



PATENTS ACT 1977

APPLICANT	Musco Corporation
ISSUE	Whether to exercise the discretion of the Comptroller under rule 108(1) to extend the period of time allowed under rule 19 for filing a divisional application under section 15(9)
HEARING OFFICER	Ben Buchanan

DECISION

Introduction

- 1 This decision relates to whether to allow the late filing of patent application GB2217981.6 (hereinafter, 'the later application'), in order to be divided from application GB2101995.5 (hereinafter 'the earlier application') and thereby to be accorded the same filing date. The issue came before me to decide on the basis of the papers on file. For the avoidance of doubt, this decision is neither concerned with any technical aspect of the application nor of the patentability of the claimed invention.
- 2 I note that in the examiner's pre-hearing report, the issue to be decided was phrased as follows:

Whether discretion should be exercised under rule 108(1) to extend the period for filing divisional application GB2217981.6 from parent application GB2101995.5.
- 3 However, only if the requirements of rule 19 have been met can the later application be treated as a divisional application under section 15(9) and referred to as such. It seems to me that, given the application has already been filed and associated fees paid, the issue may be more accurately expressed as follows:

Whether to exercise the discretion of the Comptroller under rule 108(1) to extend the period of time allowed under rule 19 for filing a divisional application under section 15(9) of the Act.
- 4 This is a subtle difference and in all likelihood is semantic. However, as we will see, the issue is more complex than it first appears and anyway now that the present application has already been filed, the instant question is whether or not it can be

treated as having, as its date of filing, the date of filing of the earlier application (i.e. whether it can derive “divisional” status). This is the issue I will address here.

Background

- 5 I have attached a timeline of relevant events as an Annex to this decision in addition to the following summary. The earlier application was filed on 23rd July 2019 in the name of Musco Corporation and claimed an earliest priority date of 26th July 2018. It was first published as international application WO 2020/023466 on 30th January 2020 and republished as GB 2590320A on 23rd June 2021 following its entry into the UK national phase. In accordance with rule 30(2)(ii), reproduced below, the compliance period was set to expire on 26th January 2023.
- 6 The first substantive examination report for the earlier application was issued by the UK IPO examiner on 29th November 2021. In that report, the examiner raised an objection on the grounds of plurality of invention, among other things. The claims were subsequently amended to relate to a single invention in the response dated 31st March 2022. Two further examination reports were issued before the application was found to be in order for grant.
- 7 A letter was issued by the examiner on 31st October 2022 informing the applicant of an intention to grant the earlier application shortly after 30th November 2022. It is important to note that at the time this letter was issued, less than three months remained until the end of the compliance period. The latest date on which a divisional application could have been allowably filed without extending the compliance period of the parent application (which could have been done as of right) was 26th October 2022.
- 8 On 30th November 2022, more than one month later, the present application in question was filed and antedating¹ was requested. On the face of it, the request for a new application to assume divisional status was made too late. On 5th December 2022 the applicant’s representative realised this and filed a Form 52² in an attempt to effectively extend the time period for filing a divisional application. On 13th December 2022, a grant letter was produced for the earlier application, and was issued the next day on 14th December. On 9th January 2023, the examiner issued a letter explaining that discretion to allow the late filing of a divisional application could only be exercised if it was shown that the reasons for the late filing were due to exceptional circumstances and that the applicant had been properly diligent³. Since no such reasons had been given, the examiner invited an explanation of the circumstances behind the late filing.
- 9 The attorney acting on behalf of the applicant responded by letter on 11th January 2023, in which they provided a detailed explanation. The examiner replied shortly

¹ Antedating is to treat it as having, as its date of filing, the date of filing of the earlier application. The request is made in part 6 of Form 1 which satisfies rule 19(3) and enables the later application to be treated as a divisional application under section 15(9) if the other requirements of rule 19 are met.

