Intellectual Property Office

BL O/012/19

10 January 2019

PATENTS ACT 1977

APPLICANT	Akron Brass Company
ISSUE	Whether patent application GB1811004.9 may be accorded divisional status under section 15(9)
HEARING OFFICER	Ben Buchanan

DECISION

Introduction

1 This decision considers the issue of whether patent application GB1811004.9 ("the divisional") can be considered to have been filed in time and may therefore be accorded divisional status. The compliance period on the preceding application GB1619158.7 ("the parent") was originally due to expire on 30th July 2018. After several rounds of examination, amendments were filed in respect of the parent on 30th May 2018 and followed by third party observations on 14th June 2018. An examination report dated 29th June 2018 was issued, taking account of the amendments and third party observations. The applicant filed further amendments in response to the examination report, a request for an as of right extension to the compliance period of the parent, accompanied by a Form 52 and the requisite fee and the divisional application on 4th July 2018. The letter accompanying the divisional application noted that following rules 29(3)(b) and 30(4) of the Patent Rules 2007, as amended ("the Rules") and including the as of right extension, the compliance period on the parent would end 5 months later on 4th December 2018 and thus claimed the divisional was filed on time.

2 A letter from the examiner to the applicant dated 27th July 2018, in respect of the filing of the divisional, stated that ante-dating of the divisional application was not allowed as it was filed less than 3 months from the end of the compliance period of the parent application, after the two month extension as of right had been applied. The examiner disputed that the rules applied as the applicant alleged because of the nature of the observations and because he did not consider that he had reported "as a consequence" of the observations filed on 14th June 2018. He thus disputed that his report qualified as a 'first observations report' under rule 29(3)(b). He was instead of the view that the objections reported addressed added matter and support issues first introduced by the amendments dated 30th May 2018 and would have been made whether or not the observations had been received. The examiner explained that the reference to the observations in the examination report was merely to inform the applicant that the observations had been considered.

3 The applicant's attorneys responded by email on 24th August 2018, stating that it is not possible for the applicant (or any third party) to determine whether the objections raised in the examination report on the parent, dated 29th June 2018, would have been raised by the examiner if the third party observations had not been filed. However, from an objective point of view they argued, the "fact pattern" fits the report being based upon the observations and therefore rule 29(4)(b) should be deemed to be met and the extension of the compliance date of the parent should follow.

4 Subsequent telephone discussions between the examiner and attorneys explored the application of rule 29(4)(a), specifically whether the observations filed concerned the question of whether the invention is "a patentable invention" under Section 1(1) of The Patents Act 1977, as amended ("the Act"). The examiner and attorneys were unable to reach agreement on these issues, resulting in a hearing being suggested in a letter to the applicant dated 25th September and subsequently requested. Skeleton arguments were filed on 7th November 2018. There was an auxiliary request (clarified during the hearing) to decide whether the Comptroller's discretion can be exercised to allow the filing of GB1811004.9, either by exceptionally extending the compliance period of the parent application, or by accepting the filing of GB1811004.9 as a late filed divisional under section 15(9).

