Intellectual Property Office

BL O/782/19

20 December 2019

PATENTS ACT 1977

APPLICANT	Gazel Investment Group Ltd
ISSUE	Whether a correction under Section 117 to include the abstract into the description of patent application GB1614145.9 is allowable
HEARING OFFICER	Phil Thorpe

DECISION

Introduction

1 This decision is unusual in that it concerns a patent application that initially comprised a two-page description and a twenty-one-page abstract. The issue before me is whether it is possible to incorporate the contents of the abstract into the description.

2 Patent application GB1614145.9 entitled "Flashbet Betwheel" was filed on 18th August 2016 and published as GB2559098 on 1st August 2018. The invention relates to an app-based betting system comprising an algorithm which is used to calculate multiple odds pathways. These are presented to a user in the form of a graphical bet wheel from which a user can choose to place a bet on a variety of football match outcomes.

3 The application names Mr Tunch Kashif and Gazel Investment Group Ltd as co-applicants and Mr Kashif as the sole inventor. Mr Kashif initially represented the applicants but in October 2018 Handsome I.P Ltd (the agent) was appointed to act on their behalf.

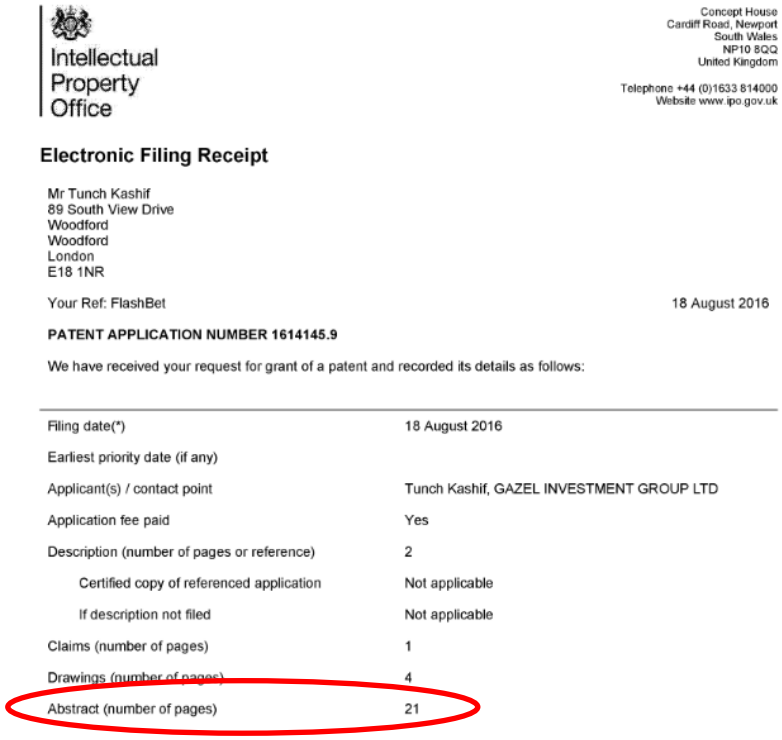
The application as filed

4 The original application, which was filed electronically, comprises two pages entitled "Description: (2 pages)", one page entitled "Claims: (1 page)", four pages entitled "Drawings: (4 pages)" and twenty-one pages entitled "Abstract: (21 pages)". This was confirmed by the applicant in section 9 of the Form 1 that accompanied the application which read as follows:

Description:	**2**
Claim(s):	**1**
Abstract:	**21**

Drawing(s): **4**

5 An electronic filing receipt was sent to Mr Kashif on the day of filing. This again confirmed the content of the application as filed.



Intellectual Property Office

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Electronic Filing Receipt

Mr Tunch Kashif
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Your Ref: FlashBet

18 August 2016

PATENT APPLICATION NUMBER 1614145.9

We have received your request for grant of a patent and recorded its details as follows:

Filing date(*)	18 August 2016
Earliest priority date (if any)	
Applicant(s) / contact point	Tunch Kashif, GAZEL INVESTMENT GROUP LTD
Application fee paid	Yes
Description (number of pages or reference)	2
Certified copy of referenced application	Not applicable
If description not filed	Not applicable
Claims (number of pages)	1
Drawings (number of pages)	4
Abstract (number of pages)	21

6 The applicants filed the necessary request for search on 22nd November 2017.

7 The examiner issued a report under section 17(5)(b) on 22nd May 2018 explaining that a search would serve no useful purpose. This was accompanied by an "Examination Opinion" detailing issues of patentability, clarity and added matter. The letter also warned the applicants that information contained in the abstract which did not appear in the description could not be used to amend the claims and that transferring this information to the description would not be allowed as it would be considered to add matter.

