

14th January 2008

PATENTS ACT 1977

APPLICANT Investigen, Inc.

ISSUE Whether requests to make late declarations of priority on patent applications GB 0608059.2 and GB 0608060.0 should be allowed

HEARING OFFICER B Micklewright

DECISION

Introduction

- 1 UK Patent application GB 0608060.0 (“the GB application”) was filed on 24 April 2006 in the name of Investigen, Inc. and claimed priority from a US application, US 60/655,929 filed on 23 February 2005. The GB application was filed outside the normal twelve month period for claiming priority from this US application. A Form 3/77 was filed with the GB application making a request to the comptroller for permission to make a late declaration of priority under section 5(2B) of the Patents Act 1977 in respect of the US application. Attached to this form was a statement indicating that the applicant initially filed a PCT application with a provisional filing date of 24 February 2006. The US attorney filing the PCT application arrived at the main Chicago Post Office with the documents on 23 February, shortly before midnight. But by the time that the automated express mail dating service applied the receipt date stamp, midnight had passed and the receipt date stamp indicated a date of 24 February 2006. The applicant subsequently filed the GB application.
- 2 The PCT application filed at the Chicago Post Office was given a provisional filing date of 24 February 2006, was allocated application number PCT/US2006/006455, and proceeded along the PCT route. The applicant then filed forms NP1, 9A/77, 10/77 and 3/77 for this application at the UK Intellectual Property Office on 24 April 2006, the same date as that on which the GB application was filed. The PCT application was assigned a GB application number GB 0608059.2 (“the PCT application”) but, as will become apparent, the Office did not accept that the application had entered the national phase on this date. On the Form 3/77 a request was made to make a late declaration of priority

under section 5(2B) of the Patents Act 1977 (“the Act”) with regard to the same US application as that for the GB application. Attached to the form was a statement analogous to that filed in relation to the GB application.

- 3 The Office wrote to the applicant on 31 July 2006 stating that the PCT application had not entered the national phase and thus that any priority claims made under the PCT were subject to the requirements of the PCT and not the UK Patents Act. The applicant replied in a letter dated 29 September 2006 opposing this view. It was argued in this letter that a request to make a late declaration of priority under section 5(2B) of the Patents Act could be made on a PCT application whether or not it had entered the national phase. The applicant further or in the alternative submitted that all necessary steps were taken to begin national processing of the PCT application on 24 April 2006, that the national phase had therefore begun, and that the Office should proceed to make a determination under section 5(2B). A hearing was requested if the Office was not prepared to proceed with a consideration of the request under section 5(2B). The Office maintained its position in a letter dated 10 November 2006.
- 4 The Office also wrote to the applicant on 31 July 2006 in relation to the GB application refusing the request to make a late declaration of priority on the grounds that there was no intention to file the application in suit (a national application) until the twelve month period for claiming priority had lapsed. The applicant, in a letter dated 29 September 2006, disputed the refusal and requesting a hearing if the request could not be complied with. The Office maintained its position in a letter dated 16 November 2006.
- 5 The matters in relation to both the GB application and the PCT application therefore came before me at a hearing on 2 February 2007, at which the applicant was represented by Mr. Richard Meade of Counsel who was assisted by Mr. Huw Hallybone and Ms. Patricia Harris of the firm Carpmaels & Ransford. Mrs. Christine Farrington attended on behalf of the Office.
- 6 Following the hearing the High Court issued a judgment in the matter of *Abaco Machines (Australasia) Pty Ltd's Application* [2007] EWHC 347 (Pat) on 28 February 2007. This judgment was clearly relevant to the present case and I therefore gave Investigen an opportunity to make submissions in relation to *Abaco*. Submissions were received on 23 April 2007.
- 7 This decision relates to both the GB application and the PCT application.

The Law

The law in relation to late declarations of priority

- 8 Section 5 of the Patents Act 1977 was amended by the Regulatory Reform (Patents) Order 2004 (“the 2004 Order”) which came into force on 1 January 2005. In particular this Order implemented Article 13 and Rule 14 of the Patent Law Treaty (PLT) which allows restoration of priority rights in certain circumstances. One such circumstance is where the filing of an application is delayed for some reason and falls after the priority period (twelve months after the filing of an earlier application) has expired. Article 13(2)(iv) of the Patent Law

Treaty states:

(2) [*Delayed Filing of the Subsequent Application*] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority if:

...

(iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

Thus a PLT Contracting Party has the choice, when implementing the requirements of the PLT into its national law, of using either a “due care” test or an “unintentional” test when considering whether to restore the right of priority for an application. The UK chose the “unintentional” test and the relevant parts of section 5 of the Act which relate to making a late declaration of priority are:

5.-(2B) The applicant may make a request to the comptroller for permission to make a late declaration under subsection (2) above.

(2C) The comptroller shall grant a request made under subsection (2B) above if, and only if -

(a) the request complies with the relevant requirements of rules; and

(b) the comptroller is satisfied that the applicant’s failure to file the application in suit within the period allowed under subsection (2A)(a) above was unintentional.

- 9 The Patents Rules 2007, SI No. 3291 (“the 2007 Rules”) entered into force on 17 December 2007. These Rules replace the Patents Rules 1995 (“the 1995 Rules”). The relevant rules in force at the time of this hearing and at the time of all actions which took place in relation to the GB application and the PCT application prior to the hearing were however the 1995 Rules. All references to rules in this decision are therefore references to those rules as set out in the 1995 Rules. These rules do however have equivalents in the 2007 Rules and I note that the practical operation of these equivalents are the same in effect as the respective rules in the 1995 Rules. Rule 6A of the 1995 Rules as amended sets out a prescribed period of two months following the normal twelve month priority period for making a request under section 5(2B) as well as other details regarding how to make a late declaration.

