

Abstract

Applicant was unable to add additional designated countries before publication because authorization of a rectification under Rule 91.1(e)(i) cannot, upon the true construction of Rule 91.1(g-bis), be effective unless its notification to the International Bureau reaches the Bureau before completion of the technical preparations for international publication of the relevant international application.

**RE VAPOCURE TECHNOLOGIES LTD'S APPLICATION
COURT OF APPEAL (CIVIL DIVISION)**

HEARING-DATES: 25 July 1989

25 July 1989

INTRODUCTION:

This was an appeal to the Court of appeal by Vapocure Technologies Ltd from judgment in the Patents Court dismissing an Appeal from a decision dated 23 October 1987 by Mr J Sharrock, superintending examiner acting for the Comptroller, refusing to allow international application No PCT/AU 86/00364 to proceed under section 89 of the Patents Act 1977.

In the Patent Office, Michael Silverleaf, instructed by Page, White & Farrer, appeared for the applicant.

Mr J Sharrock:- An international patent application No PCT/AU 86/00364 in the name of Vapocure Technologies Ltd was filed under the Patent Cooperation Treaty (PCT) at the Australian Patent Office as receiving Office on 26 November 1986 claiming priority from an earlier Australian patent application filed on 3 December 1985. The application as filed designated the following States for national patents:

-Austria, Australia, Bulgaria, Brazil, Federal Republic of Germany, Denmark, Finland, Hungary, Japan, Republic of Korea, Luxembourg, Netherlands, Norway, Romania, Sweden, Soviet Union and United States of America.

On 12 June 1987, the Australian Patent Office, the receiving Office, sent a telex to the International Bureau (IB) of the World Intellectual Property Organisation

(WIPO) stating that the Australian patent attorney for the applicant had made representations to the Australian Patent Office to correct a mistake made in the application when it was lodged, the mistake being the omission of Switzerland and United Kingdom from the list of designated States. The telex stated that the Office had accepted the argument advanced by the attorney, which was accompanied by relevant evidence, that a mistake had been made and that it had always been the applicant's intention to designate Switzerland and the United Kingdom in the request, the designation fee being consistent with the inclusion of Switzerland and the United Kingdom in the list of designated countries. The telex requested the IB to correct Box No V of the request form of the international application prior to publication to include United Kingdom in the national patent box.

On 15 June 1987 the International Bureau notified the receiving Office that the publication date for the application would be 18 June 1987 and that, the preparation for publication having already been completed, it was no longer possible to rectify the application by the addition of the United Kingdom as one of the designated states because of the provision of Rule 91.1 (g-bis). On 19 June 1987, the IB issued a Notification signed by Mr Bartels stating that: "The request for rectification reached the International Bureau after completion of technical preparations for international publication. The designation of the United Kingdom could therefore not be included in the international publication".

On 3 July 1987, a letter was received at the United Kingdom Patent Office from Page White & Farrer, patent agents, lodging Patents Forms NP1 and 9/77 and appropriate fees and requesting entry of the application into the national phase in the UK. An Office letter was issued on 10 July 1987 acknowledging receipt of the forms and fees but regretting that the Office was unable to accept the request on the grounds that the conditions of section 89(1) of the Act had not been met and the request for a correction to add the designation of the UK was not made within the time limit given in PCT Rule 91.(g) or (g-bis).

Following this a hearing was requested and the matter came before me on 25 August 1987.

Section 89 of the Patents Act 1977 sets out the effect under the Act of international applications for patents and the relevant sub-sections read 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 II of this Act as an application for a patent under this Act having that date as its date of filing and –

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

(2) Accordingly, until subsection (1) above ceases to apply to an application filed or published in accordance with the Treaty, the applicant shall, subject to subsection (7) below, have the same rights and remedies in relation to the application as an applicant for a patent under this Act has in relation to a filed or, as the case may be, a published application for such a patent.

(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; . . ."

The other relevant section of the Act is section 130(1), which defines "international application for a patent (UK)" as an "application of the relevant description which, on its date of filing, designated the United Kingdom" and defines "international application for a patent" as an "application made under the Patent Co-operation Treaty".

The question I have to decide is whether or not this application is an international application (UK) for the purposes of section 89, as defined by section 130(1). If this application falls within the latter definition, then, since the relevant conditions of section 89(4) have been complied with, it is entitled to enter the 'national phase' and proceed as an application for a UK patent.