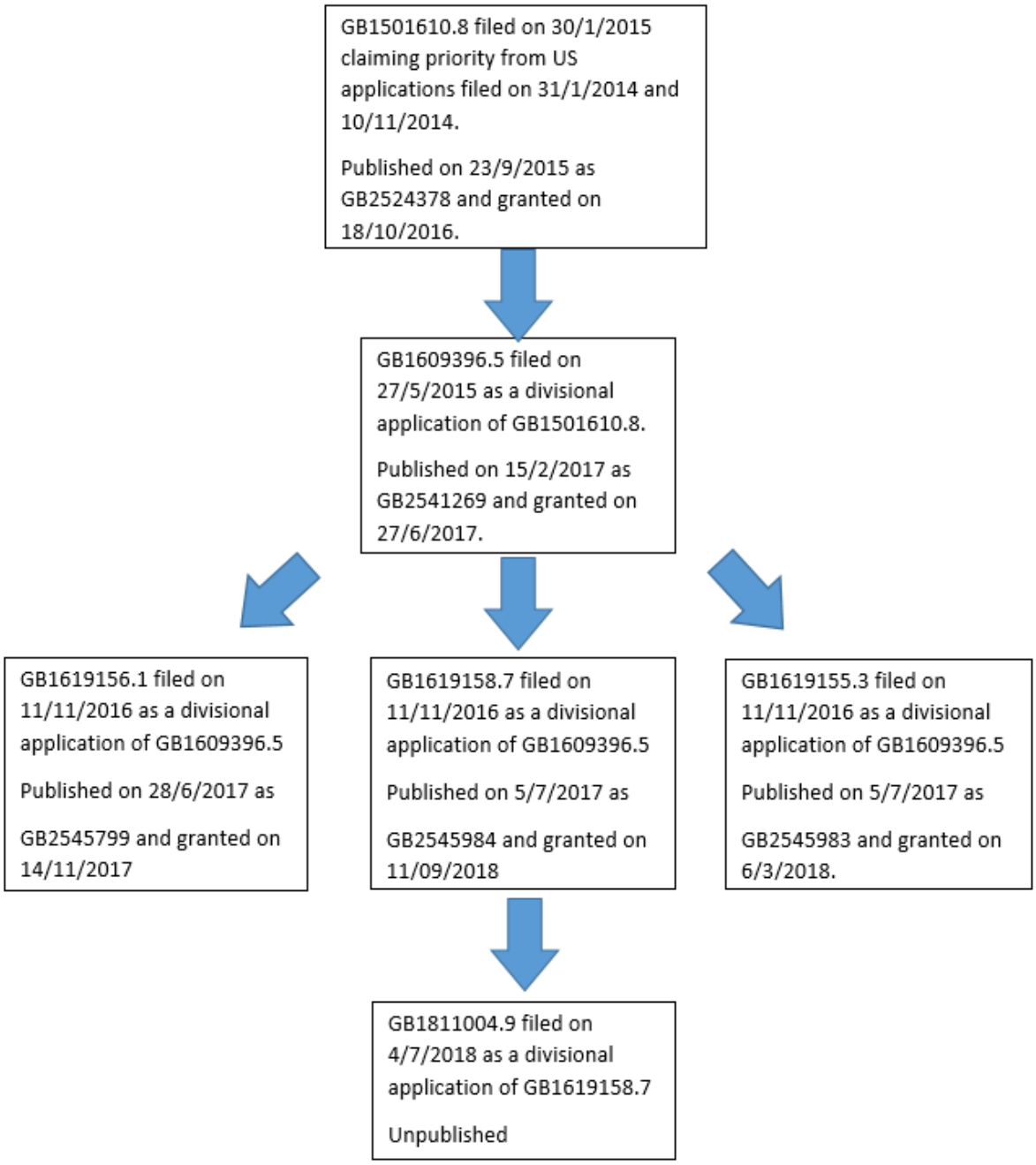
5 The application came before me at a hearing by video conference on 14th November 2018. The applicant was represented by their attorneys Ilya Kazi, Caroline Warren and Samuel Giles of Mathys & Squire LLP. The examiner Rhys Williams and hearing assistant Emma Porter also attended.

6 The question to be decided is whether the examination report dated 29th June 2018 constitutes a 'first observations report' under rules 29(3)(b) and 29(4). If so, under rule 30(4), the remaining rule 30 period of the parent is extended to 3 months from the date on which the first observations report was sent and will be extended by a further two months as of right; the divisional application may then be treated as having been filed in time. If not, the compliance period will only have been extended as of right to 30th September and the divisional will have been filed four days late. In this event I am asked to decide whether the application can be accepted as a late field divisional.

7 This decision relates to the latest filing in a family of applications summarised in the figure below. Each of the applications in the family has had numerous third party observations filed upon it.

8 Although this decision relates to the filing of the divisional application GB1811004.9, the issues under consideration relate for the most part to official periods, actions and responses on the parent application GB1619158.7. Unless otherwise stated, references below to official actions and correspondence are with relation to the parent.

The family of applications



The Law

The Patents Rules 2007 (as amended)

New applications filed as mentioned in section 15(9)

19.—(1) For the purposes of section 15(9) a new application may only be filed in accordance with this rule.

(2) A new application may be filed as mentioned in section 15(9) if—

(a) the earlier application has not been terminated or withdrawn; and

(b) the period ending three months before the compliance date of the earlier application has not expired.

(3) A new application must include a statement that it is filed as mentioned in section 15(9).

Substantive examination reports

29.—(1) Whenever the examiner reports to the comptroller under either section 18(3) or (4) on whether the application complies with the requirements of the Act and these Rules, the comptroller must send a copy of that report to the applicant.

(2) The comptroller may, if he thinks fit, send to the applicant a copy of any document (or any part of it) referred to in the examiner's report.

(3) For the purposes of rules 30 and 31—

(a) "first substantive examination report" means the first report sent to the applicant under paragraph (1); and

(b) "first observations report" means a report sent to the applicant under paragraph (1) which meets the condition in paragraph (4).

(4) The condition is that—

(a) a person has made observations to the comptroller under section 21(1) on the question whether the invention is a patentable invention;

(b) the examiner has reported to the comptroller, as a consequence of those observations, that the invention does not comply with the requirements of the Act or these Rules; and

(c) the comptroller has not previously sent to the applicant a report, relating to those observations, under paragraph (1).

Period for putting application in order

30.—(1) The period prescribed for the purposes of sections 18(4) and 20(1) (failure of application) is the compliance period.