² The Form 52 was filed on the later application, rather than the earlier application (presumably in error, intending to extend the remaining compliance period of the earlier application to more than three months), but in any case would not have provided a remedy as the earlier application had already been filed. This is discussed later in the decision.

³ From Penwalt Corporations’s Application BL O/72/82 covered later in this decision.

afterwards on 17th January 2023, in which he explained that the reasons given for the late filing did not constitute exceptional circumstances and, consequently, antedating could not be permitted and divisional status could not be accorded. The examiner offered the opportunity to request a hearing to present further arguments and stated that in the event that no reply was received a formal decision would be issued by a senior officer based on the papers on file. No further response from the applicant has been received.

The law

- 10 The legal basis for divisional applications arises from section 15(9) of the Patents Act 1977 (as amended), which states:

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 of the earlier application

- 11 “In accordance with rules” refers to, in particular, rule 19 of the Patents Rules 2007 (as amended), which states (my emphasis added):

19.—(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)

- 12 “The compliance date” refers to the latest date by which a patent application must be made to fully comply with the requirements of the Act. Its legal basis arises from section 20(1):

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

- 13 Rule 30 sets out the prescribed period for putting an application in order, as follows:

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) *...*
 - (b) ***where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.***
- (4) *...*

14 Rule 19(2)(b) clearly requires that a divisional application be filed at least three months before the compliance date of its parent application. Since in this case the later application was filed after this, it would have first been necessary to extend the compliance period of the earlier application in order for rule 19 to be met. The rules regarding extensions of time are found in rule 108:

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.

(2) The comptroller shall extend, by a period of 2 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) ...

(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) ...

(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.

- 15 I note that rule 19 falls under Part 3 of Schedule 4, which provides rule 108(1) a mechanism by which the Comptroller may exercise discretion to extend the period of time in which to allow the filing of a divisional application. The considerations that apply when deciding whether to allow the late filing of divisional applications has previously been the subject of decisions issued by the IPO and by the courts. The Manual of Patent Practice (MoPP) summarises these decisions in paragraph 15.21:

The comptroller has discretion under r.108(1) to extend the period of time allowed under r.19 for filing a divisional application. However, this discretion will normally be exercised only if the applicant shows that the circumstances are exceptional and that they have 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](#))

The comptroller also has discretion to extend the compliance period of a patent application under rule 108(3) to allow a divisional application to be filed within the period prescribed by rule 19. This discretion will normally be exercised only if the applicant shows that the circumstances are exceptional and that they have been properly diligent (see [Ferguson's Application BL O/272/09](#) and [Knauf Insulation's Application BL O/098/13](#)).

- 16 Rule 30 falls under Part 2 of Schedule 4, and may be extended once as of right under rule 108(2) and further extended at the Comptroller's discretion under rule 108(3).
- 17 Finally, for reasons which I will explain later, it is also worth noting rule 107, which concerns the correction of irregularities:

107.—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2) Any rectification made under paragraph (1) shall be made—

(a) after giving the parties notice; and

(b) subject to such conditions,

as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—

(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default omission or other error by the comptroller, an examiner, or the Patent Office;

(b) it appears to the comptroller that the irregularity should be rectified.

Arguments and analysis

- 18 In summary, then, the later application was filed too late to be accorded divisional status. The two options to remedy this were:

- (i) Extend the compliance period of the earlier application under rule 108 (2) so that more than three months remained, thus permitting a divisional filing
- (ii) Request that the filing of the later application after the period specified in rule 19(2)(b) and the accompanying request for antedating be allowed at the Comptroller's discretion under rule 108(1)

19 In respect of (i) no request to extend the compliance period of the earlier application was received. The request, accompanied by a Form 52, to extend the compliance period of the later application is considered later in this decision. The option under consideration here, then, is a request (ii) to accept the late filing under rule 108(1).

20 From the summary of previous decisions presented in paragraph 15.21 of the Manual of Patent Practice, it is clear that in order to exercise discretion under rule 108(1) to allow the late filing of a divisional application, two conditions must be satisfied. First, it must be shown that the reasons behind the late filing are exceptional. Second, it must be shown that the applicant has been properly diligent. I will consider each of these in turn with reference to the circumstances presented in the attorney's letter.

