

Abstract

Propriety of the translation of a PCT application and the communication to designated Offices under PCT Article 20 and Rule 47. PCT application was deemed withdrawn for failure to file translation within the prescribed time limit.

MITSUBISHI JIDOSHA KOGYO KK's APPLICATION PATENT

OFFICE CHANCERY DIVISION (PATENTS COURT)

HEARING-DATES: 29 July 1987, 18 February, 5 May 1988

5 May 1988

INTRODUCTION:

This was an appeal to the Patents Court by Mitsubishi Jidosha Kogyo KK from a decision dated 29th July 1987 by Mr BG Harden, principal examiner acting for the Comptroller, that application 8624689 must be taken to be withdrawn under section 89(3) of the Patents Act 1977.

Mr BG Harden:

International application No PCT/JP86/0072 in the name of Mitsibushi Jidosha Kogyo KK was filed under the provisions of the Patent Co-operation Treaty (PCT) on 17 February 1986 at the Japanese Patent Office acting as the receiving Office. The application claimed priority from various Japanese applications, the earliest ones having a filing date of 16 February 1985. The international application designated Germany, the United Kingdom, and the USA as countries in which patents were sought. The application proceeded through preliminary examination and search under the Treaty and was published by the International Bureau (IB) in the Japanese language on 28 August 1986 under the number 86/04866. 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 IB.

Rule 85(1)(a) of the Patents Rules 1982 prescribes a period of 20 months from the earliest priority date to satisfy the relevant conditions of section 89(4) and to prevent the application being taken as withdrawn under section 89(3). This period thus expired on 16 October 1986. For this application the relevant conditions included the filing of the relevant fee and translation of the international application. On 15 October there was filed at the Patent Office the

relevant fee prescribed under section 89(4), and also Patents Forms 9/77 and 10/77, a form NP1, an amended figure and an accompanying letter.

There were subsequently filed on 14 November 1986 translations of the international application and also of the priority documents. After consideration of the matter within the office a letter was issued on 11 December 1986 stating that the translation of the international application was filed outside the period prescribed under rule 85(1) and that since no Patents Form No 50/77 requesting a one month extension of the period had been filed before the end of the one month extension possible under rule 110(3) the application has been taken as withdrawn under section 89(3).

The reason why no Form 50/77 had been filed was that in the firm of patent agents handling the application the particular personnel responsible for the application were under the wrong impression that the 21 months period for filing the translations of the priority documents also applied to the translation of the international application.

After further communications between the Office and the agents for the applicants the matter came before me for a hearing on 25 March 1987.

Shortly after the start of the hearing it was adjourned at the request of Mr Thorley to enable a statutory declaration to be made by Mr E Smith an executive officer in the Office and for evidence in reply to be furnished by the patent agents instructing Mr Thorley.

In his statutory declaration Mr Smith stated that he has been the executive officer in charge of the international unit since July 1986 and that when an administrative assistant who was inserting into a file documents relating to this application noticed the apparent absence of the translation of the international application the file was referred up to him. Mr Smith explained in his declaration that he decided to telephone the agents' office to inform them that the translation was missing and that it was possible to have the period extended. Attached to the declaration is an exhibit of a copy of an internal file minute dated 21 October 1986 and recording that he telephoned the agent who was aware of the circumstances and indicated he would file the translation with Patents Form 50/77 by 16 November 1986. In his declaration Mr Smith commented that he would not have made the minute unless he had made the telephone call but that he could not now remember the words he had used. He added that he had asked the telephonist at the agents to speak to the person identified by the reference given in the agents' filing letter, and that the person appeared to understand exactly what he was talking about and conveyed so confident an impression that Mr Smith decided that the issue to the agent of a

written report of the conversation was unnecessary. Mr Smith also explained why on 17 December 1986 when a representative of the agents came to the Office to inspect the internal file minute he had stated that the person he had spoken to on the telephone was Mr Cross. He had been led to this conclusion because he had assumed the telephonist at the agents' office had put him through to the person identified by the reference. Mr Smith finished his declaration by stating that he could have been mistaken and that the person to whom he had spoken could have been another partner or employee of the agents.

Immediately prior to the hearing on 25 March 1987 declarations had been filed by Mr Cross the partner in the firm of patent agents responsible for this case and by the technical assistant working on it. In the declarations they stated that they had no recollection or record of this telephone call from Mr Smith. In a further declaration dated 28 May 1987 Mr Cross declared that he had asked each of the partners and technical assistants in the firm whether they had received the telephone call from Mr Smith on or about the 21 October 1986 and that each person had replied they had no recollection or record of it.

The hearing resumed on 18 June 1987. Mr Thorley started by cross-examining Mr Smith and asking him whether the phrase entering the national phase was synonymous with satisfying the relevant conditions of section 89(4). Mr Smith agreed that it was. Mr Thorley then moved on to the receipt form P Ack 4. This form is used as a receipt, usually when a new application is filed, and gives the application number and filing date accorded to it. The documents forming part of or received with the application are indicated on the form. Mr Smith agreed with Mr Thorley's suggestions that the P Ack 4 was not wholly appropriate to record the filing of documents filed when an international application entered the national phase, and that the form recorded the application as 'entering the national phase'. Mr Smith however declined to comment on Mr Thorley's further suggestion that it was reasonable for an agent to conclude that an application had entered the national phase if a P Ack 4 was issued.

In response to a query about how unusual it was for a translation of an international application not to have been filed with the fee under section 89(4) Mr Smith answered that it had occurred only on one other occasion since he had been taken over the international unit but that he had been told it had occurred once or twice before then. I will return to this other occasion after dealing with Mr Thorley's cross-examination of the telephone conversation detailed in Mr Smith's declaration. Mr Thorley after taking Mr Smith through his conversation with the agents' telephonist asked him whether he had ascertained the name of the person to whom he had spoken. Mr Smith thought he had ascertained it but that he does now not believe it was Mr Cross or Mr Langley the technical assistant involved. I asked him about this departure from what he had said in his

declaration. He answered that he had since had time to think and that he now believed it was not Mr Cross.

Mr Thorley then turned to the other occasion Mr Smith dealt with the absence of a translation of an international application. By coincidence the same Japanese applicants and the same firm of patent agents were involved. On this occasion at the start of December 1986 Mr Smith telephoned the partner involved, a Mr Horton, told him about the need to file the translation, and subsequently issued a 'telecon' sheet recording the contents of the conversation. Mr Thorley asked Mr Smith why he had issued the 'telecon' sheet. He answered that he had done so after discussions with the formalities section in the Office.

When Mr Thorley addressed me he informed me that he was not seeking an extension under rule 110 although he was reserving his position on two possible arguments on rule 110 in case this matter went further. One argument was that it was not necessary for the actual request on Patents Form No 50/77, for the one month's extension under paragraph (3) of the rule, to be filed within the one month. In Aisin Seiki KK's Application [1984] RPC 191, the Patents Court upheld the hearing officer's decision that an extension under paragraph (3) was only possible if the request had been made within the one month. The other argument, if I understood Mr Thorley correctly, was that the period for filing the Form 50/77 could be extended under paragraph (1) of the rule. A similar argument was raised in Nippon Gaishi KK's Application [1983] RPC 388, with respect to an extension of the period for filing the request for substantive examination, and was turned down by the Patent Court.

The relevant section of the Act is section 89(1), (3) and (4) and the rule on which Mr Thorley relied is rule 100. The Patents (Amendment) Rules 1987 brought into force on 24 March 1987 a substituted version of rule 100. Mr Thorley submitted that the previous version current in 1986 was the version which should be considered. I referred him to Daido Kogyo KK's Patent [1984] RPC 97, in which arose a similar question of which version of rule 100 should be considered. The hearing officer had taken the version current at the time the alleged irregularity of procedure had occurred. Before the Patents Court it was common ground between counsel for the patentees and counsel for the Comptroller that the version current at the time of the hearing was the appropriate version, this version having the proviso relating to the possibility of an extension of a prescribed period if there was an error, default or omission on the part of the Patent Office. Both the Patents Court and the Court of Appeal did not demur from this common ground and based their judgments on the later version containing the proviso. I will accordingly consider the version current at the date of the hearing. I commented to Mr Thorley that anyway it did not seem to matter greatly which version was the appropriate one since their provisions do

not appear to differ, the new version having apparently been substituted merely to meet judicial comment on the clarity of the previous wording. Mr Thorley replied he would reserve his position on which was the appropriate version.

