BL O/235/05

26th August 2005

PATENTS ACT 1977

APPLICANT David E Berg et al

ISSUE Whether to allow a correction to patent application number GB 0409405.8 under section 117

HEARING OFFICER B Micklewright

DECISION

Introduction

1 Patent application GB 0409405.8 ("the application") entitled "Method for detecting procoagulant conditions" is the GB national phase application for PCT application PCT/US2002/029796 filed on 19 September 2002 in the joint names of David E Berg, Harold H Harrison and Lois Hill Berg which claimed priority from earlier application US 09966311 ("the priority application") filed in the USA on 28 September 2001. The PCT application was published on 10 April 2003 as WO 03/028627 A2 and entered the national phase in the UK on 28 April 2004. It was subsequently republished as GB 2396915 A.

2 An abbreviated examination report under section 18(3) was issued on 27 May 2004. Dr Stephanie Pilkington of Eric Potter Clarkson ("the agent"), the firm representing the applicant for this application, telephoned the examiner and said that it had been brought to their attention that an incorrect specification had been filed with the international application. Dr Pilkington asked the Examiner whether it would be possible to replace the specification in its entirety with a copy of the priority application US 09966311 and for this replacement to take the form of a correction under section 117. This was followed up by a letter from the agent dated 10 June 2004 which enclosed a copy of the priority application.

3 The Examiner replied in an email on 18 June 2004 stating that such a correction was not possible and added that Rule 100 was also not an option in this case. On 11 October 2004 the agent filed a Form 11/77 and supporting documents requesting replacement of the present specification with the specification of the priority application. Amended claims were also filed in response to the examination report. On 26 November 2004 Mrs. C A Farrington replied to this letter refusing the request to correct the specification and inviting the applicant to request a hearing. The applicant accordingly requested that a hearing be appointed. The matter therefore came before me at a hearing on 6 July 2005, at which the applicant was represented by Mr. James Abrahams of Counsel and Mrs. C A Farrington

attended for the Office.

The law

4 The law concerning corrections of errors in patents and applications is set out in section 117 of the Patents Act 1977 ("the Act"). Section 117(1) sets out the Comptroller's discretion in these matters:

> 117.-(1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

5 Provisions governing such corrections are set out in Rule 91 of the Patents Rules 1995. Rule 91(2) relates to corrections in specifications:

> 91.-(2) Where such a request relates to a specification, no correction shall be made therein unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

Interpretation

6 The Manual of Patent Practice sets out in paragraph 117.07 a two-fold test for the application of Rule 91(2):

> 117.07 No correction may be made in a specification unless the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This is construed as imposing a two-fold test:-
>
> (a) is it clear that there is an error, and
>
> (b) if so, is it clear what is now offered is what was originally intended?

7 At the hearing Mr. Abrahams urged me to focus on the wording of Rule 91 rather than the reformulation above. I agree that I have to decide whether a correction is allowable with regards to the wording of Rule 91. However the test set out in the Manual of Patent Practice has proved useful on many occasions and I will use it to the extent I consider it useful to do so in the present case. At one point in the hearing Mr. Abrahams himself referred to the benefits of considering the issue in two stages.

8 Mr. Abrahams also submitted that the term "obvious" in Rule 91 means obvious to an experienced patent practitioner rather than to a layman. The Manual of Patent Practice states, in paragraph 117.08:

> "the notional addressee of the specification is a person who is reading the document with the intention of extracting all the teaching from it, and who is aware of everything of common knowledge in the art concerned. For example, while a casual reader might

> not realise that the quoted serial number of another patent is incorrect, the notional reader will turn up every reference as he comes to it, and it will then be apparent (if for example the patent apparently referred to relates to completely different subject-matter) that the reference given would not have been intended."

Rule 91(2) uses the term "obvious" to mean "obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered by the correction". I believe that the notional addressee of the specification, as well as having knowledge of the relevant technical art, at least has enough knowledge of patent practice to, for example, recognize references to other patent applications in the specification and look up the contents of any available documents referred to by such references. They would also be able to recognise the various documents on the file and would be aware that a patent specification normally includes a description and a set of claims and perhaps some drawings. This will be sufficient elaboration on the nature of the person to whom the correction is to be obvious for present purposes.

