

## **PATENTS ACT 1977**

### **IN THE MATTER OF**

Patent Application Number GB9718771.0

in the name of Spectra-Tech Inc

### **DECISION**

#### **Introduction**

1. International patent application number PCT/US96/03012 in the name of Spectra-Tech Inc and entitled "infrared microspectrometer accessory" was published on 12 September 1996 as WO 96/27784. On 5 September 1997, on filing of Patents Form NP1 accompanied by Forms 9/77 and 10/77 and their respective fees, the application entered the national phase as GB9718771.0. It was re-published on 3 December 1997 as GB2313665A. In a letter dated 6 January 1998 the applicant's agents, Withers & Rogers, wrote to withdraw the application and to request a refund of the search and examination fees. The Office acted on this letter and termination of the application was recorded in the Register of Patents on 16 January 1998.

2. On 23 January, the agent, Dr K Barnfather of Withers & Rogers, initially telephoned the Office to revoke the withdrawal request but was advised that the wording of section 14(9) of the Patents Act 1977 ("the Act") did not allow this. By a faxed letter on the same day he confirmed his wish to cancel the earlier requests so enabling the application to continue. In a further letter of 26 January he submitted supporting observations on three counts. First, he argued that the original request was conditional on the discretionary refund of search and examination fees by the Office, which condition had not been fulfilled. Secondly, he contended that the request of 23 January to cancel the withdrawal was by way of correction under rule 91 of an error in the letter of 6 January arising from a letter from a US associate which should have referred to a Hong Kong registration. Thirdly, he suggested that since publication of the withdrawal in the Official Journal (Patents) had not yet taken place, it was not a matter of official record to any third parties, who could in any case be alerted to events by the publication of a notice.

3. The Office replied by letter on 28 January 1998, quoting section 14(9) that any withdrawal of an application may not be revoked, stating that the letter of withdrawal was unequivocal, not conditional on any action on the part of the Office including the payment of a refund, and maintaining that the Register correctly reflected the application's status as terminated. The letter further argued that the general provision of section 117, pursuant to which rule 91 is made, could not be used to circumvent the mandatory provision of section 14(9). The Hearing Officer's decision in *Moskovsky Nauchno-Issledovatel'sky Institut Mikrokhirurgii Glaza* (unreported, O/5/88) was cited in support. The agent was invited to file Form 11/77 and sworn evidence if he wished to pursue the request for correction, and in the meantime the refund of the fees accompanying Forms 9/77 and 10/77 would be suspended. On 11 February 1998 the application was advertised as terminated in the Official Journal (Patents).

4. On 2 March 1998, Dr Barnfather filed Form 11/77 and a supporting statement and papers and, following an official letter seeking clarification, on 31 March he filed a further letter with a statutory declaration by him and exhibits. In a letter of 9 April the Office responded to the points made by the agent but maintained its earlier position, concluding that section 117(1) cannot be used to override the specific provisions of section 14(9) and that the application must remain withdrawn. A hearing was offered by the Office and requested by the agent. The matter therefore came before me at a hearing on 1 July 1998, at which Dr Barnfather, accompanied by Mr J Jones of Withers & Rogers, appeared as agent for the applicant, and Mrs H Thewlis also attended on behalf of the Office. At the hearing I also had the benefit of skeleton arguments filed by Dr Barnfather shortly beforehand and on which he based his oral submissions.

### **The withdrawal request**

5. I need first to consider the contents of the original letter taken by the Office to be one of withdrawal. As I have said, it was dated 6 January 1998 and it read:

**"UK Patent Application No. 9718771.0  
Infrared Microspectrometer Accessory  
Spectra-Tech Inc**

We write to withdraw the above referenced UK patent application No. 9718771.0 and to request a refund of the search and examinations fees.

We look forward to receiving a refund in due course."

6. On a plain reading it seems to me that this letter is clear and unequivocal: it requests withdrawal of the application and a refund of the search and examination fees, receipt of which is expected in due course. The letter appears on its face to contain no apparent errors nor does its phrasing suggest the merest doubt as to the applicant's intentions. It gives every appearance of being a routine request, indistinguishable from other standard withdrawal requests, and not surprisingly the Office treated it as such.

