

## **PATENTS ACT 1977**

### **IN THE MATTER OF**

**Patent Applications GB 9614154.4 and GB 9912424.0**

**in the names of David Duncan and Michael Harcombe**

## **DECISION**

### **Introduction**

1. This decision arises out of an alleged failure of the applicants to reply to an examination report under section 18(3) of the Patents Act 1977 in respect of their application GB 9614154.4, and to file a request for preliminary examination and search, pay the accompanying fee, and file claims and abstract in respect of their related application GB 9912424.0.
2. A hearing to consider the issues was appointed for 2 March 2001 but this was postponed at the applicants' request. New arrangements were made for the hearing to be held on 26 April 2001 but again this was postponed at the applicants' request.
3. It has not proved possible to agree a new date for the hearing with the applicants and so I now have to decide the matters on the papers on file.

### **Background**

4. In order to set the issues in proper context, it is necessary to summarize in some detail the various events that have occurred and the considerable amount of correspondence that has taken place between the Office and the applicants.

#### Search and Publication of GB 9614154.4

5. Application GB 9614154.4 entitled "Greeting Gift Card" was filed on 5 July 1996 by David Duncan, without the services of a professional representative. There was no claim to an earlier priority date. On 1 August 1996, an Official letter was issued asking that the preliminary examination and search request on Form 9/77, the associated fee, the claims and an abstract, be filed by 5 July 1997. Having missed this deadline, the applicant requested an extension of time and enlisted the services of a patent agent. The extension was allowed and the claims, abstract and search fee were filed on 1 September 1997. The agent wrote on 28 November 1997 to inform the Office that he was no longer representing the applicant.
6. According to the description filed with this application, a greeting card is provided with an integral scratch-off area which may be removed by the recipient to reveal either a further greeting message, or notification of an allocated gift. The recipient

may remove that part of the card bearing the notification and send it by post to a notified address to receive the gift described.

7. The examiner conducted a search on 6 February 1998 and, in his report, cited one prior art document, GB 2309415 A, which he considered to be relevant against all six claims of the application.
8. In the covering letter accompanying his search report, the examiner indicated that, in the light of the cited document, he doubted that the invention was novel and advised the applicant to consider carefully before deciding whether to file a request for substantive examination. The covering letter also included the following warning:-

“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.”

9. The application was published as GB 2318086 A on 15 April 1998.

#### Examination of GB 9614154.4

10. On 20 March 1998, the applicant filed a Form 10/77 for substantive examination. In an accompanying letter, he implied that the search report had not been received and that he desired accelerated processing. An accelerated examination report, together with a second copy of the search report, was duly issued on 21 April 1998.
11. In his examination report under section 18(3), the examiner objected that the invention was not new in view of what had already been disclosed in GB2309415A, which has a priority date earlier than that of the application. He set the usual 6 month period for reply which expired on 21 October 1998.
12. The covering letter accompanying the examination report set the usual six month period for reply which expired on 21 October 1998. It also included a warning that the application may be refused unless the applicants replied by the date set and contained a notice, very similar to that appearing in the search covering letter, warning against the disclosure of any additional technical information.

#### Summary of Subsequent Events

13. On 20 July 1998, the Office received a letter and enclosures from Michael Harcombe. In his letter, which was headed “Re Patent Application GB 9614154” and dated 17 July 1998, he stated:-

“During the last 18 months the writer has joined David Duncan and formed the above company. I have developed the original basic idea of David’s and the enclosed is a mock-up of the concept, now under consideration by major corporations. In depth details are available on the concept, but for the purposes of our next stage of application, we think the enclosed, gives a

facsimile of how our unique 3 in 1 greeting card would look”.

14. In response, the Office wrote pointing out that it was unable to consider the correspondence from Mr Harcombe as he was not the applicant. Mr Harcombe then argued that he should have been named as joint applicant with Mr Duncan at the time of filing patent application GB 9614154.4.
15. After considerable correspondence with Messrs Harcombe and Duncan spanning several months, the Office decided that the omission of Mr Harcombe as a joint applicant was an error that may be corrected under section 117 of the Patents Act. It wrote to Messrs Harcombe and Duncan on 25 February 1999 to inform them that the application form had been corrected to include Mr Harcombe as joint applicant.
16. During this exchange of correspondence, Mr Duncan was reminded that a response to the examination report was outstanding and, at his request, a further copy of the report was sent to him on 8 October 1998. On 29 October, he requested an extension of the period for response to the examination report and the examiner allowed an extension to 21 January 1999.
17. For completeness, I should mention that, Mr Harcombe sent three identical faxes on 1, 9 and 15 December 1998, again headed “Application No GB 9614154.4”, asking whether the Office required any further information concerning the “3 in 1” format”.
18. On 26 January 1999, a few days after the extended period for response to the examination report had expired, Mr Harcombe sent a fax to the Office. This principally concerned the request to be named as joint applicant but included the following sentence:-

