



were not responsible for the restoration application made on this case, that having been made by the applicant Mr Marshall. Neither were they recorded as the address for service on the patent. Ms Susan Chapple of the attorneys explained that the firm shown on the official records as address for service (Tillbrook & Co) had in fact changed its name to I.P.S etc. She agreed to file the requisite form to record the change at the IPO.

- 6 Mr Bushell explained to Ms Chapple that the IPO had not received any of the four letters referred to in her letter of 3 April 2013 and that one of the days she had said she had phoned the office (29 March 2013) had in fact been Good Friday, so the office had been closed on that day. He also explained that Mr Marshall's application for restoration had been made outside the period prescribed by rule 40(1) and as that period is non-extendable under the terms of rule 108, the only option left would appear to be to seek consideration under rule 107 of the Patent Rules 2007 to show a procedural irregularity within the office to allow the period to be extended.
- 7 Further evidence and submissions were filed by the attorneys on behalf of the applicant and this is summarised below. After consideration of the evidence and submissions, the attorneys were informed that it was the preliminary view of the office that the requirements under rule 107 had not been met and as such the application to extend the deadline in which to file an application for restoration was refused. The applicant did not accept this preliminary view and requested a hearing.
- 8 The hearing took place before me by telephone on 9 April 2014. The attorneys representing the applicant were Mr Christopher J. Tillbrook, assisted by Ms Susan Chapple.

### **Summary of the evidence**

- 9 Together with the documents and events taken from the official file recorded above at paragraphs 2-6, the following evidence was considered in this decision:
  - a) An attorneys letter dated 8 May 2013 enclosing copies of all documents relating to the renewal instructions said to have been submitted to the IPO in connection with this patent for the years 2010, 2011 and 2012. These documents, which it was said had all been filed by fax and by post to the IPO at the relevant times, consisted of in all three years:
    - a covering letter from the attorneys to the IPO;
    - a Patents Form 12 (Payment of renewal fees);
    - a Form FS2 fee sheet.
    - A single Form 51 (Appointment or change of agent) was also included with these documents in order to register the attorneys' current name correctly on the official records.
  - b) The attorneys' letter of 8 May 2013 also stated that the attorneys were surprised to learn that their renewal instructions in these documents were not acted upon, as they had not received any notice from the IPO that the patent was due to expire. They asked that the documents submitted be regarded as

evidence that renewal instructions and payment was submitted, in order that reinstatement under rule 107 may be considered.

- c) An official memo of 30 May 2013 from IPO official Mr Bushell to Ms Tracey Waters of the IPO Renewals Section asking her to investigate if the the documents filed by the attorneys in relation to their attempts to renew the patent in the years 2010, 2011 and 2012 had been received in the office.
- d) The reply from Ms Waters dated 7 June 2013. This in summary said that Ms Waters had investigated the case herself and could find no record of having received any renewal request or queries regarding this patent after 2009. The memo goes on to say that:
  - the 2009 renewal had been paid by Tillbrook & Co (the previous name of I.P.S. etc) and was showing on the official database as such. She says she can find no record of any later attempts to renew.
  - The official records show that the PREN5 (the renewal reminder letter) was issued on 16 March 2010 to Chris J Tillbrook at Tillbrook & Co at their registered address in Warwick.
  - The CEA1 letter (the notification of the ceasing of the patent) was issued on 6 October 2010 to the same address.
  - Ms Waters adds that there are no records of those letters being returned to the office at any time
- e) An official letter dated 11 June 2013 in essence saying that after investigations in the office, no record of any of the forms and documents said to have been filed by the attorneys in connection with the renewal of this patent in the years 2010, 2011 and 2012 can be found. The letter said that as the office did not receive these documents, no procedural irregularity can be attributed to the IPO and as such the application under rule 107 is refused. The letter also notified the attorneys of the renewal reminder letter and the notification of the ceasing of the patent letter sent to them.
- f) An attorneys emailed letter dated 4 July 2013 saying they did not receive the renewal reminder letter or the notification of the ceasing of the patent letter the office say they sent. The letter also made the following submissions:
  - In their experience the Post Office do not routinely return letters upon non-delivery. Their renewal instruction letters were not returned to them either, therefore this cannot be relied upon as evidence of delivery or non-delivery.
  - Their experience in this case demonstrates that correspondence can go astray within the IPO after receipt.
  - Successive renewal attempts failing is unusual after successive years if renewal submissions. One reasonable inference would be IPO procedural irregularity.
  - Had the notification of the ceasing letter been received by them, they would have applied for restoration within the period prescribed by rule 40.