Exceptional circumstances

21 In their letter of 11th January 2023, the attorney explained that the reason for the late filing was ultimately due to human error when inputting the deadline for filing any divisional applications into their in-house computer system. The deadline recorded was mistakenly based on that which would apply under European patent law, specifically 30th November 2022. The attorney also explained that this incorrect deadline was passed to the US-based applicant. The applicant's instructions for filing the later application were received on 29th November 2022 at 7:17pm, after the UK attorney's offices had closed for the day, hence why the application was not filed until the day after.

22 The attorney explained that this mistake was not detected until their own office procedures led to a review of the file on 5th December 2022, whereupon a Patents Form 52 was filed on the same day in the hope that the compliance period of the earlier application could be extended to allow the late filing of the later application. However, the Form 52 specified and was filed in respect of the later application, not the earlier application. This is not unusual in itself, in order to permit sufficient time for examination and to place the later application in order.

23 The attorney went on to explain that it is often problematic to obtain timely responses at short notice from US-based clients, especially when corresponding through intermediate US attorneys as in the present case. Under time pressure, the attorney argued that they had been diligent in obtaining instructions from the client and acting accordingly. The attorney sought to highlight this time pressure because it was indicated in *Penwalt*⁴ that the timing of events is important in determining whether the Office would exercise discretion in allowing the late filing of a divisional application.

⁴ [Penwalt Corporations's Application BL O/72/82](#)

24 Indeed, it does appear to me as though the UK attorney acted promptly in obtaining instructions under challenging time pressure from their client via an instructing attorney, both being located abroad. However, in assessing whether the circumstances in question were exceptional, I note paragraph 18.56 of the Manual of Patent Practice:

*It follows that factors which may be considered normal in relation to all or particular categories of application, e.g., the distance of an applicant's location from the UK, the complexity of the subject matter of the application or objections thereto, absence on business or holiday (see Decker's Application BL O/10/96), and a preference of the applicant to defer response until reports of parallel applications abroad have been received **do not constitute good grounds for an extension of the specified period**; on the other hand, extreme complexity or remoteness, such incidents as illness of or serious accident to applicant or agent, also fire and explosion, wars, revolutions, etc, and natural calamities, which destroy documents or dislocate normal operations, may do so.*

25 Although this paragraph concerns specified, as opposed to prescribed, time periods, it nevertheless provides some useful insight into what constitutes exceptional circumstances. In this case, the circumstances presented by the attorney—the distance of both the applicant and the instructing attorney from the UK—are not unusual, and are therefore considered unexceptional, among the applications received by the IPO.

26 Furthermore, although the prosecution of a UK patent application is a lengthy and complex process, which differs in some respects compared to the processes of other patent offices, the IPO has published extensive guidance to assist applicants and acting representatives alike. It is the responsibility of any applicant or their representative at all stages in this process to ensure that the correct documents are filed in a timely manner. Whilst unfortunate, occasional human error such as the recording of incorrect deadlines, is inevitable but not exceptional.

27 In view of these two points, I must conclude that the reasons for the late filing provided by the attorney do not constitute exceptional circumstances. I note that my conclusion is consistent with the decision in *Wei Xu's Application*⁵. In that decision, discretion was requested to exercise rule 108(1) on the basis of complexity and the applicant being based in China. However, these reasons were rejected by the Hearing Officer and the application was refused.

Properly diligent

28 In their letter, the attorney contended that both they and the applicant have acted with proper diligence throughout the prosecution of the earlier application and in filing the later application. In their pre-hearing report, the examiner indicates that he also considers the applicant to have been properly diligent.

