



BL O/265/05

23 September
2005

PATENTS ACT 1977

APPLICANT Howmet Research Corporation

ISSUE Whether the grant of patent number
GB 2377401 B should be rescinded under rule
100 of the Patents Rules 1995

HEARING OFFICER R C Kennell

DECISION

Introduction

- 1 The patent in suit derives from application no. GB 0211639.0, which was filed on 21 May 2002 in the name of Howmet Research Corporation (a United States corporation), claiming a priority date of 22 May 2001 from an earlier US application. The application was published on 15 January 2003, and was subsequently amended following substantive examination. The applicant was notified of grant in a letter dated 26 April 2005.

- 2 On 12 May 2005 the applicant's UK patent agent, Mr Richard Doble of Langner Parry, telephoned to request that the grant should be rescinded under rule 100 of the Patents Rules 1995, which allows irregularities in procedure in or before the Patent Office to be rectified. In his letter dated 25 May 2005 he alleged that the grant was made in error because a divisional application was foreshadowed (i) in Langner Parry's response of 22 July 2004, which made amendments to remove the objection of plurality of invention in the examiner's first substantive examination report of 30 January 2004, and (ii) because the description in the granted patent referred at page 12 line 2 to a method embodiment of the invention, whereas the claims were directed to a fugitive pattern for the investment casting of metallic materials. There was therefore unclaimed subject-matter which was never abandoned. Mr Doble also suggested that (ii) was an inconsistency which required rectification.

- 3 The examiner to whom the matter was referred (Mr Matthew Lawson) did not accept that there was any irregularity, and in the absence of agreement the matter came before

me at a hearing on 28 July 2005, attended by Mr Doble and Mr Lawson. (I should mention that Mr Lawson is not the examiner who carried out the substantive examination.) Grant had in the meantime been announced in the Patents and Designs Journal on 25 May 2005.

The law

4 It will be helpful first to outline the relevant law governing this matter. Once the applicant has been notified of grant under section 18(4), the Act makes no specific provision for the grant to be rescinded. However, section 123(2)(b) gives the comptroller the power to make rules authorising the rectification of irregularities of procedure, and rule 100 of the Patents Rules 1995 accordingly states:

“(1) Subject to paragraph 2 below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct.

(2) In the case of an irregularity or prospective irregularity -

(a) which consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;

(b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and

(c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.”

The circumstances in which the Office has been prepared to rescind grant where there has been an irregularity in procedure are explained below.

Prosecution history

5 Mr Doble submitted evidence in the form of a declaration from Gary P Topolosky, now a special counsel with a Pittsburgh-based law firm Eckert, Seamans, Cherin and Mellott (“Eckert”). Mr Topolosky explains the sequence of events on the applicant’s

side leading up to the grant of the patent, and I will summarise these briefly.

- 6 The applicant, Howmet Research Corporation, is a wholly-owned subsidiary of Howmet Corporation, itself a subsidiary of Alcoa Inc. Mr Topolosky says that at the time the application was filed he was a patent attorney with Alcoa's IP Law Group in Pittsburgh with supervisory responsibility for Howmet's IP portfolio, although the ultimate authority for many IP matters including the filing of divisional applications rested with Howmet. This arrangement continued until 30 September 2003 when Alcoa disbanded the IP Law Group and outsourced responsibility for its IP function to Eckert, with Mr Topolosky joining the firm as special counsel on 1 October 2003.
- 7 However, initially Mr Topolosky retained only a supervisory responsibility for Howmet. The day-to-day responsibility in the present case rested with an attorney in private practice, Mr Edward Timmer, who had drafted and filed the originating US application before Mr Topolosky joined Eckert. The UK application was being handled by Langner Parry on the basis of instructions from Mr Timmer via its US associates Ladas & Parry. On 8 July 2004, in response to the Patent Office's first substantive examination report dated 30 January 2004 and objecting amongst other things to plurality of invention, Mr Timmer instructed Ladas & Parry to hold the filing of divisional applications in abeyance and asked for advice as to the latest date when they could be filed. Plurality of invention had in fact been raised by the Patent Office in its search report dated 7 November 2002. It appears that as a result of that report Mr Timmer had already been advised by Ladas & Parry in a letter dated 10 December 2003 that he had until August 2005 to file divisional applications, and that the additional search fees should be paid not later than April 2005 in order to ensure that the Patent Office had time to carry out the searches.
- 8 Mr Topolosky says that these dates were entered into Eckert's electronic docketing system. He explained that it was standard practice in Alcoa and other firms to defer the filing of divisional applications until the prospective divisional claims had been searched and their allowable scope had been settled, and that no decision had been taken in this case not to file divisionals.
- 9 All this took place against a background of Mr Topolosky gradually assuming closer control of Howmet's foreign patent portfolio, with overseas associates corresponding directly with him. He says that this resulted in a substantial extra workload which entailed him dealing with matters on a priority basis, so that Mr Timmer still gave the instructions to respond to the Patent Office's second examination report dated 26 August 2004. However following receipt of a third examination report dated 20 January 2005, it was Mr Topolosky - on the expectation of Eckert that the contact through Mr Timmer should be phased out - who gave instructions to Ladas & Parry on 2 March 2005 to respond.

