



## PATENTS ACT 1977

APPLICANT	Response Design and Development Ltd
ISSUE	Whether the period for requesting reinstatement of patent application GB2117637.5 can be extended using rule 107
HEARING OFFICER	Nick Smith

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### DECISION

#### Background

- 1 This decision concerns whether the period for requesting reinstatement of patent application GB2117637.5 can be extended under rule 107(3) of the Patents Rules 2007 (“the Rules”).
- 2 The application GB2117637.5, titled “Mollusc Barrier”, was filed on 7 December 2021 in the name of Response Design and Development Ltd. The application was subsequently published on 14 June 2023 as GB2613585.
- 3 The request for substantive examination, i.e. a Patents Form 10 (“PF10”) and associated fee, was due on 14 December 2023 (6 months after publication, pursuant to rule 28(2)). The PF10 was not filed by that date and no extension request was made during the two-month period for extending the time limit under rule 108(2). The application was subsequently terminated with effect from 15 December 2023.
- 4 The applicant’s attorney firm, N. J. Akers & Co, contacted the Office by telephone on 13 March 2025, noting that the application had been terminated contrary to the applicant’s intentions. The patent examiner for the application explained the reasons for this and advised that the deadline for requesting reinstatement had passed, following up with a telephone report on 14 March 2025 to confirm that reinstatement was no longer possible.
- 5 The applicant’s attorney nevertheless filed a request for reinstatement on Patents Form 14 (“PF14”) on 18 March 2025, more than three months after the 12-month period for requesting reinstatement under rule 32(2) ended. They also requested that the Comptroller exercise his discretion under rule 107(3) to rectify an irregularity of procedure by extending the period for requesting reinstatement under rule 32(2).
- 6 The applicant was informed, in an official letter dated 4 May 2025, that the request to reinstate the application had been refused due to the time period under rule 32(2)

having expired. They were also informed in that letter that the request to extend the period provided by rule 32(2) using rule 107(3) had been refused.

- 7 The applicant's attorney filed further arguments in a letter dated 21 May 2025, but those arguments were not persuasive and an official letter issued on 29 May 2025, providing further reasons why the request under rule 107(3) could not be accepted. A request for a hearing was subsequently filed on 3 June 2025.
- 8 This matter was presented before me at a hearing on 8 July 2025, with Mr Noel Akers and Mr Guy Cooper of N. J. Akers & Co appearing on behalf of the applicant. In making this decision, I have carefully considered the evidence presented at the hearing and the correspondence on file in relation to this matter, including skeleton arguments filed on 4 July 2025 for which I am grateful.

### **The Law**

- 9 Rule 28 of the Rules defines the requirements for requesting a substantive examination of a patent application, including the period in which a request must be made:

*28.- (1) A request under section 18 for a substantive examination of an application must be made on Patents Form 10.*

*(2) Subject to sections (3) and (4) and Rules 60 and 68(4), the period prescribed for the purposes of section 18(1) is six months beginning immediately after the date the application was published.*

- 10 Section 18 of the Patents Act 1977 ("the Act") stipulates that the application shall be treated as withdrawn if the substantive examination request is not filed in time:

*18.- (1) ... and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period.*

- 11 Section 20A of the Act provides for reinstatement of an application which has been, *inter alia*, treated as withdrawn:

*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.*

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

*(a) the applicant requests him to do so;*

*(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.*

- 12 Rule 32 of the Rules defines the period for requesting reinstatement of an application:

*32.- (1) A request under section 20A for the reinstatement of an application must be made before the end of the relevant period.*

*(2) For this purpose the relevant period is twelve months beginning immediately after the date on which the application was terminated.*

- 13 Rule 107 of the Rules allows for a period of time (including the period for requesting reinstatement)<sup>1</sup> to be extended to rectify an irregularity of procedure:

*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) ...*

*(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 section (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.*

### **Issue to be decided**

- 14 The issue to be decided is whether rule 107 can be exercised to extend the period for requesting reinstatement. I will stress that it is the period for requesting reinstatement which is the subject of the request under rule 107. There is no suggestion by the attorney that the initial failure to file the substantive examination request was due to any irregularity of procedure on the part of the Office.
- 15 I note that the skeleton arguments also include submissions concerning the reinstatement request itself, along with a request for the proceedings to continue in writing if the Comptroller is minded to refuse the request for reinstatement. However, the substance of the reinstatement request has not yet been considered by a case officer, and the PF14 fee was refunded on 29 May 2025, which would effectively render that request null and void. Therefore, if I were to allow the period for requesting reinstatement to be extended under rule 107, I would also need to provide a further period for the PF14 fee to be repaid, so that the reinstatement

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<sup>1</sup> Rule 32(2) is listed in Part 1 of Schedule 4 to the Rules.

request could be considered by a case officer. This decision therefore does not consider the substance of the reinstatement request itself.

