



25 February 2009

**PATENTS ACT 1977**

APPLICANT                      Fisher Rosemount Systems Inc.

ISSUE                              Whether patent application number  
GB 0623798.6 complies with section 1(2)

HEARING OFFICER              Dr L Cullen

**Decision**

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**Introduction**

1. Application number GB 0623798.6 was lodged on 29 November 2006. It was divided from an earlier GB application GB 0324633.7 filed on 22 October 2003 and claims a priority of 22 October 2002 from an earlier US application. It is one of a series of patent applications filed by Fisher-Rosemount sharing the same priority date. The application was published under the serial number GB 2431484 A on 25 April 2007. The normal period, under rule 34, Patents Rules 1995, for putting this divisional application in order was 22 April 2007. This date was extended as of right under rule 110(3) Patents Rules 1995 until 22 June 2007 and a further discretionary extension under rule 110(4) was agreed taking this to 22 August 2007.
2. The substantive examiner has maintained throughout an objection that the invention claimed in this application is excluded from patentability as a computer program under section 1(2) of the Patents Act 1977, which the applicant has not been able to overcome despite amendments of the application.
3. The applicant was offered a hearing and this took place before me on 6 March 2008. The applicant was represented by their patent attorney, Dr Alex Lockey of Forresters, and the examiner dealing with the case, Mr Peter Mason, assisted.
4. The parent application has attracted no objection under section 1(2) to patentability and has been granted. I do not need to consider it in reaching my decision.
5. My decision is in two parts. Firstly, I consider the issue of patentability of the invention under Section 1(2) of the Patents Act 1977. Secondly, I deal with an

issue in relation to the period available for putting the application in order that arose at hearing.

## **PATENTABILITY UNDER SECTION 1(2)**

### **The Invention**

6. The invention claimed in the application concerns a system for modelling operations in a process plant within a distributed control system; such as is used, for example, in the petroleum, food-processing and chemical industries.
7. In particular, the invention relates to the modelling of connecting 'entities' such as conveyor belts or the flow of material in pipes between items or modules of processing plant. The invention also facilitates the provision of a graphical display of the modelled process to an operator. The invention provides a modelling system in which objects referred to as 'smart process objects' are adapted to control, simulate, and display, the elements of the process plant. These 'smart process objects' achieve three functions; firstly, they implement process control steps within the process plant through a process control module; secondly, they provide a way to simulate operations on the process plant through a process simulation module; and, thirdly, they provide a means to display graphically what is happening in the process plant and the results of any simulations, using a graphic display module that shows all the elements and material flow movements in the process plant. The process control module and the process simulation module communicate directly with each other. A number of such 'smart process objects' may be connected together to model different items, modules or sub-systems of a large process plant.
8. The invention addresses the problem of integrating simulations with actual process data so that real data can be used as input data for the simulations. Data from the actual plant may be used to influence a simulation of the effect of an actual physical element on the 'movement' of materials between process plant entities. These simulations can be conducted off-line to see what will happen to the material flow in the item or module if various parameters are varied and so help with understanding and managing the process. Also these simulations can be used to generate output data that can be used downstream as input data for control of actual processes. For example, if some of the equipment in the plant is not functioning correctly, the operator can simulate the material flow through this equipment and so acquire simulated output data which can be used to control the downstream process while the malfunction is corrected,
9. It is known to provide graphical displays of plant processes to an operator and such displays are generally preconfigured to display, in known manners, information or data received from the process modules within the process plant. It is also known to create the displays via object orientated programming (OOP) entities.
10. As originally filed there were four independent, non-omnibus claims. The claims, as amended, include independent claims 1, 13, and 21 for, respectively, a

modelling system, a method of modelling, and a modelling system. The modelling system of claim 21 is consistent with, but narrower in scope, than the system of claim 1.

11. Claim 1 reads as follows:

A system for use in modelling operation of a process plant, wherein the process plant comprises a plurality of physical entities, the modelling system comprising:

a computer readable memory; and

a plurality of modelling objects stored on the computer readable memory and adapted to be executed on a processor to model different physical entities within the process plant, the plurality of modelling objects including;

first and second process objects stored on the computer readable memory and corresponding to first and second physical entities, and having a parameter memory adapted to store connection parameter data pertaining to the connection and a graphic representation of the connection adapted to be displayed to a user on a display device;

the connection object being operable to receive a flow measurement from a sensor associated with the physical connection, wherein the connection object comprises a method adapted to be executed on the processor and to use the connection parameter data to produce an output related to the connection.

