

## CHAPTER 10

### EXTENSION OF TIME LIMITS (RULE 108)

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## Introduction

- 10.01 The successful processing of a patent application depends on an applicant complying with various requirements of Patent Law within given time limits. These time periods can either be 'prescribed' ie they are set out in the Patents Act or The Patent Rules which means the requirement **must be** met within that period or they can be 'specified' by the Comptroller which means that the Office decides how much time the applicant has to respond. The extension of prescribed periods is governed by rule 108 whilst specified periods are extendable under rule 109.
- 10.02 Once a prescribed time period has expired without the requirement being met, the Office can treat an application as being withdrawn or refused. This means that the applicant has either accidentally missed the filing date or chosen not to continue with the application by not meeting an official requirement.
- 10.03 In due course, applications being treated as withdrawn will be terminated on OPTICS and will appear as having been withdrawn in the Patents Journal. For applications treated as refused, a hearing is offered before they are terminated. Failure to meet a specified period also results in discretionary refusal.
- 10.04 When an application is withdrawn because a prescribed requirement has not been met, the applicant **may not** amend or correct the original filing (e.g. by deleting the priority date) [r.31 or s.117] in order to remove the requirement. If presented with this type of request the Formalities Examiner should refer to MPP 117.19 *Payne's Application* as a point of reference. The application will remain withdrawn until the Office has allowed a request to reinstate the case.

10.05 Any form or document (except a new Patent application which does not claim priority) which arrives at the Office on either a Saturday or Sunday is given the following Monday as its date of receipt because the Office is closed during the weekend. If a relevant period expires on either Saturday or Sunday the form or document is not treated as filed late if it is filed on the following Monday because, in the normal course of events, it would have been filed in time. Neither can a form or document be deemed to be filed on a day when the office is not open for that type of business.

See [www.ipo.gov.uk/bushour schg.pdf](http://www.ipo.gov.uk/bushour schg.pdf)

### **Rule 108 Alteration of Time Limits**

10.06 Rule 108 sets out the various ways in which time limits prescribed in the Rules may be extended or altered. The rule is governed by Schedule 4 to the Patent Rules 2007. (See Annex 10A)

10.07 The Schedule is divided into three parts and each part contains a list of the rules to which that part applies.

10.08 **Part 1** lists those time periods which cannot be extended. These include :-

- R.6(2)(b) Making a declaration of priority after filing
- R.7(1) Requesting permission to make a late declaration of priority
- R.32(1) Requesting reinstatement
- R.109 Requesting extension of time limits set by the Comptroller
- R. 66(3) Requesting permission to make a late declaration of priority in respect of an international application for a patent (UK)

10.09 **Part 2** lists those time periods which may be extended under rule 108(2) or 108(3). These include:-

- R.8(1) & (2) Filing of priority documents
- R.10(1) Filing of Form 7
- R.18 Filing missing parts
- R.22 Filing claims, abstract, application fee, F9A
- R.28 Filing Form 10
- R.30 Putting application in order
- R.66 Entry to National Phase

10.10 **Part 3** lists those time periods which are subject to rule 108(5) and 108(7). These include:-

- R.10(1) Filing of Form 7
- R.12(3)&(9) Filing of name & address & translations
- R.19 Filing divisional applications
- R.22 Filing claims, abstract, application fee, F9A
- R.28 Filing Form 10
- R.30 Putting application in order
- R.66 Entry to National Phase

### **Non-Extendable Time Periods**

10.11 The period for making a claim to priority after the date of filing under rule 6(2) ie. within 16 months of the earliest priority date, cannot be altered. If a request on a Form 3 is received out of time the letter at Annex 6D(i) should be issued.

10.12 Similarly the time period for requesting permission to declare priority from an application filed more than 12 months earlier cannot be altered. Any such request should be referred to the Formalities Manager.

## **Rule 108(1) Comptroller's Discretion**

10.13 Any time period prescribed by the rules and which is **not** listed in Parts 1 or 2 of Schedule 4 may be extended (or further extended) at the discretion of the Comptroller. No form or fee is required but the request should be made in writing and explain the reasons for late filing. For example:-

- Time for filing name & address details
- Time for filing a divisional application
- Time for filing the translation of a foreign language description
- Time for filing missing parts under rule 18(2)

10.14 If however the rule in question is listed in **Part 3** of the Schedule the availability of an extension and the duration of any extension will be restricted by r.108(5) and (7). See 10.37-41.

10.15 A request for an extension of time under rule 108(1) should be referred to the Formalities Manager to consider. If discretion is allowed, the Formalities Examiner must notify the applicant in writing (see **Annex 10B**) and complete any necessary Formalities action. A printer's instruction *footnote* should be added where appropriate.

10.16 When the request for extension of time is declined, the Formalities Manager will inform the Formalities Examiner to issue letter **Annex 10C**.

