



23 January 2009

PATENT CO-OPERATION TREATY

APPLICANTS Philip Jones et al

ISSUE Whether to allow a request to restore the right of priority on international patent application PCT/GB2008/050757 under PCT rule 26*bis*.3

HEARING OFFICER J E Porter

Introduction

- 1 International patent application PCT/GB2008/050757 entitled “Club Alert” was filed on 29 August 2008 at the Intellectual Property Office, acting in its capacity as a receiving Office under the Patent Co-operation Treaty (“PCT”). The applicants are Mr Philip Jones, Ms Kimberley Jones and Mr John Walker.
- 2 The PCT Request form filed on that date indicated that priority was to be claimed from an earlier British patent application, namely GB0712915.8 filed on 2 July 2007. Since the PCT application was filed just less than 14 months after the filing date of this earlier application, the PCT form included a request that the receiving Office restore the right of priority arising from the earlier application.
- 3 The Office considered argument and evidence which was provided by one of the applicants, Mr Jones, during subsequent correspondence and came to the view on 12 November 2008 that it was minded to refuse the request.
- 4 Mr Jones requested a review of this conclusion by a senior officer without a hearing and so it falls to me to decide, from the papers on file, whether to allow the request to restore the right of priority to the earlier application.

The law

- 5 Article 4 of the Paris Convention specifies a twelve month priority period for patent applications. This means that a patent application may be filed, in a country which is a member of that Convention, within twelve months of an earlier application for the same invention in any such country, and may then claim priority from that earlier application – with the effect that the date of filing of the later application is taken to be the date of filing of the earlier one.

- 6 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 such application failed to be filed within the twelve month period. As far as the PCT is concerned, these provisions were implemented by amendment to the PCT Regulations, and 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.

...

- 7 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.

Arguments and analysis

- 8 As noted earlier, the applicants made the request for restoration of the right of priority on filing the international application on 29 August 2008. This was followed by information in support of that request from Mr Jones, received on 29 September 2008. In response to requests from the Office he filed further evidence and arguments, which were received on 7 October, 31 October and 26 November 2008.
- 9 The evidence and arguments centre around Mr Jones' actions in preparing the international application; the other applicants appear not to have been involved in this process. Mr Jones argues that the failure to file the international application within the priority period was due to a combination of several reasons.
- 10 The first reason concerned the PCT software which Mr Jones downloaded on 7 and 8 January 2008 in order to file the application electronically. Mr Jones explains that he started to complete the details required, but when he came to attach the drawings the software rejected them because they contained "embedded fonts" and were not in black and white. He therefore needed to obtain some further software to rectify these problems, and the evidence shows that he obtained that software on 25 June 2008.
- 11 The second reason is that a holiday, booked in advance, intervened at a time when he was attempting to sort out these problems. The evidence shows that the holiday took place from 30 April to 7 May 2008.
- 12 The third reason is that Mr Jones says he "mistakenly trusted [the PCT software] to provide me with feedback and validation of the quality of my input". Or, as he puts it in a later letter, "I mistakenly expected the software to validate and inform me along the way". He explains that "By trusting the software to do the job for me I didn't spend as much time as maybe I should have in reading the conditions and notes". He therefore argues that "My only mistake in this whole process was to trust the software and not read the PCT guidance more thoroughly, therefore not realising that the deadline existed for the priority to be taken".
- 13 The fourth reason is that Mr Jones explained he is a busy IT consultant, and was very much occupied with new clients at the relevant time.
- 14 The Office's preliminary view of the matter is set out in its communication of 12 November 2008. The case officer accepted that the evidence from Mr Jones demonstrates that the software necessary to solve the problem with the drawings was downloaded on 25 June 2008, but stated that it is not possible to determine that the failure to file the application after this date, and before the priority deadline of 2 July 2008, was unintentional. He also remarked that it is not clear why there was a delay in filing the application until 29 August 2008.
- 15 The condition which must be satisfied if a request for restoration of the right of priority is to be allowed is that which is set out in PCT rule 26bis3(a)(ii). In other words, in order to allow such a request I must be satisfied, on the basis of the evidence that has been provided, that the failure to file the international application within the priority period was unintentional.