9 On the general scope of rule 117(1) the hearing officer in the case *Klein Schanzlin & Becker AG's application* [1985] RPC 241 made the following comments:

> "I do not accept that the Comptroller has discretion to correct a procedural mistake under the provisions of section 117(1) and rule 91(1). It seems to me that the wording of section 117(1) is such as to leave no doubt that it relates to errors of translation, clerical errors or mistakes *in documents* and not to procedural errors or mistakes in the filing of documents. Irregularities in procedure are dealt with in rule 100."

This seems to me to be a correct analysis of the scope of the discretion provided to the Comptroller by section 117(1) and I agree that the Comptroller does not have discretion to correct procedural errors or mistakes in the filing of documents under the provisions of section 117(1), but is limited to errors *in documents*.

The Applicant's argument

10 Mr. Abrahams argued that it is obvious from a comparison between the specification and the priority application that both documents are part of the same chain of applications but that the priority application is a later document than the specification in that chain.

11 Mr. Abrahams then focused on what was offered as the correction. In this case what is offered as the correction is a document containing all the disclosure of the priority application. He sought to persuade me that it would be immediately obvious that the application was intended to contain all the disclosure of the priority application. Mr. Abrahams then distinguished between the case where a UK application claims priority from an earlier UK application and the present case where a UK application claims priority from a foreign application such as a US application. In the former case Mr. Abrahams took the view that one would normally expect a material difference between the priority application and the later application. But in the latter case Mr. Abrahams claimed that, after filing the priority application, for example in the US, it is purely an administrative matter to file the corresponding application all over the world claiming priority from the initial US application.

Thus in the present case, Mr. Abrahams argued, it is obvious that this is what was intended, that is, to file the priority application as the application.

12 Mr. Abrahams argued that the experienced practitioner, looking at the file for this application, would see that the specification of the application was intended to be some foreign document. The specification should be an existing document which contains all the disclosure of the earlier priority application. The priority application is the only document on file that meets these criteria. Hence it would be obvious to a practitioner what had gone wrong and it would be obvious to him what ought to have happened. Thus this case satisfies the requirements of Rule 91(2) and the correction under section 117 should be allowed. Later on in the hearing Mr. Abrahams expanded on these arguments, arguing that it would be obvious that an existing document, in particular the priority application, rather than a new document was to be used as the specification for the application. To further back up his argument Mr. Abrahams pointed out that the priority application is a very complete document so there is no necessity to have a new document and that there is no other existing document which could form the basis of the application. Mr. Abrahams put it to me that these two factors along with the fact that the priority claim was a cross-border claim rather than a domestic priority claim mean that one could rule out the possibility that a new document would be filed as the specification of the application. He sought to persuade me that these three factors give a high enough degree of confidence to say "Yes, I am satisfied that it is obvious that what was intended was to file an application which used the words of the priority document".

13 In his initial submissions Mr. Abrahams commented that when he referred to "filing an existing document", presumably with reference to his comments on the procedure used when filing applications across the world based on a priority application, he meant filing an existing wording in the UK Patent Office. I asked Mr. Abrahams to expand on these arguments as to whether it was permissible to exchange a document for another document as a correction under section 117, particularly in the light of *Klein Schanzlin & Becker AG*. Mr. Abrahams then sought to persuade me that in the present case it was obvious that the words used were the wrong words and that it was also obvious that what was offered as the correct words were the words originally intended. Mr. Abrahams accepted that section 117 does not include situations where a document was filed instead of another but argued that this was not what had happened in the present case, but that it was a matter of the wrong words being used on the piece of paper.

14 It seemed to me that Mr. Abrahams got confused at one point about exactly when the error had occurred. He seemed to be arguing that the error was made when the PCT application entered the national phase and that the error was that the wrong words had been filed at this point. He stated "The point is what they should have done is filed the document containing the words of the US priority document and not the words of the existing PCT". I explained something of PCT procedures, particularly those relating to national phase entry, to Mr. Abrahams and he, in part at least, reverted to his original argument. Of course, if the applicant had amended the application as it entered the UK national phase by replacing it with the priority application, the application would have included subject matter not present in the application as filed and fallen foul of section 76 of the Act. I believe the point Mr. Abrahams was seeking to make was that it would be obvious to the skilled practitioner that the agent had used the wrong words, namely those from the specification of the PCT

application rather than those from the priority application, and it would be obvious that the words of the priority application were those intended. This argument holds if the error is considered to have been made at the time the PCT application was filed, where the wrong words were taken from the wrong earlier application, and thus I do not believe this confusion harms the applicant's case.

