



BL O/036/06

1st February 2006

PATENTS ACT 1977

APPLICANT Samuel Abekah-Mensah

ISSUE Patent application GB0114888.1.
Failure to respond to the examination
report within the period specified under
section 18(3).

HEARING OFFICER P M Marchant

DECISION

1. Mr Abekah-Mensah applied for a patent on 19 June 2001. The invention relates to a matrix of switches, preferably mounted on a panel, for connecting selected ones of a first set of communication ports to selected ones of a second set of ports. The specification explains that existing "patch" panels of this kind use jumper cables for making interconnections. After a time the cables become entangled, no doubt as a result of repeated unplugging and re-plugging. Replacement of jumper cables with switches avoids this problem.
2. The application followed the usual course. A search report was issued on 5 December 2002 and the application was published, with serial number GB2378608, on 12 February 2003. An examination report issued on 18 December 2003 asserting that the invention was substantially wholly anticipated, and lacked inventive step in view of the prior art which had been found in the search.
3. The examination report specified that a response had to be filed by 18 June 2004. Setting a period for response in examination reports is a consequence of the terms of subsection 18(3) which reads as follows; I have underlined the relevant words:

If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the specification so as to comply with those requirements

(subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

The “requirements” that this subsection refers to are the requirements with which an application must comply in order for a patent to be granted. Section 76 prohibits any amendment which would add new subject matter.

3. The subsection provides that the comptroller may refuse the application if an applicant fails to meet its requirements. The meaning is that in the absence of a satisfactory reply by the specified date the expectation is that the application will be refused. However the wording gives the comptroller discretion to allow a late response. Practice and case law have established the manner in which this discretion is normally exercised.
4. It was usual at the time this report issued for a reply period of 6 months to be set for a first examination report, and a period of 6 months was duly set by the examiner in this case. (Practice changed in January 2005, and the normal period for reply is now four months with a two month extension on request, but the considerations in relation to failure to reply have not changed.)
5. In the present case, the need to reply within a fixed time period was made very clear. The first item in the covering letter of the examination report stated in bold that the “Latest date for reply” was 18 June 2004. The date was made especially prominent by being outlined in a box. The last item in the report read, in bold: “Consequences of failing to reply”, and then in normal type: “The application may be refused unless you reply to this report by the set date.” The period for reply, the prominence of the reply date in the covering letter and the passage setting out the consequences of failing to reply, all reflected the usual practice in setting out examination reports.
6. Mr Abekah-Mensah did not reply to the examination report by the date specified, and in fact did not communicate with the Office at all until a letter was sent to him by the Patent Office on 2 November 2005. That was some 18 months after the final date for reply. The letter explained that the end of the overall period for putting the application in order was approaching, and that in the absence of a reply to the examination report, it was intended to treat the application as refused.
7. In response to that letter, Mr Abekah-Mensah contacted the examiner, explained that he had not intended to allow his application to lapse and discussed with the examiner what steps he would have to take in order to proceed with it. The examiner explained that he would have to provide a satisfactory reason for failing to reply by the due date, and indeed for failing to respond at any time since. Mr Abekah-Mensah wrote on 11

December 2005 explaining that he had been disappointed with the examination report, as a result of which he had not fully appreciated the “critical timelines associated with the report” as he put it. He also explained that he had been trying to raise funds to progress the application, and had been unemployed since January 2005 which had further hindered matters.