- 16 What, then, does the material that Mr Jones has supplied demonstrate with respect to his intentions during the relevant period?
- 17 Mr Jones clearly had difficulties with the PCT software, and in getting the drawings in the right format – and I have some sympathy for him as a result. So I accept that the problems he encountered with the software were a factor which may have had an influence on the eventual date of filing of the international application.
- 18 But there is nothing in Mr Jones’ evidence which states, or even hints, that he intended to solve these problems in order to meet the priority deadline, or that the further software he downloaded was acquired in late June because the priority deadline was approaching. There is a brief statement, made in general terms, about how busy Mr Jones was as an IT consultant but there is no specific evidence as to why – having downloaded this further software in late June – Mr Jones was not able to file the international application until late August.
- 19 Neither is any specific explanation given as to why he did not explore other routes for filing the application once the problems with electronic filing had been encountered. Mr Jones simply states that, as someone who worked in the field of IT, electronic filing of the application was “an obvious choice”.
- 20 Turning to the matter of the holiday, I find it hard to be persuaded on the evidence provided that this was a material factor in the delay in filing the international application. It amounted to a period of 8 days and so was significantly shorter than the period by which the international application missed the priority deadline. It also comprised only a very small proportion out of the 8 month period over which it appears Mr Jones was working towards the filing of the international application.
- 21 But even if I am wrong about this and the holiday did – in some significant way which has not been explained – influence the eventual date of filing of the international application, that does not help me any further in establishing Mr Jones’ intention as regards the priority period.
- 22 I then turn to Mr Jones’ brief evidence in respect of his expectations of the PCT software and his consequent reliance on it to “validate and inform” him about the process. He does not give any detail about what exactly he expected from the software – the nature of the information he expected or how he expected it might have been delivered to him. It is therefore not clear to me whether Mr Jones expected the software to warn him, prior to him filing the international application, that the priority deadline was imminent – or whether he expected the software simply to provide information about deadlines and other matters once the filing had been made. What is clear is that, because of his mistaken expectations in respect of the software, Mr Jones did not read the PCT guidance in sufficient detail and was not aware of the deadline set by the priority period.
- 23 It seems to me, then, that the evidence when taken as a whole does not point to any intention to file within the priority period. On the contrary, during the time that he was preparing the international application, Mr Jones was not aware of an impending deadline at all. Therefore, based on his understanding of the PCT

system at the time, he took the decision to file the international application at an unspecified point, when he had solved the outstanding difficulties with electronic filing – even if that meant further delays. He therefore worked to address the problems that he faced in order to do achieve this outcome.

- 24 With other demands also being made on his time, he took the decision to prioritise the outstanding work on the application in accordance with his understanding of the PCT system. He gave it the urgency which he thought appropriate at the time – a fact which is illustrated by his decision not to explore the options for filing the application another way, and his decision not to resolve with more urgency the problems with the drawings. This was, with hindsight, a decision that was based on a misunderstanding of the PCT system, but in my view it was a decision nonetheless.
- 25 The result of his decision to progress the application in that way was that it was filed after 2 July 2008. It follows that it cannot in my view be said that there was an unintentional failure to file the application before 2 July 2008 – the date that the priority period expired.
- 26 It is of course entirely possible that, had Mr Jones realised the deadline existed, he would have prioritised matters differently or explored other means of filing the application sooner. But speculating about what he might have done in different circumstances does not help establish the point I must decide – namely, to discern his actual intention in the circumstances as they stood. I have already concluded on the evidence that he intended to file the international application when he was ready to do so, and not within a particular deadline. Whether or not in different circumstances he would have acted differently, or at least had intentions to act differently, is not the matter I must decide.
- 27 Finally, it may be deduced from the evidence that Mr Jones was intending to claim priority from the earlier British application, and he thought that he could do so at any time. The consequence of the failure to file the international application by 2 July 2008 was non-compliance with the regime for claiming priority and an inability to make the intended priority claim. The fact that this consequence was not the intended one does not mean that the failure to file the application by 2 July 2008 was also unintentional.
- 28 I derive support for this approach from the judgment of Pumfrey J in *Anning's Application*¹, in which the court considered (in a different context) the “unintentional” test and the distinction between an unintentional failure to do something and an unintended consequence of that failure. The court was clear that the test is not concerned with looking at the unintentionality of a consequence which follows from the failure to do the required thing, but is solely about the unintentionality of the failure to do the thing itself.

Conclusion

- 29 I conclude that the request to restore the right of priority on international patent application PCT/GB2008/050757 under PCT rule 26bis.3 must be refused.

¹ *Anning's Application* [2007] EWHC 2770 (Pat)

- 30 Since the UK 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 made 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 J E PORTER

Deputy Director acting for the Intellectual Property Office in its capacity as a receiving Office under the PCT