



*to my examination report (dated 11 January 2023) to be filed, and a reason, in writing, for the late reply. See MoPP 18.54.*

*Given that the response is now nearly five months late and the compliance date is within six months from now, prompt action from now is of course desirable."*

- 6 On 8 September 2023, a response to the Examination Report was filed. By way of explanation for the delay, the Attorney described a change of ownership and personnel that had taken place within the Applicant company. This meant that they were unable to make contact with their client during the period 20 January – 1 June 2023. That said, on 1 June 2023 and upon reestablishing contact with their client, they did receive instructions to proceed with the application.
- 7 On 10 November 2023, the Examiner responded, accepting the reasons given for the delay up to 1 June 2023. However, the Examiner noted that no reasons had been provided for the response being further delayed in the period 1 June – 8 September 2023. The Examiner requested reasons be provided so that the request could be considered.
- 8 On 17 November 2023, the Attorney provided further information to explain the delay. Although contact with their client was reestablished on 1<sup>st</sup> June, they were subsequently contacted by a new director of the Applicant company towards the end that month. As a result of that contact, they were instructed to carry out a further review of the relevant prior art within the context of the commercial version of the product which is the subject of this application. So as to provide a response that would be of commercial value and address issues of novelty and inventive step, a period of consultation with the Applicant took place. This process was further impacted due to a holiday commitment. The Attorney concluded their reasoning by emphasising that they wished to provide a response that would fully address the substantive issues raised and avoid the need for a further examination round. Further, that bearing this in mind, the response was filed at the earliest opportunity on 8 September 2023.
- 9 On 27 December 2023, the Examiner wrote to the Applicant, again accepting the reasons for the delayed response for the period up to 1<sup>st</sup> June 2023. However, they did not accept the additional reasons for the further delay for the period 1 June – 8 September 2023. As such, the Applicant was offered a Hearing to resolve the matter.
- 10 On 10 January 2024, the Applicant requested a Hearing and following subsequent discussion with our Tribunal team the matter now comes before me for a decision on the papers.

### **The law**

- 11 The relevant law is defined in Section 18(3) and can be viewed online at the IPO's website:

The Act: <https://www.gov.uk/guidance/the-patent-act-1977>

Section 18(3) states (my emphasis):

*If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements...*

- 12 The Manual of Patent Practice (MoPP) explains the IPO's practice under the Act and makes helpful references to relevant case law. The Manual can be viewed online at the IPO's website: <https://www.gov.uk/guidance/manual-of-patent-practice-mopp>
- 13 In particular, paragraphs 18.54 and 18.55 are helpful. 18.54 relates to the particular criteria that should be met in deciding whether or not discretion should be exercised favourably to accept a late response but also envisages that the discretion may be exercised in appropriate circumstances even if this criterion is not met:

Paragraph 18.54 states (my emphasis):

*Discretion should be exercised favourably, particularly if; i) the extension period has not been exceeded by more than a de minimis period, and/or, ii) the examiner is satisfied that the failure to respond was unintentional at the time that the specified period expired... However, there is no statutory requirement that the failure to respond must have been unintentional in order for the late response to be accepted, and thus the discretion accorded by s.18(3) may be exercised in appropriate circumstances even if this criterion is not met.*

- 14 Further, 18.55 and 18.56 refer to adequate reasons for exercising that discretion which is peculiar to the particular Applicant or application in suit.

### **Argument and analysis**

- 15 In considering this matter, I note the approach of the Examiner who, in effect, split the relevant time period into two parts by accepting the reasons provided for the delay up to 1 June 2023 and conversely, in not accepting the reasons provided for the period following this date which they considered not to be *de minimis*. While I do not think this approach was necessarily incorrect, I do not propose to follow suit. Rather, and for reasons that will become clear, I will take a more holistic approach. I also acknowledge the arguments provided by the Applicant to explain the delay for the full time period in question.
- 16 Bearing in mind the criteria detailed in paragraph 18.54 quoted above, I am not prima facie persuaded that the arguments from the Applicant are sufficient. However, there are additional factors to consider and as 18.54 notes *discretion accorded by s.18(3) may be exercised in appropriate circumstances even if this criterion is not met*. As outlined above, on 2 August 2023, a telephone conversation took place between the Examiner and the Applicant's Attorney. This was followed up in a response from the Examiner via email the following day. There is no record of the telephone conversation on file, nor is there a copy of the email sent. Rather, there is a brief internal minute referring to both and it is unclear as to whether this minute is an excerpt or a full account. From the facts available, the Examiner appears to have suggested that what was required of the Applicant was a (late) response to the Examination Report, together with a reason for the delay. However,

crucially, it seems that a reply date was not set nor clearly communicated to the Applicant. Rather, the Examiner expressed that “prompt action” was required.

- 17 I acknowledge that the Manual of Patent Practice does not explicitly encompass the particular circumstances encountered here, namely the Applicant telephoning after the response period, to ask in general terms what to do. That said, in having regard to its content, it is my view that a reply date from the Examiner was advisable and should have been communicated to the Applicant as this is analogous to what would ordinarily happen when an extension to a period for response is discussed in advance. Details of any relevant conversations/emails between the agent and the Examiner should also be recorded on the public part of the file<sup>3</sup>. It is not clear from the facts exactly what the Applicant asked on the telephone, nor what was said at the time in reply. It seems that no clear extension to the response period was agreed, nor timescale for a late reply communicated. Arguably the Applicant was placed in a disadvantageous position, or at least a less advantageous position than had the requirements been made explicit and made public as such.
- 18 On balance therefore, and taking all matters in the round, I will give the Applicant the benefit of the doubt, exercising my discretion in their favour and so the request to accept a late response is granted. For the avoidance of doubt, I make no finding as to whether the failure to respond in time was unintentional, and I note that some of the presented reasoning for further delay, namely a holiday commitment, is generally unacceptable<sup>4</sup>. Nonetheless, in the absence of clear facts to the contrary, it seems that both the Examiner and the Applicant had the opportunity to communicate and meet requirements more fully and I am satisfied that the Applicant has not behaved unreasonably in the circumstances.

### **Conclusion**

- 19 The request to accept a late response is granted and the application will be remitted to the Examiner for further processing. The Applicant should note that the compliance period ended on 23 January 2024. However, an as-of-right extension to the compliance period is available to extend this to 23 March 2024. To extend this period, the Applicant is required to request this by filing the relevant form (Form 52) and paying the accompanying fee by this date. The Applicant should also note that a second, discretionary, extension of a further two months upon filing the requisite form and fee would be considered favourably.

### **Appeal**

- 20 Any appeal must be lodged within 28 days after the date of this decision.

Ben Buchanan  
Deputy Director, acting for the Comptroller

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<sup>3</sup> In contemplating a telephone conversation or email exchange discussing an extension beyond the as-of-right-extension to a response period, MoPP 18.53 states, in square brackets: *A concise report of the telephone conversation should always be sent and a copy placed on the open part of the file. A report of an email correspondence need not be sent unless specifically requested or if it is necessary to clarify the reasons for refusing an extension, but a record of the email exchange should be placed on the open part of the file.*

<sup>4</sup> Manual of Patent Practice at paragraph 18.56