



PATENTS ACT 1977

APPLICANT Roy Henry Booker

ISSUE Whether the request to reinstate patent application number GB1014537.3 should be allowed under Section 20A and Rule 32(1)

HEARING OFFICER Mr A R Bushell

DECISION

Introduction

- 1 Application GB1014537.3 was filed on 1 September 2010 in the name of Roy Henry Booker (the applicant) and a search report was issued on 6 January 2011. Prior to the publication of the application on 8 February 2012 Mr Booker telephoned the Office several times to discuss the search report, the documents cited therein, and the possible exclusion of his invention amongst other reasons. One of these telephone conversations took place on 25 March 2011. During this conversation the examiner noted that Mr Booker seemed to conclude his invention was anticipated and that he would not be proceeding further with the application.
- 2 A letter was sent to the applicant on 9 January 2012 informing him that his application would be published on 8 February 2012 and that if he wished to continue with his application he would need to file a Patents Form 10 with a fee of £100 by 8 August 2012. This letter appeared to prompt further telephone calls from Mr Booker to the Office on 29 June 2012 and 2 July 2012 where he again queried the search results he had received and the relevance of the documents cited. During the second telephone call the examiner advised Mr Booker that because of the relevance of the documents cited in the search report, he would be best advised to abandon his application, instead of filing the Form 10 for substantive examination.
- 3 The application proceeded until 24 July 2012, 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 8 August 2012, unless a request to extend that time by two months was made at the additional cost of £135.00.
- 4 The Form 10 was not filed by the due date or by the extended period. The applicant next made contact with the Office during November 2012 when he enquired about the status of his application. In response to this enquiry a letter was sent by the Office on 28 November 2012 informing Mr Booker that his application had lapsed

due to the non-filing of the Patents Form 10 and its requisite fee. The letter went on to inform him that it still may be possible to reinstate his application and advised him of how to do so.

- 5 According to official records the applicant telephoned the Office several times over the next two months and spoke directly with the examiner regarding the reinstatement of his application. On 29 January 2013 the examiner sent Mr Booker what he described as 'something akin to a full examination of his application' even though the application had been terminated for failure to file a Form 10. The letter concluded that there was nothing patentable within the application and it failed on the grounds of novelty, inventive step and through the reliance on specifically excluded matter. In light of this the examiner advised Mr Booker his application was not patentable and recommended that he abandon the application without seeking reinstatement.
- 6 On 19 February 2013 the applicant telephoned the Office's formalities department as he was confused by the letters he had received on 28 November 2012 and 29 January 2013. The formalities examiner advised Mr Booker of how to apply for reinstatement and made a note on the file that the two month deadline for applying should start from then as the applicant had made the Office aware that he was now able to comply with the requirement to file the Form 10 to continue with his application.
- 7 On 16 April 2013 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.
- 8 On 3 May 2013 the Office wrote to the applicant 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 gave him the opportunity to submit further arguments or to request a hearing.
- 9 The applicant took up the offer to be heard and the matter therefore came before me at a hearing on 3 June 2013. Mr Booker represented himself at the hearing.

The evidence

- 10 The evidence filed by the applicant in support of the application for reinstatement comprised of the following:
 - A letter received by the Office on 16 April 2013 when Mr Booker filed his request for reinstatement.
 - A copy of the examiner's letter dated 29 January 2013 which was 'akin to a full examination report'.
 - A document entitled Daimler Mercedes-Benz Adaptive Light System.

The law

- 11 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

- 12 In effect the first determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32.
- 13 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 being refused or withdrawn.
- 14 Having established this, I then need to determine whether the request for reinstatement complies with the requirement of rule 32(1) to be filed within the time periods prescribed by that rule.
- 15 Only if I determine it was, do I then need to decide whether the failure to comply was unintentional under s.20A (2) (c).

Analysis and arguments

What was the failure to comply?

