

Abstract

Applicant's PCT application failed to reach the United Kingdom (UK) Patent Office within the priority period due to a delay by the mail service. The court, applying PCT Articles and Rules, held this type of delay does not qualify as an "interruption" to justify an excuse for the arrival delay of the application. In applying PCT law as opposed to UK law, the court asserted that as the UK Office was serving as the PCT receiving office, PCT law should apply.

ARCHIBALD KENRICK & SONS LTD.'s international application

22 July 1994

In the HIGH COURT OF JUSTICE - QUEEN'S BENCH DIVISION

Before: MR. JUSTICE ALDOUS

(Sitting as an additional judge of the Queen's Bench Division)

Patent - International application - Practice - Delay in filing - Postal problems.

Patents Rules 1990, rule 97.

Patent Co-operation Treaty, Articles 11(1), 48(1), Rule 82.2(a).

The international application in suit had been filed in the United Kingdom Patent Office as receiving Office under the Patent Co-operation Treaty (PCT) claiming priority from earlier United Kingdom applications filed on 16 December 1992. Although the package containing the application had been posted by the applicant's patent agent on 15 December 1993 and in the normal course of post would have been received at the Patent Office on 16 December 1993, it was not actually received until 17 December 1993. The Royal Mail accepted responsibility for the delay; the package had apparently been damaged and put aside for repair.

The applicant contended that the application should be accorded a filing date of 16 December 1993 under rule 97 of the Patents Rules 1990 as the date on which it would have been received in the normal course of post.

The applicant also contended that the delay should be excused under Article 48.1 and Rule 82.2 of the PCT on the grounds that there had been an interruption in the mail.

In the Patent Office, the hearing officer held that there was no power under rule 97 of the Patents' Rules 1990 to accord an international application a filing date earlier than the date of receipt, if a delay in the receipt of an international application was to be excused, this could only be done under the PCT. He found that there had been no interruption in the mail service within the terms of Rule 82.2 PCT and that no other relief was available under Article 48(1) PCT.

The applicant applied for judicial review of the hearing officer's decision.

Held, refusing the application: -

1 Rule 97 of the Patents Rules 1990 did not apply to an international application filed in the United Kingdom Patent Office as receiving Office. The jurisdiction of the Patent Office when so acting came from the Patent Co-operation Treaty, which was a complete code, and the Office must apply the rules, regulations and conditions laid down in the Treaty.

2 The "date of receipt" in Article 11(1) of the Patent Co-operation Treaty must mean the date of actual receipt, not a date on which receipt was deemed to have occurred pursuant to the rules of one State.

3 Rule 82.2(a) related only to interruptions of the postal service, not to mistakes or variations occurring when the service was being supplied.

4 Delay due to damage of a package in the postal service was nothing like interruption of the service on account of war, revolution, civil disorder, strike or natural calamity.

This was an application by Archibald Kenrick & Sons Ltd. for judicial review of a decision dated 31 May 1994 of Mr. Leslie Lewis, principal examiner acting for the comptroller, refusing to accord international application No. PCT/GB93/02578 a filing date of 16 December 1993.

In the Patent Office, David W. Gee appeared as patent agent for the applicant.

Mr. Leslie Lewis:- International application, No. PCT/GB93/02578 in the name of Archibald Kenrick & Sons Ltd, was received on 17 December 1993 at the United Kingdom Patent Office (the "Office") acting as receiving Office as defined in Article 2 of the Patent Co-operation Treaty ("PCT"). The Office having found that the conditions of PCT Article 11(1)(i) to (iii) were satisfied at the time of receipt, the application was accorded the date of receipt, viz 17 December 1993, as its filing date under Article 11(1)

The application Request Form included in Box VI a declaration of priority under PCT Article 8(1) and PCT Rule 4.10(a) in respect of eight earlier United Kingdom applications, six of which had a filing date of 16 December 1992 and the remaining two having filing dates of 21 December 1992 and 12 January 1993 respectively.

However, in accordance with PCT Article 8(2)(a), PCT Rule 4.10(d) and Article 4C of the Stockholm Act of the Paris Convention for the Protection of Industrial Property (the "Paris Convention"), the filing date of any earlier application in respect of which priority is claimed must fall within the period of one year preceding the international filing date. Accordingly, in a communication dated 13 January 1994, the Office in its capacity as receiving Office under the PCT informed David William Gee, agent for the applicant, that:

"The Receiving Office has noted the filing date, (17.12.1993) of the above numbered PCT application does not fall within the period of one year from the claimed priority date, (16.12,1992). The reason for this appears to have been a problem in the postal system as can be seen from the envelope. A copy of it is attached for your reference. It does not appear that any earlier filing date can be accorded having regard to PCT Article 48(1) and PCT Rule 82.1(a). The Receiving Office has therefore concluded that despite the circumstances the application must proceed with its own date of filing."