## **R.108 (2) Request for an automatic extension of two months**

10.17 An automatic extension of two months will be granted in respect of any of the time periods listed in **Part 2** of Schedule 4. The extension must be requested within the two month period following the expiry of the time limit using Form

52 with the fee of £135. The outstanding requirement may be filed within the two month extension period. The time periods include:-

- 16 months for priority documents from a foreign application [r.8(1)&(2)]
- 16 months for F7 [r.10(1)]
- Time for filing missing parts [r.18(1)]
- 12 months from priority date or two months from filing date for F9A application fee, claims, abstract etc. [r.22(1),(2) & 4(a)]
- 6 months (after the date of 'A' publication) for F10 [r.28]
- 4 years 6 months for putting an application in order for grant [r.30]
- 31 months for a request for an international application to enter the UK national phase [r.66]
- 33 months for a F7, F9A or F10 (PCT Application) [r.68]

(Time limits are calculated either from the filing date or priority date, whichever is the earliest date)

10.18 Periods for meeting prescribed requirements, defined in **Part 2** of Schedule 4 of The Patents Rules 2007 will be extended by two months under r.108(2) when the F52 and fee are filed **before** the end of the second month after the period ended. If the F52, fee and associated form/document are all in order, the Formalities Examiner may action them using OPTICS function SET TIME LIMIT. (See 10.23)

10.19 A request for extension of time (with F52 and fee) received later than two months after a time period ended may be considered under rule 108(3) but only for those rules not listed in **Part 3** of Schedule 4. See 10.30. In response to an enquiry, the Formalities Examiner should issue a letter such as the example in Annex 10D(i).

- 10.20 A request for more than one period of time to be extended may be made on a single Form 52 but only if they relate to one application and if all the time periods, if extended, would expire on the same day. (Rule 108(4)).
- 10.21 A single Form 52 and fee cannot be used to extend the rule 30 period on both a parent and a divisional and the act of extending the rule 30 period on a parent does not automatically extend the rule 30 on the divisional. A separate form must be filed for both applications (see 14.41 -42)".
- 10.22 If an application is not in order for Grant by the end of the compliance period [s.20 & r.30] of four years and six months period, an extension of two months as of right can be requested. (See 10.26-27) The extension must be requested within two months of the expiry of the period and is effective retrospectively. Divisional applications may be filed up to three months before the end of the *extended* period and so a divisional application filed one month before the end of the unextended s.20 period will be allowable if it is accompanied by a request to extend that period under rule 108(2). The application must be immediately forwarded to the examiner for action. A request on F52 to extend the r.30 period by two months may be made before the r.30 period has expired. (e.g. to allow more time under r.19 to file a divisional application). (see 14.04 - 14.05)

### **OPTICS Function: SET TIME LIMIT**

- 10.23 Formalities may set or change time limits on OPTICS so that outstanding requirements are highlighted and automatic extensions of time under r.108(2) are recorded. (F52 [OPTICS code - **52.2**])

The first screen asks the user to select which option is to be actioned:

*Either (a)* to revise a particular time limit, extended under r.108(2)

*Or (b)* to enter or delete the time limit for filing the translation(s) of a priority document – this function is no longer used.

*Or (c)* to revise an application's lodged/filing date.

## **Extension of time under Rule 108(2)**

- 10.24
- (a) Select option N° 1.
  - (b) Enter the date the F52 [52.2] was filed.
  - (c) Enter the appropriate code for the time limit to be extended: F7, F9A, F10 or Priority Document.

The next screen will appear to confirm that the alteration has been recorded.

However, if more than one time limit is to be extended by a single F52 or the time limit relates to Claims or Abstract these are extended using OPTICS function **CHANGE CASE DETAILS (CHA CAS)** Option 10.

- 10.25
- Receipt of the F52 and confirmation that the extension has been actioned should be recorded on the minute sheet. The application may then proceed.

## **Extension of the Compliance Period (s.20, r.30)**

- 10.26
- The period for putting a patent application in order for grant may be extended in two ways:

- (a) If a F52 has been filed before or within the two months after the s. 20 compliance period has expired use OPTICS function **SET TIM** (See 10.24)
  - Select option N° 1 complete form, ie filing date of F52, time limit to be extended, ie s.20
  - Enter **S20** [Hit Enter]

The period will be extended automatically.

If a F52 or other request for an extension is filed later than two months after the compliance period expired, the matter should be referred to the Head of Administration (via the Formalities Manager) for action.

(b) The applicant is guaranteed a period of one year in which to put the application in order following issue of the first s.18 examination report. (On divisional applications the date is calculated from the date of first s.18 examination on the parent application see r.30(3)(b)) not the divisional exam report date). If, for whatever reason, when the report is issued the applicant has less than a year to respond the compliance period must be extended. This should be done automatically via the PROSE system but if necessary the Formalities Manager can extend the period using the OPTICS function **CHA CAS** (Change Case Details):

- Select Option 10 - Time Limits for case [Hit enter]
- On the second screen, overtype the r.30 time limit date with a date twelve months after the examiner's report was issued. [Hit enter]

10.27 Where a patent examiner has dealt with a request to extend the compliance period he/she will issue an instruction to de-log the F52. The Formalities Examiner should then de-log the form.

