

PATENTS ACT 1977

IN THE MATTER OF a request under section 117(1) to correct a translation of European patent (UK) No 0399902 in the name of Rhone-Poulenc Sante

0/12345

DECISION

On 25 November 1993, a translation into English of European patent (UK) No 0399902 B1 was filed under section 77(6)(a) by the proprietors Rhone-Poulenc Sante. Mention of grant of the European patent was published in the European Patent Bulletin on 22 December 1993, and the specification was published in the French language.

The patent relates to pastes for the preparation of pharmaceuticals. The relevant part of claim 1 as recited in the translation as filed on 25 November 1993 reads (emphasis added in italics):

"1. Paste intended for the preparation by lyophilization of a single-dose, solid pharmaceutical dosage form of homogeneous and porous appearance, consisting of:

.....

(d) *a quantity of 35 to 50% of water*, relative to the dry mass of the mixture, which is appropriate for adjusting the viscosity of the suspension obtained so that the latter possesses rheological properties permitting good division of the product."

On 13 January 1994 the proprietors filed Form 47/77 requesting correction of the translation under section 117(1). The correction requested was the replacement of the figure "50" in part (d) of claim 1 by "80". The request was accompanied by a corrected translation verified by the translator.

The figure of "50" in the translation has been carried over from the English language claims for the designated States other than Spain and Greece, as they appear in the printed specification of the European patent as granted by the European Patent Office. The upper limit of 50% for the relevant range appears at page 12 line 11. However, all other corresponding passages in the document, viz the description at page 4 line 18, claim 1 of the accompanying claims in the French and German languages, and claim 1 of the English language claims for Spain and Greece (which is to a process, rather than a product) specify an upper limit of 80% for the range.

In an official letter dated 2 February 1994, the proprietors were informed:

"With reference to the form 47/77 filed on 13 January 1994, it is noted for consistency that page 12 line 11 of the specification would also appear to need correction and I would be grateful to know whether you wish this to be done at the same time as the translation.

It is proposed to defer the allowance of the corrections to both the specification and translation until the expiry of the 9 month period allowed for opposition to a European Patent; The Manual of Patent Practice 117.11 refers."

This letter was issued by Mrs B A Jenkins and signed "pp G P Cosulich". Both Mrs Jenkins and Mr Cosulich were at the relevant time officials of grade "Administrative Officer" in the Legal Division of the Patents and Designs Directorate in the Patent Office.

The proprietor's agents wrote on 8 February 1994 asking for page 12 line 11 of the published specification of the European patent to be corrected as proposed by the Office. Patents Form 47/77 was subsequently amended in the Patent Office with the agreement of the proprietors to include this correction of the specification of the European patent (UK).

In an official letter dated 22 November 1994 (the nine-month period for entering opposition to the grant of the European patent having expired), the view was expressed that correction of the claim in the published specification was allowable under section 117. I am satisfied

that this is the case. I therefore do not have to consider further this limb of application for correction.

However, in regard to the correction of the translation, it was stated:

"With regard to the second document, it is the preliminary view of the Office that the uncorrected translation filed under section 77(6)(a) conferred 'narrower' protection than the original French authentic text. In such circumstances, it is the preliminary view of the Office that the specific provisions of section 80(3) and rule 80 (Schedule 4 para 4) of the Patents Rules 1990 apply. Where a specific provision exists, it is the Office's view that a general 'provision', such as section 117, cannot be allowed to circumvent the specific provision; even though, as in this case, a simple clerical error on the part of the translator has occurred."

On 9 December 1994 the proprietors filed a corrected translation under section 80(3) together with a request for publication on Patents Form 57/77. However, they also explained that the application under section 117 was not withdrawn and that the application on Form 57/77 was provisional in order to minimise the period during which the provision of section 80(4) could operate should the application under section 117 not be allowed. Notice that the corrected translation had been filed was published in the Official Journal (Patents) on 18 January 1995.

Subsequent correspondence failed to resolve the question of whether correction of the translation was allowable under section 117. The matter accordingly came before me at a hearing held on 15 March 1995 and resumed after adjournment on 24 July 1995. The proprietors were represented by Mr Nicholas Pumfrey QC. On behalf of the Office, Mr R C Kennell attended on both days and Mr A W Russell and Mr I Sim attended on 24 July 1995.