12. In his skeleton argument submitted just before the hearing, Dr Lockey submitted an alternative independent claim 1. The alternative claim 1 was more explicitly amended to claim a process control system including the features of the modelling system. The alternative claim 1 reads as follows:

A process control system for controlling a process plant, (the process system comprises a<sup>1</sup>) modelling system for use in modelling operation of a process plant, wherein the process plant comprises a plurality of physical entities including a first physical entity and a second physical entity, and a physical connection between the first physical entity and the second physical entity, the process control system comprising a modelling system,

the modelling system comprising:

a computer readable memory; and

a plurality of modelling objects stored on the computer readable memory and adapted to be executed on a processor to model different physical entities within the process plant, the plurality of modelling objects including;

first and second process objects stored on the computer readable memory and corresponding to first and second physical entities, and having a parameter memory adapted to store connection parameter data pertaining to the connection and a graphic representation of the connection adapted to be displayed to a user on a display device;

the connection object being operable to receive a flow measurement from a sensor associated with the physical connection, wherein the connection

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<sup>1</sup> The bracketed text is a verbal correction made to the submitted alternative claim by Dr. Lockey at the hearing...

object comprises a method adapted to be executed on the processor and to use the connection parameter data to produce an output related to the connection.

## The Law

13. The examiner raised an objection under section 1(2)(c) of the Patents Act 1977 that the invention is not patentable because it relates to a program for a computer as such; the relevant provisions of this section of the Act are shown in bold below:

**1(2) It is hereby declared that the following (amongst other things) are not inventions for the purpose of the Act, that is to say, anything which consists of –**

- (a) .....
- (b) .....
- (c) **a scheme, rule, or method for performing a mental act, playing a game or doing business, or a program for a computer;**
- (d) .....

**but the foregoing provisions shall prevent anything from being treated as an invention for the purposes of the Act only to the extent that a patent or application for a patent relates to that thing as such.**

14. As explained in the notice published by the UK Intellectual Property Office on 8 December 2008<sup>2</sup>, the starting point for determining whether an invention falls within the exclusions of section 1(2) is the judgment<sup>3</sup> of the Court of Appeal in *Aerotel/Macrossan* [2007] RPC 7, hereafter referred to as *Aerotel*.
15. The interpretation of section 1(2) has recently been considered by the Court of Appeal in *Symbian Ltd's Application* [2008] EWHC Civ 1066, decided on 8 October 2008, hereafter referred to as *Symbian*<sup>4</sup>. *Symbian* arose under the computer program exclusion, but as with its previous decision in *Aerotel* the Court gave general guidance on section 1(2). Although the Court approached the question of excluded matter primarily on the basis of whether there was a technical contribution, it nevertheless (at paragraph 59) considered its conclusion in the light of the *Aerotel* approach. The Court was quite clear (see paragraphs 8-15) that the structured four-step approach to the question in *Aerotel* was never intended to be a new departure in domestic law; that it remained bound by its previous decisions, particularly *Merrill Lynch*<sup>5</sup> which rested on whether the contribution was technical; and that any differences in the two approaches should affect neither the applicable principles nor the outcome in any particular case.
16. Subject to the clarification provided by *Symbian*, it is therefore still appropriate for me to proceed (as Dr Lockey did at the hearing) on the basis of the four-step approach explained at paragraphs 40-48 of *Aerotel* namely:

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<sup>2</sup> <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-pn/p-pn-computer.htm>

<sup>3</sup> *Aerotel Ltd v Telco Holdings Ltd and Macrossan's Application* [2006] EWCA Civ 1371; [2007] RPC 7

<sup>4</sup> Recently reported as *Symbian Ltd v Comptroller-General of Patents*, [2009] RPC 1

<sup>5</sup> *Merrill Lynch's Application* [1989] RPC 561

- 1) Properly construe the claim
- 2) Identify the actual contribution (although at the application stage this might have to be the alleged contribution); as explained at paragraph 43 this is “an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are”; it is essentially a matter of determining what it is the inventor has really added to human knowledge, and involves looking at substance, not form.
- 3) Ask whether it falls solely within the excluded matter, which (see paragraph 45) is merely an expression of the “as such” qualification of section 1(2).
- 4) If the third step has not covered it, check whether the actual or alleged contribution is actually technical.