(2) For the purposes of paragraph (1), subject to paragraphs (3) and (4), the compliance period is—

(a) four years and six months beginning immediately after—

(i) where there is no declared priority date, the date of filing of the application, or

(ii) where there is a declared priority date, that date; or

(b) if it expires later, the period of twelve months beginning immediately after the date on which the first substantive examination report is sent to the applicant.

(3) Subject to paragraph (4), where a new application is filed the compliance period is—

(a) where it is filed under section 8(3), 12(6) or 37(4)—

(i) the period specified in paragraph (2) in relation to the earlier application, or

(ii) if it expires later, the period of eighteen months beginning immediately after the initiation date; and

(b) where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.

(4) Where the first observations report is sent to the applicant during the last three months of the period specified in paragraphs (2) or (3), the compliance period is three months beginning immediately after the date on which that report is sent.

The Patents Act 1977 (as amended)

Section 1: Patentable inventions

Section 1(1)

A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -

(a) the invention is new;

(b) it involves an inventive step;

(c) it is capable of industrial application;

(d) the grant of a patent for it is not excluded by subsections (2) and (3) or section 4A below;

and references in this Act to a patentable invention shall be construed accordingly.

Section 14: The application

Section 14(5)

The claim or claims shall -

(a) define the matter for which the applicant seeks protection;

(b) be clear and concise;

(c) be supported by the description; and

(d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

Section 15: Date of filing application

Section 15(9)

Where, after an application for a patent has been filed and before the patent is granted -

(a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and

(b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),

the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

Section 21: Observations by third party on patentability.

Section 21(1)

Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.

Section 76: Amendments of applications and patents not to include added matter

Section 76(2)

No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

Section 91: Evidence of conventions and instruments under conventions.

Section 91(1)

Judicial notice shall be taken of the following, that is to say -

(a) the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty (each of which is hereafter in this section referred to as the relevant convention);

(b) any bulletin, journal or gazette published under the relevant convention and the register of European patents kept under the European Patent Convention; and

(c) any decision of, or expression of opinion by, the relevant convention court on any question arising under or in connection with the relevant convention.

Section 91(2)

Any document mentioned in subsection (1)(b) above shall be admissible as evidence of any instrument or other act thereby communicated of any convention institution.

Section 130: Interpretation

Section 130(6)

References in this Act to any of the following conventions, that is to say -

(a) The European Patent Convention;

(b) The Community Patent Convention;

(c) The Patent Co-operation Treaty;

are references to that convention or any other international convention or agreement replacing it, as amended or supplemented by any convention or international agreement (including in either case any protocol or annex), or in accordance with the terms of any such convention or agreement, and include references to any instrument made under any such convention or agreement.

Section 130(7)

Whereas by a resolution made on the signature of the Community Patent Convention the governments of the member states of the European Economic Community resolved to adjust their laws relating to patents so as (among other things) to bring those laws into conformity with the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty, it is hereby declared that the following provisions of this Act, that is to say, sections 1(1) to (4), 2 to 6, 14(3), (5) and (6), 37(5), 54, 60, 69, 72(1) and (2), 74(4), 82, 83, 100 and 125, are so framed as to have, as nearly as practicable, the same effects in the United Kingdom as the corresponding provisions of the European Patent Convention, the Community Patent Convention and the Patent Co-operation Treaty have in the territories to which those Conventions apply.

The European Patent Convention

Article 115: Observations by third parties Art. 93 R. 114

In proceedings before the European Patent Office, following the publication of the European patent application, any third party may, in accordance with the Implementing Regulations, present observations concerning the patentability of the invention to which the application or patent relates. That person shall not be a party to the proceedings.

The invention

The parent

9 The parent application relates to a fluid nozzle 100 comprising a nozzle body 150, a discharge tube 102, a pattern sleeve shown below as ////, and a baffle head 110, arranged such that the output flow 156 (through the nozzle fluid passage 152 and fluid discharge channel 116) is substantially perpendicular to the nozzle axis 158 when the sleeve is retracted. The nozzle may be such as embodied in Figure 1A below and may be used in a fire hose.