8 The applicants responded, through their agent, Handsome IP, on 23rd January 2019 requesting that the initially filed 21-page abstract be incorporated in its entirety into the description as a correction under section 117 of the Act. This request was refused by the examiner and despite further correspondence from the agent, the examiner maintained their objection and offered the applicants a hearing. In a letter of 25th April 2019, the agent requested a decision based on the papers. In that letter the agent made observations about the nature of the error and the test for determining whether that error could be corrected under section 117. The observations also included an additional argument that an irregularity of procedure had occurred which should be rectified by allowing the requested correction to be made.

9 Hence the issues that I need to consider are:

1) Whether the request to incorporate the 21 pages entitled “Abstract: (21 pages)” filed on 18th June 2016 in its entirety into the description should be allowed as a correction under section 117 of the Act?

2) Whether any irregularity of procedure has occurred during the processing of this application, and if so, should that be rectified by allowing the 21 pages entitled “Abstract: (21 pages)” to be incorporated into the description?

Request for a correction under section 117

10 I will begin by determining whether to allow the request for a correction under section 117 to incorporate the 21-page abstract in its entirety into the description.

The Law

11 Section 117 reads as follows:

> Correction of errors in patents and applications
>
> *(1) 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.*
>
> *(2) Where the comptroller is requested to correct such an error or mistake, any person may in accordance with rules give the comptroller notice of opposition to the request and the comptroller shall determine the matter.*
>
> *(3) …*
>
> *(4) …*

12 The relevant rule is rule 105 which reads (with added emphasis):

> *(1) A request to the comptroller to correct an error or mistake under section 117 must be made in writing and identify the proposed correction.*
>
> *(2) ...*
>
> *(3)* ***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).***
>
> *(4) But paragraph (3) does not apply where the error in the specification of the patent or application is connected to the delivery of the application in electronic form or using electronic communications.*
>
> *...*

13 The Manual of Patent Practice (MoPP) notes in respect of rule 105 as follows:

No correction may be made in a specification unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification). This is construed as imposing a two-fold test

(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?

14 MoPP goes on to say that the expression "immediately evident" is however taken as requiring that, when all the evidence is considered, it is abundantly clear that nothing else other than what is now offered as the correction was originally intended. It is not sufficient merely to show that, on balance of probabilities, the correction offered is the most likely version.

15 Section 117 and rule 105 do not specify who it is who needs to determine whether the correction is obvious. The applicants suggest that section 117 should be considered through the eyes of the skilled person and, importantly, that skilled person should have some knowledge of patent law and the contents of patents. It refers in support to *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group*[1]. The question under consideration in *Virgin* was how to construe a claim and more particularly, and of more relevance to the issues here, how much of the law and practice of the patent system is the skilled reader supposed to know. The issues of patent law that were being considered were the relevance of reference numbers in claims, the relevance of the two-part form of the claim and the nature of divisional applications. It was held that "the notional skilled reader is to be taken as knowing these matters and bringing them to bear when considering the scope of the claim". The judgement went on to note, in a paragraph relied on by the applicants here, that:

> "13. So the skilled reader is taken to suppose that the patentee knew some patent law – that his claim is for the purpose of defining the monopoly and that it should be for something new. Knowledge of that may well affect how the claim is read – for instance one would not expect the patentee to have used language which covered what he expressly acknowledged was old."

16 The question of who the notional person is for the purposes of section 117 was more directly addressed in *David E Berg et al*[2] where a request for a correction under section 117 to replace the specification in its entirety with a copy of the priority application was refused. The applicant in that case was represented by Mr James Abrahams of Counsel. In his decision the hearing officer noted:

> "8. Mr. Abrahams also submitted that the term "obvious" in Rule 91[3] means obvious to an experienced patent practitioner rather than to a layman. The Manual of Patent Practice states, in paragraph 117.08:
>
> > "the notional addressee of the specification is a person who is reading the document with the intention of extracting all the teaching from it, and who is aware of everything of common knowledge in the art concerned. For example, while a casual reader might not realise that the quoted serial number of another patent is incorrect, the notional reader will turn up every reference as he comes to it, and it will then be

[1] *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors Group*, 2009 WL 3197542 (2009)
[2] *David E Berg et al* BLO/235/05
[3] Rule 91 was replaced by rule 105 though its wording generally reflects that of rule 105.