- Their online status checks did not reveal the case had lapsed until very recently.
  - They have had other instances of post not reaching them, so there may be contributory postal delivery factors with the UK Mail service.
  - They contend that procedural irregularity cannot be ruled out unequivocally and as such the benefit of doubt should be given to the applicant.
- g) An official letter dated 5 July 2013 which addressed the points in the attorneys 4 July 2013 emailed letter and maintained the offices position and offered a hearing on the matter.
- h) The attorneys' skeleton arguments provided on 3 April 2014 which can be summarised as :
- The attorneys do not routinely handle renewals on all cases. Where they do, they issue reminders, seek instructions and funding from clients before undertaking the renewal. Renewals are logged on a database, with back-up on local hard drives. Communication is by email, post and fax.
  - They have no record of any renewal reminders on this case; renewal receipts were neither expected nor relied upon; renewal instructions to the IPO were sent by fax and post, with authority to debit the I.P.S. deposit account; reconciliation of IPO deposit account statements is only undertaken periodically by external auditors.
  - Renewal had been successfully carried out in previous years; it transpired that had not been the case in the last three successive years and this had only latterly come to their attention; no renewal default or case lapsing communications had been received from the IPO; Ms Chapple had believed from IPO Register checks that the case had been renewed.
  - The skeleton asks some questions of the IPO: if the IPO accepts that renewal applications were sent, how is it to respond if it can find no internal records of such?; what is the IPO procedure if a renewal instruction is received, but which it cannot implement? Would the IPO respond to the sender?
  - The attorneys say they have past examples of the IPO not receiving documents or not forwarding them on correctly e.g. a recent design application [no further details supplied]; the IPO did not send recorded or registered notice of overdue renewal or of ceasing of the patent in suit; a mechanism exists to pay outstanding renewal fees and bring cases back into force e.g. a EP(UK) restored by the EPO Board of Appeal [no further details supplied].
  - The attorneys ask about the balance of probabilities on events and actions and upon whom the burden of proof falls; without proof, can the IPO be confident or certain it did not receive or act upon renewal instructions or that it sent out renewal reminders and ceasing notifications?; is an admission of failure required to justify correction of the position and if the IPO made or contributed to a demonstrable error, would there be an expectation that the IPO could and would

make a correction?; can the uncertainty of postal communication be the basis of correction?

### **The hearing**

- 10 At the hearing the attorneys' arguments centred around those in their skeleton (summarised above). I was also able to address some questions I had from my reading of the evidence.
- 11 One thing both Mr Tillbrook and I agreed on at the hearing was that the circumstances surrounding this case were extraordinary. Failure to pay renewal fees on patents is not unusual, but for the same issues to ostensibly occur in three consecutive years was extraordinary.
- 12 Essentially there are two grounds the attorneys are running. The rule 107 (Correction of irregularities) being the main ground; and issues which clearly go to rule 111 (Delays in communication services). Although Mr Tillbrook did not specifically break down his arguments under these grounds, the majority of his submissions and the evidence go to the rule 107 ground, although I shall also deal with the rule 111 ground for completeness.
- 13 Rules 107 and 111 are reproduced here:

### **Rule 107 - Correction of irregularities**

**107.**—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if –

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and

(b) it appears to the comptroller that the irregularity should be rectified.

### **Rule 111 – Delays in a communication service.**

**111.**—(1) the comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these

Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be made –

(a) after giving the parties such notice; and

(b) subject to such conditions,

as the comptroller may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

## **Analysis**

### Consideration under rule 107

- 14 To be successful under this ground, the attorneys need to convince me that there has been an ‘irregularity of procedure’ and that the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office.
- 15 The attorneys’ case here is essentially that the provision of copies of all the documents filed in support of the application in 2010 to renew the patent in suit and the IPO’s contention that the official records show no trace of these documents ever having arrived in the office, either by fax or post, shows that there were irregularities of procedure within the IPO. This evidence is adduced to convince me that I should use the provisions of rule 107 to extend the period prescribed under rule 40(1) in which to file an application to restore the patent in suit.
- 16 The IPO argues that no irregularity of procedure could have taken place within the office when it never received any of the documents allegedly filed.
- 17 The evidence on the official case file shows that the office has procedures in place for receiving faxed versions of renewal documents. The procedures are somewhat dated because comparatively few renewal documents are now received by fax, but a manual system for recording the details of faxed documents received in the office is still maintained. This involves basically recording the documents received against the relevant patent number on the given date in a ledger. On checking the ledger for the relevant date of 16 February 2010 (and subsequently for the relevant 2011 and 2012 dates too), no record of having received the said documents can be found.
- 18 The attorneys challenge whether this is sufficient proof of the non-receipt of the faxed documents, but the IPO says these are the records it keeps for fax filings of renewal documentation and after investigation, no trace of the said documents are shown to have been received in the office.
- 19 The attorneys say that they also filed postal versions of the renewal documentation. These too were not received in the IPO. The official records show the IPO has