### **Argument and analysis – Patentability under Section 1(2)**

17. Dr Lockey submitted that the claims are allowable by analogy with decision BL O/148/07 of the Comptroller in respect of previous applications by this applicant, Fisher Rosemount, for process control systems<sup>6</sup>. He explained that in these applications the hearing officer held that the claim to a workstation characterized by the software run on the computer was excluded but that he was prepared to allow the alternative claim to a process control system including a workstation characterised by the same features because the contribution went beyond a mere program running on a computer and provided an improved means for an operator to control the physical process. Key to this was the fact that the alternative claim made clear that information on the operation of the physical process components was provided to the operator via the software objects.
18. In Dr Lockey’s view, this showed that claims were not excluded from patentability simply because they included software components as well as hardware.
19. It was agreed that the essential ‘elements’ of claim 1 on file and the alternative claim 1 (see above) were the same, only the introductory lines had been changed and as such the construction placed on the claim on file would be the same as the alternative claim.

#### Construing present claim 1.

20. In construing the claim it has not been necessary to apply any specific meaning or understanding of the words beyond their normal usage and their definitions obtained through the disclosure of the description.
21. The claim relates to a system characterised by a storage medium, containing modelling objects representative of entities in a process system. The invention is

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<sup>6</sup> [http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-os/p-challenge-decision-results-bl.htm?BL\\_Number=O%2F148%2F07&submit=Go+%BB](http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-os/p-challenge-decision-results-bl.htm?BL_Number=O%2F148%2F07&submit=Go+%BB)

further characterised by a 'connection' object that similarly corresponds to a connection in the physical system. The said connection object is defined by a parameter memory and a graphical representation for a graphical display. The connection object is able to receive a sensor signal related to the flow of material between the entities in the physical system and to produce an output.

22. However, in my view, the claim as written does not make clear the source of the measurement data. It indicates only that the connection object is '*... operable to receive a flow measurement from a sensor associated with the physical connection ...*'. As a consequence, I consider that two possible situations fall within the scope of this claim as written. Firstly, it could be construed that the data is obtained from an 'online' or 'real time' situation direct from a monitoring sensor. Secondly, it can be construed that the data provided is 'offline' or 'model' data from a simulation. Both such arrangements are supported by the description, see, for example the paragraph bridging pages 18 and 19.

#### Identifying the contribution made by the invention.

23. Turning now to step 2, the contribution made by the invention, the examiner was of the view that the contribution to the art was merely the provision of an 'object' including a parameter memory and a graphic representation, and since the objects were effectively blocks of software code their particular function was not significant.
24. However the agent believed the contribution to go beyond this and that, in line with the teaching of the earlier decision referred to above (BL O/148/07) and of related decision BL O/150/07, it is embedded within an overall system and provides an improved and flexible way of monitoring and controlling the physical process plant.
25. It is my view that, as presently claimed the contribution made by the invention would appear to cover both that identified by the examiner and the agent.

#### Whether the contribution falls solely within excluded matter

26. As indicated above, the claim covers both the situation where the measurement data is obtained from a sensor in real time or is obtained from a simulation. If I find that the contribution provided by either of these situations falls solely within excluded matter, then the present claim is excluded as relating to non-patentable subject matter.
27. In the latter situation referred to above, the measurement data is obtained from a simulation and is pre-obtained 'model' or 'learning' data. As a result, there is no direct interaction between the model object and the process plant and the claim is directed merely to a system for processing data. When utilising such data the invention is considered to relate solely to a computer program as there is no 'physical' link between the modelling system and the process plant. In this case, I consider that the contribution falls solely within the area of excluded matter.
28. In the former situation, the contribution made by the invention is to provide an

improved simulation. The data is obtained in real time and is embedded within, and is part of the process system. Thus, in this situation there would be a 'physical link' between the modelling system and the process plant. Following discussion of this point at the hearing, Dr Lockey suggested that making this link explicit in the claim might be a possible way forward in overcoming the examiner's objection. The examiner, Mr Mason, when asked, indicated that this would appear to be a way forward, however no decision could be made unless or until an actual amendment was proposed. While I am not required to decide this point, I agree that it appears to be a fruitful way forward.

