



## PATENTS ACT 1977

APPLICANT	Fook Yuen Lee
ISSUE	Whether to allow a late response to an examination report under section 18(3) for patent application number GB 1915484.8
HEARING OFFICER	J Pullen

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### DECISION

#### Introduction

- 1 Patent application GB 1915484.8 (“the application”) was filed via the PCT route on 20 March 2018, with a priority date of 27 March 2017, in the name of Fook Yuen Lee. It was published on 8 January 2020 as GB 2575394 A.
- 2 The applicant requested substantive examination on 25 October 2019 and a first examination report under section 18(3) of the Patents Act 1977 (“the Act”) was issued on 27 May 2021 with a latest date for reply of 27 September 2021. An email was sent to the PATEOT email address on 13 October 2021, to extend the reply date to 27 November 2021, and a reply to the examination report was filed on the same day.
- 3 The examiner subsequently issued a second examination report on 15 December 2021, which set a latest date for reply of 15 February 2022. No response to this examination report was received, consequently a letter was issued on 27 April 2022 notifying the applicant that the application would be refused shortly after the compliance date of 27 May 2022. A Form 52 and associated fee was filed on the 26 May 2022 to request an extension to the compliance date, which was duly extended until 27 July 2022. A reply to the examination report was then filed on 26 July 2022 along with an email to the PATEOT address, requesting the late response be accepted. The examiner decided to not exercise discretion to accept the late response in her letter of 17 August 2022. Arguments and evidence were filed with a letter dated 16 September 2022 along with a further request that the refusal of the late response be reconsidered.
- 4 With the position unresolved the applicant asked to be heard and the matter came before me at a hearing on 24 November 2022, where I was assisted by Mr Marc Collins. The issue before me was set out in the examiner’s pre-hearing report of 7 October 2022. The applicant was represented at the hearing by their attorney Mr

Benjamin Snipe of Snipe Chandrahasen LLP. I thank the attorney for the timely filing of skeleton arguments prior to the hearing.

## The law

- 5 Section 18 of the Act relates to substantive examination of a patent application. Section 18(3) states:

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

- 6 Section 117B of the Act provides for extensions of time limits specified by the comptroller. Section 117B(2) states:

*(2) Subject to subsections (4) and (5) below, the comptroller shall extend a period to which this subsection applies if –*

- (a) the applicant or the proprietor of the patent requests him to do so; and  
(b) the request complies with the relevant requirements of rules.*

- 7 Rule 109 states the following:

*(1) A request under section 117B(2) must be—*

- (a) made in writing; and  
(b) made before the end of the period prescribed by paragraph (2).*

*(2) The period prescribed for the purposes of section 117B(3) is two months beginning immediately after the expiry of the period to which section 117B(2) applies.*

- 8 Examiners and hearing officers alike are duty-bound to follow the law and precedents in considering whether to exercise discretion to allow a late filed response and the Manual of Patent Practice<sup>1</sup> (MoPP) sets out useful guidance in this respect. Within this guidance it may be seen that other hearing officers who have considered this issue have made it clear that it is in the public interest to resolve any uncertainty in a patent application as quickly as possible and therefore as further delays are incurred, the reasons for these delays must be strong.

- 9 Paragraph 18.53 of MoPP states:

*18.53 An automatic extension of two months (or to the end of the compliance period, as prescribed by rule 30 for the purposes of section 20, if this expires sooner) to the period set in an official report can be obtained by requesting it in writing (see also 18.53.1). The request must be received before the end of the period as extended. Only one extension of this type is available. Further extensions may be available at the examiner's discretion if an automatic two month extension has already been granted. Any request for a further extension must be made before the end of the period as already extended and an adequate reason must be given (see 18.56- 18.57.1). Under*

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<sup>1</sup> The Manual of Patent Practice is available at [Manual of Patent Practice \(www.gov.uk\)](http://www.gov.uk)

*Rule 109 of the Patents Rules 2007, there is no longer a requirement for a request for a further extension under s.117B(4)(b) to be made in writing. However this may be required if the examiner feels that a written request is appropriate in the circumstances. A discretionary extension of one month (in addition to the automatic two months) may be granted readily however any longer or further extensions should be accompanied by a very good reason. Evidence to substantiate any reason given can always be requested if considered necessary (see also 123.36.8 and 123.37).*

