



26 April 2010

PATENTS ACT 1977

APPLICANT Michael Daley

ISSUE Whether patent application
GB 0312616.6 may be reinstated under
section 20A or rule 107

HEARING OFFICER J E Porter

Introduction

- 1 Patent application GB 0312616.6 entitled "Power Saver" was filed on 3 June 2003 in the name of Mr Michael Daley, with no claim to an earlier priority date. It was published on 8 December 2004 as GB 2 402 505 A.
- 2 No correspondence was received from the applicant after publication and, in particular, there was no request for substantive examination. The application was in due course treated as withdrawn on 9 June 2005.
- 3 On 30 November 2009, the applicant called the Office's Central Enquiry Unit to discuss the application and the fact that it had been treated as withdrawn in 2005. Later that day, he filed a formal complaint by email. On 14 December 2009, the acting Comptroller and Chief Executive replied to the formal complaint and said that he would "refer the matter to a hearing officer...for a decision according to the law on whether to reinstate your application".
- 4 As a result, the matter came before me at a telephone hearing on 4 March 2010, at which the applicant represented himself.

The law

- 5 Section 18(1) requires the applicant to request substantive examination thus:

Where the conditions imposed by section 17(1) above for the comptroller to refer an application to an examiner for a search are satisfied and at the time of the request under that subsection or within the prescribed period –

- (a) a request is made by the applicant to the Patent Office in the prescribed form for a substantive examination; and*
- (b) the prescribed fee is paid for the examination;*

the comptroller shall refer the application to an examiner for a substantive examination; and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period

6 Under rule 28(2) of the Patents Rules 2007, the “prescribed period” is six months from the date of publication of the application (subject to a few specific exceptions which do not apply here).

7 Section 20A deals with the matter of reinstating applications which have been refused or otherwise terminated. Subsections (1) to (3) are relevant, as follows:

(1) Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is –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

(3) The comptroller shall not reinstate the application if –

- (a) an extension remains available under this Act or rules for the period referred to in subsection (1) above; or*
- (b) the period referred to in subsection (1) above is set out or specified –*

- (i) in relation to any proceedings before the comptroller;*
- (ii) for the purposes of section 5(2A)(b) above; or*
- (iii) for the purposes of a request under this section or section 117B below.*

8 Rule 32 sets out the “relevant requirements” referred to in section 20A(2)(b), and paragraphs (1) to (3) state:

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

(2) For this purpose the relevant period is –

- (a) two months beginning with the date on which the removal of the cause of non-compliance occurred; or*
- (b) if it expires earlier, the period of twelve months beginning with the date on which the application was terminated.*

(3) The request must be made on Patents Form 14.

9 Finally, rule 107 provides a general power to rectify any irregularity of procedure. With regard to extending periods of time, rule 107(3) states:

A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –

- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and*
(b) it appears to the comptroller that the irregularity should be rectified.

10 The six month period under rule 28(2) for requesting examination is one to which this provision applies.

Arguments and analysis

11 What I am being asked to decide is whether in law there is any way for the application to be revived. There seem to be two possible avenues to consider.

12 One is the question of whether the application could be reinstated following an application for reinstatement under section 20A. The other question is whether there has been a procedural error which allows the use of rule 107 to extend retrospectively the period for filing the examination request.

The applicant's submissions

13 In Mr Daley's formal complaint of 30 November 2009, he explained that he had not used a professional representative but that "one of the people working at the patent office offered to help me put the application together". I believe that this would have been a member of staff in the Office's Private Applicant Unit.

14 In his complaint, Mr Daley went on to say that he was given incorrect advice by the Office and was not told that, by failing to file the examination request, he would lose the rights in his patent application. Further, Mr Daley said that he had not received any letters from the Office warning him about this risk.

15 According to the file, the Office issued a standard pre-publication letter on 8 November 2004. This letter contained, at paragraph 3, a warning which was headed "IMPORTANT" and which went on to say that substantive examination had to be requested by 8 June 2005. It also set out the necessary Form and fee.

16 Then, on 24 May 2005, the Office issued a standard reminder letter, warning the applicant that he had not yet filed a request for substantive examination, and that the deadline for doing so was 8 June 2005.

