

PATENTS ACT 1977

BLO/096/81

IN THE MATTER OF an application
for Patent No 78 37177 by
Elf Union

D E C I S I O N

Application No 78 37177 was filed on 18 September 1978 and contained a declaration of priority in respect of a French application dated 20 September 1977. All the relevant documents necessary to allow the application to proceed to preliminary examination and search were filed in accordance with the requirements of the Patents Act 1977 and the Patents Rules 1978. A copy of the search report was sent to the applicants on 22 December 1978 and the application was published in accordance with Section 16 of the 1977 Act on 4 April 1979. The period prescribed under Section 18(1) and Rule 33(2) for filing a request for substantive examination on Patents Form 10/77 together with the prescribed fee thus expired on 4 October 1979. That date passed without such request being made and accordingly, in accordance with the provisions of Section 18(1), the application was treated as having been withdrawn and was advertised as such in the Official Journal (Patents) on 13 February 1980. On 6 January 1981, some 15 months after the expiry of the prescribed period, the applicants' agents filed a request for substantive examination on Form 10/77, together with the prescribed fee. The request was accompanied by a Statutory Declaration made by Mr M A Lynd, a Chartered Patent Agent and

partner in the firm of Stanley, Popplewell, Francis and Ross (the applicants' agents), in which he stated that the failure to file Form 10/77 was due to a breakdown in procedure in his office. A request was made that the Comptroller exercise discretion under Rule 100 of the Patents Rules 1978 to admit the late-filed request for substantive examination. An Official letter of 5 February 1981 stated that (i) the request for exercise of the Comptroller's discretion had been filed one day after the coming into operation of an amendment to Rule 100 which deprived the Comptroller of his discretion in cases of this kind, and (ii) even if the Comptroller retained discretion, in view of the lapse of time between expiry of the prescribed period and the actual date of filing the request for substantive examination and since the application had been advertised as treated as withdrawn, the request for the exercise of discretion would have been refused. The fee accompanying the Form 10/77 was returned to the applicants. The applicants' agents requested a hearing and the matter came before me on 19 May 1981. Mr Nigel Pumfrey (Counsel) appeared for the applicants.

Mr Pumfrey first referred to Mr Lynd's Statutory Declaration and accompanying Exhibits. I need not comment upon them in any detail here save to say that together they satisfy me that the Form 10/77 and fee were not filed due to a series of unfortunate errors in Mr Lynd's office, that both the applicants and Mr Lynd were genuinely under the impression that the Form 10/77 had been filed as early as February 1979, and that the Form was filed as soon as the omission was discovered. I am satisfied therefore that in this case there was an irregularity in procedure before the Office within the meaning of

Rule 100, at least as it stood in its unamended form before 5 January 1981 and as interpreted in Fater SpA's Application /1979/ FSR 647.

Rule 100 as it stood before 5 January 1981 reads as follows:

"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 Office may be rectified, on such terms as he may direct."

By the Patents (Amendment No 4) Rules 1980, Rule 2(u), the following proviso was added:

"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 Office, the Comptroller shall not direct that any period of time specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1978 as amended, as they continue to apply, shall be altered."

Mr Pumfrey next made two alternative submissions. First, that the addition of the proviso did not deprive the Comptroller of any discretion which he had prior to its insertion and secondly, that even if it did, the present case should be governed by the unamended Rule 100.

In support of his first submission Mr Pumfrey referred to the decisions of both the Assistant Comptroller and the Patents Court in Fater's case. He submitted that in both decisions it was accepted that in appropriate circumstances discretion could be exercised under Rule 100 which had the effect of extending a time limit. Mr Pumfrey quoted extensively from both decisions, but as I understand it, his essential point was that where there had been an irregularity in procedure, the Comptroller had discretion to allow correction of that irregularity notwithstanding that it involved as a consequence the effective extension of a time limit prima facie prohibited under Rule 110 (2). Turning to the proviso to Rule 100, Mr Pumfrey submitted that, whatever may have been the intention, it did not alter the effect of the Fater decision. He said that in exercising discretion under Rule 100 no express order for the extension of a time limit has to be made because if the Form 10/77 is allowed onto the file then, as a consequence of the exercise of discretion to correct the irregularity in procedure, what was a time bar has ceased to be a time bar. In effect the Form is deemed to have been filed at the proper time. The proviso, he said, is, on the other hand, concerned specifically with alteration of time limits and therefore leaves the main part of the Rule unaffected. In support of his argument that a proviso does not exclude application of the main part of a provision in cases which otherwise fall within it Mr Pumfrey referred to In Re Tabrisky: Ex parte The Board of Trade (1947) 1 Chancery 565. In that case it was held that "..... if facts are proved which bring the case within the proviso to Section 26, subsection (2) of the Bankruptcy Act 1914, the Court must make an order including one or other of the four alternatives mentioned in the proviso, but may in addition include any other

conditions which it could impose under the general words of the subsection, in cases not falling within the proviso." In other words, once the proviso is satisfied, the main provision may be applied. The two are not mutually exclusive. Mr Pumfrey's first submission may, I think, be summarised as follows. Under the original Rule 100, as interpreted by Fater, the Comptroller had power to exercise discretion to admit the late filed Form 10/77 onto the file without the need for an order for extension of time. The fact that the new proviso allows the Comptroller specifically to alter a time limit only in certain limited circumstances does not affect that original power, if, as in the present case, the proviso is satisfied simply by its not being applicable.

