

Abstract

In reviewing an administrative decision, the Court supported the omission of the selection of 2 designated offices as being a “not obvious” error.

R v THE COMPTROLLER-GENERAL OF PATENTS *ex parte* CELLTECH
LIMITED

QUEEN'S BENCH DIVISION

[1991]RPC 475

HEARING-DATES: 21 May 1991

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CATCHWORDS: Patents -- Application for judicial review -- International application -- Patent Cooperation Treaty -- Mistake by agents in failing to designate two contracting states by use of superseded form -- Whether obvious error-Application dismissed. Patent Cooperation Treaty Rules Rules 91.1.

HEADNOTE: The applicants had instructed their patent agents to prepare and file three international applications for patents by the procedure under the Patent Cooperation Treaty. The applicants instructed the agents to designate all PCT contracting states. The partner concerned had left it to his secretary, who had had experience in the filling in of the forms, to fill in the Request (PCT/RO/101) forms. In two cases the secretary had used the 1990 version of the form, but in one case she had used the 1987 version of the form. The difference between the two forms was that between the dates when they were issued Canada and Spain had joined the PCT, and thus the 1987 form did not contain the names of these countries in the list of contracting states. The three forms were completed in the same way, with crosses being placed against all listed countries and Greece being added as she had joined the PCT after issuance of the 1990 form. Thus the two applications filed on the 1990 form had designated Canada and Spain, but the application filed on the 1987 form had not.

When the mistake came to light the agents applied to rectify the mistake, together with certain other errors. The Patent Office allowed the other errors to be corrected but not the omission of Canada and Spain. After a hearing, the Superintending Examiner upheld that decision. The applicants applied for judicial review of the Superintending Examiner's decision, contending that the omission of Canada and Spain should be rectified as an obvious error pursuant to Rule 91.1 of the PCT Rules.

Held, dismissing the application,

(1) The purpose of the Rule was to enable errors to be corrected which were obvious and could not mislead. What had to be obvious was not simply that there had been an error but also what the error was so that it could be rectified. If extraneous evidence of the applicant's intention was necessary to show that there had been an error, then that error could not have been an obvious error. The error must be apparent from the document.

(2) The correct standard of proof was the normal standard, namely the balance of probabilities. The correct question to be asked was: on the balance of probabilities would the reader of the application conclude that there was an obvious error?

(3) The reader, upon analysing the application in question, would be surprised that Canada and Spain had not been added to the form and would conclude that there might have been an error. He would not, however, have concluded that there was an obvious error as there were legitimate reasons as to why the applicants could have excluded Canada and Spain. The Superintending Examiner's decision was therefore correct.

INTRODUCTION: Mr CP Mercer of Carpmaels and Ransford appeared for the applicants.

Mr BG Harden: International application No PCT/GB 90/02017 was filed at the United Kingdom Patent Office acting as the receiving Office on 21 December 1990 with Celltech Limited being named as applicants for all countries apart from the United States of America. The application claimed priority from GB application 8928874.0 filed on 21 December 1989.

The request form PCT/RO/101 contained at Box No V a number of boxes by which the applicants could designate the states, or groups of states, for the purpose of the international application. All of the boxes appearing at Box No V received a cross, thus the request designated all the listed countries and groups of countries. In addition Greece was inserted in the "Space reserved for designating States (for the purposes of a national patent) which have become party to the PCT after the issuance of this sheet". The printed sheet carried the issuing date of July 1987. The box for designating a European Patent was followed by a list of states which were parties to both the PCT and the European Patent Convention (EPC) at the time of issuance of the sheet, and by a dotted line for the addition of other Contracting States of the EPC which had become

party to the PCT after issuance of the sheet. No states had been inserted on the dotted line.

In a letter dated 23 January 1991 the agent of the applicants, Mr Mercer of Carpmaels and Ransford, informed the Office of mistakes in the designation due to an out of date version of the request form having been used. He requested that the form be amended by adding the designation of Canada and Spain as national applications, and Greece, Spain and Denmark as designated states within the EPC designation.

His request was not initially accepted by the receiving Office because, under the PCT, designation must be made at the time of filing the application, and, for rectification of errors to be permitted under PCT Rule 91.1, they must be obvious.

The applicant requested a hearing and the matter came before me on 10 May 1991 when Mr CP Mercer appeared as patent agent for the applicant and Mr L Higgins appeared for the PCT receiving Office of the Patent Office.