- 10 At this point the question of what to do about the further inventions identified by the Patent Office remained in abeyance. From a timeline of events and associated correspondence submitted by Mr Topolosky, it appears that Eckert's docketing system generated a reminder on 1 April 2005 that the matter was outstanding, and that Mr Topolosky followed this up by e-mail enquiries to Mr Timmer and to Dr Martyn Matheson of Ladas & Parry on 6 and 7 April 2005 respectively. However these enquiries appear to have crossed with a letter sent by fax and mail to Mr Topolosky by Dr Matheson on 4 April 2005 asking for instructions about additional searches and divisional applications. Mr Topolosky does not recall seeing this until the fax reached his desk on 19 April 2005 and is unable to establish a reason for the delay; although the letter was mis-addressed to the Intellectual Property Law Group at Alcoa, he says that his office location had not actually changed. He believes the delay was most likely due to a technical communications problems or to a clerical error, and exacerbated by the changes in IP responsibilities within Eckert.
- 11 Having received the letter, Mr Topolosky contacted Howmet for instructions, as a result of which he e-mailed instructions on 25 April 2005 to Dr Matheson at Ladas & Parry for a search to be made on one of the further inventions identified by the Patent Office. Dr Matheson wrote accordingly to Mr Doble at Langner Parry on 2 May 2005. However, suspecting that grant of the UK patent might be imminent, Mr Topolosky e-mailed Dr Matheson again on 5 May 2005 instructing the filing of divisional applications on all the further inventions identified by the Patent Office. Unfortunately, by this time Langner Parry had already written to Dr Matheson (on 27 April 2005) notifying him of grant in the UK. I asked Mr Doble what exactly had prompted Mr Topolosky to raise the matter of divisionals at this stage, but Mr Doble was unable to shed any further light.

Arguments and findings

- 12 At the hearing Mr Lawson confirmed, in response to a question from Mr Doble, that he had taken the view that there was no irregularity in procedure in or before the Patent Office and that hence the question of whether or not discretion should be exercised to rescind grant did not arise. Mr Doble argued his case on the basis that there was an irregularity within the ambit of rule 100, and that if I found for him on that I should then consider whether discretion should be exercised.

Was there an irregularity in procedure?

- 13 At the hearing Mr Doble argued that the irregularity arose under rule 100(2) in that there was a failure to meet a time limit imposed by the Patents Rules, rule 24(2)(c) requiring a divisional application to be filed before the grant of a patent on the earlier application, and that this was attributable at least partly to the erroneous grant of a patent as explained in his letter of 25 May 2005. In response to my raising the point,

he did not specifically develop any argument that the conduct of the Office might constitute an irregularity in procedure for the purposes of rule 100(1), although I understood him not to be ruling out the possibility. In practice I do not think this greatly matters, because whether the matter is taken under rule 100(1) or 100(2) it would seem necessary for me to decide whether there has been something wrong about the conduct of the Patent Office in forwarding the application for grant.

