



## PATENTS ACT 1977

REQUESTER	Kohn & Associates PLLC
ISSUE	The Patents Act 1977: whether or not the comptroller should issue an opinion on patent GB 2571696 B in respect of request 19/20 in accordance with section 74A(3)
HEARING OFFICER	Dr L Cullen

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### DECISION

- 1 This decision concerns a request for an opinion in relation to validity under section 74A of the Patents Act 1977 as amended (“the Act”).
- 2 The request in question (no. 19/20) was filed on 11 June 2020 by Kohn & Associates PLLC (“Kohn”) seeking an opinion on whether granted patent GB 2571696 (“the patent”) in the name of Compass Pathfinder Limited is valid in light of an article published in a scientific journal.
- 3 The dossier for the patent, including various documents related to the search, examination and subsequent grant of the application, as well as any document filed by third parties in relation to this patent, can be viewed on IPSUM, the IPO’s Online Patent Information and Document Inspection Service at:

<https://www.ipo.gov.uk/p-ipsu.htm>

### Relevant Background and Case History

- 4 The article in question is a paper from the *Journal of Natural Products*<sup>1</sup>. It is referred to throughout the patent as granted and throughout the application for the patent as ‘JNP’. It appeared as an X-category document on the further search report dated 24 January 2018 published as part of the A-specification for GB2571696 issued before

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<sup>1</sup> The full details of the paper are: Shirota, O. et al., "Concise Large-Scale Synthesis of Psilocin and Psilocybin, Principal Hallucinogenic Constituents of "Magic Mushroom", *Journal of Natural Products*, vol. 66, 30 May 2003, pages 885 – 887.

grant. It is also listed amongst the documents cited on the front page of the patent as granted, see the B-specification for GB2571696, dated 27 May 2020.

- 5 In a letter dated 23 July 2019, the applicant responded to an initial examination report dated 19 December 2017 and in that response explicitly took account of the results of the further search report, including JNP. The letter explained how the applicant believed that the amended application was distinguished from JNP.
- 6 The patent was granted after one further round of correspondence between the examiner and the applicant, including an examination report dated 18 November 2019 which was delayed in being made publicly available for reasons that are not clear to me. I will consider this further below.
- 7 Kohn submitted third party observations under Section 21 of the Act in relation to the validity of the patent application that were filed too late to be considered by the examiner prior to grant of this patent (as they were received after the examiner had issued the Intention to Grant letter under Section 18(4) of the Act<sup>2</sup>). They subsequently filed a request on 11 June 2020 for an opinion regarding the validity of the granted patent based on JNP arguing that the invention claimed in the patent was not novel and was obvious. I note that the third party observations essentially related to the same points as the request for an opinion.
- 8 In a letter dated 15 September 2020, the Office informed Kohn that it intended to refuse the request for an opinion, since it would be inappropriate in the circumstances to issue such an opinion as the matter in question had been properly considered before grant. It also stated that, if Kohn disagreed with this view, they were entitled to request a hearing and to submit arguments and observations accordingly.
- 9 In their letter dated 25 September 2020, Kohn requested to be heard.
- 10 A further letter from the Office dated 5 October 2020 set out more detailed reasoning why the request for an opinion should be refused.
- 11 This matter came before me at a hearing on 14 December 2020. Mr. Hedley Austin appeared for Kohn. Mr Karl Whitfield acted as assistant to the hearing officer. The hearing was also attended by an observer for training purposes.

## **The Relevant Law & Case Law**

### *The Relevant Law*

- 12 The relevant law is set out in section 74A(3)(b) of the Act.

