

PATENTS ACT 1977

Miss Durow
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IN THE MATTER OF

Application No. 9119132.0 in the name of
George Wallace McDonald

STATEMENT OF REASONS FOR DECISION

This application was filed on 6 September 1991 in the name of George Wallace McDonald. It was published on 10 March 1993, and examination was requested on 20 September 1993. The first examination report under Section 18(3) was issued on 17 October 1994, setting 6 months as the period for response, and objecting *inter alia* to lack of unity of invention and lack of inventive step. As no response had been received by 20 December 1995, a warning letter was issued on that date reminding the applicant that no response had been received, and that the normal period for putting the case in order would expire on 6 March 1996, but that this period could be extended by one month by filing Form 52/77 with the requisite fee.

Mr McDonald's Agent, Mr Michael Dean contacted the Office by phone on 29 March and 1 April and, also on 1 April 1996, filed by fax Form 52/77, and a response to the Section 18(3) report with a covering letter requesting allowance of the late response. Mr Dean gave as the reasons for the late response that the search carried out by the Office was limited and so the applicant had been awaiting the results of searches and examinations in other countries. Also, he added that the applicant had been travelling abroad and he (Mr Dean) had been absent because of illness. The examiner took the view that the reasons given were not adequate to warrant the exercise of the Comptroller's discretion, and communicated this view to the Agent by telephone on 1 April confirmed by mail and by fax on 2 April, informing the applicant that he had the right to be heard on the matter. Mr Dean responded by requesting a hearing, which was appointed for 3 April 1996. Mr Dean appeared on behalf of the applicant, and the examiner Mr Blunt attended together with Mr Waller on behalf of the Office.

At the hearing I issued an oral decision confirming the examiner's view and stated that I would issue written reasons for my decision. This I now do.

Mr Dean explained that he was relatively inexperienced in dealing with substantive examinations before the Patent Office, and accepted that through his lack of experience he was at fault in failing to ensure that a response was made in time. He had overlooked or not appreciated the significance of the 6 month deadline for responding to the Section 18(3) report. As a result, no attempt was made to make a response within the specified period. On the contrary, according to Mr Dean, the applicant had suggested that they should delay responding to the UK examiner's report until they had obtained various search and examination reports from parallel applications abroad. As these reports came in, decisions were taken to await further reports because it was felt that with the benefit of these a better response could be made to the objections raised in the Section 18(3) report. Mr Dean explained that because of this the need to respond had slipped his mind.

With regard to the warning letter of 20 December 1995, Mr Dean stated that he was still unaware that he had missed the deadline because the letter did not make specific reference to that fact. The letter is a standard letter which issues on all cases on which a response is overdue, as they approach the end of the normal Rule 34 period. The letter reminds the applicant that a response is outstanding giving the date of the Section 18(3) report, and states that the Office intends to treat the application as refused on the final date for putting the case in order, *ie* the end of the Rule 34 period. It adds that the period can be extended by one month by filing a Form 52/77 with the requisite fee, and advises the applicant that any comments that he or she wishes to make about the imminent termination of the application should be sent to the Office as soon as possible and marked "Urgent".

Mr Dean stated that he was not alerted by this letter that there was an earlier letter with a deadline to reply by. However, he said that around that time he did attempt to get things moving, but had difficulties contacting the applicant who was abroad on business. He also said that a family illness had taken him away from work for a period. As a result of these difficulties it was not until 29 March that he was in a position to advance the prosecution of the case.

Section 18(3) of the Patents Act states that the Comptroller shall give the applicant an opportunity within a specified period to make observations on the examiners report and to amend the specification. The period is not set by statute, but is set by the Comptroller, and he has discretion not only to set these periods but, where appropriate, to vary them. It is well established that the specified period for response to a first report under Section 18(3) is 6 months. It is, in fact, currently one of the Patent Office's Chartermark standards to give applicants 6 months to respond to the first report under Section 18(3). This period has been established since the introduction of the 1977 Act and was considered to be adequate under most circumstances. Nevertheless, the Office has always been responsive to requests for extensions made before the expiry of the period. Provided that an adequate reason is given, an extension is normally granted.

