

PATENTS ACT 1977

IN THE MATTER OF

Patent Application No. GB 9711337.7

in the name of Leslie Adrian Alfred Woolard

DECISION

Introduction

1. Patent Application No. GB 9711337.7 was filed on 3 June 1997 in the name of Leslie Adrian Alfred Woolard (the applicant) and was published on 12 August 1998 as GB 2321955 A. The application is concerned with an illumination method and device. A previous application of the applicant (GB 9524633.6) relating to very similar subject matter was filed on 1 December 1995 and published on 4 June 1997 as GB 2307736 A. This earlier application was cited by the examiner under section 2(3) against the present application GB 9711337.7 at the substantive examination stage.

What is in dispute?

2. This decision is concerned with the interpretation of section 2(3) of the Patents Act 1977. The issue which is in dispute and remains to be decided is whether GB 2307736 A anticipates the present application by virtue of section 2(3) following withdrawal of GB 2307736 A during its publication cycle. The applicant maintains that withdrawal of the application during the publication stage effectively means that the application would not form part of the state of the art under section 2(3) since the application was not “live” at the date of A-publication. The examiner’s opinion is that the withdrawal was too late in the publication cycle to stop publication and once the application had been published it therefore formed part of the state of the art.
3. This issue of whether or not the withdrawn application GB 2307736 A forms a part of the state of the art or not reached an impasse and on 3 May 2001 the applicant’s agent requested a hearing to determine the matter. Prior to the substantive hearing, the examiner drew the agent’s attention to *Zbinden’s Application* BL O/260/01, a recent Patent Office decision which relates to the same point of law as the present application. The agent then requested that the hearing be cancelled and that the Office issue a decision in writing. This decision is therefore being made on the papers.
4. None of the facts concerning either the withdrawal of the earlier application GB 9524633.6 or the progress of the present application GB 9711337.7 is in dispute between the examiner and the applicant. All other objections raised by the examiner during substantive examination of GB 9711337.7 have been satisfactorily overcome except for the outstanding novelty objection under section 2(3) citing GB 2307736 A.

Evidence

5. The evidence for the applicant consists of a Statutory Declaration of Laurence Andrew Sanderson, the agent for the applicant, with supporting exhibits in the form of various documents explaining how the dispute concerning the application arose. These documents comprise copies of a letter concerning the development of GB 9524633.6, an undated note informing the agent of the applicant's instruction to abandon GB 9524633.6, a Notice of Publication informing the applicant of the publication of GB 9524633.6, a letter concerning the delay in abandoning GB 9524633.6, a letter recounting a telephone conversation with Patent Office staff about the publication process, a letter withdrawing GB 9524633.6, and an undated note with instructions to prepare a fresh patent application based on GB 9524633.6.

The Law

6. Under the terms of section 16 of the Patents Act 1977 and rule 27 of the Patents Rules 1995 the Comptroller has a statutory obligation to publish patent applications as soon as possible after 18 months from the declared priority date, or the filing date if there is no priority date. Relevant parts of the UK legislation and the corresponding measures under the European Patent Convention (EPC) are as follows:

Section 16

(1) Subject to section 22 below, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed,.....

Rule 27

The period prescribed for the purposes of section 16 shall be the period of eighteen months calculated from the declared priority date or, where there is no declared priority date, the date of filing the application.

Article 93 (EPC)

(1) A European patent shall be published as soon as possible after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, as from the date of priority.

Rule 48 (EPC)

(1) The President of the European Patent Office shall determine when the technical preparations for publication of the European patent application are to be deemed to have been completed.
(2) The European patent application shall not be published if it has been finally refused or withdrawn or deemed to be withdrawn before the termination of the technical preparations for publication.

7. Section 1(1)(a) of the Patents Act 1977 requires that an invention be new. The meaning of "new" is defined in section 2 of the Act, and the sequence of the first three sub-sections, together with their counterparts in the EPC, are quoted below:

Section 2

(1) An invention shall be taken to be

Article 53 (EPC)

(1) An invention shall be

new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied, that is to say-

(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.

considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.

(4) Paragraph 3 shall be applied only in so far as a Contracting State designated in respect of the later application was also designated in respect of the earlier application as published.