At the start I pointed out that there was no specific provision for hearings under the PCT but that it was customary (as in the present case) for the UK Patent Office to offer informal hearings on matters concerning its PCT receiving Office functions.

After hearing Mr Mercer I gave an oral decision that I was not satisfied that the request for correction of the designation on the request form met the criteria for the rectification of obvious errors in documents as set out in paragraphs (a) and (b) of Rule 91.1. I accordingly refused to authorise on behalf of the receiving Office the request for rectification. I stated I would issue a statement of reasons for the refusal.

The PCT requires that an international application filed with a receiving Office shall comprise a request, a description, one or more claims, drawings (where required), and an abstract. According to Article 4(1), the request shall contain (inter alia):

"(ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States"); . . . "

Rule 4.9 reads:

"Contracting States shall be designated in the request by their names."

The effect of these provisions is that all designations must be made by name in the international application when filed; none can be added later. This is made clear also in the footnotes to the Articles of the Patent Cooperation Treaty on page 16 of the Records of the Washington Conference, 1970.

It is also important to note that the reason for this is that, under Article 11(3), any international application fulfilling the listed requirements and accorded an international filing date has the effect of a regular national application in each designated State as of the international filing date, which is considered to be the actual filing date in each designated State.

Provision for the correction of errors is made by Rule 91 of the PCT. The relevant passages of the rule are as follows:

Rule 91

Obvious Errors in Documents

Rule 91.1 -- Rectification

(a) Subject to paragraphs

(b) to (gquater), 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.

(d) Rectification may be made on the request of the applicant . . .

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

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

In addition, paragraph (f) provides that where the authorization is refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (gbis), (gter) or (gquater) 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.

Mr Mercer submitted that rectification of the request form under Rule 91.1 by the addition of the further designations, if the requirements of the rule were met, should be allowable despite the requirement that states should be designated at the time that the international application was filed. I agreed. The only point in issue was whether the criteria of paragraphs (a) and (b) of Rule 91.1 were met for the rectification to be authorised by the receiving Office.

Mr Mercer contended first that it was obvious from the request form that there was an error, and secondly that the rectification itself was obvious. As to the former the requirement of paragraph (b) for an error to be obvious is whether "something other than what was obviously intended was written in the international application or other paper".

He argued that the use of an out of date form itself demonstrated that an error had obviously been made. He also relied on the designations made. All the designation boxes had been ticked and Greece had been added as a national designation but not Spain and Canada. He explained that Spain and Canada had become parties to the PCT between the issue of the out-of-date form actually used and the current form and boxes were accordingly provided for Spain and Canada on the current form. Greece on the other hand had become a party after issue of the current Form. Hence the fact that Greece and not Spain and Canada had been added made it obvious from the face of the document that the current form had been intended to be used. It would have been absurd, he asserted, not to have intended to designate Spain and Canada while designating all the other countries including some very minor ones.

Mr Higgins on behalf of the receiving Office pointed out that the use of out of date forms was specifically allowed while agents and applicants had stocks, that space was provided for new member states to be added to the Form, and hence that the use of an out of date form did not itself indicate an error had been made.

I agree with Mr Higgins that the use of an out of date form does not necessarily indicate that an error had been made, even if, as asserted by Mr Mercer, current forms had been used on other cases filed at the same time by the agents.

The argument based on the choice of designations used is more convincing and the choice might indeed have made a reader, once alerted to the situation, wonder whether an error had been made. However, the possibility that an error might have been is not sufficient, in my view, to meet the criterion of an error being obvious, ie "something other than what was obviously intended was written". A possibility, or even a probability, that an error might have been made does not prove an obvious intention. The applicants, for a variety of reasons,

might have intended not to obtain patent protection in Spain and Canada by means of an international application. This possibility, while not in line with the maximum choice of the designations on the out of date form nevertheless exists. I am therefore not satisfied that the request form filed proves the intention to designate all the member states of the PCT at the time of the filing.

