

PATENT COOPERATION TREATY

IN THE MATTER OF International
Application No PCT/GB 2003/002308 in the name of
PENIFE INTERNATIONAL LIMITED

DECISION

Introduction

1 The United Kingdom Patent Office acting as a Receiving Office under the Patent Cooperation Treaty (PCT) has concluded that this international application cannot be accorded a filing date of 28 May 2003 - the date on which the Request form and certain supporting documentation was received. The reason was that the documentation did not contain a part which on the face of it appeared to be a claim or claims. The agent filed a claim on 2 July 2003 but argued that this was included in the original documentation and that the filing date of 28 May 2003 should thus be preserved. The Receiving Office maintained its view and said that the application would have to proceed with a filing date of 2 July 2003. The agent requested a hearing on the matter. Although the PCT does not include provision for participating offices to have their decisions reviewed on appeal to a higher judicial level, the United Kingdom Patent Office has offered such hearings by analogy with hearings under the Patents Act 1977 on UK patent applications. The matter therefore came before me on 24 September 2003, when the applicants were represented by Richard Davis, instructed by Urquhart-Dykes & Lord, and Mrs D Cooke represented the Office.

History

2 In more detail therefore, received on 28 May 2003 were the Request form - which indicated that the international application was claiming priority from a previous UK application dated 31 May 2002 - and a specification of some four pages that was accompanied by three sheets of drawings. The four pages of the specification are clearly a description of an invention, bearing all the hallmarks of a professionally-drafted document with all the conventional sections. Closer examination of the first page of this description shows a paragraph fulfilling the function of what is sometimes called a "consistory clause". Here, at lines 15 to 24, we have a single statement commencing with the words "In accordance with the present invention, there is provided an implement...". But turning to the end of the description we find no echoing statement of claim: the description simply concludes after detailing the illustrated embodiments of the invention.

3 The Receiving Office therefore concluded that the application contained no claims, as required to secure a filing date by Article 11(1)(iii)(e) PCT, and the agent was notified of this on 10 June 2003 (Form PCT/RO/103). His response was to file on 2 July 2003 a sheet, numbered as page 5 and headed CLAIM. Under that heading was a single paragraph containing a definition of an implement using identical wording to that in the consistory clause already mentioned, starting at the words "an implement". The agent did however deny that the claim was missing from the application as at 28 May 2003, because of the consistory clause.

- 4 The Receiving Office maintained its original view and pointed out that the consistory clause was not “on the face of it” a claim because it was embedded in the specification. Nor did it meet the requirement of Rule 11.4(a) PCT that each element of the application should commence on a new sheet. The filing date would therefore have to be re-dated to 2 July 2003, and as this was outside the 12-month convention period, the priority claim would fall.

The applicable law

- 5 The PCT sets out certain requirements for documents making up an international application to be accorded a filing date. These are in Article 11 and the relevant parts read:

Article 11

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:

...

(iii) the international application contains at least the following elements:

...

(d) a part which on the face of it appears to be a description,

(e) a part which on the face of it appears to be a claim or claims.

(2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.

- 6 Article 11(1)(iii)(d) and (e) are clearly distinct requirements on the textual part of the application. The question to be answered here is whether a single piece of text can serve to satisfy both requirements.

Applicant’s submissions as to the law

- 7 At the hearing Mr Davis deployed the following arguments for an affirmative answer to this question. Analysis of the PCT provisions showed that the test to be applied here fell into two parts:

A Is there a part of the application which complies with the substantive requirements of claims? We find those requirements in Article 6 PCT: “The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.”

B Can this part be identified in the application without undue burden, ie is it apparent “on its face”, to use the Article 11(1)(iii)(e) wording?

8 As to question A, Mr Davis said that the consistory clause clearly satisfied the requirements of Article 6, insofar as the clause was definitive, clear, concise and supported. As to question B, the consistory clause was easily found in this short specification; the presence and position of such clauses are in any cases matters of established drafting practice, and their function is recognised as being to detail the principal features of the invention.

