

PATENTS ACT 1977

APPLICANT John Michael Gordon

ISSUE Whether a request to restore the right of
priority on PCT international application
number GB2007/003189 under PCT
Rule 26*bis*.3 should be allowed

HEARING OFFICER B Micklewright

DECISION

Introduction

- 1 International application GB2007/003189 (“the PCT application”) was filed on 21 August 2007 in the name of John Michael Gordon at the UK Intellectual Property Office acting as receiving Office under the Patent Cooperation Treaty (PCT). The PCT Request (form PCT/RO/101) filed on that date claimed priority from, amongst other applications, GB application GB0612262.6 (“the earlier application”) which had a filing date of 21 June 2006. Thus the PCT application was filed 14 months after the filing date of the earlier application. The PCT Request also included a request that the receiving Office restore the right of priority arising from this earlier application. The other applications from which priority were claimed had filing dates less than twelve months before the date of filing of the PCT application.
- 2 Mr. Gordon, the applicant, provided a statement dated 26 September 2007 supporting his request to restore the right of the priority. The Office considered this statement and was minded to refuse the request to restore the right of priority on the grounds that the failure to file the international application within the priority period was not unintentional. Mr. Gordon requested a review of this decision and the matter therefore came before me at a hearing on 2 November 2007 in which Mr. Gordon attended along with his representative Mr. Neville Walker. Mr. Jones and Mr. Rees attended on behalf of the Office.

The Law

- 3 Article 4 of the Paris Convention specifies a twelve month priority period for

patent applications, in which patent applications may be filed in countries which are members of the Paris Convention within twelve months of one or more earlier applications and may claim priority from those earlier applications.

- 4 Article 13(2) of the Patent Law Treaty (PLT) introduced a limited set of circumstances where the right of priority could be restored if an application failed to be filed within the twelve month priority period. These provisions have been implemented into the PCT Regulations through amendments which came into force on 1 April 2007. In particular PCT Rule 26*bis*.3 states:

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.

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

Applicant’s arguments

6 Mr. Gordon said in his statement that around the time of the twelve month deadline for filing his PCT application he was very busy. He was abroad in the USA shortly before the deadline pursuing his business activities and then came back to the UK to a large amount of follow-up work. In the light of this he failed to file the PCT application by the deadline of 21 June 2007. In a letter dated 21 August 2007 Mr. Gordon’s agent Mr. Walker indicated that he failed to file the application because he forgot to do so. Once he became aware that it was possible to make a request to restore the right of priority, he asked his agent to pursue this course.

7 At the hearing itself Mr. Walker started his oral submissions on behalf of Mr. Gordon with a brief discussion of PCT Rule 26*bis*.3. He commented that in his opinion Mr. Gordon satisfied both the “unintentional” and the “due care” criteria but concentrated for the purposes of this hearing on the unintentional test. He then showed me some entries in Mr. Gordon’s diary which related to the earlier application in question. The diary includes a day planner, a month planner and a year planner. Each of these three planners has, in the entry for 21 June 2007, a reference to “KlenzPod filing” which, Mr. Walker informed me, relates to this particular priority application. He had entered these into an earlier diary when he had received the filing receipt for the earlier application in question, and then copied them over into his new diary. These entries, Mr. Walker submitted, demonstrate that Mr. Gordon was aware that he had to do something in relation to this priority application on that date. He submitted that these entries demonstrate that Mr. Walker had an intention to do something in relation to this application before the end of the priority period.

8 Mr. Walker then turned to the circumstances surrounding why nothing was actually done and referred to Mr. Gordon’s written statement in this context. He was busy and traveling in making efforts to commercialise his invention. Mr. Walker then referred to a meeting he had with Mr. Gordon on 2 August 2007 in relation to a number of earlier applications. Mr. Walker described the meeting as challenging and indicated that it went on for several hours due to the numbers of files involved and detailed analysis of prior art cited on six or seven patent applications. During the meeting it became apparent that the 21 June 2007 deadline for filing applications claiming priority from the earlier application in question in this hearing had already passed. Mr. Walker mentioned this to Mr. Gordon at the meeting. Mr. Walker said that “the colour drained from his [Mr. Gordon’s] cheeks” when he was given this information. Mr. Gordon responded at the meeting by saying that he had been away and that it was always his intention to file but obviously something had gone wrong.

