

### Abstract

Subsequent finding by the receiving Office that the PCT application did not comply with the requirements of PCT Article 11 for obtaining a filing date. The PCT application in question did not contain any claims.

## **The United Kingdom Patent Office**

### **In Re: Fletcher**

#### DECISION

#### Introduction

1. The United Kingdom Patent Office acting as a Receiving Office under the Patent Cooperation Treaty (PCT) has concluded that Mr Fletcher's international application should be considered withdrawn because it did not include claims at the filing date. Mr Fletcher requested that that decision be reviewed at a hearing. Although the PCT does not include provision for participating offices to have their decisions reviewed on appeal to a higher judicial level, the United Kingdom Patent Office has offered such hearings by analogy with hearings under the Patents Act 1977 on UK patent applications. The matter therefore came before me on 3 September 1998, when Mr Fletcher appeared in person, and Mr R C Kennell and Mr G C Shadbolt represented the Office.

2. It will be my task here to review the conclusion of the Receiving Office against the framework of the Patent Cooperation Treaty, its law and practice, and to consider whether any avenues exist under our own Patents Act 1977 for Mr Fletcher to salvage something if the international application is indeed lost. I must first explain the history of the case.

#### History

3. Mr Fletcher has made an invention concerning a bed which he has found has many beneficial properties to those suffering from a range of illnesses. He used the services of a patent agent to draw up an initial patent specification which was filed at this Office on 5 February 1997 as a United Kingdom patent application. This specification did not include claims, but the Patents Act 1977 allows a filing date to be given to such an incomplete application: that date can then establish a priority date for a more detailed patent application filed up to a year later, under the well-known scheme of the Paris Convention. Mr Fletcher decided that his initial application would be followed up by an international

application under the PCT within the year, and in January 1998 he was therefore giving thought to the preparation of that new application. He consulted the Patent Office by telephone at least twice, and I will return later to these important telephone calls. The international application was duly filed on Monday 2 February 1998.

4. When this Office acts under the PCT as a Receiving Office for the receipt of international applications it is charged with checking that they comply with certain formal requirements before one copy is forwarded to PCT headquarters (the International Bureau at the World Intellectual Property Organisation in Geneva), and another copy to the office that will carry out the international search. Mr Fletcher's application had eight pages of text and six pages of drawings, and the text concluded with a section headed "Benefits" which summarised the health improvements that users of the bed may experience. Also included on the second page was a paragraph which set out the beneficial improvements that the invention could bring to a user's health, and which specified ten numbered improvements. For example: "(1) Persons suffering from Sudden Death syndrome, in example cot deaths or crib deaths may be reduced."

5. The PCT sets out certain requirements for documents to be accorded a filing date. These are in Article 11 and the relevant parts read:

#### Article 11

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:

(i)

(ii)

(iii) the international application contains at least the following elements:

(e) a part which on the face of it appears to be a claim or claims.

(2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.

6. The function of claims is set out in Article 6:

## Article 6

The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.

7. There is therefore an onus on the Receiving Office to see inter alia whether the requirements for a filing date have been met. If a filing date is given but within four months it is found that it should not in fact have been given, Article 14(4) applies:

### Article 14(4)

If, after having accorded an international filing date to the international application, the receiving Office finds, within the prescribed time limit, that any of the requirements listed in items (i) to (iii) of Article 11(1) was not complied with at that date, the said application shall be considered withdrawn and the receiving Office shall so declare.

8. It is conventional in the patents world that the function of claims in a patent specification that is concerned with a construction, such as a bed, is to define those aspects of the construction that characterise the invention. It is clear that Mr Fletcher did not appreciate this before he filed his application, but understood the word "claims" in its alternative, and commoner, sense of a statement of benefits. I do not regard this as surprising: someone new to drafting patent applications would be expected not to be aware of the esoteric sense given to the word "claims" and thus to assume a commoner meaning. Mr Fletcher's application contained no definition, in the usual claims format, of the invention for which he sought protection. It is very surprising that the Patent Office did not identify this deficiency. It certainly identified other deficiencies: in its report of 17 February 1998 it noted the lack of an Abstract and certain defects in the presentation of the drawings.

