



BL O/309/06

30th October 2006

PATENTS ACT 1977

APPLICANT Abaco Machines (Australasia) Pty Ltd

ISSUE Whether a request to make a late
 declaration of priority under section 5(2B)
 for patent application number GB
 0504687.5 should be allowed

HEARING OFFICER G J Rose'Meyer

DECISION

Background

- 1 Patent application GB0504687.5 was filed on 7th March 2005 and claimed priority from a Vietnamese application (no. 1-2004-00017) of 7th January 2004. Clearly this is outside the twelve month period allowed for normal priority claims.
- 2 Also on 7th March 2005 a Form 3/77 was filed with the application with a request made under rule 6A(2) to make a late declaration of priority with regard to the Vietnamese application . The request was filed within the time allowed under rule 6A(1) of 2 months and was accompanied by a witness statement by Mr. Christian Schieber a patent attorney in the firm of Watermark in Australia.
- 3 Mr. Schieber explained that Abaco Machines (Australasia) Pty Ltd (the applicant) instructed his firm in July 2004 to file a PCT application which was to claim priority from the Vietnamese application referred to above, that is from the date of 7th January 2004. These instructions were acknowledged by Mr. Schieber, but unfortunately the acknowledgement noted the date of the 17th January 2005 as the date the PCT could still be effected. That should of course have been the 7th January 2005.
- 4 At the same time as the acknowledgement letter was sent by Watermark, a new internal form sheet was completed by a secretary who was assisting Mr. Schieber at that time. This form sheet included data entry points for entering details such as key dates (including filing dates and priority deadlines) onto the Watermark internal computer system.
- 5 Unfortunately this form sheet included another error in that it showed the priority date as 14th January 2004 instead of 7th January 2004. There is

detailed explanation in Mr. Schieber's witness statement as to the reasons and effects of this error and none of these facts were disputed by the Office in consideration of the evidence filed.

- 6 The ultimate outcome was that the mistake led to Watermark's electronic diary system miscalculating the date by which the PCT application should be filed. Watermark confirmed in November and December 2004 that the applicant still wished to file a PCT application and at that point indicated to them that the deadline date for filing the PCT application was the 14th January 2005. That date was of course incorrect, but neither Mr. Schieber nor the applicant spotted this at the time. With a date of 14th January 2005 indicated on the system, Mr. Schieber was prompted to action the PCT filing and picked up his case file to do so on the 13th January 2005. It was at this point that the error first came to his notice.
- 7 The applicant was consulted as to how they wished to proceed, ultimately resulting in a decision not to file a PCT but rather a number of national applications where late declarations of priority might be made.
- 8 Mr. Schieber states that it was always the applicant's intention to file further patent applications claiming priority from their Vietnamese application dated 7th January 2004. Initially this was to be via the PCT route. The mistake was an isolated error and that the failure to file the international application was unintentional.
- 9 The Office wrote to the UK attorneys Kilburn & Strode on the 6th May 2005 making a preliminary decision to refuse the request to make a late declaration of priority on the grounds that whilst the failure to file the *PCT application* did appear to have been unintentional, it appeared that there had been no intention to file the *application in suit* i.e. GB0504687.5 until after the convention deadline for filing the PCT application had expired. Accordingly the failure to file the *application in suit* within the prescribed period could not have been unintentional.
- 10 On the 6th June 2005, Kilburn & Strode replied to the preliminary refusal by filing two further witness statements, a second by Mr. Schieber of Watermark and one by Mr. Ai Nhon Nguyen a Director of the applicant company. These witness statements confirm that the international application which Watermark had been instructed to file was to have included designation of all available contracting States of the PCT, including both GB and EP. Kilburn and Strode also included some further arguments in support of the request to make a late declaration of priority under section 5(2B).
- 11 The Office replied to Kilburn & Strode's letter on the 27th October 2005 by saying the response had been held in abeyance awaiting the Office decision in unpublished application GB0507019.8 and enclosed a copy of that decision – *Sirna Therapeutics Inc.* - BLO/240/05 - because it considers issues relevant to the circumstances of the application in suit. The reply further confirmed the preliminary decision to refuse the request to make a late declaration of priority under section 5(2B) even after consideration of the further evidence filed.

- 12 On the 28th November 2005 Kilburn & Strode wrote to the Office requesting a hearing. The case therefore came before me at a hearing on the 15th February 2006. The applicant was represented by Mr. T.G. Copsey of Kilburn & Strode and Mrs. C. Farrington represented the Office.

The law

- 13 As this is only the second case which has come to a hearing on this issue, it is worth stating the legal background to the issue. Section 5 of the Patents Act 1977 (“the Act”) was amended by Regulatory Reform (Patents) Order 2004 (“the 2004 Order”) which came into force on the 1st January 2005. In particular this Order made UK law compliant with 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

- 14 Mr. Copsey at the hearing began by clarifying the Office's position that it had been accepted that the failure to file an international application claiming priority from the Vietnamese application on time had been unintentional. I confirmed that this was so and that this was also my view.
- 15 He went on to characterise the core of his clients' arguments as being whether the PCT filing or failure to file the PCT application would constitute an "application in suit" under section 5(2B). He referred to the recently issued *Sirna Therapeutics Inc* decision of the Office, to which the Office had referred Kilburn & Strode on 27th October 2005. That had been the only case to date that had been heard on this specific issue for a request to make a late declaration of priority under section 5(2B).
- 16 He acknowledged that that decision had come to the conclusion that a PCT application could not be regarded as such an "application in suit" under section 5(2B), but it was his submission that this is inconsistent with section 89(1) of the Patents Act.
- 17 Mr. Copsey went on to deliver a quite detailed set of submissions based on his section 89(1) arguments. For reasons which will become evident, I do not intend to rehearse these in full in this decision, although I will refer them to the extent I deem necessary to address the substantive issues in this case.