- 14 As I have explained Mr Doble put forward two arguments for the grant being made in error. His first argument was that divisional applications had been foreshadowed by the statement

“The amendments are made without prejudice to the Applicants rights to seek protection subsequently in the prosecution of this application or on any divisional for any subject matter originally disclosed in this application.”

in Langner Parry’s letter of 22 July 2004, and that the Office was therefore at fault in granting the application without issuing a warning letter in circumstances where this would have been expected.

- 15 These circumstances are explained in the Office’s “Manual of Patent Practice” (5th edition), where the second bracketed entry under paragraph 15.46 explains (emphasis added in bold):

*“If a divisional application has been **foreshadowed** in a letter but not yet filed, an “in order” marking on the parent application should also be deferred. (Applicants should not be allowed to abuse this practice as a way of postponing grant or to keep options open as a matter of general policy (Luk Lamellan und Kupplungsbau GmbH's Application, [1997] RPC 104) but account should be taken of the genuine needs of applicants. If a divisional filing is “foreshadowed” in circumstances where division appears unlikely, the applicant should be asked for further details of his intentions.) **Whenever an applicant has indicated the possibility of filing a divisional application, or when an application is found to be in order following amendment to meet an objection under s.14(5)(d), EL26 should be issued provided that at least one month of the r.24(1) period allowed for filing divisionals remains.** If less than one month of this period remains EL26 should not issue but nevertheless the “parent” application should not be marked in order for grant immediately. When EL26 has issued the “parent” application subsequently should be sent for grant two months after the date of the letter if a divisional has not been filed or explicitly foreshadowed in the meantime. When EL26 did not issue because the expiry of the r.24(1) period was imminent, the “parent” should be sent to grant one month after the period has expired unless a divisional has been filed or explicitly foreshadowed before then. The application can be sent for grant earlier if the applicant or agent requests this in writing. If a*

definite intention to file a divisional application has been stated without any indication of timescale (or with an unreasonably long one) and no objections remain on the "parent", the examiner should write to the applicant indicating that if the application is found to be in order on or after a certain date (eg a month from the date of the letter) then it will be sent to grant, precluding the possibility of filing a divisional application."

16 The warning letter EL26 referred to in this paragraph gives the applicant one month to confirm whether a divisional is to be filed, and states that if the application is in order after that date it will be granted, after which no divisional may be filed. I should add that the practice of the Office in regard to EL26 was considered in *Luk Lamellan und Kupplungsbau GmbH's Application* [1997] RPC 104. However, at that time the relevant paragraph of the Manual was not open to public inspection and, in the absence of any other published statement identifying the circumstances in which EL26 would be issued, the Patents Court did not consider that the Office was guilty of any error, default or omission in complying with any established practice. I will need to consider whether that is still the case now that the paragraph in question has been published, since EL26 was not issued at any stage in the prosecution of the present application - although as explained above the application had been amended in response to the objection of plurality of invention in the first of the substantive examiner's three reports.

17 It will bear emphasising that, as is stated in the preface to the 5th edition, the Manual merely explains the Editor's view of current practice in the Patent Office under the Act. As the preface states:

"Statements made in the Manual are not in themselves an authority for any action by an officer of the Patent Office. While the Manual may be regarded as a guide to action, it does not impose any particular line of action, and may not be quoted to that end."

18 I put it to Mr Doble that statements of the type in the 22 July 2004 letter were frequently encountered in the prosecution of patent applications before the Office, and arguably might not be taken as foreshadowing actual intention to file a divisional application. Mr Doble did not agree; in his view rule 100 should be interpreted *contra preferentem* very strictly against the Office and in favour of applicants in deciding whether there was an error, default or omission by the Office. Thus the Manual led applicants to expect an EL26 letter in circumstances such as the present, and although the word "foreshadowing" was vague, the applicant was entitled to rely on it. It would therefore be sufficient for there to be, as Mr Doble put it, "even the very faintest shadow" of a divisional for the EL26 procedure to be invoked.

