

Abstract

Effect of not submitting a certified copy of a priority document within the prescribed time limit under PCT rules led to loss of priority right at the national level.

MATSUSHITA ELECTRIC WORKS LTD.'S APPLICATION

PATENT OFFICE

**HEARING-DATES:** 6 November 1981

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**INTRODUCTION:**

This was a decision of Mr. A. F. C. Miller, Superintending Examiner acting for the Comptroller, in application No. 8103327 of Matsushita Electric Works Ltd. which stemmed from international application No. PCT/JP80/00130 containing a declaration of priority from a Japanese application dated 15 June 1979.

**COUNSEL:**

Mr. R. E. Perry (patent agent) appeared for the applicants.

**PANEL:** MR. A. F. C. MILLER, Superintending Examiner

**JUDGMENTBY-1:** Mr. Miller

**JUDGMENT-1:**

Mr. Miller -- This application stems from an international application No. PCT/JP80/00130 filed under the provisions of the Patent Cooperation Treaty (PCT) on 13 June 1980. The international application contained a declaration of priority in respect of a Japanese application dated 15 June 1979 and designated the U.S.A., the Federal Republic of Germany, the U.K. and France as the states in which a patent was being sought. The Receiving Office was the Japanese Patent Office, which was also the International Searching Authority and an International Search Report was duly communicated to the applicants on 1 September 1980. On 22 October 1980 the International Bureau (IB) of WIPO informed the applicants that a certified copy of the priority document had not been submitted to it within the period prescribed by PCT rule 17.1(a), namely 16 months from the declared priority date. The international application was

subsequently published by the IB on 24 December 1980 and communicated to the designated States in accordance with PCT Article 20.

The documents and fee necessary to comply with the relevant conditions referred to in section 89(3) of the Patents Act 1977, and set out in section 89(4), were filed at the Patent Office on 4 February 1981. The application thus entered the so-called "national phase". At the time of filing those documents the applicants' agents, Messrs. Gill Jennings and Every, asked, in a letter dated 4 February 1981, in what circumstances the Office would permit retention of the declaration of priority if there had been a failure to comply with PCT rule 17.1(a). In an official letter dated 6 May 1981 the view was expressed that neither the Patents Act 1977 nor the Patents Rules 1978 (as amended) contain any provision permitting "retention of the declaration of priority on any application which has failed to comply with the period prescribed under the provisions of the relevant legislation in that regard", and it was proposed to cancel the declaration of priority. Further correspondence having failed to resolve the issue, a hearing was requested and the matter came before me on 24 September 1981.

Section 89 of the Patents Act 1977 deals with the effect of filing an international application for a patent. Section 89(1)(c) states:

"(1) Subject to the provisions of this Act, an international application for a patent (U.K.) for which a date of filing has been accorded (whether by the Patent Office or by any other body) under the Patent Cooperation Treaty (in this section referred to as the 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 –

(c) any declaration of priority made under the Treaty shall be so treated as a declaration made under section 5(2) above;" and section 89(3) states: { 107 }

"(3) 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."

Section 89(4) then sets out the relevant conditions with which, as stated above, the applicants have complied. It seems to me that the effect of section 89(1)(c) and (3) as applied to the present application is that the declaration of priority made under the PCT is to be treated as a declaration made under section 5(2) of the 1977 Act, but that the allowability of the declaration is, by virtue of section

89(3), governed by the provisions of that act (and the rules made under it) and not those of the PCT.

Mr. Perry referred to PCT rule 17.1(c) which states:

"(c) If the requirements of neither of the two preceding paragraphs are complied with, any designated State may disregard the priority claim."

The rule, he submitted, clearly gives a designated State power to disregard a priority claim but does not oblige it to do so. I accept that this is so but, as I have already indicated, in the case of the U.K., resolution of the question depends entirely, by virtue of section 89, upon the provisions of the 1977 Act and the Patents Rules 1978. Rule 6 deals with declarations of priority under Section 5 of the Act and with declarations which are treated as having been made under Section 5 by virtue of section 89(1)(c). Rule 6(2) requires a copy of the priority document to be filed within 16 months after the declared priority date. This sub-rule is, however, subject to rule 6(5) which deals specifically with the case of international applications and states:

"(5) Where the application in suit is an international application for a patent (U.K.) which is to be treated as an application for a patent under the Act, the requirements of sub-rules (1) and (2) above shall be treated as having been complied with to the extent that the requirements of rules 4.10(a) and (c) and 17.1(a) of the Regulations made under the Patent Cooperation Treaty have been fulfilled."

Mr. Perry argued that rule 6(5) merely stated what was to happen if the requirements of PCT rules 4.10(a) and (c) and 17.1(a) were complied with. It did not specify what was to happen in the event that the PCT Rules referred to were not complied with. He further submitted that rule 6(5) had to be considered quite separately from rule 6(2) because if an international application enters the "national phase" more than 16 months from the declared priority date it would be impossible to comply with rule 6(2). Therefore, he argued, because rule 6(2) is inapplicable to international applications and rule 6(5) does not apply in the present circumstances, the Office is not obliged to disregard the priority and in view of the permissive nature of PCT rule 17.1(c) should not do so.

I cannot accept this argument. Rule 6(5) cannot, it seems to me, be regarded as entirely separate and distinct from rule 6(2). It constitutes a derogation, albeit a necessary derogation, from rule 6(2) as is, I think, clear from the words "Subject to the provisions of... sub-rules (3), (4) and (5) below..." in rule 6(2). What { 108 } sub-rule (5) does is to absolve applicants under the PCT who have complied in time with the requirements of certain PCT Rules from the

requirements of rule 6(2), and it would be wrong, in my view, to place a PCT applicant who has not complied with those rules in a more advantageous position. If a PCT applicant has failed to comply with rule 6(5) and has not met the requirements of rule 6(2) he must, I think, lose his priority date in the U.K. I therefore direct that the declaration of priority in respect of this application be cancelled.

**DISPOSITION:**

Judgment accordingly.

**SOLICITORS:**

Gill Jennings & Every (patent agents).