procedures here too. If a request is made to take a fee from a deposit account, a fee sheet acknowledgement is sent detailing what amounts have been taken against each official fee-bearing form filed. At the time the documents were said to have been filed in 2010, no records exist of an attempt to pay the renewal fee on the patent in suit and records show no fees were taken from the attorneys' deposit account relating to this patent at that date. If the renewal fee had been taken from the deposit account, the account would reflect this and a certificate of renewal would have been generated and sent to the address for service held against the patent.

- 20 The evidence of the attorneys says that reconciliation of IPO deposit account statements is only undertaken periodically by external auditors, but I have no statements or evidence as to whether this was done for the 2010 renewal payment the attorneys say they made.
- 21 The IPO say that non receipt of the 2010 renewal fees for this patent triggered the next procedures on this patent. These procedures were to issue the PREN5 renewal reminder letter on 16 March 2010, followed on 6 October 2010 after no renewal fees had been received, by the CEA1 letter, which is the notification of the ceasing of the patent. The official OPTICS database recorded the ceased status of the patent as of 4 October 2010. This status is publicly viewable online.
- 22 The attorneys say they never received either of these two letters.
- 23 Mr Tillbrook argued at the hearing and in his skeleton argument that majority of the onus of proof falls on the applicant and that the office is able to rely purely on its own assertions that it followed procedure and that accordingly no irregularities occurred.
- 24 Whilst to a degree that is correct, it is not entirely right to say the office merely relies on assertion. The office has well established procedures and systems and when claims of irregularity or failings in processes or procedures are made, its officers are duty bound to investigate those claims fully. When failings are found. The office is equally bound to admit them and correct them where permissible.
- 25 In this case the office checked its internal records and systems for both the receipt of renewal documents by fax and by post and found no indications of the documents alleged to have been filed having been received in the office. This was followed by the correct and established procedural steps of issuing the renewal reminder letter and the ceasing notification letter at the right times and to the correct address as held against the patent in suit.
- 26 Mr Tillbrook argues that the office has no proof that the documents it says it sends actually do get posted correctly or ever arrive at their intended destinations.
- 27 Whilst is true to say that the office does not record if every letter or document it produces is placed correctly in the post and is delivered to its intended destination, its long established practice and default position is to trust that both these actions occur correctly, unless proven otherwise. This would seem to me to be an entirely logical and defensible position. Indeed it would be entirely impractical and unreasonable to assume otherwise. In this case the office says it addressed these letters correctly to the address for service recorded on the patent and sent them at the correct time. There is no evidence to suggest this did not happen.

- 28 The attorneys also argue that renewal of patents is not a routine or regular part of their business, but that they were responsible for the renewal of the patent in suit. It was something they successfully completed in successive years prior to 2010. They say that they do not expect or rely on communications from the IPO with regard to renewal actions. However, the fact remains that the IPO do send out various communications at different stages of the renewal process and this would have been the case in the patent in suit. Assuming the attorneys had correctly marked their diary system to alert them as to the correct time to pay the renewal fee on this patent (and I was told this was indeed the case), then if the fee is correctly paid, a fee sheet acknowledgment is sent out to the payer of the fee and this is followed by the main indicator that the patent has been renewed, the certificate of renewal.
- 29 The attorneys say they didn't expect or receive these documents for the 2010 renewal they paid, but at the hearing I checked with Mr Tillbrook and Ms Chapple whether they had received either of these documents in the 2009 renewal they had successfully effected. On checking their records at the hearing, they confirmed that the certificate of renewal in 2009 had been received by them. So while they may not have remembered to expect to receive a certificate of renewal or relied upon receiving it in 2010, its non arrival in 2010 should have been a prime indicator to them that something may have gone awry with the payment on this occasion, had they been more familiar with the renewal process.
- 30 There should have been at least one other indicator more readily familiar to the attorneys to show whether the renewal fee had been successfully paid, their own deposit account records. But the evidence shows these were not checked.
- 31 Nevertheless, I accept that the attorneys were not expecting any confirmatory documentation from the IPO, so in these circumstances it is perhaps not surprising that no renewal reminder letter or subsequent ceasing notification letter were also not missed when they did not arrive. Given the attorneys relative unfamiliarity with renewals I am willing to accept that the failure of these routine indicators to arrive at their offices did not alert them to the fact that the patent had lapsed in October 2010 due to the failure to be renewed.
- 32 Whilst I am not surprised at the above, I am inclined to be less tolerant of what followed in this case.

