



**PATENTS ACT 1977**

APPLICANT                      Mr. Carl Anderson Griffith

ISSUE                              Whether patent application number  
GB 0708205.0 should be reinstated  
under Section 20A

HEARING OFFICER              Mr. G.J. Rose'Meyer

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**DECISION**

**Introduction**

- 1 Patent application GB 0708205.0 was filed on 27<sup>th</sup> April 2007 in the name of Mr. Carl Anderson Griffith, with Mr Michael Brian Dean initially representing him as his Patent Attorney in the filing of the application. However, on 25<sup>th</sup> May 2007 Mr. Dean notified the Office that he would no longer be representing Mr. Griffith on this case.
- 2 The application received a preliminary examination report under section 15A dated 1<sup>st</sup> June 2007. Amongst other things, the report notified Mr. Griffith that an abstract needed to be filed for this application by the 28<sup>th</sup> April 2008 as prescribed by section 15(10) (a) and rule 22(1).
- 3 On 5<sup>th</sup> March 2008 Mr. Griffith filed a Form 9A requesting a search on this application, but the abstract was not filed by the due date of 28<sup>th</sup> April 2008.
- 4 On 27<sup>th</sup> January 2009 the Office issued a letter to Mr. Griffith notifying him that the time for filing the abstract had passed and as such the application had been terminated and inviting him to comment on this urgently if he so wished.
- 5 On the 13<sup>th</sup> February 2009, Mr. Griffith lodged a Form 14 to request reinstatement of the application together with other documents including an abstract.
- 6 On the 9<sup>th</sup> June 2009, the Office wrote to the applicant explaining that the preliminary view of the Office was that the case for reinstatement had not been made and offering Mr. Griffith a hearing. Mr. Griffith subsequently requested a hearing and the case came before me at a hearing on the 12<sup>th</sup> October 2009.

## Evidence

- 7 During the course of the proceedings the following evidence was filed by Mr. Griffith in support of his application for reinstatement:
- a) A statement in box 4 (“What is the reason for reinstatement?”) on the Form 14 saying *“The advice I was given could have been better. I was told there were legal matters to [be] resolved, adding to the growing cost which made it seem impossible to complete in the time which I had, I’m still hoping I can fulfil a dream”*.
- b) A letter received on the 2<sup>nd</sup> April 2009 saying (in summary):
- *Given an agent had filed the application originally, I thought it had been completed in full*
  - *I didn’t know what an abstract was when the Office notified me it hadn’t been filed*
  - *I contacted another agent who said they could file the necessary abstract for a fee*
  - *Initially I was told the fee would be £1000*
  - *Some days later I was told that as the abstract was overdue, I would need to file further evidence using a solicitor and giving my reasons why I had not filed the abstract on time*
  - *I was told the cost of this would be over £3000 and that there was no guarantee of success*
  - *With the legal cost and advice, I felt I had no choice.*
- c) A letter dated 21<sup>st</sup> May 2009 saying (in summary):
- *It was not my intention to let my patent application get to this stage*
  - *The application has been one of the most difficult things I’ve ever undertaken, with many misfortunes along the way.*
  - *I am a born again Christian so I have faith that I will succeed*
  - *I have had the idea of this patent since I was 7 or 8 years of age and always dreamed it would become a reality*
  - *In 2002 after seeing a TV advertisement, I put my idea into the hands of a company called International Technology Exchange. They said they would patent my invention and help me find a company who might be interested in manufacturing it*
  - *After much time, effort and money I rang the company to find they had gone, taking with them my hopes and my money. This was a great set back to me, but I didn’t give up on my idea.*
  - *When I employed an agent I expected all the relevant documents would have been filed in full by post*
  - *If I had had a better understanding of the process and had received better advice and representation, I would never have let things get to this stage.*

- d) After the hearing, Mr. Griffith requested an opportunity to file further evidence because he felt he had come under- prepared for the hearing. I allowed the request and Mr Griffith filed a further letter received on 20<sup>th</sup> October 2009 and a number of attached documents, the pertinent content of which I summarise below, with explanatory comments where necessary:

The letter:

- *I would like to correct a point you [the Hearing Officer] made at the hearing and to show how much money I spent on my idea (not including the £595 I spent on the search fee).*
- *At the hearing you [the Hearing Officer] said an Official letter had been sent to me in April 2007 concerning the abstract. My agent Mr. Dean was acting on my behalf at this time and all letters would have gone to his address until around the end of May.*

[In fact the transcript of the hearing shows I had quoted the date of the Official letter as being 1<sup>st</sup> June 2007 and it had been addressed to Mr. Griffith at his personal address given that his agent Mr. Dean was no longer acting for him by then– see paragraphs 1 and 2 above].