*(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –*

*(a)...*

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<sup>2</sup> See Rule 33(5) of the Patents Rules

*(b) if for any reason he considers it inappropriate in all the circumstances to do so.*

- 13 Rule 94(1) of the Patents Rules 2007, as amended (“the Rules”), is also relevant in this regard providing further information in relation to circumstances under which an opinion will not be issued:

*(1) The comptroller shall not issue an opinion if –*

*(a) the request appears to him to be frivolous or vexatious; or*

*(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.*

- 14 The Manual of Patent Practice explains the IPO’s practice under the Act and the Rules and makes helpful references to relevant case law. The manual can be viewed online at the IPO’s website<sup>3</sup>. Section 74A of this manual refers to practice in relation to Opinions, and paragraph 74A.04, entitled ‘Refusal or withdrawal of request’, is relevant to the present case.

- 15 Further information on the practice of the Office in relation to opinions under section 74A is available in the Patents Opinions Service Procedures Manual also available from the IPO website<sup>4</sup>:

#### *Relevant Case Law*

- 16 I am not aware of any precedents from the UK courts in relation to refusal to provide an opinion under section 74A of the Act.

- 17 However, there have been a number of previous Office decisions dealing with this circumstance which are relevant: *Franks Opinion Request* (BL O/289/07)<sup>5,6</sup> (“*Franks*”), *Naylor Opinion Request* (BL O298/07) (“*Naylor*”)<sup>7</sup> and *Automation Conveyors Limited Opinion Request* (BL O/370/07) (“*Automation*”)<sup>8</sup>. These decisions have also been referred to in the grounds for refusal of an opinion request issued by the Office. While these decisions are not binding on me and it is necessary for me to consider the particular facts and circumstances of this case, they are helpful in establishing the approach I will take.

- 18 In *Franks*, the Hearing Officer stated at paragraph 18 (my emphasis added):

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<sup>3</sup> see [Manual of Patent Practice - Guidance - GOV.UK \(www.gov.uk\)](http://www.gov.uk)

<sup>4</sup> See [Opinions manual - GOV.UK \(www.gov.uk\)](http://www.gov.uk)

<sup>5</sup> See database of IPO patent decisions [Intellectual Property Office - Patents Decision \(ipo.gov.uk\)](http://ipo.gov.uk) for full text of Office decisions.

<sup>6</sup> for full text of decision see <https://www.ipo.gov.uk/p-challenge-decision-results/o289/07.pdf>

<sup>7</sup> for full text of decision see <https://www.ipo.gov.uk/p-challenge-decision-results/o29807.pdf>

<sup>8</sup> for full text of decision see <https://www.ipo.gov.uk/p-challenge-decision-results/o37007.pdf>

*“It was I believe **always the intention that the opinion service would not be used to repeat or in some way reappraise the examination of the patent performed either in this Office or at the EPO**”.*

They then went on, in paragraphs 19 and 20, to highlight the arguments supporting this view, making reference to the materials describing the passage of the legislation providing for opinions through Parliament. In paras 21 and 23, the hearing officer discussed when an opinion should not be provided, stating as follows:

21 *Hence, it would seem clear that the intent was always that there should at least be something new – **the request should not simply seek to go over old ground**. The rationale for this would seem to be, not unreasonably, **that a patentee should not be asked to deal again with questions that he has already dealt with to the satisfaction of the Office pre-grant**.*

...

23 *However the Act in section 74A(3)(b) gives the Comptroller broad powers to refuse to issue an opinion if for any reason he considers it inappropriate in all the circumstances to do so. It is my view that one such circumstance would be if the request merely seeks to cover old ground rather than raising something new. **I should perhaps add that I do not believe that this requires that every request for an opinion should cite a new piece of prior art, but it does require that there be at least a new argument**. In this case I can find no new argument – the argument that the mere computerising of a known process is obvious is clearly something that will have been considered pre-grant, as indeed is evidenced by the extract from the EPO examination report cited above.*

19 In *Naylor*, the Hearing Officer taking note of the earlier decision in *Franks*, indicated that it is not necessary to always have a new piece of prior art, a new argument based on a citation already identified can be enough. In paragraphs 5 and 6, they stated:

5 *In that earlier decision I also considered at some length the question of whether it is appropriate to issue an opinion if the question at the heart of the request has already been considered during the pre-grant examination of the patent. I noted that it was always the intention that the opinion service would not be used to repeat or in some way reappraise the examination of the patent performed either in this Office or at the European Patent Office. **Rather the intent was always that there should at least be something new – the request should not simply seek to go over old ground**. The rationale for this being, not unreasonably, **that a patentee should not be asked to deal again with a question that he has already dealt with to the satisfaction of the Office pre-grant**.*

6 *I should perhaps add that I do not believe that every request for an opinion should be required to cite a new piece of prior art but rather that it should at least put forward a new question. In this case I can find no new question. The prior art relied on was clearly considered during the examination process - indeed it was cited against the novelty of the patent application in two separate examination reports. Consequently, I do not believe that the request gives rise to any new question.*

20 The hearing officer in *Automation* made clear that the relevant provision when dealing with a situation such as the present which relates to the pre-grant examination process of a patent is section 74A(3)(b) of the Act (and not Rule 94(1))

invoked through Section 73A(3)(a). They went on to discuss the circumstances referred to section 74A(3)(b) further as follows:

- 29 *The use of the words “in all the circumstances” in s.74A(3)(b) means to me that I have to weigh all relevant factors in deciding on the inappropriateness of issuing an opinion. There is no doubt in my mind that what was cited during the examination phase is indeed one of the factors than can be taken into consideration in this context.*
- 30 *To this end, Mr Wallin invited me to apply a test similar to the one under rule 77D(1) (now 94(1)), namely, to ask whether the prior art cited in the request had been sufficiently considered pre-grant. There is however an important distinction to be drawn between pre-grant examination on the one hand and “proceedings” on the other. The latter are typically terminated by some kind of reasoned decision. In such cases it will be clear what has been considered by the person making the decision and it should therefore be possible to come to a view on whether the consideration was sufficient. **However, in pre-grant examination there is no corresponding window on the mind of the examiner. Although it may be possible to draw inferences from a sequence of correspondence, the examiner rarely gives an explanation as to why a particular line of argument or objection has been dropped. This is particularly true in relation to a decision not to pursue a citation made in a search report. It will therefore rarely be possible to draw the conclusion with any degree of certainty that a particular question has been “sufficiently considered”.** Applying the test proposed by Mr Wallin would, it seems to me, lead to the outcome that many, possibly most, issues involving the relevance of prior art referred to pre-grant could end up being re-examined in an opinion. I do not believe that this was the intention of the legislator and it would not in my view be an appropriate use of the opinions service.*
- 31 *The hearing officer in Franks suggested that the key issue is whether a new argument has been put forward (paragraph 23). This was rephrased in Naylor in terms of whether there is a new question (paragraph 6). This view is supported by paragraph 16 of the 2005 Patent Office consultation paper concerning opinions, to which Mr. Wallin referred, in which it is said that “a request would be refused where it does no more than repeat arguments already considered pre-grant”.*
- 32 *But what is “a new question or argument”? Mr. Wallin suggested that a new question “just has to be something that you can see from the prosecution history has not been considered before”. I agree with this statement, although I think I probably differ with him over the detail of what it means in practice. **It is an intrinsic part of the substantive examination process to assess the novelty and obviousness of the claims, as properly construed, in the light of the prior art. In this context, “prior art” means documents cited in the search report (at least under category “X” or “Y”, which indicate possible relevance to novelty or inventive step) as well as material which has come to the examiner’s attention in some other way. I think it reasonable to suppose in general that the examiner will have done his or her job properly in the absence of indication to the contrary, and I see no reason why this assumption should not apply even if the examiner has decided not to raise objection on the basis of any of the citations at substantive examination.***

