

PATENTS ACT 1977

IN THE MATTER OF Patent
Applications Nos GB9915892.5,
GB9915893.3, GB9915894.1,
GB0001507.3, GB0001508.1 and
GB0008824.5 in the name of Gordon
Ross

DECISION

Background

1. This decision concerns six applications filed in the name of Dr Gordon Ross. The table on the next page identifies the applications and also sets out the main dates of various actions for each of them. The table identifies the applications by their application number and by Dr Ross's DCS reference number. For the sake of simplicity and hopefully to assist Dr Ross, I will use his reference numbers to identify the cases. Thus we are concerned with application references 99/01, 99/02, 99/03, 2000/01, 2000/02 and 2000/04.
2. The processing of each of the applications initially proceeded normally. Dr Ross had requested that he receive a combined search and examination report ("CSE") on all six cases. First examination reports with search reports issued between 26 January 2001 and 3 April 2001, and responses from Dr Ross were received on all six cases on 10 April 2001. Second examination reports issued on all six cases between 8 May 2001 and 23 May 2001. On cases 99/01, 99/02 and 99/03, the period for response was set at 4 months, whilst for cases 2000/01 and 2000/02, the deadline for response was set at 25 January 2002, and for case 2000/04 the deadline set was 12 April 2002. A common letter covering all these applications was received from Dr Ross on 18 May 2001, and in it he indicated that he was seeking advice from a patent agent. He also set out several options available for progressing the applications, noted that he still had some time before the deadlines expired, and said he would get back to the Office with an indication of his next steps.
3. Responses to the examination reports on cases 99/01, 99/02 and 99/03 were received on 31 May 2001, and further examination reports issued on these cases between 2 July 2001 and 24 July 2001 again specifying a period of four months for response. The next communication from Dr Ross on all six cases was received on 21 February 2003, some 15 months after the deadline set for response for cases 99/01, 99/02 and 99/03, and 13 months after the deadline on cases 2000/01, 2000/02 and 2000/04. This response took the form of a letter apparently referring to these and others of Dr Ross's pending patent applications and an accompanying review of the general subject matter area of Dr Ross's applications. Neither the letter nor the review addressed the objections raised by the examiners dealing with these applications, and no amendments were submitted.
4. Letters requesting reasons for the late response were sent to Dr Ross (on all except 2000/02) between 7 March 2003 and 8 April 2003, and letters in response were received from him on all the cases between 19 March 2003 and 3 April 2003. Further letters on all cases (except 2000/02) were received from Dr Ross between 27 March 2003 and 3 April 2003. On all six

cases the respective examiners were not persuaded by the reasons given by Dr Ross for failing to make responses within the times allowed, and on each case gave notice that they proposed, on behalf of the Comptroller, to refuse the applications. Each gave Dr Ross an opportunity to be heard, and on 30 April 2003 he requested to be heard.

5. Following a communication between Dr Ross and one of the examiners in which Dr Ross suggested that there were other reasons, not previously disclosed, for the late response, he was invited to set out the details in writing, which he did on 14 June 2003. These reasons were also not considered by the examiners to be adequate, and so the hearing proceeded on 3 July as agreed. Dr Ross made further submissions in a document entitled 'Evidence' filed on 20 June and in a document he refers to as a further statement filed on 30 June 2003. Dr Ross attended the hearing in person, and Joe McCann, one of the examiners dealing with Dr Ross's applications, also attended.

The law

6. In order to regulate the processing of patent applications certain time limits are imposed for completing certain stages of the process. Some are set by statute ("prescribed periods") whilst others are within the power of the Comptroller to set ("specified periods"). For responses to examination reports, Section 18(3) of the Patents Act 1977 ("the Act") says that in the event that an examination report is issued making objections that the application does not comply with the requirements of the Act,

"... 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 ...".

The period for response to the first examination report is normally set at 6 months unless the applicant has opted to have a combined search and examination report (CSE), in which case the period is either 6 months or to the end of the period of 2 years from the priority date of the application or its filing date if no priority is claimed. For a second examination report the response period is normally 4 months (or for CSE cases to the end of the period of 2 years from earliest date if that gives a longer period) and then 2 months for responses to any further reports. These periods may be reduced if the case is approaching the end of the period set for putting the case in order. This period is specified in Rule 34 of the Patents Rules 1995 and is normally 4 years and 6 months from the earliest priority date, or the filing date if no priority is claimed.

