

Board of Appeal refused (minutes of oral proceedings dated 3 January 2022 available on the [European Patent Register](#)).

- 4 The issue before me now is whether the national phase application satisfies the requirements of section 13(2)(a) regarding the filing of a statement indicating the person or persons whom the applicant believes to be the inventor. In the preliminary examination of the application (report dated 2 August 2021), the formalities examiner informed the applicant that the application did not meet the requirements of the Patents Rules and that a Statement of Inventorship (Patents Form 7) needed to be filed. The applicant challenged this objection, saying that the provisions of section 89B(1)(c) of the Patents Act mean that the Statement of Inventorship filed in the international phase of the PCT shall be treated as the Statement of Inventorship required under the Act. He said that the applicant had filed such a statement under the PCT. The examiner maintained the view that the Statement of Inventorship filed in the international phase was inadequate and cited the Court of Appeal's judgment as binding the Office to find that the naming of DABUS as inventor does not meet the requirements of the Act. The examiner argued that section 89B(1)(c) merely requires that any statement of inventorship filed in the international phase should be deemed to have been filed on a Patents Form 7.
- 5 Despite further exchanges between the applicant and formalities examiner, the applicant remains of the view that the Statement of Inventorship filed in the international phase of the PCT is not subject to preliminary examination in the national phase and that the Office is required to treat it as having been properly filed. If the applicant is correct then this could result in an application being treated as withdrawn when filed under the UK Act but an identical application allowed to proceed when filed under the PCT.
- 6 The applicant requested to be heard and the matter came before me at a videoconference hearing on 26 April 2022. Mr Robert Jehan of William Powell appeared for the applicant. I am grateful to Mr Jehan for the skeleton arguments he submitted in advance of the hearing. For some reason, a technical problem occurred in the audio recording of the hearing that would prevent a transcript of the proceedings being produced, so it was agreed that I would prepare a written note of the hearing for Mr Jehan's approval. I am grateful to Mr Jehan for this accommodation and for his reply to my written note.

Issue for decision

- 7 The issue before me is whether, or to what extent, it is open to the Office to conduct a preliminary examination of the statement of inventorship in a national phase application (i.e. an application under section 89 of the Act) when such a statement has previously been filed during the international phase.
- 8 The Court of Appeal has already said that an inventor must be a person and that the naming of DABUS as the inventor does not meet the requirements laid down by section 13(2). The applicant does not challenge that interpretation here. However, the applicant does ask that I postpone any decision on this application until the Supreme Court has decided whether the Court of Appeal's judgment is the final word on the matter (or at the least until the Supreme Court has considered the application for permission to appeal).

