

PATENTS ACT 1977

IN THE MATTER OF an application
for Letters Patent No 8016472 by
The Secretary of State for Defence

DECISION

This application was filed on 19 May 1980 claiming the priority date of an application filed on 23 May 1979. Accordingly under Section 20(1) and Rule 34 of the Patents Act 1977 the application would normally be required to comply with all the requirements of the Act by 23 November 1983 if it were not to be refused.

On substantive examination, as a result of various objections, the application underwent amendments after the latest of which, received on 8 September 1983, the Examiner considered, having regard to the documents available to him at that time, that the application was in order for grant.

Before this fact could be communicated to the applicant observations under Section 21 of the Patents Act 1977 were received on 5 October 1983. In accordance with Section 21(1) of the Patents Act the Examiner considered these observations and a further objection under Section 18(3) was raised that, in the light of the prior art disclosed in documents cited in those observations, claim 1 was not novel and the remaining claims were not inventive. The objection was embodied in an Official letter dated 31 October 1983 and, in view of the proximity of the end of the Section 20 period, ie on 23 November, a period of 2 weeks was specified for the applicant to make observations on the report and to amend the application.

On receipt of the letter embodying the objections the Agent Mr Beckham telephoned the Examiner and objected that the period set for reply was unreasonable, saying that a period of 2 months would be required. However the Examiner pointed out that the period set was constrained by Rule 34 and that on his understanding the only permissible extension in the period prescribed by Rule 34 was that available under Rule 110 and that was limited by sub-rule 110(3) to a period of 1 month on filing of

Form 50/77 and payment of the prescribed fee. Mr Beckham considered that this situation was unfair to the applicant and at his request the matter came before me at a hearing on 8 December 1983, at which Mr Beckham appeared as Agent for the applicant.

Mr Beckham first referred to the extension of time limits allowed by Rule 110 which, in sub-rule (1) gives the Comptroller discretion to extend time limits if he think fit, and upon giving proper notice to anybody whose interests might be affected by any such extension. He pointed out that there is a limitation so far as sub-rule (1) is concerned in that the discretion does not extend to the times or periods prescribed in the Rules specified in sub-rule (2) and is subject to sub-rule (3) which states that the period prescribed in Rule 34, amongst others, may be extended for not more than one month upon filing Form No 50/77. Mr Beckham urged on me the possibility that whilst the applicant is entitled under this rule to a one month's extension on Filing Form 50/77, the Comptroller's discretion might nevertheless be exercised to allow extensions of any period as he thinks fit. Mr Beckham also referred to the decision of Mr Justice Falconer in the matter of Application No 8004040 by Morgan-Ward Critchley (not yet reported) which relates to the possibility of extension of a period prescribed by Rule 33(2), which is one of the other Rules referred to in sub-rule (3) of Rule 110. This decision seems to confirm the interpretation that those periods prescribed by Rules referred to in Rule 110(3) are only extensible by one month, however Mr Beckham sought to distinguish his application on the ground that in the Morgan-Ward Critchley application the applicants were clearly at fault, whereas in the present application the Applicants had been placed in their present position by a third party filing Section 21 observations late in the period prescribed by Section 20 for getting the application in order for grant. However the point has been argued again in an appeal before Mr Justice Whitford in the matter of Application No 8040051 by Decoflex Ltd (not yet reported). In this case the Superintending Examiner had said in his decision that, if he had a discretion, he would have exercised it in the applicants favour. However on appeal Mr Justice Whitford in his decision says, in respect of the interpretation of Rule 110:-

'It is, to my mind, a straight question of construction of the Rule, and it admits of only one answer. The general discretion given under sub-rule (1) is fettered by an absolute restriction so far as the rules referred to in sub-rule (2) are concerned, and it is

subject to a limited restriction so far as the Rules referred to in sub-rule (3) are concerned, the discretion of the Comptroller to extend time is limited to a period of one month.'

In the light of these decisions it does not appear to me that under Rule 110 it is open to the Comptroller to extend the period prescribed by Rule 34 for other than one month on filing of Form 50/77.

Mr Beckham also referred to Rule 100 and mentioned the lapse of time between the Office receiving the observations by the third party under Section 21 on 5 October 1983 and the observations being passed on to him by a letter dated 31 October 1983, although he said that he did not wish to press this issue at this time since he was more concerned with a general principle in relation to late filing of Section 21 observations than in the particular circumstances of this application.

