

Abstract

Applicant's claimed priority to an earlier filed application was not perfected in the International Phase of the PCT due to the fact that the priority document was not filed within the 16 month time limit. Applicant's attempt to restore the priority claim during the national phase based on inadvertent procedures practiced during the national phase was incorrect. This ruling was based on the fact that an improper occurrence during the international phase may not automatically be remedied at the national phase.

THE UK PATENT OFFICE

In re: BROSSMANN'S APPLICATION

[1983] RPC 109

HEARING-DATES: 13 August 1982 13 August 1982

CATCHWORDS: Patent -- Application -- International application -- Priority document not filed in due time during international phase -- No discretion to permit filing of priority document during national phase -- Irregularities occurring during national phase not relevant. Patents Act 1977, section 89(1)(c). Patents Rules 1978, rules 6(2), (5), 100, 101. Regulations under the Patent Cooperation Treaty, rule 17.1(a), (c)

HEADNOTE:

In an international application a priority document had not been filed within the period prescribed in Patent Cooperation Treaty rule 17.1(a) and the International Bureau notified the applicant accordingly. The international application was subsequently published with particulars including the declaration of priority. A request for national processing of the international application was filed in due time at the U.K. Patent Office together with the requisite forms and fees for preliminary examination, search and substantive examination. A priority document and verified English translation were also filed at the Office on the same date. The application was republished as a U.K. national application having the priority date included among the particulars on the cover page. When no substantive examination report had been received four years three months after the declared priority date, the applicant's patent agents made enquiries as to the status of the application. They were informed that, subject to the applicant having an opportunity to be heard, the declaration of priority would be cancelled with effect prior to the date of publication of the application because the priority

document had not been filed in accordance with the prescribed requirement. A hearing was requested but not attended; submissions in writing were set out for consideration by the hearing officer.

Held:

(1) The applicant's failure, before the application entered the national phase, to meet the requirements of Patent Cooperation Treaty rule 17.1(a) had the consequence that the provision of rule 6(5) of the Patents Rules 1978 could not be invoked to enable the requirement of rule 6(2) to be treated as having been complied with.

(2) Irrespective of the reasons underlying the applicant's failure to observe the relevant rules, or of any irregularities that might have occurred since, the Comptroller did not have, and had not had, any discretion under rule 100 to extend the prescribed { 110 } period for more than the month allowed under rule 110(3) and this additional month had in any event passed before the national filing took place.

Energy Conversion Devices Inc.'s Applications [1982] F.S.R. 544 (overruling Fater S.p.A.'s Application [1979] F.S.R. 647), applied.

(3) To attempt to apply rule 101 to extending periods of time would be stretching it unduly and in an unwarranted manner.

(4) It was not necessary to decide whether rule 101 might provide the Comptroller with discretion to dispense with the filing of the priority document altogether, because no adequate justification within the terms of the rule had been put forward to enable such discretion to be exercised in the applicant's favour.

(5) Inclusion of the priority data when the application was republished under the national procedure had been an irregularity in the Office and the Comptroller should exercise the discretion allowed by rule 100 to rectify it. This would be done in part by cancelling the declaration of priority with effect prior to publication. To apprise the public of the situation, an appropriate erratum should be issued and advertisement made in the Journal.

INTRODUCTION: This was a decision by Mr. A. McDowell, Principal Examiner acting for the Comptroller, in application No. 7935484 of E. K. Brossmann which originated as international application No. PCT/DE79/00017 and was published with a declaration of priority from application No. P2806337.8 filed in the Federal Republic of Germany.