Main arguments

8. GB 9711337.7 was filed on 3 June 1997 without a claim to priority. The effect of section 2(3) for GB 9711337.7 is to define a further field of prior art limited to patent applications published on or after 3 June 1997, if those applications also satisfy the conditions of sub-sections 2(3)(a) and 2(3)(b). There is no dispute that GB 9524633.6 satisfies the conditions of these sub-sections and was published after 3 June 1997, and thus appears at first sight to qualify for inclusion in the section 2(3) field against GB 9711337.7. However, does the withdrawal of GB 9524633.6 by the applicant before its date of publication have the intended effect of nullifying the publication so far as section 2(3) is concerned? Is the word “application” in section 2(3) to be construed as limited to applications which are pending (not withdrawn or refused) when published? These are the questions at the heart of this impasse and they have thrown up the following arguments.

Applicant’s position

9. The applicant instructed his agent to abandon the earlier application GB 9524633.6 on

26 March 1997. Unfortunately, although the agent was aware of the request that the application should be abandoned, this instruction was not acted upon. Subsequently, on 8 May 1997 the agent received a Notice of Publication from the Office stating that the application would be published on 4 June 1997 with the publication number GB 2307736 A. The agent then checked with the Office on 8 May 1997 to see if the application could somehow still be withdrawn from publication but was told that it was by then impossible. On 12 May 1997 the Patent Office received a letter from the agent withdrawing the application for all purposes, leaving no rights outstanding.

10. Because the earlier application had been withdrawn by the applicant, the present application was treated as the first application for protection in a Convention country and on 3 June 1998 an International Patent Application No. PCT/GB98/01469 was filed. The International Examiner found that the application lacked novelty over GB 2307736 A, the earlier application. However, according to evidence submitted by the applicant's agent, the International Examiner withdrew the objection when the agent demonstrated that the application had been withdrawn on or about 9 May 1997.
11. The agent has contested that the word "application" in section 2(3) means "live" application, ie. one that contains a request for the grant of a patent. Section 14 of the Act sets out the nature of an application and its requirements. According to the agent, every application requires a request for a grant of a patent, and it is his contention that when withdrawal is requested, one is asking for the withdrawal of the request for a grant of a patent, and that after withdrawal the application ceases to be an "application" as defined by section 2(3). Section 5 also refers to earlier applications and the conditions for disregarding a second application in preference of a first application for the purposes of determining priority date.
12. The agent also felt it appropriate to invoke common sense to the meaning of the Act. He hypothesised that if an earlier application were withdrawn before preparations for publication were complete, and by some administrative error it was in fact published, it would be inconceivable that such an error could bring the earlier application within the ambit of section 2(3). Whatever happened after the withdrawal of the application by the applicant was of no effect and the same principle ought to apply to the present circumstances.
13. The agent also proposed that the purpose of section 2(3) was to stop so-called "double patenting", but as this is not the case in this application, the objection under section 2(3) raised by the examiner should be removed.
14. Finally, the agent maintained that the European Patent Office (EPO) does not consider a published withdrawn application to be a "valid" application and citable under Article 54(3) and referred to the European Guideline C-IV, 6.1a; Decision J 05/81, European Patents Handbook Chapter 102. This is relevant in the agent's opinion since section 2(3) of the Act is the equivalent section to Article 54(3) of the EPC.

Examiner's opinion

15. The examiner first raised the novelty objection concerning GB 2307736 A in an examination report dated 7 January 2000 as a result of a search carried out under section

2(3). The applicant's response removed the major objections raised in the examination report except for the validity and relevance of GB 2307736 A as prior art. The examiner outlined the sequence of events relating to the current application and of the earlier application and referred to section 16(1) of the Act concerning the preparations for publication for GB 2307736 A. He stressed in particular that "...the comptroller shall, unless the application is withdrawn or refused before preparations for its publication have been completed by the Patent Office, publish it as filed....".

