

PATENTS ACT 1977

IN THE MATTER OF

Patent Application GB 9501879.2

in the name of Uchechukwu Osita Ezeh

DECISION

1. This decision arises out of the failure of the applicant, Dr Ezeh, to reply in time to an Official letter under section 18(3). In the last few months there has been correspondence between the examiner and Dr Ezeh on the matter without agreement being reached. This, together with the fact that the normal four and a half year period allowed under section 20 of the Act for putting the application in order for grant has now passed plus Dr Ezeh's present residence in the United States of America and unavailability to attend a hearing in person, means that the case has come to me to decide on the papers.

Background

2. The application, which relates to a female sterilization clip, was filed on 31 January 1995 without a claim to priority. A search report citing two documents subsequently issued on 22 April 1996 and the application was published on 7 August 1996. Substantive examination was requested on 5 February 1997 but prior to that, on 27 January 1997, Dr Ezeh rang the Office to say that he had dispensed with the services of the Patent Agent he had previously employed to prosecute his application and was now intending to take over the prosecution himself.

3. The examination report under section 18(3) issued direct to Dr Ezeh at his home address in London on 30 March 1998. In essence the report raised two major objections against the invention claimed, one of lack of novelty with reference to one of the cited documents and one of lack of inventive step with reference to both of the cited documents.

In line with usual Office practice a period of six months was set for reply to the examination report with the usual warning that the application may be refused unless a reply was received by the end of that period. The latest date for reply, which was clearly set out in a letter accompanying the examination report, was therefore 30 September 1998.

4. On 12 May 1999, there having been no reply to the report of 30 March 1998, the Office issued a letter informing Dr Ezeh that it was intending to treat his application as being refused on 31 July 1999, the final date for putting it in order for grant, inviting him if he wished to make comments about this imminent termination. This procedure is again standard Office practice and acts as a safeguard for applicants in the event that something untoward has happened, most obviously that an examination report might have been lost in the post, preventing an applicant from making a reply.

5. Dr Ezeh wrote to the Office on 16 June 1999 apologising for his late reply to the letters of 12 May 1999 and 30 March 1998 and asking for a delay to the end of the year for him to come up with answers to the objections raised in the examination report. The reason he gave for the late reply was that he had been "tied down with doing and writing up my MD doctoral (PhD) thesis".

6. The examiner, having considered the reason given by Dr Ezeh, replied on 21 June 1999 and said significantly "I am of the opinion that your busy state arising from your Ph.D is not an exceptional or extenuating circumstance that can justify the exercise of discretion to extend the deadline of 30 September 1998, that was set for a response to the examination report, by over eight months". He repeated the intention to refuse the application and gave Dr Ezeh until 21 July 1999 to request a hearing or present further comments. Unfortunately, as transpired in a later conversation between the examiner and Dr Ezeh, the letter of 21 June 1999 was not received by Dr Ezeh.

7. In fact the next response from Dr Ezeh was a letter dated 26 July 1999 constituting a full response to the examination report of 30 March 1998, which the examiner acknowledged in a letter of 30 July 1999 whilst making the point that the principle issue

outstanding was the lack of response to that report within the time limit that was specified. Since the examiner's letter issued only one day before the final date for putting the application in order the examiner pointed out that the case would be forwarded to a Senior Officer to decide whether it should be refused but the hearing would not take place before fourteen days during which time Dr Ezech could inform the Office if he wished to attend.

8. On the same day as sending this letter the examiner had a telephone conversation with Dr Ezech who explained that he had not received the Official letter of 21 June 1999 and raised a number of other points as to why he had not replied to the Official letter of 30 March 1998 in due time. The examiner prompted him to put those points in writing and a letter was faxed to the Office on 8 August 1999 referring to three factors which may have contributed to the lateness of Dr Ezech's reply as well as making clear that he was unable to attend a hearing because of his programme in the United States of America.

9. I shall examine the three factors more closely when I later set out the reasons for my decision but, in summary, they are that (a) Dr Ezech was misled by the Official letter of 12 May 1999 which he took as resetting the deadline for replying to the latter of 30 March 1998, (b) there had been a strained relationship between himself and the patent agents he had previously employed to process his patent application and (c) he had moved around quite a lot since taking over the handling of his patent affairs from the patent agents and letters did not get to him in spite of him taking steps to get them redirected. I would add a fourth factor and that is the one referred to by Dr Ezech in his letter of 16 June 1999 namely that he was tied down with doing and writing up his MD doctoral (PhD) thesis.

Assessment

10. Referring to the above four factors it would seem appropriate for me to deal with them in chronological order so as to fully judge their impact in the context of the background to the case that I have set out above.

11. Firstly then, I need to consider the strained relationship between Dr Ezech and the

patent agents he had employed in the early stages of the prosecution of his patent application. There is no need for me to go into detail about why Dr Ezech considers the relationship to have broken down because it is clear from the papers on file that some time after issue of the search report in April 1996 and publication of the application in August 1996, but before January 1997 when Dr Ezech got in touch with the Office about the matter, he had dispensed with the services of his agents. All this was well before issue of the examination report to which Dr Ezech failed to respond in time and therefore cannot be considered to have contributed directly, if at all, to the late response. I therefore do not find that it helps him in his argument that the Office should continue with the assessment of his case.

