



BL O/089/07

29 March 2007

PATENTS ACT 1977

APPLICANT Don Hughes

ISSUE Whether patent application GB 0204156.4 complies with section 1(1)(a), whether the application should be refused under section 18(3) for late response to an examination report, and whether the period prescribed by rule 34 should be extended

HEARING OFFICER D J Barford

DECISION

Introduction

- 1 Patent application number GB 0204156.4 (“the application”) entitled “New Learner Plate”, was filed on 21 February 2002 in the name of Don Hughes, with no claim to earlier priority, and was published on 27 August 2003 as GB 2385702.
- 2 The application was accompanied by a request for combined search and examination – and for accelerated processing. On 18 March 2002 the examiner issued a report stating that the invention was not new - on the grounds that it had been disclosed by Mr Hughes when prosecuting an earlier application. Mr Hughes was given the opportunity to withdraw the application, and offered a refund of the search and examination fees, but responded that he wished to proceed. After further communication between the examiner and Mr Hughes, a formal search and examination report was issued on 13 November 2002 objecting amongst other things that the invention was not new. The report specified – under section 18(3) – a latest date for reply of 23 February 2004.
- 3 The normal period for putting the application in order prescribed under section 20(1) by rule 34 (“the rule 34 period”) expired on 21 August 2006, however this was extended to 21 October 2006 under rule 110(3). Mr Hughes eventually provided a response to the examiner’s report of 13 November 2002 on 6 December 2006 accompanied by a request to extend the rule 34 period by a further two months to 21 December 2006; and on 21 December 2006 Mr Hughes filed amended claims.

- 4 The examiner having proposed to refuse the application on the grounds that, amongst other things, (i) the invention is not new, (ii) the applicant failed to respond to the examiner's report within the period specified period under section 18(3), and (iii) the period prescribed by rule 34 as extended has expired and should not be further extended, the matter came before me at a hearing on 17 January 2007 at which Mr Hughes appeared in person. The examiner Mr Matthew Jefferson also attended.

Detailed chronology

- 5 As noted above, a search and examination report was issued on 13 November 2002 specifying – under section 18(3) – a latest date for reply of 23 February 2004.
- 6 No response was received and in due course an official letter was issued on 12 July 2006. This letter pointed out that the applicant had not responded to the examiner's report of 13 November 2002, warned that the Office therefore intended to treat the application as refused, explained that if the applicant wished to reply he should do so urgently explaining why the response was late, and stated that unless a response was received the application would be treated as refused shortly after 26 August 2006 (the unextended rule 34 period) - noting however that this deadline could be extended.
- 7 Mr Hughes telephoned the Patent Office on 5 October 2006, and as a consequence a further official letter was issued on the same date. This letter summarised the steps necessary to enable the application to continue and explained that Mr Hughes could extend the deadline by two months to 21 October by filing the necessary form and fee. I note that the letter states that “.. to proceed, you must file a response to the examiners report...”; and that a further copy of that report was enclosed with the letter.
- 8 A letter dated 15 October 2006 along with the form and fee to extend the rule 34 period were received by the Office on 17 October 2006. Mr Hughes explained that he was seriously ill during 2003 and early 2004 and had handed over business responsibilities to colleagues, but that he had got the all clear in 2004. There was no response to the examiner's report.
- 9 A further official letter was issued on 30 October 2006, acknowledging the extension of the rule 34 period to 21 October 2006, but noting that no response had been received to the examiner's report by that date, and stating that it was therefore intended to treat the application as refused.
- 10 This elicited a further telephone call from the applicant on 15 November 2006. Mr Hughes was again told that if he wanted to continue with the application he had to file a response to the examiner's report, but that it was unlikely in the circumstances that a further extension of the rule 34 period would be granted.
- 11 On 6 December 2006 a response to the examiner's report was received. Mr Hughes explained that his failure to respond in his letter of 15 October 2006

was “simply an oversight”, and requested a further extension of the rule 34 period to 21 December 2006.

