

the comptroller in connection with an application for a patent, or a patent.

(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.

(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)

(4) If a period has already been extended under subsection (2) above -

- (a) that subsection does not apply in relation to it again;
- (b) the comptroller may further extend the period subject to such conditions as he thinks fit.

Extension of time limits specified by comptroller

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.

- 5 Given that the latest reply date set in an examination report is a period specified by the Comptroller and can therefore be extended “as of right” by virtue of Section 117B(2), Rule 109 insists that a request to extend this reply period must be made (in writing) within two months of the expiry of the reply period. (Section 117B(4)(a) confirms that this “as of right” extension is only available once in relation to any given period.)
- 6 This means that the opportunity to extend the reply period in this case expired on 2 November 2005. That is more than two years before any response was received from Mr Mellor. Although the Comptroller does have discretion to ‘further’ extend the reply period by means of Section 117B(4)(b), that discretion only arises when the specified period in question has already been extended once “as of right”. So says the first few words of Section 117B(4).
- 7 Therefore, the Comptroller has no power to extend the latest date for reply that was set in the examination report in this case.

Discretion to accept a late response

- 8 As Mr Mellor cannot have an extension of time, he is asking the Comptroller to exercise discretion and accept his late response, as suggested in the Manual of Patent Practice¹ at paragraph 18.53 (towards the end of the first square brackets) and paragraph 18.54.
- 9 Mr Mellor explained that when he received the combined search and examination report in February 2004, he misunderstood the letter and thought

¹ Available online at:
<http://www.ipso.gov.uk/patent/p-decisionmaking/p-law/p-law-manual/p-law-manual-practice.htm>

that his application had been refused. He says that he did not realise that he could amend the application, and he filed the documents away in his loft.

- 10 Early in 2005, Mr Mellor started planning an extension to his house which disturbed the documents stored in the loft. He says that several boxes were decanted to the garage, and some of the boxes were “binned”. He adds that the planning application was a long fought out affair, and went through several committees before approval was finally granted in July 2006. Mr Mellor says that, prompted by the recent correspondence relating to his patent application, he has searched through the boxes in his garage, but assumes that the box containing the search and examination report from 2004 was inadvertently destroyed.

The Examination Report

- 11 Mr Mellor says that he misunderstood the examination report that he received in February 2004. The examination report in question covers two pages, and does raise some serious objections, including novelty and inventive step. At first I thought I could understand why Mr Mellor might have formed the impression that his application was hopeless. I tried to put myself in the shoes of an inventor with little or no experience of applying for patents. I wondered how I would react if — full of enthusiasm about my new invention and having filed an application for a patent — I received such an apparently damning report. I am sure it would take the wind out of my sails, and I could imagine filing the documents away and giving up.
- 12 Nevertheless, on closer inspection, the examination report and the covering letter are littered with various encouragements to amend the application. For example, I counted eleven references to the possibility of amending the application in the examination report alone. In many cases, the examiner has suggested specific wording that could be used as an amendment. Furthermore, the covering letter has a section headed in bold type “Opportunity to file amendments”. This is followed by a further paragraph which says:

“Consequence of failing to reply

The application may be refused unless you reply to the report by the date set.”

- 13 So on closer inspection, I find it harder to understand how Mr Mellor could have got the impression that his application was refused. He does refer to a statement that the Office was “... *minded to refuse for the reasons stated*”, but nothing like this phrase appears in the correspondence until the examiner sent a further examination report to Mr Mellor in February 2008 to tell him that he did not consider that the reasons provided were sufficient to justify accepting the late response. At this stage (four years after the original examination report), the examiner reports “... *I will be minded to report that the application should be refused for non-compliance with s. 18(3) within the specified time period.*”
- 14 I also assume that Mr Mellor would have received the usual official letter (dated 7 February 2005 in this instance), advising him that his application would be published on 9 March 2005 with the publication number GB2405579.

- 15 So if Mr Mellor had misunderstood the original examination report and thought that his application had been refused, it is not clear why he didn't react when he was informed that the Office was about to publish his application. This was about a year after the examination report was issued, and at that time, there was still over six months of the reply period to run.

The discarded documents

- 16 Many of us have, at some time or another, accidentally thrown out an important document. So I have considerably more sympathy with Mr Mellor over the documents that appear to have been discarded during building work at his home. Adopting the words used in paragraph 18.57.1 of the Manual of Patent Practice, this could be described as "an isolated slip" during a period of "temporary difficulties".
- 17 But that doesn't alter the fact that Mr Mellor — for whatever reason, and by his own admission — filed the documents away with no specific intention of responding at a later time. If he had put them away somewhere temporarily (eg. intending to sort it out later in the knowledge that he had nearly two years in which to file amendments), and the documents had then been inadvertently discarded during building work etc., that would probably have been a different matter.

Conclusion

- 18 Firstly, I have concluded that it is no longer possible to extend the reply period that was set in the examination report dated 20 February 2004. Secondly, if I have discretion to accept a late response, I do not think that the reasons given by Mr Mellor are sufficient to justify a favourable exercise of that discretion in the particular circumstances of this case. I therefore refuse this application for failure to comply with section 18(3) within the specified period.

Appeal

- 19 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

S J PROBERT

Deputy Director acting for the Comptroller