The relevant parts of sub-sections (1), (3) and (4) of section 89 are as follows:

89. -- (1) Subject to the provisions of this Act, an international application for a patent (UK) for which a date of filing has been accorded (whether by the Patent Office or by any other body) under the Patent Co-operation 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 date of filing and . . .

(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.

(4) 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 have been filed at the Patent Office and the filing fee has been paid to the Patent Office by the applicant; and

(b) in the case of an amendment, are that a copy of the amendment and, if it is not in English, a translation into English have been filed at the Patent Office.

Rule 100 as substituted by the Patents (Amendment) Rules 1987 reads:

" 100. -- (1) Subject to paragraph (2) below, 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.

(2) Where the irregularity in procedure consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968, as they continue to apply, the comptroller may direct that the time or period in question shall be altered if the irregularity is attributable wholly or in part to an error, default or omission on the part of the Patent Office, but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 100 below.

" In the resumed hearing Mr Thorley submitted that there was an irregularity of procedure in failing to file the request for the one month's extension on Form 50/77 with the translation of the international application and that this irregularity was attributable in part to an error, default or omission on the part of the Patent Office. He submitted that the Office erred on two grounds. Before considering these grounds I should mention that Mr Thorley indicated that he did not seek to elevate Mr Smith's attempt to help the agents into a sort of obligation that patent agents have come to rely upon for the purposes of the Mills case, [1985] RPC 339. I agree with Mr Thorley on this. Following the Court of Appeal judgment in Mills there are a number of non-statutory obligations at the office which if the office omits to carry out amounts to an omission within the meaning of rule 100. However Mr Smith's attempt to be of assistance was not one of those non-statutory practices which the Office has promised to carry out, which is well recognised, and on which the patent profession can rely, and this does not amount to an obligation within the Mills sense.

The first ground which Mr Thorley submitted was that the Office should not have acted and either accepted the money or issued the receipt P Ack 4 when the fee was paid. This ground if I understood Mr Thorley correctly is based on the provision of subsection (3) of section 89 that until all the relevant conditions are satisfied -- including this case the filing of the translation of the international application -- the provisions of the Treaty and not those of the Act shall apply. The Patent Office should either have done nothing or else it should have contacted the agents. Since the records department of the agents check the receipt of the P Ack 4s a failure to have received one would have prompted the agents to have contacted the Office and, it was submitted, the need for a Form 50/77 would then have become apparent. If the Office had contacted the agents, it was alternatively submitted, the need for a Form 50/77 would again have come out in the wash.

I do not accept the proposition that the Office was wrong or powerless in acting before all the relevant conditions of section 89(4) were met. The Office acted in no way contrary to section 89(3) which provides that the provisions of the Treaty and not those of the Act relating to publication, search, examination and amendment shall apply until all the relevant conditions are met. The acknowledgement of which documents have been filed is sound administrative practice. Moreover, section 89(1) provides that an international application (UK) shall be treated as an application under the Act and it is, in my view, entirely

proper for the Office to process any documents filed on such an application subject of course to the provisions of section 89(3).

Mr WG Sceats, who attended the hearing on behalf of the Patent Office, explained the processing steps the application went through when the fee prescribed under section 89(4) and the other documents were filed. After the cashier had received the money the documents passed to the international unit where the documents received -- in this case the form NP1 accompanying the section 89(4) fee, a sheet of drawings in duplicate and Patents Forms No 9/77 and 10/77 -- were receipted using the form P Ack 4 which also gave the application number accorded to the application by this Office. After the preparation of Office records and the stamping of a file for the documents, the documents filed by the agents together with those received from the International Bureau, including a copy of the published application and of the priority documents, were assembled in the file. It was at this stage that the absence of the translation of the application was noticed and was drawn to Mr Smith's attention as mentioned above. All this occurred before the stage of preliminary examination during which the application is checked to determine whether the formal requirements of the Act are met. None of this processing prior to preliminary examination is, I consider, contrary to the Act on what, as I have just mentioned in the preceding paragraph, is an application under the Act. As regards the acceptance of fees before the conditions of section 89(4) are satisfied, I do not regard this in any way contrary to section 89(3). It is just an advance payment of fees.

If I am wrong on this finding the consequential question of whether this action by the Office contributed to the failure to file the Form 50/77 arises. I find this question difficult to answer in the applicant's favour. The supposition is that the Office should have done nothing because of the absence of the translation. I accept, on the evidence of Mr Middleton of the firm's records department, that the records department would have checked the absence of the receipt with the partner or technical assistant concerned. But if this supposition were correct the agent Mr Cross or his assistant, since both were fully aware of the absence of the translation, would not have expected a receipt and no contact would therefore have been made with the Office.

There is also evidence from a Mr Bayliss, another partner in the firm of agents, that had he seen their file he would have realised the need for a Form 50/77. That I accept because of his familiarity with proceedings relating to international applications. However had a receipt not been sent the matter, according to the evidence of Mr Middleton, would have been referred to the agent responsible for the case and not to Mr Bayliss. Mr Bayliss declares that he is confident that the absence of a receipt would have been made known to him and/or Mr Cross, the

partners responsible for their records department. I do not find it established having regard to Mr Middleton's evidence and the fact that Mr Cross was the partner responsible for this case that in the hypothetical situation propounded by Mr Thorley the absence of a receipt that the Office would have telephoned the agents to tell them why a receipt was not being issued. If the previous supposition was correct it seems that the Office should not even have telephoned. If the Office had telephoned according to this hypothetical scenario it is not certain that the agents would have acted on the need for a Form 50/77. In fact there is the evidence of Mr Smith's declaration and cross-examination and of the internal minute that he did telephone the agents and that the person to whom he spoke understood what he was talking about, yet no Form 50/77 was filed. I accept that there is a mystery as to whom Mr Smith spoke but that does not outweigh the contemporary evidence of the internal minute reporting the telephone call or of Mr Smith's clear recollection, in his declaration, of the details of the call.

Before leaving the first ground I should mention that Mr Thorley himself raised a not dissimilar argument in Masuda's Application [1987] RPC 37. In that case, instead of a translation of the international application which was in Japanese, a translation of the priority document had by mistake been filed. This was not discovered until after the period prescribed for filing the translation of the international application had expired. Various arguments were put forward in an attempt to resuscitate the application. One of the arguments was the invoking of rule 100 on the ground that until the relevant conditions had been complied with the Office had no power to proceed at all. This argument did not gain the support of the hearing officer and Whitford J in turning the appeal down in the Patents Court did not explicitly refer to it. When I referred Mr Thorley to this prior case he drew the distinction from it that in Masuda a purported translation had been filed. He contended that the Office was powerless to act until the purported documents are filed. I am not satisfied that this is a real distinction. If the Office is powerless to act in any way until all the relevant conditions are met -- and as explained above I do not accept this -- then it seems to me the Office is at fault in acting where a document required is not actually filed irrespective of whether it has been purportedly filed or not.

Turning now to Mr Thorley's second ground he submitted that the Pack 4 was an inappropriate receipt to use on this case and that therefore the Office erred in issuing it. The receipt stated that 'the documents listed have been received and recorded as an application for a patent made under the provisions of the Patents Act 1977'. The documents listed as having been filed were Forms 9/77, 10/77 and NP1 and drawings (1 + 1). The receipt also gave an application number and stated that the documents had been so numbered and that the number should be used on all correspondence covering the application which had been accorded

the filing date of 17 February 1986. This date it should be mentioned is not the date when the listed documents were filed but the filing date accorded to the international application when it was filed at the Japanese receiving Office about eight months earlier. Mr Thorley drew attention to the wording "recorded as an application". He drew an analogy with when the receipt is used to record the filing of a national application under section 15(1) and argued that the use of the receipt for an international application indicates that the requirements of section 89(4) have been met.

