

PATENTS ACT 1977

APPLICANT Bode Oluwa

ISSUE Whether the request to reinstate patent application number GB0911197.2 should be allowed under Section 20A and Rule 32(1)

HEARING OFFICER A. R. Bushell

DECISION**Introduction**

- 1 Application GB0911197.2 was filed on 29 June 2009 in the name of Bode Oluwa (the applicant) and was published on 5 January 2011.
- 2 The application proceeded until 21 June 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 5 July 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 but was submitted along with the reduced fee of £80.00 by the applicant via the official online filing system on 15 August 2011. However, no Form 52 and fee of £135.00 to extend the time period accompanied the Form 10.
- 4 An official letter was sent to the applicant's registered address for service on 17 August 2011 informing the applicant that as his Form 10 had been filed late he needed to file a Form 52 and fee of £135.00 by 5 September 2011 to allow the late filing. No Form 52 was received by the deadline or indeed at all.
- 5 Two further letters both dated 3 October 2011 were sent to the applicants UK address for service. One letter explained that his application had ceased through failure to file a Form 52 and fee within the specified period and the other outlined that a refund of the Form 10 fee would shortly be made to his bank account.
- 6 On 6 October 2011 Mr Oluwa checked his bank account and noticed a payment of £80.00 had been received from the Intellectual Property Office. Subsequently he telephoned the Office to ask why he had received this payment. Unfortunately no record of this telephone conversation is on file.

- 7 On 11 November 2011 Mr Oluwa wrote to the Office requesting we continue with his application but failed to include a Form 14 or the fee of £150.00 required to apply for reinstatement. He enclosed copies of the official letters dated 17 August 2011 and 3 October 2011 to this letter.
- 8 On 28 November 2011 the applicant telephoned the Office to check on the status of his application. He was advised by the Office that he needed to file a Form 14 with a fee of £150.00 to apply for reinstatement. A letter outlining how to apply for reinstatement was sent to his registered address for service dated the next day.
- 9 On 28 December 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 Oluwa and the Office transpired discussing the circumstances surrounding the lapse of the application.
- 10 On 10 May 2012 the Office wrote to Mr Oluwa 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.
- 11 The applicant took up the offer to be heard and the matter therefore came before me at a hearing on 30 July 2012. Mr Oluwa and his partner attended the hearing.

The evidence

- 12 The evidence filed by Mr Oluwa in support of the application for reinstatement comprised of the following:
 - A letter received by the Office on 28 December 2011 when Mr Oluwa filed his request for reinstatement. Attached to this letter was a Chinese work visa, a recent work pay slip and copies of a bank transaction.
 - A one page letter filed on 24 January 2012.
 - A one page letter filed on 12 March 2012.
 - A one page letter dated 26 June 2012.
 - Following the hearing Mr Oluwa submitted further information by e-mail on 9 August 2012.

The law

- 13 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

- 14 In effect the first determination to be made under s20A is whether the reinstatement request complies with the requirements of Rule 32.
- 15 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.
- 16 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.
- 17 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?

- 18 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 5 July 2011. The Form 10 was not filed by this date.
- 19 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 5 September 2011. This was notified to the applicant in the official letter of 21 June 2011, and although a Form 10 was subsequently filed late on 15 August 2011 no extension of time was sought.
- 20 These facts were not disputed by Mr Oluwa at the hearing; however he did present further evidence as to why these deadlines were missed.

Therefore my finding here is 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 by the due date of 5 July 2011. The Form 10 and fee were eventually filed after the due date on 15 August 2011,, but no Form 52 and £135.00 fee to extend the period under rule 108(2) was submitted.

Was the request for reinstatement filed in time?

- 21 The applicant requested reinstatement on 28 December 2011. The issue of whether this meets the requirements of rule 32(2) has to be established before I can go any further.
- 22 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.
- 23 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. 6 July 2011. This would put the date referred to in rule 32(2)(b) by which the request had to be made as 6 July 2012. The request in this case was made on 28 December 2011 which is clearly within the twelve months referred to in that rule.
- 24 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?