19 In response to a question from Mr Doble, Mr Lawson explained that in his experience,

when an application had been amended to remove an objection of plurality of invention, generally an EL26 letter would only be issued if the first amendment had removed the plurality and the application was otherwise in order for grant. If the applicant did not file divisionals in any subsequent actions, EL26 would probably not be considered necessary. Mr Doble thought that this was adding a gloss to the phrase “or when an application is found to be in order following amendment to meet an objection under section 14(5)d)” which would not be expected by someone in the applicant’s circumstances when reading the Manual. In any case he thought “foreshadowed” conveyed “an impression of something that might happen some considerable time in the future”. I pointed out to Mr Doble that, as explained in the *Luk Lamellan* case, the Office’s policy ought not to be used by an applicant to keep options open as long as possible, although accepting that the applicant was not in the present case trying to spin out the proceedings as appeared to be the case in *Luk Lamellan*.

20 As regards the first limb of the passage that I have highlighted, I do not think that a divisional application could be said to have been foreshadowed, or the possibility of a divisional application indicated, in Langner Parry’s letter of 22 July 2004. I do not read the paragraph in question as anything more than an indication that the applicant is not by reason of the amendment to be taken as abandoning any rights in the deleted subject-matter. Specifically I do not think that the wording “or on any divisional” does anything more than indicate one of the options open to the applicant - and the filing of a divisional is nearly always going to be an option once plurality of invention is established. For EL26 to be triggered, I think that the examiner is entitled to expect some indication that the applicant is actually contemplating filing a divisional application.

21 On the second limb of the passage, I confess to some difficulty with the word “following” - how closely should the “in order” finding follow on the amendment? I do not read in the Manual any indication that the Office should issue EL26 in all cases where the application has been amended to overcome plurality of invention; for instance, no reminder issues when there is less than one month remaining of the period prescribed by rule 24(1) for filing a divisional application. I do not therefore think it is necessarily wrong to decline to issue EL26 where some considerable time has elapsed since the amendment of the application (although I make no finding as to whether this in fact a general Office practice in the absence of further information). In the present case two further rounds of examination had taken place since the amendment, and I think the examiner was perfectly entitled to assume that by then the applicant had decided against filing a divisional. Indeed Mr Doble said at the hearing that he was not expecting it, not at that point having been made aware of what was happening at Howmet and Eckert.

22 That said I think there is some ambiguity in the wording in the Manual, which is as far

as I am aware the only public statement of the circumstances in which EL26 is issued. I am therefore prepared to give Mr Doble the benefit of the doubt, and I therefore find that there was an omission on the part of the Office in not issuing EL26 in the present case.

23 Turning now to the second limb of Mr Doble's argument on irregularity, he argues that although the reference to a method embodiment is a minor inconsistency, the Office would not normally have allowed it to remain and that the grant is therefore erroneous. He also suggested that the retention clearly foreshadowed a divisional application.

24 I do not agree. The claims of the application as granted are directed solely to a fugitive pattern and the statement of invention at page 2 corresponds with this. Although the examiner in the final report asked for the description to be brought into line with the claims as amended, no specific objection was taken to the reference to a method and it appears to have been overlooked. Nevertheless, I cannot see how the skilled reader would regard this as anything more than a minor hiccup or as anything which cast any real doubt on what the applicant was intending to protect. I think it strains credulity to suggest that this minor error is something which renders the grant erroneous or which in any way foreshadows the filing of a divisional application (since it does not indicate which of the two original method inventions might be contemplated).

Should discretion be exercised to rectify the irregularity?

25 However, even if there is an irregularity in procedure, it is not mandatory for the comptroller to rectify it. This is apparent from the wording "may be rectified, on such terms as he may direct" in rule 100(1) and from rule 100(2)(c). Mr Doble drew my attention to a wide range of precedents and literature references which in his view illustrated factors governing the exercise of discretion, from which I could infer that discretion should be exercised to rectify the irregularity in this case.