Mr Silverleaf submitted, and I accept, that the question falls to be determined under the provisions of the PCT and the rules made thereunder. There is no dispute that the United Kingdom was not designated in accordance with those provisions at the filing date. However, there is provision under PCT Rule 91 for rectification of obvious errors in documents, including the request -- that is to

say, the application form. Thus, if the request is rectified to designate the UK, and on the presumption that such a rectification takes effect ab initio, which I think it does, then the application may proceed.

Rectification of obvious errors in documents under the Patent Cooperation Treaty is governed by PCT Rule 91. The relevant parts of that Rule are as follows:

"91.1. Rectification

(a) Subject to paragraphs (b) to (g-quater), obvious errors in the international application or other papers submitted by the applicant may be rectified.

(b) Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.

(e) No rectification shall be made except with the express authorisation:

(i) of the receiving Officer if the error is in the request, . . .

(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reason therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (g-bis), (g-ter), or (g-quater) and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification together with the international application. A copy of the request for rectification shall be included in the communication under Article 20 where a copy of the pamphlet is not used for the communication or where the international application is not published by virtue of Article 64(3).

(g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:

(i) where it is given by the receiving Officer or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

(g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.

(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.

(g-quater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20."

Mr Silverleaf submitted that in the present case, the receiving Officer, the Australian Patent Office, has determined that the error in the request may be rectified under rule 91.1(a) and thus the only question which now arises for determination is whether that rectification is effective for the purpose of enabling the UK to be made a designated State.

Paragraph 91.1(g) and (g-bis) specify time limits before which such a correction shall be effective. Mr Silverleaf further submitted that on their proper construction these paragraphs set time limits before which the rectification must be effective and included in the international publication. In other words, the International Bureau and designated States are directed by these rules to incorporate a rectification made before the expiry of the time limits set by them; but, he said, they do not purport to set an inextensible time limit for rectification to be authorized or to determine that a rectification may not be effective if made or notified after the times provided by them. They divide the period between that within which the correction must be given effect to automatically and that thereafter when it becomes a question of discretion for the individual designated offices, he said.

Mr Silverleaf contrasted the wording of paragraph 91.1(g) and (g-bis) with that of section 89(3) of the Patents Act which provides that if the relevant conditions

are not complied with before the end of the prescribed period the application shall be taken to be withdrawn.

However, having given careful consideration to these rules, it seems to me that, on a proper construction, paragraph 91.1(e) sets out the authorities competent to authorize rectification in various documents and that 91.1(g) is intended, subject to (g-bis), (g-ter) and (g-quater), to set the limits to the effectiveness of those authorizations. Paragraphs (g-bis) and (g-quater) represent extensions to the time limit in (g), while (g-ter) represents a reduction, but what all three have in common is that, in order for a rectification made by the receiving Officer or the International Searching Authority to be effective, its notification must reach the IB in time for it to be included in the international publication, or where the international application is not published, then not later than the time of communication of the international application under Article 20.

The purpose of paragraph 91.1(f) is to allow the applicant to inform the public and designated Offices where a rectification has been refused and, if national law of the designated Office so permits, obtain authorization for the requested rectification from that Office. This is in accordance with Article 26 which reads as follows:

- " Opportunity to Correct before Designated Offices

No designated Office shall reject an international application on the grounds of non-compliance with the requirements of this Treaty and the Regulations without first giving the applicant the opportunity to correct the said application to the extent and according to the procedure provided by the national law for the same or comparable situations in respect of national applications.

" It further seems to me that the clear intention behind these paragraphs of Rule 91.1 is that any rectification which is effective, or which may be made effective subsequently, if national law so permits, should be published in the international publication (or should be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication) so as to inform the public and the designated Offices at that time. This, it seems to me, is essential so that the public can rely on the publication, because the PCT itself does not contain any provisions for protecting third parties who act in good faith on the basis of information contained in the publication.