PANEL: MR. A MCDOWELL, Principal Examiner

JUDGMENTBY-1: Mr. McDowell

JUDGMENT-1:

Mr. McDowell – The present application originated as an international application under the Patent Cooperation Treaty having the number PCT/DE79/00017 and filed at the Patent Office of the Federal Republic of Germany as the receiving Office on 14 February 1979, the United Kingdom being one of the States designated. A declaration of priority claiming a date of 15 February 1978 was made based on application No. P2806337.8 also filed in the Federal Republic of Germany. The applicant was notified by a communication from the International Bureau dated 25 June 1979 that the period prescribed by the Treaty for filing a copy of the priority document with the Bureau had expired without this document having been filed. The international publication took place on 6 September 1979.

A request for national processing was filed at this Office on 15 October 1979 and the relevant conditions of section 89(4) of the Act were complied with. On the same date a certified copy of the priority document together with a verified English translation were also filed at this Office. Within the periods prescribed by the Act the requisite forms and fees for preliminary examination, search and substantive examination were filed.

Republication of the application as a U.K. national application having the application No. 7935484 took place on 2 July 1980, the previously declared priority data still being included amongst the biographical particulars on the cover page. Subsequently the internal records of the Office were amended to remove the priority designation and thereafter the application was dealt with as one without priority, the period prescribed by rule 34(1) thus being calculated to run from the date of filing i.e. 14 February 1979.

On the other hand it appears that, notwithstanding the communication of 25 June 1979 from the International Bureau, the applicant assumed that the declared priority date of 15 February 1978 had been accorded, being encouraged in this assumption by the republication of the priority data referred to above. When, therefore, no substantive examination report had been received by 20 May 1982, some 4 1/4 years after the declared priority date, the agent Mr. Hartley of Withers & Rogers telephoned the Office to enquire as to the status of the application. As a consequence the applicant was informed by a letter dated 26 May 1982 that:

"since the certified copy of the German priority application No. P20806337 was not filed in accordance with the prescribed requirement, that application will be cancelled as the declaration of priority unless you apply to be heard within four weeks from the date of this letter. The cancellation will take effect prior to the publication of the application in suit."

In reply the applicant pointed out that "the priority claim was acknowledged in the printed specification as published on 2 July 1980 under the number 2037072A and that we heard nothing further until after our telephone enquiry of 20 May 1982" and requested a hearing. The hearing was set for 23 July 1982 but on 22 July the agents filed a letter stating that they had received instructions not to attend the hearing, but setting out submissions for consideration thereat.

Turning now to the relevant legislation for this type of application, section 89(1)(c) of the Act reads as follows:

"(c) Any declaration of priority made under the Treaty shall be so treated as a declaration made under section 5(2) above;"

Thus the declaration of priority previously made in the international application is to be treated as though it had been made under section 5(2) of the Act. This section provides that if a declaration is made "complying with the relevant requirements of rules and specifying one or more earlier relevant applications" and certain other conditions are complied with then "the priority date" shall be "the date of filing the relevant application".

The relevant requirements of rules are set forth in rule 6(1) and (2). Sub-rules (1) and (2) require inter alia a declaration of priority to be made at the time of filing and a duly certified copy of any application specified in the declaration to be furnished to the Office within the period of 16 months after the declared priority date. However sub-rule (2) is subject to the provisions of sub-rule (5) which reads:

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

Rule 4.10(a) and (c) of the Treaty Regulations requires certain statements to be made in respect of a priority declaration. Rule 17.1(a), which applies to the

present case, requires that the priority document "shall, unless already filed with the receiving Office together with the international application, be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 {112} months after the priority date". It is this latter requirement that the applicant failed to meet according to the Notification of 25 June 1979 issued by the International Bureau.

Treaty rule 17.1(c) specifies that the consequence of such failure is that "any designated State may disregard the priority claim". Thus it is clear from the foregoing that the applicant's failure to meet the requirements of Treaty rule 17.1(a) had the consequence that the provision of rule 6(5) could not be invoked to enable the requirement of rule 6(2) to be treated as having been complied with. It is pertinent to what follows that this failure, with its attendant consequences, occurred before the application entered the national phase.

