

Abstract

Even in light of an unintentional intended error in the submission of a correct translation for an international application, the Court found that the international application was validly withdrawn under PCT rules.

Masuda's Application

Patent Office Chancery Division (Patents Court)

HEARING-DATES: 13 December 1985

13 December 1985

INTRODUCTION:

This was an appeal to the Patents Court by Takahiko Masuda from a decision dated 9 August 1985 by Mr J Sharrock, superintending examiner acting for the Comptroller, that application No 8414539 must be taken to be withdrawn under section 89(3) of the Patents Act 1977.

Mr J Sharrock: International application No PCT/JP83/00359 in the name of Takahiko Masuda, a Japanese citizen, was filed under the provisions of the Patent Cooperation Treaty (PCT) on 15 October 1983 at the Japanese Patent Office acting as the receiving office. The application claimed priority from Japanese application No 57/179990 dated 15 October 1982 and designated the USA and the United Kingdom as countries in which a patent was sought. The application proceeded through preliminary examination and search under the Treaty and was published by the International Bureau in the Japanese language on 26 April 1984 under the number WO 84/01603. In accordance with PCT article 20 and rule 47, on the same date a copy of the application in the form of the published pamphlet was sent to the designated offices by the Bureau.

On 8 June 1984, WP Thompson & Co patent agents, submitted to the Patent Office patent forms 42/77, 9/77 and 10/77 with the appropriate fees and a document described in the agents' letter as a verified translation of the international application (in duplicate) together with patents form 43/77 and the relevant fee. Attached to the document was a certificate of translation indicating that it was a translation to English of the PCT application PCT/JP83/00359, filed in Japan on the 15 October 1982 in the name of Takahiko Masuda, [the year 1982 in the date of filing on the certificate was thus incorrect]. The date of filing these documents was within the period prescribed under rules 85(1)(a), 85(3)(a) and 85(3)(b) of the Patents Rules 1982. On 6 July 1984, within the period

prescribed by rule 6(6), a verified translation into English of the Japanese priority application was filed.

On 9 July 1984, an official letter issued querying the presence of the name of a second applicant on patents form 42/77. This matter was resolved, however, upon receipt of information contained in a letter from the agents received on 11 July 1984.

Following standard Office procedure, the translation was forwarded to the printing and publishing branches for publication according to section 89(5), and on 16 August 1984 the standard official letter issued informing the applicant that publication would take place on 21 November 1984.

On 14 September 1984, it was discovered in the Office, quite by chance, that the document which had been furnished on 8 June 1984 and described as a verified English translation of the international application appeared to be a translation of the Japanese priority document. This information was conveyed by telephone to the agents by the formalities officer dealing with the case.

On 17 September 1984, the agents filed a letter dated 14 September 1984 confirming that the translation filed on 8 June 1984 related to the priority application rather than the international application. With their letter, the agents submitted the correct translation together with a copy of the original verification by the translator.

On 24 January 1985, after the file had been returned from publication branch, an official letter issued observing that the translation of the international application had not been filed within the prescribed period, and that by operation of law, the application was taken to be withdrawn. The official letter gave the applicant the opportunity to submit comment or to request a hearing.

Mr Thorley, who appeared as counsel for the applicant, began by handing me a statutory declaration by his instructing patent agent Mr DI Huntingford, a partner in WP Thompson & Co, together with 24 exhibits, which he then proceeded to take me through.

