

457.

PATENTS ACT 1977

Miss Durow
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IN THE MATTER OF Application
No 9424637.8 in the name of Intelligence
Quotient International Limited

DECISION

Documents in respect of an international application in the name of Intelligence Quotient International Limited were filed with the United Kingdom Patent Office (the "Office"), as receiving office under the Patent Co-operation Treaty ("PCT"), on 18 July 1994. These documents included a power of attorney under the Treaty, a specification in triplicate, and a certified copy of United States Application No 08/093,386, entitled "Method of Operating a Computer System", filed in the name of Peter B Malcolm on 19 July 1993. However, they did not include a request form PCT/RO/101 or any other indication of which Contracting States were designated.

On 20 July 1994, following a telephone call from the Office, the agents acting for the applicants faxed to the Office a copy of the request form, which he stated he had signed on 18 July 1994. In the request form, all 52 permissible designations had been made under PCT Rule 4.9(a). The request form also claimed priority based on the above US application.

The international application was allocated no PCT/GB94/0158 by the Office, in its capacity as the receiving Office. In addition, the Office notified the applicant that the filing of the request form enabled an international filing date of 20 July 1994 to be accorded to the application, with consequent loss of the claimed priority. However, in the covering letter filed on 20 July 1994, the agents for the applicants submitted that the documents received by the Office on 18 July 1994 contained everything necessary to establish a filing date under the PCT. In particular, they argued that it was clear from the documents received on that date that an international application was being filed, and accordingly that a designation of states was implicit. In this matter, the agents stated that Decision J 25/88 of the Legal Board of Appeal of the European Patent Office ("EPO") under the corresponding provisions of the

European Patent Convention ("EPC") held that there was no need for an explicit designation of any particular state and that in the absence of such designation the applicant should be considered to have filed a precautionary designation of all contracting states. This argument was developed in a further letter dated 21 July 1994, arguing that by analogy the documents filed should be deemed to contain an automatic designation of all PCT Contracting States.

In an official letter dated 15 August 1994, the receiving Office contended that, notwithstanding Decision J 25/88, the documents filed on 18 July 1994 did not suffice to fulfil the requirement of PCT Article 11(1)(iii) for the designation of at least one Contracting State, and that in consequence the international application should be accorded a filing date of 20 July 1994 with consequent loss of priority. In the letter, the receiving Office pointed out that, unlike precautionary designation under the EPC, the system of precautionary designations prescribed by PCT Rule 4.9(b) expressly required the designation of at least one Contracting State in the request, and did not permit all Contracting States to be designated by implication.

The applicants requested a hearing and the matter came before Mr B G Harden (the "hearing officer"), acting for the receiving Office, on 3 October 1994. In a written decision dated 6 October 1994, the hearing officer found that PCT Article 11(1)(iii)(b) required explicit designation of at least one Contracting State for a filing date to be accorded. He did not regard himself as constrained to follow the reasoning of the EPO Board of Appeal, stating:

"Taking the wording "the designation of at least one Contracting State" in Article 11(1)(iii)(b) by itself, I would consider it as requiring the actual designation of at least one state. The comment of Mr Reid that his interpretation would make this sub-paragraph superfluous is support, if such is needed, of my interpretation. The EPO decision J 25/88, on which Mr Reid relied, is also supportive of my interpretation. In paragraph 5 quoted above there is reference to the purpose of the corresponding provision in the EPC being not to establish whether or not such protection is sought at all in any EPC Contracting State, which is almost self-evident in case of a European patent application, but rather to provide information in how many and in which Contracting States protection is sought. However in reaching their conclusion the EPO Board took into account the revised wording on EPO Form 1001 and the consequential practice before the EPO. This Form and practice are not a direct requirement

of the EPC Articles. I do not consider that this Office as a receiving Office under the PCT should use the practice and Forms of the EPO to interpret a provision of the PCT in a sense contrary to the apparent clear meaning of the provision. If it is appropriate to resort to other matter to interpret an article of the PCT then the PCT Rules should be the first resort. PCT Rule 4.9(b) in providing for additional designations to be made has some analogy with the precautionary designation of the EPO Form 1001.

.....

Thus the Rule provides that these additional designations are subject to confirmation and additional fees and also to at least one Contracting State being designated under paragraph (a). These provisions both differentiate in detail from those of the EPO practice and reinforce the interpretation of Article 11 that at least one explicit designation is required for a filing date to be accorded."

The hearing officer also found that the error which had taken place could not be rectified under PCT Rule 91. Neither could it be rectified under rule 100 of the Patents Rules 1990 (the "Patents Rules") either by virtue of PCT Article 27(4), or directly having regard to the decision of the Court of Appeal in Prangley's Application [1988] RPC 187.

In consequence the hearing officer accorded the international application an international filing date of 20 July 1994 with the consequence that the priority date was ineffective.