9. Mr Fletcher nevertheless filed a revised specification on 13 March 1998 which included a sequence of numbered claims; but the content of the claims still related to benefits of the invention rather than to its constructional definition. Still the Patent Office raised no objection. It was not until a fax was received from the International Bureau in Geneva on 20 April 1998 that the claims were officially questioned: the fax was of a Form PCT/IB/321, which is entitled "Notification of facts which should have precluded the according of an international filing date". In this form the International Bureau called to the attention of the Receiving Office the fact that the application did not contain a part which on the face of it appeared to be a claim or claims, and said that it

considered that the Receiving Office should make a finding that the international application was to be considered withdrawn. The International Unit of the Patent Office then acted promptly and issued to Mr Fletcher a Form PCT/RO/115 (Notification of intention to make declaration that international application be considered withdrawn) which said that because of the lack of claims the Receiving Office intended to declare that the international application would be considered withdrawn, based on the "tentative" finding that the requirements under Article 11(1) were not complied with at the time the international filing date was accorded. Mr Fletcher was given one month to submit arguments if he disagreed with the tentative finding. He responded with a letter dated 6 May 1998 but the International Unit in its reply of 21 May 1998 confirmed the view it has since maintained, that there were no claims in the as-filed application since a description of benefits could not be said to define the matter for which protection was sought. That letter enclosed Form PCT/RO/143 which was the official notification that the international application was now considered withdrawn, as the applicant's arguments had not been found persuasive.

10. Mr Fletcher made further representations both to the International Bureau and to the Legal Division of the Patent Office without shaking the decision to consider the application withdrawn. It emerged during these exchanges that Mr Fletcher disclosed his invention at an exhibition in November 1997, which date is of course between his priority date of 5 February 1997 and his international filing date of 2 February 1998: what is sometimes called an intervening disclosure. This is of significance because if Mr Fletcher's international application took a later filing date, for example the date on which he filed true claims (cf PCT Article 11(2)(b) above), this later date would fall outside the year allowed for filing a follow-up 5 application to the priority application of 5 February 1997. The re-dated international application would then forfeit its priority date and the disclosure of November 1997 would pre-date the application: it would then be impossible for the application to satisfy the basic requirement of patentability that the invention be new, ie not previously made available to the public. Since the international application was filed on 2 February 1998 with only a matter of days remaining before the convention year expired it would have required very quick footwork by the Office and by Mr Fletcher in order for the claims deficiency to have been identified and rectified in time for the application to be re-dated to a date still within that year. I note that Mr Fletcher filed on 5 June 1998 a further amended specification that contains what appear to be proper claims. It has not however been suggested that the international application be re-dated under the provisions of Article 11(2)(b), no doubt because of the difficulty of the intervening disclosure I have just described.

Mr Fletcher's case

11. The situation we are now faced with is therefore that the UK Patent Office acting as Receiving Office, but clearly acting with the support of the International Bureau, has decided that Mr Fletcher's international application should be considered withdrawn under PCT Article 14(4) because it did not include claims at the filing date. What arguments has Mr Fletcher advanced to try and redress this? In his letters and at the hearing his reply has been that he would not have been placed in the present situation if the Patent Office had acted differently at two crucial moments: firstly, when he sought advice in January 1998 about the claims he had made in his application, and secondly, when he filed the application with insufficient time left for the claims deficiency to be identified and rectified. On the first point he said, as I indicated above, that he had received advice by telephone from the UK Patent Office in January 1998 that certain passages in his patent specification, some of which he read out over the telephone, were indeed claims, but should be numbered. This explained why the passage on the second page of the application contained a numbered list of benefits. I have no reason to doubt what Mr Fletcher said on this important point. From the Office's side no written record exists of these telephone conversations and no member of staff has a clear memory of them. The Office has therefore been unable to confirm or deny what advice was given, and has not even argued that Mr Fletcher was unlikely to have been advised as he was. Mr Fletcher on the other hand struck me as sincere and credible, and he has told a consistent story. I conclude that Mr Fletcher was, on the balance of probabilities, given advice that was wrong and which led him to believe that the application he filed satisfied the requirement for claims.