While I accept that the use of this receipt with its present wording may not be entirely appropriate for use on an international application I do not accept the conclusion which Mr Thorley attempted to draw from this for essentially two reasons. First, while on a national application the issue of P Ack 4 normally indicates that an application has been initiated, and that the application has the specified filing date, these are only tentative indications which may be found to be wrong once the application is examined. The receipt is issued by records staff whose job does not include examination of the application. Thus deficiencies may subsequently be found in the documents. For example a drawing referred to in the description may have been omitted so that under the provisions of section 15(2) or (3) a late filed drawing may be incorporated in the application with a consequential re-dating of the application. In the case of an application filed under section 15(4) requesting the date of filing of an earlier application, the filing date given on P Ack 4 is the date of filing of the earlier application. However it does not infrequently occur that an application purportedly filed under section 15(4) is not entitled to the earlier date because the later application contravenes section 76. The earlier date tentatively recorded on P Ack 4 is then not allowed and the application is only entitled to its actual filing date.

Secondly 'recorded as an application' to my way of thinking does not clearly indicate that the relevant conditions of section 89(4) are met or are tentatively met. The satisfying of the conditions of section 89(4) is one of many stages an international application must undergo between its filing and the grant of a patent. It seems to me that the wording 'recorded as an application' only necessarily indicates that the Office has made a record of the application. In the case of an international application which designates the UK the application is one under the Act from the date of its international filing but the Office does not create a file for it and accord it an application number until the payment of the section 89(4) fee. Mr Smith however when asked the leading question by Mr Thorley whether 'recorded as an application' meant to him satisfying the relevant conditions replied 'Yes'. The crucial point of course, is not what the P Ack 4 means to an official of the Patent Office whose duties do not cover determining whether the relevant conditions are met but what the receipt means to a recipient. When asked whether it was reasonable for an agent to conclude from

the receipt that the application has been recorded as satisfying the relevant conditions Mr Smith did not comment.

Turning now to the evidence filed on behalf of the applicants, Mr Cross, the patent agent responsible for this application, states in paragraph 6 of his second declaration dated 28 May 1987 that he was expecting a receipt for patent application to be issued by the Patent Office in the normal way and that he would therefore have been surprised at the absence of a receipt. I take this to mean that he expected P Ack 4 to be issued in the normal way. In his first declaration he had explained that he was fully aware of the need to file the translation of the international application. His technical assistant in his declaration stated that he had been instructed by Mr Cross to make sure that their record system was properly primed to produce reminders about the translation which was awaited from Japan. It is clear from his declaration that the technical assistant knew that the provision of the translation was one of the relevant conditions to be satisfied. I therefore find on this evidence that Mr Cross was not misled by the issue of P Ack 4 before the translation of the international application was filed bearing in mind that he knew the translation was outstanding.

A differing view about the issue of the receipt is put forward in his declaration by Mr Bayliss who shares with Mr Cross responsibility for the record department of their firm of patent agents. When Mr Bayliss inspected his firm's file of the case after the mishap had occurred and just prior to a conference with counsel he was surprised that the Office had issued the normal form of filing receipt because it indicated to him that the documents had been examined and the documents found to be present in the papers were recorded on the receipt. He then referred to his understanding of section 89(3) that the provisions of the Treaty and not those of the Act should apply until all the relevant conditions had been satisfied. It is not clear to me why the receipt indicated to Mr Bayliss that the documents had been examined. I referred above to Mr Sceats' explanation that the receipt was issued before any formal examination of the documents had been made. This practice of issuing receipts before examination of the documents is a standard practice of this Office which should be well known to all patent agents. I have also found above that the issue of the receipt was not contrary to section 89(3).

I have therefore found that Mr Thorley has not established to my satisfaction his second ground that the Office had erred. The question again arises however whether, if I am wrong on this finding, the alleged error contributed to the failure to file the Form 50/77 in time. The alleged error consisted of a wrongly worded receipt. There is no evidence before me that if a differently worded receipt was issued this would have prompted the filing of a Form 50/77. There is

evidence, as I have indicated above, that the agents' record department checked the existence of a receipt but if a receipt was issued the department would presumably have been satisfied. The receipt would not have mentioned the need for a Form 50/77 since it is not the duty of the staff preparing receipts to determine outstanding requirements or the expiry of time limits.

Since I have found, regretfully, that the circumstances of this case do not fall within the ambit of rule 100 there is no need for me to decide whether had I found otherwise the Comptroller's discretion should be exercised and an extension of the period for satisfying the relevant conditions should be granted. But since I was addressed on the matter I feel I should give an opinion on this point. Mr Bayliss in his declaration explained how when the Patents Act 1977 came into force he had set up a new records system and had given guidance to other professional members of his firm on the new procedures. He also exhibited a special note he had prepared giving the complex details about the relevant conditions prescribed in section 89(4). Use of this note was stopped when the Patent Rules were amended in 1985 after modification of the Patent Cooperation Treaty. The Patent Office at the time introduced an unofficial form NP1 to be used when the section 89(4) fee was paid. The back of the form contains a detailed check list of the requirements. Mr Bayliss instructed his records department to supply a copy of this form instead of his special note, now out of date, on each international application being handled. Failure to follow the advice on the special note on the information and warning on the back of NP1 resulted in the error being made. This seems to be an isolated error by a firm of patent agents who, from the evidence provided, have made great efforts to avoid such errors arising. I note from the declaration of Mr Horton, the partner responsible for the other case where the translation of the international application was not filed with the section 89(4) fee, that he was aware of the need to file Patents Form No 50/77 when the translation was later filed in the 21st month. (Incidentally he seemed from his declaration to be surprised that Mr Smith from the Office had telephoned him to remind him of the need for a Form 50/77.) Since this was an isolated error on the part of a well run firm of patent agents and the translation was filed within the period extendible under rule 110(3) I would have exercised discretion to extend the period for filing the Form 50/77 had I found rule 100 to be applicable.

Since I have found that no extension of the period for satisfying the relevant conditions of section 89(4) is possible, this application must be taken as withdrawn under section 89(3).

These being procedural matters, in accordance with RSC Order 104 rule 19(2)(a), any appeal must be lodged within 14 days after the date of this decision.

(Judgment on the rule 110(1) point was given on 18 February 1988.)

COUNSEL:

In the Patent Office and Patents Court S Thorley for the Applicants; N Pumfrey for the Comptroller

PANEL: FALCONER J, BG HARDEN

JUDGMENTBY-1: FALCONER J

JUDGMENT-1:

FALCONER J: This is an appeal from a decision dated 29 July 1987 of the principal examiner, Mr BG Harden, acting for the Comptroller, whereby he held that patent application No 8624689 in the name of Mitsubishi Jidosha Kogyo KK must be taken as withdrawn under section 89(3) of the Patents Act 1977.

The application arises from an international application filed in Japan on 17 February 1986 under the provisions of the Patent Co-operation Treaty (PCT), the United Kingdom being one of the designated countries. The international application proceeded through preliminary examination and search and was published by the International Bureau (IB) in the Japanese language on 28 August 1986. In accordance with PCT article 20 and rule 47 on the same date a copy of the international application as published was sent by the IB to the United Kingdom Patent Office as one of the designated Offices.

The statutory provisions governing the processing of international applications in the UK are contained in section 89 of the Patents Act 1977. For present purposes the relevant provisions are section 89(3) and (4).

Section 89(3) (omitting wording not material for present purposes) provides:

". . . 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) provides:

"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 have been filed at the Patent Office and the filing fee has been paid to the Patent Office by the applicant". (b) is not material for present purposes.