- *I include the attached documents to show I had started the process of finding a way of having my idea patented*
- *The search shows toys similar to mine except for one which I believe is a copy of mine*

[This appears to be a reference to the Official Search Report under section 17 issued on 19<sup>th</sup> June 2008]

- *The patent application was filed in 2004*

[It wasn't, it was filed at the Intellectual Property Office in 2007]

- *International Technology Exchange (ITE) was an American company based in Ireland at the time, but vanished in 2004*
- *I also sent a letter to myself which pre-dates the application I sent to ITE by years*
- *If I get the chance I will prove that this idea is mine.*

The attached documents:

- A letter from ITE dated 4<sup>th</sup> July 2002 thanking Mr. Griffith for selecting them to promote his invention.
- Copies of an invention sketch, a drawing, a description, questionnaire and disclosure agreement from ITE
- A letter from ITE dated 22<sup>nd</sup> August 2002 acknowledging receipt of various documents from Mr Griffith and the payment to ITE of £5,935.00.

## The Law

- 8 The provisions for reinstatement is section 20A which states:

*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) Subject to subsection (3) below, 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*

- 9 All other requirements having been fulfilled, the essential issue to be decided in this case is whether the failure to comply with section 15 (10) (a) in not filing the abstract within the time period prescribed by rule 22(1)(b) was unintentional.

## The Arguments

### The applicant's argument

- 10 Mr Griffith's argument is essentially that it was never his intention to let his patent lapse as it had been a boyhood dream of his to patent his invention. He tried his best in difficult circumstances to prosecute the case, using professionals initially to file the application. He argues that he had assumed the agent would have filed everything that needed filing. Even after discovering that the abstract had not been filed, he took professional advice from another agent, but he feels here that he received poor advice and also the costs quoted by this second agent were so high that it left him with no option but not to be able to file the abstract on time.

### The Office's view

- 11 The Office has taken the view that Mr. Griffith's arguments do not satisfy the provisions of section 20A (2) because his failure to comply with the requirements was not unintentional. He took the decision not to file the abstract in the clear knowledge that he had to do so, but because he felt the costs were getting excessive, he chose not to file it. As this was a conscious decision, it cannot have been unintentional.

## The analysis

### *The surrounding circumstances*

- 12 The essential determination to be made under Section 20A (2) of the Act is that “the Comptroller shall reinstate the application if, and only if -.... he is satisfied that the failure to comply... was unintentional”. It is important that the meaning of this requirement is read and understood in totality.
- 13 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 by not filing the abstract on time) and then whether that failure unintentional.
- 14 It is clear from the evidence supplied that the circumstances surrounding Mr. Griffith finding himself in this position are extremely unfortunate. Mr. Griffith is a private individual who from an early age had an idea for a child’s toy product which he had held dear to his heart throughout his life. He had pursued his dream of one day making that idea into a reality.
- 15 The evidence summarised above shows quite how unfortunate he was in spending time and money on finding a firm who claimed they could patent his invention and help him find a company who might be interested in manufacturing it, only to find they disappeared, taking nearly £6,000 of his money with them without delivering any of the promised services.
- 16 However, to his credit Mr. Griffith persisted with his idea and in April 2007 he employed the services of a professional patent attorney to file this patent application, albeit as it transpired lacking the abstract required by the law.
- 17 After that, having dispensed with the services of the agent soon after filing the application, Mr. Griffith failed to comply with the statutory time periods for filing the abstract and was notified as such by the Office. Mr Griffith says he didn’t even know what an abstract was at that point, so he contacted another professional agent.
- 18 As it transpired, this new agent after initially telling Mr. Griffith they could file the abstract for him at a price of £1,000 later revised that to over £3,000. It seems this was because they discovered that the abstract was late and realised that an application to get the application reinstated would require evidence.