The declaration begins by reciting the filing and publication details of the international application indicated above, then indicates that by a letter of 2 June 1984, Mr Masuda's Japanese agents, Kobashi International Patent Office, instructed Thompson to handle the UK national phase of the PCT application. It then sets out the basic documents required for the UK national filing and indicates that by their letter of 7 June 1984 they believed they had filed the necessary documents, including two copies of a verified translation of the

international application. What they did not realise at that time was that someone (perhaps in their office, perhaps in the Japanese agents' office) had attached the certificate of translation to the translation of the priority documents instead of the translation of the international application, and the wrong translation was filed. The filing receipt (P Ack 4) received from the Patent Office was sent to the Japanese agents on 25 June 1984. Mr Thorley noted that it referred to "verified translation in duplicate", but he said that clearly one does not expect the formalities section to check on translations and he took no point on that. It was used by the agents to routine double-check that forms had been filed, but not to check other documents. The declaration then explains their use of a so-called "Block Sheet" which lists cases going off to the Patent Office that day and which is signed by two partners to confirm the details. It is noted that the only "missing document" listed was the translation of convention documents and it was believed by both partners who signed that a declared translation of the international application was being filed with the application. The Japanese agents were informed by telex that no translation of the priority document had been received, and subsequently they sent a declared translation of the basic Japanese patent application, which was then filed at the Patent Office with a letter of 6 July 1984.

The declaration continues:

"It is now evident that at this point the Patent Office had three translations of the priority document but none of the international application. At the time, however, we had no suspicion of this state of affairs. Some correspondence with the Patent Office and the agent in regard to the applicants then took place. It is noted that this correspondence was in connection with matters unrelated to the present problems and implied that the Office considered at that time that the relevant conditions had been met to secure an application in accordance with sections 89(4)(a) and 89(6).

" After mentioning the publication letter of 16 August 1984, the declaration continues:

"On 14 September 1984 (some 23 months from priority date) I received a telephone call from a Mr Bennett in the formalities department of the UK Patent Office advising me that there was an apparent discrepancy between the 'verified translation of the international application' as filed and the international application itself. He had noticed that the latter contained six claims whereas the former has only three. I was asked to provide a copy of the description and claims in our file attached to a copy of the certificate of translation. I filed this on the same day with our letter of 14 September 1984."

Mr Huntingford further states that at an informal interview on 12 February 1985 with Mr Sceats it was noted that the date the formalities officer first received the file was 19 June 1984, although he did not contact the agents regarding the necessary documents until 14 September 1984, by which time the available period had already expired. He further notes that the application was subsequently published, the text being a re-arranged version of the translation of the priority document and not the document attached to their letter of 14 September. It appears to have been a procedural error on the part of the Patent Office to have allowed the application to proceed to publication.

Finally, Mr Huntingford emphasized that Mr Masuda had no experience of filing patent applications in the UK, whether via national or PCT routes, and relied on his Japanese and UK agents. It has at all times been Mr Masuda's intention to obtain a patent in the UK and the present problem has arisen in a manner quite beyond his personal control and contrary to his intentions. The declaration also indicates that Mr Kobashi, the Japanese agent, studied at Stanford University, USA, speaks very good English and the UK agents have worked with him for many years with no language difficulties.

Having dealt with the evidence, Mr Thorley then took me to the Act and the rules to see what restrictions there were. The section in the Act is section 89(1), which provides:

"Subject to the provisions of this Act, an international application for a patent (UK) for which a date of filing has been accorded . . . under the Patent Cooperation Treaty . . . shall, until this subsection ceases to apply to the application, be treated for the purposes of parts I and III of this Act as an application for a patent under this Act having that date as its date of filing",

and so on. That is the enabling provision which allows an application filed by the PCT route to get in under the 1977 Act. It then says in paragraph (a) that ". . .

the application, if published in accordance with the Treaty and if it satisfies relevant conditions, shall be so treated as published under section 16 above, subject, however, to subsection (7) below."

Subsection (7) below says:

"For the purposes of sections 55 and 69 above an international application for a patent (UK) published in accordance with the Treaty (a) shall, if published in English, be treated as published under section 16 above on its publication in accordance with the Treaty; (b) shall, if published in any other language and if the relevant conditions are satisfied, be treated as published under section 16

above on the publication of a translation of the application under subsection (5) above; but, if the application is published in a language other than English, the applicant may recover a payment . . .", and so on.

Subsection (5) is:

"The comptroller shall on payment of the prescribed fee publish any translation filed at the Patent Office under subsection (4) above."