Relevant law in relation to international applications

- 10 UK law in relation to international applications is governed by sections 89, 89A and 89B of the Patents Act 1977. Section 89(1) states:

89.-(1) An international application for a patent (UK) for which a date of filing has been accorded under the Patent Co-operation 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.

11 The relevant parts of section 89A state:

89A.-(1) The provisions of the Patent Co-operation Treaty relating to publication, search, examination and amendment, and not those of this Act, apply to an international application for a patent (UK) during the international phase of the application.

(2) The international phase of the application means the period from the filing of the application in accordance with the Treaty until the national phase of the application begins.

(3) The national phase of the application begins -

(a) when the prescribed period expires, provided any necessary translation of the application into English has been filed at the Patent Office and the prescribed fee has been paid by the applicant; or

(b) on the applicant expressly requesting the comptroller to proceed earlier with the national phase of the application, filing at the Patent Office -

(i) a copy of the application, if none has yet been sent to the Patent Office in accordance with the Treaty, and

(ii) any necessary translation of the application into English,

and paying the prescribed fee.

For this purpose a “copy of the application” includes a copy published in accordance with the Treaty in a language other than that in which it was originally filed.

12 Finally, section 89B(1) states:

89B.-(1) Where an international application for a patent (UK) is accorded a filing date under the Patent Co -operation Treaty -

(a) that date, or if the application is re-dated under the Treaty to a later date that later date, shall be treated as the date of filing the application under this Act,

(b) any declaration of priority made under the Treaty shall be treated

as made under section 5(2) above, and where in accordance with the Treaty any extra days are allowed, the period of 12 months allowed under section 5(2A)(a) above shall be treated as altered accordingly, and

(c) any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 13(2) above.

Applicant's arguments

The GB application

- 13 Mr. Meade argued that the “unintentional” test of section 5(2C) of the Act did not require the Office to consider blame or whether a particular standard of care was or was not reached. No “due care” test was implied in the term “failure”, merely that the thing wasn’t done. The term “intentional” was the opposite and antecedent of “unintentional”. He therefore submitted that the question I had to answer was whether it was intentional or unintentional not to file a GB application.
- 14 Investigen’s positive intention was, Mr. Meade said, to achieve patent protection for their invention in various territories which included the United Kingdom, and the way they would generally go about doing so would be by way of a PCT application. Mr. Meade commented that Investigen did not positively and actively turn its mind to the question of whether or not to file a national GB application before the expiry of the priority period. Investigen clearly did not have an intention not to file a GB application and thus had satisfied the requirements of section 5(2C) for the GB application in suit.
- 15 Mr. Meade then turned to the decision of the hearing officer in *Sirna Therapeutics Inc’s Application* [2006] RPC 12. His primary submission in relation to *Sirna* was that it was a decision on its own facts and thus was neither here nor there for the purposes of the decision I have to make in relation to the application in suit. Mr. Meade also commented that the arguments put to the hearing officer in that case were different to those being made in the present case. The argument in *Sirna*, Mr. Meade submitted, was based on whether or not section 5(2C) required a mistake and what categories of mistake it applied to, contentions unrelated to the statutory language.
- 16 Mr. Meade also submitted that, if *Sirna* was interpreted as imposing a strict and unvarying requirement that there must have been a positive intention to file the application in suit during the twelve month period, and that the intention was not put into practice for reasons which were not intentional, then *Sirna* was wrongly decided. There is simply nothing in section 5(2C), Mr. Meade argued, that speaks to the intention of the applicant during the twelve month period. It simply speaks to the applicant’s failure to file the application in suit.

The PCT application

- 17 Mr. Meade then turned to the PCT application. Focusing initially on section 5 of the Act, which deals with priority, Mr. Meade submitted that importance should be

attached to the words “if, and only if” in section 5(2C). These words, he argued, told the reader that the conditions which followed were the only conditions relevant to granting a request to make a late declaration of priority under section 5(2B).

