

Abstract

Modification of the Chapter II demand form was allowed because the modification did not lead to prejudice upon any party, either the applicant or the European Patent Office.

PRANGLEY'S APPLICATION

COURT OF APPEAL (CIVIL DIVISION)

HEARING-DATES: 12, 13, 14 January, 1 March 1988

1 March 1988

INTRODUCTION:

This was an appeal by Gordon Noel Prangley to the Court of Appeal from a decision of Whitford J in the Patents Court unholding a decision of Mr MF Vivian, superintending examiner acting for the Comptroller, that documents filed on 7 December 1983 purporting to request national processing of application No 8332517 based on international application No PCT/GB82/00322 must be taken to have been withdrawn.

COUNSEL:

Robin Jacob QC and Mary Vitoria for the applicant (appellant); Nicholas Pumfrey and Michael Silverleaf for the Comptroller (respondent).

PANEL: FOX LJ, BINGHAM LJ, RUSSELL LJ

JUDGMENTBY-1: BINGHAM LJ

JUDGMENT-1: BINGHAM LJ: This is the judgment of the court.

In the past an inventor who wished to obtain patent protection for his invention in a number of different states was obliged to make separate applications in each of those states. To do so was time consuming and expensive and involved much duplication of effort by the patent authorities in the various states. It was accordingly sought, in particular by the Patent Co-operation Treaty (the PCT) and the European Patent Convention, to mitigate these problems by providing for certain procedures to be carried out on a shared international basis. This

intermeshing of international and national activity has led to some considerable complexity in the rules which national patent authorities (such as the United Kingdom Patent Office) are bound to observe. The present appeal is a product of the complexity.

On 10 November 1982 the applicant applied to the Patent Office for a patent under the PCT. His application was in strict accordance with the PCT. As required, he designated the countries in which he wanted a patent for his invention. He listed the United Kingdom as a country (among others) in which he wanted a national patent. He also asked for a patent in all the PCT contracting states in which a European patent might be requested. These included the United Kingdom. So he was seeking a patent in this country (under the PCT) by two means, both nationally and regionally.

The effect of making this application was to initiate a process of international search and report and notification, which duly took place. But there was an important procedural consequence: by virtue of article 22(1) of the PCT and section 89(3) and (4) of the Patents Act 1977 and rule 85(1)(a) of the Patents Rules 1982 the applicant was required, within 20 months of the priority date, to pursue his application for a United Kingdom national patent. If he did not do so in time, such application "shall be taken to be withdrawn" (S 89(3) of the 1977 Act).

Following publication of the PCT application by the World Intellectual Property Organisation as the international co-ordinating agency under the PCT, the applicant decided to invoke Chapter II of the PCT by seeking an international preliminary examination. This is a means of obtaining a preliminary, non-binding view as to the patentability of the invention. Article 31(3) and (4) of the PCT provides:

"(3) The demand for international preliminary examination shall be made separately from the international application. The demand shall contain the prescribed particulars and shall be in the prescribed language and form.

(4)(a) The demand shall indicate the Contracting State or States in which the applicant intends to use the results of the international preliminary examination ("elected States"). Additionally Contracting States may be elected later. Election may relate only to Contracting States already designated under Article 4". (ie already designated for purposes of the international application.)

Rule 53 of the PCT Rules provided that the demand for international preliminary examination "shall be made on a printed form" and "shall contain . . . election of states". by virtue of article 39(1)(a) of the PCT and rule 85(1)(b) of the Patents

Rules 1982 the election of the United Kingdom under Chapter II of the PCT has (or at the time had) another important procedural consequence: it extended from 20 months to 25 months the period allowed for pursuing the application for a United Kingdom national patent. If the United Kingdom were not elected, the 20 month period would stand.

The applicant made his demand for international preliminary examination on the appropriate form, accompanied (as PCT Rule 92.1 required) by a covering letter. In the demand form he listed the states he wished to elect. He included "United Kingdom (EPO)", showing that he wished to elect the United Kingdom for purposes of his European Patent application, but did not include the United Kingdom a second time, simpliciter, so as to elect it for purposes of his national application. The covering letter, however, referred to "the elected states, namely for all of the electable states or regions among the states or regions designated in the application as filed", referring back to the original PCT application.

The position was therefore this. On the face of the demand form the applicant had elected the United Kingdom only for purposes of the European patent and not for purposes of the national patent. This was a mistake: a dual election was intended. But the applicant was unaware of the mistake. To anyone reading the letter, and comparing it closely with the list of countries originally designated in the PCT application, it would have been apparent that the list of elected states in the demand form did not match the terms of the letter as elucidated by the original PCT application. But this comparison was not made. So the Patent Office was unaware of the discrepancy as well as the applicant. The international preliminary examination proceeded and a report was made.