“Also a letter replying to the examination report of 21/04/98 was included with our original details of 3 in 1 concept also a further copy 05/10/98”.
19. I presume the letter Mr Harcombe was referring to was that received 20 July 1998 enclosing details of a further development of Mr Duncan’s basic idea into the “3 in 1” greeting card, though there is no further copy of later date on the file.
20. On 10 March 1999, the Office received a letter from the applicants headed “Appl No GB9614154.4” in the following terms:-

“We wish to apply for Worldwide patent to cover a “lottery format” to be used in conjunction with any type of greeting card with a scratch-off or invisible portion.  
Our patent application above for our 3 in 1 concept possibly does not cover this aspect and we are anxious to make certain we do so.  
Would you please advise us at your earliest, together with the up to date position on our original application.”
21. The examiner responded on 16 March 1999 enclosing a booklet, guidance notes and

application forms for making a PCT application. He strongly recommended that the applicants use a patent agent. He reminded them that they could only apply for matter not disclosed to the Office in respect of the current application and warned them not to submit further details of the "lottery format" invention to the Office as part of the present application. Finally, with regard to the current application, he indicated that neither the letter received 20 July 1998, nor the faxes sent in December 1998 addressed the issues raised in the examination report of 21 April 1998, and he gave the applicants a further period, to 15 June 1999, in which to reply to the examination report.

22. In response, Mr Harcombe sent a fax to the Office on 19 March 1999. In it, he said he had been under the illusion that the "3 in 1" concept was part of his patent application and had been unaware that details could not be modified after the original application. He acknowledged that the examination report stated it was known to provide a card with a scratch-off portion to reveal a winner and indicated that he and Mr Duncan would now be making a new application for a different concept in which there were "three distinct and built in features". Ignoring the warning in the examiner's letter, he then went on to reveal yet more details of the "lottery format" card.
23. On 4 May 1999, Mr Harcombe sent another fax addressed to the examiner. This was headed "Old App GB 9614154.4" and in it he acknowledged that, "The original material supplied by my colleague was not patentable for the reasons you pointed out". He again referred to his wish to make a new patent application based on the "3 in 1 concept", and enquired again about PCT applications.
24. On 10 May 1999, the Office received the hard copy original of the fax of 4 May 1999 headed "Old App GB 9614154.4", accompanied by an attachment describing the "3 in 1 concept".

#### Emergence of New Application - GB 9912424.0

25. On 28 May 1999, the applicants sent a Form 1/77 to the Office together with a further copy of the previous attachment of 10 May 1999 describing the "3 in 1 concept". This new application, entitled "3 in 1 Concept", was given the application number GB 9912424.0 and a filing date of 28 May 1999.
26. There followed an exchange of correspondence concerning the filing date of the new application. Mr Harcombe claimed that he first revealed the details of the "3 in 1 concept" to the Office on 9 November 1998, later changing this to "July 1998", and argued that his new application should be given the earlier date.
27. The Office thoroughly reviewed all the papers and found that the earliest date it received correspondence clearly relating to a new application was 10 May 1999 in the form of a letter and attachment describing the "3 in 1 concept". Accordingly, the Office informed the applicants on 27 August 1999 that the application would be given the filing date of 10 May 1999. On the same day, the Office wrote to the applicants requesting that Form 9/77, the search fee, claims and an abstract, be filed by 10 May