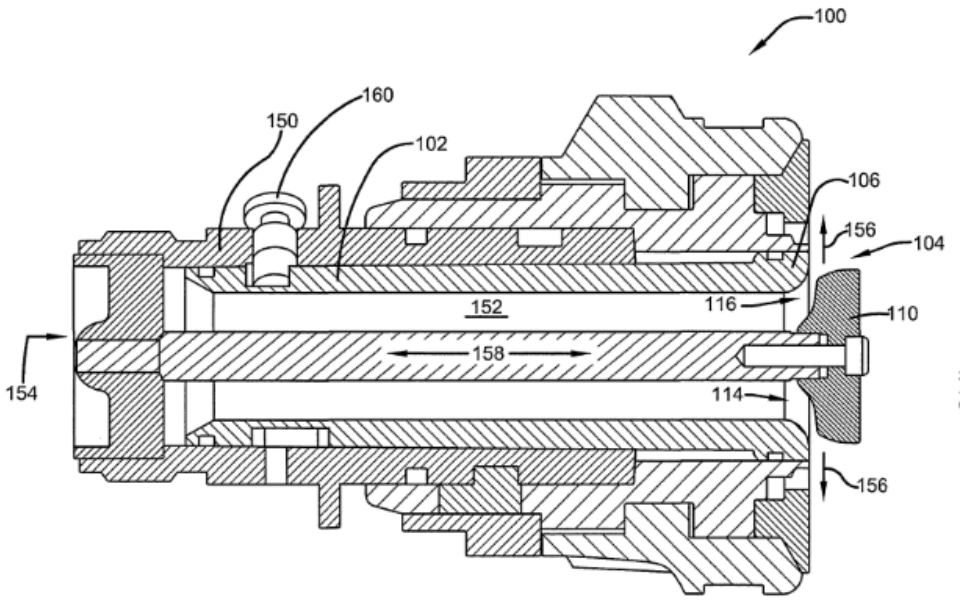


FIGURE 1A

10 An examination report of 5th April 2018 raised novelty, inventive step, clarity and consistency objections against the claims on file. The applicant's response of 30th May 2018 filed amendments to the claims, which added the feature "*the nozzle body terminating in an output lip at the distal end, the output lip forming a curved convex shape with an angle of up to 90 degrees*" to independent claim 1.

11 Third party observations were filed on 20th October 2017, 26th January 2018, 14th June 2018 and 9th July 2018. The only observations relevant to the issue to be decided, and discussed herein, are those filed on 14th June 2018. These observations include additional prior art and refer to the amendments filed on 30th May 2018, with sections directed to added matter, clarity and lack of novelty and inventive step.

12 The observations on novelty and inventive step were not mirrored in any objection subsequently raised by the examiner. The additional prior art filed by the third party was not used in support of any objection by the examiner. The observations on added matter were twofold, firstly relating to the concave shape of the proximal side of the baffle head and secondly that the claims now encompass an output lip with an

angle of less than 90 degrees. The second point was raised in the examination report of 29th June 2018.

13 The report objected to the clarity and support of, and potential added matter in, the term "of up to 90 degrees" and stated that the only supported value in the range would appear to be 90 degrees, as described and illustrated in the application as filed.

The divisional

14 The divisional application relates to aspects of a fluid discharge nozzle with means for varying the spray fluid pattern between a radial spray pattern and a substantially straight fluid pattern.

Argument and Analysis

15 The divisional application can be accorded divisional status by virtue of being filed on time if the compliance period of the parent is extended under rule 30(4). To satisfy rule 30(4), the examination report dated 29th June 2018 must constitute a 'first observations report' according to rule 29(3)(b). The requirements for a 'first observations report' are set out in rules 29(4)(a), (b) & (c). Satisfaction of rule 29(4)(c) is not disputed; consequently, during the hearing, most of the discussion focussed on the first two points. At the hearing the attorneys addressed the points in the order of *as a consequence* – rule 29(4)(b) and then *patentable invention* – rule 29(4)(a). The questions to be addressed in this decision, as I have analysed them in the order in which they are defined in the rules, are:

i) Do the third party observations relate to whether the invention is a *patentable invention* as required by section 21(1) and rule 29(4)(a)?
   a) Specifically, do observations in part or in whole in respect of compliance with sections 14(5) and 76(2) constitute observations as to whether the invention is a patentable invention?

ii) Did the examiner report *as a consequence* of the observations as required by rule 29(4)(b)?

iii) Notwithstanding (i) & (ii), are the circumstances such that the divisional filing may be accepted as a late-filed divisional under section 15(9)?

A patentable invention

16 In his letter of 25th September 2018, summarising his position in relation to the non-allowance of ante-dating of the divisional application, the examiner states that rule 29(4)(a) requires the observations to be "on the question of whether the invention is a patentable invention". Section 1(1) clearly codifies what is meant by "a patentable invention"; that is that the invention is new, involves an inventive step, is capable of industrial application and the grant of a patent is not specifically excluded. At the hearing, the examiner confirmed that he considered that the observations filed on 14th June 2018 included observations relating to the patentability of the invention (i.e. those directed at the novelty and inventive step of the amended claims) and observations not related to the patentability of the invention (i.e. those directed towards added matter and clarity). Only the observations relating to the novelty and

inventive step of the invention were considered to be observations which were acceptable under section 21(1) by the examiner. These observations were not mirrored in his examination report.

17 The applicant's attorneys disagree that the definition of patentability for section 21(1) should be interpreted narrowly according to section 1(1), and argue that, in UK IPO practice, section 21 observations under a wide range of sections of the Act are routinely considered and supplied to the applicant. The attorneys were not aware of anything to suggest that in certain cases some of the observations are taken into account and others not, or that observations should be subdivided into admissible and non-admissible portions.