### **Arguments and analysis**

16 Paragraph 123.10.01 of the Manual of Patent Practice (“the MoPP”) states:

*“Rule 107 may be used to rectify an irregularity where that irregularity was attributable, at least in part, to a reasonable expectation created by well-established practice”.*

17 Mr Akers agreed that this is the test by which I should determine whether or not there has been an irregularity made by the Office.

18 The alleged irregularity in this case is the failure by the Office to advise the applicant of the reinstatement process once the application had been treated as withdrawn for failure to file PF10. This, Mr Akers submits, is something that the Office had an obligation to do according to paragraph 10.19 of the Patents Formalities Manual (“the PFM”).

19 In my view, there are three key factors to be considered, which I will address in turn before determining whether or not an irregularity has occurred:

- (i) The Office’s actual practice following a failure to file PF10
- (ii) The proper interpretation of paragraph 10.19 of the PFM
- (iii) The reliability of the PFM in reflecting current practice

#### *The Office’s actual practice following a failure to file PF10*

20 The Office’s position, outlined in its official letter dated 4 May 2025, is that it does not by default advise of the reinstatement process when an application has been treated as withdrawn for failing to meet a prescribed period (such as the period for filing PF10). This position was reiterated in the official letter dated 29 May 2025, which also noted that this practice had been confirmed in a Practice Notice published on 24 June 2014.<sup>2</sup> While that Practice Notice was concerned with the cessation of issuing PF10 reminder letters, it also made clear that no further correspondence from the Office would be issued in the event that the deadline was missed:

#### **4. What if the Form 10 deadline is missed?**

*Practice regarding extensions to the period for requesting substantive examination will not be altered by the removal of the reminder letter. It will remain possible to file a request for examination up to two months after the end of the prescribed period by filing a Patents Form 52 and fee to request an extension under Rule 108(2).*

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<sup>2</sup> <https://www.gov.uk/government/publications/practice-notice-ceasing-of-patents-form-10-reminder-letter/practice-notice-ceasing-of-patents-form-10-reminder-letter>

*However if the (extended) deadline for filing Form 10 is missed the application will be treated as withdrawn. No further correspondence from the office will be issued.*

*Where a failure to request substantive examination within the prescribed period was unintentional and that failure led to the application being treated as withdrawn, it will continue to be possible to reinstate the patent application under section 20A, where the necessary conditions are met.*

(Emphasis added)

- 21 Prior to the issue of the Practice Notice, Office practice was to issue a PF10 reminder letter 2-3 weeks before the relevant deadline. I can find no evidence, however, that it has ever been the Office's practice to issue reminders of reinstatement procedures routinely.
- 22 Mr Akers noted that the non-filing of PF10 in this case was unusual for them, as they generally advise their clients to file a search request and examination request at the same time. Therefore, they had little to no experience of procedures followed in the event of a missed PF10 deadline. Mr Akers did however acknowledge that they had no direct experience of ever having received such a reminder.
- 23 Taking everything into account, I am satisfied that, in general, the Office's current and longstanding practice is not to issue any correspondence once an application has been treated as withdrawn due to a failure to file PF10 by the relevant deadline.

*The proper interpretation of paragraph 10.19 of the PFM*

- 24 Since I have determined that the Office's practice is not to issue further correspondence in the circumstances outlined above, it is necessary to determine the intended meaning of paragraph 10.19 of the PFM, which is key to the applicant's case. Paragraph 10.19 states:

*"If more than two months has elapsed after the time limit has expired without any extension request being made then the application is treated as withdrawn and the applicant should be advised of the reinstatement process."*
- 25 Mr Akers argues that paragraph 10.19 can only be interpreted to mean that if more than two months have passed since the expiry of the period for filing PF10 (for example) then the Office should advise the applicant of the reinstatement process.
- 26 The Office's position, outlined in its official letter dated 4 May 2025, is that paragraph 10.19 "is limited to advising an applicant of reinstatement if they get in contact with the Office and more than two months has elapsed after the time limit has expired without any extension request being made". The letter goes on to suggest that this practice was effectively carried out when the attorney firm contacted the Office on 13 March 2025 and was informed that the period for requesting reinstatement had expired.
- 27 The applicant's position, outlined in their skeleton arguments and reiterated at the hearing, is that there is nothing in paragraph 10.19 that indicates that this practice is only followed if the applicant contacts the Office. Rather, they submit, the paragraph

simply states that the applicant should be advised of the reinstatement process, and attaches no condition to this action.