### **Rule 108(3) Requests for discretionary extensions**

10.28 A further discretionary extension of time may be granted in respect of any of the time periods listed in **Part 2** of Schedule 4. Rule 108(3) provides for a discretionary extension of time beyond the automatic two month period allowed under rule 108(2). The extension may be requested at any time after the expiry of the time limit and the extension may be of indefinite length but only for those time periods which are **not** listed in **Part 3** of Schedule 4. (See

10.43) The extension will only be allowed if the Office decides that there are sufficient reason(s) to allow it.

10.29 A request for a discretionary extension or further extension of time is made on F52 accompanied by the fee of £135 and evidence explaining the circumstances under which the period for filing was missed.

10.30 A request for extension under r.108(3) will be considered when the following are filed:

- (a) F52 and fee,
- (b) Evidence - It is for the applicant to provide whatever evidence he believes will best support his case. Evidence can be accepted in the form of a letter or a sworn statement (Statutory Declaration or Affidavit) or a Witness Statement or in any other form. A statutory declaration if provided must be signed in the presence of a solicitor or a Commissioner of Oaths and prepared in accordance with The Statutory Declarations Act 1835 and r.87 of The Patent Rules 2007. A Witness Statement should be made and subscribed in accordance with the Civil Procedure Rules (notably rule 32.8 and the associated Practice Directions). (see example at Annex 10H)

10.31 A valid request for an extension of time will normally include (a) and (b). If not, Formalities must contact the applicant/agent and instruct them to file the omitted documents. A period of one month should be given and the applicant/agent should be reminded that if the document is not filed the application will remain withdrawn. If an extension is granted the outstanding item must be filed by the end of the extended period if it has not been filed with the Form 52.

- 10.32 When a request for an extension has been filed, the application should be forwarded to the Head of Administration, via the Formalities Manager, for consideration. The Formalities Manager should record the filing of the Form 52 by using Optics function **REG FIL** which creates a Register Entry. The Optics code for a Form 52 filed for a discretionary extension is **52.1**.
- 10.33 If the extension to be allowed is to a common date then more than one time period on the same application may be extended by filing a single F52. [r.108(4)]
- 10.34 Each individual request for extension must be considered on its own merits. However, if the same applicant requests extensions on more than one co-pending applications (including a parent and its divisional), the Head of Administration may agree to consider the requests jointly.
- 10.35 Formalities must never give advice on the acceptable content of evidence. It should be an accurate record of the facts relating to the late filing, from a person taking responsibility for the prosecution of the application. If this responsibility was shared, each person may supply separate evidence in support of the request in order that the full facts can be made known to the Office.
- 10.36 As a general rule the evidence should display that, at the time the period expired, the failure to meet the time period was unintentional. This is consistent with the test for reinstatement under s.20A. However, as rule 108 does not set out a statutory test for extensions of time discretion may be exercised favourably in appropriate circumstances even if the unintentional test does not appear to have been met. (see MoPP 123.37)

If the evidence shows that the failure to meet the time limit was unintentional discretion must be exercised favourably regardless of whether there was a

continuing underlying intention to proceed. Further evidence may be requested but the fee on the F52 **cannot** be refunded.

If the request is allowed the letter at Annex 10E should be issued and the decision recorded on Optics using **REC F52**. Guidance on processing a Form 52 for a discretionary extension can be found at H:\Formalities\Processing of F52.

### **Extension of Time restricted by rule 108(5) & (7)**

- 10.37 **Part 3** of Schedule 4 provides a list of those time periods where extensions beyond the initial two months are restricted. These time limits are ones where failing to meet them will mean the application is refused or treated as withdrawn. Discretionary extension of these time periods is restricted so that if the applicant leaves it too late to request an extension the only remedy will be reinstatement (see 10.42 - 62).
- 10.38 Rule 108(5) provides that any extension under rule 108(1), or (3) shall be made after giving any notice or subject to any conditions (e.g. 3<sup>rd</sup> party terms) as directed by the Comptroller **except** that a time period in any rule listed in **Part 3** of Schedule 4 may only be extended (or extended further) for a period of two months. In other words, we need to notify the applicant/agent by letter of the terms and conditions under which his extension is allowed as these are variable. However, any extensions of the requirements listed in **Part 3** are fixed and restricted to 2 months only.
- 10.39 Rule 108(7) prohibits any extension of time being granted in relation to a time period listed in **Part 3** of Schedule 4 if more than two months has elapsed since the relevant time period (or the already previously extended time period) expired. This means that a Form 52 filed more than two months but less than 4

months after the time period has expired can only be considered if the time period has already been extended as of right under rule 108(2).

An example time line is given below.

10.40 **First extension (as of right)**

→-- end of period → | → 2 months ←

→-----Requested in time-----← ☹️ TOO LATE

**Further extension (discretionary)**

-----end of extended period → | → 2 months ←

→-----Requested in time-----← ☹️ TOO LATE

10.41 Any request for a discretionary extension whether restricted or not should be referred to either the Head of Admin or, if it relates to the rule 30 period, to the Patent Examiner or DD.

