



2 March 2011

**PATENTS ACT 1977**

APPLICANT                      Matwell Services Limited

ISSUE                          Whether the request to reinstate patent application number GB0819802.0 has been filed in time under rule 32(1) and if so should it then be reinstated under Section 20A.

HEARING OFFICER              Mrs. C.A. Farrington

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**DECISION**

**Introduction**

- 1 Patent application GB0819802.0 was filed on 29<sup>th</sup> October 2008 in the name of Matwell Services Limited (the applicant). The application is entitled 'Cleaning Apparatus' and relates in particular to cleaning apparatus for commercial flooring mats.
- 2 The applicant used the professional services of David William Bradley (the Attorney) to file the application.
- 3 The £30 application fee was paid at the time of filing and a preliminary examination report was issued on 3<sup>rd</sup> November 2008. This report advised that the search request and fee should be filed by 29<sup>th</sup> October 2009 and that no further reminders would be issued.
- 4 No further communication was received in respect of the application and as a consequence the application was treated as withdrawn with effect from 30<sup>th</sup> October 2009 for failure to comply with the requirements of Rule 22(2).
- 5 On 10<sup>th</sup> September 2010 the applicant made a request for the application to be reinstated by filing a Form 14.
- 6 On 15<sup>th</sup> October 2010 the IPO advised the applicant that the evidence supplied with the reinstatement request clearly showed that the request was made outside the time prescribed by Rule 32(2) and could not be accepted. The applicant was given the opportunity to submit further arguments or to request a hearing.

7 The applicant took up the offer to be heard and the matter therefore came before me at a hearing on 7<sup>th</sup> January 2011. Mrs. Caroline Margaret Morris attended for Matwell Services Limited.

### **Evidence**

8 The evidence submitted by Mrs. Morris in support of the reinstatement request comprised the following:

- a copy of a letter to the Attorney David Bradley dated 8<sup>th</sup> April 2010
- skeleton arguments and background submitted prior to the hearing
- handwritten notes made during various telephone conversations

### **The facts**

9 Matwell Services Limited is a specialist commercial, industrial and domestic cleaning company based in Ledbury, Herefordshire. The company specialises in cleaning commercial entrance matting. The patent application represents an innovative concept which it was hoped would provide a unique commercial advantage.

10 Mrs. Morris became uneasy about the lack of progress of the patent application in early 2010 and at the end of January she contacted the Attorney by telephone to discuss the application. He advised her that the IPO had raised certain enquiries relating to novelty and obviousness which he would be responding to in due course.

11 After some unsuccessful further attempts to contact Mr. Bradley she became suspicious that all was not well and decided to contact the IPO directly. She spoke to Formalities Manager Andrew Cressey on 1<sup>st</sup> April 2010 and was informed that the application had lapsed because no search request had been made by the due date and that no communication had been received from the Attorney since the initial filing.

12 Mrs. Morris then wrote to the Attorney and in her letter to him dated 8<sup>th</sup> April 2010 she sets out her disappointment with the situation, dispenses with his services and advises him that compensation will be sought.

13 In two subsequent telephone calls to the Office on 21<sup>st</sup> April and 10<sup>th</sup> May 2010 Mrs. Morris was advised that the time limit for applying for reinstatement was two months from the removal of the cause of non compliance. The evidence shows her note of the 21<sup>st</sup> April conversation to read "got 2 months to reinstate, £150 + £90 search fee."

14 The applicant next contacted the Office in a letter dated 20<sup>th</sup> August 2010 enclosing a copy of her 8<sup>th</sup> April letter to the Attorney and asking to reinstate the patent application. She also stated that she would in future be employing the services of another firm of Patent Attorneys.

15 An official response was issued on 24<sup>th</sup> August 2010 confirming the facts relating

to the application and its withdrawn status and outlining the procedure for requesting reinstatement.

- 16 A Form 14 requesting reinstatement of the application was then received on 10<sup>th</sup> September 2010.

### **The Law**

- 17 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.*

- 18 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.**

- 19 The application was treated as withdrawn on 30<sup>th</sup> October 2009 as a consequence of the applicant’s failure to comply with the time period prescribed by Rule 22(2) for filing the request for search.
- 20 The applicant has requested reinstatement; the matter I have to decide is firstly whether that request complies with the requirements of Rule 32 and, if it does, whether the failure to comply with Rule 22(2) was unintentional.

