



PATENTS ACT 1977

APPLICANT Lucy Rose Limited

ISSUE Whether discretion may be exercised to accept a late response to an examination report for patent application GB2009974.3

HEARING OFFICER Nigel Hanley

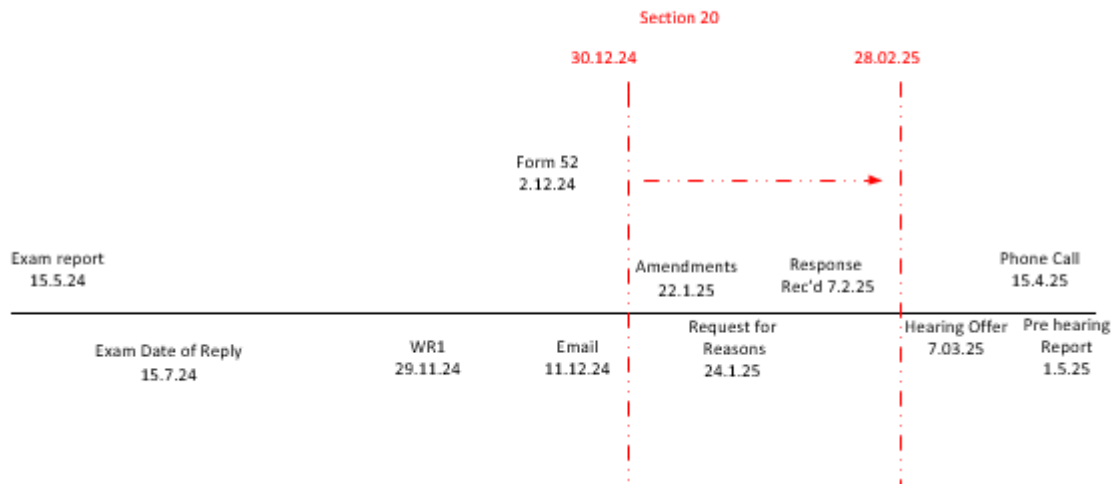
DECISION

Introduction

- 1 This decision relates to whether an amendment filed on 22nd January 2025 can be accepted on GB2009974.3 in the name of Lucy Rose Ltd.
- 2 The issue came before me to decide at a hearing held on 4th June 2025 by MS Teams Video Conference, at which Gareth Scaddan of Spinnaker IP appeared as representative for the applicant. I was assisted by Daniel Voisey.
- 3 For the avoidance of doubt, I have not considered any technical aspect of the claims. The purpose of this hearing is to decide if the amendment should be accepted.

The Course of Events

- 4 I have prepared a timeline to assist in following the order of events:



- 5 An examination report following amendment was issued on 15th May 2024, with a latest date for reply set to 15th July 2024. No reply was received by that date.
- 6 The Section 20 compliance period for the application was 30th December 2024. The office, as it normally does on cases where no amendment has been received, issued a WR1 letter on 29th November 2024 as a reminder that there was one month left on the compliance period. The second paragraph of that letter specifically noted that no amendment had been received.
- 7 A Form 52 was filed on 30th November, which was, because of the provisions of Section 120, given the date of 2nd December 2024. The effect of the Form 52 was to extend the compliance period to 28th February 2025. The Examiner subsequently emailed the applicant on 11th December to highlight that no amendment has been received. In a subsequent phone call with the Examiner on 15th April 2025, Mr Scaddon indicated that he had “no record of receiving the e-mail”.
- 8 An amendment was filed on 22nd January 2025. The Examiner replied on 24th January 2025 to advise that they could only exercise discretion to accept the late response provided an acceptable reason was given. Mr Scaddon replied on 7th February 2025, providing screenshots of the response letter and a File Explorer window dated 12th July 2024, which, he argues, proves he intended to file a response on the 12th July 2025.
- 9 The Examiner was not persuaded that these were sufficient grounds to allow them to exercise discretion to accept the late response, and therefore they offered a hearing, which the attorney accepted.

The Issue to be determined.

