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PATENTS ACT 1977

APPLICANT Ashraf Mahfouz Abbas

ISSUE Whether discretion should be exercised under rule 100 to alter either the period for payment of a renewal fee under section 25 or the period for making an application for restoration under section 28 for patent GB2317657

HEARING OFFICER B Micklewright

DECISION

Background

- 1 The eighth year renewal fee for patent GB2317657 was due on 26 September 2003. This renewal fee was not paid by that date or during the six months following that date. The patent accordingly ceased on 26 September 2003. The patentee failed to apply for restoration of the patent within the 19 months prescribed by rule 41(1), that is, by 26 April 2005. On 31 May 2006 the patentee, Mr. Abbas, contacted the Patent Office with a view to restoring his patent. The Patent Office replied in a letter dated 13 June 2006 indicating that the period for applying for restoration of the patent had ceased and that the only circumstance in which a late application for restoration could be allowed was if there had been an error, default or omission on the part of the Office, in which case rule 100 could be invoked. The Office stated though that such an error, default or omission had not been identified and therefore it would not be possible to invoke rule 100. The patentee disagreed and requested a hearing. The matter therefore came before me at a hearing on 1 August 2006 in which the patentee, Mr. Abbas, represented himself. Helen Behen attended for the Patent Office.

The law

- 2 Rule 100(2) of the Patents Rules 1995 states:

100.-(1) Subject to paragraph (2) below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity-

(a) which consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;

(b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and

(c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 or 111.

- 3 The Comptroller's discretion under Rule 100 may therefore be exercised to extend times or periods only in cases where the failure to comply with a limitation as to a time or period is attributable at least in part to an error, default or omission on the part of the Patent Office. In the present case the periods in question are the six month period prescribed by section 25(4) for payment of a renewal fee and the period prescribed by rule 41(1) for applying for restoration under section 28.
- 4 It is worth noting that it is not possible to extend either the six month period for paying a renewal fee prescribed by section 25(4) or the 19 month period for requesting restoration prescribed by rule 41(1) using rule 110. Rule 110 may only be used to extend periods of time specified in the Rules, not those prescribed in the Act. It cannot therefore be used to extend the period specified by section 25(4). Moreover rule 110 explicitly states that the period prescribed by rule 41(1) cannot be extended under rule 110. This is why the Office indicated in its correspondence that rule 100 was the only possible avenue for altering the periods in question.

Interpretation

- 5 The Court of Appeal in *M's Application* [1985] RPC 249 set out three conditions for the applicability of rule 100(2):
 - a) The Patent Office is guilty of an error, default or omission (the "omission" being an omission to do something which it can be said there is some sort of obligation to do).
 - b) Such an error, default or omission can be said to have contributed to the failure to meet the time limit.
 - c) The error, default or omission does play an active causative role in the irregularity which has taken place.

6 The Court postulated the possibility that a neglect of some well-established and generally well known practice on which it is well known or may be assumed that all those dealing with the Office can be said to rely – even though it may not be backed up by any statutory or regulatory backing – may constitute an “error or default or omission”, but declined to make a decision to that effect. These conditions were endorsed by the Court of Appeal in *Mills’ Application* [1985] RPC 339, subject to the rider that, with regard to an “omission”, the obligation need not necessarily be of a legally enforceable nature. The judge in *Mills’ Application* then went on to say:

“In my judgment this failure by the Office to perform a specific promise made to the appellant’s agent in accordance with a well-established and generally well-known practice amounted to an “omission” within the meaning of the proviso to rule 100 ...”.

7 Discretion under rule 100 may therefore be exercised in circumstances when there is an error, default or omission on the part of the Office in a well-established and well-known practice, even if that obligation is not one of a legally enforceable nature, and particularly when the Office has made a specific promise in relation to that practice. But to exercise this discretion it still has to be demonstrated that there was an error, default or omission on the part of the Office with respect to that practice.

The patentee’s case

8 Mr. Abbas’ arguments focused on his claim that he did not receive either the Office reminder that the renewal fee was due or the Office notification that his patent had ceased. His initial argument in his letter of 31 May 2005 had two limbs, namely that either the Patent Office did not send the reminders or that they were lost in the post. He also indicated that since 2003 he had been traveling abroad for two or three months at a time, but during those times any letters which arrived at his address for service would have been kept and handed to him upon his return. This indication was presumably to reinforce his argument that he did not receive the Office reminders. Mr. Abbas also stated in this letter that on 7 September 2005 he “wrote to all the patent offices and patent agents worldwide” notifying them of a change of mailing address for all his applications, but that he still received some letters at his old address.