- 33 ***Having said that, I have to acknowledge the possibility that a decision by an examiner to discount a citation might be shown to have been clearly perverse, in the sense that no reasonable person could have reached it. Only in such a case might it be appropriate to reconsider the citation in an opinion as there could be said to be a new argument.***
- 34 *I should mention that Mr Wallin also proposed an alternative test by analogy with the one set out by Laddie J in Series 5 Software [1996] FSR 273. This concerned an application for an interlocutory injunction, in which there are a number of factors to be taken into consideration, but the one focused on by Mr Wallin was the “likelihood of success”. Obviously a request for an opinion is a very different situation to a request for an injunction when fully litigated proceedings are in prospect, but what I understand Mr Wallin to have been suggesting was that the comptroller should proceed to issue the opinion if there was a significant likelihood that the outcome would be adverse to the patent. **This is a qualitatively different test to that of whether a new question is raised and is not fully consistent with the principle I set out above that the original examiner’s decision should not be revisited unless it was clearly perverse. Moreover, it is self-contradictory in the sense that to come to a view on the likely outcome of the opinion process (which is a paper-based procedure) would in practice require investigating the merits of the request to an extent that could effectively mean doing the opinion.***
- 35 *My conclusion from the above is accordingly that a request for an opinion on validity which argues on the basis of prior art that was cited as category “X” or “Y” in the search report, or as part of a substantive objection at any other time in the examination procedure, is, other than in exceptional circumstances, unlikely to clear the hurdle of raising a new question or argument.*

### **Matter to be decided**

- 21 The issue before me is to determine whether the preliminary view expressed by the Office in its letter dated 15 September 2020 and further elaborated in its letter of 5 October 2020 to refuse the opinion request made by Kohn in relation to the granted patent GB 2571696 B was correct.
- 22 If I consider that the Office was not correct to give this view, then I will refer the request back to the team at the Office responsible for the delivery of the opinions service so that the requested opinion can be prepared and issued.

### **Analysis**

- 23 Kohn as the requestor for an opinion is entitled to be heard on the matter of the refusal of their opinion request, under the general power of Section 101 of the Act which indicates that any party to a proceeding before the comptroller is entitled to be heard before the comptroller exercises any discretion vested in them under the Act or Rules adversely to that party. Section 74A(6) clarifies that a requester of an opinion is, for the purposes of section 101, a party to a proceeding before the comptroller.
- 24 To determine this issue, I do not need to come to a view on the substantive question in the request regarding the validity of the patent. As the Hearing Officer observed in

*Automation*, to do so would “*in practice require investigating the merits of the request to an extent that could effectively mean doing the opinion*”. My purpose is not to carry out the opinion but to consider whether there is any reason why the preliminary view expressed by the Office in its letter dated 15 September 2020 and further elaborated in its letter of 5 October 2020 that the request for an opinion should be refused is not correct.

- 25 At the hearing, Mr. Austin for Kohn argued that the Office has not followed the guidance from *Automation* correctly in seeking to refuse the request. He offered two arguments. Firstly, since the examination report of 18 November 2019 was not made publicly available, he argued that third parties (such as Kohn) could never see from the prosecution file (referring to the IPSUM entry for this patent) whether JNP had been considered during prosecution. I will refer to the file on this patent available on IPSUM as the public file. Secondly, he argued that in any event the decision to discount JNP was perverse in the sense used by the Hearing Officer in paragraph 33 of *Automation* quoted above.
- 26 I will deal with these arguments in reverse order, taking the argument in relation to the JNP citation first, and then considering the argument in relation to the unavailability of the exam report dated 18 November 2019 on IPSUM second.