18 Further, the attorneys noted that "third party observations referencing matters under section 14(5)(b) and (c) are allowed in established case law of the UK Court of Appeal" referring to the decision in Genentech Inc's Patent[1], specifically paragraphs 11.04-11.06. They stated in their skeleton arguments that "section 14(5) is not a ground for revocation post grant, so section 21 is the sole mechanism whereby a third party can challenge whether the invention is a patentable invention using the provisions set out in section 14(5)"; and further noted that in the CIPA Guide to the Patents Act, at 21.05, it is stated that "*in view of the decision in Genentech, it is submitted that the examiner ought to take into account observations submitted alleging non-compliance of the claims with S14(5)(a), (b) or (c) because otherwise such non-compliance cannot, according to that decision, be raised as such post-grant*".

19 Additionally, the attorneys argued that third party observations on added matter should also be considered to be observations under section 21(1). While there was no direct UK case law on this subject, the jurisprudence from the EPO could be referred to as "examination at the UKIPO should follow the EPO wherever possible", referring to section 130(7) of the Act. This states that section 14(5) (among other sections) is framed as to have, as nearly as practicable, the same effects in the UK as the corresponding provisions of the European Patent Convention (EPC), the Community Patent Convention (CPC) and the Patent Co-operation Treaty (PCT).

20 The attorneys went on to refer to section 91(1)(c) of the Act which makes clear that judicial notice is to be taken of EPO Boards of Appeal Decisions, and concluded that section 21 should, as nearly as practicable, have the same effect in the UK as Article 115 EPC. In turn, Article 115 is to be interpreted in the light of EPO Guidelines (E-VI-3) which state that:

3.Observations by third parties

*Following publication of the European patent application under **Art. 93**, any person may present observations concerning the patentability of the invention. Although lack of novelty and/or inventive step are the most common observations, third-party observations may also be directed to clarity (**Art. 84**), sufficiency of disclosure (**Art. 83**), patentability (**Art. 52(2)** and **(3)**, **53** or **57**) and unallowable amendments (**Art. 76(1)**, **123(2)** and **123(3)**).*

[1] Genentech Inc.'s Patent [1989] RPC 147 CA

21 Finally, supporting this point, the attorneys brought to my attention that EPO Boards of Appeal have considered third party observations on matters outside EPC Articles 54 (Novelty) and 56 (Inventive Step) as shown in decisions T918/94 and T598/97.

22 I have considered the *Genentech* judgment carefully, and the portion referred to states that "*before the grant of a patent…Section 21 allows third parties to make observations which the comptroller is required to consider in accordance with rules*" (para 11.06) and that "*section 14(5) cannot be used as a ground for revocation under Section 72(1)*" (paragraph 11.08). The difficulty in finding a clear basis for the position put forward in the skeleton arguments was discussed at the hearing, where the attorneys acknowledged that the decision pointed towards their line of argument, rather than being explicit. *Genentech* does not state that third party observations under section 21 can be made on section 14(5) matters, despite what the CIPA Guide to the Patents Act submits in section 21.05, referenced by the attorneys. It is, however, also stated clearly in section 21.05 of the CIPA Guide that "*the observations to be permitted are those which concern the patentability of the invention. The comptroller is not required to consider observations which relate to other matters…"* and "*The comptroller is obliged to consider the observations under section 21 as far as they relate to patentability, i.e. to the definition of patentable invention in section 1(1)*". I am therefore content that section 21(1) does not oblige me to consider observations relating to section 14(5) as permissible.

23 As to the supply of third party observations to the applicant by the UK IPO, the Manual of Patent Practice, at 21.02, states that "*Although s.21 refers to observations on patentability, i.e. bearing on whether or not the invention fulfils the conditions of s.1(1), in practice it is generally desirable to send to the applicant a copy of any letter received from a third party informant which purports to relate to an application, so that he may have prior notice of a document which may be laid open to public inspection*.". This makes clear that the supply of copies of third party observations to the applicant is not considered to be equivalent to the allowance of the observations filed under section 21.

24 Considering the required correspondence between the Act and the EPC, it is noted that section 14(5) is listed in section 130(7) as being "*so framed as to have, as near as practicable, the same effects in the UK as the corresponding provisions of the EPC*" and so, as decided in *Merrell Dow Pharmaceuticals v H. N. Norton & Co Ltd* [2] "*in construing a section of the patents act said by section 130(7) to have as nearly as practicable the same effects as the corresponding provisions of the EPC, the UK courts must have regard to the decisions of the EPO*". However, as section 21 is not listed in section 130(7), the UK courts are not compelled to have regard to the decisions of the EPO Boards of Appeal in this matter. The attorneys stated their view that this is not meant to be interpreted such that all other sections are meant to be interpreted differently, and as far as possible the UKIPO UK Courts harmonise and take the EPO's precedence, going on to say that under section 91(1) of the Act, "*judicial notice shall be taken of the following…EPC…*" which they interpreted to mean that "we should follow the EPC whenever possible but do not have to pretend that the wording is identical".