One has now to go back to subsection (4) which reads:

"The relevant conditions (a) in the case of an application, are that a copy of the application and, if it is not in English, a translation into English has been filed at the Patent Office and the filing fee has been paid to the Patent Office by the applicant."

Subsection (3) reads:

"Notwithstanding anything in subsection (1) above, the provisions of the Treaty and not those of this Act relating to publication, search, examination and amendment shall apply to any such application until all the relevant conditions are satisfied and, if those conditions are not satisfied before the end of the prescribed period, the application shall be taken to be withdrawn."

This is the subsection under which the application is taken to be withdrawn.

Then subsection (6) says:

"Before the relevant conditions are satisfied, subsection (1) above shall not operate so as to secure that an international application for a patent (UK) is to be treated for the purposes of section 8 above as an application for a patent under this Act and shall not affect the application of section 12 above to an invention for which an international application of a patent is made or proposed to be made, but when the relevant conditions are satisfied, the international application shall be so treated and accordingly section 12 above shall not apply to it."

Mr Thorley indicated that the effect of this subsection is that the international application cannot be treated as an application for a patent in this country until the certified translation has been filed.

Subsection (9), again refers to the conditions. It reads:

"Where the relevant conditions are satisfied before the end of the prescribed period, the comptroller shall refer the application for so much of the examination and search as is required by sections 17 and 18 above as he considers appropriate in view of any examination and search carried out under the Treaty, and those sections shall apply with any necessary modifications accordingly."

The relevant parts of rule 85 read:

(1) An international application for a patent (UK) shall be treated as an application for a patent under the Act if the relevant conditions of section 89(4) are satisfied before the end of the period of twenty months calculated from . . . the declared priority date; and . . . patents form No 42/77, duly completed, is filed within the relevant period."

Mr Thorley's first submission was that it is possible to correct the error under section 117 and the associated rule 91. Section 117(1) reads:

"The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application."

Rule 91(1) indicates that the request for such correction shall be made on patents form No 47/77. Mr Thorley submitted that on the evidence there was a clerical error in an application for a patent, that clerical error was the sending of two copies of the wrong document.

The problem with this argument is that the error in sending the wrong translation resulted in failure to comply with the relevant conditions of section 89(4) with the consequence that under section 89(3) the application must be taken to be withdrawn. In the judgment in the case of Payne's Application [1985] RPC 193, Falconer J held that correction under section 117(1) could not be allowed because it would circumvent the mandatory requirements of section 15(5) under which the application was taken to be withdrawn. The same principle must apply here, since the application is taken to be withdrawn under section 89(3). I drew Mr Thorley's attention to this judgment, which at that time had not been published. He accepted that the point had been taken against him and did not pursue the argument before me.

Mr Thorley then turned to rule 100 which reads:

"Any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct: Provided that, without prejudice to the comptroller's power to extend any times or periods under rule 110 below, and except where such error or irregularity is attributable wholly or in part to any error, default or omission on the part of the Patent Office the comptroller shall not direct that any time or period specified in the Act . . . shall be altered."

So that, in order to get under rule 100, it is necessary to show first that there has been an irregularity of procedure, secondly, that it may be rectified; and, thirdly, that the irregularity was attributable wholly or in part to an error, default or omission on the part of the Patent Office.

In this case, he said, the irregularity is filing or purporting to file the certified translation out of time, that is to say, the correct translation was filed on 14 September, rather than before 15 July 1984 -- this latter date, I should point out, including the extension of time which could have been obtained on filing patents form 50/77 and paying the appropriate fee. The default on the part of the Office, he said, was proceeding with the application before the relevant conditions of section 89(4) had been complied with. He submitted that in sending the letter of 9 July dealing with change of name, the Office was quite clearly proceeding with the application to publication, when it is clear under section 89(6) that until the relevant conditions had been complied with, the Office had no power to proceed at all. Thus, said Mr Thorley, the Office was in default in sending the letter of 9 July. In order to comply with their obligations under the Act, Mr Thorley said, which is not to proceed until the relevant conditions are complied with, there is a duty on the Office to check that they have received a verified translation of the international application; and they can do that by doing precisely the same comparison as was made by the formalities officer in September when he realised that the translation had only three claims and the international application in Japanese had six claims. Mr Thorley contended that this should have been done before any Office action was taken in relation to the application; the only letter which could have been written on 9 July was: "We are powerless to act under section 89(6), because we have not got a verified translation". There was thus a default on the part of the Office in a statutory obligation, he said.