The law

- 9 The relevant law is set out in sections [89B](#), [13](#) and [15A](#) of the Patents Act 1977 (as amended) (“the Act”) and rules [10](#), [25](#) and [68](#) of the Patents Rules 2007 (as amended) (“the UK Rules”). It is also necessary to refer to the requirements and regulations under the Patent Cooperation Treaty, in particular to Articles [4](#), [14](#), [22](#) and [27](#) of the Treaty and to Rules [4](#), [26ter](#) and [51bis](#) of the Regulations thereunder.
- 10 Section 89B of the Act sets out various adaptations of the Act in relation to international applications. For example, where an international application for a patent (UK) is accorded a filing date under the PCT then that date is deemed to be the filing date of the national phase application. Subsection (1)(c) states that “any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 13(2)”. It should be noted that subsection 1(c) does not refer to the additional statement required under section 13(2) concerning the derivation of the applicant’s right to be granted the patent (s13(2)(b)), which I shall address below.
- 11 Section 89B(5) allows the comptroller to refer the national phase application for so much of the preliminary examination under section 15A as he considers appropriate in view of the examination or search carried out under the Treaty (i.e. the PCT). Section 15A(2) provides for a preliminary examination of whether the application complies with various requirements designated as formal requirements under the Act, as well as a determination of whether any requirements under section 13(2) remain to be complied with (section 15A(2)(b)). Section 15A(7) says that the comptroller may refuse an application if the applicant fails to amend the application in order to satisfy formal requirements, while section 15A(9) says that the comptroller must only “inform the applicant accordingly” if any requirement of section 13(2) had not been complied with.
- 12 Section 13 is concerned with the right of the inventor to be mentioned in any published application for a patent, and subsection (2)(a) requires the applicant to provide a statement identifying the “person or persons whom he believes to be the inventor” within a prescribed period. Rules 10(3) and 10(4) of the UK Rules specify that this statement should be filed on a Patents Form 7 within sixteen months from the earliest filing date. Also, although not directly relevant in this case, for cases where the applicant is not the inventor, section 13 also requires the applicant to provide a statement indicating how the applicant derives the right to be granted a patent (section 13(2)(b)). As I have already mentioned above, the Court of Appeal has addressed the meaning of this section in some detail when it considered whether a non-human could be regarded as an inventor under the Act. The answer to that particular question is “no”.
- 13 Rules 23 to 25 of the UK Rules relate to the preliminary examination of an application under section 15A. Rule 25(1) sets out the rules under the Act which are designated as formal requirements, namely rules 12(1) and 14(1)-14(3), which I do not need to set out in detail here. Rule 25(3) states that where an international application for a patent (UK) was filed in accordance with the provisions of the PCT, the formal requirements mentioned in rule 25(1) shall be treated as complied with to the extent that the application complies with any corresponding provision of the PCT.
- 14 Rules 66 to 68 of the UK Rules are concerned with the beginning of the national phase. They set out the prescribed period for entry into the national phase (31

months from the earliest filing date) and provide for the alteration of certain other periods prescribed under the Act. Rule 68(2) states that the prescribed period for the purpose of section 13(2) is either the period prescribed by rule 10(3), i.e. sixteen months from the earliest filing date, or, if it expires later, the period of two months after the national phase begins.

- 15 The Patent Cooperation Treaty is an international treaty with over 150 contracting states, which allows an applicant to seek patent protection in a large number of countries by filing a single international application. The granting of patents remains under the control of each national or regional patent office under the so-called “national phase” (the “international phase” being the period from filing the PCT, or international, application and it entering the national phase). Under the PCT, the international application is filed at a PCT Receiving Office or International Bureau, it is examined with regard to PCT formal requirements, it is searched by an International Search Authority (ISA), it is published by WIPO (the World Intellectual Property Organisation, which administers the PCT) and it may be subject to an International Preliminary Examination by an ISA. The applicant can then pursue grant of the patent before designated national offices by requesting that the international application be treated as a national patent application under each office’s national phase provisions. For the UK, sections 89, 89A and 89B of the Act ensure that international applications which comply with the various provisions of the PCT are deemed to comply with the corresponding provisions of the Act and Rules – there should be no further check or examination in the national phase, thereby avoiding duplication and making it simpler for applicants wanting to file in more than one country. In effect, each country signs up to delegating certain checks to a central body, and when those checks are complete, each country is able to complete any remaining checks as required under national legislation.
- 16 Article 4 of the PCT is concerned with the “Request” for the international application. Article 4(1)(v) says that the Request shall contain the name of and other prescribed data concerning the inventor according to the legal requirements of the designated states for such indications. Alternatively, the indications may be provided in separate notices addressed to each designated office whose national law requires such indications to be provided and that allows such information to be provided after the filing date of a national application. UK national law, as set out above, requires the full names, addresses and postcodes of the inventors to be listed on a Patents Form 7, and this information can be filed after the filing date of a national application (up to sixteen months after the earliest filing date (rules 10(3) and 10(4) of the UK Rules). In other words, it is not necessary for an applicant wishing to enter the UK national phase to provide the necessary indications in the Request as it can do so at a later date. As a safeguard to the applicant, Article 4(4) states that a failure to provide the indications in the Request shall have no consequence in any designated state if national law allows the furnishing of the indications after the filing date of a national application.
- 17 Article 22 states that if an applicant has not included the necessary indications concerning the inventor in the Request then it shall furnish the said indications to the national office not later than the expiration of 30 months from the priority date (or the earliest filing date). Article 22(3) says that national law may fix a later time limit for furnishing these indications. As noted above, rule 68(2)(b) of the UK Rules sets a period of two months after the date on which the national phase begins (giving a maximum thirty-three months from the earliest filing date, which is later than the period of sixteen months specified by rule 68(2)(a) of the UK Rules).

