



29 July 2009

**PATENTS ACT 1977**

APPLICANT Robert Harvey Rines

ISSUE Whether patent application  
GB 0819479.7 may be accorded  
divisional status under section 15(9)

HEARING OFFICER J E Porter

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**Introduction**

- 1 International patent application PCT/IB2004/003802 entitled “Electronic & acoustic reading of printed material” was filed on 19 November 2004, in the name of Robert Harvey Rines. The application claimed priority from two US applications, the earlier of which was filed on 24 March 2004.
- 2 The international application entered the UK national phase on 18 October 2006, and an abbreviated examination report was issued on 12 March 2007, which adopted large parts of the International Preliminary Report on Patentability dated 13 December 2005. That report contained an objection to plurality of invention.
- 3 Further exchanges of correspondence ensued between the examiner and MacLeod Allsop, the firm of patent attorneys acting for the applicant. The compliance period was due to end on 24 September 2008, but on 23 September a 4 month extension to the period was requested. On 23 October 2008, a patent application was filed which claimed divisional status from the international application. I shall refer to this as “the 2008 application”.
- 4 The Office’s view was that a 2 month extension to the compliance period was allowable, but a 4 month extension was not. The view of the 2008 application was that it had been filed too late for claiming divisional status, and the circumstances did not merit allowing an extension of the period for filing a divisional application.
- 5 Subsequent correspondence focused on the matter of an extension to the period for filing a divisional application. With this unresolved, the examiner suggested on 2 March 2009 that it be referred to a Hearing Officer for a decision. The attorneys wrote on 20 April 2009 to request that a decision be made on the papers. Furthermore, in a letter of 20 July 2009, the attorneys stated that what was essentially being contested was the view that the 4 month extension to the compliance period was not allowable.

- 6 It therefore falls to me to decide, from the papers on file, to what extent the compliance period of the international application should be extended, and also whether the 2008 application should be accorded divisional status.

### **The law**

- 7 The relevant provision in relation to the filing of a divisional application is section 15(9), which reads:

*Where, after an application for a patent has been filed and before the patent is granted -*

*(a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and*

*(b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below),*

*the new application shall be treated as having, as its date of filing, the date of filing the earlier application.*

- 8 The relevant rule is rule 19 of the Patents Rules 2007 which states:

*(1) A new application for a patent may be filed as mentioned in section 15(9)—*

*(a) before the end of the relevant period; or*

*(b) if earlier, before the earlier application is terminated or withdrawn.*

*(2) Such an application must include a statement that it is filed as mentioned in section 15(9).*

*(3) For the purposes of this rule the relevant period is—*

*(a) where an applicant is notified under section 18(4) that his earlier application complies with the requirements of the Act and these Rules, two months beginning with the date of that notification; or*

*(b) in any other case, the period ending three months before the compliance date of the earlier application.*

- 9 Also relevant are rule 108 of and Schedule 4 to the 2007 Rules, which set out the regime for acquiring extensions of time to prescribed periods. Rule 108 reads:

*(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.*

*(2) The comptroller shall extend, by a period of two months, any period of time prescribed by the provisions listed in Part 2 of Schedule 4 where—*

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

*(b) no previous request has been made under this paragraph; and*

*(c) that request is filed before the end of the period of two months beginning with the date on which the relevant period of time expired.*

*(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.*

*(4) Each request under paragraph (2) or (3) for a period of time to be extended must be made on a separate form unless—*

*(a) each of those requests relate to the same patent or application for a patent; and*

*(b) the grant of each of those requests would result in the expiry of all the extended periods of time on the same date,*

*in which case those requests may be combined and made on a single form.*

*(5) Any extension made under paragraph (1) or (3) shall be made—*

*(a) after giving the parties such notice; and*

*(b) subject to such conditions,*

*as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may be extended (or further extended) for a period of two months only.*

*(6) An extension may be granted under paragraph (1) or (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.*

- 10 In understanding the relevance of this rule to the periods in issue in this decision, it is sufficient to note that the compliance period (as prescribed in rule 30) is listed in Parts 2 and 3 of Schedule 4, and the period for filing a divisional application (as prescribed in rule 19) is listed only in Part 3 of Schedule 4.