I turn now to the effect of these rules in the present case. The rectification has been authorized by the receiving Office under paragraph 91.1(e) but has not been given effect to by the International Bureau because the notification did not reach it within the time prescribed by paragraph (g) or (g-bis). The rectification

has therefore not been made in the record copy of the international application, which, according to Article 12(2), is considered the true copy of the international application, and has not been incorporated in the published pamphlet. There is no provision under the national law, the Patents Act 1977, to allow a rectification to designate the United Kingdom. I conclude, therefore, that as things stand the United Kingdom has not been designated in the international application and the Patent Office, accordingly, is not designated Office.

However, according to Mr Silverleaf there is a way out. He further submitted that if a rectification is authorised in accordance with the provisions of Rule 91.1 paragraph (e) but is made or notified to the IB after the expiry of the time limits provided by paragraphs (g) and (g-bis), but whilst the application is still able to enter the national phase, as is the case here, then the question arises whether the delay in meeting those time limits should be excused in accordance with the provisions of the PCT dealing with such excuses, namely PCT Article 48(2). The relevant passages read as follows:

-(2)(a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.

(b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit.

This Article has been the subject of judicial consideration by the House of Lords in the case of *E's Applications* [1983] RPC 232, where Lord Diplock stated at page 251 that:

"the plain intention of this sub-rule . . . is that, as respects extensions of time limits, receiving offices and the Patent Offices of designated states are bound to treat international applications, no less favourably than national applications, although they are at liberty to accord international applications more favourable treatment than national applications."

Mr Silverleaf submitted that this approach to Article 48(2) is correct and that it specifically gives to designated States a discretion to extend time limits even where this would not be permitted in relation to a national application in equivalent circumstances. He further submitted that Article 48(2) applies to the extension of the time limits provided by Rule 91.1 paragraphs (g) and (g-bis). Rule 82 bis .1(i) specifies that Article 48(2) applies to any time limit fixed in the Treaty and Rules.

Accordingly, Mr Silverleaf submitted, there is in the present case a discretionary power given by PCT Article 48(2) to excuse the delay in notifying the rectification of the application to include the designation of the UK to the International Bureau beyond the time limit provided by Rule 91.1 (g-bis).

Mr Silverleaf submitted that it is essential for compliance with the basic requirements of natural justice that the applicant for a patent has the opportunity to seek a review and reconsideration of any administrative decision taken under the PCT. He pointed out that there is no opportunity or mechanism for review within the International Bureau. Equally there is no overseeing body or tribunal which has jurisdiction to review any of the administrative acts of the International Bureau. The receiving Officer's function is to consider a request for rectification and decide whether or not to authorise it. Accordingly, he submitted that all the indicators within the PCT and Rules point to the conclusion that the designated State is the appropriate body in the circumstances which arise here. The difficulty here is that, as I have concluded above, although the receiving Office has authorised the rectification it is not effective and the UK Patent Office is not a designated Office.

Thus although Mr Silverleaf argues that the delay in meeting the time limit in Rule 91.1 (g-bis) can be excused under Article 48(2)(b) so as to make the rectification of the request effective, this leads to the dilemma that unless the time limit is excused, the UK is not designated, but until the UK is designated it has no power to do the excusing. Mr Silverleaf's answer to this is that as a fundamental matter of administrative law it is clear beyond doubt that any domestic tribunal of limited jurisdiction has jurisdiction to decide whether or not it has jurisdiction. That, he said, is really the question I am being asked to determine here, whether or not I have jurisdiction over this application, and it is because I have jurisdiction to make that determination, he said, that I have jurisdiction to decide whether or not the UK is a designated State. He also pointed out that Article 48(2) is couched in terms of Contracting States and he said it gives me the authority as a Contracting State to decide whether or not the UK is a designated State. He also reiterated the arguments that the United Kingdom Patent Office is the only available body to make the decision. This, in my view, merely puts the circular argument the other way round without removing the dilemma. Decide whether or not you have jurisdiction over the application, then decide whether to exercise discretion and extend the time limit and thus decide that it is an application designating the UK. However, it seems to me that Article 48(2) can only apply when a contracting State is seised of an application. It further seems to me that as a fundamental matter, I only have jurisdiction over the application if the UK is designated; and, as I pointed out earlier, as things stand the UK has not been designated.