**Request for Reinstatement of an application (S20A)**

10.42 When an application has been refused, treated as refused, withdrawn or treated as withdrawn by the office (hereafter referred to as withdrawn) through failure to meet a time limit set out in the Act or Rules or specified by the Comptroller then the applicant has a set period during which he can apply to reinstate the application.

10.43 Reinstatement is available where an application has been refused or withdrawn for failure to comply with a specified time limit or a time limit prescribed in one of the rules listed in **Part 3** of Schedule 4 to the Patent Rules

- 10.44 Where an applicant has failed to comply with a requirement within the time limit and has not requested an automatic extension of the time period under rule 108(2) their application is deemed to have been withdrawn.
- 10.45 S20(A) provides for the reinstatement of a withdrawn application where no further extension of time is available. Reinstatement must be requested within 2 months from the removal of the cause of failure to meet the time limit, or within 12 months of the effective date of termination, whichever expires **earlier** [r32(2)(a)(b)]. For example – if the cause of the failure to comply with the time limit was due to an administrative error, then discovery of the error would remove the cause of non compliance and the two months would run from that date. (See *Matwell Services Ltd BL/O/091/11* and *Manjinder Virdee O/104/11*). In response to an enquiry about possible reinstatement the letter at Annex 10D(ii) should be used.
- 10.46 However, reinstatement is not available if an extension of time is still available to the applicant by filing a Form 52, (see 10.28) or if the period in question relates to proceedings before the Comptroller, an extension under s.117B or to a late priority claim. The time allowed for requesting reinstatement itself is not extendable. If an extension of time is still available the agent/applicant should be informed as soon as possible.
- 10.47 A request for reinstatement will be considered when the following are filed:
- (a) F14 and fee.
  - (b) Evidence explaining the circumstances surrounding the failure to meet the time limit. Evidence to support a request can be accepted in the form of a letter, a sworn statement (Statutory Declaration or Affidavit) or a Witness Statement or in any other form. It is for the applicant to provide whatever evidence he believes will best support his case. A

statutory declaration if provided must be signed in the presence of a solicitor or a Commissioner of Oaths and prepared in accordance with The Statutory Declarations Act 1835 and r.87 of The Patent Rules 2007. A Witness Statement should be made and subscribed in accordance with the Civil Procedure Rules (notably rule 32.8 and the associated Practice Directions). (see example at Annex 10H)

- The outstanding requirement may also be filed at this stage; however this is not a necessity, as a further period for filing this document will be provided if reinstatement is allowed. This will normally be two months but a longer period may be provided if necessary

10.48 A valid request for reinstatement must include *(a) and (b)*. If either is absent, Formalities must contact the applicant/agent and instruct them to file the omitted documents. A period should be specified (rule 32(6)) for filing evidence (normally 2 months) and the applicant/agent should be reminded that if evidence is not filed the application will remain withdrawn and the request cannot be considered.

10.49 A minute should be sent to the Formalities Manager for OPTICS action **REG FIL** which will create a journal entry and where appropriate close the third party terms 'window'. This should be done in **all** cases where a Form 14 has been filed **regardless** of whether all other documents have been filed or not.

10.50 When a request for reinstatement has been filed, the application should be referred to the Head of Administration, via the Formalities Manager, for consideration.

10.51 Each individual request for reinstatement must be considered on its own merits. However, if the same applicant requests reinstatement of more than one co-pending applications (including a parent and its divisional), the Head of

Administration may agree to consider the requests jointly. A separate Form 14 is required on each application.

- 10.52 If there are multiple applicants any one or more of them may apply for reinstatement without the others [S.20A(4)].
- 10.53 Formalities must never give advice on the acceptable content of any evidence. It should be an accurate record of the facts relating to the late filing, from a person taking responsibility for the prosecution of the application. If this responsibility was shared, each person may supply separate evidence in support of the request in order that the full facts can be made known to the Office.
- 10.54 The evidence must display that, at the time the period expired, the failure to comply was *unintentional*, a "change of mind" is not sufficient. If the explanation of the events leading to the filing being missed is unclear, the request for reinstatement may be declined. Further evidence may be requested but the fee on the F14 **cannot** be refunded. A continuing underlying intention to proceed with the application does not always mean the failure to comply with the time limit was unintentional. An explanation of how the Office defines unintentional can be found in MoPP 20A.13 (*Anning's Application (BO/374/06)*).
- 10.55 A request for reinstatement may arrive before Formalities have terminated the application on OPTICS. If the application is deemed to be withdrawn the OPTICS processing status must be set as **TERMINATED** before the reinstatement request can be processed.
- 10.56 If the Head of Administration considers that the request for reinstatement under s.20A is allowable, either they or the Formalities Manager will write to the applicant/agent, using the letter at Annex 10F, informing them of the

decision, and issuing a Reinstatement Order (Annex 10G). The Head of Administration or Formalities Manager completes the relevant formalities action by recording the decision to allow reinstatement on OPTICS using the function **REC F14**. This creates a journal entry and changes the processing status of the application.

10.57 If the application has been published and its termination advertised in the journal then reinstatement is subject to mandatory 3<sup>rd</sup> Party Terms under section 20B and the application must be referred to the Head of Administration for action.