- 25 In order to decide the date when the cause of non compliance was removed, I firstly needed to consider what that cause was. In essence, Mr Oluwa's explanation was that he failed to file the Form 10 on time because he is resident in China, but that he was on vacation in the UK and that he needed to refer to all the paperwork relating to his patent, which was at home in China. He did not realise the importance of the deadline in the official reminder letter of 21 June 2011 and chose to wait until he returned home to file the form and make the payment, which was after the deadline had expired.
- 26 At the Hearing Mr Oluwa explained that he telephoned the Office on 15 August 2011 for help in submitting his Form 10 via our online filing system. He claims that at no point during the telephone conversation was he told his Form 10 and fee were being filed late and that he would need to file a Form 52 and relevant fee to extend the period for filing.
- 27 If on 15 August 2011 Mr Oluwa made a general enquiry to the Office about the mechanics of filing of a Form 10 online, then I can understand why he was not given further information about his specific application. However, I accept Mr Oluwa's submission that in the circumstances of the phone call he made to the Office, he assumed he had complied with the request to file a Form 10 and relevant fee after he successfully completed the online transaction. Understandably he then took no further action in relation to his application as he was under the impression he had met the outstanding requirement and would be contacted in due course about subsequent necessary actions.
- 28 The cause of the non-compliance is therefore clear; Mr Oluwa was under the misconception that he had complied when he submitted his online Form 10 and fee on 15 August 2011. It follows then that the removal of the cause of non compliance must be the date on which that misconception was corrected so that Mr Oluwa realised he had in fact still not complied with the requirement to pay the Form 10 and fee on time.

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

- 29 It was unclear from the papers filed prior to the hearing on what date Mr Oluwa realised he had failed to comply with our requirements. Following the late online filing of his Form 10, an official letter dated 17 August 2011 was sent to Mr Oluwa's UK address for service informing him that he needed to file a Form 52 with the relevant fee by 5 September 2011 to allow the late filing.
- 30 As no response was received in the Office, two further letters both dated 3 October 2011 were sent to the applicants UK address for service. One letter explained that his application had ceased through failure to file a Form 52 and fee within the specified period. And the other outlined that a refund of the Form 10 fee would shortly be made to his bank account.

- 31 On the face of it the receipt of either of these letters would have at least alerted Mr Oluwa to the fact that there was a problem with his patent application. One of the letters would arguably have unequivocally removed the cause of non compliance (i.e. his misconception that the Form 10 and fee had been paid in time) as the letter was quite specific in explaining the status of the application.
- 32 However, Mr Oluwa states in his evidence that there had been a delay in him receiving these letters, so the date of the removal of the cause of non compliance required further investigation.
- 33 The applicant's letter of 11 November 2011 states that "...in October 2011" the applicant checked his bank account and noticed that £80.00 had been refunded by the Office. He therefore telephoned the Office to enquire about the refund. On the evidence I had before me prior to the hearing it appeared that this was the date on which the cause of non compliance would or could have been removed as it seemed reasonable that the Office would have told him during that phone call the reason the money had been refunded to him...If the telephone call had taken place before the 28 October 2011 then Mr Oluwa's application for reinstatement would have been filed out of the time allowed under rule 32(2)(a) – the application for reinstatement having only been filed on 28 December 2011. It therefore became essential to establish the date of that phone call. Mr Oluwa was therefore contacted by e-mail just prior to the hearing to provide the specific date he contacted the Office in October 2011.
- 34 Mr Oluwa responded by saying that he checked his bank account and telephoned the Office on the same day in October 2011 but could not recall the exact date.
- 35 At the hearing I explained the importance of this date – i.e. I needed it in order to determine whether his application for reinstatement was filed in time, because if it was not, there will be no reinstatement application to consider further. I asked the applicant to think hard about when he had telephoned the Office.
- 36 I also asked Mr Oluwa what information he had been told in his telephone conversation with the Office. He stated he received confirmation the Office had refunded £80.00 to his account but was not told why. He claims he was told to refer to the relevant letters sent to his UK address for service in August and October 2011 for an explanation as to why he had received this money. The Office does not have a record of this telephone conversation on file to refer to, so I only have Mr Oluwa's version of events to rely on. Mr Oluwa seemed to me to be an honest and trustworthy witness who did his best to recall events as best he could. On the basis of this, I am content at his recollection of events..
- 37 Having accepted Mr Oluwa's submissions on the content of his telephone conversation with the Office in October, it became clear that he was still not aware that he had failed to comply with the requirements for filing his Form 10 even after this telephone conversation, therefore the removal of the cause of non compliance had still not occurred. The date of that phone call therefore did not transpire to be the crucial date.
- 38 The crucial date now appeared to be the date that Mr Oluwa received the official letters sent to his UK address for service in August and October 2011. Copies of

