



comptroller should exercise discretion and allow the extensions of the compliance and Rule 19 periods for filing a further divisional. As a fallback, they requested a hearing on this if the examiner was minded not to allow the request. They did not file the further divisional mentioned at that time.

- 5 The examiner wrote to the applicant on 15 December 2022 declining to exercise discretion, setting out their reasoning and indicating a hearing would be arranged.
- 6 On 18 January 2023 the applicant submitted skeleton arguments and further evidence regarding their personal circumstances at the relevant times. I am grateful both for these submissions and that they were filed in good time prior to the hearing.

### **Confidentiality**

- 7 At the hearing the applicant requested that elements of the letters explaining the applicant's personal circumstances and accompanying evidence be treated as confidential. This was allowed under Rule 53(1). Also, I have limited the contents of this decision to not include the sensitive personal information disclosed in the letter or at the hearing. I do not believe that this will impede the understanding of my reasoning.

### **The hearing and oral decision**

- 8 The matter came before me at a hearing on 26 January 2023, which the applicant attended along with her representative Mr Ed Clarke of ip21. After hearing the arguments, and in view of the timescales under which the discretion sought could be exercised, I gave an oral decision on the critical points.
- 9 In summary, and with the benefit of the additional evidence supplied in the skeleton arguments and at the hearing, which was not available to the Office when it reached its preliminary decision, I accepted the applicant's explanation for requesting discretion to allow an extension of the compliance period were exceptional in terms of severity and extent and that they had been sufficiently diligent making reasonable allowances for their personal circumstances. I decided that I would exercise discretion to allow the two extensions of the compliance period of this application under Rule 108(3).
- 10 This would provide the applicant with the opportunity to file a new divisional application based on this application on or before 27 January 2023 (the following day). Any such divisional application would need to be accompanied by a request under Rule 108(1) to exercise discretion to allow the antedating with less of the compliance period remaining on this application than provided for by Rule 19(2)(b) (and they subsequently did so).
- 11 I explained that I was not able to give a decision on the request under Rule 108(1) as the divisional had not yet been filed, but I indicated that I would be minded to exercise discretion should the request be filed correctly and in time.

### **The Law**

- 12 The relevant provision in relation to the filing of a divisional application is section 15(9) of the Patents Act 1977 (as amended), which reads:

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

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- (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.*

13 The relevant rule is rule 19 of the Patents Rules 2007 (as amended) which states:

- (1) For the purposes of section 15(9) a new application may only be filed in accordance with this rule.*
- (2) A new application may be filed as mentioned in section 15(9) if—*
  - (a) the earlier application has not been terminated or withdrawn; and*
  - (b) the period ending three months before the compliance date of the earlier application has not expired.*
- (3) A new application must include a statement that it is filed as mentioned in section 15(9).*

14 In relation to the compliance date the relevant provision is Section 20(1) of the Act which states:

*If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and the rules, the application shall be treated as having been refused by the comptroller at the end of that period, and section 97 below shall apply accordingly.*

15 The prescribed period is set out in Rule 30:

- (1) The period prescribed for the purposes of sections 18(4) and 20(1) (failure of application) is the compliance period.*
- (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.*
- (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.*
- (4) Where the first observations report is sent to the applicant during the last three months of the period specified in paragraphs (2) or (3), the compliance period is three months beginning immediately after the date on which that report is sent.*

16 Also relevant are Rule 108 of and Schedule 4 to the Patent 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 immediately after 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.*

17 For the purposes of 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.

18 In reaching his decision not to exercise discretion the examiner referenced the court decisions in *J v K*<sup>1</sup> and *Luk Lamellan*<sup>2</sup>, and the Hearing Officer's decisions in *Ferguson*<sup>3</sup> and *Knau*<sup>4</sup>.