- 18 Rule 4 of the Regulations under the PCT sets out the mandatory and optional contents of the Request. Rule 4.6 says that the Request shall indicate the name and address of the inventor or inventors if national law requires this information to be filed at the time of filing a national application. As already noted above, UK national law does not require the indications to be filed at the time of filing a national application.
- 19 Rule 4.17 says that the Request may contain declarations (“worded as prescribed by the Administrative Instructions”) as to the identity of the inventor or to the applicant’s entitlement to apply for and be granted a patent if this is required by national law. Sections [211](#) and [212](#) of the Administrative Instructions under the PCT set out the precise wording to be used in any such declaration. Rule 4.17 is concerned with declarations relating to certain national requirements allowed under Article 27 and set out in Rules 51*bis*1(a)(i) to (v). For context, Article 27 states that no national law shall require compliance with requirements relating to the form and contents of the international application different from, or additional to, those set out in the Treaty and the Regulations. This ensures that international applications which meet the relevant requirements under the PCT shall be treated as having met the equivalent requirements under national law on entry into the national phase, a cornerstone of the PCT system. Rule 51*bis* sets out various exceptions of national requirements that are allowed under Article 27; for example, a national law may require the applicant to furnish any document relating to the identity of the inventor (Rule 51*bis*.1(a)(i)) or any document relating to the applicant’s entitlement to apply for or be granted a patent (Rule 51*bis*.1(a)(ii)). Rule 51*bis*.2 says that a designated office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence relating to the identity of the inventor or to the applicant’s entitlement if such indications or declarations are contained in the Request or is submitted directly to the designated office. Finally, rule 51*bis*.3 says that the designated office shall give the applicant an opportunity to comply with national requirements once the international application is in the national phase.
- 20 As noted above, UK national law does require declarations as to the identity of the inventor and to the applicant’s entitlement to apply for and be granted a patent. Therefore, if an applicant fails to provide these indications in the Request then it must furnish these indications to the UK Office within two months after entry into the national phase. The relevance of setting out these particular requirements of UK national law and the PCT will become apparent when it comes to considering the applicant’s arguments.
- 21 Article 14 of the PCT deals with examination of the international application by the Receiving Office. The Receiving Office is required to check for certain defects and to invite the applicant to correct the international application within a prescribed time period. If the applicant fails to correct the application then it may be treated as withdrawn. The defects specified in Article 14 are as follows: it is not signed as provided in the Regulations; it does not contain the prescribed indications concerning the applicant; it does not contain a title; it does not contain an abstract; it does not comply to the extent provided in the Regulations with the prescribed physical requirements; the application refers to drawings which are not included; that prescribed fees have not been paid; or that the application does not fulfil the requirements for being accorded a filing date. Rule 26 sets out the procedure for checking and correcting the application in the international phase. Rule 26*ter* deals with the procedure for checking and correcting any declarations under rule 4.17, i.e. the declarations relating to national requirements. Where the Receiving Office finds that any declaration is not worded as required or is not signed as required, it may

invite the applicant to correct the declaration within a time limit of sixteen months from the priority date.