On 6 December 1994, the applicants requested the comptroller to proceed earlier with the national phase of the international application under section 89A(3)(b) of the Patents Act 1977 (the "1977 Act").

The request was made on Form NP1 giving the international filing date as 20 July 1994 and the earliest priority date declared as 19 July 1993. It being determined that the requirements of section 89A(3)(b) were met, the international application was treated pursuant to section 89(1) of the 1977 Act as an application for a patent under that act (the "national application") and accorded application no 9424637.8. In accordance with section 89B(1)(a), the international filing date of 20 July 1994 was treated as the filing date of the national

application.

In their agent's letter also dated 6 December 1994 accompanying the request, the applicants set out the following submission in support of their request:

"Background

Our client, International Quotient International Limited, is a British company. On 19th July, 1993 a patent application was filed for the client in the U.S.A. on our instructions. The application is numbered 08/093,386 and was the first application anywhere in respect of the invention it discloses.

One day before the first anniversary we had prepared and were ready to file at the London branch of the British Patent Office documents for an International application claiming priority from the U.S. application. The documents made ready were (i) the PCT request form, (ii) three copies of the patent specification and drawings, (iii) a Power of Attorney signed by a director of the client company, and (iv) an officially certified copy of the basic U.S. application. Copies of the request form, the specification, the drawings, the Power of Attorney and the front page of the certified copy are filed with this letter.

For reasons which we cannot fully explain, the request form apparently became detached from the other documents, and was not sent with those other documents to the Patent Office on 18th July, 1994. This omission was only discovered on 20th July, 1994 when we received a telephone call from the Patent Office, Newport branch. We immediately filed the request form, a copy of which is filed with this letter.

As stated above, following a Hearing on 3rd October 1994 a Decision was issued by the Receiving Office on 6th October 1994 according the later filing date of 20th July 1994 with consequent loss of priority.

Requests under Rule 100 of the Patents Rules 1990

(a) *Firstly, Article 27(1) (sic) provides:-*

(4) *Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the view point of applicants, are more favorable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application.*

Secondly, Section 15(1) of the Patents Act 1977 specifies the minimum requirements for filing an application under the "national law". It is submitted that all of those requirements were met on 18th July 1994.

It is respectfully requested that the Comptroller exercises his discretion under Rule 100 to effect any amendment of the documents necessary in order that the international application be treated as if it was an application under the 1977 Act ab initio as far as the United Kingdom is concerned.

(b) *In the alternative, it is requested that Article 27(4) PCT be invoked to allow the Comptroller to exercise his discretionary powers under Rule 100 to amend the international application so as to remove the formal deficiency of lacking a specific designation, Rule 100 being part of the "national law" referred to in Article 27(4). Attention is drawn to the fact that under Section 15(1) of the Patents Act 1977 no Request form (Patents Form No 1/77) is required to establish a filing date. In view of the fact that we had instructions to file an international application designating all PCT contracting states, it is respectfully requested that Rule 100 be used either to correct the "irregularity in procedure" constituted by omission of the PCT Request form designating all states, or to amend the documents filed on 18th July 1994, eg the Power of Attorney, to indicate that an International Application was being filed designating at least one PCT contracting state. That such an amendment is required is obvious from the self-evident and undeniable logic that any International Application includes at least one designation, at least by implication. Support for the retrospective addition of a designation of states to a document filed in the*

international phase, using Rule 100, exists in Prangley's Application [1988] RPC (see particularly page 194 at lines 43 to 51).

Further support exists in the form of Decision J25/88 of the European Patent Office Legal Board of Appeal, a copy of which is filed with this letter. In this case, which relates to a European application, it was held, effectively, that in a situation in which all of the minimum filing requirements except the designation of at least one state were met, and in which this deficiency occurred because of the omission of the Request form, the documents which were received should be regarded as including a precautionary designation of all EPC States. In other words the application should be treated as if the Request form had been filed, including the usual pre-printed precautionary designation.

It is established law that European Patent Office decisions have "considerable persuasive authority" (see Asahi Kasei Kogyo KK's Application [1991] RPC at lines 25 to 30) and not least in view of the long title of the '77 Act (see Daido Kogyo's Patent [1984] RPC '97). In B. and R. Relay's Application ([1985] RPC 1) it was stated that in this jurisdiction "it is of the greatest importance to take account of the decisions of the EPO".

It is submitted that this range of precedents gives the Comptroller the power to amend the documents filed on 18th July 1994 as suggested above to allow accordal of 18th July 1994 as the filing date for the United Kingdom.

- (c) *As the basis of a further alternative request under Rule 100, it is noted that Article 48(2) PCT provides:-*
- (a) *Any Contracting State shall, as far as that state is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.*
 - (b) *Any Contracting State may, as far as that State is concerned, excuse for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit.*

We hereby request, under these provisions, that the Comptroller exercises his discretion under Rule 100 to amend the international application insofar as it relates to the United Kingdom thereby excusing the delay in providing a specific designation of states.