26 First, Mr Doble took me through a number of reported cases relating to procedure in the Office:

- *Textron Inc's Patent* [1989] RPC 441, in which restoration of a patent under section 28 of the Act was allowed by the House of Lords because the proprietor had taken reasonable care to ensure that a renewal fee was paid by appointing a competent person to deal with the matter, and the failure of that person to carry out the proprietor's instructions was beyond the proprietor's control. Correspondingly, Mr Doble argued, the mistakes of Eckert (in the person of Mr Topolosky), to the extent that any were made, should not be attributed to Howmet.

- *Heatex Group Ltd's Application* [1995] RPC 546, a case where an application

for a discretionary extension of time (under what is now rule 110(4)) to request substantive examination was disallowed because there had been no continuing intention to proceed with the application. Mr Doble drew support from the hearing officer's views (a) that the lack of provisions in the Rules equivalent to those in section 28 showed that the comptroller's discretion was not so tightly circumscribed in the restitution of an application as in the restoration of a patent, and (b) that an applicant should not suffer loss of rights through unforeseen circumstances where there was a continuing intention to proceed with the application. Thus Mr Topolosky's declaration established a continuing intention to proceed with divisional applications, the delay in the fax of 4 April 2005 reaching him constituting an unforeseen circumstance.

- *Jaskowski's Application* [1981] RPC 197, where the hearing officer declined to allow a request for an extension of time to reply to a substantive examination report under section 18(3) on the grounds that there was no adequate reason peculiar to the particular applicant or application in suit, and nothing abnormal in the chain of communications which would constitute such an adequate reason. In this case, Mr Doble said, the loss of the fax for about fourteen days was such an abnormality.

- The *Luk Lamellan* application discussed above, which Mr Doble distinguished on the grounds that the statements in the Manual were now public and, crucially, that the present application was still within the rule 24(1) deadline for filing divisionals of three months before the end of the rule 34 period for putting the application in order (or I assume would have been if the application had not been granted).

27 Mr Doble went on to draw my attention to various avenues showing increasing liberalisation in the exercise of discretion. He pointed out Article 12(1)(iv) of the Patent Law Treaty required a contracting party, where there had been a failure to comply with a procedural time limit which had the direct consequence that rights with respect to an application or patent had been lost, to reinstate those rights if

“the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.”

Mr Doble noted that in both matter of re-instatement of a patent application under the new section 20A of the 1977 Act and the restoration of a patent application under the amended section 28(3), the Regulatory Reform (Patents) Order 2004 had opted for the test of unintentional failure rather than due care. He thus thought that there was a strong public interest that the same principle should apply *a fortiori* to the exercise of discretion in a case such as the present.

- 28 He also drew support from developments in administrative law, arising from the development of a concept of “proportionality” by the courts and from the Human Rights Act 1998. On the former he took me to a standard work, Craig “Administrative Law”, 5th edition, pages 609 - 638, which explains this development in considerable depth. The concept is summarised succinctly at page 622 as requiring the court to consider whether a measure was both necessary and suitable to achieve the desired objective, and whether it nonetheless imposed excessive burdens on the individual. I do not think it is necessary for me to go into Craig in any detail, because as I understood it Mr Doble was merely seeking to show that the courts are increasingly moving away from the *Wednesbury* test (named after the 1948 leading case) of unreasonableness as the criterion against which administrative action is judged.
- 29 As Mr Doble put it, this was all about not using a sledgehammer to crack a nut. He urged on me that the applicant was in just such a situation, since the premature grant had imposed an excessive burden by depriving it of the option of filing divisionals, when an EL26 warning letter would have kept the option alive without undue delay in the grant of a patent and the attainment of the desired objective of public certainty.
- 30 Mr Doble went on to argue that there had also been a disproportionate burden in that the applicant had been deprived of a legitimate possession, namely the property in the deleted claims, the invention therein and the putative value of an application or patent containing those claims. He developed this argument via Article 1 of the First Protocol to the European Convention on Human Rights, now enacted in Part II of Schedule 1 to the Human Rights Act 1998:

“Protection of property

“Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law.