- 18 Turning then to section 89, Mr. Meade submitted that, by virtue of section 89(1), the general approach of the Act is that PCT applications which have a filing date are to be treated as applications for patents under the Act. Exceptions to this general approach are then set out in sections 89A and 89B but, following a basic principle of statutory construction, should not be construed broadly so as to detract from the general approach. Rather they should be construed strictly. Thus if Investigen’s request to make a late priority claim was not within one of the exceptions listed in these sections, it falls to be determined under the general provisions of the Act relating to applications, which includes section 5(2C). Mr. Meade disagreed with the view expressed by the Office in its official letters that the expression “relating to publication, search, examination and amendment” in section 89A should be interpreted broadly. If Parliament had intended a broader interpretation then they would have made this clear in the statutory language, for example by referring to chapters I to III of the PCT in their entirety. Each provision of chapters I to III of the PCT has a title and many have “publication”, “search” and so forth in the title. Thus, Mr. Meade argued, it is these provisions to which section 89A(1) relates. The provisions relating to priority do not fall into this category.
- 19 I had drawn *Kenrick (Archibald) & Sons Ltd.’s International Application* [1994] RPC 635 to the applicant’s attention prior to the hearing. In this case an international application was filed with the UK Office acting as receiving Office under the PCT but the application was damaged in the post which caused it to arrive just too late. The applicant attempted to cure the problem both under the provisions of the Patents Act and under the PCT. Aldous J (as he then was) decided that the provisions of national law were completely irrelevant. Mr. Meade agreed with this finding but distinguished it from the present case, arguing that in this case the PCT application was to be treated as a national application for the purposes of section 5(2C). Thus it is national law and not the PCT which applies. Mr. Meade submitted that the contrary view, that section 5(2C) only applies to national applications, is wrong for two reasons. Firstly there is no such limitation in the words of the Act. Secondly, the provision stems from the Patent Law Treaty (PLT) which is an international treaty, and it would be illogical to treat an obligation on the United Kingdom under an international treaty as applying only to national applications. Thus an applicant can seek a late declaration of priority when the application is in the international phase because it is treated under the Act as a national application, provided that it has been allocated a filing date, which had happened in this case. Mr. Meade commented that it would be undesirable to force people to leave the international phase simply in order to make a late declaration of priority.
- 20 Mr. Meade then turned to his further or alternative submission that the PCT application entered the national phase on 24 April 2006. Section 89A(3)(b) sets out several requirements for early entry to the national phase. Firstly, the applicant must expressly request the comptroller to proceed earlier with the

national phase of the application. Secondly, a copy of the application must be filed at the Office if none has yet been sent to the Office in accordance with the Treaty, as was the case for the present application. There is a third requirement regarding translations but this is not relevant to the present application which was originally filed in English.

21 Form NP1 is commonly used by applicants for national phase entry in the UK, although it is not mandatory to use this form. This form asks the applicant if they wish to enter the national phase early. Investigen used this form but answered “No” to this question. Mr. Meade argued that the Form NP1 and the documents filed with it are business documents and should be construed as commercial documents following two House of Lords judgments, *Mannai Investment v Eagle Star* [1997] AC 749 and *ICS v West Bromwich* [1998] 1 WLR 896. The *Mannai* case related to the terms of a lease, in particular the notice period which had to be given to terminate the lease. The date of 12 January was specified by the tenant as the date of termination but this resulted in the notice period being a day shorter than that required by the terms of the lease. Lord Hoffman found that, even though the wrong words were used, the correct interpretation was that the tenant had specified 13 January as the date of termination, despite actually writing down 12 January. Mr. Meade commented that what the House of Lords was doing here was interpreting the whole of what had been said in context. He referred me to the following paragraph from the judgment:

“But apart from these exceptions, commercial contracts are construed in the light of all the background which could reasonably have been expected to have been available to the parties in order to ascertain what would objectively have been understood to have been their intention. The fact that the words are capable of a literal application is no obstacle to evidence which demonstrates what a reasonable person with knowledge of the background would have understood the parties to mean, even if this compels one to say that they used the wrong words. In this area, we no longer confuse the meaning of words with the question of what meaning the use of the words was intended to convey. Why, therefore, should the rules for the construction of notices be different from those for the construction of contracts?”

22 Mr. Meade then turned to the application in suit and commented that the applicant’s objective was to make a late claim to priority and the GB application and the PCT application, which were cross-referred, were filed with this objective in mind. The Form NP1, the form commonly used for entering the national phase, however provided a hindrance to the applicant communicating effectively their desire in relation to entering the national phase. Mr. Meade said that the applicant wanted to enter the national phase sufficiently to make the late claim to priority but did not want examination and search substantively to start immediately, as this would be a waste of time until the priority issue had been decided. Thus, Mr. Meade submitted, the “Yes/No” option in Form NP1 was not adequate in this case in indicating the applicant’s wishes.

23 Mr. Meade submitted that it would be a nonsense to read the “No” entered in item 7(a) of Form NP1 in this case as meaning “No, I don’t want to enter the national

phase at all, even though this means I can't make a late claim to priority, which is the whole object of the exercise". The "No" has to be interpreted consistently with the applicant's express, overriding and clearly stated desire to make a late claim to priority. Instead, Mr. Meade submitted, it is compelling to read "No" as meaning "No, I don't want the immediate consequences of the national phase, but I do want to do what is necessary to make a late claim to priority". Mr. Meade argued that "No means No" is inconsistent with the House of Lords decision in *Mannai* and is parallel to the landlord in *Mannai* saying "Well, 13 means 13 and it doesn't mean 12". Rather the meaning of the words has to yield to the overall intention. Mr. Meade argued that this is an unusual case where the form is not quite apt, and where the applicant made an honest effort to do the best he could. But the overall objective was absolutely clear.

