BL O/012/82

PATENTS ACT 1977

IN THE MATTER OF an application
for Patent No 7904473 by
The Penwalt Corporation

DECISION

The application was filed on 8 February 1979 and contains a declaration of priority in respect of USA application No 890, 358 dated 27 March 1978.

The application relates to the preparation of flame retarded polyurethane foams, and the claims are directed to a process for the manufacture of a flame-retarded polyurethane foam using, as a flame-retardant, a compound which falls within specified general formulae, and to the flame retarded polyurethane foam prepared by such a process. On 20 July 1981 the applicants filed a Form 11/77 requesting the addition of further claims 13 to 17 to the application. These claims are directed to certain of the compounds which fall within the scope of one of the general formulae in the main process claim. In an Official letter to the applicant dated 18 August 1981 the examiner reported that the addition of the further claims 13 to 17 was not allowable, as the proposed claims would constitute a second invention and therefore contravene section 14(5)(d) of the Act. This letter stated that under the terms of Section 18(3) of the Act the applicant was given 4 months in which to submit observations and/or amendments. In response the applicant, in a letter dated 24 August 1981, requested the Comptroller's permission to file a divisional application under section 15(4) based on the further claims. The examiner replied in a letter dated 12 October 1981

that since the application had been placed in order for grant, the Office was unable to accede to the request and a hearing was offered.

The matter came before me on 1February 1982. Mr H R Lambert of Messrs D Young and Co appeared as Agent for the applicants.

Mr Lambert explained that the reason for his request to file a divisional application was because he had filed a second application, No 8101361 on 16 January 1981, by the same applicant, which claimed priority from a later USA application and that this second application contained claims to compounds per se which are disclosed but not claimed in the present application. He accepted that the second application cannot be allowed proceed in view of the disclosure in the present application. For this reason the second application had been withdrawn by the applicants on 20 July 1981 ie at the same time as they had applied to include claims to the compounds per se in the present application.

Mr Lambert agreed with the plurality of invention objection raised by the Examiner, but felt that he was entitled to file a divisional application containing the claims to the compounds per se. In this connection he referred me to section 15(4) and Rule 24. This Rule states:-

> 24. -(1) A new application which includes a request that it shall be treated as having as its date of filing the date of filing of an earlier application for a patent may be filed in accordance with section 15(4) -
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> (a) in a case where the new application is filed after the earlier application has been amended in pursuance of

section 18(3) so as to comply with the requirements of section 14(5)(d), within two months of such amendment; and

(b) in a case which does not fall within paragraph (a) above, at any time after filing of the earlier application, provided that where the new application is filed after the first report of the examiner under section 18 has been sent to the applicant -

(i) if the report is made under section 18(3), the new application shall be filled before the end of the period specified for reply to that report, unless the comptroller agrees otherwise; and

(ii) if the report is made under section 18(4), the new application shall be filed within two months of that report being sent to the applicant;

and in any event, any new application shall be made before the earlier application has been refused, withdrawn, or taken to be withdrawn and before the expiration of the period prescribed for the purposes of section 20(1).

Mr Lambert submitted that his application to amend by the addition of claims after the case had been reported in order for grant under section 18(4) effectively re-opened the case, since it would no longer be in order for grant, due to the objection to plurality of invention, and that the application was therefore now governed by the provisions of section 18(3). He then submitted that the case fell within Rule 24(1)(b)(1)

and that since the Official letter of 18 August 1981 was a report made under Section 18(3) he therefore had up to 4 months from the date of that letter in which to file a divisional application. He submitted that since he was thus within the time limit for filing a divisional application he did not need the comptroller's permission to file.

I accept Mr Lambert's submission that the allowability of the filing of the divisional is governed by Rule 24(1)(b)(i). However, it seems to me that it is not a question of re-opening the present case, thereby bringing it back under section 18(3), but of filing a new application based on an unallowable application to amend. I therefore think that the Office erroneously issued the letter of 18 August 1981 as a report under Section 18(3) but, even if this were not the case, in my view the wording of Rule 24(1)(b)(i) is such that "the report" referred to in line 1 of sub-paragraph (b)(i) must be the "first report" referred to in line 3 of sub-paragraph (b) of the Rule since the word "the" in line 1 of sub-paragraph (b)(i) has no other antecedent. The relevant report in respect of the present application is therefore that made under Section 18(3) and dated 5 September 1980 and not the later report of 18 August 1981. The time within which a divisional application could be filed at the applicants' own volition and without the Comptroller's agreement thus expired on 5 March 1981.

The question which arises, therefore, is whether it would be proper in this case to exercise discretion and allow the late filing of the proposed divisional application. Now it seems to me that there was ample time to file a divisional application in the period between 5 September 1980 and 5 March 1981 instead of, as happened, a second substantive application, 8101361 filed on 16 January 1981, which subsequently had to be withdrawn.

In fact, during that period, on 3 November 1980, the present application was notified, in a report made under Section 18(4), being in order for grant and it was not until July 1981, some 8 months later, that Form 11/77 requesting amendments was filed which gave rise to the present dispute. In view of this length of time and when the matter could, not unreasonably, have been satisfactorily resolved at a much earlier stage I do not think it would be proper for me to exercise discretion and agree to the late filing of a divisional application and accordingly I refuse to do so. I am fortified in this view by the fact that had the examiner's first report been made under Section 18(4) the case would have fallen within Rule 24(1)(b)(ii) which does not give the same discretion as does Rule 24(1)(b)(i) and restricts the period for filing a divisional application to 2 months from the date of the report.

Mr Lambert also made an alternative proposal. He suggested that he could limit the flame-retardant compounds used in the main process claim of the present application to the same compounds which he wishes to claim per se and which are the subject of the disputed claims 13 to 17. At the same time he suggested that he could file a divisional in respect of the other flame-retardant compounds disclosed in the present case and a process for the manufacture of flame-retarded polyurethane foam using the said other compounds as flame retardants. The proposed amendments to the present application would be allowable but, in my view, the same considerations would apply as regards the filing of this divisional application as to the one considered above, and the same conclusion would apply.

Dated this 3rd day of March 1982

A F C MILLER
Superintending Examiner, acting for the Comptroller