these letters were enclosed with his letter of 11 November 2011 (see para 7 above) so it was clear he had received them sometime between his telephone conversation with the Office and before filing this letter. The letters explained why the refund had been made and what the applicant needed to do to apply for the reinstatement of his patent. By reading these letters Mr Oluwa would have been fully aware he had not complied with our requirements for filing his Form 10 and therefore in my view the cause of non compliance would have been removed.

- 39 The date he received these letters was vital, so I asked Mr Oluwa whether he could remember when they were received. I pointed out to him that copies were included in his letter to us of 11 November 2011 so it must have been before this date. He conferred with his partner over how long post takes to arrive in the UK from China. He explained that he knew he wrote to the Office as soon as he received these letters so if he could establish how long post takes he would be able to provide us with a rough date.
- 40 He estimated that post from China should take between 5 to 7 days to arrive in the UK so he was happy to state that he had received these letters around the 4th to the 6th November 2011. Again, Mr Oluwa offered to check his records following the hearing to see whether he could give an exact date.
- 41 Following the hearing, Mr Oluwa e-mailed the Office on 9 August 2012 with further details surrounding the telephone conversation and receipt of our official letters. He confirmed that he telephoned the Office on 6 October 2012 and sent in copies of his bank statement to prove it was October's statement in which he noticed a refund of £80 had been made. He also confirmed he did not receive copies of our letters dated 17 August 2011 and 3 October 2011 until 3 November 2011. Following the telephone conversation he had with the Office his parents had forwarded him copies of these letters. Unfortunately these letters were sent to his work place and as he was on holiday with friends he did not receive them until 3 November 2011. As stated in the hearing he confirmed that after viewing these documents he wrote immediately regarding the reinstatement of his patent.
- 42 It seems to me on the submissions provided at the hearing and in the subsequent e-mail, the date of the removal of the cause of non compliance must have been the 3 November 2011. According to Mr Oluwa this was the first time he became aware he had not complied with the statutory requirements for filing his Form 10, so it was the first opportunity he could do anything about it. However, even though Mr Oluwa had now received the letters explaining the reinstatement process he still did not file the relevant form and fee to apply for reinstatement. At the hearing he explained that as he was unfamiliar with the patent process he required more guidance from the Office. After further help from the Office by telephone and in an official letter dated 29 November 2011 Mr Oluwa filed his application for reinstatement on 28 December 2011.
- 43 Summarising, Mr Oluwa filed his Form 10 and fee online on 15 August 2011 assuming that he had complied with the outstanding statutory requirements. It was only when he received copies of the official letters of August and October 2011 on 3 November 2011 that he became aware that he had failed to comply.

- 44 Therefore having found that the date of the removal of the cause of non compliance was 3 November 2011, the request for reinstatement should have been made by 3 January 2012. This is clearly the earlier of the two dates possible under rule 32(2).As the Form 14 and fee were received in the Office on 28 December 2011, clearly the requirement under rule 32(2)(a) has been met.
- 45 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?

