

PATENTS ACT 1977

IN THE MATTER OF

Patent Application No GB0019352.4 in the name of Central Research Laboratories Ltd and a request for it to be ante-dated to the date of filing of Patent Application No GB9604731.1 under section 15(4) of the Act

DECISION

Introduction

1 The applicants, Central Research Laboratories (“CRL”), filed the application in suit on 8 August 2000 requesting that it be treated as a divisional on Application No GB9604731.1 under section 15(4) of the Patents Act 1977 and hence ante-dated to the date of filing, 6 March 1996, of the earlier application. The examiner expressed the view that the new application could not be permitted to proceed as a divisional application without exercise of the Comptroller’s discretion since it had been filed after the latest date allowed according to rule 24 of the Patent Rules 1995, as amended by the Patent (Amendment) Rules 1999. Mr Neville Walker of QED, CRL’s patent agents, then requested a hearing if the Comptroller was unable to affirm that the divisional application had been filed in time. The matter came before me at a hearing on 3 October 2000 at which CRL were represented by Mr Walker and Mr Eamonn Quirk attended as examiner.

Prosecution of Application No GB9604731.1

2 The first examination report, which *inter alia* raised a plurality of invention objection, issued under section 18(3) on 30 September 1997, giving as a date for reply 30 March 1998. An extension of 2 months, requested in a letter dated 23 March 1998, was allowed, making the new date for reply 30 May 1998. On 1 June 1998 a telephone request was made by Mr Wheeler of QED for a further one month’s extension, which was allowed, so that the party to which CRL wished to assign their patent rights could respond to the examination report. The response,

received on 30 June 1998, explained that, rather than assigning the application, a licence had been agreed. At this time claims 5 and 6 were deleted “without prejudice to their subsequent reinstatement into the present Application or a “divisional” Patent Application based on the present Patent Application”. Following some correspondence and phone calls between the examiner and CRL’s patent agents about the filing of a divisional application a further examination report issued on 26 October 1998 raising objections and giving as a date for reply 27 April 1999. On 26 April a request for an extension of one month was made by Miss Hamardyk of QED on the grounds that she had been absent from her office as a result of illness. The extension was granted but, in the event, a response was received on 30 April 1999. However, the version of claims filed with the response were not the amended claims filed on 30 June 1998 which met the novelty objection raised in the first examination report but the original claims and consequently a further examination report issued on 7 June 1999 giving as a reply date 7 October 1999. On 19 August 1999 Miss Hamardyk phoned to say that the file relating to the application had been misplaced so a second copy of the O/L dated 7 June 1999 was issued, together with a copy of QED’s letter of 30 June 1998. On 8 November 1999 Mr Walker phoned to apologise for the fact that there had been no reply to the examination report and the examiner explained that reasons for the oversight should be provided before a retrospective extension could be considered. A telephone report to this effect issued. On 22 March 2000 a response was filed together with a request for a retrospective extension of the time to reply on the grounds that there had been a misunderstanding between the agent and his assistant, Miss Hamardyk, exacerbated by the fact that the assistant was at the time attending a course. In a letter dated 7 April 2000 the examiner indicated that the reasons given were not considered sufficient for the Comptroller to exercise his discretion to allow such late filing of the examination response and offered a hearing. A reply date of one month was set, i.e. until 5 May 2000. No response was received to this letter and, on 21 June 2000, the normal WR1 letter issued informing the applicants that the Office intended to treat the application as refused on 6 September 2000. Subsequently, on 6 September 2000, section 21 observations were received and these were acknowledged and forwarded to the applicants.