Requests under Section 89 of the Patents Act 1977 and Article 25 PCT

Article 25(1)(a) and 2(a) of the PCT provides that "Where the Receiving Office has refused to accord an international filing date ... each designated Office [named by the applicant] shall ... decide whether the refusal ... was justified under the provisions of this Treaty and the Regulations, and, if it finds that the refusal ... was the result of an error or omission on the part of the receiving Office ..., it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred."

In the present case, the Receiving Office refused to accord the requested international filing date of 18th July 1994.

It is submitted that the Receiving Office was in error in the Decision of 6th October 1994 at least on the grounds that the Hearing Officer was incorrect at lines 17 to 18 of page 6 of the Decision to resort to the PCT Rules to interpret the PCT. The Rules must conform to the Treaty on the latter's true interpretation rather than vice-versa. Decision J25/88 of the European Patent Office has persuasive authority rather than binding authority in the situation before the receiving Office and should be used to support the analogy between an application filed in the circumstances described in Decision J25/88 and the present application as sought to be filed on 18th July 1994, given that the precautionary designation filing in the European Patent Office and PCT Request forms are similar.

In accordance with Rule 85(12) of the Patents Rules 1990, we file with this letter Patents Form No 44/77.

In the event that it is decided that Article 25 PCT and/or Rule 85(12) are inapplicable to the present situation, we hereby request amendment of the documents filed on 18th July 1994 to include the required designation or alteration of the time period required to file a specific designation under Rule 85(11) of the Patents Rules 1990. The grounds for such request are

as set forth above in the request under Article 25 PCT.

As a final point, the observations of Whitford, J. in Tomo Kogyo Co. Inc.'s Design Application ([1983] RPC 207) is cited as support for giving the present application the requested filing date as far as the United Kingdom is concerned. That observation was that applicants and their agents were not always to be treated as one. If failure to take relevant action was entirely the fault of the agent, it would be wrong to visit that default or neglect upon the applicant."

In an Official Letter dated 18 January 1995, the Office rejected the three requests under rule 100 for the following reasons:

"Request (a) under rule 100 of the Patents Rules 1990

.....

It is the view of the Office that the requirements of section 15(1) were in fact not satisfied on 18 July 1994 and that discretion under rule 100 should not be exercised on the above grounds. Thus, section 15(1)(a) requires that:

"(a) the documents filed at the Patent Office contain an indication that a patent is sought in pursuance of the application."

In addition, "patent" is defined in section 130(1) as meaning a patent under the 1977 Act. In the absence from any of the documents filed on 18 July 1994 of the designation of the "United Kingdom" or any other indication that a patent was being sought under the 1977 Act it does not appear possible to say that the conditions of section 15(1)(a) were satisfied on 18 July 1994.

Request (b) under rule 100 of the Patent Rules 1990

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In the case of an application under the PCT, the appropriate document for designating States is the PCT Request Form. However, this had not been received in the Office on 18 July 1994 and none of the documents filed on that date were suitable for designating the United Kingdom. It therefore appears to the Office that, having regard to the reasoning of the Court of Appeal in Vapocure Technologies Ltd's Application [1990] RPC1 (see page 20 at lines 19-24 and 29-35), rule 100 cannot be invoked either to "correct" the omission of the request form or to "amend" any of the documents actually filed on 18 July 1994.

In addition, to allow a correction by whatever method would have the effect of circumventing the specific requirement of Article 11(1)(iii)(b) that the application should contain at the time of receipt the designation of at least one Contracting State. However, it was decided in E's Application [1983] RPC 231 that rule 100 should not be construed in such a way as to stand on its head the well-established canon of construction generalia specialibus non derogant (see sentence bridging pages 250-1).

You also cite EPO decision J25/88 in support of your arguments. However, this was fully considered in the decision of the receiving Office of 6 October 1994 and for the reasons set out in this decision, it does not overcome the objections raised above.

Request (c) under rule 100 of the Patents Rules 1990

....

It is the view of the Office that PCT Article 48(2)(a) is not applicable since there is no reason under national law for excusing the delay in satisfying the requirement of Article 11(1)(iii)(b) in the circumstances of this case.

Further, although PCT Article 48(2)(b) allows other reasons, there would again appear no justification for construing rule 100 in such a way as to circumvent the specific requirement of Article 11(1)(iii)(b)."

The Office also rejected the remaining requests for the following reasons:

"Request under section 89(5) on Form 44/77

The arguments which you submit were fully considered by the hearing officer in reaching his decision. The Office considers the reasoning in this decision to be correct and does not therefore accept that the decision of the receiving Office to refuse the filing date of 18 July 1994 was caused by an error or omission. In addition, prima facie the application is not properly lodged since the international application was not refused a filing date under the Treaty but was accorded the date of 20 July 1994.

