



PATENTS ACT 1977

APPLICANT	Wei Xu
ISSUE	Whether to Exercise the Comptroller's Discretion to accept Form 52s to extend the S20 Compliance period on GB 2108146.8 and GB 2108148.4.
HEARING OFFICER	Dr Stephen Brown

DECISION

- 1 This decision concerns the exercise of the Comptroller's discretion to accept further Form 52s to extend the compliance period on GB 2108146.8 and GB 2108148.4. For the avoidance of doubt, it is not concerned with any technical aspect of the applications.

Introduction

- 2 Both applications are divisional applications that derive their priority from the UK national Phase application published as GB2530940. This takes its priority from the PCT application published as WO 2015/003476 that has a priority date of 8th July 2013.
- 3 I have attached a full timeline of events on both cases as an Annex to this decision but I will summarize the key events as follows. On 20th August 2021, the applicants filed a Form 52 to request an extension of two months to the compliance period under Section 20 on GB 1521949.6 to allow the filing of 10 divisional applications. I am concerned in this decision with only two of those applications and will deal with them solely on their own merits.
- 4 Following the initial filing of the divisional applications in suit, the applicants have requested further extensions using Form 52s on each application on 3 separate occasions. In each case these have been allowed. The last of these extended the compliance dates to 8th March 2022. I note that up to the filing of the 3rd Form 52 on each case only 1 round of amendments was affected on each case. After said 3rd form multiple rounds of amendments were submitted on each case but they all failed to overcome the examiner's objections.

5 The applicants then filed a further Form 52 on each case on the 30th March, 3 weeks after the extended compliance date, requesting a further two month extension. The need for the extension was explained as follows:

“although the applicant has made efforts to move this case towards grant, there remain several objections under various provisions of the UKPA which require significant work to address.

Furthermore, it was stated that:

“the applicant is keen to pursue each of the applications to grant... more time is required. This is particularly true as the applicant is based in China, and there are logistical difficulties with language and time difference to overcome”

6 One further observation is necessary at this point; Neither of the two applications are in order for grant at this stage and both still have significant objections outstanding.

7 The Examiner in these cases declined to exercise the Comptroller’s discretion and refused the requested extension. They gave three main reasons for this decision:

- i) The number of requests for extension already filed – including the extension on the parent case, this would be the 5th extension.
- ii) The geographical location of the applicant is not a relevant reason
- iii) The applicant has filed multiple divisional applications in China and Russia far ahead of those filed her. Had the UK applications been filed at the same time then there would be no issue of compliance with Section 20.

8 The applicants disagree with this view and the matter came before me for a hearing as a result. That hearing was held on 13th June 2022 where the applicant was represented by Philip Sanger of Grey Wolf IP. The Hearing was also attended by Nigel Hanley who assisted me and an observer, Anna Brandon.

9 I would like to record my thanks to Mr Sanger for the Skeleton arguments he filed beforehand and allowing the observer to attend the hearing.

The Issue

10 The Issue at hand is relatively simple:

- a. Should the comptroller exercise discretion and accept the Form 52 and further extension to the compliance period on each case?
- b. If the request is declined are the applications in order? If not, it follows that they should be refused under Section 18(3).

The Law

11 Section 20 (1) of the Act states:

If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of the Act and the rules, the application shall be treated as having been refused by the comptroller at the end of the period, and Section 97 below shall apply accordingly.

12 The prescribed period is set out in Rule 30:

Period for putting application in order

1) The period prescribed for the purposes of sections 18(4) and 20(1) (failure of application) is the compliance period.

(2) For the purposes of paragraph (1), subject to paragraphs (3) and (4), the compliance period is—

(a) four years and six months beginning with—

(i) where there is no declared priority date, the date of filing of the application, or

(ii) where there is a declared priority date, that date; or

(b) if it expires later, the period of twelve months beginning with the date on which the first substantive examination report is sent to the applicant.

(3) Subject to paragraph (4), where a new application is filed the compliance period is—

(a) where it is filed under section 8(3), 12(6) or 37(4)—

(i) the period specified in paragraph (2) in relation to the earlier application, or

(ii) if it expires later, the period of eighteen months beginning with the initiation date; and

(b) where it is filed as mentioned in section 15(9), the period specified in paragraph (2) in relation to the earlier application.

(4) Where the first observations report is sent to the applicant during the last three months of the period specified in paragraphs (2) or (3), the compliance period is three months beginning with the date on which that report is sent.

13 Rule 108 states:

(1) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by these Rules except a period prescribed by the provisions listed in Parts 1 and 2 of Schedule 4.