10.58 The Reinstatement Order will provide the applicant with a period in which to meet any outstanding requirement which has not already been met and has led to the application being treated as withdrawn or refused [s.20A(7)]. This will normally be two months. The application will be diarised for a period of 10 weeks from the date of notification to the applicant/agent to await the outstanding requirement. When the outstanding requirement is filed normal processing of the application will resume.

10.59 The outstanding requirement must be filed within the period specified in the Order. An extension of time may however be requested in writing under the provisions of s.117B. If the diary expires and the item has not been filed, the application is again treated as withdrawn [s.20A(9)].

10.59a **Reinstatement after the Compliance Period has ended.**

However, where an application is treated as refused for failure to respond to an examination report and is subsequently reinstated after expiry of the compliance period, a new period for responding to the examination report and a new period for overall compliance will be specified. This will allow the applicant to respond with amendments to bring the application into

compliance. This follows the decision in *Ali et al's Patent Application* BL O/264/10. The period specified will usually be 2 months from the date of the reinstatement decision. This new compliance period may then be extended under rule 108 if necessary.

- 10.60 If the Head of Administration decides that the reinstatement request should be refused then he/she will inform the applicant by letter setting out the reasons for the refusal and giving them a period of one month from notification to request a hearing. A diary date of six weeks from the date of notification should be set.
- 10.61 If nothing is heard from the applicant by the end of this period then the application remains withdrawn. The Head of Administration will issue a decision and record the refusal of the reinstatement request on OPTICS using function **REG F14** which will create the required journal entry. Any fees paid on unactioned forms eg. F9A, F10 should be refunded but Form 14 cannot be refunded.
- 10.62 If the agent/applicant indicates that they wish to withdraw or not continue with their request for reinstatement this is recorded on OPTICS using the function **REG F14**.

### **Applying Third Party Terms to an application**

- 10.63 If a withdrawn application is reinstated and the withdrawal has been advertised and the application has already been published by either the UK Office or WIPO, the reinstatement will be subject to special terms to protect the interests of third parties. This means that if a patent is eventually granted, the applicant will have limited legal rights for the period when the application was not in force, i.e. anyone who copied or used the invention in good faith while the

application was not in force, may continue to do so because they had genuine reason to believe that the patent application had lapsed.

10.64 Any application divided out of a parent [s.15(9)] where these Third Party Terms have been applied will also be subject to them for the period that the parent was not in force. If the divisional application is granted then a special certificate will be required. (see10.71)

10.65 Third Party Terms relate only to cases withdrawn and advertised as such after public disclosure, ie 'A' Publication. For example, failure to file patents F10 within the six month r.28 period and the late entry into the National Phase of a s.89 application (see 10.66). (Enquiries about a lapsed patent after grant are referred to Litigation Section.)

#### **Application of Third Party Terms - Late entry to National Phase**

10.66 When a request for reinstatement concerns a PCT application's late entry into the National Phase [r.66(1)] third party terms may need to be applied. This is because details of the application will have been published either by the Office (Early Publication) or by WIPO (in PCT Chapter I processing). Subsequently, the application may have been terminated on OPTICS and this fact published.

10.67 PCT applications entering the national phase in the UK under PCT Chapter I or II, are reported in the journal within around 6 weeks of receipt. Allowing for a request for an automatic extension of time for national phase entry, any third party following the progress of such an application could reasonably expect the case to be published as directly entering the national phase within 4 months of the relevant deadline (ie.31 months from earliest declared priority date) for entering the national phase. Therefore if late entry is allowed later than **35 months** from the earliest date, then 3<sup>rd</sup> party terms should be applied.

- 10.68 The only exception to this would be where the PCT application also designated GB as part of the European regional designation. Although the EP region is automatically designated, the applicant has to specify which particular states are designated in the EP phase. Under these circumstances the case would have 31 months to enter the PCT regional phase in the EPO. If it failed to do so then, around 9 months from the period allowed for entry into the regional phase, the EPO will publish their PCT application number as having failed to enter the regional phase. After noting that a PCT application has not been advertised in the journal as entering the UK national phase and, where appropriate, the equivalent EP patent has been advertised in the European Patent Journal as not entering the EPO regional phase, a third party may have acted in good faith and begun to use the invention, believing the application withdrawn. In such a case if late entry to the national phase is allowed later than **40 months** from the earliest date then 3<sup>rd</sup> party terms should be applied.
- 10.69 The Head of Administration will decide in each case whether reinstatement of the application should be subject to terms to protect the interests of third parties under section 20B.
- 10.70 The Head of Administration allowing reinstatement will set out the terms to be imposed and raise a journal entry advising that the application has been reinstated with third party conditions.
- 10.71 A third party terms label should be added to the dossier cover and the following warning imported into the dossier: the TOC should be annotated 3<sup>rd</sup> Party Note. A note could also be made in the annotation section on the dossier cover that a Special Grant Certificate will be required.

NOTE: This application has been reinstated. If and when it this application is marked in order for grant it must be referred to the Formalities Manager in order that a special certificate may be prepared. A check should also be made to see if any divided applications have been filed. If they have, consideration will need to be given as to whether a special Certificate should also be applied on the divided applications.

