

Who cares, wins...

Restoring lost IP rights

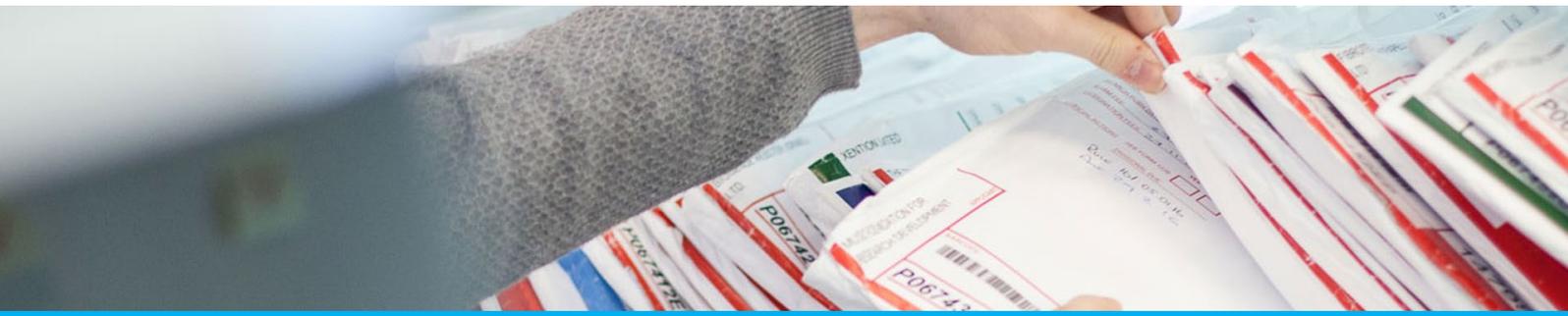
The last post in this series on rescuing lapsed registered IP rights, [Crikey! The PCT filing deadline has passed inadvertently: how to still save your priority date](#) dealt in a large part with various restoration-related patent rules and how to navigate them and use them to your advantage. This post is different, a moment of light relief perhaps.

Patent Restoration and Desert Islands

The other morning I was listening to the BBC's Desert Island Discs, a radio show where guests have to choose eight pieces of music to keep them going whilst cast away on a desert island – the guest, Thomas Keneally, author of the novel Schindler's Ark (which was made into the powerful film Schindler's List) was talking about one of his musical choices, "Fairytale of New York" sung by Shane McGowan and Kirsty McColl, which one can't escape from during Christmas. He described the song as an "encyclopaedia of love, alienation, insult and regret". My immediate reaction when I heard the words "love, alienation, insult and regret" in one sentence was that that's a perfect description of trying to restore a lapsed patent.

Here's why. **Love:** quite often when putting together an agreement to support a restoration request you end up having to deal with an experienced, dedicated employee who is proud of (and maybe even loves) their work, yet on this one occasion has made a small mistake such as docketing an incorrect date with disastrous consequences. **Alienation:** having made this kind of error can sometimes have the effect of the person losing confidence in themselves, and also develop the feeling that their colleagues no longer see them as responsible. **Insult:** The person feels that their integrity and competence is being questioned and that maybe their job is on the line, and on top of that they have to answer a list of probing questions. **Regret:** twenty-twenty hindsight whilst ridiculous is still a pain, "If only I had done what I've done a million times before and just ticked that box, docketed that date, etc."

The first time I was ever involved in trying to restore a patent which had lapsed unintentionally, I thought the whole thing would be pretty straightforward and wouldn't cost much. I was obviously completely mistaken on both counts. The European patent in question



had lapsed in the UK, Germany, France and the Netherlands due to a missed annuity. The UK restoration was by far the simplest, since the UKIPO just needs to be convinced that the lapse was unintentional. The patent offices in the other territories however had to be persuaded that the lapse occurred in spite of *all due care* having been exercised by the patent proprietor, its representative, etc.

Building a picture of due care

So how do you go about proving that due care was exercised in a situation where something definitely went wrong, and also went wrong so fundamentally that a valuable patent was allowed to lapse by mistake? The answer is that you have to make a very persuasive case to the patent office that the relevant party, whether it was the patent proprietor or their representative, had a top-notch records management system in place, with regular reminders, etc., and that the patent lapsed due to some other totally unanticipated factor, against which the best records system in the world would have been helpless.

The person from whom you need the most information in order to find out how the system works and what went wrong on this occasion is most often the person who really doesn't want to speak to you at all – the actual member of staff who made the error which resulted in the lapse. They're embarrassed and angry at themselves enough already without having to be dragged through all this again, in most cases by someone they don't even know, and generally quite some time, maybe even a year, after the mistake was made. Getting such a person to open up can be quite difficult, but there are approaches which can be taken.

First, make it clear that this isn't about blame – the purpose of the restoration exercise is to put together a persuasive bundle of information and prepare robust arguments to rescue the lapsed patent, not to point the finger at any one individual. As anybody with experience of the patent world knows very well, it is all too easy for a person to make a mistake, for example, by incorrectly docketing an important date. That is

why all good records systems contain in-built double (or even triple) checks.

Second, try to make the person feel relaxed. Understand that they are not necessarily in a positive place when they are speaking to you about this disaster that has befallen them and their organisation.

Mem'ries, light the corner of... Outlook

The person has opened up. They really want to help out, pitch in, bend over backwards to give you whatever information you need. Great! They provide you with lots of facts as to how their records system works, who in their team has responsibility for what, information-packed screenshots and tables showing that they have the best system in the world.

But then you ask what is arguably the most important question of all: "So what went wrong this time, to make the system ineffective and basically useless from the point of view of paying the annuity (or whatever other act it was that was inadvertently missed) for this particular patent?" You might expect a fairly precise explanation as how and when the error occurred. But this is hardly ever the case. The most common response is a taciturn "I have no idea". I have found that a good place to start is to check Microsoft Outlook activity and calendar activity during the day/period in question. This simple investigation can provide information such as: the person was in the office until mid-morning on the day in question, then suddenly left. This may jog the person's memory, and they recall that they were taken ill that morning, or they received an urgent telephone call relating to a family member. Speaking to other members of the person's team can also provide snippets of information which end up acting as *aides memoire* for the person. Also as touched on earlier, these discussions need to take place over the telephone (asking questions via email correspondence does not jog people's memories in the same way, in my experience). It is however, amazing what people can and do remember once you have put them in the right mental space.



A sudden unavoidable external event which could not be anticipated is generally the most powerful ammunition you can obtain – such unexpected events which I have come across have included personal injury due to accidents, and being rushed to hospital to give birth prematurely, to name a couple – although a less obviously disruptive event can still provide a good basis for a request, if argued intelligently and persuasively. Don't forget though, that even when there was such disruption, it must still be shown that there was a good records systems in place.

A good restoration argument and the meaning of life

It seems to me that being able to put together a useful bundle of evidence is made possible by dealing with all four parts of Thomas Keneally's encyclopaedia.

The first, **love** (a.k.a. all due care) – this must always be present, via a persuasive argument supported by detailed robust facts.

The second, **alienation** – restoration as a process exists for the same reason that pencils have erasers at the end; with the best will in the world, humans can still make mistakes.

The third, **insult** – once the person is reminded and reassured that they are a competent member of staff, whose expertise and dedication is valued, they willingly assist.

The fourth, **regret** – this is always a waste of time, so don't allow people to go down this negative alley. What's done is done – let's fix it. That's the only approach that works.

It is important to realise that at the end of the day restoring lost rights is in many ways about people, with all their foibles as well as amazing qualities.

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