



15 March 2011

PATENTS ACT 1977

APPLICANT Manjinder S Virdee.

ISSUE Whether the request to reinstate patent application number GB0807755.4 has been filed in time under Rule 32(1) and if so should it then be reinstated under Section 20A.

HEARING OFFICER S.W. Bender

DECISION

Introduction

- 1 Application GB0807755.4 was filed on 29 April 2008 in the name of Manjinder S Virdee (the applicant) and was published on 4 November 2009.
- 2 The application proceeded routinely until 20 April 2010, when the Office sent the applicant a reminder that if he wished to continue with the application the request for a substantive examination should be filed on a Patents Form 10 on or before 4 May 2010.
- 3 The request for substantive examination was filed on 5 May 2010. The Office wrote to Mr Virdee on 6 May 2010 explaining that the request for substantive examination had been filed one day too late, but that it was possible to retrospectively extend the deadline for filing the request if a Patents Form 52 (request to extend a prescribed time limit) and fee was filed by 4 July 2010.
- 4 The Form 52 was never filed.
- 5 On 6 July 2010 Mr Virdee telephoned the Office and was informed that the application had been terminated through failure to file the Form 52. However, he was also informed that it may still be possible to continue with the application. In order to do this he would need to file a request to reinstate the application on Patents Form 14, paying the prescribed fee.
- 6 An official letter was issued on the same day which further explained the

conditions for reinstatement, including that the request must be made within two months of the applicant becoming able to comply with the outstanding requirements. This was a reference to the filing of the Form 52 to request an extension of time in which to file the Form 10 asking for formal examination of the patent application in suit.

- 7 The request for reinstatement was filed on 14 September 2010 together with evidence in support of the request.
- 8 An official letter issued on 15 October 2010 stating that as the request for reinstatement was not filed within two months of being able to comply with the requirements and as that period could not be extended, the application for reinstatement could not be considered. The applicant was given the opportunity to request a hearing on this matter.
- 9 A hearing was requested and was held via telephone before me on 17 January 2011.

The evidence

- 10 Documents accompanying the Form 14 were the only evidence filed. The evidence comprised a witness statement from Mr Stuart Olley, a Director of Specsavers Opticians (Mr Virdee's employers) and three pages of a medication treatment record showing regular entries from Feb –August 2010. The witness statement stated that Mr Virdee had made numerous trips to hospital between February and August 2010 to be treated for a medical condition. It also said he had been preoccupied with his work during this period which had been particularly busy and within which he had had to cope by himself.
- 11 At the hearing Mr Virdee confirmed that he overlooked the need to file the patents Form 10 and the subsequently required Form 52 because of his hospital appointments. He confirmed that he did not stay in hospital during the relevant period but did attend every two weeks.
- 12 Mr Virdee also confirmed that after overlooking the need to file the Patents Form 52 by 4 July 2010, he telephoned the Office two days later and understood that he needed to file the request for reinstatement "as soon as possible" but again because of his health issues he overlooked the date.

The Law

- 13 The provisions for reinstatement are Section 20A and Rule 32. Section 20A(1) states that reinstatement 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*

Section 20A(2) states that –

....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 the rules;*
- and*
- (c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional*

Rule 32 states –

- 32.(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.*
- (4) Where the comptroller is required to publish a notice under section 20A(5), it must be published in the journal.*
- (5) The applicant must file evidence in support of that request.*

The issues

- 14 The determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32.
- 15 In order to do this, the first issue I need to determine is to identify the specific failure by the applicant to comply with a requirement of the Act or rules within a time limit which had the direct consequence that the application was either refused or treated as having been refused or withdrawn.
- 16 The second issue to determine is that given that failure to comply, whether the request for reinstatement complies with the requirement of rule 32(1) to be filed within a prescribed time period.
- 17 If I determine it was, I then need to decide whether the failure to comply with Rule 28(2) and Rule 108 was unintentional.

The analysis

What was the failure to comply?

- 18 The application was initially treated as withdrawn as a consequence of the applicant's failure to comply with the time period prescribed by Rule 28(2) for filing the request for substantive examination on a Form 10, In this case that time period was by 4 May 2010. The Form 10 was filed, but a day late.
- 19 However, this could have been rectified by the filing of a Form 52 (request

to extend a prescribed time limit) under rule 108. This had to be done by 4 July 2010, but was never filed.

20 These facts have not been disputed by the applicant although he argued in mitigation in his evidence and at the hearing that his medical condition and preoccupation with work in the relevant periods caused him to miss these deadlines.

21 Be that as it may and whilst I have every sympathy with Mr Virdee's problems, my finding is that the failure in this case was not to file the Form 52 in time to request an extension of time in which to file the Form 10 asking for formal examination of the patent application in suit.

