



BL O/114/06

5<sup>th</sup> May 2006

## PATENT COOPERATION TREATY

APPLICANT	Brian George Knight
ISSUE	Whether international patent application number PCT/GB 2006/000410 can be accorded a filing date
HEARING OFFICER	H J Edwards

---

## DECISION

- 1 The United Kingdom Patent Office acting as Receiving Office under the Patent Cooperation Treaty (PCT) has concluded that this purported international application cannot be accorded a filing date of 3 February 2006 – the date on which the Request Form and certain supporting documentation were received. The reason was that the documentation did not contain a part which on the face of it appeared to be a claim or claims. The agent has requested that certain parts of the documentation be considered to be claims, but the Receiving Office maintained its view and a hearing was arranged. Although the PCT does not include provision for participating offices to have their decisions reviewed on appeal to a higher judicial level, the United Kingdom Patent Office has offered such hearings by analogy with hearings under the Patents Act 1977 on UK patent applications. The matter therefore came before me on 9 March 2006, when the applicants were represented by Richard Davis of counsel, instructed by Maguire Boss. Mr B Micklewright from the Office was present to assist me on administrative matters.

### History

- 2 In more detail therefore, received on 3 February 2006 were the Request Form – which indicated in its check list section that the international application should contain six pages of description, two pages of claims, one page of abstract and two pages of drawings – and appended pages which actually comprised six pages of what seemed to be description (numbered 1 to 6), one page bearing a paragraph headed Abstract (numbered 7) and two pages of drawings. The Receiving Office concluded therefore that the two intended pages of claims had been omitted, and *ex officio* amended the Check List accordingly.
- 3 The Receiving Office notified the applicant of this defect relative to the requirements of Article 11(1)(ii)(e) and Rule 6 PCT by issuing form

PCT/RO/103 on 10 February 2006. It did not however set a period for reply for filing a correction (Rule 20.6(b) specifies a reply period between ten days and one month). This was rectified on 10 March 2006 when the form was re-issued with a ten-day response period. On 10 February the Receiving Office also drew the applicant's attention to a previous decided case with considerable similarities to the present case: *R. (On the application of Penife International Ltd) v Comptroller-General of Patents, Trade Marks and Designs [2004] RPC 37*, which I shall refer to below as "Penife". This was an application for judicial review of a decision of mine concerning a previous international application where claims were not presented with the other filing documents.

- 4 At one point the agent requested that the text headed Abstract be considered as a claim. He pointed out that the single paragraph of the Abstract has the construction of a claim, as it is in two-part form, viz "Spray apparatus of the kind having .....characterized in that....." He confirmed indeed that the text was identical to claim 1 in one of the two GB applications from which this international application claims priority. The Receiving Office declined the agent's request.
- 5 The agent requested alternatively that a numbered list that concludes the description be treated as a set of claims. This list, with its introductory wording, starts at line 15 of page 5 and extends to line 2 of page 6 and reads:

"Thus the present invention permits:-

1. The use of the return line to provide extra flow to the boom when spraying.
2. A reduction in the size of the feed lines because the return line provides extra flow when spraying.
3. The purging of the spray line under pressure when filling with chemical.
4. The use of a single control valve to control the feed and return flows.
5. The ability to clean the system by incorporating clean water into the filling point (on board tank or independent supply)."

The Receiving Office also declined this request. The Receiving Office has apparently consulted the International Bureau on both these points and had their approval for the action taken.

### **The law**

- 6 The relevant parts of Article 11 PCT read as follows:

*Article 11*

- (1) The receiving office shall accord as the international filing date the date of receipt of the international application, provided that the Office

has found that, at the time of receipt:

...

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

...

(d) a part which on the face of it appears to be a description,

(e) a part which on the face of it appears to be a claim or claims.

### **Counsel's submissions**

- 7 Mr Davis's main task was to build a case on and around a couple of precedent cases that have certain similarities with the present case (as well differences). Firstly, *Fletcher's Application (O/235/98)* where again the international application was filed without claims. The facts there were different to the extent that the UK Receiving Office had initially accorded a filing date, although the description had contained a numbered list of benefits, but no claims. The International Bureau then advised that claims were indeed missing and the upshot was that the application was considered withdrawn. In paragraph 12 of that decision I postulated that the Receiving Office may in certain circumstances have tended to err on the side of benefiting the applicant in deeming claims present. Mr Davis said that there should indeed be a relatively generous interpretation because the penalty of losing twelve months priority, which can follow from loss of a particular filing date, is draconian; and the International Bureau can in any case act as a longstop. My view is, however, that "flexibility" is inappropriate if the check required by Article 11 shows with little doubt the absence of a part which appears to be a claim or claims; and I said so at the end of paragraph 12 of my decision in *Fletcher*.
- 8 The *Penife* case referenced above is perhaps of more significance, not only because the absence of claims was identified by the Receiving Office, but also because we have the benefit of Laddie J.'s view of the case, on application for judicial review of my decision. The *Penife* case differs from the present in that the applicant relied on the presence of a so-called "consistory clause" that was contained within (I used the phrase "embedded within") the description at the filing date contended for, and in view of the fact that such clauses customarily mirror at least the main claim, argued that this clause should be considered to be a claim for the purposes of Article 11 PCT. Laddie J. rejected this argument, confirming that the check made by the Receiving Office is a superficial one, to reveal the presence, or not, of a part which on the face of it appears to be a claims or claims. The functional requirements that Article 6 PCT lays on the claims are not to be invoked in that check. If such a part is not found, it was not required to dig further to find something which would be capable of performing the function of a claim.