Amendment under rule 85(11) of the Patents Rules 1990

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For the reasons stated above, the Office does not accept that there was any such error or omission.

Default by agent

Finally you cite the observations of Whitford J in Tomo Kogyo Co Inc's Design Application [1983] RPC 207 that applicants and their agents were not always to be treated as one in support of giving the applicant the requested filing date.

However, in that case a decision of the Registrar refusing to exercise his discretion to extend the period for bringing two design applications in order for grant was upheld by the Patents Court. It is the view of the Office that the observations of the judge in that case do not outweigh the other considerations discussed above."

The official letter concluded that a filing date of 18 July 1994 could not be accorded for the United Kingdom, but offered a hearing to resolve the matter.

The applicants replied in an agent's letter dated 27 February 1995 in the following terms:

"In response to the official letter of 18th January 1995, appointment of a Hearing is requested. However, in view of the forthcoming Judicial Review of the Decision of the

Receiving Office dated 6th October 1994 and the interaction between the issues to be considered in the national phase and the international phase, we request the Hearing be stayed until after the Judicial Review has been heard.

In order to clarify the issues and to facilitate generally the discussion at the Hearing we make at this stage the following observations.

PCT/1977 Act interface

The present matter generally lies at the interface between the role of the United Kingdom Patent Office in exercising functions under the PCT and its role in exercising functions under the 1977 Act for domestic applications. And as pointed out by the Court of Appeal in Prangley's Application ("Prangley") 1988 RPC 187 at 189-90:

"This intermeshing of international and national activity has led to some considerable complexity in the rules which national patent authorities (such as the United Kingdom Patent Office) are bound to observe."

The learned Hearing Officer in his decision of 6 October 1994 in connection with the international phase of the present application relied upon the decision of Mr Justice Aldous in R v Comptroller-General ex parte Kenrick ("Kenrick"), now reported fully in 1994 RPC 635.

It is correct that Mr Justice Aldous stated at page 8, lines 18-22:

"The PCT is a complete code. The Patent Office's jurisdiction to act as the receiving office under the PCT, came from the PCT and, when so acting it must apply the rules, regulations and conditions laid down in the PCT."

The width of this dictum (and it is a dictum since the ratio decidendi of the Kenrick decision is much narrower) is recognised. Moreover, he proceeded at lines 25-26 to state:

"As essential aim of the PCT is to bring about uniformity."

It is submitted that it is clear from the context that the learned Judge regarded the need for uniformity of application of the PCT from one country to the other as being important, and as underpinning his dictum as to "complete code".

But a corollary of the "complete code" standpoint is that the United Kingdom Patent Office (or other relevant judicial body), when interpreting the PCT and applying the same to circumstances arising from its own receiving function, should act in accordance with the canons of construction applicable to international treaties rather than the canons applicable to purely domestic legislation. These are not necessarily identical; by taking an international standpoint to construction, international harmonisation is assisted.

A further consideration, not dwelt upon in the Kenrick, is that the PCT and the UK domestic legislation (or other domestic national legislation) do not subsist in totally separate watertight compartments. The potential interplay between the two is reflected in, for example, Articles 27(4) and 48(2) of the PCT. Article 27(4) empowers the national office to apply national law instead of the PCT (or Regulations thereunder), in certain designated circumstances - although the applicant can insist upon treatment under the PCT if he prefers. In short, the applicant has in such instances an option as to the applicable law. Article 48(2) empowers a contracting state, ie a national Patent Office, being the governmental authority through whom the contracting state exercises its functions, to excuse (within designated bounds) any delays in meeting time limits. Additional submissions as to the true scopes of these Articles may be made at the forthcoming hearing.

Another example taken from the overall body of the 1970's legislation (EPC, PCT, CPC, and national laws as amended to be in conformity therewith), although not directly relevant in the present case, is of course represented by Article 150(2) of the EPC. This provides that in cases of conflict between the EPC and PCT as regards treatment of international applications filed in the European Patent Office, the provisions of the PCT should prevail.

Generally, it is suggested that the drafters of the new patents legislation of the 1970's were very much aware of the fact that a new era was being embarked upon; and that in these uncertain waters there would necessarily be interaction between the various legal provisions at both intranational and international level. The more cautious vein of the decision of the Court of Appeal in Prangley - note the introduction to the judgement generally - reflects this

consideration better than the more trenchant vein of the decision of the Patents Court in Kenrick.

Attention is drawn finally to the significance accorded in Prangley to the applicant's original intention in relation to the mishap which subsequently occurred. At page 194, lines 49-50:

"It is accepted that such amendment or rectification would give effect to the applicant's intention at the time when the demand was made."

Kenrick totally ignores this factor, even though it would appear self-evident from the facts of the case that the applicant there wanted his international application to be filed by 16 December 1993 in order to be able to claim the priority of 16 December 1992.

