



12 July 2012

PATENTS ACT 1977

APPLICANT Nicholas Paul Robinson.

ISSUE Whether the request to reinstate patent application number GB0813303.5 should be allowed under Section 20A and Rule 32(1).

HEARING OFFICER G. J. Rose'Meyer

DECISION

Background

- 1 Application GB0813303.5 was filed on 21 July 2008 in the name of Nicholas Paul Robinson (the applicant) and was published on 25 August 2010.
- 2 The application proceeded until 8 February 2011, 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 with the prescribed fee of £100.00 on or before 25 February 2011, unless a request to extend that time by two months was made at the additional cost of £135.00.
- 3 The Form 10 was not filed by the due date or by the extended period. The next contact Mr. Robinson had with the Office was on 1 July 2011 when he rang and spoke to an official enquiring about the status of his application. He was informed that the application had lapsed due to the non-filing of the Patents Form 10 and its requisite fee, but that it may still be possible to reinstate the application and he was advised how to apply for reinstatement.
- 4 On 5 July 2011 the Office received a Patents Form 14 (Request to reinstate a patent application) along with its prescribed fee of £150.00 and an accompanying letter. Subsequent rounds of correspondence between Mr. Robinson and the Office transpired discussing the circumstances surrounding the lapse of the application.
- 5 On 22 March 2012 the Office wrote to Mr. Robinson offering the preliminary view that based on the evidence he had filed to date, the case for reinstatement of the

application had not been satisfactorily made and as such, based on his request in a letter dated 12 March 2012, a hearing would be appointed on the case.

- 6 Subsequently on 7 June 2012 Mr. Robinson contacted the Office to request that a decision on this case be made from the papers filed in support of the application for reinstatement in lieu of a hearing. This is that decision.

The evidence

- 7 The evidence in this case was letters filed by Mr. Robinson dated 2 July 2011 (received 5 July 2011 accompanying the Form 14); 25 August 2011, 19 December 2011, 12 March 2012 and an attachment to an email sent to the Office on 24 May 2012. I have also considered the official documents on the electronic case dossier.

- 8 The chronology of how this case got to the point of the reinstatement application being made is detailed under the background above and none of these facts are disputed by the applicant.

- 9 The applicant's evidence states that failing to file the Form 10 and fee to request substantive examination of his application was an unintentional oversight caused by a number of factors:

- He was very busy with filing and preparing other patent applications
- He was very busy with other working commitments and online project promotions
- A lack of UK regional development funding support
- Fresh commercial enquiries
- Deceptive expressions of interest and concerns about a number of unethical practices by business contacts and funding bodies which in his view might destroy his intellectual property and cause the demise of the UK manufacturing economy
- Because of the above factors, he did not keep sufficient records of official letters
- Advice by UK IPO staff in the previous summer had led him to mistakenly believe he had two more months to file the search and examination forms and fees than he actually had.
- He felt he could have been better advised in this respect, but had run out of money due to previous patenting and marketing activities and was facing personal bankruptcy if he risked engaging a professional patent agent again.

The Law

- 10 The provisions for reinstatement of patent applications are set out in Section 20A of the Act and Rule 32. The relevant parts of Section 20A state:

Section 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) specified by the Comptroller*

(2)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*

(3) – (9)

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

- 11 In effect the first determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32.
- 12 In order to do this, the first issue I need to determine is to identify the applicant's specific failure 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.
- 13 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 the time periods prescribed by that rule.

- 14 If I determine it was, I then need to decide whether the failure to comply was unintentional.

The analysis

What was the failure to comply?