16. The examiner refuted the "common sense" argument offered by the agent and referred instead to the assumption that a statute should only be interpreted on its own words. The examiner drew the agent's attention to *Pepper v Hart* [1992] 3 WLR 1032.
17. He added that Decision J 05/81 on which the current practice of the EPO rests was decided on whether the EPO was obliged to publish an application under rule 48 EPC, and was arguably *obiter* on the question of whether an application withdrawn at the time of publication forms part of the art under Article 54(3). The examiner noted that rule 48 EPC differs from section 16 of the Act. Rule 48 EPC states that the application shall not be published if it is withdrawn before preparations for publication are complete whereas section 16 says that we shall publish the application as soon as possible after the prescribed period unless withdrawal is requested before preparations for publication are completed.
18. According to the examiner, the term "application" in section 2(3) does not just only relate to "live" applications. There is a presumption that when a term is used in different places in a statute it has the same meaning unless there is express indication to the contrary. In this respect, the examiner referred the agent to *Unilever Limited (Davis's) Application* [1983] RPC 219 at page 229. In sections 5 and 17(1) of the Patents Act 1977 the unqualified term "application" appears clearly intended to embrace both "live" and withdrawn applications, the withdrawn applications being regarded as a particular category of application. The same term should therefore have a similar meaning in sections 2(3) and 16(1), and as such a published withdrawn application is still regarded as an application and can be used as a citable document under section 2(3).
19. On 29 August 2001 the examiner informed the agent of the recent Office decision issued on 13 June 2001 which related to the same point of law, viz. *Zbinden's Application* BL O/260/01, and opined that there appeared little to distinguish the circumstances of the present case from that in *Zbinden's Application*.

Discussion

20. The agent for the applicant has relied principally on the fact that the current practice of the EPO on this point is to answer the questions in paragraph 8 above in the affirmative and that there are compelling reasons for the UK Patent Office to follow the same practice.
21. The examiner has argued that section 2(3) cannot allow of this interpretation and that it is clear in its own terms. He finds that the reasoning adopted in the EPO is not compelling, so that the questions must be answered in the negative.
22. These arguments were followed on the same point of law in *Zbinden's Application* BL

O/260/01. The hearing officer in that case addressed the arguments persuasively and considered the equivalence of section 2 and Article 54 in some detail. He came to the conclusion that the Patents Act 1977 has no provision to exempt applications withdrawn after the date that preparations for publication are complete from the state of the art provided by section 2(3). He detected no inconsistency between the relevant corresponding provisions of the Patents Act 1977 and the European Patent Convention. However, he noted that EPO case law and practice embody the opposite conclusion of exempting late-withdrawn applications from the state of the art provided by Article 54(3). Detailed argument from his decision at paragraphs 13 -14 is as follows:

“It is clear above that section 2 is equivalent to Article 54 and that despite differences of wording the effects are the same. This equivalence is cemented by section 130(7) of the Act which conveys that section 2(3) was so framed as to have, as nearly as practicable, the same effect as Article 54(3). Moreover, our courts have repeatedly underlined the need to look to Europe, both (i) to see how the corresponding EPC provision is framed, and even to prefer it over our own Act as having “direct effect” (see *Bristol-Myers Squibb Co. v Baker Norton Pharmaceuticals Inc.* [1999] *RPC* 253 at pp 258, 259), and (ii) to take account of case law under the EPC and to accord it “great persuasive authority” (see *Merrell Dow Pharmaceuticals Inc. v H N Norton & Co Ltd* [1996] *RPC* 76 at page 82).”

“In contrast to the *Manual of Patent Practice*, which gives guidance on practice within the UK Patent Office and is silent on the above questions, the *Guidelines for Examination in the EPO* state at Part C, Chapter IV, paragraph 6.1a:

Further it is required that the conflicting application was still pending at its publication date (see J 5/81, OJ 4/1982, 155). If the application has been withdrawn or otherwise lost before the date of publication, but published because the preparations for publication have been completed, the publication has no effect under Art. 54(3), but only under Art 54(2). Art. 54(3) must be interpreted as referring to the publication of a “valid” application, ie a European patent application in existence at its publication date.”

