



26 April 2011

PATENTS ACT 1977

APPLICANT Alan Stuart Radley

ISSUE Whether to allow a late response to an examination report under section 18(3) for patent application number GB0614419.0

C L Davies

DECISION

Introduction

- 1 Patent application GB0614419.0 entitled “User interface mechanism for manipulating focus plus context on a visual display system” was filed in the name of Alan Stuart Radley, an unrepresented applicant (the “applicant”) on 20th July 2006. The application was published as GB2440197 on 23rd January 2008.
- 2 In an e-mail dated 4th August 2009, the applicant requested accelerated examination, providing reasons which were accepted by the examiner. The first section 18(3) examination report (the examination report), in which the examiner raised a major patentability objection under section 1(2), subsequently issued on 11th September 2009 setting a latest date for reply as 11th January 2010 (the specified period). In a covering letter, the examiner informed the applicant that accelerated examination had taken place and that he would deal as quickly as possible with any response to the objections in the report. The applicant neither contacted the examiner to discuss the examination report nor filed a response by the specified period.
- 3 On the 2nd December 2010, the Office issued as a matter of routine, a letter “Warning of refusal under Section 20(1)” (WR1 letter), indicating that since no reply to the examiner’s report dated 11th September 2009 had been filed, the latest date being 11th January 2010, in accordance with section 20(1) of the Patents Act 1977 (the Act), the Office intended to treat the application as refused shortly after 20th January 2011, the compliance date the deadline by which the application has to meet all of the requirements of the Patents Act and Rules if a patent is to be granted.

- 4 On the 4th January 2011, the applicant telephoned the examiner to discuss his application and during the course of conversation, he made it clear that he would like to continue with the prosecution of his application. He also informed the examiner that he had not received the WR1 letter. The examiner advised the applicant to put his reasons for late response to the examination report in writing, together with his observations on the examination report and if necessary, an amended set of claims to continue any examination and he also gave information regarding extending the compliance date and details about the hearings process .
- 5 In a subsequent letter received on 20th January 2011, the applicant provided reasons for not replying to the examination report and a F52 plus fee to extend the compliance date, as advised by the examiner, and in a further letter received on 27th January 2011, provided a response (the late filed response) to the examination report, together with an amended description and amended set of claims.
- 6 In a further letter to the applicant dated 28th January 2011, the examiner declined to accept the late filed response on the basis that the applicant had not provided a suitable reason to enable him to accept it. The applicant was offered a hearing which he accepted.
- 7 The issue of whether to allow the late filed response subsequently came before me at a hearing on 22nd February 2011 to decide.

The law

- 8 Section 18(3) of the Act reads:

18.-(3) If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.

Arguments

- 9 In the letter received on 20th January 2011, the applicant confirmed that his reasons for not replying to the examination report were that at that point in time, he believed the examiner was correct in the objections raised in the examination report with respect to the invention and hence he had not responded, but admitted that he changed his views on this when he became aware of two US patent applications which he believed covered or overlapped the same inventive concept as his application. This led him to re-consider the objections raised by the examiner in the examination report and to question whether the examiner had in fact been wrong in his objections and application of the law and hence his desire to proceed with the application.

- 10 The examiner reported to the applicant in the letter dated 28th January 2011, that he was unable to accept the late filed response because he did not consider the reason provided by the applicant to be a suitable reason: *“It is my understanding of your comments that you did not intend to respond within the correct period. However, your interest in the application was reawakened when you became aware of two patent applications filed in the US.”* The examiner pointed out that the law requires that failure to respond on time should be unintentional or that there must have been a continuing underlying intention to proceed with the application, referring to *Heatex Group Ltd’s Application [1995] RPC 546*, which makes it clear that a “change of mind on whether to proceed on the part of those responsible for its prosecution” is not a legitimate reason. The examiner pointed out that since the applicant had made it clear in his letter received on 20th January 2011 that he did not intend to continue with the application following receipt of the initial examination report, he (the examiner) had no option other than to decline to accept the late response.
- 11 In a letter dated 2nd February 2011, the applicant re-iterated the concerns he had over the examiner’s interpretation of his invention once he had become aware of the two US patent applications, and asserted that his reasons for late reply were not because he had changed his mind or did not intend to respond - he had always intended to progress the application within the boundaries of UK law- but was stopped “unintentionally” because he believed the examiner had misunderstood his invention. He asserted that on becoming aware of the two US patent applications, he felt the examiner had been wrong in his assessment and he had thus been mis-lead by the examiner.
- 12 The applicant re-asserted these arguments at the hearing, contesting that he had been mis-lead by the examiner with an unclear, very brief, examination report and stressing that he had always intended to continue with his application and that he had not simply changed his mind. He also admitted that at the time of receiving the examination report, he did not understand it but he accepted it at the time.
- 13 Whilst we did not discuss the specifics of the two US patent applications in detail at the hearing, we discussed in general that even though patent law differed within different jurisdictions, similar applications, if filed at the IPO would still be subject to exactly the same law & test for patentability (*Aerotel/Macrossan*) as the applicant’s invention.