7. At the hearing Dr Barnfather said that he believed that the Patent Office should be able to infer from the wording of this letter of 6 January 1998 that the request for withdrawal of application no GB9718771.0 was conditional on a refund of the search and examination fees. His argument continued that since the refund of those fees had not taken place, there had been no effective withdrawal. He drew an analogy with decision J11/80 of the European Patent Office ("EPO") Legal Board of Appeal. In doing so, he drew my attention to section 91(1) of the Act, which requires judicial notice to be taken of the decisions and opinions of relevant convention courts.

8. I have some difficulty with Dr Barnfather's contention that the withdrawal requested in his letter of 6 January was conditional on the repayment of fees. It does not explicitly say, for example, that the withdrawal was requested "on condition that the refund is paid". Neither do I think the most careful or cautious reader would infer such a condition. Indeed, insofar as the second paragraph of the letter speaks of looking forward to receiving a refund "in due course", it might be reasonable to infer that a refund was not expected immediately. No connection between the action to be taken by the Office to effect the requested withdrawal and the action to be taken by the Office to effect the requested refund is suggested to me by the wording of the letter.

9. Dr Barnfather further contended that on the basis of equity it is reasonable that the applicant, having requested withdrawal and a refund of fees, should receive fair treatment in obtaining both elements of the request contemporaneously. Office policy on refunds is clear and longstanding. As stated in paragraph 14.207 of the Office's *Manual of Patent Practice*:

"If an application in respect of which Form 9/77 or 10/77 has been filed is withdrawn before the report under s.17 or s.18 respectively is issued, the fee paid may be refunded (notice in the Official Journal, 15 October 1980). Such a refund is however a matter of discretion and not a right."

The relevant part of that Official Journal notice reads:

"Applicants for patents and their agents are further advised that the fee paid on Form 9/77 (Request for Preliminary Examination and Search) or Form 10/77 (Request for Substantive Examination) filed under the Patents Act 1977 will be refunded if withdrawal of the application takes place before the date of the official letter conveying the Examiner's report on the request in question."

10. Thus, such a refund is (and has been since at least 1980) a matter of discretion on the part of the Office, but as a matter of practice it will be reasonably clear and predictable whether a refund may or may not be given, depending on the stage a case has reached. Dr Barnfather accepted that any such refund was a matter of discretion, and indeed argued that this therefore also made the withdrawal request conditional. I disagree: the allowance or not of a refund has no bearing on the request to withdraw. A request for withdrawal could not be inferred as being conditional on the outcome of any request for a refund unless that condition was explicitly stated in the letter seeking withdrawal. That clearly was not the case here. More than that, I do not believe that an implicit condition relating to a refund can or should be assumed to exist in the absence of an explicit one. Longstanding and published Office practice is such that although such refunds are a matter of discretion, applicants and their agents would fully expect that discretion routinely to be exercised in favour of a refund being made in circumstances such as obtain in the present case. Either way, I do not regard the withdrawal request as having been made conditional

explicitly or implicitly on the refund of fees.

11. In case J11/80, with which Dr Barnfather sought to draw analogy, the EPO received a letter of withdrawal which said, "We hereby withdraw the above-mentioned patent application. Publication of the application should not take place." However, the letter was dated and received after preparations for publication of the application were complete, too late to stop publication of the application which was also subsequently withdrawn. A request from the applicant for further processing of the application was rejected by the Receiving Section of the EPO on the grounds that the application had been unconditionally withdrawn. The Legal Board of Appeal considered that in its letter of withdrawal the appellant did clearly indicate that it wished to withdraw its application on the not uncommon condition that the contents of the application remained undisclosed to the public. It took the view that the Receiving Section should have pointed out to the appellant that publication could not be stopped and should have enquired whether the appellant wished to proceed. A request for withdrawal should only be accepted without question if it was completely unqualified and unambiguous.

12. Dr Barnfather pointed out that in the case of J11/80 the application was allowed to continue as an ineffective withdrawal was deemed to have been filed. Similarly, he argued, the conditions of his withdrawal request of 6 January were not met at the time of retraction of the request on 23 January, and accordingly no effective withdrawal was on file. However, it seems to me that the position in the present case is distinguishable from that in J11/80. In the circumstances of J11/80 the withdrawal letter, which explicitly said that publication of the application should not take place, was too late to stop publication. That letter of withdrawal therefore did not make sense in the circumstances. The present case is quite different: the withdrawal request was clear and unambiguous, and the expectation of a refund in due course, as a separate discretionary matter to be dealt with in the usual way according to routine Office procedures, was not inconsistent with that request nor did it cast doubt on it. The intervening period between withdrawal and refund (had the latter not then been further deferred pending resolution of the present matter) could not reasonably be construed as creating a window for retraction of the withdrawal since the withdrawal itself was unequivocal.