9 Mr Davis acknowledged in the main that the check should go to form and not substance, although he did run an alternative argument based on the substance of the abstract that was included. I will come back to that later. But he was able to make some serious points concerning the form of the “numbered list” I mentioned above, that appears on pages 5 and 6. In doing so, he referred to what in my Penife decision I called physical cues for the presence of claims, based on standard drafting practice, which might be used by non-technical staff in looking for claims. I said that such cues may be:

- Claims are distinguishable from the description, usually by being placed after the description and starting on a new sheet
- They have a heading such as Claims
- They are in numbered paragraphs in the manner of a list, each paragraph comprising a single sentence

10 Mr Davis said that the numbered list here displayed several of these cues: most importantly (and in distinction from the situation in Penife):

- The list is distinguishable from the description in that it is at the end, and might be considered therefore to follow the description proper: crucially it is not “embedded” within it (as in Penife). The list does not admittedly start on a new sheet, but that can be remedied.
- There is not a conventional claims heading to the list, but the phrase “Thus the present invention permits” is a heading of sorts that introduces something different, even if not explicitly claims.
- The paragraphs are certainly numbered, and comprise single sentences.

11 At this point Mr Davis was tempted (understandably) into matters of substance by saying that item 1 of the numbered list was a technical feature that might well form the subject of a claim.

12 Mr Davis also took head on another difficult point for him, which was that the check list would seem to show that two pages bearing claims were missing. Mr Davis argued that the check list should be taken to indicate an intention only. I assume this argument implies that the documents as filed might be differently constituted from what is shown in the check list; so if the documents are two pages short according to the check list, that should not be conclusive that claims are not present. I do not think this view squares fully with what Laddie J.said about the Receiving Office looking at the check list (paragraphs 25 and 26 of the reported judgment). Miss Clark (for the Comptroller) had submitted that if it did so,

“... it would be reassured that the claims were contained on two separate sheets. Those sheets were not filed. That is a reason why there is nothing that appears to be the claim.

I accept that submission. The contents of the request form are a factor, not necessarily determinative, which should be taken into account when deciding whether the provisions of Art. 11(3)(i) have been complied with.”

- 13 So the check list is not determinative; and one can imagine situations where there are discrepancies between the list and what is filed that can be reconciled without assuming that pages are missing. But where, as here, the check list indicates six pages of description (and the checker finds a unitary body of text of six pages that looks like a description), and the check list indicates one page of abstract (and the checker finds one page with text headed Abstract), and the only discrepancy is that two pages, additional in number to those found by the checker, intended as claims, are not to be found, then the first and obvious conclusion is that the pages have not been filed, and therefore, that the claims intended to be on them have also not been filed.
- 14 Because of this explanation the checker would not have been put on guard to check the description for something distinguishable as claims. But if, to give the applicant the benefit here, we allow the checker to look into the body of six pages identified by the check list as constituting the description, to find the missing claims, we do not find any indications or cues that are strong enough to disturb the initial view that the claims are missing. Certainly, we find a numbered list that starts halfway down the penultimate page of this body of text, but there are insufficient cues here to identify these as claims. On the contrary, the list is included within the series of pages identified in the check list as description; the list follows on without a page break or other physical division from the preceding text; and (perhaps most importantly) it nowhere mentions the word “claim” or labels the list clearly to a non-technical checker as claims. These factors do not give the checker any justification to suppose that the list should be split off and regarded as a set of claims, in contradiction to what the check list seems to indicate. The list spanning pages 5 and 6 was therefore in my view correctly categorised throughout by the Receiving Office as description, and not claims.
- 15 Mr Davis argued in the alternative that the text labeled Abstract had the correct structure for a claim and should be admitted as such. I cannot accept this because the text on that page is identified as Abstract, and as I said in Penife a body of text cannot be expected to serve two functions when convenient. It is a simple matter of labeling. Such analysis also requires something of an appreciation of the substance of the Abstract, which might be more than the checker should do.
- 16 Mr Davis also raised a human rights point concerning the deprivation of property that possible loss of this international application might involve. I appreciate that the penalty for an oversight in omitting claims is severe under the provisions of the PCT, but I and the UK Patent Office are bound in this matter by the clear terms of the PCT, which is an international obligation. I also have some doubts that the failure to launch an application in the first place should be regarded as a deprivation of property under Article 1 to the First Protocol to the European Convention on Human Rights.

## **Conclusions**

17 I therefore decide that this purported international application did not contain a part which on the face of it appeared to be a claim or claims when filed on 3 February 2006. It cannot therefore be accorded that date as a filing date under the PCT.

**H J Edwards**

Deputy Director acting for the Comptroller