



PATENTS ACT 1977

APPLICANT Knauf Insulation Ltd
ISSUE Whether patent application
GB1219243.1 may be accorded
divisional status under section 15(9)
HEARING OFFICER H Jones

DECISION

Introduction

1 This decision relates to whether patent application GB1219243.1 filed on 26th October 2012 can be treated as having, as its date of filing, the date of filing of GB0807777.8, i.e. 29th April 2008. In other words, whether GB1219243.1 can be treated as a divisional application of GB0807777.8 (the parent application). The issue came before me to decide at a hearing held by Skype[®] videoconference on 26th February 2013, at which Mr Guy Farmer of arc-IP appeared as representative for the applicant.

Background

- 2 The relevant history of the parent application can be summarised as follows. The application was filed on 29th April 2008 and a search report was issued on 26th September 2008. In the covering letter which accompanied the search report, the examiner explained that he had identified plurality of invention and had limited the search to the first invention.
- 3 The first examination report was issued on 19th September 2011. This report raised objections concerning plurality of invention (as noted in the earlier search report), novelty, inventive step, and conflict. The date of issue of this report had the effect of setting the compliance period for putting the application in order (the rule 30 period) at 19th September 2012.
- 4 The applicant filed amendments to overcome these objections on 22nd January 2012, and in the covering letter it was stated that the applicant reserved the right to file a divisional application.
- 5 A second examination report was issued on 15th February 2012. This report raised a fresh objection concerning added matter introduced by the amendments filed on 22nd January 2012. The applicant responded with amended claims on 16th April 2012 and restated the applicant's right to file a divisional application.

- 6 A third examination report was issued on 14th May 2012 in which the examiner maintained his added matter objection. The applicant responded with counter-arguments on 13th July 2012, but also filed a set of auxiliary claims in case the examiner disagreed with the applicant's position. The covering letter explains that the applicant was eager to advance the patent application and was filing the auxiliary claims in case the examiner was not prepared to waive the added matter objection.
- 7 The examiner maintained the added matter objection in a fourth examination report issued on 22nd August 2012, and at the same time provided observations relating to the allowability of the auxiliary claims. The applicant responded with amended claims on 17th September 2012 and submitted a request under rule 108(2) to extend the compliance period for putting the application in order by two months as of right, i.e. from 19th September 2012 to 19th November 2012.
- 8 A fifth examination report was issued on 25th September 2012 in which the examiner maintained the added matter objection and suggested that there was potential for plurality to exist in the current form of claims 1 and 16. No formal objection to plurality of invention was made at this point. The applicant responded by filing amended claims on 24th October 2012 in which claim 16 was deleted and made the subject of a separate application filed two days later. This new application, GB1219243.1, was filed after the date required by rule 19(3)(b) for it to be treated as a divisional application under section 15(9), i.e. three months before the compliance date of the parent application (19th August 2011). On 26th October 2012, the applicant requested a discretionary extension of two months to the compliance period of the parent application under rule 108(3), i.e. from 19th November 2012 to 19th January 2013.
- 9 The examiner issued a sixth examination report on 6th November 2011 objecting to clarity and consistency only. The added matter objection had finally been resolved. The examiner also drew the applicant's attention to the fact that the divisional application had been filed out of time and that not even a two-month discretionary extension of the compliance period on the parent would assist (as this would only extend the compliance period to 19th January 2013, meaning that a divisional application had to have been filed on or before 19th October 2012; the divisional application was filed a week later on the 26th). The examiner suggested that discretion to allow the late filing of the divisional application, under rule 108(1), could only be exercised if the circumstance was exceptional and the applicant had been properly diligent, and went on to say that it was far from clear whether these conditions had been met. The examiner also noted that no evidence had been provided to support the request for discretionary extension of the compliance period of the parent application, and, as a consequence, a discretionary extension could not be allowed.
- 10 The applicant's response on 16th November 2012 was such that it placed the parent application in order and it was duly sent to grant. Search and examination of the new application was deferred pending a decision on whether it could be treated as a divisional application.

The law

- 11 There are two questions I need to answer. The first is whether discretion should be exercised under rule 108(1) to extend the date by which the divisional application had to be filed. The second is whether discretion should be exercised to extend the compliance period for placing the parent application in order under rule 108(3) - this is important because, according to rule 30(3)(b), it is the compliance period of the parent application that determines the initial compliance period for putting the divisional application in order. The relevant parts of the Rules are set out below:

*19(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.*

*19(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 immediately after the date of that notification; or
(b) in any other case, the period ending three months before the compliance date of the earlier application.*

30(1) The period prescribed for the purposes of sections 18(4) and 20(1) (failure of application) is the compliance period.

*30(2) For the purposes of paragraph (1), subject to paragraphs (3) and (4), the compliance period is -
(a) four years and six months beginning immediately after -
(i) where there is no declared priority date, the date of filing of the application, or
(ii) where there is a declared priority date, that date; or
(b) if it expires later, the period of twelve months beginning immediately after the date on which the first substantive examination report is sent to the applicant.*

*30(3) Subject to paragraph (4), where a new application is filed the compliance period is -
(a) where it is filed under section 8(3), 12(6) or 37(4) -
(i) the period specified in paragraph (2) in relation to the earlier application, or
(ii) if it expires later, the period of eighteen months beginning immediately after the initiation date; and
(b) where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.*

108(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.

*108(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 immediately after the date on which the relevant period of time expired.*

*108(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.*

108(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.

108(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.