In the period between the two hearing dates, I required notice of the proposed correction to be advertised in the Official Journal (Patents) pursuant to rule 91(3). The advertisement appeared on 12 April 1995 but no notice of opposition to the request has been received pursuant to rule 91(4).

It is not in dispute that the upper limit of 50% appearing in the translation filed under section 77(6)(a) is incorrect, but what I have to decide is whether this is an error which should be corrected under the provisions of section 117 in preference to the filing of the corrected translation already effected under section 80(3).

Section 117 reads:

"117.-(1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

(2) Where the comptroller is requested to correct such an error or mistake, any person may in accordance with rules give the comptroller notice of opposition to the request and the comptroller shall determine the matter."

The procedure for requesting corrections under section 117 is governed by rule 91 of the Patents Rules 1990, the relevant parts of which read:

" 91.-(1) Except where ... paragraph 4 of Schedule 4 has effect, a request for the correction of an error of translation or transcription or of a clerical error or mistake in any specification of a patent, in an application for a patent or in any document filed in connection with a patent or such an application shall be made on Patents Form 47/77 and shall be accompanied by a document clearly identifying the proposed correction; and the comptroller may, if he thinks fit, require that the correction be shown on a copy of the document of which correction is sought.

(2) Where such a request relates to a specification, no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

(3) Where the comptroller requires notice of the proposed correction to be advertised the advertisement shall be made by publication of the request and the nature of the proposed correction in the Journal and in such other manner (if any) as the comptroller may direct.

(4) Any person may, at any time within two months after the date advertisement, give notice to the comptroller of opposition to the request on Form 48/77."

Section 117 is applicable to a European patent (UK) and to documents filed in connection therewith as from the date of the publication of the mention of its grant in the European Patent Bulletin by virtue of sections 77(1)(a) and (b). These read:

"77.-(1) Subject to the provisions of this Act, a European patent (UK) shall, as from the publication of the mention of its grant in the *European Patent Bulletin*, be treated for the purposes of Parts I and III of this Act as if it were a patent under this Act granted in pursuance of an application made under this Act and as if notice of the grant of the patent had, on the date of that publication, been published under section 24 above in the journal; and-

(a) the proprietor of a European patent (UK) shall accordingly as respects the United Kingdom have the same rights and remedies, subject to the same conditions, as the proprietor of a patent under this Act;

(b) references in Parts I and III of this Act to a patent shall be construed accordingly;"

As noted above the translation in question was filed on 25 November 1993 under section 77(6)(a). This section reads:

(6) While this subsection is in force-

(a) subsection (1) above shall not apply to a European patent (UK) the specification of which was published in French or German, unless a translation of the specification into English is filed at the Patent Office and the prescribed fee is paid before the end of the prescribed period;"

Publication of translations filed under section 77(6) is provided for under section 77(8) as follows:

"(8) The comptroller shall publish any translation filed at the Patent Office under subsection (6) above."

The requirements relating to translations filed under section 77(6) are set out in paragraph 1 of Schedule 4 of the Patents Rules 1990. In particular paragraphs 1(2) to 1(4) require:

(2) A translation filed under section 77(6) shall comprise a translation of the entirety of the published specification of the patent (including the claims), irrespective of whether a translation of all or any part of the claims contained in the

specification has previously been filed under section 78(7) but subject to subparagraph (5) below, and shall include any drawings in the specification, irrespective of whether the drawings contain textual matter.

(3) A translation filed under section 77(6) shall comply with the following requirements as to presentation, subject to subparagraph (4) below in the case of any drawings-

- (a) it shall permit of direct reproduction by photography, electrostatic processes, photo-offset and micro-filming, in an unlimited number of copies;
- (b) it shall be on A4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable;
- (c) each sheet of paper shall be free from cracks, creases and folds and used on one side only;
- (d) each sheet shall be used with its short sides at the top and bottom (upright position);
- (e) the minimum margins shall be-

top	2.0 cm
left side	2.5 cm
right side	2.0 cm
bottom	2.0 cm;
- (f) the margins of the sheets shall be completely blank;
- (g) the translation shall be typed or printed in single-line spacing (unless the comptroller otherwise permits), in a dark, indelible colour and in characters of which the capital letters are not less than 0.21 cm high, save that graphic symbols and characters and chemical and mathematical formulae may, instead of being typed or printed, be written or drawn;
- (h) the translation shall be reasonably free from extraneous matter and also from deletions and other alterations, overwritings and interlineations and shall, in any event, be legible; and
- (i) each sheet (other than a sheet of drawings) shall be numbered consecutively in arabic numerals.