- 22 The PCT Applicant's Guide (National Phase) produced by WIPO provides a very helpful summary of the national phase requirement of the PCT procedure before the national offices. A summary of the national phase procedures and requirements before the Intellectual Property Office is available [here](#). While this does not replace in any way the legal requirements set out under UK national law and the PCT, it does provide a helpful overview of the inter-relationship between the two systems and includes the relevant forms and fees for pursuing an international application through the UK national phase. The Guide explains that if the name and address of the inventor have not been furnished in the Request then they must be furnished within a maximum of 33 months from the priority date (this is the time period set out in rules 66 and 68 of the UK Rules). It adds that this requirement may be satisfied if the corresponding declaration has been made in accordance with PCT Rule 4.17.

The PCT Request and entry into the national phase

- 23 The PCT Request names Dr Thaler as the applicant only in all designated states and includes his address in the United States (part II of the form). The Request names DABUS as the inventor only in all designated states, adding that the invention "was autonomously generated by an artificial intelligence" and providing the same address as Dr Thaler's (part III-1 of the form). The application claims priority from two EP applications, the earliest of which has a filing date of 17 October 2018. The Request includes a declaration under Rules 4.17(i) and 51*bis*1(a)(i) as to the identity of the inventor (at part VIII-1-1 of the form), which repeats the information already provided at part III-1 of the form. No declaration as to the applicant's entitlement to apply for and be granted a patent is included in the Request.
- 24 The applicant requested national processing of the international application for a patent (UK) on a form NP1 filed on 16 April 2021. No further indications concerning the inventor or the applicant's entitlement to apply for a patent were filed at this time.

Arguments and analysis

- 25 The applicant argues that when an applicant has designated the inventor under the provisions of the PCT and the designation has been accepted by the International Bureau (IB) as meeting requirements, the comptroller is bound to accept the designation as meeting the requirements of national law when the application enters the national phase. The applicant says that there is no doubt that the indications concerning the inventor were deemed to meet requirements in the international phase because the published application identifies DABUS as the inventor and because WIPO's registers record the same information. When I pressed Mr Jehan on this point he added that the IB can be taken to have accepted the designation of the inventor because it did not raise an objection to the designation during its examination of the international application.
- 26 The applicant argues that the formalities examiner's objection regarding the designation of inventor is inconsistent with section 89B(1)(c) of the Act. The examiner should not have raised an objection based on section 13(2) of the Act because it is the provisions of the PCT that prevail for international applications in the national phase. It says that the information regarding the inventor pursuant to the PCT is not the same as that required under section 13(2), and adds that the Court of

Appeal made an explicit distinction between a UK application filed under the Act and an application filed as a national phase application from a PCT: at paragraph 95 of the Court of Appeal's judgment, Birss LJ held that had the applications in that judgment been filed pursuant to the PCT then the operation of section 13(2) of the Act would be affected by the deeming provisions of section 89B(1)(c), which the Court did not need to consider.

