



## PATENTS ACT 1977

APPLICANT	Metabiotech Corporation
ISSUE	Whether to exercise the discretion of the Comptroller under rule 108(3) to extend the compliance period for GB2004670.2 under section 20.
HEARING OFFICER	Dr L Cullen

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### DECISION

- 1 This decision concerns the issue of whether to exercise the discretion of the Comptroller to accept a further Form 52 to extend the compliance period for patent application GB2004670.2 as is possible under section 20 (s.20) of the Patents Act 1977, as amended (the Act), and rule 30 (r.30) and rule 108 (r.108) of the Patent Rules 2007, as amended (the Rules).
- 2 For the avoidance of doubt, this decision is not concerned with any technical aspect of the application related to inventive step, which remain to be addressed.

### Introduction

- 3 This application was initiated under the Patent Cooperation Treaty (PCT). The UK national phase application was published as GB2581599A. Upon the issuance of the first examination report under s.18(3) of the Act, the compliance date under s.20 of the Act was set at 11 November 2022 in accordance with r.30(2)(b) of the Rules.
- 4 The compliance period was first extended as-of-right under r.108(2) by a request made using the necessary Patents Form 52 dated 21 July 2022 and paying the associated fee. The compliance period was thus extended as-of-right for a period of 2 months until 11 January 2023.
- 5 Two subsequent requests to further extend the compliance period at the discretion of the Comptroller under r.108(3) have been made on this application and these are the subject of the present decision. The first request relates to a Patents Form 52 dated 13 December 2022 and the second relates to a Patents Form 52 dated 10 March 2023.

## The Relevant Law

- 6 S.20(1) of the Act entitled "*Failure of application*" states (my emphasis added in bold):

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

- 7 S.18 of the Act concerns the substantive examination process leading to the grant or refusal of a patent application. For the present case, paragraphs (2)-(4) of this section of the Act are relevant. These state (my emphasis added in bold):

*(2) On a substantive examination of an application **the examiner shall investigate**, to such extent as he considers necessary ....., **whether the application complies with the requirements of this Act and the rules** and shall determine that question and report his determination to the comptroller*

*(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) If the examiner reports that the application, whether as originally filed or as amended ....., **complies with those requirements at any time before the end of the prescribed period, the comptroller shall notify the applicant of that fact and**, subject to ..... and on payment within the prescribed period of any fee prescribed for the grant, **grant him a patent.***

- 8 The prescribed period is set out in r.30 which is entitled "*Period for putting application in order*" and reads as follows (my emphasis added in bold):

*(1) **The period prescribed** for the purposes of sections 18(4) and 20(1) (failure of application) **is the compliance period.***

*(2) For the purposes of paragraph (1), subject to paragraphs (3) and (4), **the compliance period is —***

*(a) four years and six months beginning with—*

*(i) where there is no declared priority date, the date of filing of the application, or*

*(ii) where there is a declared priority date, that date; or*

***(b) if it expires later, the period of twelve months beginning with the date on which the first substantive examination report is sent to the applicant.***

*(3)...*

*(4)...*

9 R.108 is entitled “*Extension of time limits*” and, for the present case, the relevant paragraph is paragraph (3) which states (my emphasis added in bold):

*(3) The comptroller **may, if he thinks fit, extend or further extend** any period of time prescribed by the rules listed in Part 2 of Schedule 4 where—*

*(a) a request is filed on Patents Form 52; and*

*(b) **the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs.***

10 However, paragraph (3) of r.108 is subject to the limitations set out in paragraphs (6) and (7) of the same rule which read as follows (my emphasis added in bold)::

*(6) **An extension may be granted** under paragraph...(3) notwithstanding the period of time prescribed by the relevant rule has expired.*

*(7) **But no extension may be granted in relation to the periods of time prescribed by the rules listed in Part 3 of Schedule 4 after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired.***

11 At this point, it should be noted that the compliance period as set down under r.30 is listed in both part 2 and part 3 of Schedule 4 to the Rules. Thus the compliance period can only be extended by periods of two months at a time and it is possible to make a request to extend the compliance period anytime within the two-month period immediately following the end of the compliance period.