(4) Where a translation including any drawings is filed, the sheets of drawings shall correspond exactly in content and presentation to the sheets of drawings which were published by the European Patent Office, except that-

- (a) each sheet shall be numbered consecutively in arabic numerals, as a separate series from that used for the other sheets of the translation, if not so numbered when published by the European Patent Office; and
- (b) any textual matter contained in the published drawings shall be replaced with a translation into English."

In addition such translations are open to inspection under paragraph 6 of Schedule 4 of the Patents Rules 1990 which reads:

"6. A request for inspection of a translation published under section 77(8), 78(7) or 80(3) shall be made on Patents Form 23/77."

A translation filed under section 77(6)(a) is treated as the authentic text for the purpose of domestic proceedings (other than for the revocation of the patent), pursuant to sections 80(1) and 80(2) which read:

"80.-(1) Subject to subsection (2) below, the text of a European patent or application for such a patent in the language of the proceedings, that is to say, the language in which proceedings relating to the patent or the application are to be conducted before the European Patent Office, shall be the authentic text for the purposes of any domestic proceedings, that is to say, any proceedings relating to the patent or application before the comptroller or the court.

(2) Where the language of the proceedings is French or German, a translation into English of the specification of the patent under section 77 above or of the claims of the application under section 78 above shall be treated as the authentic text for the purpose of any domestic proceedings, other than proceedings for the revocation of the patent, if the patent or application as translated into English confers protection which is narrower than that conferred by it in French or German."

However, where the translation confers the narrower protection sections 80(3) and 80(4) provide for the filing and publication of a corrected translation. Those sections read:

"(3) If any such translation results in a European patent or application conferring the narrower protection, the proprietor of or applicant for the patent may file a corrected translation with the Patent Office and, if he pays the prescribed fee within the prescribed period, the Patent Office shall publish it, but -

(a) any payment for any use of the invention which (apart from section 55 above) would have infringed the patent as correctly translated, but not an originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted, shall not be recoverable under that section.

(b) the proprietor or applicant shall not be entitled to bring proceedings in respect of an act which infringed the patent as correctly translated, but not an originally translated, or in the case of an application would have infringed it as aforesaid if the patent had been granted.

unless before that use or the doing of the act the corrected translation has been published by the Patent Office or the proprietor or applicant has set the corrected translation by post or delivered it to the government department who made use or authorised the use of the invention or, as the case may be, to the person alleged to have done that act.

(4) Where a correction of a translation published under subsection (3) above and before it so published a person begins in good faith to do an act which would not constitute an infringement of the patent or application as originally translated but would (apart from section 55 above) constitute an infringement of it under the amended translation, or makes in good faith effective and serious preparations to do such an act, he shall have the rights conferred by section 28A(4) and (5) above, and subsections (6) and (7) of that section shall apply accordingly."

The procedure governing the filing of corrected translations under section 80(3) is regulated by paragraph 4 of Schedule 4 which states:

"4.-(1) A corrected translation filed under section 80(3) shall be filed in duplicate.

(2) The corrected translation shall comply with the requirements contained in paragraph 1(3) and (4) above.

(3) Publication of the corrected translation shall be requested on Patents Form 57/77, which shall be filed in duplicate.

(4) The period prescribed under section 80(3) for payment of the prescribed fee shall be fourteen days from the day on which the corrected translation is filed."

The first matter I am required to decide is whether the correction requested under section 117 has already been allowed by the comptroller in the official letter of 2 February 1994. At the hearing, Mr Pumfrey initially submitted that it had. However, on being handed a copy of paragraph B130.05 of the Patent Office Manual of Patent Practice (3rd Edition) which sets out the grades of the various officers of the Patent Office authorised by the Secretary of State to perform functions of the comptroller under section 62(3) of the Patent and Designs Act 1907, he accepted that neither Mrs Jenkins or Mr Cosulich, each graded as Administrative Officer, had the authority to act for the comptroller in deciding a request under section 117. I am satisfied that this is the case. However, Mr Pumfrey submitted that the letter created a legitimate expectation on the part of the proprietors that the request would be allowed and stated that he formally reserved his position to raise this matter on appeal.