Rule 85(1)(a) of the Patents Rules 1982 prescribes a period of 20 months from the earliest priority date to satisfy the conditions of section 89(4) and to prevent the application being taken to be withdrawn under section 89(3). The application claimed priority from various Japanese applications the earliest ones having a filing date of 16 February 1985. The prescribed period under rule 85(1)(a), therefore, expired on 16 October 1986. As the application as published by the IB was in the Japanese language, the relevant conditions which had to be complied with by 16 October 1986 included filing a translation of the Japanese application and paying the relevant fee. Although on 15 October 1986 the relevant fee was paid and certain documents including Forms 9/77 and 10/77 (requests for preliminary and substantive examination) not material for present purposes were filed, no translation of the international application was then filed. Subsequently on 14 November 1986 translations of the international application and also of the priority documents were filed. Of course, the translation of the international application was out of time -- but that prescribed time of 20 months could have been extended by one month under rule 110(3) had Patents Form 50/77 been filed requesting such extension. The Patent Office, after considering the matter, issued a letter on 11 December 1986 stating that the translation of the international application had been filed outside the prescribed period and, as no Form 50/77 had been filed before the one month extension possible under rule 100(3), the application had been taken as withdrawn under section 89(3). The hearing officer explains in his decision the reason for non-filing of Form 50/77 succinctly as follows:

"The reason why no Form 50/77 had been filed was that in the firm of patent agents handling the application the particular personnel responsible for the application were under the wrong impression that the 21 months period for filing the translations of the priority documents also applied to the translations of the international application."

Following further communications between the Office and the applicants' agents the matter came on for a hearing before the principal examiner on 25 March 1987 -- it was adjourned to allow evidence by statutory declaration by the appropriate executive officer of the Office and in reply from the agents. The hearing resumed on 18 June 1987. At the resumed hearing Mr Thorley for the applicants reserved his position on possible arguments based on rule 110, not open to him before the Comptroller in view of decisions of the Patents Court, and the hearing continued on his submissions based on rule 100. Before me it was agreed that I should hear his appeal based on rule 110, his appeal so far as based on rule 100, which would involve consideration of the evidence, being held over until judgment on his rule 110 arguments, since if he should succeed on his rule 110 arguments it would not be necessary to consider his case based on rule 100.

Rule 110 of the Patents Rules 1982 was amended with effect from 24 March 1987 under the provisions of the Patents (Amendment) Rules 1987. Rule 110, in its unamended form as it was at the material times was as follows:

"(1) The times or periods prescribed by these Rules for doing any act or taking any proceeding thereunder, other than times or periods prescribed in the rules specified in sub-rule (2) below and subject to sub-rule (3) below may be extended by the Comptroller if he thinks fit, upon such notice to the parties and upon such terms, as he may direct, and such extension may be granted although the time or period for doing such act or taking such proceeding has already expired".

"(2) The rules referred to in paragraph(1)",

and they are set out I do not think I need go through them because we then come on to sub-rule (3), which is the relevant one for present purposes. Sub-rule (3) says "The periods prescribed in rules", and then they are set out and they include rule 85(1)(a) and (b), and rule 85(1)(a) is the relevant one. The paragraph goes on: "may be extended for not more than one month upon filing Patents Form No 50/77". I draw attention to the word "may", so that it was discretionary.

In the present case the 20 months period under rule 85(1)(a) could have been extended to 21 months by virtue of the provisions of rule 110(3). As Mr Thorley pointed out all the documents necessary to comply with section 89(4) were on file at the Patent Office within the extended 21 months period except that Form 50/77 had not been filed or the fee paid. The Office, therefore, had within the extended 21 months period, so he submitted, all documents the Office needed to assess priority and inventiveness. He submitted that section 89(3) links the application being "taken to be withdrawn" to the timely filing of the translation of the international application but that rule 110(3) provides, as a matter of procedure, for the filing of Form 50/77. He explained that, at the hearing before the principle examiner he had been constrained to concede that, in view of authorities, his argument based on rule 110 was not open to him before the principal examiner.

In *Aisin Seiki KK's Application* [1984] RPC 191, Whitford J had to deal with a similar case involving the late filing, but within the possible one month extension of the period, possible under the provisions of rule 110(3), of the translation of the priority document of the international application (as required under rule 6(6)), although the necessary Form 50/77 required by rule 110(3) to obtain that extension had not been filed until after the expiry of the extended period. Whitford J on appeal, upheld the decision of the superintending examiner that rule 100(3) required that Form 50/77 must be filed within the one

month period mentioned in that rule and that the declaration of priority be cancelled and the application proceed with its own date of filing. Looking at that authority, in the decision of the hearing officer there is just a passage on page 193 to which I would refer in order to see an argument that was put before him. I pick it up in the middle of the first paragraph, at line 16, where referring to counsel, Miss Boone, who had appeared before him he said: "She then went on to say that although sub-rule (3)" -- that is of rule 110 –

"thus had the effect of limiting the maximum period of the extension in certain cases and of specifying the method by which the request for extension must be made, it did not expressly say when the request must be filed. In accordance with the general rules of construction of statutes words may not be implied into a statutory instrument unless they are necessary to make sense of it or it is clear that they were intended. It was therefore, she said, a wrong construction of sub-rule (3) to read into the end of it words to the effect of and such form must be filed within that month'. Provided that the requirements of rule 6(6) had been complied with before the end of the extended period, the Form 50/77 could be filed after the expiry of the month extension thus securing that extension retrospectively at the Comptroller's discretion, in accordance with the last phase of sub-rule (1) which is not over-ridden by, or inconsistent with, sub-rule (3)".

He then went on to say that he did not accept that submission.

In the penultimate and last paragraph of the hearing officer's decision, he says:

"Finally, considering only rule 110(3) and in connection with a comment made by Miss Boone that the question of deemed withdrawal, and if so when, does not arise in this case, I would observe that whilst that is, of course, true in the present case in relation to noncompliance with rule 6(6) so that it is not necessary to consider whether there is still an application in being upon which relief could be granted if available, it is not so in relation to non-compliance with several other rules mentioned in rule 110(3), eg rule 25(2), 33 or 34. It would be wrong, in my opinion, to place a construction on sub-rule (3) which would effectively preclude any extension in the case of failure to perform an act resulting in deemed withdrawal (because there was no longer any application to operate upon), but allow such an extension in the case of failure to perform an act not resulting in withdrawal (because the application was still extant). It seems to me that the consequences of a failure to perform an act within due time must ensue in like manner in all cases irrespective of whether those consequences are deemed withdrawal or some lesser penalty.

"In the result, therefore, having concluded that rule 110(3) requires that Form 50/77 must be filed within the one month period mentioned in that sub-rule and

that there is no discretion under rule 110(1) to extend that period, I direct that the declaration of priority in respect of this application be cancelled and the application proceed with its own date of filing".

I read that because it is very close to an argument put before me.

Coming to the judgment at page 1986, line 51, he said:

"Rule 110 gives a very general discretion in respect of extensions of times to the Comptroller save for the times or periods prescribed in the rules specified in sub-rule (2). Among the provisions with which I am concerned of particular relevance is the provision which, to some extent, modifies the absolute prohibitions which are to be derived from a reading of sub-rules (1) and (3)"

I think that should be sub-rules (1) and (2)

"because by sub-rule (3) of rule 110 we are told that the periods prescribed by rule 6, sub-rules (2) and (6) (I need go no further, though some other rules are referred to) may be extended for not more than one month upon filing Patents Form No 50/77.

"Mr Chappel's argument ran this way: 'Well, we did furnish a translation within one month. True we did not put in Form 50/77 or pay the fee at that time. It was an oversight -- which everybody accepts -- but we have done it subsequently and if you look at the word 'upon' that is a word of relatively broad import and there is nothing in this rule which says that the form and the fee have themselves got to be lodged within one month".