2000. This letter also advised the applicants to consult a patent agent.

28. On 9 September 1999 Mr Harcombe faxed again, disagreeing with the finding of the Office as regards the filing date and pointing out that confusion may have been caused by the fact that the Office was initially unable to correspond directly with him (for example when he wrote in July 1998 about the “3 in 1 concept”). The Office replied on 26 October 1999 setting out in detail the reasons for its earlier finding, but this did not satisfy Mr Harcombe who sent a fax on 3 November 1999 asking for arbitration.
29. Accordingly, the file was then sent to a senior Formalities officer for consideration. On 29 December 1999 the officer wrote to the applicants to confirm the earlier view of the Office that the filing date of the application was 10 May 1999 and to offer a hearing if the applicants were still dissatisfied.
30. On 7 February 2000, the Office received another fax from Mr Harcombe enquiring about the current situation and stating that he was awaiting a reply to earlier faxes including those sent 9 September and 3 November 1999. Clearly there was some confusion in Mr Harcombe’s mind at this stage as, in his fax of 3 November 1999, he had specifically acknowledged receipt of the Official letter of 26 October 1999 which was a response to his fax of 9 September 1999.
31. On 9 February 2000, the Office received a letter enclosing a partly completed Form 9/77 without the associated fee, and two pages describing more details of a game of chance.
32. The Office responded on 2 March 2000. It pointed out that the Form 9/77 which had been sent was incomplete and the fee was missing. It explained that a Form 9/77 and fee, together with claims and abstract on GB 9912424.0 were awaited, and that the Office was also still awaiting a response to the letter of 29 December 1999 on the matter of the filing date and hearing.
33. In response, Mr Harcombe sent faxes on 14 and 15 March, and a letter on 16 March 2000. The faxes were to the effect that the Official letter of 29 December 1999 had not been received and claiming that some faxes had not found the right home internally in the Office. He mentioned the problems caused by the Office being unable to respond directly to him initially, referred to the confusion that had been caused and indicated that he was looking for a patent professional.
34. Confusion was evident in the letter of 16 March 2000. It opened with the words “Please find enclosed details which clarify an earlier application GB 9614154 part of what we call “3 in 1 Concept”, and asked whether “this clarification to the original patent ....has to be filed in a separate claim”. Attached to this were the previously filed two pages describing details of a game of chance and yet more details of what is headed “Time Spot Fun Game / Lottery UK & Worldwide Formats”.
35. The faxes and letter were replied to on 6 June 2000. The response informed the applicants that, in respect of GB 9614154.4, the examiner considered the extra

details filed 16 March had no relevance to the application. It recalled that a response was still due to the examination report issued 21 April 1998. In respect of GB 9912424.0, it stated that as a Form 9/77 and fee, claims and abstract were due by 10 May 2000, that case was considered to be “not in force” and it urged the applicants to contact the Office as soon as possible if they wished to continue with the application. It reminded the applicants yet again that the Office was still waiting to hear about the matter of the filing date and hearing on GB 9912424.0. Finally, it gave advice on where to seek information about patent agents.

36. Two faxes in response were received on 7 June 2000. In these, Mr Harcombe was said to be dumbfounded at the contents of the Official letter of 6 June. The applicants again claimed that faxes were not reaching the intended person in the Office. They insisted that they had responded to Official communications, had not added any new material to their applications, and wanted to proceed.
37. On 17 August 2000 the Office wrote again, enclosing a copy of the examination report on GB 9614154.4, reminding the applicants that a response was outstanding, and warning them that the case had to be in order by 5 January 2001 at the latest. It also stated, in relation to GB 9912424.0, that Form 9/77 and the corresponding fee, the claims and the abstract were due on 10 May 2000 and accordingly the case was now considered to be withdrawn. It also suggested that the applicants contact the Office in order to discuss the possibility of an extension of the period for filing the missing items.
38. Further faxes and letters from the applicants in August, September and October again claimed that they had responded to all correspondence and alleged that the Office had mislaid “vital information pertaining to the patent applications”. Accordingly, an Official letter of 25 September 2000 was sent attaching copies of all correspondence on the Patent Office file of GB 9614154.4 and asking the applicants to check for any discrepancy. As a result, three new items of mail and a Form 21/77 in respect of GB 9614154.4, were added to the Patent Office files but none of these were considered to alter the position concerning the processing of the applications. The Form 21/77, which is a form for registering or giving notice of rights in a patent or application, appears simply to contain more information about use of the lottery concept. The words “CHQ £130 D DUNCAN” are written on the form, but there is no Official indication, normally a cashier’s stamp, that this money was ever paid to the Patent Office.
39. During the course of this large batch of correspondence, the applicants insisted that they had answered the examination report dated 21 April 1998. The Office sent letters dated 5 and 25 October 2000 which indicated it did not dispute that replies had been received but considered that these had not addressed the objections raised in the examination report. The Office warned the applicants that it would be treating the application as having been refused on 5 January 2001.
40. On 29 December 2000, a fax was received from Mr Harcombe again asking why the Office considered the outstanding issues had not been met. An Official letter dated 5 January 2001 explained the position and indicated that, as the normal four and a half

year period allowed for putting the application in order for grant had now expired, GB 9614154.4 was treated as refused. A hearing was offered.

