



PATENTS ACT 1977

APPLICANT	Windward Ltd
ISSUE	Whether the time limit for putting GB2108001.5 in order for grant can be extended under rule 107 or 111
HEARING OFFICER	Ms J Pullen

DECISION

Background

- 1 This decision relates to GB application 2108001.5, which was filed by Hutchinson IP, on behalf of Windward Ltd, on 4th June 2021. It is linked to section 89 application PCT/IL2019/050221 and has a compliance date of 5th June 2023. It was published as GB2593639A on 29th September 2021.
- 2 The first examination report under section 18(3) was issued on 27th May 2022 with a latest date for response set as 27th September 2022. A response to the examination report was filed on 25 August 2022.
- 3 A second examination report under section 18(3) was issued on 20th October 2022, with a latest date for response set as 20th December 2022. Correspondence from Hutchinson IP was filed on 27th March 2023, requesting an extension of time in relation to the exam report of 20th October 2022. The reason given was non-receipt of instructions from the applicant's overseas representatives. A response to the examination report was also filed on 27th March 2023.
- 4 The examiner responded on 16th May 2023, explaining that while he was not able to grant the extension of time, as it was filed outside the two months following the latest date for response of his examination report, he could extend comptroller's discretion to accept a late response if evidence was provided to support the unintentionality of the late response. The date set by the examiner by which the evidence should be filed was 22nd May 2023. No response was received, and the examiner issued a second request for evidence on 31st October 2023 giving a latest date for response of 30th November 2023.
- 5 As no response to the second request for evidence was received and the compliance date had passed, a letter of refusal under section 20(1) was issued on 13th December 2023.

- 6 On 27th January 2025 correspondence was filed by the attorney, Mr Hutchinson of Hutchinson IP, stating that the three pieces of correspondence from the IPO dated 16th May 2023, 31st October 2023 and 13th December 2023 had not been received. Mr Hutchinson stated it was only after the applicant's overseas representatives alerted him that the documents were available on the online IPSUM tool that he became aware that he had missed the deadlines.
- 7 Mr Hutchinson also filed a request for reinstatement on 27th January 2025. The request was refused as it was filed more than 12 months after the compliance date and this period is not extendable under rule 108. Following this refusal, Mr Hutchinson made a request to be heard in relation to admissibility of the response to the examination report as well as the request for reinstatement of the application.

The case came before me at a hearing on 22nd May 2025. Mr Hutchinson attended on behalf of the applicant, and I was assisted by Operations Manager, Mrs Ceri Munro. As a number of matters were raised at the hearing for the first time, Mr Hutchinson was given two weeks from the date of the hearing to file any further submissions.

The Law

- 8 The most relevant sections of the Patent Act 1977¹ ('the Act') are set out below:

Section 18(3)

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 (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

Section 20(1)

If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.

Section 20A(1)

Subsection (2) below applies where an application for a patent is refused, or is treated as having been refused or withdrawn, as a direct consequence of a failure by the applicant to comply with a requirement of this Act or rules within a period which is

- (a) set out in this Act or rules, or*
- (b) specified by the comptroller.*

Section 20A(2)

Subject to subsection (3) below, the comptroller shall reinstate the application if, and only if -

- (a) the applicant has requested him to do so,*

¹ [The Patents Act 1977 - GOV.UK](https://www.gov.uk/government/legislation/the-patents-act-1977)

- (b) the request complies with the relevant requirements of rules; and
- (c) he is satisfied that the failure to comply referred to in subsection (1) above was unintentional.

Section 20A(3)

The comptroller shall not reinstate the application if -

- (a) an extension remains available under this Act or rules for the period referred to in subsection (1) above; or
- (b) the period referred to in subsection (1) above is set out or specified -
 - (i) in relation to any proceedings before the comptroller;
 - (ii) for the purposes of section 5(2A)(b) above; or
 - (iii) for the purposes for a request under this section or section 117B below.

- 9 Rules² 107 and 111, relating to the correction of irregularities and delays in communications services respectively, are set out below:

Correction of irregularities

107.— (1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2) Any rectification made under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

- (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and
- (b) it appears to the comptroller that the irregularity should be rectified

Delays in communication services

111.— (1) The comptroller shall extend any period of time specified in the Act or these Rules where he is satisfied that the failure to do something under the Act or these Rules was wholly or mainly attributable to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the comptroller may direct.