- 46 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"*.
- 47 The Office's view is that a sufficient case to show that the failure was unintentional has not been made out.
- 48 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.
- 49 Mr Oluwa 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 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).
- 50 The evidence shows that Mr Oluwa received two notifications from the Office dated December 2010 and June 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 (incorrectly) dated 6 February 2012 he explained the reasons why he did not file this form on time.
- 51 According to the evidence Mr Oluwa was on vacation in England at the time the Form 10 was due to be filed and was in possession of the two official notifications referred to above. However, he decided to wait until he returned home to China before filing the form. He admitted both in his evidence and at the hearing that this was probably not the right approach but wanted to have all his paperwork in front of him before continuing with the application process.
- 52 At the hearing Mr Oluwa explained he was unfamiliar with the patent application process and therefore unaware of the consequences of his actions. He also mentioned that as a great deal of mail continues to be sent to his address in the UK he may not have read the notifications from the Office in any great detail and

therefore failed to appreciate the impending deadline for filing his Form 10. It was clear from his submissions however that he knew that a deadline existed.

- 53 Mr Oluwa submitted he showed his intention to continue with the application on 15 August 2011 by filing his Form 10 via our online filing system. Unfortunately there was no Form 52 and accompanying fee to request an extension to the time for filing the Form 10 so the Form was not accepted. In his evidence and at the hearing Mr Oluwa claimed that he telephoned the Office for help in filing his Form 10 via the online system and that he was not told that he needed to request an extension for the filing to be allowed.
- 54 Unfortunately Mr Oluwa does not have a name of the person he spoke to when filing his Form 10 and no Office record of this event exists so it is impossible for me to establish conclusively what advice he was given. However, even if I accept Mr Oluwa's recollection of this telephone conversation, the fact remains that the official reminder letters in December 2010 and June 2011 clearly informed him that if he filed his Form 10 later than the official deadline he would have to apply for an extension of time. He had therefore already clearly been made aware of the need to file a Form 52 and relevant fee.
- 55 However, in deciding on whether the failure to file the Form 10 on time was unintentional I need to return to the 5 July 2011 deadline and analyse the reason why this was missed. I accept that Mr Oluwa is by no means an expert in patent processing and have some sympathy with the fact that he was handling his application himself and wanted the comfort of all his paperwork in front of him before coming to a decision on what he needed to do. However, as this is his only patent application and he had the two official notification letters in his possession whilst in the UK at that time, both of which availed him of all the relevant details he would have needed to complete the requirements, it is unclear as to what extra paperwork he needed in front of him in order to make a decision over whether to file his Form 10 or not. It is easy for me to say that and I accept that Mr Oluwa may not have realised this; but nevertheless, this delay in acting has regrettably proved to be fatal for his patent application in my view.
- 56 The Office's letters dated 6 December 2010 and 21 June 2011 both clearly informed Mr Oluwa what he needed to do to continue with his application and by when he needed to do it. Those letters also stated the consequences if the 5 July 2011 deadline was not met. The evidence shows that Mr Oluwa was aware of what he had to do and that he knew he had a deadline by which he had to do it. He may not have noted the specific date by which he needed to act, despite the official notifications being explicit on this point, but the evidence clearly shows he chose not to continue until he returned to China. That was clearly a conscious decision.
- 57 It seems to me that the applicant's failure to file the Form 10 at a time when it would still have been on time was a deliberate decision and therefore cannot be taken to be unintentional. The other delays and misunderstandings were unfortunate, but still failed to rectify the original failure to comply.

Conclusion

- 58 As stated earlier I have much sympathy with Mr Oluwa who clearly did not understand the consequences of missing this important deadline. However, I have to make a determination based on the facts and how they apply to the law.
- 59 I conclude that as Mr Oluwa was aware of a deadline for filing his Form 10 and chose to put off making this payment until after this had expired. His failure to comply was not unintentional as required by section 20A(2) of the Act. I therefore refuse his request to reinstate his application.

Appeal

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

Andrew Bushell

Hearing Officer

Acting for the Comptroller