(2) The comptroller shall extend, by a period of two months, any period of time prescribed by the provisions listed in Part 2 of Schedule 4 where—

(a) a request is filed on Patents Form 52;

(b) no previous request has been made under this paragraph; and

(c) that request is filed before the end of the period of two months beginning with the date on which the relevant period of time expired

(3) The comptroller may, if he thinks fit, extend or further extend any period of time prescribed by the rules listed in Part 2 of Schedule 4 where—

(a) a request is filed on Patents Form 52; and

(b) the person making the request has furnished evidence supporting the grounds of the request, except where the comptroller otherwise directs.

(4) Each request under paragraph (2) or (3) for a period of time to be extended must be made on a separate form unless—

(a) each of those requests relate to the same patent or application for a patent; and

(b) the grant of each of those requests would result in the expiry of all the extended periods of time on the same date, in which case those requests may be combined and made on a single form.

(5) Any extension made under paragraph (1) or (3) shall be made—

(a) after giving the parties such notice; and

(b) subject to such conditions, as the comptroller may direct, except that a period of time prescribed by the rules listed in Part 3 of Schedule 4 may be extended (or further extended) for a period of two months only.

(6) An extension may be granted under paragraph (1) or (3) notwithstanding the period of time prescribed by the relevant rule has expired.

(7) But no extension may be granted in relation to the periods of time prescribed by the rules listed in Part 3 of Schedule 4 after the end of the period of two months beginning immediately after the period of time as prescribed (or previously extended) has expired.

The Applicants Arguments

- 14 Mr Sanger in his skeleton has summarised the issues into 5 distinct grounds, namely:
- i) Relevance of divisionals in other locations.
 - ii) The “unintentional” criterion;
 - iii) The “continuing underlying intention” criterion;
 - iv) Relevance of the number of extensions granted
 - v) The “logistical” & “complexity” criteria;
- 15 I will consider each of these in turn. I can dispense with the first ground relatively easily. The applicant’s decisions in how they prosecute an application are for them alone. The IPO is concerned only with the prosecution of an UK application to ensure it meets the requirements of The Patents Act 1977. It therefore does not matter what actions the applicant has taken in respect of applications in other jurisdictions. As a consequence, it is neither grounds for accepting, nor refusing, the extension. It is simply not relevant.
- 16 On the second and third points, Mr Sanger made clear that the applicant has not “unintentionally” missed the compliance date. More specifically, he makes the point that *“the Rule 30 period was not met because the applicant was not aware of it, or that the applicant had noted the deadline incorrectly, it is simply because more time is needed to complete the examination process”*. Furthermore, I have no doubt that the applicant wishes to continue with the application, we would not be here otherwise.
- 17 The “unintentional” and “underlying intention” criteria are, in my opinion, more properly issues of reinstatement under Section 20a of The Act. Unlike that section, rule 108 has no statutory test for the exercise of discretion. However, it is generally accepted that, for the sake of consistency at least, reinstatement offers good guidelines for applying rule 108, so I will briefly consider both criteria.
- 18 It is understood that discretion should be exercised favourably if the failure to meet the relevant date was unintentional. As this is not the case here, this ‘test’ does not help the applicants. To be clear, the fact that the applicants knew they were missing the date does not stop me exercising discretion in their favour, it’s just that this ‘test’ does not offer them any positive reason for me to do so.
- 19 As for the ‘continuing underlying intention to proceed’, I am happy to accept that this is indeed the case. However, I would note that the intensity of this intention has varied over the life of both applications. As noted above, up to the filing of the 3rd Form 52 on each case only 1 round of amendments was affected on each. Indeed, between the Form 52’s filed on the 20th October 2021 and those filed on 17th December 2021 no amendment or argument of any sort was made on either application. Clearly, the applicants wish to continue but I worry that the mere filing of a Form 52 is not enough. If that were the case, an applicant could continually file Form 52s ad infinitum and not materially progress an application. I believe something more is required than just filing a Form 52.

