

Abstract

Applicant's failure to file a translation of international application led to justifiable withdrawal by the designated office.

OHI SEISAKUSHO CO LTD'S APPLICATION  
PATENT OFFICE CHANCERY DIVISION (PATENTS COURT)

**HEARING-DATES:** 3 June, 8 November, 1983

8 November, 1983

**INTRODUCTION:**

This was an appeal to the Patents Court by Ohi Seisakusho Co Ltd from a decision dated 3 June 1983 by Mr A McDowell, Principal Examiner acting for the Comptroller, that application No 8206833 must be taken to be withdrawn.

Mr A McDowell. This application stems from an international application No PCT/JP81/00212 filed under the provisions of the Patent Cooperation Treaty (PCT) on 2 September 1981. The international application contained a declaration of priority in respect of a Japanese application dated 4 September 1980 and the United Kingdom was among the designated states in which a patent was sought. The Receiving Office was the Japanese Patent Office. Having been searched by the Japanese Office, which was also the International Searching Authority under the PCT, the application was published in the international phase on 18 March 1982.

On 9 March 1982 the applicants filed with the UK Patent Office documents intended to bring the application into the national phase and comprising a Patents Form No 42/77. Patents Forms Nos 9/77 and 10/77 and appropriate fees, an authorisation, a certified translation of the priority document, duplicate copies of a page 11 containing additional claims and a covering letter requesting that this page should be substituted for the corresponding pages in the specification as filed. Thus the only document still to be filed to fulfil the relevant conditions specified in section 89(4) of the Act was a verified translation of the application, since the application itself was in Japanese.

The Rules operative at that time were the Patents Rules 1978 as amended by the Patents (Amendment No 4) Rules 1981, and it is to these Rules that I shall be referring in what follows.

Rule 85(1)(a) prescribes that, in a case such as the present, the conditions of section 89(4) must be satisfied before the expiry of 20 months from the declared priority date (ie in the present case by 4 May 1982, this period being extendable to 4 June 1982 in accordance with the provisions of rule 110(3) and section 89(3) stipulates that if this is not done the application is to be taken to be withdrawn. A note dated 2 April 1982 on that part of the application file which is not open to inspection under the provisions of section 118(1) indicated that the agent had been notified by telephone that the required translation should be filed by 4 May 1982. There is no report of this telephone conversation with the documents open to inspection. On 28 June 1982 the Office notified the applicants by letter that since the required translation had not been filed within the prescribed period the application was deemed to be withdrawn. This letter also stated that the photocopy of the PCT application was enclosed "as requested". This request apparently resulted from an earlier telephone conversation informing the agent that the application was to be taken as withdrawn; it is referred to in a subsequently filed declaration by the agent as having taken place on about the 23 June 1982, although again there is no record of this conversation on the public file. In a letter dated 30 June 1982 the agents stated that, although they had not yet received the Office's letter referred to above, they were filing a Patents Form No 50/77 requesting an extension of time for filing the required translation and would be submitting the certified translation and observations. These were filed on 27 July 1982 with a letter requesting that the Comptroller exercise discretion to extend the time limit for filing the translation by virtue either of rule 110(1) and (3) or of the proviso to rule 100 and giving supporting argument. As this request was refused the agents submitted further argument and evidence in a statutory declaration by Mr PR Wharton dated 23 November 1982 and requested a hearing. After a further exchange of correspondence in which the agents requested and were given a photocopy of the Office's internal note of 2 April 1982 referred to above, a hearing took place before me on 12 April 1983. Mr AW Russell was present on behalf of the Office and Mr M Archer, a Formalities Officer, was called to testify during the course of the proceedings.

Referring to Mr Wharton's declaration Mr Floyd pointed out that the agents had, from the outset, assumed that the specification filed with the international application was in the English language and therefore it did not occur to them that a translation was required. He referred me to a copy of instructions from the applicants' Japanese agents which refers to a specification being enclosed. It appears that this was in fact not the PCT specification itself but the translation

which is required to be filed in accordance with Article 22(1) of the Treaty and section 89(4)(a) of the UK Act when the specification itself is not in English.

