

Discretionary extensions of time under section 93(1) for patent examination correspondence

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Summary

This is a guide for granting discretionary extensions during examination to accommodate delays in replying to applicants' submissions, and for calculating the extension and extended date. This guide does not relate to granting extensions under section 93(1) if examination commences late or if new substantive objections are raised partway through the compliance period.

All extensions should be calculated and granted in accordance with Rules 1 and 2 to ensure consistency.

Rule 1

Each time an examiner replies to submissions or amendments from the applicant, the examiner should calculate an extension so that the time remaining available to the applicant at the date of receipt of their submission is not diminished by any time taken by IPONZ to process the application.

Rule 2

The examiner should grant and notify the calculated extension – unless it has previously been granted - immediately in the reply report unless both a significant period of time for the applicant remains and the time taken to respond is reasonable.

In Rule 2

“reasonable” means no more than 15 working days following receipt of the applicant’s submissions/amendments, and “a significant period of time” means that the time period between the date of the reply report and the current deadline is more than three calendar months.

Legislation

93. Commissioner may grant extension of time—

1. Where by this Act anything is required to be done within a prescribed time, and by reason of delay in the Patent Office the thing is not so done, the Commissioner may extend the time for the doing of the thing.
2. Where, having regard to the procedure specified and the information required under sections 12 to 16 of this Act or any regulations under those sections, the Commissioner is satisfied that the circumstances warrant an extension or extensions of the period specified in subsection (1) of section 19 of this Act, the Commissioner may extend the period prescribed therein for complying with any requirement imposed on the applicant by or under this Act; and the said subsection shall then be read as if the period so extended had been substituted for the period of 15 months therein mentioned

3. Where an extension of period has been allowed under subsection (2) of this section, the period so allowed shall be extended by the Commissioner to such further period not exceeding 3 months, as may be specified in a notice given by the applicant to the Commissioner, if the notice is given and the prescribed fee is paid before the expiration of the further period so specified.
4. No fees shall be payable in respect of any extension of time granted under subsection (1) or subsection (2) of this section.
5. The powers conferred on the Commissioner by this section may be exercised notwithstanding that in any case the time limited may have expired.

Rationale

Examiners (and applicants) should be aware of the circumstances under which discretionary extensions of time accommodating IPONZ delay in replying to patent correspondence are granted and how the extensions are actually calculated.

Explanation

Where extensions are required they should be granted consistently to all patent applicants in accordance with the Rules 1 and 2 to provide the maximum opportunity and time that can be made available for applicants to prosecute their patent application. Rule 1 is the traditional “stop the clock” principle that has been IPONZ practice for many years. Rule 2 modulates the operation of Rule 1 to prevent having to unnecessarily notify extensions and change deadline dates. In all cases, the granting of these extensions is an exercise of the

Commissioner’s discretion and variations from these rules will be necessary or desirable in some cases.

Examples of the application of the rules under different circumstances are set out below.

Date calculations

Date calculations for these rules are performed using “calendar arithmetic” or calendar months and calendar days. This is the accepted method for calculating time periods and dates in patent law as prescribed in the Interpretation Act 1999 and in the Regulations Under the PCT: Rules 80.1 to 80.7. The exception is that “working day” calculations are used under the particular circumstances outlined in Information for Clients No.16 of 30 June 2001 (see Example 3 below in particular).

If a due date happens to be a weekend or holiday then the applicant has until the end of the following working day or “office open day” to comply with the requirement.

Thus time periods or date differences are expressed in months and calendar days.

For example:

1. 14 July 2004 to 15 August 2004 is one month and one day because 14 July to 14 August is one calendar month and 15 August is the one remaining day.
2. But, 15 July 2004 to 14 August 2004 is 30 days because a “whole calendar month” cannot be extracted.

Three dates are required to calculate these discretionary extensions: the previously set deadline date, the date of the receipt of the applicant’s latest submission to IPONZ; and the date of the examiner’s report in reply.

Examples

Example 1

Applicant replies in good time and examiner’s report back is timely.

Earlier set deadline date: 21 July 2004.

The applicant’s submission received 29 March 2004.

The time still remaining for the application to be placed in order is 3 months and 22 days, that is 29 March to 29 June plus 22 more calendar days to 21 July.

The examiner replies to the submission with further objections on 19 April 2004, which is exactly 13 working days after the submission was received, accounting for the intervening Easter holidays.

The calculated extension is 21 days (that is, the applicant has had to wait 21 calendar days to receive a reply), however the reply time is “reasonable” in accordance with the second rule standard and at the time of the examiner’s reply the applicant still has at least three calendar months to complete the application.

