



PATENTS ACT 1977

APPLICANT	Philip Davies
ISSUE	Whether to allow a discretionary extension to the period for responding to an examination report under section 18(3) in respect of patent application GB1317801.7
HEARING OFFICER	Phil Thorpe

DECISION

Introduction

- 1 Patent application GB1314716.0 entitled "A Device Holder" was filed on 8th October 2013 and was published on 28th May 2014 having publication number GB2508287 A.
- 2 The applicant had on filing requested that the search and examination of the application be combined. A combined search and examination (CSE) report was duly issued by the examiner on 2nd April 2014. The report raised a number of objections, the main one of which was that the invention was obvious in light of certain prior art. The latest date for the applicant to respond to the CSE report was set as 8th October 2015. The applicant, via his attorney Harrison IP, responded to the CSE report with amendments on 8th October 2015. These amendments were then considered by the examiner and a further examination report was sent to the applicant via his attorney on 26th November 2015 setting out further objections to the application. The response date to this examination report was set as 26th January 2016.
- 3 On 6th June 2016 the Office received a communication from Harrison IP withdrawing as representative for the applicant on this application.
- 4 On the 14th March 2018, which was shortly before the expiry of the compliance period by which the application was required to meet all the requirements of the Patents Act and Rules, the IPO in line with its normal practice wrote to Mr Davies to advise him that it intended to treat the application as refused as no response had been received to the examination report of 26th November 2015. The letter went on to say that a late response to that report may be accepted provided a good reason is provided for not responding to the report. The letter advised the applicant that he "should write to the Office **urgently** providing (a) your response to the examination report and (b) a written explanation of why it is late". The letter further noted that the compliance period for the application was 8th April 2018.

- 5 The applicant responded by telephone to this correspondence on the same day indicating that he would discuss the matter with his new representative.
- 6 The applicant, via his new representative Mohun Intellectual Property, filed further amendments to his application on 7th June 2018. A request was also made for an as-of-right extension of 2 months to the compliance period. In the covering letter his attorney noted that the applicant had “had a breakdown of communication with the previous representative, Harrison IP Limited”. The letter went on to note that the applicant had only become aware of the examination report of 26th November 2015 on receipt of the letter informing him that the Office intended to refuse his application and was therefore asking for discretion to be exercised to accept the late response.
- 7 The examiner wrote to the applicant on 14th June 2018 to advise him that she was not able to accept his late response given that the reasons Mr Davies had provided for the lateness of the response did not clearly demonstrate how or why the deadline was unintentionally missed. Mr Davies was offered the opportunity to be heard on the matter which he took. The hearing, by means of a telephone conference, was held on 31st October 2018 with Mr Davies represented by Mr Chris Aldridge of Mohun.
- 8 At the hearing Mr Aldridge explained that he had been the representative dealing with the application for Harrison IP however he had left Harrison IP on 19th October 2015. Mr Aldridge indicated that he was unaware of who took over responsibility within Harrison IP for the application. Mr Aldridge did accept that Harrison IP would as a matter of course copy search and examination reports received from the Office to the applicant hence Mr Davies would have received the CSE report issued in April 2014. Mr Aldridge however noted that Mr Davies could find no record of receiving the examination report of 25th November 2015 and was thus unaware of the January 2016 deadline for replying to that report.
- 9 Mr Aldridge noted that the relationship between Mr Davies and Harrison IP had broken down in the first half of 2016. I asked whether he would have expected a copy of the letter that Harrison IP sent to the Office withdrawing its representation to have also been sent to the Mr Davies. Mr Aldridge was unclear what the normal practice was but indicated that there was ongoing correspondence between Harrison and Mr Davies at that time though it is his understanding that Mr Davies was not aware that Harrison had withdrawn its representation on this case. Mr Aldridge noted that Mr Davies may have been somewhat distracted by a number of other legal issues occupying him at that time. Mr Aldridge did however note that Harrison IP was at that time continuing to represent Mr Davies on matters relating to trademarks and this led Mr Davies to believe that it was also continuing to represent him on patent matters.
- 10 Mr Aldridge also sought to draw my attention to Mr Davies’ unfamiliarity with the patent application process. Mr Aldridge did however acknowledge that Mr Davies did have other patent applications one of which had been granted.
- 11 I asked Mr Aldridge to explain the further delay between the IPO issuing the letter on 14th March 2018 and the response received on 7th June 2018. Mr Aldridge referred to a telephone conversation Mr Davies had with a member of staff from the IPO immediately following him receiving the letter, suggesting that the conversation may

have contributed to his uncertainty as to what the March letter had required of him. He suggested that Mr Davies was not fully aware of the urgency of the matter despite the explicit content of the letter. Mr Aldridge also referred to a further breakdown in correspondence between Mr Davies and Mohun that resulted in Mr Davies inexplicably forwarding the March letter from to the Office to a firm of solicitors rather than Mohun. Mr Aldridge did not therefore receive a copy of that letter until the 5th June 2018.

Conclusion

- 12 Having carefully considered Mr Aldridge's submissions, which included information not previously presented to the examiner, I am satisfied that Mr Davies did intend to pursue the application and that his failure to respond to the examination report was unintentional. In particular I accept Mr Davies' assertion that he did not know he was no longer being represented by Harrison IP on patents matters even though they were continue to represent him on trademark matters. I am therefore satisfied that the reasons put forward for this are such that it is appropriate to exercise discretion provided under section 18(3) and to allow the late response to be admitted.
- 13 I therefore refer the case back to the examiner for consideration of that response. As Mr Aldridge accepted at the hearing, the extended compliance period expired on 8th June 2018 and there is no possibility of further extension of that compliance period. Hence the question for the examiner is now simply whether or not the application including the amendments filed on 7th June 2018 is in order for grant.

Appeal

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

Phil Thorpe

Deputy Director, acting for the Comptroller