As I understood counsel's submission, the agent's error in this matter was a consequence of the ambiguity in his instructions coupled with a lack of previous experience of such cases which together led him to draw the wrong conclusion about the facts of the situation. It was contended however, that although the cause of the agent's failure lay at his own door, nevertheless it would have been possible for him to have rectified the matter in time had the Office responded otherwise than it did and that this fact should bear upon the Comptroller's exercise of discretion.

Several aspects of the Office's response were referred to me and now require consideration with regard to rule 100 and in particular the proviso in the second paragraph of that rule which states:

"Provided that, without prejudice to the Comptroller's power to extend any times or periods under rule 110 below and except where such irregularity if attributable wholly or in part to an error, default or omission on the part of the Office, the Comptroller shall not direct that any period of time specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968, as they continued to apply, shall be altered."

First it was alleged that the receipt for the filing of the national phase application documents was misleading. This receipt, document PRW 4 accompanying the agent's declaration, is of standard form -- Form P Ack 4, obviously intended for general use for the receipt of the documents filed in UK patent applications. Receipt of the various items making up the application is acknowledged by placing a tick in the box alongside the pre-printed indication of each item, and there is a final item labelled "other". Alongside the first of these ticked items "Request for Grant and Description" the code 42/77 has been inserted. Acknowledgement of the filing of the other forms has been indicated by ticking. After the item "Claims" the word "additional" has been added in brackets and after the item "Translation" the words "or priority document" have been added.

It was put to me that this general form is inappropriate for PCT applications. Mr Wharton states in his declaration that had it been in a more appropriate form then it was likely that he, or the applicants to whom a copy was sent, would have realised that a further document was required in order to carry the application into effect. Mr Floyd pointed out that the words "and description" should have been deleted and that the Office's failure to do this was an error. This I accept. But I am not persuaded that it can have misled the agent, since the latter was well aware that he had not filed any description and his covering letter confirms

this. Nor would the deletion of the word have been likely to have "triggered something off" as he suggested, since he would have expected them to be deleted. His further suggestion that the retention of these words may have led him to think that they referred to the receipt by the Office of the specification from the International Bureau is improbable. There was no reason whatsoever to suppose that the customary receipt for documents filed by an applicant would include any record of other documents filed quite separately. In any case it is irrelevant since the copies of the PCT specification were, in fact, received by the Office in accordance with the recognised procedure shortly afterwards so that if such a conclusion had been drawn from the receipt no harm should have been done. It seems to me that if anything at all emerges from this it is that, since the error concerned a discrepancy between the documents filed and those receipted, the agent's proper course would have been to query the matter and this could have brought the initial error to light.

It seems unlikely that, as suggested in the declaration, the deletion of the words would have alerted the applicants in such wise as to cause them to query the matter, although the possibility cannot be ruled out. But this is speculation. A hypothetical assumption that the applicants might have appropriately reacted to alert the UK agent had the receipt been correctly made out does not, in my view, justify the conclusion that the irregularity in issue was due in some measure to an error, omission, or default by the Office in respect of a matter in which it has an obligation under the Act or Rules and it is this latter consideration which I take to be significant in relation to the Comptroller's exercise of discretion.

This same consideration is also relevant when considering the suggestion, which will, no doubt, be noted by the Office, that the receipt given to PCT applicants should be in a different form which would include appropriate reminders. Although this would be more helpful it is not a requirement laid upon the Comptroller by the Act, but rather one of administration to be determined in relation to considerations of expense and expediency.

A further matter on which counsel placed great emphasis concerned the new page of claims, in English, filed with the application with the request that they be "substituted for the corresponding pages in the specification as filed". This, he argued, should have alerted the Office to the fact that something was amiss and required attention, since there was neither an English language specification into which the claims could be incorporated, nor indeed any existing page 11 in the Japanese specification provided by the International Bureau. At the very least, it was urged, the Office should have replied that they were unable to carry out the request and thus the agent would have been alerted.