## **The Arguments**

### The Office's view

- 21 The IPO has taken the view that the request for reinstatement does not comply with Rule 32(1) as it was made outside the 'relevant period' of two months from the date on which the removal of the cause of non compliance occurred as set out in Rule 32(2)(a).
- 22 The date of removal of the cause is taken to be the date on which the applicant became aware that the application had lapsed due to the failure of her Attorney to file the search request. This date being either 1<sup>st</sup> April 2010 when she first contacted the IPO directly or at the latest 8<sup>th</sup> April 2010 when she wrote to her Attorney. In her letter to him she says "we were reliably informed that this application has now lapsed".
- 23 As the reinstatement request was not made until 10<sup>th</sup> September 2010 it is therefore outside the two month period allowed under Rule 32(2)(a) and cannot be considered.

### The applicant's argument

- 24 In her written evidence and at the hearing Mrs. Morris submitted that she had been badly let down by her Patent Attorney after she had put faith in him to deal with the application. After discovering that the application had lapsed in April 2010 she wrote to the Attorney but to date has received no reply.
- 25 In May 2010 she received notification from the supermarket chain Morrisons that her company's cleaning contract with them was to end with only three weeks notice. The loss of this work after a period of eight years and significant investment in equipment, vehicles and labour was a devastating blow to a small company.
- 26 The company Matwell Services and its associate company Mat Services Limited have struggled during the recession and funds were extremely limited. Over the following months all her time and effort was expended in appealing the decision by Morrisons and in then down sizing and re-assessing the future of the business. This meant that no funds were available to engage another Patent Attorney and no work could be done on the patent application by the applicant.
- 27 Mrs. Morris stated that she put the request in as soon as she could 'get her head around what had happened' and was frank in saying that had her working life 'been ticking over as normal', then the matter would have been dealt with much earlier. Her main concern however was the future of her business and her employees given the circumstances they found themselves in at that time.
- 28 She confirmed that she was fully aware that the application had lapsed when she wrote to the Attorney on 8<sup>th</sup> April 2010 and that she knew the time limit for requesting reinstatement was two months from the date she became able to comply. However, she could not have dealt with it any earlier than she did because of the overriding need to concentrate on urgent matters relating to the

survival of her business.

- 29 The relevant date should therefore be considered as that later date of 20<sup>th</sup> August 2010 when she renewed contact with the Office (see paragraph 14 above) and was then on 24<sup>th</sup> August 2010 sent full details of how to request reinstatement.
- 30 The request for reinstatement was filed on 10<sup>th</sup> September 2010 which is clearly within two months of that date and therefore in time.

### **The analysis**

#### What was the failure to comply?

- 31 The determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32. The first issue 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.
- 32 This is very clear. The chronology of events is set out above and the applicant does not dispute that the failure was not filing the request for search and the associated fee within the time allowed for doing so under rule 22(2).

#### Was the request filed in time?

- 33 The second issue to determine is that given the failure to comply, whether the request for reinstatement complies with the requirement of rule 32(1) to be filed in time. This is the main point in dispute between the Office and the applicant.
- 34 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 it expires earlier.

- 35 The application in suit was terminated on 30<sup>th</sup> October 2009 and this would put the date by which the request had to be made as 30<sup>th</sup> October 2010. The request in this case was made on 10<sup>th</sup> September 2010 which is clearly within the twelve months referred to in rule 32(2)(b)
- 36 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).

- 37 The Office came to the conclusion that the date of the removal of the cause of non compliance was 8<sup>th</sup> April 2010 when the applicant wrote to her Attorney following her conversation with the IPO and in full knowledge that a failure to comply had occurred and that the application had lapsed as a result. The request for reinstatement was clearly not filed within two months of this date.
- 38 The applicant argues on the other hand that the relevant date should be considered as the later date of 20<sup>th</sup> August 2010 when she renewed contact with the Office and was then sent full details of how to request reinstatement on 24<sup>th</sup> August 2010. The request for reinstatement was filed on 10<sup>th</sup> September 2010 which is clearly within two months of that date and therefore in time.

What was the cause of non compliance?

