

**PATENTS ACT 1977**  
(THE PATENTS RULES 2007)

APPLICANT Nanjing University

ISSUE Whether international patent application  
PCT/CN2017/088403 should be reinstated  
under section 20A and be allowed to enter  
the UK national phase

HEARING OFFICER H Jones

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**DECISION**

**Introduction**

- 1 International patent application PCT/CN2017/088403 (“the international application”) was filed at the State Intellectual Property Office of China (SIPO) in the name of Nanjing University on 15 June 2017, SIPO being a receiving Office under the Patent Cooperation Treaty (PCT). The international application claims priority from Chinese patent application CN201610236484 (“the priority application”) filed on 15 April 2016. The difference of fourteen months between the filing dates of the two applications has led to problems with the international application entering the European regional phase at the European Patent Office (EPO) and then the national phase here in the UK, leading eventually to the matter coming before me for a decision on whether to reinstate the national phase application. The facts can be summarised in chronological order as follows.

**European regional phase**

- 2 A request for entry of the international application into the European regional phase was made by the applicant’s attorney, Hanna Moor + Curley, on 12 October 2018. The EPO wrote to the applicant on 22 October 2018 to confirm that the applicant’s request for early processing under Article 23(2) of the European Patent Convention (EPC) took effect on 12 October 2018, adding that the international phase of the application was terminated and drawing the applicant’s attention to various formal requirements for entry into the European phase. The European application was given the number EP17781961.2.
- 3 The EPO wrote to the applicant again on 25 October 2018, drawing attention to the possibility of requesting restoration of the rights of priority under Rule 49ter.2 PCT and an invitation to file observations under Rule 49ter.1(d) PCT, adding that the decision of the receiving Office (in this case SIPO) to restore the right of priority based on the criterion of unintentionality has “no effect in proceedings before the EPO (Rule 49ter.1(b) PCT)”. The relevant parts of the PCT Regulations read as follows:

*49ter.1(b) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion.*

*(c) A decision by the receiving Office to restore a right of priority under Rule 26bis.3 shall not be effective in a designated State where the designated Office, a court or any other competent organ of or acting for that designated State finds that a requirement under Rule 26bis.3(a), (b)(i) or (c) was not complied with, taking into account the reasons stated in the request submitted to the receiving Office under Rule 26bis.3(a) and any declaration or other evidence filed with the receiving Office under Rule 26bis.3(b)(iii).*

*(d) A designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement referred to in paragraph (c) was complied with, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for that doubt and giving the applicant an opportunity to make observations within a reasonable time limit.*

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#### *49ter.2 Restoration of Right of Priority by Designated Office*

*(a) Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period:*

- (i) occurred in spite of due care required by the circumstances having been taken; or*
- (ii) was unintentional.*

*Each designated Office shall apply at least one of those criteria and may apply both of them.*

*(b) A request under paragraph (a) shall:*

*(i) be filed with the designated Office within a time limit of one month from the applicable time limit under Article 22 or, where the applicant makes an express request to the designated Office under Article 23(2), within a time limit of one month from the date of receipt of that request by the designated Office;*

*(ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (c); and*

*(iii) be accompanied by any fee for requesting restoration required under paragraph (d).*

- 4 The applicant was invited to file observations in relation to the restoration of right of priority within two months but did not do so.
- 5 The EPO wrote to the applicant on 11 December 2018 saying that the right to priority had been lost because no reason had been provided for the late claim beyond the one accepted by the receiving Office, which could not be accepted by the EPO. The applicant was given two months to challenge this decision.

- 6 Noting the EPO's decision in respect of the lost claim to priority, the applicant's attorney wrote to the EPO on 11 January 2019 requesting restoration of the priority right and for further processing of the European application. This letter also set out the circumstances in which the applicant's late claim to priority was unintentional and how all due care had been exercised. The EPO replied on 21 January 2019 saying that the agent's requests did not amount to a challenge of the decision regarding loss of priority rights and that the deadline for providing reasons for the failure to file the international application within the priority period had now lapsed. The applicant asked the EPO to withdraw the European application on 4 March 2019.