Mr Silverleaf also addressed me at some length on the matter of discretion and sought to persuade me that the only factor to be taken into account was public interest. Since I have concluded that I have no power to act under Article 48(2)(b), there is strictly no need for me to decide whether, if there is discretion so to act, it should be exercised in the applicant's favour. I would observe, however, that it does seem to me to be a case where, if the application could be allowed to proceed in the national phase, there ought to be an order to protect third parties who have acted on the basis of the information in the international publication, but there would not seem to be any power either under the PCT or under the Patents Act 1977, in these circumstances, to make such an order.

COUNSEL: Robin Jacob QC and Michael Silverleaf for the Appellant;
Nicholas Pumfrey for the Comptroller

PANEL: FOX, MANN LJ, SIR DENYS BUCKLEY
JUDGMENTBY-1: SIR DENYS BUCKLEY

JUDGMENT-1: SIR DENYS BUCKLEY:

This is an appeal from a judgment of Whitford J given on 11 February 1988, when he dismissed an appeal from a decision dated 23 October 1987 of Mr Sharrock, superintending examiner, acting for the Comptroller-General of Patents, whereby he rejected an application by the present appellant, Vapocure Technologies Ltd ("the appellant"), the nature of which will appear later in this judgment. The Comptroller-General of Patents is the respondent. The case relates to an application by the appellant under the Patent Co-operation Treaty ("PCT")

Interaction between PCT and Patents Act 1977

By the PCT, the contracting States constituted themselves as a union for co-operation in the filing, searching and examination of applications for the protection of inventions. The United Kingdom is, and has been, one of the contracting States since the Treaty came into force in October 1977. The Treaty has, in general, no force in English law, but the Patents Act 1977, section 89, gives statutory effect to certain of its provisions.

Section 130(1) of the Act provides that ". . . international application for a patent (UK)" means an application of that description which, on its date of filing, designates the United Kingdom.

Section 89(1) provides that an international application for a patent (UK) for which a date of filing has been accorded under the PCT shall be treated for the

purpose of Parts I and III of the Act as an application for a patent under the Act, having that date as its date of filing. Consequently, a patent applied for under the PCT, though not applied for in the United Kingdom Patent Office, may in due course be granted by that Office and take effect as an United Kingdom patent.

An inventor seeking patent protection through the PCT machinery is required to make an application in a prescribed form in the Patent Office of some one of the contracting States (PCT Article 3). Such an application is termed "an international application" (PCT Article 2(vii)). The Patent Office in which the application is filed is termed "the receiving Office" (PCT Article 2(xv)). The application must embody certain specified information, including the designation of the contracting States in which protection of the invention is sought (PCT Article 4). The prescribed form of application sets out in Box V the names of the thirty contracting States, having opposite to each a boxed space in which the applicant is intended to place a cross indicating that he seeks the grant of either a national patent and/or a European patent in the contracting State so indicated. Contracting States so designated are termed "designated States" (PCT Article 4(ii)). The receiving Office has the duty of processing the application as provided in the Treaty and the Regulations made under it (PCT Article 10). The receiving Office retains one copy of the application ("home copy"), transmits one copy to the International Bureau of the World Intellectual Property Organisation at Geneva ("record copy"), and another copy ("search copy") to a body described as the competent International Searching Authority (PCT Article 12).

When it has been established to the satisfaction of the receiving Office that an international application is in a satisfactory form (if necessary after amendment), the receiving Office must "accord" the international filing date of the application. Thereupon the international application has the effect of a normal national application in each designated State as of the international filing date (PCT Article 11(3)).

An international search is then conducted by the appropriate International Searching Authority with the object of discovering the relevant prior art (PCT Article 15), whose report is transmitted to the applicant and to the International Bureau.

The international application and the international search report are then communicated to the Patent Offices of all the States designated in the international application. Search - 18 Results - patent cooperation treaty

The International Bureau must publish the international application (subject to certain exceptions) "promptly after the expiration of 18 months from the priority date of that application" (PCT Article 21(2)).

The applicant must furnish a copy of his international application and pay any appropriate fee to the national Patent Office of each designated State not later than the expiration of 20 months from the priority date (PCT Article 22).

PCT Article 23 stipulates that no designated office shall process or examine the international application before the expiration of the time limit under Article 22 unless requested so to do by the applicant.

An applicant may demand that his international application be the subject of an international preliminary examination by a competent International Preliminary Examining Authority (PCT Article 31). This is distinct from the international search referred to in PCT Article 15.