### **The GB2218041.9 divisional application**

19 At the hearing Mr Clarke accepted that GB2218041.9 was filed too late to be given antedating from GB2207669.9 and that there was no discretion available in this matter. The period specified by Rule 19(2)(b) for filing of a divisional application on

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<sup>1</sup> *J v K* and another [2019] EWCA Civ 5

<sup>2</sup> *Luk Lamellan und Kupplungsbau GmbH's Application* [1997] RPC 104

<sup>3</sup> BL O/272/09

<sup>4</sup> BL O/098/13

GB2207669.9 (in view of not having first requested a discretionary extension to the compliance period on GB2207669.9 under Rule 108(3)) ended on 29 July 2022. This is four months and a day earlier than the date on which GB2218041.9 was filed and as such Rule 108(7) prevents exercise of discretion under Rule 108(1) to allow that application to proceed with antedating. Mr Clarke indicated that he would withdraw this application and he has since done so.

## The Arguments

- 20 The examiner's reasoning for declining to exercise discretion follows the practice for considering whether to allow extension of the compliance period to allow for the filing of divisional applications set out in *Luk Lamellan, Ferguson and Knauf*. Under that practice discretion will normally be exercised only if the applicant shows that the circumstances are exceptional and that they have been properly diligent. The examiner accepted, in view of initial submissions about the applicant's personal circumstances, that the circumstances are exceptional. However, they highlight various earlier points during the processing of the family of applications when the need for the new divisional might have been apparent and conclude that the submissions did not demonstrate that the applicant has been properly diligent. To support this conclusion, they draw upon the decision by the Court of Appeal in *J v K* regarding a missed deadline in an appeal of an Employment Tribunal decision which found that justice required the grant of an extension provided the delay has not been long, because the applicants are not the only party whose interests have to be considered.
- 21 In the skeleton arguments of 18 January 2023, and at the hearing, the agent elaborated on the reasons why they believe that discretion should be exercised in this instance. They supplied with the skeleton a considerable amount of additional evidence, not made available to the examiner, as to the applicant's personal circumstances. The skeleton arguments note that the decision in *J v K* diverges on the facts from this case as it concerns an apparent technical failure, but say it is notable that the extension was allowed on appeal and that the comments the examiner highlights in support of their position appear to be obiter.
- 22 The skeleton also comments on the balance between the rights of an applicant and those of third parties especially with respect to certainty around the compliance period. These note that it is currently not uncommon to take longer than four years and six months envisaged by Rule 30 and that patent rights in the United Kingdom can be granted by the European Patent Office where no equivalent restriction exists. They submit that third parties working on the same or similar technologies would not have a reasonable expectation that all UK patent rights which might affect their position would be in place within five years of the earliest priority date and that any risk to third parties in this case appears hypothetical.
- 23 On the topic of whether the applicant had been diligent the skeleton arguments submit that the question of diligence is superseded by the applicant's personal circumstances which affect her ability to manage various deadlines so the extension should be allowed. At the hearing I asked Mr Clarke to elaborate on diligence as I put it to him that the two issues could not be conflated. He accepted that the concept of diligence cannot be merged with that of exceptional circumstances. However, he proposed that the applicant's personal circumstances also spoke to the question of

diligence. Mr Clarke said that it was always the applicant's intention to protect this invention and that whilst a set of other divisional applications were filed earlier it wasn't until November 2022 that it became clear that the divisional application filed on 30 November 2022 had not been filed earlier.

24 The guidance the examiner refers to in *J v K* is taken from a larger passage:

*39. I am hesitant about prescribing any kind of detailed guidance ... about the exercise of what is inevitably a broad discretion which will fall to be exercised in a wide variety of circumstances. But I am persuaded that there may be some value in making the following few, very general, points:*

*(1) The starting-point in a case where an applicant claims that they failed to institute their appeal in time because of mental ill-health must be to decide whether the available evidence shows that he or she was indeed suffering from mental ill-health at the time in question. Such a conclusion cannot usually be safely reached simply on their say-so and will require independent support of some kind. That will preferably be in the form of a medical report directly addressing the question; but in a particular case it may be sufficiently established by less direct forms of evidence, e.g. that the applicant was receiving treatment at the appropriate time or medical reports produced for other purposes.*