### **UK national phase**

- 7 A request for entry of the international application into UK national phase was filed at the UK IPO ("the Office") on 13 February 2019, some three weeks after the letter from the EPO informing the applicant of the final rejection of the late claim to priority on its European application. The UK national phase application ("the UK application") was given the number GB1902006.4. By this time, the 31-month period for entering the national phase had already passed (on 15 November 2018), so the request for entry into the UK national phase was also accompanied by a request to extend the 31-month period to enable it to be filed in time (such requests are provided for by rules 108(2) and 108(3) of the UK Patents Rules). A detailed explanation of the circumstances leading to the late request for entry into the UK national phase was provided together with arguments as to why the comptroller should exercise discretion to allow such late entry.
- 8 Not only was the request for entry into the UK national phase filed after the 31-month period allowed for doing so but the request to extend the prescribed period under rules 108(2) or 108(3) had also expired. Under rule 108(2), the comptroller "shall extend" any period of time set out in part 2 Schedule 4 of the Rules (which includes the time period for entry into the national phase (rule 66(1)) by a period of two months, provided that the request is made before the end of the extended two-month period. In other words, the 31-month period could have been extended by two months as of right if the request to extend had been made by 15 January 2019.
- 9 The Office wrote to the applicant on 18 February 2019 saying that the request to extend the period for entry into the national phase could not be allowed because the request to extend had itself been made too late. Although the Office letter does not specifically say so, the UK application was now taken to be withdrawn under section 89A(4) and therefore it was suggested that the applicant could apply for reinstatement of the application under section 20A. This letter noted that a request to reinstate the application is not automatic and could be refused.
- 10 A request to reinstate the application was filed on 7 March 2019 and evidence to support the request was filed on 5 June 2019. Section 20A requires that where an application for a patent is taken to be withdrawn as a direct consequence of a failure to comply with any section of the Act or Rules within a specified period, the comptroller shall reinstate an application if, and only if, he is satisfied that the failure was unintentional. The Office informed the applicant that it was minded to refuse reinstatement of the application because the evidence did not show that the failure was unintentional. After further submissions from the applicant's attorney, the Office maintained its view that the unintentional test had not been passed and that it was minded to refuse reinstatement.

- 11 The applicant's attorney requested a hearing on the matter and this hearing took place by teleconference on 15 January 2020, with Ms Marie Walsh of Hanna Moore + Curley representing the applicant. At the hearing and immediately afterwards, I invited further submissions regarding the circumstances leading up to the filing of the application, which were duly received and I deal with in more detail below.

### **The unintentionality test**

- 12 There is no definition in the Act or Rules as to what is meant by "unintentional" as it applies for determining whether to allow a request for reinstatement of a patent application. Paragraphs 20A.13-16 of the Office's Manual of Patent Practice (MPP) provide guidance on the meaning of "unintentional". In summary, the requirement to show an intention to file an application in time differs from the test of "continual underlying intention to proceed". Case law under rule 108 may be of relevance in analysing the evidence to establish the applicant's intentions. In a situation where the applicant had an underlying intention to enter the application into the national phase, the decision not to pay the prescribed fee in time was a conscious one based on his knowledge of his "impecunious state", and as such the failure to comply could not have been unintentional. The guidance at paragraph 123.37 of MPP in respect of rule 108 is also relevant:

*123.37 Discretion should be exercised favourably if it is shown that the failure to meet the time period was unintentional at the time that the period expired (except where the extension of time is for the filing of a divisional application – see 15.21). This is consistent with the statutory test that applies to requests for reinstatement under s.20A (see 20A.13-16 for guidance on the meaning of unintentional). However, since rule 108 sets out no statutory test for discretionary extensions of time, discretion may be exercised favourably in appropriate circumstances even if the unintentional criterion does not appear to have been met. Prior to the introduction of the reinstatement provisions under s.20A, a number of cases were decided on the basis that there must have been a continuing underlying intention to proceed with the application or patent; a change of mind regarding whether to proceed on the part of those responsible for its prosecution was held in Heatex Group Ltd's Application ([1995] RPC 546) not to be a legitimate reason for favourable exercise. In Meunier's International Application (BL O/013/01), the applicant had chosen to acquire patent protection in the UK via an EP(GB) designation of his international application, rather than by continuing with a GB designation and national phase entry. When it was discovered that, by mistake, EP(GB) had not been designated, a request for the application to belatedly enter the national phase directly was refused by the hearing officer, who regarded this as a change of mind, despite a continuing underlying intention on the part of the applicant to protect his invention in the UK. In a broadly similar set of circumstances, the hearing officer in Pilat's International Application [2003] RPC 13 came to the same conclusion...*

- 13 What I take from this guidance is that the applicant needs to demonstrate that it intended to file the UK national phase application before the time period for doing so had expired and that the failure to do so was unintentional. Actions need to support the intended deed.

