

PATENT COOPERATION TREATY

BLO / 051 / 87

IN THE MATTER OF Application
No. PCT/GB 86/00374 in the names
of Hemosol Inc and Robert Gordon Hiron

STATEMENT OF REASONS FOR DECISION
OF RECEIVING OFFICE ON REQUEST FOR
RECTIFICATION OF ERROR

On 20 February 1987 I gave an oral decision that the United Kingdom receiving Office could not now make an effective authorization for rectification of the request form of this international application. I stated I would issue a written statement of reasons as soon as possible.

International application No. PCT/GB 86/00374 was filed at the United Kingdom Patent Office as receiving Office on 26 June 1986 in the names of Hemosol Inc and Robert Gordon Hiron, and claimed priority from a Canadian application No. 485392 filed on 26 June 1985. The request form PCT/RO/101 designated Australia, Brazil, Denmark, Japan, and the Democratic People's Republic of Korea for a national patent, and individually all the PCT Contracting states for which a European patent may be requested, apart from Italy and the United Kingdom. It was accompanied by a description, claims, drawings and an abstract.

On the 21 July 1986 the International Bureau of WIPO mailed to the Applicants' agent the notification of receipt of the record copy. The notification contained a list of designated Offices notified of receipt of record copy of the application, the national Offices being indicated by their country codes, and the European Patent Office being followed by the country codes of the countries for which a European Patent was requested. The notification agreed with the designations appearing on the request.

In letters dated 19 and 20 November 1986 (both arriving at the receiving Office on 21 November 1986) the applicants' agent sought correction of the request form by the addition of Italy as a country

for which a European patent was requested. Accompanying these letters was a copy front page of the agents' filing instructions from their Canadian associates which specified that Japan, Australia, Denmark, South Korea, Brazil and EPC (full designation) should be designated. The agent in the letters stated he had been misinformed as to how states should be designated which had become parties to the Treaty after the date the request form was printed.

In a reply dated 12 December 1986 to these letters the receiving Office stated that various points needed to be brought to the agents' urgent attention. The reply indicated that having regard to PCT Rule 91(a) and (b), and to the fact that it was not obvious from any of the originally filed documents that there was an error in designations it would follow that the request for correction must be refused. The reply offered the agent a hearing on this matter. The reply also pointed out that the jurisdiction of the Patent Office as receiving Office is governed by PCT Rule 91.1 (g) (i) and (g^{bis}) and no longer applies once the preparations for publication are completed.

In a further letter dated 20 January 1987 the agent pointed out another error in the designations - South Korea (ie the Republic of Korea) should have been designated -, and contended that in view of the copy front page of their associate's instructions the errors should be allowed to be corrected.

In a reply dated 29 January 1987 to this letter the receiving Office made the observations, first, that with regard to the time limit imposed by PCT Rule 91.1 (g) (i) and (g^{bis}) the International Bureau WIPO had published the application on 15 January 1987 and had informed the receiving Office that if the late designation were to be allowed the International Bureau WIPO were to be informed by 19 December 1986 (due to the Christmas break), and secondly even if the preparations for publication had not been completed the interpretation given to Rule 91, as explained in the reply dated 12 December, precluded the late designations of Italy and South Korea. Again a hearing on the matter was offered.

Following a discussion the agent had in the Office on 10 February 1987, the agent, Mr H L Jukes, accompanied by one of his partners, Mr P R Corfield, appeared before me at a hearing on 20 February 1987. Mr W G Sceats represented the receiving Office.

After hearing Messrs Jukes and Corfield I gave the oral decision that the receiving Office could not now make an effective authorization for rectification.

After making this decision I was asked not to give an opinion as to the merits of the case for rectification, and the agents made no submissions to me on the allowability of the corrections sought. I accordingly give no opinion or make any finding on whether the rectification sought meets the requirements of PCT Rule 91.1 (a) and (b).

Rectification of obvious errors in documents under the Patent Cooperation Treaty is governed by PCT Rule 91. The relevant parts of that Rule for the purpose of this statement of reasons are as follows:

(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.

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

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

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(f) Any authority which authorizes or refuses any rectification shall promptly notify the applicant of the authorization or refusal and, in the case of refusal, of the reasons therefor. The authority which authorizes a rectification shall promptly notify the International Bureau accordingly. Where the authorization of the rectification was refused, the International Bureau shall, upon request made by the applicant prior to the time relevant under paragraph (g^{bis}), (g^{ter}), or (g^{quater}) 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. A copy of the request for rectification shall be included in the communication under Article 20 where a copy of the pamphlet is not used for the communication or where the international application is not published by virtue of Article 64(3).

(g) The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g^{bis}), (g^{ter}) and (g^{quater}), be effective:

(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date:

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(g^{bis}) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.

(g^{ter}) Where the application has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any

notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.

(gquater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.

Mr Jukes submitted that the receiving Office still had jurisdiction because his request for rectification was made before completion of the preparations for publication. He drew my attention to two decisions of the Legal Board of Appeal of the European Patent Office. The first decision, J12/80, related to the correction of countries designated in a European patent. The first head note reads as follows:-

I. Correction of mistakes in the request for grant of a European patent is not excluded, provided the request for correction is made promptly, even when the application has been published in its uncorrected form while an appeal against refusal of the request to correct the mistakes is pending.