12 S.117B of the Act entitled “*Extension of time limit specified by the comptroller*” states as follows

*(1) Subsection (2) below applies in relation to a period if it is **specified by the comptroller in connection with an application for patent, or a patent***

*(2) ...*

*(3) An extension of a period under subsection (2) above expires  
(a) at the end of the period prescribed for the purposes of this subsection, or  
(b) **if sooner, at the end of the period prescribed for the purposes of section 20 above.***

*(4) ...*

*(5) ...*

The period set for response to an examination report under s.18(3) of the Act is such a specified time period.

## Analysis

### *First request for exercise of discretion dated 13 December 2022*

- 13 The cover letter provided by the agent on behalf of the applicant in support of the first request for a discretionary extension stated as follows (my emphasis added in bold):

*“We request the available as of right extension of the deadline for response to the Examination Report dated 14 November 2022 and **further extension of the compliance period under Rule 108(3) in order to provide more time for responding to the Examination Report and to put the application in order for grant.**”*

- 14 This appears to seek a further extension to the compliance date to, in effect allow the applicant to take advantage of an as-of-right extension to the specified period under s.117B for responding to an exam report under s.18. In this case the examiner had set a specified period of 1 month from the date of the report – this was a further exam report under s.18(3) and the compliance date was approaching. The additional two-month as-of-right extension to the period to respond to the exam report sought by the applicant in this instance would take the application beyond the compliance date which had already been subject to its as-of-right extension under r.108(2). Seeking the two months allowed under s117B(2) and r.109(2) does not provide the basis for having a specified period extend beyond the compliance date or past the end of the compliance period. This is clear from s.117B(3)(b).
- 15 As was explained previously, and in greater detail, in Intellectual Property Office (hereafter IPO) Decision BL O/144/12 (hereafter *Optinose’s application*)<sup>1</sup>, a request for a discretionary extension under Rule 108(3) has three requirements:
- (i) a completed F52 as referred to in part (a) of this rule;
  - (ii) grounds for the discretionary extension request, as referred to in part (b) of the rule; and
  - (iii) evidence in support of these grounds, also, as referred to in part (b) of the rule
- 16 The first request for a discretionary extension under r.108(3) made on 13 December 2022 did not provide suitable “*grounds for the discretionary extension request*”, as referred to in part (b) of the rule. The grounds for this request for a discretionary extension appear to be the need for more time to respond to the Examination Report (dated 14 November 2022). No further information was provided as to why these grounds should be accepted.
- 17 As I will discuss in more detail below, suitable grounds (and evidence in support of those grounds) for the exercise of discretion to extend the compliance period must, in the words of *Jankowski’s Application*<sup>2</sup>, be “*peculiar to the particular applicant or application in suit*”. Unless the examiner has no objections to raise when they first

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<sup>1</sup> For full text of decision BL O/144/12 see IPO patents decisions database at [Intellectual Property Office - Patents Decision \(ipo.gov.uk\)](https://www.ipso.gov.uk/patents-decision/O/144/12) specifically [Patent Decision \(O/144/12\) \(ipo.gov.uk\)](https://www.ipso.gov.uk/patents-decision/O/144/12)

<sup>2</sup> *Jankowski’s Application* [1981] RPC 197

examine an application, they will issue an examination report under s.18(3) identifying the issues that they consider need to be addressed if a patent application is to be granted. The examiner also sets a specified period for the applicant to respond to this report. The applicant will have to reply to that examination report in order to proceed with the application. This is the usual or normal way that examination of a patent application proceeds. Thus, this is not something specific or unique to the present case.

18 Furthermore and for the avoidance of doubt, I consider that the applicant also did not furnish any further information or details that could be considered to meet the third requirement referred to in *Optinose's Application*, i.e. the requirement under r.108(3)(b) for "*evidence supporting the grounds of the request...*". There is no detail of the circumstance that merits the exercise of discretion requested.