If on the 9 July they had written to say they could not act, the problem would have been solved, because the agents had the correct document on their file and they could have lodged this and filed form 50/77 before 15 July 1984. Mr Thorley's argument, as I understood it, was that under the statutory language, the Office is obliged to do more than ensure that there is a verified translation,

because to require more than that the Office would have to employ someone who could understand Japanese. Nevertheless, if for any reason they accepted the wrong translation then they were in default in proceeding with the application. He emphasized that it was not a question of guilt or culpability, simply that they were unknowingly in default under the Act. He also accepted that no default on the part of the Office contributed to the original irregularity of not filing the translation within the rule 85(1)(a) period, but he argued that the irregularity to be considered was the further irregularity of not filing the correct translation within the additional month obtainable by filing form 50/77.

As I understood him, Mr Thorley based his argument that the Office was in default on his construction of section 89(6) as meaning that before the relevant conditions were satisfied the Office could not proceed with the application. However, it seems to me on careful consideration, that section 89(6) has to be read in conjunction with sections 8, 12 and 89(1). Section 89(1) states that

". . . an international application for a patent (UK) for which a date of filing has been accorded . . . shall, until this subsection ceases to apply to the application, be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act having that date as its date of filing . . ."

Section 8 deals with determination before grant of questions about entitlement to patents at the request of any person. This section in referring to "any application for such a patent" must, in view of section 130(1) mean an application for a patent under this Act. Section 12, in contrast, deals with determination of entitlement to foreign applications or applications made under any treaty or international convention (which must include applications under the Patent Cooperation Treaty). Thus what section 89(6) is saying is that before the relevant conditions are satisfied questions of entitlement to an international application (UK) are not (by virtue of section 89(1)), treated under section 8 but under section 12; but when the relevant conditions are satisfied, such questions are treated under section 8 and not section 12. I do not understand the section to be saying more than that. When the formalities officer issued the letter of 9 July 1984 he was not dealing with a reference by anyone under section 8 or 12, therefore I do not see the relevance of subsection 89(6) to the argument. Mr Thorley dealt with this subsection as if it read: "Before the relevant conditions are satisfied, subsection (1) above shall not operate" and nothing more. However, as I have indicated above it goes further, and, as I understand it, it only defines which of section 8 or 12 shall apply when a reference has been made for determination of rights.

While it is undoubtedly true that in view of sections 89(3) and (4) the Office cannot proceed with an application if the relevant conditions are not satisfied

within the prescribed period (including any extension obtainable under rule 110(3)) Mr Thorley's argument raises the question whether the Office can raise any questions, or point out apparent errors, before all relevant conditions are satisfied. Mr Thorley has interpreted the Office letter of 9 July 1984 as an act of proceeding with the application before the relevant conditions were satisfied.

It seems to me that by his letter of 9 July 1984, although he did not refer to the form specifically, the formalities officer was drawing attention to an error in the completion of patents form 42/77, which according to rule 85(1) must be duly completed and filed within the relevant period. The agents accepted the point and indicated in their letter of 11 July that the co-applicant's name should be deleted. Subsequently the formalities officer deleted the name from forms 42/77, 43/77, 9/77 and 10/77. If the Office cannot draw errors of this kind to the applicant's attention before all relevant conditions are satisfied, it would follow logically that the Office could not draw attention to the filing of an incorrect translation if it discovered it. This seems to me to be an impossible argument.