It will be appreciated that the duty of the receiving Office to process an international application extends in effect down the stage at which the applicant must comply with PCT Article 22. This has been referred to as the "international phase".

From the stage at which Article 22 becomes operative, the application proceeds in each designated State as if it had been a normal application for patent protection initiated in that State, save that any international preliminary examination which may have taken place may have served the purpose of any preliminary investigation which might otherwise be conducted under the law of the designated State. This has been called "the national phase".

If for any reason the applicant fails to comply with Article 22 within the specified 20 months' time limit, the effect of the international application provided for in PCT Article 11(3), referred to earlier, ceases in any designated State with the same consequences as the withdrawal of any national application in that State would have (PCT Article 24(iii)): in other words, it ceases to be an effective application. Otherwise the application proceeds in the Patent Office of each designated State to its appropriate conclusion, just as if it had initially been filed in that Office.

In the case of an international application for a patent (UK), the international search under PCT Article 15 forms part of the international phase as also does (pro tanto) any international preliminary examination conducted during the international phase. The substantive examination referred to in section 18 of the Act, on the other hand, forms part of the national phase and is conducted in the

United Kingdom Patent Office under the Patents Act 1977 as if the application had been initiated in the United Kingdom under that Act.

Facts

I can turn to the facts of the present case. On 26 November 1986 the appellant, a United Kingdom company resident in England, filed an international application under the PCT in Australia in the prescribed form. In Box V of that application, 17 contracting States were designated by means of a cross typed in the national patent column against each of 17 names. Due to a mistake (as is common ground) neither the United Kingdom nor Switzerland was so designated. The application was accorded in Australia the international filing date 26 November 1986, and claimed priority based on an earlier application filed in Australia on 3 December 1985. The international search was conducted in Australia and completed on 19 February 1987. The appellant did not at any time demand an international preliminary examination in respect of the United Kingdom.

On 10 June 1987 the appellant's patent agent informed the International Bureau by a fax message of the omission, in consequence of a typographical error, to designate the United Kingdom in the international application. At or about the same time, similar information was sent to the Australian Patent Office, supported by evidence. It seems that at or about the same time similar communications took place in respect of the omission to designate Switzerland.

On 12 June 1987 the Australian Patent Office, as the receiving office, requested the International Bureau to amend the international application by including the United Kingdom as a designated State. On the same day the International Bureau replied to the Australian Patent Office as follows:

"Publication date is June 8 1987. Pamphlet and PCT Gazette have already been printed. Regret but the requested addition of CH and GB designations is no longer possible. Therefore authorisation of rectification not effective (see PCT Rule 91.1 (g-bis))".

That Rule in the Regulations made under the PCT reads, so far as relevant, as follows:

RULE 91

91.1 Rectification

(a) Subject to paragraphs (b) to (g-quater), obvious errors in the international application or other papers submitted by the applicant may be rectified

....

(e) No rectification shall be made except with the express authorisation:

(i) of the receiving Office if the error is in the request." (ie the international application)

...

(g) The authorisation for rectification referred to in paragraph (e) shall subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:

(i) where it is given by the receiving Office . . . if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;

...

(g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau . . . after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorisation shall be effective and the rectification shall be incorporated in the said publication".

Since the priority claimed by the appellant was dated 3 December 1985, the 17 months' time limit prescribed by Rule 91.1(g) expired on 3 May 1987, before the appellants sought rectification of their international application and before the Australian Patent Office authorised, or purported to authorise, the required rectification.

By telex dated 12 June 1987 the Australian Patent Office informed the International Bureau that the Australian Office accepted that a mistake had been made and requested the International Bureau to correct Box V of the international application before publication to include the United Kingdom as designated for a national patent. On the same day the International Bureau replied as already stated.

On 18 June 1987 the International Bureau informed the appellant's patent agent in writing that the Bureau had that day communicated the international application to the 17 States designated in it (ie, excluding both the United Kingdom and Switzerland), reminding the appellant that it must enter the "national phase" before each designated Office by complying with PCT Article

22 or 39(1) within the time limit there laid down (ie, by 3 August 1987 in a case to which Article 22 was applicable).

On 19 June 1987 the International Bureau wrote to the United Kingdom Patent Office informing the Office of the situation, and saying:

"The request for rectification reached the International Bureau after completion of technical preparations for international publication. The designation of the United Kingdom could therefore not be included in the international publication".