Prosecution of Application No GB0019352.4

3 The application was filed on 8 August 2000 with a request for combined search and

examination and a request that it proceed as a divisional application on Application No GB9604731.1. The accompanying letter stated that "The claims are identical to those which were provisionally approved by the Examiner in the "parent" Application, in the Examiner's report dated 26th October 1998 in respect of UK Patent Application No GB9604731.1.". In official letters dated 15 August 2000 and 25 August 2000 it was stated that the divisional application had been filed out of time and the Comptroller's discretion to allow such late filing would only be exercised if CRL could show that the circumstances are exceptional and that they had been properly diligent. It was explained that the request for the exercise of discretion should be made as a matter of urgency. In a telephone conversation on 6 September 2000, the last day of the unextended section 20 period, it was agreed between Mr Walker and the examiner that form 52/77 requesting a one month extension needed to be filed on both the earlier application and the application in suit. Mr Walker was also informed that a hearing would be offered in the event that the Comptroller's discretion were to be exercised adversely to the applicants in respect of the late filing of the divisional. This resulted in a letter dated 6 September 2000 requesting a hearing if the Comptroller was "unable to affirm that the aforementioned "Divisional Application" has been timely filed ...". The examiner wrote to CRL on 14 September 2000 pointing out that, in seeking the Comptroller's discretion, they had not taken the opportunity to show that the present circumstances were exceptional and that they had been properly diligent. He pointed out that in fact no reasons whatsoever had been provided to explain why the application was filed outside the time permitted for filing a divisional application.

4 The latest date on which a divisional may be filed is determined by rule 24. It is not disputed that, in the present case, rule 24 (1) applies :-

24 (1) Subject to paragraph (2) below, a new application for a patent, which includes a request that it shall be treated as having as its date of filing the date of filing of an earlier application, may be filed in accordance with section 15(4) not later than -

the beginning of the third month before the end of the period ascertained under rule 34 in relation to the earlier application as altered, if that be the case, under rule 100 or rule 110 ("the rule 34 period")

Since the rule 34 period on the earlier application expired on 6 September 2000 this means that

any new application requesting ante-dating should have been filed by 6 June 2000, or with the one month's extension granted as of right on filing form 52/77, 6 July 2000.

The applicants' argument

5 At the hearing Mr Walker referred to an e-mail which he had received from Nigel Couch, one of the inventors of the application in suit and of which he had faxed a copy to the Office on the day before the hearing. This stated that, whilst initially the main interest was in obtaining an EP patent, in the first quarter of this year CRL had entered into discussions with a company whose markets were UK based and towards the end of the second quarter they had asked whether anything could be done about the UK patent. At the hearing Mr Walker explained that, at the time that a hearing was offered on the earlier case, the intention was to let the GB application lapse and only pursue the EP application. However, subsequently, in discussions between Mr Walker and Mr Couch, following a change in the applicants' commercial circumstances, it was decided to file a divisional in order to try to get a GB patent for the invention of the claims which the examiner had agreed were novel and inventive on the earlier application. There was however some discussion as to whether or not these were the claims filed on the later application. Mr Walker stated that he had filed the present application promptly following those discussions and therefore that he had acted diligently.

6 At the hearing Mr Walker also sought to argue that, because section 21 observations had been filed on the earlier application on 6 September 2000, under rules 34(2) and 37 the examiner should have issued a report under section 18 which would have resulted in the extension of the latest date for putting the earlier application in order, obviating the need for exercise of the Comptroller's discretion. In his view rule 37(3) required the examiner to issue a section 18 report when section 21 observations were received, if a section 18(4) report had not issued.

Decision

7 At the hearing Mr Walker requested that the e-mail should be kept confidential, since it contained commercially sensitive information. Having read it I am satisfied that this is the case and therefore direct that it be treated as confidential under rule 94(1).

8 On the earlier application the opportunity was not taken to seek a hearing to challenge the examiner's view that the Comptroller's discretion should not be exercised in favour of allowing a response to be filed more than 4 months after Mr Walker had acknowledged, in a phone call to the Office, that the response was already over a month late. However the present application has claims identical to some of those on the earlier application. Therefore, if this application were allowed to proceed as a divisional from the earlier application it would appear to have the effect, at least in part, of circumventing the refusal to exercise the Comptroller's discretion to allow a late response on the earlier case. In these circumstances it would clearly be inappropriate to exercise her discretion without compelling reasons.