Nevertheless, for the sake of pursuing the argument, I will assume that Mr Thorley is correct and, in writing the letter of 9 July 1984, the Office was in default. The next thing is to consider whether the irregularity was at least partly attributable to this default.

In the judgment of the Court of Appeal in *Morgan-Ward Critchley (M's Application)* [1985] RPC 249, Oliver LJ said:

"It is always dangerous to paraphrase statutory wording but it seems to me that the word 'attributable' involves the concept that what has to be demonstrated is that the error, default or omission upon which reliance is placed, does play an active causative role in the irregularity which has taken place. It clearly does not have to be the sole cause, but it has, I think, to be something more than a mere *causa sine qua non* so that it can be said to be a partial cause of the irregularity in the sense of having actively brought it about."

First of all, it is clear (and this was accepted by Mr Thorley) that no error or default on the part of the Office played any part in the original irregularity of failing to file the correct translation before the end of the period prescribed under rule 85(1)(a).

Secondly, if the irregularity to be considered is that of failing to file the correct translation within the additional month obtainable on filing form 50/77, the mere fact of issuing the letter of 9 July could not of itself have played an active causative role in bringing about the irregularity, because the agents were completely unaware that anything was wrong. The documents in their own files

were at that time correct. They did not even realise that the Japanese agents had sent them translations of both the international application and the priority document on 4 June 1984. Thus they could not have discovered the error even if the Office had not sent the letter of 9 July. Therefore, the real question turns on whether there was an obligation on the Office to detect the error and inform the agent before 15 July 1984 that the wrong translation had been filed. This, it seems to me, goes beyond the technical default, alleged by Mr Thorley, of proceeding with the application when the act forbade it.

To use the words of Oliver LJ in *M's Application* [1985] RPC 249 at 272, approved by the Court of Appeal in *Mills' Application*, it is a question of whether there was a failure of the Patent Office

". . . to do something which it can be said there is some sort of obligation to do".

The difficult question, as the Court of Appeal asked is: "What sort of obligation will suffice for this purpose?".

Slade LJ in *Mills' Application* [1985] RPC 339 at 359 said:

"The phrase 'omission' must in my opinion, at very least be wide enough to include the failure to perform a duty which the Office is obliged to perform at common law, whether under the law of contract or of tort, even though such duty is imposed neither by the statute nor the rules. On ordinary principles of construction, I could see no possible grounds for excluding the failure to perform a duty of this nature from the ambit of the word 'omission'.

"However, in a number of instances, difficult questions might arise as to whether a legal liability existed, in particular under the modern law of negligence. Simply, for example, to what extent, if any, does the Office owe a duty of care in giving advice and guidance to an applicant who is not legally represented? I cannot think that the legislature would have contemplated that, in performing the function imposed on him by the relevant words of the proviso to rule 100, the Comptroller should be obliged to consider nice questions as to the existence or otherwise of a legal liability on the part of the Office in order to satisfy himself as to his jurisdiction.

"With respect to Oliver LJ, my conclusion is that, whether or not they were strictly obiter, his three propositions in the *Morgan-Ward Critchley* case as to the availability of rule 100 in cases such as the present were correctly stated, subject to the rider that the failure to do something 'which the Patent Office is under some sort of obligation to do' is, in an appropriate case, capable of

constituting an 'omission' within the wording of the proviso, even though the obligation is not of a legally enforceable nature.

"I do not propose to attempt a comprehensive formulation of the categories of obligation on the part of the Patent Office which are capable of giving rise to an 'omission' in the relevant sense."

Thus it seems to me that in the absence of more detailed guidance, apart from the specific examples mentioned in the judgment, where there is no clear statutory obligation, the Comptroller can only consider the question from a common sense or practical point of view rather than a purely legalistic one. In this case the Act lays the onus on the applicant to file a translation in time and it does not stipulate that the Office must inform the applicant if the wrong translation is filed. Clearly if such an error is detected then the applicant is informed. Sections 123(1) and 2(j) make provision for rules relating to authentication of any translations and rule 113(1) lays down that a translation of a document into English shall be

". . . verified to the satisfaction of the Comptroller as corresponding to the original text".