In his response to this communication dated 14 January 1994 and in subsequent letters dated 1 February 1994 (received 1 March 1994) and 7 April 1994, Mr. Gee contended that the application was delayed in the mail and should be accorded a filing date of 16 December 1993 under rule 97 of the United Kingdom Patent Rules 1990 (the "1990 Rules") as the date on which it would have been received in the normal course of post.

He also contended that the delay should be excused under PCT Article 48.1 and Rule 82.2 on the grounds that there was an interruption in the mail.

In support of this latter contention, Mr. Gee subsequently filed a copy of a letter dated 6 April 1994 from the Royal Mail which reads as follows:

"Thank you for your further letter of 22 March concerning the damage and delay to a patent application.

The facts are without doubt that the item was posted on 15 December and delayed whilst in our care. The item I believe was damaged in Newport and the delay probably occurred as a result of being put to one side for repair and not actioned immediately.

In terms of service, our state of the art machinery is designed to speed the mail and our quality of service is around 92% for first class post. The machinery used for such packages process about 30,000 items per hour and unfortunately it is true a minute amount do suffer damage and sometimes unavoidable delay.

I would like to take this opportunity to fully exonerate you and admit absolute liability for the delay."

As a further alternative, Mr. Gee contended that his firm had been advised in a telephone enquiry to the Office that the application would be accorded a deemed date of filing of the day after posting and if this was in fact not the case, the Office had discretion under rule 100 of the 1990 Rules to rectify this as an irregularity by amending the international filing date to 16 December 1992.

However, in official letters dated 28 February 1994, 21 March 1994 and 17 May 1994, Mr. Gee was informed that the Office was of the view that as regards the applicability of rules 97 and 100 any dispensation for delay in the mail must be determined in accordance with the provisions of the PCT and Regulations and not under the national law of the receiving Office. Mr. Gee was also informed that the Office was of the view that the delay in the delivery of the envelope containing the application was not due to an interruption in the mail within the terms of PCT Article 48.1 and Rule 82.2. The matter therefore came before me at a hearing on 26 May 1994 at which Mr. David Gee and Mr. Steven Gee appeared on behalf of the applicant. Mr. R. G. Evan, senior executive officer, was also present on behalf of the Office.

The facts regarding the delay in the receipt of the application are not in dispute. The envelope containing it was posted "recorded delivery" in Birmingham on Wednesday 15 December 1993. The envelope was damaged in transit and was delivered to the Patent Office on Friday 17 December 1993. I understand that the Office is also satisfied that the envelope was sent first class post so that in the ordinary course of post the application would have been received on Thursday 16 December 1993.

The provision in the PCT governing delay in meeting time limits is contained in Article 48, in particular Article 48(1) which reads:

1 Where any time limit fixed in this Treaty or the Regulations is not met because of interruption in the mail service or unavoidable loss or delay in the mail, the time limit shall be deemed to be met in the cases and subject to the proof and other conditions prescribed in the Regulations.

The relevant Regulations are contained in PCT Rule 82, the relevant provisions of which read:

"82.1 Delay or Loss in Mail

(a) Any interested party may offer evidence that he has mailed the document or letter five days prior to the expiration of the time limit. Except in cases where surface mail normally arrives at its destination within two days of mailing, or where no airmail service is available, such evidence may be offered only if the mailing was by airmail. In any case, evidence may be offered only if the mailing was by mail registered by the postal authorities.

(b) If the mailing, in accordance with paragraph (a), of a document or letter is proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, or, if the document or letter is lost in the mail, substitution for it of a new copy shall be permitted, provided that the interested party proves to the satisfaction of the said Office or organization that the document or letter offered in substitution is identical with the document or letter lost.

(c) In the cases provided for in paragraph (b), evidence of mailing within the prescribed time limit, and, where the document or letter was lost, the substitute document or letter as well as the evidence concerning its identity with the document or letter lost shall be submitted within one month after the date on which the interested party noticed - or with due diligence should have noticed - the delay or the loss, and in no case later than six months after the expiration of the time limit applicable in the given case.

"82.2 Interruption in the Mail Service

(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.

(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within five days after the mail service was resumed. The provisions of Rule 82.1(c) shall apply *mutatis mutandis*."

