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THE PATENT OFFICE

Mr Walker
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Conference Room 3.B23
Concept House
Cardiff Road
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FOS:

Monday, 12th February, 1996

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Before:
THE PRINCIPAL EXAMINER

(Mr P Hayward)

(Sitting for the Comptroller-General of Patents, etc.)

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In the Matter of THE PATENTS ACT 1977, Sections 18/89

and

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In the Matter of THE APPLICATION of NATIONAL STARCH AND CHEMICAL INVESTMENT CORPORATION

Pre-Grant Procedural Matter in relation to UK Patent No 9522618.9

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Transcript from the Shorthand Notes of
Harry Counsell (Wales)
41, Llewellyn Park Drive, Morriston, Swansea SA6 8PF
(Tel: 01792 773001 FAX: 01792 700815)
Verbatim Reporters

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DR MICHAEL D SPENCER (of Messrs Bromhead & Co., 19 Buckingham Street, London WC2N 6EF) appeared on behalf of the Applicants

MR D WOOD (The Patent Office)

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DECISION AS APPROVED BY THE HEARING OFFICER

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THE PRINCIPAL EXAMINER: The first application for this invention was filed in the United States in March 1994, and that was followed up by an application under the PCT one year later in March 1995, the PCT filing taking place roughly two weeks after Singapore had joined the PCT. The application was duly published by WIPO on 8th September 1995, and the application which designated the UK entered the national phase on 4th November 1995 under the provisions of s.89A(3)(a) of the Patents Act 1977 and Rule 85(1)(a) of the Patents Rules 1995.

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One day before that, the applicants filed a request with this Office asking for accelerated processing because they wished to get protection in Singapore. The significance of this is the change to the Singapore patents legislation that occurred on 23rd February 1995. If they had applied for the PCT application before that date then, if and when the UK patent was granted, it would automatically have been given effect in Singapore.

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As they applied after that date, they could have designated Singapore but (for reasons which are not clear) that was not done. Alternatively, they can still rely on their UK patent for Singapore purposes provided it is granted by 23rd February 1996, which is eleven days from now. That is the significance of their request for urgent grant: not because they want urgent grant in this country but because the applicants want protection in Singapore, and they now have no other way of getting that.

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That is by way of background. The question I have to

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decide is, should we accede to the request and try to get this granted in the UK as quickly as possible? And I think the second aspect of that is, can we accede to that request? In other words, is there enough time left to do what is physically necessary to get the patent granted?

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There are, as far as I am aware and Dr Spencer is aware, no statutory provisions that lay down expressly any requirement for a delay between publication and grant; but it has been the Office practice not in fact to proceed to grant without some delay, because of s.21. S.21 allows a third party to intervene, without becoming a party to the proceedings, and make observations on the application to the Comptroller. That intervention can take place after publication. To quote s.21:-

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"Where an application for a patent has been published but the patent has not been granted to the applicant, any other person may make observations in writing to the Comptroller on the question of whether the invention is a patentable invention".

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If the Office were to grant patents immediately after publication, then it would effectively nullify the effect of s.21 because third parties would have no opportunity to invoke that section; and that is the background behind the Office's practice to allow a delay between publication and grant, so that third parties can intervene.

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This delay is spelled out in guidance the Office publishes regularly in the Official Journal. If I can quote here from the Official Journal of 12th July 1995,

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which is the copy I have in front of me although I believe this notice appears every three months, it makes it clear that "No report under s.18(4) that an application complies with the requirements of the Act and the rules will be issued until at least three months after the application has been published under s.16. This delay is to allow third parties to file observations under s.21 and to permit the search to be updated". That comment is repeated again under the subsequent paragraph in the same Official Journal on accelerated substantive examination.

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It is also spelled out in the Manual of Patents Practice, which is of course a publicly-available document, in paragraph 18.07.1, and I think one will find it elsewhere as well.

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So there is a long-established Office practice to allow this three months minimum between publication under s.16 and reporting that the case is in order under s.18(4), and it is a period that third parties ought to be able to rely upon, because that is what we have said we will do.