"Although one can see some sort of emotional advantage possibly deriving from the fact that the translation was furnished, albeit without the form or the fee, within one month of the expiry of the prescribed date, it does not seem to me that this fact has any relevance whatsoever. In the end, what the argument amounts to is that the provision of sub-rule (3) of rule 110 is such that whenever you file Patents Form No 50/77, provided you do it accompanied by the fee, you are going to be entitled to a further extension of one month; and that cannot be the case.

"In my view the simple answer to this case is to look at what happened. The relevant period expired without the translation having been furnished. Could the position be saved? Go to rule 110, which is saying in plain terms you can get a one month extension but you can only do that if you file Form 50/77. To read that rule as indicating that it does not matter whether Form 50/77 is filed within

one month, and that indeed it does not really apparently very much matter when it is filed, appears to me to make an absolute nonsense of these rules".

In conclusion, he goes on to say: "This is a plain case. Mr Miller (ie the hearing officer) was right. The appeal must be dismissed".

That seems to me to be a clear authority that to obtain under the provision of rule 110(3) an extension of one month of the time prescribed under any of the rules specified in rule 110(3), Form 50/77 must itself be filed within that one month period and that it is not sufficient that the necessary translation (under rule 6(6) in that case and under section 89(4) in this case) be filed in that one month extension period if Form 50/77 is not also filed within the month; that case seems to me to be decisive of the present case except in so far as Mr Thorley may be able to pray in aid the provisions of rule 100 on his second argument.

The Aisin Seiki case was decided on rule 110 as it then was. By the Patents (Amendment) Rules 1987 paragraph (2) and (3) of rule 110 were amended and new paragraphs (3A), (3B) and (3C) were added to read as follows:

"(2) The rules referred to in paragraph (1) above are rules 6(1), 17(3), 26 (so far as it relates to rule 6(1), 39(1) and (2), 40(2), 43(2), 60(2), 65(1), 66(1), 71(1), 78(1), 81(1), 82(1) and 91(4))."

Paragraph (3) was changed to read: "A time or period prescribed in rules" -- they are set out and they still include rule 85(1) -- "shall, if not previously extended, be extended for one month upon filing Patents Form No 50/77", and then there is a further provision which is not material for present purposes.

Then there were added three new paragraphs (3A), (3B) and (3C). They are as follows:

"(3A) Without prejudice to paragraph (3) above, a time or period prescribed in the rules referred to in that paragraph may, upon request made on Patents Form No 52/77, be extended or further extended by the Comptroller if he thinks fit, upon such terms as the Comptroller may direct, and whether or not the time or period, including any extension obtained under paragraph (3), has expired; "Provided that no extension may be granted under this paragraph in relation to any time or period expiring before 24th March 1987.

"(3B) A single request may be made under paragraph (3A) above for the extension of more than one time or period in the same proceedings if the extensions are to be a common date (but not otherwise).

"(3C) If on consideration of a request under paragraph (3A) above the Comptroller decides that the extension requested (or, in a case falling within paragraph (3B) above, any or all of the extensions requested) may be granted he shall notify the applicant accordingly and invite him to file Patents Form No 53/77, upon receipt of which the Comptroller shall effect the extension or extensions in accordance with the decision."

As Mr Pumfrey for the Comptroller pointed out, whereas under rule 110(3) as it was prior to such amendment the grant of the one month extension to any of the periods in the rules specified in rule 110(3) was discretionary having regard to the word "may" in 110(3) as it then was -- under the amended 110(3) the extension is mandatory upon filing Form 50/77. So he submitted, the rule is now a different one from that considered in the Aisin Seiki decision. That is plainly right, but the difference in that regard (ie the change to a mandatory from a discretionary extension) does not, in my judgment, in any way diminish the authority of Aisin Seiki as applicable to this case; the reasoning of Whitford J in that case does not depend in any way on the extension in rule 110(3) being a discretionary one and as I understand his reasoning it would have made no difference at all to the reasoning or decision had rule 110(3) provided for the extension being mandatory on filing Form 50/77 rather than discretionary.

Mr Pumfrey further pointed out that under the new paragraph (3A) in rule 110 the Comptroller in the exercise of his discretion might permit the filing of the translation required under section 89(4) well after the period prescribed in rule 85(1) including any possible extension under rule 110(3), although this new provision is expressly excluded from applying to any time period expiring before 24 March 1987 when the amended rule came into effect -- an exclusion that, of course, applies to the present case. He, therefore, submitted that the concern of Whitford J that underlay his reasoning in Aisin Seiki, namely, that on the applicants' submission in that case, Form 50/77 might be filed at any time, even after expiry of the one month extension period possible under rule 110(3), was not now a relevant consideration. I do not accept that submission -- whether I have to consider the position under the old form of rule 110(3) or under its new mandatory form, it is not in dispute that the period prescribed under rule 85(1) and any possible extension under rule 110(3) had expired before 24 March 1987. It seems to me, therefore, that the ratio of Whitford J's decision in Aisin Seiki remains unaffected in its applicability to the present case.

Mr Pumfrey also ventured upon the wider question of the ambit of the wording "taken to be withdrawn" in section 89(4) in view of the new provision of rule 110(3A). That, it seems to me, is not a question which arises for decision on Mr Thorley's case based on rule 110, although it may call for consideration on his argument based on rule 100.

Mr Thorley put forward an argument on rule 110 not apparently canvassed before Whitford J in *Aisin Seiki*. I pause there. It was obviously canvassed before the hearing officer, because that is the part I read. He submitted and I paraphrase the argument as I understood it: (i) that if the failure to file Form 50/77 is a failure to observe a time or period laid down by the rules, it must be a time or period prescribed by rule 110(3) itself; but, (ii) any time limit prescribed by rule 110(3) is not itself excluded from the generality of rule 110(1) and accordingly the Comptroller has a discretion to extend the time for filing Form 50/77 beyond that time limit or period -- presumably the possible one month extension of period provided for in rule 110(3). Although Mr Pumfrey referred to this argument as attractive, I do not find it so. The whole purpose of rule 110(3) is to provide in the cases of the respective time periods prescribed in the particular rules therein specified that it may be extended for a period of "not more than one month". To read the following words "upon filing Patents Form 50/77" as then taking the operation of the sub-rule within the ambit of the discretionary power of the Comptroller under rule 110(1) would be to make the distinction between those time limits which could be extended at the discretion of the Comptroller under rule 110(1) and those which could only be extended for one month under rule 110(3) of no effect at all.

In my judgment the applicants' case on this appeal based on rule 110 fails.

I will hear counsel as to how we should go on.

Thorley:-- In the light of my lord's judgment I shall have to ventilate the rule 100 question. I shall be seeking my lord's leave to take the rule 110 matter to the Court of Appeal, but I do not believe that it is sensible to take it piecemeal.

Falconer J:-- I think that is right; I regard this as simply two parts of the one hearing.

Thorley:-- If I succeed on rule 100, I do not need to take it to the Court of Appeal but, if I do not succeed on rule 100, I will seek leave to take both questions to the Court of Appeal. Now that it is fresh in my lord's memory, would my lord see fit to give leave on this issue?

Falconer J:-- What do you say, Mr Pumfrey?

Pumfrey:-- We have no views in regard to leave, my lord.

Falconer J:-- You may have leave, Mr Thorley.

Pumfrey:-- There is one thing I should mention before we go on to the rule 100 case. My learned friend has an application to admit six further statutory declarations, effectively in answer to the decision of the hearing officer on rule 100. I think it is six. It is a large number anyway. I can make it clear at this stage that there will be no objection to the admission of those statutory declarations, when one comes to the rule 100 case. That I think deals with the only outstanding procedural matter.

(Judgment on the rule 100(2) point was given on 5 May 1988).

Falconer J:-- In this appeal, which is an appeal from a decision dated 29 July 1987 of the principal examiner, Mr BG Harden, acting for the Comptroller, whereby he held that the patent application No 8624689 in the name of Mitsubishi Jidosha Kogyo KK must be taken as withdrawn under section 89(3) of the Patents Act 1977, it was agreed between the parties that the applicants' argument on this appeal based on rule 110 of the Patents Rules 1982, as amended under the Patents Amendment Rules 1987, should be heard first, since, if they should be successful on the rule 110 argument it would not be necessary to consider their case based on rule 100 of those Rules, which would involve consideration of the evidence in the matter.

