

20 February 2008

PATENTS ACT 1977

APPLICANT Robert Vincent Backhouse

ISSUE Whether patent application number GB
 0305884.9 complies with section 20A

HEARING OFFICER R C Kennell

DECISION

Introduction

- 1 The application in suit relates to an angler's casting lead and was filed on 14 March 2003 with a claim to a priority of 8 August 2002. Although the applicant Mr Backhouse is not professionally assisted, the prosecution of the application proceeded normally up to the issue of a combined search and substantive examination report on 30 June 2003. In the report the examiner objected on the grounds of lack of novelty, inventive step and clarity and specified a latest date of reply of 9 August 2004. The application was published under serial no. GB 2 391 442 A on 11 February 2004.
- 2 No reply to the report had been received by the expiry on 8 February 2007 of the period prescribed by the Patents Rules 1995 (the Rules in force at that time) for putting the application in order. The Office therefore informed Mr Backhouse in a letter dated 9 May 2007 that the application had been treated as refused under section 20(1) of the Patents Act, and invited him to send any comments for urgent attention. In an e-mail on 23 July 2007 Mr Backhouse asked for advice as to how he could reinstate or renew the application. The Office wrote on 24 July 2007 advising him that he would have to apply for reinstatement of the application under 20A of the Act if he wanted to proceed with it and would have to provide evidence explaining why no reply had been made to the examiner's report by the specified date of 9 August 2004.
- 3 Mr Backhouse filed a request for reinstatement on 23 August 2007 but the Office was not satisfied that he had made out a case. A hearing has been offered but Mr Backhouse is unable to attend an oral hearing. He accepts in his letter of 20 December 2007 that a decision can be made on the basis of the papers on file.

The law

- 4 Although the amendment of the 1977 Act which introduced section 20A only entered into force on 1 January 2005, the section applies to patent applications filed before, as well as after, that date. For the purposes of the present application for reinstatement, the relevant parts are:
- (1) Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is –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) is specified by the comptroller.
- (2) Subject to subsection (3) below [*(3) is not of relevance for present purposes*], 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 rules; and
 - (c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.
- 5 At the time the application for reinstatement was made, the relevant rules were contained in the Patents Rules 1995. Reinstatement was governed by rule 36A, the relevant parts of which read:
- (1) Any request under section 20A for the reinstatement of an application shall be made before the end of the relevant period.
- (2) The relevant period shall be the first to expire of –
- (a) the period of twelve months starting on the date on which the application was terminated, or
 - (b) the period of two months starting on the date on which the removal of the cause of non-compliance occurred.
- (3) The request shall be made on Patents Form 14/77 supported by evidence of the statements made in it.
- 6 Rule 103(1) prescribed that any evidence required by the Rules should be filed by way of statutory declaration, witness statement or affidavit; a witness statement was required by rule 104A to -
- (a) be a written statement signed and dated by a person which contains the evidence which the person signing it would be allowed to give orally; and
 - (b) include a statement by the intended witness that he believes the facts in it are true.

7 The 1995 Rules have been replaced with effect from 17 December 2007 by the Patents Rules 2007, in which rules 32 and 87 respectively now prescribe the requirements for reinstatement and the form of evidence in proceedings before the comptroller. However, the differences between the old and new Rules are not of significance for present purposes.

Arguments and analysis

8 Having regard to the above statutory requirements, the questions which arise for determination are (i) whether Mr Backhouse has filed his request for reinstatement in time, and (ii) whether on the balance of probabilities he has made out a case that his failure to reply to the examiner's report by the specified date was unintentional.

Was the request for reinstatement filed in time?

9 The period prescribed by rule 36A(2)(a) expired on 8 February 2008, 12 months after the date on which the application was treated as refused.

10 In regard to rule 36A(2)(b), the Office says in its letter of 7 December 2007 that it is not possible to determine the date of removal of the cause of non-compliance. However it seems to me that there are two possible candidates for this date:

- either the date when Mr Backhouse received the Office's letter of 9 May 2007, notifying him that that his application had been terminated because he had not filed a reply to the examiner's report and inviting him to file any comments as a matter of urgency,
- or the date when he received the Office's reply of 24 July 2007 to his e-mail the previous day, advising him why the application had been treated as refused and what he needed to do to reinstate it.

11 In my view, the first letter would have alerted Mr Backhouse that something had gone wrong because of an apparent failure on his part. However, although he left it for over two months before replying and seeking advice, I do not think that he could reasonably be expected to have taken action until he knew what options were open to him and what exactly he needed to do in order to proceed with the application. I therefore think the later of the two dates above is the date of removal of the cause of non-compliance. The period prescribed by rule 36A(2)(b) therefore expired at the latest two months from 28 July 2007, that being the date when Mr Backhouse e-mailed confirming receipt of the letter and seeking further advice from the Office. This expiry date is earlier than the expiry date of the rule 36A(2)(a) period and was therefore the latest date for requesting reinstatement.

12 I therefore consider the application to have been filed within the time limit prescribed by rule 36A(1).

Was the failure to reply unintentional?

13

In his e-mail of 28 July 2007, Mr Backhouse said that he did not recall receiving the examiner's report, thought he would have responded if he had received it, and did not enquire further because he thought he had done enough and the initial application was sufficient to protect him.

- 14 In line with this, Mr Backhouse states on Form 14/77 in his reinstatement application that the examiner's report "was never received or returned". In a document signed by him and dated 20 August 2007, he states:

"1. The above patent was filed on 14 March 2003.