17 At the hearing, Mr Daley confirmed that the two letters were correctly addressed, and that he had not moved house nor had any other problems with the non-delivery of post. He also said that he thought he could recall receiving a letter about publication, but that he did not think it had contained a warning about the need to request substantive examination. He was certain that he had not received the second letter.

18 Mr Daley also said that Office staff had not, in conversations with him, warned him of the need to request substantive examination. He thought this was a failing on the part of the Office which led him to be misinformed. He recalled last speaking to officials sometime between June and December 2004.

19 I asked about the passage of time between termination and his renewed contact

with the Office in late 2009. Mr Daley explained that, in 2005, he had no funds to take the invention forward, but that this had become possible by 2009. He therefore contacted the Office to see how he could progress his application.

- 20 Finally, Mr Daley made clear his disappointment at the turn of events. He said his decision to have his patent application published clearly showed that he wanted patent rights, and that it would not have made any sense to abandon his application at that stage. While he conceded that there had to be time limits involved, and that an application could not remain pending forever, he felt the termination of his application had been unjust and “handled wrongly”, and that he had been let down “by the people who were supposed to give me protection”.

The reinstatement question

- 21 As noted above, the law provides for the possibility of reinstating a patent application that has been terminated. This reinstatement can occur if the comptroller is satisfied that the failure which led to termination was unintentional.
- 22 However, rule 32(2) makes clear that the applicant must request reinstatement by a deadline, and there is a backstop in rule 32(2)(b) which says that the deadline can be no later than 12 months from termination of the application. Under rule 108(1), this deadline is not extendable.
- 23 It follows that, in this case, a request for reinstatement had to be made no later than 9 June 2006. No such request was made and so I cannot see how such a request could now be accepted.
- 24 I also note section 20A(3)(b)(iii), which makes clear that missing the deadline for requesting reinstatement is not, in itself, a failure to meet a statutory requirement which is susceptible to a reinstatement request.
- 25 Since no request for reinstatement was made, and cannot now be made in time, I do not think it necessary or appropriate to go on and consider how such a request may have fared. In particular, I do not think I need to consider whether the failure to file the examination request was an unintentional failure or not.

The Office error question

- 26 Rule 107 can be invoked to extend a time period if there has been a clearly identified error attributable wholly or partly to the Office. It must be a “procedural error” – that is, an error in a statutory or well-established non-statutory procedure.
- 27 Mr Daley contends that the Office was wrong to terminate his application when it did. Having considered this carefully, I can see no support for this view. Section 18(1) is clear and unequivocal – the application must be treated as withdrawn at the end of the period for requesting substantive examination, if no such request is made. That is what the Office did in this case and – whilst I recognise Mr Daley’s disappointment and frustration – I conclude that it was the right action in law.
- 28 Mr Daley also contends that the Office erred by failing to warn him about the need to request examination, and about the consequences of not doing so.

- 29 First, I must consider the official letters which contained the relevant warnings. Although Mr Daley says he did not receive one or possibly both of these letters, there is nothing in the information before me which demonstrates that this resulted from an Office error. The letters appear to have been generated in the proper way, at the right time and with the correct information and address. So I have no basis on which to conclude that, on the balance of probabilities, the Office committed a procedural error in respect of either of the two letters.
- 30 Second, I am not persuaded that a procedural error was made during conversations that Mr Daley had with officials. That is because it seems to me that there is no established procedure which governs the format, content or timing of such conversations. By their very nature, such discussions are informal and often unplanned. Depending on what a caller wishes to discuss, they may focus on matters which have already occurred, or the next stage in the application process, or later stages – or other matters entirely, such as post-grant questions. It is therefore impossible from this distance, and with the information that I have before me, to conclude that a procedural error was committed in one or more particular conversations because an official did not mention that, in the future course of the application, a particular requirement would need to be met in order to avoid termination of the application.
- 31 On the balance of probabilities I find that no error has occurred within the scope of rule 107. It follows that I do not need to go on and consider whether, and under what conditions, discretion should be exercised under that rule to give an extension.

Conclusion

- 32 I conclude that it is too late to request reinstatement of the application successfully. I also conclude that there is no basis on which to invoke rule 107 in order to extend the time period for filing the request for substantive examination. It follows that the application must remain treated as withdrawn.

Appeal

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

Dr J E PORTER

Deputy Director acting for the Comptroller