It is of course appreciated that the instant situation (both at the international phase stage and current national phase stage) is of different kind to those present in Prangley and Kenrick; also to that present in the Vapocure Technologies cases referred to in the Official Letter of 18 January. Hence that none of these decisions ranks strictly as a controlling precedent.

Generalia specialibus non derogant

The remarks in the Official Letter concerning the reliance by Lord Diplock in E's Application 1983 RPC 231 upon this maxim are noted. But it is suggested that the maxim (to be translated as "general provisions will not abrogate special provisions" -see Craies on Statute Law 4th Edition (1971) at pages 377-382) hardly supports the Patent Office's stance in this case. If Article 11(1) of the PCT be regarded as the "general provision" concerning filing requirements, then it cannot override the "special provisions" of Articles 27(4) and Article 48(2) insofar as the latter apply to the general provision. Article 27(4) hence paves the way to the application of Section 15(1) of the 1977 Act, alternatively Article 48(2) to the application of Rule 100 of the 1990 Patents Rules.

....."

The applicants' request for a stay was granted in an official letter dated 2 March 1995. However, proceedings were resumed following the withdrawal of the application for judicial

review in question.

Following the resumption, the applicants new agents (Reddie & Grose) wrote to the comptroller in the following terms on 26 July 1995:

"I write in reply to your letter of 6th July 1995, asking whether the applicants wish the Office to continue to review the filing date accorded by the Receiving Office, and if so, whether we wish to be heard in this matter.

The applicants do wish you to continue this review. They do not wish to be heard in this matter, but if you felt you would like clarification or particular submissions in any area, would be very happy to respond in that respect.

Accordingly we ask that the matter be dealt with on the basis of the documents presently on file, supplemented by the enclosed and the following.

We attach copies of a communication from the European Patent Office dated 24th April 1995, the applicant's previous agent's reply of 2nd May 1995, and a subsequent communication from the European Patent Office of 16th June 1995.

We would refer you to paragraph 7 et seq of the communication of 24th April 1995. This raises an interesting question as to the precise reasons for the rejection of the filing date, and whether those reasons would be applicable under British National law.

It would appear as accepted that the only point missing from the application, which has forced you, as Receiving Office, not to accord to the filing date requested, is the omission of a designation. Everything else is clear from the documents that you have.

Two points arise on this. First of all, as set out clearly in the reasoning of the European Patent Office, there is nowadays an implicit designation of all countries in a PCT (or indeed EPO) application. This is recognised by the two authorities primarily charged with conducting the operation of Euro-PCT cases, namely WIPO and the European Patent Office. Both now recognise that an application for a patent under either of their regimes is, initially, to be taken as designating all states, on a precautionary basis, and this precautionary

designation persists for a short period of time following the filing of the application. This short period of time allows for corrections, the payment of fees, and any other necessary formalities to clarify the precise position.

This is an entirely reasonable approach. The patent system is not intended to be something that can only be operated by infallible experts. It is surely a system that is there to serve industry, and industry must be able to use it in a practical way. Third parties are not put at risk in this procedure. Until the application is formally published, they are not aware of its existence, and therefore cannot be prejudiced by this approach. Only on publication, do they need to be appraised of the position, a consideration that is borne out in several EPO decisions.

A second point is this. The purpose of the review is to determine whether the application would have received a National filing date, had it been filed at the National Office. I submit that it would. First of all the requirements for making the application were complied with. In a British application, there is no need to make a designation; such a designation is implicit. Accordingly, the absence of a designation is of no consequence under British law.

Secondly, putting it on a slightly different footing, I would argue that the documents filed did, in fact, constitute a British patent application (quite separately from constituting a PCT application) and had the Office reacted promptly in advising the applicants of the missing documents, they could have been corrected. On that basis, I submit that the application as actually filed was a proper application, and any delay in subsequent action is due to (in the circumstances, understandable) failure of the Office to advise us of the missing details. This is a particularly unusual situation, which has arisen so far as we are aware for the first time, and it is believed that it would be appropriate to allow an unusual solution. You will be aware that the European Patent Office has on a number of occasions agreed to allow certain discrepancies to pass, on the understanding that subsequent to the date of that decision, such a failure would not be forgiven again.

Accordingly, I request re-consideration on the grounds previously submitted to you, together with the points noted above read in the light of the enclosures."

It accordingly falls to me to decide, in the light of the submissions in the agents' letters of 6 December 1994, 27 February and 26 July 1995 whether the national application should retain the filing date of 20 July 1994 accorded by the Office, or be given a filing date of 18 July 1994 for any of the reasons given in the agents' letters aforesaid.

As explained above, in his decision of 6 October 1994, the hearing officer acting for the receiving Office found that the documents constituting the international application filed on 18 July 1994 did not satisfy the requirements of PCT Article 11(1)(iii)(b) and subsequently accorded an international filing date of 20 July 1994, this being the first date on which all of the requirements of Article 11(1) were met. Article 11(1)(iii)(b) reads:

"

Article 11

Filing Date and Effects of the International Application

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:

...

