

16 March 2015.

PATENTS ACT 1977

APPLICANT	Peter Robert Goodall
ISSUE	Whether to allow a late response to an examination report under section 18(3) for patent application number GB1012359.4
HEARING OFFICER	Dr Stephen Brown

DECISION

Introduction

- 1 Patent application GB1012359.4 entitled "Invention 6.5.10" was filed in the name of Peter Robert Goodall (the applicant) on 23 July 2010. The application was published as GB2482181 on 25 January 2012. The application was searched and examined and an examination report issued on 25 January 2011. The report raised a number of substantive issues requiring significant amendment to overcome. A latest date for response to this report was set as 23 July 2012.
- 2 On 10 December 2014 a letter was sent to the applicant warning him that the application would shortly be refused under section 20(1) of the Patents Act 1977 (The Act) as the compliance date, 23 January 2015, was near. The applicant replied on 24 December 2014 requesting that he be allowed to file a late response and outlining why he had not responded earlier.
- 3 The examiner, Mr David Harness, refused this request and repeated requests to the same end from the applicant in further letters of 15 January 2015, 23 January 2015 and on the telephone on 19 January 2015. While the examiner accepted that the applicant was unable to respond around the time the specified period expired he took the view that the reasons given by the applicant do not adequately explain the lack of response between the response date and 24 December 2014.
- 4 A Hearing was thus held via video conference on 23 February 2015 to resolve this issue. In the run up to the hearing, the applicant provided additional written details of his circumstances in signed letters dated 10, 16, 18 and 19 of February. I have considered the details of all of these in reaching my decision.
- 5 On 23 January 2015 the applicant filed a form 52 to extending the compliance date to 23 March 2015. The applicant has yet to file a substantive response to the examination report.

Confidentiality

- 6 The applicant requested that several of his letters, explaining the reasons for his late response, be treated as confidential. As the letters in question contained sensitive personal information I agreed to this request under rule 53(1) of the Act. The applicant also requested that the hearing be held in private for identical reasons. I agreed that this was a good reason under rule 84 and granted that request too. In light of these decisions and of the nature of the material discussed at the hearing, I further decide that certain parts of this decision will be redacted before it is made available to the public. These redactions have only been done where sensitive personal information is discussed. I do not believe that they will impede any understanding of my reasoning.

Decision in brief

- 7 The applicant provided a written timeline explaining his circumstances between January 2012 and the end of December 2014. He provided additional information and detail orally during the hearing. From this it is clear to me that he has experienced a series of unfortunate and unusual events that has spanned the vast majority, if not the entirety, of the period of time from before the specified response date to the present day. I accept that his reasons for responding late are peculiar to him and his application and that they are sufficient in terms of severity and extent to justify the exercise of discretion in this case. I thus decide that **the Office will accept a late response on this case.**
- 8 As the applicant has yet to file a response to the report issued on 25 January 2011, I further decide that **the applicant must file his response within one month** of this decision being issued. If he does so then the application will be remitted to the examiner. If he does not file a substantive response, i.e. **one addressing the majority of the issues raised in the report**, by that date then the application will be refused under section 18(3).
- 9 Finally, I order that the **fee** paid on the form 52 filed on 23 January 2015 be **refunded**. The applicant may appeal these decisions within 28 days. I will now explain my decisions in more detail.

The law

- 10 Section 18(3) of the Act states:

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.

- 11 Section 117B of the Act governs how the specified period to respond to the examiner's report may be extended. I will not reproduce it here as it is somewhat lengthy. In brief though, it allows an applicant to extend the period for reply by two

months as of right, with further extensions being possible at the Comptroller's discretion. In this case as the specified period plus the two months 'as of right' extension has passed I cannot extend the response date.

- 12 However, it is established practice that Section 18(3) allows me the discretion to accept a late filed response if the applicant provides a good reason to do so. I can find no judicial precedent on this issue but there have been a small number of decisions by this Office that are relevant. In *Jaskowski's Application*¹ the hearing officer observed (on page 199 of the RPC):

Section 18(3) clearly gives the comptroller discretion to extend the specified period but unless a coach and horses is to be driven through the subsection he must have some adequate reason for exercising that discretion which is peculiar to the particular applicant or application in suit.

- 13 In that case the applicant's agent sought an extension on the grounds that delays were inevitably caused by the need to consult US Patent Attorneys who in turn had to seek instructions from the applicant. The hearing officer decided that he could see nothing abnormal in this chain of communications and refused the request.