[2] Merrell Dow Pharmaceuticals Inc. v H.N. Norton & Co Ltd [1996] RPC 76

25 Section 91(1) is concerned with the status of the EPC, CPC and PCT and instruments, publications and decisions thereunder, in legal proceedings[3] and this means that these matters are recognised without need for formal evidence of their existence[4]. In his judgment in the Court of Appeal in *Genentech*, Mustill L J said "*The requirement that the court shall take judicial notice of the decision of the relevant convention court is directed (like the remainder of the section) to evidentiary matters; in this case the mode of proof of matters which might otherwise have to be proved as foreign law. The subsection does not give to rulings of other courts any greater status than they would otherwise possess, although of course, the desirability for a uniform course of decision in matters touching the Convention is manifest (see, for example, section 130(7)), and the Board of Appeal as the central decision making body of the European patent system must be hearkened to with particular attention*.".

26 As noted above, the requirement for "a patentable invention" is clearly defined in section 1(1) of the Act and section 21 is not required to have the same effect as nearly as practicable to the corresponding sections of the EPC. Because section 21(1) refers explicitly to third party observations "on the question of whether the invention is *a patentable invention*", I conclude that the observations relating to novelty and inventive step filed on the 14th June 2018 were legitimate third party observations under section 21(1) and those relating to added matter and clarity were not legitimate third party observations under section 21(1). That the observations were filed together in a single correspondence does not, to my mind, preclude their being considered separately and distinguished as (partially) admissible or not.

27 In coming to this decision, I have carefully considered the guidance in the Manual of Patent Practice and the CIPA Guide, as well as the arguments put before me. Patentability is not determined directly by the strict requirement to satisfy section 14; an application for a patentable invention could fail section 14 and conversely, an application for a non-patentable invention could meet section 14. Section 14 relates to the making of an application including definition of the invention, not whether an invention is defined as a patentable invention per se. Section 1(1) of the Act clearly defines patentability and then states "and references in this Act to a patentable invention shall be construed accordingly".

28 In referring to section 21 the Manual repeatedly exemplifies patentability as the requirements for novelty and inventive step; the only example of an observation relating to other than patentability is entitlement which is of no assistance here. I should add that I consider the same reasoning to apply in respect of observations relating to compliance with section 76 (added matter). The observations are headed "Added matter" and refer to "support". The examination report is headed "Clarity and support" and refers to potential added matter. What is important is that, in my opinion, neither of these relate to patentability for the purposes of section 21(1) and rule 29(4)(a). Finally, the Manual acknowledges that observations may bear only in part on patentability and that "in general no comment on the observations should be made when the examiner is not raising an objection arising out of them" (21.07). I am not persuaded that the examiner has done anything other than to interpret the Act and the Rules correctly and take action accordingly.

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[3] Manual of Patent Practice 91.01

[4] Manual of Patent Practice 91.02

29 Therefore, I find that the only observations in question which satisfy rule 29(4)(a) are those relating to the novelty and inventive step of the parent. The observations in respect of added matter and clarity, which are mirrored in part in the examination report under the heading "Clarity and support", are not observations on patentability under section 21(1) and do not satisfy rule 29(4)(a).

30 However, in case I am wrong on this point, I will go on to decide whether or not the examination report issued as a consequence of the observations filed. This is a decision on the facts and so is required to be determined on the balance of probabilities.

As a consequence…

31 At the hearing the examiner stated that he had seen the third party observations when examining the amendments filed on the 30th May 2018, but that he considers that he would have raised the objection to clarity and support (and potential added matter) in his examination report dated 29th June 2018 whether he had seen the observations or not. The examiner went on to say that the clarity/added matter problem with the amended claims "stood out plainly" and that any competent examiner would have raised the objection.

32 The attorneys noted that the objection raised in the examination report related very closely to one of the points raised in the third party observations, and stated that, from outside the UKIPO, it is difficult to tell if an objection was raised *as a consequence* of third party observations. They went further to say that it was logically impossible to *prove* that the objection was raised as a consequence of the third party observations, as they could not read the mind of the examiner. They stated that the only interpretation of rule 29(4) that would give legal certainty was if it were to follow the facts alone: if an issue is first raised in a third party observation, and later raised as an objection by an examiner in an examination report which mirrors the third party observation, then the examination report should be deemed to have been issued *as a consequence* of the third party observations.

33 While exploring this point at the hearing, the examiner admitted that while he believes that he would have raised the objection had the observations not been filed, he could not "unsee" the observations before writing the examination report, so it is difficult for him to be certain. The attorneys also admitted that they were "pretty sure that the examiner probably would have raised the objections" (i.e. without seeing the observations) but that the examination report appeared to be raised as a consequence of the observations, and they had relied upon that appearance to file their divisional application. The attorneys also pointed out that the requirement is "as a consequence…" and not "as a consequence *only*…".

