

## **PATENTS ACT 1977**

IN THE MATTER OF a request  
under Rule 110(4) of the Patents Rules 1995  
to extend the time limit for requesting  
preliminary examination and search  
for patent application GB0026317.8

### **DECISION**

#### **Background**

1. Patent application GB0026317.8 was filed on 27 October 2000 in the name of Paul Neil MacMullen. In accordance with rule 25 of the Patents Rules 1995, the request for preliminary examination and search should have been filed, on Patents Form 9/77 together with the prescribed fee of , 130, within twelve months from that date, i.e. by 27 October 2001. No such request was filed within that period. However, in accordance with rule 110(4), on 15 July 2002 Mr MacMullen filed a Patents Form 52/77 and fee requesting an extension of the period. The form was accompanied by a Patents Form 9/77 and fee. Also filed was a Patents form 53/77 and fee which is payable if the extension request is allowed.
2. After considering the evidence filed in support of the extension request, the Patent Office took the preliminary view that the request should not be allowed. The Office's view, together with the reasons for it, was set out in a letter to Mr MacMullen dated 24 September 2002. Mr MacMullen did not accept the preliminary view and asked that a decision be taken on the basis of the written evidence.
3. The evidence filed in support of this request consists of letters signed by Mr MacMullen dated 24 December 2001, 12 July 2002, 7 July 2003 and 30 September 2003.

#### **The facts**

4. Following the filing of the patent applications, the Patent Office sent a standard letter to Mr MacMullen on 3 November 2000 in which it was explained that to continue with his application he had to file a Patents Form 9/77 and a fee of , 130 requesting preliminary examination and search by 27 October 2001. The letters also contained the following passages:

##### **Time limits**

A11. You should ensure that all documents mentioned in this letter reach this Office by the date(s) given. If you provide a good reason either in writing or over the telephone, it may be possible to extend the date(s) in this letter. You should not, though, rely on this. It is in your own interest to send the documents in on time.

A12. The date(s) marked with an asterisk (\*) can be extended by one month, but you will have to pay an extra fee of , 135 to get an extension. Further extensions of time over the one month are possible. However, to get a further extension you will need to make a special request with additional fees and any further extension will be allowed only if there is a good reason for it.

### **AWarning**

A13. If you do not send all the documents or information requested in this letter by the date(s) given, your application may be taken as withdrawn.@

As no request for preliminary examination and search had been received by the Office by 27 October 2001 or within the period of one month following that date, the application was recorded on the register of patents as withdrawn. In a letter to the Patent Office dated 19 June 2002 the patent agents Urquhart-Dykes & Lord said that they had been asked to contact the Office to establish the status of the application and referred to a letter Mr MacMullen had sent to the Office on 24 December 2001 for which he had not received a reply.

5. In his letter of 24 December 2001, Mr MacMullen explained that due to his impoverished state he was unable pay for the qualified professional help necessary to produce and submit the technical abstract and claims for his application@. In its reply the Office explained that it had no record of receiving Mr MacMullen's letter of 24 December 2001 and that the application had been withdrawn. This led to Mr MacMullen filing a Patents Form 52/77 and fee to request an extension of the period for filing a request for preliminary examination and search.
6. In his letter dated 12 July 2002, which accompanied the Patents Form 52/77, Mr MacMullen explains that he had been endeavouring to raise finance to fund his project and meet his agents' fees to complete his patent application. In particular, he was hoping to obtain financial support from an organisation called 'Carbon Trust' which he was having difficulty contacting.
7. In coming to its preliminary decision, the Patent Office took the view that Mr MacMullen did not need professional help to file a Patents Form 9/77 and fee and concluded that his difficulty in acquiring finance for such help and to fund his project was not a sufficient reason to allow the extension request.
8. After viewing the statements contained in Mr MacMullen of 24 December 2001 and 12 July 2002 letters and the supporting evidence, I invited Mr MacMullen to explain what action he took to acquire money to pay the , 130 fee for preliminary examination and search. This led to him submitting his letters of 7 July and 30 September 2003. In those letters, he explains that at the time the fee was due his debts ran into many thousands of pounds and all credit lines were exhausted. As a consequence, he was unable to raise , 130 to pay the fee. In addition to the usual lending institutions he says he tried unsuccessfully to acquire funds from newspapers, motor companies and private and commercial parties. As evidence of his

efforts in this regard Mr MacMullen has supplied samples of letters he sent to such bodies, including >Carbon Trust= from which he was optimistic about acquiring funds