Thus it seems that the legislature recognised that the Comptroller cannot be expected to check translations for correctness. From a common sense and practical point of view, therefore, it seems to me that in checking a translation which has been filed, the Office is obliged to do no more than ensure that the translation is properly verified by the translator (who accepts responsibility for the accuracy of the translation as being true to the best of his knowledge and belief) and to check for obvious errors or omissions. In the case of a translation of a Japanese document, it cannot really be suggested that the Office must be satisfied that the translation is what it purports to be; and as I indicated above, Mr Thorley at a later stage of the hearing, accepted that in good practice the Office could not be expected to do more than check that there was a verified translation. In this case, both copies of the translation were identical and both had a certificate attached indicating that the document was a translation of the PCT application. In accepting these translations and verifications on their face value, in my view, the formalities officer did all that he was obliged to do, and the fact that at some later date during the re-publication process it was discovered that they were the wrong documents, does not alter that view. Consequently, I have concluded that the fact that the Office did not notify the agents of their error before 15 July 1984 does not constitute an error, default or omission on the part of the Patent Office, and therefore the Comptroller has no discretion to act under the proviso to rule 100. I would add that in the

circumstances of this case, I would have exercised discretion in the applicant's favour had that been open to me.

Mr Thorley's third submission was under rule 113(6) which reads:

"The comptroller may refuse to accept any translation which is in his opinion inaccurate and thereupon another translation of the document in question, verified as aforesaid shall be furnished, together with the appropriate number of copies thereof."

Mr Thorley pointed out that the rule was there because the legislature appreciated that a possible source of error is in translation. The rule is not limited in any way to partial inaccuracy; it says that

"The comptroller may refuse to accept any translation which is . . . inaccurate . . .";

it does not say "in part inaccurate" or "partially inaccurate", he said. Therefore, one can take it, on proper construction that the inaccuracy can be total. In this case, he said, the formalities officer telephoned to say that he had the wrong document and the agents furnished him with the right document.

Mr Thorley put forward two arguments on this. First that the Comptroller can and should accept the correct translation under rule 113(6). Second, the Comptroller is functus; the formalities officer acted, requesting a correct translation, which has been furnished, and Mr Thorley did not think there was any functus in the Office to say that his demand was not an application of rule 113(6).

On the first of these two arguments, while I accept that rule 113(6) is not restricted to partial inaccuracies and encompasses total inaccuracy, I cannot accept that a translation of the wrong document can be regarded simply as an inaccurate translation. It is not a translation of the international application at all, and in my view, for this reason alone rule 113(6) cannot be used to correct the error. A further point is that if it is correct that the international application must be taken to be withdrawn at the end of the prescribed period because no translation of the international application was filed by that date, then an attempt to revive the application by means of a general provision such as rule 113(6) would seem to be open to the same objection as correcting the error under section 117 and rule 91, for the reasons given in the judgment on Payne's Application referred to above. It also follows, that when the formalities officer telephoned the agent in September 1984, the application was already dead and he had no authority to act. Thus it seems to me that the question of functus does not arise.

I have reached a conclusion on this case after a great deal of thought, seeking to help the applicant, and I have reached it most reluctantly. Nevertheless, I have reached the firm conclusion that none of the means suggested by Mr Thorley can be employed to rectify the situation and the application must be taken to be withdrawn under section 89(3).

COUNSEL:

In the Patent Office, and in the Patents Court, Simon Thorley appeared for the applicant; Hugh Laddie appeared in the Patents Court for the Comptroller.