41. In response, the applicants took up the offer of a hearing and again insisted that the search request for GB 9912424.0 had been filed and the fee paid. As a result, the Office inspected all the correspondence on the file of GB 9912424.0 and reported in an Official letter dated 22 January 2001 that it could find no reference to the fee of £130 having been paid. It requested the applicants to supply information regarding the cheque number, bank sort code etc in order that it might investigate the matter further.
42. In a fax of 2 Feb 2001 from the applicants, they stated that proof had been sent in the past and apparently mislaid. Some cheque details and the sort code were furnished but these were insufficient for the Office to search its records. An Official letter of 23 February 2001 asked for the date of cheque or a copy of the Office receipt but this was not forthcoming.

#### **Discussion of the Issues - GB 9912424.0**

43. The issue to be decided in relation to GB 9912424.0 is whether the application was correctly terminated for want of a request for preliminary examination and search, the search fee, claims and abstract.
44. Section 15(5) deals with the consequences of failing to file the claims, the abstract, and the request for a preliminary examination and search and not paying the search fee. It reads:-

##### ***Section 15(5)***

*An application which has a date of filing by virtue of the foregoing provisions of this section shall be taken to be withdrawn at the end of the relevant prescribed period, unless before that end the applicant -*

- (a) files at the Patent Office one or more claims for the purposes of the application and also the abstract; and*
- (b) makes a request for a preliminary examination and search under the following provisions of this Act and pays the search fee.*

45. Application GB 9912424.0 contains no declared priority date and, in such circumstances, rules 25(1)(a) and 25(2)(a) of the Patents Rules 1995 specify that the relevant prescribed period is twelve months from the date of filing the application. The Comptroller has discretion to extend this period under rule 110 if she thinks fit.
46. When the Office wrote to the applicants on 27 August 1999 to inform them that their new application had been given the filing date of 10 May 1999, it made it clear that a preliminary examination and search request on Form 9/77, the fee, claims and abstract should all be filed within twelve months of the application filing date, ie by 10

May 2000. In the event, the applicants filed an incomplete Form 9/77 and the Office wrote explaining the shortcomings of the form and reminding them that a completed form and the fee, claims and abstract must be filed within the prescribed period. Once the period had expired, two Official letters were issued asking them to contact the Office as soon as possible if they wished to continue with the application.

47. The applicants did respond, but only to insist that they had answered all previous communications, claim that they had not received Official letters and allege that their communications had been misdirected within the Office. Following these allegations, steps were taken by the Office to check for missing correspondence but nothing of particular significance was found as a result of that exercise. The applicants insisted that the search request had been filed and the fee paid. However, they were unable to provide any evidence to support their claim. Significantly, the applicants have never claimed that the claims and abstract were filed.
48. Having reviewed all the correspondence relevant to this issue, I am satisfied that, despite a reminder and guidance from the Office, a properly completed Form 9/77 requesting preliminary examination and search was not filed on application GB 9912424.0 within the prescribed period. I am also satisfied that no search fee was paid and that neither the claims nor the abstract were filed by the due date.
49. I must now consider whether Comptroller's discretion should be exercised under rule 110 to extend the period for filing the missing items.
50. There is evidence that, at times, the applicants were confused and disorganised. They were uncertain what items they had filed in relation to their application and unclear as to what correspondence they had received from the Office. Several items of mail allegedly went astray despite the Office taking care to send most of its communications both by post and e-mail. It is also clear that the applicants were often preoccupied with discussions about the disputed filing date given to their new application and, notwithstanding several warnings not to do so, with providing the Office with yet more details of their invention. It is unfortunate that, except for a very brief period of time, they were not professionally represented. The consequence of dispensing with their patent agent put the onus of prosecuting the application firmly in the hands of the applicants. In his fax dated 14 May 2000, Mr Harcombe specifically referred to uncertainty and confusion, and indicated that he was searching for a patent consultant to handle matters. It is a great pity that he did not do so for it can be very risky to proceed without professional assistance.
51. Confusion and ignorance of patent law are not grounds for exercising Comptroller's discretion. The applicants would need to have demonstrated a continuing underlying intention to proceed with their application in order for discretion to be exercised and I am not satisfied that they have done this. They disregarded the reminder and guidance in the Official letter of 2 March 2000 relating to the missing items that needed to be filed and ignored the advice in Official letters dated 6 June and 17 August 2000 to get in touch with the Office if they still wished to proceed, to discuss the possibility of an extension. I therefore decline to exercise the Comptroller's discretion under rule 110 and refuse application GB 9912424.0 under section 15(5)



of the Patent Act 1977.