In view of counsel's emphasis I have examined his argument here with great care but I am driven to conclude that it is untenable having regard to the customary Office procedures. Until all of the conditions for entry into the national phase have been complied with, further processing of the application does not take place beyond the checking of formal matters and certain preliminary administrative preparations. Correspondence relating to proposed amendments, such as those constituted by the substitution by the new claims requested by the applicant, is normally and quite properly deferred until the ensuing stage of substantive examination. Furthermore, the fact that there was no English language specification upon which the desired substitution could be performed as a purely mechanical operation would occasion no surprise or comment at this stage beyond that actually made by the Formalities Officer, viz that the translation of the specification had not been filed, since it was upon this document that the required action would, in due course, have to be effected.

Now the Office is under no statutory obligation to draw the attention of applicants to the fact that such documents are outstanding. If, when carrying out a formal examination, staff become aware of such outstanding requirements they usually draw the applicant's or agent's attention to them in an endeavour to be helpful, but this is an act of supererogation. In the present case the Office's internal file record, already referred to, indicated that such a reminder was given by telephone on the 2 April 1982 by Mr Archer, the Formalities Officer dealing with the application, but Mr Wharton has declared that he himself received no such telephone call, that there is no record of it on the file of the application nor in any of his firm's records and that none of his partners or staff were aware of any such call having been made. No confirmatory report was sent by the Office although, as was pointed out to me, such reports were commonly sent. Mr Archer affirmed that at the material time it was not his practice to send written confirmation of a simple reminder of this sort, and Mr Russell confirmed that the relevant Office instructions permitted discretion in the matter. I consider that this discretion was reasonably exercised in the circumstances. With hindsight one sees that it is unfortunate that written confirmation was not sent in this particular case. But I do not find that the officer concerned was in any way at fault in not having done so, bearing in mind that he could not know that the agent was unaware of the need to file a translation, for it would not occur to him that the agent could be unaware of the basic fact that the international application was in Japanese.

The wording of the internal file record is terse, stating merely "Translations of the WIPO prints should be filed by 4 May 1982", this being accompanied by a square bracketed note "Agent notified by phone". This was followed by a note drawing the examiner's attention to the agent's letter of 8 March 1982 and the fresh page. Mr Archer admitted that he had no recollection of the telephone call

(which is to be expected) but was adamant that he would not have entered the file report until after actually making the call. He could not say to whom he imparted the information, but was certain that it would have been someone in the agent's office whom he felt satisfied had understood the message and would deal with it.

To resolve the conflict on this question of fact, therefore, I am obliged to balance the probability that the Formalities Officer is mistaken and either failed to make the call or failed to impart the appropriate information, against the alternative that the person receiving it in the agent's office failed to appreciate its significance, or if it was taken by someone not associated with the prosecution of this application, either failed to note it or pass it on -- possibly through the intervention of some distraction. I am disposed to discount the fact that the other staff in the agent's office did not remember receiving such a call since there is no reason to suppose that, after an interval of several months, their recollection of it would be any better than that of the Formalities Officer who, even with the stimulus of his own note, could not recall the event itself. Whilst therefore I fully accept Mr Wharton's declaration on this matter, it cannot be considered as conclusive nor as justifying the setting aside of the positive evidence provided by the internal file record and Mr Archer's consistent supporting testimony. I conclude then that the agent was notified by telephone of the need to file the translation in sufficient time for him to have done so within the prescribed period.

However, even had I reached the contrary conclusion, there would not in my view have been an omission or default by the Office falling with the proviso to rule 100, since although such a default could be considered to have contributed towards the agent's irregularity, it again concerns an act which the Office has no statutory obligation to perform.

In this connection I referred Mr Floyd to the recent judgment given in Morgan-Ward Critchley and Co.Ltd, and in reply he sought to distinguish the present case on the ground that, whereas in the Morgan-Ward Critchley case the Office had followed its own standard procedures, in the present case it has failed to do so. Even had the latter fact been established, which in my opinion it has not, it does not seem to me that the distinction relied upon here is that upon which the learned Judge placed his emphasis. In respect of the issue in that other case most closely analogous to this matter of the page of additional claims Falconer J said:

"I do not accept this submission. The words of the proviso are "attributable wholly or in part to an error, default or omission on the part of the Office". There has been no error here on the part of the Office; there has been no default by the Office in anything which the Office is required to do under the Statute or

the Rules; nor has there been any omission to do anything that the Office is required to do under the Statute or the Rules."

