

## **PATENTS ACT 1977**

### **IN THE MATTER OF**

Patent Application Number GB9717298.5

in the name of Siemens Medical Systems, Inc

### **DECISION**

#### **Introduction**

1. Patent application number GB9717298.5, entitled “system for and method of aligning a radiation beam”, was filed under the Patents Act 1977 (“the Act”) on 14 August 1997 in the name of Siemens Medical Systems, Inc, and on 25 March 1998 it was published as GB2317545A. On 1 April 1998 a Patents Form 10/77 was filed with its fee requesting substantive examination. In a letter dated 15 March 1999 the applicant’s agents, Haseltine Lake & Co, wrote “... to confirm that this application is to be withdrawn and to request a refund of the examination fee ...”. Before the Office was able to act on this letter and terminate the application a telephone call was received from the agents on 19 March 1999. According to the official letter of the same date confirming the telephone conversation, the agent advised that she had received by fax further instructions from her client requesting that this application not be withdrawn. She asked whether it would be possible to rescind the instructions to withdraw the application which were contained in the agent’s letter dated 15 March, but was told, with reference to section 14(9) of the Act, that it was not possible to revoke the withdrawal of an application. The agents faxed a letter to the Office later on 19 March, confirming the request to retract the withdrawal and providing supporting argument.

2. There followed exchanges of correspondence between the Office and the agents on whether, in the circumstances of this case, the original withdrawal could be set aside or otherwise be treated as ineffective. At one point the agent requested a hearing at which to submit oral arguments in support of the request to retract the letter of withdrawal, but subsequently stated that the applicant no longer wished her to attend a hearing, and instead a formal decision based on the papers filed was requested. I have therefore read very carefully all the papers which the agents have submitted in coming to the following decision.

## The Facts

3. The train of events leading up to the letter of withdrawal of 15 March 1999 is set out in the agents' letter of 21 April 1999. I have no reason to doubt the veracity of that account and willingly quote the relevant part *verbatim*. It reads:

“The request to withdraw the application contained in our letter dated 15<sup>th</sup> March 1999 was sent owing to a clerical error in the communications between the applicant and our client, Siemens AG. We request that we be allowed to retract our letter dated 15<sup>th</sup> March since it was filed in error and did not reflect the intentions of the applicant, Siemens Medical Systems, Inc.

We were instructed to file this application by the United States agents for the applicants, Siemens Corporation, and we were instructed to report all further developments in connection with the application to our client Siemens AG.

A German language Siemens AG form was filled out incorrectly by an English-speaking employee of the United States agents for the applicants. As a result Siemens AG sent us a letter dated 19<sup>th</sup> February 1999 instructing us that no further costs were to be incurred in connection with the application. We wrote to Siemens AG on 4<sup>th</sup> March 1999 informing them that we would withdraw the application unless instructions to the contrary were received by 15<sup>th</sup> March 1999, and accordingly we wrote to the Patent Office on 15<sup>th</sup> March 1999 to withdraw the application. On 19<sup>th</sup> March we received a fax from Siemens Corporation informing us that the application was not to be withdrawn. On receipt of this fax from Siemens Corporation, we telephoned and wrote to the Patent Office on 19<sup>th</sup> March 1999 to retract our letter dated 15<sup>th</sup> March 1999.

From the above it is clear that the instructions which we received from Siemens AG in the letter dated 19<sup>th</sup> February 1999 were issued in error and did not correspond to the intentions of the applicant, Siemens Medical Systems, Inc.”

## **Error, Section 117, Rule 100**

4. The agents' letter of 21 April goes on to say:

“In view of the above, the Comptroller is requested to allow us to retract our letter dated 15<sup>th</sup> March 1999 since the letter was filed in error. Specifically, the Comptroller is requested to allow us to retract our letter dated 15<sup>th</sup> March 1999 under Section 117 Patents Act 1977 and under Rule 100 Patents Rules 1995.”

5. In an earlier official letter of 22 March 1999, the agents' attention had been drawn to a relatively recent and highly relevant decision of the comptroller, namely that given in the case of *Spectra-Tech Inc's Application* [1999] RPC 187. I do not propose to recite extensive passages from that very detailed decision here, but a short summary will be helpful.

6. In *Spectra-Tech*, the applicant's agents wrote to withdraw a patent application and to request a refund of certain fees. The withdrawal was made under section 14(9) of the Act, which reads:

“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.”

The Patent Office acted on the letter and termination of the application was recorded in the Register of Patents. In a subsequent telephone call and letter, the agents sought to revoke the withdrawal request. As in the present case the agents and the Office exchanged views in correspondence, but unlike the present case an oral hearing was held.

