

BLO / 074/90

PATENTS ACT 1977

IN THE MATTER OF an application
for a patent 8828938.4 by
Aisin Seiki K.K.

DECISION

Application No 8828938.4 was filed on 12 December 1988 in the name of Aisin Seiki K.K. claiming priority from a single earlier Japanese application filed in Japan on 18th December 1987 and was accompanied by patents forms 9/77 and 10/77. The application proceeded to preliminary examination where it was determined that a copy of the Japanese priority document and translation thereof had not yet been filed, and accordingly an official letter issued to the applicants on 17th January 1989 reporting that the priority document (required by rule 6(2)) and the translation thereof (required by rule 6(6)) must be filed within the periods prescribed by these rules (16 and 21 months from the declared priority date respectively). The application then proceeded to search in the normal way and the search report was issued on 28th February 1989.

Nothing further happened until the period for filing the priority document (together with the extension thereto which could have been obtained as of right under rule 110(3)) had expired, whereupon, in accordance with normal office practice the applicant was informed (in a letter of 23rd June 1989) that the declaration of priority had been cancelled, the cancellation taking effect before publication of the application.

The agents for the applicant responded in a letter of 27th June 1989 stating that, according to their records, the priority document had been filed by hand on 15th March 1989. In support of this contention they filed with this letter a copy of a letter from the Japanese applicants

indicating that the document had been sent to the agents on 9th March 1989 and according to a stamp on the letter received in the agents' office on 13 March 1989. They also enclosed various other items of evidence viz (a) a copy of a sheet headed "documents filed on 15th March 1989 ... by hand" on which the Japanese priority document in suit was identified, (b) copies of two Patent Office receipts for other documents (a trade marks form TM8 and some amended pages and claims for patent application 8703973) indicating that there had been a submission to the Patent Office by them on 15th March 1989 and (c) a copy of a Patent Office fee sheet dated 14th March 1989 containing details of the trade marks form TM8 and two other fee-bearing items ie, a registered designs form 3A and a patents form 24/77. No receipts for the priority document or these other fee-bearing items were included .

Following receipt of this letter by the Patent Office a thorough search was made in the Patent Office including receipt records and the files of other applications for which the agents for the applicants had submitted documents on the 15th March 1989 but no trace of either a copy receipt for the priority document or the document itself was found. The result of this search was communicated to the agent by a formalities officer in a telephone call of 22nd August 1989 and the agent was at that time requested to file a statutory declaration in support of the document having been filed. The requested declaration, together with a certified translation of the missing priority document (due by 18th September 1989) were filed on 25th August 1989. The declaration (by the senior partner, Mr Sergeant) stated that, according to his firm's records, the document had been filed by hand on 15th March and that, on this day, Mr Sergeant himself had been in London on another matter and would personally have attended to the filing, along with that of the other documents for which the Patent Office receipts had been sent with his letter of

27th June 1989. The declaration, understandably in view of the time that had since elapsed, did not go as far as stating that Mr Sergeant recalled having filed the actual document in question.

The office was not satisfied that on the evidence so far provided, the agent for the applicants had shown, on the balance of probabilities, that the priority document had been filed and the agent was referred (in a letter of 8th November 1989) to the decision of the Patents Court in Aoki's application [1987]RPC page 133. In that same letter the office pointed out the existence of the procedure under rule 110(3A) whereby the comptroller has power to extend the period for filing a priority document in suitable circumstances. The letter also requested details of the agents' procedures in relation to Patent Office receipts for vital documents.

In response, there was received a letter dated 27th November 1989, and signed by the agents' senior partner Mr Sergeant, describing the above procedures and also the general office procedures in his firm for dealing with the preparation and filing of various classes of documents.

Having considered these procedures the Patent Office was still not satisfied that the document had been filed and a hearing was offered in a letter dated 27th December 1989. Following acceptance of this offer, the agents for the applicants received a replacement priority document from Japan (certified by the Japanese Patent Office on 29th January 1990) and this was lodged at the Patent Office on 12th February 1990.