9 Mr. Gordon then said that after he had had this meeting he realised that he hadn’t attended to this application. He had been so busy in the United States and then with follow-up actions and market research that he simply forgot to file the PCT

application. He was doing all this himself and this application slipped through the cracks. His failure to file it was genuinely unintentional.

- 10 I asked Mr. Walker and Mr. Gordon what their filing strategy was in relation to the invention covered by the priority application. Mr. Gordon replied stating that he had planned to file UK applications, see the examination results of these applications, and then have a licensee take over the burden and expense of taking things forward. He did not however have a solid agreement with a potential licensee in place at the time and therefore intended to file the PCT application himself. But this particular application slipped through the net. He pointed out that he was a lone inventor, proprietor of the business and administrator and did everything he could to remind himself. Unfortunately something still went wrong, due to his busyness at the time.
- 11 Mr. Walker concluded by arguing that their submissions had demonstrated that the requirements of PCT Rule 26*bis*.1 had been met. The failure to file the international application within the twelve month period was unintentional.

Office's arguments

- 12 The Office had taken the view that they were minded to refuse the request for restoration of the right of priority because there was no evidence of an error which resulted in Mr. Gordon missing the deadline. Moreover he had given no reasons as to why he had not filed the PCT application sooner. On the basis of the evidence filed the Office therefore came to the preliminary view that the failure to file the international application within twelve months was not unintentional. The Office did not of course have the benefit of hearing the oral submissions made at the hearing when coming to this preliminary view.

Assessment

- 13 In this decision I will decide only whether Mr. Gordon's failure to file the international application in suit within the twelve month priority period was unintentional. I will make no decision on whether this failure to file occurred in spite of due care required by the circumstances having been taken, as the UK-IPO acting as receiving Office does not apply this criterion.
- 14 I first need to confirm that the request for restoration of the right of priority was made within time, that is, within the two month period from the date on which the priority period expired, as is required by PCT Rule 26*bis*.3(e). The request for restoration of the right of priority was in this case made at the same time as the filing of the international application, on 21 August 2007. This is exactly two months from the date on which the priority period expired. The request was therefore made in time.
- 15 I will now turn to whether the failure to file the international application within the twelve month priority period was unintentional, as is required by PCT Rule 26*bis*.3(a)(ii). I accept from the diary entries and the submissions made by Mr. Walker and Mr. Gordon in relation to these diary entries that Mr. Gordon did at some time have an intention to file the international application within the twelve month period. Moreover I accept that he was busy with activities relating to the

commercialisation of the invention during this twelve month period, with the hope that he would be able to find a licensee to take over the management of patent applications for this invention. I thus believe that it was reasonable for Mr. Gordon to leave the filing of these applications to later on in the priority period. This is in any case a common practice amongst patent applicants.

- 16 The question I now have to answer is what the intentions of Mr. Gordon were around the time that the priority period expired. It is useful to look at what caused the failure to file the PCT application in suit within the twelve month priority period. I accept that this was a busy period for Mr. Gordon. Moreover I note that he had hoped to get a licensee in place by this time to take forward the filing and prosecution of further patent applications in relation to the "KlenzPod" invention. Mr. Gordon assured me at the hearing that he always intended to file the PCT application within the twelve month period but something went wrong and he forgot. Given that he was not able to follow his normal practice in asking the licensee to take on further filing and prosecution of patent applications relating to this invention, this seems reasonable. Furthermore I note from Mr. Walker's recollection of the 2 August 2007 meeting Mr. Gordon's concerned reaction when he realised that he had missed the deadline for filing the PCT application and claiming priority from the earlier application. I therefore believe that on the balance of probabilities Mr. Gordon intended to file the PCT application in suit within the twelve month priority period which expired on 21 June 2007 but, due to his circumstances at the time and his failure at the time to secure a licensee who would have taken on further filing and prosecution of the relevant patent applications including the PCT application in question, unintentionally failed to do so. The failure to do so was therefore unintentional.

Conclusion

- 17 I thus conclude that Mr. Gordon's failure to file PCT application GB2007/003189 within the twelve month priority period arising from the earlier application GB0612262.6 was unintentional. I therefore allow his request to restore the right of priority in relation to these applications on the grounds that this failure was unintentional, in accordance with PCT Rule 26*bis*.3(a)(ii).
- 18 I make no decision or comment on whether this failure occurred in spite of due care required by the circumstances having been taken, the criterion specified in PCT Rule 26*bis*.3(a)(i).

B MICKLEWRIGHT

Senior Legal Advisor acting for the Comptroller