Mr. David Gee contended that the removal for repair of the damaged envelope containing the application from the normal throughput of mail in the sorting office constituted an interruption in the postal service. He further contended that the reason for this interruption, namely the damage to the envelope, could be regarded as a reason like war, revolution, civil disorder, strike or natural calamity in that it was unexpected and outside the control of the postal authority, in this case the Royal Mail.

In support of these contentions he referred me to the definitions of "interruption" and "like" and "service" in various dictionaries. However, I do not find any need to resort to such definitions. In my view, the removal for repair of a damaged item of mail does not constitute an interruption in the mail service even if it results in that particular item being delayed. Even if it were to constitute such an interruption, I cannot accept that damage to the envelope containing a patent application can be interpreted as a reason for interruption comparable to war, revolution, civil disorder, strike or natural calamity. I therefore find no evidence of an interruption within the conditions of PCT Rule 82.2(a) and that consequently no relief is available to the applicant under PCT Rule 82.2(b). It follows from this that any relief under Rule 82 would have to be under Rule 82.1 which governs the delay and loss of documents and letters in general. However this latter Rule requires the document or letter to be mailed five days prior to the expiration of the time limit and for it to be sent by registered mail. In the present case, it is apparent from the facts as set out above that neither of these requirements of Rule 82.2 are met and Mr. Gee has already stated in his letter dated 1 February 1994 that this Rule is not relevant.

Mr. Gee also contended that since PCT Article 48.1 does not state that the time limit shall be deemed to be met only in the case and subject to the proof and other conditions prescribed in the Regulations, the Office in its capacity as receiving Office had the discretion to deem a time limit in the event of a interruption in the mail service or delay in the mail as met even if the conditions prescribed in the Regulations are not satisfied. He also contended that I should exercise this discretion in favour of the applicant in the present case.

However, in my view, the words

"Subject to the proof and other conditions prescribed in the Regulation"

in Article 48.1 are inherently mandatory and allow no discretion to excuse delay other than in accordance with Rules 82.1 and 82.2.

In the course of the hearing, two subsidiary questions also arose. The first was whether the twelve month limit for a priority claim, which derives from Article 4 of the Paris Convention in accordance with PCT Article 8(2)(a), is a time limit within the meaning of Article 48(1) and Rule 82.2(a).

The second question was whether, having regard to the wording of PCT Article 11(1), the Office's power to excuse a delay in meeting a time limit under PCT Rule 82.2(b) extends to according an international application a date of filing which is earlier than its date of receipt.

However, since I have found that there was no evidence of an interruption in the mail service within the terms of PCT Rule 82.2 and no other relief is available by way of discretion under Article 48(1), I do not have to decide either of the above questions.

Mr. Gee also contended that the international application should be deemed to have a filing date of 16 December 1993 in accordance with rule 97 of the 1990 Rules 1990. This reads:

97. Any notice, application or other document sent to the Patent Office by posting it in the United Kingdom shall be deemed to have been given, made or filed at the time when the letter containing it would be delivered in the ordinary course of post."

He drew attention to the fact that the rule referred to any application sent to the Office by posting it in the United Kingdom and submitted that it therefore applied to international applications as well as applications under the Patents Act 1977 (the "1977 Act"). He also drew attention first to the fact that section 123 of the 1977 Act gave the Secretary of State the power to make rules in relation to international applications and second to the following definition in section 130(1) of that Act:

"date of filing" means –

(a) in relation to an application for a patent made under this Act, the date which is the date of filing that application by virtue of section 15 above; and

(b) in relation to any other application, the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing that application or is equivalent to the date of filing an application in that country (whatever the outcome of the application).

Having considered the matter, I find that I am unable to accept Mr. Gee's contention on this point. Thus, the matter at issue is the filing date to be accorded to the international application by the Office in its capacity as receiving Office under the PCT. In accordance with PCT Article 11(3), this international filing date is then considered to be the actual filing date of a regular national filing in each designated State, that is each State designated in Box V of the application Request Form.

PCT Article 11(1) stipulates that:

"The receiving Office shall accord as the international filing date the date of receipt of the international application" subject to certain conditions as to the applicant's right to file and the language and content of the application being satisfied.

Although PCT Article 11(2)(b) provides for according later date in the event of the receipt of a required correction, there is no express provision in either the PCT itself or the Regulations under that Treaty for according a date of filing earlier than the date of receipt. Mr. Gee drew my attention to the presence in the 1990 Rules of rules 117 to 122 under the heading "INTERNATIONAL APPLICATIONS" and to rule 99 on excluded days which of necessity applied to international applications as well as to UK national applications. He submitted that by analogy rule 97 also applied to international applications.