- 12 In response, the examiner issued a detailed letter dated 13 December 2006 proposing to refuse exercise of the comptroller’s discretion either to allow late filing of the examination response or to further extend the rule 34 period, summarising other outstanding objections including lack of novelty and offering a hearing.
- 13 A reply to this letter was received by fax on 21 December 2006 in which Mr Hughes responded in some detail to the points raised by the examiner and included amended claims as noted above.

The application

- 14 The application relates to “L” plates for learner drivers.
- 15 The application as filed on 21 February 2002 has two claims which read:
1. This invention provides a simple but effective alternative to the conventional and ubiquitous “L” plate.
 2. This new invention is distinctive, more-eye catching and more easily visible than the current “L” plate, thereby making a significant contribution to road safety.
- 16 The amended claims filed outside the extended rule 34 period on 21 December 2006 read:
1. This invention provides a simple but effective alternative to the conventional and ubiquitous ‘L’ plate for vehicles, which has always been a red letter ‘L’ on a solid white background
 2. The physical attributes of the invention are shown as a simple letter ‘L’ (for Learner) printed in red on a fluorescent solid yellow background.
 3. This new invention can be produced by normal printing process on paper, board, plastic or cling film and attached to any vehicle.
 4. The fluorescent ink used to provide the solid yellow background ensures a distinctive physical appearance, as well as causing light reflection in areas of poor visibility.
 5. The invention will make a significant contribution to road safety.
- 17 Whatever the wording of the claims, there is no dispute that the applicant considers the invention to be a learner plate having a red “L” on a fluorescent yellow background, with a view to enhancing visibility and thereby improving safety.

The law

- 18 Relevant are sections 1(1), 2(1) and (2), 18(2) and (3), and 20(1); and rule 34(1). These read:

Section 1

1.-(1) *A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say -*

(a) the invention is new;

(b) ...

(c) ..

(d) ..

Section 2

2.-(1) *An invention shall be taken to be new if it does not form part of the state of the art.*

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

Section 18

(1) ..

(2) On a substantive examination of an application the examiner shall investigate ...whether the application complies with the requirements of this Act and rules and shall determine that question ..

(3) 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 application so as to comply with those requirements .. , 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.

Section 20

20.-(1) *If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.*

Rule 34

34.-(1) *... the period within which an application for a patent shall comply with the Act and these Rules-*

(a) .. shall be-

(i) the period of four years and six months calculated from its declared priority date or, where there is no declared priority date, from the date of filing of the application; or

(ii) the period of twelve months calculated from the date the first report under section 18 in respect of that application is sent to the applicant, whichever expires the later:

Novelty

- 19 The examiner argues that the invention is not new, having been disclosed by Mr Hughes when prosecuting an earlier application number GB 9817137.4. This earlier application, entitled “Dual Purpose Driver Plates”, was filed on 7 August 1998, and published on 16 February 2000 as GB 2340282. It relates essentially to a double sided “L” plate, having an “L” on one side and a different graphic on the other. This earlier application has pages numbered 1 to 10, page 10 being an illustration in colour of a red L on a solid yellow background. Furthermore, during prosecution of that application, Mr Hughes in a letter dated 14 June 2001 states:

“I fully accept the listings you have made showing that my double sided dual-purpose product is not novel and therefore appears to be a non-starter. However, I do believe that if I were to request you to ignore say, pages 1 to 9, it still leaves in my original application what I consider to be a valid application for a patent on a novel product, i.e. an L plate with a fluorescent yellow background”.

- 20 The application having been published, this letter was placed on the part of the application file open to public inspection. The examiner argues that since the letter was thereby made available to the public before the priority date of the invention, 21 February 2002, it forms part of the state of the art under section 2(2).

- 21 Mr Hughes says that he thought his correspondence with the Patent Office was confidential. I note however two letters that were sent to Mr Hughes dated 20 November 1998 and 18 January 2000. The first, from the patent examiner, includes the following paragraph:

“**Important:** you should avoid giving any additional technical information about the invention (such as a modification) either by way of amendment or in an accompanying letter, as this would prevent you from subsequently obtaining a patent based on this information.”

