



PATENTS ACT 1977

APPLICANT	IT-ACS Limited
ISSUE	Whether patent number GB2448351 can be restored under section 28
HEARING OFFICER	Mary Taylor

DECISION

Introduction

- 1 This decision concerns whether the patent in suit can be restored under the provisions of section 28 following a failure to pay a renewal fee.
- 2 Application GB0707057.6, titled 'Method and apparatus for active system safety', was filed on 12th April 2007 in the name of ITACS Limited (with the name subsequently being corrected to IT-ACS Limited on 24th February 2017). The application was granted as patent GB2448351 B on 21st September 2011.
- 3 The patent was last renewed on 24th May 2018. The following renewal, due on 12th April 2019, was not paid at that point or during the extended period of 6 months allowed for late payments under section 25(4) of the Patents Act 1977 ('the Act'), such that the patent was subsequently deemed to have ceased on that final renewal date.
- 4 The matter came before me at a hearing on 9th March 2022. Professor Schagaev, one of the inventors and owners of the patent, represented himself. I confirm that I have also reviewed the correspondence on file, including Professor Schagaev's detailed pre-hearing letter of 28th February 2022, and taken account of the arguments provided therein in reaching my decision.

Background

- 5 The outcome of this decision is strongly dependent on the timing of various actions taken in relation to the patent, such that it is worthwhile setting out the relevant history of the patent in full. Having been filed on 12th April 2007, the application proceeded to grant on 21st September 2011, and was subsequently renewed with the last renewal payment being made on 24th May 2018.

- 6 On 9th January 2017 a Form 51 was filed to appoint a new firm of attorneys, IP21 Limited, to represent the applicants. IP21 subsequently filed a request to correct the applicant's name, from ITACS Limited to IT-ACS Limited, on 11th January 2017. This correction proceeded in the standard fashion, resulting in the correction being allowed on 24th February 2017 and corrected A and B specifications being issued on 1st March 2017.
- 7 IP21 informed the Office on 14th June 2018 that they were withdrawing as representatives for the applicants. As a result, on 28th June 2018 a RM9 letter was issued by the Office to IT-ACS Limited stating that the registered address for service, that of IP21 Limited, had been withdrawn and requesting that the applicant inform the Office which address they would like used as a new address for service. It was highlighted that the address the letter was sent to, Weavers House on Friday Street, in Painswick, Gloucester, would be used as the address for service in the meantime. The Weavers House address is that which was provided as the address of the applicant on the Form 1 filed with the application on 12th April 2007.
- 8 The patent was due to be renewed again on 12th April 2019, but no renewal payment was received. Subsequently, a number of letters were issued by the Office and sent to the Weavers House address, namely a 'Patent Renewal Reminder' letter which was sent on 15th May 2019 and a 'Notification of Ceasing' letter which was sent on 5th December 2019. No response to these letters was forthcoming, and on 3rd December 2019 the patent was deemed to have ceased on 12th April 2019
- 9 Professor Schagaev contacted the Office on 5th January 2022 via the online "questback" survey, which enables feedback to be left when you seek to renew a patent. An Office response was issued to Professor Schagaev on the same day explaining that the application had ceased due to the renewal fees not being paid. A number of emails were exchanged, first between Professor Schagaev and the Renewals team and subsequently between Professor Schagaev and a legal advisor from the PDTMD Legal section. Professor Schagaev was informed in this correspondence that there did not appear to be any scope for restoring the patent but that he did have the right for the matter to be heard by an independent hearing officer, with Professor Schagaev subsequently requesting such a hearing on 2nd February 2022. Professor Schagaev then provided a detailed letter of 28th February 2022 setting out the reasons why he thinks that the patent should be restored.

The Law

- 10 Section 28 of the Act sets out the requirements for the restoration of a lapsed patent:

28(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the comptroller within the prescribed period.

(2)...

*(3) If the comptroller is satisfied that the failure of the proprietor of the patent –
(a) to pay the renewal fee within the prescribed period; or*

*(b) to pay that fee and any prescribed additional fee within the period ending with the sixth month after the month in which the prescribed period ended,
was unintentional, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.*

11 Section 25 of the Act states:

25(1)...

25(2)...

25(3) Where any renewal fee in respect of a patent is not paid by the end of the period prescribed for payment (the 'prescribed period') the patent shall cease to have effect at the end of such day, in the final month of that period, as may be prescribed.

25(4) If during the period ending with the sixth month after the month in which the prescribed period ends the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly –

(a) anything done under or in relation to it during that further period shall be valid;

(b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and

(c) an act which would constitute the use of the patented invention for the services of the Crown if the patent had not expired shall constitute that use.

12 Rule 40 of the Patents Rules 2007 ('the Rules') states:

40(1) An application under section 28 for restoration of a patent may be made at any time before the end of the period ending with the thirteenth month after the month in which the period specified in section 25(4) ends.

(2) The application must be made on Patents Form 16.

13 Rule 107 of the Rules, which relates to the correction of irregularities of Office procedures, states:

107(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2)...

(3) 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 of the Patent Office; and*
- (b) it appears to the comptroller that the irregularity should be rectified.*

14 Rule 111 of the Rules, which relates to delays in communication services, states:

111(1) The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

(2)...