10 Paragraph 18.54 states:

*18.54 When a reply is received after the expiry of the specified period and the automatic extension period of two months has passed, the reason, if not already given, should be asked for. If no reason is forthcoming the late response cannot be accepted and a report under s.18(3) should issue informing the applicant that the application will be refused unless observations are forthcoming, or a hearing is requested. Where a reason is provided, the examiner may exercise discretion under s.18(3) to accept the late response, even though no extension to the specified period can be granted. Discretion should be exercised favourably, particularly if; i) the extension period has not been exceeded by more than a de minimis period, and/or, ii) the examiner is satisfied that the failure to respond was unintentional at the time that the specified period expired. Point ii) is consistent with the statutory test that applies to requests for reinstatement under s.20A (see 20A.13-16 for guidance on the meaning of unintentional). However, there is no statutory requirement that the failure to respond must have been unintentional in order for the late response to be accepted, and thus the discretion accorded by s.18(3) may be exercised in appropriate circumstances even if this criterion is not met.*

11 Paragraphs 18.55 to 18.57.1 of the guidance sets out the factors which should be considered in deciding whether to allow a discretionary extension of time or to exercise discretion to accept a late-filed response.

### **Applicant's case**

12 The applicant's arguments are set out in their attorney's letter of 16 September 2022 which include a witness statement from attorney Mr Snipe and the skeleton argument of 21 November 2022. The arguments were explained and expanded upon at the hearing by Mr Snipe.

13 Mr Snipe contends that the delay in replying to the examination report was unintentional at the time when the period expired, as well as throughout the period of delay. The applicant has always intended to continue with the patent application.

14 Mr Snipe explained that the reason for the initial failure to reply to the latest examination report on time was a docketing issue due to a human error on his part. He is a sole practitioner and as such is responsible for docketing. Upon receipt of the examination report he did not docket the deadline for reply. Mr Snipe queried whether the same standards for systems should be expected for a sole practitioner as for a large firm of attorneys since the large firm would have support staff responsible for tasks such as docketing reply dates to examination reports. I explained at the hearing that the Office does not treat represented applicants differently according to the size of the firm representing them.

- 15 At the hearing, Mr Snipe introduced a further reason for the delay in replying to the examination report which was not put before the examiner and apologised that this had not been brought to their attention. Mr Snipe explained that during March 2022, he relocated from his office of many years in London to working from home in Brighton. This, along with having a young family at home, caused significant disruption to his work and increased the pressures thereon leading to him falling behind in some of his work.
- 16 Mr Snipe first became aware of the missed deadline for reply to the examination report when he received the Office's letter of 27 April 2022 (on 28 April 2022) warning of refusal of the application under section 20(1). He went on a family holiday shortly after this, from 30 April 2022 until 9 May 2022. However, he did take the file on holiday with him with the intention of working on it but unfortunately this did not happen.
- 17 On returning home from holiday, Mr Snipe explained that he started to work on a reply but that the inventive step and clarity issues were more complex than he first thought and as a result the application was put to one side. Further, the complexity and the closeness of the compliance date meant that a full response, putting the application in order, would be required. A proposed response was sent to the applicant's instructing attorneys on 18 July 2022, which was approved and filed on 26 July 2022. At the hearing, Mr Snipe also indicated that he took a second holiday around this time but did not state the dates of the holiday.
- 18 At the hearing Mr Snipe discussed paragraph 18.54 of MoPP which had been highlighted by the examiner. He focussed on the following passage (emphasis added):
- “Discretion should be exercised favourably, particularly if; i) the extension period has not been exceeded by more than a de minimis period, and/or, ii) the examiner is satisfied that the failure to respond was unintentional at the time that the specified period expired... However, there is no statutory requirement that the failure to respond must have been unintentional in order for the late response to be accepted, and thus the discretion accorded by s.18(3) may be exercised in appropriate circumstances even if this criterion is not met.*
- 19 Discussing part (i), Mr Snipe questioned what was meant by “a *de minimis* period” and that the Office was prepared to allow a one-month extension when exercising discretion and thus was a period of three months “*de-minimis*”. He highlighted the presence of the alternative meaning that only one of part (i) or (ii) necessarily be satisfied in order to allow a late filed response. Whilst he accepted that the requirement in part (i) may not have been met, he considered part (ii) to have been satisfied as the failure to respond had been unintentional. Mr Snipe also discussed that paragraph 18.54 sets out that there is no statutory requirement that the failure to respond must have been unintentional in order for the late response to be accepted.
- 20 Mr Snipe also argued that even if the reasons given were not considered sufficient individually to allow the late response, that in combination they should be.