- 28 While I can understand that a plain reading of paragraph 10.19 in isolation may be interpreted this way, it is important to read the paragraph in context. Chapter 10 of the PFM covers extensions of time periods under rule 108 and rule 109. Paragraph 10.19 is part of a section (paragraphs 10.15-10.19) headed “Parts 2 and 3”, which details the requirements for extensions of time periods listed in parts 2 and 3 of Schedule 4 of the Rules – those periods that can be extended in two-month tranches using Patents Form 52 (PF52). Read in this wider context, it seems reasonable to interpret 10.19 as describing practice to be followed only when the applicant has engaged with the Office regarding extensions of time using PF52, but is out of time.
- 29 Mr Akers’ interpretation is that paragraphs 10.15-10.18 do indeed cover practice regarding extensions using PF52, but that paragraph 10.19 concerns the situation where, despite opportunities to file PF52, the applicant has failed to do so. Mr Akers believes that paragraph 10.19 sets out the practice to be followed in these circumstances regardless of any contact by the applicant. To be effective, he argues, the applicant must be informed promptly after the expiry of the two-month period, and certainly prior to the deadline under rule 32(2) for requesting reinstatement. Therefore, the telephone discussion on 13 March 2025 cannot be interpreted as fulfilling the practice outlined in 10.19.
- 30 Regarding this latter point, I am inclined to agree that both the telephone discussion of 13 March 2025 and the subsequent telephone report fall outside of the scope of paragraph 10.19. Whether or not paragraph 10.19 is limited to situations where the applicant contacts the Office, I believe it is intended to cover situations where reinstatement is still a possibility. The discussion and subsequent report informed the applicant that reinstatement was no longer an option, rather than advising them of the process as such.
- 31 At the hearing, I sought views on other paragraphs of the PFM which cover practice in relation to the situation where a PF10 has not been filed, and which appear to be silent on communications to the applicant in these circumstances:

(i) Paragraph 11.25:

*“Cases without a Form 10 require no action apart from a post-pub check. See Chapter 9*

*“If the Form 10 is not received or the correct fees have not been paid (excess description pages), the application will have been taken to be withdrawn.”*

(ii) Paragraph 11.30:

Day	Cases without action	Action required
...	...	...
Tuesday	Form 10 More than 6 months after A Pub	Run F10R Time Limit report (POLS). Terminate (see 11.48)
...	...	...

(iii) Paragraph 11.48:

*“Each Tuesday, Formalities produce a POLS picklist report of cases without a Form 10 (and fee). This lists the cases that are to be terminated because a Form 10 has not been filed within the r.28(2) period. The cases are then terminated on COPS using REC PRO.”*

32 Mr Akers suggested that Chapter 11 relates to internal management and record keeping, while it is the domain of Chapter 10 to cover what to communicate to the applicant, hence why Chapter 11 does not refer to the issuing of any warnings. He felt, therefore, that there was no inconsistency between these paragraphs and his interpretation of paragraph 10.19.

33 Mr Cooper added that paragraph 11.25 refers out to Chapter 9 if a PF10 is not received, noting paragraph 9.02 in particular:

*“If a case does not have a Form 10 filed when it is returned from publication, the applicant has 6 months from the date of publication during which to file the form. The filing period for the Form 10 can be extended for 2 months under r.108(2). Further extensions under r.108(3) may be possible and details of procedures relating to this can be found at chapter 10.”*

34 He highlighted that Chapter 9 in turn refers to chapter 10, which brings the reader back to 10.19. He suggested, therefore, that case officers following the guidance through to its conclusion will arrive at the practice described by 10.19.