I gave judgment on the appeal so far as based on the applicants' rule 110 argument on 18 February 1988 -- I held their case based on rule 110 failed.

Accordingly, the appeal was resumed for argument on the applicants' case based on rule 100. I now give my judgment on the applicants' case in this appeal so far as based on rule 100.

This appeal concerns an international patent application under the Patent Co-operation Treaty (PCT) and it may be convenient if I refer at once to the relevant provisions of the statute, the Patents Act 1977. For present purposes the relevant provisions are contained in section 89.

Section 89(1) provides:

"Subject to the provisions of this Act, an international application for a patent (UK) for which a date of filing has been accorded (whether by the Patent Office or by any other body) under the Patent Co-operation 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".

Then it goes on to set out paragraphs (a) to (f), which I need not read, which are not material for present purposes.

Therefore an international patent application for which the UK has been designated and which has been accorded a filing date under the Treaty is to be treated as an application for a patent under the Act.

But that is subject to an exception in section 89(3), which is as follows:

"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".

The need for that provision, which creates an exception to section 89(1) is apparently that in certain cases the UK Patent Office may act as an international authority under the PCT in respect of one or other or some of those specified functions under the Treaty (ie, publication, search, examination and amendment).

The relevant conditions referred to in section 89(3) are set out in section 89(4), which provides:

"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 have been filed at the Patent Office and the filing fee has been paid to the Patent Office by the applicant".

Paragraph (b) I need not read because it is not relevant for present purposes.

Rules 85(1)(a) of the Patents Rules prescribes a period of 20 months from the earliest priority date to satisfy the conditions of section 89(4) and to prevent the application being taken to be withdrawn under section 89(3).

I should explain that the processing of an international patent application under the PCT is regarded as having two distinct phases, the international phase and the national phase -- in the former the application is processed on an international basis under the Treaty and the Regulations thereunder as an international application designating certain countries, but an application enters the national phase when it falls to be processed in each of the designated countries under the appropriate legal provisions of the designated country -- in

the United Kingdom the evidence is that an international application is regarded as having entered the national phase when the applicant has complied with the requirements of section 89(4).

In my first judgment I stated the material facts relating to this application and how it came to be "taken to be withdrawn" under section 89(3), so far as necessary for considering the applicants' rule 110 argument.

It will be convenient to recapitulate what I there stated:

"The application arises from an international application filed in Japan on 17 February 1986 under the provisions of the Patent Co-operation Treaty (PCT), the United Kingdom being one of the designated countries. The international application proceeded through preliminary examinations and search and was published by the International Bureau (IB) in the Japanese language on 28 August 1986. In accordance with PTC article 20 and rule 47 on the same date a copy of the international application as published was sent by the IB to the United Kingdom Patent Office as one of the designated Offices . . .

"The application claimed priority from various Japanese applications the earliest ones having a filing date of 16 February 1985. The prescribed period under rule 85(1)(a), therefore, expired on 16 October 1986. As the application as published by the IB was in the Japanese language, the relevant conditions which had to be complied with by 16 October 1986 including filing a translation of the Japanese application and paying the relevant fee. Although on 15 October 1986 the relevant fee was paid and certain documents including Forms 9/77 and 10/77 (requests for preliminary and substantive examination) not material for present purposes were filed, no translation of the international application was then filed. Subsequently on 14 November 1986 translation of the international application and also of the priority documents were filed."

I interpolate there to explain that under rule 6(6) of the Patents Rules, the translation of the priority document was required to be filed within 21 months of the disclosed priority date. Reverting to my previous judgment:

"Of course, the translation of the international application was out of time -- but that prescribed time of 20 months could have been extended by one month under rule 110(3) had Patents Form 50/77 been filed requesting such extension. The Patent Office, after considering the matter, issued a letter on 11 December 1986 stating that the translation of the international application had been filed outside the prescribed period and, as no Form 50/77 had been filed before the one month extension possible under rule 110(3), the application had been taken as

withdrawn under section 89(3). The hearing officer explains in his decision the reason for non-filing of Form 50/77 succinctly as follows:

"The reason why no Form 50/77 had been filed was that in the firm of patent agents handling the application the particular personnel responsible for the application were under the wrong impression that the 21 months period for filing the translations of the priority documents also applied to the translation of the international application."

That reason had emerged from the evidence filed initially by the applicants. As I pointed out in my first judgment:

"Following further communications between the Office and the applicants' agents the matter came on for a hearing before the principal examiner on 25 March 1987 -- it was adjourned to allow evidence by statutory declaration by the appropriate executive officer of the Office and in reply from the agents. The hearing resumed on 18 June 1987.

" The appropriate Patent Office executive officer was Mr ES Smith who made a statutory declaration and was cross-examined at the hearing before the hearing officer. Evidence in reply was filed by the applicants.

The applicants' failure to file the translation of the international application within the prescribed 20 months period, and not having extended that period by filing Form 50/77, was a failure to comply with a time limitation set out in the Rules and, therefore, qualifies as an irregularity in procedure within rule 100. Rule 100, as substituted by the 1987 Amendment rules is as follows:

"(1) Subject to paragraph (2) below, 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.

"(2) Where the irregularity in procedure consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968, as they continue to apply, the comptroller may direct that the time or period in question shall be altered if the irregularity is attributable wholly or in part to an error, default or omission on the part of the Patent Office, but not otherwise.

"(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any time or periods under rule 110 below."

The applicants' rule 100 argument is that the case falls within rule 100(2). Mr Thorley was at pains to say he did not contend that the applicants' failure to file the application translation in time or to extend that time by filing Form 50/77 was wholly due to an error, default or omission of the Patent Office but he did contend that it was in part due to what he put forward as two defaults by the Patent Office.

What might be regarded as falling within the wording "an error, default or omission on the part of the Patent Office" has been considered in two decisions of the Court of Appeal, namely *Morgan-Ward Critchley & Co Ltd's Application* (which appears in the reports as "M's Application") [1985] RPC 249 and *Mill's Application* [1985] RPC 339. In the *Morgan-Ward Critchley* case, Oliver LJ, with whose judgment the other members of the court agreed, said (at page 270, line 47):

"I am prepared to assume, but certainly without deciding, that it is possible to bring within the description of an 'error or default or omission' a neglect of some well-established and generally well-known practice on which it is known or may be assumed that all those dealing with the Patent Office can be said to rely -- even though it may not be backed up by any statutory or regulatory backing. I am prepared to assume that, but I certainly must not be taken to be saying that is established".

and he accepted (at page 272) counsel's submission that the proviso to rule 100 (as it then was, corresponding to what is now paragraph (2) of rule 100), only came into operation on three conditions:

"First, the applicant has to show that the Patent Office is guilty of an error, default or omission; and by 'omission', I mean an omission to do something which it can be said there is some sort of obligation to do, and that I think does not include, as in this case, the answering of routine letters within any particular time limit.

"Secondly, he has to show that such error, default or omission can be said to have contributed to the failure to meet the time limit.

"Thirdly, Mr Laddie's submission is that the contribution must be shown to have played a 'significant' or a 'substantial' part in the applicants' failure. I find that submission an acceptable one, subject to this that it seems to me that it is to some extent a matter of words. 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".

In the Mills case those propositions were adopted by Slade LJ, with whose judgment the other members of the court agreed (at page 359, line 30) as follows:

"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"

and in that case, at page 360, Slade LJ specifically held that:

"In my judgment this failure by the Office to perform a specific promise made to the appellant's agents in accordance with a well-established and generally well-known practice amounted to an 'omission' within the meaning of the proviso to rule 100, whether or not it would have exposed the Office to legal liability under the law of negligence or otherwise".

The reference in that paragraph to a "well-established and generally well-known practice" was clearly a reference to a practice of the Patent Office well-known to professional patent agents, as is clear from the passage lower down on page 360, at lines 46-52.