## **Can the withdrawal request be retracted?**

13. Having found that the withdrawal request was clear and unconditional, I need now to consider whether it can simply be revoked or retracted. Section 14(9) of the Act states that:

"An application for a patent may be withdrawn at any time before the patent is granted and any withdrawal of such an application may not be revoked."

14. Dr Barnfather submitted that the literal wording of this sub-section should not be read absolutely rigidly but necessarily has to be interpreted more liberally as though the wording is "An application for a patent may be withdrawn at any time before the patent is granted and any proper and intentional withdrawal, unless made by mistake, in error, ineffectually, or fraudulently, of any application may not be revoked". He suggested that a scenario whereby a third party could fraudulently attempt to withdraw a case and such a withdrawal could not, under a strict interpretation of the sub-section, be revoked could not have been intended.

15. The proper approach to be taken to statutory interpretation is well established: the canons of interpretation have filled many text-books and I need to bring them to bear on section 14(9) to establish its meaning, or more especially the meaning of the words "... and any withdrawal of such an application may not be revoked." Looking first, as I believe I must, at the natural and ordinary meaning of those words in their context in the statute, they seem to me clearly and specifically, and simply, to mean that any such withdrawal may not be revoked, that is once made it is not susceptible of cancellation or retraction. This interpretation does not lead to a result which cannot reasonably be supposed to have been the intention of the legislature, and it is not therefore proper for me to look for some other possible meaning of the words. Even if I were to look, however, I do not believe that these words are capable of more than this one meaning.

16. I accept that if such wording as proposed by Dr Barnfather was provided in the statute, it could enable a request for withdrawal in a range of circumstances to be negated. However, that wording is not provided, nor any other proviso, and I do not believe that the implied meaning that he contends is one that the actual words of the statute can reasonably bear. A very firm and clear

set of words is provided, which clearly creates the impression that Parliament did not intend this sub-section to have the latitude that Dr Barnfather is advocating. In the event of fraudulent or unauthorised withdrawal, there are other legal provisions whereby such an action may be nullified. Such considerations, as Dr Barnfather accepted, clearly do not apply in the present case since Withers & Rogers are the applicant's properly authorised agents.

17. I therefore conclude that the provisions of section 14(9) are mandatory and specific and that if, as in the present case, a clear and unambiguous request is made by the applicant or his authorised agent to withdraw an application, it cannot be revoked.

18. Dr Barnfather argued that there must be some remedy, be it under section 117 or possibly rule 100, for dealing with such procedural errors. It is to these avenues I now turn.

### **The applicability of section 117**

19. Much of the thrust of Dr Barnfather's submissions was that section 117 should be and indeed was available to allow for correction of a withdrawal request made in error. Section 117(1) states that:

"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."

Section 117(1) is thus a general provision concerned with correcting errors in patent documents.

20. The nature of the error and the correction sought are clearly set out in the correspondence on file, and especially from Dr Barnfather's statutory declaration and its exhibits. On 17 December 1997, Withers & Rogers wrote a letter to its US associate pointing out that the instant United Kingdom application no 9718771.0 had been published on 27 June 1997 and seeking instructions as to whether consequential protection was required in Hong Kong. That letter was headed:

"UNITED KINGDOM PATENT Appln. No. 9718771.0 (2313665)

Priority US 399197

Spectra Tech Inc.

Infrared Microspectrometer Acc"

21. A faxed reply from the US associate received by Withers & Rogers on 31 December 1997 was headed:

"United Kingdom Patent Appl. No. 9718771.0

Priority US 399197

Spectra Tech Inc.

Your Ref.: KB/B'HAM/41819

Our File: 4546-8P/GB"

The significant part of the body of the letter read:

"In response to your December 17, 1997 letter concerning the above-identified matter, our client has instructed to allow this application to go abandoned."