The matter came before me at a hearing on 9th March 1990 when the applicants were represented by Mr A C Sergeant of the applicants' patent agents. Mr R G Evans was present on behalf of the Patent Office.

At the hearing Mr Sergeant submitted that, on the balance of probabilities, his evidence showed that the priority document had been filed by hand on 15th March. In support of this he relied firstly on his statutory declaration, the contents of which I have indicated above, and secondly on the letter of 27th November giving his office procedures.

According to this letter, the procedure for non-urgent documents (which at the time in question would have applied to the priority document in suit) is that they are "placed in a pigeonhole and sent to the Patent Office with the next urgent document or taken by hand when someone is to call at the Patent Office sufficiently soon". In the case of the priority document in suit the letter states that, since the filing was not urgent: "I (Mr Sergeant) would therefore have checked that the priority document was placed in the relevant pigeonhole and on the following Wednesday (the document has been shown to have been received in the agents' office on Monday 13th March 1989), I would automatically have taken it down to you myself". In response to my question at the hearing Mr Sergeant confirmed that no specific records of the progress of such a priority document within his office would have been kept. The letter goes on to say "In a small firm like this, such procedures have to rely on the personal attention of the partners". At the hearing Mr Sergeant conceded that he could not guarantee that all document movements are personally supervised by a partner, nor that all of the movements of the priority document in suit would have been so supervised. Some of this work would be carried out by a clerk/typist. However, Mr Sergeant re-affirmed, at the hearing that he would have performed the actual placing of the priority document in the aforesaid pigeon-hole.

When questioned about the status of the sheet, submitted

in evidence, and headed "documents filed on 15th March 1989 ... by hand" Mr Sergeant stated that this was a file record which would have been completed on receipt of the priority document and placed on the agents' own file for this case, prior to the placing of the document itself in the pigeonhole as specified above. The sheet, as I understand it, therefore represents an intention to file and not a record of despatch, as it were. The number of the application in suit would have been pencilled onto the priority document at this time. Since it was not the practice of the agents for the applicants to use covering letters in such situations this pencil note would be the only means by which the Patent Office could identify the relevant application. The preparation of the abovementioned sheet, its placing on the appropriate case file and the handing of the papers to the appropriate partner, in this case Mr Sergeant himself, would, as I understand it, all normally be done by a clerk/typist.

Regarding the handling of Patent Office receipts the letter states that: "Except for new applications, your document receipts are placed on an upright spike in this office and kept for reference. They are not individually checked ...". The letter adds that there would be no gain in checking receipts for priority documents since "No further action at this end depends upon such receipt, and in the time available it would not be possible to obtain a further certified copy from the patent office in the country of origin". At the hearing I understood Mr Sergeant to concede that, in some cases, there would be time to obtain a further copy.

It is convenient at this point to set out the Patent Office procedure in relation to non fee-bearing documents which have been lodged by hand. As explained by Mr Evans at the hearing, such documents are date-stamped at the counter in the front office where they are received and all patent documents then pass directly to a clerk

situated close-by in the same office area for receipting. Copy receipts for all patent documents are kept. Following receipting the documents are sent to, or more usually collected by, a member of that section of the office responsible for the next action upon them. Documents which appear to have been misrouted are either directed to the correct destination or, where this is not certain are returned to the front office "query" tray. In the case of a priority document filed after the date of the application, it would have been sent to or collected by one of the formalities units who would have added it to the relevant case file and minuted its arrival. If the relevant case was not apparent from the document (or a letter associated therewith) it would be returned to the front office "query" tray. The document would have also been returned to the Front Office by the formalities unit if it did not bear a receipt number indicating that it had been properly receipted.

