

## **PATENTS ACT 1977**

IN THE MATTER OF

Patent Application GB0202309.1

In the name of

Gines Sanchez Gomez

### **DECISION**

#### **Introduction**

1. Patent Application GB0202309.1 was filed on 31 January 2002 in the name of Mr Gines Sanchez Gomez. A Patents Form 9/77, requesting preliminary examination and search, was filed with the application. A preliminary examination report was duly sent to Mr Sanchez Gomez on 27 February 2002. Among other things, the report drew his attention to the fact that the Patent Office needed to be furnished with an address for service in the United Kingdom as required in rule 30(1)(a). Mr Sanchez Gomez did not supply the required address. The Office then informed him that his application would be refused unless by 27 March 2002 he either supplied the address, made observations on the matter, or asked to present his case in person to a senior official. In the event, Mr Sanchez Gomez informed the Office that he wished the matter to be considered by a senior officer on the basis of the papers.

#### **Arguments**

2. Mr Sanchez Gomez has not supplied an address for service in the United Kingdom because he contends that the requirement is contrary to the provisions in the Treaty Establishing the European Community. In his letter of 6 August 2002, he argues that the requirement is incompatible with Article 43 of the Treaty.
3. In two further letters, dated 14 January and 1 April 2003, he refers to two cases, namely: Case C-478/01 - Commission of the European Communities v Grand Duchy of Luxemburg and Case C-131/01 Commission of the European Communities v The Republic of Italy. In both those cases the respective Advocate Generals concluded that the requirement in the countries in question that patent agents have to have an address with an approved representative in the country in order to provide a service in the country was contrary to the obligations under Article 49 EC. In referring to these cases Mr Sanchez Gomez claimed that he has complied with the address for service requirement because the Treaty "extends the benefits of residency into the United Kingdom to the rest of the countries of the European Union".

#### **Relevant UK legislation**

4. Section 17(3) of the Patents Act 1977 provides:

"If it is reported to the comptroller under section (2) above that not all the formal requirements are complied with, he shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period (subject to section 15(5) above) so as to comply with

those requirements (subject, however, to section 76 below), and if the applicant fails to do so the comptroller may refuse the application.”

5. The “formal requirements” referred to in section 17(3) are prescribed in rule 31(1) and include the requirement in rule 30(1)(a) which reads:

“30.-(1) There shall be furnished to the comptroller -

(a) by every applicant for the grant of a patent, an address for service in the United Kingdom for the purpose of his application”

6. The fact that section 17(3) states that the Comptroller “may” refuse an application if the formal requirements are not met implies the exercise of discretion by the Comptroller in deciding whether to refuse an application on the grounds of a failure to meet a formal requirement. Section 101 requires the Comptroller to give an applicant an opportunity to be heard before exercising adversely any discretion vested in her. It was for that reason that the Office offered Mr Sanchez Gomez the chance to be heard in this matter.

### **Assessment**

7. As mentioned above, section 17(3) provides the Comptroller with discretion to refuse an application if the applicant fails to comply with a formal requirement. What I have to decide is whether the Office, in exercising that discretion, was correct in its preliminary decision to refuse Mr Sanchez Gomez’s application on the grounds that he failed to comply with the formal requirement in rule 30(1)(a).
8. Rule 30(1)(a), as with the other provisions in the Patents Rules 1995, was approved by Parliament and any amendment to that rule can only be made by the Secretary of State through the normal statutory process. It is not for me to determine in this decision whether or not the rule should be changed on the grounds that it contravenes any treaties to which the United Kingdom is a party. This is consistent with the view expressed by Lord Diplock in E’s Application [1983] RPC 231 at page 235, line 35:

“If there are cases in which the application of Patent Rules leads to injustice, the cure is for the Secretary of State to amend the Rules”.

9. This said, as has already been explained to Mr Sanchez Gomez, the Patent Office is actively looking into the possibility of recommending to the Secretary of State that rule 30(1)(a) should be amended to allow a patent applicant’s address for service to be anywhere in the European Union. Until such a change is made, applicants are required to comply with the rule as it currently stands. There is nothing in the Act or Rules that would allow the Comptroller to waive the requirement.
10. With regard to Mr Sanchez Gomez’ claim that he has met the address for service requirement because the Treaty Establishing the European Community extends United Kingdom residency to the rest of the European Union, I can find no legal basis for this in the Treaty. Nor is there anything in the Patents Act or the Patents Rules to suggest that the reference in Rule 30(1)(a) to the “United Kingdom” means anything other than

the territory of the United Kingdom as defined in schedule 1 of the Interpretation Act 1978 and section 132 of the Patents Act 1977.

### **Conclusion**

11. Having considered the arguments put forward by Mr Sanchez Gomez, I am satisfied that the Patent Office reached the correct decision in refusing the application under section 17(3) on the grounds that Mr Sanchez Gomez has failed to comply with the formal requirements prescribed in rule 30(1)(a). Subject to any appeal that Mr Sanchez Gomez may wish to lodge against this decision, the application should be refused unless within 14 days from the date of this decision he furnishes the Patent Office with an address for service within the United Kingdom.

### **Appeal**

12. Under rule 52 of the Civil Procedure Rules the appeal period is 14 days unless I direct a different period. I see no reason to do so in the present case, and accordingly any appeal must be lodged within 14 days from the date of this decision.

Dated this 16<sup>th</sup> day of May 2003

M C Wright  
Assistant Director, acting for the Comptroller