## Examiner's arguments

- 21 The examiner has stated she is happy to accept that the human error to not create a docket for reply to the examination report was an unintentional error and that at the time the specified period expired the failure to reply was unintentional.
- 22 The agent subsequently became aware of the missed deadline on 28 April 2022 upon receipt of the Office's warning letter. However, it took almost a further three months before filing a reply on 26 July 2022. The examiner has highlighted four main reasons for the delay from the attorney's arguments:
- (i) the contents of the response needing to be agreed with overseas instructing attorneys;
  - (ii) the agent being away on holiday from 30 April – 8 May 2022;
  - (iii) general work pressures on the attorney's side;
  - (iv) the closeness of the compliance date pressing the need for a full response to the examination report so that the claims would be in an acceptable form for grant.
- 23 Considering paragraph 18.54 of MoPP, the examiner explains that discretion would have been exercised favourably if the extension period had not been exceeded by more than a *de minimis* period. If a response had been received shortly after the attorney was made aware of the missed response deadline upon receipt of the Office's letter on 28 April 2022, the late response would have been accepted. However, the examiner argues that the further delay of almost three months cannot be said to be a *de minimis* period. In the examiner's opinion, this is further confirmed by the guidance in paragraph 18.53 of MoPP, which suggests that a discretionary extension of one month may be granted readily, however any longer extensions would require a very good reason.
- 24 The examiner also considered whether the four reasons listed above could be considered as a good reason for accepting the late response that was received more than a *de minimis* period after the expiry of the specified period. The examiner considered a number of prior decisions in doing so. In *Jaskowski's Application*<sup>2</sup>, the applicant's agent sought an extension on the grounds that delays were caused by the need to consult US Patent Attorneys, who in turn had to seek instructions from the applicant. The hearing officer refused the request and stated
- "s.18(3) clearly gives the comptroller discretion to extend the specified period but unless a coach and horses is to be driven through the subsection he must have some adequate reason for exercising that discretion which is peculiar to the particular applicant or application in suit. I can see nothing abnormal in the chain of communications in this case... which could be regarded as an adequate reason for extending the specified period".*
- 25 Following this decision, the need to consult the overseas attorneys is not thought to be an acceptable reason for accepting the late response. This was further confirmed

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<sup>2</sup> Jaskowski's Application [1981] RPC 197

in *Wei Xu's Application*<sup>3</sup>, where the hearing officer discussed the applicant being based outside the UK:

*"Thus, I conclude that the fact that the applicants are based in China is not a suitable reason. Neither is the fact that the applicants have difficulty with language. The working language in the UK is English (with provisions for the use of Welsh). Put simply, if I were to accept these reasons, I would be giving these applicants an advantage that would not be open to an applicant based in the UK. That cannot be right or just, and for that reason, I do not accept the location and language of the applicants as a reason for exercising discretion. To do so would, to adopt the language of the Hearing Officer in Jaskowski's Application, drive a horse and cart through Section 20."*

- 26 The proposed response was sent to the overseas attorneys on 18 July 2022, and they approved the response rapidly, so that the response could be filed on 26 July 2022. The delay between becoming aware of the missed response deadline (on 28 April 2022) and sending the response to the overseas attorneys is explained in the evidence as resulting from the attorney being on holiday from 30 April – 8 May 2022. There was a further delay between the attorney returning from holiday and sending the proposed reply to the instructing attorneys (between 9 May and 18 July 2022). The examiner considered this delay to be considerable. The examiner refers to the evidence which states "In some part the delay was because of general work pressures, and also that the reply required particular care as there would not be another opportunity".
- 27 The examiner highlights *Decker's Application*<sup>4</sup>, in which it was decided that factors that are considered normal in relation to all applications, such as absence on business or holiday is not a good reason to allow an extension of the specified period (and so it is assumed not a good reason to allow a late response). General work pressures are also thought to fall under this category of reason. The examiner considered the closeness of the compliance period as a reason for delay, and this is again not considered to be adequate.