- 10.72 When the examiner marks the application in order for grant, any application bearing the above warning label should immediately be forwarded to the Publication Liaison Officer who will prepare a special grant certificate. This will be marked with "SEE ENDORSEMENTS" and will be ribboned and sealed with the third party terms attached to the back of the certificate. (See Annex 10I) The PLO will record their action on a minute sheet and import into the dossier and notify Publishing Section that the special certificate should be issued instead of that produced by OPTICS. Similar provisions apply to published applications resuscitated after being withdrawn in error. (see 12.105)

### **Extension of Specified Time Periods (s.117B & rule 109)**

- 10.73 A specified time period is any period of time which is not prescribed by the Patent Rules but is set by the office. This includes, for example, the time allowed for filing formal drawings or replacement pages and the time allowed for replying to a substantive examination report as well as any other time period specified for reply to an official letter.
- 10.74 A specified time period may be automatically extended under rule 109 by a period of two months **or** to the end of the compliance period if that is **earlier**. The extension must be requested in writing (includes e-mail) and within two months of the time period expiring. The extension is as of right so no special

form or any other document is needed.

- 10.75 The extension must be requested within two months of the expiry of the time period in question and no further extensions to the same time limit can be granted under this rule. They must be requested before the expiry of the already extended period. A dedicated e-mail address [PATEOT@ipo.gov.uk](mailto:PATEOT@ipo.gov.uk) is available for receipt of these requests. An automatic response is generated and the e-mails are dealt with by the Formalities Support Officer.
- 10.76 A further extension after the ‘as of right’ extension may be given but only if the ‘as of right’ extension has already been requested and the request for a further extension is made before the ‘as of right’ extension runs out. A request for a further extension does not need to be in writing. An extension of one further month is generally allowable but taking into account how long remains of the compliance period. An adequate reason must be given and if not, then one should be asked for.
- 10.77 If no ‘as of right’ extension has been requested or is available then any late response to a substantive examination report should be referred to the Patent Examiner to determine whether to refuse the application or accept the late response. This includes responses received within the two months extension period but without a written request to extend the period.

### **Extensions of time due to postal delays or disruptions [rule 110 & 111]**

- 10.78 Any queries concerning receipt of mail or postal disruptions (for example by strikes or adverse weather) should be referred to Document Reception section. (see 12.56)
- 10.79 If Document Reception section confirms that a document was not filed in time to meet a prescribed or specified deadline, the Formalities Examiner

should instruct the applicant to request an extension of time under the appropriate subsection of r.108 or r.109 or alternatively under rule 111. (see 12.61)

**SCHEDULE 4**  
**EXTENSION OF TIME LIMITS**

**PART 1**

**PERIODS OF TIME THAT CANNOT BE EXTENDED**

rule 6(2)(b) (declaration of priority for the purposes of section 5(2) made after the date of filing)  
rule 7(1) (period for making a request to the comptroller for permission to make a late declaration of priority)  
rule 32(1) (application to reinstate a terminated application)  
rule 37 and 38 (renewal of patents)  
rule 40(1) (application to restore a lapsed patent)  
rule 43(4) (application to cancel entry that licence available as of right)  
rule 58(1) (request for a direction under section 81)  
rule 59(1) (request from a foreign industrial property office for a direction under section 81)  
rule 66(3) (period for making a request to the comptroller for permission to make a late declaration of priority in respect of an international application for a patent (UK))  
rule 76(2) (notice of opposition), except in relation to an opposition under section 27(5) where there are pending before the court or the comptroller proceedings in which the validity of the patent is put in issue  
rule 77(8) and (10) (opposition periods)  
rule 104(2) (period for filing an address for service), in relation to an application for a patent  
rule 109 (extension of time limits specified by comptroller)  
rule 116(2) (fee for supplementary protection certificate)  
paragraph 8(5) of Schedule 1 (new deposits of biological material)

**PART 2**

**PERIODS OF TIME THAT MAY BE EXTENDED  
UNDER RULES 108(2) OR 108(3)**

rule 8(1) and (2) (filing of information and priority documents)  
rule 10(3) (filing of statement of inventorship and the right to be granted a patent)  
rule 18(1) (missing parts)  
rule 21 (extensions for new applications)  
rule 22(1), (2) and (5) (periods prescribed for the purposes of section 15(10) and 17(1))  
rule 28(2), (3) and (5) (request for substantive examination)  
rule 30 (period for putting an application in order)  
rule 56(6) and (7) (filing of a translation of European patent (UK) specifications)  
rule 58(4) (request under section 81(2)(i))  
rule 59(3) (request under section 81(2)(ii))  
rule 60 (request for substantive examination following a direction under section 81)  
rule 66(1) and (2) (international applications for patents: entry into national phase)  
rule 68 (international applications for patents: altered prescribed periods)  
paragraph 3(2) of Schedule 1 (filing of information in relation to the deposit of biological matter)