7. The comptroller's decision in *Spectra-Tech* contained a number of main findings relevant to the present case. These may be conveniently summarised by selectively quoting from the headnote on page 188 as follows:

“(3) The provisions of section 14(9) were mandatory and specific. If a clear and unambiguous request was made by the applicant or his authorised agent to withdraw an application, it could not be revoked.”

“(4) Irrespective of the circumstances of the errors or mistakes in the withdrawal of an application, or the merits of the requested corrections in the documents filed in connection with it, the Comptroller had no power to entertain the use of section 117 to override a withdrawal properly made under section 14(9). This would mean using a general enactment to override a particular enactment of the statute.”

“(7) Invoking rule 100 as a means of retracting a withdrawal request would involve using a general provision to override a particular mandatory enactment and must therefore be rejected.”

8. The conclusion reached in *Spectra-Tech*, as stated on page 201, reads as follows:

“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.”

9. It will immediately be seen that the three findings I have drawn from the headnote and the conclusion from the decision itself are in large measure statements of general principle not closely bound up with the specific facts of the case. It seems to me that in deciding whether those principles apply in the present case the main question I have to consider is whether a clear and unambiguous request for withdrawal under section 14(9) was made.

10. The withdrawal request was made in the agents’ letter of 15 March 1999. It read:

“Re: United Kingdom Patent Application No. 9717298.5 (2317545)  
Siemens Medical Systems, Inc.\_\_\_\_\_

We write to confirm that this application is to be withdrawn and to request a refund of the examination fee which was paid on 1<sup>st</sup> April 1998.”

11. On a plain reading it seems to me that this letter is indeed clear and unequivocal. It confirms that the application is to be withdrawn and requests a refund of the examination fee. 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. The fact that it does not explicitly refer to section 14(9) is not I feel significant. Withdrawal requests do not routinely contain such a reference, nor do they need to do so to be effective; it is implicit that the withdrawal is being made under section 14(9).

12. Having found that a clear and unambiguous withdrawal request under section 14(9) was made in the present case, and applying the reasoning expounded in detail in *Spectra-Tech*, I am driven to the conclusion that, irrespective of any error in the communication chain leading to the making of the request, no power is available under section 117 or rule 100 enabling the comptroller to override it.

#### **The agents' further submissions**

13. That is not the end of the matter, however, as in their letters the agents present a number of arguments why the present case on its facts falls outside the ambit of the principles recited in *Spectra-Tech*. Although as I have said those principles are largely independent of the facts of that case, it is also true that that case is not on all fours with the present one. The agents' specific submission in their letter of 21 April 1999 that, for reasons they give, section 14(9) and the *Spectra-Tech* decision are not relevant to their request to retract their letter dated 15 March 1999 therefore deserves careful consideration. I shall take each of the agents' reasons in turn.

#### **The effective date of withdrawal**

14. The agents' central argument concerns what they call "the effective date of a withdrawal". As they rightly say, this was not a point addressed in *Spectra-Tech*. It is made in their letter of 21 April 1999 in the following terms:

"We submit that the effective date of a "withdrawal" of an application within the meaning of Section 14(9) Patents Act 1977 is the date on which the Register is updated to show that the

application is withdrawn. Since we requested retraction of our letter dated 15<sup>th</sup> March 1999 on 19<sup>th</sup> March 1999, before the Register had been updated in response to our letter dated 15<sup>th</sup> March 1999, we submit that withdrawal of the present application within the meaning of Section 14(9) Patents Act 1977 cannot be considered to have taken place prior to our request to retract our letter dated 15<sup>th</sup> March 1999. Thus Section 14(9) Patents Act 1977 is no bar to the acceptance of our request to retract our letter dated 15<sup>th</sup> March 1999.”

15. As I have already noted, section 14(9) states:

“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.”

Consistent with the well-established principles of statutory interpretation, I look first at the natural and ordinary meaning of these words in context. In doing so, it seems to me that they say two things. The first is that a patent application may be withdrawn at any time before grant; the second is that *any* such withdrawal may not be revoked. The provision seems quite clear. In particular, the second limb does not lay down or imply any derogation, temporal or otherwise, from the irrevocability of a withdrawal. It does not even hint that, to be “effective”, a withdrawal is dependent on any act beyond its being made or filed, nor in particular that the date on which the Register is updated is significant. This interpretation does not lead to a result which cannot reasonably have been supposed to be the intention of the legislature, and I need therefore look no further for other interpretations the words of the sub-section might bear. Thus, I find nothing in the wording of section 14(9) itself to support the agents’ concept of an effective date of withdrawal which is later than the date on which it is filed at the Patent Office.