- 27 I suggested to Mr Jehan that the applicant's interpretation of section 89B(1)(c) could not be correct because section 89B(5) allows the comptroller to refer the national phase application for so much of the preliminary examination under section 15A as is considered appropriate in view of the search and examination carried out under the Treaty (PCT), and section 15A(2)(b) says that the preliminary examination shall determine whether any requirements under section 13(2) remain to be complied with. There would appear to be an explicit requirement here for the Office to undertake an examination of a national phase application with respect to section 13(2). Mr Jehan said that section 89B(1)(c) is the deeming provision in connection with the filing of the designation of inventor when the inventor has been named during the PCT. He said that section 89B(1)(c) requires the Office to treat the statement filed in the international phase under the Treaty as a statement having been filed under section 13(2).
- 28 According to Mr Jehan, section 89B(1)(c) does not give the comptroller the discretion to override that provision. He referred to the hearing officer's comments at paragraphs 33, 41-43 and 49 in *Investigen's Application* ([BL O/009/08](#)) as support for this. In this case, the hearing officer was required to consider the issue of a late declaration of priority in a national phase application and said the following at paragraph 43:
- 43 I therefore have to decide whether, on balance, the absence of such a specific provision indicates that a declaration of priority for a PCT application in the international phase can or cannot be made directly under section 5(2). My initial view is that to allow declarations of priority to be made directly under section 5(2) introduces considerable complexity to the PCT system and its interaction with the national UK system. I do not believe that the provisions of sections 89, 89A and 89B were intended to allow applicants to pick and choose their preferred provisions from the 1977 Act and the PCT. This could cause chaos and confusion. In my view the purpose and effect of sections 89, 89A and 89B is rather to ensure that international applications which comply with various provisions of the PCT are treated as having complied with the equivalent provisions of the UK Patents Act. This will ensure that there are no flaws in a PCT application once it enters the national phase.
- 29 Mr Jehan says that where an applicant has designated the inventor under the provisions of the PCT then it is the provisions of the PCT that apply and not the Act. He says that the formalities examiner was wrong to seek to import a procedural provision of the Act into a PCT application when that procedural provision had been met under the PCT. He says that doing so goes to the heart of the issue set out in *Investigen's Application*, which is also consistent with the application of section 89B(1)(c) in general. He says that the guidance set out in the Office's [Manual of Patent Practice](#) is again consistent with this, for example the parts of paragraphs 89B.02 and 13.12 of the Manual as follows:

89B.02...Subsection (1) provides for various acts (concerning filing, priority and naming of the inventor) done under the PCT to be treated as having been done under the 1977 Act.

13.12...In the case of an international application which enters the UK national phase, Form 7 is not needed if a statement required by the PCT giving the name and address of each inventor has already been filed.

- 30 As further support for this interpretation of section 89B(1)(c), the applicant points to the time limit for filing a statement identifying the inventor under section 13(2), namely 16 months from the priority date (rule 10(3) of the UK Rules). It says that this deadline expires before a national UK application is filed from a PCT and that there is no basis for accepting such a statement at a later date - the Office can do nothing other than to accept the statement provided under the PCT as there is no other mechanism under the Act that would allow it to receive it. I referred Mr Jehan to rule 68(2) of the UK Rules as the basis for extending the period under section 13(2) for providing a statement concerning the inventor in national phase applications. He said that rule 68(2) only applies in cases where the applicant did not provide a statement of the name of the inventor satisfying the PCT in the international phase. In such a case, section 89B(1)(c) would not apply (as no statement had been filed) and a Patents Form 7 would need to be filed on entry into the national phase. He said that the Office could then conduct a preliminary examination under section 15A as allowed under section 89B(5), but it does not apply when a statement under the Treaty has been filed.
- 31 The final line of argument from the applicant is that it is not open to the Office to refuse an application on the basis that the statement under section 13 does not meet the necessary requirements (the formalities examiner had said that if the applicant did not file the necessary statement concerning the inventor by a particular date then the application may be refused). I can deal with this very briefly because I informed Mr Jehan at the hearing that I agreed with his interpretation of the law. Section 15A(7) says that the comptroller may refuse an application if the applicant fails to amend the application in order to satisfy formal requirements. A statement under section 13(2) is not designated as a formal requirement for the purposes of the Act, so a failure to comply cannot result in a refusal of the application. Instead, section 15A(9) says that the comptroller must only "inform the applicant accordingly" if any requirement of section 13(2) has not been complied with. Once informed of the lack of compliance, the applicant can either provide a statement that meets the requirements within the prescribed time period or else, if it does not, the application shall be taken to be withdrawn.
- 32 As to the question of whether, or to what extent, it is open to the Office to conduct a preliminary examination of the statement of inventorship in a national phase application then, again, I believe I can deal with this fairly briefly. Mr Jehan argues that the IB has deemed the indications concerning the inventor included in the Request as meeting the requirements of the PCT. However, Article 14 does not require the Receiving Office to check for defects in the indication of inventor included in the international application, and Rule 26ter2 merely requires the Receiving Office to check whether the wording of any declaration made under Rule 4.17 is worded as required, i.e. as prescribed by the Administrative Instructions. There is therefore no basis in the PCT for an examination of whether the indication of the inventor satisfies requirements other than the form of the wording used. The reason why the International Bureau did not raise an objection to the designation of DABUS as the inventor during its examination of the international application is that there is no basis in the PCT for it to do so.