## **Analysis**

- 28 I find myself in agreement with the examiner in accepting that the human error to not create a docket for reply to the examination report was an unintentional error and that at the time the specified period expired the failure to reply was unintentional. However, the attorney was made aware of the missed response deadline upon receipt of the Office's letter on 28 April 2022 and almost three months passed before the response was finally filed on 26 July 2022 -the penultimate day of the extended compliance period. In light of this, I need to determine whether the late filed response should be allowed.
- 29 I will first consider whether the extension period has not been exceeded by more than a *de minimis* period. Again, I find myself in agreement with the examiner. Whilst the initial delay may have been unintentional, the further delay of almost three

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<sup>3</sup> Wei Xu's Application BL O/610/22

<sup>4</sup> Decker's Application BL O/10/96

months is not an insignificant amount of time and thus cannot be considered *de minimis*.

- 30 Turning to whether the failure to file a response to the examination report for almost three months following the Office's warning letter was unintentional -this is a useful first step in deciding whether, or not, to allow discretion. If I find that the failure was not unintentional, I will then go on to consider whether there are any other factors which would justify an exercise of discretion to allow the late-filed response in this case.
- 31 Mr Snipe argued that the relocation of his office from London to his home caused significant disruption to his work. The timeframe mentioned at hearing for the relocation was March without any specific dates being offered. This would appear to be outside the three-month period under consideration from 28 April 2022 to 26 July 2022.
- 32 The previous decisions highlighted by the examiner in *Jaskowski's Application*, *Wei Xu's Application* and *Decker's Application* set out how the need to consult the overseas attorneys, being on holiday and general work pressures considered normal in relation to all applications would not be sufficient to consider the failure to respond to be unintentional. Furthermore, the impending compliance date requiring a full response is not a unique circumstance to this application.
- 33 The factors highlighted by the attorney are normal in relation to all applications apart from the attorney's workplace relocation in March. Although I have sympathy with the problems the relocation may have caused Mr Snipe it does not justify a failure to respond to the examination report from receiving the Office's warning letter on 28 April 2022 for almost three further months. Furthermore, when considering this in light of Mr Snipe's admission that he started work on a response upon his return from holiday around 9 May 2022, it is difficult to see how the relocation was the reason for the failure to respond.
- 34 In addition, at the hearing, Mr Snipe explained that following his return from holiday on 9 May 2022, he commenced work on a response to the examination report but due to the complexity of the objections and the response required he decided to "put it to one side". In my view, this introduces an intentional delay in responding by Mr Snipe.
- 35 To my mind all these factors do not indicate that the failure to respond was unintentional.
- 36 The attorney has submitted that it has always been the applicant's intention to continue with the application. Given the current circumstances, where at least some delays to filing a response to an Office deadline have been made consciously, it is fair to say that an underlying intention to continue with the application does not make the failure to respond unintentional.
- 37 I will now consider whether there are any other factors which would justify exercising discretion to allow the late-filed response in this case.

- 38 Another factor highlighted by Mr Snipe is the complexity of the work involved in formulating a response. The subject matter of the application appears to me to be reasonably straightforward and relates to a brush with an interlocking bristle strip. The outstanding objections made by the examiner are inventive step against some (but not all) of the claims and the clarity of claim 1. These objections would not appear to be of the extreme complexity sufficient to justify a late response or extension of time. Therefore, I do not consider the complexity of either the subject matter or the objections to be grounds to justify an exercise of discretion to allow a late response.
- 39 Mr Snipe also argued that even if the reasons given were not considered sufficient individually to allow the late response, that in combination they should be. I cannot see any reason why the individual factors would have a cumulative effect that would be considered sufficient to exercise discretion to allow the late-filed response.
- 40 I can find no grounds to justify an exercise of discretion to allow a late response to the examination report under section 18(3).

### **Conclusion**

- 41 In conclusion, I refuse the application under section 18(3) due to a failure by the applicant to satisfy the comptroller that requirements reported by the examiner as not being complied with have in fact been complied with, or to amend the application so as to comply with them.

### **Appeal**

- 42 Any appeal must be lodged within 28 days after the date of this decision.

### **J Pullen**

Deputy Director, acting for the Comptroller