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2006

PATENTS ACT 1977

APPLICANT Fuji Jukogyo Kabushiki Kaisha

ISSUE Whether European patent application
reference number P410819EP was
received by the Patent Office and should
have been accorded a filing date

HEARING OFFICER B Micklewright

DECISION

Background

- 1 It is alleged that a European patent application was filed at the UK Patent Office on 19 December 2003 in the name of Fuji Jukogyo Kabushiki Kaisha. The firm of agents handling the application, W. P. Thompson & Co.'s Liverpool branch, contacted the Patent Office on 12 May 2004 to enquire about the application. It emerged that the Patent Office had no record of having received the application. The agent argued that the application had been lost in the Patent Office and should therefore have been accorded the filing date of 19 December 2003 under the European Patent Convention (EPC). The Office did not accept that the application had been misplaced in the Office and concluded that the application must never have reached the Patent Office. The applicant requested that the matter be reviewed by a senior officer and the matter therefore came before me at a hearing on 13 July 2006. The applicant was represented by Nicholas Manley of W. P. Thompson & Co. and Linda Taylor attended for the Office.

The law

- 2 The UK Patent Office receives European patent applications on behalf of the European Patent Office (EPO) in accordance with Article 75(1)(b) of the European Patent Convention (EPC). Subject to security restrictions, EPC Article 77(2) requires the Patent Office to forward such applications to the EPO within six weeks of filing. If such an application does not reach the EPO before the end of the fourteenth month after filing, or, if priority is claimed, the date of priority, the application is deemed withdrawn in accordance with EPC Article 77(5). When the EPO receives an application forwarded from the authority of a Contracting State in this manner, the EPO is required to inform the applicant accordingly under EPC Rule 24.

The applicant's submissions

- 3 The applicant's case was that their agent has thorough procedures in place for ensuring that new applications are correctly filed and that these procedures were correctly followed in the case of the application in suit. Their contention is therefore that this application was received at the Patent Office and must have been misplaced within the Patent Office. The applicant provided evidence relating to W. P. Thompson & Co.'s internal administrative procedures concerned with ensuring that the correct documents are sent to their correct destinations. Mr. Manley's witness statement dated 7 June 2005 states that the following procedure is used at his Liverpool Office for filing all new patent applications:
- a) On the intended day of dispatch of a new application, details of the new application to be filed are written on a pre-printed master record sheet. The record sheet is retained on a heavy wooden block (known as "the block") so that the master list (known as the "block sheet", an example provided as EXHIBIT NMM1) can be easily located.
 - b) When the documents for filing a new application have been prepared they are passed to a member of the records department who collates the documents and takes the collated documents, together with the file for the new application and the block sheet secured to the block, to the fee earner responsible for the case. The fee earner checks the collated documents and, if satisfied that they are correct, initials the block sheet in the extreme right-hand column.
 - c) The documents for each new application are then taken to a large table within the records department which is cleared of other documents or files other than those relating to new applications to be dispatched.
 - d) The documents for each new application are then re-checked by a qualified Chartered Patent Attorney, European Patent Attorney or Registered Trade Mark Agent (as appropriate), with the proviso that the re-checking is carried out by a person different from the person who has previously checked the documents for that case. The re-checking for a European patent application also includes a check that a copy of the application documents has been retained in the file and that the relevant fees have been paid, and also identifies any documents to be filed subsequently. If the person re-checking the documents is satisfied that the documents are correct then he or she fills in the details on the front of the case file and signs and initials the file to confirm that everything is in order (EXHIBIT NMM2 is a sample of such a file). He or she also initials the relevant entry in the block sheet in the left-hand column. This re-checking takes place in front of a member of the records staff who cross-checks the details entered on the block sheet against information relating to the new

application read out from the documents to be filed by the person carrying out the re-checking.

- e) As the documents for each case are re-checked, the person who has re-checked the documents ensures that they are placed in the relevant envelope which is then subsequently placed in the relevant courier flyer.
- f) Two different envelopes are used for new applications to be filed at the Patent Office. Items for which a fee is payable are included in an envelope addressed to The Cashier and are additionally listed in an internal forms book. If there are no fees payable, details of the case are listed in a separate list and are placed in an envelope addressed to The Comptroller. The two envelopes are then placed inside a courier flyer which is immediately sealed and taken to the reception area for collection.
- g) On the first working day after dispatch of mail to the Patent Office, a member of the records staff checks with the courier firm and with the Patent Office that safe delivery of the courier flyer has taken place. Details of the courier confirmation number and details of the telephone call with the Patent Office are then written by hand in the top right-hand corner of the previous day's block sheet.

4 Mr. Manley then addressed in his witness statement how these procedures were followed for the application in suit. He attached with his witness statement a copy of the block sheet for 18 December 2003, the date the application in suit was allegedly dispatched. The sheet has on it an entry in the name of "FUJI JUKOGYO KABUSHIKI KAISHA", described as a "EURO/UC" application and assigned the job number "P410819EP". The sheet is initialed "NMM" in the right-hand column in accordance with step b above. Mr. Manley indicated that these were his initials. The sheet is also initialed "TLB" in the right-hand column. Mr. Manley indicated that these are the initials of his partner Dr. Thomas Louis Brand, a Chartered Patent Attorney, European Patent Attorney and Registered Trade Mark Agent who, Mr. Manley states, re-checked the documents for filing in accordance with step d above. The block sheet also includes a hand-written note comprising a courier reference number and the expression "PO:STACY:19/12/03:2.20", presumably relating to a telephone call to the Patent Office confirming that the package had been received in accordance with step g above.