Believing that he had duly elected the United Kingdom for purposes of his international preliminary examination, and so earned the 25 instead of the 20 month time limit, the applicant in December 1983 filed the forms and paid the fees necessary to pursue his United Kingdom national application. This he did within the 25 month time limit but outside the 20 month time limit. Had the Patent Office then objected that he was out of time because the application was under the Act to be taken to have been withdrawn, it would not greatly have mattered. The applicant could still have pursued his application for a United Kingdom patent through the European Patent Office. But the Patent Office did not perceive any defect in the procedure at that stage and instead proceeded for well over a year to process the application. Meanwhile, the applicant's right to seek a United Kingdom patent through the European Patent Office lapsed. Then, on 30 April 1985, the Patent Office wrote to the applicant to say that, since he had not elected the United Kingdom for purposes of the international preliminary examination, the period for pursuing his national application had expired in July 1983, with the result that his documents filed in December had

been out of time: "Therefore the documents filed on 7th December 1983 purporting to request National Processing of this application must be deemed not to have been filed".

The applicant sought to challenge this conclusion before Mr Vivian as superintending examiner, acting for the Comptroller, who with obvious reluctance felt unable to reach a different conclusion. Whitford J on appeal described the procedural defect as one of form and nothing more. He also was reluctant to uphold a decision which would deny the applicant any United Kingdom patent, but he saw no alternative. He readily granted leave to appeal. In this court counsel for the Comptroller has made clear that, if there were any lawful means of overcoming this problem, it would be welcomed, and if there were any discretion it would be exercised in the applicant's favour. But it is said that there is no escape from the mandatory terms of the Act, and the Comptroller is rightly mindful of the House of Lords' strictures on disregard of statutory rules (E's Applications [1983] RPC 231 at 253).

Mr Jacob for the applicant has in this court suggested a number of grounds upon which the applicant may be given the relief which he seeks. Some of these may be considered quite briefly.

(1) It was argued that the demand form and the covering letter should be read as one. We cannot accept this. The PCT article and rule quoted above make it plain that the demand and the election of states must be on the prescribed form. There are obvious administrative reasons, particularly in this international context, why this should be so. The purpose of the covering letter is to identify the international application in question and no more (PCT rule 92.1(a)). This submission could not be accepted without flouting the language of the PCT and the Rule.

(2) It was argued that the letter was a "Later Election" within PCT article 31(4)(a) and PCT rule 56. But the letter cannot rationally be described as later than the demand and was not written in terms apt to suggest that it was intended to elect additional states, which in fact it was not.

(3) Reliance was placed on PCT rule 60.1. This provides:

"(a) If the demand does not comply with the requirements specified in Rules 53 and 55, the International Preliminary Examining Authority shall invite the applicant to correct the defects within one month from the date of the invitation.

...

(c) If the applicant does not comply with the invitation within the prescribed time limit, the demand shall be considered as if it had not been submitted.

(d) If the defect is noticed by the International Bureau, it shall bring the defect to the attention of the International Preliminary Examining Authority, which shall then proceed as provided in paragraphs (a) to (c)."

It is said that the applicant's demand did not comply because the letter contained an election of states otherwise than on the form. But the demand was made on the printed form, and it did comply with the requirements of PCT rules 53 and 55 because it contained an election of states. It is quite unlike a case in which the demand is defective for lack of any election of states. It is too late now to initiate the one month invitation procedure, because the sanction for non-compliance with such invitation cannot now be effective, the application having already taken effect.

(4) It was said that the requirement of election on the form itself is merely directory, not mandatory, so that election of the United Kingdom (nationally) by letter instead of on the form does not invalidate the election. That is, in principle, an attractive submission but it falls foul of the language of the PCT and the PCT Rules and does not in our view recognise the need for precision and certainty in the operation of these international procedures.

(5) It was contended that, by failing to point out the discrepancy between the letter and the demand form, by accepting late submission of the national forms and late payment of fees, by failing to notice the absence of any notification by WIPO of the election of the United Kingdom and the absence of any copy of the WIPO international preliminary examination report addressed to it and by proceeding to process the national application for many months as if it had been in order (including formal republication), the Patent Office had waived any formal defect of procedure or so conducted itself that it could not now be heard to assert that the applicant's submission of the fees and forms had been out of time. This again is an attractive submission and it gains strength from *Wells v Minister of Housing and Local Government* [1967] 1 WLR 1000 where Lord Denning MR said (at page 1007D):

"Now I know that a public authority cannot be estopped from doing its public duty, but I do think it can be estopped from relying on technicalities; . . . I take the law to be that a defect in procedure can be cured, and an irregularity can be waived, even by a public authority, so as to render valid that which would otherwise be invalid."