The second matter I have to decide is whether, notwithstanding the fact that a corrected translation has already been filed and published under section 80(3), the provisions of that section were in fact not applicable to the translation filed under section 77(6) on the date of the application to correct the translation under section 117, namely 13 January 1994.

Although in correspondence before the hearing on 15 March 1995, the agents for the proprietors had contended that section 80(3) did not apply because the incorrect translation did not result in the European patent conferring narrower protection, Mr Pumfrey did not pursue this at the hearing. Having considered the matter I am satisfied that, on a plain reading, insofar as claim 1 specifies a water content of 30% to 50%, the translation manifestly results in the European patent conferring narrower protection than the specification of that patent as published under the European Patent Convention in which claim 1 of the authentic French text specifies a range of 30% to 80%.

Instead, Mr Pumfrey submitted that section 80(3) did not apply because the application for correction under section 117 had been made before the incorrect translation was published under section 77(8).

This raises two considerations. The first is whether section 80(3) is applicable only after publication of the translation. The second is whether the incorrect translation had in fact been published by the date of the application under section 117.

In respect of the first of these considerations Mr Pumfrey argued that in section 80(2) the words "a translation into English of the specification of the patent under section 77 above" meant a translation which had been both filed and published under section 77(8). He submitted that until the translation had been published, it is not possible to come to a decision whether the translation confers the narrower protection of section 80(2).

However, I am not persuaded by this argument. As a matter of language, section 80(3) does not state in express terms that the translation in question must have been published before a corrected translation can be filed under that section. Accordingly, as a matter of interpretation, I am reluctant to import such a requirements into this section.

Having considered the matter, my reluctance is re-inforced by the consequence of doing so. This is that where after a translation has been filed under section 77(6) but before it has been published under section 77(8), the proprietor realises that the translation is incorrect and results in the patent conferring narrower protection than is conferred in French or German, he must then either wait until after the incorrect translation has been published before he can file a corrected translation under section 80(3) or he must request correction under section 117.

However, there is manifestly no merit in forcibly delaying the filing of a corrected translation under section 80(3) until after the publication of the translation filed under section 77(6) as this merely prolongs, for no useful reason, the unsatisfactory state of affairs resulting from the filing of the incorrect translation.

To require a proprietor who wishes to take immediate action to proceed under section 117 appears even less satisfactory. First, for the reasons set out below, I am of the view that correction should not be allowed under this section where the translation filed under section 77(6) results in the patent conferring narrower protection than conferred in French or German. Second, even if correction were permissible under section 117 in these circumstances, the filing of a request under this section does not effect the correction of the translation on the date the request is filed. The correction is only effected if and when the request is formally allowed. In view of the extra procedures involved in the Office, it is inevitable that correction under section 117 would take longer to implement than simply publishing a corrected translation under section 80(3). This again would have the effect of prolonging for no useful reason the unsatisfactory state of affairs resulting from the filing of the incorrect translation.

In the circumstances, I see no grounds for importing into section 80(3) words which would have the effect of denying a proprietor the right to file a corrected translation under that section as soon as he becomes aware of an error in the translation into English filed under section 77(6) which results in the patent conferring narrower protection than is conferred in French or German.

I therefore find that it is permissible to file a corrected translation under section 80(3) prior to the date of the publication of the incorrect translation under section 77(8).

If, however, I am wrong in this finding, it is also necessary to decide whether the incorrect translation filed on 25 November 1993 had in fact been published under section 77(8) by the date on which correction was sought under section 117, namely 13 January 1994.

Mr Pumfrey submitted that this translation was not published until the date of the announcement of the filing of the translation in the Official Journal (Patents), namely 9 February 1994. In support of this, he handed up a copy of what he took to be the official publication of the translation under section 77(6)(a). This included a pro-forma sheet bearing a Patent Office logo stamped 9 February 1994 as "Date of Publication of the Translation". The pro-forma was also stamped "See amended specification filed in front" (apparently relating to the corrected translation subsequently filed under section 80(3)) and "The British Library, Science Reference and Information Service".