> apparent (if for example the patent apparently referred to relates to completely different subject-matter) that the reference given would not have been intended."
>
> 9. Rule 91(2) uses the term "obvious" to mean "obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered by the correction". I believe that the notional addressee of the specification, as well as having knowledge of the relevant technical art, at least has enough knowledge of patent practice to, for example, recognize references to other patent applications in the specification and look up the contents of any available documents referred to by such references. They would also be able to recognise the various documents on the file and would be aware that a patent specification normally includes a description and a set of claims and perhaps some drawings. This will be sufficient elaboration on the nature of the person to whom the correction is to be obvious for present purposes."

17 Although the abstract is not explicitly referred to by the Hearing Officer in *Berg* I am satisfied that the notional addressee for these purposes would also understand that a patent application will include an abstract.

18 As to the nature of that abstract, the applicants notes that, by definition, an abstract is "a concise summary of the mater contained in the specification" and therefore must be shorter than the patent specification. It refers to MoPP paragraph 14.182 which notes:

> 14.182 An abstract should normally contain not more than 150 words, as it is unlikely to be considered to be concise if it extends beyond 150 words. However, if a longer text is considered essential, there is space on the front page which will accompany the published specification for approximately 200 words. Abstracts should therefore contain 200 words at the very most (including any reference numerals)

19 Whilst the notional addressee may not be fully aware of the precise word limit imposed on abstracts by the Intellectual Property Office (IPO), I am satisfied that they would be aware that the abstract is intended to be a summary of the specification and that typically it would extend to no more than half an A4 page of text. Hence, in this instance, it would be clear to the notional addresses when faced with a 21-page document labelled as an abstract and a 2-page document labelled as a description, that something was amiss. Hence, I am satisfied that if the skilled person looked at the entirety of the documents that were originally filed including the abstract, then it would be clear to them that there had been an error.

20 There is one point I think I need to say a little about before I go on to consider the question of what was originally intended. This is whether you can consider the abstract at all when considering corrections. The applicants refer to *Dukhovskoi's Application*[4] in support of its assertion that all the documents filed should be considered when considering the original intention of the patentee. This was a decision of the Patents Court which considered the allowability of a request to correct a mistranslation in a patent specification on the basis that it would have been clear from the original Russian document what was intended. Of particular note was that the Russian document had not, prior to the request for the correction, been made available to the IPO. The judgement in allowing the correction is however explicitly limited to the issue of errors in translation though at least there, documents other than the claims, drawings and description could be relied on even where those

[4] *Dukhovskoi's Application* [1985] RPC 8

documents had not been filed with the application. But does that suggest that the abstract can be considered for the purposes of corrections?

21 The status of abstracts was considered more recently in *Abbott Laboratories Ltd. v Medinol Ltd*[5] which was considering whether matter present in the abstract could be incorporated into the description or claims. In holding it could not be, Arnold J. as he was then, noted:

> 65. Before turning to the Application itself, there is an issue of law as to the status of the abstract. Medinol seeks to rely upon this in support of its case as to the disclosure of the Application, and hence its case on added matter, whereas Abbott contends that the abstract cannot be relied on for that purpose.
>
> 66. In the EPO, Article 78(1)(e) of the European Patent Convention requires a European patent application to include an abstract. Article 85 provides, however, that:
>
> > "The abstract shall serve the purpose of technical information only; it may not be taken into account for any other purpose, in particular for interpreting the scope of the protection sought or applying Article 54, paragraph 3."
>
> In addition to the purposes specifically mentioned in Article 85 , the Boards of Appeal have held that a patentee cannot rely upon the contents of the abstract in his application for the purposes of overcoming an objection under Article 123(2) (added matter): see T246/86 BULL/Identification system [1989] EPOR 344 and T606/06 (23 April 2008, unreported) .
>
> 67. In the United Kingdom, section 14(2)(c) of the Patents Act 1977 also requires a patent application to include an abstract. Section 14(7) provides:
>
> > "The purpose of the abstract is to give technical information and on publication it shall not form part of the state of the art by virtue of section 2(3) above…"
>
> Despite the resemblance of section 14(7) to Article 85 , it is not one of the provisions declared by section 130(7) to be framed so as to have the same effect as the corresponding provisions of the EPC . In ARMCO Inc's Application (O/84/85) the Comptroller's hearing officer accepted the applicant's argument that, since an abstract formed part of the application by virtue of section 14(2)(c) , matter contained in the abstract could be considered for the purposes of an objection under section 76(2) (added matter). There is no reference in the decision to the corresponding provisions of the EPC , nor (obviously) to the later decisions of the EPO Boards of Appeal.
>
> 68. Counsel for Abbott submitted that, for reasons which are now well known, it is undesirable for domestic provisions corresponding to those in the EPC to be interpreted in a different manner than that adopted by the Boards of Appeal, and therefore section 14(7) should be interpreted in the same manner as Article 85 . I accept that submission. The fact that section 14(7) is not one of the provisions listed in section 130(7) does not prevent it from being interpreted in the same way as Article 85 . Nor do I see that it matters that section 14(7) omits the word "only": like Article 85 , section 14(7) identifies the purpose of the abstract as being to provide technical information, and it is implicit that that is its only purpose.
>
> 69. Counsel for Abbott also submitted that the purpose of the abstract is to provide a précis of the application. As a matter of logic, it follows that, if the abstract means the same thing as the application, it adds nothing; and, if does not mean the same thing, it must be inaccurate.