7. For cases 2000/01, 2000/02 and 2000/04, the examination reports to which Dr Ross failed to respond in time were the second examination reports. Normally, 4 months would have been set as the period for response, but because Dr Ross had opted for a combined search and examination report on each of these cases, and because of Dr Ross's prompt response to the first reports, the end of the period of 2 years from the earliest date on each of the cases was still more than 4 months hence, so the same deadline of 2 years from the earliest date was set for the response to the second examination reports. For cases 99/01, 99/02 and 99/03, third examination reports were issued. Whilst the period for response would normally have been 2 months, in each case Dr Ross was given 4 months to respond.

8. When a time period is specified by the Comptroller, she can use her discretion, if requested, to extend that period, if the reason given is deemed adequate. Requests to extend periods for responding to examination reports by up to one month are normally granted if the requests are made before the expiry of the period and an adequate reason is given. In general terms, reasons need to be exceptional and peculiar to the case in question. Reasons that could apply to almost any case are unlikely to be acceptable.

Argument

9. The first argument advanced by Dr Ross was that he had not actually missed any deadlines set for responses. He argues this in the document he calls a further statement. He suggests that having received the first examination reports, all of which raised objections of non-patentability or lack of novelty or both, he responded within time with amendments which he considered satisfactory. However, in all six cases being considered here, the examiners raised objection that the amendments added matter contrary to Section 76 of the Act. At this stage, Dr Ross suggests in his there was an exchange of correspondence, following which “it was agreed to resubmit the original applications, in their original form, and to subsequently revise them ...”. Although Dr Ross did write to the Office on 18 May setting out options that he was considering taking, I can find nothing on the files of these cases in the way of a response from the Office suggesting any particular course of action. However, this is of no consequence; in the event Dr Ross submitted responses to the reports within the time set on cases 99/01, 99/02 and 99/03. One of the responses appears to be a copy of the originally filed application, another is a close approximation to the original, and a third differs significantly from the original. No response was received on the other three cases.
10. Dr Ross goes on to suggest in his ‘statement’ that after he submitted these responses, the Office maintained the originally set deadlines. This is clearly not so. For cases 99/01, 99/02 and 99/03 a new deadline was set at each report stage. For cases 2000/01, 2000/02 and 2000/04, as I have explained above, the original examination reports set deadlines at 2 years from the filing dates, which gave Dr Ross considerably more time than the usual 6 months. When the second reports issued there was more than 4 months to the end of the 2 year period from filing date, so as is normal in those cases, the period for response was set again to expire 2 years from the filing date. This gave Dr Ross between 8 months and 11 months to respond on these cases, rather than the more usual 4 months. This is what I assume Dr Ross means when he says that the same deadlines were set. He suggests that this was inappropriate and unjust and different deadlines should have been set. I cannot agree with Dr Ross on this matter. The deadlines given were the normal ones given according to the Office’s usual practice and were more than generous when compared with those normally set on cases where the applicant does not opt for combined search and examination. It follows that I do not regard this as a suitable reason for exercising discretion to allow a late response.
11. Dr Ross has advanced a number of reasons why discretion should be exercised in his favour to allow late responses to the various examination reports. In his letter of 19 March 2003, having referred to the distinctly different nature of his invention over the prior art, Dr Ross says that the major reason for the delay “is that significant effort has gone into establishing the nature of this discontinuity with the prior art”. In his letters of 31 March and 3 April 2003, he explains that after filing the applications, efforts were made to realise prototypes, demonstrators and working models of some of the novel elements covered by his patent

applications, and that this was a difficult and complex task. Having now completed that work he suggests that it is “possible to re-visit these current applications”.