- 16 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 8 August 2012. The Form 10 was not filed by this date.
- 17 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 8 October 2012. This was notified to the applicant in the official letter of 24 July 2012, but no extension of time was sought by the applicant.
- 18 These facts have not been disputed by the applicant although he has made submissions in mitigation in his written evidence and verbally at the hearing on 3 June 2013. Therefore my finding here is 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 8 August 2012 or by the extended period allowed by r.108 (2) of 8 October 2012.

Was the request for reinstatement filed in time?

- 19 The applicant requested reinstatement on 16 April 2013. 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 the Form 10 and fee should have been filed i.e. 8 August 2012. This would put the date referred to in rule 32(2)(b) by which the request had to be made as 8 August 2013. The request in this case was made on 16 April 2013 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 Booker’s explanation in writing and at the hearing was that he failed to file the Form 10 due to a number of interconnecting factors. He claimed that on several occasions prior to the deadline for filing the Form 10 he was, in his opinion, wrongly advised by the examiner not to proceed with his application. He explained that this advice caused him to spend huge amounts of time researching why he considered his patent application to be viable, so much so that he unintentionally missed the deadline for filing his Form 10.

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 Booker received two official notifications of when the Form 10 had to be filed by. The first was in a letter dated 9 January 2012, 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 8 August 2012. The second was in an official letter dated 24 July 2012, which gave him the same information along with the 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 8 October 2012 and would not have been non compliant in not doing so until 9 October 2012.

- 27 However, given I have accepted the applicant's submissions in paragraph 23 above as *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 Even though the applicant's failure to file his Form 10 was caused by a number of interconnecting factors the overriding reason was that he forgot it was due because of the large amount of research he felt it necessary to carry out following the examiners recommendation to abandon the application. I am therefore happy to conclude the date on which the removal of the cause of non compliance took place was when Mr Booker became aware that his application had lapsed and was clear what he needed to do to apply for reinstatement.

When did the applicant become aware his application had lapsed?

- 29 It seems to me that on the evidence I have before me Mr Booker became aware his application had lapsed on 28 November 2012 when he received a letter from the Office informing him that his application had been terminated on 8 August 2012 for failure to file the Form 10. The letter went on to explain how he could apply to reinstate the patent and set out the relevant time period for him to do so.
- 30 I am clear in my mind that this is when Mr Booker became aware his application had terminated, but after reviewing the written evidence I have on file and listening to the applicant's arguments at the hearing I am not sure at this point he was totally clear of what he needed to do to reinstate his patent. At the hearing I asked Mr Booker why he did not file his application for reinstatement within 2 months of the 28 November 2012 letter. He confirmed that he had received the letter but was left confused by the content and what he needed to do next.
- 31 Indeed, following receipt of this 28 November 2012 letter Mr Booker proceeded to telephone the Office on a number of occasions before the 29 January 2013 to ask about reinstating his patent. On each occasion it appears he spoke with the examiner who rather than explain how to go about reinstating his patent continued to raise concerns about the viability of the patent. It is clear that these telephone conversations refocused Mr Booker's efforts on proving the viability of his patent rather than helping him concentrate his efforts on reinstating his patent.
- 32 This research intensified further following the 29 January 2013 when the examiner took the rather unusual step of issuing something 'akin to a full examination report', even though the applicant had not filed a Form 10 and the application had already been terminated. Mr Booker confirmed at the hearing the 10 citations the examiner had raised in his 29 January 2013 letter led to him having to invest a lot of time going through each of them with a 'fine tooth comb'.

So when did the applicant finally become aware of what he needed to do to reinstate his patent?

- 33 It seems to me that on the evidence I have before me the time Mr Booker finally became aware of what he needed to do to reinstate his patent was when he telephoned the Office on 19 February 2013. The telephone conversation report on file confirms that this telephone call was made because Mr Booker found the letters of the 28 November 2012 and the 29 January 2013 very confusing.