Mr Mercer referred to the evidence of the applicants' instruction to him to designate all states. A copy of the instruction had been filed with his letter of 23 January 1991. He did not, as I understand him, rely on this evidence as an alternative to his submissions that the request form indicated an obvious error. His attention had been drawn to an earlier decision of this receiving Office dealing with another request to correct designations. In that decision (PCT/GB 89/01122: Keith William Henderson -- SR1S reference 0/17/90) the hearing officer stated:

In dealing with this question I must, I think, give some weight to the limitation of the whole of the PCT Rule 91.1 to "obvious" errors. Some meaning must be assigned to the particular words chosen and I note that the word "obvious" is used in both Rule 91.1(a) and (b) and in the latter sub-rule both in relation to the existence of an error and its rectification. If I were to construe the rule as meaning that an error can be corrected provided evidence of the original intention of the applicant was provided I think I would be overlooking the word "obvious" entirely. To say that an error is obvious merely because it can be proved subsequently what the original intention was, seems to me to embody a fundamental contradiction. In my view the rule must mean that both the error and its rectification must be self-evident from the document originally filed.

I must conclude therefore that I cannot take the later evidence of the filing instructions into account in deciding the matter before me and that there is now no reason to call for a sworn declaration concerning the authenticity of these instructions.

I agree with the view expressed by the earlier hearing officer and therefore consider Mr Mercer right in not alternatively basing his submission on the filing instructions alone.

Since I have decided that the error was not obvious it logically follows, I think, that the rectification can not be obvious. Whether this logically follows or not, in fact I do not consider that anyone would immediately realise from the documents received by the Office on the filing date that nothing else could have been intended than what was subsequently offered as rectification.

At the hearing, after giving my decision refusing to authorise the rectification, I reminded Mr Mercer of the provisions of paragraph (f), and also of the imminent

expiry of the periods specified in paragraph (g) and (gbis) relevant not only to any judicial review on this decision but also to the provisions of paragraph (f).

Finally I would mention that, although I have found that the provision of Rule 91.1 could not assist the applicants in this case, I consider this is a case where Rule 91.1 bears somewhat severely on applicants and I would have assisted them if I could.

COUNSEL: Nicholas Pumfrey, QC and Presily Baxendal for the applicants; Michael Silverleaf for the comptroller.

PANEL: Aldous J

JUDGMENTBY-1: ALDOUS J

JUDGMENT-1:

ALDOUS J: The applicants Celltech Limited sought leave to apply for judicial review of a decision of Mr BG Harden a superintending examiner acting for the Comptroller. I gave leave and as the matter was urgent went on to hear the application.

The superintending examiner in his decision refused to amend a form filed with the Patent Office because he concluded that he had no jurisdiction to do so. The applicants submitted that his decision was wrong. To understand their submission it is necessary to have some familiarity with the way that patents can now be obtained in a number of states.

The Patent Cooperation Treaty ("the PCT") was constituted for cooperation in the filing, searching and examination of international applications. The United Kingdom has since 1977 been a signatory to the PCT.

The basic scheme of the PCT is that an applicant for a patent applies to his local patent office and fills in a form if he wishes to make "an international application" enabling him to claim priority in designated states. That local office is by an agreement with WIPO designated as a receiving office for the purpose of international applications. The receiving office checks the application to see that it complies with the formalities required under the PCT and PCT rules and, if so, gives to the application an international filing date. Thereafter the receiving office sends one copy of the application to the International Bureau in Geneva and another to the International Searching Authority which searches for prior art which might throw doubt on the validity of the invention. The result of that search is then forwarded to all the patent offices of the states which the

applicant has designated in its application as a country in which patent protection is to be sought. The local patent offices thereafter take over the application and provided the application satisfies the law of the relevant country a patent is granted in that country with a priority date of the date of the international application.

Articles 3 and 4 of the PCT lay down that the international application has to contain certain information including a designation of the contracting states in which protection of the invention is sought. To enable this to be done a form called PCT/RO/101 is available which is completed and filed together with a copy of the specification.

The applicants are one of the leading United Kingdom companies in the biotechnology field. Their principal business is the production of monoclonal antibodies. They believed that they had invented improvements in the technique of antibody engineering and instructed the well-known firm of patent agents, Carpmaels & Ransford, to prepare and file three patent applications relating to those improvements. On 21 December 1990, those patent agents filed three applications at the United Kingdom patent office using three PCT/RO/101 forms to which were attached the patent specifications. The applicants had instructed the patent agents to designate all PCT contracting states. The partner concerned left it to his secretary, who had had experience in filling in the forms, to fill in the PCT/RO/101 forms which she did. As it turned out she used two 1990 versions of the form, but for the other application she used the superseded 1987 version. The only relevant difference between the two forms was in Box V. Box V of both forms contained a list of the states that were parties to the Treaty and a space at the bottom in which the names of states which had become parties to the PCT after issuance of the form could be added. Thus an applicant can indicate by making a cross against the state which it wished to designate as a state in which it required national patents and add, at the bottom, the name of any other state which had become a party to the Treaty since the form was issued.