Check whether the contribution is actually technical in nature.

29. Given my finding above, I do not need to apply this step.

Other claims

30. The dependent claims relate to details of the system of the independent claims. The agent has submitted no argument that any of them would avoid exclusion if the independent claims were excluded, and I can see nothing in any of the claims that would do so.

### **Conclusion**

31. I therefore find that the invention as presently claimed can be considered to relate solely to excluded matter under Section 1(2)(c) of the Act. However, it would appear that there is a possibility that the claim could be amended to relate to a patentable invention under this section of the Act. In the latter situation, it would also be necessary to bring the description and claims into agreement with any amended claims. The examiner has also indicated previously that once acceptable claims were agreed upon it will be necessary to complete the search and examination processes under sections 17 and 18.

### **PERIOD FOR PUTTING THE APPLICATION IN ORDER**

32. Following consideration of the amended claims proposed by the agent, the question was raised as to the time available for putting the application in order. There was some confusion regarding this issue and as this was the first occasion that it had been raised, I agreed that I would examine the situation, communicate my view to the applicant and, if necessary, give them the opportunity to respond.

33. The chronology of events in relation to this application are the following:

- (a) The application was lodged on 29 November 2006 and, as mentioned above, was divided from an earlier GB application (GB 0324633.7) filed on 22 October 2003 with a priority date of 22 October 2002. The normal un-extended period for putting this case in order, under rule 34 of the Patents Rule 1995, expired on 22 April 2007.
- (b) The examiner issued an Abbreviated Examination Report under section 18(3) dated 19 February 2007 raising the patentability objection, indicating

that no search had been performed under Section 17(5)(b) and that further consideration of the claims under sections 17 and 18 was deferred until the patentability issue was resolved.

- (c) On 13 June 2007, the applicant wrote requesting an as of right extension to the rule 34 period under rule 110(3), Patent Rules 1995. The period for putting the case in order was extended until 22 June 2007.
  - (d) On 19 July 2007, the applicant responded to the examination report dated 19 February 2007 with a set of amended claims. In this letter, the applicant, also sought a first discretionary extension to the rule 34 period under rule 110(4), Patent Rules 1995, which, following consideration, was granted until 22 August 2007.
  - (e) On 5 September 2007, the examiner responded to the agent's letter of 19 July 2007 offering a hearing to deal with the patentability issue.
  - (f) On 12 September 2007, the agent wrote requesting a hearing.
  - (g) On 18 September the examiner notified the hearings clerk of the need to arrange a hearing on this case.
  - (h) On 19 September 2007, the examiner wrote to the agent with a summary of the issues to be considered at the hearing.
  - (i) On 22 January 2008, the applicant wrote to inform the Office that no date for a hearing had yet been notified.
  - (j) On 28 January 2008, the Office wrote to the applicant notifying them of the date of the hearing
  - (k) The hearing took place before me on 6 March 2008
34. In an Official letter dated 7 July 2008, my preliminary view was communicated to the applicant that at the date of the hearing on 6 March 2008, the application was no longer in effect as the prescribed period for putting the case in order had expired on 22 August 2007 and at this date the application did not comply with the requirements of the Act and as such would have to be refused. The applicant was invited to address me on this point at a hearing or in writing.
35. The applicant sent in a written submission dated 16 July 2008 in which he argued that the failure of the Office to appoint a date for a hearing until March 2008, amounted to an irregularity which could be attributed to the Office and, as such, the Comptroller should exercise his discretion under Section 123(3A) of the patents Act 1994 to allow the application to be amended<sup>7</sup>.

## The Law

36. Section 123(3A) of the Patents Act 1977 states:

(3A) It is hereby declared that rules -

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<sup>7</sup> In this letter the applicant requested that the Comptroller exercise his discretion under 'Section 123(3A) and possibly Rule 100(2)'. The reference to Rule 100(2) would appear to be an error. The Patents Rules 2007 came into force on 17 December 2007 and so, at the date of this letter in July 2008, these are the rules that were in force and had superseded the Patents Rules 1995. Rule 100(2), Patents Rule 2007 concerns the review of an opinion by the Office and does not refer to the discretion of the Office to rectify an irregularity. However, Rule 100(2), Patents Rules 1995 did do so, and this rule has been superseded by Rule 107(2), Patents Rules 2007. I have taken the reference by the applicant in the above letter to Rule 100(2) to be a reference to Rule 107(2), Patents Rules 2007.