#### *JNP citation*

- 27 In their skeleton argument and at the hearing, Kohn argued that even if it is held that the JNP document could be seen to have been considered and then discounted, the decision to discount it was perverse. Mr Austin from Kohn summarised their view as follows (see skeleton argument dated 7 December 2020)

*“Specifically, any chemist would immediately know that it is inevitable that the identical product would result from a reaction between identical reagents unless different conditions are specified. Specifically, the cited document (Shirota) very clearly discloses exactly the same starting reagents as those specified in step (i) of claim 1 (namely, psilocin and tetrabenzylpyrophosphate), discloses exactly the same intermediate product (namely intermediate 7 from Figure 1 or intermediate 4A from Figure 5), and discloses the reaction of that intermediate with hydrogen. As claim 1 specifies no conditions whatsoever, any chemist would conclude that the product of claim 1 would be identical to that disclosed in Shirota, and the examiner’s apparent failure to reach that conclusion shows that the decision was perverse.”*

He then went on cite a decision from the EPO Technical Board of Appeal in support of this argument. Finally, he commented on the final phrase of Claim 1 as granted and the reference therein to impurities being ‘monitored’, commenting that such a process is “*simply a passive observation which can have no effect whatsoever on the process specified*” concluding that if the examiner has relied on this feature “*the use of monitoring as providing novelty, then this would have been perverse and contrary to the clear and well understood meaning of “monitor”.*”.

- 28 In the written statement dated 11 June 2020 requesting the opinion, Mr. Austin for Kohn analysed the claims of the granted patent and compared them to the disclosure of JNP and pointed out why, in his view, there was no substantive difference in disclosure and hence the granted patent lacked novelty and inventive step.

29 I note that Mr Austin refers to the decision to discount JNP as “perverse”. However as noted above, the relevant part of the *Automation* decision, paragraph 33, refers to the need to show that the decision by an examiner to discount a citation is “*clearly perverse, in the sense that no reasonable person could have reached it.*” It does strike me that the Hearing Officer in *Automation* did choose their words carefully when they wrote “*clearly perverse*” and also reinforced this by indicating that this relates to a decision that “*no reasonable person*” could make. I am satisfied that what the Hearing Officer had in mind was indeed an exceptional circumstance and that they were acknowledging that, although not likely, the possibility could not be eliminated completely. I also consider that “*clearly perverse*” is a level above “*perverse*” and that this is intended to allow for a very rare occurrence. In support of this, I think it is important to take account of what the hearing officer said in preceding paragraph 32 (my emphasis added), i.e.

*“It is an intrinsic part of the substantive examination process to assess the novelty and obviousness of the claims, as properly construed, in the light of the prior art. In this context, “prior art” means documents cited in the search report (at least under category “X” or “Y”, which indicate possible relevance to novelty or inventive step) as well as material which has come to the examiner’s attention in some other way. **I think it reasonable to suppose in general that the examiner will have done his or her job properly in the absence of indication to the contrary, and I see no reason why this assumption should not apply even if the examiner has decided not to raise objection on the basis of any of the citations at substantive examination.**”*

From this I consider that the Hearing Officer was satisfied that, unless there is a very clear reason not to, one can assume that the examiner will have carried out their role properly in assessing the novelty and inventive step of an application including when they decide not to pursue an objection as the examination process proceeds.

30 As the Hearing Officer also pointed out in *Automation*, by contrast with a decision resulting from proceedings before the Comptroller which sets down the reasons why the Hearing officer acting for the Comptroller has come to the conclusion they have in refusing or accepting, in whole or in part, a patent application, this is not the situation in relation to the normal pre-grant examination process. As set down in paragraph 30, “*in pre-grant examination there is no corresponding window on the mind of the examiner*” and “*Although it may be possible to draw inferences from a sequence of correspondence, the examiner rarely gives an explanation as to why a particular line of argument or objection has been dropped. This is particularly true in relation to a decision not to pursue a citation made in a search report.*”

31 I believe that this sets a high bar and that this was in line with the intention of the legislator as they saw it, when the provisions concerning opinions were put in place. Thus, while it cannot be discounted completely that a situation might arise concerning an X-document already cited (as in this case) where it would be appropriate to give an opinion, this would indeed be an exceptional circumstance. I further believe that the Hearing Officer in *Automation* was right to set a high bar – and I do consider that the use of the phrase ‘*clearly perverse*’ – does reinforce this. I can see no reason why I should not adopt the same approach in this case.