22. Withers & Rogers therefore sent the Patent Office the letter of withdrawal of 6 January, as well as sending a separate reporting letter to the US associate. This prompted a further fax from the US associate on 23 January stating that its fax of 31 December 1997 concerned obtaining protection in Hong Kong. It asked for confirmation that UK application 9718771.0 "is still "alive" in the UK and that efforts to obtain protection in HK have been abandoned". This letter clearly prompted Withers & Rogers's approach to the Patent Office on 23 January and after. It also caused them to send a letter of 26 January to the US associate explaining that they had understood the US fax of 31 December to be instructing withdrawal of the UK application and not any Hong Kong registration, in essence because the fax had been headed by reference to the UK application, there was no Hong Kong registration in existence that could have been withdrawn, and the instruction was of the type they receive on a regular basis without any explanation.



23. As set out in Dr Barnfather's declaration, errors arose in the US associate's fax of 31 December. Dr Barnfather says that "accordingly, our letter of 6 January 1998 was filed in error and we requested correction of that error under Section 117 of the UK Patents Act 1977". The exact nature of the correction sought is given in the agent's letter of 30 March, namely:

"I confirm that the correction requested is that our letter of 6 January 1998 is either ignored as being sent in error or that correction of the wording of that letter of 6 January 1998 is amended to read as follows:

"We write to maintain the above referenced UK Patent application number 9718771.0 and do not request a refund of the search and examination fees.

We look forward to receiving the search report in due course."

24. The Office's position, as set out in correspondence, was that the withdrawal could not be "corrected" under section 117. This position was not taken as a result of any judgment as to the particular circumstances in which any error or mistake had arisen, but rather for legal reasons. In a nutshell, the Office maintained that a withdrawal, once validly made under section 14(9), could not be corrected under section 117(1) because to do so would contravene the long-established legal principle that a general provision, in this case section 117(1), could not override a mandatory specific one, in this case section 14(9). Thus, irrespective of the merits of the case for correction itself, the comptroller did not have the power to entertain the use of section 117 to override a withdrawal properly made under section 14(9).

25. This position was maintained by reference to several precedent cases, namely *Moskovsky*, which I have already mentioned and which was a decision by a Hearing Officer acting for the Comptroller, and two other cases referred to in it, that is *Antiphon AB's Application* [1984] RPC 1 and *Payne's Application* [1985] RPC 193. I shall consider each of these in turn.

## *Antiphon*

26. In *Antiphon*, a sheet of drawings was omitted by mistake from an application as filed, and when the fact came to light the Office required, under the then section 15(2), that either the application should be re-dated to the date when the other drawings were filed, or all references to the missing drawings should be treated as omitted. The applicant filed a request under section 117(1) for correction of the error so as to permit the filing of the missing drawings while retaining the original filing date. This course of action was refused by a decision of the Hearing Officer and an appeal was dismissed by the Patents Court. In the Patents Court, Falconer J held on page 10 under the law as it stood at the time:

"Section 117(1) ... is, of course, expressed in general terms, but to allow, under its provisions and those of rule 91 (which is the rule made pursuant thereto), correction of an error or mistake such as that sought to be corrected in this case, so as to allow the application to proceed as if the drawings filed later were part of the documents initially filed, would be to allow the provisions of section 117(1) and rule 91 to be used to circumvent the clear mandatory provisions of section 15(2). Section 15(2) is a particular enactment in the statute and , although section 117(1) is an enactment in general terms in the statute, it seems to me that it can have no application to a case which falls within the terms of section 15(2) and must be taken to affect only the other parts of the statute to which it may properly apply: see *Halsbury's Laws of England*, 3rd Edition, Volume 36, paragraph 597 at page 397. In my judgment, under the provisions of section 117(1) and rule 91, a correction may not be allowed if the effect of it would be to allow an applicant to circumvent the clear mandatory requirements of section 15(2) ."

27. The Office's position is that section 14(9) is a specific mandatory provision like the then section 15(2) and hence that section 117(1) cannot be used to circumvent it. Dr Barnfather sought to distinguish the present circumstances from those in *Antiphon* by arguing that section 117 was not applicable in that case because section 15(2) itself already contained a provision for making a form of correction, insofar as it provided that if any drawings were filed late it was possible to re-date the application to the date the drawings were filed. While I understand his

point, I do not find it all persuasive. It seems to me that section 15(2) was a specific mandatory provision and was no less so for offering two alternative courses of action. The key point is that section 117 could not be used to override it, and it seems to me that the same logic extends to section 14(9).