The Office view, as stated by Mr Kennell at a hearing on 15 March, was that in accordance with section 118(1), rule 93(4)(a) (which applies by virtue of rule 93(1)) and paragraph 6 of Schedule 4 (which applies by virtue of rule 80), the translation was made open to public inspection at the expiry of the 14 day prescribed by rule 93(4)(a), (namely on 10 December 1993) and was accordingly published on this date in accordance with section 130(1) which states:

"published" means made available to the public (whether in the United Kingdom or elsewhere) and a document shall be taken to be published under any provision of this Act if it can be inspected as of right at any place in the United Kingdom by members of the public, whether on payment of a fee or not

The text of Schedule 4 paragraph 6 is given above.

Section 118(1) reads:

"118.-(1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) give the person making the request such information and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions."

Rules 93(1) and 93(4)(a) read respectively:

"Inspection of documents under section 118

93.-(1) Subject to paragraph (5) below, and to the restrictions prescribed in paragraph (4) below, after the date of publication of an application for a patent in accordance with section 16, the comptroller shall, upon request made on Patents Form 23/77 and payment of the appropriate prescribed fee, permit all documents filed or kept at the Patent Office in relation to the application or any patent granted in pursuance of it, to be inspected at the Patent Office.

...

(4) The restrictions referred to in paragraph (1) above are—

(a) that no document shall be open to inspection until fourteen days after it has been filed at the Patent Office;

... "

Rule 80 reads:

"European Patents and application (UK): translations

80. Schedule 4 shall have effect in cases where translations are required by the Act to be filed in connection with applications for, and with, European patents (UK)."

In view of the discrepancy between this view and the date on the pro-forma produced by Mr Pumfrey, I adjourned the hearing on 15 March 1995 to enable evidence to be obtained from a responsible official in the Patent Office as to procedure concerning publication of translations under section 77(8).

The hearing was resumed on 24 July 1995, when evidence from two Patent Office officials in the form of statutory declarations from Mr I S Sim made on 15 May 1995 and from Mr A W Russell made on 31 May 1995 was available.

In his declaration Mr Sim states:

"(1) I have been employed in the United Kingdom Patent Office for 5 years. I am presently the Senior Executive Officer responsible for post-grant patent administration including Translations Section which processes translations of European patents designating the United Kingdom, and have been employed in this position since May 1994."

In relation to translation filed under sections 77(6)(a), 77(6)(b) and 80(3) he states inter alia:

"(7) In Translations Section the processing is done by an Administrative Officer (AO) who will check that the documents meet the requirements of Schedule 4 of the Patent Rules 1990. Any discrepancy will be referred to the person filing the translation. Once the translation meets the formal requirements the AO will put an entry to the effect that the translation has been filed onto the register of patents and arrange for entry to be made in the Official Journal (Patents).

(8) Of the two copies filed, one is retained on file at the UK Patent Office, where it is available for inspection. The AO sends the second copy to the British Library, Science Reference and Information Service (SRIS), in Southampton Buildings, London once the formal requirements are met. The AO prepares an identifying proforma, bearing the patent number and the date (termed "Date of Publication of the Translation" on the proforma) of the Official Journal (Patents) in which the fact of the filing of the translation is to be published, and affixes it to the front of the set of translation documents to be sent to SRIS. Any additional stamp or notation will have been made after the documents have been despatched from the Patent Office.

- (9) The filing date of the translation (ie the date that it was received in the Office) is the date that appears above the line, as a part of the bibliographic data, in the OPTICS register of patents. Entries made above the line represent basic information on the patent: dates that appear in this field are the dates on which the action occurred, and, unlike the entries below the line, do not state the date on which the action was entered on the register (see copy of register entry for EP 0399902 exhibited as ISS1).
- (10) 14 days after this date the translation is laid open to public inspection in accordance, or in analogy, with rule 93(4)(a) of the Patents Rules 1990. Even if mention of grant has not yet taken place, or there are still matters outstanding in relation to the formal requirements, the public may then inspect the document that is currently held at the Patent Office. In the light of the definition of "published" in section 130(1) of the Patents Act 1977 this is regarded as publication, and the Office makes no separate publication of the translation.
- (11) Documents that are available to the public may be inspected or copies may be obtained. To inspect, the enquirer should file a Patents Form 23/77 either at the London Search Room or at the Patent Office at Newport so that the appropriate file may be obtained. Once this is done the enquirer will be informed that the documents are available. An appointment has to be made at Newport but the London Search Room may be visited at any time during opening hours. If copies are required a Patents Form 23/77 should be filed or the request can be made when the file is inspected. There is no charge for the inspection but copies are charged at 15p per page. Arrangements to inspect or copy can be made by telephone. An enquirer will also be told in response to a telephone enquiry whether or not a translation has yet been filed.
- (12) The notice in the Official Journal (Patents) will be some 4-5 weeks from the date that the entry is placed on the register. This is because of the publication