12. It is possible that this Office adopts a flexible attitude to what constitute claims in international applications: in the first place it can sometimes be difficult for non-technical staff in a Receiving Office to judge whether applications include any definitive statements that have the necessary degree of technical content, and in the second place the International Bureau in Geneva will act as an authoritative back-stop to correct any over-generous interpretation, as here. This flexible approach will act quite properly to resolve cases of doubt in favour of the applicant, and it perhaps explains the surprising failure of this Office to object to the lack of claims when the application was received and first reviewed. But it is an inappropriate approach when either (a) when advice is asked for prior to the filing of the application, when the applicant still has time to change his application, or (b) when there can be little doubt that there are no proper claims in the application, whether before or after filing.

13. The second criticism Mr Fletcher made was that he had no time to correct his application: in essence he had not been warned that it would take the Patent Office at least a week to look at the application and pick up any defects. He had

filed some three days before the end of the 12-month priority period, so that he would have been in a position to rectify any shortcomings, and still retain his priority date, if he had been promptly notified. Again I have considerable sympathy with this. The point is not that Receiving Offices should be attempting to verify all filing dates before the expiry of the year running from any priority application that might be mentioned, since that would plainly be impractical given the numbers involved and the lack of time available on many cases, filed where the year is all but up: but rather that certain inexperienced users, particularly first-time applicants or those not using patent attorneys, could well be advised that, because the filing date requirements will not be checked for at least 7 to 10 days (say) after filing the application, it will be in their interests to file their application no later than about 11 months (say) after their earliest priority application.

14. This raises the wider issue as to what guidance is officially available for inexperienced users of the PCT, and this was touched on several times in this case. The position is not entirely satisfactory. The International Bureau publishes, at one extreme, a short pamphlet "Basic facts about the PCT", and at the other extreme, a comprehensive multi-volume loose-leaf Applicant's Guide". Both concentrate on procedural aspects that characterise the PCT, and neither offer guidance on drafting patent specifications. The United Kingdom office has attempted to fill the gap for inexperienced PCT users by producing a 14-page booklet "Notes for Private Applicants", which is usually issued together with a series of six pamphlets of which the leading one is called "Working with the PCT". I understand these pamphlets are reprints of handouts obtained at seminars run by the International Bureau for users in this country. These are excellent, but again the advice on drafting claims is confined to the bald statement that "with respect to the structure and drafting of claims, the PCT requirements are largely similar to what is accepted in most patent offices". A sample claims page shows the layout of the claims (with title and numbering) but does not convey what their subject matter should be. The UK booklet "Notes for Private Applicants" does not venture to offer any advice on drafting specifications. The UK Office however also issues a booklet on UK patent applications: "How to apply for a UK patent application". This includes drafting advice and more particularly a short model specification of a simple mechanical invention. It was not until Mr Fletcher saw this model specification that he appreciated what claims should cover, but by then it was too late.

15. It would be naive to suppose that PCT users will always follow the customary official advice to employ a patent attorney, bearing in mind the considerable costs. The needs of first-time users, who are new to patenting as well as to the PCT, should not be forgotten. I would therefore recommend that

guidance literature produced by both the International Bureau and by this Office be reviewed to include:

- a simple model specification, and some basic advice on drafting, particularly on what claims should and should not cover.

- advice to file no later than 11 months (say) from the priority application. Findings as to the international application.

16. I draw the following conclusions from all this. I am quite clear that the decision of the UK Office as Receiving Office to consider the international application withdrawn for lack of claims on the filing date was a correct one. The application simply did not have claims, in the patents sense, on the filing date. Indeed Mr Fletcher has not tried to argue that it did, now that he appreciates what claims require; his starting point is rather that the defect was attributable, at least in part, to misleading and incomplete advice, for which he believes he should not be penalised. Unfortunately the PCT contains no mechanism whereby this international application can now be revived and resume its international phase. I find therefore that international application PCT/GB 98/00321 was correctly considered withdrawn for lack of claims at the filing date, under the terms of Article 14(4) of the PCT.

17. It will be important for what follows to note that this is not an instance where a filing date was not accorded at all: one was indeed accorded, so that an international application came into being, and that application is now considered withdrawn.