9 Mr Davis said that the consequences of not finding that claims were present were draconian: loss of original filing date may lead to loss of priority date, which in turn may lead to anticipation by one's own previous application. The provision should thus be interpreted broadly. Certainly this should not turn on mere physical requirements, such as whether elements started on new sheets of paper. Article 25 PCT may provide a safety net for loss of filing date, but would require the applicants to put in train a review by each one of the designated offices.

Analysis of the law

10 I have to say that I do not accept Mr Davis' two-part test, because it must be incorrect to invoke Article 6 PCT at this point. The PCT does not say that Article 6 requirements must be satisfied to get a filing date. In fact consideration of compliance with such substantive requirements will not take place until the application enters national and regional phases and receives a substantive examination.

11 We should not therefore stray beyond the requirements of Article 11(1) PCT for present purposes. These requirements are far simpler than those of Article 6: they require the identification of an element of the application which is a part which "on the face of it" appears to be a claim or claim. There is a clear implication here that it is in fact irrelevant whether such part does in fact function as a claim in the sense of Article 6. The phrase "on the face of it" again implies looking for one or more physical cues derived from standard drafting practice, according to which, for example,

- C claims are distinguishable from description, usually by being placed after the description and starting on a new sheet
- C they have a heading such as Claims
- C they are in numbered paragraphs in the manner of a list, each paragraph comprising a single sentence

12 I stress that I am not elevating any of these factors to necessary requirements for a claim to be identified as such. I merely suggest that when non-technical staff come to look for claims in an application they will have to use such cues in coming to an "on the face of it" judgement, and I think it is appropriate and sufficient to do so, according to the terms of the PCT.

13 On this basis what are we to make of a specification such as was initially filed here? The cues were absent: there was nothing that immediately presented itself as distinct from the description by location or heading. We therefore come back to the issue I mentioned above: is it possible for a single piece of text, viz the consistory clause, to be at the same time description and claim, and thereby satisfy both Article 11(1)(iii)(d) and (e)? Merely on a

consideration of these provisions I would say not. The Article says that the international application must contain a specific list of elements of which description and claims are two. One expects the elements to be distinct and readily recognisable as such, and hence to find that number of elements included in the application, not some lesser number. A consistory clause is conventionally part of a description, and does not stand apart from the description in the manner of a claim. For all these reasons I do not think that a paragraph in a description which is in the nature of a consistory clause can be said to be “a part which on the face of it appears to be a claim”. Before drawing a final conclusion I should look however at precedent cases.

Applicant’s submissions as to precedent cases

- 14 Mr Davis acknowledged that there was no precedent case on this exact issue. He took me firstly to *British United Shoe Machinery Company Ltd v Fussell & Sons Ltd (1908) 25 RPC 631* which usefully sets out the function of claims as delimitation of the invention. Mr Davis pointed out that in the present case we had a part of the specification that delimits the invention. It was well known that consistory clauses were included in descriptions and that they accorded with claims in setting out essential features of the invention, and indeed Patent Office guidance was produced which explained this point. Mr Davis thus underlined that the consistory clause has the same function as a claim, and it was wrong to dismiss it as a claim by reference to physical requirements. A consistory clause was thus a reasonable place to look for a statement of claim.
- 15 My conclusion on this line of argument is similar to the Article 6 point above: claims have to be differentiated in the simple ways suggested by Article 11, not on any more subtle, functional basis. Consistory clauses that are embedded in and part of descriptions are not claims.
- 16 Mr Davis then turned to the decision of *Fletcher’s Application (O/235/98)*, which was also a case where a PCT application was filed without claims. The facts there were different to the extent that the UK Receiving Office had initially accorded a filing date although the application had contained a numbered list of benefits, but no claims. The International Bureau then advised that claims were indeed missing and the upshot was that the application was considered withdrawn. In paragraph 12 of that decision I postulated that the Receiving Office may in certain circumstances have tended to err on the side of benefiting the applicant in deeming claims present, but said that such flexibility was inappropriate if there was little doubt that claims were not present. Mr Davis advocated such flexibility in the present case because there was indeed a claim in the application. I have to disagree: to my mind this is a case where there is no doubt that the “claims” element of the application was missing, and hence there arises no benefit of the doubt that might be given to the applicant.
- 17 Mr Davis finally referred to two cases of Legal Boards of Appeal of the European Patent Office. The applicable law was the European Patent Convention (EPC), not the PCT. I have to point out here that the wording and presentation of the relevant EPC Article is not the same as Article 11(1) PCT. Article 80(d) EPC requires that the documents contain “a description and one or more claims...even though the description and the claims do not comply with the other requirements of this Convention.” It is notable that the description and the claims are