Considering now the agents' submissions, they first state:

"Although we have the impression that there are extenuating circumstances surrounding the late filing of the convention documents with WIPO, we do not have specific instructions as to the precise circumstances."

This is vague and unhelpful. If there were extenuating circumstances they should have been presented to the International Bureau, or submitted to this Office in support of a plea for retention of priority at the time of entering the national phase. In fact the matter was not brought to the Office's attention at that time, the application and priority documents merely being filed without any accompanying explanation or submission. The agents continue:

"The fact that the convention documents were filed late was appreciated at the time of conversion to a U.K. National Application and it was only for this reason that the convention documents were filed at the U.K. Office.

"We understood that the U.K. Patent Office would consider the particular circumstances with a view to allowing the claim to priority, provided the convention documents were filed within the period allowed for conversion to the National phase of the International application."

They do not say why they understood the Patent Office would consider the matter in the manner suggested, but assuming that they had reason, this amounts as I see it to no more than an assurance that the Office would be prepared to consider the matter in the light of the particular circumstances. To my mind it certainly would not obviate the need for the applicant to formally raise the matter with the Office.

The agents have also pointed out that the Rules operative at the material date were the Patents Rules 1978 and I accept that it is this form of the rules which I should apply in the present matter. They have also referred to the then prevailing precedent of the judgement given in Fater's Application [1979] F.S.R. 647 which, if I understand them correctly, they imply should somehow retain its precedent effect in relation to the present matter notwithstanding the fact that it has subsequently been overruled. The latter part of their letter reads:

"Further, it is submitted that the applicant should not suffer, as a result of undue pressure of comply with restricted time limits, by forfeiting his claim to convention priority without a full hearing on the point and secondly that the applicants rights should not be prejudiced merely because of intervening {113} judgements in higher courts, when he acted in accordance with the best advice available at the relevant date and received no indication meanwhile that subsequent decisions would put at risk these rights.

"It is beyond dispute that irregularities have occurred within the Patent Office and for this reason we submit that the Comptroller has discretion under Rule 100 or Rule 101 to vary any prescribed time limit or indeed any other requirement of the Patent Rules, to safeguard the rights of the applicant."

I cannot accept this. I consider myself bound to take account of the intervening judgement of higher courts and in particular that recently given in Energy Conversion Devices Incorporated [1982] F.S.R. 544 wherein Lord Diplock pronounced as follows:

"An irregularity in procedure is simply a failure to observe procedural rules, whatever the cause of the failure may be. Where there is a discretion to rectify the failure, the reason for it may be of the utmost relevance to the way in which that discretion should be exercised; but if rule 100 confers upon the comptroller jurisdiction to excuse failure to observe a time limit which is made inextensible by rule 110(1) and (2), on the ground that it is an irregularity in procedure, that jurisdiction must extend to all such failures whatever the reason for them may be, with the result of rendering the express prohibition of extensions of specified time limits by rule 110(1) and (2) wholly nugatory. So to construe rule 100 in relation to rule 110 would be to turn on its head the well-established canon of construction *generalia specialibus non derogant*."

The provisions for extending the period prescribed by rule 6(2) are set out in rule 110(1) and (3). The latter sub-rule reads:

"(3) The period prescribed in rule 6(2) above may be extended for not more than one month upon filing Patents Form No. 50/77."

Sub-rule (1) clearly stipulates that the discretion it allows to the Comptroller to extend prescribed periods is "subject to sub-rule (3)".

In the light of the foregoing it is clear that, irrespective of the reasons underlying the applicant's failure to observe the relevant rules, or of any irregularities that may have occurred since, the Comptroller has, and had, no discretion under rule 100 to extend the prescribed period for more than the month allowed under the provision of rule 110(3) and this additional month had in any event passed before the national filing took place.

The agents also refer to the Comptroller's discretion under rule 101 which reads as follows:

"101 Where, under these rules, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, and it is shown to the satisfaction of the comptroller that from any reasonable cause that person is unable to do that act or thing, or that document or evidence cannot be produced or filed, the comptroller may, upon the production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the production or filing of such document or evidence."

