Abstract
The failure to elect the United Kingdom in a Chapter II demand form was deemed not to be an obvious error.

Re Prangleys Patent Application

Chancery Division (Patents Court)

(Transcript:Marten Walsh Cherer)

HEARING-DATES: 25 March 1986

25 March 1986

COUNSEL:

TA Blanco White for the Appellant;
H Laddie for the Comptroller-General of Patents

PANEL: Whitford J

JUDGMENTBY-1: WHITFORD J:

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This is an appeal from a decision of Mr Vivian, acting for the Comptroller-General of Patents, in connection with an application which, as is I think accepted on all sides, has most unfortunately run into difficulty as a result of a mistake in making an entry upon a form. The background is so clearly set out in the decision the subject of the appeal that I do not think that I need to repeat it.

What undoubtedly happened, so far as is material for present purposes, was that, in the light of the letter which accompanied the relevant demand in this case, the Office, I think very understandably, assumed that there had been an appropriate election in respect of the designation of the United Kingdom as an issuing office. The sole failure was a failure so to indicate on page 2 of the form, where, against the entry for the United Kingdom, the only Office designated is the European Patent Office, and there is no designation in respect of the United Kingdom Patent Office.

What subsequently happened was that Form 42/77 was filed; there was a re-publication; there was the usual Official Letter; and it was not until April of last year that it was discovered at the Patent Office that there had in fact been no designation of the United Kingdom Office on the form, as is in fact required by the Patent Cooperation Treaty Rules. Rule 53.1 says that you have got to make the demand on a printed form; and one of the submissions urged upon me by Mr Blanco White was that this was a grievous misfortune in the circumstances of this particular case, because, if there had been no requirement for making the demand upon a printed form, the present difficulty would never have arisen. But it also is provided in this rule that the demand shall name the designated Offices, and this was what was not sufficiently done.

The case has been urged with great force by Mr Blanco White under a number of heads; and I confess that it is only with the very greatest reluctance that I find myself unable to accept that the very careful decision of Mr Vivian can be overcome. It is yet another of those cases where, from what Mr Laddie told me on behalf of the Comptroller, the Office feel, as I do, that it is very unsatisfactory that this particular application should not be allowed to follow the route which everyone accepts it was always intended should be followed, as indeed is made very clear from the passage at the bottom of page 3 of the decision. It is a defect of form and nothing more than that; but in truth we have reached a position where, having regard to the provisions of the Treaty and the Rules, there never was an application to the United Kingdom Office, although it is quite obvious that the matter was treated by this Office over some little period of time as if in fact there were an application; but because, in my view, it cannot be said that there was an application, it is not a case where any mode of correction which might be open under the relevant Rules applicable to United Kingdom patents, and in particular Rules 100 and 101, which were particularly referred to by Mr Blanco White in argument before me, or indeed I think Rule 117, upon which rather more reliance was placed before the Office.

The only possible escape, as far as I could see, would be by bringing into operation the provisions of Rule 60 of the Patent Cooperation Treaty. I agree with Mr Vivian in concluding that the route which might have been open up to the 8th November 1983, via Rule 91 of the Patent Cooperation Treaty Rules, quite plainly, as a matter of construction of the Rules, ceased to be available as of that date.

Rule 60 is a rule which is specifically concerned with a demand such as we are concerned with here; and under Rule 60 we get the heading "Certain defects in the demand for elections". Rule 60. 1(a) provides:

"If the demand does not comply with the requirements specified in Rules 53 and 55, the International Preliminary Examining Authority" –

In this case the Office, they having been so designated –

"shall invite the applicant to correct the defects within one month from the date of the invitation".
Of course the person who is inviting something to be done in this case is not the International Preliminary Examining Authority; it is the applicant; and, on the face of it, Rule 60 would not seem to be of application, particularly if one looks at Rule 60. 1(c), which provides that, if there is no compliance with an invitation to correct a defect, the demand shall be considered as being null and void. I have come to the conclusion with reluctance that Mr Laddie is right when he says that Rule 60 is only dealing with a demand which does not meet the requirements of the Authority; it is not concerned with defects in a demand arising out of a failure of an applicant to include within a demand, which is not otherwise in any way defective, something which he has intended to include but has failed to include.

It would be attractive to go upon the basis that, as everybody agrees in the light of the letter that accompanied the demand that this was a case where quite plainly what the applicant intended to do was to follow the United Kingdom route and as quite plainly he has failed so to indicate on the demand, taking these two together it could be said that there ought perhaps to have been a realisation that, inasmuch as it was the United Kingdom route that was wanted and the demand did not so specify, it failed to meet the requirements of Rules 53 and 55; but, attractive though this may be, it is, I am reluctant to say, misconstruing the rules in a way which, to my mind, cannot be proper.

I have come to the conclusion, as I say with great reluctance, that the decision, given with reluctance, having regard to the fact that it was no more than a matter of formality, must be upheld; and the appeal accordingly dismissed.

DISPOSITION: Appeal dismissed, with costs

SOLICITORS: Mewburn Ellis & Co; Treasury Solicitor