5 Mr. Manley also included a copy of the front cover of the file of the application in suit with his witness statement which was also initialed by Dr. Brand (see step d above). Copies of the documents which Mr. Manley claims are those re-checked by Dr. Brand were also included with the witness statement. A copy of the internal list of items placed in the envelope addressed to The Comptroller is also included as an Exhibit. This list includes an entry with the same details as those referred to above in relation to the block sheet and is initialed "CJM" which Mr. Manley indicates are the initials of Carl Mott, an experienced member of the records department in his company's Liverpool Office (see step f). Mr. Manley included a copy of the flyer shipment document for the items

dispatched on 18 December 2003 and a copy of the online tracking of the shipment. Both documents have the same reference number as that written on the block sheet. Also included was a copy of a Patent Office fee acknowledgement sheet dated 19 December 2003 and listing five fee-bearing items.

- 6 At the hearing Mr. Manley asserted that all the procedures he had outlined had been followed in this case. He commented that the evidence should be weighed on the balance of probabilities and argued that on the balance of probabilities it was more likely than not that the documents relating to the application in suit were correctly received in the Patent Office but had somehow been misplaced in the Patent Office. To reinforce this argument he commented that documents do get lost from time to time in the Patent Office and he referred to an instance where an entire file was lost by the Patent Office and he was asked to help recreate the contents of the file. He also mentioned in general terms other occasions where documents the Patent Office accepted had been filed (there was a filing receipt) had been misplaced within the Office and his firm had been asked to file another copy of the misplaced documents. Mr. Manley also speculated at the hearing that there could have been complications due to the documents relating to the application in suit being filed just before Christmas, with staff trying to get things ready for the break.
- 7 I questioned Mr. Manley further concerning steps e, f and g above. Due to a misunderstanding in some communications prior to the hearing it appears that Mr. Manley's understanding was that I had already accepted that all the procedures set out in steps a to g had been followed in the present case. He had therefore not brought with him to the hearing the records clerk who actually carried out the work. Although Mr. Manley was able to make some general points on steps e, f and g at the hearing, I gave Mr. Manley an opportunity to file witness statements from the relevant people after the hearing, which he subsequently did. Witness statements were filed subsequent to the hearing by Dr. Thomas Louis Brand, the Attorney who had been the independent checker in the present case, and Mr. Carl Mott, the member of the records department who had handled the present case. Both witness statements confirmed the comments made by Mr. Manley at the hearing that the Attorney carrying out the independent checking not only checks that the documents are placed in the relevant envelope (step e above) but also checks that the envelope is placed in the relevant flyer and that the flyer is sealed. This was not evident from Mr. Manley's original witness statement and is a useful clarification.

The Patent Office's case

- 8 Before setting out the Patent Office's case it is useful to list to the documents which the applicant claims were in the courier package dispatched to the Patent Office on 18 December 2003. The applicant claims that there were two envelopes in the package. The first was addressed to The Cashier and the Patent Office issued a fee sheet acknowledgement for five fee-related documents received from W.P. Thompson & Co's Liverpool Office on 19 December 2003. The second envelope was addressed to The Comptroller

and, it was claimed, contained the following documents:

- An EP application in the name of Fuji Jukogyo Kabushiki Kaisha (the application in suit), reference P410819EP
- A letter relating to PCT/GB2003/004393, reference P407639 WO
- A letter relating to PCT/GB2003/004279, reference P408206 WO
- A letter with reference G02390GB relating to a hearing.

This list of documents corresponds to the agent's internal list of items placed in the envelope addressed to the Comptroller in accordance with step f above.

- 9 The Patent Office's case was that, whilst their records confirmed that the courier package corresponding to the consignment number indicated in Mr. Manley's witness statement was received at the Patent Office on 19 December 2003 and that a number of fee-related documents, presumably those contained in the envelope addressed to The Cashier, were received, there was no record of the Patent Office receiving any of the documents which Mr. Manley claims were in the second envelope addressed to The Comptroller. This includes in particular the European patent application in suit.
- 10 W. P. Thompson contacted the Office five months later, on 12 May 2004, enquiring about the EP application. A very thorough search was conducted in all areas involved but no trace of any of the documents from the second envelope was found, including the missing application. Areas searched included all of Document Reception for unopened mail and EPC Section's records, shelves and desks for the missing application. Areas connected with the other missing documents were also checked to see if any of those documents had been received. None of the documents were found.
- 11 The Patent Office therefore considered that on the balance of probabilities the Patent Office did not receive any of the documents relating to the above EP application.