#### Alternative routes

18. Mr Fletcher has therefore lost his international application PCT/GB 98/00321: can anything be retrieved? The PCT itself has certain safety nets for applicants which should be considered, but it will be seen below that these are often rather circumscribed by limitations of timing and procedure. The contracting states of the PCT do of course have an obligation to reflect these safety provisions in their national laws, to the extent that national procedures are affected, but there is no bar on national laws being more generous, particularly on matters of national procedure. This will be seen to apply to our UK provisions. Looking first at the PCT however there are various safety nets provided in Articles 25, 26, 27(4) and Rule 82ter, which are examples which seem to be of most interest to the present case. The most relevant is clearly Article 25, which includes the following:

Article 25 Review by designated offices

(1)(a) Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn,... the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to any of the designated Offices named by the applicant.

(b) ...

(2)(a) Subject to the provisions of subparagraph (b), each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in paragraph (1) was justified under the provisions of this Treaty and the Regulations, and if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office ... it shall as far as the effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred.

(b) ...

19. The Article 25 procedure would require Mr Fletcher to apply to all or some of the countries he designated in his application with facts and evidence so that each country can make its own judgment as to whether the loss of the filing date was the result of an error or omission by the UK Receiving Office. If the judgment is favourable the national phase must be started and each country processes the application as a national application. There is however a two-month period provided by PCT Rule 51 for initiating this procedure, which started when Mr Fletcher was notified of the loss of filing date, ie on 21 May 1998, and has thus now expired. I am not aware that this avenue was ever pointed out to Mr Fletcher: I am surprised in particular that the official notification PCT/RO/143 of the withdrawal of the application does not contain this information. It would of course have been a major undertaking, involving considerable expense, for Mr Fletcher to have to start the national phase in all, or even a selection of, his designated countries and to have to satisfy each of them as to the error made in the UK Receiving Office. In any event the avenue is no longer open.

20. PCT Rule 82ter.1 may also be of interest. It allows a designated Office to rectify the international filing date if (i) the applicant proves that the receiving Office made an error over the date, and (ii) the national law of the designated Office would allow such rectification. Again this would require Mr Fletcher to throw himself on the mercy of the designated Offices, but there is no time



limitation. I am not sure this provision is however appropriate for Mr Fletcher's situation because it is the withdrawal of his application that he would wish to contest, not the filing date that was given to it.

21. Let us now look at what safety provisions have been included in our own law, and to what extent they reproduce the PCT provisions. Section 89 of the Patents Act 1977 includes two provisions that deal with errors or omissions by PCT offices and are based on Article 25 PCT. Firstly, section 89(5) applies where the application has been refused an international filing date. As I noted above this was not the case here, and so I shall not consider section 89(5) in any detail. Secondly, section 89(3) applies where the application has been deemed withdrawn under the PCT:

Section 89(3)

An application shall not be treated as withdrawn under this Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Treaty-

( a) because of an error or omission in an institution having functions under the Treaty,

(b)...

or in such other circumstances as may be prescribed.

22. Some "other circumstances" are provided in Rule 85(9) of the Patents Rules 1995:

Rule 85(9)

An international application for a patent (UK) shall not be treated as withdrawn under the Act if it, or the designation of the United Kingdom in it, is deemed to be withdrawn under the Patent Co-operation Treaty where, in the same or comparable circumstances in relation to an application under the Act (other than an international application)-( a) the comptroller could have directed that an irregularity be rectified under rule 100, or could have granted a dispensation for the doing of any act or thing, or the production or filing of any document under rule 101, or could have granted an extension of time under rule 110, or could have extended the time or determined the times or periods under rule 111; and (b) the comptroller determines that the application would not have been treated as withdrawn under the Act.

23. A successful outcome under section 89(3) means that the application is not treated as withdrawn under the Patents Act 1977 and section 89(1) of the Act continues to apply to it (which means that we continue to recognise the

application as an application under the Act, subject to the usual UK procedures). The comptroller is given power to do certain things listed in Rule 85(10):

#### Rule 85(10)

Where under section 89(3) an application is not to be treated as withdrawn and the applicant wishes to proceed

( a) the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau and alter any period or time which is specified in the Act or these Rules upon such terms (including payment of any appropriate prescribed fee) as he may direct; and

(b) the fee prescribed under section 89A(3) shall not be payable.

24. The applicant starts a section 89(3) determination according to Rule 85(8)

#### Rule 85(8)

Where, in relation to an international application for a patent (UK), the applicant desires that section 89(1) shall not cease to apply to the application by virtue of the operation of section 89(3), application in writing to that effect shall be made to the comptroller including a statement of the facts upon which the applicant relies, accompanied by the prescribed fee, if any.