- 32 The present case relates to a request for an opinion based on a document considered during the pre-grant search and examination process for this patent. The JNP document was clearly known to the examiner before grant and it was considered during the pre-grant examination of the patent application in relation to validity given that it was cited as an X-document, a stand-alone citation for the purposes of novelty and/or inventive step. Leaving aside the issue with the examination report dated 18 November 2019 (see below), one can conclude from the intention to grant letter dated 27 December 2020 which was issued after the response from the patent applicant dated 23 July 2019 (which provided amended claims and also discussed JNP) that the examiner did not consider the disclosure of JNP to be sufficient to deny the grant of the patent. Whether this was due to the arguments made by the patent applicant in the letter dated 23 July 2019 or for other reasons, I cannot tell for certain. One can infer that the examiner came to view that the amendments and associated arguments made by the applicant did adequately address the issue.
- 33 I see no reason why I should consider that this was anything other than the outcome of the normal consideration of documents identified by the examiner and corresponding responses from the applicant that is the usual course of the pre-grant examination process which arrives at a view whether a patent may be granted or not.
- 34 I consider that there would have to be something to show that the examiner had clearly or explicitly ignored JNP or that they discarded it without consideration. If he considered JNP and decided that it was not relevant that is not the same as discarding it without consideration. I consider that Kohn is asking me to make the latter conclusion in the absence of evidence to show why this is the case. It appears that their view is that because the examiner sent the application for grant, he must not have considered JNP. However, to reach this latter conclusion and to meet the high “clearly perverse” bar, it would be necessary in my view to provide something more than an explanation of why they think the claims, as granted, lack novelty and inventive step. The requester seems to consider that because the examiner came to a different answer than they did, i.e. that JNP did not render the claims obvious or lacking in novelty, then this conclusion is “perverse”. I do not agree.
- 35 Further, it is necessary also to bear in mind that what I am dealing with here is to review whether the view of the Office to refuse the opinion because this citation had already been considered and no new argument has been made is correct. I need to focus on the process and not the conclusion, i.e. was there anything to indicate that the Office was not entitled to consider that the examiner had correctly carried out their role and that as a result that there is no new question and so refuse the opinion request. It is not appropriate or indeed necessary for me in this circumstance to determine afresh the validity of the patent in light of JNP. This is important as the process we are dealing with is that for a non-binding opinion on validity. I find support for this view in the view of the Hearing officer in paragraph 34 of *Automation* i.e. that the approach to be adopted is one “*consistent with the principle ... that the original examiner’s decision should not be revisited unless it was clearly perverse*” and is not one where, in order to come to a view on the likely outcome of the opinion process, it would in practice require investigating the merits of the request to such a degree that it effectively means doing the opinion.
- 36 From the public file, one can infer that the examiner considered that the amendments made by the applicant adequately addressed the issue raised by JNP. This is not the

view expressed by the requester Kohn. However, coming to a different view of the relevance of the JNP citation, firstly is not the same as ignoring it and secondly does not, in my view, represent a “clearly perverse” outcome.

- 37 The examination process requires the examiner to identify relevant prior art and bring it to the attention of the applicant and, based on the exchange of views with the applicant, to decide whether or not all or some of the monopoly as expressed in the claims can be granted. This process is not required to explain why something is not being pursued for the benefit of third parties. A similar situation occurs in relation to the observations offered by a third party. Although a third party can provide observations that they think are relevant to the validity of the patent application under section 21 of the Act, they do not receive any explanation about why they are not adopted by the examiner. The receipt of the observations is acknowledged and they are copied to the applicant by the office without any comment from the examiner. Whether or not these observations are accepted by the examiner as being relevant to the validity of the patent application in question is a matter for the examiner to decide. There is no requirement on the examiner to provide an explanation to the third party who sent the observations, the reasons why he has or has not taken them into account as part of the pre-grant examination process. In this situation, the public file will show that the documents provided by a third party have been brought to the attention of the applicant but it will not provide details of why they have been adopted or accepted by the examiner. However, one can infer that if the examiner has included some or all of this material in an official examination report, they consider that it is relevant to validity, if they have not then the examiner has concluded that this material is not relevant to validity. In the present case an analogous situation has arisen, the examiner has not pursued an objection that the requester thinks he should have and there is no explanation on the public file why. The requester implies that because the examiner has not done so and sent the patent to grant, this is somehow very wrong and so meets the “*clearly perverse*” test.
- 38 In this instance, the Office indicated that it was minded to refuse the request under Section 74A(3)(b) because it did not consider that the request related to a new argument. In its letter to the requestor, dated 5 October 2020, the Office elaborated its reasons for the refusal as follows:

*“6. Your request for an opinion refers to only a single document:*

*“Concise Large-Scale Synthesis of Psilocin and Psilocybin, Principal Hallucinogenic Constituents of Magic Mushroom”, Shirota et al.; Journal of Natural Production 2003, 66 pp. 885-887.*

*7. On the basis of this document the opinion request argues that the patent lacks novelty or inventive step.*

*8. This document was however cited by the examiner as a category “X” citation in the Further Search Report relating to claims 26 to 63 found on page 68 of the published application. I note also that the claims of the patent as granted are based upon these claims. This alone seems sufficient for the hearing officer’s comments in paragraph 35 of Automated Conveyors to*

*apply. Accordingly, the opinion request ought to be refused as the prior art relied upon in the request was cited as category "X" in the search report.*

*9. Furthermore, although Shirota was not referred to in any substantive examination report, the agent has set out in their letter of 23 July 2019 how the accompanying amended claims are distinguished from Shirota (JNP in the letter). I think it must be assumed that the examiner took proper account of the agent's arguments and accordingly considered whether the claims were novel and inventive in light of Shirota.*

*10. On the face of it there is no "new question or argument" and, applying the guidance in Automated Conveyors, the opinion request should be refused."*

- 39 While it is clear that the requestor has a different view to the examiner of the relevance of JNP to the validity of the patent, that is not in itself enough, in my view to find that there is a new argument here to be addressed. Such a difference of views is not sufficient to justify allowing the request for an opinion and hence asking the patentee to deal again with a question with which he has already dealt with to the satisfaction of the Office. In short, I do not consider that this opinion request raises a new argument.
- 40 The decision to accept an opinion request is more straightforward if it relates to a new document that was not considered by the examiner already. In the situation such as the present where the opinion request relates to a document already considered as part of the pre-grant examination process, it is not so straightforward to decide to accept an opinion request. As a result, it is appropriate for the Office to consider if there is genuinely a new argument so that the applicant is not being required to address the same issue more than once. As discussed above, it is entirely appropriate in my view to assume that a document that has been cited as a standalone X-document has been properly considered unless there is some very obvious evidence to the contrary.
- 41 As I have indicated above, I can find no reason based on the material provided by Kohn to challenge or overturn the assumption that the examiner properly considered JNP. Hence, I cannot find a reason why I am not entitled to conclude that this request does not relate to a new question and so should be refused.

#### *Delay in making Exam report available on IPSUM*

- 42 Returning now to the first of the two arguments raised by the requestor in their skeleton argument and at the hearing, Mr Austin, referring to the fact that (as acknowledged in the letter from the Office dated 5 October 2020), the exam report dated 18 November 2020, had not been made available on IPSUM, argued that "*There is nothing on the public file that enables members of the public to see whether the cited document had, or had not been, considered; indeed it would place an unacceptable burden on the public if matters not available to the public were to be held to support the contention that the document had been considered during prosecution.*"
- 43 I do not know why the examination report and associated cover letter dated 18 November 2019 had not been made publicly available on IPSUM shortly after they

were issued to the applicant as is usual. So far as I can establish there is no reason why these documents should not be public. I have asked that the necessary arrangements are made to ensure these documents are available on IPSUM as soon as possible<sup>9</sup>. The examination report of 18 November 2019 is a very short one and it merely indicates that, having taken account of the amendments filed by the agent dealing with the case with their letter of 23 July 2019, the examiner considered that the invention as now claimed was allowable and that the description should thus be brought into agreement with the amended claims. It does not make any direct reference to JNP.