PANEL: Whitford J, Sharrock J

JUDGMENTBY-1: WHITFORD J

JUDGMENT-1:

WHITFORD J: The undisputed facts relevant to this appeal are set out in the decision of the superintending examiner. For the purposes of section 89 of the Patents Act 1977, in relation to this application the prescribed period had come to an end before a certified translation of the applicant's application had been filed. A certified copy was available to be filed together with the relevant certificate at the appropriate date. That a translation of the wrong document accompanied by the right certificate was filed was an error understandable enough in connection with a case involving these two Japanese language documents. The failure to meet the statutory requirement had the consequence that, pursuant to the terms of section 89(3), the application was taken to be withdrawn. The error was discovered not long after, and it could have been corrected without bringing about any difficulty within the Patent Office or any discernable detriment to the interests of any third party.

The question is whether it has been rightly held that the Comptroller has no power to correct an error of this kind. Everyone is agreed that, as a matter of discretion, provision should have been made for the correction of such an error as this, and indeed other failures to meet time limits involving a deemed withdrawal of an application; but in my view Mr Sharrock was right in reaching the conclusion that he did, after much thought and with a conscious desire to do anything that he could to help the applicant.

Mr Thorley put the applicant's case as persuasively as it should be put. He relied on section 117, which is in these terms, so far as is relevant:

"(1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application."

Rule 91 is concerned with machinery, and I need not recite it.

Mr Thorley rightly observed that I might find some difficulty in accepting his submission that section 117 offered an escape route, in the light of the judgment of Falconer J in Payne's Application [1985] RPC 193, which is referred to by Mr Sharrock in his decision. Although that was a section 15(5) case and not a section 89(3) case, I agree with Mr Sharrock that the same principles must apply. In my view, the decision of Falconer J in Payne's Application, following his earlier decision in Antiphon AB's Application [1984] RPC 1, was correct, and section 117 cannot come to the aid of this applicant.

A provision of rule 113 dealing with translations was also relied upon by Mr Thorley. Rule 113(6) which is dealing with translations, provides as follows:

"The comptroller may refuse to accept any translation which is in his opinion inaccurate and thereupon another translation of the document in question verified as aforesaid shall be furnished, together with the appropriate number of copies thereof."

Rule 113 likewise, in my judgment, cannot help the applicant. This is not a case of a refusal to accept an inaccurate translation, but a case of lodging an accurate translation of the wrong document. Mr Thorley argued very attractively that, when it was found that this was the wrong document, the refusal to accept it might well be treated as a refusal to accept an inaccurate translation.

Though a straining of language might offer a way in which it would be possible to reach a sensible solution, the House of Lords have offered a very clear warning against an approach of this character. In E's Applications [1983] RPC 231 Lord Diplock gave a warning which, although principally directed to the construction of rules 100 and 110, gives the clearest possible guidance in connection with what can be described as "strained constructions". It is illegitimate, whether under the disguise of some purported discretion or otherwise, to try to meet what is felt, however strongly, to be the justice of the case by giving a meaning to words which they are in truth wholly incapable of bearing.

Rule 100, the final avenue of escape put forward by Mr Thorley, is in these terms:

"100. Any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedures in or before the Patent Office may be rectified, on such terms as he may direct: Provided that, without prejudice to the comptroller's power to extend any times or periods under rule 110 below and except where such irregularity is attributable wholly or in part to an error, default or omission on the part of the Patent Office, the comptroller shall not direct that any period of time specified in the Act or the 1949 Act or prescribed in these Rules or the Patent Rules 1968, as they continue to apply shall be altered."

Rule 110 is of no use to the applicant in this case, and, there being no question of any error, default or omission, on the part of the Office, the decision of the House of Lords in E's Applications must be fatal to the applicant's submissions.

At page 250 of the report of E's Applications Lord Diplock says this:

"Failure to do an act within a prescribed limit, it was contended for the appellants, is an irregularity in procedure in or before the Office, which the Comptroller may rectify by deeming it to have been done before the inextensible time limit expired. I may add in parenthesis that resort to the concept of the Comptroller's 'deeming' something to have been done that had not in fact been done, as the means by which he was enabled to rectify this particular irregularity, was necessitated by the provision in section 89(3) that if the acts required by section 89(4)(a) were not done before the end of the prescribed period the application is to 'be taken to be withdrawn'.