12. Dr Ross repeats this argument in a document he entitles ‘Evidence’ submitted in advance of the hearing. He suggests that because of the novel nature of the inventions in his applications, the examiners had difficulty appreciating the inventions which led to them questioning ‘their novel nature and practicality’. He also suggests that the examiners, because of their lack of understanding, cited prior art which was irrelevant. As a result, Dr Ross says he decided to spend time realising working examples of his inventions, but this was significantly more difficult, and took longer, than expected. Dr Ross enlarges on this argument in his ‘statement’. In this he suggests that the examiners dealing with his applications lack familiarity with this area of technology and do not have the necessary skills to appreciate the novel nature of his inventions. This, he suggests, has made it very difficult for him to properly respond to their objections.
13. I am not persuaded by these arguments and so I do not accept this as a reason for exercising discretion. In the first instance, I cannot accept the argument that the examiners are not equipped to deal with the subject-matter of his inventions. Examiners have a great deal of expertise in their particular area of technology, often acquiring a great deal of knowledge over many years working in that area. In any case, I do not see that this is a reason for failing to meet a deadline for responding to an examination report. As for the need to demonstrate that the invention could be turned into a practical product, most products which are the subject of patent applications need development work in order to turn them into a vendible product, and thus I consider this reason for the delay to be quite unexceptional.
14. In his letter of 30 April 2003, in which Dr Ross requested a common hearing to present his case on all 6 applications, he referred to several family bereavements which had occurred and which had contributed to the delays. Recognising that this might be pertinent to Dr Ross’s case, despite the sensitive nature of these events, I considered it desirable to request from Dr Ross further details of the dates of the bereavements and the extent of Dr Ross’s involvement in settling affairs. I apologise to Dr Ross for having to refer again to these matters here. In his reply to my enquiry, he explained that his brother had died suddenly in October 1997, before any of the applications were made, but that he had to become involved in settling his brother’s estate. His parents died in quick succession in October and November 1998, and whilst his father’s affairs were relatively straightforward to settle, his mother’s were complex and took some time to sort out. Again, these bereavements took place before any of the applications were filed.
15. Although he says that because his brother had died intestate, his affairs took some time to sort out, I think that it is extremely unlikely to have been taking a lot of Dr Ross’s time in the period from May 2001 onwards. Whilst the settlement of his mother’s affairs may have taken some considerable time and effort, I think, again, that it is unlikely to have been a significant factor in Dr Ross’s failure to respond to examination reports in the period May 2001 to January 2002. Moreover, in the period from July 1999 to May 2001 Dr Ross filed 11 patent applications; he also responded promptly to a number of examination reports on those applications, and in June 2001 he filed a further 11 patent applications. This is not consistent with a person who is preoccupied with other matters, and so I do not find this reason for exercising discretion persuasive.

16. In his letter giving details of his bereavements, Dr Ross also mentioned that he was made redundant in January 2000 and this resulted in a long and complex employment dispute. But again, I must point out that the period I have to consider is the period from May 2001 to January 2002. Again this event occurred some time before the period under consideration, and as I have already noted, during the period leading up to May 2001, Dr Ross responded promptly to a number of examination reports. Accordingly I am not satisfied that this is a reason for exercising discretion to allow the late response.
17. At the hearing, as we were identifying the precise reports to which Dr Ross had submitted late or no responses, he stated that he had no record of having received the third examination reports on cases 99/01, 99/02 and 99/03. These reports were issued independently on 6 July, 2 July and 24 July 2001 respectively. In addition a further letter on 99/02 was issued on 11 July 2001 correcting an error in the report issued on 2 July 2001. Dr Ross could offer no reason as to why he may not have received the four separate communications in July, other than to say that he had been in the USA on business during that period. He argued that he always responded promptly to reports from the Office and the fact that he didn't respond where these reports were concerned was a strong indication that he had not received the reports. Clearly it is not possible for Dr Ross to prove that he did not receive these reports. Equally, I cannot prove that he did.
18. Firstly, I should say that I am satisfied that the reports and subsequent letter did issue. Since the hearing, I have inspected all the files relating to these applications. There is nothing in any of them to suggest any error had occurred which might have resulted in the reports not being prepared for issue. On the contrary, the evidence points to the reports having been issued on all of them. Duplicate copies of the reports appear on all the files and there is no sign of any originals. Of course, this is not in itself proof that the several items were despatched. Had it been a single communication then I would have to consider whether an error within the Office might have resulted in a letter and report not issuing. In this case however, we are dealing with four separate communications issued on four separate dates. I cannot accept that all four failed to issue. Having come to the conclusion that these reports were issued by the Office, I have to consider whether the mail services might have failed to deliver these items to Dr Ross. I think it extremely unlikely that the mail services might have failed on four separate occasions over a period of 3 weeks or so. In order to form a view as to what may have taken place I will consider what has happened from the time that the reports were issued to see whether that sheds any light on the situation.
19. Following the presumed issue of these reports, the next action on these cases was a letter sent by Dr Ross to the Office headed "Patent Applications relating to Three Dimensional Information Structures and Frameworks, Knowledge Processing, Content Sharing, Human-Computer-Content Interaction and Software Solutions 1999-2002". In the letter, which is dated 21 February 2003 and was received in the Office on 24 February, Dr Ross begins by saying "Thank you for the recent letters relating to various Patent Applications which are listed in the Appendix." The appendix contains a list of all of Dr Ross's applications, including all those being considered here. As there seemed to be no correspondence from the Office on these cases which might be regarded as 'recent' at the time he wrote, I asked Dr Ross which cases he was writing about in this letter. He replied that it was the 2000 cases, which I take to mean cases with his reference 2000/, for example 2000/01, 2000/02 and 2000/04 which we are considering here. Dr Ross said that as far as he was concerned the 99 cases had been dealt with, and he couldn't understand why they had not been granted.