*(2) If that question is answered in the applicant's favour the next question is whether the condition in question explains or excuses (possibly in combination with other good reasons) the failure to institute the appeal in time. Mental ill-health is of many different kinds and degrees, and the fact that a person is suffering from a particular condition – say, stress or anxiety – does not necessarily mean that their ability to take and implement the relevant decisions is seriously impaired. The EAT in such cases often takes into account evidence that the applicant was able to take other effective action and decisions during the relevant period. That is in principle entirely acceptable, and was indeed the basis on which the applicant failed in *O'Cathail* (though it should always be borne in mind that an ability to function effectively in some areas does not necessarily demonstrate an ability to take and implement a decision to appeal). Medical evidence specifically addressing whether the condition in question impaired the applicant's ability to take and implement a decision of the kind in question will of course be helpful, but it is not essential.[3] It is important, so far as possible, to prevent applications for an extension themselves becoming elaborate forensic exercises, and the EAT is well capable of assessing questions of this kind on the basis of the available material.*

*(3) If the Tribunal finds that the failure to institute the appeal in time was indeed the result (wholly or in substantial part) of the applicant's mental ill-health, justice will usually require the grant of an extension. But there may be particular cases, especially where the delay has been long, where it does not: although applicants suffering from mental ill-health must be given all reasonable accommodations, they are not the only party whose interests have to be considered.*

*40. I emphasise that that guidance, if such basic propositions deserve that label, is not intended to be comprehensive. The facts of particular cases are likely to be infinitely variable, and it is not desirable to seek to resolve all possible issues in the abstract.*

25 In combination with the reasons and explanations given at hearing which the examiner was not previously made aware, it strikes me that the guidance in *J v K* supports allowing the extension to the compliance date of this application in the

present circumstances. The evidence shows that the applicant was suffering from ongoing personal problems of sufficiently serious nature at the time when earlier decisions about filing divisional applications were made. I am content that although the evidence does not specifically comment on the impact her personal problems have on her decision-making ability that this was indeed impacted at the relevant times.

- 26 The decision does not expand on what might be considered a long delay (nor would I expect it to), but as Rule 108(7), which specifically prevents discretion from being granted in cases where there has been a delay longer than two months, does not apply to the requested extensions, I conclude that the delay was not long in the relevant sense. That the applicant has had a long time when they might have filed the divisional application does not, of itself, equate to a “long delay” in the relevant sense. Also, whilst the applicant is not the only party whose interests have to be considered, I do not think the interests of a third party supersede the interests of the applicant in view of the evidence.
- 27 On that basis, at the hearing, I found that it is right and proper to exercise discretion and allow extension of the compliance date in this case based on the evidence before me in view of the guidance in *Luk Lamellan* and *J v K*.
- 28 The two requests made under Rule 108(3) each extend the compliance period by two months from 29 October 2022. The compliance period of the application in suit is therefore extended to 28 February 2023.
- 29 With the compliance period extended to 28 February 2023 the period allowed for filing a divisional application set out in Rule 19(2)(b) ended on 28 November 2022. The discretion available under Rule 108(1), keeping in mind Rule 108(7), means that the last date antedating of a new divisional application could be allowed without further extensions to the compliance period under Rule 108(3) was 27 January 2023 (the day after the hearing).
- 30 The applicant subsequently filed a divisional application on 27 January 2023, and I exercised discretion under Rule 108(1) to extend the rule 19(2)(b) period, for filing a divisional application.

### **Conclusion**

- 31 With the benefit of the additional evidence supplied in the skeleton arguments and at the hearing, which was not available to the Office when it reached its preliminary decision, I found that it was proper to exercise discretion and allowed the extension of the compliance date under Rule 108(3) in an oral decision.
- 32 The compliance period of the application in suit was therefore extended to 28 February 2023. Discretion under Rule 108(1) was therefore available to allow the antedating of a further divisional application with less of the compliance period remaining on this application than provided for by Rule 19(2)(b) provided the new divisional application was filed on or before 27 January 2023. The applicant subsequently filed a divisional application on 27 January 2023 requesting that I exercise discretion under Rule 108(1) to allow the antedating with less of the

compliance period remaining on this application than provided for by Rule 19(2)(b) which I also allowed for the same reasons.

**Appeal**

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

J Pullen

Deputy Director, acting for the Comptroller