



PATENTS ACT 1977

APPLICANT	John Jackson
ISSUE	Whether a late-filed response to an examination report for patent application number GB1613728.3 should be accepted
HEARING OFFICER	B Micklewright

DECISION

Introduction

- 1 Patent application number GB1613728.3 was filed on 10 August 2016 in the name of John Jackson. The application was published on 21 March 2018 as GB2553758 A. The application proceeded as normal until a second examination report was issued on 02 November 2018 which set a latest date for reply of 02 January 2019. Although a letter from the applicant was received on 12 November 2018, no formal reply to this examination report was received by the Office until the applicant contacted the office on 09 September 2020 enquiring about the status of his application. A response to the examination report was finally received in a letter dated 08 October 2020. The examiner was minded not to exercise discretion to accept the late-filed response to the examination report of 02 November 2018. The applicant continued to argue that the late response should be accepted, and the matter was therefore referred to me for a decision on the papers.

Compliance Period

- 2 I note that the compliance period for this application expired on 10 February 2021 and no request to extend the period has been made. The two-month period following this date for making such a request has expired and the period cannot now be extended. Even if the late-filed response is accepted the examiner will therefore only be able to consider whether the amendments currently on file bring the application into order for grant. It will not be possible for the applicant to file any further amendments.

The law

- 3 Section 18 of the Patents Act 1977 (“the Act”) relates to substantive examination of a patent application. Section 18(3) states (emphasis mine):

(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 (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.

4 Section 117B of the Act provides for extensions of time limits specified by the comptroller. Section 117B(2) states:

(2) Subject to subsections (4) and (5) below, the comptroller shall extend a period to which this subsection applies if -

(a) the applicant or the proprietor of the patent requests him to do so; and

(b) the request complies with the relevant requirements of rules.

5 Rule 109 states the following:

109.- (1) A request under section 117B(2) must be—

(a) made in writing; and

(b) made before the end of the period prescribed by paragraph (2).

(2) The period prescribed for the purposes of section 117B(3) is two months beginning immediately after the expiry of the period to which section 117B(2) applies.

6 Section 18(3) gives the comptroller discretion as to whether to refuse the application or not following a failure to comply with this provision. The Manual of Patent Practice¹ sets out how this discretion is generally exercised, and the practice examiners follow in relation to extending the periods for reply to examination reports and accepting late-filed responses. Paragraph 18.53 states:

18.53 An automatic extension of two months (or to the end of the compliance period, as prescribed by rule 30 for the purposes of section 20, if this expires sooner) to the period set in an official report can be obtained by requesting it in writing (see also 18.53.1). The request must be received before the end of the period as extended. Only one extension of this type is available. Further extensions may be available at the examiner's discretion if an automatic two month extension has already been granted. Any request for a further extension must be made before the end of the period as already extended and an adequate reason must be given (see 18.56-18.57.1).

7 Paragraph 18.54 states:

18.54 When a reply is received after the expiry of the specified period and the automatic extension period of two months has passed, the reason, if not already given, should be asked for. If no reason is forthcoming the late response cannot be accepted. Where a reason is provided, the examiner may exercise discretion under s.18(3) to accept the late response, even though no extension to the specified period

¹ The Manual of Patent Practice is available at [Manual of Patent Practice - Guidance - GOV.UK \(www.gov.uk\)](http://www.gov.uk)

can be granted. Discretion should be exercised favourably if the examiner is satisfied that the failure to respond was unintentional at the time that the specified period expired. This is consistent with the statutory test that applies to requests for reinstatement under s.20A (see 20A.13-16 for guidance on the meaning of unintentional). However, there is no statutory requirement that the failure to respond must have been unintentional in order for the late response to be accepted, and thus the discretion accorded by s.18(3) may be exercised in appropriate circumstances even if this criterion is not met.

- 8 Paragraphs 18.55 to 18.57.1 set out the factors which should be considered in deciding whether to allow a discretionary extension of time or to exercise discretion to accept a late-filed response. Paragraph 18.54 above makes clear that discretion should be exercised favourably if the examiner is satisfied that the failure to respond was unintentional at the time the specified period expired.

Events surrounding the failure to reply to the examination report

- 9 The examiner issued an examination report under section 18(3) on 02 November 2018 with a latest date of reply of 02 January 2019.

- 10 The applicant sent a letter to the Office dated 07 November 2018 which was received on 12 November 2018. This letter begins:

"Thank you for your letter dated 02 November 2018, being conscious that a latest reply date has been given as 02 January 2019 ..."

- 11 The purpose of the letter was to query which earlier report the examiner's latest report was referring to when it referred to "my previous examination report".

