

PATENTS ACT 1977

IN THE MATTER OF UK Patent
Application No 9526008.9 in the
name of Lionweld Kennedy Limited

DECISION

1. Application number GB9526008.9 was filed on 20 December 1995 in the name of Lionweld Kennedy Limited, represented by Hillgate Patent Services. Preliminary examination and search were requested on 13 December 1996, and the search report issued on 20 February 1997. The application was published on 25 June 1997.
2. Substantive examination was requested within the period prescribed, indeed rather earlier than strictly necessary, on 30 April 1997.
3. The first report of the substantive examiner was issued on 16 November 1998. The report raised objections which prevented grant of a patent, in particular that the claims related to more than one invention. The latest date for reply to the examination report was set at 17 May 1999.
4. No response having been received by 29 March 2000, the applicant was warned that the Office intended to treat the application as having been refused on 20 June 2000, and comments were invited.
5. A response was received on 3 April 2000. In this response, the agents acting for the applicants explained that they had just received instructions from the applicant, and amendments were enclosed which were designed to meet the objections reported by the examiner. Request was simultaneously made for an extension of the time for reply.
6. The Office responded to this request for extension of time in a letter dated 5 May 2000, which stated:

“I am writing to inform you that in order for your request of a retrospective extension of more than 10 months to be granted you need to file compelling reasons explaining the lateness of response. Until sufficient reason is supplied the amendments submitted in your letter will not be considered. If you do not file sufficient reasons by the date specified above (5 June 2000) the request for a retrospective extension will not be granted and the application is liable to be refused.”

7. A response was received by fax on 12 May 2000. The agents explained that:

“The lateness of the response was due to a number of changes in the management organisation of the applicant company. Changes in both the personnel who were identified as being responsible for instructions on this application as well as the physical location of the individuals concerned made it very difficult to obtain material and meaningful instructions in order to properly respond to the outstanding report. For these reasons the filing of a meaningful response to the objections raised beyond the time limit was unavoidable.

We believe that we have now responded in a meaningful way which distinguishes the invention over the prior art, and we look forward to the consideration of the amendments filed and to attending to any outstanding formal requirements in good time before the statutory limit.”

8. The examiner was not satisfied with this response and replied as follows:

“I regret to inform you that the reasons given for lateness of response are insufficient. Your application may thus be refused for non-compliance with s.18(3) within the specified period. You have the right to be heard on this matter if you so wish. However you only have until the latest date for reply specified above to file a request for a hearing and if no such request is received within the period specified the application will be regarded as refused under s.18(3).

I consider the reasons given are insufficient because personnel changes in the management of the applicant company are not an exceptional circumstance of the kind exemplified in the Manual of Patent Practice 18.55 and 18.56. Moreover, the reasons do not account for the failure to contact the office to request an extension prior to the latest date for reply set on my first report under S18(3) dated 16 November 1998.”

9. The latest date for reply to this letter was set at 22 June 2000. No reply has been received, so it falls to me to determine the matter.

10. Section 18(3) of the Patents Act 1977 reads:

“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.”

11. For the purposes of the issue facing me, the key words in this sub-section are “within a specified period”. It is well-established practice that a period is set for reply to each report by the examiner under Section 18(3). Failure to reply within that period can lead to refusal of the application, but more often an extension of the period is sought if it is apparent to the applicant that for one reason or another meeting the requirement might be difficult. Such requests for extension, when they are made before expiry of the period set, are given due consideration, and are often granted.

12. The grant of an extension is discretionary, and the comptroller must have adequate reason for exercising that discretion. There are no hard and fast rules for determining whether the circumstances of any request for an extension are adequate. However, it is incumbent on the applicant to make every effort to respond during the period set.

13. In the present instance, the reason given for the failure to respond during the period set and retrospectively seeking an extension to that period is the somewhat vague statement in the fax received on 12 May 2000, that changes in the management organisation of the applicant company made it very difficult for their agents to obtain meaningful instructions.

14. The examiner did not consider these to be adequate reasons to grant an extension retrospectively, and I agree. The applicant has been given the opportunity to be heard, and no reply has been received to the letter giving that opportunity.

15. Without the grant of the extension, the amendments filed with the letter received on 3 April 2000 are out of time, and cannot be considered to have been properly filed. The application is therefore in the form which it was in prior to that, in which form it does not meet the requirements of the Act at least insofar as the claims are not directed to a single invention as required by Section 14(5)(d).

16. I therefore refuse the application.

17. Any appeal to this decision should be lodged with 6 weeks.

Dated this 27th day of July 2000

M G WILSON

Deputy Director, acting for the Comptroller

THE PATENT OFFICE