- 14 While this decision relates to *extending* the specified period for reply I believe that it is only reasonable to apply the same criteria to the assessment of reasons for a late response. Such an approach is also consistent with the decision in *McDonald's Application*² where various reasons were given for responding almost 1 year late. These included that the agent was unfamiliar with procedures before the Office and that the applicant had been awaiting the results of searches on other applications. Following *Jaskowski's Application*¹, the hearing officer rejected these reasons as being not sufficiently abnormal and for being a deliberate act. Two more reasons advanced for the delay were that the applicant had been travelling abroad and that the agent had been distracted by family illness. On these issues the hearing officer, on page 5 of his decision, stated:

It is the practice in the Office to regard absence on holiday or business as a common occurrence, and not be regarded as a peculiar circumstance sufficient to warrant the allowance of an extension. Whilst illness of the applicant or his agent might be accepted as a sufficient reason, and I think it would be reasonable to extend that to include illness within the family requiring the party to be absent, these circumstances arose well outside the period for response...

- 15 The hearing officer then went on to reject this final reason too on the grounds that the illness had occurred well after the specified period had already been missed.
- 16 Extensions of time to await the issue of reports on corresponding applications were also refused in *Smart Card Solutions' Applications*³. In paragraph 21 of this decision the hearing officer stated:

¹ Jaskowski's Application, [1981] RPC 197

² McDonald's Application (BL O/71/96)

³ Smart Card Solutions' Applications [2004] RPC 12

One reason why s.18(3) specifies a period for responding to an examination report is to ensure a smooth flow of amendments through the Office as stated above. However, another and perhaps more important reason is to protect the public interest by ensuring that any uncertainty involving a patent application is resolved as quickly as possible. When a patent application is published under s.16, the public is placed on notice that a particular monopoly has been sought. Until that application is either granted or refused, any member of the public having an interest in the subject and/or scope of the patent is somewhat limited in terms of what he/she can usefully do. There is therefore a burden on the Comptroller to protect the public interest by not allowing the examination process to be drawn out unless there are good reasons for any delay.”

- 17 So in summary, it is accepted practice that a late response requires a good reason to be accepted. The reason should be peculiar to the particular applicant or application - i.e. it should not be a common occurrence or a deliberate choice to delay. Illness may be a sufficient reason but not if it only occurs after the specified response date has already passed.

The application

- 18 I will now consider the reasons given by the applicant for requesting allowance of a late response. At the hearing the applicant provided a written statement and timeline explaining his circumstances between January 2012 and the end of December 2014. He provided additional information and detail orally during the hearing.
- 19 Paragraph redacted.
- 20 I am content to accept these arguments as far as they go. Following *McDonald's Application*², I accept that ill health is a sufficient reason to miss a specified response date. Critically, in this case the applicant's illness spanned the response date. Also, since by his own admission his illness resulted in him forgetting about his application, his failure to respond was clearly unintentional and peculiar to him and his circumstances at that time. However, the next question is: why did he not recall the need to respond at any point during the next two years?
- 21 In my opinion it is entirely reasonable that illness can result in an applicant focussing on things other than their patent application while they are ill and even for a short period afterwards. Equally though, I think it only reasonable to expect such an applicant, if they are serious about the prosecution of their application, to re-engage with the patenting process once a moderate period of time has passed since their illness. It is thus my view that an acceptable reason ought not merely to cover a period of time spanning the response date but should cover at least the majority of the time from that date to the date upon which the applicant actually responded.
- 22 Paragraph redacted.
- 23 Again, I will accept the applicant's reasons. It is clear to me that he has experienced a series of unfortunate and unusual events that has spanned the vast majority, if not the entirety, of the period of time from before the specified response date to the present day. Furthermore, I accept that his reasons for responding late are peculiar

to him and his application and that they are sufficient in terms of severity and extent to justify the exercise of discretion in this case.

Decision

- 24 I hereby decide that the Office will accept a late response on this case.
- 25 However, I am aware that the applicant has yet to file a response to the examination report issued on 25 January 2011. Furthermore, I remain mindful of the Office's duty to not allow the examination process to be unnecessarily drawn out. I thus further decide that the applicant must file his response to said report within one month of this decision being issued. If he does so then the application will be remitted to the examiner for further processing. If he does not file a substantive response, i.e. one addressing at least a majority of the issues raised in the report, by that date then the application will be refused under section 18(3).
- 26 Finally, in view of the reasons given by the applicant for his delay in responding and being aware of the time taken between his request to be heard and this decision being issued, I order that the fee paid on the form 52 filed on 23 January 2015 be refunded. However, any further extensions of the compliance period will be at the applicant's own expense and remain at the Comptroller's discretion.

Appeal

- 27 Any appeal must be lodged within 28 days.

Dr Stephen Brown