34 It seems to me that when new prior art is referenced in third party observations, and the corresponding new information is subsequently used by an examiner in an examination report, it is highly probable that, for example, a report based on new citations is issued *as a consequence* of the observations including the new information. At the hearing, I suggested that the observations allegedly giving rise to the examination report of 29th June 2018 related to added matter and clarity, but provided the examiner with no new information to that already before him, in the amended application. I saw no evidence that they had influenced his thinking. The

attorneys suggested that observations based on no new information may nonetheless give rise to an examination report, for example if they construe a claim or interpret a known disclosure differently. They reiterated that the only way to ensure legal certainty was to consider whether the "fact pattern" fits the requirements of the rule; if an examination report "followed and mirrored" third party observations, then it should be considered that the examination report issued *as a consequence* of the observations. If the report constitutes a 'first observations report', then according to rule 30(4) an extension of the compliance date should be given in order to give the applicant time to address the objections it sets out.

35 This is an attractive argument, not least for its objective certainty and repeatability. However, in my view, the fact pattern must take account of all of the facts of the case. In the present case the facts are:

i) The examiner reported after considering the third party observations
ii) The examiner's report comprised an objection which was consistent with one of the observations
iii) The examiner's report did not mirror the observations in full
iv) The objection reported by the examiner was based only on the amended specification and not on any new information

36 The objection in the examination report headed "Clarity and support" partially reflects one of the observations and relies on no new information. It specifically refers to the "convex shape of up to 90 degrees on the output lip" and does not refer to the baffle. I can see no reason to doubt that the examiner fully and independently considered the amendments to the specification during re-examination in identifying the grounds for objection. Whilst the mind of the examiner cannot be known, there seems to me to be no basis for an assertion that the examiner would have reported differently in the absence of those observations, or therefore that he reported as he did as a consequence of their presence. For example, there seems to be no basis to conclude that he adopted the observation as an objection in his report (e.g. by repeating the observation(s) in full), or that he was influenced by the observations so as to raise an issue a competent examiner would not have identified from only the amended specification (e.g. by relying on new information, or adopting an alternative construction or interpretation).

37 Based upon the specific facts of the amendments filed on 30th May 2018 I find no reason to doubt that a competent examiner would have independently arrived at the objection raised in the examination report, and so in this case that on the balance of probabilities the examination report was not issued as a consequence of the observations. In coming to that view I have taken account of all of the facts; in particular the fact that the examiner's report was not consistent with all of the observations, and the fact that the report was based on no new information.

38 To be clear, I find that even if I considered that the requirements of rule 29(4)(a) are met, which I do not, I consider that the requirements of rule 29(4)(b) are also not met.

Auxiliary request: Late filed divisional

39 I am also asked to consider an auxiliary request to decide whether the Comptroller's discretion can be exercised to allow the filing of GB1811004.9 either by exceptionally extending the compliance period of the parent application or accepting the filing as a late filed divisional.

40 The Comptroller has discretion to extend the period of time allowed under rule 19 for filing a divisional application. However, this discretion will normally be exercised only if the applicant shows that the circumstances are exceptional and that he has been properly diligent[5].

41 The compliance period on the parent was originally due to expire on 30th July 2018. The deadline for filing a divisional application is three months earlier, and so was originally 30th April 2018. Extending the compliance period as of right until 30th September 2018 would have had the effect of extending the deadline for filing a divisional application to 30th June, had the request to extend been made before then.

42 The attorneys argued that the applicant "acted with due care and proper diligence" and that "circumstances surrounding this case are clearly exceptional since it raises questions that do not seem to have been reviewed directly before the UK IPO". The attorneys went on to explain that the divisional application was filed on the same day as the examination report was first accessed electronically on the UK IPO's IPSUM service (on 4th July 2018 - despite being a national holiday for the US applicants), the examination report had been accessed electronically before the report had been received through the post and they asserted that the examination report did prompt the filing of the divisional application. The attorneys argue that their interpretation of the rules was reasonable and consistent with the case law and additional guidance found, and everything the attorneys considered and have discussed points towards the applicant being justified in expecting the filing of third party observations and the issue of a subsequent examination report to extend the compliance period on the parent. The applicant has diligently followed the rules as they believed them to apply.

43 The questions under review in this decision, and the circumstances referred to as exceptional by the attorneys – that is the filing of the observations, the issue of a subsequent examination report and the examiner disputing that the report is a 'first observations report' – arose after the original deadline for filing the divisional had passed; the very circumstances that rule 30(4) provides for. These events may well be regarded as 'exceptional' in the lifetime of the parent. However, in respect of the request to accept the divisional as late filed, I cannot see how the examiner *disputing* that his examination report was a 'first observations report' can be said to be relevant as it occurred after the event. The "exceptional circumstances" then, would seem to be the nature and timing of the observations and examination report.