- 39 In order to decide the date when the cause of non compliance was removed I firstly need to consider what that cause was. In her evidence Mrs. Morris says she instructed her Attorney to file and progress the application. She entrusted it to him and expected him to act in a professional manner and to do what was required. That was an entirely reasonable expectation.
- 40 The patent application is important to the applicant's business; she therefore fully intended to comply with the requirements and to that end employed the services of a Patent Attorney. She expected him to comply with her instructions which included filing the search request. At the hearing she referred to a letter from him dated 1<sup>st</sup> November 2008 which indicated that he would pay the search fee in about two weeks time. This clearly did not happen.
- 41 When she contacted her Attorney in January 2010 for a progress report she says he claimed the IPO had raised certain enquiries relating to novelty and obviousness which he would be responding to in due course. Her notes of that conversation support this. She accepted the information in good faith and had no reason to suspect that this was not in fact the case and that no communication relating to the application had taken place since the issue of the preliminary examination report in November 2008.
- 42 I have considerable sympathy with Mrs. Morris in this regard. The cause of the non compliance is the applicant's genuine but mistaken belief that the search request had been filed by her Attorney within the time limit. She was therefore unaware that any action was required and I fully accept that she did not know the true facts until April 2010 when her suspicions were aroused and she contacted the Office for information.

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

- 43 The Office argues that the cause of non compliance was removed at the point when the applicant became aware of the full facts and of the terminated status of the application. This is clearly evidenced from her letter to her Attorney dated 8<sup>th</sup> April 2010 and at that point she became able to comply either herself or by instructing Mr Bradley or a different Patent Attorney to act on her behalf. Her own records of the various conversations which took place between 1<sup>st</sup> April and 10<sup>th</sup> May 2010 show that she knew action was needed and what options, including

reinstatement, were available. She did not however take the necessary action to request reinstatement within the time allowed.

- 44 In her evidence Mrs. Morris fully accepts that she was aware that the application had lapsed in April 2010 and when she wrote to her Attorney she expected a response from him. She had received no reply. It was some weeks later and after further telephone conversations with both the IPO and The Chartered Institute of Patent Agents (CIPA) in May 2010 that she fully realised the extent and implications of the situation. She described this at the hearing as being in a 'sort of no man's land'.
- 45 This discovery was followed almost immediately in May 2010 by the termination of her contract with Morrisons which equated to the loss of the bulk of her business. This was in her words 'one of the worst things which could happen to a small company'. She was preoccupied from that point on with urgent matters concerning her business and did not take any action in relation to the patent application until 20th August 2010 when she wrote to the IPO about reinstatement.
- 46 Mrs Morris is not a patent expert; she does not profess to understand the patent system or procedures and therefore employed the services of a professional. She then found herself in the position where her application had lapsed through no fault on her part but she needed to do something about it. The first thing she did, quite understandably in my view, was to write to her Attorney seeking an explanation and redress from him. When nothing was forthcoming she sought further advice from the IPO.
- 47 The evidence shows that Mrs Morris knew the status of the application on 8<sup>th</sup> April 2010 and she knew what needed to be done at the latest on 21<sup>st</sup> April 2010 when she telephoned the Office for the second time – her hand written note of that date (see paragraph 13 above) proves this. She failed to do something at this crucial point, but given that she then knew what needed to be done, I find 21<sup>st</sup> April 2010 to be the date on which the cause of non compliance was removed.
- 48 This means in order to comply with the rules, the request for reinstatement had to be filed by 21<sup>st</sup> June 2010. Regrettably this did not happen.

### **Conclusion**

- 49 I have considerable sympathy with Mrs. Morris and her situation both with respect to this patent application and also her business affairs. However, having become aware of the failure to comply on 8<sup>th</sup> April 2010 and of the action she needed to take on 21<sup>st</sup> April 2010, she put aside matters relating to the patent application until 20<sup>th</sup> August 2010 when she felt better able to deal with them. Unfortunately that time was outside the time allowed by rule 32(1)(a) i.e. 21<sup>st</sup> June 2010 for filing the request for reinstatement.
- 50 I must therefore conclude that the request for reinstatement does not comply with the requirement of the rules to be filed in time and the request must be refused.

51 I do not therefore need to consider whether the failure to comply was unintentional.

**Appeal**

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

Mrs. C.A. Farrington  
Hearing Officer Acting for the Comptroller