

## **PATENT ACT 1977**

IN THE MATTER OF an application  
under section 28 for restoration of  
patent GB 2301029 in the name of  
Mr Kenneth Robert Taylor

### **DECISION**

#### **Background**

1. The renewal fee in respect of the fifth year of the patent fell due on 2 May 1999. The fee was not paid by that date or during the six months allowed under section 25(4) upon payment of the prescribed additional fees. The patent therefore lapsed on 2 May 1999. The application for restoration of the patent was filed on 18 October 2000, within the 19 months prescribed under rule 41(1)(a) for applying for restoration. After considering the evidence filed in support of the application for restoration an official letter was sent to the proprietor Mr Kenneth Robert Taylor on 28 February 2001 informing him that the Patent Office was not satisfied that the requirements for restoration, as laid down in section 28(3), had been met.
2. The matter came before me at a hearing on 17 May 2001. Mr Taylor appeared in person. Mr Ian Sim attended on behalf of the Patent Office.
3. The evidence filed in support of the application consists of several witness statements filed by Mr Taylor before the hearing and one which he filed, with my agreement, after the hearing. He also gave evidence under oath at the hearing.

#### **Facts**

4. From the witness statements Mr Taylor has filed and the evidence he gave at the hearing, the facts can be summarised as follows.
5. Mr Taylor confirmed that he received the official letter from the Office dated 22 December 1998 informing him of the grant of the patent and also that he later received the certificate of grant. Both the letter and the certificate of grant contained guidance about paying renewal fees from which it would have been possible to establish that the fifth year renewal fee had to be paid by 2 May 1999 or, with additional fees, by 2 November 1999. However, Mr Taylor says he misread the information about paying renewal fees contained in both the letter and certificate and did not realise that the renewal date was calculated from the filing date. He says he thought that the first renewal fee was not due to be paid until 12 to 18 months from the date of grant. He also says he was under a lot of pressure at the time from his landlord and was concerned about his sick mother in Scotland.
6. Mr Taylor says he had a diary which he kept in his jacket pocket but unfortunately the jacket was stolen along with the diary. However, he says he cannot remember whether or not he entered a reminder in his diary about paying the renewal fee.

7. In accordance with rule 39(4) of the Patents Rules 1995 the Patent Office sent the official renewal reminder notice, the so called PREN 5 letter, to the address for service for the patent as shown on the register of patents. The letter, which was dated 17 May 1999, was sent to Mr Taylor's home address at 175 West End Lane, West Hampstead, London, NW6 2LH. However, he says he never received the letter.

8. Mr Taylor says he moved from the West End Lane address on 17 April 1999, ie. before the PREN5 was sent. He did not provide the Office with a new address nor did he make any arrangements for his mail to be redirected to another address. The reason for this was that after vacating the West End Lane premises he says he went to stay with friends and did not have a permanent address to which mail could be sent or be redirected. It was not until he eventually moved to Scotland in May or June 1999 to look after his mother, who was critically ill and virtually bed bound, that he had a permanent address again. Moreover, he was not aware that the Office would send him a reminder letter if he had not paid the renewal fee by the due date and so was not expecting to receive such a letter.

9. Mr Taylor explained that his address at West End Lane was a flat in a block which shared a common entrance with a nightclub. The entrance was open to the public, though there was a further separate door in the entrance hall which led to the flats. He says that mail addressed to the occupants of the flats, including himself, would be put through the letterbox into a communal hallway though at the hearing he said it was put either on a shelf inside the doorway or under the door of the club. He admitted that this was not a secure arrangement and says he was aware that mail addressed to the flats often went missing.

10. Mr Taylor says that before vacating his flat at West End Lane he asked a Brazilian friend in the same block if he would collect his mail from the hallway and look after it for him. He would then visit the friend once or twice a week to collect the mail or when the friend contacted him on his mobile telephone to say that mail had been delivered. However he says the PREN5 was not amongst the mail he collected. He later learnt that his Brazilian friend had left the country. Mr Taylor says that he tried to telephone the block of flats to find out if mail addressed to him had been delivered but said the telephone would not always be working and he had difficulty speaking with the residents as they were mostly foreigners who could not speak English.