44 While I accept that it is not ideal that the examination report of 18 November 2019 was not publicly available via IPSUM at any time before the opinion request, I do not think this has a significant bearing on the matter to be decided. I do not see how this is enough to suggest that the preliminary view expressed by the Office to refuse the opinion request is not appropriate. As noted above, this exam report does not actually refer to JNP or to its relevance to the validity of the patent application. There are a number of reports or documents on the public file that do make a specific reference to JNP. These are:

- (i) as acknowledged prior art in the original application for a patent filed on 9 October 2017,
- (ii) as an X-category document in the further search report dated 24 January 2018 prepared by the examiner in response to a request from the applicant for a search on the second invention following the plurality objection raised in relation to the application as filed. This further search report was published before grant as part of the A specification; and
- (iii) the patent applicant, as they were then, identified and addressed the relevance or not of JNP to novelty and inventive step in their letter dated 23 July 2019 explaining why the proposed amendments to the application have addressed the issues in relation to this citation.
- (iv) as acknowledged prior art in the granted patent published on 27 May 2020,
- (v) as one of the documents in the 'Documents Cited' section cited on the front page of the published granted patent specification.

All of these documents are publicly available on IPSUM and were available to the public prior to and at the time that the request for an opinion was made<sup>10</sup> even though the exam report dated 18 November 2019 was not. I am satisfied that there was enough information before the requestor and the public in general to indicate that the JNP document had been before the examiner and that it had been considered as part of the search and examination process leading to the grant of the patent. As a patent had actually been granted, I am satisfied that there was enough information on the public file to infer that the examiner did not consider that the cited JNP document was sufficient to prevent a patent from being granted.

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<sup>9</sup> I have checked and can confirm that these documents are now publicly available.

<sup>10</sup> See the entry for patent application GB1716505.1 or granted patent GB2571696 on IPSUM [here](#)

- 45 I do not consider that Kohn was disadvantaged by the fact that this exam report was not made available on IPSUM as would have been expected to happen in the normal course of events after the report was issued to the patent holder. Clearly in this case this did not happen. However, the intention to grant letter dated 27 December 2019 issued by the examiner was made available on IPSUM as usual shortly after being sent to the applicant and so was publicly available before the request for the opinion was made. Thus, there was a document on the public file prior to the grant of the patent that indicated that the examiner considered that the application, as amended, now complied with the requirements of the Act.

### **Conclusion**

- 46 Taking all of the above into account, I can find no reason to conclude that the preliminary view of the Office to reject the request for an opinion in relation to the validity of GB 2571696 B was not appropriate.
- 47 For the reasons I have outlined above, I refuse the request made under section 74A by Kohn & Associates PLLC for an opinion in relation to the validity of GB 2571696 B on the grounds that I consider it is inappropriate in all the circumstances to issue such an opinion

### **Other Matters**

- 48 Given the conclusion I have come to above, I would observe that refusing a request for an opinion does not preclude the requester of an opinion from subsequently seeking revocation of the patent under section 72 of the Act. While such a decision is entirely a matter for Kohn (or indeed any other interested third party) and is not relevant to the present case, it does provide the opportunity for a fresh consideration of the novelty and inventive step of an invention as claimed in a granted patent. I appreciate that this option takes more time and resources and is more expensive than the opinion route, it does provide a legally binding decision as to whether or not the granted patent of interest is valid.

### **Appeal**

- 49 Any appeal must be lodged within 28 days after the date of this decision.

**Dr L Cullen**

Deputy Director, acting for the Comptroller