### **Was the late request to enter the national phase unintentional?**

- 14 The evidence provided in support of the applicant's intent to file a UK national phase application is as follows.
- 15 The reference number given to the UK national phase application has a suffix GB, which Ms Walsh suggests is a clear demonstration of the applicant's intent to file at the UK Office. At the hearing I asked Ms Walsh when this reference number had

been created and she confirmed that it would have been at the time when the UK national phase application was being prepared, in other words after the notification of loss of priority claim by the EPO.

- 16 In her second witness statement, Ms Walsh explains how they were instructed to proceed with the filing of the European application and refers to a copy of the letter of instruction (dated 29 September 2018) that had been submitted in previous correspondence (on 13 February 2019). She says that they were not informed that an application to file a request for restoration of priority had been filed and allowed on the PCT application. She explains that the request for priority was allowed by SIPO on the basis of the same standard that is applied by the UK IPO, namely unintentional rather than the higher standard of all due care which is applied by the EPO. Had they been aware of the restoration of priority during the international phase then she would have advised the applicant that in order to proceed with their intention of obtaining UK protection, that this should be achieved by a national phase entry directly into the UK IPO rather than by means of an EPO filing. The counter argument from the Office is that the attorney should have been aware of the fourteen-month difference between the priority date and filing date of the international application from the bibliographic data on the front page of the PCT publication.
- 17 Ms Walsh explains in her second witness statement that when they filed the European application, it was on the assumption that the priority was valid and that it was not until the letter from the EPO dated 21 January 2019 that they realised that the priority claim was being refused without recourse. Ms Walsh expanded upon this at the hearing, saying that had she been alerted to the issue regarding priority when initial instructions were received or alternatively by the EPO before the letter of 21 January 2019 then she would have taken steps to request entry into the UK national phase either within the specified period for doing so, i.e. by 15 November 2018, or within the further two-month period allowed for by rule 108(2), i.e. by 15 January 2019. After the hearing I became aware of three letters sent by the EPO to the applicant's attorney before 21 January 2019, that could possibly have alerted the applicant to a problem with the claim to priority at the EPO, these letters being dated 22 October 2018, 25 October 2018 and 11 December 2018. I invited Ms Walsh to file further submissions within a week of the hearing and she did so by way of a third witness statement dated 24 January 2020.
- 18 In her third witness statement, Ms Walsh explains that the EPO letter dated 22 October 2018 only acknowledges the applicant's request for early processing and makes no mention of any problem with the application at the EPO. For the letter dated 25 October 2018, Ms Walsh acknowledges that it draws attention to the possibility of loss of priority right but the significance of it was not apparent to her at the time as it was not stated nor was it clear that the application could not proceed further at the EPO. For the letter dated 11 December 2018, which provides a clear indication of loss of rights, Ms Walsh says that the applicant filed a request for further processing and that this in itself demonstrates that the significance of the notice was not clear and that they were still under the impression that the European application could go ahead in order to obtain patent rights in the UK. Ms Walsh confirms that there was still at this time and at all times an intention by the applicant to obtain patent rights in the UK.
- 19 Taking all of the evidence into account, I find that none of it demonstrates an intention to request entry of the international application into the UK national phase before the extended time period for doing so, i.e. by 15 January 2019. The best that

the evidence demonstrates is an intention to seek patent protection covering the UK, but the applicant's initial strategy was to do so by way of a European patent application designating the UK and not by way of a national filing. Ms Walsh's argument that had they known of the problem with the priority date then they would have advised the applicant to pursue the UK national filing is not supported by the correspondence from the EPO, which clearly alerts the applicant to a problem with the priority application in late October 2018 and confirms the consequence of the problem in December of the same year, i.e. when the EPO notified the applicant of its decision to not accept the claim to priority. The applicant could have challenged this decision but did not do so. Even at this point, it was still possible for the applicant to file a request to enter the UK national phase before the extended deadline for doing so, but no such request was made. It seems that the request was only made when it became clear that there was no possibility of retaining the priority claim at the EPO, which Ms Walsh says only became evident by way of letter dated 21 January 2019. However, I consider that the attorney should have been alert to the issue regarding late claim to priority a lot earlier than this and certainly in time for timely entry into the national phase, if that was the applicant's intention.

### **Conclusion**

- 20 I have found that the applicant did not intend to request entry of the international application into the UK national phase before the time period for doing so had expired and so the failure to do so cannot be considered to be unintentional. UK application GB1902006.4 will not be reinstated.

### **Appeal**

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

**HUW JONES**

Deputy Director, acting for the Comptroller