20. When Dr Ross was informed by letters that, whether or not his letter of 21 February 2003 was considered to be a response to the last examination reports, he had not responded within the deadlines set, he replied with a letter dated 19 March 2003 on cases 99/01 and 99/02, indicating that he wished to continue with the applications and apologising for “the delay in responding to your earlier letter”. He then goes on to explain that the main reason for the delay is that a lot of effort had gone into producing prototypes and working examples of the inventions. This was followed by a further letter dated 31 March 2003 accompanied by revised specifications for *inter alia* cases 99/01, 99/02 and 99/03.
21. Following the appointment of the hearing, Dr Ross put forward further reasons for the delayed response, and I have already considered those above. It was not until the hearing itself that Dr Ross suggested that he had not received the reports referred to. He said that he had not been made aware of the dates of these reports before the hearing so had not realised that he did not have them. However, the dates were set out in at least two letters issued to Dr Ross on each of the cases before the hearing. Also, as I have mentioned above, Dr Ross filed amendments on 1 April 2003 on cases 99/01, 99/02 and 99/03, which is not consistent with his allegation that he had not received the examination reports. If Dr Ross did not receive the reports in July 2001, he would have had no indication of any deficiencies in those cases that required amendment. That, coupled with the fact that from the time he was first informed that he had not responded to the relevant examination reports on 11 March 2003, to the day of the hearing Dr Ross had not suggested that he had not received the reports, leads me to the conclusion that in all probability Dr Ross did receive these reports. Thus I cannot accept this as a reason for exercising discretion to allow a late response.
22. Turning now to cases 2000/01, 2000/02 and 2000/04, at the hearing Dr Ross insisted that he had responded to the second examination reports issued on these cases on 17, 8 and 10 May 2001 respectively. I should say that this was the first time that Dr Ross had asserted that he had responded specifically to these examination reports. In addition to the letter of 18 May 2001 which set out various options that he was considering, Dr Ross argued that he had sent amendments on these cases at the end of May. In support of this contention, he indicated that he had on his computer, files which indicated that he had revised the specifications at the end of May 2001. He also said that he kept meticulous records of all the actions carried out on his applications, and could produce evidence in the form of proofs of posting and Office filing receipts to show that he had filed responses. As he did not bring any of this evidence to the hearing, I gave Dr Ross a period of two weeks from the date of the hearing to submit any such evidence that he had.
23. Dr Ross sent copies of a number of documents and computer screen prints in response, but unfortunately, most of the documents sent are of no relevance to the issue. Copies of Office filing receipts relate to other documents or to dates preceding the issue of the second examination reports. The copies of the recorded delivery receipts also show dates before the second reports were issued so cannot support Dr Ross’s claim. The computer screen prints show that revised documents entitled 2000/01-2000/04 were saved on 23 and 24 May 2001. However, this evidence on its own is not sufficient to persuade me that these revised documents were filed at the Office. In addition, since the hearing I have had further investigations carried out within the Office to check whether any responses from Dr Ross had been mislaid or misfiled in any of his other applications. Nothing came to light. Finally, I note that when I asked Dr Ross about his letter of 21 February 2003, he said that it concerned

his '2000' applications. If he had, as he claims, sent responses on these cases in May 2001, it is not clear why he was writing about these as if responses were outstanding. I have to conclude that no response was filed by Dr Ross within the periods set on cases 2000/01, 2000/02 and 2000/04.