cycle of the Official Journal (Patents). The Official Journal (Patents) is published once a week, each Wednesday. The notice however, refers to the date that the entry was put on the register (see copies of pages 787 and 788 of the Official Journal dated 9 February 1994, exhibited as ISS2, containing the entry for patent No EP 0399902).

- (13) In the case of the patent No EP 0399902, the original translation was received at the Patent Office on 25 November 1993. Mention of grant was published in the European Patent Bulletin on 22 December 1993. The fact of the filing of the translation was entered on the register on 10 January 1994 and published in the Official Journal (Patents) on 9 February 1994."

Mr Sim's declaration sets forth what he understands to be the current practice of the Office. I note that he did not take up his present post until May 1994. Clearly, therefore he is not in a position to give evidence from his own knowledge of the procedures that were in force at the relevant period between 25 November 1993 and 9 February 1994.

However, Mr Russell declares:

- "(1) I have been employed in the United Kingdom Patent Office for 17 years. I am the Grade 6 responsible for patent administration, and have been since December 1990.
- (2) I have read the statutory declaration of Ian Stuart Sim made on 15 May 1995 and the documents 'ISS1' and 'ISS2' exhibited thereto.
- (3) I confirm that the procedures described therein for making available to the public translations of European patents designating the United Kingdom have been in force, according to my understanding, since 1987."

At the resumed hearing, Mr Pumfrey did not dispute that with effect from expiry of the 14 day period prescribed by rule 93(4)(a) (ie from 10 December 1993) the translation in

question could be inspected as of right in the United Kingdom by members of the public, albeit on filing a request on Patents Form 23/77.

However, he did not accept that this constituted publication for the purposes of section 77(8). He submitted that the words "The comptroller shall publish" in that section imposed a positive obligation on the comptroller to do more than simply make the translation available for public inspection by filing a request on form 23/77. In support of this, he contended that it was not possible for the comptroller to meet his obligations to publish the patent application under section 16 or to publish the patent specification under section 24 merely by laying it open to public inspection under section 118. He submitted that publication under section 77(8) was effected by the comptroller sending a copy of the translation to SRIS, as described by Mr Sim, and that it was for this reason that the translation must comply with the stringent physical requirements specified in paragraph 1 of Schedule 4. On this basis, the date of publication was therefore the date on which the translation was made available to the public in SRIS, namely the date of publication of the translation as stated on the pro-forma. He also noted that if publication was effected by simply laying the translation open to public inspection under section 118(1), there would be no indication to the public as to the date of such publication.

Having considered the matter, I find that I am unable to accept Mr Pumfrey's submissions on this point. As a matter of fact, translations filed under section 77(6) are not published by printing copies as is done in the case of patent applications under section 16 and patent specifications under section 24. They are published by making them available for public inspection on filing Patents Form 23/77 in accordance with section 118(1) and rule 93. A copy of the translation is available to the public on request by completing Part 2 of Form 23/77. In line with the purpose behind Rules 18 and 20 which apply to the presentation of UK national patent applications, it is desirable that in response to such a request the public are given a document which is clearly laid out, and is capable of being read without difficulty. It is for that reason that the translation must satisfy the requirements of Schedule 4, paragraph 1 in regard to presentation.

I see no grounds for finding that making a translation available for inspection in the Patent Office under section 118(1) is any less a publication than making it available for inspection on the shelves of SRIS. In my view, either action is as much a publication as the other. What matters is that the translation can be inspected as of right at any place in the United Kingdom by members of the public, whether on payment of a fee or not, in accordance with the definition of "published" in section 130(1). It follows that the date of publication of the translation is the date on which it first becomes available for such inspection. However, it is apparent that a translation must always be available for public inspection in the Patent Office under section 118(1) before the Office can send a copy to SRIS for public inspection there. It therefore follows that the date of publication of a translation under section 77(8) is always the date on which it is open to inspection pursuant to section 118(1), rule 93 and paragraph 6 of Schedule 4.