I turn now to Mr Pumfrey's alternative submission, namely that the original, unamended, Rule 100 should apply in this case. He said that his client had at least an acquired privilege, perhaps even an acquired right, to ask the Comptroller to exercise discretion and that the privilege could not be taken away except by clear words or appropriate transitional provisions in the amended rules. He also said that the privilege would accrue as soon as the mistake was made or at the latest immediately on expiry of the prescribed time limit. In support of this submission Mr Pumfrey referred to the Interpretation Act 1978, Section 16(1)(c) of which reads:-

"(1) Without prejudice to Section 15, where an Act repeals an enactment, the repeal does not, unless the contrary intention appears, -

(c) affect any right or privilege, obligation or liability acquired, accrued or incurred under that enactment;"

The above provision is applied, by virtue of Section 23 (1) of the same Act to subordinate legislation made after the commencement of the Act (ie after 1 January 1979). Mr Pumfrey also referred to Convex Ltd's Patent /1980/ RPC 423 in which it was held, applying Section 16(1) of the Interpretation Act 1978, that the restoration of a 1949 Act patent which had expired before the Patents Act 1977 came into force, but for which application for restoration had been made after that Act came into force, was governed by the provisions of the Patents Act 1949 notwithstanding that those provisions had been repealed by the 1977 Act.

There are no transitional provisionals in the Patents (Amendment No 4) Rules 1980 and I can find nothing from which a contrary intention appears such as would negate the provisions of Section 16(1) of the Interpretation Act. I am therefore satisfied that the applicants have at least an acquired privilege to ask the Comptroller to exercise his discretion in their favour on the basis of the unamended Rule 100. It is unnecessary for me to decide when the privilege accrued since both the mistake and the date of expiry of the prescribed period occurred before the amended Rules came into operation. In my view, however, the privilege would accrue on the date of expiry of the prescribed period since until that time there would be no irregularity in procedure apparent from the documents upon which Rule 100 could bite.

I therefore accept Mr Pumfrey's alternative submission and since I have already concluded that there was an irregularity in procedure before the Office within the meaning of the unamended Rule 100 as

interpreted by the decision in Fater's Application, it follows that I have power to correct that irregularity. In these circumstances it is unnecessary for me to make any finding on Mr Pumfrey's first main submission.

Now, in cases such as this where there has been a relatively lengthy period of time between the due date for taking some action and the date when it is, in fact, taken and especially when that time is such that advertisement of withdrawal has taken place, it seems to me that I must have regard not only to the interest of the applicants but also to those of third parties. In the case of a failure to file Form 10/77 there can, of course, be no question of a third party who may have independently applied for a patent for the invention being put in jeopardy by the exercise of discretion because the application, having been published under Section 16, would be within the state of the art for novelty purposes so far as that third party was concerned. In this respect there is a difference between the possible effect of a failure to file a Form 10/77 and a failure to file a Form 9/77. A more important consideration is the position of third parties who may have taken steps to exploit the invention on the assumption that the notice of withdrawal in the Official Journal (Patents) meant that there would be no monopoly.

In this connection Mr Pumfrey referred to those sections of both the Patents Act 1949 and the Patents Act 1977 which allow for the protection of third parties in restoration of patent cases. He submitted that if the appropriate third party protection is provided nobody would be harmed by the exercise of discretion. I am, of course, here concerned with what might be termed revival of a withdrawn

application rather than the restoration of a lapsed patent. Nevertheless, having considered all the circumstances I think it would be proper for me to exercise discretion under Rule 100 to allow the late filing of the Form 10/77 subject to the refiling of the appropriate fee and subject to terms for the protection of third parties, notwithstanding that it is, I believe, unusual to do so at this stage in the progress of an application.

I therefore exercise discretion under Rule 100 of the Patents Rules 1978 to admit the late filing of the Form 10/77 subject to the refiling of the prescribed fee within 14 days from the date of this decision and subject to the following terms:-

"That, after a patent has been granted on the application, any person who, between 5 October 1979 (the date on which the application was treated as having been withdrawn) and ~~10~~¹¹ June 1981 (the date of the decision admitting late filing of Form 10/77 subject to the refiling of the prescribed fee) has done or begun to do in good faith an act which would constitute an infringement of the patent if it were in force or has made in good faith effective and serious preparations to do such an act, shall have the right -

a) to continue to do or, as the case may be, to do that act himself; and

b) if it was done or preparations had been made to do it in the course of a business, to assign the right to do it or to transmit that right on his death or, in the case of a body corporate on its dissolution, to any person who

acquires that part of the business in the course of which
the act was done or preparations had been made to do it,
or to authorise it to be done by any partners of his for
the time being in that business;

and the doing of that act by virtue of these rights shall not
include the right to grant a licence to any person to do an act
so mentioned. Where a patented product is disposed of by any
person to another in exercise of these rights, that other and any
other person claiming through him shall be entitled to deal with
the product in the same way as if it had been disposed of by a
sole registered proprietor."

Dated this 16th day of June 1981

A F C MILLER
Superintending Examiner
Acting for the Comptroller

PATENT OFFICE