

BLO/091/86

PATENTS ACT 1977

IN THE MATTER OF Patent Applications
Nos. 8515018 and 8515019 in the name
of KOEHRING COMPANY

DECISION

The applications were filed on 13 June 1985, each application including a declaration of priority on the request for grant, that for application no. 8515018 claiming a priority date based on an earlier application filed in the USA on 25 May 1984, and that for application no. 8515019 claiming a priority date based on an earlier application filed in the USA on 11 June 1984. Each application was therefore filed after the expiry of the period of twelve months from the date of filing of the respective earlier application, and as a result the office took the view that the applications had been filed too late for the claimed priority dates to have effect in accordance with Section 5(2).

The agents acting for the applicants explained in a letter dated 22 August 1985 that the late filing had been caused by delays in the postal service between the USA and the UK and they made a request that the Comptroller should issue a retrospective certificate under Rule 111(1) to the effect that during the whole period from 25 May 1985 to 13 June 1985, inclusive, there was a general interruption or subsequent dislocation in the postal services of the UK, and should extend the period for the filing of the applications and their respective declarations of priority to 13 June 1985. The office having declined to grant this request, a hearing was appointed for the matter to be heard. In the event the applicants' agents, Malcolm Lawrence and Co, notified the office by telephone, before the appointed time, that they had been instructed not to attend the hearing. I therefore make this decision on the basis of the facts and argument set forth in the agents' letter dated 22 August 1985 and the accompanying statement

dated 15 August 1985 by Mr Rustomji who is apparently an officer of the UK Post Office competent to attest facts concerning mail transit from the USA to the UK.

The circumstances leading up to the late filing of the two applications are as follows. Instructions to file the applications and the respective specifications were mailed in Detroit USA on 17 May 1985 in a single envelope which was correctly addressed to the agents in the UK, was clearly labelled "AIR MAIL", and bore the appropriate postage for that form of transit. The documents were received by the UK agents on 13 June 1985 and, with commendable alacrity on their part, the two applications comprising description, claims, abstract and informal drawings, were filed on that same day together with requests on Fm 9/77 for preliminary examination and search.

According to Mr Rustomji, the normal length of time which elapses between posting an airmail letter in the USA and its delivery in the UK is 5 or 6 days, though it is not abnormal for delivery to be achieved only 4 days after posting. On the other hand, a mail time of 8 or 9 days is not considered to be sufficiently abnormal to warrant comment. Although what I may refer to for present purposes as being the 'normal' delivery time ranges from 4 to 9 days, Mr Rustomji states that it was noticed in February 1984 that unexplained delays were occurring such that about 10% of air mail letters posted in the USA remained in that country for more than seven days after franking and 1 or 2% had been held up by more than 17 days with, of course, a correspondingly later than normal delivery time in the UK. Furthermore, despite improvements in the past year (presumably to August 1985), there have still been significant numbers of airmail letters from the USA suffering delays of the order mentioned above.

As I understand it, there is no suggestion that the unusually long period of time which elapsed between the mailing of the applicants' instructions in the USA and the delivery of those instructions to their agents in the UK was in any respect

contributed to or caused by delays in the postal system occurring within the UK, and it was the view of the formalities officer, communicated to the applicants in official letters dated 12 July 1985 and 25 November 1985, that a postal delay occurring outside the UK does not constitute a reason for the issue of a certificate by the Comptroller under Rule 111(1). It is that view which is contested by the applicants and the correctness or otherwise of which I have to decide upon.

Rule 111(1) reads:

111-(1) Subject to the provisions of paragraphs (2) and (3) below, where any period of time specified in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day certified by the comptroller as being one on which there is a general interruption or subsequent dislocation in the postal services of the United Kingdom, the period shall be extended to the first day following the end of the period of interruption or dislocation.

It seems to me that the essence of the applicants' argument is to be found in the paragraph numbered 1. in their agents' letter dated 22 August 1985 and is to the effect that as far as mail between the USA and the UK is concerned the postal services of the UK are a co-operative exercise between the UK and the USA, and the postal services referred to in the Rule should not therefore be interpreted as meaning only postal services in the UK. In the paragraph numbered 2. of the same letter, attention is drawn to Omron Tateisi Electronics Company's Application [1981] RPC 125 and in particular to the learned judge's remarks reported at p 135 lines 38 et seq that "Rule 111 deals with documents and letters posted outside the United Kingdom and in my judgement is obviously intended to protect non-residents, for example, those applying from abroad under the Convention, in the same way as residents are protected by rule 97."

The agents further argue that to apply Rule 111 in a way which fails to protect a foreign applicant from interruptions in the postal services of the UK associated with the performance of a foreign postal authority (eg in his own country) co-operating in the provision of the service to UK addresses would be unjust, inconsistent with the language of the rule, inconsistent with the reported remarks of the learned judge in the Omron Tateisi case, and would effectively mean that the UK patents legislation treats UK resident applicants with privilege.

I find myself totally unable to accept this argument. After careful consideration of the Omron Tateisi case and the learned judges reported remarks therein, I am of the opinion that Rule 111 in its proper reading does not extend to interruption or dislocation of postal services occurring outside the UK, but has the more limited application of protecting residents outside the UK from the effects of delays incurred in the UK on letters and documents posted outside the UK, in the same way as Rule 97 protects UK residents from the effects of delays incurred in the UK on letters and documents posted in the UK. I am re-inforced in this view by consideration of what would be the probable result of interpreting Rule 111 in the manner in which the applicants' agents have suggested. It seems to me that firstly the comptroller would find himself in an almost continuous state of having to issue a certificate because postal delays had been shown to have occurred somewhere or other in the world, and secondly application of Rule 111 in that way would result in precisely the invidious privileged treatment of UK residents of which the applicants have complained, this following from the fact that every time a certificate was issued in respect of postal delays occurring outside the UK, residents in the UK, who had not been affected at all by the delays concerned, would nevertheless be granted additional time in which to perform the various acts specified in the Rule.

In the result therefore I refuse to issue a certificate under Rule 111(1) and it follows from this refusal that the applications, if

they are to proceed, must do so with their actual date of filing, namely 13 June 1985.

This decision being in respect of a procedural matter, the period allowed for appeal is two weeks from the date of the decision.

Dated this 25th day of February 1986

K E PANCHEN

Superintending Examiner, acting for the Comptroller

PATENT OFFICE