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[5] *Abbott Laboratories Ltd. v Medinol Ltd* [2010] EWHC 2865 (Pat)

> He relied in support of this on the reasoning of the Board of Appeal in Case T1080/99 TEKTRONIX/Touch control [2003] EPOR 25 at [4.6]. I agree with this analysis.
>
> 70. For these reasons I shall ignore the abstract when considering the disclosure of the Application.

22 Hence in *Abbott*, the abstract was effectively ignored for the purpose of considering whether there is added matter. There does not appear to have been any consideration in the UK as to whether the abstract should be similarly ignored when considering corrections under section 117. By contrast the practice of the EPO under the EPC seems to be that corrections cannot be established on the basis of the contents of abstract. In G11/91[6] the Enlarged Board of Appeal of the EPO was considering whether documents other than the description, claims and drawings can be used for the purposes of determining the allowability of a correction under rule 88. Rule 88 has been replaced by rule 139 though the wording of the two rules is the same. Rule 139 provides that:

> "Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction."

23 The Enlarged Board held that:

> "7. Before a correction can be made under Rule 88, second sentence, EPC it has to be established what actually a skilled person would derive, on the date of filing, from the parts of the European patent application relating to the disclosure. As a result of the prohibition of extension under Article 123(2) EPC, documents other than the description, claims and drawings may only be used insofar as they are sufficient for proving the common general knowledge on the date of filing. On the other hand, documents not meeting this condition may not be used for a correction under Rule 88, second sentence, EPC even if they were filed together with the European patent application. These include, inter alia, priority documents, the abstract and the like."

24 If I was to follow a similar approach here, then it is clear that the request for the correction would fail. Firstly, if the abstract is ignored in its entirety then it would not even be clear that there was an error since the description, claims and drawings when read together are not clearly wrong. Secondly, without the abstract it would in no way be possible to say that what is proposed by the correction was what was originally intended.

25 Whilst *Abbott* was concerned with section 14(7) and the question of added matter, the judgement is clear that the only purpose of the abstract is to provide technical information. It also provides a clear steer that even though section 117 is not listed in section 130 as having the same effects as the corresponding provision in the EPC, which would be rule 139, that does not prevent it from being interpreted in the same way as rule 139.

26 I am mindful that *Abbott* does not discuss *Dukhovskoi's application* which does allow documents other than the claims, description and drawing to be used for determining if a correction is allowable. I am also mindful that this argument has not been put to

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[6] G11/91 ECLI:EP:BA:1992:G001191.19921119

the applicants though I am confident that its response would be that, even if my analysis above was correct, it would not apply here since the "abstract" in issue here was never intended to be an abstract but was mistakenly labelled and submitted as such. Though I have my doubts whether such an argument would succeed, I am prepared for the purposes of this decision to proceed on the basis that I can take into account the abstract when considering whether there has clearly been an error and also when considering the question of what was originally intended.

If it is clear that there is an error, is it also clear that what is now offered is what was originally intended?

27 The applicants contend that having determined that there has been an error, the notional address would go on to consider what the 21-page abstract was intended to be. The applicants argue that they erroneously filed 21 pages containing information about the invention as the abstract when in fact they intended for this information to form part of the disclosure of the invention. They argue that they were at the time unaware of the requirements and purpose of a patent abstract, how it would be treated or how it should be presented. This led directly to two further errors: i) The word "abstract" was added to the top of pages of the description; and ii) those pages were submitted as an "abstract" using the IPO online filing system[7].

28 Hence according to the applicants, when considering what the 21 page "abstract" was originally intended to be, there are only three possible options. It was either i) an abstract, ii) a description and drawings or iii) a set of claims. They go on to argue that the 21-page "abstract" could not have been an abstract for the reasons already given and the lack of a series of numbered clauses means it would not be considered to be the claims. This only leaves the description.