8. The examiner considered these points and came to the conclusion that they did not justify exercise of the comptroller’s discretion to allow a late response to the examination report. He set out his response in a letter of 15 December 2005 and indicated his intention to refuse the application, pointing out that Mr Abekah-Mensah could request a hearing on the matter if he wished.
9. Mr Abekah-Mensah accepted the offer of a hearing. Since the period for putting the application in order was due to expire on 19 December 2005 he filed a form 52/77 extending that period to 19 February 2006 and a hearing was arranged for 27 January 2006.
10. As I have said, practice and case law have established the manner in which the comptroller’s discretion is normally exercised in considering late responses to examination reports. The main case in this respect is *Jaskowski’s Application* [1981] RPC 197. It established the principle that something peculiar to the particular applicant or application in suit was needed in order to exercise discretion favourably. In this case, the difficulties of communicating with an applicant in the US, which was given as a reason for delay, was considered to be a normal circumstance and did not warrant an extension of time. Later clarification of the circumstances which might be considered to warrant favourable consideration included extreme complexity of the subject matter, extreme remoteness of the applicant, illness, serious accident, fire, explosion, wars, and calamities which destroy documents or dislocate normal operations.
11. These considerations are set out in paragraphs 18.55 and 18.56 of the Manual of Patent Practice, a copy of which was provided for Mr Abekah-Mensah.
12. Mr Abekah-Mensah accepted that his situation did not correspond with any of these circumstances but nevertheless asked for positive consideration of his request. He explained that he had also made a US application on the present invention and had spent a considerable sum of money with an organization in the USA which was pursuing the application on his behalf. He had allowed the GB application to fall into abeyance during that time, which was the reason he had not responded, but had received advice from this organization that a GB patent could still be obtained notwithstanding the considerable quantity of relevant prior art that had been adduced against it. It was this that had prompted him to try to reactivate the GB application.
13. I have a great deal of sympathy for Mr Abekah-Mensah. It seems

reading between the lines that he may have received poor advice from this organization. I do not think a patent professional truly acting in his interest could have advised that a patent of any value could be obtained given the substantial anticipation of his ideas by the prior art. However whatever the rights and wrongs of that advice, the issue I have to decide is whether there is anything in the circumstances that Mr Abekah-Mensah has explained, that provide grounds for the favourable exercise of the comptroller's discretion in the matter of a late response to the examination report.

14. I do not find there are any such reasons. It seems clear first of all that Mr Abekah-Mensah had received and had read the examination report of 18 December 2003. There was a slight suggestion that he may not have received the report initially, since he asked the examiner to send him a copy of it when he contacted the examiner in November 2005. But it is clear he had seen it at the time, since he gave his disappointment with its content as his initial reason for failure to reply. And indeed in presenting his case at the hearing, Mr Abekah-Mensah said he did not want to suggest he had not been aware of it.
15. Secondly, I don't think Mr Abekah-Mensah can have been unaware of the importance of replying by the final date in order to keep his application in play. As I have set out above, the reply date and the consequences of not replying form a very prominent part of the report and these are set out in direct language. Mr Abekah-Mensah can have been in no doubt on reading them that by failing to reply he was likely to lose the application.
16. I understand from what he has said that his disappointment may have caused him to put replying out of his mind, or he may have decided to concentrate on his US application instead. Mr Abekah-Mensah was also looking for ways to develop the invention which may have occupied his time and effort in other directions than pursuing the patent application, but none of that in my view can provide grounds for exercising discretion to allow a late response. There appear to have been no circumstances which actually prevented Mr Abekah-Mensah from replying, as would be required to exercise discretion. On the contrary, it appears that for whatever reason he neglected to reply and was prepared to allow the application to rest or lapse or be refused, whatever the consequences of failure to reply might be. It seems that it is only more recently, either through developments with his US patent application and advisors, or prompted by the letter from the Patent Office warning of refusal, that he thought about reactivating the application.
17. Mr Abekah-Mensah mentioned his loss of employment in January 2005 as a reason for omitting to reply. I appreciate that that situation may have caused some disruption to his normal activities and affairs, but one would expect that disruption to be temporary and in any event it was some 6 months after the final date given in the examination report so can have had no bearing on the initial failure to reply.
18. A consideration which has sometimes been introduced where the

comptroller has discretion to extend time periods and the applicant appears to have taken no action to pursue the case over a relatively long period of time is whether the applicant had a continuing underlying intention to proceed with the application. I think in the present case, given the long delay in responding to the examination report, Mr Abekah-Mensah would have had to show not only that there were circumstances peculiar to the case that prevented reply by the end of the reply period, but also that he had during this time a continuing underlying intention to proceed with the case. However it appears to me that he has shown by his actions, that is to say, not responding to the examination report, and not contacting the office until the last minute, that he did not have a continuing underlying intention to proceed, and I think on this count too, it would not be right to exercise discretion in Mr Abekah-Mensah's favour.

19. I consequently refuse the application for failure to respond to the examination report issued under section 18(3), within the time period specified in the report.

Appeal

20. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

P M Marchant

Deputy Director acting for the Comptroller