11. In his witness statement of 1 February 2001, which included a response to a Patent Office letter dated 26 October 2000, Mr Taylor says that after being granted the patent he was told by the Patent Office that he had 18 months to pay the renewal fee but then in January or February 2000 was told that his patent had ceased and that he had until 2 December 2000 to apply to have it restored. He says he did not know this until that time. However, in his response to the Office's letter of 26 October 2000 he says that after visiting a factory in Wembley, he telephoned the Patent Office in August/September 1999 and was told the patent had ceased and that he had 18 months until 2 December 2000 to pay the fee. At the hearing he says he visited the factory and subsequently contacted the Office before he moved to Scotland, so it must have been around May/June 1999 when he was told his patent had ceased.

13. There is clearly some contradiction in these statements as to when Mr Taylor was told

that his patent had ceased, ie when he contacted the Office before he left for Scotland in May/June 1999 (when it had not ceased) or in January/February 2000 (when it had ceased).

### Assessment

14. What I have to decide is whether Mr Taylor has met the requirements as set out in section 28(3) of the Act which provides:

*“If the comptroller is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period, the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.”*

15. I therefore need to be satisfied that Mr Taylor took reasonable care to pay the fifth year renewal fee on his patent. The term “reasonable care” is not defined in the Act or Rules. However, in making my assessment, it is helpful to bear in mind the following statement by Aldous J (as he was then) in *Continental Manufacturing & Sales Inc’s Patent [1994] RPC 542 at page 542 lines 46-48*:

*“The words ‘reasonable care’ do not need explanation, the standard is that required of the particular patentee acting in ensuring that the fee is paid.”*

16. The key factors that contributed to Mr Taylor failing to pay the fifth year renewal fee in time were:

- (A) his mistaken belief that he had 12 to 18 months from grant to pay;
- (B) his non receipt of the rule 39(4) official renewal reminder notice; and
- (C) his understanding that the Patent Office had told him in May/June 1999 that his patent had ceased.

17. The question is, were these the result of any failure on Mr Taylor’s part to take reasonable care?

#### As to (A) above

18. The letter of grant which was sent to Mr Taylor on 22 December 1998 and which he confirms he received, included the following paragraphs:

3. *“IMPORTANT - It is essential that you take note of the following information about annual renewal fees:*

(i) . . . . .

(ii) *For most patents, the first renewal fee is due on the fourth anniversary*

*of the filing date. If you wish, you can pay a renewal fee in the 3-month period before each anniversary.*

(iii) . . . . .

(iv) *If any renewal fee is not paid by the due date, a further six months is allowed in which to pay the fee. No additional fee is payable if payment is received by the Office during the first month after the due date, but payment received during the second to sixth month after the due date is subject to an additional fee, currently £24 per month or part of a month overdue.*

19. The certificate of grant included the following statement on the front page:

*“THE ATTENTION OF THE PROPRIETOR(S) IS DRAWN TO THE IMPORTANT NOTES OVERLEAF”*

20. The notes on the reverse side of the certificate included the following passages:

*“IMPORTANT NOTES FOR PROPRIETORS OF UNITED KINGDOM PATENTS*

*“1. DURATION OF PATENT & PAYMENT OF RENEWAL FEES*

(i) . . . . .

(ii) *To maintain the patent in force, it is necessary for the proprietor or someone on his behalf to pay a prescribed annual renewal fee. Payment may be made on, or during the three month period before, the fourth or subsequent anniversary of the date of filing the application and should be accompanied by Patents Form 12/77.*

(iii) ***The proprietor is responsible for ensuring that effective renewal arrangements are set up and maintained and that fees are paid on time.** He should not await any communication from Patent Office before paying the fee: an official reminder sent to the last recorded address for service within six weeks after the anniversary is intended to alert the proprietor to possible failure of his renewal arrangements.*

(iv) *If the form with the fee is not lodged in the Patent Office on or before the anniversary of the filing date of the patent, the fee cannot be accepted unless application for an extension of time to a maximum of 6 months is made and paid for on a Patents Form 12/77. . . . .”*

21. Mr Taylor should have been left in no doubt from these notes on the letter of grant and the certificate of grant that he needed to pay the first renewal fee on his patent before the fourth anniversary of the date he filed his patent application, ie. before 2 May 1999, or to pay the fee with additional fees before the expiry of six months immediately following that date,

ie. before 2 November 1999. I have great difficulty in understanding how Mr Taylor could have misread the notes in such a way as to believe that he had 12 to 18 months from grant to pay the renewal fee. I can only conclude that he did not take reasonable care in reading the notes despite the fact that they were clearly marked "Important".

22. The fact that Mr Taylor did not know the precise date by which the renewal fee had to be paid and thought it was some 12 to 18 months after grant, means that even if his diary had not been stolen it would not have helped the situation as it would not have contained a reminder entry that was early enough to have prompted him to pay the renewal fee in time. Therefore, his use of the diary could not be viewed as an effective renewal reminder system.

