

## **PATENTS ACT 1977**

IN THE MATTER OF a request  
under Rule 110(4) of the Patents Rules 1995  
to extend the time limit for requesting  
preliminary examination and search  
for patent applications GB0024500.1,  
GB0024501.9 and GB0024503.5

### **DECISION**

#### **Background**

1. Patent applications' GB0024500.1, GB0024501.9 and GB0024503.5 were filed on 6 October 2000 in the name of Adrian Neil Warren. In accordance with rule 25 of the Patents Rules 1995, the request for preliminary examination and search for each application should have been filed, on Patents Forms 9/77 together with the prescribed fee of £130, within twelve months from that date, i.e. by 6 October 2001. No such request was filed within that period. However, in accordance with rule 110(4), on 11 January 2002 Mr Warren filed a Patents Form 52/77 and fee for each application requesting an extension of the period. Each form was accompanied by a Patents Form 9/77 and fee requesting preliminary examination and search. After considering the evidence filed in support of the extension request, the Patent Office took the preliminary view that the request should not be allowed. The Office's view, together with the reasons for it, was set out in a letter to Mr Warren dated 19 April 2002. Mr Warren did not accept the preliminary view and the matter came before me at a hearing on 10 July 2002.
2. Mr Warren attended the hearing in person. Mr Rob Sanders attended on behalf of the Patent Office.
3. The evidence filed in support of this request consists of single statutory declaration by Mr Warren dated 9 January 2002. He also gave oral evidence under oath at the hearing.

#### **The facts**

4. Following the filing of the patent applications, the Patent Office sent three standard letters to Mr Warren, one for each application, in October 2000. Each letter explained that to continue with his applications Mr Warren had to file a Patents Form 9/77 and fee of £130 requesting preliminary examination and search by 6 October 2001. The letters also contained the following passages:

##### **“Time limits**

“10. You should ensure that all documents mentioned in this letter reach this Office by the date(s) given. If you provide a good reason either in writing or over the telephone, it may be possible to extend the date(s) in this letter. You should not, though, rely on this. It is in your own interest to send the

documents in on time.

“11. The date(s) marked with an asterisk (\*) can be extended by one month, but you will have to pay an extra fee of £135 to get an extension. Further extensions of time over the one month are possible. However, to get a further extension you will need to make a special request with additional fees and any further extension will be allowed only if there is a good reason for it.

**“Warning**

“12. If you do not send all the documents or information requested in this letter by the date(s) given, your application may be taken as withdrawn.”

5. Mr Warren statutory declaration included the following statements:

“The delay causing the late filing of Forms 9/77 was directly caused by the time taken to complete the necessary work to satisfy the requirements to obtain the clearance for approval by the Civil Aviation Authority.”

“Without the necessary safety testing and assessments for approval by the Civil Aviation Authority, it would not have been viable to proceed further with the Patent Application process, however we have now been successful in achieving this.”

6. The Patent Office’s took these statements to mean that Mr Warren was only prepared to proceed with his patent applications, by filing the Patents Forms 9/77 and fees, if he obtained Civil Aviation Authority approval for the equipment which was the subject of his applications. In referring to the decision in *Heatex Group Limited’s Application [1995] RPC 546*, the Office, in its letter to Mr Warren of 19 April 2002, took the view that this did not demonstrate a ‘continuing’ underlying intention to proceed with the applications.
7. At the hearing Mr Warren said that what he meant by the remarks in his statutory declaration was that if the engineering tests, which were being undertaken on his equipment, had come up with something that required modification to that equipment, then he would have had to amend the specifications contained in his application. He said he did not intend it to mean that he would only request preliminary examination and search if he received CAA approval. In his letter of dated 9 January 2002, he indicated that he had now obtained CAA approval. However, at the hearing he said that he was in fact still waiting for that approval and had to carry out a further test.
8. Mr Warren also disclosed for the first time at the hearing that he contacted the Patent Office by telephone on 3 or 4 October 2001, as he was concerned about the approaching deadline for filing requests for preliminary examination and search. He said that the person he spoke to told him that he could extend the twelve-month period for filing the forms and fees and was left with the impression that such an extension would not be discretionary but automatic. He said that no mention was made of the one month automatic extension available under rule 110(3). Having been told this, Mr Warren said that he felt more relaxed and because he was close to completing the tests

on his equipment he decided not to file the Patents Forms 9/77 immediately safe in his belief that he could file them later subject to paying further fees. Mr Warren did not know the name of the officer he spoke to at the beginning of October 2001 and could not recall whether it was a specific telephone extension or a general enquiry number he contacted.

9. Mr Warren's comments about the telephone calls he made to the Office in October was new evidence which was not available to the Office when it issued its preliminary decision. As there were no reports of the telephone conversation on the patent files, I asked Mr Sanders to carry out an investigation within the Office to try and establish if there was any record of the telephone call or establish whether anyone could recall speaking to Mr Warren in early October 2001. I told Mr Warren that I would await the findings of Mr Sanders' investigations before issuing my decision.
10. As part of his investigations Mr Sanders asked Mr Warren if he could supply an itemised bill for the telephone calls he made during October 2001 to identify the telephone extension he contacted and hence the member of staff to whom he would have spoken. In response Mr Warren has said that he is unable to provide an itemised bill which would include information about the call as he made it from northern Italy where he was acting as Chairman of the jury at the Sondio Film Festival.
11. Mr Sanders has informed me that he could find no record of the telephone calls Mr Warren made in early October 2001. Moreover, none of the staff Mr Sanders has interviewed in the patents formalities areas and the Office's Central Enquiry Unit can recollect receiving any telephone calls from Mr Warren at that time.