29 In response I would note firstly that the originally filed claims are not presented as numbered clauses. This at least in part undermines the applicants' argument about what the 21-page abstract could not be. Secondly and more significantly, the documents as originally filed already include a description extending over two pages. There is nothing in the applicants' arguments to suggest that the notional reader would not view these two pages as a description. Hence when looking at the documents as a whole, as the applicants is asking me to do, it simply is not clear, even if I accept that the 21-page abstract was incorrectly labelled and submitted as an abstract, whether those 21 pages were intended to be the whole description or whether they were intended to supplement the two pages labelled as the description. On that basis alone, it is not clear that what is now offered is what was originally intended and hence the request for a correction must fail.

Is this an error that can be corrected?

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[7] Whilst the applicant refers to the use of the IPO online filing system, there is no suggestion that the online filing system led directly to the error or that it contributed towards the error in any way. In particular, there is nothing to suggest that the error *is connected to the delivery of the application in electronic form or using electronic communications.* As such paragraph 4 of rule 105 is not relevant in this case.

30 I would make one final observation on the issue of correction. That is, it is far from clear whether correcting what the applicants present as in effect an error in the filing of documents, is within the scope of section 117. In *Berg* a request for a correction under section 117 to replace the specification in its entirety with a copy of the priority application was refused. In paragraph 9 the Hearing Officer noted:

> "9. On the general scope of rule 117(1) the hearing officer in the case *Klein Schanzlin & Becker AG's application* [1985] RPC 241 made the following comments:
>
> > "I do not accept that the Comptroller has discretion to correct a procedural mistake under the provisions of section 117(1) and rule 91(1). It seems to me that the wording of section 117(1) is such as to leave no doubt that it relates to errors of translation, clerical errors or mistakes in documents and not to procedural errors or mistakes in the filing of documents. Irregularities in procedure are dealt with in rule 100."
>
> This seems to me to be a correct analysis of the scope of the discretion provided to the Comptroller by section 117(1) and I agree that the Comptroller does not have discretion to correct procedural errors or mistakes in the filing of documents under the provisions of section 117(1), but is limited to errors in documents."

31 In *Klein Schanzlin*, the application in issue contained a declaration of priority however owing to a clerical mistake in the patent attorney's office no priority document was filed within the prescribed period. A request to correct this mistake by way of a correction under s117 was refused.

32 The question that arises here is whether the error made by the applicants was one relating simply to the filing of documents or more accurately was it just that a document intended to be the description or part of the description was incorrectly filed as an abstract. This would appear to be the basis of the applicants' argument. Hence the reasoning in *Berg* and *Klein Schanzlin* would suggest that the error here was not one that could be corrected under section 117. Again, I do not believe I need to decide on that particular point as I have already concluded that the correction sought would not meet the requirements of section 117 in any event.

Irregularity of procedure

33 I will now consider whether any irregularity of procedure has occurred during the processing of this case. The agent argues that the IPO should have informed the applicants who were unrepresented of the implications of including material in the abstract that was intended for the description. He argues that the applicants should have been given the opportunity to withdraw with a refund of the search fee and then re-file the application.

34 The agent refers in support to the guidance relating to abstracts provided in the IPO's Manual of Patent Practice (MoPP) at paragraphs 14.170 and 14.171 which to the extent that is relevant to the matter in issue here is set out with my added emphasis below:

> 14.170
>
> If an abstract fails to meet any requirement of r.15 then it may be amended by the examiner, using the power given to the comptroller by s.14(7). Although amendments made by the examiner do not form a part of the application as filed, it is the amended form of the abstract that is included in the published 'A' document, see 16.08 (There is no appeal to the Patents

Court from a decision of the comptroller under s.14(7)). If however the abstract as filed clearly fails to meet the dictionary definition of an abstract (ie a brief statement of the chief points of a larger work), for example when it is little more than a title, then objection should be raised that no abstract has been filed and the applicant asked to remedy this. If the time allowed for filing the abstract (see 15.50) has already expired (including any extension allowed under r.108), the application will be taken to have been withdrawn (see 15.55).

[An objection that the applicant has failed to file anything that meets the dictionary definition of an abstract should only be raised in the clearest cases. The desirability of giving every help to private applicants should be borne in mind.]

14.171

…….The disclosure of the abstract, even if filed on the date of filing, cannot therefore be considered for the purpose of determining under s.76 whether an amendment adds matter extending beyond the disclosure of the application as filed. It is not possible to incorporate this material into the description or claims by subsequent amendment, and so it will not be possible for the applicant to claim this matter, or to rely on this disclosure to provide support for the claims or to overcome an objection of insufficiency. The applicant should therefore be informed of this situation and its implications as soon as possible, so that they may have the opportunity to withdraw and re-file the application with the matter in question included in the specification. In addition, Arnold J said that the purpose of the abstract is to provide a summary of the disclosure of the specification, and so if it does not mean the same thing as the specification then it must be assumed to be an inaccurate summary. Therefore, when re-framing the abstract, the examiner should delete any material which does not appear elsewhere in the application, regardless of whether the abstract was filed on the day of filing or later.