44 I do not think it is exceptional for third party observations to be filed, nor for an examination report to follow and address previously filed amendments. What perhaps best reflects the attorneys' assertion that the circumstances are exceptional is the timing of the applicant having sight of the examination report just after the deadline for filing the divisional application (had the compliance period on the parent

[5] Penwalt Corporations's Application (BL O/72/82); Manual of Patent Practice 15.21

been extended by then as of right). However, at the time, the compliance period had not been extended and the examiner issued his report within normal timescales with regard to both the amendments filed previously and the remaining compliance period. On balance, I do not therefore consider the circumstances which existed prior to filing the divisional, and which the attorneys assert influenced the decision and action to quickly file the divisional, to be exceptional. In other words, I do not see that the circumstances prior to the deadline for filing the divisional exceptionally frustrated the applicant from doing so. After the deadline, the applicant viewed the examination report and filed the divisional quickly and under those circumstances rule 30(4) exists to determine whether it can be considered to have been filed on time. Of course that does not preclude the Comptroller from exercising his discretion even if rule 30(4) is not met. I therefore need to consider whether the examination report gave rise to exceptional circumstances.

45 If I could identify a clear link between the issues raised in the examination report and the particular invention claimed in the divisional application, that might show that the applicant could only be reasonably expected to take action after having considered the contents of the report; in other words that given the timing, the circumstances were exceptional. On this point the attorneys stated that the reported issues on the parent prompted the filing of the divisional indirectly, explaining that the point of a divisional application was to give the applicant an alternative opportunity to gain protection if there is a question mark over the parent. I do not think that this is sufficient to regard the issuance of the report as exceptional. Had the examination report issued as a consequence of the observations (whether or not they related to patentability), given the timing, the circumstances may be deemed to have been exceptional – the applicant could not reasonably have been expected to have taken action sooner. However, that is the consideration I have made above in respect of rule 29(4)(b) and found lacking, precluding rule 30(4) to extend the compliance period of the parent and enable the divisional to be filed on time. In summary, in the absence of a clear link between the issues raised in the examination report and the invention claimed in the divisional, I cannot see how the circumstances precluded the application for the divisional being filed earlier and might be deemed to be exceptional.

46 Even if the circumstances were deemed to be exceptional, I have to consider whether the applicant has been diligent. I note that there is no *requirement* for an examination report to issue following third party observations being filed, as confirmed for example in Central Research Laboratories Ltd's application[6]. Consequently, it cannot be considered to be diligent to have relied upon an examination report to follow the observations to enable a divisional to be filed 'in time'. The applicant had plenty of time to file a divisional application sooner, and indeed had filed several previously. Having left it too late, by neglecting to extend the compliance period on the parent in time, I am not sure the applicant can be said to have been diligent simply by virtue of having filed the divisional quickly following sight of the examination report on 4th July. In other words, I do not see that despite the applicant's diligence following sight of the report, they were frustrated from filing the divisional sooner, or that they were properly diligent before the period for filing a divisional expired, or before having sight of the report.

[6] Central Research Laboratories Ltd's application (BL O/41/9/00)

47 I conclude that the circumstances are not exceptional and the applicant has not been properly diligent in filing the divisional application and I therefore find that the Comptroller will not exercise discretion to allow the late filing. I apply the same reasoning in respect of the request to exceptionally extend the compliance period of the parent (which is granted) and which amounts to the same thing. I note that some of the considerations in respect of exceptional circumstances in the present case are accommodated by rules 29(3)(b) & 30(4) in respect of which I have found consistently with the above.

Other matters

48 The examination report was dated 29th June 2018. At the time, the compliance period ended on 30th July 2018. The report was therefore "sent" within the last three months of the compliance period. The applicant accessed the report online, via the IPO's IPSUM file inspection service, on 4th July 2018, and filed the divisional on the same day. The examination report was received by post sometime after that. The issue of whether it was "sent" on 29th June, or deemed to be sent when viewed on 4th July, or at some other time was not discussed at the hearing. In any case nothing turns on this because the divisional can only be considered to have been filed on time if the requirements of rules 29(3), 29(4) & 30(4) have been met. For the avoidance of doubt, I have not considered when the examination report was "sent" and make no finding in this respect.

Conclusion

49 I find that the requirements of rules 29(3)(b), 29(4)(a) and 29(4)(b) are not met and so the compliance period of the parent is not extended under rule 30(4). Consequently, the application was not filed in time to be accorded divisional status under rule 19 and section 15(9). Additionally, discretion to allow the late filing of the divisional application has not been allowed, so the application may only proceed with a filing date of 4th July 2018.

Appeal

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

BEN BUCHANAN

Deputy Director, acting for the Comptroller