Therefore, the calculated extension is not granted and notified at this stage.

Example 2

Subsequent reply from applicant and granting of accumulated delay extension.

Continuing Example 1, but now the applicant has submitted further amendments on 19 July 2004, two days before the deadline date.

The time due the applicant at the time of submission is 2 days.

The examiner replies to the applicant on 30 July 2004, and in this response cycle grants the total extension of the 2 days plus the 21 days from the earlier response/reply cycle.

The time is extended from the date of the examiner’s letter (30 July 2004) by 23 days to 22 August 2004.

Example 3

Applicant is right on the final deadline.

In this example the final 18-month deadline is set at an earlier time to 16 October 2004.

The applicant files submissions and/or amendments on 18 October 2004. (in time because 16 October 2004 is a Saturday).

The examiner replies quickly with continuing objections on 20 October 2004.

The applicant is not entitled to any further time in this case.

Despite the fact that the examiner took 2 days to reply the applicant is not entitled to the grant of an extension under section 93(1), the first rule being applied. The applicant has left things too late if the submissions are not sufficient to place the application in order on the last day. Further time for rectification of the application is not available under the time extension provisions of the Patents Act or Regulations.

In these circumstances, the examiner has the discretion notified in the Information for Clients No.16 of 30 June 2001 to grant the applicant 5 working days from the date of the examiner’s reply report to either place the application in order, request a hearing or request a further extension under section 93(2).

Under this practice, the final generally non-extendable date will be 27 October 2004, obtained in this case by counting five working days - rather than calendar days - from the 21 October 2004, the day after the date of the examiner’s letter.

To obtain a further extension under section 93(2) the applicant will be required to file evidence explaining the circumstances and reasons for requiring an extension.

Example 4

Applicant’s response is not received until after the final deadline has expired.

In this example the final 18-month deadline is set at an earlier time to 16 October 2004

The applicant’s response is received on 19 October 2004.

The application is VOID and the applicant will either have to restore the application under section 37 or request a special extension under section 93(2) for which they will be required to file supporting evidence.

Example 5

Examiner replies after a due date has expired.

In this example a 15-month deadline date is set at 21 June 2004 under section 19(1).

The applicant’s submissions are received 18 June 2004.

The applicant's time entitlement at the time of submissions is 3 calendar days.

The examiner's reply report is dated 7 July 2004.

In this case the 7 July report should extend the time under section 93(1) to 10 July 2004 being 7 July 2004 plus 3 calendar days.

Though the examiner has replied smartly, the applicant, at the date of the examiner's reply, now has less than three months to place the application in order so both of the conditions of the second rule are not met and the extension should be notified immediately.

Of course, the applicant can now request the further extension of up to three months under section 19(2) but to be calculated from the now extended date of 10 July 2004 (rather than from 21 June 2004). If this extension is notified to IPONZ then the final due date will be 10 October 2004, 3 calendar months on from 10 July 2004.

Example 6

Applicant files section 19(2) notice together with submissions.

In this example the applicant notifies the requirement for a section 19(2) extension before the examiner replies; (more usually) before or at the time of filing submissions.

Section 19(1) deadline date: 21 June 2004.

The applicant's submissions together with a Form 13 notice of 3-month extension under section 19(2) are received on 15 July 2004.

New 18 month deadline: 21 September 2004.

The examiner's reply report is dated 23 July 2004.

The applicant's time entitlement extends from 15 July 2004 to 21 September 2004, which is 2 months and 6 days.

In the examiner's reply report the time is extended under section 93(1) by 2 months and 6 days from the date of the report so that the new deadline date is 29 September 2004, which is 2 months and 6 days on from 23 July 2004.

Example 7

Applicant files submissions after a section 19(1) deadline, but initially fails to notify a section 19(2) extension.

In this example, as in examples 5 and 6, a 15-month deadline date is set at 21 June 2004 under section 19(1).

The applicant's submissions are received on 15 July 2004 without notification of extension under s19(2).

The applicant's submissions are 24 calendar days overdue.

Date of examiner's reply report: 23 July 2004.

In the examiner's reply report the time is "extended" under section 93(1) from 23 July 2004 by -24 days to 29 June 2004. No, this is not a mistake. The applicant is "out of time".

Of course, the applicant can notify IPONZ of the requirement for a further extension under section 19(2) of up to 3 months so that the final deadline including the section 93(1) extension will then be 29 September 2004, 3 calendar months from 29 June 2004, as in example 6. The notification of extension should be received by IPONZ before the last possible deadline date of 29 September 2004.