Was the request for reinstatement filed in time?

22 The applicant requested reinstatement on 14 September 2010, but the Office contends that this request was too late under the terms of Rule 32(2) (a).

23 Again Mr Virdee does not dispute the fact of the date of the filing of the Form 14. At the hearing he told me that as a result of the telephone call he made to the Office on 6 July 2010 and the subsequent letter sent by the Office confirming that conversation, he was aware that he needed to file the request for reinstatement "as soon as possible". Although at the hearing he could not recall the precise date by which he had to file the Form 14, the official letter had stated that the request must be made within two months of the applicant becoming able to comply with the outstanding requirements.

24 Rule 32(1) prescribes that the request must be made before the end of "the relevant period". Rule 32(2) then sets out 'the relevant period' as the first to expire of two possible options. These are:

- Rule 32(2)(a) which prescribes that the request shall be made before the end of "*two months beginning with the date on which the removal of the cause of non compliance occurred*" and
- Rule 32(2)(b) which prescribes that the request shall be made before the end of "*the period of twelve months beginning with the date on which the application was terminated*" if that period expires earlier.

25 The application in suit was terminated on 5 May 2010 and this would put the date by which the request had to be made as 5 May 2011. The request in this case was made on 14 September 2010 which is clearly within the twelve months referred to in rule 32(2)(b).

26 However, the *relevant* date must be the earlier of these two options and rule 32(2)(a) sets out the relevant period as "*two months beginning with the date on which the removal of the cause of non compliance occurred*". Therefore to determine which date is the earlier I need to determine the date of the removal of the cause of non compliance to see if that date was earlier than the date under rule 32(2)(b).

What was the cause of the non-compliance?

- 27 In order to decide the date when the cause of non compliance was removed I firstly need to consider what that cause was. Mr Virdee's only explanation was that he overlooked the need to file the Patents Form 10 and the subsequently required Form 52 because of his hospital appointments. The Witness statement from Mr Olley also says that Mr Virdee was preoccupied with his work in that period when the Forms needed to be filed.
- 28 It is clear then that these were the causes of the applicant's non-compliance.

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

- 29 The Office's view is that the date of the removal of the cause of non-compliance was 6 July 2010 i.e. the date Mr Virdee telephoned the Office and was informed that the application had been terminated through failure to file the Form 52. That conversation was confirmed in the Official letter of the same date explaining the termination and subsequent reinstatement procedure.
- 30 The applicant at no point in these proceedings offered any alternative date as the date of the removal of the cause of non-compliance. It seems to me then on the facts I have before me that the date of removal of the cause of non-compliance must have been 6 July 2010. Therefore the request for reinstatement should have been made by 6 September 2010. Regrettably Mr Virdee did not file it until 14 September 2010.
- 31 The period for filing a request for reinstatement as prescribed by Rule 32 (1) is expressly excluded as a period which can be extended under Rule 108 (1).

Extension of time limits

- 32 The Patents Act allows for certain time limits to be extended, indeed the original failing – to file the request for substantive examination – was extendable under Rule 10. I have considered whether or not it is possible to extend the time for filing the application for reinstatement and I note the provisions of Rule 108(1), which show clearly that it is not. Rule 108(1) and the Schedule it refers to is reproduced below:

108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules **except** a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.*[My emphasis]*

SCHEDULE 4

EXTENSION OF TIME LIMITS

PART 1

PERIODS OF TIME THAT CANNOT BE EXTENDED

rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)

rule 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority)

rule 32(1) (application to reinstate a terminated application) [My emphasis]

rule 37 and 38 (renewal of patents)

rule 40(1) (application to restore a lapsed patent)

Conclusion

- 33 Mr Virdee failed to file the request for formal examination on a Form 10 by the relevant date of 4 May 2010 and although he filed it a day later, it was after the expiry of the period allowed. However despite receiving the correct information regarding the subsequent actions needed to correct that failure, he again failed to file the requisite form and fee to extend the time limit to 4 July 2010. He then also failed to file the reinstatement application within the two months allowed by Rule 32(2)(a).
- 34 I have much sympathy with Mr Virdee. He is a lone private applicant doing his best to comply with what can seem at times sometimes like a complex set of requirements and had to do so at a particularly difficult time for him. However, he became aware on 6 July 2010 of his failure to comply with the requirements of Rule 28(2) and Rule 108. But he failed to take that action within the two months allowed by Rule 32(1)(a) i.e. 6 September 2010 and that period is non-extendable.
- 35 I must therefore refuse the application.
- 36 I do not therefore need to consider whether the failure to comply with Rule 28(2) and Rule 108 was unintentional.

Appeal

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

S. W. BENDER

Hearing Officer

Acting for the Comptroller