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Paragraph 18.07.1 does have a concession to that three-month period in the case of a PCT conversion, which is what we have here. It says that "In the case of s.89 applications, if the corresponding international application has been published by WIPO then the three-months rule can again be waived, at the request of the applicant, but only to the extent of enabling a report under s.18(4) to be issued not earlier than two months after the application has been reprinted". So there is

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express reference there to the situation we have at present; and that gives third parties the expectation that they have two months from the time at which we reprint the PCT application.

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It may help if I just explain the reprinting step. Although it is not a statutory requirement, it is the Office's practice to reprint PCT conversions shortly after they enter the national phase; and in the present case that reprinting will take place in two days' time on 14th February. So paragraph 18.07.1 gives third parties the expectation that they will have two months from 14th February in which to file observations under s.21.

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Dr Spencer argued that this was unnecessary, because third parties had been aware of the application since it was published on 8th September by WIPO, and that they could have filed s.21 observations at any time since then. Thus they have had easily three months to do so. I do not wish to make a decision on whether or not s.21 observations can be filed as soon as WIPO publish the application, even though the application has not yet entered the national phase. I can well understand third parties wanting to wait until the application enters the national phase because it may never do so, particularly on an application such as this which designates the UK both directly and via the EP route. Until the application enters the national phase one could not be sure that it would actually go ahead. Nevertheless I do not wish to decide on that particular point, and I do not think I need to.

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The position we are now in is that the applicants are desperate to get their Singapore patent, because this particular technology is very important in Singapore. We can do that only by riding roughshod over the expectations of third parties. I recognize they have been aware of the application for some time, but the Manual of Patents Practice has given them a clear expectation that they will have two months from our re-publication, and I am most reluctant to ride roughshod over that in order to help the applicants out of the position they now find themselves in. If I could see a way of doing it without overriding third party interests then I would be very happy to do so, but at the moment I cannot. Therefore I decline to order immediate grant of this application. Consideration of grant should be deferred for two months from the re-publication date, which is on 14th February.

In case on appeal I should be found to be wrong on that point, I would just like to say a brief word about the practical problems. Mr Wood on behalf of the Office has explained the grant cycle normally takes seven weeks, but the Office can in exceptional circumstances reduce it to three weeks. We have less than three weeks remaining now anyway.

"Grant" for these purposes means grant under s.24, i.e. publication of the notice of grant in the Official Journal. We could not now get that done by 23rd February anyway: the Official Journal issue for that date is already at the printers. Further, all the other things that have to be

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done at grant - including making copies available to the public, updating databases and so on - are presumably all being done or have been done. That is why we need this minimum period to get the notice in the Journal and do the other things that are necessary when that notice is published. So it is now physically impossible to grant by the requested date, even if I felt able to do so.

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I think that is all I need to say. I am sorry once again not to be able to help the applicants. I think this must be a procedural decision, so that if you wish to appeal the time period for doing so under Order 104 of the Rules of the Supreme Court is two weeks from today's date.

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That, I think, finishes the hearing. Can I just ask you, are you likely to appeal?

DR SPENCER: I do not know. I will have to go back to the clients.

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THE PRINCIPAL EXAMINER: If you are likely to appeal, then the shorthand writer will try and produce the transcript of the decision as quickly as possible.

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DR SPENCER: The honest answer is, I do not know. This whole thing developed on Thursday. I spoke to the agent handling it on Friday, who was ill in Germany, so I cannot know what National Starch will say in New Jersey on whether it will be appealed. From that point of view they have to consider the cost and other things, such as what the likely loss to them of eighteen years of patent rights would be, and that I cannot state.

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THE PRINCIPAL EXAMINER: Can I suggest, if you do decide you

wish to appeal, you telephone Mr Wood or Mr Honeywood, and we will do our best to get the transcript of the decision to you as quickly as possible. We will do our best to do that anyway.

DR SPENCER: Yes. But as I say, I have no idea of the - the problem is that once you start appealing the procedures start getting more costly and more expensive, so I do not know, I cannot state that. I have no "go ahead" from the client today. The only thing, on what you said, on the "physical impossibility" side, if it would have been made clear in January, if we had had this hearing in January there would still have been time to do this, on that three-week period.

(Proceedings concluded at 12.22 p.m.)