2. I understand that the Examiner's Combined Search and Examination Report was issued on 30/06/03 but for some unknown reason I never received it. I was unaware of it until I received your letter of 9 May 2007 wherein you advised me that my patent application was treated as having been refused.

3. I confirm that it was always my intention that the application should proceed to become a granted patent.

4. I believe that the information contained in this statement is true to the best of my knowledge and belief."

- 15 However, as the Office pointed out, Mr Backhouse did in fact appear to have received the report. In an e-mailed request on 13 January 2004 for advice in response to the Office's standard letter advising of the impending publication of the patent application, he had stated:

"However your letter of 30 June 2003 gives me opportunity to file amendments with a latest date for reply of 9 August 2004. I am in the process of preparing amendments. I thought I had until 9 August 2004 to file such amendments."

- 16 In subsequent correspondence with the Office, Mr Backhouse offered further explanation. In a letter dated 6 November 2007 he said that he had intended amendments which he later rejected; that he did not now have "the original form" and thought he must have sent it back but that the Office did not receive it; and that an unspecific psychiatric condition from which he suffered could have been a possible reason for failure to reply.

- 17 Having been reminded by the Office in a letter dated 17 November 2007 that no form was in fact needed to reply to the examiner's report and that a letter or retyped pages needed to be filed, Mr Backhouse said in his letter of 28 November 2007 that he was using the term "form" to mean the actual examination report which he no longer had in his possession – but that he had "a vague memory" of returning it with a declaration that he had dismissed his own previously intended amendments. He did not recall any objections to which he responded. However, on being subsequently sent a copy of the report, he replied on 20 December 2007 to say that he did after all recall making a response.

- 18 In this letter he now suggested that he did return "the examination report". He thought it might have gone astray because, having lived near to Newport Road, Cardiff from 1964 until 1990 he probably addressed the envelope there instead of

to the correct address, ie Newport Road, Cardiff.

Analysis of the above arguments

- 19 In its letter of 7 December 2007 setting out the facts and arguments in preparation for a hearing the Office suggested that the application for reinstatement had not been accompanied by formal evidence. However, it seems to me that the applicant's statement, although brief, does in fact comply with the formal requirements of the above rules for a witness statement.
- 20 However, I do not think the statement assists Mr Backhouse. In particular, the statement in paragraph 2 is totally at variance with his e-mail of 13 January 2004 in which he acknowledges receipt of the report and his intention to file amendments. In his letter of 6 November 2007, Mr Backhouse acknowledges that he sent that e-mail.
- 21 In paragraph 3 of his statement Mr Backhouse says that he always intended to prosecute the patent application to grant. However, as explained in paragraph 20A.13 of the Office's "Manual of Patent Practice"¹, it does not necessarily follow that, because there was a continuing underlying intention to proceed with the patent application, the failure to reply to the report was unintentional. Within the context of an overall intention to keep the application alive, it is perfectly possible intentionally but mistakenly not to file a document because of a misunderstanding as to what action was necessary at that point: the mistake does not make the failure to file unintentional. Therefore without further evidence of the applicant's intentions in the specific matter of replying to the report, the statement in paragraph 3 carries no evidential weight.
- 22 I accept that Mr Backhouse may not be entirely familiar with patent procedure and is trying to recall events from over three years ago. Nevertheless, I am afraid that I find his attempts to explain why - having e-mailed the Office in January 2004 to say that he had received the report, was aware of the due date for reply and was preparing amendments - he did not actually file a response by August 2004 to be neither consistent nor convincing. I find it difficult to reconcile the differing explanations of what he actually did by way of amending the application, or to conceive why, following the Office's letter of 17 November 2007, he thought he should need to return the examination report in order to make a reply. It does not help that Mr Backhouse is apparently unable to produce copies of the reply that he alleges he made.
- 23 Further, given that Mr Backhouse seems to have experienced no general difficulty in corresponding with the Office, I find it surprising that a medical problem or an error in addressing the envelope should have intervened on one occasion only. In the absence of any evidence that either of these factors were actually responsible for the specific failure in question, I take no account of Mr Backhouse's suggestion that they might have caused it.
- 24 It therefore seems to me that on the balance of probabilities Mr Backhouse was

¹ <http://www.ipo.gov.uk/practice-sec-020a.pdf>

aware on 13 January 2004 that a reply needed to be filed by 9 August 2004 and was indeed preparing one, but for some reason decided not to bother. If I am wrong and the failure to reply was an unintentional oversight despite the absence of any convincing evidence to the contrary, then I find it surprising that Mr Backhouse did not at any point recall the matter until notified by the Office three years later - particularly if he had continued to work on development of the invention as his e-mail of 23 July 2007 indicates.

25 Mr Backhouse said in his letter of 6 November 2007 that he had, after many years effort, recently had an optimistic appraisal of his idea from Durham University School of Aeronautical Engineering. The Office has inferred from this that Mr Backhouse had changed his mind with regard to obtaining patent protection. Without knowing when he received that appraisal, I draw no such inference - although I accept that such a change of mind would militate against the earlier failure being unintentional.

26 I do not therefore consider a case to have been made out that the failure to reply to the examiner's report by the specified last date was unintentional.

Conclusion

27 It follows that the request for reinstatement does not comply with the requirements of section 20A(2). I therefore decline to reinstate the application.

Appeal

28 Mr Backhouse has a right of appeal from my decision to the Patents Court. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any such appeal must be lodged within 28 days.

R C KENNEL

Deputy Director acting for the Comptroller