19 The request of 13 December 2022 to extend the compliance period is thus refused.

*Second request for exercise of discretion dated 10 March 2023*

20 As explained by the examiner in their letter to the applicant dated 16 December 2022 and also as forewarned by the examiner in their examination report dated 26 January 2023, the request for a discretionary extension had not been accepted and so the question that remained to be answered was whether the application was in order when the compliance period expired on 10 January 2023. The examiner indicated that, as a result, there was no further opportunity to amend the application. The examiner thus did not take account of the response and proposed amendments filed by the agent on behalf of the applicant on 7 February 2023 which was nearly one month after the end of the compliance period.

21 The agent acting for the applicant did not provide any further information in relation to why a discretionary extension should be granted until they received notification from the Tribunal section of the IPO that their patent application has been referred by the examiner for a hearing and accordingly agreement to a date for this hearing was being sought. The letter from the agent on behalf of the applicant dated 10 March 2023 was referred to me for consideration as the Hearing Officer appointed to deal with the present case. For some reason, the agent dealing with this case – until they were asked to agree a date for a hearing - failed to appreciate the significance of the compliance period and the impact of not dealing with the objection raised by the examiner that the reasons given for an exercise of discretion to extend it were not acceptable.

22 I note that this second request for a discretionary extension was filed on the last day of the two-month period under r.108(7) on which such a request could be made.

23 In the cover letter included with the F52, dated 10 March 2023, the agent made the following points on behalf of the applicant (my emphasis added in bold):

*"We understand that the Examiner is presently not accepting the previous reasons provided for the discretionary extension. We are therefore now providing more detailed reasons. **The reasons are based on both difficulties in obtaining instructions for responding to each examination report from the Applicant based abroad, and the complex nature of the subject matter under examination. Complex responses needed to be prepared for each***

**examination report. This was difficult to do with the Applicant being based abroad and further there being a long chain of communication between the UK representatives and the Applicant. Further gathering technical arguments and evidence involved more than one party in the process and in the decision making.**

*It must also be appreciated that up till now the Applicant has been very responsive to the Examiner's concerns and has dealt with each issue as completely as possible. The fact that there are outstanding issues is not due to a fault of the Applicant but is rather due to the complex nature of the subject matter under examination. The complexity is consistent with the Examiner citing a new prior art document in his latest Examination Report under Section 18(3) dated 26 January 2023, issued after the present compliance deadline, and setting a new time limit for response by 9 February 2023, which was complied with by the Applicant by filing submissions in response on 7 February 2023. It will be apparent from the Applicant's behaviour that the Applicant has always shown a continuing intention to proceed with the application."*

- 24 In contrast to the letter from the agent dated 12 December 2022, I consider that this letter dated 10 March 2023 does identify the grounds on which the applicant is seeking the exercise of discretion. These are (a) geographical location and distance between the US applicant and the UK agent and (b) the complexity of the subject matter of the patent application. Given the contents of this covering letter, I am a little surprised that this information could not have been provided with the first request seeking the exercise of discretion dated 10 December 2023.
- 25 I will now turn to consider whether the grounds identified are suitable for the exercise of discretion
- 26 The IPO Manual of Patent Practice (MoPP)<sup>3</sup> discusses the period specified for response to an examination report under s.18 in paragraphs 18.49 to 18.52 and provides further explanation in relation to the if, when and how such a period can be extended in paragraphs 18.53-18.60. It is established practice before the Office that factors which are considered normal or usual for patent applications are not, in themselves, grounds that justify a discretionary extension to a specified period. This is discussed in particular at MoPP paragraphs 18.55 and 18.56 which, as set out below, indicate that factors such as the applicant's location with respect to the UK and the complexity of subject matter of patent applications do not constitute good grounds for such an extension.
- 27 Paragraph 18.55 of MoPP indicates:

*"It should be borne in mind that the periods normally specified for response to the first s.18(3) report were determined having regard to all normal conditions, including the availability of an automatic two-month extension. While every case must be decided on its merits, the decision in Jaskowski's Application, [1981] RPC 197, furnishes some guidance in this matter. In that case the applicant's agent sought an extension on the grounds that delays were inevitably caused by the need to consult US Patent Attorneys who in turn had to seek instructions from the applicant. The hearing officer, in refusing the request, stated "s.18(3) clearly gives*

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<sup>3</sup> See discussion on practice in relation to section 18 of the Act in [Manual of Patent Practice - Guidance - GOV.UK \(www.gov.uk\)](https://www.gov.uk/guidance/manual-of-patent-practice)

the comptroller discretion to extend the specified period but unless a coach and horses is to be driven through the subsection he must have some adequate reason for exercising that discretion which is peculiar to the particular applicant or application in suit. I can see nothing abnormal in the chain of communications in this case... which could be regarded as an adequate reason for extending the specified period”.

Paragraph 18.56 of MoPP continues:

*It follows that factors which may be considered normal in relation to all or particular categories of application, e.g., the distance of applicant’s location from the UK, the complexity of the subject matter of the application or objections thereto, absence on business or holiday (see Decker’s Application BL O/10/96), and a preference of the applicant to defer response until reports of parallel applications abroad have been received do not constitute good grounds for an extension of the specified period”*

- 28 This practice was also considered recently in relation to discretionary extensions to the compliance period in IPO decision BL O/610/22 (hereafter *Xu’s application*)<sup>4</sup>. The relevance of factors such as geographical location and distance between the applicant and the agent; and complexity of subject matter of the patent application were considered alongside the additional factor that providing further opportunities for the applicant to put the application in order by extending the compliance period has to be balanced against the need to provide third parties with certainty (as to whether a patent will be granted or not).
- 29 Under the Act, the Comptroller is vested with discretion and in order to exercise this discretion, the Comptroller requires a reason which they must weigh against the desire to provide certainty to third parties. As noted by the Hearing Officer in *Xu’s application*, factors such as the number of extensions already made and how close an application is to being acceptable are part of the context of this decision in order to avoid the spectre of endless extensions. In the present case, although there has not been the same number of discretionary extensions sought as in *Xu’s application*, there still appears to be a wide margin of disagreement between the examiner and the applicant over whether the present application is inventive or not. Also, the exercise of discretion relates to factors that are peculiar to the specific case rather than to those that are usual or normal for patent applications in general.
- 30 In regard to ground (b), the complexity of subject matter of the patent application, as referred to by the applicant, I do not consider that the present application is abnormally complex for a patent application in the field of biotechnology. I note that the Hearing Officer in *Xu’s application* also had a similar argument raised before them in relation to the patent application in that case which was in the field of mobile telecommunications. I note also that they came to a similar view as I have in relation to the present case. The patent application in question in each of these cases was not abnormally complex for patent applications in their respective fields. Also, the issue of complexity in *Xu’s application* related more to the fact that the applicants decided to file 10 divisionals from one parent application rather than this being intrinsic to the technology for which protection was being sought. Thus, I do not accept that complexity of subject

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<sup>4</sup> For full text of decision BL O/610/22 see IPO patents decisions database at [Intellectual Property Office - Patents Decision \(ipo.gov.uk\)](https://www.ipso.gov.uk/patents-decisions), specifically [Patent Decision O/610/22 \(ipo.gov.uk\)](https://www.ipso.gov.uk/patents-decisions/decision/BL-O-610-22).

matter is an adequate reason in the present case to exercise discretion to extend the compliance period.