28. I would observe, as I did at the hearing, that the outcome of the *Antiphon* case was not that the correction was allowed under the law as it then existed, but that section 15 was later amended by the addition of section 15(3A), which now explicitly provides that nothing in subsections (2) or (3) of section 15 shall be construed as affecting the power of the comptroller under section 117(1) to correct errors or mistakes with respect to the filing of drawings, thereby enabling drawings omitted by mistake to be filed later without loss of the original filing date. By analogy in the present case, it seems to me that the applicant's present predicament would require a change in the law before it could be addressed.

### ***Payne's Application***

29. In *Payne's Application*, the applicant sought to delete references to two earlier applications in the priority declaration as a correction under section 117(1) and thereby circumvent the effect of section 15(5) under which the application had been taken to be withdrawn. The Hearing Officer, while finding the agent's arguments on the facts of that case very persuasive and finding no fault in his logic, held himself bound by the judgment of the Patents Court in *Antiphon*. Upholding that decision on appeal, Falconer J said at page 199:

"In my judgment, in so saying he [the Hearing Officer] was correctly applying the principle which has to be applied in a case such as this. What has been put to me is, whereas in the *Antiphon* case the relevant provision, namely, section 15(2) in fact is dealing with a section providing for a formal correction, subsection (5), which is the relevant provision in the present case, is not a section dealing with correction at all.

That distinction seems to me to be a distinction which does not appreciate the generality of the principle which I was applying in the *Antiphon* case. I was pointing out in the

*Antiphon* case that section 117(1), if the correction which had been sought thereunder had been allowed to go forward, would have circumvented the express mandatory provision of section 15(2).

In the present case, if the correction which is now sought to be made is allowed to go forward, it will be circumventing the mandatory requirements of section 15(5). It is the same principle and the fact that it so happens that subsection (2) and subsection (5) of section 15 can be differentiated in their requirements does not alter the application of the principle, so it seems to me. Accordingly, I think the hearing officer was absolutely correct in the way that he decided the case, considering that the general principle which I had applied in the *Antiphon* case was equally applicable to the present case."

30. Dr Barnfather argued that because it is possible to extend the deadline for filing the search request by using rules 110(3) and (4) as a form of "correction", the use of section 117 in that circumstance becomes irrelevant. This gave rise to a distinction between the position in *Payne's Application* and the present one. However, this contention fails in my view for the same reason that a parallel contention failed in *Payne's Application*. In Falconer J's words, it is a distinction which does not appreciate the generality of the principle applied in *Antiphon*. Thus, I find myself obliged to reject Dr Barnfather's reasoning and to conclude that the logic of *Payne's Application* also applies in the present case: if an application has ceased to exist because of a failure to comply with a specific mandatory requirement of the Act, it cannot be corrected under section 117 in effect to circumvent that requirement.

### ***Moskovsky***

31. In *Moskovsky* the applicant's agents sought to correct under section 117 (and rule 100, to which I shall turn later) an erroneous request to withdraw an application on the grounds that their foreign associates had mistakenly instructed them to withdraw the wrong application. In that case, the agent accepted that having regard to the published judgments of the Patents Court there is a continuous line of reasoning through a number of judgments that a general provision, such as section 117, cannot be used to circumvent the clear mandatory provisions of a particular

enactment in the statute. He did, however, try to differentiate that case on its facts. The Hearing Officer reviewed several court judgments, including *Antiphon* and *Payne's Application* which I have already considered above, and concluded on pages 6 and 7 of his decision that:

"As with the various sections referred to in these decisions, the wording of section 14(9) which states that "any withdrawal of such an application may not be revoked" is also quite clear and mandatory and does not say "unless made by mistake". Applying the above principle to section 14(9) would appear to mean that neither section 117 nor rule 100 can be used to circumvent the effect of the withdrawal made by the properly authorised agent.

...

It seems to me, therefore, that, regrettably, I am bound by the above decisions to apply the same principles to section 117 and rule 100 and to reach a similar conclusion that neither of these provisions can be invoked to help the applicant because this would mean using a general enactment to override section 14(9) which is a particular enactment of the statute."

32. I do not believe I can improve on that formulation of the position. Dr Barnfather correctly pointed out at the hearing that this was a decision of a Hearing Officer and is not binding on me. However, it was based on principles laid down in several court judgments, including *Antiphon* and *Payne's Application* which I have already considered and which are binding on me, and it is highly persuasive. I do not believe I should lightly depart from a relevant decision of another of the Comptroller's Hearing Officers. Although Dr Barnfather suggested that the circumstances of the present case departed from those in *Moskovsky* as regards the timing of the advertisement of the withdrawal, I do not believe that that makes any material difference.

