

01/06/97

PATENTS ACT 1977

Pat/Linda
3Y60

IN THE MATTER OF Patent

Application No GB9600678.8

in the name of Darren Lee McCarthy.

DECISION

1. Patent application no GB9600678.8 was filed on 12 January 1996 in the name of Darren Lee McCarthy. The request for preliminary examination and search in normal circumstances should have been made, in accordance with rule 25 of the Patents Rules 1995, on Patents Form 9/77 within twelve months from that filing date, i.e. on or before 12 January 1996. However, as that day was a Sunday, a day excluded for all purposes of the Patents Act 1977 by rule 99 of the Patents Rules 1995, the request could have been made on or before 13 January 1997. In the event, the Patents Form 9/77 was filed on 14 January 1997.
2. On 15 January 1997, an officer in the Patent Office contacted Mr McCarthy by telephone and informed him that the Patents Form 9/77 had been filed out of time. Mr McCarthy was also advised that in order for the application to proceed he would be required to make a request to extend the prescribed time limit under rule 110(3) of the Patents Rules 1995 by filing a Patents Form 52/77, with the prescribed fee, no later than 12 February 1997.
3. On 17 January 1997, Mr McCarthy contacted the office by facsimile transmission claiming that the cause of the late filing of the Patents Form 9/77 was attributable to his having been given incorrect information by the Patent Office in relation to the time period for filing the form. As it was possible that the giving of such incorrect information could be construed as an irregularity in procedure, the matter was considered under rule 100 of the Patents Rules 1995.

4. Following a full investigation, the Patent Office concluded that there had been no irregularity in procedure and that discretion should not be exercised in Mr McCarthy's favour. In accordance with Section 101 of the Patents Act 1977, Mr McCarthy was entitled to be heard on the issue and the matter came before me at a hearing held on 16 April 1997. Mr McCarthy represented himself and Mr D J Wearmouth attended on behalf of the Office.

5. At the hearing Mr McCarthy said he knew, from the official letter he was sent on 19 February 1996, that he had until 12 January 1997 to file a Patents Form 9/77 requesting preliminary examination and search but contacted the Patent Office on 7 January 1997 to ascertain what exactly the Office required. He said he had spoken to a male member of staff, but did not get the person's name. He also says he had the impression that the person he spoke to had accessed a computer as he had all the details of the patent application ready to hand. Mr McCarthy says that during this conversation he was told that the period for filing the Patents Form 9/77 expired on 18 January 1997 and that because that was a Saturday he had until 20 January to file the form.

6. He then went on to confirm that the Patents Form 9/77 had been filed on 14 January 1997 and that he had been contacted by the Patent Office and advised to file Patents Form 52/77 which he did on 31 January 1997.

7. Mr Wearmouth, on behalf of the Patent Office, outlined the nature of the enquiries made by the Office into the circumstances of the telephone call made by Mr McCarthy on 7 January 1997 and explained that despite a thorough investigation there was no evidence available to the Office to substantiate Mr McCarthy's assertion that he had been told he had until 20 January 1997 to file the Patents Form 9/77.

8. That then is the background. What I now have to decide is whether or not the late-filing of the Patents Form 9/77 was attributable to incorrect information given by the Office

and therefore rectifiable under rule 100 which reads:

- (1) *Subject to paragraph 2 below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.*
- (2) *In the case of an irregularity or prospective irregularity -*
 - (a) *which consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;*
 - (b) *which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and*
 - (c) *which it appears to the comptroller should be rectified,*

the comptroller may direct that the time or period in question shall be altered but not otherwise.
- (3) *Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 or 111.*

9. On the balance of probability, I find it very unlikely that the Patent Office would have told Mr McCarthy that he had until 20 January 1997 to file the Patents Form 9/77. I have taken the following factors into account in coming to this view.

10. First, I have no evidence before me to support Mr McCarthy's claim. It is particularly unfortunate that he was not able to recollect the name of the officer he spoke to on 7 January 1997, which has not helped the Patent Office in its investigations into this matter.

11. Secondly, Mr McCarthy admits that when he telephoned the Patent Office on 7 January 1997 he knew that the date by which he had to file the Patents Form 9/77 was 12 January 1997 and that his only reason for contacting the Office was to check what he needed to do next.

Despite this he says that the officer he spoke to told him that the due date was 18 January 1997 and that because that was a Saturday he had until Monday 20 January 1997 to file the form. The fact that the officer knew the details of his patent application suggests that that person was located in the Patent Office's Central Enquiry Unit, to which such enquiries are automatically diverted, and had accessed the Office's computer record of the application. That record would have been the entry in the Register of Patents that contained the details about the application which would have shown that it had been filed on 12 January 1996. All the officer needed to do to ascertain the date the Patents Form 9/77 was due was to add one year to the filing date giving a date of 12 January 1997. As that date fell on a Sunday the officer would then have known that Mr McCarthy had until the Monday that immediately followed, i.e. 13 January 1997, to file the form.

12. As I understand it, staff in the Central Enquiry Unit are used to dealing with what are fairly straightforward enquiries of this sort and are familiar with the period within which a Patents Form 9/77 has to be filed. Given these facts, I find it highly improbable that an officer in the Central Enquiry Unit would conclude that one year from 12 January 1996 was 18 January 1997 and that as a consequence Mr McCarthy had until Monday 20 January 1997 to file the form.

13. Finally, I am surprised that Mr McCarthy did not query why the date he was given was different to the date he understood to be the due date for filing the Patents Form 9/77 and simply assumed, without checking, that he had a one week grace period.

14. In conclusion, and in the absence of evidence to the contrary, I consider it very unlikely that the Patent Office would have given Mr McCarthy the wrong date. In reaching this conclusion, I wish to make it clear that I have no doubt that Mr McCarthy sincerely believes that what he says is true.

15. I therefore find that the Patent Office's decision not to exercise the Comptroller's discretion under rule 100 to allow the late-filing of Patents Form 9/77 was correct and that the late-filed form may only be accepted if an extension of time is given under rule 110(3).

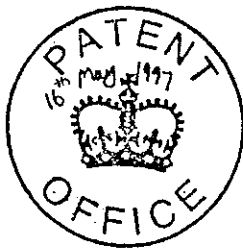
16. Since this is a matter of procedure, the period within which an appeal against this decision may be filed is 14 days from the date of this decision.

Dated this 16th day of May 1997

[REDACTED]

M C WRIGHT

Grade 7, acting for the Comptroller



THE PATENT OFFICE