"If this contention by the applicants were correct in all its nakedness, the distinction drawn by rule 110 between time limits that can and those which cannot be extended would have no effect at all. In an endeavour to avoid what was rightly felt might be a fatal flaw in the appellants' argument, it was suggested that a distinction could be drawn between a deliberate failure to observe an inextensible time limit and a failure that was the result of error, ignorance or inadvertence: the former it was conceded could not be treated as an irregularity but the latter it was contended could.

"My Lords, this in my opinion is a quite hopeless argument. An irregularity in procedure is simply a failure to observe procedural rules, whatever the cause of the failure may be. Where there is a discretion to rectify the failure, the reason for it may be of the utmost relevance to the way in which that discretion should be exercised; but if rule 100 confers upon the Comptroller jurisdiction to excuse failure to observe a time limit which is made inextensible by rule 110(1) and (2), on the ground that it is an irregularity in procedure, that jurisdiction must extend to all such failures whatever the reason for them may be, with the result of

rendering the express prohibition of extensions of specified time limits by rule 110(1) and (2) wholly nugatory. So to construe rule 100 in relation to rule 110 would be to turn on its head the well-established canon of construction *generalia specialibus non derogant*.

"It was, of course, the case that at the time this judgment was given the proviso to rule 100 had not been added; but this makes no difference in the particular circumstances of this case.

In this same speech at page 252, Lord Diplock says this:

"My Lords, *Fater SpA's Application*, involved an application for an extension of the time limit for doing the acts required by section 15(5). In an extempore judgment, Graham J justified his grant of an extension of time on the ground that despite the provision in the subsection that the application should be taken to be withdrawn if the conditions were not fulfilled (a provision which the learned judge in his judgment appears to have overlooked), there were still extant proceedings before the Office of which it retained seisin, and that the power to rectify irregularities in rule 100 overrode the prohibitions of extensions of time contained in rule 110. In this, for the reasons that I have given, he was, in my view, wrong as a matter of construction which is purely a question of law; but in the course of his judgment he used what can only have been an ill-considered turn of phrase in a passage justifying the conclusion to which he had come. '... the Patent Office', he said, 'is an Office for granting patents and not for refusing them and in a special case such as this, when there is a conflict between two rules, they should, since justice demands it, as a matter of discretion be read together in such a way as to aid grant rather than refusal'.

"Because of the phrase that I have italicised this passage in the judgment in *Fater SpA's Application* appears to have been understood in the Patent Office as meaning that for the purpose of proceedings in that Office, there is a discretion vested in the officer dealing with the matter to treat the same words appearing in the rules or even in the Act itself as bearing different meanings in different cases according to whatever meaning the officer dealing with the individual case thinks most appropriate to enable him to achieve what he regards as the just result in that particular case."

The dangers of making such an attempt must be apparent when it is considered that the result of this must necessarily be that there may in fact have been patents granted which ought never to have been granted. I have in other cases ventured to express the view that steps should be taken to widen the discretionary powers of the Comptroller in such cases as we are here concerned with.

In concluding his opinion, Lord Diplock says:

". . . no court of law has any discretion to vary the meaning of the words of primary or secondary legislation from case to case in order to meet what the tribunal or the court happens to think is the justice of the particular case. Tempting though it may sound, to do so is the negation of the rule of law. If there are cases in which the application of the Patents Rules leads to injustice, the cure is for the Secretary of State to amend the Rules. If what is thought to be the injustice results from the terms of the Act itself, the remedy is for Parliament to amend the Act".

I can only express once again the hope that a remedy may be provided to deal with situations which undoubtedly involve avoidable injustices; but, for the reasons which I have given, I think the decision the subject of appeal was correct.

The appeal must stand dismissed.

DISPOSITION:

Comptroller's costs. Leave to appeal to Court of Appeal.

SOLICITORS:

WP Thompson & Co; The Treasury Solicitor