- (a) authorising the rectification of irregularities of procedure, or
- (b) providing for the alteration of a period of time, may authorise the comptroller to extend or further extend any period notwithstanding that the period has already expired.

37. Rule 107, Patent Rules 2007, concerning the correction of irregularities reads:

- (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 such 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; and
  - (b) it appears to the comptroller that the irregularity should be rectified.

38. Thus in order to rectify an irregularity of procedure by altering a time period in the manner requested by the agent, the comptroller has to be satisfied that the irregularity (or prospective irregularity) is attributable, wholly or in part, to a error of some kind by the Office and that this irregularity should be rectified.

### **Argument and Analysis - Irregularity of Procedure**

39. This application is a divisional one and, when it was lodged, there was approximately 6 months left of the normal period for putting it in order under Rule 34, Patents Rules 1995.
40. In his letter of 16 July 2008, the applicant explained why he sought two extensions, each of two months, to the time period for response to the examination report dated 19 February 2007. He did so in order to be able to take account of five Office decisions concerning related co-pending application GB0324470.4 from this applicant (see BL O/148/07 referred to above) and four divisional applications GB0514158.5 (see BL O/149/07); GB0514161.9 (BL O/150/07 referred to above); GB0514164.3 (see BL O/151/07); and GB0514167.6 (see BL O/151/07)<sup>8</sup>.
41. It is for this reason that the applicant found it necessary to make use of the 2 month as-of-right extension (until 22 June 2007) and the further discretionary two month extension to the rule 34 period (until 22 August 2007). The response to the examination report was duly made on 19 July 2007 with just over 4 weeks remaining of the extended rule 34 period. Thus a period of five months elapsed

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<sup>8</sup> Copies of these decisions can be found on the Intellectual Property Office website, quoting the relevant BL number, at <http://www.ipo.gov.uk/pro-types/pro-patent/pro-p-os/p-challenge-decision-results.htm>

before the agent responded to the first examination report.

42. Given the short time left to put this case in order and the need for further search and examination it is unfortunate that the extensions to the reply date for the examination report were granted by the Office. The applicant would have been aware that the remaining time for putting the application in order before the end of the rule 34 period would be short. However, I do not consider that on balance this was an unreasonable delay on the part of the applicant given the relevance of the decisions on the related co-pending application and its divisionals.
43. If I consider first the situation at 22 August 2007, when the extended rule 34 period expired, the applicant points out that the examination report of 5 September 2007 from the Office in response to his letter of 19 July 2007 was two weeks outside the compliance period. I note that this is six weeks after receipt of the applicant's letter in the Office. While the Office endeavors to deal with amendments within 4 weeks of receipt, taking an additional two weeks to deal with an amendment in the normal course of events would not result in a significant problem for the applicant. However, in this case the compliance date was imminent and the Office should have replied to the applicant before expiry of this date. However, the Office did not do so until 5 September 2007. This response indicated that there were still outstanding patentability issues to be resolved with the application and suggested that these be addressed at a hearing. It also reminded the applicant that in order to continue with the processing of this application it would be necessary to file a request for a further discretionary extension and if this was allowed to file the appropriate form and fee<sup>9</sup>.
44. Matters were promptly dealt with by both parties thereafter. The agent responded promptly on 12 September 2008 to the Office letter of 5 September 2007 requesting a hearing and the examiner in turn dealt promptly with this request. On 18 September he notified the relevant section of the Office of the need to arrange a hearing on this case and on 19 September 2007 he wrote to the applicant summarising all the issues that needed to be addressed in the hearing.
45. Turning next to consider the situation between 23 August and 22 October 2007, at any point in this period, i.e., the two month period immediately following the last extension to the rule 34 period which expired on 22 August 2007, the applicant was in a position to apply retrospectively for a further two month discretionary extension to the compliance date. After 22 October 2007, this possibility no longer existed. The examination report of 5 September 2007 reminded the applicant of this possibility. To obtain this discretionary extension it would have been necessary to provide reasons and there was, of course, always the possibility that such a request would not have been granted. However, without such an application no further extension could be obtained.

