



BL O/371/04

20<sup>th</sup> December 2004

## PATENTS ACT 1977

APPLICANT    Fieldturf Holdings Inc.

ISSUE    Whether patent application GB0426269.7  
can be treated as a divisional application under  
section 15(4)

HEARING OFFICER                                H Jones

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## DECISION

### **Introduction**

- 1 Patent application GB0426269.7 was filed on 30<sup>th</sup> November 2004 with a request that it be treated as a divisional application of GB0220077.2 (“the parent”) and be given an earlier filing date corresponding to that of the parent, i.e. 21<sup>st</sup> June 2001. The rule 34 period for putting the parent application in order expires on 21<sup>st</sup> December 2004. The latest date by which a divisional application can be filed is determined by rule 24, which requires that any application under section 15(4) of the Act be filed no later than the beginning of the third month before the end of the rule 34 period. In this case, that deadline would have been 21<sup>st</sup> September 2004.
- 2 The agent’s letter dated 30<sup>th</sup> November 2004, filed in conjunction with amendments to the parent application, outlined the reasons why the comptroller should exercise discretion under rule 110(1) to extend the period under section 15(4) for filing a divisional application. Having considered the particular circumstances set out in this letter, the examiner reported that there was no basis for allowing comptroller’s discretion to extend the period for allowing the divisional application and informed the agent by telephone on 6<sup>th</sup> December. The agent requested to be heard on the matter, and a hearing was duly held on 16<sup>th</sup> December 2004 where the applicant was represented by Mr Terry Johnson of Marks & Clerk.

### **The Law**

- 3 The provisions for allowing the filing of divisional applications are set out in section 15(4) of the Act and rule 24 of the accompanying Rules:

*s15(4): Where, after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his*

*successor in title in accordance with rules in respect of any part of the matter contained in the earlier application and the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below) the new application shall be treated as having, as its date of filing, the date of filing the earlier application.*

*r24(1): Subject to paragraph (2) below, a new application for a patent, which includes a request that it shall be treated as having as its date of filing the date of filing of an earlier application, may be filed in accordance with section 15(4) not later than the beginning of the third month before the end of the period ascertained under rule 34 in relation to the earlier application as altered, if that be the case, under rule 100 or rule 110 ("the rule 34 period"):*

*provided that, where the first report of the examiner under section 18 is made under subsection (4) and the comptroller notifies the applicant that the earlier application complies with the requirements of the Act and these Rules, notwithstanding the foregoing provisions of this paragraph but subject to paragraph (2) below, a new application may be filed not later than the expiry of the period of two months beginning on the day that the notification is sent.*

*r24(2): Where any of the following dates falls before the date ascertained under paragraph (1) above, a new application may only be filed before that date instead of the date so ascertained-*

*(a) the date when the earlier application is refused, is withdrawn, is treated as having been withdrawn or is taken to be withdrawn;*

*(b) the expiry of the rule 34 period ascertained in relation to the earlier application; and*

*(c) the date when a patent is granted on the earlier application.*

- 4 Notwithstanding the above, the comptroller has discretion under rule 110(1) to extend the time or periods set out in the Rules if he thinks fit:

*r110(1): The times or periods prescribed by these Rules for doing any act or taking any proceeding thereunder, other than times or periods prescribed in the provisions mentioned in paragraph (2) below, and subject to paragraphs (3) and (4) below, may be extended by the comptroller if he thinks fit, upon such notice to the parties and upon such terms as he may direct; and such extension may be granted notwithstanding that the time or period for doing such act or taking such proceeding has expired.*

## **Interpretation**

- 5 Paragraph 15.21 of the Manual of Patent Practice provides guidance on when the comptroller should exercise discretion in allowing late filing of divisional applications:

*“The comptroller has discretion to extend the periods allowed for filing a divisional application. However, discretion to allow a divisional application to be filed out of time will normally be exercised only if the applicant shows that the circumstances are exceptional and that he has been properly diligent.”*

- 6 This approach to exercising comptroller’s discretion is consistent with the hearing officer’s comments in *Asahi’s Application* (BL O/98/89):