- 15 The application was initially treated as withdrawn as a consequence of the applicant's failure to comply with the time period prescribed for filing the request for substantive examination on a Form 10 - Rule 28 (1) and (2). In this case that time period was that the Form 10 needed to be filed by 25 February 2011. The Form 10 was never filed.
- 16 However, the applicant had the right to extend that period by the filing of a Form 52 (Request to extend a prescribed time limit) under rule 108 (2), which would have set the deadline as 25 April 2011. This was notified to the applicant in the official letter of 8 February 2011, but no extension of time was sought by the applicant.
- 17 These facts have not been disputed by the applicant although he has made submissions in mitigation in his evidence (see paragraph 9 above).
- 18 Therefore my finding here is straightforward in that the failure of the applicant was in not filing the Form 10 asking for substantive examination of the patent application in suit, along with its prescribed fee of £100.00 by the due date of 25 February 2011 or by the extended period allowed by r.108 (2) of 25 April 2011.

Was the request for reinstatement filed in time?

- 19 The applicant requested reinstatement on 5 July 2011. The issue of whether this meets the requirements of rule 32 (2) has to be established before I can go any further.
- 20 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.
- 21 Dealing with rule 32(2)(b) first, the effective date of termination of the application referred to in this case was the day after the Form 10 and fee should have been filed i.e. 26 February 2011. This would put the date referred to in rule 32(2)(b) by which the request had to be made as 26 February 2012. The request in this case was made on 5 July 2011 which is clearly within the twelve months referred to in

that rule.

- 22 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?

- 23 In order to decide the date when the cause of non compliance was removed, I firstly need to consider what that cause was. In essence, Mr. Robinson's explanation was that he overlooked the need to file the Form 10 because of the reasons given in paragraph 9 above.
- 24 I take these to be the applicant's submissions on what were the causes of his non compliance in not filing the Form 10 on time, but the date on when these causes were removed is not so clear.

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

- 25 The evidence from the papers shows that Mr. Robinson received two official notifications of when the Form 10 had to be filed by. The first was in a letter dated 26 July 2010, which was the "Notification of publication" letter. This, as well as giving the applicant the date of publication of his application, also told him that if he had not already done so, he needed to file his request for substantive examination on a Patents Form 10 (fee £100.00) by 25 February 2011. The second was in the official letter dated 8 February 2011, which gave him the same information along with notification of the right to extend that time by two months with an extra fee.
- 26 So the applicant had the right to file his Form 10 and fee up until 25 April 2012 and would not have become non compliant in not doing so until 26 April 2011.
- 27 However, given I have accepted the applicant's submissions in paragraph 9 above were *the causes* of his non compliance in not filing the Form 10 and fee on time, I need to consider at what date those causes were removed.
- 28 It seems to me on the evidence I have before me that the date of the removal of the cause of non compliance must have been on or around the 1 July 2011, the date on which Mr. Robinson rang the Office and spoke to an official about the status of his application. I say this because Mr. Robinson states in his evidence that he had a fresh commercial enquiry about his invention in mid June 2011, to which he replied by email on 30 June 2011. After that on 1 July 2011 he checked with the Office on the status of his patent application and had it confirmed that it had lapsed. He immediately sent in the Form 14 and fee to request reinstatement the next day. It was received in the Office on 5 July 2011.
- 29 Taking his actions to their logical conclusion, Mr. Robinson was unable to file his Form 10 and fee by the due date or the extended period because of the

circumstances he found himself in, but it is reasonable to assume that those factors had been sufficiently removed by 1 July 2011 when he made his enquiry to the Office and then filed the Form 14 and its fee of £150.00 in order to request reinstatement the following day.

30 Therefore I find that the date of the removal of the cause of non-compliance must have been 1 July 2011. As such under rule 32(2)(a) the request for reinstatement should have been made by 1 September 2011. This is clearly the earlier of the two dates possible under r. 32 (2).

31 As the Form 14 and fee were received in the Office on 5 July 2011, clearly the requirement under rule 32(2)(a) has been met.

32 Having decided that the application for reinstatement of the application was made in time, I now need to decide if the applicant's failure to comply was unintentional.

Was the failure to comply unintentional?

33 The only issue remaining for me to decide is whether the failure to file the request for substantive examination meets the requirements of section 20A (2)(c) of the Act i.e. "*the Comptroller shall reinstate the application if, and only if -... he is satisfied that the failure to comply... was unintentional*".