- 24 In relation to the *Investors Compensation* case, Mr. Meade argued that "No" may not mean "No, no and no" but can mean "no" in this respect and "yes" in that respect in order to get a sensible result. Mr. Meade therefore concluded that, when the document is construed properly, the applicant properly and sufficiently requested early entry to the national phase.
- 25 Mr. Meade then turned to the question of whether a copy of the PCT application was filed at the Office as is required by section 89A(3)(b)(i) for early entry to the national phase. The same specification as that of the PCT application was filed with the GB application and the letters accompanying each filing cross-referred to each other. Moreover the applicant had written to the Office before the hearing indicating that the two applications were sent to the Office in the same envelope and without any papers relating to other cases. This, Mr. Meade submitted, was enough to satisfy the requirements of the Act. He went on to make a number of points in support of that submission. Firstly, there was no conceivable public prejudice attached to the failure to include the specification of the PCT application with the request for national processing. Secondly, there was no uncertainty as to what the right specification was as the PCT application number had been provided. Thirdly, there was no administrative convenience in the Office arising from the failure as it had not started any substantive processing and a copy of the specification was sent to the Office in September 2006. Finally, it is clear that the Office realised what was happening due to the cross-referring letters.
- 26 Mr. Meade pointed out that it was common ground that, at the time of the hearing, the PCT application was in the national phase. He submitted that if the Office allowed a late priority claim on or after that time, it would be doing so at a time when the PCT application was in the national phase and thus had power to allow a late declaration at that time.
- 27 Mr. Meade finally commented that in any case the use of the word "No" at item 7(a) of the Form NP1 and the failure to file the specification in the same clip of documents as the NP1 are curable using the range of powers statute provides to the Office to correct irregularities and extend time limits. The Office had expressed the view that the use of the word "No" in Form NP1 could not be corrected under section 117 as only clear mistakes can be corrected under this provision. Mr. Meade argued that it was clear what the meaning of the document was. To the extent that there was an irregularity it was clear that the word "no" was not literally the appropriate word to use. But the overall meaning was clear

and thus, Mr. Meade submitted, there is no obstacle to regularising the position under section 117, rule 47 or rule 100.

The Abaco judgment

- 28 After the hearing the judgment of Mr Justice Lewison in the matter of *Abaco Machines (Australasia) Pty Ltd's application* [2007] EWHC 347 (Pat) was issued on 28 February 2007. This related to an appeal from a decision by the comptroller refusing a request to make a late declaration of priority under section 5(2B). The facts were similar to those of *Sirna* and to the GB application of the present case. Abaco had intended to file a PCT application claiming priority from an earlier application. Having unintentionally failed to do so within the twelve month period, Abaco filed a GB application and made a request under section 5(2B). Lewison J agreed with the reasoning of the hearing officer and dismissed the appeal
- 29 I provided an opportunity for Investigen to make submissions on the relevance of *Abaco* to the issues under consideration on both the GB application and the PCT application. In relation to the GB application the applicant commented that the arguments presented in *Abaco* are somewhat different than those presented to me in the present case and require separate analysis (and may perhaps result in a different conclusion).
- 30 After some clarification Investigen also commented on the relevance of *Abaco* to the PCT application. They commented that *Abaco* is nothing to do with the applicability of section 5 of the Act to PCT applications (whether in the international or the national phase). It is therefore wrong in principle to apply its reasoning to that situation. It is also wrong to take a collection of statements of principle from different parts of that judgment made in the context of that case and fuse them into a general principle applicable in a quite different context. As an example Investigen referred to the judge's comments that the PCT is a "complete code" and has a "rigid timetable" and argued that although this may make sense in the context of the judgment it is not a helpful generalisation which can be applied to the present case. Investigen also highlighted that they were not asking the UK Intellectual Property Office to interfere with the application of the PCT itself to Investigen's case, for example by requesting a rectification of the PCT filing date. Rather the Office can and should act under the 1977 Act to allow a late declaration of priority. Investigen did not dispute that the Patent Law Treaty (PLT) is part of the relevant background against which section 5 should be viewed but this goes neither one way nor the other in relation to the key question of Investigen's application. In any case this aspect of the judge's reasoning was in relation to whether *Abaco* unintentionally failed to file a national application, a key point in that case but not relevant to the PCT application in the present case.
- 31 Investigen argued that there is nothing in *Abaco* to undermine Investigen's argument that if the Office did not have power to allow a late declaration of priority at the initial time of request because the application was in the international phase, it obtained such power once the application entered the national phase. It was common ground that the application entered the national phase no later than 29 September 2006.

The Office's view

The GB application

- 32 In relation to the GB application the Office followed *Sirna* and took the view that the request to make a late declaration of priority could not be allowed because the failure to file the “application in suit” (ie the GB application) was not unintentional. No intention existed to file a GB application before the end of the 12 month period allowed under section 5(2A)(a). Rather the intention was to file a PCT application.

The PCT application

- 33 It is accepted by both Investigen and the Office that by the date of the hearing the PCT application had entered the national phase. Thus this application entered the national phase before amendments to the 1995 Rules came into force on 1 April 2007 (these amendments were made by the Patents (Amendment) Rules 2007, SI No. 667). These amendments allow applicants a limited period for requesting permission to make a late declaration of priority following entry to the national phase. This option was not therefore available to Investigen and the Office's view reflected this. The Office's view in relation to the PCT application was that once it entered the national phase the provisions of the Act applied in the same way as to a domestic application. If an international application entered the national phase early, before 14 months had elapsed from the earliest date, a request to make a late declaration of priority could be made. Such a request could not however be made when the international application was still in the international phase. The Office argued that section 89A(1) should be interpreted broadly such that it referred to the entirety of chapters I to III of the PCT, including those related to priority dates. The alternative of having two parallel legal regimes is unattractive because the applicant would have different rights and be treated differently under each one, and much uncertainty could be caused for interested third parties. The Office suggested that only where there is no equivalent provision under the PCT might national law apply during the international phase.
- 34 The Office also took the view that as no valid declaration of priority had been made under the Treaty, there was no declaration to treat as having been made under section 5(2) by virtue of section 89B(1)(b). Moreover the existence of provisions in section 89 relating to acts done under the Treaty being treated as done under the Act suggests they should not automatically be considered as to have been done under the Act.
- 35 In relation to national phase entry, the Office agreed that the PCT application was in the national phase by the time of the hearing but that it did not enter the national phase until after the expiry of the 14 month period for making a late declaration of priority. There was no express request to enter the national phase within that period, and nor was a copy of the PCT application filed.

