

## **PATENTS ACT 1977**

### **IN THE MATTER OF**

Applications Nos. GB9915895.8 and

GB0008827.8 in the name of

Gordon Ross

### **DECISION**

1. Dr Gordon Ross has made a number of patent applications concerning structured communication frameworks over a period of years. Among these were application number GB 9915895.8 ("895") which was filed on 8 July 1999 and application number GB 0008827.8 ("827") filed on 12 April 2000. The applications were subject to the Patent Office's fast track processing route in which search and examination are carried out at the same time. The Combined Search and Examination reports issued on 27 November 2000 and on 18 May 2001 respectively.
2. Dr Ross filed amendments in response to the examination reports on both cases and the applications proceeded in the usual way with exchanges of letters between the Office and Dr Ross up to the point where the examiner on application 895 issued an examination report on 6 July 2001, requiring a response by 14 November 2001 and the examiner on application 827 issued an examination report on 9 August 2001 requiring a response by 12 April 2002. Dr Ross was required to respond by these dates in order to continue prosecution of the applications.
3. However, no further communications were received until February 2003 when Dr Ross filed a letter dated 21 February 2003 on both of these cases as well as on a number of his other applications. The letter made a number of general points about the processing of Dr Ross's various patent applications but did not address the specific issues on the individual cases. Both examiners consequently replied, in letters of 4 March 2003 and 12 March 2003 respectively, explaining that Dr Ross had failed to respond within the necessary time limit, and that the applications therefore stood to be refused. They explained that there was discretion to allow a late response if there were extenuating circumstances, but it was necessary to set out what the circumstances were, and the explanation for the delay would have to be such that discretion should be exercised in the applicant's favour. The examiners also pointed out that the letter of 21 February did not address the issues of concern in relation to the individual cases and that Dr Ross would have to provide a substantive response as well as satisfy the examiners on the issue of the overdue reply.

4. Dr Ross responded in letters of 10 March 2003 and 31 March 2003 on application 895 and on 19 March 2003 and 3 April 2003 on application 827. The first letter in each case set out an explanation for the delay in responding. According to this letter the delay was caused by the need to develop the technology of the invention by means of a project which had to be taken through a number of phases. Dr Ross indicated that the continued prosecution of the patent applications was dependent on the successful outcome of the development process. The second letter in each case gave further information about the development process and then provided an individual response to the examination points that were still outstanding.
5. During this period, the same issue of delayed responses and Dr Ross's explanation for the delay had arisen on some of his other applications, and a hearing was pending to consider whether the reasons given for the delay were appropriate to allow discretion to be exercised in order to allow them to continue. Consequently the examiners on 895 and 827 wrote saying that while they did not consider that the reason for the delay given by Dr Ross on these cases was such as to allow discretion to be exercised favourably, they proposed to wait for the decision to issue on the other cases subject to the hearing.
6. The decision, which has been allocated the SRIS reference number O/267/03, issued on 29 August 2003. It considered a number of factors put forward by Dr Ross, namely the pressure of work in developing his invention, family bereavements, redundancy, and non-receipt of some of the reports. Also that he claimed to have filed responses on time on three of the six cases. The Hearing Officer rejected the reason of pressure of work as being unexceptional, found that the family bereavements and redundancy had occurred some considerable time before the issue of the examination reports in question and so did not constitute good reasons, and was not able to accept that Dr Ross had not received four separate communications from the Office sent over a period of 3 weeks, thus rejecting that reason also. The Hearing Officer consequently refused the applications for failure to respond in time to the several Section 18(3) reports.
7. Following this decision, the examiners wrote concerning the present applications in letters dated 3 September 2003 and 4 September respectively. They set out in each case the history of the applications, and the similarity of the circumstances to those in the cases considered in decision O/267/03. They concluded that the decision did not overturn their opinion that the present cases should be refused for failure to respond in due time. Dr Ross was given until 3 October 2003 on each application to request a hearing but has not responded.
8. Having reviewed all the circumstances, I agree with the examiners concerned with these applications. The reasons given by Dr Ross for the delay in responding to the examination reports in each case are not such as to warrant the exercise of discretion to allow the applications to proceed. They are concerned with development of the technology of the invention and not with the process of prosecuting the patent application. It is common for technological development to occur alongside the

process of applying for and prosecuting patent applications, but it is necessary for the patenting process to adhere to its own timetable. I see nothing in the events Dr Ross sets out that would have prevented him from responding to the outstanding examination issues in the time allowed. I consequently refuse the two applications which are the subject of this decision, that is to say application GB 9915895.8 and application GB 0008827.8, for failure to comply with section 18(3) of the Patents Act.

**Appeal**

9. Any appeal must be filed within 28 days of the date of this decision.

Dated this 3rd day of November 2003

**P M MARCHANT**  
Deputy Director, acting for the Comptroller

**THE PATENT OFFICE**