- 31 There is no statutory test for the application of discretion under r.108. It is generally accepted, however, that for the purpose of consistency at least, the criteria for reinstatement under s.20A of the Act offer useful guidelines for applying r.108. Ordinarily, the intention to proceed with the application is one of the considerations as to whether a request for reinstatement under s.20A of the Act might be allowed. In their cover letter dated 10 March 2023, the applicant has asserted that they have demonstrated an ongoing intention to proceed with this application. In this regard, I do note that the applicant has responded to all the examination reports while making use of the as-of-right extensions to specified periods available under s.117B and, on each occasion, has sought to address all the objections raised by the examiner by amendment and argument. This is fine as far as it goes, but it is not the whole story in my view. Despite three rounds of correspondence between examiner and applicant there still appears to be a significant gap between the examiner and the applicant as to the inventiveness of this application as evidenced by the fact that the examiner considers all the latest amended claims to lack an inventive step. Further, I consider that demonstrating a continuing intention to proceed, also includes being aware of the timescale within which the application needs to be brought to a conclusion to comply with the requirements of the Act and Rules. An applicant, and the agent acting on their behalf, needs to be aware of the compliance period and its significance and impact; that only one extension to the compliance period will be granted as-of-right and that any further extensions to it are discretionary and will relate to the specific circumstances of each case and, finally, that the compliance period under s.20 is not overcome by the possibility to have an as-of-right extension to a period for responding to an examination report under s.18 allowed by s.117B.

*Is there any other factor relevant to exercise of discretion?*

- 32 In their letter dated 10 March 2023, the agent has referred to the fact that the examiner has cited *“a new prior art document in his latest Examination Report under Section 18(3) dated 26 January 2023, issued after the present compliance deadline, and setting a new time limit for response by 9 February 2023, which was complied with by the Applicant by filing submissions in response on 7 February 2023”*.
- 33 Although this examination report was issued after the compliance date, it was in response to the applicants’ amended claims and the arguments provided in their letter dated 10 January 2023. This response from the applicant was filed with 1 day of the compliance period remaining. It was thus necessary for the examiner to consider it. In doing so, the examiner concluded that the application as amended lacks an inventive step and their report dated 26 January explains why the amendments and arguments put forward by the applicant do not overcome this objection. In this examination report, the examiner does explain why the examiner came to the view that the application was not in order when the compliance period ended on 11 January 2023.
- 34 The applicant and their agent, in their response of 7 February 2023, chose to provide further amendments and arguments as to why the examiner is not correct in their examination report dated 26 January 2023 and not on answering the question of why a discretionary extension was justified.



- 35 The fact that the examiner has indicated a date for reply on their examination report dated 26 January 2023 of 9 February cannot in my view be taken to imply that an extension to the compliance period will be granted automatically to allow the applicant to reply in light of s.117B(3)(b). Also, as the examiner was minded not to exercise discretion to extend the compliance period, s.101 applies and the matter is not finally resolved as the applicant would still have a right to be heard.
- 36 In my view the applicant and their agent have not paid enough attention to the significance and imminence of the compliance date. It would appear that they considered that a discretionary extension to the compliance date is in fact not discretionary but available as-of-right.
- 37 However, I am mindful that the purpose of s.20 of the Act to provide an element of certainty to third parties must be balanced with the need to allow for those cases where a little more time is sometimes required to put the application in order.
- 38 While I am not concerned in this decision with the technical question of whether the present application is inventive or not, I do note, firstly, that the examiner is objecting to all the claims in the application and so still considers that all features of the invention as claimed are obvious. This suggests that a little more time may not be enough in this case. Secondly, the examiner has made a change to the Inventive Step objection in light of the last set of amendments filed by the applicant on 10 January 2023. In effect, WO2014/201273 has replaced one of the two US patent documents, US2017/009274, cited in the combination Inventive Step objection being raised by the examiner (see reports from examiner dated 11 November 2021 and 14 November 2022). As explained by the examiner, in their report dated 26 January 20, this arose from the top-up and supplementary searching in response to the latest set of amendments filed on 10 January 2023. However, it cannot be denied that the applicant has had, in effect, only one-day of the compliance period – the last day - to consider and respond to this updated inventive step objection.
- 39 I think that this change to the inventive step objection is a circumstance peculiar to this application. The applicant was not able to respond to this updated inventive step objection before expiry of the compliance period the next day on 11 January 2023. They did provide a response on 7 February 2023, i.e., within 2 weeks of the examiner's report where this new document was first cited as part of the inventive step objection. However, the examiner did not consider these amendments and arguments because the applicant and the agent acting on their behalf did not identify circumstances that merited an exercise of discretion to extend the compliance date from 11 January 2023 and so allow these to be accepted.
- 40 I consider that the applicant should have one opportunity to respond to the inventive step objection partly based on this new citation. In light of this, I consider that it is appropriate for the Comptroller to exercise discretion to extend the compliance period in the present application to allow the applicants response dated 7 February 2023 to the examiner's report dated 26 January 2023 to be considered. The compliance period should accordingly be extended from 11 January 2023 to 11 March 2023.
- 41 As the compliance period is extended to 11 March 2023, I am satisfied that the set of amended claims dated 7 February 2023 can be treated as the latest amended claims

