



## The law

- 4 Article 4 of the Paris Convention specifies a twelve month priority period for patent applications. This means that, within twelve months from the filing of a patent application in a country that is a member of the Convention, an applicant may file a further application for the same invention in any such country and may claim priority from the earlier application. The effect of this is that the date of the later application is taken to be the filing date of the earlier one.
- 5 Article 13(2) of the Patent Law Treaty introduced a limited set of circumstances where the right of priority could be restored if the later application failed to be filed within the twelve month priority period. These provisions were implemented under the PCT by amendments to the PCT Regulations which came into force on 1 April 2007. In particular, the relevant parts of PCT rule 26bis.3 are as follows:

### *26bis.3 Restoration of Right of Priority by Receiving Office*

*(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant, and subject to paragraphs (b) to (g) of this Rule, restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:*

*(i) occurred in spite of due care required by the circumstances having been taken; or*

*(ii) was unintentional.*

*Each receiving Office shall apply at least one of those criteria and may apply both of them.*

*(b) A request under paragraph (a) shall:*

*(i) be filed with the receiving Office within the time limit applicable under paragraph (e);*

*(ii) state the reasons for the failure to file the international application within the priority period; and*

*(iii) preferably be accompanied by any declaration or other evidence required under paragraph (f).*

...

*(e) The time limit referred to in paragraphs (b)(i), (c) and (d) shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a) or any notice referred to in paragraph (c) submitted, or any fee referred to in paragraph (d) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.*

...

- 6 Each receiving Office may decide to apply either or both of the “unintentional” or “due care” criteria. The UK Office has decided, when acting as a receiving Office, to apply only the “unintentional” criterion and has notified the International Bureau accordingly.

### **Background**

- 7 The PCT application claims priority from four earlier UK applications as follows:

GB0812748.2, filed 11 July 2008 in the name of New Age Radiators (“P1”);

GB0816067.3, filed 3 September 2008 in the name of Ray Fisher Construction (“P2”);

GB0818969.8, filed 16 October 2008 in the name of John Terence Crilly (“P3”); and

GB0818972.2, filed 16 October 2008 in the name of John Terence Crilly (“P4”).

- 8 Applications P1 and P2 were the subject of entitlement proceedings before the Office which were launched by Mr Crilly in December 2008. Those proceedings concluded with a decision of the Comptroller dated 11 August 2009 finding Mr Crilly to be entitled to be named as the sole applicant for both applications and ordering that P1 and P2 should proceed in his name.
- 9 Mr Crilly filed the PCT application on 28 August 2009, shortly after the outcome of the entitlement proceedings. Since the filing date of priority application P1 was more than twelve months before the filing date of the PCT application, he requested restoration of the right of priority in respect of P1.

## **Applicant's arguments**

- 10 The statement accompanying the request for restoration of the right of priority indicated that Mr Crilly had always intended to file an international application for the subject matter contained in P1, but had only become entitled to file an international application having a valid priority claim to P1 following the outcome of the entitlement proceedings. Mr Crilly had filed application P4, covering the same subject matter as P1, as a precautionary application and had intended to file an international application claiming priority from P4 within the priority year. Once the entitlement dispute was resolved in Mr Crilly's favour, he took the first opportunity to use his legitimate claim to the earlier priority application P1.
- 11 Dr Rooney provided further arguments and evidence in a letter dated 13 October 2009 in which he submitted that the possibility of filing an international application within twelve months of P1 was missed because P1 was not in Mr Crilly's name and so the normal diarying processes for sending out reminders regarding the expiry of the priority year were not in place for P1. Prior to the hearing, Dr Rooney provided further evidence in support of this submission in an email dated 6 April 2010.
- 12 At the hearing, Dr Rooney started his oral submissions by reiterating that the test to be met is whether the failure to file the PCT application within twelve months of P1 was unintentional. He commented that he took this to mean that there was no positive decision not to file the PCT application. He submitted that he and Mr Crilly did not consciously decide not to file the PCT application by the priority deadline of 11 July 2009 and that they only became conscious of the need to file by 11 July 2009 after that date. This was because of the complications introduced by the entitlement dispute and the fact that the normal diarying process for generating reminders of the expiry of the priority year was not in place for P1.
- 13 I asked Dr Rooney whether Appleyard Lees had any established procedures for diarying cases that were subject to entitlement proceedings. He informed me that the firm's automatic diarying procedure would only be in place where they had taken over an application or filed a new application. Since it was such an unusual situation to set up a diary date for a case where the firm was not representing the applicant, there was no standard procedure in place to cover such circumstances. It would therefore be down to the attorney dealing with the case to instigate setting a diary date.
- 14 Dr Rooney continued his submissions by saying that, as far as he was aware, Mr Crilly always intended to file a PCT application for his invention. He had notified Mr Crilly that the deadline for filing the PCT application was 16 October 2009, because that was a year after Mr Crilly's first application, P4, for the same subject matter (P4 had been filed as a precautionary application in case P1 was withdrawn by the non-entitled party prior to the commencement of entitlement proceedings). Therefore, during the period leading up to 11 July 2009, Mr Crilly was still under the impression that the final deadline for filing the PCT application was 16 October 2009.