29 I see no reason to conclude otherwise. At all stages in the prosecution of the earlier application, it appears that a genuine effort was being made to advance the application towards grant and that all responses were filed within allowable time periods. With regards to the later application, the attorney acted promptly when they

⁵ Wei Xu's Application BL O/610/22

reviewed the file and realised that an incorrect deadline had been recorded, and also subsequently in response to the examiner's initial letter.

- 30 It is worth noting that the wording of the intention to grant letter on the earlier application clearly states that the application would be granted on or soon after 30th November 2022. It also makes it clear that any divisional applications should be filed by this date and must be filed at least three months before the compliance date. However, under the specific circumstances, it does not seem fair to me that this instance of overlooking the standard wording in the intention to grant letter should wholly impugn the diligence of the applicant.
- 31 Finally, I note that the objection to lack of unity of invention raise by the examiner in their report of 29th November 2021 does not appear to have led directly to the filing of the later application some time later. This then does not alter my conclusion in respect of the diligence of the applicant.

The filing of the Form 52

- 32 It is unfortunate that a Form 52 was filed in respect of the later application and not the earlier one. As I noted above, this is not unusual, but with hindsight it seems highly likely (and indeed the attorney's letter of 11th January confirms) that the intention was to extend the compliance period of the earlier, rather than the later application to effectively extend the period for filing a divisional application under rule 19. Under time pressure and in the circumstances, this is an easy mistake to make. For completeness it should be stated that even if the Form 52 had been filed on the earlier application, it would not have changed the fact that *at the time the later application was filed* there was still less than three months until the end of the compliance period. A new divisional application would have to have been made. In this respect the requirement of rule 19(2)(b) is absolute and because the time period for filing a divisional application had passed, retrospectively extending the compliance period would have had no effect on the earlier filing. However, had the Form 52 error been noted at the time, action may have been taken in time to correctly request an extension to the compliance period of the earlier application (which under rule 108(2) would have been available as of right) and allow a new application under section 15(9) to be made. The last date on which this would have been possible, by extending the compliance period to three months hence, would have been 26th December 2022. As this is a public holiday, in effect the deadline would have been 24th December. The new divisional application would have had to have been filed by the same day.

Whether to exercise discretion under Rule 108(1)

- 33 Having found that the circumstances behind the late filing were not exceptional, even though the applicant had been properly diligent, I must conclude that discretion cannot be exercised under rule 108(1) to accord the later application divisional status. Consequently, it must be treated as a standalone application and take the filing date of 30th November 2022, the day on which the Patents Form 1 was filed at the IPO. In accordance with rule 30(2)(a)(i), its compliance period will expire four years and six months after this date on 30th May 2027. Since a Form 52 has already been filed and the associated fee paid, this compliance period is extended to 30th

July 2027. Antedating is not allowed and the later filing is not treated as having, as its date of filing, the date of filing of the earlier application under section 15(9).

- 34 Given that this application cannot take the filing date of the earlier application, the claimed invention would appear to lack novelty in light of the earlier application and will likely be ultimately refused.

Consideration of Rule 107

- 35 As above, having considered whether to exercise the discretion of the Comptroller under rule 108(1) to extend the period of time allowed under rule 19 for filing a divisional application, I have found that I will not. With that being said, upon review of the facts to consider the matter at hand, it appeared to me that there has been an irregularity in Office procedure in respect of the handling of the earlier application GB2101995.5. Paragraph 15.34 of the Manual of Patent Practice sets out the procedure for handling divisional applications that are filed with less than three months remaining on the compliance period but earlier than the date of issue of the grant letter for the parent. In particular, I note the following passages:

[...If an application seeking divisional status is received after the “parent” has been marked in order for grant and the grant letter has not yet been produced, the formalities examiner should set back the status of the case on COPS (for the search examiner to reinstate when appropriate) and minute the file to this effect. If the grant letter has already been produced but not issued, the formalities examiner should defer issue of the grant letter but should not take any action on COPS until the search examiner has indicated whether the parent should be withdrawn from the grant cycle. Where issue has already occurred, no further action can be taken as a divisional cannot be filed after grant of the parent.]