### Assessment

9. Rule 110(4) reads:

*Without prejudice to paragraph (3) above, a time or period prescribed in the rules referred to in that paragraph may. Upon request made on Patents Form 52/77, be extended or further extended if the comptroller thinks fit, whether or not the time or period (including any extension obtained under paragraph (3) above) has expired; and the comptroller may allow an extension, or further extension, under this paragraph on such terms as he may direct and subject, unless he otherwise directs, to the furnishing of a statutory declaration or affidavit verifying the grounds for the request.*

10. Among the rules referred to in paragraph (3) is rule 25(2) which prescribes a period of 12 months from the priority date or the date of filing if there is no priority date, for filing a request for preliminary examination and search.
11. Rule 110(4) does not prescribe any particular standard that has to be met for a request to be allowed and so the Comptroller has very broad discretion. That said, in assessing such requests the Patent Office has applied the reasoning set out by the Hearing Officer in *Heatex Group Limited's Application [1995] RPC 546*. In his decision on that case, the Hearing Officer took the view that for discretion to be exercised in the applicant's favour it must be shown that the applicant had a continuing underlying intention to proceed with his application. He went on to say that to allow an extension on the basis of a change of mind would be a massive assault on public certainty and one which the Patent Office is right to resist.
12. I am, of course, not bound by the decision in *Heatex* given the very broad discretion at my disposal. However, I can find no fault with the Hearing Officer's reasoning in that case with regard to the concept of a continuing underlying intention and believe it is right to apply that reasoning to the extent that I consider it applicable and appropriate to the circumstances of the present case.
13. I think it is also worth bearing in mind the observation made by Aldous J in *Ament's Application [1994] RPC 647*. That case was concerned with a request to restore a patent under section 28 of the Act, which requires the proprietor to show that he took reasonable care to pay the renewal fee. In his judgement in the case Aldous J made the following comment.
- A party who intends to pay a renewal fee, but cannot do so, must establish that he has taken reasonable care to pay.
14. In applying the less stringent standard used in *Heatex* I believe it is equally reasonable to

take the view that an applicant who intends to request preliminary examination and search but cannot pay the required fee must establish that he had a continuing underlying intention to file the request and pay the fee.

15. If it can be shown that Mr MacMullen did not have , 130 to pay the preliminary examination and search fee but made genuine and continuing efforts to obtain that sum, then I believe that that would be an indication that he did have a continuing underlying intention to file the request for preliminary examination and search within the prescribed period.
16. The only evidence the Patent Office had in reaching its preliminary decision was the statements by Mr MacMullen contained in his letters of 24 December 2001 and 12 July 2002. In those letters Mr MacMullen refers only to his efforts to obtain money to cover the cost of professional help in pursuing his application and says nothing about trying to acquire , 130 to pay the preliminary examination and search fee. However, it would appear from the statements he makes in the subsequent letters he has submitted, following my invitation to him to supply further evidence, that his impecunious situation was such that he did not even have enough money to pay the , 130 fee. It is also apparent that he was making strenuous attempts at the time to obtain that sum from a variety of sources. The samples of the letters he has supplied with his statements bear witness to the effort he was making.
17. Mr MacMullen has not explained why he was in such a poor financial situation other than to say he had substantial debts. However, I am satisfied from the evidence he has provided that he was making continuous efforts to obtain funds not only to develop his invention but also to pay the fee required for preliminary examination and search. This to me is a clear indication that he had a continuing underlying intention to request preliminary examination and search and there is nothing to suggest that he digressed from that objective and has since change his mind.

### **Conclusion**

18. With the benefit of the additional evidence Mr MacMullen has supplied, which was not available to the Patent Office when it reached its preliminary decision, I am prepared to allow an extension of time under rule 110(4) for Mr MacMullen to file a Patents Form 9/77 and fee of , 130 to request preliminary examination and search of his application.

Dated this 14<sup>th</sup> day of October 2003

MC Wright  
Assistant Director, acting for the Comptroller

**THE PATENT OFFICE**