- 20 Before I consider Mr Sangers remaining points, I think it important to consider the purpose of Section 20 of the Act. I am of the view that Section 20 of the Act is there to make it clear to applicants when they need to have their application in order. Of equal importance, given the IPO is being asked to grant a monopoly on the claimed invention, it is there to provide certainty to third parties both about the scope of the invention and when it comes into force.
- 21 I am also cognisant of the provisions in the rules that make a distinction between a first extension without reasons (as of right) and any subsequent extension which requires a suitable reason (and the Comptrollers discretion). I believe this allows for those cases where a little more time is sometimes required hence the provision of a first extension but thereafter any more time is only allowable provided suitable reasons are given.
- 22 I will now consider in more detail the fourth ground advanced by Mr Sanger. Specifically, he argues that that there is no limit on the number of Form 52s an applicant may file. I concede that technically this may well be the case but as I have already observed above, this would permit the situation where an applicant could continually extend ad infinitum (albeit on payment of the required fees). That, I believe, is one reason the Comptroller is vested with discretion. In order to exercise discretion, the comptroller requires a reason and he must weigh this reason against the desire to provide certainty to third parties. It seems to me that the number of extensions already made and how close an application is to being acceptable ought to be part of the context of this decision in order to avoid the spectre of endless extensions.
- 23 From my analysis set out above, it is clear to me that the key issue in whether to accept a subsequent Form 52 on an application is the reason being given for why discretion is being requested balanced against the need to provide certainty to third parties.
- 24 Consequently, I now turn my attention to the reasons for the request of the Form 52. This turns on the fact that the applicant, as Mr Sanger has made clear, is based in China which, he argued, presents difficulties in communication in terms of distance and language. However, the Manual of Patent Practice (MoPP) at 18.56 makes it clear that the location of the applicant is not a relevant reason for an extension, stating:
- It follows that factors which may be considered normal in relation to all or particular categories of application, e.g., the distance of applicant's location from the UK, the complexity of the subject matter of the application or objections thereto, absence on business or holiday (see Decker's Application BL O/10/96), and a preference of the applicant to defer response until reports of parallel applications abroad have been received do not constitute good grounds for an extension of the specified period;*
- 25 This reasoning is based in part on *Jaskowski's Application*¹ where on page 199 the hearing officer made the observation:

¹ *Jaskowski's Application* [1981] RPC 197

“Section 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 adequate reason for exercising discretion which is peculiar to the particular applicant or application in suit, I can see nothing abnormal in the chain of communication in this case, which is the only reason pleaded before me in favour of an extension, which could be regarded as an adequate reason for extending the specified period”

- 26 While these quotes relate to extensions to specified periods rather than the Compliance period, I believe that they provide good guidelines in the present decision. 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.

Finally, Mr Sanger argued that a 4th extension was needed due to the complexity of the applications. In my opinion, though, the applications are not abnormally complex for patent applications. Indeed, most of their complexity stems from the applicants’ decision to file 10 divisionals from one parent application rather than being intrinsic to the technology for which protection is being sought. I thus do not accept this as an adequate reason to exercise discretion either.

Conclusion

- 27 I have carefully considered the arguments made by Mr Sanger on behalf of the applicants. I am of the view that the issue is one of discretion of the comptroller to accept a further Form 52 and that overrides any intention to continue with the application.
- 28 On the basis that the discretion is sought for the reasons of complexity and the applicant being in China, I do not find these valid reasons and I therefore I refuse to exercise discretion to accept the Form 52 on either application.
- 29 As a consequence, as neither application was in order at the compliance date of 8th March 2022, I therefore refuse both applications under Sec. 20(1).

Appeal

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

Dr Stephen Brown

Deputy Director, acting for the Comptroller

Annex

GB 1521949.6 (The Parent)

14.12.15	Priority Date
8.7.21	S20 Date
28.5.21	As of Right Extension (2 Months)
20.08.21	Form 52
8.9.21	New S20 Date

GB 2108414.8

8.6.21	F1 (Divisional Date Accepted	S20 date	8.9.21)
20.7.21	CSE		
23.8.21	Amends		
	Form 52		8.11.21
30.9.21	Examination		
20.10.21	Form 52		8.1.21
17.12.21	Form 52		8.3.22
20.12.21	Amends Filed		
25.01.22	Examination		
	EL35 Letter (S117B)		8.3.22
18.02.22	Amends		
9.3.22	EL35 – Hearing Offer and No ext of Time		
10.3.22	Email Exchange		
31.3.22	Form 52 (not Actioned)		
	Replacement Pages		
	Evidence		
2.4.22	Amendments		
7.4.22	Letter Refusing Extension		
25.4.22	Acceptance of Hearing		
1.6.22	Pre Hearing Report		

GB 2108146.8

8.6.21	F1 (Divisional Date Accepted	S20 date	8.9.21
22.7.21	CSE		
19.8.21	Amended Claims		
20.8.21	F52		8.11.21
1.9.21	Amended Drawings		
30.9.21	Exam		
20.20.21	S117b Request		
	F52		8.1.21
17.12.21	F52		8.3.21
20.12.21	Amends		
25.1.21	Further Search Request		
15.2.22	Further Search report		
	Exam		
2.3.22	Amends		
9.3.22	Exam		
30.3.22	F52 (Not Actioned)		
	Amends		
1.4.22	Letter Refusing F52/Hearing Offer		
12.4.22	Acceptance of Hearing		
6.6.22	Pre Hearing Report		