In the present case Mr Thorley submitted there had been two defaults by the Patent Office upon which he relied as bringing the matter within rule 100(2), namely:

(i) the Patent Office wrongly issued a receipt which indicated that the conditions necessary to enter the national phase had been complied with, that is to say, the conditions under section 89(4)

and

(ii) the Patent Office had wrongly applied national provisions with respect to search and examination before the relevant conditions were satisfied, contrary to section 89(3), in particular in accepting fees for search and examination.

He made clear that these were put forward as two quite separate defaults, each of which he relied upon as bringing the application within rule 100(2).

Consideration on this appeal starts upon the footing that it is not in dispute, indeed it could not be, that the major cause of the irregularity in procedure here, namely, the failure to file the translation of the application in the prescribed period (ie, by 16 October 1986) or to apply for an extension of that period for one month up to 16 November 1986 by filing Form 50/77 within that month and filing the translation within that extended period was the fault of the applicants' agents due (a) to the error of the technical assistant, Mr Langley, in thinking that the agents had a period of 21 months from the priority date (ie, until 16 November 1986) to file the translation and that the translation so filed had to be a verified one where as the correct position was that the period for filing the translation was 20 months from the priority date, with a permissible extension of one month on filing Form 50/77 within that month, and that the translation could be verified within a further two months period and (b) the failure of Mr Cross, the partner under whom Mr Langley was working on the application, to notice and correct Mr Langley's error when he inspected the papers prepared by Mr Langley on 15 October 1986 -- see Mr Cross's first declaration, paragraph 7. As he stated in that paragraph, Mr Cross noted the absence, inter alia, of the translation of the application.

As I understand it, the applicants' case in respect of each of the alleged defaults of the Patent Office amounts to this, that had the alleged default not occurred the agents would have been alerted to the fact that the application was defective in that the translation had not been filed in due time and would have taken steps to file Form 50/77 for an extension of time and the translation of the application before 16 November 1986.

It is convenient to deal first with the second of the alleged defaults submitted by Mr Thorley.

Now section 89(1) of the statute provides that, subject to the provisions of the Act, an international application (UK) shall be treated as an application under the Act. Section 89(3) provides an exception to that position -- until all the relevant conditions (which are specified in section 89(4)) are satisfied the provisions of the Treaty and not those of the Act relating to publication, search, examination and amendment shall apply to such an application. It is not suggested that any action has been taken by the Patent Office in respect of publication or amendment of the application but it is suggested that national provisions with respect to search and examination have been applied by the Office before the relevant conditions were satisfied, particularly in accepting fees for search and examination. The provisions in the Act as to search and

examination are contained in sections 17 (preliminary examination) and 18 (substantive examination). Section 17(1) provides:

"Where an application for a patent has a date of filing and is not withdrawn, and before the end of the prescribed period –

(a) a request is made by the applicant to the Patent Office in the prescribed form for a preliminary examination and a search, and

(b) the prescribed fee is paid for the examination and search (the search fee);

"the comptroller shall refer to the application to an examiner for a preliminary examination and search, except that he shall not refer the application for a search until it includes one or more claims."

and section 18(1) provides:

"where the conditions imposed by section 17(1) above for the comptroller to refer an application to an examiner for a preliminary examination and search are satisfied and at the time of the request under that subsection or within the prescribed period—

(a) a request is made by the applicant to the Patent Office in the prescribed form for a substantive examination; and

(b) the prescribed fee is paid for the examination;

"the comptroller shall refer the application to an examiner for a substantive examination; and if no such request is made or the prescribed fee is not paid within that period, the application shall be treated as having been withdrawn at the end of that period".

The papers lodged by the applicants included Forms 9/77 and 10/77, being respectively requests for preliminary examination and substantive examination and, as required by rule 3, were accompanied by a remittance covering the fees in respect thereof, as well as for the fee in respect of the form NP1 (national processing of an international application).

Now the steps which had been taken by the Office in respect of this application are explained in the hearing officer's decision thus:

"Mr WG Sceats . . . explained the processing steps the application went through when the fee prescribed under section 89(4) and the other documents were filed.

After the cashier had received the money the documents passed to the international unit where the documents received -- in this case the form NP1 accompanying the section 89(4) fee, a sheet of drawings in duplicate and Patents Forms No 9/77 and 10/77 -- were receipted using the form P Ack 4 which also gave the application number accorded to the application by this Office. After the preparation of Office records and the stamping of a file for the documents, the documents filed by the agents together with those received from the International Bureau, including a copy of the published application and of the priority documents, were assembled in the file. It was at this stage that the absence of the translation of the application was noticed and was drawn to Mr Smith's attention as mentioned above. All this occurred before the stage or preliminary examination during which the application is checked to determine whether the formal requirements of the Act are met."

In effect, all that had been done by way of processing the application was to receive the fees and the various forms (and the drawings), prepare the Office records, set up a file in which the documents received from the international unit were married with the forms filed on 15 October 1986 and when that clerical work was done the Form P Ack 4 was sent out. The application was not, of course, referred to an examiner under section 17(1) or section 18(1) which in each case would have been the initiating action by the Office under those provisions -- the application never got to that stage before it was "taken to be withdrawn" under section 89(3). No action beyond recording the receipt of Forms 9/77 and 10/77 and the accompanying fees was taken. I cannot see that in accepting the submitted Forms 9/77 and 10/77 and the fees therefore the Office was in any way acting contrary to section 89(3). The hearing officer said in his decision:

"As regards the acceptance of fees before the conditions of section 89(4) are satisfied, I do not regard this in any way contrary to section 89(3). It is just an advance payment of fees."

I agree and I reject Mr Thorley's submission that in this regard, that is to say, the acceptance of the Forms 9/77 and 10/77 and the fees accompanying them, the Patent Office was in any default.

I turn, therefore to the other matter which the applicants contend constituted a default on the part of the Patent Office upon which they can rely to bring themselves within rule 100(2), namely, that the Office wrongly issued a receipt (form P Ack 4) which indicated that the conditions necessary to enter the national phase, ie, the relevant conditions under section 89(4), had been complied with. Mr Thorley made two submissions in respect of the issue of the P Ack 4 form to the agents in this case:

(a) the Patent Office has no power to issue a form P Ack 4 until the relevant conditions under section 89(4) have been satisfied; and,

(b) even if that is not the case, the issue of a form P Ack 4 has now become such a well-known practice as indicating that the Patent Office are satisfied that either the requirements of section 15(1) (in the case of an application under the Act for a national patent) or section 89(4) (in the case of an international application (UK) have, on their face, been complied with.

As to (a) -- Mr Thorley argued that on the true construction of section 89 the Patent Office has no power to give an application number to a patent application until the relevant conditions, (ie, under section 89(4)) have been met, that is to say, until the application has entered the national phase. I do not accept that argument. Section 89(1) provides that an international application (UK) for which a date of filing has been accorded under the PCT is to be treated as an application under the Act having that date as its date of filing. In the present case the application had been filed under the PCT in Japan on 17 February 1986 and had been processed as a PCT application to the stage of its publication as such by the International Bureau on 28 August 1986. It was, therefore, even at that stage to be treated as an application under the Act having that date of filing (17 February 1986). Exhibit ESS1 to the declaration of Mr ES Smith, the executive officer in charge of the international unit at the Patent Office, a copy of the processing sheet relating to the application, showed receipt by the Patent Office from the International Bureau of appropriate documents on 4 September 1986. On receipt from the applicants' agents of the form NP1 for national processing, the Office had put both sets of documents on the same file and given the application an application number, which was nothing more than an administrative action necessary for the recordal and further processing in due course of the application. That action was not contrary to section 89(3) -- as Mr Pumfrey rightly pointed out, nothing that had been done by the Office related to publication, search, examination or amendment at that stage under the provisions of the Act so that section 89(3) had been complied with.