Following the agents letter of 27th June 1989, a search was made through copy receipts for documents filed on 15th March 1989. Copy receipts for each document stated by the agent to have been filed on that day were found but no copy receipt could be found for the priority document in suit. The office search extended to the case files of all other applications for which the agent had lodged documents on that day. These were patent application 8703973 (for which amended pages and claims had been filed), patent application 8808001 (for which patents form 24/77 had been filed), trade marks application 1202817 (for which trade mark form TM8 had been filed) and designs application 1057807 (for which a designs form 3A had been filed). The "query" tray in the front office was also searched. The documents found during the search corresponded exactly to those stated by the agent to have been filed on the occasion in question, except for the priority document in suit, of which there was no trace. The office records confirmed that the filings by the

agents for the applicants on 15th March 1989 had indeed been made by hand. At the hearing, Mr Evans confirmed that no other records of the progress of documents through the front office were kept, but all of the operations described take place in a very limited area, and he thought the possibility of a document by-passing receipting altogether was very remote.

Guidance in applying the principle of balance of probabilities is to be found in Aoki's application [1987]RPC 133 which concerned a patents form 10/77 which was alleged to have been delivered to the Patent Office, but no trace of it could be found. In the report of the judgement on that case Falconer J said, at page 145, line 1, etc

"The first hurdle that the applicant has to get over in this case is to establish that the form 10/77 was delivered and, therefore, received - I think "received" is the important part, but I will leave it like that, delivered and received - by the Patent Office by the prescribed date; the onus for that is on the applicant himself. In the present case there is no direct evidence which establishes that fact that the form was received by the Patent Office. The applicant has to satisfy me of that fact on the balance of probabilities, if he can."

Falconer J. then goes on to quote from the opinion of Lord Brandon in Rhesa Shipping Co S.A. v. Edmunds [1985] 2 All E.R. 712 at 718 where I think the following passage is particularly apposite.:

"... the legal concept of proof of a case on a balance of probabilities must be applied with common sense. It requires a judge of first instance, before he finds that a particular event occurred, to be satisfied on the evidence that it is more likely to

have occurred than not. If such a judge concludes, on a whole series of cogent grounds, that the occurrence of the event is extremely improbable, a finding by him that it is nevertheless more likely to have occurred than not, does not accord with common sense. This is especially so when it is open to the judge to say that the evidence leaves him in doubt whether the event occurred or not, and that the party on whom the burden of proving that the event occurred lies has therefore failed to discharge such burden."

At the hearing, Mr Sergeant pointed out that the present case differed from Aoki in that, since no fee is involved, there is no independent record of the processing of the document concerned, which might help establish the likelihood of filing having occurred. Moreover, there are virtually no other records which might assist the determination. Although the evidence establishes that the priority document was received in the agents' office, nobody has gone on record as specifically recalling handling it. The only evidence that goes directly to the priority document rather than surrounding office routine is the sheet headed "documents filed on 15th March 1989 ... by hand", but, as noted above, this represents only an intention to file - it has not got the status of a "posted out" record so to speak. Moreover, there is no subsequent check of outgoing documents to determine whether they correspond to those that should be filed. There is no direct evidence of the fate of the priority document following the preparation of this sheet. It cannot be said for certain that the document ever reached the "pigeonhole" from which outgoing documents are collected for delivery to the Patent Office. As Mr Sergeant explained at the hearing, whilst the placing of such documents in the pigeonhole would have been done by a partner, the handling prior to that point would normally have been done by a clerk/typist and no direct evidence concerning the other movements of the document

has been supplied.

Within the agents' office, there is therefore no specific record or check that would have needed to have been by-passed in order for the document to have gone astray either before it reached a partner or subsequently, between the placing in the pigeonhole and collection for delivery to the Patent Office. The system employed relies solely, as I see it, upon what one might call "physical security", that is direct supervision by the firms partners, although, as has been admitted, it is not possible for partners to supervise every document movement.

Within the Patent Office, as Mr Evans explained, all incoming documents pass through a standard receipting procedure which, for patent documents, takes place in the front office itself. The copy receipts kept by the Patent Office can account for all documents which the agent for the applicant claims to have filed on 15th March 1989 except for the priority document. If the priority document had indeed been filed, it must somehow have missed both the receipting procedure and been misrouted within the office to a location where its presence would not have been questioned and it has remained there, undetected, ever since. As all application documents leaving receipting are matched up with a case file, and any that cannot be so matched or appear to have missed receipting are returned to the front office as "queries", the priority document would have needed to have eluded both the office records and this physical security procedure.