The decisions below

On 3 July 1987 the appellant's patent agents applied by letter to the United Kingdom Patent Office requesting entry to the appellant's international application into the national phase in the United Kingdom. On 10 July 1987 the Patent Office replied, refusing the request on the ground that the conditions of section 89(1) of the Patents Act 1977 had not been met, and that the request for a correction to add the designation of the United Kingdom was not made within the time limit given in PCT Rule 91.1(g) or (g-bis).

The appellants demanded a hearing. That hearing in due course took place before Mr Sharrock, who held that the question he had to decide was whether or not the international application was an "international application for a patent (UK)" for the purposes of section 89. Since, as he found, the conditions of section 89(4) had been complied with, he held that the international application was entitled to enter the national phase and proceed as an application for a UK patent if it fell within the definition of "an international application for a patent (UK)", but not otherwise.

After considering PCT Rule 91.1(a), (b), e(i), (f), (g)(i), (g-bis), (g-ter) and (g-quater), Mr Sharrock reached the conclusion that ". . . in order for a rectification made by the receiving Office to be effective, its notification must reach the International Bureau in time for it to be included in the international publication".

Mr Sharrock held that, although the rectification had been authorised by the receiving office under Rule 91.1(e), it had not been given effect to by the International Bureau because the notification did not reach the Bureau within the time prescribed by Rule 91.1(g) or (g-bis). It had accordingly not been made in the record copy of the international application which, under PCT Article 12(2), is to ". . . be considered the true copy of the international application". He held that in these circumstances there was no provision under the Patents Act 1977 to

allow a rectification to designate the United Kingdom in the international application.

Mr Sharrock then considered an argument on the appellant's part founded on PCT Art 48(2), which is in the following terms:

"ARTICLE 48

Delay in meeting certain time limits

...

(2)(a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit

(b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit".

Note that, whereas sub-paragraph (a) is expressed in mandatory terms, sub-paragraph (b) is in permissive terms. In this connection Mr Sharrock drew attention to the following observations by Lord Diplock in E's Application, [1983] RPC 231 at 251: "The plain intention of this sub-rule' (Lord Diplock was in fact referring to PCT Article 48(2))" . . . is that, as respects extensions of time limits, receiving offices and the Patent Offices of designated States are bound to treat international applications no less favourably than national applications, although they are at liberty to accord international applications more favourable treatment than national applications".

The applicant submitted before Mr Sharrock that Article 48(2) conferred a discretionary power (presumably under Article 48(2)(b)) to extend the time limit under PCT Rule 91.1(g-bis). Mr Sharrock rejected this argument on the ground that it involved the dilemma that, unless the time limit was excused, the United Kingdom was not a designated State, but until the United Kingdom was designated, the United Kingdom Patent Office had no power to extend the time limit. He held that he only had jurisdiction over the international application if the United Kingdom was a designated State. He consequently reached the conclusion that he had no power under either the PCT or the Patents Act 1977 to permit the international application to enter the national phase.

It appears that the United Kingdom Patent Office, in what is described by the appellant as an official letter dated 10 July 1987, stated that the conditions of the Patents Act 1977 section 89(1) had not been met, as no international application

for a patent (UK) had been made and the request for a correction to add the designation of the United Kingdom was not made within the time limit given in PCT Rule 91.1(g) or (g-bis).

The Swiss Patent Office, on the other hand, decided to permit the appellant's international application to enter the Swiss national phase, presumably upon the footing that the rectification, having been authorised by the Australian receiving office in accordance with PCT Rule 91.1(a) and (e), was effective.

The appellant appealed from the decision of the United Kingdom Patent Office to the Patents Court. The appeal came before Whitford J. The learned judge, in a judgment which expressed much sympathy with the appellant, upheld the Patent Office decision, saying that Mr Sharrock's reasoning could not be faulted. The appellant now appeals from the learned judge's judgment to this court.

Application of Treaty and Statutory provisions to facts

One must start with the indisputable fact that, when the appellant presented the international application in this case to the Australian Patent Office (the receiving Office) it did not designate the United Kingdom as a designated State. Consequently, at the filing date of the application, the United Kingdom did not become a designated State and the application did not request patent protection for the relevant invention in the United Kingdom under PCT Article 4.