on file. I thus remit the application to the examiner to consider and report upon these amended claims under s.18 of the Act.

### *Further matters*

- 42 As it now stands, under r.108(3) the applicant would have the possibility to seek a further discretionary extension to the compliance date of 11 March 2023 within the two-month period immediately following this date, i.e., anytime up to 11 May 2023. As I have explained above, complexity of subject matter and geographical distance between agent and applicant are not sufficient grounds to justify the exercise of discretion to extend the compliance date. As I have also explained above, the exercise of discretion by the comptroller to extend the compliance date from 11 January to 11 March 2023 was made to allow the applicants' response to the inventive step objection involving a new document to be considered. It is merited because this is a specific circumstance that has arisen in relation to the present application.
- 43 I have asked the examiner to consider the amended claims filed on 7 February 2023 as a matter of urgency. If they consider that the amendments and related arguments overcome their outstanding objection well and good, the application can progress accordingly, as it will have been deemed to be in order before the compliance period ended. If the examiner maintains their view that the application as amended lacks an inventive step, then it would appear that matters are at an impasse.
- 44 When such an impasse arises during examination of a patent application, the applicant would normally be invited by the examiner to request an oral hearing before a senior officer at the IPO rather than continue with further rounds of correspondence and amendments – see MoPP paragraph 18.79 – in order to resolve matters. Alternatively, the applicant can ask for a decision from a senior officer at the IPO based on the papers on file.
- 45 However, whether to request a hearing or not on the outstanding technical issue is ultimately a matter for the applicant to decide. As a first step, it is necessary for the examiner to consider the latest set of amended claims and related arguments from the applicant dated 7 February 2023 and to share their conclusions with the applicant.

### **Conclusion**

- 46 Taking all of the above into account, I consider that the reasons given by the applicant for the exercise of discretion to extend the compliance period for patent application GB 2004670.2 from 11 January 2023 to 11 March 2023 in the request and related F52 dated 13 December 2023 and in the request and related F52 dated 10 March 2023 are not sufficient. The circumstances that were identified, i.e., (a) geographical location and distance between the US applicant and the UK agent and (b) the complexity of the subject matter of the patent application are not sufficient because they are considered usual for patent applications and they do not relate to specific circumstances that arose with this case.
- 47 However, in light of the fact that the examination report dated 26 January 2023 issued in response to the applicants amendments filed on 10 January 2023, the day before the compliance period expired, replaced one of the two citations on which the inventive

step objection is based by a new document, and the applicant has not had the opportunity to respond to this updated inventive step objection, I consider that the discretion of the Comptroller should be exercised to extend the compliance period for patent application GB 2004670.2 from 11 January 2023 to 11 March 2023. This is to allow the amendments and arguments filed by the applicant on 7 February 2023 in response to the examination report dated 26 January 2023 to be considered by the examiner. Thus, I remit the present case to the examiner to consider the amended claims, and related arguments, filed on 7 February 2023, as a matter of urgency.

- 48 Any request from the applicant to consider a further discretionary extension to the compliance period under r.108(3) will have to be considered on its own merits and how it relates to the specific circumstances of this case.

### **Appeal**

- 49 Any appeal must be lodged within 28 days after the date of this decision.

**Dr L CULLEN**

Deputy Director, acting for the Comptroller