The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.”

as applied in the judgment of the European Court of Justice in *Pressos Compania Naviera S.A. v Belgium* [1995] ECHR 47, with particular reference to paragraph 38:

“38. An interference with the peaceful enjoyment of possessions must strike a “fair balance” between the demands of the general interest of the community and the requirements of the protection of the individual’s fundamental rights. The

concern to achieve this balance is reflected in the structure of Article 1 (P1-1) as a whole, including therefore the second sentence, which is to be read in the light of the general principle enunciated in the first sentence (see paragraph 33 above). In particular there must be a reasonable relationship between the means employed and the aim sought to be realised by any measure depriving a person of his possessions. ...

In this connection the taking of property without payment of an amount reasonably related to its value will normally constitute a disproportionate interference and a total lack of compensation can be considered justifiable only in exceptional circumstances”

- 31 For support that the right to file a divisional application was a possession or property under international law (in his submission the two had the same meaning since Article 1 was headed “Protection of Property”), Mr Doble turned to a paper from the Organisation for Economic Cooperation and Development “ ‘Indirect Expropriation’ and the ‘Right to Regulate’ in International Investment Law” (Working Paper 2004/4, September 2004), in which footnote 6 explains:

“In the context of international law, “property” refers to both tangible and intangible property. Under the Protocol 1 of the European Convention on Human Rights, the concept of property is very broadly defined by reference to all the proprietary interests of an individual. It covers a range of economic interests: “movable or immovable property, tangible and intangible interests, such as shares, patents, an arbitration award, the entitlement to a pension, a landlord’s entitlement to rent, the economic interests connected with the running of a business and the right to exercise a profession ... “

- 32 In developing this argument Mr Doble sought to distinguish the decision of the comptroller in *Anderson’s Application* BL O/297/02, in which the hearing officer refused to exercise discretion to allow the filing of a divisional application outside the rule 24(1) deadline. It was argued before the hearing officer that there had been a breach of Article 1. However, this failed because although the hearing officer accepted that a patent application was property under section 30(1) of the Patents Act 1977 and thus within the ambit of the Human Rights Act 1998, he thought that the applicant had had ample opportunity to patent his invention via the parent application. (The divisional application did not in this case result from a plurality objection.)

- 33 Mr Doble distinguished this case on the grounds that it related to an application which had actually been lodged with the Office, so that strictly any comments of the hearing officer were *obiter* as regards whether the right to file a divisional application is a property right. Counsel in *Anderson* had argued that once an inventor had made an

invention which satisfied the requirements of section 1 of the Patents Act 1997 then he had an objectively realisable right at that stage to a patent, and this was distinguished from cases such as *British American Tobacco v The Netherlands* [1996] 21 EHRR 409 and *Marckx v Belgium* [1979] 2 EHRR 330 which proceeded on the basis that Article 1 was concerned with existing possessions and did not guarantee the right to acquire property. The hearing officer did not agree that there was such a right to a patent, the message from *British American Tobacco* being that possession of a patent application said nothing about the possession of monopoly rights in the invention. As I understood it, Mr Doble distinguished this line of authority on the grounds that the applicant already had a property right given that property could be intangible as explained in the OECD paper.

34 Ingenious though Mr Doble's argument on proportionality and human rights is, I do not think that at the end of the day it gets him very far. I think that I should be wary of placing too much reliance on general statements of legal principle without considering the context in which they were made and the particular circumstances of the case in suit. Thus, in corresponding manner to the hearing officer in *Anderson* (paragraph 28 of his decision) I am of the view that I should look to the Patents Acts and Rules as implemented and interpreted in accordance with practice and precedent in order to decide whether the applicant can be allowed to file a divisional application in the present circumstances. In the absence of any more detailed argument on the point, I do not think that I can entirely abandon a consideration of whether the Office and the applicant acted reasonably in favour of a proportionality-based approach, although I would accept that I should aim to strike a fair balance between the legitimate expectations of the applicant and the public interest in certainty.

