



## PATENTS ACT 1977

APPLICANT	Intermec, Inc
ISSUE	Whether to allow a correction to patent application GB1716996.2 under s.117(1) of the Patents Act
HEARING OFFICER	Stephen Brown

---

## DECISION

### Introduction

- 1 Patent application GB1716996.2 (henceforth, 'the application') was filed on 16 October 2017. It claims priority from US application 15/343553 (the priority application) with a priority date of 4 November 2016. It has not yet been published. On filing, the application, both on the first page of its description and on Patents Form 1, was entitled "Systems and Methods for a Reconfigurable Antenna".
- 2 On 13 April 2018 the Examiner contacted the attorney for the applicants, Mr Nicholas Fox-Male of Patent Outsourcing Limited, to notify him that an incorrect set of drawings appeared to have been filed. The examiner reached this conclusion as the drawings did not match the accompanying description.
- 3 On 27 April 2018 the attorney replied filing a new specification (including a new description, new claims and new drawings). The first page of this description was entitled "Systems and Methods for Controlling Radio Frequency Identification (RFID) Tag Communication". The attorney requested that the new specification be considered a correction under s.117 and Rule 105 of the Patents Act 1977. The specification matched that of the priority application US 15/343553.
- 4 The Examiner replied via a letter dated 15 May 2018, stating they were unable to accept the proposed correction as although it was clear that there was an error, it was not clear that the new specification was what was originally intended. Despite further correspondence, the Attorney and the Examiner have been unable to come to an agreement over this issue. The Attorney initially requested a hearing in their letter of 6 June 2018 but in a later letter, on 10 September 2018, changed this to request a decision be made upon the papers on file. The matter then came before me.

## The Law & Office Practice

- 5 Correction of errors in patent applications is set out in s.117(1) of the Patents Act 1977, which states:

*The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.*

- 6 This power is subject to Rule 105(3) of the Patents Rules 2007. This states:

*Where the request is to correct a specification of a patent or application, the request shall not be granted unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification).*

- 7 The Office construes Rule 105(3) as imposing a two-step test, usefully laid out in s.117.07 of the Manual of Patent Practice, as follows:

*(a) is it clear that there is an error, and*

*(b) if so, is it clear what is now offered is what was originally intended?*

From the papers, the Attorney appears content to agree that this is the correct test for determining the allowability of a proposed correction under section 117(1).

## Analysis

- 8 Both the Examiner and the Attorney agreed that the first step of the test is met, and to my mind, this is correct. As originally filed, it is readily apparent that the description and the figures do not match. For example, the description does not refer to all of the figures filed and the corresponding discussion of those figures is not in agreement with what they illustrate. It is clear that something is wrong.
- 9 As mentioned in the introduction, on 27 April 2018 the attorney filed a new specification identical to that of the priority application US 15/343553. In the accompanying letter, the attorney argued that since the claim to priority was made upon the filing date it was clear that it was always intended to claim priority from US application 15/343553. Thus, he asserted, the act of filling a new specification (to match that of the priority application) was an obvious correction to make. The letter also addressed the two-step test, set out above, stating that it was clear from the priority claim that this new specification was what was originally intended.
- 10 The Attorney filed another letter on 2 May 2018, pointing out that the title on Patents Form 1 of the application was clearly different from that of the priority application, indeed the two were clearly related to entirely different technologies. Likewise, the two descriptions were clearly different. In contrast however, both the application and the priority application had the same identical 10 figures. The attorney argued that this made it immediately obvious that the originally filed description of the application

was wrong, and that, in this present case, the specification of the priority application was what must have been intended. Furthermore, the attorney argued that since the description was unambiguously incorrect and there was only the priority document available to correct it, it was followed that “nothing else could have been intended” as per the wording of rule 105(3).

