

Young & Co. Mrs. C Farrington attended on behalf of the Patent Office.

The law

- 3 Section 5 of the Patents Act 1977 (“the Act”) 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 deals with this and 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 Contracting Party to the PLT 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.

Rule 6A of the Patents Rules 1995 as amended sets out the prescribed period and the details regarding how to make such a late declaration.

The Applicant’s arguments

- 4 Mr. Maschio commenced by referring to the body of case law built up under rule 110(4) of the Patents Rule 1995, where the comptroller has discretion to extend certain time limits, and certain conditions have been looked for in exercise of that discretion.

The lead case is *Heatex Group Ltd's Application* [1995] RPC 546 where the hearing officer looked for a “continual underlying intention to proceed” with the application. This test has subsequently been used in a number of cases where a discretionary extension of time has been requested under rule 110(4). Mr. Maschio argued that these cases relate to discretionary extensions of time and to a non-statutory test and therefore do not apply in the present case where the “unintentional” criterion is embedded in new statutory wording that originates in article 13(2)(iv) of the Patent Law Treaty.

- 5 Mr. Maschio then highlighted the two options available in Article 13(2)(iv) of the Patent Law Treaty in relation to restoration of priority rights and argued that the Patent Office in choosing the “unintentional” criterion was making a deliberate choice to make this as easy as possible for the applicant. Mr. Maschio commented that the language “unintentional” was not entirely satisfactory because the “application in suit” was always filed intentionally. In other words, when a mistake is made an applicant can choose to file a patent application late and ask the comptroller “I made a mistake. Please allow me to file it late”. Thus there is never a lack of intention to file in such cases. My understanding is that Mr. Maschio was arguing that if an application in suit was filed late due to a mistake (rather than deliberately) there was always an intention to file the application in suit on time. Moreover Mr. Maschio noted that the law does not say anything about what that mistake may or may not have been. I interpret Mr. Maschio’s submissions on this point to say that the test for determining whether the failure to file the application in suit was unintentional is to determine whether a mistake has been made and that the statute does not specify or imply any limitations on the nature of the mistake. Mr. Maschio commented that therefore the mistake could have been (or led to) a failure to file a PCT application or a failure to file a European application. If a mistake was made, then the requirements of section 5(2C) have been met.
- 6 I asked Mr. Maschio at the end of the hearing if he had any further comments on the interpretation of sections 5(2B) and 5(2C). He commented that interpreting section 5(2C)(b) to mean “only in the event that there is a mistake in filing a UK national application will we allow section 5(2B) to apply” did not square with the language of the section. He referred to his earlier argument on the interpretation of section 5(2C)(b) in relation to mistakes and stated that as there was no statutory basis for any limitation on the nature of the mistake a policy reason would be needed to make such a limitation. Mr. Maschio took the view that it would not serve the policy interests of the UK Patent Office or indeed the UK economy to say “well, this applies to people who intended to file UK applications, but not to people who intended to file international applications designating the UK”.
- 7 Much turns on identifying which application the applicant unintentionally failed to file in the twelve-month priority period. In his letter dated 17 May 2005 Mr. Maschio argued that this could not be the very same application as the one for which the Form 3/77 requesting permission to make a late declaration of priority had been filed, in the present case GB 0507019.8. These arguments were based on the fact that, had these application papers been filed, for example, a day earlier than they were actually filed they would have been assigned a different application number and filing date and thus would constitute a different application. Mr. Maschio therefore submitted in his letter that the intentions of the drafters of section 5(2C) must have been that a request under section 5(2B) should be allowed if the applicant had intended to but failed to file a

different application in respect of the same subject matter. I understand from these comments that Mr. Maschio's view is that section 5(2C) should be interpreted as meaning that the comptroller must be satisfied that the applicant's failure to file within the twelve-month period a different application in respect of the same subject matter but with an earlier filing date than that of the application in suit was unintentional.

- 8 Following his submissions above on the interpretation of the law, Mr. Maschio then turned to the facts surrounding the application in suit. He argued it would be unduly restrictive to make a distinction between failing to file a PCT application and failing to file a UK application because both are mistakes and the whole purpose of this part of the Patent Law Treaty and this part of the UK Patents Act is to allow applicants the chance to recover rights that have been lost because of errors, in other words to make such errors recoverable. To restrict errors to UK national applications would, in Mr. Maschio's view, take back part of what this provision in the Act is supposed to allow.
- 9 Mr. Maschio also argued that a PCT application should be viewed as a UK application for the purposes of this part of the Act, which, taken literally, would mean that it is not appropriate to draw a distinction between a failure to file a PCT application and a failure to file a UK application. These comments made at the hearing expanded on his comments in his letter of 17 May where he argued that as international applications are equivalent to national applications by virtue of section 89(1) it follows that it was the applicant's intention to file a UK application before the priority date. Mr. Maschio took the view that section 89B(1)(b), which states "any declaration of priority made under the Treaty shall be treated as made under section 5(2) above", includes section 5(2C)(b) and thus his view was that this could be read as saying that section 5(2C)(b) applies to PCT applications.
- 10 In concluding his initial submissions, Mr. Maschio highlighted his original argument that "unintentional" here must be taken to mean the presence of a mistake and that, with no qualification of the nature of the mistake, the provisions should be interpreted broadly. He also highlighted his argument that one should not draw a distinction between a mistake in filing a UK application and a mistake in filing a PCT application.

The Office's arguments

- 11 The Office had taken the view that the request to make a late declaration of priority had to be refused because, although the failure to file the international application did appear to be unintentional, there was no intention to file the application in suit, namely the GB application, until the priority period for filing the international application had lapsed. The Office took the view that the applicant who intended to file a PCT application but failed to do so was not also intending to file a national application and that section 5 only applies to national applications.