*“Considering the circumstances of the present case, I can see no reason for deviating from the established practice of exercising comptroller’s discretion to allow late filing of divisional applications only in instances where the applicant can show that the circumstances are exceptional, and that he has been properly diligent.”*

- 7 At the hearing, Mr Johnson accepted this two-fold test of exceptional circumstances and due diligence as a condition for exercising comptroller’s discretion. However, with regard to the requirement for exceptional circumstances, Mr Johnson took me to the Collins English Dictionary definition of the word exceptional to suggest that it means no more than forming an exception to the norm. He argued that exceptional does not mean that the circumstances needed to be remarkable or untoward, just that they would be outside the norm. In other words, the requirement should not simply be that the applicant or the patent attorney had his file stolen, or somebody instructing him had died, it simply means that there is a norm for filing a divisional, that norm is three months, and anything filed outside the norm would be exceptional.

- 8 I am not persuaded by this line of argument. If Mr Johnson is correct in his interpretation of the word exceptional, it would render virtually redundant all of the time limits and periods set out in the Act or Rules on the ground that anything filed outside the norm would be regarded as exceptional. If Mr Johnson’s reasoning were to be followed, all late filed divisional applications would be regarded as exceptional regardless of the circumstances resulting in the applicant having to file out of time. Provided that the applicants had been diligent in filing their application out of time, comptroller’s discretion would be exercised in their favour. That cannot be right, and what Mr Johnson appears to have done is to confuse the exceptional circumstances for filing late applications with the fact that late-filed applications are the exception. It is clearly the former that is required in order to exercise comptroller’s discretion.

### **Argument**

- 9 The reasons for exercising comptroller’s discretion in favour of the applicant are set out in the agent’s letter dated 30<sup>th</sup> November 2004 and were re-stated by Mr Johnson at the hearing:
- a) The agent’s letters dated 28<sup>th</sup> May 2004 and 2<sup>nd</sup> November 2004 notified the Office of the possibility of filing one or more divisional applications.
  - b) A fax dated 11<sup>th</sup> November confirms that the agent’s instructing Principals in North America had recently changed.

c) The new instructing Principals originally instructed the agent in a telephone call to prepare claims for four divisional applications. In a telephone call on 12<sup>th</sup> November 2004, the instructions were modified to file one divisional application.

c) The nature of the invention is such that there are various inventive aspects, which when within the bounds of being novel, non-obvious and susceptible of industrial application, are all therefore worthy of patent protection as individual patents. Indeed, the comptroller will be aware that these inventions are “live” in the sense that they are commercially important.

d) The Applicants are Patentees in respect of several inventions surrounding artificial playing surfaces. Previous patents granted to them in the U.K. (themselves divisional applications) have been subject to litigation in the Patents County Court.

10 The applicant had clearly warned the Office in May 2004 of an intention to file divisional applications and clearly acted diligently in doing so. However, in the period between the issue of this letter and the date by which any divisional application had to be filed, i.e. 21<sup>st</sup> September 2004, nothing whatsoever appears to have happened. The applicant has been unable to explain this. Since then, however, a change of instructing Principals in North America appears to have re-kindled the application, and a divisional application was filed on 30<sup>th</sup> November 2004, some two months after the deadline for doing so. There is little doubt that once instructed by the new Principals in North America, the agent acted with due diligence and speed in filing the divisional application.

11 In view of the fact that nothing happened between the foreshadowing of divisional applications in May and the deadline for filing in September, together with the lack of any explanation why that should be the case, I am left in little doubt that the applicant has been unable to demonstrate the exceptional circumstances required to exercise comptroller’s discretion in allowing late filing of the divisional application.

### **Conclusion**

12 I refuse to exercise the comptroller’s discretion to extend under rule 110(1) of the Patent Rules 1995 the date set out in rule 24(1) for filing a divisional application. Therefore, the application must proceed on the basis of its actual filing date of 30<sup>th</sup> November 2004.

### **Appeal**

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

**H JONES**

Deputy Director acting for the Comptroller