[Inclusion of material in the abstract but not in the specification is most likely in applications from private applicants, and so examiners dealing with applications from private applicants should be particularly alert to this possibility.]

[Applications from private applicants are sent to the Private Applicant Unit (PAU) see 17.03. PAU examiners will scrutinise abstracts to determine whether they contain matter not present elsewhere in the application. If the PAU examiner becomes aware that there is a significant disclosure in the abstract which is not present elsewhere in the application, then they may issue a letter to the applicant under the ABS or ABCSE procedure as set out in 17.94.5-9 This letter should give the applicant the options to withdraw the application and re-file (with a refund of the search fee), or to continue with the application.]

[Where a private applicant case has been sent to an examination group, this problem is most likely to come to light when the search examiner scrutinises and if necessary re-frames the abstract. If the search examiner discovers significant material in the abstract which is not disclosed elsewhere in the application, he should inform the applicant of this problem and its implications as soon as possible. This may be done by including an appropriate warning in the search letter. However, if the matter disclosed solely in the abstract is likely to be critical for the grant of a patent, then it may be more appropriate to issue an ABS or ABCSE letter.]

35 The agent argues that the IPO did not follow its own guidance, and since the application has now been published thus making it impossible for the applicants to withdraw and refile, it would be appropriate for the IPO to correct this irregularity of procedure by allowing the subject matter contained in the abstract to be incorporated into the description.

The Law

36 Before considering in more detail how the application was handled I will set out the relevant legislation and say a little about what constitutes an irregularity of

procedure. The correction of irregularities is governed by rule 107 which replaced rule 100 referred to in *Berg*. Rule 107 reads so far as is relevant as follows:

> *(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.*
>
> *(2) Any rectification made under paragraph (1) shall be made—*
>
> *(a) after giving the parties such notice; and*
>
> *(b) subject to such conditions, as the comptroller may direct.*
>
> *(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if—*
>
> *(a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and*
>
> *(b) it appears to the comptroller that the irregularity should be rectified.*

37 The applicants here are not asking for an extension of time under section 107(3) but rather that the comptroller authorises, by way of a rectification of an irregularity of procedure under section 107(1), the application to be corrected.

Meaning of "irregularity of procedure"

38 Guidance on what constitutes an "irregularity of procedure" has been provided in a number of decisions of the Courts and the Comptroller. Of relevance here, given that the applicants are arguing that the IPO did not follow the practice set out in MoPP, is *Mills Application*[8]. In that case, the date for requesting substantive examination of a pending application was missed and the application was therefore treated as being withdrawn. The agent however argued that the IPO's failure to send the applicants a copy of the published specification contributed to the applicants' failure to file the request in the required time. Neither the Hearing Officer nor, on appeal, the Patent Court judge accepted that, basing their decisions in part on an understanding that an omission by the office to do something was for the purposes of rule 107 to be construed as an omission to do something that it was obliged to do by either the patents act or the patent rules. The Court of Appeal however held that an omission need not be limited to something that the office is legally obliged to do but could also extend to for example failure to follow a well-established and generally well-known practice.

39 This is reflected in MoPP which notes that rule 107 may be used to rectify an irregularity where that irregularity was attributable, at least in part, to a reasonable expectation created by well-established Office practice.

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[8] Mill's Application 1985 RPC 339

40 I turn now to consider the handling of the case in issue here.

41 As already stated the application was filed on 18th August 2016. It included a part labelled as an abstract. The first communication from the IPO was the filing receipt which acknowledged that a 21-page abstract had been filed.

42 Before a case is processed by a patent examiner, it is first subjected to a formalities check and preliminary examination by a formalities examiner. These are simple checks to establish that all necessary documents have been filed and that they comply with the formal requirements set out in the rules. If the formalities examiner finds that any formal requirements have not been met, then a preliminary examination report is produced. It is not the responsibility of the formalities examiner to do any more than this. The guidance found in MoPP 14.170-171 relied on by the applicants is directed towards the patent examiner rather than the formalities examiner.

43 In this case the formalities examiner performed the preliminary examination and reported on 17th October 2016 that, among other things, the abstract was not acceptable. The report noted:

> "**ABSTRACT**
>
> The abstract you have submitted cannot be accepted as it does not meet the requirements expected by the Intellectual Property Office. I have attached a fact sheet explaining what is required in the abstract and other parts of the specification. If you wish to continue with your patent application, you must file an abstract of your invention by **18th August 2017**."