Thus as I see it the Office's failure must be in respect of something which it is required to do under the Statute or the Rules in order to activate the proviso to rule 100. One might perhaps include any obligation upon the Office which is directly derivable from the statutory requirements, but the alleged failures in the present case do not come within this category.

Mr Floyd submitted that there was a further matter in which the Office was guilty of an error contributing towards the applicants's irregularity. This concerns the arrangement by which the copies of the international application supplied by the International Bureau to the UK as designated office, in accordance with Article 20(1) of the Treaty, are accepted in place of those which would otherwise be required to be furnished by the applicant in accordance with Article 22(1). Mr Floyd referred to this as the "waiver provision" but I think it would be more appropriate, and avoid confusion with the specific waiver provision in Article 20(1), if instead I refer to it as the "permitted arrangement". Applicants in general were informed of this arrangement by a notice which appeared in the Official Journal (patents) dated 6 June 1979, the first two paragraphs of which are relevant to the present matter and read:

"Further to the notice which appeared in this Journal on the 21 and 28 March 1979 under the above heading, arrangements have now been made for an experimental period with the International Bureau for two copies of the international application, the international search report and any amendments to the claims to be supplied to this Office within the terms of Article 20 of the Treaty. It will therefore no longer be necessary for applicants to furnish a copy of the application when requesting national processing on Patents Form 42/77.

A translation where appropriate including the Request for Grant will however still be required, to be supplied in duplicate, and if the drawings contain textual matter in a foreign language, fresh formal drawings in duplicate with the textual matter translated should be furnished so that the specification when printed will be wholly in English. Both the drawings and translation must be prepared strictly in accordance with Rules 18 and 20 the Patents Rules 1978."

Counsel submitted that this is ultra vires and argued that, had it not been in operation, then the applicant would have had to file the copies of the specification and thus the agent, seeing that they were in Japanese, would, as a matter of course, have filed the required translation. Mr Floyd referred me in particular to subsection (a) of section 89(4) of the Act which reads: "

(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;"

He submitted that the words "by the applicant" relate not just to the payment of the filing fee, but also to the filing of the other two documents referred to and in support of this contention cited the first sentence of Article 22(1) of the Treaty which states:

"The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than the expiration of 20 months from the priority date."

Thus the Treaty requires the applicant to perform each of the three acts referred to, which same three acts are required to be performed in accordance with section 89(4)(a) of the Act. Mr Floyd admitted that the proviso in Article 22 of the Treaty given by the parenthetical clause "unless the communication provided for in Article 20 has already taken place" enable the requirement that the applicant shall furnish a copy of the international application to be dispensed with, but contended that the UK law did not include any such enabling provision. With reference to the relevant UK provisions he argued:

"If the words 'shall be filed by the applicant unless the communication provided for in Article 20 has already taken place' had been included, the waiver would be *intra vires*, but as it is, in my submission, it is *ultra vires*."

Now the relevant section of Article 20 of the Treaty reads as follows:

"(1)(a) The international application, together with the international search report (including any indication referred to in Article 17(2)(b) or the declaration referred to in Article 17(2)(a), shall be communicated to each designated Office, as provided in the Regulations, unless the designated Office waives such requirement in its entirety or in part."

The qualification "as provided in the Regulations" directs the reader to the relevant rule which is Rule 47. This stipulates that the communication referred to shall be effected by the International Bureau.

I can find no support here for Mr Floyd's interpretation of the legislation. Article 22 requires the applicant to furnish the documents in question within the prescribed period unless the Article 20 communication has already taken place by then, and Article 20(1)(a) together with Rule 47 requires the International Bureau to effect this communication unless the designated Office (in this instance the UK) waives this requirement. The UK has not waived this requirement and hence receives the copies of the international application from the Bureau in accordance with Article 20 as announced in the Journal notice already quoted. It is clear then that this notice does not introduce any waiver of Treaty requirements but rather informs applicants that the implementation of these requirements relieves them of the obligation to file copies of the international application and reminds them that this relief does not extend to the filing of translations.

