that the “relevant period” shall be the *first to expire* of two possible options.

27 Rule 36A(2)(a) prescribes that the request shall be made within the period of twelve months from termination of the application. The application in suit was terminated on 30th January 2007. That puts the date by which the request had to be made as 30th January 2008. The request in this case was filed on 26th July 2007 clearly within the twelve months referred to in rule 36A(2)(a).

28 Rule 36A(2)(b) prescribes that the request for reinstatement must be filed within a period of 2 months from the date of “*removal of the cause of non compliance*” .

29 But the *relevant* date must be the earlier of these dates. So in order to determine which date is the earlier I need to determine the date of the removal of the cause of non compliance and then see if that date was earlier than the date under r.36A(2)(a).

30 The Office’s point of view is that the date of the removal of the cause of non compliance was 5th May 2006, clearly earlier than the date the request could be made under rule 36A(2)(a) and therefore the application for reinstatement had not been filed within 2 months of this date, it having only been filed on 26th July 2007.

31 M&C argue on behalf of the applicants that the relevant date should be considered as 4th June 2007 as that was the date on which the removal of the cause of non compliance occurred. They agree that that date was obviously earlier than the date set under r.36A(2)(a). The request for reinstatement having been filed on 26th July 2007 was clearly filed within two months of that date and therefore on time.

What was the cause of non compliance?

- 32 In order to decide the date when the cause of non compliance was removed, I firstly need to consider what that cause was. In his evidence Mr Ali says that he never intended for the application to become abandoned hence his actions on 24th March 2006. He asked his fellow applicant to get an extension. It is also clear that he personally was not sent any communication as to what the extended date was until he saw the fax from Mr Farzpourmachiani on 5th May 2006.
- 33 On 5th May 2006 Mr Ali became aware of a deadline which, by the time he knew about it, had already expired. He could not comply with it because it was already too late, but he appears to have taken no action to determine what, if anything, he could have done to retrieve the situation.
- 34 The Office's objection is based on the premise that at this point Mr Ali was in possession of the fact that a deadline was looming (Mr. Farzpourmachiani's fax was sent a day before the deadline expired and specifically drew attention to that fact – see paragraph 19 above) and did nothing about it. The evidence indicates that despite Mr Farzpourmachiani's earlier involvement in obtaining the extension of time, it was in fact Mr Ali who was in a position to instruct M&C and was responsible for making funds available to them in order to progress the application. He failed to do this at this crucial point but given that he knew about what needed to be done when he received the fax on 5th May 2006, this must be the date on which the cause of non compliance was removed, the cause being that prior to this date, Mr. Ali was unaware that some action was still required against this application.
- 35 The evidence shows that at this time Mr Ali was understandably preoccupied by the serious illness of his father and was not in a position to properly deal with his business activities including this patent application.
- 36 In hindsight it is easy to see what Mr. Ali should or at least could have done to prosecute this application properly. It is possible that even at the date he first became aware of the failure to comply (i.e. on receiving Mr Farzpourmachiani's fax on 5th May 2006), he could still have asked M&C to request the examiner for a discretionary retrospective extension of time on the deadline to reply to the examination report. However, he is not a patent expert and did not necessarily know this, and it is argued that he was preoccupied with the serious illness of his father in any case and this was in fact the cause of his non compliance. The mere fact that he received the fax from Mr. Farzpourmachiani on 5th May 2006 did not detract from the fact that Mr. Ali was still caring for his sick father between May and late December 2006 when his father sadly died.

37 According to M&C it is only several months after this that Mr. Ali was able to properly assess the status of his various business matters, including this patent. Only on making an enquiry to M&C about a different patent application on 29th May 2007 was Mr. Ali minded to ask about the status of the application in suit. When M&C responded to that query on 4th June 2007, Mr. Ali then immediately instructed M&C to initiate reinstatement action on this application.

38 I am prepared to give Mr Ali the benefit of the doubt on this point. I accept that he had intended to comply but realising that the immediate deadline for responding had passed by the time he saw Mr Farzpourmachiani's fax message he believed that he had missed the opportunity to do so. His family circumstances then being most prevalent in his mind he inadvertently failed to return to the issue of the application and what he might have done at that point to extract himself from the failure to respond to the examination report. I therefore accept this to be the *cause* of his non compliance.

What was the date of the removal of the cause of that non compliance?

