

PATENTS ACT 1977

IN THE MATTER OF

Patent Application No.
GB 9522833.4 in the name of
Clive Vincent McNally

DECISION

Introduction

- 1 This decision arises out of the failure of the applicant Clive Vincent McNally, who is prosecuting his application without professional assistance, to reply in time to a combined search and examination report issued under sections 17 and 18(3) of the Act. Correspondence between the Patent Office and Mr McNally has failed to resolve the matter, and a hearing was offered by the examiner in a letter dated 16 November 2000.

- 2 The hearing was postponed twice because Mr McNally was unable to attend. On 4 January 2001, the Office wrote to him re-appointing the hearing but refusing without good reason to postpone it again. In the letter, Mr McNally was given the opportunity, if he anticipated difficulties in attending, of asking for the matter to be decided on the basis of the papers on file, including any further evidence which he wished to submit. Mr McNally replied on 24 January 2001 asking, because of unavoidable business commitments, for the matter to be dealt with in this way, and confirmed that there was no further evidence that he wished to have taken into account. It therefore falls to me to decide the matter on the papers.

Background

- 3 The application in suit, No. GB 9522833.4, relates to a receptacle for attachment to an animal, particularly a horse, to collect its droppings. It was filed on 8 November 1995 in the name of Clive Vincent McNally, and the address for service was given as Whitehouse Farm, Earlswood, Solihull, B94 5DX (hereinafter “Whitehouse Farm”).

- 4 The application included requests for both search and substantive examination. A preliminary examination report dealing with formal matters was issued on 24 November 1995, to which the applicant replied by fax dated 28 November 1995. A combined search and substantive examination report, objecting to lack of clarity and citing six documents to demonstrate lack of novelty, was issued on 15 January 1996 and set a latest date for reply of 10 November 1997. In accordance with section 18(3) of the Act, and in line with usual Office practice, a warning was given that the application might be refused if there was no reply by this date. The application was published as No GB 2306874 A on 14 May 1997.

- 5 Rule 34 of the Patents Rules 1995 prescribes a period of four years and six months from the priority date for putting the application in order, and this expired on 8 May 2000. On

23 February 2000, there having been no reply to the search and examination report, the Office issued a letter informing Mr McNally that it was intending to treat the application as having been refused on 8 May 2000. This is a standard practice of the Office, aimed at protecting applicants in the event that something untoward might have happened, such as correspondence being lost in the post.

6 On 4 July 2000, Mr McNally telephoned the Office stating that he wished to continue with the application. In a letter dated 7 July 2000, the Office explained that, in order to extend the time allowable, he would now need

- to request the discretion of the comptroller under rule 110(4) of the Patents Rules 1995 by filing the appropriate form (Form 52/77) and fee; and
- to send with the request a full written response to the combined search and examination report, together with evidence in the form of a statutory declaration or affidavit explaining why he did not file the response in time.

(Rule 110(3) of the Patents Rules 1995 allows a one month extension to the rule 34 period as of right on filing of Form 52/77 with fee, but extension beyond that is at the discretion of the comptroller and is governed by rule 110(4).)

7 Mr McNally filed the form and fee under the cover of a letter from Whitehouse Farm dated 1 August 2000. The letter did not give any reasons why the extension should be allowed, and merely stated that the essential difference between the application and the cited documents was that the invention had a disposable liner which appertained to a horse. The Office wrote on 3 August 2000 pressing the need for a statutory declaration or affidavit, and on 4 September 2000 Mr McNally filed a statutory declaration, declaring:

“I was not able to respond to the Combined Search & Examination report in the time stipulated because I was in Cyprus and only returned recently. I was unaware that the deadline had expired, until it was brought to my attention.”

8 The examiner to whom the matter was referred did not consider these reasons sufficient, and wrote on 22 September 2000 giving Mr McNally an opportunity to provide further evidence. In a letter dated 28 September 2000 Mr McNally made the following points, which I can summarise as follows:

- i he had gone through a separation and had left Whitehouse Farm; his post was supposed to have been sent to him in Cyprus; but he had evidence that he did not receive it in full, due to deliberate acts by his ex partner;
- ii whilst he had always intended to continue with the application, he had left the matter some time before contacting the Office because he assumed that proceedings before it would take several years;
- iii he did not give a full written response, other than stating the obvious feature, because he had not engaged a patent broker; and he understood the Office to be saying that he should not do so until the patent was allowed to continue; and

- iv he did not return from Cyprus until the end of May; the notice of refusal dated 23 February 2000 was in correspondence that should have been forwarded to him but was not.
- 9 In a letter dated 4 October 2000, the examiner sought further information as to when the applicant was in Cyprus and when he came into possession of the combined search and examination report. Mr McNally wrote on 20 October 2000 making some further points, which again I summarise:
- v he was in Cyprus from November 1995 and returned in April 2000 (which his accountant and solicitor could confirm if necessary);
- vi whilst living there full time he did periodically visit his parents in the UK but did not return to Whitehouse Farm where his ex partner was living;
- vii he dealt with the Combined Search and Examination report within two weeks of his return from Cyprus; and
- viii he intended to instruct a patent broker to conclude matters if the Office allowed the extension of time.
- 10 The examiner still did not consider these reasons sufficient, and offered the hearing to which I have referred above.