### **Discussion of the Issues - GB 9614154.4**

52. I now turn to the issues raised in application GB 9614154.4 which proceeded to search and examination in the normal way. As previously mentioned, an examination report objecting to lack of novelty issued on 21 April 1998 with a response date of 21 October 1998.
53. In subsequent correspondence, the Office sent a reminder that a response was outstanding. At Mr Duncan's request, a further copy of the report was sent to him and the period for response was extended by three months to 21 January 1999.
54. Mr Harcombe then claimed that a reply to the examination report had been sent, apparently referring to his letter of 20 July 1998, but nothing in that letter and enclosures addresses the objection raised in the examination report.
55. A further extension of nearly five months, to 15 June 1999, was then allowed and, in further communications dated 19 March 1999 and 4 May 1999, Mr Harcombe appeared to acknowledge that the invention was known.
56. Matters were then left somewhat in abeyance until 16 March 2000 when Mr Harcombe wrote the letter which opened with the words "Please find enclosed details which clarify an earlier application GB 9614154 part of what we call "3 in 1 Concept". The examiner responded informing the applicants that he considered the extra details had no relevance to the application and reminding them that a response to the examination report was still due.
57. On 17 August 2000 the Office wrote again, enclosing yet another copy of the examination report, reminding the applicants that a response was outstanding, and warning them that the application had to be in order by 5 January 2001 at the latest. A further warning was sent subsequently and on 5 January 2001 the Office wrote to inform the applicants that GB 9614154.4 was now treated as refused.
58. The period for putting an application in order for grant is governed by section 20(1) of the Patent Act 1977 which reads:-

#### ***Section 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,.....*

59. The prescribed period is specified in rule 34(1)(a)(i) of the Patents Rules 1995 as four years and six months from the filing date of the application and accordingly, the latest date for putting GB 9614154.4 in order was 5 January 2001. This period may be extended under rule 110 at the discretion of the Comptroller but I am satisfied there are no grounds for doing so as the applicants have clearly failed to respond in any meaningful way to the objection raised in the examination report despite several

reminders, extensions of the period for response and at least two warnings of the consequences of failing to act.

60. Having studied the correspondence, it seems to me that the applicants were perhaps under the impression, despite all the advice to the contrary in Official letters, that the details of the “3 in 1 concept” which they persisted in supplying to the Office could, in some way, be added to the original specification of GB 9614154.4 in order to distinguish the invention from the prior art. That is not the case, and thus the specification remains in the form it took on 1 September 1997 when the claims were filed.
61. I now need to decide whether the application, in the form it took on 1 September 1997, was in order. Section 1(1)(a) of the Patents Act 1977 states that a patent may be granted only for inventions which are new. Having carefully read the specification of GB 2309415A, which was cited by the examiner in his report, I am satisfied that it discloses not only all the technical features that were claimed in the specification of GB 9614154.4, but also all those that were described in the specification as originally filed. In particular, it describes a greetings card bearing an exposed greeting and hidden indicia covered by areas of scratch off material. The indicia may include a series of numbers in a lottery game and notification of a win.
62. The only features that distinguish the card from the cited prior art are in the nature of the notification and the manner of redemption. In GB2309415 A, the notification takes the form of an indication of whether a prize has been won, whereas, in the present application, it apparently indicates a specific gift that has been won. GB 2309415 A is silent as regards how the notification of a prize win is to be redeemed whereas, in the present application, the notification is sent by post to a notified address. However, neither of these features has a technical effect that could be used to patentably distinguish the invention from what is disclosed in GB2309415A. I have therefore come to the conclusion that the application fails the section 1(1)(a) novelty test.
63. Accordingly, I decide that application GB 9614154.4 was not in order at the end of the prescribed period and I refuse it under section 20(1).

### **Summary of Findings**

64. To summarise my findings, in respect of application GB 9912424.0 I am satisfied that a properly completed Form 9/77 requesting preliminary examination and search was not filed within the prescribed period. I am also satisfied that no search fee was paid and that neither the claims nor the abstract were filed by the due date. I have declined to exercise the Comptroller’s discretion to extend the period and accordingly, I have refused application GB 9912424.0 under section 15(5) of the Patent Act 1977.
65. In respect of application GB 9614154.4, I have found that the application was not in order at the end of the prescribed period. I have declined to exercise the Comptroller’s discretion to extend the period and accordingly, I have refused

application GB 9614154.4 under section 20(1) of the Patent Act 1977..

**Appeal**

66. As these are not procedural matters, any appeal must be lodged within six weeks of the date of this decision.

Dated this 27th day of September 2001

**P E REDDING**

Deputy Director, acting for the Comptroller

**PATENT OFFICE**