39 Other than the dates argued by the Office (i.e. 5th May 2006) and M&C (i.e. 4th June 2007) it seems to me from a reading of the papers on file that there was another possible opportunity for the cause of non compliance to be remedied. The reminder letter issued by the Office on 14th December 2006 which gave a date of 29th January 2007 for putting the application in order may also have alerted Mr. Ali to the consequences of his earlier failure. This deadline date was just after the death of Mr. Ali's father.

40 However, that reminder letter is not specifically addressed in the evidence on file. But the evidence does show that in the absence of further funds from Mr Ali in May 2006 M&C did not enter into any further correspondence with him. Mr. Kenrick says in his evidence that he only corresponded with Mr. Farzpourmachiani after 30th March 2006 as only he had replied to M&C's letter of 24th March 2006, so it seems Mr. Ali may not have been aware of the 29th January 2007 deadline. I must therefore again give Mr Ali the benefit of the doubt that this was not the date on which removal of the cause of non compliance occurred.

41 The other possible point at which the removal of the cause of non compliance could therefore have occurred is when Mr. Ali's father died on 29th December 2006. However, I think it is entirely unrealistic to think that the passing of this sad event would immediately have allowed Mr. Ali to return his thoughts to his business affairs. M&C argue that Mr Ali was only able to return fully to his business affairs in May 2007 and I accept this. At that point the evidence shows he enquired of M&C as to the status of this patent application.

- 42 In my view therefore it was at this point when Mr Ali found himself in a position to address his business affairs and return to the matter of the application in suit. Mr Ali enquired of M&C on 29th May 2007 as to the status of the application in suit and what could be done with it. M&C had given him that information on 4th June 2007. I consider therefore that the removal of the cause of non compliance occurred on 4th June 2007.
- 43 The request for reinstatement was filed on 26th July 2007 which is therefore within the two month period prescribed by rule 36A(2)(b). In my considered view I find that the request was therefore filed in time.

Was the failure to comply unintentional?

- 44 Having established that the request was filed in time the only issue remaining for me to decide is whether the failure to respond to the examination report meets the requirements of section 20A (2)(c) of the Act.
- 45 The essential determination to be made under Section 20A (2)(c) of the Act is that “the Comptroller shall reinstate the application if, and only if -.... he is satisfied that the failure to comply... was unintentional”. It is important that the meaning of this requirement is read and understood in totality.
- 46 It is tempting to merely look at the word “unintentional” and decide whether the evidence demonstrates that the circumstances surrounding the facts of the case were unintentional. This is not the test. The determination is not to be reached by examining and making a judgement of the general surrounding circumstances but rather what the reasons were in specific relation to the *failure to comply* (in this case by not responding to the examination report on time) and then whether that failure was unintentional.
- 47 In his evidence Mr Ali states that he fully intended to reply and that his failure to do so was as a result of an inadvertent oversight caused by the need to care for his seriously ill father.
- 48 I have already found that Mr Ali’s preoccupation with his father’s illness caused the failure to comply with the deadline for replying to the examination report. It is quite obvious that all of these unfortunate circumstances were out of the control of Mr. Ali and unintentional.
- 49 In my view the evidence clearly shows that Mr, Ali’s actions at 24th March 2006 to ask his fellow applicant Mr. Farzpourmachiani to ask M&C to seek an extension of time on the period for reply demonstrates his intention to reply. The fact that his father falling seriously ill during 2006 meant he failed to act upon his intentions is immaterial. The law only requires me to be satisfied that his failure to comply was unintentional, not to examine what his actions were to make his intent a reality.

50 Nowhere in the evidence is there anything to suggest a change of mind or a conscious decision not to reply to the examination report in time and thereby allow the application to deliberately lapse.

51 I therefore consider the failure to comply to have been unintentional

Conclusion

52 I conclude that the request for reinstatement complies with the requirements of rules and that Mr Ali's failure to comply with the period specified in the examination report and then extended was unintentional as required by section 20A(2) of the Patents Act 1977. This failure led directly to the failure to comply with all the requirements of the Act and rules within the prescribed period as required by section 20(1). I therefore allow the request to reinstate this application.

53 Section 20B of the Act sets out, amongst other things, the effects of a reinstatement on the rights of third parties. These rights will apply in the case of the application in suit, as it was published under section 16 before its termination.

54 I refer the application to the IPO for processing of the reinstatement and continued processing of the application.

Mrs. C. A. Farrington

Hearing Officer acting for the Comptroller