## **Arguments and analysis**

### *Background*

- 11 As noted above, the issue of plurality of invention in the international application was first raised in the International Preliminary Examination Report, and this was relied upon by the examiner in his first examination report of 12 March 2007.
- 12 The applicant replied to this report on 11 January 2008, deleting claims 26 to 47 but reserving the right to file a divisional application in respect of them. A further examination report was issued on 7 August 2008, stating (amongst other things) that plurality of invention remained in respect of the invention of claim 25, and reminding the applicant that a divisional application could not be filed once the application in suit had been granted.

- 13 The reply date was set as 28 August 2008, the short period being because the compliance date at the time was 24 September 2008. On 26 August 2008 the applicant filed a request for a further search in respect of the invention of claim 25, and the search report was issued on 16 September 2008.

*Extending the compliance period – the request*

- 14 On 23 September 2008, the applicant filed a Patents Form 52 requesting a “4 months extension of the time limit prescribed by rule 30”. I note in passing that the old Form 52/77 was used, with its references to rule 110 of the repealed Patents Rules 1995. However, I don’t think anything turns on this point since it is clear from subsequent correspondence that the Office and the applicant agree that the equivalent provision of the 2007 Rules is rule 108.
- 15 The Form made reference to the filing of a divisional application and the accompanying letter was explicit in stating that the intention was to seek a 4 month extension to the compliance period in order “to enable the applicant to file a divisional application”. A 4 month extension would set the compliance date as 24 January 2009, and it would have enabled a divisional application to be filed before 24 October 2008, under the period calculated in rule 19(3)(b). The 2008 application was filed on 23 October 2008.
- 16 The Office’s response to this Form was set out in a letter dated 4 November 2008 and clarified further in an email from the Formalities Manager on 10 November 2008 – which itself summarised a telephone conversation with the attorney. These communications both spelt out the Office’s view that the Form 52 was to be taken as a request for a 2 month as-of-right extension to the compliance period, which therefore now ended on 24 November 2008. The view taken was that, if a 4 month extension was required overall, then a further Form 52 would be necessary in order to request a further, discretionary 2 month extension.
- 17 I agree with the attorneys’ contention that, if I were to conclude that the Office’s response was incorrect on this point, and that the requested 4 month extension to the compliance period should be granted, then that would immediately make the 2008 application filed in time – and I would not need to consider whether to exercise discretion in order for it to be accorded divisional status.

*Extending the compliance period using rule 108(1)*

- 18 In their letter of 20 July 2009, the attorneys argue that the comptroller could exercise discretion under rule 108(1) to allow the 4 month extension. They contend that the provision “appears to provide wide powers to grant extensions if the Comptroller so decides in the circumstances” and argue that it is “moot” whether a Form 52 is necessary at all if the comptroller were to allow the 4 month extension in this way. In particular, they argue that:

If it is possible to obtain an extension, presumably of indeterminate extent, under Rule 108(1) to the deadline for filing a divisional application as indicated by Mr Hayes then *ipso facto* it should be possible to obtain a similar extension to the normal compliance period of four months as originally requested.

- 19 Having considered carefully the wording of rule 108, I am not persuaded that this

interpretation is correct. Rule 108(1) confers a general power on the comptroller to extend or further extend “any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4 [my emphasis]”.

20 In other words, under rule 108(1), the discretion that the comptroller has to extend prescribed periods is restricted to those periods which do not appear in Parts 1 and 2 of Schedule 4. For such periods, I agree with the attorneys that the comptroller has discretion to extend them without requiring a Form or fee. The period for filing a divisional application, set out in rule 19, is one such period.

21 But the compliance period, as set out in rule 30, is listed in Part 2 of the Schedule. This places it outside the ambit of rule 108(1), and a request to extend it must instead satisfy the requirements set out in rule 108(2) or (3).

*Extending the compliance period by 4 months using a single Form 52*

22 Having found that the request to extend the compliance period must be considered under rule 108(2) and (3), I must now decide whether it is possible under those provisions to extend the compliance period by 4 months with a single Form 52 and fee, as the applicant requested on 23 September 2008.