- 36 It is clear to me from the above that established Office practice, whilst not a legal requirement, was not followed. As a consequence, after the later application was filed, the earlier application should not have been granted until the examiner had considered whether the later application may proceed under section 15(9) including the request for antedating. Had this practice been followed, the examiner would have considered the later application before the earlier application was granted, and in the circumstances and in order to enable the earlier application to resume the process to grant quickly, this may well have happened urgently, before 24th December.
- 37 It is regrettable that the examiner did not issue his letter regarding the late filing of this application until after the earlier application had been granted, but for the avoidance of doubt, I do not consider this in itself to constitute a procedural irregularity. It is the failure to delay grant that constitutes the irregularity. Almost two full weeks had passed between the filing of the later application and the production of the grant letter for the earlier application. This is clearly enough time to have postponed the granting of the earlier application pending instructions from the examiner as per published Office procedure.
- 38 Had the published procedure been followed, the fact that the Form 52 was filed on the later application in error may have come to the applicant's attention before the earlier application was granted. Once the application was granted there was no opportunity for the applicant to take remedial action. The applicant would have had the opportunity to file a Form 52 in respect of the earlier application to extend the compliance period by two months as of right to 26th March 2023 and file a new

application under section 15(9) requesting antedating. Such an application subsequently filed by the date of 24th December 2022 could then have been accorded divisional status without the need for rule 108(1).

- 39 It is clear to me that this departure from published procedure was wholly attributable to an error made by the Office as per rule 107(3)(a). This error has resulted in the applicant being unfairly disadvantaged because they have been prevented from having the later application assessed under section 15(9) before the earlier application was granted, whereafter no extension could be obtained, nor other divisional application be filed. Had this happened, as it should have done, it is my belief – and in this respect I am giving the applicant the benefit of the doubt – that the assessment would have been carried out in time to enable the filing of a Form 52 to request an extension to the compliance period of the earlier application as of right and permit the filing of a divisional application in time without recourse to the Comptroller’s discretion. The basis for this belief is that to do otherwise inhibits the effect of delaying grant. The Office thus has a responsibility to rectify this irregularity as per rule 107(3)(b).
- 40 Since the compliance period falls within the remit of what may be extended under rule 107(3), it is possible for me to use rule 107(1) to extend the compliance period of the earlier application. This course of action would put the applicant into the same position they would have been in had the proper Office procedure been followed. However, there are two complicating factors.
- 41 The first complicating factor is that the earlier application has already been granted. section 15(9) of the Act clearly requires that for a divisional application to be filed, its parent must not yet be granted. Therefore, before rule 107(1) can be used to extend the compliance period of the earlier application, the granting of the earlier application must first be temporarily rescinded, also using rule 107.
- 42 The second complicating factor is that the procedure for filing divisional applications has recently changed. For all divisional applications filed on or after 1st May 2023, the Office will accord a compliance period that is the same as the un-extended compliance period of the respective parent application⁶. Therefore, even if the grant of the earlier application was rescinded and rule 107(1) was used to extend its compliance period, the compliance date of any subsequently filed divisional application would, under this new practice, seemingly be 26th January 2023, which has already passed.
- 43 Consequently, to rectify the procedural irregularity, not only must the granting of the earlier application be temporarily rescinded, and rule 107(1) used to extend its compliance period, but the compliance date of any subsequently filed divisional application must also upon filing be appropriately set. At the time the irregularity occurred, the new approach was not in place, and in fact the new approach as set out in the Manual of Patent Practice at section 15.20.1 and on the IPO website⁷ only refers to parent applications with a compliance period extended under rule 108 (as

⁶ Manual of Patent Practice section 15.20.1

⁷ [Compliance periods on divisional applications - GOV.UK \(www.gov.uk\)](https://www.gov.uk/government/guidance/compliance-periods-on-divisional-applications)

opposed to rule 107). For the avoidance of doubt, I will also extend the compliance period of a new divisional application under rule 107(1) if necessary.