It is common ground that this was the consequence of a mistake on the part of the appellant, and it has not been disputed that this was an obvious mistake. It was consequently rectifiable under PCT Rule 91.

The body having executive power to rectify the international application was in this case the receiving Office under PCT Rule 91.1(e)(i).

The receiving Office did in fact authorise the rectification requested by the appellant, but not until 12 June 1987. If that authorisation was effective, it is common ground that the United Kingdom should be treated retroactively as having been a designated State for the purposes of that application from the date of filing of the application. The crucial point of time at which to consider these matters was, it seems to me, 12 June 1987, and the crucial gateway for the appellant to negotiate is, in my judgment, to establish that at that date the receiving Office could, within the terms of the Treaty, effectively authorise the rectification.

The function of the International Bureau, as I understand the PCT, is a purely administrative one. The Bureau could not refuse to give effect to a rectification of a mistake in an international application which had effectively been

authorised by the appropriate receiving Office. So the question must be, by what limitations are the powers in this respect of a receiving Office confined.

The 17-month period specified in Rule 91.1(g)(i) had already expired before 12 June 1987. International publication of the appellant's international application was due to take place on 18 June 1987, and it is alleged that the relevant pamphlet and the relevant issue of the PCT Gazette had already been printed by 12 June 1987. No one has suggested that that was not the case. The printing of those two documents must, I think, constitute part at least of the "technical preparations for international publication" mentioned in Rule 91.1(g-bis).

By a formal communication in writing dated 19 June 1987, the International Bureau informed the United Kingdom Patent Office as follows;

"The request for rectification reached the International Bureau after completion of technical preparations for international publication. The designation of the United Kingdom could therefore not be included in the international publication".

There is no evidence before us that that statement was inaccurate in any respect. We must, I think, accept that the notification by the Australian Patent Office to the International Bureau of its authorisation of the rectification of the international application sought by the appellant did not reach the International Bureau until after the completion of the technical preparations for international publication. Did that render the Australian Patent Office's authorisation of the rectification ineffective?

The appellant submits that PCT Rule 91 does not provide that, where neither the 17 months' time limit nor the provision in Rule 91.1(g-bis) have been successfully complied with, later rectification cannot be effective. The appellant contends that "effective" in Rule 91.1(g-bis) means effective to require the rectification to be included by the International Bureau in the international publication of the application. This may have been the view adopted by the Swiss Patent Office in the present case, but we do not know on what grounds that Office acted as it did.

The PCT and the Rules made under it are concerned, to a considerable extent, with time limits with which steps to be taken thereunder are required to comply. In many of these instances the PCT or the Rules made under it (of which Article 12(3) is an example, and see Article 24(i), (ii), (iii)) provide that upon failure to comply with a prescribed time limit the relevant application shall be considered to have been withdrawn. Disciplined compliance with prescribed time limits can, I think, be recognised as a feature of the PCT and its Rules.

I can find in the Treaty and the Rules no generally applicable power of relaxing or dispensing from compliance with time limits. From this I deduce that the policy of the Treaty is that time limits must be strictly observed unless the context of a particular time limit or some other provision of the Treaty or the Rules, such as PCT Article 48(1), provides or implies otherwise.

In my judgment, authorisation of a rectification under Rule 91.1(e)(i) cannot, upon the true construction of Rule 91.1(g-bis), be effective unless its notification to the International Bureau reaches the Bureau before completion of the technical preparations for the international publication of the relevant international application. That seems to me to be the natural implication from the language used. So construed, Rule 91.1(g-bis) provides for finality in the terms of the record copy of the application. I can find in the Treaty and the Rules no provision for amending the record copy of an application after its publication. The view which I have expressed of the effect of Rule 91(g-bis) is, in my opinion crucial to this appeal.

I should perhaps, however, add that it seems from a PCT document dated 6 March 1986 relating to an international application by one Gardner (application No PCT/GB 85/00004) that the International Bureau did in that case propose to amend the record copy of that application to give effect to a rectification authorised by the receiving Office on 18 May 1985, which could not, on account of late transmission to the Bureau, be taken into account when the application was published on 18 July 1985. That document was produced to this Court in the course of the argument on this appeal but has not been formally put in evidence, and we know no more of the facts of that case than appears from the document.