Analysis

- 12 I agree with Mr. Manley that I need decide on the balance of probabilities where it is more likely that the envelope and its contents were misplaced. The records of both the Patent Office and W. P. Thompson & Co's Liverpool Office indicate that the courier flyer was received by the Patent Office on 19 December 2003. The Patent Office also has records of receiving fee-related documents from the agent on that date. The Patent Office does not however have records of receiving any of the four non-fee bearing documents allegedly included in a second envelope addressed to The Comptroller in the same flyer, one of these documents being the application in suit. It appears to me that there are three realistic possibilities as to what happened to this envelope:
 - a) The envelope was lost in W. P Thompson's Liverpool Office and was never included in the flyer.

- b) The envelope was mislaid in the Patent Office once the flyer had been opened.
- c) The flyer was opened and the envelope lost in transit.

I believe that option c is the most unlikely. Although I am aware that from time to time a package may be damaged or fall open in transit, there was nothing to indicate that the flyer arrived at the Patent Office in a damaged state. I am therefore left with two possibilities, namely that either the envelope was lost in W. P. Thompson's Liverpool Office or that the envelope was lost in the Patent Office.

- 13 The evidence provided by Mr. Manley in his witness statement and the associated exhibits suggests immediately to me that the application in suit successfully passed through steps a to d and f above. I am therefore satisfied that the application in suit was placed in an envelope addressed to the Comptroller. In general, my view based on the evidence is that the procedures that the agent has in place are thorough and provide a number of checks to ensure that the correct documents are posted on the correct date and to the correct place. The evidence is less clear though on what happens to the envelope once the documents have been placed in it. From Mr. Manley's original statement, there appeared to be no written indication on the block sheet or anywhere else to confirm that the envelope was placed in the flyer. However Dr. Brand and Mr. Motts' witness statements suggest that, as part of the re-checking procedure of steps d and e above, the re-checker (in this case Dr. Brand) does indeed check that the envelope is placed in the courier flyer and the flyer sealed. If however the envelope was indeed lost in the agent's office, it appears to me that this is the most likely point that something went wrong. The fact that the whole envelope appears to have been lost reduces the likelihood that the EP application in suit was lost prior to that point.
- 14 Another factor is that this case highlighted a weakness in the agent's post-filing checking procedure, namely that they check only that the flyer has been received and do not check that the individual documents have been received. It was not until nearly five months later that they contacted the Patent Office to check if the documents relating to the application in suit had been received. I understand that following this case the agents have changed their procedures. That said, the agents did have some form of post-filing checking procedure in place which, Mr. Manley claims, had never failed them in the past. Moreover, even though this may have been a weakness in the agent's procedures, the evidence indicates that this procedure was followed in the present case and therefore I do not attach a great deal of weight to this factor as there is no corresponding weakness in the pre-filing procedures set out in steps a to g above.
- 15 It is useful to explain the course the envelope would have taken in the Patent Office had it been received. The flyer would have been opened in Document Reception, the two envelopes removed and opened, and the documents within the two envelopes forwarded to the relevant sections of the Patent Office. I note that the documents supposedly in the flyer addressed to The Comptroller were destined for various sections of the Patent Office. It is my view therefore

that if the envelope had been mislaid in the Patent Office, the most likely place where it could have been mislaid was in Document Reception. Otherwise one would have expected at least one of the documents to have found its way to its destination.

- 16 It is certainly the case that, from time to time, documents are misplaced in the Patent Office. In this case, though, the fact that the whole envelope appears to have gone missing does reduce the likelihood of the application in suit being misplaced within the Patent Office as, as I have already said, it reduces the number of places where the application could have been misplaced.
- 17 This case is finally balanced. Both W. P Thompson's office and the Patent Office have thorough procedures in place to ensure that documents are correctly handled. The fact that a whole envelope appears to have been misplaced reduces the likelihood that either something went wrong with W. P. Thompson's procedures in this case or that the Patent Office misplaced the application in suit. But one thing which is clear is that something went wrong somewhere and my task is to decide on the balance of probabilities where it is more likely that something went wrong.
- 18 I have examined carefully the evidence provided by the applicant and have come to the conclusion that, on the balance of probabilities, it is more likely that the envelope was misplaced in the Patent Office than in W. P. Thompson's Liverpool Office. This conclusion is based on the documentary evidence provided by W. P. Thompson that the application successfully passed through their procedures put in place for filing new applications. It is also based on the fact that, although I consider it unlikely that an envelope such as the one in question here, or the entire contents of such an envelope, would be misplaced in the Patent Office, it is the case that from time to time documents are misplaced in the Patent Office, and, weighing all the evidence, this appears to be the least unlikely possibility.

Conclusion

- 19 I therefore conclude that, on the balance of probabilities, the application in suit arrived at the Patent Office on 19 December 2003 but was then misplaced within the Patent Office. The application in suit was therefore received by the Patent Office on that date and should therefore have been given as its filing date the 19 December 2003.
- 20 Mr. Manley referred at the hearing to the possibility of filing for conversion to a national application under section 81 of the Patents Act 1977. Should the applicant wish to pursue this possibility, I suggest they take this matter up with the Patent Office.

B MICKLEWRIGHT

Senior Legal Adviser acting for the Comptroller