- 44 In respect of the extension to the compliance period for the earlier application, given how much time has passed since the expiry of the original compliance period of the earlier application, if I am to do this, I must select a date which is both fair for putting a divisional application in order, should one be filed, and timely for the benefit of third parties. In this respect I will pay close attention to how much time would have been available had the irregularity not occurred.
- 45 It cannot be determined when the applicant would have taken action, perhaps having realised the Form 52 had been inadvertently filed on the later application, had proper Office procedure been followed. If my belief is correct, it seems likely that the examiner would have reported sooner that antedating was not allowable, and then the applicant would have taken some time to formulate their response and take corrective action. It seems to me to be reasonable to assume that the examiner's report and the applicant's response might have occurred shortly after the earlier application was due to be granted, on the 14th December 2023, as grant cycles are not precise and only after this date would it be confirmed. This would have left about a week to extend the compliance period on the earlier application as of right and to file a new divisional application.
- 46 Consequently, if requested, I will rescind grant and set the compliance period of the earlier application to five weeks from the date of request under rule 107(1). This would give the applicant the opportunity to file a Form 52 on the earlier application to extend its compliance period by two months as of right, leaving nearly a week to file a new divisional application under section 15(9), within three months of the compliance period in accordance with rule 19. This time frame is tight, but I believe it is fair, and consistent with the timescale for resolving the situation that would have prevailed had grant been delayed, the examiner subsequently reported on antedating shortly thereafter, and the issue with the Form 52 come to light before the 24th December. I note also that the applicant will be given a notice period within which to decide whether to make this request.
- 47 It should be stressed that, in view of the complicating factors outlined above, not least the implications of rescinding and then reinstating grant, what is proposed here will not be carried out automatically but will instead only be done upon request by the applicant.

Conclusion

- 48 The request made in the attorney's letter dated 11th January 2023 for exercising discretion under rule 108(1) to allow the late filing of the later application to proceed under section 15(9) is not allowed because the circumstances behind the late filing were not exceptional. As a result, patent application GB2217981.6 will not be accorded divisional status and must instead proceed as a normal application, being given a filing date of 30th November 2022 and an extended compliance date of 30th July 2027.
- 49 However, I have found that there has been a procedural irregularity in respect of earlier application GB2101995.5 upon filing of the later application which was wholly

attributable to an error by the Office and which should be rectified. I am therefore willing to take action to rectify this error by, upon request, temporarily rescinding the grant of earlier application GB2101995.5 and setting its compliance date to five weeks from the date of this request using rule 107(1).

- 50 If the applicant requests this course of action, a subsequently filed new divisional application will be accorded a compliance date which will be the same date as the extended compliance period of the parent, using rule 107(1) if necessary.
- 51 I give the applicant within 28 days after the date of this decision to request that the above action under rule 107 be taken. If no response is received, the current applications will remain unchanged. The later application will proceed to search and examination, and as noted above it would seem unlikely to fulfil the requirements for novelty under section 2 of the Act. Whether or not the request to take action under rule 107 is made, the applicant may request to withdraw the later application GB2217981.6 and receive a refund of the search and examination fees under rule 106(3).

Appeal

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

Ben Buchanan

Deputy Director, acting for the Comptroller

Annex

Timeline of events

26 July 2018	Priority date (United States of America)
23 July 2019	Earlier application filed
31 October 2022	Notification of intention to grant letter issued
30 November 2022	Later application filed
05 December 2022	Patents Form 52 filed in respect of later application (actioned)
13 December 2022	Grant letter produced for earlier application
14 December 2022	Grant letter issued
09 January 2023	Examiner requests reasons for late filing of divisional
11 January 2023	Attorney provides letter detailing reasons for late filing
17 January 2023	Examiner rejects reasons for late filing; hearing offered
26 January 2023	Expiry of earlier application section 20 compliance date
26 March 2023	Extended section 20 compliance date of later application