(iii) the international application contains at least the following elements:

...

(b) the designation of at least one Contracting State,

..."

The procedure in respect of this provision is prescribed by PCT Rule 4.9 which reads:

"4.9 Designation of States

- (a) Contracting States shall be designated in the request:
 - (i) in the case of designations for the purpose of obtaining national patents, by an indication of each State concerned;
 - (ii) in the case of designations for the purpose of obtaining a

regional patent, by an indication that a regional patent is desired either for all Contracting States which are party to the regional patent treaty concerned or only for such Contracting States as are specified.

- (b) The request may contain an indication that all designations which would be permitted under the Treaty, other than those made under paragraph (a), are also made, provided that:
 - (i) at least one Contracting State is designated under paragraph (a), and
 - (ii) the request also contains a statement that any designation made under this paragraph is subject to confirmation as provided in paragraph (c) and that any designation which is not so confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit.
- (c) The confirmation of any designation made under paragraph (b) shall be effected by
 - (i) filing with the receiving Office a written notice containing an indication as referred to in paragraph (a)(i) or (ii), and
 - (ii) paying to the receiving Office the designation fee and the confirmation fee referred to in Rule 15.5within the time limit under paragraph (b)(ii)."

The first matter I must decide is the applicants' submission under PCT Articles 25(1)(a) and 2(a) that the Office in its capacity as receiving Office was in error in refusing to accord an international filing date of 18 July 1994.

These articles read:

" **Article 25**

Review by Designated Offices

(1)(a) Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn, or where the International Bureau has made a finding under Article 12(3), the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to any of the designated Offices named by the applicant.

(2)(a) Subject to the provisions of subparagraph (b), each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in paragraph (1) was justified under the provisions of this Treaty and the Regulations and, if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred."

The provisions of these Articles are given effect in the United Kingdom by section 89(5) of the 1977 Act and, at the date of entry into the national phase, by rules 85(11) and (12) of the Patents Rules 1990. Section 89(5) reads as follows:

" (5) If an international application for a patent which designates the United Kingdom is refused a filing date under the Treaty and the comptroller determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act, having such date of filing as he may direct."

Rules 85(11) and (12) read:

- " (11) Where the applicant satisfies the comptroller that,—
- (a) because of an error made by the receiving Office, an international application for a patent (UK) has been accorded a date of filing which is not correct; or
 - (b) the declaration made under Article 8(1) of the Patent Co-operation Treaty has been cancelled or corrected by the receiving office or the International Bureau because of an error made by the office or the Bureau,

the comptroller may amend any document received by the Patent Office from the receiving office or the International Bureau or alter any period or time which is specified in the Act or these Rules as if the error were an error on the part of the Patent Office.

- (12) Where—
- (a) an international application for a patent (UK) purports to designate the United Kingdom; and
 - (b) the applicant alleges that he has been refused a filing date under the said Treaty on account of an error or omission in any institution having functions under the said Treaty,

the applicant may apply to the comptroller for it to be treated as an application under the Act by filing Patents Form 44/77, accompanied by a statement of the facts upon which he relies; and the comptroller may amend any document filed by the applicant and alter any period or time which is specified in the Act or these Rules upon such terms as he may direct."

The applicants' submission is that following EPO Decision J25/88 in respect of applications under the EPC, PCT Article 11(1)(iii)(b) and PCT Rules 4.9(a) and (b) do not require the explicit designation of at least one Contracting State and that the requirements of that Article were satisfied by implication.

However, Decision J 25/88 was fully considered by the hearing officer in his decision of 6 October 1994. In addition, the applicants do not appear to have contested in any way the

Office view stated in the official letter of 18 January 1995,

- that there is no apparent error or omission in the decision of the receiving Office on which an application under section 89(5) and rule 85(12), or alternatively under rule 85(11), can be founded, and
- that the application section 89(5) and rule 85(12) was not properly lodged because a filing date had not been refused.

Having considered the hearing officer's decision, I am not in any way persuaded by the submissions in the applicants' letter of 6 December 1994 recited above that the hearing officer was wrong in his findings in the matter. I am also re-inforced in this view by a further decision of the EPO referred to below that:

"Rule 4.9(b) PCT depends on at least one express designation in the request in accordance with Rule 4.9(a)."

I therefore find that the Office in its capacity as receiving Office corrected accorded an international filing date of 20 July 1994.

The next matter I must decide is whether, notwithstanding my finding that the international application was correctly accorded an international filing date of 20 July 1995, the application should be accorded a United Kingdom national filing date of 18 July 1995.

The applicants have made two submissions on this. The first is in essence that the United Kingdom Patent Office should follow the decision of the EPO in its communication of 24 April 1995 to accord a filing date of 18 July 1994 for the purposes of the regional phase of the application under the European Patent Convention.