- 33 If there is no basis in the PCT to examine the requirements concerning the inventor then it seems that either such an examination is carried out in the national phase to the extent that each national office considers it necessary to satisfy its own national law or, following Mr Jehan's line of argument (when the indications have been provided in the international phase), not at all. I do not think Mr Jehan's position can be right. When Rule 51*bis* specifically allows for national offices to require applicants to provide information concerning the identity of the inventor in cases where such information is required by national law, it cannot have been the intention to allow some applications to be examined with respect to a requirement of national law and others to be ignored simply because of the filing route chosen by the applicant. This appears to be the very point made by the hearing officer in *Investec's Applications*.
- 34 So what then does the deeming provision of section 89B(1)(c) mean if this cannot have been its intention? Section 89B(1)(c) says that any statement of the name of the inventor under the Treaty shall be treated as a statement filed under the section 13(2). The formalities examiner argues that it must mean that the information provided as part of the Request in the international phase must be treated as if it were filed within the prescribed period and made on Patents Form 7 as set out in rules 10(3) and 10(4) of the UK Rules, which are requirements concerning the indications of the inventor required by UK national law. According to this interpretation, any information provided in the international phase would be treated in the same way as any other national application, and the Office would be obliged to accept the information despite it having been filed much later than required under national law. The applicant's interpretation of section 89B(1)(c) goes further, in that not only is the information deemed to have been filed on time and made on the right form consistent with UK national requirements, but extends to it saying that national requirements concerning the naming of inventor are also deemed to be satisfied. Given that no examination of the requirements concerning the indication of the inventor is carried out in the international phase, this second interpretation doesn't seem logical.
- 35 Whatever one considers the correct interpretation of section 89B(1)(c) to be, there appears to be no doubt that the comptroller has explicit power under section 89B(5) to undertake its own examination of the indications concerning the inventor in a national phase application to the extent it considers appropriate in view of any examination or search carried out under the Treaty. The whole point of the PCT system is to avoid work being carried out in the international phase and for the same work to be duplicated in the national phase. If an examination of requirements concerning inventor is carried out by the Receiving Office then the same examination cannot be repeated by a national office in the national phase. As Mr Jehan says, it is clearly the case that if such information is not provided in the international phase then it must be examined by the national office in the national phase and the applicant be given an opportunity to comply with requirements. However, given that the PCT does not provide for an examination concerning the indication of inventor in the international phase then it would seem that such an examination must be carried out in the national office, regardless of when the information is provided.
- 36 If I am wrong as to the extent of examination concerning the indication of inventor carried out by the Receiving Office and that Mr Jehan is correct to say that the indication has been found to fully meet requirements of national law, then to what extent does section 89B(1)(c) still allow the comptroller to repeat the examination when it knows that the application does not meet requirements? The Court of Appeal has said that the naming of DABUS as inventor does not meet the requirements of

section 13(2). Knowing that this application does not meet the requirements of national law then it seems entirely appropriate for the comptroller to undertake examination of the application in view of the ineffective examination carried out under the Treaty, as provided for by section 89B(5).