- 12 In an email dated 05 December 2018 the applicant requested an extension for the latest date for reply to the "examination report and letter dated 27th of November for GB1613728.3 which I believe can be two months to march the 4th". The letter of 27 November was the letter the examiner sent to clarify to which previous report he was referring to in his report of 02 November 2018 and the two-month extension requested by the applicant seems to relate to the latest date for reply set in the 02 November report. Although not required, Mr Jackson provided the following reason for the extension:

"The reason for this request is due to some missing paperwork, which is most frustrating and I hope to clarify matters soon."

- 13 No further correspondence or clarification was however received from Mr Jackson before the 04 March extended reply date.

- 14 In fact, there is no correspondence on file until a letter from the applicant dated 04 September 2020 and received by the Office on 09 September 2020 which, amongst other things, included an enquiry about the status of the application in suit. In response the Office wrote to the applicant on 24 September 2020 to explain that no response had been received to the examination report of 02 November 2018. This letter also set out what the applicant must do if he wished to request that his application be allowed to proceed on the basis of a late filed response. The applicant responded in a letter dated 05 October 2020 which included a response to the

examination report as well as reasons why he had not responded within the period set for reply. Following further correspondence from the Office and a further opportunity I gave the applicant to provide any further submissions or evidence, the applicant provided further comments in a letter dated 11 November 2020 but received on 24 December 2021 (this later was dated in error) and in an email dated 08 March 2021.

Assessment

- 15 Mr Jackson said in his correspondence that he believed that he did not receive the examination report in question. He said: "I have been through my files and can find no letter dated 12/01/2018 nor 02/01/2018, which given I usually do respond to examiners letters means, that I did not receive them." Note that there appears to be an error in the dates referred to here, but I accept that the latter date refers to the examination report in question, which was issued on 02/11/2018. Mr Jackson commented that, based on some previous enquiries, he believed that on occasions, due to workloads and backlogs, the Office took a longer time to respond to responses to reports and "was unaware of any problem". Following comments from the examiner he commented that he must have viewed the report in question on IPSUM.
- 16 In his final email of 08 March 2021 Mr Jackson made the following comment:

"I can only re iterate that a response was sent to the examiner in proper order, however no response was given from the examiner that was received by me, ..., the first I knew of any such response, which appears is on ipsum, is when I queried why I had not received the letter, ... and being as I do make response to correspondence from the IPO then, it would be assumed that the only reason that this was not corresponded to, is due to not receiving the correspondence from the examiner."
- 17 He also stated that "*there is no intention to claim something that I had deliberately let lapse, in the sense that I had no idea that was lapsing due to not receiving correspondence.*"
- 18 In my view Mr Jackson's letter of 07 November 2018, in which he states, "Thank you for your letter dated 02 November 2018", and his request to extend the latest date for reply to the examination report, point to him having received the report by post. I therefore conclude that, on the balance of probabilities, Mr Jackson did receive the examination report in question.
- 19 Mr Jackson's recollection of events seems to be a little confused, but, having considered all his submissions, I accept that, despite my finding in the paragraph above, he genuinely believes that he did not receive a copy of the report in the post and possibly viewed the report on IPSUM (the Office's online file inspection service). In his most recent correspondence Mr Jackson claims that he did not deliberately let the application lapse, and that the only reason he would not have filed a response was if he did not receive the examination report.
- 20 It is difficult to determine what Mr Jackson's intentions were two years ago in relation this application, and what the actual reason was for his failure to reply to the examination report. It may be that he mislaid the report after requesting the extension of time and now thinks that he never received the report. In his latest

correspondence Mr Jackson seems to be saying that he would not be seeking to file a response now if he had deliberately let it lapse.

- 21 I am not fully convinced that Mr Jackson unintentionally failed to respond to the examination report before 04 March 2019. But that is not the assessment I must make. Rather, I must weigh the evidence on the balance of probabilities. Considering all the evidence and submissions provided by Mr Jackson, particularly those in his most recent communication, I conclude that it is more likely than not that Mr Jackson's failure to respond to the examination report within the specified period as extended was unintentional, even though I have concluded that, on the balance of probabilities, he did receive the report. As I have said, he may well have mislaid the report which is why he now thinks that he did not originally receive the report.

Conclusion

- 22 Having found that the applicant's failure to reply to the examination report within the specified period as extended was unintentional, I conclude that discretion should be exercised to allow the late-filed response of the grounds that the failure to respond within the specified period as extended was, on the balance of probabilities, unintentional.
- 23 I therefore refer the application back to the examiner for consideration of the response dated 05 October 2020.

B Micklewright

Deputy Director, acting for the Comptroller