### *Reason for the failure to comply?*

- 19 Mr. Griffith’s evidence states that the reason he did not file the abstract was because of the poor advice he received from the second of the agents he consulted and because of the amount they said he had to pay. He felt that because of the amount of money and the warning from the agent that despite the money involved there was no guarantee of success, he was left with no choice but not to file the abstract.

20 The Office's argues that this does not satisfy the requirements of the law because Mr. Griffith took the decision not to file the abstract in the clear knowledge that he had to do so, but because he felt the costs were getting excessive, he chose not to file it. The Office suggests that it was at this point that Mr. Griffith failed to comply because he *decided* not file the abstract and this logically leads to a finding that a conscious decision had been made not to comply with the requirements of the law and as such the failure cannot be said to have been unintentional.

21 I do not fully agree with this assessment because it omits one critical factor. When was that decision reached?

*Timing of the failure to comply*

22 The evidence shows that Mr. Griffith certainly did have "the clear knowledge" that he had to file an abstract – the official notification of the date by which this had to be done (i.e. 28<sup>th</sup> April 2008) was sent to Mr. Griffith on 1<sup>st</sup> June 2007. But it is also clear to me that in spite of this he had not necessarily consciously retained that date in his mind. Mr. Griffith had no documentation to hand at the hearing and although one must surmise that he must have received the official notification of 1<sup>st</sup> June 2007 because he says he knew of the requirement to file the abstract, he certainly could not put his hands on the relevant document or even recall having received it.

23 Although that may not be a desirable state of affairs in someone hoping to fulfil a long held dream of getting his patent granted, it was the reality of Mr. Griffith's life at the time. He explained at the hearing the difficulties he was having.

24 Mr. Griffith made sincere submissions about his Christian beliefs and how his life had become very difficult with "many things that I cannot explain that happen on a daily basis in my life, things, letters going missing, letters not coming....but the way my life is, everything I do is going to be a struggle...that is the reason why everything has not been done". It is also clear from the evidence that Mr. Griffith had very little understanding of the patenting process.

25 What this appears to have led to with regard to this patent was a general awareness that something needed to be done on it and even that it had to be done by a particular time, but I can put it no higher than that.

26 I am therefore satisfied that because Mr. Griffith felt he did not have the technical knowledge to be able to file the abstract himself and that he did not know precisely by when that had to be done in any case, he delayed doing anything until it was too late. Hence when that date came and went, Mr. Griffith was unaware that it had passed. At the hearing I asked Mr. Griffith what prompted him to go to the second agent and when this was, but he didn't know. However, I have come to the conclusion that this must have been *after* the relevant date of 28<sup>th</sup> April 2008 based on the advice given to Mr. Griffith by that second agent. Ultimately this advice was that as the abstract was *late in being filed*, a reinstatement application with accompanying evidence would need to be lodged.

The cost of this may have caused Mr. Griffith to balk at doing anything at that stage, but ultimately it did not matter in terms of filing the abstract on time, because the statutory period for doing so had already passed by then.

- 27 So the conscious decision not to file the abstract was made *after* the date in which it had to be filed. And that is the crucial point.
- 28 So what were Mr. Griffith's intentions within the period when he could have filed the abstract on time?
- 29 The determining factor as I have said before is what caused the failure to comply and was this failure unintentional? What caused the failure was clearly the fact that Mr. Griffith's difficulties outlined in this decision caused him to lose sight of the legal requirement to file the abstract on time. It is very clear that Mr. Griffith had an underlying intention to achieve his life-long ambition and get his patent granted, but was not filing the abstract on time a conscious decision and therefore an intentional act?
- 30 I think on any reading of the full evidence that would be a harsh and wrong conclusion to reach. Mr. Griffith clearly did not prosecute the patent application as carefully as he should have because of a range of external factors in his life, although he tried as hard as he could. But the failure to comply in filing his abstract on time came and went quite clearly without any awareness of those events on his part. That cannot be said to have been a conscious decision on his part. As such I regard the failure as being unintentional.

### **Conclusions**

- 30 On the evidence put before me, I am satisfied that the proprietor of this patent's failure to file the abstract on time was unintentional. I am therefore satisfied that the requirements of section 20A (2) have been met and that reinstatement should be allowed and I hereby order that this application be reinstated.

**G J Rose'Meyer**

Hearing Officer acting for the Comptroller