- 34 It is not surprising that Mr Booker was confused by these two letters as the first letter told him his application had been terminated and he needed to apply for reinstatement, whereas the second provided him with what was 'akin to a full examination report' even though he hadn't filed a Form 10. I found that even at the hearing Mr Booker was still confused as to whether he had filed a Form 10 or not.
- 35 The telephone conversation report on file confirms that the formalities examiner explained in detail to Mr Booker what he needed to do to apply for reinstatement. The report also states that 'the two month period in which to file for reinstatement should start from today as the applicant has now made us aware that he is able to comply by making this telephone call.'
- 36 At the hearing I asked Mr Booker if he could remember what advice he was given during the telephone conversation. Unfortunately he could not remember whether the formalities examiner had informed him of the two month deadline for filing his application for reinstatement but it is likely she did as the Form 14 and fee were filed within two months of the telephone call.
- 37 I also asked Mr Booker what he meant during the telephone conversation when he said he was now able to comply. Was it that he now fully understood the process for reinstating his patent or did he simply mean that he had finally completed his research into the viability of his application?
- 38 Mr Booker could not remember whether he had finished his research at this point but on the balance of probabilities he thought he probably had. However, he was certain that this telephone call was the first time he knew exactly what he needed to do to continue with his patent application.
- 39 Therefore having considered all the evidence and submissions, I find that on balance, the date of the removal of the cause of non compliance must have been 19 February 2013, as this was the first time Mr Booker understood what he needed to do to continue with his patent. As such under rule 32(2)(a) the request for reinstatement should have been made by 19 April 2013. This is clearly the earlier of the two dates possible under r. 32(2).
- 40 As the Form 14 and fee were received in the Office on 16 April 2013, clearly the requirement under rule 32(2)(a) has been met.
- 41 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.
- 42 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?

- 43 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"*.

- 44 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 judgement of the general surrounding circumstances but rather what the reasons were in specific relation to the failure to comply (in this case not filing the Form 10 on time) and then whether that failure was unintentional.
- 45 Mr Booker stated both in his evidence and at the hearing that it was never his intention to let the patent application lapse, but it has been well established in case law 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)).
- 46 The evidence shows that Mr Booker received two notifications from the Office in January 2011 and July 2011 about the date by which he had to file the Form 10 and its fee, including the ability to extend that deadline. In a letter dated 15 April 2013 he explained the reasons why he did not file this form on time.
- 47 According to his written evidence Mr Booker unintentionally missed the deadline for filing the Form 10 due to the extensive research he was carrying out in order to prove to the examiner that his patent application was viable. The Office took the view that as Mr Booker had received both the letters sent in January and June he knew the date on which the Form 10 was due and because of the examiners comments on patentability made a conscious decision not to file it.
- 48 At the hearing I asked Mr Booker whether he had made a conscious decision not to file the Form 10 because of the advice he had been given by the examiner. He assured me that this was not the case. He fully intended to file the Form 10 along with the prescribed fee by the 8 August 2012 deadline but simply forgot to do so as he was busy carrying out research to prove the viability of his application. He went on to say that he was extremely passionate about his invention and would not have intentionally done anything to harm its progress.
- 49 It seems to me that Mr Booker was receiving conflicting and confusing advice from the office, albeit in genuine efforts to be helpful. On the one hand he was being strongly advised that due to a number of objections, his application was highly unlikely to proceed to grant and that he should abandon his application rather than spend more money in filing his Form 10, but on the other hand he received an official letter reminding him to file the Form 10. Understandably Mr Booker was confused but moved to disprove the examiners view, given his passion for his invention. This led him to throw himself into researching the viability of his invention and consequently inadvertently overlooking the deadline for filing the Form 10.
- 50 After careful consideration it is clear to me that the reason Mr Booker did not file his Form 10 and fee by the required deadline was simply because he forgot to do so. I have seen enough evidence and heard sufficiently persuasive submissions to convince me that Mr Booker became so preoccupied with proving to the examiner his application was patentable, that he simply forgot to act on the two letters he was sent reminding him of the deadline for filing his Form 10.

51 It therefore 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

52 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 S20A (2) have been met and I order that this application be reinstated.

A. R. Bushell

B3 Head of Litigation Section, acting for the Comptroller