- 10 The only issue to be determined is whether I should accept the late filed amendment of 22nd January 2025.
- 11 Guidance on this is provided in the Manual of Patent Practice, specifically in paragraph 18.54, which says (with my emphasis added):

*When a reply is received after the expiry of the specified period and the automatic extension period of two months has passed, the reason, if not already given, should be asked for. If no reason is forthcoming the late response cannot be accepted and a report under s.18(3) should issue informing the applicant that the application will be refused unless observations are forthcoming, or a hearing is requested. Where a reason is provided, the examiner may exercise discretion under s.18(3) to accept the late response, even though no extension to the specified period can be granted. **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.** Point ii) is consistent with the statutory test that applies to requests for reinstatement under s.20A (see 20A.13 to 16) for guidance on the meaning of unintentional). 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.

- 12 Mr Scaddan accepted that there is no question of the period having been exceeded by a *de minimis* period.
- 13 The only situation remaining to be considered is whether I am satisfied that the failure to respond was unintentional at the time when the period expired. It is not enough that the Applicant should afterwards wish that a response had been made in time, in order to continue the application.
- 14 I take as my guide the comments of Mann J in *Matsushita Electric Industrial co v Comptroller* [2008] EWHC 2071 (Pat) who said:

“the Act requires a judgement to be formed by the Comptroller so that he can be satisfied of the relevant matters. A judgement usually has to be made on the basis of evidence... The Evidence required in any particular case where satisfaction is required depends on the nature of the enquiry and nature and purpose of the decision to be made. A significant matter requires significant proof. I repeat the Act does not require a statement that the failure to pay fees was unintentional. It requires the Comptroller to be satisfied of the fact”.

I take this to mean that, on the basis of the evidence presented, I must be satisfied that there was an underlying intention to respond at that time.

- 15 As I have already noted above, Mr Scaddan in his letter of 7th February, provided a screenshot of a copy of the letter (which was actually filed 22nd January 2025), showing a date of 12th July 2024, and with a file properties window showing a created and a modified date of 12th July 2024.
- 16 Mr Scaddan explained that his normal practice is to prepare a response in Word^{RTM}, convert the document to PDF and immediately file the document through the web filing service. He believed that he had done so in this case too. He acknowledged that he did not have a filing receipt and accepted that the attempted filing had evidently not been successful.
- 17 Mr Scaddan was very candid in acknowledging that the response was filed late through a failure in his own processes, and that the responsibility for not having realised this sooner was his own. Mr Scaddon also made clear that he had overlooked the reminder in the WR1 letter as he was expecting an intention to grant letter. Equally, as the filing of the Form 52 was to extend the compliance period for filing divisional applications, he overlooked the issue of the outstanding amendment.
- 18 I note that paragraph 18.57 of the Manual of Patent Practice, emphasises that it is the responsibility of the Applicant to respond to the Examiner’s report, indicates that:

...It may also be an adequate reason if it is established on the evidence filed that the failure to take appropriate action was due to the fault of the agent.

- 19 It is perhaps pertinent to note at this point that the test here is satisfaction that there was an underlying intention, not a demonstration of due diligence. I am content in this specific instance to accept that there was a procedural error on the part of the attorney, as evidenced by the screenshot of the dated letter and dated file properties window.
- 20 The Examiner was correct to refer the matter for a hearing. Having considered the matter, I am satisfied that the failure to respond was unintentional at the time that the period expired.

Conclusion

- 21 Having accepted that the Applicant's intention at the conclusion of the response period was to respond in time, I conclude that discretion may be exercised to accept the late filed response.
- 22 I therefore remit the application to the Examiner for examination of the amended application.

The Compliance Period

- 23 I now turn to the issue of the compliance period under Section 20 of the Act.
- 24 The compliance period of the application has been extended to 28th February 2025. In the absence of a further Form 52, there is no further opportunity to amend the claims. The claims to be considered by the Examiner are those on file as at the end of the compliance period (*i.e.* those filed on 22nd January 2025). It remains the case, that if the application is not considered in order with the claims as filed then the application will be treated as refused under section 20(1).

Appeal

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

NIGEL HANLEY

Patent Examination Group Head