

## **PATENTS ACT 1977**

### **IN THE MATTER OF Patent Application GB 9523766.5 in the name of Benjamin James Godfrey**

## **DECISION**

### **Introduction**

1. This decision arises out of the failure of the applicant, Mr Benjamin James Godfrey, to reply to an examination report under section 18(3) of the Patents Act 1977 in respect of his patent application GB 9523766.5. Mr Godfrey is prosecuting his application without professional assistance. The application was treated as having been refused when the normal period of four years and six months for putting the application in order expired on 21 May 2000.
2. Mr Godfrey subsequently requested an extension of the time allowable for the application to proceed to grant but this was refused. As correspondence between the Patent Office and Mr Godfrey had failed to resolve the matter, a hearing was offered by the examiner. The hearing took place before me on 12 April 2002.

### **Background**

3. In order to set the issues in their proper context, it is helpful to summarize the various events that have occurred and the correspondence that has taken place between the Office and the applicant.
4. The application in suit is entitled "Safety Buckle Cover for a Car Seat" and was filed on 21 November 1995 in the name of Benjamin James Godfrey.
5. On 18 December 1995, the Office wrote to the applicant enclosing a guidance booklet entitled "How to prepare a UK Patent Application" which explains the various stages that an application must pass through before a patent may be granted. The Official letter explained that the next step was for Mr Godfrey to file a request for preliminary examination and search. It also pointed out that the applicant would be well-advised to consult a patent agent.
6. Mr Godfrey requested a search by filing Form 9/77 on 21 November 1996, and a

search report citing four prior art documents was issued on 7 February 1997. The application was published as GB 2307505 A on 28 May 1997.

7. On 21 October 1997, the applicant requested a substantive examination by filing Form 10/77, and an examination report was duly issued on 20 May 1999. The examination report objected to lack of clarity and lack of novelty, citing the four documents referred to in the earlier search report. A covering letter accompanying the examination report prominently displayed the latest date for reply, which was 22 November 1999. In accordance with section 18(3) of the Act, and in line with usual Office practice, the covering letter also included a warning that failure to reply in time might result in refusal of the application. In the event, no response to the examination report was received.
8. Rule 34 of the Patents Rules 1995 prescribes a period of four years and six months from the declared priority date or, where there is no declared priority, from the filing date, for putting an application in order. In the case of the application in suit, this period expired on 21 May 2000.
9. On 1 March 2000, the Office issued a letter informing Mr Godfrey that it was intending to treat his application as having been refused on 21 May 2000, but again, no response was received. Indeed, nothing was heard from the applicant until more than a year later after the Office had mistakenly sent him a Certificate of Payment of a Patent Renewal Fee dated 6 September 2001. The certificate pertained to a granted patent that had nothing to do with Mr Godfrey. He then contacted the Office to enquire as to the status of his application and, upon being informed that it had been terminated, he filed Form 52/77 requesting that discretion of the comptroller be exercised under rule 110(4) of the Patents Rules 1995 to extend the time allowable for putting his application in order for grant.
10. In a letter dated 15 October 2001 accompanying the Form 52/77, the applicant stated that it was always his intention to proceed and “see through” his application. He made the following points, which can be summarised as follows:
  - i) up until the issue of the examination report of 20 May 1999 he had met all deadlines without fail and all correspondence and fees relating to the application were submitted on time;
  - ii) at the time of making the application he was seventeen years of age and had a relatively poor understanding and knowledge of patent proceedings;
  - iii) he was not aware of the importance of the four years and six months period to his application;
  - iv) he had mis-read and mis-interpreted the examination report of 20 May 1999 and was under the impression his application was being processed;
  - v) he had received no warning or confirmation of termination of his application,

and there had been no further contact from the Office until he received the Certificate of Payment of a Patent Renewal Fee of 6 September 2001;