Assessment

The GB application

- 36 I will first decide whether to allow the request to make a late declaration of priority on the GB application. In reaching this decision I am bound by the judgment in *Abaco*. The relevant facts in the present case are identical to those of *Abaco*, namely that the applicant intended to file a PCT application within the twelve month priority period. They unintentionally failed to do so and subsequently filed a national GB application. But they never intended to file the GB application within the twelve month period. Thus, following *Abaco*, the failure to file the application in suit within the twelve month period was not unintentional and I therefore refuse the request to make a late declaration of priority.
- 37 Although I do not need to go into detail as to the extent that the arguments put forward in *Abaco* are the same or different to those put forward by Investigen in the present case, as I have discussed above, the relevant facts are the same and the relevant law is the same. Thus, as I am bound by *Abaco*, the decision must be the same.

The PCT application

- 38 I need to address the following points in relation to the PCT application:
1. Can a request to make a late declaration of priority under section 5(2B) of the Act be made on a PCT application which is in the international phase?
 2. If the answer to the above question is no, did the PCT application enter the national phase in sufficient time to make a late declaration of priority? In particular:
 - 2a. was a copy of the application filed at the Office, and
 - 2b. did Investigen expressly request the comptroller to proceed earlier (than the usual 31 months) with the national phase of the application,both of which are requirements of section 89A(3) for early entry to the national phase, within the fourteen month period from the filing of the US priority application?
 3. If the answers to both the above questions are no, can the request to make a late declaration of priority be allowed once the PCT application enters the national phase, even if the request was made when it was still in the international phase?

If the answer to any of these questions is yes the request can be allowed as it is common ground that the failure to file the PCT application was unintentional and that, if the PCT application had entered the national phase within 14 months, the request would be allowed.

1. *Can a request to make a late declaration of priority be made on a PCT application which is in the international phase?*

- 39 To answer this question it is useful to consider the purpose and nature of the PCT. The PCT provides a route for obtaining patent protection in multiple countries through the filing of a single international application. The PCT has its own rules and procedures which must be followed by an applicant choosing to use this route which are set out in the Treaty itself and in the accompanying Regulations and Administrative Instructions. An international search report is produced and the international application is published. The application at some point enters the national phase (or regional phase in the case of, for example, the EPO) where the application is subject to national processing in accordance with the relevant provisions of the national law of the country concerned. In the UK, PCT applications normally enter the national phase at 31 months but they can enter the national phase earlier should the applicant so expressly request and providing various requirements are satisfied. Until the application enters the national phase it is in the international phase.
- 40 Alternatively an applicant can file a GB application at the UK Intellectual Property Office. Such an application is subject to the rules and procedures of the Patents Act 1977 and the Patents Rules 1995 (which have now been replaced by the Patents Rules 2007).
- 41 A person seeking patent protection in the UK has therefore several filing routes to choose from. They may choose to file a national patent application, a European patent application at the EPO, or a PCT patent application. Each route has its own rules and procedures associated with it. Those of the PCT are governed by the PCT itself and the associated Regulations and Administrative Instructions.
- 42 Sections 89, 89A and 89B of the Patents Act 1977 relate to international applications. The question as to the extent that these sections imply that various sections of the Act apply directly to PCT applications is a difficult one. Section 89(1) states that an international application for a patent (UK) is treated as an application for a patent under the 1977 Act for the purposes of Parts I and III of the Act. But this is subject to the provisions of sections 89A and 89B. Section 89A(1) states that the provisions of the PCT relating to publication, search, examination and amendment, and not those of the Act, apply to a PCT application during its international phase. Provisions relating to making a priority claim are not explicitly included in this list. Section 89B(1)(b) states that any declaration of priority made under the Treaty shall be treated as made under section 5(2) of the Act. Thus a PCT applicant can safely make a declaration of priority under the PCT and that will be treated as made under the Act. Sections 89A and 89B are however silent on whether a PCT applicant also has the option of making a priority claim directly under section 5(2) when the application is in the international phase.
- 43 I therefore have to decide whether, on balance, the absence of such a specific provision indicates that a declaration of priority for a PCT application in the international phase can or cannot be made directly under section 5(2). My initial view is that to allow declarations of priority to be made directly under section 5(2) introduces considerable complexity to the PCT system and its interaction with the

national UK system. I do not believe that the provisions of sections 89, 89A and 89B were intended to allow applicants to pick and choose their preferred provisions from the 1977 Act and the PCT. This could cause chaos and confusion. In my view the purpose and effect of sections 89, 89A and 89B is rather to ensure that international applications which comply with various provisions of the PCT are treated as having complied with the equivalent provisions of the UK Patents Act. This will ensure that there are no flaws in a PCT application once it enters the national phase. For example a priority claim under the PCT is treated as a priority claim under the Act, publication and search under the PCT are treated as publication and search under the Act, and so on. This is not the same as saying that all the provisions of the Act apply to PCT applications in the international phase as they do to national applications. My initial view is therefore that if Parliament had intended to allow an applicant this additional option of making a priority claim on an international application directly under section 5(2B) they would have provided an explicit provision rather than allowing a general approach of picking and choosing between provisions of the PCT and those of the 1977 Act.