23. The foundation for this interpretation by the EPO is the decision of the Legal Board of Appeal identified as J 05/81. In essence, an applicant withdrew an application in the pipeline period and was insistent that publication should be stopped. The Receiving Section had refused this request, saying that the EPO was prevented by law (Rule 48(2) EPC) from stopping publication after preparations for publication were complete. The Board of Appeal exposed this as erroneous (paragraph 2 of Reasons for the decision) by pointing out that Rule 48(2) merely assures that withdrawal *before* the preparations for publication were complete will prevent publication, and there was no basis for drawing any converse conclusion that withdrawal *after* the preparations for publication were complete must *not* prevent publication. There was no such obligation to publish withdrawn applications.
24. The Board of Appeal then (in paragraph 3 of J 05/81) remarked, in support of this conclusion, as follows:

“Thus, a published European patent application becomes part of the state of the art under Article 54(3) EPC, with retroactive effect as from its filing date or priority date, in assessing applications filed after that filing date or priority date but prior to its

publication. However this should only apply if such a “prior application” is still in existence at the time of publication. Furthermore, under Article 139(1) EPC a published European patent application can have a national prior right effect too. It is therefore in the general interest to keep the number of “false” prior rights as low as possible. Potential difficulties in connection with the Register of Patents (Article 127 EPC) and inspection of files (Article 128 EPC) should also be avoided if possible.”

25. The Board also remarked in paragraph 4:

“Article 93 EPC lays down the principle that all applications must be published promptly after 18 months. The Convention thus gives the public the right in principle to be informed after that period of all pending patent applications.”

26. The Board’s general conclusion was therefore that if withdrawal takes place after the date at which preparations for publication are complete the applicant cannot rely on preventing publication, although the EPO would be allowed by law to prevent publication, at its discretion.

27. The argument that section 2(3) cannot allow of the interpretation which the EPO practice would suggest, and that the EPO reasoning is not compelling, was explored fully in *Zbinden’s Application* at paragraph 19. As with the present case, there was an attempt to put section 2(3) into context as follows:

“...to put section 2(3) in a context, which at one level is the whole of the Patents Act 1977, and in considering the agent’s contention that “application” in section 2(3) must mean “live application” had looked at how the word “application” had been handled elsewhere in the Act. He referred firstly to the principle that words should be taken to mean the same throughout a statute, in the absence of express indications to the contrary, a principle relied on in the patents context by Falconer J. in *Unilever Limited (Davis’s Application) [1983] RPC 219* at page 229 (in relation to the word “therapy”).”

28. Examples of uses of the word “application” in the Act were cited where it carried no special meaning as to live or withdrawn as follows:

“Section 5(2) allows for claiming priority from “earlier relevant applications” and it is indeed possible to claim priority from live or withdrawn applications (the scenario of section 5(3) concerns withdrawal of applications made before the priority application and does not affect this). Also, section 17(1) (and hence section 18(1)) explicitly requires applications not to be withdrawn before they are referred for search (or substantive examination), which qualification would have been unnecessary if “application” had meant “live application”.”

29. The context of sections 2(3) and 16(1) was also considered and the following point was made at paragraph 20:

“that section 16(1) has the clear consequence that some applications will get published even if withdrawn after the date at which preparations for publication are complete: section 2(3) even so does not pick out such applications for different treatment.”

30. Like the examiner in the present case, there was therefore reluctance to accept the current EPO practice.

Assessment of the main arguments and views

Statutory interpretation

31. As in the present case, the meaning of the words “application” and “published” as they are used in section 2(3) of the Act were considered in some detail in *Zbinden’s Application*. It was noted that the word “application” was not given any special definition in section 130(1) of the Act. Consideration was also given to the meaning that the draftsman might have had in mind when framing the Act and it was concluded that the draftsman, if he had had it in mind that section 2(3) should *not* apply to applications withdrawn after the date at which preparations for publication are complete but then published as section 16 requires, he would have made specific provision in those terms, to nullify the act of publication.
32. The word “published” in section 130(1) is given a general meaning of “made available to the public”, but more specifically, references to an application for a patent being published are said in section 130(5) to be references to its publication under section 16. This therefore establishes a link between section 2(3) and section 16. This highlights that withdrawn applications will inevitably be published under the provisions of section 16, yet they are not separately dealt with under section 2(3).