44 A copy of the abstract factsheet was enclosed with the report. This factsheet, which is set out in Annex 1, includes the following warning:

> The Abstract **is not** part of the specification.
>
> You should ensure that **all** the technical features mentioned in the abstract are also in the description. The information contained within the abstract cannot be relied upon as a disclosure of the invention. This means that you cannot transfer any features from the abstract to the description at a later date and you cannot claim a priority date for any matter contained solely in the abstract.

45 The covering letter includes a link to the IPO website which provides further guidance on the application process. A link to the IPO website is also provided at the bottom of the abstract factsheet which was issued to the applicants.

46 The preliminary examination report also noted that a search needed to be requested and a fee paid by 18th August 2017 and that a statement of inventorship needed to be filed by 18th December 2017. On 16th August 2017 the applicants filed a Form 52 together with the associated £135 fee requesting a 2-month extension of time. A further Form 52 and fee was filed along with a "*request to extend a prescribed time limit*" on 23rd October 2017. Accompanying these were three pages "*to be included in the patent pending application number GB1614145.9*". The letter from the applicants did not specify which time limit was to be extended, neither were any reasons

provided for the request though it was assumed that the extension in time was being sought in respect of the requirement to request the search and pay the fee.

47 In response the IPO wrote to the applicants on 30th October 2017 requesting evidence to show why the extended deadline had been missed. This letter also informed the applicants that the additional three pages could not be accepted as they were considered to add matter and did not appear relevant to the current application.

48 The applicants filed the necessary request for search on 22nd November 2017. At the same time, they filed a document entitled "Abstract in support of Patent Application GB1614145.9" which comprised of 42 pages. The applicants also explained that the deadline was missed due to "operational issues" with the "FlashBet mini Wheel" which he wanted to include in the present application and also because he wanted to register "FlashBet" as a trade mark.

49 This explanation was accepted by the IPO in a letter dated 24th November 2017 which informed the applicants that an extension of time under rule 108(3) had been allowed to file Form 9A requesting the search. The letter also specified that the required statement of inventorship still had to be filed by 18th December 2018 and informed the applicants that the application had been passed to the patent examiner for search.

50 While assessing the case in preparation for performing the search, the patent examiner concluded that grant of a patent was unlikely because the application relates to matter excluded from patentability. A letter was issued on the 22nd December 2017 to the applicants advising of this and giving them the opportunity to withdraw the application and obtain a refund of the search fee. The letter included a warning that should the applicants choose to continue with the application it would be likely that a report would issue concluding that a search would serve no useful purpose. This letter also advised the applicants to seek professional advice. The letter though did not refer to the abstract nor to other outstanding issues focussing instead on the issue of excluded matter. The applicants did not respond to this letter.

51 The patent examiner issued a report under section 17(5)(b) on 22nd May 2018 informing the applicants that no search had been performed due to the application being directed towards matter that is excluded from patentability. The examiner reframed the abstract in line with the guidance in 14.171 MoPP. An Examination Opinion accompanied this search report which included further details of the problems that the examiner had identified with the application, including a paragraph relating to the abstract. This read as follows:

> **Abstract**
>
> 6. Your abstract contains information which is not included in the description. Transferring this information to the description would be considered to add matter to the application, which is not allowed. It follows that this information may not be used to amend the claims.
>
> 7. I have redrafted the Abstract to remove the information not found in the description, and the removed information no longer forms part of the application. If you want to have this information included you must file a new application with all the relevant information included in the description.

The covering letter sent with this Examination Opinion again advised the applicants to consider seeking professional advice.

52 The applicants were then informed in a letter dated 2nd July 2018 that the application would be published on 1st August 2018. The letter advised the applicants that if they wished to withdraw the application they needed to do so by 6th July 2018. No response to this letter was received and hence the application was published on 1st August 2018.

53 Having set out details of how the case was handled I now need to consider whether any irregularity in procedure has occurred that is attributable, at least in part, to a reasonable expectation created by well-established Office practice. The practice that the applicants are relying on here is that based on the guidance in that part of MoPP referred to above.

54 It is not in dispute that the IPO should, and indeed does, offer advice to unrepresented applicants particularly where there are serious deficiencies in the application including in the abstract. The guidance says this should be done as soon as possible. The reason for that is to give applicants the opportunity to withdraw their application before publication should they wish to.

55 The deficiencies in the abstract in the case in issue here were made clear to the applicants on several occasions starting with the preliminary examination report sent to the applicants within two months of the application being filed. This report also included further information, in the form of the abstract factsheet, which provided guidance on the requirement of an abstract as well as a warning that material disclosed in the abstract could not be transferred to the description. Secondly, the applicants were specifically advised on 23rd May 2018, some 2 ½ months before the application was published that the abstract included material not found in the description and that if protection was sought for that then a new application would need to be filed.