16. In support of their argument, the agents further submit:

“We believe that as a matter of public policy it is clear that the effective date on which an application is to be considered withdrawn is the date on which the Register is updated to show that the application is terminated before grant, not the date of receipt of a letter requesting that the application is withdrawn by the Patent Office.

In this respect it is clear that owing to the internal arrangements of the Patent Office, there will be a short delay between the receipt of a letter requesting that the application is withdrawn by the Patent Office and the updating of the Register to indicate that the application has been withdrawn. ....”

17. With respect, I do not believe I should look for extrinsic public policy considerations in construing the statute when it is, as I have said, intrinsically clear on its own terms. Equally, I do not see section 14(9) as making any allowance for processing within the Office. I read it as saying that once made, that is filed not published, the withdrawal cannot be retracted.

18. The agents also argue:

“The purpose of Section 14(9) Patents Act is to provide legal security for third parties. However, until the Register is updated to show that the application is withdrawn the public is unaware of the existence of the letter requesting withdrawal of the application. In this respect we note that any correspondence received in connection with an application is not open for inspection until 14 days after it has been filed at the Patent Office, in accordance with Rule 93(4)(a) Patents Rules 1995. Therefore the updating of the register is the first notification of the withdrawal of the application available to a third party, and should therefore be considered to be the effective date on which the withdrawal takes place.”

19. I accept that legal certainty is central to the purpose of the sub-section. However, that certainty is at least as much provided by regarding withdrawals once filed as being binding as it would be by applying some other trigger, such as the making of an entry in the Register. The point based on the 14-day period under rule 93(4)(a) is interesting, but in my view ultimately works against the agents’ cause. It is not the case that other documents filed in connection with an application are not effective until the 14-day period has elapsed. They are effective, but simply not open to public inspection. That as I see it is precisely the situation here too. Thus the rule 93 point if anything supports the immediate effect of a withdrawal on filing.

20. The agents also argue that the wording of the entry made in the Register recording a withdrawal is indicative that the application is withdrawn on the date on which the Register is

updated. However, I am not persuaded that a form of words which may be used in the Register carries any weight when compared with the factors I have already considered.

21. Thus, having considered the agents' submissions on what they call the "effective date of withdrawal", I hold to the view that the withdrawal request is operative as of the date it is filed, provided it is clear and unambiguous. It follows that I do not accept the agents' proposition in the present case that the withdrawal was retracted before it became effective. Coupled to my reading of the letter of 15 March 1999 as being clear and unambiguous, I conclude that a withdrawal request was properly filed under section 14(9), and hence that the conclusion I reached in paragraph 12 above by applying the principles recited in *Spectra-Tech* is not impugned.

### **EPO Decision J10/87**

22. For completeness, I should mention that the agent's letter dated 19 March 1999 draws the comptroller's attention to European Patent Office ("EPO") Decision J10/87 *Inland Steel/ Retraction of withdrawal* [1989] EPOR 437, abridged OJEPO 1989, 323. In the agents' view, this was a case where the EPO allowed the retraction of a withdrawal made erroneously by an agent as a correction under rule 88 of the European Patent Convention ("EPC") because publication of the withdrawal in the OJEPO had not then been made. Since withdrawal of the present application had not been made available to the public at the time of the requested retraction, the agent requested that a similar decision be taken to that made by the EPO.

23. In fact, EPO Decision J10/87 was carefully considered on pages 198 and 199 of the *Spectra-Tech* case. The view taken there was that the legal bases for withdrawal of an application under the EPC and under UK law were different. In the relevant parts of the EPC there is no suggestion that a withdrawal may not be revoked, whereas in UK law section 14(9) of the Act explicitly and unequivocally states that any withdrawal may not be revoked. The conclusion was that the EPO Decision in J10/77 is based on a different legal foundation from that governing the comptroller under the Act, and hence that J10/87 was of no assistance. I believe that is precisely the position in the present case for the same reasons.

## **Conclusion**

24. In summary, having carefully considered all the submissions put forward by the agents, I find that their letter of 15 March 1999 did constitute a request under section 14(9) for the withdrawal of the patent application, that it may not be revoked, and that the comptroller does not have the power to use section 117 or rule 100 to correct or otherwise override that withdrawal or any other means to regard it as being ineffective. The application therefore stands withdrawn. I should add that I do not reach this conclusion without some sympathy with the applicant, but I do not believe I have any discretion to come to a different view.

## **Appeal**

25. Since this decision determines the substance of the matter in issue, any appeal against this decision shall be filed within six weeks of the date of this decision.

Dated this 21<sup>st</sup> day of February 2000

S N DENNEHEY

Divisional Director, acting for the comptroller

**THE PATENT OFFICE**