Reverting now to the wording of section 89(4), I find the most natural reading of it to be that a distinction is being made between the copies of the application, and a translation if one is required, which are to be "filed at the Patent Office" (by whom is not specified), and the filing fee which is to be "paid to the Patent Office by the applicant". Furthermore, this reading of it appears to conform with the provisions of the Treaty as I have outlined them above and so is to be preferred to any alternative possibility which may present itself. Thus in relation to the relevant legislation both national and international I find that the arrangement set out in the Journal and operated by the Office is not ultra vires and therefore, even though it may have contributed towards the applicant's irregularity as suggested by counsel, it is not an error on the part of the Office.

I conclude that in each of the matters which I have dealt with there has been no error, omission or default by the Office of a kind giving the Comptroller discretion to extend a time or period in accordance with the provisions of rule 100.

The alternative submission made to me was that more than one extension may be granted under rule 110(3) having regard to the general power to extend under rule 110(1). Mr Floyd argued that rule 110(1) gives the Comptroller power to grant more than one extension in relation to a particular period and since rule 110(3) does not say "once only" it does not derogate from this power. In this connection he drew my attention to the footnotes to Form 50/77, the form required to apply for extension under rule 110(3). These notes read as follows:

"1 The person making the request should specify the extension required in the space provided.

2 A separate fee is payable for each extension."

Mr Floyd argued that, as this form clearly relates to a single patent application, the reference in note 2 to "each extension" implied that, having obtained one month's extension, the applicant could subsequently file a further form for a second extension of one month and so on, and that this was consistent with a reasonable interpretation of rule 110(1).

To my mind such a reading conflicts with the rule itself and so should be rejected, especially as an alternative reading is readily apparent -- viz that a single application may be made for extension of more than one prescribed period, let us say the periods prescribed by rules 6(2) and 15(1), and for each of these a separate fee would be required. The extensions permitted by rule 110(1) are to be "subject to sub-rule (3)" and the latter clearly states that the period prescribed in certain rules, including rule 85(1)(a), "may be extended for not more than one month". To use this provision as a means of obtaining a succession of monthly extensions, as suggested by counsel, makes a nonsense of the stipulation "not more than". This conclusion is supported by a recent judgment of Whitford J in Nippon Gaishi KK's Application [1983] RPC 388 in which the learned judge stated "it seems to me that the rule is plain enough. Rule 110 gives the Comptroller power to extend time, subject to any appropriate notice, other than those times specified in sub-rule (2) and subject to sub-rule (3); and it seems to me as plain as can be that what sub-rule (3) is saying is: So far as the rules mentioned in this sub-rule are concerned, the times can be extended, but only for one month and not for longer."

To summarise: I find that in none of the particulars submitted to me has there occurred any error, omission or default on the part of the Office of such kind and effect as would justify me in exercising discretion under rule 100 to extend the period prescribed in rule 85(1)(a) for filing the translation required by section 89(4)(a), nor do the provisions of rule 110 enable me to allow such extension as would render the late-filing which occurred timely. I decide therefore that the Office's ruling that the application is taken to be withdrawn shall stand.

**COUNSEL:**

In the Patent Office, and in the Patents Court, CD Floyd appeared for the applicants; Hugh Laddie appeared in the Patents Court for the Comptroller.

**PANEL:** A McDOWELL, MR JUSTICE WHITFORD

**JUDGMENTBY-1:** Whitford J

**JUDGMENT-1:**

Whitford J. This is an appeal by Japanese applicants whose application under the Patent Cooperation Treaty has been taken to be withdrawn because of a failure to supply a translation pursuant to the rules. It is one of those unfortunate cases where there has undoubtedly been an irregularity in procedure, which was quite obviously wholly inadvertent, but where in the light of recent decisions there is no question of there being any discretion resting in the Office under which an extension of time can be granted, unless the failure to meet the requirements, the irregularity in this particular case, can be said to be, in the terms of the proviso to rule 100, attributable wholly or in part to an error, default or omission, on the part of the Office.