The second decision J03/81 related to the correction of the countries designated for a European patent in an international application. In that decision the Board held that a request for the correction of a mistake by adding the designation of another country in a European patent application must be refused in the public interest if it is made too late for a warning to be added in the application as published, and that where an international application filed under the Patent Cooperation Treaty is deemed to be a European patent application the same general rule must apply mutatis mutandis. Rectification by the European Office was sought after publication of the international application by WIPO and was refused by the Legal Board.

I accept that the practice of the European Office is to permit rectification of designations in a European patent application, provided of course the relevant grounds for rectification are established, if the request for rectification is made before publication of the application even though the application is subsequently published in its uncorrected form while the request is still pending.

However the provisions of the European Patent Convention and the Patent Cooperation Treaty differ (as can be seen if EPC Rule 88 is contrasted with PCT Rule 91), and the receiving Office is only concerned with the provisions of the latter.

In my opinion the provisions of Rule 91 regarding when a receiving Office can authorize rectification are abundantly clear. If the error is in the request no rectification shall be made except with the express authorization of the receiving Office (paragraph (e)), and that authorization shall be effective if its notification reaches the International Bureau before the expiration of 17 months from the priority date (paragraph (g)) or before the preparation for publication have been completed (paragraph (g^{bis})). Since both time limits are now well passed the receiving Office can not now make any effective authorization of rectification.

Mr Jukes however submitted that in the absence of any precedent decisions on Rule 91 binding on me I should take an "equitable interpretation" of Rule 91. By this I understood Mr Jukes to mean that I should interpret Rule 91 in such away as to allow the receiving Office still to make an effective authorization of rectification. He argued that Rule 91 should be interpreted, in line with the practice of the European Patent Office mentioned above, to permit an effective authorization to be given if a request for one is made before the time limits given by Rule 91.1 (g) and (g^{bis}) expire.

I am aware of no decisions interpreting this aspect of Rule 91 and was referred to none. The absence of any precedent does not mean however that I can depart from the clear wording of Rule 91 however 'inequitable' or unfair an applicant might consider that wording to

be. If the Contracting States of the Convention had intended that it would only be necessary for a request for rectification to be made by the time limits given in paragraph (g) or (g^{bis}) then the Treaty would have so stated.

It was also submitted to me that once a request for rectification had been made the matter was 'sub judice' and that subsequent completion of preparations for publication does not effect the 'sub judice' status. Whatever may be the consequences of a 'sub judice' status I do not see how they can override the provision of paragraphs (g) and (g^{bis}) as to the time limits for rectification. In my view if an applicant seeks rectification of the request he has to apply in sufficient time before expiry of these time limits for the receiving Office to consider the matter and for any inadequacies or apparent inadequacies in the applicant's case to be dealt with.

I was also asked to give a decision with retroactive effect. Again I find there is no provision under the Treaty for such a decision. The whole purpose, as I understand it from Rule 91, of the time limits is to enable a rectification, if authorized, to be included in the application when published by the International Bureau so that the public and the designated Offices may then also be aware of the rectification.

Mr Jukes commented that he was at a disadvantage because he did not know when the completion date for the preparations for publication would be, he had not been informed of that date, and he was unaware of the need to settle his request for rectification before the deadline imposed by Rule 91.

I sympathise with applicants under the Patent Cooperation Treaty. While the Treaty has the commendable objective of an applicant under the Treaty having initially to comply with only one set of regulations instead of complying with the differing regulations of each designated country had he chosen the alternative route of filing a separate national application in each country, the Treaty is somewhat complex and contains potential pitfalls, especially for those not well accustomed to proceedings under it.

Publication of an international application is a matter for the International Bureau and not for the receiving Office. Article 21(2)(a) of the Treaty requires international publication to be effected promptly after the expiration of 18 months from the priority date of the application, while Rule 47.1(b) provides that the communication to designated Offices under Article 20 should be effected promptly after international publication and in any event by the end of 19 months from the priority date. Applicants have a period expiring normally of 20 months from the priority date in which to enter the national phase before each designated Office. Hence the International Bureau was obliged to publish this application as soon as possible after 26 December 1986 and before 26 January 1987. According to the PCT Applicant's Guide preparations for publication are generally completed 15 days before publication. Preparations were apparently completed for this application on 19 December 1986, and the application then published, after a delay for the Christmas break, on 15 January 1987. It was presumably because of the publication shortly due under the provisions of the Treaty that the letter from the receiving Office dated 12 December 1986 drew the various points urgently to the attention of the agent and indicated that jurisdiction of the Office no longer applies once the preparations for publication were completed.

I explained at the start of the hearing that the right to appeal to the Patents Court from a decision of the Comptroller under the Patents Act 1977 did not apparently extend to a decision of the Comptroller when acting as a receiving Office under the Patent Convention Treaty. However this would of course be a matter for the Court to decide. Nevertheless I pointed out there could be the possibility of a request to the High Court for judicial review.

Dated this 23rd day of February 1987

B G Harden
Principal Examiner, acting for the Comptroller

PATENT OFFICE