#### The attempted renewals in 2011 and 2012

- 33 The attorneys adduce that everything they describe as having taken place to file the renewal documents in 2010 by fax and post was replicated in 2011 and 2012. This is surprising on a number of levels, leaving aside the attorneys' arguments that all three years' failures were due to procedural irregularities at the IPO or perhaps failures in a communication service.
- 34 The patent, as I have said above, was ceased and shown as ceased on the public records, including online from 4 October 2010. I was told at the hearing and it is in the evidence that Ms Chapple made IPO Register status checks on this case, but apparently found nothing to stop her filing the renewal documents for 2011 and 2012, when the public record would have at those times clearly been showing the

ceased status of the patent. This was something which neither Mr Tillbrook nor Ms Chapple could explain at the hearing.

- 35 The evidence shows that once again the IPO has no records of any of the faxed or posted versions of the renewal documentation in 2011 and 2012 having been received in the office. It is interesting to note that in the event of an attempt to pay a renewal fee on a ceased patent, the IPO systems would show this and notify the party attempting to pay the fee. The official records show no attempts to pay the renewal fees on the patent in suit in either 2011 or 2012.
- 36 So in the circumstances described in the evidence and from my analysis thereof, the crux of the matter is was there any procedural irregularity within the office?
- 37 In my considered judgment, I have been provided with no evidence to suggest to me in the slightest that any procedural irregularity occurred in the IPO with regard to the filing of the renewal documents in 2010. It follows that when the patent in suit was correctly ceased due to the non payment of the renewal fees in 2010, the IPO were not expecting any attempts in subsequent years to renew the patent. The evidence shows that despite the attorneys' ill-informed attempts to pay the 2011 and 2012 renewal fees, these attempts never made it to the IPO in either the fax or post versions of the documents allegedly filed for reasons the evidence does not unequivocally establish. As such, I cannot find that any procedural irregularity occurred in the IPO with regard to the filing of the renewal documents in 2011 or 2012 either.
- 38 On the balance of probabilities, I find that the rule 107 ground does not succeed.

#### Consideration under rule 111

- 39 This ground was not specifically referred to in any of the written or oral submissions and although I did raise it with Mr Tillbrook at the hearing in view of the fact that some of his arguments clearly go to it, it was not argued robustly by the attorneys.
- 40 Nevertheless, for the sake of completeness, I will deal with it in so far as I find necessary in this case.
- 41 Central to the attorneys' overall case is of course the non-receipt of the renewal documentation at the IPO and there are several references throughout the evidence to the non-delivery of the renewal reminder letter and the ceasing letter to the attorneys' offices. These are issues which seemingly go to rule 111. However, other than these general repeated references and anecdotal examples of other instances of postal failures within their experience, the attorneys adduce no evidence in support of this ground.
- 42 For the case to succeed under rule 111, the comptroller must be satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.
- 43 The level of evidential burden required for the comptroller to be "satisfied", as required by rule 111 was discussed in the Patents Court in the case of *Matsushita*

*Electronics [2008]* EWHC 2071 (Pat) 2008 RPC 35, where Mr. Justice Mann gave some guidance on the matter.

- 44 The argument has never been run before me in this case as to what the attorneys regard as the whole or main reason why this patent was not renewed in 2010 or subsequently. Certainly it has not been put to me that the whole or main reason for the failure to renew the patent on time was a failure in a communication service. There may have been inferences to that effect, but inferences do not satisfy me that I should find in favour of the applicant in this case.
- 45 As such this ground also does not succeed. I find that the main reason for the failure was in all likelihood lapses in process or procedure within the attorneys' office caused by a lack of experience or familiarity with the renewals process, or by a lack of rigour in adhering to it.

### **Conclusions**

- 46 On my interpretation of the facts from the evidence before me, I do not find that there was any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office or that an irregularity or prospective irregularity was attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office.
- 47 Neither am I satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.
- 48 As such I find that I cannot extend the period prescribed by rule 40(1) for filing an application for restoration of this patent under the provisions of either rule 107 or rule 111 of the Patent Rules 2007.

### **Appeal**

- 49 Any appeal must be lodged within 28 days

**G.J. Rose'Meyer**  
Hearing Officer  
Acting for the Comptroller