- 22 Enclosed with that letter was a booklet entitled “*How to prepare a UK Patent Application*”. Paragraph 42 of this booklet outlines the publication procedure and specifically states that:

“Not only is the specification published but also all the official correspondence between the applicant and the Office is laid open to public inspection. Any matter which you would rather not be made public should not, therefore, be included in correspondence to the Office”.

- 23 The second letter, which notifies publication of the earlier application, includes the following paragraph:

“On the publication date, details of your application will be entered in the Register of Patents. From then onwards those details, and the application file, will be open to public inspection at the Patent Office”

- 24 I note that all of this went to Mr Hughes well before his letter of 14 June 2001. Whether or not Mr Hughes understood or even read this correspondence, it is

clear that he didn't act upon it. Nevertheless, the fact remains that his letter unambiguously forms part of the state of the art under section 2(2).

- 25 The statement from Mr Hughes' letter quoted above, when read alongside the figure on page 10, which it is clearly intended to be, clearly discloses an "L" plate having a red "L" and a solid fluorescent yellow background. There is very little technical disclosure beyond this in the present application (GB 0204156.4) other than that set out in the third paragraph on page 1. This states:

"As is current manufacturing practice in the production of conventional "L" plates, the new invention can be produced by normal printing process on paper, board, plastic or cling film.

The new invention can also be made to be fixed to a vehicle by tying, sticking or in window cling film format."

However I note that there is a passage identical to this on page 2 of the earlier application, so there is nothing new here.

- 26 Accordingly I conclude that the application fails because the invention as claimed is not new. Having carefully read the application, I can find no subject matter anywhere in the application that could be used to remedy this, and none was drawn to my attention at the hearing.

Exercise of comptroller's discretion

- 27 Having so concluded I do not need to go on to consider whether or not discretion should be exercised to allow a belated response to the examiner's report or to extend further the period prescribed by rule 34. However since these issues were discussed at some length in correspondence between the examiner and the applicant, and also at the hearing, for completeness I shall address them briefly.
- 28 Under the law as it currently stands, the period for replying to an examination report can be extended as of right by two months - provided the request is made before the two months is up. The comptroller has discretion to grant further extensions depending on the circumstances. In the present case, the date set for reply was 23 February 2004 and the first substantive response was received on 6 December 2006 – a delay of over 2 years 9 months.
- 29 It is well established practice that requests for significant discretionary extensions of time need to be supported by very strong reasons. Examples of such reasons include extreme complexity of the invention, remoteness of the applicant – or the applicant's suffering illness or accident. However there remains a requirement that the applicant will exercise due diligence in prosecuting his application; this requirement being driven by the important need to protect the public interest from unnecessary uncertainty and delay regarding the grant of patent rights.

- 30 Here, although Mr Hughes has explained that he was seriously ill during 2003 and early 2004 and had handed over business responsibilities to colleagues, he has also said that he got the all clear in 2004. At the hearing he explained that his failure to respond to later correspondence was due to continuing severe health problems in June, July and August 2006, which he was clear of at the end of 2006. He also pointed to experiencing serious problems with his business – particularly in 2002 and 2003. He has provided no evidence in support of any of these submissions but in any case they do not, it seems to me, justify his subsequent continued failure to respond. Indeed he goes some way to acknowledge culpability here, specifically referring to an “oversight” and to a “mistake”. Firm, unambiguous reminders were given on 5 October 2006, 15 October 2006, 30 October 2006 and 15 November 2006. Not until 6 December 2006 was a substantive response to the examiner’s report received. I accept Mr Hughes’ submission that he is a busy man with many calls on his time, but so, I would expect, are the majority of patent applicants.
- 31 Taking all of the circumstances into account there is no doubt to my mind that the way in which Mr Hughes has prosecuted his patent application falls a long way short of diligent. Accordingly I refuse the request to extend the period for replying to the examination report. Given that decision, the question of further extending the period prescribed by rule 34 is academic.

Conclusion

- 32 Having regard to the above, I refuse the application on the grounds that the invention is not new; and I can see no subject matter anywhere in the application that could be used to remedy this. I also refuse the application through the failure of the applicant to respond within the period specified under section 18(3).

Appeal

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

DAVID BARFORD

Deputy Director acting for the Comptroller