35 Turning to the various examples cited by Mr Doble of the exercise of discretion, I have to say that I do not find them particularly persuasive. *Textron* and *Heatex* would seem to be of little relevance now that Parliament has made unintentional failure the test for restitution of a patent application and restoration of a patent under sections 20A and 28 - but I do not think it follows from this that the same basis should apply to rescinding the grant of a patent to allow the filing of a divisional. Indeed the fact that Parliament has chosen not to legislate on the matter (section 20A is limited to the case where a patent application is refused or is treated as having been withdrawn or refused) suggests that different considerations may apply. I do not think that the hearing officer in *Heatex* had the present type of situation to mind in his comments about restitution.

36 The circumstances in which the Office is prepared to rescind the grant of a patent are relatively limited. As explained in the relevant parts of paragraph 18.89 of the "Manual of Patent Practice" (emphasis added in bold):

"The legislation provides no possibility to rescind grant or a s.18(4) report other

*than in circumstances where there has been an irregularity in Office procedure falling within the terms of r.100. Requests from applicants to rescind grant simply in order to allow the filing of voluntary amendments or a divisional application (that was not **clearly foreshadowed**) cannot therefore be acceded to if there has been no such irregularity. Applicants should be advised of possible actions open to them after grant, for example, amendments under section 27. Irregularities in the grant procedure which may justify rescinding may occur when:*

.....

(iii) *a parent was sent for grant when a divisional was **clearly foreshadowed**;*

.....”

- 37 As I have explained above, I do not think that a divisional application was even foreshadowed, let alone clearly foreshadowed, and so I do not think that (iii) is of any assistance. However, bearing in mind that as explained above the Manual is not a binding authority on me, I do not read paragraph 18.89 as a closed list of the circumstances justifying rescinding grant. Therefore, since I have accepted that there was an irregularity in that EL26 was not issued, I should consider whether there are any other factors that might justify rescinding grant.
- 38 I accept that if the examiner had issued EL26 when the application was found to be in order, then Langner Parry would have been able to alert their associates to the need to speed up the filing of divisional applications. I also accept that the delay of around 14 days in the 4 April fax reaching Mr Topolosky was a one-off situation which could have justified an extension of time if, as in *Jaskowski*, it was a question of extending a reply period to an examination report prior to grant, and that without it Mr Doble would in all probability have received the instructions for further search in time to head off grant of the application by the Office.
- 39 Unfortunately, that is not the full story, and there are other factors which I need to consider. Mr Doble’s argument at hearing was based largely on the difficult circumstances in which Mr Topolosky found himself and the above mentioned delay in a crucial fax reaching him. However, from Mr Topolosky’s declaration it seems that a conscious decision was taken by Mr Timmer to “park” the question of further searches, and hence divisional applications, until the last possible moment. The date of April 2005 was chosen so as to allow the Patent Office the period of four months before the latest date when divisionals could be filed as of right, that was believed necessary for it to carry out any further searches. This strategy seems extremely risky since it would have allowed no time for the results to be considered before any divisionals were filed. It is not clear to me why the further searches could not have

been requested much sooner than this, even if the decision whether or not to file divisionals had to be deferred. More importantly, no-one seems to have thought to make any allowance for the fact that the Office might grant the application in the meantime - Mr Topolosky merely says that this date, being unknown, could not be entered into the reminder system - and no suggestion has been made that the applicant or anyone dealing the application was expecting a warning from the Office.

- 40 Warning bells might perhaps have been expected to sound somewhere that grant was imminent when the third examination report containing only relatively minor objections was received and actioned in March 2005. However it appears that Mr Topolosky only realised this in May 2005, and that the instructions he sent on 5 May were too late to prevent grant.
- 41 Whilst I have some sympathy with the difficulties which Mr Topolosky was working under, I do not think that of itself is sufficient to excuse the above failings in the absence of further explanation, and to my mind this militates against the exercise of discretion even though there had been an irregularity in procedure in that the Office did not issue the EL26 letter.

Conclusion

- 42 I therefore refuse to rescind the grant of patent no. GB 2377401 B. I also refuse to allow the filing of any divisional applications in respect of the inventions deleted from application no. GB 0211639.0.

Appeal

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

R C KENNELL

Deputy Director acting for the Comptroller