This rule does not refer to extending periods of time and I think it would be stretching it unduly and in an unwarranted manner to attempt so to apply it.

The rule gives the Comptroller the authority to exercise discretion only when (considering the present case) it is shown to his satisfaction that from a reasonable cause the required document could not be filed. This has not been shown in respect of the filing of the document at the material time, nor has it been affirmed that such was the case. If one assumes that rule 101 might provide the Comptroller with discretion to dispense with the filing of the priority document altogether, this being a matter on which I do not feel it necessary for me to come to a conclusion, no adequate justification within the terms of the rule has been put forward to enable me to exercise such discretion in the applicant's favour. I would certainly not regard the fact that the applicant was unable to meet the requirement of rule 6(2) at the date of the national filing as

being of itself, a reason for exercise of discretion, since to do so would make a nonsense of the provision of rule 6(5) by rendering the rule unnecessary.

It is alleged that irregularities have occurred within the Office and I accept that this is so. Undoubtedly the priority data should not have been included when the application was republished under the national procedure. Also it would have been proper and reasonable to have informed the applicant as soon as possible that, since he had failed to meet the Treaty requirements in respect of the declaration of priority, he was not entitled to the declared priority date. This, I understand, is the normal procedure now adopted by the Office in such cases.

Unfortunately in October 1979 the Office had very limited experience of international applications entering the national phase so that correct procedures were not well established. Thus the need to be alert to the fact that the published international application retains the declared priority data, even though the relevant conditions may not have been fulfilled, had not been fully appreciated by those concerned with preparations for printing and this, coupled with the fact that the priority document and translation were included in the national filing, almost certainly contributed to the Office's error although this does not, of course, excuse it. Be that as it may, it cannot be argued that the Office's error had any bearing whatsoever on the applicant's loss of priority, since the failure giving rise to this loss occurred whilst the application was still in the international phase. It is regrettable that the error occurred, but if the applicant has in fact suffered as a result of this irregularity it must be in other respects.

It would indeed be proper for the Comptroller to exercise the discretion allowed by rule 100 to rectify the irregularity which has taken place. This was in part done by the Office's communication to the applicant on 26 May 1982 stating that it was proposed to cancel the declaration of priority with effect prior to publication. This action appears to be correct, having regard to rule 2(a), since the priority date in question was, in effect, "lost" before completion of preparations for publication in accordance with section 16 of the Act.

It is also desirable that the public should be apprised of the situation and to this end an appropriate erratum should be issued and advertisement made in the Journal. It is possible that adverse effects might result to third parties as a result of the erroneous publication. There seems no way of rectifying this other than that which I have just indicated.

The remaining submissions in the agents' letter appear to be totally without foundation. The assertion that the applicant has at all times acted properly in this matter is refuted by the fact that the loss of priority resulted solely from his failure to comply with the requirements of the Treaty. Furthermore, as already

mentioned, it seems likely that the manner in which the national application was filed contributed to the subsequent irregularity in publication.

I must confess that I do not know what is meant by the reference to "undue pressure to comply with restricted time limits". I can find no indication that any such pressure has been put upon the applicant nor any way in which the statutory time limits were restricted. Nor is the applicant being required to forfeit his claim to priority without a "full hearing" since a hearing was offered, accepted, and then a time having been set, he chose not to attend nor be represented without giving any reason, unless the somewhat puzzling reference to his being "away on holiday and unobtainable" has some bearing on this.

I conclude, then, that the declared priority must be deemed to have been lost before preparations for publication of the present application under section 16 were completed and so I decide. The remedial action in respect of the irregularity in publication set out above should be effected by the Office after the period for appealing against this decision has passed provided no such appeal has been duly filed.

DISPOSITION: Judgment accordingly.