Policy underlying section 2(3)

33. The policy underlying section 2(3) was dealt with in some detail in *Zbinden’s Application* and it is a policy with which I agree. It was made clear in paragraph 24 ff. of *Zbinden’s Application* that what we are dealing in section 2 is the extent of the state of the art, which is that body of prior public knowledge that can be drawn on to test the novelty of the invention. For knowledge that became public before the priority date of the invention there is in section 2(2) a straightforward and all-embracing provision. For knowledge that emerges to become public on or after the priority date but yet pre-dates it in some sense one thinks primarily of the contents of patent applications of earlier priority date, and this is included in section 2(3). This section comes into play when there is conflict between patent applications that overlap in the time they spend passing through the Patent Office. In particular,
- “Section 2 deals with novelty. Novelty goes to prior knowledge that was public or becomes public. The teaching of a prior patent application that gets published is prior knowledge that has become public, and the withdrawal of the application before the publication date nullifies neither the original knowledge, lodged at a patent office in a document of record on the priority date, nor does it nullify the publication, whereby it passes into the public domain. Withdrawal of the application beforehand cannot change that, and thus should not change the state of the art.”
34. As with the hearing officer in *Zbinden’s Application*, I am quite certain in my own mind that had the draftsman of the Act intended section 2(3) not to apply to applications

withdrawn in the pipeline period, he would have made an explicit derogation.

The European parallel

35. The European parallel in this case, which depends upon the interpretation of section 130(7) and a decision of an EPO Board of Appeal, is a very strong one for the applicant. Again, like the hearing officer in *Zbinden's Application*, I am very conscious of the obligation I am under to observe and reflect EPO legislation and case law, an obligation which follows from the Act and from many judgments of UK courts.
36. However, on comparing the respective statutory provisions, the EPC gives no more of a clue on the point at issue than the Patents Act 1977. The practice in the EPO is based on comments of a Board of Appeal made in the course of decision J 05/81 which are considered *obiter dictum*. The Board in that decision was not presented with argument on the interpretation of Article 54(3) which might have brought out the pros and cons of the two views that could be taken as to whether withdrawn applications can enter the state of the art.

Conclusions

37. I, like the hearing officer in *Zbinden's Application*, agree that there does not appear to be a provision under the Patents Act 1977 to exempt applications withdrawn after the preparations for publication have been completed from the state of the art provided by section 2(3). However, it is clear that EPO case law and practice exempts late-withdrawn applications from the state of the art as provided by Article 54(3) and this appears to be long-settled practice in the EPO. Therefore, I should ask the same question as was asked by the hearing officer in *Zbinden's Application*, viz. does section 130(7) require me to superimpose the EPO interpretation upon a section of our Act in the interests of uniformity?
38. I answer that question in the negative. The EPC is an international treaty that is given legislative effect in the United Kingdom by the Patents Act 1977. The Act required the parliamentary draftsman to make certain choices of language and structure in order to express the effects of the EPC according to UK styles and practices in those areas identified in section 130(7). That section also records the draftsman's intention that these areas should have the same legal effects. The Act, while always requiring attention to be paid to corresponding parts of the EPC, therefore has a certain primacy in the UK.
39. It seems inevitable therefore that divergences will appear between UK and EPO practices given the different drafting styles of the Act and the EPC. In particular, the strict need for the Act to provide vires for all administrative actions and for all dependent secondary legislation differs in comparison with the treaty language of the EPC which is not so concerned with the provision of vires. Of course, there is also the point that the EPO practice follows in this instance, not from the EPC itself, but from an *obiter* statement of a Board of Appeal, which lessens its persuasive power.
40. I have considered the arguments made by the agent for the applicant and by the examiner in this case and in the absence of any facts or points of law concerning the practice under

section 2(3) which distinguish this case from that outlined in *Zbinden's Application*, I can see no reason to depart from the decision given in that case on the same point of law. Therefore, I find that GB 9524633.6, published as GB 2307736 A, is not exempted from the state of the art under section 2(3) by reason of its withdrawal after preparations for publication were complete. Since the earlier application completely removes the novelty of GB 9711337.7, the application in suit, and since I can see no way in which the application might be amended to avoid this objection, I refuse patent application GB 9711337.7.

Appeal

41. This is not a procedural matter and any appeal against this decision must therefore be made within six weeks. The period allowed under section 20(1) of the Act for granting the application expires on 3 December 2001 but is now extended under section 20(2) for the purposes of any appeal to this decision.

Dated this 16 day of November 2001

D J JERREAT

Deputy Director acting for the Comptroller

THE PATENT OFFICE