As for (B) above

23. The important notes on the certificate of grant about paying renewal fees, which are reproduced in part at paragraphs 19 and 20 above, referred to the official reminder the Office would send to Mr Taylor within six weeks after the anniversary of the filing date if he failed to pay the fee by then. Mr Taylor was therefore made aware that he could expect to receive a renewal reminder from the Office if he did not pay his renewal fee by the due date. As such, it was incumbent on him to provide the Patent Office with an up-to-date and dependable address to ensure he received this important reminder and any other mail from the Patent Office.

24. The arrangements for receiving mail at the block of flats where Mr Taylor lived was far from secure, as Mr Taylor himself admitted at the hearing. There was no guarantee that any mail delivered to the main entrance to the block would be there when Mr Taylor's friend went to collect the post. Given this precarious arrangements for the receiving mail, I am not convinced that Mr Taylor's continuing reliance on that address after moving out of his flat amounted to taking reasonable care in ensuring that important correspondence reached him. I appreciate that Mr Taylor did not have a permanent address after moving from his flat but this cannot absolve him from his responsibility to provide the Patent Office with a secure and reliable address to which important mail, such as the PREN5, could be sent. While this would not have been straightforward for Mr Taylor, after moving out of his flat, I find it difficult to accept that he could not have made some alternative temporary arrangements by which important correspondence could have been sent to a secure address.

25. It is also worth observing that when Mr Taylor eventually went to live with his mother in Scotland in May/June 1999, he did not contact the Patent Office until some six or seven months later by which time it was too late to pay the renewal fee. Had he contacted the Office soon after moving to his mother's house, it is possible that he may have been alerted to the fact that the PREN5 had been sent to his previous address and that he had until 2 November 1999 to pay the renewal fee with additional fees.

26. I am not persuaded that Mr Taylor took reasonable care in reading the important note on the certificate of grant about the issue of the PREN5 letter or in providing the Patent Office with an up-to-date and dependable address to which such a letter could be sent.

As to (C) above

27. Unfortunately Mr Taylor is unable to say to whom he spoke at the Patent Office in May/June 1999 when he says he was told that his patent had ceased. Mr Sim is unable to find any record of the telephone conversation on the Office's file. I did however allow Mr Taylor time to try and obtain any further evidence to substantiate his claim that he had been given the erroneous information, notably a witness statement from the person he spoke with at the factory in Wembley who suggested he should contact the Office. Unfortunately the person in question has left the company and cannot be found and Mr Taylor has not been able to supply any supporting statements.

28. This said, as identified above, there is clearly some contradiction in Mr Taylor's statements as to when he was told his patent had ceased. On the one hand he says he was told it had ceased when he contacted the Office in May/June 1999, after visiting the factory in Wembley, and on the other hand he says he first became aware that it had ceased when he contacted the Office in January/February 2000. In fact in his first witness statement he says: "Maybe I misunderstood initially, I don't know?" Moreover, at the hearing he said "I cannot remember for the life of me what was said on what date". These remarks throw doubt on what Mr Taylor understood he was told in May/June 1999. In the absence of any records of the conversation or the identity of the person to whom he spoke, it is difficult to establish what in fact was said. I have to say, that I would find it surprising that someone in the Patent Office would tell a patent proprietor that his patent had ceased when there was still time to pay the fee with additional fees, particularly bearing in mind that the status record on the Office's computer system could not have shown the patent as ceased at that time.

29. On the balance of probability I am not convinced that Mr Taylor was misled by the Patent Office in May/June 1999 into believing that his patent had ceased which would have caused him not to pay the renewal fee with additional fees within the six-month grace period which expired on 2 November 1999. What seems more likely is that he misunderstood what he was told which he himself admits may have been the case.

### **Conclusion**

30. I have every sympathy with Mr Taylor given his circumstances in 1999 after leaving his flat and his move to Scotland to look after his sick mother. However, taking all the above factors into account, I am not persuaded that he took reasonable care to see that the fifth year renewal fee was paid. Regretfully therefore I have come to the conclusion that I am not satisfied that the requirements of section 28(3) have been met. Accordingly, I must refuse the application for restoration. Any appeal against this decision must be lodged within six weeks of the date of this decision.

Dated this 3<sup>rd</sup> day of July 2001

M C Wright  
Assistant Director, acting for the Comptroller  
**THE PATENT OFFICE**