PART 3

**PERIODS OF TIME TO WHICH  
RULE 108(5) AND 108(7) RELATE**

rule 10(3) (filing of statement of inventorship and the right to be granted a patent)  
rule 12(3) and (9) (filing of name and address and translations)  
rule 19 (new applications filed as mentioned in section 15(9))  
rule 21(1)(a) and (2)(a) (extensions for new applications)  
rule 22 (periods prescribed for the purposes of section 15(10) and 17(1))  
rule 28 (request for substantive examination)  
rule 30 (period for putting application in order)  
rule 58(4) (request under section 81(2)(b)(i))  
rule 59(3) (request under section 81(2)(b)(ii))  
rule 60 (request for substantive examination following a direction under section 81)  
rule 66(1) and (2) (international applications for patents: entry into national phase)  
rule 68 (international applications for patents: altered prescribed periods)

**Annex 10B**

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
Cardiff Road, Newport  
South Wales  
NP10 8QQ  
United Kingdom

**Direct line: 01633 81\*\*\*\***

**†E-mail:**

\*\*\*\*\*@ipo.gov.uk

**Switchboard:** 01633  
814000

**Minicom:** 08459 222250

**Fax:** 01633  
814444

DX 722540/41 Cleppa Park 3

<http://www.ipo.gov.uk>

**Your reference: XXX**

**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007**

**Request for Comptroller's discretion under Rule 108(1)**

Thank you for your request for the Comptroller's discretion to allow the late-filing of your  
\*\*\*\*\*.

I am pleased to inform you that your request has been allowed and that your patent application will now continue.

Yours faithfully

Formalities Examiner

September 2011

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**†Use of E-mail:** Please note that e-mail should be used for correspondence only.

**Annex 10C**

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
Cardiff Road, Newport  
South Wales  
NP10 8QQ  
United Kingdom

**Direct line:** 01633 81\*\*\*\*  
**†E-mail:** \*\*\*\*\*@ipo.gov.uk  
**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: XXX**  
**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007**  
**Request for Comptroller's discretion under Rule 108(1)**

Thank you for your request for the Comptroller's discretion to allow the late-filing of your  
\*\*\*\*\*.\*

I regret to inform you that your request has not been allowed.

Any comments you wish to make about this decision should be sent to this Office by  
**DD/MM/YYYY**.

Yours faithfully

Formalities Examiner

September 2011

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†Use of E-mail: Please note that e-mail should be used for correspondence only.

**Annex 10D (i)**

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
Cardiff Road, Newport  
South Wales  
NP10 8QQ  
United Kingdom

**Direct line:** 01633 81\*\*\*\*  
**†E-mail:** \*\*\*\*\*@ipo.gov.uk  
**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: XXX**  
**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007**  
**Request for extension of time under Rule 108(3)**

In response to your enquiry I am writing to confirm that no priority document has been filed within the time period allowed under the Rules (or the previously extended period) which expired on DD/MM/YYYY.

**What you must do next**

If you decide to continue with your patent application you must request a discretionary extension of the time period for filing your priority document.

To make the request you should use the enclosed Patents Form 52 which you should complete and return to this Office by DD/MM/YYYY with a fee of £135.

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September 2011

†Use of E-mail: Please note that e-mail should be used for correspondence only.

## **Annex 10D (i)**

Along with your Patents Form 52 you should also send:-

the priority document

evidence explaining why you did not file your priority document on time. Evidence may take the form of a signed statement of truth known as a witness statement, an example of which is attached.

### **What happens then?**

While each request for an extension is considered on its merits, the basic principle has been established that for an extension to be allowed there must have been a continuing underlying intention to proceed with the application. A change of mind is not considered to be a legitimate reason for allowing an extension.

Once your request for extension of time has been received a senior official at the Office will review your case. If it is decided that the time for filing your priority document should be extended, you will be notified and your application will then continue.

Yours faithfully

Formalities Examiner

September 2011

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
Cardiff Road, Newport  
South Wales  
NP10 8QQ  
United Kingdom

**Direct line:** 01633 81\*\*\*\*  
**†E-mail:** \*\*\*\*\*@ipo.gov.uk  
**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: XXX**

**Application number: GB \*\*\*\*\* \***

Date

Dear Sir(s)

**Patents Act 1977: Patent Rules 2007  
Reinstatement of a terminated application**

In response to your enquiry I am writing to confirm that no \*\*\*\*\* has been filed within the time period allowed under the Rules and your application was therefore terminated on DD/MM/YYYY. No extension of the time period is available.

**Conditions for reinstatement**

It may be possible to reinstate your application. To do so you must meet **all** of the following conditions:

- i) your failure to comply within the time period allowed must have been unintentional;
- ii) reinstatement must be requested within two months of you becoming able to comply with the outstanding requirements;
- iii) reinstatement cannot be requested later than twelve months after the termination of your application;
- iv) the request must be made as soon as possible on Patents Form 14 (enclosed) which you should complete and return to this Office with a fee of £150;

v) the request should be accompanied by evidence explaining why you did not comply with the outstanding requirements within the time period allowed and addressing the question of when you became able to comply.