- 37 Drawing all of this together, I consider that the deeming provision of section 89B(1)(c) means that the information concerning the inventor provided as part of the Request in the international phase must be treated as if it were filed within the prescribed period and made on Patents Form 7 as set out in rules 10(3) and 10(4) of the UK Rules. It does not mean that the information provided in the international phase should be deemed as meeting requirements of national law. If I am wrong on this then I consider that section 89B(5) allows the comptroller to examine whether the requirements of section 13(2) have been met in view of the clear conflict between the finding of the Court of Appeal and whatever examination was carried out under the Treaty (none, according to my assessment). Either of these routes results in a preliminary examination before the Office, and the formalities examiner was right to say that the requirements of section 13(2) had not been met, but wrong to say that the application would be refused.

Auxiliary Request Form 7

- 38 The applicant asks that if the Office is minded to refuse the applicant's designation of inventor under the PCT then it should consider the applicant's Auxiliary Request Form 7 which gives an indication of the applicant's right to be granted a patent and which identifies no person as the inventor. The applicant submits that this auxiliary request is permissible for the reason that there is no lawful prior time limit that applied to the filing of the form and that it is in accordance with the Court of Appeal's judgment (paras 79 and 80 from Birss LJ, para 101(ii) from Laing LJ and para 147 from Arnold LJ). I do not agree with Mr Jehan that these paragraphs from the Court of Appeal's judgment support the position that an applicant who could not in all honest belief name a person as inventor and indicated as such on a Patents Form 7 would meet the requirements of section 13(2). Birss LJ clearly finds this to be the case, but Arnold LJ and Laing LJ, who reached a different overall finding to Birss LJ, do not address the issue. In any case, and contrary to the applicant's argument, the Auxiliary Request Form 7 is filed after the prescribed period set out in rule 68(2)(b) of the UK Rules (two months beginning immediately after the date on which the national phase begins), so it does not comply with section 13(2) for that reason alone.

Appeal to Supreme Court

- 39 The applicant argues that it would be reasonable to not reach a decision in the present case until the Supreme Court has decided whether the Court of Appeal's judgment is the final word on the matter (or at the least until the Supreme Court has considered the application for permission to appeal). The formalities examiner argues that the Court of Appeal was not asked to consider what effect the deeming provisions of section 89B(1)(c) might have and so there is no justification for delaying a decision in this case.
- 40 I agree with the formalities examiner that the issue here is different to that before the Court of Appeal and that there is no reason why I should delay the issue of this decision.

Indication relating to the applicant's derivation of right to apply

- 41 Section 13(2) refers to a requirement for the applicant to provide two statements within a prescribed time period, namely a statement under subsection (a) identifying the person or persons believed to be the inventor and a statement under subsection (b) indicating the applicant's derivation of right to be granted the patent. Section 89B(1)(c) refers only to a statement of the name of the inventor filed under the Treaty as being treated as a statement filed under section 13(2). There is no mention of treating any statement concerning the applicant's entitlement to apply for and be granted a patent filed under the Treaty to be treated as if it were filed under the Act, which seems odd. In any case, I said at the hearing that this was likely to mean that the Office was prevented from examining the indication concerning entitlement in a national phase application. On further reflection I do not consider that this is correct. Regardless of the reason for why the statement on entitlement is not included in section 89B(1), sections 89B(5) and the preliminary examination under section 15A allow the Office to undertake as much of the examination in order to determine whether the requirements of section 13(2) are met. There is no basis in the PCT for an examination of whether the indication of the applicant's right to be granted a patent satisfies requirements other than the form of the wording used. Since examination of the requirement is not carried out in the international phase then it must be carried out in the national phase.

Conclusion

- 42 I have found that section 89B(1)(c) of the Act does not preclude the Office from undertaking an examination of the indication of an inventor in an international application upon entry into the national phase. The Court of Appeal has said that the naming of DABUS as an inventor does not meet the requirements of section 13(2) of the Act and so the application is taken to be withdrawn. The Auxiliary Request Form 7 is filed outside the prescribed period.

Appeal

- 43 Any appeal must be lodged within 28 days after the date of this decision.

HUW JONES

Deputy Director, acting for the Comptroller