9 I also note that a hearing was requested before any reasons were provided as to why the Comptroller should exercise her discretion in the applicants' favour. It is well established from case law that discretion can only be exercised when material is available upon which discretion might be exercised. In this case, despite the examiner making quite clear in numerous letters and telephone calls that, for the Comptroller's discretion to be exercised in CRL's favour, they would need to show due diligence and exceptional circumstances, no reasons whatsoever were put forward.

10 Taking into account the one month's extension of the rule 34 period for the earlier application, which is not discretionary but is allowed on filing form 52/77 with fee, the latest date on which a divisional application could have been made was 6 July 2000. Nothing that Mr Walker has said persuades me that they were prevented, by exceptional circumstances, from filing a divisional application before that date. In fact, as Mr Walker made clear at the hearing the application was filed promptly once the decision to file had been made. That decision to file came about following a change of mind when CRL found their commercial circumstances had changed and they were looking more to UK markets than continental Europe. In *Fibre Optic's Application* (SRIS O/156/85) which concerned an extension of the period for reply to a section 18 letter it was held that the reason why the applicant did not, or could not, respond within the unextended period should be considered in the exercise of discretion and an extension was refused on the grounds that the applicant had decided to abandon the application and then had changed his mind. Similar considerations would seem to apply in the present case. It is not

entirely clear whether the different commercial considerations which resulted in the applicants' change of mind occurred before or after the latest date on which a divisional application could have been filed. However, regardless of the exact time at which these events occurred, in my view they are part and parcel of normal business and do not amount to exceptional circumstances.

11 I accept that, once the applicants had decided to file the application in suit, they acted diligently but I am not convinced that they were so diligent in the preceding months. The e-mail provided by Mr Walker indicates that the applicants first became interested in UK markets in the first quarter of 2000 and the possibility of resuscitating the earlier GB application was considered in the second quarter of that year. At that time, a divisional application could have been filed without requesting the Comptroller's discretion but there is no indication that the applicants acted promptly following the change in their circumstances. Consequently I do not consider that the applicants have exercised the requisite due diligence.

12 As I indicated above, persuasive reasons would have been needed to be advanced to convince me that the Comptroller's discretion should be exercised in the applicants' favour and I do not consider the reasons put forward, albeit rather belatedly, sufficient.

13 At the hearing Mr Walker also argued that the Comptroller's discretion was not in fact necessary because the period for putting the earlier application in order should have been extended under rule 34(2).

14 Rule 34(2) only allows for an extension of the time for putting an application in order when the examiner has relied on the substance of the observations to report that the patentability requirements of the Act are not met. In these circumstances when the application is in the last 3 months of the period ascertained according to rule 34 (1) this period is extended to three months from the date of the examiner's report.

15 Rule 37(3) states that, when an 18(4) letter has not been sent to an applicant, observations under section 21 should be referred to the examiner conducting substantive

examination of the application under section 18 and “the examiner shall consider them and comment upon them as he thinks fit in his report under that section.”

16 I do not share Mr Walker’s interpretation that rule 37 requires the examiner to issue a section 18 report, following his consideration of section 21 observations. The observations are always forwarded to the applicant as required by rule 37(1) but, as I explained to Mr Walker, they do not always necessitate action under section 18. As stated in MOPP 20.02.1 “R.34 also provides for an automatic extension of the prescribed period when observations under s.21 are filed near the end of the period and give rise to a report under s.18(3).”. In the present instance no such report issued and consequently the provisions of rule 34(2) do not apply.

Summary

17 I have found that Patent Application No GB0019352.4 should not be allowed to proceed as a divisional application on earlier Patent Application No GB9604731.1 since it was filed after the date specified in rule 24(1) and CRL have failed to convince me that the Comptroller’s discretion should be exercised in their favour to allow late filing. I have also found that there is no reason to extend the period for putting the earlier application in order for grant. Consequently if CRL wish to proceed with Application No GB0019352.4 it must carry its own date of filing viz 8 August 2000, in which case it would be prior published by Application No GB9604731.

Appeal

18 Any appeal should be lodged within 6 weeks of this decision.

Dated this day of October 2000

JACKIE WILSON

Deputy Director acting for the Comptroller