It must be said that a Japanese priority document is a very distinctive item (being of unusual size and tied with yellow ribbon) so total loss at any point in its movement is difficult to conceive. Nevertheless, the fact remains that no trace of the document has been found in either the

agents' office or the Patent Office over a very long period, and it is for me to determine on the evidence provided whether it is more likely to have been filed than not. I must say that the evidence on which I must decide this matter is very sparse indeed. However, it is clear from Aoki that the burden of proof rests with the agent for the applicant and it is open to me to say that this burden has not been discharged.

At the hearing, Mr Sergeant put it to me that , personal evidence that the document was filed should be sufficient and he indicated that in other countries, such as the United States, self-certification of filing would be regarded as sufficient. I take Mr Sergeant's submission as meaning that he considers his statutory declaration filed on 25th August 1989 should be taken as sufficient to discharge his burden of proof. I find this difficult to accept since the substance of the declaration itself is purely circumstantial, relying on what should, rather than upon what actually did, happen and Aoki has, I believe, established that something more is required.

Having considered all the evidence and submissions I therefore conclude that the burden of proof has not been discharged and accordingly that the priority document cannot be said to have been filed within the time permitted under rule 6(2).

I must now turn to rule 100 of the patents rules since this provides that, in certain circumstances, I have discretion to extend the times for filing documents. The rule reads as follows -

"(1) Subject to paragraph (2) below, 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 Patent Office may be rectified, on such terms as he may direct.

(2) Where the irregularity in procedure consists of a failure to comply with any limitation as to times or periods specified in the Act or the 1949 Act or prescribed in these Rules or the Patents Rules 1968(b), as they continue to apply, the comptroller may direct that the time or period in question shall be altered if the irregularity is attributable wholly or in part to an error, default or omission on the part of the Patent Office, but not otherwise.

(3) Paragraph (2) above is without prejudice to the comptroller's power to extend any times or periods under rule 110 below."

The office discharged its statutory obligations in respect of the missing priority document in a report under Section 17 of the Act on 17th January 1989 which I have dealt with above. This report bears the legend "please note that no further reminders will be issued". Thus, there is no custom and practice of the Patent Office issuing reminders concerning priority documents and translations thereof after this time and this fact was confirmed by Mr Evans at the hearing. It seems to me therefore that in the present case there is no proven error default or omission on the part of the Patent Office and thus the present circumstances cannot be said to fall within the terms of rule 100 (2). I conclude therefore that I have no discretion under this rule to extend the period allowed under rule 6(2) to allow filing of the priority document in suit.

During the course of the hearing I pointed out to Mr Sergeant that (as had been previously indicated to the agents for the applicants in the official letters of 8th November and 27th December 1989) the comptroller also has a discretion under rule 110(3A) to extend the time allowed under rule 6(2) for filing a priority document,

and Mr Sergeant indicated that he would wish to take advantage of this provision should I find against him on timely filing.

I consider that the evidence already submitted by the agents for the applicants is such as to demonstrate circumstances in which the comptroller's discretion under rule 110(3A) should be exercised favourably.

Accordingly, I direct that a period of one month from the date of this decision be allowed for filing an application under rule 110(3A) to extend the period for filing the priority document to 12th February 1990 (being the date upon which a replacement priority document was lodged at the Patent Office) and that, if such application is made, the extension should be allowed, and the priority document considered filed in due time. I impose no other terms on the grant of this extension.

I further direct that, if no such application under rule 110(3A) is made within the period specified above, then the priority date stands as lost.

This being a procedural matter, in accordance with R.S.C. Order 104, Rule 19, any appeal must be lodged within 14 days after the date of this decision.

Dated this 6th day of April 1990

I R BLOOMFIELD
Principal Examiner, acting for the Comptroller

THE PATENT OFFICE



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