Assessment

- 12 The provisions of sections 5(2B) and 5(2C) which allow a late declaration of priority in certain circumstances are new and there is at present no case law specific to these provisions to guide me on how they should be interpreted or applied. Something similar to an "unintentional" test has been used in considering when it is appropriate to exercise the comptroller's discretion under rule 110(4) in extending certain time

periods and the test set out in *Heatex*, where the hearing officer looked for a “continual underlying intention to proceed” with the application, is regularly used in determining whether to allow requests under rule 110(4). Mr. Maschio argued that the body of case law developed under rule 110(4) does not apply to cases under section 5(2C)(b).

- 13 It is my view that the *Heatex* test relates to an intention always to prosecute the application, whereas the section 5(2C) test relates to an intention to file the application in time. The tests are thus different. Moreover the provisions of section 5(2C) are not discretionary unlike those of rule 110(4). I also note that an important policy objective of these provisions was to make UK patent law compliant with the Patent Law Treaty and this Treaty is an important root of the UK legislation. The body of case law built up under rule 110(4) cannot therefore be applied to section 5(2C) issues unless there are threads common to both areas. I believe such common threads could emerge, for example in cases under section 5(2C) where the intentions of the applicant are not clear and a detailed analysis of the evidence is required. However this is not the situation in the present case and my assessment will focus on the interpretation of the new provisions in section 5.
- 14 It is accepted by both the Office and the applicant that the failure to file the PCT application within the priority period was unintentional and I also agree with this. What is disputed is whether the unintentional failure to file the PCT application within the 12 month priority period amounted to an unintentional failure to file an application for a patent under the Act as defined in section 5. As PCT applications now designate all States, this application would have designated GB and so was *inter alia* an application for obtaining patent protection in the UK.
- 15 I will now turn to Mr. Maschio’s analysis of the new provisions of section 5 of the Act. He put it to me that the “unintentional” test could be formulated as determining whether a mistake had occurred and that there were no statutory limitations or restrictions on the nature of the mistake. Therefore he argued for a broad interpretation of section 5(2C)(b) which included the situation where the mistake had led to a failure to file a PCT application. I accept that it would normally be the case that it is a mistake that has led to the unintentional failure to file an application within the 12-month priority period but this does not imply that any mistake made in filing any application within the twelve-month period satisfies the requirements of section 5(2C). As an example consider the situation where the mistake was (or led to) a failure to file within the twelve-month priority period a US national application at the US Patent Office claiming priority from an earlier application and then subsequently filed a UK national application after the end of the priority period along with a request under section 5(2B) of the Act. In this situation section 5(2C)(b) clearly should not be understood as allowing such a late declaration of priority as the applicant’s intention had been to file a US national application within the priority period. Therefore section 5(2C)(b) must imply a limitation on the nature of a mistake that leads to an unintentional failure to file the application in suit within the 12-month priority period. It seems to me that the appropriate place to start in determining the meaning and scope of sections 5(2B) and 5(2C) is to examine the wording of the provisions themselves.
- 16 Mr. Maschio made submissions on the interpretation of section 5(2C)(b) and this issue is, in my view, of prime importance to the present case. I will first consider which application is the “application in suit” and then whether the test of section 5(2C)(b) has

been satisfied in the present case. Section 5 should be interpreted in as consistent a manner as possible and should be considered as a whole. Section 5(2) makes it clear that the application in suit is the application under consideration at that time. In this case this is GB national application GB 0507019.8 which includes a Form 3/77 upon which a request to make a late declaration of priority has been made. I do not accept Mr. Maschio's interpretation of section 5(2) that the applicant's failure to file within the twelve-month period a different application in respect of the same subject matter but with an earlier filing date than that of the application in suit must be unintentional. When section 5 was amended by the 2004 Order to include these provisions the drafters ensured that the provisions were as clear and straightforward as possible. If they had in mind the meaning Mr. Maschio attaches to section 5(2C) I believe they would have explicitly and clearly drafted the provision accordingly. Section 5(2C)(b) does not state that the applicant's failure to file another application with the same subject matter must be unintentional but that the applicant's failure to file the *application in suit* must be unintentional. In my view this does not merely refer to a failure to file the subject matter in the present application, that is the one upon which the Form 3/77 has been filed within the twelve-month period, but must refer to a failure to file the present application in its entirety within the twelve month period. That is, the applicant must have intended to file the very same GB national application with the same application papers before the priority period expired. This is in my mind the clear and straightforward meaning of section 5(2C) when considered in the context of section 5 as a whole.

- 17 In the present case there was no intention to file the application in suit, GB application GB 0507019.8, a national application, within the twelve-month priority period. Rather the applicant intended to file a different application, namely a PCT application, before the end of the twelve month period. There is now no PCT application in existence and for this reason also such an application cannot be considered as "the application in suit" for the purposes of section 5 of the Act.
- 18 Mr. Maschio also presented arguments that sections 89, 89A and 89B of the Act imply that section 5(2B) and 5(2C) should apply to PCT applications. In the present case, however, I have already found that there was no unintentional failure to file the application in suit within the twelve month priority period as is required by section 5(2C)(b) and this is the case whether or not Mr. Maschio's arguments on the interpretation of sections 89, 89A and 89B are correct. I therefore do not need to consider this point any further.

Conclusions

- 19 In conclusion there was no unintentional failure to file the application in suit, namely the GB national application GB 0507019.8, within the priority period as is required by section 5(2C)(b) and I therefore refuse the request under section 5(2B) for the comptroller's permission to make a late declaration of priority under section 5(2).

Appeal

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

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