The relevant parts of this decision read:

"7.3 Both the PCT and EPC procedures provide for precautionary designation, the function of which is to prevent losses of rights in respect of territorial protection. However, while the PCT mechanism contained in Rule 4.9(b) PCT depends on at least one express designation in the request in accordance with Rule 4.9(a) PCT, the practice of precautionary designation under the European system is more favourable to the applicant in having no such requirement. The precautionary designation as incorporated into the request form (EPO Form 1001) not only ensures that Article 79(1) EPC is met but also has the effect of fulfilling the requirement of Article 80(b) EPC.

7.4 What is more, whereas the operation of the precautionary designation under Rule 4.9(b) PCT assumes the use of the PCT request form, by virtue of Decision J25/88 (OJ 1989, 486) the principle of precautionary designation under the European patent system applies even where EPO Form 1001 has not been filed. In this Decision, the Legal Board of Appeal reasoned that the practice of precautionary designation in applications made on EPO Form 1001 represents a presumption of a general wish among applicants to designate all Contracting States in the initial stage of the filing of a European patent application, and that this presumption can equally apply in cases where the form has not been used. Thus, in the Board's view, for the purpose of according a filing date under Article 80(b) EPC there is no need for an explicit designation of any particular Contracting State, and in the absence of such a designation, the documents filed are to be considered to contain a precautionary designation of all Contracting States (point 6 of the reasons).

7.5 In spite of the requirement of Rule 4.9(b) PCT that at least one express designation is made in the PCT request, there appears to be no reason why the EPO should not exercise its discretion under Article 27(4) PCT in so far as the European part of an international application is concerned, and apply the principle laid down in J25/88."

As already referred to above, in paragraph 7.3 of this decision states:

"..... the PCT mechanism contained in Rule 4.9(b) PCT depends on at least one express designation in the request in accordance with Rule 4.9(a) PCT"

However, since the procedure under the European system pursuant to Decision J25/88 was more favourable to the applicant than that under the PCT, the EPO decided to apply the more favourable requirements to the regional phase in accordance with PCT Article 27(4).

This Article reads:

"

Article 27
National Requirements

...

(4) Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the view-point of applicants, are more favorable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application."

However, practice before the EPO in respect of precautionary designations of Contracting States is of no relevance to national applications under the 1977 Act since no equivalent procedure exists under that Act.

I am therefore unable to give any weight to the EPO decision, apart from noting above that it confirms the hearing officer's finding that there must be at least one express designation in accordance with PCT Rule 4.9(a).

The applicants' second submission contained in their agents' letter of 26 July 1995 is that the requirements for according a United Kingdom national filing date were met on 18 July 1994.

The requirements for according a national filing date under the 1977 Act are set out in section 15(1). In particular, section 15(1)(a) states:

"15.—(1) The date of filing an application for a patent shall, subject to the following provisions of this Act, be taken to be the earliest date on which the following conditions are satisfied in relation to the application, that is to say—

(a) the documents filed at the Patent Office contain an indication that a patent is sought in pursuance of the application;"

In addition "patent" is defined in section 130(1) as follows:

"patent" means a patent under this Act".

However, there was no indication in the documents received by the Office on 18 July 1994 that the applicants were seeking a national application under the 1977 Act. Indeed, it was not until the receipt of the letter dated 26 July 1995 from the applicants' new agents that this was even mentioned. All the proceedings until that date were solely on the basis that the applicants were seeking an international application which, having been accorded an international filing date of 20 July 1994, is now being treated in the United Kingdom as an application for a patent under 1977 Act for the purpose of Parts I and II of the Act pursuant to section 89(1) which reads:

" 89.—(1) An international application for a patent (UK) for which a date of filing has been accorded under the Patent Cooperation Treaty shall, subject to—
section 89A (international and national phases of application), and
section 89B (adaptation of provisions in relation to international application),
be treated for the purposes of Parts I and III of this Act as an application for a patent under this Act."

The applicants appear to suggest in the paragraph of the agents' letter of 26 July 1995 recited above starting "Secondly, putting it on a slightly different footing" that the one set of documents filed at the Office could be regarded as both an international application and a UK national application in the absence of any indication as to which was sought. In my view, such a proposition is completely untenable having regard to the express provisions of PCT Article 11(1) and section 15(1) of the 1977 Act.

I therefore find that the documents filed with the Office on 18 July 1994 did not satisfy the requirements for according that date as the filing date of an application under the 1977 Act since it did not contain the indication prescribed by section 15(1)(a).

I now come to the applicants' requests under rule 100 of the Patents Rules. The relevant parts of this rule reads:

"Correction of irregularities

100.—(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) In the case of an irregularity or prospective irregularity—

- (a) which 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 as they continue to apply which has occurred, or appears to the comptroller is likely to occur in the absence of a direction under this rule;
- (b) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office; and
- (c) which it appears to the comptroller should be rectified,

the comptroller may direct that the time or period in question shall be altered but not otherwise.