15 I informed Mr. Abrahams that I had read the documents on the file and he did not repeat in depth arguments already made in the various agent's letters. In these letters the agent sought to distinguish this application from *Klein Schanzlin & Becker AG* as in that case no priority application had been filed within the specified period. The agent argued that in the present case a document was filed within the specified period and an application was filed claiming priority from US 09966311 before the end of the one year priority period. The agent also argued that it was clear both from references to the earlier application on page 1 and from the technical content of the priority application and the specification of the application that the specification is clearly an earlier document than the priority application and therefore clearly incorrect. She also argued that it was immediately evident that the specification should instead be the priority application as it is obvious that what was intended is that the specification should relate to the same invention as the priority application and referred to another application from the same applicant to reinforce this argument.

The Patent Office's argument

16 The Patent Office argued that section 117(1) relates to errors *in* documents and not to procedural errors or mistakes in filing documents, citing the case *Klein Schanzlin & Becker AG*. The Office argued that the present request, namely a request to replace the specification of the application with the specification of the priority application, was not an error or mistake in a document but a procedural error or a mistake in filing documents and maintained that, following *Klein Schanzlin & Becker AG*, this error could not be corrected using section 117. The Office added that Rule 100 did not apply in this case and that no other provisions in the PCT or the Act would allow this error to be corrected.

17 The Office also commented on whether, even if this type of correction was allowable, the test of rule 91(2) was satisfied. They accepted the agent's argument in their letter dated 11 October 2004 that it was obvious that there was an error, that is, that the specification of the application was the wrong one, but maintained that it was not obvious that it was the applicant's intention to file the specification of the priority application as the specification of this application.

Assessment

18 Firstly I will consider whether the requested correction satisfies the requirements of rule 91(2). Then I will examine in more general terms whether a correction of the type requested falls within the scope of section 117(1). Although these two issues are inter-related, this seems to me to be a constructive way of approaching this case.

The rule 91(2) test

19 To satisfy Rule 91(2) a correction must be obvious in the sense that it is immediately evident

that nothing else would have been intended than what is offered as the correction. Therefore it has to be immediately evident that there is a mistake. This point was argued by the agent before the examiner and the Office has accepted that it was immediately evident that a mistake had been made. I agree with this finding and will not go into detail on the specifics of the agent's argument.

20 The requested correction then has to satisfy the requirement that it be obvious. The meaning of the term "obvious" in this context should not be confused with other uses of the term in patent law. Rule 91(2) defines "obvious" to mean "immediately evident that nothing else would have been intended than what is offered as the correction" and this is the definition I must apply in the present case. The Office, although accepting that it was immediately evident that there was a mistake in the filing of the specification, disputed that it was immediately evident that it had been intended to file the priority application as the specification. I agree with Mr. Abraham's argument that if the application in suit was a domestic application claiming internal priority from another domestic application from the same State then one would expect the specification to differ from that of the priority application. But I do not agree with the flip side of his argument that if an application claims priority from a foreign application then one would expect the application to be identical to the priority application. It is by no means always the case that when priority is claimed from a foreign application the specification of an application is the same as the priority application and the filing of the later application is not always carried out as merely an administrative action. It is reasonably common for specifications to be different from their priority applications even in cases where foreign priority is claimed. The Convention year is used to refine and perfect inventions, their disclosures, and the claims of an application and this applies as much to international as to domestic filings. Although it may be true that on the balance of probabilities the specification is more likely to be the same as the priority application than to be different, this is not the test Rule 91(2) requires to be satisfied. Rule 91(2) sets out a much higher hurdle that a correction must satisfy, specifically in the present case that it is immediately evident that nothing else was intended other than to file the priority application as the specification.