23 Under rule 108(2), a 2 month extension to the compliance period may be obtained as-of-right by filing a Form 52 and fee. Under rule 108(3), a request may be made to extend or further extend the compliance period by filing a Form 52 and fee. Any such extension is at the comptroller’s discretion and, under rule 108(5), is for a period of 2 months only.

24 It therefore seems clear to me that a request made under rule 108(2) and a request made under rule 108(3) are separate requests, each of which requires a separate Form 52 and fee to be paid. The only exception to this requirement is in the particular circumstances set out in rule 108(4), where several periods on the same patent application are all being extended together and will expire on the same date. Those circumstances do not apply here.

25 Similarly, repeated requests for discretionary extensions of 2 months can be made under rule 108(3), but under rule 108(3)(a) each such request requires a Form and fee.

26 Thus rule 108 does not envisage the possibility of requesting both a 2 month extension under rule 108(2) and a 2 month extension under rule 108(3) with a single Form 52 and fee. Neither does it envisage use of a single Form 52 to request two discretionary extensions of 2 months each, under rule 108(3).

27 In my view it is therefore right to grant a 2 month extension to the compliance period, based on the single Form 52 that was filed. That makes the end of the compliance period as 24 November 2008.

*Extending the compliance period under rule 107(3)*

28 In the submissions of 20 July 2009, the attorneys suggest in the alternative that an extension to the compliance period under rule 107(3) could be allowed.

- 29 Rule 107(3) gives the comptroller discretion to extend a prescribed period if an irregularity of procedure has occurred and it is attributable, wholly or in part, to a default, omission or other error on the part of the Office.
- 30 Their submission is on the basis that the correspondence with the Office over the filing of the Form 52 and the requested extension “has not been at all times easy to follow” and required clarification. It was also argued that “the letter of 22 December 2008 from the examining division...did not seem to square or have any connection with the communication of 4 November 2008”.
- 31 Having carefully studied all the correspondence associated with this case, I am not satisfied that a default, omission or other error was made by the Office, to which the late filing of the 2008 application can be attributed. In particular, I cannot identify any such error in the correspondence of 4 and 10 November 2008. Furthermore, it seems clear to me that the letter of 22 December 2008 from the examiner gave his view of the applicant’s request of 2 December 2008 for a discretionary extension to the time period for filing a divisional application. For that reason, it dealt with a different matter from the earlier correspondence concerning the extension of the compliance period.
- 32 I can therefore identify no basis on which I should invoke the comptroller’s discretion under rule 107(3) to extend the compliance period.

*Extending the period for filing a divisional application*

- 33 As an alternative to seeking a further extension to the compliance period, the applicant requested on 2 December 2008 a discretionary extension to the period for filing a divisional application under rule 108(1) – such that the 2008 application would be treated as having been filed in time. The letter referred to earlier correspondence in support of the request.
- 34 That earlier correspondence was the 23 September 2008 letter, which referred to “the applicant’s ill health which was relayed to the patent office in our letter of 3 December 2007”. The 3 December 2007 letter explained that “the US applicant/inventor suffered a stroke a short while ago” and referred to difficulties that the attorney had experienced in receiving instructions from the applicant, despite repeated requests. The 23 September 2008 letter went on to re-iterate the point about the applicant’s ill health having been responsible for the various delays experienced with the application.
- 35 The attorney wrote again on 11 February 2009, stating that “the failure to meet the deadline for a filing a divisional application was due to the applicant’s ill health and the inability to make the appropriate decisions at the appropriate times which was wholly unintentional”.
- 36 The attorney’s reference to unintentionality was in all likelihood prompted by the examiner’s letter of 22 December 2008, in which he pointed to a statement contained in paragraph 123.37 of the *Manual of Patent Practice*, which says:

In order for discretion to be exercised favourably, as a general rule the failure to meet the time period must have been unintentional at the time that the period expired.

