

UGO

PATENTS ACT 1977

Miss Durow
3Y60

IN THE MATTER OF an application
by Roland Graham Whiteing for the
restoration of European Patent (UK)
No 0280685

0/15/195

DECISION

The renewal fee due on 22 December 1992 in respect of the seventh year of this patent was not paid by that date, nor was it paid during the six months immediately following as allowed by section 25(4). The application for restoration was filed on 22 July 1994, the last day permitted under rule 41(1) of The Patents Rules 1990.

The Office expressed the view that the proprietor, Mr Whiteing, had not taken reasonable care to see that the renewal fee was paid, as required by section 28(3), and as a result the matter came before me at a hearing on 3 November 1995. Mr Carmichael of G F Redfern & Co, chartered patent agents, represented the applicant, and he was accompanied by Mr Whiteing himself. Mr Sim attended on behalf of the Office.

The evidence filed in support of the application consists of two statutory declarations by Mr Whiteing, one by Mr Carmichael and an affidavit from an agent who practices in South Africa, Mr Galgut. When the patent application was filed, Mr Whiteing was living in South Africa and Mr Galgut was his local patent agent. Mr Galgut was responsible for instructing foreign associates in respect of the filing and prosecution of various patent applications and the payment of renewal fees. G F Redfern were the foreign associates used for the present patent.

Mr Whiteing returned to live in the UK before the patent had been granted. He left his financial affairs in South Africa in the hands of a lawyer, Mr Fanaroff, depositing with him (or his firm) "a considerable sum of money, to deal with various matters including the payment of renewal fees on my patents". Mr Galgut says he received all his instructions from Mr Fanaroff and accounted to him for his services.

It would appear that as early as July 1990 Mr Galgut was, in fact, having difficulty getting instructions and money from Mr Fanaroff. In either 1991 or 1992 - the evidence is inconsistent as to which - Mr Whiteing learned, as a result of dealings on a completely different matter, that Mr Fanaroff was acting in "a somewhat unsatisfactory manner". He therefore told Mr Galgut to seek renewal instructions from a firm of accountants in South Africa, Beinash Klompas & Co. He says he did not provide Beinash with any monies to pay renewal fees because he was under the impression they would be able to get them from Mr Fanaroff. He also says he initiated a Court action against Mr Fanaroff's firm, resulting in an out-of-court settlement which was supposed to release funds for payment, *inter alia*, of renewal fees.

Mr Galgut continued to seek instructions and money, initially writing on "numerous occasions" to Mr Fanaroff and later writing to Beinash. It is not entirely clear why he continued trying Mr Fanaroff rather than Beinash, though it made little difference to the end result because neither of them provided him with instructions or money. By the time the present renewal was due, Mr Galgut was already owed a large amount of money for previous disbursements in connection with the various patent applications. Accordingly, because he could not get instructions himself, he did not instruct G F Redfern & Co to renew the present patent, even though they sent him renewal reminders. Mr Whiteing remained unaware that the renewal fee had not been paid until he happened to contact Mr Carmichael on an unrelated matter.

The evidence leaves a lot of questions unanswered. For example, it is not clear why neither Mr Fanaroff nor Beinash provided instructions and money to Mr Galgut, nor do we have any details of the out-of-court settlement. Mr Whiteing has been given ample opportunity to provide fuller evidence, but none has been forthcoming. However, it is quite likely that fuller evidence would not, in the end, have made any difference.

Section 28(3) requires me to determine whether the proprietor took reasonable care to see that the renewal fee was paid. On the assumption that Mr Whiteing was the proprietor throughout - and I will return to this point - it is therefore on Mr Whiteing's actions that I must concentrate. As will be clear from the above account, Mr Whiteing adopted a hands-off approach to the protection of his intellectual property. He simply put everything into the hands of Mr Fanaroff. He appears to have done nothing to monitor

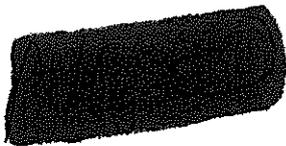
what Mr Fanaroff did. Further, he provided no specific instructions about payment of individual renewal fees, but simply assumed Mr Fanaroff understood that the patent was to be kept in force. Only when he became aware - almost by accident - that something was wrong did he intervene. However, having told Mr Galgut to try Beinash instead, he thereafter appears to have made no attempt to check whether this revised arrangement was actually working.

Mr Whiteing acknowledged at the hearing that this particular invention is very important to him commercially and that he has spent £1.75 million on the project. If this is so, it is very difficult to understand why he did so little to look after his patent rights. Whatever the reason, what little he did do falls short - I would go so far as to say a long way short - of taking reasonable care as required by section 28(3).

I have assumed it is correct to treat Mr Whiteing as the proprietor, and Mr Carmichael agreed with this at the hearing. However, Mr Carmichael did mention at the hearing that Mr Fanaroff had power of attorney. There was no sworn evidence to this effect, so I do not know whether the power was so extensive that it effectively put Mr Fanaroff into Mr Whiteing's shoes so far as section 28(3) is concerned. However, even if it did, I would still find that reasonable care had not been demonstrated because I have been given no evidence to suggest that Mr Fanaroff did anything at all.

Accordingly, I refuse the application for restoration.

Dated this 14 day of November 1995



P HAYWARD
Principal Examiner, acting for the Comptroller



THE PATENT OFFICE