Canada and Spain joined the PCT between the date when the 1987 and 1990 PCT/RO/101 forms were issued. Thus those states appeared in the list of states on the 1990 form, but not on the 1987 form.

The three applications made on behalf of the applicants were completed in the same way. Crosses were placed against all the listed countries and Greece was added as she had joined the Treaty after issuance of the 1990 form. Thus the two applications which were filed using the 1990 version of the form rightly designated all the states of the PCT, but as the 1987 form did not list Canada and Spain, those countries were not designated for the third application. That came

to light when the patent agents came to enter details of the application into their computerised record-keeping system. The patent agents therefore wrote to the Patents Office and applied to rectify the mistake in the third application and other errors which had occurred. The Patent Office allowed the application to be amended by insertion of the title and correction of a name of an inventor, but refused to allow Canada and Spain to be added. After an oral hearing the superintending examiner issued his decision upholding the refusal of the Office and that is the decision to be reviewed.

There is no doubt that an error was made. Further it is an error which should be rectified, if power to do so is given in the rules. The superintending examiner said that he would have assisted the applicants to rectify the error, but that he could not do so as no provision was made in the rules for rectification of such an error.

Rectification is provided for in Rule 91.1 of the PCT Rules. 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.

"(c) Omissions of entire elements or sheets of the international application, even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable.

"(d) Rectification may be made on the request of the applicant. The authority having discovered what appears to be an obvious error may invite the applicant to present a request for rectification as provided in paragraphs (e) to (g quater). Rule 26.4(a) shall apply mutatis mutandis to the manner in which rectifications shall be requested.

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

"(i) of the receiving Office if the error is in the request,

"(ii) of the International Searching Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority,

"(iii) of the International Preliminary Examining Authority if the error is in any part of the international application other than the request or in any paper submitted to that Authority, and

"(iv) of the International Bureau if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau."

The superintending examiner held that rectification was only possible under the rule, if it was apparent from the form that there was an obvious error and that consideration of the form did not show any obvious error. Therefore he refused the application to rectify.

On behalf of the applicants, it was submitted that when deciding whether there was an obvious error, it was permissible to look at the instructions to and the intention of the person filing the application and, if so, it was clear there was an obvious error. Alternatively, it was submitted that if the error had to be apparent from the form, then the applicants had established that there was an obvious error. It was submitted that the superintending examiner had come to a wrong conclusion as he had applied the wrong standard of proof and failed to take into account all the relevant matters.

As to the submission that it is possible when applying Rule 91.1 to consider the instructions to and intention of the patent agents making the application, the superintending examiner endorsed the view expressed in an earlier unreported decision of the Patent Office which stated:

"In dealing with this question I must, I think, give some weight to the limitation of the whole of PCT Rule 91.1 to 'obvious' errors. Some meaning must be assigned to the particular words chosen and I note that the word 'obvious' is used in both Rule 91.1(a) and (b) and in the latter sub-rule both in relation to the existence of an error and its rectification. If I were to construe the rule as meaning that an error can be corrected provided evidence of the original intention of the applicant was provided I think I would be overlooking the word 'obvious' entirely. To say that an error is obvious merely because it can be proved subsequently what the original intention was, seems to me to embody a fundamental contradiction. In my view the rule must mean that both the error and its rectification must be self-evident from the documents originally filed.

"I must conclude therefore that I cannot take the later evidence of the filing instructions into account in deciding the matter before me and that there is now no reason to call for a sworn declaration concerning the authenticity of these instructions."

I believe that the conclusion reached by the hearing officer in that case was correct. The purpose of the rule is to enable errors to be corrected which are obvious and therefore cannot mislead. Thus the rule uses the words 'obvious errors' in a context of enabling them to be rectified. What must be obvious is not simply that there has been some mistake, but also what the error is so that it can be rectified. If extraneous evidence of the applicant's intention is necessary to show that there has been an error, then that error cannot be an obvious error.

Counsel for the Comptroller submitted that Rule 91.1(b) defined what is an obvious error. I have found it difficult to read sub-rule (b) as a definition. However, that sub-rule is consistent with the view that I have reached and is a further indication that, when deciding whether there is an obvious error, the error must be apparent from the document.