The office's arguments

- 18 The Office's arguments are as stated in paragraph 9 above.

Assessment – comparisons with *Sirna Therapeutics Inc* decision

- 19 As has been said, the only previous case to come to hearing on this issue was the *Sirna Therapeutics Inc* decision – BLO/240/05. That case was not appealed so is the only guidance on the issues affecting both that and this case.
- 20 In order to establish whether the considerations and outcome of that decision apply to this case, as has been suggested by the Office in its preliminary decision, it is right for me to make a comparison of the issues and circumstances surrounding both. I have obviously made a close study of the evidence in this case and I have carefully read and considered the *Sirna Therapeutics Inc* decision (subsequently "*Sirna*").
- 21 In brief, in *Sirna* the application was filed in the UK Office on 6 April 2005 and claimed priority from two US applications, the earlier of which was filed on 20 February 2004, outside the twelve-month period for normal priority claims. This filing was accompanied by a request to make a late declaration of priority under section 5(2B) of the Act. The applicant had intended to file a PCT

application at the US Patent Office within the twelve month priority period claiming priority from the earlier applications. This PCT application would have designated the United Kingdom. However the wrong cover sheet was inadvertently filed with the application and therefore the application was effectively filed as a US utility application instead of a PCT patent application.

- 22 The case turned on the meaning of section 5(2C)(b) of the Act, specifically on whether the failure to file the “application in suit” within the priority period was unintentional. The hearing officer held that to satisfy section 5(2C) (b) the applicant had to have intended to file the GB national application, as this was the “application in suit” with the within the twelve-month period. He decided this had not been satisfied. Rather the applicant intended to file a different application, namely a PCT application, before the end of the twelve month period. The hearing officer also found that no such PCT application was in existence and for this reason also, such an application could not be considered as “the application in suit” for the purposes of section 5 of the Act. Therefore the request was refused.
- 23 From my account of the background to this case, it can be seen that the circumstances surrounding the present case are (save for individual variances of detail) identical:
- A PCT application should have been filed claiming priority from an earlier application
 - The UK was to be designated (as PCT applications now designate all contracting States automatically)
 - Due to an unintentional error, the 12 month deadline for filing the international application was missed
 - For differing reasons but with the same outcome, no PCT application resulted or exists.
- 24 In these circumstances therefore, it would seem logical to regard the substantive issues to be the same in both cases. In *Sirna* the previous hearing officer came to a conclusion that the issues to be decided were an interpretation of the words “application in suit” in section 5(2C) (b), and whether that the failure to file that “application in suit” on time was unintentional. His conclusions were that the “application in suit” can only be the present GB application under consideration – i.e. that on which the Form 3/77 had been filed with the request for a late declaration of priority.
- 25 Although I have found the substantive issues to be decided to be the same, I am of course not bound by the *Sirna* decision. I have given very careful consideration as to whether the hearing officer’s approach, considerations and conclusions in *Sirna* were correct and I am entirely satisfied that they were. That being the case, I think the Office’s application of the rulings in *Sirna* to this request was also correct.

26 It follows then that my ultimate decision must be that the present application (GB0504687.5) must be regarded as the “application in suit”. The circumstances of this case show that as it was only the unintentional failure to correctly file the PCT application on time that led to a necessity to file GB0504687.5 at all, then it (GB0504687.5) must have been filed *intentionally*, and not *unintentionally* outside the twelve month period allowed, as section 5(2C) (b) stipulates.

27 As such the request under Section 5(2B) must fail.

Other issues

28 Mr. Copsey also argued that section 89(1) of the Act states clearly that a PCT application designating the UK is to be treated as a UK application. He went on to give his supporting views on this. He noted that in the *Sirna* decision, the hearing officer was also presented with similar arguments but chose not to deal with them fully.

29 The reasons for this are clear. In both *Sirna* and in this present case, no PCT application ever resulted after the respective errors were made, so essentially the arguments were hypothetical and academic.

30 Section 89(1) begins:

An international application for a patent (UK) *for which a filing date has been accorded* under the Patent Co-operation Treaty shall.....[my emphasis]

31 In this case having missed the deadline to claim priority, the Australian agents enquired of the applicant how they wished to proceed and the applicant chose various national routes, not the PCT.

32 At the hearing, Mr. Copsey also outlined a specific hypothetical scenario taken from the previous hearing officer’s conclusions whereby only in a very limited set of circumstances could a wrongly filed PCT application take advantage of the provisions of section 5 (2B). This was essentially where having missed the twelve month deadline to file the PCT application claiming priority, applicants must file the PCT and request to enter the national phase and file the Form 3/77 requesting a late declaration of priority within the further period of grace of two months allowed by section 5(2A)(b). Only then it would appear would a PCT application be regarded as an “application in suit”. Mr. Copsey asked if this was a correct interpretation from the *Sirna* decision?

33 Although this is not explicit in the *Sirna* decision and not substantive to this case I am aware that the first example of a successful late declaration of priority following early entry into the national phase is being processed in the Office at the date of writing this decision.

34 While it might seem unhelpful not to comment on the section 89(1) *et seq* submissions of Mr. Copsey at the hearing, I have considered this approach long and hard. Decisions of the Office should limit themselves purely to the

substantive issues of the case at hand and this is what I have done.

Conclusions

- 35 I have found that there was no unintentional failure to file the application in suit, i.e. the GB national application GB0504687.5 within the priority period as required by section 5 (2C) (b) and therefore I refuse the request under section 5(2B) for the comptroller's permission to make a late declaration of priority under section 5(2).

Appeal

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

G J Rose'Meyer

Hearing Officer acting for the Comptroller