However rule 117 prescribes English as the language for the purpose of PCT Article 11(1)(ii) and the provision of the number of copies of the application having regard to PCT Article 12. Similarly, rules 118 to 122 prescribe the fees and procedure for the implementing the particular PCT Rules specified in rules 118 to 121. Finally, rule 99, although not under the heading "INTERNATIONAL APPLICATIONS" applies to such applications by virtue of PCT Rule 80.5 which regulates the situation when a period expires on a non-working day.

In contrast to the position under the above United Kingdom rules, I am unable to find any authority under the PCT itself or its Regulations for according an international application an international filing date earlier than the date of receipt under rule 97 of the 1990 Rules. Accordingly, I am of the view that if a delay in the receipt of an international application is to be excused, this can only be done under the PCT itself.

I therefore find that there is no power for the Office to deem an international filing date of 16 December 1992 under rule 97 of the 1990 Rules.

Mr. Gee did not pursue his previous request for discretion to be exercised under rule 100 of the Rules and no evidence of the alleged irregularity in or before the Office has been adduced. Accordingly, I do not need to consider the matter further. I am re-enforced in my view that national law under rule 97 is not applicable in according an international filing date by Article 48.2 which reads:

"(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." (emphasis added).

As is apparent, this Article expressly limits the effect of excusing the delay to the Contracting State in question. In contrast, if the Office were to accord the international application an earlier filing date of 16 December 1993 under UK rule 97, this date would apply in all designated States by virtue of Article 11(3) and not just the United Kingdom.

At the hearing Mr. Gee requested that if the application in suit were to be refused an international filing date of 16 December 1993, the Office should accord the application that filing date under Rule 48.2 for the purposes of the United Kingdom only. However, this was not a matter before me for decision at the hearing and Mr. Gee agreed that, if necessary, the request should be remitted to the international unit of the Office for consideration,

In consequence of the above, I find that the Office correctly accorded the date of actual receipt on 17 December 1994 as the filing date of the international application in suit.

The consequences of this as regards the priority claim are as follows. PCT Rule 4.10(d) provides that:

"(d) If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within one month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled ex officio.

Accordingly, in consequence of my finding that the filing date of the application in suit is 17 December 1993, I also find that the declaration of priority under Article 8(1) in respect of the six earlier applications having a filing date of 16 December 1992 should be cancelled ex officio in accordance with Rule 4.10(d). As a result, the priority date of the international application for the purpose of international publication under PCT Article 21(2)(a) and other purposes will be the filing date of the earliest of the two remaining priority applications, namely 21 December 1992.

In the High Court, Colin Birss instructed by Winter Myersonon appeared for the applicant (applicant for judicial review). Michael Silverleaf instructed by the Treasury Solicitor appeared for the comptroller (respondent).

Aldous J:- By notice of motion dated 1 July, 1994, Archibald Kendrick & Sons Ltd, sought judicial review of s decision dated 31 May 1994 of Mr. Leslie Lewis, a principal examiner acting for the Comptroller.

The background to this appeal is not in dispute and because it is fully set out in the decision, I need only refer to the basic facts.

Archibald Kenrick & Sons Ltd., which I will call the applicant, filed an application for a patent on 16 December, 1992. On 15 December 1993, agents acting for the applicant posted an international application to the Patent Office claiming priority from the application that had been filed on 16 December, 1992. In normal course of post, the 1993 application would have been received at the Patent Office on 16 December, 1993, with the result that it would have been received within a year of the filing of the 1992 application. In those circumstances, priority from the 1992 application could be claimed. Unfortunately the package was damaged and the application was delayed in the post with the result that it was not received until 17 December, 1993. That was, the date which the Patent Office recorded as the date of receipt.

The applicant was not satisfied and sought to persuade the Patent Office that the correct date of receipt to accord the application was 16 December, 1993. The Patent Office refused and a hearing was appointed at which the applicant submitted that the correct date of receipt to be accorded to the application was the 16 December 1993 and not the date that it was actually received, namely 17 December 1993. That submission was rejected by the principal examiner.

International applications are governed by the Patent Co-operation Treaty (PCT) which the United Kingdom ratified in 1977. That Treaty contains provisions intended to avoid unnecessary formalities and searching in different national patent offices where international patents are sought. Its Articles are essentially

procedural. Thus Article I provided that States who are parties to the Treaty, called Contracting States, constitute a union for co-operation in the filing, searching and examination of applications for patents. Article 2 contains definitions. Article 3 enables applications for protection of inventions in any Contracting State to be filed as an international application under the Treaty and sets out in broad terms the required form of such an application. Article 8 enables the international application to contain a declaration claiming priority of one or more early applications filed in any country a party to the Paris Convention. The effect of such a declaration is set out in Article 4 of the Stockholm Act. In essence, priority can be claimed from an earlier application filed not more than one year before.