not separately itemised, and the “which on the face of it appears...” terminology is also missing. Nevertheless I am ready to see whether these EPO cases have anything relevant to say.

- 18 Firstly, *J20/85 OJEPO 3/1987 102* can be quickly dismissed because the appeal was allowed by the EPO on grounds other than the agent’s contention that a consistory clause constituted a claim. Secondly, in *J20/94 OJEPO 4/1996 181* another Legal Board of Appeal decided to refer up to the Enlarged Board of Appeal certain questions all turning on whether a claim might be derived from the description for filing date purposes. Unfortunately the application was withdrawn before the Enlarged Board of Appeal had issued a ruling. Moreover it appears that the description in question did not contain a conventional consistory clause. But Mr Davis pointed out certain passages in the Legal Board’s analysis:

“If no document designated as a claim or claims can be identified however, there must be some indication that some other part of the documentation is intended to be a claim. Nor does it appear to be ruled out a priori that a part of the description can be viewed as a claim, although these two parts of the application serve different purposes which are defined in Article 83 and 84 EPC. While the description is the place for disclosing a reproducible invention, the claims serve to define the subject-matter for which protection is sought. A part cannot therefore be taken arbitrarily from the description and be reinterpreted as a claim. On the contrary, on the date they are filed the application documents must contain information which can be recognised as a subject-matter for which protection is sought.”

- 19 Here the Legal Board of Appeal appeared willing to contemplate looking within the description for a claim. They did indeed consider various possibilities, and said that a likely place to look would be in the general part of the description, but concluded that in the description in suit there was nothing immediately recognisable as a patent claim. The Board further remarked that this requirement of the EPC had to be interpreted in the light of its object and purpose, and the requirement for a claim to be present on the filing date was to speed up the search process. Following this through, Mr Davis observed that in the present case a search examiner would have no difficulty in locating the consistory clause and using it as the basis for a search. He said that the PCT Search Guidelines did indeed enjoin search examiners to consider the description.
- 20 In my view the question whether an application is searchable as filed is in the same category as the question whether an application has a passage defining the matter for which protection is sought: that is, the questions do not help me determine whether claims are present. An application with claims may define scope of protection and be searchable, but the converse does not necessarily follow, ie that an application must have claims if it contains in the description indications as to scope of protection that might be susceptible to a search. Examiners quite often detect discrepancies between consistory clauses and claims, and customarily ask for them to be brought into agreement. This underlines that the two entities are just that, two things, not one. The Legal Board of Appeal in *J20/94* had sufficient difficulty with the issue to refer it up to the Enlarged Board of Appeal, and unfortunately we

have not the benefit of their ruling. But as I noted above, the different drafting of the EPC may give grounds for more flexibility of approach, which it may not be appropriate to carry across to practice under the PCT. In this respect the PCT appears to me to admit of little flexibility, and draconian consequences, to use Mr Davis' phrase, seem inevitable where mistakes and omissions are made.

Conclusions

- 21 Taking all this into account my decision is therefore that this international application did not contain a part which on the face of it appeared to be a claim or claims as at 28 May 2003, and must therefore proceed with a filing date of 2 July 2003 in accordance with the provisions of Article 11(2)(b) PCT, as this was the date that this deficiency was corrected.

Dated this 5th day of November 2003

H J EDWARDS
Deputy Director, acting for the Comptroller

THE PATENT OFFICE