12. Second, is the argument that Dr Ezech was heavily involved with his PhD thesis. There is an established practice before the Office that, in order for the Comptroller's discretion to be exercised in favour of the granting of an extension to the time specified for reply to an examination report, an applicant must have some adequate reason which is peculiar to the applicant or application in suit. On this basis it might have been the case, and I put it no higher, that if Dr Ezech had got in touch with the Office prior to the end of the period for response to the examination report with evidence of his difficulties the examiner might have exercised discretion in his favour and granted him a short extension. Certainly that extension would have been no more than a month or so and would have taken account of the need to have the application in order for grant by 31 July 1999, in contrast to the request in Dr Ezech's letter of 16 June 1999 for a date beyond that final date. However, Dr Ezech's omission to get in touch with the Office until prompted almost nine months after 30 September 1998, the due date for reply, in my view justifies the decision of the examiner not to exercise the Comptroller's discretion. It is incumbent upon all applicants to take careful notice of the date for reply set out clearly in all examination reports issued by the Office, not least for the reason typically defined under the heading "Consequence of failing to reply" in the letter of 30 March 1998 sent to Dr Ezech that the application may be refused unless a reply is received by that date. In view of such a warning it is not good enough to ignore the need to reply by a set date only to request the Comptroller's discretion at a later date when prompted. Rarely will the Comptroller's discretion be exercised in favour of the applicant in

such circumstances and Dr Ezeh is therefore not exceptional in having his request refused.

13. The next factor I must consider as contributing to the problems experienced by Dr Ezeh is the interpretation to be given to the Official letter dated 12 May 1999. This letter, known in the Office as the "WR1 letter" is conventionally sent to applicants who have not responded to an earlier examination report and whose applications are fast approaching the four and a half year period from their earliest date when they will be refused. Having looked at that letter I can well understand why Dr Ezeh considered that the date for reply to the examination report was being reset. However, that is not the intention of the letter. The true intention is to alert an applicant to the seriousness of not having replied to an examination report and giving him or her a chance to put things right in the event that something unforeseen has occurred. What obviously comes to mind is that an examination report sent by the Office might have got lost in the post. In that case the WR1 letter would serve as a prompt for the applicant to point out to the Office that something had gone wrong and, in this extreme case, would allow the report to be re-issued if the evidence supported the applicant. All this may lead to the need to extend the period for putting the application in order for grant which explains the references to extensions of time in the WR1 letter. In spite of the imperfections in the wording of the WR1 letter I do not see how it can have contributed to the failure of Dr Ezeh to reply in time to the Official letter of 30 March 1998 since it was clearly issued way after the six month period set in that letter. Indeed it may be said that the WR1 letter served its purpose in alerting Dr Ezeh to do something urgently about his application. There is, however, no way that it can have had an influence on what he understood he needed to do between 30 March 1998 and 30 September 1998.

14. Finally I must deal with the fact that Dr Ezeh has moved quite a lot since taking over the handling of his patent affairs from his patent agents. In his letter to the Office of 8 August from an address in the United States of America he makes the point that he took adequate steps to redirect his letters but in spite of that not all of them were received. Indeed, as I have already said, it seems that he did not receive the letter from the Office dated 21 June 1999. What is clear though for the sake of this decision is that it is beyond doubt that he received the examination report of 30 March 1998 sent to his London address because he refers to that

report in his letters to the Office dated 16 June 1999 and 26 July 1999. In the former letter he asks for an extension of time to reply to the 30 March 1998 letter “so that I will be able to provide the answer to your questions” and in the latter he clearly indicates it to be a response to the March 1998 letter. The fact that he did not receive the letter from the Office dated 21 June 1999 is regrettable but can in no way explain why he did not reply in time to the examination report of 30 March 1998.

Conclusion

15. I have come to the conclusion that none of the reasons advanced by Dr Ezeh when considered individually or taken together are sufficient to avoid refusal of his application. The consequence of his dispensing with the services of his patent agent has put the onus on him to bear the burden of the prosecution of his own application. A significant part of this burden is the need to respond to letters from the Office in a timely manner. The reality of this is reflected in letters from the Office, such as the 30 March 1998 letter received by Dr Ezeh, for not only is a time for reply clearly set at the outset of the letter but also the consequences of a failure to reply is emphasised under an emboldened heading later on in the letter. Whilst I appreciate that Dr Ezeh may have been a busy man because of his work on his PhD, and may not have understood all the problems of prosecuting his application without professional help, it does not excuse his failure to contact the Office before the set date of 30 September 1998 to explain his difficulties and to seek advice. To wait until nearly nine months after that date to make any sort of response to a letter he had clearly received, and then only when prompted by the Office, does not provide me with sufficient reason to exercise discretion in his favour and I therefore refuse the application.

16. Any appeal against this decision must be lodged within a period of 14 days from the date of the decision, this decision concerning a matter of procedure.

Dated this 25th day of August 1999

D L Wood

Deputy Director, acting for the Comptroller

THE PATENT OFFICE