(3) In this rule “communication service” means a service by which documents may be sent and delivered and includes post, electronic communications, and courier.

- 10 There is no dispute concerning the relevant law and its application to the facts of this case.

² [The Patents Rules and Fees Rules 2007](#)

Argument and analysis

- 11 In his correspondence from January 2025 to date, at the hearing, and in the subsequent submissions Mr Hutchinson's arguments are focussed on what he considers to be the examiner's error in the exercise of comptroller's discretion and missing correspondence.
- 12 At the hearing Mr Hutchinson described how the application progressed as expected until the non-receipt of three items of correspondence from the IPO, namely those dated 16th May 2023, 31st October 2023 and 13th December 2023. These pieces of correspondence only came to light after the applicant's overseas counterpart informed Mr Hutchinson that they were available on IPSUM; this is the reason given for the late response.
- 13 Mr Hutchinson argued that if the filing of the late response, on 27th March 2023, had been allowed by the examiner then the application would have been in order and progressed to grant. He maintained at the hearing, and throughout his correspondence, that the veracity of his statement of unintentionality should not be called into question and should have been sufficient for the examiner to extend discretion. I shall address this matter first.
- 14 The examiner refused the request, made on 27th March 2023, for a discretionary extension of time beyond the two month as-of-right extension to the response date of the examination report dated 20th October 2022, as no two month as-of-right extension of time under section 117B(4) had been requested. The examiner offered to extend comptroller's discretion to accept a late filed response if evidence as to the unintentionality of the late filing was provided. As it was mentioned in the attorney's letter of 27th March 2023 that it was the emails from the overseas agent that demonstrated unintentionality, the examiner asked for these emails to be provided as evidence.
- 15 The examiner's request for evidence is based on precedent case *Matsushita Electric Industrial Co. v Comptroller General of Patents*³ ('Matsushita').
- 16 Mr Hutchinson was made aware of *Matsushita* at the hearing and in particular to Mr Justice Mann's guidance that:

"...the Act requires a judgment to be formed by the Comptroller so that he can be satisfied of the relevant matters. A judgment 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 the 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 that fact."

Mr Hutchinson was given two weeks from the date of the hearing to file any further submissions.

³ *Matsushita Electric Industrial Co. v Comptroller General of Patents* [2008] EWHC 2071 (Pat)

- 17 In his submissions of 11th June 2025 Mr Hutchinson attempts to draw distinctions between the facts of this case and Matsushita. He contends that the first distinction is his explanation in his letter of 27th March 2023 as to why the response was unintentionally late compared to the *'bald assertion'* of unintentionality given in Matsushita. He suggests the *'Examiner's request for additional "evidence" was moot- unless the bona fide and/or veracity of the 27th March 2023 letter was in doubt'*. The veracity of Mr Hutchinson's statement is not in question, however, on this point I do not believe the examiner has erred in making a request for the emails to be submitted as evidence. The essence of Mr Justice Mann's guidance in Matsushita is that is not for the comptroller to be told what evidence should be satisfactory for discretion to be extended, which is exactly what Mr Hutchinson appears to be doing in his most recent submissions by asserting *'all of the information needed for the comptroller to be "satisfied"...was present.'*
- 18 The second distinction Mr Hutchinson identifies is that in Matsushita the agent 'took a stand' and refused to provide evidence, whereas Mr Hutchinson states he did not provide evidence as he did not receive the request for evidence (amongst other correspondence). At this point I note that Mr Hutchinson provided the requested emails once he was made aware of the request and has not refused to do so. I do not believe this point in itself is pertinent to the exercise of Comptrollers discretion but does bring me on to the matter of missing correspondence.
- 19 From the documents on file relating to this case it appears that up until May 2022 there was no issue with receipt of correspondence from the IPO and Hutchinson IP was diligent in responding. Prior to the hearing I made internal enquiries to confirm the correct contact details were on file and that email correspondence relating to this application had been sent to the correct address for service. I was informed that while we had received Mr Hutchinson's 'out of office' notifications, there were no 'failure to deliver' notifications received. As a result, I am satisfied that the IPO has, at the very least, sent correspondence to the correct address, and the IPO had no reason to consider an alternative means of contacting the applicant as has been suggested by Mr Hutchinson. I can find no reason here to invoke rule 107 to correct an office irregularity.
- 20 The IPO's positive confirmation of sending the correspondence does not of course mean that Hutchinson IP received it. Therefore, I shall consider whether there is recourse under rule 111 if the reason for the late response lies wholly or mainly as a result of a failure of a communication service.
- 21 Mr Hutchinson stated at the hearing that a check on his email system identified multiple pieces of correspondence had not been received. In an email exchange with the Mr Andrew Cressy of the IPO between 20-25th March 2025, Mr Hutchinson sent a screen shot from Microsoft Power Automate which he alleges demonstrates that emails from the IPO were never delivered. I do not believe that this screen shot is conclusive evidence that the emails were never received at all. The screen shot may show that the emails were never delivered, but equally it may also show that the emails simply did not progress through the system to Mr Hutchinson's inbox, that they were for instance held in a spam folder or some similar quarantine.
- 22 In his submissions following the hearing Mr Hutchinson directs me to decide between *'the e-mail never having been received and that being the main reason why*

