

PATENTS ACT 1977

APPLICANT Wonderland Nurserygoods Co., Ltd

ISSUE Whether to allow divisional patent
 application No. GB1119141.8
 to be filed out of time

HEARING OFFICER Stephen Probert

Michael Harrison (of Harrison IP) represented the applicant

Hearing date: 2nd December 2011

DECISION

- 1 Patent application GB1119141.8 was filed on 4th November 2011 as a new (or “divisional”) application based on “earlier” application GB0723946.0. But the compliance date of the earlier application was 24th November 2011, which means that the divisional application was filed after the period ending three months before the compliance date — ie. it was filed too late.
- 2 The examiner reported that the divisional application did not satisfy the requirements for ante-dating¹ (ie. it cannot be treated as a divisional application) because of the late filing. The applicant requests that the comptroller exercise discretion to extend the period allowed for filing a divisional application. After hearing Mr Harrison on behalf of the applicant, I decided that in the specific circumstances of this individual case it was appropriate to exercise discretion in the applicant’s favour. These are my reasons for so deciding.

The Law

- 3 The rule which governs the time for filing divisional applications in this case is rule 19², and in particular part (3)(b) which requires that a divisional application must be filed before the end of the period ending three months before the compliance date of the earlier (parent) application.
- 4 As this period of time is prescribed by the rules³, the comptroller may, if he thinks fit, extend the period. The power to do this is found in rule 108(1)². However, as paragraph 15.21 of the Manual of Patent Practice states,

¹ Section 15(9) of the Patents Act - see Annex A

² ... of the Patents Rules 2007 (as amended). See annex A.

³ And is not among those listed in Parts 1 and 2 of Schedule 4 of the Rules.

“... discretion to allow a divisional application to be filed out of time will normally be exercised only if the applicant shows that the circumstances are exceptional and that he has been properly diligent ”

The Arguments

- 5 Mr Harrison gave me several reasons why I should consider that the circumstances in this case were exceptional, and that he had been diligent.
- 6 He told me that, at the relevant time, he had been under a considerable amount of pressure at work, following a merger between his firm and another firm. The partner who had been dealing with this application had retired from the joint practice and Mr Harrison had taken on his partner’s workload in addition to his own.
- 7 I acknowledge the difficulties that Mr Harrison faced due to the increased workload, and I have a lot of sympathy with him, but sadly I don’t think “increased workload” is exceptional today.
- 8 Mr Harrison told me that he has been in practice for forty years and he never files divisional applications, even at the EPO. He admitted that he was not aware of the rule that requires divisional applications to be filed at least three months before the end of the compliance period. He knew that a divisional application had to be filed before the earlier application is granted, but he thought that this was the only time constraint. In view of what happened in this case, Mr Harrison has spoken with a number of fellow patent attorneys, and they all told him that they also were not aware of the three month time limit.
- 9 Now I had assumed that all patent attorneys would know that divisional applications cannot be filed in the last three months of the compliance period. It is not as though this is a new rule — it has been in the rules since the end of the last century ⁴. Nevertheless, this is the second hearing I’ve had in less than six weeks in which a qualified and highly experienced patent attorney has assured me that he was not aware of the three month limit. All the same, ignorance of the law is not a satisfactory reason for exercising discretion.
- 10 Mr Harrison suggested that many patent attorneys might be unfamiliar with the three month limit; perhaps that explains why it is normal practice within the Patent Office for examiners to include a standard piece of text referring to the three month time limit when raising an objection to plurality of invention. The standard text says:—
- “You may wish to consider filing divisional applications. Any such applications should normally be filed no later than 3 months before the expiry of the period for putting the present application in order, and before grant. **WARNING-** no automatic reminder will be issued regarding the filing of divisional applications.”
- 11 This standard text usually appears when plurality is being reported for the first time, except when there is not enough time left for a divisional application to be filed.
- 12 On this occasion, despite there being twelve months left before the compliance date, the standard text was not included in the first examination report (dated 24th November 2011) when plurality was reported. I don’t know why the text was

⁴ And before the Patents (Amendment) (No. 2) Rules 1999, the period was six months.

omitted ⁵, but unfortunately for the applicant it meant that they did not get the standard message advising them that any divisional application would have to be filed at least three months before the compliance date (as well as before grant, which they already knew). Mr Harrison told me that if the warning about the three month limit had been included in the examination report, he would have made sure that the divisional application was filed in time.

13 Mr Harrison also told me that he has been taking instructions from a US patent attorney on this case, and therefore it was likely that the US patent attorney would also have noticed a warning about the three month limit if one had been given. This seems reasonable, and I assume that is why the standard clause refers to the three month limit — ie. so that recipients can take note and file divisional applications on time.