- 11 I am afraid that I am not convinced by these arguments. It is common for an application to have a specification which exactly matches that of its priority application. However, it is also well known for applications to have a specification which does not match their priority application. I agree that it is indeed likely that the specification of the current application was supposed to match that of the priority application, but this is not enough to meet the requirement of Rule 105(3). The rule sets a high bar for a correction to be acceptable and I must assume that this is with good reason. Despite the priority claim, the differences in the titles and the matching figures, I cannot say that it is immediately evident that *nothing* else could have been intended as the original specification.
- 12 The Attorney filed a further letter on 6 June 2018, this time drawing attention to two particular passages from the Manual of Patent Practice. Specifically, MoPP 117.09 which states that:

*It is not however necessary that the reader be able to correct the error unaided; in considering an offered correction regard must be had to the view which the fully-informed and inquisitive skilled reader would take of the documents originally filed and the most likely solution to the difficulty apparent to him from them. Often the correct version will be unique and will be apparent from the documents filed at the time at which the application was made.*

And MoPP 117.08 which states that:

*Also, a knowledge of all the contents of the open part of the file of the application should be attributed to the reader, so that, for example, a discrepancy between the specification and an otherwise similar priority document should be regarded as enough to put the reader on enquiry. If, however, the specification makes technical and linguistic sense, then it is not immediately evident that this would not have been what was originally intended, so that, irrespective of what is proposed as the correction, it cannot be said that nothing else than what is offered would have been intended. In such a case the matter cannot be dealt with as the correction of an error.*

(Attorney’s emphasis added on both extracts).

- 13 On the basis of these passages, the attorney argued that if a specification does not make technical sense then the discrepancy indicates something other than the specification as filed was intended. I agree with this analysis, as far as it goes - in this case the references to the figures clearly indicate some sort of error. To my mind though it only indicates that at least part of the specification is incorrect. It does not naturally follow that the specification as a whole must be in error.
- 14 Furthermore, the attorney argued that, in line with the two phrases highlighted above, whatever else might have been included in the application, the most likely

solution was that the text of the priority application would have been what was intended. He argued that given the reference to the priority application, and the fact that the description as filed did not make technical sense, the skilled reader would be faced with a simple choice between the description as filed and that of the priority application. No other solution was available, thus the skilled reader would recognise that the priority application was the only obvious correction to the specification.

- 15 Also in his letter of 6 June 2018 the attorney argued that the phrase ‘nothing else could have been intended’ was an impossible requirement to satisfy. Rather, he submitted, the question should be decided upon the balance of probabilities. The attorney argued that I should “give regard to the view which the fully-informed and inquisitive skilled reader would take of the documents originally filed and the most likely solution to the difficulty apparent to him from them”.
- 16 Again, I’m afraid I disagree. To my mind, a fully-informed and inquisitive skilled reader would, upon discovering that the error existed, be fully aware that replacing the description as filed with the description of the priority application would correct the error. Such a reader would also be aware that an application may differ, sometimes significantly, from its priority application. To my mind, the existence of these two distinct possibilities creates a discrepancy which fails to meet the second part of the two-step test. It cannot be said, with certainty, that what is now offered is what was originally intended. It may be likely, but that does not equate to the level of certainty required by Rule 105(3). I therefore decide that the proposed correction fails to satisfy the second step of the test and thus it is not allowable.
- 17 As much as I have sympathy with the attorney that it is indeed a very difficult requirement to satisfy, nonetheless it is the one written in the rules. I am also struck that a lot of the difficulty of satisfying it in this case stems from the sheer magnitude of the proposed correction – i.e. replacing *everything* in the specification as filed with another entire specification. In my experience the requirement is much more achievable where the error to be corrected is a phrase or two.
- 18 Indeed, with this point in mind, I note that the wording of s.117(1) is concerned with correcting errors of translation or transcription, clerical errors or mistakes *in a* specification of a patent. To my mind, the error in this case is not of the same sort. It appears that the attorney has filed the wrong set of documents as a whole. As such, I am not totally convinced that s.117(1) is even intended to apply to such an error. I also note that just such a point was raised in the decision in *Klein Schanzlin & Becker AG’s application* [1985] RPC 241. However, I merely note this point for completeness. I do not need to decide the issue here since I have already concluded that the proposed correction is not allowable under s.117(1) even if it does apply.
- 19 Finally, the Attorney referred to a previous Office decision, BL O/235/05, which dealt with a very similar situation. This decision also concerned a request under section 117(1) to correct an application by filing the entire specification of its priority document. In this case the Hearing Officer, Mr Ben Micklewright, refused the requested correction, deciding that it failed the second step of the test laid out in MoPP 117.07. The attorney highlighted several differences between the facts of the current case and those of this earlier decision. Essentially that there were

differences in what was filed and when. He also submitted that the earlier decision did not set a precedent for the current application.