33. On this basis, irrespective of the circumstances of the errors or mistakes or the merits of the requested corrections in the present case, I do not believe that the comptroller has the power to entertain the use of section 117 to override a withdrawal properly made under section 14(9).

## **EPO Decision J10/87**

34. At the hearing Dr Barnfather reminded me again of section 91(1) as the basis for judicial notice to be taken of the decisions of the EPO before taking me to decision J10/87 of the EPO Legal Board of Appeal which allowed the correction, and thereby retraction, of a withdrawal of the designation of a contracting state to the European Patent Convention ("EPC"). Although a letter had been sent by the applicants' representative to "... request that the British designation is irretrievably withdrawn", a subsequent telex from the representative stated that the letter had been filed without the knowledge or authority of the applicants due to an administrative error and requested that the letter should be ignored. The designation was subsequently reinstated through the application of rule 88 EPC, having satisfied the following requirements:

- i) at the time the retraction of the withdrawal is applied for the public has not been officially notified of the withdrawal by the EPO;
- ii) the erroneous withdrawal of the designation of an EPC Contracting State is due to an excusable oversight;
- iii) there is no undue delay in seeking retraction; and
- iv) there is adequate protection of third persons if the correction is allowed.

35. Before considering the detail of the decision and these conditions, I should briefly note that EPO Decisions, while not strictly binding, are of great persuasive authority. I would, however, also note that neither subsections 14(9) nor 117(1) are among those provisions listed in section 130(7) of the Act as being so framed as to have, as nearly as practicable, the same effects as the corresponding provisions of the EPC.

36. In case J10/87 the central EPC provisions were article 79(3) and rule 88. Article 79(3) states that:

"The designation of a Contracting State may be withdrawn at any time up to the grant of the European patent. Withdrawal of the designation of all the Contracting States shall be deemed to be a withdrawal of the European patent application. Designation fees shall not

be refunded."

Rule 88 under the EPC reads:

"Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns a description, claims or drawings, the 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."

37. Dr Barnfather argued that the circumstances in J10/87 were very similar to those in the present case. However, there is it seems to me a crucial difference between their legal bases. There is no suggestion in the wording of EPC article 79(3) or rule 88 that any withdrawal may not be revoked. By contrast, section 14(9) explicitly and unequivocally states that any withdrawal may not be revoked. The provisions of section 14(9) do not therefore bear comparison to those of article 79(3) and I conclude that the EPO decision in J10/87 is based on a different legal foundation from that governing me. In short it is of no assistance.

### **Third party interests**

38. At the hearing, Dr Barnfather moved on from decision J10/87 to consider how the position of third parties might be taken into account in the present case. However, since I have concluded that under UK law the comptroller does not have the power to correct a withdrawal request, and that J10/87 is not of any assistance to me, it is unnecessary for me to dwell on the question of how third party interests might have needed to be protected had I reached the opposite conclusion. However, Dr Barnfather's submissions on third party interests merged with those on the relevance of rule 100, and I shall consider them in that context.

### **Rule 100**

39. Dr Barnfather contended that rule 100 might be deployed in the applicant's favour.

Paragraph 1, which is the material part of the rule for present purposes, reads:

"(1) Subject to paragraph (2) below, any document filed in any proceedings before the comptroller may, if he thinks fit, be amended, and any irregularity in procedure in or before the Patent Office may be rectified, on such terms as he may direct."

40. Dr Barnfather suggested that an advertisement that a request for correction had been made should have been placed in the Official Journal (Patents) and an entry made in the Register to draw the matter to the attention of third parties, and that it was an omission or irregularity in procedure on the part of the Office that it did not do so. In support of this point he cited *Daido Kogyo KK's Patent* [1984] RPC 97. This was a restoration case in which the Court of Appeal held (*obiter*) that all applications for restoration which were out of time should be entered in the Register no matter how unarguable they might appear to persons in the Patent Office. However, that *obiter* comment was made in the narrow context of applications for restoration of a patent, and does not translate into a requirement for the making of an entry in the Register in circumstances such as the present ones relating to a patent application.