As to (b) -- the form P Ack 4, which was issued by the Patent Office to the agents was, it is common ground, not a particularly appropriate form of document to issue in response to the filing of form NP1 by an applicant for an international patent (UK), although it is clear from the evidence it was regularly used for that purpose as well as for acknowledging receipt of an application for a patent under the Act. I should, perhaps, mention that it has since been replaced by a different form (form P Ack 4 (Rev 9/87)) which carries in bold type the warning that its issue does not confirm that the documents received are sufficient to meet the filing conditions under section 15(1) or the relevant

conditions under section 89(4) (see Exhibit REBC3). Returning to the form issued, form P Ack 4, it carried on the left hand side the wording:

"The documents listed (right) have been received and recorded as an application for a patent made under the provisions of the Patents Act 1977 in the name of --"

Mr ES Smith, asked in cross-examination at the hearing before the hearing officer,

"It would be fair to read it, would it not, in the case of an international application as reading, instead of 'recorded as an application for a patent', 'recorded as entering the national phase'?"

replied "Yes".

It is, as it seems to me, somewhat difficult to reconcile that answer with the issue of the form P Ack 4 in this case, as it was, receipting documents which left the relevant conditions of section 89(4) not satisfied, so that on the face of the document the application could not be entering the national phase on the issue of the document. The hearing officer, however, in his decision pointed out that:

"The crucial point, of course, is not what the P Ack 4 means to an official of the Patent Office whose duties do not cover determining whether the relevant conditions are met but what the receipt means to a recipient."

On the resumed hearing of the appeal the applicants sought leave to adduce further evidence, inter alia, to deal with that point and, as Mr Pumfrey for the Comptroller did not object, I allowed the admission of the further evidence. The further evidence included declarations from five very experienced and eminent patent agents not connected with the applicants' agents and dealing with what the issue of form P Ack 4 by the Patent Office following filing of documents relating to a patent application signified to them. Those declarations were:

(1) Mr PA Smith, a partner in Messrs Reddie & Grose since 1965 and a number of the Council of the Chartered Institute of Patent Agents;

(2) Mr R Palmer, in practice since 1966 and a director of Messrs Page since 1967;

(3) Mr EWB Lyndon-Stanford, a partner in Messrs Marks & Clerk since 1967;

(4) Mr MJ Daley, a partner in Messrs FJ Cleveland & Company since 1971; and,

(5) Mr OJ Orchard, in practice since 1961 both in industry and private practice and currently the President of the British Association of the International Federation of Industrial Property Attorneys.

The effect of their evidence is that form P Ack 4, which seems to have been generally regarded and referred to as a filing receipt and not as a mere receipt for documents, would have been taken by them as signifying:

(i) when issued following filing of documents to initiate a national patent application that the documents filed had been accepted on their face as constituting a national patent application, ie, as satisfying the minimum requirements of section 15(1) to establish a filing date: and

(ii) when issued in respect of an international application UK, under a PCT application, that the application has been accepted as having entered the national phase, ie, that the relevant conditions under section 89(4) had been satisfied.

(see Mr PA Smith, paragraph 6; Mr R Palmer, paragraphs 5, 7 and 8; Mr EWB Lyndon-Stanford, paragraphs 3, 4, 6, 7 and 8; Mr MJ Daley, paragraph 6; and Mr Orchard, paragraphs 5 and 6). It is to be noted that (ii) is in accord with the affirmative answer given by Mr ES Smith to the question in cross-examination I referred to above. In view of that evidence, was the issue of the form P Ack 4 in this case a default on the part of the Patent Office in the light of the observations and reasoning in Slade LJ's judgment in Mills' Application? Slade LJ cited (at page 354) the observation of Oliver LJ in the Morgan-Ward Critchley case (M's Application) that he was prepared to assume, without deciding:

"that it is possible to bring within the description of an 'error, default or omission' a neglect of some well-established and generally well-known practice on which it is known or may be assumed that all those dealing with the Patent Office can be said to rely . . ."

In his judgment in the Mills case, Slade LJ sets out (at page 358, line 30) certain practices of the Patent Office which counsel for the Comptroller had explained to the Court of Appeal -- the second (at page 358, lines 44-48) is stated by Slade LJ thus:

"The Office issues receipts for several of the important documents filed in the course of making an application. It is under no express obligation under the rules or the Act to do so. However as his counsel tells us, the Comptroller accepts that these receipts constitute an important part of the system employed by many patent agents in ensuring that an application is duly processed."

At page 359, Slade LJ accepted as correctly stated Oliver LJ three propositions in the Morgan-Ward Critchley case, "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," -- (ie, to rule 100 as it then was) -- "even though the obligation is not of a legally enforceable nature".

It seems to me that, on like reasoning, for the Patent Office to issue a particular form of receipt, namely, P Ack 4, the issuance of which in relation to an international application the evidence shows by well-established and generally well-known practice to be accepted by those dealing with the Patent Office (ie, patent agents) as signifying to the recipient that the international application had entered the national phase, in a case where the relevant conditions under section 89(4) had not been satisfied so that the application could not have entered the national phase, as in this case, constitutes a default on the part of the Patent Office within the meaning of rule 100(2).

That brings me to the question of causation -- was the irregularity in procedure in this case, namely, the failure of the agents to file Form 50/77 in due time to secure an extension of time to file the translation and to file the translation in that extended period, attributable in part to that default of the Patent Office? In my judgment it was. The evidence establishes that had the form P Ack 4 not been received by the agents within 2 weeks, the matter would have been reported to the partner concerned (Mr Cross), see the declaration of Mr Middleton, and thereafter, enquiries of the Patent Office would have elicited the problem and a Form 50/77 would have been filed to gain the necessary extension of time -- see Mr Cross's second declaration, paragraph 6.

I have not overlooked that Mr ES Smith of the Patent Office had, as was accepted by Mr Thorley, telephoned the agents on 21 October 1986 and pointed out that the translation had not been filed and although the time for filing it had expired the period could be extended by filing Form 50/77. Unfortunately, presumably due to some failure in the agents' office, that message was not acted upon. But that misfortune does not alter the position that had the form P Ack 4 not been issued, the line of action to which I have referred would have been triggered to secure an extension of time for filing the translation.

Mr Pumfrey, in the course of his argument, contended that, apart from the initial error made by Mr Langley, there was a further error on the part of the agents in not reading the form P Ack 4, which he said, quite rightly, was notice to the agents that the translation had not been filed. But both Mr Cross and Mr Langley were very well aware that the translation had not been filed; the error remains the initial one, namely, mistakenly thinking that the period for filing the

translation was a 21 months period. Reading the form P Ack 4 issued would not have brought that mistake to light.

As I have held, on the basis of evidence not before the hearing officer, that the irregularity in procedure on the part of the applicants' agents was in part attributable to a default on the part of the Patent Office, I have to consider whether it is an appropriate case for exercise of the discretion under rule 100(2). In considering how to exercise the discretion, I bear in mind that Mr Cross, the partner responsible for the application "had not before handled a PCT national phase case which was originally filed in a language other than English", his evidence that such cases were extremely rare throughout his firm's office and that Mr Langley, although he had previously handled one PCT international patent application (UK), that was a case which was originally filed in the United States in the English language, so that he, too, was without experience in handling a case in which the original filing was in a foreign language. I also bear in mind the observation of the hearing officer (on page 15 of his decision), which I endorse, that this seems to be an isolated error by a firm of patent agents who, from the evidence provided, have made great efforts to avoid such errors arising and finally, that the translation was, in fact, filed within the extendible period under rule 110(3). I have come to the conclusion that this is a case where the discretion under rule 100(2) should be exercised in the applicants' favour to extend the period for lodging Form 50/77 in respect of extension of the 20 month period for filing the translation to the date when such form was filed 17 December 1986. I, therefore, allow such extension and, accordingly allow the appeal against the hearing officer's decision that the application must be taken to be withdrawn.

DISPOSITION:

Judgment accordingly; No order as to costs.

SOLICITORS:

Boult Wade & Tennant; Treasury Solicitor