21 I will now examine the other factors referred to by Mr. Abrahams (see paragraph 12). The first of these factors put to me is that it would be obvious that an existing document rather than a new document was intended to be filed as the specification. The second factor presented to me is that the priority application is a very complete document so that there is no necessity to produce a new document as the basis of the application. In my view it is immediately evident to a notional reader that there was a mistake in the filing of the specification and a notional reader might consider it likely that an existing document, most probably the priority application as the only relevant existing document on file except the specification, should have been filed as the specification. But I do not believe it would be *immediately evident* to the notional reader that nothing else could have been intended than to file an existing document, namely the priority application, as the specification. It may be that a notional reader, after examining the priority application and noting its completeness (in the sense that it has a set of claims and a description related to the set of claims), would think it more likely than not that the intention was to use an existing document as the specification for the application in suit and that the existing document to be used was the priority application. But the notional reader would be aware that it is by no means always the case

that an existing document, in particular the priority application, was used as the specification of an application claiming foreign priority, even if the priority application looked like a complete document.

22 The agents, in their letter dated 7 January 2005, argued that it is obvious that what is intended is that the specification should relate to the same invention as the priority application. This may be the case and this reinforces the argument demonstrating that it was immediately evident that a mistake was made but does not in my view demonstrate that it is immediately evident that nothing else would have been intended than that the specification corresponded to the priority application because, as I have said above, it is sometimes the case that the specification of an application, although broadly relating to the same invention as the priority application, does not have the same words as the priority application. Therefore in conclusion the notional addressee would consider it a real possibility that the specification (or the words in the specification) was not intended to be the same as the priority application (or the words in the priority application) and thus the correction argued for is not obvious in the sense that it is immediately evident that nothing would have been intended other than what is offered as the correction.

Scope of section 117

23 I will now consider in more general terms whether the correction requested in this case is of the type which can be made within the discretion given to the Comptroller by section 117(1), to correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application, subject to the provisions of the rules. The hearing officer in *Klein Schanzlin & Becker AG* stated that section 117(1) applies to errors of translation, clerical errors or mistakes *in documents* and not to procedural errors or mistakes in the filing of documents.

24 The correction requested in this case is, quoting from the Form 11/77, "Replacement of the present specification with the specification of the priority application". I do not agree with Mr. Abrahams that this is merely replacing the words in a document with different words. When the PCT application was filed the wrong document was filed as the specification and the correction requested is to replace this wrong document with what the applicant claims is the correct document, namely the priority application. I believe that this is not a mistake in a document such as the specification but is a mistake in the filing of a document, that is that the wrong document was filed as the specification when the PCT application was filed. Moreover as I have already concluded it is not immediately evident that nothing else could have been intended other than what is offered as the correction. I have already said that I agree with the hearing officer in *Klein Schanzlin & Becker AG* that the wording of section 117(1) relates to errors of translation, clerical errors or mistakes in documents and not to procedural errors or mistakes in the filing of documents. Although the specific circumstances of this case are different from those in *Klein Schanzlin & Becker AG* these limitations of section 117(1) apply more generally and in particular apply in the present case. In my view the mistake was in filing the wrong document as the specification when the PCT application was filed. This was a mistake in the filing of a document and was not a mistake in a document and thus section 117(1) does not give the Comptroller discretion to correct this mistake.

Conclusions

25 In conclusion I do not believe the requested correction would be obvious in the sense that it was immediately evident that nothing else could have been intended than for the words of the specification of the application to be the same as the words of the priority application. Therefore I consider that the requested correction does not satisfy the requirements of Rule 91(2).

26 Moreover in my view the requested correction, namely to replace the specification with the priority application, is not a request to correct a mistake in a document. The mistake made was that the wrong document was filed as the specification. The correction offered, whether it is framed as replacing one document with another or the words in one document with the words in another, is in effect correcting the mistake in filing by substituting the priority application for the specification. It is my view, in accordance with that of the hearing officer in *Klein Schanzlin & Becker AG*, that section 117(1) does not give the Comptroller discretion to allow corrections to mistakes in the filing of documents and therefore does not give the Comptroller discretion to make the correction requested in this case.

27 Therefore I refuse the request to correct the application under section 117(1) by replacing the specification with the specification of the priority application.

Appeal

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

B MICKLEWRIGHT
Senior Legal Adviser acting for the Comptroller