When a response is made after the expiry of the specified period, and a reason is given for the late response, the matter is considered and a decision is made whether or not the Comptroller's discretion should be exercised in the applicant's favour. In *Jaskowski's Application* [1981]RPC197 the hearing officer held that an extension should not be granted because, on the evidence, the request for an extension had been made by the Agent without any instruction from the applicant. We have no reason to believe that the Agent Mr Dean is acting of his own volition in requesting an extension so clearly that is not the situation in the present case. The hearing officer in the above case explained that the main purpose of the provision of a specified period in Section 18(3) was to ensure a smoother flow of amendments through the Office than under the 1949 Act, and whilst the Comptroller has discretion to extend the period, he must have some adequate reason which is peculiar to the particular applicant or application in suit.

I now consider the reasons given for the late response in the present case. Firstly Mr Dean's statement that he was not familiar with the processing of applications through the examination stage before the Patent Office, and as a consequence had not appreciated, or had overlooked the need to respond within a given period. I confess I find this evidence difficult to accept. Mr Dean is a qualified Patent Agent of some years standing who offers his services to act on behalf of applicants before the Patent Office. He received on behalf of an applicant a letter from the Patent Office, the first line of which states that the period for response is 6 months.

I would expect a qualified Patent Agent, even one of little experience to recognise the significance of this statement. Every Section 18(3) report issued by the Office sets a deadline for response. Mr Dean said in evidence that his experience was mainly with foreign applications, but he admitted that he constantly worked to deadlines in prosecuting those, and so it is surprising that he failed to appreciate that he had a deadline to work to with the present application. He also said that as time went by waiting for responses from other offices on equivalent applications the need to respond had slipped his mind. Before it could slip from his mind, it had to be in his mind which suggests that he was aware of the specified period.

I have to ask myself if this is a single unaccountable lapse leading to a case, on which there is every intention to meet the deadline, somehow slipping from sight and thus being overlooked and the applicant thus being prevented from making the necessary response. I think the answer must be no. Mr Dean admitted that during the period of apparent inaction, search and examination reports on corresponding applications were being received and presumably were being assessed with a view to deciding the response to the Section 18(3) report. The case was not lost from view, it was merely that a decision had been taken to delay the response. Even the receipt of the warning letter in December 1995 did not alert Mr Dean to make a response. Mr Dean suggested that he was not alerted by this letter to the fact that a response was overdue. However, the letter begins by reminding the applicant that no response to a Section 18(3) report has been received, and I would suggest that it is implicit that the response is overdue. In any event, no immediate response was made. Again this points to a conscious decision not to respond. Thus I do not regard this reason as adequate within the terms of this request.

In *Jaskowski's Application*, the hearing officer stated that it was for the applicant to respond to a Section 18(3) report, and where it was clear that there had been no attempt by the applicant to progress the case, the Comptroller was quite within his rights to refuse to exercise his discretion to allow an extension of the period for making a response. Mr Dean said in presenting his case that the applicant wished to wait for the results of searches and examination reports on equivalent applications filed at other offices. We do not know whether this was on advice from Mr Dean. Mr Dean certainly did not advise against this course of action. So it appears that from the time the Section 18(3) report was issued until some time after the issue

of the warning letter in December 1995, there had been no attempt by the applicant to progress the case by making a response to the Section 18(3) report; in fact, it appears that he had deliberately decided not to respond. This again points to a failure to comply with the requirements of Section 18(3).

I now consider finally Mr Dean's statement that between the issue of the letter in December and the approach to the Office on 29 March, there had been delays because the applicant had been travelling abroad, and he had been absent because of family illness. It is the practice in the Office to regard absence on holiday or business as a common occurrence, and not be regarded as a peculiar circumstance sufficient to warrant the allowance of an extension. Whilst illness of the applicant or his agent might be accepted as a sufficient reason, and I think it would be reasonable to extend that to include illness within the family requiring the party to be absent, these circumstances arose well outside the period for response, which period expired in April 1995, and I would only need to consider them if I had concluded that the reasons put forward for the delay in response up to that point were sufficient. I would observe also that to delay for over 3 months before responding to a letter urging a response "as soon as possible" seems lacking in diligence and optimistic in anticipating a sympathetic response.

I conclude therefore, from the date of issue of the Section 18(3) report on 17 October 1994 until 1 April 1996 there had been no attempt to advance the prosecution of this case. I find that the reasons given for the late response are not adequate and thus the Comptroller's discretion will not be exercised to allow the late response. I therefore refuse the application for failure to comply with Section 18(3) within the specified period. As this is a procedural

matter, the period in which an appeal may be lodged is 14 days, and this period runs from the date of the hearing at which the decision was given, that is 3 April 1996.

Dated this 9th day of April 1996

GM ROGERS

Principal Examiner, acting for the Comptroller



THE PATENT OFFICE