12 Rule 30 is listed under parts 2 and 3 of Schedule 4, while rule 19 is listed under part 3 only. This means that the compliance period can be extended in periods of two months either as of right or at the discretion of the comptroller in accordance with rules 108(2) and (3), while the date for filing a divisional application can be extended in periods of two months at the discretion of the comptroller in accordance with rule 108(1). No extension of the compliance period or to the date for filing a divisional application is possible if two months have elapsed since the last period expired.

13 The test to be applied when considering whether to exercise discretion to allow a divisional application to be filed out of time under rule 108(1) is set out in paragraph 15.21 of the Office's Manual of Patent Practice:

15.21 The comptroller has discretion to extend the periods allowed for filing a divisional application. However, 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).

14 Guidance regarding the circumstances in which comptroller's discretion may be exercised in favour of an extension of time under rule 108(3) is given in paragraph 123.37 of the Manual of Patent Practice. The guidance says that discretion should be exercised favourably if it is shown that the failure to meet the time period was unintentional at the time that the period expired. This is a lower threshold for exercising discretion than the one for late filed divisionals. The situation is slightly different in the present case in that the request to extend the compliance period under rule 108(3) is not being made because the compliance period has been missed or is likely to be missed, but because it indirectly extends the date by which a divisional application can be filed. This same situation was considered by the Hearing Officer in *Ferguson's Application*¹, who concluded, and rightly so in my view, that the test for deciding whether the compliance period should be extended under rule 108(3) to allow the late filing of a divisional application should be consistent with the test for exercising discretion to allow a divisional application to be filed out of time under rule 108(1), i.e. the applicant needs to demonstrate that the circumstances are exceptional and that the applicant has been properly diligent. In other words, the threshold for allowing discretion should be higher. This was the approach taken by the examiner, and Mr Farmer agrees that it is the correct test to apply.

¹ BL O/272/09

Arguments

- 15 At the hearing, Mr Farmer dealt with the two aspects of the test separately. As far as proper diligence is concerned, Mr Farmer took me through the history of the application and explained that there had been a genuine and serious attempt by the applicant to progress the application through to grant at all stages of examination. He accepted that an impasse had been reached on the added matter objection, and explained that this arose because the applicant fundamentally disagreed with the examiner's objection. However, despite the impasse, the applicant made attempts to overcome the objection through amendment of the application, by argument and by suggesting a possible solution in the form of auxiliary claims. There was no evidence to suggest that the applicant had deployed delaying tactics in prosecuting the application, nor any suggestion of prevarication on the applicant's part. Mr Farmer said that it was unfortunate that it had taken so long to overcome the added matter objection, but the applicant was merely defending what was considered to be a reasonable position. This, he suggested, is the nature of the examination process. The examiner argued that the added matter point could have been resolved a lot sooner, but did acknowledge that the applicant had responded to all examination reports within the allowable time periods.
- 16 On the second aspect of whether the circumstances leading to the late filed divisional were exceptional, Mr Farmer argued that it was not until the suggestion of plurality in the fifth examination report of 25th September 2012 that the applicant became aware of a potential need to file a divisional application. Mr Farmer pointed out that the plurality objection had not been formally made in this report, nor did it relate to the plurality objection identified in the very first examination report. Nevertheless, as soon as the applicant became aware of the potential need for a divisional application, the parent application was amended and a new application filed on 26th October 2012, a month after the examiner's report. The fact that no formal objection to plurality had yet been made and that plurality of invention only became apparent within a month of the compliance period at that time, i.e. as extended under rule 108(2) to 19th November 2012, would suggest that this was an exceptional circumstance in which it was both right and fair to allow the applicant to file a divisional application out of time. The examiner argues that the applicant had all the information to hand in order to decide how to patent the invention and the number of applications necessary to cover all inventions, and had ample time in which to file all necessary applications. Mr Farmer countered with the point that there was a difference between having all the information available and having a particular issue identified; it was not until resolution of the added matter point that the possibility of a divisional application became apparent to both examiner and applicant.
- 17 Having reviewed the relevant history of the application, I am satisfied that the applicant has been properly diligent throughout the processing of the application and that any delay in resolving the added matter point was largely inevitable. I also agree with Mr Farmer that the circumstances in which the divisional application came to be filed so late in the day can be considered to be exceptional. There is no blame on either side for this, it is simply the case that sometimes it takes time for complex issues to be resolved, and the applicant should not lose out as a result of this when serious and consistent attempts have been made to progress the application through to grant.

Conclusion

- 18 I have found that the divisional application was filed out of time because of exceptional circumstances and that the applicant has acted with proper diligence throughout the processing of the application. This dictates that I should allow the late filing of the divisional application. In order to put this into effect, I will allow the compliance period of the parent application (GB0807777.8) to be extended under rule 108(3) to 19th January 2013. This has the effect of extending the period for filing the divisional application to 19th October 2012. I will allow the period for filing the divisional application to be further extended under rule 108(1) to 26th October 2012 so that GB1219243.1 can be treated as a divisional application. In accordance with rule 30(3)b, the divisional application will have as its compliance date the compliance date of the parent application, i.e. 19th January 2013.
- 19 The applicant will need to submit a further request for discretionary extension of the compliance period under rule 108(3) in order to put into effect any amendments it wishes to make to the divisional application. Given the circumstances of the case, I see no reason why discretion to extend the compliance date to 21st March 2013 should not be exercised in the applicant's favour (the date 21st March 2013 takes into account various deadlines falling due on weekends). If the applicant does not submit a further request under rule 108(3) then the divisional application is likely to be refused for not meeting the requirements of the Act at the compliance date. The request must be submitted before 21st March 2013.
- 20 The divisional application will be remitted to the examiner for immediate search and examination.

H Jones

Deputy Director acting for the Comptroller