- 37 The examiner's view, as expressed in that letter and repeated in his letter of 2 March 2009, was that the statements made by the attorney did not demonstrate why the particular failure to file the 2008 application in time was unintentional.
- 38 Statements in the *Manual* are of course not binding upon me or the examiner. They are, however, to be regarded as highly persuasive, as they set out the Office's settled practice or view on any particular point, and so if I am to deviate from that I should have a good reason for doing so. No such reason has been put to me in this case, and I for myself cannot identify one, so I shall look more closely at what the *Manual* gives me by way of guidance.
- 39 The first thing to note is that the sentence in paragraph 123.37 from which the examiner derives guidance is not the end of the story. The paragraph goes on to say:

This is consistent with the statutory test that applies to requests for reinstatement under s.20A (see 20A.13-16 for guidance on the meaning of unintentional). However, since rule 108 sets out no statutory test for discretionary extensions of time, discretion may be exercised favourably in appropriate circumstances even if the unintentional criterion does not appear to have been met.

- 40 In other words, when read as a whole this paragraph in the *Manual* suggests that, in some circumstances, the "unintentional criterion" may not be the appropriate one to adopt. In the case of an extension to the period for filing a divisional application, further guidance is to be found in paragraph 15.21 of the *Manual*. The relevant part of the paragraph states that:

discretion to allow a divisional application to be filed out of time will normally be exercised only if the applicant shows that the circumstances are exceptional and that he has been properly diligent (*Penwalt Corporations's Application* (BL O/72/82); *International Barrier Corporations's Application*; *Kokusai Denshin Denwa's Application* (BL O/9/83); *Luk Lamellan und Kupplungsbau GmbH's Application* [1997] RPC 104.

- 41 In their further submissions of 20 July 2009, the attorneys' view is that the test contained in paragraph 15.21 of the *Manual* is the correct one for me to adopt. I agree with that view, not least because this specific and long-standing approach to consideration of late-filed divisional applications has some judicial approval – in particular in the cited *Luk Lamellan* case where the court did "not believe that it is possible to criticise the Hearing Officer's exercise of his discretion", based as it was on the test set out in the part of paragraph 15.21 quoted above.
- 42 The question I must consider, therefore, is whether the applicant has shown that the circumstances are exceptional and that he has been properly diligent.
- 43 The difficulty I have is that the applicant and his attorneys have given the Office very little information about the particular circumstances in which the applicant finds himself, and really no information at all specific to the particular circumstances surrounding the failure to file the 2008 application within the prescribed period for divisional applications.
- 44 As noted above, what has been stated is that the applicant unfortunately suffered a stroke a short while before the end of 2007, and that – in general terms – it led to an "inability to make the appropriate decisions at the appropriate times" and

which “continues to have an effect on his ability to deal with matters”. This misfortune in itself should I think be regarded as “exceptional” in a general sense, and I wish the applicant a full and complete return to health.

- 45 I think it is then moot whether this necessarily makes the particular circumstances surrounding the failure to file the 2008 application in time “exceptional”. It is possible to argue that the exceptional nature of the illness resulted in exceptional circumstances in the context of the filing of the 2008 application itself – although I don’t think the argument was clearly put in that way.
- 46 Nevertheless, whether or not I am persuaded over that point, what I have not been presented with is any argument or evidence at all which can help me on the diligence point. All I have is a general assertion about the difficulties of meeting deadlines and progressing the case and, in the most recent submission of 20 July 2009, a general assertion that the attorneys have been diligent.
- 47 The test I must apply makes clear that it is for the applicant to show that he has been diligent – yet I have been provided with no evidence of the particular circumstances that led up to the late filing of the 2008 application, nor with evidence of any efforts made to file in a timely way. I have been given little or no insight into the processes or events that occurred, and therefore into the question of whether or not the applicant was diligent in pursuing a divisional application within the time permitted.
- 48 It follows that I do not think I have been given sufficient grounds on which I can properly exercise discretion in favour of the applicant. The onus that is upon the applicant to show that the circumstances of the late filing of the 2008 application are exceptional, and that he has been properly diligent, has not been discharged.

### **Conclusion**

- 49 I conclude that the compliance period of the international application ended on 24 November 2008, having been extended by 2 months under rule 108(2).
- 50 I also conclude that I should not exercise my discretion under rule 108(1) to extend the time period for filing of a divisional application.
- 51 It follows that the 2008 application is not accorded divisional status under section 15(9), and it must proceed with a filing date of 23 October 2008.



## **Appeal**

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

**Dr J E PORTER**

Deputy Director acting for the Comptroller