- 15 In view of the fact that that the specifications of applications P1 and P4 are identical, I questioned Dr Rooney about the applicant's knowledge of the contents of application P1 prior to the outcome of the entitlement proceedings. Dr Rooney informed me that Mr Crilly was unaware of the exact contents of P1 apart from the title. Mr Crilly had come across some documents written by the patent attorney acting for the unentitled party which he thought may have been used as the basis for application P1, but he was not sure. It was not until the outcome of the entitlement proceedings that Mr Crilly became aware that the specifications of P1 and P4 were the same.
- 16 I then asked Dr Rooney about the applicant's intentions regarding P1 during the entitlement proceedings, in the light of Mr Crilly's knowledge that P1 could have related to his invention. Dr Rooney explained that he and Mr Crilly were focusing their energies on the entitlement action itself and did not discuss very much what would happen if they were victorious. Dr Rooney had understood that Mr Crilly intended to file a PCT application for his invention, but it was left unsaid as to what he intended to do with P1.
- 17 Dr Rooney continued his submissions by stating that once he realised that Mr Crilly was about to take over application P1 after the priority deadline and that this would impact on his ability to file a PCT application and claim priority, he alerted Mr Crilly and suggested that the PCT application be filed straightaway with a request to restore the right of priority. He submitted that, at the time of 11 July 2009, there was no intent or positive decision not to file the PCT application – the applicant was simply ignorant of the fact that he should do it. A mistake had been made in not setting a diary for 11 July 2009 and taking due account of it, but Dr Rooney pointed out that the test is not whether or not the applicant should have been aware of this date. Rather the test is whether or not the applicant missed it unintentionally.

### **Office's arguments**

- 18 The Office had taken the view that the failure to file the PCT application within twelve months of the earlier application could not have been unintentional because the applicant appeared to have taken a conscious decision not to file the international application before 11 July 2009 in the light of the ongoing entitlement dispute. It was the Office's view that the applicant would have been aware of the filing date of the earlier application that was the subject of the entitlement dispute and would therefore have known that the period for claiming priority from that application expired on 11 July 2009. In response to the applicant's argument that he was not entitled to file a PCT application validly claiming priority from P1 until after 11 July 2009, the Office submitted that the PCT application could have been filed before 11 July 2009 without the priority claim. Under PCT rule 26*bis*.1, the priority claim could have been added at a later date once the entitlement proceedings were concluded. It follows that the Office reached the preliminary view that the request for restoration of the right of priority should be refused as the failure to file the application by 11 July 2009 was not unintentional.

## Assessment

- 19 It falls to me to decide whether Mr Crilly's request to restore the right of priority on the PCT application is allowable.
- 20 I will first confirm that the request was made in time, that is, within the period of two months from the date on which the priority period expired, as required by PCT rule 26*bis*.3(e). The request was made at the same time as the filing of the PCT application on 28 August 2009. This is within the period of two months from 11 July 2009, the date of expiry of the period for claiming priority from P1. The request was therefore made in time. Further, the request included a statement of the reasons for the failure to file the application within the priority period, as required by PCT rule 26*bis*.3(b)(ii).
- 21 I now turn to the question of whether Mr Crilly's failure to file the PCT application within twelve months of the earlier application, P1, was unintentional, as required by PCT rule 26*bis*.3(a)(ii).
- 22 Dr Rooney submitted that he took the requirement of PCT rule 26*bis*.3(a)(ii) to mean that there was no intention or positive decision not to file the PCT application within the relevant period. Such an interpretation implies that, in the absence of a positive decision not to file the application, the test set out by PCT rule 26*bis*.3(a)(ii) is automatically met. However, PCT rule 26*bis*.3(a)(ii) does not require the absence of a positive decision not to file the application within the relevant period. All it says is that the failure to file the application must have been unintentional. In my view, according a particular meaning to the test creates a risk of moving away from the wording of rule 26*bis*.3(a)(ii). It follows that I will make my decision by considering whether the evidence before me shows that the failure to file the application within the relevant period was unintentional, rather than by using any other test. In assessing the evidence to determine the reasons for the failure to file the application, I will look at what Mr Crilly's intentions were during the relevant period, as well as considering whether a positive decision was made not to file the application within that period.
- 23 On the basis of the evidence provided during the processing of the case and the submissions made by Dr Rooney during the hearing, I accept that Mr Crilly intended to file a PCT application for the subject matter of his earlier application P4. However, he failed to do so during the relevant period, that is, the period leading up to 11 July 2009. What were the reasons for this failure and did Mr Crilly have any intention to file the application by 11 July 2009?
- 24 On becoming aware of the existence of application P1, Mr Crilly filed precautionary application P4 on 16 October 2008. He subsequently launched entitlement proceedings in respect of P1 in December 2008. However, I can find no evidence to suggest that during the period between filing application P4 and receiving the decision finding him to be entitled to application P1, Mr Crilly had any intention to file the PCT application by 11 July 2009. On the contrary, as confirmed by Dr Rooney during the hearing, at the time that the priority period expired Mr Crilly was under the impression that the final deadline for filing the PCT application was 16 October 2009 i.e. twelve months from the filing date of his earlier application P4. It was only after the entitlement decision was issued on