..."

Although the hearing officer found in his decision of 6 October 1994 that amendment under this rule was not possible in the international phase of the application, I am satisfied that now that the application has entered the national phase, amendment under rule 100 may now be possible for the purposes of the United Kingdom only. I am re-inforced in this view by the decision in Prangley's Application referred to in the correspondence recited above.

The applicants are seeking amendment of the documents filed on 18 July 1994 under three separate heads (a) to (c). They do not particularise the amendments but merely seek such amendment as would allow a filing date of 18 July 1994 to be accorded for the purposes of the United Kingdom. As I see it, there are, however, only two possibilities. The first is to allow amendment to comply with section 15(1) of the 1977 Act. The second, is to allow amendment to comply with PCT Article 11(1)(b)(iii).

As regards the first of these alternatives, I have already found that the requirements for according a UK national filing date of 18 July 1994 were not satisfied because the documents filed on that date did not include the indication required by rule 15(1)(a).

It seems to me apparent that to allow such an indication to be added under rule 100 after the date on which the documents constituting the application were filed in the Office and then to accord that date as the date of filing under section 15(1) would clearly be contrary to the express provisions of section 15(1) that the date to be accorded is the earliest date on which all of the conditions are satisfied.

In my view, it follows that such amendment would also be in contravention of the established canon of construction "*generalia specialibus non derogant*" notwithstanding the applicants' submissions in this matter.

The effect of these findings is that, in contrast to the situation before the EPO, there are thus no provisions of UK national law in this respect which are more favourable to the applicants for the purposes of PCT Article 27(4).

As regards amendment to comply with PCT Article 11(1)(b)(iii), the applicants refer to the decision in Prangley's Application. However, in Vapocure Technologies Ltd's Application

referred to in the official letter of 18 January 1995, the Court of Appeal found that:

"In support of the ground of appeal added by amendment, the appellant's counsel relied on *Prangley's Application* [1988] RPC 187. That case is, in my opinion, clearly distinguishable from the instant case in this very important respect, that Prangley had designated the United Kingdom in his international application. The problem in that case was concerned not with a defect in designation, but a defect in demanding an international preliminary examination.

....."

In my view, the same distinction applies equally to the application in suit.

In *Vaporcure*, the Court of Appeal went on to find that:

"Rule 100 of the Patents Rules 1982, as substituted by rule 11 of the Patents (Amendment) Rules 1987, relates exclusively to documents filed in proceedings before the Comptroller, and irregularities in procedure in or before the United Kingdom Patent Office and could, in my opinion, only be invoked in the present case if the appellant could successfully assert that the international application must be treated as having designated the United Kingdom, which for reasons already given, I do not consider to be the case."

In my opinion, this rules out any possibility of amending the international application under rule 100 to accord an earlier international filing date.

Even if this were not the case, to allow the designation of at least the United Kingdom as a Contracting State, thereby to permit the 18 July 1995 to be accorded as the date of filing of the international application, would be in clear contravention of the express provisions of PCT Article 11(1)(iii)(b). The same considerations therefore apply in this respect as in the case of amendment under rule 100 to comply with section 15(1).

Accordingly, I refuse the applicants' request for amendment under rule 100 of the documents filed on 18 July 1994 to enable that date to be accorded as the filing date for the purposes of the United Kingdom.

The applicants' also sought relief in their letter of 6 December 1994 on the grounds, based on observations of the judge in the Tomo Kogyo case, that the failure to file the request form on 18 July 1994 was their agents' fault and it would be wrong to visit that default or neglect upon them.

However, the applicants have not sought to contest the view expressed in the official letter of 18 January 1995 that these observations do not outweigh the other considerations raised in that letter.

Having considered the matter, I am in agreement with this view.

In consequence of my findings above, I direct that the application should proceed in the national phase in the United Kingdom with a filing date of 20 July 1994. As a consequence, the priority date of 19 July 1993 cannot be restored.

Although not deciding the matter, I would note that the consequence of this direction, taken with the decision of the EPO to allow the application to proceed under the EPC with a filing date of 18 July 1994 and priority date of 19 July 1993 would appear to be that the European patent application now forms part of the state of the art for the purposes of section 2(3) of the 1977 Act which reads:

"2(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say—

(a) that matter was contained in the application for the other patent both as filed and as published; and

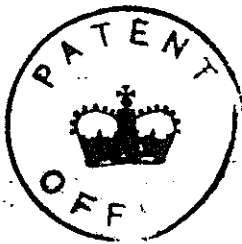
(b) the priority date of that matter is earlier than that of the invention."

This being a substantive matter the applicants have a period of six weeks pursuant to Order 104, rule 19 of the Rules of the Supreme Court to lodge an appeal against this decision.

Dated this 30th day of October 1995



L LEWIS
Principal Examiner, acting for the Comptroller



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