44 I will now turn to relevant case law in this area to determine if my initial view is consistent with the interpretation of the relevant provisions of the Act by the Courts. This question has been addressed to some extent in two judgments. The first of these was in *Kenrick (Archibald) & Sons Ltd.'s International Application* [1994] RPC 635. This involved a request to accord as the filing date of an international application a date earlier than the date the application was actually received at the Patent Office (as it then was) under rule 97 of the Patents Rules 1990. The Royal Mail accepted responsibility for a delay in the post. Aldous J (as he then was) agreed with the hearing officer that rule 97 could not be used for this purpose for an international application and said:

“Rule 97 does not apply to applications for priority filed under the PCT. 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. It is not open to the receiving Office in one State to deem an international application to have been received on one day and another receiving Office in another State to apply a different rule. An essential aim of the PCT is to bring about uniformity.”

45 I accept Investigen’s submissions that their case is different to that of *Kenrick*. Investigen is not asking the Office to carry out an action that will affect the PCT application in all States. It is making a request to the Office in its capacity as designated Office rather than receiving Office. Investigen’s request to make a late declaration of priority is restricted to the GB designation of the international application and, if allowed, would only apply in the UK. Aldous J’s comment that the PCT is a complete code is a useful observation but I must be careful of stretching it beyond the context in which it was made. Lewison J did however make some further comments on this matter in *Abaco Machines (Australasia) Pty Ltd’s application* [2007] EWHC 347 (Pat) where he said:

“19. The PCT is a complete code: *Archibald Kenrick & Sons Ltd’s International Application* [1994] RPC 635. It follows that a PCT application cannot be an application under the 1977 Act except to the extent that the Act says it is. The circumstances in which a PCT application can be treated as an application for a patent under the 1977 Act are dealt with in sections 89, 89A and 89B of the Act.

...

25. In my judgment Mr Mitcheson’s submission, if accepted, would amount to a major breach in the complete code of the PCT. The PCT undoubtedly has advantages to those who make international applications under it. As Mr Mitcheson said, these advantages include savings in cost and flexibility given to applicants to decide whether to enter the national phase in all or only some of the territories designated in the international phase. But the PCT is a package. Part of the package is, for the moment, a rigid timetable. As Mr Birss submitted, having chosen to use the PCT route, Abaco must take the PCT system as they find it.”

46 Again, as Investigen pointed out, the facts of this case are somewhat different and much turned on the fact that in the case of Abaco no PCT application had actually been filed and therefore had not been accorded a date of filing. This was a necessary precondition to the treatment of a PCT application (once it had entered the national phase) as an application under the 1977 Act. I have to be careful to read the above statements in context and not to extrapolate them to the present context unless it is clearly appropriate to do so. Nevertheless I believe that there is a general principle which arises out of these two judgments. This general principle is that the PCT is a complete code and should be taken as such. This principle has been applied in two separate situations in the two judgments. Lewison J expands on it in paragraph 25 of *Abaco*. He states that the PCT is a package and the applicant must take it as they find it, including a rigid timetable.

47 Lewison J did say explicitly in paragraph 24 of *Abaco* (my emphasis):

“The date of filing that is actually given to a PCT application is important for a number of reasons. First, it is part of the definition of the kind of PCT application that can be treated as an application under the 1977 Act. Second, it is a fixed and ascertainable point from which the international phase is measured. Third, it is only where the PCT application has been given a filing date that section 89B(1)(b) allows a declaration of priority to be treated as a declaration of priority under the 1977 Act. **Moreover, the declaration of priority in the PCT application must be a declaration under the PCT itself**; and it is common ground that such a declaration must be made, if at all, within the twelve month period which (at the moment) is incapable of extension under the PCT. All this is, in my judgment, inconsistent with Mr Mitcheson’s attempt to extend the statutory preconditions to a deemed or hypothetical PCT application at some undefined date within the priority period.”

48 It is not entirely clear whether the judge intended the comment in bold as a more general principle in relation to priority claims for PCT applications or as

something only relevant in the direct context in which it was made. I note however that, if taken as a more general principle, it is consistent with the judge's other comments that the PCT is a complete code, must be taken as a complete package, and has a rigid timetable.

49 The implications of the general principle I have identified above to the present case are that PCT applicants, once they have elected to use the PCT route, must take it as they find it as a complete package including the rigid timetable it sets out. In my view these comments rule out the possibility of flexing the rigid timetable or opting out of certain elements of the package by making use of priority provisions in the 1977 Act rather than those of the PCT if an application is still in the international phase. I therefore conclude that the case law confirms my initial view that sections 89, 89A and 89B of the Act do not provide a means for PCT applicants to make a declaration of priority directly under section 5(2) when their PCT application is in the international phase. Rather the provisions of the PCT in relation to making a declaration of priority apply. It follows therefore that Investigen cannot make a request to make a late declaration of priority under section 5(2B) when their PCT application is still in the international phase. Moreover the PCT did not allow late declarations of priority (or, in PCT language, restoration of the right of priority) at the time Investigen filed their PCT application. Thus Investigen must demonstrate that their application entered the national phase before the period for making a request to make a late declaration of priority under section 5(2B) expired, or that such a request could be allowed once the PCT application entered the national phase at a later date.