- 20 The latter point is of course correct. Earlier decisions by the Office are not binding on me. However, it is desirable to be consistent with earlier Office decisions where the law permits and the salient facts are substantially the same. Despite the attorney's argument to the contrary, I do consider the relevant facts of the current case and those considered in BLO/235/05 to be very close. I am thus reassured that my reasoning and final decision are consistent with that earlier decision.

### **Auxiliary Requests**

- 21 In his letter of 27 April 2018 the attorney also made two auxiliary requests. The first auxiliary request was that, under s.117, the text of the specification as filed be replaced with the text of the priority application. Technically this request is different from the main request – i.e. that the text of the specification as filed be replaced with the 'new' text filed on the 27 April 2018. However, in substance I believe that it is asking for exactly the same correction to be made. Thus following the reasoning I have laid out above, I decide that the first auxiliary request is also not allowable under s.117(1).
- 22 The second auxiliary request was the addition of missing pages under s.15(5)(c) of the Patents Act. Furthermore, requesting that s.15(6)(b) did not apply under s.15(7)(b). Specifically, the attorney wished to file the entire specification of the priority application as 'missing pages' replacing the specification on file.
- 23 Section 15(5) of the Act states:

*Subsection (6) below applies where-*

*(a) an application has a date of filing by virtue of subsection (1) above;*

*(b) within the prescribed period the applicant files at the Patent Office-*

*(i) a drawing, or*

*(ii) part of the description of the invention for which a patent is sought, and*

*(c) that drawing or that part of the description was missing from the application at the date of filing.*

Section 15(6) states:

*Unless the applicant withdraws the drawing or the part of the description filed under subsection (5)(b) above ("the missing part") before the end of the prescribed period-*

*(a) the missing part shall be treated as included in the application; and*

*(b) the date of filing the application shall be the date on which the missing part is filed at the Patent Office.*

And section 15(7) states:

*Subsection (6)(b) above does not apply if-*

*(a) on or before the date which is the date of filing the application by virtue of subsection (1) above a declaration is made under section 5(2) above in or in connection with the application;*

*(b) the applicant makes a request for subsection (6)(b) above not to apply;  
and*

*(c) the request complies with the relevant requirements of rules and is made within the prescribed period.*

24 I take this request to mean that the attorney is claiming that the entirety of the priority specification was 'missing' from the application as filed. Furthermore, that the application should not receive a later filing at, as per s.15(6)(b), because the applicants did indeed make a priority claim under section 5(2).

25 After due consideration, I must also refuse this request. Firstly, as MoPP 15.07 explains (my emphasis added):

*Subsections (5) to (8) provide for missing drawings and parts of the description to be filed after the date of filing, and are intended to reflect the provisions of a.5(6) of the PLT. Unless or until the terminology is further clarified by case law, it should be considered that a part is missing only when it is evident from inspection of the documents on file that the description or drawings are manifestly incomplete. The page numbering may be discontinuous, or there may be a mismatch between the number of pages of text alleged to have been filed and the number actually present. In the case of drawings there may either be a discontinuity in sheet/Figure numbering or the absence of a drawing listed in the description.*

I cannot in this case say the description, as filed, was manifestly incomplete. It was complete, it was just the 'wrong' description.

26 Secondly, I believe that it is clear that this section of the Act is not intended to bypass the requirements of s.117(1). Indeed section 15(8) explicitly states:

*Subsections (6) and (7) above do not affect the power of the comptroller under section 117(1) below to correct an error or mistake.*

27 Last, but certainly not least, the 'prescribed period' mentioned in section 15 is defined in Rules 18(1) and 18(2). These define the relevant period to be either *before* the issue of the preliminary examination report or within 2 months of its issue if said report raises the problem of missing pages. In this case the preliminary examination report was issued on 26 October 2017 and it raised no such issues. Thus the attorney's request was made outside the prescribed period. For all these reasons I refuse the second auxiliary request.

## **Decision**

- 28 I have decided that the proposed correction is not allowable under s.117(1) since I cannot say that it is immediately evident that nothing else could have been intended in the original specification.
- 29 I remit this case back to the examiner for further processing. I do not do so with any great optimism that a patent may be granted based on the apparently misfiled specification but merely because any such considerations are outside the scope of this decision.

## **Appeal**

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

**Stephen Brown**

Deputy Director, acting for the Comptroller