14 So, under normal circumstances the applicant would have been warned that any divisional applications must be filed no later than three months before the compliance date. That did not happen in this case, and I accept that the omission can fairly be described as 'exceptional'.

15 Mr Harrison also addressed me on the matter of proper diligence. He accepted that he ought to have known about the three month limit, and so perhaps he could have been more diligent. He admitted that he had relied on the warning that was given in the second examination report (dated 30th June 2011). This only referred to the grant deadline, despite the fact that the period for filing a divisional would expire before the reply period set for the examination report. Consequently when Mr Harrison was discussing the question of a divisional application with the US attorney who was taking the lead in prosecuting the application, he passed on the same deadline (ie. grant of the earlier patent) that the examiner had flagged up in the examination report.

16 Mr Harrison also considered the section of the Act that deals with the filing of divisional applications — section 15(9) — and thought that it said the same as the second examination report - ie. that the only deadline for filing a divisional application is the grant of the earlier patent. Section 15(9) opens with the words:

“(9) Where, after an application for a patent has been filed and before the patent is granted - ”

17 Although the section goes on to say that the divisional application must be filed “... in accordance with rules ...”, Mr Harrison assumed (incorrectly) that those rules would not relate to the **time limits** for filing divisional applications since the time allowed for filing a divisional application appeared to have been established in the opening words of the section - ie. after an application has been filed and before the patent is granted.

18 Having taken care of the time issue (or so he thought), and because the US attorney was responsible for the actual preparation of the divisional application, Mr Harrison felt that he did not need to look at the rules (or any other manuals, guides etc.) relating to divisional applications until he received instructions from the US attorney; at which point (as it turned out) it was too late to file the divisional application on time. I have noted Mr Harrison's submission concerning

⁵ There may have been a good reason for its omission.

the wording of section 15(9) in my decision because it was part of his argument, and because I haven't heard it before. It is not part of the *ratio* of my decision. ⁶

Summary

- 19 The first examination report (on the earlier application) did not include the usual standard warning clause specifically drawing the applicant's attention to the three month deadline. When, in the second examination report, the examiner did give the applicant a warning about the need to file a divisional application before a certain time, he only referred to the grant deadline. This was misleading because, by this stage, there was no possibility of the application being sent to grant until after the three month deadline had passed ⁷. In these circumstances I think it is right to exercise discretion under rule 108(1) to extend the period of time prescribed by rule 19 in order to allow this divisional application to be treated as a 'new' application for the purposes of section 15(9).
- 20 This means that divisional application GB1119141.8 shall be treated as having, as its date of filing, the date of filing of GB0723946.0. I am therefore remitting application GB1119141.8 to the examiner to continue with the examination process.
- 21 **NB. The compliance period of this divisional application has expired; but it can be extended by two months — under rule 108(2) — provided a request is filed on Patents Form 52 before 23rd January 2012.**

S PROBERT

Deputy Director acting for the Comptroller

⁶ To be clear, Mr Harrison did **not** suggest (and I did **not** accept) that rule 19 is, or might be, *ultra vires*.

⁷ Unless the applicant responded to the examination report before the end of the reply period. In which case the divisional application would no doubt have been filed sooner because Mr Harrison would have known that there was a possibility that the examiner might send the application to grant.

Annex A

Rule 19

New applications filed as mentioned in section 15(9)

- 19.—(1) A new application for a patent may be filed as mentioned in section 15(9)—
- (a) before the end of the relevant period; or
 - (b) if earlier, before the earlier application is terminated or withdrawn.
- (2) Such an application must include a statement that it is filed as mentioned in section 15(9).
- (3) For the purposes of this rule the relevant period is—
- (a) where an applicant is notified under section 18(4) that his earlier application complies with the requirements of the Act and these Rules, two months beginning with the date of that notification; or
 - (b) in any other case, the period ending three months before the compliance date of the earlier application.

Rule 108

Extension of time limits

108.—(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.

- (2)
- (3)
- (4)
- (5) Any extension made under paragraph (1) or (3) shall be made—
 - (a) after giving the parties such notice; and
 - (b) subject to such conditions,as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may be extended (or further extended) for a period of two months only.
- (6) An extension may be granted under paragraph (1) or (3) notwithstanding the period of time prescribed by the relevant rule has expired.

[**NB.** Rule 19 is not among the provisions listed in Parts 1 and 2 of Schedule 4.]

Section 15(9)

Date of filing application

15(9) Where, after an application for a patent has been filed and before the patent is granted -

- (a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and
- (b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),

the new application shall be treated as having, as its date of filing, the date of filing the earlier application.