2. *Did the PCT application enter the national phase in sufficient time to make a late declaration of priority?*

50 The Office has accepted that the provisions of section 5(2B) can be applied to a PCT application once it enters the national phase, providing it does so in sufficient time to satisfy the requirements of rule 6A, that is, within 14 months of the declared priority date. Investigen submit that the PCT application did enter the national phase within the fourteen month time limit. There are two issues I have to decide in relation to this matter. Firstly, within that 14 month period, did Investigen expressly request to the comptroller to proceed earlier with the national phase as is required by section 89A(3)(b), and secondly, was a copy of the international application sent to the Office within that period as is required by section 89A(3)(b)(i)?

2a. *Was a copy of the application filed at the Office?*

51 No copy of the international application was filed at the Office by Investigen on 24 April 2006, the date that Investigen filed a number of other forms at the Office in relation to this international application. These forms included Form NP1, a non-statutory form provided by the Office for requesting national phase entry. The covering letter did however include the following sentence:

“Please cross-refer to the application for a UK patent, as filed today, which relates to the same invention and with which we have also field (*sic*) a Form 3/77.”

52 It is a very clear requirement of section 89A(3)(b) that a copy of the international application must be filed at the Patent Office in order to enter the national phase early, if no copy of the application has yet been sent in accordance with the Treaty. The national application filed by Investigen at the Office is an independent application to that of the PCT application. Even if the sentence quoted above cross-referring to the GB application could be read as requesting that the GB application also be considered as the PCT application for the purposes of section 89A(3)(b), which in my view it does not, this would not be sufficient to meet the requirements of that section. Investigen were required to file an actual copy of the international application before their application could enter the national phase. They did not do this on 24 April 2006, the date on which the Form NP1 was filed, and therefore the PCT application did not enter the national phase on that date, which was the last day of the fourteen month period from the date the US priority application was filed.

2b. Did Investigen expressly request the comptroller to proceed earlier with the national phase of the application?

53 As I have found that no copy of the PCT application was filed, I do not formally need to consider whether Investigen expressly requested early entry to the national phase, but for completeness I will do so. As I mentioned above, the Office provides non-statutory Form NP1 for requesting national phase entry. In practice most applicants use this form to enter the national phase in the UK. This two-page form includes at the bottom of the first page the following question:

- “7. a) Do you wish to enter the national phase early (ie before 31 months from the priority date)? (*Answer “Yes” if this applies*)
- b) If so, has the demand been filed and on what date?”

Investigen made use of this form for their PCT application and in response to question 7 a) wrote “NO” on the form. A number of other forms were filed with the Form NP1. These were a Form 9A/77 requesting search, a Form 10/77 requesting substantive examination, and a Form 3/77 making a request under Rule 6A(2) to make a late declaration of priority.

54 I accept Mr. Meade’s submission that I must interpret the whole of the Form NP1 in context, in accordance with the *Mannai* and *Investors Compensation* cases. The purpose of the Form NP1, titled “National processing of an international application for a patent (UK)”, is to request entry into the UK national phase for a PCT application. Forms 9A/77 and 10/77 need not be filed at the same time but it is common to do so. It is apparent that Investigen filed these forms with a view to entering the national phase. The issue I have to consider is whether, taken in context, the filing of the Form NP1 and associated documentation constituted or included an express request to enter the national phase early, despite the fact that Investigen had written “NO” in response to question 7a) on the form.

55 The Form NP1 was clearly filed much earlier than is usually the case for normal national phase entry at 31 months, although it is not uncommon for the form to be filed some time in advance of the 31-month deadline. However I also have to take into account the fact that no copy of the international application was filed at that

time, and that in no place did Investigen explicitly state that they wanted to enter the national phase early. Note that section 89A(3)(b) requires the request to be express, which in my view means that the request must be explicit, not merely implied. Mr. Meade suggested that “NO” could be read as “No, I don’t want the immediate consequences of the national phase, but I do want to do what is necessary to make a late claim to priority”. I accept that Investigen had a clearly stated desire to make a late declaration of priority, demonstrated by the filing of the Form 3/77, but it does not follow from this that they expressly requested early entry to the national phase. Even if I was to read “NO” in the manner suggested by Mr. Meade, which I do not believe I can, it would still not constitute an express request to enter the national phase early. Taken in context as is required by *Mannai* and *West Bromwich* and taking into account the applicant’s answer “NO” to question 7a) of the Form NP1 along with the other forms and documents filed with the Form NP1 I can find no express request to enter the national phase early. Moreover I do not believe that this is what a reasonable person with knowledge of the background would have understood Investigen to mean. The only factor which could point to such an express request being present is the filing of the Form 3/77 with the Form NP1 but this factor alone is not sufficient to outweigh the other significant factors such as the failure to file a copy of the PCT application and the answer “NO” to question 7a). Investigen’s primary submission that they do not need to enter the national phase in order to be able to make a request under section 5(2B) adds even further weight to my finding that the filing of the Form 3/77 is not sufficient to demonstrate that the applicant made an express request to enter the national phase early. I therefore conclude that Investigen did not, on 24 April 2006, expressly request the comptroller to proceed earlier with the national phase of the PCT application, as is required by section 89A(3)(b).

3. *Can the request to make a late declaration of priority be allowed once the PCT application enters the national phase, even if the request was made when it was still in the international phase?*

56 Mr. Meade also submitted that even if the application did not enter the national phase on 24 April 2006, it is not disputed that the application was in the national phase by 29 September 2006, and the Office was therefore able to accede to the request on that date. I do not accept this submission. For the Office to accede to a request to make a late declaration of priority, the request must have been made under section 5(2B) within the prescribed period. I have found that the application was not in the national phase on 24 April 2006 and also that section 5(2B) does not apply to PCT applications in the international phase. It follows that no request could actually have been made under section 5(2B) within the prescribed period for the present application. The request could not be deemed to be made until the date the PCT application entered the national phase, which I have found was after the period prescribed by rule 6A for making such a request.