56 With hindsight it is unfortunate that the applicants were not explicitly advised in this report that to be able to obtain protection for any additional material in the abstract it was necessary to withdraw the current application before publication. That said the possibility of withdrawing the application in issue was explained to the applicants in general terms in the covering letter sent with the Examination Opinion. It is also relevant that in December 2018, again well before publication, the applicants were warned that a patent was unlikely to be granted because the application related to excluded subject matter. The applicants were advised at that time to consider withdrawing the application and then seek a refund of the search fee. They chose not to do so.

57 Further there is nothing before me to indicate that the applicants, prior to publication of the application, sought professional advice as they had been advised to do so by the examiner on several occasions. Had they done so then they would probably have withdrawn this application and filed a fresh application. That they did not do this is not I believe the result of any irregularity in procedure on the part of the IPO but rather a consequence of their unfamiliarity with the requirements of patent applications and the procedure for obtaining a patent and their decision not to get professional advice.

58 As such I am content that no irregularity of procedure has occurred that would warrant allowing the application to now be corrected as requested by the applicants.

Conclusions and Findings

59 I find that the request to incorporate the 21 pages entitled “Abstract: (21 pages)” filed on 18th August 2016 in its entirety into the description is not allowable as a correction under section 117 of the Act because it fails to satisfy the second step of the two step test set out in rule 105, namely that it is not clear that what is now offered is what was originally intended.

60 I also find that there were no procedural irregularities on the part of the IPO that would warrant rectification so as to allow the abstract to be incorporated into the description

61 Since a Form 10 has been filed, the application will be subject in due course, unless the application is withdrawn, of substantive examination.

Appeal

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

Phil Thorpe

Deputy Director, acting for the Comptroller

Annex 1

Intellectual Property Office

Patent Factsheets: Abstract

The basis of a UK patent application is a legal document called a specification. Its contents determine whether a patent can be granted. You would be well advised to seek professional assistance when preparing your patent application. A patent specification includes:

- a full description of your invention, plus any drawings referred to within your description
- one or more claims.

This factsheet tells you about the abstract. An example is shown overleaf. Other factsheets in this series explain how to prepare a description, drawings, and claims.

Content

An abstract is a brief **summary** of your invention, and should include all of the most **important technical features** of your invention. It is useful to both the Intellectual Property Office and to the public searching in the particular technical field of the application.

The abstract should indicate the technical field to which the invention belongs and be drafted in a manner which allows a clear understanding of the technical problem to be solved and the solution to that problem, namely your invention.

The abstract should have a **title**, which may be the same as the title of your description. The title should be brief, specific and reflect the nature of the invention. **Do not** include expressions such as "improvements in or relating to" or "and the like".

The Abstract **is not** part of the specification.

You should ensure that **all** the technical features mentioned in the abstract are also in the description. The information contained within the abstract cannot be relied upon as a disclosure of the invention. This means that you cannot transfer any features from the abstract to the description at a later date and you cannot claim a priority date for any matter contained solely in the abstract.

Start your abstract with the most important **essential technical features** of your invention. You may then wish to refer to some of the **non-essential features** you have mentioned in the description.

If your specification includes drawings, you should **suggest** in writing, below the abstract, which **figure** you think goes best with the abstract to illustrate your invention. **Do not** provide a separate drawing specially for the abstract.

If a feature from the figure you suggest is mentioned in your abstract, the **reference number** for that feature should be given in the abstract as well.

Style and presentation

Head your abstract page 'ABSTRACT'.

You should type or print the abstract on **one side only** of a separate sheet of white A4 paper using no more than **150 words**.

Leave **margins** of at least 2.0cm.

The Intellectual Property Office may edit your abstract.

The abstract should be in English or Welsh. (The Office will provide a translation of any material filed in Welsh).

IMPORTANT: You must file your abstract within 12 months of your filing date (where no claim to priority is made). If a claim to priority is made, you must file your abstract by the latter of 12 months from your priority date, or two months from your filing date.

Abstract: Typical example

Page numbered to follow on after the claim page(s)

Use A4 paper

Head the page

'ABSTRACT'

Title

A summary of your invention (maximum of 150 words)

Suggest a figure from your drawing sheets

Abstract

Bicycle stabilising unit

A bicycle stabilising unit 1 includes attachment means 3,4 for attaching the unit to a bicycle, a ground engaging wheel 6 which can freely rotate about an axis, and cushioning means 7,8 such that the axis of the wheel can be displaced relative to the attachment means.

Figure 1 to accompany abstract