Ever since it became apparent that the rather more liberal approach, which was at one time available, had become restricted where errors and irregularities of this kind have occurred, there has been an understandable desire on the part of the applicants who have failed to meet the requirements to lay the blame in part at the door of the Office. That is I think unfortunate in this regard, that I believe everybody would accept that in general the Office do everything they can to assist applicants and indeed in some cases they do more than they are in fact required to do to make sure that applicants do comply with the requirements resting upon them.

It would appear, although there is no requirement upon the Office to do this, that in cases such as this where a certified translation should have been furnished but has not been, the Office telephone the applicants' agents to remind them that a translation has got to be provided by a certain date, and there is evidence in this case, which Mr Floyd very properly says that he cannot any longer challenge, that there was a telephone conversation of this kind in connection with this particular application, that is to say, a telephone warning was given that in fact a translation had to be provided by a certain date. It was not. None the less, the applicants suggested that this error or irregularity was in fact due not, as Mr Floyd said, in any sense to any wrong on the side of the Office but at least in part due to Office errors.

The decision in fact deals with matters which were canvassed once again before me in the very greatest detail and, as I think the decision reached was a perfectly correct decision, I hope I may be forgiven for not going into the matter in quite the same detail as it had been gone into by Mr McDowell, who was the Principal Examiner dealing with this case. What is said is that there are two errors which contributed to this failure to supply a translation at the required time. The first has reference to a receipt, which is exhibit 4 to the declaration of Mr Wharton, who was the patent agent dealing with this matter; for this receipt, sent by the Office in response, I imagine, to the letter which we find in exhibit 2, records the

receipt of a description. It should not have recorded the receipt of a description, because it was not sent. Mr Wharton explains as much and why he did not do it.

Before we get to this point, however, I think that it is important to see what was being done at the time when the documents were sent. What was being done is that the agents were being instructed by their Japanese clients to proceed in a case where it seems to me to be quite apparent that the agents must have been aware that the original description would have been in the Japanese language. That they would have known that there was going to be a requirement for a translation is not I think a matter of dispute.

Mr Wharton, as I understand his evidence, says that he was under the impression that the international application in question had been filed in English and that there was no need for him to file a translation. It does not appear to me that it is good enough, in circumstances such as these, for agents to proceed upon the basis of what their impression may be in a case in which, as I understand it, they should have had good reason to suppose that the original description would have been a foreign language description.

The Principal Examiner has found, and I agree with him, that there is no nexus between the error in connection with the receipt and the failure to file a translation, which brings me to the second point which was taken, which arises upon a notice which we find exhibited as PRW3 to Mr Wharton's declaration, relieving applicants in connection with applications of this kind from the burden of furnishing certain documents, which are taken by the Office from the International Bureau. What is said about this official notice is that it is ultra vires and that, if there had been no such notice given so that the agents had had to supply the documents in question, they would then have become alerted to the necessity for securing a translation.

Apart from the fact that, in my view, I think the Principal Examiner is quite right when he comes to the conclusion that there is nothing ultra vires about this at all, it does not appear to me that even if it were ultra vires, it was in any way contributory to the failure. But over and beyond all this even if a case, which I do not think has been established at all, had been established, even if it could be said that there were errors which may in some faint degree, far too faint to be of any significance, have contributed to this failure, there is the subsequent telephone conversation and the failure of the agents following that telephone conversation to supply the necessary translation.

Plainly the real difficulty is one in respect of which no blame can attach to the Office in any way whatsoever. It appears to me to be quite impossible to suggest, as the applicants on this appeal do that there is any basis upon which a

discretion in their favour could be exercised. The appeal must accordingly stand dismissed.

**DISPOSITION:** Appeal dismissed with costs to the Comptroller. Leave to appeal to the Court of Appeal refused.

**SOLICITORS:** PR Wharton & Co; The Treasury Solicitor.