Analysis

- 14 I must now decide whether discretion should be exercised to allow the late filed response to the examination report.
- 15 Examiners and hearing officers alike are duty-bound to follow the law and precedents in considering whether to exercise discretion to allow a late filed response and the Manual of Patent Practice (MoPP, paragraphs 18.54-18.60) sets out useful guidance in this respect. From these paragraphs, it may be seen that other hearing officers who have considered this issue have made it clear that it is in the public interest to resolve any uncertainty in a patent application as quickly as possible and therefore as further delays are incurred, the reasons for

these delays must be strong.

- 16 In deciding whether to exercise discretion, I will therefore take guidance from *Heatex Group Ltd's Application [1995] RPC 546* (as raised by the examiner in his letter dated 28th January 2011) and paragraph 18.54 of MoPP which states:

"When a reply is received after the expiry of the specified period and the automatic extension period of two months has passed, the reason, if not already given, should be asked for. If no reason is forthcoming refusal should be automatic. The application may be allowed to proceed if the substantive examiner is satisfied that the reasons provided by the applicant meet the criterion applied to requests for reinstatement i.e. if the reasons show that the applicant's failure to respond to the examination report was unintentional (see 20A. 13-16 for guidance on the meaning of unintentional). In such a case, the examiner may exercise the discretion accorded by section 18(3) to accept the late response, even though no extension to the specified period can be granted. However, it is not a formal requirement that the applicant must show that the failure to respond was unintentional in order for the application to proceed, and thus the discretion accorded by s. 18(3) may be exercised in appropriate circumstances even if this criterion is not met."

- 17 To exercise discretion, I must be satisfied that failure to file a response to the examination report within the period specified by the examiner (ie. 11th January 2010) was unintentional or there must have been a "continuing underlying intention to proceed with the application" (*Heatex*).
- 18 The applicant, in a telephone conversation with the examiner on 4th January 2011 and in his subsequent letter received on 20th January 2011, admitted that at the time of receipt of the examination report, he was satisfied with the examiner's assessment and accepted the examiner's view that it was unlikely that a patent would be granted on the application. At the hearing, he admitted that he didn't understand the examination report because it was unclear but nevertheless accepted it at the time.
- 19 I take from this, exactly like the examiner, that the applicant made a conscious decision not to respond to the examination report and this clearly indicates that the failure to file a response was not unintentional - rather it was an intentional, deliberate action. I therefore cannot exercise discretion to allow the late response on the grounds that the failure to reply was unintentional.
- 20 As I have found the failure to respond not being unintentional, I will go on to consider whether there are any other factors which would justify an exercise of discretion to allow the late-filed response.
- 21 At the hearing and in the correspondence, the applicant made it clear that he began to doubt the examiner's understanding of his invention and the problem which it sought to solve when he recently became aware of two US patent applications. He claimed that the examiner had failed to understand the problem which his invention addressed, had mis-construed the claims, had provided him with an unclear and very brief examination report and he had thus been mis-lead by the examiner. He claimed that it wasn't until the US patent applications had

come to light that he had realised the examiner might have been wrong in his assessment.

- 22 On considering whether the circumstances leading to the failure to respond must have been set against a continuing underlying intention to proceed with the application as in *Heatex*, I take the same view as the examiner. It is clear to me that the applicant had effectively resigned himself to accepting the assessment put forward by the examiner in the examination report but had a “change of mind” when he became aware of the two US patent applications. In clear accord with *Heatex*, a decision not to proceed had been taken by the person authorised at the relevant date (ie. the applicant) and a change of mind on the part of the applicant is not an appropriate ground for favourable exercise of the Comptroller’s discretion.
- 23 Whilst the substantive issue of patentability was not the focus of the hearing nor for deliberation in this decision, it is clear to me from reading the case file that the examiner has given careful and thorough attention to prosecution of the current application. The examiner acceded to the applicant’s request to accelerate examination of the application and, on receipt of the examination report, even though the applicant admitted that he did not understand it completely, I note that he did not contact the examiner to seek clarification or further explanation. The examiner has, in his correspondence, clearly advised the applicant to seek the services of a patent attorney, has endeavoured to provide information regarding extensions of the compliance period, hearing process and advice on the patentability of his invention. To address the applicant’s concerns that the examiner has mis-lead him, I cannot find anything in the correspondence which I believe would substantiate such a claim.
- 24 Patent examiners play an impartial role in the prosecution of patent law, are technical specialists and competent in applying patent law relating to section 1(2). It is clear to me that the examiner has gone to great lengths to help the applicant but he is duty-bound to follow practice/law and has done so in this respect in not deviating unjustifiably from established practice to allow the applicant’s late filed response.

Conclusion

- 25 I decline to exercise discretion to allow the late-filed response to the examination report and therefore refuse the application under section 18(3) for non-compliance within the specified period.

Appeal

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

C L Davies

Deputy Director acting for the Comptroller