(3) In this rule "communication service" means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

Arguments

- 15 As was discussed at the hearing, the law provides only a set period within which a patent which has lapsed through lack of payment of the renewal fees may be restored. That time period is set out in rule 40, taking into account section 25 and section 28, and effectively equates to a deadline set at the end of the 19th month after the month in which the renewal fee was originally due. The renewal date of 12th April 2019 meant that the limit at which this patent could be restored as 30th November 2020. Given that this deadline has now passed, there is no scope for restoring the patent under s.28 in the normal run of things. I would note that such a restoration would also have required the filing of a Form 16, with no such form having been filed.
- 16 Professor Schagaev noted at the hearing that the patent had always previously been renewed, and that having paid IP21 for their services he had expected that they would ensure that the patent remained in force. And indeed that was the case during the period that IP21 were acting as representatives, with the renewal fees being paid regularly. It was only once IP21 were no longer representing the patent holders that the issues with which this decision is concerned took place.
- 17 As the normal deadline for restoration passed on 30th November 2020, the only possible options which might enable the patent to be restored are set out in rule 107 and rule 111, which relate to the Comptroller's powers to correct errors arising from irregularities in Office procedures and to extending time periods in response to delays in communication services, respectively.
- 18 In relation to an error or irregularity having occurred in Office procedures, Professor Schagaev queried, both in his letter of 28th February 2022 and at the Hearing, if the Office had incorrectly sent the letters to the Weavers House address in 2019. As noted above, the address for service for the patent had changed to the Weavers House address, which was provided as the applicant's address when the application

for the patent was originally filed, as a result of IP21 withdrawing as representatives for the patent.

- 19 Professor Schagaev explained at the hearing that the patent holders ceased using the Weavers House address at a point after the patent application was filed on account of Brian Kirk, one of the inventors and patent owners and the person responsible for the Weavers House address, having dissolved his company that utilised that address. Professor Schagaev highlighted that the resulting changes of address were recorded at Companies House, and he queried why the Office had not made use of this updated information.
- 20 On this point, the patent legislation requires the Office to make use of the addresses which are provided to it. At a practical level, companies may not want, and indeed often do not want, Office correspondence relating to their intellectual property sent to their primary company address and instead may wish it sent to some other address, for example to that of their patent attorneys or legal department. As such, the law does not require or enable the Office to make use of any updates to addresses which might be filed at Companies House. Rather, it is the responsibility of applicants and rights holders to ensure that the Office has a correct, up-to-date address for service.
- 21 Furthermore, applicants and rights holders may decide not to respond to Office correspondence, and patent holders may choose to allow their patents to lapse by not paying renewals fees, for example if the patent is no longer commercially useful. As such, the Office does not routinely investigate if correspondence is not responded to or if a patent lapses on account of it not being renewed.
- 22 I can therefore see no error or irregularity in the Office procedures which resulted in the letters being sent to the Weavers House address – it is not an Office error if an applicant or rights holder fails to update the Office on a change of address. Nor can I see any error or irregularity in the Office actions which arose as a result of these letters not being responded to and the patent lapsing.
- 23 Having discussed the issues around the use of the Weavers House address, I asked if Professor Schagaev was aware of any other potential mistakes that the Office might have made and he agreed that there were no such potential mistakes.
- 24 The other potential option for extending time periods is rule 111, which enables the Comptroller to extend time periods if there is a failure to do something under the Act or Rules for reasons that were wholly or mainly attributable to a delay in, or failure of, a communications service. I would note that rule 111 does not cover issues such as the provision of an incorrect address, as was the case in this instance, but rather relates to when there has been, for example, a major breakdown in the postal system.
- 25 On this point Professor Schagaev queried if some leeway might be possible due to the disruption caused by the Covid pandemic. Unfortunately, however, none of the dates around which this case revolves fall within or are affected by the period of Interruption Days which the IPO declared in response to the pandemic, which extended from 24th March 2020 through until 29th July 2020. The renewals date of this patent was 12th April 2019, nearly a year before the period of interruption, and

the final date for restoration was 30th November 2020, some months after the end of the period of interruption. As such, there is nothing which can help support any form of extension or leeway on account of the pandemic. At the hearing, Professor Schagaev was unable to highlight any other issues around communication services which might fall within the scope of rule 111.

Conclusion

- 26 From the wider discussion which took place at the hearing and from reviewing the correspondence on file, I think it is clear that Professor Schagaev and his colleagues have had a challenging time with their intellectual property over the years. While it is not my role to provide advice on how best to pursue protection for their inventions, I hope that these previous experiences do not deter Professor Schagaev and his colleagues from seeking patent protection for any subsequent inventions.
- 27 In relation to the restoration of the patent in suit, however, I am bound to follow the legislation I have outlined above. While it is, perhaps, a series of unfortunate events which led us to this point, the time within which the patent can normally be restored has passed. There have been no errors or irregularities in Office procedures which might enable the use of rule 107. There have been no delays or failures of any communication system which might enable the use of rule 111.
- 28 As such, while I am sympathetic to the position of Professor Schagaev and his colleagues, I must conclude that the application to restore the patent does not meet the requirements of the law and I must refuse the application for restoration.

Appeal

- 29 Any appeal must be lodged within 28 days after the date of this decision.

Mary Taylor

Deputy Director, acting for the Comptroller