9 Mr. Abbas was subsequently told by the Patent Office that rule 100 could not be invoked for a mistake made by the Post Office, namely a failure to deliver the Office reminders. Accordingly, at the hearing Mr. Abbas presented a new argument, namely that the Office should send important reminders or notifications, such as those relating to a patent ceasing, by recorded delivery. He referred to the large number of letters lost by the Royal Mail each year. He also indicated that he received letters relating to his PCT applications by recorded delivery.

10 Although Mr. Abbas did not express it in such terms, I understood Mr. Abbas’ argument presented at the hearing to be that at least one of the two letters sent to Mr. Abbas concerning his renewal, either the reminder that the renewal was due or the notification that the patent had ceased, should have been sent

by the Patent Office by recorded delivery, and, presumably, that the Office had made an error, default or omission by not doing so which could and should cause discretion under rule 100 to be exercised.

Analysis

- 11 It is useful to point out that in *Ling's Patent and Wilson's and Pearce's Patent* [1981] RPC 85, Whitford J held that it was reasonable for an individual in a small way of business who has taken it upon himself to pay renewal fees without professional assistance to rely on the reminder issued by the Office. Mr. Abbas is therefore entitled to rely on the Office reminder to prompt him to pay the renewal fee. As Mr. Abbas claims that he did not receive either the reminder letter or the notification of cessation, I will also consider whether rule 100 could be applied to extend the period for paying the eighth year renewal fee. I will not deal any further with the substance of the merits of Mr. Abbas' case for restoring the patent under section 28 should his late application for restoration be allowed. I will focus rather on whether his late request for restoration should be allowed.
- 12 In *Kaye's Application* (O/353/99), the applicant had chosen to rely on an Office warning letter that the application was about to be refused in accordance with section 20(1) before dealing with objections in an examination report but claimed that he never received the warning letter and argued that there had been an error, default or omission on the part of the Office in accordance with rule 100. In this case the hearing officer identified the only error, default or omission on the part of the Office which could have caused this to happen would be if the Office did not send the letter or addressed it wrongly. In this case Patent Office records indicated that the letter had been correctly produced and addressed and the hearing officer, weighing the evidence, decided that on the balance of probabilities the Office had correctly addressed and sent the letter. The implication in this case is that any error in the postal service is not an error, default or omission on the part of the Office and that discretion under rule 100 may not be exercised in such cases.
- 13 The present case bears certain similarities to that of *Kaye's Application*. Patent Office records indicate that both the reminder letter and the notification of cessation were generated and addressed to the applicant at the correct address for service. It is possible, although unlikely, that one of them for some reason failed to be posted by the Patent Office but is very unlikely that both letters were for some reason never posted. There is no evidence which suggests a reason to doubt that either letter was posted by the Patent Office and it is therefore my view that, on the balance of probabilities, there was no error, default or omission on the part of the Patent Office in failing to correctly address and send either the reminder or the notification of cessation. It is also possible that both letters were lost in the post and never reached Mr. Abbas but I also consider this possibility to be unlikely. Even if this was a realistic possibility rule 100 cannot be invoked for mistakes made by the postal service but only to errors, defaults or omissions on the part of the Patent Office.
- 14 I will now address the argument Mr. Abbas focussed on at the hearing, namely that the Patent Office should have sent the reminders by recorded delivery. My

task here is not to decide whether the Patent Office, as a matter of policy, should in general send certain correspondence by recorded delivery. What I have to decide is whether, in the particular cases of the two letters in question in this case, not sending either or both of these letters by recorded delivery amounted to an error, default or omission on the part of the Patent Office.

- 15 The Office has well established procedures for issuing reminder letters and cessation notifications. An element of these procedures is that such letters are sent by post and are not sent by recorded delivery. There is therefore no established or well-known practice or a specific promise in this case to send such letters by recorded delivery. As it was normal practice to send such letters by normal post, the Office did not make an error in sending the two letters by normal post rather than by recorded delivery. Nor did the Office make an omission in so doing as there is not a statutory requirement to do so and neither is doing so a part of established Office practice on which applicants can rely. There was also no default on the part of the Office in sending the letters by normal post rather than by recorded delivery. I therefore conclude there was no error, omission or default on the part of the Office in sending these letters by post rather than by recorded delivery and discretion under rule 100 cannot therefore be exercised on these grounds.

Conclusion

- 16 I can therefore identify no error, default or omission on the part of the Patent Office that made a substantive contribution to Mr. Abbas' failure to either pay the eighth year renewal fee for GB 2317657 by the required date or to request restoration within the period specified in rule 41(1). I therefore refuse the request to exercise discretion under rule 100 to extend either the period for payment of the renewal fee or the period for requesting restoration under section 28.

Appeal

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

B MICKLEWRIGHT

Senior Legal Adviser acting for the Comptroller