That, however, is not the end of the matter. I must consider the effect of PCT Articles 26 and 48, and of a further argument based on rule 100 of the United Kingdom Patents Rules 1982.

PCT Article 26 provides that no Patent Office of a designated State ". . . shall reject an international application on the grounds of non-compliance with the requirements of this Treaty and the Regulations without first giving the applicant an opportunity to correct the said application to the extent and according to the procedure provided by the national law for the same or comparable situations in respect of national applications".

This Article can only apply to the present case if, on the facts, the United Kingdom Patent Office can be regarded for this purpose as the Patent Office of a designated State. The appellants contend that this is the case because the

Australian Patent Office authorised the rectification on 12 June 1987. They say that the subsequent purely administrative and procedural step of the International Bureau disregarding this authorisation and excluding any reference to the United Kingdom from the record copy of the application cannot reverse the decision of the receiving Office made on 12 June 1987. But if I am right about the effect of Rule 91.1(g-bis), the United Kingdom cannot be regarded as a designated State for any purpose, and so Article 26 cannot apply.

PCT Article 48(2) does not refer to designated States but to contracting States. The United Kingdom is a contracting State. Sub-paragraph (2)(a) consequently provides that the United Kingdom shall, as far as the United Kingdom is concerned, excuse for reasons admitted under United Kingdom law any delay in meeting any time limit; and sub-paragraph (2)(b) provides that the United Kingdom may excuse for any other reason delay in meeting any time limit. This Article does not deal with amendment of international applications, but with excusing delay, which must relate, I think, to delay in complying with time limits imposed by the Treaty or the Rules made under it.

But the difficulty which stands in the way of the appellant's success in the present case is not the result of any delay in complying with any time limit under the Treaty or the Rules: it results from the failure to designate the United Kingdom. That is not a matter capable of cure by excusing some delay in meeting some time limit. It can be cured only by a rectification of the appellant's international application under PCT Rule 91. Consequently Article 48(2) does not, in my judgment, assist the appellant.

The appellant was allowed, by the leave of this court, to add an alternative ground of appeal to their notice of appeal in the following terms:

"Alternatively the learned judge ought to have held that, the receiving Office having decided that the United Kingdom was designated in relation to this application, section 89 of the Patents Act 1977 applies to it and that the rules of United Kingdom law relating to correction of errors in the Patent Office are applicable to it. The learned judge ought, pursuant to such rules, in particular rule 100 of the Patents Rules, to have permitted the application to be corrected to give effect to the said decision of the receiving Office".

This was apparently a point not taken in either tribunal below.

This ground of appeal assumes the effectiveness of the receiving Office's authorisation of the rectification of the appellant's application. Until that application has been effectively rectified, the United Kingdom cannot be a designated State, and the appellant's application cannot be recognised as an

international application for a patent (UK) for the purposes of the Patents Act 1977, section 89. For reasons which I have already given, the appellant's application has not, in my judgment, been effectively rectified.

In support of the ground of appeal added by amendment, the appellant's counsel relied on Prangley's Application [1988] RPC 187. That case is, in my opinion, clearly distinguishable from the instant case in this very important respect, that Prangley had designated the United Kingdom in his international application. The problem in that case was concerned not with a defect in designation, but a defect in demanding an international preliminary examination.

Reference was also made to Mills' Application [1985] RPC 339, where also no problem arose about any defect in designation.

Rule 100 of the Patent Rules 1982, as substituted by rule 11 of the Patents (Amendment) Rules 1987, relates exclusively to documents filed in proceedings before the Comptroller, and irregularities in procedure in or before the United Kingdom Patent Office and could, in my opinion, only be invoked in the present case if the appellant could successfully assert that the international application must be treated as having designated the United Kingdom, which for reasons already given, I do not consider to be the case.

For these reasons I would dismiss this appeal.

JUDGMENTBY-2: MANN LJ

JUDGMENT-2: MANN LJ: I agree.

JUDGMENTBY-3: FOX LJ

JUDGMENT-3: FOX LJ: I also agree.

DISPOSITION:

Appeal dismissed with costs. Application for leave to appeal to the House of Lords refused.

SOLICITORS: Bird & Bird; the Treasury Solicitor Search - 18 Results - patent cooperation treaty