the evidence request in 16th May 2023 e-mail was not filed as we say; versus whether the e-mail was received, but not acted upon, as the UKIPO says. I don't believe there has been a suggestion that Mr Hutchinson intentionally chose not to act upon the email, but I also don't believe it is simply a case of deciding which situation is most likely.

- 23 At the hearing Mr Hutchinson was asked about the monitoring processes used in his office. Mr Hutchinson confirmed he used a computer system (Equinox), used by many patent firms, which created a reminder list to be worked through of both fatal and non-fatal deadlines relating to applications. At the compliance date of the application at hand he noted that he was waiting for a response from the IPO; in his words *'we we're just waiting for the Patent Office to come back to us'*. Therefore, he took no action to make enquiries with the IPO as to the progress of this application.
- 24 While I would not expect Mr Hutchinson to be routinely checking IPSUM in case correspondence had been missed, as I believe was suggested to him, I think it is entirely reasonable to expect him to check at key points, such as the compliance date, particularly when his own systems have provided a reminder.
- 25 Mr Hutchinson brought my attention to BL O/365/4 (sic. 14?) prior to the hearing. He notes a similar failure of the delivery system and that a response to the examination report was on file before the compliance date and, as such could be given discretion to be retrospectively considered as in BL O/0359/23 and BL O/0483/23.
- 26 I don't believe the facts of this office decision are sufficiently in line with the facts of this case. In the office decision the unrepresented applicant contacted to the IPO to enquire about the progress of his application after waiting a few months for a response from the office. He was told there were backlogs and it might take some time for a response to be issued, so he did not expect to have a response within a month of the call. The applicant did not note the compliance date so did not make enquiries at this critical deadline. It was on this basis that the hearing officer found the failure to respond wholly attributable to a failure in the communication service.
- 27 I do not believe that the late filing of the requested evidence or the late filing of the request for reinstatement was wholly or mainly due to the failure of the communication service between the IPO and Hutchinson IP between March and December 2023. I believe a significant part was played by the Mr Hutchinson's assumption that the IPO simply hadn't gotten around to responding and the lack of due diligence in not following up on the notification of a deadline generated by his administrative system. Similar to that discussed in *Daihatsu Motor Co Ltd*⁴ (para 57), it is my opinion that a significant contributing factor, but not whole reason for the failure to reply on time, was the lack of systematic rigour in the attorney's office.
- 28 In the submissions filed following the hearing Mr Hutchinson refers to an 'IT report' in my possession which he was made aware of at the hearing. The relevance of the information sought has been covered in paragraph 11 above. I gave Mr Hutchinson a verbal commentary of the information at the hearing and I believed we were in general agreement that it proved the correspondence was sent by the IPO but it did not prove receipt by Hutchinson IP. In his submissions Mr Hutchinson refers to

⁴ BL O/234/14

section 3.34 of the Patents Hearings Manual, which relates to inter parties hearings, so in itself is not binding in this situation, but the general principle of admitting evidence at the hearing is relevant. Mr Hutchinson was not put at a disadvantage as he was given the opportunity to file submissions following the hearing.

Conclusion

- 29 Having reviewed the information before me I cannot identify any irregularity in procedure connected with any proceedings or other matter before the comptroller, an examiner or the IPO. Also, I cannot conclude that the late filing of the request for reinstatement was wholly or mainly attributable to a failure in the communication service.
- 30 The application remains terminated due to refusal under section 18(3).

Appeal

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

Joanne Pullen
Deputy Director, acting for the Comptroller