When the demand for international preliminary examination was made, containing an apparently valid election of states, the Patent Office was not in our

view bound to query or challenge it and the failure to do so cannot be relied on as any waiver or representation. When the forms and fees were submitted late it should have noticed this within a reasonable time and pointed it out. That is admitted. But we do not think the applicant's position in law can be stronger by virtue of waiver or representation that it would have been as a result of express agreement. So it may be helpful to enquire whether an express agreement by the Patent Office in (say) January 1984 to accept the forms and fees out of time would have been *intra vires* and valid.

In our view it would not. Section 89(3) of the 1977 Act provides that "if the relevant conditions have not been satisfied before the end of the prescribed period, the application shall be taken to be withdrawn". The relevant conditions, by virtue of section 89(4)(a), included payment of the relevant fee. Unless it can derive authority to do so from the 1977 Act and the Patents Rules (or, consistently with the 1977 Act and the Patents Rules from the PCT or the PCT Rules) it seems to us plain that the Patent Office may not lawfully and validly agree to treat as alive that which the 1977 Act stipulates must be treated as dead. If relief is to be obtained, it must be sought elsewhere.

(6) Reliance was placed on rule 100 of the Patents Rules 1982 which permits documents to be amended and procedural irregularities to be rectified in certain circumstances. But there was a lively issue between the parties whether this rule was available to assist the applicant in the present circumstances.

Section 89(1) of the 1977 Act provides:

"(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 Cooperation Treaty shall, until this subsection ceases to apply to the application, be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act . . ."

So far so good. The plain effect of this provision is to incorporate domestic procedures in the handling of international UK patents until the subsection ceases to apply.

It was argued for the Patent Office that the domestic procedures relating to amendment are ousted by section 89(3), which provides:

"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."

We do not think this subsection has the effect contended for. Both the PCT (articles 15, 19, 21, 25 and 28) and the 1977 Act (sections 16, 17, 18, 19) contain detailed provisions governing publication, search, examination and amendment in relation to the substantive application for a patent. That is what this subsection is concerned with, not the amendment of a document listing elected states. So we do not think this subsection excludes the incorporation of rule 100.

We were somewhat concerned that subsection 89(8) of the 1977 Act might operate to prevent reliance on rule 100 once an application was deemed to have been withdrawn under section 89(3). We accordingly invited further submissions from counsel on this point. The applicant submitted that section 89(8) was not a barrier to the operation of rule 100, and helpfully drew our attention to rule 110 which plainly permits retrospective extension of the time limit in rule 85(1)(a), albeit for a limited period. Counsel for the Comptroller agreed that section 89(8) was not an independent bar to the operation of rule 100. Since the parties are to that extent agreed we have not thought it necessary to enquire further into the effect of section 89(8). We accept this agreement the more gratefully, since it does in our view accord with articles 26 and 48(2) of the PCT. There is in our view no other bar to reliance on the rule.

Rule 100 provides:

"Any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct:

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

If it were necessary for the applicant to rely on the proviso to this rule in order to succeed, we should feel bound to hold that he was not entitled to do so, because the irregularity here was not in our view attributable wholly or even in part to an error, default or omission on the part of the Patent Office. There was not even the kind of failure which was found in Mills' Application [1985] RPC 339. It was not until after expiry of the 20 month time limit that any error on the part of

the Patent Office occurred, and that did not cause the irregularity which arose here. Nor is rule 110 of assistance to the applicant, because the maximum extension permitted under rule 110(3) would not save his application. So if the applicant is to succeed it must be in reliance on the substance of the rule and not on the proviso.

In our opinion the applicant is not seeking an extension of time or a direction that any time or period specified in the 1977 Act or the Patents Rules should be altered. He is simply seeking to amend a document filed in proceedings before the Comptroller, namely his demand for international preliminary examination, by adding the United Kingdom to his list of elected states or to rectify the irregularity in procedure which he caused by framing his demand in terms which differed from his original PCT application. It is accepted that such amendment or rectification would give effect to the applicant's intention at the time when the demand was made. No-one will be prejudiced. Common justice plainly requires that he should obtain this relief. It is of course true that the consequence of a retrospective amendment or rectification is to entitle the applicant to the 25-month instead of the 20-month time limit and thus to validate his submission of fees and forms in December 1983. So be it. Happily, the applicant observed the 25-month time limit and so no extension of time as such is called for.

We accordingly conclude that the Comptroller has power under rule 100 to amend the applicant's demand or rectify the irregularity which the applicant's failure to elect the United Kingdom in his demand has caused on such terms as the Comptroller may direct. We invite counsel to address us on the precise form of relief which this court should give. For these reasons we allow the appeal.

DISPOSITION: Appeal allowed with costs. No order for costs below.

SOLICITORS: SJ Berwin & Co; Treasury Solicitor