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<sup>9</sup> Under the Patents Rules 2005, a request for a discretionary extension was filed on form 52/77 and if this was allowed a form 53/77 had to be filed with the appropriate fee. Since 17 December 2007, when the Patents Rules 2007 came into force, there is no longer any need to file a form 53/77, a form 52 and the appropriate fee is all that is required.

46. I note that the hearing was convened only to consider the outstanding patentability objections. Once these were resolved it would still be necessary for the Office to consider if the invention was novel and inventive and this would involve carrying out the deferred search and examination of the application. Thus it was not at all certain that if the patentability issues were resolved that there would not be other issues remaining to be dealt with before the application could be considered in order for grant. As a consequence, I find it hard not to conclude that the applicant was not aware of the need to think about and consider seeking a further extension to the compliance date if they wished to obtain a patent for this invention.
47. Four weeks & 3 days remained of the period within which a request for extension of the compliance period could have been filed by the applicant when notification was sent by the examiner to Litigation section on 18 September 2008 of the need to arrange a hearing for this case. It is at this point that an error clearly occurred on the part of the Office because it failed to arrange a hearing.
48. There is nothing in the papers on file or before me in this case to indicate why there was a failure to arrange the hearing. On the one hand, the applicant could reasonably have expected to have been contacted about arrangements for a hearing date and venue etc within a few weeks of their acceptance of the offer for a hearing on 12 September 2007. It would not have been unreasonable for the applicant to expect a response from the Office within 1-2 weeks of this date, especially given the imminence of the compliance date. I think that there was a failure within the Office to appreciate the urgency of this case.
49. On the other hand, I consider that the applicant would have been aware that this hearing was to consider issues only in relation to patentability and that other matters, e.g., novelty, had been deferred pending resolution of this issue (see Abbreviated Examination Report issued on 17 February 2007). Thus, the applicant would still have had to decide if there was enough time remaining to put the application in order following the outcome of the hearing on patentability issues or if an extension to this time period was necessary. Thus, I find it hard to conclude that the applicant would have been unaware of the situation regarding the rule 34 period and the need to decide on a possible discretionary extension. In such circumstances, I do not consider that it is unreasonable to expect the applicant to be aware of the importance of this date. However, as the applicant pointed out in their letter of 16 July 2008 it was not necessary for them to take action on this matter until 22 October 2008.
50. I consider that while four-five weeks is a short period within which to arrange and hold a hearing, it is by no means impossible to do so with the cooperation of those involved. If the hearing had been arranged promptly, I think that it is possible that the applicant would have had the opportunity to decide if there was enough time to put the application in order following the outcome of the hearing, or, at the very least, to file a request for a further discretionary extension to the rule 34 period. I consider that if the hearing had taken place before 22 October, this may well have influenced the applicants approach on this matter which, as a discretionary extension was involved, would have required reasons acceptable to the Office to be successful.

## CONCLUSION

51. Taking all of the above matters into account, I consider that it is appropriate for the Comptroller to exercise his discretion, as provided for under rule 107, to allow the applicant an opportunity to put his application in order that corresponds to the period of time remaining to do so when the error occurred.
52. One month of the compliance period remained when the applicant replied on 19 July 2007 to the examination report of 19 February 2007. In the normal course of events, I would have expected the Office to respond to this letter and set a reply date of two weeks, i.e., half of the remaining period. However, I consider two weeks to be too short a period to set and that a period of one month is more appropriate. Thus, the applicant has a **period of one month from the date of this decision** to put their application in order and the compliance date for this application should be updated accordingly.
53. As mentioned in paragraph 31 above, a possible way forward to address the patentability objection under section 1(2) was identified and I consider that the period I have set should be sufficient to allow the applicant to act on this. I remit the application to the examiner for further processing pending a response from the applicant.
54. Should the applicant seek a further extension to this updated compliance date, I note that it will be a discretionary extension and that it will require reasons as to why it should be allowed. I think it unlikely that dealing with the outstanding patentability objection discussed above would on its own be a sufficient reason to justify a further extension. I am also aware that the examiner deferred consideration of other matters such as novelty and inventive step until the patentability issue had been dealt with and that this further processing cannot take place until an amended set of claims have been agreed.

## Appeal

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

**Dr L Cullen**

Deputy Director acting for the Comptroller.