I turn next to consider the submission of the applicants that looking at the application there was no obvious error in the omission of Canada and Spain. They relied on the following matters:

- (1) The form that was used was a 1987 form, not the current 1990 form and the difference between the two forms.
- (2) All states were designated that appeared on the form, and Greece was added, but not important states such as Canada and Spain.
- (3) The application was made by a well-known company in the biotechnology field and related to an invention which had commercial relevance in states such as Canada and Spain.
- (4) The United States of America was designated which makes it surprising that Canada was not. They submitted that when the application was carefully considered, it was apparent that the applicants intended to designate all PCT states and because the wrong form had been used Canada and Spain had been omitted.

The superintending examiner pointed out in his decision that the use of old forms was allowed while stocks lasted and therefore use of an old form did not indicate an error. He went on to consider the submission that it was clear that the applicants intended to designate all PCT states. He said:

"The argument based on the choice of designations used is more convincing and the choice might indeed have made a reader, once alerted to the situation, wonder whether an error had been made. However, the possibility that an error might have been made is not sufficient, in my view, to meet the criterion of an error being obvious, ie 'something other than what was obviously intended was written'. A possibility, or even a probability, that an error might have been made does not prove an obvious intention. The applicants, for a variety of reasons, might have intended not to obtain patent protection in Spain and Canada by means of an international application. This possibility, while not in line with the maximum choice of designations on the out of date form nevertheless exists. I am therefore not satisfied that the request form filed proves the intention to designate all the member states of the PCT at the time of the filing."

The applicants submitted that the superintending examiner was, in the passage of the decision I have just read, applying the wrong standard of proof. They submitted that the question of whether there was an obvious error should be decided upon the balance of probabilities. If so, the superintending examiner should have held that on the balance of probabilities there was an error. If so, on the balance of probabilities that error was an obvious one.

I do not believe that the superintending examiner did come to his decision by applying the wrong standard of proof. The correct standard of proof is the normal standard, namely the balance of probabilities and the correct question to be answered is -- On the balance of probabilities would the reader of the application conclude that there was an obvious error? The superintending examiner rightly differentiated between an error and an obvious error. An obvious error is that which must plainly or obviously have been made. If the facts only establish that an error might probably have occurred, then that is not sufficient to show that there is an obvious error.

The applicants also submitted that the superintending examiner failed to take account of all the relevant matters and therefore came to the wrong conclusion. I am not convinced that he did not have in mind all the relevant matters, but as the case was, I suspect, argued in more depth before me, I believe that I should reconsider his conclusion.

It is accepted that use of a superseded form is specifically allowed and therefore the applicants' use of a 1987 form does not indicate by itself an error. Further the reader of the application would know that Canada and Spain had joined the PCT after the 1987 form had been issued and therefore they should, if they were to be designated, have been added together with Greece in the space at the bottom of Box V. The reader would see that every listed state had been designated, would realise that the invention was of a type suitable for protection in every PCT state

particularly Canada as the United States of America had been designated, and that the applicant was a company likely to seek protection in every PCT country and no extra cost would be involved in designating Canada and Spain. In such circumstances, I believe the reader, on analysing the application, would be surprised that Canada and Spain were not also added to the form as designated states and would conclude that there may have been an error. However, I do not believe he would have concluded that there was an obvious error as there are legitimate reasons as to why the applicants could have excluded Canada and Spain. For instance the applicants could have had an arrangement with another company which enabled that other company to seek protection in Canada and Spain or precluded the applicants from obtaining patent protection in those states. Also the applicants might have sought protection in Canada and Spain and therefore did not wish to use the international route provided for by the PCT.

I believe it fair to test the conclusion I have reached by considering a possible hypothetical case in which an applicant instructed his patent agent to exclude Canada and Spain and the patent agent using the 1987 form, completed it in the same way as was done in the present case. Would such a form contain an obvious error? Clearly "No" as there would be no error. Further the application form would not show an error although the reader might think that an error had been made. Thus if there is a rational explanation for excluding Canada and Spain, the reader of a form, completed as in the present case, would conclude that an error might have been made but not that there was an obvious error.

For the reasons I have given I conclude that the superintending examiner's decision was correct.

DISPOSITION: Application dismissed with costs

SOLICITORS: Theodore Goddard; Treasury Solicitor