41. Dr Barnfather also argued that section 117(2), which states that "Where the comptroller is requested to correct such an error or mistake, any person may in accordance with rules give the comptroller notice of opposition to the request and the comptroller shall determine the matter", imposes an obligation on the comptroller to advertise applications for correction, which had not been done in the present case. However, I do not believe that the comptroller is obliged by section 117(2), which is silent on the question of advertisement, or by any other provision in the Act to advertise a request for a correction. Rule 91(3) states that "where the comptroller requires notice of the proposed correction to be advertised, he shall advertise the request and nature of the proposed correction in the Journal". It is clearly a matter of discretion for the comptroller as to where he requires notice of a proposed correction to be advertised. It is not the Office's practice to advertise such proposals before grant. Indeed, I pointed out to Dr Barnfather at the hearing that at least for patent applications which had not yet been published under section 16, it would be difficult if not impossible to reconcile such advertisement as he advocated with the constraint in section 118(2) that "...until an application for a patent is so published documents or information



constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the comptroller". For these reasons, I am not persuaded that the failure to publish a notice in the Official Journal (Patents) or make an entry in the Register drawing attention to the request to revoke the withdrawal constitutes any irregularity in procedure.

42. As I understood it, a further irregularity Dr Barnfather was alleging was that at the same time as it suspended the fee refund (in the official letter of 28 January 1998) the Office should have but did not suspend publication of the notice of withdrawal (which appeared in the Official Journal (Patents) of 11 February) as would in his view have been the correct course of action on receipt of the initial request to revoke withdrawal on 23 January 1998. The most I can say of this is that the failure by the Office to adopt the agent's preferred course of action does not in itself constitute an irregularity in procedure.

43. Dr Barnfather also cited *Minnesota Mining & Manufacturing Co* (unreported, O/86/96) as authority for the propositions that rule 100 could be used to allow any document filed in any proceedings to be amended, and that all or any procedural errors in the present case can be corrected at the comptroller's discretion. In *Minnesota* the patent application was treated as having been withdrawn because of a failure to file Form 10/77, and that position was advertised in the Official Journal (Patents) and an entry made in the Register. In fact a Form 10/77 had been filed but bearing an incorrect application number; the Office had filed the form on that incorrect application despite the fact that the applicant's and agent's details on the form did not match that file. The Hearing Officer concluded that the making of the entry in the Register was an irregularity in procedure on the part of the Office, and under rule 100 he cancelled that entry and directed that the Register be amended. He also allowed the request to correct the Form 10/77 and directed that the application proceed to substantive examination, subject to conditions he imposed to protect third parties.

44. As I have already mentioned, the applicability of rule 100 as a means of retracting a withdrawal request was considered by the Hearing Officer in *Moskovsky*. He rejected it for precisely the same reasons as he rejected the use of section 117, namely because invoking rule 100

would involve using a general provision to override a particular mandatory enactment of statute. For the same reasons, I am driven to the same conclusion as he was. I should add that in *Moskovsky* the Hearing Officer considered the *Minnesota* case also drawn to my attention.

45. In the present case it is clear that misunderstandings between the applicant's British and US agents have led to the present situation. However, neither matter which Dr Barnfather mentioned, even if it could be regarded at all as an irregularity in procedure in or before the Office, could be viewed as one contributing to the withdrawal of the present application. The application was not terminated because of a failure to carry out a procedure: withdrawal of the application was voluntarily requested by the agent, and this withdrawal was treated by the Office in the normal way, with the Register being amended to reflect the status as terminated and a notice being generated in the Official Journal (Patents). Thus, while I wish to make it clear that my principle reason for refusing to exercise discretion under rule 100 is that I do not believe I have the power to do so because that would involve using a general provision to override the specific mandatory provision of section 14(9), a secondary reason is that even if I had the power I do not believe the circumstances of the present case would fall within the ambit of rule 100.

### **Conclusion**

46. In summary, having carefully considered all the submissions put forward by the agent both in writing and at the hearing, I find that under the statute a request to withdraw a patent application, as in this case properly made under section 14(9), may not be revoked, nor does the comptroller have the power to use section 117 or rule 100 to correct or otherwise override that withdrawal. The application therefore stands withdrawn

### **Appeal**

47. This being a decision on a matter of procedure, any appeal against this decision shall be filed within fourteen days of the date of this decision.

Dated this 19<sup>th</sup> day of August 1998

S N DENNEHEY

Superintending Examiner, acting for the comptroller

**THE PATENT OFFICE**