- vi) he underwent knee surgery in 1996 following a physical assault by a third party and launched legal proceedings in response thereto which have only recently been resolved. This was both mentally and financially damaging. He was unable to work for considerable periods of time, and endured extreme distress;
  - vii) he had suffered two bereavements in 1999, two of his grandparents having passed away within a short period of time; and
  - viii) his long-term girlfriend suffered a nervous breakdown in November 1999;
  - ix) due to the turmoil, the relevant documents were misplaced and only found after extensive searches.
11. With his letter, Mr Godfrey enclosed a copy of the certificate mistakenly sent to him by the Office, a copy of a letter dated 23 May 1997 confirming his appointment with a consultant orthopaedic surgeon at the Avon Orthopaedic Centre, a copy of a solicitor's letter dated 28 September 1999 referring to his application for review by the Criminal Injuries Compensation Authority (CICA), and a copy of a letter from his consultant to CICA dated 4 December 2000 confirming that, at that time, Mr Godfrey had not made a full recovery.
12. Although Mr Godfrey refers to the contents of his letter dated 15 October 2001 as his statutory declaration and affidavit, none of it is sworn. In a letter to the applicant dated 4 December 2001, the examiner stated that he did not consider the reasons given were sufficient to justify exercise of the comptroller's discretion to extend the period for reply to the examination report and the period for putting the application in order. He invited the applicant to provide further evidence by way of statutory declaration or affidavit and offered the applicant an opportunity to be heard.
13. The applicant responded in a letter dated 4 January 2002, enclosing copies of his grandparents' death certificates. He stated that further evidence of his girlfriend's illness would be provided at the hearing.

### **Hearing**

14. At the hearing, Mr Godfrey reiterated the points he had previously made in his letter. In doing so, he indicated that he had lost contact with his girlfriend and so was unable to supply the promised evidence regarding her illness.
15. Mr Godfrey confirmed that he had received all letters sent by the Office other than the letter of 1 March 2000 informing him that it was intended to treat the application as having been refused. I asked him specifically whether he received the booklet entitled "How to prepare a UK Patent Application" which provides a great deal of useful information about the processing of an application including the existence of a four and a half year time limit for putting the application in order for grant. He said he had

received the booklet, but could not recall reading it. In response to later questioning, he said he had obviously not clearly read the booklet and had failed to correctly interpret the four years and six months deadline.

16. I noted that, according to the evidence he had filed, his knee injury took place on 18 November 1996, just three days before Form 9/77 was filed. Mr Godfrey explained that his mother had filed the form for him as he was “in and out of hospital, on crutches and obviously having legal proceedings with the police” at the time.
17. He said he could vaguely remember opening the examination report dated 20 May 1999 but “with everything going on, unfortunately it was my mistake, it was just sort of put to the side and misread and obviously not actioned appropriately”. The evidence shows that Mr Godfrey’s maternal grandmother died on 25 May 1999, just five days after the date of issue of the examination report, and his maternal grandfather died exactly 7 months thereafter. He mentioned that he had been very close to his grandparents, that after his grandmother had died, his grandfather had fallen ill and the family had devoted all their time to his care, and that around the time his grandfather died, in December 1999, his long term girlfriend had fallen ill.
18. Mr Godfrey went on to say that, thereafter, the examination report was mislaid and only found after an extensive effort. He was prompted to search for the missing report and to find out exactly what had happened to his application when the certificate was mistakenly sent to him more than two years later.
19. In relation to the Official letter of 1 March 2000 informing him that it was intended to treat his application as having been refused, I asked Mr Godfrey whether there had been a change of address or if he was aware of any other reason why that letter may have gone astray, but he was unable to offer any. I suggested that, in light of the fact that the examination report had been misplaced, it was not unreasonable to suppose that the letter giving notice of impending refusal might also have been lost after Mr Godfrey had received it. He assured me that this was not the case and that his family had no recollection of the letter either. He pointed out that the Office had mistakenly sent him a certificate pertaining to someone else’s patent renewal and thought it would not be beyond the realms of possibility that a mistake had also been made in issuing the letter of 1 March 2000 which resulted in him not receiving it.
20. Finally, I pointed out that the period between Mr Godfrey receiving the examination letter and enquiring about the status of his application following receipt of the mis-directed Certificate of Payment of a Patent Renewal Fee was approximately two years and five months, which might be taken to be an indication that he had lost interest in his application. He accepted that matters could be interpreted in this way but again referred to the on-going rehabilitation with his knee injury. He said that he had had his career to think about, having been hoping to join the forces, had numerous interviews and examinations, and had wrongly prioritised.

### **Consideration of the Issues**

21. It is established Office practice that:
  - for comptroller’s discretion to be exercised in favour of extending the period set for

reply to an examination report, there must be some adequate reason which is peculiar to the particular applicant or the application in suit; and

- where it is sought, under the provisions of rule 110(4), to extend the period prescribed by rule 34 for putting an application in order, comptroller's discretion will be exercised only if there has been a continuing underlying intention to proceed. A change of mind is not a legitimate reason for the exercise of discretion.