Correcting Form NP1

57 Investigen also argued that the defects which resulted in a failure to enter the national phase on 24 April 2006 were in any case curable using the range of powers provided by the statute to the Office to correct irregularities and extend time limits. Mr. Meade referred in particular to section 117 (corrections), rule 47

(requesting correction of an error) and rule 100 (correction of irregularities). I have found that the PCT application failed to enter the national phase on 24 April 2006 for two reasons: firstly because no copy of the international application was filed with the Office on that date and secondly because the applicant made no express request to enter the national phase early on that date. Both of these will need to be rectified in order for the PCT application to have been deemed to have entered the national phase on that date. I note that rule 6A(1) which specifies the period in which a request to make a late declaration of priority may be made is listed in Part 1 of Schedule 4A of the Rules which, by virtue of rule 110(1), cannot be altered under rule 110.

- 58 I will first address whether the failure to file a copy of the PCT application on 24 April 2006 is correctable. It is well established that section 117 of the Act is concerned solely with correcting errors in documents and not with procedural errors (see e.g. *Klein Schanzlin & Becker AG's Application* [1985] RPC 241). I do not believe that a failure to file the entire PCT application is an error in a document. Rather it is a procedural error. I therefore conclude that this error cannot be corrected using section 117. Similarly rule 47 relates to errors in the register or in documents filed in connection with registration and therefore cannot be used to correct the procedural error of failing to file a copy of the PCT application. Rule 100(2) may only be used to correct irregularities in procedure attributable wholly or in part to an error, default or omission on the part of the Patent Office. In this case the Office made no such error, default or omission and therefore rule 100(2) cannot be used to correct this irregularity in procedure.
- 59 Rule 100(1) gives the comptroller what appears at first sight to be wide discretion to amend documents and correct irregularities in procedure. There are however limitations on how the comptroller may use this discretion. The House of Lords in the well established case of *E's Applications* [1983] RPC 231 said that rule 100, which at the time corresponded to rule 100(1) of the 1995 Rules (rule 100(2) was subsequently added) could not be used to extend a time limit in a manner not allowed by rule 110, since a general provision of the Rules should not be construed in such a way as to circumvent a specific provision of the Rules. This applies equally to the specific provisions set out in section 89A(3)(b) for early entry to the national phase, namely the specific requirements that a copy of the international application be filed if none has yet been sent to the Office in accordance with the Treaty and that the applicant expressly request early entry to the national phase. Rule 100(1) may therefore also not be used to correct the procedural irregularities in question in the present case. Moreover there are no other provisions in the Act or Rules that would enable a copy of the PCT application to have been deemed as filed on 24 April 2006.
- 60 I now turn to the failure to expressly request early entry to the national phase. As I have said above, rule 100 may not be used to cure this irregularity. To the extent that this is a procedural error, similar arguments apply as to those in relation to the failure to provide a copy of the PCT application. Turning now to whether this matter may be curable by correcting the form NP1, Mr. Meade suggested that the word "NO" on form NP1 could be corrected to "YES". In order for this to be correctable it must be demonstrated that writing "NO" instead of "YES" was an error or mistake, such as a clerical error. It is apparent from the

submissions made to me that Investigen deliberately wrote “NO” on the form. There was no clerical error. Moreover I have found that the form NP1 and accompanying documentation, read in context, did not include an express request to enter the national phase early. All Investigen’s actions in this regard were deliberate. They deliberately filled in Form NP1 as they did. It was not a clerical error. Mr. Meade said

“the Applicant did want to enter the national phase sufficiently to make a late claim to priority, but did not want examination and search substantively to start immediately”.

- 61 Perhaps because Investigen are arguing both that they did not need to enter the national phase to make a late declaration of priority and also that if they did need to do so then they did enter the national phase in sufficient time, it is not easy to determine the precise intentions of the applicant’s deliberate actions in filing Form NP1 as they did, without a copy of the PCT application and without an express request to enter the national phase early. An application either enters the national phase or it doesn’t. There is no possibility of entering the national phase sufficiently to carry out some actions but not others. Filing the form NP1 did demonstrate an intention to enter the national phase at some point, but in my view, taking into account the failure to file a copy the international application, I do not believe Investigen demonstrated a clear intention to enter the national phase early. I can therefore identify no error or mistake of the kind correctable by either rule 47 or section 117.

Conclusion

- 62 In conclusion, following the reasoning in *Sirna* and *Abaco*, I refuse the request to make a late declaration of priority under section 5(2B) of the Patents Act 1977 on patent application GB0608060.0 on the grounds that the failure to file the application in suit within the twelve month priority period was not unintentional, as is required by section 5(2C)(b).
- 63 I also refuse the request to make a late declaration of priority under section 5(2B) of the Act on patent application GB0608059.2, the national phase case for PCT/US/2006/006455, on the grounds that no such request was made within the two month period specified by rule 6A(1). Such a request may only be made once a PCT application has entered the national phase and this application did not enter the national phase in sufficient time to make such a request.

Appeal

- 64 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

B MICKLEWRIGHT

Senior Legal Advisor acting for the Comptroller