25. As regards the fee payable I note that the Patents (Fees) Rules 1998, effective from 1 October 1998, prescribe a zero fee against the entry "On application to the comptroller under rule 85(8) or 85(12) for an international application to be treated as an application under the Act". No "national fee" for entering the national phase is payable, by virtue of Rule 85(10)(b), although this fee is also now zero.

26. Comparison of these UK provisions with those of the PCT show that they embrace and extend the PCT possibilities. Of particular concern to Mr Fletcher will be the fact that the UK provisions for review of withdrawal under section 89(3) which I have reproduced above do not reflect the two-month PCT time limit, indeed include no time limit at all. There is nothing untoward or inconsistent about this, because as I have said it is open to PCT contracting states to implement provisions consequential on the PCT in a more generous manner where the effect is confined to the national side of the international/national interface and is consistent with PCT objectives. Here we are considering how Mr Fletcher's application might survive solely within the United Kingdom, and I am therefore satisfied that the PCT Rule 51 time limits

are not a constraint here. Another point of difference is that Article 25 PCT envisages that the application is sent to the designated states where review is to be requested by the International Bureau on the applicant's request and there must first enter the national phase, by payment of the national fee and filing of any necessary translation. The UK provisions do not mention communication by the International Bureau, entry into the national phase (indeed the national fee is not payable) or filing of a translation, as a pre-condition to the review or otherwise. If the UK review is favourable the application is simply treated (again) as an application under the Act (section 89(1)). I consider however that further processing of the application must take place in accordance with the usual provisions of sections 89, 89A and 89B and that the applicant must in fact request early entry into the national phase in order to initiate processing of the application as a domestic UK application.

27. At the hearing I asked Mr Fletcher to address me on whether he considered the UK Receiving Office (or the International Bureau) had made an error or omission or other irregularity, because I wanted to advise him in this decision as fully as possible whether redress would be available to him in the United Kingdom if I decided his international application could not be revived. Now that I have so decided, his only course seems to be to pursue national patents in individual countries.

28. If he decides that he wishes to try and obtain a United Kingdom patent he should invoke section 89(3) by applying in writing in the terms provided under rule 85(8) above: the fee is zero and I am sure his previous submissions in this case would make an adequate "statement of the facts" if he were so to request. He should also request that the application proceed forthwith into the UK national phase, with a filing date of 2 February 1998 and priority date of 5 February 1997, with the application papers being copied from the Receiving Office file. If such a request under section 89(3) were received I would be ready to conclude that the conditions of Rule 85(9) had been satisfied: I considered above the role that the Office's advice played in this case prior to the filing of the international application, and I concluded on the balance of probabilities that it was wrong advice. In comparable situations under UK law we have rectified the effects of wrong or inadequate advice by invoking Rule 100, and would therefore have avoided treating the application as withdrawn. The quality of advice given to inexperienced users is of course very important and I am clear that if a private individual applying for a UK patent had been led to file no, or inadequate, claims as a result of office advice it would constitute an irregularity of procedure before the Office that it would be proper to rectify by Rule 100 of the Patents Rules 1995. I believe the two-fold test in Rule 85(9) has been shown to be satisfied.

29. If such a conclusion were reached the application would retain its filing date of 2 February 1998 as a UK application. The deficiency as to claims would need to be rectified on a timetable to be agreed; it might indeed be possible to use the claims that were filed on 5 June 1998. The powers given by Rule 85(10) above should allow the application to be put on course as a regular national application.

30. As to pursuing national applications in other countries, the possibilities will depend very much on their national laws, and Mr Fletcher has no choice but to seek professional advice on this. Certain countries (USA and Canada) may permit filing of a patent application after a public disclosure has been made if this filing is done within a "grace period" of one year. I mention this because we are approaching one year from when Mr Fletcher disclosed his invention at an exhibition in November 1997.

Conclusions.

31. I have therefore concluded that international application PCT/GB98/00321 must remain "considered withdrawn"; but that the conditions for pursuing the application solely as a United Kingdom application appear satisfied if Mr Fletcher should decide to do so. I would ask him to respond within two weeks of the date of this decision if he does so decide, giving the details mentioned in paragraph 28 above.