Reinstatement requires that your failure to comply with the time period allowed was unintentional. Consequently, for a request for reinstatement to be successful there must have been some reason why you did not proceed. The date on which you became able to comply is the date on which that reason was overcome. It may be, for example, that your papers were destroyed in a fire. In that case you would become able to comply upon the receipt of replacement papers or upon the completion of redrafting of the papers. Any request for reinstatement must be received within two months of that date. A change of mind is not considered to be a legitimate reason for allowing reinstatement.

### **What happens then?**

Your request for reinstatement will be considered by a senior official at the Office. If it is decided to allow reinstatement you will be notified and given two months to comply with the requirement(s) which led to the application being terminated.

The fee of £150 is not refundable, whether or not your request is allowed.

### **Warning**

If you do not request reinstatement your application will remain terminated and a patent will not be granted.

Yours faithfully

Formalities Examiner

**Annex 10E**

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
Any Where

**Intellectual Property Office  
Patents Directorate**

Concept House  
Cardiff Road, Newport  
South Wales  
NP10 8QQ  
United Kingdom

**Direct line:** 01633 81\*\*\*\*  
**†E-mail:** \*\*\*\*\*@ipo.gov.uk  
**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: XXX**

**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007  
Request for extension of time under Rule 108(3)**

You recently filed Patents Form 52 to extend the time for filing a \*\*\*\*\*.

I am pleased to inform you that your request to extend the time for filing your \*\*\*\*\* has been allowed and your patent application will now continue.

Yours faithfully

Formalities Examiner

September 2011

A. N. Other  
% An Agent  
Any Street  
Any Town  
Any Place  
Any Where

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Patents Directorate**

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**Direct line:** 01633 81\*\*\*\*  
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**Switchboard:** 01633 814000  
**Minicom:** 08459 222250  
**Fax:** 01633 814444  
DX 722540/41 Cleppa Park 3  
<http://www.ipo.gov.uk>

**Your reference: XXX**

**Application number: GB \*\*\*\*\*.\***

Date

Dear Sirs

**Patents Act 1977: Patent Rules 2007  
Request for reinstatement under Section 20A**

You recently filed Patents Form 14 to request reinstatement of your application.

I am pleased to inform you that your request for reinstatement has been allowed. A Reinstatement Order is attached and you should note the new time limit for \*\*\*\*\* which is **DD/MM/YYYY**. Failure to comply with this time limit will result in the application being treated as withdrawn.

You should note that an order for reinstatement gives certain rights to third parties in accordance with the terms prescribed in Section 20B of the Patents Act 1977. The relevant extracts from that section are as follows:

1. If the application has been published under Section 16 before its termination, after the termination and before publication of notice of the request for its reinstatement, a person -
  - (a) *began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or*

## Annex 10F

(b) *made in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, not withstanding the reinstatement of the application and the grant of the patent; but this does not extend to granting a licence to another person to do the act.*

2. *If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-paragraph (1) above may -*

(a) *authorise the doing of that act by any partners of his for the time being in that business, and*

(b) *assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.*

3. *Where a product is disposed of to another in the exercise of the rights conferred by sub-paragraph (1) or (2) above, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the applicant.*

If a patent is eventually granted on this application the certificate of grant that you receive will be endorsed with the above conditions.

Yours faithfully

Head of Administration

September 2011

**PATENTS ACT 1977**

Date

APPLICANT

A. N. Other

ISSUE

Whether Patent Application GB  
\*\*\*\*\*.\* should be reinstated  
under Section 20A

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**ORDER TO REINSTATE**

- 1 Patent application number GB \*\*\*\*\*.\* filed on DD/MM/YYYY was terminated on DD/MM/YYYY through failure to file \*\*\*\*\* within the relevant time period. On DD/MM/YYYY A. N. Other applied to have this patent application reinstated.
- 2 Having examined the evidence filed in support of the request, I am satisfied that reinstatement should be allowed. I therefore order that the patent should be reinstated under Section 20A.
- 3 A period of two months from the date of this Order is now prescribed under Section 20A(7) for \*\*\*\*\* to be filed.

Head of Administration  
Acting for the Comptroller

**Example of a witness statement:**

**Patents Act 1977**

**WITNESS STATEMENT**

I, ..... [name] of.....[address of  
witness] a ..... [occupation] state the following:-

- 1.
- 2.
3. [etc.]

I believe that the facts stated in this witness statement are true.

Signed.....

Date.....

3<sup>rd</sup> Party Terms for Grant Certificate

1. If after the termination of the application and before publication of notice of the request for its reinstatement, a person -

- (a) began in good faith to do an act which would have constituted an infringement of the rights conferred by publication of the application if the termination had not taken place, or
- (b) made in good faith effective and serious preparations to do such an act, he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the reinstatement of the application and the grant of the patent; but this does not extend to granting a licence to another person to do the act.

2. If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-paragraph (1) above may -

- (a) authorise the doing of that act by any partners of his for the time being in that business, and
- (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

3. Where a product is disposed of to another in the exercise of the rights conferred by sub-paragraph (1) or (2) above, that other and any person claiming through him, may deal with the product in the same way as if it had been disposed of by the applicant.