I would however observe that I find unsatisfactory and misleading the practice as described by Mr Sim whereby the date the notice of the translation is published in the journal is described as "the date of publication" of the translation on the pro-forma attached to the copy of the translation sent to SRIS.

Accordingly, I find that the translation filed under section 77(6) on 25 November 1994 was published under section 77(8) by making it open to public inspection fourteen days after it was filed, namely on 10 December 1993. It follows that I also find that the translation was published before the application for correction under section 117 was filed on 13 January 1994.

In line with both this finding and my earlier finding that it is permissible to file a corrected translation under section 80(3) prior to the date of publication of the incorrect translation under section 77(8), I am satisfied that the provisions of section 80(3) were applicable to the translation filed under section 77(6) on the date the application to correct the translation under section 117 was filed.

The question then arises as to whether, in the circumstances of the present case, the comptroller should nevertheless allow correction of the translation under section 117.

Mr Pumfrey submitted that to allow correction of the translation under section 117 as an alternative to the filing of a corrected translation under section 80(3) would not be in contravention of the established canon of construction generalia specialibus non derogat. This was because the two sections related to two different activities, one being the filing of the corrected translation, the other the correction of the translation which has already been filed.

Having considered the matter, I am not satisfied this is the case. I see no distinction, in terms of result, between correcting a translation and filing a corrected translation - in each case the result is the same, namely a correct translation. I am re-inforced in this view by fact that where correction of a translation is requested under section 117, the request may be accompanied by a corrected translation. This was done in the present case. I also note that it is established practice for the comptroller to require the proprietor to file a new translation incorporating the corrections where the corrections are extensive. Thus, as stated in B117.11(iv) of the Patent Office "Manual of Patent Practice" (3rd Edition):

"..... unless the corrections are of minimal extent, Revocations Section will call upon the proprietor to provide, within a specified period, a new translation incorporating the corrections instead of correcting the original copy of the translation."

Although I see no difference in terms of result between correcting a translation and filing a corrected translation, there is nevertheless a significant difference in the safeguards afforded to third parties. Thus, where a correction is effected by filing a corrected translation under section 80(3), the safeguards set out in sections 80(3)(a), 80(3)(b) and 80(4) apply recited above.

In contrast, correction under section 117 has effect ex tunc and contains no safeguards for third parties.

No evidence was before me as to whether or not any third party would be disadvantaged if correction were effected under section 117 rather than under section 80(3). In fact, in the absence of any opposition to the request for correction under section 117, it is quite possible that no-one would be disadvantaged.

However, Parliament has expressly provided safeguards for third parties under sections 80(3) and (4) and I am satisfied that it would be wholly inappropriate for the comptroller to exercise his discretion to allow correction under section 117 which would have the effect of circumventing these express provisions for intervening rights contained in sections 80(3) and 80(4). In my view, notwithstanding Mr Pumfrey's submission to the contrary, to do otherwise in the situation in which the translation confers narrower protection would be, in the words of Lord Diplock in E's Applications [1983] RPC 231 at page 250 line 52 to page 251 line 2:

"..... to turn on its head the well-established cause of construction generalia specialibus non derogant."

I therefore find that since the translation filed under section 77(6) confers narrow protection the error in the translation can only be corrected by filing a corrected translation in accordance with section 80(3) and paragraph 4 of Schedule 4 (as has already been done) and that the application for correction under section 117 and rule 91 should be refused.

I accordingly refuse the application on Form 47/77, insofar as it relates to correction of the translation under section 117(1).

However, also in line with my findings above, I order that an erratum slip be prepared correcting the figure of "50" to "80" at page 12 line 11 of the published specification of the European patent (UK).

This being a substantive matter, the proprietors have a period of six weeks in accordance with RSC Order 104 rule 19 to appeal against this decision.

Dated this 16 day of August 1995



L LEWIS
Principal Examiner, acting for the Comptroller

THE PATENT OFFICE