35 Noting that Chapter 11 of the PFM does in fact refer to warning letters being issued in certain circumstances, I suggested that the absence of any reference to issuing warnings where PF10 is not filed could imply that it is simply not Office practice to do so. Mr Akers accepted that there were indeed some references in this chapter to

communicating with applicants, and highlighted one such instance being paragraph 11.36:

*“If any outstanding items are filed more than 2 months after the time period for filing them has elapsed the applicant should be advised of the reinstatement procedure (see chapter 10). If any irregularities are noticed these should be referred to the Casework Lead.”*

- 36 In Mr Akers' view this highlights a consistency of practice regarding advising the applicant of opportunities for reinstatement, reinforcing his interpretation of the practice described by paragraph 10.19. When I noted that paragraph 11.36 includes an important qualifier that means it only applies if any outstanding items are filed late, Mr Akers acknowledged this, and said that where such items are not filed we should instead look to paragraph 10.19.
- 37 I am not persuaded that paragraph 11.36 reinforces the interpretation of paragraph 10.19 put forward by Mr Akers. On the contrary, in my view paragraph 11.36 provides weight to the interpretation of 10.19 that reminders of the reinstatement process should only issue when the applicant has engaged with the Office in some way.
- 38 This interpretation is further reinforced by paragraph 11.25, which clearly indicates that for cases without a PF10, no action is required other than a post-publication check, implying that no correspondence will be sent to the applicant by default, about reinstatement or anything else. It also aligns with paragraphs 11.30 and 11.48, both of which state that applications on which no PF10 has been filed in time should be terminated, with no mention of informing the applicant.
- 39 I also sought views at the hearing on the relevance of paragraph 18.02 of the MoPP, which deals with termination of applications on which no PF10 has been filed, and is also silent about any communication to the applicant in this respect. The official letter dated 29 May 2025 suggested that this reinforced the view that no further correspondence is issued in these circumstances.
- 40 The position set out in the skeleton arguments is that the MoPP is simply neutral on this matter since it is a formal matter and so it is the PFM which is to be relied upon. At the hearing, Mr Akers acknowledged that there was some overlap between the two manuals, but maintained that the focus of each manual was different, and that detail of formalities practice would be the realm of the PFM. He suggested that where the final square-bracketed sentence of MoPP 18.02 states that the application should be passed to the relevant Formalities Manager to confirm termination, at that point they would be guided by the detailed instructions set out in the PFM.
- 41 I find some merit in this argument. While some passages of the MoPP describe in detail the steps to be taken by Formalities officers, if they covered every such action then there would be little need for a separate PFM. I am inclined to agree, therefore, that the MoPP is simply neutral on this matter, and does not confirm one way or the other whether the applicant should be informed of the reinstatement process upon termination of their application.

42 Returning to the PFM, I can understand the attorney’s interpretation of paragraph 10.19 when taken in isolation. However, when considering the context provided by the section in which paragraph 10.19 sits and the other paragraphs of the PFM discussed above, on balance I think the most reasonable interpretation is that the Office informs applicants of the reinstatement process only if the applicant has engaged with the Office in some way – either by filing documents out of time or requesting an extension of time when one is no longer available.

*The reliability of the PFM in reflecting current practice*

43 Another consideration is to what extent guidance in the PFM can be relied upon to reflect current practice.

44 The Office’s position, set out in the official letter dated 29 May 2025, is that the PFM is a guide for Formalities staff and should not be relied upon as the “ultimate authority on practice”. The letter highlights the following paragraph from the summary of the PFM:

*“Statements made in the Manual are not in themselves an authority for any action by the IPO and should not be used as a set of legal requirements. The Patents Act 1977 and the Patents Rules 2007 are the ultimate authority on practice.”*

45 The position submitted by the applicant’s attorney is that, while the legal authority is of course provided by the Act and Rules, it is for the Office to decide how to implement those provisions in practice. They submit that it is reasonable and appropriate for the public and patent practitioners to rely on the PFM for details of formalities practice, highlighting two particular passages from its summary:

*“The purpose of this manual is to provide detailed, up-to-date guidelines as to the practice and procedures to be followed in the various aspects of the formalities examination of patent applications in accordance with the Patents Act 1977 and the Patents Rules 2007.”*

...

*“The manual will be updated when necessary to reflect changes in legislation or practice.”*

46 Mr Akers suggested that the PFM and the MoPP were on an equal footing, setting out different aspects of practice in implementing the Act and Rules. Mr Akers also noted the update history of the PFM<sup>3</sup>, suggesting that it had been updated regularly – most recently in January 2025, with Chapter 10 last having been updated in July 2020. Therefore, he argued, applicants were entitled to assume that current practice was that set out in the PFM, rather than that set out in the Practice Notice of 2014.

47 I do not think the PFM can be distinguished from the MoPP on the basis of the disclaimer recited in the official letter of 29 May 2025, since the summary of the MoPP contains a very similar disclaimer.<sup>4</sup> On the other hand, the summary of the

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<sup>3</sup> <https://www.gov.uk/guidance/formalities-manual-online-version/updates>

<sup>4</sup> [https://www.gov.uk/guidance/manual-of-patent-practice-the MoPP](https://www.gov.uk/guidance/manual-of-patent-practice-the-MoPP)

PFM does make clear that it is “*intended primarily for staff... for use as desk instructions*”, and it is clear from its update history that it is not updated as routinely as the MoPP, which benefits from quarterly updates. I would therefore urge some caution in treating the PFM as providing the same authority as the MoPP.