Assessment

- 11 The established practice of the Office is that:
- for the comptroller's discretion to be exercised in favour of extending the period for reply specified in an examination report under section 18(3) of the Act, the applicant must have some adequate reason which is peculiar to the particular applicant or application in suit; and
 - where it is sought to extend under the provisions of rule 110(4) the period prescribed by rule 34 for putting the application in order, there must have been a continuous underlying intention to proceed with the application, and in the interests of public certainty discretion should not be allowed on the basis of a change of mind. (This practice was drawn to Mr McNally's attention in the Office's letter of 7 July 2000).

I must satisfy myself that both of these requirements have been met, and it is with them in mind that I consider Mr McNally's arguments.

- 12 I understand Mr McNally in points (iii) and (viii) to be accepting that the application is not in order for grant as it stands, his comments on the citations being no more than observations as to how his application might be distinguished from the citations reported by the examiner. These do not in any case address the clarity objection raised by the examiner.

- 13 As to the engagement of professional assistance, I do not think that, when its letters of 7 July and 3 August 2000 are read together, the Office was intending to suggest that Mr McNally should delay until the matter of the extension had been resolved. If there has been a misunderstanding this is regretted, but I do not think anything hinges on this in the light of Mr McNally's remaining points, to which I now turn.
- 14 The timetable of events which Mr McNally gives in points (iv), (v) and (vii) is not easy to square with the papers on file, bearing in mind that up to 28 November 1995 (the date on his fax to the Office) he still appeared to have been at Whitehouse Farm. As to his date of return, points (iv) and (v) are inconsistent; further, even if he did not return until the later of the two dates, his next contact with the Office was not until his telephone call of 4 July, significantly longer than the two weeks suggested in point (vii). However, I do not deduce from all this anything more than that Mr McNally's recall of dates, some now quite distant in time, may perhaps be hazy and upon his return may well have been overshadowed by other events.
- 15 Of course, Mr McNally's absence need not have prevented a timely reply to the report if there had been a robust and reliable system in operation for his post to be forwarded. It would seem from points (i) and (vi) that he left this entirely in the hands of his ex partner who was still living at Whitehouse Farm, and that he made no attempt to return there to collect anything on his visits to the UK. At some point in time the arrangement would seem to have broken down, so that Mr McNally did not receive the notification of 23 February 2000. Mr McNally does not explain precisely when the breakdown happened, whether it was a temporary or permanent difficulty, or how much of his mail was affected. Neither does he explain why he felt able to trust his ex partner to forward his mail, rather than adopt what might have been the more prudent course of providing the Office with an alternative address for service in the United Kingdom.
- 16 Further, this very sketchy account is deficient in a number of important and specific respects. In his letter of 22 September 2000, the examiner asked for a full explanation, amongst other things, of the circumstances which existed at the time when a response to the combined search and examination report should have been filed, and of the steps which were taken to ensure that correspondence from the Office was dealt with in a timely and efficient manner. On these matters Mr McNally has remained silent. Although he says he has evidence that some of his mail was deliberately not sent on, he has not seen fit to give that evidence to the Office, despite being given an opportunity to do so.
- 17 In particular, Mr McNally has been unwilling or unable to explain when he first came into possession of the combined search and examination report, and why he left a period of some four years and seven months, from his fax of 28 November 1995 to his telephone call of 4 July 2000, to elapse without contacting the Office to enquire about the progress of his application, despite sometime in April or May 2000 having seen the notification that the Office was proposing to treat the application as refused.
- 18 On the latter point, I accept that Mr McNally could not be expected to be familiar with the Office's procedures. What I cannot accept is his argument in point (ii) above that he had left the matter some time before contacting the Office because he assumed the proceedings would take several years. He had received and acted upon the preliminary examination report dated 24 November 1995, which contained a prominent statement in

bold lettering that the results of the search would be sent some time in the next two months or so. I do not therefore think that Mr McNally can have been in any doubt at the time he left for Cyprus that the Office was processing the application and would wish to get in touch with him in the near future.

- 19 I do not therefore consider that he has put forward an adequate reason for extending the period for reply to the combined search and examination report. What is adequate must depend on the circumstances of the case, and it is not unusual for discretion to be exercised to extend a reply period by a short period of a month or so in order to overcome a temporary and unexpected difficulty. However, in view of the long delay which took place in the present case, it was in my view incumbent on Mr McNally to provide a full and detailed explanation of the circumstances which led to the failure to reply to the report in time. Despite being given a number of opportunities to provide further evidence or to put his case at a hearing, Mr McNally has declined to amplify the brief and incomplete details appearing from the papers on the file.
- 20 Mr McNally having failed to satisfy the first of the two requirements mentioned above, it is not necessary for me to decide whether, in accordance with the second requirement he had a continuing underlying intention to proceed. I therefore refuse the application.
- 21 I would however add that on the limited information on the papers I can find nothing which clearly points to a change of mind on the part of Mr McNally about whether to proceed with the application. Had it been necessary for me to decide this point I would have been prepared to give him the benefit of any doubt.

Appeal

- 22 Any appeal to the Patents Court must be lodged within six weeks from the date of the decision.

Dated this 14th day of February 2001

R C KENNEL

Deputy Director, acting for the Comptroller

THE PATENT OFFICE