24. In his document which he entitles 'Evidence' filed on 20 June 2003, Dr Ross refers to two precedent cases in support of his case. One is a decision of the Comptroller under Council Regulation (EEC) No 1768/92 in the matter of application no. SPC/GB/97/080 in the name of Abbott Laboratories for a supplementary protection certificate for a medicinal product [unreported decision SRIS O/302/02]. In that case, the applicants were 6 days outside the six month period allowed for applying for a supplementary protection certificate. In that case the period was a statutory period, and it was argued for the applicants that such a period should be extendible under Rule 110(1) of the Patent Rules 1995. Although in the present case we are dealing with the extension of a period specified by the Comptroller rather than a period fixed by statute, in both cases the granting of any extension is at the discretion of the Comptroller, so similar principles apply. In the Abbott case, the hearing officer acting for the Comptroller considered the decision in *Heatex Group Ltd's Application* [1995] RPC 546. In that case an applicant was seeking the Comptroller's discretion to file a request for examination after the normal period had expired. In that case the hearing officer had said that:

"... an applicant should not suffer loss of rights through unforeseen circumstances. Put another way, the circumstances leading to the failure must have been set against a continuing underlying intention to proceed with the application or patent."

In the *Heatex* case, the applicant had initially decided not to proceed with the application, but later concluded that that decision was a mistake. Because there had not been a continuing underlying intention to proceed with the application, the request for an extension was refused.

25. In applying this principle to Dr Ross's applications which are the subject of this decision, there is little evidence of what Dr Ross's continuing underlying intention was. It is clear from his actions now that he wishes to proceed with these applications, but is not clear cut whether this was his intention throughout. Whilst the dates for response to these applications passed, he was continuing with the prosecution of others of his applications. This might be taken as an indication that he had decided not to proceed with these applications. Dr Ross has admitted that he may not have given at least his '99 applications the attention they deserved, and he had concentrated on producing prototypes and working models of his invention, rather than attending to his patent applications. Neither of these admissions go as far as indicating that he was abandoning the applications, though the latter comes close, given that he should have been aware of the consequences of failing to respond on time as pointed out in the covering letter accompanying each examination report. However, I am prepared to give Dr Ross the benefit of any doubt in this regard and find that there was a continuous intention to proceed with the applications. That alone, of course, is not sufficient reason for exercising discretion to allow a late response.

26. The other precedent cited by Dr Ross is a trade mark case as yet unreported, *Ministry of Sound Recordings Limited v Virgin Records Limited*, 17 April 2003, in which one party sought an extension of time for lodging an appeal against a decision of the Comptroller in her role as registrar of trade marks. I see little in this decision that may lend weight to Dr Ross's case. The appointed person who was hearing the case decided that although the party seeking a discretionary extension of time did not have a compelling reason to justify the extension, due weight could be given to the public interest in determining whether discretion should be

exercised where it would not otherwise have been justified. I can see no public interest aspect that may have a bearing in Dr Ross's favour in the present case. The appointed person also referred to the decision in *Siddiqui's Application* [unreported decision SRIS O/481/00] where the appointed person had said, when dealing with a request for a discretionary extension, it is incumbent on the applicant for the extension to show that the facts merit it, and this requires the applicant to show clearly what he has done, what he wants to do, and why it is that he has not been able to do it. As I have already indicated above, I do not think that Dr Ross has been able to show good reason why he was unable to meet the deadlines set on the six cases being considered here.

27. To summarise, I have concluded that Dr Ross did receive the relevant examination reports on the six cases under consideration, and that he did not make proper responses within the times specified. As I have said above, I am prepared to give him the benefit of the doubt and conclude that he had intended to proceed with the applications. However, this alone is not sufficient to exercise discretion in his favour. He still needs to show good reason why he was unable to meet the deadlines set. Having considered the various reasons put forward by Dr Ross, I find that none of them is sufficient to warrant the exercise of discretion to allow the period for response to be extended. Thus, I order that applications GB9915892.5, GB9915893.3, GB9915894.1, GB0001507.3, GB0001508.1 and GB0008824.5 be refused for failure to comply with the requirements of Section 18(3) of the Patents Act.

Appeal

28. In accordance with the provisions of Part 52 of the Civil Procedure Rules and Practice Direction 52, any appeal against this decision shall be lodged with the Patents Court within 28 days of the date of this decision.

Dated this 29th day of August 2003

G M ROGERS

Deputy Director, acting for the Comptroller

THE PATENT OFFICE