34 The Office's view is that a sufficient case to show that the failure was unintentional has not been made out.

35 It is important that the meaning of the requirement is read and understood in totality. 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 judgment of the general surrounding circumstances but rather what the reasons were in specific relation to the *failure to comply* (in this case by not filing the Form 10 on time) and then whether that failure was unintentional.

36 Mr. Robinson has stated in evidence that it was never his intention to let the patent application lapse, but it has been established that simply having an underlying intention to proceed with the application does not prove that the failure to comply with the requirement was unintentional (see *Sirna Therapeutics Inc's Application* [2006] RPC 12 and *Anning's Application* (BL O/374/06).

37 The evidence shows that Mr. Robinson received the two notifications from the Office in July 2010 and February 2011 about the date by which he had to file the Form 10 and its fee, including the ability to extend that deadline. It is not entirely clear what Mr. Robinson did with those notifications nor indeed how closely he noted the deadlines or amounts within them.

38 Mr. Robinson's submissions show that he is a passionate inventor who is aware of the importance of his intellectual property rights and indeed has had some experience in the field. As I have outlined above, his evidence shows that for the invention making up the application in suit, he had approaches from and dealings

with a number of parties interested in his invention or in helping finance development of it. It is also clear that these dealings caused him some difficulties and pressures and that things did not always go as Mr. Robinson would have hoped.

- 39 Mr. Robinson also alludes in his latest piece of evidence of 24 May 2012 to being given erroneous information by the Office about the deadlines by which to file his search and examination forms and fees and to a shortage of funds, leading him to becoming worried about personal bankruptcy. He says at one point in his evidence that he had “run out of money”.
- 40 The issue of whether he had sufficient funds to file the Form 10 and pay the requisite fee at the time when it was due is an important one in considering the unintentional nature of the failure, so I should deal with this point here. It seems to me that having an underlying intention to do something which requires a payment, but *knowing* you do not have the ability to make that payment renders the intent meaningless. Therefore the knowledge that you cannot make the payment, leading to not making the payment, must logically be a conscious decision and as such cannot be said to be unintentional.
- 41 Whether Mr. Robinson could afford to pay the Form 10 fee of £100 has never been at issue in this case except in Mr. Robinson’s statement in his latest evidence that he had “run out of money”. On a careful reading of the evidence this seems to refer to a period before the Form 10 and fee were due to be paid. I take this to be a seemingly confused reference to earlier circumstances surrounding the filing of the Patents Form 9 (Request for search) in June 2009 and not applicable to the period in which the Form 10 had to be filed and paid. There is no suggestion in the evidence that Mr. Robinson did not have the funds to pay the fee on the Form 10 at the time when it was due.
- 42 What all this demonstrates is that there were a whole host of surrounding circumstances which were clearly in many cases out of the control of Mr. Robinson and as such unintentionally affected his handling of this application for a patent. However, as I have said, this is not the test under section 20A (2)(c). I need to decide whether the failure to file the Form 10 was unintentional.
- 43 After careful consideration it seems to me that his preoccupation with all the surrounding circumstances to this invention and other patent matters and his other working commitments ultimately led to him inadvertently overlook the deadline for filing the Form 10 and fee on this application for a patent. Even though Mr. Robinson had some experience of the patent process and knew in general terms what he had to do and that he had a deadline by which to do it (albeit one he may not have noted due to poor record keeping), the outside pressures basically caused him to forget these important things.
- 44 It seems to me that the applicant’s failure not to file the Form 10 on time was not a conscious one and as such was unintentional.

Conclusion

- 45 On the evidence I have before me, I am satisfied that the applicant's failure to file the request for substantive examination via a Form 10 and its prescribed fee was unintentional. I am therefore satisfied that the requirements of s.20A (2) have been met and I order that this application be reinstated.

G. J. Rose'Meyer
Hearing Officer
Acting for the Comptroller