11 August 2009 that Mr Crilly became aware of the need to have filed the PCT application by 11 July 2009. Dr Rooney confirmed during the hearing that, up until that point, he had not specifically discussed with Mr Crilly the issue of what would be done with application P1 if Mr Crilly were to be found entitled to it.

- 25 At the hearing, Dr Rooney said that the reason he and Mr Crilly only became conscious of the need to file the PCT application by 11 July 2009 after that date was because of the complications introduced by the entitlement dispute and the fact that no diary date was set in respect of application P1. It was clear to me from Dr Rooney's submissions that, during the relevant period, he and Mr Crilly had failed to appreciate the impact that a successful outcome of the entitlement proceedings would have on Mr Crilly's ability to file an international application and claim priority. They were therefore unaware of the existence of the 11 July 2009 deadline. Further, in the absence of any established procedure for diaring cases subject to entitlement proceedings, no automatic reminder systems were in place to alert Dr Rooney to the existence of the deadline.
- 26 It follows that Mr Crilly did not consider the possibility of filing an international application claiming priority from P1 until after the expiry of the relevant period, despite his knowledge that P1 may have related to his invention. At the end of that period, he was under the impression that the deadline for filing a PCT application was 16 October 2009. I can find nothing to suggest that he had any intention of filing a PCT application within the relevant period. Furthermore, on the basis of the evidence it seems to me that Mr Crilly's failure to appreciate the consequences of a successful outcome of the entitlement proceedings led him to delay taking any action with regard to the filing of a PCT application until after those proceedings had been concluded. In my view, this amounted to a positive decision to take no further action until the outcome of the entitlement proceedings was known. As a result of this decision, Mr Crilly failed to file the PCT application by 11 July 2009. It follows that I do not think it can be said that the failure to file the PCT application within the relevant period was unintentional.
- 27 It is clear that shortly after the outcome of the entitlement proceedings, Mr Crilly realised that the 11 July 2009 deadline existed and that, with hindsight, he should have taken action before that date. Had he considered the potential impact of the entitlement proceedings at an earlier stage, it is possible that Mr Crilly would have taken a different course of action. However, what Mr Crilly may or may not have done in different circumstances is not relevant to the issue at hand – my decision must be based on the circumstances as they stood.
- 28 The evidence shows that, on balance, Mr Crilly failed to appreciate the 11 July 2009 deadline and delayed taking any action to file a PCT application until the entitlement decision was received, having in his mind that the final deadline for filing the PCT application was 16 October 2009. His decision to delay taking action until the entitlement proceedings were resolved led to the failure to file the PCT application by 11 July 2009. Although I accept that the entitlement proceedings complicated matters somewhat and I sympathise with the situation Mr Crilly now finds himself in, it follows that I am not satisfied that the failure to file the application within the relevant period was unintentional.

## **Conclusion**

- 29 I conclude that the request to restore the right of priority on international patent application PCT/GB2009/051092 under PCT rule 26*bis*.3 must be refused on the grounds that the failure to file the application within the relevant period was not unintentional.
- 30 Since the UK receiving Office has chosen to apply the “unintentional” criterion of PCT rule 26*bis*.3(a)(ii), I make no finding as to whether the failure occurred in spite of due care required by the circumstances having been taken – this being the criterion specified in PCT rule 26*bis*.3(a)(i).

## **Appeal**

- 31 This is a decision of the Intellectual Property Office in its capacity as a receiving Office under the PCT. As such, there is no appeal available under the Patents Act 1977. The decision is, however, open to judicial review.

## **Dr H L CRAVEN**

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