Article 10 states that the international application shall be filed with the prescribed receiving Office. The receiving Office is defined as the national Office which in this case was the Patent Office.

Article 11 provides:

"The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt.

.....

(3) subject to Article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph I and accorded an international filing date shall have the effect of a regular national application in each designated State as the international filing date, which date shall be considered to be the actual filing date in each designated State.

(4) Any international application fulfilling the requirements listed in items (i) to (iii) of paragraph I shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property "

The Patent Office received the application on 17 December 1993 and accorded it that date as the international filing date.

Article 48 provides for delay in meeting certain time limits. It states:

"I Where any time limit fixed in this Treaty or the Regulations is not met because of interruption in the mail service or unavoidable loss or delay in the mail, the time limits shall deem to be met in the cases and subject to the proof and other conditions proscribed in the regulations.

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 sub-paragraph (a), any delay in meeting any time limit."

That Article enables any Contracting State to excuse delay for patents to be granted in that State, but it is only Article 48(1) which applies to delays in meeting a time limit which, for instance, would affect applications in other member States. It follows that the application for priority claimed by the applicant can only be excused under Article 48(1). It is therefore necessary to look to the Regulations to decide whether the delay in receipt can be excused so that the application can be accorded a filing date of 16 December 1993.

The relevant regulations are contained in PCT, Rule 82. It is now accepted that only Rule 82.2 could be relevant. It provides:

"(a) Any interested party may offer evidence that on any of the ten days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.

(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organisation which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organisation that the effected the mailing within five days after the mail service was resumed. The provisions of Article 82.1(c) shall apply *mutatis mutandis*."

The applicant submitted that the words "or other like reason" should be construed as covering delay caused by the Post Office putting the package aside for repair. That submission is untenable. Delay due to damage to a package is nothing like interruption of the service on account of war, revolution, civil, disorder, strike, or natural calamity. In any case, Rule 82.2(a) only relates to interruptions of the postal service, not to mistakes or variations occurring when the service is being supplied. That is emphasised by sub-paragraph (b) of the Rule which requires posting within five days after the mail service is resumed.

The PCT with its Rules contains a complete code for filing international applications. Article 11 required the Patent Office to accord the application with the international filing date of the date of receipt. That date was 17 December 1993. The reason for the delay cannot be excused under Rule 82 and therefore the Patent Office could not deem the application to have been received on the 16 December 1993, as the applicant wishes.

The applicant also submitted that rule 97 of the Patent Rules applied and that being so, the Patent Office should have accorded the 16 December 1993 as the date of receipt.

The Patents Act 1977 is an Act "to establish a new law of patents applicable to future patents and applications for patents to amend the law of patents applicable to existing patents and applications for patents; to give effect to certain international conventions on patents; and for connected purposes." Essentially it deals with patents having effect in the United Kingdom, but in so doing it has to deal with the obligations imposed by certain conventions.

Rule 97 was made under the power given in section 123 which states:

"123.(1) The Secretary of State may make such rules as he thinks expedient for regulating the business of the Patent Office in relation to patents and applications for patents (including European patents, applications for European patents and international applications for patents) and for regulating all matters placed by this Act under the direction or control of the comptroller, and in this Act, except so far as the context otherwise requires, 'prescribed' means prescribed by rules and 'rules' means rules made under this section....."

Rule 97 is in this form:

97. Any notice, application or other document sent to the Office by posting it in the United Kingdom shall be deemed to have been given, made or filed at the time when the letter containing it would be delivered in the ordinary course of post."

The applicant submitted that the international priority application sent to the Patent Office by the applicant was an application within rule 97 and therefore was deemed to have been delivered on 16 December 1993. That being so, the date to be accorded under Article 11 was 16 December 1993.

Rule 97 does not apply to applications for priority filed under the PCT. The PCT is a complete code. The Patent Office's jurisdiction to act as the receiving Office under the PCT, came from the PCT and, when so acting, it must apply the rules, regulations and conditions laid down in the PCT. It is not open to the receiving Office in one State to deem an international application to have been received on one day and another receiving Office in another State to apply a different rule. An essential aim of the PCT is to bring about uniformity. Further, Article 11 refers to the date of receipt, which must mean the date of

actual receipt, not a date on which delivery is deemed to have been made pursuant to rules of one State.

I have come to the same conclusion as the principal examiner. I do not believe that his decision can be faulted.

I refuse the application with costs.