22. I must be satisfied that both these requirements have been met if the patent application is to proceed any further.
23. As regards the first requirement, having reviewed all the evidence and carefully considered the arguments put to me by Mr Godfrey in his letter and at the hearing, I am satisfied that the peculiar and unfortunate circumstances in which he found himself at the time he received the examination report of 20 May 1999 would be such as to justify the exercise of comptroller's discretion to extend the period for response.
24. There are a number of factors which have led me to this conclusion; Mr Godfrey suffered the loss of his grandmother in May 1999, just a few days after the examination report had been issued; the solicitor's letter dated 28 September 1999 makes it clear that Mr Godfrey's application for review by the Criminal Injuries Compensation Authority was imminent; his grandfather became very ill and died in December 1999; and, to cap it all, at about the same time, his girlfriend fell ill. I consider it reasonable to assume that, having to cope with so many serious events, Mr Godfrey was completely preoccupied at a time when, in the normal course of events, he would have been preparing a response to the examination report.
25. I now turn to the second requirement. In determining whether I should exercise the comptroller's discretion to allow an extension of the period prescribed by rule 34 for putting the application in order, I need to consider the situation following the events of 1999 in order to decide whether they demonstrate a continuing underlying intention on the part of Mr Godfrey to proceed with his application.
26. There having been no reply to the examination report of 20 May 1999, the Office issued a letter on 1 March 2000 warning Mr Godfrey that it was intending to treat the application as having been refused on 21 May 2000. Mr Godfrey insisted that he had not received this letter and suggested at the hearing that, as the Office had mistakenly sent him a certificate pertaining to someone else's patent renewal, it would not be beyond the realms of possibility that a mistake had also been made in issuing the letter of 1 March 2000. However, the file copy of the letter shows that it was correctly addressed and there seems to be no reason why Mr Godfrey should not have received it.
27. Be that as it may, Mr Godfrey made no attempt, from the time he received the examination report issued on 20 May 1999, until he mistakenly was sent the certificate dated 6 September 2001, to progress his application or enquire as to its status. I can not accept, without compelling reason, that an applicant who fails to pursue his application for more than two years has demonstrated an underlying intention to proceed with it.

28. In his letter, Mr Godfrey said he had a relatively poor understanding of patent proceedings and was not aware of the importance of the four years and six months period. However, he evidently had sufficient understanding of the system to have met all deadlines up to the issue of the examination report. Moreover, he had received the booklet explaining the processing of patent applications which clearly mentions the need to respond to objections in examination reports and refers to the deadline for putting applications in order for grant.
29. Mr Godfrey said that he had mis-read and mis-interpreted the examination report and was under the impression his application was being processed. As I have already indicated, I accept that Mr Godfrey was going through a traumatic period when he received the examination report and he may well have misunderstood it on first reading. However, I believe that applicants in Mr Godfrey's position, who had a genuine underlying intention to proceed, would have put the examination report on one side and come back to it once their lives had settled back into normality. Mr Godfrey said he mislaid the report, but, had he had a genuine interest in pursuing his application, he would surely have requested the Office to send him a fresh copy. Had he done so, he would have seen that his application was clearly not in order for grant and that he would need to do something about it.
30. In his letter, and at the hearing, Mr Godfrey said that he had always intended to "see through" his application but, having carefully considered all the evidence, I believe that all the indications are to the contrary. I can find no evidence of any unusual disruption in Mr Godfrey's personal life after the series of events that occurred in 1999, except perhaps for on-going rehabilitation following his knee injury. That being the case, once he had had time to recover from the events of 1999, he might have been expected to turn again to his patent application and contact the Office to determine how he might continue with its prosecution. However, he failed to do so until prompted by the certificate issued on 6 September 2001. At the hearing, Mr Godfrey mentioned that he had had his career to think about - he was hoping to join the forces, and had had numerous interviews and examinations. I believe this lends weight to the view I have come to that he had simply lost interest in his patent application.
31. In summary, I do not consider that Mr Godfrey has put forward adequate reasons for extending the period for putting the application in order and I refuse to exercise the comptroller's discretion under rule 110(4). I therefore refuse the application.

## **Appeal**

32. This being a substantive matter, the time within which an appeal may be lodged is six weeks from the date of this decision.

Dated this 9th day of May 2002

**P E REDDING**

Deputy Director, acting for the Comptroller

**PATENT OFFICE**