### **Assessment**

12. Rule 110(4) provides:

*“(4) Without prejudice to paragraph (3) above, a time or period prescribed in the rules referred to in that paragraph may, upon request made on Patents Form 52/77, be extended or further extended if the comptroller thinks fit, whether or not the time or period (including any extension obtained under paragraph (3) above) has expired; and the comptroller may allow an extension, or further extension, under this paragraph on such terms as he may direct and subject, unless he otherwise directs, to the furnishing of a statutory declaration or affidavit verifying the grounds for the request.”*

13. Among the rules referred to in paragraph (3) is rule 25 (2), which prescribes a period of twelve months, from the priority date or the date of filing if there is no priority date, for filing a request for preliminary examination and search. The Comptroller, therefore, has very broad discretion to allow an extension of the period for filing a Patents Form 9/77 to request preliminary examination and search.
14. In *Heatex's Application*, the Hearing Officer took the view that the scheme of the Act and Rules is such as to provide a satisfactory degree of certainty for third parties as to whether an application has lapsed. He went on to say that for discretion to be exercised in the applicant's favour it must be shown that the applicant had a

“continuing underlying intention” to proceed with his application and that to allow an extension on the basis of a change of mind would be a “massive assault on public certainty” which the Office is right to resist. These are forceful principles, which the Patent Office has found to be persuasive in assessing subsequent requests for the exercise of discretion under rule 110(4). However, it is not binding on me nor is it definitive for determining whether discretion should be exercised under rule 110(4). That said, I believe the principles are relevant to the circumstances in the present case and I shall take them into account in determining whether to allow the extension requests.

15. In the letters the Office sent to Mr Warren in October 2000, it was made clear that if he did not file a request for preliminary examination and search by 6 October 2001 his applications may be treated as withdrawn. Mr Warren should have been left in no doubt therefore that he had to file a Patents Form 9/77 and fee for each of his applications by that date. However, if, as he says, he contacted the Office just before that date and was given to understand that an extension of the time, beyond the one month available under rule 110(3), for filing the form was non discretionary, then he would clearly have been misled into believing that he could delay filing the forms until after 6 October 2001 and effectively buy an automatic extension.
16. The fact that Office has no record of any telephone call from Mr Warren in October 2001, is not surprising as it is not the Office’s practice to record every single telephone enquiry. Moreover, it is perhaps not surprising that the staff Mr Sanders interviewed cannot recall speaking with Mr Warren at the time as it would not be easy to remember specific telephone enquiries seven months ago given the number of enquiries they have to deal with each day. Taking these factors into account and Mr Warren’s explanation why he is unable to provide proof of the telephone call he made in early October 2001, I am prepared to accept his statement, which he made under oath, that he contacted the Office by telephone shortly before the expiry of the period for filing the Patents Form 9/77 and fee.
17. As for the advice Mr Warren says he was given when he contacted the Office, I would be surprised if anyone in the Office told him that he could obtain an ‘automatic’ extension over and above the one month extension available under rule 110(3). It is, however, possible that the officer, to whom Mr Warren spoke, referred to the automatic extension under rule 110(3) and Mr Warren may have misunderstood what he was told believing that he could obtain a longer extension automatically by simply filing a form and fee. The fact that Mr Warren may have misunderstood what he was told would not mean that he did not intend filing the Patents Forms 9/77 within the prescribed period if he genuinely believed, from the advice he had been given, that it was possible to extend that period automatically.
18. As I have no evidence that the Patent Office provided Mr Warren with incorrect information, I am not convinced that his failure to file a Patents Form 9/77 and fee in time for each of his applications was attributable wholly or in part to an error, default or omission by the Office. Therefore I do not believe that there is a case for allowing an extension by using the discretion available under rule 100(2).
19. This said, there is nothing to indicate that Mr Warren took a positive decision not to

file a Patents Form 9/77 and fee for each of his patents. If, as he said at the hearing, he has still not obtained CAA approval yet wants to file a request for preliminary examination and search, then it undermines the Office's view that he was only prepared to file the form and fee once he received that approval. This suggests to me that Mr Warren has always had a continuing underlying intention to file the Patents Form 9/77 and fee and that his late request for preliminary examination and search does not constitute a change of mind.

20. The fact that Mr Warren took immediate action in filing a request under rule 110(4) as soon as he was told in early January 2002 that the patents had been withdrawn, for failure to file the Patents Forms 9/77 and fees, is a further indication that he did intend filing such requests.

### **Conclusion**

21. Taking all these factors into account and Mr Warren's unfamiliarity with patent matters, I am satisfied, on the balance of probability, that he genuinely thought he could automatically extend the period for filing a Patents Form 9/77 and fees for each of his applications and always had a continuing underlying intention to file those forms and fees. Therefore, I am satisfied that to allow his extension requests would not have the effect of permitting him to change his mind. Nor do I believe it would result in the "massive assault on public certainty", to quote from the Hearing Office in *Heatex*, bearing in mind that the applications have not been published and therefore have not been disclosed to the public.
22. I am therefore inclined to give Mr Warren the benefit of the doubt and allow his requests for an extension of time. This is subject to Mr Warren filing a Patents Form 53/77 and fee of £135 for each of his applications within two months from the date of this decision in accordance with rule 110(6).

Dated this 15<sup>th</sup> day of August 2002

M C Wright  
Assistant Director, acting for the Comptroller