- 48 However, I do not think the overall reliability of the PFM is material to my decision, because – as I have outlined above – I believe the guidance relevant to this case is both up-to-date and consistent with the MoPP.

*Has there been an irregularity of procedure?*

- 49 I am satisfied that the Office followed its current and longstanding practice by not informing the applicant of the reinstatement process in this case, so there has been no procedural irregularity in that regard. The question therefore turns on the role of guidance in defining established practice.

- 50 The skeleton arguments rely on three main authorities to support the applicant’s position that there has been an irregularity of procedure:

(i) *M’s Application*<sup>5</sup>

(ii) *Mills’ Application*<sup>6</sup>

(iii) *Furuno Electric Company Limited’s Application*<sup>7</sup>

- 51 Mr Akers did not advance any further arguments in respect of *M’s Application* or *Mills’ Application* during the hearing, but we agreed that they remained relevant and I will return to the first of these later. In *Furuno*, the Hearing Officer held (at paragraph 27) that “*one can generally look to the Manual [of Patent Practice] or well-established Office practice to determine if a procedural irregularity has occurred*”. While *Furuno* was concerned with guidance on substantive matters in the MoPP, Mr Akers submitted that the same reasoning should also apply to the PFM, which is fundamentally a procedural guide. I have expressed some caution above in treating the PFM to be quite as authoritative as the MoPP, but nevertheless, I do agree that guidance in the PFM is relevant to determining if a procedural irregularity has occurred.

- 52 However, I think it is important to note that the guidance found in both manuals is intended to reflect, rather than dictate, Office practice. This is illustrated by the opening line of the summary of the PFM, which states that it “*explains the Intellectual Property Office’s formalities examination practice under the Patents Act 1977*” (emphasis added). An action by the Office which appears to depart from the wording of the guidance certainly warrants further investigation, but ultimately it is the established practice itself which is most relevant to determining if a procedural irregularity has occurred. This is important because – as we have seen in this case – it may be possible for guidance to be interpreted differently to its intended meaning.

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<sup>5</sup> [1985] RPC 249

<sup>6</sup> [1985] RPC 339

<sup>7</sup> BL O/208/10

- 53 Mr Akers agreed that established practice was relevant to determining whether a procedural irregularity had occurred. However, he was keen to stress that customers who do not routinely engage with a particular practice would need to place a greater reliance on accurate and up-to-date guidance, highlighting again that his firm does not usually file the PF10 separately to the PF9. He suggested that, if the PFM does not truly reflect current practice, either because it is out-of-date or does not tell the whole story, then the public is being misled as to the Office's established practice, and that in itself is an irregularity which should be corrected.
- 54 I am sympathetic to the fact that attorneys will have varying experience depending on their particular ways of operating. However, I do not think individual experience can be a factor in determining what is "well-established practice", because such practice should apply equally to everyone. Furthermore, I do not believe there is any irregularity concerning the guidance provided in the PFM, since I have found it to be consistent with current practice.
- 55 Even if the guidance was deficient, as noted above, for rule 107 to apply the irregularity must be "*attributable, at least in part, to a reasonable expectation created by well-established practice*" (emphasis added). Furthermore, in *M's Application* the Court of Appeal held that the applicant must show that "*the error, default or omission, although not necessarily the sole cause, was at least a partial cause of the irregularity in the sense of having actively brought it about*".
- 56 Mr Akers explained at the hearing that, had a communication been received following termination of the application, it would have prompted his office into requesting reinstatement. That may well be the case, but I do not think it follows that his office had developed a reasonable expectation, based on either the guidance in the PFM or direct experience, that the Office's established practice was to send such reminders. Neither am I persuaded that their interpretation of the guidance played an active part in them missing the deadline for requesting reinstatement by leading them to believe that they would receive a communication in these circumstances.
- 57 Therefore, I can find no evidence that either of the conditions highlighted in paragraph 55 above have been met, so there is no basis for using rule 107(3).

### **Conclusion**

- 58 I can identify no irregularity of procedure and I conclude that there is no basis for exercising discretion under rule 107(3) to extend the period for requesting reinstatement under rule 32(2).

### **Appeal**

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

**NICK SMITH**

Head of Legal Section, acting for the Comptroller