Rule 100 does appear to allow the Comptroller some discretion on extension of times or periods where an irregularity in procedure before the Patent Office is attributable wholly or in part to an error, default or omission on the part of the Patent Office.

Taking into account the volume of correspondence to be dealt with by the Office, the difficulty of ascertaining the urgency of the letter containing the Section 21 observations, and the time required for the Examiner to consider the observations and issue a report, there does not appear to have been any specific error default or omission on the part of the Office in failing to pass on the observations, such as would allow the Comptroller to exercise discretion and grant an extension of time under Rule 100.

Mr Beckham also referred me to Rule 101 which provides the Comptroller with powers to dispense with the requirement for a person to do any act or thing or produce or file any document or evidence if it is shown to the satisfaction of the Comptroller that that person is from any reasonable cause unable to do that act or thing or that that document or evidence cannot be produced or filed. In the present application Mr Beckham maintained that the two weeks originally allowed was too short to enable the Agent to respond to the objection and that therefore the Comptroller should dispense with the requirement that amendment should be effected so quickly.

In considering this request I have doubts that Rule 101 should be applied to what is effectively an extension of time for filing amendments. It appears to me that Rule 100 specifically prohibits extension of time or

periods except where provided for by Rule 110 or where there was an error, default or omission on the part of the Office. To then interpret Rule 101 to provide further exceptions to the prohibition would be inconsistent with Rule 100 and contravene the provisions of Rule 110. I consider that I am supported in this view by part of Lord Diplock's judgement in E's Applications 1983 RPC at page 250 which seems particularly relevant. In that case Lord Diplock was considering the interpretation of Rule 100, in the form in which it existed before amendment in 1980 where it did not contain the clause expressly referring to time limits. In that Judgement Lord Diplock rejected the possibility that rule 100 should be used to permit an extension of time which would otherwise be prohibited by rule 110 saying

'So to construe rule 100 in relation to rule 110 would be to turn on its head the well established canon of construction generalia specialibus non derogant'.

From similar reasoning I would conclude that Rule 101 may not be used to render the express provisions of Rules 100 and 110 nugatory.

Mr Beckham also referred to the European Patent Convention and in particular article 121 which provides for effective extension of the time for reply set by the European Patent Office, seemingly by two months on payment of a fee. He also referred to Section 130(7) of the Patents Act 1977 which sets out sections of the Act which are framed so as to have, as nearly as practicable, the same effects in the UK as the corresponding provisions of the European Patent Convention - etc. However as conceded by Mr Beckham, neither Section 18 nor Section 20 is referred to in Section 130(7) and so presumably were not intended to have the same effect as corresponding provisions of the EPC. Section 130(7) therefore seems irrelevant to the issues in question in this application.

A further point raised at the hearing was in connection with Rule 37(2), which states:-

If the applicant has not already been notified under Section 18(4) that the application complies with the requirements of the Act and these Rules, the observations shall be referred to the examiner conducting a substantive examination of the application under Section 18, who shall consider and comment upon them as he thinks fit in his report under that section.

Mr Beckham suggested that the wording of this Rule implies some discretion on the part of the examiner to ignore the observations should he think fit, or possibly to extend the period for putting the application in order and that some such action would be appropriate at a late stage in the examination proceedings.

My own view is that once the observations are referred to the examiner, as they are required to be under this rule unless compliance with the Act and Rules has been notified to the applicant, then the examiner is required to consider them, and if they indicate a need for further action under Section 18(3) he cannot then ignore them, no matter how late in the period specified by Section 20 for putting the application in order. In addition, to extend the period for putting the application in order would clearly be in direct contravention of Rule 100 and so not allowable.

In the result I find that there is no justification in the circumstances of this application which admits the possibility of extending the period prescribed by Rule 34 of the Patents Rules 1982 other than as allowed by Rule 110(3).

This being a procedural matter, in accordance with the Rules of the Supreme Court Order 104, Rule 14(2)(a) any appeal must be lodged within 14 days of the date of this decision.

Dated this

19th

day of December 1983

N L Sands.

N L SANDS

Principal Examiner, acting for the Comptroller

THE PATENT OFFICE